



Bulletin

The Voice of the International Trademark Association

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Second Learned Professors Trademark Symposium

Washington D.C.'s National Press Club was the site of INTA's January 6, 2006, Second Learned Professors Trademark Symposium. Some forty professors and legal practitioners attended the program titled "Should PARMA be a Trademark? Issues Surrounding Geographical Marks and Indications," led by professors from Taiwan, the United Kingdom and the United States. Featuring speakers from the academic community and directed to professors and skilled practitioners, the annual program sponsored by the Academic Subcommittee is unique among INTA events.

Professor Roger Schechter of George Washington University Law School kicked off the program with "Trademark Protection for Geographic Terms—The Incoherence of the Goods/Place Association," outlining the evolution of geographic marks protection in the United States. In particular, he critiqued the goods/place rationale used in many U.S. cases addressing the registration of geographic terms.

That discussion was followed by "Geographical Signs in Europe and the U.K.," presented by Professor Lionel Bently of the University of Cambridge. After surveying the variety of geo-

graphical indication protection available in Europe, Professor Bently raised the interesting question of how many protections could and should be allowed to accumulate in order to protect one's rights in a geographic term.

Finally, Professor Min-Chiuan Wang of the Institute of Technology Law, National Chiao-Tung University, Taiwan, presented his paper. "The Asian Consciousness and Interests in Geographical Indications" discussed how China and Japan have tried to integrate the concept of geographical indications into their intellectual property legal system.

Professor Glynn Lumley of Tulane University School of Law moderated a lively discussion that was fueled by numerous questions from the attendees. The evening concluded with a well-attended networking reception. INTA thanks event sponsors Smart & Biggar Fetherstonhaugh; Birch Stewart Kolasch & Birch LLP and DLA Piper, Rudnick Gray Cary LLP.

Papers presented at the symposium will be published in a forthcoming edition of *The Trademark Reporter*®.

By Allyn Taylor, DLA Piper Rudnick Gray Cary US LLP, East Palo Alto, California, USA

Caribbean Trademark Law Update



The Caribbean is home to 18 British Commonwealth countries and territories. The countries are independent; the territories are UK dependencies. Countries: Antigua & Barbuda, Bahamas, Barbados, Belize, Dominica, Grenada, Jamaica, St. Kitts & Nevis, St. Lucia, St. Vincent & the Grenadines, and Trinidad & Tobago. Dependent Territories: Anguilla, British Virgin Islands, Cayman Islands, Montserrat, and Turks & Caicos Islands.

The other principal Caribbean countries and territories are: Aruba, Cuba, Dominican Republic, Haiti, Guadeloupe and Martinique (both part of France), the Netherlands Antilles, and Puerto Rico (part of the United States).

The Caribbean is home to some 25 trademark jurisdictions, each pursuing a unique path to trademark protection. Simply put, the laws of no two Caribbean jurisdictions are alike. This article focuses on the Caribbean's 18 Commonwealth jurisdictions.

Shedding of UK Dependence

Independence from the UK has swept through Caribbean jurisdictions, and reliance upon UK registrations has largely become a thing of the past. Today, Grenada remains the sole Caribbean holdout where a UK registration is an absolute prerequisite to registration.

Anguilla, Montserrat, St. Kitts & Nevis, St. Vincent and Turks & Caicos all have recently enacted major trademark reform. Tiny Montserrat—already reduced to one-third of its former size because of volcanic encroachment—has established its own local trademark system while still granting a special line of access to owners of UK-registered marks. St. Vincent abandoned its longtime dependence on the UK system in its new trademarks act, effective May 18, 2004, that sets up an altogether local trademark regime. Dominica, too, is about to enact a new system, replacing its act that dates from nearly 50 years ago.

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Association News

Design Rights Subcommittee: Bridging the Gap Between Two Forms of Intellectual Property Protection

At first glance, it seems unusual for a trademark association to have a subcommittee focusing on design rights. Formed in 2003, the Design Rights Subcommittee of the Emerging Issues Committee identifies the characteristics of new laws protecting designs and considers whether those laws enhance or conflict with the goals of trademark protection.

Today's branding strategies in international commerce show that there is an increasing need to protect designs. "Brand owners are increasingly using nontraditional indicia, such as product or packaging shapes, graphic designs, etc., as trademarks," explains Subcommittee Chair Peter Taylor of Clifford Chance in London.

Trademark law does not always ensure sufficient protection of those branding ideas. "It had been hoped that changes made over the past decade or so to the trademark laws of many countries and regions would make it much easier than had been the case historically to register product shapes and packaging and other less traditional signs as trademarks," he observed. "Recently this has not always proved to be the case, even where the applicant is able to show that the mark in question has achieved a high level of recognition amongst relevant consumers."

But design law may provide an alternative for brand owners who seek to protect their product or packaging shapes. "The design laws in many countries have also recently been changed, as a result of

which a greater range of designs can now be registered," says Mr. Taylor. It therefore may be possible to obtain registered design protection even if trademark protection is unavailable.

Working with product designs involved a "steep learning curve" for many of the subcommittee members, according to Mr. Taylor, because most of the members had much greater knowledge and experience with trademarks. The subcommittee's first task was also challenging: preparing a report on registered design laws of some twelve countries and regions when only seven of those areas were represented on the subcommittee.

A new project will report on the extent to which design laws enhance or conflict with trademark laws and whether harmonizing national design laws would be desirable or practical.

