

INTA Bulletin

The Voice of the International Trademark Association

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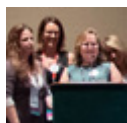
Interviews



Join INTA in Sydney for a Look Beyond Trademarks

INTA's 2018 Asia-Pacific Conference: Looking Beyond Trademarks—Protecting and Leveraging Your Brands for Growth, will be held in Sydney, Australia, October 11–12, and promises to provide unique insight on cutting-edge topics in this important region, according to conference co-chairs Ken Hamilton (Spruson & Ferguson, Australia) and Rebecca Thomas (Forever New Clothing Pty Ltd, Australia).

Association News



Trademark Administrators: Enforcers of IP Rights on Social Media and E-Commerce Platforms

Trademark administrators picked up tips on how to best utilize social media and e-commerce platforms to enforce intellectual property rights from panelists at the Trademark Administrators Brunch, held at the 2018 Annual Meeting in Seattle, Washington, on May 20.

Committee Spotlight: Young Practitioners Committee

INTA's Young Practitioners Committee ensures that INTA is accessible, inclusive, and relevant for those practitioners with five years or less of professional experience in the field of intellectual property.

Africa Update



INTA Briefs Officials from WIPO and the United Nations Conference on Trade and Development

INTA's Representative, Africa and Middle East, Tat-Tienne Louembe, recently held meetings with representatives from the World Intellectual Property Organization (WIPO) and the United Nations Conference on Trade and Development to discuss potential areas for collaboration.

Anticounterfeiting



Association Participates in Anticounterfeiting Events in Asia, Europe, and Latin America

INTA members engaged with intellectual property offices, chambers of commerce, and law enforcement officials in China, Hungary, Thailand, and Uruguay last month about ways to curb counterfeiting.

China Update

INTA Steps Up China Activity in July

The first half of July has been especially busy for INTA in China, and the second half of the month will include a delegation visit with INTA CEO Etienne Sanz de Acedo and INTA Chief Representative Officer, Asia-Pacific and China, Seth Hays, for



additional high-level meetings and events.

Committee Updates



Applications of Blockchain Technology to Trademark Protection, Enforcement, and Practice

The world is talking about blockchain, but how is it relevant for trademarks? A special Task Force of INTA's Emerging Issues Committee explains.

Recent Changes to Canadian Trademarks Act and Prospects for Protection of Traditional Knowledge

INTA's Indigenous Rights Committee reports on the effects of upcoming changes to Canada's Trademarks Act on the protection of traditional knowledge.

Europe Update



Next Steps for European Union Data Protection and Global Enforcement

Amid the big-ticket issues of Brexit and the European Union General Data Protection Regulation, INTA's Europe Office has recently been participating in discussions on local issues in Italy, as well as hot topics like blockchain solutions to anticounterfeiting, online counterfeiting, and EU design protection.

India Update



Indian Dignitaries Attend INTA's 140th Annual Meeting

From participation at the Annual Meeting to awards for Indian members, INTA's activity in India has been strong over the last few months.

Latin America Update



Roundtable Report: INTA Members Present Latin America Economic Impact Study in Venezuela

A roundtable held in May in Caracas, Venezuela, highlighted the positive impact of intellectual property protection to struggling economies, as highlighted by INTA's 2016 impact study, "Trademarks in Latin America: A study of their economic impact in five countries in the region (Chile, Colombia, Mexico, Panama, and Peru)."

Features

Understanding False Endorsement and Right of Publicity Claims in a Digital Age

As social media proliferates, state right of publicity and Lanham Act false endorsement claims are increasing. Brand owners need to understand which approach might be more effective when involved in a dispute.

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DOMINICAN REPUBLIC: Crocs, Inc.'s 3D Registration Annulled

EUROPEAN UNION: Court of Justice of the European Union Rules that Louboutin's Red Sole Is a Valid Trademark

LAOS: Opposition Procedures Now Available, Term of Protection Amended

SOUTH KOREA: Revised Unfair Competition Prevention Act Specifies Protection of Trade Dress and Business Ideas

UNITED ARAB EMIRATES: Launch of Online Trademark Register Searches

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Join INTA in Sydney for a Look Beyond Trademarks

To address some of the many issues facing brands in Asia-Pacific and beyond, INTA will host its **2018 Asia-Pacific Conference: Looking Beyond Trademarks—Protecting and Leveraging Your Brands for Growth**, in Sydney, Australia, October 11–12. This is the first time the Association is returning to Sydney in 10 years and will offer members in the region a convenient venue in which to gain insight on some key issues, according to conference co-chairs Ken Hamilton (Spruson & Ferguson, Australia) and Rebecca Thomas (Forever New Clothing Pty Ltd, Australia).



Ken Hamilton

Ken Hamilton is a Principal/Trade Mark Attorney at Spruson & Ferguson (Australia). He has more than 25 years of experience in IP and is co-chair of the 2018 Asia-Pacific Conference Project Team.

In line with the growing importance of this region to INTA members and brand owners everywhere, last year, INTA organized 34 events in Asia-Pacific—an increase of 143 percent over 2016 activity. The Association also nearly doubled its engagements with governments in the region in 2017 through policy dialogues, submissions, delegations, and face-to-face meetings; participated in 25 third-party events around the region; held an Anticounterfeiting Conference in Hong Kong; published an **INTA Impact Study** that found trademark-intensive industries generate between 27 and 60 percent of exports in each of Indonesia, Malaysia, the Philippines, Singapore, and Thailand alone; and, just this year, launched its first Asia-Pacific Moot Court Competition in Singapore.

Mr. Hamilton and Ms. Thomas spoke with the *INTA Bulletin* about how the 2018 Asia-Pacific Conference will continue to expand upon INTA's growth in the region and what registrants can expect from the two-day program.

What will be unique about this conference compared to others?

Rebecca Thomas (RT): From my perspective, being an in-house lawyer can sometimes be a little bit insular, so this is a great opportunity to meet a whole new raft of people. To me, the chance to be involved with it was too good to pass up.

It was especially exciting to craft a conference that would appeal to in-house lawyers in particular. It's been 10 years since INTA had its last conference in Australia, so it's well overdue; Australians are always traveling far and wide to attend conferences, so it's time that everyone comes here. The opportunity to have an Asia-Pacific focus is also unique. A lot of Australian conferences have an Australian focus only, and in-house lawyers like me don't always have the time or the budget to go overseas.

Ken Hamilton (KH): We don't have the chance to get a lot of input from our other neighbors in the region usually, so with this conference we've been able to get a really good mix of people who will cover a wide range of topics we don't normally deal with in terms of our usual education as trademark practitioners. More and more, we're being asked to give advice on topics that go "beyond trademarks."

What does "Looking Beyond Trademarks" mean exactly?

KH: In the world we live in—for both in-house and private practitioners—there are a lot of questions beyond simply, "What is

your trademark?” Today, the questions include: “What is your product?”; “What is your brand?”; and “How is it affected from the outside by issues such as brand restrictions, corporate identity, corporate social responsibility, and corporate culture?” These are big issues. It’s an opportunity for us to explore these issues in more depth and to be best prepared for the challenges ahead.

RT: I used to work for the global brand, Robert Bosch, and I saw firsthand the importance of the brand and the level of trust people placed in it. Brand protection is absolutely crucial in this day and age. There are a number of companies today whose IP and brands are worth more than their tangible assets. This conference is of relevance to every business today.



Rebecca Thomas

Rebecca Thomas is General Counsel and Assistant Company Secretary at Forever New Clothing Pty Ltd. She has worked as Corporate Counsel at Visy Industries, Senior Legal Counsel at Robert Bosch, and Company Solicitor and Assistant Company Secretary at Just Group.

Brand protection is absolutely crucial in this day and age. There are a number of companies today whose IP and brands are worth more than their tangible assets.

—Rebecca Thomas

What topics in particular do you think will be of most interest?

RT: I’m really interested in Session 4—Bringing Your Business Online: The View from China. I think that will be of interest to everyone. More and more businesses are looking to break into China or establish a foothold there, so this is a great way to get some firsthand insight into how to do it and how to protect your trademarks and brands at the same time.

KH: This will be one of the first conferences where we will have had some time to see the real impact of the changes imposed by the European Union’s General Data Protection Regulation and to have people in a position to speak from their experiences as to whether it’s had an effect on strategies. It will be a very hot topic that will be addressed in a number of the sessions.

What is your hope overall for those who attend?

KH: I’d like them to walk away thinking they’ve learned something, that they’ve expanded their experience, and made some good, valuable, and lasting contacts. In my experience, every time I’ve attended an INTA conference, I’ve always come away feeling like I’ve made some really good contacts that will help me in my career moving forward.

RT: I hope people who attend can come away with some really great ideas and suggestions to take back to their business about how they can help it to continue to grow, which I think is really important. It also has to be said that this is a great opportunity to get continuing professional development points, which we all need. The caliber and diversity of speakers that we have planned is going to be quite unique—they won’t be just lawyers, and they’re not only from Australia: there will be speakers who are experts in their field from across the region. I really encourage in-house lawyers, in particular, to come along and contribute.

To register for INTA’s 2018 Asia-Pacific Conference: Looking Beyond Trademarks—Protecting and Leveraging Your Brands for Growth, visit the [conference homepage](#).

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Every time I’ve attended an INTA conference, I’ve always come away feeling like I’ve made some really good contacts that will help me in my career moving forward.

—Ken Hamilton

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Trademark Administrators: Enforcers of IP Rights on Social Media and E-Commerce Platforms

Rosa Jimenez, Wyndham Destinations, Inc., Orlando, Florida, USA

The Trademark Administrators Committee welcomed 185 attendees on May 20 to the annual Trademark Administrators Brunch during the 2018 INTA Annual Meeting in Seattle, Washington. A diverse group of in-house and law firm intellectual property (IP) professionals enjoyed an informative and valuable event where panelists shared useful insights and tips on how to best utilize social media and e-commerce platforms to enforce IP rights.



Left to Right: Trademark Administrators Committee Chair (Deborah Brincat, Procter & Gamble France SAS, France), Vice Chair (Jayne Durden, CPA Global, USA), and members of the Networking, Outreach and Trademark Administrators Brunch Subcommittee welcome the Trademark Administrators Brunch panelists.

