

# Pre-conference Workshops

## Trademark Protection in China

- Trademark Searches and Registration Clearance
- Trademark Prosecution
- Opposition and Cancellation Proceedings
- Trademark Enforcement in China
- Fighting Counterfeit Goods in China
- Distribution Strategies for China
- Licensing of IP Rights

19<sup>th</sup> April 2006

WIPO, Geneva

## U.S. Trademark Protection

- Trademark Search regarding the U.S.
- Key Issues of Protection Distinctiveness, Descriptiveness and likelihood of Confusion
- Trademark Prosecution and Use Requirements in the U.S.
- U.S. Opposition and Cancellation Actions before the Trademark Trial and Appeal Board
- Strategic comparison between the Protocol and National filings
- Trademark Litigation in U.S. Federal Courts

19<sup>th</sup> April 2006

WIPO, Geneva

### Speakers

**Gerhard R. Bauer**, DaimlerChrysler AG, Stuttgart • **David J. Davis**, Baker & McKenzie LLP, Chicago  
**John C. Filosa**, Baker & McKenzie LLP, Chicago • **Dr. Burkhardt Goebel**, Lovells, Madrid  
**Dr. Rembert Niebel**, LLM, Baker & McKenzie LLP, Frankfurt

## Who should attend

- Attorneys, Solicitors, Barristers
- Corporate Trademark Counsels
- Heads of Corporate IP Departments
- Intellectual Property Consultants
- Patent Agents and Patent Attorneys

## About this workshops

As one of the world's **fastest growing economies**, **China** is a major centre for manufacturing goods to be imported to the European Union, but it is also a huge market with a fast growing demand for quality and luxury goods.

China unfortunately is also the world's **centre of counterfeit and product piracy**. A very high level of organisation among the counterfeiters serve as an ideal environment for trademark piracy.

The workshop will look at doing business in China from an IP owner's perspective. In this respect we will discuss the protection of trademark rights in China and also compare these to European practice. The workshop will address the enforcement of Trademark rights in China, the set-up of distribution systems and licensing agreements. It will also provide a comprehensive overview of anti-counterfeiting measures available in China and **how they are effectively applied**.

There will be ample opportunity to discuss specific problems and to **exchange experiences** with all participants.

## Number of participants

**The number of participants is restricted.** This limitation, a feature of all FORUM seminars, will give participants the opportunity for a thorough discussion of the complex issues to be covered by this programme.

## Speakers

### *Gerhard Bauer*

Chief Trademark Counsel,  
DaimlerChrysler AG Stuttgart

### *Dr. Burkhardt Goebel*

Attorney-at-Law, Lovells  
Madrid

## Programme 19<sup>th</sup> April 2006

### Trademark Protection in China

- |            |  |
|------------|--|
| 10.00 a.m. | <b>Trademark Rights in China</b><br><br><b>Trademark Searches and Registration Clearance</b>   |
| 11.15 a.m. | Coffee break   |
| 11.30 a.m. | <b>Trademark Prosecution</b> <ul style="list-style-type: none"><li>• Registration</li><li>• Response to Refusals</li></ul><br><b>Opposition and Cancellation Proceedings</b>   |
| 1.00 p.m.  | Lunch  |
| 2.00 p.m.  | <b>Trademark Enforcement and Fighting Counterfeit in China</b> <ul style="list-style-type: none"><li>• Trademark Enforcement in China (Hongkong and Mainland)</li><li>• Fighting Counterfeit Goods and IP Litigation in China (Hongkong and Mainland)</li></ul>  |
| 3.15 p.m.  | Coffee break   |
| 3.30 p.m.  | <ul style="list-style-type: none"><li>• Civil Actions</li><li>• Criminal Actions</li><li>• Customs Actions</li><li>• Administrative Actions</li><li>• Recognition of Well-known Marks</li></ul>  |
| 4.15 p.m.  | <b>Licensing of IP Rights</b> <ul style="list-style-type: none"><li>• Distribution Strategies for China</li><li>• Relevant Laws Governing License Agreements</li><li>• Specific Issues on Trademark Licensing</li><li>• Form</li><li>• Recordal of the License</li><li>• Required Content of a License Agreement</li></ul> |
| 5.00 p.m.  | Close of Workshop  |

## Programme 19<sup>th</sup> April 2006

### U.S. Trademark Protection

#### 9.30 a.m. The implementation of the Madrid Protocol into U.S. law

Why use the Protocol for the U.S.? – Strategic comparison between the Protocol and National filings – How do the costs compare to filing an application directly? – How safe is it to use the Protocol? – How does the Procedure compare? – When will I need a local representative? – Will the Protocol enable me to Short-Circuit use requirements and other peculiarities?

#### 10.30 a.m. Coffee break

#### 10.45 a.m. “Distinctiveness, descriptiveness and likelihood of confusion” in U.S. Trademark law – the key issues of protection

These fundamental principles of U.S. trademark law continue to play an important role in trademark searching, selection and protection. Most recent cases concerning different types of goods and services will be reviewed.

