

New **MARQUES** Chairman elected

MARQUES is pleased to announce that at the February Council Meeting Jane Collins was elected as Chairman for the next two years. She succeeds Tove Graulund who is stepping down.



Jane is a Registered UK Trade Mark Attorney. For a number of years she was Global Head of Trademarks at Syngenta, Switzerland and since May 2005 has been General Trademark Counsel for the same company. Jane joined the **MARQUES** Council in 1996, and became Vice-Chairman in 2001. Jane's experience and knowledge of the IP world will assist **MARQUES** in tackling and capitalising on the challenges that lie ahead.

"Whilst I cannot hope to emulate the achievements of Tove Graulund during the last five years, I am nevertheless looking forward to taking up the challenge to promote the interests of trade mark owners and increase the influence of **MARQUES**," said Jane.

Jane will be supported by Susanne Skov Nilsson of VKR Holding A/S, Denmark who continues as 1st Vice Chairman and is joined by Guido Baumgartner of Coty Prestige Lancaster Group, Germany, who was elected 2nd Vice Chairman. Guido is the Head of the Department of International Market Control, a position

that he has held since 1994, and has been a member of Council since 2005.

We wish all these officers success in their positions.

Tove Graulund decided not to stand for election again after being our Chairman for the past five years. Tove wished to make a change in her life, and it also meant that she changed the direction of her career and has left Arla Foods amba to join Zacco Denmark A/S.

"I am delighted with the result of the election and know that the new leadership will do very well indeed to bring the association forward," said Tove.

She added: "I have thoroughly enjoyed the many years that I have been involved. It has been a great challenge to influence events so that the interests of brand owners are put to the front. But the most fun has been all the interesting people that I have met and the best has been the many friends that I have made over the years."

Tove Graulund has worked tirelessly and successfully to elevate **MARQUES** to become Europe's most influential IP

organisation whose views and input are sought and much respected from policy-makers within Europe. During her time as Chairman, Tove has fostered a valuable relationship with organisations such as OHIM and WIPO and has successfully represented **MARQUES** members on the international stage. The increased membership, attendance at the Annual Conference, establishment of Teams and the employment of a Development Executive and External Relations Officer are testament to the growth and influence of the association over recent years. We are pleased to report that Tove has agreed to remain active within Council and with her expertise and enthusiasm will continue to be a valuable asset to **MARQUES**.



Susanne Skov Nilsson



Guido Baumgartner

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MARQUES promotes brand owners' interests in Europe

Cristina Duch, **MARQUES** External Relations Officer and Tove Graulund, **MARQUES** Chairman, provide an update on recent activities in Europe where **MARQUES** has been active.

Trade Mark User Forum

On 18th October 2006, **MARQUES** organised the fourth Trade Mark User Forum in Brussels. As in former occasions, representatives from several national patent and trade mark offices in Europe attended this meeting. Representatives from the Association des Industries de Marque (AIM) and the Union of Industrial and Employers' Confederations of Europe (UNICE) also participated in the meeting.

Participants enjoyed a presentation from Mr Eusebi Nomen, Chair of the Institute for Intangible Assets Analysis at the Spanish Business School ESADE, on the establishment of the Andorran Trade Mark and Patent Office in 1996, following which the discussion concentrated on the topic of how to run an efficient patent and trade mark office based on the needs of users.

Mr Nick Wood, Director of Com Laude and a member of the **MARQUES** Council, gave a presentation on domain names in Europe from the perspective of the IP community. The discussion that followed turned on the question of what role the national patent and trade mark offices could play in this context. In his presentation, Nick also referred to the one-day seminar that **MARQUES** and ECTA are planning to organise next April 2007 looking at sunrise schemes and best practices.

Other issues raised at the Forum were the funding system of national trade mark and patent offices and the serious issue of diversion of fees. AIM took the lead in the debate on well-known registries, and users' concerns were discussed. Further, **MARQUES** updated national offices on the current status of the discussions referred to as the UNCITRAL Receivables Treaty and Legislative Guide and their impact on IP rights.

Second working meeting on the UNCITRAL Legislative Guide

In July 2006, **MARQUES** took the initiative to hold the First Working Meeting on the United Nations Convention on the Assignment of Receivables in International Trade and Legislative Guide on Secured Transactions. The meeting was attended by representatives from several organisations and was an excellent start.

Then, on 16th October, **MARQUES** organised the Second Working Meeting, this time in Amsterdam, where the level of awareness of this issue among the IP community was further discussed and some recommendations were made in order to draft a common paper. This paper will be submitted during the Colloquium on IP Financing that UNCITRAL is organising for 18th and 19th January 2007 in Vienna.

MARQUES was represented at the Colloquium of UNCITRAL in Vienna by Mr Ben Goodger and Ms Cristina Duch (**MARQUES** External Relations Officer). A full report from this meeting will be published in the next **MARQUES** Newsletter.

MARQUES has established a site on its webpage where it is possible to find some background information about the UNCITRAL legislative initiatives on intellectual property and the activities programmed so far in this regard.

For further information, please consult <http://www.marques.org/uncitral> or www.uncitral.org

Lisbon meeting

MARQUES was represented at the recent conference addressing the role and promotion of IP organised in Portugal.

MARQUES chair Tove Graulund took part in a conference in Lisbon on 2nd and 3rd October entitled 'Journees of Intellectual Property', which was

organised by the Instituto Nacional de Propriedade Industrial (INPI).

The conference featured various presentations addressing the role and promotion of intellectual property in development of small and medium-size companies and the latest strategies for IP protection in Portugal and Europe.

Tove spoke about what companies need from IP and what the priorities are for an in-house IP department in a fast-moving consumer goods environment.

