

CITMA REVIEW

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*When it comes to
digital currency brands,
who's along for the ride?*

The Crypto
Rollercoaster



A person's legs in athletic wear, including sneakers and leggings, are shown against a dark background. The legs are surrounded by vibrant purple energy effects, including flames and lightning bolts, suggesting power and speed.

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WELCOME & CONTENTS



Tania Clark
CITMA President

“
Read which firms and advocates made the most UK IPO appearances in 2018

Spring is finally in the air and I hope you'll be joining us at our annual conference on 13th–15th March. Artificial intelligence is the main theme at that event, and technology also features on page 8 of this edition of the *CITMA Review*, with an article that takes a look at the intersection of IP and virtual reality.

Those of you who are keen on league tables should turn to page 14 to read the rankings of firms and advocates who made the most UK IPO appearances in 2018.

After Brexit, there will be an increase in UK work and oral hearings, which makes our full-day conference on litigation even more useful. See page 13 for a short report and citma.org.uk for a full event recording. Look out also for future webinars, where Trade Mark Attorneys from Canada, China and the US will share expertise and updates on legislative changes.

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CASE COMMENTS



Kelly (top right) will lead on CITMA events, such as the Spring Conference, while Aaron (right) heads up EPAD

CITMA ELECTS TWO NEW CHAIRS

To kick off the new year, the CITMA Council elected two new committee chairs. Aaron Wood, founder of Wood IP, has taken up his post as the new chair of the Education Policy & Development (EPAD) committee, while Kelly Saliger, a Chartered Trade Mark Attorney at CMS Cameron McKenna Nabarro Olswang LLP, will now lead the Events committee. Kelly replaces long-standing Events chair Maggie Ramage, while Aaron takes over from Mark Foreman, who served as acting EPAD chair in 2018.

The EPAD committee's role is to oversee and develop the education programme for CITMA members.

The Events committee leads on development of our extensive programme of events, including the annual Spring Conference and very popular Christmas lunches.

The new chairs will join: Kate O'Rourke, chair of the Executive committee; Rachel Wilkinson-Duffy, chair of Law & Practice; and Richard Hayward, who heads up Publications & Communications.

Committees and working groups are the heartbeat of CITMA. They guide and deliver our work for the benefit of the profession. Our governing Council relies on a network of volunteers to run them, which

ensures members are at the centre of everything we do.

While the committees are extremely important, we understand that our members are busy, so we make sure that our volunteers can be flexible with regard to the amount of time they need to commit. By volunteering, our members support not only CITMA, but the entire IP profession.

If you are interested in supporting the work of CITMA by volunteering, please visit citma.org.uk to view the information about our committees and working groups, and the current vacancies available.

A WORD ABOUT BREXIT

We are keeping a close watch on Brexit developments, which are picking up pace as we go to press. See citma.org.uk/brexit for our latest responses as events unfold.

THE REVIEW NEEDS YOU

Members are always welcome to contact the *CITMA Review* to suggest articles that they would like to contribute, and which are of interest to our international readership. Simply email caitlin@thinkpublishing.co.uk

IP INCLUSIVE: ANNUAL HIGHLIGHTS

In its annual report for 2018, IP Inclusive looks back on what its leader Andrea Brewster OBE describes as a busy and rewarding year. Among the highlights, Andrea singles out the first IP Inclusive Week, held in November 2018, as the “best” achievement of the year, thanks to the “enthusiastic participation of so many supporters”. Other key events included:

- a launch reception for the Careers in Ideas outreach campaign, which forged new partnerships;
- IPReg’s approval of IP Inclusive training events as valid CPD for Patent and Trade Mark Attorneys;
- winning the MemCom award for Best Equality or Diversity Campaign;
- the creation of the first IP Inclusive regional chapter at a meeting of Scottish signatories;
- learning that the EPO’s revised *Rules*

of Procedure of the Boards of Appeal contains gender-neutral terminology, following lobbying by the IP Inclusive Women in IP group; and

- huge progress in raising awareness of, and providing training around, mental health in the workplace.

In 2019, Andrea reports that the work of IP Inclusive Management, which is supported by CITMA’s Chief Executive Keven Bader and First Vice-President Richard Goddard, will assume greater importance. The group, which oversees IP Inclusive’s activities, will be carrying out a strategic review to look at the human and financial resources needed to deliver on the organisation’s mission.

Already this year, IP Inclusive has launched its new-look website, where you can also find the full annual report. Visit ipinclusive.org.uk

MEMBER MOVES



Sarah Dacre

Sarah has joined Southall Hathaway & Co as an Associate. Contact her on 0116 268 9495 or sarah.dacre@southallandco.com



Caroline Phillips

A Chartered Trade Mark Attorney, Caroline has recently joined Lane IP in London. Contact her at cphillips@laneip.com



Campbell Newell

After 30 years in the IP profession spent at Marks & Clerk, Campbell will retire at the end of July. A dual-qualified Patent and Trade Mark Attorney, he said: “I have thoroughly enjoyed my career at Marks & Clerk and working with my many colleagues over the years. I wish you well for the future.”

Considering a career move?

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



DARREN SMYTH

PRESIDENT STRENGTHENS ASIAN TIES

CITMA President Tania Clark (front row, third right) was one of the UK IP sector representatives who took part in a trip to Japan and South Korea in early February. The trip aimed to build and strengthen relationships with the Japanese and Korean IP communities.

WHY DO I SERVE? IT'S SIMPLE

IP is our economic powerhouse, believes Lord Smith

Since I took up the position of Chair of IPReg, many people have asked me why I was so interested in putting myself forward for the role. My answer is very simple. For many years now, and certainly ever since I served as Secretary of State for Culture 20 years ago, I have been a passionate believer in the importance of IP.

It was in my role as Secretary of State that I put in place the first steps towards proper governmental recognition of the value of the creative industries – those parts of the UK's economic activity such as design, architecture, film, music, advertising, games, television and fashion, which depend on individual creativity for their economic impact.

The definition of the creative industries that I developed – and which stands today – was “those industries which have their origin in individual creativity, skill and talent and which have a potential for wealth and job creation through the generation and exploitation of intellectual property”.

The raw material used by these industries is ideas; the economic worth comes from the IP created. Exactly the same fundamental principle applies, of course, to the whole spread of IP endeavour, and especially to patents and trade marks. In a highly developed economy such as the UK's, we won't compete in the world on the basis of access to raw materials, cheap

labour or manufacturing volume. Instead, we compete on the strength of our ideas, innovation, design and quality. And protecting the value of those ideas and that quality is where the work of Patent and Trade Mark Attorneys becomes so important.

“

There needs to be the very best structure in place to ensure that IP rights can be protected

Charles Leadbeater wrote a seminal book at the very end of the 20th century setting out a manifesto for the significance of the new knowledge economy. It is called *Living on Thin Air: The New Economy*, and begins with the observation that: “Today more and more of us make our livings from

thin air – from our ideas and know-how. This is because knowledge is becoming the most creative force in the modern economy. In old capitalism, the critical assets were raw materials, land, labour and machinery. In the new capitalism, the raw materials are know-how, creativity, ingenuity and imagination.”

But, of course, ideas are much more difficult to protect than tangible property and in order to realise their true economic value there needs to be the very best structure in place to ensure that IP rights can be protected. It's something we've known ever since the reign of Queen Anne, but it has become formidably important in the modern economy. And it will become increasingly so.

That's why CITMA, CIPA and the work of their members are so fundamentally important. And it's why IPReg can and must, I believe, help to make the IP profession effective, efficient, well qualified and well regulated – and able to hold its head up high. I'll be proud to be able to play a small part in that endeavour.



The Rt Hon the Lord Smith of Finsbury

is Chair of IPReg

Lord Smith will be a featured speaker at the CITMA Spring Conference.

BARBARA LUCKHURST

www.ip-support.co.uk
020 7776 8966
info@ip-support.co.uk

A large, stylized graphic of the letters 'IP' in a serif font, centered within a large, light gray, curved shape that resembles a stylized 'P' or a large 'D'. The background is a solid light gray.

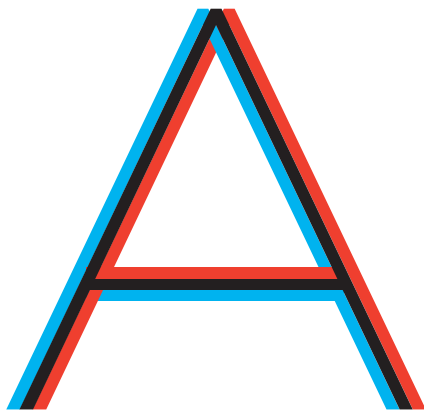
IP

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Trade Mark Records and Formalities
Trade Mark Formalities Paralegal
Trade Mark Secretary
Junior Trade Mark Administrator
Trainee Trade Mark Administrator

VISIONS OF THE FUTURE

What hold does IP have in a virtual world?
Michael Browne offers his view



As the name suggests, virtual reality (VR) technology aims to create a digital 3D environment in which a user is able to experience and interact with a landscape or scenario in a way that mimics real-life interactions. Usually, this is delivered via a headset that allows the user to become immersed in the VR world through an integrated display.

A sense of realism can be achieved in a number of ways. For example, advances in hardware processing speeds lead to ever-improving frame rates (the frequency at which the individual images appear on a VR display). This, in turn, results in smoother and more convincing digital environments. Further technological developments mean that the traditional visual and audio elements of VR applications are now also being combined with other

sensory elements, such as haptic technologies (which simulate the sense of touch), to create a more holistic user experience. Exhibitors at consumer innovation showcase CES 2019 recently demonstrated many exciting technologies designed to deliver a more “immersive” VR experience, such as Cybershoes, which enable users to translate the physical motion of walking to movement within VR-enabled games.

However, while improvements in VR technologies are fascinating and no doubt give rise to interesting and potentially patentable innovations, one might argue that if they are not deployed to allow users to experience the things that they encounter in everyday life – including brands and products – then true virtual *reality* has not been achieved. It is this additional

frontier of VR development that this article will explore.

URBAN LANDSCAPES

For the urbanites among us in particular, the buildings, monuments and other landmarks that make up our towns and cities are a significant feature of the world that we inhabit. It therefore makes sense that a VR application that wishes to offer a user the ability to explore a virtual representation of a real-life city would include the actual architecture one would encounter there. Taking London as an example, that would include such historic buildings as the Houses of Parliament and St Paul’s Cathedral, as well as modern and striking buildings such as The Shard, the “Walkie Talkie”¹ and the “Cheesegrater”². Similarly, one would expect to find Nelson’s Column in a virtual Trafalgar



Square, the Shaftesbury Memorial Fountain in Piccadilly Circus and the Orbit Tower in Queen Elizabeth Olympic Park in any truly “realistic” representation of the city. The same is, of course, true of towns and cities throughout the world.

Reproducing actual buildings and structures would therefore be an important part of creating a truly “realistic” VR representation of a real place. However, doing so gives rise to a number of potential IP issues.

