INTA returns to Africa

INTA's first conference in Africa for more than 20 years will focus on "how you grow your business in Africa and develop your brands," said Barry Gerber of Philip Morris International, co-chair of "Building Africa with Brands," which takes place in Cape Town in September.

His co-chair, Brenda M. Wood Kahiri of B. W. Kahiri in Zimbabwe, added that the conference comes as investment in areas such as the cleantech, Internet and mobile phone industries is increasing, and it complements INTA's Africa Rising initiative. "There are some huge opportunities in Africa and with the right expertise we can overcome the challenges," she says.

ARIPO calls on users to try its improved system

"We have come a long way in many ways. We are now more mature, our system is now more efficient and coherent, but we are always looking to improve," said ARIPO Director General Fernando dos Santos, who spoke to the INTA Daily News yesterday.

ARIPO will be celebrating its 40th anniversary this December and dos Santos said it has stuck to its founding principles. "The founders understood the importance of IP in economic and technological development and the objective is to collaborate with each other and harmonize the way we work. This is what we are doing today," he said.

"This 40th celebration is a moment to reflect on the past and our achievements, as our mandate has expanded to cover many IP rights."

Dos Santos said ARIPO's new online filing system has improved Office processes and experience for staff and users alike. "It is more reliable, faster and cost-effective. There is a discount for those who file online," he noted. ARIPO recently unveiled a new two-tone blue logo, something that he said reflects the fresh, modern outlook of the organization.

ARIPO now has 10 contracting parties to the Banjul Protocol (Trademarks), but dos Santos said the organization is not resting on its laurels: "We still need more member states to accede to and domesticate the Protocol. Mozambique and Zambia are two members we are expecting to accede soon."

Dos Santos acknowledged that progress is slow but said there is a solution: "Trademark administration is a major source of revenue for our members. Two years ago we introduced a fee structure system where members can make a request for their own fees in an ARIPO application designating them."

Unlike OAPI, however, ARIPO cannot join the Madrid System because of its setup. "We are not unitary in nature," says dos Santos. "Some of our member states are party to the system, but I believe the system can co-exist well with the Banjul Protocol."

Looking forward, dos Santos said ARIPO will continue to collaborate with international IP stakeholders and intends to conduct research in an effort to support its principles. "We are committed to helping members with their IP systems and to improve our Protocols. To help with this we are planning to tap into our academic connections to start research studies into IP in Africa," he explained, mentioning that INTA, among other groups, has been "very supportive." INTA's "Building Africa With Brands" conference will take place in Cape Town, South Africa September 1-2, 2016.

He concluded with a message to IP owners interested in the African markets: "Trust our system. It is working."
May the enforcement be with you

In-house counsel for some of the biggest names in their respective businesses shared their best strategies on enforcing brands in the digital environment in a panel on Monday. Moderator Esther Ono, Turner Broadcasting’s corporate legal manager of trademarks, asked each of the five speakers to present how they would approach enforcement on one of five digital platforms, using Cartoon Network’s newly rebranded and rebooted POWERPUFF GIRLS TV show as a test case.

When a website infringes a brand, effective enforcement is all about asking the right questions. Amy Grayem, Assistant General Counsel, Marketing & Intellectual Property for Nationwide Insurance, suggested that a brand’s first step in enforcement should be a thorough internal investigation to ensure the correct identification of the infringer. Most importantly, in-house counsel should ask: “What’s the business impact? What’s the financial impact?” Sometimes it’s really just a business decision, said Grayem, and it’s best not to pursue the infringer, “but you need to make sure you have all the information.” Armed with this information, a brand can decide whether it’s most appropriate to send a cease and desist letter to the infringer, or to the site host—Grayem’s usual preference—or, if it seems likely that the infringer will persist with other hosts, to litigate.

If a brand’s domain name is the victim of cybersquatting, the UDRP will become their best friend, according to Verizon’s Patrick Flaherty. He suggested that, in order to catch infringers, brands use watch services, in addition to performing their own searches and paying attention to third-party reports. If a cease and desist letter is not sufficient to stop the cybersquatter, Flaherty gave the audience tips for successfully filing a UDRP, such as including screenshots of the infringing site and the results of a Whois lookup of the domain name owner.

“If we don’t have a strong App Store presence, we’re missing out,” said Allisen Pawlenty-Altman, Amazon’s Corporate Counsel, and infringers would be too. On average, people check their phones 46 times a day, making mobile games and apps a critical platform on which to enforce brands. But, Pawlenty-Altman cautioned, it’s important to approach with care, taking the PR perspective into consideration; if an infringer is “expressing love for our brand that isn’t really appropriate, maybe a soft approach is best,” she said.

As Facebook’s Director and Associate General Counsel (Trademark Practice), Kathleen Elaine Johnston and her team “have a dual perspective of being both an online platform and a brand owner; we’re on both sides,” she said. From her experience as a representative of either side, she encouraged brand owners to use the forms provided by online marketplaces. “They’re there because these businesses have invested in building out these programs and this is going to be the fastest way to get [the infringer’s] attention,” she said.

