

The McCarthy Institute Goes to Redmond: Trademark Law and its Challenges 2011

Presented by the McCarthy Institute at USF Law School & Microsoft Corporation

Speakers

The **McCarthy Institute** at USF and **Microsoft Corporation** extend their thanks to the Speakers
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Keynote Speakers:

Judge Kong Xiangjun, Chief Justice of the Intellectual Property Tribunal, Supreme People's Court of the People's Republic of China



Xiangjung Kong is the ranking IP judge in the People's Republic of China. He is the chief justice of the Third Civil Court within the Supreme People's Court. The Third Civil Court is also called the IP Tribunal and is the highest court handling civil IP cases. He is a renowned legal scholar, authoring over 20 books and 200 articles on subjects including Corporate Law, Unfair Competition, Antitrust, Trade Secrets, Legal Methodology, and TRIPS. Prior to becoming Chief Justice of the IP Tribunal, Judge Kong was at the Intermediate Court at Heze, Shandong, and the Office of Fair Trade within the State Administration for Industry and Commerce.

In December 2010 he was appointed by the Standing Committee of the National People's Congress to the Trial Committee of the Supreme Court. The Trial Committee is the highest judicial body and decides especially complex cases.

J. Thomas McCarthy, Founding Director, Senior Professor, McCarthy Institute, University of San Francisco School of Law



Senior Professor and Founding Director of the McCarthy Institute for Intellectual Property and Technology Law. Professor McCarthy is the author of McCarthy on Trademarks and Unfair Competition, a multi-volume treatise on trademark law. Recipient of the 2003 President's Award of the International Trademark Association, the 2000 Pattishall Medal for excellence in teaching trademark law from the Brand Names Education Foundation, the 1997 Ladas Professional Author Award from the Brand Names Education Foundation, the 1997 Centennial Award in Trademark Law from the American Intellectual Property Law Association, the 1994 Jefferson Medal from the New Jersey Intellectual Property Law Association, the 1979 Rossman Award of the Patent and Trademark Office Society, and the 1965 Watson Award of the American Intellectual Property Law Association. The American Intellectual Property Lawyers Association named McCarthy the most influential trademark expert of the 20th century

Horacio Gutierrez, Corporate Vice President and Deputy General Counsel for Intellectual Property and Licensing, Microsoft



Horacio Gutiérrez is corporate vice president and deputy general counsel in charge of the Microsoft Corporation's worldwide intellectual property and licensing group. He heads the group responsible for the development and maintenance of the company's IP portfolio, including all patents, copyrights, trademarks, and trade secrets worldwide. This group is also responsible for inbound and outbound patent licensing work, and for the strategy and substance on IP legal and public policy developments.

Prior to his current position, Gutiérrez was based in Paris, France, where he was Microsoft's associate general counsel for Europe, Middle East and Africa, overseeing all legal, regulatory and government affairs matters in that region.

China Panel:

Brian Coleman, Partner, Perkins Coie, Palo Alto



Brian Coleman is a partner in Perkins Coie's Patent group. His practice emphasizes domestic and international patent and trademark prosecution, copyright procurement and enforcement, trademark procurement and enforcement, intellectual property counseling, start-up counseling and fundraising.

His areas of technical focus include social media, clean technology, fuel cells and batteries (chemistry and controls), analog electronics, software, nanotechnology (instruments and nano computing, and materials), LED lighting and systems, financial services, medical software, retail services, software, network appliances, computer administration and special effects cloud computing services.

Yongbo (Robert) Li, Partner, Unitalen, Beijing



Yongbo Li practices intellectual property law in China and specializes in IP litigation and prosecution. He has represented domestic and international clients which include Bosch, Lenovo, Montagut, Lifetime, Nautica, ABRO, PCCW, and ICON. Yongbo has handled cases on cybersquatting, counterfeiting, antitrust, unfair competition and other IP issues. His representation of MONTAGUT, a French fashion corporation, was recognized as one of the “Top 10 Valuable Intellectual Property Protection Cases” in Beijing in 2005. He also represented a domestic client against a Fortune 500 Japanese company which involved reverse trademark infringement and helped the client reach a favorable

\$1 billion settlement in 2006.

