Registrants were treated to a highly-entertaining mock trial yesterday, featuring a feud over surf board designs, an unreliable witness and even an interruption for take-out food.

The trial before the Honorable Irma Gonzalez, the Retired Chief Judge of the United States District Court for the Southern District of California, was the fictional Dolphin Surf Co v Porpoise Surf Boards. A respectful INTA audience all rose for the judge.

The mock trial, featured in the session Here Comes the Judge: See What Happens During a Mock Preliminary Injunction Hearing, concerned two similar surfboards. Both shared a fish tail shaped end, blue and white coloring, and an oval design with a stripe, two rectangles and the company name in the middle.

Arguing for the plaintiff Dolphin was Nancy Rubner Frandsen of Baker & Hostetler, who demanded Porpoise discontinue sale of its board. “The defendant purposely—or should I say porpoise-ly—chose a trade dress and mark that copied my client’s,” began Frandsen. “There can be no doubt that the defendant is intentionally infringing my client’s intellectual property by its choice of trade dress.”

She revealed that one customer had tried to return a Porpoise board to Dolphin and a potential customer had rung Dolphin and tried to buy a Porpoise board.

Arguing for the defendant Porpoise was Barry Cohen of Royer Cooper Cohen Braunfeld, who said the dispute came down to two words that were not similar. “Plaintiff inaccurately believes that there must be confusion among these two marine mammals—but they are two different species, like cats and dogs,” said Cohen. “Dolphins and porpoises should be allowed to peacefully co-exist as surf boards.”

So help you J. Scott Evans
Enter the witnesses, who were sworn in with the oath: “Do you solemnly swear to tell the truth, the whole truth, and nothing but the truth so help you J. Scott Evans?”

Dolphin owner Ms. Johnnie Utah (Debra Duguid of Terex), a respected former FBI agent, revealed her reaction “was utter shock” when she saw the Porpoise board. She said Dolphin had sold 200 of its boards in the past two years for $1,000 each.

Under cross-examination, she revealed... Continued on page 4.
Playing for leverage in multi-jurisdictional disputes

Are you ready for a trademark battle pitched across multiple continents? Yesterday’s session Have Dispute Will Travel: Managing Multi-Jurisdictional Trademark Disputes showed what such an endeavor may look like and why coordination between jurisdictions is key.

The panelists presented a case study involving a fictitious guitar company, Hendrix Guitars, with each speaker playing a different role: Hendrix’s CEO, its in-house counsel, and its outside counsel in Europe and Asia.

Hendrix owns the ALLADIN mark in the United States, a Community Trade Mark in Europe and a mark in Hong Kong, where it has a sourcing office to work with its original equipment manufacturer (OEM) in China. Its United Kingdom-based rival Bowie owns the mark ALLADIN SANE in the UK, Germany and China. Bowie’s marks in Germany and the UK predate Hendrix’s European Community mark.

Hendrix has traditionally sold in the U.S. while Bowie has been selling in the UK and Germany, but now both companies are keen to expand into each other’s markets. Bowie recently entered into a deal with the Iggy Pop Company in Detroit to distribute its products in the U.S.

Anessa Owen Kramer of Honigman Miller Schwartz and Cohn acted as Hendrix’s CEO and asked her in-house counsel Jeremy Kaufman of Fox Entertainment Group to devise a strategy for dealing with Bowie. She has no interest in entering into a co-existence agreement.

Multiple options

Owen Kramer’s legal advisors laid out the various options in their jurisdictions. For example, Kaufman observed that in the U.S., there is usually a correlation between the aggressiveness of the response and its cost. An infringement suit would be the strongest response, but would rack up the bill. Challenging Bowie’s registrations at the USPTO’s Trademark Trial and Appeal Board would be less expensive, but the potential remedies would be much more limited. Another option, filing a preliminary injunction, can give it leverage against Bowie in other jurisdictions.

Redfearn explained, the issue of whether manufacturing for export markets constitutes use of the mark in China is still unsettled, though he noted that several cases have found that it does not. The panelists emphasized that coordination is key in disputes that span multiple countries. An argument made in one country may have consequences in others. For example, Dickerson warned that getting a declaration of non-infringement in the UK may have consequences in Germany and China.

Similarly, a well-planned action in one country can benefit your position in another. Dickerson and Kaufman pointed out that given that Hendrix’s position is strongest in the U.S., achieving a positive result there, such as securing a preliminary injunction, can give it leverage against Bowie in other jurisdictions.

Seeing these legal actions in a global business context is essential to a commercially successful resolution. As Owen Kramer pointed out, even though Hendrix’s CEO may not wish to settle, the reality is that often these disputes and actions in various countries are really a way for a company to improve its negotiation position and gain leverage for an eventual global agreement between the companies.

Mark your calendar for INTA’s 2015 European Meeting on Geographical Indications—Interplay between Trademarks, Geographic Names and Indications—to take place in Rome, Italy on December 10-11.

Geographic indications are a central topic of debate in current international trade agreement talks and Europe is facing important policy choices on how to protect the names of products that have a link with a specific geographic place.

Join INTA’s exports from around the world including representatives from the European Commission; Hungarian IP Office; OHIM, Mexican Institute of Industrial Property, WIPO and WTO to gain insight into the economic benefits of Geographic indicators as well as brand owners strategies and potential benefits of association with a PGI or PDO.

Details of the educational program and networking opportunities will be available soon and registration will launch in September 2015 on the INTA website.

Visit www.inta.org/GI2015
In 2012, INTA launched the Unreal Campaign to raise awareness with teenagers (14-18 years old) about the dangers of counterfeiting and the importance of trademarks. This year, the Unreal Campaign has been accelerating its pace: it has reached 800 students from January to May in classrooms and at events in Mexico, New York and Florida.

On April 26 and 27, the Unreal Campaign participated in the 2015 DECA International Conference in Orlando (Florida, USA). This conference was attended by 18,000 students and teachers who participated in competitions and emerging leader courses. INTA thanks member Rosa Jimenez (Sea World, USA) for sharing her intellectual property experience with a presentation to 600 students. The Unreal team raised awareness with students and teachers at its exhibitor booth showing examples of counterfeit and genuine products.

Members are welcome to get involved or sponsor the next events planned for 2015:
- Alexandria, VA, USA—Exhibitor booth and session at USPTO Trademark Expo (October)
- Panama City, Panama—In conjunction with the Leadership Meeting (November 17–20)
- Austin, Texas, USA—Exhibitor booth and session at DECA Power Conference (Nov 20-22)
- Rome, Italy—In conjunction with INTA’s Interplay between Trademarks and Geographical Indications Conference (December 9)

New in 2016: the Unreal Campaign Committee
Another way to participate is to apply for the Unreal Campaign Committee, new in 2016. Committee members will be responsible for planning and participating in student engagement sessions in schools and at public events. You will also help expand the program internationally, with a particular focus on Latin America. Volunteers for this committee should be prepared for an active experience engaging with young people and may expect to spend several hours each year onsite at schools or other events.

To get involved or for more information, contact Amélie Bernet, Unreal Campaign coordinator, at abernet@inta.org or visit the Unreal Desk at the San Diego Convention Center in the Hall A Lobby.
How color marks transcend borders

Color marks are increasingly important because of globalization. Emma Barraclough preview a session that will address how they can be protected in key markets.

How to get a color mark

Obtaining trademark protection for a color is not easy. To maximize your chances, says Sllobodan Petosovic, you need to plan your strategy carefully. First, consider engaging the services of an experienced trademark attorney who is able to advise on the chances of registration in all of your target markets. Second, ensure that your marketing colleagues work closely with your legal team. “Don’t just follow marketing principles, otherwise it will lead to problems down the road,” he says. “A successful registration of a color or a color combination relies on the joint work of lawyers and marketing professionals.”

Lastly, although many IP owners would like to own the trademark rights to color per se, the legal barriers to ownership are high. “Focus on acquired distinctiveness,” says Petosovic. “You won’t be able to do it overnight but look at the case law and develop a long term strategy in the light of it.”

New opportunities in Japan

One topical example likely to come up during the session is Japan. In line with the international trend for offering IP owners greater protection for non-traditional marks, Japan has amended its law to allow the registration of color marks (along with sound marks, moving marks and hologram marks). The new rules came into force on April 1. But the liberalization of the law on what constitutes a trademark might not open the door to the protection of a single color, say commentators. Vital to determining registrability will be whether color marks have distinctiveness, a test that is likely to be applied strictly and might exclude colors that are only used to improve the function or look of a product.

