Working the World Stage of IP

Joe Ferretti, Vice-President & Chief Counsel, Global Trademarks for PepsiCo, Inc. and 2017 INTA President, is tackling the challenges of representing trademark owners worldwide. He talks to Ed Conlon about his work so far.

It is a difficult job being a brand owner, and it is not about to get any easier.

The global impact of counterfeit goods is expected to reach $991 billion by 2022, according to a 2017 report prepared for INTA and Business Action to Stop Counterfeiting and Piracy (BASCAP).

The picture is unsettling and the trends are heading in the wrong direction. Those who claim that the transaction of counterfeit products is a victimless crime should refer to the report’s estimate of job losses due to infringement: 5.4 million by 2022.

To tackle this global problem, brand owners—and indeed all IP stakeholders—need to collaborate and to coordinate their efforts. INTA is dedicated to protecting the rights of brand owners worldwide and to facilitating this collaboration on a global scale. Joe Ferretti (PepsiCo Inc., USA) is the latest to take on the role of INTA President, and he is very keen to maintain its core strategy of fighting against infringing activity in all four corners of the planet.

“The role is a tremendous experience; I feel honored to represent the membership of INTA. It’s a lot of work, but in my short time in the role, I’ve gained insight into how much the organization does on a daily basis around the globe. We work on policy proposals, advise on legislation, and generally help to improve the protection of trademark rights worldwide.”

eBay: In Search of Balance

Julien Dudouit, Global Brand Manager at eBay, spoke to Ed Conlon about the platform’s approach to fake goods.

When someone outbids you on eBay, it can be mildly annoying. But winning at auction, paying a good price and having the product delivered to your door, only to find you have been duped and bought a counterfeit good, is even more irritating.

Behind the scenes at eBay, the company is working hard to stamp out this type of behavior, but the e-commerce platform faces a constant battle against counterfeiters.

“Everything can be counterfeited—I can’t point to a specific product,” says Julien Dudouit, Global Brand Manager at eBay, when asked about the most commonly counterfeited goods on the platform.
Meet the Co-Chairs

Jomarie Fredericks and Slobodan Petosевич are the Co-Chairs of this year’s Annual Meeting. They sat down with Naomi Jeffreys to discuss what to look forward to in Barcelona.

Being given the role of Co-Chair of the INTA Annual Meeting is certainly an honor.

One of the two people picked for the job this year, Jomarie Fredericks (Rotary International, USA), says “a lot of trust is being placed in us by INTA.”

“It’s something that we took very seriously and we’ve really tried to bring our expertise, our knowledge, our connections to people in the industry, and our organizational skills to the task,” she says.

“It’s been a long process, but a fruitful and rewarding one, and to be able to see everything come together at the Annual Meeting in May in Barcelona is going to be incredibly rewarding.”

Ms. Fredericks and her Co-Chair, Slobodan Petosевич (Petosевич, Luxembourg) have been overseeing the planning for the INTA Annual Meeting since October 2015. Discussing what registrants can expect from this year’s meeting, Ms. Fredericks says: “The venue, the Fira Gran Via Convention Center, is a very versatile facility and there’s lots of meeting space available.”

Mr. Petosевич agrees. “Put very simply, there has never been an INTA Annual Meeting like this; with respect to the venue alone, it’s going to be different from anything we’ve seen so far.”

A Varied Program

The sessions featured in this year’s meeting promise to be topical, varied, and interesting for registrants.

“The topics will be divided into sections and include those that traditionally are very well attended, such as the current U.S. case law updates,” Mr. Petosевич explains.

“A European update will also be provided because there are so many things happening there, including Brexit. It’s certainly going to be very interesting,” he adds.

“We’re going to follow the milestone cases that have happened over the last year,” he says, “which is without question a key reason people will be attending the meeting.

“There will also be sessions related to customs issues, mediation, anti-bribery, and all kinds of strategies for in-house and outside counsel, and anticyberfeiting.”

Ms. Fredericks adds that there will be several sessions focused on social media.

“There are so many new and innovative things that are happening online today and trademark practitioners need to adapt to new online brand protection challenges,” she says.

“The issue of social media may explain why the Annual Meeting has dedicated a bit more time to copyright issues,” Mr. Petosевич adds.

“Today, if you’re discussing protection of brands and your IP rights on social media, it’s nearly impossible to go around copyright law.”

Lunch and Learn

Another highlight of this year’s Annual Meeting is the introduction of the Lunch and Learn sessions, which are new this year.

Speakers include Gerd Leonhard, a “futurist,” and business consultant Paul Birch.

“INTA wanted to provide the opportunity for people to have lunch and use that period in a practical way,” Mr. Petosевич explains.

These sessions are designed to help registrants broaden their thinking and navigate organizational change.

Registrants certainly have new and exciting sessions to attend this year.

“This Annual Meeting will be something we will remember for many years in the future,” Mr. Petosевич concludes.
eBay: In Search of Balance (continued)

Despite this challenge, as well as the “proactive” nature of criminals and the fact that counterfeits are increasing in quality and price, Mr. Dudouit says the number of counterfeit goods sold on eBay is a small fraction of the overall daily sales.

To keep this fraction small, eBay invests a lot of time and resources in combating fake goods on its site.

“Counterfeits are not welcome on eBay,” says Mr. Dudouit. “We have worked for 20 years to ensure a safe platform to trade, using a combination of sophisticated tools, enforcement, and strong relationships with brand owners, law enforcement, and retailers to come together to fight counterfeits.”

“We want to create a strong shopping experience for consumers.”

One of the central pillars in eBay’s anticounterfeiting strategy is the Verified Rights Owner Program, launched in 1998. It allows right owners to report listings that infringe their rights, with eBay taking subsequent action against the listing and seller where necessary.

“We have more than 45,000 brands in the program, from Fortune Global 500 companies to industry associations and small businesses,” Mr. Dudouit explains.

Underpinning the program’s success are strong relationships with brand owners.

“Partnerships are important as the brands are the experts—they know their products,” he says.

“We need to make sure the brand owners have the tools and knowledge to efficiently report infringing items on the platform, so we do anything we can on our side to detect counterfeits.”

After all, notes Mr. Dudouit, while eBay wants to protect consumers and make the platform a safe place to trade, the company itself is a valuable brand and has first-hand experience of having to protect its rights worldwide.

eBay also has a dedicated team working with law enforcement to bring down sellers of fake goods.

According to Mr. Dudouit, one of the best examples of collaboration against counterfeiters is a memorandum of understanding (MoU) signed in 2011 between the European Commission and a host of companies, including eBay, Burberry, Adidas, and Amazon.

“The MoU allows brands to communicate and share information about trends that they and platforms are seeing. It opens the communications channel.

“It’s a very collaborative approach to finding practical solutions to IP enforcement, and we believe it has been very beneficial for all parties involved.”

Along with relationships with third parties, eBay seeks to educate its community about counterfeits by encouraging brands to create profiles where people can view the IP rights that the companies own.

“We have found education to be critical,” Mr. Dudouit says.

Fighting on the Front Line

With all the work being done to fight counterfeit goods, it is too much responsibility being heaped on online intermediaries such as eBay, which are often on the front line?

“It is not a responsibility, it’s the right thing to do; it’s something we care about,” says Mr. Dudouit.

The difficulty of being caught in the middle has manifested itself through litigation in the past, with eBay being targeted over liability for fake products. In its 2017 Annual Report, filed with the U.S. Securities and Exchange Commission, the company discusses the problem in more detail.

