



THE JOHN MARSHALL LAW SCHOOL

SYLLABUS

for the
International Trademark Law Course

May 1 – 2, 2004
Marriott Marquis, Bonn Room
Atlanta, Georgia, USA

Hosted by the International Trademark Association (INTA) in conjunction with its 126th Annual Meeting and accredited by The John Marshall Law School Center for Intellectual Property.

COURSE PURPOSE AND SCOPE

This one credit course is designed to give an overview/survey of trademarks and trademark law and practice in countries around the world other than the United States. There will also be some attention given to various international treaties, conventions and agreements. The focus will vary from historical, philosophical, legal, and even practical “how tos” depending on the topic.

The course will be taught by professors and practitioners of trademark law from around the world who will be in Atlanta, Georgia, USA in connection with their attendance at the International Trademark Association’s 126th Annual Meeting. The course will be divided into eight two-hour segments with a lunch break provided each day. The course will be graded pass/fail based on a “take home” final exam that the student will mail in following the course.

The law of trademarks outside of the United States is affected by local laws and by international agreements, conventions and treaties. The applicability of case law varies from jurisdiction to jurisdiction. The course will cover acquiring trademarks and trademark protection, policing and maintenance, transfers, licensing, the practicalities of creating and maintaining a worldwide trademark program for one or more clients, and international treaties and conventions.

DAY ONE

SATURDAY, MAY 1, 2004

8:00 AM – 9:30 AM

Segment 1 Introduction (1.5 Hours)

What is a trademark? Discussion concerning distinguishing trademarks from other kinds of intellectual property, real property and personal property.

An overview of various key concepts and terminology, including: trademark use, registration, fame, famous marks, licensing, assignment, valuation, geographic indications of origin, classification systems, the trademark office, opposition, cancellation, infringement, piracy/counterfeiting, litigation, the territorial nature of a trademark, translation, transliteration, symbols and non-traditional trademarks. [Each of these areas will be discussed with a view towards the later comparison among jurisdictions.]

Discussion of the selection of a trademark. Who? When? How? What? Various considerations include: strong, weak, translations, transliterations, varying meanings of words, representations and symbols from country to country, language to language, culture to culture and weighing business and marketing needs.

What is the role of a trademark lawyer in a multinational launch of a brand name product or service?

Overview of general types of laws applicable to trademarks/service marks globally. Searching globally, and dealing with results whether negative or positive.

9:30 AM – 11:30 AM

Segment 2 Western Europe (2 Hours)

Discussion on concepts raised in the first session with the application of the particular laws of some of the countries in question; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Discussion on the number of jurisdictions and significant economies but different cultures in a relatively small geographic area; The fundamentals and differences that arise in some of these jurisdictions (U.K. concept of trafficking in trademarks and former lack of recognition of service marks for retail services); The competing and contrasting concerns of various jurisdictions; The European Community Trade Mark and Trademark Office; Geographic indications of Origin in these jurisdictions as contrasted with others; Exhaustion doctrine within the European Community; Applicable regional Agreements; Only truly international registration opportunity (Benelux); Administrative actions (oppositions and cancellations), national litigation, ECC litigation. European Trademark Harmonization Regulation (1993) and Directive (1998).

11:30 AM – NOON

Segment 3 Israel (.5 Hour)

Discussion on concepts raised in the first session with the application of the particular laws of some of the countries in question; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Cultural distinctions within the region and vis-a-vis the Americas and Europe that result in different concerns for trademark owners; What is registrable and what might not be due to cultural considerations; Changing political boundaries and allegiances; boycott and political issues and the effect on trademark practice.

Lunch Break 12 p.m. - 1 p.m. (Lunch will be provided.)

DAY ONE - CONTINUED
SATURDAY, MAY 1, 2004

1:00 PM – 2:00 PM

Segment 4 Mexico and Central America including the Caribbean (1 Hour)

Discussion on concepts raised in the first session, with the application of the particular laws of some of the countries in question; Emphasis on the instances in which a country follows a typical pattern and instances when it is unusual; Discussion on practices of the trademark offices of various countries; Administrative actions and litigation procedures in these jurisdictions; Importance of Mexico to U.S. based clients due to NAFTA.

