

FULL MARQUES FOR TURKISH DELIGHT

Jeremy Phillips and Ilanah Simon, who produce the cases for the **MARQUES** online case law database, give an account of what it is like to attend the **MARQUES** Annual Conference.

Jeremy is a seasoned attendee whose experience of **MARQUES** conferences goes back to 1986, while Ilanah is a first-timer. Their first thoughts on this year's conference appeared on the IPKat weblog (www.ipkat.com) both during and shortly after the event.

As many readers will know, this year's **MARQUES** Annual Conference took place between 16 and 19 September in Istanbul. We joined the ranks of 400 trade mark owners, practitioners and experts from across Europe and beyond at the Ceylan Inter*Continental Hotel. This year's theme was 'Successful Brand Growth'. Within the generous scope which this theme allowed them, the speakers and delegates examined the challenges to brand-owners arising from mergers, acquisitions and brand extensions. Here are just a few of the highlights.

After the opening ceremony at which **MARQUES** and its officers were welcomed by Mr Selim Sengun, Head of Patent & Trade Mark Office, Turkey, the first substantive session focused on the strategic and financial implications of mergers and acquisitions. On the issue of tax and transfer pricing, Arnout van der Reste (PricewaterhouseCooper) raised issues concerning the split between legal and beneficial ownership of trade marks, where the beneficial ownership is held in a lower tax regime. Questions were asked as to whether the split ownership could jeopardise the trade mark registration. Wim Holterman (also from PwC) mentioned that business-to-business (B2B) brands will always be valued lower than brands aimed directly at consumers because B2B brands don't reach out and



directly address the consumer. This problem can be resolved, according to Katherine Basile (Howrey Simon Arnold & White), by 'ingredient branding', where a branded product manufacturer promotes the brand of a manufacturer of a constituent of its product (e.g. where branded computers are advertised by reference to the INTEL microprocessor).

The Turkish experience of branding matters was the subject of the final session of the first day. Ozlem Futman (OFO Ventura) drew attention to the difficulties of registering packaging and slogans in Turkey. While the Turkish trade mark law.

*Tove Graulund – Chairman of **MARQUES** and Selim Sengun – Head of Patent and Trade Mark, Turkey.*

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parallels that of the EU, the Turkish Patent Institute is sometimes liable to reject applications for subject-matter which is registrable elsewhere in Europe.

Branding and its relationship to sport was considered in the first session on the second day. Marcel Beerthuizen (TWBA/Brand Experience) gave an impassioned account of the advantages of both event sponsorship and ambush marketing, showing first how maximum publicity can be leveraged from becoming an official sponsor and then how cunning planning can undermine or completely scuttle the official sponsor's position.

One good example was Amstel's hijacking of a Carlsberg-sponsored football event by giving out its distinctive hats to thousands of spectators.

Following on from Marcel, Sven Klos (Klos Morel Vos & Schaap) had some practical things to say about protecting sponsors against ambush marketing. The crudest forms of ambush marketing are actionable as infringements of trade mark rights or other IP rights. The problem lies with more subtle approaches, which manage to infiltrate a competitor's brand name into



Marius Knijff.

the heart of a sponsored event before the ambush can be detected. In some cases it is not clear whether IP rights are infringed at all. This was the case when Telecom New Zealand replaced the five interlocked Olympic rings with the strategically placed words "ring, ring, ring, ring" and "ring". The next session was devoted to the work of the Project Teams, specifically the IP Marketing Team, which considered the implications of Digital Rights Management. While Adam Baxter (BBC) and Kirsi Ekström (TeliaSonera OYJ) focused mainly on its use

for protecting copyright works in the field of broadcasting and mobile phone services respectively, the intriguing prospect of using DRM to protect trade marks was raised. This session was followed by the presentation of the Lewis Gaze Memorial Scholarship.

That afternoon, participants were faced with the difficult choice between two sightseeing tours and three workshops. On offer were: 'eu-Challenges and Opportunities'; the Trade Mark Owners' Forum and 'Overbranding and Social Reaction'. Always willing to avoid the onerous task of sight-seeing when the pleasures of talking trade marks are made so readily available, we attended the session presented by Massimo Sterpi (Jacobacci). He detailed the many ways in which a brand can court unpopularity in the marketplace or beyond it.

