INTA's Board of Directors held its second meeting of the year yesterday, and tackled a wide range of issues affecting the Association and members. Some of the highlights were:

- A focus group was held in the afternoon to obtain the Board's feedback on the 2018-2021 Strategic Plan. This complements the engagement with various stakeholders including those outside of the IP community to further the Association’s goal of building bridges. Focus groups are also being held in Orlando to obtain feedback from a diverse group of members.
- An overview of the nominations process was presented and available on inta.org under Membership and Committees/Committee Participation. Nominations for 2017 officers and Board of Directors can be submitted through the Nominations Portal on the INTA website until June 3, 2016. In addition to seeking diversity of leadership, the Nominating Committee’s suggested criteria for Board nominations includes a depth of knowledge in trademark law; appreciation of the issues facing INTA; commitment to INTA by regular meeting attendance, timely completion of substantive tasks and demonstration of strong leadership qualities in order to be role models for other INTA volunteers. Under the revised Bylaws, the Nominating Committee (see box) has the discretion to nominate up to three Advisory Directors for election by the Board of Directors as non-voting members of the Board appointed for a one-year term. Advisory Directors are meant to be non-members of the Association, whose special expertise may be needed for certain issues being considered by the Board.
- INTA's Code of Policies: The Board approved a revised draft of this important code, which supplements INTA’s recently revised Bylaws. Both Bylaws and the Code are available on the INTA website.
- 2016 In-House Counsel Presidential Task Force Co-Chairs Jacqueline Leimer and Andrea Klein provided an update on their Task Force, “The Role and Position of In-houseTrademark Professionals.” The Task Force will submit a final report and recommendations later this year.
- The Programming Advisory Council’s proposal for 2017 educational events was outlined.

**Strategic Plan**

The Planning Committee wants to build upon the existing Strategic Plan and be as inclusive and forward thinking as possible when drafting the next Strategic Plan in order for INTA to: continue to be the leading advocate for the interests of brand owners; increase consumer protection; build bridges within and outside the IP community; and explore the nexus between brands and innovation.

With this in mind the Planning Committee has started to obtain feedback not only from INTA members and staff, but also from individuals from other IP organizations and individuals from non-IP organizations, such as business school professors, CEOs, marketing and consumer experts, media professionals and legislators.

The Planning Committee is also taking advantage of the Annual Meeting to obtain feedback from a diverse group of INTA members as part of the strategic planning process. The idea is to collect the feedback from these various constituencies by early summer so that the Planning Committee can begin its analysis and the drafting process from June to September of this year.

The intent is to finalize the Strategic Plan in March 2017 so that the communication of the 2018-2021 Strategic Plan can be rolled out in May 2017.

Read an interview with INTA’s CEO Etienne Sanz de Acedo on pages 6-7.
Speakers shared their wisdom about dealing with different cultures in the “Cultural Intelligence for Trademark Lawyers Today—A Soft Skill Often Underestimated” session yesterday.

Philippe Bhering of Bhering Advogados in Brazil noted that trademark practitioners should help clients get up to speed on other cultures. “Trademarks do bridge the gap between different cultures but so do trademark practitioners,” he said. “It is very important for them to know how the local market is.”

Mark David McVicar of Winkler Partners in Taiwan gave an example of being sensitive to a particular country’s norms. A pharmaceutical company with a major drug brand was concerned about websites referring to it generically. In a survey of 100 hospitals and clinics in Taiwan, 50 of them were referring to the brand generically on their websites. “It was a classic case of genericide,” said McVicar.

His firm had to draft a letter that was culturally appropriate. This needed a “subtle juggling” of cultural factors to please the client who wanted to protect its brand, the local company that wanted to protect relationships with the hospitals and clinics, and the clinics themselves because “we didn’t want to scare them off.” The form letter thanked them for their use of brand but also asked them to make sure their use conformed to the client’s trademark use. After the letter was sent out the percentage of websites referring to the brand generically rose from 50% to 70% and then, after another round of letters, to 90%.

“The key was that on the back of the letter was an attached picture of their website, very specifically saying ‘please change this to this.’ That made it very easy for the clinic to follow. So we made sure the trademark was being used correctly and in the end everyone was happy.”

In addition, McVicar noted that “even in areas where you think they are homogeneous there are always differences.” He gave one example where a client had agreed on a trademark name for underwear in China and Taiwan, only to be told by the Hong Kong office that it absolutely could not be used, despite all three countries speaking Chinese.

Meeting in person also highlights differences in culture that can be interpreted badly. Moderator Alison Tan of The Procter & Gamble Company in the U.S. said that eye contact in Asia is considered rude or confrontational whereas in the U.S. it is considered rude not to look someone in the eye. “After 11 years in the U.S. I can now look people in the eyes!” she reported.

Stephen Jiew of Al Tamimi & Company in the United Arab Emirates noted it can very difficult to interpret social cues or be rude without realizing. “You could offend a senior person by, for example, presenting your business card to a junior person first. It can also be quite tricky trying to ascertain the true hierarchy of a firm.” Some clues may come from age and job title but Jiew warned: “Tread very carefully.”

Mythra Hurtado Rivas of Novartis Pharma in Switzerland also participated. You can also go too far in attempting to conform to other cultures. “It is a delicate line between trying to be respectful and overly ingratiating yourself for a business purpose—it exposes you as a phony,” said Jiew.
Pro bono work is becoming more popular among legal practitioners across the globe, as practitioners look to try something different than regular chargeable work, reach outside their comfort zone and give back. But it raises many challenges in practice, such as: How can you set up a sustainable and effective pro bono program? Are there laws or issues in your or other jurisdictions that you need to know about?

