



Conference: "When Trademarks Overlap with other IP Rights"
December 8-9, 2014 | Munich, Germany
<http://www.inta.org/2014tmoverlap>

Background information

Join the International Trademark Association (INTA) in Munich, Germany, on December 8–9, 2014, at the Westin Grand Munich Hotel for two days of information-packed, advanced-level sessions. Presented by leading authorities in their field, these sessions will deal with these and other emerging issues concerning the overlap of trademark rights with other IP rights.

The overlap between trademarks and other intellectual property rights is everywhere—whether in registration, enforcement or commercialization. For example:

- A product design can be protected as a two- or three-dimensional mark, trade dress, design patent, registered design, unregistered design or a work of applied art under copyright law.
- An artistic work can be registered as a trademark, whether or not it is protected under copyright law.
- A geographical indication can be registered as such or protected as a collective or certification mark, under passing off or unfair competition law.
- A trademark can be subject to unfair competition law, comparative advertising statutes or consumer protection laws. A trademark, as used in blogs and social media, can involve rights of privacy and rights of publicity.

It is essential that trademark and other IP practitioners have a solid understanding of the many opportunities and pitfalls of intersecting rights. The intersection of these rights also raises fundamental questions about the nature of trademark law and its relationship to the other areas of IP protection, and how policy should best address these overlaps.

This conference is organized by the INTA's Programs and Related Rights Committees and with the kind support of the German Association for the Protection of Intellectual Property (GRUR).

Full Program

Monday, December 8

8: 00 am – 5: 30 pm

Registration and Information Desk Open

8: 00 am – 9: 00 am

Continental Breakfast

9: 30 am – 9: 35 am

Welcome

Etienne Sanz de Acedo, Chief Executive Officer, International Trademark Association (United States)

Axel Nordemann, Program Co-Chair, Boehmert & Boehmert (Germany)

Neil Wilkof, Program Co-Chair, Dr. Eyal Bressler & Co. (Israel)

9: 35 am – 10: 00 am

Keynote Address

Overlaid, Overlegislated and Overloaded: Trademarks in the Twenty-First Century

Professor Jeremy Phillips, best known as a Professorial Fellow in the Queen Mary Intellectual Property Research Institute and founder of the IPKat blog, will set the stage for this conference by describing how the lack of joined-up legislative policy and judicial thinking has led to a patchwork of protection in which some badges of origin seem to be protected several times over while others risk missing protection entirely.

Speaker:

Prof. Jeremy Phillips, Olswang LLP, London, and Queen Mary Intellectual Property Research Institute (United Kingdom)

10: 00 am – 1: 15 pm

SESSION I

(Break 11:30 am–12:00 pm)

Trademarks and Copyright Law

Distinguished speakers provide insight and valuable information about the interplay between the protection given by trademarks to works of art (for example, logos, characters such as Mickey Mouse or three-dimensional objects such as furniture) and the protection given such works by expiring copyright or registration despite public domain. They will also discuss sound marks and rights in music, the scope of protection of such trademarks and the influence of aesthetic functionality or requirement of use as a trademark.

Speakers favoring the extension of protection through trademark registration despite public domain under copyright law will also discuss important issues with speakers who give more weight to the public domain, superseding trademark protection.

Other topics to be covered:

- A view from the European Union
- A view from Latin America
- Protection and enforcement strategies

Moderator:

Tara Aaron, Aaron | Sanders PLLC (United States)

Speakers:

Andrew P. Bridges, Fenwick & West LLP (United States)

Barbarita M. Guzmán, Markven S.C. (Venezuela)

Maximilian Kinkeldey, Grünecker (Germany)

Axel Nordemann, Boehmert & Boehmert (Germany)

Ansgar Ohly, University of Munich (Germany)

Michael Ritscher, Meyerlustenberger Lachenal (Switzerland)

1: 15 pm – 2: 30 pm

Networking Lunch

2: 30 pm – 5: 40 pm

SESSION II

(Break 4:00 pm –4:30 pm)

Trademarks and Designs

Find out about various schemes that can be used to protect designs, including the following:

- Design patent protection (United States)
 - Trade dress (United States)
 - Community design rights (European Union)
 - Other schemes (e.g., Hague Agreement Concerning the International Registration of Industrial Designs, Asia-specific laws), focusing particularly on products and features that may be protected by both design rights and trademarks/trade dress
- Panelists will explore the following areas:

- The underlying frameworks of various types of rights and the rationale behind choosing particular types of protection
- Obtaining protection
- Limitations on protection and enforcement (including consideration of whether the available actions and remedies are adequate)
- Pros and cons of design protection versus trademark protection
- Registered versus unregistered protection

Moderator:

Mark Owen, Taylor Wessing (United Kingdom)

Speakers:

Anna Carboni, Redd Solicitors LLP (United Kingdom)

Daniel Greif, Siam Premier International (Thailand)

Annette Kur, Max Planck Institute for Intellectual Property, Competition and Tax Law (Germany)

Theophile Margellos, Office for Harmonization in the Internal Market (Spain)

Kenneth L. Wilton, Seyfarth Shaw LLP (United States)

5: 45 pm

Adjourn

6:00 pm–7:30 pm

Welcome Reception

Tuesday, December 9

8:00 am–8:30 am

Registration

8:00 am–8:30 am

Continental Breakfast

8:30 am–8:35 am

Overview of Day Two

Axel Nordemann, Boehmert & Boehmert (Germany)