“In a number of circumstances, third parties, including government regulators and law enforcement officials, have alleged that our services aid and abet violations of certain laws, including laws regarding the sale of counterfeit items, laws restricting or prohibiting the transferability (and by extension, the resale) of digital goods (e.g., event tickets, books, music and software), the fencing of stolen goods, selective distribution channel laws, customs laws, distance selling laws, anti-scalping laws with respect to the resale of tickets, and the sale of items outside of the United States that are regulated by U.S. export controls.”

The report goes on to say that in Turkey, local prosecutors and courts are investigating eBay’s liability for allegedly illegal actions by users of the company’s Turkish marketplace, GittiGidiyor.

“In accordance with local law and custom, they have indicted one or more members of the board of directors of our local Turkish subsidiary. We intend to defend vigorously against any such actions and a growing number of these cases have been dismissed by the relevant courts.”

The filing also notes that Tiffany & Co, Rolex, Louis Vuitton, and Christian Dior, in an effort to protect their rights, are just some of the brands to have either threatened or filed litigation against eBay over IP infringement, including counterfeit items, and the company has paid “substantial amounts in connection with resolving certain trademark and copyright suits.”

For now, while courts remain split over who should be held responsible when it comes to online counterfeits, it seems both brands and companies such as eBay are sometimes stuck between a rock and a hard place.

Julien Dudouit’s colleague Louise Delcroix, Head of IP, Asia-Pacific at eBay, will be speaking in CT20 Strategies for Online Brand Protection on Tuesday, from 11:45am to 1:00pm, about the different measures eBay implements to prevent the sale of counterfeit products.
Turkey: New Code Fights the Fakes

Turkey has been singled out as a hub for counterfeit goods, but new legislation will help in the battle against fake products, as Habip Asan, President of the Turkish Patent and Trademark Office, tells Uldduz Larki.

Turkey’s share of global physical counterfeiting amounted to US $1.7 billion in 2016, according to a report by The Global IP Center, an affiliate of the U.S. Chamber of Commerce.

And in an article for WIPR, Oktay Simsek of Destek Patent in Turkey said the counterfeit market in Turkey is “huge.” He added that, geographically, Turkey is at a crossroads between Europe and Asia and “this puts Turkey in a critical position regarding counterfeited goods traffic.”

But Habip Asan, president of the Turkish Patent and Trademark Office, says that Turkish law provides “effective protection to combat counterfeiting.”

The new Industrial Property (IP) Code, which entered into force in January this year, introduces several major changes that are expected to ensure the country establishes a structured legal framework to prevent counterfeiting, he adds.

There are other changes too—for example, more flexibility for nontraditional trademarks. “The requirement for representing signs graphically is abolished and instead it has been added that signs are represented on the register in a manner to determine the clear and precise subject matter of the protection afforded to their proprietor,” says Mr. Asan.

“The letter of consent, through which the owner of an earlier trademark may consent to the registration and use of an identical or similar trademark later filed for the same or similar goods or services, has also been added to the Code. In addition, the period of opposition is reduced to two months from three.”

“The Office now has the authority to invite parties to make a friendly settlement with the new Code, which aims to reduce disputes before they are transferred to court.”

Another change brought by the Code is the requirement for an opponent to submit evidence proving that it genuinely used its trademark for the goods and services relating to the opposition. Mr. Asan explains that this change is aimed at preventing oppositions in bad faith.

“Additionally, legal protection provided for industrial property subject matters was enhanced by adopting measures for effective enforcement of rights and eliminating problems and uncertainties related to the judiciary processes,” he says.

The Fight Against Fakes

With the new Code, the authorities have more advanced tools required to fight counterfeiting.

“Article 163 on the Fast Destruction Procedure now allows judges to order the immediate destruction of infringing goods even before a verdict, as long as certain conditions are fulfilled.”

“Thanks to our inclusive policy that extended to all political spheres and stakeholders, we were able to ratify the Code in much less time than foreseen due to the high level of acceptance by all parties,” he says.

The Need for the New Code

According to Mr. Asan, the earlier Decree Laws contradicted a number of principles outlined in the Turkish Constitutional Law, which put the Decree Laws at risk of being cancelled by the Turkish Constitutional Court.

“This damaged legal predictability in the IP rights field,” he says.

For this reason, it was necessary that the new legislation was passed as quickly as possible.

The Code came with some challenges, however, and Mr. Asan explains that one of the difficulties was that four different legal texts had to be integrated into one Code. This proved to be a real challenge, especially in drafting the common provisions.

The next issue, he explains, was the size of the Code, which could have taken months of discussion at the National Grand Assembly.

“Thanks to our inclusive policy that extended to all political spheres and stakeholders, we were able to ratify the Code in much less time than foreseen due to the high level of acceptance by all parties,” he says.

The new Code, according to Mr. Asan, is designed to ensure compliance with international treaties and EU legislation in order to achieve a contemporary IP system that operates more efficiently and effectively.

This is all in the hope that Turkey will become a more attractive and predictable place for investors—and a less attractive place for counterfeiters.●
INTA has a global footprint, with offices in New York City, New York; Washington, D.C.; Brussels, Belgium; Santiago, Chile; Shanghai, China; and Singapore; and a consultant based in Gurgaon, India. The Santiago office is the most recent addition, having opened earlier this month as part of the Association’s mission to provide local access and knowledge to its members. It is the first INTA office in Latin America and the Caribbean.

“We opened an office in Chile, which highlights that INTA is a truly global organization. Having a presence in Latin America and the Caribbean means we can better address specific issues throughout the region,” he says.

After taking on the role in January, Mr. Ferretti has already chalked up a number of achievements, including engaging with the Indian government.

“We had a delegation in India and we were able to meet with various government officials and practitioners to talk about a host of issues, and that was extremely positive, building on the strong relationship we enjoy in India. We look forward to continuing that,” he says.

Mr. Ferretti also took part in the Association’s successful Brands and Fashion conference in New York in March, and has been working hard to prepare for the Annual Meeting. “We exceeded the 10,000 registrant number in April and are looking forward to a very successful meeting—not only in terms of numbers, but in top-notch programming,” says Mr. Ferretti. “It will be a great time to meet new friends and colleagues, and see some old ones.”

On the Front Line of Protection

Looking forward, Mr. Ferretti is taking a central role on the front line in the continuing battle against threats to brand owners—particularly “brand restrictions.” The term “brand restrictions” encompasses a number of types of legislation and policies, such as plain packaging, standardized packaging, and laws introduced to ban or reduce the use of characters (which are trademarks) on packaging. Across the world, protecting existing rights can remain an obstacle course, but Mr. Ferretti is determined to make those challenges easier to navigate.

“We’ve established a Presidential Task Force to investigate brand restrictions that are being considered, and in a few cases implemented, in countries around the world. It’s a group made up of members who span the globe, which means it has a great global presence. Moreover, the group comprises lawyers who are the highest level thinkers and experts in the field. True trademark rock stars,” he says.

“They are looking at the various implemented or proposed brand restrictions that have been passed in multiple jurisdictions, and at how to create a plan to better improve the situation for trademarks. We look forward to hearing their findings and recommendations at our Board Meeting in September.”

Over the years, he says, INTA has been on top of these issues globally and has taken important positions in court filings, for instance.

“The goal is to look at the trends and determine the things INTA can do proactively to address this issue,” he says. Mr. Ferretti’s attention has been on the organization’s three-year 2018–2021 Strategic Plan, which is due to be revealed at the Annual Meeting in Barcelona. A key theme of the plan is promoting the value of trademarks and brands.

