Asia-Pacific
“Looking Beyond Trademarks” Conference Co-Chairs on What to Expect in Sydney

Europe
All Eyes on Brexit

India
Increasing Engagement with Government Officials
From Seattle to Sydney: A Global Year

With just a few months left in my term as INTA President, I’d like to thank the Association’s global community of passionate, hard-working members for an exciting milestone year so far.

While we prepare now for the Leadership Meeting in New Orleans, Louisiana, we should also applaud the results of the 140th Annual Meeting in Seattle, Washington, USA, in May, which drew 10,900+ registrants from more than 150 countries, including 2,674 first-time registrants. This marked an increase from 10,642 registrants at the 2017 Annual Meeting, and demonstrates a steadily increasing demand for education and information-sharing on IP, as brands continue to expand into new jurisdictions and platforms.

As detailed on page 9 of this Global Report, INTA members from the around the world will soon gather once again, this time in Sydney, Australia, in October for INTA’s 2018 Asia-Pacific Conference: Looking Beyond Trademarks. With this conference we continue to strengthen ties in Asia-Pacific. The Association has ramped up its activities and collaborations significantly in the region this past year, including welcoming government officials from Australia, China, Hong Kong, Japan, Korea, New Zealand, and Singapore to the Annual Meeting in May.

Following the Asia-Pacific Conference, INTA leaders will convene in New Orleans, Louisiana, for the 2018 Leadership Meeting, where the Association leadership will continue to advance the Association’s objectives and goals, as well as bolster its commitment to corporate social responsibility efforts by participating in a volunteer program to benefit the New Orleans community.

Two events the INTA community will be preparing for at the Leadership Meeting and in the coming months are the 2019 Annual Meeting in my hometown of Boston, Massachusetts, and the 2020 Annual Meeting in Singapore. The Singapore Annual Meeting will mark the Association’s second Annual Meeting to be held in Asia and promises to bring industry and government together to discuss the challenges and opportunities for IP in this booming region. Start planning now to attend both of them!

All of these past and upcoming activities, and the many other developments described in the following pages, illustrate the truly global nature of our Association. We hope you enjoy this latest Global Report, and I look forward to seeing you at our upcoming events.

This report was compiled with the help of INTA’s Global Advisory Councils, as well as the INTA Bulletins Committee and the authors named herein. Please direct all comments/feedback to csteinberg@inta.org.

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INTA Delegation Strengthens Ties in Kenya

During the first week of June, an INTA delegation comprising INTA CEO Etienne Sanz de Acedo and INTA Representative, Africa and the Middle East, Tat-Tienne Louembe, undertook an official trip to Nairobi, Kenya. The visit presented an opportunity to acknowledge the efforts of the Kenyan government in enforcing the rights of brand owners and protecting consumers. It was also an occasion to introduce the Association, explore potential synergies, and advocate for the strict enforcement of IP rights in Kenya.

At the Supreme Court of Kenya, Mr. Sanz de Acedo introduced the Association to the Honorable Justin Muturi, Elder of the Order of the Golden Heart of Kenya (EGH), Speaker of the National Assembly. He further underscored the key role of the legislative branch in protecting trademarks and IP rights. The two men shared ways to transform Kenya into an “IP hub” in East Africa.

At the Kenya National Assembly, Mr. Sanz de Acedo introduced the Association to the Honorable Justin Muturi, Elder of the Order of the Golden Heart of Kenya (EGH), Speaker of the National Assembly. He further underscored the key role of the legislative branch in protecting trademarks and IP rights. The two men shared ways to transform Kenya into an “IP hub” in East Africa.

Prior to meeting with Mr. Muturi, Mr. Sanz de Acedo was warmly welcomed by the lawmakers who attended INTA’s 140th Annual Meeting in Seattle, Washington, USA, and with the chairs of select committees, including the Trade, Industry and Cooperative Committee, the Committee on Delegated Legislation, and the Committee on Justice and Legal Affairs. Meetings were also held with Jerome Ochieng, Permanent Secretary of the Ministry of Information Communication and Technology, and Chris Kiptoo, Permanent Secretary, State Department for International Trade. The INTA delegation also met with senior officers at the Kenya Anti-Counterfeit Agency and with representatives from the private sector.

Association Updates

INTA Briefs Officials from WIPO and the United Nations Conference on Trade and Development

In late June, INTA’s Representative, Africa and Middle East, Tat-Tienne Louembe, held meetings with officials at the World Intellectual Property Organization (WIPO) and the United Nations Conference on Trade and Development (UNCTAD).

Mrs. Louembe shared INTA’s latest activities in Africa—including INTA CEO Etienne Sanz de Acedo’s visit to Kenya, the Association’s analyses of various IP strategies and laws, and briefings of government officials and private sector representatives—with WIPO’s Regional Bureau for Africa. Mrs. Louembe also updated WIPO on the participation of delegates from Ghana, Kenya, and Uganda at INTA’s 140th
Mr. Louembe held discussions with senior officials of the Regional Bureau for the Arab Countries of WIPO regarding potential joint activities and INTA’s upcoming Middle East and Africa Conference: Innovation, Investment, and IP, which will be held in Dubai, United Arab Emirates, on December 10 and 11. The two-day conference for trademark owners and legal professionals will focus on the opportunities and challenges of attracting investment to the regions, how innovation is re-shaping the economy, and the importance of a robust IP strategy for effective protection and enforcement in these regions.

After providing an introduction to INTA and its mission and advocacy worldwide, including in Nigeria, Mr. Louembe underscored the importance of IP and trademarks as catalysts for strong economic growth. Furthermore, the two entities discussed the recent efforts of Nigerian authorities to revamp intellectual property (IP) legislation in order to equip the country with a comprehensive law relating to trademarks. Overhauling the current IP system would be a major step in the right direction and would be viewed as a positive development by brand owners, IP practitioners, and local entrepreneurs.

Mr. Louembe and Mr. Olagunju also agreed to move swiftly on the organization of a joint workshop for judges, which is expected to take place next year in Nigeria. The workshop will present a prime opportunity to engage with various stakeholders involved in the promotion and enforcement of IP rights. INTA’s first Judges Workshop on Trademarks took place in San Jose, Costa Rica, on November 28, 2016. INTA believes that providing judges, prosecutors, and professionals involved at different levels of trademark proceedings with information, resources, and international comparisons on best practices will foster awareness and understanding of IP issues.

Mr. Louembe held discussions with senior officials of the Regional Bureau for the Arab Countries of WIPO regarding potential joint activities and INTA’s upcoming Middle East and Africa Conference: Innovation, Investment, and IP, which will be held in Dubai, United Arab Emirates, on December 10 and 11. The two-day conference for trademark owners and legal professionals will focus on the opportunities and challenges of attracting investment to the regions, how innovation is re-shaping the economy, and the importance of a robust IP strategy for effective protection and enforcement in these regions.

At UNCTAD, Mr. Louembe met with Patrick Osakwe, Deputy Director, Africa and Least Developed Countries Division. Among other topics, Mr. Louembe and Mr. Osakwe agreed to look into the nexus between illicit trade and trademarks in select jurisdictions.

UNCTAD is a permanent intergovernmental body established by the United Nations (UN) General Assembly in 1964. While UNCTAD works mainly with governments to effectively deal with the magnitude and complexity of meeting the Sustainable Development Goals, the UN body is gradually opening up to the private sector and civil society.

An estimated 30,000 trademark applications are captured in these journals, which include all applications filed via the online platform from its inception in 2012 through the end of 2017. The two-month opposition period for these journals lapsed on April 12, 2018, after which final registration fees will be due in order for Registration Certificates to be issued by the Registry. This is important because, after April 12, third parties are no longer able to oppose alleged infringing trademarks published in these particular journals.

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Singapore 2020: INTA to Bring Industry and Government Together in Asia

INTA was honored to have numerous government officials from Asia join the 2018 Annual Meeting in Seattle, Washington, USA. Candice Kwok (Marks & Clerk, Singapore), Chair of the Trademark Office Practices—Asia-Pacific Subcommittee, noted, “Having government representatives from IP offices across the region participate in this year’s committee meeting underscored the important work that INTA is doing to address the diverse set of issues, as well as common challenges, that brand owners face in Asia.” Officials from Australia, China, Hong Kong SAR, China, Japan, Korea, New Zealand, and Singapore participated in various events and meetings.

INTA continued its engagement with officials in the region during Singapore IP Week, which took place September 4 - 5. INTA leadership attended and the Association hosted a luncheon for the 10 ASEAN IP offices.

Cross-Border Protection, Working with Judges, and Fighting Fake Pharmaceuticals with INTERPOL

On May 14, INTA represented international brand owners at an event announcing the public release of rules establishing Indonesia Customs’ new trademark recordal system. Enacting a recordal system for trademarks is one of the major policy initiatives for which INTA has been advocating in the Asia-Pacific region. Following the passage of Regulation 20 last year to enact provisions in the 2006 Customs Law, and following Implementing Regulation No. 40 of 2018 to implement a customs recordal system, Indonesia is clearly moving in the right direction to help brand owners protect their IP rights at the border in the world’s fourth largest country by population.

INTA did raise concerns with leadership about certain provisions which may prevent widespread use of the recordal system, such as the need for registrants to have a local Indonesian business entity in order to apply for a recordal.

Indonesia is clearly moving in the right direction to help brand owners protect their intellectual property at the border in the world’s fourth largest country by population, but INTA raised concerns about certain provisions which may prevent widespread use of the recordal system.

Additionally, a stringent three-strike policy for brand owners that do not reply to customs inquiries may prove to undermine the widespread adoption of the program, and, in particular, use of the program by small and medium-sized enterprises (SMEs), which would not otherwise have a business presence in Indonesia.

INTA will continue to work with customs to improve the system and looks forward to further engagement on the issue.

From May 15 to 17, INTA participated in the Operation Pangea XI Single Point of Contact (SPOC) Meeting, Asia Region, held at the INTERPOL Global Complex for Innovation (IGCI) in Singapore. Authorities from Sri Lanka, Fiji, Japan, Singapore, the Philippines, Cambodia, South Korea, Vietnam, Malaysia, Bangladesh, Thailand, China, Timor Leste, Hong Kong, Bhutan, and Australia participated in the program.

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focused on the sale of counterfeit pharmaceuticals in the region.

INTA shared important information about initiatives it is undertaking to address these issues, in particular, regarding the sale of counterfeit pharmaceuticals online. INTA’s Chief Representative, Asia-Pacific, Seth Hays, shared the findings of INTA’s Anticounterfeiting Committee’s best practices in a report called *Addressing the Sale of Counterfeit Goods on the Internet.*

Mr. Hays called on the attendees to encourage their governments to closely monitor this issue through research in line with a recent opinion editorial placed in regional media by INTA, titled, “In advancing e-commerce, ASEAN should study problem of fake goods sold online, protect consumers.”

### Association Updates

**Guiding SMEs**

SMEs are the drivers of growth in Asia, and INTA is supporting these businesses through public awareness and also exploring how the Association can better support these unique businesses through a Presidential Task Force.

In support of these initiatives, on June 6, INTA participated in the Asian Business Trade Center SME Summit and spoke on a panel session on IP with representatives from the Singapore IP Academy, the U.S.-ASEAN Business Council, and 3DUPlay, an Indonesian toy company. INTA raised three crucial points for SMEs to keep in mind regarding trademarks:

1. **Be informed:** Companies need to be aware of the consequences for not registering trademarks, including exploitation by trademark squatters.
2. **Be prepared:** SMEs need to dedicate time and resources to monitoring the market against counterfeits, in particular online counterfeits.
3. **Be positive:** Although trademark prosecution and enforcement may seem like a cost center, the smartest businesses always see trademarks and brands as a valuable asset and revenue generator in the long term through asset-backed loans or licensing revenue.

### First Delegation Visit to Nepal, Working with International Governmental Organizations, Advocating for Safe Regional E-Commerce

The Association of the Southeast Asian Nations (ASEAN) held the 32nd ASEAN Summit in Singapore from April 25 to April 28 under the theme “Building a Resilient and Innovative ASEAN.” A major item on the agenda was pushing more e-commerce in the region.

INTA has been emphasizing a need for policy makers to pay attention to the surge of counterfeits being sold online in the region as e-commerce is being promoted. Most recently, INTA published an opinion piece in Singapore’s *Today Online,* titled, “In advancing e-commerce, ASEAN should study the problem of fake goods sold online, protect consumers.”

### INTA in Nepal

From April 10 to April 12, INTA participated in an International Criminal Police Organization training on the fight against pharmaceutical and health-related counterfeits in Kathmandu, Nepal. Two dozen representatives from Nepal’s enforcement agencies attended the event to hear from industry and foreign governments on how to protect consumers from fake pharmaceuticals and personal care items.

INTA’s Chief Representative Officer, Asia-Pacific, Seth Hays, spoke on behalf of the Association, sharing the resources of INTA’s Anticounterfeiting Committee, including the online customs training webinar series, “Customs Connection.”

INTA also organized a delegation of members to make the first formal visits to the Department of Industries, which is in charge of IP registrations. The INTA delegation met with the Director General of the Department of Industries, Shankar Aryul. The Department of Industries shared recent efforts to digitize files, including all trademark registrations, a massive project which is currently under way.

Ms. Lohadhasan highlighted the need for police and customers to work together with brand owners and e-commerce platforms to combat the sale of counterfeit goods in the region.

On June 20, INTA Board Member Kowit Somwaiya (Lawplus, Thailand) spoke to a group of judges from Asia at a U.S. Patent and Trademark Office-ASEAN Judicial Colloquium on IP. Mr. Somwaiya addressed the group of judges from the 10 ASEAN countries on how to protect consumers from fake pharmaceuticals and personal care items.

On June 21, INTA Anticounterfeiting Committee member Sharmini Lohadhasan (BP plc, Singapore) spoke on behalf of INTA at the INTERPOL Project Chain Case Presentation. Officials attended from India, Jordan, Kazakhstan, Malaysia, Myanmar, Cambodia, China, Nepal, the Philippines, Singapore, Thailand, the United Arab Emirates, and Vietnam. Ms. Lohadhasan shared details of a complex cross-border, e-commerce anticounterfeiting case that implicated public safety. She highlighted the need for police and customs to work together with brand owners and e-commerce platforms to combat the sale of counterfeit goods in the region.

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Working with Partners Across Asia

On April 7, INTA supported the ASEAN IP Association’s annual general meeting, held in Phnom Penh, Cambodia. Undersecretary of State, Ministry of Commerce Samheng Bora delivered opening remarks. He noted that Cambodia is a member of a number of international agreements on intellectual property (IP), which is rare for a least developed country. He noted that Cambodia is also paying great attention to IP rights enforcement, citing efforts by the Cambodia Counterfeiting Committee, and he noted that the growth in online counterfeiting is a concern for the government.

INTA organized a panel session on online counterfeiting, moderated by Toe Su Aung (Elpe Ltd., UK) and featuring panelists Ellen Lin (JD.com, China), Brian Law (Evershed Harry Elias, Singapore), Wiramrudee Mokkhavesa (Tilleke & Gibbins, Thailand), and Sophia Hou (Lusheng, China). The panelists provided an overview of how online counterfeiting is tackled in their respective jurisdictions, including how a sales platform views these issues. INTA’s newly revised best practices on how to combat the sale of counterfeit goods online, “Addressing the Sale of Counterfeits on the Internet,” was discussed. The panelists also discussed the need to address online counterfeits on a regional level through cross-border information sharing and coordination. Malaysia’s Digital Free Trade Zone was highlighted as an example of how e-commerce offers small and medium-sized enterprises great promise for economic advancement, but also can present potential problems if the legal framework is not robust enough; for example, if customs recordals are not possible.

