INTRODUCTION

By Gerhard R. Bauer

President, International Trademark Association

Dear Friends and Readers,

In 2003 we were able to read a special issue of The Trademark Reporter (TMR) on the occasion of the 125th Anniversary of the International Trademark Association (INTA). In her introduction, one of my predecessors, the then President Kathryn Barrett Park, already foresaw that the work done for that issue would contribute to the next history. She was definitively right, with one exception: the work would contribute not to the 150th Anniversary of the Association, as she expected, but to the 100th Anniversary of the TMR itself.

Eight years have passed since then; the world has changed and with it the trademark world as well as the Association itself. In the year 2003, the first Annual Meeting outside North America took place in Amsterdam. Since then, it took just 5 more years to see another Annual Meeting outside North America—Berlin, in 2008. We are looking forward to the next two meetings outside North America, namely, Hong Kong in 2014 and Vienna in 2018.

In these eight years we have experienced two more non-U.S. INTA Presidents, and in 2011 INTA has chosen to have its first non-native-English-speaking President.

Although having been visible by its work and by the distribution of its members all over the world in more than 190 countries, INTA is not only present at its headquarters in New York but also has offices in Shanghai and Brussels and representatives in Geneva, Mumbai, and Washington, DC—great progress within just eight years. As INTA’s President for 2011, I am especially proud to have been actively involved in the planning and setting up of the European Representative Office in Brussels.

INTA has not only changed and evolved into a truly international Association that is respected by the trademark
community (by trademark owners, representatives, and institutional authorities alike), but has also followed the changing trademark world, sometimes even foreseeing where the new developments will lead.

Long before the coming of the Web 2.0, INTA tackled Internet issues, including the problems of online counterfeit sales, the rise of new gTLDs, and the introduction of social media in our daily life. I am happy to state that INTA itself has adapted to these changes and that all of you can see proof of this by looking at the new INTA website, which was launched in January.

INTA is actively participating in the evolution of trademark law; this participation can be seen, for example, in its contribution to the Anti-Counterfeiting Trademark Agreement, the final text of which was published in December of last year, as well in its involvement with the ongoing Study of the European Commission with respect to the trademark systems in Europe.

INTA has been invited as one of just five observers to participate in the Administrative Board and Budget Committee meetings of the Office for Harmonization in the Internal Market (OHIM), the European Community trademark office, and was re-appointed for another term of four years—proof of the high regard in which INTA is held by government authorities. In 2010, for the first time, observers were admitted to participate in a regular trilateral meeting of the Japanese Patent Office (JPO), OHIM, and the United States Patent and Trademark Office (USPTO). Again INTA was chosen as one of only a few observers.

With all these changes and evolutions (sometimes also revolutions) in the trademark field, we have to realize that there is also a need for continuity in our work; when I was considering our work’s most stable factors, I realized that they have been the never-ending dedication and contributions of INTA’s volunteers and staff and—last but not least—the 100-year history of The Trademark Reporter. In the current issue you will find many of these developments and contributions described.

I feel honored to be INTA’s President and to dedicate myself to the work and to share with all of you my passion for trademarks during my presidency in 2011. I wish to congratulate The Trademark Reporter on its 100th Anniversary and I am confident that we will see many more anniversaries to come, with TMR continuing to deliver scholarly articles of the highest quality, an achievement that is guaranteed by INTA’s engaged and committed membership.
INTRODUCTION

By Alan C. Drewsen

Executive Director, International Trademark Association

It is a signal honor for me to congratulate The Trademark Reporter (TMR) on its 100th Anniversary. One hundred years ago, 1911, William Howard Taft was President of the United States. The readers of that first issue of the TMR were closer in time to the Napoleonic Wars than to the events of today. The USTA (predecessor to INTA) was still a small group of New York–based trademark owners, and TMR stood for “The Trade-Mark Reporter.”

Volume 1, Number 1 of the TMR, which is before me as I type, was 54 pages and reported on, among other matters, a decision by the most wondrously named American jurist, Learned Hand, who decided a case brought by R. Guastavino Co. The plaintiff objected to the use of the terms “Spanish tile” and “cohesive tile” by the defendant. Those phrases indicated the workmanship of the plaintiff and were, though Judge Hand does not use the term, indications of source. As a result, Judge Hand required either a disclaimer so that consumers would not be confused or the abandonment of the phrases.

Also before me is the most recent issue of the TMR, November–December 2010. There is an article about the registration of scents as community trade marks; another on trademark registration in Canada; and yet another on nominative fair use online. We have come a long way in the breadth of coverage and the complexity of the issues in one hundred years.

