

LESI Committee Report
Summary of activity (April 2015- April 2016)

Committee : Trade mark, Design and Merchandising Committee

Chairs : Johan du Preez
: Stefan Völker

Vice Chairs : Corrine Sukluennik
: Gökce Yilmaz

1. Projects/ workshops carried out during this period.

- Conducting one workshop at 2016 International Conferences. Title: Geotargeting and Geoblocking - W6 – 14:00 – 15:30 (Summary of the workshop is attached)
- Dr Stefan Völker represented LESI, together with representatives from ASIPI, AIPPI, INTA, ASCAN, IPA, AUDAPI and AAPI at a work session during the 2015 INTA conference. A joint statement of Global IP Associations on Plain Packaging Measures in the Tobacco Industry was, finalized and it was presented to the LESI Board for approval.
- Simon Chalkley represented the Committee at the Winter Planning meeting in Lisbon.
- The Committee suggested a Title for a second workshop at the Beijing conference on “Aspects of non-traditional trademarks”. Unfortunately a slot was not awarded.

2. Projects that will continue, or start after the end of this period.

Trade Mark License Agreement

The Committee decided to resuscitate a project that was previously run by this committee considering a Trade Mark Licensing Agreement that will serve as a comprehensive document. A questionnaire will be prepared identifying aspects on which clarity is required:-

- points to be regulated ;
- language to be used;
- do's and dont's of License Agreements;
- similarities and differences in the various jurisdictions that we should take into account when preparing a license agreement;
- tax aspects; and
- whether the trade marks needs to be registered with the Registrar of Trade Marks for reasons such as whether it is a prerequisite for the validity of the license agreements ;

- it is a prerequisite for attribution, will use without registration be sufficient to preserve that right;
- is registration a prerequisite for action to be instituted against infringers; and
- the position of the Licensee should the Licensor become insolvent.
- Simon Chalkley will take the lead with the project.

Unreported decisions

The meeting discussed a project it is involved with and considered the fact that in most countries in Europe and the UK, cases are reported while in other regions it is not the case. It is often necessary to also consider unreported cases. Consensus could not be reached on whether the project should be continued with.

3. Committee meetings (including conference calls) held outside the Intl. Delegates Meetings.

Co-Chairs – Stefan Völker and Johan du Preez arranged a Conference call on 25 November 2015 (minutes of the call is attached). Members of the Committee come from many time zones and logistical problems are experienced.

4. Committee publications (including anything posted on the web).

-

5. How can LESI help the committee be more active next year?

It is difficult to get momentum going if Committee meets only once a year at the LESI Conference. Although one conference call was arranged during the year the Committee wished to arrange four conference calls during the year. The committee will look to Chris Katopis to schedule telephone conferences and to suggest suitable times.

6. Will your committee require funds in next year's LESI budget?

If so, provide the requested amount and a brief description of the project for which the money will be used.

The committee will require funds. It is increasingly difficult to get quality speakers that do not require that their travel and accommodation costs are at the very least be covered.

Report by: Johan du Preez

Date: 20 April 2016

LESI ANNUAL CONFERENCE IN BEIJING 2016

Summary of Workshop on Geotargeting and Geoblocking

(Monday, May 16, 2016, 14:00-15:30)

The internet provides the technology to make content of any kind available for download anywhere in the world. In contrast, intellectual property rights are limited to a specific territory. This formerly harboured the risk that a prohibition based on an intellectual property right handed down by a national court, which for example prohibits the use of a certain trade mark on a website, could (despite its scope being formally limited to a specific territory) de facto result in the owner of the website ultimately being prevented from using the sign on the internet worldwide. Today, geotargeting provides an effective remedy for this dilemma by enabling website owners to differentiate their web appearance/ trade mark use territorially. Geoblocking is an effective tool for preventing access to websites with content that infringes IP rights (such as copyrights). The object of the workshop is to discuss the impact of these new technologies on conflicts concerning IP rights, but also its uses in other areas; for example, geotargeting is increasingly the subject of licensing agreements (for instance regarding streaming of sports events for a limited territory on the internet.). There will also be a discussion on how key players on the internet (e.g. Google, Facebook, YouTube, Twitter, Apple, PayPal) employ geotargeting to effectively target different audiences.

Minutes

Conference Call: Trade Mark, Design and Merchandising Committee held on

Wednesday, 25 November 2015

Minute taken: Johan du Preez (Co-Chair)

Co-Chairpersons: Johan du Preez

Stefan Völker

Vice-Chairpersons: Corrine Sukluennik

Gökce Yilmaz

Attendees: Johan du Preez (LES South Africa) – johan.dupreez@adamsadams.com

Simon Chalkley (LES Britain Ireland) – simon@redd.eu

Chris Katopis (LES Administrative Office) – ckatopis@lesi.org

1. Present & Apologies

Johan du Preez (LES South Africa) acts as Chair of the first telephone conference hosted by the Trade Marks, Design and Merchandising Committee. He welcomed both attendees and minuted apologies received from:

- a) Stefan Völker (LES Germany)(Co-Chair)
- b) Audrey Yap (LESI Board member)
- c) Ken McKay (LES USA/Canada)
- d) George Hwang (LES Singapore)

2. Approval of the minutes of the previous meeting

The Minute of the meeting in Brussels, Belgium, as was circulated to the Committee, was discussed and accepted.

3. Matters arising

Matters arising from the Brussels meeting form part of the body of the agenda for this meeting and will be discussed under separate headings below.

3.1 Workshop at LESI 2016 Beijing meeting on Geotargeting and Geoblocking.

Moderator: Dr. Stefan Völker

Johan du Preez reported that the Committee had requested two speaking slots for Beijing and were awarded a workshop on Geotargeting and Geoblocking. Dr. Stefan Völker (Vice-Chair) will act as the moderator of the workshop and will also take control of the arrangements of the speakers.

