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141st Annual Meeting, Boston



# daily news

Wednesday May 22, 2019

## Practicing What You Preach

Corporate social responsibility (CSR) has become an important issue for brands, but it's vital to back up your good words with good actions, as Rory O'Neill reports.

Climate change has the potential to be the defining social and political issue of our era. As calls increase for governments to declare a climate emergency, there has never been more scrutiny on what decision makers, whether in the political or corporate sphere, are doing to tackle the problem.

It is little surprise, then, that brands are increasingly attempting to define themselves as "green" in an effort to make it known that they are part of the solution, rather than the problem.

Companies that exaggerate or fail to live up to their own claims,

however, do so at their own peril, and often at significant risk to their brand. This was the warning from the panel at yesterday's session **CT03 Brand Protection and the Intersection of Trademarks, Advertising, and Corporate Social Responsibility**, which discussed the branding implications of corporate social responsibility (CSR).

As Gare Smith, Partner, Corporate Social Responsibility Practice, Foley Hoag (USA), noted: "People have very different ideas of what CSR means." He pointed to a useful definition from The



Natasha Reed highlights "green trademarks."

John F. Kennedy School of Government at Harvard University (USA): "CSR encompasses not only what companies do with their profits, but also how they make them."

The increased focus on CSR, both from consumers and in the media, has coincided with the filing of so-called "green trademarks," as moderator Natasha Reed, Counsel, Foley Hoag

LLP (USA), described them. Companies may choose a green trademark to define not just a single product line as eco-friendly, but possibly their whole brand identity.

Failure to get it right, however, can cause reputational damage, Ms. Reed said. Panelists highlighted examples of brands that had faced negative publicity after their

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## Grand Finale

Join us at the Museum of Science, Boston for a night of fun—and for your last chance to network during the 2019 Annual Meeting.

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## How IP Offices Use Artificial Intelligence

While it's still a novelty, some intellectual property (IP) offices have begun to use artificial intelligence for a range of purposes related to trademark applications, examinations, and analysis, as Peter Scott reports.

Artificial intelligence (AI) has become a source of intrigue, and its impact on society much debated. While intellectual property offices around the world are wrestling with how to handle AI-related, or even AI-created, intellectual property (IP), many are beginning to use the technology to facilitate their own work.

Just last month, the World Intellectual Property Organization (WIPO) announced the launch of a new image-search technology powered by AI. It will be implemented through 45 trademark offices worldwide (covering almost 38 million marks) as part of WIPO's Global Brand Database. Unlike

previous iterations of AI-powered image search, which mainly rely on analysis of shape or color to determine similarity, the new tool is able to identify combinations of concepts to do the same.

Announcing the new initiative, WIPO Director

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## Practicing What You Preach(continued)

← 1 environmental claims were found to be overstated.

“Green trademarks have gotten intense scrutiny from the Federal Trade Commission (FTC), the [U.S.] Patent and Trademark Office, consumers, and competitors for greenwashing,” Ms. Reed said.

Greenwashing is the practice of making unsubstantiated or even misleading claims about a product or brand’s stance on environmental sustainability issues.

“People don’t like to be hoodwinked,” said Mr. Smith.

So what are the standards that brands must follow in order to navigate the challenges of CSR-focused branding? To this end, Lesley Fair, Senior Attorney, Bureau of Consumer Protection, Federal Trade Commission



(L. to R.) Gare Smith, Lesley Fair, Mary Carragher, and Lena C. Saltos

(USA), said that brand owners need to be rigorous in the evidence they provide when making claims about the social and environmental benefits of their products.

Speaking in her personal capacity, Ms. Fair said that companies would do well to adhere to the FTC’s regulations on false and deceptive advertising. These require environmental claims in advertising to be demonstrably true and backed up by science.

It is not enough, Ms. Fair said, to mask claims in ambiguous language such as “earth-friendly,” to obscure a lack of objective evidence.

“It is a big mistake for companies to think [that] if they don’t have science,” they can just use ‘fluffy terms,’ she added. “That’s not just puffery; it’s a lawsuit waiting to happen.”

Mary Carragher, Chief Counsel, Global Marketing and Media at Mondelēz International (USA), echoed the point, noting that deceptive advertising is not just a marketing concern but, in the United States at least, can open companies up to liability at both federal and state levels.

“  
CSR encompasses not only what companies do with their profits, but also how they make them.”

Gare Smith

Even if such conduct doesn’t result in a lawsuit, “it can still end up in the court of public opinion,” Ms. Reed pointed out, and that can be just as damaging to a brand.

### Cultural Appropriation

Of course, CSR encompasses much more than just environmental concerns. Brands have to be conscious of the wider impact of all of their actions.

Lena Saltos, Associate General Counsel, Global Director of Intellectual Property at Urban Outfitters, Inc. (USA), referenced the practice of “cultural appropriation,”

whereby a brand is perceived to have exploited a community’s cultural assets or knowledge, typically that of an indigenous people or minority group.

As Ms. Saltos noted, these scandals “often play out in the media,” causing significant harm to a brand’s image.

How can these pitfalls be avoided? The obvious answer, of course, is simply not to engage in cultural appropriation. But that may be easier said than done. Ms. Saltos offered some practical advice to help prevent such missteps.

“Luxury and fashion brands frequently get into trouble in this area, especially when they overlook the importance of having both CSR and IP professionals in the same room as the creative executives, product developers, designers, and marketers,” she said.

“They also often overlook the need to clear new products and ads not just from a legal perspective, but also from a general standards perspective,” she added.

At Urban Outfitters, Ms. Saltos said, IP and legal professionals work as part of a “cross-functional” approach to ensure consistency in the company’s CSR statements and protect the brand.

Driving home the point, Ms. Reed reiterated the best practice of having “everyone in the room before a new product or ad launch, including IP counsel and executives who can vet communications with an eye on standards and practices.” ●

### #LoganLobster

Logan Lobster, the 2019 Annual Meeting’s mascot, had fun in Boston! Where in the world will Logan be next (Singapore?)?



### Take The Unreal Challenge!



Thank you to the 193 Annual Meeting registrants who have already signed up for the Unreal Challenge!

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# Exploring Alternative Realities

New technology is enabling consumers to experience the world around them differently, with implications for brands and intellectual property professionals. Sarah Morgan reports

From the film *Blade Runner* that highlights a future where advertising is built into the landscape, to the book *Buy Jupiter and Other Stories*, in which aliens purchase the planet Jupiter for use as a giant billboard, the sci-fi genre has imagined a multitude of scenarios for advertising and branding.

We're still some time away from seeing these extreme forms of advertising become a reality. But augmented reality (AR) and virtual reality (VR) technologies are surging forward and taking branding along for the ride. The future is now.

Speaking yesterday during **CT02 Reality Check: Adapting Brand Strategies for AR and VR**, Matt Stratton, Associate General Counsel, IP at Snap Inc. (USA), explained that AR, where digital elements are blended into the real world, is well-used already across its Snapchat platform and others.

"AR is a new form of user-generated content. It's another way of visual communication; we're progressing from texts, photos, and videos to [using] AR within photos and videos," he said.

Four years ago, Snapchat launched AR lenses, which apply AR to your face (think filters with bunny ears and multi-colored hair) and world lenses, which project out into your field of view (think of a mini-cartoon version of yourself dancing across a table). Snapchat also offers Lens Studio, a free software that allows anybody to create AR lenses.

"It's not just something for big companies," Mr. Stratton said. "Normal everyday people can make AR."

He showed session attendees how a poster for the film *The Lion King* could be transformed into an AR experience. "A Snapchat lens can teach it to recognize the poster and allow for a 3D experience," he explained.



(L. to R.) Kimberly Culp, Matt Stratton, and Deborah Davis

Brands are already interacting with the technology: HBO (USA) recently sponsored a *Game of Thrones*-themed lens. "They're advertising, but they're fun," commented Mr. Stratton.

"Brands can make branded user-generated content that ideally has a viral nature to it and will get the word out," said Mr. Stratton.

AR technology also allows users to create lenses that interact with public spaces. For example, Snap has created a model of the Eiffel Tower, allowing users to interact with its structure.

This is where the technology runs into difficulties, inviting questions about brands and their relationships with public and private spaces, and who controls the digital space around the structures viewed through an AR lens.

### A Consumer Experience

While AR presents an opportunity to target consumers with individualized ads, Deborah Davis, Senior Advertising Counsel at Electronic Arts Inc. (USA), warned that targeting consumers too specifically may cause problems.

"If you over-target, you lose the opportunity to create a national conversation around your brand and do something unique," she said.

She pointed out that brands should keep in mind the concept of accessibility when considering whether to use AR.

