



# Global Report

Recent Trademark Developments and INTA Activities in Eight Key Regions



## Africa

INTA Delegation Meets with Officials in South Africa and Zimbabwe

## Asia-Pacific

INTA Deepens Regional Ties: South Korea

## India

Launch of INTA-CIPAM Children's IP Awareness and Education Campaign in Schools



2017 INTA President Joseph Ferretti  
(PepsiCo, Inc., USA)

With another successful Annual Meeting behind us, and the Leadership Meeting almost here, my year as INTA President is going fast—but there is still much to be done.

2017 is a transition year for the Association in several ways. During the Annual Meeting in Barcelona, Spain, we announced the 2018 - 2021 Strategic Plan, which will guide the Association through its next four years. The plan will be presented again to committee members at the Leadership Meeting. We will share key insights into the direction and goals of the organization over the next four years. This will prove highly beneficial as we plan for our committee objectives for the 2018 - 2019 term.

Indeed, next year begins a new committee term. The committee selection process is now complete and the number and quality of applicants is impressive. The committee structure will remain the same for the 2018 - 2019 term, and member volunteers have been notified of their assignments.

Lastly, 2017 is also a transition year with respect to international expansion. The Latin America and Caribbean Representative Office is up and running, the Europe Representative Office has added

new staff, and a new representative for Africa and the Middle East has been helping to grow the Association's network in these emerging regions.

A June delegation to southern Africa, detailed below in the Africa chapter, went a long way toward strengthening INTA's presence on the African continent and building relationships that will ultimately help to bolster IP protection.

In Latin America, INTA's Santiago, Chile Office, which began operating in May, has been powering through the summer with a number of trips around the region and preparations for "The Changing Landscape of Latin America Conference," which takes place in early October. This two-day conference promises to foster important discussions about the many economic and political changes occurring in the region, and their impact on IP.

As always, we hope you enjoy all of the content included in this issue of the 2017 *Global Report*, which is compiled from *INTA Bulletin* reporting during the past few months, with help from the Global Advisory Council's staff liaisons.

Africa	4
Asia-Pacific	8
China	12
Europe	16
India	20
Latin America	24
Middle East	28
North America	30

This report was compiled with the help of INTA's Global Advisory Councils, as well as the *INTA Bulletin* Committee and the authors named herein. Please direct all comments/feedback to [jdarne@inta.org](mailto:jdarne@inta.org).

**Global Report Staff**

- Chief Executive Officer**  
Etienne Sanz de Acedo
- Director, Marketing and Communications**  
Carol Steinberg
- Strategist, Communications Content**  
Eileen McDermott
- Manager, Communications**  
JC Darné
- Editor**  
Elizabeth Venturo
- Graphic Designer**  
Eric Mehlenbeck

**INTA Officers & Counsel**

- President**  
Joseph Ferretti, PepsiCo, Inc.
- President Elect**  
Tish L. Berard, Hearts On Fire
- Vice President**  
David Lossignol, Sandoz International GmbH
- Vice President**  
Ayala Deutsch, NBA Properties, Inc.

- Treasurer**  
Tiki Dare, Oracle Corporation
- Secretary**  
Zeeger Vink, Maus Frères
- Counsel**  
Maury M. Tepper, III, Tepper & Eyster, PLLC

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

© 2017 International Trademark Association

**WORKSHOP**

# **FREE TRADE ZONES: COMMERCE VS COUNTERFEITS**

Meet with brand owners, free trade zone authorities, government officials, and other key stakeholders for a one-day workshop focused on common challenges, best practices, and strategic solutions to combating the ongoing threat of counterfeits in free trade zones.

**November 29 | Berlin, Germany**

**For more information, visit [www.inta.org/2017FTZ](http://www.inta.org/2017FTZ)**



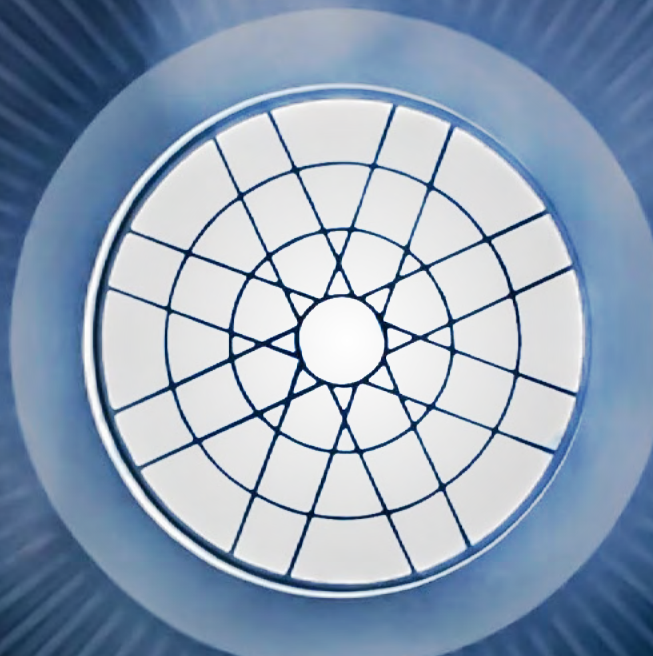
2018 Designs Conference:

# **The Power of Design**

**Save the Date!**

February 26-27, 2018

London, England





## Building New Partnerships



**Tat-Tienne Louembe, Representative, Africa and Middle East**

In June, keeping up the momentum created by INTA's first-ever major conference held in Cape Town, South Africa, an INTA delegation led by CEO Etienne Sanz de Acedo journeyed to Southern Africa to interact with local partners, government officials, private sector representatives, as well as the judiciary and academia, as covered in detail below.

In Zimbabwe and South Africa, INTA's CEO reiterated the Association's strong willingness to establish long-lasting, working relationships with key stakeholders. During the various meetings held, joint activities and policy dialogues with national trademark offices and policymakers were scheduled and will be organized before the end of this year. For instance, a training of examiners at Zimbabwe Intellectual Property Office (ZIPO) is being arranged alongside a high-level symposium

targeting government officials. Meanwhile, INTA is currently analyzing proposed legislative and regulatory developments in the region relating to trademark registration.

**In the weeks ahead, INTA, in collaboration with local partners, will organize a series of activities highlighting the nexus between economic diversification and intellectual property rights.**

A month later, from July 22 - 23, INTA representative for Africa and Middle East, Tat-Tienne Louembe, visited Nigeria (Lagos and Abuja), Cameroon (Yaoundé), and Switzerland (Geneva) to stress the Association's commitment to developing partnerships with key stakeholders supporting IP rights in Africa.

In West Africa, the visit was aimed at harnessing efforts with local members in view of encouraging the adoption of the Industrial Property Commission Bill, liaising with law enforcement agencies, such as the Nigeria Customs Service, and encouraging the tremendous work undertaken by INTA local members.

In Cameroon, INTA strengthened its partnership with the African Intellectual Property Organization (OAPI) and expressed support to join forces with its new Director General Denis L. Bohoussou. On the margins of the swearing in ceremony, Mr. Louembe interacted with key attendees, including Chairman of the OAPI Board, WIPO, OMPIC, and ARIPO,

government departments, the private sector, the judiciary, and academic institutions responsible for, or who have a stake in, the effective use of trademarks.

### Meetings in Harare, Zimbabwe

#### African Regional Intellectual Property Organization (ARIPO)

Fernando dos Santos, Director General of ARIPO, was pleased to receive Mr. Sanz de Acedo in his new, state-of-the-art headquarters

### Africa Global Advisory Council

#### Chair

Lara Kayode, O. Kayode & Company, Nigeria

#### Council Members

Barbara Berdou, Berdou Attorneys, South Africa

Anne-Marie Breek, Remgro Management Services Limited, South Africa

Brenda Kahari, B.W. KAHARI, Zimbabwe

Madelein Kleyn, Oro Agri Inc, South Africa

Stephen Le Feuvre, Lysaght, Channel Islands

William Mansfield, ABRO Industries, Inc., United States

Uche Nwokocho, Aluko & Oyeboade, Nigeria

#### Staff Liaison

Tat-Tienne Louembe, Representative, Africa and Middle East

[tlouembe@inta.org](mailto:tlouembe@inta.org)

practitioners, and current and future members, increasing the Association's visibility in a French-speaking area.

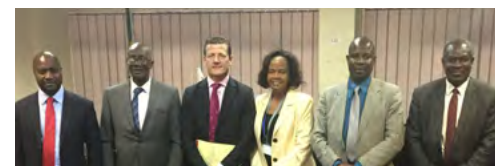
Finally, in Geneva, INTA reached out to WIPO's Africa Bureau to inquire about their activities on the continent and to explore ways to develop synergies. Subsequently, the two parties agreed to develop joint awareness and educational programs, fact finding missions, and to hold regular consultations.

In the weeks ahead, thrilled by the strong local enthusiasm and its members' dedication, INTA, in collaboration with local partners, will organize a series of activities highlighting the nexus between economic diversification and intellectual property rights.

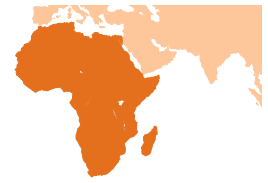
## Association Activities

### INTA Delegation Meets with Officials in South Africa and Zimbabwe

INTA CEO Etienne Sanz de Acedo and INTA Africa and Middle East Representative Tat-Tienne Louembe traveled to Southern Africa from June 24-28, visiting partner associations and government officials in Zimbabwe and South Africa. The goal of the trip was to reach out to members in the region, better understand the realities of the continent, and fine tune INTA's relationships with



From left to right: Fernando dos Santos, DG (ARIPO), Fidelis Maredza, Chief Registrar (ZIPO), Etienne Sanz de Acedo, CEO (INTA), Brenda Kahari, Partner (BW Kahari), Willie Mushayi, Deputy Chief Registrar (ZIPO), and Mr Emmanuel Sackey, IP Development Executive (ARIPO).



on June 26. The delegation toured the new building, visited the IT department, library, meeting rooms, and modern conference facilities. Mr. Sanz de Acedo noted the warm and congenial work atmosphere of the headquarters. He expressed INTA's interest in using the new facilities for conducting trainings, organizing informative sessions, and various activities aimed at raising the profile of intellectual property (IP) beyond southern Africa.

Mr. dos Santos briefed Mr. Sanz de Acedo on ARIPO's latest activities, including the first Intellectual Property Seminar for Universities held in Sierra Leone, which aimed to reach out to institutions of higher learning in Africa about using national and regional IP systems to foster economic development. ARIPO also held two roving seminars in Malawi focusing on the protection and promotion of patents, utility models, industrial designs, trademarks, and computer software through the ARIPO system and the economic benefits of copyright and related rights. The seminars also addressed the benefits of protection and utilization of traditional knowledge, genetic resources, and expressions of folklore to the people of Malawi and Africa in general.

Mr. dos Santos next introduced ARIPO's Masters Degree in Intellectual Property (MIP) and invited INTA to attend the award ceremony in December. They exchanged views on the upcoming ARIPO Ministerial Conference (ARIPO's annual conference), to be held the third week of November in Lilongwe, Malawi. The two parties agreed that INTA will have a speaking slot and discussed the possibility of organizing a side event followed by an evening reception. Welcoming the suggestion, Mr. Sanz de Acedo highlighted the importance of this high-level event as a venue to further the working relationship with ARIPO and to touch base with its board members, especially policymakers and government officials.

Mr. Sanz de Acedo introduced the idea of delivering tailor-made trainings to examiners from various IP offices and students involved in ARIPO's MIP, in partnership with ARIPO. In addition, he stressed that INTA, via its foundation, was ready to strengthen the MIP through scholarships and online module trainings, as well as various other INTA resources.

#### **Interactive Session with Various Stakeholders**

In a meeting with various stakeholders, including government representatives, local and potential members, ARIPO staff, and the press, Mr. Sanz de Acedo briefed the audience on his first visit to the region. He shared with the public INTA's strong determination to engage with several actors in order to strengthen the



From left to right: Fernando dos Santos, DG (ARIPO), Etienne Sanz de Acedo, CEO (INTA), along with government representatives, local and potential members, ARIPO staff, and the press.

importance of IP and demonstrate the danger of counterfeit goods to consumers and current and future business owners.

Mr. Sanz de Acedo provided the audience with background on INTA and stressed the need to increase the number of African companies among INTA's membership. He then noted with great interest the changing dynamics in the region and its economic potential, including Zimbabwe's contiguity to booming economies such as South Africa, Zimbabwe, and Botswana.

**Ms. Mabiza expressed the need to further the technical cooperation with INTA on various areas such as capacity building and training of public officials, policymakers, and examiners.**

Mr. Sanz de Acedo underscored the importance of strengthening the value of IP through educational programs and the link between IP and sustainable economic growth. He urged young business owners to liaise with ARIPO in order to protect their brands and to embrace international best practices.

#### **Permanent Secretary of the Ministry of Justice, Legal and Parliamentary Affairs**

Virginia Mabiza, Permanent Secretary of the Ministry of Justice, Legal and Parliamentary Affairs, welcomed the INTA delegation and emphasized the government's strong commitment to IP.

After briefing the Permanent Secretary on the purpose of his trip, Mr. Sanz de Acedo and Ms. Mabiza discussed general challenges related to IP, such as counterfeiting, consumer protection, and plain packaging. Mr. Sanz de Acedo again pointed out the economic potential of Zimbabwe and INTA's desire to increase the

membership of Africa-based companies.

Ms. Mabiza mentioned that Zimbabwe is part of several international treaties and expressed the need to further the technical cooperation with INTA on various areas such as capacity building and training of public officials, policymakers, and examiners. She reiterated the government's willingness to attend INTA events, such as the Annual Meeting and workshops, and to encourage local companies to join INTA.

#### **Chief Justice of the Supreme Court**

After welcoming the delegation, Luke Malaba, Chief Justice of the Supreme Court of Zimbabwe, noted with appreciation INTA's strong interest in Zimbabwe and Africa. He further described the central role and driving force of his office in enforcing and protecting IP-related matters. He emphasized that IP is a top priority for the government, as shown recently by the ratification of the Madrid Protocol.

Mr. Sanz de Acedo and his team congratulated the Chief Justice on his recent appointment. In acknowledging the importance of INTA, the Chief Justice mentioned various areas of potential collaboration as ways of strengthening the technical capacity of his office. The two parties agreed on such an approach.

#### **The Zimbabwe IP Office**

Fidelis Maredza, Chief Registrar of the Zimbabwe Intellectual Property Office (ZIPO), was pleased to meet with the INTA delegation. After a brief presentation of ZIPO, Mr. Maredza stressed the need to raise awareness on IP-related issues, with an emphasis on economic growth. He pointed to the willingness of the government to ratify most of the international treaties in view of strengthening the country's policies.

Mr. Maredza then discussed the urgency of enhancing ZIPO's operational capacity through training of examiners (on opposition, for instance), participation in INTA awareness programs, and review and revision of strategic documents.

continued on page 6



## Association Activities continued from page 5

Mr. Sanz de Acedo welcomed the opportunity to assist ZIPO and offered INTA's assistance in delivering trainings on a yearly basis in order to improve examiner qualifications. He agreed on the importance of a solid IP architecture as a way to attract foreign direct investments and to create jobs.

### Meetings in Pretoria, Johannesburg, South Africa

#### South African Institute of Intellectual Property Law (SAIPL)

On June 27, Mr. Sanz de Acedo met with Vicky Stilwell, President of the South African Institute of Intellectual Property Law (SAIPL). SAIPL represents more than 187 patent attorneys, patent agents, trademark practitioners, and academics in South Africa. Ms. Stilwell thanked Mr. Sanz de Acedo for coming and emphasized her desire to organize regular meetings and workshops between INTA and SAIPL. She recalled SAIPL's participation in INTA's first-ever conference in Africa, "Building Africa with Brands," organized in September 2016. Many SAIPL members participated in the event and felt proud to contribute.

Ms. Stilwell also briefed INTA on the latest IP developments in the region, such as review of the copyright law, and reviewing and providing substantive comments on the Intellectual Property Consultative Framework. In September 2016, SAIPL representatives attended a workshop on the Framework organized by the Department of Trade and Industry (DTI), the United Nations Development Programme (UNDP), and the United Nations Conference on Trade and Development (UNCTAD).

After acknowledging SAIPL's various achievements, Mr. Sanz de Acedo introduced INTA and explained its strong commitment to raising awareness about IP in Africa, with a strong emphasis on job creation. He mentioned that Africa remains a priority for INTA and welcomed partnerships on various issues, including counterfeiting and consumer protection. Mr. Sanz de Acedo referred to several of INTA's initiatives, such as the Unreal Campaign (a counterfeit awareness initiative designed to educate teenagers) and the September 28 Dubai Free Trade Zones Workshop: Commerce vs. Counterfeits.

#### Companies and Intellectual Property Commission (CIPC)

Mr. Sanz de Acedo's visit with the Companies and Intellectual Property Commission (CIPC) was greatly appreciated by CIPC officials. The



From left to right: Fleurette Coetzee, Senior Manager, Trademarks (CIPC), Amanda Loetherigen, Senior Manager IP Enforcement (CIPC), Etienne Sanz de Acedo, CEO (INTA), and Vanessa Ferguson, Senior Director Trade Mark Attorney Head of Trade Mark & Anti-Counterfeiting Department (Kisch IP).