2:00 PM – 3:00 PM

Segment 5 South America (1 Hour)

Discussion on concepts raised in the first session with the application of the particular laws of some of the countries in question; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Traditional approach of various countries in this geographic area due to economic controls, emphasis on registration and government supervision; Limitations on registrations and licensing; Two major languages; Significant number of regional agreements making for uniformity of law in certain geographic areas: Andean Pact, MERCOSUR; Emphasis on particular formalities.

3:00 PM – 4:00 PM

Segment 6 North America, including Canada and the U.S. (1 Hour)

Discussion on concepts raised in the first session with application of the particular laws of some of the countries in question; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual. For instance, Canada has no classification system. Discussion on practices of the trademark offices of the United States and Canada; Administrative actions and litigation procedures in these jurisdictions; Focus on how to best obtain protection in these jurisdictions for a trademark.

4:00 PM – 5:00 PM

Segment 7 Australia/New Zealand (1 Hour)

Roots in British Trademark law; Discussion on concepts raised in the first session with the application of the particular laws of some of the countries in question; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual.

DAY TWO
SUNDAY, MAY 2, 2004

8:00 AM – 9:00 AM

Segment 8 Russia / Eastern Europe (1 Hour)

Discussion on concepts raised in the first session with the application of the particular laws of some of the countries in question; Historical experience with the Republic of Russia; Trademark law and concept under the former Soviet Union, and changes in trademark law and administration since de-unification; Development of new laws and new trademark offices in each jurisdiction. Transition provisions; Administrative actions, litigation, counterfeiting; Developing case law and interplay of unfair competition and trademark law; Regional agreements and cooperation.

DAY TWO - CONTINUED
SUNDAY, MAY 2, 2004

9:00 AM – 9:30 AM

Segment 9 Sub-Saharan Africa (.5 Hour) Emphasis on South Africa and Regional issues

Discussion on concepts raised in the first session with the application of the particular laws of some of the countries in question; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Cultural distinctions vis-a-vis the Americas and Europe that result in different concerns for trademark owners; Dealing with trademark registration programs on a regional basis; regional agreements in Africa, e.g., African Regional Industrial Property Organization Protocol on Marks; Changing political boundaries and allegiances; boycott and political issues and the effect on trademark practice.

9:30 AM – 10:00 AM

Segment 10 Northern Africa and the Middle Eastern Countries (.5 Hour)

Discussion on concepts raised in the first session with the application of the particular laws of some of the countries in question; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Cultural distinctions within the region and vis-a-vis the Americas and Europe that result in different concerns for trademark owners; What is registrable and what might not be due to cultural considerations; Changing political boundaries and allegiances; boycott and political issues and the effect on trademark practice.

10:00 AM – 10:30 AM

Segment 11 Middle Eastern Countries - Arab (.5 Hour)

Discussion on concepts raised in the first session with the application of the particular laws of some of the countries in question; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Cultural distinctions within the region and vis-a-vis the Americas and Europe that result in different concerns for trademark owners; What is registrable and what might not be due to cultural considerations; Changing political boundaries and allegiances; boycott and political issues and the effect on trademark practice.

10:30 AM – NOON

Segment 12 International Treaties, Agreements and Conventions (1.5 Hours)

Paris Convention (history and continuing influence over national trademark laws) focusing the protection of famous and well-known marks .

Lunch Break 12 p.m. - 1 p.m. (Lunch will be provided)

DAY TWO - CONTINUED
SUNDAY, MAY 2, 2004

Segment 13 Asia (2.5 Hours)

(Singapore, Thailand, Indonesia, Malaysia, Japan, Republic of Korea, People's Republic of China, Hong Kong, Taiwan, Vietnam)

Discussion on concepts raised in the first session with the application of the particular laws of some of the countries in question; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Issues of translation and transliteration; Cultural patterns influencing trademark law and practice; Interaction of national trademark offices with local courts and administrative agencies; Large geographic expanse, particularly in mainland China leading to many significantly different approaches to trademark law and protection of intellectual property rights.

Segment 14 Review and Q&A (1 Hour)

Review concepts; question and answer period.

A take home exam will be distributed at the end of the second day along with an envelope for mailing.