This unpopularity may reveal itself in the brand being parodied, defamed or attacked in more subtle ways.



*WIPO and OHIM Panel Chaired by Huib Berendschot – Team Leader **MARQUES** Trade Mark Team.*



Conference session underway.

Massimo listed three types of hatred: that which attaches to the mark itself, that which points to the company behind the mark and that which points at the country with which the brand is associated.

On the final day, the latest developments within WIPO were presented by Marcus Höpperger (of WIPO), followed by a consideration of recent events and decisions within OHIM and the European Court of Justice by Alexander von Mühlendahl and Bruno Machado (both of OHIM).

In conclusion, we can report that this year's conference had much to offer both the first-time attendee and the hardened conference-goer. We eagerly await the **MARQUES** Conference 2004, in Rome.

NOTE: Full details of all papers and photographs are posted on the **MARQUES** Website: www.marques.org



Istanbul⁰³
ANNUAL CONFERENCE



Sven Klos.

Full **MARQUES** for Turkish Delight

(CONTINUED)



*Alexander von Muehlendahl,
Vice-President, OHIM.*



Istanbul⁰³
ANNUAL CONFERENCE



*Session Chair Willem Leppink
with Marc Jacobs.*



Panos Malamis..

MARQUES Annual Conference 2003: The Social Programme

David Stone (Howrey Simon Arnold & White) also travelled to Istanbul for the 2003 Annual Conference. At the request of the Editor David's report dwells on the social programme of the event: The Ilanah Simon and Jeremy Phillips' article covers some of the technical sessions in greater detail. David is at pains to point out that he attended most of the sessions and learned a lot about experiences in industry and in other countries.



Ottoman Mint – Social

Straddling the Bosphorus and linking the Asian and European continents, Istanbul is as beautiful as its history is fascinating. And what a venue for the **MARQUES** 2003 Annual Conference!

Arriving Tuesday night, we were treated to a reception at the Rahmi Koç Industrial Museum, an interesting collection of machinery (and some much coveted vintage cars) on the waterfront. It was a time to catch up with old friends, and meet new ones, while the call to Muslim prayer drifted across the water from the minarets on the opposite shore. This was the first of many opportunities for networking in convivial surroundings.

The theme of the conference was **"Successful Brand Growth"** – with each of the speakers examining the challenges and opportunities facing brand owners,

particularly in relation to brand exploitation, and the less often explored area of mergers and acquisitions. The sessions were of the usual high quality. (Please see Jeremy and Ilanah's report elsewhere in this Newsletter).

Wednesday evening saw delegates venturing by coach to "a cultural experience" at the old Ottoman Mint in the grounds of the magnificent Topkapi Palace. The occasion was one of the highlights of the conference. Delegates were treated to fine Turkish food while enjoying traditional music, belly dancing and displays of local crafts (always useful for presents to take home).

One of the most entertaining sessions was on Thursday morning on brands and sports. Marcel Beerthuisen demonstrated his ambush marketing skills whilst Sven Klos asked whether those investing in sports marketing get what they pay for. I suspect that if Marcel's clients succeed in their ambush marketing, Sven's clients won't!



The Social Programme

(CONTINUED)

Before lunch on Thursday, the Lewis Gaze Memorial Scholarships were awarded by Alexander von Mühlendahl. Lewis Gaze was the first Chairman and President of **MARQUES** and the annual scholarship in his name recognises students at a local university who have written an essay on brand protection. This year, Ulas Demir from Bilgi University, Istanbul, was awarded first prize for his essay "The Exhaustion of Trade Mark Rights and Parallel Importation". His prize includes all expenses paid participation in the 2004 Annual Conference in Rome.

After lunch the siren song of an organised excursion lured me to the delights of Istanbul: the Sultanahmet Mosque with its 21,043 blue-glazed tiles; Hagia Sophia, built as a church by Emperor Constantine in the city that then bore his name, rebuilt by Roman Emperor Justinian in the 6th Century, and transformed into a mosque on the arrival of the Ottomans in 1453; followed by carpet shopping (with a tempting aniseed drink rightly called "lion's milk") and a visit to the Grand Bazaar. Exploring Istanbul was a relaxed way to network with clients, potential clients and foreign associates.



