Association News

INTA Participates in Celebration of Mexico’s Entrance to Madrid System

The Mexican Institute for Industrial Property celebrated the country’s accession to the Madrid Protocol on February 19. From left, IMPI General Director Miguel Margain, Mexican Undersecretary of Competitiveness and Standardization Rocio Ruiz Chavez and WIPO General Director of Trademarks and Design Binying Wang.

In recognition of its role supporting the Mexican government’s efforts to join the Madrid Protocol, INTA was invited to participate in an official ceremony on February 19, 2013, to commemorate Mexico’s entrance to the Madrid Protocol. Pan Bimbo became the first Mexican trademark owner to file for extension of protection—in nearly 50 new jurisdictions—using the system.

High-level authorities Rocio Ruiz Chavez, Undersecretary of Competitiveness and Standardization at the Secretariat of Economy, and Miguel Margain, General Director of the Mexican Institute of Industrial Property (IMPI) observed that the Madrid Protocol is an important tool for the growth of the Mexican economy.

INTA applauds the leadership of the Indian government in ensuring that India has the tools and resources necessary to continue its growing importance in international commerce.

Association News

India Joins Madrid Protocol

After several years of consideration through the legislative and executive approval process, India deposited its instrument of accession to the Madrid Protocol for the International Registrations of Marks with the World Intellectual Property Organization on April 8, 2013.

The Madrid System facilitates the international filing of trademark applications and trademark registration renewal in almost 90 countries plus the 27 members of the European Union’s Community Trade Mark System. The benefits to trademark owners include one language (English, French or Spanish), one set of fees and cost efficiencies. Indian and international companies will begin to reap these benefits when the Trade Marks Registry within the Indian IP Office begins accepting Madrid applications on July 8, 2013.

Efforts to have India join the Madrid Protocol began to accelerate in 2007, when the Indian Parliament first considered legislation enabling India’s accession; it passed in 2010. INTA played a significant role in supporting India’s membership in Madrid through organizing, in partnership with the Confederation of Indian Industries (CII), the first major forum on the benefits of and process for obtaining an international registration through the Madrid System, in 2008. Advocacy efforts included meetings between key government officials and INTA members in India, as well as with special delegations led by INTA corporate members.

In preparation for joining the Protocol, the Indian IP Office has accelerated its efforts in electronic filing and streamlining procedures. The final implementing regulations for accepting Madrid applications are now in place.

INTA applauds the leadership of the Indian government in ensuring that India has the tools and resources necessary to continue its growing importance in international commerce.

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Association News
because it supports Mexican entrepreneurs and facilitates the export of products to foreign markets. Binying Wang, General Director of Trademarks and Design at WIPO, said that IMPI ranked as one of the top trademark offices in the world.

The ceremony was followed by a series of seminars in Mexico City, Guadalajara and Monterrey sponsored jointly by authorities from the Secretariat of Economy, IMPI and WIPO. Panelists representing different roles and perspectives discussed the opportunities and challenges of using the Madrid System.

Speaking on INTA’s behalf at the seminar in Mexico City was Laura Cruz, External Relations Manager for Latin America. Ms. Cruz commended Mexican authorities, particularly IMPI, for their efforts in preparing for Madrid accession through consultations, the legislative process and the development of regulations and guidelines. She pledged that INTA would continue to work with the Mexican government throughout the implementation phase.

Ms. Cruz emphasized the Protocol’s significance for trademark owners, noting that it harmonizes and streamlines trademark registration procedures and substantially cuts costs. Attendees also heard about INTA’s mission to represent international trademark owners, and Association members in attendance were invited to get involved with the work of relevant policy subcommittees, including the Trademark Office Practices—Madrid System Subcommittee, the Harmonization of Trademark Law and Practice—International Classification Subcommittee, and the Enforcement—Opposition & Cancellations Standards & Procedures Subcommittee, among others. In addition, the Practitioner’s Guide to the Madrid Agreement and Madrid Protocol, prepared and maintained by the Publications Committee, was presented as a useful online benefit, particularly for members in regions where the Madrid System is expanding.

Changes to IMPI Regulations and Procedures
Consultations leading to Mexico’s entrance to the Madrid System generated substantial debate as to the need to introduce new administrative, regulatory or even legislative changes to Mexico’s trademark laws in order to harmonize internal proceedings to comply with requirements under Madrid. Some of these concerns related to Mexico’s entering Madrid without first introducing an opposition system, which would have required substantive amendments to Mexico’s IP law.

Ultimately, IMPI introduced new implementing regulations without making changes to legislation. At the seminars, IMPI Deputy Director General Alfredo Rendon and Director, Trademark Divisions, Eliseo Montiel discussed IMPI’s new application requirements and office procedures.

How Accession to Madrid Affects the Practice of Trademark Law
The seminars included presentations from attorneys in the EU and the United States, who discussed how their trademark practice changed when their jurisdictions joined the Madrid Protocol.

Giulio Martellini (IP Skill, Italy), member of the Madrid System Subcommittee of INTA’s Trademark Office Practices Committee, explained that the trademark scenario in the European Union is rather complex given the European Union itself is a Madrid Protocol member, as are all Member States of the Union (with the exception of Malta). Thus, applicants seeking trademark protection in EU countries may get coverage in one of three ways: via individual national registrations; via a single registration through the Madrid System; or via a Community Trade Mark (CTM) registration, covering the entire EU.

Mr. Martellini said this added complexity is advantageous for trademark applicants, as they are provided with a number of different tools to obtain trademark protection in the EU territory and can customize their filing strategies as necessary in each case. It also has a remarkable impact on the trademark profession overall in the European Union, since a substantial amount of legal analysis needs to be conducted at a preliminary stage, when such filing strategies are being developed.

Mexican trademark owners now enjoy benefits similar to those of their European counterparts and will benefit from the additional registration route offered by Madrid. However, in order to take full advantage of these new options, increased attention to strategy at the preliminary stage is advisable.

Speaking from the U.S. perspective, former INTA Board of Directors member Frances Jagla (Lane Powell, USA) advised that Madrid filings designating Mexico would increase the need for the expertise of local counsel, who will be needed to help respond to rejections based on goods and services designations as well as perceived similarities to third-party marks. In addition, it is anticipated that the number of cancellation actions in Mexico will increase and that oppositions—when they become available—will be plentiful.

Ms. Jagla also shared strategies on how and when best to use the System. She explained, for example, that if there is a strong mark and there is no possible opposition, the Madrid System is the easiest and least expensive way to obtain protection.

Recent Madrid Expansion in Other Countries
When Mexico began accepting trademark applications under the Madrid Protocol on February 19, 2013, the international registration system became available in a total of 89 contracting jurisdictions. Other countries recently joining or announcing their accession include Colombia, India, New Zealand and the Philippines. It is expected that Brazil may be next in line, as Brazil’s Foreign Trade Chamber, CAMEX, approved accession in early April. The proposal was sent to the Executive Branch and will be debated by Congress.