“Practitioners are increasingly working with brands and not just trademark rights, so our attention is going beyond the scope of pure legal protections of trademarks and exploring further how the overall brand is reflective of a company’s products or services.

“It’s not a simple task for Mr. Ferretti, but nobody said the job was going to be easy. Fortunately, PepsiCo is extremely supportive of my role at INTA, and as a big, international brand company, it recognizes the benefits of a strong and vocal international organization on the side of IP owners.

“I was fortunate to be well prepared for the role of President of INTA because PepsiCo is a global company with products in more than 200 jurisdictions around the world. Thus, I was already familiar with various laws and trademark issues in countries globally. My role at PepsiCo has helped me to step right in and provide assistance to the organization,” he adds.

His time at PepsiCo has given Mr. Ferretti the necessary insight to take on the job, but balancing the two roles is not without its difficulties.

“It’s been a very busy year wearing two hats. There is no second place in my priorities; PepsiCo is 1A and INTA is 1B. It’s a busier schedule and I have to work longer hours, but it’s extremely rewarding and I feel privileged to be in this role,” he says.

“PepsiCo has been completely in favor of my role as INTA President. Management has been extremely supportive and I’m lucky to work with such an outstanding team.”

It will take more than Mr. Ferretti alone to tackle the increasing challenges that trademark and brand owners face in an ever-changing landscape. With infringement taking its toll on the global economy, he knows it requires a strong organization and an active membership to rise to the challenge.

“The key message I have for this year’s INTA Annual Meeting is if you’re not involved, get involved.”

Visit the Pro Bono Clearinghouse at the INTA Information Booth!

INTA is proud to announce that it recently launched a pilot program to establish a global Pro Bono Clearinghouse. The purpose of the clearinghouse is to bolster the protection of trademarks by matching eligible individuals and nonprofit organizations needing trademark legal assistance with trademark attorneys prepared and able to assist. The Pro Bono Committee is actively recruiting potential clients to participate in the program.

To learn more about the program while in Barcelona, please visit the Pro Bono Clearinghouse at the Information Booth in the Hall 8 lobby. A member of the committee will be at the booth from 9:00 am to 5:00 pm—and each day of the conference—to answer all of your questions.

If you cannot make it to the booth, but want to learn more or are aware of any individual or nonprofit organization that may be in need of free legal services, please refer them to the Pro Bono Committee website at http://www.inta.org/Membership/Pages/2017_ProBono.aspx.
HARMONIZATION

GCC Trade Mark Law: Finding Consistency Across the Gulf

When will the Gulf Cooperation Council Trade Mark Law be fully implemented? Will it unify the protection and enforcement of trademarks? WIPR puts these questions to two lawyers in the region.

Uniformity across the Gulf Cooperation Council (GCC) is an obvious benefit of the region’s new Trade Mark Law.

“Many brand owners will look at the GCC as one market, and being able to have trademark consistency across the market can be incredibly helpful,” says Rob Deans (Clyde & Co, United Arab Emirates).

The region is no stranger to unifying law—it implemented the GCC Patent Law in 1992 and it also has a long-standing harmonized Customs Law.

Under the new law, which has not yet been implemented across the whole region, consistency comes in two forms: time frames and procedures across the region are now unified; and the substantive provisions of the law are consistent across the GCC states.

Opposition proceedings must now be heard within the relevant trademark office (in Saudi Arabia, previously they were heard before the Board of Grievances, an administrative court), while the deadline for filing an opposition in all member states is 60 days.

In Saudi Arabia, the deadline for filing was 90 days, an “overwhelming and long period,” according to Omar Obeidat (Al Tamimi & Company, United Arab Emirates), but the new deadline is much more acceptable.

He adds: “In states where the law and procedures were quite weak where timelines were usually overlooked and work was lagging with a huge backlog, the trademark office is now sticking to the deadlines and timelines under the GCC Trade Mark Law, as opposed to under national law.”

This also includes grounds of cancellation—although the grounds were fairly typical by international standards in most GCC states, now everything is brought up to a global level across the region, explains Mr. Deans.

Mr. Obeidat says the most important change is the increased cap on penalties for infringement.

While under national law the penalties were “just a slap on the wrist,” now they are acting as real deterrents, he says.

Infringers can encounter a fine of between US $1,365 and US $272,000 and/or imprisonment for between one month and three years for counterfeiting a registered trademark, according to Mr. Deans, who adds that it’s too early to tell whether there could be any difficulties in implementation.

One provision that may prove challenging, however, is the expansion of registrable trademarks to include unconventional marks such as sounds and smells.

Although the United Arab Emirates (UAE) has allowed the filing of all forms of nontraditional trademarks for a number of years, until now there’s been no demand for such marks. Mr. Obeidat, who has been practicing in the region for 14 years, has never received a request for one of these; nor has Mr. Obeidat.

This could all change with the advent of the unifying law.

Kuwait was the first state to adopt the GCC Trade Mark Law in December 2015, followed by Bahrain (May 2016) and Saudi Arabia (September 2016). It’s unclear when the remaining three states in the GCC region—Oman, Qatar, and the UAE—will sign up.

Mr. Deans is optimistic about the law, claiming it has no real disadvantages, but he does suggest two potential improvements that could be made: a provision for serving documents on applicants using a local address, and setting up a central court which can ensure some consistency of decision-making under the new law.

Usually, if someone wants to cancel a trademark registration they would need to serve proceedings on the local agents, but currently under GCC law there is no requirement to provide a local address.

This means that where the mark’s owner is based outside a GCC country, proceedings must be served overseas through the use of diplomatic channels, which can be a lengthy and expensive process, says Mr. Deans.

Kuwait was the first state to adopt the GCC Trade Mark Law in December 2015, followed by Bahrain (May 2016) and Saudi Arabia (September 2016).
Unlike in the European Union, where cases are referred to the Court of Justice of the European Union, there is no fixed court under the GCC Trade Mark Law.

There is, however, an entity called the GCC Commercial Co-operation Committee, which has the ability to interpret provisions of the law—although how that will work in practice is still unclear.

**Fee Increases—Are They Inevitable?**

Within the past decade, all the GCC states have increased their official fees for filing and registering trademarks, says Mr. Obeidat.

In May 2015, the UAE doubled most of its official fees, with some being multiplied by ten.

This means fees in the UAE are higher than those in any other GCC country (at US $3,450); indeed they are the highest in the world, according to Mr. Obeidat.

Mr. Obeidat jokes that there is now no room for the UAE to increase its fees, saying “you can choose between having plastic surgery or registering a trademark in the state,” such is the cost.

Bahrain and Kuwait also increased their fees significantly, to accompany the implementation of the law.

The cost of registering a trademark (from filing through to registration) increased from approximately US $80 to US $1,035, a 13-fold increase, in Kuwait. Bahrain’s fees increased more than five-fold to US $1,725 from US $320, according to Clyde & Co.

**Next Steps**

No news has come out of Oman or the UAE, while Qatar, in Law Number 7 of 2014, has said that the GCC Trade Mark Law will automatically become effective six months after the publication of implementing regulations.

So far, no implementing regulations have been published.

According to Mr. Obeidat, adoption of the law in the three remaining states should take place this year, but nothing has been set in stone.

Mr. Deans agrees, adding that predicting implementation is difficult, but he remains hopeful.

Will an increase in fees be inevitable when Oman, Qatar and the UAE implement the new trademark law?

No, says Mr. Deans, who adds that it’s important to look at the broader economic climate.

