

CITMA REVIEW

ISSUE 443

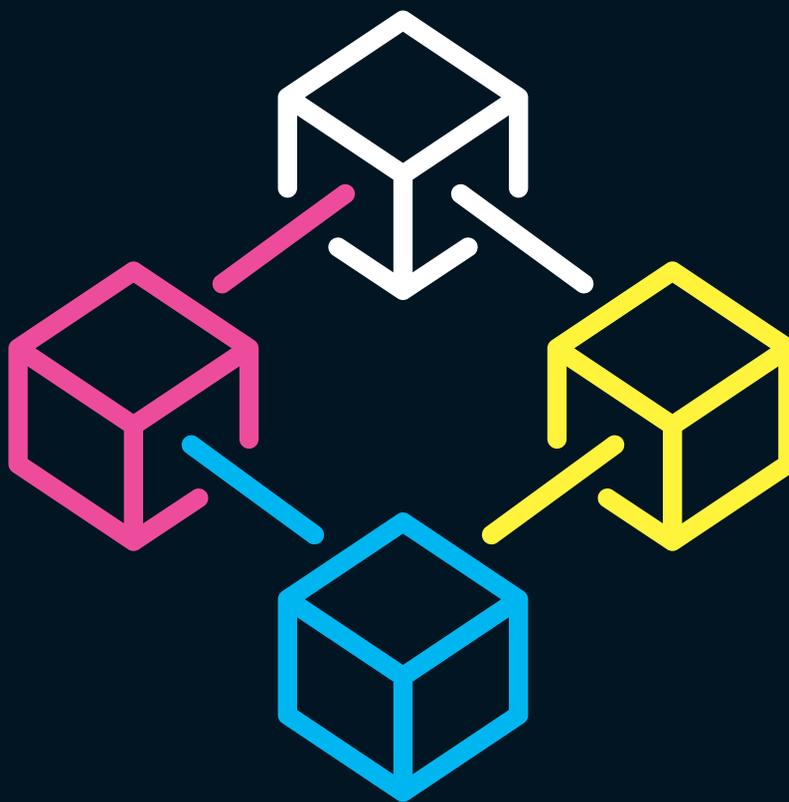
JULY/AUGUST 2018

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BLOCKCHAIN

Is it time for the IP sector to get smart?

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CITMA The Chartered
Institute of Trade
Mark Attorneys

WELCOME & CONTENTS



Tania Clark
CITMA President

“
It's time to recharge your batteries and spend time with loved ones

trust that you are all reading this edition of the *CITMA Review* during your much-deserved summer holidays; it's time to recharge your batteries and spend time with loved ones.

In June, I spoke at the ECTA Annual Conference in Athens about the UK's draft EU withdrawal agreement, and more generally about CITMA's involvement in Brexit. I urge you to check our website on a regular basis so that you can keep your clients and contacts updated.

If, like me, you are wondering about the implications of blockchain and distributed ledger technology – or, indeed, wondering what these terms actually mean – all is revealed on page 8 of this edition.

Elsewhere, on page 47, there is a useful case comment on two-letter marks, and – with a view to addressing the challenges, both in protection and searching, posed by the increase in digital branding – the article on page 23 sets out some practical tips, and gives examples of multimedia marks already on the EUIPO register.

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CITMA REVIEW

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Keven (centre) with EUIPO Deputy Executive Director Christian Archambeau (left) and António Campinos (right)

USER ASSOCIATIONS APPRECIATED

CITMA Chief Executive Keven Bader was pleased to attend the June meeting of the EUIPO Management Board and Budget Committee (MBBC) in the role of invited observer.

The June sessions of the MBBC were particularly poignant as they were the final meetings at which António Campinos, former Executive Director of EUIPO, was present. Campinos took up his new post as President of the European Patent Organisation on 1st July 2018.

Keven reported that he was particularly interested in a video, produced by EUIPO as part of its 2017 annual report, which set out its achievements. Introducing the film, Campinos made clear that users are central to the strategic plan of the Office and that collaboration is key to achieving efficiency.

“This message was reinforced throughout the three days,” said Keven, “and I genuinely got the sense that user associations were regarded highly, and that the work that they have carried out in supporting various EUIPO projects has been greatly valued.”

CITMA is a user association on rotation as an observer for 2018.

ROWAN TAKES UP REGISTERED RIGHTS POSITION

Steve Rowan has been appointed Director of Registered Rights at the UK IPO. In this role, he has overall responsibility for the IPO’s trade mark, patent and designs services, and tribunal and mediation services. He will also be responsible for policy concerning registered rights and unregistered designs.

VELCRO DELIVERS ENTERTAINING IP EDUCATION

Leading brand Velcro has delivered a masterclass in making IP education enjoyable with its Don’t Say Velcro video campaign. The short films explain why the brand would like people to use the phrase “hook and loop” rather than its trade marked brand name, alerting the public to the problem of genericisation. Find out more at velcro.com/about-us/dontsayvelcro

FAKE TAKE

€60bn

is lost each year to counterfeiting in the EU, corresponding to 7.5 per cent of sales in 13 key marketplace sectors.*

*SOURCE: EUIPO, SYNTHESIS REPORT ON IPR INFRINGEMENT (JUNE 2018), BIT.LY/2M1WPD7

“ The UK is the 54th member of the Hague Agreement and the 68th member of the Hague Union

Hague to offer UK Brexit buffer

On 13th June 2018, the UK officially joined the Hague System for the International Registration of Industrial Designs. As *CITMA Review* readers will know, the EU has been a member since 2008, which has given UK businesses access, but the UK's accession allows for the UK to be designated individually.

The news means the UK is the 54th member of the Hague Agreement and the 68th member of the Hague Union.

On its website, the UK IPO said: “The UK's decision to join the Hague System in a national capacity is about flexibility. It is part of a wider designs modernisation programme to streamline the designs legal

framework. Businesses will have a greater choice in how they register their designs internationally.”

CITMA President Tania Clark said: “Protecting industrial designs via the Hague System will improve efficiency and is likely to be a more cost-effective system for businesses... it will also provide UK businesses and Chartered Trade Mark Attorneys direct access to filing EU registered community designs, whatever the outcome of Brexit negotiations.”

The UK's accession to the Hague System was discussed at CITMA's April Designs Seminar. Find out more at bit.ly/Designs2018

CITMA Review recognised

The *CITMA Review* was named “highly commended” in the small membership magazine category at the prestigious MemCom Excellence Awards in May. Think Publishing, which has produced the magazine since 2011, received the award on behalf of CITMA.

The *CITMA Review* was up against a number of leading membership sector publications, including the Chartered Institute of Public Relations' magazine *Influence*. This recognition follows our success at the Association Excellence Awards last year, where we picked up an award for our Royal Charter campaign, and were nominated in the best e-newsletter category.

At the same event, IP Inclusive, the diversity and inclusion initiative that spans the IP professions, received an award in the best equality or diversity campaign category.

IP Inclusive earns CPD

Attending educational events organised by IP Inclusive can now count towards the 16 continuing professional development (CPD) hours that Trade Mark Attorneys are required to complete each year. The announcement follows IPReg updating its guidance on which activities qualify for CPD.

IP Inclusive Leader Andrea Brewster said: “It is a huge step forward for IP Inclusive that our diversity and inclusion training is

seen, in principle at least, as a valid way of developing professional skills and practices.”

IP Inclusive was founded in 2015 by a number of IP organisations, including CITMA. It aims to improve access to the IP professions, regardless of disability, age, gender, sexual orientation, or social, economic and cultural background.

Find out more about IP Inclusive events at ipinclusive.org.uk

MEMBER MOVES



Mark Bearfoot

Tommy Hilfiger has appointed Mark Bearfoot as Legal Director – Brand Protection, a role in which he is leading the global anti-counterfeiting programme.



Claire Freeman & Lewis Jones

Dummett Copp LLP has announced that Claire Freeman became a Partner of the firm from 1st April 2018, while Lewis Jones joined the firm as a Trade Mark Attorney on 1st May 2018.



Triona Desmond & Matthew Harris

Pinsent Masons has appointed Triona Desmond as Senior Trade Mark Attorney and Matthew Harris as Trade Mark Attorney.

Considering a career move?

Visit the CITMA jobs board at citma.org.uk/job_board

SLEEP LESS IN SEATTLE

Chris McLeod sent this missive in the afterglow of his 18th INTA

Seattle, Washington, US, 18th May 2018. And so it begins.

After a mere nine-and-a-bit hours' flight across the Atlantic (and most of the US), I reached the location of this year's International Trademark Association (INTA) Annual Meeting. The sages say that you should look for meaning in signs. Well, on attempting to check in to my hotel, I was told that my reservation had been cancelled. Considering that, at a conservative estimate, there were 12,000 INTA 2018 attendees in town, the sages would have had a field day with that one.

I was already aware that there is another Chris McLeod in the profession, based in Australia. I have been advised not to refer to coincidences, but instead to statistical likelihoods, of which this mix-up was clearly one. The "other" Chris McLeod had cancelled his reservation, but the hotel had also cancelled mine, believing it must be a "dupe" (certainly, I began to feel like one). Nonetheless, they found me a room – which must have been against the odds – so I was able to unpack a week's worth of business casual wear, penny loafers and all.

The INTA Annual Meeting officially started on Saturday 19th; cue large queues to obtain the prized badge and lanyard. Then it was on to meetings

with some old and new contacts. And lunch. It is important not to forget to eat real food at INTA, and to resist the temptation to subsist on canapés. As the conference gathered pace and the city filled up, there was plenty of talk about jet lag, hotels, the royal wedding, Brexit and GDPR. With dry weather forecast, it was warming up nicely in several senses.

The ability to walk around the host city really can make the difference between a stressful and a stress-free INTA event. Any city has a limited number of taxi options – even with Uber, Lyft and the like – so, if you are battling 12,000 others for cabs, the inevitable result is being late for appointments, or missing them altogether. For me, this did not happen in Seattle – although my calendar reminders got me to one meeting 24 hours early and to another eight hours early! (I am still telling myself that it is better to be early than late.)

The conference continued with the usual mix of meetings over coffee, lunch and dinner; receptions; and impromptu encounters, until the grand finale at the stunning Chihuly Garden and Glass museum in the shadow of the retro Space Needle.

This was my 18th INTA Annual Meeting; each one has been bigger than the previous year's, and we should take our hats off to INTA for not resting on its laurels in the knowledge that, for most practitioners, this is the conference they feel they have to attend. Each year sees new initiatives and tweaks to the format, while the essential elements of education and networking remain at its heart.

Next year's Annual Meeting will take place in Boston, meaning a slightly shorter flight and another walkable city, while 2020 will take us to Singapore – plenty of time to prepare for that 13-hour flight and break in a new pair of walking shoes.



Chris McLeod

is a Partner and Chartered Trade Mark Attorney at Elkington and Fife, and Past President of CITMA
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A large, stylized graphic of the letters 'IP' in a serif font, centered within a large, white, curved shape that resembles a stylized 'P' or a large 'D'. The background is a solid light grey.

IP

A selection of our current vacancies:

Senior Associate 5Y+ PQE
Trade Mark Legal Assistant - Up to £55,000
Trade Mark Paralegal - Up to £40,000
Trade Mark Formalities Clerk - Up to £40,000

TIME TO GET SMART?

Don't know the difference between a block, a fork and a node? It may be the moment for the IP profession to get to grips with the use of blockchain technology in its practice

B

Blockchain and other examples of distributed ledger technology (DLT) have risen to their current fame as the technology underpinning cryptocurrencies such as Bitcoin, and the Ethereum platform. As the technology evolves to its third generation, various industries are exploring potential applications for DLT, and new blockchain use cases emerge on a regular basis. So, to what extent should these technologies be on the radar of IP professionals, and how might they be used in relation to trade marks and IP?

In its basic form, blockchain technology is an open ledger of information that can be used to record and track transactions, and which is exchanged and verified on peer-to-peer networks. From an information governance perspective, the real innovation of blockchain technology is that it ensures the integrity of the ledger by crowdsourcing oversight and removes the need for a central authority, ie transactions are verified and validated by the multiple computers that host the blockchain. For this reason, it is seen as “near unhackable”, because, in order to change any of the information, a cyberattack would have to attack all copies of the ledger simultaneously. As blockchain technology becomes mainstream, “private” blockchains – which may only be used by vetted users – are of increasing interest, as are shared ledgers, whereby information on the blockchain is split and shared on a need-to-know basis. Various types of data can be added to a blockchain, ranging from cryptocurrency transaction information and contracts to data files, photos, videos and design documents, and so on.

Owing to the fact that it creates a secure, incorruptible chain of information, blockchain is already finding new applications in brand protection and enforcement, marketing and customer engagement – and has been on the radar of various governmental agencies, including EUIPO and WIPO. ▶



In the context of IP-heavy industries, blockchain and related DLT offer obvious possibilities for IP protection and registration, and as evidence, either at the registry stage or in court. Some argue it might also offer a cost-effective way to speed up such processes. Potential use cases include: evidence of creatorship and provenance authentication; registering and clearing IP rights (IPRs); controlling and tracking the distribution of (un)registered IP; providing evidence of genuine and/or first use in trade and/or commerce; digital rights management (eg online music sites); establishing and enforcing IP agreements, licences or exclusive distribution networks through smart contracts; and transmitting payments in real time to IP owners.

The burden of efficiently gathering and retaining such information in anticipation of future need may, however, affect its usefulness to IP owners. Arguably, much of this information would only be drawn on when an IP right is being enforced. This may have an impact on whether the opportunities offered by blockchain would be fully utilised by IPR owners – perhaps with the exception of industries where there is another driving force for the advanced retention of such information, eg the new serialisation requirements for pharmaceutical products.

SMART IP

One important offer of blockchain technology is that it provides immutable and time-stamped evidence, either at the registry stage or at court. This leads us to the idea that IP offices might use blockchain technology to establish “smart IP registries”, eg in the form of a solution run by an IP office as an accountable authority which would create an immutable, robust and trustworthy record of events in the life of a registered IPR. Alternatively, blockchain could be used to supplement the existing register. In all likelihood, this would be actioned by way of a private blockchain, since IP registries would want to be able to vet the participating nodes.

IPRs registered on a distributed ledger rather than on a traditional database could become “smart” IPRs. As DLT can track the full chronology of the events and life cycle of a right (eg its application, official letters, transactions, licensing, assignments and changes of title), this would allow anyone to audit prior transactions and large trade mark portfolios, which could significantly ease the due-diligence exercises in an IP transaction (such as those required for mergers and acquisitions). This does, however, beg the question of whether a robust e-filing system, such as the one currently offered by EUIPO, in which the life cycle of a right can already be tracked reliably by accessing an online file, provides an inferior offering in practice.

While it is perhaps a somewhat aspirational target for countries where there are currently no administrative use requirements, registered trade marks, designs and other registered rights could, in theory, also be cleared for registration and use if actual use information were added to the registration details of a trade mark on the official register. For example, this could be achieved by linking the use of a product on the market back to a blockchain solution. This has been predicted by some enthusiastic observers, yet it seems unlikely that DLT could eventually lead to a single global registry for IPRs, since IPRs are territorial rights.

EVIDENCE OF USE

It remains true, however, that collecting information on the use of a trade mark in trade on a DLT ledger would allow the relevant IP

blockchain technology. While there are national variations, the main difference between collective marks and certification marks is that the former may be used only by a specific group of enterprises, such as members of an association, whereas the latter may be used by anyone who complies with the standards defined by the owner of the certification mark (eg that products meet certain established criteria or standards). As it is an important requirement for certification marks that the entity owning the mark must be “competent to certify”, these might be best suited to private blockchains. Fake certificates could be identified almost immediately, which would benefit both trade mark owners and consumers.

RIGHTS MANAGEMENT

Another blockchain buzzword is the concept of “smart contracts”. As some DLT solutions can

“ *IP offices could establish ‘smart IP registries’, which would create an immutable, robust and trustworthy record of events in the life of a registered IP right* ”

office to be notified virtually immediately on the occurrence of a verified event of this use. Reliable evidence of actual use of a trade mark in trade, as well as the frequency of this use, could be available on the official trade mark register. If this were to be accepted legally, DLT could simplify the process of providing evidence of use of a trade mark and other evidence at an IP office or court – eg in cases of proving first use, genuine use, acquired distinctiveness or goodwill in a trade mark.

In contrast to traditional IP registers, a smart trade mark register could also reflect the state of the market, which is relevant when it comes to assessing the infringement risk in many jurisdictions. However, it is important to recall that much of this data is likely to be considered highly confidential by trade mark owners, so sharing of information would potentially have to be optional. The logistics of setting up such a system could put a significant up-front burden on trade mark owners, reducing the likely uptake if this were introduced as a voluntary system. This does have to be balanced against the benefit of having such information available without delay – saving time, resources and money when a trade mark owner needs to draw on it.

