I. Theme Issue 2018 TBD

II. Substantive Trademark Law Issues

   a. Anti-Counterfeiting
      i. Update on anti-counterfeiting efforts to get relief by going after banks, credit card processors, etc.
      ii. Seizure Order article (in pipeline)
   b. Certification Marks
      i. How to implement an effective certification program
   c. Co-Branding
   d. Disparaging Marks
      i. U.S.—update on the application of the U.S. Supreme Court decision in Matal v. Tam on the constitutionality of Lanham Act Section 2(a) (commentary promised)
      ii. Global—approaches to disparaging marks in other countries
   e. Dilution
      i. Current state of U.S. law
      ii. Dilution principles applied in other countries
   f. Enforcement / Unfair Competition
      ii. Enforcement in the Middle East
   g. Exhaustion/Importation issues
      i. Summary of exhaustion law in the EU
   h. Famous Marks
   i. Generic Terms
i. Appropriate time for a court to assess genericness—at the time defendant entered the market or at the time of trial, or both?

ii. Test for genericness outside of the U.S.

j. Infringement

i. U.S.—Comparison of the likelihood-of-confusion factors in the various circuits

ii. U.S.—Survey of differences in trademark law among the circuits

iii. U.S.—Litigation/ best practices articles: e.g., entitlement to jury trial; admission of evidence of actual confusion and hearsay rule; voir dire; jury instructions

iv. U.S.—State immunity: Does the federal Trademark Remedy Clarification Act (15 U.S.C. § 1122(b)), which abrogates states’ immunity from trademark infringement lawsuits, violate the Eleventh Amendment of the Constitution?

v. Europe—Analysis of CJEU decisions

vi. Defenses

1. U.S.—Discussion of the doctrines of laches and progressive encroachment in trademark infringement actions

2. Global—When/where/how laches defenses succeed

k. Non-Traditional Marks

i. The use of Community designs to protect 3D trademarks; as the ECJ is very strict on distinctive character, companies are moving toward designs; is this good, bad, or useful?

ii. Commentary re smell marks (Play-Doh recent application in the U.S.)

l. Plain Packaging

i. Review of current pending disputes / laws & of TM owners efforts to address/challenge

m. Re-Branding

i. Commentary re companies who are re-branding and the reasons for and against re-branding

n. Registration

i. U.S.—Bona fide intent to use

ii. Japan and other Asian markets—Getting trademarks registered in these markets

1. How assessments of similarities of goods/services are made in China, Japan, South Korea, and Taiwan (whether by grouping items together or
using codes, etc.), comparing and contrasting how one or more of these trademark offices handle the assessment

2. Examination of non-traditional trademarks in Japan, since 1,195 trademark applications for non-traditional trademarks other than 3D marks ("sounds, colors, position, moving and hologram marks") were filed between April 1, 2015, and January 31, 2016.

iii. China: Attacking Bad-Faith Registrations

iv. Global Filings—Update—Practical considerations of using the Madrid Protocol

v. Tips from national or regional IP offices

1. Europe—Tips from EUIPO

2. U.S.—Tips from the TTAB

3. Tips from other offices

vi. Opposition/ Cancellation Practice

1. U.S.—Change in strategy following B&B Hardware case

2. U.S.—How to assess whether B&B Hardware has had an effect on TTAB practice (commentary)

3. What is the value of oppositions to “keep the register clean”?

o. Remedies

i. Preliminary / Permanent Injunctive Relief

ii. Attorney Fees

1. Outside the U.S.—fee awards in other jurisdictions

iii. Damages and other relief, such as recalls, in the advertising context

iv. Recent developments in trademark damage theories—PODS v. U-Haul in the U.S.

p. Statutes /Laws/ Trade Agreements /TPP

i. Ecuador—New constitutional changes that are likely to impact IP rights

ii. Central American Free Trade Agreement—Discussion of CAFTA’s changes to the trademark laws of participating countries and the issues that may arise

iii. Japan -- How to incorporate the idea of punitive damages or statutory damages into the Trademark Law in Japan. Japan does not allow punitive damages under the current legal framework related to IP. Because of the TPP Agreements, it is now required to introduce the system of punitive damages or statutory damages.
iv. New opposition procedure in Italy—compare with European standards

q. Trade Dress

r. Unregistered Rights

s. Use Requirements

i. “Use” sufficient for federal registration / federal question jurisdiction

ii. U.S.—What use is required by the plaintiff to support an opposition? 4th Circuit FLANAX case / discussion of First Niagara case, in which the CAFC reversed the TTAB’s ruling on the use required to support a § 2(d) opposition. First Niagara Ins. Brokers, Inc. v. First Niagara Financial Group, Inc., 81 U.S.P.Q.2d 1375 (Fed. Cir. 2007)

iii. Europe—Genuine use requirements. Is genuine use of an EUTM in a Member State sufficient to maintain trademark rights (Benelux TM Office and Hungarian TM Office rulings versus EUIPO rulings)?