Around the world, IP owners seeking protection for color marks have had greater success when they use color in combination with other aspects of a mark, because it is often easier to argue that the mark is distinctive. An example of this in practice are applications made by agricultural machinery company John Deere in the United States. The company has denied the color green in a 1982 dispute with Farmhand Inc, after it failed to establish that a secondary meaning exists for the color often referred to in the industry as “John Deere green.” The USPTO did, however, allow the company green and yellow in In re Deere & Co after it provided evidence that established that the colors had become distinctive of the goods.
What’s next for plain packaging?

Trademark practitioners have raised alarms about the threat that plain packaging laws pose to IP rights. In yesterday’s Trademarks and Consumer Protection session, Myrtha Hurtado Rivas of Novartis argued that pharmaceuticals are already subject to similar restrictions.

“Even though medicines and tobacco have nothing in common … what we’re seeing from the regulators’ side is that they seem to be taking a similar approach,” she said.

Australia, which was one of the first countries to introduce plain packaging for tobacco, is once again involved. In November, its Therapeutic Goods Administration, the government body that regulates medicines, closed its public consultation on a draft of Order No. 79, which would impose new packaging and labeling limitations on pharmaceuticals. Like plain packaging for tobacco, Order No. 79 is intended to enhance public welfare. According to Hurtado Rivas, the draft Order would leave essentially no room for brand elements, rather as Australia’s plain packaging law has standardized cigarette packaging and eliminated logos and other elements such as color.

“Logos for pharmaceuticals will pretty much disappear if Order 79 goes through,” Hurtado Rivas warned.

Regulations in other countries also limit the use of trademarks on medicines. For example, many countries require that a molecule’s generic name, the International Nonproprietary Names for a molecule selected by the World Health Organization, be displayed on drug packaging in a certain-sized font. In some countries, the generic name of the molecule is actually bigger and more prominent than the trademarked brand.

Hurtado Rivas also warned the audience about Ecuador’s Decree 522, which was enacted in January. This requires off-patent drugs to be registered and sold as generic. Furthermore the label must clearly state that it is a generic medicine.

INTA’s Board of Directors on Saturday approved a resolution on plain packaging, saying it is detrimental to consumers, trademark owners and competition.

The Internet committee welcomes you

INTA’s Internet Committee will open its doors to all INTA Annual Meeting registrants during an unprecedented open full committee meeting today from 4:00 pm to 5:30 pm in Room 25AB. The meeting is designed to engage all members who are interested in Internet issues, but may not know where to start.

“We got the feeling bubbling up from our subcommittee chairs that there is a lack of engagement from the membership as a whole with ICANN,” says John McElwaine of Nelson Mullins Riley & Scarborough, Vice Chair of the Internet Committee. This partly because members sometimes don’t know how to take the first step. “They get our call to action emails and say now what? What if my employer won’t pay?” adds Committee Chair, Fabricio Vayra of Perkins Coie.

Vayra and McElwaine have identified key people from Internet user organizations to address such questions and provide practical tips for making Internet advocacy fit in with one’s career. Making the time to engage with this issue is more important than ever as ICANN reviews its policies around new gTLDs and the U.S. government transitions its stewardship of the Internet Assigned Names and Numbers Authority (IANA) functions to ICANN.

Food and beverages will be served to encourage a laid back atmosphere. “We’re hoping everyone will feel comfortable enough to grab a glass and talk frankly,” says Vayra. INTA’s Senior Director, Internet Policy, Lori Schulman, adds: “The intention is to demystify Internet advocacy and the ICANN process. We will answer questions and encourage involvement from all INTA members.”
The mobile revolution has played a big role in internationalizing trademark practice. Peter Leung asks: what can you do to help your clients adapt to this new world?

The mobile revolution is the topic of one of today’s morning sessions. As panel moderator Larry McFarland of Kilpatrick Townsend & Stockton explains, the popularity of online and mobile technologies has added many challenges for trademark practitioners.

One of the biggest issues is that while trademark practice has long been limited by territorial boundaries, the mobile online world transcends these borders, forcing practitioners to adapt. McFarland cites enforcement as one of these challenges, where a company based in the U.S. may be trying to enforce its trademarks against infringers based in some far-flung country. In these situations, rights holders have to resort to other tools to help them achieve their goals.

“Let’s say you’re trying to enforce an injunction against a user of your mobile app or site, but the user is not in the U.S.,” he explains. “If you have site T&Cs [terms and conditions] that specify the terms of use and that the law of your state applies, then you may be able to enforce an injunction you got from California, even though the user is based in Eastern Europe.”

He adds: “From my experience, courts in other countries are generally willing to enforce these contractual rights, unless it’s something completely crazy.”

The open nature of the mobile space affects not just enforcement. Many of the bread-and-butter aspects of trademark lawyers, such as clearances, registrations and general strategy, have been made much more difficult. Even seemingly fundamental issues, such as whether to use trademark markings, are more difficult in the mobile space.

For example, many rights holders do not hold registrations in all the markets that they operate in. Because mobile products and the attached trademarks will almost undoubtedly cross national boundaries, one question that arises is whether the brand owner should use trademark markings. According to McFarland this can be a thorny problem, because in some jurisdictions, there are negative consequences for claiming to have a trademark when you don’t.

The open nature of mobile space also poses new problems for trademark practitioners. Infringing user-generated content is an especially difficult issue, in part because there are no bright line rules or best practices for how to deal with this type of infringement.

“Even if it is clear from an IP perspective that a certain piece of user generated content is infringing, it is important to keep the practical issues in mind,” McFarland says. “In general, you have to be cognizant of the purpose of the user generated content—it is a fan of your brand, or does it commercialize the user trying to make money off your brand?”

Because of the range of motivations behind user-generated content, there is no one-size-fits-all approach to the issue. Instead, each case requires careful analysis of these realities. For example, the Internet is filled with stories of rights holders facing a backlash when enforcing their rights against infringing user-generated content. Such considerations, McFarland says, have to be part of the process when deciding the next move.

However, even if these considerations may stop brand owners from adopting draconian or overly aggressive enforcement practices, he says that brand owners shouldn’t be scared to protect their marks. As he notes, it is almost inevitable that big companies will become the subject of negative Internet publicity. The role of trademark lawyers is to have the tools to analyze these cases and to act accordingly.

“The European Commission is holding a consultation on the Digital Single Market, which has numerous implications for trademark owners,” he says. “These include a prohibition on geo-blocking (redirecting consumers to national sites) and consumer access to pricing and promotions across all EU member states. Toe Su Aung, co-founder of Elipe and INTA Past President, says: ‘We see a major issue for brands in the online world transcends these borders, forcing practitioners to adapt.’

However, even if these considerations may stop brand owners from adopting draconian or overly aggressive enforcement practices, he says that brand owners shouldn’t be scared to protect their marks. As he notes, it is almost inevitable that big companies will become the subject of negative Internet publicity. The role of trademark lawyers is to have the tools to analyze these cases and to act accordingly.

He also gave some advice for what to look for if you are “going to hire Magnum PI”, saying you want an investigator who specializes in intellectual property.

He added that when interviewing prospective candidates you should ask about their experience and hypothesize a situation with them. “You want hear the words ‘no’ or ‘can’t,’” Bulle. “And ask yourself whether you can imagine them on the stand. I am from North Carolina so I can say this: you don’t want someone who sounds like a redhead on the stand.”

The do’s and don’ts of pretexting

The complexities of deciding when to hire an investigator for IP litigation and subsequently vetting, hiring and instructing them were discussed yesterday in the Using Private Investigators Without Losing Your License to Practice Law session.

Ross Bulla of The Treadstone Group advised registrants to start with an exchange of view about the attorney’s expectations, the client profile, case type, boundaries, and format and form such as whether results are desired by phone, by a written report or both.

The session then discussed the type of techniques that can be deployed. “Arguably the most controversial investigations technique is pretexting,” said Bulla.

Pretexting is when a fictitious reason is used to elicit prejudicial information. This is a useful way of getting information about counterfeit goods, for example, which would not be given if the private investigator revealed his or her true identity.

“This technique is not always illegal,” he explained, but it is always a misrepresentation or deception, and frequently conflicts with the rules. Despite this, Bulla said it is a valuable investigative technique. INTA even has its own resolution on it, endorsing “ethical and legal pretexting as an essential tool in investigating and combating trademark infringement and counterfeiting.”

Unsurprisingly, the technique is an ethical minefield. “What can be valuable and legal may not be ethical,” warned Frank Long of Dickinson Wright. “I would suggest approaching this with extreme caution. Courts can take an extremely doctrinaire approach to pretexting.”

