INTA Board Approves 2006 – 2009 Strategic Plan

At its March 7 meeting, the INTA Board of Directors unanimously approved the Strategic Plan for 2006 – 2009.

The Strategic Plan outlines the strategic directions and objectives of the Association and will guide the work of the Board, staff, and committees during the planning period. The Plan establishes four general Strategic Directions for the Association – internationalization; policy development and advocacy; education, information and services; and association governance, leadership, membership and participation (for details see side bar on page 2). Each Strategic Direction is supported by a series of Strategic Objectives, which the Association will use to guide its programs, policies, activities and development during the 2006 – 2009 period.

The development of the Strategic Plan began almost a year ago when the 2004 Planning Committee surveyed INTA’s members, staff, committee leadership, and Board to identify the most important issues and goals for the 2006 – 2009 period.

The Plan was approved in early 2005 so that INTA had time to develop the tactical measures for implementing the Strategic Objectives by January 1, 2006. This process is currently underway. The next step, according to Planning Committee Chair Paul Reidl, is for the Planning Committee to recommend a committee and subcommittee structure to the Board at the May meeting. This will be based on proposals being developed by the staff and the group officers for the Policy Development and Advocacy (PDA) and Education Information and Services (EIS) Committee Groups. When this is completed, each Strategic Objective will be the responsibility of one or more committees, and all subcommittee projects will flow directly from Paul Reidl, is for the Planning Committee to recommend a committee and subcommittee structure to the Board at the May meeting.

A Toast to the Asia Pacific Forum

Trademark attorneys attending the March 3 and 4 Asia Pacific Forum on Emerging Issues in Brand Protection had beer on their minds – BLAGBEER that is.

Panelists from the first session on Selecting a Brand used the fictional BLAGBEER mark, from the imaginary Republic of Molvonia, to illustrate the marketing and legal issues that should be considered when selecting a brand. Using witty examples and personal expertise, the panelists managed to open the forum with a stimulating presentation.

More than 200 participants from all over the world attended the Asia Pacific Forum in Singapore, jointly organized by INTA and the Intellectual Property Office of Singapore (IPOS). Co-chaired by Elisabeth Cardoza of IPOS and Jeannie Smith of Baker & McKenzie, this was the first time that INTA had partnered with a local registry in the region and the largest forum held in Asia.

Participants felt that the forum was a success with strong presentations and lively question and answer sessions after each topic. There were many INTA members from the Asia Pacific region, ensuring that the views of everyone in this vast region were discussed. According to Bruce MacPherson, INTA’s director of external relations, members had the opportunity during this event to get together

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Strategic Plan CONTINUED FROM PAGE 1

a Strategic Objective. The committees will then be staffed during the committee selection process that will begin in a few months. (Stay tuned to the INTA Bulletin and the website for more details.)

“Development of the Association's Strategic Plan is one of the most important functions of the INTA Board of Directors, and the new Plan is an essential tool for the Board, staff, and committees to make sure that the Association is moving in the right direction,” says Paul. He adds that in creating the Strategic Plan, the Planning Committee tried to stay focused on strategic or “big picture” directions and objectives. “The Planning Committee thought it best to leave the tactical, or ‘how do we do it’ questions, to the discretion of committees and staff,” he says.

The Planning Committee is comprised of board members Gert-Juergen Frisch, Dana Gilland, Richard Heath, Paul Reidl, Colleen Sarenpa, Rhonda Steele, Scott Thompson, Verena von Bomhard, Dee Ann Weldon-Wilson, Executive Director Alan C. Drewsen and staff liaison Maria Bachman. David Gooder, Heather Steinmeyer, and the former chair, Anne Gundelfinger, were members of the Planning Committee in 2004, and were also instrumental in developing the new Strategic Plan.

The new Strategic Plan can be viewed in its entirety in the Association Plans and Policies section on INTA’s Members Only website, which can be accessed through www.inta.org. Paul urges members to “visit the website to review the Association's new blueprint for the future.”

Dilution Reform Bill Sent to House Floor

On March 9, the Judiciary Committee of the United States House of Representatives sent to the floor of the House H.R. 683, the Trademark Dilution Revision Act. Action by the Judiciary Committee comes after a February 17 hearing before the House Subcommittee on Courts, the Internet and Intellectual Property. INTA President Anne Gundelfinger testified at the hearing in support of the legislation. A full report by Ms. Gundelfinger on the provisions and status of H.R. 683 can be found online at www.inta.org/dilution.html. The House is expected to vote on H.R. 683 in early April or May. INTA is working to secure consideration of companion legislation in the Senate.

