

# CITMA REVIEW

ISSUE 436

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### Trade Mark Attorney : Manchester

VAC53477

A rare opening for a Trade Mark Attorney to join this top tier firm's Manchester office. Ideally you will be finalist or newly qualified level, though those with additional experience will also be considered. It could be your open door to a supportive and encouraging career path working on a caseload from some of the best clients in the business.

### Newly Qualified Trade Mark Attorney : London

VAC50544

Award winning Heavyweight IP firm seeks a tenacious newly qualified Trade Mark Attorney! Ideally you'll be newly qualified to 1 years PQE, with a real passion for the industry, however finalist level and those with more experience will also be considered. High quality work, big name clients and an expert team of professionals await you - enquire now.

### Formalities Assistant : Leeds

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Looking for the chance to increase you IP support knowledge? This boutique practice seek a formalities assistant with excellent attention to detail. No prior IP experience is necessary though those with experience will be looked upon favourably. A great opportunity to gain skills in cradle to grave formalities procedures.

### Trade Mark Partner : London

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Career defining move to be at the forefront of a top tier IP firm. Have you got the drive, ambition and tenacity to push this team forward with strong leadership skills, brand promotion and business development? You may be an existing Partner within practice looking for a new challenge or an aspiring Partner with demonstrable experience of involvement in the wider business. Put your expertise to exceptional use with exceptional rewards through this extraordinary opportunity.

### Qualified Trade Mark Attorney : Scotland

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Plentiful caseload of exciting work from an extensive high profile client portfolio, making this an exciting time to be joining such a highly regarded firm. You must be qualified and able to manage your own workload from the off, but the real clincher here is the freedom and scope for business development. A platform to propel both your career and the Trade Mark group onto a whole new level, with huge rewards to reap, both in the short and the long term.

### Trade Mark Attorney : Birmingham

CEF51325

Experts in their field and looking to expand their Birmingham office, our client are seeking an Attorney to join their thriving Trade Marks team. The ideal candidate will be 1 - 4 years PQE, with fantastic communicative skills and a tenacious work ethic. You'll enjoy support in a small but strong department, where you can really make a difference and put your career on the map, with high profile work and expert company.

### Trade Mark Attorney : Leeds

CEF48693

Based in vibrant Leeds, this exciting and expanding practice seeks a Part or Fully Qualified Trade Mark Attorney with ideally between 18 months to 4 years' experience within the Trade Marks profession, either prior to or post qualification. With plenty of scope to grow, not only the practice but on a personal level too, this will be an immensely rewarding position with a great location, supportive environment and a superb package being just the starting points.

### Trade Mark Secretary / Paralegal : London

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A leading IP firm seeks a pro-active, forward thinking Trade Mark Secretary / Paralegal to work at Partner level, providing full secretarial and Paralegal support. You'll be motivated, switched on and bring with you a wealth of Trade Mark knowledge and experience.

### Trade Mark Paralegal : London

TJB53551

An internationally renowned IP Practice are looking to expand their Trade Mark team as they seek to appoint an additional Paralegal to join them. Working closely with one of the Trade Mark Partners, you will be exposed to a broad range of Trade Mark work as well as having the benefit of a strong team environment to provide excellent and ongoing support as you continue to develop.

For further information about this selection of opportunities or to discuss any other aspect of IP recruitment, please contact:

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or tim.brown@saccmann.com

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**W**elcome to the September issue of the *CITMA Review*, in which, I am delighted to say, we are publicising the new CITMA Paralegal category of membership (page 8), a welcome change that recognises the enhanced skills of those members.

This is also an issue of statistics, from the impact of Brexit on filings (page 10) and the annual roll call of the busiest firms undertaking UK and EU trade mark filings (page 13) to current salaries and some interesting inclusion trends (page 22).

We are also guided by Claire Lehr on how to succeed in combing through EU registries (page 19), Aaron Wood on advocacy tools (page 16), and Robert Cumming on cautious use of emojis (page 24).

I hope that the photos of the Summer Reception (page 6) remind you of a fantastic night out on a beautiful sunny evening, and that there are still many more of those for us to enjoy this autumn.

**Kate O'Rourke**  
CITMA President

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# CITMA



## CITMA | INSIDER

### Chief Executive's bulletin

*Highlights from and updates to Keven Bader's 26th July message to members*



#### CITMA PARALEGAL IS NOW LIVE

On 20th July we launched the CITMA Paralegal category of membership. All current Administrator members were transferred to this new category, and the Administrator category has been withdrawn. Details about the change have been published on the CITMA website, and more information can be found on page 8. We'd like to thank all members and their firms for their input into the development of this category, and the support and positive comments we've received. I would like to encourage those members in the new Paralegal category to use the title "CITMA Paralegal", as set out in the regulations.

If you know anyone who may be eligible to become a CITMA Paralegal member, please let them know about this new category. If you know of anyone who may be interested in becoming a CITMA Paralegal by passing the CITMA Paralegal Course (formerly the Trade Mark Administrators' Course), please ask them to pre-register their interest for the 2018 course by emailing Marzia Sguazzin at [marzia@citma.org.uk](mailto:marzia@citma.org.uk)

#### PRO BONO SCHEME

In November 2016, in conjunction with other IP organisations, we launched a pro bono scheme for IP contentious matters. The scheme has seen a steady flow of cases, many of which have been related to a trade mark matter. We encourage members to visit the scheme's website at [iprobono.org.uk](http://iprobono.org.uk), where you can find out more information, how to get involved, and details if you need to signpost anyone to the services offered.

#### DATA PROTECTION – GDPR

The General Data Protection Regulation (GDPR) comes into force on 25th May 2018. We are looking into what impact the new regulation will have on CITMA and the data we process, and will be communicating to members any changes or action required of you. The regulation has been described as "the biggest change to data-protection law for a generation"; therefore, I would encourage all members and their firms to make sure they are aware of GDPR and how to ensure compliance. We plan to hold an event that will provide further information. In the meantime, see the news item at [citma.org.uk](http://citma.org.uk) for links to further guidance.

#### COMMERCIAL PARTNERSHIPS

We have continued our commercial partnership arrangements with Corsearch and CompuMark Clarivate Analytics for 2017. Corsearch sponsors our London Lecture programme, the Spring Conference and the Autumn Conference (coming 12th October in Birmingham).

CompuMark Clarivate Analytics is sponsoring the pre-lunch drinks reception at the London Christmas Lunch (8th December) and has supported the running of the Trade Mark Administrators' Course, now the CITMA Paralegal Course.

#### CAN YOU FIND TIME FOR CITMA?

If you feel you have some capacity to volunteer with CITMA, please see the information about our committees and working groups, including current vacancies. If there are no vacancies in your area of interest, still get in touch, as we may be able to accommodate you.

### Brexit: taking a position

We hope all members saw our recent communication about the publication of CITMA's official position paper on matters relating to Brexit. If you haven't had a chance to read it yet, the paper is available at [bit.ly/BrexitPosition](http://bit.ly/BrexitPosition). We recently held a webinar to update members on the latest developments, providing an opportunity for them to ask questions. Access a recording of the webinar on the CITMA website.

A number of meetings have also been taking place, including: a meeting with the Ministry of Justice to discuss rights of representation across the legal sector; with the IPO to discuss exhaustion of rights; and with the public affairs agency we have appointed to discuss developments and the next steps. We will continue to communicate updates as this issue moves forward.

In brief, CITMA is campaigning for:

- existing EU registered trade mark and design rights to continue to cover the UK;
- Chartered Trade Mark Attorneys to continue to be able to represent their clients before EUIPO; and
- Chartered Trade Mark Attorneys to be granted rights of representation at the General Court and CJEU.

### New CEO at IPReg

IPReg has appointed a new Chief Executive Officer, Fran Gillon. She joins IPReg following previous roles in the legal services and regulatory environment, including at Ofgem, Postcomm and the Legal Services Board, and as a Special Adviser at Slaughter & May.

# Autumn Conference goes social

Register now for our 12th October Autumn Conference, which will focus on "Social media and IP"

12th October 2017  
Hyatt Regency Birmingham  
Earn five hours' CPD

 Wolters Kluwer  
Sponsored by  Corsearch

Brands and trade marks live and breathe on social media, and now we are bringing together a host of expert speakers to provide vital insight on the interaction of social media and IP law.

From memes to advertising, the CITMA Autumn Conference will answer some of the most important questions surrounding IP law and social media. Our speakers will also equip you with practical steps and tools available to take action on social media infringement.

Find out answers to the following questions:

- How can you act on unwanted infringing content online?
- Has social media changed the way we create and market brands?
- Can businesses utilise user-generated content like memes?

To round off the day, we will ask the question: has social media made trade marks more valuable business assets?

## BOOK NOW

Book your place at [citma.org.uk](http://citma.org.uk). Tickets are on sale until Wednesday 4th October, subject to availability. The cost is £225 for CITMA members and £275 for non-members. Each ticket includes lunch and the evening drinks networking reception.

Can't make the whole day? Why not book a place at our evening drinks reception only?

**ACT FAST!**  
Last year's event sold out early



## KEY SPEAKERS

Our key speakers and subjects include:

**David Haigh, Brand Finance plc: "Has social media made trade marks more valuable business assets?"**

With social media being used by brands to promote products, and by consumers as a research tool, how has this affected how brands are valued?

**Vanja Kovacevic, Schmitt & Orlov: "Memes and IP"**

Vanja will be considering the law on the use of third parties' photos and video online. She will look at whether businesses can utilise user-generated content to create their own advertising, looking at notorious and not so notorious examples from around the world.

**Nick McDonald, Potter Clarkson: "EU can't link to that?"**

Nick will analyse the effect recent CJEU decisions relating to the issue of communicating to the public will have on the interpretation of this form of copyright infringement in the context of social media.

**Charlotte Robson, Yawn Creative: "How social media has changed the way we create and market brands"**

Charlotte will look at how brands use social media to communicate their message and products to consumers, focusing on how businesses have had to adapt quickly in order to service the new ways we communicate and consume information.

**Azhar Sadique, Keltie LLP: "Social media and the law: tales, trends and template auto-responses"**

This talk aims to arm you with strategies to increase your social media content "efficiency", and illustrate the various methods through which social media can be used to fill in the missing links between infringing evidence.

**Helen Saunders, INCOPRO: "Has anyone seen my brand?"**

From the perspective of an internet monitoring company, Helen will cover the different types of social media; geographical and cultural variations in the way social media is used around the world; and the way in which brands are exploited by those seeking to abuse or piggyback on them.

**Catherine Wiseman, Barker Brettell: "Taking on take-downs: trade marks, trials and insta-gains"**

Catherine will explore trade mark infringement on the internet and the various take-down services available on social media.

# CITMA ENJOYS A THAMES-SIDE TIME OUT

*A stunning sunset capped off our recent Summer Reception at Sea Containers*

PHOTOGRAPHY BY SIMON O'CONNOR



CITMA MEMBERS AND guests from across the IP profession met high above the banks of the River Thames on 4th July for an evening of networking at the stunning Cucumber Bar at Sea Containers.

Some 200 guests enjoyed the lively event in the bright, modern surroundings featuring panoramic views of the London skyline. The venue's curvaceous green bar and canapés by the award-winning Green & Fortune contributed to another great summer occasion. The evening closed with a dramatic sunset.





- 1)** (L-R) Jackie Conway, Florian Traub (Squire Patton Boggs LLP); Anna Szpek (Urquhart-Dykes & Lord LLP)
- 2)** (L-R) Patsy Heavey (Formula One); Chris McLeod (Elkington and Fife LLP)
- 3)** (L-R) Laurie Smith (J A Kemp); Amelia Skelding, Roy Scott, Nick Bowie (Keltie); Nathalie John (GJE)
- 4)** (L-R) Rob Davey, Ilse van Haaren (CompuMark Clarivate Analytics); Kate O'Rourke
- 5)** (L-R) Lisa Cook (Corsearch); Jasmine Sihre (Cooley LLP)
- 6)** The gathering attracted some 200 members and guests
- 7)** The London skyline was a star attraction
- 8)** (L-R) Geoffrey Smith, Adjoa Anim, Chris Cottingham (HGF)



“

*Some 200 guests enjoyed the lively event in the bright, modern surroundings featuring panoramic views*





# Introducing the CITMA Paralegal

*Richard Hayward explains why it is time for a vital role to be better recognised*

A new category of CITMA membership has been launched: CITMA Paralegal. This has been established to recognise the roles and responsibilities of those in the profession, and the number of people working at this level. Everyone who was an Administrator member has automatically transferred to the new category.

These changes will help increase the skills, knowledge and standards of this part of the sector, assisting the profession in providing the first-class service for which it is well known.

## CPD OPPORTUNITY

To complement the launch, we are introducing a continuing professional development (CPD) requirement to the new category. This comprises eight hours of learning and development – four hours can be personal study – which members will need to complete each year. Specialist events and webinars run by CITMA will ensure Paralegal members have the best opportunities to earn focused CPD.

To become a CITMA Paralegal, and use the title, an applicant must have completed the Trade Mark Administrators' Course – which, from 2018, will be renamed the CITMA Paralegal Course.

The course will run each year and its standards will be continuously reviewed. The category will continue to be open to anyone working in the trade mark and design profession who has passed that course, or the earlier formalities course.

CITMA President Kate O'Rourke said: "This is more than just a change of name – it is a commitment we are making to do more to support and develop the work of trade mark paralegals, administrators and formalities staff.

"Many Chartered Trade Mark Attorneys and our firms rely on the excellent work of paralegal colleagues to deliver outstanding results for the organisations we represent. I am proud that CITMA is doing more to develop and recognise this vital role."

## CONSULTATION

The results of a consultation in 2015 confirmed that the role of trade mark administrators, paralegals and formalities staff has taken on increasing importance, and that the majority in these roles have responsibilities beyond basic administration and support.

The vast majority of members in all categories were in favour of providing further opportunities for trade mark administrators and paralegals to develop their skills, and better recognition of the role they play in the sector.

The number of those eligible for the new category continues to grow – 100 people took the Trade Mark

Administrators' Course exam this year. All those who passed will have the chance to join CITMA.

The course will continue to see lectures being delivered by experienced trade mark paralegals and attorneys. Topics covered include how to register a trade mark, searches, renewals and maintenance, changes of ownership, oppositions, and cancellations. The course also touches on registered designs and domain names.

## GROWTH OPPORTUNITY

The CPD requirement for this category will be mandatory for all new members who pass the CITMA Paralegal course from 2018 onwards. Therefore, the first year for self-certifying CPD will be 2019.

