Interview

Interview: Elisabeth Kasznar Fekete, ABPI President, and Jorge Arbache, University of Brasilia and Brazilian Development Bank

In August, INTA leaders and staff attended the XXXIV Congress of the Brazilian Association of Intellectual Property (ABPI) in São Paulo. There, ABPI President Elisabeth Kasznar Fekete announced key findings of a landmark study on the value of IP to the Brazilian economy, which Jorge Arbache, an economics professor at the University of Brasilia (UNB) and Economic Advisor to the President of the Brazilian Development Bank, expanded upon during his keynote address. Ms. Fekete and Mr. Arbache spoke with the INTA Bulletin about the intent of the study and its implications for the future of trademark protection in Brazil.

Can you tell us about the study?  
Elisabeth Fekete: ABPI’s study will be published in two volumes, written in Portuguese:


See “Interview” on page 6

Association News

INTA Responds to European Commission Paper on GIs; Topic to Be Addressed at INTA Conference in Munich

In July, the European Commission launched a Green Paper consultation—a document intended to generate discussion and debate on a particular topic—on the prospect of offering EU-wide geographical indication (GI) protection for non-agricultural products. The period for comments closed on October 28, just over one month before the Association will examine the complexities of overlapping IP rights during a two-day conference in Munich, where this issue will be addressed in-depth.

INTA’s Position

While having a number of mechanisms for protecting a particular product is important—for instance, via a combination of patents, trademarks and copyrights—multiple regimes for protecting similar aspects of a product can at times result in an overreach of protection and potential conflicts. It is therefore crucial when considering the expansion of GI protection for non-agricultural products in the European Union that appropriate measures be taken to minimize such issues. The EU regime for protecting agricultural GIs already includes overly broad protections, and INTA is concerned the problems associated with this could be far greater for non-agricultural products.

Examples of non-agricultural products originating from the EU that might be eligible for GI protection include Scottish tartans, Marmo di Carrara (marble) and Meissner Porzellan (porcelain). The system would also allow third countries to protect their non-agricultural GIs EU-wide (for example, Indian sarees, silk paintings and shawls).

In its comments on the EU Green Paper, INTA proposed the following precautions be taken in developing an EU-wide GI system, among other recommendations:

1. Allow trademark owners to challenge GI applications based on the concept of “first in time, first in right,” without qualification as to reputation, renown or length of time.

See “Green Paper” on page 5

Feature

Issues to Consider in Assignments of U.S. Trademark Applications and Registrations

Law & Practice

Argentina 13
Brazil 13
European Union 13, 14
India 14
South Africa 15
United Arab Emirates 15
United States 16

See “Interview” on page 6

Association News

Welcome New Members  2
USPTO to Issue Courtesy Email Reminders of Registration Maintenance Filing Deadlines  3
Italian Patent and Trademark Office Celebrates 130 Years of Activity  3
Why Renew Your INTA Membership?  4
Kelly Maser, United States Olympic Committee
Volunteer Spotlight  7
Monique Cheng Joe Charles Webster
When Worlds Collide: Name Collision Within the New gTLD System and Its Effects on Brand Owners and End Users  8

In This Issue

See “Green Paper” on page 5
Welcome New Members

Anguaila Busiku & Co. Advocates, Kampala, Uganda
Astrachan Gunst Thomas, PC, Baltimore, Maryland, USA
B CUBE, Paris, France
Baker & Hostetler LLP, Seattle, Washington, USA
Bally Technologies, Las Vegas, Nevada, USA
Berenbaum Weinschenk, PC, Denver, Colorado, USA
Brand Protection Co, Dingley Village, Victoria, Australia
DC Law, Makati City, Metro Manila, Philippines
Deeb & Co. for Legal Services, Doha, Qatar
DEIURECORP, Quito, Ecuador
Freeths LLP, Birmingham, United Kingdom
Global Law Office, Beijing, China
Green Rights Rechtsanwaltskanzlei Leidereiter, Hamburg Germany
Hahn Loeser & Parks LLP, Cleveland, Ohio, USA
Honor Law Firm PC, San Antonio, Texas, USA
Henkel & Cohen, PA., Miami, Florida, USA
IntelectPol, Kutno (Gmina), Poland
JIG Group LLC, Friday Harbor, Washington, USA
Keen Branding, Nassau, Delaware, USA
Kenneth Bradley Trademark Services, Vancouver, British Columbia, Canada
Klehr Harrison Harvey Branzburg, Philadelphia, Pennsylvania, USA
Law Office of Raphael A. Gutierrez, Los Angeles, California, USA
Law Offices of Pankaj S. Raval, Los Angeles, California, USA
Law Offices of Robert F Zielinski, LLC, Philadelphia, Pennsylvania, USA
Lexia Attorneys Ltd, Helsinki, Finland
Litvin Legales, Buenos Aires, Argentina
Meunier Carlin & Curfman, Atlanta, Georgia, USA
MusclePharm Corporation, Denver, Colorado, USA
Newpop IP Law Firm, Kawasaki-Shi, Japan
Officium Lex Lau Abogados, Panama City, Panama
Petock & Petock, LLC, Valley Forge, Pennsylvania, USA
Pioneer Law Associates Private Limited, Kathmandu, Nepal
Regard IP Law, San Francisco, California, USA
Rivera Córdova & Cordero, Guatemala, Guatemala
Rohde & Co, Mexico City, Mexico
Shams Globe/Intellectual Property Consultants, Amman, Jordan
Spectrum Brands, Inc., Middleton, Wisconsin
USA Universal Music Group, Beijing, China
Vilau | Associates, Bucharest, Romania
VMG Partners, LLC, New York, New York, USA
von Maltitz, Denerberg, Kunin, Janssen & Giordano, New York, New York, USA
Wilmer Cutler Pickering Hale and Dorr LLP, London, United Kingdom
Wizecounzel Law Firm, Lagos, Nigeria

INTA Bulletin Committee
To contact the INTA Bulletin Committee, email bulletin@inta.org.

Chair
Barbara Sullivan, Henry Hughes

Vice Chair
Lisa Thomas, Winston & Strawn LLP

Co-Chairs, Features Subcommittee
Elizabeth Buckingham, Dorsey & Whitney
Peter McAleese, AKRAN Intellectual Property Srl

Co-Chairs, Association News Subcommittee
Barbara Barron Kelly, Corsearch
Katherine Dimock, Gowling, Lafleur, Henderson

Co-Chairs, Law & Practice: Asia-Pacific Subcommittee
Chetan Chadha, Chadha & Chadha, An Intellectual Property Law Firm
Joseph Yang, Lee and Li, Attorneys at Law

Co-Chairs, Law & Practice: Europe & Central Asia Subcommittee
Mary Bleahene, FRKelly
Thomas Mudd, Zeiner & Zeiner

Co-Chairs, Law & Practice: Latin America & the Caribbean Subcommittee
Martín Chajchir, Marval, O’Farrell & Mairal
Carlos Corrales-Azoula, Corrales Core IP

Chair, Law & Practice: Middle East & Africa Subcommittee
Ghaida Aia Eddine, Saba & Co. IP

Co-Chairs, Law & Practice: United States & Canada Subcommittee
Robert Felber, Waller, Lansden, Dortch & Davis
Catherine Hoffman, Mayback & Hoffman

INTA Bulletin Staff
Chief Executive Officer
Etienne Sanz de Acedo

Director, Marketing and Communications
James F. Bush

Managing Editor, News & Policy
Eileen McDemott

Senior Periodicals Editor
Joel L. Bromberg

Designer
Eric Mehlenbeck

INTA Officers & Counsel
President
Mei-lan Stark, Fox Entertainment Group

President Elect
J. Scott Evans, Adobe Systems Incorporated

Vice President
Gabrielle Olsson Skalin, Inter IKEA Holding Services S.A.

