

The Bubbles Business

Charles Goemaere on protecting Champagne



Enhancing IP in Africa

Tat-Tienne Louembe on INTA's approach



Changing Times

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140th Annual Meeting, Seattle

daily news

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A New Day for Designs

As brands increasingly turn to designs to protect their IP, a panel yesterday provided some tips for how to manage risk in this crucial area. Sarah Morgan reports.



(L. to R.) Thomas Adams, Anne Gundelfinger, Emily Weal, and John Froemming

The EU registered community design, which is less than 20 years old, has brought design rights to the fore," said Anne Gundelfinger, Vice President, Global IP, Swarovski AG (Liechtenstein), in yesterday's Session **CSA52 Design Clearance in 2018**. The session looked at the ins and outs of design clearance, an option that innovative brands are beginning to take advantage of.

"We've even seen online platforms starting to take down infringing content based on design registrations," exclaimed Ms. Gundelfinger.

Over the course of a year, Swarovski receives up to eight demand letters on designs and, according to Ms. Gundelfinger, these come in three distinct types:

First, they come from small designers who don't even have design registrations but are "morally outraged" that the company's design may resemble theirs.

Second, they come from big luxury brands that own well-known designs.

Third, and increasingly, they come from "trolls" who "just want to use

their registrations to milk you for royalties," she said.

The picture in Europe is slightly more complex than in the United States because, in addition to EU rights, there will be national rights which may affect the scope of protection.

Additionally, while the scope of protection will be generally similar for U.S. design patents and EU registered designs, there may be a slightly broader scope of protection in the European Union because the test is one of different overall impression.

"Even the courts are [still] sorting out exactly what they think about infringement and the overall impression test," said Emily Weal, Director at Keltie (United Kingdom).

John Froemming, Partner at Jones Day (USA) and moderator of the panel, explained that, historically, design rights tended not to get as much attention as utility patents, trademarks, and copyrights, but that this is changing.

He added that, in the United States, designs have



ANNUAL MEETING REGISTRANT FIRST-TIME RECEPTION



2,674 first-time registrants at this year's Annual Meeting

Closing the IP Knowledge Gap

Tish Berard, INTA's 2018 President, is eager to raise awareness among small to medium-sized enterprises and non-IP professionals about the importance of IP, as she tells Ed Conlon.

Tish Berard (Hearts On Fire Company, LLC, USA), INTA's 2018 President, says there will be a few surprises when she speaks at the **Opening Ceremonies** later today.

Ms. Berard began her INTA presidency in January this year. She

previously was the Vice President and General Counsel for Hearts On Fire Company, a privately-held diamond jewelry design and manufacturing business based in Boston, Massachusetts, and is currently serving as Hearts On Fire's INTA designee.

Ms. Berard's background at a small to medium-sized enterprise (SME), where she was the only legal counsel, is somewhat unusual for an INTA President. She follows a long list of INTA Presidents who have come from major



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The Bubbles Business

The battle to protect Champagne as an IP right spans much farther than the sparkling wine's native France, as Charles Goemaere, Director of Economic and Legal Affairs at the Comité Champagne, tells Ed Conlon.

If the average person were asked to identify a product associated with a particular region, Champagne would probably be one of the first names to come to mind. For centuries, the sparkling wine that comes from the Champagne region of France, 100 miles east of Paris, has been widely associated with quality, luxury, and celebration.

But protecting that reputation has been a long struggle, and one that continues to this day. Tomorrow, May 21, Charles Goemaere, Director of Economic and Legal Affairs at the Comité Champagne (Comité interprofessionnel du vin de Champagne) (France), will be speaking in **Session CM50 Geographical Indications in the Domain Name Space (3:30 pm to 4:45 pm)**, focusing on the inadequacy of existing tools for protecting geographical indications (GIs) on the Internet.

"The existing legal tools we can use in the real world are partly inefficient on the Internet, considering the speed and low cost of trading with websites and registering domains, so we need cheaper and faster legal tools to protect our GI," Mr. Goemaere explains.

For example, he says, the Uniform Domain-Name Dispute-Resolution Policy is not available for GIs, only for trademarks.

The regulation of the term Champagne dates back to 1845, when France's highest court ruled against the use of the word for other sparkling wines. The zone of Champagne production was defined legally in 1927; Champagne was first protected as an *appellation d'origine contrôlée* (AOC, meaning protected designation of origin) under French law in 1936; and the Comité Champagne (a joint trade association) was established in 1941. Today, the Comité Champagne has 20,000 members representing 16,000 winegrowers and 320 Champagne houses.



istockphoto / Poike

Mr. Goemaere says that producers must meet two requirements: the grapes must be produced in the Champagne region, and there must be respect for the production process of the Champagne wines, which have been created slowly for 100 years.

The Champagne AOC governs aspects of production, including approved grape varieties, method of pruning, maximum permitted yields, and secondary fermentation inside the bottle.

The protected designation of origin (PDO) for Champagne has been recognized throughout the European Union since 1973. Due partly to bilateral agreements between the European Union and other countries, and thanks to the efforts of the Comité Champagne, the name is also protected as far away as Canada, Australia, and China. In 2013, Champagne became the first GI to be recorded in Myanmar.

The Comité Champagne has 16 bureaus in its biggest export markets, including in China and Japan, which are responsible for protecting the image and reporting misuse. Its policy is "to prosecute anyone who misappropriates the reputation or identity of the Champagne appellation."

are not yet granted exclusive rights for the name, although this number has dramatically reduced since 1980," he says.

"The United States, Russia, and Argentina are the last countries where the name is not yet fully protected. In those countries, some sparkling wines which do not originate from Champagne, France are still being labeled as 'champagne.'"

In these countries, the Comité Champagne undertakes lobbying and awareness-raising campaigns. It also seeks to work with local producers, to encourage them to emphasize the local origins of their sparkling wine, rather than using the term "champagne."

Elsewhere, the Comité Champagne has had success among winegrowers in the Vale dos Vinhedos in Brazil, who have now dropped the use of the name Champagne.

When it comes to enforcing the Champagne IP rights, Mr. Goemaere says the Comité Champagne works with police, customs, and other authorities to take action against counterfeiters. It also seeks to protect the reputation of the Champagne brand.

"We try to identify mis-use of the name—and we are suing the mis-users," he says.

The Comité Champagne has about 1,000 active cases in 80 countries, and about 95 percent of those are not related to counterfeiting. "Champagne" has been used without authorization on goods such as perfumes, e-cigarettes, and biscuits. "We had a recent case in Thailand on so-called 'champagne' escort-girl services—unfortunately, we get everything," Mr. Goemaere notes.

One pending lawsuit in Europe concerns the sale of a sorbet called "Champagner sorbet" which contains 12 percent Champagne. In its judgment in December 2017, the Court of Justice of the European Union "confirmed strict conditions need to be fulfilled in order for a retailer to legitimately use the name of the PDO in the name of a product," says Mr. Goemaere.

The court said "Champagner sorbet" can be sold as such only if the Champagne ingredient in that product confers an essential characteristic, such as taste or aroma, on the product. The case is now back before the German courts, which will have to decide the outcome, taking into account all the evidence presented by the parties.

The Champagne region has been producing sparkling wine since the 17th century. While the Champagne appellation is now recognized around the world, and sales are at record levels, the challenges of protecting it in the age of globalization and the Internet remain profound. ●



Charles Goemaere

“The United States, Russia, and Argentina are the last countries where the name is not yet fully protected.”

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Work of the Comité

In 2005, the Comité Champagne joined the Declaration to Protect Wine Place and Origin, whose members seek to uphold the unique connection between a wine and its location. The Declaration now has 23 signatories representing major wine-producing regions in Australia, Canada, France, Hungary, Italy, Portugal, Spain, and the United States.

But, Mr. Goemaere says, some challenges remain. "There are countries in which the name Champagne is not recognized as an IP right and producers

A New Day for Designs (continued)

← 1 to be “virtually identical” in order for infringement to be proved and that the defendant only has to convince the judge that there is a “plain dissimilarity.”

Managing Risk

For Swavorski, the most important part of managing risk is having well-trained designers.



Anne Gundelfinger

“In the trademark arena, most methods for managing infringement risk rely on conducting searches, but the design world is different.”

“A lot of people use inspiration as a euphemism for copying. That’s not the case at all,” explained Ms. Gundelfinger. “In design-intensive fields, inspiration is part of the process; it’s expected.”

Fashion houses are constantly looking at the market, asking “What’s on trend? What’s cool?” she added.

Another way to manage risk is to create a record of independent creation—“a far more important element of responding to a demand letter than having done a search,” said Ms. Gundelfinger.

She added: “If I can convince the company that we have independently created a product, more often [than not], a lot of the moral outrage that tends to drive the case goes away.”

It’s also incredibly important to “understand your competition and what they do own or what they think they own,” said Thomas Adams, Associate General Counsel of The Procter & Gamble Company (USA).

Searching Suggestions

While in the trademark arena, most methods for managing infringement risk rely on conducting searches, the design world is different, according to Ms. Gundelfinger. But that doesn’t mean searching is unimportant.

“In an ideal world, if you had

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infinite time and money, you’d search every nook and cranny. But this is not a practical reality—you must be time- and cost-effective, making some compromises,” explained Ms. Weal.

The primary purpose of a design search is to assess the legal risk; in order to determine whether there is a potential risk of infringement, you need to know about the context of the design.

“The searches you’re doing can never be completely rigorous, but you hope to establish a good context,” Ms. Weal added.

Searches can also help after a demand letter has been received to help convince the other party that there hasn’t been infringement.

“In a troll situation, they have a particular modus operandi and searches can be helpful in framing your strategy and response,” stated Mr. Froemming.

It’s also important to bear in mind that the evolution of the design throughout the process may or may not be reported back to the legal department, added Ms. Weil.

Timing is crucial. At Swavorski, searches have to fit into the product

development process, creating a “fairly short window” to do clearance for final designs, noted Ms. Gundelfinger.

“We’re all hoping there’s a silver bullet of image matching, but I’m very skeptical,” said Ms. Weal. “There’s so much you can’t account for in image matching.”

Ms. Gundelfinger added that technology is currently not developed enough to conduct a global image search, and that it may never develop to the level it would need to be.

In practice, after choosing the relevant Locarno class (an international classification for registering industrial designs), brands may choose to further limit what is being searched for.

While Ms. Weal noted that this increases the risk of missing something, Mr. Adams pointed out that “if you’re looking at the whole class, there’s a human fatigue element.”

He added: “If you’re just doing key word searching on registers, you really have to wrack your brain.”

Finally, it’s important to know “when to stop and not go too far down the rabbit hole,” concluded Ms. Weal. ●

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Still Flying High

After taking off in Seattle, The Boeing Company rose to number one in the aerospace industry, facing many IP challenges along the way, says Senior Counsel David Shenk in an interview with Aislinn Burton.

The Boeing Company's story dates back to 1916, when Bill Boeing started the company in Seattle, Washington. Now, having expanded across the United States and around the globe, The Boeing Company (USA) is the largest aerospace company in the world.

"The Boeing Company conducts business in every part of the world so, naturally, we have worldwide watches in place for our trademarks," says David Shenk, Senior Trademark Counsel at The Boeing Company.

