

Feature

By **Adam Smith, Lise Charles**
and **Trevor Little**

A great deal more than tea at this party

WTR takes a look at the blockbuster of the trademark calendar: the annual meeting of the International Trademark Association, held this spring in Boston

Many members of the International Trademark Association (INTA) feared that they would not make it to Boston for their 132nd annual meeting, with volcanic ash clouds and airline strikes threatening the world's largest trademark gathering. But despite these challenges, over 8,000 delegates managed to convene in Boston, with many suggesting that it was the best INTA meeting yet.

One reason for this success is INTA's ever-broadening reach, as represented in the exhibition hall and convention centre corridors. Delegates had come from as far away as Ghana and Japan, and everywhere in between. If the world is shrinking, however, the online world continues to grow; it was identified at this year's meeting as one of the greatest challenges for trademarks in the 21st century. "INTA's Internet Committee has submitted detailed comments on the expansion of the generic top-level domain (gTLD) space," said Alan Drewsen, INTA's executive director, during the opening ceremony. "INTA has argued that online expansion without protections for brand owners will create many hardships."

In the same breath, Drewsen explained how INTA is planning to develop its own web presence. The INTA website has looked dowdy for some time, and has lacked functionality and interactivity. As a result, some INTA members have migrated to networking sites such as LinkedIn to host discussions which INTA should arguably have facilitated. Not before time, Drewsen announced plans to remedy this: "INTA will introduce a new website in 2011, which we will use to increase our social media presence. The site will be different from the current site in every conceivable way."

INTA's president, Heather Steinmeyer, picked up on this development as she opened the annual meeting, outlining both the risks and rewards of social media. "Social media has opened a door that allows criticism to go viral," she told delegates. "This can destroy in seconds a brand that has been built up over decades. But social media also offers new opportunities to everyone. This applies not just to those involved in reputation management, but also to those seeking to extend sales opportunities."

The online world remains one of INTA's main areas of focus, according to Steinmeyer. Others include the ongoing study into the functionality of the European trademark system and the Anti-counterfeiting Trade Agreement (ACTA), which INTA has supported since negotiations began over two years ago. "The treaty is critical to raising cooperation between participating countries," argued Steinmeyer, adding that the release of the draft agreement in April moved the process on significantly. "The draft is encouraging, but there is a long way to go in the negotiations... One concern is that the scope of ACTA goes beyond trademarks and copyright, and this would dilute its anti-piracy focus."

But to counterbalance such serious concerns, delegates made sure that they had their fair share of fun. Although the global economy is not out of the woods just yet, this year's INTA meeting suggested that trademark practice is certainly rebounding. Firm receptions and parties were in full swing and the conference had much more of a buzz than last year. Meanwhile, host city Boston was preparing for summer, with outside concerts taking place and Bostonians settling down in parks to enjoy the sunshine.

Boston seemed like the perfect venue for such an international meeting. For Americans, its relatively lengthy history makes it an exciting national destination. Meanwhile, for European visitors, the city's curving streets, Irish pubs and Italian delis strike the perfect balance between new-world modernity and old-world eccentricity. For everyone else, it is clear that Boston is one of the world's finest metropolises.

Just as it is difficult to select a handful of features that make Boston special, it is difficult to pinpoint the highlights of this year's annual meeting – but *WTR* has made an attempt. The reports below represent our pick of the meeting's sessions.

Legally responsible green and natural marketing

More and more companies are now portraying themselves and their products as socially responsible. Speaking at this session, Geri Lynn Mankoff-Elias of Perry Ellis International noted: "Everywhere you look now you can't avoid environmentally friendly claims – even the taxi to the conference hall today carried one. As competition increases, companies are finding themselves under more and more pressure to demonstrate their green credentials."

While a positive sales point, many green and natural claims also expose a company to potential liability. To explore this issue, the session took the form of an in-depth roleplay centred around a fictional individual, Ms Sustain A Bull, who had designed and advertised as environmentally friendly a golfing jacket only to receive a letter of complaint from the National Advertising Division (NAD)



Drawing on a case involving Apple (NAD 5013), he explained that use of the word ‘family’ in the claim “The world’s greenest family of notebooks” had been problematic, as it “suggested that each member of the family had to be the greenest in their product class, rather than the range as a whole being the greenest overall”. As such, the advertising claim was amended to “The world’s greenest line-up of notebooks”.