CIPC officers in attendance agreed to intensify the collaboration with INTA in both awareness and law enforcement areas through training of examiners and customs officials, review of major documents, and data collection.

Furthermore, INTA was invited to join the World Intellectual Property Organization (WIPO), the World Customs Organization (WCO), INTERPOL, and the CIPC in organizing a conference in 2018. Since it is still at a preliminary stage, it was agreed that the CIPC would share more information on INTA's expected role in the 2018 conference, to be organized in Pretoria.

In addition, CIPC officials expressed strong interest in partnering with INTA in a summer school sensitization campaign targeting youth. Mr. Sanz de Acedo described the success of the Unreal Campaign and welcomed collaboration in this area.

Mr. Sanz de Acedo concluded by noting the CIPC's important contributions to the field of IP.

#### South African Revenue Service (SARS) Customs Administration

Mr. Sanz de Acedo briefed customs officials on the purpose of his visit to South Africa and mentioned INTA's interest in building a solid working relationship with South African authorities on anticounterfeiting and enforcement of trademarks. He presented INTA's 2018 - 2021 Strategic Plan and inquired about the mission and priorities of the South African Revenue Service (SARS) Customs Administration.

According to Vuledzani Madima, National Coordinator in charge of IP rights, the SARS Customs Administration provides border control management, community protection, and industry protection; administers trade policy

measures and industry schemes; and collects revenue. Mr. Madima praised the cooperation among customs, attorneys, and the private sector in anticounterfeiting and law enforcement.

The customs officials expressed their willingness to cooperate with INTA in order to boost their operational capacities, including improving intelligence, building skills through sharing best practices, and strengthening IP rights.

INTA would like to acknowledge the tremendous support provided by its volunteer members. The INTA delegation also expresses its thanks to the many officials who took the time to meet, as well as for the warm welcome and the outstanding discussions. INTA looks forward to cooperating in the near future on examiner trainings, awareness programs, and various other activities. These meetings have set the stage for a creative and constructive collaboration between INTA and IP authorities across Africa.

#### Unreal Student Engagement Session Held in Nigeria

On Thursday June 8, 2017, a student presentation was conducted at a GR8 School located in the Ajah area of Lagos state by Lara Kayode (O. Kayode & Co., Nigeria), Chair of the Unreal Campaign Committee of Africa and Asia.

The presentation, made before 20 students ranging from 12 to 16 years old, had as its objective the sensitization of teenagers to the importance of trademarks and intellectual property and to the dangers of patronizing sellers of counterfeit products.

Students in attendance displayed a high level of interest in the topics presented and participated eagerly in a brief quiz held toward the end of the 45-minute presentation. There was



Lara Kayode (O. Kayode & Co., Nigeria) presents the Unreal Campaign to students in Lagos, Nigeria.

visible enthusiasm among the students. Such a positive student response suggested that a lot had been learned during the session.

Based on the student reaction, we can say that this is another achievement for INTA's Unreal Campaign Committee in Nigeria, in terms of creating awareness in young people of the importance of brand protection and the negative implications of counterfeiting and piracy.

Thank you to our 2017 Unreal Campaign sponsors for making these events possible. Please visit [inta.org/unrealcampaign](http://inta.org/unrealcampaign) to learn more.

## In the News

### **KENYA: Practice Amendments Relating to the Removal of Trademarks for Non-Renewal**

The Registrar of Trademarks in Kenya issued a practice notice on June 30, 2017, regarding the removal of trademarks for non-renewal.

Registered trademarks in Kenya are renewed by submitting an application and paying a prescribed fee. The Kenyan trademark rules provide that where the renewal fee has not been received on the due date, the Registrar must publish the removal of the trademark from the register for non-renewal. However, prior to the publication of a mark, the legislation requires the Registrar to issue a 60-day notice for removal of the trademark to the registered proprietor of the trademark. The Registrar is also given the

discretion to issue a further 30-day notice to the registered proprietor of the trademark.

Under the terms of the practice notice of June 30, 2017, the Registrar has now resolved to discontinue the practice of issuing a further 30-day notice.

The practice notice also states that where registration of a later trademark application is refused by an examiner as a result of the existence of an earlier non-renewed trademark for which a 60-day notice has not yet been issued, the examiner should ensure that the notice is immediately issued and in the provisional refusal letter inform the applicant (of the later trademark application) of the date of the notice

so that the applicant can determine when the 60-day period will expire.

This practice notice is welcomed, given that there are numerous trademarks on the Kenyan register that have not yet been removed, despite non-renewal, and should make it easier for applicants to overcome citations of such registrations.

**Contributor: Ilse du Plessis**

ENSafrica, Stellenbosch, South Africa  
Co-Chair, INTA Bulletins Law & Practice—Middle East & Africa Subcommittee

**Verifier: William Maema**

Iseme, Kamau & Maema Advocates, Nairobi, Kenya

### **SOUTH AFRICA: Trademark Office Issues Examination Guidelines**

The South African Companies and Intellectual Property Commission (CIPC) issued Guidelines on the Examination of Trade Mark Applications (the Guidelines) on February 28, 2017. The Guidelines are extensive in their scope, running the trademark applicant through the formalities of filing, examination procedures, substantive examination, the procedure after examination, and other related matters.

The purpose of the Guidelines is to assist trademark examiners in the process of substantively examining trademark applications, as well as to assist in the training of examiners. The CIPC stresses that the Guidelines serve mainly as an internal training manual within

the Trade Marks Office. However, the Trade Marks Office is aware of the fact that the Guidelines may serve as a main point of reference for trademark applicants to ensure that they have the latest information regarding the Trade Mark Office's examination procedures.

In the introduction section to the Guidelines, Fleurette Coetzee, Senior Manager of the CIPC's Trade Marks Division, emphasizes that the Registrar strives to align its internal practices with the needs and requirements of trademark applicants, recognizing the potential for the development of trademark law and the Trade Mark Office's pivotal role in this development.

Ms. Coetzee specifically states that, insofar as examinations of trademark applications are

concerned, the Registrar of Trade Marks aims to ensure that the trademarks on the Register perform the basic function of a trademark, i.e., to protect the public against potential confusion between trademarks and, as far as possible, ensure the integrity of the National Trade Marks Register.

The Guidelines can be accessed [here on the CIPC's website](#).

**Contributor: Brendon Ambrose**

Spoor & Fisher, Pretoria, South Africa

**Verifier: Fleurette Coetzee**

Companies and Intellectual Property Commission (CIPC), Pretoria, South Africa

### **SOUTH AFRICA: Trademark Office Issues Notice on Acceptances**

The South African Companies and Intellectual Property Commission (CIPC) issued a Notice on June 5, 2017, stating that, as of that date, Trademark Notices of Acceptance would be

issued electronically and sent to the email address of the customer code reflected on the trademark application.

The Notices of Acceptance will also be available online.

**Contributor: Stephen Goldberg**

Spoor & Fisher, Pretoria, South Africa  
INTA Bulletins Law & Practice — Middle East & Africa Subcommittee

**Verifier: Fleurette Coetzee**

Trade Marks Division, CIPC, Pretoria, South Africa



## Asia-Pacific Office Celebrates One Year Anniversary



**Seth Hays, Chief Representative Officer, Asia-Pacific**

INTA celebrated the first anniversary of the establishment of its Asia-Pacific Branch Office in March. Since its founding in March 2016, the Asia-Pacific office has been pursuing its goals of serving a growing membership in the region through increased service offerings, communications, and policy advocacy.

### Increasing Membership, Annual Meeting Attendance, and Regional Activity

INTA's membership in the Asia-Pacific region rose to 1,020 in 2016, with significant increases in corporate membership, which saw a rise of 18 percent.

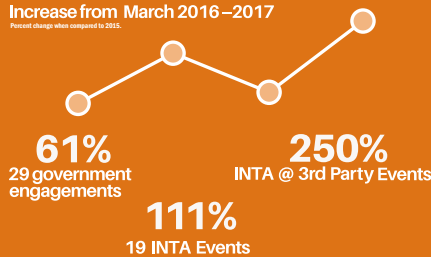
Compared to calendar year 2015, INTA has also seen a rise in activity in the Asia-Pacific region since opening its office. INTA has engaged governments in the region a total of 29 times, through delegations, policy dialogues, or attendance at government-hosted events—an increase of more than 61 percent over the year prior.

INTA events in the region are also up 111 percent—having hosted 19 receptions, education roundtables, seminars, and conferences—compared to nine events in the previous year.

## 1<sup>st</sup> Anniversary INTA Asia-Pacific Office

### Activity

Increase from March 2016–2017  
Percent change when compared to 2015.



### Membership

1020 total Asia-Pacific Members

18% Increase in corporate members 2015–2016



### Highlights

- 4 Submissions on Brand Restrictions
- Audience with ASEAN Working Group
- 4 Leadership Delegations to Singapore, Malaysia, Japan and China

The value of a regional office is most clearly seen in the number of third-party events in which INTA has been asked to participate, which rose by 250 percent. INTA was invited to participate in only six events held by third-party non-government organizations in 2015, but

### Asia-Pacific Global Advisory Council

#### Co-Chairs

Mona Lee, Hanol Law Offices, South Korea  
Kowit Somwaiya, LawPlus Ltd., Thailand

#### Council Members

Louis Chan, Procter & Gamble, Singapore  
Daniel Greif, Spruson & Ferguson, Singapore  
Marion Heathcote, Davies Collison Cave, Australia  
Patsy Lau, Deacons, Hong Kong  
Andy Leck, Baker McKenzie, Wong & Leow, Singapore  
Shunji Sato, TMI Associates, Japan  
Thomas Treutler, Tilleke and Gibbins, Vietnam  
Jay Young-June Yang, Kim & Chang, South Korea  
Christopher Young, Minter Ellison Rudd Watts, New Zealand

#### Staff Liaison

Seth Hays, Chief Representative Officer: Asia-Pacific  
[shays@inta.org](mailto:shays@inta.org)

accepted invitations to 21 events in the 12 months after opening the Asia-Pacific office.

Additionally, the quality and quantity of policy advocacy has increased since opening the office. INTA has made ten written submissions around the region, compared to five in the previous calendar year. INTA also saw some of the most active partnerships from governments in the region, with the Vietnam Ministry of Science Technology co-hosting two seminars with INTA in 2016 as part of an ongoing project to research the well-known marks protection regime in Vietnam under a 2015 memorandum of understanding. Another significant event was INTA's audience with the ten IP offices of the ASEAN countries at the Working Group on IP.

## Association Activities

### INTA Deepens Regional Ties: South Korea

Recent news and INTA activity in South Korea exemplify the growing importance of the Asia-Pacific region to INTA and the brand owner community.

The Korean IP Office (KIPO) ranked first in the trademark category on the 2017 Global IP Index report issued by the U.S. Chamber of Commerce's Global IP Center, scoring 6.55 out of 7 on the trademark portion of the index

scorecard. This outperformed runner-up countries Sweden, Switzerland, and Germany, all of which scored 6.5.

INTA has been deepening ties with KIPO over the last several years, most recently with an





education roundtable on March 3, 2017, in Seoul. More than 50 INTA members, non-members, leading Korean brands, and government officials attended the event, titled “Practical Tips from the Trademark Office.”

INTA Board Member and Asia Roundtable Taskforce Chair Mona Lee (Hanol Law, South Korea) said that KIPO’s interest in serving the trademark community was made obvious by the attendance of six of its officers, including the Director General for Trademarks & Designs, Choi Gyuwan. “It is my hope that the KIPO will continue to co-sponsor roundtables on a regular basis into the future,” said Ms. Lee.

As one of Asia’s leading brand hotspots, with several brands climbing global rankings, South Korea is a priority jurisdiction for INTA

membership recruitment efforts.

INTA will welcome a delegation from KIPO to this year’s Annual Meeting for engagement with committees and attendees.

For more information on the Asia-Pacific Branch Office, contact Seth Hays, Chief Representative Officer, Asia-Pacific, at [shays@inta.org](mailto:shays@inta.org).



Attendees of the INTA-KIPO Education Roundtable, “Practical Tips from the Trademark Office,” held in South Korea in March.

## Association Convenes Asia-Pacific Stakeholders in Barcelona

INTA welcomed delegations from eight Asia-Pacific jurisdictions to the Annual Meeting in Barcelona this year from across a wide spectrum of government stakeholders, including IP offices, customs, judiciary, and IP rights enforcement agencies. IP Offices from Japan, Korea, China, Hong Kong, Vietnam, Singapore, Australia, and New Zealand engaged members through committees, and learned valuable insights from other IP offices at the Annual Meeting’s IP Office Workshop. Judges from Japan, China, and Vietnam participated in a panel session and engaged in closed-door discussions with peers from other jurisdictions. IP rights enforcement agents from China’s Ministry of Public Security, Hong Kong

Customs, and Vietnam’s Ministry of Science Technology Inspectorate also engaged INTA committees and Annual Meeting attendees at numerous events.

Immediately following the Annual Meeting, INTA’s policy committee jumped back to work, submitting comments to Singapore Customs on proposed amendments that could stymie brand owners’ efforts to combat the trade in counterfeit goods through transshipment via Singapore’s ports.

INTA’s Asia-Pacific Chief Representative, Seth Hays, and members from Vietnam participated in a meeting with the Ministry of Science Technology Inspectorate in Vietnam on June 30 to discuss the future for a memorandum of

understanding ([MOU](#)) currently being executed between the parties. The MOU comes to an end this year, and future work plans, objectives, and goals are being explored for a possible extension. The existing MOU has focused on improving the existing state of Vietnam’s well-known marks recognition regime. The MOU resulted in a research paper to be released this year, three high-level conferences with stakeholders across the Vietnamese government and industry, as well as numerous recommendations for improvements to the existing system in Vietnam.

Members interested in participating in any future MOU activities in Vietnam should contact INTA’s Chief Representative, Seth Hays, at [shays@inta.org](mailto:shays@inta.org) for more information.

## Interviews

### INTA Launches New Moot Court Competition in Asia-Pacific

Building upon the success of the Saul Lefkowitz Moot Court Competition, which has been held annually in the United States for the past 26 years, INTA will launch a new moot court competition in the Asia-Pacific region early next year. The event will be held in Singapore in February 2018 and is open to all students outside the United States. Read [the full interview](#) in the *INTA Bulletin*.

“We wanted to make this a more practical and well-rounded training that will prepare students for real life in the IP world, so we’re going to include training in media presentation skills. Be-



Karina Dimidjian-Lecomte  
(Casalonga Avocats, France)



Stacey Watson (Markery Law,  
LLC, USA)



Karen Fong (Collyer Bristow,  
United Kingdom)

sides being extremely helpful for practicing advocacy, media training is useful for everyone. There will also likely be a career panel, a

networking event, and then the competition, followed by a dinner.” — Karen Fong



## Interviews continued from page 9

### Ang Pich, President, Intellectual Property Association of Cambodia (IPAC)

Since being elected President of the Intellectual Property Association of Cambodia (IPAC) in February 2017, Ang Pich (Pich & Partners Law Office, Cambodia) has been busy motivating IPAC members to help improve the situation for IP owners in his country. IPAC was formed in 2014 with the purpose of promoting IP rights to help further the social, economic, and cultural development of Cambodia. IPAC has held various events and lectures across the country and is now seeking partnerships with international IP organizations such as INTA to help expand its reach and improve resources for its members.

Mr. Pich spoke with the *INTA Bulletin* about IPAC, the challenges faced by IP owners in Cambodia, and the impact so far of the country's recent decisions to join the Hague and Madrid Systems. Read [the full interview](#) in the *INTA Bulletin*.

### IPAC

**President:** Ang Pich  
**Membership:** 120, with 66 founding members  
**Registered:** June 13, 2016  
**Inaugurated:** August 17, 2016



Ang Pich, President, Intellectual Property Association of Cambodia (IPAC)

### Patricia Kelly, Director General, IP Australia

Patricia Kelly has served as Director General (DG) of the Australian IP office (IP Australia) since 2013, and has been with the office's parent department, the Department of Industry and Innovation, since 1995. In her previous role, she focused on IP policy issues, but since taking on the role of DG, she has had to get up to speed on the operational challenges facing the office—particularly since demand for trademarks has been growing recently. Her term is not fixed, so she has settled down for the long haul to help IP Australia function as efficiently as possible for both users and examiners alike.

Ms. Kelly spoke with the *INTA Bulletin* about some of the upcoming improvements users can expect from IP Australia and what challenges the office faces. Read [the full interview](#) in the *INTA Bulletin*.

