

OHIM upbeat on costs and backlog

At a special meeting in Alicante, representatives of **MARQUES** and OHIM discussed the latest developments relating to the Community trade mark and design, as well as other issues affecting European brand owners.

OHIM officials gave an optimistic report to **MARQUES** representatives at a special meeting held on 17th May. The meeting, which is likely to be repeated annually, took place at OHIM's offices in Alicante. There were 15 representatives of **MARQUES** present, including members of the Council and the trade marks team.

Healthy finances

OHIM President Wubbo de Boer reported that recent changes such as the enlargement of the EU had been managed without fees being increased – news which will be welcomed by brand owners.

From 2006, the Office will start to receive renewal fees from the first Community trade marks (CTMs). Meanwhile, the amount it pays for national searches is being reduced. As a result, the Office's finances should remain healthy and there should be room for a fees reduction in the near future – although no decision on fees has yet been taken.

OHIM trade marks director Hans Jakobsen provided statistics showing that the Office has eaten into the backlog in formalities, examination, opposition and cancellation. Following efficiency improvements, the average time between filing and publication is now 10.2 months, and is expected to fall (this time includes the three months for national searches). Jakobsen added that the backlog in receipt, classification, examination and cancellation is likely to be negligible by



the end of this year, and OHIM intends to be able to render decisions on cancellation within three months of the close of proceedings. **MARQUES** welcomes the backlog reduction, provided examination quality is maintained.

However, the backlog in opposition decisions (about 25% of opposition cases reach the decision stage, the remainder being settled during the cooling-off period or thereafter) is likely to remain, with the average time from the closing of the proceedings to the decision currently about 14 months. The situation will be improving before the end of the year. OHIM is looking into ways to speed up the opposition process.

Madrid Protocol

The Office will start to receive designations under the Madrid Protocol from 1st October this year. It promises to examine on absolute grounds in six months. It is expected that this will therefore be a popular route for protection. The combined fee for application and registration, which has to be paid up front (to WIPO), is € 200 less than the fee for the direct route to OHIM, as a result of

the savings in particular as regards translations. When the Madrid mark does not proceed to final acceptance, the part of the fee corresponding to the registration element will be refunded.

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OHIM upbeat *continued...*

Enlargement

Vincent O'Reilly, director of the administration of trade marks and designs department, said that 35 staff from the new EU member states will have been hired by the end of this year – but, like all EU institutions, OHIM has found it hard to recruit staff who speak Maltese or Latvian.

Eight of the 10 new member states are likely to perform national searches, with only Slovenia and Cyprus indicating that they will not at the time of the meeting. Searches by the new member states will be made only for CTM applications filed after their accession to the EU, that is after 30th April 2004. The first search reports from these countries are expected by the end of this year. All national searches will become optional from 2008, under Article 39 CTMR as revised by Council Regulation (EC) No 422/2004.

“The backlog in receipt, classification, examination and cancellation is likely to be negligible by the end of this year”

The Office has also finalised its guidelines on opposition, enlargement and restitution. The enlargement and restitution guidelines will be published in the next Official Journal (No. 6/2004); the opposition guidelines will only be published on the internet, due to length. The guidelines are binding on staff and may be useful for applicants to review. They are likely to be updated every two years, and further guidelines on (for example) non-traditional marks and geographical indications may also be published. The guidelines are available on the OAMI-ONLINE website.

The database CTM-ONLINE has been redesigned. The search facilities will extend to more parameters.

A new electronic facility under the OHIM's "e-business" strategy will also be available in the near future, enabling applicants to access their own files and submit and receive communications electronically.

The meeting also addressed how applicants can help to reduce examination times. Representatives of OHIM advised that the most important things include proper indications of the goods/services so as to avoid classification problems, preferably by using the EURONICE indications available on OHIM's website, referring to an old registration (if relevant) and using electronic filing where possible.

On behalf of **MARQUES**, Chairman Tove Graulund made a presentation illustrating the role that brands play in industry, and demonstrating some of the challenges of protecting the different aspects of a brand. She explained what brand owners want from trade mark protection, such as the need to protect the whole brand and the difficulty of identifying some of the less tangible aspects of branding.

Visit OHIM online at:

<http://www.oami.eu.int>

CTM-ONLINE is available at:

http://oami.eu.int/search/trademark/la/en_TM_search.cfm

“Eight of the 10 new member states are likely to perform national searches, with only Slovenia and Cyprus indicating that they will not at the time of the meeting”

From the editor...



This Newsletter is the first to be published since I joined the MARQUES Publication and Website Team in June. On behalf of the team, I would like to thank Robin Tyler at BAT who edited the MARQUES newsletter before me, and stepped down in the spring. Robin has built up the newsletter into a valuable resource for all MARQUES members, and I hope that is a foundation we can build on in the years ahead.

Since attending my first MARQUES conference in Stockholm in 1996, I have come to know many MARQUES members individually and to appreciate the vital role the association plays for brand owners in Europe and beyond. In the rapidly evolving world of trade marks, the opportunity to share knowledge and meet colleagues is

invaluable, and organisations such as MARQUES have an important part to play.