By Anja Franke, Grünecker, Kinkeldey, Stockmair & Schwanhäusser, Munich



Peter Taylor, Clifford Chance, London

INTA China Office Relocation

INTA's China office has moved to a new location. The contact information is:

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Anticounterfeiting Discussions with China President Hu Jintao

At the November 2005 Royal Gala State Visit hosted by the King of Spain, INTA Past President Frederick Mostert had the pleasure of meeting with President Hu Jintao of China. President Hu and Mr. Mostert discussed current educational initiatives regarding the anticounterfeiting cause and agreed that these initiatives would help increase awareness of the problem.



2005 Task Force on Confronting Anti-Intellectual Property Views

The 2005 Presidential Task Force on Confronting Anti-Intellectual Property (Anti-IP) Views presented its conclusions to the Board of Directors during the November 2005 Leadership Meeting in Naples, Florida, USA. The Board referred the task force's report and recommendations to the Emerging Issues Committee for further consideration and development.

The group's goal was to evaluate anti-IP sentiment and recommend how INTA can best avoid, deflect or reduce such sentiment, particularly as it is directed to trademark owners and the protection and enforcement of trademark rights. Members of the task force were:

Sally Abel, *Fenwick & West LLP*, Chair
Miles Alexander, *Kilpatrick Stockton LLP*
Shlomo Cohen, *Dr. Shlomo Cohen & Co.*
Denis Daniel, *Daniel Advogados*
Sarah Deutsch, *Verizon Communications*
Marie Driscoll, *Fross Zelnick Lehrman & Zissu, P.C.*
Charles Gielen, *NautaDutilh*
Rose Hagan, *Google*
Jennifer O'Malley, *McDonald's Corporation*
Jeannie Smith, *Baker & McKenzie*
Mei-lan Stark, *The Walt Disney Company*
Verena von Bomhard, *Lovells*

The task force recognized that with today's heightened awareness of IP has come anti-IP backlash to a degree that varies around the world. The backlash was found to be primarily fueled by developments outside of trademark law, such as enforcement of copyrights against online music file sharing, the proliferation of suits involving Internet providers and users, a series of extensions to the term of copyright protection, patents on business methods and anti-AIDS drugs, and database laws. While recognizing that the origins of anti-IP sentiment are varied and complex, the task force identified specific risks that IP backlash poses to the trademark community, such as making it more difficult to pass critical legislation and potentially causing judicial hostility to traditional trademark claims.

In light of the concerns created by anti-IP sentiment, the task force made specific recommendations on setting policy, pursuing outreach and educating relevant audiences.

Policy

Task force members assessed existing INTA structure, process and goals—such as the committee framework, the policy-setting process from committees through the Executive Committee to the Board, and the Strategic Plan—to determine that no structural or policy changes were necessary to respond to anti-IP sentiment. However, task force members recommended that the Board continue to be mindful of the existence of and potential for anti-IP backlash as a response to Association activities, policies and positions. In addition, the task force recommended that INTA continue to ensure diversity and strong representation of regular members when populating policy committees.

Outreach

The task force recommended that INTA engage in a dialogue with consumer and public interest groups that have raised concerns

about the overextension of IP laws and have taken positions adverse to IP organizations in various policy debates. To reach out to those groups, the task force suggested inviting a prominent consumer rights advocate to be a keynote speaker at an upcoming Annual or Leadership Meeting. The task force also deemed it crucial to reach out to WIPO and other IP organizations. It will be important for the Association to discuss anti-IP bias with other organizations and to explore whether joint activity is possible or desirable.

Other outreach recommendations include the publication of a special issue of *The Trademark Reporter* on anti-IP backlash, the development and maintenance of a list of speakers willing to address non-INTA, non-IP groups on the issue and, finally, the appointment of public relations staff to coordinate INTA's response, if any, to IP backlash issues.

Education

The task force considered education to be key to combating anti-IP sentiment, since the problem stems largely from misunderstandings and faulty information. The exact form and nature of educational programming would need to be tailored to different audiences and regions. The task force recommended focusing on IP rights owners, the public, the media, courts, patent and trademark offices (PTOs) and university faculty and students in relevant fields of study including law and business.

The recommendation to educate IP owners stems from the belief that brand owners and their legal representatives are responsible for policing and enforcing brands in a manner that avoids the potentially far-reaching implications that IP backlash can have on the trademark community.

The task force also believed that INTA could play an instrumental role in educating the general public about the inherent value and societal benefits of IP rights. Educational events should focus on the role trademarks play in aiding consumer choice, in developing the economy and in promoting health and safety.

Mindful that the public receives most of its understanding of IP from the media, the task force suggested that INTA promote better understanding of trademarks and the benefits of trademark protection in the media. Such increased understanding would help generate press reports that are more balanced.

Recognizing that judges' lack of experience with IP cases could negatively affect the decision-making process, the task force recommended that INTA consider hosting seminars or conferences for judges from around the world. INTA could also sponsor opportunities for judges to visit other jurisdictions with different experiences in IP cases. Such initiatives would enhance individual judges' knowledge and allow judges from different jurisdictions to exchange views.

Also, the task force advocated educating patent and trademark office examiners and government entities that make the rules for PTOs. The task force suggested educating PTOs about best practices in examination, the impact of issuing overly broad rights and the importance of having robust examination guidelines. Such focus would help ensure a consistent quality of rights being granted.

By Sally Abel, Fenwick & West LLP, Mountain View, California, USA

Association News

Class Headings as Identifications of Goods and Services—A Global Analysis

Using International Class headings to identify goods and services may make it easier to file a trademark application. But not all countries accept goods and services designations that use class headings.

