Spotify, for example, generates playlists for its users based on their personal data, Mr. Leonhard explained. “This is very powerful because it discovers stuff that you may really like,” he said.

The trend to move products and services to the cloud has consequences for IP law. IP infrastructure, and establishing regional IP platforms.

The plan, which is overseen by the ASEAN Working Group on IP Cooperation, also seeks to expand the region’s IP system, and promote asset creation and commercialization.

Some experts have said the Association of Southeast Asian Nations (ASEAN) has fallen short of its potential to be a unifying force in Southeast Asia. However, trademark specialists might disagree.

That’s because the ten-member region, home to more than 620 million people, has embarked on a ten-year strategic IP plan that involves close collaboration and a rotating presidency. These are heady times for IP owners in this vibrant and diverse region.

ASEAN and Madrid: Six Down, Four to Go

The ASEAN region has embarked on a ten-year IP plan, with accession to the Madrid Protocol one of the core aims. Ed Conlon analyzes progress so far.

The contribution of physical recordings such as CDs to global music revenues has been steadily declining between 2008 and 2017, and that trend is expected to continue, but the share of downloads has not grown much over the period. What has grown significantly, and is expected to accelerate even more until 2020, is the share of music streaming.

“One hundred million people are now paying to stream music on the Internet,” Mr. Leonhard said. “They pay for music which is otherwise essentially free on the Internet, because what they get on those services is vastly superior to YouTube.”

IoT is continuing to reshape music consumption. Streaming service Spotify, for example, generates playlists for its users based on their personal data, Mr. Leonhard explained. “This is very powerful because it discovers stuff that you may really like,” he said.

Futurist Thinking: From Products to Experiences

AI and the Internet of Things will change the meaning of ownership and what constitutes a copy, with consequences for IP lawyers as a result. Christian Wuestner reports.

Futurist Gerd Leonhard suggested during the Lunch and Learn event at the INTA Annual Meeting yesterday that IP lawyers may have to rethink how to protect intellectual property in an environment where intangible goods are rapidly overtaking the value of tangible ones. At the same time, their job roles are likely to change too.

As the Internet of Things (IoT) becomes more ingrained in our lives, the lines of ownership will further blur as revenues move from unit sales to experiences, Mr. Leonhard said, citing the music industry as an example.

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The trend to move products and services to the cloud has consequences for IP law.
ASEAN and Madrid: Six Down, Four to Go (continued)

Chew Phye Keat

There is the Madrid process but why can’t we revisit the idea of having an ASEAN trademark system?

Madrid Protocol by Numbers

Membership of the Madrid Protocol now stands at 98. ASEAN Member State Brunei was the last country to join the 125-year-old treaty, in 2016, the accord entering into force in January this year. Those 98 members cover 114 territories, all of which can be protected by filing just one international trademark application. Users pick one language and select one set of fees (in a single currency).

In 2016, the number of Madrid applications (52,550) was up 7.2 percent year-on-year, according to WIPO. U.S. applicants accounted for the most (7,741), with Germany (7,551), France (4,132), China (3,200), and Switzerland (3,074) taking the next four country spots. Of the ASEAN countries, Singapore ranked highest with 879. L’Oréal was the biggest filer, with 150 applications, while Glaxo Group (141), BMW (117), and Lidl (112) were close behind. Novartis, the most prolific applicant in 2015, filed 100 fewer applications last year (94) and now holds fifth spot. Applicants were most likely to specify computers and electronics (9.4 percent), ahead of business (7.6 percent), and technological services (6 percent).

China, with 22,314 designations, was the most popular destination country, followed by the European Union (21,526) and United States (20,979).

Going to Madrid

A central aim under the ten-year action plan is for all ASEAN countries to join the Madrid Protocol, which is administered by the World Intellectual Property Organization (WIPO).

Brunei, Cambodia, Laos, Philippines, Singapore, and Vietnam are all members, leaving Indonesia, Malaysia, Myanmar, and Thailand still to join. At the time of writing, there are 98 Madrid Protocol member states.

Chew Phye Keat, President of the ASEAN Intellectual Property Association, a private sector organization, says: “One by one they are coming through—Malaysia should be this year, others are on board, and the others are coming soon,” but he questions whether the infrastructure of some of the IP offices is ready.

Commenting on the strategic plan, Mr. Phye Keat says that, while there is a serious intent to improve the area’s trademark systems, “things are never moving quickly enough.” But, he adds, “we are getting there slowly but surely in a consensus-based way.”

Ms. Tan says that differences in IP regimes and domestic considerations across the Member States inevitably bring challenges when joining international treaties such as the Madrid Protocol.

“As one of the earlier adopters of the Madrid Protocol now stands at 98. ASEAN Member State Brunei was the last country to join the 125-year-old treaty, in 2016, the accord entering into force in January this year. Those 98 members cover 114 territories, all of which can be protected by filing just one international trademark application. Users pick one language and select one set of fees (in a single currency).

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China, with 22,314 designations, was the most popular destination country, followed by the European Union (21,526) and United States (20,979).
Futurist Thinking: From Products to Experiences (continued)

Companies used to earn money through physical copies of things, and through the copyright that covers them. But as seen in the case of music, for some sectors this is now less true, because once everything is in the cloud, the notion of “a copy” becomes less important.

Business models are adapting to focus on the right to distribute—“it’s about access, not ownership,” Mr. Leonhard said, and the definition of what “copy” means may have to be reassessed.

Technology is now a driving force in society, and this is reflected in company valuations. Companies such as Apple, Alphabet, Amazon and Facebook have made it to the top of the list of the most valuable companies.

“All the companies that offer non-physical products or services are on top of the food chain,” Mr. Leonhard explained. When products move from the physical world to the digital world they become cheaper. Consumers now value the experience more highly than the individual products, he noted, pointing to companies such as Airbnb and Uber, which do not own physical assets but rely on the strength of their platform.

The business trends toward experiences is set to affect the future of copyright and IP because experiences are quite different from products, Mr. Leonhard said.

“How do you license or protect an experience?” he asked.

3D Printing
Another trend that is likely to pose new challenges for IP lawyers is 3D printing, which is becoming increasingly common, Mr. Leonhard suggested. In the pharmaceutical industry, 3D printing of drugs is already possible, he said. In the future, a robot in a drugstore might be able to print a drug on demand. Brands such as IKEA might be able to print products on an individual basis onsite. The business model around this will need to be reinvented, Mr. Leonhard suggested.

“In a 3D world, do you sell the license to print? Do you own the printer?” he said.

Artificial Intelligence
Finally, Mr. Leonhard discussed artificial intelligence (AI), which is becoming more important to many business models and is likely to change some job roles. Stock traders might be replaced by AI machines; in China, there is already a face detection system which is set to replace some jobs within the police, he said. The connected world, together with AI, is going to reshape the working environment.

From a legal perspective, it is unclear who owns these AI businesses, Mr. Leonhard said, if this intelligence lives in the cloud. Would someone need a license to copy the product of AI technology, he asked. Who would have invented that technology?

The role of IP lawyers themselves is also likely to be affected by the inclusion of AI technology, primarily by taking away routine jobs, he suggested.

“All your routine work will be replaced—that much is certain. Research, discovery, fact-checking, filing, and accounting will be replaced by machines because they do not require ‘human’ work,” he said.

Critical thinking and emotional intelligence will be key skills in the future, he noted.

