



A I P P I

**ASSOCIATION INTERNATIONALE
POUR LA PROTECTION DE LA PROPRIETE INTELLECTUELLE**

**INTERNATIONAL ASSOCIATION
FOR THE PROTECTION OF INTELLECTUAL PROPERTY**

**INTERNATIONALE VEREINIGUNG
FÜR DEN SCHUTZ DES GEISTIGEN EIGENTUMS**

Congress

Seoul

October 20 to 23, 2012

**Report
Special Committee Q212**

Trademarks

Marques

Marken



Report Q212

Trademarks

Names and Functions of Committee Members

Chair	Peter Widmer	(Switzerland)
Co-Chair	Uli Widmaier	(USA)
Secretary	Anne Marie Verschuur	(Netherlands)
Members	Brett August Theresa Corneau Eduardo Kleinberg Masako Nishimura Aleli Angela G. Quirino Richard Watts Christian Rohnke Jan Vleck Bartosz Krakowiak Béatrice Thomas Eléonore Gaspar Stefano Vatti Abdurrahim Ayaz Maxim Koval Michael Reinle Shane Smyth Jorge Llevat Elena Molina López Fiona Brittain Elisabeth Siemsen do Amaral	(USA) (Canada) (Mexico) (Japan) (Philippines) (New Zealand) (Germany) (United Kingdom) (Poland) (France) (France) (Italy) (Turkey) (Ukraine) (Switzerland) (Ireland) (Spain) (Spain) (Australia) (Brazil)
Responsible Reporter	Thierry Calame	(Switzerland)

Annual Report of Special Committee Q.212 TRADEMARKS

by Peter Widmer, Chair and Anne Marie Verschuur, Secretary

1. Summary:

2.1. Q212 has currently two priorities in its substantive work, of which both have already been brought to the attention of the RGT and the Bureau:

- a) Plain Packaging: the systematic and scientific analysis of trademark related consequences of the adoption of plain packaging concepts in selected industries with latent health issues.
- b) Madrid System: studying the implications of the proposed abolishment of the basic mark requirement as suggested in a recent MARQUES' initiative and the interrelation of the basic mark requirement and transcription marks if different writing systems are involved.

2.2. On a more operative level there are three goals:

- a) To improve the visibility of AIPPI in meetings of WIPO and OAMI by securing adequate personal representation and by submitting substantive papers where necessary;
- b) To improve the involvement of all members of SC Q 212;
- c) To liaise with SC Q227 Designs in order to coordinate the representation at the WIPO SCT which covers both aspects of design and trademarks.

2. Report of Committee's activities and Recommendations

2.1 Committee meeting in Hyderabad

There was a gathering of members of SC Q212 in Hyderabad during the AIPPI ExCo meeting. Another meeting will take place during the AIPPI Congress in Seoul.

2.2 Work and Contributions on Substantive Matters

- a) Madrid System: Basic Mark Requirement: Earlier this year AIPPI was approached by our sister organization MARQUES with a request for support of the so called Norwegian proposal which basically suggests to completely abolish the basic mark requirement in the Madrid system. Upon request of the RGT, Q212 has prepared a summary analysis of MARQUES' proposals and submitted a report to the Bureau. The latter has meanwhile considered our analysis and recommendations and recognizes that the basic mark requirement under the current Madrid System
 - i. is a complex issue and that its discussion has merit,
 - ii. should also be considered under the aspect of necessary transliterations and transcriptions, if a certain mark is intended to be used and protected in zones with different writing systems.

As a result, the Bureau agreed that AIPPI should further study the details and consequences of the proposed changes to the Madrid system in regards to the

basic mark requirement, which may be the content of a possible new Working Question with a full scale comparative law analysis.

At the same time AIPPI is not in the position to support the conclusions of the MARQUES' Paper as submitted earlier this year *before* studying the underlying complex issues in more detail and in a broader context.

b) Supporting the Drafting Process regarding two pressing issues

(i) **Plain Packaging re. Tobacco Products**

The new TM regime in Australia in regards to the prohibited use of stylized marks etc. in particular on cigarette packages is certainly a very pressing and highly complex subject matter. AIPPI has already submitted a paper last year in the course of the Public Consultation of the European Commission on the possible revision of the Tobacco Products Directive 2001/37/EC.

A number of tobacco producing countries will or intend to challenge Australia's legislation on plain packaging before the WTO Dispute Settlement Body. In this context it is the plan that AIPPI prepares and submits an **independent study** in regards to the plain packaging issue under IP related aspects based on the results of an AIPPI-typical questionnaire.

The RGT has approached committee Q212 with the request to support this project and to find volunteers in our committee who would work with the RGT on this question. The only condition is that such volunteers would ideally not work for clients exposed or involved in the tobacco industry in order to avoid any appearance of bias or conflict of interest. Our committee is currently about to put this task force together.

(ii) **Case C-12/12 Colloseum Holding AG v. Levi Strauss & Co. ("Stofffähnchen") before the European Court of Justice**

Members of SC Q212 assisted the RGT and in particular Alexander von Mühlendahl preparing a submission in regards to the critical question of genuine use of marks which are applied on products as combination marks although each element of such combination mark is protected alone.

It is **recommended** to further study this important aspect of genuine use.

2.3 Representation of AIPPI at WIPO and OAMI meetings

WIPO and OAMI hold regular meetings for the purpose of the further development and/or harmonization of formal and substantive trademark law. Our committee succeeded in much broader representation of AIPPI in regards to such meetings during 2011/2012 due to the participation of several group members for which we take the opportunity to thank them. We also refer to the reports of our members as are or will be published on the AIPPI website¹. In particular we would like to refer to the following events with participation of SC Q212:

a. **Working Group on the review of Model International Form of the Singapore Treaty on the Law of Trademarks 1st Session in Geneva, January 31, 2012**

¹ <https://www.aippi.org/?sel=questions&sub=specialcommittees&viewQ=212#212>.

b. OAMI Users Group Meeting in Alicante on 17 April 2012.

We specifically thank Jorge Llevat

c. WIPO Working Committee on the Legal Development of the Madrid System for the International Registration of Marks, 10th Session, July 2012 in Geneva;

We particularly thank Alexander von Mühlendahl, Elena Molina and Abdurrahim Ayaz for attending this meeting and would like to mention Elena's and Abdurrahim's excellent reports.

d. WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) in Geneva

Members of Q212 including Anne Marie Verschuur, Eduardo Kleinberg, Abdurrahim Ayaz, Michael Reinle, Jorge Llevat and Peter Widmer attended several SCT meetings in 2011 and 2012 i.e. 26th and 27th Session in Geneva.

2.4 Other Projects

Q212 was approached by members of AIPPI in regards to the following items:

- a) Luis-Alfonso Durán, Barcelona, Spain: Request for Comments Regarding Amending the First Filing Deadline for Affidavits or Declarations of Use or Excusable Nonuse. It is the plan to file comments with the USPTO.

In addition it is **recommended** to study whether the Filing Deadline for Affidavits or Declarations of Use should be harmonized.

- b) Abdurrahim Ayaz alerted SC Q212 to the IP TRANSLATOR case, Case C-307/10.

It is **recommended** that our committee will look into the consequences of this decision, in particular in regards to future filing strategies.

Peter Widmer/ Anne Marie Verschuur, September 24, 2012