As editor of Managing Intellectual Property magazine for the past six years, I have seen first hand the changes and challenges that face brand owners in Europe.

Together with the rest of the publications team, I hope that we can bring you an interesting, thought-provoking and entertaining Newsletter each quarter. If you have any comments on the Newsletter, suggestions for articles to be included, or pieces you would like to submit, please feel free to contact us at editor@marques.org.

James Nurton



Designs discussed in Venice

Experts gathered to discuss the international design system earlier this year, as the Hague Agreement was modified to make it more useful for brand owners.

A conference in the spring this year provided an opportunity for trade mark owners and officials to discuss design protection and compare strategies for registering designs. The conference was organised jointly by WIPO, the Italian Ministry of Productive Activities and the City of Venice. It was held in Venice on 13th and 14th May.

MARQUES was represented at the Conference by Council member Carles Prat of Mullerat in Barcelona. He says the Conference came at a crucial time for the international design system: "The purpose was to promote the international registration of designs. WIPO have modernised the Hague Agreement to enable more countries to step into the system."

The revision of the Hague Agreement on 1st April this year introduced the Geneva Act, which is designed to encourage more countries to accede to the Treaty, making it more attractive to applicants. The Geneva Act also enables regional systems – such as the Community design – to be incorporated.



Prat, who gave a presentation on the second day of the conference, adds: "Our role was to present on why designs are important to trade mark owners and how protection can be achieved."

In his presentation, Prat reviewed the advantages of various tools available to protect designs – including three-dimensional trade marks, unregistered designs, the Community design, copyright and unfair competition – and the interplay between them. "Branding is a combination of everything – and design and packaging are an integral part of that," he explained.

Prat was among more than 20 speakers from all over the world to address the meeting. The first day of the conference featured presentations from representatives of national and international offices, including Wubbo de Boer of OHIM, Lois E. Boland of the USPTO, Ernesto Rubio of WIPO and Zhang Qin of the State Intellectual Property Office in China – which leads the world in the number of design applications filed.

The speakers provided news and statistics on design protection and application procedures in their jurisdictions. De Boer outlined OHIM's progress in administering the Community design and explained that the Office aims to improve electronic filing and reduce delays in publication in the coming year.

Giuseppe Bertoli of the European Commission DG for the Internal Market provided an update on the Commission's plans to amend the Designs Directive to deal with spare parts – a controversial subject which was left out of the original Directive. He also confirmed that the EU is working on accession to the Geneva Act of the Hague Agreement, which may be completed during 2005.

The second day featured speakers from IP organisations such as AIPLA, FICPI and **MARQUES** as well as industry representatives including Gerhard Bauer of DaimlerChrysler, Yoshihide Nakamura of Sony and Kenneth D. Enborg of General Motors.

More information on the Hague Agreement is available at:
<http://www.wipo.int/hague/en/index.html>

Full details of the Venice conference can be seen at:
<http://www.wipo.int/meetings/2004/venice/en/index.html>

“Branding is a combination of everything – and design and packaging are an integral part of that”



Slow start for Madrid in the US

Trade mark owners celebrated the opportunity to designate the US using the Madrid Protocol in November 2003. Six months on, Janet Satterthwaite of Venable examines the trends revealed from the first filings.

On 2nd November 2003, it became possible to designate the United States in an International Registration under the Madrid Protocol. This US practitioner's perspective eight months on is that Madrid is off to a slow start with US brand owners, but seems to be more popular with European brand owners.

Who is filing?

According to statistics compiled by NameProtect, Inc, as of 18th May 2004, 889 International Applications were originated (outbound) from the United States. Foreign brand owners have been more visible, with over 4,000 International Applications/Registrations (inbound) designating the United States as of that date.

As of 18th May 2004, of those 4,000 in Madrid Express, WIPO's online database, approximately 2,200 had been logged in the by US Patent and Trademark Office (USPTO). Of those, the vast majority of the applications designating the United States came from Europe, as the chart below shows. The top three sources of those 2,200 inbound applications as of 18th May 2004

were Germany (539), France (274), and Switzerland (244). For comparison, note that during this same time period, over 130,000 new non-International trade mark applications were filed with the USPTO.

What are US companies doing?

Why are so few US companies taking advantage of the Madrid Protocol? We see several reasons.

“brand owners may not want to base their entire international protection on a US application that may fail even after it is registered”

First, the US examination of new applications is relatively rigorous compared with that of many other countries. It is likely, therefore, that an application that may not reach registration in the US will sail

through in other major countries. And even registered US marks are vulnerable to attack from prior common-law users for the first five years, so the central attack provisions of the Madrid system also provide long-term uncertainty.

Therefore, brand owners may not want to base their entire international protection on a US application that may fail even after it is registered. (Perhaps this also explains why there were relatively few (121) inbound applications coming from the UK, which also has a rigorous examination procedure and strong common-law rights.)

