

**Contents:**

British Judges Answer Questions	1
PepsiCo Debated	2
Judges in The Hague	2-3
Plain Packaging	3
GeoNews	4
Profile: An Italian GI	5
Denmark Enforcement	5-6
Domains in Argentina	6
UNCITRAL IP Annex	6

**British Judges Answer Questions**

**The Court of Justice of the EU, the unitary nature of the CTM, look-alikes and unfair competition, shape trade marks and the Patents County Court were just a few of the topics that judges answered questions on at a discussion in London in November.**

The discussion was hosted by **MARQUES** and University College London and featured Mr Justice Arnold of the High Court, Gordon Humphreys of OHIM, senior hearing officer and head of the Trade Mark Tribunal at the UK IPO Allan James and appointed person Amanda Michaels. It was chaired by former appeals judge Sir Robin Jacob.

**CJEU criticised**

The panel responded to questions posed by the



audience of more than 100 trade mark specialists. A popular target for questions was the decision-making of the Court of Justice. Mr Justice Arnold bemoaned the “severe inability of the Court of Justice to pronounce a clear principle and stick to it”. But he added that refusing to follow the Court’s guidance would be “a recipe for anarchy”: “Whether we like it or not, there has to be an arbiter.”

The judges also rejected the contention that they could avoid delays and uncertainty by not referring questions to the Court, saying that would be ducking the issue.

There was slightly more sympathy for the judges in Luxembourg from Allan James. He noted that they are not generally trade mark specialists and added: “The increase in the size of the General Court and the number of chambers hasn’t helped.”

**Trade mark reform**

Asked what one aspect of trade mark law they would like to change, the panel provided various answers. Gordon Humphreys said he regretted the

conflicting case law on submission of late facts and evidence and would like “flexibility to be restored”. Amanda Michaels said she would like to “get rid of” Article 5(2) of the Trade Marks Directive, regarding trade marks with a reputation. “It has caused an enormous amount of uncertainty and taken in far more cases than intended. Trade mark owners use it to clobber anyone in their way,” she said.

Allan James favoured limiting trade mark protection to “particular functions” such as the origin function and the advertising function. He said the meaning of the other functions mentioned by the CJEU, such as those of quality and investment, was unclear. Mr Justice Arnold agreed, but said the “root of the problem” was that the case law on double identity had introduced the concept of “affecting the functions” of the trade mark. “Double identity should mean use of a sign identical to the mark on identical goods, nothing more.”



UNIT Q, TROON WAY BUSINESS CENTRE  
HUMBERSTONE LANE, LEICESTER, LE4 8BN, UNITED KINGDOM  
T +44 116 264 0080, F +44 116 264 0141  
E info@marques.org, W www.marques.org

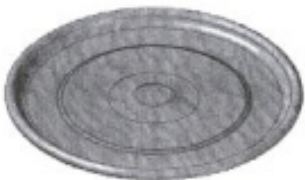
**Disclaimer**

The views expressed by contributors to this Newsletter are their own and do not necessarily reflect the policy and/or opinions of **MARQUES** and/or its membership. Information is published only as a guide and not as a comprehensive authority on any of the subjects covered. While every effort has been made to ensure that the information given is accurate and not misleading, neither **MARQUES** nor the contributors can accept responsibility for any loss or liability perceived to have arisen from the use or application of any such information or for errors and omissions. Readers are strongly advised to follow up articles of interest with quoted sources and specialist advisers.

## PepsiCo Design Decision Debated

**MARQUES** recently presented a first impressions summary and discussion of PepsiCo v Grupo Promer Mon Graphic, the much awaited first substantive decision of the Court of Justice of the European Union (CJEU) concerning a Registered Community Design (RCD). The event was held at MAQS Law Firm in Copenhagen on 27th October 2011, just 7 days after the PepsiCo decision was handed down on 20th October 2011. By Peter Gustav Olson, a partner of MAQS Law Firm and member of the Designs Team, who hosted the event.

David Stone, chair of the **MARQUES** Designs Team and partner at Simmons & Simmons in London, gave a presentation of the history and background of the dispute, and summarized the CJEU decision. This presentation was followed by a panel discussion with Peter Halkjaer, Senior IPR Manager, Devices IPR, at Nokia Danmark A/S, and Hanne Weywardt, partner and IP litigator at MAQS Law Firm.