"Many consumers can't see well or hear well. There's a whole community of consumers that may be underserved by a brand [that hyper-targets consumers]," she said.

VR, which creates simulated environments, is a totally different tool. Ms. Davis noted that to use this technology effectively, brands need to "invest in building an entire consumer experience," which takes a lot of computing power, time, and development costs.

**“As consumers become more accustomed to depending on AR as a source of information, there are more opportunities to disrupt that process.”**

Matt Stratton

"You may not be able to do as much targeted marketing [as you could with AR]," she said. "It's going to need to be a little more uniform."

The technology can be used as a way to extend your product line, she said, citing The Walt Disney Company's

work with entertainment company The VOID to create VR experiences, where participants walk through a *Star Wars*-themed environment (while, in reality, they're walking through a series of empty rooms).

Looking to the future, Kimberly Culp, Director at Carr McClellan (USA), explained that VR activities could lead to litigation over sensory experiences in this space.

Trademarks are being granted for sensory experiences, such as a particular scent. If a trademarked scent were to become associated with the smell of a virtual experience, and another brand then used the same scent in a different VR experience, it could lead to litigation, she said.

Litigation is also likely to arrive in the AR context, panelists said, especially in the context of so-called "conquest ads", where brands deploy their own advertising over or next to their competitor's advertising.

Mr. Stratton said: "As consumers become more accustomed to depending on AR as a source of information, there are more opportunities to disrupt that process."

For example, an app could direct you to "replace" one brand's ad on the street with a rival brand's ad in the AR space to win a prize or discount.

"Is there a claim? In my view, it depends on how consumers are doing this. Is it genuinely confusing anybody? I don't think anybody really is, but on brand tarnishment maybe there's a claim," he said.

Despite the complexity of the issues, Mr. Stratton is optimistic that a traditional trademark analysis for infringement and dilution will be used when such issues arise in the AR and VR context—as they inevitably will, he said. ●

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## How IP Offices Use Artificial Intelligence (continued)

← 1 General Francis Gurry called on IP offices not currently participating to consider joining, underlining that “a larger data pool means better AI results.”

Communication plus collaboration between IP offices is likely to be crucial for AI-based solutions to be implemented effectively, says Christophe Mazenc, Director of the Global Databases Division at WIPO. He says current collaborations with national offices provide WIPO with “diverse data” that is compiled, prepared, and cleaned for building AI tools.

“If these tools bring some benefits, they can be shared with collaborating offices to help improve their operations,” he explains. “We are also envisaging transferring knowledge about building, maintaining, and using AI tools.”

As well as trademark search, WIPO uses AI to enhance other areas of its work, says Mr. Mazenc. The Madrid System has been using machine translation to speed up the work of translators for goods and services texts, reducing translation outsourcing costs. As the AI technology is open source, WIPO can build on and customize it to fit the organization’s needs, Mr. Mazenc says.

Trademark administration procedures involve a number of repetitive tasks. With time, Mr. Mazenc points out, such tasks will become more efficient due to advances in AI technology—with more reliance on the technology than on humans.

However, those who worry that AI will supplant humans need not be too alarmed for now, at least when it comes to IP. “AI has benefits, but it’s not perfect,” Mr. Mazenc suggests.



AI outputs still need to be validated by humans. In addition, people will continue to have an important role to play to ensure quality control. AI tools often suffer from a “black box” effect that leads to difficulties in their quality assessment and in their adoption by end-users, he adds.

### Around the World

While WIPO has certainly been a pioneer in using AI for trademark work, many national offices have also begun using, or exploring the use of, the technology.

In January, the Trademark Office of China’s National Institute of Intellectual Property (CNIPA) announced the launch of a new smart device search function. In line with a national reform goal to improve the efficiency and quality of trademark examination, and reflecting a continuing acceleration in the number of trademark applications in the country, the new tool uses AI for image searches.

In a statement, CNIPA said that, this has increased productivity and decreased the number of trademarks that an application needs to be checked against from the tens of thousands to around 5,000. In addition, CNIPA said it is looking to extend its use of AI—and to become a standard setter in the field, enabling the Office to increase its voice in international cooperation.

While China’s solution was developed in partnership between CNIPA and Beijing Huazhi Jingwei Company (China), Shanghai Yitu Company (China), and Tencent (China), IP offices in other countries

are looking to off-the-shelf solutions.

The Norwegian Industrial Property Office (NIPO) uses basic AI for its trademark search function, and currently uses “lower degree AI” in its digital case management system, according to Jens Petter Sollie, IPR Systems Manager at NIPO. This lower-degree AI involves pattern recognition to assist with hit sorting for trademark comparison. “It gives value,” Mr. Sollie says, “but just as a complement.”

However, NIPO is currently exploring the next generation of AI-based software, and hopes to upgrade soon. NIPO uses software called Acepto, produced by Sword Group (United Kingdom); it is also used by several IP offices worldwide (including in Croatia, New Zealand, and South Africa). The latest version of the software employs image search and classification using “neural network AI,” which is trained on previous examiner activity to enable more accurate results, according to Mr. Sollie.

He says that ultimately, the biggest beneficiaries will be users of the system; in time, they will be able to make free searches, which in turn should improve the quality of filings. The aim is to roll out the software to cover trademarks initially, and then adapt it for designs and patents too.

“In time AI will improve the quality of decisions, both by enhancing the capacity of the Office and the quality of search results by officer,” Mr. Sollie says, “but perhaps most importantly, [it will improve] the quality of filings by the customer and their understanding of quality levels.”

In Chile, the Instituto Nacional de Propiedad Industrial (INAPI) has been using AI in trademark examinations for over a year now. The technology allows INAPI to compare image trademarks with “incredible accuracy,” finding all relevant images within its database that contain some kind of similarity, explains Lorena Mansilla Inostroza, INAPI’s Acting Deputy Director of Trademarks, Geographical Indications and Appellations of Origin.

The tool was developed in conjunction with the University of Chile Physics and Mathematical Sciences Faculty, which owns the associated IP rights. Ms. Mansilla Inostroza explains that although INAPI has started rolling out the technology, it is still being tested and refined. Once it is fully developed, “I believe its possibilities will be very broad,” she suggests.

What are the benefits? Among the many advantages, Ms. Mansilla Inostroza says AI allows INAPI to improve processing times and increase the accuracy of searches.

“Specifically regarding image comparison, the great advantage is that it makes it an objective, science-based exercise, diminishing our margin of error and giving us a solid ground for refusal in certain cases. It also makes the process quick and reliable,” she says.

Therefore, Ms. Mansilla Inostroza adds, “Our expectations for the future are very high.” INAPI hopes to use AI in other stages of the trademark examination process, particularly within formal examination of goods and services. “Being able to conduct



Christophe Mazenc

“We are also envisaging transferring knowledge about building, maintaining, and using AI tools”

this phase automatically would be very useful in order to save time and speed up the registration process," she explains.

Some of these benefits are appreciated by the Japan Patent Office (JPO), which has not yet implemented AI in trademark examinations, but is exploring how it might do so in the future. Satoshi Noguchi, Director General, Trademark and Customer Relations Department, says the Office is expecting AI to relieve trademark examiners' workloads and improve examination quality and efficiency.

"The number of trademark applications is increasing in recent years, so if we can use AI, we hope it can lead to providing applicants earlier notices about examination results," he explains.

**Use Studies**

In a two-part study, the JPO is first examining whether it can use AI for image searches. Mr. Noguchi explains that when searching for prior figurative marks, examiners "must make significant efforts" to ensure that their search queries cover a large number of databases and check all of the search results. Quite simply, this creates a vast amount of work for examiners, he says, so the ultimate goal is to reduce their workloads.



Satoshi Noguchi

**“**  
**We think that AI can become a means of supporting examiners' work.**  
**”**

In fiscal year 2017, the JPO verified the search accuracy of image searches through the use of AI and identified issues that need to be resolved. In fiscal year 2018, the JPO continued its work to increase search accuracy and clarify the scope of image searches that

are capable of supporting figurative trademark examinations. It also began conducting trials on AI-based image searches by examiners, including the task of assigning search codes to figurative elements of the filed mark, Mr. Noguchi says.

The second phase of the JPO's study relates to the examination of similarity of goods and/or services. Throughout fiscal years 2017 and 2018, the JPO studied the use of AI to support the assignment of similar group codes, which helps examiners to ascertain the scope of similarity between goods and/or services, to designated goods and/or services, says Mr. Noguchi.

To conduct the study, the JPO developed AI that could learn the lists of goods and services in its Examination Guidelines for Similar Goods and Services, as well as past examination results.. The assignment of similar group codes is one of the most time-consuming tasks for trademark examiners, Mr. Noguchi explains.

