

AssociationNews

MEP Jürgen Creutzmann Visits INTA's New York Offices



On April 4, MEP Jürgen Creutzmann of Germany visited INTA's offices in New York to meet with Association volunteers and staff. This marked the first time that a Member of the European Parliament paid a visit to INTA headquarters. Association President Gregg Marrazzo (Estée Lauder Companies—USA) joined Tiffany Trunko (Pfizer—USA), INTA Executive Director Alan Drewsen and staff members Bruce MacPherson, Claudio DiGangi, Candice Li and Carla Schwartz in discussing with Mr. Creutzmann a range of topics, including the draft EU Customs Regulation, the European Observatory on Counterfeiting and Piracy, ACTA and ICANN issues. From left: DiGangi, Schwartz, Li, Marrazzo, Creutzmann, Drewsen, Trunko, MacPherson.

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U.S. Appeals Court Follows Association Brief in Keywords Case

In a highly-anticipated ruling on keyword advertising, on April 9, 2012, the U.S. Court of Appeals for the Fourth Circuit issued its opinion in *Rosetta Stone Ltd. v. Google, Inc.*, reversing the district court's grant of summary judgment to Google. In doing so, the appellate panel adopted arguments INTA made as amicus, citing legal errors by the lower court.

Rosetta Stone sued Google in 2009 over the search engine's sale of advertising space "keyed" to searches on the ROSETTA STONE trademark through its AdWords program, claiming direct and contributory trademark infringement and trademark dilution, among other claims. The maker of the popular language-learning software offered the district court anecdotal evidence that consumers were confused by the AdWords advertisements into believing that Rosetta Stone was behind ads that in fact were for counterfeit Rosetta Stone software or competitors' products.

Rosetta Stone also submitted survey evidence showing that consumers were confused, and pointed to internal Google studies acknowledging that consumers were confused about the source or sponsors of AdWords advertisements.

Despite this evidence, the district court rejected Rosetta Stone's claims and granted summary judgment to Google, holding that: (1) Google's keyword ad practices were protected by the "functionality" doctrine of trademark law, (2) Google could not be liable for dilution because it did not compete with Rosetta Stone and, because Rosetta Stone's mark became more well known during the period at issue, it couldn't show actual dilution, and (3) Rosetta Stone's anecdotal, survey, and documentary evidence of confusion was de minimis and could not support a finding of confusion at trial.

The appellate court reversed the lower court on each of these points.

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Welcome New Members

Feldman Gale, P.A., Philadelphia, Pennsylvania, USA

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GJG BRANDS, Tegucigalpa, Honduras

GMS Law Associates, Chennai, India

Graf & Pitkowitz Rechtsanwälte GmbH, Vienna, Austria

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The Ollila Law Group LLC, Lafayette, Colorado, USA

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Virtualaw LLC, Washington, DC, USA

Warner Music Group, New York, New York, USA

Welsh Flaxman & Gitler LLC, Alexandria, Virginia, USA

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U.S. Appeals Court Follows Association Brief in Keywords Case continued from page 1

INTA's amicus brief argued that the lower court misunderstood and misapplied the functionality doctrine in granting judgment for Google that because trademarks used in the AdWords program are "functional." INTA explained that the doctrine protects functional product design features, not the use of internal workings of a search engine.

The Court of Appeals agreed, saying "it is irrelevant whether Google's computer program functions better by use of Rosetta Stone's nonfunctional mark."

INTA also argued that the lower court erred in ruling for Google on the grounds that it did not use the ROSETTA STONE mark on its own products and that Rosetta Stone's brand awareness dramatically grew over the relevant timeframe.

U.S. trademark dilution law, INTA noted, applies even where the parties do not compete. INTA also pointed out that since the enactment of the U.S. Trademark Dilution Revision Act of 2006, the law does not require proof of actual harm, but rather only a likelihood of dilution.

The Fourth Circuit adopted both of INTA's arguments in reversing the lower court, holding that the statute does not require that the defendant use the mark on its products, but only "in commerce," nor that the plaintiff suffer actual economic loss or harm to reputation.

