

MARQUES Winter Meeting Majorca 2007

The **MARQUES** Winter Meeting took place in Majorca in February. Bas Kist of Shield Mark and Nanda Ruyters of AKD Prinsen van Wijmen review some of the highlights.

Did you know that putting forward a new **MARQUES** corporate member qualifies you for a 15% discount on your own membership fee for the following year? This new scheme was devised by the **MARQUES** Membership Team and is designed to boost the association's corporate membership. It was one of a large number of inventive plans unveiled by the 14 **MARQUES** teams at the **MARQUES** Winter Meeting on 15th and 16th February 2007 on the island of Majorca.

Different character

The Winter Meeting has a totally different character to the autumn **MARQUES** Conference. While the September conference is largely a practical and social gathering for all members, the Winter Meeting gives all the **MARQUES** teams an opportunity to look back over the past year and to present their plans for the coming year.

Behind the scenes

It's amazing what goes on behind the **MARQUES** scenes at the Winter Meeting each year. Not only did practically all of the 14 teams present an impressive list of activities and results, they also detailed their ambitious plans for 2007-2008. We describe some of the highlights below.

Intellectual Asset Management Team

By adopting a critical and committed

approach during the UNCITRAL meeting in Vienna in January 2007, the **MARQUES** Intellectual Asset Management Team ensured that there is now an open debate on IP rights within UNCITRAL.

Designs Team

Thanks to the Designs Team, **MARQUES** members now have access to a unique overview of the first 150 (in)validity decisions of registered Community designs, including pictures of the designs themselves. This is preceded by an analysis of the statutory definitions. This is a truly impressive document, which must have taken a great deal of time and effort to produce. (For more details, see page 11.)

Programming Team

Even before the September 2007 Oporto conference has taken place, the Programming Team is already busy planning the 2008 conference in Noordwijk, a town on the Dutch coast between Amsterdam and Rotterdam. It's a measure of their dynamic approach that the programme for September 2008 is already taking shape.

These, then, are just a few examples of the many ideas presented by all the teams. It's a pity that not all members can see just how much goes on at these Winter Meetings and realise that **MARQUES** involves so much more than the annual conference in September.



Bas Kist

Nanda Ruyters

Social programme

Of course, it wasn't exclusively two days of wall-to-wall meetings in Majorca. At the end of the Thursday there was plenty of opportunity for people to chat to their own and other team members over a relaxing drink and dinner. The Winter Meeting then suddenly starts to look very like the autumn get-together.

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The road ahead for **MARQUES**

Newsletter editor James Nurton speaks to the new **MARQUES** chair, Jane Collins of Syngenta, to find out more about her work in trade marks and her plans for the Association.

How did you get into trade marks?

I started training as a solicitor but I didn't really enjoy that. Then I moved to Denmark for nine years and didn't really do anything with the law. When I came back to the UK I went to a no-work, no-hassle job at a patent and trade mark agency doing office work. After about three months, one of the trade mark partners was really busy and he asked me: would you like to do some trade mark work?

I had two days to apply for the Foundation exam, which I did. That gave me three months to do the work that normally takes four-and-a-half years. Later I moved to BAT; I wasn't looking to move but it was an offer I couldn't refuse. After that I worked at Zeneca, and following the demerger of the crops business, I moved to Syngenta.

Do you prefer working in-house?

In private practice you get a variety of different kinds of trade marks but in-house you get fewer, and for a limited class of goods. It's not monotonous but it means you're dealing with the same sort of thing. At BAT we very rarely launched new brands. It was more about freshening up old ones, for example introducing Lights, so there was not very much searching compared with other industries such as FMCG, where it is more aggressive. At Zeneca, it is more technology-based so there are new brands all the time and you have a much longer lead-time.

In private practice, you never know what you're going to get next. You're also

constantly aware of the need to be charging your time, and you don't have that in industry. The downside in industry is that you sometimes have people who spend too long on things when the work could be completed in 80% of the time.

Tell us about Syngenta.

It's an agri-business company, one of the two biggest in the world with Bayer. 80% of what we do is agro-chemicals – pesticides, herbicides, fungicides – and 20% is seeds. We also have a very small emerging business in the biotech side, with things such as GM cotton, soyabeans and beneficial insects.

What are the main trade mark issues?

It is a highly regulated industry, similar to the pharmaceuticals industry. To get approval for a particular crop, you need data proving it is safe and how it is applied, etc. You have patents but it takes about 10 years to produce anything so that only leaves about 10 years of patent protection. So it soon becomes generic and then counterfeiting becomes quite a problem. We have one attorney who does nothing else but counterfeiting work.

Is counterfeiting a big problem?

It can be. For example, we were sued by a Russian farmer whose crops had died. We did tests and found the produce he used was counterfeit. Farmers are quite small businesses and are more likely to buy counterfeits because they are not using big

wholesalers. Third-world farmers are particularly vulnerable. In China, the industry has got together in a consortium to try to tackle it. There is also a crop life organisation for the agri-business, and we do a lot through them.

When did you get involved with **MARQUES**?