Gerí Lynn Elias, Vice President and Intellectual Property Counsel for Kate Spade, spoke about the importance of engagement and brand protection on social media. “You cannot not be in the space at this point in time without knowing how to educate your business people” about the advantages and risks of social media, she said. Advantages—such as the speed and ease with which information spreads on social media and its immunity from a company’s control—expose companies in negative ways as well as positive ones. For this reason, she stressed that proper clearance and educating all members of a company to be its “eyes and ears” is invaluable to brand protection.

Don’t you know who I am?

Panelists shared tricks for defeating trademark hijackers in various jurisdictions yesterday in the session “Almost Famous: Proving Fame in First to File Jurisdictions.”

Tiki Dare of Oracle Corporation offered a war story from Oracle in Chile. The technology company did not have a registration in Chile when a watch notice for trademarks, asked each of the five speakers said an applicant would likely need a surefire way to present how they would approach social media and the company’s involvement in the Americas Cup. “It didn’t hurt that we were in Iron Man 2,” she said.

Mauro Santos of Dannemann Siemens Bigler & Ipanema Moreira in Brazil gave an overview of well-known trademarks and famous trademarks in his country.

Well-known trademarks give a trademark owner the chance to attack a third party independently of whether it has previously filed or registered in Brazil. The general conditions needed are evidence in Brazil, evidence in the field of activity and evidence prior to infringement. Actual use is not a pre-condition, however.

Famous trademarks get a higher level of protection. “The Brazilian PTO is very stringent on evidence for these,” said Santos. “It is a very high standard.” He said an applicant would likely need a survey showing brand recognition with more than 60% of the public. When taking on trademark hijackers, bad faith is a strong tool in Brazil because there is no time limit for requesting cancellation.

Spring Chang of Chang Tsi & Partners in China said that famous is an interesting concept in her country. If you don’t have a registration, you have to claim you are famous within the class at issue, for example.

The panel, moderated by Rachelle Dubow of Morgan Lewis & Bockius in the U.S., shared some practical tips. “The number one thing is to build a fame binder,” said Dare. “I have found it very important to maintain some kind of record.” This would include items such as the company’s welcome book, InterBrand rankings, and lists of licensees and worldwide partners.

David Gooder of Jack Daniel’s Properties urged registrants to “update constantly.” He advised being mindful of how far back they will need evidence. He said Jack Daniel’s once had to prove fame in a country going back 20 years.

Another tip was to consider unconventional evidence. One example is the Wayback Machine Internet archive. It is not always easy to search but “you can often find a website from a long time ago,” said Dare.

Gooder said to consider the impact of paid compared to unpaid product placement. “My feeling is it doesn’t really matter,” he said, because people are exposed to the product either way. Other examples of unconventional evidence were being referenced in competitor advertising, mentions on social media and evidence in the country of counterfeiters and take-offs of the brand.

Michael Graham of Expedia spoke on a panel yesterday about the value of trademarks for technology companies in the transportation and hospitality spaces and those based on a sharing-economy model.
Your products are sold in emerging markets in ASEAN and Africa regions but you are dealing with a major counterfeiting issue. Considering that each country is unique in terms of legal system and culture, how should you tackle this problem? Monday’s session entitled “Anticounterfeiting Strategies in South East Asia and Africa” explored this. The session was moderated by Lara Kayode of O. Kayode & Co.

Kingsley Ejiofor of NAFDAC (Nigeria) said international and regional collaboration is crucial in the fight against counterfeits in Africa, and that his agency has benefited from this approach. “When they escape from one place we can catch them where they go,” says Ejiofor. He said conflict between various public authorities in a country can hinder efforts, and that engagement with local communities helps. “We’ve come to realize that awareness is key in this fight,” he said. Ejiofor also informed registrants about next month’s public hearing in the Nigerian Senate on the issue of counterfeiting.

Nick Redfearn of Rouse said the IP regimes and justice systems in ASEAN countries vary. For example, Thailand and Malaysia have specialized IP courts whereas Vietnam and Cambodia do not. Redfearn said strategically important ASEAN countries need to take the lead on IP enforcement in the region, picking out Singapore as a leading light. He noted the Internet has worsened counterfeiting in the region. “This is because of the boom in e-commerce. Governments are not yet able to understand where e-commerce is going,” he said. For brand owners facing major counterfeiting problems in the region, Redfearn advised: “Self-help is the only way for now.” He said the branded goods industries need to collaborate, just like the copyright-based industries, to deal with this problem.

Redfearn said the best way to approach the issue is through customs, but unfortunately most Southeast Asian countries do not yet have strong IP protection at customs. He believes Thailand’s authorities operate well in this area, but it remains to be seen when others will get to that level. China, he said, has made progress due to health concerns. Corruption and smuggling can also affect anticounterfeiting efforts but this is not something the IP community can do anything about. “This is a failure of the legal system,” he noted. He said the narrative should be that counterfeiting is part of general illegal activities.

“Don’t put all your efforts into the administrative system. You need the criminal system to work too.”

