Interview: John C. Knapp, Solidoodle
How Brand Owners Can Learn to Love 3D Printing

As countries including Brazil, China, India, South Africa, United Arab Emirates and the United States make increasingly significant investments in 3D printing technology, companies like Solidoodle—a leading consumer 3D printing manufacturer—flourish. John C. Knapp, General Counsel at Solidoodle, and Solidoodle CEO Sam Cervantes will be addressing INTA members about the rapid growth in this technology during the Association’s 3D Printing/Additive Manufacturing Conference, which will be held March 10–11 in New York, New York, USA.

By 2018, it is estimated that 3D printing—which allows average consumers to “print” three-dimensional objects—will result in the loss of at least $100 billion per year in intellectual property globally. At the same time, knee-jerk attempts to address these losses through litigation could ultimately cost companies even more.

To help mitigate these losses and bridge the divide between the 3D printing industry and trademark owners, the INTA Bulletin spoke with Mr. Knapp—who practiced trademark, copyright and advertising law prior to joining Solidoodle—to learn more about the potential opportunities presented by this latest “disruptive” technology.

What is Solidoodle?
Solidoodle is a leading consumer 3D printing manufacturer founded by former Makerbot COO Sam Cervantes in 2011.

Who are your products geared to and what is the average cost?
Since its inception, Solidoodle has been

See “Knapp” on page 3

Association News

Interview: Lu Guoliang,
Deputy Director, WIPO China Office

During INTA’s Delegation visit to China in January, Lu Guoliang, Deputy Director of WIPO’s China Office, met with INTA leaders and staff to discuss the role of the office in helping local users of the Madrid System to cope with expansion of the Madrid Protocol throughout the ASEAN region as well as other parts of the world, among other important mandates. Here, Mr. Lu explains to the INTA Bulletin how WIPO’s China office is working with Associations like INTA to expand access to WIPO resources and to educate users about the Madrid and Hague Systems.

What is your background in IP?
Before joining the WIPO China Office, I worked with WIPO for four years as a Senior Program Specialist. Prior to that, I was the Director General of the International Cooperation Department of the State Intellectual Property Office (SIPO) in China.

What does your role with WIPO in Beijing entail?
WIPO’s China Office is one of six WIPO External Offices, including the liaison office in New York. Its goal is to provide a better liaison between WIPO headquarters (HQ) in Geneva and its member states and to promote WIPO’s services and various IP cooperation programs in the host countries.

My role is to ensure that the following mandates are carried out efficiently and effectively:

See “Lu Guoliang” on page 5
Welcome New Members

Giorgio Armani S.p.A., Milan, Swiss branch, Mendrisio, Mendrisio, Switzerland
Glaser Wei Fink Jacobs Howard Avchen & Shapiro LLP, Los Angeles, California, USA
Glen Raven Mills, Glen Raven, North Carolina, USA
GODYO & ASSOCIADOS, Tegucigalpa, Honduras
GOLAB INTELLIGENT PROPERTY, Coral Gables, Florida, USA
Gordon, Gordon & Co., Castries, Saint Lucia
Gresham Savage Nolan & Tilden, PC, San Bernardino, California, USA
HIREN THAKKAR & ASSOCIATES, Ahmedabad, India
Hodgson Legal, Santa Monica, California, USA
Huyi Global Internet Trademark Domain Registry, Hong Kong SAR, China
IBM Corporation, San Jose, California, USA
IDEX Corporation, Lake Forest, Illinois, USA
IndusLaw, Bangalore, India
Intelegal, Karachi, Pakistan
IP TRADER, Latham, New York, USA
IQAir North America, Inc., La Mirada, California, USA
Jackson Consulting, Philadelphia, Pennsylvania, USA
Jaguar Land Rover North America, LLC, Mahwah, New Jersey, USA
JK LEGAL SERVICES, Encinitas, California, USA
Jupiter Law Partners, Gurgaon, India
Kapur Law Chambers, New Delhi, India
Katun Corporation, Minneapolis, Minnesota, USA
Keller Jolley Preece, North Salt Lake, Utah, USA
KIPA, Helsingborg, Sweden
Knoll PC., New York, New York, USA
Knyazyan & Partners IP Law Firm, Yerevan, Armenia
Koffsky Schwalb LLC, New York, New York, USA
Kuit Steinart Levy, Manchester, United Kingdom
Kurz Pfitzer Wolf & Partner Rechtsanwälte mbB, Stuttgart, Germany
KWR Karasek Wietrzyk Rechtsanwälte GmbH, Vienna, Austria
Law Firm Sonia Tondowski-Elkrief, Geneva, Switzerland
Law Office of Afsoon Hamid, Santa Monica, California, USA
Law Office of Heena Kampani, Norcross, Georgia, USA
Law Office of Stacy J Grossman, New York, New York, USA
Lee & Hayes, PLLC, Spokane, Washington, USA
Legalmax, Almaty, Kazakhstan
LEGAL MAXIMS CONSULTANTS, Dubai, United Arab Emirates
LEXEA Rechtsanwälte, Cologne, Germany
Lex Machina, Menlo Park, California, USA
Lex Propriadeite Intelectual Ltda., Rio de Janeiro, Brazil
LIAD WHATSTEIN & CO., Bnei Brak, Israel
Linklaters Oppenhoff & Radler, Munich, Germany
Lippert, Stachow & Partner, Bergisch Gladbach, Germany
Lynch Kneblewski Advogados Associados, Sao Paulo, Brazil
MacPherson Leslie & Terman LLP, Regina, Saskatchewan, Canada
Maipica, Iturbe, Buj y Paredes, S.C., Mexico City, Mexico
Mango Attorneys, Inc., Johannesburg, South Africa
Malpica, Iturbe, Buj y Paredes, S.C., Mexico City, Mexico
MCCARTER & ENGLISH, LLC, New York, New York, USA
MEDINA Y MERINO SC, Mexico City, Mexico
MelaLeuca, Inc., Idaho Falls, Idaho, USA
Miller Thomson LLP, Waterloo, Ontario, Canada

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

Chair
Barbara Sullivan, Henry Hughes

Vice Chair
Liisa Thomas, Winston & Strawn LLP

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

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

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

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

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

Chair, Law & Practice: Middle East & Africa Subcommittee
Ghaida Ala’Eddein, Saba & Co. IP

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

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

Chief Executive Officer
Etienne Sanz de Acedo

Chief Knowledge Officer
James F. Bush

Editor-in-Chief
Eileen McDermott

Editor
Joel L. Bromberg

Graphic Designer
Eric Mehlenbeck

INTA Bulletin Staff

INTA Officers & Counsel

President
J. Scott Evans, Adobe Systems Incorporated

President Elect
Ronald Van Tuilj, JT International S.A.

