

# GI database goes live

André Pohlmann of Lovells, Vice Chair of the **MARQUES** Geographical Indications Team, provides a guide to the extensive new online GI database

## What was the idea behind creating this database?

The original idea behind this project was to find out whether and to what extent a possible multi-lateral system for the registration of geographical indications (one of the hot issues discussed on WTO-level) could rely on existing national registration systems. However, when we began to inform other **MARQUES** members about our plans, we found out that there is a real need for and interest in having a detailed database. There exist various ways of protecting geographical indications, for example unfair competition provisions, collective marks and specific laws including the registration of GIs. To our knowledge, there does not yet exist a comprehensive database on the protection of GIs.

So we decided to provide the report as an information source to the members of **MARQUES** and to publish it on the **MARQUES** website.

## What information is available in the database?

The database contains useful information about the protection of GIs in 22 European jurisdictions. The database is made up of two parts. Part one deals with EU Regulations and international agreements (Lisbon Agreement, Paris Convention, Stresa Convention etc) and includes a table giving an overview of various bilateral agreements between European countries. Part two contains the sections dealing with national laws. We concentrated on three main topics: the national mechanisms for the protection of GIs, the registration of a GI under the relevant national law and details about bilateral agreements. The database contains direct links to the relevant legislation in each country.

## Where does the information included in the database come from?

We first made use of various public sources to gather information about the national

laws, in particular WTO documents.

Then we asked national experts to verify the data.

## Is the database limited to the European Union?

The database now contains national laws of most of the member states of the European Union. However, in the future, we would like to extend the project to other European countries (Iceland, Norway, Switzerland and Eastern Europe).

## Will the database include further information in the future?

The database is a living document which will be updated on a regular basis. Furthermore, we plan to include various new sections in the database – case law, useful links to web sites dealing with GIs and a bibliography.

*The database is available to all members on the **MARQUES** website: [www.marques.org](http://www.marques.org)*

# Seeing the ECJ in action

Twenty-six **MARQUES** members visited Luxembourg in June to see the European Court of Justice (ECJ) and Court of First Instance (CFI) at work. They attended an ECJ hearing in a competition case and heard presentations from Joris Plingers of the ECJ, Joanna Gray of Linklaters and Laura Parret of Simmons & Simmons.

Further insight into the work of the court was provided by Mrs Gavanier, legal secretary to CFI judge Franklin Dehousse, Mrs Edwards, legal secretary to Advocate General Francis Jacobs and Mrs Rodriguez Ameneiro, legal secretary to CFI judge Ena Cremona.



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# Denmark marks World Anti-Counterfeiting Day

Hanne Weywardt, attorney-at-law, of MAQS law firm in Copenhagen, reveals how World Anti-Counterfeiting Day was marked in Denmark.



Wednesday 15th June 2005 was appointed World Anti-Counterfeiting Day. In Denmark, the Danish Anti-Counterfeiting Group (DACG) marked it by distributing a leaflet with the title "Say No to Counterfeit Goods!" and by granting an honorary award to an employee with the Danish customs authorities, Jørli Bak-Hansen. Mr Bak-Hansen works with great enthusiasm, energy and skill in the battle against

counterfeiting and IP piracy, and has done so for the past 10 years.

The board members of DACG have been working intensively during the past few weeks to celebrate World Anti-Counterfeiting Day for the first time in Denmark. A huge number of leaflets had been printed for distribution in the major Danish airports in Copenhagen and Billund, Jutland. In Copenhagen, the leaflets were handed out to travellers by six students who had been freed for the purpose by MAQS law firm. In Billund, the distributors were supplied by Lego Holding A/S.

The distribution took place within the transit area by special permission of the airport. In this way we were able to approach the travellers on their way to boarding their flights, so that they would bring on board the leaflet to read it on the plane while waiting for take-off. This limited the risk of the leaflet being simply dumped in the nearest bin. It also enabled us to head

for the destinations where counterfeit goods are most frequently offered for sale.

The distribution of the leaflets was a great success. In the course of the day, the students reported from Copenhagen airport that the distribution was not progressing as quickly as expected because people were showing immense interest in the leaflet, asking questions about its contents, about counterfeiting and why the leaflet was being distributed!

With the press coverage and the events on the day, we hope that the awareness of the problems caused by counterfeiting has been enhanced. And, since counterfeiting is a continuous and increasing problem, we should anticipate DACG's continued active participation in the battle against counterfeiting in years to come.

*Hanne Weywardt is a member of the **MARQUES** council, Chairman of the **MARQUES** Website and Publications Team and a board member of the Danish Anti-Counterfeiting Group*



# Serbia & Montenegro trade mark update

By Simon Walters and Jovana Radevic, of SD Petosevic bvba, Overijse, Belgium

Various revisions have been made to Serbia and Montenegro Trade Mark Law, in accordance with TRIPs, European Community legislation (1993 and 1998 Regulations), and the WIPO joint resolution on well-known marks. These revisions are effective from 1st January 2005. The most notable points, some of which clarify the old law, are as follows:

- the introduction of **certification trade marks**, described as a form of collective mark;
- the **legal conditions** required must be met at the time of the grant of a trade mark, not the date of application;
- parts of a trade mark may be **disclaimed**;
- a trade mark application or registration can be **divided**;
- **exhaustion of rights** is henceforth universal. The trade mark owner can prevent exhaustion if it would harm its reputation in some manner;
- a **company name** does not infringe a trade mark if this name was acquired in good faith and used before the trade mark's application;
- **famous marks** must be registered to enjoy protection. To be famous, the mark must have a high reputation and be known to relevant members of the public;
- if an earlier rights holder tolerates a registration for five years, there is **acquiescence** (this does not include well-known marks);
- in a **cancellation action**, the owner of the earlier right or its legal successor is obliged to prove that the trade mark is in use. Cancellation for non-use takes effect on the date of last use (not on the date of the decision);
- use must be **genuine use**;
- **revocation** on the grounds that a trade mark has become generic takes effect at the time of the final decision;
- if a trade mark is filed in **bad faith**, the rightful owner can ask for the mark to be transferred into its name;
- where an infringing mark infringes a well-known mark, it may be transferred into the name of the owner of the well-known trade mark.

## IP first for São Tomé e Príncipe

By Jose Amorim of Gastão da Cunha Ferreira, Lda in Lisbon, Portugal

São Tomé e Príncipe, a small yet thriving former Portuguese colony located in the oil-rich Gulf of Guinea, has finally enacted its first Intellectual Property Law, making it possible to apply for patents of invention, industrial designs, industrial models, trade marks and service marks.

São Tomé e Príncipe has been a member of both the Convention Establishing the World Intellectual Property Organisation (WIPO)

and the Paris Convention for the Protection of Industrial Property since 12th May 1998.

