INTA’s Unreal campaign challenges teens

“Who has downloaded music without paying for it?” asked Christopher Robertson of U.S. Customs and Border Protection. “I promise I’m not going to take any names.” At this, nearly everyone raised a hand. The better question, perhaps, was who hadn’t illegally downloaded music.

At a session yesterday on anticounterfeiting, Robertson was speaking to a group of students from D.C. area high schools about the risks associated with purchasing fake goods. Few people, he told them, think about the direct consequences of illegal downloading but it is not a victimless crime.

The talk was part of INTA’s Unreal campaign, an effort aimed at educating teens about trademarks and counterfeiting. Yesterday’s launch was the culmination of months of research with AMP Agency, a marketing firm that specializes in targeting teens. Together, they held focus groups and invited teens from major U.S. cities to join a private social network to complete assignments and questionnaires.

“These are the folks that are obviously the next generation of purchasers,” said INTA President Gregg Marrazzo of Estée Lauder. “Even now they have significant purchasing power.” Recognizing that teens today rely heavily on social networks to communicate (“I’ve been told that email is so yesterday,” said Marrazzo), the Unreal campaign has a Facebook and Twitter account.

During the session, Alya Deutsch, of NBA (above left), flashed photos of two seemingly authentic LeBron James jerseys. “I’ve been with the NBA 15 years, and counterfeiters are getting better,” she told them.

Perhaps nothing elicited as much horror from the students as when Richard Halverson, of the U.S. Department of Homeland Security, spoke. He told them of cough syrup created with an ingredient used in antifreeze, and showed videos of a counterfeit computer battery bursting into flames. “They will counterfeit anything, and it can all be very dangerous,” Halverson said.

The program concluded with a tour of the INTA Anticounterfeiting booth at the Exhibition Hall. There, pairs of UGG boots, basketball jerseys, perfume and jeans lay next to each other. The students were asked to detect the real from the fake, which at times required close inspection. They peered at two boxes of Bose earphones, the fake only distinguishable by a stray capitalized letter or two. “I think most trademark owners are coming to realize the importance of awareness-raising as part of our counterfeiting strategy,” said Bose trademark counsel Michelle Brownlee.

With much of the campaign focusing on the next generation, a potential future IP enforcement investigator was in attendance. Aliliyah Berger, 17, of Archbishop Carroll High School, said she’s taking a class on law and social justice. A basketball player bound for Towson University in Baltimore, Maryland, Berger said she warns her friends against buying counterfeit sneakers. Ultimately, she’s thinking of a career in IP enforcement. “I like the subject—how our rights aren’t protected as much as you think they are,” she said. www.facebook.com/unrealcampaign

A pan-Asian lesson in fighting fakes

T.V. shows such as Surfer Dudes and Bull Run, an actor named Grad Ditt and an apparel business called Lami: a recipe for financial success or a trademark law headache?

Lawyers at a regional update session yesterday considered the trademark woes of a fictional business, Lami, which had grown from being a small T-shirt-making operation endorsed by the star of a California-based TV show about surfers, to a company that makes cufflinks, shirts and ties—as worn by Ditt in a career-reviving show about Wall Street traders.

Moderator Ravi Ravindran of Ravindran Associates explained how the company had registered its mark around the world in the 1970s for T-shirts and that the registrations had been maintained by a diligent trade mark attorney. Unfortunately the attorney had not been instructed to advise the company on its decision to refresh its mark, and consequently the updated version of the LAMI mark on its new products had not been registered.

After the company’s CEO discovered fake versions of its products on sale in Phuket during a holiday in Thailand, he ordered Joe Blow, the company’s lawyer, to stop the counterfeits. But investigations revealed fakes on sale not just in Thailand but across southeast Asia—in part due to the cult status of Grad Ditt in the region.

Nettaya Warncke of Donnern Somgiet and Booman Law Office Ltd said that civil action in Thailand could cost far more than the company would get back in damages and that it was unclear whether criminal law provisions could be used to protect marks on goods for which they are not registered: “It’s a complicated area of the law and the police don’t like complications,” she said.

The scenario that would help Lami most, said Warncke, would be if Blow discovered the counterfeiters using the LAMI mark on T-shirts, for which it does have a registered mark. If so, they could ask the police to conduct a raid, allowing officers to seize the rest of the knock-off products.

Barry Yen of SKYS in Hong Kong outlined the rules in Hong Kong and Singapore, explaining that their common law provisions could be used to protect marks on goods for which they are not registered.
Attendees flock to discuss keyword ads

More than 1,400 attendees crowded into a session on keyword advertising yesterday, where Rosetta Stone counsel John Ramsey and other panelists shared their frustrations about the issue and also faced tough questions about the proper legal approach.

Ramsey could not discuss specifics of the company’s closely watched case with Google over trademarks as keywords in sponsored ads, but he explained to attendees the aggravation the brand has experienced with search results like some of the ROSETTA STONE trademark that managed to appear above links to the company’s authentic site. One example Ramsey cited was Rosetta Stone Greek, which used “black hat” search engine optimization (SEO) marketing techniques to drive up traffic. Examples of black hat techniques include when a site incorporates and links to words and phrases used by the trademark owner (link farming). He added that infringing advertisers have even learned how to use geo-targeting to avoid displaying infringing ads in markets where the company has offices so as to keep them off Rosetta’s radar. “Make sure you have monitors in a number of different locations and keep moving them around,” urged Ramsey.