As explored in detail in issue 445 of the *CITMA Review*³, a number of famous buildings and landmarks are the subject of trade mark registrations. Assuming for present purposes that such marks are validly registered, the reproduction of their subject matter in a VR context raises interesting and complex questions of trade mark law. For example, would

“
*Reproducing actual
buildings and
structures in VR
gives rise to a
number of potential
IP issues*”

1. 20 Fenchurch Street
2. The Leadenhall Building
3. Leighton Cassidy, “Trade Marks on Tour”, pp21–25
4. See C-48/05 – Adam Opel, ECLI:EU:C:2007:55

the reproduction of a building within a VR system that aims to produce a realistic representation of a real-world location amount to a use liable to affect the function of the relevant trade mark, such as to give rise to potential infringement?⁴

Similarly, would the accurate reproduction of branding on a digital representation of a McDonald’s outlet, for example, amount to a use of the famous “golden arches” that is liable to affect the essential function of a trade mark in the context of a digital world that is striving to replicate “reality”? It would be a brave studio that proceeded on the basis that the wholesale incorporation of unlicensed third-party brands on buildings (or, indeed, in other contexts) in a virtual world does not infringe any trade mark rights on this basis alone. Naturally, ►



the surrounding context within which any such use took place would be determinative of whether any of the relevant grounds of infringement were engaged.

In any event, the common-law action of passing off may well cause further issues should the use of a building and any associated branding leave users with the impression that the reproduction of these things is licensed. This would likely be all the more true where the building itself is the subject of merchandising activities, such as The Shard or Wembley Stadium.

Both sculptures and works of architecture (defined as buildings or models for buildings) are capable of copyright protection in the UK as “artistic works” under the Copyright Designs and Patents Act 1988 (CDPA), with protection of older works also

possible under the 1956 and 1911 Copyright Acts. Might the inclusion of representations of such works in a VR setting therefore infringe UK copyright?

One answer might be to point to s62 CDPA, which excludes from infringement the reproduction (in the form of graphic works) of artistic works “situated in a public place or in premises open to the public”, as an effective “shield” to such a claim. Adopting the approach of the Court of Appeal in *Nova v Mazooma*⁵, it seems likely that each still frame produced in a VR display amounts to an individual graphic work which ought to engage this so-called “freedom of panorama” exception. However, this exception does not extend to any copyright subsisting in the architectural plans and drawings for a protected work, which might be

an obvious reference point for the creation of a virtual reproduction (particularly if internal aspects or features are to be used), the copying of which might therefore give rise to infringement. Moreover, while a similar exception is found under copyright laws applying in other jurisdictions, the position does vary. In France, for example, the equivalent exception does not extend to “commercial uses”, which may, therefore, rule out its applicability to a commercially exploited VR application.⁶

Moral rights are another potentially important consideration. For example, s80 CDPA provides that an author⁷ has the right not to have its work subjected to “derogatory treatment”. In this context, “treatment” means any addition to, deletion from or alteration or



“

By striving to achieve ever greater ‘realism’, the creator of a virtual world will also in effect be seeking to satisfy the infringement test

5. [2007] EWCA Civ 219 at para 16

6. See Article L. 122-5 of the French Intellectual Property Code

7. s80(2) CDPA 1988

8. s80(5) CDPA 1988

9. s226(1) CDPA 1988

10. s226(1) CDPA 1988, Article 19(1) Council Regulation 6/2002 of 12 December 2001

adaptation of the work, which will be considered “derogatory” if it amounts to a distortion or mutilation of the work or is otherwise prejudicial to the honour or reputation of the author. While this right does not apply to works of architecture that are buildings,⁸ if a VR system enables users to interact with and manipulate their surroundings in order to enhance the “reality” of the experience, then the ability to destroy or deface a protected sculpture within that VR world might infringe the moral rights of the author of that work, if such rights have been asserted. The recognition, duration and scope of moral rights is another area that varies significantly from jurisdiction to jurisdiction and, interestingly, Article 6bis of the Berne Convention appears to have a broader scope

than s80 CDPA, as it extends to (among other things) “derogatory action in relation to the said work” (emphasis added). This suggests that the scope of the moral right that applies under UK law may well be narrower than the equivalent laws of other signatory states.

DANGEROUS STEP

Of course, a truly “real” virtual experience would ideally include all sorts of other “things” that we encounter in our daily lives, such as vehicles, furniture and consumer products. If one wanted to create a realistic virtual environment, then reproducing all of those things in the same way as they are encountered in real life (ie to the same shape and specification as products that we encounter in the real world) would be a natural step to take.

But to what extent would including representations of real-world products that are manufactured by third parties in a VR world raise IP issues?

When considering the reproduction of the shape of products, design rights immediately come to mind. While it is unlikely that UK unregistered design rights would come into play in the context of VR, given that it confers the exclusive right to make articles to the protected design,⁹ in the absence of further guidance from the CJEU, there is no obvious limitation to the right conferred by UK or Community registered and Community unregistered design rights, which simply cover “use”.¹⁰ Although each case will turn on its merits (which, in the case of registered rights, will depend very much on the design actually depicted in the relevant registration), a catch-22 situation arises in that, by striving to achieve ever greater “realism”, the creator of a virtual world will also in effect be seeking to satisfy the infringement test, namely to reproduce a design that produces the same overall impression on the informed user.

In addition to design protection, many brand owners obtain registered trade mark protection for the shape of their products, as well as the more “traditional” marks applied to those goods, such as brand names and logos. While shape marks have been given quite a tough time (as anyone who has followed the KitKat saga will attest), if the issue of validity is put to one side, then the interesting and complex questions of trade mark law noted above in the context of registrations for buildings and landmarks apply equally here.

In the UK, an associated passing off risk might be heightened in the case of the reproduction of products in particular, given the number of years that consumers have been exposed to active product placement in other media, such as film. This may increase the likelihood of an assumption that the “virtual” reproduction of a real-world product in VR is a similar form of authorised use of the likeness of that product. A finding of passing off based on a similar rationale to that applied by ►



the Court of Appeal in the Irvine v Talksport case certainly could not be ruled out.¹¹

In the UK, copyright is less likely to be an issue. The “closed list” approach to the categorisation of protected works in this jurisdiction significantly limits the extent to which copyright might be said to exist in everyday functional items. Section 51 CDPA also operates to exclude from infringement the making of an article to a design document (in which copyright may subsist as a graphic work) or copying an article made to such a design for anything other than an artistic work. That said, copyright may nevertheless subsist in certain aspects of “everyday” items, such as the pattern applied to the surface of a product, as well as logos that may or may not also be the subject of trade mark protection. So, the consideration of copyright cannot be entirely ruled out.

POPULATING THE LANDSCAPE

An otherwise “realistic” VR world featuring real-life places and “things” would be a lonely place if not populated by other people to interact with. So, what if “real-life” people were also reproduced in VR?



As VR technologies become ever more mainstream they also create opportunities for rights holders

English law does not recognise “personality rights” as such, though the decision in Irvine might well form the basis of a claim in passing off to the extent that the inclusion of a likeness of a well-known individual gives the impression of endorsement of the VR “world” by that person. While straying somewhat out of the realm of IP, it is foreseeable that the way in which such a character interacts with users could also

give rise to other issues under defamation laws.

EXCITING OPPORTUNITY

There are many reasons why reproducing the world around us in VR is an attractive proposition and continuing improvements in VR technology mean that the ability to experience digital versions of far-flung destinations is now a very “real” and exciting possibility.

And, although this article has focused largely on risks, as VR technologies become ever more mainstream they also create opportunities for rights holders. This may be by making reproductions of works accessible to a much wider audience, or by offering further opportunities for consumer engagement and interaction with products and brands. Only time will tell whether these opportunities become reality. ●



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11. Irvine & Ors v Talksport Ltd [2003] EWCA Civ 423

A 'FRESH' PERSPECTIVE ON DEFICIENT PLEADINGS

Rebecca Anderson-Smith enjoyed a full day's learning on litigation

Litigation took centre stage at CITMA's latest full-day seminar, where experienced litigation solicitors offered expert advice on how to manage trade mark and design litigation cases.

Roland Mallinson, a partner in the IP and media group at Taylor Wessing, opened the day by asking delegates to review a fictitious claim form with particulars of claim. The imaginatively named "Mallinson's Mints" had issued proceedings for trade mark infringement and passing off in respect of its mint brand. However, as it soon became clear, the brand's attorneys' attention to detail left much to be desired.

Criticisms coming from delegates ranged from basic formality points, such as failing to identify the defendants adequately, to more significant omissions, including the absence of a properly pleaded passing off claim.

After the group reported on its own findings, Roland shared his tips for preparing statements of case:

- Clearly identify who owns each right being asserted and in what capacity each claimant can bring proceedings.
- Identify the geographical scope of each trade mark registration relied on and set out the list of goods and services with reference to the correct Nice classification.
- Omit irrelevant marks.
- Serve copies of important

documents referred to along with the statement of case, enclosed in chronological annexes. Translate foreign-language documents.

- Some detail may be necessary in relation to allegations that goods or services are similar.
- When pleading passing off, make sure the "holy trinity" of (i) goodwill, (ii) misrepresentation

“

Roland cautioned against jumping into applications for strike out and summary judgment

and (iii) damage are specifically pleaded.

- Be precise about which defendant has committed which act(s) of infringement and passing off.
- If claiming that defendants are jointly liable, explain why.

The delegates then discussed how they would advise the defendants in light of the claimant's defective pleadings. One option considered

was an application for strike out. The court may strike out all or part of a statement of case: (i) if it appears that the statement of case discloses no reasonable grounds for bringing or defending the claim; (ii) if the pleadings present an abuse of court process; or (iii) if there has been a failure to comply with a rule, practice direction or court order. The delegates also discussed whether an application for summary judgment would be appropriate.

However, Roland cautioned against jumping into applications for strike out and summary judgment where, although defective, the pleadings can still be understood. Instead, he suggested considering a request for further information under CPR Part 18, or asking the other party to amend its statement of case (CPR 17). These options give the other side an opportunity to strengthen its case and allow you to understand the full extent of the case to be answered. This means avoiding the time and expense involved in applications that have little prospect of success.



Rebecca Anderson-Smith

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STAND AND DELIVER

Aaron Wood, one of 2018's most active advocates, provides the latest UK IPO appearance analysis



The statistics related to appearances in 2018 reflect a drop (9 per cent) in the number of oral hearings compared with 2017. However, there was

a rise in the total number of cases. In 2017, the top five representatives contributed approximately 18 per cent of all appearances before the UK IPO – the top 10 contributing 31 per cent – and the top 10 firms contributed 27 per cent of all the appearances. This has been broadly replicated, with figures for 2018 of 21 per cent, 31 per cent and 31 per cent respectively.

Also, in 2017, only 22 firms participated in 10 or more hearings for the previous five-year period (ie an average of two per year or better). This has gone up to 27 firms, which suggests that several firms are tending to take more cases to a hearing.

