

# WIPO



WIPO/ACE/3/4

ORIGINAL: English

DATE: April 26, 2006

WORLD INTELLECTUAL PROPERTY ORGANIZATION  
GENEVA

E

## ADVISORY COMMITTEE ON ENFORCEMENT

Third Session  
Geneva, May 15 to 17, 2006

EDUCATION & AWARENESS-BUILDING INITIATIVES OF INTERNATIONAL  
TRADEMARK ASSOCIATION (INTA) ON TRADEMARK PROTECTION  
AND ENFORCEMENT\*

*Document prepared by Ms. Toe Su Aung, General Counsel,  
BATMark Limited, Chairperson, Anti-counterfeiting and Enforcement Committee,  
International Trademark Association (INTA)*

---

\* The views and opinions expressed in this paper are those of the author and not necessarily those of the World Intellectual Property Organization (WIPO) or its Member States.

EDUCATION & AWARENESS-BUILDING INITIATIVES OF INTERNATIONAL  
TRADEMARK ASSOCIATION (INTA) ON TRADEMARK PROTECTION AND  
ENFORCEMENT

***INTRODUCTION***

The International Trademark Association (INTA) is a not-for-profit membership association of more than 4,900 trademark owners and professionals, from more than 180 countries, dedicated to the support and advancement of trademarks and related intellectual property as elements of fair and effective national and international commerce.

The Association was founded in 1878 by 17 merchants and manufacturers who saw a need for an organization “to protect and promote the rights of trademark owners, to secure useful legislation and to give aid and encouragement to all efforts for the advancement and observance of trademark rights.” After 128 years, INTA continues its mission to represent the trademark community, shape public policy and advance professional knowledge and development.

Along with its leadership, INTA’s most important asset is the talented and committed group of volunteers, like me, who serve on its committees. INTA’s goal is to make the best use of these vital resources to serve best the international trademark community.

***IMPORTANCE OF TRADEMARKS/INTELLECTUAL PROPERTY TO GOVERNMENTS, CONSUMERS,  
SOCIETY AND ECONOMY***

INTA considers that intangible business assets like trademarks have never been as important as they are considered at the dawn of this third millennium. Trademark rights are now recognized as a property right which has an economic value and contributes to the overall value of a business and which can be owned and sold. Therefore, understanding the legal mechanisms for protecting such rights has undoubtedly become increasingly important to national economic policy makers worldwide. It is in the interest of countries to have the strongest enforcement mechanisms possible to protect the investment climate and labor markets and to reduce the loss of tax revenues that are directly affected by the lack of efficient enforcement mechanisms and protections against trademark counterfeiting.

INTA being a global community of thousands of trademark professionals helps its members by providing :

- the opportunity to influence public trademark policy,
- access to an international community of peers, trademark professionals and owners, through a wide variety of networking opportunities and the *INTA Membership Directory*, and
- access to authoritative, relevant and timely information on global trademark law through INTA’s many educational programs, print and online publications and resources.

The education and awareness building activities of INTA can broadly be classified in three areas, namely: Information & Publishing, Education & Training/ Networking & Benchmarking, and Policy Development & Advocacy. Let me briefly discuss each of these.

### ***INFORMATION & PUBLISHING***

INTA's array of information resources help companies stay current on the cutting edge trademark issues that affect their businesses and economies where they have business interests. To name a few important INTA publications:

***The Trademark Reporter® (TMR)*** - a bimonthly journal containing articles that contribute to the scholarly discussion and exploration of all aspects of trademark law.

***The INTA Bulletin*** – a biweekly newsletter with up-to-date news on Association issues, trends in trademark law practice and procedure, and legislative activity and business developments.

***The Practitioner's Guide to the Madrid Agreement and Madrid Protocol*** - a searchable online database of practical information on the local application of both treaties in the member countries, which provides guidance on the application of local practice and procedure in obtaining, maintaining, licensing and enforcing registrations obtained through the Madrid system.