"Therefore, the JPO believes that if AI-based systems can be used to do this, it will improve examination quality and speed up the examination process," he says.

One of the main limitations is that, as things stand, AI is not 100 percent

accurate, so there is still a need for human input. Mr. Noguchi gives the example of decisions on trademark registrability, a requirement that is based on consumer recognition. "As of today, it is technologically difficult for AI to make decisions about trademark registrability; instead, we think that AI can become a means of supporting examiners' work," he suggests.

While there's certainly a long way to go before AI can revolutionize the work of IP offices, the speed of advancement suggests it would be foolhardy to predict that it won't. In the meantime, the technology is already enhancing IP offices' work, and perhaps more significantly, is proving more beneficial for users of the systems.

That trend is likely to continue as more offices adopt the technology, and specifically as initiatives such as WIPO's gain traction, since the strength of an AI solution is predicated to a large degree on the quantity and quality of available data. The extent to which IP offices coordinate their efforts in this area is likely to have widespread ramifications for the future of the industry. In any event, the days of trademark examiners manually trawling through thousands of applications are, if not over, then on the way out. ●

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# Making the Case for Diversity

The importance of diversity at law firms remains a center of conversation. Sarah Morgan reviews the status.



2019 is a landmark year for women in law—it marks the centenary since the passing of the Sex Disqualification (Removal) Act in the United Kingdom, which allowed women to become barristers and solicitors for the first time.

Yet, while it's been 100 years since women were given the right to practice law, gender diversity as well as other aspects of diversity remain hot topics today—not just in the UK but around the world.

While global statistics on diversity at law firms are not available, data on women and minority ethnic lawyers in some countries show that numbers are increasing—but slowly.

For example, in the UK, women make up just under half all lawyers at law firms, but only 33 percent of partners, reports the Solicitors Regulation Authority (United Kingdom). In North America, according to McKinsey & Company (USA), while law firms are taking important steps to increase gender equality, as of 2017, only 19 percent of equity partners were women,

and women were 29 percent less likely than men to reach the first level of partnership.

“We are making progress, but likely still have decades of work ahead before achieving true equality in the legal profession,” says Brian Winterfeldt, Principal of Winterfeldt IP Group (USA).

## Business Side of Diversity

Diversity is important: firms that understand this and ensure it, are likely to benefit in the long run.

“Growing research shows that improving diversity within companies is not just about ‘doing the right thing,’ but actually helps businesses and economies grow, providing a real business case for change,” says Martijn Schouten, Singapore People & Organisation Leader, PwC South East Asian Consulting (Singapore).

Along with bringing a variety of perspectives to the table, diversity can help lawyers connect with clients who themselves have diverse teams,

according to Mr. Winterfeldt. “The increasingly global nature of business makes it important to have perspectives that are as broad and creative as possible,” he says.

Lynell Tuffery Huria, Principal at AJ Park (New Zealand), agrees that a diverse team will better reflect its clients.

“The world is becoming more and more diverse, and we need to understand the ideas, values, and needs of our clientele to ably assist and advise them,” she says.

Hilton Worldwide, Inc. (USA), which was named as the best workplace for diversity by consultancy Great Place to Work (USA) last year, is one example of diversity and inclusivity.

Christian Eriksen, Senior Counsel Brands and Intellectual Property at Hilton Worldwide, Inc. (USA), says: “From a big picture perspective, we believe an inclusive approach supports our hospitality culture, provides access to better and more diverse talent, and gives Hilton distinct advantages in the marketplace.”

If Hilton Worldwide, Inc. believes a law firm is not committed to or operating in a way consistent with its values, he says, “They are not likely to be our counsel for long.”

## Commitment Is Key

Obviously, diversity makes sense, but how can the legal profession achieve parity? In recent years, law firms have worked hard to employ diversity-focused professionals, and to make diversity commitments, and have built up committees to improve hiring, retention, and advancement prospects.

“It's not complicated. It's very simple in concept but very difficult for law firms to follow through,” suggests Chasity Wilson Henry, Assistant General Counsel of Corporate Affairs and Legal Strategy at Kimberly-Clark Corporation (USA).

Unfortunately, a “lack of role models, allies, and networks, and the assumption that one must conform to a presumed standard as you advance in your career, lead to diverse talent seeking opportunities at other companies,” adds Mr. Schouten.

“Networks make a huge difference. You can be introduced to others who have already ‘made it’ and you can learn from it,” adds Ms. Henry.

In 2014, Ms. Henry launched the NEW Roundtable (USA), a nonprofit organization. Through a mix of relationship-building, professional development initiatives, and mentoring, the organization aims to drive the inclusion and advancement of African-American women attorneys.

## Leading From the Top

What's also important for law firms is not only to make a commitment to diversity, but also to effectively communicate that message to their employees.

Trish Mundy, Associate Dean at the University of Wollongong, Australia (Australia), says: “I don't think leading a firm culture needs to look a certain way, but it does need to be communicated to everyone.”

Ms. Mundy and Nan Seuffert, Professor of Law at the University of Wollongong, Australia, conducted the Advancement of Women in Law Firms: Best Practice Pilot Research Project in August 2017, which investigated current best practices on gender equity criteria in four of the top-achieving national law firms in Australia.

Echoing the study findings, all interviewees saw a commitment from the top as extremely important to achieving diversity.

Mr. Eriksen says: “The responsibility for advancing the culture of an organization lies with every individual

## Giving Back to Boston

INTA volunteers helped inspect, sort, and package grocery items yesterday at The Greater Boston Food Bank: in all, 4,196 meals for local families.



within that organization. It is not enough to hire a diverse team. Leaders should work to ensure diverse voices are heard and part of the decision-making.”

While everyone is a “culture-carrier” in their own capacity, Mr. Schouten notes, “Leaders cast long shadows and influence employees in the way they behave and communicate, which makes their role critical by embracing diversity and inclusion and role-model supporting behaviors.”

Ms. Caboli suggests that ensuring that both men and women can take advantage of these policies can benefit all involved.

“Our society stigmatizes men who decide to take time off from work to spend time with their families. We need to have more men leading the way so we can all benefit, and women can see that it is acceptable,” she says.

Ms. Dean agrees: “It’s extremely important not to water down diversity policies in anticipation of that resistance. We need men to actively



Chasity Wilson Henry

“**Networks make a huge difference. You can be introduced to others who have already ‘made it’ and you can learn from it.**”

be a part of creating this culture and modelling it.”

During their research, Ms. Mundy and Ms. Seuffert found two areas in which law firms appear to go beyond the current best practice.

First, one of the firms had a series of programs to ensure pay equity, including reviewing the performance appraisal process and lawyers’ salaries for gender bias.

“This involves looking at pay raises and particularly at bonuses and comparing them to performance ratings to ensure that what lawyers are being paid reflects their performance without gender bias intervening,” said the research.

Mr. Winterfeldt adds: “Attorney performance criteria should be applied fairly and transparently, particularly so that diverse attorneys will have a clear sense of what standards need to be met for retention and advancement purposes.”

Second, the research found an example of a practice group in a

large firm that had broken down the traditional siloed approach to work, where one lawyer only works on certain issues/industries, into a team effort.

“If a person only works in a certain area they will become very proficient, but if that person wants to go part time or chooses flexible work, it can make it difficult to share the work,” says Ms. Seuffert.

Juan Acosta, Director of Litigation and Alternate Dispute Resolution at OlarteMoure (Colombia), notes that most firms that have decided to invest in diversity in Colombia are self-regulated. Many Colombian law firms have implemented different diversity practices, such as extended maternity and paternity leave and mentoring opportunities.

“We are getting there,” says Mr. Acosta, “but we still believe there is a glass ceiling that has to be broken when women face challenging positions in which traditional views push them to decide between family and work.” ●

## Better Business Development

Many people dislike selling their skills, but business development is an essential part of a good lawyer’s practice. Sarah Morgan reports.

“You need to find your passion in law and be able to align your existing activities to what you want to do,” said Mark Beese, President of Leadership for Lawyers, LLC (USA), told registrants yesterday during the **Lunch and Learn** session.

Mr. Beese introduced registrants to the basics of lawyer business development, a concept that he said many lawyers seem to find challenging.

“Do you think intellectual property (IP) lawyers are more introverted or extroverted?” he asked the audience. No response. “Since you’re so quiet, I’m going to assume introverted,” he continued.

“We tell ourselves a story that I’m an introvert so I’m not very good at business development ... and going to a [meeting] like this is exhausting. But that doesn’t mean you can’t be good at business development,” he said.

Introverts have a particular set of qualities that make for great business development: they’re observant and great listeners, they build relationships, and they’re often composed.

