

In their own words

Trademark-related quotes, opinions and observations from around the globe

“Since the *Philips/Nokia* ruling (C-446 and 495/09) in 2011, under EU law European Customs can check counterfeit goods transiting through the EU but can only stop them if there is a risk of these goods entering into the Single Market. This means in practice that customs are powerless against counterfeit goods on route to a third country, and must let them go, at the risk of these goods being illegally diverted back into the EU. The new provisions adopted today will allow Customs to stop trademark counterfeit goods even if destined to a country outside the EU, and will not affect the trade of legitimate goods under the EU’s WTO international obligations. Likewise, these provisions ensure that genuine generic medicines will reach their final destination. With this vote, the European Parliament signals that it is serious about stopping trademark counterfeits to protect consumers everywhere and that the EU should show leadership in the global fight against counterfeiting.”

Business community groups – including the Anti-Counterfeiting Group, Business Action to Stop Counterfeiting and Piracy, the International Trademark Association (INTA) and MARQUES – welcome the European Parliament’s adoption of amendments to the proposed Community Trademark Regulation and recast of the Trademarks Directive (February 25 2014)

“I have no problem with wanting to protect a name, a logo and athletic teams, and those things can be monetised through licensing. But names of programmes, research initiatives, names of entire schools; these are things that don’t readily lend themselves to licensing opportunities and I see it as a waste and a misguided foray. All it does is clutter the market for potentially non-confusing use of those terms and phrases by others. Universities should not be in competition with actors in the commercial market.”

Jacob Rooksby, assistant professor of law at Duquesne University’s School of Law, hits out at universities that “go too far” in their trademark activities in a bid to create licensing revenue (February 28 2014)

“We are not sure that all the MEPs involved in this dossier [the European trademark reforms] will be re-elected and I find it somehow shameful that, in many cases, the politicians we send to parliament are not the most brilliant politicians we have at national level. We often see politicians who are at the end of their career and want to be rewarded, or are sports and television personalities. Are these the people we want making important decisions? I am not so sure.”

Etienne Sanz de Acedo, chief executive officer of INTA, tells the audience at the USF School of Law McCarthy Institute and Microsoft Corporation Symposium of his frustration at Europe’s legislative system (March 13 2014)

“Approving ‘.sucks’, a gTLD with little or no public interest will have the effect of undermining the credibility ICANN has slowly been building with skeptical stakeholders... I view it as little more than a predatory shakedown scheme. The business model behind this gTLD seems to be: force large corporations, small businesses, non-profits and even individuals to pay ongoing fees to prevent seeing the phrase ‘sucks’ appended to their names on the Internet... [One applicant] has started soliciting defensive registrations before it has even secured the rights to operate the ‘sucks’ gTLD. According to its website, the company is accepting payments of \$2,500 for trademark reservation, which will rise to \$25,000 during a 30-day sunrise period and remain at that level annually for trademark owners.”

US Senator John D Rockefeller writes to the Internet Corporation for Assigned Names and Numbers (ICANN) to express displeasure at the plans for a ‘.sucks’ generic top-level domain (gTLD), with particular ire directed at one applicant’s plans to charge trademark owners \$25,000 in sunrise fees (March 12 2014)

“ICANN has to approve sunrise plans and it’s very important to watch this – should ICANN say that this is fine, it will undermine all of the rights protection mechanisms that have been developed.”

Kristina Rosette, of counsel at Covington & Burling, urges ICANN to clamp down on excessive sunrise fees (March 13 2014)

“We are aware of this situation and are monitoring this to see what evolves. Our party line is that we don’t get into pricing, but we do watch stuff closely and ensure that sunrises do what they are intended to do. The rights protection mechanisms are defined and our goal is to have such things well defined – but sometimes you do get to implementation and things arise.”

Krista Papac, director of registry services at ICANN, responds to questions about sunrise fees posed by the Intellectual Property Constituency during the ICANN meeting in Singapore (March 25 2014)

“Consumers need to be aware that a counterfeit sports product is a sub-standard product which will most likely not last long and may even cause physical discomfort due to the non-tested materials they contain. Furthermore, consumers risk supporting criminal organisations that use the profits to invest in other crime areas such as drugs and trafficking in human beings. By purchasing fake merchandise online, consumers also run the risk of having their credit card details stolen and used for other transactions.”

Rob Wainwright, director of Europol, outlines the message that should be conveyed to consumers ahead of the 2014 World Cup. He was speaking at a conference on the issue of counterfeiting and piracy in the sports industry organised by the Office for Harmonisation in the Internal Market and Europol (March 26 2014)