Ping Gu, Partner, Unitalen, Beijing



Ping Gu focuses on intellectual property matters involving computer software and electronic devices. She practiced for seven years in the U.S., litigating patent cases in U.S. federal district courts and the International Trade Commission. Her practice also involves counseling on IP related transactions, including patent licensing, patent and trademark due diligence during merge and acquisitions, and IP contracts. Ms. Gu has drafted and prosecuted patent applications for business methods, financial industry tools, optical devices and electrical products.

Ms. Gu is admitted to practice in the State of New York, the Southern and Eastern Districts of New York. She is also registered to practice before the United States Patent and Trademark Office.

Paul Schmidt, Counsel, June He, Beijing



Paul Schmidt is counsel at Jun He Law Offices in Beijing. Paul specializes in intellectual property law, contentious and non-contentious, as well as cross-boarder arbitration and litigation. He has extensive experience in all aspects of PRC trademark practice. He is experienced in managing large trademark portfolios and has helped a number of foreign brand owners achieve PRC “well-known” trademark status. He has overseen the acquisition of high-profile marks and directed the recovery of numerous

stolen marks.

Paul has successfully prosecuted numerous administrative, civil and criminal IP cases in the PRC. A criminal enforcement matter he helped direct involving a coalition of automobile manufacturers, was picked as a top QBPC ("Quality Brands Protection Committee") case in 2004.

Dilution Panel

Darren Cahr, Partner, Drinker, Biddle & Reath, Chicago



Darren Cahr is a partner of the Intellectual Property Practice Group and co-chair of the Firm's Advertising and Promotions practice. Darren counsels clients on matters, ranging from IP disputes to rights of publicity, social media, parallel imports, advertising and promotion law. Darren has litigated IP and unfair competition cases around the nation, and has participated in challenges before ICANN arbitration forums, self-regulatory bodies such as the National Advertising Division and the Children's Advertising Review Unit of the Council of Better Business Bureaus, and in the Trademark Trial and Appeal Board.

Darren also conducts internal investigations regarding misappropriation of proprietary rights, develops IP enforcement strategies, creates branding policies, reviews advertising for compliance with regulatory standards and crafts promotion tactics.

Stacey King, Senior Internet and IP Counsel, Richemont



Stacey King is a Senior IP Counsel for Richemont SA, a Swiss luxury goods company. She is the secretary of the Intellectual Property Constituency, ICANN, and sits on the Board of Directors of the International Trademark Association. Prior to joining Richemont Stacey was associated with Finnegan Henderson and Howrey Simon.

Batur Oktay, Director, Corporate Counsel, IP, Starbucks Coffee



Batur Oktay is director and corporate counsel at Starbucks Coffee Company, where he manages worldwide patent and trademark portfolios, works on the company's intellectual property litigation, drafts and advises on a variety of contracts, and works in the areas of copyright and trade secrets. Before Starbucks, Batur was Senior Corporate Counsel at the software company Adobe Systems and a litigator at the law firm Foster, Pepper & Shefelman.

Dana Northcott, Senior Corporate Counsel, IP, Amazon.com



Dana Brown Northcott is a Senior IP Counsel for Amazon.com, where she leads the global trademark and domain name practices for Amazon and its affiliates. Prior to Amazon, Dana worked for Agilent Technologies, and Howrey LLP in London, England and Menlo Park, California. Dana has a Bachelor of Arts from Stanford University, her Juris Doctor from University of San Francisco School of Law, and a Diploma in Intellectual Property Law and Practice from University of Bristol, England.

Ellen Shankman, Partner, Ellen B. Shankman & Associates, Rehovot, Israel



Ellen B. Shankman, Esq. has more than twenty years of experience practicing Trademark, Internet, Licensing and Copyright Law. She established Ellen B. Shankman and Associates as a boutique intellectual property firm specializing in global branding strategy, trademark and domain name counseling, clearance, protection and enforcement, including the development and management of international trademark and domain name portfolios for technology and other companies.

A recent member of the Board of Directors of INTA, Adv. Shankman represents the Israel ISOC, the administrative body responsible for Domain Name allocation under the .IL gTLD, and her clients include a wide range of companies from Fortune 100 companies to small start-ups.

