

Licensing Executives Society International (LESI)

Minutes

Conference Call: Trade Marks, Design and Merchandising Committee

held on

Wednesday, July 31st, 2019

Minutes taken: Stefan Völker (Co-Chair)

Chairpersons: Charmaine Koo
Stefan Völker

Vice-Chairperson: Barbara Berdou

Attendees: Charmaine Koo (LES Hong Kong) – charmaine.koo@deacons.co.hk
Stefan Völker (LES Germany) – stefan.voelker@gleisslutz.com
Tatiana Campello (LES Brazil) – tcampello@demarest.com.br
Barbara Berdou – barbara@berdou.co.za

1. Welcome to Barbara Berdou

Barbara Berdou was welcomed as the new vice chair of the Committee.

Tatiana Campello agreed to again contact Fiona with the aim of formalizing Barbara Berdou's accession as vice chair (with publication on www.lesi.org)

2. Report on last workshop

Stefan Völker reported that the Committee organized a workshop on coexistence agreements for the last annual meeting in Yokohama.

Speakers were Scott Havlick (Holland & Hart, USA) and Arnaud Michel (Gide, Paris) (past president of LESI). Charmaine Koo reported that David Swaine took over as the third speaker on her behalf and that the workshop was a success.

3. Workshop Proposal for the 2020 Annual Meeting in Berlin

It was agreed that, after the full Committee conference call to be held in September, the Committee will again propose a topic for a workshop to the Board. This would be the sixth workshops organized by the Committee since 2015.

Stefan Völker suggested the following topic:

“Trademarks and Designs: Developing a coordinated protection strategy”

This topic was in principle approved by the other participants to the call.

This suggested topic will therefore be proposed in the upcoming full Committee conference call with the aim of them formulating and submitting a full proposal to the Board.

Stefan Völker will be responsible for this.

4. Contact persons from national LES societies

As already touched upon in the last conference call on February 26th, 2019, Tatiana Campello has suggested a project already implemented by the high-tech committee aimed at involving national chapters/local LES societies by finding a contact person from the local societies for this committee. One target would be to enable national societies to tap into the activities and generated know-how of the Committee where there are no corresponding committees in national societies. This would, for instance, pertain to participation of members of national societies in webinars organized by the Committee.

It was agreed that this is a good idea and should be put on the agenda for the upcoming full Committee conference call with the aim of finding a person in charge.

5. Discussion of possible webinars

This subject had also already been touched upon in the last full Committee conference call on February 26th, 2019.

It was now more specifically suggested to organize webinars on issues relating to the Madrid Protocol. Each webinar could address a different issue relating to the Protocol. This would be of interest both to Committee members as well as to practitioners from national LES societies.

Tatiana Campello proposed (and agreed to take charge of) organizing webinars relating to the Madrid Protocol as soon as September, October and/or November. One possible topic mentioned by Stefan Völker was the current accession of Brazil to the Protocol.

6. Research requests to national societies

Based on prior discussions between Charmaine Koo, Tatiana Campello, Susan Goldsmith and Barbara Berdou, it was suggested to send to all national societies a research request about whether or not license agreements could or should be registered with a local entity and the effects of registration.

There was a consensus among the participants that this a sensible project which should be pursued after being presented in the upcoming full Committee conference call.

There was also an agreement that the questionnaire should, in any event, pertain to trademarks and designs.

There was some discussion of the issue whether it should also pertain to copyright and patent licenses (or whether there should be separate parallel questionnaires from the Committees responsible for these types of licenses). Tatiana Campello offered to discuss this with the Board. The other participants considered this a good suggestion.

A person in charge of the project needs to be found at the upcoming full Committee conference call.

7. Contacts with other societies such as INTA, MARQUES

Stefan Völker suggested that the Trademarks, Design and Merchandising Committee could reach out to other organizations active in the same field, namely INTA and Marques.

Tatiana Campello agreed to address this issue with the Board and provide us with the Board's insights and guidance.

8. Next steps

Stefan Völker agreed to prepare draft minutes and circulate them to the participants for approval (or corrections and additions, if any).

He also offered to circulate some suggested dates for the full Committee conference call to the participants for prior coordination before then requesting Esha to organize a conference call.

Stefan Völker also agreed to then prepare a draft agenda for the full conference call and to circulate it to the participants.

Finally, Stefan Völker agreed to prepare an action plan and a summary of this and the subsequent full Committee conference call in the format requested by LESI and provide it to the Committee and Tatiana Campello.

-Stefan Völker-