Vice President and Secretary
Joseph Ferretti, PepsiCo, Inc./Frito-Lay, Inc.

Vice President
Tish Berard, Hearts On Fire Company LLC

Treasurer
David Lossignol, Novartis Pharma AG

Counsel
David Fleming, Brinks Gilson & Lione

Although every effort has been made to verify the accuracy of items in this newsletter, readers are urged to check independently on matters of specific interest. The INTA Bulletin relies on members of the INTA Bulletin Committee and INTA staff for content but also accepts submissions from others. The INTA Bulletin Editorial Board reserves the right to make, in its sole discretion, editorial changes to any item offered to it for publication. For permission to reproduce INTA Bulletin articles, send a brief message with the article’s name, volume and issue number, proposed use and estimated number of copies or viewers to bulletin@inta.org. INTA Bulletin sponsorships in no way connote INTA’s endorsement of the products, services or messages depicted therein.

© 2015 International Trademark Association
Interview: John C. Knapp, Solidoodle continued from page 1

dedicated to making 3D printing affordable and easy to use. When the company launched, it offered the first ever, fully assembled 3D printer for under USD 1,000. Today, 10,000 units later, our sixth generation product, the Solidoodle Press, offers single-touch operation in a sleek, modern design for just USD 599. Our Workbench line, which is geared toward professional and advanced users, offers even greater functionality in an open frame form factor beginning at USD 899.

What is your background and role within the company?
Before joining the company, I practiced as a trademark, copyright and advertising lawyer for 10 years, representing consumer electronics, fashion, toy and entertainment clients. I am also a life-long hobbyist and tinkerer, so I had followed the explosion of consumer-accessible 3D printing with great interest even before I brought in Solidoodle as a client. I joined the company as General Counsel just under a year ago.

What is a typical day like?
The one thing I can say is no day is typical. I spend a lot of time overseeing intellectual property matters, including maintaining the terms of service and user agreements for our file-sharing site and software and hardware products, negotiating agreements with content partners, developers, and distributors and maintaining our trademark and patent portfolio. But I also spend a good amount of time dealing with the business’s operations and financing. One of the more exciting aspects of being General Counsel is the diversity of issues that you encounter. Each day presents its own fascinating challenges.

Why is 3D printing an important technology, and how quickly is it evolving?
As President Obama said in his 2013 State of the Union address, “3D printing has the potential to revolutionize the way we make almost everything.”

INTA and the trademark bar can work with 3D printing industry stakeholders to create a dialogue.

Traditional manufacturing methods require substantial upfront investment. Say, for example, you have an idea for an amazing new mobile phone case. Using plastic injection molding, you would need to pay anywhere from USD 5,000 to USD 25,000 just to have the mold built. So you would have to be sure you would be able to sell thousands of units just to recoup that cost. And if you wanted to make any changes to your design—either to fix a problem you failed to spot before the mold was made, or to modify it to fit the newest mobile phone that was released right after—you would need to have an entire new mold built, at the same price. If your project is more complicated and is comprised of multiple parts, you would need to have multiple molds built, multiplying that upfront cost. And then there would be additional costs for shipment, warehousing, inventory management, etc.

With 3D printing, for less than USD 1,000, you can design and build your mobile phone case right at home. If you print it out and want to make adjustments, you can just edit the file in your CAD software and print it again. In fact, beyond just making adjustments, you can make customizations, offering multiple colors, monograms, messages, images, etc., to your customers, all without any additional cost. And you can print to order, so there is no inventory management.

Hear legal experts, policy makers and industry thought leaders address the legal issues stemming from the ongoing, widespread use of 3D printers. Find out the answers to:

- How will 3D printing challenge IP laws and affect the value of IP?
- What are appropriate responses and solutions to such challenges?
- What are the ingredients for 3D printing-driven IP disruption?
- How can the growth of 3D printing technology be assisted while protecting the value of intellectual property?

Learn more and register at www.inta.org/2015-3DPrinting
Interview: John C. Knapp, Solidoodle

continued from page 3

For the potential entrepreneur, 3D printing substantially lowers the barriers to entry. Think of the amazing products and solutions that have never made it to market because the weekend tinkerer didn’t have the time or resources to commercialize them. Seeing the amazing things—and businesses—our customers create with our printers is one of the more rewarding parts of the job.

But beyond the entrepreneurs among us, 3D printing offers an unprecedented way to engage with whatever you are passionate about. From jewelry, to crafts, to model trains, to eyewear, to cycling, to action figures, to personal drones, to photography, 3D printing allows you to customize, personalize and share with a community of your peers whatever hobby or interest you have. As more and more content becomes available, and design software becomes more and more intuitive, even consumers with no technical or design background will be able to take advantage of this incredible technology.

As an IP lawyer, you must understand the reservations some trademark owners have about 3D printers—what would you say to them? I think brand owners will always be nervous when a new technology allows consumers to interact with their content in new ways that they cannot control. But I think anyone who paid attention to the movie industry’s battle with home video recorders, or the music industry’s campaign against digital file formats, understands that content owners can and should embrace disruptive technological innovations to create new markets for their properties. The SuperFanArt project, in which Hasbro has allowed the Shapeways community to create and sell their own 3D designs based on My Little Pony characters, is an outstanding example of this is. The Finnish 3D printing marketplace Lauzun announced a similar deal with Warner Brothers and ITV that will launch later this year and make Looney Tunes, Superman, Batman, Thunderbirds and other popular brands available as 3D printed content. And MyMiniFactory currently is holding a contest that awards a GoPro camera to who ever designs the best 3D printed GoPro accessory. So I think brand owners would do well to spend more time figuring out opportunities like these to embrace 3D printing than worrying about ways it may be abused. In some ways, the presence of infringing content indicates that there is demand for that content, and a savvy brand can fill that demand itself.

In some ways, the presence of infringing content indicates that there is demand for that content, and a savvy brand can fill that demand itself.

Do you think it might be necessary at some point to enact laws that regulate what 3D printers can be used for or how CAD files are used? I think Digital Millennium Copyright Act (DMCA)-like safe harbors for trademark and patent claims make sense, and many 3D printing ISPs have, to good result, implemented terms of service that extend their notice-and-take-down policy to those claims. But that means, for example, that long-standing concerns about how that regime handles fair use determinations extends to those claims as well.

I also think everyone watching this market develop is worried about overreaction. For example, I have seen concerns raised about 3D printed content being labeled as being “compatible with” popular brands. But we have cases addressing third party automotive parts that provide pretty good guidance on how nominative fair use applies in that context. So, we should think carefully about what, if anything, is truly unique before clamoring for new laws. An infringing CAD file is an infringing CAD file; it may be more difficult to chase it down in a distributed manufacturing environment, but we have to balance that inconvenience against the possibility that new laws could stifle innovation in a young and exciting new industry.