These were some of the points discussed in a session titled ‘For the Global Good: A How-to Guide for Pro Bono IP Work Around the World’ yesterday, which was moderated by Rose Hickman Rigole of Strategy IP. The panelists provided an overview of the legal framework in their countries, the level of pro bono work, and their firms’ pro bono initiatives. Referral work can come from networking with clients, colleagues in other jurisdictions, legal charities and NGOs. PILnet and TrustLaw were two networks mentioned.

The panelists advised having the right resources, management and expertise in your firm to set up or take on pro bono work. There are many ways to do this. “Start small,” David Aylen of Gowling WLG said enthusiastically. “You may crash due to lack of commitment if you take on a huge project. Look for ones that encourage team building or are educational in nature and slowly build it up,” he added. Employee engagement is the key, according to Eugene Low of Hogan Lovells. Julia Hopf of Spoor & Fisher also participated.

Low said junior lawyers, for example, should be allowed to take ownership of the project. “Find out what they are interested in, and it doesn’t necessarily have to be in IP,” he said. Formalize the initiative, develop a pro bono policy, and manage client expectations. Registrants also learned of resources to help with implementing programs. For example, INTA has resources such as the Pro Bono Toolkit and Pro Bono Resource Guide on its website.

Aside from prioritizing fee-paying work, legal practitioners can also find that it is not straightforward to take on pro bono work due to regulatory issues. This is particularly true for foreign-qualified lawyers in countries such as Russia, Japan and China. However, Aylen said this does not hinder such lawyers utilizing their skills in society. Interestingly, he also said that the tax authorities in Russia consider pro bono work as taxable, but he hopes this will cease to be the case soon.

Speakers agreed that their clients do not mind that they engage in pro bono work, provided it does not affect their other work. Some clients may well have corporate social responsibility initiatives in which they are happy to get your help. “Our clients even ask us about the pro bono work we have done each year,” said Aylen.

Trademark administrators exchanged tips on best practices and career development at a workshop yesterday.
In a session yesterday, panelists demonstrated how trademark practitioners—particularly litigators—can use big data and analytics tools to grow their practices, provide fact-based predictions to clients and streamline the legal research process. Daniel Lewis of Ravel Law, Ian C. Ballon of Greenberg Traurig, Darren Schleicher of Lex Machina and Alex Butler of Bloomberg BNA contributed the perspectives of both data analysts and litigators.

Massive databases such as PACER and LexisNexis catalogue comprehensive records and statistics of cases, but this volume of information can be unwieldy, requiring practitioners and their teams to spend many hours combing through records to manually find and analyze relevant data. However, harnessing this information through analytics tools can be useful at every stage of a case.

As attorneys and law firm business developers formulate strategies to grow their businesses, data can provide insights into “who are these companies using, who has a good track record, who has a good track record, then drill down into the actual cases and dockets that are interesting to see changes trends over time,” said Butler. In-house counsel, he said, can also use this data to guide their choice of outside counsel, based on the past performances of firms handling matters similar to what they expect to encounter.

Data allows attorneys to demonstrate their expertise on various judges and venues, with specific regard to the client’s industry and the nature of the case at hand. Instead of providing anecdotal descriptions about the speed of a venue, or their personal impression of a judge, data gives attorneys an opportunity to prove that they know what they are talking about. Lex Machina, a legal analytics company owned by LexisNexis, provides features such as a timeline predictor which, depending on the stipulations a user enters, will return visualizations for the average duration of a case of the specified nature.

Even a specific judge’s decisions have become far more predictable through data analytics. Lewis said that the tool analyzes patterns of language used by judges, so that litigators can see “what's resonated with the judge before, and how can you tailor your argument to grab them.”

This and other insights accessible through analytics could theoretically be mined manually, but that process is made far more efficient through technological tools. These facts still require interpretation, but analytics tools are “exploratory”: they should not be seen as “replacing human reasoning, but as supplementing it with data,” said Lewis.
INTA registered its branch office in Singapore in March. This reflects the Association’s “increased engagement” in the Asia-Pacific region, particularly with IP offices, enforcement agencies and the judiciary, according to Asia-Pacific Chief Representative Seth Hays.

The new office is, says Hays, “geographically in the middle of the region” that stretches from Australia and New Zealand in the south to Japan and South Korea in the north. Singapore is also a self-proclaimed IP Hub, hosting local offices for ICANN, Interpol and WIPO. INTA’s office in Shanghai, which has existed for more than 10 years, will continue to focus on mainland China.

Hays says “policy advocacy” is a big part of his role in Asia-Pacific. One focus of this is the new ASEAN Economic Community, comprising 10 countries in southeast Asia. “IP is a big part of that, and INTA is working with organizations, including the ASEAN IP Association and the ASEAN Working Group on IP Cooperation, to help develop the IP community here in southeast Asia,” he adds.

While INTA brings the perspective of its global membership in promoting harmonization of trademark law and practice, it is also working to help local businesses (95% of whom are SMEs) to develop and internationalize their trademark portfolios, says Hays: “We aim to contribute to the body of knowledge on the importance of trademarks and make more people aware of that.”

On World IP Day in April this year, for example, INTA organized an education panel focusing on protection for SMEs at the Lao PDR World IP Day Fair. And during the coming year, the Association plans to commission research on the economic impact of trademark-intensive industries in the region. “Whether you are a developing or a developed country, there is an immediate value to protecting trademarks,” says Hays.

