

Index

- Abella, Justice 215
- abuse of rights 219–24, 225
- accession principle 215–16
- accessories 174–5, 177
 - Australia 184–6
 - Singapore 188–9
 - see also* mutant trademark avoidance:
 - exclusion for accessories to parallel imports
- accountability 94, 95–6, 97, 137
- advertising 48, 118–19, 123, 299
 - spillover 48
- Africa 144
- Alito, Justice 168, 177, 182
- Almacenes Exito SA v. El Gallo Meat Market* 240–41
- anti-consumerism 138
- Anti-Counterfeiting Trade Agreement (ACTA) 15
- Anti-Cybersquatting Consumer Protection Act (ACPA)
 - see* Lanham Act
- appellations of origin 120
 - see also* geographic indications
- Apple 300
 - iPhone 2, 5
- Asia 144
- auditable certification standard (SA8000) 89
- Australia 174, 177, 179
 - accessory copyright 184–6
 - Copyright Act (1968) 207
 - Copyright Act section 44C 184–6, 188–9, 194
 - Copyright Law Review Committee 183, 207, 218
 - Federal Court (FCA) 184–6
 - functionality test 185–6
 - generic top level domain (gTLD) process 321
 - mutant trademark avoidance:
 - exclusion for accessories to parallel imports 183–6, 196
 - Polo/Lauren Company LP v. Ziliani Holdings* 185, 186
 - QS Holdings SARL v. Paul's Retail* 185–6
 - R. & A. Bailey & Co. v. Boccaccio* 183–4, 207–8
 - Supreme Court of New South Wales 183
 - 'wtf' application in generic top level domain (gTLD) process 315
- Bacardi v. Domench* 72
- Baeumer, L. 109–110
- Barcelona.com v. Excelentísimo Ayuntamiento de Barcelona* 7
- Bastarache, Justice 226–7, 230
- Bentham, Jeremy 9
- Bobbs-Merrill v. Straus* 160, 166–7
- Bosley v. Kremer* 319
- boycotting 138
- brand
 - building 280
 - consciousness 380
 - managers 302
- branding 298–300
 - see also* 'branding the land' strategies and geographic designators
- 'branding the land' strategies and geographic designators 100–124
 - advertising 118–19, 123
 - appellations of origin 120
 - certification marks 116–17, 120–21
 - collective marks 118–19, 121
 - collective organization 119–20

- culture authentication marks 106–8
- enforcement policy reconfiguration
 - to protect local identities 122–3
- handicrafts (human traditions) 102
- investment clusters 119–20
- local environmental factors (terroir) 102
- local identity, strengthening of
 - 108–116
 - ‘country of use’ veto 111
 - ‘first in time, first in right’ rule 110–11, 115
 - Lisbon Agreement 111–13
 - local meanings over
 - country-of-use meanings, precedence of 112
 - protected appellations 111–12
 - TRIPS Agreement 110–13, 115
 - wines and spirits, prohibition against use of geographical indications for 111–12
- local industries, supporting creation of 104–8
- traditional cultural expressions 104–5
- traditional knowledge, protection of 104–5
- Brazil 106
- Breyer, Justice 166, 167
- British-American Tobacco Co. v. Philip Morris Inc.* 70
- Brundtland Report on Environment and Development 136
- Budweiser mark in United States and Budweiser Budvar
 - mark in Czech Republic 114–15
- California District Court 173
- Canada 28–30, 107–8, 179
 - coffee industry 129
 - Copyright Modernization Act (2012) 191
 - Court of Appeal 210–11, 213, 215, 216
 - Court of First Instance 216
 - Euro-Excellence v. Kraft Canada* 190–91, 196
 - Federal Court 206
 - merely incidental 190–91
 - mutant trademark avoidance:
 - exclusion for accessories to parallel imports 190–92
 - Supreme Court 190, 206, 212, 213, 217, 223–4
 - see also* logos and packaging as copyrighted works
 - certification 116–17, 120–21
 - auditable (SA8000) 89
 - coffee industry 129, 134–6
 - initiatives for coffee 146–7
 - see also* certification in global value chains
 - certification in global value chains 79–99
 - certifications 88–90
 - consumers as regulatory entrepreneurs 96–8
 - marks 90–96
 - multi-stakeholder governance 84–5
 - standards 86–8
- Charron, Justice 226
- Cherokee Nation 107
- China
 - Beijing First Intermediate People’s Court 54
 - enforcement in developing countries:
 - counterfeiting as corporate externality imposed by MNCs 283, 290, 294–5, 296–7
 - interactional theory 54
 - Local Administration of Industry and Commerce 296
 - see also* counterfeit Olympics merchandise
- civil law 39, 225, 228, 230
- Clémence, A. 204–5, 208–9
- Coca-Cola 101, 159, 300
- coffee industry: moving from
 - commodity to differentiated exports 125–48
 - bird-friendly coffee 136–7, 138–9, 140–41, 148
- Café de Colombia: Juan Valdez logo 129
- changes in consumer patterns 126–7
- CIRAD (French agricultural research organisation) 130