How can trademark lawyers work with the 3D printing industry to mitigate infringement issues and use this technology to their advantage? Perhaps because of the sensationalism that pervades the media, new industries often are branded with the reputation of their worst representatives. While any technology can be abused, I would encourage the trademark bar to refrain from treating the entire industry as a threat, or overplaying their hand when they do see potential infringement. I think INTA and the trademark bar can work with 3D printing industry stakeholders to host events, educate, and create a dialogue that will help both sides take advantage of the opportunities this revolutionary technology presents.

What does the near future hold for Solidoodle and for 3D printing generally? As easy as it is to think of 3D printing as a technology of the future, it is still beholden to decidedly old-economy problems like supply lines and inventory. In recent months, Solidoodle has been beset by the West Coast port slowdown caused by a dispute between the Longshoremen and port operators. So, in the very short term, we will be shoring up our supply lines to meet rising demand. But we are very excited about our current models and the new product announcements slated for later this year. We recently released our first generation software and web properties as well, and are working on partnerships that will make it even easier for consumers to design, customize and build amazing creations right in their homes. Combined with a new generation of 3D printers that will offer new features unavailable anywhere near our price point (if at all), we are very excited for the future of the company and industry.

More than 100 international IP professionals have registered for the 3D Printing/Additive Manufacturing Conference. Learn more on inta.org and register to attend here.
Interview: Lu Guoliang, Deputy Director, WIPO China Office

• Promoting closer relations and cooperation between WIPO and the government of China, industry and the private sector, as well as the general public.
• Providing legal and technical assistance on all aspects of industrial property and copyright and related rights as well as cooperation-related activities.
• Promoting WIPO services and providing assistance to users.
• Liaising with WIPO HQ on pertinent issues that affect the work of the Organization and providing support for the work of the Organization in China.

What is a typical day like for you?
Since it was established in July 2014, the WIPO China Office has been quite busy in dealing with the tasks above. The seven hour time difference between Beijing and Geneva can be a challenge, and we are responsible for hosting officials when they make local visits, fielding phone calls from users and other Chinese stakeholders of IP, as well as conducting missions outside of Beijing. In short, there is always a lot of work throughout the day.

Can you provide specific examples of ways in which you accomplish these goals?
In 2014, while continuing to finalize administrative arrangements of the office in consultation with Chinese authorities, the WIPO China Office undertook 15 missions, both in and outside Beijing, representing WIPO on various IP outreach events. We organized or co-organized IP events in Beijing, including two seminars last November and December—one on protection of industrial designs for Chinese enterprises and the Hague Agreement Concerning the International Deposit of Industrial Designs (Hague System), and another on the promotion of the Marrakesh Treaty.

Why is it important for WIPO to have a presence in China?
China is a member of many treaties administered by WIPO, and has made remarkable achievements in developing its IP systems over the past decades. In recent years, China’s national filings in patent, trademark and industrial designs remained number one in the world; it is therefore a huge market for WIPO services, reflecting the important role that IP can play in an innovation-driven economy.

How can INTA help WIPO to achieve its mission?
I am very happy to have met with J. Scott Evans, the 2015 President of INTA, at the WIPO China Office in January, as well as other INTA staff. Our discussion on promotion of the Madrid and Hague Systems in China was constructive and encouraging. INTA is a strong supporter of the Madrid and Hague Systems, and China is a huge potential market for the use of these Systems. As the ASEAN countries are set to join Madrid in the next couple of years, the potential for increased use of Madrid in China and more generally in the region is enormous. The WIPO China Office will have an important role in supporting local users in China through these changes. In reaching out to those users, the WIPO China Office will also be attentive to the difficulties they face in using these Systems. This feedback will be communicated to WIPO HQ to be shared with policy makers with a view to ensuring that the Systems evolve in line with the needs of the local Chinese users.

INTA can play an extraordinarily important role in helping to promote the Madrid System in China in particular, and helping to educate users about it. The Chinese market is so vast that this challenge must be met by WIPO working together with many players in the region, and INTA clearly is one of the most important.
Avoid discovery delays by drafting properly worded discovery requests directed at information relevant to the issues in dispute. See “Discovery Requests in Trademark Cases Under U.S. Law” in INTA’s Practitioners’ Checklists series for an outline of topics to help you create an individualized discovery checklist.

Visit www.inta.org/discoveryrequests
Katja Loeffelholz

With a Russian first name, meaning “little Katherine,” and the married name “Loeffelholz,” which is of German origin, Katja Loeffelholz feels right at home in an international association.

While in law school, and after several informational interviews covering various practice areas, the topic Katja found most interesting was IP/trademarks. She thought it was creative and innovative; and today, after some experience in this area, she can confirm that she has never regretted the decision to specialize in IP.

After she graduated from law school, Katja practiced IP law in South Carolina for about seven years. There, she passed the patent bar during her first year of practice. South Carolina was a great experience, as there are several multinational companies based there, including Michelin, BMW, Ryobi, Fiji and Hitachi, some of which were her clients. She claims that thanks to her relationship with Japanese clients, the best Japanese food she ever had outside of Japan was in South Carolina.

Today her practice at Dickenson Peatman & Fogarty, LLP, is in Napa, California, so she has exchanged Japanese food for Napa’s wine. Consequently, her practice tends to focus on trademarking wine brands, bottle design patents and enforcement issues. Napa is also known for its restaurants, hotels, spas and scenic beauty, so she still races outside in the morning to see the hot air balloons fly overhead. If she were not practicing law, she says she would want to be a professor, as she enjoys learning, reading and exploring new ideas.

The first INTA meeting Katja attended was the San Antonio Annual Meeting in 1997. She thought it was fun, very organized and she thoroughly enjoyed meeting so many professionals from around the world. She is currently serving on the Geographical Indications Subcommittee of the Related Rights Committee, which she believes is a fascinating area of the law, and she is learning Spanish in preparation for the 2015 INTA Leadership Meeting in Panama.

Katja likes to run and does “boot camp” exercises called INSANITY. She enjoys being outdoors, especially in warm weather. Her husband likes to sail, so occasionally all the family goes sailing out in the San Francisco Bay. Because her parents live in Puerto Rico, one of her preferred vacations is visiting them and then cruising around the Caribbean to Saint Thomas, Barbados, Saint Kitts and Nevis, Saint Lucia and Saint Martin. Katja also has three daughters—Gabriella, 18; Francesca, 16; and Dominique, who is in the fourth grade.
Committee Spotlight: The Harmonization of Trademark Law and Practice Committee

Adam Sears
Davies Collison Cave, Melbourne, Australia

Melanie Martin-Jones
Porter Wright Morris & Arthur, Columbus, Ohio, USA

Mr. Sears is Chair and Ms. Martin-Jones is Vice Chair of the Harmonization of Trademark Law & Practice Committee.