Takedown Methods

Social media and e-commerce platforms provide policies and takedown mechanisms for brand owners to use that are straightforward and easy to use. In addition to online social media or e-commerce takedowns, brand owners may opt to send a cease and desist (C&D) or a demand letter. Even though C&D letters take more time and effort, and there is possibly the added expense of outside counsel, they give you the ability to tell your story a little bit better; you can customize them, add exhibits, and fill in the gaps that otherwise would be left out when using the online takedown requests provided by the platforms. Whether to bring a lawsuit will depend on the circumstances of the situation, including the danger of the infringement.

Approaching Online Takedown Requests

Not all platforms are created equal. Whether you are dealing with commercial or social platforms, or entertainment or news platforms, understanding them will help you strategize enforcement efforts. Think revenue, for example. If it's a popular product, an e-commerce platform may push back. What about popular content? If a social media platform takes it down, users will most likely move to another platform. Another factor to consider is legal liability. If the platform fears legal

liability, it may react differently to the takedown request.

Taking a collaborative approach to takedowns can also yield results. Platform owners are not necessarily the bad guys. Platform owners are also IP owners! They understand IP. Trying to establish a contact and developing a relationship with the platform may help to achieve your goal.

Develop a Targeted Strategy

The approach to online trademark infringement will depend on the type of infringement. Do you go after everything or only the most egregious violations? Some brand owners take a balanced approach to enforcement efforts and are not too overreaching. But what happens when trademark teams don't have a lot of resources? Do you outsource? Having a strategy in place and managing this strategy based on your resources will translate into a proactive approach. Developing a big-picture enforcement strategy will help target your efforts to support your business.

These four principles will help you develop a strategy when considering a takedown request:

1. Impact on revenue;
2. Your business's ability to market;
3. Protection of your brand, your brand's reputation, and its value;
4. Protection of consumers against any harm.

Brand prioritization is a fantastic tool when designing a strategy—think top-tier brands, followed by products and services, and then other initiatives.

Many brand owners want to make sure they are not overreaching. For example, taking down fan accounts may have a negative impact; taking down bloggers may trigger public relations issues; and there's a risk of taking down the brand owner's own legitimate accounts.

The bottom line for brand owners and platforms alike is to protect consumers against fraud and counterfeit or faulty products.

To learn more about this and many other relevant topics, please join the **2018 Trademark Administrations and Practitioners (TMAP) Meeting in Orlando, Florida**, September 12–14, 2018.

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Committee Spotlight: Young Practitioners Committee

Nina O'Sullivan, Mishcon de Reya LLP, London, United Kingdom
INTA Bulletins—Association News Subcommittee

The mission of the Young Practitioners Committee is to ensure that INTA is accessible, inclusive, and relevant for Young Practitioners (YPs), defined as those practitioners with five years or less of professional experience in the field of intellectual property (IP). The committee strives to inform YPs about INTA, enables them to make better use of INTA resources, and encourages greater engagement in a wide range of international YP and general Association events. In doing so, it aids INTA's mission of being a global Association, and fosters the interests of practitioners in INTA from an early stage in their careers.

Despite the focus of the committee, those whose young practitioner days are behind them can still play a central role in its continued success. In particular, they can promote YP events (both within their own firms and in their geographical regions, e.g., through social media), and can encourage general engagement by their junior colleagues in INTA events. Many YPs are, of course, unable to attend the Annual Meeting, and they may also not be on INTA's mailing lists for email blasts. Member firms therefore have a crucial role to play in ensuring that information about YP events and other initiatives is disseminated to those who will benefit from it.

The co-chairs of the YP Committee are Jan Gerd Mietzel (Rolim, Mietzel, Wolnick & Calheiros LLP, Germany) and Mat Brechtel (Norton Rose Fulbright Canada LLP, Canada) and the YP Committee includes four subcommittees:

- **Awards and Fellowship:** Jason Champion (Knobbe Martens, Olson & Bear, USA) and Nerissa McGinn (Loeb & Loeb LLP, USA) serve as co-chairs.
- **Programming:** Michelle Ciotola (Cantor Colburn LLP, USA) and Katherine Nye (Neal, Gerber & Eisenberg LLP, USA) serve as co-chairs.
- **Outreach:** Cliff Kuehn (Kuehn Law, USA) and Dima Naber (Abu-Ghazaleh Intellectual Property, Jordan) serve as co-chairs.
- **Events:** Carolina Calheiros (Rolim, Mietzel, Wolnick & Calheiros LLP, Germany) and Neda Lajevardi (Lott & Fischer, USA) serve as co-chairs.

Key initiatives of the YP Committee for the current INTA committee term include:

- **Tomorrow's Leader Award:** The first two award winners of the Tomorrow's Leader Award were announced at the 2017 Leadership Meeting in Washington, D.C., with applications for this year's awards opening on June 22, 2018, and closing on August 15, 2018. Winners of the award receive complimentary admittance to the Annual Meeting and Leadership Meeting and have the opportunity to serve on an INTA committee. To be eligible for the award, individuals must be a YP (i.e., with less than five years' experience in IP), have so far not participated in an Annual Meeting or Leadership Meeting, and demonstrate early leadership merits in the IP profession. The committee asks that all INTA member firms encourage their YPs who demonstrate leadership qualities to consider applying.
- **YP–Trademark Reporter Program:** A group of selected YPs will be paired with senior writers on *The Trademark Reporter* (TMR) Committee with the aim of creating young practitioner–led submissions for the TMR.
- **YP web video series:** The Outreach Subcommittee is continuing to produce a series of short web videos which focus on content relevant to YPs.
- **YP events:** As well as planning YP-related content for the 2019 Annual Meeting (including the popular First Time Registration Orientation and Reception, as well as a Table Topic), there are a series of YP events planned in the coming

months, including:

- o **The Nordic Event:** Now in its fourth year, the Nordic Event will be held in Oslo, Norway, on September 28, 2018.
- o **An event in Madrid:** This is scheduled for October 25, 2018.
- o **The Middle East:** The first YP event in the Middle East will take place in Dubai, United Arab Emirates (December 9, 2018), and will precede the 2018 Middle East and Africa Conference: Innovation, Investment, and IP, being held there December 10–11, 2018.

YP events are open to all YPs, even if their firm is not an INTA member organization. Member firms can also assist the committee's work by offering to co-host YP events in their regions.

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INTA Briefs Officials from WIPO and the United Nations Conference on Trade and Development

In late June, INTA's Representative, Africa and Middle East, Tat-Tienne Louembe, held meetings with officials at the World Intellectual Property Organization (WIPO) and the United Nations Conference on Trade and Development (UNCTAD).

Mr. Louembe shared INTA's latest activities in Africa—including INTA CEO Etienne Sanz de Acedo's recent visit to Kenya, the Association's analyses of various IP strategies and laws, and briefings of government officials and private sector representatives—with WIPO's Regional Bureau for Africa. Mr. Louembe also updated WIPO on the participation of delegates from Ghana, Kenya, and Uganda at INTA's 140th Annual Meeting in Seattle, Washington, in May.

Mr. Louembe also held discussions with senior officials of the Regional Bureau for the Arab Countries of WIPO regarding potential joint activities and INTA's upcoming Middle East and Africa Conference: Innovation, Investment, and IP, which will be held in Dubai, United Arab Emirates, on December 10 and 11. The two-day conference for trademark owners and legal professionals will focus on the opportunities and challenges of attracting investment to the regions, how innovation is re-shaping the economy, and the importance of a robust IP strategy for effective protection and enforcement in these regions.

At UNCTAD, Mr. Louembe met with Patrick Osakwe, Deputy Director, Africa and Least Developed Countries Division. Among other topics, Mr. Louembe and Mr. Osakwe agreed to look into the nexus between illicit trade and trademarks in selected jurisdictions.

UNCTAD is a permanent intergovernmental body established by the United Nations (UN) General Assembly in 1964. While UNCTAD works mainly with governments, to effectively deal with the magnitude and complexity of meeting the Sustainable Development Goals, the UN body is gradually opening up to the private sector and civil society.

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Association Participates in Anticounterfeiting Events in Asia, Europe, and Latin America

From Bangkok to Budapest, INTA members and staff recently have been actively engaged in anticounterfeiting efforts around the globe.

USPTO Judicial Colloquium in Bangkok

From June 20 to 22, INTA Board Member Kowit Somwaiya (LawPlus, Ltd., Thailand) participated in the Judicial Colloquium on Civil and Criminal IP Infringement Cases, organized by the U.S. Patent and Trademark Office (USPTO) and the ASEAN Secretariat. Mr. Somwaiya participated on behalf of the Association and spoke on a panel titled “Challenges for Consumers and Rights Holders in the Global and Online Environment,” along with Michael Schlesinger (Motion Picture Association, Singapore), Say Sujintaya (Baker & McKenzie, Bangkok), and moderator Peter Fowler, Senior Counsel at the USPTO.

Mr. Somwaiya spoke about the challenges facing brand owners in the realm of anticounterfeiting due to the growth of the Internet and what INTA is doing through the Anticounterfeiting Committee to address them. Mr. Somwaiya also spoke about the Unreal Campaign and the importance of educating consumers on the harms of counterfeit products in order to decrease demand for counterfeit goods.

Justice Suvicha Nagavajra, Chief Justice, Central Intellectual Property and International Trade Court (Bangkok) delivered the opening remarks. Other notable speakers included Judge Victoria Roberts of the U.S. District Court for the Eastern District of Michigan, Judge Derrick Watson of the U.S. District Court for the District of Hawaii, and Evan Williams, Regional Intellectual Property Law Enforcement Coordinator-Asia, of the U.S. Department of Justice.

Forum on Intellectual Property in Uruguay

On June 22, INTA participated in a forum on the Economic Impact on Intellectual Property, jointly organized by INTA; the National Directorate of Industrial Property Ministry of Industry, Energy and Mining of Uruguay (MIEM-DNPI); and the Inter-American Association of Intellectual Property (ASIPI). The forum was a continuation of the discussions that took place at the IPO Enforcement Seminar, held by INTA in partnership with MIEM-DNPI, ASIPI, and the International Chamber of Commerce—Business Action to Stop Counterfeiting and Piracy in Montevideo on April 19 and 20.