The new office also comes as major political developments are underway. Many countries in the region are signatories to the Trans-Pacific Partnership, while the Regional Comprehensive Partnership, while relations with IP offices have also been developing; INTA has signed Memorandums of Understanding with the IPOPHL, IPO, HKIPD, KIPO and China’s SAIC, and this year the Annual Meeting welcomes representatives of the offices of Australia, China, Japan, Lao PDR, New Zealand, Singapore, South Korea and the Philippines. The Honorable Yasuhito Okinaka, a judge from the Tokyo District Court, is taking part in today’s session on Free Speech and Trademark Law.

Engagement with the judiciary, as well as with IP offices and enforcement agencies such as Customs, is one of Hays’s priorities: INTA recently filed an amicus brief before the Supreme Court of The Philippines and more amicus filings are likely to follow. There are also likely to be more events hosted in the region following the two held in Singapore earlier this year—a seminar on designs (jointly with AIPPI) and a workshop on the roles of intermediaries in enforcing IP rights (in association with BASCAP).

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As asked about his priorities for INTA, Chief Executive Officer Etienne Sanz de Acedo picks out two themes: “becoming truly global” and “engaging as many constituencies as possible”. They’re topics that are evident in this year’s Annual Meeting and other INTA activities, and both are likely to feed into the process of drafting the next three-year Strategic Plan, which is now well underway.

Thinking globally
Registrants at this year’s Annual Meeting will notice that there is a continued emphasis on broad ranging topics covering multiple jurisdictions and engaging various stakeholders. There are Users’ Meetings hosted by WIPO, the EUIPO, JPO and USPTO, and on Monday registrants can meet IP offices and IP attaches in a special open house session, expected to feature representatives from Canada, the Cayman Islands, Denmark, Georgia, Ghana, Japan, Namibia, the United Kingdom, the U.S. and Vietnam.

On the same day, for the first time there will be parallel receptions for registrants from diverse regions: India, Africa, Asia-Pacific, Latin America and Middle East (the latter two are both new this year). “We know registrants find these meetings very rewarding and they are always well attended, so we are pleased to be able to expand them,” says Sanz de Acedo, who joined INTA in 2013 and is taking part in his third Annual Meeting as CEO.

The past year has also seen greater emphasis on INTA activities around the world. Last year’s Leadership Meeting was held in Panama City, the first time it has taken place outside of the United States. “Panama is a country which has a very important role to play in IP, and this was a great opportunity to raise the importance of IP in high level meetings with officials at ministerial level,” says Sanz de Acedo. INTA has also held well-attended meetings in Singapore and Rome in the past year, as well as in New York, and has sent delegations to China and India. Later this year, it will hold its first event in many years in Africa—a region to which Sanz de Acedo says INTA will be “paying more and more attention.”

But globalization is not just about one-off events. It is a permanent effort to visit countries, meet members, recruit local corporations and interact with officials and legislators. This year, INTA opened a branch office covering Asia-Pacific in Singapore, and has plans to open a similar office in Latin America. Sanz de Acedo says having such offices “means a lot to our members globally and to officials.” INTA also recently jointly organized (with IPEC, IMPI, ASIPI and BASCAP) a workshop on enforcement in Latin America attended by representatives of 12 national offices; this will be repeated annually and one of the concrete achievements already has been the creation of a repository of information on IP enforcement.

Engaging new constituencies
As well as reaching out to new regions, though, INTA is also seeking out new constituencies and aiming to build bridges between the global trademark community and organizations and individuals not directly involved in IP—be they officials, judges, academics, consumer associations or politicians. Sanz de Acedo says he is “very pleased” to see how the Congressional Trademark Caucus in the United States is working, for example: it has had three briefings in the past year, there are 19 members of Congress involved and Senator Grassley made a memorable speech at a recent event to mark World IP Day.

Also important is working alongside other IP associations, something that has been effective notably in the
advocacy on the EU trademark reform package, from which he believes lessons can be learned: “Did the associations work well together? Yes they did. Could they work better? Yes they can.” This type of engagement is also evident in the Association’s efforts in the U.S. to collaborate with other IP associations via the U.S. IP Associations Coalition. Since 2015, INTA has been taking part in meetings with leadership of the American Intellectual Property Law Association (AIPLA), the ABA Section on Intellectual Property Law and the Intellectual Property Owners Association (IPO) to strengthen the voice of trademark owners and users in the United States.

In terms of non-IP constituencies, the Association’s Building Bridges Committee, created as part of the new committee structure announced in 2016, is dedicated to the task of identifying key issues and creating new relationships. The committee focuses on developing long-term trust with non-trademark groups worldwide in order to expand INTA’s reach.

“We need to engage with non-IP professionals—marketing people, consumer associations, the younger generation, economists, and so on—ask them what they think about IP, and listen to them,” says Sanz de Acedo. This is particularly important with respect to non-IP constituencies, the general public and legislators. “Lawmakers need to understand the positive contributions of IP to innovation, GDP growth and employment,” he says, adding: “Protecting brands is protecting our economies.”

Holding events dedicated to specific topics—such as geographical indications, designs, or sports—is one way to bridge some of the divides that exist, says Sanz de Acedo. In March, INTA held its first Brands and Sports Conference in New York. The event’s 242 registrants heard from speakers across many sectors, including sports leagues and sports governing bodies in both the United States and abroad, licensing companies, private practitioners, consumer products, entertainment companies and government agencies. “We will take a similar approach with our upcoming conferences in Africa and Europe. We need to bring people, including non-IP professionals, to the table. Are they all going to agree? Maybe not, but at least let’s try to talk to each other,” says Sanz de Acedo.