***The International Opposition Guide (IOG)*** – a searchable online database that allows comparative analysis of the availability and feasibility of trademark opposition in 130 jurisdictions worldwide.

***Country Guides*** – a searchable online database of current information on trademark filing, prosecution, registration and maintenance in more than 90 jurisdictions.

### ***EDUCATION & TRAINING / NETWORKING & BENCHMARKING***

INTA's educational programs and leadership development opportunities allow one to keep current on trademark issues, protect one's company's intellectual property assets and meet with experts worldwide. INTA's most popular and prestigious events include:

***The INTA Annual Meeting*** – the largest and most prestigious meeting of the international trademark community, with more than 7,000 participants from more than 130 countries taking advantage of five days of educational programs, committee meetings, exhibits, social events and networking opportunities.

***E-Learning*** – customized, Internet-based educational programs providing an innovative way to obtain trademark knowledge efficiently while avoiding travel and lodging costs.

***Forums*** - comprehensive and practical analysis of a variety of relevant and timely trademark issues, presented in a multi-day format.

**Roundtables** - popular two-hour discussions on current trademark topics, held in numerous cities throughout the world.

**Workshops** - intensive half-day educational programs on basic trademark law topics, providing invaluable tools of the trade.

**Distance Learning** – live, real-time presentations, broadcast to various locations simultaneously, allowing in-depth discussions between sites without the need for travel.

**Webcasts** - online seminars covering emerging issues in trademark law presented live via the Internet, providing access to relevant topics from a computer anywhere in the world.

### ***POLICY DEVELOPMENT AND ADVOCACY***

As the leading advocate for the interests of trademark owners, INTA fosters the development of effective trademark laws and procedures, and the harmonization of their application worldwide. INTA represents its members' intellectual property interests in a many ways.

**Policy Development** - Governments rely on INTA's expertise on trademark issues and value the Association's reputation for insightful and reasoned commentary. INTA works to protect trademark rights worldwide by:

- promoting harmonization of trademark laws and procedures through model laws and examination guidelines;
- working with legislators on the drafting and introduction of new or amended legislation on trademarks, anticounterfeiting and other intellectual property matters;
- providing in-depth analysis of current trademark topics through white papers; and
- offering INTA's knowledge to courts through amicus curiae briefs.

**Advocacy** - INTA develops and maintains relationships with national, regional and international trademark offices, and influences the passage and implementation of legislation for more effective trademark enforcement. The Association's representatives work with government bodies and intellectual property organizations on the national, regional and international levels, including:

- the U.S. Congress and U.S. Patent and Trademark Office (USPTO);
- the European Commission, European Parliament and Office for Harmonization in the Internal Market (OHIM);
- the Association of Southeast Asian Nations (ASEAN);
- the World Intellectual Property Organization (WIPO);
- the World Trade Organization (WTO); and
- the World Customs Organization (WCO)

### ***INTA'S FUTURE OUTLOOK***

In the coming years INTA will continue to provide consistently excellent education, information, and services to its members, industry, trademark professionals, public officials and the general public around the world on trademarks and related issues. The Association will continue to reflect the scope and diversity of its membership through expansion of

international policy development and advocacy; education; information and services; and recruitment and involvement of new members.

And finally, INTA, in its global capacity, will continue to develop policies on critical trademark and related rights, increase the influence of trademark owners, and to shape public policy by advocating Association positions in treaties, legislation, regulations and cases.

Thank you.

## APPENDIX

**ENFORCEMENT COVERAGE IN INTA PUBLICATIONS**

INTA provides valuable information to help protect trademarks, perform trademark research more efficiently, and make informed legal and business decisions.

*ONLINE PUBLICATIONS (AVAILABLE FREE ONLY TO INTA MEMBERS):*

***Country Guides: Basic Information on Trademark Registration Worldwide***

Searchable online database that provides access to practical information on trademark filing, prosecution, registration, maintenance and enforcement in more than 90 jurisdictions.