After the excursion, with Istanbul traffic as bad as it was, there was just enough time to change into black-tie for the Gala Dinner. Guests boarded boats for a short 007-like boat ride down the Bosphorus to the Ciragan Palace Hotel, where Whirling Dervishes whirled in the cool night air, before a magnificent meal in the Palace. Stamina award goes to the band, which kept the hits coming, without a break, into the early hours.

The "now traditional" Friday morning session remains one of the best of the

Conference. Marcus Höpperger kindly replaced a colleague at the last minute to speak about developments at WIPO, including the accession of the USA to the Madrid Protocol. Bruno Machado, Head of Boards of Appeal at OHIM, discussed some recent decisions, including some in relation to non-traditional marks (including taste, 3D, position and colour marks). Alexander von Mühlendahl all too rapidly trotted through recent decisions of the CFI and ECJ. This is always one of the highlights of the **MARQUES** conference, and was sadly cut short as he ran out of time.

And with that, the Annual Conference was over for another year, with delegates departing for the airport, or an afternoon of golf at the Kemer Golf and Country Club. Once again, the **MARQUES** Secretariat and Council did a marvellous job of keeping everybody on time and happy.

See you in Rome!



Delegates relaxing – Turkish style!



Istanbul⁰³
ANNUAL CONFERENCE



"The *Dolce Vita* of Design Protection"

By Massimo Sterpi

On October 17, OHIM and **MARQUES organised in Rome a joint seminar on the design protection under the new EU, national and international laws.**

The Conference was opened by a word of introduction and greeting by Ingrid De Groot, who welcomed all participants on behalf of **MARQUES and announced the next **MARQUES** Annual Conference 2004 in Rome.**

The first speaker was Mr. Carlo Guglielmi, President of INDICAM (a leading organisation of Italian brand owners) and CEO of the world famous FONTANA ARTE design factory. Carlo discussed the importance of design for the first world businesses – which live on innovation and protection thereof – whereas production can be sub-contracted to anywhere in the world. He also expressed very interesting remarks about the possible risks linked to the introduction of labelling such as "MADE IN ITALY" for famous Italian design firms, which often sub-contract the production or buy raw materials or components abroad, so that they could be ineligible to use such a label.

This was followed by three presentations concerning the current legal protection of industrial designs in Italy.

The first, delivered by Mr. Marco Francetti of Studio Legale Jacobacci & Associati, focused on the Italian national laws on industrial design, underlying the large variety of "legal weapons" now offered for its protection. He also highlighted some problems concerning the possible protection offered to industrial design under Copyright Law, additional to that provided for under the Registered Design

Law. Requirements for protection under Copyright Law are, in fact, both the creative character and the "artistic value", the latter element being very subjective and difficult to evaluate. He also reported on forthcoming amendments to the law which may clarify these and other areas of uncertainty.

This was followed by Mr. Carlo Rusconi of OHIM, who gave an extensive presentation on both the substantial requirements for a design to enjoy protection under the EU Community Design Regulation (EC Regulation no. 6/2002) and the proceedings to obtain a design registration with the OHIM in Alicante. He also reported on the first national case law based on the Regulation with respect to the concept of unregistered design rights.

The presentations on the current protection offered by the law were closed by Mr. Giulio Zanetti of IDLO, who summarised the protection mechanism offered by the international model under the Hague Convention and the new possibilities offered by the new Convention ratified a few months previously.

The day was concluded by two outstanding presentations by the heads of the intellectual property departments of Gucci and Prada, respectively.

Ms. Murielle Vincenti for PRADA and Mr. Carlo Imo' for GUCCI – with a wide array of examples and stunning visual presentations – gave a very interesting insight into the protection strategy of large fashion groups, which have to take into account the usual life-span of each single product and the possibility of covering, through trademarks, some elements which have or have acquired a distinctive status. These presentations were particularly welcomed by the audience, as it is rather rare to be allowed access to this kind of information.

All the presentations were followed by a number of questions from the audience, which permitted a very interesting debate among the attendants and the panellists.

The Seminar was chaired by the writer, who was particularly honoured to co-ordinate such a prestigious and successful event.

"DOUBLEMINT" unregistrable

By Joanna Gray, Managing Associate of Linklaters Alicante

The European Court of Justice (ECJ) recently handed down its long-awaited judgement on the registrability of the word mark DOUBLEMINT as a Community trade mark (CTM), in Case C-191/01 P of 23 October 2003.