Neil Wilkof, Dr. Eyal Bressler & Co. (Israel)

8:35 am–8:45 am

Related Rights Committee Update

Speakers:

Marion Heathcote, Davies Collison Cave (Australia)

Keri Johnston, Johnston Law (Canada)

8:45 am–10:30 am

SESSION III

Trademarks and Geographical Indications

Experts in the field provide a global perspective on the interplay of trademarks and geographical indications (GIs) and will discuss the following issues:

- What are GIs?
- How are they protectable in Europe?
- How does GI protection overlap with trademark protection in Europe?
- Is this protection too wide?
- How does it compare with protection elsewhere?
- Is this protection enforceable in courts in European countries?
- What are some of the important decisions of the Court of Justice of the European Union concerning the overlap of GIs and trademark protection?

These topics will be covered as well:

- The U.S. approach to GIs and trademarks
- GIs as collective / certification marks
- Attempts at the international level to negotiate a worldwide framework for GI protection
- The U.S. approach compared with the European approach
- GIs and trademarks in India from a global brand perspective
- GI protection in the European Union as collective marks and as protected geographical indications, and in the United States as certification marks
- The Darjeeling case

Moderator:

Anna Carboni, Redd Solicitors (United Kingdom)

Speakers:

Irene Calboli, Marquette Law School and National University of Singapore (United States and Singapore)

Peter Harvey, Harvey Siskind LLP (United States)

Julia Holden, Trevisan & Cuonzo Avvocati (Italy)

Latha R. Nair, K & S Partners (India)

10:30 am–11:00 am

Break

11:00 am–1:00 pm

SESSION IV

Trademarks and Unfair Competition Law

A comprehensive discussion will cover the following topics:

- Registered versus unregistered trademarks
- Passing off and unfair competition
- Trademark protection
- Comparative advertising
- Keyword advertising
- Product imitation and other forms of source and source-like confusion versus trademark infringement
- Overlap paradigms
 - Does trademark infringement correspond to claims under unfair competition law? If so, are there still separate legal claims?

- Does trademark law cover all potentially actionable uses of signs? If so, will unfair competition law “fill in” the lacunae?
- Trademark/unregistered marks/unfair competition overlaps: conceptual overview of the common law and continental law approaches
- The view from Continental Europe
- The common law view
- The view from South America

Moderator:

Axel Nordemann, Boehmert & Boehmert (Germany)

Speakers:

Gordian N. Hasselblatt, CMS Hasche Sigle (Germany)

Myrtha Hurtado-Rivas, Novartis AG (Switzerland)

Anselm Kamperman Sanders, Maastricht University (Netherlands)

Neil Wilkof, Dr. Eyal Bressler & Co. (Israel)

1:00 pm–3:00 pm

Lunch

Special Lunchtime VIP Interviews—Trademarks and Patents

Interviewer:

Ronald Van Tuijl, JT International S.A. (Switzerland)

Special Guests:

Christoph Ernst, Ministerialdirigent, German Federal Ministry of Justice (Germany)

Mihály Ficsor, Vice President for Legal Affairs, Hungarian Intellectual Property Office (Hungary)

3:00 pm–5:35 pm

SESSION V

(Break 4:15–4:30 pm)

Overlap Between Trademarks and the Right of Publicity

This session will address the interplay between the right of privacy or publicity and trademark rights, including implications for the use of trademarks in blogs and social media networks.

Learn about the following:

- The differences and similarities between the rights afforded by publicity laws and the rights afforded by trademarks—e.g., what each type of right protects, whether they are property rights, whether the rights can be transferred?
- Source of trademark rights and right of publicity in the law
- How rights of publicity overlap with trademark rights
- How publicity rights are used to generate trademark rights
- How rights of publicity can invalidate trademark rights (United States versus other jurisdictions on rights in a personal name as a trademark)
- Celebrity names registered as trademarks (e.g., BLUE IVY); when celebrities sell their names, who owns the goodwill behind the name
- Protection of likenesses of fictional characters and the actors who play them
- Remedies for infringement
- Interplay between right of privacy or publicity and trademark rights, including implications for the use of trademarks in blogs and social media networks

Moderator:

Kenneth L. Wilton, Seyfarth Shaw LLP (United States)

Speakers:

Tara Aaron, Aaron | Sanders PLLC (United States)

Mario Soerensen Garcia, Soerensen Garcia Advogados Associados (Brazil)
Mark Owen, Taylor Wessing (United Kingdom)

5:35 pm–5:45 pm

Wrap Up, Adjournment

Project Team

Exceptional topics, faculty and presentations have come to distinguish INTA programs and earn them an unmatched reputation in the field of trademark law and practice. INTA owes this achievement to the many volunteers who so willingly contribute their time and energy to this effort.

INTA would like to thank the Project Team for its excellent work in planning and presenting this conference.

Co-chairs

Axel Nordemann, Boehmert & Boehmert (Germany)
Neil Wilkof, Dr. Eyal Bressler & Co. (Israel)

Members

Tara Aaron, Aaron | Sanders PLLC (United States)
Anna Carboni, Redd Solicitors (United Kingdom)
Julia Holden, Trevisan & Cuonzo (Italy)
Mark Owen, Taylor Wessing (United Kingdom)
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