On renewal each year, members will be required to self-certify that they have fulfilled their CPD requirement. This will give CITMA Paralegal members a clear opportunity to grow and develop the skills they have gained throughout their professional career and on the course. It will also provide a way to demonstrate commitment to professional development to employers.

For more information on the new category, visit [citma.org.uk](http://citma.org.uk) ■



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# Rule your domains

*A Scottish event provided welcome insight into digital strategy, says Robert Buchan*

**T**he online threats facing brand owners and their customers are varied, and include the sale of counterfeit goods or customers being targeted by financial scams.

A CITMA Lecture in Glasgow, held in June, provided a domain-name update, and an interesting insight into how such threats are policed and resolved.

Suzy Wright, IP Counsel at the Royal Bank of Scotland, stressed the need to be agile and review any domain-name management policy to ensure it is fit for purpose. Since 2010, the bank's domain-names portfolio has reduced from around 8,000 domain names to around 2,700. With fewer customers typing in specific domain names, and instead searching for brands or products, there has been less need to register protective domain names in every top-level domain, or covering similar or misspelled names. The protection of core trade marks and brands will always be key, but IP is only one of a number of stakeholder interests to be protected. It is not always the key driver when issues of fraud, security and regulatory compliance are also present, she suggested.

Key threats facing banks include dedicated denial-of-service attacks on core domains, threatened data loss as a result of cyber-attacks and increasingly sophisticated scams/phishing. In conjunction with a domain-watching service, the bank has policies to deal with a varying level of threats, including immediate take-down of fraudulent sites, sending cease-and-desist letters for blatant IP infringement, and using domain-name dispute-resolution procedures to recover infringing domains.

Tim Brown from Demys, himself a panellist on the UK Dispute Resolution Service (DRS) procedure, provided practical tips on what brand owners or their advisors should avoid

if they want to successfully recover domain names. Large international brands can assume that, because they have an extensive collection of registered trade marks or domain names across the world, they are automatically entitled to recover any domain name registered by a domain-name speculator, and forget to meet the legal tests set out by the DRS.

In fact, brand owners must demonstrate that they have rights to the brand, particularly where the brand/domain in question is a generic dictionary word. Brown made reference to cases involving the fashion brand Mango and MOT services offered in a particular town. Even if a speculator seeks a large price for such domain names, detailed evidence showing that a generic name has gained a secondary meaning must be provided – for example, sales figures, advertising spend totals, or evidence of a global portfolio – in order to avoid failure and the need to pay a huge premium to a speculator.

Brown also reminded delegates that being successful in recovering a domain name is only part of the picture. The brand owner's team must also remember to renew key registrations to avoid speculators snapping them up when they lapse.

Although different brands and businesses will have different levels of threats in the domain-name sphere, the speakers provided interesting and practical guidance on how to successfully manage and protect a domain-name portfolio. ■



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# BANKING ON BRITAIN

*Rob Davey examines new data showing the impact of Brexit on UK trade mark application trends*



**B**efore 23rd June 2016, no one could have predicted just how far-reaching the impact of the Brexit referendum result would be. The political uncertainty will no doubt last for years to come, and aftershocks have been felt across even the most unlikely of industries. One of these industries is IP.

It has now been more than a year since the referendum, and data courtesy of CompuMark's Custom and Managed Solutions unit (using SAEGIS® on SERION®) throws up some interesting trends with regard to the number of brands and businesses filing EU and UK trade mark applications following the historic referendum result.

Before the Brexit vote, the average number of EU trade mark applications made by UK-based applicants per month was 933. Afterwards, however, this monthly average fell to 766 – an 18 per cent decline (see Figure 1). Although the results are perhaps unsurprising initially – it was

always likely that a vote to leave would lead to a dip in business confidence and uncertainty around commitment levels to the EU market – a fall of almost 20 per cent is significant, considering there is still a long way to go before the UK actually leaves the EU.

Interestingly, a very different picture develops when we look at the number of global businesses applying for UK trade marks. In the 18-month period preceding the Brexit vote, the average monthly filing figure for UK trade marks was 4,538, but, in the first 11 months after the referendum, this rose to 5,567. That is a 20 per cent increase in UK trade mark filings, which is a clear indicator of businesses proactively securing the relevant trade marks in anticipation of Brexit proceeding.

The importance of these results becomes much clearer once we focus on the number of UK applications being submitted by overseas applicants – an area in which there has been a 93 per cent increase. The average number

Figure 1 EU TRADE MARK APPLICATIONS BY UK APPLICANTS

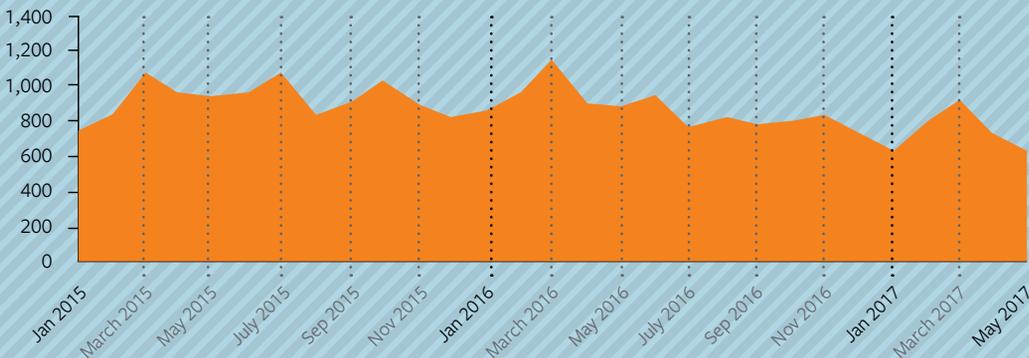


Figure 2 UK MONTHLY TRADE MARK APPLICATIONS



of monthly applications by US-based applicants in the 11 months following the referendum was 261, compared with just 104 in the 18 months beforehand. That is a huge increase of 150 per cent. Figure 2 shows that the sharp, sudden increase following the result continues to be sustained.

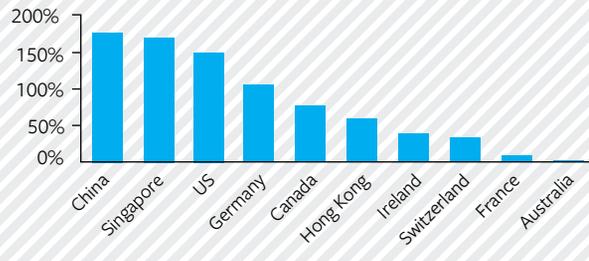
China was the only major country with a greater increase in average UK trade mark applications, with a monthly average of 170 filings post-referendum, compared with just 62 beforehand – a 175 per cent increase. Other countries whose monthly average applications have increased sharply include Singapore (168 per cent), Germany (104 per cent) and Canada (76 per cent).

But not every country seems to be quite so enamoured by the prospect of filing UK-specific trade marks. France’s monthly average increased by 10 per cent, while Australia’s grew by a mere two per cent.

Although the factors behind these results are likely to vary according to country, the overall increase in trade mark applications could be due to companies taking the precautionary measure of double-filing EU and UK trade marks. Our analysis of the data does suggest that some of the largest global brands have indeed begun filing in both the EU and the UK since last June.

This precaution could prove to be unnecessary, as it is very likely that a mechanism will be introduced to protect existing EU rights in the UK as part of the Brexit negotiations. However,

Figure 3 INCREASE IN UK TRADE MARK APPLICATIONS SINCE JUNE 2016 – BY APPLICANT COUNTRY



businesses at present seem intent on investing in securing their UK rights before the UK makes its EU exit.

Despite the lack of clarity surrounding Brexit and its aftermath, these statistics clearly prove that businesses are taking matters into their own hands and proactively seeking to protect the IP rights of their brands. It is a much-needed sign of encouragement for the trade mark community in these uncertain times. ■



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**Robert Reading**, Director of Custom and Managed Solutions, co-authored.

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IP

We have a number of positions available for:

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NQ to 5 years' PQE - London

Trade Mark Secretaries/Administrators  
All levels - Nationwide

# TOP FILERS 2016

*It is time once again to unveil the UK's busiest trade mark representatives, courtesy of corsearch.com*



## **DATA COLLECTION DETAILS**

Figures represent filers that are the current UK agents for EU trade marks or UK trade marks for which applications were made in 2016. They do not include corporate filers. Where a trade mark's ownership was transferred between agents, both the first and new representative will be credited. Figures do not represent WIPO-designated filings. Where firms have acquired other firms, the full representation of filing statistics may not be captured. Where firms have multiple IPO accounts under separate naming conventions, we cannot guarantee complete representation. For any individual enquiries, please contact [corsearch.ukservices@wolterskluwer.com](mailto:corsearch.ukservices@wolterskluwer.com)



## TOP 100 UK TRADE MARK FILERS

1	MARKS & CLERK LLP	616	51	A A THORNTON & CO	107
2	HGF LTD	467	52	WALKER MORRIS LLP	106
3	D YOUNG & CO LLP	427	53	STEPHENS SCOWN LLP	105
4	MURGITROYD & COMPANY	417	=	ELKINGTON AND FIFE LLP	105
5	BARKER BRETTELL LLP	392	55	WP THOMPSON	104
6	WILSON GUNN	386	56	FRKELLY	100
7	WITHERS & ROGERS LLP	376	=	TRADEMARKROOM LTD	100
8	URQUHART-DYKES & LORD LLP	346	58	BRIFFA	95
9	TRADE MARK WIZARDS LTD	336	59	ASHFORDS LLP	94
=	BOULT WADE TENNANT	336	=	CHANCERY TRADE MARKS	94
11	TRADEMARK EAGLE LTD	335	61	FREEMAN HARRIS SOLICITORS	89
12	STOBBS	311	62	LANE IP LTD	88
13	AXIS IP SERVICES LTD	302	=	TRADE MARK CONSULTANTS CO	88
14	GROOM WILKES & WRIGHT LLP	301	64	ADDLESHAW GODDARD LLP	86
15	KELTIE LLP	264	65	COOLEY (UK) LLP	85
16	MATHYS & SQUIRE LLP	227	66	BARON WARREN REDFERN	82
17	APPLEYARD LEES IP LLP	226	=	HASELTINE LAKE LLP	82
18	GILL JENNINGS & EVERY LLP	225	68	CARPMAELS & RANSFORD LLP	81
19	NUCLEUS IP LTD	216	69	BRISTOWS LLP	80
20	KILBURN & STRODE LLP	215	=	BROOKES BATCHELLOR LLP	80
21	DEHNS	214	=	FREETHS LLP	80
22	CSY	212	72	POTTER CLARKSON LLP	79
23	SWINDELL & PEARSON LTD	202	=	IRWIN MITCHELL LLP	79
24	BAYER & NORTON BUSINESS CONSULTANT LTD	195	=	KATARZYNA ELIZA BINDER-SONY	79
=	BIRD & BIRD LLP	195	=	CHAPMAN+CO	79
26	LEWIS SILKIN LLP	194	76	KEMPNER & PARTNERS LLP	78
27	VENNER SHIPLEY LLP	192	=	FRANKS & CO LTD	78
28	NOVAGRAAF UK	190	=	BIRKETTS LLP	78
29	TAYLOR WESSING LLP	189	=	TRADEMARKING4U LTD	78
30	PAGE WHITE & FARRER	188	80	BOND DICKINSON LLP	75
31	J A KEMP	179	=	PENNINGTONS MANCHES LLP	75
32	BECK GREENER	174	=	BLAKE MORGAN LLP	75
33	CMS CAMERON MCKENNA NABARRO OLSWANG LLP*	173	83	IP21 LTD	74
34	FORRESTERS	172	=	EDWIN COE LLP	74
35	WILDBORE & GIBBONS LLP	159	85	DLA PIPER UK LLP	73
36	FIELD FISHER LLP	154	86	BAILEY WALSH & CO LLP	70
37	BAKER MCKENZIE LLP	153	=	MAUCHER JENKINS	70
38	REDDIE & GROSE LLP	148	88	THE TRADEMARK CAFE LTD	69
39	ALBRIGHT IP LTD	147	89	CHARLES RUSSELL SPEECHLYS LLP	66
40	ABEL & IMRAY	146	=	FOX WILLIAMS LLP	66
41	WYNN-JONES, LAINÉ & JAMES LLP	143	91	WARD TRADE MARKS LTD	63
42	REVOMARK	128	92	THE TRADE MARKS BUREAU	62
43	TRADE MARK DIRECT	120	=	DUMMETT COPP LLP	62
44	STEVENS HEWLETT & PERKINS	116	94	TRADEMARKIT LLP	59
45	MEWBURN ELLIS LLP	115	95	SQUIRE PATTON BOGGS (UK) LLP	57
46	SILVERMAN SHERLIKER LLP	113	=	BRYERS LLP	57
47	DOLLEYMORES	112	97	WIGGIN LLP	56
48	SIPARA LTD	110	98	TLT LLP	55
49	HARRISON IP LTD	108	=	LAWRIE IP LTD	55
=	MISHCON DE REYA LLP	108	100	FILEMOT TECHNOLOGY LAW LTD	54

\*Figure represents total for the current merged entity over the data-collection period specified.