Industry breakout: fragrance and fashion

Speakers from two of the world’s biggest fragrance houses must have sent pheromones through the convention centre, as this industry breakout session was heavily subscribed. The panel outlined how fragrances trigger emotions and can therefore function as the perfect brand extension. “Fragrance should be the brand’s DNA in a bottle,” explained Laure de Metz, vice president of licensing at Marc Jacobs. De Metz detailed the commercial benefits of fragrance, in that it can bring the brand to a wider consumer base and leverage the brand globally better than any other product. Elisheva Jasie, senior counsel at Coty, went on to outline best practice rights protection strategies for perfume brand owners. “Fashion designs have very limited IP protection in the United States,” she explained, “and by that I mean none.” Fortunately, the situation is very different in the European Union, where both registered and unregistered designs are protected.

Breakout attendees heard that while trademarks are crucial for perfumes, due to the difficulties in translating smell into audiovisual advertising, the challenge lies in finding an available one. Jasie also provided an excellent analysis of trade dress protection, noting that many infringers think it satisfactory to use their own name, but rip off a famous bottle design. The Marc Jacobs fragrance Daisy was held up as a fine example of distinctive packaging. “As soon as you see the flowers on the bottle, you think, ‘Marc Jacobs,’” Jasie noted.

Transitioning from in-house to private practice and vice versa: the US perspective

Far from a mere careers clinic, the session on moving from one position to another revealed insights into peers’ professional decisions and provided a behind-the-scenes look at some of the world’s biggest brands. Laura Covington, associate general counsel at Yahoo! and co-chair of the conference, joined Yahoo! in 1999, just as the Web was opening up new areas of law. “I drove home every night for the first few months thinking, ‘I love my job!’” she said. “It felt like I was making new law.” Intellectual stimulation was cited as a key motivating factor when considering a new direction. Antonio Borelli from The Donna Karan Company agreed: “I still have days when I learn a lot. You’re definitely exposed to many more issues

about her claims. From this starting point, the panel explored the potential liability surrounding such claims and how trademark counsel and brand owners can minimize the risk. While a complaint from the NAD may not be a welcome development, Joseph Norvell of Norvell IP argued that it “is one of the best you can get, as it is from a non-binding, self-regulatory body”.

Interestingly, Norvell noted that just one word in an advert can have a significant impact on the meaning of an environmental claim.

when you're in-house because you become a full-service attorney."

On the other hand, a move outside can be just as challenging – and not simply because it signals a shift back to billable hours. "As a lawyer, you tend to be well organized anyway, so having to track time is not a big deal," said Curtis Krechevsky, who used to work in-house with Reebok and is now a partner at Cantor Colborn. "As long as you have a system, it shouldn't be a significant factor." Panellists added that smaller firms may feel like a comedown after working in-house, but argued they can offer an attorney the flexibility and client contact that every lawyer craves.

Regional update – China

Rather than delivering a dry report on developments to the Chinese trademark system (pending is down, but so are criminal prosecutions), the panel at this session opted to tell fascinating stories of trademark trials and tribulations in the world's most litigious jurisdiction for intellectual property.

"The problems that we're experiencing in China are the same as everywhere else, with one exception: I love enforcing IP rights in China," said Lucy Nichols, Nokia's director of global brand protection. "I've just completed a two-year assignment to China – I wanted to demonstrate my company's commitment to enforcing IP rights in China. Generally, my experiences have been very good."

Nichols' strategy was to engage as deeply as possible with the Chinese authorities. The key to succeeding in litigation is to choose your battles very carefully and, moreover, to be able to explain why the infringing activity damages not just your own brand but also China's economy. "When I look at a problem, I have to consider why China would want to buy into it," said Nichols. "I need to argue why finding a solution to Nokia's problem will benefit China's economy. If I can't find that, I back off."