He says The Boeing Company's approach to protecting its marks, brand, and reputation "is to be very vigilant and very proactive, both in terms of filings and enforcement," and the aerospace manufacturer will take "appropriate action" in response to any threats in this area.

In recent years, Mr. Shenk explains, a major challenge for the legal team at The Boeing Company has been the infringement of its well-known corporate symbol.

Noting that the company is "one of the most admired brands in the world," he says it is a prime target for copycats looking to free ride on the goodwill and reputation affiliated with The Boeing Company.

Mr. Shenk's team has found that "in some jurisdictions, copyright in conjunction with trademark rights has enabled us to prevail against infringers," proving that a company should be armed with an arsenal of IP rights in order to best protect itself. "This has particularly been the case in China," he adds.

Accordingly, the strength of The Boeing Company's name is a core focus of the organization when innovating

around the brand, and is "leveraged" by the company when selecting names and marks for new products or services.

Branding is therefore a collaborative process at The Boeing Company, Mr. Shenk explains. "My team and I work with our communications colleagues during the naming process for each new product and service," he says, to make sure that proposed new marks are available for use and capable of protection.

Equally, when it comes to collaborating with other businesses and countries, Mr. Shenk says "it is in everyone's interest to find ways to engage in fair and responsible trade practices."



David Shenk

“

The Boeing Company remains the single largest private employer in the Seattle area.

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istockphoto / O. Wolter

Looking East

The Boeing Company's aircrafts and other products and services connect people from countries all over the world.

Mr. Shenk notes that one of the biggest markets for Boeing Commercial Airplanes' products and Boeing Global Services' support services is China.

Following President Trump's proposal to impose U.S. tariffs of up to US \$150 billion of Chinese goods in response to alleged IP theft by Chinese companies, trade relations have been somewhat strained between the two countries.

China initially responded to the proposed tariffs by providing a list of its own tariffs that could affect US \$50 billion worth of U.S. imports, which may include some of The Boeing Company's 737 airplanes.

As The Boeing Company has a firm base in the United States and a solid trade relationship with China, Mr. Shenk says it has been "proactively" engaging with the U.S. and Chinese governments in efforts to resolve the dispute.

According to Mr. Shenk, the Chinese market "will only grow in years to come," and The Boeing Company is advocating that the two governments should "build on the recent assurances by U.S. and Chinese leaders that productive talks are ongoing."

Although The Boeing Company has grown into a multinational corporation with interests across the world, it has kept its roots in Seattle.

Mr. Shenk explains that Boeing Commercial Airlines, the division responsible for making the 787 Dreamliner airplane, 747 Jumbo Jet, and all the other 7-series aircrafts, is

still based in the Puget Sound region of Washington State, including in Seattle.

"The Boeing Company remains the single largest private employer in the Seattle area, with over 60,000 employees located here," Mr. Shenk says.

As a company with a social conscience, The Boeing Company seeks to operate profitably but with integrity, ensuring that it is a "responsible partner, neighbor, and citizen to the diverse communities and customers" it serves, Mr. Shenk says.

In 1970 a donation from the Boeing Employee's Good Neighbor Fund helped to start Seattle's Medic One, the first paramedic service in the country.

The Boeing Company also invests in the local environment; it helped to remove contamination from the Lower Duwamish Waterway in Seattle by cleaning up a one-mile stretch of the waterway next to one of the company's former plants and building a wildlife habitat.

In July 2017 the aircraft manufacturer implemented a renewed strategy to refresh The Boeing Company's philanthropic organization, now called Boeing Global Engagement.

The new organization seeks to provide assistance to develop "tomorrow's innovators" through investments in education and skills of the future; to lend assistance to military veterans; and to support the communities where its employees live and work. Mr. Shenk explains that the company's overarching aim is to "connect, protect, explore, and inspire," in relation to the employees, customers, and the communities The Boeing Company works with. ●



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Enhancing IP in Africa

INTA's External Relations Department plays a vital role in representing the interests of the Association and its members before IP offices and governments worldwide, as Tat-Tienne Louembe, INTA's Representative, Africa and the Middle East, explains to Aislinn Burton.



IP rights can boost trade growth in Africa

The creation and protection of IP rights has the potential to significantly contribute to economic diversification across Africa, and INTA has been increasing activities such as advocacy and education in efforts to explain this economic and social value across the continent.

"An IP-friendly environment is an important factor for attracting foreign investment, boosting innovation, enhancing competition, and fostering a business environment that is conducive to trade growth," says Tat-Tienne Louembe, INTA's Representative, Africa and the Middle East.

Mr. Louembe explains that economic diversification can—and does—happen through the protection and promotion of goods that are locally-produced and manufactured.

He believes the Association's

members are central to engagement activities across Africa. "Members are the lifeblood of INTA since, as practitioners, they are the ones dealing with IP offices, government officials, and other key actors on the ground," he says.

At an organizational level, INTA works with other bodies, including the World Intellectual Property Organization (WIPO), the African Regional Intellectual Property Office, and the Organisation Africaine de la Propriété Intellectuelle, to create an IP-friendly environment.

These activities vary by jurisdiction. In Ethiopia, INTA is presently collaborating with the Ethiopian Intellectual Property Office to recommend changes to the country's IP infrastructure, which will contribute to accelerated economic transformation. In Kenya, Mr. Louembe says there has been an increasing strategic collaboration with key authorities, and the Association hopes it will facilitate local development and economic growth. The Association is also working with the Rwanda Intellectual Property Office to explore how INTA can support the country's efforts to enhance IP protection.

Through his work at INTA, Mr. Louembe also conducts policy dialogues with key institutions, such as

the African Union (AU), the European Union, and the United Nations (UN) Economic Commission for Africa. In March, INTA attended the official signing ceremony of the historic treaty of the Continental Free Trade Area (CFTA), which allows signatories to benefit from free trade across Africa.

The UN Economic Commission for Africa estimates that the CFTA will increase intra-African trade by 52 percent by 2022, boosting economic

growth and lifting millions of Africans out of poverty. The AU's Department of Trade and Industry is now addressing the IP aspect of CFTA, since sufficient IP protection is vital to the agreement's aim to increase manufacturing output and boost innovation.

Mr. Louembe says INTA is working to provide input during this implementation phase, "to ensure that the voice of brand owners is heard and that the benefit of strong protection for trademarks and related rights is kept as a top priority."

In the future, Mr. Louembe says, INTA hopes to further collaborate with WIPO to host workshops in Sub-Saharan and North Africa and enhance the work of INTA's Indigenous Rights Committee. He adds that he is currently engaging in "forward-looking" discussions with WIPO's Traditional Knowledge Division to explore the potential for indigenous communities to be involved in a product's value chain, particularly in the context of small and medium-sized enterprises in the handicraft trade.

"This approach will contribute to a better understanding of their IP rights and will empower indigenous communities to play an active role in protection," Mr. Louembe explains. ●



Tat-Tienne Louembe

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Closing the IP Knowledge Gap (continued)

← 1 corporations, including Immediate Past President Joe Ferretti (PepsiCo, Inc., USA), 2016 President Ronald van Tuijl (JT International S.A., Switzerland), and 2015 President J. Scott Evans (Adobe Systems, USA).

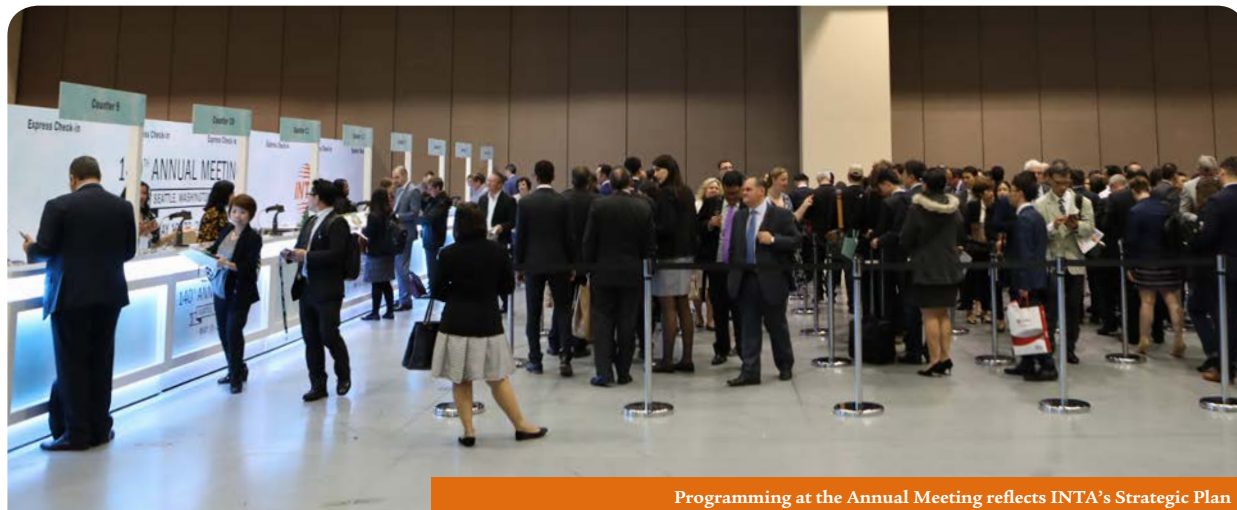
Being the sole person in charge of legal affairs at Hearts On Fire often required dealing with non-legal specialists, in addition to lawyers, says Ms. Berard. This experience has allowed her, when warranted, to speak in “non-legalese” and focus on what’s important for whichever audience she is working with.

“When speaking with consumers and businesses, there often is a disconnect between what IP is, as explained by us, and what they understand it to be,” says Ms. Berard. That highlights the need for legal professionals to communicate better with those outside the field, she adds.

Asked about INTA’s 2018–2021 Strategic Plan, Ms. Berard says she is focused on all three of its major tenets: promoting the value of trademarks and brands, reinforcing consumer trust, and embracing innovation and change. She adds that all three areas are covered by a 2018 Presidential Task Force—Small-to-Medium Enterprises and Entrepreneurs—she is spearheading.

In the area of SMEs, INTA can become “a major player,” says Ms. Berard. She says INTA needs to educate SMEs and entrepreneurs about IP, especially in an era when new companies can be created much more easily via the Internet. There is a gap between knowing about IP and understanding its importance, particularly in the early stages of a business.

“Often SMEs are focused on raising capital, which is important, but when



Programming at the Annual Meeting reflects INTA’s Strategic Plan

the brand is left to the end of the process, by then it might be too late—bad-faith actors can prey on or trade off goodwill,” she explains.

“The Presidential Task Force will take a look at the issue, to see what opportunities exist for SMEs, the challenges they face, and what gaps need to be filled, as well as the opportunities to partner with either IP or non-IP organizations,” she adds.

The Task Force, composed of experts from around the world, will give periodic updates to the INTA Board, and its goal is to produce a final report and present recommendations in November.

During her tenure as INTA President, Ms. Berard has already spent time with SMEs, including in Singapore and India, and discussed with them some of the challenges around simply getting business people to understand the importance of IP.