This wave of accessions to Madrid has been referred to by WIPO officials as the Third Generation Expansion, and is particularly notable in that emerging economies make up many of the new member countries.

For more information, visit the Madrid in Latin America page in the Policy and Advocacy section of www.inta.org.
INTA Boosts Advocacy Efforts in Asia

In March, INTA officers, member representatives and staff conducted three weeks of policy advocacy throughout Asia. Although the delegation visited a diverse set of jurisdictions facing varying levels of development and sophistication on IP matters, the response from governments, associations and INTA members was overwhelmingly positive. This enthusiasm will feed well into the build up to the 2014 Hong Kong Annual Meeting—INTA’s first in Asia—as well as future policy activity in the region.

Combating Counterfeits in Thailand

The tour began with the Combating Counterfeiting in Thailand policy roundtable organized by the Anticounterfeiting Committee (ACC) East Asia & Pacific Subcommittee. The roundtable was co-hosted by the Thailand Department of Intellectual Property (DIP) and attended by Pajchima Tanasanti, the Director General of the DIP. Also attending the roundtable was Sirasak Tiyapan, the Director General of the Department of IP and International Trade Litigation of the Office of the Attorney General.

The more than 40 participants included seven officers from the DIP, three officers from the Attorney General’s Office, two officers from the Economic and Crime Division and representatives from the Department of Special Investigation, Customs Department, U.S. Embassy and the Japan External Trade Organization (JETRO). Representatives of more than 25 INTA member firms and companies attended the event. Government and industry participants commented on the challenges faced in anticycounterfeiting and provided constructive proposals for dealing with the problem, such as providing more training and education for police and Customs, increasing public awareness and strengthening legislation.

Tilleke & Gibbins hosted the roundtable at their office and provided lunch and refreshments.

Engaging with Korean Brand Owners

The delegation also visited Seoul, South Korea. Led by INTA President Toe Su Aung (BATMark, UK), the delegation met with leaders from the Korean Patent Attorney Association (KPAA) and with the former Director General of the Korean Trademark & Design Office, HJ Kwon.

Ms. Aung introduced the Association’s work and related the most recent policy activity in the region and globally. These include INTA’s comments on the China trademark law revision earlier in the year, as well as comments on the Thailand trademark law revision and on plain packaging issues in Australia and New Zealand.

KIPO will be hosting a booth at the Annual Meeting in Dallas, where KIPO will be able to communicate with a larger INTA audience.

The following day, Ms. Aung delivered a talk at the Korean Intellectual Property Association’s trademark breakfast meeting covering global policy issues and practical tips on how to manage a complex trademark portfolio, including how INTA membership and Annual Meeting attendance help facilitate one’s brand management work. The Korean brand owners present expressed their desire to continue the conversation—an indication that INTA educational programming and further outreach in Korea are welcomed.

Indonesia Considers Madrid and Hague Agreement

In Indonesia, Ms. Aung was joined by representatives of several other INTA corporate members, including Louis Chan (Procter & Gamble, Singapore) and Charles Hoskin (Unilever, China), with support from Indonesia-based INTA volunteers Gunawan Suryomurcito and Nick Redfearn (both of Rouse & Co.). The delegation visited the Supreme Court and met with a justice, as well as a lower court judge from the Commercial Court, to discuss improvements INTA members have seen in the IP-related judgments coming from the Supreme Court and Commercial Court.

The INTA delegation headed to the ASEAN Secretariat, based in Jakarta, to discuss the recent achievements and work of the ASEAN Working Group on IP Coordination (AWGIPC).
which has been a significant force in supporting Madrid Protocol accession across the region in time for the formation of the ASEAN Economic Community in 2015. In addition to Madrid, the AWGIPC is working on having member states join the Hague Agreement on Designs. INTA offered its support for these and future initiatives by ASEAN to further integrate and harmonize trademark laws in member states.

The following day, INTA’s delegation visited the IP Office and met with officials from the Trademark Office (TMO). The TMO is currently busy digitizing records and overall improving the state of trademark prosecution. The INTA delegation offered the TMO access to its many educational resources, such as the Model Examination Guidelines.

The IPO is also home to a dedicated IP infringement enforcement department, called PPNS.

Officials from PPNS were keen to hear from INTA brand owners and look forward to future cooperation between PPNS and INTA in areas such as training, education and communication.

A New IP Hub for Asia
Ms. Aung and INTA staff member Seth Hays flew to Singapore on April 4 to meet with the head of the IP Office of Singapore (IPOS), Tan Yih San. The previous week, Singapore had released its plans to make the city an IP Hub, which include providing tax deductions for IP activities, conducting extensive research and developing best practices on IP valuation methodologies, and generally improving the country’s IP regime to meet international standards. Mr. Tan was keen to seek INTA’s involvement and participation in the project.

Shaping Trademark Law in Myanmar
The policy tour ended in Yangon, Myanmar, for the ASEAN IP Association Annual General Meeting. Ms. Aung delivered a speech on the need for further integration of ASEAN countries on IP matters, with respect to both legal developments and enforcement.

The INTA delegation also conducted a meeting with officials from the Myanmar Ministry of Science and Technology (MOST) charged with drafting the first trademark law. Following a November 2012 roundtable, INTA had submitted comments to MOST on the latest draft, and the officials welcomed further comment from INTA on subsequent revisions next month. Officials hoped to see a fully implemented law by the end of the year, if not sooner.

For further information on INTA’s policy activity in Asia, please contact Seth Hays, External Relations Manager, Asia-Pacific, at shays@inta.org.

China Delegation Engages Government on Counterfeiting, Changes to Trademark Law

A series of meetings, roundtables and member receptions to discuss pressing trademark issues in China was held in Beijing and Shanghai, China in March. The INTA delegation was led by Alan C. Drewsen, INTA Executive Director, and included Susan Crane (Wyndham Worldwide, USA), John Motley (Columbia Sportswear, USA), David Butler (GlaxoSmithKline, USA) and Charles Hoskin (Columbia Sportswear, USA), David Butler (Wyndham Worldwide, USA), John Motley (Columbia Sportswear, USA), Charles Hoskin (GlaxoSmithKline, USA) and Susan Crane (Wyndham Worldwide, USA).

The delegation organized government meetings and forums to discuss key topics such as the China Trademark Law revision, bad-faith registrations, anticounterfeiting enforcement and online counterfeiting. The delegation met with the following Chinese governmental bodies: State Administration for Industry and Commerce (SAIC), China Trademark Association, China Trademark Office, Trademark Review & Adjudication Board, Supreme People’s Court IP Tribunal, General Administration of Customs, Shanghai Administration for Industry and Commerce, and the Ministry of Commerce.

