

# Team members provide update on **MARQUES** activities

The **MARQUES** Council and Team members gathered in the Hilton Malta on 24 and 25 February to report on the association's activities and plan future events.

The Malta meeting was the second annual gathering of the Council members and representatives of the 12 teams who work on various aspects of organisation and policy. More than 85 **MARQUES** members were present to hear about the wide range of work undertaken by team members in both the running of the organisation and more generally in working on current trade mark and related matters.

The Hilton Hotel, situated in St Julians, near Malta's capital Valletta, will host the **MARQUES** Annual Conference in 2006 and Team members had an opportunity to inspect the facilities, as well as some of the other attractions in the country – which is one of the EU's newest Member States.

## Team activities

Representatives from each Team gave brief presentations on their work. On behalf of the Anti-Counterfeiting Team, Hans-Friedrich Czekay spoke about the events that Team members had attended, notably an enforcement committee in Geneva in June 2004 and talks between the EU and China in October 2004. Other issues the Team is following include customs operations and the liability of internet service providers.

The Anti-Counterfeiting Team is focused on building contacts with other associations,

such as the World Customs Organisation, Anti-Counterfeiting Group and the Global Business Leaders Alliance Against Counterfeiting.

David Crawford reported that the Cyberspace Team is following closely the launch of the new .eu domain, and in particular the problematic primary legislation put forward by the European Commission, which leaves concepts such as speculative registrations undefined. Team chair Egon Engin-Deniz met EURid, the .eu administrators, in February this year. When more details are available on the .eu launch, **MARQUES** will organise a series of seminars to raise awareness among trade mark owners in Europe.

Another issue the Cyberspace Team is looking into is Whois? Records and ICANN's reform proposals. The Team's Nick Wood is developing a gTLD guide and Sylvain Hirsch hopes to be able to offer a complimentary search to all **MARQUES** members.

On behalf of the Education Team, Daan Teeuwissen said work was underway on the annual Lewis Gaze memorial scholarship, to be presented in Prague, and that some thought has been given to refreshing the procedure. The Team is also working with WIPO regarding providing general information on IP issues and also with



*This article is continued on page 2...*

## Contents:

Design team launched	2
Counterfeiters to pay \$594m	3
<b>MARQUES</b> unveils new database	3
A guide to Community trade mark courts	4-5
ICANN tackles the Whois issue	6-7
How to protect product short-term marks	8-9
How to protect famous names in Turkey	10
<b>MARQUES</b> team news	11

OHIM and the University of Alicante.

The Education Team is also compiling a list of manuals and handbooks of use to members, which will be posted on the **MARQUES** website in due course. It will also be represented at the EADA Institute meeting in Barcelona in April.

### GI database

The Geographical Indications Team has had a very productive year, compiling a database on GIs in Europe – covering all bilateral and multilateral agreements, EU and national legislation. This database is expected to be published and available on the **MARQUES** website by 1st July.

Ben Goodger, chair of the newly-launched IAM Team, introduced the Team's members and explained that they would be looking into the role of brands in business and promoting IP awareness among company directors and CEOs. The Team has a number of initiatives under way which will develop later this year.

Massimo Sterpi of the IP Outer Borders Team explained how his Team will continue to look into the issues surrounding IP rights. In particular, the Team will focus on trade marks and sociology, and trade marks and emotions.

The Trade Mark Team has also set up two sub-teams to work on, respectively, WIPO and OHIM issues. The WIPO sub-team has been consulted by WIPO on proposed revisions to the Madrid Protocol, and will raise issues of concern to trade mark owners, while the OHIM Team is represented



at users' meetings and presents the views of trade mark owners on issues such as the proposed changes to the Fee Regulation and classification.

### Look-alike questionnaire

Till Lampel of the Unfair Competition Team announced the launch of a questionnaire on look-alikes, to be presented in a session at the **MARQUES** annual conference in September. The Team is researching the protection against look-alikes in the EU Member States and will consider whether to propose that the EC legislate in this area with a European unfair competition law.

For the Programming Team, William Leppink outlined the planned programme for the

Prague meeting in September 2005, and also indicated a number of other possibilities for hosting meetings. There is also a formal visit to the European Court of Justice planned for June 2005.

In addition, the Promotion and Membership Team suggested some new ways of invigorating the **MARQUES** membership, while the Publications Team revealed the latest developments with the website and newsletter.

### Links:

More information about all the Teams' activities is available on the **MARQUES** website: <http://www.marques.org/>

# Design Team launched

**MARQUES** is to set up a new Team looking at design rights. The Team, which is to be chaired by Sven Klos, of Klos, Morel, Vos & Schaap in Amsterdam, will meet for the first time at the annual conference in Prague in September.

