

## Trademark Office Profile

### Zain Ibrahim Al Awamleh, Jordan IPPD



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The Director of Jordan's Industrial Property Protection Directorate, Zain Ibrahim Al Awamleh, spoke with the *INTA Bulletin* about the role of the Office in ensuring protections for and educating the public about IP.

in accordance with the current laws. The IPPD also handles all cooperation efforts with national and international organizations dealing with intellectual property.

#### Can you discuss any partnerships or events you're involved with to help increase awareness about IP rights?

1. The IPPD conducted a national study in collaboration with WIPO on small and medium enterprises (SMEs) and the use of IP rights.
2. The "IP for Business Series" (an introduction to trademarks for SMEs) was printed and distributed to public and private sectors and schools to promote more active and effective use of the intellectual property system.
3. The IPPD has helped to customize WIPO's guides, "Looking Good" and "Creative Expression," for printing and publishing in Arabic.

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#### What is the role of the IPPD?

As the basis for protection of creativity and human invention, the need for industrial property to protect patents, trademarks, industrial designs and models and integrated circuits ensures an appropriate environment for investments in industries and other commercial activities. This is why the IPPD takes on the supervisory role in all matters related to the registration of trademarks, patents, industrial designs and models and integrated circuits, as well as indexing them, in an effort to provide adequate protection

## Association News

### INTA CEO Announces First Leadership Meeting Outside the United States



The 2014 President's and Volunteer Service Awards Winners pose with INTA President Mei-lan Stark and CEO Etienne Sanz de Acedo.

During the opening ceremonies of the 2014 Leadership Meeting in Phoenix, Arizona, INTA CEO Etienne Sanz de Acedo announced that next year's Leadership Meeting will for the first time take place outside the United States, in Panama City, Panama. "The expansion of the Panama Canal will be concluded in 2015," said Mr. Sanz de Acedo. "That means the number of containers passing through the canal is going to grow from 300 million [PCUMS (Panama Canal Universal Measurement System) tons] to 600 million [PCUMS tons], and many of those goods may be counterfeit." INTA members must be present on the ground to join Panama's IP community in ensuring that appropriate measures are in place to identify counterfeit goods being trafficked through this popular port city, he added.

The 2014 Leadership Meeting was the Association's largest to date, with more than 1,300 INTA member volunteers from 77 countries attending committee meetings and educational sessions from November 11 to 15 at the JW Marriott Phoenix Desert Ridge Resort & Spa. Mr. Sanz de Acedo also announced the Board of Directors' elected Board Members and Officers for 2015, including 2015 President J. Scott Evans (Adobe Systems, USA).

INTA's 2014 President, Mei-lan Stark (Fox Entertainment, USA), recapped her busy year with the Association, which included the [first-ever Annual Meeting held in Asia](#) and high-level delegation trips to [China](#), [Hong Kong](#), [Japan](#),

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## EUROPEAN UNION OHIM Cancels Registration for SPINNING

On February 7, 2012, the Czech company Aerospinning Master Franchising filed an application for revocation of the registration for the word mark SPINNING, registered on April 3, 2000, in the name of the U.S. company Mad Dogg Athletics. *Aerospinning Master Franchising Ltd. v. Mad Dogg Athletics, Inc.*, No. 6281 C (July 21, 2014).

The application was based on Article 51(1) (b) CTMR, for which two conditions need to be met: first, it must be objectively established that the mark has become the common name in the trade for the product or service in respect of which it is registered; second, this loss of distinctive character must have occurred in consequence of acts or inactivity of the proprietor.

Since the perception of consumers or end users plays a decisive role in assessing the first requirement, the OHIM Cancellation Division first determined which consumers comprise the relevant market. The applicant focused its evidence on the distinctiveness of the mark in the Czech Republic. Consequently, the Cancellation Division ruled that the relevant public

consisted of the Czech-speaking part of the Union. Subsequently, the Cancellation Division found that a substantial part of the relevant Czech market does not perceive the term “spinning” as an indication of origin. Indeed, based on the evidence provided and on earlier findings of the Czech Industrial Property Office (Czech IPO) on substantially the same question, the Cancellation Division concluded that, in the Czech market, “spinning” is generically used to refer to a type of exercise training and related equipment.

Therefore, the Cancellation Division found that SPINNING had become the common name in the trade in the Czech market as a type of exercise training and the exercise equipment used in this training.

In assessing the second requirement, the Cancellation Division determined that Mad Dogg Athletics failed to ensure that its licensees did not use the mark as a generic term. In addition, Mad Dogg Athletics only enforced and defended the mark when infringements were brought to its attention in adversarial proceedings. The Cancellation Division was of the

opinion that Mad Dogg Athletics did not proactively protect the mark but merely retroactively defended it. The decisions of the Czech IPO and the Czech community trademark courts (in relation to infringement proceedings between the same parties) both supported this opinion.

Therefore, the Cancellation Division found that the evidence suggested that Mad Dogg Athletics failed to vigilantly protect the mark when it could easily have done so. In that regard the Cancellation Division ruled that the mark’s loss of distinctive character could be attributed to Mad Dogg Athletics’ failure to act.

For the above reasons, the Cancellation Division concluded that the application for revocation was successful and that SPINNING should be declared invalid for exercise equipment in Class 28 and exercise training in Class 41 of the Nice Classification.

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## Avoid Regrets Further Down the Line

Settlement and coexistence agreements are intended to solve problems, not cause them. All too often, though, oversights can result in an arrangement’s unraveling.

Find out how to minimize the likelihood of recurring disagreements in “Settlement & Coexistence Agreements” in INTA’s **Practitioners’ Checklists** series, available exclusively to INTA members.

Visit [www.inta.org/practitionerschecklists](http://www.inta.org/practitionerschecklists)