These are the most relevant features of the law which is now in force:

- a patent is valid for 20 years counted from the application date and a maintenance tax should be paid every year;
- the duration of an industrial design or



model is five years from the filing date, renewable for two equal periods;

- trade and service mark registrations are valid for 10 years from the filing date, renewable for further periods of 10 years;
- applicants having no permanent residence or business office in São Tomé e Príncipe should be represented by an official industrial property agent residing in the country.

# IP licensing under threat from new Convention

The UN is set to agree a controversial Convention that will have serious implications for international licence agreements. Ben Goodger and Patsy Day of Rouse & Co International in Oxford analyse the details of the Convention, and reveal why IP owners should be worried.

The intellectual property professional community has recently woken up to a convention which, if ratified, will have a direct negative impact on the way in which IP owners will be able to collect royalties, and even control their IP assets, once they are in the hands of a licensee. The intellectual property could end up being controlled by third parties such as banks with whom the licensor has no contractual relationship.

The United Nations Commission on International Trade Law (UNCITRAL) has sponsored the Convention on the Assignment of Receivables in International Trade. The Convention has been 10 years in the making and is now in its final form, awaiting ratification by the UN signatory states. The main objective of the Convention is to "promote the availability of credit at more affordable rates across national borders". One consequence of this is that licensees will be allowed to use the royalties derived from a sub-licence agreement as security for loans. The idea is that by placing banks and other asset-based creditors (who generally provide credit to manufacturers and distributors) in a stronger position, these creditors will be able to offer more affordable credit to their borrowers.

It appears, however, that the affordable credit is going to come at great expense to IP owners. As the implications of the Convention are sinking in, considerable alarm is being raised.

The Convention, as it stands, upsets the original relationship between a licensor and licensee, impinging on the licensor's freedom of contract, and is in conflict with accepted international laws governing intellectual

property such as the Berne Convention and TRIPS.

## The language barrier

The Convention is a lengthy and in places complex document. It appears to have been drafted with the financial interests of banks and other asset-based lenders in mind and without taking into account the practical effect that the Convention will have on the IP industry. There has certainly been very little consultation with IP professional and brand owner forums such as **MARQUES** in the drafting of the Convention. This view is enforced by the language of the Convention which uses words such as "assignor", "assignee" and "debtor" in the place of "licensee", "lender" and "sub-licensee". Admittedly the Convention is not directed solely at the licensor/licensee/lender relationship so one cannot expect to have IP tailored language. However, the terminology employed makes it difficult to interpret the Convention in an IP context, and the forced interpretation may well result in consequences to transactions that were unforeseen by the drafters of the Convention.

The fact that the Convention does not make special consideration for receivables

**“Under the Convention, a licensee is permitted to assign to its lender all rights to future royalties from sub-licensees.”**

(royalties) arising out of intellectual property transactions highlights the Convention's failure to take into account the complex rules and conventions which govern IP transactions.

## Losing control of royalties

The Convention allows a licensee to use the royalties arising out of a sub-licence agreement as security for a loan despite any provision in the head licence agreement prohibiting such an assignment. In the event that the licensee defaults on its loan repayments, the lender will be able to take all royalty income received by the licensee, which will include the share that the licensee is supposed to pay on to the licensor under the head licence. Under the Convention, the existence of an anti-assignment clause in the licence agreement will not have an effect on the assignment of the royalties. Further, the licensor may not terminate the licence agreement as a result of this breach.

## Assignment of future royalties

The IP owner's position is further weakened by the licensee's ability to assign rights to future royalties to its lender. Under the Convention, a licensee is permitted to assign to its lender all rights to future royalties from sub-licensees. The lender is therefore in a position to secure itself as a priority creditor even before the licence agreement is concluded. If the licensor wishes to overcome this problem, it would have to carry out a search of all its licensee's creditors and negotiate a priority arrangement with the creditors on an individual basis.

## Losing control of your IP

There is also some doubt as to the limits on

“*The Convention, as it stands, upsets the original relationship between a licensor and licensee, impinges on the licensor’s freedom of contract, and is in conflict with accepted international laws governing IP.*”

## How brand owners can act

It was clear from the debate at the WIPO’s Informal Expert Consultation Day that there are too many unanswered questions and disputed interpretations for the Convention to be ratified as it now stands. The **MARQUES** IAM Team is considering what steps **MARQUES**, on behalf of the European IP owning community, should be taking or recommending, to mitigate the practical effects the negative aspects of the Convention, as discussed above.

Input and comments of members would be most welcome.

how far a lender can reach when it comes to calling in the security for its loan. The Convention states (at article 10) that a “personal or property right securing payment of the assigned receivable [the royalties] is transferred to the lender without a new act of transfer”. This is perhaps the most controversial provision under the Convention and is another example of wording that has no clear interpretation in an IP context.

The Convention further allows the lender to retain any proceeds of the receivables and/or “goods returned” that it receives in respect of payment of the assigned receivable (the royalty). The phrase “goods returned” is not clearly explained. Under this, not only the royalties but the assets relevant to the intellectual property could end up in the hands of a third party. The film industry is particularly concerned that this provision

could result in master copies of films being transferred to the lender. The licensor would not be able to regulate what the lender did with the returned goods in its possession. The lender on the other hand would be eager to dispose of the returned goods quickly in a way that would offset as much of the licensee’s debt as possible.

### Too many unanswered questions

There is much confusion in trying to fit ambiguous terms of the Convention with the realities of IP transactions. It cannot be assumed that national courts will be sympathetic to an interpretation of these terms that would protect the rights of (in many instances foreign) IP owners. Even in the most tightly controlled supply chains, it is possible for pirates and counterfeiters to obtain master copies of the latest films or

moulds with which to reproduce protected goods. With IP owners losing control of their licences, royalties, and even the ability to enforce their IP rights, this delivers advantage to pirates and counterfeiters.

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The authors would like to acknowledge the assistance of Kevin Mutch in the preparation of this article.

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### Links

Read about the Convention here:  
[www.uncitral.org/](http://www.uncitral.org/)

# Dot-eu comes a step closer

**The .eu sunrise period, when trade mark and other IP right owners in Europe can apply to obtain .eu domain names, is set to begin in autumn this year.**

Applications made during the sunrise period will be validated by PricewaterhouseCoopers in Brussels, who have been appointed by the registry, EURid, to manage the sunrise process. The full guidelines for sunrise applicants are due to be published in all EU languages later this summer.

EURid has also published its proposed official fees, which are wholesale prices

charged to registrars. These are €10 for each .eu application and an extra €45 for registered rights owners using the sunrise period. Registrars will be accredited over the summer and they will set their own fees in addition to the official fee.

Bart Lieben of PwC Brussels will explain the sunrise and validation process at a special session during the **MARQUES** Annual Conference in Prague in September.

