

Introduction

MARQUES at a glance

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MARQUES is the European organization representing brand owners' interests worldwide. Since its foundation in 1987 it has provided an effective platform for voicing brand owners' concerns, created a forum for the exchange of ideas and information, and promoted the professional development of its members in the management of their IP rights.

MARQUES has over 750 members worldwide, including many well-known brand owners. It operates through a consolidated structure supported by the council, the executive committee and internal teams. While the council acts as the board of directors, exercises all the power and carries all the responsibility of the organization, the executive committee implements council decisions and handles the day-to-day running of the organization. The council is composed of up to 40 members, with half coming from industry and half from private IP practice.

The leading influence in the IP development and decision-making that characterizes MARQUES is the diligent work of its teams. They cover a wide range of areas, including:

- *amicus curiae*;
- anti-counterfeiting and parallel trade;
- brands and marketing;
- China;
- cyberspace;
- designs;
- IP outer borders;
- international registration system;
- regulatory;
- unfair competition;
- geographical indications; and
- trademark law and practice.

Part of the internal work of the organization is also covered by teams: education, membership, programming and publications and website. All MARQUES members are encouraged to register and voluntarily work for one of the teams or create a new team dealing with topics of particular interest to their business.

In addition to local events and seminars, MARQUES organizes two conferences each

year: the annual conference and the winter meeting. The winter meeting is exclusively for council and MARQUES team members. The annual conference takes place in September each year. It lasts for three days and tackles not only the latest IP issues, but many other issues facing brand owners and IP professionals. Along with presentations by expert speakers, the programme includes workshops organized by the teams.

Main activities

MARQUES is an active organization and is present at most IP debates, as well as carrying on many activities to achieve its goals. Among its diverse activities, the following stand out.

Regular meetings with European national trademark offices: MARQUES organizes two meetings a year with representatives of the national patent and trademark offices in Europe with participation of its sister users' associations, the European Brands Association (known as AIM) and BUSINESSEUROPE. The meetings are designed to provide a platform to discuss the future role of the national offices and to tackle cross-border issues. Topics discussed include:

- the United Nations Commission on International Trade Law (UNCITRAL) guide and its impact on IP owners;
- funding of national trademark offices;
- protection and registration of geographical indications;
- revision and expansion of the Madrid Protocol;
- domain names and Internet Corporation for Assigned Names and Numbers (ICANN) initiatives;
- protection against lookalikes;
- three-dimensional trademarks and designs;
- protection of well-known trademarks;
- use of class headings;
- IP mediation practice; and
- recent European law on trademark rights and enforcement.

These meetings undertake to address issues of concern to brand owners and continue to be a benchmarking opportunity for national offices.

Development of the Madrid System:

MARQUES is working closely with the World Intellectual Property Organization (WIPO) on the development of the Madrid System for the international registration of marks. For many years, MARQUES has actively promoted the expansion of the Madrid Protocol. MARQUES believes that the protocol is well placed to become the main system for the registration of trademarks and thus takes every opportunity to improve the system for the benefit of users.

In that connection, MARQUES proactively participates as an observer at the meetings of the WIPO Ad Hoc Working Group on the Legal Development of the Madrid System. As an example, MARQUES took a decisive initiative that, three years later, led to the WIPO member states agreeing to issue a statement of grant of protection on all designations in an international registration. The necessary amendments were accepted by the General Assembly in September 2008.

MARQUES collaborates with WIPO by providing speakers and organizing local events in targeted countries to promote the protocol. In order to keep updated and strengthen efforts, the new Protocol in South America Team, which originated from joint efforts with the International Trademark Association since 2004, was formed by MARQUES in 2008. Its mission is the promotion of the protocol in South America to encourage more countries to join.

Meetings with Community trademark judges: MARQUES has arranged a series of seminars with the aim of promoting study and collaboration between trademark holders and the judges of the Community trademark (CTM) courts in various EU member states. The first of these meetings was organized together with the Office of Harmonization for the Internal Market (OHIM) and involved presentations from the CTM judges in Alicante, followed by open discussions between the judges and seminar participants.

The second meeting was organized with the Italian Patent and Trademark Office and brought together the most prominent Italian IP judges. The Italian judges gave lectures on the main subjects that concern CTMs, such as distinctiveness, risk of confusion and association of trademarks, and cross-border injunctions.

MARQUES is currently organizing the third of these seminars, scheduled to be held in June 2010.

Observer status before the OHIM

Administrative Board: Following an initiative from MARQUES, the OHIM Administrative Board granted MARQUES observer status as an international non-governmental body, along with four other user organizations. Observer status is granted for a period of two years. MARQUES attends each meeting and follows the debates. To date, two position papers have been co-signed by MARQUES aimed at defending users' priorities.

Member of the ICANN Implementation

Recommendation Team: MARQUES was designated one of the 15 experts that comprise the ICANN Implementation Recommendation Team. The team was created by the ICANN board to consider whether standardized rights protection mechanisms could reduce the financial and administrative burden on rights owners that might be caused by the launch of up to 500 new general top-level domain names from early 2010 onwards. The MARQUES Cyberspace Team has submitted comments on the team's recommendations and is closely following the development of this initiative.