Klos says the Team will focus on developments with the Community Design Regulation and Directive. "In theory there is harmonization but in practice it will be a long time before there are clear guidelines from the ECJ on issues such as the exclusion of functional designs. Practice and case law is only just developing." It will analyse developments regarding both national and Community registered designs, as well as unregistered design rights.

The Team will also help raise awareness in industry about the possibilities of design protection. "We've seen a lot of instances especially with the unregistered design, which can be an excellent alternative to trade mark protection, for example in the fashion industry." Designs are popular among applicants seeking quick protection which they can use to enforce their rights.

The Team will also work closely with OHIM's Designs Department which is developing its own case law, especially on invalidity. OHIM has already received applications for more than 100,000 designs, 95% of which have been registered. By the end of March, 18 decisions had been published on invalidity.

Any members interested in finding out more about the Design Team can write to Sven Klos at [sven.klos@kmvs.nl](mailto:sven.klos@kmvs.nl)

# US judge orders counterfeiters to pay \$594 million

Cartier, the internationally renowned luxury brand, has obtained an important judgment against counterfeiters doing business in the Chinatown area of New York City. According to a judgment issued by District Court Judge Thomas Griesa of the Southern District of New York on 21st December 2004, each of the 33 named defendants were ordered to pay Cartier the sum of \$18 million in statutory damages, for a grand total of \$594 million, as well as reimbursement of legal fees.

The case was the culmination of several years of investigative effort by Cartier directed towards the trade in counterfeit watches in New York. In an earlier contempt judgment against one of the principal defendants, the same judge had already awarded damages of \$4.85 million in favour of Cartier.

The contempt judgment and final decision are perhaps among the highest awards ever granted in the context of a trade mark counterfeiting case anywhere in the world. Cartier believes that through this case it has been able to dismantle a major operation that was the dominant player in the importation into the US of counterfeit watches, and their subsequent distribution within the country as well as via the internet.

Is there a realistic chance of having the contempt and final judgments enforced? Cartier certainly intends to try, based on its firm belief that to put counterfeiters out of business it is essential to tackle them where it hurts the most: financially. The defendants in this case, Cartier was able to demonstrate in the course of documents provided to the court, had turned over huge sums of money through the counterfeit watch business, the profits of which were, for the most part, repatriated to China and other countries in the Far East.

*Report provided by Bharat Dube, Senior Counsel and Head of Enforcement, Cartier, Geneva*



“ To put counterfeiters out of business it is essential to tackle them where it hurts the most: financially ”

## MARQUES to unveil new GI database

The Geographical Indications and Designations of Origin Team has existed for more than a year. One of the more time-consuming tasks that the Team has assumed is the preparation of a database on the protection of GIs in Europe, covering EU Regulations, bilateral and multilateral agreements and national regulations.

The database is not limited to the European Union but also includes European countries outside the EU (Switzerland, Norway, Turkey, and many Eastern Europe countries). The Team's goal is to provide MARQUES members with an efficient tool enabling them to get to the relevant provisions by a couple of mouse clicks. The database will also have a bibliography on the protection of GIs (articles, monographies, reports etc), a list of important case law and a section

including useful links to for example organisations dealing with the protection of GIs.

In the coming weeks, the national sections will be verified by national experts, many of them MARQUES members. The Team expects to set up the database on the MARQUES website by 1st July 2005.

*Report provided by Susie Staerk Ekstrand, Team chair*

# A guide to Community trade mark courts

Jeremy Phillips and Ilanah Simon explain what the CTM courts are and consider how potential problems will be dealt with.

The Community trade mark (CTM) was founded upon three planks: a single trade mark to cover the entire territory of the European Union, a single office to examine and grant CTMs and a set of specially designated national courts before which CTMs could be enforced and their validity challenged.

The notion of a single trade mark has become well established in the past 10 years – a short span of time in European history – and, after some initial misgivings, OHIM too has come to occupy a focal role in European trade mark practice. But what of the special CTM courts?

## The CTM courts

Each EU Member State has to nominate two tiers of courts within its jurisdiction that are to handle CTM cases, the first level being trial courts, the second being appellate courts. However, at the time of writing, the following Member States have yet to do so: Cyprus, Hungary, Latvia, Malta, Poland and Slovakia. The range of courts nominated by each Member State varies considerably. Germany, where trade mark infringement is a matter of jurisdiction for the *Länder* rather than for the Federal courts, has 18 CTM trial courts and a further 18 appellate courts; Italy is not far behind, with 12 regional trial courts and corresponding appellate tribunals. In the United Kingdom, the High Courts of England and Wales and Northern Ireland are listed along with the Court of Session in Scotland (which possesses its own legal system and many of its own laws).