The Trademark Office Practices Committee's Classification Subcommittee recently investigated which countries permit goods and services to be identified using class headings, posing these questions to trademark professionals throughout the world:

- Are class headings acceptable as identifications for goods or services for new applications in your country?
- If so, what will resulting registrations cover?
- Can a registration be maintained, either by renewal or by defending against opposition or cancellation, for goods or services covered under a class heading but not actually listed in the application?

The investigation revealed that most jurisdictions treat class headings in one of three ways.

Class Headings Not Accepted in Any Form

Colombia, Portugal, South Korea and the United States are among the minority of jurisdictions that do not permit class headings as part of an acceptable identification of goods or services. In the United States, for example, an application that provides only a class heading will be rejected for lack of definiteness. Similarly, applications that use indefinite wordings such as "electrical appliance" or "clothing" will be refused by the U.S. Patent and Trademark Office for failing to provide a definite identification. For the identification "clothing" to be accepted in the United States, it must be followed by the designation "namely" and a precise listing of the common commercial names for the goods (e.g., "clothing, namely, T-shirts, sweaters and sweatshirts").

Class Headings Accepted; Resulting Registration Covers Only Goods/Services Listed in Heading

Many countries, including China, Denmark, Hong Kong, India, Norway, Sweden and the United Kingdom, generally permit use of class headings. However, these jurisdictions do not permit broad claims for all goods or services in a class. Instead, protection is typically limited to those goods or services specifically mentioned in the class headings or those goods or services specifically designated after the class headings. For example, simply claiming the Class 9 heading might not cover computer software because the Class 9 heading does not specifically state "computer software."

In many of these jurisdictions a successful opposition requires proof of use of the specific goods or services. Use of one or only a handful of goods in a class will not necessarily support an opposition against an application for other goods in that class.

In some situations, the listing of goods or services may be narrowed to those with which the mark is actually used. Therefore, it appears prudent to use both class headings and a listing of the particular goods or services with which the mark is to be used.

Class Headings Accepted; Resulting Registration Covers All Goods/Services in Class

A few jurisdictions, such as Argentina, Cambodia and Laos, permit the use of class headings in the broadest sense—to include a claim to all goods or services in the class. In Argentina, for example, an applicant may simply quote the class for which registration is desired and insert a "T" in the appropriate box of the application. The designation "T" stands for *todos*, meaning all goods or services in the class. Alternatively, an applicant may opt to recite the complete class heading, which will likewise offer protection for all goods or service in that class. To date, Argentina's trademark office and courts have not faced the issue whether reciting a class heading protects all goods or services that could possibly fall within the class.

In Argentina, it is therefore possible for a registrant or senior applicant claiming all goods or services in a class to oppose or challenge use of a confusingly similar mark on any of the goods or services falling within the class. It is important to note, however, that the Argentina Trademark Act does require actual use of the mark in commerce in Argentina to renew a registration or to avoid a cancellation challenge. To comply with Argentina's liberal use requirements, however, the mark need not be used in connection with the designated products or services. Use in connection with goods or services not covered by the application/registration, or even trade name use, is sufficient. Thus it is impossible to cancel a mark that has been used for goods or services covered by the challenged registration even if use has been limited to goods or services from a completely unrelated class.

Conclusion

In view of different countries' treatment of applications that use class headings, it is imperative to consult local counsel about the best approach in each jurisdiction and, where practical, tailor designations on a country-by-country basis. In many jurisdictions, using both class headings and listings of specific goods or services may provide the most comprehensive protection.

By the 2004–2005 Classification Subcommittee of the Trademark Office Practices Committee

INTA thanks Lafafsi Ltd., Gold Sponsor of the December 2005 Berlin Forum on the Importance of Evidence and Other Burning Issues



Features

Communication Skills Essential for Trademark Administrators

U.S. President Ronald Reagan was known as “The Great Communicator” because of his skill in delivering messages succinctly. Today’s trademark administrators also need to be great communicators in working with their clients and marketing colleagues while meeting short-term deadlines.

“It is impossible to do your job without maintaining a good relationship with your creative people,” said Margaret Bizzari, a trademark administrator for Nautica Enterprises in New York City who works with the NAUTICA and NAUTICA JEANS brands. With a career spanning 20 years, Ms. Bizzari says, “the biggest challenge is working with business people who may have concepts that don’t always fly and then trying to explain to them why. When you are an administrator in a corporate office, it is a lot different than in a law firm. You have to have hands-on communication with the business and creative people.”

Jane Tyler is a 25-year veteran trademark administrator with Harrah’s Entertainment in Memphis, Tennessee, USA. She says that keeping abreast of what the client is doing and then balancing the creative with the legal within a short time frame is one of the biggest challenges she faces. Ms. Tyler is one of three trademark administrators in a company with more than 100,000 employees worldwide. Marks she and her colleagues administer include HARRAH’S, THE WORLD SERIES OF POKER and HOLIDAY INN.

“Communication and partnering with the client to know their drivers and structure and then organizing your time to give them attention” is the daily goal of Deborah Hampton, intellectual

property manager for Limited Brands in New York City. She and two other administrators handle the company’s 6,000-mark portfolio, which includes brands such as THE LIMITED, EXPRESS, BATH AND BODY WORKS and VICTORIA’S SECRET.

All three of these administrators agree that the Internet has changed the way they do their jobs. Chief among the changes in the past 20 years has been the introduction of electronic filing systems. For example, the U.S. Patent and Trademark Office’s (USPTO’s) e-filing system allows for filing and prosecution of trademark applications, recording of assignments and checking of trademark status, all of which can be done via computer from anywhere in the world.

