

INTA Boston: Highlights from Bean Town

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Photo courtesy of Dorsey Partner, Marcus Simon

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If you missed the 2019 Annual Meeting of the International Trademark Association in Boston, or if you were there but were spending time with colleagues and friends, the Dorsey trademark team is here to provide a brief overview of some interesting seminars we attended and tidbits scooped up during the Meeting:

Fictional Characters: Dorsey's very own Jeff Cadwell (Minneapolis office) kicked things off for a packed room on Saturday by moderating a session called "Character Wars." The panel focused on the intersections of trademark and copyright law relating to the protection of fictional characters. Jeff was joined by panelists Michael Lovitz, Chantal Koller, and Christopher Smith, who spoke about US law, European and Swiss law, and Chinese law, respectively. The panel explored options for registration of rights, what sort

of unregistered protection may exist, enforcement tools, and merchandising considerations.

Trademark Investigations: With participants from the United States, China, Europe, and Mexico, this panel addressed the ethical contours of trademark investigations in various countries around the world. These types of investigations can be a crucial component for both enforcement and prosecution efforts and require special ethical considerations that vary depending on the jurisdiction.

For example, in the United States, evidence gathered illegally or unethically by an investigator can render the evidence inadmissible in a contested proceeding. Additionally, evidence gathered by an attorney might also be inadmissible due to ethical conflicts with an attorney acting as a fact witness. In China, evidence needs to be notarized to be admissible; notarization in China can be extremely expensive. Accordingly, in situations where a party is considering petitioning to cancel a registration for non-use in China, it can sometimes be less expensive to simply file the proceeding and see what happens rather than conduct a formal investigation to gather admissible evidence. Unlike in the United States, in Europe, attorneys are generally not prohibited from presenting evidence they have collected. In Mexico, a court will accept an investigation report, but will independently confirm the facts presented therein.

With so many considerations at play, it behooves brand owners and trademark attorneys to consult with local counsel prior to conducting an investigation outside of their home jurisdiction.

Blockchain: Chances are that you've heard the buzzword "blockchain" sometime in the past two years. Whether it be in the context of Bitcoin's meteoric rise (and subsequent fall) or in the many other tech products based on the concept. This session discussed the potential solutions blockchain may offer to IP attorneys and consumer brands. "Blockchain" is a distributed ledger technology that houses a record of transactions on computers linked across a peer-to-peer network.

In the context of the IP world, blockchain has numerous potential applications, including:

- Supply chain shipment tracking for anti-counterfeiting efforts (i.e., the ability track and verify the shipment of original products)
- Brand messaging (i.e., ability to verify where and from whom a message originated)
- Copyright royalty administration (i.e., more accurate accounting of number of plays of a given copyrighted song for mechanical royalties)
- Verification and housing of trademark registers (i.e., instant access to a verifiable ledger of trademark registrations)

With all of the potential uses of blockchain, major intellectual property organizations are paying attention. For example, the World Intellectual Property Organization (WIPO) has created a task force to investigate possible uses of blockchain for creating a distributed IP registry. In fact, WIPO held a workshop in April 2019 focused on potential uses of

blockchain.

While the future of cryptocurrencies may be uncertain, it is clear that the underlying blockchain technology will continue to reverberate in the tech world and, it appears, in the legal community.

Artificial Intelligence (“AI”): AI was also a hot topic at INTA, with many speculating as to how to solve common trademark law problems with AI as the technology evolves and develops. We learned that AI already exists to help identify key and missing terms in certain contracts, but we are only on the cusp of what AI can accomplish for more particular trademark tasks, such as searching and clearance or for determining likelihood of confusion based on consumer impressions. As it turns out, trademark law remains heavily dependent upon human perceptions. AI can also be cost prohibitive for most firms and businesses, and reliance upon AI for providing legal opinions can impose its own set of risks. Nevertheless, AI has arrived and those who can utilize it to their benefit now will be ahead of the competition.

Updates from the USPTO and TTAB: USPTO leadership held a transparent session on new updates—all aimed to make the Office more efficient and streamline processes. All practitioners will eventually need a USPTO.gov account, so log into your MyUSPTO account and make sure to keep it updated. We also learned that opposition and cancellation proceedings before the TTAB have increased over 10%, and that more practitioners are taking advantage of accelerated case resolution. Meanwhile, the chances of a successful TTAB appeal remain slim: Likelihood of affirmance of a Section 2(d) likelihood of confusion refusal was about 91% for calendar year 2018, and likelihood of affirmance of a Section 2(e)(1) mere descriptiveness refusal was about 90% for 2018—both figures slightly higher than for 2017.

Hot Trademark Cases: Trademark law remains as exciting as ever. Perhaps the hottest trademark case of the year was the most unmentionable (*In re Brunetti*). On the heels of “The Slants” case, the Supreme Court’s upcoming decision about the fate of the FUCT trademark promises to give us all plenty to talk about concerning indecent or scandalous marks. The other hot trademark law decision, *Mission Product Holdings, Inc. v. Tempnology, LLC*, issued the week of INTA. At last, we can be sure that trademark licensees rejected by bankruptcy debtors may continue to use licensed trademarks.

We hope to see you in Singapore in 2020!