It is difficult to gauge with accuracy how many CTMs are litigated in national courts, since there is no legal duty on the part of Member States either to record such cases or to report them to any agency charged with collating CTM litigation statistics. Although the first CTM applications were received in April 1996 and registrations have been granted at a steadily increasing rate since that time, the OHIM website at the time of writing this article records just

44 cases involving CTMs as having been decided in national courts, a figure which is almost certainly a gross understatement of the number of disputes involving CTMs that have been resolved at national level.

## Opportunities and problems

From the point of view of most European trade mark proprietors, the designation of certain national courts as CTM is not a big issue. If you're suing a counterfeiter or trying to prevent an imminent infringement from occurring, it may be a matter of chance whether the infringed mark is a national trade mark rather than a CTM. Also, since trade mark owners want certainty and predictability from an enforcing court, not exotic forays into transcendental jurisprudence, some of the more esoteric and problematic areas of the interface between issues such as enforcement and cancellation at the Community and national level may pass them by.

If there are any major problem areas, we suspect that (i) they are at the level of theoretical problems that are easily solved in practice or (ii) they are in the form of accidents waiting to happen, or (iii) they are really well-kept secrets. Why do we say this? Because a survey of the extensive literature of Community trade marks seems to suggest that CTM owners and their adversaries are coping with the CTM courts very well. Subject to any special provisions of Regulation 40/94 itself, designated courts apply their own local law to CTM disputes in the same way as they would to disputes concerning national trade marks. This means that any complaints that users have about CTM courts are likely to be the result of national law, not Community law.

That's not to say that there are not some fascinating problems and scenarios awaiting treatment. How many **MARQUES** members know what to do where, for example, the same CTM dispute is the subject of litigation in two or more Community trade mark courts and:

- One court rules that a batch of trade marked goods has been placed on the market by the trade mark proprietor or with his consent, while a second court rules that other goods from that same batch have not been so emplaced;
- One court holds a CTM to be valid and infringed, while another holds that it should not have been registered and cancels it;
- One court grants pan-European injunctive relief in order to protect the owner of a CTM application that has not yet proceeded to grant, since it provides similar relief in respect of its own national trade mark applications, while another rules that such relief is not available;
- One court rules that a CTM is owned by the alleged proprietor, while a court in another country decides that the CTM has been registered by the named proprietor as an agent on behalf of a third party;
- One court, applying the principles adopted within its own jurisdiction, rules that a CTM is contrary to standards of ordre public or morality, while another country takes the opposite view.

Discerning readers will spot that these problems are all variations on the same simple theme – but that doesn't mean that the solution is the same in each case. And there are also plenty of more subtle issues to play with: forum-shopping, enforcement issues, submarines and torpedoes, differentials in scales of costs and principles for calculating damages, to name but a few.

“ A survey of the extensive literature of Community trade marks seems to suggest that CTM owners and their adversaries are coping with the CTM courts very well. ”



“ Issues such as the composition of the court and the rules by which it operates are ultimately determined by a variety of complex issues spanning the diplomatic, the politically acceptable, the financially viable and the technically efficient. ”

#### Differences are inevitable

MARQUES has always expressed the needs and preferences of its members in debates as to what a Community trade mark court system should be able to do. However, issues such as the composition of the court and the rules by which it operates are ultimately determined by a variety of complex issues. These span the diplomatic, the politically acceptable, the financially viable and the technically efficient. We are fortunate if we can at least keep our concentration on just one thing and stick to it: that is the need to ensure that justice is convenient and accessible while at the same time we can enjoy a degree of uniformity in the standard of judicial decision-making. If these two ends are achieved, we will all be the winners. Differences between the rulings of Community trade mark courts are inevitable and they may not all be capable of being removed by rulings of the European Court of Justice – but is this not a small price to pay for having courts that can deal with CTM disputes in different languages and locations?


Jeremy Phillips and Ilanah Simon are members of the MARQUES Publication and Website team. They have recently edited a new book, entitled Trade Mark Use, which is published by Oxford University Press.