“Electronic filing is the greatest thing since sliced bread,” Ms. Hampton said. “The tools and technology have made the trademark screening and clearance process so much easier and less time consuming.”

“I like electronic filing...we assigned 2,000 marks last year—all electronically,” Ms. Tyler added.

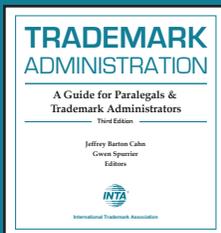
Ms. Bizzari agreed, saying that for her the USPTO’s search system has cut trademark searching and screening time in half. Also, the time it takes to file trademark maintenance documents, such as declarations of continued use and renewal applications, has been reduced considerably.

Time will tell what technology will create to challenge trademark administrators 20 years from now. One thing, however, is likely to be the same. The communication and information-processing skills that are important today will be essential for trademark administrators in the future. As Ms. Tyler notes, “People often ask me how it is that I can do the same job for 25 years. I tell them it’s not the same job as it was five or ten years ago.” And that is what she likes best about being a trademark administrator.

By Jeffrey J. Look, Look Law Firm PLLC, Eudora, Arkansas, USA

THE THIRD EDITION OF TRADEMARK ADMINISTRATION IS NOW AVAILABLE

This classic publication provides a thorough introduction to trademark practice and procedure, covering key topics including:



- Selection and Clearance
- Registration
- Maintenance
- Business Transactions
- Litigation
- International Practice
- Ethics

These are enhanced by step-by-step guidance on standard procedures, checklists to review major functions, helpful exhibits and references to other resources.

Visit www.inta.org/pubs/tma.html for more information, to preview the publication and to order.

February/March Trademark Administrators Roundtables

There’s still time to register!

Join your colleagues to discuss the advantages and disadvantages of the Community Trade Mark and Madrid Protocol registration systems at an upcoming INTA roundtable.

Topic: CTM vs. Madrid Protocol: One Year Later
February 20 – March 3, 2006 | Various U.S. cities

Held in multiple U.S. cities, these roundtables are designed to fit into your busy schedule.

Visit www.inta.org/events to register and for more information.

Features

Caribbean Trademark CONTINUED FROM PAGE 1

Jurisdictional Confusion

Confusion about jurisdiction continues to afflict many trademark proprietors, made worse by the coupling of names, as with Antigua & Barbuda, St. Kitts & Nevis (St. Kitts is more formally known as St. Christopher), St. Vincent & the Grenadines, Trinidad & Tobago, and Turks & Caicos Islands. Other jurisdictional names are sometimes confused with their constituent territories, for example, Netherlands Antilles excludes Aruba but includes Bonaire, Curacao, Saba, St. Eustatius (also known as Statia) and St. Maarten.

Dutch St. Maarten is of course to be distinguished from St. Martin—the latter is the French side of the island. Similarly, the U.S. Virgin Islands are often confused with the British Virgin Islands, which are a British Dependent Territory. Guadeloupe and Martinique, among the larger islands in the Caribbean, are co-equal departments of France, ranking with those within the bounds of France itself—and, as such, these Caribbean islands are covered by trademark registration in France, as is tiny but chic St. Barths.

Most often, the incorrect jurisdictional assumption is that a single trademark registration will cover the many countries and territories of the Commonwealth Caribbean, or that a UK registration somehow extends to most or all of the English-speaking countries. To the contrary, there are 18 different jurisdictions within the Commonwealth Caribbean, all different and independent of one another.

Another divide is the wide gulf that separates the Dutch-, English-, French- and Spanish-speaking Caribbean nations. This translates into another distinction: that between the English common law jurisdictions and the others that take after Napoleon.

Service Marks

Service marks can now be registered in nearly all 18 Commonwealth Caribbean jurisdictions. The only exception is the Bahamas, whose Trade Marks Act—dating from 1906—is the antique of the region. Service marks are not even on the legislative agenda, despite the jurisdiction's exceptionally heavy reliance on service industries, both finance and tourism.

Six other Caribbean jurisdictions still allow for registration of a service mark only if the mark has already been registered in the UK: Antigua & Barbuda, British Virgin Islands, Cayman Islands, Dominica, Grenada and Guyana. The Cayman Islands also allows a European Community trade mark to ground a local service mark application.

Official Filing Fees

As one might expect, the Caribbean's many jurisdictions have a wide range of filing fees. Topping the list is St. Kitts & Nevis, which has fees of \$385 for one mark in one class. Each additional class, however, will cost only \$30. Add another mark, and the cost of the extra mark filed simultaneously dips to \$237. Renewal, too, is costly in St. Kitts, where the \$237 per class renewal fee jumps to \$385 three months after expiration.

Also expensive is Bermuda, where the registration fee is \$360—for each and every class. Ouch, again, when it comes to renewal—that costs \$315 per class.

On the opposite end of the spectrum are Grenada and Guyana,

where fees barely exceed \$10 per application. Some jurisdictions still maintain a distinction between local and UK-based trademark applications. Anguilla and Turks & Caicos charge less for UK-based applications; Dominica charges more.

Belize levies high publication costs. Registration and renewal each cost \$125 for publication. Furthermore, each separate transaction incurs a publication fee of \$50. For example, recording a change of name *and* address requires publication fees of \$50 times two, even when the applications are bundled. Barbados also can be expensive when it comes to publication, with design marks costing some \$225 for publication alone—more than double the \$105 application fee.