“While some lawyers at SMEs understand brands and IP, others might not be as familiar,” she says. She suggests that one solution might be to “train the trainer,” where one person is educated on IP and teaches the rest of the company about it.

Being President

Ms. Berard’s role requires that, along with INTA CEO Etienne Sanz de Acedo, she is the face of INTA. Her responsibilities are wide-ranging, including taking part in meetings with government officials, meeting INTA members, and speaking at Association events. She has particularly enjoyed seeing the inner workings of the organization and adds that the Annual Meeting has kept her “extremely busy.”

As INTA’s President, Ms. Berard says, “you always want to keep the momentum going” from the predecessor, in this case, Mr. Ferretti.

Among INTA’s policy priorities specified in the 2018–2021 Strategic Plan are (1) global harmonization; (2) counterfeiting; (3) the Internet; (4) brand restrictions; and (5) better understanding about the value of IP.

“Many of our efforts begin with awareness-raising,” she says, “and we collaborate with key stakeholders, including government officials, to address these issues.”

At the moment, she says, brand owners should be cognizant of the potential impact of brand restrictions, the Internet Corporation for Assigned Names and Numbers (ICANN), and Brexit.

On the first issue, Ms. Berard notes that while brand restrictions—legislative restraints on the ability to display trademarks, also known as plain packaging—started in the tobacco industry, they are spreading elsewhere, including to baby formula products (in South Africa) and sugary snacks (in numerous countries). There are even concerns about toys being affected, she adds.

“We want regulators to take an informed approach. Right now regulators are thinking about a perceived benefit—potentially decreasing certain behavior—but they are doing so without taking into account the impact on IP rights, gross domestic product, the workforce, and consumer protection,” she says.

Regarding ICANN, INTA is concerned about trademark owners’ access to the WHOIS database of domain name registrant information after May 25 when the EU’s General Data Protection Regulation (GDPR) takes effect. According to INTA, ICANN’s recently approved interim plan for ensuring that the WHOIS registration directory system complies with the regulation does not contain

sufficient open access to information. Most data that is relevant to brand owners for enforcement purposes will be hidden without any clear system in place to provide access for legitimate purposes. This will make it much more difficult to track down counterfeiters. INTA believes that ICANN’s approach over-interprets the GDPR to the detriment of consumers.

Brexit requires more of a “wait and see” approach, Ms. Berard says, as the major details concerning IP still need to be fleshed out. INTA is advocating that the European Union and the United Kingdom both support, promote, and safeguard the following core principles for brand owners and right holders during the negotiations, as well as when Brexit becomes effective: minimal disruption of trade, minimum costs, maximum retention of rights, and maximum transparency and legal clarity.

Growing with INTA

INTA has grown “quite a bit” since Ms. Berard became a member in 1999.

“When I started it was much smaller,” she says. Since, “INTA’s thinking has expanded, trying to look at things from a different perspective and how things are changing for our members.

“There are more issues for members to focus on now and there is more work than ever to be done. We’re taking a forward-thinking approach.”

Ms. Berard says INTA’s Brands and Innovation conference in New York, New York, which took place in March, was a “great example” of this approach, with topics covering hot-button issues such as artificial intelligence and bitcoin.

“These concepts are becoming part of brands’ lives, but are not necessarily things that impact you right now. Companies need to be thinking about what’s coming next,” she suggests.

With that in mind, Annual Meeting registrants should head to the **Opening Ceremonies** at 4:30 pm to hear Ms. Berard speak about the most pressing IP issues for the next 12 months and beyond. ●



Tish Berard

“The Presidential Task Force will take a look at the issue to see what opportunities exist for SMEs, the challenges they face, and what gaps need to be filled.”



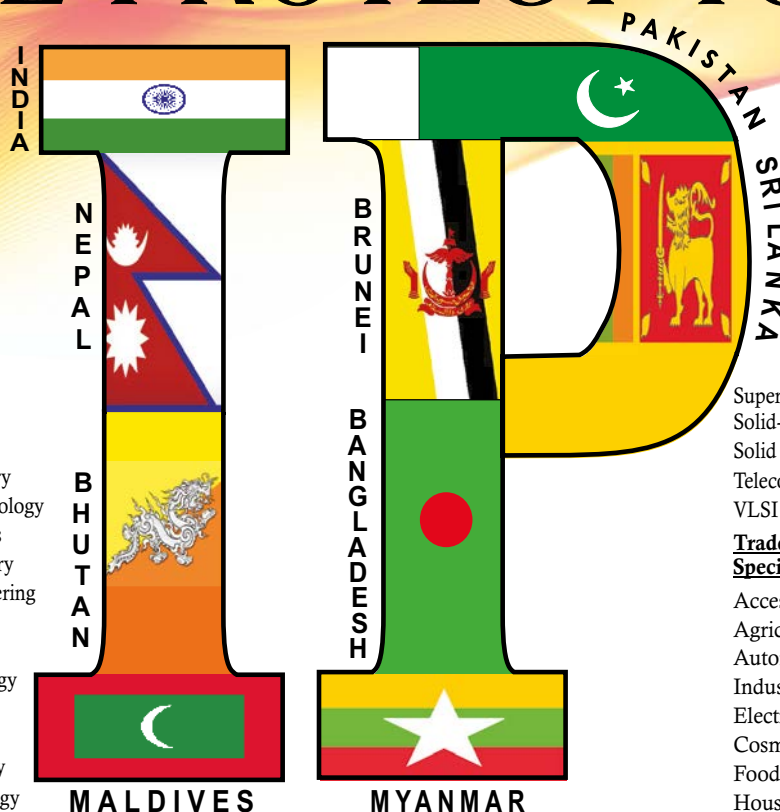
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Geographical Indications: Hear From the Experts

Geographical indications (GIs) protect things we all love—including food and drink—but upholding that protection is no easy feat. Aislinn Burton talks to four GI insiders, including several speaking on panels at the Annual Meeting, about the challenges in registering and enforcing GIs.



A geographical indication (GI) acts as a badge of trust, showing that a product meets certain standards or is produced in a certain region. But just as obtaining and registering a GI is no easy feat, protecting these rights against infringement presents a range of challenges.

Jurisdictional Dilemmas

Lindsey Low, Deputy Director Legal Affairs at the Scotch Whisky Association (Scotland), who spoke during the 2018 Annual Meeting's **Session CSA23 Certifying Geographical Origin** on Saturday, says that the United Kingdom's upcoming departure from the European Union—known

as Brexit—poses a big issue for GI-protected products in both the United Kingdom and the European Union. Currently, U.K. laws relating to GIs are based on EU instruments and the jurisprudence of the Court of Justice of the European Union, both of which will lapse after Brexit.

With the United Kingdom set to leave the European Union in March 2019, measures need to be put in place to protect U.K. GIs in the remaining 27 EU member states, as well as to protect European GIs in the United Kingdom, according to Mr. Low.

“U.K. GIs benefit from protection in third countries through trade agreements with the European Union, and we need to make sure this continues,” he adds.

Since the United Kingdom's exit from the European Union jeopardizes the benefits of those trade agreements, Mr. Low says the Scotch Whisky Association has been “engaging closely” with the U.K. government and the European Commission to ensure they address issues such as this.

Trade agreements are also used in other parts of the world as a tool to secure GI protection. According to Dirk Troskie, Director Business Planning and Strategy at Western Cape Department of Agriculture (South Africa), an important development in South Africa centers on the Economic Participation Agreement (EPA) between the European Union and the South African Development Community (SADC), which was signed in 2016. The agreement between the European Union and six countries of the SADC (Botswana, Lesotho, Mozambique, Namibia, South Africa, and Swaziland) is intended to increase

economic growth and encourage trade within and across the regions.

“It was the first time these six countries jointly entered into a free trade agreement with the European Union, and it was also the first time such an agreement contained a GI provision,” Mr. Troskie says.

As a result of an addendum to the 2016 agreement (Protocol 3 to the EPA), he explains, several South African GIs are now protected in the EU market, such as the Rooibos infusion and Paarl wine. In return, the agreement gave more than 250 EU products bearing GIs protection in South Africa.

Massimo Vittori, Managing Director at the Organization for an International Geographical Indications Network [oriGIN] (Switzerland), who is a panelist at tomorrow's **Session CM50 Geographical Indications in the Domain Name Space**, believes that bilateral/multilateral trade agreements can be particularly important for protecting GIs across jurisdictions.

“Modern free trade agreements generally have a chapter on IP and GIs which provides for the recognition and protection of a list of GIs in the relevant jurisdictions,” he explains.

However, Mr. Vittori says that, although these agreements are generally positive, different rules in regional or bilateral agreements related to the recognition and protection of GIs can make it problematic to

reconcile at the multilateral level and be burdensome for businesses.

Patrick Kole, Vice President Legal and Government Affairs at the Idaho Potato Commission (USA) and Chair of INTA's Geographical Indications—Existing Rights Subcommittee, who also participated in Saturday's session on **Certifying Geographical Origin**, believes that GI legal developments are inseparable from public policy and trade issues. Competing interests in and between countries mean the ways brands market and sell their products can be a contentious issue in jurisdictional negotiations.

Mr. Vittori agrees that policy makers and associations play a part



Lindsey Low

“

I don't believe that consumers buy fake food and drink on purpose.

”



Dirk Troskie

“

The agreement between the European Union and six countries of the SADC is intended to increase economic growth.

”



GIs act as a badge of trust, showing that a product meets certain standards or is produced in a certain region.

in arranging and orchestrating the level and form of protection for GIs overseas.

“Through bilateral agreements, governments are trying to ensure that protection for GIs is available in more countries,” he says.

Protect and Enforce

When it comes to protection, Mr. Low says it's important not to confuse the GI right itself with the method used to protect it: registering the right is the primary task.

“Scotch Whisky is registered as a GI in Canada, a certification mark in Australia, a collective mark in China, and in the United States we rely on federal regulations and the Lanham Act,” Mr. Low explains.

“In order to preserve the reputation of GIs, producers must hold themselves to exacting standards,” he says, adding that the Scotch Whisky Association often simultaneously deals with more than 50 civil cases, several hundred trademark oppositions, and numerous administrative complaints and investigations.

Mr. Troskie agrees that GI owners should apply for protection across other jurisdictions, although he notes that there is limited practical support available to those trying to develop

a GI. The Western Cape Department of Agriculture, for one, seeks to help producers with the development of individual product descriptions and the application process relating to acquiring GI protection, he says.

Mr. Kole has found that developing protective marketing strategies that link back to the product's origins is



Massimo Vittori

“
Through bilateral agreements, governments are trying to ensure that protection for GIs is available in more countries.
”

an effective way to inform consumers that a product is genuine, authentic, and predicated on cultural heritage, but he acknowledges that the “cost, time, and effort” required to execute a marketing strategy on a large scale can be a problem for some brands.

If consumer demand for GI-infringing products decreases, so will the supply, suggests Mr. Low. “I don't believe that consumers buy fake food and drink on purpose,” he says.

In terms of governments' role in enforcement, Mr. Kole says governments should encourage stakeholders to resolve differences in a fair, honest, and equitable way. He adds that governments are responsible for creating public policy related to trademarks and GIs, “so they should create a legal framework to protect against infringement in a cost-effective way.”