The Harmonization of Trademark Law and Practice Committee is composed of two subcommittees: Free Trade Agreements and Classification. Each of the subcommittees is working to make brand owners’ trademark filings and registrations more consistent in countries across the globe. The Chair of the Committee, Adam Sears, oversees progress of the subcommittees with Vice Chair, Melanie Martin-Jones. INTA Staff Liaisons Bruce MacPherson and Seth Hays help to coordinate the efforts of these two rather large subcommittees.

The Free Trade subcommittee is chaired by Andreas Ebert-Weidenfeller (Meissner Bolte & Partner, Germany). This subcommittee includes members from all over the world. These members created and continually update INTA’s Model Free Trade Agreement, which they seek to provide to countries embarking on new trade relationships. The subcommittee monitors the progress and developments regarding free trade agreements worldwide. Members are in regular communication with the Office of the U.S. Trade Representative and parallel agencies in other nations and have provided input on the negotiations of many important free trade agreements, including the Transatlantic Trade and Investment Partnership between the EU and United States and the Trans-Pacific Partnership. The subcommittee is working to create a database that maps all free trade agreements currently in place or being negotiated. The database will ultimately provide a snapshot of the terms and implications of each agreement by region for easy reference by brand owners and practitioners.

The Classification subcommittee is chaired by Clark Lackert (ReedSmith, USA). This subcommittee also includes members from all over the world. Members are grouped into task forces that examine differences in the requirements for listings of goods/services in a trademark application in a spectrum of countries and work with other INTA subcommittees covering those countries in an effort toward a harmonized system for identification of goods and services in trademark applications. The subcommittee monitors requests for changes to the International (Nice) Classification of Goods and Services listings proposed to the Committee of Experts and provides comments to INTA’s WIPO representative. The subcommittee is currently working on a major project to compile a document titled “Goods and Services Identification for an International Filing Program.” The document is proposed to be a reference illustrating issues in goods/services recitation requirements by country.

Each of the subcommittees has regular telephone conference calls to report on progress, as well as meeting at INTA’s Annual and Leadership Meetings.

TRADEMARKS IN
Japan
March 26 – March 27, 2015

Be part of INTA’s major regional conference in Japan. Network with trademark professionals and meet government officials while learning about:

• Strategies for nontraditional trademarks.
• The latest developments and trends in the ASEAN Community.
• Geographical indications.
• Online counterfeiting.
• What in-house counsel expect from outside counsel.
• Maximizing the value of your brand.

Learn more and register at www.inta.org/2015Japan
FOREIGN MARK FILED | DATE OF APPLICATION | FOREIGN LANGUAGE | MEANING | CLASS | REGISTRY’S STANCE | DATE OF ISSUE OF EXAMINATION REPORT
--- | --- | --- | --- | --- | --- | ---
PARFUM (#1033033) | July 31, 2001 | FRENCH | PERFUME | 3 | REGISTERED | February 26, 2003
WASSER (#1096245) | April 17, 2002 | GERMAN | WATER | 32 | REGISTERED | February 15, 2003
EAU (#1650609) | February 6, 2008 | FRENCH | WATER | 32 | REGISTERED | October 11, 2008
ACQUA (#1826594) | June 8, 2009 | ITALIAN | WATER | 32 | REGISTERED | July 22, 2010
SAVON (#1901529) | December 29, 2009 | FRENCH | SOAP | 3 | REGISTERED | August 26, 2010
YAKISOBA (#2449481) | December 26, 2012 | JAPANESE | DERIVATIVE OF CHINESE CHOW MEIN | 30 | OBJECTION DESCRIPTIVE | March 27, 2014
MIZU (#2476737) | February 12, 2013 | JAPANESE | WATER | 32 | OBJECTION DESCRIPTIVE | January 13, 2014
The defendant contended that “Volvo” had a descriptive meaning implying ‘re-rolling,’ ‘to roll up,’ ‘to roll together’ and ‘form by rolling’ in Latin, thus, it was not a word invented by the plaintiff. The Bombay High Court held that the Doctrine is to be applied only in those cases where there is a “likelihood that the customers may translate the word easily and get confused with the meaning of the word in English.” In this case, because the impugned foreign word (Volvo) originated from a “dead and obscure language,” Latin, the Doctrine, which is “not an absolute rule but merely a guideline,” would not be applicable.

Similarly, in the case of C Kamani Oil Industries Pvt. Ltd. vs Bhuwaneshwar Refineries Pvt. Ltd [2014(4) BomCR 487], the dispute revolved around the plaintiff’s mark RISO LITE. The defendant claimed the mark was descriptive, as “riso” in Italian means “rice,” and thus was not a word invented by the plaintiff. However, the Doctrine was not applied by the court on the ground that the majority of the Indian population would be unaware that “riso” in Italian means “rice.”

The Indian courts have also been confronted with the issue of deception or descriptiveness on account of India’s regional languages. In the case of Bhatia Plastics v. Peacock Industries Ltd. [AIR 1995 Delhi 144], the plaintiff had registered the word MAYUR for its goods. “Mayur” means “peacock” in Sanskrit. Subsequently, the defendant started using the mark PEACOCK for its goods and services, which were in the same class, 21, for various household plastic goods. The plaintiff alleged infringement and pleaded for an injunction so as to enjoin the defendant from using the mark PEACOCK. The court passed judgment in favor of the plaintiff and observed that “a person cannot use a trade mark comprising a word in a different language that nonetheless conveys the same idea as an earlier mark in another language.”

In another interesting case, M/S. Hitachi Ltd. vs Ajay Kumar Agarwal [ILR 1996 Delhi 359], the plaintiff was the registered proprietor of the mark HITACHI for class 9 goods. It applied to the court to enjoin the respondents from using and registering the trade mark HITAISHI written in Hindi script for similar goods falling in class 9. In reply to the allegations, the respondent submitted that the two words “HITACHI” and “HITAISHI” in Hindi script are different, as HITAISHI written in Hindi means “well-wisher.”

The court analyzed the case from the point of view of an average person with imperfect memory and held that “the word ‘HITACHI’ and ‘HITAISHI’ are pronounced almost the same way and an average or ordinary purchaser will not be able to know the difference between the two when he goes to the market to buy the said product. This is likely to cause deception and confusion in his mind. Even though the meaning of the two words may be different and they are written in different scripts, there is no doubt that both words have a striking phonetic similarity.”