The **MARQUES** Cyberspace Team has prepared a briefing on the latest developments, which is available on the **MARQUES** website: [www.marques.org](http://www.marques.org)

Up-to-date news can be found on the first .eu site, run by EURid: [www.eurid.eu](http://www.eurid.eu)

# Trade-mark clarification in Canada

This year, practitioners have benefited from clarification by the Opposition Board, the Federal Court, and practice notices concerning issues of common concern to trade-mark lawyers and agents. Some of the developments have taken practitioners by surprise, reports Andrea Rush of Heenan Blaikie in Toronto.

## All sights on first use

The framework of a Canadian trade-mark application differs depending on whether or not the mark has been used in Canada. Rights in a trade-mark arise from use or making known in Canada. A registration will not issue unless there has been some use of the mark in Canada. (The Paris Convention allows for one exception: use may have occurred elsewhere in the world in support of a corresponding foreign registration).

It can be seen that “use” is the linchpin of trade-mark rights in Canada. Definitions of “use” are set out in the Trade-marks Act for each of wares and services. Use prior to the filing date is incompatible with proposed use and serves as a basis to challenge the validity of an application and/or registration. The examiner is not in a position to question the accuracy of the “first use” date which is indicated on the application. The application is unsworn, and often signed by an agent rather than a representative of the applicant. Consequently, practitioners who are accustomed to a “first to file” regime may be

“*The Effigi decision is a watershed because the Federal Court held that an application based on proposed use (i.e. no use at time of filing) ranks ahead of a later-filed application asserting an earlier use date.*”

less surprised than many of their Canadian colleagues by the recent decision of *Procureur Général du Canada v Effigi Inc* (2005) 35 CPR (4th) 307. The *Effigi* decision is a watershed in Canadian trade-mark practice because the Federal Court held that an application based on proposed use (ie no use at time of filing) ranks ahead of a later-filed application asserting an earlier use date. The decision directs the examiner to discount the relevance of seniority of use when assessing priority of entitlement at the outset of the examination stage.

Section 16 of the Trade-marks Act directs the Registrar to reject an application which is confusing with another trade-mark that was previously registered by someone else or for which someone else has previously filed an application for registration which is “pending at the date of advertisement of the applicant’s application in accordance with section 37”. Seniority of use should thus remain a live factor in determining entitlement to registration during opposition proceedings.

Use at the filing date will still remain a factor for consideration at the examination stage if the proposed mark is descriptive, as in the case of *THE DISCOUNT PARTY SUPER STORE* which can be seen in *Zorti Investments Inc v Party City Corp* (2005) 36 CPR (4th) 90. By exception, a descriptive mark is registrable if it is not without distinctive character, according to Section 14 of the Trade-marks Act. The material date for assessing whether the mark fits within the exception? It is the filing date of the application. That is, the examiner must be satisfied that at the filing date, the applicant is in a position to establish that the mark is not without distinctive character. The Opposition Board



held that a claim under Section 14(1) will not succeed unless the applicant can prove the existence of its corresponding foreign registration and show that its applied for mark was not without distinctive character in Canada as of the filing date of the Canadian application. To rely on the existence of a corresponding foreign registration and use after the filing date would be “not only logically inconsistent but would also appear to unfairly advantage a foreign applicant over a domestic applicant who must evidence that his clearly descriptive mark has become distinctive as of the filing date”.

In summary, a bare filing date is sufficient sometimes, but not all the time. Canada is not yet a pure first to file country,



## The sounds of registrability

Is a mark registrable if design elements exist apart from the words? Not if the words are descriptive, even if they are disclaimed.

A recent decision of the Federal Court reconsiders the degree to which the word portion of the applied-for mark, when sounded, forms the dominant feature of a mark, so as to negate registrability of the design elements. The applied-for mark, BEST CANADIAN MOTOR INNS was characterised as clearly descriptive, or deceptively mis-descriptive, when *sounded*, of the applicant's services in Canada, contrary to Section 12(b) of the Trade-marks Act. The design features consisted of: a maple leaf (disclaimed), the words BEST CANADIAN in a font and style of lettering different than used for the words MOTOR INN, and lines appearing above and below the words BEST CANADIAN.

The decision highlights the importance of sound as a criterion for assessing the descriptiveness of a mark pursuant to Section 12 (b) of the Act, which provides:

### Section 12(1)

Subject to Section 13, a trade-mark is registrable if it is not

(b) whether depicted, written or *sounded*, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin.

Mere design embellishments of lettering have never *per se* been sufficient to render an otherwise descriptive mark registrable where the embellishments could not be separated from the words themselves. For example, in *John Labatt v Registrar of Trade Marks (1985) 79 CPR (2d) 110, 115 (TD)* Cattanach J upheld a decision of the Registrar of Trade-marks denying registration of SUPER BOCK in design form. The words SUPER and BOCK were disclaimed, leaving an insufficient number of design elements.

(T)he question is that when the words and the comprising letters thereof are overlooked is there sufficient left of a design nature to warrant registration as a trade mark.

*Best Western* extends the spectrum of non-registrability based on sound considerations. Consideration of "sound" as a dominant criteria for assessing descriptiveness raises the threshold test of



registrability for design marks that include words as a dominant feature. Design marks that have no dominant element would not have to meet the "sounded" test on the basis of the word elements.

As indicated in the Practice Notice published on 16th February 2005, only one element is dominant. Therefore, in situations where the word element and the design element are considered to be equally influential or prominent in a trade-mark, neither can be the dominant feature of the mark.



As apparent from the file history of that application, the examiner has cited *Playboy Enterprises v Germain (1987) 16 CPR (3d) 517 (TD)*. In *Playboy*, the applied-for mark was uttered when wares were shown to potential customers of "Playboy hair pieces". Speaking a mark does not fit within the highly specific definition of "use" in Section 4 of the Trade-marks Act:

### When deemed to be used

(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that

notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services...

It has been apparent that sounding a mark is not a basis of entitlement to registration. However, it has now become clear that the sound of a mark is relevant after all – if only as a reason to impede (rather than support) registration.

**Andrea Rush is a partner of Heenan Blaikie in Canada. The second part of this article, looking at well-known marks before the Supreme Court, and registry practice, will be published in the next MARQUES Newsletter.**

### Links

Read the Effigi decision here:

[www.canlii.org/ca/cas/fca/2005/2005fca172.html](http://www.canlii.org/ca/cas/fca/2005/2005fca172.html)

“*Consideration of "sound" as a dominant criteria for assessing descriptiveness raises the threshold test of registrability for design marks that include words as a dominant feature.*”

# Taking the moral high ground

Ilanah Simon and Jeremy Phillips review European decisions on ethical trade marks, and examine how trade mark registries assess what is offensive or immoral.