***International Opposition Guide***

Searchable online database of basic, practical information on the structure of trademark opposition and related practices in jurisdictions worldwide. Content covering 130 jurisdictions worldwide enables practitioners to quickly assess the availability, feasibility and merits of pursuing opposition before incurring costs or retaining a local representative.

***Practitioner's Guide to the Madrid Agreement and Madrid Protocol***

Searchable online database of practical information on the local application of both treaties in the member countries. It offers guidance on the application of local practice and procedure in obtaining, maintaining, licensing and enforcing registrations obtained through the Madrid system, and compiles detailed information about how each jurisdiction treats marks extending to it. The searchable database also includes text treatments of the history of the Madrid treaties, use of the system and strategic considerations of whether, and how, to take best advantage of the system.

***PRINT PUBLICATIONS***

Some of the print resources that cover enforcement issues include:

***The Community Trade Mark***

This book offers commentary and analysis on core tenets, the pertinent regulations and implementing rules, application contents and procedure, search considerations, registrability, seniority, oppositions and observations, grounds for revocation, assignments and other transfers of marks, infringement, litigation and free movement of trademarked goods and enlargement of the EU. Included in the Appendix are full texts of the Regulation and Implementing Rules, reference copies of the Application and General Authorization forms, the Guidelines Concerning Procedures Before OHIM (General Provisions, Examination Guidelines, Opposition Proceedings), and current information on obtaining OHIM and ECJ case law via the Internet.

***Famous and Well-Known Marks - An International Analysis***

This invaluable guide prepared by 32 leading practitioners explores the rationale, history and implementation of the protection of famous trademarks. Famous and well-known trademarks generate a commercial magnetism of such exceptional power that protection of these

trademarks requires an expansion of legal principles beyond the traditional concepts of trademark and unfair competition law. This publication covers the principles and practice of this evolving body of international law and includes a website application that provides a searchable database by jurisdiction and marks that have been recognized as famous or well known.

### ***Trademark Anticounterfeiting in Asia and the Pacific Rim***

This practical reference defines the problem of trademark counterfeiting and proposes strategies for administering a concerted, effective program for dealing with it both generally and, specifically, in 14 key countries in Asia and the Pacific Rim. Part I frames the pertinent issues in the context of discussion of the impact of global marketing, economic considerations, the efforts of worldwide, regional and national entities to foster better trademark protection, and the challenge of effectively designing and implementing a well-crafted anticounterfeiting program that produces results. Key to translating this wealth of knowledge to targeted action are the Country Profiles in Part II, which present comprehensive individual treatments of pertinent law and practice in 14 countries in the region. Prepared by expert local counsel, these profiles offer insight and opinion on the implementation of the international regime for trademark protection afforded by the TRIPS Agreement, including background on the civil and criminal judicial systems, remedies and supplemental statutory, regulatory, and strategic means of deterring counterfeiters.

### ***Trademark Law Handbook***

This excellent reference is part of an ongoing annual series that covers important developments in both U.S. and international trademark and unfair competition jurisprudence. Yearly reviews provide commentary on need-to-know developments in trademark law and practice.

### ***The Trademark Reporter*<sup>®</sup>**

The Trademark Reporter<sup>®</sup> (TMR) is INTA's bimonthly (six issues per year) legal journal that contains articles by authors who wish to contribute to the scholarly discussion of all aspects of trademark law. The first two issues of every year are dedicated to the Annual Reviews: the January-February issue is the United States Annual Review and the March-April issue is the International Annual Review (IAR). The other four issues contain scholarly articles on trademark-related topics and, from time to time, special features such as book reviews of new and noteworthy trademark publications.

The TMR has been a fixture in the International Trademark Association since 1911 and is one of the most long-standing and well-respected institutions of INTA and the trademark community. The TMR is free to INTA members and is available both in print and online. Subscriptions are also available to schools, public libraries and government agencies

The TMR is read by over 4,900 trademark practitioners, judges and academics throughout the world. The TMR has always been at the forefront of covering new developments in trademark law and at INTA. This prestigious history and reputation of the TMR attracts a wide range of authors who wish to write articles that explore timely trademark topics.