Vice President
Lucy Nichols, The Center for Responsible Enterprise and Trade (CREATE)

Treasurer
Joseph Ferretti, PepsiCo, Inc./CREATe

Secretary
Ronald Van Tuijl, JT International S.A.

Counsel
Etienne Sanz de Acedo

Although every effort has been made to verify the accuracy of items in this newsletter, readers are urged to check independently on matters of specific interest. The INTA Bulletin 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. For permission to reproduce INTA Bulletin articles, send a brief message with the article’s name, volume and issue number, proposed use and estimated number of copies or viewers to bulletin@inta.org. INTA Bulletin sponsorships in no way connote INTA’s endorsement of the products, services or messages depicted therein.

© 2014 International Trademark Association
USPTO to Issue Courtesy Email Reminders of Registration Maintenance Filing Deadlines

In response to comments and requests from self-represented trademark owners, and in an effort to help ensure that trademark registrations are not inadvertently forfeited, the U.S. Patent and Trademark Office (USPTO) plans to begin sending courtesy email reminders of upcoming post-registration maintenance filing deadlines for Sections 8 and 71 declarations and Section 9 renewals. Beginning in late January 2015, the courtesy email reminders will be sent to registration owners who (1) have “live” registrations on the date of sending, (2) have provided a valid email address to the USPTO and (3) have authorized email communication. No reminders will be sent by regular mail, and no follow-up emails will be attempted for undeliverable emails.

To ensure receipt of the courtesy email reminders, registration owners should add the USPTO to their “safe senders list” and/or confirm that their email server will accept email from the USPTO and will not treat it as junk mail or spam. Any failure by the USPTO to provide the courtesy email reminders or any non-receipt of such reminders will not excuse a registration owner that fails to meet its statutory obligations.

Eligibility and Targeted Recipients
The courtesy email reminders will be sent on the first day of the statutory filing period for the maintenance filing (e.g., 5th year anniversary date, 9th year anniversary date, 19th year anniversary date, etc.) to all email addresses of record within the Correspondence and Current Owner(s) Information fields, as indicated in Office records, even if email was authorized for only one of the fields. For example, if email was authorized in the Correspondence Information field but not in the Current Owner(s) Information field, the reminders will be sent to email addresses in both the Correspondence Information and the Current Owner(s) Information fields.

The reminders will be sent to both primary and secondary email addresses. If an email address is duplicated (e.g., within the Correspondence Information and Current Owner(s) Information fields), only one notice will be sent to that email address.

Registration owners should use the USPTO’s Trademark Electronic Application System (TEAS) Change of Correspondence Address and Change of Owner’s Address forms to verify, update, add or delete email address information, as necessary, to ensure receipt of the reminders by the registration owner(s) and any legal representative that elect to receive them. The USPTO encourages owners and/or their attorneys to promptly make any necessary changes to email address(es) in the Trademark Database.

Information Communicated in the Courtesy Reminders
The courtesy email reminders will identify the registered mark, corresponding serial and registration numbers, the date of registration and the owner(s) of record in the USPTO’s Trademark database. The reminders will also identify the maintenance filing currently due (e.g., Section 8 declaration, Section 71 declaration, or Section 8 declaration and Section 9 renewal application), along with the anniversary filing deadline, the grace period deadline and the filing fee per class.

The courtesy email reminders will provide links to the USPTO website for general information on registration maintenance requirements, as well as direct links to TEAS, the Trademark Status & Document Retrieval (TSDR) database and the Electronic Trademark Assignment System (ETAS).

Opting Out of Receiving the Courtesy Email Reminders
If registration owners or their attorneys do not wish to receive the courtesy email reminders, they should delete their email addresses from the USPTO’s Trademark database using the TEAS Change of Correspondence Address and Change of Owner’s Address forms.

If legal representation prior to registration will not be ongoing, the TEAS Change of Correspondence Address and Change of Owner’s Address forms should be used to remove any attorney email address(es) from the USPTO’s Trademark database and to provide the email address(es) of the registration owner(s), so that the USPTO can send the courtesy email reminder directly to the registration owner(s).

Italian Patent and Trademark Office Celebrates 130 Years of Activity

On October 23, 2014, Italian members of INTA attended a conference to mark the 130th year of operations of the Ufficio Italiano Brevetti e Marchi (UIBM), the Italian Patent and Trademark Office, in the splendid surroundings of the Temple of Hadrian in Rome.

Attendees were welcomed to the event by the Hon. Simona Vicari, Undersecretary at the Italian Ministry for Economic Development. Speakers included Ms. Loredana Gulino, Director General of UIBM; Mr. Raimond Lutz, Vice President of the European Patent Office; Ms. Wang Binyang, Vice Deputy Director-General at WIPO; Mr. Christian Archambeau, Vice President of OHIM; and Mr. Luciano Bosotti, President of the Italian Institute of Patent and Trademark Attorneys.

Leading figures from Italian industry and academic institutions also spoke at the event, during which attendees were presented with a 200-page volume of text and photos charting the history of UIBM’s activities from 1884 until today, alongside a narrative of contemporary social, political and economic conditions in Italy.

The event coincided with Italy’s Presidency of the European Union, from July 1 through December 31, 2014.
Why Renew Your INTA Membership?
Kelly Maser, United States Olympic Committee

Kelly Maser of the United States Olympic Committee explains to the INTA Bulletin where her organization has found the most value in INTA membership, and why it has kept them renewing for nearly 15 years.

How long has your company been a member of INTA?
The U.S. Olympic Committee (USOC) has been a member of INTA since 2000.

Where do you find the greatest value in the Association overall?
The educational sessions at the Annual Meeting are usually well done, and the contacts you make with other trademark lawyers at different companies can be extremely valuable.

What was your first Annual Meeting, and what are your memories of it?
My first Annual Meeting was Orlando in 1995, and the biggest thing I remember was the keynote speaker driving a Harley Davidson motorcycle through the convention center, right up onto the stage.

How has attendance at the Annual Meeting been most beneficial to you personally and to the company as a whole?
The Annual Meeting is a huge opportunity for networking with other trademark attorneys, comparing best practices, meeting in person with outside counsel, and even talking to third parties with whom you may have a conflict.

Beyond the Annual Meeting, how else do you/the company make use of INTA’s resources?
I often utilize the membership directory to find the appropriate contact person at a company when I need to reach out and discuss a trademark infringement matter.

Are there policy or judicial issues that INTA has helped to improve to the company’s benefit?
INTA has held multiple sessions on ambush marketing, which is an important topic for the USOC.

Why do you think it is useful or important for trademark practitioners to be involved with INTA?
INTA membership provides educational opportunities, helps you to stay current in your field, affords opportunities to meet and compare notes with counterparts at other companies and allows you to interact with and learn from others who deal with issues similar to those facing your company or clients.

The 2015 membership renewal process is now open and runs until December 31, 2014. Members can renew via our online renewal system with a credit card or print an invoice to pay via check.

Please make sure to renew before December 31 to receive the member rate for the San Diego Annual Meeting. Registration opens January 14, 2015.

Get your copy of the 2014–2015 INTA Membership Directory today!

There you’ll find:
• The most current contact information of all INTA member organizations and key people.
• An extensive list of service providers that can help with your business needs.

Visit www.inta.org/MembershipDirectory to order now!
Supplies are limited!