Participants included representatives from the Presidency of the Republic, Ministry of the Interior, National Customs, the Uruguayan Association of Industrial Property Agents, civil and criminal judges, and representatives from the Departmental Government-Municipality of Montevideo. INTA was represented by Virginia Cervieri (Cervieri Monsuarez & Asociados, Uruguay), chair of INTA's Anticounterfeiting Committee.



Participants discuss the importance of trademarks at the joint forum on the Economic Impact on Intellectual Property, organized by INTA, the National Directorate of Industrial Property Ministry of Industry, Energy and Mining of Uruguay (MIEM-DNPI), and the Inter-American Association of Intellectual Property (ASIPI).

Opening remarks for the forum were provided by Dr. Marianela Delor, Director of the National Directorate of Industrial Property.

Following the opening remarks, participants discussed conclusions from the IPO Enforcement Seminar and how stakeholders can collaborate to combat counterfeiting.

Europol IPC3 Stakeholders Advisory Group and Conference

On June 25, INTA CEO Etienne Sanz de Acedo and Anticounterfeiting Manager Maysa Razavi attended Europol's Second Intellectual Property Crime Coordinated Collation (IPC3) Stakeholder's Advisory Group. As reported in the **2016 INTA Bulletin interview** with IPC3 Cluster Manager Chris Vansteenkiste, IPC3 is the intellectual property crime unit of the European Police Office (Europol). The unit has a staff of 18 and is working in partnership with the EUIPO to expand its efforts to fight IP crime—particularly with respect to Internet-related IP crimes. INTA is a member of the Steering Committee of the Stakeholder's Advisory Group.

Following the meeting, Europol hosted its Intellectual Property Crime Conference on June 26 in Budapest, Hungary. Ms. Razavi represented INTA at the conference and held several side meetings with officials in attendance. The event was also an opportunity to meet with the new Executive Director of Europol, Catherine De Bolle, who took office in May.

For more information on the customs trainings or on INTA's anticounterfeiting activities, please contact INTA Anticounterfeiting Manager, Maysa Razavi at mravazi@inta.org or Anticounterfeiting, Senior Coordinator, Tiffany Pho, at tpho@inta.org.

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INTA Steps Up China Activity in July

The month of July has included a strong focus on activities and meetings in China for INTA. INTA staff and members participated in a number of initiatives that took place in the first half of the month, and are gearing up for more in the second half.



Panelists at the Global Trade Development Week Anti-Illicit Trade & Brand Protection Workshop in Shanghai, China. From left to right: Yu Bo (SIPS, China); Michael Morantz, Senior Policy Analyst, Task Force on Countering Illicit Trade, Directorate for Public Governance, OECD; Xiaobing Tang, Counsellor, Market Access Division, World Trade Organization; and Daoming Zhang, Assistant Director, Illicit Markets & Organized and Emerging Crime, INTERPOL.

Global Trade Development Week and 2018 China Forum on Criminal IP Protection

INTA was invited to participate in Global Trade Development Week (GTDW), China's first major e-trade and trade facilitation summit, which took place July 2–4 in Shanghai, China. As the world's largest trade facilitation event, GTDW featured a series of specialized trade summits linking key sectors across international trade, such as brand owners and businesses, customs, infrastructures, special free-trade zones, supply chain logistics and transports, and small and medium-sized enterprises. The three-day summit included speakers from various organizations discussing the role of governments and cooperation with the private sector, and the "One Belt, One Road" initiatives, including challenges, collaboration, and strategic partnership.

Valentina Salmoiraghi, INTA's Anticounterfeiting Advisor, Asia-Pacific, spoke at the summit about INTA's advocacy efforts and Strategic Plan in relation to anticounterfeiting, including efforts and initiatives on e-commerce and border issues, best practices for addressing the sale of counterfeits on the Internet, best practices for lessening risks to goods in transit, and developments in border

measures. On July 4, the summit ended with the Anti-Illicit Trade & Brand Protection Workshop, which focused on collective actions to fight illicit trade, cross-industry best practices, transformative technologies, and public and private sector partnerships for anti-illicit trade and market integrity.

INTA member and representative of INTA's Anticounterfeiting—China Subcommittee, Yu Bo (SIPS, China), participated in a panel discussion concerning collective actions to fight illicit trade and promote market integrity across regions. Mr. Yu stressed the importance of information-sharing among anticounterfeiting players and intra- and intergovernmental cooperation.

Following the GTDW, from July 11-13, INTA was invited to join the 2018 China Forum on Criminal IP Protection in Suzhou, China, organized by the Quality Brands Protection Committee of the China Association of Enterprises with Foreign Investment (QBPC) and supported by IP Key China, a program directed by the European Commission and implemented by the European Union Intellectual Property Office (EUIPO) to facilitate market access, increase transparency, and improve the implementation of intellectual property protection and IP enforcement systems. The Forum focused on new trends in criminal IP protection in China, data protection and IP protection, social cooperation and governance on IP protection, and China–European Union Collaboration on IP protection and enforcement. Valentina Salmoiraghi, INTA's Anticounterfeiting Advisor, Asia-Pacific, participated in a panel discussion and shared INTA's advocacy efforts and achievements in relation to cooperation between the private and public sectors and initiatives in relation to combating counterfeits in China and globally.

Delegation Visit

From July 16 to 18, INTA CEO, Etienne Sanz de Acedo, will visit Beijing with Seth Hays, INTA's Chief Representative Officer, Asia-Pacific and China, to meet with relevant local authorities, to discuss trademark protection and enforcement in the country, and to strengthen cooperation. The visit will include various meetings and also events involving INTA's members based in China. INTA will meet with the State Intellectual Property Office (SIPO) to discuss the new restructuring plan and new competencies of the office after the trademark reforms become effective. These reforms will make SIPO responsible for registration and protection of trademarks.

The delegation's visit will continue with meetings with the Beijing IP Court, China customs, and the Ministry of Public Security (MPS)--the main Chinese authorities in charge of trademark enforcement in the country. INTA will also engage the China Trademark Association (CTA), a national community association with the mission to implement trademark strategies and promote national brands. INTA's delegation will also host a lunch to meet with the IP community in Beijing, including IP attachés, INTA members, and various stakeholders, and will also host an INTA - Beijing Justa Intellectual Property Center lecture, titled "The Future of Trademarks" on July 18 to conclude the visit.

All of these initiatives contribute to the Association's continuous efforts to reinforce INTA's role as a leading advocate for the interests of brand owners, to foster effective trademark laws and policies worldwide, and to harmonize their implementation in China.

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Valentina Salmoiraghi, INTA's Anticounterfeiting Advisor, Asia-Pacific, speaks at the Global Trade Development Week Summit in Shanghai, China.

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Applications of Blockchain Technology to Trademark Protection, Enforcement, and Practice

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INTA Emerging Issues—New Emerging Issues Subcommittee

Blockchain Task Force

The Blockchain Task Force of the Emerging Issues—New Emerging Issues Subcommittee was recently charged with examining the potential relevance of blockchain technology in trademark practice. One member of the Task Force, Bennett Collen (Cognate, USA), had already begun exploring this question in depth through his company, which seeks to leverage blockchain technology to provide trademark owners with a secure means of documenting proof of first and continuous use. From there, the Task Force sought other potential avenues of utilizing the technology, and through research regarding the development of microcomputers, recognized the potential of utilizing blockchain technology in anticounterfeiting efforts. This article provides a brief introduction to blockchain technology, and summarizes the Task Force's conclusions regarding these two potential avenues for use of that technology by trademark owners and practitioners.

A hacker would have to control more than half the network's computing capacity to change any record in a given block.

What Is Blockchain?

A blockchain is a decentralized digital ledger of transactions that combines powerful cryptography algorithms with a system of decentralized computing power. In other words, instead of having a single party keep a record of all of the transactions that happen within a given system, a blockchain shares the task of recording those transactions among the people making them, and the underlying technology verifies that all users are keeping matching records.

This causes a blockchain ledger, and all transactions recorded within it, to be public, timestamped, and tamper proof. A hacker would have to control more than half the network's computing capacity to change any record in a given block, and because blockchain records are comprehensive (i.e., they contain a record of every transaction that has happened in the history of that

particular blockchain), the more records added to a blockchain ledger, the more secure it becomes.

The technology came to prominence as the backbone to cryptocurrencies such as Bitcoin and Ether, but has expanded beyond cryptocurrencies into other more tangible applications.

How Will Blockchain Affect Trademarks?

The Blockchain Task Force has found that there seem to be at least two immediately applicable uses for the technology (as well as many more potential future uses). The two immediately applicable use cases are:

1. Creating blockchain-based records as a more secure and trustworthy recordkeeping system to prove trademark use; and
2. Proving the provenance and legitimacy of goods in anticounterfeiting efforts.

Benefits of Blockchain-Based Records

- There is unequivocal evidence of use in case of infringement.
- Immutable timestamps associated with proof of first use, filing date, registration date, etc.—timestamps cannot be altered by any party—remove any question as to source/veracity/time of specimen creation and lock in a highly credible date on which that information was captured.
- Use of registered and unregistered trademarks can be recorded on the same distributed ledger, creating a comprehensive picture of all trademarks in use and the extent of use in a particular jurisdiction.
- Records can be made for trademark use in any jurisdiction.
- Blockchain can be used to build comprehensive, unequivocal timelines of trademark use and rights.
- Records are quick to obtain and always accessible (they cannot be destroyed).
- They save time and money in discovery.
- May lessen the number of issues an infringer or other party will be able to challenge regarding use documentation because blockchain is secure and immune to alteration.
- A blockchain protocol can ensure that all relevant data has been recorded, eliminating the incomplete recordkeeping that plagues many informal, or even formal, recordkeeping systems.
- Assignments, chain of ownership, and sales of trademark rights are more secure.
- “Smart contracts” (which are not contracts per se, but self-enforcing computer code that exists on a blockchain ledger) can be used to transact with blockchain.
- Evidence of rights in Uniform Domain-Name Dispute-Resolution (UDRP) Policy and other domain name–related disputes (possibility to redesign the WHOIS system to be compliant with the European Union’s General Data Protection Regulation (GDPR)) are more readily available.