The appeals court also found error in the district court's treatment of the "fair use" exclusion to dilution. It said that the lower court in effect presumed that any non-trademark use was necessarily fair use, and instructed it to "reexamine the nominative fair use defense" on remand, keeping in mind that Google has the burden to prove it.

The court also held that the lower court's "truncated analysis" of the dilution question focused too much on Rosetta Stone's increase in brand awareness, and that it should consider "whichever additional factors might apply to inform its determination" on the issue.

The appeals court also instructed the lower court to consider when Google first used the ROSETTA STONE mark and whether that was before or after the mark became famous.

Lastly, the Fourth Circuit held that the district court erred in rejecting Rosetta Stone's evidence of confusion, holding that it had presented fact questions requiring a trial.

In sum, the Fourth Circuit corrected the various legal errors in the lower court's opinion that INTA cited, and gave the court plenty of direction for its consideration of the evidence on remand. But although Rosetta Stone won the appeal, whether it will be able to meet the tests set out by the appeals court remains to be seen.

INTA's brief was authored by International Amicus Committee Vice Chair David H. Bernstein (Debevoise & Plimpton—New York, New York), Kurt E. Anderson (Giordano, Halleran & Ciesla, P.C.—Red Bank, New Jersey) and A. Justin Ourso III (Jones Walker—Baton Rouge, Louisiana). Laurence K. Nodine (Ballard Spahr LLP—Atlanta, Georgia) and Pamela Kilby (Microsoft Corporation—Redmond, Washington) also worked on the brief, with support by other members of the U.S. Subcommittee of the International Amicus Committee. ■

INTA, China Customs Agree on New Cooperation Initiative

On April 19, INTA signed a Memorandum of Cooperation with the General Administration of China Customs (GACC). This event marks the second major milestone for INTA's government relations efforts in China, following a 2010 agreement with the State Administration of Industry and Commerce (SAIC).

INTA China Representative Chen Min and GACC officials formally signed the memorandum at GACC headquarters in Beijing after several months of negotiation. The document

reaffirms the information sharing and cooperative efforts between INTA and GACC to protect against trademark infringement activity as goods cross China's international borders. Under the agreement, INTA will assist GACC by educating customs officials and communicating the latest GACC policy and procedure to INTA members.

INTA and GACC have a long history of cooperation and this agreement further strengthens this important relationship. INTA officers meet

with GACC officials annually during delegation visits to Beijing and GACC frequently participates in INTA government roundtables and programs, including the 2010 Hong Kong Anticounterfeiting Conference.

INTA looks forward to building on this memorandum to further deepen its ties with GACC, and to continue to pursue similar agreements with other Chinese government organizations.

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Association News

INTA Delegation Meets with India's New Controller General of Patents, Designs & Trade Marks

Since the announcement in June 2011 of the resignation of P. H. Kurian as India's Controller General of Patents, Designs and Trade Marks, the trademark community has been awaiting the news of his successor. INTA was privileged to meet with the new Controller General, Chaitanya Prasad, soon after he assumed his post in mid-March. Mr. Prasad, like Mr. Kurian, is an Indian Administrative Services officer. Before this appointment, he was a Joint Secretary at the Ministry of Commerce and Industry, Department of Industrial Policy and Promotion. As a result, the Controller General position has been elevated to the Joint Secretary level.

Although this is his first exposure to intellectual property, Mr. Prasad says he has found the subject to be extremely interesting and is

developing a vision for the Controller General's Office that he and his team can work to realize. As a start, he is holding a series of stakeholders meetings across India for practitioners (the first was scheduled in the state of Maharashtra in early April). Communications with users will be enhanced through information cells at each of the five branch offices, which will serve as the main points of contact with practitioners. All grievances or suggestions that come through these cells will then be shared among the offices. Mr. Prasad is well aware of the tremendous backlog in trademark applications and is developing strategies to maximize the Office's resources to resolve the issue in anticipation of India's accession to the Madrid Protocol this September.

INTA used this opportunity to introduce Mr. Prasad to the work of the Association and outlined several ways that INTA might assist the Office. The delegation presented a number of documents, including INTA's Guidelines for Trademark Examination, the India report from INTA's trademark office benchmarking database project and the Board Resolution regarding well-known mark registries. Mr. Prasad subsequently indicated that he would appreciate INTA's input on such matters as improving Office procedures and the online filing system.