IDEAS Event in Malaysia

INTA was invited to participate in a regional think tank event organized by the Institute of Democracy and Economic Affairs (IDEAS) in Kuala Lumpur, Malaysia, on April 18. This half-day program released the research paper and IP index produced by IDEAS. INTA shared its impact study, The Economic Contribution of Trademark-Intensive Industries in Indonesia, Malaysia, the Philippines, Singapore, and Thailand, which was released last year.

The keynote speaker was Zulkarnain Mohammad from Malaysia’s IP Office, the Intellectual Property Corporation of Malaysia (MyIPO). He noted that MyIPO has been receiving a number of new IP filings. About 60 percent of filings are foreign filings overall (including patent and trademarks). MyIPO is committed to improving this trend and fostering more domestic filings and innovation.

Marolita Setiati (S普ruson Ferguson, Indonesia) presented a paper on ASEAN IP policy. She noted that Singapore’s increasing rankings in the IDEAS International Property Rights Index are due to a focus on technology improvements. Malaysia has slightly decreased in the rankings, and this is due to enforcement issues, though officials are focusing on areas such as online infringements through the country’s Special Internet Forensics Unit. Indonesia, the Philippines, and Thailand have relatively low rankings and this is again due to enforcement issues. Indonesia is improving, due mostly to the recent adoption of a customs regulation (Government Regulation No. 20) to control the import and export of goods infringing IP rights.

Sinclair Davidson (RMIT University, Australia) spoke on the framework of political attitudes that are influencing IP and anti-IP sentiment in Australia. He noted the anti-consumer sentiment that drives much of the attitude.

Raza Ullah Khan (Alternative Solutions Institute, Pakistan), spoke about the IP situation in Pakistan. He noted that there is a high amount of informal trade through porous borders. Pakistan is the world’s 18th largest economy and ranks 121st on the IDEAS IP Index. He noted that the laws in Pakistan are robust, but implementation is weak. This is the major driver for poor performance on these indexes. Piracy is rampant in higher education, as many textbooks are copies.

Ganesh Muren of Saora Industries, a young entrepreneur, talked about his startup and what IP means to him and his company. The company is dedicated to solving water cleanliness issues in rural Malaysia. He discussed the problems he faces trying to monetize his IP. He said that the government could make it easier to enforcement IP rights when they are infringed. He suggested that there could be an ASEAN IP bank for collaboration with others working in similar fields.

On April 30, INTA partnered with the Anticounterfeiting Society of Indonesia (MIAP) on a half-day program focused on the current state of Indonesia’s e-commerce anticounterfeiting. Representatives from Pfizer, Inc. (USA) and Luxottica Group, S.p.A. (Italy) spoke on the issue of online sales of counterfeits in their industries and how it negatively impacts public health. Mr. Hays shared INTA’s views on voluntary best practices to combat the sale of counterfeit goods online. Officials from the Pharmaceutical Regulatory Authority and the Ministry of Telecommunication and Information shared recent government initiatives and regulatory changes.

INTA Participates in Anticounterfeiting Event in Thailand

From June 20 to 22, INTA Board Member Kowit Somwaiya (LawPlus, Ltd., Thailand) participated in the Judicial Colloquium on Civil and Criminal IP Infringement Cases, organized by the U.S. Patent and Trademark Office (USPTO) and the ASEAN Secretariat. Mr. Somwaiya participated on behalf of the Association and spoke on a panel titled “Challenges for Consumers and Rights Holders in the Global and Online Environment,” along with Michael Schlesinger (Motion Picture Association, Singapore), Say Sujintaya (Baker & McKenzie, Bangkok), and moderator Peter Fowler, Senior Counsel at the USPTO.

Mr. Somwaiya spoke about the challenges facing brand owners in the realm of anticounterfeiting due to the growth of the Internet and what INTA is doing through the Anticounterfeiting Committee to address them. Mr. Somwaiya also spoke about the Unreal Campaign and the importance of educating consumers on the harms of counterfeit products in order to decrease demand for counterfeit goods.

Justice Suvicha Nagavajra, Chief Justice, Central Intellectual Property and International Trade Court (Bangkok) delivered the opening remarks. Other notable speakers included Judge Victoria Roberts of the U.S. District Court for the Eastern District of Michigan, Judge Derrick Watson of the U.S. District Court for the District of Hawaii, and Evan Williams, Regional Intellectual Property Law Enforcement Coordinator-Asia, of the U.S. Department of Justice.
INTA World IP Day Events in Brunei, Laos, Myanmar, and Singapore

World IP Day (WIPD) was celebrated on April 26. The week included a number of events in the region in which INTA participated.

On April 24, INTA participated in WIPD events in Singapore organized by the United States Patent and Trademark Office, the United Kingdom Intellectual Property Office, the French National Institute of Industrial Property, the Japan External Trade Organization, the Intellectual Property Office of Singapore, and the World Intellectual Property Organization. The UK High Commissioner to Singapore and the U.S. Chargé d’Affaires in Singapore opened the event.

Interview

Join INTA in Sydney for a Look Beyond Trademarks

To address some of the many issues facing brands in Asia-Pacific and beyond today, INTA will host its 2018 Asia-Pacific Conference: “Looking Beyond Trademarks—Protecting and Leveraging Your Brands for Growth,” in Sydney, Australia, October 11–12. This is the first time the Association is returning to Sydney in 10 years and will offer members in the region a convenient venue in which to gain insight on some key issues, according to conference co-chairs, Ken Hamilton (Spruson & Ferguson, Australia) and Rebecca Thomas (Forever New Clothing Pty Ltd, Australia).

Mr. Hamilton and Ms. Thomas spoke with the INTA Bulletin about how the 2018 Asia-Pacific Conference will continue to expand upon INTA’s growth in the region and what registrants can expect from the two-day program.

What does “Looking Beyond Trademarks” mean exactly?

KH: In the world we live in—for both in-house and private practitioners—there are a lot of questions beyond simply, “What is your trademark?” Today, the questions include: “What is your product?”; “What is your brand?”; and “How is it affected from the outside by issues such as brand restrictions, corporate identity, corporate social responsibility, and corporate culture?” These are big issues. It’s an opportunity for us to explore these issues in more depth and to be best prepared for the challenges ahead.

What topics in particular do you think will be of most interest?

RT: I’m really interested in “Session 4—Bringing Your Business Online: The View from China.” I think that will be of interest to everyone. More and more businesses are looking to break into China or establish a foothold there, so this is a great way to get some firsthand insight into how to do it and how to protect your trademarks and brands at the same time.

KH: This will be one of the first conferences where we will have had some time to see the real impact of the changes imposed by the European Union’s General Data Protection Regulation and to have people in a position to speak from their experiences as to whether it’s had an effect on strategies. It will be a very hot topic that will be addressed in a number of the sessions.

To register for INTA’s 2018 Asia-Pacific Conference: Looking Beyond Trademarks—Protecting and Leveraging Your Brands for Growth, visit the conference homepage.

INTA Board Member Louis Chan (Procter & Gamble, Singapore) represented the Association at WIPD events in Bandar Seri Begawan in Brunei Darussalam.

INTA also participated in events in Laos and Myanmar in April. On April 26, INTA member Carla Federis (BDO Bank, Philippines) delivered a presentation on the importance of building a brand and service mark in the financial industry. As Myanmar has yet to pass its first trademark law, the interest in developing trademarks in the country was well received, and INTA will work with partner organizations in the country in the future to continue building awareness of trademarks and to encourage the passage of a trademark law.

Interview

Ken Hamilton is a Principal/Trade Mark Attorney at Spru son & Ferguson (Australia). He has more than 25 years of experience in IP and is co-chair of the 2018 Asia-Pacific Conference Project Team.

Rebecca Thomas is General Counsel and Company Secretary at Forever New Clothing Pty Ltd. Her key areas of practice include intellectual property, general commercial, trade practices, and corporate governance.

Brand protection is absolutely crucial in this day and age. There are a number of companies today whose IP and brands are worth more than their tangible assets.

—Rebecca Thomas

This will be one of the first conferences where we will have had some time to see the real impact of the changes imposed by the European Union’s General Data Protection Regulation...

—Ken Hamilton
In the News

AUSTRALIA: Well-Known Qantas Mark Makes the Difference

A recent opposition decision from IP Australia, the Australian trademark office, has followed a line of authority in which the notoriety of an element of the later mark is an important factor in removing the likelihood of confusion with an earlier mark. *Ingeus Australia Pty Ltd & Ingeus Pty Ltd v. Qantas Airways Ltd*, [2018] ATMO 23 (Feb. 19, 2018).

Qantas, the well-known Australian airline, applied for registration of the mark QANTAS ASSURE. Following acceptance, that application was opposed by Ingeus based on a number of marks, including an earlier registration for the trademark ASSURE PROGRAMS. The respective specifications covered, among other things, identical/similar services in Class 35. In response, Qantas argued that the notoriety of its QANTAS mark would act as a “dominant cognitive cue” in the mark QANTAS ASSURE and, as such, would remove any possibility of confusion as to the source of the respective services. The Hearing Officer rejected the claim that inclusion of the QANTAS mark would “remove any possibility” of deception or confusion, but he was satisfied that it would “significantly mitigate” the likelihood thereof. In light of the “significant differences” between the respective marks, the applied-for mark QANTAS ASSURE was found not to be deceptively similar to the earlier-registered trademark ASSURE PROGRAMS.

Ingeus also relied on its reputation in ASSURE and ASSURE PROGRAMS as of Qantas’ November 23, 2015 filing date, arguing that use of QANTAS ASSURE would result in confusion. However, Ingeus’ evidence on this point was considered insufficient to meet the reputation threshold, so this ground fell “at the first hurdle.” As ever, this case was decided on its particular set of circumstances and facts. The word element ASSURE has a low level (if any) of distinctiveness, and that fact clearly played a role in the outcome: the Hearing Officer held that it was “unlikely that the ASSURE element alone would be seen as indicating the trade source” of Ingeus’ earlier mark.

The opposition was rejected. Ingeus has filed an appeal with the Federal Court.

LAOS: Opposition Procedures Now Available, Term of Protection Amended

Laos’s new Law on Intellectual Property, No.38/NA of November 15, 2017, was published electronically in the Laos Official Gazette on May 25, 2018, and became effective 15 days following its publication. This supersedes the previous Law on Intellectual Property, No.01/NA, dated December 20, 2011.

The new legislation brings reform to a variety of areas of intellectual property law in the country, but it is with respect to trademarks where the greatest number of amendments has been made.

A new digital platform is to be created which will publish submissions of new trademark applications. Within 60 days of the publication of a new application, third parties can now oppose the registration of the mark concerned.

This is a fairly substantial innovation when compared to what means have been previously available to third-party mark holders—namely, only cancellation. To achieve this, a cancellation request needed to be filed with the Department of Intellectual Property (DIP), which could only be done after the mark had been registered and the certificate issued, and within five years of the publication of said registration in the Official Gazette. Factoring in delays in the publication of registrations in the Official Gazette, this often meant that successful cancellation actions could only prevail after the mark had been put to use in Laos for a significant period of time.

It is anticipated that regulations will be issued in due course to supply further guidance to trademark holders on the scope and application of the new law.

A further important amendment that the new law introduces is the term of protection of registered Laos trademarks. Trademark registrations will now be valid for a period of 10 years from the filing date. Previously, marks had been valid for 10 years from the date of registration.

Lastly, the updated legislation also expands the range of matters which may be registered as trademarks in Laos. With the new law coming into effect, 3D images and animated images are now registrable.

It is anticipated that regulations will be issued in due course to supply further guidance to trademark holders on the scope and application of the new law. Given the extent of the changes introduced, it will take time to develop infrastructure and train local officers in order to streamline registration and opposition procedures. Nevertheless, the introduction of the new legislation signifies a major step forward for Laos’s trademark regime.

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SOUTH KOREA: Revised Unfair Competition Prevention Act Specifies Protection of Trade Dress and Business Ideas

The Korean Intellectual Property Office (KIPO) announced the revisions to the Unfair Competition Prevention and Trade Secret Protection Act (UCPA) on April 17, 2018. The revisions, which includes the protection of trade dress and the prohibition of stealing another’s business ideas, will take effect on July 18, 2018.

Trade dress is not registrable as a trademark, and it was not clear whether it could be protected under the UCPA. Articles 2(1)(b) and (c) of the UCPA define acts of causing confusion with another person’s commercial facilities or activities, and acts of doing damage to the distinctiveness or reputation attached to another person’s mark, as acts of unfair competition. As trade dress has been included as an example of a mark indicating another person’s goods or business in these articles, it has become clear that trade dress is protected under the UCPA.

Another notable revision is the introduction of an article that prohibits stealing another party’s business or technological ideas. The new article prohibits “an act of unfairly using information containing technological or business ideas with economic values that was obtained in business proposals, biddings, contests, business consultations, etc., for one’s own or another’s business interests, or providing such information to another party for use against the purpose of the information’s provision, on the condition that the person who received the idea was not aware of it when it was provided, or the idea was not widely known in the same industry when it was provided” (note: this is not the official English translation by the Korean Ministry of Government Legislation). The party harmed by such unfair act can file a civil lawsuit for cessation of the act based on Article 4 of the same law, and for damage compensation based on Article 5.

This new article was introduced especially to protect small business owners or individuals who often provide their new business or technological ideas to large companies or investors to get investments or contracts but do not have means or leverage to prevent misuses of their ideas by other parties.

KIPO has the authority to investigate a company suspected of violating the UCPA and issue a corrective order to cease the act of unfair competition or to remove or destroy a mark used in the act within a specific period. However, to date, it has not aggressively exercised its authority. With the announcement of the recent amendment to the UCPA, KIPO has demonstrated its determination to take a more proactive role in preventing and resolving acts of unfair competition, especially in relation to indiscriminate imitations of trade dress and the stealing of business or technological ideas. Once the revised law goes into effect, KIPO is expected to use this authority more often and actively than before.

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Registered Patent Attorneys in Australia and New Zealand are now regulated under a unified “Trans-Tasman” system. On February 23, 2018, a new Code of Conduct for Trans-Tasman Patent and Trade Marks Attorneys came into effect. The new Code arose out of necessity to ensure it regulates the new Trans-Tasman Patent Attorney profession and incorporated attorney firms. The key changes relevant to trademark practitioners are discussed below.

Duty of Confidentiality. The confidentiality requirements have been strengthened by expressly confirming that a registered attorney must not use or disclose confidential information including from a former client without consent.

Duty of Loyalty. The new duty of loyalty confirms attorneys owe a duty of loyalty to their clients, arising from a fiduciary relationship. The registered attorney must prefer the client’s interests over his or her own and cannot prefer one client’s interests over another client. More importantly, the changes confirm that an attorney may act adverse to a former client, provided the attorney does not hold confidential information relevant to the matter or, if it holds relevant confidential information, has established an effective information barrier.

Duty of Independence. If a registered attorney is part of an ownership group, a client of that registered attorney is considered a client of all members of the group for the purposes of the duty of loyalty and conflicts of interest, unless the professional services are provided by registered attorneys who are operating independently within the group. Professional services are contrasted with “back-office” activities in the guidelines and which may be provided to multiple members of the ownership group provided client information remains confidential.

Further, a registered attorney who is a member of an ownership group must not act in contentious proceedings against a client of another member of the group without informed consent in writing from the client of the registered attorney.