- Coffee Industry Board of Jamaica (CIB) 135–6
- Coffee Industry Regulation Act 135
- Common Code for the Coffee Community (4C) 146
- corporate coffee sector 146
- decommodification 126–7
- differentiated coffees 127
- Directorate General of Intellectual Property Rights (DGIPR) 130
- eco-friendly coffee 136–7, 138, 140–41, 148
- Ethiopia Trademarking and Licensing Initiative 133
- Ethiopian Coffee Network 93, 133
- Ethiopian fine coffee trademarking and licensing initiative 131–2
- Ethiopian Intellectual Property Office (EIPO) 132–3
- fair trade coffees 136–7, 141–7
 - definition, philosophy and principles 141–3
 - fair trade coffee facts 143–6
 - fair trade labelling 143
 - industry-driven certification initiatives 146–7
 - long-term trading relationships 142
 - minimum price and social premium 143
 - trade with producers 142
- Fairtrade Labelling Organizations (FLO) 144
- Fairtrade Minimum Price or floor price 144
- Fairtrade Premium 144
- Flores Bajawa Arabica coffee 130
- Gayo Arabica coffee 130
- Global Partnership for Good Agricultural Practice protocols (Global-GAP) 146
- Guatemalan Antigua coffee 129
- Harrar/Harar 132–3
- Hawaiian Kona 128–9
- Indonesia Arabica coffee 129–30
- Indonesian Coffee and Cocoa Research Institute (ICCRI) 130
- International Coffee Organization (ICO) 139
- International Federation of Organic Agriculture Movements (IFOAM) 138–9
- Jamaica Blue Mountain Coffee 135–6
- Kintamani Bali Arabica coffee 130–31
- London LIFFE and fair trade prices for Robusta coffee 145–6
- National Coffee Association (NCA) 133
- National Federation of Coffee Growers of Colombia (FNC) 129
- New York and fair trade prices for Arabica coffee 144–5
- organic coffee 136–7, 138–9, 140–41, 148
- Rainforest Alliance 146
- Rainforest Alliance for ‘Rainforest Alliance Certified’ coffee 140, 148
- Robusta coffee 129–30
- shade-friendly coffee 136–7, 138, 140–41, 148
- Sidamo 132–3
- single-origin coffees 128–36
 - certification and collective marks 134–6
 - geographical indications of origin 128–31
 - trademarks 131–3
- Smithsonian Migratory Bird Center (SMBC) 140, 148
- Starbucks’ CAFE Practices (Coffee and Farmer Equity) Program 88, 146
- sustainable coffees 136–8
 - ethical consumerism 137–8
 - sustainable development 136–7
- third-party certified coffees 137, 146
- Utz Kapeh certification (Utz certified) 146
- Yirgachette 132–3
- Cohiba* case 75
- collective marks 118–19, 121
- coffee industry 134–6
- collective organization 119–20

- Colombia 129
- commercial piracy 285
 - see also* counterfeiting
- common law 39, 225, 228–9, 230
- Congress 6–7, 33
 - exhaustion 161, 166, 168, 170–72, 174–5, 177
 - mutant trademarks avoidance 181–2, 195
 - Second Circuit 27
 - treaty implementation 68, 69
 - well-known foreign marks
 - enforcement 240, 254–5, 256
- consumer recognition 43–6
- consumer safety 137
- consumer trust 85, 90, 97
- consumers as regulatory entrepreneurs 96–8
- cooperative movement 137
- Copyright Act
 - Australia 184–6, 188–9, 194, 207
 - Canada 202, 208–10, 214–15, 217, 219
 - section 27(2) 227
 - section 106(3) 181
 - section 109(a) 202
 - section 602(a) 179, 181–2
 - Singapore 187–9
 - South Africa 193, 216
 - see also under* exhaustion of trademark and copyright
- Corp. Cimex S.A. v. D.M. Enterprises & Distributors Inc.* 71
- Corporate Social Responsibility (CSR) 83, 89, 98, 137
- corrupt governments 283–5, 290, 296–7, 301–2, 304
- Costco Wholesale Corp. v. Omega* 163–4, 173, 180
- counterfeit Olympics merchandise in
 - China 259–82
 - Beijing Olympics and its aftermath 262–6
 - Beijing Organizing Committee for the Games of the XXIX Olympiad (BOCOG) 263, 264, 282
 - brand building 280
 - brand consciousness 380
 - brand owners, lessons for 270–75
 - co-branding 272
 - Copyright Law (1990) 278
 - country size 267
 - disposable income and purchasing power 281
 - ‘face saving’ 272, 280
 - future of trademark protection 275–82
 - GDP per capita 274
 - goodwill 280
 - heterogeneity 267
 - Host City Contract 264
 - International Olympic Committee (IOC) 264
 - Legend 275–6
 - LENOVO mark 276
 - Measures for the Recordal and Administration of Olympic Insignia 263
 - middle class and luxury goods 281–2
 - Morrison & Foerster LLP 264
 - National Intellectual Property Strategy 278
 - National Patent Development Strategy 278
 - Patent Law (1984) 278
 - protectionism 267, 269, 273
 - regionalism 268
 - Regulations on the Protection of Olympic Insignia 263
 - Regulations on the Protection of Olympics-Related Intellectual Property 262
 - Rule 40 264
 - ‘special enforcement’ approach 273–4
 - State Council 278
 - State Intellectual Property Office 278
 - structural problems 269
 - Trademark Law (1982) 275, 278
 - warlordism 268
 - World Trade Organization (WTO)
 - accession 280–81
- counterfeiting 122
 - see also* counterfeit Olympics merchandise in China;

