Association News

Panama Leadership Meeting Expands INTA’s Global Network

INTA President J. Scott Evans (Adobe Systems, USA) dubbed the Association’s first Leadership Meeting in Latin America “a huge success” during his remarks at the Opening Ceremony on November 17, 2015.

With 1,132 attendees from all around the world, INTA was excited to bring the Leadership Meeting outside the United States for the first time in the Association’s history. In line with the 2014–2017 Strategic Plan, this Meeting served to expand the Association’s outreach internationally and strengthen the relationship with Panamanian government officials.

Board of Directors and Opening Ceremony
The Meeting kicked-off on November 17 with INTA’s Board of Directors Meeting. During this meeting, the new Officers were elected for 2016 and the budget was approved for the coming year.

Later that evening, the Opening Ceremony took place at the Megapolis Convention Center. During the ceremony, INTA CEO Etienne Sanz de Acedo reviewed the Association’s accomplishments over the past year—including the Memorandums of Understandings (MOUs) signed with IP offices around the world and the Association’s involvement with major issues, such as New gTLDs, plain packaging and geographical indications. Mr. Sanz de Acedo also highlighted the goals for the coming year, such as the delegations planned for the first quarter of 2016 to China and India and conferences including Brands, and Sports and Designs: Into the Future.

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Association News

INTA’s 2015 Award Winners Share Their Tips for Leadership Success

At this year’s Leadership Meeting in Panama City, Panama, INTA President J. Scott Evans presented the 2015 President’s Awards to Janet Hoffman (Fross Zelnick Lehrman & Zissu, P.C., USA), a 20-year member of the Association who played a pivotal role in INTA’s international expansion into Russia and surrounding countries. Mr. Evans highlighted Ms. Hoffman’s service on more than 15 committees and subcommittees, the Board of Directors, and her years as a contributing author and editor of The Trademark Reporter.

Mr. Evans also presented seven Volunteer Service Awards to INTA members who have proven their dedication to the Association and commitment to furthering trademark law. Below, Ms. Hoffman and the Volunteer Service Award winners share their advice to young trademark practitioners, recount their personal paths to trademarks and give us a glimpse into their lives outside the trademark realm.

President’s Award

Janet Hoffman, Fross Zelnick Lehrman & Zissu, P.C., USA

What (or who) led you to practice trademark law?
I would say it was a natural choice, given my background in languages and my interest in the world around me, including all the symbols that come into our view on a daily basis. Of course, once I joined Fross Zelnick (then Weiss, Dawid, Fross & Lehrman), I became totally inspired, and frankly even surprised, by the depth and breadth of the practice, and of course the fun of it all. And, needless to say, being surrounded as I was by some of the greatest pioneers in the field was greatly inspiring. And, yes, I like to shop!

Janet Hoffman with 2015 INTA President J. Scott Evans

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Mr. Evans highlighted the importance of navigating change. This theme has been especially important during his presidential term and was meaningful to the committee members as they embarked upon a new committee term. Mr. Evans highlighted the importance of change by using the following five influential lines from prominent world leaders:

1. “Change before you have to”—Jack Welch (CEO of General Electric)
2. “You manage things; you lead people”—Admiral Grace Hopper
3. “Lead from the back”—Nelson Mandela
4. “It is not the strongest or the most intelligent who will survive but those who can best manage change”—Charles Darwin
5. “When you’re finished changing, you’re finished”—Benjamin Franklin

Additional speakers at the Opening Ceremony included Alvaro Aleman, Ministry of the Presidency of Panama, and Jorge Luis Quijano, Administrator of the Panama Canal Authority. Both individuals spoke about the impact of the Panama Canal expansion on international trade and the future of Panama’s economy as a result.

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Jorge Luis Quijano, Administrator of the Panama Canal Authority.

The Opening Ceremony concluded with the presentation of the 2015 President’s and Volunteer Service Award Winners.

Speakers from the Leadership Enhancement Development Sessions (LEAD).

On Thursday, November 18, there were two Leadership Enhancement Development Sessions. The first was titled “Take it to the Goal,” where attendees had the opportunity to hear Gary Stempel, former Head Coach and Manager of the Panamanian national football team, discuss how his views on leadership have evolved throughout the course of his many careers. Next, registrants had the opportunity to hear from Mr. Evans, Immediate Past Presi-
Immediate Past President Mei-lan Stark (Fox Entertainment Group, USA), Mr. Evans, and President-Elect Ronald van Tuijl (JT International, Switzerland).

President-Elect Ronald van Tuijl (JT International, Switzerland) and President-Elect Ronald van Tuijl (JT International, Switzerland) discuss their views on navigating through change in their roles as business leaders.

Committee leaders also attended a management workshop, where they heard from a panel of speakers who discussed effective management tips for the incoming committee terms. Panelists included Tish Berard (Hearts On Fire Company LLC, USA), Janice Bereskin (Bereskin & Parr LLP, Canada), Alicia Lloreda (Lloreda Camacho & Co., Colombia) and Mr. Sanz de Acedo.

MOU Signing
INTA concluded the Meeting by signing a MOU with The Judiciary of the Republic of Panama on November 20. This MOU sets a foundation for future cooperation between INTA and the Judiciary, and recognizes both the need for robust IP systems in a rapidly changing and increasingly integrated global economy, as well as the central role of Panama in international maritime trade.

Mr. Sanz de Acedo expressed his thanks to everyone who attended the 2015 Leadership Meeting. The milestone Meeting was a huge success thanks to the Association’s dedicated committee members.

Unreal Campaign Educates Panamanian High School Students
On Wednesday, November 18, the Unreal Campaign visited Colegio San Agustin, a private high school in Panama. The presenters included Audrey Williams (Bendetti & Bendetti), Hugo Moran (Icaza, Gonzalez-Ruis & Aleman) and Gabriela Tejada de Britton (Icaza, Gonzalez-Ruis & Aleman), who presented to 250 high school students on the importance of trademarks and the dangers of counterfeit goods. This was the Unreal Campaign’s first event in Panama; both the students and the administration expressed interest in hosting future programs.