For lawyers this may mean that they will focus on topics that need to be understood at a deeper level, Mr. Leonhard concluded. “Let computers do the groundwork. Don’t be afraid of machines that can think.”

We don’t just practice Mexican IP Law.
We help shape it.
ASEAN and Madrid: Six Down, Four to Go (continued)

Protocol and seeing the advantages it brought to local as well as foreign rights owners, Singapore will continue to share with fellow ASEAN Member States our experiences on Madrid Protocol accession,” she says.

One of the challenges is language proficiency, according to Ms. Tan. She says that while companies file their trademarks in a language that works best for their business strategy, there are benefits from using English as a common filing language, especially in terms of filing internationally.

“As ASEAN Member States become more proficient in the English language, we will be able to reap the benefits from using English as a common filing language and become more efficient.”

A second difficulty stems from the region’s differing levels of development, she adds, noting that Member States are at different stages of economic and legal development, and have different priorities with regard to building IP expertise, IT infrastructure, and examination know-how.

“With varying levels of capacity, access to international treaties such as the Madrid Protocol will naturally progress at different speeds in different countries.”

Mr. Chew, whose organisation meets the ASEAN Working Group on IP Cooperation once a year to discuss IP strategies in the region, says that in future there could be a pan-ASEAN system for businesses to use instead of Madrid.

“We are assessing whether you need to go to Geneva—why can’t a Malaysian applicant go to the Malaysian Intellectual Property Office (MyIPO), file in other ASEAN countries and MyIPO will send the application there?”

“There is the Madrid process but why can’t we revisit the idea of having an ASEAN trademark system?” he asks.

The idea of a regional trademark system was previously rejected, he explains. As early as the late 1990s, the working group considered the issue but faced practical difficulties “with differences in language, jurisdiction, jurisprudence, and basic law across the member states.”

But now, with Madrid as a “backbone,” the idea seems more plausible, he says.

**ASEAN Impact Study**

At the end of December 2016, INTA’s Impact Studies Committee (ISC) commissioned a study to determine the impact of trademark-intensive industries on the economies of Indonesia, Malaysia, Philippines, Singapore, and Thailand. The study focuses on trademarks’ contribution to gross domestic product (GDP), external trade; tax revenue; foreign direct investment and job creation; and on their benefit to employment and wages. ISC’s project lead, Ai Ming Lee (Rodyk IP, Singapore) and team are working closely with Mr. Seth Hays, INTA’s Asia-Pacific Chief Representative, currently heads those efforts, and Queenie Zhao, Associate, Asia-Pacific Office, joined the office on January 2, 2017.

Mr. Hays has been with INTA since March 2011. His first role was External Relations Manager–Asia-Pacific, and he was subsequently INTA’s China Chief Representative. Today, he heads up and works out of the Asia-Pacific office. “It’s all about the members,” Mr. Hays says. A good day for him involves as much member interaction as possible, whether assisting INTA’s policy committees to advocate INTA’s positions to governments in the Asia-Pacific region, supporting the Education Department in organizing events, or pitching INTA’s services to current non-members. Ms. Zhao is tasked with fostering and increasing membership in the Asia-Pacific Region for the Association. Her daily work spans from assisting with implementing and conceptualizing programs in Asia-Pacific, in the form of roundtables, seminars, and leadership delegations, to increasing INTA’s corporate membership in the region and providing strategic advice on membership recruitment.

**INTA’s Asia-Pacific Office**

INTA’s newest office, opened in March 2016, supports the nearly 18 percent of the Association’s members who live and work throughout the Asia-Pacific region. Established as a branch office in Singapore, the Asia-Pacific office is active in education, policy advocacy, and member services. Seth Hays, INTA’s Asia-Pacific Chief Representative, currently heads those efforts, and Queenie Zhao, Associate, Asia-Pacific Office, joined the office on January 2, 2017.

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**For more information on INTA’s work in the ASEAN region, contact Seth Hays at: shays@inta.org**
Procter & Gamble: Keeping the IP House Clean and Tidy

Managing a global trademark operation at Procter & Gamble is no easy feat, as Deborah Brincat, Senior Legal Manager, tells Ed Conlon.

For every man seeking a clean shave, Gillette razors provide useful tools. For parents, Pampers diapers perform a vital service. And for anyone tackling the dirty dishes, Fairy dish liquid brings welcome relief.

It’s not easy categorizing U.S.-headquartered Procter & Gamble (P&G), the owner of these brands and many more. The company’s array of products are found in households across the world and play a multitude of unsung, yet vital, roles in the domestic lives of millions of people.

Underpinning this success is a focused, global approach to intellectual property protection. The company has approximately 80,000 trademark registrations covering multiple jurisdictions around the world. Staying on top of this portfolio is no easy task, and Deborah Brincat, Senior Legal Manager at P&G, is responsible for the company’s global trademark renewals and ownership records, as well as other duties.

Overseeing a huge operation for an international company such as P&G comes with its own set of challenges. Every issue regarding brand rights is magnified. Inefficiencies in the application process or costs of filing can be the source of a huge amount of friction. This is especially true for a company constantly looking to expand into new territories, where the rights protection system may not be as modern and awareness of the importance of IP rights not as high.

The Need for Digitization

“One of the biggest challenges with global renewals is when previous renewals aren’t recorded. It’s still paper files and they’re put into piles and hard to find,” Ms. Brincat says.

Failing to keep electronic records may be a seemingly trivial issue on the surface, but it can cause many headaches. For instance, P&G merged with Gillette approximately 12 years ago and is still dealing with some of the legacy issues from the transaction.

“Gillette has been a complicated one. Before we acquired the company, many trademarks were being assigned from the U.K. company to the U.S. company and these assignment recordals are still pending in countries where the trademark filing system was not computerized,” she recalls.

“Also, we’ve changed the company’s address, which has led to the renewal of many trademarks being suspended while the ownership change is not recorded in countries such as Bangladesh and Sri Lanka. And in countries where the electronic system has not been set up, such as Pakistan, you have to go into the office and ask them to look for the paper files.”

The other big difficulty, she says, is transferring files in some countries from one law firm to another, which “makes it hard to complete recordals or applications.”

Ms. Brincat has a great appreciation of the importance of having a modern administrative service. Having been involved with INTA for 15 years, including time spent on the Trademark Office Practices Committee, where she served a term as Vice-Chair, she currently serves as the Vice Chair of the Association’s Trademark Administrators Committee and is very familiar with the obstacles to seeking the necessary protections.

“We also have big challenges after we have acquired companies and try to keep the trademarks in the name of the acquired company. At some point someone starts filing the trademarks afresh in the name of The Procter & Gamble Company. This causes an issue in many countries, especially Latin America, because you can’t have two companies registering the same trademarks.

“Necessarily this leads to office actions and the trademarks being assigned from one company to the other.

“It becomes a long process and not very easy to handle. We will decide who should be the owner and then assign the marks to overcome the office actions. Trademarks are being moved around a lot, and this creates extra work and expense,” she says.

Different standards for IP protection apply from jurisdiction to jurisdiction and dealing with the idiosyncrasies of each system can be a problem for rights owners who need to move quickly. Even though the Internet has enabled people to complete a number of tasks around the world from one location, some offices are failing to take advantage of today’s communication tools.

Ms. Brincat says: “Globally we have to get everybody computerized—I have been told that in Sri Lanka the IP Office only has two computers.