I joined the Council at the Stockholm conference in 1996 and I became vice chair about two or three years later. **MARQUES** has changed enormously in that time. When I first joined it was almost nothing more than a conference organisation, though it was aimed at trade mark owners. It didn't do an awful lot. But we were starting to think about the future. We started to divide up and set up committees. Tove Graulund gave a big impetus and Panos Malamis did a SWOT analysis and we moved on from there.

MARQUES has more than doubled in size now and has been hugely influential. For example, on the Madrid Protocol WIPO called **MARQUES** in and we talked it through. As far as I'm aware, no other organisation was asked to do that. We're very active in supporting WIPO. I made five or six trips all over the world last year – to places such as Mongolia, Brazil, Colombia and The Philippines. We also have influence with OHIM – they like us because we're an owners' organisation.

What have been **MARQUES** main achievements?

Promoting the Madrid Protocol – its use,

MARQUES takes part in designs discussion

David Stone, Chair of the **MARQUES** Designs Team, represented **MARQUES** at an International Symposium on Industrial Designs in Buenos Aires, Argentina, on 20th and 21st March 2007. The Symposium was jointly hosted by WIPO and the Argentinian industrial property office, INPI.



Simposio Internacional Sobre Diseños Industriales



Photograph: INPI

This was one of the first conferences to focus specifically on industrial design rights, and particularly apposite from a European perspective, given the success of the registered Community design, and the impending implementation by OHIM of the Hague Agreement. Participants heard that design rights are no longer the "ugly duckling" of IP.

In addition to speakers from INPI and WIPO, participants heard from representatives of the Spanish, Swiss, Chinese, US, Moroccan and Singapore industrial property offices, as well as from AIPPI, FICPI and AAAP.

David spoke on "Current Tendencies in Industrial Design Protection" in Europe, focussing on the innovative ways that designers and brand owners are using the new EU-wide unregistered and registered rights.

more member countries, and improvements in the countries that have joined – has been a big one. Also, **MARQUES** took the lead on UNCITRAL which was a lot of work and that is looking more optimistic now. The Designs Team has made a review of all European design cases, and there has been a lot of interest in that. Generally, we have helped to keep the beacon burning for European trade mark owners and to look after uniquely European interests.

What are European trade mark owners' interests?

We work for European-based trade mark owners and for all owners who have trade marks in Europe. But we are not limited to the European stage – for example we have been promoting the Madrid Protocol in Latin America and the Far East. We bring a European focus from the majority of the members.

Where is **MARQUES** going in the future?

We're definitely expanding operations in the anti-counterfeiting area – as counterfeiters themselves are expanding. Our Anti-Counterfeiting Team is now split into three groups as it is getting too difficult for one group to cover. We are holding seminars in Amsterdam and Hong Kong and we're going to try to boost that. We'll also continue to push for more countries to join the Madrid Protocol, especially in Latin America.

We will be looking at the OHIM surplus and what we should do generally. We have a regular forum with national offices in Europe, which is in the unique position of trying to gauge their opinions and feelings. It's a difficult question we're trying to address.

How long will you be chair?

I will be chair for a two-year term that is not extendable. There are two vice chairs and we have official elections for the posts. I think the job is not so attractive if it's not finite and it is good to have change every few years. The system will ensure there is continuity but there will be some change of people and ideas.

What do you do in your spare time?

I'm studying advanced Latin at the Open University – I've been studying from home for the past year or 18 months. It's just one module, not a degree or anything, and I'm doing it out of general interest. I'm also quite a fanatical gardener – we have half an acre and are out there nearly every weekend. And I enjoy reading whodunits, especially historical ones.

Romania versus the EU

Following Romania's accession to the EU, Andrew Ratza of Ratza & Ratza asks: do CTMs automatically give earlier rights than national marks?

After a long and arduous journey, Romania has finally succeeded in joining the European Union. It was a moment long awaited by the entire population and the day of 1st January 2007 was greeted with great enthusiasm. It was now time to prove that Romania was ready for this important step and, despite what anyone thought, that it deserved to be a member of the European family.

One of the problems Romania faced in the last stages of negotiations with the EU regarded the field of intellectual property. The EU officially placed a so-called red flag over this subject, pointing out that Romania has important issues regarding the protection and enforcement of IP rights. Romania struggled to make a series of legislative changes meant to improve this situation and, in a relatively short period of time, the enforcement of IP rights became, at least on a theoretical level, much easier to do. But the changes did not stop here. All the major laws regarding industrial property rights were put under scrutiny and projects for the modification of all these laws were conceived.

The Romanian PTO was at the forefront of this effort to get all the legislative changes in place and to prepare the country for the accession to the EU. One of the issues that the PTO had to prepare for was the CTM and the impact that accession will have on the national trade mark system. Although preparing for these particular problems should not have been a big strain on the PTO, since the rules were identical to the ones applied for the 10 new Member States that had joined the Union in 2004, and all that the PTO should have done was to capitalise on the experience of these states, the Romanian officials decided that this will not be the case. In their rush to change everything and to please the EU they decided to be different and to proceed in the Romanian way.

Therefore, since the work on the new trade mark law was far from being completed, the Romanian PTO felt it was necessary to issue an Order regarding the way that accession to the EU and the CTM system will affect how the Office conducts its business. Order 148 was issued in December 2006 and stated, in brief:

Starting from 1st January 2007, all the automatically extended CTMs will constitute earlier rights and will be considered as such during all the registration procedures of national trade marks or international trade marks designating Romania.