INTA organized three roundtables during the delegation’s visit to further explore key issues. On March 26, INTA’s Anticounterfeiting Committee (ACC) China Subcommittee organized a roundtable discussion about online counterfeiting in China. The roundtable was conducted in a discussion format with two ACC member representatives, Joseph Simone (Simone IP Services, Hong Kong) and George Chan (Rouse, China). The discussion focused on what issues brand owners were facing with online counterfeiting in China and began drawing ideas on how to address the topic. Participants highlighted that more effective practices and collaboration between trademark owners and marketplace and auction sites—as well as with enforcement authorities on identifying, taking down and tracking counterfeit merchandise and the sellers of counterfeits—were needed to better address the problem in China.

On the same day, INTA’s Trademark Office Practices Committee China Subcommittee organized a policy roundtable on the revisions to the China Trademark Law and the impact the revisions will have on trademark registration, examination and enforcement. The new law will simplify the opposition procedure, allow for registration of sound and color marks and provide opportunities for amending applications, among other changes. Guest speakers included Senior Judge Wang Yangfang from the IP Tribunal of the Supreme Court, Chief Judge Cui Xuefeng from the IP Tribunal of Beijing No. 1 Intermediate People’s Court and Dean Qu Sanqiang from Beijing Institute of Technology School of Law.

Finally, a March 29 INTA China Customs Roundtable held in Shanghai marked the first roundtable held under the Memorandum of Cooperation between INTA and the China General Administration of Customs (GAC). The roundtable provided an opportunity for high-level engagement with senior officials, such as Chen Xudong, Director General of the Policy & Regulation Department of the GAC, as well as sharing of information with China Customs officials from provinces including Shanghai, Ningbo and Xiamen. INTA volunteer Katie Feng (Hogan Lovells, China) provided remarks and moderated the discussion session.

In addition to meetings and roundtables, for the purposes of celebrating the 10th anniversary of the establishment of INTA’s China Office and promoting INTA’s Annual Meetings, the INTA delegation hosted two well-attended cocktail receptions in Beijing and Shanghai, which more than 200 members and colleagues from the IP community attended. INTA thanks two active members in China—UNITALEN Attorneys at Law and Shanghai Patent & Trademark Law Office LLP—for sponsoring the Beijing and Shanghai receptions.
On March 27, the European Commission unveiled its legislative package containing the highly anticipated proposed revisions for the Community Trade Mark Regulation (CTMR), which governs the Office for Harmonization in the Internal Market (OHIM) and the Community Trade Mark (CTM), and the Trade Marks Directive (TMD), which provides guidance for EU member states’ trademark laws.

The proposals resulted from the Commission’s extensive evaluation of the European Union trademark system, including a study by the Max Planck Institute for Intellectual Property and Competition Law, an economic analysis by INNO-tec and consultations with users and other stakeholders, with the aim of upgrading, streamlining and modernizing the current legislation.

The Commission’s overarching goals are: (1) to improve accessibility and efficiency by lowering costs and creating greater predictability; and (2) to ensure improved cooperation between OHIM and the national offices.

The proposals include provisions to rename OHIM and the CTM the “European Union Trade Marks and Designs Agency” and “European Trade Mark,” respectively. The recast CTMR also enhances the functions of OHIM’s Administrative Board (now to be called the “Management Board”), aligns selection procedures for senior officials, provides for annual and multiannual work programs, addresses OHIM’s responsibility for the Observatory on the Infringements of Intellectual Property Rights, and formalizes OHIM’s coordination with EU national offices.

The draft legislation includes a groundbreaking new provision that will allow EU trademark owners to prevent third parties from bringing into the Union goods bearing marks that are “essentially identical” to an EU registered mark. Following Nokia, this is a surprising but welcome legislative improvement for trademark owners, as it would substantially strengthen their position in combating counterfeiting.

The TMD and CTMR proposals also aim to align offices’ fee structures by making registrations and renewals subject to payment of additional class fees for each class of goods and services beyond the first. They also delete the requirement that trademarks must be capable of being graphically represented.

The co-legislative process is already underway, as the proposals were officially introduced to the Council of the European Union’s IP working group on April 10. The European Parliament may be voting in plenary as soon as spring 2014.

INTA’s policy committees are closely reviewing the drafts and are developing views on the various proposals, to be presented and discussed with policy-makers shortly.

INTA Annual Meeting attendees shouldn’t miss a discussion of the proposals in the session “Regional Update: What’s New at OHIM and the CJEU? An Update on European Union Trademark Law,” on Tuesday May 7, from 10:15 am to 11:30 am in Dallas Convention Center Ballroom D 3-4.
VolunteerSpotlight

Virginia (“Ginger”) Smith is a Paralegal Specialist at Exxon Mobil Corporation. Her first IP job was with a boutique IP firm in Dallas, Texas, USA, where she worked on patent litigation and trademark searches. Ginger quickly realized she enjoyed trademarks much more than patents. She joined the trademark group of (then) Exxon Corporation 21 years ago and hasn’t looked back.

Ginger has been involved with INTA since the early 1990s. She has served on several committees, including the Publications, Membership, Programs and In-House Practitioners Committees; currently she is chair of the Trademark Administrators Committee and a member of the INTA Board of Directors. Ginger believes that her INTA involvement has helped sharpen her collaborative and communications skills and increased her awareness of issues in trademark law generally. INTA provides her a venue to meet with outside counsel and other in-house practitioners to work on or to resolve substantive matters. Through INTA, Ginger has developed lasting friendships and invaluable relationships with colleagues; for almost any type of question, she knows help is just a phone call away. Her colleagues probably do not realize that she is a partner and head of the intellectual property law department at Low Murchison Radnoff LLP in Canada’s capital, Ottawa, where she specializes in IP law, with a strong emphasis on trademark law. Having obtained an LLB from the University of Windsor in Ontario and been admitted to practice in Canada in 1997, Ginger has been fascinated with the trademark field from the very beginning of her career, and has assisted local and international clients in matters such as clearance, prosecution and enforcement of trademarks, and also in handling acquisition, branding and labeling issues.

Anticounterfeiting and licensing matters are also part of her practice. Wendy has served on INTA’s Anticounterfeiting Committee as a member of the North America Subcommittee, and previously was on the China Subcommittee. Recently she rejoined the International Amicus Committee’s Canada Amicus Subcommittee. “I have enjoyed my time with all of my committees,” Wendy says, “but the role I have enjoyed the most was my participation on behalf of INTA in a Supreme Court of Canada case.” INTA’s intervention was cited in that case dealing with the protection of famous marks, Veuve Clicquot Ponsardin v. Boutiques Clicquot Ltée.

When asked about her INTA experience as a whole, Wendy confesses, “I know of no other venue that gives you the opportunity to meet so many different people from all over the world... and feel fortunate that numerous friendships have developed over the years I’ve been an INTA member.” Noting that trademark practice has changed extensively over the years, she says, “I expect that this will continue to be so in the future; fortunately, I have always enjoyed change and new challenges...and definitely INTA will continue to be a leading voice for brand owners and practitioners to ensure that we have the tools necessary to continue expanding trademark knowledge and protection.”