More information on the CTM courts, including a full list, is available here: <http://oami.eu.int/en/mark/aspects/default.htm>

Decisions are available here: <http://oami.eu.int/en/mark/aspects/ctmcourt.htm>







Jeremy Phillips and Ilanah Simon with their new book



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

## BOHEMIAN RHAPSODY— WHAT'S BREWING?

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



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

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# ICANN tackles the Whois issue

Ken Taylor of Marksmen, and a member of the **MARQUES** Cyberspace Team, examines ICANN's attempts to bring order to Whois domain name information, and explains how rights owners can help improve the system.

If you are a domain name registrant, and have owned your domain name for at least one year, you should have received notice (most likely via email) from your registrar asking you to examine the Whois information you have on record for each domain name you own to make sure it is accurate. You received this notice because, on 31st October 2003, all ICANN-accredited registrars were obligated to comply with the new "Whois Data Reminder Policy" (WDRP). The WDRP, which was adopted as consensus policy by the ICANN board of directors on 27th March 2003, is intended to be an additional step towards improving Whois data accuracy. As noted above, the policy requires that a registrar present current Whois information to each registrant, at least annually, and remind the registrant that the provision of false data can be grounds for cancellation of a registration. Registrants must review their Whois data and make any necessary corrections. All of these actions are ICANN requirements.

## The ICANN report

On 30th November 2004, ICANN published a report on the implementation of the WDRP (and will do so annually thereafter) in accordance with Amendment 6 to the ICANN/DOC Memorandum of Understanding. In the report, ICANN stated that it used a variety of means to assess WDRP implementation but in actuality relied heavily on their "Whois Data Reminder Policy Survey and Compliance Audit" sent to all 364 ICANN-accredited registrars in October 2004.

However, only 254 or 70% of the 364 ICANN-accredited registrars responded to the survey. ICANN states in the report that this is a very high response rate "for an unsolicited survey" and then provides varying statistics on how effective the WDRP is

impacting accurate Whois data. It is troubling to note however, that of the 254 registrars that responded, 171 sponsor less than 1000 domain names each (or a maximum of 171,000 domain names). It is particularly troubling that one third of the top 15 registrars (representing the collective sponsorship of 23.3 million domains) did not respond to the survey and compliance audit. The sponsorship of millions of domain names is not represented in the survey and compliance audit report.

ICANN mentions in the report that it has taken several steps prior to adoption of the WDRP to improve the accuracy of Whois data. In May 2002, ICANN reminded registrars of the importance of understanding their obligations regarding accurate Whois data. In September 2002, ICANN developed a system for receiving and tracking complaints about inaccurate or incomplete Whois data. In April 2003, a month after the adoption of the WDRP, ICANN issued a "Registrar Advisory Concerning the '15-day Period' in Whois Requirements", which provided guidance on a registrar's right to cancel a registration. None of these efforts necessitate that the registrars do anything, but rather suggest that changes be made.

**“ One of the biggest problems with the implementation of the WDRP, as reported by ICANN, is with registrars who use resellers to sell domain name registrations. ”**



Ken Taylor

In the report under the section title Whois Requirements, ICANN lists several provisions of the Registrar Accreditation Agreement (RAA) which requires each registrar under contract with ICANN to obtain accurate contact information from their registrants of the domain names and to investigate and correct any reported inaccuracies in the contact information for each domain name that registrar sponsors.

## WDRP problems and solutions

One of the biggest problems with the implementation of the WDRP, as reported by ICANN, is with registrars who use resellers to sell domain name registrations. Many registrars stated that they received complaints from their resellers that getting a notice directly from the registrar confused the reseller customers: "Resellers accuse us of interfering with their end-customer relationship, with single resellers even considering changing to another registrar who does not comply [with] the WDRP policy."

# Model WDRP Notices

ICANN also posted for all of its accredited registrars a model WDRP Notice along with the WDRP Policy. Of the 254 registrars that did respond to the ICANN survey and compliance audit (out of the 364 accredited), ICANN reports that 143 did not send Notices. It was determined that 127 of these have been accredited for less than one year and so were not required to send out Notices. The remaining 16 did not indicate a reason why they did not send Notices.

110 of the 254 respondents said that they had sent Notices but were unable to determine the number of them. Only 78 registrars sent Notices out before the anniversary of the registration date (as required by the WDRP), and 63 registrars managed to track bounce rates. ICANN also reported that more than half of the registrants that responded do not track when changes occur to Whois records. Registrars were also asked to send a copy of a WDRP to ICANN for review. Only 48 registrars did so. Of the samples ICANN received, there were 45 that reflected compliance with the requirements. This means that only 45 registrars are documented as having been in full compliance with the WDRP or 12% of 364 accredited by ICANN. If you add the 127 registrars that have been accredited less than one year and were not required to send Notices, this represents only 46% of all ICANN accredited registrars.