Conclusion

More and more people are being introduced to foreign languages in India and technology has further enabled easy access to translation. Apps such as GOOGLE Translator can be easily employed to check the meaning or English equivalent of any foreign word, thereby increasing the importance of the Doctrine of Foreign Equivalent.

Moreover, it has become imperative for businesses and individuals applying to register a mark in a foreign country to translate the mark into the native language of the filing country. A preliminary search for names and trademarks with the same meaning or pronunciation, and to ascertain whether the mark has any negative connotations in India, therefore becomes essential in order to avoid any subsequent objections, oppositions or just plain and simple embarrassment in the market.

Contact Sharón R. Aguayo at saguayo@inta.org for more information.
BRAZIL  “Cutting” INPI’s Line

In a judgment published on November 12, 2014, the Second Panel of the Federal Court of Appeals of the Second Circuit (TRF2) ordered the Brazilian National Institute of Industrial Property (INPI) to issue, within 60 days, a final decision on the appeal filed by A Especialista Comércio e Design de Móveis Ltda (A Especialista). A Especialista was appealing INPI’s rejection of its trademark application. Based on Federal Law No. 9,784/99, which regulates the federal administrative proceedings, in conjunction with Federal Law No. 9,279/96, the Industrial Property Law Justice André Fontes found that INPI was taking an unreasonable amount of time to resolve the appeal (six years), and said that this would amount to an unjustifiable omission (Proceedings No. 0131120-46.2013.4.02.5101).

A Especialista sought a judgment to compel INPI to issue a decision on the appeal sooner, i.e., to have it prioritized. INPI contended that A Especialista should wait in the chronological line. This argument was rejected, and INPI has not challenged the TRF2 court’s judgment.

According to the language of Brazil’s federal laws, INPI, as a federal, self-sufficient agency, should have brought the appeal to trial within 180 days from its filing. In other words, not complying with the legal obligation to decide a case in a reasonable time amounted to an inexcusable omission. Moreover, upholding the first instance judge’s opinion, Judge Eduardo Fernandes of the TRF2 reiterated that these laws echo the constitutional principle that reasonable and sufficient damages are awarded to the legitimate IPR holders.

This judgment is seen as one solution for those who have been waiting an unreasonable amount of time to receive a decision on their trademark applications.

Contributor: Maurício Maleck Coutinho
Veirano Advogados, Rio de Janeiro

Verifier: Erica Aoki
Aoki Advogados Associados, São Paulo
INTA Bulletin Law & Practice—Latin America & the Caribbean Subcommittee

CHINA Third IP Court Established to Strengthen IPR Protection

On December 28, 2014, the Shanghai Intellectual Property Court was established. This is the third specialized IP court of its kind in China; the first two began operating in Beijing and Guangzhou on November 6 and December 16, 2014, respectively.

On December 26, 2014, the Supreme People’s Court of the People’s Republic of China announced in a report that China may consider setting up a national IP court. As the models for this potential national IP court it is important to note the highlights of the three specialized IP courts thus far and what roles they will play in promoting the judicial progress on IP laws in China.

Increasing Efficiency
The IP courts have taken several steps to increase the efficiency and quality of trials. Among other measures, they have simplified China’s complex trial procedures, significantly reduced the number of non-judicial officers and personnel, added judges’ clerks and employed high standards for selecting judges, presidents of the IP courts and the chief judges. As of December 20, 2014, the Beijing IP court had accepted 367 cases—92 percent of them cases of first instance.

Each of the IP courts has a different jurisdictional focus: the Beijing IP court handles IP-related cases within the Beijing area and administrative cases of authorization and determination of intellectual property rights (IPR); the Shanghai IP court shares its office with the newly founded Shanghai Third Intermediate People’s Court and handles local civil and administrative cases of IPR; the Guangzhou IP court has cross-regional jurisdiction for trials of first instance for some IP cases within the Guangdong Province and for trials of second instance for some appellate cases of IPR.

Strengthening Judicial Protection for IPR Owners
The IP courts will take stronger and more severe measures to punish infringers as a means of warning infringers against the risks of infringement, and the IP courts will ensure reasonable and sufficient damages are awarded to the legitimate IPR holders.

The IP courts also conduct research and studies on the issue of level and amount of damages in particular cases. Costs such as reasonable expenditures for litigation, including lawyers’ fees and disbursements for collection of evidence, should be borne by the infringers.

Civil and Administrative Trials Consolidated
Another groundbreaking feature for the IP courts is a two-in-one trial mechanism for civil and administrative cases, which helps to guarantee fairness by implementing a unified standard for trials.

As China’s economy has improved and technologies have rapidly developed in recent years, the number of and types of IP-related cases have progressively increased. There have been many problems with previous trial practices, such as different conclusions for the same type of cases and multiple judgments for one case. The two-in-one mechanism will promote fairness and increase the quality of decisions.

The establishment of these IP courts will ensure the independence of IP trials, reduce and avoid any intervention and disturbance from governmental departments and strengthen the role of IP laws.

Contributor: Guizeng (Wayne) Liu
Yuanhe United Intellectual Property Partners/Yuanhe Partners, Beijing
INTA Bulletin Law & Practice—Asia-Pacific Subcommittee

Verifier: David Zhu
Suning Commerce Group Co. Ltd., Nanjing
EUROPEAN UNION

EU General Court Reiterates Similarity of Goods and Retail Services Relating to the Goods

On November 13, 2014, the General Court issued its decision for Natura Selection v. OHIM – Afoi Anezoulaki AE and ruled that there was a likelihood of confusion between the trademarks at issue on the basis that there was similarity between retail services relating to the provision of table covers in Class 35 and table covers themselves in Class 24 (T-549/10).

Afoi Anezoulaki AE had filed a Community Trade Mark (CTM) application for the word mark “natura” on May 12, 2008, covering “Textiles and textile goods, not included in other classes; bed and table covers” in Class 24. Natura Selection SL opposed the application on the grounds that there was a likelihood of confusion between the subject mark and its three earlierfigurative CTMs, which included the word “natura,” as well as additional graphical and verbal elements:

Earlier Community Trademarks

The earlier marks were registered for goods in Class 20 as well as retail services relating to the provision of table covers in Class 35. The OHIM Opposition Division upheld the opposition in respect of “textiles and textile goods, not included in other classes; bed covers” in Class 24 but dismissed it in respect of “table covers (also in Class 24).” Natura Selection SL filed a notice of appeal. The Board of Appeal agreed with the Opposition Division that “table covers” were not similar to the goods in Class 20 or to the services in Class 35 covered by the earlier marks, and as such there was no likelihood of confusion between the marks. The appeal was dismissed and resulted in Natura Selection SL filing a subsequent appeal to the General Court.