Although not very clear in its wording, at first glance the Order does not flagrantly contradict

“The Office has suspended the Order temporarily and provisional refusals based on Community trade marks are no longer issued.”

the European legislation (Article 159a of the Council Regulation 40/94). However, what was in clear contradiction with the provisions of the European legislation was the way the PTO put into practice this Order. According to the Office the Order is to be interpreted in the sense that starting from 1st January 2007, all the automatically extended CTMs are to be considered as earlier rights for all trade mark applications (both national and international) regardless of their application date (before or after 1st January 2007). That is to say that an automatically extended CTM can be cited *ex officio* by the Office as an earlier right in the examination procedure of a trade mark application filed, let's say, sometime in 2005. Moreover, the Office considers that an automatically extended CTM can also be the basis for an opposition against a registered national trade mark.

This interpretation by the Office of the relevant European legislation has sparked a lot of controversies in the IP community in Romania. After some deliberation, the Romanian Chamber of Industrial Property Attorneys decided to officially challenge the PTO's Order. An official letter voicing the concern of the Chamber's members regarding the way the Office intends to apply the legal provisions related to the extension of the CTM system was sent to the Romanian PTO in January. The Office took the letter under advisement almost a month ago. During this period of time different departments within the Office have stated their opinion regarding this matter and some of them agree that the path taken by the Office is not the right one. Unofficially, the Office has suspended the Order temporarily and provisional refusals based on Community trade marks are no longer issued. To this date a final decision has not been taken.

This still unresolved situation affects equally national trade mark applicants and Community trade mark owners who are not yet certain as to the scope of their IP protection in Romania.

Links

The Romanian PTO site:
<http://www.osim.ro/index3.html>

Protecting well-known trade marks in Estonia

Does a new decision put an end to the long-lasting K-Raua versus K-Rauta court cases in Estonia? Adele Rütel and Karolina Ullman of MAQS Law Firm discuss.

In 2001 an Estonian company registered with the Estonian Patent Office the trade mark K-Raua (meaning in English K-Iron), which is a direct translation into Estonian of the Finnish trade mark K-Rauta (also meaning K-Iron) which was used by a Finnish company for several years before the trade mark registration was made by the Estonian company in Estonia. After the registration of this trade mark, the Finnish company submitted a claim against the Estonian Patent Office to declare the registration of the trade mark invalid as it violated its rights arising from the Trade Mark Act. The Finnish company claimed that its trade mark was well-known long before the registration.

At the same time the Estonian company that had registered the trade mark K-Raua submitted a claim against the Finnish company's Estonian subsidiary, on the grounds that the Finnish company was using the trademark K-Rauta, which was a direct translation of the Estonian company's registered trade mark and that it was violating the company's rights arising from the Trade Mark Act.

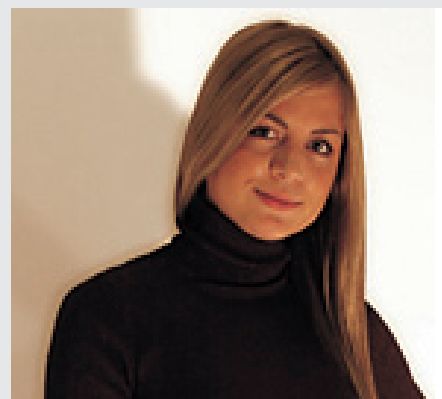
In the case in which the Estonian company filed a claim against the Finnish company, the lower courts decided the claim in favour

“A definition of well-known trade marks was introduced giving the direct possibility to claim protection for these independent of registration.”

of the Estonian company. But the Supreme Court later disagreed and ruled for the Finnish company, saying that a well-known trade mark still takes precedence over a domestic registered trade mark based on the Paris Convention, Article 6bis.

After this judgment was made, the courts started to look over the first claim (where the Finnish company was the claimant). In a decision that came into force in September 2006, they found that the registration of the trade mark K-Raua should be cancelled and deleted from the Registry, because the Finnish trade mark K-Rauta was already known among Estonian consumers before the Patent Office registered the local trademark K-Raua.

In Estonia, the protection of well-known trade marks has become more important during the past few years. From its birth in



Adele Rütel



Karolina Ullman

1995, the Estonian Trade Mark Act has granted protection to trade marks which are well-known within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property. However, in practice this protection was not enough. In 2004, when Estonia entered the EU, the Trade Mark Act was thoroughly renewed. With these changes a definition of well-known trade marks was introduced giving the direct possibility to claim protection for these independent of registration – giving well-known trade mark owners a stronger legal position. The result of this we can see in the ruling discussed here.

Feel like joining a team?

One or two of the teams are looking for new members. The Anti-Counterfeiting Team, for example, would like input from someone from eastern Europe, preferably the Czech Republic. The Designs Team also has a place for someone from eastern Europe.

If you're interested, contact the **MARQUES** secretariat at info@marques.org

Former MARQUES chair Tove Graulund was presented with the outstanding achievement in IP award at Managing Intellectual Property's annual awards dinner in London in March in recognition of her work promoting the interests of trade mark owners. Pictured with Tove is MIP's Europe and Asia editor Emma Barraclough.



