

MARQUES Reloaded

The 24th **MARQUES** Annual Conference was held in Berlin from 14th to 17th September.

The theme was **MARQUES Reloaded – An Update to Hot Topics**, and despite the variable weather nearly 600 attendees from 55 countries enjoyed discussions, talks and networking.



A German band welcomed attendees at a reception in the InterContinental Hotel on Tuesday evening

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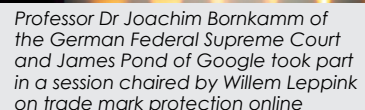
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Entertainment at the Welcome Reception included a magician



Cornelia Rudloff-Schäffer, President of the German Patent and Trademark Office, formally opened the Annual Conference



Uwe Over of Henkel AG & Co discussed IP portfolio consolidation as part of a session on financing



In a panel on marketing, Nick Foot of HJ Heinz Company spoke about brand licensing



Wednesday evening's reception was held in a beer hall, with traditional German food and drinks



The entertainment included a tribute to the musical Cabaret



Thomas Raab of Taylor Wessing moderated a panel on designs and copyright featuring David Stone of Simmons & Simmons, Bert-Jan van den Akker of Dijkstra Voermans and Elke Hoffmann of Villeroy & Boch



Attendees enjoyed the all-round recreation of 1930s Berlin



The Gala Dinner featured entertainment from a pair of mime artists



Shane Smyth of FR Kelly revealed the winner of the prize for choosing a brand name for the Dolly Parton/Guido Baumgartner perfume during the Gala Dinner



MARQUES presented a gift to Wubbo de Boer, who retired as OHIM President in September 2010 after 10 years in the role. In a forthright speech, Wubbo emphasised that the CTM system must continue to evolve to meet users' needs



Matthijs Geuze provided a timely update on developments from WIPO, including on the Lisbon system for geographical indications



Thursday's keynote speaker was Christiane von Trotha of KPMG, who gave a fascinating account of the evolution and role of brands in the porcelain industry



Roland Mallinson of Taylor Wessing and Andreas Lubberger of Lubberger - Lehment posed as cowboys to compare the good, the bad and the ugly - unfair competition and passing off



Frauke Asendorf received the 2010 Lewis Gaze Memorial Award for her paper titled "A Piece of (the) Cake dangers for proprietors and licensees due to infringement of Community Trade Marks"



After the Gala Dinner there was live rock music

Read detailed reports of the **MARQUES Annual Conference** sessions on the [Class 46 blog](#)

Managing historic brands

IAM Team members Leo Longauer of UBS and Ben Goodger of Edwards Angell Palmer & Dodge provide advice on resurrecting old brands.



In our globalised and fast-moving economy it is common for historic brands to cease being used because of marketing considerations or consolidation through mergers. As a result, branding specialists and IP managers find themselves sitting on trade mark portfolios that no longer fulfil their primary role: that of identifying the source of a product or service. They are, so to speak, dead. Well, are they really?

Historic brands can be extremely valuable assets. It is striking how long residual goodwill or brand equity can persist in the marketplace. The more (positive) recognition left and still present in people's heads, the more valuable is a historic brand.



An extreme example is Condé Nast's magazine title VANITY FAIR which flourished in the affluent 1920s but folded in 1935. It was revived by Condé Nast in 1983 in the middle of another boom and has done well since.

A slightly less distant example is the FIFA World Cup brands such as World Cup Willie for England 1966 and Footix, the French cockerel of 1998. FIFA realised the continuing value of these mascots and other merchandise such as posters and shirt designs, and has for some years been successfully building a retro merchandising business from these assets.

“ VANITY FAIR flourished in the affluent 1920s but folded in 1935. It was revived by Condé Nast in 1983. ”

The key issue is to get a sense of how much residual goodwill is left in the marketplace – and with what sections of the potential buying public. Some brands are truly dead and not worth reviving: despite some attempts, it is hard to see PAN AM ever returning as an airline brand.

But where there is enough positive recognition left in people's heads, this delivers the major advantage of saving on the marketing costs needed for introducing a new brand from nothing.

An existing base like this is something that, with skill, can be built on. Cadbury's revival of the WISPA chocolate bar brand came about through a clever “brought back by public demand” campaign.



Brands with built-in goodwill can be a great asset for bad times, when a new (or in this case old) brand is needed to replace a damaged one, or to launch a new product or service.