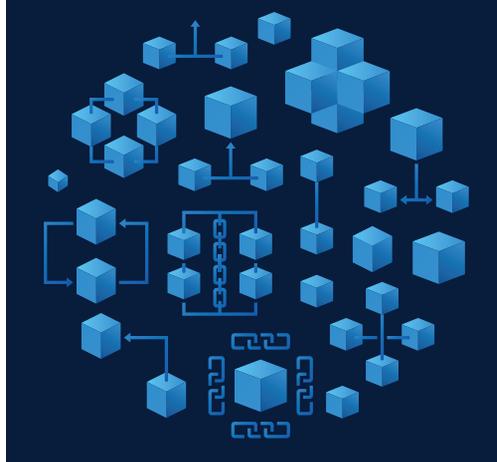
CERTIFICATION

Certification and collective trade marks are another field for the potential application of

hold, execute and monitor contractual codes, such “smart contract performance” could be of interest to digital rights management and other IP transactions. Smart contracts could be used to establish and enforce IP agreements, such as licences, and allow the transmission of payments in real time to IP owners. Meanwhile, “smart information” about intellectual rights of protected content (eg a song) could be encoded in digital form (eg in a music file).

Adding scannable blockchain-connected tags or other markings to products that include legal and other information could also enhance the effectiveness of customs enforcement in the fight against counterfeits, and help when it comes to validating a genuine product. If a brand owner is able to tell customs authorities that its genuine products are embedded with a tag or marking, then the absence of this tag, or a tag bearing incorrect data, provides an easy way for customs officers to check whether a product is counterfeit. It would also allow brand owners to educate consumers about the dangers of fake goods.

The idea of using interactive tags, such as QR codes, is not new. However, unlike blockchain, these established technologies link to one single source of information – rather than a distributed ledger – and, although they may make life more difficult for counterfeiters, they are still prone to corruption and copying. Blockchain



technology does not suffer from this drawback, since counterfeiters should be unable to alter the information on the blockchain.

The ability to add blocks of data to the chain also creates opportunities for IP owners to record details about a product's progress through stages in the manufacturing and supply chain; allows them to distinguish grey goods in cases of parallel imports; and helps to identify where certain goods left the supply chain. Similarly, DLT can be used to monitor and control leaks from selective distribution networks and so assist in enforcing these agreements, bearing in mind, of course, competition law aspects.

Such tracing and tracking of goods is also required by legislation that has been introduced to address counterfeits in the pharmaceutical industry. The EU Falsified Medicines Directive (FMD) will introduce an EU-wide system that aims to secure the supply chain between pharmaceutical manufacturers and patients

ownership, and to license and track use and potential infringements of their works on the internet. This application can also act as a deterrent to potential infringers, since all use can be traced.

INDUSTRY APPROPRIATE

The large-scale adoption of blockchain technology still faces a number of obstacles, both technical (eg scalability and energy consumption) and legal (eg questions of privacy, data protection, governing laws and jurisdictions). Blockchain developers will also have to create a regime of standards and interoperability protocols.

“ *Blockchain technology could play an important role in the context of unregistered IPR, such as copyright* ”

against counterfeits. Blockchain lends itself to achieving the FMD's legislative aim of tracking of goods in fragmented supply chains. Indeed, such technology already exists – for example, London-based Qadre's blockchain solution, which is currently being tested by several large pharmaceutical companies.

Blockchain technology could also play an important role in the context of unregistered IPRs, such as copyright (which in many jurisdictions is not a registrable IPR) and unregistered design rights, since it can provide evidence of their conception, use, status and qualification requirements. Because unregistered rights are notoriously difficult to prove, blockchain could help to bridge the gap. This is not just hypothetical: online pioneer platforms, such as Binded, Bernstein and ascribe, use DLT and digital certificates to allow creators to make a record of their copyright

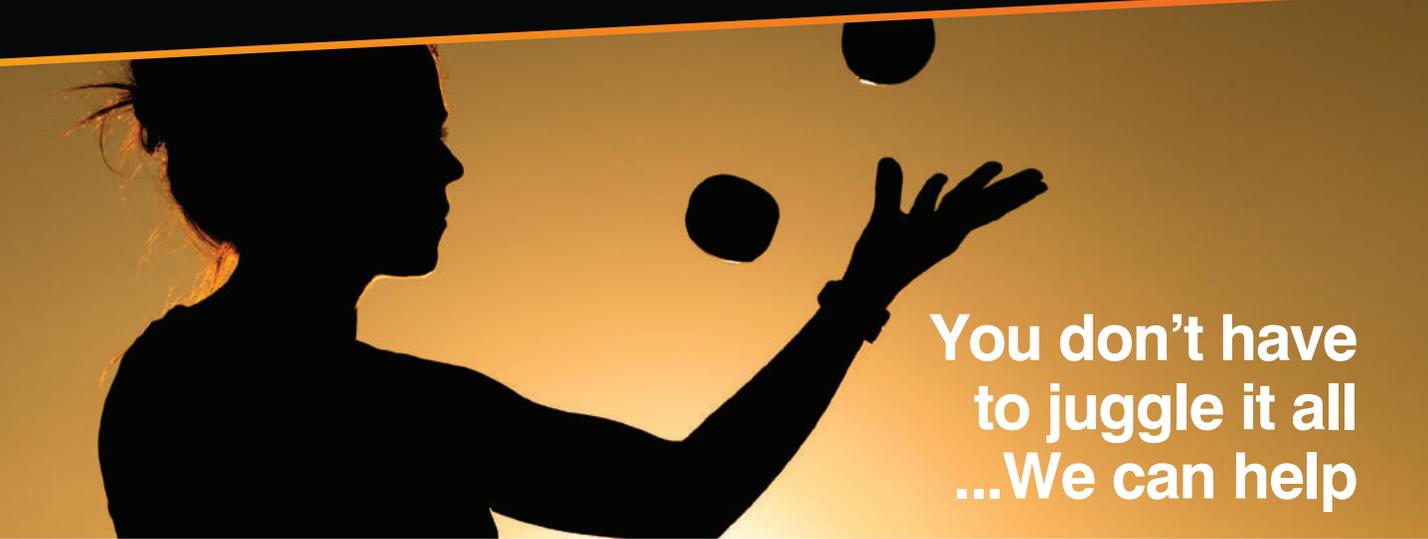
So, is blockchain use in IP more than just hype? Should Trade Mark Attorneys be reading up on the difference between a block, a fork and a node? While many of these blockchain ideas may be feasible or sufficiently attractive for implementation in practice, blockchain is now widely expected to have a transformative effect on IP-heavy industries, especially those faced with counterfeit goods and parallel imports.

It is the authors' view that the speed of that transformation is likely to be at least partially dependent on the development of corresponding technology, and changes to the regulatory and IP enforcement landscapes. Nevertheless, in the mid and long term, and when the initial buzz has calmed, IP law and practice appear to make for a feasible use case of DLT – which, one might argue, is only right for an area of law founded on the principles of embracing and protecting innovation. ●



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to juggle it all
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LKA57597

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Trade Mark Attorney : Manchester

VAC50594

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Trade Mark Attorney : Birmingham

VAC51785

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DATABASE RIGHT: MIND THE GAP

Following his Leeds Lecture in May, Patrick Cantrill points out a potential future problem for owners of valuable data pools

As became clear during the recent push to prepare for GDPR, data now impacts on every aspect of our technical, social, business and personal lives – and this data is extremely valuable. For example, Uber’s estimated value of \$70bn is derived from its ownership of the largest pool of data about personal transportation – rather than from the profits made through the labour of its pool of drivers. It is therefore important to consider what property rights vest in the databases that hold our data and the extent to which owners can exploit these assets.

Demonstrating some prescience, the EU addressed these issues well over 20 years ago, when it created a wholly new IP right (database right), introduced via Directive 96/9/EC and implemented into UK law in 1997.

Database right vests in a qualifying person who can demonstrate they have made a substantial investment into obtaining, presenting or verifying the compilation of data, even if such aggregated data is publicly available. The right runs alongside copyright, which protects original databases, with the creator being treated as the first owner. The Directive covers both electronic and non-electronic databases, and the High Court recently held that a PDF of an electrocardiogram reporting system constituted a database.¹

THE RIGHT IN DETAIL

Database right lasts for 15 years from the end of the calendar year in which the database was created. However, if there is a substantial change in the contents of the

database, it may qualify for a new term of protection. To qualify for the right, the “maker” must be a national of, or habitually resident in, a European Economic Area state or a body incorporated in such a state.

Database right owners can prohibit:

- unauthorised extraction and/or reutilisation of a substantial part of a database’s contents; and
- repeated and systematic extraction or reutilisation of insubstantial amounts of the contents.

There are statutory defences, which provide that “lawful” users can make a copy of a database and that they cannot be restrained from extracting and/or reutilising

insubstantial parts of one. Nevertheless, as held in *Ryanair v PR Aviation*,² to the extent that database right is found not to subsist, such contractual restrictions are permissible.

One question that CITMA and CIPA members have raised is whether the UK IPO might use database right to clamp down on misleading and bogus invoices being sent to UK trade mark owners whose details have been sourced from the IPO’s database. This possible remedy – and, in particular, the extent to which these unscrupulous third parties would be regarded as lawful users – is perhaps worthy of further consideration.

BEYOND BREXIT

Post-Brexit, it seems likely that protection across the EU for UK owners of databases will cease following the transitional period, but the European Union (Withdrawal) Bill 2017-19 as currently drafted provides that the UK will continue to recognise database right for those databases made by EU and UK nationals or residents. Accordingly, this situation creates a “reciprocity gap”, as the EU will cease to recognise database right of UK nationals or residents in return.

“

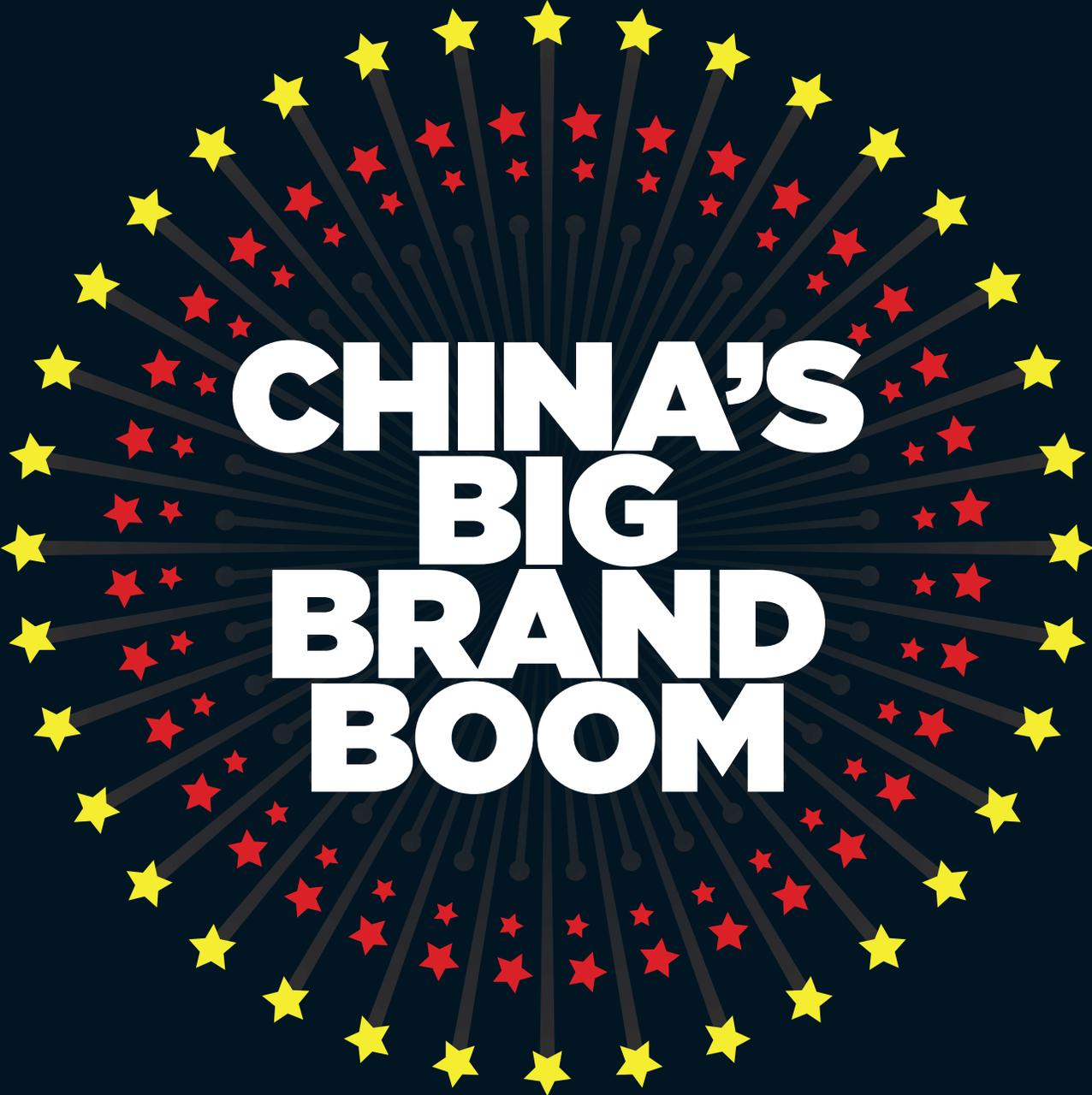
*Post-Brexit,
it seems likely
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for UK owners
of databases
will cease*



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1 *Technomed Ltd & Anor v Bluecrest Health Screening Ltd & Anor* [2017] EWHC 2142 (Ch)
2 C-30/14



CHINA'S BIG BRAND BOOM

The world's single largest consumer market
is spreading its wings, explains
Robert Reading



2017, China's economy grew at a rate of nearly seven per cent, exceeding forecasts. It was also the first year since 2011 in which the country demonstrated accelerated growth, a positive step forward for the world's second largest economy. But while conventional commentators may focus on GDP, another indicator of a sound economy is strong trade mark filing activity. And in the case of China, in the past two years alone, the number of trade mark applications from China to foreign registers has doubled.

This is one of the findings in *Chinese Brands Go Global*, a report compiled by CompuMark's Custom and Managed Solutions team, which analysed 62.6 million active trade marks across 186 trade mark registers in over 200 countries. It assessed domestic and foreign trade mark applications by Chinese brands, made between 2014 and 2017.

DOMESTIC PICTURE

To put the figures into perspective, it helps to set the scene. China's domestic trade mark register is the largest in the world. In 2017, the register saw more than 5.2 million applications filed, making it approximately 10 times the size of

the world's second-largest register, that of the US. In the first week of September 2017 alone, more than 116,000 applications were filed on the Chinese register — which is more than the total number of trade marks filed with EUIPO in 2016.

For more than 20 years, the Chinese trade mark register has seen more trade mark applications filed annually than any other register in the world. With more than 1.4 billion consumers, the Chinese market is seen as a key target for international brands, and although mainland China has just under 19 per cent of the world's population, the Chinese trade mark register has handled 50 per cent of all trade mark applications filed globally in recent years. And the proportion of global trade mark applications filed in mainland China is still growing.

SPREADING THEIR WINGS

When it comes to Chinese brands venturing out into international markets, our research shows that these businesses are now appearing

on foreign trade mark registers in increasingly large numbers.

In four years, Chinese brands have gone from number 10 in the world by filing volume to number two, and will likely challenge US brands for number one in the world during 2018. Chinese applicants filed nearly 120,000 foreign applications in 2017. Again, putting those figures into perspective, if this were a separate register, it would rank between Mexico (138,400) and EUIPO (118,762) and be the eighth-largest register in the world. Chinese applicants filed one in every nine US applications in 2017 — more than 50,000 applications in a single year.

GROWTH SPURT

Just four years ago, the Chinese trade mark sector looked quite different. Foreign trade mark applications filed by Chinese applicants outside mainland China were relatively modest. Growth in filing volume was steady but not

In 2017, more than
5.2m
applications were filed on China's domestic register





spectacular (14 per cent in 2013 compared with 2012), and mainland China ranked 10th in the world, with the US, Germany, the UK, Italy and France making up the top five for filing foreign applications.

Fast-forward to 2018: Chinese applicants are now filing in significant numbers around the world, with the number of foreign applications almost doubling in the last two years.