On the other hand, he believes that governments can, on occasion, be a hindrance for GI owners, as “there are always competing forces in the context of public policy.” As such, it's important for brands to have the means and ability to protect their identities independently, Mr. Kole concludes.

INTA adopted a Board resolution on the protection of GIs and trademarks on September 24, 1997. For more

information on INTA's activities related to GIs, see the dedicated topic portal at <https://www.inta.org/Advocacy/Pages/GeographicalIndications.aspx>.

Learn more about these issues in **Session CM50 Geographical Indications in the Domain Name Space** on Monday from 3:30 pm to 4:45 pm. ●



Patrick Kole

“
There are always competing forces in the context of public policy.
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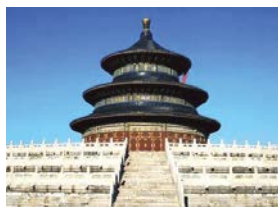
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Protecting a Treasure Trove of Resources

While Africa's legal systems have a strong basis for protecting traditional cultural expressions, more needs to be done to establish links between brands and indigenous communities, as Sarah Morgan reports.

In the Maasai community, which inhabits central and southern Kenya and northern Tanzania, a group of Maasai elders and leaders united to protect their cultural brand after an estimated 1,000 companies made use of the community's name, image, and reputation.

While the brand itself is worth billions of dollars, around 80 percent of the Maasai live below poverty level, according to non-governmental organization Light Years IP. The organization helped set up the Maasai Intellectual Property Initiative, dedicated to reclaiming the Maasai ownership of its famous brand.

Unfortunately, it's not just the Maasai community whose work has been used in this unauthorized manner: Kente designs from Ghana and Ndebele art from South Africa are just two other examples.

"Traditional cultural expressions (TCEs) embody the exquisite creativity of the more than 300 million members of indigenous and local communities from all around the world, representing a treasure trove of cultural wealth," explains Wend Wendland, Director at the World Intellectual Property Organization's (WIPO's) Traditional Knowledge Division (Switzerland).

It stands to reason that TCEs, as creations of the human mind, should receive some type of IP protection, adds Mr. Wendland.

He believes that not all TCEs should receive absolute and indefinite protection, which some indigenous and local communities ask for, but rather that a system for the protection of TCEs should be inspired by the



The Maasai have united to protect their brand

isaachphao / Barozz Hadyniade

IP systems that already exist for the protection of contemporary literary and artistic expressions, trademarks, and geographical indications.

"These existing IP systems reflect delicate balances between the interests of rights holders and users, and these balances should also apply to TCEs and traditional knowledge (TK) protection," Mr. Wendland says.

This is more easily said than done, however.

Deeper Roots

Denis Loukou Bohoussou, Director General at the Organisation Africaine de la Propriété Intellectuelle (OAPI) (Cameroon), believes "there is no incompatibility between the IP system and Aboriginal values, for example. However, because of the holistic nature of TK and TCEs, the IP system does not fully understand them."

He questions how the IP system could "protect an object, such as a statue, without the ritual that gives it its meaning."

TCEs and TK are an "integral part of the identity" of the peoples who hold them, making them invaluable in the cultural and social life of these communities, explains Mr. Bohoussou.

Mr. Wendland adds: "A bedrock principle of most parts of the IP system is that protected materials pass, at some stage, into the public domain."

However, the differences between TCEs and TK, and other forms of IP, shouldn't be overstated, says the WIPO director.

"The basic norm that underlies IP protection—that human creativity and innovation should not be misappropriated and misused by third parties—is not unique to the societies that most fully embrace the current and conventional IP system," he notes.

Mr. Wendland goes on to explain that this norm forms part of the customary laws and protocols of societies in all parts of the world, noting:

"What we call 'IP' rules are, therefore, found in almost all societies, now and in the past."

Special Measures

In 2010, the African Regional Intellectual Property Organization (ARIPO) introduced a regional instrument, the Swakopmund Protocol on the Protection of Traditional Knowledge and Expressions of Folklore, which entered into force in May 2015.

The Protocol is aimed at empowering TK and TCE owners to exploit and protect their resources, as well as preventing misappropriation and illicit use of the resources.

Fernando dos Santos, Director General at ARIPO (Zimbabwe), says: "The TK owners already have knowledge as their own. The Swakopmund Protocol gives them legal rights to exploit it as their own."

It enables ARIPO to manage transboundary TK and TCEs. The Maasai tribe is a prime example: it has a common pool of traditional and cultural knowledge, but the community resides in both Kenya and Tanzania.

Under the Swakopmund Protocol, applications to register TK and TCEs cost US \$50, and it costs another US \$50 for registration.

The Protocol has also served as a template for the development of national legislation, with Kenya and Zambia modeling legislation on it.

ARIPO is also attempting to develop a database on codified and non-codified TK and expressions of folklore.

Mr. dos Santos explains: "It is a database for the knowledge holders. For one to access the database one needs consent from the owners."

Many African nations are also



Wend Wendland

“Traditional cultural expressions embody the exquisite creativity of the more than 300 million members of indigenous and local communities from all around the world.”



Denis Loukou Bohoussou

“There is no incompatibility between the IP system and Aboriginal values.”

undertaking practical initiatives, such as creating their own databases and supporting work on protocols and guidelines.

OAPI's Mission

The protection of TK and TCEs is also an integral part of OAPI's mission, reflected in the Bangui Agreement of March 1977, with measures on the protection of expressions of folklore and cultural heritage.

In 2007, OAPI member states adopted two legal instruments on the protection of genetic resources, TK, and expressions of folklore.

OAPI registers industrial property rights and marks or other distinctive signs that may include figurative elements representative of certain communities. The existing opposition procedure allows an interested community to oppose any appropriation by a third party.

The majority of OAPI member states have had national laws on the protection and promotion of cultural heritage, including TCEs, since the 1960s, but difficulties remain in the implementation of these laws, says Mr. Bohoussou.

OAPI intends to invest more in supporting its member states in the protection of genetic resources, TK, and TCEs, as presented in its strategic plan for 2018 to 2022.

On the policy side, WIPO assists the regional organizations to develop policies, action plans, strategies, and legislation.

"The assistance that the WIPO Secretariat provides is not 'advice' as such, but rather information as to the key issues, options, and international experiences," explains Mr. Wendland.

Community Links

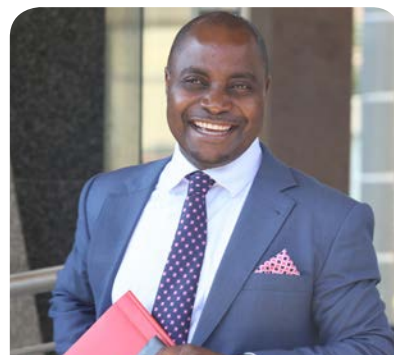
Establishing links between brands and the community should also be high on the agenda, although Mr. dos Santos notes that there are challenges to doing so.

"Brands should work with these communities to promote their authentic cultural artefacts and for the communities to derive some economic benefits from them. If one has a brand and can link it to the community then it adds value to what they are doing," he concludes.

Mr. Wendland adds: "In my view, it's not that brand owners should never use indigenous materials, but rather that there are good and not-so-good ways of doing so."

Consultation is a key ingredient of any successful collaboration, he explains, adding that without this, the brand owner may attract negative publicity.

"The ideal would be win-win collaborations between the brand owner and the community, in which the



Fernando dos Santos

"Africa is doing well on traditional and indigenous knowledge, and has institutional structures and cultural heritage sites."

community can benefit economically, socially, and culturally, and the brand owner can enjoy the enthusiastic endorsement of the community and achieve a broader public relations benefit that increases brand equity," Mr. Wendland says.

It's Always Possible to Do More

"Africa is doing well on traditional and indigenous knowledge, and has institutional structures and cultural

heritage sites, but more needs to be done on IP and economic development. Documentation is also lacking," says Mr. dos Santos.

He adds that Africa supports the establishment of international frameworks to effectively protect resources and to create more awareness of the rights and obligations of communities. "We also need to empower them through community projects and assist them to add value to what they have," states Mr. dos Santos.

The first step is to help communities make more strategic and effective use of existing IP tools, through hands-on capacity-strengthening and practical projects, says Mr. Wendland.

"If new *sui generis* laws are enacted, more could be done to ensure that the laws are implemented in practice (and do not simply sit on the statute books) and in ways that benefit communities," he claims.

Lessons learned at national and regional levels should find their way into international processes, such as the WIPO Intergovernmental Committee, so that "new normative outcomes are focused on addressing actual harms and build on real-world experiences," Mr. Wendland concludes.

The views expressed by Wend Wendland do not necessarily represent the views of WIPO or any of its Member States. ●



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GIs: The Journey We Do at Dinner

One of the first sessions of the Annual Meeting shone a spotlight on the unique role of geographical indications, as Aislinn Burton reports.

Geographical indications (GI) is a “special topic in the trademark world”, according to Eric De Gryse, Partner at Simont Braun (Belgium), who moderated yesterday’s panel discussion **CSA23 Certifying Geographical Origin**.

The panel consisted of Elio De Tullio, Managing Partner at De Tullio & Partners (Italy), Patrick Kole, Vice President Legal and Government Affairs of the Idaho Potato Commission (USA), and Lindesay Low, Deputy Director Legal Affairs at Scotch Whisky Association (Scotland).

“Strengthening the protection and significance of GI in product branding is receiving renewed interest” from brands, Mr. De Gryse said. Not

only have GIs become “an important advertising tool,” but they also act as an indication of quality and safety within the food industry.

Simply put, “what we’re talking about is food quality,” Mr. Kole said. For him, GIs are “all about the consumer and the impact of food fraud.”

He explained that certification marks come in many different shapes and sizes, and there can be overlaps between origin-based certifications and trademarks. However, consumers don’t necessarily recognize the distinctions between each type of mark.

For example, Mr. Kole said that currently there is no federal law which regulates use of the word “natural” on foods in the United States. “Consumers

think it means organic and it really doesn’t,” he added. “It looks like a certification mark but it’s registered as, and functions as, a trademark.”

Though there can be “synergies” between trademarks and GIs and “both concepts enable producers to distinguish their products in the market,” Mr. De Tullio noted that there are also some crucial differences between the two forms of IP.

Unlike trademarks, GIs can never become generic; there is no duty of use; and the registration process is managed by institutions rather than private bodies, Mr. De Tullio explained.

Referring to the EU approach to GIs, he said “the GI system is a way to preserve cultural and gastronomic

diversity and heritage.” A GI refers to different tastes, cultures, and traditions. “It’s a journey that we do when we go to dinner,” Mr. De Tullio summarized.

Scotch Whisky enables consumers to enjoy a journey that is “uniquely Scottish,” according to Mr. Low, who said that most of his working hours are spent trying to protect the organization’s GI. Scotch Whisky is imported into around 200 markets and its annual export value is worth roughly US \$5.4 billion, so the GI of it “really is an important IP asset,” he said.