By Michael Heltzer, External Relations Manager, INTA

INTA Bulletin Board

INTA Treasurer Scott E. Thompson has joined GlaxoSmithKline in King of Prussia, Pennsylvania, USA.

Alban Kang has been appointed Managing Partner at Alban Tay Mahtani & de Silva in Singapore. Additionally, Sheena Jacob has been promoted to head the Intellectual Property and Technology Group and Sandra Seah has been promoted as partner in the company.

John H. Murphy has joined Arochi, Marroquin & Lindner, S.C., in Mexico City, Mexico.

Michael B. Harlin has been promoted to the board of directors of McAndrews, Held & Malloy, in Chicago, Illinois, USA. Joseph M. Butscher, Ronald A. DiCerbo, Joseph F. Harding and Jennifer E. Lacroix have been promoted to partner.

The “INTA Bulletin Board” announces news of a professional nature about individuals who belong to INTA companies or INTA staff. To submit an item for consideration, send a brief message to bulletin@inta.org.
“on their own turf” to discuss issues of common interest.

Many members from outside of the region also attended the forum, proving that the area that is home to more than half the world’s population has become more important to brand owners throughout the world. Participants from 31 different countries shared thoughts on subjects close to their hearts such as co-branding in Asia, effective border control and the Madrid Protocol. In particular, the Madrid Protocol attracted a great deal of attention as more and more countries prepare to accede to the treaty and the consequences that this entails.

Singapore was an appropriate venue for the forum with its many government initiatives to create and leverage intellectual property rights. Ms. Cardoza said, “For Singapore, IP protection is practically a national priority.”

Participants not only attended presentations, but also had ample opportunities to network. According to Lindsay Esler of Deacons: “One of the attractive things [about the forum] was the number of international participants; it was not just a Singapore conference but a truly international one.”

By Ravi Ravindran, Ravindran Associates, Singapore

Special Thanks to the Asia Pacific Forum Project Team:

Elizabeth V. Cardoza, Co-Chair, Intellectual Property Office of Singapore; Jeannie Smith, Co-Chair, Baker & McKenzie; Lu Lin Chiam, Intellectual Property Office of Singapore; Murgiana Haq, Haq & Selvam; Alban Kang, Alban Tay Mahtani & DeSilva; Jim Kheng Lim, Shook Lin & Bok; Christine F. Lowe, Davies Collison Cave; Jin Nee Wong, Raja, Darryl & Loh

INTA & IPOS wish to thank the supporting organizations of this forum:

The 127th Annual Meeting Preliminary Attendee Portal is now available!

Your link to vital Annual Meeting resources.

Make the most of your time at the Annual Meeting by using the Attendee Portal. The portal includes:

- Attendee List, with name, company and location of attendees
- Speaker lists
- Sessions at a Glance
- Committee Meeting list
- Exhibitors and sponsors (including Exhibition Hall Floor Plan) list
- CLE Information

Go to www.inta.org/sandiego for access to the portal

And don’t forget to check the Final Attendee Portal after April 15 for much more!

- Annual Meeting Final Program
- Course materials
- Enhanced Attendee List, with hotel information and email capability
Anticounterfeiting Proposals in Italy Aimed at the Consumer

For the first time, Italian government officials have proposed fighting counterfeiting by going straight to the consumer who buys the infringing article.

On February 28, 2005, at an anticounterfeiting conference in Milan held by INDICAM (an Italian association against counterfeiting), government officials took a closer look at the problem of counterfeiting in Italy and issued some striking proposals. The Italian Economic Undersecretary Manlio Contento, who has been working with the Vice-Minister for Foreign Commerce Adolfo Urso, presented a proposal to implement a fine of up to 10,000 Euros for anyone who purchases counterfeit goods.

Mr. Contento presented the proposal as a measure that would have a direct impact on the sale of infringing articles sold on the streets, where consumers are aware that they are buying counterfeit goods. Because part of the collected fines would be given to the local government, Mr. Contento noted that it is likely that local officials would be diligent in implementing the provision. As a result, he concluded that Italian citizens, who are unfortunately often indifferent to counterfeiting, would become more aware of the seriousness of these crimes.

Other speakers and participants at the conference pointed out that this proposal would be difficult to implement, and would probably not effect more high-scale counterfeiting, in which counterfeit goods are placed in shops next to legitimate goods, making it difficult for consumers to tell the difference between the two.