William Mansfield of ABRO Industries Inc. urged Western brand owners not to give up on certain markets even though it is tough. “If you work in the right way you can be a success story,” he said. He highlighted that the approach in developed countries is unlikely to work in developing countries. “In most of these countries lawsuits don’t work. Let go of the lawsuit mentality,” he warned. “These are different countries with different problems,” he said, adding: “You have to adapt to the environment. Be prepared to think how they think.” Lastly, he urged brand owners to venture out into these countries and present their cases to the government.

Nick Redfearn of Rouse said the IP regimes and justice systems in ASEAN countries vary. For example, Thailand and Malaysia have specialized IP courts whereas Vietnam and Cambodia do not. Redfearn said strategically important ASEAN countries need to take the lead on IP enforcement in the region, picking out Singapore as a leading light. He noted the Internet has worsened counterfeiting in the region. “This is because of the boom in e-commerce. Governments are not yet able to understand where e-commerce is going,” he said. For brand owners facing major counterfeiting problems in the region, Redfearn advised: “Self-help is the only way for now.” He said the branded goods industries need to collaborate, just like the copyright-based industries, to deal with this problem.

Redfearn said the best way to approach the issue is through customs, but unfortunately most Southeast Asian countries do not yet have strong IP protection at customs. He believes Thailand’s authorities operate well in this area, but it remains to be seen when others will get to that level. China, he said, has made progress due to health concerns. Corruption and smuggling can also affect anticounterfeiting efforts but this is not something the IP community can do anything about. “This is a failure of the legal system,” he noted. He said the narrative should be that counterfeiting is part of general illegal activities.

“Don’t put all your efforts into the administrative system. You need the criminal system to work too.”

William Mansfield of ABRO Industries Inc. urged Western brand owners not to give up on certain markets even though it is tough. “If you work in the right way you can be a success story,” he said. He highlighted that the approach in developed countries is unlikely to work in developing countries. “In most of these countries lawsuits don’t work. Let go of the lawsuit mentality,” he warned. “These are different countries with different problems,” he said, adding: “You have to adapt to the environment. Be prepared to think how they think.” Lastly, he urged brand owners to venture out into these countries and present their cases to the government.
Digital discussions in Brussels

The Digital Agenda, the use of trademarks online, effective digital enforcement, the implications of a mobile economy and copyright protection will be just some of the topics addressed at INTA’s Digital World Conference in Brussels on December 1 and 2 this year.

The conference will be co-chaired by INTA Past Presidents Toe Su Aung and Melian Stark, who says it will cover “the changing landscape of business” and take “a holistic approach.” She adds: “These issues will impact your business and are already doing so. While people in the trademark field get exposed to issues such as domain names and Whois, they don’t often get the opportunity to explore other facets.”

“There are many challenges, but all challenges present opportunities,” says Aung. “And unless you have a specific e-commerce counsel, it’s often the IP counsel who has to deal with these issues.” She adds that the two-day program, which is now being put together, will feature panels, discussions and keynotes from experts in their fields, including some from outside the familiar IP world.

As the conference is being held in Brussels, senior Commission officials and MEPs are also expected to attend.

The conference comes as European member states are discussing issues such as territoriality in the context of the Digital Single Market. Aung says that topic will be addressed, but the conference will range much more widely, looking at the role of brands in the digital economy in many different respects: “In many ways, the Internet is really a global single market.”

That means brands will become more important, rather than less so, says Stark: “The brand is how you navigate content, and you will be relying on it more than ever before. So I believe people will be more cognizant of the power and efficacy of brands.”

Registration for the Digital World Conference opens on September 14.

INTA’s Unreal Campaign was launched in 2012 to educate teenagers (ages 14-18) about the importance of trademarks, intellectual property, and the dangers of counterfeit products. It has successfully reached more than 6,200 students since then. In 2016, the Campaign held events for the first time in five cities: Rome, Italy; Singapore; Managua, Nicaragua; Sydney, Australia; and Ottawa, Canada. Contact Laura Heery at lheery@inta.org for information about sponsoring an Unreal Campaign event or to get involved.
Industry Awards 2016
Winners revealed
www.WTRIndustryAwards.com

World Trademark Review is pleased to announce the winners of the World Trademark Review Industry Awards 2016, revealed last night at the Hilton Orlando Bonnet Creek. Now in their tenth year, the awards shine a spotlight on the vital work performed by in-house counsel across the globe and identify the teams and individuals that deserve special recognition for their exceptional achievements over the past year.

World Trademark Review congratulates the award winners on their success and thanks its law firm partners for all their assistance in hosting such a memorable event.