Late filing of renewals incurs an extra fee everywhere. St. Vincent's new act provides for escalation of \$25 for each month of the 12-month grace period. "Renewal fee" has an altogether different meaning in the Cayman Islands, where every trademark owner must pay an annual maintenance fee of \$61 for each registration.

Oppositions

UK norms characterize opposition practice throughout the Commonwealth Caribbean, with the only real variant being the length of the opposition period. Seven jurisdictions allow three months, but five jurisdictions allow only one month to file an opposition notice: Anguilla, the Bahamas, Guyana, Jamaica and Turks & Caicos Islands. Transmission of trademark office gazettes from distant jurisdictions can easily take weeks, and, most importantly, an extension of time for filing an opposition cannot be obtained.

Registry Practices

The relaxed Caribbean-island lifestyle is sometimes presumed to infuse Caribbean business practices, but the great majority of jurisdictions have long demonstrated efficiency in trademark processing, especially Anguilla, Belize and the Cayman Islands—and also tiny Montserrat, which continues to cope with the scourge of volcano Soufriere.

On the other hand, there are several countries where delay has become agonizing, chiefly Antigua, the Bahamas and Guyana. In the Bahamas, the December 8, 2005, Gazette published marks applied for in April 2002. That constitutes delay of three years and eight months. In the Bahamas, too, post-publication action can be painfully slow. The delay in publication also impacts trademark searching, rendering searches inherently out of date.

Other practices that could be improved upon include:

- The Bahamas require a separate signed authorization form for each and every class.
- In St. Lucia, a proprietor who enters its address after its name at the top, rather than the bottom, of the power of attorney form meets with automatic rejection. The form also requires the company's seal or stamp to be applied; otherwise, the form must be notarized.
- The Dominica Trade Marks Registry rejects certified copies of UK Certificates of Registration that have been issued by the UK Patent Office with a stamped seal (which is fully consistent with UK law) instead of a raised seal.

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- St. Vincent & the Grenadines requires two separate signed authorization forms, both bearing the seal or stamp of the company and full notarization of both forms. This keeps notaries busy—too busy, some owners complain.
- St. Vincent & the Grenadines also does not issue a filing number or filing date until after examination of the application and approval on seven preliminary points—which can result in delays between the time of lodging and the time of official logging in of applications.

Trinidad & Tobago is quite critical in examining applications, and for several years objections have been almost the rule rather than the exception. Just recently a mark registered in many jurisdictions, including Australia, Canada, Jamaica, New Zealand, the United Kingdom and the United States, was refused in Trinidad as lacking distinction.

WIPO continues to conduct training for Caribbean trademark officials; this past December, there was a week-long session in St. Lucia attended by officials from Barbados, Belize, Guyana, Jamaica, St. Kitts & Nevis, Surinam and Trinidad & Tobago.

Reclassification

The 1938 British classification system still operates in five Caribbean jurisdictions: Antigua & Barbuda, the Bahamas, British Virgin Islands, Dominica and Montserrat. Even with enactment of many new trademark acts, the old British classification system remains a holdover in some jurisdictions that have abandoned it but now are being confronted with applications to reclassify registered goods into their corresponding International Classes.

Continued use of the old British classification system means two things: no service marks and antiquated categorization. Nearly 70 years old, the 1938 classification was designed more with component materials than actual goods in mind. There are, for example, 13 different classes that cover goods made of cotton, linen, wool, silk and hemp.

Applications that require the British system to be applied to goods that have already had International Classes assigned can sometimes result in messy-looking match-ups. Often the application must cover more classes or must resort to the old system's catchalls—which sometimes catch more than is comfortable.

The 1938 classification system also speaks of "carriages," which covers cars, trucks and planes, and "horological instruments," which means watches and clocks. Finally, there is old British Class 50, which covers "Miscellaneous," but also specifically covers tobacco pipes, walking sticks, plate powder, buttons, hose and other odd items—all in 10 separate sub-classes that end with the catchall "other goods."

The eighth edition of the Nice International Classification Convention governs 13 Commonwealth Caribbean jurisdictions. Trinidad & Tobago and Turks & Caicos still rely on the seventh edition.

Counterfeit Goods

Corrective action against counterfeit LEVI'S, TOMMY HILF and DOCKERS goods was taken recently in Belize. In each of these cases the U.S. Embassy became directly involved in the seizures. To invoke such action, however, it was necessary for

company officials to personally confirm that the suspect goods were counterfeit.

Caribbean Single Market and Caribbean Court of Justice

The Caribbean Single Market and Economy (CSME) treaty went into effect January 1, 2006, with Barbados, Belize, Guyana, Jamaica, Surinam and Trinidad & Tobago as the first full members. Montserrat has applied for associate status. The Bahamas will not join because of a provision that allows free movement of workers among signatory nations. Other nations in the 15-member Caribbean Community are moving or at least debating whether to join.

The first sitting of the Caribbean Court of Justice (CCJ) took place at its headquarters in Trinidad & Tobago on August 8, 2005, with the former chief justice of Trinidad & Tobago sworn in as the court's first president. The court is designed to replace the UK Privy Council as the final appellate body for the Commonwealth Caribbean. Sitting in London, the Privy Council had decided Caribbean appeals since 1833. However, only two countries—Barbados and Guyana—have agreed thus far to use the CCJ as their court of last resort in all civil and criminal matters. Other countries have agreed to jurisdiction over trade disputes arising out of the Caribbean Community and Common Market (CARICOM) treaty.

By George C. J. Moore, Caribbean Trademark Services, West Palm Beach, Florida, USA



For more information on trademarks in the Caribbean or other jurisdictions, visit *Country Guides* on the Members Only Site. *Country Guides* is a searchable database of basic, practical information on trademark filing, prosecution, registrations, maintenance and enforcement. Visit www.inta.org today!