Mr. Beese outlined “five mindsets” required to improve a lawyer’s capabilities. First, realize there’s a difference between marketing and business development.

While he said all lawyers should write articles and advertise, “being involved in public relations no longer makes the phone ring.”

The distinction is that marketing builds your reputation and business development builds relationships.

“In today’s world we have to build relationships. We have to sell. I know you don’t like that four-letter word but it’s true,” he said.

Second, stop thinking of business development as just selling to a client but rather, think of it as helping them. This will make it easier to engage.

Third, focus on your target market. “Many of you are very skilled IP lawyers, and you can do it across the board,” Mr. Beese said. But it’s rare that a client says, “I’m looking for a generalist that can do everything.” Clients want someone who understands their specific needs, their challenges, and their technologies.

For the fourth mindset, Mr. Beese presented an equation: attitude (a) plus behavior (b) plus capabilities (c) equals results (r). He said that most people don’t have problems with “b” and “c”, but sometimes get stuck with “attitude.”

A bad attitude to business development is exemplified in an approach that relies on “a numbers game.” Some people think if you “just tweet a lot” that will bring results, but that’s incorrect, he noted.

“**In today’s world we have to build relationships. We have to sell. I know you don’t like that four-letter word but it’s true,**”

For the fifth and final mindset, Mr. Beese emphasized the importance of networks. “People hire people they trust, and they look for referrals from other people,” he concluded.

Beyond these tips, Mr. Beese provided insight into necessary skills, including using “verbal business cards” (sometimes known as an “elevator pitch”), which he called a “powerful tool” to help lawyers describe themselves.

“It doesn’t have to be pithy or cute. It has to work for you and be authentic and resonate with clients,” advised Mr. Beese, before asking audience members to speak to each other and present their own verbal business cards.

“Without saying ‘I’m a trademark lawyer,’ think about how you would introduce yourself to somebody else in the context of the problems you solve,” he said.

But why should lawyers undertake business development?

First, it results directly in money. Second, the more we do business development, the more we have control over our careers, our lives, our practice,” Mr. Beese said. ●



Mark Beese outlines “five mindsets” to improve capabilities.

# GDPR's First Anniversary of Implementation and WHOIS: Where Are Brand Owners Now?

It's been nearly a year since the European Union's implementation of the General Directive on Privacy Regulation (GDPR). Lori Schulman, INTA's Senior Director of Internet Policy, takes a look at where things stand today.

In a recent interview conducted at the International Association of Privacy Professionals (IAPP) Global Privacy Summit in Washington, D.C., European Data Protection Board Chair Andrea Jelinek expressed that she is pleased with the first year of the GDPR because it has prompted a global discussion on privacy and "the sky has not fallen."

While it is true that GDPR compliance is becoming a norm for brand owners, it is equally true that access to critical brand enforcement information is still being masked without a reliable method of access. The unforeseen consequences of GDPR implementation in the domain name system continue to harm brand owners and the consumers who they are tasked with protecting.

Domain name registration data such as WHOIS has been masked worldwide by registries and registrars ever since the Internet Corporation for Assigned Names and Numbers (ICANN) put its Temporary Specification for WHOIS data compliance with GDPR into effect on May 25, 2018. As ICANN grapples with this issue as part of its Expedited Policy Development Process (EPDP), law enforcement, brand owners, and cybersecurity experts are scrambling to find ways to obtain information on domain name registrants. To help brand owners navigate the new landscape, INTA has prepared the WHOIS Toolkit, which provides direct contact information for registrars.

As of now, brand owners must contact registrars directly with their requests for WHOIS information. While this may seem reasonable, several



industry studies have shown that these requests generally go unanswered or unresolved. An area in which ICANN and INTA agree is that there is a genuine need for a Uniform Access Model (UAM). ICANN has convened a group of technical experts to explore automated solutions while the EPDP is tasked with developing a reasonable and balanced policy.

The EPDP has been divided into two phases. Phase 1 looked at the legitimate purposes and legal bases for collecting and processing WHOIS data in relation to ICANN's mission and contractual relationship. Phase 2 will focus on access, and address any open questions from Phase 1. The open questions from Phase 1 have caused great concern for INTA members as they do not fully recognize enforcement of intellectual property (IP) rights as a legitimate purpose for data collection and processing.

INTA's full comments are available on the advocacy section of [inta.org](http://inta.org). INTA and IP stakeholders must now look to Phase 2 to provide greater clarity and certainty to the IP community that

the right tools to combat cybercrime and online infringement will be provided in a timely manner. INTA



hopes that the direction of Phase 2 will be made clearer when ICANN holds its next meeting in Marrakech, Morocco on June 24-27.

In the meantime, INTA continues its advocacy outside of ICANN, meeting with EU Commission representatives and participating in dialogues on Internet governance. INTA is preparing substantive comments in response to proposed guidelines on the purposes of data collection for the performance of a contract under GDPR.

As INTA keeps a spotlight on this issue in the privacy realm as well as in the domain name space, the Association's strategic alliance with IAPP is helping to spread the word of the unforeseen consequences of GDPR implementation. IAPP leadership has been briefed on the importance of this issue to brand owners. In addition, INTA staff has been interviewed for articles, and INTA volunteers presented a panel at the IAPP Policy Conference in Brussels on this topic.

INTA encourages all of its members to follow the developments in WHOIS and GDPR implementation, as these policies will likely determine the way brands enforce their rights on the Internet for many years to come. ●

## Brand & New

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World Trademark Review is pleased to announce the winners of the WTR Industry Awards 2019, revealed last night. Now in their 13th year, the awards shine a spotlight on the vital work performed by in-house counsel across the globe and identify the teams and individuals that deserve special recognition for their exceptional achievements over the past year.

WTR congratulates the award winners on their success and thanks its law firm partners for all their assistance in hosting such a memorable event.

For more information about the awards visit Booth 918-920 in the exhibition hall or go to [www.WTRIndustryAwards.com](http://www.WTRIndustryAwards.com).

# Winners revealed

[www.WTRIndustryAwards.com](http://www.WTRIndustryAwards.com)

**Asia-Pacific Team of the Year**

- Alibaba
- Louis Vuitton Malletier
- Danone
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TECHNOLOGY & LAW

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**DANIEL**  
LAW

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- EasyGroup
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**ROUSE**

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- Groupon
- Honeywell International
- Nintendo of America

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Visit booth 918-920 for more information about the awards.

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# Africa: The Hot Ticket for Technology

Brands operating in the field of cutting-edge technologies can no longer ignore Africa when it comes to protecting their intellectual property, as Sarah Morgan finds out

With a moderator from South Africa and panelists from Kenya, Nigeria, and Zimbabwe, the **RW01 Regional Update: Protecting Technology in Africa** (Wednesday, 10:15 am - 11:30 am) will evaluate how companies can protect technology across the continent.

Of interest to trademark practitioners and technology-based businesses looking to branch out in Africa, the panel will focus on “understanding what the leading and up-and-coming technologies are, how they can be protected, and the extent to which

this intellectual property (IP) can be effectively enforced” in different African countries, says Simonne Christina Moodie, Partner at Von Seidels (South Africa), who will moderate the panel.

In addition, speakers will explore how technology differs in how it is used by people in Africa compared to those in the Western world, she says.

Lorna Gathigia Mbatia, Partner at CFL Advocates (Kenya), will focus on East Africa and the unique IP rights protection and enforcement issues in the area.

She notes that a major enforcement issue in the region relates to the involvement of customs officials in IP protection. “Although the East African countries recognize and appreciate that the role of customs officials goes beyond collection of taxes, many do not have formal proceedings for customs official involvement in IP protection and as such, involvement of customs officials is usually reactive,” she says.

Nancy Samuriwo, Partner, Intellectual and Commercial Law at Samuriwo Attorneys (Zimbabwe), will provide an “all-Africa” perspective, discussing the nuances inherent in the two regional trademark registration systems in Africa, which are provided through the African Regional Intellectual Property Organization (ARIPO) and Organisation Africaine de la Propriété Intellectuelle (OAPI).

“While IP clients the world over experience challenges in various jurisdictions, the main difference with this session is its special and authentic



focus on Africa and its inspiring proposition of Africa,” she says. “Far from the ‘Africa Rising’ theme of old, [this session will offer] a new view that suggests that not being in Africa is now a material risk for tech clients.”

Ms. Samuriwo will explain why proprietors need to have an Africa-specific strategy for trademark protection, technology-based IP, the common challenges IP practitioners are likely to face, and how to overcome them.

One of these challenges is the lack of investment in local counsel, according to Ms. Samuriwo.