Of course, US brand owners may also extend protection under the Madrid Protocol for existing incontestable registrations, but we have found so far that clients already have national registrations in the countries that are of interest and most have not, at least not yet, determined to convert to Madrid even if they may save on renewals later on.

Second, the USPTO requires a narrow identification of goods. As such, basing an International Registration on a US

application precludes the ability to file a broader and more flexible specification than is available, for example, in a Community trade mark (CTM) application.

Third, some of the most important trading partners of the US, such as Canada and Mexico, do not participate in the Madrid Protocol.

Therefore, whenever a client decides to expand a registered US brand internationally for the first time, we look seriously at whether the Madrid Protocol is the best option, but we often find that it is not. Depending on the circumstances, it may be just as beneficial in each client's case to file a CTM application, and then file in some other major markets such as perhaps Japan, Canada and Mexico.

Fourth, US companies who handle their own international portfolio management indicate that a busy in-house counsel or paralegal may simply not yet be comfortable with figuring out the requirements of the Madrid Protocol, which has many traps for the unwary, such as, for example, the restrictions on assignments.

If only a few countries are of interest, it may be faster, simpler, and possibly not much more expensive, for that busy in-house lawyer or paralegal to fire off instructions to foreign associates. Therefore, from a human nature standpoint, there may simply be some inertia due to unfamiliarity with the new system, all other possible disadvantages also being taken into account.

Therefore, those of you who handle European filings for US clients may not see a major drop off in those filings, at least in the near future; but that could change. James Rogan, who was winding up his tenure as Director of the USPTO when the Madrid Protocol was being implemented, is optimistic that it will become more popular with US filers: "During my time as Director, members of the trade mark bar and trade mark filers made clear that they looked forward to the adoption of the Madrid

Protocol. Now that it has been ratified finally, I suspect that people will take greater advantage of it once ease of navigating the rules increases, along with general familiarity with how and when to file. Madrid offers great benefits to US filers; knowing how hard they fought for its implementation, I am sure they will soon take advantage of Madrid's many benefits with much greater frequency."

What are European brand owners doing?

It appears that the major early benefit of the US participation the Madrid Protocol is for non-US brand owners. It is easy to see why the Madrid is more popular for "inbound" applications, such as those from Europe. First, European brand owners are already comfortable with the International Registration process and have probably already consolidated many of their international brands in International Registrations.

Second, while there may be a rigorous examination by the US or attack by a common-law user, this will not jeopardise the International Registration in any other country.

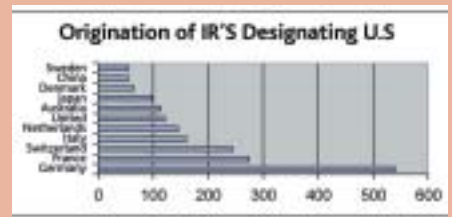
At the Brand Management Forum in London in March this year, I asked a panel of in-house counsel for European brands from a variety of industries how they plan to take advantage of the Madrid Protocol in the US. They all said they would do so as much as possible. They acknowledged they were likely to get an office action that would require US counsel, but they foresaw that the great cost benefit would be at the renewal stage.

Hanne Weywardt, a member of the **MARQUES** Council, and in-house trade mark counsel for Skandinavsk Tobakskompagni, a multinational company headquartered in Denmark, advises: "In our opinion the Madrid Protocol is the natural choice cost-wise as well as from a practical point of view when you deal with world-wide filings or filings in more than three countries.

Popular with Europeans

Therefore, we believe the Madrid Protocol will continue, at least for the short-term, to be more popular with European brand owners than with US brand owners. Given the strong protection afforded to common-law rights in the US, though, we would still recommend that our European clients have US counsel assist with searching before planning actually to use a mark in the US.

Janet Satterthwaite is a partner in the trade mark group of Venable LLP in Washington DC. She wishes to thank Mike Kolpien of NameProtect Inc, for researching the statistics set forth in the article, and Andrew Price of Venable for consultation.



Data correct as of 18th May 2004. Source: NameProtect, Inc

More information on the Madrid Protocol is available at:
<http://www.wipo.int/madrid/en/index.html>

See the USPTO's Madrid Protocol information at:
<http://www.uspto.gov/web/trademarks/madrid/madridindex.htm>

“ We believe the Madrid Protocol will continue, at least for the short-term, to be more popular with European brand owners than with US brand owners”



Where trade mark rights meet free speech

How can brand owners protect their UK trade marks against parody? Nicola Dagg and Emma Alanko of Lovells review the latest case law in the UK and provide some advice for rights owners.



Nicola Dagg



Emma Alanko

*Nicola Dagg is a partner and Emma Alanko is an associate in the intellectual property group of Lovells in London. An extended version of this article is published in the July/August issue of *Managing Intellectual Property* magazine; see www.managingip.com*

Visa for condoms; Intel-Play for construction toys; Eveready for contraceptives: what comfort does UK trade mark law offer when a well known brand is being taken for a ride? This article examines the UK law on tarnishment and blurring with regard to registered trade marks and draws attention to the pertinent lessons to be drawn from case law in the area of trade mark parody.

