



# MARQUES

MARQUES  
Achievement List

In Memoriam Berenika Depo

Ingredient branding

 GeoNews

Domain names  
in Denmark

Google and eBay cases  
in France

## Find out more about MARQUES Achievements

What have **MARQUES** members and Teams accomplished during the past year? Among the many achievements are input into the study into the European trade mark system; representation before the European Commission, UNCITRAL, OHIM and WIPO; and events as wide ranging as the Trade Mark User Forum and Judges Meeting.

You can read full details of the recent **MARQUES** accomplishments, as well as the achievements of specific teams, in the **MARQUES** Achievement List, which is available on the website and was distributed to those attending the Annual Conference in Berlin.

The Berlin meeting, which took place from 14th to 17th September, is just one of the events organised by **MARQUES** this year. Others highlighted in the Achievement List include a designs seminar in Paris, a trade mark roundtable in Düsseldorf and a parallel trade workshop in Brussels, as well as the Winter Meeting which was this year held in Nice. The third Judges Meeting organised by **MARQUES** will take place in Munich in December.

### Team work

The Achievement List also highlights the work done by many of the **MARQUES** Teams, including submissions in key European trade mark cases and in response to WIPO and OHIM initiatives; attendance at various events addressing anti-counterfeiting, domain names and policy in China; and the publication of articles on topics of interest to **MARQUES** members.

Other notable achievements include the publication of information on the **MARQUES** website, such as the Advertising Portal; a guide to look-alikes entitled Who's Behind the Mask; a table on GI protection; and a Due Diligence Check List.

**MARQUES** Teams have also been busy analysing legislative proposals in Europe, China and elsewhere, as well as plans to expand the domain name system.

The Achievement List shows the wide range and important impact of the work of **MARQUES** Teams and members in the interests of trade mark owners during the past year. Read it in full [here](#).

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## Berenika Depo

MARQUES is very sad to note the sudden passing away of Berenika Depo on 4 August. Berenika was a partner of LDS Lazewski Depo in Poland and an active member of the MARQUES Amicus Curiae Team.



Berenika had a very good knowledge of trade marks and was widely known and admired around the world. Before being admitted as a patent attorney in 2005, she had been the first Polish examiner employed at OHIM.

Berenika's family, along with the Polish Chamber of Patent Attorneys, has established an award in her name to be presented to a talented young IP lawyer in Poland.

More information about the award, and how to make donations to the fund, are available online [here](#). It is also possible to write condolences.

## Is ingredient branding worth a try?

IAM Team member Anastassia Sinitsyna of Gowlings International Inc provides an overview of the benefits and challenges of ingredient branding



In today's market environment, when consumers select specific aspects to value and this drives purchasing decisions, businesses are being forced to be faster and more flexible to gain a competitive advantage and find ways to differentiate.

Ingredient branding is a strategic branding effort to show the benefits of the ingredient and increase its appeal for consumers by putting the brand of an ingredient on the outside of a product.

Ingredient branding has become a popular marketing strategy since the late 1980s. Intel Inside in PCs remains one of the most quoted examples of ingredient branding. Among other early adopters are NutraSweet with diet soft drinks,



Dolby Laboratories with noise reduction stereos, Teflon with cookware and Bayer with Makrolon plastic products. According to marketing and brand consultant David Aaker: "Ingredient branding hurts the top-end players just as often as it helps the bottom-end players."



### Successful ingredient branding

Being a multi-stage marketing process, ingredient branding requires careful planning and accurate monitoring. Factors in the successful implementation of ingredient branding include:

- the host brand must be widely recognised and valued by consumers;
- the final product must be complex and multi-component;
- ingredients have to be a point of differentiation and create sustainable value for the consumer;
- ingredients must be key to the functional performance of the host brand product;
- ingredients must be supported by scientific research and legal protection;
- host and ingredient branders should demonstrate a willingness for pro-active collaboration and commitment to show the same level of product quality.

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## Is ingredient branding worth a try? - continued...

### Challenges

Ingredient branders should be prepared to predict and forestall the challenges. These include:

- risk of compromise of the host brand identity or conflict with its core values;
- risk of negative publicity involving the host brand;
- becoming a visible target to competitors;
- the host brand owner may develop a strong dependence on the ingredient brand supplier;
- consumers may become sceptical of the additional value of an ingredient;
- the exclusivity of the ingredient brand may lead to generalisation of the brand where the licensing is not controlled and proper use is not policed.

**“Being a multi-stage marketing process, ingredient branding requires careful planning and accurate monitoring.”**

If managed appropriately, ingredient branding can become a powerful marketing tool reassuring your customers of the performance and quality of the proposed product and providing differentiation from your competitors.

### Benefits of successful ingredient branding

- increased quality and value of the host product;
- increased consumer loyalty to the host product;
- ability to follow new trends and technology;
- alternative market strategies for the host brand;
- creation of secure barriers to market entry of low cost competitors;
- potential cost saving benefits in marketing and product development.

