

Introduction

Talking trademarks: the changing IP landscape

In partnership with INTA



Author

Trevor Little

Editor, *World Trademark Review* magazine

As he enters his final year as executive director of the International Trademark Association (INTA), *World Trademark Review* sat down with Alan Drewsen to gain his thoughts on the major developments over the past 12 months, and the future challenges for the trademark industry.

Looking back over the 2011 to 2012 period, the first major development that Drewsen identified is the expanded online space, with the Internet Corporation for Assigned Names and Numbers' (ICANN) generic top-level domain (gTLD) programme having gathered real steam. One industry concern that INTA has been addressing proactively is the trademark protection mechanisms adopted by ICANN, notes Drewsen: "Everyone knew the online expansion was coming, but there has long been a conviction that there is insufficient trademark protection. We have been deeply engaged with ICANN in a number of ways – for instance, through the Intellectual Property Constituency, which is a part of ICANN's governance that we helped to found. We also do it through our internet committee, which provides comment on ICANN proposals, and we meet independently

with both ICANN and the Government Advisory Committee to make sure our positions are known to them. Another pitch we have been making is that we want to encourage as many companies as possible to get involved. They have to be aware of the gTLD process."

Drewsen also urges involvement in wider online issues, adding: "There remains a question about who will govern the Internet. We want companies to be aware of these developments so they can weigh in individually through their government channels. It's up to INTA to play a role in these events, but we also have to educate members so they can play a role."

Public engagement

Efforts to implement increased trademark protection in the gTLD space received pushback from some quarters of the online world, a situation mirrored in wider debates on intellectual property and piracy. "Over the past year we have seen the public attention given to the Stop Online Piracy Act and the Preventing Real Online Threats to Economic Creativity and Theft of Intellectual Property Acts in the United States, as well as the Anti-Counterfeiting Trade Agreement (ACTA) in Europe. It is a bit of a new phenomenon and a lot of the opposition was based on some

misperceptions about the respective legislations, whether deliberately put out there or not, and how it would impact on people's internet experience. INTA – particularly with ACTA – has done what it can to clarify the situation, but there is still a lot of misplaced opposition,” says Drewsen.

INTA has been a firm supporter of ACTA, with Drewsen observing earlier this year: “The benefits of ACTA are enormous. ACTA will protect European creators and innovators, generate and preserve jobs, stimulate economic competitiveness and growth, and foster international trade.”

Public outreach about the benefits of trademark protection and the way it interacts with other rights is a central challenge for the organisation in today's online world, where protest – whether informed or misguided – can quickly spread: “As people have started using the Internet more, they are engaging with intellectual property in a way that they never have before. So they are learning what it really means and we have an educational job to do there. There are those who don't believe in IP as a concept – not many, but some. And we can't necessarily change those opinions, but the more you can show people the true benefit of IP economically and can explain the integrity of IP, and as users develop their own IP and want to protect it, you will see change. There is a balance to be struck – there really is no reason why IP and trademark rights, for example, can't happily co-exist with a free and flexible Internet.”

Getting real

One method used to engage the public on IP issues is INTA's Unreal campaign, which aims to educate teens about the value of trademarks and the negative effects of counterfeiting (for details visit www.facebook.com/unrealcampaign). The integrated awareness campaign follows a collaboration with AMP Agency, which specialises in marketing to teens, to understand the thinking of the target age group, and draws on a series of focus groups which took place in New York and Boston. Drewsen explains: “We learned that teenagers don't know a lot about counterfeiting, but also that they are fairly socially conscious, and once they understand

the implications of counterfeiting, they feel less inclined to buy fake goods.”

The Unreal campaign utilises social media, traditional media and special events to raise awareness on the issue. It will initially focus on teens in the United States, with the goal of expanding to other countries and regions in the future. In addition to reaching out to teens online, INTA and member volunteers will visit high-school classrooms across the country to present information on trademarks and counterfeiting.

Other elements of the campaign include video public service announcements of teens sharing real-life examples of how buying counterfeit goods affected them, development of educational materials and visits to shopping malls to inform consumers about the potential harms of buying fake goods.

“Teens' purchasing power will only increase over time, and they will soon be the next generation of consumers. With that in mind, we see a tremendous opportunity for INTA to arm teens with as much information about the economic, social and health risks involved with counterfeiting as possible,” explains Drewsen. “It is our hope that this information will influence their decision the next time they are approached by a site or vendor selling counterfeit goods.”

Importantly, the campaign will encourage the target audience to spread the word about the dangers of counterfeiting, with peer-to-peer communication being key: “We found that teens found celebrity endorsements to be somewhat phony, as they know they can afford to buy what they want – they are actually more influenced by their parents than celebrities. But clearly, the most effective communication was peer to peer and we plan to communicate peer-led stories to show the harm counterfeiting can do.”

Tackling the bullies

Another emotive issue that has attracted attention over the past year is trademark bullying: INTA was one of the IP associations which met with the US Patent and Trademark Office (USPTO) to discuss legal education programmes on trademark policing.