However, Mr. Low explained that it’s “important for a GI to be able to prove that it actually is the real thing.” “Saying ‘we’re from Scotland, you can trust us,’ doesn’t get you very far,” he said. Product verification is therefore a crucial part of GI protection.

After protection comes enforcement. “Perhaps the most onerous part of our job is actually to prevent infringement,” Mr. Low said, as “in just about every country there will be somebody trying to take unfair advantage.”

“It’s a big job, protecting our GI. Investment is important; it’s a long-term project, as success always breeds imitators,” Mr. Low concluded.

Learn more about these issues in **Session CM50 Geographical Indications in the Domain Name Space** on Monday from 3:30 pm to 4:45 pm. ●



(L. to R.) Elio De Tullio, Lindesay Low, Patrick Kole, and Eric De Gryse

Learn To Love Change

Encouraging Nigeria’s government to adopt legal protection for geographical indications is one of several ways the country can help to increase the value of local indigenous products, says Uche Nwokocha, Head of IP and Partner at Aluko & Oyebo.

“Companies that haven’t embraced innovation are now becoming extinct. If you don’t change, you get left behind.”

These are the words of Uche Nwokocha, Head of IP and Partner at Aluko & Oyebo (Nigeria), a member of INTA’s Board of Directors.

For brands that are brave enough to embrace change and view innovation as an everyday requirement, the future is bright, she says.

“And that’s what INTA has embraced and is championing,” she adds.

“Embracing Innovation and Change” is the third pillar of INTA’s 2018–2021 Strategic Plan, and includes positioning the Association as a thought leader on opportunities arising from innovation and technology.

One clear example of this is INTA’s Brands and Innovation Committee, which is seeking to build and strengthen ties with technology-based groups.

Ms. Nwokocha likens the Association to her “second family,” stating that she has not missed an Annual Meeting since attending her first one, in Washington, D.C., in 2002. She has previously chaired INTA’s Anticounterfeiting Committee’s Middle East, Africa and South Asia Subcommittee.

This year, she began serving as a member of the Association’s Board of Directors—helping to advocate for global trademark protection and other policy priorities, and to implement INTA’s 2018–2021 Strategic Plan.

In her day job, Ms. Nwokocha represents global brands including The Coca-Cola Company, GSK, and the Fédération Internationale de Football Association, to mention a few.

Many of these brands suffer at the hands of fake goods in Nigeria, she explains, and this is why her firm formed an anticounterfeiting department, as well as the Anti-Counterfeiting

Collaboration, Nigeria, a forum in which regulators, brand owners, law practitioners, and the press can discuss the issues companies are facing.

Nigeria’s laws are not yet in conformity with the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), due in part to the need for updated IP legislation. For example, geographical indications (GIs) are not available in the country (despite being available under TRIPS), although legislation on GIs has been pending for the past 10 years.

“We need to look at legislation to import this aspect of TRIPS,” says Ms. Nwokocha.

The country’s current policy goal of having a sustainable international market for products of Nigerian origin is also expected to drive the change forward.

Ms. Nwokocha emphasized the need to develop initiatives and awareness-



Uche Nwokocha

“Nigeria’s current policy goal of having a sustainable international market for products of Nigerian origin is expected to drive change forward on IP and GI legislation.”

raising activities with key stakeholders in order to explain the value of traditional knowledge and traditional cultural expressions and to ensure adequate protection and enforcement for rights holders. ●

Groundless Threats of Trademark Infringement

Trademark owners in common law jurisdictions should be familiar with the law on groundless threats of infringement, says Faisal Daudpota of Daudpota International (UAE).

Common law statutes often provide for preemptive legal proceedings against groundless threats of trademark infringement. Such laws usually include nuances like that of Section 52 of Pakistan's Trade Marks Ordinance, 2001 (TMO'01), which says that where a person makes a "threat" to bring a legal action against another person on the ground that the other person has (a) infringed a registered trademark; or (b) infringed a trademark claimed as registered; the person "threatened" may bring preemptive legal proceedings for relief against the person making the threat.

However, if the "threat" has not been defined, TMO'01 clarifies that notification that a trademark is registered or that an application for registration has been made shall not constitute a "threat." Further, it says that such preemptive legal proceedings can be initiated to seek relief, including (a) a declaration that the threats are unjustifiable; (b) an injunction against the continuance of the threats; or (c) damages in respect of any loss sustained by the threats.

Further, the law states that such preemptive legal proceedings by the person "threatened" will fail if the person making the threat shows that the relevant acts (in respect of which legal action was threatened) are (a) an infringement of the registered



trademark concerned; or (b) would be an infringement of the given registered trademark.

Notwithstanding the foregoing defenses for the person making the threat, such preemptive legal proceedings by the person "threatened" may still be maintainable if he shows that the registration of the given trademark is (a) invalid; or (b) liable to be revoked.

Tricky Causes of Action

Common law courts understand perfectly that causes of action for preemptive legal proceedings are tricky. Leading courts from various countries have always cautioned about the awkwardness of such cases by making the point that the right to institute a suit for infringement of a registered trademark is an important one.

Also, it is settled law that unless there is an express statutory bar, the right of a person to institute a suit should not normally be interfered with. Thus, essentially the preemptive legal proceedings must be viewed cautiously, because through such proceedings the court is usually called on to pass an order restraining the defendant from instituting a suit.

When a Cause of Action Arises and Expires

There is an inherent limitation to such causes of action. That is, preemptive legal proceedings seeking an injunction against groundless threats for trademark infringement can arise only from the date on which the "threat" for alleged infringement has been made, and that such a cause of action expires on the date on which legal proceedings have been initiated by the person that originally issued the "threat" of infringement action.

Claimant's Burden of Proof

In typical circumstances of preemptive legal proceedings seeking injunction against groundless threats for trademark infringement, the claimant must prove that:

- The claimant has received threats of an imminent legal action by the defendant for alleged trademark infringement;
- The defendant does not have any valid trademark right; and
- The claimant has not committed any actions of trademark infringement (and will be able to successfully defend himself against a trademark infringement claim).

Defendant's Burden of Proof

Again, in typical circumstances of preemptive legal proceedings seeking injunction against groundless threats for trademark infringement, the defendant must prove that:

- The defendant has the statutory right to claim infringement and issue a threat of legal action against the claimant;
- The defendant has a valid trademark right;
- The claimant cannot stop the defendant from exercising his legal right;
- The claimant has committed actions of trademark infringement (and will lose the case of trademark infringement); and
- The defendant has already initiated the legal action for infringement of the given trademark. ●

Faisal Daudpota is Senior Partner at Daudpota International (UAE). He can be contacted at: faisal@daudpota.com



Faisal Daudpota

“Preemptive legal proceedings must be viewed cautiously, because through such proceedings the court is usually called on to pass an order restraining the defendant from instituting a suit.”

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Covering All Your Bases

For large multinational companies, brand protection is a matter of combining an assertive approach to discovering infringement with proactive steps to securing rights, as Sarah Morgan reports.

“Your market is really the world. From a brand perspective, you need to protect it everywhere or you risk erosion to the brand.”

These are the words of Patrick Keane, Executive Shareholder, Buchanan Ingersoll & Rooney P.C. (USA), who was responding to a question from the audience on how aggressively businesses should protect brands in areas where the business isn't operating or plans to operate in the foreseeable future.

For Laure van Oudheusden, IP & Standards Manager of Health & Wellness and Personal Care at Philips Intellectual Property & Standards (the Netherlands), protecting the company's US \$11.5 billion parent-brand is vital.

During **CSA21 Generating Effective IP Protection Efficiently: Building a Trademark and IP Department for International Corporations**, yesterday, she gave an example of Philips approach, even

where the infringing product is not one which the company makes itself.

“It wouldn't matter so much how many of these products we sell, it's blatant infringement so we want to do something,” said Ms. van Oudheusden.

“That's why we enforce our brand even on products where we're not competing,” she said, adding that this type of infringement has a high impact on one of the biggest assets of the company.

“

This governance model helps us to know how and where value is created and to focus on activities that create the most value.

”

Laure van Oudheusden

Ms. van Oudheusden recommended a form of “double monitoring,” where the executive function in the business monitors infringement as well as the IP team, “because the business knows better what the key threats are”.

She went on to explain that it's easier for the business to track new entrants in the market and that it's useful to promote a dialogue to prioritize actions.

“The less resources you have, the more you need to plan,” added Ms. van Oudheusden.

Philips Intellectual Property & Standards, which manages all the licensing and IP activity for Philips, works like any other type of business, responsible for creating value and controlling its costs.

Ms. van Oudheusden stated: “This governance

➔ 20



(L. to R.) Patrick Keane, Laure van Oudheusden, and Stephan Wolke



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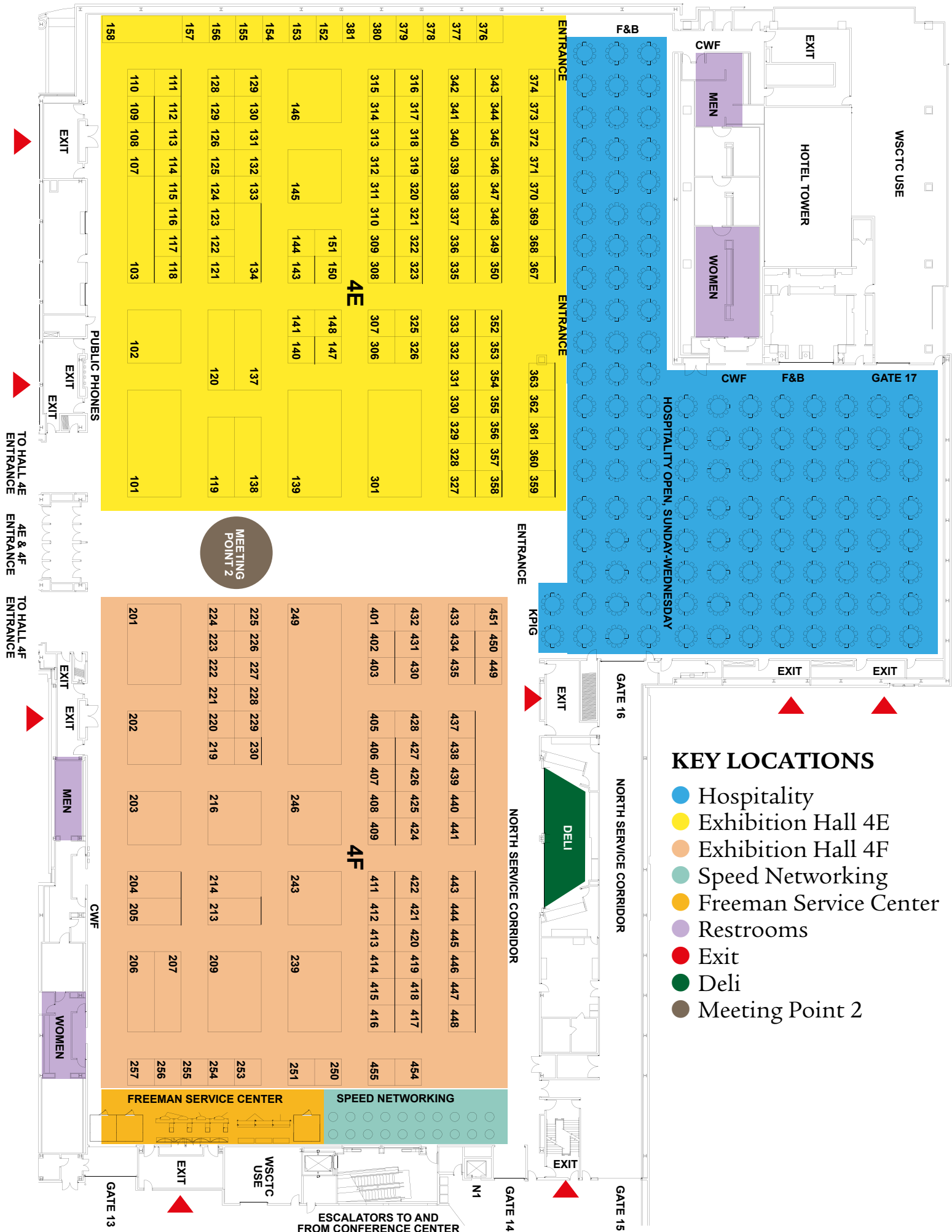