Selected articles from 1994:

- Consumer Literacy and Confusing Similarity of Pictorial Trademarks in Nigeria
- Commentary on Recent Changes to the Canadian Trade-Marks Act

- Preliminary Discovery Procedures, Precautionary Measures and Remedies in Italian Litigation
- Developing Industrial Property Laws in Cuba
- Heading Them off at the Pass - Can Counterfeit Goods of Foreign Origin Be Stopped at the Counterfeiter's Border
- Rights of Trademark Owners to Require Canada Customs to Seize Infringing Goods Have Been Strengthened by NAFTA
- Protection of Geographical Indications in the Wake of TRIPS: Existing United States Laws and the Administration's Proposed Legislation
- Revision of the German Trademark Law

Selected articles from 1995:

- Interlocutory Measures in the Defense of Trademarks in Italy - Strategies and Procedural Techniques in the Light of Recent Legislative Reforms
- Trademark Licensing in Canada
- Similarity and Other Issues in Japanese Trademark Law
- Recent Developments and Imminent Changes in Nigerian Trademark Law and Practice

Selected articles from 1996:

- Protection of Geographical Indications in the TRIPs Agreement
- Well-Known and Famous Marks: Is Harmony Possible in the Global Village
- Lookalikes under the New United Kingdom Trade Marks Act 1994
- Comparative Advertising - Should It Be Allowed in the United Kingdom
- References to the European Court of Justice for a Preliminary Ruling in Trademark Matters
- Benelux Trademark Act: A Guide to Trademark Law in Europe
- McDonald's Case: South Africa Joins the Global Village
- United States Customs' Protection of Registered Trademarks: Has Technology Rendered Customs Recordation Unnecessary

Selected articles from 1997:

- European Community Trademark: Effects of Seniority and Conversion in Former Colonies and Protectorates
- Is the Purpose of the Trademark Law Limited Only to Protecting Purchasers - Analysis under United States and German Trademark Law
- Trademark Use in Canada
- Nature and Scope of Trademark Provisions under TRIPS and the Pan-American Convention
- Domain Name-Related Infringement Procedures in Germany
- Internet Issues in the United Kingdom

Selected articles from 1998:

- Russian Highest Judicial Authority in Commercial Law Issues a Letter Interpreting the 1992 Russian Trademark Act
- Towards a European Consumer - Protection against Misleading Advertising in Europe
- Silhouette Case: The European Union Moves to the Highest Common Denominator on the Gray Market Question



- Threatening Trademark Infringement Proceedings in the United Kingdom - The Impact of the Trademark Threats Provision
- German Courts Implement the EU Directive 97/55/EC - A Fundamental Shift in the Law on Comparative Advertising
- Should We Use Guns and Missiles to Protect Famous Trademarks in Europe

Selected articles from 1999:

- Territoriality and Exhaustion of Trademark Rights under the Laws of the North Atlantic Nations
- Towards Implementation of the Madrid Protocol in the United States
- Semi-Generic Geographical Wine Designations: Did Congress Trip over TRIPs

Selected articles from 2000:

- Locating Geographical Indications - Perspectives from English Law
- Protection of Well-Known Marks in Taiwan: From Case Study to General Theory
- Tips from the Office for Harmonization in the Internal Market (Trademarks and Designs) (OHIM)
- Amicus Letter of the International Trademark Association in Glaxo Group Limited v. Dowelhurst Limited and Swingward Limited
- Amicus Letter of the International Trademark Association in IKEA Inter-Systems Inc. v. Beijing Cinet Co. Ltd.