She adds: “African IP systems are

complex, and there are several legal, cultural, linguistic, jurisdictional, and sometimes political issues that can arise from the implementation of an IP strategy in Africa. It is advisable for technology-based clients to invest in reputable local expertise in African jurisdictions for these clients to be best placed to navigate around potential pitfalls.”

Okey Onyekanma, Founder and Managing Partner of Okey IP (Nigeria), will provide an overview of financial technology (FinTech) in West Africa — focusing on Ghana, Nigeria, and the larger West African economies, and protecting and enforcing FinTech in West Africa. ●



Nancy Samuriwo

“Far from the ‘Africa Rising’ theme of old, [this session will offer] a new view that suggests that not being in Africa is now a material risk for tech clients.”

## INTA and Kenya’s Anti Counterfeit Authority Sign Memorandum of Understanding

INTA and Kenya’s Anti Counterfeit Authority (ACA) signed a Memorandum of Understanding (MoU) on May 20, during the Annual Meeting. The MoU is the culmination of years of collaboration between the two organizations. It will guide their future cooperation in areas that include trainings for customs and enforcement officials, the promotion of INTA’s Unreal Campaign, and the organization of anticounterfeiting-focused workshops and seminars.

ACA is the leading entity within the Kenyan government, established under the Anti-Counterfeit Act 2008 as a state corporation with the mandate to enlighten and inform the public on matters relating to counterfeiting; combat counterfeiting, trade, and other dealings in counterfeit goods; devise and promote training programs to

combat counterfeiting; and coordinate with national, regional, or international organizations involved in combating counterfeiting. In order to support ACA’s efforts, INTA’s Anticounterfeiting Committee—Middle East and Africa Subcommittee has provided input on key documents and strategies.

Prior to signing the MoU with ACA, INTA President David Lossignol and INTA CEO Etienne San de Acedo had a bilateral meeting with a high-level delegation from the Kenyan National Assembly, led by Honorable Justin Muturi, a Member of Parliament and Speaker of the National Assembly.

During the meeting, Hon. Muturi announced the launch of Kenya’s Intellectual Property/Trademark Caucus. The Caucus will be a tool to foster the promotion and protection of intellectual property rights. ●



Elema Halake (L.), Executive Director of Kenya’s Anti Counterfeit Authority, and INTA President David Lossignol

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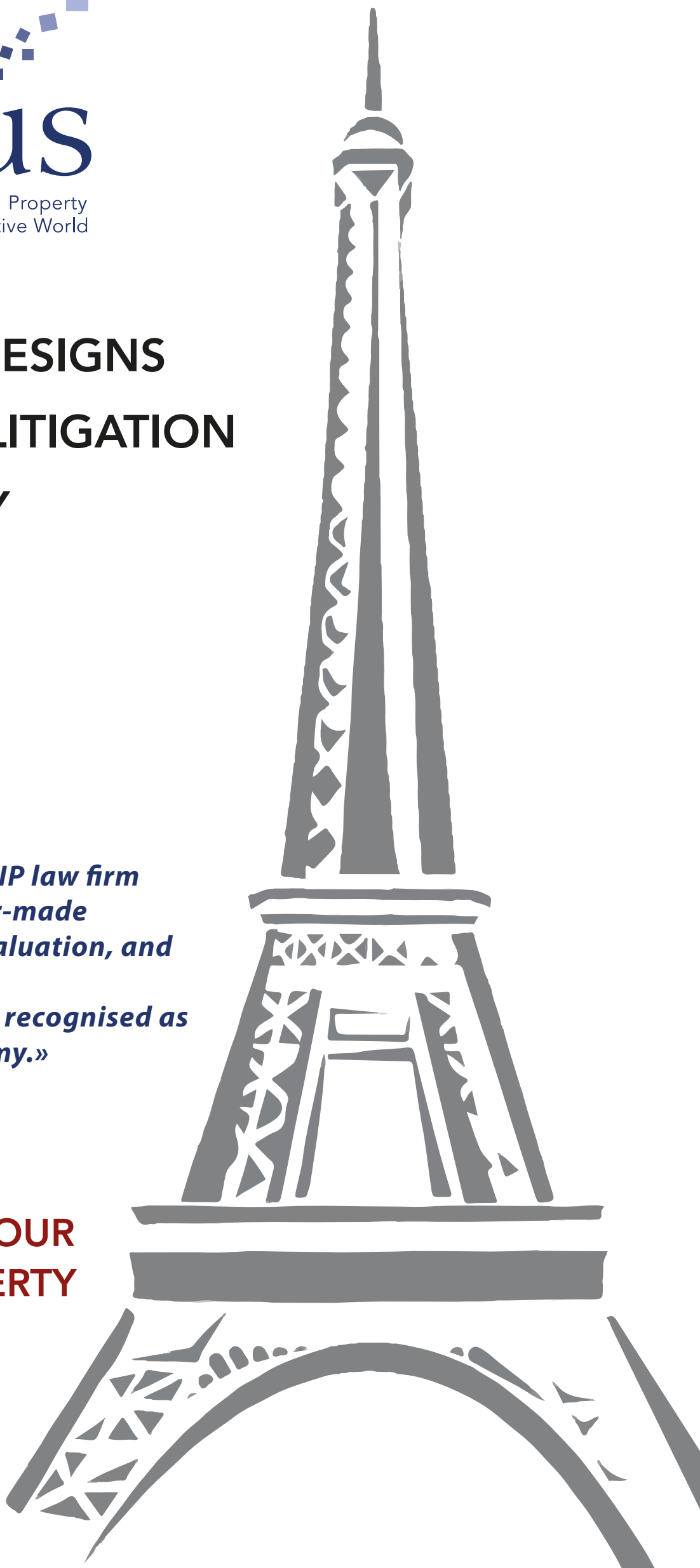
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# Strengthening IP Rights in the ASEAN

With new trademark laws and more countries acceding to the Madrid Protocol, the signs are there that intellectual property (IP) is in a stronger place than ever before in the ASEAN region and Australasia, as Rory O'Neill reports.

In Monday's session **RM50 Regional Update: Southeast Asia, Australia, New Zealand**, panelists gave a positive assessment of the latest developments in trademark law across the region.

As Catherine Su Yee Lee, Principal, Rodyk IP (Singapore), who moderated the session, noted, "There has been recognition that IP plays a very important role" in the achievement of the region's social and economic development goals.

At present, 8 of the 10 countries comprising the Association of Southeast Asian Nations (ASEAN) have acceded to the Madrid Protocol; Malaysia and Myanmar are the exceptions.

However, as Pauline Khor, Head of Intellectual Property and Technology at Rahmat Lim & Partners (Malaysia), informed attendees, Malaysia is preparing to accede to the Protocol as part of a number of milestone developments in Malaysian trademark law.

Noting that Malaysia last year had its first change in its governing political party since independence from the United Kingdom in 1957, Ms. Khor said, "The way we are going about upgrading our trademark laws is no different – we do nothing [for a long time], and then we have massive, sweeping changes."

Among the changes currently making their way through the country's legislature is a new Trademarks Bill, which would update the 1967 legislation. If passed, according to Ms. Khor, it will put Malaysia's trademark statute "on par with the current laws in the UK" and enable accession to the Protocol.

"Essentially what we are doing is lifting our trademark laws up and complying with international standards," she said. Under the proposed law, it would be possible to file trademark applications in different classes, as well as for non-conventional registrations such as 3D, single color, and shape marks.

Malaysia would be the latest in a series of recent accessions to the Madrid

Protocol in the region. As Andrew Flagg Brinn Diamond, Foreign IP Consultant, Januar Jahja & Partners (Indonesia), noted, Indonesia started accepting international registrations under the agreement in January 2018, with a total of 9,300 designations issued so far.

On the other hand, uptake with respect to international registrations with Indonesia as the country of origin has been limited. This is not for the want of trying on the part of the Indonesian authorities, Mr. Diamond noted. "Both Indonesia's [Directorate General of Intellectual Property] and its Creative Economy Agency have undertaken considerable efforts to educate and inform the public about this new option," he said, referring to registrations with Indonesia as the country of origin.

"I think generally [Indonesian authorities have] done a pretty good job in generating interest but to date that interest hasn't really led to a significant number of filings," he added.

Darani Vachanavuttivong, Co-Managing Partner, IP Department, Tilleke & Gibbins (Thailand), reported similar success of the Madrid Protocol with respect to incoming international registrations in Cambodia, Laos, Myanmar, Vietnam, and Thailand, known as the CLMVT group of countries. All of them except Myanmar have acceded to the Madrid Protocol since 2006.

“Essentially what we are doing is lifting our trademark laws up and complying with international standards.”