Blockchain can be used to build comprehensive, unequivocal timelines of trademark use and rights.

Benefits for Anticounterfeiting Efforts

- If used in conjunction with other technologies, such as radio-frequency Identification (RFID) chips, near-field communication (NFC) chips, QR codes (Quick Response Codes), or microcomputers, legitimacy and provenance of goods can be tracked via blockchain by consumers or customs agents.
- Facilitates supply chain coordination between manufacturers, shippers, middlemen, and delivery, ensuring only legitimate goods enter the supply chain and are delivered to consumers.
- Customs authorities would reference supply chain blockchain to validate legitimate goods or identify counterfeit goods.

Significant efforts are already underway to use blockchain for both of the use cases stated above. For example, the European Union Intellectual Property Office (EUIPO) recently hosted a “Blockathon” (blockchain + hackathon) “to explore how blockchain technology can actually make a difference and lead to a better society,” specifically with an eye towards creating “the next level of anti-counterfeiting infrastructure, by working directly with manufacturers, logistics companies, customs, retailers and consumers.” The EUIPO handed out over EUR 100,000 in prizes to the winning teams, with the goal of having working prototypes within 100 days.

Although the Task Force identified two immediately applicable uses of blockchain in the trademark field (1. as a secure recordkeeping system to prove trademark use; and 2. To prove the provenance and legitimacy of goods in anticounterfeiting efforts), other potential uses cannot be discarded.

Because blockchain is, by nature, a timestamped, tamperproof, and self-enforcing technology, it can help to solve many trademark issues, such as bringing legitimacy to the filing of specimens for goods with patent and trademark offices around the world. The Task Force plans to join forces with the subcommittee studying specimen legitimacy across jurisdictions to explore whether applicability of blockchain can also be of aid in this matter. Other uses might also involve registration of certifications marks or collective marks. The endless advantages of blockchain may indeed trigger exploration of its applicability in other IP areas, such as copyright, patents, and design rights.

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Recent Changes to Canadian Trademarks Act and Prospects for Protection of Traditional Knowledge

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Indigenous Rights Committee

Fundamental changes to the Canadian Trademarks Act were passed on June 19, 2014, by way of an omnibus budget bill. These changes will come into force on a date to be determined, possibly in early 2019. The necessary update of the Trademarks Regulations and various practice directions is well underway as part of the implementation of the Madrid Protocol, Singapore Treaty, and Nice Agreement contemplated by the changes to the Act.

Protecting Traditional Knowledge

So what does all of this mean for the protection of traditional knowledge (TK) in Canada? Trademark law provides protection for distinctive marks that have been used or are intended to be used in the marketplace. The use of a mark commercially is contrary to the belief of some indigenous communities that do not want their ceremonial symbols, designs, and words used for profit. However, other indigenous businesses and organizations in Canada do have registered or protected marks.

Indigenous indicia may qualify for protection as “official marks,” which excuse the requirement for commercial use in association with specific goods and services. For example, the Osoyoos Indian Band Council of British Columbia has sought protection of the word “Inkameep” as an official mark. Currently, the official marks regime of the Canadian Trademarks Act does not specifically include the symbols and designs of indigenous peoples. Certification marks, another form of trademark, are also used to identify indigenous works. A certification mark has been registered in Canada for Cowichan sweaters (“Genuine Cowichan Approved”). A downside of certification marks is that technically they cannot be used by their owners, but rather they can be used only by those who have been approved or licensed by the owners.

This change potentially opens the way for indigenous communities to commercialize and protect many indicia, symbols, or signs for the benefit of their communities.

New Definitions

Both of these avenues remain open to “qualified” indigenous groups to pursue. What will be changed are the more expansive definitions of a trademark and a person. A trademark will be defined as essentially a “sign or combination of signs,” while a “sign” will include (but not necessarily be limited to) a color, a figurative element, or a 3D shape, among other things. This is intended to provide protection for many forms of “nontraditional” marks previously unregistrable under the current Trade-marks Act and Regulations. Further, a “person” will include two or more persons who, by agreement, have the right in Canada to use the mark but only on behalf of both or all of them. In other words, the concept of joint applicants will extend beyond partnerships and joint ventures presently entitled to register trademarks in Canada. This change potentially opens the way for indigenous communities to commercialize and protect many indicia, symbols, or signs for the benefit of their communities.

The Road Ahead

Is there anything on the horizon for greater protection of TK under Canada's Trademarks Act? The Act currently does not contain a specific prohibition against any word or device which causes offense to indigenous groups but rather it contains a general prohibition against the registration of "any scandalous, obscene or immoral word or device." This prohibition could be expanded or supplemented to provide greater protection for indigenous groups and their TK. As presently worded, it is unclear whether the prohibition could be used successfully to oppose an application for a mark which causes offense, but it would be interesting to watch the progress of such an opposition.

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Next Steps for European Union Data Protection and Global Enforcement

The May 25 deadline for the implementation of the European Union General Data Protection Regulation (GDPR) has come and gone. Since then, brand owners and IP professionals are struggling with restricted WHOIS data access in light of fallout from the GDPR. To support them, the WHOIS/RDS Subcommittee of INTA's Internet Committee has prepared a helpful **Toolkit for IP Professionals** which "suggests ways to meet [IP] enforcement challenges in a landscape where most WHOIS registrant data is redacted" and provides "tips to assist with investigation of IP infringement, identification of the registrant, and enforcement of rights."

Moreover, INTA wants to hear from its members how these new policies are affecting them. INTA set up a dedicated mailbox at WHOISchallenges@inta.org for members to share their stories and solutions and to report any problems obtaining a registrant's information from registrars or registries.

Christian Archambeau Recommended as Next EUIPO Executive Director

On July 13, the Committee of Permanent Representatives in the European Union (COREPER) voted to recommend that the Council of the European Union appoint Christian Archambeau as Executive Director of the European Union Intellectual Property Office (EUIPO). The appointment is expected to be formalized in an upcoming Council meeting. Mr. Archambeau, current Acting Executive Director of the EUIPO, will succeed António Campinos, who began his five-year term as President of the European Patent Office (EPO) on July 1, 2018.

Christian Archambeau has a long record of experience in intellectual property and with the EUIPO, having joined the Office, which, at the time, was still known as the Office for Harmonization in the Internal Market (OHIM), as its Vice President in 2010. Before joining the organization, Mr. Archambeau served as Principal Director of Human Resources at the EPO, where he worked since 2002.

INTA strongly encourages members to use this address to report issues and help INTA better refine its advocacy strategy based on concrete and practical examples.

Brexit: Uncertainty over UK Position in Negotiations Following Unexpected Resignations Within the UK Cabinet

Brexit—another hot topic in Brussels—has recently seen concerning developments. On the one hand, the sky seemed to be clearing for Prime Minister Theresa May on the UK national stage with the adoption of the EU Withdrawal Act by the UK Parliament on June 26. This Act enables EU law to be transferred into UK law in order to ensure a smooth break from the EU. While several Members of Parliament, including within the Tory majority, successfully pushed for Parliament to have a final say (a "meaningful vote") on the Brexit agreement, their amendment was ultimately defeated and Ms. May managed to keep her government authority untouched. While this victory seemed to have provided Ms. May with unconstrained powers to further negotiate with the EU side, the unexpected resignation of Brexit Minister David Davis—as he believes the current status leaves the UK "in a weak position" with regard to negotiations—followed by the resignation of pro-Brexit Foreign Secretary Boris Johnson on July 9, came as a shock. These resignations strengthen the divide within Ms. May's government and puts its future in jeopardy, as snap elections appear more and more likely.

On the other hand, clouds are still looming regarding the UK position on the Brexit agreement and post-Brexit relationship with the EU. While many hoped the June 28–29 EU Summit would offer at least some breakthroughs, even though the meeting was overshadowed by the

INTA congratulates Mr. Archambeau on this achievement and looks forward to continuing its close and cooperative relationship with the EUIPO under his leadership.

migration crisis, these hopes were ultimately shattered: EU27 leaders are expecting Ms. May to produce a concrete set of proposals on what she expects from the Brexit agreement on several issues (notably, the “future relationship” and the Republic of Ireland-Northern Ireland border). As President of the Council of the European Union, Donald Tusk stressed, “there is a great deal of work ahead, and the most difficult tasks are still unresolved. If we want to reach a deal in October we need quick progress. This is the last call to lay the cards on the table.”

INTA continues to monitor the situation. After publishing its position paper in November 2017, and holding several meetings with the EU and UK authorities, respectively, the Association is now focused on further developing its position on certain issues (notably, exhaustion of rights and international registration).

For the latest updates and more on Brexit, including INTA's Brands Brexit Toolkit, visit INTA's dedicated webpage.

EU Blockathon: First Event Dedicated to How Blockchain Technology Can Help Fight Counterfeiting

In the heart of Brussels, INTA Europe Office Chief Representative Officer H el ene Nicora and Policy Officer Hadrien Valemb ois attended the EU Commission and EU Observatory's first-ever EU Blockathon: a competition among 11 teams, from June 22 to 25, to propose a blockchain-based system and solutions to fight counterfeiting. The teams competing were working directly with manufacturers, logistics companies, customs, retailers, and consumers.

During the opening ceremony, the EU Commission's DG GROW Director-General, Lowri Evans stressed that blockchain specialists need to develop systems to authenticate products and that customs officers need to have real time means to detect counterfeits entering the supply chain in order to help the IP rights holders protect their legitimate assets. On his end, EUIPO Deputy Executive Director Christian Archambeau reminded attendees that while there is a vast demand for IP rights protection for new innovative sectors such as artificial intelligence, robotics, 3D printing, and blockchain, “counterfeiting is a plague and is on the increase. During the closing ceremony, the EU Commission's Vice-President in charge of the Digital Single Market, Andrus Ansip, highlighted that one of the Commission's roles is “to protect creators” as well as consumers, adding that there is a need to “focus much more attention to IPRs.”

