

AssociationNews

Bruce Foucart, Director, U.S. IPR Center: Help Us to Deliver Our Message

Bruce Foucart says his goal is to make the U.S. [National Intellectual Property Rights Coordination Center](#) (IPR Center) “a household name.” That may seem lofty, but Mr. Foucart is well prepared—appointed Director of the IPR Center in April, after having served as Acting Director since July of last year, he has had a 30-year career in federal law enforcement and was most recently Special Agent in Charge of the New England office of the U.S. Immigration and Customs Enforcement (ICE), Homeland Security Investigations (HSI), which heads the IPR Center. “HSI is tasked by Congress to stand up and lead the IPR Center, and there’s a reason for that,” explains Mr. Foucart. “The investigations that we conduct relate to cross-border crimes, and—as you can imagine—in the area of IP rights, most counterfeits are coming from overseas, so it falls right into our lane.”

The IPR Center was created in 1999 as part of the former U.S. Customs Service, before it came under the jurisdiction of the Depart-

ment of Homeland Security. Based in the Crystal City neighborhood of Arlington, Virginia, it sits in a task force setting with 19 federal agencies and four international agencies (EUROPOL, Interpol, the Mexican Tax and Customs Administration and the Royal Canadian Mounted Police). The headquarters office serves as a “triage” for getting information about counterfeit goods to the relevant entities in the field, says Mr. Foucart. “We have a very good relationship with private industry and we ensure that, when we do receive information, which can come from a variety of sources, the proper entities in the field receive it.”



Mr. Foucart, who recently met with INTA’s Washington, D.C., office staff to discuss

[See “Bruce Foucart” on page 3](#)

AssociationNews

New Developments on Exhaustion and Parallel Imports in the Russia/CIS Region

The Parallel Imports’ Europe and Central Asia Subcommittee has been closely monitoring the “hot topic” of exhaustion of IP rights and parallel importation in the Russia/Commonwealth of Independent States (CIS) region. An entirely new round of rather unexpected discussions and lobbying initiatives is rapidly unfolding at the level of the Russian federal government, as well as the Eurasian Economic Commission (EEC), the governing body of the Eurasian Economic Union.

Russia is a member of the Customs Union with Belarus and Kazakhstan, as well as the Eurasian Economic Union. International treaties endorsed by the Customs Union members, and more broadly at the level of the Eurasian Economic Union, provide for regional exhaustion of trademark rights. Thus, the obligations accepted by Russia will not allow for a unilateral change to the standard of exhaustion for Russia alone. Any such decision must be endorsed by other member states of the Eurasian Economic Union.

Recently, the Russian government began demonstrating a very strong desire to reconsider the principles of regional and national exhaustion of rights existing in the Customs Union and in Russia. The Russian government seems to be seriously considering changing its standard of exhaustion of trademark rights from regional to international and allowing protection against parallel imports only to those companies that have localized their production facilities in Russia. Russian officials believe that the flow of parallel imports is likely to decrease prices and give Russian consumers access to cheaper goods.

Concurrently with the discussions in the Russian government, the issue of exhaustion of rights and liberalization of parallel imports is being reviewed at the level of the Eurasian Economic Union by the EEC.

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Welcome New Members

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Textron Inc., Providence, Rhode Island, USA
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The Law Office of Carrie Hedayati, Vista, California, USA
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opportunities for collaboration, spoke with the *INTA Bulletin* about recent achievements and future plans for the IPR Center—an agency tasked with a mission that is particularly crucial to the effective enforcement of trademark rights.

One of the terrorists involved with the Charlie Hebdo attacks in Paris was financing his weapons cache by selling counterfeit luxury and sporting goods.

How has the IPR Center advanced its mission over the years?

The mission of the IPR Center is to ensure national security by protecting the public's health and safety, the U.S. economy and our [military], and to stop predatory and unfair trade practices that threaten the global economy. We also ensure that we work with private industry—the cooperation with industry has become very strong over the last several years. I have go-to contacts in nearly all industries who I can just pick up the phone and call—and they know that they can call me and the employees here as well. That helps us to do our job better going forward.

One of the other things we've become stronger with over the last few years is educating consumers. That's another of my goals going forward—to educate people of all ages, from kids on their XBOXes to older folks who need to be educated about counterfeit pharmaceuticals, for instance. So we've done a lot of messaging, for example, with the [Ad Council](#), and we have run a few public service announcements (PSAs) and have several in the pipeline that will be coming out shortly. That messaging is something we will be continuing to improve upon at the IPR Center.

Has it become harder to get that message across?

The Internet makes it so easy to purchase counterfeits and allows for the proliferation of counterfeits, but I liken the challenge of educating consumers about this issue to when

smoking was accepted back in the 1960s and 1970s. There was a huge push to educate consumers on the negative effects of smoking tobacco. It took a lot of Surgeon General warnings and Ad Council PSAs, and it took some very big verdicts, until finally, over the last decade or so, the public became aware. So that's the challenge here—we're trying to make the public aware of the negatives of purchasing or consuming counterfeit goods.

We generally say that there are three significant ways the public can be affected negatively by counterfeits. The first is health and safety related—putting counterfeit pharmaceuticals in your body can be harmful, or putting counterfeit contact lenses in your eyes can damage your retina. The second point to make is that it's not only bad for the U.S. economy, but the world economy. The United Nations Office on Drugs and Crime [has estimated](#) that the financial losses of counterfeits to the international community is upwards of \$200 to \$250 billion, which is just a staggering number. And the third point we make is that criminals are behind counterfeiting. We've seen organizations that are involved with selling counterfeit goods using those profits to invest in activities such as illegal drugs, human trafficking and forced child labor. I like to say that counterfeiting begets criminality and criminality begets counterfeiting. We've even seen counterfeiting profits that have been used to finance terrorism. For example, [CNN reported that](#) one of the terrorists involved with the Charlie Hebdo attacks in Paris was financing his weapons cache by selling counterfeit luxury and sporting goods.

Statistics from the IPR Center's [latest Annual Report](#) show that seizures overall went down in FY14 from FY13, but seizures in the auto industry went up—why is that?

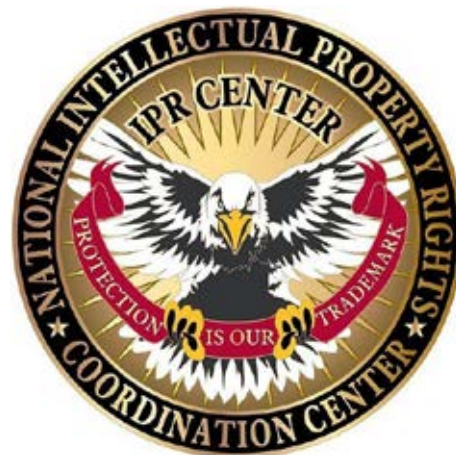
The seizures weren't down by much, but they were down. Some of that had to do with the U.S. government's [budget sequestration](#) at the beginning of that fiscal year; unfortunately, we had a number of people within HSI and Customs and Border Protection who weren't on the front lines during that time and support people who weren't assisting for two to three weeks, and I think that lack of resources contributed to the decline. I'm not one that's really big on the numbers though—quality of cases is very important as well. When you take down an organization involved with smuggling pharmaceuticals that could harm consumers, that's very noteworthy.

As for auto industry seizures, we have developed a very good relationship with “the big

three” auto makers in Detroit and with a lot of the foreign producers as well. They have been extremely helpful to us. As you can imagine, if you get a widget in a car that doesn't work or a counterfeit airbag that opens up at the wrong time, that can be extremely harmful to the consumer. So we're very happy that our field oficers have taken these cases to a higher level.