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Exhibitor	Booth
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ABPI-Brazilian Intellectual Property Association	445
ACCOLADE IP Ltd.	361
Acumass	246
Adastra IP	417
Afilias	450
African Regional Intellectual Property Organization (ARIPO)	115,116
AIPPI, International Association for the Protection of Intellectual Property	443,444
Al Adwani Law Firm	354
Alan & Associates (Hong Kong, Beijing) Intellectual Property Agency Limited	126
ALIAT LEGAL - Intellectual Property & Business Law	440
ALIPO - Asia Lih Intellectual Property Office	143
Alt Legal	308,309
Alvarez Delucio	130
Alyafi IP Group	216
Amazon Brand Registry	405
Anaqua	202
Andrade & Andrade Intellectual Property-Ecuador	144
AppDetex	123
Applied Marketing Science	223
Asia IP	254
ASIP: Inter-American Association of Intellectual Property	446
Beijing Gaowo International Intellectual Property Agency	335,336
Beijing Globe-Law Law Firm	373,374
Beijing Saintbuild Intellectual Property Agency Co., Ltd.	329,330
Beijing Sanyou Intellectual Property Agency Ltd.	134
Beijing Uni-intel Patent and Trademark Law Firm	320,321
Beyond Attorneys at Law	413,414
Brand Institute, Inc.	122
BrandShelter	339,340
BrandShield Ltd.	433,434
Bufete Mejia & Asociados	380
C&H Int'l Consultant Limited	424,425
CARIBBEAN TRADEMARK SERVICES - GEORGE C.J. MOORE, P.A.	359
Catchword Branding	371
Center for Anti-Counterfeiting and Product Protection, MSU	454
CheckMark Network	401,402
China Intellectual Property Magazine	379
China Periodic Law Firm	355
Cislo & Thomas LLP	435
Clarivate Analytics (CompuMark) Inc.	101
Computer Packages Inc. (CPI)	119
CONSOR	225,226
Copyright Clearance Center	219
Corsearch	139
Cosmovici Intellectual Property	346
CPA Global	239
CSC	120
Darts-ip	301
Dastani & Dastani LLP	403
Delegate	206
Denнемeyer	249
Dragon Intellectual Property Law Firm	107,108
Eldib & Co	337,338
EnCirca, Inc.	322,323
Getting The Deal Through	230
GEVERS	318,319
The Global IP Matrix	407
Gorodissky & Partners	362
Haihong Jiacheng Intellectual Property & Partners	154
Herbert T. Patty, Esq.	153
HFG Law & Intellectual Property	250,251
Hong Kong Trade Development Council	437
HSM IP LTD	138
IAM	213
InSearchIP Corporation (TJIP Patent & Trademark Firm)	381
Intels Group	158
Inventa International	146
INVESTIP	363
Iolite Softwares Pvt. Ltd.	438
IP Markets	426
IPConnect Limited	421
IPPro The Internet	229
IPzen	214
IRANTM.COM	125
Japan Patent Office /Japan External Trade Organization	117,118
Jinan Baitu Trademark Software Co., Ltd	419
JW IP Law Firm	455
Keisen Associates	353
KINHALO International Intellectual Property (Beijing) Ltd	316,317
Kondrat & Partners	367

Exhibitor	Booth
Korean Intellectual Property Office (KIPO)	113,114
ktMINE	420
Leaders League	128
LEAO Intellectual Property-Brazilian IP Firm	439
LexisNexis	228
Lexsynergy	408,409
Lighthouse IP	133
The Luzzatto Group	147,148
Lung Tin Intellectual Property Agent Ltd.	207
Madderns Patent & Trade Mark Attorneys	152
Managing IP	131,132
Marcasur	447
Markify	150,151
Marksmen	137
Maxval Group, Inc.	418
Med-ERRS	221
Mikhailyuk, Sorokolat & Partners	357,358
Mission Legal	360
Morningside IP	127
Moser Taboada	378
Nam & Nam World Patent & Law Firm	377
Namied Patent & Trademark Law Office	368
Nevium Intellectual Property Solutions	406
Nominet & Valideus	448
Novagraaf	203
O P Solutions	222
OAPI	111,112
Oorkle LLC	372
OpSec Security	449
Oxford University Press	224
Pacific Patent Multiglobal	312,313
Page Vault	376
Patrix	201
Pham & Associates	220
Pintz and Partners LLC - Trademark.eu	356
Practice Insight	415,416
Quality Brands Protection Committee (QBPC)	350
Quantify IP	430
Questel	121
RWS	109,110
S.S. Rana & Co	314,315
SafeBrands	428
Safenames	327,328
SBZL IP Law Firm	157
Sedo/InterNetX	343,344
Selvam and Selvam	369
Shirasaka & Patent Partners	370
Singh & Associates, Founder- Manoj K Singh Advocates and Solicitors	306,307
Sjiem Fat & Mahabir	204
SK Worldwide, Ltd.	227
SMD Group	103
SOJUZIPATENT	253
Sortify.tm Limited	347
StratJuris Partners-India	422
SUGIMURA & Partners	243
Tangible IP	349
Tilleke & Gibbins	205
TM Cloud Inc.	325,326
TM TKO, LLC	255
Trademark Clearinghouse	352
The Trademark Lawyer Magazine	129
TrademarkNow	332,333
Trademarks & Brands Online	256
TrademarkVision	145
Tsingyihua Intellectual Property Law Firm	345
Vantage Asia Publishing Limited	348
VASH PATENT Ltd.	441
VIVANCO & VIVANCO – LATIN AMERICA	431,432
Vox Populi Registry	209
Watson & Band	310,311
Wayne Intellectual Property Agency Co., Ltd	331
WEBDRONE	155
WebTMS Ltd./Intellectual Property Online Ltd.	140,141
Western Union Business Solutions	124
Wolters Kluwer	411,412
Work AnyWare	156
World Intellectual Property Organization (WIPO)	102
World IP Review	257
World Trademark Review	213
YUHONG Intellectual Property Law Firm	341,342

Africa, Geographical Indications, and 3D Marks

For those interested in IP issues in Africa, geographical indications, or 3D marks, Aaron McDonald outlines what you can expect from three sessions this week.

Session RM01 Africa Regional Update: Land, Sea and Air Adventures—New Developments and Trends in the Protection and Enforcement of Trademark Rights in Africa (Monday, 10:15 am–11:30 am)

“The African continent is one of the most thriving and dynamic places in the world,” according to Marius Schneider, Attorney-at-law at IPvocate Africa Law Firm Cabinet d’Avocats (Mauritius), one of the speakers at this session.

“Individuals such as judges, trademark practitioners, and law enforcement authorities are highly motivated because they are aware that they are engaged in pioneering work,” he says.

As an example of the progress made in the region, Mr. Schneider notes that some countries, such as Nigeria and Tanzania, have introduced online filing of trademark applications.

The continent may be embracing new developments, but it still faces challenges, he notes.

To overcome these, brand owners are partnering with local officials and practitioners to invest in protecting their rights.

“There can no longer be any doubt that Africa is rising; its growing middle class represents an untapped, dynamic, fast-moving, and competitive market for brands,” adds Mr. Schneider.

The session will be moderated by Vanessa Ferguson, Director at KISCH IP (South Africa), who says that the African continent’s fast-growing young population is making the region attractive to investors and brand owners alike.

However, she says that “Africa has the tendency to test a brand holder’s patience. Navigating the legal minefield requires patience, cooperation, and collaboration.”

Ms. Ferguson notes that the panelists will share “top tips, advice, cautionary tales, and other stories” resulting from their experiences in protection and enforcement of IP rights in Africa.

The session will also include the following speakers: Vanessa Halle, a Partner at Nico Halle & Co. Law Firm (Cameroon); Karen Kitchen, Director at KISCH IP (Zimbabwe); and Sandra Wens, Technical Expert, IPR, at the World Customs Organization (Belgium).

Session CM50 Geographical Indications in the Domain Name Space (Monday, 3:30 pm–4:45 pm)

Scott Gerien, a Partner at Dickenson Peatman & Fogarty, PLC (USA), says that in many cases, geographical indications (GIs) have greater consumer recognition than trademarks



Marius Schneider

“

The continent may be embracing new developments, but it still faces challenges.

”

and provide the producers with instant consumer recognition.

“The problems GIs face in the domain name system are a result of the larger international conflict as to the treatment of GIs under international systems,” suggests Mr. Gerien, who will be one of the presenters at this session.

“While the Agreement on Trade-Related Aspects of Intellectual Property Rights treats trademarks and GIs as equivalent properties, the lack of an international registration system for GIs similar to the Madrid Protocol for trademarks or the Patent Cooperation Treaty for patents means that it is difficult for regional producers to secure registered rights equivalent to those of trademarks,” he explains.

According to Mr. Gerien, the “genericness” of a small number of GIs in certain jurisdictions presents a problem, with the political sensitivity of this issue preventing governments enacting an international system that could be valuable to the large majority of regional producers that use and benefit from GIs.



Scott Gerien

Mr. Gerien will be joined tomorrow by Jonathan Agmon, Senior Partner at Soroker Agmon Nordman, Advocates & Patent Attorneys (Israel); Charles Goemaere, Deputy General Director at Comité Champagne (Comité interprofessionnel du vin de Champagne); Massimo Vittori, Managing Director at oriGIn (Switzerland); and Mary Wong, Senior Policy Director at ICANN (USA). The panel will be moderated by Francine Tan, Director at Francine Tan Law Corporation (Singapore).

Session CT21 3D Trademarks after Rubik’s Cube (Tuesday, 11:45 am–1:00 pm)

In a competitive market, it is important for brand owners to explore different avenues to set their products apart. Whereas European Union Trade Marks (EUTMs) tended traditionally to be words and logos, this is no longer necessarily the case.

“More recently, brand owners have attempted to obtain trademark registrations for other types of marks, including color or the shape of the product or packaging,” says David Stone, a Partner at Allen & Overy LLP (UK), a speaker at this session.

He explains that EUTM reforms have removed the requirement for a mark to be “capable of graphical representation.” This should allow for further types of trademarks such as holograms and sounds.

