

Top **MARQUES** in IP protection



The World IP Review talks to **Tove Graulund**, immediate past chairperson of MARQUES, the Association of European Trade Mark Owners, about her career and how intellectual property law and enforcement has changed over the past decade

What have been the major issues in international trade mark law during your time as an IP practitioner?

A great many issues have been important, since I have been around for a quite a long time now, so my answer will be as seen from a personal perspective, i.e. the issues that were important from the point of view of the business that employed me at the time and the priorities of that business.

Seen from the perspective of a European-based business in search of trademark protection, I believe that the single most important point was the introduction of the Community Trade Mark and the entry into force of the Madrid Protocol in Denmark, all in 1996. It completely changed the way that we planned and implemented our trade mark protection strategies.

As a result of the Harmonisation Directive and the advent of the CTM, over the following ten years and still on-going, we have seen many decisions from the European Court of Justice (ECJ) that have created numerous stirrs in the intellectual property industry and hours of interesting discussions between the experts. And it was not just the filing strategies that changed. Also, the introduction of new trademark types, the so-called unconventional trade marks, has made a big difference when it comes to protecting other brand elements than the name of the product. You find yourself not just making plans for which system to use and/or how to combine them, but also how/if to protect your packaging through design or 3D trade mark and when to rely on copyright for other brand elements and so on. It has all added much more colour and life to protection of trade marks and brands.

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What do you think will be the major issues to face global business with regards to trade mark protection in the future?

One important thing is to reduce the diversity in trade mark protection procedures and, specifically, to reduce what I would call traditional – but non-essential procedures – like legislation, filing of powers and so on to increase speed of examination. Some countries insist on the value of these types of procedures, but when you look at it from a business perspective, they hold no value what so ever in modern times.

What businesses and intellectual property professionals look for these days in an IP office is efficiency and cost-effectiveness that does not reduce the quality of the work. The services that an office offer must represent added value or else it will not be used, but many processes on a number of offices can be optimised and restructured without having a negative impact on quality.

For several years now, MARQUES has worked closely with INTA to promote the Madrid Protocol to countries that are not members as this is one effective way of reducing non-essential trade mark protection work. MARQUES also strives to keep the value of the CTM, while at the same time being a supporter of the reduction of the fees.

MARQUES works closely with both WIPO and OHIM. It goes without saying that when you are promoting the works of the offices, you must at the same time make sure that they perform as you would wish so that you remain a critical, but close friend.

Another issue linked to reducing complexity is the funding of the national patent and trade mark offices. It is of concern to MARQUES that there is a diversion of fee-generated revenue, which is in clear contradiction with the demands from users for improvement of services and quality. MARQUES has built a close

working relationship with the national offices in Europe, and it is during the so-called forum meetings with these offices that issues like this come to the surface. MARQUES is presently working on this issue and has entered into direct discussion with European governments.

How has MARQUES developed during your time as chairperson at the organisation?

I became vice-chair in 1996 and chair in 2001. If you think back ten years, most organisations were not much more than a conference, which was what was needed at the time. The priority of intellectual property professionals was to build relationships and to make new business connections across borders. In Europe this changed in 1996, and with the many fine conferences running at the time, it was a real open question whether there was a need for all the organisations that were active in Europe. With this in mind, the MARQUES council did a thorough review back in 2001/02 of the market place and the needs of its existing and potential clients and came to the conclusion that MARQUES did have an important role to play. In order to fulfil that role, however, changes needed to be made and the organisation needed to develop into something more than an annual conference. While regular MARQUES goers say that it is still the best conference around, I would like to think that MARQUES has developed into an organisation that members can rely on all year round.

The many members that put up their own time to work actively on MARQUES Teams, which have been created since 2002, prove that while there is still a need to build relationships, there are also many issues to look at and work on – issues that the volunteers know are important to the IP community and that MARQUES as a consequence has to be actively involved in. MARQUES now has 14 teams with 135 members in total.

How effective are advocacy groups such as MARQUES and INTA (among others) in combating the problems that counterfeiting presents global business today?