As oil prices fall lower than they have been for years, governments will begin to look for revenue in other places—one of these being trademark fees.

“It’s possible that the remaining states will review and increase fees when they implement the law, but this is not inevitable,” he says.

The only option, it seems, is to wait and see.

Many brand owners will look at the GCC as one market, and being able to have trademark consistency across the market can be incredibly helpful.

“Adoption of the law in the three remaining states should take place this year, but nothing has been set in stone.”

We don’t just practice Mexican IP Law.

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Working Together is the Only Way

Chinese Customs officers are assisting trademark owners with trying to stamp out counterfeit goods in a country that still struggles with counterfeiting problems, but brands need to play their part too. Sarah Morgan reports.

A fter years of pressure by its trading partners, China is making a serious effort to rid itself of the stigma of being what many call a “counterfeiting hub.”

In March, China’s State Council released a new policy aimed at cracking down on IP infringement by increasing the fight against the production, distribution and sale of counterfeits. “Any plans at State Council level to crack down on counterfeiting and do a better job in enforcing and protecting IP is a good sign,” says Michael Mangelson, IP Attaché for the U.S. Patent and Trademark Office (USPTO), based in Shanghai.

Although he’s not yet seen anything specific or concrete in terms of measures implemented, Mr. Mangelson is encouraged to see the Council mention new technologies, such as big data, to try to address counterfeiting more effectively.

This topic has also been discussed at the Joint Commission on Commerce and Trade (JCCT), an annual dialogue that discusses trade and commercial issues between the United States and China.

Mr. Mangelson explains that rights holders in China, as in most countries around the world, are often unable to access information about online counterfeiters, making it difficult to enforce offline, but that the use of big data can help solve this problem.

“If the government and e-commerce platforms work more to enable rights holders and enforcement agencies to access and analyze information, it could make enforcement much more effective,” he says.

One such operation is an effort between e-commerce platform Alibaba and China’s Ministry of Public Security, called Operation Cloud Sword. Alibaba’s data engine was used, demonstrating the “role big data will play in the future of intellectual property enforcement actions,” according to Alibaba.

Based on intelligence and leads from the platform, 332 suspects were arrested and fake goods valued at RMB 1.43 billion (US $2.1 billion) were seized. Tom Duke, Senior IP Officer at the British Embassy in Beijing, says that the State Council report doesn’t go into “granular detail” but that there is some continuity year-on-year.

Top priorities include protecting IP online, tackling counterfeit foods that pose safety risks or damage the environment, and looking to make sure rural and agricultural communities are protected from these products, he says. Over the past few years, those working in companies or products that fall under these priority sectors have benefited from these initiatives, he adds.

“It’s definitely worth companies keeping track to see whether there is scope to benefit and also to comply with the goals of the Chinese government,” says Mr. Duke.

To this point, a delegation from the General Administration of Quality Supervision, Inspection and Quarantine (AQSIQ) recently visited INTA’s New York headquarters to explain its role in using big data to fight the sale of online counterfeits through its “Bridgehead” Project. The project aims at promoting quality and famous-brand products online while cracking down on substandard and counterfeit products. AQSIQ is very interested in working with INTA to encourage brand owners to assist AQSIQ in its efforts.

Understanding the Problem

Despite these efforts, a 2016 report by the U.S. Chamber of Commerce Global Intellectual Property Center, which looked at seizure data from reports published between 2010 and 2014, determined that the value of counterfeit goods produced in China each year is US $396.5 billion. While some, including Mr. Mangelson, believe this and other similar statistics warrant continued characterizations of China as a counterfeiting hub, others feel such views run the risk of ignoring the bigger picture.

“The supply of counterfeit products can be complex and it’s an oversimplification to describe the source of the problem as a single country,” says Mr. Duke. “It’s a cross-border problem.”

He does agree that China is a source for physical counterfeit goods supplied to various parts of the world, but if you examine the flow of money through criminal networks, China is not always the original source of the fake goods.

“The approach we’ve taken is to work together with Chinese law enforcement in understanding how these networks operate and target elements that are based in each country.”

The United States has also taken action, including working on outcomes from the JCCT.
However, the continuation of JCCT and other dialogues are currently on hold pending U.S. President Donald Trump’s 100-day trade plan and a new comprehensive dialogue, which was announced in April.

The details of the plan are still unclear, but it aims to address trade imbalances between China and the United States.

Five-Year Plan
In January this year, China’s State Council also released a five-year plan on the protection and application of IP in the country.

Seven tasks for the development of IP were put forward, including improving the legal system for IP, strengthening protection of IP, improving quality and benefits, promoting industrial upgrading, and promoting international cooperation and exchanges.

In a visit to INTA’s New York offices on May 11, Vice Minister Liu Junchen of the State Administration for Industry and Commerce (SAIC) emphasized that China is determined to crack down on counterfeiters and stressed the necessity of the government to work with organizations like INTA and its members in order to be successful.

Indeed, a number of initiatives are currently underway that indicate where the Chinese government is looking at further improvements, explains Mr. Duke.

In December last year, China published its draft e-commerce law to solicit comments.

Although IP is one small part of the law, there is a section in the draft that looks at how e-commerce websites deal with IP enforcement and platform liability.

“E-commerce has become increasingly important. It’s changing the way people buy and sell products throughout the economy, so the law which looks into it in further detail is incredibly important and will have an impact in the coming years,” explains Mr. Duke.

But, according to Mr. Mangelson, the draft has not done enough to clarify the liability of intermediaries.

He adds that some of the provisions could actually be a step backwards, such as the provision for counter-notices in Article 54 of the draft.

Counter-notices work in reverse to a takedown notice—with the subject of a takedown notice claiming that the work is not infringing.

Under the proposed draft, if an alleged infringer submits an unsupported statement of non-infringement, the e-commerce platform is required to terminate all takedown measures. This will likely encourage meritless counter-notices and make it more difficult for rights holders to stop the online sale of counterfeits.

Although they are very effective at policing the border, Chinese Customs don’t have detailed inland powers.

Collaboration a “Must” for Success
How can IP rights owners protect their valuable goods?

Brand owners should ensure that their rights are recorded in China, both at the China Trademark Office and at Customs. Without registration, the goods can’t be seized by Customs. This is usually the case in most countries.

But a key problem which can hinder the ability of legitimate brand owners from registering their marks is bad-faith trademark filing.

Bad-faith trademark filings and cybersquatters have proliferated in the region, explains Mr. Mangelson, and it’s the problem he receives the most calls about.

“Without trademark rights you can’t enforce in China—you can’t enforce at the border, in the courts, in administrative processes, with the police or on online platforms,” he adds.

Mr. Mangelson adds that China could do a lot more to address the issue of bad-faith trademark filings at the examination stage.

For brand owners to take the most advantage of Customs, they should provide as much information as possible.

Mr. Duke says: “If you’ve detected a problem on a certain route or at a certain port, contact Customs, either directly or through an industry association. The more you put in, the more you get out.”

The two agree that brand owners should take the time to understand the counterfeiting routes used and spend time communicating and sharing information with Customs.

Customs have made this easy: on the website there’s a form (in English) that can be submitted.

“They want it to be as easy as possible for rights owners, but it’s effective only if owners are willing to educate Customs and help them identify infringing products,” Mr. Duke adds.

“Communication and cooperation is what it all boils down to—working together is the only way to solve the counterfeiting problem,” he concludes.