### IP Australia

**Headquarters:**  
Discovery House  
47 Bowes Street  
Phillip, ACT 2606  
Australia

**Head of Trademarks:**

- Deputy Director General & Registrar of Trade Marks — Ms. Fatima Beattie
- Deputy Registrar and General Manager of Trade Marks — Ms. Celia Poole

**Number of Trademark Examiners:**  
93, and 31 trainee examiners

**Total Filings:**  
June 2016 – 2017: 72,621 applications



Patricia Kelly, Director General, IP Australia

## In the News

### BRUNEI: Counterfeit Raid Results in Seizure of More Than 1,000 Fake Products

On Tuesday, March 14, 2017, Brunei took its first tentative steps toward ridding itself of counterfeit products when three branches of a local department store were simultaneously raided in Bandar Seri Begawan for over 1,000 counterfeit razors and razor blade products.

The raid for the counterfeit consumer goods, believed to be the first anticounterfeiting action in the sultanate, was carried out by 26 Royal Brunei Police Force (RBPF) officers from the Commercial Crime Unit, including three Crime

Scene Unit teams, in response to a complaint filed by the relevant trademark owner.

The targeted shops were alleged to be selling counterfeit disposable razors and razor blades bearing an international and well-known brand. If convicted, the alleged perpetrators would be facing up to five years' imprisonment and a maximum BN \$100,000 (US \$72,000) fine under Section 100 of the Trade Marks Act, Chapter 98.

During the raid, police officers seized 1,106 various imitation products, while represen-



Officials analyze goods at a shop accused of selling counterfeits in Bandar Seri Begawan, Brunei.



tatives from the Brunei branch of Singapore-based law firm Harry Elias & Partnership LLP (HEP) observed and assisted in the operation.

The raid was also in line with the RBPF Commercial Crime Unit's move to expand their operations in order to more aggressively crack down on traders peddling counterfeit products

and enforce intellectual property laws in the country beginning this year.

At the same time, HEP had also been expanding its IP portfolio in recent months as it looks to increase its IP-related activities in the oil-rich country.

With the Bruneian government eager to woo

foreign direct investment in recent years in an effort to diversify the economy away from its heavy dependence on the oil and gas sector, the move toward clearing out branded fakes currently perforating through the local market could be seen as a vital step in increasing the attractiveness of Brunei as a potential destination for foreign companies, while also raising confidence among local consumers.

## NEW ZEALAND: Supreme Court Gives and Takes Away

The New Zealand Supreme Court has ended a lengthy dispute between Lacoste and Crocodile International by revoking one of Lacoste's registered trademarks for non-use: see *Crocodile International Pte Ltd v. Lacoste*, [2017] NZSC 14.

The Court restored the status quo as to the test for whether use of a trademark different from its registered form will nevertheless be regarded as use of the registered trademark under Section 7(1)(a) of the Trade Marks Act 2002. However, the Court also decided, contrary to the historical position, that there is no residual discretion under Section 66(1) to keep an unused mark on the register.

Lacoste's registered mark was



Lacoste conceded it had never used the mark, but argued that its use of the marks



and



**LACOSTE**

constituted use of the registered mark, being "use in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was registered" under Section 7(1)(a).

The Assistant Commissioner of Trade Marks had ruled after a standard and relatively detailed analysis of the differences between the marks as used and the registered mark, that the used marks did differ in elements that altered the distinctive character of the registered mark.

On appeal, the High Court overturned this decision on the basis that the points of difference were insignificant and the visual and conceptual message associated with each of the three marks was "distinctively similar." The Court of Appeal agreed with the High Court on the basis that the crocodile was the "central message" of the three marks and so the differentiating features between them did not alter the distinctive character of the registered mark. As the Court of Appeal put it, "it's all about the crocodile."

On appeal, the Supreme Court confirmed a two-stage test applies in determining whether differences alter the distinctive character of a mark. The Court decided it was implicit in the test that the distinctive character of a mark must be identified before it is possible to analyze whether any additions, alterations, or deletions have altered that distinctive character. The Court further explained that the distinctive character of a mark must be identified with reference to its "elements," in line with the statutory language in Section 7(1)(a), rather than the broader "central idea" and "central message" favored by the lower courts.

Applying this more granular approach, the Court described the distinctive character of the registered mark as having two essential visual elements: the stylized word and the crocodile device.

The Court characterized the differences in the direction of the crocodile's poses as minor. In

contrast, the lack of a depiction of the word "crocodile" in a cursive script and the differences between the stylized representation of the crocodile in the used marks and the realistic representation of a crocodile in the registered mark were "significant."

The Court commented that the absence of one of the essential visual elements of a mark would likely mean that the distinctive character was altered and that the addition of the significant differences in the depiction of the crocodile in this case made such a conclusion inescapable.

As to whether there was a residual discretion under Section 66(1) to retain an unused mark on the register, the Court ruled that despite previous case law, no such discretion exists. Central to this conclusion was the fact that the 2002 Act had been drafted and enacted in the knowledge that the same words in the precursor UK statute had been interpreted as not including a residual discretion.

The decision restores and clarifies the previous relatively granular test for judging whether use of a trademark different from a registered trademark will nevertheless be regarded as use of the registered trademark under Section 7(1)(a). However, the finding that there is no residual discretion to allow an unused mark to remain on the register is new and will require owners to be more vigilant if they wish to protect their unused registered marks from removal for non-use in the future.

**Contributors: John Glengarry and Elizabeth Horvath**

Buddle Findlay, Auckland, New Zealand

**Verifier: John Hackett**

Partner, AJ Park, Wellington, New Zealand



## INTA Builds Upon its Successes in Barcelona



**Seth Hays, Chief Representative Officer, Asia-Pacific**

The Annual Meeting in Barcelona broke a number of records for INTA. For one, this year the Association welcomed the largest delegation of Chinese government officials to any Annual Meeting to date. Among them were representatives from the Commerce's China Trademark Office (CTMO), Trademark Review and Adjudication Board (TRAB), Supreme People's Court (SPC) IP Tribunal, and the Ministry of Public Security (MPS) Economic Crime Investigation Department.

INTA was pleased to also have many of the Chinese delegates participate in a number of

events during the Annual Meeting. The SPC joined a judicial panel session, which included judges from jurisdictions across the globe. CTMO and TRAB officials joined the closed-door IP Office Workshop, and also interacted with INTA's China Subcommittee of the Trademark Office Practices Committee. The MPS was able to address a dedicated audience of brand owners and Annual Meeting attendees.



QBPC Chairman Jack Chang (l.) and INTA President Joe Ferretti (r.)

As covered in the *INTA Daily News*, at the Annual Meeting, INTA and the Quality Brands Protection Committee (QBPC) renewed a cooperation agreement for the next three years. QBPC Chairman Jack Chang and INTA President Joe Ferretti (pictured below) signed the agreement on behalf of their respective organizations.

## In the News

### Trademarks and the One Belt One Road

INTA's China Office participated in the China Trademark Association's Trademark Festival in Guilin, China, September 1-4. As part of the program, INTA organized a panel session on trademark protection along the global infrastructure and investment area known as the One Belt One Road (OBOR), spanning the Eurasian continent, Africa, and Southeast Asia.

**OBOR could reach 64 countries, 4.4 billion people, and around 40 percent of the global economy.**

### China Global Advisory Council

#### Co-Chairs

Longbo Li, Unitalen Attorneys at Law, China

He Jing, Anjie Law Firm, China

#### Council Members

Bai Gang, Wan Hui Da Intellectual Property Agency, China

George Chan, Simmons & Simmons (Beijing) Intellectual Property Agency Company Limited, China

Ding Xianjie, King & Wood Mallesons LLP, China

Feng Zhen, Hogan Lovells International LLP, Shanghai

Liao Fei, King & Wood Mallesons LLP, China

Shen Chunxiang, NTD Patent & Trademark Agency Ltd., China

Zhou Fang, China Telecom, China

Iris Chao, Johnson & Johnson, China

Scott Palmer, Sheppard Mullin Richter & Hampton LLP, China

Sam Xu, Tencent Technology (Shenzhen) Co., Ltd., China

#### Staff Liaison

Seth Hays, Chief Representative, Asia Pacific Office, [shays@inta.org](mailto:shays@inta.org)

INTA looks forward to a busy remainder of 2017, with numerous activities for members in China. INTA is also exploring joint activities for members on priority policy issues such as cross-border enforcement and online anti-counterfeiting.

### What Is OBOR?

OBOR is the massive infrastructure and trade strategy led by China spanning the regions covered by the old Silk Road land routes (Land Belt) and the ancient maritime trade routes (Maritime Road) through Southeast Asia, South Asia and Africa, and Europe. Some estimates put the potential investment figures at 12 times the Marshall Plan that rebuilt Europe at the end of World War II. OBOR could reach 64 countries, 4.4 billion people, and around 40 percent of the global economy.



## INTA Works with Local Partners in Industry and Government

INTA was invited to a meeting of the Quality Brands Protection Committee (QBPC) in April. The meeting hosted officials from Guangdong Customs and from the Ministry of Public Security (MPS). INTA and QBPC signed a cooperation agreement in 2014, and look forward to working closely on education and policy initiatives as momentum picks up in China to address the issue of counterfeiting.

INTA will be working with the Chinese government authorities on several initiatives as well. INTA staff met with officials from the General Administration of Quality Supervision, Inspection and Quarantine of the People's Republic of China (AQSIQ) at the Hangzhou E-Commerce Risk Monitoring Center. This national center, founded in 2014, is charged with assisting in the investigation of dangerous goods in online channels of commerce, including many dangerous counterfeit goods. The

AQSIQ visited with INTA brand owners at INTA's headquarters in New York in May.

INTA also received the Vice Minister of the State Administration of Industry and Commerce (SAIC), Liu Junchen, at the Association's New York headquarters. INTA presented its research efforts on brands and innovation and invited members to speak about brand ranking and valuation, as well as explained the role INTA plays in Washington, D.C.

## In the News

### Working Closely with China to Combat Counterfeits

According to [a report](#) in the Chinese newspaper *Xinhuanet*, the head of the National Leading Group on the Fight Against IPR Infringement and Counterfeiting, Vice Premier Wang Yang, noted at a conference on April 11 that China convicted 18,000 intellectual property rights (IPR) infringers, having investigated over 200,000 cases. He said that, in the coming year, authorities will concentrate on six main points in the fight against counterfeits and IPR infringement: (1) monitoring online counterfeiting sales; (2) cleaning up rural markets; (3) ensuring that cross-border trade to "Belt and

Road" countries is prioritized; (4) ensuring further adoption of authentic software; (5) improving the e-commerce laws by increasing penalties and standards for infringement; and (6) speeding up the adoption of the "credibility system."

This statement comes after Premier Li Keqiang at his Annual Government Work Report to the National People's Congress emphasized the country's strategic priority of pushing for innovation and improvements in quality production. Premier Li said the government will "improve the system for creating, protecting, and applying intellectual property rights." Reflecting

on the nature of quality, and personal innovation he said, "The spirit of quality resides in craftsmanship."

**Premier Li said the government will "improve the system for creating, protecting, and applying intellectual property rights."**

### China's Supreme People's Court Issues New Judicial Regulations

*Trademark Office Practices Committee—China Subcommittee*

The Judicial Committee of the Supreme People's Court issued new Regulations on Several Issues Concerning the Trial of Administrative Cases Involving the Granting and Confirmation of Trademark Rights (2017 Regulations) on December 12, 2016, which became effective on March 1, 2017.

The 2017 Regulations apply to the review of administrative decisions by the Trademark Review and Adjudication Board (TRAB) that are brought before the Beijing IP Court and Beijing Higher People's Court. Such decisions involve issues including trademark application rejections, reviews of decisions involving successfully opposed marks, non-use cancellations, and the review of invalidation decisions. The 2017 Regulations will be useful to trademark practitioners in China because they seek to clarify a

number of issues that have been the subject of inconsistent review by the trademark office (TMO), the TRAB, and the People's Courts under the PRC Trademark Law.

Some of the more important clarifications in the 2017 Regulations include the following:

- An application to register the name of a public figure who is known in the fields of politics, economics, culture, religion, or representing a particular ethnic group can be rejected as a mark that has "other adverse effects" under Article 10(1)(8) of the People's Republic of China Trademark Law.
- Trademarks that contain the names of certain PRC administrative areas or publicly known foreign place names are registrable if they contain additional elements and are otherwise distinguishable from the place name in question.
- When reviewing foreign language marks, the doctrine of foreign equivalents will not serve as a bar to registration if relevant consumers

are likely to have little or no awareness of the meaning of a foreign term, and the mark can nevertheless serve to distinguish the source of goods (Article 8).

- Three-dimensional (3D) signs that consist solely of the shape of goods or a part thereof can be registrable upon a showing of acquired distinctiveness.
- Marks that suggest the characteristics of goods or services are registrable if they can serve as a source identifying function to relevant consumers.
- The subjective intent of a trademark applicant is relevant to a finding of "likelihood of confusion" when determining whether a mark should be protected as an unregistered well-known mark in a dispute against a third-party application for an identical or similar mark covering similar goods (Article 12).
- The prohibition of the unauthorized registration of trademarks by agents or representatives also extends to trademark applicants

continued on page 14



## In the News continued from page 13

that have a “special personal relationship such as kinship, etc.” with those agents or representatives (Article 15).

- Article 15(2) of the PRC Trademark Law provides that when a trademark applicant has a contractual or business relationship or “any other relationship” with the prior user of an unregistered trademark, and that applicant files a trademark that is the same or similar to that third party’s prior unregistered trademark for the same or similar goods, then an opposition against such an application should be supported by the TMO.
- The protection of a geographical indication (GI) can extend to goods that are not traditionally associated with the relevant geographical area (or covered by a registration for a collective or certification mark) provided that there is evidence that use of the disputed trademark on such goods will cause consumers to mistakenly believe that the goods originate from that region and thus have the qualities, reputation, or other characteristics associated with that GI (Article 17).

- The first clause of Article 32 of the PRC Trademark Law provides that applications for the registration of a trademark “may not prejudice the existing right of priority” of another, and copyright is one such priority right.
- The right of priority afforded to name rights under the PRC Trademark Law also applies to pseudonyms, stage names, translated names, etc., provided that the subject name can be shown to possess a definite degree of fame, has established a stable corresponding relationship with a specific natural person, and is used by the relevant public to refer to that person (Article 20).
- A right of priority will also be recognized for the names of copyright protected works and names of characters within copyright protected works provided that the names have obtained a rather high degree of fame, and use of the names will cause the relevant public to assume a license or other relationship with the rights holder (Article 22).
- The second clause of Article 32 of the PRC Trademark Law provides that “improper

means may not be used to preemptively register a third party’s trademark that is already in use and has a certain degree of influence.”

For a more detailed description of the regulations, [read the full report](#) in the *INTA Bulletin*.

An unofficial translation of the 2017 Regulations prepared by the Trademark Office Practices Committee (TOPC), China Subcommittee, can be found under the Reports section [here](#).

The 2017 Regulations were issued within days of the issuance of new Trademark Examination and Review Standards by the SAIC. The new examination and review standards are extremely detailed and appear to support and augment the 2017 Regulations. INTA and the TOPC—China Subcommittee will be preparing a detailed summary and translation of the new examination and review standards, which will be available to INTA membership in a separate publication later in 2017.

### Cyber Security Law: Reinforcing the Great Firewall

On June 1, 2017, the recently passed Cyber Security Law (the Law) came into effect in China. The Law is widely applicable to all entities with Chinese operations, and in many

ways simply codifies traditional government restrictions on Internet usage. In general, the new Law tends to reinforce the Chinese government’s determination to maintain Internet safety and national security, while protecting

the domestic public’s interests through censorship and regulations. For a full summary of the changes, read the full report on the [INTA Blog](#).

### China’s Top Government and Industry Leaders: Stricter Penalties for Counterfeiting Needed

In March, the top policy-making bodies in China met for the annual “Two Sessions” or liang hui in Beijing.

In his Annual Government Work Report to the National People’s Congress, Premier Li Keqiang said the government will “improve the system for creating, protecting, and applying intellectual property rights.” Premier Li placed a heavy emphasis on innovation and improved quality. The annual report signals the government’s policy priorities and strategic vision for the coming year.

At a press conference on the sidelines of the liang hui, State Administration of Industry and Commerce (SAIC) Minister Zhang Mao also called for stricter punishment of counterfeiting.

Weeks before, Alibaba’s founder, Jack Ma, made headlines when he stated that in cases against counterfeiters China’s government should enact criminal penalties as stringent as China’s drunk driving laws. Noting that China’s criminal code dates from the late 1990s, Mr. Ma recommended a sensible revision of the law.

Mr. Ma was not alone in his call for reform. Lenovo founder Liu Chuanzhi called for the Chinese government to “increase the cost of counterfeiting” through stricter laws.

Xiaomi founder Lei Jun also joined the chorus, calling fakes “a cancer” and saying that counterfeiters seriously damage the image of the country.

Liu Yonghao, the chairman of New Hope, a major Chinese agribusiness firm, also called for resistance against counterfeits, mentioning that counterfeits negatively impact innovation.