As part of the survey and compliance audit, ICANN offered a free text box for registrars to send comments and/or problems documenting their experience of the implementation of this policy. Additionally, some registrars (unnamed in the report) volunteered to be interviewed. One registrar respondent offered what seems to be an excellent model of implementation, stating:

"...There were no issues implementing the WDRP. As is likely the case with most registrars, ours is a fully automated system. Notices were sent 30 days before the anniversary and all Notices are copied to us so that we have an electronic record of the full text of each WDRP email. The domain's record includes a timestamp for the email, as well."

This model is great ammunition for ICANN to combat the typical resistance historically proffered by registrars that their margins are too thin and they can't afford to accurately collect and maintain Whois data.

The report notes that another registrar stated that "the most accurate contact information is contained in its internal accounting system... we have been fairly successful in keeping this data up to date as registrants who are interested in keeping their domain keep their billing information accurate."

## “ The sponsorship of millions of domain names is not represented in the survey and compliance audit report. ”

ICANN speculates that the WDRP is more likely than not to have a positive effect on improving accuracy in Whois data, but this is only conjecture. The potential for the WDRP to improve things though is certainly there; if ICANN will take a more aggressive stance in making sure policy is followed. Some positive news in the report is that the budget for Fiscal Year 2004-2005 includes funding for a proactive compliance project for gTLD registrars and registries. The bad news is that money allocated to Whois improvement appears to be on a slow track toward a solution. ICANN plans to develop a statistical model for Whois data accuracy investigations, and plans to monitor registrar and registry compliance, rather than focusing

on enforcement of the RAA and WDRP. If there are contracts and policies with their accredited registrars, and they are not enforced, then why have contracts and policies?

There are follow up actions in the report suggested by the registrars and constituencies interviewed by ICANN that will need to be approved by the broader ICANN community before they can be instigated. Among the best of these that take a more active path in affecting improvement include requiring registrars that are unable to confirm delivery of a WDRP Notice to follow up in non-electronic ways (such as fax or regular mail) and to maintain appropriate records; and limiting the WDRP to those registrars that have generated concern about their commitment to ensure the accuracy of Whois data. Additionally, ICANN mentions that they might publish the names of those registrars subject to the WDRP that in ICANN's view would provide further incentive to improve their record on Whois accuracy.

Trade mark owners can assist in moving all of this along, by assisting their registrars in updating their contact data when they receive a WDRP notice, and by reporting registrars to ICANN who are not in compliance with their RAAs or with the new WDRP policy. Leverage your large portfolios of domain names, as a way of getting your registrar's attention if they are not in compliance with the obligations to ICANN and to you. Make your concerns known or report problems to the Intellectual Property Constituency (IPC) that represents your trade mark concerns to the Internet community at quarterly ICANN meetings. Provide members of the **MARQUES** Cyberspace Team with examples of real world examples of Whois abuse or difficulties. And finally, monitor the ICANN Website or one of the blogs that cover ICANN issues and express your concerns when ICANN asks for public comments on Whois policy.

### Links:

More information on the WDRP policy:  
<http://www.icann.org/registrars/wdrp.htm>



# How to protect product short-term marks

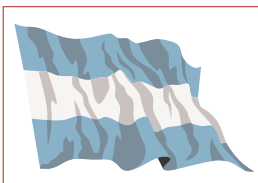
Dr María Elena Pérez and Gabriela Hanak, of Moeller & Co in Buenos Aires, Argentina examine the various means of protecting brands with a short lifespan in Latin America.

It has recently been observed that marks for certain products usually have only a short life in the market. This is mainly true of products renewed every season which are each year provided with new features.

When they are external, such novel or characteristic features frequently identify the products by themselves and when they are not evident to consumers, a new name or sub mark or accessory trade mark should be assigned to the products to refer to the new version.

This phenomenon makes it necessary to review the range of available IP rights, to determine those most suitable to provide prompt and effective protection, and to be in a position to prevent and repel, simply and rapidly, any unexpected infringement of the new products and/or services.

Such an examination should be conducted in each country and pursuant to local regulations.



## ARGENTINA

### Trade mark registration

The definition contained by Act 22362 includes the expression "having the capacity to distinguish and any other sign with such capacity". Registration procedures take a considerable period of time: even when no oppositions are filed by third parties or by the Trade Mark Office, they take almost a year at least.

### Industrial models and designs

Industrial designs and models are covered by Decree-Law 6673/63, which defines them as "any shape or appearance incorporated or applied to an industrial product providing it with an ornamental character", covering mainly aesthetic and external features of the product impressing sight and/or taste, regardless of the application or function of the product by itself. Models are protected

when they result from a creative activity and have an original component.