- enforcement in developing countries: counterfeiting as corporate externality imposed by MNCs
- 'country of use' veto 111
- Court of Appeal 8
 - Canada 210–11, 213, 215, 216
- credible quality standards 92
- credit rating agencies 90
- Cuban Assets Control Regulations 73
- Cuban draft (1929) 65
- culture authentication marks 106–8
- Customs Service Regulations 160

- Dawn Donut v. Hart's Food Stores* 248–9
- Deng Xiaoping 268
- Denomination of Origin 129
- developing countries *see* enforcement in developing countries:
 - counterfeiting as corporate externality imposed by MNCs
- Diaz v. Servicios De Franquicia Pardo's S.A.C. (United States)* 70–71
- Dinwoodie, G. 257
- Directorate General of Intellectual Property Rights (DGIPR) 130
- distribution networks 289–90
- District Court 175

- East Asia 294
- Ecuador 129
- Empresa Cubana del Tabaco v. Culbro Corp.* 74, 239
- enforcement in developing countries:
 - counterfeiting as corporate externality imposed by MNCs 283–304
 - advertising, promotion and media 299
 - brand managers 302
 - China 283, 290, 294–5, 296–7
 - cigarettes 294–6
 - commercial piracy 285
 - consumer knowledge of counterfeit item 289
 - corrupt governments 283–5, 290, 301–2, 304
 - different consumer groups involved in purchasing goods 290
 - distribution networks 289–90
 - drugs and medicines 297
 - European countries 297
 - fraud or deception on the consumer 289
 - G20 countries 286
 - genuine product 287–9
 - global 10 most valuable brands 300
 - goodwill 284, 292–3, 299
 - gray marketing 288–9
 - harms from counterfeiting 291–8
 - government corruption and local protectionism 296–7
 - health and safety risks 297–8
 - MNCs' loss of control of how brands are presented to the public 292–4
 - organized crime 294–6
 - health and safety issues 284
 - human costs 284
 - industrial pollution 303
 - Internet purchase of counterfeit goods 290
 - legal system 301–2
 - luxury goods 289, 291
 - manufacturing costs reduction 301
 - market survey 288
 - MNCs' claims of financial losses from counterfeiting 286–91
 - assumptions used in determining volume and losses 288–91
 - consumers' knowledge of counterfeit purchase 291
 - MNCs' contribution to counterfeiting 298–304
 - branding 298–300
 - exaggeration of losses, reasons for 302–4
 - globalization and foreign direct investment 300–302
 - new technology introduction 301
 - on-the-ground market survey 287
 - organized crime 284–5, 297, 304
 - parallel imports 288–9
 - passing-off 292–3
 - pharmaceutical companies 298–9

- political costs 284
- prestige 293–4, 300
- professional services companies 299
- Racketeer Influenced and Corrupt Organizations Act (RICO) 295
- social costs 284–5
- street vendors 290
- Trademark Counterfeiting Act (1984) 295n
- enforcement policy reconfiguration to protect local identities 122–3
- environmental issues 83, 102, 137
- Ernst & Young 281
- ethical consumerism 137–8
- Ethiopia 93, 131–2, 133
- Euro-Excellence v. Kraft Canada* 190–91, 196
- Europe 147, 297
- European Community Trademark System 3
- European Union 172n
 - Brussels Regulation on Jurisdiction 4
 - coffee industry 129
 - Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs Regulation 112
 - Wine Regulation 115
- exceptions to territoriality 63–7
- exhaustion of trademark and copyright 8, 151–77
 - accessory copyright 174–5, 177
 - alternative approaches 154–8
 - Bobbs-Merrill v. Straus* 160, 166–7
 - Canada: logos and packaging as copyrighted works 203
 - Copyright Act (1909) 160
 - Copyright Act (1976) section 109(a) 151, 153, 158, 160–61, 162–3, 165–7, 168–9, 171, 176
 - Copyright Act (1976) section 602(a)(1) 161, 164, 168–9, 171, 176
 - Copyright Acts 172–3, 174–5, 177
 - Costco Wholesale Corp. v. Omega* 163–4, 173, 180
 - effects of different approaches 170–76
 - gray marketing 151–2, 157, 159–60, 162–3, 170, 171, 174, 176
 - impact of *Kirtsaeng* on gray marketing 164–70
 - incidental product features 152–3, 174
 - international exhaustion 153, 157, 163, 166, 171, 175, 177
 - Kirtsaeng v. Wiley & Sons* 151–4, 158, 170–71, 176–7
 - Lever Brothers* cases 160
 - leveraging copyright 173, 175
 - materially different 159–60
 - misuse of copyright 172–3, 175–6, 177
 - national exhaustion 153, 156–8, 163, 171, 177
 - Omega v. Costco* 173, 175
 - parallel imports 152–3, 156, 159, 162, 171–5, 177
 - pre-*Kirtsaeng* exhaustion 158–64
 - proprietary right 155
 - quality 160
 - Quality King v. L'anza* 162, 164, 165–6, 167–9, 177
 - regional exhaustion 157
 - restraint of alienation of private property 155
 - same ownership 159
 - extent of use 248
 - extraterritorial provisions, application of 75
 - extrinsic territoriality 250–51
 - fair trade standards 88
 - Fairtrade 90
 - see also under* coffee industry
 - Fairtrade Labeling Organizations (FLO International) 88, 89–90, 144
 - famous marks *see* well-known foreign marks
 - Federal Circuit 57–8, 75
 - Federal Court cases 72–5
 - Feng, P. 278
 - FERRARI trademark 50–51, 54
 - financial burdens 51
 - financial services industry 90