Obligation to Avoid Conflicts of Interest. This obligation has been simplified, now requiring the registered attorney to take all reasonable steps to avoid any conflicts between the attorney and client, or one client and another. Furthermore, the registered attorney must take all reasonable steps to resolve actual conflicts identified as soon as practicable.

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Mr. Drew is Co-Chair and Ms. Neilson is a member of the INTA Bulletins Law & Practice—Asia-Pacific Subcommittee.
INTA Delegation Discusses Key Issues, Collaboration with China IP Leaders

From July 17 to 18, INTA organized a leadership delegation in Beijing, China, to discuss priority issues with trademark and intellectual property (IP)-related ministries, including the China National Intellectual Property Administration (CNIPA), China Trademark Association (CTA), Beijing IP Court, the Ministry of Public Security, Economic Crimes Investigation Department, and the General Administration of Customs. INTA also conducted membership recruitment events and participated in a VIP lecture with leading professors and thought leaders.

Discussing Trademark Law Amendments, Anticounterfeiting

INTA’s leadership delegation, headed by INTA CEO Etienne Sanz de Acedo, met with CNIPA Deputy Commissioner Liu Junchen on Tuesday, July 17. This marked the first meeting with INTA leadership and Chinese authorities since the major restructuring of China’s IP ministries in March, which saw trademark, geographical indications, and other regulatory issues moved to CNIPA and combined under a new regulatory body, the State Administration of Market Regulation (SAMR).

Deputy Commissioner Liu welcomed INTA’s delegation and thanked the Association for hosting officials from the China Trademark Office to INTA’s Annual Meeting in Seattle, Washington, USA, earlier this year and for signing a letter of intent last year. He noted that the office continued to receive more and more applications, and they estimate that the office will receive over 8 million trademark applications this year. At the same time, he noted that the office is setting goals to reduce trademark examination pendency to 4–5 months by 2020. Under the current trademark law, applications are required to be examined within nine months. Deputy Commissioner Liu also noted that the China Trademark Law amendment process has commenced and welcomed INTA’s views.

Mr. Sanz de Acedo noted the increasing numbers and that, at 8 million applications, China clearly received more than half of global trademark applications. INTA members are chiefly concerned about the increasing numbers of bad-faith trademark applications. Mr. Sanz de Acedo noted that INTA’s policy advocacy committees submitted the Association’s views during the public comment period. (Please see here for a copy of the submission.)

Following this meeting, INTA’s delegation met with CTA Secretary General and President, Ma Fu. INTA and CTA reviewed their history of cooperation, which includes instances of shared education programming. Most recently, this included a CTA-organized panel session at the INTA Annual Meeting in Seattle, and also included an INTA-organized session at this year’s CTA Festival in Tangshan, China, in August. Discussions also touched on potential areas of advocacy engagement and research. INTA and CTA successfully organized a workshop on bad-faith trademark registrations earlier this year in March. INTA and CTA look forward to continuing their cooperation for the mutual benefit of the international and Chinese trademark community.

INTA’s leadership delegation met with Deputy Chief Judge Song Yushui of the Beijing IP Court. Judge Song reviewed the progress of the court since INTA last visited in 2015. The court currently hears more than 20,000 cases per year, 80 percent of which are trademark related. The Court has implemented a number of fast-track programs to speed adjudication of these important matters. INTA welcomed further research initiatives with the Court to improve process and substantive matters. INTA also raised the possibility of amicus brief submissions in the future.

The China Trademark Office will receive more than 8 million trademark applications this year, but still plans to reduce trademark examination pendency to 4–5 months by 2020.

On July 18, INTA focused on meetings with enforcement authorities. The first meeting was conducted by Deputy Director Zhang Jingli of China’s Economic Crime Investigation Department (ECID), Ministry of Public Security (MPS). Mr. Zhang expressed appreciation for working with INTA at the Annual Meeting, having joined several anticounterfeiting-related sessions and committee meetings. He noted that INTA as a communications platform is incredibly important to highlight the innovation and efforts of Chinese enforcement authorities. INTA’s delegation noted the
the Sale of Counterfeits on the Internet and transports, and small and medium-sized special free-trade zones, supply chain logistics owners and businesses, customs, infrastructures, sectors across international trade, such as brand series of specialized trade summits linking key largest trade facilitation event, GTDW featured a place July 2–4 in Shanghai, China. As the world’s e-trade and trade facilitation summit, which took Development Week (GTDW), China’s first major INTA was invited to participate in the Global Trade Forum on Criminal IP Protection Global Trade Development Week and 2018 China activities and meetings in China for INTA.

The month of July included a strong focus on e-commerce and border issues, best practices for addressing the sale of counterfeits on the Internet, best practices for lessening risks to goods in transit, and developments in border measures. On July 4, the summit ended with the Anti-Illicit Trade & Brand Protection Workshop, which focused on collective

Growing the Stakeholder Network in China
INTA conducted a membership recruitment dinner in the evening. Meeting with INTA membership champions from the China Global Advisory Council and volunteers, INTA invited non-member companies from around China to participate and learn about the service offerings and international network.

The Association supported a program with Justra Intellectual Property Research Center on the Future Outlook of Trademarks. Professors Liu Chun-tian (Renmin University, China) and Professor Liu Kung-Chung (Singapore Management University, Singapore) shared views on the outlook for trademarks from an academic perspective. Mr. Liu noted that, with the surge in trademark applications in China, necessary policy changes should be implemented to bring the use and registration of trademarks in line with productive economic activity. Felix Fan (Alibaba, China) shared industry views on protecting trademarks online, and Huang Hui (WanHuiDa Peksung Law Firm, China) shared the views of practitioners, highlighting interesting policy differences between China and the Euro-pean Union—particularly in light of forthcoming China trademark law amendments.

INTA also had its first meeting with the IP Publishing House (IPPH)—the education and communications arm of CNIPA. IPPH expressed interest in working with INTA to build capabilities on trademarks, now that CNIPA is responsible for this sector. IPPH also invited INTA to participate in this year’s Patent Information Conference in August.

During the delegation week, INTA reached out to foreign government representatives in China and convened local representatives in charge of IP from Australia, the European Union, Germany, the United States, and the United Kingdom to share views on the policy outlook in China.

On July 20 in Shanghai, INTA was invited to speak at a forum hosted by CTA and Chinese brand registry DotTrademark, in Shanghai. INTA Chief Representative Officer, Asia-Pacific and China, Seth Hays, delivered opening remarks, and former INTA Board Member Peter Dernbach (Winkler Partners, Taipei) delivered a substantive presentation on INTA’s work in the Internet space with ICANN and online anticounterfeiting efforts. Mr. Dernbach emphasized INTA’s various activities in the area, including the work of both the Anticounterfeiting Committee and Internet Committee, and pointed to projects such as trainings of customs officials, best practices papers, and ICANN policy review. Mr. Dernbach also empha-sized recent changes to ICANN’s WHOIS database.

Other organizations involved in the program includ-ed the Hong Kong International Arbitration Centre, Asian Domain Name Dispute Resolution Centre, Asian International Arbitration Center, Shanghai Pudong IP Association, China International Economic and Trade Arbitration Commission, and the Legal Executive Board. Company speakers included industry and service provider representatives, such as Tencent.

INTA Conducted Membership Recruitment Dinner
INTA’s final meeting of the day was with Customs IP Department Vice General Director Huang Jianhua. As the world’s largest exporter of branded goods, China Customs has a tremendous responsibility and burden to monitor the trade in counterfeit goods. The number of seizures—17,000 in 2017—reflects this importance. INTA noted the need for more cross-border enforcement coordination, and welcomed customs to join next year’s Annual Meeting. INTA noted the valuable tools created by the Anticounterfeiting Committee, such as the online webinar product identification trainings offered through the Customs Connection program.

INTA Steps Up China Activity in July
The month of July included a strong focus on activities and meetings in China for INTA.

Global Trade Development Week and 2018 China Forum on Criminal IP Protection
INTA was invited to participate in the Global Trade Development Week (GTDW), China’s first major e-trade and trade facilitation summit, which took place July 2–4 in Shanghai, China. As the world’s largest trade facilitation event, GTDW featured a series of specialized trade summits linking key sectors across international trade, such as brand owners and businesses, customs, infrastructures, special free-trade zones, supply chain logistics and transports, and small and medium-sized enterprises. The three-day summit included speakers from various organizations discussing the role of governments and cooperation with the private sector, and the “One Belt, One Road” initiatives, including challenges, collaboration, and strategic partnership.

Valentina Salmoiraghi, INTA’s Anticounterfeiting Advisor, Asia-Pacific, spoke at the summit about INTA’s advocacy efforts and Strategic Plan in relation to anticounterfeiting, including efforts and initiatives on e-commerce and border issues, best practices for addressing the sale of counterfeits on the Internet, best practices for lessening risks to goods in transit, and developments in border measures. On July 4, the summit ended with the Anti-Illicit Trade & Brand Protection Workshop, which focused on collective

INTA delegation meets with SIPO delegation.

Valentina Salmoiraghi, INTA’s Anticounterfeiting Advisor, Asia-Pacific, speaks at the Global Trade Development Week Summit in Shanghai, China.
China

Panelists at the Global Trade Development Week Anti-Illicit Trade & Brand Protection Workshop in Shanghai, China. From left to right: Yu Bo, SIPS, China; Michael Morantz, Senior Policy Analyst, Task Force on Countering Illicit Trade, Directorate for Public Governance, OECD; Xiaobing Tang, Counsellor, Market Access Division, World Trade Organization; and Daoming Zhang, Assistant Director, Illicit Markets & Organized and Emerging Crime, INTERPOL.

Association Updates

Expanding Connectivity and Communication Efforts Across China
INTA’s goals in China are twofold: (1) provide international brand owners with the tools to understand China’s dynamic trademark policy landscape, and (2) bring best practices for burgeoning and established Chinese brands to succeed on the global stage. Recently, the Association has been pleased to further build these lines of communications and connectivity inside and outside China.

Engaging Chinese Officials at the Annual Meeting
The 2018 Annual Meeting continued to expand the opportunities for INTA members to hear from and interact with officials from across China’s trademark policymaking landscape. For the third year in a row, INTA invited China’s Supreme People’s Court to participate in its judicial panel session, which took place on May 20. This year’s discussion focused on brand restrictions. For more information on this year’s session, please see the report on page 6 of the May 21 issue of the INTA Daily News.

INTA also had substantial participation from China’s Ministry of Public Security (MPS) Economic Crimes Investigation Department (ECID) in charge of pursuing criminal counterfeiters. ECID Deputy Director General Zhang Jingli spoke at a session on e-commerce. Additionally, the MPS delegation attended this year’s anticounterfeiting day events on May 19, engaging in frank discussions with INTA members. The Anticounterfeiting Committee also welcomed Mr. Zhang to address pressing issues raised by the committee’s members.

The China Trademark Office (CTMO) and associated Trademark Examination Cooperation Center also sent a delegation. Officials engaged in the IP Office Workshop—a closed-door meeting of IP office officials in attendance at the Annual Meeting. CTMO also participated in the Trademark Office Practices—China Subcommittee meeting.

Monitoring Changes
As evidenced by INTA’s leadership delegation to authorities in Beijing in early July, INTA is leading the way to better understand and communicate changes resulting from the reshuffling of IP-related duties within China’s ministries earlier this year. INTA is working to keep members informed about these issues and set the stage for important improvements to ensure that China is a leading trademark jurisdiction in the world. For insight into how recent changes are affecting brand owners, see “The Outlook for IP and Brand Owners in the Context of China’s Institutional Reform” in the May 1 INTA Bulletin.

Additionally, INTA’s advocacy committees have been working hard to draft and submit views that will influence the next round of amendments to the China Trademark Law in order to ensure that China’s trademark landscape is a fruitful and beneficial one for the global trademark community.

INTA member and representative of INTA’s Anticounterfeiting—China Subcommittee, Yu Bo (SIPS, China), participated in a panel discussion concerning collective actions to fight illicit trade and promote market integrity across regions. Mr. Yu stressed the importance of information sharing among anticounterfeiting players and intra and intergovernmental cooperation.

Following the GTDW, from July 11 to 13, INTA was invited to join the 2018 China Forum on Criminal IP Protection in Suzhou, China, organized by the Quality Brands Protection Committee of the China Association of Enterprises with Foreign Investment (QBPC) and supported by IP Key China, a program directed by the European Commission and implemented by the European Union Intellectual Property Office (EUIPO) to facilitate market access, increase transparency, and improve the implementation of intellectual property (IP) protection and IP enforcement systems. The Forum focused on new trends in criminal IP protection in China, data protection and IP protection, social cooperation and governance on IP protection, and China-European Union Collaboration on IP protection and enforcement. Valentina Salmoiraghi, INTA’s Anticounterfeiting Advisor, Asia-Pacific, participated in a panel discussion and shared INTA’s advocacy efforts and achievements in relation to cooperation between the private and public sectors and initiatives in relation to combating counterfeits in China and globally.

INTA worked with the China Trademark Association (CTA) to co-host this year’s China Reception following an INTA-CTA education panel session. CTA Vice Secretary General Zang Baoqing delivered remarks alongside INTA President, Tish Berard (Velcro Companies, USA).

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Expanding the Message to Western China
INTA was honored to participate in an MPS-INTERPOL capacity training in historic Ningxia province on May 19. This marks the first time that INTA and its members have provided training outside the major coastal metropolitan centers. As China expands the trade in goods through the One Belt, One Road initiative via western China into Central Asia, the important role of China’s enforcement agencies will grow to protect these vital trade linkages. During the meeting, INTA also learned about some cutting-edge initiatives by the MPS to use big data to combat counterfeits in the online-to-offline setting.

Actions for fight illicit trade, cross-industry best practices, transformative technologies, and public and private sector partnerships for anti-illicit trade and market integrity.

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Additionally, INTA’s advocacy committees have been working hard to draft and submit views that will influence the next round of amendments to the China Trademark Law in order to ensure that China’s trademark landscape is a fruitful and beneficial one for the global trademark community.
Impact of Amended Anti-Unfair Competition Law on Trademark Practice

China has amended the Anti-Unfair Competition Law of the People’s Republic of China for the first time in 24 years, since the original implementation of the law on December 1, 1993. This amendment was approved by the Standing Committee of the National People’s Congress on November 4, 2017, and entered into force on January 1, 2018.

The amendments will have a significant impact on trademark practice. First, the removal of Clauses 5(1) and 21(1) avoid duplication with China’s Trademark Law. Violations set forth in Clauses 5(1) and 21(1) of the previous Anti-Unfair Competition Law are at the same time regulated by the Trademark Law, so the clauses were removed to avoid overlapping applications of the law.

Clause 5 of the previous Anti-Unfair Competition law provided that “any business owner shall not adopt any of the following unfair means to carry on transactions during business activity and cause damage to competitors: (1) counterfeiting another’s registered trademark…etc.”

Clause 21 provided that “when a business owner counterfeits another’s registered trademark, uses another’s company name or personal name as their own, without authorization, counterfeits or fraudulently uses symbols of quality such as symbols of authentication and symbols of famous and high-quality goods, falsifies the origin of the goods and makes false representations which are misleading as to the quality of the goods, it or he shall be punished in accordance with the provisions of the Trademark Law of the People’s Republic of China and the Product Quality Law of the People’s Republic of China.”

The previous overlap between these clauses and the Trademark Law caused inconvenience for intellectual property (IP) owners who sought protection on the grounds of the Anti-Unfair Competition Law. Their removal has therefore streamlined the legal process.