Visit www.inta.org/MembershipDirectory
EU Commission Green Paper  Continued from page 1

of use and irrespective of whether there is protection in one Member State or the entire European Union.

2. Adhere to TRIPS, Article 22 language on exceptions for misleading use, rather than the broad exceptions allowed by the existing EU regime for GI protection of agricultural products, which grants protection beyond misleading use;

3. Include objection and cancellation mechanisms to ensure that only indications deserving of protection are registered;

4. Require full examination by the country of origin, as well as at the EU level; and

5. Establish a limited duration of protection, with the possibility of renewal.

A Timely Debate
As the European Commission considers expanding GIs to non-agricultural products it is crucial that trademark owners understand the impact of such a regime on their existing trademark rights, and that they work with INTA to ensure appropriate protection measures. INTA's conference, “When Trademarks Overlap with Other IP Rights,” to be held December 8-9 in Munich, Germany, will include an in-depth analysis of the issues raised in this Green Paper. Session III, “Trademarks and Geographical Indications,” will be moderated by Anna Carboni (Redd Solicitors, United Kingdom), will look at the current regime for protecting GIs in Europe and internationally, with an emphasis on recent case law from the Court of Justice of the European Union and elsewhere.

The conference will also feature an opening keynote by Professor Jeremy Phillips (Olswang LLP, London, and Queen Mary Intellectual Property Research Institute, United Kingdom); VIP interviews with Christoph Ernst, Ministerialdirigent at the German Federal Ministry of Justice, and Mihály Ficsor, Vice President for Legal Affairs at the Hungarian Intellectual Property Office; and a closing session presented by Antonio Campinos, President of the Office for Harmonization in the Internal Market (OHIM). Other sessions, featuring expert speakers from both academia and law firms, will explore the interplay between trademarks and copyrights, designs, unfair competition law and the right of publicity.

To learn more about the program and speakers or to register, click here or contact Ann Eng at aeng@inta.org.

Strong IP Protection Requires the Right Tools
More than 250 people have already registered!

See which organizations will be there. If you have not already signed up, don’t miss the opportunity to secure your spot and learn how trademarks intersect with patents, copyrights, designs and other IP Rights.

Highlights include:

• A Keynote address by Professor Jeremy Phillips, best known as the founder of the IPKat blog and Professorial Fellow in the Queen Mary Intellectual Property Research Institute, where he shares his insights on the unevenness of protection regarding badges of origin.

• A special lunch time VIP Interview, conducted by INTA Secretary and Board of Directors Member Ronald Van Tuijl of JT International S.A. (Switzerland), with
  · Dr. Christoph Ernst, Ministerialdirigent, German Federal Ministry of Justice (Germany) and
  · Dr. Mihály Ficsor, Vice President for Legal Affairs, Hungarian Intellectual Property Office (Hungary)

• A closing session presented by Antonio Campinos of the Office for Harmonization in the Internal Market (OHIM) about the future of trademarks.

And various sessions featuring expert speakers from both academia and law firms exploring the interplay between trademarks and copyrights, designs, unfair competition law and the right of publicity.

For more information about the educational program and networking opportunities, please visit: www.inta.org/2014tmoverlap
Interview: Elisabeth Kasznar Fekete and Jorge Arbache

Continued from page 1

Among other things, this volume includes proposals to provide sufficient resources to INPI to improve judicial enforcement, and it points out the negative impacts of plain packaging legislation.

Volume 2: Professor Jorge Arbache’s study, “O Brasil e a Importância Econômica da Indústria Intensiva em Conhecimento” (“Brazil and the Economic Importance of the Knowledge-Intensive Industry”), 74 pages, with an Executive Summary and Suggestions at pages 9–16.

This is a pioneer economic study on Brazilian intellectual property, requested by ABPI and its Corporate Members Committee. In his research and analysis, Mr. Arbache measures innovation in the country and also points out the deficiencies and structural obstacles to be overcome by Brazil, as well as the paths recommended to reach the circuit of more value-added global supply chains.

IP public policies are addressed by both volumes: in the first, through the contribution of IPR owners and experts with technical/legal experience; in the second, from an economic perspective.

Is it modeled after the recent EU and U.S. studies on the impact of IP-intensive industries on the economy? How is it similar or different? Jorge Arbache: Yes, the study was inspired by the EU and U.S. studies. We tried to replicate those approaches in the first place, but because of the lack of data, we ended up doing something different.

In order to identify the most knowledge-intensive industries, we built a composite indicator composed of nine indicators, including R&D per employee, R&D per plant and innovation expenses per industry. We also employed two other alternative criteria (and databases), including one on royalty expenses per industry and one on patents per industry.

Once we ranked industries, we split them into groups according to knowledge intensity and calculated productivity, job intensity, revenues and other indicators by group.

Finally, we ran regressions in order to identify the relationship between knowledge intensity and key economic variables, including employment, exports, imports, education of employees and revenue. The results will be very useful in developing policy.

What do you hope the study will achieve with respect to the status of IP in Brazil’s government? Elisabeth Fekete: The goal of these studies is, in summary, to demonstrate the importance of intellectual property to Brazil’s economy and to orient ABPI’s next actions. The country is right now in a historic electoral season. Copies were sent to the main presidential candidates.

We hope that the studies will help ABPI in its mission to contribute with initiatives and to cooperate with legislative, executive and judicial authorities, with a view to achieving increased recognition of innovation in Brazil and to supporting the need to protect IP rights and activities for industries that are rich in R&D and technological progress.

Key Recommendations Based on ABPI Study

1. Reduce the time for granting trademark registrations by providing Brazil’s National Institute of Industrial Property (INPI) with the necessary infrastructure and sufficient examiners;
2. Improve the Innovation Law and the Industrial Property Law;
3. Provide tax incentives and reduce obstacles to Brazilian companies expanding internationally;
4. Provide tax incentives for small and medium enterprises;
5. Revise and update the tax treatment of licenses, including trademark licenses;
6. Strengthen and specialize the judiciary system with regard to IPR enforcement; and
7. Reject plain packaging legislation and other limitations to the use of trademarks.

Key Economic Findings

1. The most knowledge-intensive sectors include: pharmaceuticals, telecom, oil, transportation equipment, auto, IT equipment, electronics and optical, electricity and gas generation and provision, IT, architecture services and engineering services.
2. The most knowledge-intensive industries employ relatively more employees; their labor force is more skilled as measured by schooling; they have a higher revenue and productivity; and they are more active in international trade.
3. The increase of knowledge-intensity at the industry level is associated with increase in revenues, increase in pay of labor force and job creation.

Conclusion

The increase of knowledge-intensive industries in the Brazilian economy—which requires, among other factors, a more modern IP framework and institutions—will likely create better conditions for development and sustainable growth.

Searchable database on the cancellation practice and procedure in more than 85 jurisdictions worldwide

Trademark Cancellations on INTA’s Global Trademark Resources Page

Visit www.inta.org/Cancellations
Volunteer Spotlight

Monique Cheng Joe is Vice President—Trademark Counsel, NBC Universal

Monique has found each of her INTA committee assignments rewarding in its own unique way. Most importantly, however, she has enjoyed the opportunity it has afforded her to be introduced to new people, which has become the basis of many friendships. She enjoys bringing people together to exchange ideas and to meet new people, whether through arranging events for the Roundtables Committee or coordinating a luncheon for the In-House Practitioners Committee. If there is one thing she would like INTA to address in the near future, it would be how to make more time in the day!

Monique believes that with the roll-out of the new gTLDs, the increase in global markets and the many distribution channels available for goods and services, finding ways to adequately protect brands across all media with the same amount of resources is one of the most difficult challenges facing all trademark owners today.