**TOTAL: 15,396**

## TOP 100 EU TRADE MARK FILERS

1	MARKS & CLERK LLP	645	51	WP THOMPSON	105
2	HGF LTD	469	52	HASELTINE LAKE LLP	103
3	FORRESTERS	451	53	NOVAGRAAF UK	101
4	STOBBS	388	54	STEVENS HEWLETT & PERKINS	99
5	D YOUNG & CO LLP	382	55	SILVERMAN SHERLIKER SOLICITORS	97
6	KILBURN & STRODE LLP	364	=	WILDBORE & GIBBONS LLP	97
7	BOULT WADE TENNANT	351	57	REVOMARK	96
8	BARKER BRETTELL LLP	350	58	DLA PIPER UK LLP	82
9	LANE IP LTD	299	59	AA THORNTON & CO	77
10	WITHERS & ROGERS LLP	297	60	FILEMOT TECHNOLOGY LAW LTD	75
11	BAKER MCKENZIE LLP	293	=	TRADEMARKROOM LTD	75
12	KELTIE LLP	282	62	ABEL & IMRAY	74
13	URQUHART-DYKES & LORD LLP	246	=	FREETHS LLP	74
14	KATARZYNA ELIZA BINDER-SONY	233	64	HARRISON IP LTD	71
15	MURGITROYD & COMPANY	229	65	LOCKE LORD LLP	69
16	GILL JENNINGS & EVERY LLP	228	=	DOLLEYMORES	69
17	COOLEY (UK) LLP	224	67	BAILEY WALSH & CO LLP	67
18	ALBRIGHT IP LTD	222	68	ASHFORDS LLP	65
19	BIRD & BIRD LLP	217	=	SQUIRE PATTON BOGGS (UK) LLP	65
20	MEWBURN ELLIS LLP	208	=	ELKINGTON AND FIFE LLP	65
21	CLEVELAND SCOTT YORK*	206	=	DUMMETT COPP LLP	65
22	LEWIS SILKIN LLP	202	72	MW TRADE MARKS LTD	63
=	J A KEMP	202	73	EDWIN COE LLP	62
=	FIELDFISHER LLP	202	=	SWINDELL & PEARSON LTD	62
25	CMS CAMERON MCKENNA NABARRO OLSWANG LLP*	186	=	RENAISSANCE SOLICITORS LLP	62
=	WILSON GUNN	186	76	SANDERSON & CO	61
27	BRISTOWS LLP	183	77	DECHERT LLP	60
28	MATHYS & SQUIRE LLP	182	78	NUCLEUS IP LTD	59
29	DEHNS	180	=	MAGUIRE BOSS	59
30	TRADE MARK DIRECT	179	80	HANSEL HENSON LTD	58
31	LADAS & PARRY LLP	178	81	STEPHENS SCOWN LLP	57
32	GROOM WILKES & WRIGHT LLP	176	82	CHAPMAN+CO	56
33	BECK GREENER	175	83	SIMMONS & SIMMONS LLP	52
34	REDDIE & GROSE LLP	172	=	FINNEGAN EUROPE LLP	52
35	MAUCHER JENKINS	165	85	GLOBAL IP LAW LTD	51
36	CARPMAELS & RANSFORD LLP	164	=	EIP	51
37	PAGE WHITE & FARRER	161	87	CLARKE WILLMOTT	50
38	MISHCON DE REYA LLP	141	88	NORTON ROSE FULBRIGHT LLP	49
39	JEFFREY PARKER AND COMPANY	139	89	IRWIN MITCHELL LLP	48
=	THE TRADE MARKS BUREAU	139	=	FRY HEATH & SPENCE LLP	48
41	POTTER CLARKSON LLP	131	91	MILLS & REEVE LLP	47
42	WYNNE-JONES, LAINE & JAMES LLP	123	=	FOX WILLIAMS LLP	47
=	VENNER SHIPLEY LLP	123	93	SERJEANTS LLP	46
44	SIPARA LTD	120	94	JAMES LOVE LEGAL LTD	44
45	TRADEMARK EAGLE LTD	118	=	JENSEN & SON	44
46	SHERIDANS	116	=	BOND DICKINSON LLP	44
47	TAYLOR WESSING LLP	113	97	WILLIAMS POWELL	43
48	APPLEYARD LEES IP LLP	112	98	WARD TRADE MARKS LTD	42
49	BRIFFA	110	99	OSBORNE CLARK LLP	41
50	AXIS IP SERVICES LTD	107	100	CHARLES RUSSELL SPEECHLYS LLP	40

\*Figures represent total for the current merged entity over the data-collection period specified.

**TOTAL: 14,258**



# WHAT'S THE STORY?

*Aaron Wood offers advice on which advocacy tools will bear the greatest fruit for your client*



In June, I was fortunate to have the opportunity to speak as part of a CITMA webinar on the subject of evidence and advocacy. The product of reviewing many past cases and speaking to counsel and senior members of the profession about their experiences with UK IPO cases, the webinar focused on those areas that most commonly cause difficulties before the IPO. The main thrust of the presentation centred on those elements that are likely to bear the greatest fruit in improving case outcomes: planning the case, finding and presenting the relevant facts, and planning the final advocacy of the case to reflect your initial outline.

UK IPO cost scales may remain paltry, but its approach to evidence seems to be becoming more forensic. It is my view that to overcome this difficulty more focus is needed on planning the case to ensure that the evidence-gathering and presentation stage – which is both the most costly and the most important stage – is done as efficiently and effectively as possible.

Although the points I made in the webinar had broader application (many are relevant to lawyers acting in commercial cases), the particular issues that apply before the UK IPO in terms of costs recovery and testing evidence meant these were areas of particular focus.

## EVIDENCE ISSUES

The particular issues that arise from the cases reviewed, and the practice notes of the UK IPO in relation to evidence, are that:

- A party cannot assume that the absence of cross-examination or evidence in reply means that its evidence will be accepted as showing what it asserts.
- Parties should not make broad, sweeping claims to use and repute where the evidence to support it does not exist.
- A party must be careful to deal with “missing” evidence where the evidence could and “should” have been provided to support an assertion.

There is a contingent of our profession that believes that facts asserted by a party and untested by cross-examination must be accepted, citing *EXTREME* (O/161/07). That is not entirely correct. Others have noted that Hearing Officers now seem to have an “EUIPO” approach to statements from interested parties, ie that they are now more liable to disbelieve a witness who is connected to a party, such as an employee of that concern.

Although parties may correctly note a natural reluctance to believe witnesses that have a connection to a party, this is the result of an approach that goes back to Geoffrey Hobbs QC sitting as the Appointed Person in *CLUB SAIL* (O/074/10) and subsequently developed by Daniel Alexander QC in *PLYMOUTH LIFE CENTRE* (O/236/13).

The effect of these decisions is that:

- It is not obligatory to regard the written evidence (ie the statement) as sufficient in itself to establish a fact or matter.
- Evidence is to be weighed according to the power of one side to produce it and the other to contradict it.
- If evidence is likely to exist and is not produced, a tribunal will be justified in rejecting evidence as insufficiently solid.
- A tribunal is entitled to be sceptical of a case that is inconclusive where the

evidence could easily have demonstrated it conclusively.

The combined effect of these four points is to make clear that where a party relies on an assertion there should be exhibits to demonstrate its truth rather than a bare claim. Where evidence cannot be provided, the reasons for its absence should be given. Evidence that does not go to a relevant assertion should be excised.

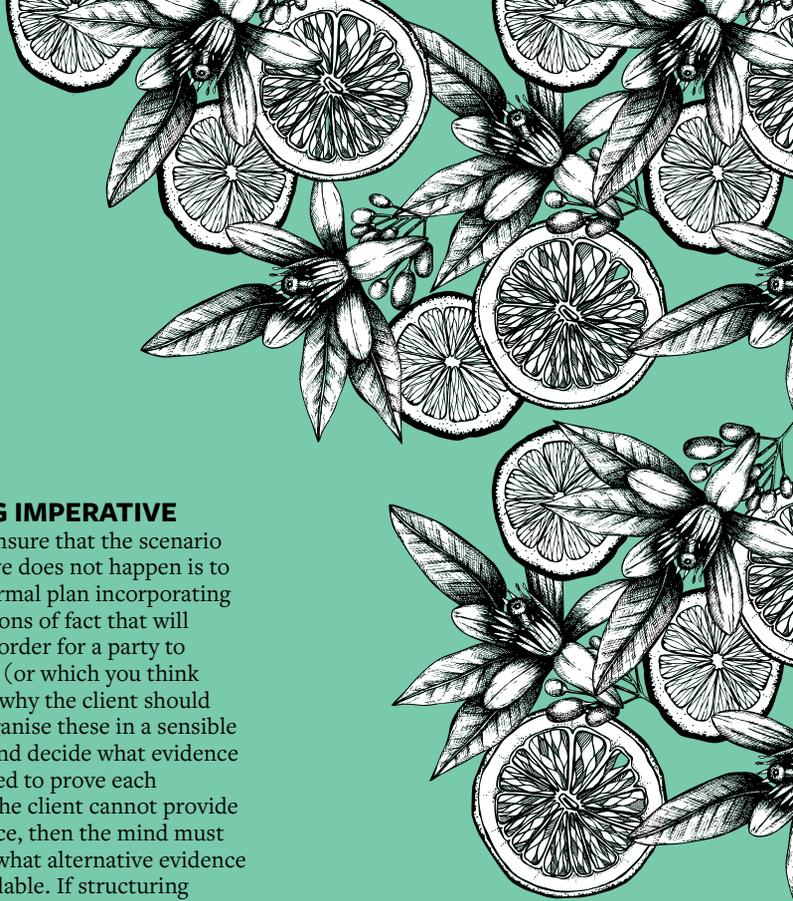
It may, in fact, be the case that, where a party submits a great deal of irrelevant evidence, this will render a case less impressive: it may leave the way open for the other side to argue that, if substantial effort has been expended on evidence, yet relevant evidence is missing, the tribunal should infer that such evidence does not exist. Tribunal Practice Notice 1/2015 gives a list of the most common sorts of irrelevant evidence offered.

## WITNESS STATEMENTS

Further issues upon which comment should be made are the tendencies for witness statements to be filled with submissions, for parties to feel obligated to use evidence deadlines, and for witness statements to be drafted by lawyers aiming to fulfil case requirements rather than present an accurate representation of the facts.

The role of a witness statement is to introduce facts that will ultimately be adopted as the truth by the decision-maker. It is a formal requirement that a party explain the basis for any belief and the source of any evidence (although those drafting witness statements often simply insert assertions of fact). The introductory paragraph of the witness statement, in which the witness explains their profession and background with the party (where relevant), lays the foundation for the witness to make assertions of fact and to be credible in saying evidence comes from personal knowledge.

It is very common for a witness to assert very broad use and repute that is not reflected in the evidence. This is a mistake. There is a difference between deficient evidence and claims



“

*Remember that, contrary to the opinion of some, the seminal cases TREAT and CHEVY do not lay down exhaustive conditions*

that are obviously untrue, and once the credibility of a witness is damaged decision-makers will be less likely to believe them with regard to other assertions. It is also common for witness statements to be drafted (poorly) by lawyers, and equally common to find judicial comment criticising these statements (even to suggest that litigants in person could do a better job). It may be that a narrower claim as to fact, combined with submissions that seek to build upon this solid evidence, is more effective.

Remember also that the deadline for evidence in response is just that. There is no obligation to file evidence in reply, and in many cases no such evidence will be available to refute the assertions of a party. Although a case on bad faith may involve conflicting stories, in most cases revolving around non-use or reputation, there will be no evidence that can be easily put forward to refute the evidence of the trade mark proprietor.

Submissions at that stage on the poor state of evidence merely give the party the opportunity to resolve those issues. In fact, GUCCI (O/424/14) suggests that some trade mark owners (or their representatives) may rely on this happening so that they have the opportunity to remedy issues in their evidence. It may be more effective to leave these submissions to the final hearing or final written submissions.

### PLANNING IMPERATIVE

One way to ensure that the scenario outlined above does not happen is to establish a formal plan incorporating all the assertions of fact that will be needed in order for a party to be successful (or which you think go to explain why the client should succeed), organise these in a sensible framework, and decide what evidence can be adduced to prove each assertion. If the client cannot provide direct evidence, then the mind must be turned to what alternative evidence might be available. If structuring the facts and arguments proves challenging, one suggestion is to put each relevant fact or argument on a sticky note and arrange them on a wall or table. The Trade Marks Act 1994 generally provides the structure.

Remember also that, contrary to the opinion of some, the seminal cases TREAT and CHEVY do not lay down exhaustive conditions. In the recent CRISTAL and ZUMA cases, both of which required the Claimants to demonstrate repute, the Claimants were successful despite having cases that, at least on the surface, did not correspond with the CHEVY “criteria”.

Finally, on the issue of oral hearings, I made a few key points:

- The skeleton argument that precedes the hearing (and must be filed by all professional representatives) is not intended to replace the oral hearing, but rather to guide the Hearing Officer and provide a “roadmap” for the hearing.
- A clear and well-planned structure will be all the more important in an

oral hearing, since it will be difficult for the Hearing Officer to follow arguments once the structure is lost.

- If questions are asked, attempt to answer them fully – immediately if possible. If the structure is well planned, there should be little issue in returning to the flow of the argument afterwards.

### NEXT STEPS

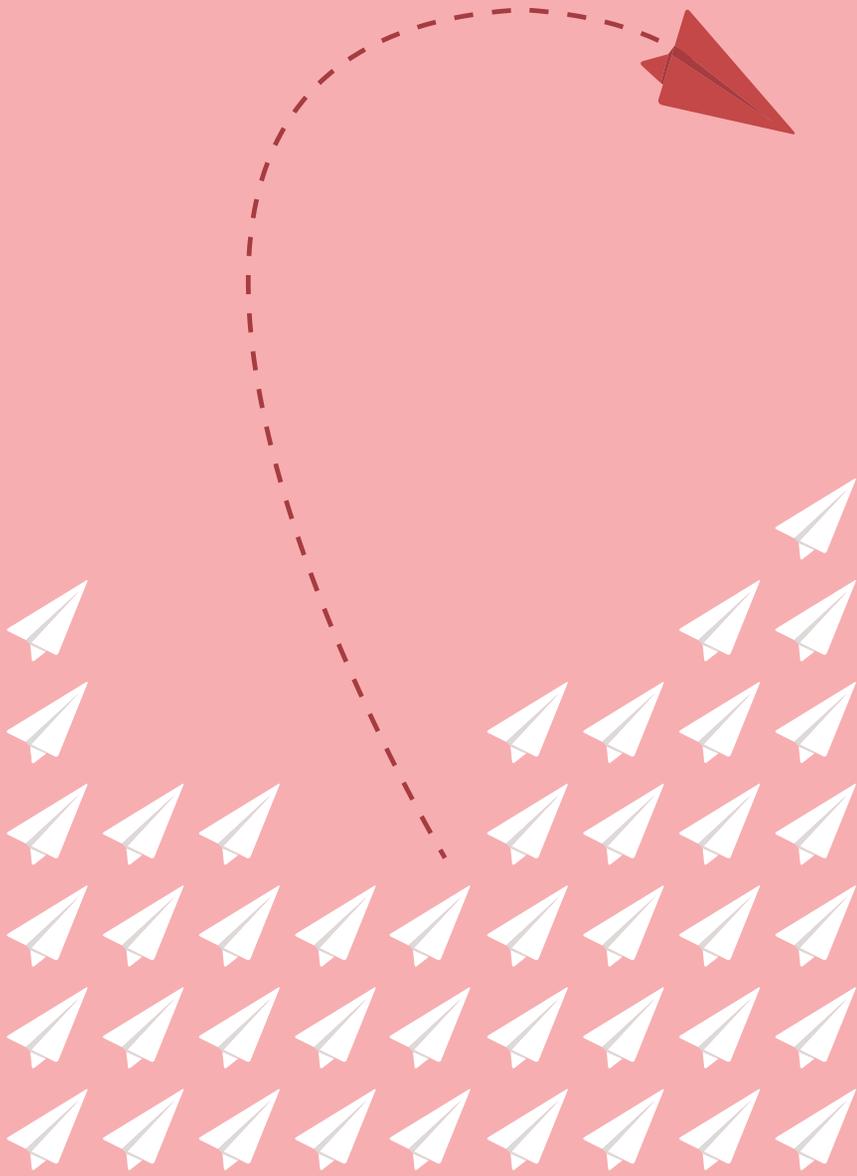
For those with an ongoing interest in developing their skills and abilities in this area, two “next steps” are recommended. First, consider attending the Litigation and Advocacy course run by Nottingham Law School, and second, consider purchasing the book by Michael Edenborough QC on the subject, which will be published by CITMA over the coming months. ■



#### AARON WOOD

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Aaron is a Trade Mark Litigator and Trade Mark Advocate with experience appearing at the UK IPO, before the Appointed Person, in the IPEC and in the High Court.