In its judgment, the General Court stated that, according to settled case law, there is similarity between goods and retail services which relate to those goods. Furthermore, the court held that there was similarity between the Class 35 services relating to the commercial retailing of table covers and the provision of table covers “via worldwide telematic networks” (which were protected by the earlier mark) and the table covers included in Class 24 of the later application. The Court also held that “the services covered by the earlier application for the mark natura constitute one of the possible distribution channels for the goods covered by the mark applied for. That fact thus accentuates their similarity.” Consequently, the Court ruled that the Board of Appeal had been wrong in finding that there was no likelihood of confusion and held that the contested decision be annulled.

FRANCE

The Cour de Cassation Invalidates the I ♥ PARIS and J ♥ PARIS Trademarks

On January 6, 2015, the Commercial Chamber of the Cour de Cassation upheld the decision of the Cour d’Appel of Paris, declaring the I ♥ PARIS and J ♥ PARIS trademarks invalid.

The owner of the marks, Laurent Zilberberg and France Trading, filed oppositions against the registrations of the marks PARIS JE T ♥ and I ♥ LA TOUR EIFFEL filed by Paris Wear Diffusion. The latter accordingly filed suit against Mr. Zilberberg for invalidity of the I ♥ PARIS and J ♥ PARIS trademarks and for goods and services in Classes 9, 14, 16, 18, 21, 24, 25, 28 and 34.

The Cour d’Appel of Paris, in a judgment rendered on March 8, 2013, held that such trademarks were invalid and underscored the autonomous requirement that a trademark must be able to fulfill its essential function, namely, to indicate the origin of a product or service and to distinguish it from other products or services from other origins.

In analyzing the reasonably well-informed and attentive average consumer’s perception of the trademarks, the Cour d’Appel inferred that the consumer is also familiar with the slogan I ♥ NY, which indicates a person’s enthusiasm for a particular place, and is accustomed to seeing the sequence I ♥ associated with the names of well-known places. Therefore, the slogan does not fulfill an essential function of the trademark because the average consumer does not perceive it as a means of guaranteeing the commercial origin of the product.

The Cour de Cassation dismissed the appeal of the holder of I ♥ PARIS and J ♥ PARIS trademarks and underscored that the distinctiveness of a sign implies that “even if it is neither necessary, generic, common, nor descriptive, [it] must lead the relevant public to believe that the goods or services originate from a given company.”

Accordingly, the Cour de Cassation held that the Cour d’Appel rightly considered that the targeted public comprised “average tourists on a quest to buy souvenirs to remember their stay in Paris.” The concept of the average consumer was developed in the case law of the EU Court of Justice to assess likelihood of confusion (ECJ, 11 Nov 1997, Case C- 251/95 Sabel; September 29, 1998 Canon aff; June 22, 1999, Case C- 342/97 Lloyd). As pointed out by the European Court, the average consumer perceives a mark as a whole and does not scrutinize its various details, which is why this particular public will perceive the trademark as decorative rather than as one guaranteeing the origin of the product. The Cour de Cassation agreed with the Cour d’Appel’s finding that the trademark’s purpose of distinctiveness was not achieved for products using the trademarks I ♥ PARIS and J ♥ PARIS.

This judgment is useful in two aspects. Firstly, the Cour de Cassation has revisited the old concept of the essential function of the mark developed by the case law of the CJEU since the Terrapin v. Terranova case (June 22, 1976). Secondly, it confirms that the proliferation of these signs in all major cities of the world has rendered them commonplace and unlikely to be perceived as trademarks by the average consumer.

Contributor: Mary Bleahene and David Flynn
FR Kelly, Dublin, Ireland
Verifier: Tobias Dolde
Noerr Alicante IP, Alicante, Spain
Ms. Bleahene is co-chair and Mr. Dolde is a member of the INTA Bulletin Law & Practice– Europe & Central Asia Subcommittee.

Contributor: Nathalie Dreyfus
Dreyfus & associés, Paris
Verifier: Éléonore Gaspar
Duclos, Thorne, Mollet-Viéville & Associés, Paris
Both are members of the INTA Bulletin Law & Practice– Europe & Central Asia Subcommittee.
The Paris Court of Appeal recently held that the word mark “Se Loger” and the word and device mark “SeLoger” (literally meaning “find accommodation” in French) lacked distinctiveness with respect to real estate services. The court upheld the word trademark Seloger.com only because it had acquired distinctiveness through use at the time it was filed. The word and device trademark for Seloger.com was also upheld, but this is less surprising (Janny B./Pressimo On Line et Sa Se Loger.com, October 14, 2014).

The trademark owner, Pressimo On Line, runs a French website seloger.com, a leader for online real estate services enlisting offers for the rent or sale of houses. It filed action before the Paris Court of First Instance against Janny B for its registration and use of seloger-pascher.com, selogermeinscher.com and se-loger-immo.com in relation to real estate services. The action was based on the word trademark and word and device trademark Seloger.com as well as on the trademark Seloger.com. Janny B filed a counterclaim and requested cancellation of the claimant’s trademarks based on a lack of distinctiveness.

The Court of First Instance ruled in favor of the trademark owner, upheld the trademark infringement claims and dismissed the defendant’s counterclaims for cancellation. The defendant appealed against the judgment.

In its decision, the Court of Appeal first decided to cancel partially the “se loger” trademarks in relation to real estate services. The Court was severe when applying the test of distinctiveness, as the partial cancellation concerns both Se Loger word mark and Seloger word and device mark, for lack of distinctiveness. However, the Court declined to cancel partially the word trademark seloger.com based on a lack of distinctiveness, considering that it had acquired distinctiveness through use. It admitted that the generic top-level domain (gTLD) is a common and descriptive term but explained that seloger.com had been used notoriously in 2006, at the time the trademark was filed.

Secondly, surprisingly, the Court did not find that there was trademark infringement. To explain that there was no likelihood of confusion between the appellant’s domain names and the trademark seloger.com, the Court assessed the TLD differently and held that the sign [.com] “constitutes a dominant element and an essential element for the trademark’s distinctiveness, as the sole term ‘se loger’ is not distinctive.”

This matter is similar to the two “vente-privée” cases of 2013, where in one case the First Instance Court relied on the reputation of the figurative trademarks vente-privee.com (First Instance Court, December 6, 2013), while in the other matter the First Instance Court canceled the word trademark vente-privee.com (First Instance Court, November 28, 2013), holding it was generic and descriptive and had not acquired reputation through use.