Wendy has no particular all-time-favorite mark, but enjoys marks that bring a smile to her face, whether it is from nostalgia or from humor. She reflects on her past as a trademark examiner and all the interesting marks she has come across.

Like many other INTA volunteers, Wendy combines her professional career with family life: “With three kids, Conor, Kiera and Declan, all playing hockey, you cannot help but be involved! I recently started playing outdoor hockey myself, joining a women’s pickup hockey league. Now my kids can coach me from the stands.” In her free time, Wendy enjoys taking the kids on trips with her husband (she is usually drawn to the water, and feels the need to try dragon boat racing this spring.

Frank Hiscox
Lewis and Roca LLP, Mountain View, California, USA
INTA Bulletin Association News Subcommittee
Committee Spotlight: Leadership Development Committee

In an association of over 6,000 organizational members, it’s easy to get lost in the mix. The Leadership Development Committee reaches out to INTA volunteers at large, including employees of new member companies, first-time meeting attendees and young practitioners. The Committee’s members don’t just want to shake your hand and get your card; they want to assist you in getting to know other volunteers and becoming involved with committee work and leadership opportunities. The Committee realizes good leaders are hugely important in keeping INTA on track, so it strives to provide insight and assistance to those who desire to become leaders. The Committee’s members are rewarded by helping members at large find a comfort zone within the organization, and as a bonus, they continue to make good friends along the way.

Interesting projects keep this Committee very active. The Leadership Academy is an ongoing project that the Committee seeks to improve every year. Held at the Leadership Meeting, this program provides an opportunity for all INTA committee members to gain valuable information and work on their leadership skills. Last year’s Leadership Academy was attended by more than 300 INTA committee volunteers, who heard featured keynote speaker Robert D. Scott of the University of Michigan speak on “Working Globally: Enhancing Remote Team Effectiveness.” Mike Maoz (General Electric, USA) led the Leadership Academy project team.

The Committee also comprises four other project teams. The E-Learning/Webinar Project Team, led by Phil Cox (Global Law Marketing, USA), creates e-learning sessions specific to leadership skills and to attaining leadership roles within INTA. In 2012, the team presented webinars on “The Nuts and Bolts of Committee Work” and “Advocating Effectively Within INTA.” The Leadership Programming Project Team, led by Kevin McDevitt (Neal & McDevitt, USA), develops content for leadership programs at venues other than the Leadership Academy; it will be presenting a session at the 2013 Annual Meeting titled “How a Leadership Role Can Define Your INTA Career Path.”

The Committee Transition Project Team, led by Dolores Moro (Kimberly-Clark Corporation, USA), recommends and develops resources, including the Committee Transition Roadmap, to aid in effective committee leadership transition. The Marketing and Communications Project Team, led by Iris Quadrio (Marval, O’Farrell & Mairal, Argentina), develops marketing content for all Leadership Development Committee programs.

Chair Susan Brady Blasco (Birch, Stewart, Kolasch & Birch LLP, USA) and Vice Chair Rudy Gaines (Marksmen, USA) lead the Committee, with assistance from INTA staff liaison Ryan O’Donnell. The Committee members are a diverse group: former actors, musicians, writers, belly dancers, and heads of law firms and companies. They have strong opinions and great ideas, and the combination of talent and experience makes for a vibrant and productive team. The members’ enthusiasm and excitement about what they are doing make participation in the Leadership Development Committee immensely rewarding and fun.

Jennifer K. Ziegler
Ann Arbor, Michigan, USA
INTA Bulletin Association News Subcommittee

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In March 2013, INTA’s In-House Practitioners Committee hosted two Idea Exchange sessions on the topic of department structure and managing workflow.

Participants in these teleconferences came from a cross-section of INTA’s corporate membership in different countries and across a wide range of industries. This article is not meant to identify the views of any particular individual, company or industry but instead is a general aggregate of the issues raised and the views expressed in the idea exchange.

With the plethora of business models used by companies today, the in-house trademark department can take many forms and have traditional (and often nontraditional) roles in advising the business client. Understanding how to best structure and utilize the team, as well as other available resources, can increase the team’s productivity and help avoid pitfalls.

In-House Practitioner Idea Exchange: Department Structure and Managing Workflow

Dori Hummel
General Mills, Inc., Minneapolis, Minnesota, USA

In-House Practitioners Committee

In March 2013, INTA’s In-House Practitioners Committee hosted two Idea Exchange sessions on the topic of department structure and managing workflow.

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With the plethora of business models used by companies today, the in-house trademark department can take many forms and have traditional (and often nontraditional) roles in advising the business client. Understanding how to best structure and utilize the team, as well as other available resources, can increase the team’s productivity and help avoid pitfalls.

In-House Department Structure

The session participants’ portfolios ranged between 600 and 20,000 marks. Therefore, it is expected that the work is performed and managed in many different ways. Most participants worked in teams of attorneys, paralegals and administrative assistants, with some also including docketing clerks. A few companies had access to a pool of paralegals who could help out when needed.

Attorneys often had responsibilities outside of trademark prosecution and enforcement, such as patents, copyrights, social media, domain names, agreements and anticonteighting. The paralegals’ responsibilities centered on trademark search and clearance, prosecution, and management of international outside counsel.

The allocation of responsibilities was also diverse. Some of the participants had tested various alignments before settling on the one that worked best for them. There were trademark teams where the attorneys were responsible for different brands/clients and their respective paralegals were responsible for certain geographic regions. Others were just the opposite, with paralegals responsible for different brands/clients and the attorney responsible for regions. One company had the paralegals divided by brand/clients in Canada and the United States and by regions for the rest of the world. It may be worth experimenting to determine the best alignment of work for each company.

How Trademark Work Is Performed or Managed In-House

Trademark Searches
Searching and clearance is an important and large part of the in-house trademark team’s responsibilities. The preliminary searches ranged from simple knock-out searches to very in-depth search strategies utilizing several sources. It was common among the participants to have the paralegals conduct the search, provide an opinion to the attorney and then advise the client of the search results. When a full search was necessary, it was either ordered from a vendor and reviewed by the attorney or outsourced to outside counsel for review and analysis. International searches typically were conducted by outside counsel, then reviewed and summarized by the paralegals for the clients.

There were different methods used to report search results to clients. Some companies used forms, some preferred telephone contact (especially for bad news), some gave a lot of data up front to prevent back-and-forth emails, and others (mindful that there might be future litigation) gave little detail for litigation purposes. A few companies used a ranking system of red (not available), yellow (some risk) and green (available).