In the US in particular, trade mark trolls have noticed the unprotected value of historic brands that have not been used sufficiently and have developed a business model out of it.

When such a troll files a historic brand as a trade mark, and the original owner cannot prove sufficient used for the goods and services in question, the only solution might be a costly settlement.

Similarly we have seen the emergence in recent years of Chinese buyers of famous but declining brands, keen to leapfrog their products to instant familiarity in the market place.

This is particularly the case in the automotive sector, with the acquisitions of MG, ROVER and VOLVO.

A topic of discord

However while historic brands can be opportunities, filled with values and memories, untapped assets or (to borrow a patent analogy) "Rembrandts in the attic", they can be a topic of discord between trade mark counsel and branding teams.

For the trade mark counsel, unused brands become vulnerable to cancellation for non-use once the respective grace-periods have expired and can end up being seen as nothing more than a cost burden in often already stretched IP budgets.

What legal issues need to be addressed in reviving a brand that has ceased to be in use,

or in warehousing dormant brands for possible future relaunch? When asked to keep up robust protection for historic brands, trade mark counsel need to define the level of required use. It must be genuine use, which means that producing a leaflet a year with the brand in question will not be enough.

Depending on the jurisdiction, these brands may need to be present on goods and services used in commerce and actively marketed.

Hence, implementing a long-term protection strategy for historic brands needs to be carefully planned and to be in line with the company branding strategy in general.

Trade mark counsel have to push the branding specialists to be specific about when, where and for what they would like to use a historic brand. Only this information will enable to them to design the ideal protection plan.

Another difficulty with relaunching historic brands is the specification of goods and services covered by the existing trade mark registrations, which will not always match the intended re-use of a trade mark.

For single-class brands like pharmaceuticals or tobacco goods this may not be an issue, but for brands that may be suitable for, say, general

merchandising, this is more of a problem. And what about the geographic scope of the portfolio?

Trade mark counsel will have to ask themselves: do I have protection for what and where I need it? If the brands have not been used for a long period, it might be necessary to conduct third-party searches to make sure that no third party has used – or registered – it in between.

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In short, plans for the resurrection of a historic brand do not correspond to its historic legal protection, making it necessary almost to start from scratch, searching and registering the brand as if it were new.

Faced with the practicalities and costs of this exercise, the branding people might lose their enthusiasm for the old brands and turn to something really new.

GI GeoNews

Champagne, wine and Lisbon

This month: Unilever will not be celebrating with Champagne any time soon. The EU however does have reason to celebrate as a trade agreement, protecting geographical indications on wine, has come into force with Australia. However, the WIPO Working Group would prefer it if the EU would become part of the Lisbon system instead of making bilateral agreements.



By **Paul Reeskamp of Allen & Overy**, a member of the GI Team

Unilever not allowed to use Champagne Shampoo
(District Court of The Hague, 8th October 2010, Case number 374579, CIVC v Unilever)

In honour of Andrélon's (a Unilever shampoo brand) 70th anniversary Unilever launched a special edition line of shampoo called Champagne Shampoo



Andrélon Champagne shampoo advertisement

and marketed the new shampoo intensely. In summary proceedings the district court of The Hague enjoined Unilever from using the designation of origin Champagne as it infringed on the rights of the Comité Interprofessionnel du Vin de Champagne (CIVC).

Interestingly, in this case Unilever had not even disputed that it was infringing upon the protected designation of origin Champagne.

EU-Australia wine trade agreement enters into force *(thanks to Sébastien Vitali)*

As of 1st September 2010 a new agreement governing the wine trade between Australia and the European Union has entered into force. This agreement replaces the previous agreement signed in 1994. The new agreement protects the EU's wine-labelling regime and gives full protection to EU geographical indications, including wines intended for export to third countries.



EU-Australia wine agreement enters into force

The wine agreement also provides for the phasing out of the use of a number of important EU names such as Champagne and Port on Australian wines within a year of the agreement coming into force.

WIPO Working Group on the Development of the Lisbon system continues to discuss changes to be made to the Lisbon Agreement

In early September 2010 the WIPO Working Group, in which **MARQUES** has observer status, held its second session to discuss the changes it deems necessary for the Lisbon System.

The Working Group is trying to make the system more attractive for new members to join and to create the possibility for intergovernmental organisations to join.

The overall feeling during the session was that to make progress, it would be better to amend the existing Lisbon agreement as opposed to creating a new one.