From left to right: Michelle Brownlee, Audrey Williams, Daniela Rojas, Laura Heery, Father Pedro Gregorio Rivas (Dean of Colegio San Agustin), Gabriela Tejada de Britton, and Hugo Moran.

Challenges, Counterfeits and Crisis Communications—Maintaining Brand Integrity in a Changing Landscape
Visit www.inta.org/2016Sports to learn more about the program, networking opportunities and attendance justification.

Visit www.inta.org/2016Sports
What (in addition to your colleagues) is the best thing about working in the trademark field?
I have to say that landing in the field was a dream come true. It has been a perfect thing about working in the trademark field.

Anthony Dreyer, Skadden, Arps, Slate, Meagher & Flom LLP, USA

Advancement of Trademark Law

What advice do you give to people just starting their careers?
Don’t be afraid to be afraid. Becoming better at the practice of law, like many things, requires you to do things you have never done before, which might be uncomfortable or even scary. It might be arguing a motion before a tough federal judge, cross examining a witness in front of a jury, or trying to persuade a potential client why you are the best lawyer for the case. If you are too afraid to move outside of what is comfortable or safe, you will likely miss out on some of the most exciting things you can do as a lawyer.

Marc Lieberstein, Kilpatrick Townsend & Stockton LLP, USA

What’s your favorite trademark?
What’s your favorite trademark? The evolution of trademarks is a kind of reflection of the ever-changing international stage and the world around us. Look at all the changes we have seen over the past two decades. We have witnessed both a coming together and a splitting apart of trademark registration systems around the world. Are we on the way to a supranational trademark registration system? Time will tell of course, but it has been a fascinating ride so far.

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Advancement of Committee or Subcommittee Objectives

What do you do when not practicing law?
I enjoy art and music, playing guitar and piano, making jewelry, taking long walks, traveling, spending time with new and old friends. More recently, I have become more deeply engaged in handling the art portfolio of my late husband, Len Rosenfeld, whom many of you know was a big INTA Annual Meeting “regular.” With a one-man show coming up in New York in late November, and other opportunities on the horizon, I expect I will be putting more time into this venture in the coming years.

What’s your favorite trademark?
Probably the iconic Nike Swoosh. It is a great example of a simple trademark that, because of Nike’s tremendous advertising and promotional efforts, conveys so much with so little. In my trademark law class, I show students just the Swoosh and ask what it conveys to them. Without fail they play back not just “Nike,” but everything that Nike associates with its brand, including hard work, athleticism and the pursuit of excellence.

What advice do you give to people just starting their careers?
If you are too afraid to move outside of what is comfortable or safe, you will likely miss out on some of the most exciting things you can do as a lawyer.

What do you do when not practicing law?
I teach courses on the Lanham Act and a class on sports and the law (with a heavy IP focus). It’s a great way to stay current on new cases and developments in the area. I also find that spending time with students at the start of their legal careers is invigorating. And when I’m not doing that, I try to spend as much time as I can chasing around my four-year old son and six-month old daughter...which is probably more exhausting than invigorating, but pretty amazing nonetheless.

Marc Lieberstein, Kilpatrick Townsend & Stockton LLP, USA

What (or who) led you to practice trademark law?
My interest in combined my passion for business and law. Trademarks, and the branding power they possess, are an excellent vehicle for me to exercise my transactional attorney skills to strategically work together with clients to create new businesses, expand or rejuvenate old businesses, all with the objective of making money for clients.

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Marc Lieberstein, Kilpatrick Townsend & Stockton LLP, USA

What do you do when not practicing law?
I have been asked this before and my only answer can be, “Wow—must I play favorites?” Of course, the Harley Davidson vroooooom is a tempting choice, as is the Louboutin red sole. That said, however, I prefer to dodge this question by saying that my favorite trademarks are those that are well protected!

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What (in addition to your colleagues) is the best thing about working in the trademark field?
I enjoy working in the trademark field because the law seems to be flexible enough to enable attorneys to usually find resolutions to our clients’ problems. It permits creativity and ingenuity in the practice, which I don’t think other areas of law allow as much. At INTA I am proud to say I work with trademark attorneys who truly enjoy applying these aspects of the practice in our committee work for INTA.

What advice do you give to people just starting their careers?
I advise people just starting out to get out from behind their desks and meet other professionals and prospective clients. They should be asking lots of questions to find out what their peers are doing, what prospective clients’ needs are, what issues the profession or the business owners are facing. And most important, my advice is to listen to the answers so you can become a trusted advisor.

What’s your favorite trademark?
This is a tough question because there are so many good marks out there. But I will have to go with the Dallas Cowboys BLUE STAR. I’ve been a fan since the days of Roger Staubach, Tony Dorsett and when Tom Landry was their coach, and the brand recognition of their BLUE STAR has always amazed me, whether you love them or hate them.

What do you do when not practicing law?
When I am not practicing law, I am trying to spend as much time as I can with my wife and four children. In my spare time I do like to run, go to the gym, play softball and golf.

Assuming Responsibility for a Trademark Portfolio
This Practitioners’ Checklist is intended to provide basic guidance and a list of “things to remember” when a practitioner assumes responsibility for an existing trademark portfolio previously managed by others.

Visit www.inta.org/practitionerschecklists
Get involved with your local trademark community, find a good mentor and work hard!

What’s your favorite trademark?  
CANADA GOOSE

What do you do when not practicing law?  
Enjoy family and friends, climb mountains, go to the ranch and photograph animals—this is my new hobby.

Pro Bono Services Provided by Individuals

Jennifer Mikulina, McDermott Will & Emery LLP, USA

What (or who) led you to practice trademark law?  
My college honors thesis focused on the economic impact on certain types of international intellectual property protection, and I learned a lot about the different categories of intellectual property. I was drawn to the issues that arose in trademark law and the focus on protecting consumers from confusion. I also really enjoy learning about new products (and their brands) before they launch!