The 2017 statistics also showed that only 48 UK firms had an average of one case a year or better, and this remains the case when we look at the last 10 years. The mean number of cases per firm in the period 2010 to 2017 is 5.3 over the entire 10-year period, with approximately 43 per cent of the firms who appeared in that period only appearing once. Over the last five years, approximately 50 per cent of the firms that have appeared have

2018: MOST APPEARANCES

Firm: Wood IP
Barrister: Charlotte Blythe, Hogarth Chambers
Trade Mark Attorney: Aaron Wood, Wood IP

2014–2018: FIRMS MAKING MORE THAN 10 APPEARANCES

Firm	Number of appearances
Stobbs IP	31
Beck Greener	24
D Young & Co	23
Haseltine Lake	23
CMS Cameron McKenna Nabarro Olswang LLP	23
Wood IP	23
Bird & Bird	19
Swindell & Pearson	19
Marks & Clerk	18
Withers & Rogers	18
HGF	17
Wilson Gunn	17
Potter Clarkson*	16
Cleveland Scott York	15
Boult Wade Tennant	15
Kilburn & Strode	14
UDL	14
Squire Patton Boggs	13
Mewburn Ellis	12
Fieldfisher	11
Groom Wilkes & Wright	11

* Includes appearances attributed to Wildbore & Gibbons, following its acquisition



“ Looking more broadly at UK practice, it is difficult to speculate on likely activity post-March 2019, but firms may well be dealing with much more UK contentious work

2014-2018: TOP 10

Trade Mark Attorney/solicitor appearances – five years

Rank	Name	Firm	Total
1	Julius Stobbs	Stobbs IP	28
2	Aaron Wood	Wood IP	23
3	Ian Bartlett	Beck Greener	14
=	Martin Krause	Haseltine Lake	14
5	Barbara Cookson	Filemot Technologies	9
=	Kate McCormick	Trade Mark Direct	9
7	Rowland Buehrlen	Beck Greener	8
=	Alan Fiddes	UDL	8
=	Kieron Taylor	Swindell & Pearson	8
10	Chris McLeod	Elkington & Fife	7

2014-2018: TOP 10

Barrister appearances – five years

Rank	Name	Chambers	Total
1	Charlotte Blythe	Hogarth Chambers	33
2	Tom St Quintin	Hogarth Chambers	31
3	Jonathan Moss	Hogarth Chambers	30
4	Simon Malynicz QC	Three New Square	29
5	Amanda Michaels	Hogarth Chambers	24
6	Michael Edenborough QC	Serle Court	19
7	Philip Harris	—	17
8	Chris Aikens	11 South Square	14
9	Michael Hicks	Hogarth Chambers	13
=	Andrew Norris	Hogarth Chambers	13

Ashton Chantrille (8 New Square), Christopher Hall (11 South Square) and Benet Brandreth QC (11 South Square) also made 13 appearances

appeared only once, and not all firms are represented on the list.

Over the same 10-year period, only 40 people have appeared on average more than once per year, of which only 10 are not counsel. It increases to 50 people if we only look at the last five years (all but 16 being counsel). The statistics would suggest an uptick in work, but that it is a few firms doing substantially more than in the past, while the remainder of firms have backed away.

When one looks at the split between counsel and solicitors/Trade Mark Attorneys, it has changed from 60:40 in favour of counsel to 52:48 in favour of counsel.

FUTURE FORECAST

Looking more broadly at UK practice, it is difficult to speculate on likely activity post-March 2019, but firms may well be dealing with much more UK contentious work. UK IPO proceedings offer the opportunity to exercise contentious skills in a more forgiving environment than the courts. Even if many “new” cases are decided on paper, overall that would be likely to lead to more oral hearings, which will provide either an opportunity for attorneys to practise those skills or a challenge in trying to find counsel with experience of UK IPO proceedings. ●

All data presented is based on the calendar year. Raw data collected from the UK IPO.



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WHO'S ALONG FOR THE RIDE?

Chris McLeod digs into the IP rights interests in the world's volatile digital currencies

It has been a bumpy ride for cryptocurrency investors in recent months. According to *Forbes*, the “bad old days of the crypto rollercoaster” have returned.¹ So, with the viability of bitcoin and its digital brethren now becoming somewhat precarious, it seemed timely to take a look at who holds the IP reins of cryptocurrency brands – and in relation to what activities – with a focus on the UK, EU and US registers.

Having undertaken this review, an unexpected point arose immediately. Wikipedia records bitcoin as the world's first cryptocurrency, and BITCOIN is registered as an EU trade mark (EUTM) under No 010103646 in classes 9, 35, 38 and 42 in the name of bitFlyer, Inc, a Japanese company. The same company also owns a later WIPO international registration for the same mark in class 9, which designates the EU. The bitflyer.com website indicates that the owner operates a trading platform in relation to bitcoin, which makes it interesting that neither registration covers class 36/financial services. There are indications that at least the WIPO registration initially

covered class 36 and that the class and services have been deleted from some designations, including the EU designation.

The picture with regard to ownership of the word BITCOIN for what would appear to be the core services is therefore unclear, although the UK and EU trade mark registers seem to show a pattern of acceptance of class 36 applications for marks including the word in the name of various different entities, meaning that the word is now considered descriptive and non-distinctive for such services. There are also several applications and registrations for BITCOIN marks covering cosmetics, clothing, drinks and smokers' articles.

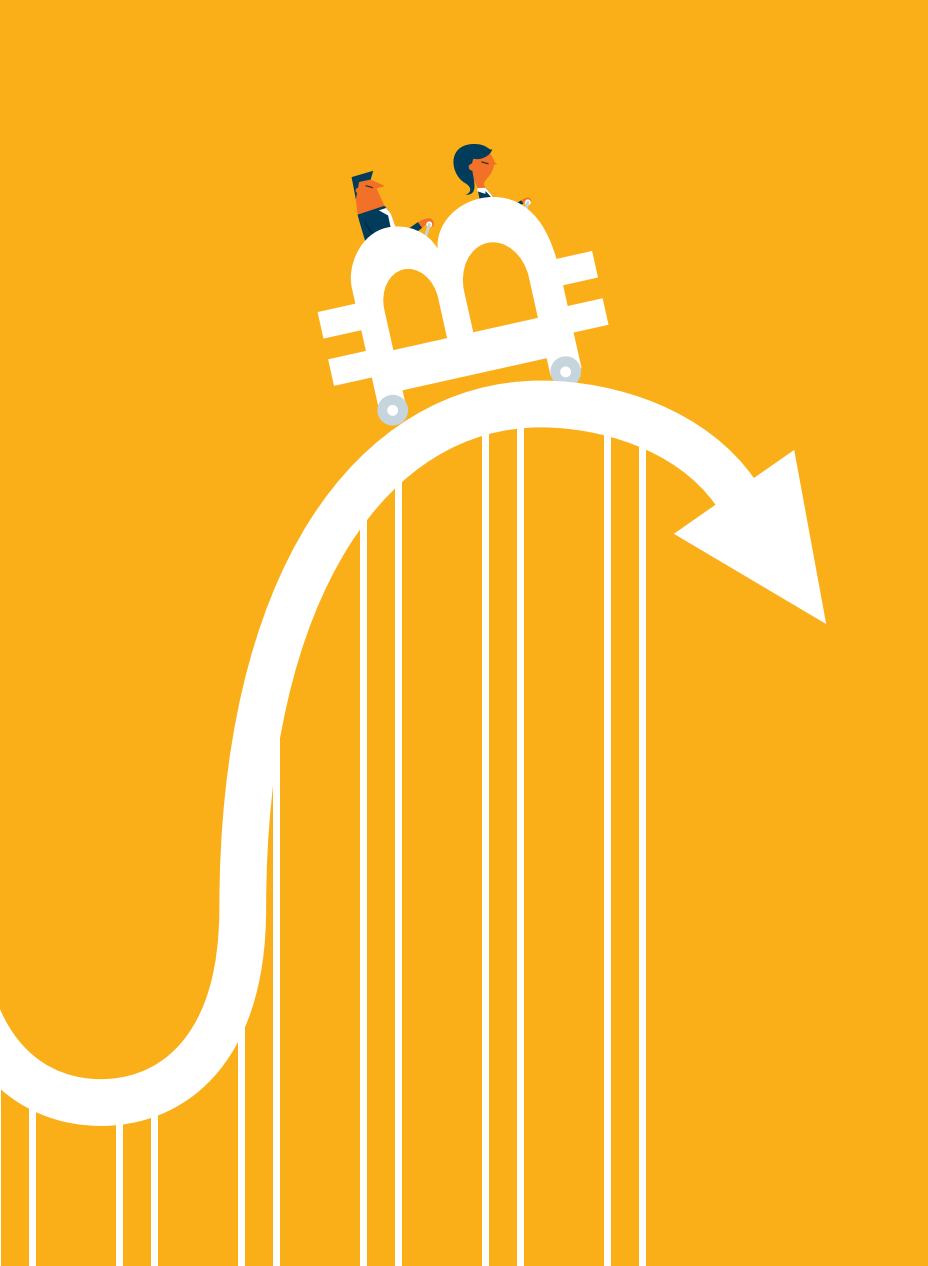
Other primary cryptocurrency brands are Ethereum, Ripple, Dash, Cardano, Stellar, EOS, NEO and Litecoin. So who owns these? And are they registered as trade marks?

EU AND UK ROUND-UP

Stiftung Ethereum, based in Switzerland, owns an EUTM registration for the ETHEREUM mark. However, the registration does not cover class 36. There is also a UK registration for a logo mark

containing the words “ethereum classic”, owned by Stanley Arthur Bernard, an individual based in Glasgow, and a WIPO international registration for ETHEREUM designating the EU. While the owner of the EUTM registration appears to have a connection with the cryptocurrency and owns various US trade mark registrations for ETHEREUM, it is not clear that the owners of the UK registration and international registration have any such connection.

Ripple Labs, Inc, based in California, owns a UK registration for the RIPPLE mark in class 36 and others, and a WIPO registration designating the EU and possibly other territories. On its website, Ripple Labs describes its offering as “the world's



appear to have a connection with these cryptocurrencies.

US BRANDS ARE BUSIER

Cryptocurrency branding in the US appears to be more active. Wikipedia provides a list of the most notable for-profit companies, which include BitGo, BitPay, Bittrex, Blockstream, BTCS (Bitcoin Shop, Inc), Coin.co, Coinbase, CoinDesk, Digital Asset Holdings, Gemini, Kraken, LibertyX, Poloniex, R3, Tidbit and Circle. Typical services include wallet provision, bitcoin exchanges, payment and venture capital, mining pools, cloud mining, peer-to-peer lending, exchange-traded funds, over-the-counter trading, gambling, micropayments, and affiliates and prediction markets. Notably, in 2014, Coin.co, a bitcoin payment processor, partnered with a US law firm and a US college to accept bitcoin payments.

The US trade mark registration strategy for these companies tends to show a no-nonsense approach to protection. The majority either own US trade mark registrations or have at least attempted to file for protection. Some of the more savvy players secured registrations from as early as 2011, while others left things rather late in the day.