Towards the new Strategic Plan
The emphasis on looking beyond traditional borders is also apparent in the process now underway to draft INTA’s Strategic Plan 2018-2021. Sanz de Acedo says the Association has already reached out to members, staff, organizations such as WIPO, the TMS and non-IP constituencies, as part of a process that will take another year to be completed: “We want to have as much input as possible,” he says. “INTA’s role is to advocate and provide networking opportunities, but also project into the future. We need to be thinking about what the next trend will be and how it will affect the IP industry.”

In particular, he stresses the importance of speaking to consumers and young people—who will be the consumers of the future. “As lawyers, sometimes we spend too much time discussing the wording, when what is important is the meaning behind the words. We need to bring more factual evidence and be more engaging, and this is an area where perhaps we can do a better job.”

Profile Etienne Sanz de Acedo

Etienne’s Annual Meeting
As well as speaking at today’s Opening Ceremony and at a number of other receptions during the coming week, Etienne Sanz de Acedo says he hopes to attend as many educational sessions as possible—though other commitments do not allow him to attend as many as he would like.

Other than that, he is looking forward to meeting INTA members and government officials and in particular to interacting with Past Presidents. “We owe them great respect for what they’ve done, I think they have a great deal to offer, and I like to talk to them about where we’re going,” he says. Another meeting he hopes to attend is today’s Trademark Administrators’ Brunch, which he describes as “always a very rewarding event.”
Feature Asia and Africa

The big issues in Asia and Africa

James Nurton preview some of this week’s sessions on trademark issues in Asia and Africa, and introduces related INTA events.

A panel at the Annual Meeting tomorrow will focus on anticounterfeiting strategies in southeast Asia and Africa. “These are two massive regions, so we can’t cover everything—but we hope to provide the audience with key strategies and pointers for these important areas,” says Lara Kayode, of O Kayode & Company in Nigeria, who is moderating the session.

She emphasizes the importance for brand owners of looking at different means to tackle counterfeiting. For example, in some countries, regulatory legislation may be more up-to-date and enforcement agencies better resourced than police or the courts. “Going to the Regulatory Body to attack counterfeiters may be the best option in some cases,” says Kayode. Regulatory bodies may also be better able to deal with issues such as relabelling or forging date codes or authorization certificates.

One of the speakers on the panel is Kingsley Ejiofor, of the National Agency for Food and Drug Administration and Control (NAFDAC) in Nigeria. Speaking to the INTA Daily News, he acknowledged that “the incidence of counterfeiting in Africa is higher than in developed countries” but said that agencies such as NAFDAC are making progress: “There have been eight or nine cases in the federal courts in Nigeria recently. One resulted in a five-year imprisonment. Another led to a seven-year sentence.”

He elaborated on how agencies can go about combating the problem, giving the example of a case in which one criminal and he was in tears when he realized the implications of what he had done. But he added that effective enforcement will require much bigger fines to be issued, to reflect the scale of the gains that counterfeiters make.

Another speaker on the panel, William Mansfield of ABRO Industries, Inc will bring first-hand perspective from a U.S. company that sells a lot of products in Africa, while Nick Redfearn of Rouse & Co International has the task of providing an overview of developments and strategies throughout southeast Asia.

Kayode says that the biggest targets for counterfeiters include western brands in the food and fashion industries, electrical goods and car parts, as well as pharmaceuticals: counterfeit malaria and asthma medicines are often discovered. But she adds that one emerging trend is the counterfeiting of African fashions, which are going through a Renaissance in Africa: hollandais fabric (pictured) is a particular target of overseas counterfeiters.

Asked what brand owners can do to improve enforcement, Ejiofor emphasizes sharing information and collaborating with agencies, helping with training of judicial officers and promoting technology such as authentication services to sort genuine from fake products. For overseas investors in Africa, Kayode warns against working with distributors who you don’t know well, and ensuring you do due diligence on local partners: “Before you start working with distributors, do your homework—just like you would anywhere else.”

CM21 Anticounterfeiting Strategies in South East Asia and Africa takes place tomorrow 11:45 am to 1:00 pm

Advertising laws in Africa

Another session tomorrow will look at how advertising laws impact brand owners in Asia’s large consumer markets, with speakers from China, India, South Korea, Japan and the United States. These markets—which span several billion people—have growing middle classes that are becoming increasingly sophisticated consumers. One result is that advertising laws and regulations are tightening up. Specific issues due to be addressed include the recently revised Chinese Advertising Law, comparative advertising, the role of trademark law and how advertising is treated in the digital and analogue spheres. Speakers will also give examples of recent case studies in each jurisdiction.

During the panel there will be discussion of specific industry sectors, including tobacco, alcohol, medication, educational services, financial investment services and advertising targeting minors, and examples of specific cultural taboos in certain jurisdictions.

RM20 Regional Update: Asian Powerhouses—Buy, Buy, Buy—How Advertising Laws Impact Brand Owners in the Large Consumer Markets of Asia takes place tomorrow from 11:45 am to 1:00 pm.

Reaching out in Asia

The past few months have seen lots of INTA activity throughout Asia. In November last year, INTA held an Anticounterfeiting Policy Dialogue on Customs Practices in Putrajaya, Malaysia. INTA was also represented at the ASEAN IPA Annual Meeting in Kuala Lumpur, Malaysia in March this year, which was attended by government officials and practitioners from throughout the region.

