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Lawyer Annual 2023

Statutory damages provide key enforcement mechanism to curb counterfeiters

Nicholas J. Nowak, Matthew M. Zuziak and Will Rodenberg of Sterne, Kessler, Goldstein & Fox PLLC and Charles Hawkins, General Counsel, Intellectual Property & Litigation at Volkswagen Group of America, Inc., report on the *Verotec Wheels, Inc.* case that has solidified the structure for statutory damages.

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Women in IP Leadership

Celebrating achievements and continuing
the empowerment of women



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We give special thanks to Innocelf for their dedication and support in continuing
the empowerment of women in IP by facilitating this opportunity.

This segment is dedicated to women working in the IP industry, providing a platform to share real accounts from rising women around the globe. In these interviews we will be discussing experiences, celebrating milestones and achievements, and putting forward ideas for advancing equality and diversity.

By providing a platform to share personal experiences we aim to continue the empowerment of women in the world of IP.

This segment is sponsored by Innocelf, who, like *The Trademark Lawyer*, are passionate to continue the empowerment of women. Innocelfs' sponsorship enables us to remove the boundaries and offer this opportunity to all women in the sector. We give special thanks to Innocelf for supporting this project and creating the opportunity for women to share their experiences, allowing us to learn from each other, to take inspiration, and for continuing the liberation of women in IP.



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Innocelf is proud to sponsor this segment as a women-led organization. The world of intellectual property is constantly evolving, and women are leading the way with different skills and perspectives. We need more women in leadership positions in the world of IP to support rising female entrepreneurship across the globe.

Women have much to offer the world of IP, from law practices to legal tech. Increasing diversity in IP will reflect diversity in innovation and inventorship. Innocelf will continue to support them in their efforts to make a difference.

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If you would like the opportunity to share your experiences with *Women in IP Leadership*, would like to nominate an individual to be involved, or would like to learn more about sponsorship, please contact our Editor.

Virginia Wolk Marino: Partner, Crowell & Moring

An interview: inspirations, experiences, and ideas for equality.

Virginia is a partner in Crowell & Moring's Technology & Brand Protection Group in Chicago. She focuses her practice on all aspects of domestic and global brand protection, copyright, and unfair competition law. Virginia's extensive trademark prosecution, counseling and litigation practice includes the acquisition, maintenance, licensing, enforcement, and transfer of intellectual property. Her clients operate in a wide variety of industries, including biopharmaceutical, consumer goods, food and beverage, hospitality and travel, technology and luxury goods.

What inspired your career?

My career was inspired by an internship I completed during college, when I had an opportunity to work at the Australian Embassy in Washington D.C. While there, I worked at the Embassy's museum. This work touched on various aspects of museum law, as well as various national and international laws relating to artwork. The artwork being displayed at the museum was shipped on a regular basis from Australia, so I was exposed to issues related to artist attribution and provenance, particularly as it related to Aboriginal artists, and matters of that nature. My interest in IP law piqued there.

How have you found the pathway to your current position? And can you offer advice from your experience?

Despite being intrigued by IP law at the outset, I did take somewhat of a circuitous route through law school. I interned with the U.S. Department of Justice and I took a summer position working in-house for a large investment bank, so I did try on a couple of different hats on my way toward intellectual property law. That said, I was taking trademark and copyright classes because of my continuing interest in soft IP law. I knew that getting a job dedicated to soft IP would be difficult, as it is more of a niche field. Eventually, I found my way to an intellectual property boutique in Chicago where I was really fortunate to be offered a job in exactly the field I wanted to be in, focusing on trademarks and copyrights and other soft IP issues.

I would certainly advise people to try on various hats and really feel their way out when they're choosing which area of law they want to focus on. It's worth experimenting while you have the time and the bandwidth. This is particularly the case for law students, and lawyers, who don't have a technical degree, of which I am one, as it's important to realize that there are many pathways to practice intellectual property law. Those pathways exist outside of the soft IP realm. For example, you can still be a patent litigator even if you don't have a particular technical degree and aren't qualified to sit for the patent bar.



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There are so many things that we can be doing as individual attorneys to both improve retention and decrease attrition of women and diverse lawyers.
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Otherwise, I would advise that the people whom you surround yourself with matter. If you are in a position to have a choice in who your colleagues are, including mentors and sponsors, choose wisely. Not only will these people have a significant impact on your career, but consider how much time you will be spending with them over the course of your day-to-day working life. There are absolutely benefits to spending that time with folks you actually want to be around, on a personal level. Prioritize your mental and emotional well-being, in addition to your professional pathway.

What challenges have you faced? And how have you overcome them?