Adv. Shankman served as Chair of the INTA Internet Committee and has served as a member of International Trademark Association's Emerging Issues Subcommittee and Internet Subcommittees.

Will Rava, Chair, Intellectual Property Litigation Practice, Perkins Coie, Seattle



Will Rava is a partner in Perkins Coie's Seattle office and chair of the firm's Intellectual Property Litigation Practice. He focuses his practice on litigation involving trademarks, trade dress, domain names, copyrights and trade secrets. He has successfully litigated such disputes in federal courts across the country, before arbitration panels under the UDRP and before the Trademark Trial and Appeal Board.

Will also has extensive experience counseling clients in a variety of industries on intellectual property protection strategies, including securing, policing, investigating and enforcing their rights, investigating and removing from the market counterfeit and other unauthorized goods, and investigating computer fraud and other unlawful Internet activities.

Gtlds Panel:

Russ Pangborn, Associate General Counsel for Trademarks, Microsoft Corporation, Redmond, Washington



Russell Pangborn is the Associate General Counsel for trademarks at Microsoft Corporation. He leads a team counseling Microsoft's global businesses on all aspects of trademarks including, clearance, counseling, prosecution, maintenance, enforcement, licensing, litigation, and policy. Russell was previously Microsoft's group manager for the Copyright & Trade Secret practice and a senior attorney in the Trademark group.

Mr. Pangborn is presently on the Board of Directors for the International Trademark Association (INTA) and a member of INTA's Executive Committee. He is also on ICANN's Intellectual Property Constituency and participated on the Implementation Recommendation Team as one of 18 legal professionals selected to propose trademark protection mechanisms to be implemented in connection with ICANN's

anticipated expansion of new generic top level domains. Russ is a frequent speaker at various IP association and CLE events.

Alan Drewsen, Executive Director, INTA, International Trademark Association, New York *



Alan C. Drewsen joined INTA on September 1, 1998, and has overseen the significant expansion of the Association, including the establishment of offices in Brussels and Shanghai to complement the headquarters office in New York City.

Mr. Drewsen is an attorney admitted to practice in New York. Prior to joining INTA, he was in private practice, specializing in antitrust and health care law and served as the Senior Vice President and General Counsel of Empire Blue Cross and Blue Shield.

Mr. Drewsen is a frequent speaker and commentator on legal issues involving trademarks and intellectual property and on governance and other management issues affecting not-for-profit organizations. He serves on the Board of the New York Society of Association Executives and the Harper's Bazaar Anti-counterfeiting Alliance.

Peter Dengate Thrush, Chairman of the Board, ICANN



Peter Dengate Thrush is a barrister practicing in civil litigation and specializing in intellectual property, competition and Internet law.

Peter has been involved in ICANN since its inception. As a member of the Boston Working Group, he provided comment in 1998 on the early drafts of the ICANN bylaws, and as President of AIPPI-NZ, he co-chaired one of the preformation meetings of the Intellectual Property Constituency in Wellington, New Zealand. In 1999 he was appointed to ICANN's Independent Review Advisory Committee, or IRAC, a multi-national panel of legal experts charged with defining the principles of independent review of the actions of the Board of ICANN. He contributed to InternetNZ's submission to WIPO 1 and served on ICANN's Working Group A, which

led to the development of the UDRP. He is currently on the President's Strategy, Board Finance, Board Governance and Executive committees.

Peter was originally selected for the ICANN Board by the Country Code Names Supporting Organization in 2005. He was first elected Chairman of the Board at the organizational meeting following the Annual General Meeting on 2 November 2007. He has been re-elected at the organizational meetings following the Annual General Meetings in 2008, 2009 and 2010.

David Taylor, Partner, Hogan Lovells, Paris *



David Taylor is a partner in the Intellectual Property, Media and Technology Group. He specialises in Internet related intellectual property, and in particular the protection of brands online, thus trade mark and copyright issues, domain names (registration, recuperation and management of client portfolios via the Anchovy® service), data protection, web site design and development, encryption regulation and security issues, together with software licensing and development agreements.