Reiner Hansert, corporate director, intellectual property at Beiersdorf, outlined a particularly instructive case in which his company took a number of actions against a third party which had copied the get-up of Nivea's product line. The infringer had used a distinctively different word mark, but devices and fonts that were confusingly similar to Nivea's. After winning \$5,000 damages, Beiersdorf found the products on the market again and took further action, eventually winning \$24,000. "What made this case special is that the court made a breakthrough in finding trademark infringement on distinctively different words," explained Hansert. "Usually the words count for about 80% in the overall weight in a combined word and device sign."

(For more on trademarks in China, see p14.)

Domain names – how to protect your .assets

The smash hit of INTA's 132nd annual meeting, this session covered new trends in cybersquatting, the controversial proposal for new generic top-level domains (gTLDs) and practice developments around the Uniform Dispute Resolution Policy (UDRP). The panel boasted former members of the team assembled to recommend trademark protection measures for the expansion of the gTLD space, plus a representative from the Internet Corporation for Assigned Names and Numbers (ICANN), the body which bears the brunt of brand owners' fears over cybersquatting.

While Kristina Rosette from Covington & Burling predicted a review of the UDRP, ICANN's Doug Brent was quick to point out that such a review would be instigated only by the community. He added that his organization is considering whether the proposed rights protection mechanisms for new gTLDs would complement the UDRP. "You all need to think about how you would like to see the UDRP changed," Rosette told the audience. "You need not just to react, but to develop policy upfront."

Nick Wood, managing director of Com Laude and one of the most vocal commentators on domain issues, said that he expected the introduction of internationalized domain names (IDNs) to lead to a rise in cybersquatting. "The battleground will be confusingly similar interpretations," he warned, "for example, transliteration and transcription (the sound of the word). In a number of jurisdictions, the cybersquatters will jump in again." Meanwhile, Fabricio Vayra, senior counsel, intellectual property at Time Warner, revealed his



company's approach to cybersquatters. "With so many IDNs opening up, you can't defensively register everything," he said. "So we're waiting to see whether IDNs take off and then we'll act."

The bigger threat – that posed by gTLDs – led to much discussion. The fact that the room was filled to capacity, with some delegates standing at the sides, is testimony to how far this debate has come since it first touched the fringes of INTA several years ago. With most trademark counsel still vehemently opposed to ICANN's proposed expansion – but the gTLD explosion set to happen regardless – members of the panel grew animated. "ICANN is so close to securing the trademark protection mechanisms that we all need to assume this is happening," said Vayra. "It'll be a bad day for someone who assumes that it's not going to launch and it does." Rosette added that the process could still be stalled by a law suit brought by a government – or even a large brand owner.

Fraud at the USPTO: what do we do now?

The groundbreaking *Bose* decision may have changed trademark practice, but many attorneys are still working out exactly how to approach fraud in the new era. Michael Adams, an associate at

Mayer Brown, explained how, in 2003, *Medinol* set the following standard: the applicant knew or should have known that its statement was false. Therefore, the 'intent' requirement was removed. Post-*Medinol*, fraud claims increased, as did their success rate. However, in *Bose*, the Federal Circuit reversed the *Medinol* 'knew or should have known' standard. "There are now fewer risks and consequences for innocent mistakes," said Brown.

Sara Blotner, senior trademark counsel for Citigroup, and Cisco's Leslie McKnew then gave practice tips and summed up the lessons learnt from *Medinol* and *Bose*. Their main piece of advice was to continue to follow best practice. With regard to clearance and use, attorneys should always review and confirm details with clients. Blotner said that the attorney should be prepared to "scare" clients in order to "hammer home" how important this is. McKnew added that it is crucial to correct mistakes as soon as they come to light and to file applications to replace vulnerable registrations.

The USPTO's deputy director was the final member of the panel to speak. Unfortunately, she said very little, except to provide a brief overview and confirm that the office still faces significant problems due to "dead wood" on the register. [WTR](#)

INTA: Attendees' views



INTA president
Heather Steinmeyer
Lead counsel for intellectual property, WellPoint

How is the annual meeting going?