What (in addition to your colleagues) is the best thing about working in the trademark field?  
The long-term relationships that I have developed with clients and my network of trademark counsel around the world are the best things about working in the trademark field.

What advice do you give to people just starting their careers?  
It is important to realize that there are niche practices that you may not realize exist when you are in school—take on a variety of opportunities and work for as many people as possible. You can learn something from everyone.

A working life without challenges could be very long and boring.

What’s your favorite trademark?  
One of my clients has a great slogan: LISTEN. THINK. SPEAK. It’s short, simple and such a great message!

What do you do when not practicing law?  
I am involved in a number of boards, including Lawyers for the Creative Arts, Working in the Schools, and Girl Scouts of Greater Chicago and Northwest Indiana. I’m also my daughter’s Brownie Girl Scout leader and a huge Wisconsin Badger football fan!

Pro Bono Services Provided by Organizations

Simmons & Simmons LLP, UK

Simmons & Simmons LLP has a strong culture of corporate responsibility, resulting in wide-ranging pro bono activities. In 2015, the firm expanded the pro bono work they do, and sought to innovate their pro bono delivery, effectively overcoming some of the barriers to performing pro bono in the UK. For example, the firm has fostered partnerships with agencies to provide pro bono legal services to smaller clients that were previously difficult to access.

The Simmons & Simmons IP Group in London is at the forefront of the firm’s pro bono engagement and is particularly active in providing pro bono support for the arts and indigent individuals and groups in the creative field. As a member of the Queen Mary University Legal Advice Centre “Law for the Arts” program, IP lawyers from the firm supervise Queen Mary University law students in providing advice to young artists and designers with their IP-related issues.

Also in the field of the arts, the Simmons & Simmons IP team provided pro bono advice and support to the London Mozart Players, Frieze Art Fairs, the Centre for Recent Drawing and the English National Ballet.

The firm’s IP team has also provided substantial pro bono IP support for a number of environmental organizations, including the Rainforest Foundation, Water and Sanitation for the Urban Poor and Global Action Plan.
2015 Treasurer’s Report

David Lossignol
Novartis Pharma AG, Basel, Switzerland
2015 Treasurer

As I end my term as Treasurer, I am pleased to report that our Association is in sound financial standing. The 2015 budget, adopted by the Board of Directors in Phoenix last November, projected a net loss (total revenue minus total expenses) of $164,500. We expect to end the year with net revenue of more than $500,000.

We maintained a 90 percent membership retention rate in 2015, added 709 new member organizations and now have members in 190 countries around the world. Our primary source of revenue continues to be our Annual Meeting, which consistently accounts for more than 50 percent of our gross revenue. When we prepared the 2015 budget, we assumed that attendance in San Diego would be comparable to our 2012 meeting, which had the greatest attendance until now. I am pleased to report that we exceeded that threshold and hosted just under 9,900 trademark professionals in May. As a result, the Association’s gross revenue for 2015 is expected to be better than budget by approximately $745,000.

Last year at this meeting, 2014 Treasurer Joseph Ferretti (PepsiCo, Inc./Frito-Lay, Inc., USA) explained that we view international city selections for our larger meetings as opportunities to send an important message to current members and potential new members around the globe by improving accessibility to attendees and by demonstrating commitment to those regions in particular. It is important to note that attendance at the TMAP Meeting in Alicante in October was 252 registrants, comparable to our 2012 meeting, which had the greatest attendance until now. I am pleased to report that more than 1,100 volunteers have joined us in Panama this week.

On the expense side of the 2015 ledger, our Association’s staff demonstrated their ability to manage operating expenses, and the forecasted variance of total expenses versus budget is only negative by 2.5 percent. The majority of the incremental expenses were in the area of professional fees, including lobbying, legal, impact study consulting and technology contracting.

As of September 30, 2015, the portfolio balance of the reserve fund was $19.0 million, but well within the guidelines due to recent market volatility, $1.2 million less than when we met at this meeting one year ago. During 2015, the Finance Committee has been diligently monitoring and reviewing performance with our investment advisors at UBS Financial Services. There is an expectation that the overall portfolio will continue to move with the relevant market indices and marginally gain value in the near term.

2016 marks the third year of the 2014–2017 Strategic Plan. In implementing the new strategic plan, the CEO and his executive team developed a detailed roadmap to grow membership, enhance educational offerings through educational events and online resources, further extend public policy and advocacy around the globe and develop staff core competencies, all to solidify our Association’s sustainability. The team is well on its way to accomplish this implementation plan; an update will be provided to the Board of Directors later today.

The 2016 budget will be presented to the Board of Directors today as well. We rolled out the new Membership Dues structure this fall and launched renewal in mid-October. Membership Revenue is budgeted to increase 12.4 percent. For conservative budgeting purposes, we are projecting Annual Meeting attendance will exceed 9,400 participants in Orlando, comparable to our budgeted attendance in San Diego. In addition to the unique programming that will be provided in May, we have an ambitious offering of meetings and other programs scheduled around the globe throughout 2016, including joint programs with AIPPI and ICC/BASCAP. Revenue from our meetings, conferences and other programs next year is expected to generate $13.7 million, an increase of 4.6 percent.

We have plans to expand our legal resources, and public policy and advocacy. Our D.C. office will continue to enhance our presence and effectiveness in Washington, with the addition of two new staff members supplemented by expert lobbying and consulting support. The Congressional Trademark Caucus, which launched during the second half of 2014, will gain even more traction. INTA’s representative offices in China and Europe continue their advocacy, membership development and communications. We will be opening our Asia Pacific office in Singapore during the first quarter. We continue to be well served by our consultants in Geneva and New Delhi. The Unreal Campaign, our anticounterfeiting effort targeted to teenagers, will be rolled out through social media in Latin America, Europe and Asia. Underlying all of these activities is the dedication to grow our membership base globally and consistently enhance our member benefits.