In response, Piero Luigi Vigna, the national chief prosecutor of the anti-mafia section, proposed that professional counterfeiters, regardless of whether they belong to the mafia or other crime organizations, who are found to be dealing in counterfeit goods, should have their property seized as a deterrent to the crime. He further stated that undercover agents should be used to infiltrate and gather information from crime organizations who deal in infringing goods. Although these ideas are not new to crime fighting in Italy, they would be new to the country's anticounterfeiting efforts. Conference participants were led to conclude that if, under threat of a fine, people stopped purchasing infringing goods, professional counterfeiters would find counterfeiting less profitable, especially if they also risked losing the property gained through such illegal activity.

By Gabriele Lazzeretti, Societa’ Italiana Brevetti, Florence, Italy

Trademark Owners in India: “Be Aware Of New Tax”

A unanimous decision of the five-judge Constitutional bench of the Supreme Court of India, in Tata Consultancy Services v. State of Andhra Pradesh, published early this year, has sent a shiver throughout the intellectual property and information technology industries in India, triggering a heated debate over the wider ramifications of the decision.

The genesis of the decision was the assessment order by the Commercial Tax Officer, Mr. Hyderabad, who had held that off-the-shelf computer packages fell within the domain of “goods” as defined under the sec. 2(1h) of the Andhra Pradesh Sales Tax Act 1957 and were thus liable to sales tax.

Upholding the decision of the Andhra Pradesh High Court, the five-Judge constitutional bench held that software programs such as Oracle, Lotus and Unigraphics that are sold off the shelf are “goods” for the purposes of sales tax levies by the Indian States.

The Bench held that Intellectual property, once put on to a medium, whether they are cassettes, books or even canvas, becomes “goods” and is in this regard no different from the music or films sold on cassettes or CDs.

The decision may have a significant effect on IP and the IT Industry already operating on thin margins, and possibly compel these industries to pass on the ultimate burden of the proposed sales tax to the end users. This decision, which may negatively impact the costs of off-the-shelf software to legitimate end users, may also unfortunately aid the already burgeoning IP piracy market in India.

Contributor: Ashutosh Mehta, Amritabha Sen & Co., New Delhi, India; Verifier: M.L. Mangla, Advocate, New Delhi, India

TTAB – E-Learning | June 6 – 26, 2005

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ARMENIA

Recent Developments in the Trademark Law

Increasing activity in the intellectual property sphere in Armenia in the past few years has shown that there are still many unanswered questions and gaps in the relevant legislation. These gaps led to the recent adoption of the amendments to the Trademark Law, effective January 7, 2005. The following are the most critical amendments:

- only legal entities, private entrepreneurs or foreign physical persons, engaged in business activities in Armenia may register a trademark and obtain exclusive rights to a trademark;
- unauthorized use of a trademark on the Internet and other global communication networks, including domain names, may amount to trademark infringement;
- should there be no prior authorization given by the original trademark owner, such owner may be in a position to prohibit use and registration of a trademark in the name of its agent and even cancel the relevant registration, if granted;
- slogans, trade dress and packaging design may qualify for legal protection as a trademark;
- a divisional trademark application/registration may be used to maintain trademark rights;
- distinctiveness, acquired as a result of continuous use in Armenia, may serve as a ground for registering a trademark, which otherwise could be refused registration on absolute grounds;
- a special legal regime has been introduced for safeguarding well-known trademarks;
- the non-use grace period has been reduced from five to three years. The burden of proof now lies with the owner of the challenged trademark. A cancellation action has become an administrative proceeding and is considered by the Appeal Board of the Trademark Office;
- Disputes arising from trademark assignments and licensing are settled by the Appeals Board of the Trademark Office and/or the court;

These amendments increase the role of the Armenian Intellectual Property Agency (Trademark Office) in settling disputes, as well as strengthening the protection of the rights of consumers and trademark owners.

Contributor: Oxana Pishvanova, Gowlings International Inc.; Verifier: Hovannes S. Manoukian, Manukian & Partners

ANGLIA

Adoption of the 8th Edition of the Nice Agreement

Angola has adopted the 8th Edition of the International Classification of Goods and Services for the Purpose of Registration of Marks as of January 2, 2005 (34 classes of goods and 8 classes of services).

There will be no re-classification of the trademark applications/registrations filed before January 2, 2005.

Contributor: João Paulo Miotudo; Raul César Ferreira (Herd.), Lda., Lisbon, Portugal; Verifier: Matthew Costard; Spoor & Fisher Jersey, St Helier, Jersey, Channel Islands

PERU

Trademark Office Decisions Go On-line

The Chamber of Intellectual Property of the Appeal Tribunal of INDECOPI – the National Institute of Defense of Competition and Intellectual Property Protection – has made its Resolutions available on its website at www.indecopi.gob.pe. Interested persons may now view the text of decisions issued by the Appeal Tribunal. Resolutions published include recent decisions up to a month old.