## Court Imposes Highest Statutory Penalty for Refusal to Abide by Injunction

On August 1, 2016, New Balance brought five defendants to Suzhou Intermediate People's Court on charges of unfair competition for using New Balance's unique trade dress—which consists of the letter "N" on both sides of sports shoes—without prior authorization. The five defendants included Shenzhen XIN PING HENG Sports Company, Jinjiang XIN NIU BAI LUN Shoes Factory, Putian BO SI DA KE Trading, Chaozhong ZHENG (an individual), and Suzhou XIN PING HENG Shoes Shop.

The plaintiff also applied for an injunction to the court, requesting an immediate stop of all ongoing production and distribution activities. Suzhou Court held two injunction hearings—on August 10, 2016, and September 12, 2016—before issuing its decision on the injunction on September 13, 2016. The court ordered the defendants to immediately cease ongoing production and distribution of the disputed NEW BOOM shoes featuring the letter "N," citing the following reasons: (1) the plaintiff submitted evidence to prove the "N" letter has been recognized as the unique trade dress of a famous brand; (2) the continuous activities by the defendants could incur irremediable

damage if timely measures were not taken; (3) the plaintiff provided a financial guarantee; and (4) the implementation of the injunction would not injure public interest.

The full case was heard on April 11, 2017; however, the defendants refused to implement the injunction and continued with their production and distribution activities, despite the injunction verdict issued by the court. Consequently, the court decided to issue the maximum punishment against the defendants, ordering the highest statutory penalty in accordance with the Civil Procedure Law of China, in the total amount of RMB 1.7 million (approximately US \$260,000).

This is the first injunction case involving unique trade dress in an intellectual property matter handled by Suzhou Intermediate People's



New Balance Shoe (from the plaintiff)

Court, and also the first case in which this court ordered an injunction requiring the defendant to cease production and distribution.



New Boom Shoe (from the defendants)

### Contributor: Nikita Xue

Hong Fang Law, Shanghai, China  
INTA Bulletins Law & Practice—Asia-Pacific Subcommittee

### Verifier: Wu Li

Deputy Director, Legal Division, Guangdong Provincial Administration for Industry and Commerce

## Supreme Court Newly Launching Regulations Concerning Trademark Authorization and Validation for Administrative Lawsuit

On March 1, 2017, the Regulation on the Trial of Administrative Lawsuits Concerning Trademark Authorization and Validation issued by the Supreme People's Court of China became effective. This newly launched Regulation is meant mainly to better implement the Trademark Law of China and the Administrative Procedure Law of China relating to administrative lawsuits stemming from appeals of trademark rejections, cancellations, and invalidations. There are 31 articles stipulated by the Regulation—and the following are the most significant for trademark owners:

- Article 5: "Filing a trademark application for the name of a public figure in the field of politics, economics, culture, religions and other national fields as could be defined as 'bad influence activity,' stipulate by Item 1(8) of Article 10 of the Trademark Law."

Recently there have been some trademark disputes involving celebrity names or political figures' names. While Article 10 of China's Trademark Law provides for eight situations in which trademarks may be rejected on absolute

grounds, it does not explicitly state that registrations containing public figures' names should be rejected, so this new article provides a welcome clarification.

- Article 12: "The Court should consider the following factors when any party claims for the copy or translation of their well-known trademark by referring to Item 2 of Article 13 of the Trademark Law and requests non-registration or invalidation:

1. Degree of similarity between the disputed and cited trademark;
2. Degree of similarity between the classes;
3. Significance and famous status of the trademark being claimed for protection;
4. The intention of the trademark applicant and the substantial confusion evidence could also be factors in determining the possibility of confusion."

The current Article 13 of the Trademark Law focuses more on reputation and evidence of recognition of the trademark; the new Regulation emphasizes the comparison between the disputed and the cited trademark.

- Article 15: "The Court could refer to Item 1 of Article 15 of the Trademark Law when considering administrative lawsuits relating to conflict of interest, including the following situations: It could be presumed bad faith if there is a family relationship between the trademark applicant and the distributor or the agent of the principal."

Trademark registration applications in China have rapidly increased, and some are indeed being filed in bad faith. It is beneficial for brand owners to protect their trademarks from being copied via this specification that the family relationship between the trademark squatter and the distributor of the principal could be regarded as bad faith.

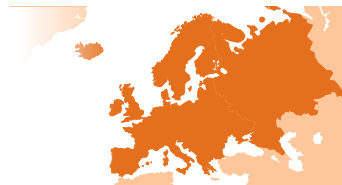
The full content of the Regulations is available [here](#).

### Contributor: Nikita Xue

Hong Fang Law, Shanghai, China  
INTA Bulletins Law & Practice—Asia-Pacific Subcommittee

### Verifier: Wu Wenjing

Trademark Office Official, Guangzhou Administration for Industry and Commerce, Guangzhou, China



## A New Europe Team Prepares to Tackle a Busy Policy Agenda



**H el ene Nicora, Chief Representative Officer, Europe**

While the quiet summer months have provided the perfect opportunity for the new Europe Office team (see below) to get settled in, the usually low level of political activity in Brussels during the summer period was punctuated by Brexit negotiations. Following the initial round of negotiations between the UK and the other 27 EU member states, on June 19, two following rounds took place over the summer (July 10–14 and August 28–September 1).

The main issues of contention include the “exit bill” that the UK will have to pay to the EU; the fate of EU and UK citizens living in the UK and in the EU-27, respectively; and the Irish border—to name a few. While trademarks and related rights do not have a high profile among the political leaders, the relevant actors and stakeholders (including the UKIPO and user associations such as INTA) are already engaged.

Brexit aside, the EU is gearing up for another significant national election against a wave

of increased “Euroscepticism.” Following the success of pro-EU parties in the Netherlands (March 15) and in France (May 8 and June 18), and Germany went to the polls on September 24 for the country’s general elections.

On Brexit, INTA attended several meetings with representatives of the EU Commission “Article 50” Task Force and the UKIPO over the summer. The last one took place on July 27, where Anna Carboni (Redd Solicitors LLP, member of the Brexit Rapid Response Group) attended a UKIPO meeting in London devoted to discussing the exhaustion of rights and reaffirming INTA’s general position that national exhaustion is preferable (except in harmonized regions where regional exhaustion is acceptable).

**Despite the challenges of Brexit and Euroscepticism, the EU is moving ahead with its policy agenda.**

Despite the challenges of Brexit and Euroscepticism, the EU is moving ahead with its policy agenda. The European Commission is considering whether or not to review the IPR Enforcement Directive (IPRED) by this fall. INTA is currently preparing a wish list of key issues to advocate to the Commission and other EU Institutions.

In other activities in Europe, INTA CEO Etienne Sanz de Acedo held several meetings in Paris on July 12 with various organizations in order to build further collaboration. He met with the Organization for Economic Cooperation and Development (OECD); the International Chamber of Commerce–Business Action to Stop Counterfeiting and Piracy (ICC–BASCAP); APRAM, the French-speaking association of

**Europe Global Advisory Council**

**Co-Chairs**  
 Anne Gundelfinger, Swarovski AG, Liechtenstein  
 Michael Hawkins, Noerr Alicante IP, S.L., Spain

**Council Members**  
 Carsten Albrecht, FPS Fritze Wicke Seelig, Germany  
 Jose Luis Arnaut, CMS Rui Pena & Arnaut, Portugal  
 Gerhard Bauer, Gerhard Bauer, Germany  
 Catherine Boudot, Biofarma, France  
 Geert Glas, Allen & Overy LLP, Belgium  
 Lorenzo Litta, Societ a Italiana Brevetti, Italy  
 Jeremy Newman, Rouse, United Kingdom  
 Gabrielle Olsson Skalin, Inter IKEA Holding Services S.A., Belgium  
 Petter Rindforth, Fenix Legal KB, Sweden  
 David Stone, Allen & Overy LLP, United Kingdom  
 Zeeger Vink, Lacoste S.A., France  
 Vanni Volpi, GUCCI, Italy  
 Verena von Bomhard, Bomhard IP, Spain

**Staff Liaison**  
 H el ene Nicora, Chief Representative Officer, Europe  
[HNicora@inta.org](mailto:HNicora@inta.org)

trademark practitioners; and INPI, the French national IP office.

More recently, on September 10 - 11, the INTA [Board of Directors met and held a Government Relations Program in Brussels](#), a Europe Office representative attended the Europol Intellectual Property Crime Conference on Innovative Strategies for Effective Enforcement in Antwerp on September 19 - 20; and promotional activities around INTA’s educational programs in Berlin are under way.

## Association Activities

**Staff Changes at the Europe Representative Office**  
 Effective July 1, H el ene Nicora is the new Chief Representative Officer of INTA in Brussels; she joined INTA in February 2013 as a Policy Officer and subsequently as a Representative Officer. Together with a small and dynamic team, Ms. Nicora will support INTA’s operations in Brussels and at the national level in Europe,

including representation of the Association to the EU Institutions and other stakeholders, and she will advise on and implement INTA’s policies, membership development, and communications efforts.

Ms. Nicora replaces Christina Sleszynska, who stepped down after setting up the Europe

Representative Office and leading its growth for more than ten years.

Hadrien Valembos joined INTA on July 7 as a Policy Officer. A Belgian national, Mr. Valembos was formerly with Europtimum Conseil, an EU public affairs consultancy, for more than five years. He holds an LL.M. in International





Hadrien Valembois,  
Policy Officer, Europe

Legal Studies from Georgetown University, Washington, D.C., and a Masters in International Relations from the University of Louvain, Belgium.



Carolina Oliveira  
Policy Officer, Europe

Carolina Oliveira joined INTA on July 10 as a Policy Officer. A Portuguese national, Carolina was formerly with the European Commission—Directorate General for the Internal Market, Industry, Entrepreneurship and SMEs (DG

GROW). This followed a four-year stint of legal practice at the Portuguese law firm of PLMJ—Sociedade de Advogados.

Mr. Valembois and Ms. Oliveira will focus on a range of policy advocacy priorities that protect trademarks and related rights, and foster further harmonization of laws and convergence of practices, both at the EU level and at national levels across Europe, and will act as staff liaisons for several INTA advocacy committees.

## INTA CEO Visits Paris to Build Bridges and Advance the Association's Objectives

As mentioned in the introduction to this chapter, INTA CEO Etienne Sanz de Acedo was in Paris on July 12 to meet with directors and key representatives from various organizations, including the Organisation for Economic

Cooperation and Development (OECD), the International Chamber of Commerce's Business Action to Stop Counterfeiting and Piracy (ICC-BASCAP), APRAM (the French-speaking association of trademarks and designs professionals), and the French IP Office (INPI).

The various meetings aimed to develop existing relations and explore further collaboration opportunities to advance INTA's work and to serve brand owners. Opportunities for (joint) impact studies, educational programming, and advocacy were among the topics discussed.

## INTA Comments on Various Trademark and Design Laws and Practices

In June, INTA submitted various comments to the European Union Intellectual Property Office (EUIPO) on a variety of trademark and design-related topics, namely:

- The draft examination guidelines for European Union Trade Marks, for registered community designs, and invalidity actions; and

- Questionnaires on convergence projects in trademarks and in designs.

In addition, INTA advocated:

- Against brand restrictions in the course of the ban of totalitarian symbols in Hungary;
- For a more efficient protection and enforcement of trademark rights in Ukraine; and

- For an improved German trademark draft law in line with the new EU Trade Marks Directive.

All of the above submissions can be accessed by INTA members on our Testimony and Submissions page at [www.inta.org/Advocacy](http://www.inta.org/Advocacy) (nonmembers can join INTA at [www.inta.org/join](http://www.inta.org/join)).

## Brexit: INTA and Other IP User Associations Meet with the EC's Negotiating Team

On June 13, 2017, the European Community's "Task Force for the Preparation and Conduct of the Negotiations with the UK under Article 50 TFEU" invited INTA and other User Associations (AIM, APRAM, BusinessEurope, CITMA, ECTA, MARQUES, and UNION-IP) to an exchange on intellectual property in the context of Brexit.

INTA was represented by Zorita Pop (RB, UK, co-leader of INTA Brexit Cross-Committees Task Force) and H el ene Nicora, INTA Europe Representative Officer.

The objective of the meeting was to discuss a list of issues related to trademarks and designs, which needed to be considered as part of the Brexit negotiations between the EC and

the UK government. INTA expressed its support for solutions that would ensure the minimum disruptions and costs to brand owners, and its willingness to continue working with the EC and the UK government on this issue.

You can find more information on INTA's activities on Brexit [here](#) and access INTA's Brexit Brands Toolkit [here](#).

## In the News

### EUROPEAN UNION: EUIPO Announces "Anti-Scam Initiative" to Fight Misleading Invoices

IP rights owners and their representatives have been receiving an increasing number of misleading notices claiming to be from or sent on behalf of IP offices all over the world. These communications appear to be realistic letters

and demand payment for unsolicited or nonexistent services.

In an attempt to minimize this phenomenon, the European Union Intellectual Property Office (EUIPO) launched its Anti-Fraud Network in 2014. The participants in this initiative are EUIPO, European national IP offices, user

associations, the World Intellectual Property Organization (WIPO), the European Patent Office (EPO), and Europol (the European Union Agency for Law Enforcement Cooperation). In order to better focus on the scope of the activities carried out, EUIPO has recently

[continued on page 18](#)



## In the News continued from page 17

renamed the Anti-Fraud Network the “Anti-Scam Network.”

The anti-scam initiative covers four areas: IT measures, communication, legal action, and cooperation.

EUIPO, European national patent and trademark offices, and relevant international organizations and user associations have been working to inform users about this trend and to help them avoid paying such scam invoices.

Several activities have been carried out so far:

- Enhanced cooperation with Europol;
- Provision of external legal expertise;
- Awareness campaigns;
- Development of defensive IT countermeasures; and
- Interaction with users and user associations.

In order to raise users’ awareness, both EUIPO and European national IP offices implemented several initiatives, such as putting warnings on

their websites and social media pages (including names of known “entities” and examples of misleading communications) and publishing articles in IP-specialized press. [Read the full report in the INTA Bulletin.](#)

### Paola Ruggiero

Bird & Bird, Milan, Italy

Trademark Office Practices Committee, EUIPO Subcommittee

### EUROPEAN UNION: CJEU Ruling Impacts Method of Damage Calculation

On January 25, 2017, the Court of Justice of the European Union (CJEU) rendered an important judgment in Case C-367/15, *Stowarzyszenie “Oławska Telewizja Kablowa” (OTK) v. Stowarzyszenie Filmowców Polskich (SFP)* concerning interpretation of the EU law governing the rules of calculating damages for infringement of intellectual property (IP) rights.

The request for preliminary ruling was filed by the Polish Supreme Court on the grounds of a copyright infringement dispute between SFP, a Polish organization collectively managing and protecting copyrights in audiovisual works, and OTK, a Polish broadcaster of television programs.

The Polish Supreme Court posed the following question to the CJEU: Whether Article 13 of the Directive 2004/48/EC of the European Parliament and of the Council of April 29, 2003—on the enforcement of IP rights (the Enforcement Directive)—actually allows EU national legislations to enable IP rights holders to choose to demand from an infringer, without the need to prove actual loss and the causal link between the infringing event and the amount of loss suffered, payment of a sum

corresponding to the multiple (in the discussed case: twice) of a hypothetical royalty fee, which would have been due in case a consent had been given for the work concerned to be used.

The Supreme Court’s doubt and query submitted to the CJEU followed from the fact that compensation corresponding to multiple license/royalty fees provides in fact a form of penalty, while Recital 26 of the Enforcement Directive sets out that its aim is not to introduce an obligation to provide for punitive damages.

In its ruling, the CJEU held that Article 13, which pertains to the method of damage calculation, does not preclude the EU member states legislation under which the claimant (the IP rights holder) may demand of the infringer, without having to prove the actual loss, payment of a sum corresponding to twice the appropriate hypothetical royalty fee that would have been due if permission had been given for the work concerned to be used. Importantly, the CJEU held in the ruling’s reasoning that “the fact that the Enforcement Directive does not entail an obligation on the Member States to provide for ‘punitive’ damages cannot be interpreted as a prohibition on introducing such a measure.” Consequently, national legislation

setting out multiple royalty fees as a basis for damage calculation is not as such contrary to the provisions of the Enforcement Directive.

Although this case concerned a copyright infringement dispute, the judgment is of particular importance for brand owners within the EU as well. Methods of calculating damages envisaged by Article 13 of the Enforcement Directive, including a method based on the multiple royalty fee concept, can also be applied by the member states with respect to trademark infringements. Moreover, in many trademark infringement cases, proving the exact amount of damage suffered may be very difficult, if at all possible, so setting damages based on a fictitious license fee (or its multiplication) may prove to be the only effective measure.

### Contributors: Aleksandra Kuźnicka-Cholewa and Marek Oleksyn

CMS Cameron KcKenna Greszta sp.k, Warsaw, Poland

### Verifier: Adrianna Zięćik

AOMB Polska Sp. z o.o., Warsaw, Poland

Mr. Oleksyn is a member of the INTA Bulletins Law & Practice—Europe Subcommittee

### UNITED KINGDOM: High Court Rules on Use of Google AdWords/AdSense and Trademark Infringement

UK retailer Argos Ltd has lost its claim for trademark infringement and passing off (in the High Court of England and Wales) against Argos Systems Inc., a U.S. software company, with respect to the domain name argos.com. *Argos Ltd v. Argos Systems Inc.*, [2017] EWHC 231 (Ch), Feb. 15, 2017 (High Court of England and Wales).