Two laws allow pretexting—one is civil rights, the other is intellectual property rights, and both are becoming more supportive of pretexting. Those involved have to be sure a violation is taking place or is imminent, and that the information is not available through other means. The investigator must also act as a regular consumer, as opposed to a government official or an insurance company agent.

Personally identifiable information protected under federal law is off-limits in these types of investigations, including financial and banking details under the Gramm-Leach-Bliley Act, telephone and toll records under the Telephone Records & Privacy Retention Act, insurance information, and credit reports.

It is important to choose the right person to do these investigations. “Attorneys often ask, ‘Why can’t I do it on my own, and get one of my paralegals to do this?’” said Bulla.

“But objectivity is the most critical component of any investigation. And do you want your paralegal to be witness number one?”

He also gave some advice for what to do of intermediaries. This is expected to be followed by legislative proposals in September, so there is still time for trademark owners to influence these measures that will define the future European market.

Aung adds: “Brand owners should continue to assess their views, using a long-term business lens, on different issues covered in the strategy and consider engaging on commercial priorities.”
T
rademark cases are not won on the day of the trial. Nor are they won on the day a killer lawsuit is served. As many experienced litigators will have learned, the groundwork for winning a trademark case begins years, sometimes decades, earlier.

Panelists in a session today on gathering evidence will underline the importance of pulling together and maintaining evidence for use in trademark litigation, well before litigation is contemplated. “You really can lose cases before IP offices and in the courts without sufficient evidence”, says Carsten Albrecht of FPS Fritzke Wicke Seelig in Germany, who is moderating today’s session.

“OHIM and the General Court also like to see copies of invoices showing the trademark,” he says.

In February, the General Court in Luxembourg backed OHIM’s Board of Appeal, which had found that Longines had not succeeded in proving the existence of a reputation for its “winged hourglass” device on its own, independently of the mark LONGINES.

Types of evidence
So what kind of evidence should IP owners stockpile to prove their trademark claims? Albrecht suggests they build up evidence of use of at least the most important trademarks in their portfolio, bringing together packaging designs and labels as well as figures showing the amount spent on advertising.

“Easy access to the evidence is important so that litigation teams can find, analyse and submit it within tight litigation timetables. In a digital era, the job of evidence collection and archiving should be easier, allowing IP owners to keep records online and scan copies of documents and examples of packaging. But Albrecht says that while the German courts are relatively relaxed about the submission of scanned documents, the UK courts might be more suspicious. “British lawyers have told me that the courts in London might expect the parties to be able to produce witnesses to the scanning process. It is important to consider evidence gathering on a global basis”.

Another headache for trademark lawyers is the trend for IP owners to use their marks in dynamic ways. This trend is often driven by the marketing department, but their colleagues in the legal team should be aware of the potential problems that regular changes to the way the trademark is presented might have for litigation success down the line. “In Europe the IP owner needs to be able to show that the mark has been used in the registered form, or with only slight changes to it,” warns Albrecht.

Another member of the panel are Richard Groos of Norton Rose Fulbright in the United States, Paul Harris of Pillsbury Winthrop Shaw Pittman in the UK and Anna-Lena Wolfe of Tetra Pak in Sweden.
The concept of fair use is not a new one, but some companies with business models built on the mobile Internet are adopting more relaxed approaches to the use of their marks.

Panelists from yesterday’s session Is Fair Use Always Fair? International Approaches to Fair Use Issues in a Mobile World discussed the evolution of the concept.

Gavin Charlston of Google pointed out that though brand owners sometimes see their trademarks as property rights to be enforced against third parties, the reality is that marks do not operate in a vacuum. Referring to a quote from former U.S. federal appellate court Judge Alex Kozinski, he said that trademarks become part of a common language and that everyone, including third parties, have a right to use them to communicate in truthful and non-misleading ways.

Sung-Nam Kim of Kim & Chang in Seoul explained the basic framework behind nominative fair use, where a third party uses a trademark to refer to the product or service of the trademark holder. In the U.S. and several other countries, courts look at whether the third party’s product is readily identifiable without use of the trademark, whether the degree of use exceeds what is necessary, and whether use of the mark falsely suggests sponsorship or endorsement by the trademark holder.

Kim pointed out that under this test, the use of another company’s logos may be problematic in many cases because it can be argued that the use may exceed what is necessary to convey information.

The situation may be different in the mobile world. Andrea Sander of Microsoft explained that as consumers migrate toward mobile devices with smaller screens, logos may in many cases be the best way to convey the necessary information.

Some Internet companies also encourage third parties to use their logos and marks. Stephen Jadie Coates of Twitter explained that his company encourages third parties to use its unmodified blue bird logo or the word “tweet” to refer to its service. He noted that the company is sometimes even accepting of uses that are not technically compliant with all requirements, especially when there is no suggestion of endorsement or affiliation with Twitter.

Google’s approach to its ANDROID robot logo is even more lenient; the company has adopted a Creative Commons license which allows for modification of the logo. “We firmly believe that it’s the open nature of the logo that has helped to make it so iconic,” Charlston said.
Three hot topics in the Middle East

There are some important changes happening in the Middle East. James Nurton finds out what today’s session will cover.

The new trademark law in the Gulf Cooperation Council (GCC) states; the fight against counterfeits and the impact of economic growth on trademark registration—these are the three topics that will be addressed by speakers in today’s regional focus on the Middle East.

The GCC Trademark Law looks finally to be nearing reality, after it was approved last year by Saudi Arabia’s Cabinet. It has also been enacted in Bahrain and Qatar, but the other three member states (see box) also need to enact it before it can come into force.

“People have been talking about the law for more than a year, but now we have more information about what to expect,” says Charles Shaban of AGIP in Jordan, who is moderating today’s session. The new law will mean that all six states will have the same standards and requirements for examination and opposition. They will not, however, be adopting a unified registration system such as that in the EU.

“It’s expected to make protection in the region easier as requirements will be standardized. But the bad news is that it will be more expensive in some countries, as the charges will be made the same,” says Shaban. For example, at the moment there is a big difference between Kuwait, which has relatively low official fees, and the UAE, which is more expensive.

Aisha Salem, the USPTO IP Attaché for the Middle East & North Africa, who has been in the region for two years, will provide an update on the latest developments regarding the law.

Shaban says that, while the unification brought by the law is welcome, the laws themselves in the region are not generally deficient at the moment; the biggest problems are to do with enforcement, particularly in those areas where there are free-trade zones and large volumes of goods in transit.

Omar Obeidat of Al-Tamimi & Company in the UAE will present different approaches to fighting counterfeits, with examples, during today’s session. These include notification, cease-and-desist letters, online filing of forms and Customs actions. “Although it may seem difficult, there are ways that you can get information as the trademark owner,” says Shaban. His view is backed up by rights owners who have visited the region recently and report that police and Customs authorities are willing to help locate counterfeiting sites, shut them down and seize fake goods.

The other side of the enforcement battle is to increase awareness among consumers; in Lebanon recently there was an advertising campaign telling people what number to call if they suspect counterfeit goods are on sale. Rany Sader of Sader & Associates will demonstrate how the campaign worked, as well as addressing other issues.

And if that’s not enough to tempt you along, Shaban also promises that—in line with this year’s Annual Meeting theme—there will be some music from the region. He declined to confirm, though, whether there would also be belly dancing.

RT21 Regional Update: The Latest News from the Middle East. Why is it so Important to Protect IP in the Region? takes place from 11:45 am to 1:00 pm today.
The evolving Indian trademark environment

Sudeep Chatterjee and Jaya Mandelia of Singh & Singh Lall & Sethi talk about some of the most important court cases and legal developments in India, as well as some best practices for enforcement.

What are some of the most important cases in the past year or so?

Sudeep Chatterjee: Anchor vs P&G is one of the important trademark cases from the past year. Anchor manufactures and sells its toothpaste under the trademark ALLROUND along with the tagline ALLROUND PROTECTION since 2007. P&G launched ORAL-B toothpaste using the tagline ALL AROUND PROTECTION and had also sought registrations for the same in India and various jurisdictions of the world. Anchor filed a suit for permanent injunction against P&G for infringement, passing off, dilution and damages. The Single Judge of the Delhi High Court granted an interim injunction against P&G and restrained it from using the slogan/tagline.

P&G filed an appeal before the Division Bench against the order of the Single Judge. The Division Bench, in a landmark judgment, recognized that slogans and taglines used within advertising campaigns are valid and enforceable trademarks. Moreover, since P&G had sought registration for ALL AROUND PROTECTION in India and other jurisdictions of the world, P&G ought not to be permitted to argue descriptiveness. Thus it could not apropoate and repropate.