Selected articles from 2001:

- Application of the European Rules on Trademark Exhaustion to Extra-Market Goods
- Revendication: Is It Appropriate for Trademark Piracy Cases
- Amicus Letter of the International Trademark Association in Libertel Groep B. V.
- Trademarks v. Domain Names - The Brazilian Experience
- Nice Agreement Revisited: Still a Class Act
- Amicus Letter of the International Trademark Association in Shield Mark B.V. v. J. Kist

Selected articles from 2002:

- Incorporal Curtain: The EEA Is Closed to Extra-Market Gray Goods
- Seniority under European Community Trademark Law
- Handling of Counterfeit Goods: A Hands-on Problem for the Italian Criminal System
- Avoiding Hague Convention Headaches - An Analysis of Lanham Act Section 1(E) Service of Process on Foreign Nationals
- Madrid Protocol: Impact of U.S. Adherence on Trademark Law and Practice
- Amicus Letter of the International Trademark Association in Intel v. PT Panggung Electronic Industries
- Amicus Letter of the International Trademark Association in Prefel SA v. Fahmi Babra et al.
- Amicus Letter of the International Trademark Association in Prefel SA v. Jae Ik Choi

Selected articles from 2003:

- Would Victoria's Secret Be Protected North of the Border - A Revealing Look at Trade-Mark Infringement and Depreciation of Goodwill in Canada
- Geographical Indications and Trademarks - The Road from DOHA
- Using the Madrid Protocol after U.S. Accession

- Is European Community Trademark Law Getting in Good Shape?
- After WTO Accession: Chia's Dilemma with the Trafficking of Fakes
- Crocker Revisited: The Protection of Trademarks of Foreign Nationals in the United States
- Article 82 of the E.C. Treaty and Trademark Rights
- What Must a Foreign Service Mark Holder Do to Create and Maintain Trademark Rights in the United States?
- Protection of Trade Dress and Color Marks in Australia
- Trademark Law in Belize: Implementation of GATT TRIPs in a Developing Country

Selected articles from 2004:

- Considerations regarding Dilution in Argentina
- Use of Arbitration and Mediation for Protecting Intellectual Property Rights: A German Perspective
- Protecting Colour Marks in Canada
- *Paranova v. Merck* and Co-Branding of Pharmaceuticals in the European Economic Area
- Trade Mark Licenses and the Technology Transfer Block Exemption
- Enlargement of the European Union: Trade Mark Issues in Hungary and Other New EU States
- Brand Name and Look-Alike Drugs in Canada after *Ciba-Geigy v. Apotex*: A Proposal for Relief from Slavish Imitation
- Sign of the Times - A Review of Key Trade Mark Decisions of the European Court of Justice and Their Impact upon National Trade Mark Jurisprudence in the EU
- Significant Trademark Developments in the Asia-Pacific Region
- Dilution of a Trademark: European and United States Law Compared
- Recent Developments in Comparative Advertising and Their Implication for Trademark Law in Germany

Selected articles from 2005:

- Protection of Famous Trademarks Against Use for Unrelated Goods and Services: A Comparative Analysis of the Law in the United States, the United Kingdom and Canada and Recommendations for Canadian Law Reform
- Well-Known Marks & China's System of Well-Known Mark Protection
- Recent Trends in Asian Trademark Law—Changes and Challenges
- Recent Trends in European Trademark Law: Of Shape, Senses and Sensation
- Amicus Letter of the International Trademark Association in *Bovemij Verzekeringen N.V. v. Benelux Merkenbureau*
- Amicus Brief of the International Trademark Association in *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. Les Boutiques Cliquot Ltee, Mademoiselle Charmante Inc. and 3017320 Canada Inc.*
- Amicus Letter of the International Trademark Association in *Tungsway Food & Beverage Holdings, Pte Ltd v. PT Istana Pualam Kristal*
- Geographical Indications and Trademarks in Europe
- Protecting Well-Known Trademarks: Perspectives from Singapore
- The Community Trade Mark and Design Court of Alicante and Forum Shopping Regarding European Community Intellectual Property Rights Litigation
- Protecting Trade Marks in Myanmar: Strategies for Foreign Trade Mark Owners
- Trademark Licensors and Product Liability Claims—A European Perspective