Incoming registrations have been continually increasing in each of these four countries. Thailand, for example, recorded a record high of 6,625 international registrations in 2018, while, according to the latest data, there have already been 3,253 such registrations in 2019, Ms. Vachanavuttivong said.

Just as Malaysia is debating sweeping changes to its trademark system, Ms. Vachanavuttivong reported a major change to the law in Myanmar, which last year adopted a new trademark statute.

The law replaced older regulations dating back to 1908, she said, marking significant progress in the country's IP protection regime. Unlike Malaysia,



(L. to R.) Andrew Flagg Brinn Diamond, Pauline Khor, and Joy Atacador

however, nontraditional marks such as 3D shapes still cannot be protected in Myanmar.

## Enforcement Matters

While the trademark laws in force across the ASEAN region may be improving, how effectively are they enforced?

According to Mr. Diamond, enforcement of trademark rights in Indonesia is "still difficult, but it's possible." He noted that success largely depends on a given brand owner's objectives. For example, the destruction of infringing goods is "achievable," but monetary damages or a public apology can be challenging to obtain.

"The narrative which is fairly true is that litigation in Indonesia is unpredictable, so it's important to consider non-litigation options first," Mr. Diamond said. He noted anecdotally, that his firm has enjoyed a "significant increase in success" with sending cease and desist letters in recent months, which might be a good sign for brand owners with IP assets in the country.

In Malaysia, the forthcoming trademark reforms may make it easier for brand owners to litigate their rights, Ms. Khor said. The bill includes what, in her view, is a "lower threshold for infringement."

Whereas brand owners at present can sue for infringement only if there is a "direct match with the goods and services for which [the mark] is registered," under the new law, infringement suits could be filed over merely "similar goods" as long as the plaintiff can demonstrate genuine confusion among consumers between the marks.

Ms. Vachanavuttivong also provided a positive update on enforcement in the CLMVT countries, noting that the Cambodian Counter-Counterfeit Committee is "now a very effective organization," while "the police in Laos are quite effective and fast in handling enforcement actions."

Echoing the positive report for brand owners from the ASEAN jurisdictions, Joy Atacador, Head of IP & Technology

at Dentons Australia Pty Ltd (Australia), said that in Australia there are improved procedures on the way "which will allow customs to seize goods even where a notice of objection hasn't been filed by a trademark owner."

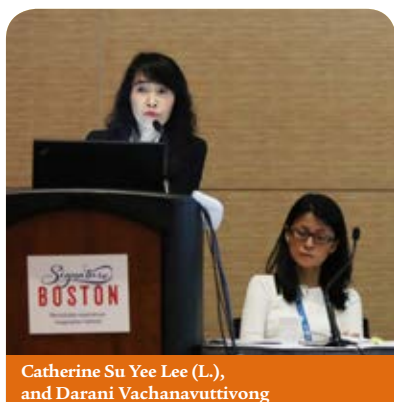
Perhaps the most significant development for brand owners in Australia is the passage of the Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Act 2018 into law last August.

Under the new law, "a parallel importer will not be found to be engaging in infringing conduct if, after making reasonable inquiries, it would be reasonable to conclude that the trademark had been applied to the product with the consent of the registered owner," Ms. Atacador said.

The law also allows the parallel importation of goods under the reasonable assumption that the trademark had been applied to the product with the consent of either an "authorized user" of the mark; or a person permitted to use the mark by an authorized user or the registered owner.

Ms. Atacador also noted that an "express IP exemption" in Australian competition legislation had been removed, and that similar changes were also being adopted in New Zealand.

"If you have a client with an agreement with a licensee who would otherwise be a potential competitor, it might be that those prior agreements need to be reviewed to check if they fall foul of competition legislation," she advised. ●



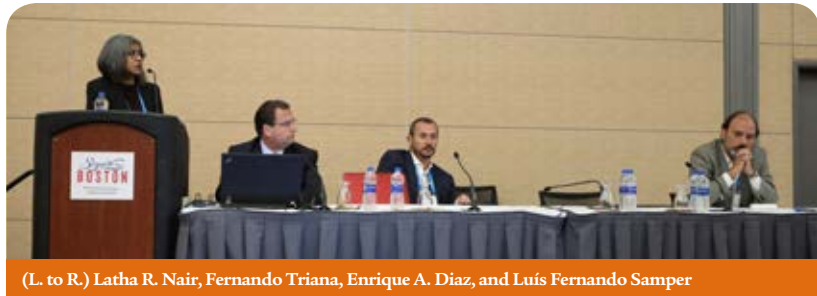
Catherine Su Yee Lee (L.), and Darani Vachanavuttivong

INTA's 2019 Asia Conference: Brands in Changing Times will take place in Kuala Lumpur, Malaysia, October 17-18; and INTA's 142nd Annual Meeting will be in Singapore April 25-29, 2020.

Visit [www.inta.org](http://www.inta.org)

# There's No Place Like Home

Geographical indications can be powerful tools to maintain the quality and reputation of regional brands—but protecting them can take patience and persistence.



(L. to R.) Latha R. Nair, Fernando Triana, Enrique A. Diaz, and Luis Fernando Samper

At yesterday's session **CT20 The Experience Around Geographical Indications and Appellations of Origin for Champagne, Darjeeling Tea, and Colombian Coffee**, panelists discussed how geographical indications (GIs) and appellations of origin (AO) can help safeguard the distinctiveness of regional products.

Fernando Triana, Founding Partner at Triana, Uribe & Michelsen Ltda (Colombia), who moderated the panel, laid the foundation for the discussion by defining the value of GIs and AOs.

"Geographical indications are a way to highlight specific qualities of goods specific to the geographical area in

which they are produced," he said. "The use of a GI or AO also allows consumers to identify a product's quality based on the characteristics of the area in which it's produced."

But these protections are not always readily available. "In many countries, AOs and GIs are not even protected," Mr. Triana said.

## Not all GIs Are Equal The Story of Darjeeling

Darjeeling tea is grown in sloping terrains in the Lesser Himalayas at altitudes ranging from 600 to 2,000 meters above the sea level. This unique climate, combined with the soil and

the rainfall, create an agro-climatic condition that has given rise to Darjeeling's famous muscatel flavor since the tea was first planted in 1845.

Darjeeling tea gardens are nearly 175 years old and the Indian Tea Board has engaged in the protection of Darjeeling as a GI around the world since 1986.

Yet, in general, Latha R. Nair, Partner at K & S Partners (India), noted, "It is very challenging to be born a 'non-wine', 'non-spirit' GI in a developing country."

Both GIs and trademarks affect brands, she explained. "However, protection of GIs is so very challenging because there is no level playing field for GIs," she said. "Unlike trademarks, the protection of which is streamlined around the world, GIs are protected in different parts of the world through different systems."

"I want to say that while all GIs are equal, some GIs are more equal than others. It is not a complaint, but a dispassionate reflection arising from my representation of all kinds of GIs," Ms. Nair said.

## Some GIs Are Too Famous The Protection of Champagne

The Champagne GI is one of the best-known in the world and, as with Darjeeling, a unique location and set of circumstances give it a distinctiveness that permits GI protection.

"As you know, the protection of Champagne has an historical background. It's grown as a sparkling wine in a very particular region of France," said Mr. Triana. "The method of producing Champagne implies the way the wine is poured into the bottle and rotated over a period of years."

While the method is not exclusive to the Champagne region, only sparkling wine that comes from that region may legally be called "Champagne," he said. Since 1844, the GI for Champagne has been strongly protected and heavily litigated.

"We've been successful in blocking infringements, but the problem in the past three or four years is that many registrations were granted for 'Champagne,'" explained Enrique A. Diaz, Senior

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# Choosing the Right Path to Protection

When it comes to rights protection, intellectual property (IP) owners have a variety of options, each with advantages and disadvantages, as Saman Javed finds out.

In Monday's session **CM50 Interplay Between Designs, Copyright, and Trade Dress—Overlapping or Coexisting**, which was moderated by Simon Brown, a Partner at Adams & Adams (USA), panelists discussed the challenges associated with different types of protection in their various jurisdictions.

Imogen Fowler, a Partner at Hogan Lovells (Spain), said anybody who has filed a trademark with the European Intellectual Property Office (EUIPO) in the last few years would have found it is becoming increasingly difficult to get particular types of marks approved.

"The first place we saw things change was in the context of 3D marks. Effectively, the law now says that a shape has to depart significantly from the norm in order to be registerable. That bar is very high, it's very hard to prove," she noted. "So if you're trying to file a 3D mark based on inherent distinctiveness, I would say good luck to you."

