

In the last presentation, Prof Dr Olaf Sosnitzka, University of Würzburg, addressed trans-border aspects of Community trade mark law. In this session, Guido Baumgartner presented the brand owner's position.



“**Dr Hildebrandt presented his provocative opinion that national trade mark rights in the European Union were superfluous.**”

The seminar was closed by Dr Alexander Dröge of Markenverband and Guido Baumgartner in his role as chairman of **MARQUES**.

On behalf of **MARQUES** Paola Tessarolo, Ingrid de Groot, Till E Lampel, Dr Andreas Lubberger and Kay Uwe Jonas had organised and participated in the seminar.

Madrid reforms thanks to **MARQUES**

An important change to the Madrid Protocol came into effect in January, partly thanks to **MARQUES members who raised the issue at WIPO and worked with member states to reform the system.**

As of January 1, national offices are obliged to provide a statement of grant of protection for each International application.

The change, which is designed to provide more security for international trade mark owners, was agreed by member states in September 2008. It came into effect on 1st September 2009 but there was a transitional period before national offices had to comply.

“The whole system for 100 years has been run on the basis that if there is no refusal, then protection is granted – basically no news is good news,” Ernesto Rubio, special counsel at WIPO, said. But he added it had become apparent in recent years that this did not give enough certainty to trade mark owners. “It can be difficult if you don't have any document saying the right is recognised.”

Changes to Rule 18

The most important change was to a paragraph in Rule 18ter providing that when “all procedures

before an office have been completed and there is no ground for that office to refuse protection” the office shall, as soon as possible and before the expiry of the applicable refusal period, send the International Bureau a statement saying that protection is granted.

Rule 18ter also says that where an office sends a notice of provisional refusal, it should send the International Bureau information on which goods and services the mark is protected for, or a statement saying it concerns all goods and services.

Rule 18bis says that where there are opposition procedures an office may send “a statement to the effect that the ex officio examination has been completed and that the Office has found no grounds for refusal but that the protection of the mark is still subject to opposition or observations by third parties, with an indication of the date by which such oppositions or observations may be filed”.

Ernesto said many of the 83 member states have already started to notify the International Bureau, ahead of the January 1 deadline. Some have done so by sending regular lists of non-refused marks electronically.

WIPO processes this information, which is published in the ROMARIN database. This means it is accessible to third parties as well as to the mark owners.

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The role of MARQUES

MARQUES raised the need for greater clarity for Madrid Protocol applicants as far back as 2005. After the matter was discussed in the Working Group on the Madrid System, a number of national delegations recognised the benefits of providing more information to both trade mark owners and interested third parties, and support for the change built up over successive meetings.

Tove Graulund was chair of **MARQUES** at the time and in-house counsel for Danish company Arla Foods. She said after Denmark joined the Madrid System in 1996, applicants could choose between national, Community and international protection, which led to some confusion. “With the Madrid System, you had to wait,” she says. “The registration in each country might have happened but you didn’t know.”

For applicants who were not used to what was still a relatively new system, this uncertainty could be a problem, she added. “Sometimes someone in the business would want to know what protection we had, and you would have to check.” Other times, faced with no information, applicants would fear that an application had been lost or was at risk of being refused.

Requiring offices to provide a formal notification that a registration had been granted would therefore benefit both the applicant itself and third parties who want to monitor what rights are protected, Tove explained.

But, when she attended a Working Group meeting in Geneva in her capacity as **MARQUES** Chair in 2005, she said some member states representatives did not see what the problem was: “They looked at me as if I’d fallen from the moon.”



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Ernesto Rubio, WIPO



Ernesto Rubio said that once member states understood the problem support increased: “A number of delegations were very much in favour of providing more information to trade mark owners about the fate of trade mark registrations.”

He added that “some thought it would provide more work for offices” but that they showed a readiness to adapt their procedures, provided there were interim measures.

Meanwhile, organisations such as INTA added their support to the plans and the International Bureau indicated that it was ready to facilitate communications between national offices and mark owners.

Discussions were encouraged by António Campinos, who chaired the Committee on Trademarks and is now president of OHIM. One of the delegations that most strongly supported the proposal was that of Australia, which was represented by Michael Arblaster. In formal meetings in Geneva the idea to provide statements of grant of protection was soon known as the Australian proposal.

It also helped that WIPO was keen at the time to improve the electronic tools. This meant, however, that countries would have to be encouraged or mandated to send information to WIPO, to be collected centrally, rather than direct to applicants.

Although it took three years from the first discussion to approval – and a further 15 months before the changes became obligatory – Tove says the process is “a good example” of what can happen when different interests work together.

“It probably helped that this was a practical not a political issue,” she added.