Argos Ltd had claimed that Argos Systems was infringing its EU trademarks for ARGOS by allowing its argos.com domain to feature Google AdSense advertising. Argos Systems had registered its domain name in 1992 and Argos UK had registered the domain name argos.co.uk in 1996.

Argos UK did not argue against Argos Systems’ use of argos.com as a website and for email to promote its software. Instead, it argued that

the use of the domain name in conjunction with the advertisements amounted to trademark infringement and passing off. Argos Systems participated in Google’s AdSense advertising program, and Argos UK’s ads were among those that appeared on Argos Systems’ website. This meant that indirectly the money Argos UK paid to Google (as part of the Google AdWords program) was being received by Argos Systems, as the clicks on the ads were from Argos Systems’ website.



In rejecting Argos UK's claims against Argos Systems, the High Court made two key rulings, which were that:

- Argos UK had expressly and unequivocally consented to Argos Systems' use of the sign ARGOS in the domain name by agreeing to the Google AdWords terms of use. Argos UK did not need direct knowledge of where its advertisements were appearing; this knowledge was available via its advertising agency.
- In any event, Argos Systems had not targeted UK consumers, so the sign ARGOS was not used within the UK. The court took into account the fact that most of the UK visitors to argos.com had visited the website by mistake and had left the website almost

instantly when they realized it was not Argos UK's website.

Although these two rulings were enough to dispose of the action, the court also ruled on a number of other issues between the parties. Among other things, it concluded that Argos Systems was not using the sign ARGOS in relation to goods and services that were identical to those for which Argos UK's trademarks were registered, and that its use of the sign did not adversely affect any of the functions of those marks. With respect to passing off, the court considered that there had been no material misrepresentation to the public, no damage (or the likelihood of damage), and no fraudulent use of the domain name.

This decision is interesting as it covers new ground concerning the extent to which the use of Google AdWords or AdSense can result in trademark infringement or passing off. However, the facts of this case were very unusual, so its significance to future decisions of the UK courts remains to be seen.

**Contributors: Leighton Cassidy and Heidi Hurdle**

Fieldfisher LLP, London, United Kingdom

**Verifier: Florian Traub**

Squire Patton Boggs LLP, London, UK

Mr. Cassidy is a member and Mr. Traub is Co-Chair of the INTA Bulletins Law & Practice—Europe Subcommittee.

## UNITED KINGDOM: UK's IP Office Publishes New Registered Designs Examination Practice Guide

The UK Intellectual Property Office (UKIPO) published a new *Registered Designs Examination Practice Guide* (the Guide) in March 2017, available [here](#). The Guide provides information on how UK national design applications are examined at the UKIPO under the UK Registered Designs Act 1949 (RDA) and the Registered Design Rules 2006 (Rules). The Guide is a result of the EU Intellectual Property Office (EUIPO)'s Common Communication on CP6 (Graphic Representation of Designs),



which is intended to harmonize the examination process for designs, and which was published by the EUIPO in April 2016 and reported [here](#) in the *INTA Bulletin* on May 15, 2016.



**Simon Bennett**

Fox Williams LLP, London, UK



## Brand Authenticity

November 30–December 1, 2017 | Berlin, Germany

**Register Today:**  
[www.inta.org/2017Berlin](http://www.inta.org/2017Berlin)



## Industry Steps Up IP Advocacy Efforts



**Gauri Kumar, India Consultant**

INTA's 2018–2019 committee selection process kicked off in July, and the Association received a fervent response from Indian members. Indian lawyers and brand owners have been participating actively in influencing the policy landscape, as they rightly realize the importance of feedback mechanisms within lawmaking and adjudicating frameworks. With active committee participation from India, INTA will be able to sustain and even intensify its influence in the country.

Industry activism is becoming more and more prominent in the IP arena. With the advent of India's National IPR Policy, the government has taken numerous steps to increase the level of IPR awareness and education among various stakeholder groups, including school children, enforcement agencies, and the public. Policymakers appreciate that to bring about a mindset change in the whole country on the importance of IP rights, collaboration is key. This has given lawyers, law firms, in-house counsel, and industry associations opportunities to collectively contribute to the government's efforts. In an article covered on page 22 of this chapter, you can read about the Scheme for IPR Awareness—Creative India; Innovative India launched by the Cell for IPR Promotion and Management (CIPAM) that calls on industry organizations, academic institutions and other stakeholders across the country to assist in realizing the goals of the National IPR Policy. In this, INTA has been standing front and center, receiving and participating in opportunities to provide support to the government's IP initiatives.

The much-discussed INTA-CIPAM Children's IP Awareness and Education Campaign in Schools was launched successfully in April. Discussions are now afoot on developing new, interesting, and engaging material on IP for children and the project promises to provide more opportunities for INTA member engagement. INTA members are invited regularly by CIPAM to speak at IP awareness trainings for enforcement officials. Just recently, INTA attended the "National Workshop on Enforcement of Intellectual Property Rights" organized by the Department of Industrial Policy and Promotion (DIPP), Ministry of Commerce and Industry and CIPAM. Participants and speakers at this 3-day workshop included many INTA members.

INTA was also invited recently by DIPP to discuss the EU Trademark Package provisions on goods in transit. During this very productive meeting that was attended by members of the Anticounterfeiting Committee—South Asia Subcommittee, INTA and DIPP were able to discuss different aspects of counterfeit goods in transit in the European Union and how these regulations could be interpreted and applied in India. In a follow-up, INTA reiterated its commitment to the EU transit provisions as a means to fight counterfeiting beyond borders and shared relevant information in an effort to allay India's concerns.

**INTA has positioned itself as an active collaborator in the Indian government's efforts.**

INTA's Indian members have also been quite busy dealing with other big changes that have occurred on the trademarks practice front. India's new Trademarks Rules were announced in March. The Rules bring about many changes in the trademarks procedural practice, but overall, stakeholders are optimistic about the improvements these will bring. INTA was actively involved in each stage of stakeholder consultations through its Trademark Office Practices Committee (TOPC)—India Subcommittee and a specialized task force that was constituted to study these Rules in their draft and final forms. To supplement the Rules, the Indian Trademarks Registry also issued guidelines in May for the determination of well-known marks. Again, thanks to active committee participants from India, these

### India Global Advisory Council

#### Co-Chairs

Ranjan Narula, RNA IP Attorneys, India  
Shwetasree Majumder, Fidus Law Chambers, India

#### Council Members

Murlidhar Balasubramanian, Castrol India Limited, India  
Shailendra Bhandare, Khaitan & Co., India  
Vikram Grover, Groverlaw, India  
Abhayan Jawaharlal, CIPLA Ltd., India  
Latha Nair, K&S Partners, India  
Samta Mehra, Remfry & Sagar, India  
M.S. Bharath, Anand & Anand, India  
Shilpa Joshi, Mahindra & Mahindra Limited, India  
Rick McMurtry, Turner Broadcasting System, Inc., United States  
Sarita Joglekar, Reliance Industries Limited, India  
Hemant Singh, Intl Advocare, India

#### Staff Liaison

Gauri Kumar, India Consultant  
[gkumar.consultant@inta.org](mailto:gkumar.consultant@inta.org)

guidelines are being studied by the Famous and Well-Known Marks Committee—MEASA Subcommittee and the TOPC India Subcommittees. Comments from these subcommittees will soon be submitted to the Office of the Controller General of Patents, Designs and Trade Marks.

**Policymakers appreciate that to bring about a mindset change in the whole country on the importance of IP rights, collaboration is key.**

It is apparent that in all this and much more, the role of INTA's member volunteers is invaluable. Members who take time from their extremely busy professional lives to advance the Association's cause are INTA's greatest ambassadors and assets.



## Association Activities

### Launch of INTA-CIPAM Children's IP Awareness and Education Campaign in Schools

INTA and the Cell for IPR Promotion and Management (CIPAM) launched their collaborative IP Awareness and Education Campaign for schoolchildren across India on April 25 in New Delhi. The formal launch took place in Kendriya Vidyalaya, RK Puram, and was attended by Rajiv Aggarwal, Joint Secretary, Department of Industrial Policy and Promotion (DIPP), Ministry of Commerce and Industry, CIPAM, and INTA. The launch presentation was delivered to approximately 90 schoolchildren by members of the INTA Working Group, including Shwetassree Majumder (Fidus Law Chambers, India), Gunjan Paharia (Zeus IP, India), and Dhrubajyoti Basu (Aditya Birla Management Corporations Pvt Ltd, India).

Children were given an hour-long, engaging presentation on intellectual property (IP) rights, the significance of those rights, and an introduction to patents, trademarks, copyright,

and designs—the four basic types of IP rights. During the session, the children participated in interactive games that formed part of the presentation and were also given a handy brochure on IP rights. Colorful posters on the theme that were prepared by CIPAM and INTA were also displayed in the school.

Quoting from [a press release](#) issued by the Ministry of Commerce and Industry, “Mr. Aggarwal from DIPP said IPR Awareness: Outreach and Promotion is the first and foremost objective of the National IPR Policy and is critical to shaping an IP environment that is conducive to fostering creativity and innovation in the country. He said that one of the key focus areas is children in schools, as it is essential to nurture creativity and the ability to innovate from a young age. Mr. Aggarwal said a streamlined system is being worked out to conduct over 3,500 awareness programs in schools, universities, and the industry across the country including Tier 1, Tier 2, and Tier 3 cities as well as rural areas, along with



INTA-CIPAM Launch of IPR Awareness Campaign for Schools

translating the content to various regional languages for a wider reach.”

This formal launch was followed by presentations in approximately ten more schools in India's National Capital Region during the month of May. Many INTA volunteers also participated. More presentations and school interactions will be scheduled in the coming months.

### Corporate Member Meeting Held at Reliance Corporate Park

On April 19, INTA Corporate Member [Reliance Industries Limited](#) hosted an INTA Corporate Member Meeting at Reliance Corporate Park. Reliance Industries Limited is a Fortune 500 company and the largest private sector corporation in India.

The main agenda of the meeting was to discuss the nuances of the new [Trade Marks Rules, 2017](#), of which IP stakeholders were notified in March. Shailendra Bhandare (Khaitan

and Co., India), who is also the chair of the Trademark Office Practices Committee—India Subcommittee, made a detailed presentation covering a comparative analysis between the old and the new Rules. Mr. Bhandare also highlighted the concerns around some provisions that require more clarity from the Trade Marks Registry. With about 20 members and prospective members in attendance, the session was highly interactive and extremely well received.

As a task force under the India Subcommittee is currently reviewing the new Rules and

compiling its comments for submission to the office of the Controller General of Patents, Designs and Trade Marks (CG), corporate members were asked to share any of their concerns on the new Rules so that these could be discussed by the task force and raised with the CG.

INTA would like to thank Sarita Joglekar (Reliance Industries Limited, India) and her team at Reliance for hosting this event.

### INTA Members Participate in CIPAM Workshop on Enforcement of IP Rights for Kolkata Police

From April 11–13, 2017, INTA members had the opportunity to participate in, and make presentations at, a three-day workshop on the enforcement of intellectual property rights for Kolkata Police Officials, at Kolkata Police Training School, Kolkata, West Bengal. The workshop was organized by CIPAM (the Cell for IPR Promotion and Management), which has been set up as a professional body under the aegis of the DIPP (Department of Industrial

Policy and Promotion), Ministry of Commerce & Industry, Government of India, to coordinate the implementation of the country's National IPR Policy.

This training workshop was held pursuant to the larger objective of strengthening intellectual property (IP) enforcement mechanisms across the country. So far, CIPAM has organized many trainings and workshops in the Indian states of Andhra Pradesh, Uttar Pradesh, and West Bengal.

Such IP sensitization programs have already begun to pay off for those police officials that have taken part in them. Recently, an official who had attended a CIPAM police training conducted a successful raid seizing fake sports shoes and arresting persons involved in the illegal activity.

INTA is pleased to be an active supporter in all such future endeavors of the Indian government.

### World IP Day Celebrations in India

INTA attended the National IPR Conference on the “Expanding IP Ecosystem in Industry,” followed by the National Intellectual Property

Awards ceremony, in New Delhi on April 27 in celebration of World IP Day. This one-day event is held each year to recognize and reward the organizations and people that have contributed

to harnessing the country's IP capital and have helped to create an ecosystem that boosts creativity and innovation. India's Minister of

continued on page 22



## Association Activities continued from page 21



Hindustan Unilever Limited IP Symposium on World IP Day

State (Independent Charge) for Commerce and Industry, Nirmala Sitharaman, presided over the awards ceremony and her comments

expressed the great significance the Indian government places on creativity, innovation, and IP protection. She said that India stands firm and clear on IP rights and the country's IP rights regime will be moving from strength to strength in the future. The minister also spoke about the extensive activities and events taking place nationwide to meet the objectives of the country's National IPR Policy. For the first time, the awards recognized the best police unit for enforcement of IP in the country, with Crime Branch, Chandigarh Police, taking the honors.

INTA also supported an IP symposium hosted by Hindustan Unilever Limited (HUL) at their Mumbai headquarters on April 26 to celebrate World IP Day. The event was attended by more



Nirmala Sitharaman at the National IP Awards, 2017

than 90 school children. Among many other IP activities, the symposium showcased an interactive presentation on IP rights that was prepared by INTA and CIPAM. Madhu Rewari (Anand and Anand, India) made the presentation on behalf of INTA and CIPAM.

### Unreal Campaign Visits India

On May 1, 2017, Pooja Dodd (Dodd & Co., India), a member of the Unreal Campaign Committee, hosted a [Student Engagement Event](#) at the Tagore International School, New Delhi. The event drew 270 students.

After providing an overview of INTA and the Campaign, Ms. Dodd discussed the basics of trademarks, their importance for consumers as well as companies, and some of the dangers that arise from counterfeiting. The students were interested, and some even shared their own experiences and encounters with counterfeit products.

The students seemed to understand the gravity of the counterfeiting problem and were excited at the prospect of educating their parents about it.

To get involved in the Unreal Campaign, please visit the landing page [here](#). Thank you to our 2017 sponsors that make these events possible.



Pooja Dodd hosted a Student Engagement Event at the Tagore International School, New Delhi

## In the News

### India Takes Steps to Bolster Awareness, Commercial Value of IP

In order to meet the objectives of India's National Intellectual Property Rights (IPR) Policy and to enhance creativity, innovation, competitiveness, and economic growth in the country, the Cell for IPR Promotion and Management (CIPAM), Department of Industrial Policy and Promotion, released [the Scheme](#)

### for IPR Awareness—Creative India: Innovative India.

Under this scheme, CIPAM aims to conduct a nationwide IP awareness initiative in collaboration with industry organizations and academic institutions. The awareness program will be tailored for four categories: (1) primary school; (2) secondary school; (3) university level; and (4) industry, including micro, small, and medium-sized enterprises (MSMEs) and startups.

CIPAM will also conduct IP training and sensitization programs for enforcement agencies and the judiciary.

This scheme commenced in April 2017 and is expected to be completed in March 2020. During this time, CIPAM aims to undertake, among other things, 4,000 IP awareness workshops and 270 IP training and sensitization programs.

### IP Exchange for India Soon

A project proposing the opening of an Intellectual Property (IP) Exchange in India has been granted "in-principle approval" by the country's Ministry of Science and Technology. This IP Exchange will be developed by the National Research Development Corporation (NRDC), which is currently collecting relevant

data in order to set up the exchange. The idea behind the exchange would be to create an on-line marketplace for individuals and commercial entities in India and the rest of the world to buy and sell their patents across sectors.

In recent years, India has seen a surge in the filing of IP applications, and there is a huge

potential to exploit the commercial viability of IP. At this point, there is no indication that the purview of this IP Exchange would extend to trademarks and other IP rights, except patents. That said, establishing such a platform is a step in the right direction for the country's IP regime, which is developing at an exponential pace.



## CG Addresses Indian General Counsels on the Strides Made by Indian IPO

Addressing a gathering of general counsels and legal heads at a conference held in Mumbai on April 21, the Controller General (CG) of Patents, Designs and Trade Marks, O.P. Gupta, spoke about the leaps by which the

country's Intellectual Property Office has grown in the past few years. Mr. Gupta was speaking at IDEX Legal's Legal Counsel Congress, 2017.

Referring to the recent positive developments at his office, Mr. Gupta spoke about the electronic issuance of examination reports and

registration certificates, digitization of records, reduction of time in the first examination of a mark, and an increase in human resources. Mr. Gupta also acknowledged that debate and discussions on IP issues would become more and more frequent, as India grows as an IP-enabled and IP-conscious society.

## Indian Trade Marks Registry Issues Guidelines on Well-Known Marks

The Indian Trade Marks Registry (TMR) maintains [a list of well-known trademarks](#) in its records. In March 2017, the modalities for determination of well-known trademarks were laid out for the first time under Rule 124 of the new Trade Mark Rules 2017.