Where, in the past, Chinese applicants focused on filing foreign trade mark applications in regions close to mainland China – including in south-east Asia – since 2014, the US has become the major market for Chinese brands, with US trade mark applications growing from just over 6,200 in 2014 to over 50,000 in 2017.



But it is not just the US market that has experienced this growth in Chinese brand interest. Compared with 2016, filing volume from China in 2017 increased by more than 40 per cent on a number of major registers. The registers of the US (+61 per cent), Europe (EUIPO, +55 per cent), Japan (+73 per cent), the UK (+122 per cent), Australia (+139

China's register is

10x

the size of the US's

per cent) and Canada (+49 per cent) all saw significant growth.

THE LARGER LANDSCAPE

While foreign trade mark applications by Chinese brands are higher than they have ever been, what does the rest of the landscape look like? The US continues to rank highest when it comes to filing foreign trade mark applications outside its domestic market. As mentioned previously, applicants from mainland China are in second place, with applicants from Hong Kong taking third spot. If foreign trade mark applications from mainland China continue to grow at their current rate, the country will be on course to overtake the US as the world's leading source

of foreign trade mark applications by 2020.

By examining the most frequently used classes selected by Chinese brands when filing foreign trade mark applications, it is possible to build a picture of the most important types of products being exported from mainland China. In 2017, class 9, which includes electronics and electrical equipment, was the most frequently used class. In 2017, Chinese applicants filed nearly 30,000 foreign trade mark applications in class 9. The second most frequently used class was class 25, which covers clothing, footwear and headgear. And third on the list was class 11, which relates to lighting, heating, cooking and refrigeration apparatus.

LAND OF OPPORTUNITY

China has been an important destination for global brand owners in recent years, especially as it is the world's single largest market and home to 1.3 billion consumers with purchasing power that is growing substantially. As Chinese brands look to foreign shores, they will need to develop a strategy to overcome the challenges posed by different trade mark registers around the world, and consider how to protect and enforce their brand once it is registered.

Ultimately, if the past four years are anything to go by, trade mark registers in the US and Europe are likely to see Chinese applicants playing a dominant role, and the trade mark landscape in the West is set to take on a very different shape. China's emerging brands will continue to require expert advice from the IP profession in order to navigate its new contours. ●



DOWNLOAD THE FULL REPORT AT
COMPUMARK.COM/CHINA-REPORT



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UNDER THE INFLUENCE

Jason Stephens explores the dangers that can arise in aligning a brand with today's online superstars



Zoe Sugg, aka Zoella, boasts an Instagram following of 11 million

“ More than two-thirds of marketers intend to increase their influencer marketing budget over the next year

success. The fall from grace of some online celebrities has been spectacular, while regulators around the world are asking whether social media stars are being sufficiently transparent about the nature of their content. Are they only wearing that dress or enjoying that holiday because they have been paid to do so? And if so, have they made that clear?

THE RISE OF THE INFLUENCER

Despite any reservations marketers may have had, last year was widely hailed as the year of influencer marketing, and the trend shows no sign of slowing in 2018. Influencers – individuals with a loyal following on social media – continue to team up with brands keen to engage with (and sell to) their audience.

Of course, it's inevitable that stars such as Zoella, with her 11 million Instagram followers, or PewDiePie, a gamer and online celebrity who has a staggering 63 million YouTube subscribers, will attract attention from brands. But influencer marketing has become increasingly varied as some brands shift their focus to “micro-influencers” – individuals posting on everything from fashion or parenting to bike maintenance – whose fan bases may be smaller, but are often very highly engaged.

Influencers can lend credibility and enable brands to contact demographic groups that are notoriously hard to reach through traditional marketing. Meanwhile, the loyalty and enthusiasm of the audience means that influencer posts can trigger much higher levels of engagement than brands' own social media updates. One survey suggests that consumers under 30 are five times more likely to purchase a product online that has been reviewed by an influencer than one marketed by a “traditional” celebrity. Influencer posts on Instagram are said to have doubled in 2017, while it is reported that more than two-thirds of marketers intend to increase their influencer marketing budget over the next year.

WARNING WORDS

But while influencers have become a hugely important part of the marketing mix, there are also some less positive stories to serve as a warning to would-be partners.

YouTube star Logan Paul attracted controversy and condemnation when, on 31st December 2017, he uploaded a video to his YouTube channel showing the body of a man who had hanged himself at the base of Mount Fuji in Japan. YouTube temporarily suspended advertising revenue on his account, and the brands he worked with, such as Disney, Pepsi and HBO, were left to reconsider their relationship with Paul, as they looked to preserve their brand image and reputation.

The incredibly popular PewDiePie made worldwide headlines in 2017 after being accused of making anti-Semitic remarks in a number of videos. Following the controversy, he was dropped from a number of campaigns and partnerships.

These stories illustrate the danger of hitching a brand to an individual who has perhaps generated a following through being provocative or irreverent, but may push things too far or suddenly appear to have unpleasant underlying attitudes or views. Brands that rush in on the basis of numbers of followers or subscribers alone, and fail to do their due diligence or put an appropriate contract in place – as they would do when agreeing a traditional celebrity endorsement relationship – may live to regret their haste. And while any celebrity can make a gaffe, those who have risen through traditional media outlets may have had a much longer time to develop (or be trained in) the diplomatic skills that could avoid or limit reputational damage.

REGULATORY ATTENTION

Influencer marketing has also attracted the attention of regulators across the globe. While influencers are typically dependent on income from endorsements and

The stars of YouTube and Instagram – who curate their every thought and their lifestyles for the benefit of legions of followers – have changed the face of modern marketing. Whether it's global personalities like the Kardashians, or the health, fitness and “mummy” bloggers who appeal to a particular niche, this new breed of celebrity has something every marketer is looking for – a dedicated and engaged audience hanging on their every post. But brands should take note: not every social media tie-up will be a



Controversy surrounding YouTube star Logan Paul put the reputation of partner brands at risk

advertising, many are reluctant to appear too “commercial” for fear of appearing inauthentic and damaging their relationship with their audience. That has sometimes led to a lack of transparency, where a connection between an influencer and a brand is unclear and users may be deceived into believing that an endorsement represents the genuine, independent opinion or choice of the influencer (as opposed to a disguised advertising message).

In the UK, the Advertising Standards Authority (ASA) and the Competition and Markets Authority (CMA) have both been active in seeking to ensure that influencer content that has been paid for by a brand (and which may also be “controlled” by the brand) is appropriately signposted – for instance by labelling posts with #ad – to distinguish it from editorial content.

In the US, the Federal Trade Commission has been working hard to ensure that influencers clearly and conspicuously disclose their endorsement relationships in their content. It published an updated

“
Users may be deceived into believing that an endorsement represents the genuine, independent opinion or choice of the influencer

MAKING HER MARK

With books, beauty products and fragrances, influencer Zoella has made it her business to create her own brand. We take a look at her tally of registered US, UK and EU marks so far.

US PATENT AND TRADEMARK OFFICE

ZOELLA

ZOELLA (5102789)
Date of registration: 20th December 2016.
Notes: Registered in relation to a wide range of goods and services, including cosmetics, retail services and beauty services.
Classes: IC 003, 021, 035, 041, 044; US 001, 002, 004, 006, 013, 023, 029, 030, 033, 040, 050, 051, 052, 100, 101, 102, 107.

Zoe Sugg

ZOE SUGG (5034230)
Date of registration: 6th September 2016.
Notes: The name(s), portrait(s), and/or signature(s) shown in the mark identify “Zoe Sugg”, whose consent(s) to register is made of record.
Classes: IC 003, 021, 035, 041, 044; US 001, 002, 004, 006, 013, 023, 029, 030, 033, 040, 050, 051, 052, 100, 101, 102, 107.

UK IPO

ZALFIE (UK00003147490)
Date of registration: 29th April 2016.
Classes: 9, 16, 18, 25, 28, 35, 38, 41, 45.

SUGG LIFE (UK00003046930)
Date of registration: 27th June 2014.
Classes: 16, 18, 25.

ZOELLA (UK00003014472)
Date of registration: 29th November 2013.
Classes: 3, 8, 9, 14, 16, 18, 20, 21, 25, 35, 38, 41, 45.

CORDIALLY INVITED (UK00003268228)
Date of registration: 23rd February 2018.
Classes: 9, 16, 21, 25, 41.

EUIPO

ZOELLA BEAUTY

ZOELLA BEAUTY (015808967)
Registration date: 31st January 2017.
Classes 16, 18, 20, 21, 24, 25, 3.

ZOE SUGG

ZOE SUGG (013292719)
Registration date: 27th February 2015.
Classes: 21, 3, 35, 41, 44.

ZOELLA (013411954)
Registration date: 28th March 2015.
Classes 21, 3, 35, 41, 44.

version of its *Endorsement Guides* in 2017, has written warning letters to many well-known influencers and has taken enforcement action against brands and influencers alike.

Elsewhere, the International Consumer Protection and Enforcement Network, an informal network of consumer protection enforcement authorities in over 60 territories, has treated misleading online endorsements as a priority, publishing guidelines to help digital influencers operate fairly and improving regulatory practices in this area, leading to enforcement cases around the world.

INFLUENCER MARKETING - UK RULES

The rules governing influencer marketing on social media are the same as those applying to other media. It is not new to suggest that advertising should be identifiable and should not mislead.

For example, in the UK, the Consumer Protection from Unfair Trading Regulations 2008 (which implement Directive 2005/29/EC on unfair commercial practices) provide that: "Using editorial content in the media to promote a product where a trader has paid for the promotion without making that clear in the content or by images or sounds clearly identifiable by the consumer" is a practice which is always to be regarded as unfair. The regulations are enforced by the CMA and by local authority Trading Standards.

The UK Code of Advertising, Sales Promotion and Direct Marketing (CAP Code), which is a key part of the UK's self-regulatory system of advertising standards, provides that marketing communications must be "obviously identifiable". The CAP Code is enforced by the ASA.

Issues arise for various reasons. Marketing teams and agencies can take a different view to the regulators on what consumers need to understand as to whether influencer content is paid for; there may be resistance from influencers to #ad or similar labelling; and large numbers of influencers producing large volumes of content present practical challenges for clearance programmes and monitoring.

“ Marketing teams and agencies can take a different view to the regulators on what consumers need to understand as to whether influencer content is paid for

ENFORCEMENT ACTION

The CMA has taken enforcement action against a number of high-profile agencies engaging influencers on behalf of brands, while the ASA has upheld various complaints against influencer marketing campaigns where the content is not obviously identifiable as advertising.

In a 2017 ASA ruling against Nomad Choice Pty Ltd t/a Flat Tummy Tea, the ASA held that an Instagram post by the make-up blogger and influencer Sheikhbeauty had breached the CAP Code, as it was not obviously identifiable as a marketing communication.

The ASA applied its usual test for determining whether an influencer post is an ad, namely whether the brand paid the influencer or entered into a form of reciprocal arrangement with them, and whether the brand had "control" over the content. The ASA interprets "control" widely – while it appears that Flat Tummy Tea did not write or have a veto over the content of Sheikhbeauty's posts, the ASA noted that its agreement with her "required that the content should

be based on key messages" – eg concerning Flat Tummy Tea's 20 per cent discount offer during Black Friday. Flat Tummy Tea had also required that posts be uploaded at certain dates and times. The ASA deemed this to be sufficient to give the brand "control" – the content was therefore advertising and, since it was not labelled with #ad or similar, was in breach of the CAP Code.

Unleashed PR Ltd t/a I Spy Eyes (Unleashed) fell foul of the same rules when, in 2017, Marnie Simpson from reality TV show *Geordie Shore* failed to identify a Snapchat snap as advertising. Unleashed is a celebrity management agency which managed Marnie Simpson. It also sold a range of coloured contact lenses branded "by Marnie Simpson", which were included in a snap from her account, alongside text that stated "[heart emoji] mrs grey coming soon". In its first ruling on Snapchat marketing, the ASA concluded that the snap was a marketing communication and not identifiable as such.

In a separate snap, Simpson posted an image of herself holding a ▶

TOP SOCIAL BRANDS 2018

Brands most pictured on Twitter and Instagram, compiled by Brandwatch

SOURCE: THE 2018 BRAND VISIBILITY REPORT, BRANDWATCH, BIT.LY/2HOTRPG

RANK	BRAND	AVERAGE UNIQUE IMAGES PER MONTH
1	Adidas	6,664,170
2	Nike	5,134,017
3	Google	3,888,432
4	Emirates	2,841,215
5	Puma	2,719,715
6	Coca-Cola	2,534,527
7	Starbucks	2,294,695
8	McDonald's	2,015,792
9	Disney	2,000,062
10	Apple	1,964,235

“Regulators around the world have shown a willingness to tackle the more problematic side of influencer marketing”

Diamond Whites product close to her face. Text on the snap stated “50% off everything from Diamond Whites! Swipe up [Heart emoji]” and “www.diamondwhites.co.uk”. The ASA again concluded that the snap was a marketing communication and that it “was not clear from the snap that Marnie Simpson had a commercial relationship with Diamond Whites”. This was despite the snap being noticeably different from Simpson’s usual posts. The snap therefore breached the CAP Code.

Where a brand pays an influencer to produce content (including by simply providing something of value, such as clothing, tickets or the loan of a vehicle) and has control over that content (according to the ASA’s broad take on what amounts to control), the content must be adequately labelled. In practice, this will often mean using #ad or similar wording and ensuring that it is clearly visible to the user (without the need to, for example, “click to expand”) before they engage with the content. Note that #spon or similar wording is unlikely to be sufficient and that it is at least questionable whether the labelling provided by platforms such as Instagram meets the standards required by the ASA. Even where influencer content is not “controlled” by the brand (and is not advertising within the ASA’s remit), the influencer will still need to make it clear in their post if they have received payment, free products, tickets, etc in order to mitigate the risk of breaching the Consumer Protection from Unfair Trading Regulations 2008. Brands are therefore advised to seek advice on the rules and to formulate an appropriate policy before engaging with influencers to ensure that they label content in the right way.

On 15th March 2018, the ASA launched a project to investigate consumers’ ability to recognise online ads. Guy Parker, Chief Executive at the ASA, stated that

a driver for this project is that “people shouldn’t have to play detective to work out if they’re being advertised to”.

CONTENT OF POSTS

Of course, if an influencer post is an ad according to the ASA’s definition, then the brand will also be responsible for ensuring that the post complies with all the other rules on the content of advertising. So, if the influencer includes a misleading message, one which could cause serious or widespread offence, or one which, for example, promotes an alcohol product in conjunction with an image of a person aged under 25, or a car with an image showing irresponsible driving, then the brand may find itself on the receiving end of regulatory action or complaints. For example, in a second ruling on influencer content relating to Flat Tummy Tea, the ASA found that the post breached rules on nutrition and health claims in food and beverage advertising.

There will be few large businesses that aren’t either using influencers widely in their marketing or considering it in some way. And although the approach may differ depending on the jurisdiction, regulators around the world have shown a willingness to tackle the more problematic side of influencer marketing with enforcement. Getting it right is about more than just legal compliance – no reputable brand wants to gain a reputation for deceiving people through surreptitious advertising. So whether you represent brands, agencies or influencers, now is the time to focus on influencer marketing policy, template agreements, “dos and don’ts” for influencer posts, etc. Getting your house in order at this stage could avoid costly issues down the line. ●



Marnie Simpson's Snapchat snaps fell foul of the CAP Code



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TIMS MOVE WITH THE TIMES

Tom Hooper reviews the fast-evolving world of marks in motion

As *CITMA Review* readers will be aware, on 1st October 2017, a number of changes to EU trade mark (EUTM) laws came into effect, including the removal of the graphical representation requirement. The aim of this change was to make entries in the EUTM register clearer, more accessible and easier to search for.

The change has also opened the door to new types of marks, which can now be filed provided they use a generally available technology and the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

Brand owners can now better protect sound, motion and multimedia marks. Videos and sound files can now be submitted in commonly recognised formats and protected as EUTMs. (Indeed, if technology for reproducing scent becomes generally available in the future, it may be possible to protect those as EUTMs, although we are likely decades away from that.)

A reasonable amount of multimedia and motion EUTMs have already been submitted (33 applications and registrations at the time of writing). The new types of marks appear to be particularly attractive to TV producers (to protect an introduction or TV format), gaming companies (to protect the gameplay) and other creative industries that use digital branding, such as moving images, logos or distinctive promotional videos. ▶

However, it's early days for these registrations, and they introduce some challenges for brands and those who advise them.

WHAT ARE MOTION MARKS?