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ANTICOUNTERFEITING
COMMITTEES

Saturday May 20, 2017

Staying Ahead of the Curve:
The Anticounterfeiting and Unreal Campaign Committees

INTA’s Anticounterfeiting Committee and Unreal Campaign are working hard to fight fakes and educate young people about IP, as their Chairs and Vice Chairs explain to Sarah Morgan.

Tasked with leading the charge against fakes, INTA’s Anticounterfeiting Committee (ACC) has a tough job. But Heather McDonald (BakerHostetler, USA), Chair of the Committee, and Virginia Cervieri (Cervieri Monsuarez & Asociados, Uruguay), Vice Chair, are up for the challenge.

“INTA is a leading voice for brand owners, and we regard counterfeiting as one of the most critical issues facing not only our members, but consumers, communities, national economies, and society at large,” explains Ms. McDonald. Customs and border measures, criminal enforcement, and the sale of counterfeit goods online are just some of the issues the committee is tasked with handling, and trying to stay ahead of the curve is a constant challenge.

The team advance INTA’s objectives through policy development and advocacy initiatives, including providing comments to strengthen or enact legislation, meeting policymakers and enforcement officials, training customs officials, and holding policy discussions and roundtables. Policy dialogues bring together all the stakeholders involved in anticounterfeiting efforts, such as online platforms, brand owners, and government officials in order to focus on exploring solutions to the problem. Ms. McDonald adds: “Online counterfeiting, which is global in nature, has become so big that one of our challenges is just to stay constantly focused on the issue. We try to bring disparate viewpoints together to find a common solution.”

Maysa Razavi, INTA Anticounterfeiting Manager, adds that INTA is developing several best practices documents focused on online counterfeiting, including one for private stakeholders and another one for law enforcement.

One of the ACC’s most important objectives, according to Ms. Cervieri, is the continued focus on involving brand owners. This year’s Annual Meeting will include two workshops dedicated to brand owners, because it is important to know what they need and how INTA can help.

“The number of brand owners at INTA is increasing, with new brand representatives joining the committee all the time from all over the world,” Ms. Cervieri says. The increased involvement of brand owners ensures that INTA’s policies reflect an even more comprehensive cross-section of the IP community, adds Ms. McDonald.

And constant vigilance is the key to facilitating industry cooperation with administrative and law enforcement bodies. “We take pride in the fact that our volunteers are so actively committed to these issues and work with local governments and stakeholders on keeping these issues front and center,” Ms. McDonald says.

Global Reach

The ACC is a member-driven network of 270 professionals from all over the world. Divided into nine regional subcommittees, the members provide INTA with local expertise and act as on-the-ground advocates for the Association’s positions globally.

As Ms. Razavi notes, the ACC has been taking the lead on holding a series of workshops globally in the last two years. “Last year, the focus was on the role of intermediaries in counterfeiting, with events held in Singapore, Johannesburg, Beijing, Brussels, and Buenos Aires. This year, INTA is focused on discussing how brand owners should enforce in free trade zones, with events in New York, Hong Kong, Cartagena, Dubai, and Berlin.”

In April 2016, the Association sponsored an enforcement seminar hosted by the Mexican Institute of Industrial Property and the U.S. Intellectual Property Enforcement Coordinator, the first event of its kind. And INTA was grateful to work with the National Institute of Industrial Property of Chile to host a second annual seminar, which took place from May 4-5, adds Ms. Razavi. “We were able to expand the event from 12 to 14 offices this year.”

The committee has also been very active in Canada, due to recent legislative and governmental changes, says Ms. McDonald. “Our subcommittee in Canada has been great. We sent three large delegations to speak to the government representatives focusing on the issue.”

Heather McDonald

Maysa Razavi

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Sister of the Month: Anna Li, Jiali, and Jiaozhu Wang

French firm SIG穹 for SIGuru

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and our voices are being heard,” she adds. Another major achievement during the committee’s term was INTA’s 2017 Anticounterfeiting Conference, which took place in February in Hong Kong SAR, China.

At the conference, representatives from numerous regional task forces focused on the issue of anticounterfeiting on a global scale. INTA also issued a report during the conference, The Economic Impacts of Counterfeiting and Piracy, finding that the global economic value of such infringement could reach US $2.3 trillion by 2022.

The committee has no shortage of programs aimed at addressing the issue of counterfeiting. This committee term Customs Connection was launched, providing brand owners in specific industry sectors—such as pharma, luxury goods, sports, personal care and consumer electronics and energy—with the opportunity to record their brand identification trainings for enforcement officials to view worldwide.

The secure videos are then uploaded to customs portals worldwide, allowing customs organizations to access the information and training provided by INTA members.

A customs training program has also been set up. Launched at the request of members looking for more opportunities to meet one-on-one with customs officials, the program is focused on establishing face-to-face meetings between brand owners and customs so that the officials can receive training sessions on how to identify counterfeit goods. Since November 2016, two training sessions have been conducted with plans to continue holding more training sessions in 2017.

Educating the Next Generation

Through collaboration with the Anticounterfeiting Committee, the Unreal Campaign was born. Launched in 2012, the Unreal Campaign aims to educate students (ages 14-18) on the importance of trademarks and the dangers of counterfeit goods. Over the past five years the Campaign has reached approximately 9,000 students inside the classroom and countless more through online initiatives.

In 2016, the Unreal Campaign got its own committee. This group of 70 INTA members focus on expanding Unreal all around the world through direct and online student engagement events.

With the help of the Unreal Committee, 2016 was a year full of successes. Unreal held 38 direct student engagement events reaching over 2,500 students inside the classroom, launched in 15 new countries, published 10 new videos and reached over 120,000 students online.

The committee is off to a great start this year and is hoping to surpass the number of students reached in 2016. So far in 2017, the committee has helped to organize over 15 direct student engagement events.

However, as with any grassroots campaign, there are some challenges. Michelle Brownlee (Bose Corporation, USA), Chair of the Unreal Campaign, says: “Sometimes it’s not easy to convince schools of the educational value of Unreal events. “It really can be challenging to persuade school officials that it’s a good use of the students’ time,” she adds. In order to overcome these challenges, the committee has drafted letters to the schools that outline the importance of its presentation.

The content not only touches upon law, business, economics and marketing studies, but it also brings a new discussion to the classroom that is not regularly addressed in high school curriculums.

“Student engagement is not a problem, as the teenagers respond well during the sessions,” Ms. Brownlee explains. “We find that because students are not regularly exposed to intellectual property and trademarks in their normal studies, they are extremely attentive and eager to learn more.”

Daniela Rojas (Hilborne Hawkin, USA), Vice Chair of the Unreal Committee, says: “People think it’s a challenge to get teenagers engaged, but they really get into it, especially when you give examples of things that can go wrong.”

In terms of online engagement, it can be difficult to get the attention of teenagers when competing with so much content online, especially when it comes to social media.

However, other ways of promoting the message online have been identified, including commissioning a European social media influencer, @agiesamperi, to create a video—more than 60,000 of her followers have watched it. The committee must be creative and strategic when determining where to grow Unreal online. This has been one of its main objectives and continues to be a focus moving forward.

What’s Next for Unreal?

According to Ms. Brownlee and Ms. Rojas, the Unreal Campaign is trying to reach more schools, continuing the successful partnership with DECA (an international association of students interested in studying marketing and entrepreneurship), and establishing its new partnership with the educational association, Future Business Leaders of America-Phi Beta Lambda. These large youth-oriented groups allow Unreal to reach a large audience of students through exhibition and break-out session opportunities.

