



MARQUES

Achievement List Highlights 2009-2010

Notable **MARQUES** Achievements during 2010

Input into study on trade mark system in Europe:

MARQUES members and Teams have been highly active in the past year in providing input into the European Commission's study on the functioning of the trade mark system in Europe, conducted by the Max Planck Institute in Germany. **MARQUES** has submitted written comments, alongside other users' groups, and took part in a two-day discussion of user requirements in Munich in June. Together with **AIM** and **BUSINESSEUROPE**, **MARQUES** submitted a memo identifying areas where trade mark offices can harmonise procedures. The Association has set up and maintained a page on the **MARQUES** website providing updates and background material on the study.

<http://www.marques.org/europeancommissionstudy/>

Representation before WIPO:

A delegation representing **MARQUES** visited **WIPO**'s offices in Geneva in April and held meetings with senior **WIPO** officials. **MARQUES** also attended the 2nd session of the **WIPO** Working Group on the Development of the Lisbon System and the **WIPO** Advisory Committee on Enforcement.

Trade Mark User Forum:

The 10th Trademark User Forum in Europe – a meeting between **MARQUES**, **AIM**, **BUSINESSEUROPE** and the national PTOs – was held in Brussels in March. The one-day seminar, the latest in a series, enabled users and national offices to discuss trade mark issues of concern.

Judges Meeting:

The third **MARQUES** Judges Meeting will be held in Munich, at the premises of the German PTO, in December 2010.

OHIM engagement:

Representatives of relevant **MARQUES** Teams attended the 17th **OHIM**'s Users Group Meeting in Alicante in March. **MARQUES** was also invited to attend a meeting on e-business at **OHIM** in May and it continues to have observer status on **OHIM**'s Administrative Board and Budget Committee.

Representation before the European Commission:

MARQUES has secured itself representation in the **European Commission**'s register of representatives, and prepared submissions to the EC's consultation on the review of the EU laws on customs enforcement of IP rights. In May a **MARQUES** delegation met with the EC Director for Knowledge-Based Economy in DG MARKT, Margot Fröhlinger, in Brussels. **MARQUES** has made representations to the **European Commission** to be admitted to the Observatory on Counterfeiting and Piracy as an Interested Representative Association.

UNCITRAL:

MARQUES was represented at the **UNCITRAL** Working Group VI, Session number 42, held in Vienna in March 2010. The meeting led to the publication of the **UNCITRAL** Legislative Guide on Secured Transactions, Supplement on Security Rights in Intellectual Property.

Events for Members:

The 2010 Annual Conference in Berlin was coordinated by the Programming Team, with the theme being **MARQUES** Reloaded. The Winter Meeting 2010 was held in Nice and other meetings during the year included a designs seminar in Paris and a trade marks roundtable in Düsseldorf. Various **MARQUES** Teams have worked on themed sessions and workshops for these and future events.

MARQUES Team Achievements

(Please visit <http://www.marques.org/teams> for more information on the teams)

In addition to the general achievements, the various **MARQUES** Teams have focused on specific projects. Some of their achievements are summarised on the following pages.

Amicus Curiae Team

- Submissions in the case *Nokia Corporation v Her Majesty's Commissioners of Revenue & Customs (HMRC)* to UKIPO and Polish Ministry of Economy supporting the view that goods in transit can be seized.
- Submission to the *Gerechtshof Den Haag* on the decision on *Leno Merken BV v Hagelkruis Beheer bv* (ONEL/OMEL case) supporting the view that Article 15 (1) CTMR should be interpreted in a way that it does not depend on the use of the trade mark in a specific number of EU member states but takes into account all facts and circumstances of the individual case, in line with **MARQUES** position paper.



Team Chair:
Carles Prat
Baker and McKenzie

Anti-Counterfeiting & Parallel Trade Team

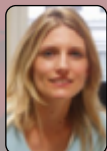
- Seminar on parallel trade to be held in Brussels in November 2010 and drafting of questionnaire (with Education Team) on parallel trade.
- Proposal for revisions to the first public draft of the Anti-Counterfeiting Trade Agreement, which is being negotiated by the EU and 10 other countries.
- Attendance at meetings of the **Global Anti-Counterfeiting Group (GACG)** and the Fifth Global Congress on Combating Counterfeiting in Mexico in December 2009.