“There are still many countries where you need documents notarized and legalized by the embassies, which is very time consuming. It is always a lot of work for us and the vendors we use, and it can get very complicated.”

Although North America, Europe and some Asian and Latin American countries have better processes, challenges still lie ahead. One such issue comes from trademark reforms in the European Union, under which the requirement to graphically represent a mark has been abolished. Until all trademark offices catch up, a graphical representation will be required when claiming priority or basing representation will be required.

Ms. Brincat continues: “Even though the Internet has enabled people to complete a number of tasks around the world from one location, some offices are failing to take advantage of today’s communication tools.

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Procter & Gamble has approximately 80,000 trademark registrations covering multiple jurisdictions around the world.

Deborah Brincat
Senior Legal Manager, Procter & Gamble

“Every issue regarding brand rights is magnified. Inefficiencies in the application process or costs of filing can be the source of a huge amount of friction.”
Mr. Justice Arnold: Brexit and Trademarks

What impact will the Great Repeal Bill, which will end the supremacy of EU law in the United Kingdom, have on UK trademark law?

It remains to be seen. The essential policy, as stated in the UK government’s white paper, is that as far as possible the law should be the same on the day after we leave the European Union as the day before we leave.

That’s very clear as far as it goes, but it leaves many questions unanswered. As far as UK trademarks and international marks in the United Kingdom are concerned, it would seem to follow from the policy stated that there would be very little change in the law following Brexit, at least immediately.

The mechanism by which that will be achieved is twofold. First, the Great Repeal Bill will provide for all legislation based on EU directives to be incorporated into our domestic legislation.

The second aspect is that the white paper says Court of Justice of the European Union (CJEU) case law will be given the same precedent in our courts as that from the UK Supreme Court.

But the position is quite different for EU trademarks: having left the European Union, the EU trademark regulation will no longer apply in the United Kingdom.

There are three basic options to address what happens: do nothing and allow EU trademark owners to lose their right in the United Kingdom; negotiate an agreement with the European Union that enables the United Kingdom to remain part of the EU trademark system post-Brexit; or enact national laws that give EU trademark rights in the United Kingdom, notwithstanding Brexit.

If you assume option one is commercially unacceptable, and option two is not feasible, then we are driven to option three.

At least six possible models that could be adopted have been identified but it’s a matter for the government to decide which they think is preferable.

What gaps will need to be filled in trademark law once the United Kingdom exits the European Union?

Presently, we have a rule of EU exhaustion of trademark rights, but not international exhaustion of trademark rights.

It would be possible for the government to leave this aspect of law unchaged but they might feel that post-Brexit, it doesn’t make sense to continue to have a rule of EU exhaustion. They would have to decide whether to go for international exhaustion or a rule of purely UK exhaustion, although that would seem to be rather unlikely.

One issue is what happens with pending applications at the date of the United Kingdom’s departure. There’s going to have to be some solution adopted.

The next issue is what happens with regard to the use requirement. At present, CJEU jurisprudence tells us that when assessing whether there has been use of a trademark you ignore geographical boundaries in the union.

The result is that it may be possible to maintain an EU trademark based on use in just one country, such as the United Kingdom.

Clearly, going forward, use in the United Kingdom won’t be sufficient, so questions will need to be addressed.

It’s difficult to see that there can be any legislative answer to that—trademark owners may have to take steps to make sure they make sufficient use of their EU trademarks.

What impact will Brexit have on trademark litigation?

It’s very difficult to tell as it depends on the future legislative solutions, but it would appear that it will have relatively little impact.

Issues may arise on exhaustion but that depends on the policy choices the government adopts.

If the government decides to maintain EU exhaustion rules there will be no impact; the only question is the future effect of the CJEU.

As for UK trademark litigation, there’s unlikely to be any impact in the short term, but perhaps there may be some in the medium term.
IN THE INDIAN SUBCONTINENT

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EUIPO: New Name, New Tasks

The European Union Intellectual Property Office has a lot on its plate, especially as a new batch of trademark reforms are set to come into force later this year, as Luis Berenguer, Member of the Executive Director’s Cabinet and Spokesperson of the Office, tells Sarah Morgan.

F rom preparing for EU trademark reforms to changing the Office’s name, it’s been a busy few years for the European Union Intellectual Property (EUIPO), and it’s not over yet.

In March 2016, the Office changed its name from the Office for Harmonization in the Internal Market, upon the entry into force of Regulation (EU) 2015/2424.

The same day, the name of the trademark it administers also changed, to the European Union trademark (EUTM).

“Our new name is translated into the 23 EU languages in which we operate, but the acronym remains uniform—in every EU language it is EUIPO,” explains Luis Berenguer, Member of the Executive Director’s Cabinet.

The single acronym helps the Office protect its users against fraud, by reducing the number of permutations and combinations of its name that fraudsters can appropriate, he adds.

The next big event on the EUIPO calendar takes place on October 1, 2017, when more trademark changes will enter into force.

EU certification trademarks will be introduced and the requirement of graphical representation will be eliminated, among other changes.

Second Phase

EUIPO’s current work is a continuation of efforts that have been underway at the Office for nearly four years. The first wave of changes saw updates to the EUIPO’s IT tools and website to fully reflect the new terminology and fee structure, while the signs around the office’s home in Alicante, Spain, were changed to reflect the new name and logo.

This time around there’s no name or terminology change but procedures before the office will be modernized, including removing obsolete methods of communication such as hand deliveries.

“The second phase of the implementation of Regulation 2015/2424 and the new secondary legislation is being implemented by the Office in a manner that ensures that the benefits for users take effect as soon as practicable,” says Mr. Berenguer.

Under the provisions of the amended Regulation, since March 23, 2016, cooperation has been a core task of the Office and part of its Strategic Plan 2020.

The EUIPO will continue to work with national and regional IP offices in the European Union on cooperation and convergence projects through the renamed European Union Intellectual Property Network (formerly known as the European Trade Mark and Design Network).

Another core part of the Office’s work is international cooperation.

Over the lifetime of the Strategic Plan, the EUIPO will continue its work as the implementing agency for EU-funded projects at the request of the European Commission, says Mr. Berenguer.

Doing the Research

Studies into the cost of IP infringement and the perception of IP are also within the EUIPO’s remit.

In 2012, the Office was entrusted with overseeing the European Observatory on Infringements of Intellectual Property Rights. One of the Observatory’s objectives is to provide evidence-based contributions and data to enable EU policy makers to shape effective IP enforcement policies and to support innovation and creativity.

Since 2015, the Office has carried out a series of studies looking at the impact of counterfeiting and piracy in a range of economic sectors.

“Many series of studies don’t measure infringement as such—it’s very important to point that out from the start,” says Mr. Berenguer.

“It measures the scale of the two major economic impacts of counterfeiting or piracy, i.e., the direct and indirect costs to industry, and the costs to governments and to society.”

So far, the Observatory has released 11 studies across sectors such as cosmetics and personal care, pesticides, smartphones, and recorded music.

“What all these sectors have in common is that they are known or are thought to be subject to counterfeiting (or piracy, in the case of recorded music),” explains Mr. Berenguer.

Nearl y €54 billion (US $58.8 billion) is lost each year in direct sales alone across the 11 sectors assessed, according to the study.

For example, in supply sectors, when you add in indirect sales, the number hikes up by €36 billion (US $40.4 billion).