Trade marks law to be amended in Singapore

Gladys Mirandah of patrick mirandah co outlines the main changes expected in the amendments to Singapore's Trade Marks Act.



The Trade Marks (Amendment) Bill 2006 proposes a number of significant additions and alterations to Singapore's Trade Marks Act (The Act). It was first read in Parliament on 8th November 2006 and received the Presidential assent on 1st February 2007. It is expected to come into force as the Trade Marks (Amendment) Act 2007 with the following changes.

The most important amendment will be the possibility to file multi-class registrations. This will make post-registration matters such as address amendments, assignments or renewals more manageable and economical, as only one application will need to be filed for all the classes for which the mark is registered.

The Trade Marks (Amendment) Bill will however provide for an option to have the registration of a trade mark divided into two or more separate applications.

This change will allow a more efficient registration process when an application in one or several classes faces objections or oppositions. An application which does not encounter these obstacles will proceed to registration independently after having been divided out. However, the right to divide applications does not allow the applicant to seek protection in new classes not included in the original application.

Furthermore, renewal fees will be payable on a per-mark registration basis.

It will also be possible to register licences for trade marks that are pending and awaiting registration. Additionally, provisions pertaining to additional recognition such as the filing of notices of registrable transactions with the Registry and the keeping of records of such notices by the Registry are also included.

Finally, there will be greater flexibility and discretion given to the Minister who will be able to act independently to make new rules

“This change will allow a more efficient registration process when an application in one or several classes faces objections or oppositions.”

without consulting the Intellectual Property Office of Singapore. Specifically, the Minister will be empowered to make new rules for extension of time limits that have yet to expire and reinstatement of matters that have gone past the due date. Consequently, an applicant who has missed a deadline may be given a second chance to sustain his rights. These provisions give effect to article 14 of the Singapore Treaty on the Law of Trade Marks.

Links

Singapore's IP office: <http://www.ipos.gov.sg>



More efficient protection in Latvia

The Latvian Customs authority recently cooperated with trade mark owners in one of the biggest cases of counterfeit perfumes. Ieva Blekte and Jeppe Brogaard Clausen of MAQS Law Firm explain.



Ieva Blekte



Jeppe Brogaard Clausen

In October 2006 a huge shipment was stopped before Latvian Customs with both illegal counterfeit and look-a-like perfumes which infringed the trade mark rights of Cacharel, Guy Laroche (L'Oreal), Christian Dior Perfumes (LVMH) and many other trade mark owners. The products were imported from Ukraine and the producer of the perfumes is a Ukrainian company named Avalon.

In Latvia, practice in Customs cases shows that typically there are no indemnities or compensation obtained for trade mark owners. Usually in Customs cases, the actions of trade mark representatives are confined only to legal expertise of the products in question that leads to the destruction of goods.

After lengthy discussions with the infringer, a joint action between the brands Cacharel, Guy Laroche (L'Oreal) and Christian Dior Perfumes (LVMH) successfully obtained damages amounting to €3,000. This shows there is now more efficient trade mark protection and it also brings new legal practice into force in Latvia. Moreover, an agreement not to infringe trade mark rights in the future was reached between the trade mark owners and the infringer.

Protection of trade mark rights in Latvia is becoming more and more important as the amount of marketing of products infringing registered trade mark rights is increasing. Initiating more strict consequences for infringers, including in Customs cases over the protection of trade mark rights, makes enforcement more effective and brings legal practice closer to that of neighbouring countries in Scandinavia and western Europe.

“Practice in Customs cases shows that typically there are no indemnities or compensation obtained for trade mark owners.”

Update on trade marks in Africa

Andre van der Merwe and Jeannine Robertson of D M Kisch Incorporated provide an overview of potential pitfalls and opportunities for trade mark owners in Africa.



Andre van der Merwe



Jeannine Robertson

Many trade mark owners and potential applicants do not realise that almost every country in Africa has different requirements and provisions when it comes to filing trade mark applications. What follows is an update and summary of some of the differences faced in various African countries with regard to trade mark registration.

a) Countries not registering service marks

In Malawi, Nigeria, Uganda and Zambia, applications for service mark are not accepted. See also Sierra Leone and Gambia under c) below

b) Somalia

Due to political unrest, Somalia does not have any intellectual property laws in place at this time, and it is uncertain when any such laws will be adopted and implemented.

c) Classification

Sierra Leone and Gambia have not yet adopted the Nice classification and still follow the former British classification of trade marks. This classification system has 50 classes of goods, with no provision for services.

d) New-filing countries

Sao Tome & Principe, as well as Cape Verde Islands, have recently accepted the filing of trade mark applications. However, in Eritrea, filing of trade mark applications is still not possible, and the only option is to proceed by way of publication of cautionary notices.

e) OAPI

For those who are not familiar with OAPI, it is a regional IP registration system dealing with French-speaking African states. OAPI covers the following

countries: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Congo, Equatorial Guinea, Gabon, Guinea, Guinea Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal and Togo. In trade mark applications, it is not possible to separately designate any one of these countries. An OAPI application/ registration therefore extends to all these countries. One characteristic of the OAPI system to bear in mind is the publication of the mark for opposition purposes after registration. This opposition period lasts for six months.