Tarnishment and blurring in the UK

The concepts of tarnishment or blurring are often referred to together as dilution though they are in fact quite different concepts. Generally, use that gives rise to an unfavourable connotation is referred to as tarnishing, while blurring is taken as meaning use which lessens the attractive powers of a mark. For example, in *DaimlerChrysler AG v Alavi (t/a Merc)* Mr Justice Pumfrey stated: "Detriment can take the form either of making the mark less attractive (tarnishing) or less distinctive (blurring)."

In the UK, a trade mark owner wishing to defend his mark against dilution will base his case on section 10(3) of the Trade Marks Act 1994. This section enacted Article 5(2) of the Trade Marks Directive 89/104/EEC. The test for section 10(3) can be broken down into the following requirements:

- 1) the claimant's trade mark has a reputation in the UK;
- 2) identity with or similarity to the trade mark of repute must be shown;
- 3) the use of the sign complained of must take unfair advantage of, or cause detriment to, the distinctive character or repute of the claimant's trade mark;
- 4) the use of the sign complained of must be without due cause.

A storm in a teacup?

In the UK, the most recent full judicial statement of the law on tarnishment and blurring is also the first reported case on section 10(3): *Premier Brands UK Ltd v Typhoon Europe Ltd* ([2000] All ER (D) 52) in which judgment was handed down on 21st January 02.

This case concerned the tea supplier Premier Brands, whose trade mark TY.PHOO was (and continues to be) one of the best-known brands of tea in the UK. The three registered trade marks in suit were all in respect of the word-only mark TY.PHOO, which had been used in relation not only to tea, but also on tea canisters, tea pots, etc, all as a means of promoting tea sales. When Premier Brands learnt of Typhoon Europe's use of TYPHOON for a range of kitchen houseware, it brought an action alleging trade mark infringement under section 10(3). Premier Brands claimed that Typhoon Europe's use of the TYPHOON sign:

- 1) caused detriment to the distinctive character or repute of the TY.PHOO trade mark because it would lead to blurring, thus reducing the uniqueness of the TY.PHOO brand name in the kitchen; and
- 2) would lead to tarnishing of the TY.PHOO brand image, because of its association with the destructive power of tropical cyclones.

Ultimately, Premier Brands failed to convince the judge, Mr Justice Neuberger, with these arguments. Although Typhoon Europe had not adopted the TYPHOON trade name with any good cause, in the eyes of the law no damage had been caused to the reputation of Premier Brands.

“Neither statute nor case law in the UK suggest that it is unlawful to play on a mark with a reputation to comic effect”

Although the court fell short of requiring proof of likelihood of confusion, it found that something further than mere association – namely unfair advantage or detriment – had to be shown. Perhaps because the concepts of unfair advantage and detriment are so new in the UK, the court turned to German case law and US statute for assistance in defining them. Essentially, a UK court is likely to find that there has been “unfair advantage” taken in situations where there has been parasitic use of a trade mark of repute: the offending mark “rides on its back” or captures part of the other mark's goodwill.

Is detrimental to

In order to define this concept, Neuberger J in *Typhoon* noted the statements of the German Federal Supreme Court in *Quick* ([1959] GRUR 182):

[T]he owner of ... a distinctive mark has a legitimate interest in continuing to maintain the position of exclusivity he acquired through large expenditures of time and money and that everything which could impair the originality and distinctive character of his distinctive mark, as well as the advertising effectiveness derived from its uniqueness, is to be avoided ... Its basic purpose is not to prevent any form of confusion but to protect an acquired asset against impairment.

The choice of this quotation illustrates the UK courts' sensitivity to the concept of exclusivity – a quality which will be eroded if a trade mark is allowed to be used without limitation by third parties.

In view of Neuberger J's line of reasoning in *Typhoon*, it is likely that if called upon to consider in detail the concept of dilution again in the future, a UK court would take inspiration from other countries.

Since *Typhoon*, European case law (*Fitnessworld* [Case C-408/01]) has confirmed the fact that likelihood of confusion is not a requirement for pleading trade mark infringement under section 10(3).

Proving detriment in the absence of actual confusion does, of course, pose practical challenges of its own: in *DaimlerChrysler v Alavi* (MERC) ([2001] All ER (D) 189 (Jan)), the High Court was unwilling to find detriment simply because Mercedes' mark MERC was used in connection with a business heavily concerned with Mods, Skinheads and Casuals. In Pumfrey J's view, DaimlerChrysler needed to demonstrate that the relevant public made a connection between the famous Merc mark, and the alleged disparaging use. In effect, DaimlerChrysler would have had to prove that as a result of the use of the MERC mark by the defendant, the public connected DaimlerChrysler with skinhead culture.

Trade marks and freedom of expression

Neither statute nor case law in the UK suggest that it is unlawful to play on a mark with a reputation to comic effect

The Trade Mark Act does not make a specific provision for parody, either as an unlawful act or as a defence to trade mark infringement. In the absence of proof of confusion, a trade mark owner will therefore be obliged to rely on section 10(3) and to adduce solid proof of unfair advantage or detriment.