# BEAT THE CROWDS

*Claire Lehr offers eight key steps to help you navigate the EU's crowded registers with confidence*

Imagine this situation: you receive a request for a full “EU-wide” search. A “word search” of the EUIPO register produces hundreds of results and, when combined with searches of the national registers of the 28 Member States, the result is a daunting number of prior trade marks to be reviewed. So what can you do to produce a meaningful “first cut” report for your client and, ultimately, get to “yes”?

As I hope the suggestions in this article will show, it is possible to navigate through the thousands of hits likely to result from a dictionary word search of EU registers. And although getting to “yes” may not be feasible for each search result, providing the client with a focused, considered and manageable search report that identifies the greatest legal and commercial risks certainly is.

## 1. PRELIMINARY CHECKS

Where appropriate, and particularly with new or smaller clients, confer with the client on any pre-checks it may already have done. A UK-based client may tell you that it has already checked the UK IPO register, there are no identical marks and all is well – job done. Now is the time to highlight any marks that stand out in the client’s pre-checks that, although not identical, may be (closely) similar to the target mark, which may already have been enthusiastically released through a premature press release. In this scenario, now is the time to manage client expectations. ▶



In addition, a website search at this stage can throw up use of a mark – possibly unregistered – for the goods or services of interest.

## 2. DEFINE YOUR RANGE

Few clients actually require in-depth searches of each EU Member State’s register in addition to searches of EUIPO and the WIPO International Registry (IR). Many UK clients work in, or target, four or five “top” EU territories. Reviewing with the client the territories of most interest and importance will likely result in a compromise search strategy – perhaps full availability in the UK, EU and IR in those territories, and an “identical plus” search in the four or five EU territories of most interest. Such a search strategy will give a sufficient view of the most pertinent registers to allow you to assess the risks involved.

## 3. CONSIDER CLASSES

Consider the core use or proposed use by the client. The use may be complex – for example, a bookstore with an in-store coffee shop, or an online portal to be accessed exclusively by clients in the field of insurance broking. Ideally, the classes searched should be broad. Practically, however, your search report may well end up focusing on a single core good or

service, particularly if the search is for a dictionary word.

## 4. TYPE OF MARK

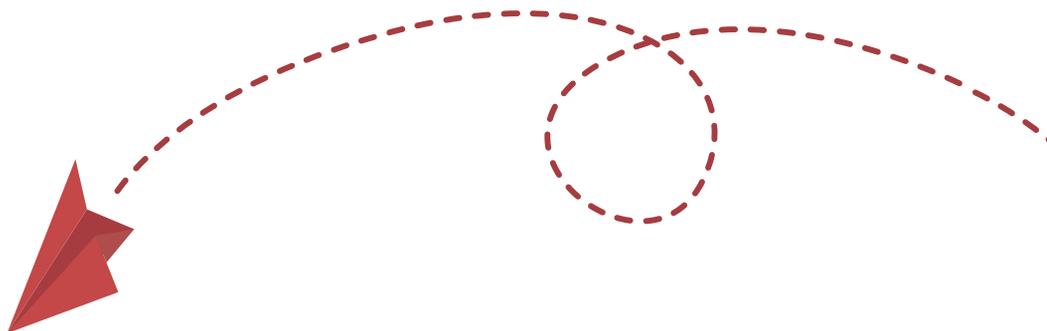
The EU registers are increasingly crowded, and rarely is it possible to “clear” a mark for use. The marks producing the most hits are dictionary words. Consider the ultimate use of a mark – will it be used with a house mark? Including the house mark will reduce the number of hits and provide a more focused result. Establish whether the mark is to be used within a more prominent device; such use will likely affect the commercial risk element of the search report.

## 5. ADD-ON ACTION

The internet is your friend! A surprising number of businesses still use a mark but do not seek to register their rights. Yet those unregistered rights can be used to challenge use and registration of a later-filed mark. Other “quick check” search sources include Companies House or a local EU equivalent. Take note of country-specific rights – for instance, in Spain and Sweden, which give proprietors particular rights for company names. Many retailers also use Twitter and Facebook. A domain-name search may already form part of your full availability search package(s).

“

*Reviewing with the client the territories of most interest and importance will likely result in a compromise search strategy*



## 6. NARROWING YOUR TARGETS

When your initial results are in, they might run to more than 2,000 pages of citations. Selecting marks with “double identity”, including local EU language equivalents, might narrow this to, say, 25 citations. Some basic checks may help reduce that number:

- Age of citations – do a website search to see what use, if any, has been made of marks that are more than five years old. A mark may be (partially) vulnerable to revocation proceedings on the basis of non-use, and may not safely be relied on in opposition proceedings.
- Family of marks – one entity owning more than three marks with the same characteristics may have increased rights in those marks. Check if at least three are used.
- Renewed marks – renewal could indicate an ongoing interest.
- Thomson Life<sup>1</sup> house mark bugbears – can you exclude marks that are confusingly similar according to Thomson Life if the search has revealed an identical mark(s) to that of interest?
- IP Translator<sup>2</sup> and class heading specifications – it can be difficult to identify the core interest of the proprietor, and online checks are essential to help narrow down the goods/services of real interest to the earlier rights holder.

## 7. WEIGH UP THE RISKS

Almost inevitably, there is a difference between the legal and commercial risk of using a chosen mark. A mark may have “double identity” with the mark searched, but if the earlier mark is

more than five years old and a website search reveals no information about the proprietor or its use of the mark, the commercial risk may be manageable. That said, a mark in the name of a company or individual about which no or scant information is available should not be instantly dismissed. The company may be a “straw” company, behind which lie the resources of a large company. Similarly, an individual proprietor may not be as innocuous as it appears on the register.

Certain names crop up repeatedly, including “mass filers” (so-called “trade mark trolls”) who file marks with the intention of “reserving” them on the registers and selling them at a later date – and for a high price. Such proprietors are more likely to challenge registration of a later mark to preserve their own rights.

Marks that are similar or identical to company names tend to present a higher commercial risk. Most companies are understandably more sensitive about a (perceived) variation of their house mark(s) and will be watching the registers closely.

Where a proprietor has opposed before, it knows the opposition ropes and will likely oppose again. Check to see which proprietors have opposed and the extent of the opposition(s).



### CLAIRE LEHR

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This article is based on an INTA Table Topic discussion held in May, which the author moderated.

“

*Check to see which proprietors have opposed and the extent of the opposition(s). Was it against specific goods or services, or all of them?*

Was it against specific goods or services, or all of them?

## 8. LATER STEPS

A client resolved to use a mark may “file and be damned”. Others may be cautious and try to close off possible challenges through mitigation – eg by purchasing an older mark through a straw company and/or instructing in-use investigations with a view to filing revocation proceedings. Some clients are more direct and approach the owner of a blocking older mark to demand its withdrawal following the results of an in-use investigation. ■

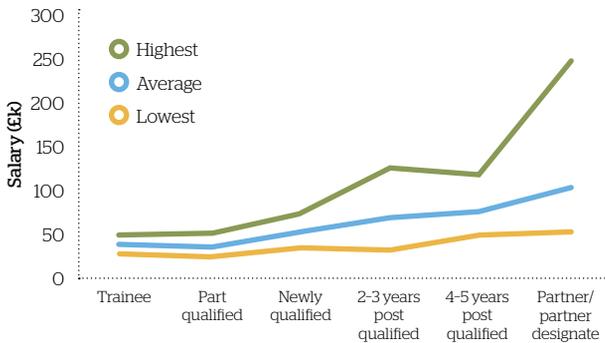
1. Case C-120/04, Medion AG v Thomson Multimedia Sales Germany & Austria GmbH.
2. Case C-307/10, Chartered Institute of Patent Attorneys v Registrar of Trade Marks.

# THE WAGE FOR THE WORK

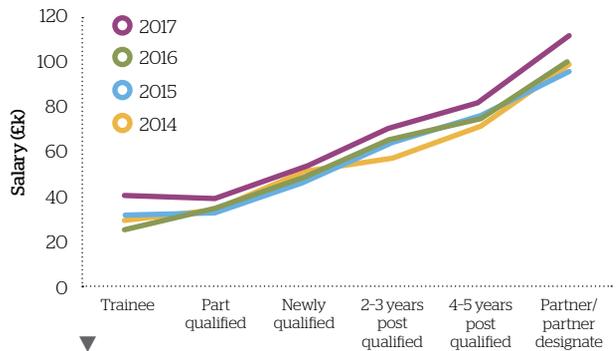
The latest Fellows and Associates survey includes insight on inclusion

## SALARY SPECIFICS

AVERAGE UK BASE SALARY BY YEAR OF QUALIFICATION

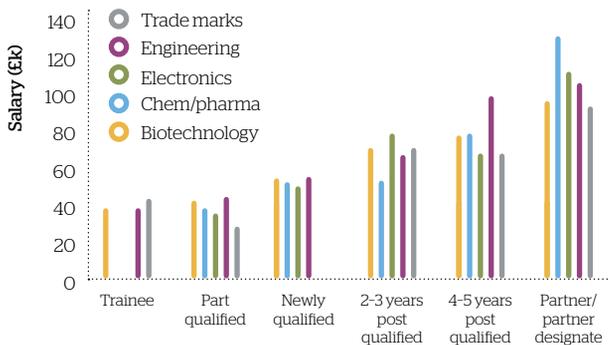


YEAR OF QUALIFICATION: SALARY TRENDS

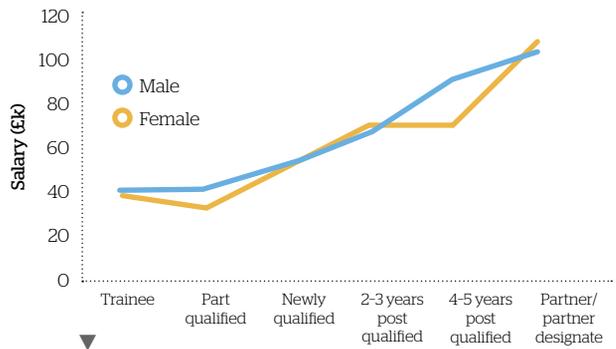


Note: some well-paid international contributors may have affected the 52% rise in trainee salaries

AVERAGE UK BASE SALARY BY TECHNICAL SPECIALISM

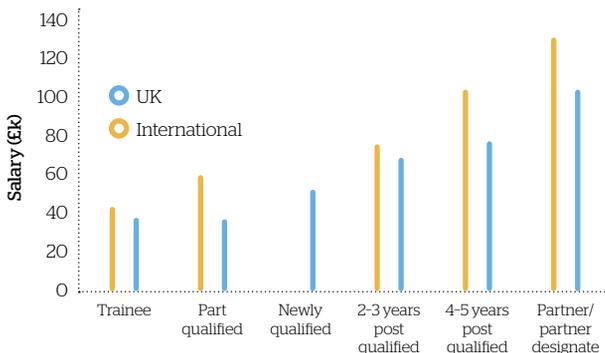


AVERAGE UK SALARY BY GENDER



Note: represents 96% of respondents

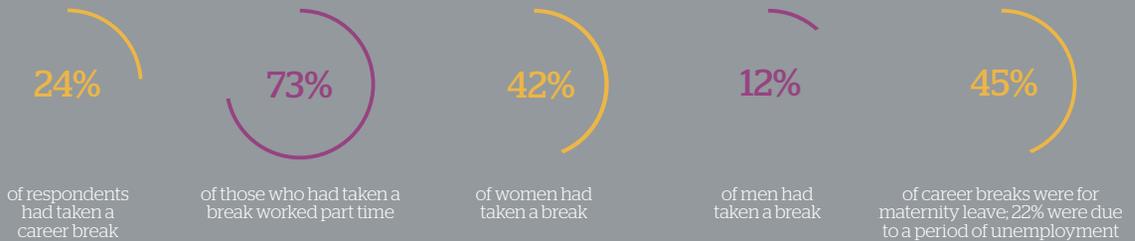
AVERAGE UK BASE SALARY: THE INTERNATIONAL GAP



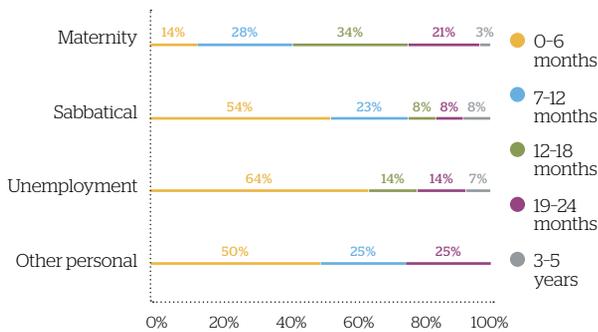
Note: although the UK appears to lag on base salaries, the widening gap between earnings for UK and international respondents may be partly a consequence of a weakening pound

## TAKING A BREAK

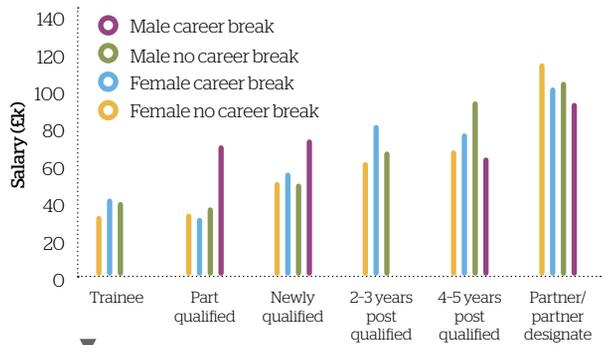
For the first time, participants were asked to indicate any career break they had taken lasting more than two months. Among the headline results:



## LENGTH OF CAREER BREAK BY REASON



## AVERAGE SALARY BY GENDER AND CAREER BREAK

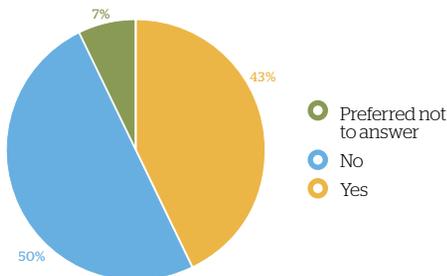


Interestingly, career breaks do not necessarily appear to have a detrimental effect on salary

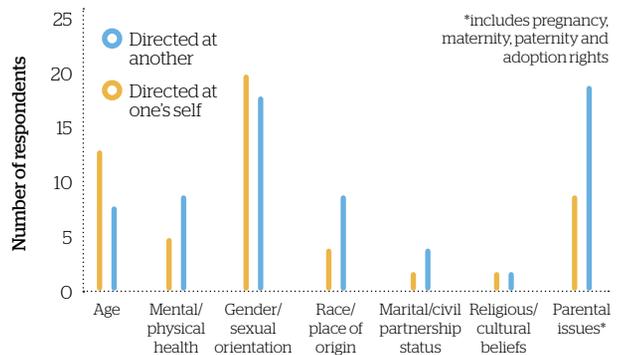
## INCLUSION IN THE SPOTLIGHT

This year, as part of Fellows and Associates' support for IP Inclusive, the survey incorporated questions related to discrimination in the workplace. Among the findings, 43% of respondents reported experiencing discrimination over the past two years. Of those, approximately two-thirds encountered more than one type of discrimination, either directed at themselves or a colleague.

