

**SYLLABUS**  
for the  
**International Trademark Law and Practice Course**  
May 6 – 7, 2006  
The Fairmont Royal York  
Salon B  
Toronto, Ontario, Canada

Hosted by the International Trademark Association (INTA) in conjunction with its 128<sup>th</sup> Annual Meeting, accredited by The John Marshall Law School Center for Intellectual Property and offered in cooperation with The Faculty of Law and Division of Continuing Studies, The University of Victoria, BC.

**COURSE PURPOSE AND SCOPE**

This course is designed to give an overview / survey of trademarks and trademark law and practice in countries around the world. 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. For U.S. law students, the completion of this course will earn one unit of credit from The John Marshall Law School Center for Intellectual Property. For Canadian law students, the completion of this course will merit the issuance of a certificate of completion from The Faculty of Law and Division of Continuing Studies, The University of Victoria, BC.

The course will be taught by professors and practitioners of trademark law from around the world who will be in Toronto, Ontario, Canada in connection with their attendance at INTA’s 128<sup>th</sup> Annual Meeting. The course will be divided into morning and afternoon segments of varying length 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 6, 2006**

**8:00 a.m. – 9:30 a.m.**

### **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 a.m. – 10:30 a.m.**

### **Segment 2** Western Europe (1.0 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).

**10:30 a.m. – 10:45 a.m.**

### **Break**

**10:45 a.m. – 12:15 p.m.**

### **Segment 3** Treaties (1.5 hours)

Paris Convention (history and continuing influence over national trademark laws)

Madrid Agreement

Madrid Protocol

TRIPS Agreement on Trade Related Aspects of Intellectual Property Rights

Trademark Law Treaty

**12:15 p.m. – 1:00 p.m.**

**Lunch Break** (Lunch will be provided.)

## **DAY ONE – SATURDAY, MAY 6, 2006 (CONTINUED)**

**1:00 p.m. – 1:30 p.m.**

**Segment 4** Mexico (0.5 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 when it is unusual; Discussion on practices of the trademark office; Administrative actions and litigation procedures in this jurisdiction; Importance of Mexico to U.S. based clients due to NAFTA.

**1:30 p.m. – 2:00 p.m.**

**Segment 5** Central America (0.5 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 when it is unusual; Discussion on practices of the trademark offices of various countries; Administrative actions and litigation procedures in these jurisdictions.

**2:00 p.m. – 2:30 p.m.**

**Segment 6** South America (0.5 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; 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.

**2:30 p.m. – 3:00 p.m.**

**Segment 7** Caribbean (0.5 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 when it is unusual; Discussion on practices of the trademark offices of various countries; Administrative actions and litigation procedures in these jurisdictions.

**3:00 p.m. – 3:15 p.m.**

**Break**

**3:15 p.m. – 4:15 p.m.**

**Segment 8** North America, including Canada and the U.S. (1.0 Hours)

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.

**4:15 p.m. – 5:15 p.m.**

**Segment 9** Australia / New Zealand (1.0 Hours)

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.

**5:30 p.m. – 7:00 p.m.**

**Law Student Happy Hour**

## **DAY TWO – SUNDAY, MAY 7, 2006**

**8:00 a.m. – 9:00 a.m.**

**Segment 10** Russia / Eastern Europe (1.0 Hours)

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.

**9:00 a.m. – 9:30 a.m.**

**Segment 11** Sub-Saharan Africa – Emphasis on South Africa and Regional issues (0.5 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; Cultural distinctions vis-à-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 (ARIPO); Changing political boundaries and allegiances; boycott and political issues and the effect on trademark practice.

**9:30 a.m. – 10:00 a.m.**

**Segment 12** Northern Africa (0.5 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; Cultural distinctions within the region and vis-à-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 a.m. – 10:30 a.m.**

**Segment 13** Middle Eastern Countries – Arab (0.5 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; Cultural distinctions within the region and vis-à-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 a.m. – 11:00 a.m.**

**Segment 14** Israel (0.5 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; Cultural distinctions within the region and vis-à-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.

**DAY TWO – SUNDAY, MAY 7, 2006 (CONTINUED)**

**11:00 a.m. – 12:00 p.m.**

**Segment 15** Famous Trademarks (1.0 Hours)

Discussion of the concept of famous or well-known trademarks; How the jurisprudence involving such marks has evolved through the courts, national legislation and treaties; Perspectives on protecting and enforcing famous trademarks; and Insights into how the protection of famous trademarks may evolve in the future.

**12:00 p.m. – 1:15 p.m.**

**Lunch – Student Panel Presentation** “*Considerations for Careers in Trademark Law: A Panel Discussion for Law Students*” (Lunch will be provided.)

**1:15 p.m. – 2:15 p.m.**

**Segment 16** UDRP / Internet Issues (1.0 Hours)

Discussion of trademarks in relation to the Internet; Review alternative dispute resolution procedures such as the Uniform Domain Resolution Policy (UDRP) and other similar procedures; Discussion of evolving legal issues unique to the Internet, including metatags, initial interest confusion and the use of trademarks in Internet search engines.

**2:15 p.m. – 3:15 p.m.**

**Segment 17** ASEAN (1.0 Hours)

(Singapore, Thailand, Indonesia, Malaysia, 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.

**3:15 p.m. – 4:15 p.m.**

**Segment 18** East Asia (1.0 Hours)

(Korea, Japan, China, Taiwan, Hong Kong)

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.

**4:15 p.m. – 5:15 p.m.**

**Segment 19** Review and Q&A (1.0 Hours)

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.