f) ARIPO

Likewise for those who are not familiar with ARIPO, it is a regional IP registration system dealing with English-speaking African countries. At present, only eight countries have acceded to the Banjul Protocol (the enabling treaty to file ARIPO trade mark applications/ registrations): Botswana, Lesotho, Swaziland, Namibia, Zimbabwe, Malawi, Uganda and Tanzania. With the exception

of Zimbabwe, none of these countries has amended its national legislation in order to recognise ARIPO applications/registrations, and the new law in Zimbabwe has not yet come into force. In light of this, it is recommended that trade mark owners should file national applications in the member states until the national laws of these states have been amended to give recognition to the Protocol.

g) Namibia

The (composite) IP Bill – including patents, trade marks, designs and unlawful competition but excluding copyright – that was published last year has not yet been approved and passed by Parliament. We are monitoring the passage of this legislation to modernise the IP law of Namibia, and we shall report when the IP Act comes into operation.

Links

[Find out more about OAPI here](#)
<http://www.oapi.wipo.net> and [ARIPO here](#).



The limits of copyright in Sweden

Christina Berggren of MAQS Law Firm discusses two new cases where an applied art was considered to be protected by copyright in Sweden.

The Swedish Copyright Act includes applied arts – works of design – in the list of works in which a creator can own copyright.

Swedish Courts of Appeal have recently given decisions in two cases concerning claims based on alleged infringements of the copyright to works of design, that is applied arts. The works of design in question were the flashlight Mini Maglite and the quilted down jacket Dun Expedition.

In the case regarding the flashlight Mini Maglite, Mag Instrument, Inc (Mag) filed a claim against IKEA for damages on the grounds of infringement of Mag's copyright to the Mini Maglite. The basis for Mag's infringement claim was that the Mini Maglite's design is original and the result of creative work and therefore is protected by copyright. Mag won the case in the District Court but lost in the Court of Appeal. Contrary to the opinion of the District Court and Mag, the Court of Appeal declared in its decision that the shape and design of the Mini Maglite nearly completely corresponds to what can be described as the basic shape of a flashlight at the time when the Mini Maglite was designed. The only difference between the Mini Maglite and other pocket-sized flashlights in respect of shape and design is the fact that the Mini Maglite does not have a visible power switch. Due to this the Mini Maglite does not meet the fairly high requirements for an item of applied art to be protectable by copyright. According to the court, therefore, Mag had no copyright

to the flashlight Mini Maglite and the sale of identical flashlights by IKEA did not constitute infringement.

In the other case, Fenix Outdoor AB (Fenix) filed a claim against two other Swedish companies for damages on the grounds of infringement of Fenix's copyright to the jacket Dun Expedition. As in the Mini Maglite case, the basis for Fenix's infringement claim was that the design of the Dun Expedition holds such originality that it should be considered to be a work under the Copyright Act. After losing the case in the District Court, Fenix was successful in the Court of Appeal. In its decision the court first declared that it has been clarified through a decision by the Supreme Court in 2004 that a fashion product can, like other applied arts, be subject to copyright. In order to attain copyright it is required that the garment has been created with originality and independence and that the result is an individual and artistic design.

The court based its judgment on whether the design was original and independently created, and on the availability of similar jackets at the time when the Dun Expedition was designed. The court established that at the time when the Dun Expedition was designed only one similar jacket was available – the Moncler – and that the Dun Expedition is designed with a combination of details that makes it different from that



jacket. Based on this the court decided that the Dun Expedition was an original design and the result of independent creative work and therefore was protected by copyright.

The outcome of both these cases is unexpected and it remains to be seen if the Supreme Court will decide on the cases. The Swedish Society of Crafts and Design has in two opinions declared that Mini Maglite is protected by copyright. As regards copyright protection for garments, the requirements have generally been very high and it could be questioned whether the Dun Expedition jacket fulfils these requirements.

Links

Read about Sweden's copyright law here:
<http://www.sweden.gov.se/sb/d/2707/a/15195>

“The outcome of both these cases is unexpected and it remains to be seen if the Supreme Court will decide on the cases.”

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Blog to the future

Rebecca Tilbury of Pinsent Masons assesses the rising phenomenon of blogs, their uses and implications for IP professionals.

Oscar Wilde once said that "It is a very sad thing that nowadays there is so little useless information" and I feel this epitomises the phenomenon of blogging, which churns up vibrant opinions and articles daily from leading players in their fields. Blogs spark debate, change and most importantly creativity. They extend beyond the normal realms of government and media comment to look at issues in-depth and relay them to those who need to know – including IP professionals.

The complexity of IP has been well documented. In his paper "Innovating for success: The Intellectual Property Review and Economic Competitiveness" (July 2006) Lord Sainsbury called for a sophisticated debate about IP and for the government to recognise the complexity of the system but not to stifle innovation, something which has been a problem for the UK in the past.

In general blogs give a voice to people who are normally behind the headlines and ensure their comments are not blocked by red tape or bureaucracy but are automatically placed in the public domain.