BENELUX

Opposition in the Benelux – A Modest Start

Since the beginning of 2004, it has been possible for oppositions to be filed against Benelux trademark applications. The system was initially made available only for applications that include goods in International Classes 2, 20 and/or 27.

During the first year, 27 oppositions were filed, of which 6 were considered not admissible for various reasons (such as oppositions in classes not yet open for opposition; filed beyond the deadline and, in one instance where the opposition form was used for filing a trademark application.). 3.4 percent of the applications in Classes 2, 20 and 27 were oppositions.

Six oppositions are considered completed by withdrawal of either the opposition or the opposed application. No decision has been issued so far – the first one is anticipated in May or June of this year.

Since January 1, 2005, opposition has been open to applications filed in Classes 6, 8, 13, 15, 17, 19 and 21 in addition to the three above-mentioned classes. Owners of marks registered in more popular classes still have to wait until the opposition system is made available for them.

Contributor: Eric Bakker, Bakker & Verkuil, Breda, Netherlands; Verifier: Freyke Bus, CMS Derks Star Busmann, Utrecht, Netherlands
EUROPEAN UNION

Requirements of Distinctiveness in Consequence of Use

The Court of First Instance (CFI) of the European Union (EU) issued two decisions regarding a figurative trademark and a three-dimensional (3D) trademark in related opinions published on November 10, 2004 that refer to the requirements of proof of distinctiveness in consequence of use (acquired distinctiveness) (See Case T-396/02 August Storck v. OHIM [2004] and Case T-402/02 August Storck v. OHIM [2004]).

In both of the underlying cases, the German company August Storck KG (Storck) appealed judgments of the Second Board of Appeal and the Fourth Board of Appeal (Boards) of the Office for Harmonization in the Internal Market (OHIM), denying registration respectively for the shape and the packaging of one of the company's products, Werther's Original, a caramel flavored sweet.

In both cases the respective boards held that the mark at issue was devoid of any inherently distinctive character and had not become distinctive through use, thus preventing registration as a trademark.

Storck sought registration of the three-dimensional shape for its caramel flavored confectionery, claiming that the shape together with the light-brown color allow it to be distinguished from the sweets of other companies. The CFI, however, upheld the board's decision, noting that the board correctly found that in a mass consumer product, such as sweets, the average consumer would not pay much attention to the shape and color of the product, and that both the shape and the color in this case are common for sweets.

Similarly, the CFI upheld the board's judgment that Storck had failed to adequately prove acquired distinctiveness. The CFI noted in this respect that it must be shown that a significant proportion of the relevant section of the public identifies the product as originating from a particular undertaking of the trademark, which cannot be shown to exist solely by reference to general, abstract data, such as percentages. Furthermore, the acquired distinctiveness must be demonstrated in a region of the EU where the trademark was devoid of any distinctiveness. Additionally, factors like the market share, the intensive use and statements of chambers of commerce and trade association have to be taken into account.

However, the CFI stated that the turnover figures submitted by Storck did not permit a determination of market share, the submitted advertising costs were not specifically attributable to promotion of the shape of the sweet, and the submitted consumer surveys contained no reference to the shape of the sweet but focused only on the name.

Storck also sought registration for the shape and color of the wrapper for its Werther’s Original sweet. The CFI upheld OHIM’s denial of registration for the same reasons as discussed above, i.e., lack of distinctive character and insufficient proof of acquired distinctiveness. The CFI based its conclusions on inherent and acquired distinctiveness of the shape and color of the wrapper on similar reasoning as that for the shape and color of the sweet itself.

Source: Dr. Martin Tongbohaye, Patentattorneys Freischem; Verifier: Dr. Roberto Kunz-Hallstein, Law Office of Dr. Kunz-Hallstein

IRAN

NOKIAN held to be confusingly similar to NOKIA

In a decision published on February 28, 2005, the Appellate Court upheld the decision of the First Instance Court, holding that the marks NOKIA and NOKIAN are confusingly similar and would confuse average consumers.

Mr. Kazem Rahimzadeh filed an application to register NOKIAN in Farsi covering goods in International Class 12 in Iran. Nokia Corporation filed an opposition against the application claiming that NOKIAN is confusingly similar to its NOKIA mark registered in Classes 9 and 35 in Iran. To strengthen its opposition, Nokia also filed a new application for NOKIA as applied to goods in Class 12.

NOKIA claimed that the trademark NOKIA is famous and that use of NOKIAN by the applicant will mislead consumers as to the source of goods. Nokia also provided the court with the letterhead and brochures of the Iranian applicant bearing the mark NOKIAN in Latin (not Farsi) as evidence of the likelihood of confusion to consumers.