## EXPERIENCE OF WORKPLACE DISCRIMINATION IN THE PRIOR TWO YEARS



## TYPE OF DISCRIMINATION FACED BY RESPONDENTS



Survey author: Michele Fellows. Number of participants: 206. Method of collection: Data from a salary survey of the IP profession collected between 2nd May and 11th June 2017. The online survey was accessible through a weblink that was promoted on the websites of Fellows and Associates, *The Patent Lawyer Magazine* and The Chartered Institute of Patent Attorneys. View the full results at [fellowsandassociates.com](http://fellowsandassociates.com)



*Robert Cumming sets out sensible precautions for employing emoji*

**T**he word “emoji” is a transliteration of the Japanese word 絵文字 (pronounced “eh-moh-jee”), which literally means “picture letters”. The little yellow faces in our daily text messages have evolved from the original emoticons, which combined punctuation and everyday letters to form facial expressions, such as:

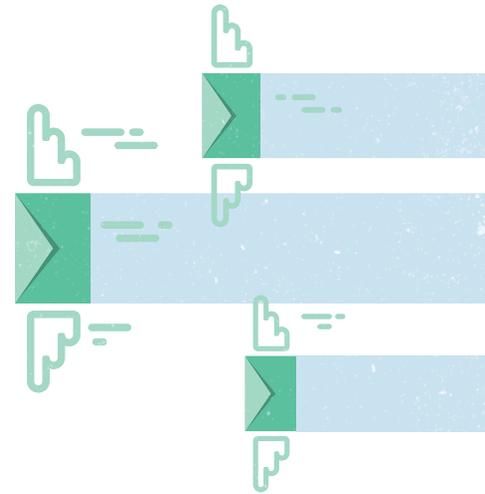
DESCRIPTION	EMOTICON	EMOJI	TRANSLATION
Slightly smiling face	:~)		Good mood
Winking face	;-)		Mischievous or humorous
Face with open mouth	:-O		Surprise, shock

First used in the late 1990s, emoji are described by their creator, Shigetaka Kurita, as “adding subtle emotional emphasis to a sentence in text”. They can now be used as search terms and hashtags, and in marketing communications generally, in the same way as traditional words and letters.

However, businesses that use emoji need to be sure they stay on the right side of the law. So where exactly do IP rights fit into the picture?

### USING EMOJI

In simple terms, emoji function like a font. Computers communicate across different hardware platforms by adopting the Unicode standard. This universal code ensures



that a message sent from one device is identical to that received on another. However, the visual appearance of the message will vary on each device depending on the operating software being used to display the message.

For example, the emoji at the right of this page might appear in a text-message conversation between two friends using different phone brands (ie one using an Apple phone, and the other a Samsung). The images correspond to the emoji set on each user's device.

### PROTECTION POTENTIAL

Each individual emoji is potentially protected by several IP rights. In the UK, copyright subsists in emoji as original artistic works by virtue of s1(1)(a) of the Copyright, Designs and Patents Act 1988. This entitles the owner to prevent the unauthorised copying of the whole or a substantial part of the work for 70 years. In the EU, new emoji are also protected by unregistered design right for the first three years after disclosure, pursuant to Article 11 of Council Regulation (EC) No 6/2002. Emoji may also be registered as Community designs, which can last for up to 25 years. Each image could, of course, be protected by trade mark law – though obviously not for fonts, messaging services or other descriptive items.

The use of emoji therefore brings a risk of infringement unless the owner has authorised the use of the IP rights.

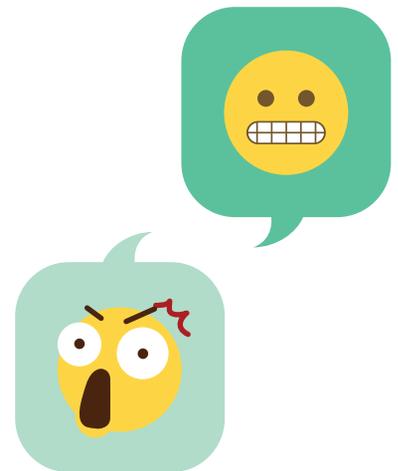
Fortunately, by default, the operating software on most devices permits the use of installed emoji, as

this is obviously necessary for them to function. Likewise, the terms and conditions of social media permit the use of emoji that are available within the platform. This means a business can promote itself using an emoji provided it does so within the website where it is created.

The position is more tricky when emoji are used outside the proprietary software ecosystem. A business cannot, for example, use Apple's or Samsung's emoji to promote its own goods or services without infringing the owners' rights. There are, however, freely available emoji sets, such as EmojiOne, whose owners allow them to be used commercially under the Creative Commons licensing scheme.

So, the bottom line is that emoji are protected by copyright, design right and trade mark law. This is not to say they are entirely off limits for use in a business if some basic precautions are taken:

- Consider whether you have permission to use the emoji in the specific format.
- Think about using emoji available under a Creative Commons licence, such as EmojiOne.
- Design your own original emoji.
- Always conduct clearance searches to check whether the emoji you wish to use is protected in your industry. ■



*The use of emoji brings a risk of infringement unless the owner has authorised the use of the IP rights*



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# Kit Kat bar is no badge

*Salmah Ebrahim explains why Nestlé once again failed in its bid for shape registration*

**IN THE LATEST** instalment of the ongoing battle to register the shape of the four-fingered Kit Kat bar as a trade mark in the UK, Nestlé's appeal before the Court of Appeal has been rejected. In particular, it was found that Nestlé had failed to demonstrate acquired distinctiveness within the meaning of Article 3(3) of Directive 2008/95/EC (the Directive). To acquire distinctiveness, an inherently non-distinctive shape mark must exclusively designate the goods it is applied to as originating from a particular undertaking. It is not sufficient to show only that consumers recognise and associate a mark with an applicant's goods.

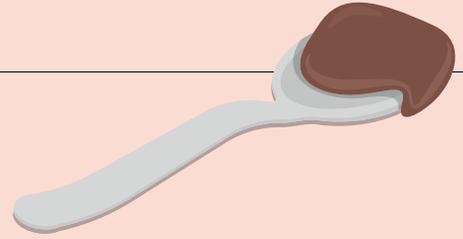
## **EARLY STAGES**

In 2010, Nestlé applied to register the shape of the four-fingered Kit Kat chocolate bar as a trade mark. The application was made in relation to class 30 goods. The shape in the application did not include the Kit Kat logo, which is embossed onto each of the fingers of the actual product as sold, but was instead sought as shown on page 27 (the Mark). Cadbury subsequently opposed the application, arguing, among other points, that the Mark

lacked distinctive character and its registration was therefore precluded by s3(1)(b) of the Trade Marks Act 1994, which gives effect to Article 3(1)(b) of the Directive. In defending its application, Nestlé argued that the Mark had acquired distinctive character as a result of the use that Nestlé had made of it prior to the application date.

In June 2013, the Hearing Officer (HO) found that the Mark was devoid of inherent distinctive character (except in relation to cakes and pastries) and had not acquired distinctive character in relation to any of the other goods in respect of which registration was sought. Nestlé subsequently appealed to the High Court, while Cadbury cross-appealed on the issue of allowing Nestlé's application to proceed in respect of cakes and pastries. In the process of deciding these appeals, Mr Justice Arnold deemed it necessary to seek a preliminary ruling from the CJEU and, following on from the CJEU's response, held that: the HO had not erred as a matter of law in addressing the issue of acquired distinctiveness, and had been correct in the decision reached; and that the appeal should be dismissed. Arnold J stressed that, to demonstrate that a sign had





“

*Trade mark law demanded that the relevant class of persons regard the shape concerned alone as exclusively indicating origin*

acquired distinctive character, the applicant or trade mark proprietor must prove that, at the relevant date, a significant proportion of the relevant class of persons perceived the relevant goods or services as originating from a particular undertaking because of the sign in question (as opposed to any other trade mark that may also have been present).

### APPEAL ARGUMENTS

By the time of the appeal, it had been accepted that the shape of the Kit Kat bar was not inherently distinctive, and the registrability of the Mark turned on whether it had acquired distinctiveness. This, however, was the point at which agreement between the parties ended.

Broadly, Nestlé argued that a substantial proportion of the relevant consumers, when presented with the 3D shape of the Kit Kat bar, had identified it as a Kit Kat and subsequently as a specific product from a single source, meaning the Mark is and was distinctive within the meaning of Article 3(3) of the Directive at the relevant date. Cadbury countered that the correct question had always been whether consumers had come to perceive the Mark as an indication of origin, and Cadbury had ultimately succeeded in its opposition because Nestlé's evidence merely established that consumers had come to associate the Mark with Nestlé.

### APPEAL DECISION

Dismissing the appeal, in the leading judgment (with which Lord Justice Floyd and Sir Geoffrey Vos, Chancellor of the High Court, agreed), Lord Justice Kitchin stressed the importance of distinguishing evidence that a significant proportion of the relevant class of persons

recognised and associated a mark with an applicant's goods from evidence that they perceived the goods designated exclusively by the mark applied for as originating from a particular undertaking. The latter, he noted, would secure the registration of an inherently non-distinctive 3D shape mark such as the Mark, while the former would not.

Kitchin LJ pointed to an applicant's exclusive right to use a shape in relation to a product should its application prove successful. A proprietor would not need to show a likelihood of confusion about the origin of the product (save for certain defences) in a trade mark infringement case, as a likelihood of confusion could be presumed even if consumers did not perceive the shape of the product as denoting the origin of the product and were not actually confused.

In addition, Kitchin LJ noted that the HO had properly taken into account additional facts, such as: there being no evidence that the shape of the Kit Kat bar had featured in Nestlé's promotional and advertising material; the Kit Kat bar having only ever been sold in an opaque wrapper; and the shape of the Kit Kat bar not having been shown on the packaging for the most part. At this juncture, it was also noted that it was relevant that there were other finger-shaped chocolate products on the market long before the application date that were never thought to be Kit Kats, and that the Kit Kat logo had itself always been embossed on the fingers of the Kit Kat bar.

In short, recognising and associating a product with an applicant was not enough: trade mark law demanded that the relevant class of persons regard the shape concerned alone (as opposed to any other trade mark that may be present, such as the Kit Kat logo) as exclusively indicating origin. Assessed against this backdrop, the shape of the Kit Kat bar did not perform the function of acting as a badge of origin.

### KEY POINTS

- ▶ To acquire distinctiveness, an inherently non-distinctive shape mark must exclusively designate the goods it is applied to as originating from a particular undertaking. It is not sufficient only to show that consumers recognise and/or associate a mark with an applicant's goods
- ▶ Evidence that consumers have come to rely on a mark as denoting the origin of the goods to which it has been applied will demonstrate that the mark has become distinctive, although this is not a prerequisite for demonstrating acquired distinctiveness

- ▶ The Nestlé mark



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# Attachment theory

*Tom Hooper warns of the potential dangers of selling similar products online*

**THIS CASE CONCERNED** trade mark infringement and passing off claims arising out of the sale of aluminium flagpoles on Amazon (Amazon was not a party to the proceedings, but the alleged infringement took place on its site.)

There were two Claimants in this matter, both of which had common shareholders. The first Claimant (Jadebay Ltd) owned UK trade mark registration No 2653159 for the DESIGN ELEMENTS device mark shown on page 29. This mark covered “flagpoles plastic storage box garden furniture” in class 20. It was filed on 18th February 2013 and registered on 30th August 2013. The second Claimant (Noa and Nana Ltd) sold the products of the first, under licence, from March 2011.

## BACKGROUND

It was alleged that the Defendant, at some point between July 2012 and February 2013, decided to use the Claimants’ Amazon listing to sell its own flagpole product. It is worth summarising how this issue can arise. An Amazon listing can be created by one seller, then used by multiple



*The Court found that the Defendant’s use on Amazon did infringe the Claimants’ registered trade mark rights and led to a likelihood of confusion*

sellers offering the same product. For example, a seller can review an existing listing (description, manufacturer, etc), confirm that the products are the same as its products, and then join the original listing. Amazon then tends to promote the cheapest of the offerings, allowing consumers to review each listing in more detail.

The Defendant purchased the Claimants’ flagpoles from Amazon and then attached its own product, sourced and purchased from a different manufacturer in China, to the listing. There was clearly some knowledge that the product was not exactly the same, although the quality and appearance of the products were very similar.

The Defendant alleged that it was entitled to attach the listing to the Claimants’ because it did not refer to any brand, let alone the registered trade mark, and the generic description of the products matched. The Claimants’ listing (to which the Defendant’s product was attached) mentioned that they were products “by DesignElements”. The Defendant’s product was branded “Feel Good UK”. The question was not whether the Defendant attached the sign or trade mark to the product or packaging itself, but whether the use of the listing in this way infringed (and/or passed off) the Claimants’ rights.

## COURT QUESTIONS

The IPEC had to consider a number of questions in order to ascertain whether trade mark infringement and passing off had taken place. In brief, the Court had to consider whether:

- (a) the Defendant had used in the course of trade a sign and goods that were identical (or similar) to the registered trade mark, and that such use led to a likelihood of confusion on the part of the public;
- (b) the Claimants had a reputation in their mark and that the Defendant’s use would be detrimental to the distinctive character or repute of the Claimants’ mark; and



(c) the requirements of passing off had been established (goodwill, misrepresentation and damage).