Simran Daryanani Zainulbhai
INTA India Representative, Mumbai, India



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VolunteerSpotlight



Jeff Kobulnick—unlike many trademark practitioners—knew he wanted to become a trademark lawyer while he was still shopping for prospective law schools. During a visit to Franklin Pierce Law Center (now University of New Hampshire School of Law), Jeff sat in on Professor Susan Richey's trademark class. The subject fascinated him, and he went on to attend that school and take that class.

Jeff began his involvement in INTA early on as well, competing in the Association's Saul

Lefkowitz Moot Court Competition—the only moot court competition focused on trademark law—as a second-year law student. After law school, his interest in INTA's Lefkowitz Committee blossomed. Since joining the committee in 2005, Jeff has participated on both the Competition Coordinating Subcommittee and the Problem and Bench Memo Subcommittee, and currently serves as chair of the latter. As a regular judge of the competition's Western Region oral arguments, he enjoys watching the students bring the committee's hypothetical case to life. While Jeff admits that juggling this extensive committee work with his regular work can be a challenge, it is a challenge that he welcomes, and one that nicely complements his day-to-day practice as a partner at Ezra Brutzkus Gubner LLP in Woodland Hills, California, USA.

His other passion is providing pro bono legal services. Jeff is a Los Angeles coordinator for Bet Tzedek Legal Services' Holocaust Survivors Justice Network, with which he has been active since 2008. In this role, he assists elderly, often impoverished, Holocaust survivors and their families in navigating

recent changes in German law, under which they may obtain reparation payments for work performed while in German-controlled ghettos. Jeff gathers the necessary facts and documents from his clients, who share their very emotional stories with him as he helps them to apply for these benefits. He calls his pro bono work the “most meaningful work in my legal career.” Both the State Bar of California and Bet Tzedek Legal Services have presented Jeff with distinguished service awards in recognition of his efforts. In addition, as leader of the Content Development Project Team of INTA's new Pro Bono Committee, Jeff is helping the Association expand its focus on pro bono services.

Jeff enjoys spending free time with his wife, Belinda, and their two-year-old twins, Adam and Sarah. He looks forward to exploring another of his favorite activities with them—his passion for travel—when they are a little older.

Stacey Berg Keller
Citigroup Inc., New York, New York, USA



Brian Winterfeldt entered the field of trademark law with a background in Art History and Latin American Art and Archaeology. In his undergraduate years, his focus was on Egyptology, and he studied with renowned professor Gay Robins at Emory University. Later, after he entered law school, an opportunity to work as a law clerk for Mary Denison, who was then in private practice and is now Deputy Commissioner for Trademark Operations at the USPTO, proved pivotal to his career. “As a mentor, Mary not only taught me the foundations of trademark practice, but also infused me with the energy and enthusiasm for trademarks that have

sustained me throughout my career.”

Today, Brian is a partner in the Washington, D.C. offices of Steptoe & Johnson LLP, where his practice involves most aspects of IP law. He has counseled clients on cutting-edge issues such as social media and Web 2.0, including strategies for brand promotion and protection in these spaces. Brian has been a member of INTA's Internet Committee for several years. In his opinion, the most serious issue concerning trademark infractions on the Internet is “understanding the new gTLD program and the steps brand owners must take to protect their valuable marks at the first and second levels (to the right and left of the dot).” He is pleased that the Internet Committee is “working with many leading brand owners to develop strategies for them to adapt their online enforcement efforts to encompass the expanding Internet, including monitoring applications in the program for infringement, selecting and inputting marks into the trademark clearinghouse, and understanding the new enforcement tools introduced in this program.”

Brian's advice for professionals new to the trademark field is: “If at all possible connect with a great mentor! Build a broad skill set to

start with, and get as much hands-on experience as possible. Also, start networking through INTA and other professional organizations as early as you can in your career! Be willing to volunteer your time—and keep both your professional and your volunteer commitments—as being both focused and reliable will allow you to develop an excellent reputation in the trademark community over time.” Brian's involvement in INTA is a perfect example of this last piece of advice in action. In 2011, he received a Volunteer Service Award, in recognition of his efforts on the Internet Committee.