A Google representative stood up during the Q&A period to remind attendees that the search engine’s ad platform has zero tolerance for counterfeiting, as well as infringing advertisers have even learned of the practice of keyword advertising is fleshed out by the courts. Livingston encouraged brand owners to incorporate social media on their sites to drive up Google search results. He suggested brands should engage in what he called “karmic marketing” that will inspire discussion on social media platforms about the brand and its competitors, rather than discounting or discounting competitors.

“You can ask us to monitor your trade marks in ad text and we will take down ads that infringe,” said the Google attorney.

She was followed by Professor Rebecca Tushnet of Georgetown University Law Center, who challenged the panel to explain why Rosetta Stone is accusing Google of direct—rather than contributory—trademark infringement in its case over keyword ads. Plaintiffs in keyword ad cases have argued that Google profits from the sale of the trademarks and is therefore directly, as well as secondarily, liable. But Tushnet asked the panel why Google is not then also liable for infringement when users click on legitimate links. “You can’t have it both ways,” she said.

Geoff Livingston, a marketing and search engine optimization expert who also spoke on the panel, said: “People don’t take the time today to discern quality information.” This makes it more crucial than ever to take creative approaches to marketing while the U.S. law on trademarks in keyword advertising is fluffied out by the courts. Livingston encouraged brand owners to incorporate social media on their sites to drive up Google search results. He suggested brands should engage in what he called “karmic marketing” that will inspire discussion on social media platforms about the brand and its competitors, rather than discounting or discounting competitors.

Plan your brand extension

Lawyers whose clients want to extend their brand need to ask themselves four key questions, said John Joseph Cheek, Caterpillar Inc., at a session yesterday.

Do they want to extend a name or a logo; a product configuration; a brand or a trademark? Whatever companies do, he said, they should have a clear plan.

He was outlining Caterpillar’s experience of extending its brand from heavy machinery into footwear and apparel by way of a licensing deal at a session entitled “The Living Brand: Borderless Extensions Limited Only by the Imagination, alongside two other in-house lawyers who have helped their companies boost revenues by extending into new product areas.

Cheek underlined the importance of doing thorough clearance checks to identify similar marks that are registered for the goods or services you intend to start selling. And he warned that phased brand extensions may “telegraph” where you are taking the brand. “Frequent and speculative filings are double-edged swords,” he said.

Coca-Cola’s campaign of polar bear charac ters reaching live to the Super Bowl through a dedicated website, CokePolarBowl.com. Pepsi was the official sponsor for the American football game this year, but Coca-Cola’s bears proved so popular that they upstaged their competitor. The two bears, each supporting a different team, reacted in real time to the game—and even left the room when an ad for Pepsi came on. Coke, which has 534,000 Twitter followers, saw a 12% increase in Twitter activity during the game.

That campaign was seen by yesterday’s speakers as something of a retaliation for Pepsi’s successful football ad during the 2010 World Cup in South Africa. The video, in which players such as Messi and Drogba played on a pitch created by hundreds of South Africans, was designed just to play online and became incredibly popular.

With that kind of competition between big brands, strong ambush marketing laws—such as those introduced by the UK ahead of this summer’s Olympic Games—are just one tool for brand owners. Everyone needs their own social media campaign.
Companies outside Europe could be forgiven for thinking that trademark law around the EU is relatively harmonized, given the EU-level directives and Community trade mark system. Attendees at the Regional Update session on Europe yesterday were reminded, however, that that is not the case with unregistered marks.

The speakers took the audience on a tour of European countries and their sometimes confusing court decisions, beginning in the Baltics. In Latvia, the AKVAPARKS chain of water parks stopped another company using the AKVAPARKS name for selling a line of clothing, even though the former had no registered mark and the goods were not similar. Another case between Latvia and Estonia, however, saw a former agent of the EVERMEN clothing line retain his trademark registration because the court considered the agent had made sufficient investment in the brand locally—and the EVERMEN company did not have a local registration.

In France, there is very little protection for unregistered marks. The example given was Denver Electronics, a company with European-wide sales that was sued in France after a local company registered the DENVER trademark. Denver Electronics registered a Community trade mark at the time, but lost the case in France, leaving “the rather strange situation where it has a valid CTM but cannot sell its product in France,” said speaker Marten Bouma of Merkenbureau Bouma.

Although there is no protection for unregistered marks as such in the Benelux, its trademark act does allow companies to bring an action based on bad faith. That case was illustrated by Unilever’s attempt to protect a taco-shaped ice cream. In Turkey, too, bad faith is a powerful weapon and the ROCKSTAR line of games used it successfully to cancel a similar mark.

“There is certainly a desire for harmonization, and that was recommended in the continued on page 4.

“For now my advice would be to assume that Europe is a bundle of countries, not a union, on unregistered rights.”