- 'first in time, first in right' rule 110–11, 115, 245–6
- first-party certifiers 82–3
- first-sale rule 181–2, 202
- Food and Agriculture Organization (FAO) 94
- foreign direct investment 300–302
- foreign nationals 254–5, 256–7
- Fourth Circuit 7–8
- France 130, 221–2, 225–6
 - Act of 1793 201
 - Champagne region 103, 118
 - Clement-Bayard spite and fence case (1917) 222
 - Code article 544 222
 - droit d'édition* 201
 - les juristes inquiets* 221
- Frank & Hirsch v. Roopand Brothers* 192–4
- Franpovi S.A. v. Wessin* 71–2
- free trade agreements (FTAs) 162, 169, 177, 181
- full screening 138
- functionality test 185–6
- fundamental doctrine 3
- G20 countries 286
- GE 300
- Geneva Convention 314
- Geny, F. 222
- geographic area of use 246–8
- geographic designators *see* 'branding the land' strategies and geographic designators
- geographic indications (GIs) 95–6, 128–31
- Germany 221
- Ginsburg, Justice 162, 165, 166, 169
- globalization 300–302
- Goodlatte, B. 171
- goodwill 246–7, 248, 257
 - counterfeit Olympics merchandise in China 280
- enforcement in developing countries:
 - counterfeiting as corporate externality imposed by MNCs 284, 292–3, 299
- Google 300
- grandfather clause 111
- gray marketing 8–9
 - Canada: logos and packaging as copyrighted works 201, 205
- enforcement in developing countries:
 - counterfeiting as corporate externality imposed by MNCs 288–9
- exhaustion of trademark and copyright 151–2, 157, 159–60, 162–3, 170–71, 174, 176
- South Africa 194–5
- Grupo Gigante SA de CV v. Dallo & Co.* (United States) 24–5, 237–9, 241
- Guatemala 129
- Gutteridge, H.C. 225
- Hague Conference (1925) 18, 41
- handicrafts (human traditions) 102
- Hanover Star Milling Co. v. Metcalf* (United States) 3
- Harrington, Justice 206, 207–8, 211–13
- Havana Club Holding v. Galleon* 72–3, 75
- Hayek, F.A. 222
- health and safety standards 83
- Hong Kong 3
- horsemeat scandal in European Union 82
- Houle v. Canadian National Bank* 224
- House Judiciary Committee 1954
- Howse, R. 98
- human rights 83
- IBM 300
- ICANN: generic top level domain (gTLD) process 307–23
 - Anti-Cybersquatting Consumer Protection Act 319
 - Applicant Guidebook 309–10, 317
 - auction process 316–17
 - Board of Directors (ICANN) 309, 316, 317
 - Bosley v. Kremer* 319
 - community-based objections 310–11
 - contention sets 310
 - curse words 315