Other speakers at the conference included Mr Alberto Costa, the Portuguese Minister for Justice; Mr Antonio Campinos, president of INPI, and Ms Maria José Costeira, judge at the Commercial Court in Lisbon, as well as other representatives of important bodies in Portugal. There were also presentations from members of other national and regional patent and trade mark offices in Europe.

The closing ceremony featured Mr Alain Pompidou, president of EPO, Mr Wubbo de Boer, president of OHIM and Portuguese Secretary of State for Justice Mr João Tiago Silveira.

10th anniversary of Boards of Appeal

Tove Graulund also represented **MARQUES** at the conference to mark the 10th anniversary of the OHIM Boards of Appeal, held at OHIM on 27th October. She explained brands from a brand owner's viewpoint to the participants and stressed how non-traditional trade marks are often important elements of brands. She also discussed the lookalikes problem where these types of brand elements are often copied and why the Boards should consequently consider taking this into account in their decisions.



The day-long conference involved past and present members of the Boards of Appeal, and featured reflections from former chairpersons of the Boards, as well as comments from representatives of users, who emphasised the need for fast, coherent and predictable decisions.

There are four Boards of Appeal at OHIM, led by the President of the Boards Paul Maier. An enlarged board gives decisions on important or disputed cases, and issued its first two decisions earlier this year.

Links

Information on the OHIM Boards of Appeal is available at <http://oami.europa.eu/en/office/aspects/decisionsboard.htm> and http://oami.europa.eu/search/legaldocs/la/EN_boa_index.cfm



“Tove Graulund spoke about what companies need from IP and what the priorities are for an in-house IP department in a fast-moving consumer goods environment.”

Canada takes battle to the counterfeiters

Michel A Chartrand, Paul D Blanchard and Lisa R Vatch of Gowlings review the significant progress made by the Canadian government in fighting counterfeiting during the past year.

An Interdepartmental Working Group (IWG), chaired by the Minister of International Trade, has been formed by the federal government to enhance IP rights crime enforcement. This Group is working towards proposing legislative reforms and resource requirements to create an effective national IPR crime enforcement programme, perhaps through legislative changes that may be proposed in the next few months.

Representatives of the Canadian Anti-Counterfeiting Network (CACN) have also recently met with the IWG. In a letter to the CACN in May 2006, the Minister of Public Safety and Emergency Preparedness undertook to meet with CACN representatives. In May 2006, the Minister of Canadian Heritage commended CACN's efforts, stating: "I recognise that counterfeiting and piracy are serious threats to the legitimate businesses that provide Canadians with goods and services."

On 15th June, the Canadian Minister of Industry met the US Commerce Secretary, the Mexican Economy Minister and select business leaders to launch the North American Competitiveness Council (NACC), which may address anti-counterfeiting issues. In August, the International Trademark Association sent a letter to the Canadian Minister of Industry and the Minister of Public Safety and Emergency Preparedness calling on the government to address the lack of any effective means to deal with counterfeit products in Canada. The letter identified the main problems in dealing with trade mark counterfeiting in Canada as lack of effective provisions making it a criminal offence to deal in counterfeit products, lack of effective provisions for civil enforcement against dealings in counterfeit products and lack of effective border measures to prevent counterfeit products from entering Canada.

At a meeting of the IWG on 30th October, Doug George, the Director of the Intellectual

Property, Information and Technology Trade Policy Division of the Department of Foreign Affairs and International Trade, said the IWG is ready to submit a memorandum to Cabinet. Some of the suggestions already presented to the IWG include ex officio powers for customs agents, sharing of information with IP owners, the power of seizure for customs agents, an increased role for the Royal Canadian Mounted Police (RCMP), increased penalties, a focus on the proceeds of crime, and training for judges and prosecutors.

Other recent activities

Among other anti-counterfeiting activities in the past year, Health Canada has released an advisory statement warning Canadians about unsafe counterfeit household batteries while a group of industry associations issued a joint statement on "Combating IPR Piracy and Counterfeiting" supporting the government's strengthening of IP protection and proposing new federal copyright legislation.

In August 2006, Toronto police broke up what they believed to be the largest counterfeit DVD manufacturing ring in Canada. In the raid, 20,000 counterfeit DVDs worth \$400,000 were seized, and a sophisticated manufacturing operation was discovered with the capacity to make 560 DVDs an hour.

In late August, a seizure of more than 47,000 cartons of counterfeit Canadian-brand cigarettes such as Du Maurier and Player's Light was revealed, as the RCMP announced the arrests of three Toronto men allegedly involved in the criminal enterprise. The contraband cigarettes arrived in Halifax by ship from China and were transported by rail in containers to a Canada Customs clearing house.

In September, a 10-month RCMP investigation resulted in charges against three Nova Scotians after the RCMP seized

a truck loaded with counterfeit clothing, millions of illegal cigarettes, guns, a crossbow and cocaine. In the same month it was also reported that a Canadian member of an alleged smuggling ring that dealt in contraband cigarettes, counterfeit Zig-Zag rolling papers and fake Viagra, and steered some of the profits to Hezbollah guerrillas, pleaded guilty to racketeering charges. He faces up to 20 years in prison and a \$250,000 fine.

The RCMP is also launching a national initiative to educate business owners about counterfeit goods and is adopting a new strategic priority, Economic Integrity, in the 2006/2007 fiscal year, recognising the priority of IPR crime enforcement.

On September 22, the Canadian Standards Association announced a consumer safety alert for HRS-Global indoor extension cords posing a potential electric shock and fire hazard and bearing counterfeit registered trade marks belonging to CSA. HRS-Global had imported these extension cords from China and distributed them throughout Canada.