Monique became aware of the true power of trademarks when her son was just a toddler and could not yet read, but when he saw the Target bullseye logo, he said, “That’s Target!”

Monique loves traveling to new and exotic places with her husband and six-year-old son. Her son’s first international trip was to Haiti, when he was just seven months old.

Charles Webster says, “Trademarks are in my blood.” A senior partner at Spoor & Fisher in Pretoria, he specializes in litigation, including trademark infringement, passing off and domain name disputes, and has over 27 years’ experience in the field. Charles, who is a past president of the South African Institute of Intellectual Property Law and chairman of his firm, explains, “I have fewer management responsibilities than before, which has allowed me to concentrate on what I enjoy most, specifically, furnishing opinions and strategic input on enforcement matters.”

“Defending companies in a tight spot” is a highpoint of Charles’s practice. He has handled cases that have resulted in landmark decisions—for example, clarification of the law relating to shape marks, and the ruling that use other than as a trademark does not constitute primary trademark infringement. Asked about factors that motivate him, Charles responds, “Closing cases, ideally with a successful result and a happy client, but sometimes closure in itself is sufficient motivation and allows one to move on to the next challenge.”

Currently Charles is a member of the INTA Bulletin Committee. His other INTA contributions include writing for The Trademark Reporter (TMR) Committee and serving as the Southern Africa representative on the TMR’s International Annual Review Task Force. Charles was on the project team for and a speaker at INTA’s Middle East and Africa regional conference in Dubai in December 2013. “I am excited at the prospect of INTA’s next regional conference’s possibly being held in Cape Town,” he says.

INTA has also played a significant role in Charles’s personal life. The 1993 INTA Annual Meeting in New Orleans gave Charles the opportunity to engage with Kay Rickelman, whom he had met once at her office in Chicago. Charles and Kay married in April 1994, and they have been a regular INTA couple ever since. Together they have built up a wonderful group of global INTA friends. “Be warned,” Charles promises, “when we retire we’ll travel around the world visiting all of you.”

Favorite pastimes include spending time atgame parks in southern Africa, where he can photograph wildlife, and relaxing at their Cape Town holiday home, where Cape wines are best enjoyed. At home, they delight in the company of their two golden retrievers. Charles’s main pursuit is cycling, and he uses the annual Cape Argus cycle tour and the Joburg 94.7 as incentives to train. “My motto,” Charles says, “is to finish the +/- 100km rides with a smile, rather than worrying about the time I take.”

Shamin Raghunandan
Spoor & Fisher, Pretoria, South Africa
INTA Bulletin—Association News Subcommittee
Imagine that you are a member of a private network. To get your company’s archived documents, you type “mycompany.mail” into your browser and instead of reaching secured files, you are directed to a public website. Of course, you are not aware that your browser was tricked in this way. You only know that your request was not handled as expected.

To get your company’s archived documents, you type “mycompany.mail” into your browser and instead of reaching secured files, you are directed to a public website. Of course, you are not aware that your browser was tricked in this way. You only know that your request was not handled as expected.

The Interaisle report did not find new problems—other than previously identified—relating to the .brand names that were caught in a net of embargoed domains without clear Rights Protection Mechanisms (RPMs). A further concern for brand registries was that because of the manner in which the lists based on DITL data were generated, they inevitably included a number of their own branded and industry-relevant terms. So, for example, the list for .IBM includes computer, ibm, laptop.ibm, cognos.ibm, lenovo.ibm and lotus.ibm.

The discussions resulted in the new gTLD Occurrence Management Plan, released in October 2013, and the engagement of JAS Global Advisors to create a Name Collision Management Framework. The plan allowed the majority of strings to proceed by following an Alternate Path to Delegation (APD), requiring that they block from use as second-level domains (SLDs) all the terms identified on their block lists, pending further work. Two domain names (.home and .corp) were identified as so “high risk” that they were permanently reserved for internal use. An additional 25 gTLD names were not eligible for the APD, having been identified as “high risk” and requiring specialized assessment before implementation: .box, .business, .casa, .cisco, .comcast, .dev, .family, .free, .google, .inet, .log, .mail, .network, .office, .orange, .philips, .prod, .sfr, .site, .taobao, .taxi, .web, .work, .world and .zip. Eventually, .mail was put on the permanently reserved list, based on the JAS Final Report, issued in June 2014. (See the final report here.)

ICANN also implemented a public awareness campaign regarding name collision within the technical community and created a list of resources and problem reporting page. ICANN’s position is that it will initiate an emergency response only where there is a reasonable belief that name collision will endanger human life. We are not aware of any scenarios where such a report has been submitted.

Mitigating the Risk
On July 30, 2014, following the JAS Final Report, ICANN’s New gTLD Program Committee approved the Name Collision Occurrence Management Framework, which directs new gTLD registries regarding how to mitigate the risk of name collision. Aside from the three permanently reserved strings, the rest may now proceed, including those classified as “high risk.” Each gTLD applicant and new gTLD registry that has entered a gTLD contract (“registry agreement”) with ICANN has received a Name Collision Assessment Management addendum to the contract stipulating how to check for potential occurrences of name collision and how to release blocked SLD names that were identified as potential name collisions in a previous study.

Each registry operator (new gTLD applicant or registry) is not to release any of these blocked names for a period of 90 days, when testing for name collision. The testing framework is referred to as “controlled interruption” and alerts system administrators to a conflict between a private and public DNS record using a special IP address. The appearance of the special IP address in system logs will assist registry administrators in making necessary site name changes within their networks. gTLDs that are delegated on or after August 18, 2014, will receive a waiver to use wild-card records for purposes of controlled interruption testing measures only. During this period, only the SLD name nic can be delegated. gTLDs that have already been delegated and have already activated names (other than nic) under the TLD must run controlled interruption testing for each SLD name that they wish to release from their block list. If no occurrences of name collisions are reported within the 90 days of testing, the new gTLD registry is allowed to make all the names on the block list available for registration. Further, registry operators are to be reachable and respond to any reports of name collision within the first two years of the lifetime of a TLD, which applies to .brand names as well.

Unresolved Issues
Still to be resolved is how the RPMs will be applied to the released names. Typically, a new gTLD will have a “sunrise period,” when only registrants with trademarks filed in the Trademark Clearinghouse may apply for a do-
As a result of objections raised by the community, including by INTA, ICANN has been put on notice that brand owners are not satisfied with this proposed course of action. ICANN solicited public comments on alternative proposals for the appropriate RPMs for names removed from registry SLD name block lists, where the registry has already delegated and completed its sunrise period.

ICANN has addressed the RPMs in a name collision context, referencing the various concerns of the trademark stakeholder groups, including INTA and ICANN’s own Intellectual Property Constituency (IPC).

INTA’s position, as stated in a letter to ICANN on July 18, 2014, is that ICANN must offer a secondary sunrise period to trademark owners for all new gTLDs apart from the closed .brand TLDs, where no sunrise periods are needed, as all domain names will be registered to the gTLD registry (the brand) itself. (The letter, which was prepared by the INTA Internet Committee’s gTLD Registry Issues Subcommittee, may be accessed here.)

INTA stresses that the sunrise period and Trademark Claims Service, the Uniform Domain-Name Dispute-Resolution Policy (UDRP) and the new Uniform Rapid Suspension System (URS) are “complementary” and not substitutes for one another. It further emphasizes that “the goals and benefits of preventative measures, such as Sunrise, are not the same as the goals and benefits of curative measures.”