- cybersquatting 307, 319
- domain name 307
- domain name disputes 308
- dotbrand 309
- Early Warnings 315
- fan sites, unauthorized 317–18
- ‘first come, first served’ basis 318
- formal objections 315–16
- General Services Administration 309
- generic words 309
- geographically based gTLDs 309
- Government Advisory Committee 316, 317
- governmentally significant terms 315
- gripe sites 307–8, 317–18, 319
- International Center for Dispute Resolution 310–11
- International Chamber of Commerce 311
- internationalized domain names 309
- internationally protected, well-known names 313
- left of the dot 317–21
- legal rights 310–11
- limited public interest grounds 310–11
- personal names protection 318
- political figures, significant 315
- politically, culturally, racially or otherwise offensive 315, 316–17
- regulatory challenges 321–2
- right of the dot 308, 313–17
- special protections 313
- sponsored new gTLDs 309
- string similarity 310–11
- TLD Applicant System software (ICANN) 312
- Uniform Domain Name Dispute Resolution Policy (UDRP) 308, 310, 312, 323
- Uniform Rapid Suspension (URS) 311, 312, 323
- Universal Postal Union 309
- World Intellectual Property Organization (WIPO) Arbitration and Mediation Center 311
- illegitimate motives 227–8
- incidental copyrights 152–3, 174, 195–6, 217
- India 106
 - Myesore silk 103
- Indonesia 129–31
- industry associations 89
- Intel 300
- intellectual property law 224–9
- intellectual property rights (IPRs) 172
- Inter-American Bureau (IAB) 71
- Inter-American Convention 70, 71, 73, 74
- Inter-American trademark convention in Mexico City (1902) 60
- interactional theory 43, 46–7, 52–5, 56
 - benefits 54–5
 - overview 52–4
- interactivity and well-known marks 37–56
 - consumer recognition 43–6
 - interactional theory 52–5
 - norms of international trademark system 38–43
 - passive perception theory 47–52
- International Anti-Counterfeiting Coalition 259
- International Berne Convention on Copyright 217n
- International Center for Dispute Resolution 310–11
- International Chamber of Commerce 259, 311
- International Congress of American States at Montevideo (1889) 60
- international exhaustion 153, 157, 163, 166, 171, 175, 177, 202
- International Federation of Organic Agriculture Movements (IFOAM) 94, 138–9
- International Federation of the Red Cross 313–14
- International Labor Organization 80
- International Olympic Committee 313–14

- International Organization for Standardization (ISO) 80, 90, 92
 9000 87, 88
 14000 88
 26000 89
- International Social and Environmental Accreditation and Labelling (ISEAL) Alliance 87–8, 91
- International Trademark Association (INTA) 50
- intrinsic territoriality 244–50
 domestic territoriality to well-known foreign marks 250
 territorial limits on trademark remedies 248–9
 territorial limits on unregistered trademark rights 245–8
- investment clusters 119–20
- Iroquois (Haudenosaunee) 107–8
- ITC Ltd. v. Punchgini Inc.* 26–7, 53–4, 240–42, 256
- Jacob, Sir Robin 9
- Jamaica 135–6
- Japan 141
- Joint Recommendation on Protection of Well-known Trademarks* (1999) 19–20, 35, 47–50
- Josserand, L. 221–4, 225–8
- jurisprudential positivism 222
- Kagan, Justice 163, 168, 170, 177, 182
- Kennedy, Justice 169
- Keynes, J.M. 143
- Keynesian model of economics 143
- Kimberley Process Certification Scheme 89
- Kirtsaeng v. John Wiley & Sons* 178, 180–82
see also under exhaustion of trademark and copyright
- Knopf, H. 217
- knowledge requirement 71
- Kraft v Euro-Excellence* (Canada) 200, 203, 204–19, 229–30
 accession principle 215–16
 Copyright Act section 27(2)(e) 209–11
 copyright perplexity and diversion 213–15
 interpretation of Copyright Act section 27(2)(e) 211–13
 missing points 215–19
 parties involved 204–5
 subterfuge and the lower courts 205–9
- Kysar, D. 85
- labelling, reliable 137
- labor characteristics 83
- Ladas, S.P. 62
- LaFrance, M. 173, 175
- Lanham Act 16, 28, 36, 319
 certification in global value chains 79, 93
 Federal court cases 73, 74
 necessity for amendment to 34–5
 Ninth Circuit 24–5
 ‘reverse domain name hijacking’ provision 7–8
 Second Circuit 26–7
 section 43(a) 239
 South Africa 33
 State courts 22
 Trademark Trial and Appeal Board (TTAB) cases 70
 treaty implementation in the United States 68–9
 United States Patent and Trademark Office (USPTO) 23
see also under well-known foreign marks enforcement
- Latin American states 61–2, 66–7, 76, 144
- Lebel, Justice 226
- LEED certifications 83
- Lever Brothers* cases 160
- leveraging copyright 173, 175
- likelihood of confusion 248–9, 252
- Lisbon Agreement 111–13
- Lisbon Conference (1958) 19, 46, 47
- local industries, supporting creation of 104–8
- local meanings over country-of-use meanings, precedence of 112