OHIM, followed by the First Board of Appeal, had initially refused Wrigley's CTM application for DOUBLEMINT for *inter alia* "confectionery and chewing gum" on the basis that the sign DOUBLEMINT is simply a combination of two English words that describe certain characteristics of the goods in question, namely their mint-based composition and their mint flavour, pursuant to Art.7(1)(c) of the Community Trade Mark Regulation (No. 40/94) (CTMR).

The European Court of First Instance (CFI), however, held that the word DOUBLEMINT did not fall within CTMR Art.7(1)(c) because it had two different possible meanings. It could mean that it had twice as much mint or that it was flavoured with two varieties of mint (mint being a generic term for a number of different herbs, such as spearmint and peppermint). The CFI ruled that, as the word DOUBLEMINT had an ambiguous, suggestive meaning open to various interpretations, it was not "exclusively descriptive" and it was therefore perfectly registrable as a CTM.

The ECJ, following the opinion of Advocate General Jacobs and the intervention of the UK and German governments in support of OHIM, set aside the judgement of the CFI. The ECJ held that the CFI had misinterpreted Art.7(1)(c) by finding that a mark was registrable if it had a number of possible meanings as it was not "exclusively descriptive". CTMR Art.7(1)(c) clearly refers to trade marks which "consist exclusively of

signs or indications" which "may" be descriptive and not to marks that are "exclusively descriptive". Contrary to the finding of the CFI, the ECJ held that the wording of Art.7(1)(c) actually meant that a sign must be refused registration if at least one of its possible meanings designated the goods or services concerned or their characteristics, as with the word DOUBLEMINT.

The ECJ further clarified that Art.7(1)(c) pursues a public interest aim of leaving descriptive signs or indications relating to goods and services or their characteristics free for use by all traders.

The ECJ further confirmed that the signs and indications comprising a mark do not have to be in actual use as descriptors of the goods or services or their characteristics to be unregistrable. It is sufficient that they could be used as such in the future. This is clear from the choice of the word "may" by the legislator in drafting Art.7(1)(c).

The ECJ's interpretation of Art.7(1)(c) of the CTMR is no surprise. Its findings are wholly consistent with the wording of Art.7(1)(c) and generally accepted principles of (Community) trade mark law. However, the judgement is not the landmark case that it had the potential to be. The CFI judgement in the DOUBLEMINT case was generally considered to be a bad ruling. It is a shame that the ECJ did not take the opportunity to rule on the wider issues considered at length by Advocate General Jacobs in his

Opinion of 10 April 2003 on the DOUBLEMINT case. Advocate General Jacobs not only attempted to clarify his earlier controversial BABY-DRY decision and to provide guidance on how it should be applied consistently, he even devised a three-stage test to assist in assessing whether a mark is inherently registrable. We will have to wait for these issues to be tackled by a future, more courageous, ECJ panel.

DISCLAIMER:

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

Introducing: The Publications and Website Team

We shall introduce the members of other teams in future issues

The Publication & Website Team is responsible for all printed and published materials, including the structure, contents and lay-out of the newsletter and website, pre-conference material (with the Programming Team), case notes database, educational material (with the Education Team), membership recruitment materials (with the Promotion & Marketing Team), mailing lists for publications.

The current members of the team are:



Ms Hanne

Weywardt –

Chair Hanne is in-house IP counsel for and heads the trademark department of an internationally focused tobacco company based in Denmark (**Skandinavisk Tobakskompagni A/S**). Initially practising as attorney at law in general areas, Hanne has specialised in IP law for the past six years.



Bas Kist is partner and co-director of **Shield Mark**, a trademark office in Amsterdam with 50 employees. He has specialised in trademarks since 1990. He regularly publishes articles on trademarks in the major Dutch daily newspaper 'NRC Handelsblad' and is a contributor to the advertising trade journal 'Adformatie'. Bas has written several books including 'So you thought you had trademark rights' (1995), 'Trade Name Law' (1997) and 'Trademark Fiasco's' (1998).