Motion marks are defined by the EUIPO guidelines as trade marks that consist of, or extend to, a movement or a change in the position of the elements of the mark. The phrase "extending to" contained in the definition means that the mark will include movement itself, but can also include words, logos or labels. There are, of course, technical requirements, and these will need to be considered before filing. A motion mark must be:

- represented either by submitting a video or a sequence of still sequential images showing movement/change of position;
- a video must be in MP4 format and cannot exceed 8,000KB per second and 20MB in size.

To date, only one motion mark has been filed as a group of sequential images, with all other brand owners opting for the video format. The

a sequence of images offline). Audiovisual files must also be in MP4 format and cannot exceed 8,000KB per second and 20MB in size.

From an enforcement perspective, one concern is that filing multimedia marks with sound may arguably reduce the strength of those rights – it adds another layer when attempting to argue confusing similarity. It is unlikely that the sound in a multimedia mark will go unnoticed by the average consumer in the majority of cases, at least where the sound is not generic of the images displayed. It could be argued, then, that if there is a low level of similarity between the videos in a dispute, an overall difference in sound could take the mark far enough away. Accordingly, if the sound in a multimedia mark is independently distinctive, it is worth protecting the sound separately by filing for a motion mark with no sound. There are some analogies to be drawn here to the US supplemental register. A non-distinctive sound could sit in a multimedia EUTM while it is acquiring distinctiveness through

“ One concern is that filing multimedia marks with sound may arguably reduce the strength of those rights

benefit of sequential images is that they will actually appear on the registration certificate in that format, rather than being provided in a link to the video – something to bear in mind if the client is likely to enforce its EUTM and wants certainty.

MULTIMEDIA MARKS

Trade marks combining movement with sound do not qualify as motion marks, but will be multimedia marks. The inclusion of sound is the clear dividing line between the two. In addition to the image and sound, a multimedia mark can also contain words, logos, figurative elements or labels. The marks can only be represented by submitting an audiovisual file at the time of filing. That means these marks can only be filed online with the office (unlike motion marks, which can be filed as

use, with the brand owner looking to protect the sound independently after many years of use and consumer recognition.

EXAMPLE MARKS

On the right is an overview of some of the relevant marks that have been filed so far. Of course, as these are moving images, we have had to make do with screenshots of the marks and a brief description.

As these examples illustrate, the motion and multimedia marks being filed cover anything from moving logos, promotional videos, characters, moving hands and screen displays to computer/mobile gameplay. They are also being filed by IP firms, who presumably hope to be able to say that they were one of the first to take advantage of this new strand of protection.

MULTIMEDIA MARKS: RECENT EXAMPLES



	APPLICATION DATE/DESCRIPTION	STATUS
	02/03/2018 A multimedia mark with the sound of a heart beating in the background. Covers: food and confectionery.	Accepted and published
	20/12/2017 A multimedia mark that introduces the logo, with sound presented over the top. Covers: various teaching apparatus, equipment and materials, as well as education, procurement and business services.	Registered
	10/11/2017 A multimedia mark in which the character waves and takes a bow, followed by presentation of the company logo. Sound plays over the top. Covers: flag poles of metal; flags of paper and various textile and bunting materials.	Registered
	01/10/2017 A multimedia mark with the sound of a heart beating in the background, followed by this final image. Covers: IP services.	Registered
	01/10/2017 A mark comprising the image circling around. Covers: various services in classes 35, 38, 42 and 45. Opposed by Doro AB based on prior rights to a similar device mark.	Opposed
	02/10/2017 Relates to a number of EUTM applications filed by Bang & Olufsen A/S, covering speakers, headphones and related goods in class 9. All applications are for moving hands.	Pending
	16/10/2017 Application relates to images from gameplay in a computer/mobile phone app. Covers: computer software; entertainment; and gambling services.	Pending
	02/05/2018 Application filed by Vodafone Group plc. Covers: various goods and services in classes 9, 35, 38, 41.	Pending (likely to be accepted)
	18/05/2018 Motion mark for a hand displaying the letter L. Covers: various services in classes 35, 36, 44 and 45.	Pending
	01/10/2017 Pending motion EUTM for shooting gameplay featuring a headshot. Covers: various goods and services related to those activities in classes 9, 28 and 41.	Pending

NOTE: DETAILS CORRECT AS AT 1ST JUNE 2018

However, while it is clear that many brand owners are attempting to protect their non-traditional brands, the rate (or speed) of acceptances is not particularly high at present. It also appears that certain brand owners have sought to protect arguably non-distinctive moving marks, attempting to take advantage of the recent removal of graphical requirements and the potential for uncertainty in terms of these marks at EUIPO.

We anticipate that a number of the pending applications illustrated will be refused registration on non-distinctive grounds, but if the owners have been using those videos and displays for a number of years, they could potentially argue acquired distinctiveness. Even if these marks are able to proceed to registration, they may be difficult rights to enforce against third parties and, at best, may be supplementary to traditional word and logo protection.

Of particular interest are applications for representations of moving hands, which would, if registered, provide a very broad scope of protection and hinder competition in the relevant industries. For example, if these marks are successfully registered and enforced, they could prevent competitors from building in the facility to use hand motions to open a speaker or change the volume. Many of these marks contain non-distinctive sounds and elements that, if removed, may have provided a slightly broader scope of protection. The fact that brand owners are attempting to push the boundaries of protection is really exciting, but the good news is that EUIPO is clearly still examining these marks in full and taking its time in the process. We hope that the UK IPO is paying close attention to these concerns, and will address them when the EUTM directive making these changes is implemented here in the future.

REMAINING CONCERNS

What is clear already, however, is that non-traditional marks continue to be difficult to protect. The same criteria apply to their assessment as for traditional trade marks (words ►



WORLD IN MOTION: PRACTICE POINTERS

and logos), so the brand still must be distinctive and not generic or descriptive. The added hurdle for non-traditional marks is that the brand must be represented in a sufficiently clear and precise manner.

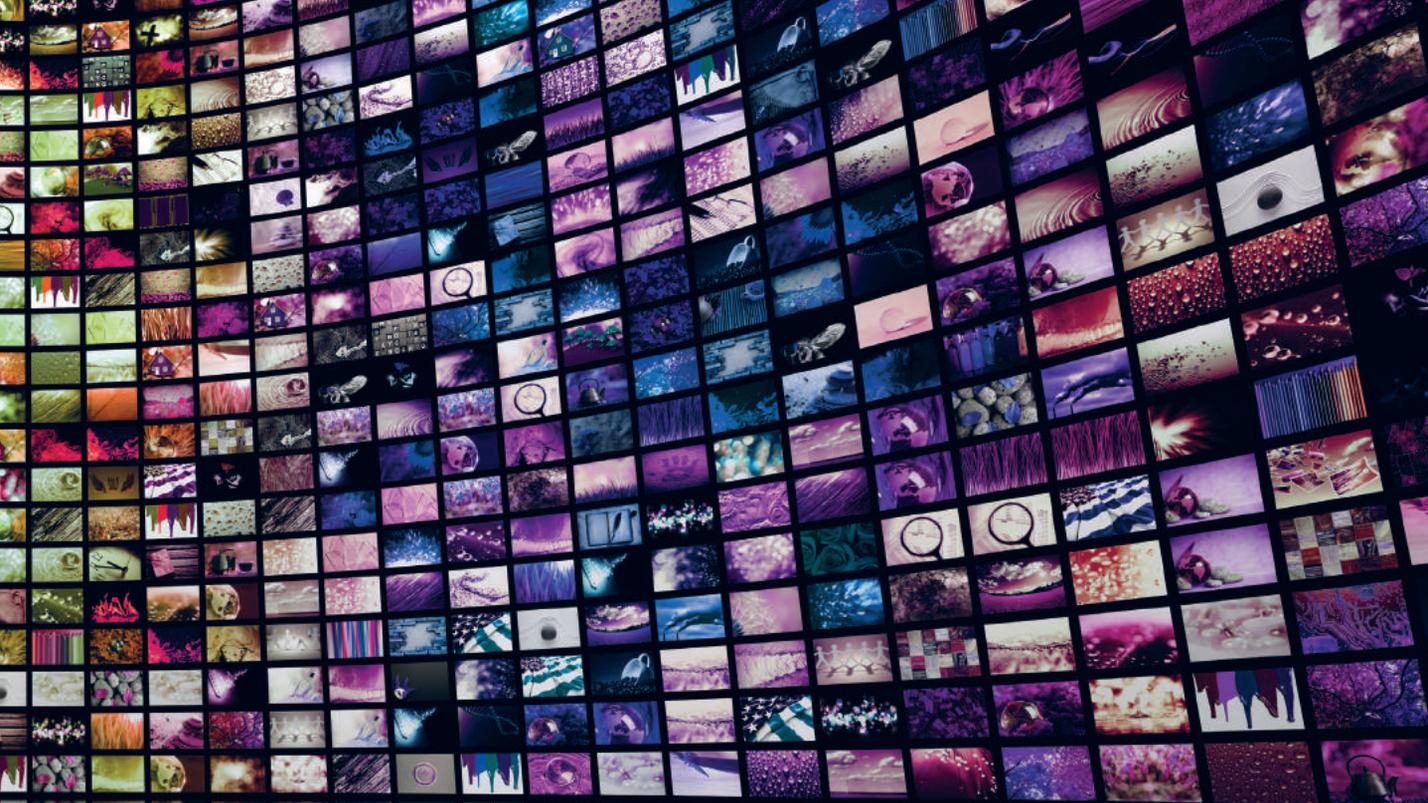
And even if a mark is registered, some concerns remain. Having reviewed the registration certificates for the accepted motion and multimedia registrations, these simply include a link to EUIPO's website. It is not clear what the registered EUTM is. This means that EUIPO cannot change its domain name in the future without affecting those non-traditional marks. It will also inevitably lead to confusion when enforcing those registered marks. Many courts in Europe are traditional (relying only on paper) and may not even follow, or attempt to access, the link. That could lead to brand owners intent on registering motion or multimedia marks forum shopping for those EU courts that use digital systems.

Also of concern is the question: what if infringers do not have access

- Filing multimedia marks with sound may arguably reduce the strength of those rights – it adds another layer when attempting to argue confusing similarity.
- Defining a video mark as a series of sequential images rather than providing a link to the video may enhance enforcement certainty.
- To be clear about what right is being asserted in a motion or multimedia mark, screenshots or storyboards should also be relied on.
- Ensure your watch provider is equipped to capture each individual frame of a protected video mark in order to adequately police unauthorised use.
- If the sound in a multimedia mark is independently distinctive, it is worth protecting the sound separately by filing for a motion mark with no sound.
- Video and audiovisual files are not yet accepted by WIPO; a brand owner contemplating a filing must be committed to achieving only EUTM protection at present.

to the internet? In the UK, the civil procedure rules require pre-action steps prior to enforcement action. One of those requirements is to be clear about what right is being asserted. Based on these certificates, little more than sending the web link may be required. It follows then that screenshots or storyboards should also be relied on.

What raises the most serious concern, though, is that these new motion or multimedia marks could contain names or logos that are identical or confusingly similar to a brand owner's earlier rights. Although the non-traditional marks are being examined in the same way as traditional ones, it remains a fact that EUIPO does not raise objections based on identity or similarity with earlier rights. The brand owner itself needs to file an opposition. Having reviewed the EUTM register, we are not convinced that notices are being sent to earlier right holders where similar marks are contained in the videos for which applications have been filed.



“ The fact that brand owners are attempting to push the boundaries of protection is really exciting, but EUIPO is clearly still examining these marks in full and taking its time in the process ”

Because these are new types of marks with untested boundaries of protection, we also suggest that trade mark representatives keep an eye on them so that anything containing identical or similar brands can be caught and challenged where necessary. Clearly, it will be hard for a watch provider to capture each individual frame of a protected video if it relies only on the software used for traditional marks. Our recommendation to brand owners is to think carefully about which watch provider they are using, and ensure the one they choose has suitable technology available to meet the new requirements of watching motion and multimedia marks.

CREATIVE CHALLENGE

Undoubtedly, the continuing trend will be for brand owners to get increasingly creative in terms of how they define their business. Taking advantage of technology to enhance their identity is what makes creative brands stand out and gets people talking. Yet considering

the large number of our clients already using digital branding, moving images and promotional videos, we observe that many of the largest global brand owners have yet to take advantage of protection for these potential marks. This may be an indication that they are waiting for the dust to settle and the boundaries of protection to be clarified, or it could be that they see traditional protection as sufficient for the time being. It is also true that, where the applicant is considering protection beyond the EU, it must be aware that video and audiovisual files are not being accepted by WIPO, and this is not expected to change any time soon.

As a result, the brand owner must be committed to achieving only EUTM protection for now.

Nonetheless, for brands or clients implementing a creative branding strategy that takes advantage of new technology, this could be the time to review the protection strategy and consider EUTM protection. For certain right holders, such as those that own TV formats or computer games, the ability to protect these marks is a real asset. Often those owners would refer to unregistered rights as their strongest IP rights. With the help of these new EUTM rights, they are now more likely to also have registered rights to assert, sell, assign or license. ●



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REIGN IN SPAIN?

Colin Hulme laments the current lacuna in relation to the enforcement regime

In **AMS Neve Ltd & Ors v Heritage Audio SL & Anor** [2018] EWCA Civ 86, the Court of Appeal considered an appeal from His Honour Judge Hacon, sitting in the IPEC. The issue before the Court was whether a Spanish company, Heritage Audio, could be sued in the IPEC by British-based Claimants for infringement of an EU trade mark (EUTM) if Heritage Audio's allegedly infringing acts were all carried out in Spain. Heritage Audio had notified visitors to its website (accessible from the UK and in English) that it was possible to purchase goods from a UK distributor, and suggested that it was also possible to place orders from within the EU directly.

It is important to note that, in relation to the part of the claim based on the Claimants' UK trade marks and passing off, it was acknowledged that the law is settled in terms of Regulation (EU) No 1215/2012 (Brussels I). This allows the claimant, under Article 7(2), to choose either to raise the action in the domicile of the defender, as is the general rule (set out in Article 4), or, in the case of passing off, to utilise one of the exceptions set out in Brussels I and raise the action in the place where the harmful event has taken place – in this case, the UK.

The law in relation to the EUTM is less straightforward, with jurisdiction governed by Article 97(5) of Council Regulation (EC) No 207/2009, as amended by Regulation (EU) No 2015/2424. Article 97(5) gives claimants a choice to “sue in the court of the Member State of the alleged infringer's domicile in respect of infringements anywhere in the EU,

or to sue in the courts of a Member State where an infringement has been committed or threatened, but only in respect of the infringements or threats in that territory”.

Lord Justice Kitchin sought clarification as to the interpretation of Article 97(5), making a CJEU reference in the following terms:

“In circumstances where an undertaking is established and domiciled in Member State A and has taken steps in that territory to advertise and offer for sale goods under a sign identical to an EU trade mark on a website targeted at traders and consumers in Member State B:

i) does an EU trade mark court in Member State B have jurisdiction to hear a claim for infringement of the EU trade mark in respect of

- the advertisement and offer for sale of the goods in that territory?
- ii) if not, which other criteria are to be taken into account by that EU trade mark court in determining whether it has jurisdiction to hear that claim?
- iii) in so far as the answer to (ii) requires that EU trade mark court to identify whether the undertaking has taken active steps in Member State B, which criteria are to be taken into account in determining whether the undertaking has taken such active steps?”

It would seem odd to find that a party domiciled in Member State B which commits acts that constitute infringement of an EUTM in Member State A cannot be sued in A because it ensured all infringing acts were contained in B. In this case, offering infringing goods online targeted at consumers in A should be actionable in that jurisdiction, where harm results.

Ultimately, we have to wait for the CJEU to provide instructions. Until then, we are left to ponder which EU trade mark courts have jurisdiction to enforce an EUTM. Unfortunately, that instruction is unlikely to come before 2019, leaving a lacuna in the enforcement regime.

“

Lord Justice Kitchin sought clarification as to the interpretation of Article 97(5) from the CJEU



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Colin would like to acknowledge the support received from Antonia Welsh (Paralegal) in writing this article.

Passing off gets prickly



The ability to recover legal fees incurred is the point for Margaret Briffa

This judgment from Her Honour Judge Clarke reminds practitioners that it is possible to successfully defend a passing off claim with a near total recovery of the legal fees incurred.

The claim was brought by Henry Martinez (a renowned tattoo artist, known professionally as Henry Hate) and his company, Henry Hate Studio and Prick Tattoo Parlour Ltd. The Defendants were Gynelle Leon (the proprietor of a nearby cactus and succulent plant shop) and her company Prick Me Baby One More Time Ltd.

Both sides traded as PRICK, but for very different reasons. In spite of this, the Claimants asserted that the identical nature of the Defendants' chosen brand name and the close proximity of the respective commercial outlets (1.2 miles) amounted to an actionable passing off.

