MARQUES
THE ASSOCIATION OF EUROPEAN TRADE MARK OWNERS

News
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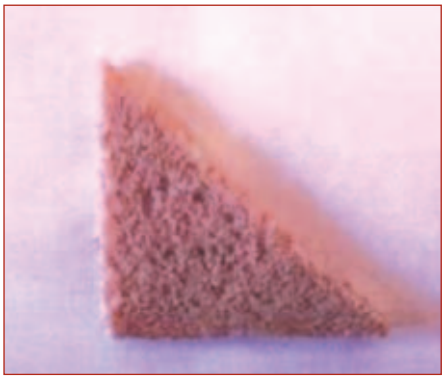
Lessons on design invalidity

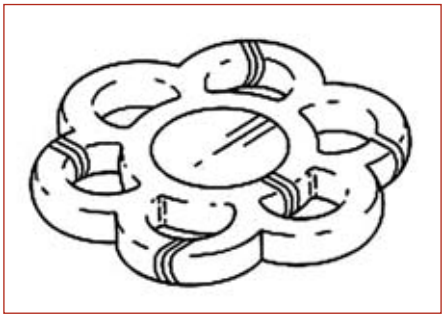
Danise van Vuuren-Nield of The Coca-Cola Company – a member of the MARQUES Unfair Competition Team – and David Stone of Howrey LLP and Chair of the MARQUES Designs Team review some of the first decisions on invalidity of registered Community designs.

Many rights owners responded to the introduction of registered Community designs (RCDs) by filing large numbers of applications with OHIM: by 31 January 2006, there were 41,372 applications filed. OHIM does not examine design applications on relative grounds – there is no assessment of the prior art. Thus, many designs have issued that are of doubtful validity. One of our favourites is this application for a piece of bread:

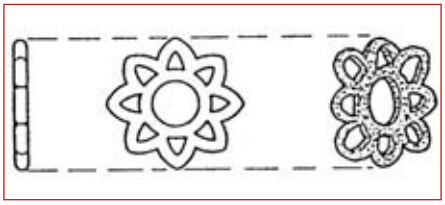


So far, the validity of RCDs has arisen most frequently before OHIM's invalidity division. Whilst not claiming to have reviewed all of OHIM's decisions on invalidity, our overview gives some sense of OHIM's position on the scope of protection to be given to registered designs. Of the 77 decisions to date, only 39% have confirmed the validity of the registration.

Take for example RCD application number 150206-0001. On 20 February 2004, Crown Confectionery Co applied to register the following RCD for biscuits:



Leng-d'Or sought a declaration of invalidity of Crown's RCD on the grounds that it was not "new" or of "individual character", the two main requirements for validity of an RCD. Leng-D'Or submitted as evidence the following Community trade mark registered for "crackers and savoury foods" published on 12 May 1997:



OHIM held that Crown's RCD retained novelty in spite of the registered trade mark, reasoning that the cracker shown in the RCD has *six circular arches*, whereas the mark has eight pointed arches. Furthermore, OHIM found that, due to these same basic differences, the RCD also retained its "individual character" because it gives a different overall impression to the informed user. Leng-D'Or's application for invalidity failed and Crown's RCD remains on the Register: *Leng-D'Or SA v Crown Confectionery Co Limited* (23 February 2005).

The point-by-point comparison undertaken by OHIM in this case (and repeated in more recent decisions, such as *Aktiebolaget Design Rubens Sweden v Bäcklund and Jakobsson* (20 December 2005)) appears to be a way of dressing up the analysis of "overall impression", rather than a move away from a genuine comparison of the "overall impression" the design will create.

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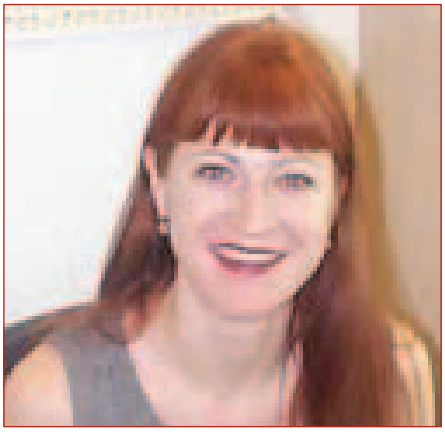

Danise van Vuuren-Nield

David Stone

On the whole, many of the cases reviewed appear to have been poorly argued. There is therefore some danger in trying to draw conclusions or establish precedent from the decisions rendered to date. However, we suggest the following:

- OHIM will not look outside the facts and evidence provided to it – there is no taking of "judicial notice", even for very obvious prior designs that are well known throughout the Community: *Grupo Promer Mon-Graphic SA v PepsiCo Inc* (1 July 2005). Documentary evidence of prior rights should be submitted, showing the date the design was made available to the public in the EEA (although the date should not be written on by hand: *Rodi Commercial SA v ISCA SpA* (30 August 2005)).
- A magazine article makes good evidence of disclosure of a design because "magazines are usually published and distributed": *Leng D'Or SA v Crown Confectionery Co Ltd* (20 September 2005). However, no such assumption can be made about catalogues: *Leng-D'Or v Recot Inc* (8 September 2004).
- The decisions reviewed give little assistance in defining the terms of the Regulation: for example, many of the decisions use the expression "the informed user is familiar with [the object the subject of the design]". In a case about dolls, no indication is given as the whether the informed user is, for example, an adult (vendor/purchaser) or a child (user), finding merely that the informed user is familiar with the designs of dolls: *Aktiebolaget Design Rubens Sweden v Bäcklund and Jakobsson* (20 December 2005).
- The degree of freedom available to the designer appears to impact significantly on the informed user in assessing what overall impression the design in issue will create: *Rodi Commercial SA v ISCA SpA* (30 August 2005). The larger the degree of freedom, the more differences will be required to create a different overall impression on the informed user.
- Filing a Community Trade Mark application is not considered to disclose any design shown in the application – the design will be disclosed for RCD purposes on publication of the CTM: *Leng-D'Or SA v Frito-Lay Trading Company* (19 September 2005).
- Many of the successful actions relate to designs that are so close as to belie any suggestion one was not copied from the other. Although copying is not a requirement for RCD invalidity, it is obviously present in many cases: see, for example *Heidelberger Druckmaschinen AG v Microsoft Corporation* (6 February 2005) where Microsoft's registration of a commonly available font was invalidated.
- A confidential disclosure to a party who then copies and registers the design will not be a disclosure for the purposes of invalidating the RCD: see *Grupo Promer Mon-Graphic SA v PepsiCo Inc* (1 July 2005) in which OHIM accepted that Grupo Promer Mon-Graphic had confidentially disclosed the design for a promotional item to PepsiCo, which then registered the design. OHIM invalidated PepsiCo's registration on the basis of other disclosures.

The test for "novelty" appears already to be sufficiently clear. However, "individual character", "overall impression" and "informed user" all appear to be expressions in need of further judicial clarification.

RCDs remain a useful and cost-effective tool against IP infringement, particularly for look-alike and counterfeit goods. It is to be hoped that national courts and the ECJ will seize early opportunities to provide clarity around the scope of RCD protection.

The authors' views are their own. More information on designs cases is available on the OHIM website: http://oami.europa.eu/en/design/decispending.htm

Meet the new MARQUES officer

Cristina Duch has been appointed to work as the new external executive officer for MARQUES. In an interview with James Nurton of the MARQUES Publications and Website Team, she explains what the role involves and what she hopes to achieve.

Tell us about yourself.

I've always worked in IP, especially litigation in copyright, trade marks, patents and utility models. I've also done a lot of unfair competition and design work.

I started in 1993 working in a very small local IP boutique in Barcelona where I worked for four years. In 1996 I joined the Barcelona law firm Mullerat and a month ago, at the beginning of May, I moved to Baker & McKenzie where I will continue to work in litigation part-time.

What will you be doing for MARQUES?

I will be working part-time, 80 hours a month, for MARQUES. So at the moment I'm settling properly into both jobs. I will be working for MARQUES mainly in the afternoons from a small external office in Barcelona where everyone can contact me.

How did the MARQUES opportunity arise?

I've been attending the MARQUES annual conference since I joined Mullerat. One of my partners there, Carles Prat, is a MARQUES Council member. We were very involved with the MARQUES conference in Barcelona in 1998, helping to organise it. Since then I have attended all the conferences and got to know people, especially on the unfair competition committee, which I joined.

MARQUES were looking for someone and Carles proposed me. It is a nice opportunity for me to work with MARQUES.

What will the post involve?

The title is external executive officer and it is a new post. MARQUES felt they needed someone to handle the international affairs in a professional way. We want to take part in conferences, reports and seminars at the international level, and preferably have an IP lawyer to have some input.

The main task is to be the voice of MARQUES outside and to help all the teams with their activities. I will also hopefully gather new members and have contact with WIPO, OHIM and the main institutions as well as with other IP organisations and associations. We will look to cooperate with them and act together on things of interest to the IP community.

For example, where we identify a big issue we can organise a seminar and contact all the other IP associations even if they are in a sense competitors to MARQUES. The aim is to work together to strengthen these relations. We think MARQUES can have more weight in Europe to help members.

What do you think are the biggest issues facing trade mark owners?

One of the first battles is the fight against piracy, for example coming from China, and MARQUES is very involved in that.

MARQUES is also very active on the Madrid Protocol, especially to see that expand to new Member States to make it even more useful to trade mark owners.

We also face a new legislative guide from UNCITRAL and we have organised some working groups here to draft our position on this.