If a brand owner were to bring an action for trade mark infringement to stop parodic use of its trade mark, it is likely that the parodist would allege that the trade mark has been used with "due cause" (section 10(3)). "Due cause" may in the future provide a public interest based defence for parody, perhaps introducing a concept of "freedom of expression" into UK trade mark law.

As international brands go on to assume greater cultural significance, and take on iconic roles that extend beyond pure indication of origin, it is likely that brand owners will look deeper into the possible forms of redress under trade mark law. It remains to be seen whether UK judges will display a tendency – like their

French, German and US neighbours – to fall on the side of freedom of expression.

Glossary

Dilution:	the concepts of tarnishment and blurring are often referred to together as dilution though they are in fact different concepts
Tarnishing:	use that gives rise to an unfavourable connotation
Blurring:	use that lessens the attractive powers, or distinctiveness, of a mark
Reputation:	the earlier trade mark is known by a significant part of the public concerned by the products or services covered by that trade mark

Section 10(3) of the Trade Mark Act

Section 10(3) (as recently amended in the Trade Marks, Proof of Use etc Regulations 2004) provides that:

- 1) A person infringes a registered trade mark if he uses in the course of trade in relation to goods or services a sign which—
 - a) is identical with or similar to the trade mark,

... where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

“It is likely that if called upon to consider in detail the concept of dilution again in the future, a UK court would take inspiration from other countries”

Formal Notice of Annual General Meeting of the Association 2004

In accordance with the rules of the Association, all Ordinary (full voting) Members are hereby formally advised that the Annual General Meeting of MARQUES will be held on Friday, 17th September 2004 in the Hilton Cavalieri Hotel, Rome, Italy starting at 0930 hrs.

The Meeting will receive the audited accounts for the year ended 31st March 2004, appoint auditors for the year to 31st March 2005, and receive confirmation of the results of the annual electoral processes for Council membership.

Under current rules, one half (5/10) of the Special Members and one third (5/15) of the Ordinary Members currently serving on Council are required to retire each year by rotation but may offer themselves for re-election. In accordance with this rule, the following vacancies are created this year:

Ordinary Members: Nunzia Varricchio (Belgium), Danielle Le Carval (France) and Hanne Weywardt (Denmark).

There are, in addition, two vacancies created by the resignations (16/9/2003) of Anouk von Meyenfeldt (Netherlands) and Isabel de Minvielle Devaux (UK).

Special Members: David Goldring (UK), Kay-Uwe Jonas (Germany), Shane Smyth (Ireland), Paul Steinhauser (Netherlands) and Carles Prat (Spain).

In addition, the following Ordinary Members, who were appointed to the Council subsequent to the 2003 Annual General Meeting, require their appointments to be formally confirmed by the AGM: Lena Borg (Sweden), Maria Falk (Sweden), Carlo Imo (Italy), Ana Pallares Casado (Spain), Susanne Skov Nilsson (Denmark) and Dieuwerke van der Schalk (Netherlands). The following Special Members also require their appointments to be formally confirmed: Knud Wallberg (Denmark) and Nick Wood (UK).

Council may be composed of up to 40 members with not more than 6 from any individual European country, not more

than 6 drawn from countries outside of Europe and not more than 14 Special Members. Except where indicated, all those due to retire have confirmed their intention to offer themselves for re-election. The nomination of candidates in excess of the declared number of vacancies in either category would require MARQUES to organise a postal ballot of all Ordinary Members to select candidates to fill the available places. Should such need arise, the process will be conducted under the direction of the Company Secretary who will announce the results at the AGM.

Nomination Forms, which are available on request from the Secretariat, should be completed and returned to the Secretary General by not later than 1700 hrs (BST) on Friday, 20th August 2004.

By Order of the Council
Robert Seager
Company Secretary
1st July 2004

Professional services: the last piece in the harmonisation jigsaw?

Jeremy Phillips and Ilanah Simon discuss whether harmonisation of law and practice in the EU should be complemented by the harmonisation of professional standards among trade mark practitioners.



Ilanah Simon



Jeremy Phillips

Harmonisation of trade mark law and practice within the European Union has raced on apace. What can be registered, what grounds exist for refusing registration, what constitutes infringement, what defences can be argued against infringement? These and other issues have been brought to the point at which a trade mark owner or applicant now knows pretty well what the strengths and weaknesses of his trade marks are in every country within the new, harmonised Europe.

There is however one area in which harmonisation seems a long way off, perhaps because of the delicate political considerations that attend it: that is the harmonisation of the standards, the training and the responsibilities of trade mark practitioners themselves. But is this something that trade mark owners should worry about? Arguably, yes.

Qualification by examination

The position of the trade mark practitioner can be contrasted with that of the patent attorney. The European Patent Office (EPO), in conjunction with the Institute of Professional Representatives before the EPO (epi), conducts a European Qualifying Examination for patent attorneys who wish to practise before the Office. There is no clear equivalent examination for trade mark attorneys who practise before the Office for Harmonisation in the Internal Market (OHIM).