ISSUES

The two issues to be decided at trial were:

1. whether the Claimants' goodwill associated with signs incorporating the word PRICK extended beyond the provision of tattooing and piercing services supplied from the tattoo parlour and, if so, to what extent; and
2. whether use of the word PRICK by the Defendants amounted to a material misrepresentation that the goods and services offered by the Defendants were those of the Claimants or were somehow authorised by or connected with the Claimants.

On the first issue, the Claimants had no problem asserting goodwill in relation to tattooing services. Mr Martinez is well known for his array of celebrity clients, including Amy Winehouse, and this was not disputed. What was in dispute, however, was how far this goodwill extended beyond the Claimants' normal commercial activities.

Her Honour Judge Clarke, in reaching her judgment, found that the goodwill extended to artistic works, Mr Martinez having undertaken a range of artistic activities. However, this goodwill did not extend to the provision of cacti and succulent plants. Turning to the issue of misrepresentation, the Court considered substantial witness evidence on behalf of the Claimants, but ultimately decided that it was insufficient. Clarke J stated in her judgment:

"My findings in relation to these witnesses mean that there is only one instance of

deception of a member of the relevant public which supports the allegation of a misrepresentation. Even that instance, however, I do not find to be material as I am not satisfied that the misrepresentation has damaged the Claimants' goodwill or is likely to

damage it in a serious way."

In the absence of any material misrepresentation, the claim was dismissed.

COSTS

Having found for the Defendants, submissions were made at the handing down hearing in relation to costs. The Defendants had incurred costs that amounted to roughly half of the maximum award (£50,000) in the IPEC. In light of this, the Court was extremely sparing in its assessment, awarding the Defendants 96 per cent of the costs incurred and proving that it is possible to successfully defend a claim in the IPEC without incurring significant unrecoverable legal costs.

“

The Court was extremely sparing in its assessment

KEY POINTS

- This was a claim for passing off in which both sides traded as PRICK, one offering tattooing and piercing services, and one operating a cactus and succulent plant shop
- The Court found that there was no material representation and dismissed the claim
- The Defendants were granted 96 per cent of the costs incurred



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Dr Brian Nicholson and Dr David Ivison, instructed by Briffa, acted for the Defendants.

One more rough ride

Loren Ravenscroft reports on a lengthy and acrimonious dispute

On 20th April, the High Court decided on issues of trade mark infringement and inducement to breach contract, following a long-running dispute between Lifestyle, owner and licensee of the BEVERLY HILLS POLO CLUB trade mark, and the Sports Direct (SD) group of companies. The marks concerned were UK and EU registrations for the BEVERLY HILLS POLO CLUB logo in class 25 (the Marks), one example of which is shown on page 31.

The Defendants were entities in the SD group. The first Defendant was the trading company for SD and the second was the group holding company, while the sixth (Republic) owns and operates USC, a chain of men's fashion stores.

In January 2013, SD sold items of clothing bearing the Marks in its UK Lillywhites stores. Following discussions between the parties, SD thought the matter resolved, but in October of the same year, Lifestyle issued a letter before action seeking damages of £4.2m. Negotiations followed, eventually leading to the Agreement.

His Honour Judge Pelling appeared critical of Lifestyle's CEO, who "had a reputation for ruthlessly and irrationally resorting to litigation at the slightest provocation". Pelling J noted that SD's motivation for seeking the Agreement was to settle the claim, while Lifestyle's was to ensure its goods were sold in the "right type" of store (to maintain its reputation for "affordable luxury"). Lifestyle wished to ensure its goods were not associated with Sports Direct (a discount store), but could be sold in outlets within the SD group that they considered appropriate, ie the USC stores.

The Agreement, under Dutch law, licensed the Marks to a company within the SD group called West Coast Capital (USC) Ltd (WCC). The licence stipulated that goods must only be sold via the USC stores or website, and that purchase and importation of goods must be executed only by WCC. The parties agreed to payment of a £250,000 royalty, purchase of £800,000 of branded goods and 10 per cent royalty on sales. A clause was inserted stating that all prior claims between the parties were

settled (although the Defendants were not party to the Agreement).

Unknown to Lifestyle, at the time the Agreement was executed, WCC owned only half of the USC stores (the other half were owned by Republic). Further, despite the terms of the licence, SD proceeded to purchase and import all of the goods on WCC's behalf (SD claiming it was the only company in the group capable of opening letters of credit at that time).

In January 2015, WCC entered into administration and sold the USC part of its business to Republic, including the remaining branded goods. Lifestyle claimed that: (i) the sale breached the Agreement; (ii) Republic had induced the breach; (iii) by purchasing and importing branded goods SD had infringed the Marks; and (iv) the 2013 infringement was not settled because the Defendants were not parties to the Agreement. The Defendants counterclaimed for partial non-use revocation of the Marks.

DUTCH-LED DECISION

Pelling J referred to Dutch law on the issues, and the first three claims succeeded, but the fourth failed. In summary:

1. The sale of the goods to Republic (though still in USC stores) breached the licence, which stated that goods could only be sold to consumers.
2. The evidence showed that Republic had induced the breach, as it was improbable that the relevant executive for Republic (who, given its structure, also acted for the entire SD group) had not read and understood relevant clauses. Pelling J accepted that the evidence was consistent with the Claimant's description of SD's "propensity to act in breach... and generally run rough-shod over other people's rights" when this was in its own commercial interests. The low threshold for damage was met, as Lifestyle was deprived of the opportunity to negotiate with Republic and the Agreement was unenforceable against Republic with respect to royalties.





“ This is a multifaceted but relatively straightforward case highlighting the importance of the construction of, and adherence to, licence agreements

The counterclaim was that the scope of the Marks should be reduced to particular items of clothing, as use could not be shown for the broad categories “clothing, footwear, headgear”. Pelling J determined that he did not have jurisdiction to decide the revocation of the EU trade mark for footwear or headgear, because removal of those terms would not affect the outcome of the case. However, he decided that the revocation failed with respect to clothing. For the UK trade mark, jurisdiction was not an issue, and the scope was reduced to “clothing excluding footwear and headgear”.

HARD FIGHT

The Claimants sought an order requiring SD to refer to the judgment on its website, but Pelling J considered that unnecessary and disproportionate, adding that “regrettably, this is an element of the way in which this litigation has been fought and perhaps over-hard fought”.

Both parties were denied permission to appeal, and there will be a further hearing to determine the remedies. Pelling J noted that any injunction (if elected) would restrict the Defendants from infringing the Marks in any way in the future, and that Lifestyle would be entitled to claim damage to reputation in a quantum claim.

This is a multifaceted but relatively straightforward case highlighting the importance of the construction of, and adherence to, licence agreements, especially with regard to setting out the parties (particularly where there are complex group structures involved), as deficiencies can turn into ammunition where there is acrimony between sides.

KEY POINTS

- It is important to determine the parties to an agreement, especially where there are complex company structures
- The jurisdiction of the agreement should be carefully considered
- Rights in a mark are not exhausted when a licensee has put goods bearing the mark on the market in the EU in breach of the licence, as the owner of the mark is not considered to have provided consent

LIFESTYLE LOGO MARK



- WCC was the only entity licensed to import/sell branded goods. Notwithstanding that, SD had purchased and imported the goods and had therefore infringed the Marks, which were found to have a reputation. The Defendants argued that Lifestyle’s rights in the Marks had been exhausted, but Pelling J disagreed and noted that, because the goods were put on the market against the terms of the licence, Lifestyle had not given its consent, and so its rights were not exhausted.
- The 2013 infringement claim was dismissed because, under Dutch law, the Defendants were found to be entitled to full/final settlement of that claim under the Agreement (despite not being parties to it), as that was the clear intention behind it (indeed, it was the primary motivation of the Defendants). However, Pelling J criticised SD’s failure to distinguish the separate legal personalities of its group entities by not including the Defendants as parties.



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Sky fight goes forward

Charlie Bond eagerly awaits the court's answers on several questions of clarity

In May 2016, Sky commenced proceedings for trade mark infringement and passing off against SkyKick. SkyKick counterclaimed that the specifications of Sky's earlier registered trade marks, in particular the term "computer software", were insufficiently clear or precise, meaning the trade marks were applied for in bad faith and were invalid.

On 6th February 2018, Mr Justice Arnold handed down a preliminary decision that Sky's registered trade marks had been infringed, but only in the event that they were deemed to be valid. On the issue of validity, Arnold J elected to make a reference to the CJEU for further guidance on two questions:

1. Could a trade mark be declared wholly or partially invalid on the ground that some or all of the terms in the specification were lacking in sufficient clarity or precision?
2. If yes, was a term such as "computer software" lacking in sufficient clarity or precision?

Both parties were given the chance to comment on the final form of the CJEU reference. Sky used the opportunity to request that the Court reconsider its previous conclusions and/or provide further amplification of the reasons for its decision.

NO RECONSIDERATION

Arnold J found no justification for reconsideration of his previous conclusions. There was no basis for the suggestion that the initial 358-paragraph judgment contained insufficient reasons for the conclusions reached. He did, however, make some changes to the form of the CJEU reference following the parties' submissions. The finalised form of the questions was:

1. Can an EU trade mark or national trade mark registered in a Member State be declared

wholly or partially invalid on the ground that some or all of the terms in the specification of goods and services are lacking in sufficient clarity and precision to enable the competent authorities and third parties to determine the extent of the protection conferred by the trade mark?

Arnold J agreed with Sky's submission that CJEU case law "supported the view that lack of clarity and precision in the specification of goods and services was not a ground of invalidity which could be asserted against a trade mark after registration".

However, in the context of infringement proceedings or relative grounds opposition, he noted that an unclear or imprecise term would be narrowly interpreted, extending only to those goods or services it clearly covered.

2. If the answer to question 1 is yes, is a term such as "computer software" too general (and does it cover goods which are too variable to be compatible with the trade mark's function as an indication of origin) for that term to be sufficiently clear and precise to enable the competent authorities and third parties to determine, on the basis of that term alone, the extent of the protection conferred by the trade mark?

Arnold J reaffirmed his position that "computer software" was too general and that the answer to this question was yes. He went on to comment that requiring greater specificity at the registration stage could be a possible solution. Such an approach, he said, "does not appear to have done the US system any harm". Further, it was at least arguable that all of the terms relied on by Sky for its registered trade marks were objectionable (with the exception of "electronic mail").

3. Can it constitute bad faith simply to apply to register a trade mark without any intention to





use it in relation to the specified goods or services?

4. If the answer to question 3 is yes, is it possible to conclude that the applicant made the application partly in good faith and partly in bad faith if and to the extent that the applicant had an intention to use the trade mark in relation to some of the specified goods or services, but no intention to use it in relation to others?
5. Is s32(3) of the UK Trade Marks Act 1994 compatible with Directive (EU) 2015/2436 and its predecessors?

Sky argued that established law says an examination of grounds for refusal must be carried out in relation to each of the goods and services. Therefore, it could not be argued that the existence of bad faith in relation to just some goods and services should lead to the invalidity of the entire trade mark. However, Arnold J reaffirmed his position that it is arguable that bad faith is different to other grounds of objection in that the existence of bad faith in relation to any goods or services taints the entire application and resulting registration. He also held his stance that, in the EU, the bad faith objection encompasses a lack of intention to use the trade mark.

OTHER MATTERS

Arnold J dismissed Sky's permission to appeal application, not being persuaded that the appeal had a real prospect of success. He also refused SkyKick's request for an extension of time to appeal. Arnold J felt the best use of time was for the CJEU reference to proceed in parallel with any permission to appeal applications the parties chose to make to the Court of Appeal. It would then be for the Court of Appeal to

KEY POINTS

- ★ The term "computer software" was deemed too general to be compatible with the function of a trade mark as an indicator of origin, and lacked clarity and precision

- ★ CJEU guidance is sought on whether a lack of clarity and precision in the specification of a trade mark can be asserted as a ground of invalidity; whether it could be considered bad faith simply to apply to register a trade mark without any intention to use it in relation to certain goods or services; and whether a finding of partial bad faith could be reached

stay any appeal pending the outcome of the CJEU reference, should it choose to do so.

It is also worth noting that Arnold J confirmed his view that it was correct to deal with passing off briefly in his previous decision, as it had also been dealt with briefly by counsel at the trial. He reiterated that likelihood of confusion does not equate to misrepresentation.

OUTCOME AWAITED

We await the outcome of the CJEU reference, in particular its guidance as to whether a lack of clarity and precision in the specification of a trade mark can be asserted as a ground of invalidity, and whether the lack of intention to use a mark for certain goods or services can constitute an application for a mark being made in bad faith.

If the CJEU does consider the term "computer software" to be unclear and imprecise, would there then need to be a consultation with the IT sector for the provision of a myriad of more specific software terms within the classification system? Conversely, if the CJEU considers the term to be sufficiently clear and precise, would this be seen as encouragement to corporations to tighten their grip on their broad monopolies? The CJEU's conclusion will make interesting reading either way.



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No easy ride for easyGroup

It failed in its battle against an EZI-prefixed bicycle mark, writes Dale Carter

In 2016, Dennis Ware (the Applicant) applied to register EZIBIKE as a UK trade mark covering, *inter alia*, bicycles in class 12 and clothing in class 25; easyGroup Ltd opposed under ss5(2)(b) and 5(3) of the Trade Marks Act 1994.

Under s5(2)(b), easyGroup relied on its family of EASY-prefixed marks (including EASYJET and EASYBUS) for identical goods in class 12 and similar services in class 39 (rental of vehicles). EASYJET was also relied on in relation to identical goods in class 25. Under s5(3), easyGroup relied on its EASYJET and EASYBUS word marks, claiming reputation for transport services. None of easyGroup's marks were subject to proof of use, but evidence was filed to substantiate the family of marks argument and s5(3).

There were identical goods in play in classes 12 and 25. In terms of other goods/services under s5(2)(b), easyGroup's "rental of vehicles" was considered moderately similar to "bicycles". A very low degree of similarity was found between "bicycles" and "transport services".

Neither EASY/EZI nor the name of the vehicle played an independent distinctive role in the marks. The overall impressions were based on the combination of the individual word elements, albeit with EASY/EZI playing a slightly stronger role.

EASYJET was considered highly distinctive for "airport services" and moderately distinctive for "clothing" and "bicycles". Any reputation in the EASYBUS mark was limited to "transport services"; but it was questionable whether this reputation existed at all. A moderate degree of distinctiveness was found for easyGroup's other marks.

NO CONFUSION RISK

The Hearing Officer (HO) dismissed the opposition on all grounds. Despite the class 12 goods being identical, there was no risk of direct confusion because of the visual differences between the marks, the higher than average degree of attention of the average consumer and the distinctiveness attaching to the marks. The differences between the marks EASYJET

and EZIBIKE were sufficient to avoid direct confusion for goods in class 25.

Indirect confusion was not made out based on easyGroup's family of marks. At the relevant date, the family was small and hadn't been used in relation to goods. The different EZI and EASY prefixes also lessened the risk of EZIBIKE being considered part of the easyGroup family and being associated with easyGroup. The differences between the marks were sufficient to remove the risk of indirect confusion in relation to class 25. The HO did not believe that EZIBIKE would bring EASYJET or EASYBUS to mind, so the s5(3) ground was swiftly dismissed.

APPEAL EXPECTED

EasyGroup had attempted to establish a pattern of brand extensions under the EASY brand, including for foodstuffs, estate agency services and gyms. Despite easyGroup alluding to these brand extensions, and therefore a wider family of marks, its evidence fell short. As easyGroup failed to plead the other marks in the wider family and file evidence relating to them, these rights could not form part of the opposition. At the relevant date, easyGroup's evidence only pointed to use of a small number of marks for "transport services", which didn't overlap with the Applicant's goods. The HO's finding in relation to s5(3) is perhaps surprising and is a reminder of the difficulties rights holders may face when attempting to protect trade marks under this ground, particularly where such marks have a limited inherent capacity to distinguish.

The writer suspects that this decision may be the subject of an appeal.