Another thing we have been working on is gathering representatives of all national patent and trade mark offices into a common forum. That is a very nice way of sharing experiences and meeting global goals. I was in a forum in April, which was an enormous success, with many national representatives from patent and trade mark offices attending. They have the same problems and it is a good focus group.

What are you looking forward to about the role?

I hope to accomplish at least some of these goals. After six months, it will be a success of we can do some work on the Madrid Protocol and widen our list of contacts in the IP community to provide a better service to the MARQUES membership.

We want to attract companies and industry as MARQUES is the voice of trade mark owners. The way to do that is through our work and I will have a proper external role to support the trade mark members.

What do you like to do in your spare time?

I have three kids and we like to go out of the city to a house on the beach. I like everything to do with nature – mountains, hiking, skiing.

Cristina Duch

Gambling on the Madrid system in Africa

Alan Smith, of Adams & Adams, questions whether international trade mark registrations are enforceable in some African countries which have acceded to the Madrid system.

The Madrid Protocol is sweeping across the world. Some African countries are already members of the Madrid Agreement and some have joined the Protocol. South Africa intends to join the Madrid Protocol in the near future; though implementation is not expected before 2006.

Is the Protocol self executing?

Among practitioners in many countries there is a widely held view that the Madrid system is self executing and that rights created by the Agreement and Protocol automatically extend to new members. However, self execution or automatic extension depends on the constitutional dispensation within each country. In the case of South Africa, a consideration of the constitution indicates that automatic extension does not apply.

The view that the Madrid system is self-executing seems to be based on the provisions of Article 14 of both the Agreement and the Protocol, particularly the provision of paragraph 4(b), which states that the Agreement/Protocol shall enter into force three months after the date on which a country's ratification or accession has been notified by the Director General of the World Intellectual Property Organisation (WIPO).

South African authors on the subject of the ratification and implementation of international treaties (see John Dugard *International Law: A South African Perspective* 1st ed (1994) at 344) recognise, broadly speaking, three main constitutional regimes governing accession and implementation, namely:

a) the British system, which empowers the executive to sign or ratify a treaty but requires the legislature to incorporate a treaty into domestic law if it creates rights and duties for individuals;

b) the American system, in which a treaty entered into by the executive (President) and approved by one house of Congress (Senate) has domestic effect without national legislation, unless the treaty concerns matters that require legislation to be adopted by both houses of Congress; and

c) the system applied by many states with bicameral legislatures, where the executive acting with both houses of the legislature has the power to enter into international treaties and the rights and duties of individuals can be translated into domestic law either by statutory enactment or by mere approval of both houses.

South Africa's current constitutional dispensation follows the British model. Dugard (supra, 2nd ed (2000) at 58) suggests that a treaty could be self-executing if existing domestic laws enable a country to carry out its international obligations without further legislation. Since the Madrid system imposes procedures and actions within stipulated timeframes, appropriate domestic provisions in a country are unlikely to exist unless specifically enacted. The view that the Madrid Agreement/Protocol is self-executing is therefore not supported as far as South Africa is concerned.

The situation in South Africa

Section 231 of the South African Constitution (Act number 108 of 1996) indicates that, with limited exceptions, international agreements bind the Republic only after they have been approved by resolution in both the National Assembly and the National Council of Provinces.

The concept "international agreement" is not defined in the Constitution. Article 2 of the Vienna Convention on the Law of Treaties, 1969, defines a treaty as "an international agreement concluded between states in written form and governed by international law, whether embodied in a single instrument or in two or more related instruments and whatever its particular designation".

Terminology itself is not a determinant factor: once an agreement is between states, in writing, and intended to be governed by international law, it is an "international agreement". Since the Madrid Protocol is in writing and constitutes an agreement between states that clearly intend that international law will apply (inasmuch as the Protocol had to be registered with the United Nations in terms of Article 16(5)), it constitutes an international agreement. Section 231 of the South African Constitution would, therefore, apply expressly to the Madrid Protocol.

Although the negotiation of international agreements is an administrative function, section 231 is clearly intended to allow for a democratic determination on whether or not South Africa should be bound by an international agreement. Accession to the Protocol by South Africa therefore required approval by both the National Assembly and the National Council of Provinces, which approval has now been given.

As a second step, enabling provisions must be enacted for the Protocol to become effective in terms of section 231(4), which provides that an international agreement becomes law in South Africa when it is enacted into law by national legislation. The government has indicated that the necessary enabling legislation will be enacted before the country deposits its instrument of accession.

Other African countries

The conflict between the view that the Madrid system is self executing and the position under the South African Constitution prompted an investigation in other African countries. This led to the conclusion that anyone wishing to rely on the Agreement or the Protocol for trade mark protection and enforcement in African countries may find that, in some countries, no rights have been acquired or no method of enforcement has been created.