Secondly, the new law provides for broader coverage and protection of IP, for instance, with respect to trademarks and trade names, by expanding the scope of the definition of IP. Trade dress and trade names are addressed for the first time in Clause 6, which states that businesses shall not commit certain acts of confusion to mislead consumers. A number of new terms, such as “trade name,” “social organization name,” “pseudonym,” “stage name,” “translated name,” “domain name,” “website,” and “webpage,” have been defined. The addition of these terms represents a major step forward for China, as it illustrates that new terms which emerged in recent landmark cases can drive the development of changes to Chinese trademark law.

Thirdly, Chapter 4, Clause 18(2), addresses the legal measure to rectify improper company names in the new law. It clearly stipulates that “in the event that the business owner’s registered company name violated the term stipulated in Clause 6 of the said Law, they shall apply for the company name change process within a timely manner, and before such application, the company registry office shall use the unified social credibility code [which identifies legal entities and other organizations], as the company name.” Company names and trade names are distinct from trademarks, but when used on the packages and labels of a product or in relation to a service, they denote the origin of the goods or service; thus, when any third party uses without authorization a company name or trade name that is confusingly similar with another’s prior trademark, it will be regarded as improper usage. This is the first time that this issue has been addressed in Chinese legislation.

The change to the statutory damage range for violating Clauses 6 and 9 of the new law follows the relevant terms in the Trademark Law, and sets the highest statutory compensation at RMB 3 million. Clause 9 sets forth criteria for determining damages for trade secrets infringement. This represents a significant increase over the previous maximum fines.

The Anti-Unfair Competition Law will be useful in cases that cannot be solved via the Trademark Law.

Beijing IP Court Rules in Trademark Dispute Between M MONALISA and MONA LISA and Chinese Characters

An appeal by plaintiffs Guangzhou Mona Lisa Building Materials Co. Ltd. and Guangzhou Mona Lisa Sanitary Appliance Co., Ltd. against a judgment made by the Trademark Review and Adjudication Board (TRAB) regarding the plaintiffs’ request to invalidate the mark M MONALISA with respect to “Flush Toilets; Toilets” in Class 11 was rejected by the Beijing IP Court on January 26, 2018.

In 2012, the plaintiffs attempted to cancel the registered mark M MONALISA owned by Mona Lisa Group Co., Ltd., another company based in Guangzhou, based on the plaintiffs’ prior registration for MONA LISA and Chinese characters with respect to “Bath fittings, Sauna bath installations, Shower cubicles, etc.” in Class 11.

The Supreme People’s Court previously ruled that an appeal against a decision of the Beijing Higher People’s Court that has already taken effect should be rejected.

On November 25, 2013, the TRAB ruled in favor of the plaintiffs with respect to “Flush Toilets; Toilets.” SHANGPINGZI [2013] No. 116692. However, the mark was upheld by the Beijing First Intermediate People’s Court and the Beijing Higher People’s Court in two subsequent trials. According to judgment (2014) YIZHONGZHIXINGCHUZI No. 1741, the first of the two subsequent trials, the registered mark was considered a legitimate extension of protection deriving from the reputation of the registrant’s prior registration of the same mark for “ceramic tiles” in Class 19. According to judgment (2016) JINGXINGZHONG No. 1946, the second of the two subsequent trials, both the marks and the goods concerned were considered dissimilar and the registrant’s trademark reputation for the same mark on “ceramic tiles” could extend to the newly registered mark, which the plaintiffs wanted to cancel.

The plaintiffs were dissatisfied with the result and filed a retrial application with the Supreme People’s Court but it was rejected on June 23, 2017. According to the Beijing Higher People’s Court’s judgment, the TRAB made its second adjudication in favor of the registrant on July 6, 2016, which led to the plaintiffs’ appeal to the
**In the News continued from page 15**

Beijing IP Court. However, the appeal was rejected by the Beijing IP Court on January 26, 2018, as ruled in judgment (2016) JING73XINGCHU No. 5134. The plaintiffs have appealed the first instance administrative lawsuit to the Beijing Higher People’s Court, and a decision should be forthcoming. However, according to Judicial Interpretation [2017] No. 2, the Supreme People’s Court previously ruled that an appeal against a decision of the Beijing Higher People’s Court that had already taken effect should be rejected. Thus, it is likely that the appeal will be unsuccessful.

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**Extension of Opening Hours for Online Trademark Filing**

As of February 1, 2018, the China Trademark Office (CTMO) has extended the opening hours for filing online trademark applications to 8:00 pm, Beijing time, from its previous closing time of 4:30 pm, to better satisfy the needs of the rapid increase in trademark applications. Additionally, except on the National Day and Chinese New Year holidays and one day of system maintenance, the online application system will also be available on holidays.

The extension of opening hours for online trademark filing on working days and the opening of the online system on holidays has made it much more convenient for trademark applicants. The People’s Republic of China Trademark Law adopts a “first-to-file” principle in granting trademark registration. Therefore, the CTMO will give protection for a trademark with a prior filing date and refuse other conflicting marks filed at a later date. In order to obtain an earlier filing date, the trademark applicants who fail to file trademark applications during the CTMO’s working hours, can file online applications after work or even on holidays. However, not all trademark applications can be filed through the online system, since the online filing system can only accept the standard goods/services listed in the Nice Classification and the acceptable goods/services published by the CTMO. This means that an application containing goods/services which are not listed in the Nice Classification and the acceptable goods/services published by the CTMO cannot be filed through the online filing system. Instead, such applications would need to be filed as paper applications at the CTMO.

The extension of the opening time of the CTMO online application system has undoubtedly provided trademark applicants with a great deal of convenience, saving both time and travel. Although there are still some shortcomings, we believe that with the further promotion of the facilitation reform measures of the State Administration for Industry and Commerce, the channels for trademark applicants to submit applications will be more open and efficient.

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**Supreme Court Sets Tone for Three-Year Non-Use Trademark Disputes About Suntory**

In Suntory Holdings Limited (Suntory Ltd.) v. the Trademark Review and Adjudication Board (TRAB), China Supreme People’s Court (SPC) ruled against Suntory Ltd., rejecting its retrial application. Docket: 2017Zui-Gao-Fa-Xing-Shen No. 5093. The Japanese maker of beverages tried but failed to cancel trademark No. 313758 SAN DE LI SDL (sharing the same Chinese characters with Suntory) on three-year non-use grounds. Although the result has remained unchanged, the SPC corrected the two lower courts which erred in fact and law, and also clarified when retrial is applicable in the context. Those opinions should act as significant guidance for future cases.

**What should prevail when a trademark’s designated goods go wrong?**

The trademark SAN DE LI SDL was initially filed to cover “cola; liquid drinks; solid drinks; health drinks,” but the first semi-colon was omitted during extension in 2008. In late 2017, the error was rectified by the China Trademark Office. The SPC thus gave credit to the previously incorrect, but later corrected, coverage of goods.

**Does drinking water count as a liquid drink?**

According to the evidence submitted, the trademark SAN DE LI SDL had only been used on drinking water in the relevant three-year period. Thus, the question became whether such use could be regarded as use on the designated goods. Citing China’s National Standards, the SPC said yes, reversing the lower courts’ determination.

**Can trademark use on goods similar to those designated maintain the validity of a trademark which would otherwise be canceled for three-year non-use?**

In China, exclusive trademark rights are limited to a registration with its designated goods; an additional application is required for extra coverage. A trademark that has not been in use for three consecutive years can be canceled. However, the lower courts recognized use on similar goods sufficient to maintain a trademark. The SPC disagreed and deemed this to be abuse of a trademark registrant’s rights that would encourage squatters.

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**Is retrial applicable when unsatisfied with court’s affirmation of a court-ordered trademark review decision?**

By Suntory Ltd.’s application for retrial, the first and second instance courts had already ordered the TRAB to review and maintain the trademark SAN DE LI SDL and continued to affirm its decision when Suntory Ltd. sued again. Regarding the application, the SPC examined the TRAB’s review decision and the new judgment with the goal of preventing redundant lawsuits. It ruled pursuant to its judicial interpretation that a retrial against the duly remade and affirmed decision shall not happen, because a retrial would undermine the effective judgment and unnecessarily prolong court proceedings.

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Looking at Brands from All Angles

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Brussels Stays Focused on Brexit

While summer is generally quiet in Brussels, this year, the European Union (EU) capital is facing a heat wave in temperatures, as well as with respect to Brexit. With six months to go until the March 29, 2019, deadline, an agreement between the EU and the United Kingdom (UK) appears more uncertain than ever, with the possibility of a "cliff-edge" scenario—i.e., the UK becoming instantly a third country with no agreement on transition or the future—more and more likely.

In Brussels, the last meeting of the 28 EU heads of states and governments on June 28 and 29 saw no progress on the issue. The EU27 leaders are expecting UK Prime Minister Theresa May to produce a concrete set of proposals on what she expects from the Brexit agreement on several issues (notably, the "future relationship" and the Republic of Ireland-Northern Ireland border).

Second, Ms. May had to face unexpected resignations: the pro-Brexit Minister David Davis—as he believes the current status leaves the UK "in a weak position" with regard to negotiations—on July 8 and Brexit Foreign Secretary Boris Johnson on July 9. They were replaced, respectively, by Dominic Raab, former Minister for Housing and Planning, and Jeremy Hunt, former Secretary for State for Health and Social Care.

The UK government nonetheless saw the adoption of the EU Withdrawal Act by the UK Parliament on June 26, with no "final say" vote given to the UK Parliament on the final Brexit agreement. Moreover, on July 12, Ms. May released the "Brexit White Paper," which details its set of proposals regarding the UK’s future relationship with the European Union and which hints towards a “soft Brexit.”

Finally, with respect to intellectual property (IP), the United Kingdom Intellectual Property Office (UKIPO) has published an update of its “IP and BREXIT: The facts” page, including, for the first time, statements about its intentions regarding continued protection of rights (specifically in case of a ‘no-deal’ scenario). On enforcement, the UKIPO stresses that it will “establish an approach to enforcement cooperation that best suits the needs of the UK and EU and facilitates frictionless trade in goods to avoid a hard border between Northern Ireland and Ireland. This may involve sharing information and research on IP rights enforcement, working closely with the EU Observatory on the infringement of IP Rights.” Regarding geographical indications (Gis), the UK has not yet made a final decision, but is contemplating setting up its own GI mechanism.

The Association is now focused on further developing its position on certain issues, with dedicated papers on exhaustion and international registration sent to the EU and UK authorities in July.

Next Steps for European Union Data Protection and Global Enforcement: INTA Needs Your Feedback!

The May 25 deadline for the implementation of the European Union General Data Protection Regulation (GDPR) has come and gone. Since then, brand owners and intellectual property professionals are struggling with restricted WHOIS data access in light of fallout from the GDPR. To support them, the WHOIS/RDS Subcommittee of INTA’s Internet Committee has prepared a helpful Toolkit for IP Professionals which “suggests ways to meet [IP] enforcement challenges in a landscape where most WHOIS registrant data is redacted” and provides “tips
Christian Archambeau Recommended as Next EUIPO Executive Director
On July 13, the Committee of Permanent Representatives in the European Union (COREPER) voted to recommend that the Council of the European Union appoint Christian Archambeau as Executive Director of the European Union Intellectual Property Office (EUIPO). The appointment is expected to be formalized in an upcoming Council meeting. Mr. Archambeau, current Acting Executive Director of the EUIPO, will succeed António Campinos, who began his five-year term as President of the European Patent Office (EPO) on July 1, 2018.

INTA congratulates Mr. Archambeau on this achievement and looks forward to continuing its close and cooperative relationship with the EUIPO under his leadership.

António Campinos Reflects on Eight Successful Years of EUIPO Leadership

António Campinos, who served as Executive Director of the European Union Intellectual Property Office (EUIPO) from 2010 to 2018, has assumed his post as President of the European Patent Office (EPO), effective July 1.

Mr. Campinos was elected in October 2017 for a five-year term by the Administrative Council of the European Patent Organisation to succeed Benoît Battistelli. INTA CEO Etienne Sanz de Acedo has said that “Mr. Campinos is sure to bring tremendous value to the EPO,” and INTA looks forward to continued collaboration with him in this new capacity.

During his eight-year tenure as EUIPO Executive Director, Mr. Campinos achieved significant improvements of relevance to users, focusing on the quality of the trademark and design-related services and involving users in the EUIPO’s initiatives and management. He was also instrumental in enhancing overall IP awareness, launching the first study in 2013 that quantified the value of IP to the global economy. Published by EUIPO’s European Observatory on Infringements of IP Rights and the EPO, the study was the first in a series of reports aimed at better understanding how IP factors into economies, the impact of counterfeiting on the economy, and user perceptions of IP rights.

Just a few days before starting his post at the EPO, Mr. Campinos shared with the INTA Bulletin some of his reflections on the eight years he spent at the EUIPO, as well as his hopes for the future of both EU IP offices. Read the full interview in the INTA Bulletin.

Association Updates
EU Blockathon: First Event Dedicated to How Blockchain Technology Can Help Fight Counterfeiting
In the heart of Brussels, INTA Europe Office Chief Representative Officer Hélène Nicora and Policy Officer Hadrien Valembois attended the EU Commission and EU Observatory’s first-ever EU Blockathon: a competition among 11 teams, from June 22 to 25, to propose a blockchain-based system and solutions to fight counterfeiting. The teams competing were working directly with manufacturers, logistics companies, customs, retailers, and consumers. The total prize awarded is EUR 100,000.

This Blockathon is part of the continuing effort by the European Union Intellectual Property Office (EUIPO) to tackle counterfeiting by attracting, promoting, and supporting new ways to fight counterfeiting based on blockchain technology.

The event was also supported by the EU Commission with Vice-President in charge of the Digital Single Market, Andrus Ansip, and EU Commission’s DG GROW Director-General, Lowri Evans attending.

The event was also marked by the signing of a memorandum of understanding (MoU) on online advertising and intellectual property rights. This voluntary agreement, under the aegis of the European Commission, was signed by approximately 20–30 representatives of the advertising industry, including advertisers, rights holders, and technology providers. All signatories have committed to minimize the placement of advertising on websites and mobile applications, which are known to disseminate counterfeit goods or to infringe copyright.

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INTA High-Level Visits in Europe

INTA's Europe Representative Office enjoyed a visit from its top leadership in Brussels, Belgium, in April. INTA CEO Etienne Sanz de Acedo traveled to Europe to raise awareness on brand value, brand restrictions, and the impact of counterfeiting in France, Spain, and Brussels.

From April 23 to 25, INTA 2018 President Tish Berard (Velcro Companies, USA), was in Brussels to hold meetings with government officials and private stakeholders to raise awareness about the link between small and medium-sized enterprises (SMEs) and intellectual property (IP) and innovation. Ms. Berard notably promoted the ongoing working of the newly created 2018 Presidential Task Force on SMEs.

Finally, on July 5 and 6, INTA CEO Etienne Sanz de Acedo and INTA’s Europe Office met with high-level representatives from several Directorates of the European Commission to exchange information on IP rights protection outside the European Union (EU), the EU strategy on IP, protection of SMEs and incentives for innovation, and tools to fight counterfeiting, including INTA’s Best Practices to Fight the Online Sales of Counterfeiting.

On July 12, Mr. Sanz de Acedo and Ms. Nicora flew to Rome, Italy, to meet with the Italian Patent and Trademark Office (UIBM), together with Italian members Marie-Laure Bonnaffous (Fendi, Italy), who is a member of the INTA Board of Directors; Laurence Morel-Chevillet (Bulgari, Italy); and Elio de Tullio (De Tullio & Partners, Italy) to finalize a new memorandum of understanding (MoU) with the UIBM. The MoU focuses on anticounterfeiting-related projects in Italy.