We believe that this progress in Canada in the past few months indicates the new Canadian government's awareness of the importance of anti-counterfeiting issues. However, the October 30 IWG meeting has indicated that further efforts will be required to spur the government to action on the issue of anti-counterfeiting.

Michel A Chartrand, Paul D Blanchard and Lisa R Vatch are members of Gowlings in Canada. Michel is a member of the **MARQUES** Anti-Counterfeiting & Parallel Trade Team.

Links

More on the RCMP activity against counterfeiting is available here: http://www.rcmp-grc.gc.ca/fio/ipr/counterfeit_report/2006/winter/ip_crime_e.htm

Tips on showing use at OHIM

In the second part of their article on showing trade mark use, Franck Soutoul and Jean-Philippe Bresson review what Community Regulations and OHIM practice reveal about the content of evidence required.

OHIM compares the products and/or services displayed on the submission of evidence of use with those on which the opposition is based or against which the cancellation claim is directed.

When use must be demonstrated in respect of specific products and/or services, only evidence for these particular products and/or services is sufficient to save the mark from cancellation for non-use. Evidence of use relating only to specific products and/or services that could be considered to be similar to those submitted to the claim for evidence has no effect in demonstrating the relevant use.

When use must be demonstrated in respect of a large category of products and/or services, evidence of use for a specific product and/or service falling within that broader category leads OHIM to hold that (i) use of the mark is only shown for this specific product and/or service and (ii), in the context of an opposition proceeding, only this specific product and/or service will be taken into account in assessing the similarity of the products and services involved.

Evidence is regarded as sufficient to show use of a broad category of products and/or services when the proof shows use of several products and services that are all included in that category. For instance, bath salts and bath gels were deemed sufficient to maintain a Community trade mark on the register for soaps (Cancellation Division, 21st February 2005, *Kama Sutra*).

Examiners also consider the classes into which products and services fall. OHIM for instance upheld that use of “beers, minerals, aerated waters and other non alcoholic drinks” in class 32 was not demonstrated through documents relating to milk products as (i) these products were not raised in the opposition whereas they were claimed in class 29 under the earlier mark opposed and (ii) the explanatory notes of the Nice Agreement exclude from class 32 milk beverages and those in which milk predominates (Board of Appeal, 18th May 2006, *Hero Viva v Viva*).

It must be noted that use of a mark in advertising to promote a product and/or service does not demonstrate, even indirectly, use for advertising products or services. Furthermore, giving away T-shirts and baseball caps at promotional events with the purpose of marketing a drink is not a genuine use of the mark for clothing products.

“**Volume of sales and length of the use of the mark in the market are interdependent factors.**”

Contents of evidence

When comparing the mark displayed on the evidence of use with the mark on which the opposition is based or the cancellation claim is directed, difficulties arise when the two signs do not fully correspond.

Word trade marks displayed in a different type face, in a different letter size (capitals/lower case), in different colours and with non-distinctive additions are generally considered to be equivalent to use of the mark. Device trade marks used in colour compared to black and white or with added non-distinctive words also generally constitute use of the mark.

OHIM determines whether the variation between the sign used on the market and the mark registered is admissible in light of the alteration in the distinctiveness of the trade mark that this situation creates. This determination relies on a case-by-case analysis which takes into account in particular what makes up the mark, its length, the distinctiveness of its components and the extent of the variation.

The European Court of First Instance has ruled that the owner of a registered trade mark cannot be exempted from submitting evidence of the use of a trade mark by simply raising the use of a similar registered trade mark (23rd February 2006, *Bridge v Bainbridge*).

Extent of use

The evidence filed before OHIM must show the extent of the use. This firstly means that use must reach a certain level to be regarded as serious. OHIM has not however fixed any minimum for the volume of sales. Each situation is a particular case that depends on the area of business, on the circumstances proper to the proceedings and on the nature of the products or services at issue (ECJ, 11th March 2003, *Ansul*).

The volume of sales and length of the use of the mark on the market are interdependent factors. A short-term use with a high volume of sales or a continuous use with a low volume of sales may both properly show serious use of the mark. The required volume of sales is however higher for mass products than for special products for which public demand is rather limited.

The extent of use of a Community trade mark also implies the need to demonstrate use from a geographical perspective. Community Rules provide that the mark must have been put in genuine use in the Community. Some people, including even the Community authorities, have considered that using a Community trade mark in one single European country would save the mark from cancellation for non-use.

This single-country view has never been endorsed by the Community case law but some decisions have found that use of the mark in two or three countries is sufficient. Demanding that use of the mark in all countries of the Community be shown would certainly be excessive. However, it would be fair to require that the use of mark is made in a majority of countries, as the number of Member States continues to increase.

An overall approach

The assessment of the pertinence, efficiency and admissibility of the evidence of use is made solely and exclusively under an overall approach. All the circumstances in relation to the mark are taken into consideration in conjunction with all of the evidence. Compared to the policy of national trade mark offices and even the practice of some courts, the specific and strict approach of OHIM clearly requires trade mark owners to give special care to selecting and gathering each element that is provided in support of the demonstration of trade mark use. Only continued practice enables applicants to meet the OHIM criteria.

Franck Soutoul is a partner and Jean-Philippe Bresson is a trade mark attorney working in Inlex Conseil in Paris, France. Franck is France correspondent for the MARQUES Newsletter.

