Africa
INTA Makes Significant Inroads in Nigeria Through Advocacy Outreach

Europe
Brexit: With a Draft Deal in Place, IP Owners Await Final Approval

North America
Washington, D.C., Office Prepares for 116th Congressional Session
Celebrating Accomplishments and Looking Ahead

This Global Report marks the end of my term as INTA President and comes soon after the 2018 Leadership Meeting, which convened in New Orleans, Louisiana, USA, November 6–9. The Leadership Meeting was a wonderful opportunity to reflect upon the accomplishments of the past year; to honor members of the INTA community with the Tomorrow’s Leader Awards, Volunteer Service Awards, and the President’s Award; and to outline what lies ahead for 2019, with an emphasis on corporate social responsibility (CSR) and membership engagement.

As the pages ahead demonstrate, INTA staff and volunteers were exceedingly busy leading up to and after the Leadership Meeting. For example, in Africa, the Association engaged in intensive outreach campaigns in Nigeria and East Africa. In the Asia-Pacific, INTA’s growing team reached every major jurisdiction in the region and hosted more than 200 delegates in Sydney, Australia, for INTA’s two-day 2018 Asia-Pacific Conference: Looking Beyond Trademarks, which took place October 11 to 12, and in China specifically, this year’s level of activity was record-breaking and the Association is well-positioned to monitor the many government and policy changes that are underway there. In Europe, although the unrelenting activity around Brexit has kept the team on its toes, it still managed to take part in dozens of events across the region during this last quarter of the year. In Latin America, a number of events focusing on brand restrictions and engagement with judges have helped to bolster INTA’s influence on key policy issues; and in North America, the Association is focused on continued engagement in the upcoming 116th U.S. Congress, as well as monitoring implementation of Canada’s new Cannabis Act and Regulations, which includes brand restrictions.

With thoughts on the year ahead, I look forward to seeing you all soon at the 2019 Annual Meeting, which will be held in my hometown of Boston, Massachusetts, USA. I would like to thank all of the INTA family with whom I have had the pleasure of working so closely with this year and who made my INTA presidency such an enjoyable and productive one. See you in Boston!
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INTA Makes Significant Inroads in Nigeria Through Advocacy Outreach

INTA Representative, Africa, Middle East, and Inter-Governmental Organizations, Tat-Tienne Louembe, engaged with key policymakers during the week of October 22, in Abuja, Nigeria. Building on the work undertaken by local members, the advocacy tour was an interesting opportunity to further engage with key stakeholders.

Thanks to the efforts of Akeem Aponmade (A.O. Aponmade & Co., Nigeria), a member of INTA’s Enforcement Committee, discussions took place with Jonathan Gunu Taidi, the recently elected General Secretary of the Nigerian Bar Association (NBA). With a membership of more than 105,406 lawyers active in 125 branches across the 36 Nigerian states, the NBA is a professional, nonprofit, umbrella association whose members are lawyers. In line with previous interactions, Mr. Taidi was keen to learn about cooperation with INTA. He expressed the NBA’s commitment in expediting the organization of a training for Nigerian lawyers and judges on trademarks and related rights. He also invited INTA to attend the NBA’s Annual Conference in 2019.

In a meeting with Abubakar Malami, Attorney General and Federal Minister of Justice, INTA was briefed on the latest developments pertaining to the adoption of the Industrial Property Commission (IPCOM) bill. The legislation is expected to revamp the IP infrastructure in Nigeria and hence help the country to diversify its economy through the development of a vibrant non-oil industry. In addition, accompanied by INTA member Davidson Oturu (AELEX, Nigeria) and staff from the Federal Ministry of Industry Trade and Investment, Mr. Louembe met with Justice Rosaline Bozimo, Head of the National Judicial Institute (NJI). The institution serves as the principal focal point of judicial activities relating to the promotion of efficiency, uniformity, and improvement in the quality of judicial services in the superior and inferior courts in Nigeria. During the meeting, the participants agreed to step up efforts to organize a workshop for judges on trademarks as a way to increase their expertise in this field and to facilitate knowledge sharing.

At the Federal Ministry of Industry, Trade and Investment, the INTA team met with Okechukwu Enyinna Enelamah, Federal Minister of Industry, Trade and Investment, and explored ways to streamline service delivery within the Industrial Property Office. In the same vein, Mr. Louembe had a one-on-one meeting with the new Registrar of the Industrial Property Office, Shafiu Yauri, who expressed his strong willingness to work with INTA on capacity building activities and other means to meet the demands of various national and international users. Last but not least, the team met with Mohammed Babadende, Chief IPR Unit Nigeria Customs Services (NCS). Among other topics, the Customs Service proposed greater collaboration between the Trademarks Registry and customs.

Informal meetings took place with senior officials, including the Commissioner of Trade and Industry and the Commissioner of Human Resource, Science and Technology, of the African Union; Technical Advisers of the Minister of Industry, Trade and Investment; officers at the Ministry of Industry, Trade and Investment dealing with trade matters; and government officials at the Nigeria Export Processing Zones Authority (NEPZA) in charge of free trade zones.

Association Updates

INTA Advocates in East Africa

On August 20, Tat-Tienne Louembe, INTA Representative, Africa, Middle East, and Intergovernmental Organizations, visited the key East African jurisdictions of Ethiopia and Kenya.

Following up on an INTA delegation to Kenya earlier this year, the trip was an opportunity to reiterate INTA’s commitment to working with government officials, private sector representatives, and members in this vital region.

Meetings with High-Level Officials in Kenya

In Kenya, discussions were held with senior officials at the Ministry of Trade and Industry on the fight against illicit trade and enhancement of the intellectual property (IP) infrastructure. A meeting...
INTA held fruitful talks on ways to educate consumers on counterfeits and to protect and promote traditional African products in the area of traditional medicine.

Engaging on IP Policy in Ethiopia
In Ethiopia, at the Ministry of Science and Technology, Mr. Louembe met with Shumete Gizaw, State Minister of Research and Technology, and Ermias Yemane, Director of the Ethiopian Intellectual Property Office. The discussion revolved around INTA’s April comments on Ethiopia’s IP policy and the government’s constructive efforts in securing the rights of IP owners.

Ms. Okoth (Gikera & Vadgama, Kenya) spoke about the work of the Anticounterfeiting Committee and the economic and social impacts of counterfeiting and piracy. She also spoke about the harms that counterfeit products pose to the health and safety of consumers worldwide.

Anticounterfeiting Committee Participates in Kenya Trade Exposition
From July 30 to August 3, 2018, INTA participated in the second Kenya Trade Week & Exposition, held in Nairobi, Kenya. The theme for this year’s exposition was “Powering Kenya Big 4 Agenda Through Trade.” Hazel Okoth (Gikera & Vadgama Advocates, Kenya), member of the Anticounterfeiting—Middle East & Africa Subcommittee, represented INTA at the exposition, which drew more than 5,000 delegates from the private and public sectors. Ms. Okoth spoke on a panel focused on “Best Practices in Combating Illicit Trade: An International Perspective,” organized by the Anti-Counterfeit Agency of Kenya. Ms. Okoth spoke about the work of the Anticounterfeiting Committee and the economic and social impacts of counterfeiting and piracy.

Ms. Okoth referred to the INTA—International Chamber of Commerce (ICC) BASCAP impact study, “The Economic Impacts of Counterfeiting and Piracy,” to demonstrate the growth of counterfeiting globally, and concluded by recognizing the efforts of the Kenyan government in working with the private sector to curb illicit trade and the flow of counterfeit goods. She encouraged all stakeholders to work together in combating the flow of counterfeit goods.

In the News
AFRICAN UNION: Execution of the Agreement Establishing the African Continental Free Trade Area
The member states of the African Union (AU) entered into an agreement establishing the African Continental Free Trade Area on March 21, 2018. The African Union is a continental union consisting of all 55 countries on the African continent that is aimed at integrating Africa’s market and accelerating the socioeconomic integration of the continent.

The African Continental Free Trade Area (AfCFTA) Agreement, which was signed by 44 of the 55 member states of the AU in Kigali, Rwanda, is subject to ratification/accession by all of the member states.

The AfCFTA Agreement covers trade in goods and services, investment, intellectual property (IP) rights and competition policy. It is a condition of the AfCFTA Agreement that member states will need to enter into phase two of negotiations concerning IP rights, competition policy, and others, which will be undertaken in successive rounds. The AfCFTA Agreement will also develop protocols for IP rights and dispute resolution, which will be included subsequently as annexes to the AfCFTA Agreement.

The AfCFTA Agreement and the protocols on trade in goods and services, IP rights, competition policy, and any other instrument within the scope of the AfCFTA Agreement will enter into force 30 days after the deposit of the 22nd instrument of ratification. For members acceding to the AfCFTA Agreement, it will enter into force on the date the instrument of accession is deposited at the AU.

The AfCFTA Agreement, if ratified by member states, will create a single market in which free movement of people, goods, and services will be established. It will grant business entities better and effective access to AU member states' markets and reduced import tariffs. It will also be instrumental in reducing the challenges of multiple and overlapping trade regimes currently faced by business owners, including IP owners, in the protection of their IP rights in the various jurisdictions.

It is noteworthy that a few AU member states, such as Nigeria, have refused to sign the AfCFTA Agreement, as its stakeholders in the manufacturing sector hold the view that there are some perceived unfavorable provisions. This position may change over the course of time if the parties are able to resolve their concerns.

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continued on page 6
In the News  continued from page 5

**BOTSWANA: Companies and Intellectual Property Authority Relocated**
The Botswana Companies and Intellectual Property Authority (CIPA) moved to a new location on September 28, 2018, and became fully operational on October 29, 2018.

**ESWATINI: The Kingdom of Swaziland Is Now the Kingdom of Eswatini**
Swaziland, one of Africa’s smallest countries, has changed its name. On April 19, 2018, the monarch, King Mswati III, announced that the country would change its name from the Kingdom of Swaziland to the Kingdom of Eswatini. The country is now known as the Kingdom of Eswatini.

The decision was published in the official gazette, Legal Notice no. 80 of 2018, on May 11, 2018, which states that all reference to the Kingdom of Swaziland in any written laws, international agreements, and legal documents shall be construed and read to reference the Kingdom of Eswatini.

The Kingdom of Eswatini (formerly the Kingdom of Swaziland) is a member state of the World Intellectual Property Organization (WIPO), a member of the Madrid Protocol, the Paris Convention, and the African Regional Intellectual Property Organization (ARIPO) regional registration system. The Kingdom’s WIPO ST.3 County Code remains SZ following the name change.

**KENYA: SONY Trademark Decision Not a Threat to Well-Known Brands**
On May 29, 2018, the High Court of Kenya rendered judgment in Sony Corporation v. Sony Holdings Limited [2018] eKLR. Media reports, taken in the context of recent cases emanating from the High Court, suggested that well-known brands were under threat in Kenya.

Sony Corporation had registered and used the SONY brand in Kenya in Classes 9, 35, 36, 38, 39, 40, 41, and 42. On the other hand, Sony Holdings Limited applied to register SONY HOLDINGS in Classes 12, 16, 25, 35, 36, 37, 39, and 45.

Sony Corporation opposed the applications on grounds that SONY was not only registered in Kenya, but was also a well-known mark.

Interestingly, the Assistant Registrar had, during the opposition proceedings, found that: both marks were similar; there was an overlay with respect to Classes 35, 36, 37, and 39; and there was bound to be actual or likelihood of confusion. Despite these observations, the Assistant Registrar dismissed Sony Corporation’s opposition and allowed Sony Holdings’ mark to proceed to registration in all the classes, including those in which Sony Corporation’s marks were already registered. Sony Corporation then appealed to the High Court.

The High Court expressed its profound reluctance to interfere with the Registrar’s ruling, reiterating the well-established principle that the Registrar is a specialized quasi-judicial tribunal staffed by officers who are competent in the technical fields falling under their jurisdiction. As such, the Court would only disturb the Registrar’s ruling if it was so manifestly unreasonable that no reasonable tribunal could have arrived at such a decision.

The Court also agreed with the Registrar that due to the insufficient evidence filed by Sony Corporation, there was no basis upon which the Registrar could take judicial notice of the fact that SONY was a well-known trademark in Kenya. The Court implied that, had Sony Corporation filed the requisite evidence to prove the well-known status of its mark in Kenya, the Registrar would probably have invoked the doctrine of judicial notice and found that the mark was well known. The court further noted that Sony Corporation failed to invite the Registrar to take judicial notice of the well-known status of the mark in Kenya.

In the absence of cogent evidence and failure by Sony Corporation to plead the doctrine of judicial notice, the Registrar’s hands were tied, hence the undesirable outcome of the opposition proceedings.

Finally, the Court agreed with the Registrar that Sony Corporation had failed to prove its global ownership of the marks by not attaching copies of the certificates of registration from the various countries where it claimed to have registered the marks.

In the end, however, the Court held that the Registrar was wrong in allowing the registration of Sony Holding’s mark to proceed in the classes already registered by Sony Corporation and ordered that Sony Holdings Ltd’ applications relating to the classes covered by Sony Corporation’s trademarks (Classes 35, 36, 37 and 39) should not proceed.

Therefore, contrary to widespread media reports, Sony Corporation’s registrations in Kenya remain intact. Both parties have filed notices of appeal, although the actual cross appeals have yet to be filed.

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NAMIBIA: New Industrial Property Act Has Far-Reaching Implications

The long-anticipated Namibian Industrial Property Act, 2012 came into effect on August 1, 2018, and has introduced important changes to the protection and enforcement of trademarks and other intellectual property (IP) rights in Namibia.

This Act governs the registration, protection, and administration of patents, utility models, industrial designs, trademarks, collective marks, certification marks, and trade names. It repeals the Patents, Designs, Trade Marks and Copyright Act, 1916; the Patents and Designs Proclamation, 1923; the Patents, Trade Marks and Copyright Proclamation, 1940; and the Trade Marks in South West Africa Act, 1973, and is aimed at ensuring compatibility of national laws with the international legal framework.