I think it has been going very well – it is noticeably busier than last year. The improving economy is definitely having an advantageous impact on this year's meeting. We're also benefiting from the weather – delegates who remember the last INTA annual meeting in Boston are especially relieved to come to

great weather this time around.

What trademark fact have you learnt this year?

INTA just signed a memorandum of understanding with China's State Administration for Industry and Commerce (SAIC) and I learnt today that it's the first agreement between the SAIC and a private group – that just shows how much trust the SAIC has in INTA and how far INTA has come.

What do you think is the hottest trademark topic at this year's meeting?

Everyone's talking about the Anti-counterfeiting Trade Agreement (ACTA). Now that the draft text has been published, people are poring over it. Here at the meeting, people are discussing it and thinking about how it will be applied in practice. It's really got a lot of people talking. Some people are discussing new generic top-level domains, of course – but not enough people are aware of the problem and fewer still are involved in the debate.

What advice would you give President-Elect Gerhard Bauer

regarding the INTA conference?
I'd tell Gerhard to block out two weeks of his schedule prior to the annual meeting – last-minute plans take up a lot of time! [WTR](#)



Trademark attorney
Brian Banner
Partner, H&A Intellectual Property Law

Why is it important for you to come to INTA?

I'm here to introduce myself and my firm, H&A IP Law. We're a new firm with a century-worth of experience. As we're a very small

organization, I like talking to people about competitive pricing.

Is the 'I' in INTA living up to its promise?

Yes. I take my hat off to the conference producers, because the programme has something for everyone and the sessions are very good.

What particular trademark facts have you learnt at this year's conference?

On Saturday I went to a session on protecting rights in China. I learnt a lot about China's efforts to stop the export of counterfeit goods. Customs authorities are checking exports now – they're putting their money where their mouths are.

For a small practitioner, does the registration fee represent good value?

It's good value because I see foreign clients that I couldn't otherwise meet – but Skype will change all that! [WTR](#)



Exhibitor
Nicolai Bezonoff
Chief operating officer, .CO

Why is it important for you to exhibit at INTA?

As we are launching the '.co' domain with a number of strong rights protection mechanisms, we are very trademark friendly. We want to be here at the world's most important trademark meeting so that trademark professionals can learn exactly how we'll ensure that their rights are protected in the '.co' space.

But won't a company's decision regarding '.co' be made by teams other than the trademark group?

Yes, but even though the trademark professionals here are not necessarily the people in the company who are making the decision, we're building their knowledge so that they can work together with their colleagues.

What particular trademark facts have you learnt at this year's conference?

I've learnt that trademarks are truly global. I was really surprised by this! Just walking around the exhibition hall, you notice that trademark practice is very international in nature – every service has to be global. **WTR**



Office for Harmonization in the Internal Market (OHIM)
Wubbo de Boer
President, OHIM

How busy have you been at OHIM's stand in the exhibition hall?

We have had more visitors than ever before – more than 1,000. When we first started coming to the INTA annual meeting 10 years ago, people asked: "What is OHIM?" That is no longer the question! Now people come with practical questions – for example, people outside the European Union ask how to file a trademark application without a representative. We don't seem to be receiving many complaints or angry people – that makes me happy!

Is the 'I' in INTA living up to its promise?

Although it is undeniably dominated by US attorneys, yes. When you walk around the meeting, you see an increasing number of people from other countries – the numbers of Latin American and Asian delegates in particular have grown over recent years. That alone is a measure of INTA's merits. There's no comparison: INTA is the most global trademark association.

What trademark fact have you learnt this year?

We're grateful to be allowed to meet with industry during INTA. This year's meeting was attended by 50 of the biggest firms. The

message that stood out for me is that we dearly need to beef up our IT systems on Madrid applications. This is not a spectacular revelation, but it was loud and clear that we have not lived up to investment obligations there. **WTR**



Investigator
Darlene Seymour
General counsel, Continental Enterprises

Why do you attend INTA?

Among other things, we specialize in investigations, so we need to keep our operations low key, but we also need to market our name to increase our client base. INTA provides the platform for us to market ourselves within the IP community and not to the entire world.