Companies will most likely say that we are not efficient enough – but that would be a reflection of how difficult the problem is and how crucial it is for businesses to have something done about it. Everything is relative, and while many organisations like INTA and AIM do wonderful work on the area, the question is how effective can it be at the end of the day. But one thing is certain, and that is that it is none

the less vital that organisations like MARQUES keep pushing in a persistent manner. Some intellectual property issues take years of work before you can say that you have done the job, but you need to keep going. You need to keep the dialogue going with the decision makers, and this is what these organisations and MARQUES do.

When I take the discussion up with friends in industry, I am sometimes amazed at the sense of abandonment they send back at you. And these are hard-working passionate people. I believe that if you are not personally involved in the political discussions, it seems futile or unrealistic to try to change the way the OHIM fees are set as an example, or how to persuade all agents to be in favour of the Madrid Protocol, even if you should consider yourself the most important stakeholder on the issue. But I can say from personal experience that organisations like MARQUES do make a difference and do have influence.

Sometimes you have to celebrate the little victories on the way to the final one, but I can only recommend getting involved. It is great fun and holds many stimulating challenges for anyone with a bit of energy. I know that the accomplishments that MARQUES has achieved, alone or working with others, would never have happened if we did nothing and were sitting on our hands.

Drawing from your vast experience, what are the three biggest pieces of advice you would give to in-house trade mark attorneys?

From my personal experience what was most helpful was when the department moved and I started reporting to the corporate marketing director. I know that it does sound as if we joined the enemy, but consider the old saying “if you can’t beat them, join them”, and I am pleased to say that it did actually work very well for us.

It helped in the sense that we had the opportunity of learning much more about how marketing works and what its priorities are, and consequently we were better able to evaluate our own work and spot where it added value to our colleagues and where it did not really make much difference for them. It also made it easier for us to communicate with them in a way that was much less legal and more adapted to where they were in the process. So I would recommend any in-house trademark person to learn more about marketing – that would also go for external persons.

The other thing that I learned was that while it is deadly important that all the procedural work runs like clockwork, it is not interesting for the people involved in the business. On the one hand, you must teach them never to forget you; on the other hand, you must understand that they are not particularly interested in knowing that their mark was finally registered in Malaysia after more than ten years of waiting. Basically, they should not even have to think about this as it should be part of your back office routine to look after this.

This advice is obviously dependant on the size of your department, but even with a small department it make sense that in the outgoing activities you remain tactical and strategic in your discussion and that you do not overload your colleagues with the procedural details or discuss with them the differences between CTM and national registration, as an example. It should be your responsibility to get it right in accordance with the priorities of the business. So the advice would be to keep the back office running in the back and to discuss the big picture with your colleagues.

With a reference to the above, the last piece of advice would be to encourage in-house people to

become active in organisations like MARQUES. As far as what I have heard, it is often difficult to find time and sometimes it is not even appreciated by the boss or the company. But I know that the knowledge and experience that you carry back with you into the company can never be obtained otherwise. It is not something you can read in a book or learn at a seminar. You will be the first one to know about important developments in the field that you are involved in – which should obviously be an area that is relevant for your company, like counterfeiting or look-alikes. The personal development that you obtain when working with others that are often from different parts of the world than yourself is also something that will increase your capabilities within the company. As a trademark person working for marketing that often does not understand what you are saying, it is vital that you develop good communications skills. So find the time, it is important and you will make a difference! Get involved. **IP**

Tove Graulund is the immediate past chairperson of MARQUES, the association of European trade mark owners. For more information on MARQUES, please visit the website at www.marques.org



TOVE GRAULUND

Tove Graulund graduated as an interpreter in French from the Copenhagen Business School in 1987. In 1981 she started work with a private law firm in intellectual property. She joined Arla Foods in 1987 and became head of corporate intellectual property in 1992. In December 2006 Graulund moved to private practice to head up Zacco's trademark & legal department in Denmark. The firm has 270 employees based in its offices in Denmark, Norway and Sweden.

Graulund was chairperson of MARQUES from 2001 to 2006. While stepping down from leading the organisation, she is still active in several lobbying activities of the association, such as the development of the international registration system and the future role of the national Patent and Trade Mark Offices in Europe.



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