In his spare time, Brian greatly enjoys kickboxing, running and weightlifting. He also loves to travel and learn more about the interesting cultures of the world. “I love art, particularly art from ancient cultures, and look for every excuse to explore ruins or museums on my travels.”

Rosemary Brkopic
Brandprotect, Mississauga, Ontario, Canada

Co-chair of the INTA Bulletin Association News Subcommittee

Features

The U.S. Trademark Registers: Supplemental vs. Principal

Daniel M. Gurfinkel

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The U.S. Trademark Act (Lanham Act) provides for two separate registers for the registration of trademarks with the U.S. Patent and Trademark office (USPTO). Most practitioners and trademark holders are largely familiar with the Principal Register; yet, many have never heard of the secondary register, known as the Supplemental Register. Since the enactment of the law in 1946, the Supplemental Register (Lanham Act Sections 23-28, 15 U.S.C. §§ 1091-1096) has afforded a place to register a mark that is inherently descriptive but that can potentially identify goods or services with a source. The names of new magazines, which typically are descriptive of the contents of the magazine, are a good example of marks that are registered on the Supplemental Register. The anticipation is that when the magazine becomes better known, through circulation, the mark may be registered on the Principal Register on the basis of acquired distinctiveness.

Differences Between the Two U.S. Trademark Registers

The Principal Register is the site for the registration of marks that are distinctive, by virtue of either their unique characteristics or their long and exclusive use. Registration on the Principal Register provides the registrant with, among other things, the presumption of the validity of the mark, prima facie evidence of ownership of the mark and acknowledgment of its continuous and exclusive use. Further, there is the possibility, after five years of continuous, uninterrupted use from the date of registration, of achieving incontestable status (limiting the grounds of third-party attacks to cancel the mark). An application for registration on the Principal Register must provide, to the satisfaction of the USPTO, proof that the mark meets the basic requirements for trade-

mark registration and must survive publication and an opposition period.

The Supplemental Register is an enigma to most. Often it is first heard about and understood when, during the prosecution of an application for registration on the Principal Register, the USPTO examining attorney issues an office action refusing registration on the ground that the mark is “merely descriptive.” If the examining attorney believes that the mark has the potential to identify the source of the goods or services with the applicant, he or she might offer to allow the applicant to amend the application from the Principal Register to the Supplemental Register.

Comparison of U.S. Trademark Registers

	Principal	Supplemental
Distinctiveness required?	Yes	No
Distinctive marks eligible for registration?	Yes	No
Gives prima facie evidence of ownership and use?	Yes	No
Can achieve incontestability?	Yes	No
Published for opposition?	Yes	No
Based on intent to use?	Yes	No
Based on foreign registration?	Yes	Yes
Can use indicia of registration—®?	Yes	Yes
Bar to subsequent applications for registration?	Yes	Yes

Registration on the Supplemental Register is limited to marks that are in use (as opposed to marks that are applied for on the basis of intent to use) in the United States or its territories and those based on an issued foreign registration in the country of origin of the applicant. An intent-to-use application can be amended to the Supplemental Register only after an allegation of use is filed and accepted. An examining attorney cannot suspend such an application to await the filing of the allegation of use; thus, if it appears likely that the application will be refused on descriptiveness grounds, waiting until use of the mark is imminent is advisable. The filing of an allegation of use in connection with an intent-to-use application that is amended to the Supplemental Register results in a change of the priority date of the application; that is, the USPTO will consider the filing date of the amendment to allege use to be the effective filing date of the application (37 C.F.R. § 2.75(b)). Consequent-

ly, the examining attorney must conduct a new search of USPTO records for conflicting marks. While this may be the only possible course of action for an applicant, consideration should be given to such a move, as there may be third-party applications that have been filed in the interim between the original filing and the filing of the amendment to allege use and that will therefore have priority over the amended-to-Supplemental Register application.