The Court's assessment as to whether the Defendant's use was use of the sign complained of was interesting. The Defendant argued that it had not used the sign complained of at all. It had merely listed a generic 20ft aluminium flagpole on Amazon. The Court dismissed this easily. The Defendant was selling a product listed as a 20ft aluminium flagpole "by DesignElements". The use was therefore not generic. Whenever the product was presented to a consumer (or possible consumer) it was expressed to be "by DesignElements". The consumer could easily discover that this was the manufacturer's brand. The Court was satisfied that there was use of the DESIGNELEMENTS trade mark.

The Court did not find the marks to be identical, because the registration relied upon was presented in a stylised font containing a blue flag device. It also had spacing between the words, while the sign complained of did not. This reduced the identity between the marks. But, as readers would surely agree, the marks were still highly similar. The Court went on to find that the use complained of was for flagpoles, an identical product.

After that conclusion was reached, the outcome was not really that surprising. Despite the fact that no actual confusion was evidenced, there was a very high likelihood of confusion on the part of the average flag-buying consumer.

Citing *Jack Wills v House of Fraser*, the Defendant attempted to argue that the lack of confusion was significant, especially since it had sold its products for around four years, and that, because the mark lacked distinctive character, a likelihood of confusion could not be found.

Taking into account all the relevant factors, and due to the weight in favour of it, the Court disagreed.

In relation to the passing off claim, the Claimants had submitted sufficient evidence of sales, positive consumer reviews and repeat purchases that goodwill was found (which was more than trivial). Misrepresentation and damage followed. This is not surprising, given the similarities between the marks, the identity between the products and the conduct of the Defendant. The fact that it had purchased the Claimants' product from Amazon clearly didn't help it in front of Her Honour Judge Melissa Clarke.

The Claimants did, however, struggle to show that they had a significant reputation in the mark and for a significant part of the public, so that ground was quite easily dismissed.

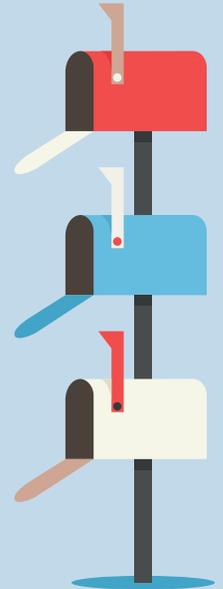
The Court found that the Defendant's use on Amazon did infringe the Claimants' registered trade mark rights, and that such use led to a likelihood of confusion on the part of the public. It also found that the Defendant's use amounted to a passing off of the Claimants' goods.

As a result, an injunction was awarded to restrain the Defendant from committing further infringing acts, together with damages amounting to more than £25,000.

## TAKEAWAYS

This case is another reminder that businesses should carefully consider their online marketing strategies, especially if they are selling their products through online auction sites. Attaching products to an existing Amazon listing when the products are clearly not the same could potentially be an infringing act.

Although the outcome is perhaps not surprising, it is a useful reminder of the types of marketing practices that are not permitted under trade mark laws. It also highlights (once again) the usefulness of the IPEC in awarding injunctions and damages.



## KEY POINT

- ▶ Attaching products to an existing Amazon listing when the products are clearly not the same could be an infringing act

1. [2014] EWHC 110 (Ch).

- ▶ UK trade mark No 2653159

*Design Elements*

- ▶ Use complained of: **by DesignElements**



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# Losing its marbles

*It is getting harder to find solid ground on distinctiveness, reports Katherine Thompson*

“SINCE THE TIME of the Roman empire marble has been extracted from quarries near the city now called Prilep, in the Balkan peninsula.” Thus began His Honour Judge Hacon’s judgment in *Mermeren Kombinat AD v Fox Marble Holdings plc*. Near to the city of Prilep, Republic of Macedonia, is a mountain pass called Sivec, where the notable marble at the centre of this case is quarried.

Mermeren Kombinat AD (Mermeren) is the proprietor of EU trade mark No 12057915 SIVEC, covering “marble of all types”, registered since 2013. Fox Marble Holdings plc (Fox) sells marble under the mark SIVEC. Mermeren accordingly brought infringement proceedings against Fox, which argued that its use merely indicated geographical origin, and that it had a defence under Article 12 of Council Regulation (EC) No 207/2009. Fox counterclaimed for invalidity under Articles 7(1)(b)–(d), 51(1)(b) and 52(1)(b). Mermeren denied these allegations, and claimed acquired distinctiveness under Article 7(3). Fox acknowledged that, if the mark did not indicate the geographical origin of the marble, the registration would be valid and the defence under Article 12 would also fall away. The case therefore turned on whether or not SIVEC indicated the geographical origin of the marble.

## TIMING QUESTION

This raised the question of whether the use made of a mark prior to its filing date can be taken into account when assessing its inherent distinctive character. Hacon J concluded that it should not. If use is automatically taken into account in the initial assessment under Articles 7(1)(b)–(d), what is the purpose of Article 7(3), allowing inherently non-distinctive marks to be registered on the basis of acquired distinctiveness?

Following this logic, Hacon J concluded that, Mermeren’s use of SIVEC aside, very few of the relevant consumers would have heard of Sivec the place (which is very small) at the filing date. They would not understand the mark to indicate the geographical origin of the goods. Therefore, the mark was inherently distinctive. So far, so simple.

## IMPACT OF USE

But there was a twist. As Fox argued, it is conventional to identify types of marble by reference to the place where they are quarried. Fox argued that the average consumer, on seeing Mermeren’s use of SIVEC, would assume that it indicated the place from which the marble originated, even if, prior to that point, it had no idea that such a place existed.

Hacon J did, to an extent, accept this reasoning. If a mark is used in a certain way, it could lead the average consumer to believe that it indicates the geographical origin of a product, even if the consumer has never heard of the place. A consumer can be educated into believing that a sign indicates a place, just as it can be educated into believing that the sign indicates commercial origin.

This is where a strict adherence to the distinction between the inherent distinctiveness of a mark and distinctiveness acquired through use starts to leave a gap for some counter-intuitive application of the law. Following this logic, a mark can be either inherently distinctive or inherently non-distinctive, but acquire distinctiveness through use. What it cannot do,



*Mermeren had failed to show any evidence prior to 2011 that it had used SIVEC in a way that indicated it was a brand*

on a strict reading of Articles 7(1)(c) and 7(3), is lose its distinctive character through use, even though it is possible to educate a consumer that a sign indicates the geographical origin of the goods in question.

Although it seems unlikely that a party would choose to educate consumers into believing that its brand is non-distinctive, that is largely what Mermeren was found to have done through its use of SIVEC prior to 2011. Mermeren had used and registered BIANCO SIVEC®, and referred to types of marble as “Sivec A”, “Sivec C”, etc, but failed to show any evidence prior to 2011 that it had used SIVEC in a way that indicated that particular mark was a brand.

### AFTER KIT KAT

This manner of use was, in Hacon J’s view, crucial to the impression that Mermeren’s customers received. Applying the still-fresh judgment of the Court of Appeal in Kit Kat, he drew a distinction between: a consumer associating a sign with an undertaking (which is insufficient to generate distinctive character); relying on the mark to guarantee origin (which demonstrates distinctiveness, but goes beyond the threshold necessary to show acquired distinctiveness); and – somewhere between the two – a mark having the ability to demonstrate exclusive origin when used on its own (even if consumers have not, in practice, relied on the mark alone to guarantee origin). The last of these three is what must be shown in order to demonstrate acquired distinctiveness.

The non-trade mark use made prior to 2011 may have led consumers to associate SIVEC with Mermeren, but it did not lend the mark the ability to demonstrate origin. It was only after 2011 that Mermeren started using SIVEC on its own (though use of BIANCO SIVEC continued), marking it with “®”. It was used in prominent positions and generally indicated to customers that this was a brand. Hacon J ruled that, as a result of this use, in the space of a mere two years, a significant proportion of relevant persons had changed their view and, by the filing date, would have seen SIVEC as an indicator of origin, lending it acquired distinctive character under Article 7(3).

The mark was deemed inherently distinctive, and, if use need not be taken into account in assessment of inherent distinctiveness, nothing further need be said. However, if Article 7(3) was also engaged, the mark was found to have indicated geographical origin by 2010 – but that impression was reversed through use during 2011–2013, so that, by the filing date, the mark had acquired distinctiveness.

### AMPLE INTEREST

This decision contains points of interest at both a theoretical and practical level. The interpretation that use of a mark should not be taken into account when assessing distinctive character under Articles 7(1)(b)–(d) is perhaps not often considered. When questions of acquired distinctiveness are not at stake, it is tempting to jump straight into asking what the average consumer’s perception of a mark is at the relevant date, and not to ask whether that perception is a result of the inherent qualities of the mark or of the proprietor’s use. Although it is hopefully rare that a brand owner’s use of a mark would weaken its distinctive character, there may be instances in which this is the case, and the ability to argue that such use should not be taken into account could make the difference between obtaining a registration and not.

On a practical level, the decision points towards the things that brand owners can do to educate consumers to see their marks as brands: use the ® symbol; put the mark in capitals; put it in a different font; use it as an adjective; use “look for” advertising; and use the mark in a consistent form. We have heard it all before, but this decision provides a welcome reminder that, following Kit Kat, the courts will be more alive than ever to the nature of a brand owner’s use, and whether this is trade mark use.

### KEY POINTS

- ▶ Following Kit Kat, it is more important than ever to ensure you use your mark as a trade mark\*
- ▶ Although a non-distinctive mark can gain distinctiveness through use, a strict reading of the law does not allow an inherently distinctive mark to lose its distinctive character that way (other than under Article 7(1)(d))



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# Taking Liberty

*Caroline Phillips reveals why a famous fashion brand was victorious*

ON 5TH DECEMBER 2015, Coco's Liberty Ltd (CLL) applied to register UK trade mark No 3139335 COCO'S LIBERTY in class 14 for jewellery-related products, including jewellery boxes.

Chanel Ltd (Chanel) opposed this application on the basis of an alleged likelihood of confusion with three earlier registered rights: UK trade marks Nos 2584184 COCO, 3099353 COCO CRUSH and 3109878 I LOVE COCO. The Hearing Officer (HO), for the purposes of procedural economy, focused his attention on Chanel's best case, the COCO mark registered, notably, in relation to jewellery.

The majority of the goods were found to be identical, as they were types of jewellery, while "jewellery boxes" were found to be similar to jewellery, as they may share trade channels, are available from the same outlets and are complementary. The level of attention of the relevant consumer was found to be "reasonable", as opposed to "high", because jewellery, although not an everyday purchase, is not an unusual one. The HO found that the marks shared a moderate degree of visual, aural and conceptual similarity, noting in particular that COCO would be understood to be a reference to a physical person, and finding that the words COCO'S and LIBERTY each had equal distinctiveness, as the elements of each mark hang together as a phrase.

Chanel argued that COCO and COCO CRUSH constituted a family of marks, and that COCO'S LIBERTY would be considered part of this family. The HO did not fully consider this, but he expressed scepticism.

## EVIDENCE

CLL (which was unrepresented) requested proof of use, but this was denied, as Chanel's earlier rights had not yet been registered for

five years before publication of the application. CLL submitted that third parties were also using COCO, but provided no evidence to back up the claim; therefore, the argument was dismissed. CLL argued that no actual confusion had occurred, but again provided no evidence that customers had been exposed to both marks. The HO therefore dismissed this submission.

Chanel argued that its use of COCO, and the links to its founder Gabrielle "Coco" Chanel, meant that the mark COCO had an enhanced level of distinctive character in respect of jewellery, and it provided evidence to support this. The HO considered the traditional factors: (i) market share; (ii) the intensity and geographic extent of the use of the mark; (iii) the amount invested in promoting it; (iv) the proportion of the relevant section of the public that identifies the goods as coming from a particular undertaking; and (v) statements from industry experts. Due to the evidence submitted and the fact that the mark relied upon did not reference CHANEL, there was no obvious link to Ms Chanel, and the claim was rejected.

## DECISION

Notwithstanding the finding that the mark COCO did not benefit from enhanced distinctiveness, and that women's forenames are not uncommon in the jewellery industry, the HO upheld the opposition, which was successful in its entirety. The case highlights the need for solid evidential support for all arguments.

## KEY POINTS

- ▶ Evidence of enhanced distinctive character must be provided for the mark as registered, or must create an obvious link to the registered mark, in order for an opposition to succeed
- ▶ It is crucial to plan submissions and support them with evidence



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# Can I be electric too?

*Submitting solid evidence remains important in passing off cases, says Samantha Collins*

**THIS INVALIDITY ACTION** was brought by Castle Rock Properties Ltd (CR), owner of the iconic London music venue the Electric Ballroom, against a UK trade mark registration for an identical mark in class 25 by Mr Ashdjian (the Proprietor).

CR relied on s5(4)(a) of the Trade Marks Act 1994, arguing that it had earlier use of the mark ELECTRIC BALLROOM for its music venue, clothing and operation of a clothes market in the venue.

The Proprietor put CR to proof of use and argued that, even if it had use, there was no misrepresentation, since the intended use was specifically for ballroom-dancing garments, thus “ballroom” would be descriptive of the goods, and “electric” would invoke a feeling normally associated with dancing.

## EVIDENCE OFFERED

CR asserted that staff members wear T-shirts and hoodies bearing the mark, and that some merchandise would have been sold to the public, but did not produce evidence to support this. It also argued that visiting bands were given permission to use the ELECTRIC BALLROOM name on their merchandise sold at the venue. The Hearing Officer (HO) did not agree that this proved use for clothing.

CR produced a screenshot of a Facebook page and an article on camdenguide.co.uk about the clothing market held at the Electric Ballroom until August 2014, but provided no evidence regarding the market’s sales or footfall. Equally, there was no evidence that the market was known outside Camden, London, so it was held that any goodwill in the operation of a clothes market was small, but more than trivial.

However, CR produced evidence including tickets, signage, social media screenshots and independent press articles showing that the venue had been called ELECTRIC BALLROOM since 1978, and that high-profile artists had played there. The HO held that this showed

the music venue was of cultural importance and that, although only at one location, “the length of use and the likely appreciation of the name by members of the public is symptomatic of a goodwill which is far more than trivial”.

