

Annual conference comes to Baveno

The 2011 **MARQUES** annual conference takes place in Baveno, Italy later this month. Massimo Sterpi, of Studio Legale Jacobacci Sterpi Francetti Regoli de Haas, has chaired the team putting together the meeting. He says the theme, "Reality Check", will involve "an assessment of what has happened to brands during the economic crisis".



"There is more and more hype around brands," adds Massimo.

"We will consider this from various different angles." The programme includes sessions on social media, the function of trade marks and branding strategies, as well as a variety of workshops.

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Massimo himself will chair a session on Wednesday featuring two speakers who he describes as a "dream team": Francesco Morace of Future Concept Lab, who will talk about emerging trends, and Derrick de Kerckhove of the University of Toronto, a world specialist on communications technologies, who will discuss the impact of social media on brands.

Among the many other participants are the keynote speaker Marco Boglione, president of BasicNet Group, and Loredana Gulino, director general of the directorate for combating counterfeiting in the Italian Patent and Trademark Office.



Exceptionally, the conference was totally sold out by the end of the early-bird period and a waiting list had to be set up. On one day alone, the secretariat received 180 registrations.

Massimo said he thinks at least part of the appeal is the venue. Baveno is a town of just 4,500 people on the shore of Lago Maggiore, and is surrounded by many historic buildings, which can be reached by bus or boat. One of these is the Borromeo Palace in Isola Bella on Lake Maggiore, where Wednesday night's dinner will be held. The palace has a striking 17th century garden, with dozens of white peacocks in residence. "It's like a dream," says Massimo.



The conference itself will be held at Grand Hotel Dino, with delegates staying here and at neighbouring hotels, all of which can be reached on foot. The Dino is a well-established conference venue, with state-of-the-art facilities. For example, says Massimo, there is an electrician whose job is solely to change lightbulbs: he changes up to 100 a day.

Reports and pictures from the annual conference will be available on marques.org and in **HouseMARQUES** later in September.

Seminar in Buenos Aires

Around 60 attendees from Argentina, Uruguay, Paraguay and Chile participated in the half-day seminar organised by **MARQUES** at the Sofitel Hotel in Buenos Aires in June. The seminar was titled **Trademarks in a Global Market: remedies and actions; different perspectives**.

Paola Tessarolo from **MARQUES** and Santiago O'Conor from Marval, O'Farrell & Mairal welcomed the attendees. The topics covered in the sessions were:

- Anti-Counterfeiting
- Protection of trade marks worldwide, with special reference to protection in Europe
- Green washing



Santiago moderated all the sessions and introduced each of the speakers to the audience. The first session, **Anti-Counterfeiting: the battle continues**, featured María Laura Perna, ADIDAS Brand Enforcement Manager for Argentina, Uruguay and Paraguay and Julian Carvajal, Chief of the Trademark Fraud Division from Argentinean Customs. Gustavo Giay, partner at Marval, O'Farrell & Mairal, concluded with a practical presentation of the role of the external attorney. He also explained the possibility of having Customs registrations filed with the different Customs registries in the Latin American countries and outlined in which Latin American countries this filing is possible.



In the subsequent colloquium, **How to effectively protect your trademarks worldwide – special reference to IP protection in Europe**, Laura Sansalvador, IP Manager of Group Arcor in Argentina, discussed what her company does to protect IP at an international level. Paola Tessarolo, member of **MARQUES** External Relations Team and partner of Arochi, Marroquín, Lindner & Asoc, presented the different possibilities of trade mark protection in Europe.

In the third session, titled **Green washing: environmentally friendly, but legally valid?**, Dámaso Pardo, Partner at Pérez Alati, Grondona, Benites, Arntsen & Martínez de Hoz(h), addressed issues related to green marketing and María Rivera Ayerza, Legal Director for Latin America of Arcos Dorados, explained the sustainable initiatives that her company has adopted in recent years. In the last presentation, Esteban Mazzucco, International Director from The Clorox Company in Argentina, presented the company's green marketing strategies.

The seminar was closed by Piet Verdult, partner of ASKVW & Asoc in Argentina, who gave an entertaining speech during lunch at Sofitel Hotel, and Paola Tessarolo, in her role as representative of **MARQUES**. Willem Leppink, Ingrid de Groot, Santiago O'Conor, Dámaso Pardo and Paola Tessarolo had organised and participated in the seminar on behalf of **MARQUES**.

Recent Team developments

The **Anti-counterfeiting and Parallel Trade Team** has published the **MARQUES** submission in response to the Consultation on the Commission's Report on the Enforcement of Intellectual Property Rights. To [download the submission click here](#)

The **Cyberspace Team** has published a report on the **Countdown to New gTLDs** and its implications for brand owners. The launch of the new gTLD programme is now expected in January 2012, after it was approved by Iccann's Board at its meeting in Singapore in June.

MARQUES is supporting the ICC conference "The Changing Domain Name Landscape and New gTLDs" in Paris on 30th September 2011. The conference will examine both gTLDs and internationalised domain names from a business perspective and provide advice to brand owners. **MARQUES** invites members to view the conference programme [here](#).