Jeremy Phillips



Ilanah Simon

What do Bill Clinton, Fidel Castro, Jesus, Pope John Paul II and the Fuck of the Year have in common? This isn't the beginning of a very bad joke. Instead, these notorious terms have all been refused registration as trade marks on morality grounds.

The European trade mark regime requires offices to refuse to register marks which are contrary to public policy or the accepted principles of morality. In so doing, it requires difficult value judgements to be made by the relevant trade mark registries. In particular, OHIM has the unenviable task of deciding precisely which standard of morality is "accepted" throughout the 25 states that make up the EU.

## A sound ground for the refusal or registration?

One thing is clear in this quagmire of people's innermost prejudices. If your mark is offensive, it will remain offensive if you alter its spelling in a way that allows it to retain phonetic identity with the original offensive meaning. For example, just as you can't say BOLLOCKS to OHIM, you also can't say BOLOX, BOLLOX or even BALLEs. Likewise, trade mark registries will not be impressed with a *laissez-faire* attitude to trade mark law on the part of the applicants. If you say SOSUMI ("so sue me") to the UK Trade Marks Registry, chances are they will.

## The name game

Our examples show that, if you're famous, your name may be barred from registration. The reason is not necessarily that the celebrity in question has indulged in immoral behaviour (we leave our readers to decide whether that is so). Instead, it is thought to be wrong to obtain IP rights in a name that is not your own. As well as encroaching on

*“While registries may not wish to taint themselves by being seen to grant rights in naughty words and lewd images, it is questionable whether preventing their registration as trade marks is the most effective way to regulate their usage.”*

another person's personality, if the applicant were able to obtain such a mark, he would close off a source of revenue to the celebrity in question, or could associate his name with unsavoury or unsuitable goods or services. In some countries, a famous person may be able to prevent the registration of his name by arguing that the application for registration has been made in bad faith. However, this is not an option before OHIM since bad faith is not a ground for opposing an application, although it may be possible to raise bad faith as a ground for invalidity after the offending mark is registered.

## Immoral marks generally

What about signs that don't cause offence to an individual named in the sign or his estate, but which do cause offence to a wider public? In trade mark law we are usually concerned with the perception of consumers of the goods or services concerned, but here we're looking at a more general class of people when assessing perception. Since offensive marks may be viewed by people other than those who purchase the goods

(for example on billboards and in other advertising), it is fitting to look either at the public as a whole or at specific subsets of it, identified by characteristics such as religion or nationality.

But what must the public see in order for a mark to be barred from registration on immorality grounds? There are at least two ways of approaching this question, exemplified by two (arguably conflicting) decisions of the appeal bodies of OHIM and the UK Registry.

The first option, chosen by the OHIM Board of Appeal in *Dick Lexic Limited's Application R 111/2002-4*, is to examine what the applicant is trying to tell consumers through using his mark, and whether they will detect this message. Under this test, in order for a mark to be barred from registration, it must proclaim an opinion, contain incitement or convey an insult. Thus the application for DICK & FANNY (English slang words for male and female genitalia) was allowed because, while it was crude, it did not transmit any message. In this case though, the application appears to have been aided by the fact that the words DICK and FANNY both have a neutral meaning in formal English, as the diminutive forms of the forenames Richard and Frances.

The other option, typified by the decision of the UK Lord Chancellor's Appointed Person in *Basic Trademark SAC Application Case O-021-5*, is to look at the reaction of the public to the mark, rather than to conduct a semantic examination of the mark in the abstract. Here the test was said to be whether the mark would be "seriously troubling" in terms of the public interest in the prevention of disorder or the protection of morals. While such a test may be difficult to apply, in the sense that it

leads to no “one right answer” as to whether a given mark is barred from registration and involves the decision-maker in predicting the effect that the use of the sign will have on other people, this mode of analysis was regarded as acceptable because it did not involve an arbitrary decision-making process. The use of the applied-for mark, JESUS, as a trade mark would fall within this “seriously troubling” test: both believers and those who respect the religious sensibilities of others would view the commercialisation of the ultimate Christian name with a mixture of anger and despair, depending on their temperament.

Neither test is perfect. The “message” test is coldly objective, perhaps unduly so. In fact, it does not appear to be the whole story, since the Office also notes that the use of the two terms (DICK and FANNY) together does not strengthen the mark’s sexual connotation. Why strengthening such a connotation should be relevant under the “message” test should be relevant when the sexual connotation was said not to convey a message was not made clear. However, the “seriously troubling” test is unpredictable and applicants cannot safely know what the outcome of their application is likely to be before they go to the expense of filing.

## Solutions to the dilemma

Certainly there are good arguments why we might not want immoral terms to be used to identify goods. However, by refusing registration, registries are, as was recognised in the JESUS decision, to a greater or lesser extent limiting the free speech of applicants for such marks. It may be that such a limitation is justified since free speech is not an unqualified right. As Article 10 of the European Convention on Human Rights recognises, your right to free speech does not give you the right to have complete disregard for the reputation or rights of others: it can be regulated in the interests of morality and the prevention of disorder or crime. Additionally, the refusal of registration does not prevent an applicant from using the mark. Quite the contrary, if the refusal is

“OHIM has the unenviable task of deciding precisely which standard of morality is “accepted” throughout the 25 states that make up the EU.”

based on absolute grounds, the applicant can still use the term, but so can all of his competitors. This suggests that using trade mark law to combat immoral marks can actually lead to a *greater* presence of such marks on the market.

While registries may not wish to taint themselves by being seen to grant rights in naughty words and lewd images, it is questionable whether preventing their registration as trade marks is the most effective way to regulate their usage.

This leaves two options: either crack down on offensive marks through other legislation, such as obscenity or blasphemy law or, as the authors have suggested elsewhere, maintain a list of marks, enforced by actions initiated by the registry or a body dedicated to the purpose, that not only cannot be registered but also cannot be used as trade marks.

*Jeremy Phillips and Ilanah Simon are co-authors of the IPKat weblog ([www.ipkat.org](http://www.ipkat.org)) and members of the MARQUES Publications and Website Team.*

### Links

Search OHIM’s decisions here: [oami.eu.int](http://oami.eu.int)

The UK cases can be searched here: [www.patent.gov.uk/tm/legal/decisions](http://www.patent.gov.uk/tm/legal/decisions)

# ECJ rules in “Have a break” slogan case

James Nurton, MARQUES Newsletter Editor

The European Court of Justice has confirmed that trade marks can acquire distinctiveness if used in conjunction with or as part of another registered mark.

The July 7 decision is a victory for Nestlé whose application to register the slogan “Have a break” for Kit Kat chocolate bars had been referred to the Court by the UK Court of Appeal. Nestlé was relying on its use of the registered trade mark “Have a break ... Have a Kit Kat” to demonstrate the acquired distinctiveness in the shorter slogan.