Protection is granted for five years and this term can be extended up to 15 years. The deposit is based only on a *iuris tantum* assumption as the official authority or entity verifies only that the formal requirements are fulfilled.

### Intellectual property

Intellectual property expressly acknowledged by Act 11723 includes works of drawings, paintings, sculpture, architecture, models and works of art and science used in commerce and industry. Regulations in force provide for a right for life to the author or physical person, and institutions, corporations or artificial persons are granted such rights for 50 years from publication.

Registration is made effective through deposit with the National Copyright Bureau, an action which determines the time from which the author is entitled to exercise his right to resort to the courts to demand the due protection of the published work, and the certificate attesting to the deposit constitutes the title allowing the author to enforce the copyright.



## BRAZIL

There are three possible courses of action with a varying scope, speed and cost.

### Industrial design certificate

The industrial design certificate, covering industrial models and designs, provides protection for a minimum 10 years, which can be renewed every five years up to a total of 25 years. Procedures take from 90 to 150 days from date of filing. This is the quickest protection and can coexist with a patent and a three-dimensional trade mark.

### Three-dimensional trade mark

Protection is in only one class. Applications can face third parties' oppositions and be delayed by up to three years.

### Unfair competition

If no protection is available by either of these



means, the only possible course of action against a third party would be based on unfair competition.



## CHILE

The current IP law and the amendments to it, which will be coming into effect soon, set forth that, as far as industrial designs are concerned, colouring products shall be excluded from protection as designs, excepting soles of footwear.

However, it is to be noted that certain ornamentations of sports footwear can be registered as labels, though a particular analysis should be made in each case.

All creations which have a utilitarian use, such as sporting articles, can be protected as a utility model or an invention patent. Registration procedures are take a long time in Chile: one to two years for industrial designs, three years for utility models and four to five years for patents.



## MEXICO

### Industrial trade marks and industrial designs

It is possible to obtain protection for three-dimensional shapes by a trade mark registration. Both protection as three-dimensional trade mark and industrial design registrations can cover the same object (accumulated protection), even when the origin of protection is not the same.

Three-dimensional trade marks having an animated or changing shape cannot be registered. Examination of a trade mark application can take about six months.

### Intellectual property

Mexican legislation on copyright allows the protection of artistic works, which comprise works of applied art including graphic or textile designs – for which final granting can take less than one month. The industrial design can be regulated at the same time by both industrial protection and copyright laws.



## URUGUAY

### Trade mark protection

Act 17011 provides that the shape given to products or containers is not considered to be a trade mark if the product meets the requirements to become a patent of invention or utility model.

As long as procedures encounter no objections, they can be fairly quick (about six months).

### Industrial models

Since 14th January 2004, the National Bureau of Industrial Property has started to request a substantive examination (and payment of the corresponding fees), which now implies further delays in proceedings. Certain companies, such as automotive companies, are seriously considering this kind of protection.

## Intellectual property

Artistic and literary property rights are regulated by Act 9739, which covers literary, scientific or artistic creations and acknowledges rights on productions of thought, science and art.

These regulations cover leaflets, photographs, commercials, plans, models or creations having an artistic value as related to clothing, furniture and precious objects, which are not covered by IP legislation.

Article 6° of the Act states: "The enjoyment and enforcement of said rights shall not be subordinated to any formalities or registration ... In order to have owners of works and of other rights protected by this law – unless otherwise evidenced – considered as such and consequently acknowledged by administrative or judicial authorities, to sue infringers, it will be sufficient to have a notice with his name stamped on the work."

Article 54 sets forth that recordal with the registry kept by the National Library is not mandatory, though it is always convenient to hold a filing certificate bearing a certain date.

# Weighing up the options

Legislation in most Latin American countries provides for the possibility to protect the appearance of products under several systems of protection, such as trade mark registrations, industrial models and designs and copyright. Procedures in each case vary in complexity depending on the particular country.

Considering costs and celerity, the most effective manner to obtain a title to protect the marketing of an innovative product to be launched in the market is usually an industrial model registration, except in Chile, where no such protection is available, and Uruguay, where procedures could take longer than for a trade mark registration.

In each case, the strategy to be followed should be evaluated in the light of the regulations involved and considering that a particular kind of protection could be detrimental to the novel or original features of a subsequent claim under another form of protection.