Typically, applications arrive on the Supplemental Register through amendment of an application filed on the Principal Register. An applicant that believes its mark is descriptive but may become distinctive through use may, however, file an application directly on the Supplemental Register.

The Supplemental Register is only for marks that are descriptive in nature. Thus, if a mark is distinctive, the mark cannot be registered on the Supplemental Register; therefore, if the application is being prosecuted on the Supplemental Register and is found to be distinctive, the application must be amended to the Principal Register or the mark will be refused registration (see TMEP § 815.01).

Key Benefits That Attach to Marks on the Supplemental Register

The Supplemental Register offers some important benefits: the mark will appear in trademark searches and that the registrant can use the ® symbol, and other indicia of registration, in connection with the mark. Further, the registration number of a Supplemental registration is consecutive with marks on the Principal Register, such that the particular register cannot be determined from the registration number alone. In addition, having a mark registered on the Supplemental Register can, through treaty, assist in achieving registration and/or give priority to the application for the mark in some foreign countries and regions. Further, the registration on the Supplemental Register may be used to prove exclusive use of a mark for a five year period, one of the aspects of proving

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distinctiveness for registration on the Principal Register.

Vulnerability of a Mark on the Supplemental Register

A mark on the Supplemental Register can never achieve incontestability and a request for such (which on the Principal Register is typically made between the fifth and sixth year from registration along with the declaration showing use) will be rejected by the USPTO. As such, should a third party be able to show earlier use of a confusingly similar mark, or show any cause proving superior rights (or any other cause for cancellation), it can move to cancel a registration on the Supplemental Register at any time during the life of such registration.

Subsequent Registration on Principal Register

Practitioners often discuss the amendment or the moving of a registration on the Supplemental Register to the Principal Register. There is in fact no such procedure. The owner of a registration on the Supplemental Register must file a new application for the mark to secure registration on the Principal Register. In the new application the registrant may note that it is the owner of a registration for the mark on the Supplemental Register. Further, the registration of a mark on the Supplemental Register does not constitute an admission that the mark has not acquired distinctiveness (15 U.S.C. § 1096), jeopardizing subsequent registration on the Principal Register or challenge of an infringer.

While the continuous use of the mark for a period of at least five years is considered as some evidence of acquired distinctiveness, it is often not sufficient to overcome the descriptiveness deficiency of a mark. Oftentimes, the examining attorney will request

more proof of acquired distinctiveness, such as evidence of notoriety, extensive advertisement of the mark, and declarations from third parties showing that the mark has become known and associated with the goods or services of the applicant/registrant.

In practice, as the five year period of use to show distinctiveness coincides with the time period during which the registration on the Supplemental Register must be maintained (between the fifth and sixth year from registration), registrants usually will file the necessary use (Section 8) declaration and then concurrently file a new application on the Principal Register. This allows the owner to maintain the Supplemental Register registration of its mark while it applies for registration on the Principal Register. If registration on the Principal Register is achieved, the Supplemental Register registration may then be allowed to lapse. Lapse naturally occurs on the tenth anniversary of registration when a renewal declaration is not filed. If closure is desired more rapidly, a request for an express abandonment can be filed with the USPTO requesting that the registration be abandoned. If the USPTO is not convinced that the mark has become distinctive, and therefore does not issue a registration on the Principal Register, the Supplemental Register registration continues to protect the registrant.

Strategy Regarding Nonpublication of Supplemental Register Marks

Marks applied for (or moved to) the Supplemental Register are not published for opposition prior to registration; once allowed, such registrations issue in due course without publication. If a registration must be obtained quickly or stealthily, an applicant could directly file an application for a mark (not otherwise eligible for registration on the Principal Register) on the Supplemental Register and surprise the

market with a registration of its mark without publication.