Dr. Völker prepared a summary of the workshop to present to the Conference Organizers. A copy is attached to this minute. The Meeting agreed that this is a fascinating topic and that it would be interesting to listen to the various perspectives from different parts of the world.

As to paragraph 4.2 of the minute of the Brussels meeting, the Committee was informed that we were not awarded a workshop slot to discuss aspects of non-traditional trademarks. This is an aspect of Trade Mark Law that should be kept on the radar of the Committee because of the developments and different points of view in the different jurisdictions.

Johan du Preez raised an aspect he wished to discuss with the Committee and possibly also ask Audrey to discuss with the Board, namely the roll that the Committees play in the planning of International Conferences. This Committee is under the impression that it is the function and purpose of the LESI Industry, Professional and Regional Committees to submit titles for workshops for international meetings. These Committees are the first port of call for an International Organizing Committee putting together a program before an International Conference.

In the past three years 3 international conferences have been organized. In the one instance, this Committee was not approached at all for titles for workshops. For the upcoming international meeting, the Committee had to approach the organizers with a request for workshop slots. It would appear that, with the introduction of sponsorships into the LESI Conferences, a trend is developing where sponsors are afforded the opportunity to present workshops. As far as the Committee is concerned, this was never the intention when sponsorships were introduced.

3.2 Projects going forward: Trade mark Licensing agreement that will serve as a comprehensive document

The Meeting discussed this project and Simon Chalkley (LES Britain/Ireland) kindly volunteered to lead the project. He will, before the next meeting, circulate to the members of the Board a strategy and possibly also a list of questions for consideration and comment. Johan du Preez pointed out that the Committee had previously been

involved in a project of this nature. The meeting discussed what they wished to achieve with this project.

The Meeting agreed that they wished to produce a final product that differs from those published by the International Chambers of Commerce. Typically these documents provide for the requirements of Licensing in developed areas, but often fall short on aspects of Law in those areas where a great deal of trade takes place, for instance in third world countries, but where Licensing Law is not developed to the extent that it is in first world countries.

On this aspect, the meeting discussed, for instance, Licensing Law in Africa where the following points were made:-

- (a) A License Agreement often forms part of a larger commercial agreement that could incorporate all aspects of Commercial Law, i.e. Tax Laws, Exchange Control, Consumer Protection Laws, Competition Laws, Environmental Laws and the like.
- (b) What is the position in the Middle East and African territories where IP Laws are often determined by the regions earlier colonial history.
- (c) What is the position re free trade zones?

The meeting agreed that the Trade Mark License agreement the Committee wishes to develop must be in the format of a best practice document in the various areas, and must also consider the Laws in areas such as South America, Africa, Middle East, China as well as in those jurisdictions where licensing is a specialised field and widely practised.

3.3 Other future projects

The Committee briefly discussed future products of the Committee and reiterated:-

- (a) that non-traditional trademarks should not disappear off the radar and should be investigated in more detail;
- (b) although 3D printing was discussed in Brussels, it is such a wide and rapidly developing field that a proper workshop should possibly be considered in the future.

3.4 Unreported decisions: Project Quo Vadis

Johan du Preez indicated that this was a very valuable exercise, initiated by Martin Schneider, the previous Chair of this Committee. The results of those efforts should not be lost.

The background to this project was that there is a common belief that all court cases in the field of IP Law are, as a matter of course, reported and can easily be searched on various websites. This is not the case and, in a number of countries in South America and in Africa, decisions are made by courts that have far-reaching

consequences for License Agreements. We should therefore attempt to keep this project going.

3.5 Discussion of the Joint Statement of IP NGOs regarding plain packaging

Referring to the minutes of the Brussels meeting and more specifically the annexures to that minute, the Committee discussed the draft Plain Packaging measures – proposed Joint statement of global IP associations.

As a background to this matter, Johan du Preez explained that Co-Chair, Dr. Stefan Völker, had attended the INTA meeting after the LESI Brussels meeting earlier this year, where IP associations met to discuss the plain packaging measures imposed on the cigarette industry. The purpose of the meeting was to formulate a draft statement to be issued by the Global IP Associations. The result of that meeting is the draft document attached to the Brussels meeting.

Unfortunately Dr. Stefan Völker could not participate in the telephone conference and we therefore do not have the benefit of his comments. The Meeting agreed that the views expressed in that statement, against the background of the workshop that was hosted by this Committee in Brussels on Plain Packaging, reflect the point of view of this Committee.

While we await Dr. Völker's comments in this regard, the Committee would like to clarify what happened to this report –

(a) Was it again discussed by the parties present at the INTA meeting?;

(b) Were any reports forwarded to that committee, expressing LESI's position?

Depending on the answers above, the Committee will make further recommendations to the Board.

4. Articles for Les Nouvelles

The Committee confirmed that we are still awaiting the article that was to be prepared by the Moderator and Speakers in Brussels on Plain packaging. Andreas Wehlau (moderator) indicated that he would put together an article on this topic to be published in Les Nouvelles.

5. Any other business and date of next meeting

Chris Katopis raised the January 2016 WPM in Lisbon and asked if the Committee would be represented at this meeting. Simon Chalkley kindly volunteered his availability to attend the planning meeting.

The Meeting suggested that a further telephone meeting be held before or just after WPM in Lisbon. It would be appreciated if Chris Katopis could assist us with the logistics.

· Ideally a time should be found which is convenient for all members of the Committee who
· come from different time zones. We should try to steer clear of a situation, if at all possible,
· where the time of the meeting is at unreasonable hours, say, for instance, between 23:00 –
06:00. We would appreciate Chris's comments.

The meeting ended at GMT 08h47.

Johan du Preez