So far, 12 African countries have joined the

> *"In some countries, no rights have been acquired or no method of enforcement has been created."*

Madrid system: four are members only of the Agreement (Egypt, 1952; Algeria, 1972; Sudan, 1984; Liberia, 1995) and one of the Protocol only (Zambia, 2001); and seven are members of both (Kenya, Lesotho, Morocco, Mozambique, Namibia, Sierra Leone and Swaziland, from 1997, with Morocco joining the Agreement in 1917).

Article 14 of the Protocol does not expressly require enabling legislation upon accession, but accession does not always mean that there will be an appropriate mechanism to acquire or enforce any rights.

Article 14 of the Agreement likewise does not expressly require domestic enabling legislation for accession. It merely provides for either a collective notification by the International Bureau or a declaration by the country concerned in relation to the recognition of marks for purposes of protection. Article 14 has provisions dealing with the effect of international registration and states, in paragraph 14(5), that accession shall automatically entail acceptance of all clauses and admission to all advantages. Even so, Article 14 would not appear to be adequate to provide for all aspects of implementation and could not be viewed as sufficient to render the Agreement self-executing.

Attempts to obtain certainty from legal practitioners in the various countries have not been totally successful; recourse to legal departments at universities was also not decisive. To the extent that information is available, the review of the legislation of African countries that have acceded to the

> *"WIPO appears to have realised that this situation is unsatisfactory and indications are that it will try to persuade new African members to amend their laws before acceding."*

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Madrid system indicates that some automatically recognise international treaties but others do not. Some have taken steps to implement the Agreement or Protocol but others have not. The prospect of enforcing rights in some countries is highly uncertain.

For those with an interest in Africa, a summary of the research findings follows.

Countries with enabling legislation:

Algeria joined the Agreement in 1972 and, by an ordinance dated March 1972, registrations granted under the Madrid Agreement were given the same status as national registrations. This country seems to have fulfilled its obligations. Morocco, which joined the Agreement in 1917 and the Protocol in 1999, has amended its legislation and the courts in Morocco have already upheld international registrations.

Mozambique joined the Agreement and the Protocol in 1998, although intellectual property was not recognised until 1999. When the new legislation was drafted, international registrations under the Madrid system were taken into account and rights should be respected in Mozambique.

Countries with uncertain implementation:

It seems that the constitution of Egypt requires an international treaty to be incorporated into national laws by domestic rules and regulations. There is some doubt over the ratification and implementation of the 1979 amendments to the Agreement; the situation is, therefore, uncertain.

In Kenya, which joined both the Agreement and the Protocol in 1998, recent amendments to the existing intellectual property legislation granted recognition to international registrations. However, the status of international registrations designating Kenya prior to the implementation of the amending legislation is not clear.

Countries without implementing legislation:

Lesotho (1999) and Swaziland (1998) joined the Madrid Agreement and the Protocol. Their constitutions do not appear automatically to acknowledge international treaties. It seems that there must be appropriate domestic legislation. However, neither country has implemented the necessary legislation and there is no provision, in law, to enable rights ostensibly extended to either country to be enforced.

Zambia has been a member of the Protocol since 2001 and indications are that international treaties must be implemented in domestic law; this has not yet been done. An attempt to protect trade marks in Zambia by relying on the Protocol may be futile.

Liberia acceded to the Madrid Agreement in 1995 but its 1972 Trade Marks Act is still in force and there have been no amendments to deal with its obligations in terms of the Agreement. Apparently specific legislation is necessary for the Agreement to be recognised. As a result, the enforceability of an international registration designating Liberia is, again, questionable.

Finally, Sudan has been a member of the Agreement since 1984 but the issue of enabling legislation is simply not clear. The courts do not appear to have had cause to test the validity of a Madrid registration, although enforcement would, in any event, have been problematic because of the civil strife. Although legal practitioners in Sudan tend to be of the view that registrations in terms of the Agreement are valid and enforceable in Sudan, they do not appear to be able to provide reference to supporting legislation. The view seems to be that the courts may recognise the Agreement in any event.

The road ahead

Namibia has deposited (June 2004) its instruments of accession for both the Agreement and Protocol. The draft Industrial Property Bill (not yet in force) provides for recognition of the Agreement and Protocol. However, the Bill does not provide for rights arising from international registrations prior to accession to be extended to Namibia.

WIPO appears to have realised that this situation is unsatisfactory and indications are that it will try to persuade new African members to amend their laws before acceding. Even so, this is a sensitive diplomatic and political issue. WIPO can assist but cannot, of its own accord, intervene if a country fails to do what is necessary to make the system effective. Until there is a strict requirement for enforceability on accession, trade mark owners will be at risk.

***Alan Smith** is a partner based in the Pretoria office of South African intellectual property law firm Adams & Adams.*

More information on the Madrid system is available from WIPO's website: http://www.wipo.int/madrid/en/

Special docketing issues for US Madrid Protocol extensions

Janet Satterthwaite and Andrew Price of Venable LLP **provide some guidelines for MARQUES members who wish to renew their International Registrations in the US.**

Many European brand owners have expressed interest in extending protection to the United States via International Registrations. Some have told us that while they anticipate they will get office actions in most cases, and will need to hire a US associate to take those over, they expect to save money and effort at renewal time.