Links

Information on the Community trade mark is here: <http://oami.europa.eu/en/mark/default.htm>

Read CFI and ECJ decisions on Community trade marks here: <http://curia.europa.eu/en>

“**Evidence is regarded as sufficient to show use of a broad category of products and/or services when the proof shows use of several products and services that are all included in that category.**”

How to protect famous marks in Greece



Owners of famous trade marks in Greece do not need to show likelihood of confusion to earn protection. Dimitris Prokopiou and Vali Sakellarides, partners of Sakellarides Law Offices in Athens, examine recent case law.

A famous trade mark in Greece is protected not only for the goods and services for which it is registered but also for dissimilar goods or services even when a similar later trade mark does not cause likelihood of confusion (Articles 4.1.c and 26.1 of Trade Mark Act 2239/1994). The reason for the broad protection is to prevent the depreciation of its strong distinctive character and the unjust enrichment of a third party by the use of the famous trade mark.

In two landmark decisions recently issued in Canada (*Mattel Inc v 3894207 Canada Inc* 1006 SCC 22 and *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 23), the Supreme Court pointed out that fame alone does not create a likelihood of confusion. Although famous marks are generally entitled to a broader scope of protection, the likelihood of confusion was examined as well as the similarity of the parties' goods. As a consequence, the defendant's Barbie's restaurant and catering services were found not to cause confusion with the famous mark Barbie for dolls and accessories, owned by Mattel.

Most probably, a similar court decision would be virtually impossible in Greece. Following a plethora of Greek court decisions and most recently a decision rendered by the First Instance Court of Athens in 2006 (Decision 1225/2006), a famous trade mark is protected regardless of whether or not there is a likelihood of confusion. It is protected against the danger

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of weakening of the mark and undue similarity. The test is not whether there is a likelihood of confusion. Rather, it is whether a sign imitates or resembles the famous mark, is used for dissimilar goods and services, and that use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark (as also stated in the Council Directive 89/104).

Requirements for protection

The broader scope of protection of the famous mark is justified by its “intense distinctive character or its fame”. The use of such a mark constitutes an infringement either because its use by a third party weakens its distinctive character or because it constitutes parasitic competition: competitive survival of the third party due to the use of the famous mark, conferring therefore undue gain (with no consideration) to the infringer.

In general under Greek legal theory and case law, the requirements that have to combine for a trade mark to be characterised as a famous trade mark are as follows (although on occasion the court may not base its decision on all of these requirements or only on part of these or take into account other factors as well):

1. The particularly good position of the trade mark in the marketplace: that is, the ascertaining that the trade mark has been established among a major part of the consumer audience (the so-called high degree of recognition).
2. The uniqueness of the indication: that is, the ascertaining that there are no goods or services in the marketplace, even irrelevant to the goods or services of the trade mark in question, using the indication. In a notable decision of the First Instance Court of Athens in 1992 (Decision 9077/1992), it was held that the trade mark Apple for computers was not unique, since the trade mark Apple had been previously registered for underwear.
3. The originality of the trade mark in question: that is, a trade mark cannot be characterised as a famous trade mark if it consists of a weak indication, namely an indication with a low level of distinctiveness. Examples of weak indications are those whose prototype exists in nature. Based on this the Court of First Instance of Athens (Decision 9077/1992) considered the trade mark Apple to be weak due to the device of the apple, since both the wording and the device had their prototype in nature.
4. The positive appreciation by consumers of the goods and services distinguished by the trade mark. Sometimes this can constitute the only critical factor taken into consideration by the Greek courts to establish that a trade mark is indeed famous and can be protected for all



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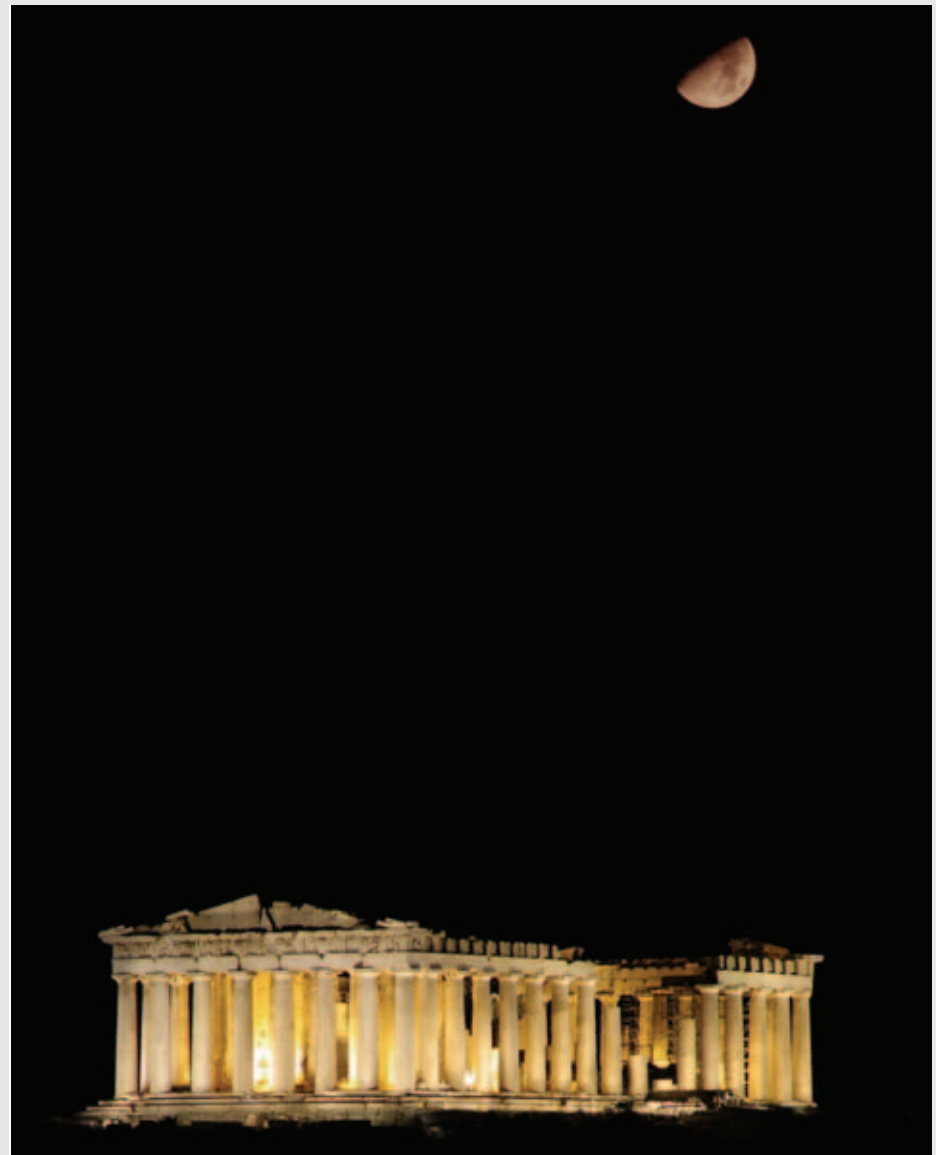
goods and services. In 1981, the Court of First Instance of Athens prohibited the marketing of bicycles named Bravo due to the existence of the famous Greek trade mark Bravo for coffee products. The trade mark Mercedes prevented the registration of the same word for flowers.