The event was also marked by the signing of a Memorandum of Understanding (MOU) on Online Advertising and Intellectual Property Rights.

This voluntary agreement, under the aegis of the European Commission, was signed by approximately 20–30 representatives of the advertising industry, advertisers, rights holders, and technology providers. All signatories have committed to minimize the placement of advertising on websites and mobile applications, which are known to infringe copyright or disseminate counterfeit goods.

High-Level Meetings with the European Commission to Defend Brand Owners

On July 5 and 6, INTA CEO Etienne Sanz de Acedo and INTA Europe Office met with high-level representatives from several Directorates of the European Commission to exchange information on IP rights protection outside the EU, the EU's strategy on IP, protection of small and medium-sized enterprises and incentives for innovation, and tools to fight counterfeiting, including the Anticounterfeiting Committee's ***Best Practices for Addressing the Sale of Counterfeits on the Internet***.

INTA High-Level Visit to Italy

On July 12, Mr. Sanz de Acedo and Ms. Nicora flew to Rome, Italy, to meet with the Italian Patent and Trademark Office (UIBM), together with Italian members Marie-Laure Bonnaffous (Fendi, Italy), who is a member of the INTA Board of Directors; Laurence Morel-Chevillet (Bulgari, Italy); and Elio de Tullio (De Tullio & Partners, Italy) to finalize a new MOU with the UIBM. The MOU focuses on anticounterfeiting-related projects in Italy.

Ms. Nicora made a stop in Milan to attend an INTA Anticounterfeiting Committee-led policy dialogue on online counterfeiting, jointly organized with the UIBM and Istituto di Centromarca per la lotta alla contraffazione (INDICAM), featuring speakers from government, brand-owner, and Internet service provider sectors. Ms. Nicora also took the opportunity to meet with current and prospective corporate members in Milan.

INTA Co-Signs Paper with ECTA and MARQUES on Designs in the EU

On July 9, INTA's Europe Office, together with the European Communities Trade Mark Association (ECTA) and the Association of European Trade Mark Owners (MARQUES), submitted a joint position paper on the EU design protection system to the European Commission.

The EU Commission's Vice-President in charge of the Digital Single Market, Andrus Ansip, highlighted that one of the Commission's roles is “to protect creators” as well as consumers, adding that there is a need to “focus much more attention to IPRs.”

ECTA, MARQUES, and INTA hope that their common position on changes to the EU design protection system assists the European Commission in the context of the recently launched evaluation of the EU legislation on design protection.

The EU design protection system is made up of a Regulation (Regulation 6/2002 of December 12, 2001, on Community designs) that introduced the Registered Community Design and Unregistered Community Design Right into EU law and a Directive (Directive (EC) 98/71 of October 13, 1998, on the legal protection of designs), which harmonized design law across the EU member states.

Some 15 years since the entry into force of this legal framework, the joint paper submitted by ECTA, MARQUES, and INTA addresses those aspects that require some reflection and correction. The three associations hope that their common position assists the European Commission in the context of the recently launched evaluation of the EU legislation on design protection.

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Indian Dignitaries Attend INTA's 140th Annual Meeting

This year's Annual Meeting in Seattle, Washington, had a strong contingent of members and delegates from India. INTA was honored and pleased to host the Honorable Justice Manmohan of the Delhi High Court and Om Prakash Gupta, Controller General of Patents, Designs and Trade Marks, as representatives of India.

Justice Manmohan participated in the Judges Workshop, in which judges from various international jurisdictions discussed public well-being versus private rights, offering the Indian judiciary's perspective on the topic of brand restrictions. Mr. Gupta spoke at the IP Office Workshop and presented the Indian IP Office's perspective on determining the deceptiveness of trademarks, including certification marks.

INTA expects that in the coming years the Association will continue to have the sustained and increased participation of dignitaries from India.

Sun Pharmaceutical Recognized by WIPO and DIPP in New Delhi

India's Department of Industrial Policy and Promotion (DIPP) and the World Intellectual Property Organization (WIPO) in Geneva, Switzerland, awarded Sun Pharmaceutical Industries Ltd. with the "WIPO User Trophy for top Indian Company creating Global Brand 2018." The Controller General of Patents, Design and Trademark commended Sun Pharmaceutical's efforts to promote and protect its trademarks in other countries through the Madrid Protocol.

The honor was bestowed upon Sun Pharmaceutical during an event organized by DIPP and the Cell for IPR Promotion and Management (CIPAM) commemorating the successful completion of two years of India's National Intellectual Property Rights Policy.

The award was presented by the Honorable Minister of Commerce and Industry, Suresh Prabhu, and received by Rajamalliah Cirumalla and Azadar Khan of Sun Pharmaceutical. INTA congratulates its member Sun Pharmaceutical on this recognition.

IP Rights Awareness in Schools Using Satellite Communication

On May 15, CIPAM organized its first-ever EduSAT program in collaboration with Vigyan Prasar, an autonomous organization under the Department of Science and Technology, to educate school children across the country on IP rights using satellite communication. During this session, INTA was represented by its member, Meera Chature (Jupiter Law Partners, India), who talked with students about IP rights and their importance. The program reached school students in the Indian cities of Itanagar, Jalgaon, Vijayawada, and Mandi.

Public Notice Regarding Applications in Danger of Abandonment

The Office of the Controller General of Patents, Designs & Trade Marks has issued a list of trademark applications in which examinations were completed before December 31, 2017, and the examination reports containing office objection(s) were duly communicated to the persons concerned at the address for service on record, but for which the Trade Marks Registry has not received a reply. Applicants and their authorized agents have been provided one last opportunity to send a scanned copy of their reply to the examination report on or before July 25, 2018, at parm.tmr@nic.in, failing which these applications will be treated as abandoned.

The notice also informs the public that, in addition to the service of examination report at the designated email of the applicant,

the Trade Marks Registry has started providing a link (at <https://ipindiaonline.gov.in/progress/noEXRReceived.aspx>) of all applications on a monthly basis, in effect from January 2018, in which a reply to the office objection is awaited. The notice advises applicants to refer to the link periodically to comply with legal requirements and avoid abandonment of applications for non-compliance of office action.

The complete notice can be **accessed here**.

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Roundtable Report: INTA Members Present Latin America Economic Impact Study in Venezuela

A roundtable focused on INTA's 2016 impact study, *Trademarks in Latin America: A study of their economic impact in five countries in the region (Chile, Colombia, Mexico, Panama, and Peru)*, took place in Caracas, Venezuela, on Thursday May 3.

Co-hosted by INTA, the Inter-American Intellectual Property Association (ASIPI), and the Venezuelan Association of Industrial Property Agents (COVAPI), the event attracted more than 75 attendees from the Venezuelan IP community, representatives from the Venezuelan Congress, and the press.

The roundtable was a prime opportunity to introduce the results of the impact study, which demonstrated the positive impact of trademark-intensive industries on the economies of Chile, Colombia, Mexico, Panama, and Peru. The study included findings that the contribution of IP-intensive industries to total employment in these regions is about 8 to 26 percent and 10 to 21 percent of GDP. Such data is particularly important for an economy like Venezuela's, which is experiencing economic and political challenges.



From left to right: Castor González-Escobar, Jacqueline Moreau and Luis Alejandro Henriquez.

Luis Alejandro Henriquez (Marquez, Henriquez, Ortin & Valedon, Venezuela), Secretary of ASIPI and member of the team that developed the impact study, was the main presenter. He shared the highlights of the study with the audience and stressed the importance of adequate protection of IP rights so that the country and brand owners can benefit from their contribution to the economy.

Castor Gonzalez-Escobar (GR LEX Americas, Venezuela) talked about the present and future of IP rights protection in Venezuela, discussing the challenges for promoting a culture of innovation and creativity as a tool to promote growth and wealth, as well as human and economic development.

Matias Perez-Irazábal (Hoet, Pelaez, Castillo & Duque, Venezuela) and President of COVAPI, gave a detailed presentation about the actions and challenges faced by COVAPI in defending IP rights.

The meeting was also an excellent opportunity for the IP community to receive an update from Mario Massone, Legal Advisor of the Science, Technology and Innovation Commission of the National Assembly (Venezuela's Congress) and Coordinator of the technical committee for the reform of the Industrial Property Law, regarding the advances and challenges for passing such reform.

The event was co-organized by Jacqueline Moreau Aymard (Moreau Gonzalez & Asociados, Venezuela), National Delegate to ASIPI, who also moderated the roundtable; Mr. Perez-Irazábal; Mr. Henriquez; and Mr. González-Escobar.

A Spanish version of the Latin America impact study was published on December 15, 2016, and is **available here**.

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Understanding False Endorsement and Right of Publicity Claims in a Digital Age

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In the United States, right of publicity laws at the state level prohibit the unauthorized use of a person's name, image, or other aspect of identity for commercial purposes. In many of these situations, Section 43(a) of the Lanham Act (the federal Trademark Act) will also provide a claim for false endorsement of goods or services. Understanding these claims is particularly important in today's digital age of ubiquitous smart phone cameras and expanding social media platforms (with both businesses and celebrities promoting their brands), in which posting (and reposting) of photographs and other aspects of a person's identity can be done instantly and without much thought. In this context, it is important to understand the similarities and differences between right of publicity and false endorsement claims, and identify situations in which one claim or the other may provide a plaintiff's only means of challenging a defendant's misappropriation of a plaintiff's identity.

Right of Publicity State Law Claims

Most states in the United States recognize a statutory and/or common law right of publicity. The right of publicity is the right of a person to control the commercial uses of his or her identity by prohibiting unauthorized commercial appropriation by others. The specific requirements for proving a violation of the right of publicity vary by state, but generally consist of the defendant's use of an aspect of the plaintiff's identity (e.g., name, photo, image, likeness, or voice) for commercial purposes or financial gain and without the plaintiff's permission. See, e.g., *Stewart v. Rolling Stone LLC*, 181 Cal. App 4th 664, 679, 105 Cal. Rptr. 3d 98, 111 (2010); *Bullard v. MRA Holding, LLC*, 292 Ga. 748, 752, 740 S.E.2d 622, 626 (2013).