The specifications provide further interest, with many including the expected classes 9 and 36, and a few including class 42. Only newer specifications mention “bitcoin”, “blockchain” and “cryptocurrency”. It can only be assumed that, in 2011, the popularity and knowledge of cryptocurrency was not where it is today, and the USPTO may have queried the inclusion of such terms in a trade mark specification.

US registration activity for some of these notable crypto companies includes the following:



BITGO

BitGo, a blockchain security company that was founded in 2013, offers a

[1. forbes.com/sites/forbescoaches/council/2019/01/08/what-bitcoin-needs-now/#7328d75f150d](https://www.forbes.com/sites/forbescoaches/council/2019/01/08/what-bitcoin-needs-now/#7328d75f150d)



only enterprise blockchain solution for global payments”.

Regarding LITECOIN, there appears to be a trade mark spat in progress. Litecoin Exchange Ltd, a UK company, applied to register LITECOIN/litecoin in the UK as a series of two marks in December 2017. The Litecoin Foundation Ltd, a Singapore-registered company, has opposed the application. It applied to register Litecoin/LITECOIN in the UK as a series of two marks in February 2018, and Litecoin Exchange Ltd opposed the application. The first opposition is currently suspended and it appears that the Applicant’s defence is the next step in the second opposition. The website [litecoin.com](https://www.litecoin.com) is operated by The Litecoin Foundation Ltd, but, beyond that, it

is difficult to speculate as to how the oppositions will play out.

MISSING THE MARK

There appear to be no UK or EU trade mark registrations of relevance related to DASH, which, according to dash.org, offers “a revolutionary digital money system”. While there is a class 36 EUTM registration for CARDANO in the name of Cardano Risk Management BV, this appears to have no connection with the cryptocurrency. Similarly, a class 36 UK registration for STELLAR in the name of Stellar Asset Management Ltd appears to have no connection with the cryptocurrency. And while the registers show a large number of registrations in class 36 consisting of or containing EOS and NEO, none

multi-signature bitcoin wallet service through which “keys” are divided among a number of owners to manage risk. BitGo, Inc owns two US word mark registrations for BITGO: one in classes 9 and 36, and the other in class 42, both filed on 25th July 2013. Class 36 covers “monitoring transactions” and class 42 covers “providing temporary ... non-downloadable software for automated and customized financial management”. The class 36 application was eventually registered on 18th October 2016, while the class 42 application achieved a much quicker registration on 23rd September 2014. As use in US commerce is claimed from January 2014, BitGo appears to have wasted no time in consulting a Trade Mark Attorney.



BITPAY/bitpay

BitPay, a global bitcoin payment service provider founded in May 2011, provides bitcoin and Bitcoin Cash payment processing services for merchants. BitPay became the first bitcoin company to sponsor a North American sports event, and, in May 2016, it launched the BitPay Visa Prepaid Debit Card, the first prepaid Visa debit card available for bitcoin users in all 50 US states. There are three registrations for bitpay and BITPAY in various forms, with two owned by BitPay, Inc and one assigned to “BIT-PAY LLC LIMITED LIABILITY”.

The first registration, and the earliest filing date among these examples, is for the BitPay logo, filed on 1st August 2011 and registered on 10th July 2012. Coverage is for class 9: “computer software, namely, electronic financial platform that accommodates multiple types of payment and debt transactions in an integrated mobile phone, PDA, and web based environment”. Use in commerce of this particular logo is claimed from 31st July 2011. Clearly, BitPay, Inc wasted no time in securing registered trade mark rights, although the registration has since been assigned to Bit-Pay LLC Limited Liability.

A second registration, for the word mark BITPAY, was filed on 28th February 2014 and registered on 12th May 2015 for class 36: “merchant services, namely, payment transaction processing services”. Use in commerce is also claimed from July 2011. Therefore, BitPay, Inc may have been advised to register a word mark following the first application, to ensure broader protection.

The third US registration is for a stylised device mark covering identical class 36 services, also filed on 28th February 2014 and registered on 12th May 2015. Use in commerce of this particular version of the mark is claimed from 3rd February 2014, which again demonstrates that BitPay takes a no-nonsense approach to trade mark protection.

BITTREX

Bittrex is a “cryptocurrency exchange” company founded in 2013 by three former Microsoft “security professionals”. According to Wikipedia, Bittrex is the 13th-largest cryptocurrency exchange by daily trading volume and “renowned for the vast number of cryptocurrencies it lists”. Unsurprisingly, it has a good reputation for its security. However, in true crypto-anarchic fashion, Bittrex is not a regulated exchange under US securities laws.

The USPTO register shows one registration and one application owned by Bittrex, Inc. Interestingly for a company formed in 2013, the first application for the word mark BITTREX was not filed until 13th

February 2017; it was registered on 16th January 2018. The class 36 and 42 specifications for this registration provide an interesting comparison to the BITGO and BITPAY marks. Class 36 includes reference to now-familiar terms not used in the specifications back in 2011, namely “digitized assets ... bitcoins, cryptocurrency, digital tokens ... derivative contracts, virtual currency, and digital currency”. Use in commerce of the BITTREX mark for these services is claimed from 28th February 2014. It is surprising that a company formed by ex-employees of a brand goliath such as Microsoft left trade mark protection so late.

The second application for BITTREX, also filed on 13th February 2017, is based on an international registration and appears to be having less success. It was published on 3rd October 2017 and currently remains unregistered. The application covers class 9, “magnetically encoded debit cards”, and class 35, “financial intermediary services”.

COIN.CO

Coin.co, a “bitcoin payment processor” based in New York City and founded in 2014 by bitcoin entrepreneurs Alex Waters and Yifu Guo, allows businesses to accept bitcoin, yet receive US dollars. In 2014, it partnered with law firm McLaughlin & Stern and The King’s College, the first US college to accept bitcoin for payment. Coin.co was created under a “bitcoin company incubator” called Coin Apex. However, the company’s website currently greets visitors with a slightly ominous message: “We’ll be back. Get notified.”

There are other Coin.co type registrations coexisting on the USPTO register with no direct relation to cryptocurrency – eg registration No 1494028 in the name of COIN ACCEPTORS INC, active since 1987, covers class 9 “vending machines”. There is one application for COIN CO in the name of “COIN.CO SYSTEMS LLC LIMITED”, filed on 12th May 2014, in class 36 for: “electronic commerce and payment processor services, namely ... processing of digital currencies ... converting such payments to United States currency or other fiat currency, and electronic payment services

“
Recent Coinbase application activity shows an awareness of brand strategy and protection by updating and expanding specifications”

involving electronic processing of digital currencies". Use in commerce is claimed from February 2014. The representative happens to be Coinbase partner McLaughlin & Stern, which was unfortunately unable to return the favour; the application was abandoned on 20th October 2015, following publication on 19th May 2015. This may well have been the result of an opposition by Coin Acceptors, Inc, which owns a registration for COINCO, filed on 25th February 2016, claiming use in commerce from July 2013 for class 9 ("cashless payment transaction devices ... hardware and software ... for ... use with vending machines") and from May 2015 for classes 36 and 42 ("electronic commerce and payment processor services").

coinbase

COINBASE

Coinbase is a "digital currency exchange" founded in 2012. Impressively, it brokers exchanges of bitcoin, Bitcoin Cash, Ethereum, Ethereum Classic and Litecoin with fiat currencies in around 32 countries, and bitcoin transactions and storage in 190. Wikipedia adds that, in 2014, Coinbase reached one million users, acquired the blockchain explorer service Blockr and the web bookmarking company Kippt, secured insurance covering the value of bitcoin stored on its servers (which should come in handy at the moment), and launched the vault system for secure bitcoin storage. In 2014, the company formed partnerships with Overstock, Dell, Expedia, Dish Network and Time Inc, allowing them to accept bitcoin payments. The company also provided bitcoin payment processing capabilities for Stripe, Braintree and PayPal. In January 2015, Coinbase received a \$75m investment, led by Draper Fisher Jurvetson, the New York Stock Exchange, USAA and several banks. The company has also launched a US-based bitcoin exchange for professional traders called Coinbase Exchange, rebranded to Global Digital Asset Exchange (GDAX) in 2016, and offering ether, the value token of Ethereum, for trade to professionals.

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future*”

There are four applications and four registrations for COINBASE in the name of Coinbase, Inc, including one for the COINBASE EXCHANGE logo, making the company the most prolific filer of the companies we researched. The four applications were filed as recently as August 2018 and cover a broad range of financial services relating to cryptocurrency (or "digital currency") in class 36, together with related software goods in class 9 and related services in class 42. There is even a focus on class 36 "management of digital asset mutual funds" and "securities" in application No 88090651. Coinbase, Inc already owns registrations dating from 6th December 2013 (with use of commerce claimed from 18th May 2012) for the marks COINBASE and COINBASE EXCHANGE for various goods and services relating to "digital", "fiat" and "virtual" currency in classes 9, 36 and 42.

Therefore, recent application activity shows an awareness of brand strategy and protection by updating and expanding specifications. This is one bitcoin company that appreciates the value of registered trade marks and appears to defend its rights. Notably, the one dead application for "coinbase" (No 79191376), filed on 3rd February 2016 in classes 9, 35, 36, 38 and 42 by Japanese company bitFlyer, Inc (which also owns the EUTM registration for BITCOIN),

was abandoned on 21st June 2018, most likely as the result of an opposition by Coinbase, Inc.

Further applications filed by Coinbase, Inc on 11th May and 29th July 2016 for its rebrand of COINBASE EXCHANGE to GDAX appear to have been unsuccessful, with both abandoned on 19th and 21st June 2018. However, Coinbase, Inc had better luck with registering the less catchy GLOBAL DIGITAL ASSET EXCHANGE on 31st October 2017.



ETHEREUM

There are 18 applications and registrations for the mark ETHEREUM and other combinations.² The picture with regard to ownership is messy, as there are recent applications filed by applicants with no connection to the owner of the earlier registrations, Stiftung Ethereum, which also owns the EUTM registration for ETHEREUM.

Stiftung Ethereum appears to own three registrations for the word mark ETHEREUM (Nos 5110579, 5401650 and 5646310) dating back to 19th May 2015, 26th July 2017 and 8th August 2017, with use in commerce ranging from December 2013 to 5th December 2014. Coverage includes the expected but rather broad class 9 ("software platforms for developing, building, and operating distributed applications"), together with more unusual coverage for "T-shirts" in class 25 and "educational services ... in the field of ... computer applications and blockchain software" in class 41. There is also an abandoned application (No 86359718) for a logo version, "ethereum", filed on 7th August 2014 in class 9 and abandoned on 9th December 2015.