Singapore hosted INTA’s Designs Conference in February, which was organized jointly with AIPPI, followed by an INTA-BASCAP Workshop in Intermediaries and Rights Holders—Working Together to Stop Counterfeiting and Piracy. For more details and to register, please visit the INTA registration desk or inta.org/2016 Asia

INTA/AIPPI Designs Conference

“Building Africa with Brands”, IN TA’s first conference to be held in Africa for 20 years, will take place in Cape Town, South Africa from September 15 to 22, 2016. It will be preceded by the INTA-BASCAP Workshop: Intermediaries and Rights Holders—Working Together to Stop Counterfeiting and Piracy. For more details and to register, please visit the INTA registration desk or inta.org/2016 Africa

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What does your day-to-day role entail?
I’m director and assistant general counsel of IP and privacy. On a day-to-day basis I manage the OFFICE DEPOT and OFFICEMAX trademark portfolios. I work with outside counsel to make sure all the renewals are done, I work with our private brand team as well as e-commerce and other business groups to clear trademarks for use in advertising, packaging, print materials and brochures. I review product packaging. I also do some agreement reviewing of IP provisions in contracts and the general due diligence work relating to trademarks.

That’s the trademark hat. Then I also have the privacy hat.

What are some of the overlaps between trademark and the privacy side?
There are issues that overlap. Ultimately, if there is a data breach your brand is at issue. Your customers and your employee data is at issue but fundamentally it really affects your brand. That’s why I think it is important for trademark attorneys to understand the privacy side a bit more.

The main issue is how to control the damage to your brand if you have a data breach. If you have a well-planned security program and privacy program in place at your corporation then you are going to be much more likely to be able to handle things more easily and potentially on a more expedited basis, and in turn reduce the risk and damage to your brand.

How many trademarks do you manage?
Well over 1,000 by the time you add in the global portfolio. We have business operations throughout the world in Europe, Australia and New Zealand, Asia and Canada.

What are the biggest challenges in your role?
One of the biggest challenges when I started was that the company had just gone through the Office Depot/OfficeMax merger [the merger was completed in November 2013]. So it was trying to figure out what the portfolio actually consisted of and then working with the private brand team to understand how we were going to use the OFFICE DEPOT marks in conjunction with or without the OFFICEMAX marks.

Not only did I have one portfolio, but a second as well, and it was a new portfolio for the company as a whole. There was not anybody here who could provide any historical knowledge or usage relating to the marks. So that was something I had to get up to speed on relatively quickly.

“The main issue is how to control the damage to your brand if you have a data breach.”

Katherine Tabor, assistant general counsel at Office Depot in Boca Raton, Florida, discusses why trademarks and privacy are increasingly overlapping and points to the biggest challenges in her role.

Why trademark attorneys should respect privacy

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Not only did I have one portfolio, but a second as well, and it was a new portfolio for the company as a whole. There was not anybody here who could provide any historical knowledge or usage relating to the marks. So that was something I had to get up to speed on relatively quickly.

“The main issue is how to control the damage to your brand if you have a data breach.”

Katherine Tabor, assistant general counsel at Office Depot in Boca Raton, Florida, discusses why trademarks and privacy are increasingly overlapping and points to the biggest challenges in her role.
On a day-to-day basis, it is really keeping track of everything, because there are some days when I get multiple requests for trademark searches and clearance work. The deadlines with much of the work I do are really tight, so that seems to be one of the biggest challenges I have.

What are the trademark issues that are specific to your industry?
For any company that has a website there are always issues relating to unauthorized people setting up websites that use your name. There are still a lot of internet related issues that we have to deal with.

Tell me a little bit about the team? What do you use the outside counsel for?
I am the team. I do have a paralegal and there is a second paralegal who has worked on intellectual property matters in the past. But for day-to-day matters there is really only two of us. It is a small team, so we are very busy. We do things in house but, because there are only two of us, we tend to use outside counsel more for trademark searches and renewals and also to assist with foreign matters.

How much do you deal with international matters?
Quite a bit. I am responsible for the trademark portfolio globally so I play a part when there are new marks that need to be cleared in Europe, domain names that need to be registered, or if we find out that a third party is using one of our trademarks in a store in another country, or online on a country-specific website. I generally work with the business people and we do have counsel in most of our foreign countries.

“One of the biggest challenges when I started was that the company had just gone through the Office Depot/OfficeMax merger.”

Interview Office Depot

www.managingip.com
Well-known trademarks in China

Samiko Sun and Gloria Q Wu of Kangxin Partners discuss well-known trademark protection in China, and explain how to obtain these powerful rights.

What does well-known trade mark status mean? What’s the difference between the protection offered by a well-known trade mark and a normal one?

Samiko Sun: The well-known trademark status means that the mark has acquired high reputation and influence among the public through extensive and continuous use, and it has been recognized as a well-known trademark by the relevant public, based on which a broader scope of protection could be given on a case-by-case basis.

A well-known trademark is offered a broader scope of protection, which is not limited to the designated goods and services covered by the registration. It means that the protection for a well-known mark could be extended to the non-similar goods and services; even though, sometimes, the gap among the goods and services is large, the well-known mark would also be protected to prevent the possible dilution of the well-known mark.

However, the extent of such extended scope may depend on the degree of the well-known status as well as the distinctiveness of the mark.

What factors are considered in determining well-known trademark status?

Samiko Sun: The following factors are the keys when determining the well-known trademarks:

- Time of registration: though theoretically an unregistered well-known trademark is also possible, it is extremely rare in practice. It is generally considered that a well-known mark should be registered in China for at least two years prior to the filing date of the opposed or canceled mark.

- Length, geographic coverage and volume of use: It is generally considered that a well-known mark should be used in China for at least five years prior to the filing date of the opposed or canceled mark. Such use shall cover at least 10 provinces, and the sales volume should be large based on specific industry.