It is true that an IR does not have to be "renewed" in the United States, but the other rules that apply to the maintenance of any US registration still apply to US extensions under the Madrid Protocol.

First, you must file a declaration of use between the fifth and sixth anniversary of the date that the US issues the registration certificate. There is no grace period. This is similar to the US Section 8 requirement but under the IR is known as a Section 71 declaration.

Second, you must file another Section 71 declaration of use between nine and a half years and ten years after the grant date. There is a three-month grace period. This is similar to the requirement for all US registrations that a declaration of use be filed every ten years when the mark is renewed.

Since the US grant date will be different from the IR registration date, all these dates must be separately docketed.
Finally, a declaration of incontestability may be filed in the US once the mark has been registered and in continuous use for more than five years.

More information on the Madrid Protocol: http://www.uspto.gov/web/trademarks/madrid/madridindex.htm

Reward for reporting a counterfeit product in Korea

Ann Kwon of Kim & Chang explains how members of the pubic can be rewarded for helping the fight against counterfeiting in Korea.

According to an article which was recently posted on the Korean Intellectual Property Office (KIPO) website, KIPO introduced a reward system on 1 January 2006, in an attempt to crack down on counterfeit products. Under the system, those who report a counterfeit product are eligible for a monetary reward ranging from KRW100,000 (US$100) to as high as KRW10 million (US$10,000).

KIPO funds the monetary reward system from its own budget. To elaborate, KIPO's new reward system is intended to help bring to justice those who manufacture and/or distribute counterfeit products, those who infringe trade mark rights or exclusive licences, and those who fall under Article 2(1)(i) of the Unfair Competition Prevention and Trade Secret Protection Act – that is cause confusion with another person's goods by using signs identical or similar to another person's name, trade name, trade mark, container or package of goods or any other sign widely known in the Republic of Korea as an indication of goods, or by selling, distributing, importing or exporting goods with such signs. In the case of distributors, the counterfeit products they distribute should be worth more than KRW100 million (US$10,000) in terms of the price of the related genuine goods.

Any person may file a report when they come across a counterfeit product,

although it is required that the person has a legitimate address or business address in Korea (this applies to non-Korean citizens as well). Reports can be filed with KIPO, the Prosecutors' Office (PO), or the Police Agency (PA). The reports filed with KIPO are handled by the competent police authorities, while those filed with the PO and PA are handled internally. In any case, the identity of the person filing the report is to be kept confidential.

The monetary reward, from KRW100,000 (US$100) to a maximum of KRW10 million (US$10,000), is decided in relation to the price of genuine goods (the amount of counterfeit product multiplied by the price of the genuine goods). The reward is granted when a prosecuting authority issues an indictment or a suspension of indictment based on the report filed.

In one such case, KIPO awarded KRW3.3 million (US$3,300) for a citizen's reporting of a copied product that imitated a famous trade mark. The system has so far been successful: there were 223 such cases in January 2006 alone, while there were only a total of 250 reports of counterfeit products for the entire year in 2005.

Ann Kwon is a senior attorney with Kim & Chang in Seoul, Korea.

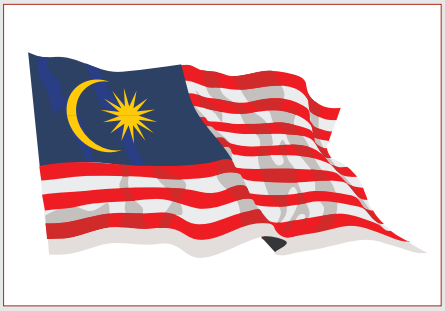
> *"In one case, KIPO awarded KRW3.3 million (US$3,300) for a citizen's reporting of a product that imitated a famous trade mark."*

OHIM Updates

- OHIM has a new internet address – oami.europa.eu – which provides access to all online services. Although visitors to the old addresses are being redirected for the next year, the Office is encouraging all users to update their bookmarks to use the new address. Email addresses of OHIM staff are name.surname@oami.europa.eu

- Two new departments have been created to deal with trade mark examination and opposition proceedings. The Trade Mark & Cancellation Department will deal with trade mark and design data reception, capture and dispatch, trade mark cancellation proceedings and Madrid Protocol applications and will be headed by Beate Schmidt, formerly Director for Trade Marks and Designs in the German Patent and Trade Mark Office. The other department, to be called the Trade Mark & Registry Department, will deal with trade mark and design registry, related databases and Euronice and will be headed by Hans Jakobsen. These two departments replace the Administration of Trade Marks and Designs Department and the Trade Marks Department.