KEY POINTS

- ✦ A family of marks argument under s5(2)(b) requires evidence of use of the family at the relevant date for overlapping goods/services
- ✦ When relying on evidence filed in earlier proceedings, take care that the evidence is up to date and relevant to the grounds being pursued
- ✦ Small differences in marks with a weak distinctive character can avoid a finding of likelihood of confusion and even a "bringing to mind"

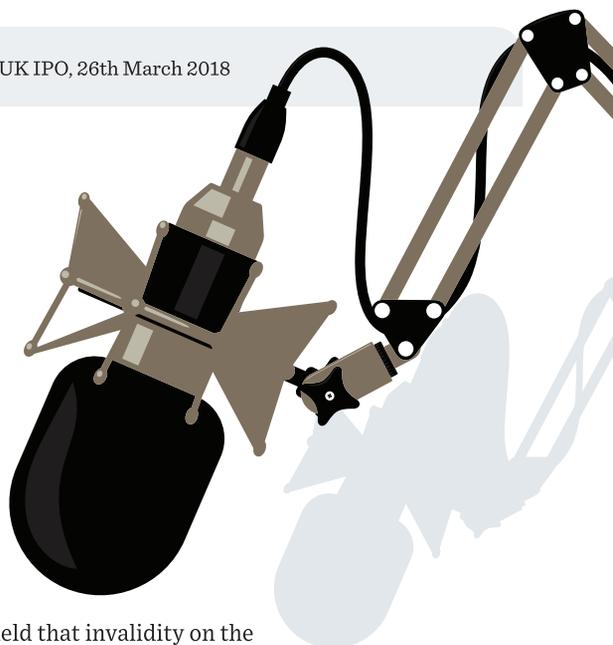


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A use-ful lesson

Georgy Evans sounds off about a case that saw a comprehensive review of relevant case law



Independent Local Radio (ILR) owned a number of marks for local radio, including registration No 3077324 (shown below right). CENTRE RADIO had been the name of a radio station in Leicester between 1981 and 1983. ILR began to create an online radio station (though not under the CENTRE RADIO name) from 2008 and filed its application in class 38 in October 2014. This was registered in January 2015 for a lengthy specification that included radio broadcasting.

OnBrand Group Ltd (OGL) is a specialist provider of marketing and communications services. It has provided piped music and advertising with a message service for shopping malls and garden centres since 2009 under the mark CENTRE RADIO. In May 2015, it applied to register a CENTRE RADIO device series of two marks (also shown below right). ILR opposed this on the basis of s5(2)(b) (earlier registered trade mark) of the Trade Marks Act 1994. OGL applied to invalidate ILR's registration on the basis of ss3(1)(b) and (c) (lack of distinctiveness), and 5(4)(a) (passing off).

While neither party succeeded overall, OGL came out of the dispute somewhat better than ILR, as it obtained a trade mark registration for services in which it had a commercial interest. By contrast, ILR lost its registered trade mark for most of the services in its specification, including radio broadcasting.

EVIDENCE OF USE

The Hearing Officer (HO) went through OGL's evidence of use to see when it could claim a reputation in CENTRE RADIO. After looking at various cases, including *Advanced Perimeter Systems Ltd v Lutisys Computers Ltd*, he concluded that the material date for OGL to establish its passing off claim was the date of ILR's trade mark application in October 2014. He also held that OGL had goodwill beyond radio broadcasting to cover telecommunication and other services. But OGL's claim failed in respect of some other services.

However, he held that invalidity on the basis of ss3(1)(b) and (c) failed because CENTRE RADIO was not descriptive: it merely gave a very rough idea of where radio services might be targeted.

On the opposition, the HO concluded that the CENTRE RADIO marks were highly similar, and that ILR's CENTRE RADIO mark was inherently distinctive to a medium degree but without enhanced distinctiveness through use. He emphasised that, where similarity of goods or services is not self-evident, the opponent must adduce evidence of how and why they are similar. He then identified a range of goods in OGL's application in both classes 38 and 41 that were not similar to the remaining goods in ILR's class 38 registration. The services that survived in OGL's application included radio broadcasting and telecommunication of information.

TIME-SAVING STRATEGY

While no costs were awarded because both sides had succeeded (or failed) in part, OGL did gain a registration that covered the services that it was providing in the marketplace.

Though not breaking new ground, this 50-page decision comprehensively sets out established case law. It illustrates that use, properly evidenced, does trump registration, but also that a registration to cover the use would have likely saved time and money, since earlier rights would not have had to be proved through use.

KEY POINTS

- + Where similarity of goods or services is not self-evident, the opponent must adduce evidence of how and why they are similar
- + Use, properly evidenced, trumps registration, but registration to cover use would have likely saved time and money in this instance

REGISTRATION
NO 3077324



ONBRAND GROUP
APPLICATION
NO 3107657



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No triumph of form over function

Désirée Fields explains an attempt to extend patent protection through trade mark rights

On 8th April 2016, Hambleside Danelaw Ltd (the Applicant) filed a UK trade mark application for a 3D mark (shown below right) of a roofing product covering various building materials in classes 17 and 19.

The examiner refused the application under ss3(2)(a), 3(2)(b) and 3(1)(b) of the Trade Marks Act 1994, finding that the average consumer would not see the mark as an indication of trade origin, but simply as a shape necessary to obtain a technical result, and that the sign lacked distinctive character. The Applicant disclosed the existence of several expired patents pertaining to the product. Following a hearing and submission of further evidence, the Hearing Officer (HO) formally refused the application.

EVIDENCE CONSIDERED

The Applicant described the product as being “dry fix”, meaning that no mortar was used in fitting it. The evidence and submissions showed that the product was originally a “wet fix” product in which mortar was used. The HO found that these essential characteristics of the sign were inherent to the generic functioning of the shape. The Applicant had conceded that in “wet fix” mode, all the essential characteristics of the shape were inherent to its functioning. The Applicant contended that in “dry fix” mode, one of the outer ridges was redundant. This was insufficient to overcome the objection, as the presence of the second ridge was originally conceived as being functional.

The Applicant had expressly claimed the four ridges in its patents and argued that the intent behind these had been to bring to mind the horns of a Viking helmet, reflecting its predecessor’s branding. The HO did not consider that the evidence supported this argument.

The HO also noted that any aesthetic aspects of the shape were far outweighed by

their technical utility, and his duty to interpret the patent claims to protect the public from an unjustifiable extension of patent rights by registration of a trade mark. With all the essential characteristics of this shape the subject of patent protection, there must be a very heavy presumption in favour of functionality and utility. The switch from “wet fix” to “dry fix” and the presence of an element that had little or no utility did not render the essential characteristics of the shape applied for redundant so as to avoid the objection.

The HO found that, at the date of filing, the shape would have had little or no inherent novelty, and that the inherent characteristics of the shape had not changed. The fact that it could be used in “dry fix mode” did not take the shape outside the norms and customs of the trade. Refusing the application in its entirety, the HO found that the evidence did not show use of the sign as a trade mark.

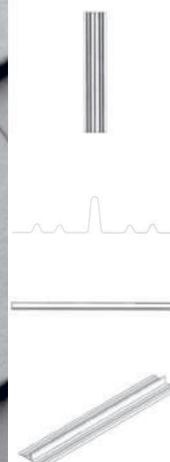
UPHILL STRUGGLE?

Obtaining protection for product shapes is always an uphill struggle for brand owners, who must prove that the shape differs sufficiently from the norms of the sector to be distinctive and does not serve a functional purpose so as to cause a “technical result”. Here, the timing of the trade mark application coincided with the expiry of patent protection, causing the HO to carefully examine the scope of the patent claims.

KEY POINTS

- ✦ A shape mark must differ from the norms of the sector to be distinctive
- ✦ A shape mark may not serve a functional purpose to cause a technical result
- ✦ Trade marks cannot unjustifiably extend the life of patent claims

THE APPLICANT'S MARK



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When Harry met Selfridges

A name is not reason for confusion, confirms Amelia Skelding

In this decision, the UK IPO found in favour of retailer Selfridges, allowing the registration of its trade mark applications for HARRY GORDON'S BAR and HARRY GORDONS.

In May 2013, Selfridges applied for the above trade marks covering classes 29, 30, 32, 33 and 43 for goods including alcohol and services for providing drinks.

In August 2013, Harry's New York Bar filed a notice of opposition against all of the goods and services in both applications.

The Opponent argued that the use of the name HARRY in Selfridges' trade marks resulted in similarities with its earlier marks HARRY'S, HARRY'S BAR and HARRY'S NEW YORK BAR, which it claims were first used in Paris in 1911.

The Opponent submitted that its bars can be found in luxury hotels that would be visited by the same sort of people who frequent Selfridges' store on London's Oxford Street. Therefore, use of the mark in such a prestigious establishment would "ride on the coat tails" of its existing reputation.

Selfridges rejected these claims, stating that its bar was named after the retailer's founder, Harry Gordon Selfridge, and inspired by the popular TV series, *Mr Selfridge*, about his life.

COMPARISON OF MARKS

The IPO said that, as all the marks at issue began with the name HARRY, there was an inevitable degree of visual and aural similarity – however, only to a medium degree for HARRY GORDONS and to a slightly higher than medium degree for HARRY GORDON'S BAR.

The conceptual similarity was found to be low because the Opponent's HARRY'S BAR trade mark indicates that the bar is owned or operated by somebody called Harry, giving no reference to a surname. Meanwhile, Selfridges' trade marks refer to a specific individual, namely

a HARRY whose surname is GORDON, or the particular individual Harry Gordon Selfridge.

LIKELIHOOD OF CONFUSION

The IPO stated that consumers are used to distinguishing between names and using them to identify particular undertakings, because it is not uncommon for bars and restaurants to use personal names for their businesses. Therefore, HARRY GORDONS or HARRY GORDON'S BAR

would not be perceived as a reconfiguration of HARRY'S BAR. Consequently, the s5(2)(b) claim failed.

REPUTATION

The Opponent's evidence supported use and reputation in the sign HARRY'S NEW YORK BAR,

but not HARRY'S BAR, because the differences between the marks were considered sufficient to avoid the public making the necessary link. Even if the Opponent had a reputation for HARRY'S BAR in the EU, its Paris location meant it had not been brought to the attention of a commercially significant part of the UK public. Therefore, the ss5(3) and 5(4)(a) claims failed.

The opposition failed in respect of all of the grounds pleaded by the Opponent, and it was ordered to pay Selfridges £2,200.

Although there is nothing objectionable about businesses using personal names per se, small differences and conceptual variations between name marks can often be sufficient to avoid the risk of likelihood of confusion.

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Consumers are used to distinguishing between names

KEY POINTS

- While names are, in most cases, perfectly acceptable as trade marks, they often do not result in the most distinctive of marks
- Small differences and conceptual variations between similar name marks can be sufficient to rule out overall similarity



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Opposition on the rocks

Blanket arguments didn't wash, reports Heather Williams

Boutique Coffee Brands Ltd (the Applicant) filed an application to register the trade mark shown below right for, among other goods, alcoholic beverages in classes 32 and 33, and services relating to the provision of food and drink in class 43. The application was opposed by Chivas Holdings (IP) Ltd (the Opponent) on the basis of ss5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994. The Applicant denied all the grounds and a decision was reached on the papers.

COMPARISONS

The Opponent relied on blanket arguments pertaining to the similarity of the respective goods and services at issue.

The Hearing Officer (HO) determined that classes 32, 33 and 43 of the Applicant's trade mark were identical to classes 32, 33 and 43 of the Opponent's composite word and ship device and ship device (also shown right).

Based on an assessment of the ingredients, methods of production, taste, colour and aroma, the HO determined that the goods "wine, cider and sparkling wine" in class 33 of the Applicant's trade mark were neither similar nor complementary to gin in class 33 of the Opponent's word mark. Further, the HO considered there to be no similarity or complementarity between the Applicant's class 32 goods and the goods in class 33 of the Opponent's word mark.

The services relating to the provision of drinks in class 43 of the Applicant's trade mark were considered to have a low degree of similarity with the class 33 goods of the Opponent's word mark. There was no similarity for the remaining items in class 43 covering "restaurant services and provision of food".

The HO considered there to be a low degree of similarity between the Opponent's word mark and the Applicant's trade mark and a very low degree of similarity compared with the Opponent's ship device.

The HO concluded that the most prominent elements of the Opponent's mark are the word PLYMOUTH and the sailing ship device, which coincided with the most prominent elements of the Applicant's trade mark. The HO considered that there was a medium degree of similarity between the Applicant's trade mark and the Opponent's composite word and ship device.

CONFUSION

The opposition under s5(2)(b) in respect of the Opponent's ship device failed, as there was no likelihood of confusion. In respect of the Opponent's word mark, the opposition under s5(2)(b) was upheld in respect of class 33 in its entirety and part of class 43 in respect of services relating to the provision of drinks. Allowing for the concept of imperfect recollection, on the basis of the Opponent's composite word and ship device, the opposition under s5(2)(b) succeeded in relation to all goods and services in classes 32, 33 and 43.

EVIDENCE LACKING

The Opponent failed to adduce evidence of reputation or goodwill in respect of the trade marks relied on. Accordingly, the grounds for opposition based on ss5(3) and 5(4) failed. Had the Applicant requested proof of use of the Opponent's registered trade marks, taking into account the quality of evidence filed to substantiate the grounds for opposition, a different decision may have been reached.



KEY POINTS

- ✦ Where the goods at issue fall into the same category of goods, they will not always be deemed similar
- ✦ Where similarity between goods is not self-evident, it is necessary to adduce evidence to demonstrate similarity, rather than rely on blanket arguments covering collective terms

THE APPLICANT'S TRADE MARK



THE OPPONENT'S REGISTERED MARKS



EU9921644, ship device



EU 9893306, composite word and ship device

PLYMOUTH EU 908723, word mark



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Mister overcomes Master



Chris Morris notes that all marks are not created equal

This case concerns opposition proceedings against an application by Mr Chef Ltd to register MISTER CHEF to cover a range of bakeware, cookware and utensils. The Opponent, Shine TV Ltd, opposed on the basis of its earlier UK registrations for MASTERCHEF and MASTER CHEF. The earlier marks covered kitchen utensils and containers in class 21, and Shine opposed under s5(2)(b).

It also claimed a reputation for its class 41 reality TV series. Because the MASTERCHEF brand is heavily merchandised (Shine claimed), the public is accustomed to seeing cooking-related items pertaining to the show. Use of MISTER CHEF would take unfair advantage of the reputation under s5(3).

PROOF AND EVIDENCE

All bar one of Shine's earlier rights had been registered for more than five years when Mr Chef's application was published. In its counterstatement, Mr Chef put Shine to proof of use, but did not specify for which mark. Despite a request from the UK IPO, clarification was not given and the proof of use request was dismissed. Shine was, consequently, able to rely on all its rights as registered.

Only Shine elected to file evidence, which detailed the history and popularity of the *MasterChef* format in the UK. An exhibit to the statement provided two examples of merchandising (one in French), although where or when these goods were on sale/sold was not apparent.

DECISION

On review, the Hearing Officer (HO) concluded that the goods covered by Mr Chef's application were all identical to goods covered by the earlier marks. The HO concluded that the average consumer was either a professional cook or a member of the general public, both paying a normal degree of attention. The purchasing act was likely to be primarily visual.

The distinctive character of the earlier mark was discussed next. "Chef" is strongly allusive in respect of goods for use in cooking, and it was also found that the mark as a whole alluded to goods of sufficient quality to be used by a "master chef". This meant a lower than average level of distinctiveness.

Turning to a comparison of marks, the HO found that they were visually and aurally similar to a high degree. However, the marks were found to be conceptually dissimilar – a skilled cooking practitioner versus a person called Mister Chef. As a result, and in conjunction with the fact that the (small) visual and aural differences occurred at the start of the marks, the HO found no likelihood of confusion. The opposition failed under that head.

As to s5(3), Shine enjoyed a reputation in the MASTERCHEF name for a TV series. So would the public make the requisite mental link between the respective marks? It was found that they would not. While the earlier mark had, through use, acquired at least a normal level of distinctive character for the above services, Shine had not established that the UK public was familiar with merchandised goods. The absence of a likelihood of confusion, while not decisive, was relevant. Overall, there was no unfair advantage.

On the strength of the above, the opposition was unsuccessful. This case is a clear demonstration that not all trade marks are equal, and that the protection afforded by registration will vary.

KEY POINTS

✦ The striking out of the proof of use request is an important reminder of the need for procedural precision and a proper understanding of UK IPO process, even at the counterstatement stage

✦ Very small differences can be critical where an earlier mark is not inherently distinctive, and distinctiveness cannot be shown through use



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TSS strikes it lucky

Small differences had a big impact, observes Rebecca Campbell

On 28th January 2016, TSS Facilities Ltd (the Applicant) applied to register the TSS FACILITIES logo shown below right in relation to “Installation, maintenance, servicing and repair of air conditioning, refrigeration, heating, ventilation, water treatment and hygiene apparatus; information, advice and consultancy in relation to the installation, maintenance and repair of air conditioning, refrigeration, heating, ventilation, water treatment and hygiene apparatus; electrical installation services” in class 37. ISS World Services A/S (the Opponent) opposed the application under ss5(2)(b), 5(3) and 5(4) of the Trade Marks Act 1994. The Opponent relied on three earlier EU and international trade marks for its ISS logo and a range of goods and services in classes 9, 35, 37, 39, 40, 41 and 42 (limited to class 37 in final submissions). Both parties filed evidence, and the Opponent was asked to show proof of use, reputation, goodwill and enhanced distinctiveness.