One personal challenge that I face - and I wouldn't trade this challenge for anything - is having three children, all of whom are quite young. So, certainly, balancing my home and career obligations was, and continues to be, a challenge. I'm hesitant to say that I've overcome that challenge because it's something I wrestle with on a daily basis, but I do think that I've found ways to manage that challenge. This includes relying on the support of my fantastic colleagues. I also work with wonderful clients who are likewise supportive, many of whom also have significant obligations outside of their jobs. I think working with supportive folks makes all the difference in the world.

I want to clarify that this is a caregiver role challenge, not a challenge that's unique to women or parents. There are many caregiving and personal obligations that people have outside of the office, and I think law has changed over the past 10-15 years, since I've been practicing, and has become more flexible. This flexibility promotes diversity by encouraging openness in terms of the way people talk about the various challenges that they are having at home. I've found that people can be very creative in addressing these challenges - this creativity should continue to be encouraged.

What would you consider to be your greatest achievement in your career so far?

Making partner has been my greatest professional achievement thus far, particularly in light of the fact that I am a working mum and I have significant obligations outside of the office. Being able to hit that milestone really meant a lot to me personally because it was something that I had worked very hard to achieve for a very long time. But it wasn't something I was able to accomplish in a vacuum, there were a lot of people who helped me along the way. I've always been fortunate in my career to have strong mentors, sponsors, and peers who have helped to boost me up.

What are your future career aspirations? And how will you work to achieve them?

I really love the type of work that I do; I'm passionate about working with trademarks and copyrights. I want to continue my work, particularly with solving complex and novel issues, as I find that to be very rewarding. One of the fun things about working with intellectual property is that you're working with people's ideas - somebody's sweat equity - it's their baby and they're trusting you to protect it, to enforce their rights, and really provide them with their pathway to move forward. It's incredibly rewarding work.

Another thing I want to continue doing is focusing on my own mentorship and sponsorship of junior attorneys, agents, and staff at the firm. Again, I've been so fortunate to have sponsors and mentors in my life who really care about me and my career, and it's very important to me to pass that forward. Even as a junior associate I realized that there were senior folks out there who were really looking out for me, on both a personal and professional level. I tried to start doing that early on in my career, really paying attention to new attorneys coming into the office and laterally in my professional network, even with new attorneys who were joining my clients in-house. I think about how can I help them achieve their career goals separate and apart from any particular matters that we might be working on together. I definitely want to continue to devote time to those initiatives and relationships moving forward.

What changes would you like to see in the IP industry regarding equality and diversity in the next five years?

Certainly, representation needs to improve - period. I think there's a lot of conversation about that issue, particularly in our field. The bottom line is, we as an industry need to do better. The number of diverse IP attorneys and practitioners - whether by racial or ethnic identity, gender, sexual orientation, ability, or otherwise - in this industry simply needs to improve, significantly. A lot of it comes down to accountability - of individuals, leaders, and clients. The industry is certainly moving in the right direction at a macro level, but I think real, meaningful change will come down to individuals taking accountability as well. There are so many things that we can be doing as individual attorneys to both improve retention and decrease attrition of women and diverse lawyers. We need to think about what we are doing as individuals to attract diverse talent and, equally as important, what we can do to welcome our new colleagues and promote them (at our firms, at our client organizations, or even through our professional organizations). I think that's a really important part of the

conversation, what are we doing in leadership roles or in our own capacities to help those lawyers' careers move along in a positive direction? Recruitment efforts don't mean much if you hire women and diverse attorneys as first-year associates or laterally, but a lack of mentorship, sponsorship, and advancement drive them to leave two or three years later. That's a pretty strong signal that something is awry.

When paying attention to the recruitment and retention of women and diverse talent, particularly in the IP industry because of the need for a technical degree to be able to sit for the patent bar, I think attention has to be paid at an undergraduate level because that's where the pipeline begins. Realizing that our attention as a community needs to be shifting even earlier, to be looking at what's going on at an undergrad level, will be crucial for diversifying the industry.

That said, education and outreach at the law school level is obviously necessary, as there are many pathways to practicing in the IP industry that don't involve a technical degree, and that may not be apparent to law students. There are various ways to integrate women and diverse talent on intellectual property service teams irrespective of whether there's a technical degree involved. That's where outreach and creative thinking need to come into play so that we can showcase these alternative pathways in our industry.

How do you think the empowerment of women can be continued and expanded in the IP sector?