To renew or not to renew



Jin Nee Wong and Shie Ying Liew of Wong Jin Nee & Teo provide some guidance to trade mark owners in Malaysia who have concerns about renewing trade mark rights that date back to before the country was unified.

Malaysia was historically divided into West Malaysia, Sabah and Sarawak. Prior to 1 September 1983 (the Effective Date), the coming into force of the Trade Marks Act 1976 (TMA), there were three separate laws, namely the Trade Mark Ordinance 1950 of Malaya, Trade Mark Ordinance of Sabah and Trade Mark Ordinance of Sarawak (collectively TM Ordinances), under which three separate registers were kept.

An applicant wishing to obtain trade mark protection throughout Malaysia then would have to file three separate applications in these three component regions. Registrations obtained in these regions would bear registration numbers with the prefix M/xxxxx (Malaya), S/xxxxx (Sabah) and R/xxxxx (Sarawak).

With the coming into force of the TMA, the TM Ordinances were repealed and the three registers were incorporated into one single register kept under the TMA. The registration rights obtained under the TM Ordinances are enforceable throughout Malaysia and continue in force and have same effect as if they had been issued under the TMA.

The incorporation of the previous registers into one single register has the following effects:

- Where a mark has been registered in all regions, it will be deemed to have been registered throughout Malaysia.
- Where a mark has been registered in one or two regions and there was no conflicting registration or application at the Effective Date in the remaining region(s), it will be deemed a registered mark throughout Malaysia.
- Where a mark has been registered in one or two regions and there were conflicting registrations secured by different proprietors in these regions, then both marks will be deemed registered in the names of the respective proprietors subject to concurrent use.
- Where there were existing registrations and pending conflicting applications in one or two regions, then the existing registration will only be effective in the region(s) it was originally registered unless the pending conflicting applications were subsequently refused, abandoned or successfully opposed, then the existing registration will be deemed to cover the whole of Malaysia. In the event the pending conflicting applications proceed to registration, then both marks will be deemed registered in the names of the respective proprietors subject to concurrent use.

The common question posed is whether the registered proprietor (RP) holding identical or similar registered marks in two or three regions should continue to renew all of them or should merely renew one of these registrations, usually the "oldest" registration having the widest specification of goods, and abandon the other registration(s) in the remaining region(s).

> *"The owner should renew all registrations in these three regions as any marks which are not renewed will be removed from the Register."*

It is recommended that the RP should renew all registrations in these three regions as any marks that are not renewed will be removed from the Register. In the event there are conflicting registrations in any of these regions in which the marks were allowed to lapse, the Court or Registrar of Trade Marks in determining the conditions of concurrent users may restrict the RP from using its mark in the region in which it chose to "give up".

Alternatively, the RP may wish to adopt the practice of renewing the registrations for all the three component regions in relation to the core or essential marks and to abandon the other two territories for marks which are not that essential to its business.

In the event the RP does not wish to maintain the registrations in all the component regions for cost reasons, it may consider the following options prior to allowing the registrations to lapse due to non-renewal:

- Applying for a fresh application for the same mark covering the same or a wider specification of goods and retain at least one of the registrations to prove that it has secured registration for substantial period; or
- Conducting a trade mark search to determine whether there is any prior conflicting application or registration filed prior to 1 September 1983. If the results show no such prior conflicting application or registration, then the proprietor may retain at least one of the registrations and abandon the remaining registrations.

Jin Nee Wong and Shie Ying Liew are members of Wong Jin Nee & Teo.

MARQUES

THE ASSOCIATION OF EUROPEAN TRADE MARK OWNERS

THE 20th ANNUAL CONFERENCE

Tuesday 12th - Friday 15th September 2006
The Hilton Malta Conference Centre, Malta

RIGHTS IN SHINING ARMOUR

The 20th MARQUES Annual Conference will focus on the complex issues related to the use of brands in sponsoring. International panels of experts will discuss and explore the manifold legal, economic and marketing aspects of sponsoring and will look to the challenges and opportunities for brand owners.

Malta

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For more information visit www.marques.org/conferences or contact the MARQUES Conference Office:

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The geography of food

by Jeremy Phillips and Ilanah Simon

Europe's trade mark community has begun to take almost for granted the increasing number of terms that have been advanced by Member States as being deserving of protected geographical indication (GI) status. The European Commission's Official Journal regularly lists the latest designations, which suggest to the casual browser of the Commission's website that there is now scarcely a region in Mediterranean Europe in which the oil, olives, sheep, wines, cured meats, cheeses and other consumables have not been given their own unique, generally descriptive, protected designation.

The protection of terms is however likely to be a growth area in Europe for several reasons. First, northern European states and countries that have recently acceded to the European Union have been slow to protect their own geographical indications. This may be on account of (i) unfamiliarity with the availability of this protection, (ii) the fact that local appellations are not seen as being under threat and (iii) the trend in those countries to import products bearing GIs rather than to export them.