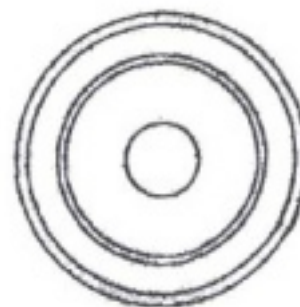


In spite of the short time between the invitations being sent out and the event, there were 34 participants from nine European countries in attendance. Besides Denmark and nearby Sweden, they came from the UK, the Netherlands,

Finland, Estonia, Italy, France and Spain. The event was scheduled from 16:00 to 18:30, so most of the foreign participants were able to fly in and fly out on the same day.

“The strong turnout in Copenhagen shows that RCDs have caught the interest of IP practitioners.”

“Being in Denmark, we took a cue from Hans Christian Andersen and asked whether PepsiCo meant that RCD, considered by many to be the Ugly Duckling of IP rights, really was a swan,” said David Stone. “The decision got reversed twice on its way to the CJEU, so it was exciting to see how the Court would rule. Although PepsiCo is unique on its facts, the Court came down in favour of the owner of the prior right, indicating that RCDs are enforceable. The strong turnout in Copenhagen shows that RCDs have caught the interest of IP practitioners.”



## Trade Mark Judges on Trade Mark Law

Following the success of the Meet the Judges sessions in various EU countries, **MARQUES** organised a similar meeting on 4th November in The Hague, The Netherlands. The meeting was hosted in cooperation with the Benelux Office for Intellectual Property and the Benelux Association for Trade Mark and Design Law (BMM).  
By Ralph Thomas of DSM.

Dieuwerke van der Schalk (**MARQUES** Council) and Edmond Simon (Director-General BBIE) welcomed the attendees to the meeting, which with more than 70 people was very well attended. Paul Steinhauser (**MARQUES** Council) hosted this special event. No less than seven judges from various Dutch courts were involved in giving lectures on the main substantive and procedural aspects of community and national trade marks. They included Edmond Simon, Director-General of the Benelux Organisation for Intellectual Property, The Hague; Ernst Numann, Vice-President Supreme Court of the Netherlands, The Hague; Edger Brinkman, Judge Court of First Instance, The Hague; Xandra Kiers-Becking, Vice-President, Appeal Court, The Hague; and Walter van Straalen, Judge at the Court of First Instance in Amsterdam. There were also several judges in the audience.

In the first session moderated by Willem Leppink (**MARQUES** Council), Judge Ernst Numann spoke

Continued...



Left to right: Rian Kalden (Court of First Instance The Hague) Walter van Straalen (Court of First Instance Amsterdam); Edger Brinkman (Court of First Instance The Hague); Michel Bonneur (Court of Appeal The Hague); Xandra Kiers-Becking (Court of Appeal The Hague); and Tanja Tanja-van den Broek (Court of Appeal The Hague).

about acquired distinctiveness and genuine use. A meeting at the Benelux Office was of course an ideal place to have lively discussion about the office's ONEL decision, in which the office found that use of a CTM in only one EU member state did not constitute "genuine use" of the trade mark right. The criticised decision has been appealed and questions have been referred to the Court of Justice of the EU.

Trade mark use in comparative advertising was also discussed in a session moderated by Paul Reeskamp and developments in the role of the appeal court of The Hague as an appeal court for decisions of the Benelux Office were debated. Finally, all judges and attendees participated in a round table discussion on the grounds of court decisions lead by Professor Dirk Visser, the author of a book on decision making in trade mark cases.

The judges candidly shared with the audience some practical tips and tricks in trade mark litigation to smoothen the legal proceedings.

The event was wrapped up with an informal gathering over Luxembourg wine, for which the reporter investigated the protected geographical indications.

## Controversy Over Plain Packaging

**Members of the MARQUES Regulatory Team address questions raised by the proposed law on plain packaging for cigarettes in Australia.**



**What concerns do brand owners have about the proposed plain packaging law in Australia?**

**MARQUES** and brand owners oppose the Australian government's legislative proposal on plain packaging, as the introduction of plain packaging legislation effectively deprives one industry sector of its intellectual property rights.

**To what extent do you think it will impinge on trade mark rights?**

The laws undermine the intellectual property protection system as a whole by dismantling the value of trade marks used by companies that

operate in Australia.

**What can brand owners still do to challenge the proposed restrictions (if they wish to)?**

They may contact the Australian government representative with regard to the Public Consultation on the Tobacco Plain Packaging Bill 2011.

**Do you think this could set a precedent for other industries?**

Unfortunately, it is possible that plain packaging could be extended to other industries, particularly those which face opposition from some groups, such as pharmaceuticals and alcohol.