An Italian meal at GI session

“We now hand over to Paola Gelato of Studio Legale Jacobacci to talk about geographical indications in Italy. And I warn you, anyone that skipped lunch is going to find this difficult,” said chair Jaroslaw Kulikowski of Kulikowski & Kulikowski in Poland in yesterday’s session, Appellations d’Origine: Made in Europe. And so it proved.

Gelato ran the audience through some existing high-profile geographical indications (GIs) and the key cases that have formed legal practice on the issue. These included Pizza Napoletana, which recently received a Traditional Specialty Guaranteed (TSG) designation for its red, white and green toppings that mimic the Italian flag. Mozzarella di Bufala Campana is another example of a foodstuff with a TSG, which aims to protect traditional methods of manufacture rather than a particular region of origin.

Then it was onto the Balsamico di Modena and Salame Felino—important test cases—before Gelato explained that the Italian Consumer Protection Code was also a valuable tool in protecting GIs, as labels that mislead the consumer as to the origin of a product can lead to them being banned. Those products were honey, supposed to be from Mount Etna, and Lardo di Colonnata (bacon).

The talk was washed down with some Budweiser beer, both the Anheuser-Busch and Budvar varieties, as Gelato talked through the Italian leg of that series of cases, which led to the Budvar GI being rendered “null and void.”

Anders Jessen, Head of Unit for Public Procurement and Intellectual Property at the European Commission’s DG TRADE, spoke on the GI panel.

For now my advice would be to assume that Europe is a bundle of countries, not a union, on unregistered rights.”
When The Goodyear Tire and Rubber Company released its BIG FOOT TIRE, it didn’t realize that another, smaller company, Big O Tire, was already marketing a tire by the same name. The result was a court ruling in favor of Big O and an award of about US$5 million in damages—a hefty sum in 1977.

This was a classic case of “reverse confusion,” a situation in which the plaintiff bringing a trademark claim is either a much smaller player or its mark is less well known than the defendant’s. This often leads to consumers believing the senior user’s product is associated with the junior user. But some panelists in yesterday’s session on reverse confusion questioned whether distinguishing reverse confusion from traditional—or forward—confusion is helpful, or even fair.

“Is reverse confusion really a distinct problem?” asked Professor Roger Schechter of George Washington University. Schechter suggested it might be useful to require registration for a reverse confusion claim, or to limit monetary remedies if the senior, lesser-known mark was not registered to curb abuse, since some see reverse confusion cases as encouraging extortion or blackmail of large companies by smaller players.

“Should a small senior user be entitled to corner the market on a name, even where use is limited and there is no goodwill, for example, asked Rita Odin of The Estée Lauder Companies.

However, Schechter pointed out that doing away with the concept of reverse confusion would result in a negative incentive for big brands. “Larger companies would have no inhibition about taking a smaller users’ mark, so it’s wise to provide some degree of remedy or relief,” said Schechter. Robert MacDonald of Gowlings said that Canadian and UK courts have ignored the concept of reverse confusion for the most part, sticking to the traditionalal tests for actual confusion. “Canadian courts have said we’re not interested,” said MacDonald.

A red herring or appropriate remedy?

Continued from page 3. recent Max Planck study on the European trademark system,” said Bouna. “But for now my advice would be to assume that Europe is a bundle of countries, not a union, on unregistered rights. Protection is the exception. So register what you can.”

Ceylin Beyli of CBL Law Office in Turkey spoke to a slightly different topic at the end of the session: how much a trademark can be used in a modified form, but still qualify for use in order to maintain its registration. Although EU law is harmonized, requiring the mark not to lose its “distinctive character” in its modified form, there have been different interpretations. In the UK, supermarket Asda succeeded in having several registered marks for the Penguin range of biscuits canceled, as a counterclaim in a passing-off case.

Other examples from the Czech Republic, Denmark and Switzerland showed that an instinctive reaction to the marks didn’t always tally with the ruling in the case, with Beyli ticking or crossing off each comparison in turn. “I was particularly surprised by the CRYSTALEX case in the Czech Republic,” she said. So be warned that even when the law is harmonized, Europe can raise a variety of problems.

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World Trademark Review (WTR) is pleased to announce the winners of the WTR Industry Awards 2012, revealed last night at Washington DC’s National Museum of Women in the Arts.

The awards shine a spotlight on the vital work performed by in-house counsel across the globe and identify the teams and individuals that deserve special recognition for their exceptional achievements over the past year.

WTR congratulates the award winners on their success and thanks its law firm partners for all their assistance in hosting such a memorable event.

For more information about the awards visit booths 541 and 543 in the exhibition hall or go to www.Industry-Awards.com.
Making your mark the nontraditional way

There are signs that it is becoming easier to register nontraditional trademarks. But how useful are they for brand owners? A session today will compare practice in China, Europe and the United States, reports Emma Barraclough.

Sixteen years ago OHIM opened its doors in Alicante. The legislation that had created it also ushered in a new era for nontraditional marks in Europe. From now on, the Community trade mark regulation said, CTMs can be registered as long as they are capable of being represented graphically and of distinguishing the goods or services of one undertaking from those of another.