Ms. Fowler cited two examples in which the EUIPO rejected applications to register 3D shape marks for confectionary, noting: "These are very well-known trademarks, which are quite unique shapes. I would have thought they would be inherently distinctive, but they didn't meet the threshold."

She added that it has also become more difficult to register 2D marks, with the EUIPO rejecting applications for marks that feature "non-distinctive words and logo elements."

Mr. Brown said that "while a lot of lawyers are more focused on trademarks than any other form of IP, given the difficulties of securing trademark rights, certainly in the non-traditional sphere, it's becoming increasingly important to look at other aspects of IP."



(L to R) Diego Palacio, Ray Zhao, Imogen Fowler, and Simon Brown

One way in which brands are protecting their marks is through trade dress. However, this can only be done at a national level as an "unregistered right" because trade dress does not exist as a specific category for protection in the European Union.

Ms. Fowler noted how this is further complicated by the fact that national laws differ from country to country. "An unregistered right in Spain will not be the same as in Bulgaria," she added. This means that there is no clear scope for the right across Europe.

There are no fees applicable for unregistered rights, but they can be expensive to enforce because it is necessary to demonstrate "serious evidence of unfair competition and actual confusion" to prove infringement, she said.

A category for design patents also does not exist in the EU. Instead,

unregistered or registered community designs are available.

Since there is no detailed examination required to obtain these rights, Ms. Fowler said, it makes them "really quick to register."

In China, in contrast, design patents are available. Ray Zhao, Partner at Unitalen Attorneys At Law (China), explained that in order to qualify for protection, design patents must be novel, fit for industrial application, and artistic.

"There is no substantial examination for design patents in China. Often companies file design patents, and as long as you meet the formality requirements, the applications will be approved," he said.

While this makes approval extremely fast, the lack of substantial examination can result in disputes when two companies file the same design, he noted.

Copyright applications in China are also not subject to examination, meaning they can be issued in as little as a month, Mr. Zhao said.

However, copyright is registered on a regional basis in the country but the "registries don't share information, so it can be difficult to find what works are already protected," he added.

Nonetheless both copyright and design patents can provide alternatives to or supplement trademark protection.

In the United States, brand owners can protect product packaging and product design in the form of trade dress protection.

Diego Palacio, Attorney at Palacio & Asociados (Argentina), said trade dress protection is a "source indicator for consumers, which helps avoid the likelihood of confusion."

To qualify for trade dress protection, the product packaging must be non-functional, must not be essential to the use or purpose of the product, and must not affect the product's cost or quality.

The packaging must be inherently distinctive or acquire distinctiveness by secondary meaning, while the design is considered inherently non-distinctive and must acquire distinctiveness by secondary meaning.

Mr. Palacio said that in the U.S., trade dress protection lasts indefinitely, as long as it is being used. Additionally, brands can obtain protection after a product has been made available in public. This is important because, in some cases, public disclosure can be helpful to establish acquired distinctiveness, which can be difficult to prove. ●

**“Registries don't share information, so it can be difficult to find what works are already protected.”**

## There's No Place Like Home (continued)

13 Partner at Goodrich, Riquelme & Asociados (Mexico). "We have had some cases involving Champagne in Mexico as well."

"While it may be easy to oppose an infringement when it's related to goods, it's not always a red line in how to oppose it when it comes to a service," he said, noting that there are even some schools with the name "Champagne."

### The Intangible Value of GIs Promoting Colombian Coffee

Café de Colombia became recognized as a denomination of origin in

Columbia in 2005, and subsequently became recognized in Peru, Ecuador, and Bolivia. It was also the first non-European protected GI in the European Union in 2007 and the first protected GI in Switzerland in 2013.

Since the emergence of highly recognized global coffee chains, the perception of quality coffee brands has shifted, and the Colombian coffee strategy had to evolve. "We came out with a protected GI as part of this strategy," explained Luís Fernando Samper, Founder and President at 4.0 Brands SAS (Colombia). "[It] is an

important tool to protect collective rights."

Earning this status holds great value for Colombian coffee makers and the Colombian people. "Coffee is very important for Colombia, and has a lot of social significance for many. In fact, half of the towns in Colombia produce coffee," he said, emphasizing the added "intangible" value GI protection brings to a product and the perceived quality of a product.

"Once you have GI protection it can be very powerful," he said. "It takes a lot of effort – but once you get it, it can be very useful in legal terms." ●

**“While it may be easy to oppose an infringement when it's related to goods, it's not always a red line in how to oppose it when it comes to a service.”**

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# The Data Holds the Answers

Efforts to combat online counterfeits have made data analytics a brand's best friend, while prompting innovative lawyers to transform their practices, says Tom Phillips.



The opportunities provided by e-commerce are obvious. Online shopping habits vary between countries, but most statistics show that businesses are experiencing a steady year-on-year increase in the percentage of total revenue from a click on a screen or a tap on a phone.

The data culled from these transactions are essential for all online businesses to inform decisions about their product lines, regional expansion, and customers' buying habits.

And the huge popularity of social media platforms has turned scrolling on a cell phone into a shopping experience, as Instagram, Facebook, and Pinterest grow their e-commerce activities.

Also growing, at an alarming rate, is the volume of online counterfeits.

A U.S. International Chamber of Commerce 2017 report—*The Economic Impacts of Counterfeiting and Piracy*—estimated the global economic value of counterfeiting and piracy will reach US \$2.3 trillion by 2022.

The report predicts that by 2021, counterfeit trade could drain US \$4.2 trillion from the global economy annually, and put 5.4 million legitimate jobs at risk.

In many ways, an Internet sale is a two-way street. While there are significant challenges associated with

tracing online transactions, IP lawyers are increasingly able to use data to fight back against the counterfeiters.

## The Law Firm

Aaron Newell, Partner in the Trade Marks & Designs Group at JA Kemp (United Kingdom), has been working in trademark law for 12 years.

Mr. Newell has developed a domain name dispute management system that receives alerts about new domain name registrations. Industries such as fashion, automotive, and software in particular suffer high volumes of illegitimate domain registrations.

Built in-house, the system is the culmination of experience that grew organically over his career, as he gradually became the “go-to” guy for online brand protection issues.

“The online brand protection platforms have real people—analysts—looking at the data. But the analysts aren't lawyers. They can't always tell the client the best thing to do with that data. That's the gap we're trying to fill.”

Big brands could see as many as 5 to 50 domains for counterfeit names being registered per day, so there is plenty of work available in this vein. The question is, do clients want it?

“There's always a profitability issue. If you're lucky enough to have a big brand as a client you're going to get 20 [illegitimate] domains daily. That can eat up an hour or two of every day,” Mr. Newell explains.

Mr. Newell has even filed trademark applications and found domains using the same mark the very next day. “It just shows the people who do this are keeping an eye not only on what's happening in business but also on the trademarks register,” he says.

## The Brand

Some prefer a more homegrown system of data management.

Alastair Rippon, IP & Brand Protection Director, Union-Swiss (Pty) Ltd. (South Africa), relies on tried and tested methods to manage the skin care brand's online protection.

“We are very diligent at recording relevant data that comes out of our various work streams. And then we ‘work’ the data as required,” explains Mr. Rippon.

“

**Data is the foundation of every investigation. You need others to do that, but you need data to start the process.**

”

Dan Shapiro

He notes that “odd as it may sound,” the brand just uses relatively simple MS Excel databases to record data. “I've looked around for various systems, but they seem expensive, and we find that working with Excel we're forced to understand the related processes,” Mr. Rippon says. “It's about the flexibility you have to evolve and improve your system.”

He admits he might try an “off-the-shelf” service, but it would have to be customized to his brand's situation.

“For us, the fun of working is looking for a better way ... or the best way, for our specific needs,” he says.

## The ‘Brand Intelligence’ Provider

One man who has been recording, shifting, and analyzing e-commerce data since the early days of web marketplaces is Dan Shapiro, Director, Global Strategic Partnerships, Red Points (USA).

Mr. Shapiro spent eight years at eBay Inc. (USA), where he created the auction site's first-ever brand protection team. Now at Red Points, he represents one of the many service providers in the competitive “brand intelligence” industry.

“Data is the foundation of every investigation. You need others to do that, but you need data to start the process,” Mr. Shapiro says.

During the past decade or so, he has seen e-commerce take a bigger and bigger slice of brands' overall revenue.

“It used to be that 25 percent of a brand's business came from brick and mortars. Today we have brands signing up to Red Points that are 100 percent e-commerce and don't have any brick and mortar stores,” he said. “We're seeing new marketplaces pop up every week. They may be transactional, like Alibaba, or peer-to-peer like Craigslist, but this changes the face of e-commerce.”