2016 will be an important year for INTA as we execute the third year of the Association’s implementation plan developed to support the 2014–2017 Strategic Plan. As Treasurer, it has been an honor to work with the officers, committee members, the general membership, the staff and the Chief Executive Officer, and I am confident in the continuing progress of our Association.

U.S. State Trademark and Unfair Competition Law

Release 54 of U.S. State Trademark and Unfair Competition Law is now available online exclusively for INTA members interested in U.S. laws. Access profiles for each of the 50 U.S. states and Puerto Rico today!

Visit www.inta.org/unfaircompetition
Association News

Annual Meeting of Members

INTA President J. Scott Evans called the 2015 Annual Meeting of Members to order at 8:30 am on Tuesday, November 17, 2015, at the Panama Megapolis Convention Center in Panama City, Panama.

In the absence of the Secretary, Mr. Evans turned the meeting over to President-Elect, Ronald van Tuijl. Mr. van Tuijl certified that the official notice of the Annual Meeting of Members was mailed on October 14, 2015. Lori Ball moved that the notice of the 2015 Annual Meeting of Members be filed as part of the minutes of the meeting, and Tiffany Trunko seconded the motion. The motion was passed on a voice vote.

Mr. van Tuijl reported that, of the 911 INTA Regular Members, a quorum as defined by Association bylaws was present in person or by proxy. Mr. Evans declared the meeting regularly and lawfully convened and open to transact business. He reported that the minutes of the 2014 Annual Meeting of Members had been published and circulated to the members, and asked for amendments or corrections. There were no such requests. Rick McMurtry moved that the minutes be approved as published, Ms. Ball seconded and the motion passed.

Mr. Evans called on Treasurer David Lossignol to report on the Association’s financial affairs. Mr. Lossignol presented his report. Mr. Evans moved that the report be approved as read, Mr. McMurtry seconded the motion and the motion passed.

Mr. Evans stated that the President’s report on the activities of the Association during the 2015 year would be presented at the Opening Ceremonies of the Annual Meeting on Sunday, May 22, 2016, at 4:00 pm at the Orange County Convention Center in Orlando, Florida.

Mei-lan Stark, Chair of the Nominating Committee, presented the Nominating Committee’s report. Mr. Evans advised that no nominations for these elected offices were made other than those proposed by the Nominating Committee. Ms. Ball moved that a single vote be cast for the Nominating Committee’s slate of candidates for election to the INTA Board of Directors. Mr. McMurtry seconded and the Directors were elected on a voice vote.

Mr. Evans asked if there was any new business and there was none. He asked for a motion to adjourn. Ms. Trunko so moved, Ms. Ball seconded and the motion passed.

Elections for INTA’s Board of Directors, Officers and Counsel

On November 17, 2015, at INTA’s Leadership Meeting in Panama City, Panama, the voting members of the Association elected the following persons for the INTA Board of Directors:

Board of Directors

Term Ending December 31, 2016
Tish Berard, Hearts On Fire Company LLC (USA)
Tiki Dare, Oracle Corporation (USA)
Ayala Deutsch, NBA Properties, Inc. (USA)
Joseph Ferretti, PepsiCo, Inc./Frito-Lay, Inc. (USA)
David Lossignol, Novartis Pharma AG (Switzerland)
Ronald van Tuijl, JT International S.A. (Switzerland)

Nominees for Term Ending December 31, 2018
Susie Arnesen, Sandel, Loje & Partnere (Denmark)
Elisabeth Bradley, Bristol-Myers Squibb Company (USA)
Peter Chalk, Ashurst (Australia)
Gerardo Munoz de Cote, Televista, S.A. de C.V. (Mexico)
Junghoon Kenneth Oh, LG Display Co., Ltd. (S. Korea)
Melissa Rotunno, Blue Cross & Blue Shield Association (USA)
Shunji Sato, TMI Associates (Japan)
Hemant Singh, Inti Advocare (India)
Vanni Volpi, GUCCI (Italy)

Board of Directors Continuing to Serve Term Ending December 31, 2017
Catherine Boudot, Biofarma (France)
Peter Dernbach, Winkler Partners (Taiwan)
Elisabeth Escobar, Marriott International, Inc. (USA)
Elena Grimme, Microsoft Corporation (USA)
Brenda M. Wood Kahari, B.W. KAHARI (Zimbabwe)
Stacey Keller, Citigroup Inc. (USA)
Christy Susman, Jack Daniel’s Properties, Inc. (USA)
Zeeger Vink, Lacoste S.A. (France)
Neil Wilkof, Dr. Eyal Bressler Ltd. (Israel)
Brian J. Winterfeldt, Mayer Brown LLP (USA)

Term Ending December 31, 2016
Lori Ball, Molson Coors Canada (Canada)
Susan Brady Blasco, Muncy, Geissler, Olds & Lowe, PLLC (USA)
Brian Brokate, Gibney Anthony & Flaherty (USA)
Zhen (Katie) Feng, Hogan Lovells (Shanghai) IP Service Co. Ltd. (China)
Jomarie Fredericks, Rotary International (USA)
Cathy Lueders, MasterCard International Incorporated (USA)
Geri Lynn Mankoff-Elias, Kate Spade & Company (USA)
Sheila Henderson, Richemont International Limited (UK)

Officers & Counsel President

President
Ronald van Tuijl, JT International S.A. (Switzerland)

President-Elect
Joseph Ferretti, PepsiCo, Inc./Frito-Lay, Inc. (USA)

Vice President
Tish Berard, Hearts On Fire Company LLC (USA)

Vice President
David Lossignol, Novartis Pharma AG (Switzerland)

Treasurer
Ayala Deutsch, NBA Properties, Inc. (USA)

Secretary
Tiki Dare, Oracle Corporation (USA)

Counsel
Maury Tepper, Tepper & Eyster, PLLC (USA)

Immediate Past President and Ex-Officio
J. Scott Evans, Adobe Systems Incorporated (USA)
Volunteer Spotlight

Joshua Burke

Josh Burke is a person with many passions, including a passion for cereal. Yes, he eats up to three bowls a day! Makes sense since he has been trademark counsel for General Mills for the past 15 years. A sweet benefit of his job is handling the PILLSBURY BAKE-OFF contest. Seeing the priceless look on the million dollar winner’s face is a reward for him, too.

