Charting the Development of the Trademark Industry through INTA: An Analysis of INTA Annual Meeting Programs and Participants

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As one of the world’s largest gatherings of IP practitioners, the annual meeting of the International Trademark Association (INTA) serves as an interesting barometer of the industry. The programme and the composition of participants offer insight not only into the evolution of the event itself, but also more broadly into developments in trademark law and practice. On the eve of this year’s event, it is timely to look back over the past decade and analyze the key indicators from selected INTA annual meetings (starting in 2002 and culminating in the 2009 Seattle meeting) against available industry data. Even where trends are predictable to a degree, it is instructive to observe their dimensions. Together, they highlight the dynamic challenge for the practice of trademark law to evolve alongside the producers and consumers that it aims to protect.

Increased participation
The first trend that becomes apparent from an analysis of past events is that the trademark industry is expanding, demonstrated by both significantly increased INTA annual meeting attendance (even if in-house counsel make up only a minority of participants) and a rise in INTA membership. It is worth noting that the meetings also attract non-members — in 2008, the number of participants was approximately 1.5 times the number of incumbent members. The 2007 peak of nearly 9,000 participants represented an increase of some 28% compared to 2002. According to available numbers, INTA membership itself grew by 34% between 2002 and 2008.

Reflecting the increased membership in the Madrid Union and adherence to the Singapore Treaty on the Law of Trademarks, which signify the international evolution of trademark law, INTA membership has also experienced a geographical shift. Figure 1 shows the geographical distribution of INTA membership over time. INTA members are found in more than 190 countries, and while North America remains by far the largest membership region, its percentage share of total INTA membership from 2004 to 2008 actually decreased by 6% to a total of 40%. This percentage corresponds to a membership increase during the same period in Europe, Russia and Commonwealth of Independent States countries from 25% to 27%; in Asia-Pacific from 13% to 16%; and in other regions by about 1%.

This internationalization is also evident in participation in INTA annual meetings, which offers one measure of trademark activity in different countries. Figure 2 shows the top 15 countries in terms of 2009 participation. Most of these countries also feature among the national trademark offices that receive the highest number of filings (Figure 3) and that top the Madrid filing and designation charts (Figures 4 and 5).

When all of this data is taken into consideration, it may be concluded that the United States, China, Japan, the European Union (in particular Germany, France, Italy, Spain and Benelux), Switzerland, South Korea, Australia and Turkey rank highly in terms of activity in today’s trademark world.

Representing the second-largest delegation, the United Kingdom is a strong participant at INTA annual meetings, but it ranks outside the top 10 in trademark applications by office. On the other hand, Russia’s meeting participation has remained modest (eg, about half the number of the 15th participating country in 2009, South Korea), but the country is becoming increasingly prominent in the Madrid system.

India, Mexico, Brazil and Argentina each have significant levels of trademark activity, but are not yet members of the Madrid Union and an important share of registrations in these countries is undertaken by non-residents.

Geography lessons
If participation in INTA meetings is an indicator, however, North America continues to dominate the development of trademark law and practice.

While INTA meetings feature increasing participation from a range of other countries, measured as an average over time, an estimated 40% of all attendees and 50% of all speakers are from North America. In absolute terms, at 22% of US participation, US in-house counsel represent by far the largest such group (although the lower overall figures on levels of in-house participants from key regions do demonstrate that there is room for more balanced participation).

That said, the location of the meeting does have an impact and North American dominance is mitigated when the meetings are held elsewhere, reflecting in part increased participation from the host country and neighbouring countries. Although INTA membership has steadily grown each year, there have been ups and downs in the total number of meeting participants, with...
participation dipping when the event was held outside the United States (Amsterdam in 2003, Toronto in 2006 and Berlin in 2008).

For example, German participation at the 2008 Berlin meeting was twice the number in the years before and after. Neighbouring countries such as Switzerland (in addition to punching above its weight in terms of total meeting attendance, Switzerland brings the largest national percentage of in-house participants, representing companies in areas ranging from pharmaceuticals to luxury goods) and the Netherlands aligned themselves with this boost, showing increases of 64% and 35%, respectively. US participation, however, dropped by nearly 40% that year, even as Chinese attendance was up 25%. Likewise, session topics concerning European jurisdictions increased when the meeting was held on that continent.

To some extent, therefore, the allocation of an INTA annual meeting can help to advance trademark practice and protection in the chosen jurisdiction and region – for example, in Hong Kong, the next meeting venue (2014) outside North America.

**Building BRIC by BRIC**

While North American attendance continues to dominate, the rise in participation from Brazil, Russia, India and China also stands out. Between 2003 and 2009, their meeting presence nearly doubled (from 322 to 652 attendees). In 2009 China (including Hong Kong) ranked third among participants – a remarkable shift compared to the country’s previous attendance record. Although perhaps partly attributable to the outbreak of SARS, fewer than 100 attendees from mainland China travelled to the 2003 meeting. By contrast, the 2009 meeting counted 2.5 times as many participants from mainland China (257), plus approximately 76 from Hong Kong, for a total of around 333 Chinese delegates.