Benefits from Registration on the Supplemental Register

To summarize, the Supplemental Register offers the following advantages:

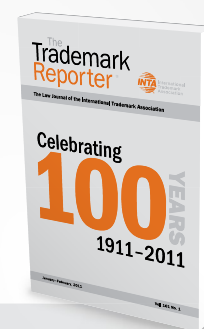
- Is a secondary option for registering marks that have the potential to be distinctive and act as source indicators
- Creates a first registration useful for securing some counterpart foreign registrations and priority there
- Permits the use of the indicia of registration, including the registration symbol ® and such phrases as "Reg. U.S. Pat. and T.M. Off."
- Provides notice to those conducting clearance searches
- Serves as a bar to registration of subsequent confusingly similar marks
- Is a means of protecting a mark while distinctiveness is acquired

Even though the Supplemental Register has been available for more than 60 years, its importance as a means of securing registration, and thereby a measure of protection, for marks having the potential to serve as source indicators often is not well understood. Brand owners and their counsel should be aware of this option, the steps that must be taken to register and the work that may subsequently be done to help advance the mark to the Principal Register. In this way a registration that might not otherwise be possible on account of a mark's inherently descriptive nature can be secured and held before, during and after the mark acquires distinctiveness.

For more information, visit www.inta.org/TrademarkBasics/FactSheets/Pages/Principalvs-SupplementalRegister.aspx

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Contact the Managing Editor at tmr@inta.org or visit www.inta.org/tmr

AZERBAIJAN Improvements to Trademark Prosecution System

On February 2, 2012, the Ministry of Taxes of the Republic of Azerbaijan created the Center for Examination of Industrial Property Objects (AZPATENT LLC). AZPATENT was established by the State Committee on Standardization, Metrology and Patents, the governmental agency responsible for trademark and patent registration matters, to assume the Committee's responsibilities on prosecution matters.

AZPATENT was created as a result of cooperation between the State Committee on Standardization, Metrology and Patents and the Korean Ministry of Foreign Affairs and Trade. On October 11, 2011, the Ministry and the Committee signed a grant agreement on Automation of the Intellectual Property Man-

agement System in Azerbaijan. The agreement envisions the establishment of a computerized system allowing the automation of administrative processes related to the application, examination, maintenance and registration of trademarks and patents, as well as the establishment of a national information database of industrial property objects and the formation of the National Digital Library of Intellectual Property. The project is funded by the Korean International Cooperation System.

The automation of the prosecution system should allow applicants and trademark owners to review trademark application information online, order clearance searches via the Internet and keep track of trademarks filed for

registration. All paper management systems should become electronic. The parties' intention is that the national system will be similar to the Korean "KIPOnet" system.

The hope is that the automated Intellectual Property Management System will make trademark search and registration more efficient. It is expected that the system will be operative as of July 1, 2012.

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TAIWAN Amendment to Trademark Act Will Come into Effect July 1

Following promulgation of the amendment to the Trademark Act on June 29, 2011 (as reported in INTA Bulletin Vol. 66, No. 14, August 1, 2011, the Executive Yuan announced on March 26 that the new Act will come into effect on July 1, 2012.

The newly amended Act extends protection to more nontraditional marks, such as motion and hologram marks; recognizes online trade-

mark use; and accepts priority rights based on exhibition. Further, a letter of consent is no longer guaranteed to prevent citation of conflicting prior rights, and proof of use of a trademark will be required to support a cancellation action based on a prior trademark registration. In addition, provisions have been added to enhance protection against trademark infringement and to strengthen enforcement of border control measures.

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Law&Practice

PORTUGAL Specialized Intellectual Property Court Now in Operation

On March 30, 2012, an Intellectual Property Court began operating in Portugal, in accordance with Ordinance No. 84/2012 of March 29, 2012.

The Intellectual Property Court, which is located in Lisbon, is competent to handle actions concerning industrial property, copyright and related rights and appeals against decisions of the Portuguese Patent and Trademark Office (INPI). The Court will also handle actions concerning domain names, appeals against decisions of the Portuguese NIC Authority (FCCN), actions regarding company names, appeals against decisions of the National Register of Companies (RNPC) regarding company

names, actions concerning acts of unfair competition in the field of industrial property and interim measures for obtaining and preserving evidence, as well as providing information on the protection of intellectual property rights, as previously established by Law 46/2011 of June 24, 2011.

The Intellectual Property Court will also act as a Community Trade Mark Court and a Community Design Court in the Portuguese territory.

