

Class 99 blogs provide useful analysis of trade mark and design developments, written by **MARQUES** members. You can also follow **MARQUES** on Facebook, LinkedIn and Twitter.

House**MARQUES** now includes “Field Notes”, a regular column focusing on truly unusual trade marks, written by members of the IP Outer Border Team. Longer versions of many of the articles included in House**MARQUES** are available on the Team pages of the **MARQUES** website. Also on the website is a regularly reviewed and updated Book List.

The Unfair Competition Team published a booklet, “Jurisdictional Approaches to Fair Use of Trademarks and the Intersection between Trademark Law and Freedom of Speech”, in 2014.

The article “Everything you need to know about environmental labelling” written by members of the Brands & Marketing Team was printed and distributed at the Annual Conference.

RESOURCES FOR MEMBERS

The **MARQUES** website includes numerous resources for trade mark practitioners, which can be accessed via the Document Library.

Current and planned projects include: a compilation of databases on the treatment of parallel imports in different territories; flowcharts on the PRC trade mark prosecution, opposition, cancellation and civil litigation processes; charts on the results of a questionnaire investigating the meaning of different terms indicating notoriety (reputation, famousness, well-knownness etc) in 27 jurisdictions and on different methods to evidence notoriety as well as on dilution; and a checklist for marketing departments.

The Famous and Well-Known Marks (FWKM) Team is compiling projects on a best-practice checklist on how to avoid the risk of genericness; famous and well-known trade names; a red-flag list of typical traps regarding FWKM protection; and how to handle brandjacking problems in social media.

The IAM Team is working on a project on the allocation of costs, concerning the way in which in-house IP functions are structured and resourced.

The Unfair Competition Team’s three sub-teams are working on the following topics:

- national courts’ views on the use of market surveys as evidence in trade mark and unfair competition cases;
- analysis comparing actual consumers’ perception of brands and look-alikes with what judges believe consumers perceive;

- the EU Commission’s public consultation on misleading and comparative advertising.

PARTNERSHIPS

MARQUES continues to work closely with other IP associations on issues of common interest. Highlights from the past year include: the development of a strategic relationship with the China Trademark Association (led by the China Team); discussions with the European Law Students Association in Denmark and the UK; and cooperation with the American Bar Association.

During 2014, **MARQUES** Team members participated in meetings and conferences hosted by AIPPI, INTA, the Global Anti-Counterfeiting Group, the EU-China IP Working Group and ICANN.



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MARQUES

ACHIEVEMENT LIST 2013/2014

CHAIR REPORT AND NOTABLE ACHIEVEMENTS 2014

My two-year term as Chair of **MARQUES** is passing by very fast, and the proverb "time flies when you are having fun" certainly applies here. Please allow me to repeat myself here: being the Chair of this association, surrounded by so many skilled and motivated volunteers and members, is a privilege.

When I flip through the list of the past year's achievements I can hardly believe it, and I feel really proud of **MARQUES**. There were so many developments taking place simultaneously in the field of trade marks, designs, domain names and geographical indications that it is impossible to properly summarise them.

Again this year we shared our view on different legal topics in amicus briefs, joint papers, presentations and workshops. We participated in meetings initiated by OHIM, OHIM's Anti-Fraud Network, the EU Observatory, the European Commission and Parliament, ICANN and of course also WIPO.

We were actively involved in the plain packaging debate and we are continuously following and arguing about the reform of the European trade mark legislative package.

We have had "Meet the Judges" seminars in Spain, Italy, France, Belgium, the Netherlands, Germany and the United Kingdom, and this year we added Poland, Austria, Finland and Bulgaria to our list. We have also developed the programme of co-existence agreement workshops, which have taken place in many cities.

There simply is too much to mention, and really whatever I would say here would not reflect the amount of time and effort that has been put into all these projects, nor would it do justice to the people behind them. Therefore I will stop trying to summarise it and let the Achievements List speak for itself.

We are clearly on the right track here, and our last Annual Conference in Copenhagen demonstrated that a growing number of IP professionals agree with this. In the coming years we will assess whether we can continue to grow in a sustainable way while safeguarding our high quality and unique selling points.

Thanks to our Teams, our members and our staff, **MARQUES** is perceived as a trusted business adviser by all the European and global institutions in the field of IP. The burden to perform is sometimes heavy, especially when there are short deadlines, and therefore I would like to take this opportunity to say to all of you out there:

THANK YOU SO MUCH!

Warm regards,
Diana Versteeg
Chair of **MARQUES**



OHIM AND THE OBSERVATORY

MARQUES takes part in various groups and official meetings at OHIM, representing the interests of brand owners, in its position as permanent observer before the Office. These include the OAMI Users Group Meeting; the working groups on the Convergence Programme (CP) projects (CP1 and CP2); and the Liaison Meetings on both Trade Marks and Designs. Through its Anti-Counterfeiting and Parallel Trade Team, **MARQUES** also monitors the activities of the EU Observatory on the Infringement of Intellectual Property Rights and of its Working Groups, and ensures the proper representation of its membership in both the Plenary meetings and the private stakeholders sector meetings.