Your chance to help lead INTA's 2007 Annual Meeting has arrived!

Moderators are needed to facilitate Table Topic sessions at the 2007 Annual Meeting in Chicago, Illinois. Table Topics are being developed now, and we need volunteers to lead these interactive, casual events.

To sign up as a moderator, email Table Topic team leader Bernard Malone at Bernard.Malone@bakernet.com.ar by **March 3, 2006**.

Include the following in your email:

- A short biography, including areas of significant legal experience
- The topic that interests you most
- Whether you would be able to facilitate a Table Topic in a language other than English

Don't let this great opportunity pass you by!

We have a limited number of topics, so volunteers will be assigned to topics depending on their interest and experience.

CHINA

Beijing Landlord of Fake Brands Retailers Found Jointly Liable

At the end of 2005, the Beijing Second Intermediate Court delivered its decision in the first civil action in China to find a landlord company jointly liable for tenants' trademark infringement.

Xiushujie (Mandarin for "Silk Street") in Beijing was notorious for its sale of fake luxury goods. There was little effective enforcement against individual vendors, who were mostly transient street traders. Last year, the vendors moved into a new building, the "New Silk Market." This created an opportunity for international brand owners to bring trademark infringement proceedings against the company that manages and operates the building that houses the market.

In May 2005, the Quality Brands Protection Committee (QBPC) of the China Association of Enterprises with Foreign Investment, on behalf of Louis Vuitton, Gucci, Chanel, Prada and Burberry, notified landlord Beijing Xiushui Haosen Clothing Co. Ltd. of the sale of counterfeits in the market. The QBPC found that counterfeits were still on sale in June and July. The QBPC then filed a lawsuit at the Beijing Second Intermediate Court, claiming damages of around US\$300,000. The defendant argued that it had posted notices at the premises prohibiting the sale of counterfeits and, upon receipt of the complaint, it had stopped leasing booths to vendors QBPC found to be selling fake products.

The court found that the defendant failed to take effective measures to stop the ongoing sale of unauthorized products after the trademark owners notified it, and thus facilitated infringement. The court held that the defendant should be jointly and severally liable for the conduct of the vendors. The five plaintiff companies were each awarded damages of approximately US\$2,500.

The China Trademark Law does not have an express provision on a landlord's liability for contributory infringement. However, Article 50 of the Implementing Rules of Trademark Law states that the "provision of storage, transportation, postage, concealment and convenience to facilitate infringement of exclusive rights to use a registered trademark" constitutes an infringement. This case illustrates the Chinese courts' position that failure to stop infringements may also be considered infringement.

Since China is a civil law jurisdiction, the Beijing court decision is not binding. However, the principle set out in this case is still likely to be taken into account by the Chinese courts in future cases.

Contributor: Joan Wu, Freshfields Bruckhaus Deringer, Hong Kong; Verifier: An Xiaodi, An Tian Zhang & Partners, Beijing

ARGENTINA

Court Looks to ICANN Policies in Domain Name Case

In a November 2005 decision, *Pharmacia & Upjohn Aktiebolag v. Fasano Fernando*, the Federal Court of Appeals confirmed the trend of looking to ICANN policies for guidance in domain name cases in Argentina. Division Three of the Court of Appeals affirmed the trial court decision that acknowledged Pharmacia's claim and ordered Fernando Fasano to stop using the domain name www.pharmacia.com.ar on the basis of the plaintiff's registration and use of the mark PHARMACIA.

The court specifically pointed out that if traditional trademark confusion standards were relied on, none of the ICANN rules (namely, whether claimant has genuine rights or interest in the domain name and whether the domain name was registered and used in bad faith) would be taken into account. That is, there would be no need to prove use or registration in bad faith. Since this case involved domain names, the court disregarded trademark standards. Looking to ICANN parameters, it decided that: 1) the domain name registrant was engaged in the sale of products identical to those protected by the existing PHARMACIA trademark registrations; and 2) since no evidence to the contrary had been filed, the registration and use of www.pharmacia.com.ar must have been in bad faith.

Contributor: Verónica Canese, Marval, O'Farrell & Maizal, Buenos Aires; Verifier: Carolina Fernandez, Hausheer, Belgrano & Fernandez, Buenos Aires

INDIA

Indian Trade Mark Registry: The New Look

The Indian Government is taking steps to improve the infrastructure of its intellectual property (IP) offices. The government is overhauling current offices or moving to modern buildings and aims to set up integrated IP offices with patents, designs, trademarks and geographical indications serviced from a single location. One integrated IP office has already opened at New Delhi, and three more are planned to open shortly in Mumbai, Chennai and Kolkata.

Over the last four years, the Indian Government has committed over Rs.300,000,000 (US\$6,000,000) to modernize the IP administrative infrastructure. These measures have been introduced together with modernized laws on patents, designs, trademarks and geographical indications.

The modernization initiatives include the installation of automated inquiry counters at the New Delhi IP Office for making status check inquiries free of charge. Inquiry terminals are connected to the central database of the Indian Trademarks Registry, and anyone who wishes to check the status of a trademark can simply key in the application number and class.

Further, the Trade Mark Registry is in the process of building search rooms for IP practitioners and trademark agents. These rooms will be equipped with computers and, for a nominal fee, trademark agents may search registry records for 15 minutes. The system would operate somewhat on the lines of an Internet café.