What can INTA members do to better help the IPR Center deliver on its mission?

I'm trying to make the IPR Center a household name, and one of the things we would ask if possible is if they could somehow display our new trademark symbol. The IPR Center eagle (pictured) has been trademarked now, and if they'd like to put that on their website somewhere, it would show that they're in lockstep with us and that we're partnering with them.



It would also be great if they could display our yellow IPR Center button (pictured). This allows consumers to [click and provide intelligence leads](#), which we receive at a clearinghouse. We take the information, and if it looks like it can be used for a seizure, our field office is provided with it and they'll work to get it prosecuted. So that is very productive for us, but I think it's helpful to industry as well because now you're assisting with stopping the flow of counterfeits into the United States.

How can INTA help as an Association to get the message out?

One of the things we discussed when I met with INTA staff recently in Washington, D.C., was about opportunities for us to speak about counterfeiting and to provide training, which we will be doing at upcoming INTA conferences. We also have posted [“Acquisition Professionals Training”](#) on our website, which allows consumers and procurement people

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within businesses to be educated as to the potential of buying counterfeits. We'd really like to promote that. While some of the larger companies may already have procurement policies in place, there are smaller companies that probably aren't aware of the threats, so we think that this acquisition training will be very beneficial.

What are your goals for the IPR Center long term, and how do you see it evolving?

Well, Congress mandates that we conduct investigations and seize items; that's what we're



going to continue to do. However, we're going to be ramping up and becoming much more aggressive with the consumer education and messaging piece. I'm in the process of hiring a public relations person whose sole duty will be to deal with that issue and to work with private industry to get our message across to the consumer. We also want to get much more aggressive on putting our message across on social media. Again, making the IPR Center a household name is my goal. ■

IPR Center Successes, FY15

- Last October, a Homeland Security Investigations (of which IPR Center is a division) effort led to the indictment of a Houston man for illegally trafficking in \$560,000 worth of counterfeit BEATS products.
- Through "Operation in our Sites," developed by the IPR Center in early December 2014, nearly 30,000 websites illegally selling counterfeit merchandise were shut down, as part of increased enforcement actions on a global scale.
- Last December, HSI seized 6,000 counterfeit items worth an estimated \$1.6 million from a local Detroit business. Items included counterfeit designer clothing and luxury accessories from Nike, Louis Vuitton, North Face, Gucci, Rolex and Polo.
- This past January, we seized 680 pieces of counterfeit NHL apparel worth an estimated \$25,000 during the NHL Winter Classic.
- An HSI investigation led to the arraignment of two men accused of selling \$3 million worth of counterfeit electronic goods, and violating the registered trademarks of Apple, Nokia, Blackberry and Google.
- This February, at the Super Bowl, we announced that 2015 "Operation Team Player" efforts had resulted in the seizure of over 326,000 pieces of counterfeit sports apparel and merchandise worth an estimated \$19.5 million.
- During this year's Stanley Cup Finals, we seized over 4,300 pieces of counterfeit NHL apparel/product with an estimated value of \$181,000.
- Operation Engine Newity resulted in \$12.1 million (MSRP) worth of counterfeit automotive products and parts seized in its first three years.
- Operation Chain Reaction uncovered the purchase of counterfeit Cisco converters by an individual who intended to sell them to the Department of Defense for use by the Marine Corps to transmit troop movements, relay intelligence and maintain security for a military base.

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Trademark Cancellations on INTA's Member Resources Page

Visit www.inta.org/Cancellations

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New Developments in the Russia/CIS Region continued from page 1

It appears that Russia is trying to persuade the EEC to agree to ending the currently existing regional exhaustion regime and to liberalizing parallel imports.

So far, it seems that this suggestion is not enthusiastically supported by the EEC; officials from the EEC believe that this may be detrimental to foreign investment, the economy and other considerations. The most recent idea being considered by the EEC is to leave the national/regional exhaustion of rights intact generally, but changing the standard to international exhaustion for three industrial sectors: automobile spare parts, pharmaceuticals and medical equipment.

As Russia is unlikely to be able to change the standard of exhaustion unilaterally, it appears that there is some serious negotiation ahead. The subcommittee will be following further developments and, if necessary, recommend appropriate advocacy activities.

In May, the INTA Board of Directors adopted a resolution on international exhaustion for trademark rights, arguing that, in jurisdictions where international exhaustion is allowed, a “material differences” standard should be adopted “in order to exclude parallel imports that are materially different from those products authorized for sale by the trademark owner in the domestic market” and to protect consumers’ interests.

INTA firmly supports a standard of national (or regional) exhaustion for trademark rights with respect to parallel imports.

For more information, read the INTA Blog post “Trademark Protection in the Customs Union: INTA Speaks in Belarus” (April 9, 2013). ■

Denis Khabarov

Baker & McKenzie, CIS Limited, Moscow, Russia
Parallel Imports’ Europe and Central Asia Subcommittee

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INTA Hosts Focus Group on Indonesia Trademark Law Revision

On June 11, INTA and the Indonesia Intellectual Property Consultants Association (AKHKI) hosted a focus group discussion with officials from Indonesia's Directorate General of Intellectual Property (DGIP), Supreme Court, Customs and local universities on the forthcoming Indonesia Trademark Law revision.

The invitation-only event was held in Jakarta and organized by the Chair of the East Asia & Pacific Subcommittee of INTA's Anticounterfeiting Committee, Kowit Somwaiya (Law Plus Ltd., Thailand), and AKHKI's President, Cita Citrawinda.

Director General of the DGIP, Dr. Ahmad Mujahid Ramli, opened the event, followed by Mr. Somwaiya and Ms. Citrawinda.

The Director of the Trademark Office, Bambang Iriana Djajaatmaja, delivered an extensive summary of the draft trademark law. The new law will be amended to include:

- Non-traditional marks such as sound, 3D and scent;



Members of INTA and AKHKI with Indonesia DGIP Director of International Cooperation Parlagutan Lubis.

- Adjustments to provide for Madrid Protocol Accession;
- Increased criminal penalties for counterfeiting;
- Reduced statutory time limits on trademark examination (eight months); and

- Six-month grace periods on renewals.

The draft went to parliament on June 10 and is expected to be passed quickly, so as to be implemented by the end of the year.

In addition to Mr. Somwaiya, INTA speakers included Somboon Earterasun (Tilleke & Gibbins, Thailand); Daniel Greif (Siam Premier International Law Office Limited, Thailand), Chair of INTA's Non-Traditional Marks Committee, East Asia & Pacific Subcommittee; Koji Murai (Shinjiyu Global IP, Japan); and Soh Kar Liang (Ella Cheong, Singapore), a member of INTA's Legislation and Regulation Committee. DGIP Director of International Cooperation Parlagutan Lubis provided the closing remarks.

INTA also greatly appreciates the efforts of INTA Anticounterfeiting Committee member Mr. Justu Kusumah (K&K Advocates, Indonesia) for organizing the event.

ACC Members Participate in WIPO International Forum, Conduct Roundtable in Russia

Anton Bankovskiy
CMS, Moscow, Russia

Oxana Pishvanova
Dentons, Moscow, Russia

Both are members of the Anticounterfeiting Committee—Eastern Europe & Central Asia Subcommittee.

The "Intellectual Property—XXI Century" International Forum was sponsored by WIPO at the Russian Chamber of Commerce and Industry (CCI) in Moscow on April 21–23, 2015. In addition to the CCI, the Upper Chamber of the Russian Parliament, the Federal Service for Intellectual Property, the Russian Ministry for Industry and Trade, the Russian Ministry for Education and Culture and the Russian Court for Intellectual Property Rights acted as co-organizers of the Forum. For the first time in its history, INTA also joined the Forum as one of the co-organizers.