#### 11.45 p.m. Trademark Litigation in U.S. Federal Courts

Learn about the nuts and bolts of Federal court trademark infringement litigation and strategies for initiating and defending trademark actions from an experienced U.S. intellectual property litigator

#### 1.00 a.m. Lunch

#### 2.00 p.m. Trademark prosecution and use requirements in the U.S.

How does the U.S. prosecution process differ between use-based and intent-to-use based applications? What is the “country of origin” problem? What is proper trademark use under U.S. law? Learn about common types of refusals of registration as well as arguments and strategies in response to refusals. Discuss with the speaker the unique benefits and pitfalls of registrations obtained by non-U.S. trademark owners.

#### 3.00 p.m. Coffee break

#### 3.15 p.m. Your Trademark Search regarding the U.S.

Learn from an experienced professional about the trademark search and clearance process

#### 4.15 p.m. U.S. Opposition and Cancellation Actions before the Trademark Trial and Appeal Board

Trademark opposition and cancellation actions in the U.S. can be quite involved and follow many of the same procedures and rules of practice as trademark infringement litigation in Federal courts. Learn strategies for successfully litigating oppositions and cancellations and for using such actions as platforms for settling larger disputes related to use.

#### 5.30 p.m. Close of Workshop

### Who should attend

- Attorneys, Solicitors, Barristers
- Corporate Trademark Counsels
- Heads of Corporate IP Departments
- Patent Agents and Patent Attorneys
- Intellectual Property Consultants

### Objective

U.S. trademark law is becoming more important for European trademark owners by the day. After the Madrid Protocol entered into effect in the United States on November 2, 2003, European trademark owners may file an International Registration (IR) for the U.S., there being no legal need to retain U.S. trademark counsel.

Learn about the **advantages and disadvantages of using International Registrations for the U.S.**, and what you should take into consideration when filing your trademark in the United States.

Also, to better enable you to understand and follow U.S. trademark prosecution, this seminar will cover **key questions of U.S. trademark law** (distinctiveness, descriptiveness and likelihood of confusion), **proceedings before the TTAB** as well as **special use requirements in the United States**. No US enforcement and protection strategy would be complete without an understanding of **how to enforce trademark rights in US courts**. Learn about the nuts and bolts of Federal court trademark infringement litigation, how these actions differ from TTAB proceedings, and strategies for obtaining or defending against claims for preliminary injunctive relief and damages.

There will be ample opportunity to discuss the benefits and pitfalls of applications and registrations, as well as enforcement strategies.

### Speakers

#### *Gerhard Bauer*

Chief Trademark Counsel,  
DaimlerChrysler AG, Stuttgart

#### *David J. Davis*

Attorney at Law,  
Baker & McKenzie LLP, Chicago

#### *John C. Filosa*

Attorney at Law,  
Baker & McKenzie LLP, Chicago

#### *Dr. Rembert Niebel, LL.M.*

Attorney at Law,  
Baker & McKenzie LLP, Frankfurt

# Pre-conference Workshops

**Registration**  
Fax +49/62 21 / 500 555

## Registration Form

Please complete this form and register by fax or mail to:  
next column

### ☐ Trademark Protection in China

19<sup>th</sup> April 2006, WIPO, Geneva  
Seminar-No. 06 04 121 I

### ☐ U.S. Trademark Protection

19<sup>th</sup> April 2006, WIPO, Geneva  
Seminar-No. 06 04 122 I

Name

Position

Department

Company

Street

City/Postal Code/Country

Tel. No.

Fax-No.

Date

Signature

## How to register

### Registration-Information:

**FORUM** · Institute of Management GmbH  
PO Box 10 50 60 · D-69040 Heidelberg  
Tel.: +49/6221/500 501 (it is possible to register by telephone)  
Fax: +49/6221/500 555  
e-mail: anmeldung@forum-institut.de  
Internet: www.forum-institut.com

### Date:

Both workshops will be held on 19<sup>th</sup> April 2006.

### Venue:

WIPO – World Intellectual Property Organization  
34, chemin des Colombettes  
1211 Geneva 20  
Switzerland

### Fee:

Trademark Protection in China: CHF 1.050,-  
U.S. Trademark Protection: CHF 1.050,-

The fee includes course documentation as well as midsession refreshments and lunch. Invoice and confirmation will be forwarded to you.

### Discounted Rate:

Delegates who have also registered for the 7<sup>th</sup> International Trademark Conference pay only CHF 910,-.

### Hotel Accommodation:

A list of hotels will be supplied with our confirmation.

## Cancellation Policy

A cancellation of conference registration, up to two weeks prior to the event in question, is possible upon payment of an administrative charge of CHF 75,-. In the case of a cancellation up to seven days prior to the seminar 50% of the seminar participation fee will be charged, thereafter the full participation fee is due unless a substitute participant is nominated. Cancellations are registered by us upon receipt of written notification, att. Registration Department. In the case an event is cancelled by the organiser, due to organisational reasons etc., the fee already submitted will be fully refunded.

## Further questions?

For further details please contact:

**Adrian Schmechel**

Phone +49/6221/500 670

Fax +49/6221/500 959

Email: a.schmechel@forum-institut.de

**FORUM · Institut für Management GmbH**  
Postfach 10 50 60 · D-69040 Heidelberg

Tel. +49/6221/500-501  
Fax +49/6221/500-555

**25 Jahre**  
FORUM

Registration