For more information about the awards visit Booth 1417 in the exhibition hall or go to www.WTRIndustryAwards.com

---

Asia-Pacific Team of the Year
Billabong International
Sponsored by Marks & Clerk

Financial & Professional Services Team of the Year
Voya Financial
Sponsored by NetNames

Not-for-Profit Organisation Team of the Year
American Red Cross
Sponsored by Davis Wright Tremaine

Vehicles & Transport Team of the Year
Jaguar Land Rover
Sponsored by Balder

Europe, Middle East and Africa Team of the Year
Red Bull
Sponsored by Intima

Food, Beverages & Tobacco Team of the Year
Chocoladefabriken Lindt & Sprüngli
Sponsored by Cooley

Software & Online Services Team of the Year
Facebook
Sponsored by C'MS Law Tax

In-house Team of the Decade
Google
Sponsored by SeedJP

Latin America Team of the Year
Grupo Bimbo
Sponsored by Daniel

Healthcare & Life Sciences Team of the Year
GlaxoSmithKline
Sponsored by Gowling WLG

Sports, Entertainment & Media Team of the Year
A+E Networks
Sponsored by epoint

In-house Counsel of the Year
Colm Dobbin, MasterCard
Sponsored by Locke Lord

North America Team of the Year
Enterprise Holdings
Sponsored by Fish

Household & Consumer Goods Team of the Year
Procter & Gamble
Sponsored by Ap

Technology & Consumer Electronics Team of the Year
Honeywell International
Sponsored by Rouse

Lifetime Achievement
Frederick Mostert
Sponsored by World Trademark Review

Fashion, Cosmetics & Luxury Goods Team of the Year
Moncler
Sponsored by Venable

Internet & Telecommunications Team of the Year
Verizon Communications
Sponsored by fieldfisher

Travel & Leisure Team of the Year
Hard Rock International
Sponsored by Dentons

---

World Trademark Review is the world’s only independent daily news and information service dedicated to the issues that matter to international trademark professionals.

The magazine, along with the daily email alert, editor’s blog and regular outbound supplements, keeps trademark practitioners abreast of the latest business, legal and brand management developments.

Visit Booth 1417 for more information or visit our website for a free sample copy and three weeks’ free online access.

www.WorldTrademarkReview.com
The trademark cases to watch in the U.S.

Michael Loney previews today’s sessions on U.S. case law and scandalous marks.

Registants will be brought up to speed on the most important trademark cases in the United States in the ever-popular Annual Review of U.S. Federal Case Law and TTAB Developments session today, with Theodore Blackhorse of Wolf Greenfield & Sacks and John Welch of Wolf Greenfield & Sacks.

Two cases sure to be discussed are the In re Tam and Pro Football, Inc., v. Blackhorse (Redskins) cases. The Tam case is now being appealed to the Supreme Court after the Federal Circuit sitting en banc in December last year ruled that the disparagement provision in section 2(a) of the Lanham Act is unconstitutional, and reversed and vacated the Trademark Trial and Appeal Board’s (TTAB) holding that THE SLANTS is an unregistrable mark. The Redskins case is pending before the Fourth Circuit but Pro-Football last month petitioned for a petition for certiorari at the Supreme Court. This was an unusually proactive move from Pro-Football.

“I was a little surprised,” says Welch. “Most trademark practitioners don’t even dream of getting to the Supreme Court. I had never heard of a petition for certiorari before, and I think it was a good idea because these two cases should be decided the same way. That was a pretty clever maneuver.”

Another case that Welch, who runs the TTABlog, will be discussing is the Board of Trustees of the University of Alabama et al. v. HoundsTooth Mafia Enterprises LLC et al case. “It’s a really crazy case,” he says. Last year, the TTAB refused to vacate its 2013 precedential decision that dismissed an opposition to registration of the mark HOUNDSTOOTH MAFIA for shirts and hats. This was despite a judge in the District Court for the Northern District of Alabama ordering that the Board’s decision be vacated. In February this year, Judge David Proctor granted the Board of Trustees of the University of Alabama’s motion to enforce the judgment, denied as untimely the USPTO’s motion to intervene, and issued an order requiring the TTAB to vacate its decision within 14 days.

“It’s an interesting case because it basically says if you lose at the TTAB you can buy your way out of it by giving the other side some money and getting a consent judgment that says the Board decision should be vacated,” says Welch.

One case that Davis will cover is the Belmora LLC v. Bayer Consumer Care (FLANAX) case. This complicated case is being closely watched. Bayer had used the FLANAX mark for naproxen sodium pills in Mexico but not in the United States because it sells the Aleve product there. Belmora registered the FLANAX mark in the United States and sold pills in packaging that was similar to that used by Bayer in Mexico.

The Fourth Circuit in March this year held that Bayer could bring false association and false advertising claims under the Lanham Act, as well as a petition before the TTAB to cancel Belmora’s U.S. registration of the FLANAX mark based on deceptive use. This is despite Bayer’s non-use of the mark in the United States. “That is a really interesting case because it is a chink in the wall of territoriality that is pretty shocking,” says Welch.

“It is a very interesting case. They said that Mexican-Americans might go over into Mexico and be confused about which is which, and Mexicans visiting the U.S. might be confused. It is kind of crazy. The problem with this case from the start has been Belmora is a really bad actor. Not only did he make false statements, his testimony was unbelievable.”

Hear about these and other cases in the CW'01 Annual Review of U.S. Federal Case Law and TTAB Development sessions taking place from 10:15 am to 11:30 am today.

The TTAB’s proposed rule changes

In April, the USPTO proposed to amend the Trademark Rules of Practice before the Trademark Trial and Appeal Board (TTAB). This would be the first update to TTAB rules since 2007. Comments on the proposed changes are due to the TTAB by June 3.