The Forum was opened by a plenary session featuring Sergey Katyrin, President of the Russian Chamber of Commerce and Industry;

Lyudmila Ogorodova, Russian Deputy Minister of Education and Science; Lyudmila Novoselova, Chairman of the Russian Court for Intellectual Property Rights; Michal Svantner, Director of the WIPO Office in the Russian Federation (WRO), which recently opened in Moscow; as well as representatives of major Russian (Rosatom) and foreign innovative companies (Microsoft). The Forum was welcomed by the Head of the Administration of the President of Russia and the Russian Parliament.

Bartosz Krakowiak (PolSERVICE Patent and Trademark Attorneys Office, Poland), Chair of INTA's Anticounterfeiting Committee (ACC), made a welcoming speech at the plenary session outlining the role of INTA in working out strategies for IP protection by building dialogues among government officials, non-governmental organizations, brand owners, practitioners and Internet Service Providers.

According to the CCI, the opening plenary session was attended by 243 participants out of 2,146 at the Forum. All events, including roundtables, were streamed online, with an audience of 1,560 people. On April 30, 2015,

the leading Russian news channel "Russia-24" aired a summary of the Forum on the "Business Vector" TV program.

"Intellectual Property on the Internet: Russian and Foreign Practices" was a roundtable held jointly by INTA and CCI, which took place on the heels of the Forum, on April 23, with 145 participants. The event was moderated by Denis Voevodin (Dentons, Russia), on behalf of INTA, and by Tagir Kalimullin, M-Video Corporate Relations Director. The event was organized and coordinated with the CCI by members of the ACC's Eastern Europe Subcommittee, Anton Bankovskiy (CMS, Russia) and Oxana Pishvanova (Dentons, Russia). The panel covered the amendments to the Russian Civil and Criminal Codes affecting the protections of trademark rights, analyzed current case law and suggested some legal initiatives, such as expanding the scope of persons liable for promoting infringing goods and simplifying legal procedures for shutting down websites posting goods that infringe trademark rights.

VolunteerSpotlight



Virginia Cervieri

In the 1990s, effective enforcement of trademark rights in Uruguay was not common. Companies filed trademarks but didn't often consider anticounterfeiting measures. Virginia Cervieri noticed this and decided to make it her challenge. She initiated her practice in

1990 with the intention of focusing on anti-counterfeiting and has been working since to improve the enforcement system in Uruguay for the benefit of all trademark owners. This has included working with the Uruguayan Customs Office to educate them about international border control standards and lobbying governments and the courts.

The first steps were not easy. In an environment dominated by men, she had to fight her way up. She was hesitant to open her own firm more than five years ago, but says that this has been the most rewarding professional experience of her life and the best move she could have ever made. When she started, the firm comprised only three professionals; now, not only have they opened an office in Paraguay, but have a team of 30 people.

Virginia feels she is incredibly lucky to work with such great people, to travel all over the world, to form friendships with people she meets from so many different countries and to be in contact with some of the most famous brands in the world. She does not like routine

and finds that, in intellectual property, there is a new challenge every day.

Virginia's partner is her husband, an attorney who also practices IP law. She says that this "dual contract" (husband-wife/partner) has worked harmoniously for several years now. One contract has resulted in the significant growth of the firm. The other contract has resulted in two children, ages nine and 10.

When she isn't enthusiastically working with trademarks and fighting against counterfeiters, Virginia enjoys her family. She values the moments they are all together at home and/or the weekends practicing sports, cycling, running and picnicking on the beach—especially as Virginia and her family live only half an hour from Punta del Este, one of the nicest beach cities in Uruguay.

Bernard Malone

Baker & McKenzie, Buenos Aires, Argentina
INTA Bulletin—Association News Subcommittee

Committee Spotlight: *The Trademark Reporter* Committee

Jonathan Moskin

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Daniel Glazer

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New York, New York, USA

Mr. Moskin serves as Chair and Mr. Glazer serves as Vice Chair of *The Trademark Reporter* Committee.

The Trademark Reporter (TMR) has been published for over 100 years, since 1911. Although it did once "report" or publish trademark decisions, for many years it has sought to be the premier scholarly journal of trademark law for practitioners—combining scholarly research on cutting edge issues of law with practical insights from actual practitioners who both write many of the articles and comprise the editorial board. Like other scholarly journals, it is peer reviewed, but the peers are practitioners too, so are able to bring insights that purely academic journals do not. Indeed, TMR articles have often been cited by courts in important trademark cases, and writing for the TMR provides an opportunity to influence the development of the law.

For many years, the TMR has published an [Annual Review of U.S. Trademark Law](#). Owing to the increased diversity of the INTA membership, the TMR committee now also publishes an [Annual Review of European Trademark Law](#). For many years, the authors of the annual reviews have reported the highlights of the annual review to the full INTA membership at the Annual Meeting. It has long been one of the most popular features of the Annual Meeting.

From time to time, the TMR also publishes theme issues. For instance, the Committee recently published a theme issue on trademark "use," and is currently working on a forthcoming theme issue on design law. It has also just begun soliciting submissions for an issue on monetary relief in trademark cases.

One of the most challenging projects the TMR currently is pursuing is the publication of such scholarly articles in multiple languages. It is unusual among scholarly, peer-reviewed journals to publish in more than one language, but owing to the increasingly diverse nature of the INTA membership, the Committee is working now to publish in languages other than English (albeit also accompanied by an English translation).

The current Editor in Chief of the TMR (and Committee Chair) is Jonathan Moskin, a partner at Foley & Lardner in New York. The Committee Vice-Chair (and next in line to be Editor-in-Chief) is Daniel Glazer, a partner at Fried Frank, also in New York. Once editors are selected for inclusion among the senior editors, they serve in this role until they are ready to transition to editor-in-chief status. Because of the increasing focus on publishing in languages other than English, the committee is now also looking for members with diverse language abilities.

Although the TMR does not have discrete subcommittees, it does have a series of evolving task forces. The current task forces include: Minders & Solicitors/Multi-Language Publications (which solicits articles from potential authors, in particular now in languages other than English); Commercial/Business Issues Related to Trademarks (which focuses on attracting technical articles relevant to trademark law by non-lawyers); Commentary (which focuses on shorter thought pieces); Recruiting Event Speakers as Authors (which seeks to enlist talented speakers—including at INTA events—to put their words into writing); and Theme Issue Task Forces (which evolve depending on the theme issue at hand).

Features

Lending Color to Trademarks: Protection and Enforcement of Color Marks in the U.S., EU, China and Japan

John Froemming

Jones Day, Washington, D.C., USA

Marc Groebel

Jones Day, Munich, Germany

Chiang Ling Li

Jones Day, Hong Kong, China SAR

Ulrich Mehler

Jones Day, Munich, Germany

Anna Raimer

Jones Day, Houston, Texas, USA

Michiru Takahashi

Jones Day, Tokyo, Japan

Ms. Raimer is a member of the *INTA Bulletin*—Features Subcommittee.

While the laws differ on whether a single color trademark may be registrable and on the evidence required for registration of a color trademark, the United States, the EU, China and Japan are uniform in refusing to register functional color trademarks. This article provides a perspective on the protection of color trademarks through registration in the United States, the EU, China and Japan. It also examines decisions in those jurisdictions regarding the enforcement of trademark rights in color.

The United States

In the United States, color alone may serve as a trademark. The Supreme Court has determined that U.S. trademark law permits the use and registration of a single color as a trademark. *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995). In the *Qualitex* decision, the Court held that the greenish-gold color of dry cleaning press pads was protectable as a trademark. This color met the requirements of a trademark by acting as a symbol, operating as a source identifier and serving no other function aside from identifying the press pads' source.

