

## EDUCATION TEAM

- Organisation of the Lewis Gaze Memorial Scholarship: before the 2010 Annual Conference the Team revamped the award to make it more attractive for students to participate.
- Development of the professional accreditation project: the Team is putting together an overview of all the requirements of national associations on CLE points to see what **MARQUES** must and can do to comply with them so that members profit from their membership as much as possible.

## GEOGRAPHICAL INDICATIONS TEAM

- Chairing of the WIPO session at the **MARQUES** Annual Conference 2010 and presentation at the ACTA workshop organised at the **MARQUES** Winter Meeting 2011.
- Attendance at the third session of the WIPO Working Group on the development of the Lisbon System; presentation at the Worldwide Symposium on Geographical Indications co-organized by WIPO and Peru and submission of comments on GIs to OHIM and to the Max Planck Study.
- Publication online of table of national databases on protected GIs and regular publication of GeoNews in the House**MARQUES** newsletter.
- Participation as invited speaker in the WIPO's World Symposium on GIs, which was held in Lima, Peru in June this year.

## INTELLECTUAL ASSET MANAGEMENT TEAM

- Publication of five asset management-related articles in House**MARQUES** Newsletter covering trade mark management in difficult times, IP due diligence, new product development, ingredient branding and managing historic brands.
- Update to the Noordwijk toolkit on intellectual assets on the **MARQUES** website, with new information added.
- Development of a project on IP as an asset to be bought and sold: the Sub-Team working on this project has drafted a strategy, addressing questions including the state of the market for trade marks as commodities, the future for trade marks as commodities and what trade mark sellers/buyers can learn from other IP markets.
- Development of the allocation of costs in trade mark management project: this will identify similar surveys, conduct pilot industry studies, identify criteria to collect comparative data, and then draft and finalise a questionnaire.
- Conclusion of ISO certification in relation to trade marks project with an article in House**MARQUES**, following the first edition of the International Standard ISO 10668 Brand Valuation.

## IP OUTER BORDERS TEAM

- Workshop on intermediary liability for trade mark infringement at the Annual Conference 2010: an accompanying paper was circulated on the use of trade marks in hosting sites and a related article on the landmark US case Tiffany v eBay was published in the House**MARQUES** newsletter.
- Recommendation that the INTA include a session on the cutting edge issue of fluid trade marks: Team members presented on the topic at the 2010 INTA Leadership Meeting and also conducted two INTA table topic discussions at the 2011 INTA Annual Meeting.

## MADRID PROTOCOL TEAM

- Promotion of the Madrid Protocol system in South American countries, in support of WIPO's initiatives and in coordination with other IP organisations: a breakthrough occurred this year with the approval of the Protocol by the Colombian Senate, meaning that Colombia will soon become the first South American country to join the international trade mark system.
- Broadening of Team mission to promote the Madrid System in any countries that are still not members (the Team was formerly named the Protocol in South America Team). Priorities include the Asean countries and a representative of Council working with the Team joined a WIPO-sponsored mission to Thailand and the Philippines to discuss latest developments. **MARQUES** is also discussing joining a mission to Malaysia and Indonesia later this year.

## REGULATORY TEAM

- Delivery of a workshop on brands and product placement rules worldwide at the 2011 Annual Conference: the Team has gathered information on product placement advertising requirements from a broad selection of countries or territories. The presentation will address many types of media in which products may be displayed, and will provide a starting point for those who deal with placement of their company's or clients' goods.
- Submission of position papers to the EU Commission, as well as the Australian government, on the proposed plain packaging regulations in these regions. These submissions objected to the loss of trade mark rights that plain packaging would cause and the conflicts between trade mark rights under existing international treaties and the proposed plain packaging regulations.

## STUDY TASK FORCE TEAM

- Assisting the preparation of comments on the OHIM Strategic Plan, in February 2011, broadly welcoming the proposals and highlighting the need for transparency, efficiency, consistency and continuing consultation.
- Submission of detailed point-by-point comments in response to the Max Planck Institute study on the trade mark system in Europe and attendance at a meeting of users in Brussels.
- Circulation of list of issues that the Commission should consider in reviewing the trade mark system: streamlining of conversion procedures; system of precedents; harmonisation of enforcement practice, unfair competition law, design law and customs practices; specialist chamber of the General Court; and procedures at the Court of Justice.

## TRADE MARK LAW AND PRACTICE TEAM

- Publication of position paper supporting the Norwegian Proposal to abolish the basic mark requirement for the Madrid System, suggesting not replacing the central attack provision by any measure with similar effect.
- Submission of response to the European Commission's 2010 IPR Survey on IP enforcement in third countries, commenting on the protection and enforcement of IP law in African countries.
- Participation in the WIPO 9th Session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks in July 2011.
- Participation in the Search Image project of the Cooperation Fund, and application for participation in the Future Software Package project to be implemented within the Package 2 projects.