See “In-House” on page 10

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In-House Practitioner Idea Exchange  Continued from page 9

One question posed concerned managing clients’ expectations, especially with descriptive marks. The recommendation was to avoid putting advice in writing, but instead to talk to clients about the balance between marketing communication and protection. It was strongly suggested that the in-house staff not foster any expectation that a descriptive mark can be protected. One company regularly used the term “arguably descriptive”; another advised its clients that a competitor could use the same mark and there would be no way to stop them. Training clients to pick stronger marks is a good practice; although it may be time-consuming, there will be a great benefit in the end.

During one of the idea exchange sessions, participants addressed the subject of how much time they allowed for preliminary and full searches. The time to conduct and render an opinion on preliminary searches ranged from 24 hours to one week. The time range for full-search review and opinion ranged from 5–7 business days to three weeks.

Prosecution

The consensus was that U.S. prosecution is best handled in-house. In-house personnel know their company’s products best, so they can prosecute applications faster and more cost-effectively. Paralegals can work with clients to obtain first use dates and specimens and can draft goods/services descriptions for applications. They also can do the research for maintenance and renewal filings.

Every company has its own comfort level regarding the authority to sign documents. Many stated that the attorney of record with the U.S. Patent and Trademark Office (USPTO) signed all of the trademark office filings. International trademark filings normally were signed by outside counsel with power of attorney authority. Several of the participant attorneys were able to sign the power of attorney forms for their foreign counsel. Other companies required an officer to sign the power of attorney forms. Major dispute documents often required signature by division management or a corporate officer.

Portfolio Management

Several of the session participants review their portfolios on a 12–18-month basis. They reach out to their business contacts to review upcoming renewals, new territories and/or new products for existing brands. It is important to have a good relationship with clients to know what is important to their specific businesses. It is better to be proactive than reactive to trademark protection. One participant informed upper management that distributors were filing international trademark applications and then holding the company hostage for more business. Such practices provide good incentive to ensure major brands are protected before a business enters a country.

Some participants managed portfolios on an ad hoc basis depending on their different business styles. Auditing the actual files on a regular basis is beneficial in many ways, but it is especially valuable in the event of a sudden sale of a brand. This could avoid a rush to update records that have not been kept up to date.

INTA 2013 Calendar of Events

Plan your calendar with these INTA events and stay up to date on issues that affect your trademarks—domestically, regionally and globally.

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<td>July 8–19</td>
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Learn more about INTA events, including international roundtables, networking receptions, E-Learning, academic competitions and more, at www.inta.org/programs

Dates and topics subject to change. Contact meetings@inta.org for the latest information.
Database Management/Docketing

There are a number of helpful docketing tools available to help maintain trademark records and handle the docketing of important dates. Database management and docketing can be handled either by outside counsel or, increasingly, by the in-house staff. During one session, there was a discussion on when to bring docketing in-house. Most companies found that in-house docketing was more cost-effective, even if they needed to add a paralegal or docketing clerk. A couple of participants continued to rely on outside counsel for their docket management.

Overall, attorneys left the docketing to either a docketing clerk or paralegals. When possible, move the docketing to a clerk or administrative assistant to free the paralegals for their primary responsibilities. Most attorneys preferred to have “read-only” access to their databases (and paralegals would tend to agree). It is important also to audit the actual data within the docketing system. One database vendor allows access to 20 or so trademark offices so companies can automatically check the integrity of their database records. Docket information for remaining countries can be cross-checked against the file or through outside counsel.

It was recommended that a change of entity name or merger information should be recorded immediately. Often the business has money set aside for these recordals. A change of address is not as critical and can be postponed until the next filing.

One tip was to ensure docketing staff understands that different regions of the world use different styles for expressing dates, which can cause huge problems with data integrity (for example, 2/1/13 can be January 2 or February 1).

Watch Notices/Disputes

The participants who discussed this topic relied on watch services or outside counsel to identify potential conflicts and no longer review official trademark office publications of marks. Most of the participants watched only their own marks and not the marks of their major competitors. Also, most were not in favor of social media watches, as the cost outweighed the benefits. Most companies relied on their own employees to bring concerns to the trademark team, while others used their advertising agencies.

Cease and Desist Letters

The consensus was that the in-house team had responsibility for sending cease and desist letters. Outside counsel was brought in when muscle was needed. Typically, in-house counsel would send one or two letters before soliciting help from outside counsel. Cease and desist letters from in-house counsel tended to be more friendly and less aggressive, which ensured a less negative reaction in the event the media got involved.

Depending on the effect desired, some counsel may pick up the phone and call the other party. It was highly recommended that a company consider making an initial telephone call, especially to other INTA members. Other participants involved their consumer group or an existing business-to-business relationship. One company had a five-tier system for deciding disputes (competitor vs. non-competitor; content impact (objectionable); etc.).

Fool the Lawyer? (When Business Clients Aren’t Candid With You)

Finally, there was a question on how to handle the “fool the lawyer” game. For instance, the client says the mark will be used descriptively, but the use turns out to be trademark use. It was recommended that the practitioner stay calm and use humor. Be direct with the client—remind the client that the opinion applied only to descriptive use, then put the client on notice that trademark use could be a problem and reiterate the basis for the advice. Other participants referred the situation to a brand manager and asked for senior-level sign-off (e.g., by a financial officer). In the end, however, how to use the mark is a business decision.

Summary

Based on the size of your trademark team and your portfolio, there are numerous options for structuring your team and the workflow. The idea exchange offered insights into many of these options for consideration. Don’t fear change—embrace an opportunity to better structure and utilize your team. Look for options that will allow your team to increase its productivity, maintain accurate records and have a great relationship with your clients.

In-House Practitioners Committee Idea Exchange Team

INTA’s In-House Practitioners Committee (IHPC) consists of in-house attorneys and non-attorneys who concentrate on bringing and enhancing benefits to corporate members. Currently the IHPC has four areas of focus: (1) In-House Idea Exchange; (2) In-House Counsel Luncheon and Workshop (presented each year at the Annual Meeting); (3) Corporate Benefits; and (4) Corporate Recruitment.

The In-House Idea Exchange team develops topic outlines to facilitate conference calls that bring in-house practitioners together to share ideas, concerns and resources. Participation is free, but registration is required in order to keep participants to a manageable number. Idea exchanges generally occur quarterly, but if registration is high enough an idea exchange may be repeated in order to keep exchanges to a manageable size. Only in-house practitioners are permitted on the calls, to encourage candid participation.

Past idea exchange topics include “Metrics—How to Show the Value of Your Trademark Group to Your Company”; “Brand vs. Budget: How to Lead Your Company’s Trademark Function in Today’s Economy”; “Social Networking and Your Brands”; “Trademark Clearance Issues—Subject Matter, Strategies, Resources”; “Managing Your In-House Trademark Department” and “Internet Enforcement—Strategies and Tactics for Protecting IP Assets Online.” Detailed information from the calls is not disseminated to the general membership or to the public. In-house staff of corporate members who are interested in joining the IHPC should apply to INTA during the committee selection process in June 2013.
BRITISH VIRGIN ISLANDS Bill Would Revolutionize BVI Trademark Law

On February 12, 2013, the Trade Marks Bill, 2013 received its first reading in the House of Assembly of the British Virgin Islands. It now has to receive another reading, be considered by a committee and have a final reading before it is passed. The Bill will completely revolutionize the law of trademarks in the British Virgin Islands; however, existing trademarks will continue to be protected.