Moving on to misrepresentation, the HO held that, although CR had goodwill in the mark for a clothing market, it was unlikely to expand into trading in branded clothing, and, of course, CR had failed to demonstrate goodwill for clothing itself, so no misrepresentation would occur on either basis. However, he held that there was misrepresentation when ELECTRIC BALLROOM was used for certain items of clothing, as a substantial proportion of the public would believe this was related to the venue of that name. The HO concluded that there could be damage here based on injurious association.

## COMPROMISE

Since all three elements of passing off were present, the application for invalidity succeeded. However, the HO indicated that the Proprietor could amend its specification to “articles of clothing, footwear and headgear for ballroom dancing”, or to include any other goods that are not traditionally merchandised goods, in order to avoid the objection.

This case highlights the importance of solid evidence in passing off cases, and the UK IPO’s willingness to find a compromise where the scope of the earlier goodwill is limited or the parties operate in markedly different areas. It is not at all surprising that the Proprietor has now limited its specification to goods for ballroom dancing, as suggested.



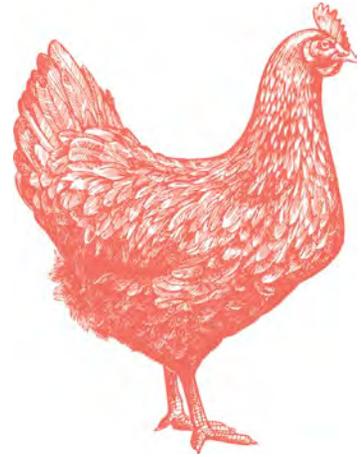
## KEY POINTS

- ▶ Evidence of use for identical goods was insufficient, but there were misrepresentation and damages, based on goodwill in the mark for an iconic music venue
- ▶ The HO identified a compromise position, allowing the Proprietor to avoid invalidity



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# Don't be absurd

*Oliver Tidman confirms the need to introduce all relevant evidence*

**THIS CASE CONCERNED** a consolidated declaration of invalidity brought by Dirtybird Restaurants Ltd (Dirtybird) against UK trade mark registrations Nos 3120192 ABSURD BIRD (figurative, series of four marks) and 3123434 ABSURD BIRD (the Registrations) in the name of Salima Vellani (the Registered Proprietor), covering, *inter alia*, class 43 services.

Based on Dirtybird's earlier UK trade mark registration No 3035551 BIRD, invalidity proceedings were brought under s47 of the Trade Marks Act 1994 (the Act) on the grounds of ss5(2)(b) and 5(4)(a) in respect of class 43 services only.

## BACKGROUND

Dirtybird first opened a restaurant in Shoreditch, London, on 28th April 2014, with substantial restaurant sales under its BIRD mark. From this time, Dirtybird also owned the domain name [www.birdrestaurants.com](http://www.birdrestaurants.com), which, along with the restaurant exterior and interior, all used a figurative BIRD mark rather than the word mark registered. Although Dirtybird's mark was clearly filed before both of the Registrations, it was registered in February 2016. Accordingly, the Registered Proprietor could not request proof of use.

Under s5(2)(b) of the Act, Dirtybird argued that the marks were highly similar and the class 43 services were identical. Relying on its passing off rights under s5(4)(a), it contended that it had considerable goodwill in the BIRD mark, and that use of ABSURD BIRD would cause misrepresentation and damage through loss of sales or detriment to the repute and distinctive character of its BIRD mark.

The Registered Proprietor alleged that its ABSURD BIRD mark had been created in 2013, prior to the filing of Dirtybird's mark. It contended that the first element ABSURD was particularly important and also denied that Dirtybird had any reputation or goodwill in the

mark BIRD in relation to "restaurant services" in class 43, as its use was of a figurative BIRD mark.

## INVALIDITY

The invalidity action succeeded in respect of all the class 43 services for which the Registrations were protected. Although it was accepted that the mark used by Dirtybird had a degree of stylisation, the distinctive element was still the word BIRD.

Taking account of the average consumer and the nature of the purchasing decision, the Hearing Officer (HO) was of the view that a low to medium degree of attention would be paid to the selection of such services. As the services were considered to be identical and the marks highly similar, there was a likelihood of consumers being indirectly confused.

It is worth noting that the only items of evidence admitted for the Registered Proprietor were its domain names [absurd-bird.com](http://absurd-bird.com) and [absurd-bird.org](http://absurd-bird.org), registered in December 2013. Numerous details regarding branding and photographs showing use of ABSURD BIRD post-July 2015, including "state of the register" evidence, were of no assistance to the HO.

This case serves as a reminder that, although the first element of a mark is considered important, the distinctive and dominant components must also be considered. Although the decision is unsurprising, it is nonetheless useful, as it highlights the need to provide relevant and dated evidence in relation to brand creation, which the Registered Proprietor failed to do in this case.

## KEY POINTS

- ▶ The distinctive and dominant component of the contested mark was the second element
- ▶ Given that the marks involved were highly similar for identical services, the HO declined to consider passing off
- ▶ It is always wise to include a passing off ground in any invalidity action

- ▶ UK registration No 3120192



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# Visii prompts revisitation

*Objections can be overcome by a new  
choice of words, writes Victoria Leach*

**DREAM IT GET IT** Ltd (the Applicant) filed a UK trade mark application for VISII for software in class 9, online advertisements in class 35, and “software as a service [SaaS]; [and] search engines (providing-) for the internet” in class 42. Vero UK Ltd (the Opponent) opposed the application based on an earlier EU trade mark registration, shown below.

The class 9 goods were considered identical, as the Applicant’s goods (software) encompassed the Opponent’s goods (computer software for design and manufacture). “Software as a service [SaaS]” in class 42 was considered identical to “licensing of computer software for design and manufacture” in class 45, and also highly similar in that both services allow access to software, meaning that the trade channels could coincide, and they could be in competition.

Nevertheless, the class 35 services were considered dissimilar. The Hearing Officer (HO) referred to the case of *Commercy AG v OHIM*<sup>1</sup> to support her decision that the Opponent’s provision of software and the design and development of software in class 42 could not be held similar to “online advertisements” simply because both involved software at some level.

The Opponent also sought to argue that the Applicant’s “search engines (providing-) for the internet” in class 42 overlapped with its educational and training services in class 41, as “search engine technology is an essential way of helping train people”. Unsurprisingly, this was rejected on the basis that the core meaning of the services is completely different. The opposition therefore failed in respect of “online advertisements” in class 35 and “search engines (providing-) for the internet” in class 42.

The Opponent’s mark, which possessed a high degree of inherent distinctive character, was found visually highly similar and aurally identical to the Applicant’s mark. A conceptual comparison was not relevant.

In view of the identity between the goods and services, and the high degree of similarity between the marks, a likelihood of confusion was found in respect of software in class 9 and software as a service in class 42. However, the matter did not end there. The HO cited *Mercury Communications*<sup>2</sup> to argue that a trader for a limited area of software should not obtain a monopoly over all software. She referred to Tribunal Practice Notice 1/2012 to decide that



*The HO decided that it  
was within her remit to  
devise a rewording of  
the specification*

it was within her remit to devise a rewording of the specification to overcome the objection. She therefore found that the Applicant’s mark could proceed for “search engine software” in class 9, but the term “software as a service” did not lend itself to a suitable limitation that would avoid a likelihood of confusion.

This case serves as a reminder to trade mark applicants in opposition proceedings that they can put forward alternative rewordings of the specification to invite the HO to avoid a finding of a likelihood of confusion.

## KEY POINTS

- ▶ In UK opposition proceedings, HOs have the power to propose a rewording of the specification to overcome the objection
- ▶ In doing so, the HO must have regard to any rewording proposed by the trade mark owner

1. Case T-316/07.
2. *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850.

- ▶ The Opponent’s mark



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# Thwartin' Morton's

*A private club proved its wider influence, reports Nicola Hill*

**THIS DECISION OF** the General Court (GC) upheld a decision of EUIPO's Board of Appeal (BoA) in which an EU figurative mark (the EUTM) containing the word MORTON'S was found to be invalid under Article 53(1)(c) of Council Regulation (EC) No 207/2009, read in conjunction with Article 8(4), in light of prior use in the UK by the Intervener of a series of unregistered marks containing the word MORTONS/MORTON'S.

In January 2012, Morton's the Restaurant Ltd (MTRL), operator of a UK private members' club, filed an application for a declaration of invalidity of the EUTM (registered, *inter alia*, in class 43, including restaurant and bar services), relying on its prior use of unregistered marks including MORTON'S and MORTONS RESTAURANT in the provision of food and entertainment. The Cancellation Division rejected the application. However, on 15th February 2015, the BoA annulled the Cancellation Division's decision, holding that MTRL had successfully invoked its prior rights, relying on the law of passing off.

The Applicant appealed the decision to the GC, relying on two grounds: infringement of Article 8(4), that the contested decision was flawed; and Article 52(1)(b), bad faith (not considered by the GC). The GC examined five complaints from the Applicant. All arguments were ultimately unsuccessful, but two points of interest bear further consideration.

## GOODWILL OWNED

To establish passing off, MTRL needed to demonstrate that it owned the goodwill in the earlier marks. MTRL is, however, only the operator of Morton's club, not the owner. Goodwill is inseparable from the business to which it adds value (*IRC v Muller* [1901] AC 217), and is recognised as legal property capable of

being assigned. Did the goodwill therefore reside with MTRL or the owner? A 2002 agreement demonstrated that MTRL had been granted the exclusive right to operate the club and use the trading names associated with it. It was, therefore, concluded from the evidence that goodwill was assigned with the management rights. This case thus demonstrates that it is important to ensure that goodwill is properly dealt with in any transfer of rights.

## LOCAL PRESENCE

The GC also rejected the argument pursuant to Article 8(4) that MTRL's prior rights had mere local significance, although club membership was small and localised in London. In applying Article 8(4), the GC was required to consider both the geographic and economic significance of the marks. Economic significance is demonstrated by the duration of use of the earlier unregistered mark and the degree of use<sup>1</sup>, both of which must be non-negligible.<sup>2</sup> On the evidence (including accounts and membership records), MTRL's degree of use was held to be non-negligible, despite modest membership and turnover due to its private-member status. From a geographical perspective, a series of national and international press articles, magazines and restaurant guides were submitted, including an article in British Airways' *High Life* magazine. Based on this evidence, the GC found Morton's Club to have a reputation extending beyond merely local significance.

## KEY POINTS

- ▶ Goodwill is legal property that is capable of being assigned. Anyone wishing to assert prior rights under the tort of passing off should verify the intended applicant for invalidity owns the goodwill prior to proceeding
- ▶ Under Article 8(4), a sign used in the course of trade having more than local significance is considered from both a geographic and economic perspective. Even a small, private London club may be able to demonstrate more than local significance with sufficient evidence

1. Case C-96/09P, *Anheuser Busch v Budejovicky Budvar* EUC:2011:189, para 160.
2. For example, Case T-534/08 (*GRANUFLEX*), 30th September 2010, not published.



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# Sabre put to the sword

*Olivia Gregory gets straight to the point of a dispute related to definitions*

IN 2015, US company Sabre GLBL Inc applied to register INSTASITE as an EU trade mark, covering various web-related goods and services in classes 9, 35 and 42 (the Mark). The Mark was refused as descriptive and non-distinctive, a decision that Sabre contested up to the General Court (GC).

Its appeal centred on three pleas:

1. Sabre had not been given the chance to present its comments on an argument of the Board of Appeal (BoA), as it was entitled to under Article 75 of Council Regulation (EC) No 207/2009 (EUTMR).
2. The Mark was not descriptive, so it should not have been refused under Article 7(1)(c) EUTMR.
3. The Mark was not devoid of distinctive character, so it should not have been refused under Article 7(1)(b) EUTMR.

## PLEAS REJECTED

In relation to the first plea, the BoA had identified the Mark as laudatory and an advertising slogan, which the examination division had not. Sabre submitted it had not been given a chance to comment on this. However, Article 75 applies to reasons on which decisions are based. The GC considered that the BoA had merely pointed out these factors, rather than taken them into consideration in the refusal of the Mark. Therefore, this plea was rejected.

Regarding the second plea, the initial objection was based on online definitions of “insta” and “site”. EUIPO’s use of online dictionary definitions is common, but the Applicant brought the probative value of such definitions into question. The GC dismissed this, noting that the definitions are from one of the main English dictionaries, privately operated and controlled (rather than, for example,

Wikipedia, which can be publicly modified). There are separate dictionary definitions for “insta” and “site”, so the Mark would naturally be split into two words by the relevant English-speaking public, which would understand the Mark as descriptive of goods/services for building websites quickly. There was nothing unusual about this combination. In its analysis, the GC kept returning to the principle that the Mark is to be interpreted from the perspective of the relevant public.

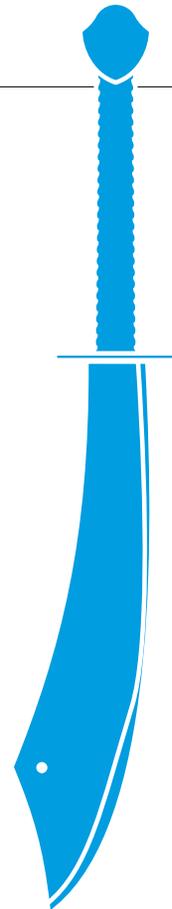
In light of the decision that the Mark was descriptive, the third plea was rejected as ineffective, as only one ground for refusal needs to apply for a mark to be refused registration.

## PUBLIC INTERPRETATION CRUCIAL

To conclude, this time, Sabre failed to make the cut.

Key points to consider are that: the right under Article 75 only applies to evidence/reasons on which decisions are based; online definitions can have probative value; and the relevant interpretation of a mark is, as always, that of the relevant public.

Ultimately, however, it is the relevant public’s interpretation that is crucial. If a dictionary definition that the relevant public would not recognise is cited, there is nothing in this case to suggest applicants could not undermine its relevance on that basis.



## KEY POINTS

- ▶ The right to present comments applies only to evidence/reasons on which decisions are based
- ▶ Online definitions can have probative value, but it is the relevant public’s interpretation that is crucial



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# Sun seekers

*Paul McKay shines light on a decision where two wine marks found themselves at odds*

**THE APPLICANT, AN** Italian wine producer, filed an EU trade mark (EUTM) application for the composite mark depicted below covering “wines” in class 33. This application was opposed by a Spanish wine producer on the basis of Article 8(1)(b) and 8(5) of Council Regulation (EC) No 207/2009. The marks relied upon included an EUTM registration for VIÑA SOL (“vineyard of the sun”). In addition, an EUTM for SOL was relied upon for Article 8(1)(b) only. Both marks covered “alcoholic beverages (except beers)” in class 33.