“However, there is a tension between the reforms allowing nontraditional marks and numerous Court of Justice of the European Union cases where EUTM protection has been rejected for 3D shapes on the basis that they are not distinctive, or are functional,” he continues.

According to Mr. Stone, this creates uncertainty and has increased brand owners’ reluctance to fight to protect this type of trademark.

Mr. Stone believes that brand owners should develop global filing strategies to provide the best



Vanessa Ferguson

chance of successfully registering 3D trademarks.

“Overall, it is far more difficult to obtain registered protection for 3D marks than more traditional forms of trademarks,” he adds. “It can take many years to prove that a shape functions as a trademark, so owners may want to embark on this fight only for their signature brands.”

Another speaker at this session, James Johnson, Intellectual Property Counsel at Eversheds Sutherland (USA), says that in the United States, 3D trademarks give a brand the opportunity to set itself apart from the competition.

“3D trademarks offer unique possibilities for a mark owner to step out of the pack, distinguishing, identifying, and safeguarding their brands,” he says.

According to Mr. Johnson, globalization has helped the market accelerate toward saturation, “thus giving rise to an increasing demand for novel ways of identifying brands.”

“The use of nontraditional trademarks is now more important than ever, with consumers having a significantly larger social presence online ... and impacting the way today’s generation communicates,” he says.

Maximilian Kinkeldey, Lawyer at Grunecker (Germany), is joining Mr. Johnson and Mr. Stone to discuss these issues on Tuesday. The session will be moderated by Georg Schönherr, a Partner at Schwarz Schonherr Rechtsanwälte (Austria). ●



James Johnson



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Boosting Innovation in Ethiopia

The Ethiopian Intellectual Property Office is raising awareness of the importance of trademark rights, while also warning businesses about the risk of counterfeiting, as Director General Ermias Yemanebirhan tells Aaron McDonald.

With 102 million inhabitants, Ethiopia is the second-most populous country in Africa, after Nigeria.

Such a large population creates a challenge for the developing country in raising awareness of the importance of IP protection.

"It is important to support and protect the trademark rights of Ethiopian inventors so that they know their rights and obligations in the use of their trademarks, and other trademarks too," says Ermias Yemanebirhan, Director General at the Ethiopian Intellectual Property Office (EIPO).

To this end, the office has a number of initiatives in place. These include organizing educational events through television and radio programs regarding registered trademarks and brand protection.

Other initiatives that the EIPO has in the pipeline include embracing the Technology and Innovation Support Center (TISC) program at universities and other research institutes.

The TISC program is a World Intellectual Property Organization (WIPO) project that provides innovators in developing countries access to technology information and related services. This provides them with a platform to help them reach their potential and manage their IP rights.

The program's services include providing participants with training in database searches and basic information on industrial property laws, management and strategy, and technology commercialization and marketing.

The Office is also undertaking automation of its internal trademark application and registration system, which is being done in collaboration with



The EIPO provides training to trademark owners and the business community in Addis Ababa

WIPO's Industrial Property Automation System, an integrated IP administration system that can automate the processing of trademarks, patents, and industrial designs. The EIPO expects to have full online service soon.

Other objectives include completion of a trademark examination manual in June of 2018; a new system for registering and licensing trademark agents; reestablishment of the IP tribunal court, which will have federal first instance jurisdiction over industrial property and copyrights; and transitioning IP appeal hearings to more formal proceedings that will be held in open court twice per week.

Challenges

While the EIPO has strategies in place to encourage innovation, there are still some obstacles facing brand owners.

"The biggest threat to brand owners in Ethiopia is [the unauthorized use of] similar, identical, or confusingly similar marks to registered ones," explains Mr. Yemanebirhan.

Another obstacle that brand owners face is the risk posed by counterfeiters. If a brand falls victim to counterfeiters,

this could lead to a loss of market and of reputation, says Mr. Yemanebirhan.

To help overcome these challenges, the EIPO has provided training to legal bodies (such as law enforcement, customs, consumer and trade authorities, and judges), as well as business owners, judges, and government officials, in order to raise awareness.

The EIPO also uses its website to educate the public and to disseminate information in a more efficient manner. The Office also recently launched an online trademark publication and search database and has finalized a draft IP policy, which will pave the way for more coordination and protection of trademarks and other IP assets.

Training is also provided to trademark owners, the business community in Addis Ababa, Ethiopia's capital city, and regional towns, and other stakeholders. If a brand owner does fall victim to infringement, the EIPO is able to offer support by "providing the necessary information to legal bodies (police and courts) concerning the status of the registration of the victim's marks while

they are acting against the infringer," Mr. Yemanebirhan explains.

"INTA collaborates with the EIPO through policy reviews, sharing of best practices, and regular dialogue," he concludes. ●



Ermias Yemanebirhan

"The EIPO has provided training to legal bodies...as well as business owners and government officials, in order to raise awareness."



Covering All Your Bases (continued)

14 model helps us to know how and where value is created and to focus on activities that create the most value."

Mr. Keane noted that as the world becomes increasingly globalized and moves to "an era of grand technology disruption and reorganization," brands should focus on the future.

"Find ways to use your IP to effectively leverage relationships," he said. According to Mr. Keane, the future will see many companies in different spaces creating smart products. He recommended that when developing IP, companies take into account the companies they will deal with in the future.

Building a Shield

Stephan Wolke, CEO of thyssenkrupp Intellectual Property GmbH (Germany) and moderator of the panel, explained that five years ago, his company wasn't even sure how many patents it owned.

Since then, there's been a dramatic change, with the brand building up an effective IP shield.

When Mr. Wolke first took up the role, the company was filing fewer than 300 new patents per year. Now it's managing to file 600.

To build a shield, Mr. Wolke launched patent councils in each of the company's 25 business units. The head of research and development in

each unit meets with other members every three months to discuss the full-cost of creating the desired IP. After hiring 50 patent lawyers, the company is insourcing 50 percent of its work, as compared with 100 percent outsourcing previously.

Building up an effective and efficient shield also means that "IP is reflected in some way in every contract we do with the outside world," explained Mr. Wolke.

Mr. Keane, who works with companies to help cultivate an IP shield, concluded that it "all begins with creating a solid foundation that's grounded in efficiency and effectiveness." ●



Stephan Wolke

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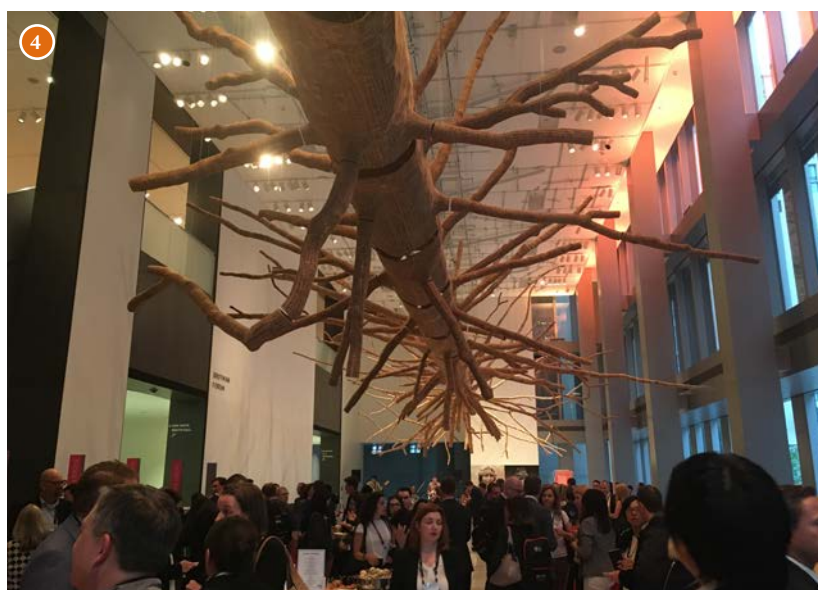


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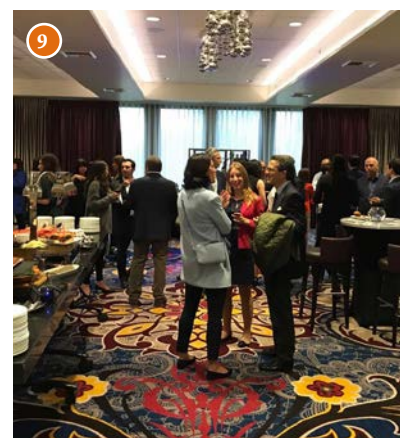
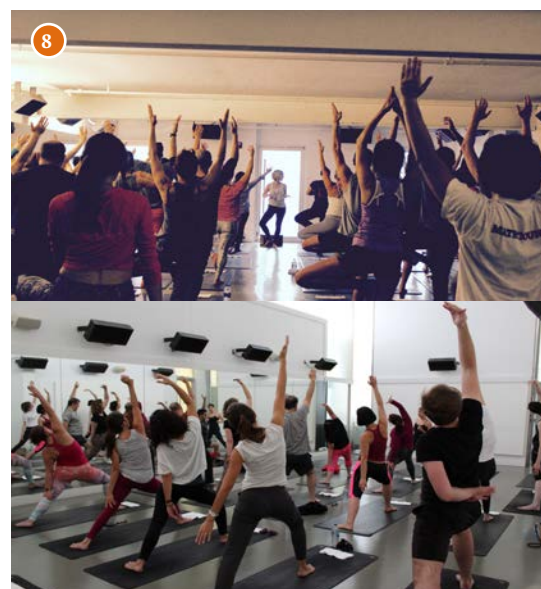
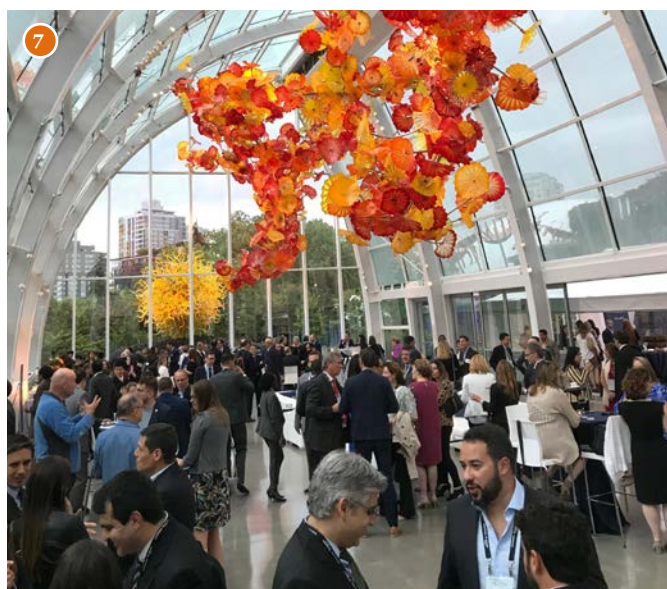
Outstanding young practitioners are eligible to win INTA's Tomorrow's Leader Award! Tell us why you qualify. Visit inta.org/tomorrowsleaderaward for more information. Applications are available beginning in June.