Secondly it is likely that, when the requirements of the TRIPs Agreement are revised, the scope for GI protection will be extended beyond the foodstuffs and wines for which the law already makes provision, to cover manufactured products such as jewellery, cloth and other items which are traditionally associated with a particular area. This will enable developing countries to gain control over terms associated with products for which lucrative export markets may be cultivated.

Thirdly, in the wake of the European Commission's stance and the subsequent European Court of Justice decision in the *Feta* case last year, interest has been awakened in the possibility of clawing back into collective private ownership a number of terms that may now be regarded as generic, having lost their former geographical significance. These terms include Cheddar and Emmental for cheese, as well as Cornish pasties for a baked pastry case filled with diced meat and vegetables.

> *"Northern European states and countries that have recently acceded to the European Union have been slow to protect their own geographical indications."*

Fourthly, as more businesses find themselves inconvenienced or adversely affected by the grant of GI status, it is likely that more litigation will be directed towards challenging their grant and towards references to the European Court of Justice (ECJ) for preliminary rulings on a number of unresolved problems contained in GI legislation.

One such reference has been made to the ECJ from the Court of Appeal for England and Wales in *Northern Foods Ltd v DEFRA* (the British government department responsible for food). Following DEFRA's decision to recommend to the Commission that the words MELTON MOWBRAY be protected as a GI for a distinctive type of pork pie, Northern Foods raised a number of objections, one of which related to the relationship of the appellation itself to the zone of manufacture. Melton Mowbray is a small town in the county of Leicestershire (incidentally, the home of another GI which is protected by a certification mark, STILTON cheese). The specification for the pies however indicated that they could be manufactured not only in Melton Mowbray but in an area that included parts of Leicestershire and two other counties.

Northern Foods Ltd, who made what it claimed to be similar pies but who had no place of manufacture within the specified zone, challenged DEFRA's recommendation on the ground that there was no clear legal basis for designating a zone that was not contiguous with the name of the area. While it has been the practice of the Commission to accept recommendations for GI protection in such circumstances, the issue has not hitherto been the subject of a specific reference.

> *"In what way are the interests of trade mark law and GI protection to be balanced?"*

Other fascinating questions remain to be asked. For example, what happens where a single manufacturer succeeds in monopolising the use of a GI, which then indicates both the specification of goods produced by him and serves as a guarantee of the identity of goods produced by him: in what way are the interests of trade mark law and GI protection to be balanced? Also, when the body that controls production of goods under a GI stipulates a change in the manufacturing process, with the result that a business which was previously excluded from being able to use the GI now falls within the amended specification, may existing users continue to bar that business from making use of it?

MARQUES members in the food production industries may be vitally concerned in the answers to these questions on a commercial basis. The rest of us may be interested principally as consumers. In either event, it is hoped that their resolution will be swift and unambiguous, for the sake of all of us.

More information from the European Commission:
http://ec.europa.eu/comm/agriculture/foodqual/quali1_en.htm

View the MARQUES GI database here:
http://www.marques.org//Teams/GeoInd/default.asp

The MARQUES Outer Borders Team

The MARQUES Outer Borders Team was formed to focus on and explore the most debated, controversial or challenging issues in the world of trade marks, brands and related IP rights such as geographical indications, industrial designs, domain names and copyright. Within these areas, the Team collects information and differing opinions, and contributes to finding solutions to these issues and/or influencing public opinion.

Daniel Drapeau
Daniel Drapeau practises in all areas of IP law, particularly in patent, trade mark and industrial design litigation. He is a lawyer and trade-mark agent with Ogilvy Renault in Montréal and coordinates anti-counterfeiting programmes in Canada for major European luxury goods manufacturers and has also coordinated and conducted seizures of evidence for a major Canadian telecoms company and a company specializing in collective administration of copyright. Daniel regularly deals with the Trade-marks Office and has appeared before the Opposition Board of the Trade-marks Office, the Quebec Superior Court, the Federal Court and the Federal Court of Appeal.
He has written and spoken on IP topics and taught industrial design law under the auspices of McGill University and the Intellectual Property Institute of Canada.

Wilfrido Fernandez
Wilfrido Fernandez is a partner of Zacarias & Fernandez in Asunción, Paraguay. He studied at the National University of Asunción, Paraguay, Georgetown University Law School (Washington DC) and the JW Goethe Universitaet (Frankfurt, Germany). He is a member of the Paraguayan Bar Association and has been a delegate at many international events, as well as chairing committees for INTA and ASIPI.
He also co-organized and lectured at the First National Seminar on Industrial Property in Paraguay and has been a consultant to the Paraguay government. He is the author of many publications including *Analysis of the New Trademark Legislation of Paraguay*, which was recognised as the best juridical book of 1998 published in the Americas by the Interamerican Bar Association.