Evidence that a trademark acquired distinctiveness through use appears to be essential in France. This ruling confirms the severity of French courts towards descriptive trademarks when assessing whether they are distinctive. Companies intending to create websites should be particularly creative when choosing their domain name if they want to register it in France as a trademark too. They should also be sure to collect and keep evidence as they acquire notoriety before filing their trademark.

Contributor: Nathalie Dreyfus
Dreyfus & associés, Paris

Verifier: Éléonore Gaspar
Duclos, Thome, Mollet-Viéville & associés, Paris

Both are members of the INTA Bulletin Law & Practice—Europe & Central Asia Subcommittee.
GERMANY Federal Supreme Court: Copying Paper and Print Media Not Similar

In a recently published decision, the German Federal Supreme Court made some very interesting observations regarding similarity of goods in a case of phonetically identical signs. In this case, the trademark ZOOM was filed for print media in 2009. An opposition was filed against this trademark based on the earlier trademark registration ZOOM for copying paper. While the German Patent and Trademark Office (DPMA) canceled the younger mark, the German Patent Court rejected the opposition (in Germany, oppositions are filed after registration, not before). The opponent then filed an appeal to the German Federal Supreme Court. The German Federal Supreme Court confirmed the decision of the Patent Court for the following reasons.

The Supreme Court said that the Patent Court had correctly found that similarity of goods had to be assumed where the goods concerned are in competition with each other or complementary due to an assessment of all the relevant factors relating to those goods including, in particular, their nature, their intended purpose or their method of use. Similarity of goods exists where consumers believe that the goods at issue come from the same or an economically linked undertaking.

In this case the Court said that copying paper on the one hand and print media on the other hand were not similar; consumers would not assume that a manufacturer of copying paper would also publish print media. Similarity of goods could not be assumed due to the fact that in some shops, both print media and copying paper were offered for sale. Consumers would purchase print media due to the content thereof while copying paper was supposed to be blank paper.

The Federal Supreme Court also did not accept the argument of the opponent that copying paper was an indispensable requirement for the production of print media. The opponent claimed that without copying paper there could be no print media. In the process of manufacturing print media, copying paper was more than a simple ingredient, it was a key factor for the value of print media because the quality of the product would depend on the choice of the right paper.

However, the Federal Supreme Court found that this could not constitute a functional connection between print media and copying paper. The intended use of copying paper was limited to copying. The scope of protection of the opposition trademark was limited and did not cover paper per se, but only paper for copying. However, print media was not usually printed on copying paper. Copies of print media were not made by the respective publisher but later on by the consumer. Thus, the goods in question were not similar (German Federal Supreme Court, 3 July 2014, I ZB 77/13 – ZOOM/ZOOM).

SINGAPORE Ku De Ta Club May Be Forced to Change Its Name

In Guy Neale and others v Nine Squares Pty Ltd [2014] SGCA 64, the Singapore Court of Appeal on December 22, 2014, rendered a decision that may result in the posh Ku De Ta club at Marina Bay Sands SkyPark in Singapore losing its name.

“Ku De Ta” is the name of a well-known beachfront club in Bali which started operation as a partnership (the Partnership) in 2000. It was the brainchild of one of the founding partners, Australian businessman Arthur Chondros (Chondros), who was also responsible for the daily operation of the Bali club. The name was first registered as a trademark in early 2001 in Indonesia, naming another one of the founding partners as registered proprietor.

From late 2002 onwards, Chondros began the process of registering the name overseas without the knowledge of the other partners. The overseas marks, including two Singapore trademarks registered in 2004 and 2009, which were the subject of the present dispute, named Nine Squares Pty Ltd (Nine Squares), a company set up and owned by Chondros, as the registered proprietor.

Subsequently, Nine Squares purported to license the Singapore trademarks to a Hong Kong businessman, Chris Au, who then assigned his right to Ku De Ta SG Pte Ltd (KDTSG), the operator of the Marina Bay Sands club.

The Partnership commenced separate suits in the High Court against Nine Squares and KDTSG, but twice was denied its bid to prevent the unauthorized use and license of its “Ku De Ta” name. The central issue in this appeal was whether Nine Squares, the legal owner of the Singapore trademarks, was in fact holding them in trust for the Partnership.

In a dramatic twist to the long-standing legal battle over the “Ku De Ta” name, Singapore’s highest appellate court decided, overturning the judgment in the court below, that the licensor of the Singapore trademarks did not have ownership rights but was merely holding the marks in trust for the Partnership. It ordered Nine Squares to transfer registration of the marks to the Partnership and provide an account of all profits made from use of the same, including licensing royalties.

In arriving at its conclusion, the Court of Appeal considered all the surrounding circumstances. Chondros’s lack of rebuttal response to an email memorandum issued by the Partnership asserting ownership rights over the overseas marks led to an adverse inference that he had implicitly accepted the position the Partnership took. Much weight was also given to an affidavit sworn by Chondros for an earlier related Australian proceeding, where he made an unequivocal acknowledgement of the Partnership’s beneficial ownership of the overseas marks. His contradictory testimony in the present appeal and attempts to explain away his earlier affidavit were found to lack basis.

Among the takeaways from this case are that tactical positioning may sometimes backfire and that silence is not always golden.

The Court of Appeal will proceed to hear the appeal of the other suit against KDTSG.
TAIWAN Extended Protection for Famous Marks

In a continuing effort to protect famous marks, the Intellectual Property Court (IP Court) found likelihood of confusion between “FACEBOOK” and “LOVEBOOK” (103- ShienShanSu-98, December 31, 2014).

The LOVEBOOK & DEVICE trademark was registered for services in Classes 38, 41, 45, such as communication, publication, online games, computer program designs, association of friends, etc., under Reg. No. 1535470. Facebook, Inc. (FB) opposed the trademark for likelihood of confusion with its famous FACEBOOK marks and for violation of the bad-faith clause of the Trademark Act. Under the Trademark Law in Taiwan, a trademark is registered first before it is published for opposition.) The Taiwan Intellectual Property Office (IPO) dismissed the opposition mainly on the grounds that both marks concerned are distinguishable in appearance, concept, sound or visual impression as a whole (Chung Tai Yi Chi No. G01010971, December 20, 2013). The appeal against the decision was also dismissed by the appellant authority, the Ministry of Economic Affairs (MOEA).

The CAFC focused on the first prong of this three-prong test. The USPTO and Board had concluded that Newbridge, Ireland, is a place generally known to the public because: (a) it is the second largest town in County Kildare; (b) it is listed in the geographic encyclopedia Columbia Gazetteer of the World; and (c) it appears in numerous websites that promote the town.