Recent decisions

In a recently published decision, issued by the First Instance Court of Athens (Decision 1225/2006) the court took into consideration as evidence of fame the following: the broad advertising of the goods bearing the trade mark, the advertising expenditure for the promotion of the goods (about ?700,000 for 2001-2003), the sales in Greece during the period of 1989-2003 (about ?34 million), the market share in Greece (1.4%), the recognisability of the goods (in this case the goods were found to be 72% recognisable even with the wording of the trade mark covered, according to a sworn testimony by the manager of a market research and survey agency).

Finally, the court concluded that the mark constituted a famous mark under Greek trade mark law as it had been continuously used by the trade mark owner to distinguish its products throughout the international market and had been broadly advertised; its distinctive character was not impaired by being used by third parties on dissimilar products and services; there was a positive evaluation of the consuming audience with regard to the quality of the goods that the mark distinguished. Furthermore, the court held that the defendant took advantage of the good fame and management of the trade mark owner, who had managed through wide advertising and the quality of its products to become well known in the international market, as well as in the Greek market and had acquired the trust of consumers.

The minor differences between the famous trade mark and the later similar mark did not change the situation, as the court held



that the more recognisable a trade mark is, the broader the scope of protection meaning that even fewer similarities are needed to prove its imitation.

In addition, the colouring and shape used by the well-known company were found to enjoy protection in themselves, especially when they constitute a dominant characteristic of the whole packaging and are capable of attracting the attention of the consumer (similarly the triangle shape of Toblerone chocolate enjoys protection, First Instance Court of Athens, Decision 1478/2005).

In a different decision, (Conseil d'Etat, Decision 726/2005) it was held by the Supreme Court that the registration of a trade mark in multiple countries (28 countries in this case) and the large circulation of goods under the mark in the Greek and international marketplace (300 million kilograms of chocolate in the period of 1960-1980) were not sufficient in the particular case for the claimant's trade mark to be characterised as famous.

The reason was that the Second Instance Court did not evaluate properly the evidence submitted and did not confirm the international fame of the claimant company and its prominent position in the international marketplace and Greece in particular. Nor did the Second Instance Court decide whether these factors in combination with others resulted in the conclusion that the goods of the claimant enjoy a particularly good reputation among the consumers. The claimant contended that its goods had been in the Greek marketplace since 1977 and in the United States the mark was registered in 1923. The defendant argued that it ignored these products and on the contrary it had been marketing its own goods since 1974. Although the Second Instance Court accepted that the Greek company took advantage of the fame of the foreign company, the Supreme Court overturned the decision due to the lack of complete justification in its decision.

Dimitris Prokopiou and Vali Sakellarides are partners of Sakellarides Law Offices in Athens.

Declarations raise questions in Mexico

Baudelio Hernández, of Baudelio Hernández & Asociados, SC, explains why the new provisions for protecting well-known and famous trade marks in Mexico raise more problems than they solve.



The Mexican Law on Industrial Property has been amended. A Chapter II bis has been added called Well-Known or Famous Trade Marks. Paragraphs III and X of Article 6 and Paragraph XV of Article 90 have been changed, and paragraph XV bis has been added to Article 90. With these amendments individuals as well as national and international corporations can obtain a declaration of a well-known or famous trade mark.

The Mexican Congress approved the amendments, which came into force in June 2005. However, the amendments raise some serious issues.

I believe that it is arbitrary to leave the decision to declare whether a trade mark is well-known or famous in the hands of the authorities. To declare that a trade mark is a well-known trade mark is not easy, but we may say that it may be declared when the trade mark has been advertised to a determined market scope. However, to declare that a trade mark is famous is another thing, which is much more complicated: the authority making the decision needs experts in advertising and marketing, with knowledge of the international and national markets. Moreover, I cannot say what the advantages of obtaining the declaration of a well-known or famous trade mark are; at least the applicable law does not show any.

Definitions

First we must analyse the meaning of famous and well known. It should be noted that anyone is invited to obtain the declaration of well-known or famous trade mark status, but the advantages and the costs are not clear.