This is the first judgment that categorically holds that slogans and taglines can serve as a trademark and that advertising campaigns have an impact on the perception of the trademark by consumers.

P&G appealed to the Supreme Court of India, which also dismissed the case.

Jaya Mandelia: Hoverless vs Eveready was another noteworthy case. Eveready launched the impugned advertising/promotional campaign for their LED Bulbs.

The ads stated: 'Switch to the brightest LED' below which it read 'Check lumens and price before you buy' followed by a chart comparing the price and lumen quantity of several brands of LED bulbs, including Havells with that of Eveready's.

Havells filed a suit against Eveready on the ground that the advertisement wrongly laid stress on the assertion that Eveready's LED Bulbs are the brightest at the least price whereas those of other brands, including Havells, are of inferior quality and unreasonably priced. Havells further alleged that such advertising is misleading and results in disparagement of the brand as well as Havells' products. It further argued that its policies are framed in a manner to avoid any violation of intellectual property of the manufacturers as well as all third parties and therefore undertakes only to sell genuine products.

The Single Judge of the Delhi High Court issued an order to restrain KAFF from publishing any further caution notices until further orders.

What do these cases mean for rights holders?

Chatterjee: As far as Anchor vs P&G is concerned, it is a very significant development for right holders. Slogans and taglines are integral elements of most advertising campaigns. They create the recall value.

Despite satisfying the definition of a trademark as provided under the Trade Marks Act, 1999, up until this decision, slogans and taglines had not been recognized as valid and enforceable trademarks in India. Although the Courts had granted slogans and taglines protection under the law of Copyright such as in the case of Pepsi vs Hindustan Coca Cola wherein the dispute related to use of Pepsi’s slogan ‘Yeh Dil Maange More’ by Coca Cola in its advertisement, the Courts had consistently refrain from granting slogans and taglines protection under the law of Trademarks.

Internationaly, there is a growing trend for recognizing slogans and taglines as trademarks. Not only does this decision make the Indian position more consistent with the general trend being followed internationally, it also means that right holders can now reasonably expect that their slogans and taglines will be upheld and protected by the Courts as trademarks.

Mandelia: The decision of Havells vs Eveready on the other hand provides competition and each other is likely to bring the fight to the streets. This judgment lays down some very definitive guidelines qua comparative advertising and also the tests to be applied when adjudicating whether a comparative advertisement is misleading in nature.

However, the law laid down in this case may be interpreted to permit right holders the use of another’s registered trademark in a manner which may be misleading such that it creates a negative impression in the minds of consumers toward the particular brand. The reason I say that is because in this case, Eveready selected only two criteria out of several to compare the products giving the misleading impression that Havells’ product (amongst others) was inferior in quality and more expensive than Eveready’s. Although Eveready is correct in claiming that it was squarely telling the ‘truth’ so to speak, however, it cannot be denied that it was only telling a ‘half-truth’. Also, in this particular case, I believe that Havells should have been offered protection by the Courts considering that the Havells mark has been held to be a well-known mark by the same Court vide an order in a different lis.

I apprehend that a situation might occur wherein IP right holders may start releasing counter advertisements using each other’s registered trademarks and the same will create chaos in the marketplace. Further, the Court’s decision to not offer protection to a well-known mark may be discomforting to brand owners today because it is generally perceived that well-known marks deserve a higher degree of protection. Although healthy competition is essential to any marketplace and comparative advertising is permissible under Indian laws, the damage or loss of reputation suffered as a consequence of misleading advertising needs further addressing.

Chatterjee: The interlocutory decision in Jasper Infotech vs Deepak Anand is a very balanced approach taken by the Hon’ble Delhi High Court. It promotes e-commerce and competition but also does not in any manner authorize the sale of non-genuine and counterfeit goods. Promotion of e-commerce will undoubtedly benefit consumers and IP right holders alike in the long run as brick and mortar retail is declining and the future of retail rests in e-commerce.

Are there any important decisions or developments that we should keep in an eye on in the next year?

Mandelia: The Indian IP Policy is slated to be published shortly. It aims to provide a roadmap for the growth and development of IP in India over the next few years. The Department of Industrial Policy and Promotion set up a six-member panel called the ‘Think Tank’ which has been given the responsibility of identifying the areas in IP laws which require further research and policy making and also to advise the government about the emerging issues and problems faced in the realm of IP in India. On the basis of its consultations and research, this panel is also entrusted with responsibility for drafting the National IP Policy. We...
expect this new IP Policy to greatly impact the IP landscape in the country at an administrative and legal level and across all areas including trademark, copyright, patent, design, geographic indications, etc.

**Chatterjee:** Another interesting development involves the status of the IP Appellate Board (IPAB). In a writ petition filed before the Hon’ble Madras High Court, Shannad Basheer vs UOI & Ors, a bench headed by the Hon’ble Chief Justice of the Madras High Court has observed that the selection process of the members of the IPAB is entirely executive whereas the functioning of the IPAB is judicial in nature. The Hon’ble Madras High Court while holding various provisions of the Trade Marks Acts, 1999 that provides for the establishment and constitution of the IPAB as ultra vires to the Constitution of India and has also specifically directed the minimum required qualifications for various posts in the IPAB such as Technical Member, Vice-Chairman and Chairman. Unless the Government of India appeals from this decision before the Hon’ble Supreme Court and is able to secure a favorable order, it was further contended that more permanent benches of the IPAB need to be established. As a result of the said writ petition, the Delhi High Court issued various directions such as locating a premises in Delhi for the IPAB and appointment of staff for it. The Hon’ble Delhi High Court also issued a direction to the Government of India to take a reasoned decision on the need for having a permanent bench of IPAB at Delhi within three months.

In light of the above two writ petitions, we can now hope that going forward, the IPAB will be a better equipped tribunal with smoother and more efficient functioning. The same would result in a higher disposal rate of cases as well as sounder decisions.

**How can brand owners take enforcement actions against infringers in physical marketplaces?**

**Chatterjee:** Anton Piller injunctions and search and seizure operations are important enforcement tools. Anton Piller injunction orders grant the right to conduct search and seizure of an infringer’s premises. They are the most effective tools for assessing the extent and nature of infringement occurring in the marketplace. Following the issuance of an Anton Piller injunction, a civil search and seizure operation is conducted within short notice wherein the infringing stock is seized. Such operations have a significant impact on infringers and act as very effective tools in deterring future infringing activities.

**Mandelia:** John Doe orders can also help with enforcement efforts. In the physical marketplace, most infringers and counterfeiters are fly-by-night operations, the roots of which are typically very hard to track. Therefore, especially when tackling counterfeiting cases, seeking a John Doe order which includes an Anton Piller injunction is the most effective way of getting hold of counterfeiters. In such cases, if search and seizure operations are conducted in a strategic and widespread manner, it will enable brand owners to deter the retail of counterfeit goods and may also lead them to the source of the counterfeit goods.

Border control measures such as registration of your intellectual property with Customs authorities to intercept goods suspected to be counterfeit or pirated at the border are also very effective means for curbing infringement and counterfeiting in the physical marketplace. Once IP is registered with Customs, seizure of suspected counterfeit goods are carried out suo moto (on its own initiative) by the authorities. The proprietors or authorized representatives of the IP are informed and required to inspect the same. However, such measures only cover goods which are imported into India, not exports.

**Sudeep Chatterjee, Partner**

Sudeep completed his law degree at Lucknow University in 2000. He also has a Masters in software development and software engineering. Sudeep joined Singh & Singh in September 2005 and in 2012 became a partner at the firm. In 2015, Singh & Singh and Lall & Sethi merged to form a new entity, Singh & Singh Lall & Sethi, of which he is a partner. He handles infringement matters relating to copyright and trademarks, domain related issues including filing of UDRP complaints, trademarks and copyright filings, all work related to trademarks & copyright issues including registrations, assignments, oppositions, rectifications, etc.

**Jaya Mandelia, Associate**

Jaya completed her Bachelor of Science in Liberal Arts and Sciences in Psychology and Political Science from the University of Illinois, Urbana-Champaign in 2009. She thereafter completed her LLB from Campus Law Centre, Faculty of Law, University of Delhi in 2013 and joined Singh & Singh Law Firm. Jaya presently handles litigation as well as trademark prosecution.

**www.managingip.com**
Foreign direct investment into Africa rose by 4% to $57 billion in 2013, according to data published by UNCTAD last year. With that figure expected to rise in the coming years, IP owners will become increasingly focused on protection in the region.

“Foreign investment is very much connected with intellectual property because investors will not come into a region where their rights are not adequately protected,” says Uche Nwokocha of Aluko & Oyebode in Lagos, Nigeria, who is moderating today’s regional update on Africa.