Jeremy Phillips holds degrees from Cambridge and Kent, is a Professorial Fellow, Queen Mary Intellectual Property Research Institute, and Visiting Professor to the universities of Alicante, UCL and Bournemouth. He is also intellectual property consultant to London-based solicitors **Slaughter and May**. Together with Ilanah Simon he is a consultant to the case law database of **MARQUES**. He has written numerous articles and books.



Robin Tyler has been the Legal Research Officer for **British American Tobacco** since 1996 and the Editor of the **MARQUES** Newsletter since 2001. Before that (for more years than he cares to admit) he was the marketing manager for a small but internationally successful computer software company. He is a barrister and holds a Masters degree in the management of Intellectual Property.



Ingrid de Groot was the in-house IP counsel for the second-largest confectionery manufacturer in Europe (**Perfetti Van Melle Holding B.V.**) for some 15 years. Early in 2003 Ingrid was appointed to the post of **MARQUES** Development Executive to further expand its role in shaping IP in Europe. She sees the **MARQUES** Newsletter as an important tool in achieving that purpose.

Robert Harrison is a director of **association enterprises** and has over 10 years experience of developing and implementing integrated computer and IT systems and is a specialist in developing database driven web and email based applications and services.



Geographical Indications

MARQUES newly formed Geographical Indications Team has produced a paper giving full support to the INTA proposal for a system facilitating the protection of GIs, with examination and opposition at Member State level. You will find both papers at www.marques.org/latestinfo

A system as described in the papers could be the starting point for a solution that would build for the future and make it easier to obtain effective protection of GIs. At the same time, a system as proposed could open the way for a solution to the very practical and basic problems with GIs as opposed to other IP rights – for instance, that fact that there is no central database that can be used in clearance searches. The new GI Team is committed to participating in the important tasks that lie ahead.

As part of this work, the Team will monitor and take an active position – as appropriate – with regard to the extension of Art. 23 TRIPS protection to products other than wines and spirits as well as monitor developments in respect of the undertaking of some WTO Member States to try to re-develop designations which have become generic or trademarks into geographical indications. The Team will seek solutions which do not prejudice existing, validly registered trade marks.

Members who are interested in becoming involved, please contact either the Secretariat at info@marques.org or Team members Burkhard Goebel at burkhart.goebel@lovells.com and Susie S. Ekstrand at sse@lettco.dk

The colour combination of Red Bull

Bas Kist¹

In May 2003 the European Court of Justice (ECJ) delivered an important decision on colour marks. The case had been brought to the Court by the Dutch telephone company Libertel. In its rather complex decision of 6 May 2003 the ECJ gave some general rules that should be applied with regard to the registration of colour marks in Europe.

In the first place the ECJ ruled that in principle one can register a single colour as a trademark, but that this is only possible in exceptional cases and that distinctiveness of colour marks should usually be acquired through use.

Further the Court stated that strict rules should be applied with regard to the technical part of the registration. According to ECJ, to register a colour *per se* (without any spatial delimitation) as a trademark, the colour not only has to be distinctive, but also will have to be represented graphically in such a way that it is described in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner (these are the requirements that were set out by the ECJ in the Sieckmann case about a smell mark, in December 2002). A mere sample of a colour does not satisfy these requirements. In particular a sample of a colour may deteriorate with time. Therefore it does not possess the required durability, according to the ECJ.

The general conclusion after this Libertel decision could be that, in the future, it would be a tough job to obtain protection for colour marks.


Therefore it was interesting to see how the Libertel rules would be applied in EU-member states. In the Benelux people were looking forward to a decision of the District Court of Utrecht

in a case between Red Bull, manufacturer of a well known energy drink with the name Red Bull, and United Soft Drinks (USD).

United Soft Drinks, just as Red Bull, used the colour combination silver and blue for their energy drink London. Red Bull is the owner of various trademark registrations of the colour combination silver and blue, all registered well before 6 May 2003, the date the Libertel decision was rendered. What would the District Court of Utrecht do in one of the first cases about colour marks after Libertel? Were the registrations of Red Bull valid and, more generally, could Red Bull claim this colour combination as a trademark at all?

USD argued that the registrations of Red Bull were invalid. According to USD, the registrations did not comply with the requirements of the Libertel decision. One of the registrations of the combination silver and blue did only contained a sample of the colour together with the description in words 'metallic silver and metallic blue'.