“It is arbitrary to leave the decision to declare whether a trade mark is well-known or famous in the hands of the authorities.”

The Regulations have not been amended yet, so we will use the current Regulations for this quick exercise, but eventually the Regulations will need to be amended as well. For the time being, and in order to start discussing our subject matter, let us analyse two simple definitions of what is famous and what is well known, the first from the *Oxford Advanced Learner's Dictionary* (2000) and the second from *Webster's Third New International Dictionary* (1986):

Famous: Known about by many people.

Well known: 1. Known about by a lot of people; 2. generally known and accepted (Oxford University Press, 2000)

Famous: 1a. much talked about, well-known.
b. honoured for achievement, celebrated.
c. discredibly renowned, notorious.
2. common, usual (taking the word... in its most famous signification)... 3. excellent, first-rate.

Well known: Fully known: as a: widely known: generally acknowledged: known to many.
b: closely intimately, or thoroughly known.

If the authority issues a declaration of a famous trade mark, of course that would not be a problem if we are talking about trade marks such as Coca-Cola, Pepsi, IBM, and Nike; but then, if a trade mark is famous that means it is also well known. However, if a trade mark is well known it does not necessarily mean it is also famous. How is the decision to be made? Under what criteria will the Mexican Institute of Industrial Property act? Who will sign the declaration of a well-known or famous trade mark?

No answers

There are many questions that have been raised, many of which have already been asked to the authorities, but there are no answers. The people who proposed and made the amendment apparently did not have much experience, or the amendment just seemed like a good idea. It would be interesting to know how many countries all over the world have this kind of declaration.

Now the Mexican Institute of Industrial Property has to straighten things out. I can see petitions for declarations of well-known or famous trade mark status coming from big, medium and small businesses, which will be packed with attached documents, photographs, oaths, and so on, urging the Institute to issue a resolution. What started as a fairy tale with a happy ending will become problematic in the future and it will risk the security of trade marks, people's trust and consumers' safety.

The authority's duty to take care of the consumer will diminish, many people will get confused trying to figure out which trade mark they should buy – the correct, the well-known or the famous trade mark. And we also have to analyse if a well-known or famous trade mark means good quality, or if it is a mere declaration of the authority.

I see myself filing a petition for a declaration of a well-known or famous trade mark. Of course I will make sure to meet all the legal requirements, and in doing so I will meticulously try to guess if I should ask for a declaration of a well-known trade mark or a famous trade mark. Up to now, I still don't know how to tell the difference, I hope the authority does and will tell us when the time is right.

What do you gain from declaration as a well-known or famous trade mark? Why is the declaration valid for five years? Is it because the status of being well known or famous ends at a certain moment? We do not yet know the answers to such question as, so far, no one has applied for a declaration of well-known or famous trade mark status, since the Official Fees and the Regulations of the Law have not been amended.

Problems of registration

The purpose of granting certificates to well-known or famous trade marks is to provide additional protection to trade marks used in Mexico or abroad and more specifically to avoid dilution (the possibility that the trade mark loses prestige due to inconvenient use even in different classes).

This kind of certificate is innovative, since we have no evidence that it exists in other countries. Nonetheless, we believe that really well-known trade marks do not need this kind of protection; as bad faith third parties could try to cancel these certificates, and jeopardise a trade mark that is famous or well known.

Furthermore, the effective term of the certificates will be five years from the issue date of the declaration and thereafter the declaration may be renewed for the same period of time provided that the requestor complies with the requirements again, and of course the costs will be more expensive every time.

Finally, the Trade Mark Office does not have the qualified personnel it needs to review all the information required (such as experts in marketing and opinion polls) or a department that is specifically in charge of this innovative protection system.

Since there is no background or comparative law regarding this matter, everything will be new and subject to new criteria that we hope will be efficient, honest and professional.

Baudelio Hernández is a partner of Baudelio Hernández & Asociados, SC in Mexico City.



"What do you gain from declaration as a well-known or famous trade mark? Why is the declaration valid for five years?"

How to get a declaration

In order to get a declaration of well-known or famous trade mark status from the Mexican Institute of Industrial Property, the requestor should comply with certain requirements, many of which involve big expenses, which I'm sure many businesses are not willing to pay.

The requestor should provide, among other things, the following information (article 98 bis):

1. Information about real or potential consumers of the goods or services sold under the trade mark who can identify it with the products or services covered by it, obtained from opinion polls, market research studies or in any other lawful way.
2. Information about people other than real or potential consumers who can identify the trade mark with the goods or services covered by it (based on an opinion poll, market research study or in any other lawful way).
3. Information about the commercial circles consisting of traders, industrialists, or service providers associated with that kind of goods or services; who can identify the trade mark with the goods or services covered by it, based on an opinion poll, market research study or in any other lawful way.
4. The date when the trade mark was used for the first time in Mexico and, if applicable, abroad.
5. The period of time during which the trade mark has been continuously used in Mexico or, if applicable, abroad.
6. Commercialisation channels of the trade mark in Mexico or, if applicable, abroad.
7. Diffusion media of the trade mark in Mexico or, if applicable, abroad.
8. Effective advertising time for the trade mark in Mexico or, if applicable, abroad.
9. Information about the investment made to advertise or promote the trade mark in Mexico or, if applicable, abroad in the past three years.
10. Geographic area where the trade mark has an effective influence.
11. Sales volume of the goods or detail of the profits earned from providing the services protected by the trade mark, during the past three years.
12. Monetary value of the trade mark in the net equity of the holder or based on an appraisal of the trade mark.
13. Trade mark registration certificates in Mexico or abroad.
14. Information about the franchises and licences granted in relation to the trade mark.
15. Percentage of market participation of the trade mark in any given market.