The case will now return to the UK Trade Marks Registry who will have to determine whether Nestlé has in fact demonstrated the necessary distinctiveness.

Jean-Pierre Maeder, head of IP at Nestlé, welcomed the ruling: “We are very pleased with the outcome. It’s a key decision for brand owners of unconventional trade marks.”

The decision confirms that shapes and colours, as well as slogans, can be registered based on distinctiveness acquired through use in conjunction with word or design marks. In its ruling, the ECJ said marks can acquire distinctiveness “as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark.” In both cases, the relevant audience must perceive the product or service as originating from a particular undertaking.

Nestlé’s application for the slogan was refused by a hearing officer in the UK’s Patent Office in 2002 after rival Mars filed an opposition.

In 2003, the Court of Appeal agreed that “Have a break” is devoid of distinctive character, but asked the ECJ to clarify whether a mark can acquire distinctive character “following or in consequence of the use of that mark as part of or in conjunction with another mark”.

Nestlé was represented by Jane Mutimear of Bird & Bird and barrister Henry Carr QC. Mutimear told *MIP Week* that the case will now have to go back to the Trade Marks Registry, which will look again at the application: “They will look at the same evidence as before but apply the new law.”

She added that the decision would have implications for a number of cases in the Registry and on appeal that were held up pending the outcome: “It doesn’t matter how something has become distinctive, just that it has become so.”

# Well-known and famous marks reformed in Mexico

Carlos de la Sierra and Vianney Gutierrez Muñoz of Calderon y De La Sierra y Cia, SC in Mexico City provide a guide to protecting well-known and famous marks in Mexico under the new guidelines.

Proposed amendments to the Industrial Property Law in Mexico were discussed, voted and approved by the House of Representatives during its session held on 1st March 2005. Furthermore, these amendments were published in the Official Diary on 16th June 2005 and thus are effective as from 17th June 2005. The new text of the law includes amendments to Article 6 Sections III and X and Article 90 Section XV. Further, a new Section XV Bis of Article 90, and a complete new chapter "The Well Known and Famous Trade Marks" have also been included in the Industrial Property Law.

Under the new provisions, it is now possible to request from the Mexican Trade Mark Office declarations to establish the well-known and famous status of trade marks in México, following a now established ex-parte procedure. It should be noted that these amendments clearly establish two different and independent qualifications for these types of trade marks, namely well-known marks on the one hand, and famous marks bearing a slightly different meaning to be explained below on the other.

***“The new provisions are aimed at providing a clear and practical framework in which to secure a declaration from the Mexican Trade Mark Office recognising the given status.”***

## Clear guidelines

While the Industrial Property Law had already mentioned and contained specific provisions on the issue of well-known trade marks, it lacked guidelines to fully implement the needed protection due for these sorts of marks. The new provisions are aimed at providing a clear and practical framework in which to secure a declaration from the Mexican Trade Mark Office recognising the given status, whether it be of a well-known or a famous trade mark. This recognition will then constitute a valuable tool to better enforce the mark against third parties and will aid examiners to protect these types of marks during the prosecution of new trade mark applications for identical or confusingly similar marks.

Notwithstanding the intention of legislators noted above and which transpired in the approved amendment, examiners are to refuse registration of marks which are identical or confusingly similar to well-known or famous marks, even if they are not registered nor have been declared as such. This unfortunate wording will regrettably leave ample room for the subjective interpretation of examiners as to which marks are to be treated as well-known or famous, even when the owners of such marks have not sought their registration in Mexico nor the respective declaration under the terms of the amendment.

## Famous versus well-known marks

As noted, these amendments clearly distinguish between well-known marks and famous marks, where the former are those that a specific sector of the general public or of an established commercial circle know the mark as a consequence of commercial



activities developed in Mexico or abroad, by an entity using the given mark in connection with goods or services or, as a consequence of promotion or advertisement of the same; and where the latter is simply a mark known by the majority of consumers in Mexico. No further explanation or detailed definition is contained in the amendment for famous marks.

An official declaration of well-known or famous status is obtained from the Mexican Trade Mark Office at the specific request of the interested party which, on a valid interpretation of the amended statute, does not necessarily have to be the trade mark owner, although the existence of a valid trade mark registration for the given mark is mandatory. The petition for a declaration to

***“Examiners are to refuse registration of marks which are identical or confusingly similar to well-known or famous marks, even if they are not registered nor have been declared as such.”***

be issued is to contain all information and evidence demonstrating the well-known or famous status, among which the amendment lists surveys or market research studies; proof of first use of the mark, either in Mexico or abroad; proof to demonstrate the period of continued use in Mexico or abroad; distribution channels; advertising means availed of; investment figures on advertisements and on promotional activities during the past three years; the geographic area of effective influence of the mark; gross sales of the respective goods or services covered with the mark; a valuation of the mark; valid trade mark registrations secured for the given mark, either in Mexico or abroad; information on franchises or licences covering the mark and percentage of participation of the mark in the relevant market.

The amended Law also provides that an official fee will need to be paid with every application for a declaration of well-known or famous status. However, the law which covers government fees is yet to be amended to specify the fee. Therefore in practice a registrant may find it impossible to file a petition for such a declaration(s) at this time, as no specific amount has been established as the official fee to be paid for these cases. The amended provisions clearly indicate that the applications for these types of declarations "...are to be accompanied by the respective payment of official fees".



The fact that a valid trade mark registration constitutes an insurmountable burden to meet to be in a position to request the noted declaration is to be carefully taken into consideration, especially for marks which may have acquired sufficient distinctiveness and even recognition among the general public, but which have not been granted registration. For instance, three dimensional marks could fall into this category.

Well-known and famous status declarations will last for five years and can also be renewed for additional five year periods, as long as conditions to demonstrate

continuance of the well-known or famous status are fully met with the renewal petition. It should also be noted that interested parties will also have the right to seek the nullity of the given declarations when these are granted against the applicable legal requirements or when false information was used to obtain the noted declarations.

If the trade mark registration which served as the basis for a declaration expires, is cancelled or declared void, the declaration of well-known or of famous status will also be deemed to have expired.

THE 19th ANNUAL CONFERENCE  
 Tuesday 13th – Friday 16th September 2005  
 Hilton Prague, Prague, Czech Republic

## BOHEMIAN RHAPSODY— WHAT'S BREWING?

The 19th **MARQUES** Annual Conference will address trade mark issues in a new expanded European Union which now consists of 25 member states. International panels of experts will look back on the experiences of the past year, discuss the current status and explore the challenges and opportunities that trade mark owners will face in the future.