For more extensive reporting on these visits, please see the INTA Bulletin’s Europe updates of May, June, and July 2018.

INTA Co-Signs Paper with ECTA and MARQUES on Designs in the European Union

On July 9, INTA’s Europe Office, together with the European Communities Trade Mark Association (ECTA) and the Association of European Trade Mark Owners (MARQUES), submitted a joint position paper on the European Union (EU) design protection system to the European Commission.

The EU design protection system is made up of a Regulation (Regulation 6/2002 of December 12, 2001, on Community designs) that introduced the Registered Community Design and Unregistered Community Design Right into EU law and a Directive (Directive (EC) 98/71 of October 13, 1998, on the legal protection of designs), which harmonized design law across the EU member states.

Some 15 years since the entry into force of this legal framework, the joint paper submitted by ECTA, MARQUES, and INTA addresses those aspects that require some reflection and correction. The three associations hope that their common position assists the European Commission in the context of the recently launched evaluation of the EU legislation on design protection.

Interview

András Jókúti, Hungarian Intellectual Property Office: Elevating the Global Dialogue on IP Rights

“There is no aspect of intellectual property (IP) law that I haven’t been in touch with in the course of my 15 years in the public administration,” says András Jókúti, Acting Director-General for Legal Affairs at the Hungarian Intellectual Property Office (HIPO). From the overhaul of the European Union trademark system to copyright in the Digital Single Market and substantive patent law harmonization, Mr. Jókúti is well versed in all aspects of IP law and policy. This made him particularly suited to help organize and host INTA’s IP Office Workshop, “Working Towards the 21st Century IP Office” at the 2018 Annual Meeting, where he moderated a closed-door session titled “New Marks on the Block: Experience and Challenges with New Types of Trademarks.”

Mr. Jókúti spoke with the INTA Bulletin about some of HIPO’s current priorities. Read the full interview in the INTA Bulletin.

In the News

EUROPEAN UNION: Court of Justice of the European Union Rules That Louboutin’s Red Sole is a Valid Trademark

On June 12, 2018, the Grand Chamber of the Court of Justice of the European Union (CJEU) held, in a case involving Louboutin’s famous red sole, that a color affixed to the sole of a high-heeled shoe is not a shape and thus not excluded from the scope of trademark protection. Case C-163/16, Mr Louboutin and Chris-
The Hague System facilitates the registration of up to 100 designs at a time in more than 80 territories through one single international application at the World Intellectual Property Organization (WIPO). This can expedite design filings in multiple jurisdictions, leading to administrative and procedural savings. The result is a bundle of national rights, rather than a single unitary right covering the various designated territories. Eligible applicants outside the EU can designate the EU, and that designation is treated, as from registration, as a Registered Community Design (RCD), with the same rules and procedures. The UK’s instrument of ratification includes the following declarations (see WIPO Information Notice (6/2018) dated April 11, 2018):

- International applications may not be filed through the UK Intellectual Property Office;
- The maximum period for the deferment of publication is 12 months from the filing date or priority date; and
- The maximum duration of protection in the UK is 25 years.

Read the full report in the INTA Bulletin.

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**UNITED KINGDOM: United Kingdom Joins the Hague Agreement Concerning the International Registration of Industrial Designs**

The United Kingdom (UK) ratified the Hague Agreement Concerning the International Registration of Industrial Designs (Hague System) on March 13, 2018. This is good news for UK designers and practitioners and accords with the December 2016 INTA Board Resolution encouraging countries and intergovernmental organizations to accede to the Hague System. Russia also joined the System, in February 2018, and other countries, such as Canada, Israel, and Mexico, are expected to ratify by the end of the year. The UK’s ratification took effect on June 13, 2018.

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**BENELUX: Important Changes to Trademark System Implemented**

Due to changes in the Benelux Convention on Intellectual Property, the Benelux trademark system underwent two important changes as of June 1, 2018.

**Appeals from Decisions of the Benelux Office for Intellectual Property**

Prior to June 1, 2018, appeals from decisions of the Benelux Office for Intellectual Property (BOIP) in opposition cases were brought before the courts of appeal of The Hague, Brussels, or Luxembourg (with further appeals on questions of law to the respective supreme courts). This resulted in some inconsistent rulings. For example, in cases of refusal on absolute grounds, the Court of Appeal of The Hague tended to confirm absolute grounds refusal decisions, whereas the Court of Appeal of Brussels was inclined to quash refusal decisions and to accept the trademarks.

As of June 1, 2018, all appeals from decisions of the BOIP (refusals, oppositions, etc.) must be brought before the Benelux Court of Justice (BCJ). This Court established a new chamber consisting of judges from national courts of the member states of the Benelux. This is expected to result in more consistent and harmonious case law. So far, the BCJ has only played a role where national courts had doubts as to the interpretation of matters of Benelux law. In the past number of years, this role was not very large, since questions of interpretation of substantive trademark law were referred to the Court of Justice of the European Union (CJEU). Thus, chiefly procedural issues were brought before the BCJ. As before, the BCJ can refer questions of interpretation of Union law to the CJEU.

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**Revocation and Invalidation Actions Can Be Brought Before the BOIP**

The second important change concerns the possibility to request revocation and invalidation of trademark registrations in an administrative procedure before the BOIP, as is the case with European Union (EU) trademarks. The new procedure is similar to the procedure before the European Union Intellectual Property Office (EUIPO). This is done in anticipation of implementation of Articles 43 and 45 of Directive 2015/2346, the new EU Trade Marks Directive.

So far, prior rights holders, those who wish to invoke lapse of rights based on non-use, or those who wish to argue that a trademark lacks distinctiveness, for example, could only do so before the courts. This will still be possible, but the new system offers the alternative of an administrative revocation or invalidation.
procedure, which can be attractive since it will be less costly. Again, appeals from decisions of the BOIP in such administrative proceedings can only be brought before the BCJ.

Comment
The new system should be welcomed. Previously, the variations among the decisions of the courts of appeal in the Benelux countries were generally viewed as causing confusion. We can now expect more consistent case law, the quality of which should be good, since the BCJ’s new chamber consists of judges with experience in IP matters. Also, the new administrative revocation and invalidation procedure will be faster and less expensive than court proceedings. It is up to the claiming party to carefully develop a strategy to decide which of the proceedings would best benefit his or her case.

FINLAND: Government Proposal for a New Finnish Trademarks Act
The Ministry of Economic Affairs and Employment appointed a working group in 2016 for a total revision of the Trademarks Act. The working group submitted its draft government proposal for a new act on March 19, 2018. The new act would implement the revised Trademark Directive and enforce the Singapore Treaty on the Law of Trademarks. The draft government proposal also introduces amendments to related laws, particularly to the Company Names Act. In addition, provisions concerning collective marks and certification marks would be included in the new act.

The proposal introduces an administrative procedure for the revocation and invalidation of trademarks, in addition to current court proceedings. This administrative procedure would largely correspond to the current opposition procedure. Furthermore, trademark owners could henceforward invoke the five-year partial or total non-use of a claimant’s trademark or trade name as a defense in opposition, revocation, or invalidation proceedings. To avoid the same trademark being subject to parallel administrative and court proceedings, the working group proposes that if a court proceeding concerning the same trademark is initiated between the same parties, the proceedings at the Finnish Patent and Registration Office will be terminated.

The working group similarly proposes the introduction of administrative procedures to deal with partial or total revocation of company names and auxiliary trade names, in addition to the current court proceedings; however, such procedures would be limited to cases of non-use. Finnish companies with a broad (partly undefined) field of business frequently constitute a relative ground for refusal for national trademark registration despite operating in a totally different field. The presumably more efficient administrative procedures and possibility for partial revocation should help trademark owners to more easily overcome such hurdles.

The working group proposes that trademark owners of registrations filed before October 1, 2012, using class headings shall specify their list of goods and services to ensure that they follow the new classification provisions not later than the deadline for renewal of the respective trademark registrations. After said due date, the class headings would, unless specified, embrace only those goods and services covered by the literal interpretation of said class heading.

A few other notable changes are: the waiver of the graphical representation requirement, the introduction of the exclusive right of a Finnish trademark owner in situations where counterfeit goods are caught in transit (i.e., not put up for sale on the Finnish market, but caught while passing through), as well as the introduction of a clear provision criminalizing infringement of EU trademarks (typically counterfeits).

A government proposal will be handed over to Parliament during the autumn session. The new act should enter into force by January 2019.

RUSSIA: Constitutional Court Clarifies How to Tackle Parallel Imports
In a ruling on February 13, 2018, the Russian Constitutional Court clarified the conditions under which courts may authorize parallel imports into Russia. Ref. No. 8-P, Feb. 13, 2018.

From now on, lower instance courts will likely apply these guiding principles when considering parallel import cases, which may make the rightsholders’ goal to prevent parallel imports more complex.

Following a complaint raised by the Russian parallel importer PAG LLC against Sony Corporation (Ref. No. 8-P, Feb. 13, 2018), the Constitutional Court examined the constitutionality of Civil Code provisions prohibiting parallel imports and ruled that, while the provisions do not contradict Russia’s constitution, the principle of regional exhaustion of rights in Russia should not be automatically applied to all cases without considering the facts and circumstances related to every case.

In particular, parallel imports may be authorized for public interest reasons. Examples include the protection of health, if the rights holder acted in bad faith or abused its trademark rights, or if the actions of the trademark owner constitute unfair competition or support economic sanctions against Russia. The ruling can, however, give rise to various interpretations, and even a rights holder’s failure to reply to an importer’s request for permission may be considered “abusive.”
The Constitutional Court also ruled that, when imposing remedies, courts should distinguish between parallel imports and counterfeit goods. As a general rule, remedies, especially monetary fines, should not be as severe for parallel imports because losses incurred are generally not as high as in the case of the importation of counterfeit goods. Seizure and destruction of parallel imports should only be imposed if the goods do not meet the required quality standards and can undermine public health and security.

With many different approaches at both the EU and national levels, there has been no uniform interpretation of how the functionality issue should be addressed in Europe. However, in DOCERAM, the CJEU held that a product’s features of appearance are exclusively dictated by its technical function only when the technical function is the only factor determining those features, the existence of alternative design options to achieve the same function not being decisive in that regard. The Court, therefore, set aside the “multiplicity of forms thesis,” which was followed by a number of national courts up to this decision. In doing so, the CJEU confirmed the practice of the European Union Intellectual Property Office’s Board of Appeal as seen in several recent decisions (for example, R 690/2007, Lindner Recyclingtech v. Lars Fransson; R 1341/2015-3, 2WF v. Benmore Venture; and joined cases R 1517/2014 and R 2114/2014, International Edge Inc v. Blue Gentian LLC, by EUIPO’s Third Board of Appeal dated January 27, 2016).

In addition, regarding the assessment of whether the features of appearance have been solely dictated by functionality considerations, the CJEU held that the national court must take into account all the objective circumstances relevant to the individual case. In that regard, there is no need to adopt an “objective observer” standpoint. Instead, the assessment should consider the design at issue, the objective circumstances which dictated the product’s features of appearance, information on its use, or the existence of alternative designs that fulfill the same technical function, as long as supported by reliable evidence.

Read the full report in the INTA Bulletin.
Indian Dignitaries Attend INTA’s 140th Annual Meeting

Justice Manmohan participated in the Judges Workshop, in which judges from various international jurisdictions discussed public well-being versus private rights, offering the Indian judiciary’s perspective on the topic of brand restrictions. Mr. Gupta spoke at the IP Office Workshop and presented the Indian IP Office’s perspective on determining the deceptiveness of trademarks, including certification marks.

INTA expects that in the coming years the Association will continue to have the sustained and increased participation of dignitaries from India.

Sun Pharmaceutical Recognized by WIPO and DIPP in New Delhi

India’s Department of Industrial Policy and Promotion (DIPP) and the World Intellectual Property Organization (WIPO) in Geneva, Switzerland, awarded Sun Pharmaceutical Industries Ltd. with the “WIPO User Trophy for top Indian Company creating Global Brand 2018.” The Controller General of Patents, Design and Trademark commended Sun Pharmaceutical’s efforts to promote and protect its trademarks in other countries through the Madrid Protocol.

The honor was bestowed upon Sun Pharmaceutical during an event organized by DIPP and the Cell for IPR Promotion and Management (CIPAM) commemorating the successful completion of two years of India’s National Intellectual Property Rights Policy.

The award was presented by the Honorable Minister of Commerce and Industry, Suresh Prabhu, and received by Rajamallaiah Cirumalla and Azadar Khan of Sun Pharmaceutical.

INTA congratulates its member Sun Pharmaceutical on this recognition.

IP Rights Awareness in Schools Using Satellite Communication

On May 15, CIPAM organized its first-ever EduSAT program in collaboration with Vigyan Prasar, an autonomous organization under the Department of Science and Technology, to educate school children across the country on IP rights using satellite communication. During this session, INTA was represented by its member, Meera Chature (Jupiter Law Partners, India), who talked about IP rights and their importance with students. The program reached school students in the Indian cities of Itanagar, Jalgaon, Vijayawada, and Mandi.

Public Notice Regarding Applications in Danger of Abandonment

The Office of the Controller General of Patents, Designs & Trade Marks has issued a list of trademark applications in which examinations were completed before December 31, 2017, and the examination reports containing office objections were duly communicated to the persons concerned at the address for service on record, but for which the Trade Marks Registry has not received a reply. As of July 25, 2018, these applications are being treated as abandoned.

The notice also informs the public that, in addition to the service of examination report at the designated email of the applicant, the Trade Marks Registry has started providing a link (at https://ipindiaonline.gov.in/progress/noEXR-Received.aspx) of all applications on a monthly basis, with effect from January 2018, in which a reply to the office objection is awaited. The notice advises applicants to refer to the link periodically to comply with legal requirements and avoid abandonment of applications for non-compliance of office action.
Association Updates

INTA Celebrates World IP Day in India

On April 26, INTA attended the India Intellectual Property Convention and 10th National Intellectual Property Awards, co-organized by the Confederation of Indian Industry, the Department of Industrial Policy and Promotion, and Intellectual Property Office of India. The award ceremony is held each year on World IP Day (WIPD) to recognize and reward the organizations and people who have contributed to harnessing the country’s intellectual capital and who have helped to create an ecosystem that boosts creativity and innovation.

INTA congratulates its corporate member, Wipro Limited, India, which won the award under the category “Top Public Limited Company/Private Limited Company for Patents and Commercialization (Indian) and WIPO Enterprises Trophy.” Wipro Limited is a leading global information technology, consulting, and business process services company. As a company, Wipro consciously nurtures innovation and an intellectual property (IP) culture and has a rich IP portfolio.

On the same day, INTA also attended the WIPD celebrations in Chennai, hosted by Anand and Anand, which explored unique topics such as the history of IP in India, the evolution of India’s unique IP culture, and the power of respect and emotions vested in IP. The program showcased acclaimed speakers, including:

- Historian Venkatakrishnan Sriram; Academy Award nominee Bombay Jayashri; and ex-Chairman of the Intellectual Property Appeal Board, The Honorable Justice Prabha Sridevan. The audience enjoyed listening to anecdotes on historic pre-independence landmark IP cases fought before the Madras High Court in the 1930s through 1940s and shared in an artist’s perspective on IP and creativity.