Then there are lost jobs—every sector studied was affected by this problem, with the reports estimating that half a million jobs are directly lost as a result of counterfeiting in these sectors. An additional €15 billion (US $16.3 billion) was lost in government revenues.

It’s important to make clear that a large proportion of the businesses observed are small and medium-sized enterprises (SMEs), Mr. Berenguer says.

He adds: “We already know that SMEs are the backbone of the EU economy: 99 percent of all EU businesses are SMEs.”

The Importance of IP

Support for IP remains high across the European Union, according to the EUIPO’s study into the perception of IP in which 26,500 people aged 15 and over throughout the European Union’s 28 member states were questioned.

“Nearly everyone questioned (97 percent) agreed that it was important for inventors, creatives and performing artists to be able to protect their rights and be paid for their work,” says Mr. Berenguer, adding that the results of the study broadly confirmed the results of a 2013 study.

Nothing can justify the purchase of counterfeit goods, said 70 percent of respondents, while 78 percent said they believed buying counterfeit had a negative effect on businesses and jobs.

On the other hand, young people have a higher tolerance for buying counterfeit goods than the older generation, especially when the goods are purchased online.

One in ten of all respondents said they had knowingly accessed content from unauthorized sources, but that figure rises to 27 percent among 15 to 24-year-olds.

“The IP perception studies are the first EU-wide assessment of citizen perception and the relevant drivers of consumer behaviors,” explains Mr. Berenguer.

He adds: “They help us understand not just how people perceive IP, but to see how their perceptions change depending on how old they are, for example, or where they live. They are an extremely valuable pillar of our research and analysis work.”

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Keeping it Real: Fighting Back Against Fake News

Fake news took center stage yesterday as panelists discussed its impact on the publishing industry and the need for a speedy response. Ed Conlon reports.

“Break ing News: Donald Trump Shot on Stage” might be a gripping headline, but it is just an example of the growing phenomenon of “fake news,” which panelists discussed yesterday in IM01 Industry Breakout: Trademark Issues in the News and Publishing Industries.

Fake news, which many have identified in the past few years as a major threat to democracy, may have benefitted publishers’ business models, prompting people to seek quality and reliable content, but it is bad for their IP, said Jeffrey D. Parnass (News Corporation, USA).

He moderated a session on IP challenges faced by newspapers, book publishers, and other content producers, with Karen Louie (Harlequin Enterprises Limited, Canada), Nick Redfearn (Rouse & Co. International, Indonesia) and Kate Teh (Telegraph Media Group, United Kingdom) joining the panel.

Ms. Teh presented the fictitious President Trump story, which had been attributed to The Telegraph, and said the accompanying picture of the President lying bloodied on the floor had been taken from a WrestleMania event in which he had participated.

In emerging markets, the problem of fake books is still widespread, Mr. Redfearn said, noting that universities want fast access to textbooks and may use illegitimate printing or photocopying services to achieve this.

Even though this might seem to be more an issue of copyright, sometimes it’s easier to rely on trademark protection, especially when the trademark in question has been printed on the illegal cover.

Mr. Redfearn also discussed illegal reproduction in China of the Harry Potter series via machine translation, which was done “within days” of the books’ release. This type of activity can destroy a publisher’s ability to release an official translated version itself, he added.

Enforcement in emerging markets is a “matter of speed,” so cease-and-desist letters should be filed as soon as possible—the “whole industry needs to move very quickly,” he said.

However, he added, trademark rights need to be balanced with concerns over free speech and editorial freedom, and the public relations implications of any action should be carefully evaluated.

The session also assessed examples of flattery—where the infringer thinks the use does not harm the trademark owner because it is flattering, said Mr. Parnass.

Typically in these examples, the trade dress, title or logo of a book or newspaper are very similar to those of an existing publication, potentially causing brand confusion and dilution.

Ms. Teh, who said The Telegraph sees instances of flattery quite regularly, commented on one example by saying she was “particularly flattered that my riveting legal terms and conditions were worth copying.”

“I was particularly flattered that my riveting legal terms and conditions were worth copying.”

Kate Teh (second from left)

UNO Pizzeria & Grill Expands India Footprint

Amitabha Sen & Co., New Delhi, has advised UNO Pizzeria & Grill on its franchising agreement and protecting its diverse Intellectual Property Rights in India. The Boston-based chain, known for its Chicago style deep-dish pizza, will open 60-70 outlets across the country.

Amitabha Sen & Co. was represented by Dr. Amitabha Sen, Ms. Aditi Pandey, Ms. Nishtha Arora, Ms. Malyashree Sridharan, Mr. Nithi Nagpal, Mr. Puneet Dhawan, Ms. Pragati Aneja, and Ms. Garima Yadav. Pizzeria Uno Corporation was represented by Senior Vice-President and General Counsel Mr. George W Herz II. The team recently concluded the deal in London with Tastetaria Private Limited, India.

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Hague Convention:
Smoothing the Path of Cross-Border Litigation

In November 2017, discussions on updating a multilateral treaty governing foreign judgments will resume at the Hague Conference, an intergovernmental organization. Its First Secretary, Marta Pertegás, speaks with Uldduz Larki about the potential impact on trademarks.

Cross-border litigation can bring multiple challenges, but work is under way to ease the pressure in this area.

A new Convention is being negotiated and may become the successor to the 1971 Hague Convention on the Recognition and Enforcement of Foreign Judgments in Civil and Commercial Matters. This multilateral treaty is managed by the Hague Conference, an intergovernmental organization established in the 19th century.

Marta Pertegás, First Secretary of the organization, is one of the lawyers with primary responsibility for the commercial law and litigation area. This means she oversees a number of projects and leads the ongoing legislative initiative that may result in a new Hague Convention.

“The Hague Conference is an organization that dates back to 1893. It started with 13 states as participants in the first conference and became an intergovernmental organization in the 1950s,” Ms. Pertegás says. “The Hague Conference is now a group of 81 states plus the European Union.

Trademark Matters
Ms. Pertegás says there are other Hague Conventions dealing with trademarks, for example, one on “taking evidence abroad.”

“This can apply to a trademark infringement case where the evidence is located in another jurisdiction. In this case, Ms. Pertegás explains, the Convention would make it possible to launch a request from state A to state B so that state B can collect evidence and transmit it back to the country where the litigation takes place.

“When a judge in country A decides, for example, that there has been a situation of wrongful termination of a licensing agreement, it often has to be recognized somewhere else because some of the parties are in some other jurisdictions, or because there is a monetary fine that has been imposed and the money has to be collected in another jurisdiction.”

For this reason, the future Convention will facilitate the circulation of judgments and ensure that judgments have a cross-border effect. Ms. Pertegás clarifies that the Convention deals only with civil and commercial cases, so it does not extend to criminal matters.

She adds: “In some jurisdictions, trademark infringements can also be fought by means of criminal procedures, but that is beyond our remit.”

INTA’s Role
INTA has been an observer of the work of the Hague Conference, a status that has been granted to a number of nongovernmental organizations with particular expertise. INTA represents the trademark branch.

“This in itself is an interesting development, that from a trademark perspective, INTA has been closely watching our ongoing work to conclude a new Convention,” she says. “They are hopeful, as we are, that the new Convention will be useful for trademark litigants, generally speaking, and they have been very instrumental in explaining trademark matters to the negotiators of the Convention. These negotiators are officials specializing more generally in international litigation and do not have a background in IP.”