After it has complied with these requirements, the Mexican Institute of Industrial Property is likely to deny the declaration. On the other hand, if a certificate of declaration is issued any interested third-party may contest it by arguing that the holder did not comply with the 15 requirements indicated by the Law; moreover, any interested third-party may contest the certificate of declaration on the grounds that the trade mark is not well known or famous, if the certificate has been granted.

IP effects of Vietnam's WTO membership

By Gladys Mirandah, patrick mirandah & co

With 84 million people (more than half of them under the age of 30), Vietnam is poised to become the next Asian tiger and an alternative to China. Businesses will flock to the country attracted by its low costs, and the educated and hardworking workforce. If Vietnam can overcome shortcomings relating to licensing delays, a lack of transparency, an overwhelmed infrastructure and widespread corruption, it can take full advantage of its WTO membership.

Vietnam has been ranked a dismal 104th out of 175 countries for the ease of doing business. Notwithstanding this, overseas companies are moving into the country: for example, Intel plans to invest US\$1 billion in Vietnam.

The New Vietnam IP Law

The new Vietnamese Intellectual Property Law came into force on 1st July 2006. The enactment of the new laws improves the efficiency and enforcement of IP rights. IP regulations from various documents such as the Vietnamese Civil Code have been compiled into the new law consisting of six parts, 18 chapters and 222 articles.

Trade Mark Regulations

One important feature of the Trade Mark Law is the listing of the criteria to determine whether a mark is well known, such as the duration of continuous use of the mark, the number of countries where the mark is registered and the value of sales of products/services bearing the mark. The time limit for examination as to form is reduced from three months to one month from the filing date. The time limit for examination as to substance is also reduced from nine months to six months from the date of publication of the trade mark application. Furthermore, all the applications will be published in the Official Gazette within two months.

The Four Decrees

Less than three months after the new Law on Intellectual Property came into effect, the government has issued four decrees, namely decree 100/2006/ND-CP dated 21st September 2006 which became effective on 17th October 2006, and decrees 103/2006/ND-CP, 105/2005/ND-CP and 10/2006/ND-CP which have taken effect on 21st October 2006. These decrees are the continuation of this trend to improve the Vietnamese IP law.

Infringement

The most important changes are related to the infringement of IP rights. Indeed, decree 105/2005/ND-CP defines an act of infringement as the loss of possession, the reduction of income and profit, the loss of business opportunity and the determination of damages. It provides adequate detailed guidelines. Legal costs are also recoverable.

Penalty

Decree 106/2006/ND-CP makes provision for acts of administrative violation in the IP domain and defines infringement to include producing (manufacturing, processing, assembling, etc), exploiting, selling, transporting, advertising, offering, stocking and importing. Fines of up to one to two times the value of goods if this value is VND15 million (US\$937.50), up to two to three times the value of the goods if the value is VND15 million to 30 million (US\$937.50 to 1,875), up to three to four times the value of the goods if the value is VND30 million to 45 million (US\$1875 to 2812.50), and four to five times the value of the goods if the value exceeds VND45 million (US\$2812.50). Additional penalties and compulsory remedial measures, such as confiscation of evidence, destruction of infringing goods or publication of corrective notices, may also be imposed.

Madrid Protocol and Madrid Agreement

The new Vietnamese Trade Mark Law was a premise for Vietnam to become a member of the World Trade Organisation (WTO). Vietnam is a member of both the Madrid Agreement and Madrid Protocol. Since July 2006, registering trade marks in member countries of the Madrid Protocol can be done by sending an application to the World

Intellectual Property Organisation (WIPO) via the National Office of Intellectual Property (NOIP).

Enforcement

The Vietnamese authorities have stepped up IP enforcement with more efficient use of police and customs enforcement. In conducting frequent raids early this year, they have shown their determination to improve IP enforcement systems. The authorities have taken action against a number of large distributors of pirated discs. They also broke up a counterfeit cigarette business. Another successful operation was the seizure of 20,000 counterfeit birth control pills and 550 bottles of counterfeit spirits in January 2006.

These improvements are part of the numerous efforts made by Vietnam to reach its goal of joining the WTO. On 7th November 2006 Vietnam was accepted by the General Council as a member of the WTO after almost 12 years of negotiation. Vietnam is therefore set to become the 150th member of WTO early in 2007.

Gladys Mirandah is a partner of patrick mirandah & co and is ASEAN correspondent for the **MARQUES** Newsletter.



Meet the **MARQUES** Designs Team

The newest **MARQUES** team monitors and influences legislative, judicial and other developments in the law and practice of registered and unregistered design rights, including issues relating to protection, management, taxation, filing, renewal and the relationship with three-dimensional trade marks.

**Laura Alonso Domingo, Elzaburu**

Laura Alonso is a partner of Elzaburu, which she joined in 1997. She specialises in intellectual property focussing on advising on national and Community trade mark and design matters and domain name issues and contentious-administrative litigation before the High Court and Supreme Court. She received her law degree from the Madrid Autonomous University and completed a masters programme in Law and Economics at Syracuse University (USA). She has lectured as a visiting professor at the masters course in Corporate Management and Administration at Madrid Autonomous University, is a past member of the INTA Dilution Committee for the EU, Canada and the Middle East, and is a member of the INTA Bulletin Law & Practice Subcommittee for Europe & Central Asia.