### Further development of successful ingredient brands:

- appliance of established ingredient into new categories;
- ingredients maturing to major brands;
- development of in-house ingredients.

## GeoNews: Budweiser, Rijavina and more

This month: the European Court of Justice has ruled that Anheuser-Busch may not register BUDWEISER for beer in the European Community; RIOJAVINA is not acceptable for vinegar; Finland asks preliminary questions on the applicability of the Regulation for geographical indications of spirit drinks; and roosters, apparently, are Portuguese.

By Paul Reeskamp and Fiona Muir of Allen & Overy and Miguel Angel Medina of Elzaburu, members of the GI Team

### Budweiser cannot be registered as a CTM for beer

Anheuser-Busch may not register the word Budweiser as a Community trade mark for beer (ECJ, 29 July 2010, C-214/09 P, Anheuser Busch Inc v Budějovický Budvar).

Czech brewery Budějovický Budvar, as owner of a prior international word mark BUDWEISER, had brought



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## GeoNews - continued...

opposition proceedings against that registration. The Court confirmed that the Czech brewery was not obliged to provide, automatically, proof of renewal of its earlier identical mark during the period set for submission of evidence in support of its opposition.

### Riojavina for vinegar not allowed

Based on the high degree of phonetic similarity between the words Riojavina and Rioja the Court ruled that there is a likelihood of confusion between the proposed CTM for RIOJAVINA and the figurative trade mark that contains the word Rioja (General Court, T-138/09, Muñoz Arraiza v OHIM – Consejo Regulador de la Denominación de Origen Calificada Rioja).

The fact that the proposed CTM Riojavina was registered for vinegars, or that the trade mark RIOJAVINA is registered in Spain, is no reason to decide otherwise. The relevant public would still assume that the vinegar and the wine have the same commercial origin.

### Preliminary questions on the applicability of EC Regulation 110/2008 before 2008

Finland has asked the European Court of Justice to clarify whether EC Regulation C110/2008 regarding geographical indications on spirit drinks is applicable to trade marks containing a geographical indication that were applied for in 2001 and registered in 2003 ((C-4/10 and C-27/10).

### El Gallo Verde blocked

The Spanish Patent and Trade Mark office has rejected a Spanish trade mark application for EL GALLO VERDE (Spanish for the green rooster) for wines due to its incompatibility with VINHO VERDE, a famous protected designation of origin registered in the European Union for Portuguese wines (Spanish Patent and Trade Mark Office, 1 February 2010, BOPI, 17 February 2010, El Gallo Verde).

While the PDO was not mentioned as such, one of the arguments used during the opposition was that the rooster is a typical symbol associated with Portugal.

The decision also mentions that the trade mark was deceptive in its nature and origins of goods and that it conflicts with an international trade mark for VINHO VERDE.

## Free permanent blocking for domain names in Denmark

Denmark has introduced a mechanism whereby trade mark owners can permanently block typosquatted domain names. Once the names have been blocked, they are effectively removed from the pool of registrable names, without the trade mark owner having to register and renew them. Hanne Weywardt of MAQS Law Firm says trade mark owners should check whether there are typosquatted Danish domain names – owned by themselves or third parties – which could be permanently blocked, effectively reducing future watching and renewal costs.



### Typosquatting

As of 1 July, it is possible to permanently remove typosquatted domain names from the Danish (.dk) domain name register. The new [rules](#) are the latest effort to curb typosquatting in Denmark, which has a series of mechanisms to suspend and remove harmful and/or infringing domain names.

Denmark has had rules to summarily transfer or cancel registration of typosquatted domain

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## Free permanent blocking for domain names in Denmark - continued...

names since 2005. Over 2,000 typosquatted domain names have been transferred/cancelled since then. Aggrieved parties – typically trade mark owners – had the opportunity to either register the domain name themselves (transfer), or have the registration cancelled. Experience has shown that cancelled domain names were often re-registered, sometimes several times.

Repeated cancellation is a waste of resources, both on behalf of trade mark owners and [DK-Hostmaster](#), the Danish domain name administrator. To address this problem, blocking has been introduced as an extra option available to trade mark owners.

**“Trade mark owners that block typosquatted domain names will not be able to use these to point to the proper site.”**

### Blocked domain names

A blocked domain name is permanently removed from the Danish domain name space and will not function. Blocked domain names are not registered, and as such do not have to be renewed. This means that trade mark owners that block typosquatted domain names will not be able to use these to point to the proper site.

**“To address this problem, blocking has been introduced as an extra option available to trade mark owners.”**

In the event someone wants to register a blocked domain name, the entity that had had the name blocked (typically a trade mark owner) must be contacted and given the opportunity to comment. If the blocking entity refuses to accept the registration of the blocked name by the new registrant, a case can be brought before the [Danish Complaints Board for Domain Names](#) (a kind of Danish UDRP).