**If the law is successfully implemented in Australia, do you think that will embolden legislators in other jurisdictions to follow suit?**

It does seem quite possible that the EU and additional jurisdictions will follow suit, now that the Australian plain packaging laws have come into effect. These jurisdictions will argue health benefits and public cost savings. Although we support these jurisdictions entirely in health and safety matters, we believe that plain packaging will greatly increase the trade in counterfeit goods, and the black market in general. Plain packaging could be copied with ease, devoid of specific trade marks and logos. Such lack of consumer information may lead to more serious health concerns and costs as consumers find closely regulated products via non-traditional sources.

## GeoNews

**Keri Johnston, Louise Gellman and Alessandro Sciarra of the MARQUES GI Team round up the latest developments in geographical indications.**

### GI Workshop in Baveno

The **MARQUES** GI Team's workshop at the annual meeting gave enthusiastic participants an opportunity to learn about GIs and debate practical issues faced by trade mark and GI owners.

The workshop was moderated by Keri Johnston and Louise Gellman.

Rather than spending an afternoon in the Italian sunshine, we were treated to a master class.

Peter Munzinger laid the foundations, explaining the key GI concepts and gave us all a hugely practical cheat sheet to take away. This clearly set out the relevant rights and terms to the legal basis and scope of GIs, with a particular focus on Europe.

This was followed by a presentation by Sébastien Vitali outlining the legislative framework of GI protection. In particular, Sébastien told us about the EU regulations and the Commission's strategy of negotiating bilateral agreements within an international framework.



Paulo Monteverde built on Sébastien's presentation showing how GI disputes and their interaction with trade marks have played out in the courts.

Miguel Angel Medina, chair of the GI team, brought us up to date on international developments in the WTO and WIPO. In particular, he reviewed the new proposals to amend the existing EU GI regulation and news of WIPO's plan to propose a new international instrument to improve upon the 1958 Lisbon Agreement (as amended). The Lisbon Agreement is limited to appellations of origin and the hope is that the new treaty would have a broader application, thereby attracting more members.

The workshop culminated in real bites and tastes. Attendees were treated to a number of



Italian delicacies protected by GIs, arranged by Alessandro Sciarra. Special thanks to the associations who generously provided us with their first-rate products, shown in the accompanying map of Italy.

### Lisbon System

The fourth session of the WIPO working group on the development of the Lisbon System will be meeting on December 2011. Members of the **MARQUES** GI Team will attend as observers. We will report on their contributions and the outcome of the meeting in the next GeoNews.

## Featured GI number 1

**In this and future issues of GeoNews, members of the GI Team will present a GI, providing information on its main characteristics and the protection obtained. In this issue, Alessandro Sciarra introduces Aceto Balsamico Tradizionale di Modena (Traditional Balsamic Vinegar of Modena).**

Aceto Balsamico Tradizionale di Modena is an Italian designation of origin that identifies a unique (and, let me say, delicious) balsamic vinegar produced in the province of Modena, in the Emilia-Romagna region, an area that is also known for the Parmigiano-Reggiano cheese and other things of excellence, such as Ferrari sports cars.

Aceto Balsamico Tradizionale di Modena, which is classified as a “condiment”, was recognized in Italy by Ministerial Decree of 5 April 1983, and on 17 April 2000 obtained registration in the European Union as a protected designation of origin (PDO) pursuant to Council Regulation (EC) No 813/2000: <http://eurlex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2000:100:0005:0006:EN:PDF>

Particulars of the PDO registration, including a summary of the production regulations, are available on the European Union database of geographical indications for agricultural products and foodstuffs (DOOR): <http://ec.europa.eu/agriculture/quality/door/registeredName.html?denominationId=59&locale=en>

This special condiment is made from selected grapes which must be grown in the province of Modena. Following harvesting, the grapes from this specific province are pressed and then cooked in open containers placed on a direct flame. After the “grape must” has reached the prescribed degree of concentration, it undergoes an ageing process lasting at least 12 years. If the ageing continues for 25 years or more, the appellation “Extra Vecchio” (“Extra Old”) may be added to the designation of origin “Aceto Balsamico Tradizionale di Modena”. The ageing phase takes place in wooden barrels of diminishing sizes. Initially, the grape must is poured into the biggest barrel of the row. The grape must is then moved to increasingly smaller barrels in the row – until it is poured into the smallest barrel to complete the ageing process. Once the ageing is completed, samples of the product are taken from the smallest barrel of the row for analytical and organoleptic tests. The approved product is bottled in a special bottle with a round shape and rectangular base. The bottle is sealed with a numbered guarantee label.