He is a domain name panelist/expert/arbitrator with WIPO, Nominet and the Czech Arbitration

Court.

Kristina Rosette, Special Counsel, Covington and Burling, Washington D.C.



Kristina Rosette counsels a wide array of clients on a broad range of Internet, trademark, and intellectual property matters. She is principal trademark counsel to, among others, a luxury casino hotel resort, a national sports federation, a global satellite company, and a leading distributor of financial services and products. Ms. Rosette has wide-ranging experience in negotiating and drafting trademark licenses, assignments, security, and other associated transactional documents, and frequently performs due diligence reviews arising from corporate transactions.

She is the Intellectual Property Constituency (IPC) (North America) representative to the ICANN Generic Names Supporting Organization Council. Ms. Rosette is deeply involved in ICANN policy development relating to Whois, domain tasting, and the introduction of new gTLDs. She negotiated the terms and passage of the recent GNSO Council motion that ended the policy development process on Whois; wrote and implemented the IPC Supplemental Request for Information on Domain Tasting that provided trademark owners with the opportunity to articulate to ICANN the harms caused by domain tasting; drafted policy recommendations on the introduction of new gTLDs and to curb domain tasting; and chaired the ICANN Protecting the Rights of Others Working Group, which was charged with identifying and recommending “best practices” for the protection of trademark rights in the launch of new gTLDs.

Keywords Panel:

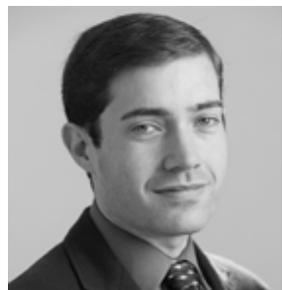
David Franklyn, Professor, Director, McCarthy Institute, USF School of Law



David Franklyn is the Executive Director of the McCarthy Institute for Intellectual Property and Technology Law at the University of San Francisco Law School. He is also Director of USF’s LLM Program in IP Law and Director of the Center for the Empirical Study of Trademark Law at uSF. Professor Franklyn teaches and writes in the area of IP law, with an emphasis on trademarks. He is co-author of McCarthy’s Encyclopedia of Intellectual Property Law and has published several articles on trademark law.

Professor Franklyn practiced law at Mayer, Brown in Chicago before entering academia, and regularly serves as an expert witness and consultant in trademark matters.

Ben Edelman, Assistant Professor, Harvard Business School



Ben is an assistant professor at the Harvard Business School in the Negotiation, Organizations & Markets unit.

Ben's current research explores the public and private forces shaping Internet architecture and business opportunities. He has written about the implications of growing market concentration in Internet search and resulting risks for advertisers. Examining the mechanisms that allocate pay-per-click advertising, Ben compared the revenue of alternative pricing rules, quantifying the losses from early inefficient auction systems. He has also analyzed the stability and truth-telling properties of modern online advertising systems, and he designed a simulated bidding environment to evaluate bidding strategies

empirically.

Ben's recent online privacy investigations uncovered a series of privacy violations including Google Toolbar continuing to track user browsing even after users "disable" the toolbar, as well as Facebook revealing users' names and details to advertisers (even after specifically promising the contrary).

David Hyman, Richard & Marie Corman Professor of Law and Professor of Medicine, University of Illinois*



Professor Hyman served for three years as special counsel to the Federal Trade Commission, where he was responsible for coordinating hearings and a major report on health care and competition law and policy. He is on the editorial board of the *American Journal of Law & Medicine* and is an adjunct scholar at the Cato Institute. He is admitted to practice before the 6th, 7th and 10th Circuit Courts of Appeal and the United States Tax Court and is a member of the Illinois Bar. Professor Hyman earned a B.A., M.D., and J.D. from the University of Chicago.

His 2006 book, *Medicare Meets Mephistopheles*, was named to the U.S. Chamber of Commerce/National Chamber Foundation's Top Ten Books of 2007, a list of books by leading think tanks, business leaders, and policy experts that the U.S. Chamber recommends to industry leaders.

* Speakers unable to attend due to bad weather; Alan Drewsen presented at the gTLD Panel by teleconference.