A task force within INTA’s Enforcement Committee—General Trademark Enforcement Matters Subcommittee (GTMEM SC) is presently working on comments to the draft text of the Hague Convention on the Recognition and Enforcement of Foreign Judgments from the perspective of trademarks that are the subject of judgments in cross-border enforcement cases. This entails balancing the generally territorial nature of trademark rights and registrations against the advantages of facilitating cross-border enforcement activities.

The draft Convention as prepared in 2015 is subject to comments and discussions among all stakeholders before the Special Commission, the first meeting of which took place from June 1–9, 2016, in The Hague. INTA was invited to participate in this meeting as an observer and was represented by Geert Johann Seelig (Luther Rechtsanwaltsgesellschaft, Germany), the GTMEM SC Task Force leader, and Iris Gunther, INTA’s Senior Advisor, External Relations—Enforcement, on June 6 and 7, when the discussions on IP took place.

Ms. Pertegás will be addressing the full GTMEM SC about the Convention and the importance of supporting its development during the INTA Annual Meeting.

TRADEMARKS ARE LESS CONTESTATIONAL THAN PATENTS.
ONE OF THE POSITIONS IS THAT PATENT LITIGATION SHOULD BE EXCLUDED FROM THIS CONVENTION’S SCOPE.

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For example, one on “taking evidence abroad.”

There were diverging views in a number of delegations on how to handle IP. Most IP matters are still subject to further considerations in the separate jurisdictions,” she says, and when the discussions resume in November this year, IP will no doubt be prominent on the agenda.

“Trademarks are less controversial than patents. One of the positions is that patent litigation should be excluded from this Convention’s scope. "One delegation doesn’t see the relevance of cross-border patent enforcement,” she explains.

Another proposal on the table relates to the nature of disputes, Ms. Pertegás adds. “Another delegation could only see contractual litigation as part of the Convention, so if you’re having a dispute on a trademark licensing agreement, recognition of enforcement of the resulting judgment is within the Convention. However if it is a trademark infringement case, they would not want it to be within the Convention.”

The Hague Conference hopes that INTA’s Annual Meeting in Barcelona will be an opportunity for people with views on cross-border trademark enforcement to discuss this further, says Ms. Pertegás.

“We need to make an effort and come up with compromises in that area. If that’s too difficult the most likely outcome is probably that it is excluded from the scope of the new Convention.”

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INTA’s 139th Annual Meeting in Barcelona, Spain

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**Private Labels: Keeping an Eye on Consumers**

Private labels need to be carefully designed so that they don’t mimic those of popular brands too closely, registrants at the Annual Meeting heard yesterday. Sarah Morgan reports.

"The rule is if you squint at it and you can’t tell the difference" between the packaging of a private label and a consumer product, the private-label good’s packaging needs to be changed, said Karen Feisthamel (Kacvinsky Daisak Bluni, USA) in CM03 Trade Dress: Brands vs. Private Label—When Is It Too Close for Comfort?

Ms. Feisthamel suggested that those making private labels meant to be an alternative to consumer products should use this test.

Joshua J. Burke (General Mills, USA) agreed that the "squint test" was a good idea to keep in mind, given that consumers spend roughly four seconds making product purchasing decisions, according to consumer research by the company.

He added that consumers read approximately seven words during their entire grocery shop.

John Pickerill (Fredrikson & Byron, USA) walked the audience through a U.S. case: McNeil Nutritionals v. Heartland Sweeteners, that covered the trade dress of the artificial sweetener SPLENDA.

"There’s a unique thing about trade dress disputes: when you analyze trademarks you don’t do a side-by-side comparison, you’re supposed to analyze in a vacuum. But in these cases, when putting brands right next to a private label, a direct side-by-side comparison is fair," he said.

Mr. Pickerill advised that when creating a private label, stores need to "drive a wedge" between its similarity with branded products, while ensuring consumers know the comparison and realize the difference.

In terms of litigation, Mr. Burke suggested that brand owners pick the "right target," adding that it was "probably better to go after someone who is not your customer" and instead choose the manufacturer.

He recommended that brand owners make it harder for competitors to imitate their packaging, by making it distinctive and strong.

Ms. Feisthamel explained that although private label goods are not exclusive to any one country, such goods have more "successfully penetrated" developed markets.

According to a 2014 survey by consumer study company Nielsen, 71 percent of respondents said that private label quality had improved over time.

The type of goods sold under private labels also differs among countries—in the UK, babycare goods lead the way, while in France and Italy alcoholic beverages are ranked highly, added Ms. Feisthamel.

Ms. Feisthamel explained that one factor people often don’t take into account is that the retailer and national brand owner are business partners.

"It [the business relationship] is a really interesting dynamic that drives a lot of these decisions," she said.

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**Panel: Private Labels**

Joshua J. Burke (left)
Trademark Oppositions: Proving Use in Latin America

In a discussion yesterday, lawyers from different parts of the region ran through the requirements for defending a cancellation action for non-use. Ed Conlon reports.

In Peru, sales invoices are the most important type of evidence to demonstrate trademark use when responding to a cancellation action, registrants heard during a panel session yesterday. The discussion—RM20 Regional Update: Impact of Absence of Local Use in Trademark Protection in Latin America—focused on Brazil, Mexico, and the Andean Community, a customs union comprising Bolivia, Colombia, Ecuador, and Peru.

Francisco Espinosa-Reboa (ESPINOSA BELLIDO ABOGADOS, Peru) said that in his home country, “you can have all the sales in the world,” but invoices are very important because they provide a reliable date of use that cannot be changed or forged.

He said the same applies in Ecuador, where copies of foreign invoices must be legalized by the Ecuadorian Consulate in the relevant country or by apostille, and if they are issued in Ecuador, the copies must be legalized by a notary public.

Mr. Espinosa-Reboa added that in Colombia, strong evidence includes certification issued by the tax auditor stating sales volumes of the products or services in any Andean country. Other evidence includes samples of advertising material and certifications issued by the advertising agencies that have promoted the brand.

In Bolivia, besides invoices, the inspection of the trademark owner’s warehouse is also considered relevant evidence, he said. For mass consumer goods such as food and beverages, the evidence must demonstrate use in all of the prior 36 months before the filing date of the cancellation action.

Marcela Bolland (Uthhoff, Gomez Vega & Uthhoff, S.C., Mexico), explained the rules in her country. Any type of evidence is permitted to demonstrate trademark use, with the only restriction being that personal statements and testimonials should be issued in “documentary form.” She said all documents must be exhibited in original form and that every piece of evidence must be in Spanish or accompanied by a translation.

For plaintiffs (opposers) rather than defendants—on which most of the discussion had focused—Ms. Bolland encouraged them to submit evidence that the opposed mark is not in use, saying it’s important to have “something on the file showing that you have tried to establish non-use.”

In Colombia, strong evidence includes certification issued by the tax auditor stating sales volumes in any Andean country.

In Brazil, said Rodrigo Affonso Ouro Preto (Ouro Preto Advogados, Brazil), fiscal and tax documents are considered essential documents to prove sales. Secondary evidence includes marketing and advertising materials, while import and export documents are permissible where relevant.

The amount of evidence required depends on the quality and quantity of the documents available to prove regular and effective use of the mark in the country, he said, taking into consideration the nature of the goods and services, as well as the characteristics of the market.

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**Mexico: Getting to Grips with the New Regime**

Almost a year after Mexico implemented a trademark opposition system, rights owners are coming to grips with the new regime. Naomi Jeffreys hears about its performance so far.