The initiatives will certainly help IP practitioners access trademark information. Unfortunately, Registry records are not up to date, so information provided may not reflect a mark's exact status.

The government's ultimate aim is to enable all relevant IP-related services to be provided via the Internet to remote users on a real time basis.

Contributor: Rachna Bakhru, Rouse & Co., International, Dubai, U.A.E.; Verifier: Manmohan Singh, Manmohan Singh & Associates, New Delhi

INDIA

Special Copyright Act Jurisdiction Does Not Apply to Cases Under 1958 Trademark Act

The Supreme Court of India held on December 15, 2005, that a special form of jurisdiction conferred by the copyright act may not be used for a combined trademark and copyright infringement action, especially when the action is essentially a trademark action. All decided and pending cases relying on the copyright act's special jurisdiction provision are invalid. This has a far-reaching impact, as numerous cases have been filed and decided under the copyright act provision. *Dhoda House v. S. K. Maingi* (Civil Appeal No. 6248 of 1997 with Civil Appeal No. 16 of 1999).

Indian civil procedure dictates that a suit should be filed either at the place where the cause of action arises or where the defendant resides, works or carries on business. The copyright act additionally provides that copyright infringement suits can be filed where the plaintiff resides, works or carries on business.

Prior to this decision there was a conflict between the decisions of different high courts as to whether this special jurisdiction could be invoked in a combined action for copyright and trademark infringement under the Trade & Merchandise Marks Act, 1958.

The Delhi High Court has consistently held in the affirmative,

and many injunctions and permanent decrees in combined actions have been granted by that court. The Allahabad and Madras High Courts had taken a contrary view, stating that by virtue of the jurisdiction conferred under the copyright act, a court cannot entertain a trademark infringement action where the court did not have jurisdiction under the Trade & Merchandise Marks Act, 1958. This view has now been upheld by the Supreme Court.

The Supreme Court has also held that a judgment or order passed by a court lacking territorial jurisdiction is without force and stands nullified. This would mean that a number of trademark infringement matters previously decided and a number of pending litigations will now stand invalidated.

As the Court noted, the new Trade Marks Act, 1999, provides an additional forum similar to that provided by the copyright act, and therefore the Court's judgment should be limited to cases under the Trade & Merchandise Marks Act, 1958.

Contributor: Anuradha Salhotra, Lall Lahiri & Salhotra, Gurgaon, India; Verifier: Ajay Sahni, Ajay Sahni & Associates, New Delhi



International Trademark Registration Strategies Forum

March 6 – 7, 2006 | New York, New York, USA

Learn how to protect your trademarks on a global basis.

This two-day forum includes in-depth discussion, debate and updates on the international registration process, from choosing the global brand to overcoming registration and opposition hurdles to maintaining your registrations.

Top reasons to attend:

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- Learn the latest strategies for using multinational registration systems—including the Madrid Protocol—as well as which ones work best for your trademarks
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Law and Practice

ITALY

Amendments to Law Fining Purchasers of Counterfeit Goods

Law No. 248 of December 2, 2005, makes some important amendments to the famous law that earlier in 2005 introduced fines of up to €10,000 for consumers who buy counterfeit goods. The changes were effective as of December 3, 2005.

The anticounterfeiting sanctions had not lived up to expectations. One of the main reasons was that, generally, the administrative law provided that if the fine was timely paid, the amount would be either one-third of the maximum fine or double the minimum fine. Since the law did not provide a minimum fine, authorities were forced to charge a fine of at least €3,333 (one third of the maximum €10,000).



Consumers will have to pay at least €200 if they are caught buying counterfeit goods in Italy

Since this sum was quite high—especially if the consumer had bought a single item that would not have cost as much even if it had been genuine—there was a concern that instead of paying the fine many people would have hired an attorney to institute administrative proceedings and obtain cancellation of the fine. Given the risk of a serious and unmanageable backlog before the administrative board, the law was not applied on a large scale.

The amendments should solve that problem. The new law provides a minimum fine of €100, making it possible to charge €200 at first or a greater sum if the fine is not paid within the deadline. The new law also introduces much higher administrative fines (from €20,000 up to €1,000,000) if the fake products are bought by traders or importers.

In addition, the law explicitly grants local police the power to charge the fines.

Contributor: Gabriele Lazzeretti, Società Italiana Brevetti, Florence, Italy; Verifier: Ilaria Carrai, Studio Professore Marzaduri e Carloni, Viareggio, Italy

UNITED STATES

Customs Now Permits E-Filing for Trademark Recordation

On October 24, 2005, U.S. Customs and Border Protection (Customs) introduced its Intellectual Property Rights e-Recordation (IPRR) online system. IPRR permits owners of U.S. trademark registrations to apply for recordation with Customs using a convenient Web-based e-filing system rather than the traditional paper method.

With a paper filing, the applicant must provide a certified copy of the U.S. trademark registration, as well as extra paper copies. With the e-filing system, no certified copy is needed. Processing of the application by Customs personnel can go more quickly with an e-filed application because Customs personnel can easily compare application information with registration information drawn directly from U.S. Patent and Trademark Office (USPTO) records.

The applicant can pay the recordation fee by credit card, check or money order. It may be preferable, though, to pay by credit card, because this permits the application to be processed immediately. If payment is by check or money order, Customs will need to match a later paper submission with the online submission.

For design marks, the applicant must attach and upload an image of the design, which does not get drawn directly from USPTO records. IPRR documentation indicates that either a JPG or a GIF format may be used for submitting designs. Early experience, however, indicates that the e-filing system does not actually accept the JPG format. Thus, applicants may wish to use a GIF format while this issue is resolved.