The flexibility that the legislation gave to OHIM is important, says João Miranda de Sousa of Spain’s J&A Garrigues. “A trademark is a message to a consumer that says ‘this is unique. It’s my product. Buy it,’” he says. “Legislation should not put additional obstacles in the way of companies when it comes to them finding ways to attract customers.”

Miranda de Sousa, a former Director of General Affairs and External Relations at OHIM, is one of the speakers at today’s session on nontraditional marks. He and Paul Ranjard of Wan Hui Da Intellectual Property Agency in China, Michael L. Gannon of 3M Company in the US and Shelley Watson of Chivas Brothers Limited in the UK will share their experiences of protecting nontraditional marks in different parts of the world and consider the best strategies for trademark owners.

In Europe, the Court of Justice’s decision in Sieckmann (see box) was instrumental in clarifying how trademark examiners at OHIM should apply European trademark law in practice. “The Court essentially said that the problem of nontraditional marks is a logical problem, not a conceptual one,” says Miranda de Sousa.

But those practical problems still remain when it comes to applying for olfactory trademarks in particular. How can smells be represented objectively? Is the smell of cut grass (once registered as a CTM but now lapsed) or of baking bread different in Finland than it is in Greece? It is important that IP offices are cautious when it comes to granting exclusive rights to trademark owners—which is one of the reasons why so few smell and sound marks have been registered, says Miranda de Sousa.

Further relaxation

Europe’s relatively liberal legislative approach to nontraditional trademarks could become even more relaxed. In December 2010 the Max Planck Institute, which had been asked by the European Commission to consider what changes should be made to Europe’s trademark system, recommended that law makers eliminate the notion of “graphic representation” from the requirements of trademark applications. Instead, any representation would be acceptable as long as it met the Sieckmann standards of being clear, precise, self-contained, easily accessible, intelligible, durable and objective. IP owners will find out whether the Commission accepted the recommendation when it publishes its proposals for changing the rules. This is expected next month.

But while trademark owners keen to obtain nontraditional marks may welcome any move to relax the rules, they—and the attorneys who advise them—should keep their ultimate commercial goals in focus, says Miranda de Sousa. That means honing in on what the client really wants: do they just want a trade mark certificate or do they need something to stop rivals encroaching on their rights?

“Legislation should not put additional obstacles in the way of companies when it comes to them finding ways to attract customers.”

“Even word marks can be very weak,” the former OHIM official says. “It’s not just about getting a mark on the register. It’s about the reaction you will get when you send someone a cease-and-desist letter.”

Key case: Sieckmann v. Deutsches Patent- und Markenamt

A decade ago Europe’s highest court ruled in a case referred to it by a German court seeking clarity over the need for a mark to be represented graphically. In its decision, the Court confirmed that a trademark may consist of a sign which is not in itself capable of being perceived visually (such as a sound or a smell), provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. It went on to say that for an olfactory sign, the requirements of graphic representation are not satisfied by a chemical formula, by a description in written words, by the deposit of an odor sample or by a combination of those elements.

(Nontraditional) trademark trivia

• The US Supreme Court case Qualitex Co v. Jacobson Products Co in 1995 established that color can qualify for trademark protection.
• Shape trademarks registered include the Coca-Cola bottle, Apple’s iPod and AT&T’s globe design.
• Sound marks include Nokia’s ring tone, Intel’s jingle and the MGM lion’s roar.
• The plumeria scent for sewing thread was registered in the US in 1990.
• Origanon’s attempt to register the taste of orange in the US and Eli Lilly’s bid to register a strawberry taste in the EU were unsuccessful.
• The German trademark office has registered a touch mark, consisting of a word written in Braille. The Coca-Cola bottle and Magilite torch have both been registered in Japan, after the country introduced the concept of 3D marks in 1997.

<table>
<thead>
<tr>
<th>Nontraditional mark</th>
<th>Number registered</th>
<th>Notes</th>
<th>Examples of the CTM and its owner</th>
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<td>Smell</td>
<td>0</td>
<td>Only seven have ever been applied for, five of which were refused, one withdrawn, and the one successful registration has since expired</td>
<td>Smell of cut grass (since expired)</td>
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<tr>
<td>Sound</td>
<td>124</td>
<td>Samsung Electronics, Intel, Green Flag Group and Lego</td>
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<td>Color</td>
<td>238</td>
<td>Bioclin and Eve Holdings</td>
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<tr>
<td>Hologram</td>
<td>2</td>
<td>Only nine hologram marks have been applied for</td>
<td></td>
</tr>
</tbody>
</table>

Registered nontraditional Community trade marks (March 2012)

Source: OHIM
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Both the Trademark Trial and Appeal Board (TTAB) and U.S. courts have been hard at work again this year on the topic of functionality. In the courts especially, judges seem to be grappling with the proper interpretation of the doctrines of utilitarian and aesthetic functionality for the second year in a row. Two important decisions seem to have clarified the functionality analysis in the courts for now, but a Federal Circuit ruling on the Board’s interpretation of the utilitarian functionality doctrine demonstrates that judges are still uncertain about where to draw the line between trademark-eligible subject matter and functional features.

