

## **MARQUES ACTIVITIES AND ACHIEVEMENTS HIGHLIGHTS**

### **2008-2009**

#### **MARQUES ACHIEVEMENTS**

##### **Observer Status Before OHIM's Administrative Board**

The Administrative Board of OHIM decided to grant **MARQUES** observer status as an international non-governmental body concerned with the use of the Community trade mark and Community design systems. Observer status is granted for a period of two years. The Association will be represented by Tove Graulund (Past Chairman of **MARQUES**) at each OHIM Administrative Board meeting during this time.

##### **Meeting with Italian CTM Judges**

The **MARQUES** Judges Meeting, focusing on national jurisdiction concerning legal problems associated with European trade marks, has become a trade mark for the Unfair Competition Team and is a huge success.

The Team organised the second of these Meetings with the Italian Patent and Trade Mark Office in Venice, Italy. The seminar gathered the most prominent Italian IP judges (including judges of the Supreme Court and from the major specialized IP courts, such as Milan, Rome, Naples and Venice), and attracted a vast audience of more than 100 representatives of industry and IP practitioners. The most prestigious law firms and brands were represented. The Italian judges gave lectures on the main subjects that concern Community trade marks, such as distinctiveness, risk of confusion and association of trade marks; value of well-known trade marks; preliminary measures; cross-border injunctions and parallel imports; and recovery of damages. Discussions were followed by a panel discussion, where panellists were representatives of major brand owners, such as Gucci, Prada and Richemont.

##### **MARQUES Appointed Member of the ICANN IRT**

**MARQUES** has been designated one of the 15 experts that compose the Implementation Recommendation Team (IRT) of ICANN. The IRT was created by the ICANN Board to consider whether standardized rights protection mechanisms (RPM) could reduce the financial and administrative burden on rights owners that might be caused by the process of launching up to 500 new generic top-level domains from early 2010 onwards. **MARQUES** will be represented by the chair of the Cyberspace Team, Nick Wood. The Cyberspace Team already submitted comments on the IRT's recommendations and is closely following the development of this initiative by ICANN.

##### **Madrid Protocol – Paper on Statement of Grant**

**MARQUES** has been pushing for an increase in communication between WIPO and users since 2005 and proactively supporting in every meeting the requirement for all designated offices to issue a Statement of Grant of Protection for each successful designation. During the 5th Meeting of the Working Group for the Legal Development of the Madrid System, it was agreed to recommend to the General Assembly this important change to the system. Therefore, the principle of so-called tacit acceptance has been broken. **MARQUES** considers this a very important step for the future of the International Registration system. The recommendation was adopted by the General Assembly in September 2008. National offices will benefit from a transitional period until 31st December 2010.

##### **New Team to Cover Issues Related to China**

**MARQUES** founded a new Team to provide information and business tools to protect and enforce IP rights in China. The China Team is committed to assisting brand owners navigate the complex brand protection issues presented by China. In addition, this Team works with officials from both regions to increase communication, as well as carry out best practice and training programmes beneficial to both Europe and China.

### **Meetings with European National Trade Mark Offices**

Since 2005 MARQUES has organized twice-yearly meetings with representatives of the National Patent and Trade Mark Offices in Europe together with the users' associations AIM and BUSINESS EUROPE. The aim of these meetings is to serve as a tool to discuss the future role of NPTOs and to approach issues that go across borders. The topics discussed include: UNCITRAL Guide and impact on the IP owners; funding of NPTOs; protection and registration of geographical indications; Madrid revision and expansion of the Protocol; domain names and ICANN initiatives; protection and infringement of look-alikes; 3D trade marks and designs; protection of well-known trade marks; use of class headings; IP mediation practice; and recent European law on trade mark rights and enforcement. These meetings promise to address issues of concern to brand owners and continue to be a benchmarking opportunity for European national offices.

### **Seminar on Distinctive Signs in Argentina**

MARQUES co-organized the seminar "How to Position your Wine in a Foreign Market; Use the appropriate tools. Successful Export Cases" in Mendoza (Buenos Aires) in April 2009, which was attended by 125 delegates. The programme included sessions on the importance of image and distinctive signs as well as the Madrid Protocol and the advantages of international registration. Practical cases from Spain, Argentina and Brazil were also presented. The seminar benefited from the contribution of several speakers, including representatives from WIPO, Miguel Torres, SA, Seragini Brand Design, Bodega Dominio del Plata, Louis Vuitton Moet Hennessy Group and Miolo Wine Group.