The Act brings about significant changes to the administration of trademarks in Namibia. For instance, multiclass trademark applications can now be filed and priority, as provided for under the Paris Convention, can now be claimed. Another change is that trademarks accepted by the Registrar in terms of the Act will now be published under the newly established Bulletin, rather than in the national Government Gazette.

The Act also resolves the uncertainty in Namibia regarding the validity and enforceability of registrations filed under international and regional systems, such as the Madrid Protocol and the Banjul Protocol.

Another important development is the introduction of the hypothecation and attachment of industrial property titles for the purposes of providing security to creditors and to confirm jurisdiction. This can be useful when legal proceedings are instituted in Namibia against foreigners.

The Act further provides for the recordal of a voluntary license with respect to a trademark application or registration. A voluntary license agreement must be in writing and signed by the licensor. Furthermore, the license agreement should provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used, failing which, the license is invalid. The Registrar is required to publish the grant of a voluntary license in the Bulletin.

Infringement proceedings under the new Act will now be brought before the newly established Industrial Property Tribunal. The Tribunal will consist of two members who have skill, knowledge, or experience in economic, financial, or IP matters, as well as a person with legal qualifications and at least five years’ experience in practice. Decisions of the Tribunal may further be appealed to the High Court of Namibia.

Another noteworthy amendment is the period of non-use, which has been amended from five years to three years, effectively making it easier to remove trademarks that are not used in Namibia.

Lastly, the regulations to the Act provide for revised prescribed forms and a considerable increase in the official fees payable with respect to all forms of IP. Such fees are no longer payable by affixing the appropriate stamp duty, but rather must be paid in cash, money order, or electronic transfer.

NIGERIA: Release of Four Trademark Journals

After the release of six online journals in February 2018, the Nigerian Trademarks Registry published four more journals on April 24, 2018, three of which are for trademarks filed electronically and one for manually filed marks.

The Nigerian journal numbering system for electronically filed trademarks has different volume numbers than those used for manually filed trademarks.

The four journals released on April 24 are numbered:

- Volume 1, Nos. 7–9, for electronically filed marks; and
- Volume 6, No. 1, for manually filed marks—the first for 2018

The period for opposing these marks expired on June 25, 2018. This was the first working day after the expiry of the two calendar months’ opposition period.

The next step is for sealing fees to be paid for the registration certificates to issue.

Hard copies of these journals may only be accessed from the Registry, subject to payment of a fee.

It is hoped that this publication trend will continue, thus reducing the backlog of pending trademark applications.

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Reaching New Jurisdictions, Emphasizing Cooperation

INTA’s activities in 2018 reached every major jurisdiction in the Asia-Pacific region, and included cooperation with governments in each jurisdiction across the spectrum on IP-related departments, from IP offices to customs and police. Additionally, INTA’s activity in 2018 had a strong emphasis on cooperation with multi-lateral organizations such as the World Intellectual Property Organization (WIPO), the International Criminal Police Organization (INTERPOL), the World Customs Organization, the Asia-Pacific Economic Cooperation (APEC), and the Association of Southeast Asian Nations (ASEAN).

In Northeast Asia, beyond the Association’s record-breaking level of activity in China (see China chapter, page 12), INTA most recently organized the first Korean Intellectual Property Office (KIPO)-INTA Trademark and Design Protection Symposium during the KIPO Trademark and Design Week on October 29. Panelists came from Cambodia, Malaysia, and Sri Lanka, Customs, as well as representatives of INTA’s Anticounterfeiting Committee.

In Southeast Asia, INTA’s 2018 activities were extensive. Major focus was placed on anticounterfeiting, with policy dialogues held in the Philippines, Singapore and Thailand, brand restrictions with large scale awareness seminars in Cambodia, Indonesia, Singapore, and Thailand, and further harmonization of trademark law and practice with capacity and training events held with partners in Indonesia, Laos, Myanmar, and Vietnam.

A special focus of INTA’s activity in ASEAN was placed on Indonesia, the largest economy in ASEAN, where INTA most recently held a widely covered workshop on the dangers of fakes in the automotive and lubricants industry. This marked the first time that an international IP association organized such a workshop with representatives of Indonesia’s police.

In Oceania, INTA’s annual Asia-Pacific Conference was held successfully in Australia, accompanied by a high-level policy dialogue on anticounterfeiting in Sydney. Additionally, INTA engaged numerous Pacific island countries, such as Samoa and Papua New Guinea, through joint programming with WIPO and APEC and made a submission to the regional harmonization body, the Pacific Island Forum, encouraging the countries of the Pacific basin to utilize trademarks to unlock economic growth and creativity.

INTA’s work in South Asia outside of India continued to grow in 2018 as well, with INTA’s first delegation visit to Nepal, and submissions to governments in the region on trademark law amendments in Nepal and the Maldives.

In 2019, INTA will continue its multilateral and bilateral cooperation with governments, inter-governmental organizations, NGOs, associations, and businesses to promote trademarks.

Key projects will include building awareness on Internet and digital issues in the lead-up to the ICANN meeting in Kobe, Japan; further cautioning against countries again brand restrictions; strong emphasis on cross-border anticounterfeiting, including leading the organization of a keystone summit on the role of IP offices on enforcement; energizing students around IP through the second annual INTA Asia Moot Court Competition; and conducting the Asia-Pacific Conference in Malaysia in October 2019. These activities will build anticipation for and culminate in the 2020 Annual Meeting in Asia, to be held in Singapore from April 25 through 29, 2020.

Seth Hays, Chief Representative Officer, Asia-Pacific

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More than 200 delegates gathered in Sydney, Australia, for INTA’s intensive and productive two-day 2018 Asia-Pacific Conference: Looking Beyond Trademarks, from October 11 to 12. The Conference covered an exciting balance of traditional trademark material (for example, anticounterfeiting strategies and enforcing trademark rights against unauthorized ad words and metatags) together with highly informative sessions on hot topics such as data privacy, corporate social responsibility, 3D printing, and ambush marketing.

Themes
Several key themes emerged over the two-day conference. In particular, the benefit of working in partnership was a recurring message. Brand owners can strengthen their position against infringers by working in partnership with border protection officials, intellectual property (IP) offices, and online retailing platforms.

INTA CEO Etienne Sanz de Acedo spoke in his opening address about INTA’s desire to embrace innovation and to assist its members in doing likewise. This became another theme, as the IP offices of Australia, New Zealand, and Singapore are planning ahead to ensure that their systems are equipped to meet the changing pace of innovation. Attorneys and brand owners must also adapt to new technologies.

INTA Leaders Participate in Events Throughout Southeast Asia
From August 30 to September 7, INTA President-elect David Lossignol (Sandoz International GmbH, Germany) represented INTA at a series of events in China and Southeast Asia. Following the events in China, Mr. Lossignol participated in Singapore’s IP Week.

On the opening day of Singapore’s annual international intellectual property (IP) event, IP Week @ SG 2018, Indranee Rajah, Singapore Senior Minister of State, Ministry of Law, presented the prestigious World Intellectual Property Organization (WIPO)-IP Office of Singapore (IPOS) IP Awards to six outstanding local enterprises that used IP effectively to take their innovative technology, brands, and content to the world.

Engaging the ASEAN Working Group on Intellectual Property Cooperation
The ASEAN Working Group on Intellectual Property Cooperation (AWGIPC) is the sectoral group responsible for IP issues in the region. It is composed of the IP offices of the ASEAN member states. INTA hosted a luncheon to gather the AWGIPC representatives and organized a “lunch and learn” session on the topic of the use of artificial intelligence in IP.

Valentina Salmoiraghi Joins INTA as Advisor, Anticounterfeiting, Asia-Pacific
INTA is pleased to announce that Valentina Salmoiraghi has joined INTA as Advisor, Anticounterfeiting, Asia-Pacific, working from the Asia-Pacific Representative Office in Singapore.

Ms. Salmoiraghi drives the regional anticounterfeiting implementation and advocacy activities in the Asia-Pacific region, working closely with the Asia-Pacific and China Anticounterfeiting Subcommittees and INTA Headquarter Anticounterfeiting Committee staff to achieve goals and objectives according to INTA’s Strategic Plan.

INTA’s Asia-Pacific Representative Office, based in Singapore, represents the Association’s 815 members across the region. Working in collaboration with staff at INTA’s headquarters in New York City, the Asia-Pacific Representative Office leads the Association’s policy, membership, marketing, and communications initiatives throughout this region.

Valentina Salmoiraghi, Advisor, Anticounterfeiting, Asia-Pacific

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INTA Hosts Policy Dialogue in Bangkok

On August 20, INTA’s Anticounterfeiting—East Asia and Pacific Subcommittee held its policy dialogue with the Department of Intellectual Property (DIP) and the Royal Thai Customs at Tilleke and Gibbins’ offices in Bangkok. The event was co-organized with the Intellectual Property Association of Thailand (IPAT) and the law offices of Tilleke and Gibbins International Ltd. and was well attended by representatives from the DIP, Thai Customs, Homeland Security Investigations, as well as trademark owners, intellectual property (IP) practitioners and private IP investigators. The main objective of the dialogue was for trademark owners and other IP stakeholders to learn of the challenges others have faced when dealing with customs cases or online infringement against counterfeit products, as well as to learn of any successful solutions or activities by other participants.

Chakra Yodmani, Director of IP Promotion and Development Division of the DIP, spoke about Thailand’s recent awareness campaign on enforcement, including the 20-year Intellectual Property Roadmap published by the DIP in January 2017. The IP Roadmap specifies developments in a number of areas, including more effective enforcement by improving efficiency and coordination.

Anticounterfeiting Activities Throughout Asia

In July and August, INTA held policy dialogues in Manila, the Philippines, and in Bangkok, Thailand, engaging local customs officials on the topics of border measures, online counterfeits, and small parcel consignments. These are topics of concern for INTA members globally, and INTA has developed best practice papers to support the dialogue and discussion among members, local authorities, and other key players, as well as to support INTA’s advocacy efforts on domestic legislation.

Meeting with Singapore Customs

INTA’s engagement with customs officials also included a delegation of Anticounterfeiting Committee brand owner and IP practitioner representatives, including INTA President-elect David Lossignol (Sandoz International GmbH, Germany). They met with Singapore Customs in early September to discuss the amendments to the new Intellectual Property (Border Enforcement) Bill passed on July 9, 2018, in relation to seizures on exported goods from Singapore upon the rights holder’s request, and cooperation between brand owners and customs to share information relating to the seizure or detainment of infringing goods. Possible cooperation or support that INTA may offer to facilitate smooth implementation of the bill and to reach out to brand owners in relation to the new changes, as well as the provision of product identification trainings, were proposed and discussed during the meeting.

Growth in ASEAN

INTA also prioritizes IP enforcement–related initiatives at the regional level, and in August participated in the third meeting of the ASEAN Network of IPR Enforcement Experts (ANIEE) as a resource for a consultation session chaired by the Director General of the Intellectual Property Office of the Philippines, Josephine Santiago. INTA’s membership presence in ASEAN is continuously growing, making ASEAN a very important region to monitor and to build cooperation and partnerships, especially in relation to anticounterfeiting matters. INTA is aware and supportive of the important role of IP offices in IP rights enforcement worldwide, and especially for IP office directors from the Asia region, where there are increasing challenges due to increased trade opportunities.

INTA Participates in Events in Indonesia, Malaysia, Papua New Guinea, and Singapore

On August 8, INTA took part in discussions at a workshop of the Asia-Pacific Economic Cooperation (APEC) Intellectual Property Experts’ Group and Customs Subcommittee on trademark infringement determinations in a cross-border context. The workshop took place in the context of the Senior Officials Meeting in Port Moresby, Papua New Guinea.

INTA member Lynell Tuffery Huria (AJ Park, New Zealand) presented on judicial case decisions on determining confusingly similar trademarks. Government representatives from Papua New Guinea, Peru, South Korea, and the United States covered topics such as best practices to prevent the commercial-scale trade in infringing goods, existing practices, and risk assessment techniques. Other industry associations involved in the workshop included CropLife Asia.

First Delegation Visit in Papua New Guinea

INTA also organized a delegation visit to the
Asia-Pacific

Intellectual Property Office of Papua New Guinea, marking the first time the Association has organized a member delegation in the country. INTA introduced the work it does on trademark office practices, harmonization of law and practice across the region and globe, as well as certain issue areas of interest to the Office, namely the research and monitoring of developments around indigenous rights.

INTA emphasized the important, and often overlooked, role of trademarks and brands as drivers of innovation, growth, and investment in developing countries, such as Papua New Guinea. INTA also noted the recent submission to the Pacific Island Forum (PIF), emphasizing the important role that trademark protection and enforcement can play in the economic development of the PIF member states, which includes Papua New Guinea.

**In the News**

**AUSTRALIA:** World Trade Organization Upholds Australia’s Tobacco Plain Packaging Legislation

On June 28, 2018, the World Trade Organization (WTO) dispute settlement panel handed down its decision finding that Australia’s legislation requiring tobacco products be sold in plain packaging does not violate its trade obligations. The WTO panel found the legislation contributed to Australia’s objective of improving public health by reducing the use of, and exposure to, tobacco products and to be an integral part of Australia’s comprehensive tobacco control policies. Read the full report in the INTA Bulletin.

**MALAYSIA:** Apex Court Clarifies Where Right of Appeal for Aggrieved Party in Trademark Opposition Proceedings Ends

In Merck KGaA v. Leno Marketing (M) Sdn Bhd; Registrar of Trade Marks (Interested Party), the Federal Court on May 7, 2018, revisited the issue of whether a decision of the Registrar of Trade Marks in opposition proceedings under the Trade Marks Act 1976 (TMA) is appealable to the Federal Court.

In a landmark decision, the Federal Court departed from its earlier decision in Yong Teng Hing v. Walton International Ltd; Pendaftar Cap Dagangan, Malaysia (Interested Party) (which was the most direct authority on this issue) and held that when hearing an appeal against a decision of the Registrar in opposition proceedings, the High Court is exercising its appellate jurisdiction. As such, opposition proceedings end at the Court of Appeal. While an aggrieved party may appeal to the Court of Appeal against the High Court’s decision, the decision of the Court of Appeal is final. Consequently, Merck’s appeal was dismissed by the Federal Court. Read the full report in the INTA Bulletin.