However, various third-party applicants appear to have recently filed for ETHEREUM marks relating to cryptocurrency. For example, application No 88063927 for

² These include ETHEREUM CLASSIC LABS, CERTIFIED ETHEREUM EXPERT, CERTIFIED ETHEREUM SPECIALIST, CERTIFIED ETHEREUM PROFESSIONAL, ENTERPRISE ETHEREUM and ETHEREUM POINTS 

ETHEREUM CLASSIC LABS, filed on 3rd August 2018 in the name of Assets Bay Investments Ltd, covers class 36. Application Nos 88011134 and 88011131, filed on 22nd June 2018 in the name of John Souza, for CERTIFIED ETHEREUM SPECIALIST and CERTIFIED ETHEREUM PROFESSIONAL include class 41; and application Nos 87481873 and 87494429, filed on 9th June and 18th June 2017 in the name of Gene Riccoboni for ETHEREUM cover class 36.

This may be an indication that the word ETHEREUM is becoming descriptive of a specific type of cryptocurrency, which may make registration and enforcement difficult in the future.



RIPPLE

Ripple Labs, Inc owns three applications, two for the word mark RIPPLE and one combined word and device mark (shown above), filed on 22nd May and 7th June 2017 respectively, for goods and services relating to cryptocurrency in classes 9, 36, 38 and 42. All three applications were published on 12th June 2018.

CARDANO

As per the UK and EU registers, there is a class 36 registration for CARDANO in addition to a recent registration for the logo, in the name of Cardano Risk Management BV, neither of which appear to have any connection to cryptocurrency. Perhaps the owner of the cryptocurrency CARDANO does not see any value in registering a trade mark or is deterred by the risk of opposition from Cardano Risk Management BV to an identical mark in class 36.

EOS

The US register shows a large number of registrations consisting of or containing EOS, but none appear to have a direct connection with the cryptocurrency. The closest marks located are three abandoned applications (Nos 87486704,

87486782 and 87493053) for EOS as a word and logo, and EOS.IO in the name of “block.one limited company (Ltd)”, based in the Cayman Islands. All relate to class 42 for “developing open-source software which can be adopted by blockchains for ... building ... applications on the blockchain” filed on 13th and 16th June 2017, published 12th December 2017, and abandoned on 17th December 2018. Block.one limited company (Ltd) appears to be making another attempt with application No 88252885, filed on 7th January 2019, for EOS, this time including terms such as “promoting public awareness of blockchain technologies and cryptocurrency” in its class 35 and 41 specifications.



LITECOIN

There are four US applications for LITECOIN and LITECOIN COMPUTER on the USPTO register, three of which are dead/abandoned. The remaining live application (No 87730174), in the name of Long Invests LLC, was filed on 21st December 2017 and published on 8th May 2018. Class 36 includes various references to “currency trading” and “virtual currency”. The earliest application (No 85897410), filed in class 36 for “virtual currency” services on 7th April 2013 in the name of Anthony R Murgio, was abandoned on 24th January 2014, with no filing basis added to the application.



BITCOIN

Finally, as a comparison to the EUTM registration mentioned at the

start of this article, there are 50 applications and registrations on the USPTO register consisting of or containing BITCOIN. The majority cover a variety of goods and services with no relationship to cryptocurrency. However, a recent application was made for BITCOIN (No 88055293), filed on 27th July 2018, in class 36 for “cryptocurrency, namely, providing a digital currency or digital token for use by members of an on-line community via a global computer network”. The Applicant, Coin Legal Ltd, based in the UK, is claiming use in commerce from 12th January 2009. Considering that the word can now be considered descriptive for class 36 services, Coin Legal Ltd may have a difficult time, this late in the day, convincing the USPTO otherwise.

LAGGING BRANDS

For DASH and STELLAR there appear to be no US registrations of relevance. For NEO, while there is a large number of registrations consisting of or containing the name, none appear to have a connection to cryptocurrency.

CRYPTO CONCLUSIONS

Cryptocurrency often has a somewhat iconoclastic, if not anarchic, image associated with the objective of cutting banks out of the frame. However, at least some of the major players, particularly in the US, are aware of the importance of registering trade marks in order to protect their part of an unpredictable but growing market. The future of cryptocurrency is currently uncertain. However, the furious pace of change and the demands of modern consumers and investors in the digital age indicate that it should not be counted out yet. ●



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DESIGNING AN APPROPRIATE FILING STRATEGY

William Burrell reviews the use of registered designs in the context of figurative marks

When it comes to protecting a figurative mark, such as a logo, it is natural for trade mark protection to come to mind. This is as it should be, given the versatility and power of the trade mark regime.

There are some instances, however, where trade mark protection for a logo may not be possible, such as for a new logo that is yet to acquire any distinctiveness or goodwill. In such instances, one can, of course, rely on passing off or perhaps copyright to help protect the logo. But is there anything else that can be done? What about a registered design directed to the logo?

On first consideration, the use of a registered design to protect a

logo may sound inappropriate, given that registered designs are invariably associated with protecting the shape and appearance of a product. However, the breadth of the UK and EU design regimes is such that a logo can also be protected under them.

So, why might a registered design be useful, and in what situations might a registered design be worthy of consideration? One obvious application is for new logos that have yet to acquire distinctiveness, perhaps due to the dominant element being a verbal element that is considered to be descriptive. In such instances, a registered design can provide invaluable

interim protection for the logo until such time as corresponding trade mark protection can be obtained once the logo has acquired distinctiveness through use.

Noting that publication of a registered design can be deferred, registered design protection is also suited to owners wishing to obtain registered protection for a logo while not disclosing it to the public. A good example here would be for those considering multiple different logos for release. Here, all the logos can be applied for in a single design registration with deferred publication. If and when the logos have been finalised, the relevant design registration(s) can then be published. For reference, publication of a UK registered design can be deferred for up to 12 months from its filing date and, in the case of an



“
*Used correctly,
 registered designs
 can be a powerful
 tool in the protection
 of logos*”

EU registered design, for up to 30 months from its priority date.

The UK/EU registered design regimes also allow for fast registration within a matter of days. Particularly for important logos where simultaneous trade mark protection is being applied for, a registered design can provide valuable interim protection while a corresponding trade mark application is still pending.

There is also no opposition procedure for UK/EU registered design applications, which means a design registration can be obtained in these jurisdictions without objection from a third party.

Cost is another factor. The official fee for a UK registered design is £50, compared with £170 for the cheapest UK trade mark registration. The corresponding official fees for an EU

design and EU trade mark are €350 and €850 respectively. Particularly compared with the cost of a trade mark applied for in several classes, the relative cost of a registered design is therefore marginal.

In terms of the scope of protection, whereas a trade mark is nominally restricted to particular goods or services, a registered design is enforceable against all product types (though services are excluded). Tying in with this, a trade mark can be revoked in cases of sustained non-use for goods/services covered by the trade mark registration. Such non-use provisions are not present under the UK/EU registered design regimes.

There are some drawbacks of registered design protection. The most notable is that a valid design registration can only be obtained for logos that have been publicly disclosed for less than 12 months.

Further, a trade mark has the potential to be renewed for an

unlimited duration, compared with a registered design, which is restricted to a maximum term of 25 years. That being said, in many sectors, 25 years will often be enough time to cover the life of a particular logo.

POWERFUL TOOL

The registered design regime is not by any means a substitute for strong trade mark protection. However, used correctly, registered designs can be a powerful tool in the protection of logos and other figurative marks.

Not least from the viewpoint of clearance searching, noting that the use of registered designs to protect logos is becoming increasingly prevalent, a comprehensive clearance search in respect of a figurative mark should ideally include relevant searches of the UK IPO and EUIPO design registries, in conjunction with any traditional searches of trade mark registers. ●



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PROBABLY THE MOST SPECIAL BENCH...

Ashwin Julka remarks on a boost to IP jurisprudence in India

For the first time, a special bench of five judges of the High Court of Delhi was recently constituted, to consider an IP suit. It was called on in the case of Carlsberg Breweries A/S v Som Distilleries & Breweries Ltd¹ to adjudicate on a seminal question of law (the maintainability of a composite suit in relation to infringement of a registered design and for passing off).

The matter began when Carlsberg, through Remfry & Sagar, instituted a suit against Som Distilleries that combined two separate causes of action – infringement of its registered design and passing off (of its trade dress) in respect of Carlsberg’s beer bottle and the overall get-up of the CARLSBERG mark. Som Distilleries, the Defendant, objected to the filing of a single suit. It placed reliance on a decision issued by a three-judge bench of the Delhi High Court in *Mohan Lal v Sona Paint*² where it was held that: “As the cause of action for a suit for infringement of a registered design is different from the cause of action on which a claim of passing off is premised, two separate suits have to be filed though, if filed at the same time, or in close proximity, they may

be tried together as there may be some aspects which may be common.” The judgment in the case of *Mohan Lal* was, in turn, premised on the case of *Dabur India v RK Industries*,³ in which the Supreme Court held that two different causes of action cannot be combined in one single suit when the court lacks jurisdiction to entertain any one of the causes of action.

Remfry & Sagar contended that the decision rendered in *Mohan Lal* was *per incuriam*. To begin with, referring to *Dabur India*, we pointed out that under the Indian Code of Civil Procedure (CPC) a plaintiff can sue a defendant at the place where the cause of action arises or where the defendant resides and/or carries on business. However, both the Indian trade marks statute and the Indian copyright statute provide plaintiffs with the benefit of an additional forum. That is, they also permit filing a suit for trade mark and/or copyright infringement at the place where the plaintiff resides or carries on business.

Dabur India addressed a situation in which a plaintiff taking advantage of such an additional forum filed not only a suit for infringement, but also a second cause of action – that of passing off – in the same suit. Now, if the court before which the said





suit was filed had territorial jurisdiction only to try the first cause of action, and not the second (governed as it was by the CPC), under the Supreme Court ruling, both causes of action could not be clubbed into one suit. This would amount to conferring jurisdiction on the court where it had none.

It was further put forward by Remfry & Sagar that such a dichotomy in jurisdiction was not possible in the case of suits involving design violations, since, under the Indian designs statute, no additional forum is provided to a plaintiff. Just as in the case of passing off, a suit for design infringement could only be initiated where the cause of action arose or the defendant resided/carried on business. In light of this, the Dabur India ruling did not fit the facts of the present case.

Extensive arguments were also addressed to assert that the decision rendered in Mohan Lal required reconsideration in light of Order II Rule 3 of the CPC. This provision explicitly permits a plaintiff to unite in the same suit several causes of action against the same defendant(s). Further, Order II Rule 6 of the CPC allows the court a remedy if it appears to the court that such joinder of causes of action may delay the trial or is otherwise inconvenient. The court can order separate trials of the claims, confine the action to some causes of action and exclude the others or order the plaintiff to elect which cause of action will be proceeded with.

Based on the aforesaid, Remfry & Sagar argued that a composite suit involving two causes of action was maintainable, subject to the court being vested with jurisdiction to entertain both causes. It also argued that under no circumstances could the court reject and/or dismiss such a composite suit or order two separate suits to be filed.