The **Designs Team** has published **MARQUES'** official response to the **Consultation on Proposed Changes to Design Legislation**. To download a copy of the [official response click here](#).

The **Trademark Law and Practice Team** has published **MARQUES'** official response to the IPR Survey 2010 of the European Commission. You can download the [official response here](#).

The Study Task Force has prepared an update on the progress of the study on the trade mark system in Europe. The latest developments will be discussed during a workshop at the annual conference and the update will be available online afterwards.

Other **MARQUES** news

In collaboration with the German Patent and Trademark Office and Markenverband, **MARQUES** will organise the second debate with the Judges of the German Trademark Courts at the German Patent and Trademark Office in Munich on 25th November 2011.

Further details and the complete programme of the meeting will be soon made available on the **MARQUES** website.

MARQUES participated as an invited speaker in WIPO's Worldwide Symposium on GIs, which was held in Lima, Peru in June.

MARQUES members welcome L'Oréal v eBay decision

In a report published on the **MARQUES** website, members of the Famous and Well-Known Marks Team welcomed the Court of Justice of the EU's judgment in the L'Oréal v eBay case.

The case arose when L'Oréal brought an action in the High Court in London against eBay and the individual sellers involved in 17 particular transactions conducted on the eBay website at ebay.co.uk.

eBay did not contest that two of the items sold were counterfeit. The other 15 items were either not intended for sale (such as tester or dramming products – containers from which small amounts can be taken to be supplied to consumers as free samples), or were intended for sale outside the EEA.

Further, some of the items were sold without packaging. It was not in dispute that L'Oréal did not consent to these transactions.

The High Court referred 10 questions, with a number of sub-questions, to the Court of Justice, and its judgment was published on July 12 (Case C-324-09).

“ This judgment will be welcomed by trade mark owners, but could cause some concern to eBay and other online marketplaces ”

The **MARQUES** report, which is authored by John Coldham of Wragge, concludes:

This judgment will be welcomed by trade mark owners, but could cause some concern to eBay and other online marketplaces as to the extent to which they will now be required to act on notifications of infringement.

As soon as they are deemed to be aware of an infringement, they could be liable. We await the UK court's response to the judgment handed down by the Court of Justice.

None of this should be a huge surprise to followers of recent trade mark decisions, and the judgment takes us a little further down the road of ascertaining the precise scope and effect of trade mark law to the internet.

With hundreds of millions of users posting advertisements of (one assumes) billions of products, eBay and other operators face a significant challenge to create a system by which they can effectively deal with notifications that comply with all the requirements of this judgment.

It is in their interest, as well as that of trade mark owners, for such a system to be developed quickly and effectively. Otherwise it would be a surprise if this marks the end of eBay's involvement with the courts on this issue.

Read the full report at www.marques.org

AdWords: alternative grounds for acting against Google

On 11th May 2011, the Court of Appeal of Paris held that Google Inc and advertiser Home Cine Solutions were both liable for unfair competition, misleading advertising and illegal comparative advertising.



The Court confirmed the findings of the Trade Court, except with regard to the liability of Google France, as the latter is owned by Google Inc. Jean-Philippe Bresson and Franck Soutoul, of Inlex IP Expertise, discuss the case

French company Cobrason sells hi-fi and video equipment through its websites at cobrason.com and cobrason.fr. Cobrason submitted that, when an internet user searched for the term 'Cobrason' in Google's search engine, the search results included the address of the website homecinesolutions.f, which belongs to French company Home Cine Solutions – one of Cobrason's direct competitors.

After obtaining evidence from a bailiff report, Cobrason sued Google Inc, Google France and Home Cine Solutions, alleging unfair competition, misleading advertising and illegal comparative advertising.

With regards to the unfair competition claim, the Court found that use of Cobrason's company name and domain name as a keyword: created confusion in the mind of the public; unfairly diverted consumers from Cobrason's website; and misappropriated Cobrason's investments in its website and advertising campaigns.



The Court added that, by offering for sale the keyword 'Cobrason' in its AdWords system, Google Inc had contributed from a technical point of view to the confusion created in the public's mind.

With regard to the misleading advertising and illegal comparative advertising claims, the Court pointed out that internet users and potential clients could believe that there was a commercial link between Cobrason and Home Cine Solutions, given the identity of the products offered for sale. Moreover, the fact that, on the search results page, Home Cine Solutions' web address was accompanied by the phrase 'pourquoi payer plus cher?' ('why pay more?') was likely to divert internet users looking for Cobrason to Home Cine Solutions' website.

With the uncertainty resulting from the CJEU rulings of March 2010 on how to enforce one's rights against Google for trade mark infringement, this decision shows that at least in France alternative grounds can be considered for trade mark owners to act against Google.

Southern Africa update

Andre van der Merwe of D M Kisch Incorporated rounds up recent developments in South Africa and Namibia.