The need for trade mark practitioners to be suitably qualified for their calling has been widely accepted. But OHIM – whether it has the resources and the know-how or not – has not been given a mandate to go beyond its current role. This role is simply to maintain a register of practitioners who, through qualification or experience, have been regarded as possessing the requisite skills by the appropriate national authorities of the EU Member States from which they come. Inevitably, standards are likely to be assessed differently in the various Member States, which may deter a CTM applicant from selecting a representative from the OHIM-maintained list without making further prudent enquiries.

Training

There is no single set of criteria which must be fulfilled in terms of the training of trade mark professionals. In theory it may be easy to list criteria based on either the length of time spent in acquiring the

necessary skills or the number of trade mark applications, oppositions and the like, but local considerations will affect the fulfilment of those criteria. For example, there is no correlation between length of time spent being trained and the amount of experience gained from training. It is always easier to acquire valuable experience when working with a large and well-resourced firm of specialist trade mark practitioners in a high-filing jurisdiction, but more difficult where client work in the field of trade marks must be supplemented by a diet of other legal or paralegal work in related or even unrelated areas. If training criteria are to be established, they must work for those who learn their craft in regions where the volume of trade mark client work is low as well as for those who practise in busy centres such as London, Munich, Amsterdam or Milan.

How much law?

Some trade mark practitioners are also fully-qualified lawyers within their jurisdictions. Others practise as patent agents and are therefore qualified to deal on a regular basis with related fields of intellectual property such as design protection and copyright. Others again have no real expertise or qualifications outside the field of trade marks.

“There is no single set of criteria which must be fulfilled in terms of the training of trade mark professionals”

This observation is important when you consider the needs of a business that wants to register, enforce or exploit a trade mark. Some client work – such as prosecution and opposition – is exclusively trade mark based. Other client work overlaps with other disciplines. For example, licensing a trade mark is a matter not just of trade mark law but also of contract law; setting up distribution agreements is not just trade mark law but competition law, and so on. Then there are areas such as litigation and alternative dispute resolution, which may hinge upon a trade mark but depend on skills that in areas which are distant from basic trade mark law. Other distant but important areas are those of tax planning and brand valuation, which are highly specialist and do not fall within the competence of most regular trade mark practitioners at all.

This raises two questions: (1) how much law other than trade mark law does a trade mark practitioner need to know and (2) how easily can a client business identify the limits of a practitioner's competence before deciding whether to instruct him? Both of these questions are sensitive, but important. If there is no single area of competence that is covered by the skills of trade mark professions, it is important for clients – from whom **MARQUES** members are drawn – to be able to make an informed decision as to who they instruct and for what purposes.

Professional responsibilities

It is not just in terms of professional competence that the harmonisation or standardisation of the practitioners' role should be considered. Clients are entitled to ask not just “what can this practitioner do?” but also “what should he or she do?” and “what

is my legal position if he or she fails to do it?" Thus the issues of professional ethics and liability for failure to deliver the service required must also be raised.

At present there is no single ethical or legal code for Europe's trade mark practitioners. Thus issues such as conflicts of interest (where a practitioner continues to act for parties whose interests are actually or potentially incompatible), client confidentiality, immunity from having to divulge privileged communications and malpractice insurance fall to be determined at national level. The variation between the level of professional responsibility demanded locally in each jurisdiction is unlikely to be the sole determinant of a decision to instruct a professional representative in one country rather than in another, but it may nonetheless prove to be decisive in determining whether a client receives satisfaction from his adviser.

Has the case been made out?

It is unlikely that Europe's trade mark practitioners will welcome any demands that they should be qualified via a common standard of training and examination. They will point out that, while there may be disparities between the degree of experience or professional knowledge between different countries, the system works on the whole very well and modern practitioners have come to grips with more radical changes in the last few years than many other people may see in a lifetime: the introduction of CTM and Madrid Protocol filings, the new yardstick of TRIPs,

the unification of Germany and the enlargement of the European Union, the birth and early maturity of the internet as a search tool and as a channel of communication via email, the rise of cybersquatting, metatags and other forms of invisible infringement, not to mention new institutions such as the Community trade mark courts and the reference and appeal mechanisms of the European Court of Justice and Court of First Instance.

Given the manner in which the modern European profession has faced these changes and guided clients through them, the profession may argue that the case for standardising its training and qualification procedures is yet to be made out. However, much the same sort of changes have been faced by patent practitioners and there is now little clamour within that profession for a relaxation of the notion that common professional standards have been of benefit to it.

The future

It is impossible to predict the manner in which the regulation of legal and paralegal services in the European Union will shape the future provision of trade mark-related professional services. It is however unreasonable to expect businesses to select their advisers (and the jurisdiction that governs the client-adviser relationship) on the basis of trial-and-error alone. Trade mark owners and their competitors are entitled to expect and rely upon a level of service that is efficient, cost-effective and adequate for their needs. If that level has

already been attained, well and good; but, if it has not, then it is right and proper that organisations such as **MARQUES** articulate their members' demands and press the case for realistic, coherent and harmonised standards for their professional advisers throughout the European Union.