This is the second year of the committee’s term and it has confirmed eight 2017 sponsors, including eBay, CSA Group, CompuMark, Google, GUCCI, IP4Kids, New Era Cap Co. and Tilleke and Gibbins. The help of sponsorship money will allow Unreal to continue expanding its international reach and begin developing new online engagement initiatives to fight fakes.

How Can You Get Involved with Unreal?

Volunteer

Even if you are not serving on the Unreal Campaign Committee, you can still host a student engagement session in your local school. These sessions are typically one-hour assembly style presentations and INTA has the materials already prepared.

Sponsor

We would not be able to continue spreading the Campaign without the help of our sponsors. A big thank you to our 2017 Unreal Campaign Sponsors: eBay, CSA Group, CompuMark, Google, GUCCI, IP4Kids, New Era Cap Co. and Tilleke and Gibbins. Learn more about the benefits of sponsorship today.

Donate

Any examples of real versus counterfeit goods are greatly appreciated. These examples help to enhance the presentations with students. If you are interested in donating, we ask that you contact INTA directly to ensure that the proper waivers are completed.
To start off your week at the INTA Annual Meeting, bring your e-ticket to the registration desk at the north entrance of the Fira Gran Via. You can register beginning at 9:00 am on Saturday, May 20. Here you will receive your badge, which will give you access to all Annual Meeting events including, education sessions, the Exhibition Hall, Hospitality, receptions, and all events affiliated with INTA. This year, all registrants will receive complimentary passes to use Barcelona’s public transport system.

We advise you to give yourself enough time to travel between educational sessions and networking and business meetings. For your own convenience, we further advise you to meet at the Fira Gran Via. There will be two meeting points to make finding people easier for you. These are located in the hallway outside the Hospitality Area in Hall 8.1. Halls 8.0 and 8.1 are located at the North Entrance, where the morning shuttle drop-off and evening shuttle pick-up will be, as well as the taxi stand. These shuttles will travel to the five closest hotels and will also stop by the metro station in the evenings.

You can stay up to date by reading the INTA Daily News and following the 2017 Annual Meeting on Twitter (#INTA17) both of which will be your only source for updated room locations and schedule info. Download the free mobile app, called “INTA 2017”, to design your schedule. This app will guide you on the Annual Meeting schedule of events, room locations, and committee meetings, among other functions.

Besides educational sessions, there will be great opportunities to network. There will be the Annual Meeting Registrant First-Time Orientation and Reception on Saturday from 3:00 pm to 5:00 pm. There will also be Speed Networking opportunities in the Exhibition Hall, as well as networking excursions during which you can explore Barcelona.

Keynote Speaker: Íñigo Méndez de Vigo, Commences at 4:00 pm, Sunday May 21, 2017

Lunch and Learn: Gerd Leonhard Monday, May 22 1:15 pm–3:15 pm

Lunch and Learn: Paul Birch Tuesday, May 23 1:15 pm–3:15 pm

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Al-Otaishan Intellectual Property & Technology Law Firm (AIP&T) is an IP law firm in Riyadh, Saudi Arabia with an active presence in GCC, Middle East, Africa and Asia. AIP&T is managed by Atty. Mohammad Al-Otaishan, who holds an LLM degree in intellectual property from the University of Washington, USA. Atty. Mohammad was previously a legal advisor for Saudi Basic Industries Corporation (SABIC). During his career at SABIC, he had a very remarkable contribution to the case EXXON Mobile vs SABIC which is the largest case ever in the region with respect to volume of damages and one of the most complex cases in the Middle East.

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Other networking events that we recommend are:

- Trademark Administrators Brunch: Fira Gran Via, Hall 8.0, Room C1; Sunday, May 21, from 11:30 am to 1:30 pm. Separate and advance registration is required for the brunch.
- Opening Ceremony and Keynote Address: Fira Gran Via, Hall 6; Sunday, May 21, from 4:00 pm to 5:30 pm.
- Welcome Reception: Fira Gran Via, Hall 7; Sunday, May 21, from 5:30 pm to 7:30 pm.
- Lunch and Learn: Fira Gran Via, Hall 6; Monday and Tuesday, May 22 and 23, 1:15 pm to 3:15 pm.
- Grand Finale: Ocean Promenade at Barceloneta Beach; Wednesday, May 24, from 7:00 pm to 11:00 pm.
Sessions to Watch: Counterfeit Goods and Enforcement

The threat of counterfeit goods is a global problem and brand owners need different strategies depending on where their goods are being infringed. Ed Conlon and Sarah Morgan preview some of the must-attend sessions that focus on counterfeit goods around the world.

On Monday at 3:30 pm, China and Africa will take center stage in two concurrent sessions that both incorporate some focus on counterfeiting.

In CM50 A Passage out of China—Is It Any Easier?, led by Timothy Golder (Allens, Australia), there will be an update on Chinese trademark law and practice, including the impact on foreign companies manufacturing there.

Providing a range of views from both inside and outside China, the speakers in this session are Michael Shu (Zhong Lun Law Firm, China); Scott R. Miller (MBM Intellectual Property Law LLP, Canada); Dan Plane (SIPS—Simone Intellectual Property Services Asia Ltd., Hong Kong SAR, China); and Volker Schmitz-Fohrmann (Boehmert & Boehmert, Germany).

The speakers will cover issues including strategies for trademark registration—with emphasis on clearing the path for export—and using registrations in enforcement actions to prevent unauthorized exports. They will also consider the use of creative legal strategies to thwart the sale or marketing of counterfeits.

At the same time, RM50 Regional Update: Protection and Enforcement Strategies in Africa will provide updates on a range of developments in that continent.

Along with assessing recent groundbreaking case law in Africa, the effectiveness of the Madrid Protocol and its implementation by African registries, the session will cover anticyfurtherest strategies, focusing on jurisdictions without counterfeit goods legislation.

The session, moderated by Nolwazi Gcaba (Adams & Adams, South Africa), will include panelists Godfrey Budeli and Darren Olivier (Adams & Adams, South Africa); Vanessa Ferguson (Kisch IP, South Africa); and Monique Gieskes (Vlisco Netherlands B.V., Netherlands).

Issues facing brand owners in their attempts to tackle the problem of shipments of counterfeit goods is next on the agenda, on Tuesday at 10:15 am in CT02 Potential Liability of Intermediaries in the Real World.

Industry experts will also discuss the efforts being made by the shipping industry to help ensure the goods they transport are not fake.

Executives at two global brands will discuss the issues in dealing with shipments of counterfeit goods, both by sea freight and small packages by air.

Executives at two global brands will discuss the issues in dealing with

Scott R. Miller

Vanessa Ferguson

Volker Schmitz-Fohrmann

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The Fight Against Counterfeiting: Collaboration Is Key

Brand owners and government officials are coming together at the Annual Meeting to share best practices for the fight against criminal counterfeiting, as Ed Conlon reports.

By 2022, the cost of crime due to counterfeiting will be US $125 billion, according to The Economic Impacts of Counterfeiting and Piracy, a report prepared for INTA and the International Chamber of Commerce Business Action to Stop Counterfeiting and Piracy.

With so much at stake in the fight against criminal counterfeiting, brand owners, law enforcement officials, and others will need to work closely and efficiently to stamp out the scourge of fake goods.

The Annual Meeting in Barcelona is bringing together brand owners and government representatives in a special two-day workshop, which started yesterday, May 19, and finishes today. Titled Workshop—Strategy + Collaboration: The Key to Success Against the Crime of Counterfeiting, this session is open only to corporate and government officials.