All existing registered trademarks will be automatically transferred to the new register created by the Bill. If the registered trademark was an extension to the British Virgin Islands of a prior UK registration, it will continue to be registered as though it were actually registered under the new legislation, but the dual procedure for registration that includes re-registration of UK trademarks will no longer be required. Therefore, all existing registered trademarks will benefit under the new system; the only exception is that infringement proceedings can be commenced under the new Bill only in respect of infringements that take place after the legislation comes into force.

Unless the Financial Services Commission issues an order to introduce some other classification system, the Bill will move the British Virgin Islands to the 2013 version of the 10th Edition of the International Classification of Goods and Services under the Nice Agreement (Nice Classification). Therefore, all existing registered trademarks will need to conform to the Nice Classification when the Bill comes into effect. Under the rules and regulations being prepared to ensure the Bill is fully operational, the Registrar will be permitted to make changes to the classification of existing trademarks in order to conform to the Nice Classification.

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INTA’s Practitioner’s Guide to the Madrid Agreement and Madrid Protocol

This searchable database offers practical information on member countries’ practices and procedure in obtaining, maintaining and enforcing registrations through the Madrid system.

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BRAZIL Non-Use Cancellation Effective from Date of Declaration, Not Retroactively

On February 26, 2013, the Fourth Chamber of the Brazilian Superior Tribunal of Justice (STJ) rendered a final decision on the Special Appeal (Recurso Especial Nº 1.080.074 - RS (2008/0173308-2)) filed by the National Institute of Industrial Property (INPI) against Calçados Only Ltda.

The appeal filed by the INPI concerned the effects of the cancellation of the senior trademark for non-use during the judicial proceedings, which had been declared only after Calçados Only’s trademarks had been finally rejected by the INPI and the administrative procedure had been closed.

The INPI noted that Calçados Only did not request the cancellation of the senior trademark for non-use during the judicial proceedings, which had been declared only after Calçados Only’s trademarks had been finally rejected by the INPI and the administrative procedure had been closed.

The INPI argued that the subsequent declaration of cancellation for non-use did not reopen the administrative procedure related to the trademark applications, nor could it change the result of the litigation that was filed based on the argument that there was no possibility of confusion between Calçados Only’s marks and the now-cancelled senior trademark.

In deciding the appeal, Justice Luis Felipe Salomão cited the precedent of the Second Chamber of the STJ (EREsp 964.780), which established that “the cancellation of a registered trademark, for lack or interruption of use by the owner, has legal effects from the date of its declaration (ex nunc), and has no retroactive effect (ex tunc),” and that Articles 212 and 215 of Industrial Property Law provide that the administrative phase ends with the decision on an appeal rendered by the INPI.

Nonetheless, the INPI’s appeal was rejected since Justice Salomão concluded that the lower court had found that Calçados Only’s mark LYON and the senior mark PIERNAS LYON DOR evoked different meanings and identified products directed to completely different markets (shoes in the first case and stockings in the second), and, thus, that the lower court recognized Calçados Only’s right to its trademark and nullified the INPI’s act of denying its applications on grounds of the lack of a possibility of confusion between the marks, rather than due to cancellation of the senior trademark for non-use.

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ITALY Judge “Raps” GUCCI Counterfeiter

On February 8, 2013, the Court of Florence handed down an interim decision in a case involving a third party’s unauthorized use of a famous patronymic trademark (General Docket No. 17984/2012). Among other interim measures taken by the Court was the issuance of a cross-border preliminary injunction to stop the unauthorized use.

The trademark in question was the renowned house mark GUCCI, which two individuals had been using since the summer of 2012 in videos and songs with sexually explicit content that were uploaded on the YouTube website and on several other websites and radio channels. The name of the video channel on YouTube was “TheGucciBoy1992.” Additionally, the songs making reference to the infringing sign had been published in a music collection named “Gucci by Gucci Presidente,” which also included a distorted version of the trademark, “Guccieeii.”

The Judge took the general approach that any use of signs that are similar or identical to renowned trademarks—like GUCCI—gives a clear advantage to those who use them. In other words, without examining the specific, unfair advantage that accrued to the defendant in this particular case, the Judge stated in principle that the use of signs that permit the establishment of a link with a famous trademark always gives the infringer an unfair advantage.

The Court also found that, considering the context in which it was used, the infringing sign could cause prejudice to Gucci’s fame and reputation, in addition to all the negative consequences that resulted from having its famous trademark associated with vulgar and explicit lyrics.

This decision recognizes the enormous importance famous trademarks play in the market as message bearers and carriers of goodwill. The Court held that in general they must be afforded protection when unlawfully exploited by third parties who seek to profit from the advantages deriving from the adoption of an identical or similar sign.

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LIBYA Trademark Office Resumes Work

According to informed sources at the Libyan Ministry of Economy and Trade, the Trademark Office is expected to reopen shortly, nearly two years after its services were interrupted as a result of the latest civil unrest in the country. The Office is now ready to accept search requests and is expected to begin accepting new trademark applications in May 2013. All deadlines and priority dates that fell due within the closure period will be properly dealt with to ensure that the files are in order.

The most important change following the recent events concerns Libya’s relations with Switzerland. Specifically, Switzerland recently reestablished formal diplomatic relations with the Libyan government after a three-year breakdown in those relations. The implication of this development is that it will now be possible for Swiss individuals and entities to file new trademark applications.

Below is a timeline of major trademark-related events over the past three years.

2009 The list of goods and services was revised. A Trademark Appeal Board was expected to be established; its main responsibility was to be hearing and deciding on appeals against any rejection decision issued by examiners in connection with trademark applications. This plan was interrupted following the recent events.

2010 A new Trademark Law was published in the local Gazette and went into effect, replacing Law No. 40 of 1956. The definition of a trademark was broadened to include trade names, sound marks and color marks. The new law recognizes famous trademarks that are well known in Libya and ensures protection even if the marks are not registered. In addition, it gives trademark owners the right to initiate civil and criminal actions against any infringing party. Penalties include a maximum imprisonment of two years and payment of fines of up to US $7,500. The implementing regulations for the new law have not been issued yet.

2011 The requirement for a certified copy of the corresponding home registration certificate in support of a trademark application was eliminated.

The country’s official name changed from “Great Socialist People’s Libyan Arab Jamahiriya” to the more commonly known (and now official) name “Libya.” The international code remains the same (LY).