- The Honorable Justice Prathiba M. Singh, which explored India’s IP culture and has a rich IP portfolio.

On April 27, INTA supported a conference organized by the Federation of Indian Chambers of Commerce & Industry (FICCI) in association with the government of India, to celebrate WIPD. The conference was titled “Promoting Innovation, Creativity & IP Generation Among Women Entrepreneurs.” The event included senior policy makers, administrators, and IP experts as speakers—many of them national and global women leaders from industry, academia, and the legal realm—who deliberated on subjects that included: “Women Empowerment Through IPR”; “Women Innovators Impacting Developments”; “Supporting Ecosystem Required for Women Creators”; and “Strategy for Next Stage of IP Growth.”

The focus of the FICCI conference was in keeping with the World Intellectual Property Organization’s WIPD theme for 2018—“Powering Change: Women in Innovation and Creativity”—and was intended to be a tribute to the brilliance, ingenuity, and courage of the women who are making a difference in people’s lives while shaping the future. The objective was also to generate discussion on India’s industrial landscape in the light of various IP-related developments in the country, and to encourage stakeholder exchanges on how innovation is increasingly driving businesses worldwide and the relevance of innovation to India’s growth story.

Suresh Prabhu, India’s Minister of Commerce and Industry, in a video message, said that the Indian government is addressing IP from every angle—legislative, administrative, enforcement, and prosecution—and will continue to take an aggressive approach to improving the country’s IP landscape.

In the News

India IP Office Annual Report: A Tale of Transformation and Progress

Adheesh Nargolkar
Khaitan & Co., Mumbai, India

Samta Mehra
Remfy & Sagar, Gurgaon, India
Trademark Office Practices—India IP Office Subcommittee

The Office of the Controller General of Patents, Designs, Trade Marks and Copyrights of India (IP Office) has recently released its Annual Report for the year 2016–17, which covers the period from April 1, 2016, to March 31, 2017 (the Year).

The highlights of the Annual Report (set out below) reflect the transformation the IP Office has undergone under the aegis of the Controller General, Om Prakash Gupta, who was appointed to the IP Office in November 2015.

The total number of trademark applications filed in the Year were 278,170, which showed a marginal dip compared to the previous year. However, the number of applications examined increased by 98.7 percent to 532,230 and the number of registrations granted showed a phenomenal increase of 284.5 percent, to 250,070 (up from 65,045 last year). Disposal of applications increased by 150 percent over the previous year. If numbers ever told a story, this year has been nothing short of a fairy tale.

Often, in a straightforward case, it is now possible to obtain a trademark registration within six months from the date of filing the application. The pendency of examination of applications has been reduced from 14 months to less than one month. Further, the rate of acceptance of trademark applications for publication has increased from less than 10 percent to about 40 percent.

Some other noteworthy changes for trademarks are as follows:

- Amendments to the Trademark Rules, which are primarily aimed at simplifying and expediting procedures: a few of the key amendments include service of documents through electronic communications, provision of hearings through video conferencing, discounts on electronic filing, specific provisions for sound marks, determination of marks as well-known, and expedited registrations.

- Increase in manpower: the Year saw 100 examiners joining the Trade Marks and Geographical Indications Office.

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• Increase in transparency via digitization of records.
• Controller General’s timely engagements: stakeholders are invited to make suggestions on a periodic basis and discuss them by having meetings. A feedback mechanism has been set up on the IP Office website whereby stakeholders can provide their feedback and suggestions with respect to issues related to the functioning of the IP Office, complaints, and general queries.
• Several initiatives have been undertaken to upgrade the existing IT-enabled environment, computerized workflow, and internal IT system of the IP Office.

Harmonization with various international offices: these include the European Union Intellectual Property Office, the United Kingdom Intellectual Property Office, and the Japan Patent Office. The Department of Industrial Policy and Promotion also published a booklet on the Madrid Protocol, in collaboration with the EUIPO, recognizing the importance of the Madrid System in today’s international IP landscape.

The IP Office has also increased its social media presence by creating a Twitter account. An android mobile app has been launched through which one can not only ascertain the status of trademarks, but also obtain information about hearings, journals, manuals, guidelines, and other trademark tools.

• The IP Office, through the Rajiv Gandhi National Institute of Intellectual Property Management (RGNIPM), trains examiners and imparts awareness to the IP-user community. RGNIPM conducted 99 programs on IP rights training and awareness during the Year.

All in all, one can safely say that the above changes have been brought about as a result of the positive intentions of the government and solution-based decision-making by the Controller General. The results speak for themselves and give IP owners reason to hope that the IP Office will soon be one of the most efficient in the world.

Delhi High Court Rules Color Red for Shoe Soles Not a Trademark

In the matter of Christian Louboutin SAS v. Abubaker and Ors., CS (Comm.) No. 890/2018, May 25, 2018, the plaintiff sought a permanent injunction against the defendants’ sale of red-soled shoes (notwithstanding that the defendant’s shoes featured the distinguishing trademark VERONICA). The plaintiff relied on its registered trademark for the color red for the soles of women’s shoes. The suit as filed was taken up on the question of admission.

The Delhi High Court examined in its decision whether the suit plaint set out a presentable cause of action that could be tried:

...taking the contents of the plaint as correct, whether there exists a legal entitlement in the plaint to claim the reliefs as prayed in the suit.

The Court examined the statutory definition of a “mark” and a “trademark”:

“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colors or any combination thereof [Section 2 (m) of the Trade Marks Act, 1999]

“trade mark” means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colors . . . . [Section 2 (zb) of the Trade Marks Act, 1999]

The Court observed that it is clear from the definitions of “mark” and “trademark” in the Trade Marks Act, 1999, that a single color does not qualify as either.

The plaintiff argued that a single color is capable of acquiring distinctiveness through use, and once distinctiveness is acquired, the single color can become a valid trademark. The Court, however, rejected this argument, holding that:

this argument ignores the first basic sine qua non of a thing becoming a trademark i.e. of whatever is sought to be claimed as a trademark must first also be a mark.

The Court accordingly dismissed the suit at the threshold, holding that even if the facts as set out in the plaint were to be taken as entirely true, there was simply no cause of action presented thereby that could possibly be taken up for trial.

This decision, which may be appealed, is a significant departure from the Delhi High Court’s own December 2017 ruling in another trademark infringement suit filed by Louboutin, Christian Louboutin SAS v. Pawan Kumar and Ors., CS (Comm.) No. 714/2016, in which the Court had ruled Louboutin’s “Red Sole Trademark” to be a “well-known mark.” The implications of this decision, particularly in the context of existing trademark registrations for single colors in India, is yet to be seen.

INDIA: 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.

Contributor: Sheja Ehtesham
ALG India Law Offices LLP, New Delhi, India
Verifier: Swaraj Paul Barooah
Centre for Internet and Society, Bengaluru, India
INTA Bulletins—Association News Subcommittee
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 observed that, because of increased “foreign travel and exchange of cultures,” it could be presumed that consumers would be aware of top brands worldwide.

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.

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INTA Weighs in on Data Protection and Brand Restrictions
Developments in Latin America

On May 8, INTA’s Latin America and the Caribbean Representative Office, in collaboration with the Brazilian Intellectual Property Association (ABPI) and the International Chamber of Commerce (ICC), participated in the Second Intellectual Property Seminar—Public Policies and International Perspectives, organized by the National Confederation of Industry (CNI) in partnership with the World Intellectual Property Organization (WIPO) and the Brazilian National Institute of Industrial Property (INPI).

The event covered topics including recent developments in the Brazilian intellectual property system, Brazil’s adherence to international treaties, international cooperation and negotiations in which Brazil is involved, and the role of the private sector in these initiatives.

INTA members Alonso Camargo (Olivares, Mexico) and Marina Dostal (General Electric Company, USA) presented the Association’s position on the Madrid Protocol. Mr. Camargo shared Mexico’s recent experience with implementation of the Protocol from the practitioner perspective, while Ms. Dostal provided a brand owner perspective on filing trademarks via the Madrid System.

Impact of EU General Data Protection Regulation and Changes in the WHOIS System on Trademark Holders

While in São Paulo, the Latin America and the Caribbean Representative Office also participated in a workshop about data protection on the Internet that was organized by CNI. Fabiano Barreto, Analyst of Politics and Industry for CNI, moderated a panel comprising INTA’s Chief Representative Officer, Latin America and the Caribbean, José Luis Londoño; Daniel Fink, Stakeholder Engagement Senior Manager at the Internet Corporation for Assigned Names and Numbers (ICANN); and Pedro Paulo Vilhena (Kasznar Leonardos, Brazil).

Mr. Londoño spoke first, providing an overview of INTA and introducing the Association’s concerns surrounding data protection on the Internet. He explained the potential risks for the EU General Data Protection Regulation (GDPR) to facilitate illegal trade and increase counterfeiting, which severely harms companies as well as consumers and governments.

Mr. Fink gave a comprehensive overview of ICANN’s operations and the expected consequences of the GDPR on ICANN’s and contracted parties’ activities. He highlighted the role of ICANN in assisting companies that have their trademarks infringed on the Internet.

Finally, INTA member Mr. Vilhena (Kasznar Leonardos), who is also a member of INTA’s Data Protection Committee, examined the importance of the WHOIS system for brand owners, as well as the challenges for WHOIS related to the implementation of the GDPR. He said that Brazil does not have a set of privacy standards on par with the European Union, due to the lack of a culture of privacy protection, and concluded, “GDPR creates a unified data system for Europe, but at the same time it imposes far more stringent rules than existing ones.”
INTA Addresses Brand Restrictions in Chile
On May 3, José Luis Londoño, Chief Representative Officer, Latin America and the Caribbean, and the Chair of INTA's Emerging Issues Committee, Ariela Agosin (Albagli Zaliasnik, Chile), met with the Chilean Ministry of Economy, Development and Tourism, José Ramón Valente Vías. The primary objective of the meeting was to explain INTA’s position regarding brand restrictions and the potential consequences for commerce.

The discussion centered on Bill 9914-11, which intends to modify Chile’s Sanitary Code. The bill includes a rule related to trademarks, possibly limiting the size of trademarks on pharmaceutical product packaging. Secondly, in 2016, a regulation entered into force in Chile regarding labeling and packaging of food being advertised to children. Based on new legislation, administrative authorities started proceedings against several companies for the use of figurative marks on the packaging of products classified as high in sugar, calories, sodium, and carbohydrates. Such marks were deemed to constitute advertising and the regulation went so far as to order their removal from the packaging.

Mr. Valente seemed very receptive to INTA’s position regarding the fact that limiting the use of trademarks in these two markets may have negative consequences, particularly regarding customs controls, anticyfitering, and freedom of choice. In the pharmaceutical market, it may even have negative effects on consumers’ health and safety. INTA also emphasized that, from an economic perspective, excessive regulation in the use of the trademarks on the packaging of both pharmaceuticals and food products can create barriers to entry of foreign products into the country, discouraging foreign investment and competition.

On May 18, Mr. Londoño, Ms. Agosin, and Ms. Davis attended a meeting with Juan Luis Castro Gonzalez, the Head of the Health Commission of the Chamber of Deputies of the Chilean Congress.

INTA believes that this modification is an improvement, since it does not limit the use of trademarks or any other intellectual property.

The purpose of the meeting was to discuss the implications of Article 128 bis of Bill 9914-11, which initially dramatically limited the size of trademarks on the packaging of pharmaceutical products. The article was modified during the legislative process, and no longer limits the size of the trademark, but establishes that it will be a regulation handled by the Ministry of Health, which will determine the shape, size, colors, proportion, characteristics, and content of the labels of medicines.

INTA believes that this modification is an improvement, since it does not limit the use of trademarks or any other intellectual property. However, the Association stressed that the Ministry of Health must be cautious when using its regulatory powers and avoid following the modified 128 bis provision measures that unjustifiably limit the acquired rights of trademark owners to use their trademarks. This position was presented to the Health Commission of the Chambers of Deputies on July 10, when Antonio Varas (Porzio Rios Garcia, Chile) and Mr. Londoño attended the public hearing organized by the Health Commission.

INTA Welcomes Improvements to Mexico’s Trademark Legislation
On May 18, amendments to Mexico’s industrial property legislation were published in the country’s Official Gazette and entered into force on August 10, 2018.

The modification includes significant improvements, including the addition of protection for:

- Nontraditional marks (sound, olfactory, and holographic trademarks);
- Trade dress; and
- Generic or descriptive trademarks that have acquired distinctiveness by use in the market.
- The amended legislation also includes:
  - Introduction of the obligation to file a Declaration of Use within three months after three years of registration. If this declaration is not filed, the trademark will lapse.

Miguel Ángel Margain, Director General of the Mexican Institute of Industrial Property (IMPI) and Eliseo Montiel Cuevas, Divisional Director of Trademarks, attended INTA’s Annual Meeting in Seattle, Washington, USA. They attended various committee and subcommittee meetings to inform members about the legislative amendments, thanking INTA for participating in that process and requesting INTA’s assistance in making the regulation. As a result, there has been considerable cross-committee collaboration to support Mexican authorities in the creation of a new regulation.

Following publication in the Official Gazette, there was a 60-day period for the authority to issue a new regulation and INTA submitted its comments on the proposed regulations. The submission was the result of the efforts of several subcommittees and task forces, including the Nontraditional Marks Committee; the Trademark Office Practices—Oppositions and Cancellations Subcommittee; and was led by the Legislation and Regulation—Latin America Subcommittee.

Association Updates

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INTA Takes Anticounterfeiting Message to Argentina, Ecuador, and Uruguay

In April, INTA CEO Etienne Sanz de Acedo, Anticounterfeiting Manager Maysa Razavi, and Latin America and the Caribbean Chief Representative Officer José Luis Londoño traveled to Buenos Aires, Argentina, and Montevideo, Uruguay, to support several activities led by the Anticounterfeiting Committee.

The highlight of the trip was the “Third Forum on Enforcement of Intellectual Property Rights: The Role of Intellectual Property Offices,” which was hosted by the National Directorate of Intellectual Property of Uruguay in Montevideo. Intellectual Property (IP) offices from 12 countries were in attendance: Argentina, Belize, Chile, Colombia, Cuba, Ecuador, El Salvador, Guatemala, Mexico, Paraguay, Peru, and Uruguay. There were also officials in attendance from the United States, the World Customs Organization, Uruguay Customs, and local judges. The meeting was a two-day seminar focused on ways the offices can champion anticounterfeiting efforts in their countries. The event was sponsored by INTA, the International Chamber of Commerce—Business Action to Stop Counterfeiting and Piracy, and the Inter-American Association of Intellectual Property.

The event began with a review of last year’s Forum in Santiago by Maximiliano Santa Cruz, National Director of Chile’s National Institute of Industrial Property. Next, Hector Balmaceda, Director of the National Directorate of Intellectual Property of Paraguay, and Rogelio Canales, Executive Director of El Salvador’s National Center of Registries, discussed the innovative ways in which their offices are tackling counterfeiting. INTA Board Member Maria Cecilia Romoleroux (Corral Rosales, Ecuador) moderated a panel on oppositions and cancellations with the representatives from Belize, Ecuador, and Uruguay. Ray Meloni, Director of Peru’s National Institute for the Defense of Competition and Protection of Intellectual Property and John Alexander García Rodríguez Head of Cancellation and Oppositions of Colombia’s Superintendencia de Industria y Comercio discussed the role of IP offices in consumer protection and respect for IP. A panel titled “Cooperation between National Enforcement Agents and IP Offices” was held with the various agencies from Uruguay and Ibery Aquíque Pineda, IP Enforcement Division Director at the Mexican Institute of Industrial Property (IMPI). The first day closed with a prestigious panel of Uruguayan judges focused on judicial criminal actions.