Some of the most important changes in the 29-page document include:

- A requirement that all filings in TTAB proceedings be made via ESTTA.
- A shift in responsibility to the TTAB to serve notices of opposition and petitions for cancellation.
- A requirement that all discovery be completed by the close of the discovery period.
- Option to submit testimony by declaration or affidavit, subject to cross-examination.
- Ruling that service of papers between parties be effected by email.
- Limitation of document requests and admission requests to 75 per party.

Tips for avoiding offense

The panellists will be providing some tips for negotiating this thorny issue.

“Sometimes it helps to make sure that if your brand might be considered by some to be vulgar, scandalous or sensitive that you try to limit the goods and services;” says Rojas. “The office will consider sometimes who is the targeted consumer, and whether they will be offended or not.”

Rojas adds that if you want to cover a lot of countries, it can be a good idea to go through the Madrid System because it doesn’t reject based on vulgarity or scandalousness.

“WIPO accepts everything then lets each country reject based on their national standards,” says Rojas. “So you might be able to get more registered than not in that case because you might have some countries saying no but some countries saying yes.”

In addition, for a good that you are going to launch in several countries, you should always make sure you investigate not only the language but also whether a word is slang in those countries. “Especially if you are considering a big regional marketing launch or selling, those are things you have to consider,” concludes Rojas.

CW21 Are you Getting Down and Dirty in a Correct Way? Protection of Immoral, Vulgar, Scandalous or Simply Culturally Sensitive Trademarks takes place from 11:45 am to 1:00 pm today
Your reliable partners for intellectual property matters in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

UNITED TRADEMARK & PATENT SERVICES
International Intellectual Property Attorneys
Trademark, Patent, Design, Copyright, Domain name registration, litigation & enforcement services

Pakistan Office
85 -The Mall Road, Lahore 54000 Pakistan  (Opposite Ferozesons books store / adjacent radio time center)
Email: UnitedTrademark@UnitedTm.com  Websites: www.utmps.com and www.unitedip.com

Gulf, Middle East, South & East Asia and African Offices

DUBAI (UAE)
Suites 401-402, Al-Hawai Tower
Sheikh Zayed Road, Dubai
Tel: +971-4-3437 544
Fax: +971-4-3437 546
Email: Dubai@UnitedTm.com

OMAN
Suite No. 702, 7th Floor
Oman Commercial Centre, Ruwi
Tel: +968-24-787555, 704788
Fax: +968-24-794447
Email: Oman@UnitedTm.com

SRI LANKA
105, Hunupitiya Lake Road, Colombo 02,
Sri Lanka.
Tel: +94 11 4322790-1
Email: srilanka@UnitedTm.com

JORDAN (Amman)
Suite 7, 2nd Floor
Chicago Building, Al Abdali
Tel: +962-6-5683088
Fax: +962-6-5683089
Email: Jordan@UnitedTm.com

QATAR
Villa # 40, Al Amir Street
Al Mirqab Area, Doha, Qatar
Tel: +974-444 3083, 444 3093
Fax: +974-444 7311
Email: Qatar@UnitedTm.com

LEBANON
6th Floor, Burj Al-Ghazal Bldg.,
Tabaris, Beirut, Lebanon
Tel: +961-1-21 5373
Fax: +961-1-21 5374
Email: Lebanon@UnitedTm.com

SAUDI ARABIA
Behind Maktabab Al Shawwaf
30th Street-Offaya, Riyadh 11444
Tel: +966 -11- 4616157, 4655477
Fax: +966 -11- 4616156, 4622134
Email: SaudiArabia@UnitedTm.com

SHARJAH (UAE)
Suite 203, Al Buahirah Building
Buahirah Comiche, Sharjah
Tel: +971-6-5722742
Fax: +971-6-5722741
Email: UAE@UnitedTm.com

SUDAN (Khartoum)
Flat No.1, 3rd Floor, Al Hurriya St.
Shaik Al Deen Brothers Bldg.
Tel: +249-183-740634
Fax: +249-183-796031
Email: sudan@UnitedTm.com

TANZANIA
Shauri Moyo Area,
Pugu Road
Dar-Es-Salaam
Tel: +255-222862900
Email: Tanzania@UnitedTm.com

YEMEN
6th Floor
Ideal Clinic Building
Hadda Street, Sana’a, Yemen.
Tel: +967 181 9642
Email: yemen@UnitedTm.com
China's trademark reforms, two years on

Two years ago, China introduced major amendments to the Trademark Law. Lily Changxin Lei and Wen Zhong of Liu Shen & Associates analyze the impact they have had.

The latest Trademark Law made several changes designed to speed up the examination and opposition procedure. Have the changes achieved the goal so far?

Lily Changxin Lei: According to my far-from-being-exhaustive research, at least more than 80% of cases (trademark applications, non-use cancellations, oppositions, review applications on rejection/opposition decision/cancellation and etc. filed after May 1 2014) have been examined and concluded within the statutory time limit. Yet it is noticed and assumed that of the 80% and more concluded cases, extensions of time (varying from three months to six months depending on the nature of the case) have been applied a lot. According to the law, where special circumstances arise, extension of time can be applied upon approval of the competent authorities.