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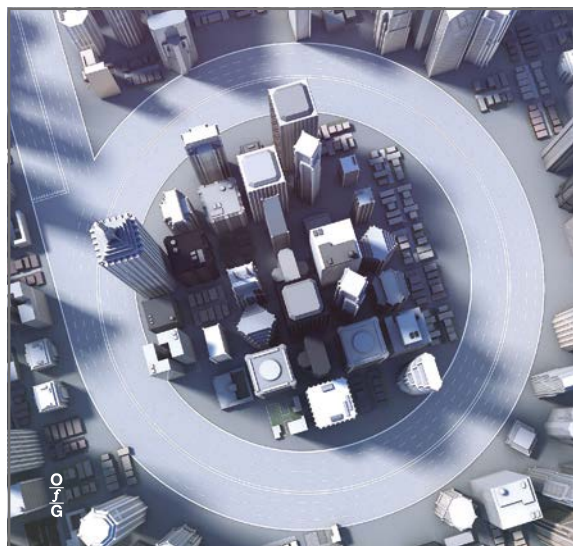
1. ASIPI, Hyatt at Olive 8
2. Birch, Stewart, Kolasch & Birch LLP, Copperworks Distilling
3. Davies Collison Cave, Frolik Kitchen
4. Lane Powell, P.C., Seattle Art Museum
5. Papula-Nevinpat, Benaroya Hall
6. Potter Clarkson LLP, The Edgewater Hotel
7. Venable LLP, Chihuly Garden and Glass
8. S.S RANA & Co., Urban Yoga Spa
9. ALAF Latin American Anti Counterfeiting Lines, Motif Hotel



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START	END	NAME	LOCATION*
SESSIONS			
11:30AM	12:45PM	CSU20 More or Less Secure: Are International Data Privacy Regulations Helping You Protect Your Brand?	Room 6C
11:30AM	12:45PM	CSU21 Influencer Marketing: Insights on ROI from Marketing and Legal Academics	Room 605 – 607
11:30AM	12:45PM	The Latest Trademark Issues Facing IP Attaches based in China, Europe, South America, Asia and Geneva	Room 602 – 604
11:30AM	1:30PM	Trademark Administrators Brunch: Practical Lessons, Takeaways and First-Hand Experience Relating to IP Enforcement in Social Media (Advance registration required)	Room 608 – 609
12:00PM	2:00PM	LUNCHEON TABLE TOPICS	Room 6E
SESSIONS			
12:15PM	1:15PM	USPTO Users Meeting	Room 616 – 617
COMMITTEE MEETINGS			
12:15PM	1:15PM	Data Protection Committee – Best Practices Subcommittee	CC* Yakima 1
12:15PM	1:15PM	Data Protection Committee – Education and Awareness Subcommittee	CC* Yakima 1
12:15PM	1:15PM	Data Protection Committee – Enforcement Subcommittee	CC* Skagit 1
12:15PM	1:15PM	Geographical Indications Project Team (Legal Resources)	Room 305
12:15PM	1:15PM	Global Advisory Council – Africa	Room 307
12:15PM	1:15PM	Global Advisory Council – Asia-Pacific	Room 620
12:15PM	1:15PM	Global Advisory Council – Europe	Room 306
12:15PM	1:15PM	Global Advisory Council – Middle East	Room 310
12:15PM	1:00PM	Course on International Trademark Law and Practice Lunch	Room 3B
12:30PM	1:30PM	SPEED NETWORKING	Hall 4EF
1:15PM	3:30PM	Legislation & Regulation Committee – Latin America & Caribbean Subcommittee	Room 306
COMMITTEE MEETINGS			
1:30PM	2:30PM	Trademark Office Practices Committee – Leadership Only	CC* Tahoma 4
1:30PM	2:30PM	2018 Annual Meeting Project Team	Room 303
SESSIONS			
1:30PM	2:45PM	CSU22 Ethical Implications of Unconscious Bias in the Boardroom, Classroom and Courtroom (All Levels)	Room 605 – 607
1:30PM	2:45PM	CSU23 Professor vs. Practitioner Debate: Trademarks in the Cannabis Industry	Room 602 – 604
1:30PM	3:30PM	Japan Patent Office (JPO) Users Meeting: Recent Activities and Quality Management for Trademarks in Japan	Room 616 – 617
COMMITTEE MEETINGS			
1:30PM	3:30PM	Anticounterfeiting Committee – East Asia and Pacific Subcommittee	Room 309
1:30PM	3:30PM	Anticounterfeiting Committee – Latin America and Caribbean Subcommittee	Room 310
1:30PM	3:30PM	Government Officials Training Committee	Room 610
1:30PM	3:30PM	Pro Bono Committee	Room 304
1:30PM	3:30PM	Programming Advisory Council	Room 307
1:30PM	3:30PM	Public Information Committee	CC* Skagit 4
1:45PM	2:15PM	Emerging Issues Committee – Full Committee	Room 608 – 609
2:00PM	3:00PM	SPEED NETWORKING	Hall 4EF
COMMITTEE MEETINGS			
2:30PM	3:30PM	Trademark Office Practices Committee – Full Committee	CC* Tahoma 4
2:45PM	3:15PM	Emerging Issues Committee – Artificial Intelligence Subcommittee	Room 608 – 609
2:45PM	3:15PM	Emerging Issues Committee – Brand Restrictions Subcommittee	Room 608 – 609
2:45PM	3:15PM	Emerging Issues Committee – Country Marks Subcommittee	Room 608 – 609
2:45PM	3:15PM	Emerging Issues Committee – Embargoes and Sanctions Subcommittee	Room 608 – 609
2:45PM	3:15PM	Emerging Issues Committee – New Emerging Issues Identification Subcommittee	Room 608 – 609
2:45PM	3:15PM	Emerging Issues Committee – Territoriality Limitations and Fair Uses of Trademarks Subcommittee	Room 608 – 609
CONCURRENT SESSIONS			
3:00PM	4:15PM	CSU50 Copyright and Trademark: What They Can Learn From Each Other on the Internet Frontier of Trademark Protection	Room 605 – 607
3:00PM	4:15PM	CSU51 Taking Our New Seattle Coffee Pot to the World—Design (Patent) and Trademark Protection for Our New Brewer	Room 602 – 604
COMMITTEE MEETINGS			
3:00PM	4:00PM	Famous and Well-Known Marks Committee – Leadership Only	Room 305
3:30PM	4:00PM	Trademark Office Practices Committee – India IP Office Subcommittee	Room 301
4:00PM	5:00PM	Parallel Imports Committee – Leadership Only	Room 302
SESSIONS			
4:30PM	6:00PM	Opening Ceremony Keynote – Neil Lindsay – Amazon	Room 6AB
6:00PM	8:00PM	Welcome Reception: Building Blocks of Seattle's Brands and Innovation	Hall 4A

* Conference Center



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START	END	NAME	LOCATION*
7:30AM	7:00PM	Registration	Hall 4B
7:30AM	7:00PM	Hospitality	Hall 4C & EF
7:30AM	12:00PM	Mediation Training: Guiding the Parties to and Through an Effective Mediation	Room 615
8:00AM	10:00AM	Continental Breakfast	Hall 4C & EF
		TRAINING SESSIONS	
8:00AM	4:00PM	Course on International Trademark Law and Practice – Day 2	Room 3A
8:30AM	10:00AM	TM5 Users Meeting	Room 616 – 617
		COMMITTEE MEETINGS	
9:00AM	9:30AM	Designs Committee – Full Committee	Room 610
9:00AM	10:00AM	Nominating Committee	Room 601
9:00AM	11:00AM	BREAKFAST TABLE TOPICS	Room 6E
		SESSIONS	
9:00AM	10:30AM	INTA's International IP Court is in Session: Judges from International Jurisdictions Discuss Public Well-Being v. Private Rights— Brand Restrictions from the Perspective of the Judiciary	Room 613 – 614
		COMMITTEE MEETINGS	
9:00AM	11:00AM	Anticounterfeiting Committee – Intermediaries Meeting	Room 309
9:00AM	11:00AM	Anticounterfeiting Committee – EU Observatory Joint Project Team	Room 301
9:00AM	11:00AM	Legislation & Regulation Committee – Canada Subcommittee	Room 302
9:15AM	9:45AM	Copyright Committee – Full Committee	Room 3B
9:30AM	11:00AM	Designs Committee – Design Emerging Issues Subcommittee	Room 306
9:30AM	11:00AM	Designs Committee – International Design Harmonization Subcommittee	Room 620
9:30AM	11:00AM	Designs Committee – Law and Practice Subcommittee	Room 610
		SESSIONS	
9:30AM	2:30PM	In-House Practitioners Workshop and Luncheon: <i>(Advance registration required)</i>	Room 611 – 612
		COMMITTEE MEETINGS	
9:45AM	11:15AM	Copyright Committee – Overlapping Issues between Copyright and Trademark Law Subcommittee	Room 3B
9:45AM	11:15AM	Copyright Committee – Database and Publication Subcommittee	Room 3B
9:45AM	11:15AM	Copyright Committee – Enforcement Subcommittee	Room 304
9:45AM	11:15AM	Copyright Committee – International and Legislative Subcommittee	Room 303
9:45AM	11:15AM	Copyright Committee – Copyright Policy of INTA Subcommittee	Room 308
		SESSIONS	
10:00AM	11:15AM	INTA and QBPC Joint Session on China's New E-Commerce Law: What Does it Mean for Protecting Brands Online?	Room 605 – 607
		COMMITTEE MEETINGS	
10:00AM	11:00AM	INTA Foundation Meeting	Room 601
10:00AM	11:00AM	Madrid Project Team <i>(Legal Resources)</i>	Room 305
		SESSIONS	
10:00AM	11:15AM	CSU01 Working with Intermediaries to Combat the Manufacture and Trade of Counterfeit Goods in Free Trade Zones (FTZ)	Room 602 – 604
10:00AM	11:15AM	CSU02 Does Firm Size Correlate to Success?	Room 6C
10:00PM	4:00PM	Exhibition Hall	Hall 4EF
		COMMITTEE MEETINGS	
10:15AM	12:00PM	Madrid System Users' Meeting (MSUM) Organized by World Intellectual Property Organization (WIPO)	Room 616 – 617
		SESSIONS	
10:45AM	3:00PM	Judge's Workshop: A Discussion with IP Judges on Hot Topics in Trademark Law <i>(Exclusive to IP Judges) "</i>	Room 613 – 614
		COMMITTEE MEETINGS	
11:15AM	12:15PM	Global Advisory Council – China	Room 620
11:15AM	12:15PM	Data Protection Committee – Full Committee	CC* Yakima 1
11:15AM	12:15PM	Emerging Issues Committee – Leadership Only	Room 306
11:15AM	12:15PM	Enforcement Project Team <i>(Legal Resources)</i>	Room 305
11:15AM	1:15PM	Anticounterfeiting Committee – China Subcommittee	Room 309
11:15AM	1:15PM	Anticounterfeiting Committee – United States Subcommittee	Room 304
11:15AM	1:15PM	Global Advisory Committee – Latin America and the Caribbean	Room 308
11:15AM	1:15PM	INTA Bulletins Committee	CC* Skagit 4

Continued overleaf

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