Registrability of Color Trademarks

To obtain a federal registration for a color trademark on the Principal Register, it must be shown that (1) the mark is not functional, and (2) the mark has acquired distinctiveness. If a proposed mark is not functional but is also not distinctive, it is only registrable on the Supplemental Register.

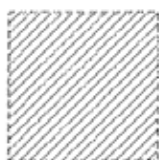
Functional color marks are incapable of registration. In other words, if the exclusive use of a

color would provide the owner with a utilitarian or functional advantage, the color is not registrable. For example, in *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527 (Fed. Cir. 1994), the color black was found to be functional for boat motors. Although the color black does not make motors work better, black provides the significant competitive advantages of being compatible with a variety of boat colors and making the motors look smaller.

A color trademark must have a secondary meaning to be registered on the Principal Register. Evidence of acquired distinctiveness may include evidence of sales success, advertising expenditures, length and exclusivity of use, unsolicited media coverage and consumer studies. For example, in its decision *In re Owens-Corning Fiberglas Corp.*, 744 F.2d 1116 (Fed. Cir. 1985), the Federal Circuit determined the color pink had acquired secondary meaning based on evidence that included use of the color for 29 years, over \$42 million in advertising expenditures and a survey demonstrating 50 percent consumer recognition of the source of the applicant's pink insulation.

An application for a single color trademark must include a drawing showing the mark in color with (1) a color claim, and (2) a statement naming the color(s) and describing where it appears (e.g., on the product or an object related to the services). The particular color or shade of color must be described in ordinary language, such as "red" or "maroon," even if a description from a commercial coloring system is provided.

A color mark drawing is typically a representation of the relevant product or its package, with the object appearing in dotted lines. The drawing of a proposed color mark for services may consist of a generic shape, such as a square with a dotted peripheral outline. *In re Thrifty, Inc.*, 274 F.3d 1349, 1353 (Fed. Cir. 2001). For example, United Parcel Service of America, Inc., (UPS), owns U.S. Trademark Reg. No. 2,901,090 for transportation and delivery services, which is described as consisting of "the color chocolate brown, which is the approximate equivalent of Pantone Matching System 462C, as applied to the entire surface of vehicles and uniforms" and depicted as follows:



The evidence UPS submitted to support registration included: 80 years of use of the mark, 109 consumer statements attesting to association of the color brown with the delivery services of UPS, unsolicited media coverage recognizing brown as UPS's trademark, examples of advertising featuring the color brown and advertising expenditures of over \$100 million per year for 10 years and billions of dollars in revenue and package deliveries.

Enforcement of Color Trademarks

As with traditional trademark infringement actions under the Lanham (Trademark) Act, asserting an infringement claim based on a color trademark registration requires the trademark owner to prove (1) the mark is legally eligible for protection; (2) the trademark owner is the senior user of the mark; and (3) the infringer's use is likely to create confusion as to source or affiliation. Registered and common law trademarks are enforceable under the Trademark Act.

As demonstrated by recent case law, a key issue with color trademarks is the scope of protection afforded by the registration of the mark. For example, in *Christian Louboutin, S.A. v. Yves Saint Laurent America Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012), the U.S. Court of Appeals for the Second Circuit recognized that the use of red lacquered soles on shoes is a legally protected trademark. However, protection of the red sole (depicted below) is limited to shoes on which there is a contrast between the outsole and adjoining shoe.



Because of the contrasting color limitation, the trademark owner was ultimately unsuccessful in obtaining an injunction in connection with monochromatic shoes.

In a recent case involving service mark infringement, *T-Mobile US, Inc., et al. v. Aio Wireless LLC*, 991 F. Supp. 2d 888 (S.D. Tex. 2014), a district court found that Deutsche Telekom AG and T-Mobile US, Inc.'s (T-Mobile's) magenta color (shown below) had acquired secondary meaning within the wireless-telecommunications industry.

The court granted T-Mobile's request for a preliminary injunction against the defendant's "use of large blocks or swaths of Pantone 676C

Features

and confusingly similar shades in its advertising, marketing, and store design.” *Id.* at 932.



The European Union

Formal trademark protection for color marks was introduced in the EU by the First Council Directive of December 21, 1988 (the Trademarks Directive). The purpose of the Trademarks Directive was to harmonize European trademark law where possible. Prior to the Trademarks Directive, protection for color marks varied by Member State.

Registrability of Color Trademarks

The general criteria for the registration of color trademarks was set forth by the Court of Justice in *Libertel Groep BV v Benelux Merkenbureau*, [2003] ECR I-03793. Like any other trademark, color marks and color combination marks are subject to an examination under Article 7 CTMR. However, due to the particular features of color trademarks, some conditions for registration have proven to be particularly difficult, namely the graphic representation of the mark and the requirement of distinctiveness.

The graphic representation for the proposed color mark must depict a visual representation of the mark. The representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. In order to fulfill these criteria, applications for color trademarks must contain a description, a sample and the designation of the color using an internationally recognized identification code (e.g., Pantone or RAL). The graphic representation should clearly indicate the position and proportion of the various colors. An abstract claim of two colors in “any possible combination” is not acceptable.

Color marks must also be distinctive. The appropriate examination standard is whether the marks are distinctive when applied to the goods or their packaging, or as used in the context of the delivery of services. The distinctive character must be proven to exist in the entire territory of the EU.

Because consumers might not be in the habit of making assumptions about the origin of products based on a color alone, color is typically not inherently capable of distinguishing the products of one party from those of another. Therefore, single colors are not inherently distinctive except under very special circumstances. For example, a color that is absolutely striking or unusual for the product in question

may be deemed inherently distinctive, such as the color black for milk.

If a color mark is not inherently distinctive, acquired distinctiveness must be shown prior to the filing date of the application. In a recent decision involving use of the color red for financial services in Germany, the Court of Justice of the European Union confirmed that mere color marks may be capable of constituting trademarks and clarified the evidence that must be brought forward to show acquired distinctiveness. *Oberbank AG v Deutscher Sparkassen- und Giroverband eV; Banco Santander SA and another v Same* (Joined Cases C-217/13 and C-218/13) [2014] WLR (D) 274. Acquired distinctiveness may be shown by “the market share held by the mark in question; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identifies goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.” *Id.*

It is typically easier to demonstrate acquired distinctiveness for color combination trademarks. Color combination marks have been recognized in several General Court judgments, including *BCS SpA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, [2009] ECR II-04047 and *CNH Global NV v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, [2010] ECR II-05153.

Enforcement of Color Trademarks

Color trademarks have also been successfully enforced in the EU. For example, the German media company Langenscheidt, which specializes in language training material, owns a yellow color mark. In Germany’s highest court, Langenscheidt successfully enjoined its competitor, Rosetta Stone, from distributing its learning software in yellow packaging in Germany. Rosetta Stone, in turn, failed in its application to cancel Langenscheidt’s mere color mark. Federal Supreme Court for Civil Matters (BGH), verdicts of Sept. 18, 2014, I ZR 228/12 and Oct. 22, 2014, I ZB 61/13.

China

In accordance with Trademark Law of the People’s Republic of China, effective May 1, 2014, any visually perceptible sign, including color combinations, capable of distinguishing the goods of one party from those of others is eligible for registration as a trademark. Hence, color combination marks are registrable as trademarks and service marks in China.

Registrability of Color Trademarks

The Chinese Trademark Office examination standard states that color marks need to consist of two or more colors. When applying for color marks in China, applicants must clearly state in the application forms that they are applying for color marks and provide color specimens. The colors should be named by reference to Pantone numbers.