On Friday, there were concurrent half-day workshops—one for brand owners and one for government officials—allowing registrants to discuss IP issues and how to better collaborate to resolve them. Stakeholders from around the world were well-represented in both tracks—in the government session, there were representatives from Europe, Latin America, Asia, and the United States.

When registrants return today, a full-day workshop will allow brand owners and government officials to discuss some best practices, criminal prosecution of counterfeiters, and how they can achieve more effective collaboration in the fight against counterfeits. Today’s topics will include a “how-to guide” on successful collaboration between the public and private sectors, discussion on conducting a successful criminal prosecution, and how to create an “authentic city.”

AUTHENTICITY is a program that was proposed by UNIFAB, INDICAM and ANDEMA to the European Observatory in 2014 when it requested campaigns to raise awareness about IP rights and counterfeiting. Under the program, one of 11 projects chosen for a grant from 120 applications, cities including Rome and Paris have dedicated themselves to protecting trademarks through collaboration with the city government and implementing awareness campaigns.

This initiative fits in nicely with the workshop’s main focus of collaboration, a process which requires several best practices. A key requirement here is communication, and one of INTA’s main objectives is to be a facilitator of best anticounterfeiting practices across jurisdictions, allowing for exchange and interaction between the public and private sectors.

Jeremy Newman, Chair of INTA’s Anticounterfeiting Committee, EU Subcommittee, says, “While counterfeiting must clearly be addressed at a global level, there’s a great deal to be learned from local best practice. The tremendous interest in this workshop confirms the appetite for effective public/private collaboration locally and across borders.”

He adds: “Today’s workshop will take the discussion beyond the general concepts of collaboration by facilitating the sharing of some very practical best practices. We hope that participants will leave with new ideas, new contacts, and renewed optimism as to what can be achieved.”

The workshop is based at:

Hotel Santos Porta Fira, Plaça d’Europa, 45, 08908 Barcelona.

Are you having a reception in Barcelona? Do you have big news you’d like to share?

Contact the INTA Daily News editorial team ...

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Time Out in Barcelona

Art, architecture, and parks are among the must-see attractions of the Annual Meeting’s host city. Naomi Jeffreys provides a rundown of the highlights, brought to you in association with Zivko Mijatovic & Partners.

Sagrada Familia
The first stone of the Sagrada Familia was laid on March 19, 1882. The church’s first architect, Francisco de Paula del Villar y Lozano, who drew the neo-Gothic design, left due to disagreements later that year. His position was taken up by Spanish architect Antoni Gaudí in 1883.

The church, one of the greatest neo-Gothic buildings in the world, is uncompleted and the goal is to finish all the architectural work by 2026.

Still Life (1901), and The Wait (Margarit) (1901). During the INTA Annual Meeting, two exhibitions to look out for are Other Artists in the 1970 Picasso Donation and Picasso Portraits. These showcase works that the artist donated to the museum, and include drawings, paintings, and prints.

Barcelona Cathedral
The Metropolitan Cathedral Basílica of Barcelona is another of Barcelona’s breathtaking feats of architecture and is the seat of the Archbishop of Barcelona, Lluís Martínez Sistach.

Construction of the cathedral started in 1298 and was carried out in three stages over 150 years. The main façade was raised at the end of the 19th century. The largest stadium in Spain by capacity, with 99,354 seats, and the largest stadium in Europe, it has been home to many magical moments down the years.

Camp Nou
For the football fans, why not visit Camp Nou? It’s the home of professional football club FC Barcelona.

Visitors can go behind the scenes of the club accompanied by an official guide. The football stadium offers a range of services such as a VIP Tour, where visitors can go behind the scenes of the club accompanied by an official guide.

Park Güell
Established in 1914 by Gaudí, this public park comprises gardens and architecture, and is a must-see for any registrant attending the Meeting this year.

Count Eusebi Güell, an entrepreneur, wanted to recreate a park similar to British residential parks and instructed Gaudí to draw up plans for developing an estate for wealthy families. This estate would become a large private garden, which Güell used for public events.

Park Güell was recognized as an artistic monument in 1969. Highlights of the park include the Dragon Stairway, the Nature Square, and the Hypostyle Room.

The Magic Fountain of Montjuïc
Registrants who wish to see a spectacle should head to the Font Màgica, also known as the Magic Fountain of Montjuic.

The fountain, Barcelona’s biggest, which was built in 1929 for the International Exposition, offers a musical display with lights and water acrobatics. It was designed by Catalan architect and engineer Carles Buigas in 1922.

To see a “piromusical” reminiscent of the Fountains of Bellagio in the United States, head to Avinguda Maria Cristina in the Montjuic neighborhood and experience the magic.

The metro pass for the public transportation system is included in your registration fee and will be available when you pick up your badge.

Highlights of the cathedral include the pond with a fountain in the Cloister of the Cathedral, which is home to 13 white geese representing the age of Saint Eulalia when she died. Eulalia is buried in the crypt and the cathedral is dedicated to her.

To see a “piromusical” reminiscent of the Fountains of Bellagio in the United States, head to Avinguda Maria Cristina in the Montjuic neighborhood and experience the magic.

The Magic Fountain of Montjuïc: music, lights and water acrobatics
Growing Success for EU Customs

With EU customs detaining an increasing number of counterfeit goods, what impact have the goods-in-transit and other reforms to the EU trademark system had so far? Ed Conlon investigates.

In September 2016, the European Commission announced that customs authorities across the European Union had seized around five million more counterfeit items in 2015 than the previous year. That amounted to 15 percent more goods year on year, and in total, more than 40 million products suspected of IP infringement were detained.

Cigarettes were the most frequently detained goods, while food and beverages, toiletries, medicines, toys, and household electrical goods also ranked highly. China was the leading source for the fakes, accounting for 41 percent. According to the Commission, in more than 91 percent of detentions, either the goods were destroyed or a court case was launched with the brand owner in order to establish infringement.

Henk Molegraaf, Policy Officer in the Directorate-General for Taxation and Customs Union (DG TAXUD), says the increasing number of seized counterfeits results from better technology deployed by customs.

In the Customs Union, the European Union’s 28 member states use a common set of rules—the Union Customs Code—to operate one system for importing and exporting goods. In May 2016, a new code came into force containing counterfeit goods which allows us to deal with them in a simplified and accelerated way.”

In 2015, the European Union accounted for almost 15 percent of the world trade in goods, worth €3.5 trillion (US $3.75 trillion), according to the Commission. “Managing this volume of international trade requires handling millions of customs declarations per year in a fast and efficient manner,” it added.

Discussing the biggest challenges in detaining counterfeit goods, Mr. Molegraaf says it is important for rights owners to provide correct information about their goods. “You have to give us as much information as you can,” he says, adding that information on the normal routing of legitimate goods is helpful. His advice for brand owners worried about counterfeits is to file an application with customs.

“It can be a national application or a Customs Union application, if you have Customs Union rights. You can submit the application in one member state and then have protection in all member states.”

“Once we have that application in action, you submit all the information relevant to your IP rights, the type of goods, and information relevant for your routings, official suppliers, and producers.”

“We will try to build a risk analysis and select the shipments which might infringe your IP rights,” he adds.

According to Mr. Molegraaf, e-commerce has had an “enormous” effect on customs’ work. “Thousands and thousands of packages are coming through the post or by express courier and are keeping customs busy. Fortunately, an ad hoc procedure exists for small consignments containing counterfeit goods which allows us to deal with them in a simplified and accelerated way.”