Support from Outside Constituencies

Remarkably, the Registrars Stakeholder Group (RySG), the IPC and the business constituency (BC)—all stakeholders at ICANN—have submitted a joint letter proposing an alternative mechanism to protect trademarks when the blocked names are released. Among their recommendations:

- “Any name on the name collision block list not reserved by the registry would have to be subject to some period of 30 days or more in which registrations were available exclusively to SMD holders.” (SMD signifies a Signed Mark Data Holder, which is a trademark owner that has filed its trademark in the Trademark Clearinghouse. Each filed trademark is given an SMD code qualifying the owner to file for domain name registrations during the sunrise period.)
- “ICANN and/or the TMCH would develop procedures by which appropriate notification of these registration periods could be made to trademark holders. We expect that ICANN would work with the community to develop appropriate notification requirements and mechanisms.”

The released names “would NOT be subject to the requirement of an additional 90-day Claims period.”

The letter echoes INTA’s request for a secondary sunrise period. The three groups, like INTA, do not believe that the Trademark Claims Service alone (as had been proposed by ICANN) is sufficient to provide trademark owners with a fair set of RPMs, as the Claims Service will inform only those trademark holders that have registered with the Trademark Clearinghouse once a domain name is already registered to a third party. In addition to these recommendations, ICANN stakeholder groups further take into consideration that a Claims notification requirement would, potentially, be a financial and technical burden for the registry operators to implement and may not be needed, as the expected number of registrations is so limited that a manual or simple process should be sufficient.

A Clear Message

Jointly, the two letters send a clear message to ICANN: that a sunrise (or similar) process for those domain names, many of which are identical to trademarks, must be mandatory for all open gTLDs. Further, the letters indicate that ICANN should help to implement a direct notification of the release of these blocked names to those who have filed with the Trademark Clearinghouse, so that brand owners can plan for the application of their names in these various new sunrise phases. Many brand names were blocked because of the results of the risk assessment for name collision. Some may be released as early as November 2014.

In a time when ICANN’s accountability is being questioned, not only by many brand owners but also by governments, the decision by ICANN to allow the release of name collision blocked names before having found a solution for proper RPMs would appear to cast doubt on its commitment to reliability and security in the public interest.

INTA’s Internet Committee has been closely following these issues, submitting comments and participating in working groups to protect the interests of brand owners and, ultimately, the consumer. INTA submitted additional comments on the treatment of RPMs for the name collision block-listed names during the public comment reply period. That public comment period closed on October 7, 2014, and we await ICANN’s decision. It is hoped that ICANN will accept the widely supported joint RySG, IPC and BC approach, eliminating much of the risk that brand owners would otherwise face upon the release of the name collision block lists.
Issues to Consider in Assignments of U.S. Trademark Applications and Registrations

Miriam D. Trudell
Sheridan Ross P.C., Denver, Colorado, USA
INTA Bulletin—Features Subcommittee

There are important issues to consider when assigning U.S. trademark applications and registrations. U.S. trademark law has specific requirements for trademark assignments that must be met in order for the assignment to be valid. This article provides an overview of the requirements applicable to all trademarks, as well as the special requirements for assignment of intent-to-use–based trademark applications and of applications and registrations based on a Madrid Protocol filing. It is critical that assignments of U.S. trademarks meet these requirements. If they do not and the assignment is challenged by a third party in a trademark opposition or cancellation proceeding or in trademark court litigation, the underlying application or registration can and will be invalidated.

Requirements for All Assignments

U.S. trademark law recognizes that the value of a trademark lies in the goodwill associated with the trademark. “Goodwill” is well defined as representing “the desirability of the goods or services which are identified by the trademark or service mark.” 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 2:15 (4th ed. 2014) (hereinafter McCarthy). A trademark is not worth much without the consumer recognition it represents. To that end, Section 10 of the U.S. Trademark Act (Lanham Act) requires that any trademark application or registration must be assigned in writing together with the goodwill of the business in which the mark is used in order to be valid, or with the part of the goodwill connected with the use of/symbolized by the mark.

See 15 U.S.C. § 1060(a). This requirement applies regardless of the filing or registration basis. This includes both a corresponding foreign registration under Section 44 of the Lanham Act and an International Registration designating the United States under Section 66 of the Lanham Act. For the avoidance of doubt, the term “goodwill” should be included in all written assignments of U.S. trademarks. In addition, it is good practice to include the applicable U.S. trademark registration or application numbers in all written assignments. Suggested language is as follows:

Assignor does hereby assign to Assignee all right, title and interest in and to U.S. Reg. No. ____________, together with the goodwill of the business symbolized by the trademark.

Additional Requirements for Assignments of Intent-to-Use Trademark Applications

With respect to an intent-to-use trademark application filed under Section 1(b) of the Lanham Act, the legal requirements of the assignment depend upon whether the trademark owner has begun to use the underlying mark. If use has begun, that owner must file an allegation of use with the U.S. Patent and Trademark Office (USPTO) in connection with the application. The allegation of use can be in the form of either an Amendment to Allege Use (which is submitted after a Notice of Allowance issues). Once the allegation of use has been filed in connection with the application, the assignment rules are the same as those for use-based trademark applications and registrations, namely, the U.S. trademark application must be assigned in writing together with the goodwill of the business in which the mark is used in order to be valid. See 15 U.S.C. § 1060(a)(1).

If, however, the trademark owner has not yet begun to use the mark, then U.S. trademark law requires that the assignment be made to a successor to the business of the applicant, or portion thereof, to which the mark pertains. See 15 U.S.C. § 1060(a)(1). Therefore, a trademark that is not yet in use in the United States and that is the subject of an intent-to-use–based U.S. trademark application must be transferred together with the part of the ongoing and existing business connected with the mark. The intent of this provision is to prevent trafficking in or profiting from the sale of an intent-to-use trademark application. See Clorox Co. v. Chemical Bank, 40 U.S.P.Q.2d 1098 (T.T.A.B. 1996). “That is, one who merely has an intention to use a mark in a business not yet established really has no ‘trademark’ to sell.” 3 McCarthy § 18:13.

Suggested language for an assignment of an intent-to-use trademark application is as follows:

Assignor does hereby assign to Assignee the mark in U.S. Trademark Application No. ____________, together with the goodwill of the business symbolized by the trade-

Imitation May or May Not Be Flattery

Food and beverage industry manufacturers and large national supermarket chains share a mutually dependent relationship, and either would likely be reluctant to damage it in a full-blown dispute over a “look alike” product. To better understand the views of both sides — and to know where and when to draw the line — see “Trade Dress in the Food and Beverage Industries: Manufacturer’s and Retailer’s Views” by Mark Hiddleston, Elkington and Fife LLP, London, United Kingdom, and Richard Young, Quarles & Brady LLP, Chicago, Illinois, United States, in INTA’s exclusive member service Industry Perspectives series.

Visit inta.org/IndustryPerspectives
mark. This application is being assigned as part of the entire business or portion thereof to which the mark pertains, as required by Section 10 of the Trademark Act, 15 U.S.C. § 1060.

Additional Requirements for Assignments of Madrid Protocol Filings
As with intent-to-use trademark applications, additional requirements apply to assignments of Madrid Protocol filings, which are U.S. trademark applications and registrations filed under Section 66 of the Lanham Act as extensions of protection from preexisting international applications or registrations filed through the World Intellectual Property Organization (WIPO). Specifically, Section 72 of the Lanham Act, 15 U.S.C. § 1141, states that an extension of protection to the United States of an International Registration may be assigned, together with the goodwill associated with the mark, only to a person who is a national of, is domiciled in or has a bona fide and effective industrial or commercial establishment in a country that is either (1) party to the Madrid Protocol or (2) a member of an intergovernmental organization that is a party to the Madrid Protocol. See USPTO, Trademark Manual of Examining Procedure (TMEP) § 1904.06. Furthermore, the owner of an International Registration that designates the United States should also be aware that the transfer of goodwill together with the trademark is required, as it is required with the transfer of all U.S. trademark registrations.

