

INTA Bulletin

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INTA Volunteers Honored in Miami

At the INTA Leadership Meeting in Miami Beach, Florida, USA, on November 9, 2011, Association President Elect Gregg Marrazzo (Estée Lauder—USA) presented the 2011 President’s Award to **David Bernstein** (pictured left in the photo, with Mr. Marrazzo). The President’s Award recognizes the most distinguished and deserving INTA volunteers for careers dedicated to trademark and IP protection and advancement.



Mr. Bernstein (Debevoise & Plimpton LLP—USA) has been a dedicated and committed leader for many years. He has participated in a number of committees, including the Internet Committee and Programs Committee. He co-chaired the 2005 Annual Meeting in San Diego and served with distinction on the Board of Directors from 2000 to 2002 and as Counsel in 2006 and 2007.

In other INTA activities, David was a member of the Dilution Task Force and was a principal drafter of what became the U.S. Trademark Dilution Revision Act of 2006. As the 2010–2011 chair of the U.S. Amicus Subcommittee of the International Amicus Committee, David oversaw the submission of a number of amicus briefs, through which the Association influenced the outcome of several U.S. trademark cases, including *Chloe v. Queen Bee of Beverly Hills*, *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.* and *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*

In accepting the award, David said that it was an incredibly deep honor to be recognized along with some of the leading figures of the trademark profession whom he had long sought to emulate. His volunteer efforts for the Association have never felt like work, David explained, so it felt somewhat unusual for him to be honored for activities that were “pure joy.” David thanked his wife and three daughters, his partners at Debevoise & Plimpton and his many mentors—particularly Bruce Keller and Dolores Hanna.

Indeed, David says that it has taken an entire “village” of support to set him on the path to a successful career in trademark law. His mother, Diane Steiner, inspired him to consider a career in law “when she had the courage to divorce my father and become a lawyer herself to help others trapped in unhappy marriages.” At Princeton, David’s thesis advisor, Walter Murphy, encouraged him to consider a career in law that also would include policy components. Yale Law School professor Guido Calabresi sparked David’s interest in tort and property law and helped him obtain a clerkship with Judge Robert Keeton, who introduced David to IP law through some of the cases he handled during his clerkship year. David’s wife, Kim Grillo Bernstein, encouraged him to join the law firm of Debevoise & Plimpton, where his mentor, Bruce Keller, taught him everything he knows about trademarks and introduced him to INTA. “And Robin Rolfe and Dolores Hanna welcomed me into my first project for INTA—the inaugural Lefkowitz Moot Court Competition—which solidified my passion for both trademarks and a career-long relationship with INTA.”

One of the joys of practicing trademark law, David says, is that he has had the chance to learn about a myriad of industries and products from all around the world. “I’ve protected black charge cards, white rum bottles and red shoes; I’ve learned how to cure heartburn, athlete’s foot and flea infestations; I’ve learned how infant formula is made, how the South Beach Diet works and how vodka is distilled; I’ve traveled to Sydney, Moscow and Havana; and I’ve seized fake handbags, fake cigars and fake men’s hair color products (the latter of which, regrettably, is of little help to me now).”

Volunteer Service Awards

Subcommittee chairs, committee members and non-committee volunteers, such as authors and meeting speakers, are eligible for Volunteer Service Awards. Nominations come from those who are most knowledgeable about the quality of the volunteer effort: committee chairs and vice chairs, Board members and INTA staff. Association officers then select the winners.

Advancement of Trademark Law

The award for the Advancement of Trademark Law recognizes individuals whose efforts during the year have led to the advancement of substantive trademark law and practice.



Paul Kilmer (Holland & Knight, LLP— Washington, DC, USA) chaired the 2010–2011 Free Trade Areas Subcommittee of the Harmonization of Trademark Law and Practice Committee. He initiated a project to develop INTA’s Model Free Trade Agreement (FTA), which launched in May 2011. These FTA guidelines are intended to aid trade negotiations and ensure that trademark rights are properly protected. The Model Agreement has already been used as a model for negotiations of FTAs between the United States and Colombia, Panama and South Korea, and between the European Union and Singapore.

Paul was drawn to IP law because its focus on the protection of creative works reminded him of his own creative pursuits in school, where his activities included photography and theater. Paul maintains his interest in creative pursuits, as he still enjoys photography and accompanies his family to the theater. He enjoys traveling and particularly likes the outdoors, running and hiking with his dogs. “I also ride my bike quite a bit, including cycling to the office in Washington, DC, a couple of days a week, weather permitting.”

Advancement of Committee or Subcommittee Objectives



Katherine Keating (Holme Roberts & Owen LLP—San Francisco, California, USA) led the 2010–2011 Oppositions and Cancellations Subcommittee of the Enforcement Committee in presenting two Resolutions that were adopted by the Association’s Board of Directors earlier this year. One Resolution established guidelines for determining who should decide opposition proceedings; the other encouraged countries to allow third parties to initiate partial non-use cancellation actions to remove goods and services from the scope of existing trademark registrations when the trademark owner has not used the mark in connection with those goods or services within a specified time.