As provided in Decree-Law No. 67/2012 of March 20, 2012, the Intellectual Property Court will be handling cases submitted to it

on or after March 30, 2012. The jurisdiction of existing courts (including the Commercial Court of Lisbon and Vila Nova de Gaia) will be maintained for pending proceedings.

The government has determined that, for the time being, the Intellectual Property Court should include only one chamber.

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UNITED STATES Depends on What Your Definition of “THE” Is...

The Trademark Trial and Appeal Board (TTAB) recently affirmed the refusal of the application for registration of the mark THE MUNICH & Design (shown) for failure to disclaim the term MUNICH apart from the mark as a whole. *In re Geskes*, Serial No. 77911173 (T.T.A.B. Feb. 9, 2012) (not precedential).



The examining attorney maintained that the requested disclaimer was required because the term was geographically descriptive of the identified services, which included “advertising; forestry management services; insurance and consulting services; medical and veterinary services, and hygienic and beauty care for human beings.” The applicant, Christoph Geskes, admitted that the services would originate in Munich, Germany. The examining attorney took the position that the term MUNICH was primarily geographically descriptive

of the services because (1) Munich is a well-known city, (2) the applicant’s services would originate there and (3) consumers were likely to make a service-place association between the mark and the city.

Rather than dispute this finding, Geskes argued that the combination of THE and MUNICH resulted in an incongruity. Specifically, he contended that “THE MUNICH is incongruous because in common usage the word the is a definite article that is not used before the names of cities.” The applicant analogized to prior cases in which two or more descriptive terms were combined in an incongruous fashion to create a unitary mark in which a disclaimer was not necessary (e.g., SNO-RAKE, URBAN SAFARI, FRANKWURST).

The TTAB concluded, however, that the definite article THE had no inherent source-indicating significance and that combining it with MU-

NICH did not create an incongruous term. Specifically, the Board found that the addition of THE (even in an usual or grammatically incorrect manner) to an otherwise geographically descriptive term like MUNICH did not change the mark into a nondescriptive term whose meaning would require a leap of imagination to decipher. The TTAB therefore affirmed the refusal to register based on the requirement for a disclaimer of MUNICH.

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UNITED STATES Misstatement of First Use Date Is Not Fraud

In the latest Trademark Trial and Appeal Board (TTAB) case addressing a claim of fraud, the TTAB held that a false claim of a first use date was not material to an application. *Bio-One, Inc. v. A.L.E.G., Inc.*, Cancellation No. 92052195 (T.T.A.B. Mar. 8, 2012) (non-precedential).

Bio-One filed a petition to cancel the trademark registration for BIO1ONE owned by A.L.E.G., based on a claim that the first use date in the application was fraudulent and that the mark was confusingly similar to a mark in which Bio-One had superior rights. Regarding the fraud claim, Bio-One alleged that the BIO1ONE registration was “riddled with fraud” because A.L.E.G.’s original ap-

plication stated that the date of first use was 1988. After a cease and desist letter from Bio-One, A.L.E.G. amended the claimed date of first use to 2004.

The TTAB held that a false claim in a use date is not material to the validity of the application or the resulting registration so long as the mark was in use in commerce at the time the application was filed (if the application was based on use in commerce) or at the time the Statement of Use was filed (if the application was based on intent to use). The petition on the ground of fraud was dismissed, as Bio-One failed to prove A.L.E.G. did not make use of its mark before the filing date of the application. Bio-One did prevail

on its likelihood-of-confusion argument for reasons wholly unrelated to the fraud claim.

U.S. trademark owners can rest assured that the TTAB does not appear to be encouraging a return to the days of rampant opposition and cancellation filings on the basis of fraud.

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UNITED STATES COLOMBIANO COFFEE HOUSE Denied Registration Based on Certification Mark COLOMBIAN for Coffee

In a precedential opinion, the Trademark Trial and Appeal Board (TTAB) refused registration for the mark COLOMBIANO COFFEE HOUSE. In re Accelerate s.a.l., 101 U.S.P.Q.2d 2047 (T.T.A.B. 2012).