## UNFAIR COMPETITION TEAM

- Participation in a plenary panel discussion at the 2010 Annual Conference discussing the legal framework and practical consequences when protecting original products against look-alikes and leadership of a workshop analysing the CJEU's L'Oréal v Bellure decision, its practical consequences and subsequent court decisions.
- Publication of the guide "Who's behind the Mask?" advising on look-alike issues on the website: the Team has added a document with newer look-alike case law from various countries.
- Planning of an update to a questionnaire on the legal framework applying to look-alikes country-by-country (EU and non-EU): this will be converted into a searchable database and distributed at the 2011 Annual Conference.

# MARQUES

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# MARQUES

## ACHIEVEMENT LIST 2010/2011

## REPRESENTATION BEFORE OHIM

The status of **MARQUES** as a permanent observer at OHIM's ABBC – the Administrative Board and Budget Committee has been confirmed until 2014. **MARQUES** has also secured representation in the Cooperation Fund Programme.

**MARQUES** responded to OHIM President Antonio Campinos's Strategic Plan 2011-2015, published in May this year, and has also recently provided a response to the President's letter on the OHIM Convergence Programme, aimed at reaching an enhanced level of harmonisation on trade mark practices amongst the European IP Offices, suggesting which projects should be included in the forthcoming work plan.

In March **MARQUES** representatives met with Mr Campinos and a delegation of his Cabinet in Brussels and in April a delegation visited Alicante for the annual OHIM Users Group meeting. There is also regular contact with OHIM's IAERD – Institutional Affairs and External Relations Department regarding e-business services, CTM publication, the functioning and efficiency of the proceedings before the Office, etc.

## EUROPEAN UNION ACTIVITIES

**MARQUES** has been closely engaged with European Commission IP policies and has regularly provided responses to consultations launched by the Commission in connection with IPR protection and enforcement matters, notably on the European Commission's Report on the enforcement of intellectual property rights and the planned review of the Tobacco Directive, criticising the plan to introduce plain or generic packaging. Comments were also addressed to the Australian Government and MPs regarding the proposal this year to pass a plain packaging bill in Parliament.

**MARQUES** participated in the RAND Europe survey run on behalf of the European Commission regarding a study on a methodology for counterfeiting and piracy in Europe, in March this year. A review of the European Commission's proposal for a Regulation entrusting the management of the Observatory to OHIM and of another concerning customs enforcement of intellectual property rights is ongoing.

**MARQUES** received confirmation of its appointment as a member of the Observatory on Counterfeiting and Piracy. Next October, **MARQUES** will attend the meeting of the private sector members of the Observatory, organised by DG Markt, with a view to updating the members on progress of the Observatory draft Regulation, the Memorandum of Understanding between the Commission and OHIM and the RAND Europe study.

**MARQUES** continues to follow closely developments regarding the reform of trade mark protection in the EU. The Association published a response to the Max Planck Institute study on the trade mark system in Europe, and attended a meeting of users' groups in Brussels in May. It also hosted a workshop on the study in London in April.

**MARQUES** members have also been monitoring the EU IPR Dialogues, notably with China, Russia and Turkey.

At the European Parliament, **MARQUES** joined with other IP associations to comment on the debate about the ratification of ACTA.

## REPRESENTATION BEFORE WIPO

**MARQUES** participated in a WIPO-sponsored mission to Thailand and the Philippines to promote the Madrid system. Representatives also took part in meetings of the WIPO Standing Committee on Trademarks, Industrial Designs and Geographical Indications and the Lisbon Agreement Working Group. A paper was submitted to the Ad Hoc Working Group on the Legal Development of the Design System

**MARQUES** participated as an invited speaker in WIPO's World Symposium on GIs, which was held in Lima, Peru in June this year.

## JUDGES MEETINGS

The third Judges Meeting was held in Munich, Germany in December 2010. The fourth Meeting will be held in the Netherlands in November, and there will also be a second Meeting in Germany in the same month. The fifth Meeting will be held in the UK, and a repeat of the first Meeting in Spain is planned for 2012.

## EVENTS FOR MEMBERS AND OTHERS

**MARQUES** organised a number of members' events during the year. As well as the Annual Conference 2010 in Berlin and the Winter Meeting 2011 in Madrid, there was a one-day seminar on parallel trade in Brussels in January, a dinner meeting in Toronto on cost-effective trade mark strategies for Europe in May and a half-day seminar on trade marks in a global market in Buenos Aires in June.

**MARQUES** was formally represented at a number of other events, including the ICC-BASCAP meeting of Anti-counterfeiting Leaders in Paris in February, a conference on well-known and famous trade marks organized by the University of Law in Geneva, also in February, and the annual Joint Meeting of the European Sister Associations, which was hosted in London by ITMA in early March.

## PUBLICATIONS

In addition to its own publications for members, **MARQUES** has contributed articles to the WTR Yearbook 2011, the WIPR Digest 2010 and the WIPR Annual Review 2011.