During the same period, participation from India almost tripled from 55 to 154, while Brazil’s nearly doubled from 76 to 121 (Figure 6). Both countries ranked among the top 15 participant countries in 2009 (Figure 2).

**Content reflects industry focus on enforcement**

Increasingly, the practice of trademark law demands an understanding of a broad range of legal, technological and business developments, as an integral foundation for the provision of strategic advice and transactional support. As such, the INTA programme both illustrates the wide range of practice areas covered by the trademark profession and highlights issues which are climbing up the trademark agenda.

Figure 7 shows the composite elements of this challenge, as evidenced by the meeting sessions at the 2009 event. Comparing the coverage afforded to industry topics in 2003, 2006 and 2009, the most important growth areas in trademarks are:

- protection and enforcement;
- filing strategies;
- transactional and licensing issues and portfolio management; and
- the Internet.

While litigation and the interpretation of trademark law remain consistent focus areas, and designs, trade dress and non-traditional trademarks have been drawing increasing attention, one in every five sessions at the 2009 meeting addressed trademark protection and enforcement. Tellingly, exhibitors providing software or services to support investigation and enforcement also grew fourfold between the 2003 and 2009 meetings.

In addition to meeting sessions addressing issues such as border
Figure 2. Top 15 INTA Annual Meeting participants by country (2009)

Figure 3. Top 15 trademark applications by office (2007)
(Counts based on trademark application date; data estimated for China, India and OHIM)

Source: WIPO statistics on trademarks
**Figure 4.** Top 15 Madrid filings by country (2008)

Source: WIPO

**Figure 5.** Top 15 Madrid most designated countries (2008)

Source: WIPO
measures and parallel imports on a generic level, many sessions cater to trademark counsel’s need to develop enforcement strategies for specific jurisdictions or industry sectors – in particular, the apparel, entertainment and pharmaceutical sectors.

The growing INTA focus on enforcement matches a steady increase in the number of IP-related seizures by customs and other authorities, in particular in the United States and the European Union. According to US figures, the number of seizures increased by nearly 10% between 2007 and 2008, with the value of these seizures representing a fraction of total counterfeiting affecting the country. The European Union, meanwhile, has reported a comparable growth percentage in the number of registered cases within its borders, from 43,671 in 2007 to 49,381 in 2008, with the total number of items detained in the European Union in 2008 coming to 178,908,278. Significantly, the EU report notes that 55% of these cases involved trademark infringement.

Both the US and the EU enforcement authorities also publish data on the origins and types of goods seized. Figures 8 and 9 provide the respective 2008 rankings, based on different commodity reporting approaches (value v cases).

Preparing for ambush
While many meeting sessions address enforcement by focusing on particular jurisdictions or regions, others examine specific categories of infringing behaviour that are in vogue. An example is the growing interest in ambush marketing – commercial campaigns that seek to free-ride on the goodwill of target events. This topic has been covered under a number of guises: “How ambush marketing will affect the Winter Olympic Games in Vancouver 2010”; “Sport sponsorship: ambushes and other perils”; “Ambush marketing, sports marketing – the real Dream Team”; and “Ambush marketing – lessons for Beijing from Sydney and Athens”.

In addition to discussing how to combat counterfeiters and opportunistic operators, these sessions explore the proper limits to the legitimate exercise of trademark rights by and between rights holders. Given the high stakes involved, it is a safe bet that this subject, often intersecting with sports law, will continue to feature highly on the trademark agenda.

Focus on filing
Filing strategies involve a combined consideration of different registration systems, third-party rights, time and cost implications, administrative procedures, marketing plans and branding priorities, defensive policies, local law, language and culture. Reflecting this, INTA meeting sessions cater to major international filing campaigns as well as more local protection needs – at least one-third of filing-related sessions since 2003 concerned the international systems of the World Intellectual Property Organization (WIPO) and the Office for Harmonization in the Internal Market (OHIM), with numerous further sessions providing other regional filing guidance – for example, concerning the Gulf area, India or the Andean countries.

Multi-jurisdictional as filing strategies often are today, international registration systems hold significant potential for further growth. At present, a large share of trademark registrations are still undertaken through direct filing in one or several jurisdictions. This may imply that many applications are filed by smaller enterprises or involve local branding and marketing strategies.

Apart from the geographical scope of trademark filing, the INTA meetings also discuss a wide array of more technical aspects of registration, highlighting the sophistication required for successful strategy implementation.

Common examples include docket management, e-filing
guidelines, global search and clearance, opposition practices, translation and transliteration of marks, Madrid procedures, OHIM languages, Trademark Trial and Appeal Board decisions and US Patent and Trademark Office examination.

Related substantive topics regularly featured include use requirements in certain jurisdictions, famous or well-known mark status and European Court of Justice jurisprudence. The events also address the need for quality filing assistance by offering education for trademark administrators and guidance on choosing foreign counsel.

Recent programmes bear out that trademark owners increasingly employ hybrid strategies to ensure the broadest possible protection. This involves not only a new reliance on non-traditional marks, but also the combined use of other rights and identifiers – notably copyright, designs, geographical indications, personal names, trade dress and publicity.