If the blocking entity does not respond within 28 days, the domain name will be unblocked automatically.

### Criteria for blocking

For a name to be blocked, it must have been typosquatted in Denmark. A typosquatted domain name is one that meets the following criteria:

- There must be an obvious risk that internet users who are looking for the complainant's website, due to a key error, get directed to another website or other service;
- The registrant of the domain name has no trade mark rights or other rights in the domain name; and
- The registrant of the domain name or someone who may work in close association with him or her has undertaken registration of other typosquatted domain names (serial typosquatter).

The new rules will be effective retroactively, which means that any domain names previously adjudged to be typosquatted in Denmark are eligible for permanent blocking after 1 July. It can be expected that blocking domain names will be a relatively inexpensive administrative procedure.

Trade mark owners with one or more typosquatted Danish (.dk) domain names which do not direct significant traffic should consider having these permanently removed from the Danish register by utilising the new rules.

## Google and eBay changes in France

The summer period in France has been far from quiet as striking developments arose regarding Google AdWords, Google Suggest and eBay. Franck Soutoul and Jean-Philippe Bresson of INLEX explain.



Google AdWords moves forward



After the decision of the ECJ of 23 March 2010, the French Supreme Court took back the joint cases to rule on 13 July that Google's AdWords system did not infringe the trade marks of Louis Vuitton, CNRRH, GIFAM and Viaticum.

The French decisions confirmed that Google would be held liable for trade mark infringement

only if it was aware of the illegal character of the data stored and failed to take action.

It was reiterated that a trade mark owner is entitled to prohibit advertisers from advertising, on the basis of a keyword that is identical or similar to a trade mark, goods or services identical to those for which that mark is registered when that advertising does not or hardly allows an average internet user to ascertain that the goods or services originate either from him or from an undertaking economically connected to him or otherwise from a third party.

Google France announced on 4 August a new policy on AdWords, with effect from 14 September. These changes will soften the system and further reduce cases where trade marks reserved as keywords by third parties can be prevented. The French system will be in line with those in the USA, UK and Ireland.

**“Google would be held liable for trade mark infringement only if it was aware of the illegal character of the data stored and failed to take action.”**

### Google Suggest's U-turn

A decision of 22 July has led to a complete U-turn in French practice by denying Google's liability regarding its Suggest system.

Google France and Google Inc were sued for trade mark infringement and harm to a company name because internet users searching for 'OMNIUM' or 'OMNIUM FINANCE' were given the suggestions 'Omnium Finance arnaque' ('Omnium Finance rip-off') or 'Omnium Finance escroquerie' ('Omnium Finance swindle') by Google's tool.

For the Court, the plaintiff's marks had not been used for promoting services of competitors. Only a polemical use made in the course of ordinary trade was concerned.

The addition of a company name to an uncomplimentary word was also regarded as not reprehensible in itself.

This is the third proceeding directed against Google Suggest before the French courts. Google had been found liable in the two other proceedings, which went to the courts of appeal last December.

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## Google and eBay changes in France - continued...

### eBay liability steps up



On 20 July, the Court of Appeal of Reims ruled that eBay and a seller of fake Hermès bags on [www.ebay.fr](http://www.ebay.fr) had infringed the marks of Hermès International.

The Court said that, when the fake Hermès bags were sold in 2006 on the auction site, eBay had not set up full and complete information tools enabling its users to properly identify legitimate items offered for sale and differentiating them from counterfeit products.

The Court pointed out that a hosting company such as eBay, offering services which aim to take

advantage of the attractive value of stored data, goes beyond simply hosting, cannot be regarded as neutral and is consequently fully responsible for the website content.

**“We now need to know whether this direction will be further adopted by French case law generally.”**

A deep analysis of the services for starting, concluding and following the transactions on [www.ebay.fr](http://www.ebay.fr) was applied.

The “purchase suggestion” link, “marketing tools”, warranties offered by Paypal and amounts paid to eBay on the basis of the sale prices of the items led the Court to consider that eBay could not be regarded as purely offering technical, automatic and passive activities as its interventions determined the effective and final contents of the ads presenting the items offered for sale.

This is the first decision of a French Court of Appeal on eBay's liability. It draws an apparent line, preventing eBay from benefiting from the limited responsibility of a hosting company.

We now need to know whether this direction will be further adopted by French case law generally.

The circumstances of the case at hand went back to a situation dated back to 2006 and the eBay system has evolved quite a lot in four years.

Indeed, on May 13 2009, the Court of First Instance of Paris ruled that trade mark infringement against eBay could only be brought where knowledge of the infringing content is shown as well as eBay's failure to remedy it.

**For full reports, photos  
and videos from the  
MARQUES Annual  
Conference in Berlin,  
look out for the next  
newsletter or visit the  
MARQUES website.**