The second day started with a panel on intra-border measures with Miguel Ángel Margain, General Director of IMPI, and Aracely Quingalombo, Legal Expert with the Ecuadorian Institute of Intellectual Property. INTA Anticounterfeiting Committee Chair Virginia Cervieri (Cervieri Monsuarez & Associates, Uruguay) led a session on border measures with the help of representatives from Uruguay Customs, the Navy Investigation Division of Uruguay, and the World Customs Organization. Finally, Dámaso Pardo, President of Argentina’s National Institute of Industrial Property, Mr. Santa Cruz, and Martin Chajchir (Marval, O’Farrell & Mairal, Argentina) gave the opening remarks on behalf of INTA and provided a brief overview of the issue. He also referred to the recently updated best practices guide, “Addressing the Sale of Counterfeits on the Internet,” prepared by the Anticounterfeiting—Online Counterfeiting Project Team. Leonardo Barbieri, AAA Treasurer, commented on this hot topic from the perspective of the members of his association.

The first panel addressed the current status of the situation in the region and offered the views of Pedro Duarte Guimaraes, Project Leader of the European Union (EU)-funded project for intellectual property in Latin America, “IP Key Latin America,” at the European Intellectual Property Office; Diego Farreras (LVMH Fashion Group, Argentina); and Martin Gimenez, Chief of the Cybercrime Department of the Buenos Aires Police. The second panel, moderated by Claudia Serritelli (Estudio Chaloupka, Argentina), focused on the actions that the different stakeholders are taking to curb counterfeiting, and included presentations by Maria Laura Perna (adidas Group, Argentina) and Guadalupe García Crespo (MercadoLibre, Argentina). Finally, the third panel, moderated by Juan Porta (Ryan Lussich & Asociados, Argentina), featured Esteban Lescano, Director of the Committee on Legal Affairs and Public Policies of the Argentine Internet Chamber, and Gustavo Giay (Marval, O’Farrell & Mairal, Argentina), a member of the AAA and former INTA Board member, engaging in an interesting discussion on the draft bill addressing Internet service provider liability for third-party-generated content, which is currently being considered by the Argentine Congress.

After the policy dialogue, the delegation met with several important enforcement officials. Ms. Razavi and Andrés O’Farrell (Marval, O’Farrell & Mairal, Argentina) traveled to meet the Honorable Dr. Federico Villena, Federal Judge of the Court of Lomas de Zamora, and Lomas de Zamora Mayor, Martín Insarrale, to discuss counterfeiting problems within La Salada, the largest informal market in South America. At the same time, Mr. Londoño and Mr. Giay met with representatives of Argentine Customs to ask them to share more information with the private sector. Finally, Mr. Sanz de Acedo, Mr. Giay, and Ms. Perna met with Patricia Bullrich, Minister at the Ministry of Security, to join the National Roundtable Against Illegal Commerce, a coordination body of all public agencies, which is supported by the private sector and focused on illicit trade, including counterfeiting.
Finally, separate from the delegation, INTA held a cross-border customs training in Tulcán, Ecuador, for authorities from Colombia and Ecuador. Besides a brand identification training for several INTA members, the Anticounterfeiting Committee was able to take the opportunity to explain the complicated procedures involved with the Colombian legal system and identify the gaps in the Ecuadorian regime. On April 17, a Binational Training took place in the city of Tulcán, Ecuador, by committee members from member firms, Estrategia Juridica and Correal Rosales.

Forum on Intellectual Property in Uruguay
On June 22, INTA participated in a joint forum on the Economic Impact on Intellectual Property, jointly organized by INTA, the National Directorate of Industrial Property Ministry of Industry, Energy and Mining of Uruguay (MIEM-DNPI), and the Inter-American Association of Intellectual Property (ASIPI). The forum was a continuation of the discussions that took place at the IPO Enforcement Seminar, held by INTA in partnership with MIEM-DNPI, ASIPI, and the International Chamber of Commerce—Business Action to Stop Counterfeiting and Piracy in Montevideo on April 19 and 20.

Participants included representatives from the Presidency of the Republic, Ministry of the Interior, National Customs, the Uruguayan Association of Industrial Property Agents, civil and criminal judges, and representatives from the Departmental Government-Municipality of Montevideo. INTA was represented by Virginia Ortin & Valedon, Venezuela, Secretary of State for the Interior, National Customs, National Association of Industrial Property Agents (COVAPI), and the press.

The roundtable was a prime opportunity to introduce the results of the impact study, which demonstrated the positive impact of trade-mark-intensive industries on the economies of Chile, Colombia, Mexico, Panama, and Peru. The study included findings that the contribution of IP-intensive industries to total employment in these regions is about 8 to 26 percent and 10 to 21 percent of GDP. Such data is particularly important for an economy like Venezuela’s, which is experiencing economic and political challenges.

Luis Alejandro Henríquez (Marquez, Henríquez, Ortin & Valedon, Venezuela), Secretary of ASIPI and member of the team that developed the impact study, was the main presenter. He shared the highlights of the study with the audience and stressed the importance of adequate protection of IP rights so that the country and brand owners can benefit from their contribution to the economy.

Castor Gonzalez-Escobar (GR LEX Americas, Venezuela) talked about the present and future of IP rights protection in Venezuela, discussing the challenges for promoting a culture of innovation and creativity as a tool to promote growth and wealth, as well as human and economic development.
Latin America

Association Updates continued from page 31

Matias Perez-Irazábal (Hoet, Pelaez, Castillo & Duque, Venezuela) and President of COVAPI, gave a detailed presentation about the actions and challenges faced by COVAPI in defending IP rights.

The meeting was also an excellent opportunity for the IP community to receive an update from Mario Massone, Legal Advisor of the Science, Technology and Innovation Commission of the National Assembly (Venezuela’s Congress) and Coordinator of the technical committee for the reform of the Industrial Property Law, regarding the advances and challenges for passing such reform.

The “Combatting Online Counterfeiting” Policy Dialogue took place at the offices of Marval, O’Farrell & Mairal in Buenos Aires, Argentina, on April 17.

In the News

ARGENTINA: Trademark Law Amended to Simplify Prosecution and Opposition Proceedings

On January 10, 2018, the Argentine government issued Decree 27/2018, which aims to simplify the administrative proceedings. Among the many changes introduced by the decree, the Trademark Law has been revised for the first time since 1981, bringing key changes to local trademark practice—particularly to the unique opposition system.

According to the new provisions, the applicant and opponent will now have three months from the date the applicant was notified of the opposition to negotiate a friendly settlement; in the absence of an agreement, the National Institute of Industrial Property (INPI) will decide on the opposition in an administrative proceeding yet to be determined. INPI’s decision may be appealed before the Federal Court of Appeals. Cancellation of trademarks registered in bad faith will remain the exclusive jurisdiction of federal courts.

With respect to lapsing, registrations will only remain valid if the mark is used in connection with the goods and services it protects or with related goods and services, even if they belong to a different class. The previous provisions allowed a mark owner to claim use with respect to any unrelated product or service to avoid lapsing. Moreover, under the new regulations, a sworn statement of use must be submitted by the sixth year after the registration date.

The decree became effective on January 12, 2018, but since many of its provisions require additional regulation, on January 16, 2018, INPI issued Regulation P-001. This regulation clarified which provisions are fully operative and which ones need further regulation. A special provision was included for trademark applications with oppositions notified under the previous system, where INPI established that the former one-year term remains in place for those cases unless the applicant voluntarily declares to the office that no agreement was reached with the opponent or the opponent submits new grounds to support the opposition.

BERMUDA: Official Fees Increased in April

Bermuda’s Registrar General increased the official fees for trademark matters as of April 1, 2018. With already some of the highest official fees in the Caribbean region, the small British Overseas Territory increased its fees by approximately 5 percent for all types of actions.

For example, the total official fees for filing and completing the registration of a trademark increased from USD 488 to USD 512. The fee for a renewal, including issuance of the certificate, increased from USD 420 to USD 441. Bermuda’s last fee increase took place in 2016.

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INTA Heads Back to Dubai

Tat-Tienne Louembe, Representative, Africa and the Middle East

On December 10 and 11, accompanied by a dedicated project team, INTA will convene its “2018 Middle East and Africa Conference: Innovation, Investment, and IP” in Dubai, United Arab Emirates (UAE). Preparations are well underway and the members of the project team have been working to ensure that the content will be relevant and practical for all who attend.

The conference’s theme, “Innovation, Investment, and IP,” is expected to attract key government officials, trademark owners, judges, heads of intellectual property (IP) offices as well as private sector representatives and intergovernmental institutions. Building on the success of previous workshops held in Dubai, the December conference represents an opportunity to foster knowledge sharing on trademarks and related IP rights among the participants and to keep abreast of the latest developments in Africa and the Middle East. Furthermore, it will contribute to building bridges between experts and trademark owners operating in these respective regions.

The conference represents an opportunity to foster knowledge sharing on trademarks and related IP rights among the participants, to keep abreast of the latest developments in Africa and the Middle East, and to build bridges between experts and trademark owners operating in these respective regions.

From a policy and advocacy perspective, the conference will be an occasion for INTA leadership, with support from the Middle East Global Advisory Council, to further its engagement with local authorities by learning more about the national IP strategies in the region, ongoing enforcement efforts, and the benefits of economic diversification through innovation. For more information or to register, please visit the conference homepage.

In the News

IRAQ: Refiling of Trademarks Required Under New Relative Grounds Examination System

To address its substantial backlog, the Iraqi Central Organization for Standardization and Quality Control (COSQC) has adopted a rather anomalous decision that will be of some concern to trademark owners with pending applications in Iraq.

Previously, in Iraq, trademark filings were given an application number and an official filing date prior to the examination (as in the majority of jurisdictions around the world). Now, an application number and an official filing date will be given to the application only when the relative grounds examination has been concluded. The application will then proceed to publication.

In order to avoid ex officio citations of earlier confusingly similar marks whose owners may have lost interest in maintaining protection, in December 2017, the COSQC requested the refiling of pending, unpublished applications for marks cited by the Registrar during the relative grounds examination as confusingly similar or identical to a mark newly applied for by a third party.

In other words, the owner of a pending, unpublished application for a mark that has been cited as confusingly similar to a newly applied-for mark will have to refile its application in order to ensure that the trademark office maintains its relative grounds objection based on that earlier mark. The refilled application will have a refilling date, but reference to its original filing date will be maintained on record to ensure that the original filing date is preserved and thus that the refilled application takes precedence over the new application. However, the protection of the refilled mark will run from the date of refiling. The good news is that the new application will not be allotted a filing date unless the applicant is able to successfully overcome the citation.

The December 2017 request applies only to unpublished trademark applications with filing numbers preceding T2000, which were filed prior to the introduction of the new relative grounds examination system by the COSQC more than a year ago. The deadline to refile these applications is calculated as seven days from the official date on which
the mark owner is notified of the confusingly similar mark. If the owner does not refile its application, that application will not be published and will be considered abandoned. It seems that all unpublished applications with filing numbers preceding 72000 will not proceed to publication.

In view of this development, trademark owners would do well to verify the status of their trademark portfolios in Iraq.

OMAN: IP Office Adopts 11th Edition of the Nice Classification
The Trademark Office in Oman adopted the 11th Edition of the Nice Classification as of February 1, 2018, thus replacing the outgoing 10th Edition. The adoption of the 11th Edition will not affect trademarks already filed and registered in Oman. Pending trademark applications, as well as trademark registrations, will be reclassified at the time of renewal.

The amendments in the 11th Edition cover 15 class headings and explanatory notes for seven classes. Furthermore, the list of goods and services was increased by 334 terms.

UNITED ARAB EMIRATES: Launch of Online Trademark Register Searches
On April 19, 2018, the United Arab Emirates Trademarks Department issued a circular to all registered trademark agents announcing the launch of an online portal through which agents can conduct trademark register searches. This development means that agents no longer need to visit the Trademarks Department in person, reducing the time and costs for agents in conducting register searches. The official fees do, however, remain relatively high when compared to most other countries at AED 500 (USD 137) per mark, per class.

Searches can be conducted for word marks only. It is not possible to conduct searches by trademark owner or for figurative elements of marks. The search results will only return results for the identical mark that is searched. Each variant searched will incur a new search fee, and it is not possible to conduct searches of similar marks.

The search results contain relatively few details compared to other online search portals in other jurisdictions. The searches will provide agents with the following information only: word elements contained in the mark, the filing date, the registration date (if applicable), owner name, address and nationality, and the current status of each mark revealed by the search. However, the search results do not contain the following information: details of priority claims (if any), a representation of any figurative elements contained in the mark, details of the agent of record, prosecution history, or details of any conditions, disclaimers, recorded licenses, or mortgages. In order to obtain these details about a record identified by the online searches, a visit to the Trade Marks Department would be necessary. However, recently, the Trade Marks Department has been refusing to provide agents with further information unless that is the agent of record for that particular mark and the agent holds a valid power of attorney.

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North America

INTA President Tish Berard Speaks at USPTO Trademark Exposition

INTA’s Washington, D.C., staff has been focused on advocacy this summer, participating in events representing the trademark community in Congress and government agencies. The Washington, D.C., Office looks forward to the INTA Leadership Meeting in New Orleans, Louisiana, which will occur just weeks before the conclusion of this Congressional session.

USPTO Trademark Exposition
On July 27, INTA President Tish Berard (Velcro Companies, USA), spoke on a keynote education panel titled “Counterfeits and Con Artists: The Real Dangers and Costs of Fake Goods” at the United States Patent and Trademark Office’s (USPTO’s) 2018 National Trademark Exposition, which was held at the Smithsonian National Museum of American History and attracted 26,000 visitors on July 27 and 17,000 on July 28. In a packed room with consumers of all ages, Ms. Berard spoke about the direct harms caused by counterfeit goods, including noting that all companies are challenged by counterfeiting when trying to protect their brands. She discussed how counterfeiting undermines a brand’s research and development efforts and diminishes consumers’ trust, especially when those consumers receive counterfeit products of substandard quality.

Ms. Berard explained that counterfeiting is a crime that endangers public health, dislocates millions of jobs, and drains government revenue, including funds to run key services. She noted how counterfeiters benefit financially from selling counterfeit goods and that counterfeiters rarely receive long prison sentences. She also pointed out that, with over 1.5 billion websites, the Internet has provided counterfeiters with the ability to reach consumers online, while acting anonymously, including the opportunity to hide Internet Protocol (IP) addresses.

Ms. Berard discussed INTA’s commitment to global outreach initiatives, including education, and encouraged attendees to visit INTA’s Unreal Campaign booth to learn more about the direct harms presented by counterfeiting.

Capitol Hill Briefing
In late July, INTA member and Chair of the U.S. Subcommittee of INTA’s Anticounterfeiting Committee, Tara Steketee (Merck & Co., Inc, USA), represented INTA in an informal briefing for staff from both the U.S. Senate and House of Representatives, organized by Congressional Trademark Caucus Co-Chair, Representative John Ratcliffe, a Republican Congressman for Texas’ 4th District. The briefing, which was limited to Congressional staff, focused on the security and safety challenges presented by counterfeiting and INTA’s recommendations for best practices in dealing with online counterfeiting.