Under Mexico’s new trademark opposition system—which was approved by the Mexican Congress in April 2016 and became effective on August 30, 2016—trademark applications will be published no later than ten days after filing, objections must be filed 30 days after publication, and they must be based on absolute or relative grounds.

An opposition won’t result in the suspension of the registration process, and it is not mandatory to object or respond to the opposition. In addition, opposing an application doesn’t grant the opposing party any status as an interested third party.

The Mexican Institute of Industrial Property (IMPI) decides during examination whether an application might conflict with earlier rights and, therefore, this is the earliest the owner can invest time in reviewing all the objections. Álvaro Huerta (Malpica, Iturbe, Buj & Paredes, Mexico) says around 2,400 registrations have been filed so far.

“I would say that it has been working rather well from the trademark holder perspective. IMPI has decided 350 oppositions, with around 120 registrations being granted,” he adds.

Mr. Huerta says that trademark holders will have a “new opportunity” to protect their rights as they have an additional stage in which an application might be rejected, instead of having to challenge a registration, he says.

While the new system is not binding on IMPI examiners, IMPI has mentioned that it will analyze the applications that are filed.

Another issue is that a trademark owner has to consult the Official Gazette to find out whether someone has filed an opposition.

“You have to review the Gazette; if you don’t and someone has filed an opposition, you may lose the right or possibility to file your arguments,” says Mr. Huerta.

“Trademark holders will have to invest time in reviewing all the published Gazette to (i) review if they should file an opposition; or (ii) review if an opposition has been filed in connection with their recent applications,” he concludes.

Providing the Arguments

The trademark opposition system is a positive step forward for trademark owners in Mexico, and it brings Mexico into line with other jurisdictions, but how does it work in practice?

“You can provide IMPI with arguments and evidence to show that the pending application might violate your rights if you hold a prior registration,” Mr. Huerta explains.

“It allows you to use an alternative stage to protect your rights on a trademark if someone tries to file a similar mark.”

Mr. Huerta says it is a “good start” to have an opposition system, “even though there are some issues that can be worked on in the coming months and years.”

“For example, the process should be simplified by binding on IMPI, it should be possible to use an alternative system to specifically serve the holder of the application that was opposed, and a decision should be issued to explain to the opponent the reasons why the opposed application was granted.”

Other countries have opposition systems in which the oppositions are read independently—the examiner doesn’t analyze the opposition, he adds.

“Here the examiner in charge of the registration process is the same person that will review the opposition as part of the substantive examination.”

So far, Mr. Huerta adds, IMPI has been notifying the opponent when the registration is granted, but he reiterates that it is not legally obliged to.

While this is a good start, “there is still room for improvement,” he concludes.

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**INTA-IMPI Collaboration**

In October 2016, INTA and IMPI discussed best practices for examiners following the implementation of the trademark opposition system, as part of the fourth IMPI/INTA Annual Training Seminar that took place in Mexico. In particular, the discussions included the need to support the interpretation that consideration of an opposition to a trademark application during the examination process should be mandatory, rather than voluntary, for IMPI. During the course of the seminar, IMPI officers confirmed that all oppositions would be taken into consideration as part of the substantive analysis of an application.

INTA welcomes this development and hopes to continue the dialogue with IMPI to ensure the most effective and productive application of the new opposition regulations as another step towards a model trademark protection system in Mexico.
Things to Buy Before You Leave

Nougat, footwear, and football shirts are just some of the souvenirs that you could take home from your trip to Barcelona, as Ulduz Larki reports.

**Turrón**

Why not bring home the flavor of Barcelona in your suitcase with the classic Spanish nougat, turrón. It is a centuries-old confection, typically made from egg whites, honey, sugar, and almonds. Today, this mouth-watering sweet comes in different varieties of nuts, including peanuts, hazelnuts, and walnuts, among others. Turrón may also sometimes contain fruits, chocolate, marzipan, and liquor, and generally comes in two textures—hard and soft.

**Espardenyes**

If you want to prepare yourself for the summer season even more, getting a pair of espardenyes would be a good way to start. Espardenyes are typically flat shoes made from soft canvas. They also come with high heels. Although this footwear started off being associated with peasants, it is now also made available by designer brands.

**A Customized FC Barcelona Shirt**

FC Barcelona is the home of Lionel Messi, Xavi, and Neymar, some of the world’s greatest football players. The team might have lost out on winning La Liga, but if you are a Barça fan, know one, or are married to a Real Madrid fan, this may be the perfect purchase for you to bring home. Better yet, these shirts can be customized with your name.

**An Artistic Touch**

If a football shirt is too controversial, why not try a creative souvenir? Barcelona is famous for its art and the various shops stock dozens of unique gift ideas which enable you to take some of the city home with you. You can choose from the traditional fridge magnets through to small melting clocks inspired by artists such as Salvador Dali, so there is bound to be a souvenir that stands out for you—and most of them are designed to slip straight into your suitcase.

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**VOXPOP!**

**How do you find Barcelona as the location for this year’s Annual Meeting?**

It’s a terrific place. The city has a lot to offer from good food to museums and shopping. And the convention center is well located in the vicinity of two public transport stations.

Roberto Zurita, Deiurecorp, Ecuador

**What is the highlight for you here at the Annual Meeting?**

I like the hospitality area, which is a perfect meeting place every year. We can make use of the facilities to hold meetings with our clients.

Lauren Lau, China Trademark & Patent Law Office Co., Ltd., China

**How do you find Barcelona as the location for this year’s Annual Meeting?**

It’s a great location because it is absolutely gorgeous. People have the opportunity to see all the beautiful architecture. We are very happy to be here.

Joanna Szota, ZMP Zivko Mijatovic and Partners, Spain

**What are you most looking forward to at the Annual Meeting?**

We are looking forward to networking and learning about hot topics. I just spoke to somebody regarding misleading advertising, which is one of the topics I am really interested in.

Kshitij Saxena, Kan and Krishme, India

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Our network covers the protection of European Trademarks (EUTM) and provides full IP service in the countries of the Balkans, Central and Eastern Europe, namely:

Albania, Bosnia and Herzegovina, Bulgaria, Croatia, Czech Republic, Hungary, Kosovo*, Macedonia, Montenegro, Poland, Romania, Serbia, Slovak Republic, Slovenia, Spain (Including EUTM)

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In an ideal world, trademark rules would be harmonized across the globe. In reality, it’s not that simple. INTA, however, sets its sights high when advocating for brand owners.

No Size Fits All in Asia-Pacific

Asia-Pacific is a diverse region, from developed countries with strong IP laws to developing nations with extremely little protection for IP.

“There’s a very justifiable reaction that no one size fits all here,” explains Seth Hays, Chief Representative Officer of INTA’s Asia-Pacific Office in Singapore. “We have some jurisdictions with very top of the line IP protection, and others that don’t have anything. How do you link up the state of development with the need for investment? The right formula is going to be different for each.”

INTA representatives visit, and in partnership with the relevant INTA committees and often local INTA members, analyze each market and jurisdiction to tailor advocacy efforts to the local situation.

Over the years, the biggest facilitators of harmonization have been through various treaties such as the Singapore Treaty on Trademark Law and the Madrid Protocol, the accession to which are high on the list of INTA’s advocacy goals.

It’s been a major push by INTA, particularly in South East Asia where, over the last few years, some of the more reluctant and larger countries are now joining.

