

# MARQUES MAKES THE IP WORLD A BETTER PLACE FOR BRAND OWNERS

For nearly 25 years, MARQUES—the European Association of Trademark Owners—has been representing trademark owners’ interests in Europe and beyond. In 2010, the association has backed brand owners throughout a year that has seen rapid change. Tove Graulund provides a substantive overview of MARQUES’ most recent initiatives and achievements, and examines what the association is working on next.

On January 1, 2011, a major improvement to the Madrid Protocol international trademark system comes into effect. With the full implementation of rule changes agreed by the Madrid Union in September 2009, all designated offices for a Madrid Protocol application will have to issue a statement of grant of protection when the examination is finalised. The statement will be issued when there has been no problem with the application; when the relevant opposition period has ended without any opposition being filed; or if there has been an opposition, when that has been dealt with.

The change means that international brand owners have a lot more predictability about the fate of their applications. No longer do they wait for months, not sure whether the application has been successful or not, wondering whether it has been lost in the system or not processed for some reason beyond their control.

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MARQUES, the association of European trademark owners, was instrumental in bringing about this change, recommending the reform in letters to WIPO and in representations before the meetings of the relevant working group. Such fundamental rule changes do not come about overnight and need to be thoroughly debated. This improvement is just one of many achievements for trademark owners that MARQUES can claim in the past few years.

### About MARQUES

For nearly a quarter of a century, MARQUES has represented brand owners' interests through a variety of activities. It has organised many educational and networking events, notably the Annual Conference (which takes place in a different European city every September), the Trade Mark User Forum (which brings together brand owners and IP offices in Europe) and the annual Judges Meeting, at which European trademark judges meet.

In addition, MARQUES provides information to members via its newsletter, blog, case database and comprehensive website, as well as other occasional publications; works closely with other brand owners' groups and international organisations to improve

protection for trademarks and associated IP rights throughout the world; and presents the Lewis Gaze Memorial Award annually to an outstanding student in the field of trademarks.

Today, MARQUES has more than 700 corporate members from both brand owners and law firms, from Europe and beyond. Many representatives of the member companies participate actively in the 22 teams, which work on topical issues such as cyberspace, designs, geographical indications and regulatory matters. In all these areas, MARQUES aims to improve the environment for brand owners by simplifying and harmonising trademark protection, thereby reducing inefficiencies in IP work.

Since MARQUES was founded in 1987, the IP landscape has changed enormously, with the launch of the Community trademark (CTM) and registered Community design (RCD), the harmonisation of European trademark law, the rapid development of the Madrid System and the emergence of domain name registrations and disputes. With the growth of these instruments, MARQUES has been particularly active in liaising with organisations such as OHIM, WIPO, the European Commission and ICANN in representing brand owners' interests.

### International reform

As the work on the Madrid Protocol statement of grant shows, MARQUES has been highly influential in representing brand owners' views on the development of the international registration systems and other international instruments.

For example, in April 2010, a delegation representing MARQUES visited WIPO's offices in Geneva in April and held meetings with senior WIPO officials, including the new director general, Francis Gurry. During the past year, MARQUES members have also attended the second session of the WIPO Working Group on the Development of the Lisbon System (for geographical indications) and the WIPO Advisory Committee on Enforcement.

MARQUES' designs team has recently made submissions to WIPO's standing committee on trademarks, industrial designs and geographical indications (SCT) on possible areas of convergence in industrial design law and practice, and attended the 23rd session of the SCT, which addressed design law issues among others. The GI team has likewise provided an important contribution to the ongoing discussions on a possible revision of the Lisbon Agreement for the protection of appellations of origin and their international registration.

Beyond Geneva, MARQUES has been active in raising the importance of IP issues in the United Nations Commission on International Trade Law (UNCITRAL) agreement on secured transactions. Following a meeting in Vienna in March 2010 (at which MARQUES was represented), the UNCITRAL Legislative Guide on Secured Transactions, Supplement on Security Rights in Intellectual Property was published. This owed a lot to MARQUES' extensive input over a number of years.