Do you agree with this article? If you have ancomment on any of the issues raised, or would like to write a response, please write to editor@marques.org

“Trade mark owners and their competitors are entitled to expect and rely upon a level of service that is efficient, cost-effective and adequate for their needs”

MARQUES Needs You!

Several of the MARQUES Project Teams are seeking members (particularly from brand owners) to join their teams and take part in the formation of policies and engage in discussions and lobbying activities.

The teams include:

Anti-Counterfeiting & Parallel Trade Team: Investigations, regional issues, trade secrets, parallel imports/exhaustion.

Geographical Indications Team: To monitor and influence legislative and any other developments in the area of Geographical Indications and Designations of Origin

Infringement Team: Regional issues, look-alikes, own labels, innovation, code of conduct, ethics, trademark councils

IP Outer Borders Team: Social responsibility of IP, how much IP do we need, negative points/abuses,

managing the IP power, intellectual property or monopoly privilege, ethical responsibility of owners, managers and creators, creating and exploiting IP.

Education Team

Studies, scholarships, Lewis Gaze memorial scholarships, seminars, in-house "stages".

Design Team

Protection, Management, Tax Issues, Filings, Legal, Renewals, Designs vs. 3-D marks

Programming Team

To facilitate the education and promotion of the profession development of brand owners, all within the mission statement of MARQUES, through developing the professional programme for conferences, including the annual conference, seminars and other meetings for the members of MARQUES and thus co-operate with the other MARQUES-teams to also provide

these teams with a form for the free exchange of ideas and information.

If you are willing and able to add your voice and expertise to any of these teams please contact a Team member (contact details are shown in the "Teams & Committees" area of the MARQUES website (<http://www.marques.org/>) or alternatively contact:

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E-mail:
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MARQUES
THE ASSOCIATION OF EUROPEAN TRADE MARK OWNERS

All roads lead to Rome

This year's **MARQUES** Annual Conference takes place in Rome from 14th to 16th September. The focus will be on territorial issues affecting brands and brand owners.

The 18th **MARQUES** Annual Conference this September will feature a number of topical themed sessions on territorial issues. The programme has been designed by the Rome committee to feature some familiar issues – and a few unexpected ones.

Massimo Sterpi, chair of the Rome team, has been planning the Annual Meeting for over a year. He says: "We are looking at brands and territorial issues, and we found all the subjects that could fit into that general idea. Some issues are not that common at a trade mark conference."

One focus of attention will be the new trend for GLOCAL brands: panels of marketing and business people, including representatives from Gucci, Unilever and Tiscali, will discuss the challenges of adapting brands to local communities.

Another session will focus on the latest developments regarding denominations of origin. And there will be discussion of issues relating to transliteration of brands, and how to maintain the brand message in different languages.

More unusual subjects covered include the increasingly important "Made in..." issue and

the relationship between brands and local communities. This subject will be examined with a case study of the City of Venice, which has used its international brand to raise money for restoration works in the city.

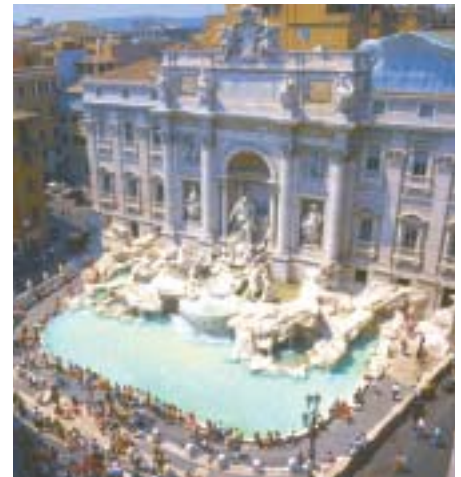
In total, there will be almost 40 speakers including the Italian Minister of Productive Activities, who will open the conference.

As well as a busy educational programme, there will also be social opportunities including a rare opportunity to have a private view of the Sistine Chapel.

And, to reinforce the territorial theme of the conference, the meals will all reflect Italian regional cuisine – so there will be food and drink from areas such as Tuscany, Sicily and Piedmont. "This will allow attendees to have the full physical experience of Italy," says Sterpi.

For details about the **MARQUES** Annual General Meeting, to be held during the conference, see page 7.

To register for the conference, visit www.marques.org



Introducing: the **MARQUES** Newsletter correspondents

Continuing our series of introductions to the people behind **MARQUES**



CANADA
Andrea Rush
Heenan Blaikie

Andrea Rush is a partner of Heenan Blaikie in Toronto and also vice-president and a member of the Board of Directors of the Association Littéraire et artistique internationale. She is a trustee of the Copyright Society of the USA and publishes and lectures on IP and technology law in Canada and the US.



NETHERLANDS
Bas Kist
Shield Mark BV

Bas Kist is partner and co-director of Shield Mark, a trade mark office in Amsterdam with 50 employees. He has specialised in trade marks since 1990. He regularly publishes articles on trade mark 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 Fiascos* (1998).