A fix for functionality
One of the most notable recent developments on aesthetic functionality came from the Ninth Circuit in Fleischer Studios v. A.V.E.L.A., a case that had the trademark bar up in arms at last year’s Annual Meeting. In its February 2011 decision, the Ninth Circuit Court of Appeals had ruled that Fleischer didn’t adequately show it held the copyright to the well-known Betty Boop character and that A.V.E.L.A did not infringe Fleischer’s trademark because its use of Betty Boop to sell merchandise was functional.

That analysis is what The Trademark Reporter author and speaker in today’s Annual Review of U.S. Federal and TTAB Developments session, Theodore Davis of Kilpatrick Townsend & Stockton, refers to as a “defensive functionality” approach. This means the court was addressing claims that what the defendant did was not actionable because it was functional, rather than focusing on whether the plaintiff’s use of the mark was functional. INTA and many others argue the latter interpretation is proper.

A similar analysis was applied by the U.S. District Court for the Eastern District of Virginia in August 2010, when it ruled in Rosetta Stone v. Google that using trademarks as keywords to identify relevant sponsored links is a functional use, and that Google is therefore protected from infringement claims under the doctrine of functionality.

INTA attacked this analysis in its amicus curiae brief to the Fourth Circuit Court of Appeals.

But within the last year, both rulings have been replaced to the great relief of trademark owners and practitioners. The Ninth Circuit in August last year withdrew its original opinion in the Fleischer case and issued a new one that made no mention of aesthetic functionality. And in the Rosetta Stone case, the Fourth Circuit Court of Appeals struck down the district court’s functionality analysis, stating clearly that “the functionality doctrine simply does not apply in these circumstances.”

While those rulings have put some fears about a recent expansion of the functionality doctrine to rest for now, the Second Circuit Court of Appeals is still set to rule in Christian Louboutin v. Yves Saint Laurent, another closely watched case involving the interpretation of the functionality doctrine. The district court in that case ruled that a red sole on a shoe is functional and cannot be trademarked. Although Davis says this is a proper application of the functionality doctrine, he remains critical of the opinion. Says Davis: “My criticism is that it seems to be adopting a bright line rule that color can never function as a trademark in the fashion industry.”

“The dilution statute has been around for years and nobody knows what to do with it still.”

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and goats

TTAB and functionality

John Welch of Lando & Anastasi, who will be covering developments at the TTAB during today’s case law review session, will also be focused on functionality, particularly with respect to one recent case that Welch says “reopens a whole can of worms.”

In In re Becton Dickinson and Company, a divided panel of the Federal Circuit affirmed a TTAB decision refusing registration of a closure cap for blood collection tubes. The panel focused on how much of a design must be functional for it to be ineligible for trademark protection, and took two different approaches. The divide highlights the uncertainty about where to draw the line between patent and trademark protection. “The question is where to draw the line for purposes of Section 2(e)(5): how significant must these non-functional features or elements be to avoid the verdict that the design is functional ‘as a whole?’” says Welch.

Dilution and fraud

Welch will also highlight the Board’s recent approach to dilution, which he says is front and center there lately. “For the first 12 years of the dilution statute there were two cases where the Board found dilution, and in the last six months there have been three,” says Welch. One noteworthy case involved watch maker Rolex, which failed to prove dilution because it did not adequately show that the rival mark would have changed the marketing power of Rolex. “That was interesting because the mark had never been used, so I don’t know how they would have proven that,” notes Welch. He adds: “The dilution statute has been around for years and years and nobody knows what to do with it still. It’s inconsistent and shows the TTAB is really struggling with how to apply it.”

As for proving fraud at the TTAB—perhaps the hottest topic at the Board in recent years—since In re Bose Welch says such claims are dead in the water. “In the 32 months since Bose not a single fraud claim has been upheld,” says Welch. “It’s hard to get them to even look at the issue now.”

But that doesn’t mean fraud pleadings are less frequent. “People still plead it all the time because it’s an effective tool. It causes all kinds of heartache,” adds Welch. A claim of fraud can cause personal as well as professional angst, so the accusations continue despite the Board’s refusal to acknowledge them. Welch says he’d like to see the Board impose a rule to “stamp down” on such behavior. “They should pass a rule where if you plead fraud, an interlocutory attorney must participate in the settlement conference so they can kick it out right there,” says Welch.

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Scott Paintin is in charge of protecting intellectual property for Western Union, including the Washington D.C.-based Travelex Global Business Payments. James Nurton spoke to him.

**What is your background?**

I’m Vice President and Senior Counsel for Western Union and have been with the company for nearly eight years. I’m involved in the company’s IP matters, and I also have responsibility for supporting the marketing teams in the Americas, as well as the corporate affairs and privacy and data security functions.

I added IP work to the variety of work I handle in 2006. It was a very natural progression as I had been supporting marketing teams up to that point so when we spun off from First Data, it made sense to add IP, given my experience with trademarks and copyrights in marketing.

**Was IP new to you then?**

It’s something I’ve picked up over time. I didn’t focus on it previously, other than in relation to the marketing work. Now, quite a lot of my time is devoted to IP, given our portfolio. We have over 1,400 trademarks in 200 countries and territories, and we handle copyright and patent work, as well. I have five people on my team.