**VIETNAM:** Adoption of the Vienna Classification System

On June 1, 2018, pursuant to Notice No. 3391/TB-SHTT, dated April 19, 2018, Vietnam adopted the Vienna Classification System (under the Vienna Agreement, now in its eighth edition). In addition to the Nice Agreement on the International Classification of Goods and Services, Vietnam also applies the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks to trademark registration. Accordingly, the Vienna Classification System is essential for trademark searches and registration in Vietnam for trademarks consisting of figurative elements, thereby facilitating the trademark search and examination.

The eighth edition of the Vienna Classification System comprises a total of 29 categories, 145 divisions, 816 main sections, and 919 auxiliary sections.

To facilitate both international and local users, the National Office of Intellectual Property of Vietnam (NOIP) provides the bilingual version of the eighth edition of the Vienna Classification System in Vietnamese and English, which is downloadable from the NOIP website. The Vienna Classification System is of great significance for the classification of figurative marks in trademark searches, as well as in the establishment and enforcement of industrial property rights. By following the classification system, the figurative elements used in trademark registration in Vietnam can be easily classified in trademark searches and then evaluated during examination.

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INTA Commits to Boost Engagement with Authorities on China Trademark Law Revision

Monica Su, Representative, China Office

With 8 million trademark applications expected to be filed in China by the end of 2018, the country is the world’s largest filer of trademarks and represents an important market for INTA’s global membership. With this in mind, the Association is closely monitoring upcoming amendments to China’s Trademark Law that could help to improve trademark practice and foster innovation.

China’s IP landscape has undergone a tremendous change as the result of the Ministry restructuring this March. The biggest change is the separation of authority over IP registration versus enforcement. The China National Intellectual Property Administration (CNIPA) now holds the power to grant rights, while the State Administration for Market Regulation (SAMR) is responsible for enforcement. China’s President Xi Jinping reiterated in his keynote speech at the recent China International Import Exposition in Shanghai that IP rights are one of four pillars of China’s deepening reform and push to become more open. The policy will step up efforts to improve the punitive compensation system and move toward higher quality examination to incentivize a more level-playing field and fair treatment of foreign brand owners.

INTA’s activities in the last quarter of 2018 emphasized IPR enforcement, including cooperation with the judiciary and key partners across a wide spectrum of topics. INTA’s most recent visit was led by Ayala Deutsch, Officer and member of INTA’s Executive Committee, to the Shanghai Intellectual Property Court—one of three specialized courts in China that were established in late 2014—on October 24. It was a very frank and constructive meeting to discuss the importance of pre-trial injunctive relief in protecting the IP rights of brand owners.

INTA also spoke at the 2018 China-EU Conference on IPR Protection Online and Innovation co-hosted by IP Key and China Anti-Infringement & Anti-Counterfeit Innovation Strategic Alliance (CAASA) in Xiamen in November. The Conference was a great opportunity to further engage with high-level enforcement officials in China and make formal acquaintance with potential partners for marketing INTA education programs and membership in 2019.

Additionally, INTA also participated in the Female Leadership Development in Intellectual Property Law Salon held by Anjie Law Firm on October 25. It was a private event in a fairly relaxed setting, allowing IP practitioners to speak their minds on IP from a female perspective.

In 2019, INTA will continue its bilateral cooperation with government agencies and the judiciary across China to promote INTA’s leading role in advocating for brand owners globally through an amendment to Chinese Trademark Law. A pipeline of policy dialogues, coupled with INTA’s research program and communication campaign, are being planned for the new year. INTA will also continue to demonstrate its value to brand owners, and looks forward to seeing more Chinese brands join the Association.

Outreach to Patent Community, Building Awareness on Brand Restrictions

From August 29 to September 1, INTA’s President-Elect David Lossignol (Sandoz, Switzerland) represented INTA at a series of events in China alongside the nation’s leading intellectual property (IP) authorities.

First Outreach to China’s Patent Community
The China Patent Annual Conference (CPAC - 专利年会) has been held for the past nine consecutive years. This year, INTA was extended an invitation to attend for the first time. Commissioner Shen Changyu of the China National IP Administration (CNIPA, formerly the State Office of IP (SIPO)), Deputy Commissioner Liu Lunchen, and Director General of WIPO Francis Gurry gave opening remarks. Notably, China’s Premier, Li Keqiang, had recently held a meeting with Mr. Gurry following a high-level summit on IP and the Belt and Road Initiative (see...
China

Given this market’s importance, INTA is working

articles [here](#) and [here](#) on INTA’s involvement in highlighting IP protection in the Belt and Road. The importance of IP to China’s economic and global leadership was a central message.

Mr. Lossignol was invited to speak at an afternoon breakout session titled “The Collaborative Approach to IP Strategies.” He briefly introduced INTA and pointed to recent work focusing on the importance of embracing innovation and change, as outlined in the 2018–2021 Strategic Plan.

**Raising Awareness on Brand Restrictions**

Following the CPAC meeting, Mr. Lossignol proceeded to nearby Tangshan, China, to participate in the China Trademark Association Trademark Festival (CTF). The CTF has been organized for 10 years, and this is the fourth time that INTA was invited to organize a dedicated session. During the course of the CTF, INTA was presented with an award for “Contributions to International Trademark and Brand Communication” and attended a protocol meeting with leadership from CNIPA, alongside MARQUES, the Japan Patent Attorneys Association (JPPA), IP attachés of the European Union (EU) Embassy, and the U.S. Embassy.

Recognizing the number of brands at the CTF that may be affected by brand restrictions, INTA organized a panel session on the regional impact of brand restrictions in the context of the regional expansion of protection of trademarks through adoption of nontraditional marks in a session titled “Brand Restriction vs. Non-Traditional Trademarks.” Nearly 100 attendees joined the event, which featured INTA members Simon Brown (Adams & Adams, South Africa), Meredith Levins (Airbnb, Inc, USA), and Nuttaphol Arammuang (ZICO IP, Thailand).

Mr. Brown shared INTA’s research and positions regarding brand restrictions globally, and in particular the role that INTA has played in countering plain packaging around the world.

Mr. Arammuang shared INTA’s research on how nontraditional marks are expanding in the region. Ms. Levins provided insight on the growing importance of nontraditional marks for brands, particularly those that sell goods and services online. The overall discussion focused on how nontraditional marks, such as shape and color, are most vulnerable to brand restriction, which includes plain packaging rules. Plain packaging rules seek to standardize packaging and remove all elements of a trademark except for a uniform word mark.

INTA joined other events in the CTF, such as the DotTrademark Reception for China’s growing

**Su Hong (Monica) Joins INTA as Representative Officer, Shanghai**

INTA is pleased to announce that Su Hong (Monica) has joined INTA as Representative Officer, Shanghai.

Ms. Su takes the lead on INTA’s government relations with Chinese intellectual property authorities, including planning and delivering policy-related dialogues, educational events and trainings, and communications.

Su is fluent in English and Japanese.

Prior to that, she was in private practice at Li & Lee Intellectual Property Agency, also in Beijing. She holds a double master’s degree in European Union Law from Hamburg University and Chinese Law from the China University of Political Science and Law. She received her bachelor’s degree in English also from the China University of Political Science and Law. Ms. Su is fluent in English and Japanese.

**INTA in China: By the Numbers**

China has the largest population in the world, the largest e-commerce marketplace globally, 813,000 IP cases in the courts, more than 173,000 trademark infringement actions taken up by administrative authorities in the past five years, and is expecting 8 million trademark applications in 2018.

Given this market’s importance, INTA is working with members in China and Chinese authorities to ensure that it is the world’s safest for consumers and brand owners.

**Trademark Law Amendments and Draft e-Commerce Law**

As mentioned by the China National Intellectual Property Administration (CNIPA) during INTA’s leadership delegation visit to Beijing in July, China has commenced the process of amending its Trademark Law.

INTA committees, including the Enforcement Committee, Famous and Well-Known Marks Committee, Trademark Office Practices Committee, and Anticounterfeiting Committee, have worked together to deliver comments to the authorities.

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A major focus of the comments is on improving tools for brand owners to combat the problem of bad-faith trademark applications. INTA provided several recommendations for improving anticyferfeiting enforcement as well.

INTA also commented on the need to extend deadlines, improve quality, and reduce red tape for brand owners—for example, by making license recordal optional and requiring quick approvals.

In addition, INTA recently submitted comments on the China e-Commerce Law, which is in its third reading at the National People’s Congress, concerning the provisions on Article 42, which may create opportunities for counterfeiters to sell counterfeit goods online in China with impunity.

In pertinent part, INTA advised the following:

As drafted, Article 42 mandates that platforms must reinstate infringing listings whenever a seller submits “a statement... to warrant that there is no infringement” accompanied with “prima facie evidence of no act of infringement.” There is a significant risk that the law as drafted will allow counterfeiters to ‘game’ the system by simply protesting every online listing takedown, and shifting the burden to the rights owner to pursue the takedown through formal legal channels. Article 42 appears to take away the discretion that platforms currently have to evaluate the “evidence” and decide whether to reinstate when a seller files a counter-notice and that platforms will be obligated to “immediately stop the measures it has taken” and reinstate the listing.

INTA’s Profile in China

INTA has added more members in China between 2010 and 2017 than in any other country, with 113 new members joining during that period. With 267 Chinese members as of 2018, this reflects a growth of over 55 percent in the last seven years. INTA is proud to claim 28 corporate members, reflecting a diverse range of Chinese companies, from high-tech innovators to classic Chinese brands.

China sends the second-highest number of registrants to the Annual Meeting (644 attendees in 2018), after the United States. This contingent will continue to grow; the number of attendees is predicted to nearly double in the coming decade. Currently, one out of three attendees from Asia at the Annual Meeting comes from China. This proportion has grown since 2012, when one out of four attendees from the region was from China.

As demonstrated above, INTA has been increasing its activity since 2016 (the figures for 2018 reflect only eight months of activity). The Association is set to break records this year for activities organized in the country and interaction with third-party stakeholders and government.

INTA’s Activity in China

Notably, INTA’s engagement with government officials has increased threefold in the last few years. These engagement opportunities come in many forms: policy dialogues organized through committees; leadership delegation visits; and government official participation in INTA events outside China, such as the Annual Meeting. As INTA focuses on its impact on the trademark policy landscape in China, this engagement is set to increase in the coming years.

INTA aims to continue growing its profile in China, with several new initiatives planned, beginning later this year. These will focus on engaging authorities on the trademark law revision, new tactics and techniques to fight online counterfeits, and prevention of cross-border trade in counterfeit products.

To learn more about INTA’s activity in China, please reach out to INTA’s Chief Representative Officer for China, Seth Hays, at shays@inta.org and INTA China Office Assistant Vicky Dai, at wdai@inta.org.
Regulations Clarify Role of New Agencies Following China’s IP Institutional Reform

Since the Chinese government announced its plan to reorganize various government agencies in March, foreign brand owners have been wondering how it will affect the intellectual property (IP) sector and practice.

In August 2018, China’s State Intellectual Property Office (SIPO) was renamed the National Intellectual Property Administration (CNIPA). Shen Changyu, ex-SIPO Commissioner, was appointed as CNIPA Commissioner, Liu Junchen, ex-Vice Commissioner for the State Administration for Industry and Commerce (SAIC) was appointed as one of the six vice Commissioners of the CNIPA.

At the same time, the activities of the SAIC (trademarks and competition); SIPO (patents); the General Administration of Quality Supervision, Inspection and Quarantine (AQSIQ) (product quality); and food and drugs regulation were regrouped under one central administration, the State Administration for Market Regulation (SAMR). Zhang Mao, ex-Commissioner of the SAIC was appointed as Commissioner of the SAMR.

In September, two regulations were released by China’s State Commission Office for Public Sector Reform (SCOPSR). The SCOPSR is the executive organ of the Central Institutional Organization Commission, a governmental agency specializing in policymaking on administrative reform, central reorganization plans, staffing, quotas, and administrative regulations for state institutions. In a nutshell, the Commission is a supervisory agency that decides on the constitution and running of other government agencies.

On September 10, 2018, the “Regulations on the Function, Organisational Structure and Staffing of the State Administration for Market Regulation” (SAMR Regulations) were released and came into force retroactively on August 1. On September 11, 2018, the “Regulations on the Function, Organisational Structure and Staffing of the National Intellectual Property Administration” (CNIPA Regulations) were released and came into force retroactively on August 1.

SAMR Regulations

The SAMR Regulations outline the following IP rights (IPR)-related functions:

- **Market Regulation Enforcement**: overseeing the integration and building of enforcement teams at local Administration for Market Regulation (AMR) offices; promoting integrated market supervision; and orchestrating major enforcement programs;
- **Anti-Monopoly Enforcement**: coordinating and promoting the execution of competition policy; overseeing fair competition probe; conducting anti-monopoly probe against concentration of operators, as well as anti-monopoly enforcement against monopoly agreement, abuse of market dominance position, and abuse of administrative power in eliminating or restricting competition; and coaching Chinese businesses in coping with overseas anti-monopoly suits; and
- **Administration of Market Order**: supervising and regulating market transactions, Internet commodity trading and the services thereof; organizing and overseeing the enforcement against pricing offenses or violations, unfair competition, illegitimate pyramid scheme or multi-level marketing; trademark or patent infringement, manufacturing or sale of counterfeit or shoddy goods; and supervising advertising industry and advertising activities.

These functions are expected to be fulfilled by the agency’s bureaus: the Enforcement Inspection Bureau, the Anti-Monopoly Bureau, the Internet Transaction Administration Bureau, the Price Probe & Anti-Unfair Competition Bureau, and the Advertising Administration Bureau.

According to the regulation, the Enforcement Inspection Bureau is tasked to organize and oversee investigations and enforcement against major cases of national implication or which have trans-provincial/municipal geographical reaching. Brand owners are advised to approach the Bureau if they seek to initiate nationwide or trans-provincial/municipal enforcement actions.