Again, I think it comes down to accountability, and I think that accountability comes from different places. What's been really interesting over the past couple of years is seeing clients holding law firms accountable as to the number of women and diverse lawyers that are put on client teams. And not only that the numbers reflect a certain percentage of the team, but clients are demanding to interface with those women and diverse lawyers as integral members of the team. I think the push for equity has been accelerated by the folks who are buying legal services by making these demands known to law firms in a very vocal way, and law firms have had to step up to the plate and respond accordingly. It is crucial that clients continue to hold us accountable by not only communicating their commitment and standards for more diverse teams, but also closely scrutinizing our diversity data and following up with us to ensure we are providing substantive opportunities to our women and diverse team members. We all know at this point that research shows diverse teams perform better overall, so having a diverse client service team is a goal that both law firms, as well as the

clients that they're serving, will benefit from.

I think that law firms are doing a better job now in terms of the promotion and retention of women talent, and again it comes down to accountability. Having specific metrics in place that are transparent and measured, such as how many women attorneys are being promoted, how many are being considered for leadership positions, how many are being retained, etc., and then having easy and transparent access to those metrics is important because law firms need to hold themselves accountable. It is also imperative that law firms consider intersectionality in their discussions about women talent – only by understanding the experiences of women of all backgrounds can we begin to make real progress toward empowering women in IP and the legal industry more broadly. I think law firms that set goals based on these metrics, and hold their leadership accountable to those metrics, should see more success. For example, through my firm's Crowell Rule, a supplement to our Mansfield Rule participation on the recruitment side, my firm has various requirements in terms of how diverse and female talent is interviewed for lateral associate, counsel, and partner positions, where the interview pool must be at least 50% composed of women and diverse attorneys. Likewise, through our Diversity Pledge, Crowell has committed to adding 150 women and diverse lawyers to the firm within five years, by 2026. In the spirit of transparency, my firm's leadership have also reported internally on the progress of both aforementioned initiatives periodically. Making and enforcing these types of transparent metrics inspires accountability from all corners of our firm community.

Another way that firms can continue to increase retention and promotion of women attorneys is by making sure that when women and diverse attorneys are added to client teams, they're being credited accordingly. Being credited for contributions acknowledges the value of their talent and insights. And being valued, in a way that can be objectively measured, is a crucial retention tool.

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Prudence Jahja: Managing Partner, Januar Jahja and Partners

An interview: inspirations, experiences, and ideas for equality.

Currently Managing Partner of the boutique IP firm Januar Jahja and Partners based in Jakarta, Indonesia, Mrs. Prudence Jahja is widely recognized as one of the leading IP lawyers in Indonesia. As both a Registered IP Consultant and licensed attorney, her practice focuses both on trademark prosecution and IP litigation, as well as enforcement matters, including infringement matters and website takedowns. She also has experience advising on and prosecuting patent, industrial design, and copyright matters as well. Mrs. Jahja's work has been recognized by various outlets such as the Legal 500, WTR 1000, Managing IP/ IP Stars, and Chambers Asia Pacific. She has been named one of the Top 250 Women in IP and one of Indonesia's Top 100 Lawyers.

What inspired your career?

Law and IP were not strange things to me when I was growing up. My late father was an IP lawyer (he began practicing IP law in 1974) and was the founding partner of the firm. My mother actually decided to pursue a law degree and become an IP Consultant to help my father with his career and his firm. My brother also went to law school, though he then realized that it was not really for him and instead chose a career in IT. Despite this background, my parents never forced me to go to law school; however, my father and I had a lot of discussions about IP since I was young and he also encouraged me to learn English as well. Perhaps that was what led to my decision to go to law school and specialize in IP. Although some people may think that I'm "privileged" to continue my father's business, it has not always been an easy journey.

How have you found the pathway to your current position? And can you offer advice from your experience?

Even though my late father was the founding partner of the firm, to be where I am right now

did not come instantly; I only made partner after 10 years, which I think is normal in this industry. During that time, I had to work hard to demonstrate to him that I could positively contribute to the firm, bring in clients, and also make the firm better than it used to be. When he got sick and then later passed away, I felt like I already had a lot of experience and exposure on how to manage the firm because he brought me along very deliberately. I like to think that he would be very proud of how the firm is doing now.

To tell a bit about my career journey, I started with my father's firm after I graduated from law school and essentially became a paralegal for a few years. Two years later, I moved to Munich, Germany for a Master's Program in IP based at the Max Planck Institute. It was an excellent program, and we had the chance to learn about different legal systems, such as the EU and US legal systems as well as Japanese patent litigation, for example. I got to spend four weeks interning at a German IP Firm, which was a great experience and I even still work with them to this day. As soon as I graduated from Munich, I moved to New York and Washington DC to do an internship at an IP firm in Manhattan, New York and then at the Court of Appeal for the Federal Circuit in Washington D.C. I met my husband in New York (who is also a lawyer) and we decided to move back to Indonesia in 2012 and have been actively involved at the firm ever since.