STARTING POINT

The Hearing Officer (HO) started by rejecting the case under s5(2)(b). She took one of the Opponent’s earlier EU marks, which was not subject to proof of use, as a starting point, and held that the contested services were identical, or in some cases at least highly similar, to those covered by the earlier right (in accordance with the principle outlined in *Meric*¹).

Although both parties adduced evidence that they provided facilities management, the HO declined to make an assessment regarding these services, as the respective specifications did not refer to them. The average consumer was found likely to be a member of the general public (such as a homeowner or landlord) or a business with a higher than average degree of attention. The evidence provided in support of enhanced distinctive character was insufficient, as much of it was broad, referring

to general services or, in the case of global annual turnover for one sector, not broken down by country. The phrase “facilities management” was also said to be a “buzz word” that did not provide a clear indication of the services involved.

STRIKING DIFFERENCE

Assessing the similarity of the marks, the HO stated that “small differences can indeed make a striking difference in short marks”. Although the marks shared the letters SS, there was a low degree of visual similarity. Aurally, the degree of similarity was low to medium and the conceptual position was neutral, with both marks likely to be identified as abbreviations for the names of the organisations. The marks were simply not similar enough to cause direct or indirect confusion.

The grounds under ss5(3) and 5(4) also failed. The evidence filed did not establish a reputation. Although the Opponent had acquired valuable goodwill as a cleaning company,

evidence of sales or marketing had not been provided for other services. Further, use of the contested mark would not constitute a misrepresentation to the public even where identical services were involved, as the contested mark was unlikely to be mistaken for the earlier marks. The opposition therefore failed in its entirety.

Note: the official status of the contested application at the time of writing is “published”.

“
The marks were not similar enough to cause direct or indirect confusion”

KEY POINTS

- + Short marks, including acronyms, can be difficult to enforce, as small differences can be striking
- + It is important to ensure that evidence of enhanced distinctiveness, reputation or goodwill directly relates to the services claimed, rather than vague categories or buzzwords
- + Goods can be considered identical where a more general category in a later application includes goods covered by an earlier mark

THE APPLICANT'S LOGO



THE OPPONENT'S EARLIER MARK



¹ Gérard Meric v OHIM, Case T-133/05



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Key concerns

Sarah Brooks says evidence was central to this TSA LOCK decision



Following the 9/11 terror attacks, the US government set up the Transportation Security Administration (TSA). The TSA commissioned Travel Sentry, Inc and Safe Skies LLC to manufacture luggage locks that could be unlocked by airport authorities during the security screening process without damage to the lock.

On 7th July 2005, Travel Sentry filed an EU trade mark application for TSA LOCK for goods in classes 6 (metal locks for luggage), 18 (bags, wallets and other luggage articles) and 20 (non-metal locks for luggage). On 15th April 2014, Safe Skies filed an application for a declaration of invalidity on a number of absolute grounds, including that the Mark was devoid of any distinctive character, descriptive and deceptive.

The Cancellation Division, in a decision upheld by the Board of Appeal (BoA), refused the application for a declaration of invalidity.

DISTINCTIVE CHARACTER

Safe Skies argued that the BoA was wrong in holding that the relevant date for assessment of the distinctive character of the Mark was the filing date, not the registration date. However, the Court reiterated that, as is clear from the case law, the only relevant date for assessing absolute grounds for refusal in invalidity proceedings is the filing date. Any subsequent material provided must apply to the situation as at the filing date. Here, while Safe Skies appears to have submitted a substantial amount of evidence, it was dated after the filing date (or had no obvious date).

The Court also rejected Safe Skies' argument that the BoA had wrongly focused its assessment on the public when it had accepted that the goods were targeted at both the general public and professionals, in particular manufacturers and retailers in the luggage and suitcase sector.

In relation to whether the Mark was devoid of distinctive character, the Court accepted that the word "lock" could not confer a distinctive character on it. However, Safe Skies

had not submitted relevant and/or sufficient evidence to demonstrate that the relevant public would have understood TSA as an abbreviation for the Transportation Security Administration or as a reference to the agency. Therefore, at the filing date of the Mark, it would not have been perceived by the relevant public as being devoid of distinctive character.

MERELY DESCRIPTIVE

In terms of descriptiveness and deceptiveness, both grounds failed because the evidence did not demonstrate that the relevant public understood TSA to be an abbreviation for the Transportation Security Administration. In relation to deceptiveness, in particular, the Court rejected Safe Skies' argument that the relevant public could be misled into believing that locks sold under the Mark were supplied by the US or were at least under its control, given that the TSA sign had no association in the public consciousness with a particular origin.

PRESUMPTION OF VALIDITY

The case demonstrates the need to file relevant and good-quality evidence that predates the filing date. It also indicates that registered trade marks enjoy a presumption of validity and it is for the invalidity applicant to establish why a mark is invalid; it cannot expect the court to conduct the analysis and review itself.

KEY POINT

✦ In invalidity proceedings, it is important to file pertinent evidence that applies to the relevant period



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No cornet confusion

One common element didn't convince, says Daniel Bailey

In November 2013, the Applicant applied to register a figurative mark containing the words BOBO CORNET (shown below right) in classes 29, 30 and 32 in relation to a range of dairy products, confectionery and non-alcoholic beverages. Şölen Çikolata Gıda (the Opponent) opposed this application in February 2014 on the basis of Article 8(1)(b) of Regulation (EC) No 207/2009. The Opponent relied on its earlier registration for a figurative mark containing the words OZMO CORNET (also shown below right).

In March 2015, EUIPO's Opposition Division rejected the opposition in its entirety. In July 2016, the Fourth Board of Appeal (BoA) dismissed the appeal, finding the marks to be visually and conceptually dissimilar and phonetically similar to a less than average degree. While the goods were identical and similar, the differences between the signs led the BoA to conclude that there was no likelihood of confusion. The Opponent appealed that decision in September 2016.

COMPARISON OF THE SIGNS

The Opponent argued that the dominant visual elements of the opposed mark were the words "bobo" and "cornet". The General Court (GC) did not accept this argument, and held that the BoA was correct in finding that, as the rabbit occupies two-thirds of the opposed mark, it was the dominant visual element of the mark. Therefore, the marks were found to be visually dissimilar.

The GC found that the words "bobo" and "ozmo" would have a greater phonetic impact in the signs at issue than the word "cornet", and that these terms are pronounced very differently in the relevant languages. The relevant public would likely only pronounce the first word of each mark when purchasing the goods. The word

"cornet" would be seen as descriptive by the relevant public with an understanding of the meaning of the word, who would not pronounce it when making the purchase.

Assessment of conceptual similarity must take into consideration the distinctive and descriptive nature of common elements. The words "bobo" and "ozmo" have no meaning. The common element "cornet" was not sufficient to establish a conceptual similarity, as it would be either understood by the relevant consumer to be descriptive or unable to convey any concept.

Accordingly, the GC found that the BoA did not err in finding the marks to be visually and conceptually dissimilar, and phonetically similar to a lower than average degree.

CORRECT CONCLUSION

In light of the above, and despite the identity and similarity of the goods, the GC found that the BoA was correct in finding that there was no likelihood of confusion between the marks. The opposition therefore failed and the Opponent was ordered to pay costs.

Overall, it is not surprising that the GC upheld the decision of the BoA, which was based on consistent reasoning.

This case serves as a reminder to trade mark owners, when assessing the risk of a likelihood of confusion, to fully consider the figurative and descriptive elements of a mark and their impact on the overall impression.

KEY POINTS

- ✦ When assessing the risk of a likelihood of confusion, trade mark owners must fully consider the figurative and descriptive elements of a mark
- ✦ A common descriptive element is not sufficient in itself for a finding of conceptual similarity

THE APPLICANT'S MARK



THE OPPONENT'S MARK



“
The common
element did not
establish a
conceptual similarity



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National rights at risk

Eleanor Merrett discusses a decision with potentially disastrous effects for EUTM seniority claims

The Court's ruling follows a request for a preliminary ruling from the German Supreme Court relating to Article 14 of the previous Trade Marks Directive (2008/95/EC). Under Article 14, a national mark that forms the basis of a seniority claim can be invalidated or revoked a posteriori, with the result that the seniority claim is lost.

In the German proceedings, Peek & Cloppenburg KG, Düsseldorf claimed that German registrations of PUC – owned by Peek & Cloppenburg KG, Hamburg – were vulnerable to non-use attack when the marks were surrendered, so the seniority claim based on these marks enjoyed by the EU trade mark (EUTM) registration of PUC should be lost. Peek & Cloppenburg KG, Hamburg claimed the seniority claim should remain because it had since begun using PUC in Germany.

DATE DECISION

The CJEU had to decide on the relevant date for assessing genuine use of PUC – was it the date of surrender of the German registrations, or the date of the non-use revocation action? The CJEU decided that, in the context of a later revocation action brought against a national mark that has been surrendered or allowed to lapse, the relevant date for assessing genuine use is the date of lapse/surrender. Any use after that date is use of the EUTM and cannot save the national rights, so the seniority claim is lost.

Article 39 of Regulation (EU) 2017/1001 states that: “where the proprietor of the EU trade mark surrenders the earlier trade mark or allows it to lapse, he shall be deemed to continue to have the same rights as he would have had if the earlier trade mark had continued to be registered”. An unused national mark is “reactivated” and saved from revocation if use recommences later. However, national rights acquired through a seniority claim cannot be reactivated in the same way as national registrations.

DISADVANTAGE

This is a significant disadvantage for rights holders. If there is any doubt that a national mark that forms the basis of a seniority claim has not been used, it would be unwise to allow it to lapse. If a national mark is allowed to lapse, rights holders should ensure they have and retain sufficient evidence to prove genuine use of the mark in the preceding five years to stave off any future non-use attack and ensure they can preserve their valuable earlier filing date. EUTM owners who have already allowed earlier national rights to lapse may now face challenges to seniority claims and the difficult task of collating evidence of use from potentially more than two decades ago.

Seniority was supposed to allow trade mark owners to group all their rights together and remove the need to maintain numerous national filings in parallel with an EUTM. However, this ruling seriously calls into question the usefulness of seniority claims. Unless EUTM owners have used a national mark widely and retained extensive evidence of such use, dropping national registrations and relying solely on seniority claims would be risky.

KEY POINTS

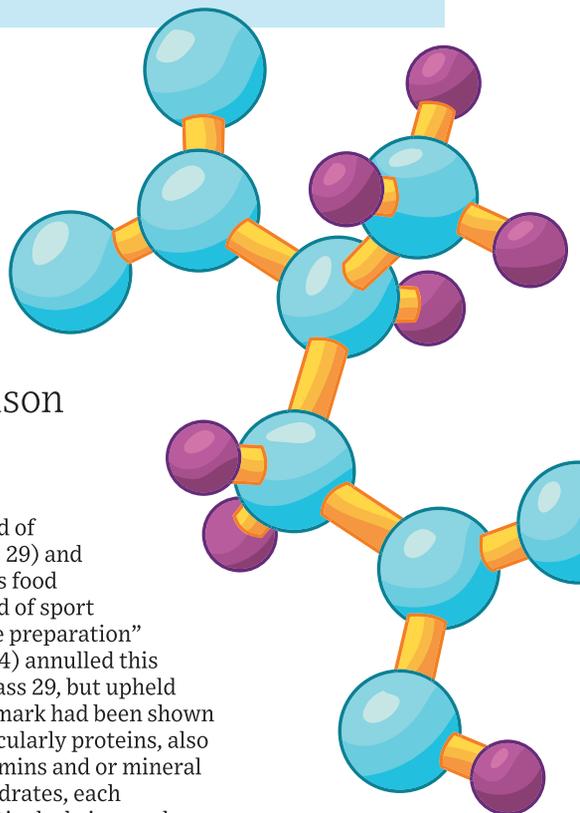
- + If a national registration is vulnerable to non-use cancellation when it lapses, any EUTM seniority claim based on it is subsequently at risk
- + Use of a previously unused mark does not “reactivate” national rights that are the subject of a seniority claim
- + EUTM owners should exercise extreme caution when allowing national rights which are the subject of a seniority claim to lapse or expire



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No gains from the GC



A protein producer was unsuccessful in its second appeal, writes Angharad Rolfe Johnson

In its second appeal to the General Court, the Applicant, Bernhard Rintisch, attempted to have annulled two decisions (2014, 2016) of the Board of Appeal (BoA) that rejected, in part, its opposition against classes 5 and 29 of a Community trade mark designation for PROTICURD in the name of Compagnie laitière européenne SA. The opposition was based on three German registrations and relied primarily on the registration for PROTI, protected for protein-powder-related products in classes 29 and 32.

The current appeal relied on three pleas:

1. the BoA had failed to provide reasons for its finding that genuine use of PROTI in class 29 had not been shown in evidence;
2. the BoA had incorrectly assessed the genuine use evidence provided; and
3. as a result, an incorrect assessment had been made in respect of the likelihood of confusion.

STATEMENT OF REASONS

The Court, in its first decision (2015), found that the BoA had failed to make any statement in respect of genuine use for the goods in class 29. It therefore sent the case back to the BoA for review. In its second decision (2016), the BoA found that genuine use had not been made of PROTI for class 29.

This decision was appealed again on the same grounds (failure to state reasons for its decision). However, in the current decision, the Court rejected the Applicant's second appeal, noting that it was not necessary to follow every single avenue of argument set forth by the Applicant. It was enough that it was clear from the BoA's second decision that possible genuine use in class 29 had been taken into account.

ULTIMATE ASSESSMENT

In the original decision, the Opposition Division found that genuine use of PROTI had

been made for: "protein concentrates as food supplements for the field of sport and fitness" (class 29) and "protein concentrates as food supplements for the field of sport and fitness, for beverage preparation" (class 32). The BoA (2014) annulled this decision in respect of class 29, but upheld that genuine use of the mark had been shown for "preparations, particularly proteins, also supplemented with vitamins and or mineral salts, as well as carbohydrates, each

particularly in powder form, for beverage preparation" in class 32. This was ultimately upheld by the Court in the current decision.

On the basis of this genuine use assessment, the Court also upheld the BoA's assessment of the likelihood of confusion: no likelihood of confusion for the goods in class 5 (found

dissimilar to the class 32 goods) and "milk powders, milk beverages, with milk predominating" in class 29 (deemed "remotely" similar to those in class 32); likelihood of confusion found for the remaining class 29 goods.

This case serves as a useful reminder that the relevant distinguishing criterion between class 5 and class 32 goods is not whether they are liquid and edible in nature, but instead relates to their intended purpose.

“

It was not necessary to follow every single avenue of argument set forth by the Applicant

KEY POINTS

- It is not necessary for the BoA to follow every avenue of argument set forth by an applicant
- The distinguishing criterion between class 5 and class 32 goods is not whether they are liquid and edible in nature, but instead relates to their intended purpose



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Out of joint

Lucy Pope outlines a case in which the registered proprietor disputed withdrawal of proceedings

On 31st January 2014, C5 Medical Werks filed applications for declarations of invalidity before EUIPO against three marks of CeramTec GmbH. The marks, shown below right, were registered in 2013 on the basis of distinctive character acquired through use for class 10 goods, hip- and knee-joint replacement parts (the Marks). The invalidity applications before EUIPO were in response to infringement proceedings brought by CeramTec in 2013 against C5 before the Regional Court, Stuttgart, and the Regional Court, Paris.

On 7th April 2016, C5 notified EUIPO that it had filed counterclaims for declarations of invalidity of the Marks before the Regional Court, Paris, and that it was withdrawing the applications for declarations of invalidity before EUIPO. The EUIPO invalidity cases were closed, and C5 ordered to pay the costs incurred by CeramTec.

On 19th May 2016, CeramTec filed actions against the decisions to close the cases claiming that:

1. closure of the proceedings required its consent;

2. it had been deprived of the chance to obtain a positive ruling on the validity of the Marks; and
 3. withdrawal of the invalidity proceedings before EUIPO was an abuse of process.
- On 15th February 2017, the Board of Appeal (BoA) dismissed CeramTec's actions as inadmissible.

GC FINDINGS

The BoA held that under Article 56(1) of Regulation (EC) No 207/2009 (EUTMR) (now Article 63(1) of Regulation (EU) 2017/1001), the proprietor cannot request a positive statement on the validity of its mark. CeramTec argued before the General Court (GC) that it was adversely affected under Article 59 EUTMR, as a positive final decision on invalidity on the merits would have the effect of *res judicata*, preventing further invalidity proceedings against the Marks.