In most states, the right of publicity extends to non-celebrities as well as celebrities. For example, New York's applicable statute provides a claim for "[a]ny person whose name, portrait or picture is used within the state for advertising purposes or for purposes of trade without the written consent first obtained as above provided." N.Y. Civ. Rights Law § 51 (West 2017). Available remedies for violations of the right of publicity generally include an injunction, damages and/or recovery of a violator's profits from the violation, and punitive damages.

Lanham Act False Endorsement Claims

Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), generally prohibits use of a name, a false designation of origin, or a false or misleading description or representation of fact which is likely to cause confusion or to deceive about the affiliation or association of a person with another person. The statutory language is broad enough to provide a vehicle for false endorsement claims; i.e., claims of falsely implying the endorsement of a business, product, or service by a celebrity or other person.

False endorsement claims are similar to claims for misappropriating the right of publicity, in that they both involve unauthorized use of a person's name, image, likeness, or other aspect of identity for commercial purposes. However, false endorsement claims require proof of the added element of falsity; i.e., that the unauthorized use of the person's identity is likely to confuse, deceive, or mislead consumers into falsely believing that the person approves, sponsors, or endorses the goods or services of the business at issue. See *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 925 (6th Cir. 2003) ("[f]alse endorsement occurs when a celebrity's identity is connected with a product or service in such a way that consumers are likely to be misled about the celebrity's sponsorship or approval of the product or service"); see generally 5 *J. Thomas McCarthy, McCarthy on Trademarks*

Asserting Both Claims—Michael Jordan and Katherine Heigl

Given the frequency with which celebrities and public personas endorse products, services, and brands, it should come as no surprise that in many cases involving a celebrity, an alleged violation of the right of publicity will also support a claim that use of the celebrity's identity misleads consumers into falsely believing the celebrity is sponsoring or endorsing the defendant or the defendant's goods or services. For example, in *Jordan v. Jewel Food Stores, Inc.*, the Seventh Circuit held that an unauthorized Jewel/Osco grocery store tribute ad to Michael Jordan stated valid claims for both violation of Mr. Jordan's right of publicity under state law and false endorsement under the Lanham Act. 743 F.3d 509 (7th Cir. 2014). Similarly, in *White v. Samsung Elecs. Am., Inc.*, the Ninth Circuit held that Samsung's use of a robot likeness of *Wheel of Fortune* letter-turner Vanna White created a triable issue of fact on whether Samsung's ads caused a likelihood of confusion as to Ms. White's endorsement of Samsung's products under the Lanham Act and violated Ms. White's right of publicity under state law. 971 F.2d 1395 (9th Cir. 1992).

On some occasions, a Lanham Act false endorsement claim may provide relief when a state right of publicity claim does not.

A social media example of this occurred in 2014 when drug store chain Duane Reade posted a paparazzi photo on Facebook and Twitter of actress Katherine Heigl carrying Duane Reade shopping bags, with an accompanying tweet reading: "Love a quick #DuaneReade run? Even @KatieHeigl can't resist shopping #NYC's favorite drugstore." Ms. Heigl promptly filed a US \$6 million lawsuit for false endorsement under the Lanham Act and violation of her right of publicity under state law. The case was reportedly settled by Duane Reade's removal of the postings and donation to a charity supported by Ms. Heigl.

When the Lanham Act Succeeds—Woody Allen and the Naked Cowboy

On some occasions, a Lanham Act false endorsement claim may provide relief when a state right of publicity claim does not. This primarily occurs in certain states, such as New York, which limit the aspects of a person's identity that are protected under the state's right of publicity law.

For example, in *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612 (S.D.N.Y. 1985), National Video, a chain video rental store, ran an advertisement featuring Woody Allen look-alike Phil Boroff. The advertisement depicted Mr. Boroff as a customer at the counter in a National Video store, holding his National Video V.I.P. card with videotape cassettes of "Annie Hall" and "Bananas" (two of Mr. Allen's movies) on the counter waiting to be rented. The headline on the advertisement read "Become a V.I.P. at National Video. We'll Make You Feel Like a Star." The same photo and headline were used on point of sale advertisements inside National Video stores.

Mr. Allen was not amused and brought claims against National Video and Mr. Boroff for violations of his right of publicity under state law and claims of false endorsement under the Lanham Act.

The district court struggled with the portion of the New York statutory right of publicity claim requiring use of the plaintiff's "name, portrait, or picture," since the photo in the advertisement was a picture of Mr. Allen's look-alike, Mr. Boroff, and not of Mr. Allen himself. 610 F. Supp. at 622–25. It concluded that it did not need to rule on the right of publicity claim, deciding that it only had to determine whether the look-alike was "sufficiently similar to plaintiff" to create a likelihood of confusion as to Mr. Allen's endorsement of National Video. After analyzing the evidence, the court was led "to the inescapable conclusion that defendant's use of Boroff's photograph in their advertisement creates a likelihood of consumer confusion over plaintiff's endorsement or involvement." *Id.* at 625–28. As a result, the court granted summary judgment to Mr. Allen on his Lanham Act claim and entered an injunction prohibiting use of the photograph. *Id.* at 632.

Similarly and more recently, Robert Burck—better known as Times Square's so-called "Naked Cowboy" street entertainer—brought a right of publicity state law claim and a false endorsement Lanham Act claim over a Times Square billboard featuring an M&M candy dressed in Burck's signature outfit of cowboy hat and boots, white briefs, and a guitar. The district court dismissed the right of publicity claim under New York law because the billboard did not contain a portrait or picture of Mr. Burck. However, it denied a motion to dismiss the false endorsement claim under the Lanham Act, finding that the complaint sufficiently pled facts to suggest that viewers were likely to falsely believe that Mr. Burck endorsed M&M candies. *Burck v. Mars, Inc.*, 571 F. Supp. 2d 446, 454–56 (S.D.N.Y. 2008).

When Right of Publicity Succeeds—Non-Celebrity Cases and Sofia Vergara

In other situations, primarily involving non-celebrities, a plaintiff may be able to pursue a claim for violation of his or her right of publicity but not for false endorsement. For example, one court held that a non-celebrity model whose image was used in a consumer advertisement could not maintain a false endorsement claim because few people would recognize her picture or be confused or deceived into buying a product because she endorsed it. However, she was permitted to maintain her claim for violation of her right of publicity. *Ji v. Bose Corp.*, 538 F. Supp. 2d 349 (D. Mass. 2008).

In 2016, actress Sofia Vergara filed a US \$15 million lawsuit against Venus Concept for misappropriation of her right of publicity, based on authorized promotional use of a selfie that Ms. Vergara had posted to her social media site while using a Venus skin-tightening product during a massage. Venus re-posted the photo to several social media pages with captions such as "Loved by bombshell actress Sofia Vergara." Ms. Vergara alleged that this conduct created the false impression that she

endorsed the brand and its products, although she chose not to assert a Lanham Act false endorsement claim (perhaps to prevent removal to federal court and keep the case pending in Los Angeles Superior Court). The case was settled in 2017 for an undisclosed amount.

Prevention Is Better Than Cure

Our fast-paced, digital world of social media posts, tweets, snaps, and pins increases the risks of right of publicity claims under state law and false endorsement claims under the Lanham Act. These claims can come from celebrities or non-celebrities, but the risks increase with celebrities—who can and will sue to protect against unauthorized use of their personal brands, and who have succeeded with high damages awards and settlements against those who have used their identities without permission. The safest way to avoid these claims is to get permission before using anyone’s name, image, or likeness on a social media page or to promote your business or commercial endeavors. This is one of those areas where, as Benjamin Franklin said in an earlier, pre-digital time “an ounce of prevention is worth a pound of cure.”

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AUSTRALIA: BOHEMIA and BOHEMIA CRYSTAL Trademarks Canceled for Descriptiveness

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In *Bohemia Crystal Pty Ltd v. Host Corporation Pty Ltd*, [2018] FCA 235 (Mar. 6, 2018), the Federal Court of Australia found the marks BOHEMIA and BOHEMIA CRYSTAL are not to any extent capable of distinguishing glassware, nor are they considered factually distinctive by virtue of their use, and should be removed from the Register.

Bohemia Crystal Pty Ltd (BCP) had imported and sold glassware from the Bohemia region in the Czech Republic for decades, initially under license from its parent company. BCP registered the trademarks BOHEMIA (in 2003) and BOHEMIA CRYSTAL (in 2001) covering glassware in Class 21. BCP alleged that by importing and selling crystal products under the name BANQUET CRYSTAL BY BOHEMIA, Host Corporation Pty Ltd (Host) had infringed its registered trademarks and engaged in misleading and deceptive conduct in breach of Australian Consumer Law. Host cross-claimed for cancellation of BCP's marks on the grounds the marks were not capable of distinguishing for glassware as of the filing date of the applications, and therefore should not have been registered.

When considering whether the marks were inherently capable of distinguishing, the Court found that when used in relation to crystal and glassware, the word "Bohemia" would signify to both consumers and traders the region where the goods were manufactured; and the words "Bohemia Crystal" would likely denote a particular style of glassware originating from Bohemia.

BCP submitted substantial evidence of use in an attempt to support its claim that the marks had acquired distinctive through use. However, the Court found significant deficiencies in the evidence, as much of it: was not dated prior to the filing date of BCP's applications, or was use of a composite mark which included other distinctive elements, rather than use of the marks as they were filed. The Court concluded the marks had not acquired distinctiveness as of the filing date and ordered both marks be cancelled from the Register.

As the marks were found invalid, it was not necessary for the Court to consider BCP's infringement claim; however, the Court did consider that, had the marks been held valid, Host's use of BOHEMIA would infringe BCP's registrations.

The case demonstrates the need to maintain detailed historical records of use of trademarks to assist in showing your mark has acquired distinctiveness through use, particularly for marks containing descriptive terms and references to geographical regions.