IPR enforcement against trademark or patent infringement, counterfeiting, and unfair competition also falls under the jurisdiction of the Enforcement Inspection Bureau, but given the top-down nature of the institutional reorganization, a nationwide AMR network has not yet been formed. For instance, there is no Beijing AMR yet. This could be problematic. The IPR enforcement function of the CNIPA and local IP offices (IPOs) has been de facto transferred to the SAMR and its local offices. However, in the regions where there is no local AMR, brand owners will need to resort to the local IPO and the Market Supervision and Administration Office (equivalent to the local Administration of Industry and Commerce) with respect to functions to enforce their IPRs.

The Anti-Monopoly Bureau, integrating the Anti-monopoly Bureau of the Ministry of Commerce (MOC), the Price Supervision and Inspection and Anti-monopoly Bureau of the National Development and Reform Commission (NDRC), and the SAIC’s Anti-monopoly and Anti-unfair Competition Enforcement Bureau, will be the nation’s anti-monopoly watchdog, acting as the executive organ of the Anti-monopoly Committee of the State Council.

CNIPA Regulations

The CNIPA Regulations outline, among others:

- **Drafting and Execution of National IPR Strategy**: formulating major policies, initiatives, and developing plans for building China into an IP powerhouse; and developing and executing administrative policies and mechanism to promote IP innovation, protection, and utilization;
- **IPR Protection**: devising and implementing protection mechanisms for trademark, patent, geographical indications (GIs), and layout design of integrated circuits; drafting laws, regulations, and departmental rules; and overseeing the execution thereof; and overseeing trademark and patent enforcement and supervising IP dispute resolution, enforcement aid, and dispute mediation at local levels; and
- **Examination, Registration, and Administrative Adjudication of IPR**: trademark registration, patent examination, and registration of layout design of integrated circuits; re-examination, invalidation, and other administrative adjudication of trademarks, patents, and layout design of integrated circuits; as well as the drafting and execution of integrated GI assessment mechanisms.

The CNIPA Regulations explicitly task the agency to shorten the IP registration cycle and to enhance examination quality and efficiency, as well as to focus on trademark bad faith filings and unproductive patent applications.

Read the full report in the *INTA Bulletin*.

Bai Gang
Wanhiuda Pekung IP Group, Beijing, China
Co-Chair, China Global Advisory Council
Brexit: With a Draft Deal in Place, IP Owners Await Final Approval

Despite much pessimism and growing concern, the European Union (EU) and the United Kingdom (UK) finally succeeded in agreeing on a draft deal on the UK withdrawal agreement (the divorce phase) on November 14.

What It Means for Intellectual Property
Most of Title IV (Arts. 54—61), which covers intellectual property (IP), was already agreed in principle. Trademarks, designs, databases, and even plant variety rights were addressed and generally agreed upon. The main principle put forward then remains “continued protection in the United Kingdom of registered or granted rights.” Also, the draft agreement kept its regional exhaustion principle where “intellectual property rights which were exhausted both in the Union and in the United Kingdom before the end of the transition period under the conditions provided for by Union law shall remain exhausted both in the Union and in the United Kingdom.” The outstanding issues—geographical indications (Gs), registration procedure, and pending applications for supplementary protection certificates in the UK—are now agreed.

For GIs, the UK will be granting automatic rights to EU GIs “as from the end of the transition period” until a future relationship is established, although the UK will still have to pass a legislative act to enshrine GI protection into UK law.

Registration will be carried out “free of charges” and IP rights holders will “not be required to introduce an application or to undertake any particular administrative procedure,” nor will they be required to “have a correspondence address in the United Kingdom in the 3 years following the end of the transition period.”

A Tricky Path Forward
Does this mean the end of the Brexit process? Far from it. Both the EU (through a Council Summit on November 25 and a Parliament’s vote in January or February 2019) and the UK (through a vote in the UK Parliament on December 11) will have to approve and ratify the “divorce” deal.

On the EU27 side, the approval process is on track and should not face any more hurdles. Indeed, during a Summit on November 25, the EU27 approved the draft agreement on the divorce (a simple majority was required) as well as a political declaration on the setting out the framework for the future relationship between the European Union and the United Kingdom. The latter is a political document (not a legally binding one) for which the unanimity of the EU27 was required. This document provides the basic framework for the future relationship, i.e., an “ambitious, broad, deep and flexible partnership” whose nature has yet to be determined (some possibilities include a customs union or a free trade agreement). This partnership should cover “trade and economic cooperation, law enforcement and criminal justice, foreign policy, security and defense and wider areas of cooperation.” The declaration nonetheless leaves the door open for “areas of cooperation beyond those described in this political declaration.” It includes a point VII on intellectual property (paragraphs 44-47) which notably stress that the parties should provide for IP protection and enforcement “beyond the standards of [TRIPS and WIPO] convention where relevant” as well as the “freedom to establish their own regimes for the exhaustion of intellectual property rights.” Finally, the parties agreed to “establish a mechanism for cooperation and exchange of information on intellectual property issues of mutual interest, such as respective approaches and processes regarding trademarks, designs and patents.”

The last step at EU level will be the consent—a mere “yes” or “no” without the power to amend—from the European Parliament on the deal.

On the UK side, the process is expected to prove far less simple. UK Prime Minister Theresa May is facing opposition in her own party, notably with the resignations of several members of her cabinet, including Brexit Minister Dominic Raab, over their opposition to the final deal. She managed to win a “defiance” vote in her own party on December 11 but the split between her opponent (117) and her party (200) leave little chance of success for the deal to be approved in the UK Parliament if she does not get the back-up of the opposition (the Labor party mainly), which the latter refuses at this stage. Ms. May attended a European Summit in Brussels on December 13 where she obtained the formal declaration of the EU that the backstop to prevent a hard border with Ireland – the main bone of contention—is only “temporary” and “an insurance policy”. She will need to find a majority in favor of the deal in the UK Parliament by January 21, 2019. At this date, she needs to inform the Parliament of her intentions if the deal is not adopted. Whether
Association Updates

INTA's Advocacy Efforts Result in Inclusion of IP and Anticounterfeiting in EU Parliament Report on Blockchain

On November 20, The International Trade Committee of the European Parliament adopted its own-initiative (non-legislative) report titled “Blockchain: a forward looking trade policy.” Thanks to INTA’s advocacy efforts, the report highlights the potential of blockchain to protect IP rights (IPR) and fighting against counterfeits. This adoption by a broad majority is a significant political signal from the EU Parliament to the Commission.

INTA Enhances Relations with French IP Office and Parliament

On October 24, INTA CEO Etienne Sanz de Acedo and INTA Europe Chief Representative Officer Hélène Nicora met in Paris with the recently appointed Director General of the French Institute for Intellectual Property, Pascal Faure, to exchange ideas on the office’s strategy and areas of future cooperation. They also met with French Senator Ronan Le Gleut to discuss anticounterfeiting policy efforts and a potential French bicameral Trademark Caucus in the French Parliament.

Read about other activities in Europe in the latest Europe Update in the INTA Bulletin.

Important Changes Foreseen at the European Observatory on Infringements of Intellectual Property Rights

INTA provided comments and additional comments on the European Observatory’s first-ever consultation on the evaluation of the Observatory since its creation in 2012, as well as input regarding the European Observatory on Infringements of Intellectual Property Rights’ Multiannual Plan Extension and Work Programme for 2019. Hélène Nicora, INTA Chief Representative Officer for Europe, attended the Observatory’s plenary session in Alicante, Spain, from September 26 to 27, where the question of the restructuring of the Observatory’s working groups (WGs) was at the cornerstone of the three points mentioned above. After several proposals, the Observatory now intends to put forward the following new structure:

• Keeping four existing WGs as they are: Enforcement, Public Awareness, IP in the Digital World, and Economics and Statistics (INTA has been represented in all so far);
• In addition, and in parallel, creating six expert groups: Legal, International Cooperation (a split from the previous “Legal and International” WG), Impact of Technology, Cooperation with Intermediaries, Observatory Outreach, and Small and Medium-Size enterprises.

• The expert groups will be small in number (around 30 members) and limited to experts. INTA members are invited to apply online.

In September, the Observatory published a Study on legislative measures related to online IPR infringements. This study’s main purpose is to establish whether and to what extent a number of specific legislative measures, which can be applied to prevent or combat IP rights infringement in the online environment, are available in EU member states.

Europe Office Works with WIPO, European Commission, National Offices, and EUIPO

In a meeting in Brussels on September 19 with Program Officer Monika Zikova and the Department for Transition and Developed Countries, INTA learned that the World Intellectual Property Organization (WIPO) is currently setting up a single common Global IP Platform that consolidates the customer experience, revenue management, and data assets capture and management across the business lines and associated information and communications technology (ICT) systems. WIPO is looking for brand owners willing to provide detailed input on the pilot platform.

On October 2, INTA’s Europe Office attended a meeting organized by the Directorate-General for Trade of the European Commission (DG TRADE) in Brussels to exchange with stakeholders on the 2019 Work Plan for the EU IP Key programs. Financed by the European Commission, the IP Key programs are implemented by the EUIPO to support robust IP systems in China, Latin America, and Southeast Asia. More information on trainings, seminars, and projects foreseen in the different regions can be found at https://ipkey.eu/en.

INTA is also strengthening its relationship with EU national IP offices. Hélène Nicora, INTA Chief Representative Officer for Europe, discussed IP strategies, the impact of new technologies, and the role of IP offices in a changing European landscape with the heads of the IP offices of Estonia, Latvia, Lithuania, Hungary, Poland, Sweden, and the UK in Geneva, Switzerland, in the context of the WIPO General Assemblies on September 24 and 25.

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Amaryllis Verhoeven is Head of Unit, Industrial Property and the Fight against Counterfeiting, which is in charge of assessing, monitoring, and defining policies related to the protection of industrial property and the fight against counterfeiting, within the Directorate General (DG) for Internal Market, Industry, Entrepreneurship and SMEs (DG GROW) at the European Commission (EU Commission). Ms. Verhoeven came to the unit in September 2017 after having worked with the EU Commission since 2002 on a number of projects aimed at boosting the competitiveness of the European Union (EU) single market.

Ms. Verhoeven spoke with INTA's Europe Representative Office about her role with DG GROW and some of the key priorities for the EU Commission leading up to the end of the Commission’s mandate on October 31, 2019.

What are the EU Commission’s main priorities on IP protection for the end of its mandate?

Before the summer, the EU Commission delivered a legislative proposal for a Supplementary Protection Certificate (SPC) manufacturing waiver. Our aim is to reaffirm Europe’s position as a hub for all pharmaceutical companies: originators, generics, and biosimilars, as well as the R&D communities working alongside these companies. We hope that discussions on the SPC proposal within the Council and European Parliament, as well as with stakeholders, will allow for its quick adoption within this legislative term.

Our work in the following months will also focus on ensuring swift implementation of the Trade Mark Package and Trade Secrets Directive, as well as completing further steps of the design protection system’s reform, as mentioned above.

INTA Europe Policy Officer Carolina Oliveira traveled to Warsaw to attend the celebration of the Polish Office’s 100th Anniversary (November 26) and the DesignEuropa Award ceremony (November 27). In the margin of these events, Ms. Oliveira accompanied Bartosz Krakowiak (POLSERVICE, Warsaw) Chair of INTA’s Europe and Central Asia Subcommittee of the Legislation and Regulation Committee in a meeting with the Head of Cooperation with International Institutions of the Polish Patent Office, Ms. Anna Dachowska, to exchange on the Office’s priorities, cooperation with INTA in trademark-related practices and the implementation of the Trade Marks Directive in Poland.

The Association conveyed its willingness to further ties through the sharing of best practices, knowledge, and expertise, as well as scaling up the organization of joint activities in order to foster intellectual property (IP) rights and contribute to the development of the global IP system.

## Comments on Draft Guidance to Counter Illicit Trade

Myrtha Hurtado-Rivas (Novartis International, Switzerland), Heike Bhonsle (Crocs, Inc., Germany), and María González Gordon (Gomez-Acebo & Pombo, Spain), gathered recommendations on suggested modifications to the draft language in order to emphasize the need for stronger enforcement against counterfeit products in illicit trade and the need for unified guidelines for enforcement in free trade zones.

Ellen Breddam
Plougmann Vingtoft, Hovedstaden, Denmark
INTA Trademark Office Practices—European National Offices Subcommittee

## Interviews

### Amaryllis Verhoeven: How the European Commission Is Working to Stimulate Innovation

Amaryllis Verhoeven is Head of Unit, Industrial Property and the Fight against Counterfeiting, which is in charge of assessing, monitoring, and defining policies related to the protection of industrial property and the fight against counterfeiting, within the Directorate General (DG) for Internal Market, Industry, Entrepreneurship and SMEs (DG GROW) at the European Commission (EU Commission). Ms. Verhoeven came to the unit in September 2017 after having worked with the EU Commission since 2002 on a number of projects aimed at boosting the competitiveness of the European Union (EU) single market.

Ms. Verhoeven spoke with INTA’s Europe Representative Office about her role with DG GROW and some of the key priorities for the EU Commission leading up to the end of the Commission’s mandate on October 31, 2019.
I also hope that, still under this Commission, the long-awaited Unitary Patent and the Unitary Patent Court can see the light of day. The ratification process is nearly complete, though a legal challenge in Germany has delayed the final ratification in that member state.

Last but not least, we will soon start to look ahead to the issues that might arise during the next EU Commission’s term. The challenges in the area of IP are huge, and we want to take the time needed to ensure that, also in the future, we set our priorities for action right. Read the full interview in the INTA Bulletin.

As of December 18, 2018, 58 countries and intergovernmental organizations will be parties to the Geneva (1999) Act. In total, 69 countries and intergovernmental organizations will be members of the Hague Agreement.

In line with its Board Resolution of November 15, 2016, INTA encourages countries, intergovernmental organizations, and non-member countries whose citizens are covered by the adherence of an intergovernmental organization to accede to the Hague Agreement.