The European Union has entered into many bilateral agreements and the Working Group feels it would be beneficial if the European Union would join the Lisbon agreement.

Italy takes another step toward international standards

Benedetta Cordovado, trademark counsel at Abbott Healthcare Products BV, discusses the latest revision of the Italian IP Code.

Five years after the new Italian IP Code in 2005, the long-awaited Executive Regulation and a revision of the IP Code itself entered into force in Italy this year.

While the Executive Regulation clarifies and simplifies the procedures to obtain, protect and enforce IP rights, the revision of the IP Code strengthens and improves this protection and continues the European and international harmonisation process.

Online system

It will soon be possible to file via an online system not only trade mark and patent applications, but also any request for amendment or change, as well as oppositions and recourses. In addition to the paper version, the Trade Mark and Patent Office will release an electronic version of the Trade Mark Bulletin.

Trade marks

Trade mark applications for a portrait or for a well-known sign will not be accepted if the applicant does not enclose with the application

a document containing the consent of the interested subject. Another innovation is that the Executive Regulation introduces the possibility to divide the original trade mark application into partial applications, as already permitted in the European and US systems.

Domain names

The protection of the domain names will now be granted if they are used for “economic purposes”, and not only for “entrepreneurial purposes”, as before. This broader criterion will also apply to the case of interference of a domain name with an earlier trade mark.

Designs

The revised Code expressly states the prohibition to register designs whose features or content are contrary to public morals. The need for this specification follows some cases recently brought to the attention of the Italian courts.

The exposure of new designs in fairs or official exhibitions will now be considered as frustrating the novelty of designs and will impede their registration.

Moreover, the revised IP Code allows cumulative protection under the designs and the copyright laws in respect of designs already part of the public domain at the date in which the cumulative protection has been allowed for the first time in Italy (2001).

Patents

The new Code regulates the patentability of biological materials, excluding (among others) the human body, embryos and inventions contrary to human dignity and public order. The notions and role of equivalents and the faculty for the proprietor to ask for a reformulation of the claims are inspired by the European Patent Convention.

The remuneration for employees' inventions will be granted in a higher number of cases, and calculated according to the criteria now established by the Code.

Procedures

The Executive Regulation also establishes the conditions and terms of the new administrative opposition procedure before the Trade Mark Office. However, a decree fixing the amount of the opposition fees has to be issued by the Ministry for Economic Development, before the procedure starts to be effective.

It will be now easier to obtain preliminary measures against counterfeiters, thanks to simplified procedures. Lastly, the Code provides for the possibility to initiate a pre-emptive action for the declaration of non-infringement before the Italian courts, in order to prevent abuses and the unfair exploitation of intellectual property rights.

Southern Africa update

Andre van der Merwe of D M Kisch Inc provides a brief review of recent developments in southern Africa relating to trade mark matters.



South Africa

As from December 2010, the official Patent and Trade Mark Journal will be published in electronic format. As we understand the position, there will be free access to the e-Journal via a link on the home page of the [CIPRO website](#).

Good news! Extended examination periods for trade mark applications appear to be a thing of the past. The Registry staff has worked hard to reduce the examination period and it is now taking less than a year to examine trade mark applications and to issue examination reports.

The new Companies Act (which has not yet come into operation) will establish a Companies and IP Commission that will have wide-reaching powers. These will include improvement of regulations and processes in respect of IP matters, including recommending and formally proposing amendments to the IP statutes. In this latter regard, the Companies and IP Commission will therefore partly replace the former Standing IP Advisory Committee (to the Minister).

The Commission is expected to commence operations during 2011/2012 and advertisements have already appeared in the media for the positions of the Commissioner and Deputy Commissioner.

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The so-called Traditional Knowledge Bill (the Intellectual Property Laws Amendment Bill), which dates from 2007, was tabled before the National Assembly during April of this year. Public hearings were held during October 2010 and various institutions and bodies submitted comments on the Bill to the Departmental Portfolio Committee.

The Portfolio Committee will meet with CONTRALESA (the Council of Traditional Leaders of South Africa) during the course of November, and it will then deliberate on the various reports and comments submitted.

Namibia

The new (composite) IP Bill is in the process of being redrafted, and it is understood that the Bill will be tabled before the Namibian Parliament during the course of 2011.

The Registry is in the process of computerising its records, including the official Trade Marks Register. Although this is a lengthy process, it is understood that good progress is being made.

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