Applicant Accelerate s.a.l. filed for the mark COLOMBIANO COFFEE HOUSE (in standard character form) for use in connection with “providing food and drink.” The examining attorney denied registration on the grounds that the mark was likely to be confused with the prior-registered mark COLOMBIAN, covering coffee, and that the mark was merely descriptive.

On the issue of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), the TTAB first pointed out that it made no difference that the cited registration was for a certification mark. As to the similarity of the marks, the TTAB found that consumers understood the term Colombiano as the Spanish equivalent of the English term “Colombian.” Further, even if consumers were unfamiliar with the direct translation, the visual and aural identity of the

terms was so similar that consumers would conclude that they had similar meanings.

As to similarity of goods and services, the TTAB followed the case law as precedent in the context of food items and restaurant services which require a showing of “something more” than just that similar or identical marks are used for food products and for restaurant services. *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234 (C.C.P.A. 1982). The “something more” evidence consisted of the applicant’s website, which indicated that it was in the business of coffee house services, as well as evidence of third-party registrations covering both restaurant or café services and coffee beverages. Thus, the TTAB found that the applicant’s services and Colombian coffee were related, which in turn favored a finding of likelihood of confusion.

As to the refusal based on descriptiveness under Section 2(e)(1) of the Trademark Act, the TTAB reviewed the evidence of record and determined that consumers encountering the applicant’s mark in connection

with the recited services would immediately understand the term COLOMBIANO to be a particular type of coffee served in a coffee house and having certain qualities and characteristics associated with authentic Colombian coffee. It was noted that the examining attorney’s refusal to register was based on Section 2(e)(1), even though refusal based on geographical descriptiveness under Section 2(e)(2)) or geographical deceptive misdescriptiveness under Section 2(e)(3) was conceivable.

In conclusion, the TTAB affirmed the refusal to register the applicant’s mark.

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EUROPEAN UNION Day, Hour and Minute: What Counts for Priority Assessment?

The Court of Justice of the European Union (CJEU) has confirmed that the date of filing of a Community trade mark (CTM) application means only the day of filing and not the hour and minute relating thereto. The CJEU further held that European Union law bars consideration of the hour and minute of filing of a CTM application in assessing whether that CTM had priority over a national trademark, even if the national law governing that national trademark considered the hours and minute to be relevant in that regard. *Génesis Seguros Generales, Sociedad Anónima de Seguros y Reaseguros v. Boys Toys SA et al.*, Case C-190/10 (CJEU Mar. 22, 2012).

On December 12, 2003, at 11:52 am, Génesis electronically filed a CTM application for RIZO in Classes 16, 28, 35 and 36; on the same day, at 12:13 pm, Génesis filed a CTM application for RIZO, EL ERIZO in Classes 16, 35 and 36. At 5:45 pm that day, Pool Angel Tomas SL filed a national trademark application for RIZO'S in Class 28 at the Spanish Trademark Office. Génesis filed an opposition against the

applied-for Spanish trademark on the basis of its two CTM applications.

The Spanish Trademark Office rejected the opposition, holding that the date of filing of the CTM applications was the day when the applications were completed at OHIM, namely January 7, 2004. Génesis appealed, but the High Court of Justice, Madrid, confirmed the decision. Génesis then went before the Tribunal Supremo and challenged the Court's ruling. It contended that the date of filing of the CTM applications was the date of their transmission to and receipt by OHIM, namely December 12, 2003.

The Tribunal decided to stay the proceeding and asked for a preliminary ruling of the CJEU on whether Article 27 of the Community Trade Mark Regulation (Council Regulation (EC) No. 40/94, codified at Council Regulation No. 207/2009) enabled it to take into account not only the day but also the hour and minute of filing of a CTM application for the purpose of establishing temporal priority over a national

trademark application filed on the same day where the national legislation governing the national trademark considered the hour and minute of filing as relevant.

The decision of the CJEU shows that the European harmonization of trademark law is still encountering difficulties as a result of clashes with national rules. It also leaves unresolved how to resolve the conflict and priority issues between two CTMs or between one national mark and one CTM filed on the same day. If the hour and minute cannot be considered, the trademark rights might have to coexist, as is the practice in some member states of the EU.

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