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DOMINICAN REPUBLIC: Crocs, Inc.'s 3D Registration Annulled

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On February 23, 2018, the Director of the Distinctive Signs Department of the National Office of Industrial Property (ONAPI) issued Resolution 000111, invalidating Crocs, Inc.'s July 2, 2013, registration (number 204406) for the company's 3D sandal design in Classes 10 and 25. *Grupo Ramos, S.A. v. Crocs, Inc.*

In March of 2017, Grupo Ramos S.A., a major retail store in the Dominican Republic, filed a nullity action before the Director of the Distinctive Signs Department of ONAPI against Crocs, Inc.'s 3D registration, alleging that it was issued in violation of Article 73(1) a, b, d, and f of Law 20-00 of Industrial Property, which states that a sign that falls within the following prohibitions may not be registered as a trademark:

1. Consisting of the usual and regular forms of the products or services or of the shapes necessary or imposed by the nature of the correspondent product or service;
2. Consisting of shapes that grant a functional or technical advantage to the product;
3. Consisting of a name or sign that in the commercial language of the country describes the product or its characteristics;
or
4. Consisting of a sign that in the commercial language of the country may be considered generic.

Grupo Ramos S.A. stated that the protected mark consisted of the typical "clog" shoe used by doctors and others that in recent years had begun to be known as "Crocs" but are clogs; that the openings are needed in any plastic shoe to allow the passage of air; and that "Crocs" is the term used generally to describe this type of shoe.

Crocs, Inc. argued that, in most international jurisdictions, 3D marks do not need to satisfy additional requirements beyond distinctiveness and the principle of "specialty," which refers to the fact that the trademark protects only the goods for which it has been registered, in order to be afforded protection. Furthermore, Crocs argued that the holes are not functional, as many plastic shoes have no openings and that its shoe has absolutely no relation to typical clogs.

Crocs, Inc. also presented the results of a poll providing evidence that, when consumers are shown a picture of the shoe, they immediately say it is a Croc. Crocs, Inc. also deposited proof that its mark is famous, including several newspaper, magazine, and book articles, blogs, the company's Twitter profile, pages from the Crocs website, copies of the CROCS trademark registrations, certified copies of Crocs' tridimensional registration in Colombia, and a certified copy of Crocs' Korean design registration.

The Director of the Distinctive Signs Department ultimately ruled that the mark included functional elements.

Crocs, Inc. filed an appeal against the invalidation of its mark before the General Director of ONAPI on April 23, 2018. A final decision on the matter at the administrative stage is still pending.

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EUROPEAN UNION: Court of Justice of the European Union Rules that Louboutin's Red Sole Is a Valid Trademark

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Verifier: Claudia Csáky, Graf & Pitkowitz Rechtsanwälte GmbH, Vienna, Austria

Ms. Verhoestraete and Ms. Csaky are members of the INTA Bulletin's Law and Practice—Europe Subcommittee.

On June 12, 2018, the Grand Chamber of the Court of Justice of the European Union (CJEU) held, in a case involving Louboutin's famous red sole, that a color affixed to the sole of a high-heeled shoe is not a shape and thus not excluded from the scope of trademark protection. Case C-163/16, Mr Louboutin and Christian Louboutin SAS v. *Van Haren Schoenen B.V.*, EU: C: 2018: 941.



The case concerned a Benelux trademark, shown left, and described as follows:

The mark consists of the color red (Pantone 18-1663 TP) applied on the sole of a shoe [shown left] (the outline of the shoe is not part of the mark but is intended to highlight the location of the mark).

Louboutin had initiated infringement proceedings against the Dutch company Van Haren Schoenen B.V., which sold high-heeled shoes with red soles.

In its defense, Van Haren challenged the validity of the Louboutin registration, arguing that the red sole lends substantial value to the products concerned and should thus be excluded from trademark protection. The Hague court agreed that the red sole gives substantial value to the shoes, since it plays an important role in the customer's purchasing decision, but decided to refer the following question to the CJEU:

Is the notion of "shape" within the meaning of Article 3(1)(e)(iii) [of the then applicable Trade Mark Directive 2008/95/EC, i.e. the absolute ground for refusal concerning "signs which consist exclusively of [...] the shape which gives substantial value to the goods"] [...] limited to the three dimensional properties of the goods, such as their contours, measurements and volume (expressed three-dimensionally), or does it include other (non three-dimensional) properties of the goods, such as their colour?

The CJEU ruled, very concisely, that in trademark law the term "shape" refers to "a set of lines or outlines delimiting the product concerned in space" and that a color per se, without an outline, does not constitute a shape. A trademark intended to protect the application of a color to a specific location on the product cannot be regarded as consisting exclusively of a shape.

It will be interesting to see whether color marks applied to products (or parts thereof) registered after the transposition of Directive 2015/2436/EU repealing Directive 2008/95/EC will be treated differently. Under the new Trade Mark Directive, the aforementioned absolute ground of refusal is not limited to shapes of products and may extend to "another characteristic" of the product. While it is too soon to make predictions in this regard, it would appear important, when assessing the value conferred by the shape of a product or other characteristic, to first determine whether that value existed at the time of filing or is the result of substantial marketing and branding efforts.

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LAOS: Opposition Procedures Now Available, Term of Protection Amended

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Laos's new Law on Intellectual Property, No.38/NA of November 15, 2017 was published electronically in the Laos Official Gazette on May 25, 2018, and became effective 15 days following its publication. This supersedes the previous Law on Intellectual Property, No. 01/NA, dated December 20, 2011.

The new legislation brings reform to a variety of areas of intellectual property law in the country, but it is with respect to trademarks where the greatest number of amendments has been made.

A new digital platform is to be created which will publish submissions of new trademark applications. Within 60 days of the publication of a new application, third parties can now oppose the registration of the mark concerned.

This is a fairly substantial innovation when compared to what means have been previously available to third-party mark holders—namely, only cancellation. To achieve this, a cancellation request needed to be filed with the Department of Intellectual Property (DIP), which could only be done after the mark had been registered and the certificate issued, and within five years of the publication of said registration in the Official Gazette. Factoring in delays in the publication of registrations in the Official Gazette, this often meant that successful cancellation actions could only prevail after the mark had been put to use in Laos for a significant period of time.

A further important amendment that the new law introduces is the term of protection of registered Laos trademarks. Trademark registrations will now be valid for a period of 10 years from the filing date. Previously, marks had been valid for 10 years from the date of registration.

Lastly, the updated legislation also expands the range of matters which may be registered as trademarks in Laos. With the new law coming into effect, 3D images and animated images are now registrable.

It is anticipated that regulations will be issued in due course to supply further guidance to trademark holders on the scope and application of the new law. Given the extent of the changes introduced, it will take time to develop infrastructure and train local officers in order to streamline registration and opposition procedures. Nevertheless, the introduction of the new legislation signifies a major step forward for Laos's trademark regime.

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SOUTH KOREA: Revised Unfair Competition Prevention Act Specifies Protection of Trade Dress and Business Ideas

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The Korean Intellectual Property Office (KIPO) announced the revisions to the Unfair Competition Prevention and Trade Secret Protection Act (UCPA) on April 17, 2018. The revisions, which include the protection of trade dress and the prohibition of stealing another's business ideas, will take effect on July 18, 2018.

Trade dress is not registrable as a trademark, and it was not clear whether it could be protected under the UCPA. Articles 2(1) (b) and (c) of the UCPA define acts of causing confusion with another person's commercial facilities or activities, and acts of doing damage to the distinctiveness or reputation attached to another person's mark, as acts of unfair competition. As trade dress has been included as an example of a mark indicating another person's goods or business in these articles, it has become clear that trade dress is protected under the UCPA.

Another notable revision is the introduction of an article that prohibits stealing another party's business or technological ideas. The new article prohibits "an act of unfairly using information containing technological or business ideas with economic values that was obtained in business proposals, biddings, contests, business consultations, etc., for one's own or another's business interests, or providing such information to another party for use against the purpose of the information's provision, on the condition that the person who received the idea was not aware of it when it was provided, or the idea was not widely known in the same industry when it was provided" (note: this is not the official English translation by the Korean Ministry of Government Legislation). The party harmed by such unfair act can file a civil lawsuit for cessation of the act based on Article 4 of the same law, and for damage compensation based on Article 5.

This new article was introduced especially to protect small businesses or individuals that often provide their new business or technological ideas to large companies or investors to get investments or contracts but do not have means or leverage to prevent misuses of their ideas by other parties.

KIPO has the authority to investigate a company suspected of violating the UCPA and issue a corrective order to cease the act of unfair competition or to remove or destroy a mark used in the act within a specific period. However, to date, it has not aggressively exercised its authority. With the announcement of the recent amendment to the UCPA, KIPO has demonstrated its determination to take a more proactive role in preventing and resolving acts of unfair competition, especially in relation to indiscriminate imitations of trade dress and the stealing of business or technological ideas. Once the revised law goes into effect, KIPO is expected to use this authority more often and actively than before.

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UNITED ARAB EMIRATES: Launch of Online Trademark Register Searches

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On April 19, 2018, the United Arab Emirates Trademarks Department issued a circular to all registered trademark agents announcing the launch of an online portal through which agents can conduct trademark register searches. This development means that agents no longer need to visit the Trademarks Department in person, reducing the time and costs for agents in conducting register searches. The official fees do, however, remain relatively high when compared to most other countries, at AED 500 (USD 137) per mark, per class.

Searches can be conducted for word marks only. It is not possible to conduct searches by trademark owner or for figurative elements of marks. The search results will only return results for the identical mark that is searched. Each variant searched will incur a new search fee, and it is not possible to conduct searches of similar marks.

The search results contain relatively few details compared to other online search portals in other jurisdictions. The searches will provide agents with the following information only: word elements contained in the mark, the filing date, the registration date (if applicable), owner name, address and nationality, and the current status of each mark revealed by the search. However, the search results do not contain the following information: details of priority claims (if any), a representation of any figurative elements contained in the mark, details of the agent of record, prosecution history, or details of any conditions, disclaimers, recorded licenses, or mortgages. In order to obtain these details about a record identified by the online searches, a visit to the Trade Marks Department would be necessary. However, recently, the Trade Marks Department has been refusing to provide agents with further information unless they are the agent of record for that particular mark and hold a valid power of attorney.