The Chinese Trademark Office examines whether the applied-for color mark is registrable, and whether it is similar or identical to prior two-dimensional, three-dimensional and color marks.

Often, a color mark is rejected because the color combination is found to be common for the specified goods or services. For example, when Swedish tool maker Kapman AB applied for an orange and blue color mark in 2002, it was rejected by the Chinese Trademark Office, the Trademark Review and Adjudication Board and administrative review courts on the grounds that the mark was too simple and not sufficiently distinctive.

Enforcement of Color Trademarks

Color combination trademarks have been enforced by courts in China. For example, Deere & Company owns a trademark registration in China for a green and yellow color mark, as shown below, for various farm equipment.



Deere & Company sued JOTEC International Heavy Industry (Qingdao) Co Ltd. and JOTEC International Heavy Industry (Beijing) Co Ltd. for using the green and yellow color combination on their products and in promotional material. The Chinese court, in an unpublished decision, found for Deere & Company and issued an injunction and compensatory damages, confirming that color marks are protected in China.

Japan

Effective April 1, 2015, color marks will become registrable in Japan. On April 25, 2014, an amendment to the Trademark Act of Japan (Act No. 127 of 1959, as amended) was enacted, introducing the protection of non-traditional marks.

Under the amended Trademark Act, “any character(s), figure(s), sign(s), three-dimensional shape(s) or color(s), or any combination there-

See “Color” on page 10

Features

Lending Color to Trademarks: Protection and Enforcement of Color Marks in the U.S., EU, China and Japan *continued from page 9*

of, sound(s), or other(s) specified by a Cabinet Order, which is perceptible with human sense” will be protected as a trademark (Article 2, Paragraph 1). Under this new definition, a “color per se” mark and a combination of colors without delineated contours will be protected.

Registrability of Color Trademarks

An application for a color mark shall state that the proposed mark is a color or color combination per se mark (Article 5, Paragraph 1). To show the applied-for single color mark in the application, the applicant should provide either (i) a drawing or a photo indicating the applied-for color, or (ii) a drawing or photo indicating the place where the color is used in the relevant product with the object appearing in dotted lines. Further, the applicant should provide a description of the color by indicating the ratio of three primary colors (RGB) in the color, or using the Pantone color identification system. For a color combination mark, the ratio of each color used in the combination should also be described.

Like any other trademark, a color mark is registrable when it is inherently distinctive or has acquired distinctiveness. As a matter of practice, it is expected that a color mark will be found distinctive only on the basis of

acquired distinctiveness because showing inherent distinctiveness of a color mark would be very difficult. Further, even showing proof of acquired distinctiveness will likely be a very difficult task, especially for a single color mark. Evidence of acquired distinctiveness typically includes evidence of sales figures, advertising expenditures, length and exclusivity of use, unsolicited media coverage (magazines, newspapers) and consumer surveys. Color marks for colors that goods (including packages) or services naturally have as characteristics of such goods or services (so-called functional marks) are not registrable (Article 4, Paragraph 1, Item 18 of the amended Trademark Act, Article 1 of the Enforcement Ordinance). According to the examination guidelines, such functional color marks are (i) marks that consist solely of colors that naturally derive from goods or services, or (ii) colors that are indispensable for ensuring the functionality of such goods or services.

Enforcement of Color Trademarks

Because color marks were not registrable before the amendment, a color per se or color combination mark could only be protected under the Unfair Competition Prevention Law (Law No. 47 of 1993, as amended). However, courts have taken a very rigid position toward the protection of single color or color combi-

nation marks. For instance, in a case where the plaintiff sought protection of a navy color that it had used for its series of home electric appliances, the Osaka High Court rejected the protection, stating that whether a single color has acquired a source identification function should be determined carefully with a view to not hampering free use of colors in commerce. *Sanyo Electric v. Twinbird*, Osaka High Court judgment of Mar. 27, 1997 (29 *Chisai* 368).

On the other hand, in a case seeking to enforce a combination of three color lines as used on wetsuits, the Osaka District Court found the color combination had become a source identifier to be protected under the Unfair Competition Prevention Law through extensive and continuous use by the plaintiff, and issued an injunction against the defendant. *Tank v. Taiyo Sensui*, Osaka District Court judgment of Dec. 23, 1983 (15 *Mutai* 894).

In sum, when considering the scope of protection available for a color trademark, as well as the ability to enforce rights in the mark, it is critical to review the law in each jurisdiction of interest. ■

Jurisdiction Comparison

Jurisdiction	Protection for single color trademarks available?	Evidence of secondary meaning required for registration?	Functionality of color mark prevents registration?	Registration required to enforce rights in color mark?
United States	Yes	Yes, and a substantial showing of secondary meaning is required.	Yes	No, but mark must be legally eligible for protection.
European Union	Yes	No, provided the mark is absolutely unusual or striking in relation to the specific goods.	Yes	Technically no, but given the degree of recognition a mark must have to be protected by mere use, it is difficult for any color mark to reach this level of recognition.
China	No	Yes, and a substantial showing of secondary meaning is required.	Yes	In practice, yes.
Japan	Yes, effective on April 1, 2015.	As a practical matter, likely yes, and a substantial showing of secondary meaning will be required.	Yes	No; action may be brought under the Unfair Competition Prevention Law.

CHINA CTMO Enforcing Limits on Spec Amendments

The Trademark Office of the State Administration for Industry and Commerce of the People's Republic of China (China Trademark Office or CTMO) has recently adopted important changes in its policies for approving descriptions of goods and services. As a result, trademark applicants will need to give more careful consideration when drafting specifications in order to avoid potential risks of higher prosecution costs as well as impediments to licensing and anticounterfeiting work.

Direct Filings

Following the entry into effect of the latest amendments to the People's Republic of China Trademark Law in May 2014, the CTMO has tried to accelerate the examination process in various ways to meet the nine-month deadline mandated under the revised law. To reduce the time spent in processing applications, the CTMO is now requiring applicants to limit their descriptions to those on the CTMO's index of pre-approved descriptions.

Historically, CTMO examiners have allowed time for multiple exchanges with applicants that are seeking acceptance of "non-standard" descriptions. But under the latest policy change, the CTMO is now allowing applicants only one chance to amend their applications, failing which the applications may be rejected.

Applicants faced with CTMO objections typically either will delete rejected items or replace them with "standard" descriptions from the CTMO's index. Alternatively, applicants can respond to CTMO objections by providing explanations and evidence as to why their non-standard descriptions should be accepted.

But under the CTMO's latest policy change, if the examiner rejects non-standard descriptions, the application will be deemed not to have been received in the first place, and the filing date lost.

Such decisions can be appealed to the State Administration for Industry and Commerce (SAIC), the parent organization of the CTMO. But it remains unclear at this time what the chances of success in such appeals will be.

The net effect of this new policy is to discourage applicants from seeking protection for non-standard descriptions of goods and services. However, in many cases, applicants may feel constrained to take the risk of rejection, e.g., where their goods or services are not adequately covered by existing "standard" descriptions. This is particularly the case for goods and services that are new, and have not previously been considered for inclusion in the Nice Classification or the CTMO's own index.

Potential Harm?

The CTMO's refusal to accept non-standard descriptions can in principle result in denial of access to criminal enforcement against counterfeits, as China's Criminal Code conditions enforcement on a finding that the goods or services sold by the infringer be "identical" to those covered in the trademark owner's registration certificate.

Further, the CTMO's refusal to accept non-standard descriptions may also have negative repercussions with respect to administrative and civil enforcement, as well as licensing activity.

Best Practices

Applicants seeking to minimize their prosecution costs would be best advised to limit their draft specifications for direct filings only to goods and services deemed "standard" under the CTMO's current index.