The session will cover different parts of the continent, with speakers from South Africa, Nigeria and Kenya. Nwokocha told the INTA Daily News: “These represent the different regions of Africa—sub-Saharan, west Africa (including Nigeria and Ghana) and east Africa.”

The session will focus in particular on the issues that arise when there are different agencies involved in IP protection; for example, dealing with trademarks, company names and food and drug approval.

In Nigeria, the National Agency for Food and Drug Administration and Control (NAFDAC) works “hand-in-hand” with the trademark registry, as applicants for

Avoid pitfalls when investing in Africa

With investment in Africa growing, IP protection in the region is key. Two sessions this week will provide some guidance for rights owners, explains James Nurton.

A session tomorrow will look at the implementation of international IP treaties in Africa, asking is Africa ready to join the global train? Or is a hybrid model more suited to the African terrain?

OAPI and Zimbabwe have both recently joined the Madrid Protocol, increasing the number of African countries covered by the international trademark system (see map). But concerns remain about the implementation of the treaty in the region, as speakers at tomorrow’s session will explain.

The session will include a presentation from Dr Paulin Edou Edou of OAPI.
product approvals must show that they are a Nigerian-registered company and either the owner or assignee of the trademark they are intending to use, says Nwokocha.

Even though they are housed in different premises, she says, cross-reference between the two agencies takes place and trademark owners need to know what to expect: “NAFDAC will refer to the Trademark Registry to confirm that the acceptance was issued to the right person.”

Similar rules apply at the Companies Registry to ensure that applicants do not register a company name that infringes a registered trademark. “It’s not complicated,” says Nwokocha, “but you need to ensure you are not doing something that will go against the law of the land.”

She adds that getting your strategy in place ahead of investment is vital to ensure you know what to expect from the various agencies: “We will show you how they work hand-in-hand to ensure rights are adequately protected.”

RT20 Trademark Offices in Africa: The Importance of Working with Related Government Agencies takes place from 11:45 am to 1:00 pm today. It is followed by the Africa Reception from 1:15 pm to 2:15 pm, INTA will host a conference in Africa addressing many of these issues in 2016.

San Diego is known for its craft breweries: there are more than 90 of them in the region, including well-known names such as Karl Strauss and Stone Brewing Co.

The city was recently named “Top Beer Town” in America by Men’s Journal and called a “sunny heaven for suds lovers” by the New York Times.

The best way to experience the range of beers is to go on a brewery tour, where you can meet the brewers and see how the beer is made.

**Quiz**

Win INTA merchandise!

Answer the INTA Daily News quiz question each day to have a chance to win INTA merchandise.

Today’s question: **Who are Bai Yun, Gao Gao and Xiao Liwu?**

Send your answer to contest@inta.org by midnight tonight. Winners will be announced on Wednesday.
Navigating the well-known maze in China

Well known trademark status is a valuable asset to have in China. Frank Liu and Kenneth Ng of Chang Tsı & Partners examine how to get well-known status, and review recent legal developments.

How do you get well-known status in China?

Principles of recognition (new changes of 2014 Trademark Law)

Well known trademarks are recognized on a case-by-case basis, and are subject to the principle of passive protection. This is explained in Article 4 of the Provisions on the Recognition and Protection of Well-Known Trademarks.

Passive recognition occurs “if the holder is of the opinion that its rights have been infringed upon,” (Article 13) “upon request by the party concerned” (Article 14).

Case by Case basis is when “a well-known trademark shall be recognized as a fact that needs to be ascertained in the handling of trademark-related cases” Article 14.

Approaches and authorities of recognition (new changes as a result of the 2014 Trademark Law)

Generally there are two approaches to obtain recognition of well-known status in China. This chart below explains:

Evidence Requirements for Recognition of Well-Known Trademark

Article 14 states that the following factors shall be taken into consideration in the recognition of a well-known trademark:
1) The degree of recognition of the trademark by the relevant public;
2) The duration of the use of the trademark;
3) The duration, extent and geographical scope of all promotional activity carried out for the trademark by the trademark owner;
4) The enforcement history of the trademark when recognized as a well-known trademark; and
5) Other factors relating to the trademark’s well-known status.

What tips do you have for foreign rights holders who are trying to get well-known status for their marks in China?

Brand owners should pay attention to the preservation of evidence supporting well-known status, which include:
1) Materials proving the extent of the relevant public’s awareness of the trademark;
2) Materials proving the duration of the continuous use of the trademark, such as materials on the history and scope of the use and registration of the trademark. If the trademark is unregistered, materials proving that the trademark has been in continuous use for not less than five years shall be submitted. If the trademark is registered, materials proving that the trademark is registered at least three years ago or that the trademark has been in continuous use for not less than five years shall be submitted;
3) Materials proving the duration, degree and geographical scope of all publicity campaigns carried out for the trademark, such as the models and geographical scope of advertising and promotional activities, the type of promotional media, advertising volume, etc. in the past three years;
4) Materials proving the past protection of the trademark as a well-known trademark in China or other countries and regions; and
5) Other materials proving that the trademark is well-known, such as sales revenue, market share, net profit, tax payment, geographical scope of sales, etc. in the past three years of the main products bearing the trademark.

For instance, in the recent successful recognition of the well-known status of “TIFFANY” and “TIFFANY & CO.” for jewelry and precious stones products handled by Chang Tsı & Partners before the Trademark Review and Adjudication Board (TRAB), we assisted Tiffany & Co., owner of the subject trademarks. In that matter, we submitted abundant evidence to prove the registration and use of the subject trademarks in a number of countries including China, the publicity campaigns carried out for the subject trademarks, and the protection of the subject trademarks in China. Meanwhile, based on the well-known status of “TIFFANY,” the TRAB disapproved the registration of the “蒂芙尼”(TIFFANY in Chinese) by a third party in Class 12 for vehicles and tires that was opposed by Tiffany & Co.

It is also important to understand that the well-known status of a trademark is viewed as an existing fact to be recognized rather than a specific goal to be achieved. Before applying for the recognition of a well-known trademark, foreign right holders should evaluate whether their trademarks are in fact well-known in the market. The attorneys of Chang Tsı can provide an analysis prior to the submission of such a claim.

Did the revised Trademark Law bring about any changes to the area of well-known marks?

Yes, the revised Trademark Law provided much clarity and process to this area of the law. The revised Trademark Law made changes in respect of the Principles of Recognition, Approaches and Authorities of Recognition as well as Use and Protection of Well-Known Trademark.

Apart from above mentioned Principle of Recognition and Approaches and Authorities of Recognition, the changes to the Use and Protection of Well-Known Trademark are as follows

a) Article 13 clarifies the definition of “well known trademark” as “a trademark that is well-known by the relevant public”.

The relevant public shall include the consumers relevant to the goods or services bearing the trademarks concerned, manufacturers of the said goods or other business operators that provide said services, salespersons and other relevant persons in the distribution channels, etc. This is laid out in Article 2 of the Provisions on the Recognition and Protection of Well-Known Trademarks.

b) Article 14 prohibits the commercial use of the words “well known trademarks” in advertising or promotion, such as on goods and the packaging or containers of goods. This article specifically prohibits the use of the words “well known trademark” as a title of honor to sell products. In other words, a trademark is recognized as well-known for the specific purposes of enhancing the scope of trademark rights held by the trademark owner, as a means of legal relief. This right was not designed to further the commercial use of the trademark.

c) Article 45 grants a longer protection period for well-known trademarks in matters involving a declaration of invalidation. Where a third party registration is obtained in bad faith, the owner of a well-known trademark, when requesting the TRAB to declare the registered trademark invalid, is not bound by the five-year restriction, but can challenge the third party’s registration at any time.

d) Article 58 protects unregistered well-known trademarks.

The well-known status of a trademark is viewed as an existing fact to be recognized rather than a specific goal to be achieved.
through the Anti-Unfair Competition Law where such trademark is being used by another party as a trade name to mislead the public.

In the past there have been concerns about too many companies getting well-known marks and using them for improper purposes. Is this still the case?

Indeed, in the past there were companies who made up evidence and created non-existent situations in order to obtain well-known status and use such status for commercial gain.

However, even before the promulgation of the new Trademark Law in 2014, the judicial interpretation issued by the Supreme Court in 2009 had already limited the recognition of well-known trademarks to certain specific situations. Therefore, in the past several years, the threshold has been raised such that even eligible trademarks would be denied recognition, which we believe was an overcorrection. The new Trademark Law has thus provided much needed clarity in this field.