SECOND LOOK SANCTIONED

The single judge analysed the submissions made, felt the decision issued in Mohan Lal required a second look and referred the matter to the Chief Justice of the High Court of Delhi, who then constituted a five-judge bench to decide the issue. This special bench held that the basic

facts that impel a plaintiff to approach a court of law complaining of design infringement are the same facts that would impel a case of passing off. Thus, in such circumstances, it is inconceivable that a cause of action be split in some manner and presented in the form of two separate suits.

COMMON CAUSE

The bench reasoned that, as action related to infringement of design and passing off would arise from the “same transaction of sale”, common questions of law and fact would be presented, and thus joinder of causes of action “ought” to be done. Thus, the bench overruled the Mohan Lal decision to hold that a composite suit that joins two causes of action – one for infringement of a registered design and the other for passing off – is maintainable. It also made clear that “there is no per se or threshold bar to maintainability of suits, on the perceived grounds of misjoinder of causes of action”.

This landmark judgment, delivered on 14th December 2018, has enormous precedential value in terms of both law and procedure. It has been held that, because common questions of law and fact exist between the two causes of action of infringement of a registered design and passing off, the evidentiary requirements of both causes will be common – thus, joinder of both the causes of action against the same defendant in one single composite suit is permitted.

Insofar as procedure is concerned, the requirement to file separate suits would no longer apply, and a composite suit can be filed. Multiplicity of proceedings, in the opinion of the bench, would only result in a waste of time, money and energy for parties, as well as for the courts. In contrast, a composite suit would enjoy the advantage of a “bird’s eye” view. ●

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In the
opinion of
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and energy

1. CS (COMM) 690 of 2018
2. 2013 (55) PTC 61 (Del) (Full Bench)
3. 2008 (10) SCC 595



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A serie-ous case for Cadbury

Mark Caddle finds some tasty takeaways from the latest colour clash

Cadbury UK Ltd is the proprietor of UK trade mark registration No 2020876A (the Mark), filed on 19th May 1995 and registered on 13th November 1998. The mark protected is presented as a purple square (shown bottom right, page 27). The description provided at the time of filing was simply that “the mark consists of the colour purple”. Initially, the application claimed protection for a variety of goods and services in classes 29 and 30. It was subsequently limited to “chocolate in bar or tablet form” in class 30. Evidence exemplifying the extent of use of the colour purple by Cadbury was a determinative factor in the UK IPO accepting the mark for registration.

MARK DESCRIPTION

On 2nd April 1997, the UK IPO published its Special Notice on Colour Trade Marks, which required colour mark applicants to provide a suitably clear description of the colour constituting their mark. After toing and froing with the UK IPO, Cadbury settled on the following:

“The mark consists of the colour purple (Pantone 2685C) as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods.” (emphasis added)

Interestingly, this final wording was stipulated by the UK IPO and not instigated by Cadbury, which had unsuccessfully proposed this description:

“The mark consists of the colour purple as shown applied to the packaging or labelling of goods covered by the registration.”

CLAIM OF SERIES

The issue in this latest decision is whether Cadbury’s Mark constitutes a series of marks pursuant to s41 of the UK Trade Marks Act 1994 (the Act).

On 5th June 2014, Cadbury wrote to the UK IPO to claim that its Mark is a series. Rule 28(5) of the Trade Mark Rules 2008 permits the deletion of a mark in a series. Cadbury asserted that the Mark comprised a series of two marks, based on the content of the aforementioned description:

- Mark (a): the colour purple (Pantone 2685C) applied to the whole visible surface of the packaging of the goods; and
- Mark (b): the colour purple (Pantone 2685C) being the predominant colour applied to the whole visible surface of the packaging of the goods.

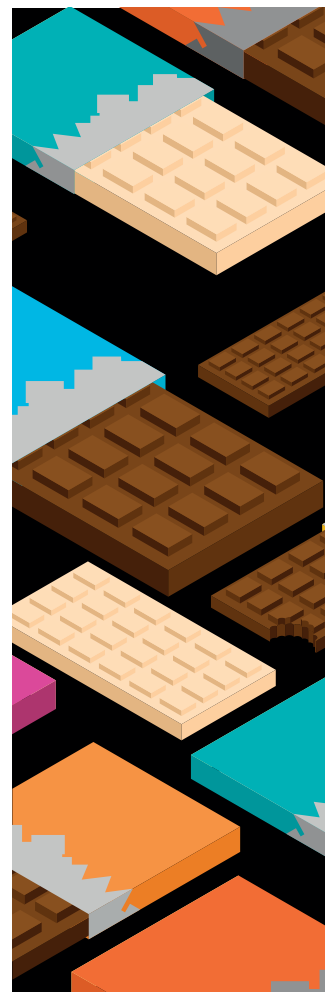
Cadbury wished to delete alleged Mark (b) from the series due to the opposition brought by Nestlé to Cadbury’s later trade mark application, No 2376879, also in respect of the colour purple and with the same description. Nestlé’s opposition was ultimately successful before the Court of Appeal ([2013] EWCA Civ 1174, Cadbury 1). Nestlé submitted third-party observations in this case and was party to the proceedings as Intervener.

UK IPO ANSWER

The UK IPO refused Cadbury’s request to acknowledge the Mark as a series. It did not accept that the wording of the description resulted in the Mark being a series. Also, pursuant to s44 of the Act, it was noted that registered trade marks cannot be altered.

The UK IPO’s decision to refuse the deletion of the predominant colour wording, alleged Mark (b), was upheld by the High Court.

“ *The decision provides clear guidance on the treatment of series marks and the requirement for clarity and precision* ”





The UK IPO noted that Rule 28(5) could not be relied on, as there was no application to register a series of marks. Notably, Cadbury had not completed the section of Form TM3 specifying the Mark was to be treated as a series. Further, the UK IPO noted that a request for deletion must relate to a trade mark, and the alleged Mark (b) did not fall within the definition of a trade mark (it was not an appropriate graphically represented “sign”, as confirmed in Cadbury 1). Finally, a registered mark cannot be altered, and the request conflicted with the s44 restrictions on amending registered marks.

Mr John Baldwin QC agreed that the series mark requirements were not made out. Cadbury appealed.

COURT OF APPEAL

In its decision of 5th December 2018, the Court of Appeal (CoA) dismissed the appeal. Lord Justice Floyd, in his leading judgment,

concluded that Cadbury had applied to register a single mark and not a series. The CoA noted that Cadbury had relied too heavily on the presence of “or” in the Mark’s description to provide the interpretation that there was a valid series. Floyd LJ preferred to rely on the linguistic indications as a whole in the description. He cited the wording “the mark consists of the colour purple” in concluding that this was an attempt to register one mark only.

Even if allowed as a series, the predominant colour wording in alleged Mark (b) could cover uses of the colour purple in “extravagantly different ways”. This would fall foul of s41’s requirement that marks in a series must not differ materially or create different identities.

Cadbury also put forward an alternative argument on appeal, namely that: the Mark is a permissible registration of more than one mark within a single registration, even if not a qualifying series; and the alleged Mark (b) was a separate trade mark registration (not simply the second mark in a series). It was held to be out of hand to allege that there are other means to protect a number of marks within a single registration other than by way of the series provisions.

CLEAR WARNING

Cadbury’s claim was founded on the description imposed by the UK IPO. The CoA expressed some sympathy with this and noted that it had been Cadbury’s adherence to the UK IPO’s Guidelines that gave rise to the potential to argue the series point regarding its Mark’s description.

Nevertheless, the decision provides clear guidance on the treatment of series marks and the requirement for clarity and precision when applying for trade mark monopoly rights. For the most part, using a series registration to cover up to six marks that do not alter in their materiality is a non-contentious procedure, but this case illuminates the ability for creative arguments to test the practices of the UK IPO. However, with Cadbury’s loss comes a clear warning to others trying to make more of the series registration procedure than is permitted.

KEY POINTS

- + Cadbury’s adherence to the UK IPO’s Guidelines gave rise to the potential to argue the series point regarding its Mark’s description
- + The decision provides clear guidance on the treatment of series marks and the requirement for clarity and precision when applying for trade mark monopoly rights
- + Cadbury’s loss is a clear warning to others trying to make more of the series registration procedure than is permitted

UK TRADE MARK
REGISTRATION
NO 2020876A



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Red Bull knocked back

The court noted marks were of a different species, reports Jade MacIntyre

The Claimant in this case manufactured and distributed the well-known energy drink Red Bull. It was the proprietor of several registered trade marks in class 32, including the mark shown below right, top (Red Bull's Mark).

The first Defendant (D1) imported into and sold in the UK energy drinks bearing the name Big Horn, a sample of which is shown below right, middle.

The second Defendant (D2) distributed D1's Products in Bulgaria. The third Defendant (D3), a Bulgarian citizen, was the director and sole shareholder of D1. He was also the owner of the domain name bighornenergy.co.uk, on which D1's Products were advertised.

On 23rd August 2016, D2 applied to EUIPO for registration of the mark shown below right, bottom, featuring the name Big Horn in class 32 (D2's Mark). This application was opposed by Red Bull on 7th November 2016 under Articles 8(1)(b) and 8(5) of Regulation (EU) 2017/1001 (EUTMR).

On 6th February 2018, Red Bull issued proceedings under the Shorter Trials Scheme against the Defendants for infringement of Red Bull's Mark contrary to Articles 9(2)(b) and 9(2)(c) EUTMR. No claim was made for passing off.

On 23th February 2018, D3 filed acknowledgments of service of D1 and D3, stating an intention to defend the claim. On 13th March 2018, it filed Form F9D. This incorporated a document dated 7th March 2018 entitled "Defence" (the D1/D3 Defence).

FIRST APPLICATION

Relying on *Almond v Medgolf Properties Ltd* [2015] EWHC 3280 (Comm), on 8th June 2018, Red Bull applied for judgment in default against D2 on the grounds that D2 had failed to file an acknowledgment of service.

On 6th August 2018, without a hearing, the Court granted a retrospective order for service by alternative means, which provided that the steps already taken by Red Bull to bring the claim form to D2's attention were deemed good service and that the deemed period for D2 to file an acknowledgment of service or defence had expired on 7th May 2018. Master Clark ruled that this order had been made on the basis that it would not prejudice any rights accrued before the order was made, namely D2's opportunity to defend itself.

Further, on 2nd March 2018, unknown to Red Bull, D2 had changed its registered office address in Bulgaria. The claim form and particulars of claim were delivered to D2's old address on 16th April 2018. The fact that D2's old address was its address as at the date of issue of the claim form (6th February 2018) did not validate it as an address for service when, by the date of service, it was no longer D2's address. Therefore, as at the date when the application was made (8th June 2018), D2 had not in fact been served.

For these reasons, Master Clark dismissed the application for default judgment.

SECOND APPLICATION

Master Clark next considered Red Bull's application dated 10th August 2018 regarding whether a number of procedural deficiencies on the part of the Defendants in the filing and serving of their defences to the trade mark infringement claim were sufficient for the purposes of striking out and/or summary judgment of the D1/D3 Defence.