### **Support for ACTA and Other Initiatives**

Following the position paper sent by the Anti-Counterfeiting and Parallel Trade (ACPT) Team to the EU in December 2007 welcoming the plans for a new Anti-Counterfeiting Trade Agreement (ACTA), MARQUES has co-signed all five subsequent business memoranda on ACTA, the most recent being submitted immediately before the latest round held in Rabat, Morocco on 16th/17th July 2009. The ACPT was also represented at the EU Commission briefing to stakeholders held in Brussels on 21st May 2009 and circulated a detailed report to members. The next round of negotiations will be hosted by the Republic of Korea in November 2009, and the intention is to conclude the agreement as soon as possible in 2010. Enforcement in the digital environment remains one of the more challenging elements yet to be tackled.

ACPT and other MARQUES team members also attended the launch meeting of the proposed EU Observatory on Counterfeiting and Piracy, and have committed MARQUES' support to this important new initiative.

### **Customs Workshop and Seminar**

The Anti-Counterfeiting and Parallel Trade (ACPT) Team organized and held a workshop at the MARQUES winter meeting in Venice – "Co-operating with Customs – More Bang for your Buck!" – focussing not only on changes in laws and practices in various jurisdictions, but also on practical examples of the progress achieved. The workshop was followed by a

day-long seminar “More Bang for Your Buck” which again focused on working to protect brands with customs services and underlined strategies in hotspot counterfeiting jurisdictions. The event was held on 17<sup>th</sup> June 17 2009 in Amsterdam and examined the twists and turns of working with customs organizations worldwide. Around 40 delegates attended and also took part in lively question-and-answer sessions.

## **MARQUES TEAM REPORTS**

### **Brands and Marketing Team**

The Brands and Marketing Team deals with current commercial issues related to IP, in particular advertising and marketing issues that affect IP management. We consider it fundamental to provide practical information and advice to assist brand owners in managing their IP portfolio in the most cost-effective manner.

The Team has members from industry such as Cadbury and Heinz as well as specialized IP lawyers who have marketing experience. Due to the international acclaim of MARQUES, the Team is fortunate to be able to draw upon expertise from IP firms and lawyers around the world. We also liaise with external sources such as The British Brands Group.

The largest project undertaken by the team to date focused on advertising issues in various countries. Questionnaires were sent to more than 40 attorneys around the world for their opinions on regulations and marketing constraints faced in their territory. Current Team projects are nostalgic branding, marketing blunders, translations and cultural issues. Our most prominent project looks at IP management in the recession.

### **Designs Team**

The Designs Team continues to strengthen and grow. In February 2009, it published the 3<sup>rd</sup> Edition of its Review of the First 400 RCD Invalidity Decisions, now one of the most important practical works on design validity in the EU.

The Review was enhanced this year by an additional collection of decisions of Community Designs Courts in the member states of the EU and Switzerland – again, one of the only places that this information is gathered together. Also this year, the Designs Team has continued its lobbying for open disclosure by OHIM of design applications that it rejects – only through knowing what is rejected can we know what will be allowed!

Further, the Designs Team has been heavily involved in proposed amendments to the Locarno Classification used for registered designs around the world, assisting WIPO, OHIM and the offices of member states in this dry but important task.

### **Education Team**

One of the highlights that the Education Team is responsible for is the organization of the Lewis Gaze Memorial Scholarship. Team member Shane Smyth has been working hard on this project. Contacts are being established with professors of law faculties with the help of local MARQUES members. The challenge is to raise awareness of the Lewis Gaze Award among potential contenders and to call for submissions that meet the required quality level. As a result of discussions we are now considering if any additions or changes can and should be made to the set up of the Award.

The Team is constantly looking for new topics in the field of education that deserve further attention. One of the topics that was raised is that MARQUES members, mostly outside counsel, through their line of work are frequently confronted with enquiries and questions from the public (business schools, professional associations etc) about IP matters in general. We are considering whether it would be useful to make available a basic booklet on the principles of IP/trade marks that can be distributed in response to such enquiries.

### **Geographical Indications Team**

The GI Team has been particularly active in 2008/2009, representing MARQUES at many important meetings and organizing activities to disseminate information and education in the area of GI law.