The CAFC focused on the first prong of this three-prong test. The USPTO and Board had concluded that Newbridge, Ireland, is a place generally known to the public because: (a) it is the second largest town in County Kildare; (b) it is listed in the geographic encyclopedia Columbia Gazetteer of the World; and (c) it appears in numerous websites that promote the town.

The CAFC concluded, however, that the USPTO and Board failed to establish that the name NEWBRIDGE is a place generally known to the purchasing public in the United States. According to the CAFC, the idea that Newbridge, Ireland, a town of fewer than 20,000 people, is a place known generally to the relevant American public was not supported by substantial evidence. The fact that Newbridge is the second largest town in County Kildare revealed nothing about the perception of the American consumer. The mere entry of the town name in a gazetteer and the fact that the town is described on the Internet do not alone evidence that the town is known generally to the consuming public in the United States. Because the CAFC found that the first prong of the test was not satisfied, it did not consider the second prong.

The CAFC reversed the Board’s refusal to register the mark and remanded the matter for further proceedings consistent with the opinion.

UNITED STATES NEWBRIDGE Not Primarily Geographically Descriptive

The U.S. Court of Appeals for the Federal Circuit (CAFC) reversed the decision of the Trademark Trial and Appeal Board (Board) which refused registration of the trademark NEWBRIDGE HOME for “silverware, jewelry and kitchen goods” on grounds that the name NEWBRIDGE was primarily geographically descriptive under Section 2(e)(2) of the Lanham Act. In re The Newbridge Cutlery Co., Appeal No. 2013-1535 (Fed. Cir. January 15, 2015).

The Newbridge Cutlery Company, an Irish company, based in Newbridge, Ireland, appealed the decision of the Board affirming the USPTO and Board conclusion that Newbridge, Ireland, is a place generally known to the public because: (a) it is the second largest town in County Kildare and the seventeenth largest town in the Republic of Ireland; (b) it is listed in the geographic encyclopedia Columbia Gazetteer of the World; and (c) it appears in numerous websites that promote the town.

The CAFC concluded, however, that the USPTO and Board failed to establish that the name NEWBRIDGE is a place generally known to the purchasing public in the United States. According to the CAFC, the idea that Newbridge, Ireland, a town of fewer than 20,000 people, is a place known generally to the relevant American public was not supported by substantial evidence. The fact that Newbridge is the second largest town in County Kildare revealed nothing about the perception of the American consumer. The mere entry of the town name in a gazetteer and the fact that the town is described on the Internet do not alone evidence that the town is known generally to the consuming public in the United States. Because the CAFC found that the first prong of the test was not satisfied, it did not consider the second prong.

The CAFC reversed the Board’s refusal to register the mark and remanded the matter for further proceedings consistent with the opinion.

Contributor: Joseph S. Yang
Lee and Li, Attorneys-at-Law, Taipei
Co-Chair, INTA Bulletin Law & Practice—Asia-Pacific Subcommittee

Verifier: Su-Mei Lee
Chief of Trademark Division, Intellectual Property Office, Taipei
UNITED STATES U.S. Supreme Court Leaves Tacking to Juries

In its first substantive trademark decision in at least a decade, a unanimous Supreme Court affirmed a Ninth Circuit decision and held that “when a jury is to be empaneled and when the facts warrant neither summary judgment nor judgment as a matter of law, tacking is a question for the jury.” *Hana Financial, Inc. v. Hana Bank*, et al., No. 13-1211 (Jan. 21, 2015). The decision was in line with the amicus brief submitted by INTA in the case.

Businesses often update their marks; tacking allows them a way to do so without losing valuable priority over third parties. Explaining that tacking, which gives a trademark owner’s newer mark the priority of its older mark, is allowed only when the two marks “are ‘legal equivalents’ in that they create the same, continuing impression,” the Court reasoned that as the test “relies upon an ordinary consumer’s understanding of the impression” of a mark, it is a fact-intensive question for the jury, and not a question of law to be reserved for the judge.

Here, Hana Financial, Inc.’s, infringement claims had failed at trial, given a jury finding that Hana Bank had priority. The Ninth Circuit had affirmed, ruling that tacking was a “‘highly fact-sensitive inquiry’” that should be “reserved for the jury.” In affirming, the Court made it clear that where the parties have opted for a bench trial, the judge can decide any tacking issues, and that even in a jury case, a judge can rule on tacking where the facts warrant entry of summary judgment or judgment as a matter of law. An open question is whether, as a practical matter, the Court’s decision will end up making it more difficult to obtain such judicial rulings on tacking issues.

The Court did not rule on the actual test for tacking or on the facts needed to prove tacking, but simply quoted the Ninth Circuit’s statement that it applies only in “exceptionally narrow circumstances.” In litigating future tacking cases, parties will be aware of the need for careful presentation of the facts underlying the alleged tacking, and may wish to consider whether to present expert testimony on the tacking issue to the jury, possibly including survey evidence. This may potentially raise the costs of such litigation.

It will be interesting to see whether the Court’s ruling on the importance of the jury on the commercial impression issues underlying tacking may, in turn, also affect the central issue of likelihood of confusion in those circuits where it is still considered at least partly a question of law for the judge to decide.

Contributor: Rose Auslander
Carter Ledyard & Milburn LLP, New York, NY, USA

Verifier: Catherine Dennis Brooks
Miller Thomson LLP, Toronto, Ontario, Canada

Both Ms. Auslander and Ms. Dennis Brooks are members of the INTA Bulletin Law & Practice, United States & Canada Subcommittee.
Register Today for
INTA’s 137th Annual Meeting
May 2–6, 2015 | San Diego, California, USA

Look forward to these highlights:

- Almost 300 customized educational offerings, including 33 general educational sessions, more than 250 table topics, users' group meetings with leaders from several national and regional trademark offices, a 2-day Course on International Trademark Law and Practice with 18 course segments, a 2-day Basic Mediation Training, Academic Day, Career Development Day, the Trademark Administrators Brunch and more.
- Special offerings for IP professionals at corporations of all sizes, including the In-House Practitioners Workshop and Luncheon, the In-House Practitioners Reception and a new series of Industry Exchanges.
- New hassle-free ways to conduct business in the San Diego Convention Center by booking one of 4 different types of meeting spaces.
- More than 30 official networking events, including the INTA Gala, the Sunday evening Opening Ceremony and Welcome Reception, a new array of smaller networking excursions and the Grand Finale to expand your client and referral network.
- Over 100 committee, project team and Global Advisory Council meetings.
- Exhibition Hall with more than 100 exhibitors and numerous sponsorship opportunities to help you spread the word about your company and make new connections.

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

www.inta.org/2015AM

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

#INTA15