Regardless of the option followed when seeking protection, any advertising material referring to the new product should be protected by copyright. Should the new product conceived only on a temporary basis then becomes a long lasting classic, it will be advisable to protect it via a trade mark registration, which, upon fulfilment of the pertinent use requirement, allows indefinite protection if renewed.

We hope this article has helped to clarify certain concepts and provided useful information for any commercial transactions you may start, based on protecting and maintaining IP rights in Latin America.

# How to protect famous names in Turkey

In the light of an increasing number of bad faith registrations of famous personalities, Isik Ozdogan of Ofo Ventura examines how to defeat the pirates.

In Turkey, as in other countries, any sign or any combination of signs can be registered as a trade mark. According to the Turkish Trade Mark Law, such signs may be words, personal names, letters, numerals, figurative elements, shapes of goods or packaging.

The number of attempts to register the name of famous international celebrities continues to increase considerably in Turkey. Bad faith Turkish applicants follow the news and international magazines very closely, and they file trade mark applications for the names of anybody who becomes popular in the world. This could be the name of a designer, actress/actor, pop singer, model, painter or photographer. The most important criterion for acceptance as a trade mark is to be publicly renowned. The reason for the renown is not important. For instance, after the Iraq war in 2003, many trade mark applications for the name Colin Powell, who was the US Secretary of State at that time, were filed and published in the Official Bulletin.

## Nature of the threat

Which classes are most favoured by those applicants? As you would expect, classes 25 (clothing) and 35 (retail services) are the most preferred classes. These classes are followed by classes 18 (leather products), 3 (cosmetics), 9 (sunglasses), and 14 (jewellery, watches).

The Turkish Patent Institute does not immediately refuse this kind of application simply because it is the name of someone other than the person filing the application. Such applications are permissible under Turkish law and are not automatically denied. In other words, the Turkish Patent Institute examines the application and publishes it even if it is the name of an individual other than the applicant. If an

opposition is not lodged against the application, the Institute does not have any choice but to register the application.

On the other hand, this kind of application can be refused on the basis of relative grounds. Article 8 of the Turkish Trade Mark Law provides: "Upon opposition by the holder of the relevant right, the trade mark applied for shall not be registered if it contains the name, photograph, copyright, or any industrial property rights of third parties." Upon receiving an opposition supported by documents showing the rights of an opponent, the Institute will decline the application.

## Unanswered questions

World famous designers such as Alexander McQueen, Nicole Miller and Yohji Yamamoto suffer from this kind of application. They have so far successfully contested attempts by others to register their name.

However if an application consists of only the last name of a celebrity, the Institute's position has not yet been clearly established. Until now in its initial examination the Institute has rejected oppositions filed against applications consisting of the last names of celebrities, stating that individuals have no personal rights to their last names. Although there are no precedents about this issue, many legal authorities are of the opinion that registering the last name should not cause any confusion and would not damage the personal rights of third parties. The decisions of the Institute regarding this issue have been brought to the Re-examination and Evaluation Board to be revised, but a final ruling has not been issued yet.

Another issue regarding the registration of celebrity names is the registration of



“ If an application consists of only the last name of a celebrity, the Institute's position has not yet been clearly established. ”

pseudonyms, for example stage names. Upon receiving an opposition, the Turkish Patent Institute refuses that kind of application only if sufficient evidence proving the use of a stage name by an opponent is submitted.

In any of the situations discussed above, it is highly recommended that the rightful owner file a new trade mark application for the contested trade mark at the same time that an opposition is presented to the Institute.

Moreover, it is important to note that successful registration of a trade mark does not mean that the trade mark cannot be declared void afterwards. Any interested third party can file a lawsuit for cancellation of a trade mark based on the article cited above.

# Introducing: The **MARQUES** Education Team

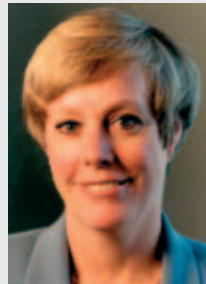
Continuing our series of introductions to the people behind the **MARQUES** Project Teams

This month, we meet the members of the **MARQUES** Education Team – responsible for educational programmes, trade mark research and the annual award of the Lewis Gaze Memorial Scholarship



## **Karen Abraham**

Karen Abraham graduated from the University of Adelaide with an LL B and was admitted to the South Australia Supreme Court in 1988 and to the High Court of Malaya in 1989. She is a partner of Shearn Delamore & Co. Her practice covers all areas of intellectual property and information technology law although her main area of practice has been IP litigation and enforcement of IP rights for leading multinational companies throughout the world. She has also designed and crafted anti-piracy and anti-counterfeiting programmes for leading companies in the global market. Karen is the President of the International Association for the Protection of Intellectual Property (AIPPI) Malaysian Chapter. In this capacity she has been invited to propose legislative reform to the IP infrastructure in Malaysia and is currently the Asian Coordinator for the International Trademark Association's (INTA) Alternative Dispute Resolution Sub-Committee and has been appointed on the Panel of Neutrals of the INTA. She has presented numerous papers at national and international IP conferences and conventions.