- The degree of similarity between the subject mark and the opposed mark should be high.

- The designated goods/services of the two parties should be “dissimilar” according to the Chinese Classifications, but “connected”, so that there is likelihood of “misleading”; only very well-known marks may enjoy the protection based on dilution.

Are there any other significant issues that have arisen following the changes?

Gloria Wu: In some recent opposition cases since late 2015, where the opponent’s earlier cited mark is similar to the opposed mark, the goods are dissimilar according to the Chinese Classification of Goods and Services but are connected to some extent, such as Class 24 (bed sheets) and Class 25 (clothing), and the cited mark has enjoyed certain reputation but not yet reached the standard of well-known mark, the TMO held that the opposed mark shall be rejected according to Article 10.1.7 of the China Trademark Law, “signs deceptive, and may easily mislead the public with regards to quality and other features of the goods”.

This Article 10.1.7 used to be only applied in cases where the mark is inherently deceptive instead of relative ground involving conflict with earlier rights. Though the criteria of applying Article 10.1.7 in such relative ground oppositions is not clear by now, for example the required extent of reputation and extent of connection of the goods, it is nevertheless a favorable change for many foreign brand owners whose trademarks are copied by others in different but related classes and the evidence of prior use and reputation is not sufficient to establish well-known trademark in China.

It is also worth noticing that in some earlier opposition cases, TMO occasionally used Article 10.1.8 (signs detrimental to social morality or having other negative influence) in relative ground as described above, where as the TRAB and the courts made it very clear that Article 10.1.8 can only be applied in absolute grounds where the mark itself has inherent negative meaning and cannot be applied in relative grounds where conflict of rights exists. Nowadays, the TMO seems to follow the same rule and stop using Article 10.1.8 in relative grounds as well.

Another significant change is according to Article 14.5 of China Trademark Law, producers and dealers shall not use the words “well-known trademark” on their goods and the packages or containers of their goods or for the advertisements, exhibitions, and other commercial activities. According to Article 53, where a party violates the provision of Article 14.5, the local administrative authority for industry and commerce shall order the party to rectify the situation and impose a fine of ¥100,000 (~$15,500). The purpose is to prevent the misuse of well-known trademark as a kind of government award or guarantee of quality which would mislead the consumers.

What suggestions do you have for an international company that is seeking to obtain well-known trade marks in China?

Gloria Wu: Firstly, better management of evidence is always important, whether or not for the purpose of obtaining recognition of well-known trademark, as the sufficiency of evidence especially related to use and reputation of the mark in China for each year in each region and on each type of products or services is always a core factor affecting the chances of success of the case. The brand owner could discuss with a trademark attorney to form an efficient way of sharing and collecting evidence on a regular basis, and if the brand owner has any branch office or distributor in China, the way of collaborating among the parties. The reason for doing so is that the time limit for submitting evidence in trademark cases is usually no more than three months from filing the action (such as opposition, invalidation), which sounds quite long, but in fact, when some evidence needs to be notarized and legalized, some need affidavit from certain person, some need audit report issued by qualified auditors for a certain year, three months may be too short to complete all the work. Therefore, a mechanism of regular maintenance of a well-categorized evidence database by the trademark attorney for the brand owner is very important and has great value.

Secondly, as the recognition of the well-known trademark is on a case-by-case basis, it is possible that one mark is recognized as well-known trademark in one case, but fails in another, and the reason might be that the filing date of the opposed/disputed mark is different and thus the period of required use evidence differs.

What else to do if a right holder cannot obtain well-known status?

Gloria Wu: Defensive applications in other related or even unrelated classes of goods/services would be an economic and efficient method, as compared to filing oppositions against endless new marks of others. Besides, even for the classes of existing registrations or applications, it is sensible to double check the subclasses covered to see whether the protection scope is sufficient according to the Chinese examination criteria.

One risk related to defensive applications is the
possibility of non-use cancellation, i.e. after three years of registration, if anyone files non-use cancellation against such trademark, the registrant need to submit use evidence, otherwise, the trademark might be cancelled then.

Another possible option is copyright protection, especially over the device mark or the complete logo including word and device or the word mark in stylized form.

The protection of copyright is not limited to any specific class of goods or services, which is a big benefit of such type of right, but the threshold of similarity is normally higher than that between trademarks. Similar to many other countries, copyright recordal is not mandatory in China, but the recordal certificate can serve as a prima facie evidence if the recordal date is earlier than the trademark filing date. If the recordal date is later than the filing date of the opposed/disputed trademark, the owner then needs to provide additional evidence to prove the ownership of the copyright (such as agreement with designer, original manuscript), as well as the accessibility of the works before the filing date of the mark (such as publication of the copyright on magazines distributed in China, or publication via the Internet).

In case one trademark has been registered for over five years, any invalidation against it needs to be based on the ground of well-known trademark and bad faith claim, i.e. the cited mark had been well-known in China before the filing date of the disputed mark, and the registrant of the disputed mark filed this mark in bad faith, or absolute grounds. If neither of these grounds can be based, one may need to wait for three years to file the non-use cancellation, or try other ways such as negotiation of assignment with the registrant. At the same time, the use of the same or similar mark over the same or similar goods without authorization of the registrant may face the risk of infringement. Though the possible infringement litigation could be suspended upon request to the court based on a pending invalidation against the trademark registration cited as ground in the infringement proceeding, the legal risk is still high and damages might be claimed if the registrant obtains sufficient evidence.

Copyright recordal is not mandatory in China, but the recordal certificate can serve as a prima facie evidence if the recordal date is earlier than the trademark filing date.