South Africa: CIPRO transforms to CIPC and new Companies Act

On 1st May 2011, the Companies and IP Registration Office (CIPRO) became the Commission for Intellectual Property and Companies (CIPC), in terms of certain provisions of the new Companies Act (see below).

The Commission, while retaining the overall functions of the Registrars of Patents, Trade Marks, Designs and Copyright, has additional powers to prepare and propose legislative amendments to the various IP Acts and the Companies Act. The Commission also has the power to appoint hearing officers for formal IP and Companies Act disputes.

A new Companies Act entered into force on 1st May 2011 with various simplified requirements and procedures. In future, it will not be possible to register close corporations (that is, for smaller businesses). Company name objections are still possible and do not have a time limit.

Company names will be approved relative to both existing registered company names and relative to trade mark applications and registrations.

In future, it will not be possible for a company to use a "trading as" name or trading style name. These names will have to be registered.

New Consumer Protection Act (CPA)

On 1st April 2011, a new Consumer Protection Act (CPA) came into effect. The CPA has a broad application and will affect manufacturers, producers, wholesalers, distributors, retailers and end-users of consumer goods and services. The CPA sets new standards for consumer protection and aims to promote and maintain a consumer market that is accessible, sustainable and responsible for the benefit of consumers generally.

“ In future, it will not be possible for a company to use a “trading as” name or trading style name. ”

Consumers will now have the right to fair value products which are safe and of good quality, and they will have the right to the disclosure of important information when making a purchasing decision.

The CPA has introduced several new statutory consumer protection concepts including product liability, disclosure of pertinent information pertaining to the goods and services, marketing practices, and fair contractual terms.

A five-day cooling-off period has also been provided for consumers. Producers of goods and suppliers of services will need to ensure that their packaging and promotions comply with prescribed standards.

If a supplier is found guilty of prohibited conduct under the CPA, such a supplier may receive an administrative penalty of up to 10% of the supplier's annual turnover during the preceding financial year, or a R1m (€100,000) fine, whichever is the greater. Furthermore, contravention of the CPA could result in criminal conviction.

Namibia

The draft Intellectual Property Bill (which is a composite bill excluding copyright law) is still being re-drafted, and will hopefully be tabled before the Namibian Parliament shortly.

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Enforcement in the Philippines – a new beginning

Piracy has wreaked havoc on the economy of the Philippines, adversely affecting economic activity and stifling organised industry. While the Philippines remains on the Watch List of the Office of the US Trade Representative (USTR), the USTR has recognised the innovative and sustained efforts of the Intellectual Property Office of the Philippines (IPOP HL) to undertake effective enforcement strategies.

Neha Jain and Jennifer D Fajelagutan of Patrick Mirandah Co in Singapore report on recent initiatives.

In 2010, IPOP HL adopted a holistic approach to the fight against piracy. This new strategy calls for concerted action whereby “each stakeholder, IP owner, user and enforcement agencies play their respective crucial roles in safeguarding IP rights.

Law enforcement agencies are mandated to further their coordination efforts at all levels to ensure that there are no loopholes for pirates to explore and no bottlenecks remaining unclogged.”

To address widespread piracy and counterfeiting, the Philippine government adopted these measures:

- Establishment of an Operations Center in May 2010 that receives complaints from rights holders and if necessary, builds up cases to ensure prosecution of IPR violations.
- Release of Php 10,000,000 (€160,000) from the Office of the President in October 2010 for the operational requirements of the National Committee on Intellectual Property Rights (NCIPR) to include promotion, protection and enforcement of IP rights.
- Provision of a free warehouse facility which can be used by rights holders during IPR violation cases. This was undertaken to address the cost of storage whenever there are seizures made and cases filed.
- Deputisation of IPOP HL employees as agents of the Optical Media Board (OMB) and Bureau of Customs (BOC) arming the latter with visitatorial and enforcement powers for optical media products and on imported items in violation of the IP Code.
- Checking on mall owners compliance by IPOP HL. In December 2010, IPOP HL wrote to Greenhills Shopping Center, an establishment notorious for its counterfeit goods, and requested the mall owner to disallow stalls or lessees selling counterfeit products. Violating lessees can expect to have their lease terminated and lessors may find their business licences cancelled and US travel visas revoked.

- Strengthened internal mechanisms for disposition of IP cases.



IPOP HL Director General Ricardo R Blancaflor during the ceremonial destruction of counterfeit goods in PNP Headquarters Camp Crame, Manila. Photo courtesy of IPOP HL.

Office Order No 186 was issued giving the rights holder an immediate remedy of a temporary restraining order upon complaint if the matter is of extreme urgency. There is also an arrangement with the Department of Justice to provide full-time prosecutors for the handling of IPR violation cases. Moreover, it is now possible to file appropriate legal actions for the cancellation of the business name of the erring establishments registered with the Department of Trade and Industry as well as the Securities and Exchange Commission.

The measures taken by the Philippine Government in 2010 have shown a heightened commitment to enforce IP rights and demonstrate a firm resolve to prosecute violators to the full. Philippines IPO director general Ricardo Blancaflor has said: “We are only one step away from being removed completely” from the USTR Watch List.