### ***INTA Bulletin***

As the voice of the International Trademark Association, this biweekly newsletter, sent to more than 5,500 INTA members, provides up-to-date news on Association issues, trends in trademark law practice and procedure, and legislative activity and business developments that affect trademarks in more than 180 countries. Some of the topics of *INTA Bulletin* Special Reports include:

### **Special Report on Trade Dress May 2005**

#### **Covers:**

- Trade Dress Survey Shows Surprising Results
- Design Protection Versus Trademark Protection in the European Union
- Making a "Clear Case" in the United States
- U.S. Customs Protection for Trade Dress
- Color Protection in the European Union
- Protecting Color Marks in the United States
- Best Practices for Registration of Product Configuration
- Trade Dress in the USPTO
- Trade Dress Within the Andean Community
- The McDonald's Case in Singapore and the Philippines
- Trade Dress Protection Available in China
- Analysis of *Wal-Mart* and *TraFFix* Under Brazilian Law
- When Are "Three-Dimensional Marks" Ordinary Trademarks?

---

### **Special Report on Counterfeiting September 2004**

#### **Covers:**

- What is Counterfeiting?
- Consumer Demand for Counterfeiting
- The Past and Present of International Efforts Against Trademark Counterfeiting
- Anticounterfeiting Milestones of the European Union
- Regional Anticounterfeiting Agreements
- Successful Global Enforcement Strategies
- Health and Safety Issues - Counterfeit Drugs
- Health and Safety Issues - Counterfeit Food and Beverages
- Buyers Beware of Counterfeit Toys
- Counterfeiting and Organized Crime
- The Economic Impact of Counterfeiting
- Success Stories
- References

---

### **Special Report on Dilution June 2004**

#### **Covers:**

- INTA Select Committee on the Federal Trademark Dilution Act
  - Dilution in the Andean Community, Australia and New Zealand, Brazil, Canada, the European Union and Germany, the Republic of Korea, Singapore, the United Kingdom and the United States
-

## **Special Report on Geographical Indications September 2003**

*Covers:*

- GI Protection Systems Around the World
  - Glossary
  - Comparing Positions
  - Perspectives
- 

## **Special Report on the Madrid Protocol April 2003**

*Covers:*

- Why the Protocol?
  - Corporate Perspective
  - Comparing Filing Procedures
  - Recent Members' Rules and Regulations
  - Madrid Educational Programming
- 

## **Special Issue on ADR October 2002**

*Covers:*

- Alternatives to the Courthouse
  - Trademark Mediation
  - Tips from the Experts
  - ADR Around the World
  - Stay Loyal to the ADR Process
- 

## **Special Issue on Domain Names August 2002**

*Covers:*

- UDRP: Online and On Target
  - Domain Disputes Around the Globe
  - Domain Name Strategy
  - Achieving Uniformity Within the Domain Name System
  - Resources for Domain Name Dispute Resolution
- 

## **Special Issue on China May 2002**

*Covers:*

- Trademark Practice in China and Beyond
- Managing International Portfolios
- In the Spirit of Exploration
- A Review of the Meetings
- A Brief Timeline

---

## **Special Issue on Counterfeiting October 2001**

*Covers:*

- To Catch a Counterfeiter
- The Art of Enforcement
- INTA's Anticounterfeiting Efforts in 2001
- World Update : Covers Counterfeiting Efforts in Europe, East Asia, Middle East and Africa
- Tales from the Front
- INTA Comments on WCO Model Provisions
- ACEC Future Training Initiatives

---

## **Special Issue on ECJ August 2001**

*Covers:*

- The European Court of Justice - What is it, what makes it tick?
- INTA Files Amicus Letter - Libertel case
- Influences and Precedents - Significant cases that have set an example for future rulings of the ECJ
- Future Challenges

---

## **Special Issue on China February 2001**

*Covers:*

- Why China, Why Now?
- Membership Initiatives Go Full Speed Ahead
- Current Status of China's WTO Accession
- Read About INTA's 18 New Members
- The First Chinese Trademark
- See what major Beijing and Shanghai newspapers had to say about INTA's involvement with China
- Become an INTA Recruiter

[End of document]