The Opponent was successful under Article 8(1)(b), the Opposition Division taking the EUTM SOL as its point of reference. The Applicant appealed, and the decision was upheld by the Board of Appeal (BoA), which also chose to examine the grounds under Article 8(5) that were not considered by the Opposition Division.

The BoA found that VIÑA SOL had a reputation in the EU with regard to wines, which, in conjunction with the similarity of the signs at issue, the distinctive character of VIÑA SOL and the fact that the goods were identical, was sufficient to establish a link between the signs for a substantial proportion of Spanish-, Portuguese- and French-speaking consumers. On further appeal, the General Court (GC) annulled the BoA’s decision on the basis that it did not make clear whether the BoA had taken into account the Applicant’s evidence in support of the weak distinctive character of the words “sol” and “sole”. On re-examination of the evidence, the BoA confirmed its decision and rejected the application.

## SECOND ATTEMPT

The Applicant filed a second appeal before the GC. In its judgment of 31st May 2017, the GC overturned the BoA’s decision, holding that it had erred in its reasoning regarding comparison of the marks. It found that the Applicant’s evidence did alter the overall assessment of the

similarity of the marks. The evidence submitted included: website extracts demonstrating that different undertakings offered wines in the EU under marks that included the words “sol”, “sole”, “soleil” or “sun”, and various images of the sun; and lists of EUTM registrations that covered goods in class 33 and contained the same words or images.

Although the GC found the mark VIÑA SOL to be somewhat fanciful, it considered VIÑA to be only weakly distinctive and SOL to be of below normal distinctiveness, with the figurative element also found to add a certain degree of originality to the Applicant’s mark. By contrast, the dominant element of the contested EUTM did not consist solely of the word SOLE, but of the association of the terms SOLE and ITALIANO. Therefore, the GC concluded that the mere reference to the sun was not capable of conferring conceptual similarity.

## CONCLUSION

Overall, given the dissimilarity of the marks and the weak distinctive character of the earlier marks, even if it enjoys reputation (which was not challenged during any of the proceedings) and the marks are registered for identical goods, the public will not make any association between the marks.

So, even if a mark’s reputation is demonstrated and not contested (as in this case), if it is found to have a low distinctive character, it will be difficult to rely on Article 8(5), even for identical goods. This case also shows that it clearly pays to be vigilant when reviewing EUIPO decisions.

## KEY POINTS

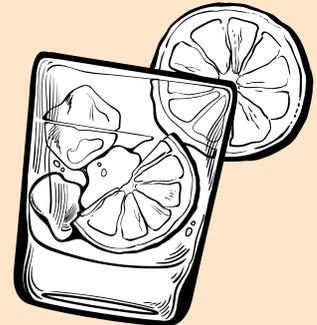
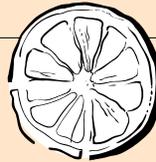
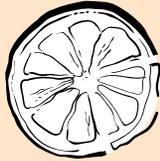
- ▶ Even where the reputation of a trade mark is not contested, if it is found to have an inherently low distinctive character, it will be difficult to rely on Article 8(5), even for identical goods
- ▶ It pays to review EUIPO decisions critically with regard to the assessment of evidence, as the GC may order the BoA to review the evidence until a correct decision is reached

- ▶ The Applicant’s mark



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# Raw roars again

*Chris Morris sets out the Court's conclusions on another raw mark dispute*

IN DECEMBER 2013, Mediterranean Premium Spirits, SL (the Applicant) filed an application to register the word mark GINRAW as an EU trade mark (EUTM) in classes 21 and 33 for “household and kitchen utensils” (among others) and “alcoholic beverages (except beers); [and] gin”, respectively.

G-Star Raw CV (the Intervener) filed a notice of opposition to the registration of the mark, based on its earlier EUTM for the word mark RAW, in respect of all of the goods applied for. The opposition was upheld at first instance and by EUIPO’s Board of Appeal (BoA). The Applicant appealed to the General Court (GC).

## OPPOSITION BASIS

The opposition was based on Article 8(1)(b) of Council Regulation (EC) No 207/2009, namely a likelihood of confusion on the part of EU consumers. The appeal considered the Applicant’s following pleas in law:

- The BoA infringed its obligation to state reasons for its decision. It was held that the BoA is not required to provide an exhaustive account of the lines of reasoning so long as the facts and considerations that have decisive importance, in the context of the decision, are set out.
- The goods applied for are not similar to the goods for which the intervener’s sign is registered. The Applicant unsuccessfully argued that “shakers, manual mixers (cocktail shakers), cocktail stirrers, cocktail straws, cocktail sticks, [and] cocktail mixing sticks”, covered by the mark applied for, and “household or kitchen utensils and containers”, covered by the earlier mark, are not similar. Pointing to the Explanatory Notes of the Nice Classification, the GC held that the “shakers, etc” applied for are utensils and containers typically found in the kitchen, and are therefore identical goods.
- There is no similarity between the signs. The GC found an average degree of visual and phonetic

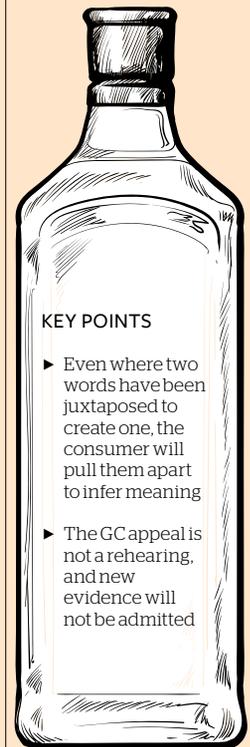
similarity, as well as conceptual similarity. It was held that consumers would focus more on the element “raw” within the mark applied for, which is dominant, than on the element “gin”, which is descriptive.

- A global assessment of likelihood of confusion is pointless, because there is a lack of similarity between the goods and signs at issue, and the earlier mark RAW is descriptive. The GC considered the BoA’s views in relation to the similarity of the goods and signs, and the distinctiveness of the earlier mark, and concluded it was right to find that there was a likelihood of confusion in relation to the mark. Consequently, the appeal failed.

## CRUCIAL VIEW

This case confirmed how the Courts believe consumers view marks – namely, even where two words have been combined to create one new word, it is natural for consumers to pull them apart in an attempt to understand the mark’s meaning, which can produce dominant elements. In this case “gin” was the more familiar element, which meant that consumers would focus more on the element “raw”, which was identical to the earlier mark.

As regards procedure, the Applicant attempted to submit new evidence to the application in the form of EUIPO decisions and Wikipedia extracts. As the role of the GC was to review the legality of the decision of the BoA, only the annexes that related to EUIPO’s decision-making practice were admissible.



### KEY POINTS

- ▶ Even where two words have been juxtaposed to create one, the consumer will pull them apart to infer meaning
- ▶ The GC appeal is not a rehearing, and new evidence will not be admitted



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# Uphill battle

*Dale Carter explains why demonstrating EU genuine use can be a mountain to climb*



ON 21ST AUGUST 2009, the mark shown below was registered to Kaane American International Tobacco Company FZE (Kaane) under EU trade mark (EUTM) No 007157233 for “tobacco; smokers’ articles; [and] matches” in class 34.

On 22nd October 2014, Global Tobacco FZCO filed an application to revoke the registration for non-use. Kaane filed evidence, which in summary consisted of:

- evidence of participation in international tobacco trade fairs in the EU between 2006 and 2013, including photographs of trade stands bearing the word mark GOLD MOUNT;
- invoices detailing costs for hosting trade stands at those fairs;
- one invoice issued by a magazine publisher;
- one copy of a magazine advertisement in *Tobacco Asia* showing the word mark GOLD MOUNT;
- copies of customs receipts relating to the import of small volumes of cigarettes for the purpose of attending trade fairs; and
- an analysis report issued by a laboratory in Germany, testing Kaane’s cigarettes for levels of tar, nicotine and carbon monoxide.

On 28th July 2015, the Cancellation Division upheld the application for revocation, finding that there had been no genuine use of the mark and no justifiable reasons for non-use. Kaane’s appeal to the Board of Appeal (BoA) failed, so it appealed to the General Court (GC), which held as follows:

- The BoA had correctly assessed the evidence and it could not be relied upon to establish genuine use.
- The figurative element in the EUTM was co-dominant with the word element and was absent from Kaane’s evidence. The mark used did not constitute an acceptable variant.
- Kaane admitted there had been no sales of its GOLD MOUNT cigarettes in the EU, because they did not meet EU regulatory standards. Participation in trade fairs could not be linked

to actual sales or marketing of the products in the EU.

- The *Tobacco Asia* advertisement did not target the relevant (EU) public.
- The customs documents did not refer to the registered mark, and Kaane had not provided any additional explanation or information regarding these documents.
- The regulatory barriers to Kaane marketing its cigarettes in the EU did not arise independently of the will of the proprietor and could not be considered a proper reason for non-use (unlike the securing of marketing authorisation for pharmaceuticals).
- Proper reasons for non-use must cover the entire five-year period. Kaane had only attempted to satisfy EU regulatory requirements towards the end of that period.

## LATE ACTION

The GC did not look favourably on Kaane’s late attempt to reformulate its product so as to comply with EU regulatory standards. Ultimately, the barrier preventing Kaane from selling its GOLD MOUNT cigarettes on the EU market was of its own making, and this was not sufficient to justify non-use of the mark. Trade mark owners should note that regulatory barriers to the commercialisation of a product in the EU may not offer a justifiable reason for non-use if it is within the control of the proprietor to overcome those barriers. This case also reminds us of the importance of using a trade mark in the form in which it is registered.

## KEY POINTS

- ▶ Regulatory barriers preventing access to the EU market will not always justify non-use of a mark
- ▶ Use of a variant mark where one co-dominant element of the registered version is missing is unlikely to be use of an acceptable variant

- ▶ The Kaane mark



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# events

More details can be found at [citma.org.uk](http://citma.org.uk)

DATE	EVENT	LOCATION	CPD HOURS
12th September	<b>CITMA Lecture – Leeds</b> The afterlife of brands: Trade mark registrations and insolvency	HGF, Leeds LS11	1
13th September	<b>CITMA Webinar</b> Trade marks and EU competition law	Log in online	1
26th September	<b>CITMA Lecture – London*</b> Reflections on brand licence agreements – the good, bad and stuff in between	58VE, London EC4	1
5th October	<b>CITMA Lecture – Nottingham</b> Trade mark case-law update – an analysis of issues and trends arising from recent key trade mark decisions	Potter Clarkson LLP, Nottingham NG1	1
12th October	<b>CITMA Autumn Conference &amp; Networking Drinks Reception – Birmingham*</b> IP and social media	Hyatt Regency, Birmingham B1	5
24th October	<b>CITMA Lecture – London*</b> Nailing jelly – tips on effective trade mark practice	58VE, London EC4	1
27th October	<b>CITMA Paralegal Seminar</b> Madrid protocol: tips and tricks – what paralegals need to know	Keltie LLP, London SE1	
1st November	<b>CITMA Seminar for Litigators – London</b>	Carpmaels & Ransford LLP, London WC1	2.5
15th November	<b>CITMA Webinar</b>	Log in online	1
28th November	<b>CITMA Lecture – London*</b> Update on UK IPO and UK court cases	58VE, London EC4	1
8th December	<b>CITMA Christmas Lunch – London**</b>	London Hilton on Park Lane, London W1	
13th December	<b>CITMA Northern Christmas Event</b>	TBC	

## SUGGESTIONS WELCOME

We have an excellent team of volunteers who organise our programme of events. However, we are always eager to hear from people who are keen to speak at a CITMA event, particularly overseas members, or to host one. We would also like your suggestions on event topics. Please contact Jane at [jane@citma.org.uk](mailto:jane@citma.org.uk) with your ideas.

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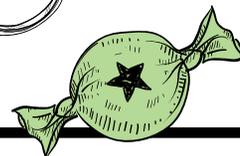
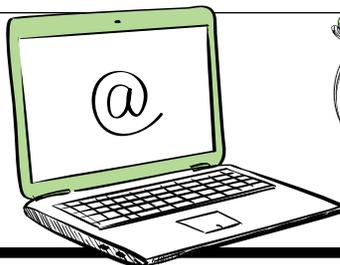


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## THE TRADE MARK 20

# Q&A



**I work as...** a self-employed Trade Mark Paralegal, serving clients in China, the EU and Singapore. I work from home and am the mother of two children, aged two and four. We recently relocated back to Singapore from the UK.

**Before this role, I was...** a Trade Mark Paralegal at a small specialist firm in Oxford, where I managed the office and all fee-earning responsibilities. That spurred me to start my own humble business – why not?

**My current state of mind is...** chaotic. I have too many things on my plate, and I have just volunteered to write for the *CITMA Review* too!

**I became interested in IP when...** I started my first proper job at a boutique IP firm in Singapore. I was exposed to all areas of IP, but trade marks interested me the most, maybe because they involve a process that is so simple, yet complex at the same time.

**I am most inspired by...** Steve Jobs. I love the products he created, and am inspired by his perseverance and his advice to never stop searching, and to “stay hungry”. He changed the way we think, work and play.

**In my role, I most enjoy...** when my clients drop brand names into my lap and trust that I will make it work for them – as if by magic.

**In my role, I most dislike...** clients who make lots of enquiries and then go and make their own applications!

**On my desk is...** my MacBook Air, iMac, iPhone, iPad – need “iSay” more?

**My favourite mug says...** “Drink coffee”.

**My favourite place to visit on business is...** a nice resort by the beach – anytime, anywhere.

**If I were a brand, I would be...** Tiffany & Co. Like a small diamond hidden inside one of their exquisite blue boxes, we support staff are behind the scenes, doing the ground work for our bosses.

**The biggest challenge for IP is...** Brexit.

**The talent I wish I had is...** the ability to stop time.

**I can't live without...** my children and husband. I cannot imagine the world without them.

**My ideal day would include...** a good cup of coffee and a break from work.

**In my pocket is...** a mint.

**The best piece of advice I've been given is...** never give up. And Steve Jobs once said that “simplicity is the highest sophistication”. That inspired me to keep things simple for my clients; I handle the difficult part.

**When I want to relax, I...** just want to sleep. But I can't do that with two young children running around!

**In the next five years, I hope to...** be a Trade Mark Attorney (if possible), although we haven't got the specialised option here in Singapore.

**The best thing about being a CITMA member is...** that it's a recognition of the hard work I have put in over 18 years, going from being a secretary to a CITMA Trade Mark Administrator and (now) a CITMA Paralegal.



Steve Jobs is inspiring Singapore-based Sabrina Moden



*Trade marks interested me the most, maybe because they involve a process that is so simple, yet complex at the same time*

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