**What kind of trademark work do you handle in-house?**

Over time we’ve tried to bring more work in-house, as many other companies have given recent economic times and budget constraints. We use outside counsel for routine maintenance and interacting with foreign associates and also for the more challenging trademark and copyright matters. We do a lot of clearance in-house, but if it’s a large area, we’ll engage our outside counsel to get an opinion, as well.

**What are the biggest issues you face?**

The issues that we face are not very different from those faced by other famous brands. We monitor the Internet for unauthorized use of our marks and take action where there is a likelihood of confusion, dilution or tarnishment. We also do some trademark licensing, which we handle in-house, including with movie studios where we’re asked to include our trademark or logo in one of the scenes.

It’s product placement type work. We haven’t actively sought it, but studios have approached us. A cross-functional team internally looks at each request and decides whether we want our brand associated with the movie or the particular scene. Usually, we are able to see the script before we decide.

Other challenges come from operating on a nearly-global basis, and the laws being different from one country to another.

**What are the major brands?**

Our core marks are WESTERN UNION, the initials WU, our telegraph pole logo and our yellow and black trade dress. Some of those date back to 1856, when the Western Union name was introduced, signifying the union of multiple telegraph companies, including those in the Western-most regions of the U.S.

**Is it an advantage having such a long history?**

I think it’s an advantage. We have famous marks around the world, and that gives us extra tools when it comes to taking action against others who have inappropriately used our marks.

We run into a number of scenarios where people are trying to use our marks. The details vary. In a lot of cases, it involves companies trying to use marks in connection with financial services, but not always.

**Do you have particular challenges online?**

The Internet does present challenges in that it makes it easy for somebody to copy our materials, and that is a big challenge. There’s a fairly common misconception out there that if you find something on the Internet, you’re free to use it however you want.

Over the years we’ve put tools in place to monitor uses that we think are problematic. We’ve run across all kinds of challenges, from domain names that incorporate our marks to copying copyrighted materials from our webpages to using our marks in a manner that’s not authorized.

With the tools we have in place, we usually get a pretty good sense of what activity is happening and can deal with it internally or sometimes get outside counsel involved, as well.

**Do you have to make a lot of defensive domain name registrations?**

We do have some, but over the years we’ve taken steps to decide which ones it made most sense to keep and which ones to let go. So the defensive registrations today are not a large component of our domain portfolio.

**What about new gTLDs?**

We’ve been monitoring that and have had a series of conversations with our senior business leaders. Not surprisingly, we’re not in a position to say whether or not we have applied yet.

**What qualities do you look for in outside counsel?**

We have trademark counsel in the U.S. that we’ve been using for years and are very pleased with the services we’ve gotten from that firm. For matters outside the U.S., we go through that firm as they have an extensive network of foreign associates in the countries in which we operate.

**What makes them good?**

First of all, the managing attorney is outstanding, and she is a great business partner for us. She alerts us to appropriate matters, and we’ve developed a good working relationship with the firm over years. They also have a deep understanding of the business.

**What’s the connection with Travelex?**

We purchased Travelex Global Business Payments last year, and the services provided are very similar to those provided by another company we bought, Custom House. Both companies focus on cross-border business-to-business payments, including making payments and managing foreign exchange exposure. One of the tools is for law firms, and we always have a booth at the INTA Annual Meeting to showcase those tools.

**So you have a license to the TRAVELEX brand?**

There is a license agreement associated with the acquisition. We’re in a rebranding effort right now, but we’ll be using the TRAVELEX brand for a bit longer while that’s going on.

**Do you have any other major brands?**

We do have ancillary brands that are more regionalized, such as VIGO and ORLANDI VALUTA, and PAGO FACIL in South America.

**Is there a move towards global branding in the industry?**

I think so. Our focus in recent years has been to concentrate on the core, and we began an exercise several years ago where we really focused on the WESTERN UNION brand and developed sub-brands under that core.

**What do you like about IP?**

I love the diversity of the work. My team and I support all aspects of IP on a global basis. That keeps the work very interesting.

**What advice would you have for someone considering working in-house?**

I’d say make sure you have good outside counsel, and use every opportunity as a learning opportunity. Also make sure you remain close to the business, understand the strategy and where the company wants to take the brand and logo and any new products or services that might be introduced, as well as acquisitions. Also, have a good working relationship with the business teams.

**What other IP work do you do apart from trademarks?**

In addition to trademarks, I deal with copyright, patent and trade secret matters on a global basis.

**Have you been affected by patent trolls?**

We really haven’t seen anything like that relating to our core business. We’ve been fortunate in that respect, but I know a number of other companies that have been affected.
Your client is rolling out a new global brand, but budgets are tight so you need to decide which countries to protect in. Of course, you will register in your main markets but what about developing countries that may become important markets in the future? Is it worth obtaining registrations? Are there cost-effective and legally sound ways to do so using regional systems or the Madrid Protocol? And what can you expect from trademark offices if you do decide to register?

If you find yourself asking those sorts of questions, a session today on trademarks in Africa will be invaluable. The continent is home to more than 1 billion people, one-sixth of the world’s population. But it comprises 56 countries, with a variety of languages and legal traditions, so obtaining trademark protection is complicated. To make matters even more difficult, in some African countries it can take years to obtain a registration.