An issue of ever growing concern to brand owners is the protection of domain names and trademarks on the Internet. Among the most pressing priorities is the proposed expansion of the domain name space with the launch of new generic top-level domains. MARQUES' devoted team has been at the forefront of raising the concerns of brand owners before ICANN, submitting comments on the brand protection mechanisms proposed, including the clearinghouse, the Uniform Rapid Suspension, the financial framework/operating budget from 2011 and the post delegation dispute resolution procedure, as well as the Draft Applicant Guidebook, version 4. This work has been undertaken in close co-operation with other associations, especially ECTA.

Also with ECTA, MARQUES recently organised a meeting with representatives of the EC Information Society & Media directorate general in Brussels to express concerns at ICANN's proposed expansion of the domain name system with the launch of new gTLDs.

## At the heart of Europe

Although MARQUES members come from all over the globe, what makes it unique is that it is the European organisation representing brand owners' interests worldwide. Much of its work is therefore focused on improving the trademark system in the EU and neighbouring countries.

To this end, the association has built up a warm, but not uncritical, relationship with OHIM. For example, MARQUES argued in favour of trademark users' associations having observer status on OHIM's administrative board and budget committee, and is one of the five associations that are now represented there. This means that MARQUES can observe the debates about the development of the CTM and RCD, and make informed contributions when appropriate.

In addition, representatives of many of the MARQUES teams attend the regular OHIM's users group meetings, as well as other occasional meetings, such as one in December 2010 on e-business. The association recently secured representation in Europe before the European Commission's register of representatives and prepared submissions to the Commission's consultation on the review of the EU laws on customs enforcement of IP rights. It also made extensive submissions to the Max Planck Institute's study of the trademark system in Europe, which the European Commission is now reviewing. In May, a MARQUES delegation met with the EC director for the knowledge-based economy in DG Markt, Margot Fröhlinger. MARQUES has made representations to the European Commission to be admitted to the observatory on counterfeiting and piracy as an interested representative association. MARQUES also provided responses to the consultation on the Tobacco Directive, particularly focused on the troubling legislative proposal to introduce so-called generic or plain packaging for tobacco products.

MARQUES also provides extensive information on developments in Europe, through its case database and newsletter, and in some cases, in greater detail. For example, the website includes a unique and comprehensive guide to decisions on the validity of designs at OHIM, covering the first 300 decisions. A fourth, updated, edition of the guide will be published in spring 2011.

Following the recent launch of an *amicus curiae* team, MARQUES has made representations in important trademark cases in Europe, including the *Nokia Corporation v Her Majesty's Commissioners of Revenue & Customs (HMRC)* case on transshipment, the *Leno Merken BV v Hagelkruis Beheer bv (ONEL/OMEL)* case on genuine use of CTMs and the *CIPA v UK IPO (IP Translator)* case on the use of class headings.



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## A vital role

The globalisation of trade and the growth of rapid electronic communication present great opportunities for owners of valuable brands to reach new markets and extend their products to new areas. But they also bring enormous challenges, from clashing trademarks to the risk of dilution and the rapid spread of counterfeits. An effective brand protection strategy involves addressing issues as varied as the Internet, unfair competition, valuation and parallel imports. Given the demands on time and resources, many trademark counsels find it invaluable to work alongside their peers in other organisations and benefit from the extensive work undertaken by and through MARQUES.

MARQUES is unique in representing the interests of brand owners in Europe before the key authorities in the EU and beyond, and takes a practical, commercial approach that reflects its members' interests. For example, at the AGM, all industry members can vote on major policies and appointments. The same practice applies to the MARQUES Council whenever there is a vote on a substantive issue. (Among the companies represented on the Council today are Coty, SCA Hygiene Products, Syngenta, F Hoffmann-La Roche, IKEA, INDITEX, Cadbury, Nestlé, Henkel, GSK, Sara Lee, Anheuser-Busch InBev, DSM and AkzoNobel.) This makes MARQUES' voice particularly powerful in international organisations.

As the improvements to the Madrid Protocol show, this approach can lead to real reforms to benefit trademark owners. We are already beginning to see the fruits of similar intensive work in the EU and

at ICANN, and MARQUES members are even now working on further initiatives to help make the lives of trademark owners simpler and more effective, enabling them to spend more time focused on their most important work—maximising the value of brands to their business.

For more information about MARQUES, visit [www.MARQUES.org](http://www.MARQUES.org) to find out about upcoming events, the work of the various teams, the latest trademark news on the Class 46 blog and much more.



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