Carlo Imò
Carlo Imò graduated in law from the Padova University of Law, Padova, Italy in 1998, before completing, among other courses, a Postgraduate Diploma in EC Competition Law at Kings College, London in 1998. In 1990 he joined the Benetton Group SpA, working from 1990 to1993 at the Litigation Unit (National and International, advertising related litigations) including letters of credit and bank guarantees. From 1993 to 2000 he was the Senior Assistant to the General Counsel and Head of National and International Contracts Department. In 2000 he became the Head of the Corporate Affairs Department. In 2001 he joined Cofiri SpA in Rome as General Counsel of Gucci Gucci SpA in Italy. Carlo is a member of several organisations: the Associazione Italiana Giuristi d'Impressa, Confindustria Team on Competition Law, Unindustria Team on Reform of Italian Trade Union Association Protocol on Agents and Representatives Contract, and a member of the International Chamber of Commerce team on Competition Law and a member of Indicam.

Enikõ Karsay
Enikõ Karsay is member of S.B.G. & K. Patent and Law Office in Budapest. She graduated from the Faculty of Law of Eötvös Lóránd University of Science in 1998, before completing, among other courses, an LL M degree in European Business Law at the Pallas Consortium at the Catholic University of Nijmegen (The Netherlands). She holds a Diploma on Mediation and Negotiation and International Arbitration from the Humboldt University in Berlin. Enikõ is a member of AIPPI, the Hungarian Association for Protection of Industrial Property and Copyright, the Hungarian Trademark Association, Hungarian Competition Law Association and the Expert Body of the Hungarian Patent Office. Enikõ joined MARQUES in 2003 and is the Secretary of the IP Outer Borders Team.

Maria Luisa Palmese
Maria Luisa Palmese joined Kenyon & Kenyon in 1990. She focuses primarily on patent litigation, mainly in the chemical, pharmaceutical and biological fields. She also has extensive experience in patent prosecution in various fields, including pharmaceuticals, nutritional products, agricultural machinery, mosaic design and roofing. In addition she regularly counsels clients on validity, enforceability and infringement issues, as well as licensing and due diligence investigations. She also has a keen interest in the protection of trade marks and design. While at the Munich Intellectual Property Centre she wrote her thesis "Much Ado, Yet Nothing Done About Design Protection in the U.S.: Has the Time Finally Come for a U.S. Design Law?" She is bilingual in English and Italian, and fluent in French and Spanish. Maria Luisa is a member of the Federal Circuit Bar Association, the International Intellectual Property Association, the International Association for the Protection of Intellectual Property, the International Bar Association and MARQUES.

Susanne Skov Nilsson
Susanne Skov Nilsson is Head of Trademarks and Corporate Lawyer at VKR Holding A/S. Susanne holds a Masters Degree in Law from the University of Copenhagen and a Masters Degree in Journalism from the Danish School of Journalism. Before joining VKR Holding, Susanne worked for three years in the Danish Ministry of Finance. Susanne is Vice-chair of MARQUES and vice-chair of the MARQUES IP Outer Borders Team. She is also a member of the Trademark Committee within DIP (Danish Industry IP Specialists).

Massimo Sterpi
Massimo Sterpi is a senior partner in the law firm Studio Legale Jacobacci e Associati. He studied at the University of Turin (Italy) and King's College London (UK). He is a member of the Editorial Board of the European Copyright and Design Reports and serves as a Council Member of MARQUES. He is the founding member and chairman of the IP Outer Borders Team. Massimo lectures at conferences on IP topics and is co-author of *The Community Trade Mark Handbook* (Turin, 1995) and he has authored several articles, in various languages. His practice involves mostly technology, famous brands and art-related issues.

Marieke Westgeest
Marieke Westgeest graduated in law (Erasmus University Rotterdam) and is a qualified Benelux Trademark and Design Attorney and European Trade Mark and Design Attorney. Her experience is diverse: she has worked for several trade mark firms, patent firms, law firms and multinational companies including Unilever and Sara Lee. Marieke is a panellist for the Meditation and Arbitration Centre in Prague and can be appointed as mediator in .eu conflicts. She has given several seminars on trade mark and design law. Furthermore, she is active in various organisations, such as the legislative committee of the BMM, the feedback group of the Benelux Trademark Office with respect to the recently introduced opposition procedure as well as the IP Outer Borders Team of MARQUES.

Write for the MARQUES Newsletter

All **MARQUES** members are welcome to submit articles for publication in the Newsletter. Articles should be submitted by email, and should be about 500 words in length. Relevant photographs and illustrations should also be submitted. **MARQUES** considers publishing articles on any topic that is of interest to members, in particular case reports, details of new legislation, government initiatives, deals, IP strategy and other trade mark-related developments.

If you would like to submit an article, please contact the editor (editor@marques.org) well in advance of the deadline, with details of the subject you propose to cover. You can also contact any of the country correspondents listed below.

The deadline for the next issue is 15th September 2006.

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