Thus, the team held the successful workshop “GIs & TMs: A double-decker? Where do we get off?”; was present at the celebration co-organized by WIPO and INPI of the 50th Anniversary of the Lisbon Agreement on Appellations of Origin (Lisbon, October 2008); organized a GI Seminar in Geneva in November 2008 at which some of the most relevant organizations took part; and prepared a Position Paper (which was submitted by MARQUES to the Commission) on the EU Green Paper on GIs and related aspects in December 2008. The Team actively contributed to the National Roving Seminars on GIs co-organized by WIPO and the State of India (Chennai, Bangalore and Kolkata in January and February 2009) and participated as an observer in the Working Group set up by WIPO to discuss possible amendments to the Lisbon Agreement. Since the last few months the Team has had a regular section (GeoNews) in the MARQUES Newsletter.

### **Membership Team**

The Membership Team set up an exclusive group within LinkedIn for MARQUES, which allows members news feeds, a discussion forum and an opportunity to seek help from experts or recommendations for legal and business assistance from other MARQUES members.

### **Unfair Competition Team**

The Unfair Competition Team conducted a deep study on look-alike issues, which recognized that there is uncertainty over identifying and legally evaluating look-alikes in the jurisdictions considered. The Team therefore considered that it would be worth drafting a practical Guide on look-alikes. The Guide was drafted by Alessandra Romeo and Andreas Lubberger with the collaboration of the rest of the Team members, and will be published and distributed to all MARQUES members. It addresses issues including: how to categorize and recognize look-alikes, whether and under what conditions look-alikes infringe IP rights, and how brand owners may consider defending their IP rights, in terms of preventive measures and substantial enforcement strategies. The Guide will be launched at the MARQUES Annual Conference in Brighton.

In the near future we will focus on revising and updating the Team’s Questionnaire on Unfair Competition Law in different European countries. The revision will take place during 2009 and 2010 and the Team will present the results during the Winter Meeting in Berlin. Apart from these projects, the Team is working on a paper concerning the Enforcement Directive and its possible effects on unfair competition and a paper that deals with the influence of case law on the relationship between trade mark protection and freedom of competition. In addition, Team member Till Lampel has represented MARQUES during several conferences in Brussels, leading to MARQUES being asked to sign a Joint Industry Letter to the European Commission on parasitic copying.

### **Trade Mark Law and Practice Team**

A major achievement for the Trade Mark Law and Practice Team during the past year has been the continued work in relation to the issue of use of class heading wording in specifications for trade mark applications in Europe – in particular, in relation to Community trade mark applications. Jochen Höhfeld of the Team raised this issue as a cause of concern and the team has considered it in some depth. Broadly speaking, the issue concerns the OHIM's practice of treating the use of class heading wording as, in effect, specifying all goods falling within the class, notwithstanding that some goods would not logically be capable of falling within any of the broad terms comprising the class heading wording.

In order to assess how this issue was dealt with across the EU, the team conducted a survey of the different practices of the National Offices compared with the practice of OHIM. The results of that survey (which are available on the MARQUES website) confirmed that OHIM's practice does not coincide with the approach of many of the National Offices. This issue was raised again with OHIM at the meeting of the OAMI Users Group in Alicante in March 2008. The Office has now changed its position and admits that its practice is at variance with that of many of the National Offices. The fact that this is a real, rather than theoretical issue has now been highlighted in the recent case of *Daimler v Sany* and the Trade Mark Law and Practice Team will continue to monitor this issue closely.

### **Cyberspace Team**

The Cyberspace Team monitors internet developments of concern to MARQUES members and over the year has attended meetings with a wide variety of organizations including national domain name registries and dispute resolution providers as well as providing information to members through MARQUES News Channels. During the past 12 months there has been a special focus on the use of trade marks in Adwords as well as the ICANN new gTLD process. Several members of the team attended the ICANN Open Meeting in Paris where Caroline Perriard of Nestlé represented MARQUES on a panel of brand owners raising concerns about the demand for new gTLDs and the importance of rights protection mechanisms. Subsequently the Team submitted comments on the two ICANN Draft Application Guidebooks and its Economic Impact study. The Cyberspace Team also coordinated the European meeting of a five-continent ICANN Consultation process designed to get the views of rights owners on trade mark protection in the new gTLDs.

### **Publications and Website Team**

The Team has been active in improving the presence of MARQUES in members' awareness and communicating the great work being carried out within MARQUES. This year the first edition of the new electronic MARQUES newsletter, which replaces the printed edition, was presented in March 2009. This exciting new format lets MARQUES publish six editions a year (a 50% increase over the paper newsletter). Not only will it report on developments and cases in and outside Europe, but it will also focus on information about the activities and achievements of the MARQUES teams.

In addition, the website has been refreshed and information on Teams' activities is now easily available for members and MARQUES. The website also now hosts the MARQUES blog on European trade mark law and practice, Class 46.