In her remarks, Ms. Steketee described how counterfeit medicines have even been given to patients in a medical setting that have led to adverse effects, including death. Congressional staff in attendance indicated a strong interest in increasing opportunities for coordination to help address the challenges presented by counterfeiting and opportunities to educate consumers. INTA is continuing the dialogue and will be arranging further briefings.

IP Associations Convene July Meeting
In late July, representatives of leading U.S. intellectual property (IP) associations, including the American Intellectual Property Law Association, the American Bar Association’s Intellectual Property Law Section, and the Intellectual Property Owners Association, and INTA, held a meeting focused on key U.S. agency issues and new stakeholder initiatives. In addition, the attendees discussed priorities for the remainder of the 115th Congress, which will conclude at the end of 2018.

Foreign Service Officer Training
Also in late July, INTA Anticounterfeiting Committee member Chun Wright (Law Office of Chun T. Wright, PLLC, USA) participated on behalf of INTA in an IP training session at the USPTO for U.S. Department of State Foreign Service Officers. The training was designed to assist Department of State Political and Economic Officers and Locally Employed Staff in better understanding the global challenges posed by counterfeiters and ways in which those challenges are handled by government and the private sector.

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Left to right: INTA President Tish Berard (Velcro Companies, USA); Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director of the USPTO; Kareem Abdul-Jabbar; Mary Boney Denison, USPTO Commissioner for Trademarks; and Naomi Takeuchi (1,000 Cranes, LLC)
Association Updates

INTA Hosts Education and Outreach Events on Capitol Hill in Celebration of World IP Day
On April 25, INTA hosted a Sports Industry Briefing in the Hart Senate Office Building focused on intellectual property (IP) enforcement. The briefing featured remarks from the U.S. Senate Congressional Trademark Caucus co-chairs Senator Chris Coons (D-DE) and Senator Chuck Grassley (R-IA); the Intellectual Property Enforcement Coordinator, Vishal Amin; and an all-star panel of representatives from sports leagues and collegiate sports, including Lindsay Victor (IMG, USA); Ashley Page (IMG, USA); Dolores DiBella (National Football League, USA); Tanya Fickenscher (Major League Baseball Properties, Inc., USA); Thomas Prochnow (NHL Enterprises, L.P., USA); Sacha Tarrant (NBA Properties, Inc., USA); and Moderator, Kristi Dosh, a freelance sports journalist. The panel focused on how the sports industry works to ensure strong IP protections for its products and seeks to stop counterfeit products from reaching consumers.

During the keynote speeches, Senator Coons shared anecdotes about discussions with his family at sports events and how he explains to them why fans of all ages should only purchase authentic merchandise. Senator Grassley further discussed how counterfeit products are sold by criminals and the importance of supporting businesses that are selling authentic goods.

The panel provided insight and tips about purchasing goods and how to find authentic goods at varying price points. Speakers discussed the importance of researching retail outlets and suggested purchasing items from your favorite team (or league) website or store. They shared experiences about sales of counterfeit goods and noted the costs of IP enforcement. In conclusion, the panelists noted the importance of working together with the sports community to educate and engage with consumers and especially fans about the direct harms caused by counterfeit products and the importance of buying only authentic sports products in support of their favorite team or league.

The Association looks forward to its continued work together with the global community on educating consumers of all ages about IP and celebrating how gender parity and diversity leads to increased opportunities for innovation and collaboration.

On April 26, World IP Day (WIPD), INTA joined with the U.S. Patent and Trademark Office (USPTO) and the IP stakeholder community to host a briefing in the Rayburn House Office Building focused on this year’s WIPD theme of “Powering Change: Women in Innovation and Creativity.” INTA Vice President and Executive Vice President & Deputy General Counsel at NBA Properties, Inc., Ayala Deutsch, presented keynote remarks on behalf of INTA, noting INTA’s commitment to diversity of all forms, including gender diversity and how diversity and inclusion is central to the Association’s mission. Further, Ms. Deutsch shared that INTA currently has a female president, Tish Berard (Velcro Companies, USA), and that in the past 20 years, 50 percent of INTA presidents have been women.

The WIPD event included a women-in-innovation panel and passionate speeches about the importance of IP from Representative Bob Goodlatte (R-VA-6th), Representative Darrell Issa (R-CA-49th), and Representative Hank Johnson (D-GA-4th). In addition to the importance of IP enforcement, the members of Congress spoke about the importance of IP to the global economy and innovation. INTA looks forward to its continued work together with the global community in educating consumers of all ages about IP and celebrating how gender parity and diversity leads to increased opportunities for innovation and collaboration.

INTA and Intellectual Property Constituency Host Successful Fundraiser at ICANN61 in Puerto Rico
INTA and the ICANN Intellectual Property Constituency (IPC) took the opportunity to leave the conference rooms of ICANN61, held in Puerto Rico in March, in order to head out to the beach for a fundraiser to benefit the victims of Hurricane Maria, which devastated Puerto Rico last fall.

Sponsored by Com Laude and the San Juan law firm of Ferraiuoli LLC, the event took place on March 13, 2018. Attendees included INTA and IPC members attending the ICANN meeting. INTA members residing in Puerto Rico, ICANN senior staff and Board members, community leaders, and government officials. The venue...

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Anticounterfeiting Committee Holds Customs Trainings in Cooperation with U.S. Customs and Border Protection
The Anticounterfeiting Committee successfully organized two customs trainings in the first half of 2018 in cooperation with U.S. Customs and Border Protection (CBP). On April 24, the Anticounterfeiting Committee organized a customs training with CBP in Atlanta, Georgia, at the Atlanta field office. The training gathered local enforcement officials from CBP and from the Atlanta Consumer Products and Mass Merchandising Center of Excellence and Expertise and brand owners for a half day of brand identification training. Following the brand identification training, CBP officials brought participating brand owners to their warehouse for an informational session on a recently seized counterfeit shipment.

On May 22, the committee organized a training during the INTA Annual Meeting with local Seattle, Washington, CBP officials, including import specialists from the Apparel, Footwear, and Textiles Center of Excellence and Expertise. More than 25 brand owners participated in a two-hour session, training more than 30 enforcement officers.

INTA began its pilot customs training program as a free membership benefit in 2016 at the Leadership Meeting in Hollywood, Florida, and expanded its trainings internationally in 2017. Upcoming trainings for 2018 include: (1) Iquique (Chile); (2) New York, New York (USA) at the John F. Kennedy International Airport in cooperation with the Pharmaceuticals, Health and Chemicals Center of Excellence and Expertise; (3) Long Beach, California (USA) in cooperation with the Electronics Center of Excellence and Expertise; (4) Mexico City (Mexico); and (5) New Orleans, Louisiana (USA), during the 2018 Leadership Meeting.

For more information on the customs trainings or on INTA’s anticounterfeiting activities, please contact INTA Anticounterfeiting Manager Maya Razavi at mrazavi@inta.org or Anticounterfeiting Senior Coordinator, Tiffany Pho, at tpho@inta.org.
North America

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Su was situated right on the beach at the La Concha Resort in Condado, where more than 120 guests heard about the exciting work being done by the Ricky Martin (RM) Foundation, the recipient of the funds raised that evening.

The RM Foundation was founded to prevent human trafficking. The Executive Director of the Foundation, Bibiana Ferraiuoli, explained how natural disasters increase the potential for human trafficking by making populations more vulnerable to exploitation. She also explained how the Foundation organized a dedicated hurricane relief fund to help rebuild homes and provide essential supplies to Puerto Ricans who lost everything in the hurricanes that battered their island.

Approximately USD 6,000 was raised through generous donations from the event’s sponsors and guests, who provided individual donations. The money will go directly toward building 200 homes in the town of Loiza. All agreed that it was a very special evening and reminded everyone of the importance of being connected to the communities that host these meetings. Ms. Ferraiuoli commented, “the Ricky Martin Foundation is pleased to see so many guests from around the world take an interest in helping Puerto Rico rebuild.”

This community outreach reception was part of INTA’s continued efforts to promote corporate social responsibility and provide meaningful events for our members.

Saul Lefkowitz Competition Celebrates 27th Annual National Finals Winners

Joseph T. Nabor
Fitch Even Tabin & Flannery, LLP, Chicago, Illinois
Chair, Saul Lefkowitz Moot Court Competition Committee

Cynthia Walden
Fish & Richardson P.C., Boston, Massachusetts
Vice Chair, Saul Lefkowitz Moot Court Competition Committee

Richard Stockton
Banner & Witcoff, Ltd., Chicago, Illinois
Immediate Past Chair, Saul Lefkowitz Moot Court Competition Committee

INTA’s Saul Lefkowitz Moot Court Competition concluded another successful year at the National Finals on March 17, 2018, at the U.S. Court of Appeals for the Federal Circuit in Washington, D.C., USA.

Nationwide, 71 teams from 55 law schools participated in this year’s competition. For the first time, the event expanded to include a regional competition in Los Angeles, California. The following 12 teams advanced to the National Finals:

New York Region
Georgetown University Law Center

Chicago-Kent College of Law, Illinois Institute of Technology
Notre Dame Law School

Atlanta Region
Georgia State University College of Law (two teams)

Dallas Region
SMU Dedman School of Law
University of Oklahoma College of Law

San Francisco Region
University of California, Hastings College of Law
University of California, Berkeley School of Law

Los Angeles Region
Pepperdine University School of Law
University of California, Los Angeles (UCLA) School of Law

San Diego Region
University of San Diego School of Law
University of California, San Diego School of Law

Chicago Region
Chicago-Kent College of Law, Illinois Institute of Technology
Notre Dame Law School

Atlanta Region
Georgia State University College of Law (two teams)

Dallas Region
SMU Dedman School of Law
University of Oklahoma College of Law

San Francisco Region
University of California, Hastings College of Law
University of California, Berkeley School of Law

Los Angeles Region
Pepperdine University School of Law
University of California, Los Angeles (UCLA) School of Law

Read the full report in the INTA Bulletin.

Mary Boney Denison Updates INTA on the USPTO’s Trademark Enforcement Efforts

As Commissioner for Trademarks at the United States Patent and Trademark Office (USPTO), Mary Boney Denison is the highest-ranking U.S. government official whose role is devoted entirely to brand protection. A U.S. lawyer admitted in New York and the District of Columbia, she was first exposed to trademark law in 1981. “Coming from a family of architects, the creative aspect of trademarks immediately appealed to me,” Ms. Boney Denison says. In fact, trademark litigation and/or prosecution have made up the bulk of her work ever since. Today, she oversees all aspects of the USPTO’s trademarks department, including policy, operations and budget relating to trademark examination, registration, and maintenance.

Ms. Boney Denison spoke with Christian W. Liedtke (acuminis llp, USA), a member of the INTA Anticounterfeiting Committee’s United States Subcommittee, about the USPTO’s role in the fight against counterfeiting.

What are some of the biggest challenges you face in your efforts to combat counterfeits?

The most fundamental challenge for USPTO attorneys and attachés lies in working to help our trading partners to establish an effective IP enforcement framework, so as to ensure U.S. businesses’ rights are enforceable wherever they choose to operate. In addition, the Internet and rise of e-commerce have created a more fluid and anonymous medium for selling pirated or counterfeit goods, making IP enforcement even more challenging.

Read the full report in the INTA Bulletin.

Christian Liedtke
acuminis llp, Costa Mesa, California, USA
Anticounterfeiting–United States Subcommittee
North America

In the News

CANADA: Recent Changes to Canadian Trademarks Act and Prospects for Protection of Traditional Knowledge
Fundamental changes to the Canadian Trademarks Act were passed on June 19, 2014, and will come into force on a date still to be determined. The necessary update of the Trademarks Regulations and various practice directions is well underway as part of the implementation of the Madrid Protocol, Singapore Treaty, and Nice Agreement contemplated by the changes to the Act.

Protecting Traditional Knowledge
The use of a mark commercially is contrary to the belief of some indigenous communities that do not want their ceremonial symbols, designs, and words used for profit. However, other indigenous businesses and organizations in Canada do have registered or protected marks. Indigenous indicia may qualify for protection as “official marks,” which excuse the requirement for commercial use in association with specific goods and services. For example, the Osoyoos Indian Band Council of British Columbia has sought protection of the word “Inka-meep” as an official mark. Currently, the official marks regime of the Canadian Trademarks Act does not specifically include the symbols and designs of indigenous peoples. Certification marks, another form of trademarks, are also used to identify indigenous works. A certification mark has been registered in Canada for Cowichan sweaters (“Genuine Cowichan Approved”). A downside of certification marks is that, technically, they cannot be used by their owners, but only by those who have been approved or licensed by the owners.

New Definitions
Both of these avenues remain open to “qualified” indigenous groups to pursue. What will be changed are the more expansive definitions of a trademark and a person. A trademark will be defined as essentially a “sign or combination of signs,” while a “sign” will include (but not necessarily be limited to) a color, a figurative element, or a 3D shape, among other things. This is intended to provide protection for many forms of “nontraditional” marks previously unregistrable under the current Trade-marks Act and Regulations. Further, a “person” will include two or more persons who, by agreement, have the right in Canada to use the mark but only on behalf of both or all of them. This change potentially opens the way for indigenous communities to commercialize and protect many indicia, symbols, or signs for the benefit of their communities.

The Road Ahead
The Act currently does not contain a specific prohibition against any word or device which causes offense to indigenous groups, but rather, it contains a general prohibition against the registration of “any scandalous, obscene or immoral word or device.” This prohibition could be expanded or supplemented to provide greater protection for indigenous groups and their traditional knowledge. As presently worded, it is unclear whether the prohibition could be used successfully to oppose an application for a mark which causes offense, but it would be interesting to watch the progress of such an application.

Data Protection
The provisions of the European Data Protection Regulation (GDPR) and the General Data Protection Regulation (GDPR) do not specifically include personal data protection of indigenous peoples.

UNITED STATES: Sanctions on Iran and Trademark Rights
On May 8, U.S. President Donald Trump announced his decision to cease the United States’ participation in the Joint Comprehensive Plan of Action (JCPOA) in relation to Iran’s nuclear program. He further indicated that the United States would begin to reimpose certain sanctions on Iran that were lifted in order to put the JCPOA into effect.

After reviewing information released by the U.S. Treasury Department’s Office of Foreign Assets Control (OFAC) regarding re-imposed sanctions on Iran, INTA contacted sources at OFAC, the U.S. Department of State, the Office of the U.S. Trade Representative, and the U.S. Patent and Trademark Office to determine whether U.S. persons and entities could continue to protect their trademarks and other intellectual property (IP) rights in Iran.

Upon review, the consensus of those agencies and offices is that the sanctions waiver allowing for protection of IP rights in Iran remains in effect. That provision may be found at Title 31 of the U.S. Code of Federal Regulations, Section 560.509, which reads as follows:

Certain transactions related to patents, trademarks, and copyrights authorized.

b) This section authorizes the payment of fees currently due to the United States Government or the Government of Iran, or of the reasonable and customary fees and charges currently due to attorneys or representatives within the United States or Iran, in connection with the transactions authorized in paragraph (a) of this section, except that payment effected pursuant to the terms of this paragraph may not be made from a blocked account.

c) This section does not authorize any transaction by an entity owned or controlled by a United States person and established or maintained outside the United States otherwise prohibited by § 560.215 if the transaction would be prohibited by any other part of this chapter V if engaged in by a U.S. person or in the United States.

Should INTA receive information regarding re-imposition of U.S. sanctions on Iran that may impact protection of IP rights, it will promptly advise its membership.

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Holland & Knight, Washington, D.C., USA
Vice Chair of the Emerging Issues Committee

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Roberts Mlotkowski Safran & Cole PC, McLean, Virginia, USA
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