Samiko Sun

Samiko Sun obtained her Bachelor of Science degree in Information System and Management from the Beijing Technology and Science University in 2007 and her Masters degree in IP Management from National University of Singapore in 2009.

Ms Sun joined Kangxin in 2010 and started her career as a trademark attorney. Her main areas of practice are in the fields of trademark, copyright, domain names and Customs. Ms Sun has considerable experience in trademark prosecution, including trademark application, opposition, recordal of trademark assignment, recordal of trademark license agreement, and Customs recordal of registered trademark, domain name registration and dispute resolution, as well as copyright recordal.

Gloria Q Wu

Gloria Wu graduated from Beijing Foreign Studies University, School of Law in 2005, and joined Kangxin in the same year and started her IP practice.

Ms Wu has assisted brand owners from all over the world in devising and implementing tailored strategies for trademark protection in China, with regard to both prosecution and litigation. She is also experienced in dealing with cases involving different types of IP rights, such as trademarks, copyright, design patents and domain names. Based on her deep knowledge and extensive experience of trademark practice, she provides proactive, insightful advice to clients who encounter complicated trademark disputes in China, and helps them to resolve their problems successfully and efficiently.

Ms Wu has been recognized for her expertise in the trademark field (both prosecution and contentious) by Chambers and Partners and World Trademark Review, and is consistently ranked among the top IP professionals in China.

Ms Wu is also active in IP transaction and licensing area. She has successfully assisted her clients in monetization of IP assets through various ways and also provided legal services such as drafting and reviewing agreements, due diligence during the process.

She has also authored many articles in both Chinese and international journals and has been frequently consulted and interviewed by legal media to give comments and opinion in relation to latest influential trademark cases or other new development in legal system in China. She is also an active speaker and moderator at international conferences and seminars, sharing her knowledge and experience of IP practice in China with audiences from all over the world.

Ms Wu is a member of the Legislation and Regulation Committee of INTA, and is also a member of the China Trademark Association Development Committee.
Pre-Annual Meeting receptions

The following cities hosted receptions prior to the Annual Meeting this year:

Amsterdam, Netherlands
Simmons & Simmons

Vienna, Austria
Schwarz Schönherr Rechtsanwälte

Rio de Janeiro, Brazil
Di Blasi Parente & Associados

Beijing, China
Unitalen

Bogotá, Colombia
Wolf Mendez Abogados Asociados
Bogotá, Colombia Cavelier Abogados (pictured bottom)

New Delhi, India
Mrs. Prathiba M. Singh

Lagos, Nigeria
Jackson, Etiti & Edu

Paris, France
Simmons & Simmons

Warsaw, Poland
Lazewski Depo & Partners and POLSERVICE

Mосcow, Russia
Gowling WLG

Pretoria, South Africa
Spoor & Fisher

Stockholm, Sweden
Groth & Co

Istanbul, Turkey
GÜN + PARTNERS

Los Angeles, CA, USA
Hanson Bridgett LLP

San Francisco, CA, USA
Harvey Siskind LLP

New York, NY, USA
INTA Zurich, Switzerland BrandIT
What is the most important trademark/IP issue for you at the moment?

Tracy L. Garner, Schneider Electric, Lexington, Kentucky, U.S. The ease of finding counterfeit goods on the Internet. E-commerce service providers have to step it up and work with companies against counterfeiters.

Sangeeta Chavan, Mumbai, India. The length of time it takes to get court decisions in India is something that worries brand owners. It can take four to five years. The government needs to appoint more judges who are knowledgeable about IP.

Dr. Maurice Batanga, OAPI, Yaoundé, Cameroon. Trying to get OAPI member states to introduce IP into economic policy, but also to seriously implement the policies.

Zsófia Fulajtár, Bérczes, Budapest, Hungary. It will be interesting to see how the goods in transit provision in the EU will work in practice, considering the countries bordering Hungary. Anticounterfeiting programs may be difficult to implement because the situation is so different in each, especially with non-EU countries.

Daniel E. Brunetti Marcos, Avalos Brunetti, Asunción, Paraguay. Only about 5% of cases are related to IP in Paraguay, so it’s important to hear the perspectives of attorneys from other countries at INTA, so we can make a case in Paraguay for having judges specialized in IP.

Gilbert Leong, Rodyk, Singapore. Enforcement on the Internet. Not just availability of counterfeit goods on e-commerce sites but also peer-to-peer file sharing. On the plus side, securitization of IP is a big thing right now in Singapore.

Nadya Djajadiningrat, HarvesPat, Jawa Barat, Indonesia. The backlog. The system is very slow. The standard time required for a mark to be registered is two years, but in practice it’s more like three to four years. We lack the resources to speed things up, although there is a law in Parliament that should shorten the timeline for registering trademarks.

Naqueeab Nawab, Zeus IP, New Delhi, India. The recent abandonment of trademark applications by the India Trademark Office. Backlog has always been a problem, but the Office is working on streamlining the administrative process, including online filing.

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Stefano Klausner, Grogorj, Milan, Italy. In Italy, a brand owner is required to reply to every item seized by the Customs Office, and attorneys can be brought to court by police to testify, proving through their expertise that a product is counterfeit.

Nadia Alvarez Mainegra, Claim SA, Havana, Cuba. We have seen a fivefold increase in trademark filings in Cuba in the past year. The ease in relationship between the U.S. and Cuba could mean the number of filings from the U.S. will increase further and allow more U.S. brand owners to fully use their marks in Cuba.