Josh has always had a passion for music and doing puzzles—two not-so-simple passions, though relaxing. By day, he views contract negotiations and disputes as puzzles to be solved. By night (time permitting), he reigns as a bass player in a band. In fact, his bucket list includes being on the road for a week or two performing to crowds who can connect with his art.

Of course, when it comes to INTA, we have all reaped the benefits of Josh’s many talents through years of committee work, including serving on the INTA Board from 2008 to 2010. One of his most recent accomplishments has been to serve as the Co-Chair of the 2015 INTA Annual Meeting. It takes a lot of puzzle solving to bring together 10,000 of your colleagues. In 2016, Josh will be joining the new Building Bridges Committee.

Josh’s evolution as a husband, dad, musician and lawyer has been very much inspired by his parents, who taught him how to find balance in his life. The talented and passionate people he has met through INTA have also been inspiring. He strives to live up to these standards and to pass those same values to his daughter.

Stay tuned for what other “Trix” Josh might have up his sleeve as he continues along in his career and with INTA.

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Trademark Trolls: Here to Stay?

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INTA Bulletin—Features Subcommittee

While the term “patent troll” has entered common parlance in recent years, the term “trademark troll” is less commonly used. However, trademark trolls do exist and can present brand owners with real challenges. This article explains the two main types of trademark trolls, the distinction between a “trademark troll” and a “trademark bully” and discusses examples of each of these. It concludes by providing tips on how to avoid becoming the victim of a troll.

What Is a Trademark Troll?
In the trademark world, a troll is generally understood as one who attempts to register a mark and then demands payment and threatens litigation against unsuspecting companies that have adopted the same or similar marks. There are generally two different classes of people or entities that have been accused of being trademark trolls.

Troll #1: Opportunistic Trademark Registrants
Perhaps most common is the person or entity that doesn’t actually use any trademarks, but opportunistically attempts to register well-known or recently introduced trademarks registered by a different company in other countries, in anticipation of that company eventually wanting to use it in the troll’s country at some point in the future. The troll then “lays in wait” until the other company enters the country and finds its trademarks already registered and therefore unavailable for use without paying the troll a licensing or purchase fee. This is more common in “first to file” countries where use of a mark is not required to register a trademark, and has produced some well-publicized cases in recent years, particularly in China.

For example, as widely reported by IP and mainstream media, French winemaker Castel Frères SAS experienced this when a Chinese court ordered it to stop all sales of its CASTEL brand wines in China and pay over USD 5 million to Li Dao Zhi (Li), a Shanghai company that had registered the name Ka Si Te, the known transliteration of “Castel.” (2012) No. 166 Zhe Xi Zhong (2012). While Castel reportedly entered the Chinese market in 1998, and began selling wine under the name Zhang Yu Ka Si Te in 2001, it did not apply to register its CASTEL mark until 2002. In 2005, it became aware that Li had registered the KA SI TE mark in 2000. Castel filed a request to cancel Li’s registration based on non-use, but during the pendency of the cancellation action, Li began use of the KA SE TI trademark, and Li sued Castel for infringement. The court ultimately ruled in Li’s favor, and Castel found itself in the unenviable position of being labeled an infringer of a mark it had developed more than several decades earlier. Subsequently, however, Castel appealed the case all the way to the Chinese Supreme Court, and earlier this year it was reported that the Supreme Court had suspended the fine and would retry the case. (2013) No. 1405 Min Shen Zi (2013).

Another case in China involved the Tesla Motors family of TESLA marks and logos. In 2009, Zhan Baosheng, a businessman based in Guangzhou and founder of a cosmetics website, registered the TESLA trademark across a range of classes, including cars. Tesla Motors made various offers to purchase the marks, but Mr. Zhan rejected the offers and ultimately demanded a price of USD 32 million, which Tesla rejected. The carmaker sued Mr. Zhan for damages and cancellation of the marks and was initially successful, but Mr. Zhan appealed and sued Tesla for trademark infringement, demanding USD 3.9 million in damages and seeking an order that the company stop all marketing and shut down all showrooms displaying cars with the TESLA marks. (2014) No. 09258 San Zhong Min (Zhi) Chu Zi (2014). In August 2014, the parties entered into a settlement whereby Mr. Zhan would give up his trademark rights while Tesla would drop its compensation demands in return. “Collectively, these actions remove any doubt with respect to Tesla’s undisputed rights in its trademarks in China,” Tesla said. Tesla has also agreed to buy domain names including tesla.cn and teslamotors.cn from Mr. Zhan for an undisclosed purchase price.

Most recently, a Chinese court ordered an affiliate of New Balance Athletic Shoe Inc. to pay nearly USD 16 million to a local businessman for infringing his registered BAI LUN and XIN BAI LUN trademarks by marketing New Balance’s sneakers under the name “Xin Bai Lun” in China. The New Balance affiliate was also ordered to stop using the Xin BAI LUN name to promote products in China. New Balance argued that it needed to use the Xin BAI LUN name as the transliteration or translation of its own Chinese-registered NEW BALANCE trademark, but the court rejected this argument stating that Xin BAI LUN is neither a straight translation nor transliteration of the term New Balance. It is unclear if the company will appeal the ruling. (2013) No. 547 Sui Zhong Fa Zhi Min Chu Zi (2013).