- logos and packaging as copyrighted works in Canada 200–230
- abuse of rights 219–24, 225
- Bill C-11 207
- Bill C-32 Committee 207
- Canadian Association of Manufacturers and Exporters (CAME) 213
- Civil Code of Québec 220, 224
- Copyright Act 208–9
- Copyright Act section 3(1) 202, 209–10
- Copyright Act section 27(1) 219
- Copyright Act section 27(2)(e) 214–15, 217
- Copyright Modernization Act 202
- exhaustion principle 203
- first-sale doctrine 202
- gray marketing 201, 205
- Houle v. Canadian National Bank* 224
- illegitimate motives 227–8
- incidental approach 217
- intellectual property law 224–9
- Intellectual Property Office 204
- international exhaustion 202
- misuse of copyright 200, 213
- parallel imports 201, 205, 207, 216
- Retail Council of Canada (RCOC) 213–14, 217
- separation of powers principle 227
- Théberge v. Galerie d'art du Petit Champlain* 215
- unreasonableness standard 224
- Volkswagen Canada v. Access International Automotive* 206–7
- see also Kraft v Euro-Excellence*
- Long, D. 272–3
- McCarthy, T.J. 34, 249
- McCarthy treatise 256
- McDonald's 300
- McDonald's Corp. v. Joburgers Drive-Inn Restaurant* (South Africa) 32–3
- McLachlin, Justice 215
- Madrid Agreement (1891) 39, 60
- Madrid Protocol 3, 39
- Madrid System 51
- Maison Prunier v. Prunier's Restaurant & Café* (United States) 236–7, 241
- market positioning, subtle 85
- marks 90–96
 - accountability and transparency 95–6
 - quality 91–4
- Massey, J. 269
- materially different 159–60
- Meidinger, E. 88, 97
- merely incidental 190–91
- merger analysis 194
- Mertha, A. 269
- Mexico 7, 106, 121
- Microsoft 300
- misleading quality assurance to consumers 81–2
- misuse of copyright 172–3, 175–6, 177, 200, 213
- Moody's 90
- Moyse, P.-E. 190
- multi-stakeholder governance 84–5
- multinational corporations *see*
 - enforcement in developing countries: counterfeiting as corporate externality imposed by MNCs
- Muñoz-Najar, L.A.G. 119
- Murtha, Judge 165
- mutant trademark avoidance: exclusion for accessories to parallel imports 178–99
 - accessory 197–8
 - Copyright Act section 106(3) 181
 - Copyright Act section 602(a) 179, 181–2
 - Costco Wholesale Corp. v. Omega* 180
 - first-sale rule 181–2
 - incidental copyrights 195–6
 - Kirtsaseng v. John Wiley & Sons* 178, 180–82
 - legislative solution for United States 195–8
 - parallel imports 179–82, 198
 - Quality King Distributors v. L'anza Research* 179–80, 181

- relative value of copyrighted feature 196–7
- see also* Australia; Canada; Singapore; South Africa
- Nairobi Treaty on the Protection of the Olympic Symbol (1981) 314
- national exhaustion 153, 156–8, 163, 171, 177
- national treatment principle 34
- New Zealand: *toi-iho* Maori-made goods 107
- Ninth Circuit 6, 24–5, 26
 - exhaustion 163, 173, 175
 - logos and packaging as copyrighted works 200
 - mutant trademarks avoidance 180
 - well-known foreign marks
 - enforcement 233, 237, 238, 241, 242
- non-governmental organizations (NGOs) 89, 96, 146
- norms of international trademark system 38–43
 - registration 39–40
 - territoriality 40–41
 - well-known marks: limited exception 41–3
- Novelty Pte Ltd v. Amanresorts* (Singapore) 31
- Obama Administration 181
- Office of Technology Assessment (OTA) 91–2, 97
- Omega v. Costco Wholesale* 173, 175, 200–201, 203
- Omnibus Appropriations Act 72–3
- ‘organic’ commodities 83
- organic standards 94
- Organisation for Economic Co-operation and Development (OECD) 259, 286–7
- organized crime 284–5, 294–6, 297, 304
- Orkin Exterminating Co. v. Pestco Co. of Canada* 28–9
- packaging *see* logos and packaging as copyrighted works in Canada
- Pakistan: clothing factory fire 82
- Pallante, M. 170–71
- Pan-American Trademark Convention (1929) 57–76
 - application of extraterritorial provisions 75
 - disputes invoking the Convention 70–75
 - Federal Court cases 72–5
 - Trademark Trial and Appeal Board (TTAB) cases 70–72
 - exceptions to territoriality 63–7
 - historical background of Inter-American Convention 59–63
 - treaties implementation in the United States 67–70
- parallel imports
 - Australia 184
 - Canada: logos and packaging as copyrighted works 201, 205, 207, 216
 - enforcement in developing countries: counterfeiting as corporate externality imposed by MNCs 288–9
 - exhaustion of trademark and copyright 152–3, 156, 159, 162, 171–5, 177
 - Singapore 186–7
 - South Africa 194
 - see also* mutant trademark avoidance: exclusion for accessories to parallel imports
- Paris Convention 4, 15–16, 21, 36, 46, 76
 - accountability and transparency 96
 - amendment to Lanham Act, necessity for 34–5
 - Canada 30
 - certification in global value chains 83–4, 99
 - coffee industry 128, 134
 - exceptions to territoriality 64, 66
 - generic top level domain (gTLD) process 314