Mr. Molegraaf is also concerned about the increased use of e-commerce. “It can be a national application or a Customs Union application, if you have Customs Union rights. You can submit the application in one member state and then have protection in all member states.”

In 2016, the European Union introduced a host of trademark reforms, including some on goods transiting through the Union’s member states, and more changes will follow later this year.

According to the new EU Trade Mark legislation which entered into force on March 2017 and the EU Trade Marks Directive, owners of an EU trademark or a national trademark protected in an EU member state can seek to prevent third parties bringing counterfeit goods in the course of trade into the European Union, even if those goods are not intended for that market.

Previously, only goods that were put into circulation in the European Union were deemed to infringe, whereas under this rule the mere transport or storing of goods through or in the European Union could be an infringement.

However, the right to stop counterfeit goods transiting through the European Union will lapse if the owner of the goods can show that the trademark owner is not entitled to prevent the goods being placed on the market in the country of the goods’ final destination.

Mr. Molegraaf says the reform of goods in transit in transit has not had much of an impact on customs authorities, “but it has made life a little easier as we do not have to wonder whether the goods are destined for the EU market.”

According to Huib Berendschot (AKD, Netherlands), one of the main challenges is detaining goods that are “essentially identical” to a trademarked product and not just those that are 100 percent identical. Under the EU Regulation and DG TAXUD guidelines, goods matching this standard and those that are identical can be seized.

“We believe the authorities are inclined to read identical marks, so the challenge is to make sure customs understand that it’s also about essentially identical marks,” he says.

He gives the example of LIPTON TEA drinks, saying that something labeled NIPTON TEA should be acted on.

Communication with customs and other authorities is crucial to ensure all parties are clear on issues such as this, and even though “many customs officers” understand the rules, the responsibility to maintain clarity is a joint one, says Mr. Berendschot.

Another area that brand owners should monitor is that the goods holder carries the burden of proof to show the trademark owner cannot object to the marketing of the goods in the country of their destination, irrespective of the grounds laid out. Under the current rules, this burden should be on the goods holder—rather than on the trademark owner to provide evidence of a mark.

Mr. Berendschot says that although there have not been “any major accidents yet,” brand owners and INTA are watching this area closely to ensure the shift does not occur.

As the European Commission’s figures show, and as every trademark owner knows, counterfeiting is a complex, and multifaceted problem, they are a step in the right direction.
Luncheon Table Topics

**CSA0 Using Copyright to Protect and Enforce Rights in Logos**

Logos are traditionally protected and enforced using trademark laws, but copyright may also be available. This presentation will focus on the benefits and challenges of using copyright to protect and enforce rights in logos in the United States, the EU, and China. The presentation will also compare and contrast trademark protection of logos in these jurisdictions.

**CSA1 Cost-Effective Use of Patents: Protecting Inventions with Smaller Budgets**

For small businesses (and startups in particular), funds for IP protection are limited, and in many cases, patents are not pursued because they are considered too expensive, particularly when compared with trademarks. Additionally, patent law is still strongly influenced by national laws and policies to stimulate innovation, resulting in a system that is far from harmonized. This can make it difficult for practitioners to appreciate what is possible in other countries and regions. After a short overview of the different possibilities, the speakers will discuss (i) how they deal with such clients and (ii) how to identify the options available in the main patenting countries for both domestic and foreign applicants.

**CSA2 Mastering the Art of INTA's Online Resources: Tools and Techniques for Successful Trademark Research**

From the Annual Reviews of Case Law to the Quick-Start Trademark Chart, to all of the fact sheets, checklists, online treatises, and searchable guides, come and learn how to use INTA’s library of Member Resources to help you in your daily work. Let us show you how easy it is to access these materials and to find the quick answers you need to many of your preliminary research questions.

**Indigenous Rights Committee**
Leadership Only

**Annual Meeting Registrant First-Time Orientation and Reception**

Learn from experienced Annual Meeting attendees about the many resources and opportunities for education and networking; also, find out how to navigate the Exhibition Hall and make the best use of your time. Don’t miss out on this informative event and discover what’s new at this year’s Meeting. After you hear from experienced INTA attendees about how to maximize your time at the Meeting, stick around to network with other first-time attendees and get to know each other better. First-time attendees, young practitioners, and students, as well as new INTA members, will find this orientation essential to making the most of their first Annual Meeting and will have the opportunity to network at a reception after the session.

**Designs Committee**
Leadership Only

**Patent Professionals Networking Reception**

**Pro Bono Committee**

**Ministry of Public Safety Meeting**

**Harmonization of Trademark Law and Practice Committee**
Leadership Only

**Copyright Committee**
Leadership Only

**Legislation and Regulation Committee**

**Annual Meeting Project Team Meeting**
Course on International Trademark Law and Practice

This course is designed to provide a comparative analysis of trademark law and practice in countries around the world. Depending on the topic, the focus will vary from historical, philosophical, and legal perspectives to practical "how to" tips and advice. Each international jurisdiction covered in the course will be taught by a professor or practitioner from that region. Practitioners new to trademark law, law and paralegal students, trademark administrators, and in-house counsel seeking to obtain a well-rounded overview of trademark law and practice from around the globe are encouraged to attend.

Continental Breakfast

Continental breakfast will be served daily until 10:00 am in the Hospitality Area in Hall 8.1.

Registration

Hospitality

Board of Directors Meeting

Workshop: Strategy + Collaboration: The Key to Success against the Crime of Counterfeiting

This workshop will give in-house teams and government officials an opportunity to benchmark and collaborate with other brand owners, investigators, law enforcement and governmental agencies, leading anticaounterfeiting associations, and legal experts to identify best practices to help in the fight against the ever-growing crime of counterfeiting. Prosecution of counterfeiters via criminal proceedings and how law enforcement identifies, investigates, and prosecutes counterfeiters will be the focus of this workshop. Workshop participants will share case studies, lessons learned and will discuss how collaboration and the right strategy is the key to successfully fighting counterfeiting. This workshop is only for in-house counsel and government officials and space is limited. On Day 1 of the conference, there will be two dual tracks—one for corporate members and a second track for government officials. Both groups will come together on Day 2 to work together to enhance collaboration by sharing best practices and learning to work together more efficiently.

Career Development Day

CSA20 The Ownership and Operation of Law Firms in Spain and the Broader EU—What Can Others Learn from Their Experience?

Law firms around the world have different ownership structures. Some laws and regulations prevent non-lawyers from having ownership interests. Some law firms are family owned. Some law firms have affiliations with larger professional businesses such as accounting firms. This panel will focus on the organization of law firms in Spain and in other countries in the EU. It will also delve into how such firms operate with an emphasis on the similarities and dissimilarities with the running of firms in other countries. Importantly, the discussion will highlight practices that attorneys in other jurisdictions can learn from and consider employing within their own firms.

CSA21 Geo-Branding: The Global Interplay Between Geographical Indications and Trademarks

As one of today’s truly hot topics in IP, geographical indications (GIs) are receiving renewed interest in various areas, from geo-branding of countries and cities, to the debate in ICANN on the scope of protection of so-called geo-names as domain names, and to expanded use of collective and certification marks to protect GIs in countries that do not have active GI registration systems. This expert panel with diverse views will discuss various GI topics, and how these GI developments interact with trademarks.

Data Protection Committee

Enforcement Committee

...means something entirely different

You are the backbone of the IP industry. You care more, worry more, are insanely diligent and relentlessly passionate. Not everyone has what it takes. We get you.

We speak the same language.