IPRR offers a more efficient way to record a U.S. trademark registration with Customs, and there may be a reduced time from filing of the application to enforcement by field personnel. Nothing about the Customs e-filing system requires that the applicant be in the United States.

IPRR can be accessed online at: http://www.cbp.gov/xp/cgov/import/commercial_enforcement/ipr/iprr_intro.xml

Contributor: Carl Oppedahl, Oppedahl & Larson LLP, Dillon, Colorado, USA; Verifier: Kevin W. Grierson, Willcox & Savage, P.C., Norfolk, Virginia, USA

International Opposition Guide: Comparative Practice and Procedure

This searchable online database of basic, practical information on the structure of trademark opposition and related practices in 130 jurisdictions worldwide enables practitioners to make informed legal and business decisions and quickly assess the availability, feasibility and merits of pursuing trademark opposition. Content can be searched by jurisdiction or subject heading. Available online FREE to INTA members only.

www.inta.org

PERU

New Precedential Decision on Partial Cancellations

Peru's Competition and Intellectual Property Tribunal has issued Resolution 1183-2005/TPI-INDECOPI, published November 30, 2005, establishing a mandatory precedent for partial cancellations. Andean Community Decision 486, which came into effect on December 1, 2000, allowed interested parties to seek partial cancellations of trademark registrations. However, its provisions regarding partial cancellations were not applied until December 1, 2003.

Andean Decision 486 allows partial cancellations actions on the basis of non-use of some of the goods or services protected by a registration. In cancellation proceedings, the trademark owner must submit evidence of use. Evidence of use in any of the Andean Community member countries (Bolivia, Colombia, Ecuador, Peru and Venezuela) is sufficient to defeat the cancellation, provided that the use has been within three years preceding the cancellation filing date. The asserted use must be consistent with the nature of the goods or services in regards to the amount and manner of use and the way they are marketed.

The recent precedential decision states that the evaluating authority has the obligation to limit the list of products or services in regard to which use has not been proven. In evaluating evidence of use, the authority now must first determine whether the evidence shows use on goods or services identical or similar to those recited in the subject registration. If the use is not for goods or services specifically recited in that registration, the authority will review whether the goods or services are similar to or in the same general category as any of the goods or services detailed in the registration. Under the new resolution, if the evidence of use does not show use of the mark on goods or services identical or similar to those identified in the registration, the registration will be cancelled as to those goods or services for which no proper evidence was supplied. Thus, the authorities will treat the actions as if no evidence of use had been filed.

This precedent applies to Peru only. It remains unclear how the other Andean Pact countries will interpret and apply Andean Community Decision 486 and/or whether the Andean Tribunal will issue a statement on this matter.

Contributor: Claudia Fernandini, Clarke Modet & Co. Peru, Lima, Peru; Verifier: Francisco Espinosa Reboa, Francisco Espinosa Bellido Abogados, Lima, Peru

INTA Bulletin Board

Georges Nahitchevansky, **Lisa Pearson** and **Jason Vogel** have joined the New York City office of Kilpatrick Stockton LLP.

James B. Raden has joined the Chicago office of Welsh & Katz, Ltd. as partner. Mr. Raden was formerly with Jones Day, and before that was patent counsel of ITT Corporation.

SD Petosevic has opened its second office in Serbia and Montenegro. The Balkan Regional Office will expand the firm's activities in Serbia and Montenegro, in particular in Kosovo and Montenegro. The intellectual property practice will be handled by **Slobodan Petosevic**, **Mihajlo Zatezalo** and **Andrej Prekajski**.

Liisa M. Thomas has joined Winston & Strawn LLP's Chicago office as partner. Ms. Thomas was formerly with Gardner, Carton & Douglas.

The "INTA Bulletin Board" announces job changes or other significant career news about individuals who belong to INTA organizations. To submit an item for consideration, send a brief message to bulletin@inta.org.

WORKSHOPS

Protecting Your Brand on the Internet March 13 – 17, 2006

Gain essential facts, tips and training on enforcing trademarks on the World Wide Web and be back at the office by lunchtime.

Learn about cybersquatting, keywords, metatags, brand disparagement and information management at INTA's practical, half-day workshops, and participate in the question-and-answer period to address individual concerns.

Top reasons to register:

- Gain essential guidance on how to establish internet policy and procedure
- Learn about the latest developments in domain name issues
- Network with other trademark professionals
- Be ready for the workday by lunchtime

Look for the workshops in:

Columbus – Dallas – Denver – Madison (NJ) – New York – Palo Alto – Washington, DC

Visit www.inta.org/events to register and for more information.



Mark Your Calendars

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February 20 – March 3, 2006

Roundtable: CTM v. Madrid Protocol: One Year Later
Various U.S. cities

February 25, 2006

Saul Lefkowitz Moot Court Regional Competitions
Atlanta, Chicago, New York and San Francisco, USA

March 6 – 7, 2006

International Trademark Registration Strategies Forum
New York, New York, USA

March 13 – 17, 2006

Workshops: Protecting Your Brand on the Internet
(For non-attorney trademark professionals and new attorneys)
New York, New York, USA

March 18, 2006

Saul Lefkowitz Moot Court Final National Competition
Washington, DC, USA

March 20, 2006

Workshop: In-House Trademark Counsel's Workshop
(For Regular Member and non-member in-house counsel only)
Chicago, Illinois, USA

April 10 – 21, 2006

Roundtable: Topic to be determined
Various U.S. cities

Additional Details About INTA's Events

For a full description and to register, visit www.inta.org/events.

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