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UNITED STATES: Opposer's Motion to Strike Pre-Trial Disclosure of Authenticating Witnesses Denied by TTAB

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Verifier: Linda Yang, Baker Donelson Bearman, Caldwell & Berkowitz, PC, Chattanooga, Tennessee, USA

Ms. Gifford and Ms. Yang are members of the INTA Bulletins Law & Practice—North America Subcommittee

The Trademark Trial and Appeal Board (TTAB) held that Thatch LLC's (Thatch) failure to disclose authenticating witnesses until pre-trial disclosures was "substantially justified and harmless," thus denying the motion of Kate Spade LLC (Kate Spade) to strike pre-trial disclosures of authenticating witnesses. *Kate Spade LLC v. Thatch, LLC*, 126 U.S.P.Q.2d 1098 (TTAB Mar. 22, 2018).

Thatch filed applications for the marks PATIO BY SPADES and THE SPADES for clothing and handbags. Kate Spade opposed the applications based on its registrations and use of the KATE SPADE mark for clothing, handbags, and other goods.

Thatch's initial disclosures provided, in part, for categories of documents for use to support "its claims and defenses, including [d]ocuments reflecting third party use and registration of marks similar to" applicant's marks.

Thatch supplemented its initial disclosures during Kate Spade's trial period to identify a witness to authenticate "recently obtained third party use goods for use at trial" and "third party use witnesses to be determined" to testify on "authentication of third party use goods and services and use of third party marks."

Thatch served pre-trial disclosures identifying the witness in its supplemental initial disclosures to testify and authenticate third-party use and purchasers of third party use goods. Thatch also identified two additional witnesses to testify on "adoption, use and/or registration of third party marks" and to introduce associated exhibits.

Kate Spade filed a motion to strike Thatch's pre-trial disclosures.

In determining the merits of Kate Spade's motion, the TTAB followed Federal Rules of Civil Procedure 37(c)(1), which governs whether "evidence will be excluded for failure to disclose, or allowed because the failure to disclose is substantially justified or harmless." The TTAB looked to the five-factor test in *Great Seats Inc. v. Great Seats Ltd.*, 100 U.S.P.Q.2d 1323, 1327 (TTAB 2011). Those factors are: "(1) the surprise to the party against whom the evidence would be offered; (2) the ability of the party to cure the surprise; (3) the extent to which allowing the testimony would disrupt the trial; (4) importance of the evidence; and (5) the non-disclosing party's explanation for its failure to disclose the evidence."

The TTAB considered those factors regarding each witness identified in Thatch's supplemental initial disclosures and pre-trial disclosures. The TTAB first addressed whether Thatch's supplemental initial disclosures were deficient, and found that its "initial disclosures, supplemental initial disclosures, and pre-trial disclosures are entirely consistent in providing the necessary notice" for submitting documentary evidence of third-party use at trial.

For the testimony witness provided by Thatch in its supplemental initial disclosures, the TTAB denied Kate Spade's motion to

strike because of the timely identity of this authenticating witness and lack of deficiency in Thatch's evidence disclosure.

The other two witnesses were not specifically identified in Thatch's initial disclosures; however, the initial disclosures identified third-party use as a category of documents to be used at trial. The TTAB considered each of the *Great Seats* factors in view of Kate Spade's motion to strike the pre-trial disclosures. To rebut the *Great Seats* fourth and fifth factors regarding the importance of evidence and Thatch's failure to disclose explanation, Kate Spade argued that witness testimony regarding third-party use would be within the general knowledge of other witnesses and that Thatch was dilatory in its trial preparation. The TTAB was not persuaded by the arguments concerning any of the *Great Seats* factors, as Kate Spade did not claim surprise upon receipt of the supplemental initial disclosures and did not seek discovery regarding the third-party use.

The TTAB found that "on balance" with the *Great Seats* factors, the applicant's failure to disclose the identity of the witnesses for authenticating third-party use until pre-trial disclosures was both substantially justified and harmless, and thus denied Kate Spade's motion to strike.

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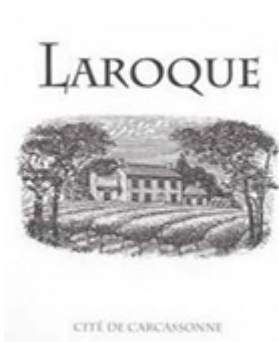
UNITED STATES: TTAB Finds LAROQUE & Design Similar to CHATEAU LAROQUE for French Wines from Different Regions

Contributor: Linda Yang, Baker Donelson, Chattanooga, Tennessee, USA

Verifier: Cynthia A. Moyer, Fredrikson & Byron, P.A., Minneapolis, Minnesota, USA

Ms. Yang and Ms. Moyer are members of the INTA Bulletins Law and Practice—North America Subcommittee

The Trademark Trial and Appeal Board (Board) affirmed, with one concurring opinion, a refusal to register the mark shown below for “Wine of French origin protected by the appellation of the origin Cité de Carcassonne” (“Cité de Carcassonne” disclaimed) in International Class 33, finding it confusable with the registered mark CHATEAU LAROQUE (in standard characters, “Chateau” disclaimed) for “Wine having the controlled appellation Saint-Emilion Grand Cru.” *In re Aquitaine Wine USA, LLC*, Serial No. 86928469 (Apr. 2, 2018).



Marks

The Board found that the shared term “Laroque” dominates both marks. Compared to the other disclaimed terms, “Laroque” is the only arbitrary term in the marks. Moreover, in the applied-for mark, “Laroque,” as the largest literal portion of the mark, would make a greater impression upon consumers than the design portion.

The applicant, Aquitaine Wine USA, LLC argued that because consumers today pick wines based on images on labels, “the dominant mark would be the design of the wine label as a whole.” The Board disagreed. It reasoned that, if consumers order the wine by glass from a wine list showing only the wine names, consumers would not see the images at all. Moreover, even assuming the applicant’s theory is correct, the applied-for mark is not a wine label; the Board must compare the marks as they appear in the application drawings, rather than as they are actually used in the

market.

The Board then addressed the unsettled question of how it should compare a standard character mark to a word and design mark in determining likelihood of confusion. After revisiting *In re Viterro Inc.*, 101 U.S.P.Q.2d 1905, 1908 (Fed. Cir. 2012), the Board held that it will consider variations of the depictions of the standard character mark only with regard to “font style, size, or color” of the “words, letters, numbers, or any combination thereof,” which appears to categorically exclude the consideration on designs.

It added, however, that, because here the word and design mark being compared included a pictorial representation of a term in the standard character mark (the design of a large estate home or “chateau”), such pictorial representation would be considered, which also favored the view that confusion was likely.

Thus, the Board concluded that the marks are similar.

Goods; Trade Channels; Consumers

The Board held that, even though the application and the registration have identified the different origins of the wines in France, consumers may well be unaware of this distinction. Evidence also shows that wine purveyors sell French wine from different regions on the same webpage. The Board concluded that the goods are closely related and are sold through the same trade channels.

Concurring Opinion

While concurring in the result, Judge Ritchie disagreed with the majority's approach in not considering "design features" that a standard character mark might include in the actual display of the mark. Rather, Judge Ritchie would find that the registrant's right to display the mark CHATEAU LAROQUE in any "font style, size, or color" includes designs that would make it similar to the applied-for mark.

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UNITED STATES: TTAB Considers Three SERIAL Applications, Refusing One and Allowing Two to Proceed

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Ms. Moyer is a member and Ms. Trudell is co-chair of the INTA Bulletins Law and Practice—North America Subcommittee.

In a precedential decision, the Trademark Trial and Appeal Board (the Board) examined three applications for SERIAL (a standard character mark and two composite logo marks) and held that the standard character mark SERIAL is generic for “entertainment in the nature of an ongoing audio program featuring investigative reporting, interviews, and documentary storytelling,” affirming the refusal of the U.S. Patent and Trademark Office (USPTO) to register it. But the Board reversed the USPTO’s refusal to register the two composite logos below:



The Board held they are registrable because they have acquired distinctiveness, provided that the applicant disclaims the word “serial.” *In re Serial Podcast, LLC*, 126 U.S.P.Q.2d 1061, 2018 WL 1522217 (T.T.A.B. Mar. 26, 2018).

Board Concludes Standard Character Mark Is Generic

With regard to the standard character mark, the Board examined both whether the mark was generic and whether it had acquired sufficient distinctiveness such that it would be registrable. The Board began its analysis by noting that a term is generic if it “is the common descriptive name of a class of goods or services.” *Id.* at *2. If a term is generic, it is “not registrable because “[g]eneric terms, by definition, incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status.” *Id.* The parties agreed that the relevant genus of services were “entertainment in the nature of an ongoing audio program featuring investigative reporting, interviews, and documentary storytelling,” and the Board held the consumers are “ordinary listeners of audio programs.” *Id.* Unpersuaded by the applicant’s many arguments about the number of listeners, whether the mark is a noun or an adjective, and the multiple media references to the mark, the Board held the term was generic and lacked acquired distinctiveness, finding that Internet articles and websites demonstrate that the term “serial” refers “categorically to ongoing audio programs.” The Board also stated, “the serial has long been a staple of the radio waves,” citing *Sergeant Preston of the Yukon*, *The Lone Ranger*, and *Sky King*. *Id.* at *3.

The Board Held That the Composite Logo Marks Are Registrable

With regard to the composite logo marks, the Board reversed the Trademark Office’s refusal. It began by noting that composite logos “may be registrable even when the word portion, taken alone, is not.” *Id.* at *11. The Board held that the composite logos are not generic when taken as a whole. And the Board held that the applicant met a high bar and successfully proved that the composite logos had acquired distinctiveness. The Board noted that others—including *Saturday Night Live* (SNL) and *Sesame Street*—have created parodies featuring the design elements. With regard to the SNL reference, the Board stated that the use of a parody by “a long-running, famous, national weekly television show” is “highly probative” of acquired distinctiveness. The

Board characterized the parodies by both SNL and *Sesame Street* as “highly unusual and highly significant evidence.” *Id.* at *15. Accordingly, the Board concluded that the composite logo marks are registrable if the applicant disclaims the term “serial.”

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