For more information visit [www.marques.org/conferences](http://www.marques.org/conferences) or contact the **MARQUES** Conference Office:

840 Melton Road, Thurmaston  
 Leicester LE4 8BN United Kingdom  
 Tel: +44 116 264 0080  
 Fax: +44 116 264 0141  
 E-mail: [info@marques.org](mailto:info@marques.org)

**PRAHA**  
 2005

# New Indian Trade Mark Law aids foreign plaintiffs

**Manisha Singh of Lex Orbis in New Delhi examines a recent case on jurisdiction in regional Indian courts in trade mark cases, and finds that foreign companies now have greater flexibility in filing actions than under the old Trade Mark Act.**

In a significant move, the new Indian Trade Marks Act, 1999 recognised the right of the aggrieved party, in this case a foreign body, to institute a suit before either the District Court or the High Court, within the local limits of which it has its offices for gain or profit. This is a substantial change from the situation under the old Trade Marks Act, 1958 where a suit could be instituted only where the infringer had its principal place of business or offices for gain or profit or where the infringing activities had taken place. This statutory provision recently came up for consideration before the Chennai High Court when Officine Lovato Spa, a foreign entity – the party aggrieved by infringement – received leave to file an infringement suit.

## The dispute explained

In its request seeking permission to institute infringement proceedings within the jurisdiction of the Chennai (Madras) Court, Officine relied on the fact that it has its liaison office in India at Chennai and as it is carrying on business at Chennai within the jurisdiction of this Court, a suit could be instituted where the plaintiff actually or voluntarily resides or carries on business. Officine is located at and carries on business at Chennai and therefore is entitled to file the suit before the Chennai Court. Officine's trade mark is also registered at the Trade Marks Registry at Chennai with Chennai as the appropriate office of jurisdiction; thus, the material part of cause of action has arisen at Chennai.

The alleged infringers, represented by one of them, Mr Ajay Kumar Aggarwal, filed a counter application to revoke the permission granted. They argued that their business is situated outside the territorial jurisdiction of

this Court and that their goods were not being sold within its territorial jurisdiction. The defendant also relied on the fact that Officine's liaison office is permitted to act as a communication channel between the head office in Italy and various parties in India and that such activities would not amount to its actually or voluntarily residing or carrying on business or personally working for gain at the said liaison office. They claimed that Officine's position violated the Foreign Exchange Management Act.

The defendant also relied on the fact that as the Trade Marks Registry is situated at Mumbai and the Register of Trade Marks is only available there, the suit can be filed only there.

## The new Act

Under section 105 of the Trade Marks Act, 1958, a suit for infringement of a registered trade mark could not be instituted in any court below a District Court having jurisdiction to try the suit. The 1958 Act is repealed by the Trade Marks Act, 1999. Therefore the new Act alone governs the situation. Section 105 of the old Act is re-drafted as section 134(1) of the new Act. Sub-section (2) of section 134 is a new provision. Under that sub-section, for the purposes of clauses (a) and (b) of sub-section (1), a "District Court having jurisdiction" is stated to include a District Court within whose jurisdiction, any of the person(s) instituting the suit actually or voluntarily resides or carries on business or personally works for gain. In other words, under sub-section (2) of section 134 of the new Act, the plaintiff has the option either to go before the court within whose jurisdiction he is carrying on business – that being the sole



cause of action – or before any other court, where the cause of action has arisen. Such an option was not available under section 105 of the old Act.

It is clear from this that the change brought about under section 134(2) of the new Act is only giving an additional option to the party complaining of infringement of a trade mark to go before a court within whose jurisdiction he carries on business and such a change does not affect the existing rights available under the old Act. Accordingly the Chennai High Court held that the situs of the trade mark (stated to be infringed), being situated in the appropriate office of the Trade Marks Registry at Chennai, would give a cause of action for the plaintiff to come before this Court.

The other ground for revocation of the leave granted was that as the head office of the Trade Marks Registry is situated at Mumbai, suits, if any, can be filed only there. It is

**“The change brought about under section 134(2) of the new Act is only giving an additional option to the party complaining of infringement of a trade mark to go before a court within whose jurisdiction he carries on business.”**

**“Under the old Act, a suit could be instituted only where the infringer had its principal place of business or for gain or profit or where the infringing activities had taken place.”**

pertinent to note here that Officine is mainly relying upon the situs of the trade mark as giving him a cause of action to move this Court. Section 5 of the Trade Marks Act, 1999, provides for a Trade Marks Registry with a head office in Mumbai and various branch offices. Under section 6 of the 1999 Act, a record called the Register of Trade Marks shall be kept at the head office of the Trade Marks Registry, wherein all the details relating to the registered trade mark shall be entered. Under sub-section (6) of section 6 of the 1999 Act, a copy of the register and the other documents mentioned in section 148 of the Act shall be kept in each branch office.

Under Rule 4(a)(ii) of the Trade Marks Rules, 2002, the appropriate office of the Trade Marks Registry for the purpose of making an application for a trade mark under section 18, or for other purposes mentioned in Rule 4, shall be where there is no entry in the register as to the principal place of business

in India of the registered proprietor at the place mentioned in the address for service in India as entered in the register. In other words, if there is no entry in the register for the owner’s principal place of business, then the branch office of the Registry within which its address for service is situated would be the appropriate office.

It is not in dispute that the address for service of the plaintiff, when it moved for its registration of the trade mark, is within the jurisdiction of the trade marks branch office at Chennai and therefore it would be the appropriate office.

A registered trade mark is a proprietary right; though the head office is at Bombay, the branch offices, including the one at Chennai, have independent territorial jurisdiction regarding the powers conferred under the Act; therefore there can be no doubt that in respect of the trade mark registered at the Chennai office, the situs of the property in the mark is at Chennai and therefore there can be a little doubt that the alleged infringement is not only at a place where the defendant markets his goods but also where the plaintiff’s property itself is situated [1977-1-MX J 286] in *SBS Jayam & Co v Krishnamoorthi* as Higher Court [Division Bench].

Also in [AIR 1991 Madras 277] *Amrutanjan Limited v Ashwin Fine Chemicals & Pharmaceuticals* it was held that “the registration of the trade mark being at



Madras office, the situs of the property in the registered trade mark is deemed to be at Madras”.

### **The right decision**

The above case law makes it clear that the situs of the trade mark would give a cause of action for the party complaining of infringement of that trade mark to go before the court within whose jurisdiction the said situs is situated.

In this case, the plaintiff was not claiming any relief on a contract, dealing or transaction against the defendants but only complaining about the infringement of its trade mark.

The Chennai Court confirmed the leave in favour of Officine to institute infringement proceedings against the defendant within the jurisdiction of the Chennai Court and held that the Court had rightly granted leave and that there was no need to revoke the same on any of the grounds raised by the defendant as none of them could stand ground in relation to the spirit of the new Trade Marks Laws.