Indonesia and Thailand recently amended their laws to allow for Madrid applications. There are inklings that Malaysia will be working on amendments to its law as well.

More countries, however, need to join the Singapore Treaty, which harmonizes trademark office practice and procedures in order to streamline trademark registration and renewal.

The Trans-Pacific Partnership (TPP) also remains high on the agenda in the region, despite the United States’ decision not to join the agreement.

Mr. Hays says: “It’s still viewed as a viable agreement in the region, although it will need some adjustments.” He explains that free trade agreements such as the TPP, even
when not put into force, play a role in harmonization.

The Regional Comprehensive Economic Partnership (RCEP) between the ten member states of ASEAN plus Japan, South Korea, China, India, Australia and New Zealand also provides hope for harmonization with an IP chapter under negotiation.

“It’s not too far-fetched to say that nontraditional trademarks provisions in recently revised trademark laws have been as a result of nontraditional marks being included in these free trade agreements around the world,” adds Mr. Hays.

Boots on the Ground: Latin America and the Caribbean

In Latin America and the Caribbean, an ongoing physical presence is key to increasing INTA’s influence on trademark issues as well as membership growth in the region, according to Gabrielle Doyle, INTA External Relations Senior Associate, Latin America.

That’s one of the key factors that led the Association to open its first Representative Office for Latin America and the Caribbean in Santiago, Chile, on May 2, 2017.

“This new office will allow closer interaction with our members in Latin America and the Caribbean, enhanced policy engagement, and increased educational programming in the region,” says Ms. Doyle.

That’s not all: on October 2 and 3, the Association is holding a Latin America and Caribbean-focused conference titled, The Changing Landscape of Latin America, which will take place in Cartagena, Colombia.

“The reason we chose to host this conference is because the region is rapidly progressing as a serious investment hub and contender to other emerging markets,” she explains, adding that she expects there will be more conferences in the pipeline.

The Changing Landscape of Latin America conference will focus on the vast economic, social, and political developments taking place throughout Latin America and the Caribbean, and their impact on IP.

This conference will discuss investment opportunities, and the impact of IP and innovation on economic growth, among other topics. The broad range of topics offered will appeal to start-ups and established businesses, both small and large enterprises. And since our focus is on the vast socioeconomic and political changes in the region, it provides an opportunity for brand owners, business and economic experts, entrepreneurs and established businesses to network and learn from each other, says Ms. Doyle.

The new office and the conference both fit into the Association’s strategic plan of internationalization, as well as the objective of increasing awareness of IP and IPR enforcement as larger public policy issues in Latin America and the Caribbean.

Increasing the awareness of IP and IPR enforcement is key to alleviating the challenges posed from issues in the region that tend to be more socially accepted, such as buying counterfeit goods, explains Ms. Doyle.

INTA’s work also extends to encouraging the harmonization of efforts among government agencies, stakeholders, and specialized enforcement units.

“It’s about developing public and private partnerships. We try to encourage harmonization of trademark office practices through different activities such as informational workshops for examiners, “

INTA opened its first Representative Office for Latin America and the Caribbean in Santiago, Chile, on May 2, 2017.
organize our members,” says Ms. Doyle.

Earlier in May, the second annual forum on Promoting IPR Enforcement Policy in Latin America was held in Santiago, Chile with the specific purpose of discussing best practices for promoting IP rights enforcement at a national and regional level and increasing the role of the IP offices in the enforcement of these rights.

“Increasing awareness of IP is one of our most important objectives, and through the activities we have planned, we hope to encourage governments throughout the region to recognize the importance of protecting IP and make it a larger conversation on a national level,” explains Ms. Doyle.

One way to demonstrate this point is the trademark economic impact study the Association completed this year—Trademarks in Latin America: A study of their economic impact in five countries in the region (Chile, Colombia, Mexico, Panama, and Peru).

Ms. Doyle adds that the statistical data from Impact Studies will provide quantitative proof of the value of IP, offering additional motivation for governments to increase investment in IP-related institutions in the region.

Creating a Level Playing Field in Europe

The Europe Representative Office is also advocating for harmonization.

The Office aims to support and implement advocacy efforts in Europe, educational trainings and membership. It also supports various advocacy committees covering trademark protection in Europe, as well as geographical indications (GIs), the relationship between brands and innovation, and designs across the world.

For instance, the Designs Committee recently won INTA Board approval of a resolution supporting adherence to the Hague Agreement Concerning the International Registration of Industrial Designs, another way to foster the centralization of all requirements for international registered design applications.

Hélène Nicora, INTA Representative Officer, Europe, says that the European Union “has heavily contributed to increased harmonization in the EU and its neighboring countries, particularly in the trademark arena.”

In March 2016, trademark reform came into effect, resulting in the rebranding of the Office for Harmonization in the Internal Market to the European Union Intellectual Property Office (EUIPO), a reduction in fees, and substantive and procedural changes to European Union and national trademarks.

INTA has been there every step of the way, to influence the outcome of the trademark reform.

Although the European Union is not fully harmonized, the reform has definitely improved the trademark landscape, with the elimination of some major discrepancies across the 28 member states.

INTA is also involved as an Observer in the EUIPO Management Board and Budget Committee, and the EUIPO’s numerous convergence projects, aimed at bringing closer the practices of EUIPO with those of national offices. INTA is also very active in the EU Observatory for the Infringements of IPRs.

INTA’s Europe office recently celebrated its ten-year anniversary. In this period, it has managed to develop relationships with key stakeholders in Europe and central Asia, be it national offices, enforcement authorities, agencies like the World Customs Organization and Europol, and other associations.

The Office is busy monitoring and advocating on EU legislation impacting IPRs, such as the Customs Regulation, the upcoming review of the EU Directive on Enforcement of IPRs, and the potential review of the EU Designs system or non-agricultural GIs.

“Some IP rights, such as trademarks, are more harmonized than others, and the Association has played a big role in this,” explains Ms. Nicora. “But there are still improvements to be made—we’ve not reached global harmonization in any area.”

Much like Ms. Doyle, Ms. Nicora is concerned with the abundance of counterfeits, this time on a global scale.

“Counterfeiting is a global phenomenon, and to deal with this, we need a global answer. This is an issue where every region of the world should try to reach a common answer.”

“Counterfeiting is a global phenomenon, and to deal with this, we need a global answer. This is an issue where every region of the world should try to reach a common answer,” she says. This is one of INTA’s core objectives: advocating for strong trademark protection laws and vigorous enforcement in order to provide the same experience to brand owners wherever they are in the world.

To make this happen, the Association ensures that any position it advocates in one jurisdiction is consistent with that in another, but taking into consideration regional and local differences.

“INTA has a global view, meaning it’s in a good position to make constructive recommendations that are consistent across regions,” says Ms. Nicora.

One set of trademark rules applying to the whole world is “the dream objective,” she says, adding that it’s key that the INTA committees and external offices all communicate.

But change can be a slow process for two reasons.

First, IP protection is not a priority for all governments, and INTA makes sure to provide education on this essential aspect.

Second, reaching consensus with such a large number of stakeholders is not easy. Some practices and laws governing IP have existed for a long time, so it’s difficult to change people’s minds, explains Ms. Nicora.

Despite such difficulties, INTA will continue working hard to achieve its harmonization aims.

Visit the Pro Bono Clearinghouse at the INTA Information Booth!