This application was based on the following grounds under CPR 24.2 and CPR 3.4(2): (i) the Defendants had failed to comply with rules and practice directions; (ii) the Defendants' actions were likely to obstruct the just disposal of the



RED BULL'S MARK



SAMPLE OF D1'S PRODUCTS



D2'S MARK





“ Red Bull’s criticisms of the Defendants’ actions did not, in Master Clark’s judgment, constitute serious or significant breaches so as to justify striking out

The Court rejected these submissions and agreed with the Defendants’ arguments that the graphic elements of Red Bull’s Mark are dissimilar to those of the sign on D1’s Products, and there was therefore no likelihood of confusion or link between the marks.

The Court noted the dissimilarities between D2’s Mark – a mountainous landscape against the background of a sun/yellow circle, with two large-horned ibex starting to jump – and Red Bull’s Mark, in which two small-horned bulls move towards each other in black and white. The Court also agreed with the decision of EUIPO’s Opposition Division on 25th May 2018 rejecting Red Bull’s opposition to the registration of D2’s Mark, which stated that “the fact that two apparently different animals move towards each other is not sufficient for a finding of similarity”.

Master Clark therefore rejected Red Bull’s application, as the Court was: (i) not satisfied that the Defendants had no real prospect of defending the claim (for the purposes of CPR 24.2(a)(ii)); and (ii) satisfied that there was no likelihood of confusion (in respect of the claim under Article 9(2)(b)) and no link (in respect of the claim under Article 9(2)(c)).

Master Clark noted the regrettable extent to which the judgment had been lengthened by the determination of procedural points of little or no merit advanced by the Claimant in support of its strike-out application.

KEY POINTS

- ✦ The Claimant’s applications seeking judgment in default and to strike out, and/or summary judgment in respect of a number of defences to a trade mark infringement claim, were dismissed
- ✦ The Court was not satisfied that the Defendants had no real prospect of defending the claim
- ✦ The procedural deficiencies in the filing and serving of the defences were insufficient for the purposes of striking out

proceedings; and (iii) there were no reasonable grounds for defending the claim.

In relation to the first two grounds, Master Clark rejected Red Bull’s submissions. Red Bull’s criticisms of the Defendants’ actions did not, in Master Clark’s judgment, constitute serious or significant breaches so as to justify striking out. Master Clark therefore dismissed Red Bull’s application, finding that it would be wholly disproportionate to strike out the D1/D3 Defence for the procedural breaches of the kind submitted by Red Bull.

As to the similarities between D2’s Mark and Red Bull’s Mark (and the absence of a likelihood of confusion or link), Red Bull’s counsel submitted that there were clear visual and conceptual similarities between Red Bull’s Mark and D2’s Mark. The average consumer for such products is the general public, who exercise a relatively low level of attention when purchasing such items, which seek to attract customers using visual cues.



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Easyjet's claim fails to take flight



Ben Evans explains the role of targeted marketing in this decision

In this case, EasyGroup Ltd, the proprietor of numerous “easy-” prefixed registered trade marks, including EASYFLIGHTS for various classes, including class 39, was granted permission to serve infringement proceedings against two Defendants located in Bangladesh. The Defendants were Easy Fly Express Ltd (D1) and Mr Saber Chowdury (D2), and the action related to use of the mark EASY FLY within the domain easyfly-express.com and use of a logo including the wording EASY FLY EXPRESS, both in relation to airline cargo services. It was alleged by EasyGroup that D2, as the Chairman of D1, was the guiding mind behind D1.

In September 2017, the Defendants applied to the Court for an order that the English courts did not have jurisdiction to hear the claim or, alternatively, that they should not exercise any jurisdiction that they may have. In considering the Defendants’ application, Mr Justice Arnold referred to the case of AK Investment CJSC v Kyrgyz Mobile Tel Ltd [2011] UKPC 7 and the basic criteria that EasyGroup would be required to establish to serve out of the jurisdiction, namely that:

- there is a real prospect of success on the claim;
- there is a good arguable case that the claim against the foreign defendant falls within the classes of cases for which leave to serve out of the jurisdiction may be given (often referred to as the gateways); and
- in all the circumstances, England is clearly or distinctly the appropriate forum.

Considering whether EasyGroup had a real prospect of success on the claim, Mr Justice

Arnold made reference to the commercial reach of the Defendants, the territories to which flights are chartered (Europe did not feature), the type of cargo being transported (primarily “live shrimp fry”) and the small size of the aircraft fleet. Mr Justice Arnold concluded that D1 had never served a European customer and had no intention to do so.

EasyGroup asserted that because D1’s website and Facebook page were written in English, the business targeted English-speaking consumers. Mr Justice Arnold dismissed this assertion, assessing English as the dominant language of websites generally and a language widely spoken in Bangladesh. In addition, neither D1’s website or its Facebook page made reference to UK or EU contact details, and internet searches brought up the website only when “Bangladesh” was included in the search terms.

In view of Mr Justice Arnold’s conclusion that the UK and EU consumer had not been targeted, EasyGroup was found to have failed in establishing a real prospect of success, and the Defendants’ application was upheld.

This decision highlights the need for trade mark owners to tread cautiously when considering the pursuit of a potential infringer for the use of marks online. It cements the position that, no matter the size of a business’s trade mark portfolio and the perceived goodwill associated with the same, a claimant must establish the direct targeting of specific groups of consumers within the jurisdiction in order to succeed with an infringement claim.

KEY POINT

- Online use of a mark by a business/ individual based outside the UK will not constitute use for the purposes of bringing infringement proceedings within the UK unless the claimant can demonstrate the specific targeting of UK consumers by the defendant

THE DEFENDANTS’ LOGO

EasyFly
EXPRESS



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Elizabeth Dennis, a Solicitor at Blake Morgan LLP, contributed to this article.

Leeds City FC shown red card

The Court wasn't disposed to see the Applicant's side, says Dale Carter

In June 2017, Leeds City Football Club Ltd (the Applicant), incorporated in 2003, applied to register the series of marks shown below right, covering classes 16, 25, 26 and 41. Leicester City Football Club Ltd (the Opponent) opposed under s5(2)(b), s5(3) and s5(4) of the Trade Marks Act 1994, based on its LCFC word mark registration covering identical goods and services. The Opponent also asserted bad faith under s3(6), although this claim failed due to lack of supporting evidence.

ESSENTIAL ELEMENT

While the device elements were important in the overall impression of the Applicant's mark, the LCFC element was likely to be the element pronounced by the average consumer. These letters were centrally positioned, were of a sufficient size to retain an independent, distinctive role, and constituted the dominant verbal element of the mark. The marks were considered to be visually, aurally and conceptually similar. The average consumer of the goods was considered to be the general public, whose level of attention would be normal. For the services in question, the average consumer also included businesses, and the level of attention of the average consumer was deemed to be above average. The goods and services would be selected primarily by visual means, although aural considerations would also play a role.

In finding that a likelihood of confusion existed under s5(2)(b), the Hearing Officer (HO) was mindful of there being no "right way round confusion", and it was inevitable that confusion would arise if the average consumer were to encounter the Opponent's mark after the Applicant's mark on identical goods.¹

No finding was made in relation to the opposition under s5(3) and s5(4).

The Applicant, which was not professionally represented, argued that there are various football clubs whose initials are LCFC. If this was an argument that LCFC was non-distinctive, the HO could not reach a finding on this issue in the context of the opposition and in the absence of supporting evidence. Indeed, the HO was required to find that the Opponent's mark possessed some distinctive character, merely as a consequence of its registration.²

“

Although the Opponent was successful in blocking registration, it is unlikely it would be successful in preventing use

which would weigh heavily against a finding of confusion.

Given that the goods and services were primarily selected by visual means and the level of attention of the average consumer was high, it is perhaps a little surprising that the LCFC element dominated the overall impression, rendering ineffective the "striking" and imposing visual elements in the Applicant's mark.



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KEY POINTS

- Visually complex trade marks incorporating an earlier identical mark may be deemed similar where the common verbal element forms a dominant part of the complex mark and the goods/services are identical
- Acronyms that have no obvious connection with the goods and services for which they are registered possess at least an average degree of distinctiveness

THE APPLICANT'S MARKS



- Comic Enterprises Ltd v Twentieth Century Fox Film Corporation [2014] EWHC 185 (Ch)
- Formula One Licensing BV v OHIM, Case C-196/11P

Success rode on second section

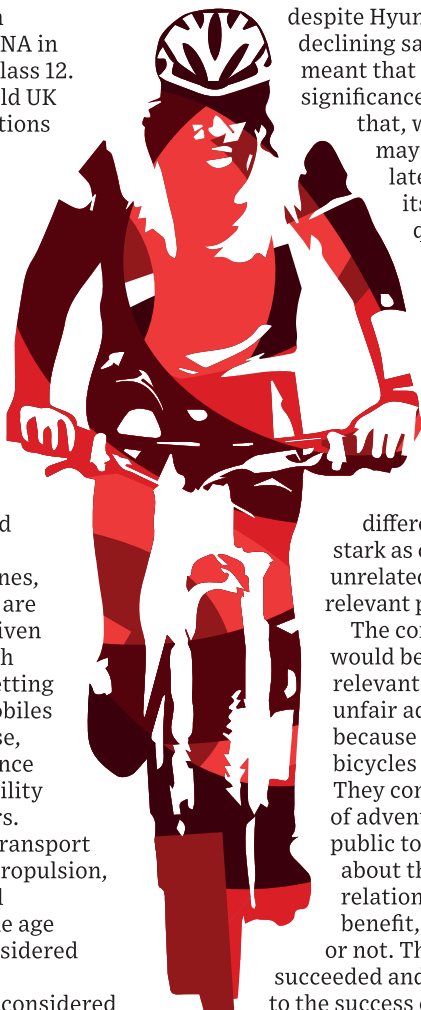
Kona's win highlights the importance of pursuing every avenue of opposition, writes Suzan Ure

Hyundai sought to obtain registration of the word KONA in relation to automobiles in class 12. However, KONA USA has held UK and EU trade mark registrations for KONA covering bicycles since 1990 and 1998 respectively, and had supporting evidence of use since registration. It opposed the registration on both s5(2)(a) and s5(3) grounds under the Trade Marks Act 1994.

Given the identical nature of the marks, the core question for the s5(2)(a) ground was whether automobiles and bicycles could be considered similar. Following previous case law and EUIPO guidelines, it was found that the goods are dissimilar. The reasoning given was that, although they both provide a mechanism for getting from place to place, automobiles have a more specific purpose, given their speed, the distance they can travel and their ability to carry multiple passengers. Further, the two modes of transport have different methods of propulsion, namely engine versus pedal power, such that, even in the age of e-bikes, they are still considered materially different.

The methods of use were considered to be neither complementary nor in competition and, despite evidence suggesting commonality of manufacturers and trade channels, they were still not similar and so were unable to support a likelihood of confusion. Thus, the s5(2)(a) ground failed.