Challenging the Validity of Trademark Assignments in the United States
The validity of an assignment of a U.S. trademark application or registration usually will not be reviewed by the USPTO Assignment Division, because the filing and acceptance of an assignment with the USPTO Assignment Division only confirms that the filer met the USPTO’s minimum filing requirements. The filing and acceptance of an assignment with the USPTO does not confirm the validity of the document. See 37 C.F.R. § 3.54. As the validity of assignments is not examined by the USPTO, the validity may be challenged by a third party when a trademark opposition, cancellation or infringement claim arises.

Challenges Based on No Transfer of Goodwill
If ownership of a U.S. trademark is transferred without the associated goodwill, the transfer is determined to be an “assignment in gross” and can result in an assignee’s losing rights to the assigned trademark. See Sugar Busters LLC v. Brennan, 177 F.3d 258, 265, 50 U.S.P.Q.2d 1821, 1824 (5th Cir. 1999). In Sugar Busters, the court of appeals recognized that a transfer of goodwill not only requires a recitation of the required language but also requires that the assignee use the mark on a product or for a service having substantially the same characteristics as the assignor’s services. The U.S. trademark registration that was assigned covered retail store services featuring products and supplies for diabetic people, and the assignee used the mark on diet books only. As such, the court of appeals ruled that there was no goodwill transferred in the assignment in question because the assignor’s SUGAR-BUSTERS retail store services were not sufficiently similar to the assignee’s SUGAR BUSTERS! book to prevent consumer confusion. Thus, the court upheld the invalidation of the underlying registration.

An “assignment in gross” may also be found when the assignor abandons a mark prior to the assignment. In Osmosis Technology, Inc. v. GE Osmonics, Inc., 2004 WL 725457 (T.T.A.B. Mar. 30, 2004), the court ruled that although the written assignment in question included a recitation of a transfer of goodwill, there was no transfer of goodwill because the assignor had abandoned rights in the trademark as a result of its non-use of the mark for six years and no intent to resume use. Therefore, the petitioner could not establish priority from the assignment of an abandoned mark, and its petition to cancel was denied.

It is interesting to note that the petitioner’s registration was not invalidated by the proceeding, as invalidation was not pled by the opposed party.

Challenges Based on Transferring an ITU Application Apart from the Underlying Business
With regard to an intent-to-use U.S. trademark application in which proof of use has not yet been submitted, if ownership of a trademark is transferred without the ongoing and existing business to which the mark pertains, this results in the U.S. trademark application’s being void. If the application itself is void, it is subject to opposition by a third party based on its being void and consequently the resulting registration is subject to cancellation by a third party on the basis of being void. This result was confirmed in the recent case of Central Garden & Pet Co. v. Doslacil Manufacturing Co. 108 U.S.P.Q.2d 1134 (T.T.A.B. 2013). There, the Trademark Trial and Appeal Board cancelled a U.S. trademark registration because the underlying application was an intent-to-use application in which use had not yet been submitted and was transferred without the portion of the ongoing and existing business to which the mark pertained. Therefore, the assignment was “contrary to the anti-assignment provision of Trademark Act § 10.”

See “Issues to Consider” on page 12

Avoid Regrets Further Down the Line
Settlement and coexistence agreements are intended to solve problems, not cause them. All too often, though, oversights can result in an arrangement’s unraveling.

Find out how to minimize the likelihood of recurring disagreements in “Settlement & Coexistence Agreements” in INTA’s Practitioners’ Checklists series, available exclusively to INTA members.

Visit www.inta.org/practitionerschecklists
108 U.S.P.Q.2d at 1150. Furthermore, although the trademark was actually in commercial use at the time of the assignment, the TTAB found this to be irrelevant because the Lanham Act restricts assignments until the filing of an allegation of use with the USPTO. Id. at 1147.

There was a similar finding in Creative Arts by Calloway, LLC v. Christopher Brooks, d/b/a/The Cab Calloway Orchestra, Civil Action No. 09-CIV-10488 (S.D.N.Y. Dec. 27, 2012). In Creative Arts, the widow of the late jazz musician Cab Calloway, Mrs. Zulme Calloway, filed an intent-to-use trademark application for the mark CAB CALLOWAY. Shortly after filing the application, and prior to filing proof of use, Mrs. Calloway assigned the application to a company formed by Mrs. Calloway and her children. The assignment did not include a transfer of the ongoing and existing business to which the trademark pertained. The district court concluded that because the assignment of the intent-to-use trademark application did not include a transfer of the business or portion thereof to which the mark pertained, the transfer was void and the underlying trademark application was invalid.

On the other hand, in the case of Philip Restifo v. Power Beverages, LLC, Opposition No. 91181671 (T.T.A.B. Sept. 21, 2011), although there was no specific language in the assignment document that stated the transfer included the “ongoing and existing business” to which the intent-to-use application pertained, the Trademark Trial and Appeal Board reviewed the transfer language and other documents I the record and inferred that such a transfer occurred. As a result, the assignment of an intent-to-use trademark application was found to be valid because it included a transfer of the business to which the mark pertained. The TTAB in the Central Garden decision did not address Restifo, but Restifo can be distinguished from Central Garden in that the TTAB in Restifo had additional documents that showed that there was a relationship between the assignor and assignee, including that the assignor was one of the founding members of the assignee company, that helped prove a transfer of the business. On the other hand, in Central Garden, there was no additional evidence in the record to infer a transfer of the business. The case of Amazon Technologies, Inc. v. Wax, 95 U.S.P.Q.2d 1865 (T.T.A.B. 2010), points out that whether an assignment of an intent-to-use U.S. trademark application must meet the requirements of a transfer of the business depends on whether the transfer is truly an assignment. In Amazon, the Board did not invalidate an intent-to-use trademark application in which one joint applicant assigned to the other joint applicant his rights in the trademark, even though the assignment did not include a transfer of the business to which the mark pertained. That was because the transfer was ruled not an assignment that lacked a transfer of the business, but, rather, a relinquishment of rights by one joint owner.

In conclusion, assignments of U.S. trademarks should be drafted and reviewed with attention to detail. What is and is not included with the transfer of the mark itself, as well as to whom the mark is transferred, may jeopardize the validity of the transfer, and the validity of the application or registration being assigned. Likewise, defendants in TTAB proceedings and civil litigation should closely scrutinize the assignment history of plaintiffs trademarks and not hesitate to challenge any improperly assigned trademark.

Issues to Consider Continued from page 11

Allegations of Fraudulent Procurement and Maintenance of Federal Registrations Since In re Bose Corp.
Theodore H. Davis Jr. and Lauren Brenner

Trademark Licensing in Canada:
The Control Regime Turns 21
Sheldon Burshtein

Canada’s Ill-Conceived New “Trademark” Law: A Venture into Constitutional Quicksand
Daniel R. Bereskin, Q.C.

...and much more!
ARGENTINA  INPI Creates a New Registry of Licenses

The National Institute of Industrial Property (INPI), by means of Resolution No. 117/2014 of June 9, 2014, has created a new registry of licenses for patents, trademarks, utility models, industrial models and designs, and technology transfer agreements. The registry will be administered by the Technology Transfer Department of INPI.