The problem of counterfeiting has been exacerbated by the growth of social media platforms. Legitimate selling spaces have teams dedicated to removing illegitimate sellers. But it is the users, or those masquerading as users, that have turned social media counterfeiting into a trillion-dollar industry.

Says Mr. Shapiro: “I'm talking about selling within posts on Facebook, Instagram, Twitter, WeChat, Pinterest ... all these places where a user claims to have an ‘authentic Manchester United jersey. Let me know if you're interested.”

It's no wonder that companies like Red Points use data search software. With billions of items for sale, the old method of brand protection—people physically searching the web—is simply not scalable to meet the challenge.

“As a brand intelligence provider you need to use technology to solve a technological problem,” Mr. Shapiro emphasizes. But there is more to the data hunt than understanding what is being counterfeited and where.

Other tasks are more complex, like combatting the issue of “price compression.” In this scenario, which Mr. Shapiro has “seen 100 times,” a counterfeit product is sold at a reduced price for so long that customers get used to it—and then reject the original as being too expensive.

This results in a nasty surprise for brand owners, when an expected uptick in sales does not materialize.

The methods used to crunch data across the intellectual property industry vary alongside the various different approaches to brand protection. There is no one-size-fits-all approach. The only constant is the growing number of counterfeiters. ●

“

**We are very diligent at recording relevant data that comes out of our various work streams.**

”

Alastair Rippon



# Finding the Right Brand Balance

The Internet has revolutionized the way brands reach their customers, but it's also forced them to tackle new threats. Sarah Morgan reports.

If you're looking for practical tips on how to protect your brand online, Session **RW20 Regional Update: How Do Brand Owners Balance the Benefits versus Risks of Joining Social Media and E-commerce?** (Wednesday, 11:45 am-1:00 pm) is not to be missed. Presenters will specifically address trademark-related issues surrounding e-commerce in China, Hong Kong SAR, Japan, South Korea, and Taiwan.

The rise of social media and e-commerce presents myriad opportunities for brand owners, creating new markets, and opening new channels to access existing markets, says Benjamin Morris, Partner at PI IP LAW (LEE, PARK & MORRIS) (South Korea).

However, along with these new opportunities comes an array of new dangers, as brands attempt to navigate an online environment.



Of particular concern to Mr. Morris is the potential for infringers to evade current controls.

"Many online platforms have already put in place mechanisms for taking down infringing contributors to their platforms," he says. "In many cases, the take-down policies follow a very simple algorithm. It is easy to see how such a system can be abused by third parties to potentially disrupt legitimate operations by simply filing illegitimate complaints."

The ease with which users can create anonymous accounts on social media platforms only increases the risk of infringement. Mr. Morris adds that anonymous accounts can make it very challenging for intellectual property (IP) owners to take legal action, "since it may be very difficult or even impossible to determine the identity of an infringer."

Christine Chen, Partner at Winkler Partners (Taiwan), cites the issue of authenticity as both the biggest opportunity and the biggest threat.

"Consumers are increasingly aware of those brands that stray from their

values or beliefs, and aren't afraid to call them out on it. In fact, calling out brands is now even easier—your brand can lose value overnight if it's the target of a campaign on social media," says Ms. Chen. How you handle the crisis can make or break your brand.

At the same time, she adds, if how you present your brand online resonates with consumers, "then you are in a great position to attract even more loyalty. But it has to be authentic," she adds.

At today's session, Ms. Chen will share why it's important for brands to take a serious look at e-commerce and social media opportunities in Taiwan. Taiwan is "often overlooked but boasts a well-developed economy and recently ranked as the 17th richest country in the world," she notes. "Taiwan is an exciting place to connect with consumers as people are open to products from both the East and West."

Rosita Li, Partner at Mayer Brown (Hong Kong SAR), and moderator of the panel, will share best practices for the Hong Kong and China markets. She will discuss how the Chinese social

media landscape is "changing and becoming more open to IP protection, but at the same time making it more difficult for brand owners to prove they own their IP."

Session attendees will also gain insight into recent trademark infringement cases centered on adwords and keywords in South Korea, including tax obligations for brand owners advertising via YouTube in Taiwan.

Hitomi Iwase, Partner at Nishimura & Asahi (Japan), will talk about the risk related to the use of social media in marketing in Japan.

"The use of social media is a powerful and effective marketing tool, but once an incident happens, it can affect a lot as well. Companies should be aware of the risks and be prepared for them," he concluded. ●



Rosita Li

“  
(The Chinese social media landscape) is changing and becoming more open to IP protection  
”



Christine Chen

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Taiwan is an exciting place to connect with consumers as people are open to products from both the East and West.  
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7:30AM	2:00PM	Registration	Hall B1
7:30AM	2:00PM	Hospitality	Hall A
8:00AM	9:00AM	Sponsors Breakfast <i>(By invitation only)</i>	151 A
8:00AM	10:00AM	Continental Breakfast	Hall A
8:00AM	10:00AM	BREAKFAST TABLE TOPICS	253 BC
		COMMITTEE MEETINGS	
8:00AM	10:00AM	Resources Group	253 A
8:00AM	10:00AM	Communications Group	252 A
8:00AM	10:00AM	Advocacy Group Council	257 AB
8:30AM	10:00AM	Financial Services Industry Group	151 B
9:00AM	10:00AM	Canadian and Australian IPO Meeting	153 C
9:30AM	10:30AM	2020 Europe Conference	153 B
10:00AM	2:00PM	Exhibition Hall	Hall A
		COMMITTEE MEETINGS	
10:15AM	11:15AM	Global Advisory Councils Co-Chairs and Staff Liaisons	252 B
		CONCURRENT SESSIONS	
10:15AM	11:30AM	CW01 Annual Review of U.S. Federal Case Law and TTAB Developments	Ballroom East - West
10:15AM	11:30AM	CW02 Abolishing Graphical Requirement: Impact and Practical Examples of This New (Non) Requirement Before EUIPO and EU National Offices	205 AB
10:15AM	11:30AM	RW01 Regional Update: Protecting Technology in Africa	210 C
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START	END	NAME	LOCATION*
10:30AM	11:30AM	<b>SPEED NETWORKING</b>	Hall A
10:30AM	12:00PM	In-House Practice of the Future Think Tank Expert Group	259 A
		<b>COMMITTEE MEETINGS</b>	
11:30AM	12:30PM	Latin American Corporates	151 B
11:30AM	12:30PM	Group Officers and Staff Liaisons	252 A
11:30AM	12:30PM	Bad Faith Group	152
		<b>CONCURRENT SESSIONS</b>	
11:45AM	1:00PM	CW20 Mastering the Protection of GUI	205 AB
11:45AM	1:00PM	CW21 Advertising and Branding Restrictions (Interplay of Regulatory, Right of Publicity, and TM Issues)	210 AB
11:45AM	1:00PM	RW20 Regional Update: China—How Do Brand Owners Balance the Benefits versus Risks of Joining Social Media and E-commerce?	210 C
		<b>COMMITTEE MEETINGS</b>	
12:00PM	1:00PM	Media, Music, Entertainment, Arts and News Industry Group	151 A
12:00PM	1:00PM	<b>SPEED NETWORKING</b>	Hall A
		<b>COMMITTEE MEETINGS</b>	
1:00PM	1:30PM	Enforcement/Anticounterfeiting South Asia Meeting	152
1:00PM	2:30PM	Intellectual Property Constituency (IPC) Meeting	205 C
1:00PM	3:00PM	INTA Foundation Meeting	102 A
1:15PM	3:15PM	<b>LUNCHEON TABLE TOPICS</b>	253 BC
7:00PM	11:00PM	<b>Grand Finale - A Night of Experiments</b>	Museum of Science

Grand Finale shuttles will be provided and will be making roundtrips for the duration of the event beginning at 6:30 pm until 12:00 am, focusing on returns beginning at 9 pm. If you are in a hotel that is on the daily shuttle route, shuttles will pick up from the same location. Registrants at Westin Boston Waterfront, Aloft, and Element Hotels will take the shuttle from the D Street Entrance outside the Westin Waterfront Hotel. Guests at the Renaissance Waterfront will pick up the shuttle on Congress Street, and Yotel Guests will pick up on Seaport Blvd. This is Route #7 for the Grand Finale ONLY.

Remember to bring your badge or Grand Finale wristband to board the shuttle and to enter the Grand Finale, as no registration will be available on the shuttle and you will not be allowed entrance without either.



The launch sequence of IPC Renew, by IP Centrum, marks the final few weeks of the renewals industry as we've all known it to date.

After five years of development, we are proud to finally introduce to the world's greatest IP formalities professionals, the future of renewals.

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### ipcrenew LAUNCH SEQUENCE