In more ways than one, a challenging economic climate increases the importance of considered filing decisions. These must accommodate current market realities, yet also help prepare for future opportunities. The relationship between IP filing and economic conditions is also receiving increasing attention on a macro level.

Transactional issues
If filing strategy is concerned with the legal basis for the protection of marks, transactional, licensing and portfolio activities serve to optimize their value and revenue. As companies explore further opportunities to generate income from their intangible assets, transactional practice areas such as marketing, branding, licensing, franchising, portfolio management, trademark audits and brand securitization take on special importance.

This increased reliance on trademarks as an economic tool creates a need for practitioners to understand and help to enhance the financial potential of such rights, supporting new methods and markets for maximizing revenue. Irrespective of business area, brand history or company size (Figure 10 provides one 2009 estimate of top 20 global brand value, whereby it may be just a question of time before Chinese brands start appearing in such rankings), trademark counsel can add significant value.

Reflecting this corporate trend, a growing number of sessions have focused on this practice. Likewise, the drive to maximize trademark revenue is causing many brands to take on a more intrinsic identity, separate from the original product source for which they serve as identifiers. This concerns both trademark licensing for similar goods and the branding of unrelated retail items pioneered by the entertainment and sports industries, and has similarly come under the microscope.

Domain name system expansion
In 1999 Network Solutions (NSI) signed an agreement with the US Department of Commerce ending NSI’s monopoly in domain name

Figure 8. Top five US trading partners for IPR seizures – FY 2008

Top commodities seized FY 2008 (in terms of domestic value)

Figure 9. Report on EU customs enforcement of IP rights results at the European border

Breakdown of number of registered cases per product type

Source: US Customs and Border Protection, US Immigration and Customs Enforcement

Source: European Commission Taxation and Customs Union
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registration. Ten years and 110 million registrations in generic top-level domains (gTLDs) later (Figure 11), the domain name market is anticipating competition on a different level, with the Internet Corporation for Assigned Names and Numbers (ICANN) promoting plans for a significant expansion of the number of gTLDs.

During these 10 years, trademark owners filed nearly 17,000 cybersquatting cases with the WIPO Arbitration and Mediation Centre under the WIPO-initiated Uniform Domain Name Dispute Resolution Policy (UDRP).

The recent convergence of gTLD registration and WIPO UDRP annual growth rates (Figure 12) provides one benchmark of the current trademark response to the continually evolving practice of cybersquatting. The enforcement reaction to the future of the domain name system envisaged by ICANN will depend in part on further dispute prevention and resolution instruments presently under consideration. Notably, these may include higher-level options for trademark owners to engage domain name registries on criteria based on the WIPO General Assembly’s 2001 Joint Recommendation Concerning Provisions on the Protection of Marks and Other Industrial Property Rights in Signs on the Internet.

Reflecting this expansion, INTA annual meetings include numerous sessions to help trademark professionals to utilize the UDRP tool, with WIPO experts and external domain name specialists answering questions on procedure and substance, often on the basis of WIPO’s online precedent resources. As attention shifts to an expanding domain name space, including internationalized domains and domain names (IDNs), these professionals are sure to return for new sessions on the complementary dispute prevention and resolution mechanisms under consideration. Likewise, INTA and its Internet Committee are bound to remain active stakeholders in the ICANN debate.

**Trademarks on the Internet**

Far beyond the domain name system itself, the Internet has become one of the principal areas of focus for trademark owners and their representatives. As online commerce has progressed, the direction of trademark law has become increasingly technology-driven, posing unprecedented challenges for practitioners. While the Internet legally is neither supra-jurisdictional nor extra-jurisdictional, its global nature frequently demands special application of existing norms and even the development of new ones.

Unsurprisingly, INTA’s 2009 meeting was by far the most prolific in terms of internet-related content. While back in 2003 internet-related topics were limited mostly to cybersquatting and piracy, the 2009 programme read like a veritable catalogue of internet issues, covering virtual worlds, Web 2.0, blogging, online resale sites, border trademark use, counterfeit products, social networking sites, search engines, keyword marketing and privilege in cyberspace. Another source of debate was the dispute between L’Oréal and eBay about secondary liability of online intermediaries for sales of counterfeits. The growing incidence of such court cases publicly underscores the jurisdictional and substantive challenges being presented by online commerce.

With internet practices seemingly exploding in every legal, commercial and social direction, trademark practitioners have their work cut out for them.

**Looking ahead**

While this article is designed to identify key trends in trademark law and practice, including significant growth areas for the trademark profession during the period examined, new focus areas continue to emerge. Mirroring general global developments, recent INTA meeting programmes appear to reveal at least two important items for tomorrow’s trademark practice agenda: economizing the filing, management and protection of trademark rights, and understanding and enhancing the role of trademarks in developing and marketing environmentally responsible goods and services. A third area coming into focus is the further professionalization of the trademark profession with a view to meeting both client and public expectations. In serving producers and consumers, the global trademark community will continue to learn and teach in increasingly dynamic cycles.

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