After the passage of the new Trademark Law, the popularity associated with well-known status recognition has weakened a little. The commercial use of the term “well-known” for trademarks used in the market has been prohibited. It is now understood that well-known mark status can only be used in individual cases. The Courts in China are also aware that well-known trademark recognition should not be overcorrected. Thus, in the cases where well-known status is necessary for trial, the Courts have started to recognize the same.

What would you recommend for a trademark owner seeking to have their trademark recognized as well-known in China?

We typically recommend that our clients are focused on the use and enforcement of their respective trademarks in China. Such focus allows us to monitor the scope of enforcement, to enhance the portfolio of rights, and to familiarize ourselves with the use and promotion of the trademark in the marketplace. Such focus then justifies the additional effort and cost needed to support an application for well-known trademark status.

Once a trademark owner has amassed a sufficient volume of evidence to support the claim of well-known trademark status, we counsel our clients to wait for a good case to bring a claim. Claims at the administrative level, namely, before the Chinese Trademark Office (CTMO) are comparatively easier to win; however, such decisions are less influential to use as evidence in future cases. In contrast, claims brought before the People’s Court are more difficult to win; however, a Court decision recognizing a trademark as well-known is a significant victory for a trademark owner. Since multiple claims can be brought, for a client with a strong focus on building a strong brand in China, we counsel clients to bring successive and incremental claims for well-known trademark recognition. For example, recognition of a trademark as well-known by the CTMO can later be used to support an application for well-known trademark status by the TRAB or the People’s Court.

After the passage of the new Trademark Law, the popularity associated with well-known status recognition has weakened a little.
Who is the average consumer under European trademark law? What kind of conduct constitutes “taking unfair advantage” of the reputation of an established trademark? How can you prove that you have used your trademark to the standard required by EU law?

If you need to know what Europe’s courts decided last year on these questions (and many others), today’s annual review of leading case law in the European Union will provide a whistle-stop tour of some of the most important decisions and an analysis of emerging trends.

30 cases in 75 minutes

Speakers Guy Heath of Nabarro in the UK and Georg Jahn of Noerr in Germany will take in more than 30 decisions from 12 EU member states, the Court of Justice of the EU (CJEU) and the General Court, and explain how they are shaping trademark law.

Some of the leading CJEU and General Court cases that will be under discussion include the CJEU ruling on the registrability of Apple’s retail layout as a trademark, the TRIPP TRAPP decision on the registrability of shape marks, the Leidesplein/Red Bull case dealing with the

Understand Europe’s trademark trends

It has been a busy year in Europe’s courts. Emma Barraclough previews a session that will discuss some of the most significant cases.

APPLE STORE

In a victory for Apple, Europe’s highest court has told retailers that they may be able to secure trade marks for their store layouts if the design is capable of distinguishing their goods and services from those of other businesses.

KORNSPITZ

The decision was a useful reminder to IP owners to guard against their trademarks becoming generic. The case asked whether the views of the end consumer of oblong-shaped bread rolls known as KORNSPITZ are relevant when assessing whether a trademark has become a common name for a product, or of those who trade in the product commercially. The CJEU held that the views of consumers are decisive.

TRIPP TRAPP

The Norwegian maker of TRIPP TRAPP highchairs suffered a setback in its battle to protect the shape of its products after the Court of Justice of the EU ruled that EU law can preclude the registration of shapes required by the function of a product.
defence of “due cause” in an unfair advantage claim, a case involving the German Savings Banks and the registrability of the color red, and the KORNSPITZ bread roll case, which dealt with the question of what a trademark owner must do to prevent its mark from becoming generic.

“Amongst other things, the session will focus on the views of the EU General Court on the registrability of a wide variety of non-traditional trademarks, and how that court approaches the comparison of trademarks that are descriptive, or which have a meaning for some but not all of the EU public,” says Heath.

Heath and Jahn will also analyze some of the important decisions that were handed down by national courts across Europe last year. The featured cases will include a LOUBOUTIN red soles case from Benelux, a comprehensive review from the Irish High Court on the principles of bad faith, a ruling from the Spanish Supreme Court that does away with its traditional view on the defensive power of a registered trademark, and a French case involving a claim against a trademark owner by a defendant which removed its goods from the market when first threatened.

The speakers will also consider some of the reasons why national courts continue to hand down very different rulings.

“European trademark law is harmonized and member states are not permitted to reach different conclusions— but in practice they do,” says Jahn. “Sometimes they apply the standards that they are very familiar with because they are part of their national legal traditions, without realizing that some things have changed”.

“The overall theme is that there isn’t always a level playing field in Europe”, says Heath. “It is mostly due to national courts applying the Trademark Directive in different ways, and in ways that the legislators didn’t anticipate. Many of the issues that we will be drawing out have lessons for IP owners interested in the possibilities for forum shopping”.

The session will draw on the recently-published Annual Review of EU Trademark Law—the special issue of INTA’s The Trademark Reporter—and is designed both for European practitioners who want to understand how the decisions will affect their practice and for non-European lawyers who want a curated overview of developments in Europe.

CTO4 Annual Review of Leading Case Law in the EU takes place from 10:15 am to 11:30 am today.
Leadership Meeting heads to Panama

Panama City will host this year’s INTA Leadership Meeting in November, as the Association holds a major event in Latin America for the first time.

Panama was chosen as the destination for INTA’s Leadership Meeting partly due to the enlargement of the Panama Canal, which will greatly increase shipping. Susan L. Crane, group vice president, legal at Wyndham Worldwide and one of the Leadership Meeting co-chairs, told the INTA Daily News: “The expansion of the Canal will more than double the traffic and will also enable two ships to go through simultaneously.” The number of containers passing through the canal is going to grow from 300 million [PCUMS (Panama Canal Universal Measurement System) tons] to 600 million [PCUMS tons], and many of those goods may be counterfeit. The potential for growth in goods being shipped—both genuine and counterfeit—means it is of vital concern to trademark owners.

All major Latin American IP offices are expected to attend, as well as representatives from Panamanian government and Latin American Supreme Courts. Crane added that for the first time at a Leadership Meeting, there will be concurrent sessions with one track focusing on educational programming and the other on policy matters. Other speakers invited include representatives of shipping firms, who will be able to address questions about the growth of the Canal, while discussions are also underway to invite a high-profile sports star to talk.

Gerardo Munoz de Cote Amescua, IP legal director of Televisa in Mexico, is the other co-chair of the Leadership Meeting. He told the INTA Daily News the decision to go to Panama shows “the interest and importance of the region” for INTA, adding: “The Latin America community has been very engaged in INTA for many years, and this decision is a recognition of that.”

In another change this year, the Meeting will start on Tuesday and finish on Friday, meaning registrants can head home for the weekend—or spend some time getting to know the region. The co-chairs visited the City earlier this year, and say it has a lot to recommend it. Munoz de Cote Amescua highlights the mix of races and cultures, biodiversity and striking architecture, while Crane notes the accessibility and familiarity for visitors from overseas, adding: “If you have time, I would encourage people to go out to the Canal Zone, which is really interesting to see.”

INTA’s 2015 President, J. Scott Evans, added: “I think Panama is an exciting place, and I think the expansion of the Panama Canal makes it politically, geographically and legally relevant to the issues we face with counterfeiting and free trade zones, so it’s an important time for us to be there.”

The INTA Leadership Meeting takes place from November 17 to 20 and is open to all INTA volunteers. Registration will open later this year.
Stereotypes about academics living in ivory towers were shattered yesterday as law professors considered the practical challenges of branding cannabis products and trademarking sex toys.

At the Sex, Drugs, Motorcycle Clubs: Trademark Issues on the Edge Professor Luncheon, academics talked about the problems of helping clients in the adult content industry and the legal marijuana trade to protect their IP rights.

Shabnam Malek of Cobalt explained the regulatory barriers that affect her clients’ abilities to trademark the names of their marijuana products in those states in the United States that now allow the sale of cannabis-related goods. “You can imagine how terrible this is from a branding perspective,” she said.

Todd Alberstone of Alberstone Consulting outlined the problems suffered by what he described as legitimate/established adult content brands in an online marketplace crowded with get-rich-quick businesses. “In the past brands such as PLAYBOY, PENTHOUSE and HUSTLER had very clear identities and associations. Now the adult content market is very different.”

He went on to discuss the problems that adult content companies have when they extend their brands into the retail market, such as selling sex toys. “There is an inherent conflict between the brand names used to drive search engine traffic and those that are acceptable to the USPTO. Terms that are descriptive or suggestive will cause problems,” he said.