Trademark applicants or their agents will not be able to know if and for what reason an extension of time is applied. They may only make assumptions based on the time when they receive Office Actions (Notification of refusal, Notice of publication, Review decision, opposition decision etc.). According to the law, the time for responding to a Notice of Amendment, supplementing materials, pending other procedures etc. shall not be counted in. It is noticed that time for waiting in the queue for handling at the Trademark Office Mail Room, which can be months, will not be counted in. It is noticed that time for waiting in the queue for handling at the Trademark Office Mail Room, which can be months, will not be counted in.

Lily Changxin Lei: From where the trademark applicants stand, the cons of a multi-class application are way more than the pros.

Cons: a multi-class application does not save money at all, as opposed to class-by-class applications. The official fee for filing, assigning, recording change, licensing renewing etc. is still charged class-by-class.

Division is only possible between the rejected part and the approved part when the application is partially rejected by the Trademark Office. This means it is not possible to divide an application (or later a registration) anyway in case of assignment and renewal.

When division happens in the case of a partial rejection, it takes money and time. Meanwhile such division will delay the process of the approved part of the application.

When a Notice of Amendment (for instance on non-standard description of goods) happens, handling the Notice will delay the process of the whole application. Even worse, a mis-handling of the Notice may result in invalidation of the filing date of the whole application. The non-problematic part will be seriously affected by the problematic part.

Pros: It is easy to manage the portfolio since only one registration number and date is allocated, especially for companies with a large trademark portfolio.

Weighing the pros and cons, we would advise our clients to stick to single-class applications. Although it is a trend to do multi-class applications, we think it better to wait until further complementary rules and systems on charging and division of cases come into being.

Trademark Office (or later a registration) anyway in case of assignment and renewal.

New provisions have been added to tackle trademark squatting. What has been the result so far?

Wen Zhong: Speaking of newly added anti-squatting provisions, we are mainly talking about Articles 15 (against agent’s or representative’s application), 58 (protecting prior use) and 59 (prohibiting third party’s use as trade mark and descriptions of goods in a way to solve evident problems prior to filing to avoid entanglement affecting the whole application.

Pros: It is easy to manage the portfolio since only one registration number and date is allocated, especially for companies with a large trademark portfolio.

Weighing the pros and cons, we would advise our clients to stick to single-class applications. Although it is a trend to do multi-class applications, we think it better to wait until further complementary rules and systems on charging and division of cases come into being.

Should an applicant insist on filing a multi-class application, the agent had better have an overview of the trademark and descriptions of goods in a way to solve evident problems prior to filing to avoid entanglement affecting the whole application.

How does the revised law determine a bad-faith registration?

Lily Changxin Lei: In practice, it has been difficult to prove bad-faith, which usually expresses itself in malicious intention, ill purpose and possible harm. Malicious intention and ill purpose may have some overlap. If evidence can be produced to prove some of the following, there may be a case for claiming bad-faith:

• The registrant has access to the real owner’s trademark through previous negotiation/cooperation/employment/etc;
• The registrant has no intention or capacity to use the trademark at all;
• The registrant offers to assign or license the trademark at unreasonable high price;
• The registrant uses the registration to force the real trademark owner into commercial cooperation;
• The registrant fakes information/document obtaining the registration;
• The real owner's trademark has been used in Mainland China and has established a reputation.

In addition to the above, evidence proving the following may also help:

• Registrant is in the same industry as the real owner;
• Goods of the parties have the same sales channel, geographic coverage etc;
• Registrant has registered large amount of trademarks that obviously belong to someone else;
• Taking advantage of famed (or well-known) marks, confusing the public and disordering fair competition and market are possible harms.
Does the latest Trademark Law bring any changes to the area of well-known trade marks?

Lily Changxin Lei: In my understanding, the amended Trademark Law is meant to bring the well-known mark back to its original and appropriate status and position. “Well-known mark”, being a category in the Law, means high quality and honor. Also, well-known marks do not necessarily refer to other Law articles or finding other facts to reach the same judgment than deciding that a mark is well-known.

On the other hand, however, as well-known marks are entitled to special, wider and stronger protection, a large number of trademark owners are still quite interested in their marks being recognised as well-known marks, though under current circumstances, administrative authorities and courts having jurisdiction on recognizing well-known marks are super cautious in well-known mark recognition. Unless in an extremely necessary cases, the authorities and courts would rather apply to other Law articles or finding other facts to reach the same judgment than deciding that a mark is well-known.

Do trade mark holders get sufficient compensation as expected, after the revised Trademark Law increased damages granted in infringement cases?

Wen Zhong: We think that the trademark holders now have the reason to expect a reasonable compensation determined by the China courts for trademark infringement. The Beijing IP Court is the first set-up IP court specialized in hearing IP cases, and is the base of the China Supreme Court for establishing a nation-wide Case-Guidance System. So the judgments made by the Beijing IP Court are of reference value to the general compensation level after the Trademark Law was revised in this regard, or at least can give the indication on how it will go in the future.