Subsequently, on May 31, 2017, the Office of the Controller General of Patents, Designs and Trade Marks (CG) [published guidelines](#) for the determination of well-known marks to assist the filing of applications under Rule 124. Among other things, the guidelines state that:

- The application should be filed only online through e-filing services of the TMR.
- The application should be accompanied by the following documents:
  - Statement of case;
  - Evidence in support of the applicant's rights and claim;
  - Details of the successful enforcement of rights, if any, relating to the said trademark in particular and the extent to which the trademark is recognized as a well-known trademark by any court in India or by the Registrar;
  - Copy of the judgment of any court in India or the Registrar, wherein the trademark is

determined as a well-known trademark; and

- Restrictions on the size of the documents to be submitted.
- The application process to be followed while filing and considering the application for inclusion of a mark on the list of well-known marks.

The guidelines are available [here](#).

**Shailendra Bhandare**  
Khaitan & Co., India

Chair, Trademark Office Practices Committee—India  
IP Office Subcommittee

## New Trademark Rules Are Now in Force

The Indian government began enforcing new Trademark Rules as of March 6, 2017, with the aim to streamline and expedite the registration process. Some salient features include:

1. Hike in official fees: There is a substantial increase in the fees for the filing and renewal of marks. The official fee for registering/renewing registered trademarks is now approximately 150 USD, compared with the previous fee of about 75 USD, for all entities other than individuals, start-ups, and small enterprises, as defined in the Rules.
2. Affidavit for claiming prior use of a trademark: If a trademark has been in use prior to the date of application for registration with the Trademark Registry, it is mandatory to submit an affidavit substantiating the claim of prior use of the mark. Documents such as invoices, advertisements, etc., should also be submitted. This new rule results in trademark owners being required to file separate applications for goods (1) with respect to which the mark has been in use; and (2) on a proposed-to-be used basis. The user claim made at the time of filing a trademark application cannot be amended at a later stage.
3. Going digital: The Rules include provisions for the service of documents via emails as a means of communication and serving of notices.
4. Request for declaring a mark well-known: New provisions allow a party to apply for designation

of a mark as a well-known mark upon payment of 100,000 INR (approximately 1,550 USD). The Trademark Registrar shall, before determining a mark to be well-known, keep a window of 30 days in which third parties can raise objections to a mark being declared as well-known.

5. New Rules pertaining to hearings: In opposition proceedings, each party is allowed only two adjournments. An application for adjournment of hearing must be given by either party at least three days prior to the hearing date. A hearing may also be held through any means of audiovisual communication, such as video conferencing. If the applicant is not present at the adjourned date and time of the hearing, the application may be treated as abandoned.
6. Opposition proceedings: The Rules impose a penalty of 10,000 INR (about 154 USD) on the applicant for not contesting opposition proceedings and a penalty of 10,000 INR on the opponent for not filing evidence after filing the counter statement. Furthermore, if an applicant learns that the applied trademark has been opposed (as available on website), the applicant can directly file a counter statement with the Trademark Registry. In such cases, requirement of service of copy of the notice of opposition to applicant shall be dispensed with.
7. No extension of time: In opposition proceedings, the evidence in support of opposition and evidence in support of the application will have to

be filed within a period of two months. If evidence is not filed within this timeline, no extension will be granted and the opposition or application will be deemed to be abandoned. The evidence in the opposition proceedings has to be delivered to the other side along with exhibits, and it is mandatory to give an intimation of such delivery, in writing, to the Registrar.

8. Sound mark registration: The new Rules provide for sound mark registrations whereby a reproduction of the sound has to be submitted in MP3 format not exceeding 30 seconds in a medium that allows clear and audible replaying. This has to be submitted with graphical representation of the notations.
9. Early renewal: The new Rules allow a trademark owner to apply for renewal one year (earlier it was six months) before the date of expiration of registration.
10. Removal of excess character and association fees: The Rules no longer require the payment of extra fees if the description of goods/services exceeds 500 characters or if a mark has to be associated with another applied for/registered trademark.
11. Expedited registration of trademarks: An applicant can apply for expeditious registration of a mark by paying a higher fee. The expedited time period is not known and will vary from case to case.

**Contributor:** Disha Dewan, R K Dewan & Co,  
Pune, India

**Verifier:** Neha Chugh, IPR International Services,  
New Delhi, India



## Latin America and Caribbean Representative Office in Full Swing



**José Luis Londoño, Chief Representative Officer, Latin America and the Caribbean**

INTA President Joe Ferretti and CEO Etienne Sanz de Acedo officially launched the Association's first Latin America and Caribbean Representative Office during an inaugural celebration hosted in Santiago, Chile, in May 2017. The office began operating almost immediately after its launch, with José Luis Londoño as its Chief Representative Officer and Alberto J. Onetto as the Representative Office Assistant.

Mr. Londoño was Deputy Superintendent of Industrial Property at the Superintendency of Industry and Commerce of Colombia for the past seven years. Prior to this, he was in-house counsel for the National Federation of Coffee Growers of Colombia, during which time he was also an active INTA member, serving on a number of INTA committees.

Mr. Onetto has worked in business development in the education, hospitality, and wine and spirits industries. Working closely with Mr. Londoño, he will strive to increase INTA's membership and support the Association's regional Marketing and Communications initiatives.



**Alberto J. Onetto, Assistant, Latin America & the Caribbean Representative Office**

### **Building Bridges throughout the Regional IP Community**

The Latin America and Caribbean Representative Office has set forth as one of its

key priorities establishing understanding and collaboration with national and regional IP offices and associations. In August, Mr. Londoño participated in the 37th ABPI (Brazilian Intellectual Property Association) Annual Congress held in Rio de Janeiro, where he was able to strengthen his networking objectives by holding meetings with important entities and government agencies, such as the Brazilian National Confederation of Industry (CNI) and the Brazilian Patent and Trademark Office (INPI), as well as international IP organizations, such as the International Association for the Protection of Intellectual Property (AIPPI).

Also in August, both members of the office team participated in the 10th ACHIPI (Chilean Intellectual Property Association) Annual Congress in Santiago, where INTA's commitment to establish collaborative guidelines to promote the value, enforcement and advocacy of trademarks and brands in the region was once again emphasized to stakeholders and board members from different national IP associations and offices, as set forth in INTA's 2018-2021 Strategic Plan.

Before 2017 ends, the Latin America and Caribbean Representative Office plans to attend more events in the region, one of them being the "SMEs Innovation: Capacity Building on IP Strategy" Forum, which is jointly organized by APEC/IPEG and IMPI (Mexican Institute of Intellectual Property).

### **Training Hard and Smart**

On August 17, several Trademark Office Practices Committee members traveled to Guatemala to train trademark examiners on Trademark Law Treaty (TLT) implementation-related topics and issues, which include issues such as dealing with non-traditional and famous and well-known brands. Similarly, on August 28 Mr. Londoño traveled to Asunción, Paraguay to participate in an IP examiners' training workshop organized by DINAPI (Paraguayan National Intellectual Property Office). This was a great opportunity for the new INTA office to obtain first-hand knowledge of the current IP issues and objectives being addressed in Paraguay.

### **Debuting at the Changing Landscape of Latin America Conference**

The "Changing Landscape of Latin America" Conference, to be held in Cartagena, Colombia, on October 2-3, will be a major task for the new team, with invaluable support and

### **Latin America Global Advisory Council**

#### **Co-Chairs**

Gustavo Giay, Marval, O'Farrell & Mairal, Argentina

Vianey Romo de Vivar, CERVERA & ROMO DE VIVAR, S.C., Mexico

#### **Council Members**

Sergio Barragan, PepsiCo, Inc., Mexico

Jacobo Cohen Imach, MercadoLibre.com, Argentina

Agustina Fernandez Giambruno, Fernandez Secco & Asociados, Uruguay

Luis Alonso Garcia, Estudio Ehecopar (Baker & McKenzie International), Peru

Elisabeth Kasznar Fekete, Kasznar Leonardos Intellectual Property, Brazil

Rodrigo Marre, Mackenna, Irrazazaval, Cuchacovich & Paz, Chile

Hugo Moran R., Icaza, Gonzalez-Ruiz & Aleman, Panama

Gerardo Munoz de Cote, Televisa, S.A. de C.V./Mountrigi Management Group Ltd., Mexico

Urko Ochoa, Minino, Dominican Republic

Graciela Perez de Inzaurraga, Hausheer Belgrano & Fernandez, Argentina

Monica Wolf de Camhi, Wolf Mendez Abogados Asociados, Colombia

#### **Staff Liaison**

José Luis Londoño, Chief Representative Officer, Latin America and the Caribbean  
[jlondono@inta.org](mailto:jlondono@inta.org)

feedback from the conference co-chairs, project team members, and INTA's staff liaisons.

The Latin America and the Caribbean Representative Office sees this event (together with the October 4 Free Trade Zones Workshop in Cartagena) as a grand debut to the region—this is the first time INTA has organized a two-day conference of this kind in Latin America. The "Changing Landscape of Latin America" aims to facilitate discussion and thought leadership on the vast economic, social, and political changes taking place throughout Latin America and their impact on IP; the key message this Office has actively been spreading through email and telemarketing campaigns is that Latin America is an incredible opportunity for local, regional, and multinational companies looking to expand their product and service offerings.





## Association Activities

### INTA Hosts Anticounterfeiting Workshop in Aruba

On June 7, 2017, the Anticounterfeiting Committee—Latin America and Caribbean Subcommittee hosted a regional customs training workshop at the Chamber of Commerce and Industry (CCI) in Oranjestad, Aruba.

Approximately 55 attendees participated in the workshop, including enforcement and customs officers from Aruba, Jamaica, and Curacao. Also in attendance was the Minister of Economic Affairs in Aruba, the President of the Chamber of Commerce, and the intellectual property (IP) offices of Aruba and Trinidad and Tobago.

Tiffany Pho, INTA Anticounterfeiting Coordinator, gave opening remarks and discussed the INTA-ICC BASCAP impact study on the “Economic Impacts of Counterfeiting and Piracy.”

Richard Arends, the Minister of Economic Affairs in Aruba, described the importance of addressing counterfeiting in Aruba. Here affirmed his office’s commitment to fighting counterfeiting in the region and stated how it requires unification and cooperation to combat counterfeiting. Further, Lousthel Lourens from Curacao Customs discussed cooperation, legislation, and education as tools to be used in combating counterfeiting.

Jaime Angeles (AngelesPons, Dominican Republic) moderated the first panel, focusing on the Dominican Republic’s recordal system. Lourdes Ruiz Castro, Deputy in charge of the Dominican Republic’s recordal system, discussed the benefits of the system, offering statistics showing that information gathered from the system contributed to 85 percent of seizures in the country. Additionally, Ms. Ruiz Castro called upon brand owners to lead further training in the region.

Next, Franklin Hoet-Linares (Hoet Pelaez Castillo & Duque, Venezuela) moderated a panel on collaboration between different anti-counterfeiting agencies. Esteemed speakers included Rubylin Nicasia, Team Leader at the Airport, Curacao Customs; Greg Illidge, Customs Investigation and Information, Aruba;

and Carl Berry, Head of the Counter Terrorism and Organized Crime Unit, Jamaica.

Mr. Hoet-Linares began by noting that the Caribbean is a small but emerging region, and that the diversity of the workshop attendees stood to improve communication among the different countries. Mr. Hoet-Linares also stated that counterfeiting is not always a matter of money, but of health and safety; for example, counterfeit toys can be potentially dangerous to children.

**The committee’s goal is to facilitate discussion between the public and brand owners in order to identify and solve counterfeiting issues. Additionally, the committee discusses resources and different legislative options to enforce IP rights.**

Mr. Berry highlighted the Jamaican model of fighting counterfeiting, and discussed the known link between counterfeiting and organized crime. He further described how Jamaica uses its tax laws to prosecute counterfeiters, as well as MATA, a multi-agency task force where customs, the IP office, the public prosecutor, the ministry of health, the tax administrator, and representatives from U.S. Homeland Security Investigations and Interpol, meet once per month for an Anti-Contraband Committee discussion organized by the Jamaican police. The committee’s goal is to facilitate discussion between the public and brand owners in order to identify and solve counterfeiting issues. Additionally, the committee discusses resources and different legislative options to enforce IP rights.

Mr. Nicasia and Mr. Illidge then spoke on the detention processes in Curacao and Aruba, describing several transit issues they have experienced in their work. Mr. Illidge praised the workshop as a valuable way to learn from other enforcement offices and governments.

The second panel discussed best practices for IP practitioners and was moderated by Nicole Booi (Aanic Legal, Aruba). Regan Asgarali from the IP office in Trinidad and Tobago described how his office has an ad hoc committee consisting of the Bureau of Standards and the police. Mr. Asgarali also emphasized Trinidad and Tobago’s high piracy rates and stressed the need for further IP education and training to dispel the public myth that counterfeiting is not a victimless crime.

Next, Kalista Powell, Director of Intelligence Border Protection at Jamaica Customs, discussed how their organization cooperates with stakeholders and law enforcement at their monthly advisory group meetings. Ms. Powell also discussed how the customs office honors World IP Week in April by destroying seized goods. Enrico Webb from Interpol Aruba spoke about Interpol’s investigations in the region and collaboration efforts among different organizations. Finally, Mark Hope (Hope Law, Barbados) discussed counterfeiting issues in the country and what progress the country has made in fighting counterfeits.

After the panels concluded, brand owners in attendance were able to conduct brand identification trainings for enforcement officials from Aruba, Jamaica, Curacao, and the Dominican Republic. The workshop was a success due to the open dialogue with attendees and the ability for the enforcement officials to discuss collaboration with the relevant stakeholders.

For more information on INTA’s anticounterfeiting events, please reach out to INTA Anticounterfeiting Manager, Maysa Razavi, at [mrzavi@inta.org](mailto:mrzavi@inta.org) and INTA Anticounterfeiting Coordinator, Tiffany Pho, at [tpho@inta.org](mailto:tpho@inta.org).

### INTA Brings Unreal to Aruba

On June 6, 2017, INTA brought the Unreal Campaign to Oranjestad, Aruba, at Colegio Arubano. The presentation was made by Anticounterfeiting Committee—Latin America and Caribbean Subcommittee member Nicole

Booi (Aanic Legal Services, Trademarks & Consultancy N.V., Aruba). Ms. Booi presented to a class of high school students on the value of trademarks and how counterfeits are harmful to the economy and to society. Ms. Booi discussed the value of brands and why

it is important to support the brands that put resources into developing a quality product for consumers.

For more information on the Unreal Campaign, please contact Laura Heery at [lheery@inta.org](mailto:lheery@inta.org).

continued on page 26



## Association Activities continued from page 25

### INTA Holds Policy Dialogue on Parallel Imports in Brazil

On May 3, 2017, INTA's Parallel Imports Committee—Latin American Subcommittee held a Policy Dialogue on parallel imports at the Brazilian IP Agents Association (ABAPI) in Rio de Janeiro, Brazil. The event drew 20 attendees and included a very interactive Q&A session.

The program featured Rodrigo Sergio Bonan de Aguiar (Luiz Leonardos & Advogados, Brazil), a member of the Parallel Imports Committee's Latin American Subcommittee, and Ricardo Pinho (Guerra IP, Brazil).

Mr. Pinho kicked off the program by saying a few words introducing INTA and its activities and committees to the audience. He invited all attendees, especially young professionals, to join and attend INTA programs and meetings.

In his speech, Mr. Bonan talked about the legal framework governing parallel imports in Brazil as well as in other jurisdictions. He also provided a brief overview of the legal provisions and their possible interpretations and commented on several court decisions dealing with the subject.



Speakers and attendees of INTA's Parallel Imports Committee—Latin American Subcommittee Policy Dialogue on parallel imports at the Brazilian IP Agents Association (ABAPI) in Rio de Janeiro, Brazil

Mr. Pinho then took advantage of the material prepared by Otavio Padilha (Soerensen Garcia Advogados Associados, Brazil), and discussed how certain court decisions view the relevance of the existence of license agreements between the trademark owner and its licensee or distributor in Brazil. Both panelists commented on the courts' decisions not only from a trademark law standpoint, but also from the perspectives of constitutional, civil, competition, and consumer law.

At the conclusion of the presentation, many attendees asked questions about the legal aspects of parallel imports in Brazil and the

panelists' interpretation of the law. A very interesting discussion ensued when one of the attendees asked a question relating to enforcement against parallel imports at customs. Although there were no customs officers present, the speakers and attendees speculated about measures that customs could use to tackle the problem. One interesting proposal was that trademark owners should use the Brazilian National Institute of Industrial Property's National Directory against Trademark Counterfeiting (the Directory) to inform customs (and other enforcement authorities) about their licensees and distributors in Brazil. Another suggestion was that customs should also use the Directory more frequently during their clearance operations.

The dialogue proved very stimulating and educational, and the committee hopes to host additional events in the future.

