



MARQUES

THE EUROPEAN ASSOCIATION OF TRADE MARK OWNERS



**CHAIR REPORT
AND
NOTABLE
ACHIEVEMENTS
2012/2013**

MARQUES Chair Report

The first six months as Chair of MARQUES have been busy, but I have enjoyed every minute so far. Being surrounded and supported by this many qualified and passionate IP professionals is simply fantastic.

Again this year many MARQUES representatives have been active in representing the brand owners' interests in Europe and abroad.

With pleasure I look back to the various formal and informal meetings with OHIM and WIPO officials, and this year, MARQUES hosted a successful annual European Sister Organizations meeting in Torino.

I strongly believe in joint efforts, and the sum being so much more than the separate parts. Therefore I will strive to build further upon the positive relationships with our peers in the IP world. We have much in common, but I am also very, very proud that MARQUES has very strong and unique selling points.

Within our Council and our Teams, we have not only an incredible level of expertise that we all can profit from, there is a solid understanding about what it is that drives brand owners, their in-house counsel and other IP professionals in the widest sense.

We continue to focus on brand owners' interests first. We are also looking into a further professionalization of our association, so that we are even more able to protect and promote these interests.

There would, however, be nothing to report if it were not for our Teams, the backbone of our association. The impressive level of professionalism, knowledge and fast responsiveness would almost make one forget that it is all done by volunteers (!) who all have highly demanding jobs. A big thanks to all our Teams which have been very active again this year as you will see from the list of notable achievements below.

I am proud to be the Chair of this organization. I cannot thank enough our Council and Executive Committee members, our Executive Director, our External and Internal Relations Officers, and our Secretariat who have all been such a huge support to me in the last months. Not to forget our Treasurer, who keeps us on the right track and financially healthy, as well as our Social Media Coordinator and Media Specialist, through whose efforts MARQUES and its activities are brought to the attention of the wider IP world, sometimes quicker than you would imagine possible.

Finally, I would like to thank you, our members, for your ongoing support and loyalty. Especially for new members: please always feel free to speak up or ask questions. I invite you to participate in our continued efforts to be the best association for brand owners that we can be.



Warm regards,

Diana Versteeg

Chair of MARQUES

European Union activities

In response to the EU Commission's trade mark reform proposals, MARQUES published an Information Note and held a seminar/webinar. MARQUES also presented a list of most important issues at a meeting with the European Parliament Working Committee in June, and continues to have a dialogue with the Commission and Member States. MARQUES will have a speaker at the EU Presidency's IP Event in October this year. The response is led by the Study Task Force, which has members representing all relevant areas. Further information is available at www.marques.org/europeancommissionstudy.



The **Anti-Counterfeiting & Parallel Trade Team** met representatives of the European Commission to discuss the new **Customs Regulation** and the need for trade mark law reform to deal with counterfeit goods transiting through the EU.

MARQUES submitted comments to the European Parliament regarding the proposal for a **Regulation on Geographical Indications**, which the **Geographical Indications Team** was responsible for.

The **China Team** attended meetings of the **EU-China IP Working Group** in Brussels, Shanghai and Beijing and the **GACG Annual Meeting** in Beijing.

The **Regulatory Team** published a position paper with regard to the European Commission's proposal for a revised **Tobacco Products Directive (TPD)** and submitted comments to the UK Department of Health's Consultation on **standardised packaging of tobacco products**, which the **Regulatory Team** worked on. A submission was also made to the Republic of Ireland's Department of Health WRT Public Consultation on a proposal for an EU Directive on the Tobacco Products Directive (TPD).

Representation before OHIM



In its role as a permanent observer, MARQUES participated in the **OHIM Administrative Board and Budget Committee** meetings in Alicante. It has pushed for improvement on timing and quality standards on opposition and cancellation decisions, increased harmonisation of practices notably on classification issues and also tabled the issue of lack of harmonisation of the EU laws on lookalikes.

“MARQUES has been active in various cooperation and convergence projects and meetings at OHIM”

MARQUES has been active in meetings at **OHIM**, led by members of the Trade Mark Law & Practice Team. These include: the **OAMI Users Group Meeting**; the **9th Liaison Meeting on Trade Marks**; working group meetings on **OHIM's**

Convergence Programme projects CP1/CP2 (classification/class headings), the new OHIM Website Project and the Cooperation Fund I projects E-Learning and Search Image. MARQUES representatives have also participated in user acceptance tests on TM Class and Taxonomy.

MARQUES was represented at the OHIM Trade Marks and Designs Liaison Meetings. Members of the **Designs Team** also participated in OHIM's 10 Years of Community Design conference in Alicante in April 2013 and in the design sessions at the TM5 meeting between the registries of OHIM, the United States, Korea, China, Japan and WIPO.

The **Anti-Counterfeiting & Parallel Trade Team** provided comments on behalf of MARQUES on the priorities and role of the **European Observatory on Infringements of Intellectual Property Rights**. The MARQUES chair participated in the 1st Plenary Meeting of the Observatory and members of the Team took part in the Private Sector Stakeholders' Meeting of European Observatory in Brussels.

MARQUES submitted comments on GI-related matters in the OHIM Manual, which were prepared by the **Geographical Indications Team**.

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Representation before WIPO

The **Anti-Counterfeiting & Parallel Trade Team** represented MARQUES at the eighth session of the WIPO Advisory Committee on Enforcement.



MARQUES has been represented on the Madrid System Working Group and proactively works with all relevant stakeholders, including WIPO, to promote and develop the Madrid System.

Members of the **Designs Team** are representing MARQUES on the Locarno Agreement Working Group, the Hague System Working Group and the Standing Committee on Trademarks, which is discussing an international treaty to harmonise design filing practice.