For applicants that wish to go the extra mile to register marks covering non-standard descriptions, consideration can also be given to filing two sets of applications—one covering the closest standard description (thus ensuring acceptance) and the other covering the desired non-standard description. If the latter application is ultimately rejected, an appeal to the SAIC can be considered but without the risk of losing the original filing date.

Alternatively, consideration can be given to filing through the Madrid System. Under current practice, the CTMO normally accepts non-standard descriptions for such filings despite the fact that the goods and services are non-standard under the CTMO's index.

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Yuanhe United Intellectual Property Partners/
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Subcommittee

INTA's International Oppositions Guide

This searchable database offers over 100 country profiles on the structure of trademark opposition practice and procedure including:

- general provisions
- applicable grounds
- alternatives to opposition
- opponent issues
- filing requirements
- post-filing stages and procedures

Visit www.inta.org/iog



CROATIA Goods Seized by Customs in Operational Action “Trademark II”

On May 7, 2015, the Customs officials of the Mobile Units Department of Zagreb, in cooperation with the Customs officials of the Mobile Unit Service and the Department for Internal Audit and Control of the Customs Authority of the Republic of Croatia, officials from the Zagreb Police Department, Department of Economic Crime and riot police officers, carried out the operational action “TRADEMARK II” in Zagreb, Dubrava, for the purpose of combating illegal trade of goods infringing intellectual property rights under the provisions of Croatia’s Trademark Act.

Pursuant to the order of the Magistrate’s Court in Zagreb, searches were carried out at seven different addresses in Zagreb due to the presence of reasonable suspicion of the conduct of illegal trade of goods that infringe the provisions of the Trademark Act and the

operation of unregistered services relating to the production, storage and sale of goods.

In accordance with the implemented control measures and searches, a total of 120,468 pieces of different textile products, leather goods and other items of the renowned brands LOUIS VUITTON, LACOSTE, ARMANI, MICHAEL KORS, MOSHINO, D&G, CHANEL, GUCCI, VERSACE, etc., along with 2.014.70 kilograms of raw materials with logos of renowned brands that are used for the production of leather bags, were temporarily seized.

The Mobile Units Department of Zagreb has also temporarily sealed the business premises in three locations due to the conduct of unregistered services relating to the production, storage and sale of the above goods, thus violating the provisions of the Law on

the Prohibition and Prevention of Conducting Unregistered Business.

The total estimated value of the seized goods is more than HRK 13.9 million (approximately EUR 1.9 million).

The Customs Authority will now follow up with misdemeanor and criminal proceedings against the suspects due to illegal activities related to the violation of the provisions of the Trademark Act and the Law on the Prohibition and Prevention of Conducting Unregistered Business.

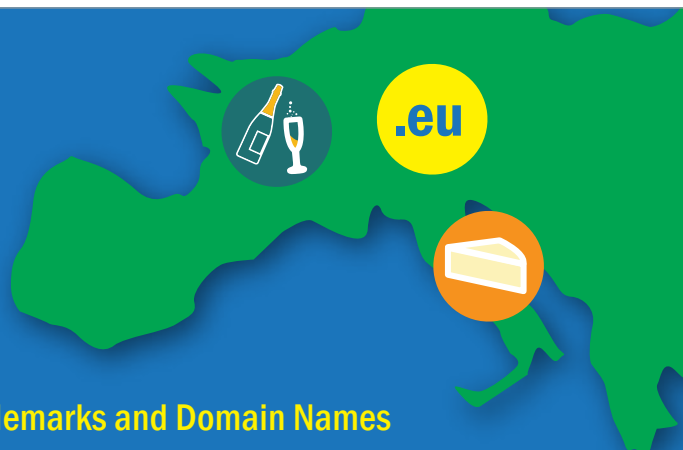
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The Geographical Names Conference

Protecting and Enforcing Geographic Names, GIs, Trademarks and Domain Names



Mark your calendar for INTA’s 2015 European Meeting on Geographical Indications–**The Geographical Names Conference: Protecting and Enforcing Geographic Names, GIs, Trademarks and Domain Names**–to take place in Rome, Italy, December 10–11.

Geographic indications are a central topic of debate in current international trade agreement talks and Europe is facing important policy choices on how to protect the names of products that have a link with a specific geographic place.

Join INTA’s experts and officials from around the world to gain insight into the economic benefits of Geographic Indicators as well as brand owners’ strategies and potential benefits of association with a Protected Geographical Indication or Protected Designation of Origin.

Details on the educational program and networking opportunities will be available soon and registration will launch in September 2015 on the INTA website.

Visit www.inta.org/GI2015

OHIM Left with Heavy Hangover After General Court Decision

EUROPEAN UNION

In a decision handed down on May 21, 2015, the General Court (GC) has revoked a decision from the OHIM Opposition Division, confirmed by the Appeal Board, on the possible risk of confusion between the trademarks WINE IN BLACK and NOVAL BLACK.

In 2012, the German company Wine in Black GmbH filed for trademark registration of its trade name for, among other products, goods in Class 33 (“alcoholic beverages (except beers), in particular: wines, brandy”). The Portuguese company Quinta do Noval-Vinhos, S.A. opposed the application based on its Community Trade Mark NOVAL BLACK, registered for “alcoholic beverages (except beers),” claiming a risk of confusion in accordance with Article 8(1)(b) of the Community Trade Mark Regulation. The opposition was upheld by OHIM’s Opposition Division and in March 2014 confirmed by OHIM’s First Board of Appeal. Dissatisfied with the OHIM outcome, Wine in Black took the decision to the GC.

The GC limited its observations to a comparison of the two trademarks involved, as there was no dispute over conflict of goods, nor over the definition of the relevant public: It should be seen as consisting “of average

European consumers who are English-speaking or who are deemed to have an elementary knowledge of English, with a reasonable level of attention in respect of wines and other alcoholic beverages.”

In its findings, the GC stated that the Board of Appeal erred in finding that the two signs had a certain visual similarity, not only because of the difference in length and structure, but also because of the different beginnings of the marks.

As for phonetic similarity, the GC more or less rejected all the reasons of the Appeal Board decision, pointing again to the difference in length and beginnings of the marks as well as to the difference in rhythm; furthermore, the GC referred to the fact that the word “noval” did not belong to the English language, and the relevant public would therefore “not know exactly how to pronounce it, which precludes the presumption that the word will be pronounced with the same rhythm and intonation as the initial part ‘wine in’ of the mark applied for.”

Finally, with regard to conceptual similarity, the GC rebuked the Appeal Board for not properly assessing the mark applied for as a whole, as the Board failed to take into account that the

expression “wine in black,” as claimed by the applicant, “has an imaginative and evocative character.” The GC also emphasized that the non-English word “noval” in the opponent’s mark is without meaning and is simply qualified by the word “black,” the only common element of the two marks.

On this basis, the GC concluded that the identity of goods was not sufficient to establish a likelihood of confusion, given the low degree of visual and phonetic similarity of the signs and their conceptual differences.

On top of overturning OHIM’s decision, the GC added to the headache by ordering OHIM to pay the legal costs of both parties involved.

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Trademark Assignment Agreement Checklist

Determine the requirements of each applicable jurisdiction where your to-be-assigned trademark assets are located. This fact sheet also covers key questions on assets to be assigned, execution requirements, the assignor and assignee, consideration and taxation, checking and correcting chain-of-title issues, and miscellaneous provisions.