“There is a pressing need for blogs to be taken more seriously and used consciously by professionals and academics as a credible resource.”

Top blogs

A blog is a journal/newsletter that is frequently updated and intended for general public consumption; posts on blogs represent the personality of the author – which is part of their appeal. Starting a blog is a quick and easy way of creating your own web presence, but legal problems arise with this form of media, such as defamation, confidentiality, copyright and libel.

For professionals in the IP field, blogs are becoming a new mainstream reference point for up-to-date news due to their immediacy and sharp focus on the latest cases and regulatory developments. The magical thing about blogs is that they discuss events as they happen, and this speediness makes them very appealing.

Each blog provides a unique perspective and analysis of IP law, often with the flavour of the country in which its author is based, which makes blogs a source of invaluable information as you gain opinion and not just facts. Readers need to acknowledge that comments on a blog are sometimes unverified and not subject to any restrictions, therefore they should note that what is posted is not always strictly accurate. There are dangers connected to unverified comments but the nature of blogs is that the comments are put out there to be analysed, debated and used at the readers' own risk. However, as Justin Patten, of the Human-Law Blog, says: "On the positive side, blogs are good networking tools, can generate business and do act for me as a good place to store research and information and refer to other articles I like on the web."

Below are five wide-ranging blogs that vary in content and perspective but may all be of interest to the IP professional.

1. Naked law

(<http://www.nakedlaw.typepad.com>)

A group of Cambridge lawyers from Mills and Reeve, headed by Alasdair Poore, maintain this blog, which focuses on developments in technology law. The blog is well laid out and the posts are accessible, with posts split into categories such as brands/patents/copyright



and digital media/software and hardware. There is also a handy archive retrieval system. The blog posts are not overly detailed and do not give a strong sense of opinion from the authors but as a source of basic information, especially technological it is worth a look.

2. IPKat

(<http://www.ipkat.com>)

This UK blog is run by academics Jeremy Phillips, Ilanah Simon and Johanna Gibson and patent attorney David Pearce and deals with trade marks, designs and patents. The IPKat and the alternative authorial voice, Mepel, provide daily updates of news and case decisions in IP, which are also available via email bulletins. The striking difference between this and other blogs is that the personalities of each of the authors shine through in the posts and they often attack each other in corresponding posts, which is a good form of internal quality control and offers the audience broader opinions.

IPKat always references the source of comments, which gives the posts authority and a degree of accuracy.

3. Impact – IP and IT Law Blog

(<http://www.impact.freethcartwright.com>)

This award-winning blog is run by UK Law Firm Freeth Cartwright LLP and headed by Andrew Mills. It covers various areas such as branding, freedom of information, podcasts and litigation. The content is accessible and there are posts regarding specific areas such as IP in China. All posts are referenced with links to the source of information.

The key driving force behind this blog appears to be providing pragmatic (often client) viewpoint posts and the team actively engages with the comments they receive, which allows them to interact with people on a broad spectrum and communicate with clients on a different level. Andrew Mills says: "Blogs are really important. It gives us the ability to publish quickly and with minimal

Counterfeiting Focus Spots:

Asia and the Internet Continuing Challenges for Brand Owners

22nd May 2007 –

Hilton Hotel, Amsterdam Airport

Full details and online registration are available on the MARQUES website (<http://www.marques.org/conferences>)



process getting in the way. We can use the blog to showcase our views, our approaches and personality... a good way to provide information to clients which is of a general interest."

4. Trademark blog

(<http://www.schwimmerlegal.com>)

This blog is maintained by members of the Schwimmer Mitchell Law firm and focuses on all areas of US IP law, with around 50 wide-ranging categories dedicated to specific subjects such as "famous marks", "advertising", "trade mark fair use" and "dilution". The blog is always up to date, even having a top 5 links section which is updated hourly and all posts are heavily referenced making it easy to locate the original source, so you can verify what is being written.

The blog is professional in that there is an "About us" section which gives details on the authors and their history in IP, a section on "How to Register a Trade Mark" giving basic information and also a rolling screen displaying famous brand marks from past and present.

5. Now, why didn't I think of that?

(<http://www.gelsing.ca/blog>)

This Canadian blog focuses on patent, trade mark and copyright issues and is run by Canadian IP Lawyer Sander Gelsing from Warren Sinclair LLP. Although this blog does not cover Europe, the content is still relevant as there are references to UK cases and law in relation to Canadian decisions.

This blog appears to be ultimately about having fun with trade mark law and takes a light-hearted look at recent decisions and applications and is useful for Canadian trade mark database updates.

“The nature of blogs is that the comments are put out there to be analysed, debated and used at the readers' own risk.”

6. Other notable blogs

a. IPI Policy Bytes (USA)

<http://www.policybytes.org/>

b. IP Dragon (China)

<http://www.ipdragon.blogspot.com/>

c. Le petit Mesees des Marques (France)

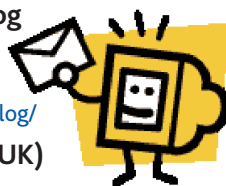
<http://www.museedesmarques.ouvaton.org/>

d. The Lessig Blog (USA)

<http://www.lessig.org/blog/>

e. Human Law (UK)

<http://humanlaw.typepad.com/>



Are blogs a liability?