Take 2015 statistics for instance: the Beijing IP Court accepted and heard six trademark infringement cases in 2015, and the total compensation requested amounts to ¥4.74 million ($750,000); on average, ¥790,000 requested for each case. Among those, ¥3.72 million are supported by the court, and on average ¥620,000 for each. Compensation supporting rate is 78.48%. What is more, compensation requests were fully supported in three cases and in one of the three cases, the amount of compensation requested was ¥3 million which was fully supported by the court, too.

It is the trademark infringement case that gets the highest average compensation amount and highest supporting rate with respect to all the IP-related infringement cases being heard by the Beijing IP Court. So, to our review, the compensation level is increased considerably compared with the past; for ease of reference, from 2008 to 2012, a well-recognized academic institute had made a survey on the compensation level of trademark infringement litigations; the result revealed that among 488 cases litigated before the court, the average compensation amount was only ¥2,000, while the average request was ¥330,000.

Lily Changxin Lei

Lily Changxin Lei, attorney-at-law, is a partner of Liu, Shen & Associates, heading the firm’s trademark practice.

Lily obtained her BA degree from the Institute of International Relations, majoring English literature and international relations. She also has a Certificate of Incompletion of graduate from Beijing Foreign studies University on United Nation subjects. Part of her legal training is on a ‘Young Chinese lawyer’s training Scheme in London University, Clifford Chance and Chambers of Christopher Morcom QC.

Lily’s expertise includes advising corporate clients on trademark filing strategy, trademark portfolio management, providing full-range service on trademark prosecution, including clearance search, trademark filing, trademark licensing and assignment, opposition and invalidation, administration litigation and the like. She advises US, European and Japanese companies on trademark protection strategies in China. She also advises Chinese companies on trademark protection in China and abroad, through national, Madrid and EU registration channels to obtain greatest protection at the least cost. As a team leader, she supervises the practice of the firm’s trademark team.

Lily makes presentations on INTA Forum and seminars sponsored by corporate clients and firm clients, on trademark issues in China.

Wen Zhong

Wen Zhong is an attorney at law and partner of Liu, Shen & Associates. He has two Masters of-law degrees, from Law school of Liaoning University in China, and Law School of Toin University of Yokohama in Japan as a Government-financed student, and up to 2016, he has handled more than 550 trademark opposition and invalidation cases, over 30 trademark infringement cases, about 10 copyright infringement cases, over 15 unfair competition cases, and jointly handled several patent infringement cases, etc. The companies he has represented are mostly multi-national companies such as Realnetworks, ABB, BASF,LEGO and Schneider Electric, etc.
1. Orlando was named in 1857 (1856 was also accepted)  
Winner: Bidyut Tamuly, Archer & Angel, India

2. Orlando is a character in Shakespeare’s As You Like It  
Winner: Leanne Stendell, YUM! Brands, Inc., USA

3. The old City Hall was demolished in Lethal Weapon  
Winner: Jason DeFrancesco, Baker & Rannels, PA, USA

4. The band formed in 1995 was N'Sync  
Winner: Uche Chiwetalu, Ken Ahia & Associates, Nigeria

Winners can collect their prizes from the Managing IP booth (#207) in the Exhibition Hall until 2pm today.
Trademark practitioners in the U.S. are thinking more strategically about the Trademark Trial and Appeal Board (TTAB) since the Supreme Court’s B&B Hardware v. Hargis Industries ruling in March last year. A session on Monday looked at the ruling’s impact in the U.S. and Europe.

The Supreme Court held that: “So long as the other ordinary elements of issue preclusion are met, when the usages adjudicated by the TTAB are materially the same as those before a district court, issue preclusion should apply.”

Moderator David Bernstein of Debevoise & Plimpton in the U.S. noted that the consequences for a refusal to register may now be much greater because of the risk of preclusion being found. He asked whether applicants are now more likely to seek de novo review at the district court instead of taking an appeal right up to the Federal Circuit.

“Absolutely,” said Anthony Dreyer of Skadden Arps Slate Meagher & Flom in the U.S. “There are far greater consequences now. The circumstances where a likelihood of confusion determination will have a preclusive effect is rare but certainly findings about priority of use—as we have seen already being applied—and other potentially important factual issues that could be dispositive on a subsequent infringement case, now scream for de novo review if you are on the losing side.”

Peter Harvey of Harvey Sokind in the U.S. agreed but added: “My concern is that the original conception of what the TTAB its court proceedings was designed to do will morph into something much more than that. I worry that we will see ourselves putting more resources than was even thought about in the past.”

Harvey noted that there was not much guidance in terms of cases yet. He gave a presentation revealing that seven district court trademark cases have cited B&B.

Bernstein said one of the great benefits of litigating at the TTAB is it is much more limited, with little discovery and no actual trial in many cases.

The TTAB itself may also have to adjust. Gerard Rogers, its chief judge, said the B&B ruling was positive for the Board. “It is not true that judges ran around high fiving each other, but that’s mostly because they work at home so I had no one to high five,” he joked.