Because no internationally recognised identification code like PMS or Pantone was added, this registration could not be accepted, said USD. A second colour mark registration of Red Bull contained an internationally recognised identification code. However, according to USD this registration was not valid. There was an inconsistency because the registration mentioned two colours: 'silver' and 'metallic grey'.

On 23 October 2003 the Dutch Court decided in favour of Red Bull. It is interesting is that in its judgement the Court starts by saying that the rules as they are laid down in the Libertel decision cannot, as such, be applied to the registration of a combination of two colours. The subject in Libertel was a single colour mark and not a combination of colours.

With regard to the first registration of Red Bull the Court states that the absence of an internationally recognised identification code does not *per se* make the registration invalid. However, according to the Court, one could seriously doubt whether this registration without the code, is sufficiently stable and durable.

With regard to the second registration, the one with the internationally recognised identification code, the Court rules that this one is, without any doubt, valid because a recognised

code is recorded in the registration. Even if there should be an inconsistency in the registration, the Pantone code makes it comply with the Libertel requirements.

Finally the Court states that the colour combination silver and blue for energy drinks is not very common. And because the goods for which the registrations are applied for are limited to 'energy drinks', the colour combination can be considered to be inherently distinctive.

Having said this, the Court is of the opinion that the packaging of London infringes the trademarks registration of the colour combination silver and blue of Red Bull.

From this case in the Netherlands one can conclude that the strict rules, as they are laid down for single colourmarks, cannot as such be applied to trademarks that consist of a combination of two colours.

For Red Bull this is, of course, a great victory. According to Sven Klos of Klos, Morel, Vos & Schaap, the lawyers of Red Bull, the other manufacturers of energy drinks that use the colour combination silver and blue, can look forward to receiving a summons.

1 Partner Shield Mark Amsterdam, The Netherlands

MARQUES meets with the European Commission

A **MARQUES** delegation consisting of the Chair and members of the Cyberspace Team, held a meeting with the Commission on Monday 8th November to discuss the .eu

The purpose of this meeting was for **MARQUES** to offer advice to the Commission and to assist them to form Public Policy rules. The Sunrise rules were discussed in detail.

MARQUES also put forward the requirement and need for the "Whois" in addition to the Dispute Resolution policy.

The **MARQUES** Cyberspace Team will keep you fully updated on developments. However please note that it is **NOT** possible to register domain names under .eu yet, although this may be being offered from many sources.

Report from Barcelona Seminar held on 15 May 2003

Angel Aguado

Under the title “The trade mark as a tool of competitiveness” a challenging program was organised jointly by MARQUES and Pimec Sefes, the Catalanian Association of Small and Medium sized companies. Pimec Sefes represents over 90,000 companies being, by far, one the most significant entrepreneurial associations in Spain. It provides a wide range of services to its associates as well as organising various seminars and courses throughout the year.



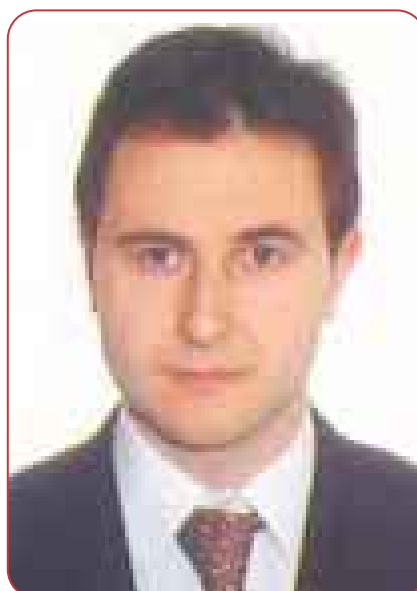
The Forum, specifically addressed to managers and personnel of small and medium-sized companies, provided the opportunity to learn about the importance of protecting intellectual property assets in a globalised economy and explained the guidelines on how to carry out such protection at national and UE levels.

A welcoming speech by Mrs. Ingrid de Groot, identified major issues currently facing trade mark protection for businessmen and professionals alike.

The ensuing speeches were made by the Forum Chairman Mr. Flavio A. Soares, from Torralba Abogados, which highlighted some new aspects of the Spanish Trade Mark Act. Following that, Mr. Pere Sugrañes, President of the Spanish Trade Mark Attorneys Association and Mr. Marcelino Currel, President of the Spanish Trade Mark Attorneys Association for International Bodies, provided a detailed view of CTM opposition proceedings.