WIPO’s information notice of September 27, 2018 can be found here.

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Mr. Pernet and Ms. Durkin are members of the Designs—International Design Harmonization Subcommittee.

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Ms. Malaspina and Mr. Bonini are members of the INTA Bulletins Law & Practice—Europe Subcommittee.

ITALY: Implementation of Trade Secrets Directive
Legislative Decree No. 63 of May 11, 2018, implementing EU Directive 2016/943 on the protection of trade secrets, came into force in Italy on June 22, 2018, introducing important amendments to both the Italian Industrial Property (IP) Code and the Criminal Code.

Firstly, the implementing law clarifies the subjective element relating to the criminal liability of the author of the violation, specifying that the owner of the trade secrets may challenge their unlawful acquisition, use, and disclosure, not only in case of intentional wrongdoing, but also where there has been gross negligence.

Considerable innovations also affect the preservation of confidentiality of trade secrets in the course of legal proceedings, as now Italian judges may, upon request, prohibit the parties and any other participants in legal proceedings from using or disclosing the trade secrets of which they have become aware during the proceedings. Judges may also, upon request, restrict access to documents containing trade secrets, keep attendance of hearings to a limited number of persons, and redact the passages of decisions containing trade secrets.

As a consequence, the implementing law amended the Criminal Code, providing that the punishment for the crime of intentional noncompliance with a judicial order also applies to the violation of the judicial orders described above.

The IP Code has been amended as well. Article 126 on the publication of judicial decisions now provides that, in deciding whether to order publication, the judge shall, on the one hand, take into account the value of the trade secret, the conduct of the infringer, the impact of the unlawful use or disclosure of the trade secret, and the likelihood of further unlawful use or disclosure by the infringer.

On the other hand, the judge shall also take into account whether the information on the infringer would allow for identification and the possible harm that such measure may cause to the privacy and reputation of the infringer.

Finally, the IP Code now provides for compensation for the holder of the alleged trade secrets as an alternative to the provisional and precautionary measures against the alleged infringer, when the latter was not aware or could not have been aware of the nature of the trade secrets and the execution of the measures would be too burdensome.

In injunctive proceedings, the alleged infringer may ask the judge to continue using the alleged trade secrets upon the lodging of an appropriate security to guarantee the reimbursement of potential damages suffered by the owner of the trade secrets.

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The membership of the Benelux countries to the Hague Agreement, the territories of Belgium, Luxembourg, and the Netherlands in Europe are, for the application of the Hague Agreement, to be deemed a single country. The Benelux Office for Intellectual Property (BOIP) is the common office for the three countries. Declarations were also made (1) to prohibit the filing of international applications through the BOIP (only directly with the International Bureau); (2) to shorten the deferment period to 12 months; and (3) to extend the duration of protection to 25 years.

THE NETHERLANDS: Following Ratification of Geneva Act of the Hague Agreement, Benelux Consequently Becomes a Member
The World Intellectual Property Organization (WIPO) informed users that on September 18, 2018, the Government of the Kingdom of the Netherlands deposited the instrument of ratification of the Geneva (1999) Act of the Hague Agreement Concerning the International Registration of Industrial Designs (the Hague Agreement) with the International Bureau of WIPO. As Belgium and Luxembourg had already deposited their instrument of accession in 2013, the Geneva (1999) Act will enter into force in the Benelux on December 18, 2018. Read the full report in the INTA Bulletin.

As a consequence, the implementing law clarifies the subjective element relating to the criminal liability of the author of the violation, specifying that the owner of the trade secrets may challenge their unlawful acquisition, use, and disclosure, not only in case of intentional wrongdoing, but also where there has been gross negligence.

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In injunctive proceedings, the alleged infringer may ask the judge to continue using the alleged trade secrets upon the lodging of an appropriate security to guarantee the reimbursement of potential damages suffered by the owner of the trade secrets.
INTA Leadership Meeting Underscores Importance of Continued Outreach in India

INTA's 2018 Leadership Meeting was significant for India in several ways. The Association announced that it would hold its Board Meeting, Government Relations Program, and events related to these meetings in India from September 23 to 25, 2019, in New Delhi, India. This is the first time the INTA Board of Directors will be holding its meeting in India.

The India Global Advisory Council also met for its second in-person meeting of 2018 and discussed its objectives. Several initiatives were proposed and advocacy opportunities identified, including advocating for customs coordination in South Asia and statutory damages for intellectual property rights (IPR) disputes in India.

India's growing importance on the global map is not lost on INTA, and the Association has been focused on sustained growth of its activities and initiatives in the country. There have been annual high-level delegations to India for eight years now, ongoing collaboration with the government, regular educational programming, multiple advocacy endeavors, and much more.

Suffice it to say, the coming year in India already looks promising for INTA. If you would like to become involved in INTA's India-related activities, please reach out to INTA's India Consultant, Gauri Kumar, at gkumar.consultant@inta.org.

Association Updates

Call for Action to Help Educate Children on IP

INTA is looking for volunteers to create and contribute material to a project of the Cell for IPR Promotion and Management (CIPAM). The project relates to Objective 1 of the National IPR Policy – IPR Awareness: Outreach and Promotion. Pursuant to this, CIPAM is developing an interactive IPR Activity Book that will be disseminated to school children across India and is currently seeking volunteers to contribute to the creation of this book.

CIPAM is a professional body under the aegis of the Department of Industrial Policy and Promotion (DIPP), which ensures focused action on issues related to IPRs and addresses the seven identified objectives of the policy. CIPAM assists in simplifying and streamlining IP processes, apart from undertaking steps for furthering IPR awareness, commercialization, and enforcement.

Please write to gkumar.consultant@inta.org if you would like to volunteer.

Learn more here in the INTA Bulletin.

INTA Holds Corporate Member Meeting, Attends Cutting-Edge Events

On August 31, INTA held its Corporate Member Meeting at the Mumbai, India, office of Corporate Member Procter & Gamble. INTA's Corporate Member Meetings provide corporate members regular opportunities to gain educational insights and updates on the work of the Association, as well as to discuss and address their common concerns with their in-house counterparts.
Stakeholder Meeting at Indian IP Office

INTA was invited to a meeting of IP professionals and practitioners at the Indian IP Office in New Delhi, which operates under the Department of Industrial Policy and Promotion (DIPP), on August 3. The meeting was chaired by Ramesh Abhishek, Secretary, DIPP, who was accompanied by Mr. Aggarwal; O.P. Gupta, Controller General of Patents, Designs, and Trade Marks; and other senior officials of the IP Office.

The purpose of the meeting, which was attended by representatives from law firms and companies, was to facilitate discussion and provide feedback on the implementation of the National IPR Policy and further improvement required in the functioning of the Office to make the IPR ecosystem in India more progressive.”

As covered in previous India Updates for the INTA Bulletin, the IP Office has made remarkable progress in its operations and the processing of IP rights in recent years. The IP Office has been highly receptive to user feedback and organizes regular meetings to address stakeholder concerns. At this meeting, attendees lauded the IP Office for making huge strides in improving its overall functioning. At the same time, they raised a few concerns (such as pendency in opposition matters and non-acceptance of user amendments) and made some suggestions (such as streamlining the document process). The IP Office said it is looking into these concerns. The IP Office updated stakeholders about its plans to further improve the trademark side with efforts that include shortening the backlog in the opposition section and considering videoconferencing for trademark hearings.

Realizing the true potential of the latest technologies available, the IP Office also mentioned that it intends to make use of artificial intelligence, blockchain, the Internet of things, and other technologies in its patent processing system. As confirmation of this intention, the IP Office has recently published an invitation to interested eligible vendors to submit their proposals for implementing these technologies. The IP Office has also recently published a recruitment notice for more than 200 vacancies for patents and designs examiners, thereby actively addressing the need for additional personnel.

If you have any suggestions regarding the processing of trademark rights at the IP Office, please email them to INTA’s India Consultant, Gauri Kumar, at gkumarconsultant@inta.org.
In the News

**H&M Wins Injunction Based on Prior Adoption Abroad**

In *H&M; Hennes & Mauritz Ab & Anr v. HM Megabrands Pvt. Ltd. & Ors/ IA-7259/2016 (May 31, 2018)*, the High Court of Delhi issued a permanent injunction against the defendants, HM Megabrands Pvt. Ltd & Ors., confirming that prior adoption of a mark overseas can be superior to prior use of the mark in India.

The plaintiffs own the trademark H&M, a brand that is popular worldwide. The first registration for the mark H&M was in the year 1985 in the United Kingdom. The plaintiffs registered the mark in India in 2005. The defendants began marketing garments under the brand “HM Megabrands” in India in 2011 and applied for registration of HM MEGABRANDS on April 11, 2014.

The plaintiffs filed a suit against HM Megabrands for trademark infringement and passing off. The defendants contended that their adoption of the mark was honest and based on the initials of the names of its directors. Further, the defendants contended that, when they adopted the trademark HM MEGABRANDS in 2011, the plaintiffs had not yet entered India with their products. The defendants also maintained that their brand included the word “Megabrands,” which sufficiently differentiated their goods from those of the plaintiffs’ brand, “H&M.”

The court disagreed that the defendants’ adoption of the mark HM MEGABRANDS was bona fide. The court observed that the defendants were using a red and white color scheme identical to H&M’s, and further noted that customers would interpret the additional word “Megabrands” to mean “huge brand,” which would escalate confusion with H&M.

The court therefore restrained the defendants from the use of the trademark HM MEGABRANDS. This judgment once again establishes that, in India, prior adoption of a mark overseas can be superior to prior use of the mark in India.

**Court Questions Proper Forum for Determining Well-Known Marks**

On July 27, 2018, in *Texmo Industries v. Mr. Roshan Kumar, C.S. No. 357/2017*, while deciding a trademark infringement case, the Madras High Court said that the Trade Marks Registry was the proper authority to respond to the plaintiff’s request for the court to declare its trademark, TEXMO, a well-known trademark.

The dilemma that the court was faced with was that, while the Act’s literal interpretation is that a court or a tribunal has the right to determine a mark to be well known, the court itself has taken divergent views in light of the new Trade Marks Rules, 2017. The new Trade Marks Rules, 2017 laid down specific criteria and procedures that allow the Registrar to declare a trademark well known.

The term “Well-Known trade mark” was defined under the Trade Marks Act, 1999 as a mark which has become so to the substantial segment of the public which uses such goods or services that the use of such mark in relation to other goods or services would be likely to indicate a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first mentioned goods or services.

The new Trade Marks Rules, 2017 and in particular, Rule 124, which has created a new procedure to recognize well-known trademarks. Rule 124 gives a party the right to file a specific request (Form M-M) to have a mark listed and declared as a well-known mark. The single bench in this present matter opined that the court only had the authority to decide the factors relating to the mark being well known, and that the Trade Marks Registry was better equipped to appreciate the documentary evidence submitted and was the only appropriate forum to be approached for such a declaration.

The question has been referred to a division bench to consider whether the courts can renounce their powers and the repercussions of making the Registrar the ultimate forum for such a declaration.
Supreme Court Rules That Similar Marks Can Be Registered for Different Goods in the Same Class

In Nandhini Deluxe v/s Karnataka Coop. Milk Producers Fed. Limited, with Ors. Civil Appeal Nos. 2937-2942 of 2018, dated July 26, 2018, the Supreme Court of India was confronted with the use and registration of almost identical marks for use on products that were different in nature and manner of selling, but fell in the same class of goods under the Nice Classification, in an appeal to an opposition proceeding.

Karnataka Co-op. Milk Producers Fed. (Karnataka) adopted and registered its trademark NANDHINI in 1985 under Classes 29 and 30 and was producing and selling milk and milk products under this mark. Nandhini Deluxe adopted the mark NANDHINI in 1989 and it sought to register its mark NANDHINI in Classes 29 and 30 for meat, fish, poultry and game, meat extracts, preserved, dried and cooked fruits and vegetables, jellies, jams, eggs, edible oils and fats, salad dressings, and preserves included in Classes 29 and 30.

Karnataka objected to the registration by Nandhini Deluxe and claimed that Nandhini Deluxe’s mark would lead to confusion among the public, who would be led to believe that food-stuffs bearing the mark NANDHINI belonged to Karnataka. The Deputy Registrar rejected Karnataka’s plea and ordered registration of NANDHINI to be granted, with the condition of deleting milk and milk products from the specification of goods. Karnataka approached the Intellectual Property Appellate Board (IPAB), which overturned the Registrar’s order. The High Court ultimately affirmed the IPAB’s decision, and Nandhini Deluxe appealed before the Supreme Court.

At the Supreme Court, Nandhini Deluxe argued that NANDINI/NANDHINI were words that represented the name of a goddess and a cow in Hindu mythology. Nandhini Deluxe also contended that Karnataka was using the mark only with respect to milk and milk products under Classes 29 and 30, whereas Nandhini Deluxe’s goods fell in the same classes, but included food items that would not be sold by a dairy over the counter.

The Supreme Court agreed with the Deputy Registrar and granted registration of the mark NANDHINI. The Supreme Court’s reasoning was that the Trade Marks Act gives monopoly rights to the proprietor over the goods falling in a particular class and not the entire class. This analysis affirmed the Supreme Court’s earlier decision in the case of Vishnudas Trading Company v. Vazir Sultan, 1996 SCALE (5) 267, which was rendered under the previous law of 1958.

This judgment supports the proposition that, even if a mark is registered and used by one proprietor for one set of goods in one class, that proprietor cannot exercise a monopoly on all the goods or services in that class, and a third party with the same or similar mark can apply for and obtain registration for its mark for a different set of goods in that class.

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INTA Bulletins Law and Practice—Asia-Pacific Subcommittee
Verifier: Sushant Singh
Supreme Court of India and Delhi High Court, New Delhi, India

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Supreme Court Rules Evidence of Fraud and State of Mind Not Relevant in Passing-Off Action

On September 12, 2018, in Wockhardt Limited v. Torrent Pharmaceuticals Ltd., Civil Appeal No. 9844 2018, the Supreme Court of India held that, in a passing-off action, it is not necessary to provide evidence of fraud or the defendant’s state of mind.