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INTA Bulletin Law & Practice—Middle East & Africa Subcommittee
NEW ZEALAND Use of Trademarks as Keywords Found Not to Infringe

In considering a request for an interlocutory injunction, the High Court of New Zealand found that use of the term “intercity” as a keyword and in Internet advertisements did not infringe a trademark registration for the identical word. InterCity Group (NZ) Ltd v. Nakedbus NZ Ltd, [2013] NZ 379 (Mar. 1, 2013) (Hansen, J.). The decision demonstrates the influence of European trademark law in New Zealand and the difficulties that an owner of a registered trademark may face in similar circumstances if its mark is descriptive.

The decision relates only to an interlocutory hearing. Mr. Justice Hansen noted that the court might reach a different decision at a full trial, in which all of the complex issues and facts could be considered.

InterCity Group alleged that the use by Nakedbus of “intercity” or variants of that word as a keyword or in online advertising infringed its prior-registered trademark INTERCITY and related common-law rights. In order to succeed in its request for an interlocutory injunction, InterCity needed to satisfy the court that there was a serious issue to be tried and that the balance of overall convenience weighed in its favor. If InterCity proved those elements, then the court needed to assess whether the overall justice of the case favored the grant of an interlocutory injunction or whether it was preferable for the Court not to intervene until all of the issues were canvassed fully at a substantive hearing.

The court considered numerous recent European cases, including Interflora v. Marks & Spencer ([2012] Bus LR 1440 (CJEU)) and 32Red Plc v. WHG International Ltd & Others ([2011] EWHC 62 (Ch)), in demonstrating the difficulty of determining whether use of a third party’s trademark as a keyword will damage the reputation or distinctive character of that trademark—in circumstances where the trademark is descriptive of the relevant goods or services. The 32Red case was cited to support the conclusion that, for purposes of this interlocutory hearing, the use by Nakedbus of the INTERCITY trademark as a keyword and in Internet advertisements did not “lead to a risk of confusing or deceiving consumers as to the origin of the services on offer.” As such, InterCity Group had failed to establish that there was a serious question to be tried on the issue of trademark infringement. Important in the court’s reasoning was the primarily descriptive significance of the mark INTERCITY.

Does confusion matter if the infringing mark is identical to a registered mark? The court concluded that Nakedbus’s use of InterCity’s trademark as a keyword and in Internet advertisements had not been shown to lead to a risk of consumer confusion or deception as to the origin of Nakedbus’s services on offer. Consequently, the court found it unnecessary to consider whether the mark that Nakedbus used was “identical or merely similar” to the registered INTERCITY trademark.

However, in New Zealand there is no need to prove that the use of an allegedly infringing mark in relation to the same goods or services is likely to cause confusion if the mark in question is identical to the relevant registered mark. Hence, it was very important for the court to assess whether the infringing mark was identical or only similar to InterCity’s registered mark before moving on to consider any risk of confusion.

Although it was not clear from the judgment, the court did not conclude that Nakedbus was using the term “intercity” and related terms as trademarks, as they were not shown to have been used to indicate the origin of Nakedbus’s services. If so, this would be a narrow interpretation of what constitutes use of a term as a trademark, as the court seemed prepared to find that there was not even an arguable case that the use was potentially liable to adversely affect one of the functions of the trademark—not just the origin function, but also its quality, communication, investment and advertising functions, particularly as it had found that the way in which the defendant used the “intercity” word was “ambiguous.”

The court also found that InterCity Group did not establish that there was a serious issue to be tried as to whether Nakedbus’s use of “intercity” did not constitute passing off or contravention of the Fair Trading Act 1986, as it had not been shown that Nakedbus had made representations to the public that would be likely to lead the public to believe that its services were those of InterCity Group.

Breach of undertaking InterCity also alleged that Nakedbus had breached an undertaking not to promote itself as “intercity.” As the undertakings to which InterCity referred were never recorded in writing, InterCity sought to rely on oral undertakings between the parties to support its position. It failed to establish this cause of action, as the court ruled that the oral undertakings were unclear and should have been confirmed in writing.

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**SERBIA** Amendments to Law Governing Unfair Competition

On February 7, 2013, a set of amendments came into force in Serbia affecting the Law on Trade, which regulates unfair competition (passing off).

The amended Law, originally enacted in 2010, defines unfair competition as an act of one trader against another trader (i.e., a competitor) that violates the code of conduct and good business practices and that is or may be damaging to the competitor. Selling goods featuring designations, data or shapes that create consumer confusion regarding the source, quality or other characteristics of the goods is listed as an example.

The amendments introduce detailed provisions regarding the available civil remedies. A trader can request the court to recognize that an act of unfair competition has been committed, to prohibit continuation of that act, and to order removal of the consequences of the act as well as award indemnification. Before the amendments, the Law contained only a general provision prohibiting unfair competition and providing that the trader could request indemnification.

In addition to material damages, which were already available, the amended Law explicitly provides that nonmaterial damages (for harm to business reputation) can be claimed, and lists the factors that will be taken into consideration in evaluating the indemnification (the gravity, duration and intensity of the violation; the effect of the violation on the trader’s business; the importance of the infringed property; and the aim that is to be achieved with indemnification).

Last, the amended Law introduces a deadline for commencing an action based on unfair competition. The action must be initiated within six months after the trader has learned of an act of unfair competition and the identity of the perpetrator, and no more than three years after the act of unfair competition was committed. Previously, the Law did not provide for a deadline for such actions.

The amended Law represents an important piece of legislation for the fight against “lookalikes,” and the detailed provisions on civil remedies that were introduced represent good news for brand owners.

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**SINGAPORE** Sufficient Goodwill for Passing-Off Claim, Despite Sales Figures

Hai Tong Co Pte Ltd, a Singapore company, is engaged in the business of importing, exporting and distributing cosmetic products under the LADY ROSE brand and has registered that mark in Class 3. Ventree Singapore Pte Ltd imported ROSE LADY brand cosmetic products from VOV Cosmetics in South Korea and distributed the products in Singapore.

Upon discovering that Ventree had been distributing ROSE LADY products, Hai Tong instituted proceedings for infringement and passing off before the High Court. While upholding the infringement claim, the court dismissed the passing-off claim, finding that Hai Tong had “trivial” goodwill and had failed to adduce sufficient evidence to demonstrate likelihood of damage.

Cross-appeals were filed to the highest court in Singapore, the Court of Appeal. It granted both the infringement and the passing-off claims. Hai Tong Co (Pte) Ltd v. Ventree Singapore Pte Ltd et al., [2013] SGCA 26 (Mar. 15, 2013).

With respect to infringement, the Court of Appeal held that:

1. The mark LADY ROSE was not descriptive. It went beyond merely describing the product and served to distinguish it as to its origin.
2. The marks were similar despite the fact that Ventree had used the ROSE LADY mark alongside the VOV mark. The Court also clarified that secondary product identifiers can indeed function as trademarks.
3. The goods on which the respective marks were used were identical.
4. There was a likelihood of confusion.