The panel was hosted by David Bell of Haynes & Boone. The vice-chair of the Academic Committee, Megan Carpenter of Texas A&M School of Law, said that the session was designed to examine the issues that push the boundaries of trademark law. The Academic Committee has 65 members. Among other things its members organize the Academic Course on International Trademark Law and a Career Development Day for law students at the Annual Meeting, as well as hosting the Professor Luncheon for IP deans and law professors. This year they also launched the (Dis)Order in the Court debate featuring practitioners and professors debating topical law issues.
Protecting the business of story telling

Fox must strike a delicate balance between protecting its IP and not prompting backlashes from fans. Jeremy Kaufman explains the entertainment giant’s trademark strategy.

How long have you been at Fox and what is your background?
I have been at Fox for five-and-a-half years. I am a vice president in the intellectual property group. Before that, I was at Disney doing both entertainment law for a short bit of time with their prime time television production company and then with their IP group. I was at Disney for three years, and then before that in private practice for five.

What does the role entail?
We have six attorneys in the IP group, which is led by INTA Past President Mei-lan Stark. Of those six attorneys, one is a patent attorney and the rest of us are copyright and trademark attorneys.

In my role I work mainly with our television businesses and our consumer products group. I also manage Fox’s anti-counterfeiting efforts for our consumer products group. I view the role of in-house counsel as being a partner within the business units to help them fulfill their creative and business goals while hopefully not getting into too much trouble. That means not only helping them recognize and gauge risk, but working together with the business people to find ways to mitigate the risks so that they won’t hamper the business. As you can imagine, in the entertainment industry I have to work with some creative types such as a film director and a television show runner who can become wedded to a particular aspect of their project that might be risky. Telling them no is rarely an option. So that process of finding creative solutions that don’t impinge on their artistic visions is probably the most rewarding part of my job.

How many brands then does that mean you are dealing with?
Probably too many to count. We are in the midst of pilot season. That means over the past three months we are creating 20 new shows, which means 20 new brands and that’s just the past three months. It is always in flux because what was once the hot show 10 years ago there is no market for any more. So we have this constant turnover. But that means we are always busy and have interesting work to do.

Ultimately, Fox is in the business of great story telling. That’s what we create and sell and that’s a purely an IP business. So securing and licensing and enforcing our trademark rights is paramount to our business, whether we are going to license to broadcast a new television series or create a “Simpsons” theme park attraction or sell a “Sound of Music” DVD the value of those transactions are largely derived from the underlying intellectual property. Our IP department is asked to consult on an incredibly broad array of business issues and that is the fun part.

What does Fox use outside counsel for?
Our in-house department is all U.S. attorneys. That means for our international practice, which is always growing, it seems, we have to rely on our international counsel for really all aspects of the trademark practice—clearance, prosecution and enforcement. We also rely on outside counsel for spillover clearance work during busy times and of course to handle litigations that come up from time to time.

When assessing potential law firms to use, what are the qualities you look for?
The qualities I look for in outside counsel are, first and foremost, are they going to provide practical advice? That requires knowing our business and specialized bits of trademark law that apply to film and entertainment. Then making sure and enforcing our trademark rights is paramount to our business, whether we are going to license to broadcast a new television series or create a “Simpsons” theme park attraction or sell a “Sound of Music” DVD the value of those transactions are largely derived from the underlying intellectual property. Our IP department is asked to consult on an incredibly broad array of business issues and that is the fun part.

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identifying risk. It allows them to help us solve legal problems by advising on the practical business risks, or by proposing maybe business solutions to those problems.

A finer point is the ability to give prompt and very concise advice. In-house counsel are just as busy as their outside counterparts and so counsel that can respond quickly and very concisely are very valued. We don’t need a detailed explanation of every single strategy, especially ones outside counsel believe are doomed anyhow.

The other thing I really appreciate about certain outside counsel is the ability to give very specific advice about risk levels and stick with that advice. I know that’s very hard to do. But it is very helpful so that we can communicate the risks to our business counterparts.

So one pet peeve of mine is receiving advice that is just too vague to be helpful. There is nothing worse than getting a memo that says there is a less than 50% chance of prevailing. That’s almost meaningless because there is a huge difference between a 1% chance of prevailing and a 49% chance of prevailing—both of those are under 50%. I know it is hard for outside counsel to give estimates, but just do it and stand by it and we’ll all be in the same boat together.

How do you balance protecting IP and not discouraging fans who may not know they are infringing?

That is one of our biggest challenges actually. We have a complicated relationship with some of our super fans because their properties can create such enormous passions in them, and that can motivate our fans to do unhelpful things. For example, with comic book or science fiction franchises like Aliens or X-Men there is an insatiable demand for the latest news on every tidbit on those franchises. That demand can result in leaks of set photos or scripts or other things that are going to be spoilers, which are called spoilers for a reason—they can spoil the viewing experience for everyone else. That is very tricky. Sometimes that is more of a security issue than anything else but it’s a challenge.

A more extreme version of how that passion can create IP challenges is with shows such as “Firefly”. The fans of that show are so moved by the series that they have on more than one occasion created unauthorized prequels or sequels to the TV series. They have written scripts and got actors and cameras and created their own filmed entertain-ment based on our intellectual property. Dealing with those situations is challenging because on the one hand we just can’t allow those infringements to happen because our right to do prequels and sequels are among the most valuable we own, but also we don’t want to alienate our most ardent fans. So it is always a most delicate enforcement issue that we have to walk the line on.

What effect do you see from recent Supreme Court trademark decisions?

One of the big topics of conversation is the most recent Supreme Court case [B&B Hardware v Hargis Industries]. It basically says that oppositions before the USPTO can have a precedential effect on infringement actions in trial courts. That’s going to make us want to think twice about where to start challenges to trademark rights. I don’t think we have worked it through, in part because that Supreme Court case has the caveat that it is limited to just those facts in that instance. That’s something we are going to be talking to a lot of people about at INTA. Sometimes even if you say it is only to be applied narrowly over time the narrow becomes wide.

How are the new gTLDs affecting you?

We have applied for the .fox gTLD and we are excited about that. We think it presents some advantages to our business. One of those advantages is practical, which is that it provides enhanced security for our websites that will be hosted on our gTLD. We are especially conscious of that in the wake of the Sony hack and other cyber attacks on major corporations.

While there are a lot of initial upfront costs, we also think there will eventually be cost savings because we won’t need to do country code-specific registrations, we won’t need to buy domain names from squatters, and so there could be over the very long term some cost savings.

Thirdly, it could become a really valuable marketing tool. For example, we own a U.S. television network called Fox and that network is comprised of local affiliates and the way those local affiliates domain names have been created is not uniform. This provides a way to make that uniform for each single affiliate. We are also excited that we can use it as the place for a hosted store so that consumers know they are getting authentic goods in a secure and safe manner.
Vox pop

What has been your career highlight since the last Annual Meeting in San Diego?

Espen Clausen, Acapo, Bergen, Norway - It was going to my first Annual Meeting in Seattle. It was so unexpected. I was taken aback by the scale of the event, its friendliness and the way that it engulfed the city. The INTA Annual Meeting is very different from any other conference.

James H. Walters, patenttm.us, Portland, Oregon - It was my first client meeting in Europe. I went to Belgium and it was great to get the international exposure and see the city. I would definitely like to have more trips like those.

Katharina Schmid, Schmid-IP, Vienna, Austria - There have been so many, but I think it has to be starting my own firm in Austria and going to my first INTA meeting in Berlin soon afterwards.

Frank Schilling, Uniregistry, Grand Cayman, Cayman Islands - The launch of the Uniregistry and navigating the process of bringing new domain name endings to market. It has been a very big project and I am sure I won't see anything like that again in my lifetime.

Luca Stefano Ghedini, Notarbartolo & Gervasi, Milan, Italy - My biggest accomplishments in the last decade have been implementing a new structure of cost control at the firm and developing an integrated approach to trademark applications, to help clients manage the process from application to possible court action.

Aminiasi Vulaono, Pacific Islands IP Services, Suva, Fiji - I think my career highlight has been joining INTA. It has broadened my knowledge of IP issues and I have gotten to know so many people by attending the Annual Meetings. I have been attending since San Francisco.

Jan Klink, Rüger Barthelt & Abel, Esslingen, Germany - I appeared in a trademark opposition case before the Court of Justice of the EU. I really appreciated how the Court dealt with the matter. The judges were informed and they asked tricky questions. It was an intense three-hour hearing.

William Wang, Boss & Young, Beijing, China - There have been so many highlights, and that is mainly due to China's rapid economic development. I have been very lucky to work in IP over the past 10 years because the IP market in China has evolved very quickly. Our firm has grown from 20 people to hundreds and now we are in merger talks with another firm.