Marco van der Merwe of Spoor & Fisher, who is moderating today’s session, adds that many countries also have unfamiliar characteristics: “Many African countries still have their own classification system, with up to 56 classes, dating back to the nineteenth century.” And then there is South Sudan, a new country that as yet has no trademark law at all. In this case, advises van der Merwe, the best strategy is “belt and braces”: publish a cautionary notice stating your rights in a local newspaper to try to establish common-law rights. He says that such an approach has proven effective in countries such as Ethiopia in the past.

Despite the challenges, there are systems to help trademark owners. The Organisation Africaine de la Propriété Intellectuelle (OAPI) enables applicants to register marks in 16 French-speaking countries, while the African Regional Intellectual Property Organisation (ARIPO) has 18 English-speaking member states. Today’s session will discuss how both work, and van der Merwe says they provide contrasting scenarios: “OAPI works really well but ARIPO not quite so well, mainly because the national legislation of the participating countries hasn’t been amended.” Gift Sibanda of ARIPO will explain more in today’s session.

International trademark owners who use the Madrid System can also extend their rights to the 16 African countries that are members. But again there are problems in some common-law countries where there are doubts about whether the implementing legislation has been passed. It is important to be clear what the status is in each country, says van der Merwe: “In some registries, all those files from WIPO literally sit in a corner somewhere because the registry staff don’t know how to deal with them.”

This highlights a problem that afflicts many parts of Africa—lack of resources and outdated equipment. While there are countries such as Namibia that has a modernized system, and Zimbabwe where applications are published in about nine months, there are others where nothing happens to applications for two or three years. This can be frustrating, but van der Merwe says it is important to remain patient: keep records, help the office where you can (without telling them what to do) and support the local profession in their efforts to improve the infrastructure.

Van der Merwe emphasizes that most multinationals with global brands seek protection in the major African markets, as well as in those countries where they have local manufacturing. Some industries are also driven to register more broadly by local developments, such as the discovery of oil in Angola and gas and coal in Mozambique. The lesson is: with patience and a clear strategy, you can get protected.

CWO2 Regional Update-Africa takes place in room 147 AB at 10:15 am

Maximize protection in Africa

A panel today will discuss the best strategies for protecting your marks in Africa, as James Norton discovers.
IN TA Daily News 2012

Yesterday’s contest winner
Jeff Epstein of Cowan Liebowitz & Latman
Come to the IN TA Booth by 2 pm to claim your prize.
The answer was: The Senators left Washington after the 1971 season; the Nationals started playing here in 2005.

Visit the Exhibition Hall today for one more chance to win an iPad device! The hall is open till 2:00pm.

Previous winners:
Monday:
Colleen F. Goss, Fay Sharpe, Cleveland, Ohio, USA

Tuesday:
Patricia Hoet-Limbourg, Hoet Pelaez Castillo & Duque, Caracas, Venezuela

In-house Practitioners Reception Raffle Winners
Grand Prize: 2013 Annual Meeting Registration
Carolyn Dinberg, InterContinental Hotels Group

Forum Registration (excludes Annual and Leadership Meetings)
Tina Bondy, Big Fish Games

Registration to 2013 In-House Practitioners Luncheon and Workshop (during Annual Meeting)
Tim Woolsey, Hyatt
David McDonald, Abbott Laboratories
Angela Steele, McDonald’s Corporation

In-house Practitioners Reception

The African Intellectual Property Organization (OAPI) returns to the Exhibition Hall with a booth decorated in African style. A participant in IN TA activities for many years, the OAPI is the office of industrial property for 16 states of Central and West Africa.

CORRECTION Contrary to what was stated in yesterday’s issue, the northern indigenous people of Alaska refer to themselves as Eskimo. The northern indigenous people of Canada refer to themselves as Inuit.

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Successful IP protection in Mexico is about seeing pitfalls before they happen. In a regulatory environment that is not always predictable it’s necessary to employ foresight and offer alternative solutions – We built our practice on this principle.

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What are you most looking forward to next year?

Marinos Cleanthous, Christodoulos G. Vassiliades & Co, Nicosia, Cyprus I would like to see stability in the world and for the economy to develop again and people to feel secure. We need stronger IP laws around the world and better enforcement in general, and particularly on the Internet.

Ioana Draquilin, Rominvent, Bucharest, Romania Romania has been in the EU since 2007 but we expect use of the Community trade mark among Romanian companies to grow. It’s a more efficient way for Romanian companies to get protection in the EU.

Guoping Liu, Runping & Partners, Beijing, China I expect to see more training programs especially for people who are new to IP. Chinese companies are paying more attention to IP and I hope there is the opportunity for more people to attend training programs in China.

Ramesh C. Dhawan, Lall Lahlri & Salsotra, Gurgaon, India I’m looking forward to India switching to the Madrid Protocol. That is long overdue but the Registry is now making preparations to meet the timelines. It is always unpredictable where politics is concerned, but I hope it will be decided by the end of this year. Indian companies are exporting more and I expect many companies will use this system.