"At WIPO, MARQUES Teams have taken part in discussions on enforcement, designs, geographical indications and the Madrid Protocol"

Members of the **Geographical Indications Team** were present on behalf of MARQUES at the 6th and 7th Sessions of the WIPO Working Group on the Development of the Lisbon System and also at the World Symposium on GIs in Bangkok.

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Events

The **Annual Conference 2012** was held in Athens, and was attended by more than 600 trade mark professionals. The **Programming Team** coordinated the professional programme and social activities. The **Famous & Well-Known Marks Team** organised a session on issues in the lifetime of a famous and well-known mark. Members of the **IP Outer Borders Team** presented on fluid trade marks. The **Geographical Indications Team** and **IP Outer Borders Team** jointly hosted a workshop on Indigenous Peoples' Rights in Athens. The **Regulatory Team** hosted a workshop on the role of trade marks in packaging and branding, and plain packaging. The **Brands & Marketing Team** hosted a

workshop on best practices for marketing departments and brand owners when collecting and storing the evidence required in trade mark proceedings; a check list is now posted on the MARQUES website. The **Education Team** plan the annual Lewis Gaze Memorial Scholarship, which was presented in 2012 to Asimaki-konstantinos Alexopoulos, for a paper on parallel imports and trade mark law.



The **Spring Meeting** for MARQUES Council and Teams was attended by more than 140 people. It included the first Kay Uwe Jonas Memorial Lecture, given by Professor Joachim Bornkamm. The second Memorial Lecture will be held at the Spring Meeting 2014 in Amsterdam, which the **Programming Team** is now planning. The **Famous & Well-Known Marks Team** hosted a workshop discussing the threat of famous marks on the edge of genericness. A questionnaire on the threat of genericness was issued to 27 jurisdictions and there was a presentation on the responses to the questionnaire.

The **China Team** hosted a seminar in Shanghai titled Brand Protection in China and Europe in the 21st Century When West meets East to Join Forces in Brand Protection.



Two workshops on **Drafting Coexistence Agreements** were held in the Netherlands and

Germany. These were prepared by the **Education Team**.

A webinar on the Community Design was co-presented by MARQUES and the American Bar



Association (ABA), as part of cooperation between the two associations.

MARQUES continues to organise **Judges Meetings** throughout the EU, enabling practitioners in various countries to hear from and ask questions of their local judges. In the past year, Judges Meetings have been held in France, Germany, the Netherlands, Spain, Belgium and the UK. Many MARQUES members from various Teams have participated.

"Judges Meetings have been held in France, Germany, the Netherlands, Spain, Belgium and the UK in the past year"

Communications

MARQUES, led by the **Communications & Membership Team**, has been developing its **online presence**, with the redevelopment of the MARQUES website and the introduction of the Class 99 blog on designs to supplement the growing Class 46 blog. The HouseMARQUES now includes news and contributions from representatives of MARQUES Teams, as well as a regular HouseMARQUES interview.

The **China Team** has circulated **updates on IP developments in China** such as the draft PRC Trademark Law and the top 10 cases concluded by the Supreme People's Court. It has also published a booklet covering the top 10 things about IP in China and flowcharts of various trade mark proceedings.

The **Trade Mark Law & Practice Team** has published updates on the status of the **Madrid System in African countries**.

The **Cyberspace Team** has published a **multi-country survey on search engine keywords**; a **summary of registry formalities for gTLDs and ccTLDs**, and updates on the ICANN new gTLD initiative.

The **IP Outer Borders Team** created a guide to **Corporate Social Media Policy Best Practices**.

The **Geographical Indications Team** guest-edited a **special issue of JIPLP on geographical indications**.

The **Unfair Competition Team** has **updated its pages on the MARQUES website**, with new categories and case law on lookalikes from various countries.

Industry cooperation

MARQUES hosted a meeting of the sister IP associations in Turin in March 2013.

"MARQUES is closely involved in ICANN's new gTLDs launch, in particularly regarding IP rights protection mechanisms"

The **China Team** has developed a strategic relationship with the **China Trademark Association**.

MARQUES, led by members of the **Cyberspace Team**, participates with other IP associations in ICANN's **Intellectual Property Constituency (IPC)**. It has also taken part in briefings sessions with Deloitte on the **Trademark**



Clearinghouse and with WIPO on the UDRP.

MARQUES published a joint statement with the sister IP organisations on **plain packaging and its denigration of trade mark rights**, an issue which the **Regulatory Team** has worked on.

Other activities

MARQUES is strongly engaged with ICANN's **new gTLDs launch**, and has drafted comments to the ICANN Board on rights protection in the new gTLDs. The **Cyberspace Team** has contributed to Internet governance discussions, and in particular rights protection, including by attending and speaking at ICANN Meetings in Prague, Toronto and Beijing and meeting with government officials from the EU, the UK, Australia, Brazil, Canada and the United States.

Members of the **Anti-Counterfeiting & Parallel Trade Team** represented MARQUES at the **IP Protect Expo 2013** event in London.

MARQUES submitted comments on the **proposed changes to US trade mark law**, which were prepared by the **Trade Mark Law & Practice Team**.

The **Famous & Well-Known Marks Team** has conducted questionnaires covering 27 countries on: different terms indicating notoriety (reputation, famousness, well-known-ness etc); the different methods to show notoriety; the existence/omission of extra provisions and national approach towards dilution.

The **IP Outer Borders Team** has done further research on fluid trade marks and created a **Pinterest page** collecting fluid mark exemplars and resources available at <http://pinterest.com/fluidmarks/>

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