And yet in dicta, Judge Hand noted that “[t]he calm of a temporary stay stimulates the inventive faculties, which congenital imitativeness seems so often to palsy. The defendant may from the resources of the language find an adequate description, without using the precise phrases which have been associated with Guastavino.” I will wager that in a corner of the convention center at INTA’s 2011 Annual Meeting in San Francisco, two warring parties will settle a dispute not very different from the one that brought the artisan Guastavino into court.

For the one hundred years 1911-2011, the authors writing in the TMR, and the editors supporting them, have been the primary contributors to the doctrinal development of trademark law and to the growth in sophistication of trademark practice. I have worked with three staff editors—the legendary Charlotte Jones and her two someday-legendary successors Randi Mustello and Lisa Butkiewicz.
They and the long list of distinguished practitioners who have been Editors-in-Chief and Editors and who have performed other important services for the TMR deserve immense credit for the scholarly rigor and creativity that have made the TMR the foremost publication in its field. The Association is deeply in their debt, and I am pleased to be able to acknowledge that debt on the occasion of the 100th Anniversary of the TMR.
INTRODUCTION

By Lanning G. Bryer

Editor-in-Chief, The Trademark Reporter

It is my great honor and privilege to be serving as Editor-in-Chief during the 100th Anniversary of The Trademark Reporter (TMR), The Law Journal of the International Trademark Association and the world’s leading scholarly journal dedicated exclusively to trademark law, practice, and analysis. For several decades, each year the TMR has published six volumes of articles and commentary of the highest quality legal scholarship by distinguished trademark practitioners, academics, and law students. Throughout its tenure and illustrated in the hundreds of its published volumes, the TMR has been at the leading edge of educating those who are interested in the research and understanding of trademark law throughout the world.

The Editorial Board of the TMR, which has included the most experienced and respected minds involved in the global trademark community throughout its 100-year history, provides a peer review editorial process that, frankly, sets it apart from student-edited law journals or reviews. The editorial process has remained rigorous to assure the continued publication of the high caliber of scholarly articles that readers of the TMR have come to expect. I believe I speak for all past and current members of the Editorial Board in expressing our pride in the continuous level of excellence that is embodied in The Trademark Reporter.

This Anniversary Issue of the TMR commemorates the distinguished role that the TMR has played over the last century in the evolution and chronicling of trademark law. This issue surveys many of the most significant trademark cases in the United States and in the European Community over the last century, and also covers insights on the latest issues confronting the trademark community, including the registration and enforcement of nontraditional marks, the growth of both counterfeiting and the anti-counterfeiting industry, the need for a global body of rules that will efficiently combat trademark fraud on the Internet, and how U.S. intellectual property laws apply to the issues raised by trademarks in virtual reality. In addition, this
special issue contains: comments on the foresight of a revered member of INTA regarding his predictions about the future of trademark law in his 1978 TMR article; a republished TMR article and its update on the journal’s history; and reminiscences from the TMR’s former Editors-in-Chief of their respective tenures.

To further celebrate this important milestone, the TMR is also sponsoring an expanded-length session scheduled for INTA’s May 2011 Annual Meeting in San Francisco. The session, “A Century of Trademark Law: Looking Back and Looking Forward,” will bring together some of the leading thinkers in trademark law in the United States and Europe, who will consider how trademark law might develop in the future, based on how the law has evolved over the last 100 years. J. Thomas McCarthy will serve as moderator for session panelists Lord Justice Jacob, Miles Alexander, and Professor Eric Goldman. That session is currently slated for Tuesday, May 17, at 11:45 a.m.–1:00 p.m. We hope you will join us.

In closing, I would be remiss if I did not thank those people whose hard work will make this anniversary celebration a truly remarkable one. For their extensive written contributions to this commemorative issue, I gratefully acknowledge its authors and former TMR Editors-in-Chief. I would also like to express my gratitude to the Anniversary Issue Task Force\(^1\) as well as the TMR’s Managing Editor, Editor, and Senior Periodicals Editor,\(^2\) who were the behind-the-scenes thinkers, planners, and editors whose efforts have brought us to publication. Finally, I am thankful to the TMR Commemorative Session Task Force,\(^3\) who took part in the creation of the upcoming session to be held at the 2011 INTA Annual Meeting in San Francisco.

\[^{1}\text{Miles Alexander, Sherri Dratfield, Sandra Edelman, Samuel Fifer, Maria Nelson, Pier Luigi Ronca glia, and Jerre Swann.}\]
\[^{2}\text{INTA staff Lisa Butkiewicz, Beverly Harris, and Joel Bromberg, respectively.}\]
\[^{3}\text{Dan Bereskin, Sheldon Burshtein, Daniel Glazer, and J. Thomas McCarthy.}\]