Registration of license agreements with the registry is voluntary. A registered license agreement will become enforceable vis-à-vis third parties, and, as from the registration date, any third party will be considered to be aware of the existence of the license agreement.

BRAZIL  BPTO Now to Issue Only Digital Trademark Certificates of Registration

In accordance with Resolution No. 136/2014, published in Official Bulletin No. 2,282 of September 30, 2014, the Brazilian Patent and Trademark Office (BPTO) now will issue trademark certificates of registration only in a digital format, digitally signed. The digital certificates will be accessible at the BPTO’s website.

In addition to making the issuance of the certificates faster, more efficient and transparent, the measure is expected to reduce environmental impact.

EUROPEAN UNION  General Court Rules on CTM WASH & COFFEE

In May 2010, the German firm BSH Bosh und Siemens Hausgeräte GmbH filed an application for the registration as a Community trade mark (CM) the word mark WASH & COFFEE, for goods and services in Classes 25, 37 and 43, including “washing of laundry, services of a laundromat, provision of food and drink.” On examination at OHIM (Office for Harmonization in the Internal Market) the application was rejected for Classes 37 and 43 by the examiner on absolute grounds, the reasoning being that the slogan “Wash & Coffee” was devoid of distinctive character. The applicant’s appeal against the examiner’s decision was rejected by the OHIM Fourth Board of Appeal. The applicant then filed a further appeal with the European General Court.

The General Court found that in order to assess whether the mark applied for was more than a slogan in the classical sense, it was necessary to examine whether the mark had an unusual or ambiguous meaning regarding the syntactic, grammatical, phonetic and/or semantic rules of the language concerned that would cause the relevant consumers to come to a different association. In the case at hand, the OHIM Board of Appeal had correctly assumed that WASH referred to services in Class 37 and COFFEE to services in Class 43. Therefore, the Board of Appeal had correctly assumed that, in an overall assessment of the mark in its entirety, consumers would understand the term “Wash & Coffee” as the general statement that the services in question were offered together, in the sense that services of a laundromat were connected with the offer of coffee.

The Court rejected the applicant’s argument that the combination of those services was unusual. That consumers might not yet have encountered combined services of this type did not change the fact that they would immediately understand the meaning of the advertising slogan “Wash & Coffee.” Moreover, the slogan did not show any originality or conciseness that would allow consumers easily to remember it. Therefore, consumers could not determine the commercial origin of the services concerned. As a consequence, the mark was devoid of distinctive character and had to be rejected. (BSH Bosh und Siemens Hausgeräte GmbH v. OHIM, Case T-5/12 (GC (Eighth Chamber) July 14, 2014).)
EUROPEAN UNION “Retailing of Services” Ruled an Acceptable Service

Although “retailing of goods” has been capable of protection as a service in the European Union for some time, “retailing of services” has not previously been accepted in the same way. That is set to change following a recent decision by the Court of Justice of the European Union (CJEU).

In September 2011, Netto Marken-Discount AG & Co. KG applied to register the logo shown above as a trademark in Germany. The application was for the following services:

Class 35: Services in the retail and wholesale trade, particularly the bringing together, for the benefit of others, of a variety of services enabling customers conveniently to purchase those services, particularly services provided by retail stores, wholesale outlets, through mail order catalogues or by means of electronic media, for example websites or television shopping programmes, in relation to the following services: in Class 35: Advertising; business management; business administration; office functions; in Class 36: Issue of vouchers or tokens of value; in Class 39: Travel arrangement; in Class 41: Entertainment; in Class 45: Personal and social services intended to meet the needs of individuals.

The German Patent and Trademark Office (Deutsches Patent- und Markenamt (DPMA)) rejected the application on the basis that the services listed could not “be clearly distinguished from other services in either their substance or [their] scope.”

Netto brought an action before the German Federal Patent Court (Bundespatentgericht) for annulment of the DPMA’s decision. That court noted that the CJEU had never ruled on whether retail trade in services was a valid service. Questions were then referred to the Court of Justice for a preliminary ruling on this point.

The CJEU held that retail trade in services (which it described as “bringing together services so that the consumer can conveniently compare and purchase them”) can be an acceptable service, provided the application is “formulated with sufficient clarity and precision so as to allow the competent authorities and other economic operators to know which services the applicant intends to bring together.” (Netto Marken-Discount AG & Co. KG v. Deutsches Patent- und Markenamt, Case C-420/13 (CJEU (Third Chamber) July 10, 2014).)

Following this decision, it should now be possible for businesses to obtain protection for the retailing of services in the EU, provided they explain the substance and scope of their services clearly enough.

Contributor: Mark Holah  
Sipara, Oxford, United Kingdom  
Verifier: Tom Albertini  
J A Kemp, London, United Kingdom

Both are members of the INTA Bulletin Law & Practice—Europe & Central Asia Subcommittee.

India

High Court Lifts Blanket Ban on “Statement of Use” Amendment; Registrar Must Decide Every Case on Its Merits

In an important development concerning a recent order of the Controller General of Patents, Designs and Trademarks, the High Court of Delhi struck down Clause No. 3 of Office Order No. 16 of 2012-2013. This clause provided that “[n]o request for amendment shall be allowed which seeks substantial alteration in the application for registration of a trademark. The substantial amendment in the trademark, proprietor details, specification of goods/services (except deletion of some of the existing items), [and] statement as to the use of mark shall not be permitted.” (Intellectual Property Attorneys Association v. Union of India & Anr. [W,P.(C). No. 3679/2014 & CM No. 7455/2014]).

The question that arose for consideration in the present petition was, “When the Statute... confers on the Registrar of Trademarks the power to permit the correction of ‘any error’ in or in connection with the application or to permit an amendment of the application, whether the Controller General by a general order in the nature of a guideline can direct as to which of such amendments shall not be allowed.”

While the court overruled the blanket ban on any amendment (particularly the amendment of the date of first use), it also held that the Registrar of Trademarks must decide, on a case-by-case basis, whether the amendment claimed (even if to postpone the date of commencement of use of the applied-for trademark) is merely an after-thought intended chiefly to meet the objection filed to registration, and thus an abuse of the system. However, the court said, there can be no general order that such amendments will never be allowed.

Hence, the court allowed the writ petition, which was in the nature of a Public Interest Litigation (PIL), and held that the Registrar of Trademarks must render a decision on applications for amendment to an application for registration of a trademark on a case-by-case basis.

While the court has provided relief to brand owners and practitioners by lifting the blanket ban on amendments, care must still be practiced to provide a correct statement of use, as such amendments will not be allowed as a matter of right.

Contributor: Swati Bhano  
Chadha & Chadha, New Delhi  
Verifier: Gaurav Miglani  
Worldwide Intellectual
**SOUTH AFRICA** Food Labeling Changes to Affect Registered Trademarks

The South African Department of Health has published draft regulations relating to the labeling and advertising of foods in terms of the Foodstuffs, Cosmetics and Disinfectants Act (Act No. 54 of 1972). These regulations strive to ban any form of puffery, false and misleading labeling, advertising and presentation of food. They include, *inter alia*, the following:

1. **Prohibition of the use of the words “health” and “healthy”** and any words/logos/pictorials with a similar meaning, except in the case of the fortification logo for food vehicles as regulated;

2. **Prohibition of the use of the words “wholesale” and “nutritious”** or any words/logos/pictorials with a similar meaning; and

3. **Regulation by the State of the use of trademarks incorporating the words “fresh,” “natural,” “nature’s,” “pure,” “traditional,” “original,” “authentic,” “real,” “genuine,” “home-made,” “farmhouse,” “hand-made,” “selected,” “premium,” “finest,” “quality” or “best.”**

The draft regulations are intended to have a retrospective effect. This will deal a death knell to registered trademarks containing prohibited words, as they will be unusable. The draft regulations clearly state that any trademark (registered or not) that consists of a prohibited word should never be used.