**“The defendants argued that their business is situated outside the territorial jurisdiction of this Court and that their goods were not being sold within its jurisdiction.”**



# Introducing: The **MARQUES** Anti-Counterfeiting and Parallel Trade Team

This month, meet the members of the **MARQUES** Anti-Counterfeiting and Parallel Trade Team who aim to champion the protection and enforcement of brand owners' rights against counterfeits and unlawful parallel imports within a global economy and to create a forum for the free exchange of ideas and mutual experience amongst trade mark practitioners.



## **John Anderson**

Currently Resident Twinning Adviser on IPR Protection for Investment, Latvia (EU/Phare Project), and consultant to Queen Mary Intellectual Property Research Institute (University of London) Project Team, John Anderson is also a Visiting Expert on Public Authority Co-operation on IPR Enforcement in Bulgaria. He has been chairman of the Global Anti-Counterfeiting Network (GACG) since 2001 and is Chairman, Operations Committee, of the UN/ECE Advisory Group for the Protection and Implementation of Intellectual Property Rights for Investment. He is also a WIPO consultant and was Director General of ACG from 1997 to 2003. Before that, he served in the British Diplomatic Service for 16 years in various information and commercial posts in South America, the Middle East and Africa. He has an honours degree (BA) in political and social science.

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## **Alejandro Angulo**

Alejandro Angulo is a founding partner of Grau, Baylos & Angulo, which was formed in November 2003 and is now one of Spain's leading IP firms. He is a specialist IP litigator in the civil and criminal courts and represents many international IP owners in the textile, fashion, mass consumer goods, high technology, pharmaceutical, sport and leisure industries. Alejandro deals with some of the country's most significant court cases. He speaks Spanish, English, French, Italian and Catalan. Alejandro is an active member of **MARQUES**, AIPPI, INTA, EPLA, IPO and APRAM.

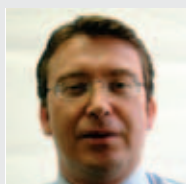
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## **Guido Baumgartner**

Guido Baumgartner is head of the Department of International Market Control at Lancaster Group GmbH, a producer of luxury fragrances and cosmetics of brands such as Davidoff, Joop!, Jil Sander, Chopard and Jennifer Lopez. His area of responsibility is to enforce selective distribution and brand protection for the whole Lancaster Group. Guido has held this position since 1994 after previously serving as head of the legal department in a pharmaceutical company from 1993. Prior to this from 1990 to 1992 he was a legal associate with the Benckiser Group. Guido qualified at the Universities of Heidelberg and Lausanne and started his working life with Commerzbank in Frankfurt before joining Benckiser. He is an active member of various industry associations and chairs the working group on selective distribution and law of the German Brand Association.

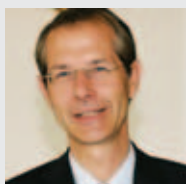
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## **Spencer Burgess**

On completion of his masters degree at Stirling University in 1994, Spencer commenced his investigative career with a major oil company specialising in environmental and safety issues. His experiences include the investigation of both on and offshore-based incidents. This was a high profile role dealing with issues often in a very public forum. In 1997 he joined Carratu International where he specialised in the investigation of IP abuse including the complex area of pharmaceutical patent infringement. He has handled complex investigations throughout Europe, North America and Asia. He is an elected member of the Institute of Professional Investigators and has qualified as a Certified Fraud Examiner. He is a guest lecturer at Nottingham Law School on the LL M in Intellectual Property Litigation course. Spencer joined the board of Carratu International Plc in 2002 and now heads the IP division, which provides investigation and brand enforcement services to international brand and IPR owners and their legal representatives.

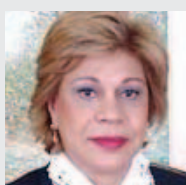
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## **Hans-Friedrich Czekay**

Hans-Friedrich Czekay has been Head of the Global Trade Marks Function of F. Hoffmann-La Roche AG in Basel, Switzerland since 1991. He studied law at the Universities of Marburg and Hamburg. He obtained a doctors degree from the University of Hamburg with a thesis about German and French Patent Law. Between 1980 and 1991 he worked as a lawyer in private practice in Hamburg, mainly in the field of intellectual property, unfair competition and antitrust law. He is author of several publications on trade mark matters. As in-house lawyer he is involved in litigation, lobbying and anti-counterfeiting. Hans-Friedrich is married and lives with his wife and two sons in Grenzach-Wyhlen (Germany).

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## **Gladys Bareiro de Modica**

Gladys Bareiro de Modica graduated from the National University of Asunción Law School, and she was admitted to practice in 1972. She received a doctorate degree in juridical sciences from the National University of Asunción. Because of her experience in intellectual property rights, she was appointed by the United Nations (UN) as a national consultant for the reform of the Paraguayan regulatory framework of intellectual property. Dr Bareiro de Modica is Professor of Intellectual Law at the Catholic University of Asunción Law School. She has published a book, *Contrato de Franchising*, and many works in specialized reviews. She is a member of the INTA and ASIPI Anti-Counterfeiting Committees, among others. She is a former president of the Paraguayan Industrial Property Association and a former vice president of the Paraguayan Bar. Dr Bareiro is a trade mark and patent agent. She deals also with commercial matters. She speaks Spanish, English, French and Italian.

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**Magnus Hallin**

Magnus Hallin has worked since 1997 as an attorney-at-law with the Swedish intellectual property firm of Awapatent where he is co-owner and also head of the legal and trade mark department of the Gothenburg office. Awapatent is one of Europe's largest IP firms with around 130 attorneys with offices throughout Sweden as well as in Copenhagen and Munich. Magnus has a Swedish law degree from the University of Lund and an LL M from the University of Brussels in European Law. Before joining Awapatent he completed district court service and then worked as an associate with a general practice law firm dealing mainly with litigation. He advises clients in all areas of IP and marketing law and is actively involved in the management, commercialisation and enforcement of his clients' IP portfolios. However, he specialises on trade mark and licensing issues.

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**Joachim Hofmann**

Joachim Hofmann is Senior Trade Mark Specialist/Group Head with Syngenta (Basel, Switzerland). He holds a J D degree from the University of Heidelberg, Germany, a LL M degree from the University of Miami, USA and a Ph D from the University of Mannheim, Germany. He took his Second State/Bar Exam with the Court of Appeals Mannheim and is admitted as a lawyer in Germany. Before the merger of the agro departments of Novartis and AstraZeneca to form Syngenta, Joachim worked for Novartis, BASF and several law firms. Joachim handles international trade mark, domain name and counterfeiting matters. He is married and lives in Lörrach (Germany) with his wife and three children. In his free time he enjoys all kinds of outdoor sports and reading.