Opportunistic trademark trolling cases are not limited to China. In Scotland, for example, a company named Never Give Up attempted to register at least 34 different juice-related...
Features

marks, including the names of two existing juice bar companies, Juiceling and Juiced Up. During the trademark application stage, Never Give Up was alleged to have threatened the owners of both Juiceling and Juiced Up with legal action and demanded tens of thousands of pounds in licensing fees, despite the fact that Never Give Up’s trademarks had not even passed the application stage and had never been used. A BBC reporter who had heard of the claims went undercover and posed as a representative for Juiceling. During his discussions with Never Give Up, the reporter stated that he was told that the demand for a licensing fee went up from GBP 25,000–30,000 to around GBP 60,000. When later confronted by the reporter, Never Give Up claimed that it never threatened the juice bars with legal action and that its activities were all legitimate. With respect to the JUICED UP trademark, the owner of the Juiced Up bars went on the offensive and successfully opposed Never Give Up’s application for JUICED UP based on prior use and bad faith, and the hearing officer noted that “in all probability [the application was made] with the intention of inducing [the juice bar owner] to part with money to continue use of the name.” What this case demonstrates is that trademark trolls will often attempt to rely on the ignorance of the business owner from whom it is seeking to extract money, in this case by asserting rights in a pending application against businesses which were in fact senior users of the marks in question. It also shows that even small businesses with little-known trademarks are vulnerable to demands from trademark trolls.

Troll #2: Suspect Trademark Users

Another type of trademark troll is one who claims, without adequate foundation, to have actually used a particular trademark and threatens infringement actions or oppositions against any company that uses the mark, even in unrelated areas.

In the United States, where trademark rights are based on use and not registration, there have been several notable examples involving parties claiming broad rights based on alleged prior trademark uses. Perhaps the two most famous instances involve Leo Stoller and Tim Langdell.

Leo Stoller is a name well known to many companies, large and small, that have received his requests for licensing fees based on one of the many marks he registered for a wide variety of goods and services. Mr. Stoller has instigated hundreds of cases in both the U.S. federal courts and the United States Patent and Trademark Office (USPTO), and the convoluted history of his extensive exploits would require a much longer article than this one. A list of the hundreds of Trademark Trial and Appeal Board cases that just one of his companies, Stealth Industries Inc., has been involved in can be found on the TTABVUE, the Trademark Trial and Appeal Board Inquiry System.

One of the primary marks with respect to which Mr. Stoller attempted to enforce his alleged rights was the mark STEALTH. In the Northern District of Illinois alone, Mr. Stoller was involved in at least 47 cases involving trademark infringement, and he was described by that court as “running an industry that produces often spurious, vexatious, and harassing federal litigation.” In case after case, Mr. Stoller was unable to demonstrate legitimate trademark use or infringement, and the Northern District of Illinois not only ordered him or his corporate entities to pay costs and the defendants’ legal fees in several cases, but enjoined him from filing any new civil actions in that court without first obtaining the court’s permission. Moreover, in Central Manufacturing, Inc. v. Brett, 492 F.3d 876 (7th Cir. 2007), the Seventh Circuit affirmed the decision of the Northern District of Illinois that ordered both payment of the defendant’s legal fees as well as the cancellation of 34 of Mr. Stoller’s trademark registrations. It has been argued that the court’s power to order cancellation of a registered trademark (a power it shares with the U.S. Trademark Trial and Appeal Board) should be used more often to deter trademark trolls.

Mr. Stoller eventually went bankrupt, and, in 2007, the bankruptcy court approved an auction and sale under which Stoller’s trademark assets were transferred to the Society for the Prevention of Trademark Abuse, LLC, the sole bidder in the auction, for USD 7,500. Mr. Stoller’s legal struggles continued as he was sentenced to 20 months in prison in November 2014 after entering into a plea agreement relating to federal fraud charges surrounding his bankruptcy filing. He is currently in prison and is scheduled for release in May 2016.

Another example of a well-known trademark litigant with a very convoluted history is Dr. Tim Langdell, CEO and founder of Edge Games. Dr. Langdell has been involved in numerous attempts to enforce the EDGE trademark against other companies using marks with the term Edge in them, most notably in the video game industry. In one notable case involving Edge Games, Future Publishing, the publishers of Edge video gaming magazine, brought suit in the United Kingdom against Dr. Langdell for copyright infringement, passing off and other claims. Future Publishing Limited v The Edge Interactive Media Inc & Others [2011] EWHC 1489 (Ch). In that case, which Edge Games lost, the judge described much of the evidence presented by Dr. Langdell as proof of trademark use of the EDGE mark as being fabricated and unconvincing.

In one instance, Dr. Langdell claimed he created the logo for Edge magazine in 1991, two years before the magazine launched in 1993, and produced a floppy disc containing the logo which his expert asserted dated back to 1991. Future Publishing’s expert then showed that the logo was created using Windows 95 software, which did not even exist in 1991.

Despite Dr. Langdell’s loss in this suit and the cancellation of his EDGE registrations in the United States, he has continued to press claims based on his alleged common law rights in the EDGE trademark, including filing opposition and cancellation proceedings against various EDGE marks in the USPTO even after his registrations were canceled.

“Trademark Bullies” or Legitimate Enforcement?

A variation on the concept of the trademark troll is the company with a well-known trademark that attempts to assert its rights more widely than is warranted by its registrations or prior use. In such cases, well-established businesses have been accused of acting like “trademark bullies” when the company in question has attempted to enforce its trademark rights more broadly than is warranted by its registrations or prior use. Of course, in many cases, what is one person’s overreaching may be another person’s legitimate enforcement. Moreover, the assertion of tarnishment claims by owners of famous marks against unrelated products may lead the recipient of such claims to believe that the owner is overreaching as well.
Trademark Trolls: Here to Stay? Continued from page 11

Trademark filing service, Trademarkia, made news a few years ago by publishing a list of what it terms the “top trademark bullies,” based on the number of trademark oppositions filed in the USPTO. However, the number of oppositions filed may just reflect aggressive but legitimate enforcement, and even Trademarkia acknowledged that this metric does not necessarily define which company is or is not a trademark bully. Indeed, companies have an obligation to police their rights, and often rely on strong enforcement of their trademark rights to discourage third parties that would otherwise be tempted to piggyback or infringe on their rights.