- inter-American convention history
 - 59–63
- Ninth Circuit 25
- passive perception theory 47
- registration 39–40
- Second Circuit 26–7
- Singapore 30
- South Africa 33
- territoriality 41
- treaty implementation in the United States 68
- well-known foreign marks
 - enforcement 41–2, 234–5, 237, 239, 251
- Parma hams 114
- passing-off 91, 93, 292–3
- passive perception theory 42–3, 46, 47–52, 55–6
 - overview 47–50
 - problems 50–52
- Patent and Trademark Office 26
- Pepsi-Cola 101
- Person's Co. v. Christman* (United States) 57–8, 67, 75
- Peru 129
 - Bembos Burger Grill 102
 - Cumbe village 119
 - Inca Kola 102
 - Intellectual Property Office (INDECOPI) 123
- Philips, T. 274
- 'pisco' dispute between Peru and Chile 114
- Polo/Lauren Company LP v. Ziliani Holdings* 185, 186
- Porcherot, E. 220
- positive buying 138
- prestige 293–4, 300
- private law 224
- private standards 98
- product information, basic 137
- proprietary right 155
- protected appellations 111–12
- Protected Geographical Indication (PGI) 129
- Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs Regulation (European Union) 112
- protection of well-known marks:
 - transnational perspective 15–36
 - Canada 28–30
 - dilemma of well-known marks 17–18
 - Lanham Act, necessity for amendment to 34–5
 - Ninth Circuit: *Grupo Gigante v. Dallo* 24–5
 - Paris Convention 18–20
 - Second Circuit: *ITC v. Punchgini* 26–7
 - Singapore 30–32
 - South Africa 32–3
 - State courts 21–2
 - treaties in United States 21
 - United States Patent and Trademark Office (USPTO) 22–4
- protectionism 267, 269, 273, 296–7
- QS Holdings SARL v. Paul's Retail* 185–6
- quality 91–4, 160
- Quality King Distributors v. L'anza Research* 162, 164, 165–6, 167–9, 177, 179–80, 181
- R. & A. Bailey & Co. v. Boccaccio* 183–4, 207–8
- Radin, M.J. 86
- regional exhaustion 157
- Register/Registry of Copyright 164, 177
- registration 39–40
 - costs 51–2
- relationship purchasing 138
- relative value of copyrighted feature 196–7
- reputation 246–8, 249, 254, 257
- restraint of alienation of private property 155
- Rio de Janeiro convention (1906) 60
- Ripert, G. 220, 225–6, 227
- Rogers, E.S. 62–3, 65–6
- Rothstein, Justice 214–15, 217, 219, 226–7
- same ownership 159

- Samsung 300
- Santiago convention (1923) 60, 71–2
- Scalia, Justice 169
- Second Circuit 6, 26–7, 53–4, 73, 74
 - exhaustion 165, 166, 167
 - well-known foreign marks
 - enforcement 233, 239, 241, 242, 245, 248, 256
- second-party certifiers 83, 89
- ‘secondary meaning plus’ standard 238–9, 246
- self-executing treaties 67–9, 72, 73
- separation of powers principle 227
- Shenkar, O. 267, 280
- Singapore 3–4, 30–32, 174, 177, 179
 - Copyright Act 175
 - free trade agreement with United States 235–6
 - mutant trademark avoidance:
 - exclusion for accessories to parallel imports 186–90, 196
 - accessories 188–9
 - Copyright Act section 40A 187–9
 - parallel imports 186–7
 - Trademarks Act 30–31
- Sixth Circuit 249
- Social Accountability International (SAI) 89
- Socially Responsible Investment (SRI) funds 89
- South Africa 32–3, 179
 - Copyright Act (1978) 216
 - Frank & Hirsch v. Roopanand Brothers* 216
 - mutant trademark avoidance:
 - exclusion for accessories to parallel imports 192–5
 - Copyright Act 193
 - Frank & Hirsch v. Roopanand Brothers* 192–4
 - gray marketing 194–5
 - merger analysis 194
 - parallel imports 194
 - Supreme Court 192–4
 - well-known marks 42
- Spain 7–8
- Standard & Poor’s 90
- standard-setting organizations (SSOs) 84, 86, 91, 96
- standards 86–8
- state courts 26
- statutory law 229
- STORK CLUB case 247
- Supremacy Clause of the Constitution 69
- Supreme Court 72
 - Australia 183
 - Canada 190, 206, 212–13, 217, 223–4
 - exhaustion 162, 163, 164, 166, 171, 173
 - logos and packaging as copyrighted works 200, 203
 - mutant trademarks avoidance 179, 180
 - South Africa 192–3
 - trademark and copyright exhaustion 151–4
 - treaty implementation 69
 - well-known foreign marks
 - enforcement 245, 247
- sushi exposé in United States 82
- sustainable consumerism 138
- sustainable development 136–7
- Taiwan 141
- Tao Xinliang 271
- Tea Rose doctrine 245–7, 249
- Technical Barriers to Trade (TBT) 80, 86n, 87
- Tequila 114
- territorial limits on trademark remedies 248–9
- territorial limits on unregistered trademark rights 245–8
- Thailand 290
- The All England Lawn Tennis Club v. Creations Aromatiques* 23
- Théberge v. Galerie d’art du Petit Champlain* 215
- Third Circuit 161
- third-party certifiers 83, 88–90, 91, 137, 146
- TORRES mark in Portugal 115
- Toyota 300