EUROPE-OHIM
Joanna Gray
Linklaters, Alicante

Joanna Gray is the managing associate of Linklaters, Alicante. She is a qualified English solicitor. She qualified into Linklaters intellectual property department in 1997; and was seconded to the BBC for a period to assist with its trade mark work in 1999. Since 2000, Joanna has been running the Linklaters Alicante office, specialising in all aspects of Community trade mark and design work (including appeals before the European Court in Luxembourg) and maintaining close contact with officials at the Community Registry (OHIM).



ROMANIA
Andrew Ratza
Ratza & Ratza

Andrew Ratza is a partner of Ratza & Ratza in Bucharest, which was founded in 2003. He provides both prosecution and general legal services in the IP area, and has written on developments in Romanian IP law. He co-authored the article "A New Era in the Romanian IP Field" in issue number 78 of the **MARQUES** Newsletter.



GERMANY
Thomas Raab
Taylor Wessing

Thomas is a partner in the IP department of Taylor Wessing. Based in Munich, he is head of Taylor Wessing's German trade mark group. With more than 15 years of experience in the field of IP, Thomas specialises in all legal aspects of trade marks, company names, domain names as well as advertising, trade dress and designs. Thomas is author or co-author of various German and international publications in the fields of trade mark, design and internet law. He is a regular speaker at conferences dealing with trade mark law topics.



SOUTH AFRICA
André van der Merwe
DM Kisch Incorporated

André van der Merwe has a degree in chemistry from the University of Pretoria (1965) and worked for seven years in the glass and steel industries. He was admitted as an attorney of the High Court of South Africa in 1975 and as a patent agent in 1977. He is a council member of the SA Institute of Intellectual Property Law, past president of the Environmental Law Association of South Africa and current president of LES South Africa. He specializes in trade mark prosecution and litigation, as well as litigation relating to copyright and unlawful competition.



UNITED STATES
Janet Satterthwaite
Venable

Janet Satterthwaite is a partner in the trade mark group of Venable LLP in Washington DC. She handles trade mark prosecution, litigation, counselling, and licensing, and also specialises in worldwide domain name dispute and registration strategies and internet fraud. She studied at the University of Virginia, Cambridge University and Yale University, and is admitted to the bar in Virginia, Washington and the District of Columbia. She has written a number of articles including "Intellectual Property Law Considerations in Indian Gaming," in the Native American Law Digest.

MEXICO
Carlos De la Sierra
Calderon y De la Sierra y Cia SC
Carlos De la Sierra is a partner of Calderon y De la Sierra y Cia SC in Mexico City. He specialises in intellectual property.

If you are interested in becoming a correspondent for the **MARQUES** Newsletter, please contact the editor or speak to a member of the Publication and Website team.

Call for Articles

Correspondents and "Letters to the Editor"

The MARQUES Newsletter is an ideal vehicle for communicating your news, your ideas, your opinions or your vision of where trade mark law is or should be heading. It will be seen and read by in-house counsel, trade mark practitioners, IP lawyers, academics, government officials and other NGOs. We are also actively seeking volunteer "Correspondents" from every country to advise MARQUES members of recent or proposed changes to the laws of practice within their jurisdiction. We are conscious that English is not the first language of every member but the Editor will be

pleased to check any article for mistakes of grammar or spelling etc. Finally, if you disagree with or have any comment to make about any article in the Newsletter, please write to the Editor. This, after all is YOUR Newsletter and gives you an opportunity to communicate with all MARQUES members. Please send any contribution to: editor@marques.org

The Editor MARQUES Newsletter, 840 Melton Road, Thurmaston, Leicester. LE4 8BN, United Kingdom,

The Council 2004

Full details of the Chairman and member of each active and formative **MARQUES** Project Team can be found at: www.marques.org/teams

Chairman: **Tove Graulund** (Denmark)

Vice Chairmen: **Jane Collins** (Switzerland)
Nunzia Varricchio (Belgium)

Treasurer: **David Goldring** (UK)

Lena Borg (Sweden)
David Crawford (UK)
Hans-Friedrich Czekay (Switzerland)
Maria Falk (Sweden)
Nicholas Foot (UK)
Carlo Imó (Italy)
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Kay-Uwe Jonas (Germany)
Danielle Le Carval (France)
Susanne Skov Nilsson (Denmark)
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Bruce N Procter (UK)
Shane Smyth (Ireland)
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Massimo Sterpi (Italy)
Eva Szigeti (Hungary)
Virginia Taylor (USA)
Dieuwerke van der Schalk (The Netherlands)
Knud Wallberg (Denmark)
Hanne Weywardt (Denmark)
Nick Wood (UK)

Development Executive:
Ingrid de Groot (The Netherlands)

Company Secretary:
Robert Seager (UK)

NOTE: Council is composed of up to 40 members with not more than six from any individual country, not more than six drawn from outside of Europe and not more than 14 Special Members.

One half of Special Members and one third of Ordinary Members retire, by rotation, each year but may offer themselves for re-election.

Disclaimer

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