With respect to passing off, the Court of Appeal disagreed with the High Court. It found that:

1. Hai Tong had sufficient goodwill, as it had developed a sustainable business over a period of more than four decades, notwithstanding less-than-impressive sales figures of the LADY ROSE products in Singapore.
2. The elements of misrepresentation and damage were established.

This decision is significant, as the Court of Appeal clearly articulated the tests to be employed in the determination of trademark infringement and passing off. Further, in holding that Hai Tong had sufficient goodwill, the Court laid emphasis on the quality, as opposed to mere quantity, of the evidence.

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UNITED KINGDOM  Own Name Defense Successful

On March 4, 2013, the UK High Court, in *Stichting BDO et al. v. BDO Unibank, Inc et al.*, [2013] EWHC 418 (Ch), held that the defendants’ use of the marks BDO and BDO REMIT did not infringe Stichting BDO’s Community trade mark (CTM) registration for BDO. This case is a rare example of an “own name” defense succeeding in the UK courts. This first instance decision is part of an international dispute spanning over 40 jurisdictions. The judge commented that the situation cries out for negotiation of a global (but perhaps geographically differentiated) coexistence agreement.

The claimants are part of an international network of accountancy and professional services firms that trade under the name BDO. BDO Unibank, the leading bank in the Philippines, also trades under the name BDO. Unibank has no trading presence in the United Kingdom but has agreements with the other defendants, which provide remittance services under the name BDO Remit. These services enable foreign workers to transfer earnings from the United Kingdom to their families in the Philippines.

The claimants argued that Unibank’s use of the name BDO in advertisements in publications circulated within the European Union infringed the Mark under Article 9(1)(a) of the CTM Regulation (Council Regulation (EC) No. 207/2009) (CTMR) (identical mark for identical services) and the other defendants’ use of the name BDO Remit in relation to remittance services was an infringement under Articles 9(1)(b) (likelihood of confusion) and 9(1)(c) (dilution). The defendants denied infringement and counterclaimed for declarations that the Mark should be partially revoked on the ground of non-use. This analysis focuses on the infringements aspect of the case.

The claimants’ case under CTMR Articles 9(1)(b) and 9(1)(c) failed on the facts. However, their claim under Article 9(1)(a) (‘double identity infringement’) *prima facie* succeeded with respect to the use of BDO in three (out of 20) advertisements. The key questions for the court were whether the use was within the EU and whether Unibank could rely on the “own name” defense.

In relation to the issue of use in the EU, Mr. Justice Arnold considered the matters laid down by the Court of Justice of the European Union in *L’Oréal SA v. eBay International AG* (Case C-324/09) and the joined cases of *Pammer v. Reederei Karl Schützer GmbH & Co. KG* and *Hotel Alpenhof GesmbH v. Heller* (Cases C-585/08 and C-144/09) (which discuss factors relevant to whether online advertisements and websites ‘target’ consumers in a particular location) to be relevant when considering print advertisements. Ultimately, three advertisements were found to target consumers in the United Kingdom and thus to infringe. The court relied in particular on the fact that two advertisements did not refer to the Philippines and referred to investing “across institutional and geographic boundaries”; the third referred to “foreign investors”; and all three were aimed predominantly at European readers and contained contact numbers either with an international code or without any indication that it was a Philippine telephone number.

Despite infringement being found on a *prima facie* basis, Unibank’s “own name” defense was successful. At all relevant times, BDO was Unibank’s trading name. When assessing whether use was in accordance with honest practices, the court considered each of the factors set out in *Samuel Smith Old Brewery (Tadcaster) v. Lee* ([2011] EWHC 1879 (Ch)). This analysis is fact specific, but, on balance, the court concluded that use of Unibank’s trading name BDO did not amount to unfair competition, and so Unibank had a defense to the infringements.

This is a first instance decision in the United Kingdom, and whether it is to be appealed is not known. There are currently proceedings between the parties in Hong Kong, Italy, Philippines and the United States. In addition, there are pending cancellation actions in China, Japan, Oman, Saudi Arabia and Singapore, and 183 opposition actions pending in 40 jurisdictions.

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The U.S. Trademark Trial and Appeal Board (TTAB) dismissed an opposition to three applications for the mark RSTUDIO in view of the applicant’s motion to amend and narrow the goods and services description in the opposed applications. *Embarcadero Technologies, Inc. v. RStudio, Inc.* Opposition No. 91193335 (T.T.A.B. Feb. 14, 2013) (precedential).

RStudio sought to register the mark RSTUDIO for goods and services broadly identified in the application as potentially encompassing all types of statistical software and applications development software, as well as training, design and development services. Embarcadero Technologies alleged likelihood of confusion with its registered mark ER/STUDIO, covering “entity relationship modeling software for SQL databases.”

Just before the close of discovery, RStudio, without Embarcadero’s consent, filed a motion to amend the application to narrow the goods and services “in the event that the [TTAB] deems such amendments necessary to dismiss the opposition.” In particular, the amendment restricted the goods and services to the field of “advanced” statistical software using the “R” computer language and data from two-dimensional datasets.

The TTAB deferred ruling on the motion until its final decision, noting that such an amendment under the Lanham Act usually is asserted as an affirmative defense in the defendant’s answer to put the plaintiff on notice. Nevertheless, it held that the motion was filed in a timely manner where it was clear that the issue of the proposed amendment was tried by the parties and addressed in their trial briefs.

In reviewing likelihood of confusion, the TTAB found that the marks had some degree of similarity in appearance and sound, but that they engendered distinctly different meanings and commercial impressions. Purchasers of Embarcadero’s software would understand the abbreviation “ER” to mean “entity relationship,” whereas the “R” in the applicant’s mark referred to the “R” computer programming language. Furthermore, as to the common element STUDIO, the record established that this term was highly suggestive and frequently used by third parties in connection with software. Therefore, this likelihood-of-confusion factor weighed in RStudio’s favor.

With regard to the similarity of the goods and services, the TTAB found RStudio’s software and related services as originally published to be related to Embarcadero’s software. However, upon reviewing RStudio’s proposed amendment that significantly narrowed the goods and services, the TTAB did not find “any significant relationship between the respective software products of the parties.” In addition, RStudio’s services were found to be even more removed, as they involved a service in the specific field of R computing language software.

The record also showed that consumers of the software products of both parties were likely to be experienced in their respective specific field and knowledgeable of the different types of software and their intended purpose. Neither product was the type of software to be purchased in retail stores by ordinary consumers, but rather would be purchased by “technology professionals highly familiar with the different nature, use and purpose of each software product.” Thus, the factors involving purchasing conditions and sophistication of consumers weighed against any finding of likelihood of confusion.

Balancing the relevant factors, the TTAB found a likelihood of confusion based on the unamended description of goods and services, but no likelihood of confusion as to the amended goods and services. Accordingly, it granted RStudio’s motion to amend and dismissed the opposition.

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