The main features of the PDO Aceto Balsamico Tradizionale di Modena are:

**Colour:** bright dark brown;

**Consistency:** like a runny syrup;

**Aroma:** characteristic, fragrant and, altogether, well-formed, penetrating and persistent bouquet with a noticeable but pleasant and harmonious acidity;

**Flavour:** characteristic, sweet and sour and well

balanced, with appreciable acidity and a hint of aroma imparted by the wood used for the vats; strong, clear, full, velvety, intense and persistent, in keeping with its characteristic bouquet.

**Tasting tips:** pour some drops of Aceto Balsamico Tradizionale di Modena on Parmigiano-Reggiano cheese or try it on strawberries.

GeoNews is brought to you by the **MARQUES** GI Team <http://www.marques.org/Teams/TeamInfo.asp?TeamCode=GelInTeam>

## Seizure of single watch upheld

**In November the Copenhagen Maritime and Commercial Court delivered a judgment in favour of Rolex against an individual, NN, who had had bought a fake watch online. The Court said that Customs could seize and destroy the watch, which was imported from outside the EU. Hanne Weywardt of MAQS Law Firm explains:**



The importer claimed that as he had purchased the product for private use, he did not violate trade mark law and thus should have the product released. The court ruled that the watch undisputedly being a counterfeit was produced and sold under circumstances that it would infringe trade mark rights in Denmark, that the fact that

Continued...

the importer did not himself violate that law was not decisive, and that the Regulation on customs control allows for such goods to be destroyed without compensation to the importer.

It is a long-awaited decision and has been decided by an expanded panel of judges. It confirms prior rulings by the same court but it remains still to be seen if it will be appealed. Anyhow, for now we have a strong decision in favour of destruction of counterfeit goods even though the importer has not committed a trade mark infringement.

## Argentina creates domains registry

**The National Registry of Internet Domains was created on 15th December 2011. According to the provisions of Decree 189/2011, it will report to the Legal and Technical Secretariat of the National Presidency, and Gustavo Guillermo Justich will be in charge. Rita Colombo of Mitrani, Caballero, Rosso Alba, Francia, Ojam y Ruiz Moreno, Buenos Aires explains.**



Until the provisions of Decree 189/2011 are implemented, top-level domains in Argentina will continue to be registered, published, renewed and administered by NIC Argentina, an entity that was created by and reports to the Ministry of Foreign

Affairs. Then, the brand-new Registry will have the primary responsibility of assessing those matters. It will also be involved in the administration, supply and backup and safety tasks of the interactive databases used by its organisational units.

Moreover, it will be in charge of the implementation of plans and projects related to domain names, and will intervene in negotiations and agreements regarding these matters. Additionally, as an issue that has raised great expectations, the Registry will deal with dispute resolution arising out of the registration and ownership of internet domain names. The details regarding the rules to be applied to these proceedings are so far unknown. Decree 189/2011 came as a surprise to those who work in domain names. Though it is still imprecise it has generated great expectations. We hope to have further information soon.

## A guide to the UNCITRAL IP Annex

**Following lobbying from MARQUES and others, UNCITRAL agreed to add an IP Annex to the Legislative Guide on Secured Transactions. The IP Annex was published in March last year. Ben Goodger of Edwards Wildman Palmer – a member of the Team – has written an article on the topic, which is available on the MARQUES website.**



The article covers the aims of the Annex, the creation and effectiveness of security rights, the registry system, the priority of security rights in IP, enforcement, acquisition financing for IP and the applicable law. Ben concludes: While the 168 pages of the IP Annex to the 564 pages of the Guide are not exactly light reading, its aims are admirable - to promote and streamline the rules and procedures for secured financing.

The application of the aims of the Guide to transactions involving IP was not easy: the way in which IP is commercialised has its own rules and often involves the complex interrelationship of overlapping and differently demarcated rights.

The IP Annex in addressing these issues seeks to explain how the recommendations in the Guide would apply to IP and makes asset specific recommendations with respect to security rights in IP. Critically it seeks not to interfere with existing fundamental policies of law relating to IP. It contains intriguing recommendations on the establishment of a new type of register to IP assets. It will be interesting to see whether this suggestion is taken up and indeed whether the Guide and Annex have the desired effect of opening up greater avenues to accessing finance for IP owners and their licensees.

Read the full article in the IAM Team section of the **MARQUES** website <http://www.marques.org/Teams/TeamPage.asp?PageID=316&TeamCode=IAMTeam&DS=Publications>