The Forum was also presented with a view from industry with a very interesting experience described by Mrs. Carmen Prieto, Communication Director of PPG Iberica, S.A., on how PPG carried out a re-branding strategy after having acquired the coating and painting division of ICI. This section generated a warm debate among the attendees with the unmatched assistance of Mrs. De Groot and moderation by Mr. Soares.

An event evaluation among the 40 or so participants conducted by Pimec Sefes clearly supported a follow-up session after the summer holidays.



ANGEL AGUADO

Madrid gets a boost

The USA has implemented the Madrid Protocol and since the 2nd November 2003 it has been possible to designate the USA under the Protocol.

In addition, from 25th December 2003, Iran has implemented both the Madrid Agreement and the Protocol.

MARQUES is also pleased to report that last Friday the COREPER decided to recommend to the Council of Ministers the adoption of the Commission proposal for a decision approving the accession of the EC to the Madrid Protocol.

Furthermore, the WIPO General Assembly has voted to adopt Spanish as a working language. It is hoped that this will make it more attractive for South American countries to join the system.

MARQUES Newsletter: Your views

During the conference in Istanbul, delegates were given a questionnaire seeking their views, hopes and aspirations for the **MARQUES** Newsletter.

Most of those who read the Newsletter (about two-thirds of those responding) found both its length and frequency of publication about right. As regards content, many people held the view that the primary function of the Newsletter was to inform members (and potential members) about ongoing activities of **MARQUES**. We have to rely on the various **MARQUES** Project Teams to make this happen.

A few commented upon the fact that reported case law referred to in past issues was a little out of date. However, a quarterly Newsletter can never compete with the many widely read journals and bulletins already filling this need on a more frequent basis (eg, *European Intellectual Property Review*, *World Intellectual Property Reports*, *Trademark World*, etc). Against that, some responses sought more information on practical trademark matters. To accommodate this, the Publications & Website Team has started to compile a list of voluntary "rapporteurs" to feed the Editor with short comments on key changes in national law, legal work in progress, case law, administrative practice etc¹. The number of rapporteurs is still. Volunteers for this task are urged to contact Ingrid de Groot, **MARQUES** at developmentexecutive@marques.org

As regards distribution in hard-copy by post or electronically by e-mail, opinions seemed fairly evenly divided. The Publications & Website team will certainly investigate the options for e-mail distribution.

To all who made their views known, thank you. We will strive to meet your demands. If you have any views on these or any other aspects of the Newsletter, please do send them to:

Robin Tyler, Editor – robin_tyler@bat.com

¹ Copy for the next issue to be with the Editor by 15th January 2004 please.

A Guide to the Domain Name Registries of the EU

Later this year, the European Commission will be announcing the rules for a new .eu domain which is likely to be introduced in the second quarter of 2004. In the run up to this, the **MARQUES** Cyberspace Team undertook a survey of the registries in the Union which is available on the **MARQUES** web site in the Cyberspace Team area .

The global market for domain names now comprises over 50 million names. The Table below takes data from ICANN and sets out the split between generic Top Level Domains and Country Code Domains, comparing 2002/3 to 2003/4.