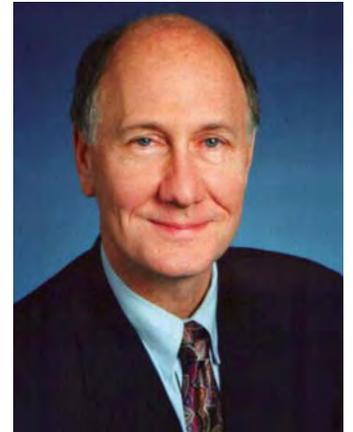
What trademark fact have you learnt?

I went to the session on trade dress and design. I didn't know how hard it was to get a design registered in Brazil; here in the United States, it's very easy. That was an interesting fact because we do a lot of work in Brazil.

Which is the best session you have attended?

The video game session was very informational. We have a lot of clients whose products show up in video games, so it was interesting to see counsel from video game companies Take-Two and Atari. Their perspective was interesting: they said that while US courts have given

broad protection under the First Amendment, there are some grey areas. The take-home point for the trademark owner on spotting unauthorized use is to reach out to the video game maker first. **WTR**



Host
Alan Drewsen
Executive director, INTA

How is the annual meeting going?

Very well. You may have heard some people say that when we were in Boston in 1988, it rained from beginning to end. This time, the weather is good: it's amazing how fine weather puts everyone in a good frame of mind. The benchmarks by which I measure our success are doing just as well: the sessions and the programme seemed to be good. And we have 100 more corporate members this year than last – so that attracts more outside counsel. It definitely seems more bustling than last year.

What's the hottest trademark topic at this year's meeting?

Probably ACTA, even though there are still a lot of square brackets in the draft text. Before it was published, there were a lot of silly rumours about what it contained. People are discussing it now that it is published, and they know to some extent what they're talking about. The publication has relieved some anxiety, but not necessarily among INTA members. **WTR**



World Intellectual Property Organization (WIPO)
Binying Wang
Director of trademarks, WIPO

Why is it important for you to come to INTA?
It's the largest gathering of people who work with

trademarks, so it's important that I bring my new team here so we can brand ourselves. The Madrid system has been building for over 100 years, but it still has a lot of potential.

How does this event fit into your overall strategy to promote Madrid?

Although we have been promoting the Madrid system, we haven't done enough to make the system known to the general public and small to medium-sized enterprises. So this is just the beginning.

What trademark fact have you learnt at the conference?

The importance of non-governmental organizations (NGOs) such as INTA. We have one day for NGOs every year, but we need to keep them involved throughout the year. [WTR](#)



US Patent and Trademark Office (USPTO)
Lynne Beresford
Commissioner of trademarks, USPTO

Why is it important for you to come to INTA?

Many people recognize that this is the place where a lot of trademark-related business can be done. You see your foreign associates, your clients – they all come to this conference. So it is a huge meeting place and an even bigger opportunity. From the USPTO's perspective, meeting with INTA's USPTO sub-committee is very important. Although we do meet throughout the year, the meeting here is the most in-depth. We usually take a couple of hours to talk about all the issues. Coming to INTA is an opportunity to talk to a lot of our customers: people come up and tell you whether you're doing a good job – or otherwise!

Why doesn't the USPTO have a dedicated stand in the exhibition hall?
We have had one in the past, but



INTELLECTUAL PROPERTY

IDENTITY & IDEAS

When the value of an identity must be protected or enhanced, many of the world's most creative thinkers trust Bereskin & Parr LLP.

As one of Canada's top-of-mind trade mark firms, we help safeguard distinctive brand names at home and around the globe.

Bereskin & Parr
INTELLECTUAL PROPERTY LAW

www.bereskinparr.com 1.888.364.7311
TORONTO MISSISSAUGA WATERLOO MONTRÉAL



decided against it this year because we're thinking that it might be more important for us to have a stand when the meeting is not held in the United States. Because there are a lot of US practitioners here, we wouldn't get a lot of questions.

Is the 'I' in INTA living up to its promise?

INTA is definitely becoming more international every year. As the meeting is in the United States, there are a lot of US practitioners, but when you go to the various committee meetings, you see all the other nationalities represented too – there's a lot of stuff going on. [WTR](#)