Team Chair:
Mr Bert-Jan Van Den Akker
Dijkstra Voermans Advocatuur & Notariaat

Brands and Marketing Team

- The launch of the online Advertising Portal providing guides for **MARQUES** members to advertising regulations, cultural considerations and inappropriate trade marks, among other topics. The Portal includes examples of brands and advertisements, as well as links to other useful websites.
- Cultural survey on issues such as how numbers, flowers, dates and colours are viewed in different cultures, and in particular whether they are considered lucky or unlucky.



Team Chair:

Claire Mounteney
Marks & Clerk

China Team

- Attendance at the first meeting on the new session of the EU-China IP Dialogue, in Beijing in April 2010, and monitoring the work of the EU-China IPR SME desk.
- Examination of the recent changes to the Chinese trade mark and customs laws, and case law on trade mark enforcement.
- Representing trade mark owners' interests before **European Commission** officials in China.



Team Chair:

Mr Tan Loke Khoon
Baker & McKenzie

Cyberspace Team

- Submission of comments to **ICANN** on the Clearinghouse, the URS, the Financial Framework/Operating Budget from 2011 and the PDDRP as well as the Draft Applicant Guidebook version 4, jointly with **ECTA**.
- Organisation of joint meeting with **ECTA** and representatives of the EC Information Society & Media DG in Brussels to express concerns at **ICANN**'s proposed expansion of the domain name system with the launch of new gTLDs.
- Study of Google AdWords policies and the impact of the most recent case law of the Court of Justice of the European Union.



Team Chair:

Nick Wood
Com Laude

Designs Team

- Submissions on harmonisation of design laws to **WIPO's** Standing Committee on Trademarks, Industrial Designs and Geographical Indications (SCT) on possible areas of convergence in industrial design law and practice.
- Attendance at the 23rd session of the SCT to address industrial design law and other issues.
- Paper on the publication of registered Community designs.



Team Chair:

David Stone
Simmons & Simmons

Geographical Indications Team

- Submission in response to the **WIPO** Survey on the Lisbon System, addressing issues of concern, including the need for a study focused on the compatibility of the relevant EU regulations and the Lisbon Agreement. This followed a consultation of **MARQUES** members by a circular letter.
- Table of EU regulations, international agreements and EU bilateral treaties on GIs and a table of databases on protected GIs in the EU, Lisbon and **OHIM** databases.
- Reports on the protection of GIs designating wines and spirits in the EU.



Team Chair:

Miguel Angel Medina
ELZABURU

Intellectual Asset Management Team

- Update of the Noordwijk Toolkit on Intellectual Assets on the **MARQUES** website and compilation of Due Diligence Check List.
- Attendance at the **WIPO** seminar on The Economics of Intellectual Property.
- Preparation for three new projects: IP as an asset to be bought and sold, allocation of costs in trade mark management and ISO Certification in relation to trade marks.



Team Chair:

Boudewijn van Vondelen
NautaDutilh

IP Outer Borders Team

- Questionnaire on the impact of infringement on web hosting sites and the benefits and shortcomings of complaints procedures, as part of a study on liability of intermediary services.
- Articles on fluid trade marks in the US and Benelux.
- Examination of issues relating to religion and trade marks in Europe and beyond.



Team Chair:

Marieke Westgeest
Markenizer BV

Trade Mark Law and Practice Team

- Letter to **OHIM** regarding "extensions of term in opposition proceedings" commenting on **OHIM**'s suggestion to grant a first request for an extension of term in opposition proceedings by two months as a matter of right and to grant a second extension of term only in cases of force majeure.
- Submission of comments on **OHIM**'s proposal on how to shorten opposition proceedings.
- Survey on use of class headings and practice established by the national PTOs in Europe, following the official submissions to **OHIM**.



Team Chair:

Adrian Smith
Simmons & Simmons

Unfair Competition Team

- Guide entitled Who's Behind the Mask? defining look-alike products and providing information on how brand owners can best defend and enforce their rights against such products. The Guide includes photos of real look-alike products and a review of relevant recent decisions of the Court of Justice of the EU.
- Update of the study on look-alikes, re-launching of the questionnaire throughout the EU and expansion of the study to non-EU countries, in particular Turkey and the United States.
- Publication of article on look-alikes in Turkey.



Team Chair:

Till Lampel
Harmsen . Utescher



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