Wockhardt Limited and Torrent Pharmaceuticals Ltd. are pharmaceutical companies headquartered in India. Torrent Pharmaceutical Ltd. is the proprietor of the mark CHYMORAL FORTE. The mark has been registered and continuously in use since 1962. The trademark is derived from the drug’s active ingredient, Chymotrypsin. For the same active ingredient, Wockhardt Limited adopted the mark CHYMTRAL FORTE.

Torrent filed suit at the Bombay High Court against Wockhardt Limited for passing off. The trial court dismissed Torrent Pharmaceutical’s case on the grounds that, on the date of filing of the suit, nearly six years had lapsed, the plaintiff had not presented any evidence for actual passing off or fraud, and, over the period of six years, both the marks had co-existed in the market. The trial judge also concluded that since the prefix “chym” was adopted from the name of the active ingredient, there was no intention to deceive, as the element of mens rea was missing.

The Appellate Court at Mumbai reversed the trial court’s judgment and relied on the three-way test for passing off laid down by Lord Oliver in Reckitt & Colman Ltd v Borden Inc.: (i) establishment of reputation, i.e., if the goods or services have acquired reputation in the marketplace and are distinguishable from those of competitors; (ii) misrepresentation, i.e., the defendant misrepresents itself in a manner that its goods/services are confused with those of the plaintiff; and (iii) injury/damage caused to the plaintiff as a result of the defendant’s activity. 1990 1 All E.R. 873 viz.

The appellate court thus enjoined Wockhardt from using the mark CHYMTRAL FORTE. Wockhardt appealed to the Supreme Court of India, which held that the test for passing off does not require the fraud to be proven for the purposes of inferring misrepresentation. The misrepresentation can be innocent, though fraud may assist the court to arrive at the finding of dishonesty. The Supreme Court therefore reaffirmed the precedent of the cases Laxmi-kant Patel v. Chetan Bhat Shah, 2002 (3) SCC. 65 and S. Syed Mohideen v. Sulochana Bai, rendered in 2015. Both of these judgments dealt with the three-way test of passing off.

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R K Dewan & Co., Mumbai, India
INTA Bulletins Law and Practice—Asia-Pacific Subcommittee
Verifier: Sushant Singh
Supreme Court of India and Delhi High Court, New Delhi, India
Join leading legal and business experts for two-days in Paris as INTA explores the opportunities and challenges facing brand owners doing business in Europe today! This conference will help practitioners identify changes that will impact their professional life, discuss practical tips and concrete tools to adapt to the challenges raised, and enable attendees to better equip themselves to navigate the changing European political and legal landscape.

Visit [www.inta.org/2019Paris](http://www.inta.org/2019Paris) to register for this exciting event!

Join INTA in New York on March 28-29 where we take the conversation beyond trademarks and focus on brands from a business perspective. This forward-looking conference will consider both the legal and the business perspectives to enable both sides to collaborate and transform their communications, their integration, and ultimately the brand value!

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- Economic Aspects of Trademark Transactions—Valuation, Taxes, and Financial Planning
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Plan Ahead

2019 Events

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2020 Event

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<tr>
<td>April 25–29</td>
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<td>Singapore</td>
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Learn more about INTA events, including international roundtables, networking receptions, e-Learning, and academic competitions, at www.inta.org/programs.

Dates and topics subject to change. Contact meetings@inta.org for the latest information.
INTA Engages with Latin American IP Associations and Offices

From November 25–28, INTA Associate for Latin America and the Caribbean Representative Office, Agustina Davis, attended the XX Congress of the Inter-American Association of Intellectual Property (ASAPI) in Rio de Janeiro, Brazil. More than 500 people from Latin America, North America, Europe, and Asia attended.

During the Congress, Ms. Davis had the opportunity to meet with INTA members from the region and discuss INTA’s Latin American subcommittees’ projects and initiatives. She also met with ASAPI’s authorities and Latin American government officials.

Seminar on Geographical Indications and Denominations of Origin
On Monday, October 8, Mr. Luis Londoño attended the Seminar on Geographical Indications and Denominations of Origin organized by the Chilean National Institute of Industrial Property (INAPI) in Santiago, Chile.

Authorities from the World Intellectual Property Organization (WIPO) and the Ministry of Economy and Chilean Technical Cooperation Service (SERCOTEC) also attended the event, as well as experts from the Ministry of Agriculture. They discussed various matters related to geographical indications (GIs) and denominations of origin (DOs), including the challenges related to the promotion of products that have high social impact. SERCOTEC also provided information regarding the programs they offer in regard to GIs and DOs.

International exhibitors from Tequila and Café de Colombia, Juan Valdez also attended. They shared experiences in using DOs to promote their products and provided educational opportunities for the agricultural producers, artisans, and members of the fishing industry who attended the event. Issues discussed included the challenges associated with trading products protected by DOs and solutions that have shaped the success of producers in other countries.

Launch of AI “Deep Learning” Tool at INAPI
On October 12, Mr. Luis Londoño and Ms. Davis attended a ceremony for the launch of an artificial intelligence (AI) tool based on “deep learning,” which was hosted by INAPI and the faculty of the Physics and Mathematics Sciences Department of the University of Chile.

Representatives of INAPI and faculty of the Physics and Mathematics Sciences Department presented their vision for a new trademark system, which was developed jointly by the two institutions using AI. They presented a new method for searching and comparing trademark labels using deep learning that will save examiners time when reviewing trademark applications. This new system may have other significant applications as well—not only for INAPI but for institutions such as customs, which could improve methods for seizing counterfeiting products.

Association Updates

INTA Raises Awareness Around Brand Restrictions in Latin America

INTA’s Chief Representative Officer, Latin America and the Caribbean, José Luis Londoño, was invited to present at the International Think Tank Policy Dialogue on Health, Trade, and Innovation in Bogotá, Colombia, organized by Geneva Network and the Colombian Institute of Political Science Hernán Echeverría, which took place September 25–27.

During the two days of presentations, the participants discussed how new regulations that restrict intellectual property (IP) had not improved access to medicines or had the positive effects that governments expected. They concluded that these short-term measures, instead of encouraging competition and a better economic environment, are a deterrent to access to medicines.

From October 1 to 5, Mr. Londoño attended the event +Cartagena in Cartagena de Indias, Colombia. He was invited to present on October 4 in a session titled “Brands and Marketing.” His presentation was titled “The Impact of Regulatory Restrictions on Brands and the Anti-Intellectual Property Sentiment in the Sales Force.”
Roundtable on Adherence to WIPO Treaties

On June 26, INTA’s Chief Representative Officer for Latin America and the Caribbean, José Luis Londoño, and Associate for Latin America and the Caribbean, Agustina Davis, attended a meeting at the Ministry of Economy of Chile hosted by the Chilean National Institute of Industrial Property (INAPI). INAPI presented a proposal to the government to adhere to eight World Intellectual Property Organization (WIPO) international treaties: the Nice Agreement, the Strasbourg Agreement, the Locarno Agreement, the Vienna Agreement, the Patent Law Treaty, the Singapore Treaty on the Law of Trademarks, the Madrid Protocol, and the Hague Agreement.

During the roundtable, Carolina Belmar, Subdirector of Trademarks at INAPI, presented the main content of the treaties and the benefits and challenges of their implementation if Chile were to adhere to each of them. After the presentation, the attendees were able to ask questions and make comments.

Mr. Londoño shared INTA’s position on the Madrid Protocol and referred to Colombia’s and Mexico’s experiences with the implementation of the Protocol.

Association Weighs In on WIPO Treaties and Brand Restrictions in Chile

From left to right: INTA Associate for Latin America and the Caribbean, Agustina Davis; Diego Morandé (Guerrero Olivos, Chile), Carolina Contreras (Fundación Pro Bono Chile, Chile); and Peter Dirk Siemsen (Dannemann Siemsen, Brazil), ASIPI Honorary President and Founder.

Agustina Davis Joins INTA as Associate in the Latin American and the Caribbean Representative Office

INTA is pleased to announce that Agustina Davis joined INTA as Associate in the Latin America and the Caribbean Representative Office on May 10. Ms. Davis obtained her Intellectual Property Masters (LL.M.) from Melbourne University, Australia. Prior to that, she worked as an IP associate attorney at Alessandri Abogados in Chile for more than four years.

She also holds a double master’s degree in international law, investments, commerce, and arbitration from Heidelberg University (Germany) and Universidad de Chile, and received her bachelor’s degree in social science and law from the Adolfo Ibáñez University (Chile). Ms. Davis also taught public international law and a specialization course in IP at the National University Andrés Bello. She is fluent in English and Spanish.

INTA Sends Delegation to Brazil and Participates in Intellectual Property Events in Mexico

From August 19 to 22, INTA Chief Executive Officer Etienne Sanz de Acedo and Chief Representative Officer, Latin America, José Luis Londoño, visited São Paulo, Brazil, to attend the 38th Annual Meeting of the Brazilian Intellectual Property Association (ABPI).

For the second time, INTA was invited to be part of the opening ceremony and was seated at the main table. Mr. Sanz de Acedo participated on a panel titled “The Value of IP in the Relationship of Accelerators, Incubators and Start-Ups / Block Chain.”

The delegation also took the opportunity to meet with different regional intellectual property (IP) offices and associations, such as the IP offices of Argentina, Brazil, Chile, Mexico, and Spain; the Interamerican Association of Intellectual Property (ASIPI); ABPI; and the São Paulo IP Agents Association.

Finally, the delegation had a meeting with the Brazilian National Industry Confederation (CNI), an association formed by more than 700,000 companies from 27 Brazilian states that periodically produces studies and papers about various economic issues, including IP.
INTA Position on Bill to Restrict Pharmaceutical Trademarks in Chile
On July 10, Mr. Londoño, Ms. Davis, and INTA member Antonio Varas (Porzio Ríos García, Chile) attended a session of the Health Commission of the Chamber of Deputies of the Chilean Congress. The goal was to present INTA’s position on the implications of Article 128bis of Bill 9914-11, which initially limited dramatically the size of trademarks on pharmaceutical product packaging. However, it was recently established that a regulation administered by the Ministry of Health will instead be responsible for determining the shape, size, colors, proportion, characteristics, and content of medicine labels. INTA presented its view regarding the dangers of trademark restrictions and established that this modification is an improvement on the prior wording of the article, as it no longer explicitly limits the use of trademarks or any other intellectual property (IP) on packaging, instead leaving it to the Ministry to craft a new regulation. However, the Association stressed that the Ministry of Health must be cautious when using its regulatory powers and avoid reverting to the initial wording of Article 128bis, which would unjustifiably limit the acquired rights of trademark owners to use their trademarks.

Finally, INTA offered to participate and contribute to the construction of an adequate and balanced regulatory framework that considers elements of competitiveness and health as complementary.

International Seminar on Counterfeit Products Detection and Challenges for Customs
On July 31, INTA’s Anticounterfeiting Committee, together with the National Customs Service of Iquique, Chile, organized the International Seminar on Detection Methods for Counterfeit Products and Border Challenges. INTA was represented by Ms. Davis and a number of members. The event opened with presentations by INTA members regarding the prevention of illegal trade and criminal prosecution. It also included two panels: the first was titled “Current Customs Practices Against Counterfeiting in Chile” and the second was “Private-Public Collaboration in Counterfeiting.” The panelists included INTA representatives, as well as members of the National Customs Service of Iquique, the Tax Office, the Prosecution Office, the National Chamber of Commerce, and the duty-free zone of Iquique.

The seminar was mainly directed at judges and prosecutors. It addressed issues related to enforcement of criminal actions in Colombia, the policies of Colombia’s General Prosecutor Office, an explanation of the procedures surrounding border measures by the customs authority, as well as critical debates such as compensation for damages due to infringements of IP. Mr. Londoño presented on the role of brand owners in the IP enforcement system.

INTA Participates in Anticounterfeiting Events in Colombia and Mexico

IP Rights Training Organized by the U.S. National Intellectual Property Rights Coordination Center
From August 20 through 23, INTA participated in an intellectual property rights (IPR) enforcement training held in Mexico City, Mexico. The training was organized by the U.S. National Intellectual Property Rights Coordination Center (IPR Center), in partnership with the Mexican Tax and Customs Administration Service (SAT). The SAT is the body responsible for collecting taxes and applying the customs laws in the country.

The purpose of the event was to create an open forum between the public sector and private sector through IP rights trainings and discussion panels. In attendance were over 100 officials from the SAT, police, prosecutors, and judiciary.

Representatives from Adidas, Apple, Inc., Chanel, Eli Lilly, GlaxoSmithKline, Novartis, Phillip Morris International, P&G, Pfizer, UL, and VF Corporation presented brand identification training to the officials in attendance and participated in a panel at the close of the workshop. Guest speakers from the public sector included representatives from the Federal Commission for the Protection Against Sanitary Risk (COFEPRIS), the Federal Police/National Security Commission, the IPR Center, the U.S. Patent and Trademark Office, and the U.S. Department of Justice.

Attendees discussed the different health and safety issues associated with counterfeit products, collaborating on investigations, and why the protection of IPR is so critical for Mexico and its citizens. The workshop closed with a Q&A open discussion session, with questions submitted by the audience members to the participating private sector representatives.

INTA Hosts Joint Policy Dialogue in Colombia
On August 30, the Latin America and Caribbean Subcommittee of the Anticounterfeiting Committee held a policy dialogue on “Border Measures: Policies, Best Practices, and Collaboration” in Bogotá, Colombia. This dialogue was tailored to foster collaboration between enforcement officials and the private sector in Panama and Colombia, as neighboring countries. The event was organized by Claudette Vernet (Estrategia Jurídica, Colombia), Chair of the Latin America and Caribbean Subcommittee, and Anticounterfeiting Committee members Hugo Moran (Icaza, Gonzalez-Ruiz & Aleman, Panamá), Guillermo Lopez (Bolet & Terrero, Venezuela), and Natalia Vera Matiz (Vera Abogados Asociados S.A., Colombia).