These educational and professional opportunities really opened me up to a lot of new learning experiences and helped me make connections with a wide variety of IP professionals that have been very useful to my career. If I could offer some advice based on my experience, it would be to be brave and try to take on new challenges. Doing new and challenging things is not easy for me, but it helped me grow from these experiences and allowed me to start to develop my own personal network.

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My advice is to follow your instinct and pursue those dreams, focus on what you enjoy doing and things will happen.
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What challenges have you faced? And how have you overcome them?

After spending three years living abroad in Europe and the United States, I came back to Indonesia with the hope that I could help my father with his firm. Of course, there are both advantages and disadvantages to this approach. But even though the firm had already been established for 26 years at that time, I could still see a lot of room for improvement. My father was a great lawyer, but he only wanted to do the legal work. He did not like networking, business development, public speaking, etc. For me, that created a great opportunity so in the early years, I spent a lot of time traveling to conferences all over the world to try to further develop the firm's network and to learn more about the IP field. From this, I learned that it is important to talk to anyone and everyone because you really never know who might need your assistance, especially in a country like Indonesia which may not be at the top of everyone's list of most important IP jurisdictions.

When not traveling, I found that managing people could be very challenging, and sometimes frustrating as well. As our firm grows, we want to make sure that we only hire competent people who have the same vision and mission. While Indonesia has a large population, there are still deficits in education and IP can be a very specific field, so finding the right people has taken time. To help with this challenge, I relied on the people I trust the most – my

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Having people I really trust in important positions within the firm has allowed me to, in turn, focus on the legal work.
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husband, who also works at the firm, and my best friend from middle school, who switched careers to IP and is now our Head of Operations. Having people I really trust in important positions within the firm has allowed me to, in turn, focus on the legal work side of things, which helps keep the firm moving along and growing.

Another challenge that is faced daily is my jurisdiction, Indonesia. It's a large, spread-out country with a lot of diversity and beauty. But legal enforcement here can be difficult and unpredictable. Regulations can be vague, conflicting, or sometimes non-existent. As an IP Lawyer, we must explain to the client how the situation is in reality so they understand that what works in another country might not work in Indonesia. Despite those challenges, we can see that our governmental institutions are trying to improve themselves, which is reason for optimism.

What would you consider to be your greatest achievement in your career so far?

Honestly, this is a difficult question, but if I have to answer there are two things that stand out: 1) We won an important trademark cancellation case for a client against an Indonesian trademark squatter in a highly publicized case that went up to the Indonesian Supreme Court; and 2) Being able to move to a bigger and nicer office space in 2019. This has created a far more comfortable working environment for all of us and allowed us to add more employees as needed, instead of worrying about where we were going to fit them. One other, more recent thing that I'm proud of is that during the pandemic, we worked hard to take care of our employees, both emotionally and physically, and then later gave them the flexibility to adjust to the new working conditions that have arisen. I am thankful that we never had to lay anyone off and in fact, have added 15 new employees since the start of the pandemic.

What are your future career aspirations? And how will you work to achieve them?

I want to be considered one of the best IP lawyers in Indonesia. But at the same time, I would like to keep the firm size manageable so we can keep our focus on meeting our clients' Intellectual Property needs in Indonesia by providing them with the best service possible. To achieve that? I think hard work is the key, but it is also important to surround yourself with hard-working and honest people.

What changes would you like to see in the IP industry regarding equality and diversity in the next five years?

I think that women are already starting to drive equality and diversity forward in the IP industry.

I hope that by providing [women] with a safe yet challenging work environment, it will encourage them to do the same in the future when they become leaders of their own.

We realize that we really need to support each other both personally through friendships and also professionally through sharing work, referrals, etc. I have been lucky enough to have joined a few of these female-focused groups that have already formed and are active within some of the larger IP organizations and associations. This could be a model for other groups as well to band together to support and promote each other because, while there are barriers, the IP community overall seems like a supporting and caring place.

How do you think the empowerment of women can be continued and expanded in the IP sector?

It may be surprising but in the IP field as well as in the legal field more generally in Indonesia, it is common to see women as partners, managing partners, and in other positions of power. Of course, there are still issues to overcome but the infamous "glass ceiling" that certainly exists in other countries seems to either be much higher or perhaps gone altogether in Indonesia. As a female-led IP firm, we have focused on hiring (and retaining) smart, honest and professional women across all levels of our firm. As a result of those efforts, I can say that over 80% of our firm is female. I hope that by providing them with a safe yet challenging work environment, it will encourage them to do the same in the future when they become leaders of their own.



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