Regulation 48(2) of the draft regulations further provides that there are certain statements that are permitted only if they comply with certain criteria. Such statements include, *inter alia*, the words “fresh,” “nature’s,” “traditional” and “original.” “Fresh” may not be used in relation to highly pasteurized milk or frozen or processed foods if processed ingredients are used. This endangers trademarks such as COUNTRY FRESH for ice cream and DEWFRESH for yogurt, since these products ordinarily include processed ingredients.

Terms such as “country” or “farm” may be regarded as misleading if the food products to which they are applied have not been produced on what the average consumer would understand to be a farm. This endangers trademark registrations such as FARMFRESH for high-temperature pasteurized milk and FARMHOUSE for ice cream.

**UNITED ARAB EMIRATES** Trade Names Regulated in Abu Dhabi

The Abu Dhabi government recently issued a new trade names law, Administrative Directive No. 7 for the Year 2014 Regulating Trade Names in the Emirate of Abu Dhabi. Abu Dhabi is an Emirate (state) in the United Arab Emirates, which is a federal union with both federal and local (Emirate) legislation. The Directive, which is local legislation, applies to businesses setting up in Abu Dhabi and using trade names to identify their business. This law regulates which trade names can be or cannot be registered in Abu Dhabi, and is similar in fashion to the provisions on prohibitions and restrictions regulating registration of trademarks under the Federal Trademarks Law.

The Directive addresses the ever-existing conflicts between trademarks and trade names in the country, which is a continuing weakness in the protection system in that the two databases were never cross-checked regarding trademark or trade name clearances and this resulted in conflicts. For a long period of time, trademark owners suffered from their marks’ being registered and used as trade names, because trade names are not published and there is no opportunity to file opposition, as there is for trademarks. The Directive, however, specifically prohibits registration of trade names that are identical or confusingly similar to locally or internationally registered trademarks. That is, both well-known marks and locally registered trademarks will prevent the registration of identical or similar trade names absent the authorization of the trademark owner. Consequently, the Directive is expected to eliminate the conflicts between future applications for trade names and existing trademarks.

**When You Need to Know**

Whether undertaken as an assessment of trademark rights or an evaluation of the adequacy of internal management systems, a trademark audit has to be thorough to offer an accurate picture of a company’s brand name activity. For tips on navigating the myriad details associated with the exercise, see “Trademark Audits” in INTA’s exclusive Practitioners’ Checklists series.

Visit [www.inta.org/practitionerschecklists](http://www.inta.org/practitionerschecklists)
UNITED STATES

Board Allows Opposer Opportunity to Cure Signatory Defect in Limited Circumstances

In a precedential decision, the Trademark Trial and Appeal Board (TTAB or Board) held that under limited circumstances, a party may have the opportunity to cure a signatory defect in documents filed through the Electronic Systems for Trademark Trials and Appeals (ESTTA) after the applicable filing deadline has passed. *Birlinn Ltd v. Angus Stewart*, Opposition No. 91214145 (T.T.A.B. Sept. 3, 2014).

The subject proceeding commenced when an individual in the United Kingdom filed two requests for extensions of time and a timely notice of opposition through ESTTA on behalf of opposer Birlin Limited. The TTAB, automatically through ESTTA, granted both extension requests and initiated the notice of opposition. Applicant Angus Stewart then filed a motion to dismiss the opposition on grounds of insufficient service of process, arguing that the proceeding should be dismissed because the opposer’s documents were filed and served by an individual unqualified to practice before the U.S. Patent and Trademark Office (USPTO). Subsequently, an attorney authorized to practice before the USPTO filed an entry of appearance, a brief contesting the motion to dismiss and an amended notice of opposition on the opposer’s behalf. Notably, the only differences between the original notice of opposition and the amended notice were the signatory and the certificate of service.

The TTAB first noted that the issue in this proceeding was not whether service was proper. Instead, the issues were whether the initial documents filed on the opposer’s behalf were signed in accordance with the Trademark Rules of Practice, and if not, whether the opposer cured this defect within the time allowed by the Rules. On the first issue, the Board determined that the opposer’s initial signatory did not qualify as an “attorney” or “authorized representative” under the relevant Trademark Rules, and thus it held that the extension requests and initial notice of opposition were not properly signed. Turning to the second issue, the Board cited Trademark Rule 2.119(e), which states in part that “an unsigned paper will not be refused consideration if a signed copy is submitted to the [USPTO] within the time limit set in the notification of this defect by the [USPTO].” Finding that the rule was applicable to improperly signed filings as well as unsigned filings, the TTAB applied it to the at-issue documents and held that, while the amended notice of opposition effectively cured the defect in the original notice, the extension requests remained uncured. Disagreeing with the applicant’s position that the opposer’s defect was incurable because the time for filing each of the initial documents had expired, the Board then allowed the opposer 20 days from the mailing date of its order to file properly signed extension requests, in accordance with Rule 2.119(e). The TTAB warned, however, that if the opposer failed to file properly signed extension requests within that time period, the proceeding might be dismissed and that until such time its ruling on the motion to dismiss was deferred.

The TTAB emphasized the narrow application of its holding, explaining that its decision to allow the opposer the opportunity to cure its improperly signed filings after the applicable deadlines was limited to the issues presented here and in no case would apply when there was evidence of intentional misconduct. Finally, the Board referenced another proceeding between the parties currently pending in the United Kingdom, and it required the opposer to, within the same 20-day time period, file and serve a notice with information related to the other proceeding for the TTAB’s review and consideration.

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.
Save the date for
INTA’s 137th Annual Meeting
May 2–6, 2015 | San Diego, California, USA

Look forward to these highlights:

• Almost 300 customized educational offerings including 33 general educational sessions, more than 250 table topics, users’ group meetings with leaders from several national and regional trademark offices, a 2-day Course on International Trademark Law and Practice with 18 course segments, a 2-day Basic Mediation Training, the Trademark Administrators Brunch and more.

• Special offerings for IP professionals at corporations of all sizes, including the In-House Practitioners Luncheon and Seminar, the In-House Practitioners Reception and a new series of Industry Exchanges.

• New hassle-free ways to conduct business in the Convention Center by booking one of 4 different types of meeting spaces.

• More than 30 official networking events, including the INTA Gala, the Sunday evening Opening Ceremony and Welcome Reception, the Grand Finale and a new array of smaller networking excursions.

• Over 100 committee, project team and Global Advisory Council meetings.

• Exhibition hall with more than 100 exhibitors and numerous sponsorship opportunities to help you spread the word about your company and make new connections.

We expect more than 9,500 trademark professionals from all over the world to register!

www.inta.org/2015AM

Exhibitions and Sponsorship
To inquire about sponsorship or exhibition opportunities for INTA’s events, visit www.inta.org or email sponsorship@inta.org

www.inta.org
Visit the INTA Bulletin on www.inta.org to download the current issue or to search issues from January 1, 2000, to the present.

Email Addresses
INTA Bulletin: bulletin@inta.org
Member Services: memberservices@inta.org
Programs: meetings@inta.org
Job Bank: jobbank@inta.org

Policy & Advocacy: tmaffairs@inta.org
Public Relations: publicrelations@inta.org
Publications: publications@inta.org
Roundtables: roundtables@inta.org