Guest speakers at the dialogue included representatives and former officials from the customs authorities of both Panama and Colombia and experts from the private sector. Among them were Rodolfo Samuda, professor at the University of Panama and former customs official with the Colombia Directorate of National Taxes and Customs (DIAN); Julián Vélez, IP expert and lawyer from DIAN; César Aguirre and Gustavo Osorio, both DIAN officials, who spoke on free trade zones; and Juan Pablo Moreno, an innovation and digital transformation specialist (Colombia), who spoke on digital transformation and innovation as applied to IP crimes.

The attendees discussed different regulations, policies, and best practices on border measures and free trade zones in each country, with a main focus on the importance of collaboration between frontier countries.
INTA Engages with Andean Community Judges on IP Enforcement

The Judicial Training Task Force of INTA’s Enforcement Committee, in association and cooperation with the Andean Community Court and Colombia’s Consejo Superior de la Judicatura (the Supervisory Organ for Judges and Courts in Colombia), organized and hosted a workshop on July 30 in Bogotá, Colombia.

Following a 2017 event in Quito, Ecuador, this second Andean Community–focused workshop was created for Colombian judges of first and second instances and addressed trademark rights and the significant role the Andean Community Court and System have in intellectual property enforcement matters. In addition to the judges in the auditorium of the Consejo Superior, the program was broadcast live stream to 20 local court offices around the country, reaching more than 400 judges.

In the News

ARGENTINA: Court Awards Substantial Damages for Unfair Use of Trademark as Keyword

The use of a third party’s trademarks as “keywords” in search engines was ruled an undue use of the trademarks and an act of unfair competition by Chamber III of the Federal Court of Appeals for the City of Buenos Aires. Organization Veraz v. Open Discovery S.A./Cease of use action, Docket No. 1789/09, May 4, 2018.

In this case, the defendant, Open Discovery S.A., used the trademarks VERAZ and ORGANIZACIÓN VERAZ, owned by the plaintiff, as keywords in Internet search engines. As a result, the defendant’s webpage appeared in Internet users’ search results for these keywords.

The court of first instance ruled against Open Discovery and ordered the company to cease use of VERAZ and ORGANIZACIÓN VERAZ on the basis that the trademarks were well known in the field in which they were used. (Organization Veraz provides commercial reports on physical persons and companies, mostly used by credit institutions such as banks). The court added that a strict standard should be applied with respect to well-known trademarks to avoid a third party taking advantage of a particular mark’s prestige. The court also applied the principles of loyalty and good faith, which help to avoid consumer confusion. The court of appeals confirmed the lower court’s ruling.

In its decision, the court of appeals took into consideration (i) similar cases in foreign countries (USA/Europe); (ii) the distinctive character and the renown of the plaintiff’s trademark; and (iii) the act of unfair competition by a direct competitor.

The court of appeals also increased the damages awarded by the court of first instance. For a number of years, the courts were reluctant to award damages in trademark cases due to the difficulty in proving the damage caused; however, on the basis of the Argentine Procedural Code, in the 1990s the courts began adopting the position that the use of a third party’s trademarks on its own can cause damage, and that if there is difficulty in proving that damage, the courts could establish it based on the circumstances of the particular case. Thus, the courts started awarding damages, mostly nominal.

In this case, however, the court of first instance had awarded damages for ARS 35,000 (about USD 920), but the court of appeals awarded damages in the amount of ARS 3,336,468 (about USD 87,900). This represents a substantial increase, both in this case and also as compared to the amounts typically awarded by the courts to date. We must now see if the trend is continued by other courts.

BOLIVIA: Entry to the Hague Apostille Convention

In September 2017, Bolivia signed the Hague Apostille Convention, which entered into force on May 7, 2018. Presidential Decree No. 3541, which was passed on April 25, 2018, sets out the regulations for its application. Article 11 of the decree states that “foreign documents that are legalized with Apostille […] will have full effects within Bolivia.” This will allow trademark owners to more easily prosecute trademark applications and provides an easier approach to defending trademarks from cancellation by demonstrating use in member states belonging to the Andean Community of Nations, as the legalization procedure will be simplified and considerably less expensive.

Foreign intellectual property (IP) owners were previously burdened with visiting a Bolivian Consulate to obtain legalizations of powers of attorney and other documents to be used in Bolivia in connection with trademark prosecution. This process resulted in very high, and in some cases even prohibitive, official fees for validation of documents. In addition to the costs, the time period for legalizations was often long, causing trademark owners to miss deadlines. Many IP owners in Bolivia lost application fees, priorities, opposition rights, and even the right to defend against cancellation actions.

Regarding cancellation actions, the Andean Law under Decision 486, Article 165, provides that:

The competent national office shall cancel the registration of a trademark at the request of any interested party when, without justification, the trademark has not been used in at least one of the member countries, by the owner or his licensee or any other person authorized for such purpose during the three consecutive years preceeding the date on which the cancellation action was initiated…

The option to file evidence of use from Colombia, Ecuador, or Peru is particularly useful to brand owners because they may not have entered smaller markets, such as Bolivia, but do have trade and business in the Andean Community. The Apostille Convention will put Bolivia on the radar of IP owners seeking protection.
INTA in Twelfth International Law Enforcement IP Crime Conference

The Conference theme for this year focused on “Combating the Global Crime Wave of Illicit Trade” and featured a mix of plenary and panel sessions, with opportunities for attendees to break out into operational workshops focused on different enforcement topics.

Ms. Pho spoke on a panel titled “Combating Online Threats and Making the Internet Safer for Consumers,” moderated by Liam Gimon (INTERPOL), with Angus Lee (Australian Federal Police), George Salama (Twitter, Int.), and Maher Esmat (ICANN) as panelists. Ms. Pho spoke about the recent activities of the ACC and what the committee is doing to combat online counterfeiting. In particular, Ms. Pho spoke about the completion of the guide Addressing the Sale of Counterfeits on the Internet and how a collaborative effort of stakeholders is important in curbing online counterfeiting. A critical piece of the stakeholder group are the consumers. Ms. Pho spoke about how educating consumers is a necessary part of anticounterfeiting enforcement and emphasized the work of the Unreal Campaign in educating teenagers ages 14–18 on the value of trademarks and the harms of counterfeit products.

The Association was able to coordinate several meetings during the conference with Dubai Police, Dubai Customs, the Emirates Intellectual Property Association, and the Brand Owner’s Protection Group to discuss anticounterfeiting priorities in the region.

In the News

LEBANON: Revised Procedures for the Recordal of Assignments and Mergers

Revised procedures were introduced by the Office of Intellectual Property (the Office) in Lebanon relating to the recordal of assignments and mergers, effective June 29, 2018. While in the past, the recordal of an assignment or merger was considered complete upon the issuance of an official declaration to that effect by the Office, the process now entails additional requirements.

Applicants are now asked to submit the original certificate of registration along with the application for the recordal of an assignment/merger as an additional documentary requirement. Upon completion of the process, the Office will issue a new certificate instead of a simple declaration. However, the format of the new certificate has not yet been finalized. It is not clear whether the certificate will simply be issued in the name of the new owner, or if it will plainly show the details of the recordal as an endorsement while keeping the name of the original owner. The original certificate of registration will not be returned to the owner upon completion of the recordal of assignment/merger.

The downside of this revised procedure is that the application for the recordal of assignment/merger will not be processed if the original certificate is not submitted. Thus, it would appear that owners who have not kept the original certificate of registration in their files...
YEMEN: Class Headings No Longer Acceptable
As part of the Yemeni Ministry of Industry and Trade’s overall objective to improve the laws and procedures relating to the protection of intellectual property rights, on May 26, 2018, it issued Ministerial Decree no. 72/2018, introducing some changes to the administration of trademark applications in Yemen. The decree, which took effect on August 26, 2018, among other things, repeats past announcements that the use of the class headings of the Nice Classification by way of specifications of goods and services in new trademark applications will no longer be an acceptable practice in Yemen.

As a result, from August 26, 2018, onwards, applicants must state the specific goods or services of interest as to the actual or intended use, rather than the general descriptions set out broadly in the class headings, when applying for the registration of their marks. New applications that do not conform to this requirement will be identified during the examination phase and returned to the applicants to provide more specific indications.

The new change is meant to resolve any ambiguity as to the actual and proposed use of the applied-for marks and align local trademark practice with Yemeni Law No. 23 of 2010 on Trademarks and Geographical Indications (the Law) and its implementing Regulations, particularly the following two articles:

- Article (3) of the Law: The trademark is every distinctive shape perceivable by eye facility and consisting of names, words, letters, figures, signatures, drawings, signs, stamps, pictures, encryptions, unique formation of color or collection of colors, or a combination of any of the aforesaid elements if the same is used or otherwise intended to be used in distinguishing goods or services of a commercial, industrial, agricultural, professional or service establishment.

The application for registration of a trademark shall be submitted to the Registrar and must include the following details: ... (C) The goods and services that the trademark will be fixed on and the relevant class.

Yemen follows the eighth edition of the Nice Classification and applicants must therefore use this version as a guide when preparing the lists of goods and services.

Interview
Panelists Discuss Trademark Harmonization and More at INTA’s 2018 Middle East and Africa Conference
From December 10 through 11, INTA’s 2018 Middle East and Africa Conference: Innovation, Investment, and IP in Dubai, United Arab Emirates, examined the most pressing issues for intellectual property (IP) owners in these vast and developing regions. Jon Parker (Gowling WLG, United Arab Emirates), a member of the Middle East and Africa Conference Project Team, moderated Session 3—State of Play: The Growing Need for Harmonization, and Session 6—Balancing IP Rights and Regulatory Restrictions. He spoke with the INTA Bulletin in advance of the conference for a sneak peek at what these sessions addressed and why brand owners should be focused on this region of growing commercial importance.

What are some of the biggest challenges remaining with respect to achieving global trademark harmonization? Cultural differences can play a significant role in harmonization, as can safeguarding the national interest/national identity. For example, many countries in the Middle East and Africa require legalized supporting documents, which can generate government revenues in countries where taxes are low or do not exist. As such, there are different competing needs upon IP offices within their own countries, as well as in the wider region or on a global scale, that need to be considered in any harmonization projects. We will touch on harmonizing treaties such as the Singapore Treaty on the Law of Trade Marks.

We find that, even within the region, practice and requirements can vary significantly from one country to another. The question for harmonization is do we adopt the “lowest” setting or do we adopt the “highest” setting, or something in between? If you are looking at countries where one has a fairly light touch for inherent registrability, for example, alongside another which has a robust process, which is better? If you are a brand with a nontraditional mark, you would prefer the lighter touch system where you could cost-effectively obtain protection, over and above a regime where the bar is set very high and there is no guarantee of protection even with extensive evidence of use. Against that, you could argue that in obtaining a registration through a tougher regime, such a registration should be afforded more evidentiary weight. But in reality, does that sway the enforcement official, or do they simply see the registration certificate? These are the key questions.

There are also times when you may lose out due to harmonization. A local example of this is that, once Oman fully implements and adopts the Gulf Cooperation Council (GCC) law, there are a number of areas in the current local law that will no longer be available, such as “honest concurrent use,” which allows similar marks to coexist. However, harmonization is still to be lauded and something we should look to achieve, even if it may come at a “cost” at the national level in some respects.

Read the full report in the INTA Bulletin.
INTA Participates in the TM5 Invited User Session in Seoul

In November, Alex Cho (Kim and Chang, South Korea), who serves on the Trademark Office Practices Committee (TOPC) TM5 subcommittee, represented INTA at the TM5 Invited User Session in Seoul, South Korea. During the session, users had the opportunity to ask questions and receive updates about the 15 TM5 joint projects, which are aimed at the harmonization or improvement of trademark procedures. The TM5 Offices value stakeholder participation and they maintain a website with information about the member IP offices and their projects. (See the TM5 website at www.tmfive.org.)

National IPR Coordination Center IP Symposium

In late October, INTA participated in the Annual National Intellectual Property Rights (IPR) Coordination Center Symposium in Arlington, Virginia, which gathers government officials and brand owners to discuss IP enforcement and coordination. The focus of this year’s summit was brand engagement and outreach using social media. The symposium provided ideas for brand owners to connect with consumers and influencers. Government officials noted how they use social media to share information about enforcement actions and provide direct education to consumers about the dangers of counterfeit goods.

Panelists delineated how different social media platforms connect with consumers and the need to strategically engage, depending on the platform, including the creation of storylines, dialogue, videos, and pictures.

As part of the symposium, INTA staff also participated in a panel focused on using social media as a public education tool and discussed the Association’s innovative social media strategy to support building consumer trust with brands and providing education and outreach to consumers and businesses. INTA also discussed its Unreal Campaign, which seeks to connect with students of all ages to educate them about the dangers of counterfeit goods.

INTA PAC Hosts Reception at the 2019 INTA Leadership Meeting

INTA’s Washington, D.C., Representative Office enjoyed meeting with members and discussing the office’s activities, including legislative work and outreach, at the INTA Leadership Meeting in New Orleans, Louisiana, USA, last month. Among the many activities and meetings in which the office took part, INTA’s Political Action Committee (INTA PAC) Board of Governors hosted a reception featuring special guest speaker, Ralph Brennan, who owns and operates with family members a number of iconic restaurants in New Orleans. In a packed room of INTA PAC supporters, Mr. Brennan discussed the importance of trademarks as a key component of his family’s business. INTA PAC supports both U.S. political parties and provides unique opportunities for INTA to advocate and represent brand owners’ interests in the U.S. Congress.

Washington, D.C., Office Prepares for 116th Congressional Session

When the 116th session of Congress convenes in January, INTA will meet with the new members of Congress and new leadership of committees of interest to introduce the Association’s legislative goals and engage about trademark issues.