Various websites, such as www.lumendatabase.org, have also sprung up which focus on alleged trademark bullies. Some of these sites post cease and desist letters from companies in an attempt to expose aggressive litigation tactics used against small businesses, which may not have the time, resources or expertise to fight back against large corporations’ claims of infringement. Social media and blogs are also being used to generate publicity regarding aggressive trademark enforcement tactics.

In 2010, pursuant to the Trademark Technical and Conforming Amendment Act, the U.S. Department of Commerce (DOC) was required to issue a report on the extent to which small businesses may be harmed by litigation tactics used “to enforce trademark rights beyond a reasonable interpretation of the scope of the rights granted to the trademark owner.” After receiving public comments on both sides of the issue, the report was published by the DOC in 2011. The report concluded that “it is unclear whether small businesses are disproportionately harmed by enforcement tactics that are based on an unreasonable interpretation of the scope of an owner’s rights.” The report stated that abusive tactics are best addressed by existing safeguards in the litigation system (including awarding attorney fees in the case of frivolous litigation and imposing sanctions under Rule 11 of the Federal Rules of Civil Procedure) and recommended enhancing education (such as continuing legal education programs), increasing outreach by federal agencies to help small businesses get the resources they need to deal with trademark issues and engaging the private sector to provide support in the form of low-cost or free legal advice such as pro bono programs and educational clinics.

Banish the Troll
How can one avoid falling prey to a trademark troll? First and foremost, one should file trademark applications as early as possible, not only in the countries in which one currently does business or manufactures or sources products, but in any countries in which expansion is feasible in the future. Filing transliterations of one’s marks in the local language, as well as logos, is also key. In addition, it is important to establish watch services or conduct trademark searches to identify potential trolls at an early stage. Updating the search periodically and scanning local media for references to the mark will help trademark owners keep abreast of local developments. Furthermore, keeping good records of one’s trademark use will come handy should a conflict arise and it is necessary to show early legitimate use of a mark. Moreover, keeping all emails and notes of verbal communications with trolls can be critical when trying to demonstrate to a court or other decision-maker the troll’s bad faith. Finally, if possible, it is advisable to set aside a litigation fund if one is operating in an industry and geographic territory where trolling is more likely to happen.

While it is often impossible to predict when one may become the victim of trolling activity, it pays to be aware of, and prepare for, the possibility that one will have to deal with a troll in the future. Rather than just saying “we will cross that bridge when we get to it,” only to find a troll blocking the way, trademark owners are well advised to act ahead of time to protect their interests.

Discovery: Understand the rules and overcome the challenges

Avoid discovery delays by drafting properly worded discovery requests directed at information relevant to the issues in dispute. See “Discovery Requests in Trademark Cases Under U.S. Law” in INTA’s Practitioners’ Checklists series for an outline of topics to help you create an individualized discovery checklist.

Visit www.inta.org/discoveryrequests
ARGENTINA  MARLBORO Succeeds in Opposition against MELBOUR

Division I of the Civil and Commercial Federal Court of Appeals of the city of Buenos Aires confirmed the lower court’s decision in Espert S.A. v. Philip Morris Products S.A. on July 16, 2015. That decision admitted an opposition filed by the defendant, owner of the marks MARLBORO and MARLBORO & design in International Class 34, against trademark applications for MELBOUR & design and MELBOUR FILTER CIGARETTES FULL FLAVOR 19 & design in the same class.

Espert (the plaintiff) filed a complaint pointing out that the intense use of its mark MELBOUR & design demonstrated it had acquired de facto rights in the local market. Espert argued that its company, which started doing business in 2002, had 120 employees and had acquired 12 percent of the domestic cigarette market since its foundation. The plaintiff also stated that the lack of confusion between the marks was supported by the fact that the defendant (Philip Morris) had withdrawn an opposition filed against its prior trademark application for MELBOURNE & design in the same class. Moreover, Espert cited a court decision of Division II of the same Court of Appeals (Philip Morris Products S.A. v. Medidas Cautelares (Preliminary Injunction) (Nov. 16, 2006)) that ruled that MARLBORO’s notoriety did away with any confusion. This decision further highlighted that the challenged words MELBOUR and MELBOURNE brought to mind an important city and port of Australia, therefore denying the injunction.

Philip Morris argued that it was the largest private cigarette company in the world founded in 1847, doing business in more than 160 countries. The company said that in 1924, it introduced into the market its most famous mark, MARLBORO, which it claimed was confusingly similar to MELBOUR. Philip Morris also claimed that it had opposed the plaintiff’s mark from the beginning, as it was a slavish imitation.

The Court of First Instance rejected the complaint on the grounds that the confronted marks were confusingly similar fantasy words. On appeal, the Federal Court of Appeals held that notoriety required two elements: (i) broad knowledge of the sign (to be known by all the public and not only by the purchaser of the relevant market), and (ii) the spontaneous association made by people between the sign and the product.

The appeals court said that MARLBORO was a prestigious and globally renowned mark that was synonymous cigarettes and involved a classic case of obvious notoriety that extended beyond cigarette consumers. It further stated that MELBOUR brought to mind the opponent mark MARLBORO and could cause confusion, since they both protected identical products that were sold in the same stores. Finally, the appeals court said that although MARLBORO’s notoriety could in principle do away with the confusion with MELBOUR, it was not reasonable to choose a mark with no meaning, compounded with a design and colors almost identical to the opponent mark to distinguish locally manufactured cigarettes.

The case highlights the conditions that a mark requires to be considered notorious as well as the protection granted to such marks by Argentine courts.

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EUROPEAN UNION  KRISPY KREME DOUGHNUTS CTM Upheld

On October 7, 2015, the General Court of the European Union adopted a judgment in the long-running dispute among Panrico SA, the Office for Harmonization in the Internal Market (OHIM) and HDN Development Corp. The outcome is that the KRISPY KREME DOUGHNUTS figurative mark is registered as a Community trade mark (CTM). (Panrico, SA v. OHIM–HDN Development Corp., Case T-534/13, GC, Oct. 7, 2015).