**Ricardo Pinho,**  
Guerra IP, Rio de Janeiro, Brazil

Parallel Imports Committee—Latin American Subcommittee

### Trademark Office Practices Committee Hosts First Online Workshop in Latin America

On May 5, 2017, INTA hosted its first online Examiners Workshop in Colombia. Titled "Non-Traditional Trademarks: An American and European Perspective," the event was

organized with the assistance of Tatiana Carrillo (Lloreda Camacho & Co., Colombia) of the Trademark Office Practices Committee's Latin America Subcommittee and attended by more than 60 examiners from the Superintendencia de Industria y Comercio (SIC).



Tatiana Carrillo from the Latin America Trademark Office Practices Committee participating in the first online Examiners Workshop held in Colombia on May 2017.

### García & Bodán Collaborates with INTA on the Unreal Campaign in Honduras

On April 6, 2017, Graciela Cruz, Senior Associate of García & Bodán, presented the Unreal Campaign to students at the Universidad Católica de Honduras (UNICAH).

Approximately 80 second-year law students taking courses in Commercial and Administrative Law attended the presentation. The objective of the conference was to provide the students with information on general aspects of intellectual property. The students were instructed on how counterfeiting can be fought in Honduras through educating both consumers and businesses on the issue.



Graciela Cruz presented the Unreal Campaign to students at the Universidad Católica de Honduras (UNICAH)



## The Unreal Campaign Visits Peru for the Second Time

On April 6 and 7, 2017, the Unreal Campaign was presented at Prescott Anglo American School and Max Uhle German Peruvian School in Arequipa, the second largest city in Peru.

This was the second time that the Unreal Campaign presented its program in Peru. Both

schools are private and were founded in 1965 and 1956, respectively. Currently, these two schools are among the only three institutions that offer the International Baccalaureate in Arequipa.

Jean-Carlo Costa and Luisa Alvarez (INTA members and associate lawyers at BARLAW-Barrera

& Asociados in Lima, Peru) conducted the presentations for more than 400 students ranging in age from 14 to 17-years-old. The audience also included ten teachers.

## In the News

### BRAZIL: Domain Name or Trademark Registration and Earlier Rights. Which Shall Prevail?

In a decision published on March 3, 2017, the 4th Chamber of the Brazilian Superior Court of Justice provided the criteria to decide cases in which identical marks are registered by different owners as domain names and trademarks (Recurso Especial No. 1466212).

Brazil's registry of domain names functions fully independently of the National Institute of Industrial Property (INPI), and Brazilian law follows the principle of "first to file" for both domain names and trademark registration. This inevitably raises the question of which one shall prevail when there is a conflict between parallel registrations of the same sign.

The dispute concerned the cosmetic brand PAIXÃO (meaning "passion" in Portuguese), previously registered with INPI and the match-making services website paixao.com.br. The plaintiffs, DM Indústria Farmacêutica Ltda. and Papyrus L.L.C., claimed trademark infringement and held that the website could not seek the registration of its prior trademark as a domain name. On the other hand, the defendants,

Fundação de Amparo à Pesquisa do Estado de São Paulo—FAPESP and Plano de Serviços de Internet Ltda.—ME, claimed that the principle of specificity should apply, since the fields of activity were not the same.

The Superior Court found in this case that a prior trademark registration could prevent a third party from registering a domain name for the same sign only if the brand was a well-known or highly reputed trademark, or if the domain name could result in consumer confusion or deception as to the origin of the goods or services. Bad faith, the possible dilution of the trademark, and parasitic misappropriation are also factors that can prevent a domain name from being registered by third parties.

In this case, the court held that no such confusion could arise, since PAIXÃO was not regarded by the public nor officially recognized by the trademark office as a highly reputed trademark. Moreover, and perhaps more importantly, the fields of activity of the litigating parties were considered different and the justices held that PAIXÃO was not a very distinctive sign, meaning that coexistence with similar

brands was mandatory. Moreover, many other trademark registrations containing the word "paixão" coexist with the plaintiff's registration in other classes or areas of activities, without any likelihood of confusion or association with the earlier rights. Thus, the court ruled against the plaintiff, upholding the defendant's domain name.

The case sets a very important precedent, as it acknowledges the independence of both systems while providing the criteria for solving the inevitable conflicts that arise therefrom. In this sense, the court indicated that the principle of specificity and bad faith play key roles in adjudicating such disputes.

#### Contributors: Rafael Lacaz Amaral and Rafael Salomão

S. R. Aguillar, Kasznar Leonardos Intellectual Property, Rio de Janeiro, Brazil

#### Verifier: Flavia Mansur Murad Schaal

Mansur Murad Advogados, São Paulo, Brazil

Mr. Amaral and Ms. Murad Schaal are members of the INTA Bulletins Law & Practice—Latin America Subcommittee

### CAYMAN ISLANDS: New Trade Marks Law to Become Effective in August

The Trade Marks Law, 2016 was implemented in the Cayman Islands on August 1, 2017. The Trade Marks Regulations, 2017 and the Trade Marks Law, 2016 (Commencement) Order, 2017 were published on May 26, 2017, and set the implementation date for the new trademark laws.

The practice of reregistering UK and EU trademark registrations to the Cayman Islands ended on July 31, 2017. As of August 1, 2017, the Cayman Islands Intellectual Property Office (CIIPO) accepts only national Cayman Islands applications, filed by a registered agent in the Cayman Islands. A registered agent must be appointed and Form TM3 completed accordingly. Unlike applications filed under the old law, applications filed under the new law will

be examined on absolute and relative grounds and published for opposition purposes (third parties will have 60 days from the date of the publication of the application to oppose). There are no intent-to-use (ITU) requirements on applications under the new law, and, notably, there is no procedure for the revocation of a Cayman trademark registration on grounds of nonuse. However, annual fees will continue to be payable on all Cayman trademarks.

It is expected that trademarks registered under the old law will remain in force and will be treated in the same manner as national trademark registrations from August 1, 2017, onwards. The current understanding is that there will be no change to the next renewal date of marks registered in the Cayman Islands prior to the implementation of the new law; marks registered under the old law will continue to fall

due for renewal on the same date that the underlying UK or EU trademark registration falls due for renewal (i.e., ten years from the filing date of the UK/EU registration). Transitional provisions should be issued soon to confirm these points. However, future Cayman trademark renewals will no longer be dependent on the renewal of the underlying UK or EU trademark registration. The renewal period of marks filed under the new law will be ten years from the date of filing.

#### Contributor: Sophie Davies

HSM IP Ltd, George Town, Cayman Islands

#### Verifier: Katherine Van Deusen Hely

Caribbean IP, West Palm Beach, Florida

Chair, INTA Bulletins—Law & Practice Latin America Subcommittee



## A Promising Partnership



**Tat-Tienne Louembe, Representative, Africa and Middle East**

In the Middle East, INTA has been committed to supporting ongoing efforts to build an intellectual-property-friendly environment that will contribute to boosting economic growth.

Reducing reliance on commodities can be achieved through the development of a strong intellectual property framework. Considering the region's economic potential, the Association looks forward to engaging with numerous stakeholders, promoting responsible dialogue, and supporting initiatives that will enhance IP rights.

INTA relies on the Middle East Global Advisory Council (GAC) to advise on and explain the nuances of the local markets in the region. The GAC provides strategic advice and guidance necessary for brands and consumer protection techniques to fight against infringement and counterfeiting of goods.

During the 139th INTA Annual Meeting, the members of the GAC welcomed the 2017 **"Free**

### **Trade Zones: Commerce vs. Counterfeits"**

workshop, held in Dubai on September 28, and the Middle East Forum in December 2018. The two events demonstrate INTA's commitment to the Middle East and its willingness to organize capacity-building activities matching the needs of the region.

The one-day Free Trade Zones workshop will be one of many events held around the world throughout the year to serve as a platform for brand owners, free trade zone authorities, government officials, and other key stakeholders to share their concerns and best practices, and to work together toward solutions to combat the ongoing threat of counterfeiting in free trade zones. The event will be organized around the following sessions:

- Navigating the Free Trade Zone Landscape (Session 1)—learn about the United Arab Emirates' enforcement regime and how to navigate government authorities in order to best enforce your IP rights;
- But I'm Only Passing Through (Session 2)—hear from experts how they work with customs officials to stop counterfeits from entering the country and how they identify fake goods;
- The Sum of All Parts (Session 3)—gain a better understanding of the many different ways in which counterfeiters manipulate free trade zones to cover their tracks and learn best practices for successfully identifying and disrupting counterfeiters;
- Hit Them Where it Hurts: Civil and Criminal Remedies (Session 4)—become more savvy about the various legal remedies for enforcing rights in free trade zones.

### Middle East Global Advisory Council

#### Co-Chairs

Hoda Barakat (Chair), Hoda Barakat Legal Consultancy, United Arab Emirates

Charles Shaban (Chair), Abu-Ghazaleh Intellectual Property (AGIP), Jordan

#### Council Members

Motasem Abu-Ghazaleh, Abu-Ghazaleh Intellectual Property (AGIP), United Arab Emirates

Ghaida Ala'Eddein, Saba & Co. IP, Jordan

Elie Atallah, Brand Owners' Protection Group, United Arab Emirates

Faisal Daudpota, Daudpota International, United Arab Emirates

Mohammad Jomaa, Kadasa & Partners, Saudi Arabia

Hady Khawand, Saba & Co. IP, United Arab Emirates

Alireza Laghaee, Dr. Laghaee & Associates Inc. International, Iran

Omar Obeidat, Al Tamimi & Company, Advocates & Legal Consultants, United Arab Emirates

#### Staff Liaison

Tat-Tienne Louembe, Representative, Africa and Middle East

[tlouembe@inta.org](mailto:tlouembe@inta.org)

The conference will end with a Q&A session and discussion meant for sharing additional best practices and discussing next steps. For more information, contact Dolores Moro at [dmoro@inta.org](mailto:dmoro@inta.org).

## In the News

**SAUDI ARABIA: Official Fees Dramatically Increased**  
Effective February 19, 2017, Saudi Arabia's General Administration of Trademarks has

raised publication fees for the recordal of assignment, license, mortgage, limitation of goods, merger, change of name, and change of

address. The fees will increase by two to three times the current level. Online filing is expected to follow suit soon. An online platform for the

Item	Previous Fees		New Fees	
	Riyal	USD	Riyal	USD
Publishing a recordal of an assignment	500	133	1,500	400
Publishing a recordal of a change of name and address or agent	500	133	1,500	400
Publishing an amendment limiting goods or services of a trademark	500	133	1,500	400
Publishing a recordal of a merger	500	133	1,500	400
Publishing the recordal of a license agreement	1,000	266	2,000	533
Publishing the cancellation of a license agreement	1,000	266	2,000	533



Item	Previous Fees		New Fees	
	Riyal	USD	Riyal	USD
Publishing the recordal of a mortgage	500	133	1,500	400
Publishing the cancellation of a mortgage	500	133	3,000	800
Publishing the cancellation of a trademark registration	1,000	266	3,000	800

registration of trademarks was introduced on September 25, 2013, and the platform for renewal was introduced on March 24, 2016,

both coupled with a significant increase in publication fees.

**Contributor: Zeina Salameh**  
Saba & Co. IP, Beirut, Lebanon

**Verifier: Yassin Ghanim**  
Al Hadaf Marks Services LLC, Riyadh, Saudi Arabia

## Country Guides

Essential Information on TM Protection Worldwide

A searchable guide of country profiles offering basic, practical information on:

- trademark filing
- registration
- enforcement
- prosecution
- maintenance

Each jurisdiction profile follows a standardized format, with topics organized by subject heading. This format makes it easy to search within a jurisdiction profile or to compare how different jurisdictions treat a particular subject.

Visit [www.inta.org/CountryGuides](http://www.inta.org/CountryGuides)



## Advocacy in Action



**Deborah Cohn, Senior Director, Government Relations, Washington D.C. Representative Office**

In North America, outreach and engagement with all three branches of government has been a central theme focused on educating stakeholders about INTA's positions. Specifically, in the United States, INTA has been meeting with members of the new Presidential Administration, including a meeting with the Acting Director of the USPTO, where the Association shared its priorities, such as the long-standing commitment to working collaboratively with the USPTO on projects like annual educational trainings. In Canada, INTA has actively participated in filing comments on proposed amendments to the trademark regulations and is planning an autumn advocacy event. In addition to the activities included in this chapter, below are some of the highlights since the last Global Report.

### **USPTO and TPAC Roundtable on Fraudulent Solicitations**

In July, INTA participated in a roundtable at the USPTO hosted by the Trademark Public

Advisory Committee (TPAC) focused on fraudulent trademark solicitations that have targeted trademark owners globally. INTA noted the challenges presented by these fraudulent entities and a commitment by the association to work with the global community to support eliminating these fraudulent solicitations and educating the trademark owner community.

### **Comments on Canadian-Proposed Amendments to the Trademark Regulations**

Also in July, three of INTA's Canadian subcommittees worked collaboratively to draft INTA's comments on proposed changes to Canada's trademark regulations. INTA's comments applauded Canada's accession to the Madrid Protocol, the Singapore Treaty, and the Nice Agreement. INTA's comments focused on providing guidance and direction that will further strengthen the Canadian trademark system and work toward harmonization of trademark laws. INTA is committed to working with the Canadian IPO and the Canadian stakeholder community to support the Canadian trademark system.

### **Comments to the USPTO on Streamlining Cancellation Proceedings**

In early August, three INTA subcommittees worked collaboratively to review the USPTO's request for comments related to the development of streamlined cancellation proceedings. INTA's comments supported the USPTO's efforts and proposals focused on improvements to the accuracy of the Trademark Register. In September, INTA will be participating in a Trademark Trial and Appeal Board stakeholder roundtable focused on this issue.

### **INTA Opening Counterfeiting Education Exhibit at National Inventor's Hall of Fame Museum**

During INTA's leadership meeting in November, INTA will be launching a counterfeiting

**North America Global Advisory Council**

**Co-Chairs**  
Paula Clancy, Clancy P.C. + Brion Raffoul, Canada  
Adam Scoville, RE/MAX, LLC, United States

**Council Members**  
Lori Ball, Molson Coors Canada, Canada  
Phillip Barengolts, Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP, United States  
Thomas Brooke, Holland & Knight LLP, United States  
Anthony Dreyer, Skadden, Arps, Slate, Meagher & Flom LLP, United States  
Elisabeth Escobar, Marriott International, Inc., United States  
Julia Huston, Foley Hoag LLP, United States  
Christopher Kindel, Pirkey Barber PLLC, United States  
Jennifer Morton, Gowling Lafleur Henderson LLP, Canada  
Cynthia Rowden, Bereskin & Parr LLP, Canada

**Staff Liaison**  
Deborah Cohn, Senior Director of Government Relations, [dcohn@inta.org](mailto:dcohn@inta.org)

education and outreach exhibit at the National Inventor's Hall of Fame (NHIF) museum which is located at the United States Patent and Trademark Office (USPTO) in Alexandria, Virginia. The exhibit will run until spring 2019 and will provide opportunities for INTA to share information with thousands of museum visitors about the dangers presented by counterfeit goods and further encourage consumers to buy real goods.

## Association Activities

### **INTA Addresses U.S. Secretaries of State**

On February 16, 2017, INTA members presented at the National Association of Secretaries of State (NASS) Conference in Washington, D.C. INTA has developed a relationship with NASS, which made it possible to engage with NASS and share the work of INTA's Enforcement Committee. At the conference, INTA had the

opportunity to speak to the 42 secretaries of state present.

In the United States, secretaries of state provide information and resources for companies of all sizes that are interested in doing business in their state. Businesses often use the secretary of state's website to research business name availability without sufficient

knowledge about the need to make a trademark clearance search.

The event made it possible for INTA to share trademark education and insights with the secretaries of state, who were then encouraged to share that information with local businesses in their state. INTA's Enforcement Committee also prepared FAQs, a "disclaimer," and a video



on the topic of trade names and trademarks, which the secretaries of state were encouraged to post on their state websites to assist with trademark education and outreach.

## U.S. Supreme Court: Bar Against Registering Trademarks That “May Disparage” Is Unconstitutional Violation of Free Speech

In *Matal v. Tam* (U.S., No. 15-1293, June 19, 2017), the United States Supreme Court held (8-0) that the bar in Lanham Act Section 2(a) against registration of disparaging trademarks was an unconstitutional violation of the free speech clause of the First Amendment, affirming the Federal Circuit’s en banc decision. The decision opens the door for federal registration of marks that many would consider offensive or racially insensitive. Moreover, the decision effectively ends the efforts by Native American groups to cancel the REDSKINS trademark registrations.

### INTA’s Amicus Brief

Although the Court was unanimous in its result, it was divided 4-4 on one of the key issues that [INTA focused on in its amicus curiae brief to the Supreme Court](#)—whether trademarks

should be considered commercial speech. INTA plans to continue this relationship with NASS and welcomes the invitation received by some attendees to present at additional

conferences to raise awareness on this important topic.

should be considered commercial speech. INTA argued that trademarks are commercial speech that Congress may regulate under so-called intermediate scrutiny standards of *Central Hudson Gas & Electric Corp. v. Public Service Comm’n of N.Y.*, 447 U.S. 557(1980), which allows restrictions on commercial speech if there is a “substantial purpose” and the restriction is “narrowly drawn.” INTA advocated this standard and argued against applying “strict scrutiny,” expressing concern that a strict scrutiny standard might inadvertently undermine trademark law in general.