III. General Legal Issues Affecting Trademark Practice

a. Alternative Dispute Resolution

i. ADR & its role in trademark cases (any jurisdiction)

b. Appeals

i. U.S.—Analysis of possible split in the circuits regarding how much new evidence can be submitted if you elect to appeal a loss at the TTAB by pursuing a civil action (15 U.S.C. § 1071(b)). Do you get a second bite at the apple? Recent cases include University of Wisconsin (see http://thettablog.blogspot.com/2011/08/on-rehearing-7th-circuit-rules-that.html) and Nike (see http://thettablog.blogspot.com/2007/09/federal-court-reverses-ttabs-nikepal.html)

ii. U.S.—Standard of review relative to likelihood of confusion assessment by district court

c. Attorney-Client Privilege

i. Preservation and waiver of privilege in trademark cases (any jurisdiction)

d. Discovery

i. Global: How to secure evidence in cases pending in countries outside of the U.S. where discovery practices differ or are non-existent

ii. U.S.: How the federal e-discovery rules have affected U.S. trademark litigation and/or TTAB practice; will the new rules make it better/worse/different?

e. Evidence

i. U.S.—Proving actual confusion
ii. Surveys

1. Proximity of products in the marketplace and surveys: What is proximity? How should it be measured and defined, particularly for lineup studies? Is it different in a world with online shopping? Is it different for industrial goods sold through distributors than consumer goods sold at retail? What are the research alternatives when proximity is not present?

2. Controls: A good control in survey research should be similar to the test product, but not too similar. What are the guidelines for defining an appropriate control?

3. Global or multi-country review of surveys: What are the evidentiary rules that govern whether surveys can be admitted as evidence? What are the logistical requirements of executing the survey? Update of 2010 article.

f. Jurisdiction

i. Europe: The scope of jurisdiction of EU courts—e.g., if there is infringement of an EUTM in Latvia, should the injunction also cover Malta, where perhaps there is no infringement because the trademark and sign are pronounced differently? If an EUTM has a reputation in Austria, can the broader protection granted to such trademarks also be invoked in the United Kingdom, where it has no reputation?

g. Mergers/Acquisitions

i. Evaluation of brands in mergers: international or comparative perspective

ii. Integration of acquired brands from a marketing perspective

IV. New Media / Internet Issues

a. Keyword Advertising update

b. Internet—Analysis of how we should assess the commercial marketplace in the context of infringements involving use on the Internet

c. Monetization on the Internet—how it works, when it works, and pitfalls for brand owners

d. Social Media

i. Analysis of actions that can be taken against social media user names that include trademarks

ii. Trademarking hashtags (commentary promised)

e. Fads—the role of trademarks in exploiting fads

f. Fans—how to handle fan sites; cases involving fans

i. Commentary regarding &/or comparing/contrasting cease and desist letters to fans that are creative/nice & work vs. those that are overly aggressive & don’t work
g. New gTLDs/UDRP/URS

V. Issues for Specific Industries
   a. Pharmaceutical Industry
      i. Best practices for trademark searches for pharmaceutical marks: regulations in other countries equivalent to the FDA regulations
   b. Entertainment Industry
      i. Trademarking History—Who owns historical events and facts?
   c. Politicians
      i. Trademarks and Political Campaigns
   d. Others?

VI. Areas of Law Related to Trademark Law
   a. False Advertising
      i. Interaction between labeling law requirements and false advertising claims on a global basis; U.S. Pom Wonderful case
   b. Designs/ Design Patents
      i. Industrial Model Laws: What are they? Are they applicable as adjuncts to TMs? Can they be used to protect the trade dress of restaurants?
      ii. U.S.—Should a design patent owner be restricted in claiming trade dress rights in the design?
      iii. The reason for the increase in registered designs in the EU
      iv. A comparison of likelihood of confusion of trade dress vs. infringement of a design patent
   c. Right of Publicity
      i. What does it take to win a case? Is the right of publicity assignable/transferable? (e.g., Naomi Campbell v. MGN Ltd.)
   d. Sports Sponsorships
      i. Analysis of the current state of the law on what can and cannot be done to stop ambush marketing in the context of sports sponsorships
      ii. Update on case pending against the NCAA by former college players who assert that the use of their likeness (school, height, weight, uniform number, but not name) in NCAA-licensed video games violates their right of publicity
   e. Patent Law
i. Inequitable Conduct—compare and contrast patent vs. trademark applications processes—should they have the same standard for disclosure and why?

f. Copyright Law

i. Should rules be different for online enforcement of trademarks and copyrights?

ii. Copyright vs. trademark takedown notices outside of the U.S.