According to Katherine, the best part of working with trademarks is helping others grow their brands. "It is such a pleasure to watch a mark develop from a thought to a valuable asset that has a life of its own." Her favorite trademark is CHICAGO CUBS, so it should come as no surprise that Katherine spends her spare time watching baseball. "And in the months when there is no baseball, watching football. And the rest of the time, watching tennis."



Max Millican (Dell Inc.—Round Rock, Texas, USA) dedicated years to ensuring that Texas's trademark law was updated. For four years, she was a key player on the "Texas Team" within the Association's Model State Trademark Bill Subcommittee. Despite several hurdles along the way, Max remained positive and determined throughout the entire process. In June 2011, the Texas bill was signed into law—an achievement that would not have been possible without Max's work and tenacity.

Max advises those new to the trademark field to use the vast resources available on INTA's website and to attend the roundtables in their area, as well as INTA educational meetings. "Whenever possible, meet with the individuals you work with," she says. "In-person meetings improve the communication you will have via phone and email." When not working to protect her favorite trademark (DELL), Max enjoys traveling, hiking, and reading mysteries and history.



Brian Winterfeldt (Steptoe & Johnson LLP—Washington, DC, USA) has long played an active role in Internet-related matters. As chair of the Internet Governance and Contractual Relationships Subcommittee of INTA's Internet Committee, Brian led a team that developed the Association's formal submissions of comments on critical Internet-related issues, including comments to the U.S. Department of Commerce on its review of its current agreement with ICANN. Brian has also been a leading educator about ICANN's new gTLD program, including on INTA webcasts and at the recent "Trademarks and the Internet" conference.

Brian was drawn to the trademark field in law school, when he had the opportunity to work as a law clerk for Mary Denison (who is now at the USPTO but was in private practice at that time). In this position, and as an associate following law school, he learned about every aspect of trademark portfolio management. Brian says, "Mary not only taught me the foundations of trademark practice, but she infused me with the energy and enthusiasm for trademarks that have sustained me throughout my career. I also credit Mary with introducing me to and getting

me involved with INTA!"

Brian's favorite trademark is COCA-COLA. "To me, in addition to its iconic global nature, the COCA-COLA mark represents a culture of responsible corporate citizenship and an ongoing commitment to diversity and charitable activities."

Advancement of the Association

The award for the Advancement of the Association is presented to individuals who have most notably advanced the objectives of INTA outlined in the Association's Strategic Plan.



Gabrielle Olsson Skalin (Inter IKEA Holding Services SA—Waterloo, Belgium) has served as INTA's representative at OHIM's Administrative Board and Budget Committee (ABBC) meetings. As a result, she has been able to effectively promote the Association's positions on trademark policies in Europe. In addition to representing INTA at the OHIM meetings, Gabrielle has attended a series of CTM-review meetings at the European Commission to advocate INTA's views on important IP legislation. She has also been proactive in collaborating with other user associations.

One of the best things about working in the trademark field, Gabrielle says, is that it is a truly global and international area of law. "Irrespective of what kind of business and products you are interested in, practicing IP law gives you the possibility to work with all kinds of companies." She says that those starting their careers should try to broaden their experience as much as possible—for example, by working for an international company or by interacting with colleagues from a variety of professions. Gabrielle enjoys spending free time with her family as well as playing tennis and golf.

Pro Bono Services by Individuals



Florencia Rosati (Estudio Beccar Varela—Buenos Aires, Argentina) has been involved with a number of pro bono projects in Argentina. She serves as general counsel to Silvio Velo, the captain of Los Murcielagos, an Argentinean football club for blind players. She is also the general IP counsel to Red Comunidades Rurales, a network that organizes efforts and resources to support the development of rural workers. Most recently, Florencia has completed trademark prosecution work for Nuevos Aires, a foundation devoted to contributing to economic, social and environmental development.

When asked what advice she would give to those considering a career in trademark law, Florencia says, "I think it is very useful to work in a law firm while you study, because it is easier to realize what areas you are most interested in. I would not have imagined that I would love working with trademarks had I not had the chance to experience it." In her spare time, Florencia tries to spend as much time as possible with her family and friends, and also tries to make time for movies and tennis practice.

Pro Bono Services by Organizations

When the off-Broadway Brick Theater was sued for trademark infringement, **Morgan Lewis & Bockius** helped the Brooklyn, New York, USA-based venue stay in business. The firm argued on behalf of Brick Theater and ultimately won the case, as a result of which the theater was allowed to keep its name. The efforts of the attorneys at Morgan Lewis & Bockius helped preserve the center's good name within the local community.

Although every effort has been made to verify the accuracy of items in the INTA Bulletin, readers are urged to check independently on matters of specific concern or interest.

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