**Fabio Angelini, Intel Corporation**

Fabio Angelini obtained his Doctorate in Jurisprudence, summa cum laude, in 1985 from the University of Rome Law School La Sapienza. In 1989 he became a Master in European Law, summa cum laude, after studying at the European studies Institute Alcide De Gasperi in Rome. After studying at Boalt Hall School of Law, University of California in Berkeley he obtained his Master of Laws [LL M], in 1993. Fabio is the Senior Attorney for the Intel Corporation in Santa Clara, California and is a panelist for WIPO adjudicating on domain name disputes under the ICANN Uniform Domain Name Disputes Resolution Policy.

**Peter J Dernbach, Winkler Partners**

Peter J Dernbach is a partner of Taipei's Winkler Partners, where he heads the firm's intellectual property practice. He works with global brand owners in obtaining, licensing and enforcing trade marks, copyright, design rights and patents in Taiwan and around the world. Fluent in English and Mandarin Chinese, Peter is a member of the California and District of Columbia Bars and is a registered Attorney of Foreign Legal Affairs with Taiwan's Ministry of Justice. Before joining Winkler Partners, Peter practiced at Arent Fox Kintner Plotkin & Kahn in Washington, DC and at Qi Lin International Law Offices, in Taipei, where he focused on intellectual property and corporate transactions.

**Henning Hartwig, Bardehle Pagenberg**

Dr Henning Hartwig is a partner with the IP law firm Bardehle Pagenberg Dost Altenburg Geissler, based in the Munich office. He specialises in the prosecution and litigation of IP rights, particularly in the fields of trade mark, design, copyright and unfair competition law. He was among the first lawyers to successfully enforce Community designs before a national court under the new design regime. Henning Hartwig has published more than 50 articles in the above-mentioned fields and is preparing the publication of a Europe-wide up-to-date collection of the emerging national case law on the Community design (to be released in February 2007).

**Sven Klos, Klos Morel Vos & Schaap**

Sven A Klos was educated at the universities of Amsterdam and San Diego. Having earned his degree in 1988, he qualified for the Bar and began practising in intellectual property litigation in 1989. He became partner in the IP department of the firm NautaDutilh in 1996, and, before founding Klos Morel Vos & Schaap, spent two years as a partner of Allen & Overy. Sven has published and lectured on a wide variety of topics, such as the copyright aspects of multimedia, sports marketing, damages proceedings in IP matters, sport and intellectual property, the Database Directive, cross border injunctions in trade mark infringement cases, non-traditional trade marks, licensing contracts, character merchandising and the interface between competition and IP law. He is the author of the acclaimed copyright, neighbouring rights and database right chapters in the leading Dutch IP handbook *Kort Begrip van het Intellectuele Eigendomsrecht*.

**Dolores Moro, The Coca-Cola Company**

Dolores Moro is a Trademark Counsel with The Coca-Cola Company at its corporate headquarters in Atlanta, Georgia. Dolores is a member of the Company's Marketing, Strategy and Innovation Trademark Team. Dolores earned her BSME from Tufts University in 1984 and earned her JD in 1987 from Albany Law School of Union University. Prior to joining The Coca-Cola Company in late 2000, Dolores spent the majority of her career in private practice at law firms in New York City, most recently at Fitzpatrick, Cella, Harper & Scinto. Dolores serves on the Board of Directors of the International Trademark Association and is an active INTA committee member. She is an active speaker on a variety of trade mark issues including the Madrid Protocol, basics of international trade mark practice, trade mark search processes and managing outside counsel.

**David Stone, Howrey**

David Stone is a partner in the London office of Howrey LLP, specialising in all aspects of intellectual property with a focus on brand protection. As a solicitor advocate, David is one of a small number of solicitors entitled to argue cases in the English higher courts. David was educated at the Universities of Sydney and Oxford and writes and lectures widely on brand protection issues. He is a member of numerous professional organisations, and chairs the Designs Team.

**Laurent Venetz, Nestlé**

Laurent is Intellectual Property Adviser with Nestlé SA based in Vevey, where he has worldwide responsibilities for trade marks, designs and copyrights matters for two Strategic Business Units of the Group. He joined Nestlé in 2004. Prior to that, between 1999 and 2004, Laurent set up and managed the Trademark Department of Galderma Pharma (a joint-venture company between Nestlé and L'Oréal) in Paris and Lausanne. Before joining Galderma Pharma, he worked as an associate in a law firm in Geneva specialising in IP matters and completed a traineeship within the International Trademark Department of L'Oréal in Paris (1997). Laurent holds a law degree from the University of Lausanne and a Master of Law in Intellectual Property from the University of Strasbourg (CEPI).

**Bernard Volken, Fuhrer Marbach & Partner**

Bernard worked for six years at the Swiss Trade Mark Office first in the legal department of the patent and design division, then as the head of the trade mark opposition proceedings section. During his time at the Trade Mark Office, he was the lawyer in charge of drafting the total revision of the new Swiss Design Protection Act. For the last six years, Bernard has been in private practice. As a partner of the law firm Fuhrer Marbach & Partners, he is active in all aspects of IP law, including defining IP strategies, litigation and portfolio prosecution.

**Hanne Weywardt, MAQS Law Firm**

Hanne practises as an attorney in IP and commercial matters at the MAQS Law Firm. Previously she was employed as in-house IP counsel and head of the trade mark department of the internationally focused tobacco company Skandinavisk Tobakskompagni A/S in Denmark. Hanne is chairman of the **MARQUES** Publication and Website Team.

Write for the MARQUES Newsletter

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

If you would like to submit an article, please contact the editor (editor@marques.org) well in advance of the deadline, with details of the subject you propose to cover. You can also contact any of the country correspondents listed below. Everyone is welcome to contribute to the Newsletter, whether or not you are listed as a correspondent. **The deadline for the next issue is 15th March 2007.**

Country Correspondents

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

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