M. Yawar Irfan Khan, United Trademark & Patent Services, Dubai, UAE. The biggest issue for brand owners is the Trademark Office official fees in the UAE, which are very high. I wish the authorities would review the decision to increase them.

We don’t just practice Mexican IP Law.

We help shape it.

In an uncertain legal environment, we are one law firm that is not content simply to accept the status quo. We work constantly to influence the evolving body of Mexico’s intellectual property laws, with the goal of ultimately bringing them in line with international standards. While we continue to make great strides in this regard, clients from all over the world rely on us to prosecute, manage, and defend their IP portfolios under the laws that exist today. In other words, we work effectively within the system, even as we seek to change it.

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Today’s Schedule | Sunday, May 22, 2016
All events take place at the Orange County Convention Center (OCCC) unless otherwise indicated.

<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Location</th>
</tr>
</thead>
<tbody>
<tr>
<td>7:30 am - 7:00 pm</td>
<td>Registration</td>
<td>West Hall E</td>
</tr>
<tr>
<td>7:30 am - 7:00 pm</td>
<td>Hospitality</td>
<td>West Hall D</td>
</tr>
<tr>
<td>7:30 am - 7:00 pm</td>
<td>Information Desk</td>
<td>West D Lobby</td>
</tr>
<tr>
<td>7:30 am - 7:00 pm</td>
<td>Exhibition/Press Registration Desk</td>
<td>West D Lobby</td>
</tr>
<tr>
<td>7:30 am - 7:00 pm</td>
<td>Networking Excursion Desk</td>
<td>West Hall E Lobby</td>
</tr>
<tr>
<td>8:00 am - 10:00 am</td>
<td>Continental Breakfast</td>
<td>West Hall D</td>
</tr>
<tr>
<td>8:00 am - 12:00 pm</td>
<td>Soccer Tournament</td>
<td>Offsite</td>
</tr>
<tr>
<td>8:00 am - 12:00 pm</td>
<td>Course on International Trademark Law and Practice Breakfast</td>
<td>W331 - G</td>
</tr>
<tr>
<td>8:00 am - 4:00 pm</td>
<td>Advanced Mediation Training: Guiding the Parties to and Through an Effective Mediation - Day 2</td>
<td>W331 - E</td>
</tr>
<tr>
<td>8:00 am - 5:00 pm</td>
<td>Strategic Plan Focus Group</td>
<td>W223 - A</td>
</tr>
<tr>
<td>9:00 am - 11:00 am</td>
<td>BREAKFAST TABLE TOPICS</td>
<td>W240</td>
</tr>
<tr>
<td>10:00 am - 2:00 pm</td>
<td>Aliens and Wildlife Adventure Tour</td>
<td>Offsite</td>
</tr>
<tr>
<td>11:00 am - 1:00 pm</td>
<td>Judges Workshop: Trademarks Beyond Borders—A Discussion with IP Judges on Hot Topics in Trademark Law (Exclusive to IP Judges)</td>
<td>Tangerine Ballroom West Hall F - 4</td>
</tr>
<tr>
<td>11:00 am - 2:00 pm</td>
<td>Madrid System Users’ Meeting (MSUM) Organized by World Intellectual Property Organization (WIPO)</td>
<td>W315 - A</td>
</tr>
<tr>
<td>11:30 am - 13:00 pm</td>
<td>China Trademark Association Sponsored Panel</td>
<td>Sunburst Room - W340 - B</td>
</tr>
<tr>
<td>12:00 pm - 2:00 pm</td>
<td>LUNCHEON TABLE TOPICS</td>
<td>W240</td>
</tr>
<tr>
<td>2:00 pm - 4:00 pm</td>
<td>Exhibition Hall</td>
<td>West Hall D</td>
</tr>
<tr>
<td>2:00 pm - 3:00 pm</td>
<td>SPEED NETWORKING</td>
<td>West Hall D</td>
</tr>
<tr>
<td>2:00 pm - 3:15 pm</td>
<td>CSU20 What Do You Do When a Copyright Issue Lands on Your Desk? (Intermediate Level)</td>
<td>Tangerine Ballroom West Hall F - 2</td>
</tr>
<tr>
<td>2:00 pm - 3:15 pm</td>
<td>CSU21 Mediation Level: A Real-Life Mediation Experience (Advanced to Intermediate Level)</td>
<td>Sunburst Room - W340 - B</td>
</tr>
<tr>
<td>2:00 pm - 3:15 pm</td>
<td>CSU22 Followship: An Essential Element of Leadership</td>
<td>W314</td>
</tr>
<tr>
<td>2:00 pm - 3:15 pm</td>
<td>CSU23 Opportunities and Challenges of Being an Adjunct Professor (organized by Adjunct Professor Subcommittee; open to all) Advanced Level</td>
<td>Tangerine Ballroom West Hall F - 3</td>
</tr>
<tr>
<td>2:30 pm - 3:45 pm</td>
<td>Free Speech and Trademark Law: A Survey of Recent and Relevant Cases from the United States, Japan and Norway Concerning Speech, Expression and Trademark Protection</td>
<td>W230 - C</td>
</tr>
<tr>
<td>3:00 pm - 4:00 pm</td>
<td>USPTO Users’ Meeting: News and Updates from the United States Patent and Trademark Office</td>
<td>W230 - D</td>
</tr>
<tr>
<td>4:00 pm - 5:30 pm</td>
<td>Opening Ceremony and Keynote Address</td>
<td>Chapin Theater</td>
</tr>
<tr>
<td>5:30 pm - 7:30 pm</td>
<td>Welcome Reception Orlando</td>
<td>West Hall C</td>
</tr>
</tbody>
</table>

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