Observer at the legal discussions on the

UNCITRAL guide: In 2006 MARQUES took the initiative to hold the first working meeting and discussion forum on the UN Convention on the Assignment of Receivables in International Trade and Legislative Guide on Secured Transactions. The legislation had a number of aspects which it was believed could negatively impact on the rights of IP owners. Thus, MARQUES, through its Intellectual Asset and Management Team, gathered together a large group of organizations to discuss this impact and raise awareness within the IP community.

Since then, the team has organized further meetings and collaborated in the preparation of the UNCITRAL expert meetings. MARQUES was invited to draft a common proposal for an IP annex to the guide. The IP annex is designed to explain the issues concerning IP secured financing and how IP law interacts with secured financing law. MARQUES is currently involved in the development and implementation of the annex.

Lobbying in Brussels: MARQUES continuously organizes meetings with the relevant services of the European Commission to discuss issues of concern, such as counterfeiting and piracy, trademark law, unfair competition practices and CTM fees.

OHIM user group meetings: MARQUES attends all the OHIM user group meetings in Alicante and gives its members a voice at these meetings.

Publications and papers

The MARQUES teams are engaged in several studies on IP issues – the conclusions reached by these studies are valuable tools for the day-to-day work of MARQUES members.

For example, the MARQUES Design Team reviewed the first 300 decisions on the validity of registered Community designs given by the OHIM Invalidity Division. These decisions were classified and organized in an electronic searchable form, and statistics were generated. The team regularly updates the review and has now published a third edition. The review has proven to be a valuable tool for designers, brand owners and legal practitioners in general.

Another example is *Lookalikes: Who's behind the mask? A practical guide to lookalikes and their impact on IP rights*. This guide was drafted by the MARQUES Unfair Competition Team, which has conducted an in-depth study on lookalike issues and recognized that there is general uncertainty in regard to the identification and legal evaluation of lookalikes in the considered jurisdictions. The guide is designed to provide guidelines to brand owners on how to address lookalike issues in the European Union. The guide addresses, among others, the following issues:

- how to categorize and recognize lookalikes;
- whether and under what conditions lookalikes infringe IP rights; and
- how brand owners may consider defending their IP rights in terms of preventive measures and substantial enforcement strategies.

The guide is to be launched at the MARQUES Annual Conference in Brighton in September 2009.

MARQUES speaks up in defence of IP users' priorities wherever relevant. It also signs and sends position papers to appropriate institutions and authorities to ensure that the interests of the IP community are safeguarded. Over the past year MARQUES has, through its teams, submitted papers on the following subjects:

- the EU plans for the new Anti-counterfeiting Trade Agreement;
- the ICANN Implementation Recommendation Team's proposals regarding the impact of the new global top-level domains;
- an OHIM communication on the use of class headings in the list of goods and services for CTM applications and registrations;
- the Locarno classification system for industrial designs;
- the registered Community designs database and Article 71 of the relevant implementing regulation;
- the Green Paper on Agricultural Product Quality;
- the EU comprehensive study of trademark systems in Europe; and
- the OHIM Cooperation Fund.

In addition, and to help keep its members updated, MARQUES distributes the monthly MARQUES News-channel, an e-bulletin containing the latest news from the IP community and a variety of information related to intellectual property. MARQUES also produces a quarterly newsletter which includes the latest developments in the IP field and provides information on its activities. The newsletter also offers members the opportunity to raise issues and concerns and to seek responses from the wider professional membership.

What's ahead

MARQUES is already organizing its next set of regular activities, such as the 10th forum of European national trademark offices, the third meeting of CTM judges and the 2010 annual conference in Berlin.

MARQUES will continue to play a proactive role at meetings of the OHIM Administrative

Board, WIPO and ICANN, as well as lobbying the initiatives of these institutions and the European Commission.

One of MARQUES's latest concerns is eBay's recent petition to amend the EU Vertical Restraints Regulation (2790/1999). The online auction site considers that brand owners are unlawfully trying to block the sale of their products online and thus is calling for a public petition to remove alleged EU trade barriers. MARQUES has reacted against this petition, considering that eBay's campaign is intended to undermine the fight against the sale of counterfeit goods. One of the most worrying aspects of eBay's campaign is that it might confuse not only consumers, but also EU policymakers.

It is for reasons such as these that MARQUES is committed to defending rights holders' interests before the EU legislature, and it will continue to take the necessary steps to ensure that rights holders' views are duly and fully considered.

MARQUES members receive a unique service which recognizes and responds to the whole range of problems facing the modern trademark owner. Drawing on the variety of skills and expertise within its worldwide membership, MARQUES seeks to ensure that its corporate finger rests on the pulse of affairs. Every member is encouraged to make a contribution – in whatever form and through whatever medium suits – to a global resource centre by agreeing to share professional strengths with fellow members, while at the same time improving and enhancing their own performance by drawing support and guidance from the association.