The meeting followed an earlier USPTO study into trademark litigation tactics, which

made a number of recommendations, including education programmes and getting the private sector to provide free or low-cost legal advice to small businesses via *pro bono* programmes and IP rights clinics.

Again, promoting a full understanding of the issue is seen as key: “The trademark bullying issue has continued to get publicity and, once again, this is often based on a misunderstanding of what is actually involved in the enforcement of IP rights. There is no question that, from time to time, a big brand owner will perhaps overreach in its enforcement efforts, but it is not a trend by any means. In fact, there are many occasions when it is a small enterprise – or the infringer – which is using the system to its advantage. Misuse of process does run both ways.”

Towards harmonisation

In addition to addressing these overarching issues, INTA has continued to work with other organisations on trademark issues and to keep a close eye on global developments towards harmonisation. Drewsen notes: “We were very encouraged to see Mexico, Colombia and the Philippines joining the Madrid Protocol, as this provides a great opportunity for continuing harmonisation. In addition, the fact that the Korean Intellectual Property Office and the State Intellectual Property Office of the People’s Republic of China joined the Office for Harmonisation in the Internal Market, the USPTO and the Japan Patent Office (JPO) in an expanded trademark trilateral is very positive.

“The information sharing and benchmarking that those five offices will now engage in will be very helpful. In the meantime, INTA will continue to promote its model trademark laws and examination guidelines to government and will continue to contribute to both trademark law and practice. It is a continuing effort – it’s our overarching policy in some respects, as we want to make sure that our members can go into a market with their product with as much confidence as possible over the integrity of the IP system, in terms of both protection and filing.”

Efforts to increase harmonisation and cooperation also resulted in INTA signing a memorandum of cooperation with the General Administration of China Customs (GACC),

which marked the second major milestone for INTA’s government relations efforts in China, following a 2010 agreement with the State Administration of Industry and Commerce.

The document reaffirms the information-sharing and cooperative efforts between INTA and GACC to protect against trademark infringement activity as goods cross China’s international borders. Under the agreement, INTA will assist GACC by educating customs officials and communicating the latest GACC policy and procedure to INTA members. Drewsen comments: “These are very valuable agreements for us. They really mean that the organisations will continue to cooperate, even when there are leadership changes. They represent a strong commitment from both organisations to continue working together.”

He adds that Asia represents a key focus for the association: “We have developed significant contacts with the JPO, and have also met with China’s trademark-led delegation. So we have made a great deal of progress in terms of our activities and presence in Asia – and increased our membership in the region. In addition, everyone is looking forward to the 2014 INTA Annual Meeting, which will be held in Hong Kong. Our Asian membership base is very excited and we are already receiving a lot of support from government and other stakeholders.”

Expanding horizons

Asia is currently the association’s fastest-growing membership segment – more than 1,000 members as of June 2012 – but is not its sole focus, says Drewsen: “As an organisation, we are continuing expansion outside the United States and western Europe. Asia will be a significant focus of our efforts, but we have also done little in Africa over the years – it’s a region that has some good intellectual property protections and some which are not so good, and a major challenge with developing areas and countries is to persuade them - when their resources are stretched so thin and there are so many human needs - that it is also important in the long run to protect intellectual property. But it will allow them to protect local intellectual property and also develop an environment that is attractive for international IP owners to come in and invest. We need to

convey that message – but recognise that it is more difficult in developing countries.”

In the meantime, organic growth is occurring in the membership base, with the association going from strength to strength internationally. Drewsen concludes: “I think our corporate members are opening up new markets all the time. No matter what we say about harmonisation, IP law remains geographically based and as companies move into new jurisdictions, and have to maintain counsel there, this naturally generates interest in both INTA and the annual meeting. With the latter, a lot of people want to come and learn, and it also gives brand owners an opportunity to meet their international counsel and to see what the year ahead may hold for them. Our leadership is driving this effort, but each annual meeting generates positive word of mouth. People will say, ‘I went to this conference and learned some things and got new ideas for my business’, and this builds. So the future for us is market expansion, as led by our corporate members.”

International Trademark Association

655 Third Avenue, 10th Floor
New York, NY 10017-5646, United States

Tel +1 212 642 1700

Fax +1 212 768 7796

Web www.inta.org



Alan C Drewsen

Executive director
adrewsen@inta.org

Executive Director Alan C Drewsen joined INTA in 1998, and has overseen the significant expansion of the association, including the establishment of offices in Brussels and Shanghai to complement the headquarters office in New York City. Mr Drewsen is an attorney admitted to practise in New York. Before joining INTA, he was in private practice, specialising in antitrust and healthcare law, and served as senior vice president and general counsel of Empire Blue Cross and Blue Shield. Mr Drewsen earned his BA degree from Denison University in 1968 and his JD degree from the Yale Law School in 1973. He served in the US Army for two years between college and law school. Mr Drewsen is a frequent speaker and commentator on legal issues involving trademarks and intellectual property, and on governance and other management issues affecting not-for-profit organisations.