Visit www.inta.org/practitionerschecklists

FRANCE Supreme Court Rules That Behavior Subsequent to Filing Can Prove Bad Faith

On February 3, 2015, the French Supreme Court took a step forward with respect to assessing a trademark registrant's bad faith. The Supreme Court issued a decision (*French Supreme Court, Commercial Division, February 3rd, 2015, 13-18.025*) that a fraudulent trademark filing and a registrant's bad faith at the time of registration can be established with respect to circumstances subsequent to the filing of the trademark application, and not only to facts at the time of filing, as was the standard in the past.

In this case, the defendant ran a souvenir business between 1985 and 1993 on the plaintiff's premises, and was the owner of the BATEAUX-MOUCHES PARIS PONT DE L'ALMA trademark filed on April 20, 1993, and which had expired on April 20, 2003, due to non-renewal. The defendant thus filed an application for an identical trademark on April 28, 2003, as well as the word mark BATEAUX-MOUCHES on September 24, 2013, designating the same class of goods (for merchandising) as the expired mark.

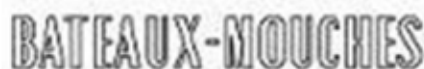


The plaintiff, Compagnie des bateaux mouches, which organizes cruise trips on the river Seine in Paris, filed a lawsuit against the defendant for infringement to its prior rights, and

particularly the name of their company and trade name. It also claimed that the trademark filings had been fraudulently made according to Article L.712-6 of the French Intellectual Property Code. The plaintiff also emphasized that the defendant had never used the trademark in question.

In the contested judgment, the Paris Court of Appeal held that the term "bateaux-mouches" had a generic meaning that is used commonly to designate tourist transportation on the Seine, and as such, rejected the plaintiff's claim, considering that the public would not attribute the term to the plaintiff. The company tried to counter this decision, arguing that the corporate name became distinctive or reputed through use, but the Court of Appeal refused such allegations, and rejected the plaintiff's claim regarding his prior rights on the term (*Paris Court of Appeal, Pole 5, Chamber 1, January 4, 2012, No. 09/08240*).

A similar decision had been issued by the European Court of Justice (ECJ) Sixth Chamber, on December 11, 2014, (case C-368/14 P.) regarding the trademark BATEAUX-MOUCHES, holding that these terms were descriptive for the French-speaking public, in particular for transportation services by tourist boats.



Furthermore, regarding the fraudulent filing of the trademark, the Court of Appeal rejected the claim of the plaintiff in light of article L.712-6 of the French Intellectual Property

Code, holding that circumstances subsequent to the filing, such as non-use of the trademark, could not be taken into account in the appraisal of the registrant's bad faith, as bad faith should only be relevant at the time of the filing.

The Supreme Court reversed this decision, holding that the intention of the trademark registrant at the time of the filing must be assessed considering all pertinent factors of the case, including the elements subsequent to the trademark's filing. The Court further held that the Court of Appeal could not have properly ruled on the plaintiff's prior rights without considering if "the filing of the disputed trademarks was not made with the intention to impede the expansion of plaintiff's sales activity on these goods under such sign."

The case is now remanded to the Paris Court of Appeal, which will have to decide on the issue of trademark infringement in consideration of these new elements.

This decision demonstrates increased flexibility by French judges with respect to bad faith and may greatly impact future cases.

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Assuming Responsibility for a Trademark Portfolio

This Practitioners' Checklist is intended to provide basic guidance and a list of "things to remember" when a practitioner assumes responsibility for an existing trademark portfolio previously managed by others.



Visit www.inta.org/practitionerschecklists

GERMANY German Federal Supreme Court Confirms Important Requirements for Genuine Use

In a verdict that was just recently published, the German Federal Supreme Court confirmed some important rules on how to and how not to produce evidence for genuine use (German Federal Supreme Court, decision dated November 27, 2014, legal case I ZR 91/13 – STAYER).

The defendant in this case was a Russian manufacturer of hand-operated tools. The defendant owned an international registration for the mark STAYER, protected in Germany for goods in Classes 3, 8 and 16, including “tools” and “hand-operated abrasion instruments” in Class 8. The plaintiff requested cancellation of this mark in Germany based on non-use.

The Court confirmed that establishing genuine use of a mark in Germany requires more than the mere transit of goods through Germany, where the trademark was applied to the goods in another country. However, genuine use may be assumed where goods are labeled with the trademark in Germany even when the goods are intended to be for export only.

“Genuine use” requires that the mark must be used to serve as indication of origin for goods and services in order to develop or maintain a market for these goods. Relevant factors include duration, extent and frequency of use.

All activities must show a connection to the German market.

Therefore, a catalog presented by the defendant was not considered sufficient evidence of genuine use as the defendant had failed to explain what number of copies had been distributed to German consumers since when and to whom exactly. Detailed information would have been necessary as the catalog was written in English, and the distribution and use of this catalog in Germany was not evident. It was also questionable whether goods reproduced in the catalog actually showed the trademark in question.

The defendant further claimed that it had presented its goods in showrooms in Germany. However, the Court found that the defendant had failed to explain what turnover had been achieved by presentations and assessments in such showrooms. Also, the defendant had not stated opening hours, targeted group of consumers or advertising actions for such showrooms.

Finally, a master agreement between the plaintiff and a Russian licensee was insufficient as evidence of use because this document could only be considered an internal document. The master agreement provided that goods

with different logos, including the challenged trademark, as well as goods without any logo should be delivered by the defendant to the licensee. The exact type, number and price of goods to be delivered were supposed to be stated in separate cargo lists. Therefore, the master agreement as such was not suitable to give any information as to the number of goods showing the challenged trademark that had actually been sold. The defendant had also failed to submit invoices.

This decision is in line with previous decisions regarding requirements of genuine use. What makes it interesting is that it comments on various examples of genuine use and can therefore be used as a valuable manual on how to and how not to present evidence of genuine use.

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The Trademark Reporter®

Vol. 105, No. 3

Contributing to Infringement: Intermediary Liability After *Tiffany v. eBay* and *Louis Vuitton v. Akanoc*

Michael Pantalony

Using Trademarks as Keywords: Empirical Evidence of Confusion

Ronald C. Goodstein, Gary J. Bamossy, Basil G. Englis, and Howard S. Hogan

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INDIA Recognition of Color Trademarks in India: John Deere's Yellow and Green

The Deere Group, commonly referred to as John Deere, is a US Fortune 500 company and a leading agricultural and construction equipment manufacturer in the world. The company's logo comprises a leaping deer and green and yellow color combination. The logo was the basis of a December 2014 suit seeking a permanent injunction restraining third parties against infringement and dilution of the company's registered trademarks, passing off of trade dress, unfair competition, rendition of accounts, delivery up and damages (*Deere & Co. & Anr. vs. S. Harcharan Singh & Anr.* CS(OS) No. 3760/2014 before the High Court of Delhi). Concurrently, an application was filed seeking a temporary injunction.

Tracing first use to 1905, John Deere established evidence that by 1956 internal guidelines had clearly defined the "color standards" for the use of the green and yellow combination on agricultural equipment. The company also declared that its first inroads into the Indian agricultural market were made in 1943 and

between then and now it had grown to become one of India's leading tractor brands.

In October 2014, John Deere became aware of the manufacture and sale of farm equipment, including tractors, harvesters and combines across India, under the trading name/mark SURINDERA, which bore a striking resemblance to John Deere's products and also incorporated use of its well-known logo and color combination. SURINDERA's green and yellow colors had been used in a manner very similar to John Deere's—the body of the vehicle had been painted green with the wheels and the seat painted yellow. The present suit was thus filed and injunctions sought.

Section 2(zb) of the Trade Marks Act, 1999 clearly defines a trademark to include a combination of colors provided such a combination is capable of distinguishing the goods of one person from those of others. However, not many judicial precedents exist on this point. In this instance, John Deere established that the

green and yellow combination was a distinctive and well-known feature of its mark on the back of Indian trademark registrations as well as very strong sales and publicity figures. It further proved a pan-India business network, a visible, local presence on the Internet and television and asserted that it was the largest exporter of tractors from India.