Sudarshan Kumar Bansal, United Overseas Trade Mark Company, New Delhi, India In the coming year there will be greater awareness of IP laws among business, lawyers and young people. IP will become a central part of business strategy, rather than a side issue. More people will use IP as a business tool to generate profitability and market access throughout the world.

Chilako Hashimoto, Chilako Hashimoto & Associates, Tokyo, Japan I hope the economic situation will improve. When there is a recovery, that will have a big impact on IP and trademark work.

Nicoleta Tarchila, Cabinet Enpora, Bucharest, Romania We’re hoping for more newly filed trademark applications. National applications from foreign clients have diminished since Romania joined the EU so we are fighting for national clients and looking for more Community trade mark work.

Howard M. Gitten, Edwards Wildman, West Palm Beach, U.S.A. I’m always looking for that one big, unexpected case—the Black Swan. For me the most interesting cases turn on their facts and you can never be sure when they will turn up. But at the moment the Internet seems to be generating a lot of them.

Reene Xavier, Alpha Omega, Singapore I work with a lot of southeast Asian companies and I am looking forward to an increased awareness of IP assets and how much revenue they can achieve. There is a lot of education to do. The Singapore government funds IP strategy and IP audits, but despite that many companies don’t take full advantage.

Pedro Alberto Jedicka Z., Markven, Caracas, Venezuela In Venezuela, we look forward to becoming part of a regional treaty, but it is not clear whether that will be the Andean Community or Mercosur. We need to become clear. It will have a huge impact for IP, especially if we go back to the Andean Community. Another thing we hope for is that the government will take patents seriously.

David Lopez, SICPA Holding, Prilly, Switzerland We used to have our work centralized in Asia and we are changing to having an individual presence in each country. We’re removing the middleman and we hope we can get more quality information by direct communication. We have formalities systems in place so we hope the change will be smooth.

Ram esh C. Dhawan, Alfa Omega, Singapore I expect to see more training programs, especially for people new to IP.

Sw itzerland

Trademark Expo should submit an application by May 18, 2012. Apply online at www.uspto.gov/TMExpo

Exhibitors are invited to showcase their federally registered trademarks through educational exhibits, including booths, themed displays, costumed characters, and inflatables. In addition, the Expo features educational seminars for adults, and children’s workshops and activities.

Space is limited, so owners of federally registered trademarks who wish to participate in this year’s Trademark Expo should submit an application by May 18, 2012. Apply online at www.uspto.gov/TMExpo

Applications to exhibit at the Expo will be evaluated on the following criteria:

• Brand recognition among consumers

• Ability to engage the public’s interest in trademarks

• Educational value of the proposed exhibit to enhance public understanding of the value of trademarks

• Category diversity, in particular whether an applicant’s participation helps ensure that the Expo will feature a variety of different types of trademarks from different sources

Applications will be reviewed by the National Inventors’ Hall of Fame on a rolling basis. Those applicants who are selected to exhibit in the Expo will be notified by June 15, 2012.

For non-press inquiries, please email TMExpo@uspto.gov or contact Susan Hayash at (571) 272-9362, Lana Pham at (571) 272-9478 or Carol Spils at (571) 272-9226.
Today’s Schedule | Wednesday, May 9, 2012

All events take place at the Washington Convention Center (WCC) unless otherwise indicated. Consult the Final Program for times and locations of invitation-only events.

<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Location</th>
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<tbody>
<tr>
<td>7:30 am – 2:00 pm</td>
<td>REGISTRATION East Registration</td>
<td>Hall D</td>
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<tr>
<td>7:30 am – 4:00 pm</td>
<td>HOSPITALITY</td>
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<tr>
<td>8:00 am – 10:00 am</td>
<td>BREAKFAST TABLE TOPICS</td>
<td>150 AB</td>
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<td>8:00 am – 10:00 am</td>
<td>FDA Executive Council</td>
<td>144 AB</td>
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<tr>
<td>9:00 am – 10:00 am</td>
<td>PUBS Group Council</td>
<td>143 A</td>
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<tr>
<td>10:00 am – 11:00 am</td>
<td>India Business Group</td>
<td>144 AB</td>
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<td>10:00 am – 2:00 pm</td>
<td>EXHIBITION HALL</td>
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<td>10:00 am – 2:00 pm</td>
<td>Tour Booth</td>
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<td>10:15 am – 11:30 am</td>
<td>CONCURRENT SESSIONS</td>
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<td>10:30 am – 11:30 am</td>
<td>SPEED NETWORKING</td>
<td>146 ABC (overflow: 145 AB)</td>
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<tr>
<td>11:00 am – 12:00 pm</td>
<td>North America Council</td>
<td>147 AB</td>
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<tr>
<td>11:45 am – 1:00 pm</td>
<td>CONCURRENT SESSIONS</td>
<td>144 ABC</td>
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<tr>
<td>12:00 pm – 1:00 pm</td>
<td>SPEED NETWORKING</td>
<td>Hall D</td>
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<td>1:15 pm – 3:15 pm</td>
<td>LUNCHEON TABLE TOPICS</td>
<td>150 AB</td>
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<td>7:00 pm – 11:00 pm</td>
<td>GRAND FINALE: INTA Headliners</td>
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Shuttles depart from hotels beginning at 6:45pm