The applicant argued that the mark NOKIAN is in Farsi script and additionally has its own meaning in Farsi and therefore is not similar in meaning or appearance to the mark NOKIA. Mr. Rahimzadeh further argued that NOKIA covers goods in Classes 9 and 35 while his application covers goods in Class 12 and consumers have sufficient knowledge so as not to be misled or confused by use of the trademarks for goods in Classes 9 and 12.

The court ruled for the cancellation of the NOKIAN application, finding misleading similarities between the NOKIA and NOKIAN marks, based both on prior Iranian and worldwide registrations and use of the mark NOKIA by Nokia Corporation. The judge held that the mark NOKIAN imitates the famous mark NOKIA as shown on the NOKIAN letterhead and brochures.

The Appellate court affirmed the judgement.

Contributor: Mohammad Badamchi, HAMI Legal Services, Inc., Tehran, Iran; Verifier: Houman F. Matin, Cabinet Abad, Tehran, Iran

Representing the Trademark Community since 1878
The South Korean Intellectual Property Office (KIPO) recently amended certain Trademark Examination Guidelines and Directives, effective as of January 1, 2005. Improvements have been made by recognizing partial priority, enhancing examination of foreign language trademarks and expediting opposition procedures.

Recognition of partial priority
In the past, the KIPO would reject an entire application rather than recognizing separate priority for each designated good. Thus, if the designated goods of a South Korean trademark application (claiming priority) fell outside of the scope of the designated goods of the application upon which the priority was based, this would result in the wholesale rejection of the application. However, this has now been changed, so that KIPO will reject the priority claim on a goods-by-goods basis. Further, provisions allowing applications to claim multiple priorities have also been added to the guidelines.

Improved examination of foreign language trademarks
When examining a mark for distinctiveness or similarity with a senior mark, a mark composed wholly or partially of English alphabets, Chinese characters or Japanese (Hiragana and Katakana) characters must be examined while considering the pronunciation and meaning in the foreign language.

Expedited opposition procedures
Previously, oppositions required about 10 months before a decision. However, the amended Examination Guidelines require that an opposition decision be issued within two months after the opposition response deadline. Thus, future trademark opposition decisions are expected to be issued within three to four months of filing.

Other changes
• Where applications for identical/similar trademarks are filed on the same day, the KIPO examiner will select the application entitled to the application date through a lottery (even if the applicants fail to attend the lottery).

• The three-month exclusive application period following a successful non-use cancellation action now also applies to the following applications for identical/similar marks (i.e., to the canceled mark), in addition to those filed by the cancellation action petitioner: (i) those transferred to the petitioner from a third party who filed its application during the same three-month period; and (ii) those transferred to a third party from the petitioner.

• Other provisions governing the examination of “Madrid” applications, divisional applications, conversion applications, goods-addition applications, renewal applications, business emblem/collective mark applications, etc., have also been added to the Guidelines, and will be enforced on July 1, 2005.

Contributor: Jay J. Kim, Kim & Chang
Verifier: Joong-hyo Kim, Choice Kim International Property Law

QATAR

Documents Certification Simplified
Pursuant to a new directive, the Qatari Trademark Registrar announced that a copy of the commercial register or certificate of incorporation setting out details of an applicant no longer needs to be legalized by the Qatari Consulate. Accordingly, only a simple copy of the commercial registrar or certificate of incorporation is now required at the time of filing a trademark application. However, the Power of Attorney must still be legalized by the Qatari Consulate.

Contributor: Hamad Al Mehairi, Emirates Advocates, Dubai, United Arab Emirates
Verifier: Rajesh Babu; Gulf Institute for International Law, Dubai, United Arab Emirates
Mark Your Calendars

April 11 – 22, 2005
Roundtables: Preventing the Sale of Counterfeit Goods and Other Trademark Infringements on Internet Auction Sites
Various U.S. Cities

May 14 – 18, 2005
127th Annual Meeting, San Diego, California, USA

June 6 – 26, 2005
TTAB – An E-Learning Program

June 13 – 24, 2005
Roundtable: Prosecution Tips for Trademark Administrators and Paralegals
Various U.S. Cities

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To inquire about sponsorship or exhibition opportunities for INTA's events, visit www.inta.org/sponsor.

Although every effort has been made to verify the accuracy of items carried in this newsletter, readers are urged to check independently on matters of specific concern or interest. The INTA Bulletin primarily relies on members of the INTA Bulletin Committee and INTA staff for content but also accepts submissions from others. The INTA Bulletin Editorial Board reserves the right to make, in its sole discretion, editorial changes to any item offered to it for publication.

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