Are you aware of all of the benefits that Pro Bono legal services can provide? Not only do pro bono services help the legal community as a whole, but they can greatly assist an attorney’s career.

INTA is proud to have recently launched a Pro Bono Clearinghouse to match eligible individuals and non-profit organizations with attorneys prepared and able to assist. To learn more about this program and all of its benefits, come visit the Pro Bono Clearinghouse Information Booth, located at the INTA Information Booth in Hall 8.

Members of the Pro Bono Committee will be available at the booth from 9:00 am to 5:00 pm today. If you cannot make it to the booth, but want to learn more or know of any individual or nonprofit organization that may be in need of free legal services, please see box, right.

Pro Bono Committee website:
http://www.inta.org/Membership/Pages/2017_ProBono.aspx

Any questions?
Seth Hays:
shays@inta.org
Gabrielle Doyle:
gdoyle@inta.org
Hélène Nicora:
hnicora@inta.org
Read All About It:
The TM5 Subcommittee

One of INTA’s youngest subcommittees covers the TM5, a cooperative effort between five major trademark offices. The subcommittee’s Chair, Elisabeth Escobar, speaks with Naomi Jeffreys about its importance.

When it comes to international collaboration, there is one INTA committee that is working overtime—the TM5 Subcommittee, which falls under the Trademark Office Practices Committee.

Five trademark offices, known as the TM5—the Japan Patent Office (JPO), Korean Intellectual Property Office (KIPO), European Union Intellectual Property Office (EUIPO), China’s State Administration for Industry and Commerce (SAIC), and U.S Patent and Trademark Office (USPTO)—work on joint projects and exchange information on trademark-related matters. Elisabeth Escobar (Marriott International, USA) is Chair of the TM5 Subcommittee, which was formed just last year.

“INTA had a Presidential Taskforce to study its committee structure a couple of years ago, and the recommendations included proposals for a number of new committees and subcommittees,” explains Ms. Escobar. The formation of a subcommittee focused on the TM5 was one of those adopted.

“Our mission is twofold: first, to facilitate INTA’s increased involvement in the TM5 process, and second, to raise awareness among INTA’s membership regarding the TM5 and their good work. “INTA recognized, rightly, that to have serious involvement in the TM5 process and to be effective, we needed a dedicated subcommittee.”

Each of the TM5 projects is led by a member office. Currently, the TM5 has 13 active projects underway and it is considering a proposal by KIPO for a fourteenth project on how TM5 members describe goods and services.

One of the longest running TM5 projects, she says, is the ID List Project. According to the TM5 website (www.tmfive.org), this project is an attempt to enable rights owners seeking protection in multiple jurisdictions to enjoy benefits from the use of pre-approved identifications (IDs)—descriptions of the goods and services that each trademark identifies.

“It is expected that the project may result in a ‘unified’ list of IDs that are acceptable not only to the IP offices of each of the five TM5 partners, but to IP offices in other jurisdictions as well,” it says. Ms. Escobar explains that over 17,000 IDs have been approved by the TM5 to date. “For a global filer like my company, that is tremendously helpful,” says Ms. Escobar, who is Vice President and Senior Counsel, Intellectual Property, at Marriott International.

TM5 at the Annual Meeting

On Sunday, May 21, the TM5 hosted an event at the INTA Annual Meeting called TM5 Workshop Presentation of the Compilation of Case Examples of Bad Faith Trademark Filing.

More than 17,000 identifications, which are descriptions of the goods and services that each trademark identifies, have been approved by the TM5.

Discover INTA’s newest searchable guide!

Enforcement: An International Litigation Guide, covering more than 40 jurisdictions, is a ready reference for quick information on the key aspects of trademark litigation practice. From pre-filing requirements to emergency proceedings to remedies, costs, and post-judgment relief, the searchable guide provides basic, essential information helpful to selecting a venue in multijurisdictional infringement controversies. This members-only guide is designed to provide a first overview to help direct consideration and discussion with counsel in jurisdictions of interest.

To learn more about this INTA member resource, visit www.inta.org/enforcementguides
INTA and QBPC: Continuing the Collaboration

INTA and China’s Quality Brands Protection Committee (QBPC) signed a cooperation agreement at the Annual Meeting yesterday to reinforce trademark protection for their members.

The agreement requires both parties to recognize the value of trademarks as a vital form of intellectual property to protect consumers and to promote fair and effective commerce.

It follows a rapid increase in the trade in branded goods within China and between China and other nations. QBPC comprises members of the China Association of Enterprises with Foreign Investment.

“The great thing about QBPC is that you are on the ground,” said INTA CEO Etienne Sanz de Acedo. “The good thing about INTA is that we can bring in the international expertise,” he added.

INTA President Joseph Ferretti noted that the Association is paying attention to brands more holistically as part of its Strategic Plan. “Part of that is education, so we greatly appreciate the agreement we are here to sign today,” Mr. Ferretti said.

The purpose of the agreement is to establish a strategic cooperation and to set forth a framework between INTA and QBPC, to protect the trademark rights of their members in accordance with the shared objectives of the parties.

“QBPC is full of energy and passion. We have the guts to do the right thing and keep on going,” he said.

Potential cooperation activities include the development of programs and specific collaborative projects related to trademarks, dispute settlement, trademark rights enforcement, and in other related areas. The agreement also includes the exchange of research and information on issues of mutual interest; exchange of experience and educational material; and the organization of congresses.

Furthermore, the two parties aim to accept members of each other’s organizations.

Within this framework of cooperation, INTA and QBPC will respect the “commercial-in-confidence” status of information provided by either party to this cooperation agreement, subject to any overriding legal obligations affecting either party.

“We are very much looking forward to continuing our efforts in China,” said Mr. Sanz de Acedo.

The agreement will be in full force from May 2017 to May 2020.

AIPPI welcomes Members and Non-Members (“NEW”) to Sydney in October!

AIPPI has been “Shaping IP for 120 Years”. This is your year to take part in that activity and to do it in what promises to be an unforgettable AIPPI World Congress in one of the world’s most beautiful and welcoming cities.

NEW for 2017!

• For the first time, AIPPI Congress registration is open to non-members
• The first year for the annual Young Participants Forum
• Special 120th Anniversary Celebration

Early bird registration deadline - June 27, 2017.

For Registration and Programme information about the 2017 AIPPI World Congress please go to aippi.org or email us at registration@aippi.org
AFFILIATE RECEPTIONS

1. Arochi & Lindner, Shoko
2. DLA Piper, W Hotel Barcelona
3. Wan Hui Da, El xalet de montjuic
4. H K Acharya, Crowne Plaza
5. Petosevic, Renaissance Hotel
6. Osler Hoskin Harcourt, Hotel Casa Fuster
7. Allen & Overy, Torre d’alta Mar
8. Arnold Siedsma, Círculo del Arte

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Tuesday May 23
Office action

Tuesday May 23

**Daily News Schedule**

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<td>Brands and Innovation Committee - Full Committee</td>
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<td>International Amicus - Full Committee</td>
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<td>Trademark Scholarship Symposium - Session (Advanced Level)</td>
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<td>CT03 IP Representations and Related Provisions in M&amp;A Transactions (Advanced Level)</td>
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<td>CT02 Potential Liability of Intermediaries in the Real World (Intermediate Level)</td>
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<td>CT01 Annual Review of Leading Case Law in the European Union (Intermediate Level)</td>
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<td>Harmonization of Trademark Law and Practice Committee - Full Committee</td>
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