## **Mary Squyres**

As the head of the International Trademark Practice Group at Brinks Hofer Gilson & Lione in the US, Mary Squyres manages eight staff and more than 20,000 active trade mark files. Her practice includes international trade mark litigation, licensing and prosecution, including determination of international filing strategies, negotiating worldwide mutual co-existence agreements and effective enforcement strategies to defend marks and prevent infringements. Prior to joining Brinks, Ms Squyres was in-house counsel at Sears, Roebuck and Co in corporate and international trade mark law for an international trade mark portfolio of more than 2,800 active trade marks and service marks in over 100 countries.



## **Daan Teeuwissen**

Daan Teeuwissen obtained his law degree at the University of Amsterdam in 1991, specializing in intellectual property law. In 1991 he started his career at an Amsterdam general practice law firm. In 1994 he continued his career as a trade mark attorney at a large Dutch trade mark firm. He passed the exams of the Benelux Association for Trademark Attorneys in 1995 and he joined Knijff Trademark Attorneys in 1999 where he became a partner in 2000. Daan is responsible for the firm's US clients. Daan has been a member of the Board of the Benelux Association for Trademark Attorneys for several years and has served on several committees of the International Trademark Association and as a vice-chairman of the dilution committee. He teaches a course on International and European Community trade mark law at the professional education of the Dutch Association for Patent Attorneys and at the highly recognized Grotius Academy. Daan has acted as chair, moderator and speaker at several (international) IP conferences.



## **José Amorim**

José Amorim was born in Lisbon in 1963, having studied Business Administration at the Catholic University in Lisbon. He has also obtained a BA in English Language (CLES). He started his professional life as a teacher, having joined Gastão da Cunha Ferreira, Lda in 1992, where he currently coordinates the Trade Mark Department. He manages trade mark portfolios of several Portuguese and foreign companies, having extensive experience with the filing, prosecution and maintenance of trade marks in Portugal and abroad.



## **Michael Grow**

Michael Grow chairs the Intellectual Property Department at Arent Fox PLLC. He specializes in domestic and international trade mark, copyright, advertising and e-commerce litigation. He has represented clients in civil actions and appeals in state and federal courts throughout the United States and in hundreds of opposition and cancellation proceedings before the Trademark Trial and Appeal Board. He also has broad experience in assisting clients with worldwide trade mark and copyright selection, clearance, registration, and enforcement. On several occasions, he has helped clients with government relations issues and in securing legislation directed at enhancing their IP rights. He has testified before Congressional committees in both the United States Senate and House of Representatives on IP matters and serves on the editorial board of Internet Law & Business. He is fluent in Italian and Spanish.



## **Janice Trebble**

Janice Trebble qualified as a teacher in the UK in 1975. During a career break to start a family, she obtained a BA in mathematics and earth sciences from the Open University (OU). She worked for a couple of years as a buyer/estimator for a builders' merchant before joining Saunders & Dolleymore in 1986. Janice qualified as a trade mark attorney in 1990 and since then has been involved with training students, and setting and marking the UK Trade Mark Practice and Trade Mark Searching professional examinations for ITMA/CIPA. She is a Fellow of the Institute of Trade Mark Attorneys in the UK and a contributor to Sweet & Maxwell's European Trade Mark Litigation Hand Book and to Markenkompendium published by Wila Verlag Wilhelm Lampl GmbH. As an intellectual exercise and to remind herself of what it feels like to be a student, she has recently obtained an OU Certificate in Accountancy.



## **Shane Smyth**

Shane Smyth B Sc (Comp Sc), Solicitor BCL, European Patent Attorney, Community Trade Mark Attorney, joined the firm of F R Kelly in 1982 and has degrees in both law and computer science. He is a lecturer in computer law at Trinity College Dublin. He is a council member of MARQUES and a member of ECTA. He is the Secretary of the Irish Association of AIPPI. He is a member of the EU Scientific Committee on Designations of Geographical Origin and co-author of the leading textbook on Irish Intellectual Property Law published by Butterworths.



# Call for Articles

## Rapporteurs 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 "Rapporteurs" 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

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](mailto:editor@marques.org)

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

## The Council 2004/05

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

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