# MARQUES TEAM ACHIEVEMENTS

## AMICUS CURIAE TEAM

- Submissions to CIPA as well as to the Benelux, Czech, German, Polish and Portuguese offices in the IP TRANSLATOR case regarding the use of the general words of the class headings in the Nice International Classification of Goods and Services to be interpreted in accordance with Communication 4/03 of the OHIM President.
- Organization of a workshop at the 2010 Annual Meeting on five EU cases: Realchemie Nederland v Bayer CropScience; Interflora v Marks & Spencer and Flowers Direct Online; Nokia Corporation v Her Majesty's Commissioners of Revenue and Customs; Budějovický Budvar v Anheuser-Busch; and The Chartered Institute of Patent Attorneys v Registrar of Trade Marks.
- Cooperation with the European Sub-Committee of the International Amicus Committee of INTA is being discussed.

## ANTI-COUNTERFEITING AND PARALLEL TRADE TEAM

- Preparation of a submission in response to the consultation on the European Commission Report on the implementation of the Intellectual Property Rights Enforcement Directive.
- Representation at meetings of the EU Observatory on Counterfeiting and Piracy; the WIPO Advisory Committee on Enforcement; and the UN/ECE Team of Specialists on IP, promoting **MARQUES** policies on co-operation on IP protection and enforcement.
- Preparation of proposals to improve Indian Customs laws.
- Participation in the series of EU IPR dialogues with countries outside the EU where potential difficulties arise with IP enforcement. Recent meetings concerned Turkey and Russia.
- Organization of a workshop at the 2011 Winter Meeting on the ACTA treaty, in collaboration with members of the Amicus Curiae and the Geographical Indications Teams

## BRANDS & MARKETING TEAM

- Establishment of the Famous and Well-Known Marks Sub-Team, following the proposal submitted to Council by a member of the Unfair Competition Team.
- Examination of various aspects of green marketing issues, such as ethical branding and fair-trade certification marks, as well as the impact of the Olympic Games on trade mark owners.
- Development of a research project concerning advertising materials required as evidence in trade mark disputes: this will be developed into a tool kit to help brand owners assess the precise nature and urgency of proof required in trade mark proceedings in various jurisdictions.
- Upgrade of content on and accessibility of the Team's website, which includes the advertising regulation project and the cultural survey examining the international significance of certain symbols, numbers, words, colours and flowers.

## CHINA TEAM

- Publication of two articles, on preliminary injunctions in China and intermediary liability in China, on the **MARQUES** website. A one-day seminar on intermediary liability is to be held in Beijing.
- Attendance at meetings relating to the 7th EU-China IP Dialogue, where industry representatives provided the Commission with comments on the draft agenda and related topics. The Commission requested further information from **MARQUES** on the Memorandum of Understanding and Customs action. Other issues raised included the registration of European trade marks, particularly in the wine industry, in China; inconsistent opposition decisions; the definition of bad faith; the possibility of unregistered designs in the clothing business; and enforcement.
- Attendance at meetings of the EU-China IP Working Group in Shanghai and Beijing to address and monitor recent IP development in China: comments were submitted on the new judicial opinions regarding criminal IP cases and on the email sent by UNIFAB to the Commission.

## COMMUNICATION AND MEMBERSHIP TEAM

- Merger of the former Publication and Website Team and the Membership Team into this new team, appointment of Team members to new roles and redesign of the relevant part of the **MARQUES** website.
- Implementation of **MARQUES** Class 46 blog, redesign of the News Channel and change of the name of the Newsletter to House**MARQUES**.
- Considerable growth in visits to the **MARQUES** website, and management of **MARQUES**'s presence on social media networks Facebook, LinkedIn and Twitter.
- Entering into an agreement with Martindale.com Connected providing a professional social network for lawyers and paralegals and also with Darts IP for cooperation granting marketing possibilities and member advantages in the future.

## CYBERSPACE TEAM

- Release of three papers: a beginners' guide to domain names; a collection of profiles of European domain registries; and a study of internet developments in China and Hong Kong.
- Submission of comments on the ICANN draft guidelines, which helped ICANN realise that legal measures were necessary to insert a minimum legal/IP standard into the guidelines.
- Workshop on IDNs during the Winter Meeting in Nice in 2010.
- Focus on the new gTLD programme coming in 2012 and on legal perspectives related to social media, keywords and smartphone applications.

## DESIGNS TEAM

- Release of fourth edition of the Review of Registered Community Designs Validity Decisions, now covering over 700 decisions of OHIM, the General Court and the Court of Justice.
- Representation as an observer at the WIPO Standing Committee on Trade Marks, Industrial Designs and Geographical Indications, presenting several position papers to encourage member states towards a treaty to harmonise worldwide design filing practice and procedure for the greater ease of users.
- Representation at discussions to update the Locarno Convention on classification for design purposes, and submissions to the UK government to remove defences for innocent infringement and to the members of the Hague Convention on simplifying the International Registration system.