When required, **MARQUES** provides input in connection with proposed amendments to OHIM's CTM and RCD Guidelines, thanks to the valuable input of both the Trademark Law & Practice Team and the Designs Team.

EUROPEAN UNION

The reform of the European trade mark systems is the most important legal development for trade mark owners in Europe since the inception of the review of the legislation in 2010.

MARQUES has set up a Task Force, comprising members of various relevant Teams, to monitor and influence developments. At least eight position papers have been published and meetings were held with key individuals of the European Commission, the European Parliament and the IP and business community leading up to the vote in Parliament in early 2014. The Trilogue negotiations between the Commission, Parliament and Council began towards the end of 2014, and **MARQUES** took part in the debate by distributing a final position paper on the top 20 most important issues for brand owners.



MARQUES is keen to preserve the independence of OHIM and to safeguard the financial autonomy of OHIM and national offices. **MARQUES** supports the abolition of relative grounds examination and the establishment of administrative opposition and cancellation procedures, and takes an active part in the discussions on goods in transit. **MARQUES** is in favour of increased harmonisation and supports cooperation projects.

MARQUES Teams have also been involved in other EU activities including: attending the second EU Customs meeting for right holders and stakeholders to combat IPR infringements in Brussels; submitting comments on the Green Paper on the possible expansion of geographical indications to non-agricultural products; submitting a response to the European Commission's Public Consultation on the Review of the EU Copyright Rules; and considering whether to comment on the Commission's proposal for a directive on trade secrets. Documents submitted on these and other topics can be downloaded from the Position Papers section of the **MARQUES** website.

The **MARQUES** Amicus Curiae Team and Council review pending CJEU and other cases to decide when it is appropriate to file amicus briefs.

WIPO

Representatives of **MARQUES** Teams have attended numerous meetings at WIPO where they have made formal submissions to represent the views of the association. These include: the Madrid System Working Group Meeting, in particular regarding the proposed freeze of the dependency between the basic mark and the international registration and of the central attack and Replacement in International Registrations; the WIPO Madrid Fee Management Project; the Hague Union Working Group; and the Standing Committee on Trademarks (where topics include a proposed international treaty to harmonise design filing practice, as well as work on domain names and country names). Members of the GI Team have taken part in all of the Working Group meetings on the Lisbon Agreement concerning geographical indications and **MARQUES** is expected to be a non-governmental observer at the Diplomatic Conference in Geneva in May 2015. Members of the Madrid Protocol Team are monitoring activities in countries that are about to join the Madrid Protocol.

WTO

At the World Trade Organisation, **MARQUES** has written a brief for the proceedings concerning the complaint against the Australian plain packaging legislation regarding tobacco products. The brief states that the Australian legislator failed to justify the law in the context of the TRIPs Agreement. The brief will be submitted by March 2015. **MARQUES**, led by the Regulatory Team, also contributed to the Joint Statement - Reflection on the adoption of plain packaging legislations issued by APRAM, BMM, ICC-BASCAP, ECTA, **MARQUES**, UNION DES FABRICANTS and UNION-IP. It has made submissions on the same topic to the governments of New Zealand, the UK and Ireland.

MARQUES, in common with the other associations, calls upon national member states not to introduce any extreme legislation or policy options which will preclude, whether fully or in part, brand owners from the ability of making legitimate use of their trade marks, undermine the legal protection offered by IPRs and fundamental rights as required by plain or standardized packaging or measures tantamount to standardized packaging and may increase the prevalence of counterfeit and illicit goods.

EVENTS

The 2014 **MARQUES** Annual Conference in September was the largest ever. Many Teams put together panels and there were workshops on GIs, the



design process, crisis management, new gTLDs, the new Chinese Trade Mark Law and food labelling legislation. The annual Lewis Gaze Memorial Award was presented to three Danish students. Members and newcomers alike appreciated the educational sessions and social programme, and a number of publications reported events, including Managing IP, Trademarks and Brands Online, World IP Review and World Trademark Review.

The Spring Council and Team Meetings were held in Amsterdam in March, and Professor Dirk Visser of Leiden University gave the second annual Kay Uwe Jonas Memorial Lecture.

During the year, **MARQUES** also hosted Judges Meetings and Coexistence Agreement Workshops throughout Europe. These have recently been extended to Latin America, with events in Argentina, Mexico, Paraguay and Peru among those planned. In June, the Cyberspace Team hosted a Webinar on Social Media and m-Commerce, attended by about 60 people. It can be viewed online.



Thanks to work by the Education Team, certificates of attendance are now available from the Secretariat on request for any **MARQUES** conference, workshop or seminar.

PUBLICATIONS

The House**MARQUES** email newsletter is published monthly and keeps members up to date with **MARQUES** news and activities, while the Class 46 and