It is important to mention that aside from the IP sphere, blogging is becoming big business with over 100 million active members of blog hosting sites MySpace and Facebook. The recent acquisition of YouTube by Google highlights the importance that companies are placing on online social networking and the growing emphasis on Web 2.0.

Many businesses are considering the implications of setting up blogs and producing corporate podcasts, as negative comments can cause major marketing headaches and the leakage of confidential

information can spell the end of a product launch. For example L'Oreal set up the Vichy blog with disastrous consequences. However, at the same time a brand is complemented by having a human voice and discussing ideas with potential customers without launching a brand campaign, making a considerable saving. For example McDonald's, IBM and Time Warner all run corporate blogs to engage with their consumers and keep interested parties in the know. "Due to embedded social attitudes towards traditional media, the writer of an offline diary is more likely to weigh his words carefully... online content, however, can be read by just about anybody with an internet connection... exercise less editorial consideration" (Scott Vine, Clifford Chance, EBL 2004).

There appear to be an abundance of blogs directly from the US that narrowly relate to US IP law. However, those of the highest quality and with a sharper focus come from the prominent UK sites discussed above.

There is a pressing need for blogs to be taken more seriously and used consciously by professionals and academics as a credible resource. People need to be intelligent about the information they read and use blogs as a building block to further discussion and research which will spur the innovative sphere of IP forward.

For IP professionals, blogs provide invaluable information, are a good networking tool and offer a place to store articles. On a wider scale blogs allow interaction with people across the globe who experience different trade mark systems and can provide advice based on experience, for which there is no substitute.

Dilution law evolves in India

Trade mark dilution has been recognised in India since 1999 and addressed in numerous cases, the most recent earlier this year. Manisha Singh of Lex Orbis explains.



Dilution is a trade mark law concept forbidding the use of a famous trade mark in a way that would lessen its uniqueness. In the course of time a trade mark acquires a selling power that transforms it into a famous trade mark and often, eventually, a brand. This transformation is essentially the expansion of the trade mark, making the trade mark per se acquire distinctiveness due to consumer preferences for the products it represents.

Dilution takes place when a famous trade mark is used by another on non-competing goods where there is no likelihood of confusion between the two uses of the mark. Thus traditional trade mark infringement and dilution start with the same concept of mental association of the trade mark by the consumer. But they differ in that the mental association is not the mistaken belief that the plaintiff is in some way associated with the defendant's goods but rather is the recognition that a mark once associated exclusively with the plaintiff is now also in use as an identifying symbol on other products.

Injury by dilution

Dilution is weakening or erosion of the uniqueness or ability of a mark to unmistakably signify a single source of a product or service. The erosion can occur in two ways: it is (1) likely to blur the distinctiveness and/or (2) tarnish the reputation of the trade mark.

Blurring is basic dilution: it blurs a mark from being associated with only one

product to signifying other products in other markets. Tarnishment is the weakening of a mark through unsavoury or unflattering associations.

Dilution in India

Statutory recognition has been given to the modern concept of trade mark dilution. Section 11 Clause (2) (b) of the Trade Marks Act 1999, while enumerating Relative Grounds for Refusal of Registration of a trade mark, says that:

A trade mark which is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor, shall not be registered if or to the extent the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.

The expression "detrimental to the distinctive character" refers to blurring and the expression "detrimental to the repute" refers to tarnishment of a famous mark.

Dilution or the erosion of distinctiveness is generally raised as a head of damage to goodwill. Cases on dilution of a trade mark have to show something akin to a monopoly interest in the name or indicia so that there is real damage to the exclusivity in the name.

In *Caterpillar Inc v Mehtab Ahmed & Others 2002 (25) PTC 438 (Del)* the Court developed the Indian law on dilution in a substantial way by holding that dilution or weakening of the trade mark takes place where there is no likelihood of confusion but that is not to say that there would have been no dilution where there is a likelihood of confusion. The Court reasoned that though the goods are similar to those of the plaintiff, the principles of dilution could be applied as the inferior quality goods of the defendant were leading to dilution of the value of the plaintiff's trade marks.

In a recent judgment involving the infringement of the registered trade mark of

Castrol Limited in Castrol Limited & Another v Manoj Duggal & Another 2007 (34) PTC 95 (Del), punitive damages were awarded for dilution of the plaintiffs' trade marks as well as infringement. Castrol Limited marketed its products under the banner of Castrol, which is registered in India for petroleum products. In addition, the mark Castrol GTX for lubricants and fuels and a device depicting a motorcycle rider and hockey sticks forming the backdrop of the trade dress of the plaintiff are also registered. A suit for infringement of the trade mark and damages was filed alleging that the defendant was using the same trade mark and trade dress on similar products. On perusal of the evidence, the infringement of the trade mark as well as the trade dress was established. On the front of assessment of damages, though the plaintiff failed to provide any evidence about the size of the seizure made, the Court awarded punitive damages for dilution of the trade mark as well as for infringement of it.