In the face of such weighty evidence of acquired distinctiveness, this case assumed significance for being one of the few where trademark rights in a color combination were expressly recognized by the court and misuse halted speedily through grant of a temporary injunction by way of interim relief.

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JORDAN New Drug and Pharmacy Law Ratified with Maximized Penalties

Jordan has recently approved some amendments to the Drug and Pharmacy Law of Jordan. The amendments have maximized the penalties of counterfeiting of medicines in Jordan by combining imprisonment and fines for counterfeiters and increasing the amount of the fines to ten-fold the value of the counterfeit products.

The amendments also granted the Food and Drug Administration the right to close down

any store, fitness gym, beauty spa or other establishment that is engaged in selling or trading in counterfeit or banned medicines or supplements in an attempt to decrease the volume of illegal trading and counterfeiting of drugs in the Kingdom.

The new amendments became effective as of May 18, 2015.

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UNITED KINGDOM Maier & Another v ASOS Plc & Another

On April 1, 2015, the English Court of Appeal (Lord Justices Kitchin, Underhill and Sales) handed down judgment on the appeals and cross appeals of three connected High Court judgments concerning the alleged infringement of Community Trade Mark (CTM) number 4580767 for the word ASSOS (the ASSOS CTM). The mark was owned and used by the claimants, which manufacture and retail high-end performance cycle wear (Roger Maier and Assos of Switzerland SA (together Assos) by virtue of the defendants' (ASOS plc and ASOS.com Limited (together Asos)) use of the sign ASSOS in relation to the online retail of fashion clothing and accessories. [\[2015\] EWCA Civ 220 \(01 April 2015\)](#)

At first instance, the High Court judge had limited the specification of the ASSOS CTM from, among other items, "clothing, footwear and headgear" in Class 25 to "specialist clothing for racing cyclists; jackets, t-shirts, polo shirts, track suit tops, track suit bottoms, casual shorts, caps" and revoked the remainder for non-use. In addition, the judge rejected Assos' claims of registered trademark infringement under Article 9(1)(b) and (c) CTM Regulation (CTMR) 207/2009 and did not find that any passing off had occurred.

On appeal, the Lords Justice agreed that the trial judge had overly limited the specification of the ASSOS CTM, although disagreed as to the appropriate revision. Ruling in the majority, Kitchin LJ (approved by Underhill LJ) found that the specification should be extended to cloth-

ing for "cyclists," rather than "racing cyclists" only. Dissenting, Sales LJ suggested that even with this revision, the specification had been overly restricted and the mark's use justified protection for a broader category of "casual wear" generally.

The Lords Justice unanimously agreed that the first instance finding of non-infringement should be overturned. They held that the trial judge had, in error, failed to consider the full scope of the specification (even when suitably limited) when considering both the "likelihood of confusion" (Section 9(1)(b) CTMR) and the impact on the mark's distinctive character (Section. 9(1)(c) CTMR) posed by the ASOS brand, and had instead incorrectly focused on the use made of the ASSOS mark.

In light of the finding of infringement, the Lords Justice then had to consider whether ASOS nevertheless had an "own name" defense under Article 12 CTMR, i.e., whether Asos had made use of its own name in accordance with honest practices in industrial or commercial matters.

Kitchin LJ and Underhill LJ found that the defense did apply as: (i) the ASOS name had been adopted in ignorance of the ASSOS brand and without the intention of trading off the repute of it; (ii) there was no evidence of any actual confusion between the goods and businesses of the parties; and (iii) once Asos did become aware of the ASSOS brand, it took steps to minimize the risk of confusion arising,

including deleting references to "cycling" from its product descriptions and withdrawing its Google keyword bid for the search term "AS-SOS" (initially placed to capture any misspelled searches for the ASOS brand).

In his dissenting judgment, Sales LJ stated that in his view, greater weight should be given to the rights of a CTM proprietor and the relevant public when considering the "honest practices" standard. He pointed to several factors in the CTMR and the authorities in support, in particular noting that the rights of a CTM proprietor to expand and develop its mark across the full scope of its specification (including those goods falling within the notional fair use of it) must be taken into account and whether or not the defendant has taken sufficient steps to avoid conflict with those rights. According to Sales LJ, Asos's failure to conduct proper clearance searches before adopting the ASOS brand did not satisfy the "honest practices" standard as, had it done so, it would have appreciated that "it ought to adopt a different sign for itself, so as not to trample on Assos's existing rights and legitimate interests."

It has been suggested that this case is likely to be the subject of a further appeal to the Supreme Court.

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UNITED STATES The Federal Circuit Strips the iPhone of Its Trade Dress Victory

While leaving the majority of the judgment unscathed, on May 18, 2015, the U.S. Court of Appeals for the Federal Circuit partially reversed a \$930 million judgment against Samsung, ruling that Apple's iPhone trade dress was not protectable. *Apple Inc. v. Samsung Elec. Co.*, No. 2015-1029 (Fed. Cir. May 18, 2015).

Apple had alleged that Samsung infringed and diluted the iPhone's registered icon trade dress and its unregistered trade dress, which purportedly covered such elements as "a rectangular product with four evenly rounded corners," and "a flat, clear surface covering the front of the product."

Applying Ninth Circuit precedent, the Federal Circuit analyzed the following Disc Golf factors to determine if Apple's unregistered trade dress was functional and therefore non-protectable: "(1) whether the design yields a utilitarian advantage, (2) whether alternative designs are available, (3) whether advertising touts the utilitarian advantages of the design, and (4) whether the particular design results from a comparatively simple or inexpensive method of manufacture."

Analyzing the first factor, the court found that the trade dress provided a utilitarian advantage, given Apple's testimony that it sought to create a design that was "easy to use," and that the trade dress "improved the quality [of the iPhone] in some respects." The court found further usability functions, such as rounded corners, which improved "pocketability," and the rectangular shape, which maximized the display area.

Looking to the second factor, the court found that while Apple cited numerous alternative designs, it failed to establish that such designs offered exactly the same features as its asserted trade dress.

Applying the remaining Disc Golf factors, the Federal Circuit found that Apple failed to establish that its iPhone advertisements did not tout the utilitarian aspects of the iPhone's trade dress when it promoted features such as tapping and scrolling functions on the touch screen. Additionally, Apple had asserted that because it had "experienced manufacturing challenges," the design "did not result from a 'comparatively simple or inexpensive method of manufacture.'" The

Federal Circuit, however, found those challenges to be related to durability issues and not trade dress design considerations.

Apple also failed to rebut Samsung's showing that certain elements of the registered trade dress were functional, such as the evidence that the registered icon designs promoted usability and communicated to the user that certain functionality would occur by touching them.

This decision shows the difficulties of protecting trade dress—and serves as a reminder to monitor advertising carefully to avoid touting useful aspects of trade dress.


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September 22	Trademark Protection for Nonprofits Workshop	Colorado Springs, Colorado, USA
September 28–October 9	TMA Roundtables: Aspects of Trademark Due Diligence in M&A Transactions	Various U.S. cities
October 13–October 15	Trademark Administrators and Practitioners Meeting	Alicante, Spain
October 19–30	US Roundtables: Cybercrime for the Trademark Practitioner-Data Security and Privacy Issues	Various U.S. cities
November 17–20	Leadership Meeting	Panamá City, Panamá
December 10–11	The Geographical Names Conference: Protecting and Enforcing Geographic Names, GIs, Trademarks and Domain Names	Rome, Italy

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