INTA Participates in the TM5 Invited User Session in Seoul

Last month, elections were held in the United States for the entire House of Representatives and a portion of the U.S. Senate. Two key intellectual property (IP) champions will retire at the conclusion of this session of Congress from the U.S. House of Representatives: Rep. Bob Goodlatte (R-VA-6th) and Rep. Darrell Issa (R-CA-49th). An IP champion from the U.S. Senate, Senator Orrin Hatch (R-UT), is also retiring; however, the majority of INTA’s champions in Congress were re-elected or not up for election in this cycle, including the current leadership of the Congressional Trademark Caucus (CTC).

During the Holiday Shopping Season

INTA hosted a congressional briefing on counterfeit goods during the holiday shopping season in the Rayburn House Office building. The featured guest speaker was U.S. Intellectual Property Enforcement Coordinator Vishal Amin. The expert panel included officials from the Consumer Products Safety Commission, National Intellectual Property Rights Coordination Center, U.S. Customs and Border Protection, National Crime Prevention Council and the U.S. Department of Justice, and The Walt Disney Company. The panelists provided insights and answered questions about the direct health and safety challenges presented by counterfeit goods.

Association Signs Memorandum of Understanding with Canadian Intellectual Property Office

On November 28, INTA and the Canadian Intellectual Property Office signed a Memorandum of Understanding that will promote collaboration in areas of training and outreach for both parties.

Congressional briefing on Counterfeit Goods During the Holiday Shopping Season

On December 6, INTA hosted the Congressional briefing on counterfeit goods during the holiday shopping season in the Rayburn House Office Building. The featured guest speaker was U.S. Intellectual Property Enforcement Coordinator Vishal Amin. The expert panel included officials from the Consumer Products Safety Commission, National Intellectual Property Rights Coordination Center, U.S. Customs and Border Protection, National Crime Prevention Council and the U.S. Department of Justice, and The Walt Disney Company. The panelists provided insights and answered questions about the direct health and safety challenges presented by counterfeit goods.
Association Updates

INTA Meets U.S. Copyright Office Officials to Discuss Key Issues

On September 11, INTA visited the U.S. Copyright Office in Washington, D.C., to meet with senior officials. Dale Cendali (Kirkland & Ellis, USA), chair of the Copyright Policy Subcommittee of INTA’s Copyright Committee; Axel Nordemann (Boehmert & Boehmert, Germany), Copyright Committee chair; and Debbie Cohn, INTA Senior Director, Government Relations, attended in person and several Copyright Committee members, including Noel Cook (Owen, Wickersham & Erickson, P.C., USA), Copyright Committee vice-chair, attended remotely.

The meeting focused on copyright registration of logos and other current topics of interest to the Committee, as well as potential future collaboration on programs and events. The discussion was extremely productive and served to enhance INTA’s relationship and future work with the Copyright Office through the Copyright Committee.

Trademark Administrators and Practitioners Brush Up on Trademark Trends

Sunny Orlando, Florida, USA, was the perfect venue for the Trademark Administrators and Practitioners Meeting (TMAP) 2018, which was held September 12–14 at the Rosen Plaza Hotel.

More than 400 professionals gathered to discuss important topics, such as trademark clearance; advertising law and data privacy; the ethics of trademark investigations; copyrights and designs; counterfeiting; and how to avoid trademark “genericide.”

As a new initiative this year, and prior to the formal kick-off to the meeting, many participants volunteered to help the Second Harvest Food Bank in its effort to collect and distribute donated food to more than 550 feeding partners in six central Florida counties.

INTA CEO Etienne Sanz de Acedo formally opened the event and, together with TMAP Co-Chairs Marion Woods (Eversheds Sutherland, USA) and Amber Sterling (Association of American Medical Colleges, USA), warmly welcomed the attendees to the meeting. Educational content included Luncheon Table Topics on seven key issues; Regional Update sessions on Africa, Asia, and Europe; panels on related rights and genericide; and a presentation by the TMAP Project Team on how to access INTA’s many online resources.

Overall, TMAP succeeded once again in fostering community, updating registrants on current trademark trends, strengthening professional relationships, and creating new friendships. INTA looks forward to seeing everyone again at the 2019 TMAP Meeting in Berlin, Germany, on September 16–17, 2019.

Focus on IP Enforcement and Counterfeiting with Lawmakers in Washington and New York

INTA’s Washington, D.C., office was focused on advocacy and outreach throughout the summer, including participation in events both in Washington, D.C., and New York representing the trademark community.

INTA Participates in Roundtable with Representative Ted Deutch

In August, INTA participated in an intellectual property (IP) stakeholder roundtable in Washington, D.C. with Representative Ted Deutch (D-FL-22nd) focused on education and outreach about the importance of IP enforcement. Representative Deutch is committed to strong IP laws, including opportunities for increased mechanisms for IP enforcement, and noted proudly that he serves as a co-chair of the Congressional Trademark Caucus (CTC). Roundtable participants, including Representative Deutch, stressed the need to educate consumers about the challenges presented by counterfeiting, such as direct health and safety risks.

INTA Participates in Brooklyn, New York, Roundtable with Representative Hakeem Jeffries

The Washington, D.C., office also participated in a roundtable focused on innovation and trademark counterfeiting with Representative Hakeem Jeffries (D-NY-8th) in August. INTA member Heather J. McDonald (Baker Hostetler, USA), who served as 2016–2017 Chair of INTA’s Anticounterfeiting Committee, spoke about the importance of innovation in the trademark world and the dangers of counterfeiting. In a packed room at the New Lab in Brooklyn, New York, INTA joined the United States Chamber of Commerce’s Global Innovation Policy Center (GIPC), the International Anticounterfeiting Coalition, and the Brooklyn Chamber of Commerce to discuss the importance of investing in trademarks and the need for education and outreach to consumers about the direct harms caused by counterfeit products.

During the roundtable, Representative Jeffries spoke about the need for government and private industry to work collaboratively on IP enforcement. He further noted his commitment to working with the IP community on education and outreach to consumers about counterfeiting.

In her remarks, Ms. McDonald spoke about the challenges presented by counterfeiting and its direct effect on consumers and brands. She noted INTA’s commitment and focus on addressing the issues caused by counterfeit products.

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**Association Updates** continued from page 33

**INTA Supports Application Interpretation for Copyright Claims at Supreme Court of the United States**

On September 4, INTA filed an *amicus curiae* brief with the Supreme Court of the United States (U.S. Supreme Court) in *Fourth Estate Public Benefit Corp. v. Wall-Street.com, LLC*, et al., taking the position that “registration of [a] copyright claim has been made” under 17 U.S.C. Section 411(a) at the time of filing a copyright application, deposit, and fee with the United States Copyright Office (U.S. Copyright Office) for purposes of instituting a copyright infringement action in a U.S. court.

Read the full report in the INTA Bulletin.

**INTA Presents at Intellectual Property Training Program for Foreign Service Officers**


**Overview of Program and Participants**

The program is an annual collaboration between the USPTO and the United States Department of State (U.S. Department of State) to provide intellectual property (IP) training for Foreign Service Officers, most of whom do not have extensive experience in IP. The program provides an opportunity for Foreign Service Officers to learn about key IP issues and to develop private-public relationships that will enhance their IP work abroad.

Approximately 15 U.S. Department of State Officers (Foreign Service Officers) assigned to key economic posts around the world, including Bosnia and Herzegovina, China, Ethiopia, Israel, Italy, Lebanon, Pakistan, Vietnam, and Washington, D.C., participated in this year’s program.

In addition to INTA, the panel included speakers from the Business Software Alliance, Pharmaceutical Manufacturers of America, and the U.S. Chamber of Commerce. Lisa Dyer, Director of the Office of IP Enforcement (IPE), Bureau of Economic & Business Affairs, U.S. Department of State, moderated the discussion.

Read the full report in the INTA Bulletin.

**INTA Brings Delegation to Ottawa**

On July 18, 2018, the Canada Subcommittee of the Anticounterfeiting Committee traveled to Ottawa, Canada, for a day of meetings to discuss the anticounterfeiting regime in Canada. The delegation included Canada Subcommittee Chair David Lipkus (Kestenberg Siegal Lipkus LLP, Canada); Jennifer Bleyx (Chanel Inc., Canada); Tania D’Souza-Culora (Gowling WLG, Canada); Karen McDonald (Norton Rose Fullbright, Canada); Andrea Rush (Blaney McMurtry, LLP, Canada); Nathaly Vermette (DS Avocats, Canada); INTA consultant Gar Knutson (Borden Ladner Gervais LLP, Canada); and INTA Senior Coordinator, Anticounterfeiting, Tiffany Pho.

The delegation first met with members of the Department of Innovation, Science and Economic Development, including Mark Schaan, Director General, Marketplace Framework Policy Branch; Andrea Flewelling, Senior Project Leader, Policy Development; and Luc Laforest, Senior Policy Analyst, Copyright and Trade-mark Policy Directorate. They discussed the current state of anticounterfeiting legislation in Canada following the recent release of the Intellectual Property (IP) Strategy from the Department of Innovation, Science and Economic Development. INTA offered its support for future anticounterfeiting legislative changes.

In addition to INTA, the panel included speakers from the Business Software Alliance, Pharmaceutical Manufacturers of America, and the U.S. Chamber of Commerce. Lisa Dyer, Director of the Office of IP Enforcement (IPE), Bureau of Economic & Business Affairs, U.S. Department of State, moderated the discussion.

The delegation also met with Michael Junek, Director, Program Policy and Management Division, Canada Border Services Agency, to discuss how INTA could assist in strengthening anticounterfeiting enforcement at the borders. INTA discussed the formation of an IP rights coordination center, based on the U.S. model, and offered its assistance in providing brand owner training for border officials to target counterfeit shipments through Customs Connection and in-person trainings. The delegation then met with Caitlin Gropp, Director of Parliamentary Affairs for Senator Joseph Day, and Arthur Lam, Policy Advisor, Office of the Minister of Innovation, Science and Economic Development, to discuss how INTA could assist in making anticounterfeiting a priority within the Canadian Parliament.

**INTA offered its assistance in providing brand owner training for border officials to target counterfeit shipments through Customs Connection and in-person trainings.**
North America

In the News

CANADA: High Times Ahead: Brand Restrictions on Legalized Cannabis in Canada

Cannabis was legalized in Canada on October 17, 2018, although sales are subject to many provincial and municipal restrictions on access. For now, only dried cannabis, cannabis oil, and plants may be sold—edibles and concentrates are expected to be approved next year. In anticipation of legalization, hundreds of trademark applications for cannabis and accessories have been filed in the Canadian Intellectual Property Office (CIPO). However, brand owners must be aware that while there are significant brand selection and use restrictions in both the Cannabis Act (S.C. 2018, c. 16) and Regulations, CIPO has signaled that such restrictions will not be considered in its examination process—posing potential issues for oppositions and enforcement.

The Canada Subcommittee of the Legislation and Regulations Committee provided comments on both the Tobacco and Vaping Products Act and the Cannabis Act in June.

Packaging for cannabis and cannabis accessories, and promotions, including for services, may not show endorsements, depict a real or fictitious person, character, or animal, or display brands that appeal to young persons (anyone under the age of 18), or evoke a way of life, including one associated with daring, excitement, or vitality. In addition, sensory attributes (smell, sound, taste) must not appeal to young persons.

The Regulations also limit brand display on cannabis products (cannabis and accessories that contain cannabis, such as a pipe sold with cannabis). Labels must display the authorized licensee’s name, a brand name, and may include only one additional brand element on each package panel. Brand size and color, as well as backgrounds, must be less dominant than, and contrast with, mandatory health warnings and the required cannabis symbol. Fluorescent colors are not permissible and embossing or texture is not allowed unless for accessibility or anticounterfeiting purposes. Brands can only appear on labels and may not otherwise appear on containers or coverings. Noncompliance can lead to significant penalties, ranging from fines to imprisonment.

CIPO has accepted applications for cannabis goods and services for years, and hundreds of applications are awaiting examination—many filed before cannabis branding restrictions were announced. CIPO has informally indicated that it will not examine applications for compliance with the Cannabis Act, so registrations may issue for marks that cannot lawfully be used.

CIPO has informally indicated that it will not examine applications for compliance with the Cannabis Act, so registrations may issue for marks that cannot lawfully be used. The Cannabis Act contains a “trademark saving” provision protecting registrants from expungement based on abandonment or nondistinctiveness due to compliance with the Act (but, oddly, not cancellation for non-use). This could potentially make hundreds of cannabis-related trademark registrations immune from expungement since brand owners may claim that branding rules prevent use.

There are many questions about the rules as well as the interface between cannabis brand restrictions and the Trademarks Act. What does “appealing to young persons” mean? Can (or should) cannabis companies rely upon earlier “illegal” use in enforcement? How will confusion be determined, particularly given limited brand choices, brand display restrictions, and regulated channels of trade? Will investment in cannabis companies, particularly by alcoholic beverage companies, result in cannabis being seen as a logical market expansion of alcohol?

All of this is to say that the new Canadian statutory regime dealing with cannabis is smoking hot, and brand owners are in for interesting times.

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UNITED STATES: TEQUILA Is Now a Registered Certification Mark

If you filed a federal trademark application listing “Tequila” in the identification of goods and services recently, you probably received an office action from the U.S. Patent and Trademark Office (USPTO) with a notice indicating that, because TEQUILA is now a registered certification mark, Consejo Regulador del Tequila, A.C. (CRT), a Mexican nonprofit civil association that includes agave liquor producers, producers/manufacturers, bottlers and distributors of Tequila, and representatives of the Mexican government, finally obtained U.S. Registration No. 5,225,126 for TEQUILA. The registration followed an almost eight-year battle before the Trademark Trial and Appeal Board (TTAB) with Luxco, Inc., a U.S. importer, bottler, producer, and marketer of alcohol products. Luxco, Inc. v. Consejo Regulador del Tequila, A.C., 121 U.S.P.Q.2d 1477 (T.T.A.B. 2017). The TTAB dismissed Luxco’s opposition in a decision issued on January 30, 2017.

Because TEQUILA is now a registered certification mark, examining attorneys are required to advise applicants that list “Tequila” in their identification of goods or services that they must delete that term and replace it with generic wording—most commonly, “distilled blue agave liquor.”

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