He said the TTAB is not planning any changes as a result of B&B, including to its recently-published proposed rule changes.

The Supreme Court recognized that preclusion will be very rare in confusion cases, but it is more likely in other issues such as priority, fraud, genericness and functionality. “There’s no doubt that, at minimum, B&B changes the calculus for those involved in Board proceedings,” said Rogers.

He added, however, that increasing the discovery taken was not necessary or useful, and neither was having more evidence on us: “So there is little reason to change the trial strategy.”

Anna Carboni of Redd Solicitors in the U.K. gave an overview of similar case law in Europe. Her conclusions were that: oppositions proceedings are not binding but they may influence a later tribunal, so practitioners should be careful not to contradict themselves; invalidity proceedings may be binding, even where you don’t expect it, so think carefully about the possibility of a later attack on use; and IPO proceedings remain much more streamlined and cheaper than court proceedings, but don’t be too reluctant to treat them like litigation in an appropriate case.
<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Location</th>
</tr>
</thead>
<tbody>
<tr>
<td>7:30 am - 2:00 pm</td>
<td>Networking Excursion Desk</td>
<td>West D E Lobby</td>
</tr>
<tr>
<td>7:30 am - 2:00 pm</td>
<td>Information Desk</td>
<td>West D Lobby</td>
</tr>
<tr>
<td>7:30 am - 2:00 pm</td>
<td>Housing Desk</td>
<td>West Hall E Lobby</td>
</tr>
<tr>
<td>7:30 am - 2:00 pm</td>
<td>Exhibitor/Press Registration Desk</td>
<td>West D Lobby</td>
</tr>
<tr>
<td>7:30 am - 2:00 pm</td>
<td>Registration</td>
<td>West Hall E</td>
</tr>
<tr>
<td>7:30 am - 4:00 pm</td>
<td>Hospitality</td>
<td>West Hall D</td>
</tr>
<tr>
<td>8:00 am - 10:00 am</td>
<td>BREAKFAST TABLE TOPICS</td>
<td>W240</td>
</tr>
<tr>
<td>8:00 am - 10:00 am</td>
<td>Continental Breakfast</td>
<td>West Hall D</td>
</tr>
<tr>
<td>10:00 am - 2:00 pm</td>
<td>Exhibition Hall</td>
<td>West Hall D</td>
</tr>
</tbody>
</table>

CONCURRENT SESSIONS

<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Location</th>
</tr>
</thead>
<tbody>
<tr>
<td>10:15 am - 11:30 am</td>
<td>CW01 Annual Review of U.S. Federal Case Law and TTAB Developments (Advanced Level)</td>
<td>Chapin Theater</td>
</tr>
<tr>
<td>10:15 am - 11:30 am</td>
<td>RW01 Regional Update: ASEAN—So You Think You Are Famous! (Intermediate Level)</td>
<td>Tangerine Ballroom West Hall F - 1</td>
</tr>
<tr>
<td>11:15 am - 12:00 pm</td>
<td>CW21 Are you Getting Down and Dirty in a Correct Way? Protection of Immoral, Vulgar, Scandalous or Simply Culturally Sensitive Trademarks (Advanced Level)</td>
<td>Tangerine Ballroom West Hall F - 1</td>
</tr>
<tr>
<td>11:15 am - 12:00 pm</td>
<td>CW20 Remedies are Available to Trademark Owners After eBay and the 1999 Amendments to the Lanham Act (Intermediate or Advanced)</td>
<td>Chapin Theater</td>
</tr>
<tr>
<td>11:45 am - 1:00 pm</td>
<td>CW22 The Role of Trademarks in the Infrastructure of E-Commerce (Advanced Level)</td>
<td>Tangerine Ballroom West Hall F - 1</td>
</tr>
<tr>
<td>11:45 am - 1:00 pm</td>
<td>CW23 Annual Review of U.S. Federal Case Law and TTAB Developments (Advanced Level)</td>
<td>Chapin Theater</td>
</tr>
<tr>
<td>12:00 pm - 1:00 pm</td>
<td>SPEED NETWORKING</td>
<td>West Hall D</td>
</tr>
</tbody>
</table>

LUNCHEON TABLE TOPICS

<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Location</th>
</tr>
</thead>
<tbody>
<tr>
<td>1:15 pm - 3:15 pm</td>
<td>LUNCHEON TABLE TOPICS</td>
<td>W240</td>
</tr>
<tr>
<td>6:00 pm - 11:30 pm</td>
<td>Grand Finale</td>
<td>Universal Studios Orlando</td>
</tr>
</tbody>
</table>

Special Offer for INTA Members:

- 2016 Annual Meeting attendees can pre-register for Barcelona till 2pm today and:
  - Save 10% on registration
  - Get early access to the hotel booking system in January 2017

Visit Onsite Registration to take advantage of this offer.

Since 1976, BSKB has been providing a full range of intellectual property law services to clients in the areas of trademark and patent prosecution, post-grant review, litigation, ITC litigation, opinions and counseling, design patents and licensing.

bskb.com  •  Metropolitan, D.C.  •  703.205.8000