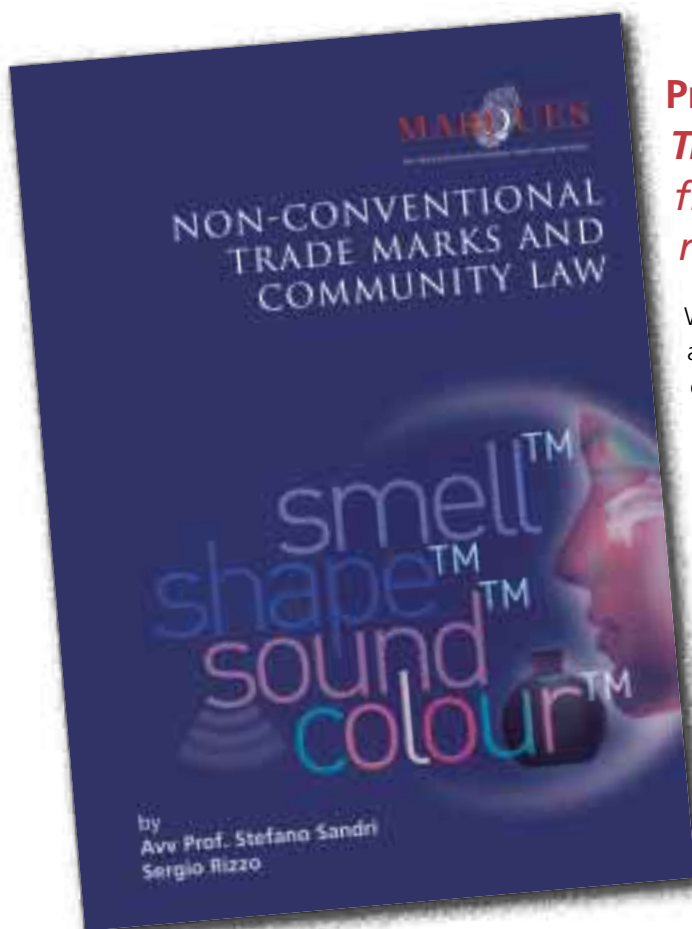
	2002-2003		2003-2004	
	No. of Domain Names	Percent	No. of Domain Names	Percent
GTLDs (.com, .org, .net, .info, .biz etc)	33,333,000	67.90%	31,819,000	61.60%
CcTLDs (.de, .uk etc)	15,746,270	32.10%	19,158,364	38.40%
Total	49,079,270	100.00%	50,977,364	100.00%

Source icann.org, July 03

It is interesting to note how the number of ccTLDs has grown by 6% this year over last year. Why is this? Are more companies registering in overseas jurisdictions? Maybe. Is it indicative of a worldwide trend towards registry liberalisation? It certainly seems as if more registries are choosing to allow businesses and individuals to file with freedom, a step they often take at the same time as implementing a Dispute Resolution System to stamp out piracy.

Whatever the reason, the survey is designed to give a flavour of the regimes that operate within the countries of the European Union.

Any questions should be directed to Nick Wood, Chair of the Cyberspace Team: nwood@cpaglobal.com



Prof. Sandri book on “Non-Conventional Trade Marks” now available. MARQUES first publishing venture – essential reading for all Members

What do a shoe buckle, the colour orange, the roar of a lion, the noise of a Harley Davidson exhaust pipe, the smell of freshly cut grass, the cock's crow, the scent of raspberries and the “Für Elise” melody by Ludwig van Beethoven have in common?

At first sight, little or nothing. Yet they do share a common link. They are signs and thus communicate something to someone and, under certain conditions, can work as trade marks.

The examples given above are not selected at random. They have each appeared in recent cases.

“Non-Conventional Trade Marks for Community Law” (ISBN 0-9545703-0-8; A5; 36pp) written by Avv Prof Stefano Sandri and Sergio Rizzo, is a significant piece of research and is the first book to be published by **MARQUES**.

The author's examine in detail the juridical aspects of this emerging economic, social and cultural reality, starting from an analysis of such marks within the Community Trade Mark System. They begin by clarifying what is meant by a “sign” capable of becoming a

Community Trade Mark, concentrating, in particular, on the theory of sign communication and perception and examining the minimum requirements that all signs must satisfy to benefit from protection under the Community's Trade Mark system – their distinguishing capacity and graphical representation.

The work then presents an in-depth analysis of problems linked to acceptance of “new marks” among Community marks, especially in the light of recent and, at times, controversial case law promulgated by the Court of Justice. Detailed attention is focused, in turn, on shape, colour, smell and sound marks before the authors turn their attention to “futuristic marks” as they explore the potential of other types of mark which might be registered in the future (*position, tasted, tactile, gesture, sequences, light, holograms, etc.*).

Fully annotated and supported by an extensive bibliography covering each topic, the book also supplies a comprehensive list of the relevant international and national laws – insofar as they govern the issue of non-conventional marks – together with full details of the most significant and relevant case law.

The book is now available to Members through the **MARQUES** Secretariat at the special rate of **€45/£27** per copy (Cover price for non-Members: **€50/£30**) plus **€5/£3.50** for postage and packing. Please refer to the **MARQUES** Web site (www.marques.org) for further details.

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