Hamood-ur-Rub Jaffry, Intelegal, Karachi, Pakistan - My highlight has been starting my own firm. I worked for another firm for 17 years but three years ago I started my own practice. I have enjoyed the independence. I am the boss of myself. I have more responsibility but, as they say, more risk, more gain.

Vlad Podolyak, Vasil Kisil & Partners, Kiev, Ukraine - It is not always easy to navigate the court system in Ukraine so winning a case in court is always personally very satisfying. However, we try not to focus purely on court victories. From a cost-benefit perspective it can often be in the client's best interests to achieve a negotiated settlement.

Rose Hickman, Strategy IP, Irvine, U.S.- I started my own firm in 2012 after working in medium and large firms. It has been wonderful being able to help clients in small- and medium-sized companies. We have a vibrant SME community in Orange County, California.

Peter Emerson, Page Hargrave, Bristol, UK - Taking part in a 12-hour mediation session. We were acting for the small guy against a large organization. I know that there are not supposed to be winners and losers in mediation but our client definitely won it. It was a bonding experience with the client.

Kohji Suzuki, Smart & Bigpar/Hertherstonhaugh, Ottawa, Canada - Getting more involved in the management of the firm. The IP marketplace has changed so much in the past decade. Now we have to focus much more on the business side and look at new ways of working for our clients.

Rachna Bakhr, Ranjan Narula Associates, New Delhi, India - In the past 10 years we have seen great changes in the IP world. The recession has had a big impact on corporate budgets so filing work has been affected. Since the last Annual Meeting I have also been made a partner and become an arbitrator.

Don't be afraid of the IPC

If you would like to join ICANN's nearly 400-member Intellectual Property Constituency but are concerned that it might be too technical or it’s very technical, “But it’s a very low learning curve and we’re very open to new members—you don’t even need to know how the Internet works.”

As the voice of IP stakeholder concerns in ICANN’s multi-stakeholder framework, it is particularly important that the IPC is representative and active. “I would like to see more involvement from outside the EU and North America,” says Shatan. Asian and African members are particularly underrepresented.

“The bottom line is that the domain name system and the Internet are a critically important part of the world that trademark owners live in, and the IPC is the voice for brand owners. It can’t be ignored.” You can learn more at the IPC’s meeting, which is open to all INTA registrants, on Wednesday from 11:30 to 1:30 in Room 10.

“We’re very open to new members—you don’t even need to know how the Internet works.”

“I started my own firm three years ago I started my own firm. I am the boss of myself. I have more responsibility but, as they say, more risk, more gain.”

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SMART HAS A NEW LOOK

INTRODUCING OUR NEW IDENTITY

Change is necessary for evolution and growth, and we at Saba pride ourselves on a heritage of progress and always moving forward. We will still be doing what we do best, which is protecting your intellectual property, but we'll now be doing it with a revamped look. Like our makeover? We're even better on the inside.

# Today's Schedule | Tuesday, May 5, 2015

All events take place at the San Diego Convention Center unless otherwise indicated. Consult the Final Program for times and locations of invitation-only events and Committee Meetings.

<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Location</th>
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<tbody>
<tr>
<td>8:00 AM – 10:00 AM</td>
<td>CONTINENTAL BREAKFAST</td>
<td>HALL B</td>
</tr>
<tr>
<td>8:00 am – 10:00 am</td>
<td>BREAKFAST TABLE TOPICS</td>
<td>Room 6A</td>
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<tr>
<td>8:00 AM – 5:00 PM</td>
<td>INFORMATION/MEMBERSHIP DESK</td>
<td>HALL A LOBBY</td>
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<tr>
<td>8:00 AM – 5:00 PM</td>
<td>HOUSING DESK</td>
<td>HALL A LOBBY</td>
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<tr>
<td>8:00 AM – 5:00 PM</td>
<td>EXHIBITOR REGISTRATION DESK</td>
<td>HALL A LOBBY</td>
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<td>8:00 AM – 5:00 PM</td>
<td>REGISTRATION</td>
<td>HALL A</td>
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<tr>
<td>8:00 AM – 5:00 PM</td>
<td>HOSPITALITY</td>
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**LAW FIRM/COMPANY SESSION**

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<tr>
<th>Time</th>
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<tbody>
<tr>
<td>8:00 am - 10:00 am</td>
<td>Gorodissky &amp; Partners</td>
<td>Room 1AB</td>
</tr>
<tr>
<td>8:30 AM – 5:00 PM</td>
<td>NETWORKING EXCURSION DESK</td>
<td>HALL A LOBBY</td>
</tr>
<tr>
<td>10:00 AM – 4:00 PM</td>
<td>EXHIBITION HALL</td>
<td>HALL B</td>
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<tbody>
<tr>
<td>10:15 am – 11:30 am</td>
<td>CT01 Gathering Evidence with In-house Counsel: Achieving Harmony and Avoiding Discord Beginner Level</td>
<td>Room 6D</td>
</tr>
<tr>
<td>10:15 am – 11:30 am</td>
<td>CT02 Leveraging Your Brands Through Alternative Revenue Streams Advanced Level</td>
<td>Room 6C</td>
</tr>
<tr>
<td>10:15 am – 11:30 am</td>
<td>CT03 Trademark Rights in a Mobile World Intermediate Level</td>
<td>Room IAB</td>
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<tr>
<td>10:15 am – 11:30 am</td>
<td>CT04 Annual Review of Leading Case Law in the European Union Advanced Level</td>
<td>Room 6B</td>
</tr>
<tr>
<td>10:15 am – 11:30 am</td>
<td>IT01 Industry Breakout: Sports and Entertainment-The Intersection of the First Amendment, the Lanham Act and State Rights of Publicity Intermediate Level</td>
<td>Room 5F</td>
</tr>
<tr>
<td>10:30 am – 11:30 am</td>
<td>SPEED NETWORKING</td>
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<tr>
<td>11:45 am – 1:00 pm</td>
<td>CT20 Global Portfolio Management on a Budget: In-Housing, Outsourcing or Somewhere in Between? Intermediate Level</td>
<td>Room 6B</td>
</tr>
<tr>
<td>11:45 am – 1:00 pm</td>
<td>CT21 Protecting and Preserving Your Brand After a Cyber Security Incident Intermediate Level</td>
<td>Room 6F</td>
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<tr>
<td>11:45 am – 1:00 pm</td>
<td>CT22 Show Me the Money: Creating Alternative Fee Arrangements That Provide Value Intermediate Level</td>
<td>Room 6C</td>
</tr>
<tr>
<td>11:45 am – 1:00 pm</td>
<td>RT20 Trademark Offices in Africa: The Importance of Working with Related Government Agencies Beginner Level</td>
<td>Room IAB</td>
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<tr>
<td>11:45 am – 1:00 pm</td>
<td>RT21 Regional Update: The Latest News from the Middle East: Why is it so Important to Protect IP in the Region? Intermediate Level</td>
<td>Room 6D</td>
</tr>
<tr>
<td>12:00 pm – 1:00 pm</td>
<td>SPEED NETWORKING</td>
<td>HALL B</td>
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<tr>
<td>1:00 pm – 2:00 pm</td>
<td>Africa Reception</td>
<td>Room IAB</td>
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<tr>
<td>1:15 pm – 3:15 pm</td>
<td>LUNCHEON TABLE TOPICS</td>
<td>Room 5C</td>
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<tr>
<td>3:30 pm – 4:45 pm</td>
<td>CT50 Implications of the New European Trademark Directive</td>
<td>HALL B</td>
</tr>
<tr>
<td>3:30 pm – 4:45 pm</td>
<td>CT51 Legal Project Management: Improving Client Service While Reducing Ethical Risk Intermediate Level</td>
<td>Room 6C</td>
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<tr>
<td>3:30 pm – 4:45 pm</td>
<td>CT52 Trademark Enforcement by U.S. Customs and Border Protection Intermediate Level</td>
<td>Room 6B</td>
</tr>
<tr>
<td>3:30 pm – 4:45 pm</td>
<td>IT50 Industry Breakout Sessions: Hot Trademark Challenges That Keep Telecom Lawyers Up at Night Advanced Level</td>
<td>Room 6D</td>
</tr>
<tr>
<td>5:00 pm – 7:00 pm</td>
<td>In-House Practitioners Reception (Exclusive to in-house practitioners only)</td>
<td>Room TAB</td>
</tr>
<tr>
<td>6:00 pm – 7:00 pm</td>
<td>Law &amp; Practice Resources (LPR) Reception</td>
<td>Room 5B</td>
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