Section 43(a) was broad and flexible and could be invoked without regard to whether a mark was registrable. The Supreme Court declined to reach this issue.

INTA’s *amicus curiae* brief was drafted by Anthony Dreyer (Skadden, Arps, Slate, Meagher & Flom, USA), Chair of the International Amicus Committee—United States Subcommittee.

Read the [full report](#) on the decision in the *INTA Bulletin*.

### Robert Carroll

Goodwin Procter LLP, Boston, Massachusetts

### Lawrence Nodine

Ballard Spahr, LLP, Atlanta, Georgia

International Amicus Committee—  
United States Subcommittee

## Free Trade Zones Workshop: Not a “Free-for-All” Zone

The declaration from 2017 INTA President Joe Ferretti (PepsiCo, Inc., USA) (pictured right) that free trade zones (FTZs) are not “free-for-all zones” kicked off INTA’s first FTZ workshop in New York City titled “Free Trade Zones: Commerce vs. Counterfeits.” The one-day workshop on March 21, 2017, immediately preceded INTA’s Brands and Fashion Conference on March 22-23 in New York City. The 60 workshop registrants, including speakers from Latin America, the Caribbean, Canada, China, and the United Arab Emirates, discussed balancing the positive economic impact of FTZs with the

proliferation of illicit and counterfeit products that pass through them. The event, which is the second such workshop after the inaugural workshop in Hong Kong, was planned and presented by members of INTA’s Anticounterfeiting Committee (ACC) and INTA staff liaisons. The International Chamber of Commerce (ICC) was a supporting partner. Read the [full report](#) in the *INTA Bulletin*.

### Donna Tobin

Frankfurt Kurnit Klein & Selz PC, New York, New York  
INTA Bulletins—Association News Subcommittee



INTA President Joe Ferretti (PepsiCo, Inc., USA)

## INTA Conference Explores How Technology Is Changing the Fashion Industry

INTA’s Brands and Fashion Conference, held March 22 - 23 in New York City, brought together more than 350 registrants from the United States and across the globe for a two-day opportunity to hear from industry and brand experts from the legal, business, and creative sectors regarding the establishment of brands on a global level. Lawyers and industry professionals shared experiences, recommendations,

and insights into protection and enforcement of intellectual property, as well as maintenance of consumer awareness in the fashion industry. Conference Co-Chairs Jessica Cardon and Marie-Laure Bonnaffous (Fendi Adele SRL, Italy) assembled speakers with a variety of perspectives on fashion and branding, with a particular focus on how technology advances have changed and continue to change the business of fashion. Read [the full report](#) in the *INTA Bulletin*.



Keynote speaker Mercedes Castillo, former creative director of accessories at Tory Burch

[continued on page 32](#)



## Association Activities continued from page 31

### INTA Hosts Small Business Roundtables with Representative Ted Deutch, Meets with IP Associations

On July 10, more than 100 South Florida business owners attended small business roundtables focused on trademarks in Fort Lauderdale, Florida, and Boca Raton, Florida, featuring Representative Ted Deutch (D-FL) and a panel of IP experts. The roundtables provided attendees an opportunity to connect with experts in trademark law and to learn about what trademarks mean for their enterprises. Following INTA's successful small business roundtable in Delaware earlier this year with

Senator Chris Coons (D-DE), these roundtables continue INTA's initiative to provide education and outreach to small businesses.

Representative Deutch, who serves as the Congressional Trademark Caucus (CTC) co-chair and an active member of the House Judiciary Committee, noted the importance of trademarks as a key component for a successful business and discussed the need for businesses to protect their products and reputations.

Following Representative Deutch's remarks, the roundtable featured a panel with IP experts, who provided an overview of the U.S. trademark

system, including a summary of the process for applying for trademark registration and trademark enforcement. The panelists encouraged attendees to seek assistance and guidance from trademark lawyers, the USPTO, and the U.S. Small Business Administration before making decisions about their intellectual property.

#### Donna Tobin

Frankfurt Kurnit Klein & Selz PC, New York, New York  
INTA Bulletins—Association News Subcommittee

### Saul Lefkowitz Competition Celebrates 26th National Finals Winners in Washington, D.C.

INTA's Saul Lefkowitz Moot Court Competition concluded another successful year at the National Finals on March 18, 2017, at the U.S. Court of Appeals for the Federal Circuit in Washington, D.C. Nationwide, 71 teams from 55 law schools participated in this year's competition. The winning team was University of San Francisco School of Law (Nguyen La, Daniel Gaitan, Jeffrey Hughes, Liam McNamara).

#### Richard Stockton

Banner & Witcoff, Ltd., Chicago, Illinois  
Saul Lefkowitz Committee Chair

#### Joseph T. Nabor

Fitch Even Tabin & Flannery, LLP, Chicago, Illinois  
Saul Lefkowitz Committee Vice Chair



From left to right: Joe Nabor (Fitch, Even & Flannery, LLP, USA), The Winning Team of the University of San Francisco School of Law (Jeffrey Hughes, Daniel Gaitan, Nguyen La, and Liam McNamara), and Richard S. Stockton (Banner & Witcoff, Ltd., USA)

## In the News

### CANADA: Federal Court Grants Rare Interlocutory Injunction Signaling it Is Open for Business

In a significant decision issued on February 9, 2017, the Federal Court of Canada issued rare interlocutory relief to a plaintiff in the trademark infringement case of *Sleep Country Canada Inc. v. Sears Canada Inc.*, 2017 FC 148.

An interlocutory injunction is an extraordinary and powerful remedy; it blocks the defendant's conduct until the completion of trial, which may take two years or more. But, for over 20 years, interlocutory injunctions in patent and trademark matters have been few and far between in the Federal Court of Canada (apart from counterfeit cases). However, for the past

five years, the Federal Court has sent informal signals to the intellectual property (IP) bar through presentations at IP conferences and other means, that it would be prepared to issue pre-trial injunctions if suitable evidence of irreparable harm were presented.

The first interlocutory trademark injunction in modern times was issued two years ago in *Reckitt Benckiser LLC v Jamieson Laboratories Ltd.*, 2015 FC 215. However, the facts of that case were very specific because the defendant had launched its mark *prior* to the plaintiff as a calculated preemptive strike to undermine the plaintiff's new brand. Nevertheless, it was hoped that Reckitt marked a new willingness of

the Federal Court to grant such injunctions.

The three-part test to obtain an interlocutory injunction in Canada is well established as:

1. a serious issue to be tried (on the merits of the infringement claim);
2. the applicant would suffer irreparable harm if the motion were refused; and
3. the balance of convenience favors the applicant.

The challenge for the past 20 years has been to prove the second factor of "irreparable harm." In particular, on that point, the Federal Court of Appeal has required proof of harm





that cannot be compensated in damages, and that should not be inferred based on a conclusion of infringement.

The present case of *Sleep Country* involved typical circumstances of trademark infringement in which the plaintiff's well-known slogan of 25 years, "Why buy a mattress anywhere else?," was threatened by Sears Canada's new slogan, "There is no reason to buy a mattress anywhere else."

The first and third elements of the injunction test—"a serious issue to be tried" and "the balance of convenience"—were not seriously disputed, and the decision turned on the "irreparable harm" element. On that point, the

court expressly acknowledged the Federal Court of Appeal jurisprudence requiring "clear and non-speculative evidence" of irreparable harm, which may not simply be inferred from trademark confusion.

Upon a detailed review of the evidence, which included affidavits from a corporate representative, a brand valuation expert, an accounting expert, and a marketing expert, the court held that Sleep Country had shown that it would suffer irreparable harm in the form of (i) potential trademark confusion leading to lost sales that would be difficult or impossible to quantify; (ii) depreciation of goodwill; and (iii) loss of distinctiveness. The court's treatment

of the kind of evidence required to show irreparable harm and its criticism of the defendant's responding evidence provides a roadmap to future litigants seeking to obtain or defend an interlocutory injunction.

This decision marks a bright new day for IP owners seeking to obtain interlocutory relief from the Federal Court of Canada.

**Contributor: Daniel M. Anthony**  
Smart & Biggar/Fetherstonhaugh, Ottawa, Canada

**Verifier: Ted Brook**  
Chitiz Pathak LLP, Toronto, Canada

## UNITED STATES: Fame Should Be Weighted for Likelihood of Confusion Analysis in Dispute over "Insignia" Marks

The U.S. Court of Appeals for the Federal Circuit (Court) recently held the Trademark Trial and Appeal Board (Board) erred when it considered a mark's fame as an all-or-nothing factor in a likelihood of confusion analysis (*Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, Appeal No. 2016-1089 (Fed. Cir. May 24, 2017) (precedential)).

Since 1979, appellant-petitioner Joseph Phelps Vineyards, LLC (Vineyard) has owned the registered mark INSIGNIA for its high-end bottled wine. Appellee-registrant Fairmont Holdings, LCC (Fairmont) received registration of the mark ALEC BRADLEY STAR INSIGNIA in 2012 for its cigars and cigar products. Vineyard petitioned the Board to cancel Fairmont's mark, alleging a likelihood of confusion with its claimed well-known mark. Conducting the *du Pont* factor analysis, the Board denied Vineyard's petition because it concluded, *inter alia*, Vineyard's INSIGNIA wine mark was not "famous" despite success in the marketplace.

The Court vacated this decision on appeal. The correct standard for the likelihood of confusion analysis is a totality of the circumstances, which considers all of the relevant *du Pont* factors (like fame or, as sometimes described, the

strength of the mark) on a scale appropriate to their merits. The all-or-nothing standard the Board used to measure the fame of Vineyard's mark in this case was therefore "legally incorrect," said the Court. Evaluation of fame as a factor in likelihood of confusion analysis is different from considering fame in a dilution context. "While dilution fame is an either/or proposition—fame either does or does not exist—likelihood of confusion fame 'varies along a spectrum from very strong to very weak.'" According to the Court, the Board was wrong to discount the fame of Vineyard's INSIGNIA mark entirely; it should have afforded the mark some level of fame along the applicable spectrum.



Fame in a confusion context exists if a significant portion of the relevant consuming public

recognizes the mark as a source indicator. This includes both actual customers and potential customers, but not the general public. As the Court noted, Vineyard provided ample evidence suggesting Insignia wine is well-known and revered among the relevant consuming public of fine wine (e.g., Insignia wine was selected as Wine of the Year in 2005 and 1997; *Wine Spectator* noted that Insignia wine consistently earns an outstanding score in 26 of its 29 vintages; Insignia wine repeatedly received positive reviews in national press; Insignia wine has been served at the White House). As such, the Court was "perplexed" at the Board's finding that Vineyard's Insignia wine is not famous and remanded the case for reconsideration in line with the proper totality of the circumstances standard.

**Contributors: Deborah A. Wilcox**  
Baker & Hostetler LLP, Cleveland, Ohio

**Cory Barnes**  
Ohio State University Moritz College of Law,  
Columbus, Ohio

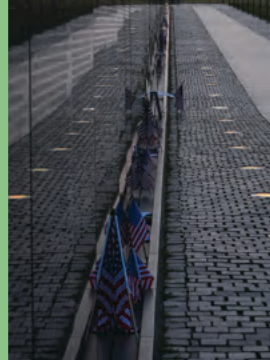
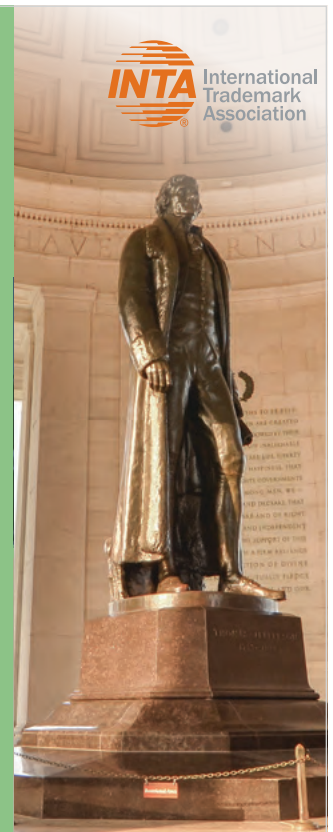
**Verifier: Kevin W. Grierson**  
Culhane Meadows PLLC, Washington, D.C.

Ms. Wilcox and Mr. Grierson are members of the INTA Bulletins Law & Practice—North America Subcommittee

# LEADERSHIP MEETING

Register Today!

[www.inta.org/2017lm](http://www.inta.org/2017lm)



**WASHINGTON, D.C.**  
**NOVEMBER 7-10, 2017**

## Geographical Indications

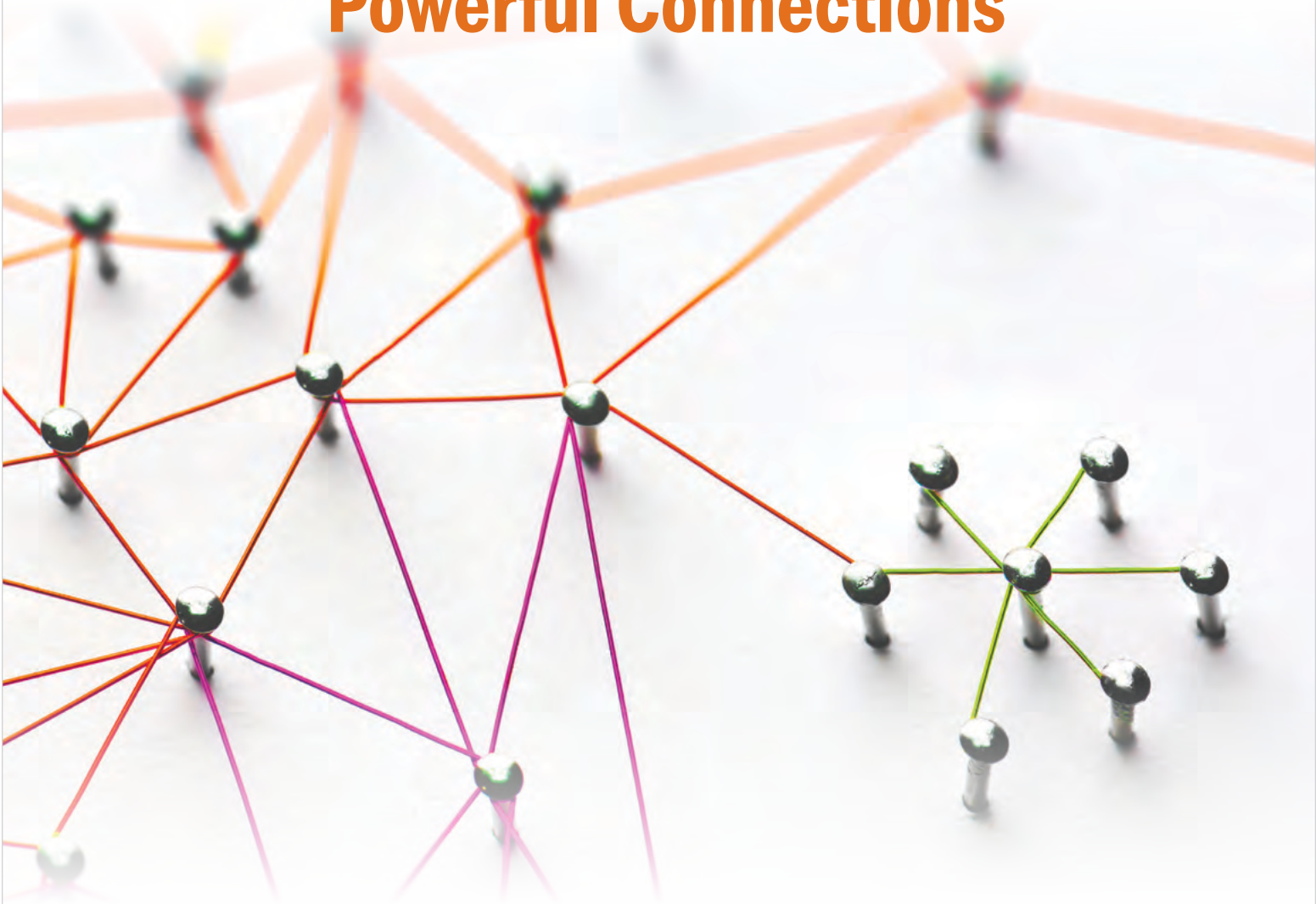
### Certification Marks and Collective Marks: An International Guide

This resource assists attorneys in determining how to protect geographical indications, certification marks, and collective marks in select jurisdictions, whether under *sui generis* laws or other types of law.

Visit [www.inta.org/giguide](http://www.inta.org/giguide) to learn more about this new tool and how it can help you in your daily research!



# Powerful Network, Powerful Brands, Powerful Connections



**Join the conversation today – #INTAGlobal**



# Save the Date!



# 140<sup>TH</sup> ANNUAL MEETING



— MAY 19-23, 2018 —