The GC agreed with the BoA that there had been no adverse effects: the Marks remained on the register and a favourable costs award had been made. Effectively, it was the same outcome as if the full proceedings had been decided in CeramTec's favour. The GC confirmed that the existence of other proceedings before EU trade mark courts had no bearing on conditions for admissibility of the instant proceedings.

The GC denied CeramTec's argument that there is an absence of provision in the EUTMR for unilateral withdrawal of an application for invalidity, meaning proceedings cannot be terminated without the consent of the proprietor. The GC also held that the question of abuse of rights is irrelevant in invalidity proceedings under Article 56(1)(a) EUTMR.

This case is part of a series of IP battles between these parties. C5 was successful in France, where the EU Court held in 2017 that the Marks were invalid.

KEY POINTS

- +
- The GC held that invalidity proceedings can be terminated without the consent of the proprietor of the marks under attack
- +
- The EU trade mark owner was not "adversely affected", in accordance with the terms of Article 59 EUTMR, by the decision to allow withdrawal of invalidity proceedings against its marks

EUTM NO
10214179:
3D PINK,
PANTONE 677C



EUTM NO
10214112:
FIGURATIVE
MARK, PINK
PANTONE 677C



EUTM NO
10214195:
COLOUR
MARK, PINK,
PANTONE 677C



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Hard target

An appeal decision held firm, reports Leanne Gulliver

Pfizer Inc (the Intervener) is the owner of the earlier EU trade mark (EUTM) for VIAGRA. The word mark is registered in respect of pharmaceutical and veterinary preparations and substances in class 5. Gall Pharma GmbH (the Applicant) applied to register the word mark STYRIAGRA for “Preserved, frozen, dried fruits and vegetables, in particular pumpkin seeds” in class 29.

The Intervener opposed the application under Articles 8(1)(b) and 8(5) of Regulation (EC) No 207/2009 (now Regulation (EU) 2017/1001). The Opposition Division dismissed the opposition. The Intervener successfully appealed the decision based on Article 8(5), and the application was dismissed in its entirety. The General Court (GC) reaffirmed the findings of the Board of Appeal (BoA), namely that the EUTM for VIAGRA had a sufficient reputation to prevent the registration of the mark STYRIAGRA in class 29.

REPUTATION IN THE EU

The GC supported the BoA’s assessment that the reputation for VIAGRA was significant and not only included the consumers of the actual goods, but also extended to the entire EU population. In addition, the GC pointed out that certain marks may acquire a reputation that goes beyond the relevant public as regards the goods or services for which those marks are registered. Although the goods at issue in this case were not similar, the aphrodisiac properties attributed to certain dry and preserved fruits and vegetables were capable of giving rise to an association between

VIAGRA and STYRIAGRA in the mind of the relevant public, despite the different nature and purposes of the goods. Further, consumers of the class 29 goods applied for may also be consumers of the medicinal products covered by the registration for VIAGRA.

SINGLE PLEA

Having recognised the reputation attributed to VIAGRA in the previous proceedings, the Applicant subsequently disputed the reputation of the earlier mark for the first time at the hearing. The GC rejected the claim as inadmissible because: the Applicant’s complaint was new, and could not be regarded as based

on matters of law or of fact that came to light in the course of the procedure; the reputation of VIAGRA has previously been recognised by the Opposition Division (T-332/10, *Viaguara v OHIM – Pfizer*); and the Applicant did not challenge the finding before the BoA or in its application before the Court.

“

The BoA was correct to conclude that the general public may establish a link

GC DECISION

The GC held that the BoA was correct to uphold the opposition. It was fully entitled to conclude that, even though the goods were dissimilar, in view of the other factors, such as the similarity of the marks (albeit weak), the significant reputation of the earlier mark (a reputation which extended to the general public of the mark applied for) and the fact that aphrodisiac effects are sometimes attributed to the natural products in class 29 covered by the mark applied for, the general public may establish a link between the two signs and transfer the positive values of the earlier mark VIAGRA to the goods of STYRIAGRA.

KEY POINTS

Article 8(5) expressly refers to the situation in which the goods or services are not similar

No new plea in law, complaint or argument may be introduced in the course of proceedings unless it is based on matters of law or of fact that come to light in the course of the procedure



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WE are not champions

Its opposition to a two-letter mark fell flat, writes Matthew Harris

On 20th November 2013, El Corte Inglés, SA (the Applicant) filed an EU trade mark (EUTM) application for the stylised two-letter mark EW (shown below right) covering the majority of the class heading terms in classes 3, 18 and 25.

WE Brand Sàrl (the Opponent) opposed the application based on Articles 8(1)(b) and 8(1)(5) of Regulation (EU) 2017/1001. The opposition was based on the Opponent's earlier EUTM registration (No 7209571) for the word mark WE covering, *inter alia*, goods including "soaps, perfumery, lotions" in class 3; "leather goods, bags" in class 18; and "clothing, footwear, headgear" in class 25.

On 28th January 2015, the opposition was successful in respect of all of the contested goods, except for "walking sticks" in class 18, because the Opposition Division took the view that there was a likelihood of confusion between the marks at issue within the meaning of Article 8(1)(b). By contrast, the opposition was rejected in respect of Article 8(5) on the basis that the Opponent had failed to show that the earlier mark had a reputation. The Applicant consequently appealed the decision.

By 11th February 2016, the EUIPO Second Board of Appeal (BoA) had dismissed the appeal on the basis that "the signs at issue exhibited significant visual and phonetic similarities, with the result that there was a likelihood of confusion on the part of the relevant public, consisting of average Italian- and Spanish-speaking consumers, within the meaning of Article 8(1)(b) in respect of all the goods that had been found to be identical, similar or similar to a low degree".

The decision was consequently appealed to the General Court (GC).

In carrying out a global assessment of the marks, the GC rejected the BoA's decision as being unfounded. The GC's assessment was as follows:

1. The earlier mark has little phonetic and visual complexity, with the result that it is necessary, when comparing that mark with other marks, to take into account the factor resulting from any changes or modifications observed in the later trade mark.
2. The mark applied for differs from the earlier mark, since there are a number of elements in the mark applied for that are not present in the earlier mark.
3. Consequently, the overall impression made

on the relevant public by the signs at issue cannot be capable of giving rise to a likelihood of confusion between the marks at issue, even though the goods at issue are identical or similar.

Accordingly, the GC annulled the decision of the BoA and ordered a costs award in favour of the Applicant. The GC

ruled that trade mark owners cannot prevent the registration of other trade marks that use the same letters but in a different order and, as a result, are phonetically, visually and conceptually different. The case shows the strict assessment criteria when comparing two-letter marks and the difficulty faced by trade mark owners in enforcing two-letter marks within the EU community.

“

The case shows the strict assessment criteria when comparing two-letter marks

KEY POINTS

- ✦ A likelihood of confusion was not established on the basis that the relevant public would not mistake EW for WE and assume the marks were connected
- ✦ When dealing with two-letter marks, earlier trade mark owners face a difficult task in preventing the registration of other trade marks that use the same letters but in a different order, on the basis that this is likely to create phonetic, visual and conceptual differences

THE EL CORTE INGLÉS MARK

EW



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Follow-up failure

Timely compliance is crucial, David Yeomans cautions

This case concerns a non-use revocation action filed by Sky International AG against EU trade mark (EUTM) registration No 6347827 – SKYLEADER (figurative). The revocation action succeeded and the registration was revoked on the basis that Skyleader a.s. had failed to file timely evidence of use. The only communication received by EUIPO before the deadline expired was a faxed cover letter from Skyleader explaining that proof of use would follow by post. No evidence accompanied the letter. Although the evidence did indeed follow, it was received after the deadline. Skyleader's appeal was rejected, and it then further appealed to the General Court (GC), which has now dismissed the appeal and upheld the revocation of Skyleader's registration.

PRIMARY ARGUMENTS

Skyleader put forward two primary arguments in its appeal to the GC. Its first argument was that the late filing of the evidence was due to circumstances outside its control (primarily attributable to delays in the postal service), and that EUIPO ought therefore to have used its discretion to take the evidence into account.

In its judgment, the GC reiterated that, in a non-use revocation action, EUIPO must invite the proprietor of the EUTM to furnish proof of genuine use of the mark within a specific period. If no proof of use is provided within the period set, the mark must be revoked. The burden of proof lies with the proprietor, and the proprietor must exercise care and diligence in order to comply with the time limit. The GC was satisfied that, since Skyleader had failed to file any evidence in time or request an extension, it had not exercised sufficient care and due diligence. Although it is possible to submit additional evidence of use after expiry of the time limit (and EUIPO is not prohibited from taking the additional late-filed evidence into account), in this case, Skyleader's failure to file any evidence at all before the expiry of the deadline was fatal to its argument.

Skyleader's second argument was that EUIPO's failure to advise it that it could seek

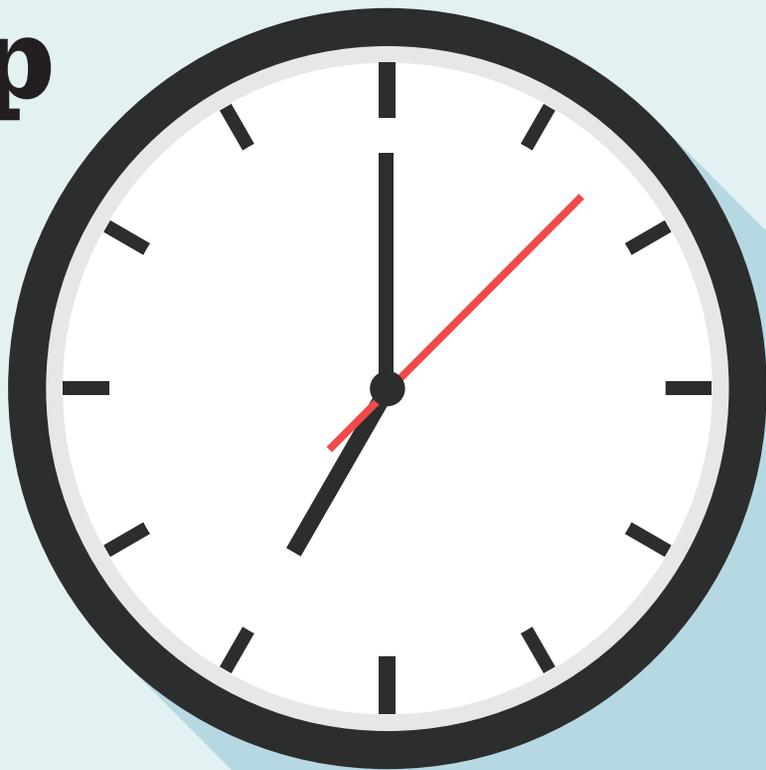
leave to file the evidence late under the principle of *restitutio in integrum*, or by applying to EUIPO for a continuation of proceedings, violated the principle of sound administration. The GC rejected this argument on the basis that EUIPO is not obliged to inform a party of the options available to it, and that all the relevant provisions are laid out in EUIPO's guidelines.

COMPLIANCE NEEDED

This case illustrates the importance of complying with deadlines in proceedings before EUIPO. If meeting the deadline is proving to be a struggle, consider applying for an extension of time. If it is not possible to meet the deadline and you are unable to obtain an extension of time, then all is not necessarily lost, but you need to be proactive in seeking a remedy (such as *restitutio in integrum* or continuation of proceedings).

KEY POINTS

- + Skyleader's failure to file evidence before the expiry of the deadline was fatal to its argument
- + Extensions of time can be available if pursued in a timely manner
- + EUIPO is not obliged to inform a party of the options available to it with regards to late-filed evidence



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October sees us put the focus on CITMA Paralegals with a dedicated seminar at Lewis Silkin in London →



Events

More details can be found at citma.org.uk

DATE	EVENT	LOCATION	CPD HOURS
15th August	CITMA Webinar* UK IPO and EUIPO procedure – legally harmonised but procedurally different	Log in online	1
25th September	CITMA Lecture – London* Latin America: trade marks as a tool for investments and innovation in a 4.0 environment	58VE, London EC4	1
12th October	CITMA Paralegal Afternoon Seminar	Lewis Silkin, London EC4	
17th October	CITMA Webinar* An update on groundless threats	Log in online	1
1st November	CITMA Day Seminar for Litigators – London	London	7
8th November	CITMA Autumn Conference* Relative disharmony – earlier rights and resolving conflicts	ICC, Birmingham B1	5
14th November	CITMA Webinar*	Log in online	1
19th November	CITMA Paralegal Webinar	Log in online	
27th November	CITMA Lecture – London* Update on UK IPO and UK court decisions	58VE, London EC4	1
29th November	CITMA Lecture – Leeds Emerging professional liability risks for IP professionals	Walker Morris, Leeds LS1	1
7th December	CITMA Northern Christmas Lunch	TBC	
14th December	CITMA London Christmas Lunch**	London Hilton on Park Lane, London W1	

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 with your ideas.

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THE TRADE MARK 20

Q&A

Shirley Collins

is feeling seasonably optimistic

I work as... a Chartered Trade Mark Attorney at Lawrie IP in Glasgow.

Before this role, I was... a Trade Mark Attorney at another IP firm in Glasgow. Prior to that, I worked in various trade mark-related roles in Glasgow and in South Africa.

My current state of mind is... optimistic, partly due to the lovely sunshine we are enjoying at the moment (which can be a rarity in Scotland).

I became interested in IP when... I was helping out at an IP firm during my school holidays.

I am most inspired by... people who work relentlessly towards a goal and use their success to improve the lives of others.

In my role, I most enjoy... the variety of people, businesses and brands I am privileged to work with every day.

In my role, I most dislike... an unfavourable opposition decision. Sadly, you can't win them all!

My favourite mug says... "Life begins with coffee".



“
‘This isn’t a job; it’s a career’. These were the words of an HR manager on my first day in an IP firm

The talent I wish I had is... musicality. I would love to be able to play a few musical instruments.

I can't live without... family, friends and coffee.

My ideal day would include... exploring Machu Picchu; and waffles with syrup and ice cream.

In my pocket is... a single pound coin.

The best piece of advice I've been given is... "This isn't a job; it's a career". These were the words of an HR manager on my first day in a clerical job at an IP firm 20-odd years ago. Her words that day completely changed my outlook.

When I want to relax, I... attend a yoga class or go to the cinema.

In the next five years, I hope to... travel more and learn to play the piano.

The best thing about being a member of CITMA is... the regular updates it provides on matters relevant to the profession, and the sense of community.

On my desk is... a chunk of rose quartz, hand cream and a Steven Brown desk calendar.

The best place I have visited on business is... Forres, a town on the Moray coast in the north of Scotland, especially because it involved a scenic drive through the Highlands.

If I were a trade mark/brand, I would be... Reiss – like me, it's sensible, understated and dependable, and was established in the 70s.

The biggest challenge for IP is... policing brands online.

Shirley enjoyed the scenic Highland drive to Forres



Full Time Trade Mark Attorney

Keltie

Keltie is one of the fastest growing and most innovative of all IP Firms. Committed to excellence in client service, the firm remains true to its Founder's value of empowering its members to achieve personal growth through professional experience. We are now seeking a full time qualified Trade Mark Attorney to join our dynamic team in London.

The Role

The successful candidate will have at least 2 years CITMA (or equivalent EU) post-qualification experience and will be expected to work with minimal or no supervision and advise on a full range of trade mark issues, including clearance searching, trade mark filings, assignments, licensing, portfolio management, oppositions, infringement and other contentious matters. Experience with design matters would also be beneficial.

You will be expected to contribute to business development and foster the continued growth of the practice. The successful candidate will have strong marketing skills, entrepreneurial attitude, the ambition to develop his/her own client base and will be offered opportunities to do so. Communication skills will be essential.

Based in our London office, your portfolio of clients will include SMEs and larger international clients and you will enjoy close direct client relationships as well as tangible involvement in advising on the strategy behind their trade mark portfolios. Our attorneys are encouraged to take on high levels of autonomy from an early stage and are supported in building their own practice.

Why join us?

Keltie is an exceptional IP firm with a reputation for providing excellent client service to a range of small, medium and large clients around the world. World Trademark Review ranks Keltie among Britain's top trade mark firms and we are one of the fastest-growing IP firms in the UK, with new offices in Cambridge and in Ireland (Galway).

We provide a flexible and supportive environment with competitive pay/benefits and collective bonuses, in line with our values. We also offer genuine potential for career progression reflecting the successful candidate's contribution to the firm's success.

To Apply

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