The case has a long history. In 1999, HDN, an American company, applied to register the figurative mark KRISPY KREME DOUGH-NUTS as a CTM in Classes 30 and 42. The application was opposed by Panrico, the holder of earlier Spanish registrations for DOGHNUTS [note: the standard English spelling would be “doughnut”] and DONUT in Class 30. In 2005, the OHIM Opposition Division dismissed the opposition on the basis of no likelihood of confusion and that the contested mark did not take unfair advantage of the earlier marks. Panrico appealed, but the OHIM First Board of Appeal dismissed its appeal. The KRISPY KREME DOUGHNUTS mark was registered in 2007.

In January 2008, Panrico filed to invalidate the registration, relying not only on its two earlier verbal marks, DOGHNUTS and DONUT, but also on the figurative mark DONUTS. The OHIM Cancellation Division rejected the invalidation, finding there was no likelihood of confusion and that the contested mark did not take unfair advantage of the earlier marks. Panrico appealed, but the OHIM Fourth Board of Appeal dismissed on the basis that the conflicted trade marks were visually dissimilar and the slight phonetic similarity between the signs could not create likelihood of confusion. Similarly, the Board of Appeal held that the signs at issue did not have a sufficient similarity for Article 8(5) of Regulation No. 40/94, concerning a mark with reputation, to apply.

Panrico appealed to the General Court, requesting annulment of the decision and invalidation of the HDN mark. In an earlier “doughnut” case, the Court of Justice of the European Union had found that BIMBO DOUGHNUTS was confusingly similar to Panrico’s earlier DOGHNUTS mark (Bimbo SA v. OHIM–Panrico SA, Case C-591/12 P, 8 May 2014; reported in the INTA Trademark Reporter). Here, however, the General Court found that, when analyzed as a whole, the marks were dissimilar visually and conceptually, and that the KRISPY KREME DOUGHNUTS mark did not take unfair advantage of the earlier marks, notwithstanding the reputation of these earlier marks. In reaching this conclusion, the court particularly took into account the additional elements KRISPY KREME at the beginning of the contested mark and that, where Class 30 products were concerned, the public would usually perceive the mark visually before making the purchase decision.

The General Court upheld the Board of Appeal’s decision and dismissed the appeal.

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SINT MAARTEN  BIP Now Handling Trademark Matters

The Bureau for Intellectual Property Sint Maarten (BIP Sint Maarten) announced on October 1, 2015, that it will now handle its own trademark matters for the jurisdiction locally. The office, located in Philipsburg, opened online on October 5, 2015, in cooperation with the Benelux Office for Intellectual Property (BOIP).

When the Netherlands Antilles ceased to exist in 2010, all Netherlands Antilles trademark registrations were automatically converted into two separate registrations in the newly independent jurisdictions of Curacao and Sint Maarten. For the last five years, trademark owners desiring protection in these jurisdictions have needed to register their marks independently in both jurisdictions as opposed to making a single filing as had been past practice. Since the changes of 2010 and up until now, the Bureau for Intellectual Property Curacao (BIP Curacao) has managed all trademark matters for both Curacao and Sint Maarten. This may be surprising, as Curacao is in the southernmost part of the Caribbean—only 40 miles off the coast of Venezuela while Sint Maarten lies farther north—close to Anguilla, St. Kitts and the British and U.S. Virgin Islands. The primary reason that BIP Curacao initially handled trademark matters for both jurisdictions is that it was fully equipped to do so, having formally been the BIP for the Netherlands Antilles. In the interim, the BIP Sint Maarten has been preparing to take over control as the entity handling trademark filings for the country. As the BIP Sint Maarten is now fully operational, the BIP Curacao will not process any requests regarding Sint Maarten received on or after October 1, 2015.

UNITED STATES  Slippery Mistake Leads to Dismissal of an Opposition

In Warren Distribution, Inc. v. Royal Purple, LLC, 115 USPQ2d 1667 (TTAB 2015) [precedential], the USPTO’s Trademark Trial and Appeal Board (TTAB) dismissed a Notice of Opposition for lack of subject-matter jurisdiction. The subject application, registration of the mark HMX for motor oil, published on December 3, 2013. A 30-day request for an extension of time to oppose was filed by Jennifer Wehrman in her individual name. Warren Distribution Inc. (WDI) filed a Notice of Opposition within the extension of the opposition period granted to Ms. Wehrman, identifying WDI as the opposer. Ms. Wehrman was an employee of WDI, but was not an owner or a manager of WDI. The applicant argued that WDI was not the same entity to whom the extension of time was granted. WDI argued that it was in privity with Ms. Wehrman and that Ms. Wehrman was misidentified through mistake, as Rule 2.102(b) sets forth two disjunctive conditions under which an opposer may claim the benefit of an extension of time granted to another named entity: privity and identification by mistake.

In trademarks, the concept of privity, however, generally includes the relationship of successive owners of a mark. WDI argued that Ms. Wehrman and WDI were in privity because Ms. Wehrman was an employee of WDI, was authorized to file the extension request and used her business contact information in the request. However, the TTAB found that it has long been recognized that privity between a person and a corporation does not exist because the person is employed by the corporation.

As to the alleged misidentification by mistake, the TTAB explained that “misidentified through a mistake” refers to a mistake in the form of the potential opposer’s name or its entity type, not naming a different legal entity that is not in privity with the party that should have been named. WDI attempted to argue that Ms. Wehrman intended to file the request on behalf of WDI, but instead innocently entered her own name. However, the request clearly identified Ms. Wehrman, an individual, who is a different existing legal entity from WDI. WDI could therefore not claim the benefit of the extension of time granted to Ms. Wehrman.

The motion to dismiss the opposition was therefore granted. The case demonstrates the importance of identifying the exact party requesting the extension of time to oppose to avoid a dismissal of the opposition.

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<td>March 15–16</td>
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