- Trademark Board 23
- Trademark Trial and Appeal Board (TTAB) 70, 233, 237, 239
- Trademark Trial and Appeal Board (TTAB) cases 70–72, 233, 237, 239
- traditional cultural expressions 104–5
- traditional knowledge, protection of 104–5
- Trainer, T. 274–5
- Trans-Pacific Partnership Agreement (TPP) 170, 175, 177, 181, 191, 198
- transaction cost 85
- transparency 93–4, 95–6
- treaties implementation in the United States 67–70
- Trebilcock, M.J. 98
- TRIPS Agreement 4, 15, 20, 36
 - accountability and transparency 95–6
 - ‘branding the land’ strategies and geographic designators 110–13, 115
 - Canada 30
 - coffee industry 128, 134
 - exhaustion of trademark and copyright exhaustion 156, 161, 176
 - Ninth Circuit 25
 - passive perception theory 47–8
 - registration 39
 - Second Circuit 26
 - South Africa 32–3
 - standards 86
 - territoriality 41
 - well-known foreign marks enforcement 42–3, 234–6, 251
- trust function 99
- unfair competition doctrine 237
- Uniform Dispute Resolution Policy (UDRP) 7–8
- United Drug Co. v. Theodore Rectanus* (United States) 3, 5
- United Kingdom 137
 - Copyright Act (1911) 218
 - registration 39
- United Nations Conference on Trade and Development (UNCTAD) 94
- United Nations Resolution 89
- United States 229
 - coffee industry 129, 147
 - Copyright Act section 27(2) 227
 - enforcement in developing countries:
 - counterfeiting as corporate externality imposed by MNCs 287, 289–90, 294–5, 297
 - Federal Circuit 3
 - Green Building Council 83
 - International Trade Commission (USITC) 259–60, 286–7
 - Jordan Free Trade Agreement 169
 - Morocco Free Trade Agreement 170
 - Omega v. Costco Wholesale* 200–201, 203
 - Patent and Trademark Office (USPTO) 91, 93, 133
 - standards 86
 - Supreme Court cases 3, 5
 - Trade Representative (USTR) Secion 301 Report Watch List/Priority Watch List 259
- Universal Postal Union 309
- unreasonableness standard 224
- unregistered trademark rights, territorial limits on 245–8
- value-for-money 137
- Vaudable v. Montmartre* (United States) 22, 237, 239
- Vietnam 290
- Volkswagen Canada v. Access International Automotive* 206–7
- Washington conference (1929) 65
- well-known foreign marks enforcement 6, 233–58
 - Almacenes Exito SA v. El Gallo Meat Market* 240–41
 - Dawn Donut v. Hart’s Food Stores* 248–9
 - Empresa Cubana del Tabaco v. Culbro Corp.* 239
 - extent of use 248
 - extrinsic territoriality 250–51
 - first in time rule 245–6

- foreign nationals 254–5, 256–7
- geographic area of use 246–8
- goodwill 246–7, 248, 257
- Grupo Gigante SA de CV v. Dallo & Co.* 237–9, 241
- ITC Ltd. v. Punchgini* 240–42, 256
- Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks 235, 239
- Lanham Act 234, 237, 240, 251–7
 - sections 43(a), 44(b) and 44(h) 239, 244, 251, 252–6
 - standing under section 43(a) 256–7
- likelihood of confusion 248–9, 252
- McCarthy treatise 256n
- Maison Prunier v. Prunier's Restaurant & Café* 236–7, 241
- Paris Convention 234–5, 237, 239, 251
- reputation 246–8, 249, 254, 257
- 'secondary meaning plus' standard 238–9, 246
- Singapore free trade agreement 235–6
- STORK CLUB case 247
- Tea Rose doctrine 245–7, 249
- Trademark Trial and Appeal Board (TTAB) 233, 237, 239
- treaty obligations 234–6
- TRIPS Agreement 234–6, 251
- unfair competition doctrine 237
- Vaudable v. Montmartre* 237, 239
- zone of interest 256–7
 - see also* intrinsic territoriality
- well-known marks *see* interactivity and well-known marks; protection of well-known marks; well-known foreign marks enforcement
- wines and spirits, prohibition against use of geographical indications for 111–12
- World Intellectual Property Organization (WIPO) 43
 - Arbitration and Mediation Center 311
 - see also* Joint Recommendation
- World Trade Organization (WTO) 304
 - accession of China 280–81
 - Agreement on Technical Barriers to Trade (TBT) 80, 87
 - certification in global value chains 79
 - member nations 236
 - standards 86
 - United States–China dispute 260
 - see also* TRIPS Agreement
- Young, Justice 207
- zone of interest 256–7