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**Antonina Pakharenko-Anderson**

Antonina Pakharenko-Anderson is the founder and senior partner of one of the first private IP and law firms in Ukraine, Pakharenko & Partners (founded in 1992). She is a registered patent attorney and doctor of laws who has been working in the field of intellectual property since 1977. She practises IP registration and litigation acting as an advocate before the civil and commercial courts. As the acting chairman of the Ukrainian Alliance Against Counterfeiting and Piracy (UAACP) and a member of several international anti-counterfeiting coalitions, she provides assistance to businesses in tackling counterfeiting and piracy problems and enforcing their IP rights in Ukraine. She is also a frequent speaker and author on IP law and practice.

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**Oxana Pishvanova**

Oxana Pishvanova is a registered trade mark attorney with the IP group of Gowlings' Moscow office. Gowlings, one of Canada's largest national law firms, has offices in all major business and technology centres across Canada and a representative office in Moscow. Ms Pishvanova joined the firm in 1994 and obtained her trade mark attorney licence in 1999 after completing special training on IP protection at the Russian Institute of Intellectual Property. Prior to that, she worked as an information officer with different USSR agencies located in New York, USA, for a number of years, and for Novosti Press Agency in Moscow, Russia.

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**Eddy Sigrist**

Eddy Sigrist is managing director of Aristeed BV based in The Netherlands. Eddy has worked with a number of brand owners in reducing counterfeit trade of their products and improving their logistics systems and practices to prevent the flow of their products into parallel trade.

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**Loke-Khoon Tan**

Loke-Khoon Tan is a partner of the Hong Kong and China offices of Baker & McKenzie and is the head of the firm's IP group. His practice focuses specially on IP law in the People's Republic of China, with particular emphasis on the structuring of IP rights and anti-counterfeiting planning in the area of trade marks, patents, copyright, trade names, computer software, passing-off, unfair competition, designs, labelling laws, food, drug and health regulations, consumer, media and advertising laws. With the new economy, Mr Tan's practice also encompasses domain name, internet and technology law. He is the author of Trademark Law in the People's Republic of China (Oxford University Press) and Pirates in the Middle Kingdom: The Art of Trademark War (Sweet & Maxwell). Among other affiliations, he sits on the Anti-Counterfeiting and Enforcement Committee [East Asia & Pacific Subcommittee] of the INTA and the Copyright Committee of the Hong Kong Group of the Asian Patent Attorneys Association and is also the past chairman of the IP committee of AMCHAM (the American Chamber of Commerce) in Hong Kong from 1996-1998.

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**Anouk von Meyenfeldt**

Anouk von Meyenfeldt was educated at the University of Utrecht, in The Netherlands. After having earned her degree in both civil and criminal law in 1994, she was admitted to the Bar and practised at Nauta Dutilh, specialising in IP law. In 1998 Anouk started working for Tommy Hilfiger Europe BV as Director of Legal Affairs, setting up and heading the European legal department in Amsterdam. Anouk is responsible for the enforcement and protection of Hilfiger's trade marks in Europe and the Middle-East and for all European corporate legal affairs. From 2001 to 2004 Anouk was a member of the **MARQUES** Council.

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**Gregor Vos**

Gregor Vos was educated at the Universities of Amsterdam and London. After having earned his degrees, Gregor was admitted to the bar in 1994. Apart from the period from 1997 to 1999, when he worked as trade marks manager at the corporate trade marks department of Unilever NV, Gregor has practised as an intellectual property litigator. Since the end of 2002, Gregor has practised at the Amsterdam IP firm Klos Morel Vos & Schaap, of which he is one of the co-founders. Gregor is an IP litigator and advisor with a practice that has an emphasis on the marketing side of IP, on trade marks, designs and advertising, in which fields he has extensive experience. As well as being a member of the **MARQUES** Anti-Counterfeiting and Parallel Trade Team, he is also on the INTA Anti-Counterfeiting and Enforcement Committee. Gregor also acts as a teacher at the post graduate trade mark programme Grotius of the University of Nijmegen.

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# Formal Notice of Annual General Meeting of the Association 2005

In accordance with the rules of the Association, all Ordinary (full voting) Members are hereby formally advised that the Annual General Meeting of **MARQUES** will be held on Friday, 16th September 2005 in the Hilton Hotel, Prague, Czech Republic starting at 0930 hrs.

The Meeting will receive the audited accounts for the year ended 31st March 2005, the Report of the Chairman and the Council for the same period, appoint auditors for the year to 31st March 2006, receive confirmation of the results of the annual electoral processes to fill vacancies on the Council and consider any other business details of which have been submitted in advance by Members in accordance with the procedures described below.

The AGM provides all Members with the opportunity to express views on the way in which the Association is developing, on the range and nature of services offered and on the performance of the Council and Secretariat.

All Members are free to contribute to the Agenda – whether they are present or not. In addition, any Member has the opportunity to raise any matter of concern by writing to the Secretariat by not later than Friday, 19th August 2005. Full notice of all business to be discussed at the AGM is then sent to every

Member at least 21 days in advance of the meeting to give time for due consideration of all of the issues involved.

All Members are entitled to put themselves forward as candidates to fill vacancies on the Council but each candidate, other than a retiring member of Council, must be nominated by three Ordinary Members. Further details and advice, if required, are available from the Secretariat.

Under current rules, one half of the Special Members and one third of the Ordinary Members currently serving on Council are required to retire each year by rotation but may offer themselves for re-election. In accordance with this rule, the following vacancies are created this year:

**Ordinary Members:** David Crawford (UK), Hans-Friederich Czekay (Switzerland) and Lena Borg (Sweden) and Maria Falk (Sweden)

**Special Members:** Virginia Taylor (USA), Massimo Sterpi (Italy), Eva Szigeti (Hungary), Knud Wallberg (Denmark) and Nick Wood (UK).

In addition, the following individuals, were appointed by Council subsequent to the 2004 Annual General Meeting and require their appointments to be formally confirmed at the AGM:

Guido Baumgartner (Germany) Rudolf Haugg (Switzerland), Panos Malamis (Greece),

Jean-Pierre Maeder (Switzerland), and Jennifer Powers (Austria)

Council may be composed of up to 40 members with not more than six from any individual European country, not more than six drawn from countries outside of Europe and not more than 14 Special Members.

All those due to retire have confirmed their intention to offer themselves for re-election. The nomination of candidates in excess of the declared number of vacancies in either category would require **MARQUES** to organise a postal ballot of all Ordinary Members to select candidates to fill the available places. Should such need arise, the process will be conducted under the direction of the Company Secretary who will announce the results at the AGM.

Nominations are therefore invited from and on behalf of Ordinary Members to fill these vacancies on Council.

Nomination Forms, which are available on request from the Secretariat, should be completed and returned to the Company Secretary by not later than 1700 hrs (BST) on Friday, 19th August 2005.

By Order of the Council  
Robert Seager  
Company Secretary

1st July 2005