Protecting famous marks

The concept of dilution as a form of intrusion on a trade mark aims to protect distinctive, famous and unique trade marks from losing their singular association in the public mind with a particular product. These trade marks include instantly recognisable brand names and unique invented words. A famous trade mark may also establish a basis for dilution protection from the standpoint of consumer confusion. Famous trade marks are likely to be seen in many different contexts due to branching out, to the extent that there may be a market that a consumer would be surprised to see that famous trade mark involved in. A prime example may be the connection of Mercedes-Benz in an undergarment clothing line.

The award of punitive damages for dilution of the trade mark on the same level as infringement is significant in the sense that the blatant copying of a plaintiff's trade mark and trade dress even in the case of similar goods/services manifests a lessening of the uniqueness of the trade mark due to trade mark piracy on goods of inferior quality.

MARQUES designs review launched

In the first of a series of articles providing an update on **MARQUES** team activities and achievements, David Stone of Howrey LLP introduces the **MARQUES Designs Team Review of RCD Invalidity Decisions**.



The introduction of the registered Community design (RCD) on 6th March 2002 heralded a new era in protection of intellectual property in the European Union. As at 31st

December 2006, 222,466 applications for RCDs had been filed with OHIM, and 214,581 registrations had been granted. Such a high number of registrations is explained by the fact that OHIM does not examine applications on relative grounds.

Once issued, RCDs can be notified to Customs or used in *ex parte* interlocutory proceedings, without any opportunity for the allegedly infringing party to test the validity or otherwise of the RCD. Thus, the process of applying to OHIM to invalidate RCDs assumes a particular importance.

With this in mind, the **MARQUES** Designs Team undertook a review of the first 150 decisions on invalidity of RCDs made by OHIM, and has now published the results of the review. The report is available online, free to **MARQUES** members, at www.marques.org

The aim of the report is to assist designers, brand owners and legal practitioners with

some statistics on OHIM's decisions, as well as to provide some practical pointers on how to conduct and defend invalidity proceedings. We read the first 150 decisions so you don't have to!

The report gives statistics on the languages used for decisions and the nationality of both holders of contested RCDs and those contesting the RCDs. It will not surprise rights owners that Article 25(1)(b) – the requirement for “novelty” and “individual character” – is the ground for invalidity most relied on.

Where our report will hopefully be most useful is the analysis of the jurisprudence of OHIM to date. Although the decisions are generally light on detailed analysis, it is possible to start to draw some threads of authority as to the meaning of some of the legal terms in the Designs Regulation. Much more detail is given in the report, but some examples include:

- the publication of a design for a toothbrush in the register of the Japanese Patent Office could reasonably be expected to come to the attention of toothbrush designers in the European Union;
- a magazine article makes good evidence of disclosure, because magazines are usually published and distributed. The same cannot be said for catalogues

or company brochures;

- the “informed user” is not a person skilled in the art, or a designer, or an expert in the field;
- the indication of the product in the RCD does not form part of the assessment of overall impression, because it is not a feature of the design; and
- bad faith is not a ground of invalidity.

The report also includes a chart of the first 150 decisions, an excerpt of which is shown here, to provide a pictographic summary. For practitioners looking for cases in a particular industry, the chart provides easy access to relevant decisions.

This brief article is not the place for a full summary of the conclusions of the review. However, the review demonstrates the importance to rights owners not only of filing RCDs to protect their rights, but also of monitoring RCD filings to ensure that invalid RCDs are not allowed to remain on the register.

The **MARQUES Designs Team** welcomes feedback on the report, and suggestions for future projects.

David Stone is chair of the **MARQUES** Designs Team.

Links: Download the **MARQUES** Designs Review at www.marques.org

Date of Decision	Decision No.	RCD No.	Applicant	Earlier Right	RCD Owner	RCD	Grounds	Result
30/08/2006	ICD 000001006	000163290-0002	Honda Motor Co. Ltd.		Kwang Yang Motor Co., Ltd.		Art. 25(1)(b)	Invalidity Application rejected
31/08/2006	ICD 000002185	000171178-0005	Honda Motor Co. Ltd.		Wuxi Kipor Power Co., Ltd		Art. 25(1)(b)	RCD invalid
31/08/2006	ICD 000002640	000273693-0001	Societe BIC		Baide International Europe s.r.o.		Art. 25(1)(b)	RCD invalid
08/09/2006	ICD 000002285	000387089-0002	Ancieto Canamasas Puigbo		HENKEL KOMMANDITGESELLSCHAFT AUF AKTIEN C/O HENKEL KGaA		Art. 25(1)(b)	Invalidity Application rejected
12/09/2006	ICD 000001956	000330782-0001	HK Ruokatalo Group Oyi		Atria Yhtymä Oyj		Art. 25(1)(b)	RCD invalid
12/09/2006	ICD 000001964	000330782-0002	HK Ruokatalo Group Oyi		Atria Yhtymä Oyj		Art. 25(1)(b)	RCD invalid
13/09/2006	ICD 000001642	000378757-0001	Linea Hogar Deco, S.L.		Venilia, S.A.		Art. 25(1)(b)	RCD invalid

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. Everyone is welcome to contribute to the Newsletter, whether or not you are listed as a correspondent. **The deadline for the next issue is 15th June 2007.**

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If you would like to join the list of country correspondents, please email editor@marques.org

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