The importance of being able to rely on s5(3) therefore came to the fore. Kona USA was able to establish the requisite reputation,



despite Hyundai's arguments that declining sales since the 1990s meant that its reputation was of less significance. The UK IPO concluded that, while Kona USA's heyday may have been in the mid to late 1990s, this did not impair its ability to possess a qualifying reputation, as its sales of bicycles remains significant.

And, although bicycles and vehicles were considered dissimilar goods for s5(2)(a) purposes, under s5(3), it was considered that the goods are both forms of transport, and so the

difference between them is not as stark as could be the case with wholly unrelated products. Therefore, the relevant public will overlap.

The conclusion was that a link would be made in the mind of the relevant public and, as a result, unfair advantage would be gained because of the "symmetry between bicycles ... and off-road vehicles. They complement each other's spirit of adventure". The potential for the public to imagine a tie-in or wonder about the existence of such a relationship would provide a benefit, whether intentional or not. Therefore, the s5(3) ground succeeded and proved to be paramount to the success of the opposition.

KEY POINTS

✦ Automobiles and bicycles are dissimilar goods under s5(2)(a) and unable to support a likelihood of confusion, but sufficiently connected to create a link in the mind of the relevant public, potentially leading to unfair advantage

✦ This case highlights the importance of pleading a full case in oppositions



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Lads brand shows its strength

Joel McDonald stresses the role of robust evidence

Florentyna Dawn Ltd (the Applicant) filed an application to register the trade mark THEUNIBIBLE and device (shown below right) on 23rd December 2016 for a range of goods and services in classes 9, 38 and 41. The application was opposed by The LAD Bible Group Ltd (the Opponent) under s5(2)(b), s5(3) and s5(4)(a) of the Trade Marks Act 1994. The earlier rights the Opponent relied on were its UK and EU trade mark registrations for a family of BIBLE trade marks, including THE LAD BIBLE, THE SPORT BIBLE and THE FOOD BIBLE.

Both parties filed evidence, the Opponent's consisting of two witness statements from its head of finance, and the Applicant's consisting of examples of other BIBLE trade mark registrations and applications, and use of other BIBLE marks by parties not associated with the Opponent. A hearing took place on 26th June 2018.

SECTION 5(2)(B)

The Hearing Officer (HO) found that the marks were visually similar to a low degree, but aurally and conceptually similar to a medium degree. Turning to the distinctiveness of THE LAD BIBLE, the HO found the mark to be distinctive to a normal degree for some class 9 goods (such as glasses, and cases for mobile phones and personal electronic devices), but of low inherent distinctive character for the remaining goods and services, which broadly related to online publishing, telecommunication services, social media, online magazines and entertainment. However, the HO found, due to the Opponent's use of THE LAD BIBLE, as evidenced in the witness statement, that it had acquired enhanced distinctiveness in the mark.

The HO believed that the enhanced distinctiveness of THE LAD BIBLE mark meant there was a likelihood of confusion between THE LAD BIBLE and THEUNIBIBLE for all goods and services,

with the exception of "eyewear; glasses; spectacles; sunglasses; lenses; frames for spectacles and sunglasses; cases and boxes for spectacles and sunglasses; cords, straps and chains for spectacles and sunglasses; digital photograph frames; covers and cases for mobile phones, computers and personal electronic devices" in class 9.

SECTION 5(3)

The HO was satisfied, based on its earlier findings, that it was clear the Opponent had obtained a significant reputation in THE LAD BIBLE for publication of news, information and entertainment (including original and

user-generated content). The analysis under s5(2)(b) also satisfied the HO that the Opponent's THE LAD BIBLE mark will be brought to mind on seeing the THEUNIBIBLE mark, with the exception of those goods for which no likelihood of confusion had been found. As a result, the HO believed THEUNIBIBLE would take unfair advantage of THE LAD BIBLE in respect of all

services in classes 38 and 41 applied for by the Applicant.

ESSENTIAL EVIDENCE

This case shows the importance of good evidence. The strength of the Opponent's evidence allowed it to prove the enhanced distinctiveness of its mark and the reputation it owned in it. It was ultimately this that got it over the line in this matter.

KEY POINTS

- ★ Good evidence can be crucial to success
- ★ When compiling evidence, consider what you are trying to show and whether the evidence you have goes towards proving your case

THE APPLICANT'S
MARK
NO 3203971



“
The HO was satisfied that the Opponent had obtained a significant reputation in THE LAD BIBLE”



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Stobbs represented the Opponent in this case

Lush is the loser

Ultimately, far removed fields of activity meant failure, reports Laura Robyn

This case concerns an opposition against an application to register the logo mark LUSH in class 29 filed by Tasty Snacks Ltd (the Applicant). The Opponent was Cosmetic Warriors Ltd (licensor for soap and cosmetics retailer Lush Ltd).

Relying on its earlier EU and UK registrations, the Opponent claimed a reputation and goodwill in LUSH for cosmetics and toiletries in class 3, directing the opposition against class 29 goods covered by the application: “snacks consisting of mixtures of nuts; crisps”.

The Applicant conceded that the Opponent’s earlier marks have a significant reputation for all goods relied on, and that the average consumer would make the required link to establish a reputation claim. The Hearing Officer (HO) then considered the three heads of damage advanced by the Opponent: tarnishing, detriment to distinctive character and unfair advantage.

For tarnishing to exist, the contested mark must be, or be capable of being, used in a way that is either unpleasant or “incompatible with the earlier mark’s image”. The Opponent’s submissions and evidence demonstrated its focus on ethical trading, campaigning against animal testing and use of fresh ingredients. It also demonstrated use of foodstuffs in its soap formulations.

Notwithstanding the Applicant’s concessions, the HO judged the link to be weak, bearing in mind the superficial overlap in users and the clearly different goods. While recognising the high degree of visual, aural and conceptual similarity between the marks, the HO found that LUSH’s degree of inherent distinctiveness was below normal, considering its laudatory meanings, and the Opponent’s extensive use only enhanced its distinctiveness to a medium level.

This, coupled with the notion that (even slightly unhealthy) snacks are not likely to evoke a negative reaction in consumers, meant that there was no tarnishing or detriment to distinctive character. The claim of unfair advantage also fell. This was because the Opponent had failed to show “any advantage, let alone an unfair one”, despite arguing its goods’ presentation would bring to mind edible goods in the average consumer’s mind, leading it to believe the Opponent had sold out to mass production. The reputation claim failed.

The Applicant conceded from the outset that the Opponent had protectable goodwill in respect of the class 3 goods. Having considered the case law on the relevance of a common field of activity between the parties, the HO concluded that this was an important consideration in deciding likelihood of confusion, amounting to misrepresentation. She deduced that, as the fields of activity are far removed in this case, the burden of proving likelihood of confusion would be high. On balance, the HO found that there could be no misrepresentation because:

- LUSH is distinctive only to a medium degree, making a mental connection less likely considering the wholly separate commercial fields;
- including natural ingredients in formulations is not unusual, so does not make a connection (more) probable; and
- the Opponent’s goods’ presentation does not create a sufficiently striking impression to cause the relevant public to associate the parties.

Falling at the second hurdle, there was no need to consider damage, and the passing off claim also failed, with the opposition being rejected in its entirety.

KEY POINTS

- Marks with laudatory connotations can, even with extensive use, be found to have enhanced their distinctiveness only to a medium level, rendering a finding of enhanced distinctiveness less powerful than in other, more inherently distinctive marks
- In a passing off claim, the further removed the respective fields of activity, the heavier the burden of proving likelihood of confusion to establish damage as a result of misrepresentation



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More is not always the merrier

Evelina Skrudyte explains why some evidence missed the mark

On 2nd August 2017, Easy Question Ltd (the Applicant) filed to register a series of two stylised marks for BISOU BEAUTY (shown below right, the Application) for goods in classes 3, 5, 8, 16, 18, 20, 21 and 24.

Nuwena GmbH (the Opponent) opposed based on three earlier EU trade marks (EUTMs) for BILOU in classes 3, 4, 5, 8, 14, 18, 21, 26, 29, 30, 32, 33 and 44, and two EUTMs for BILOU BIBI LOVES YOU in classes 3, 4, 5, 8, 14, 18, 21, 25, 26, 44 (the Earlier Marks). All marks were registered less than five years ago. The Opponent relied on s5(2)(b) and s5(3) of the Trade Marks Act 1994.

EVIDENCE AND DECISION

In support of its s5(3) claim, the Opponent submitted a variety of evidence, including sales figures and awards, data related to the Opponent's Instagram and affiliated vlogs, various internet links (not supported by screenshots) and photographs. The aforesaid evidence was either related to Germany, undated, post-dated the filing date of the Application or wasn't presented on paper (ie internet links).

In relation to the s5(2) claim, the Hearing Officer (HO) observed that BILOU is the first word that is read and heard in the Earlier Marks, as is BISOU in the Application. BILOU is an invented word and is inherently distinctive. Aurally and visually, BISOU and BILOU only differ in the middle letter. Aurally, both marks end with a long “-oo” sound. Accordingly, the HO found that there is a good degree of visual and aural similarity between the Application and BILOU, and a medium degree when compared to BILOU BIBI LOVES YOU.

In assessing the similarity of goods/services, the HO carried out a class-by-class comparison. Applying, among others, the Meric principle (whereby the opponent's goods cover the applicant's or vice versa), the HO concluded

that the applied-for goods, save for “mouldings for mirrors; bathroom vanities; cushions adapted to support the face [other than for medical use]”, were identical or similar to a high, medium or low degree. The s5(2)(b) claim partially succeeded.

However, the evidence presented before the HO was insufficient to establish the reputation in the UK, and the s5(3) claim failed. Notably, it didn't cover the right territory, and the internet links were not presented in the correct

format to be considered.

Without a reputation in the UK, the UK public would not have formed a link between the Application and the Earlier Marks at the relevant date, meaning there could be no damage.

ADVANTAGE OF YOUTH

The Opponent's “young” registrations were an advantage and entitled it to rely on a wide range of goods and services

and leave the groundwork to the examiner.

However, in relation to the evidence of reputation, the Opponent has “shown its hand”. As the registration matures, difficulties may arise if proof of use is requested and no more use is made.

Further, the case is a reminder that the evidence of reputation has to be relevant, clear and precise, in date, and cover a reasonable portion of protected goods and services. More is not always the merrier when it comes to claiming reputation for lots of goods and services.

“

The evidence presented before the HO was insufficient to establish the reputation in the UK, and the s5(3) claim failed

KEY POINTS

✦ Goods and services are deemed identical when the opponent's goods cover the applicant's or vice versa

✦ The HO found that undated and post-dated evidence, evidence covering a small portion of the goods and services protected by the registrations, and evidence originating from outside the UK were not sufficient to succeed in the s5(3) claim

✦ The HO found that internet links are not durable and reliable evidence

THE APPLICATION



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Past its peak

No summit for Mont Noir, says Amelia Skelding

Mont Adventure Equipment Pty Ltd filed a UK designation of international registration No 1385791 for the mark shown below right on 27th November 2017, with a priority date of 10th November 2017. This designation was opposed by AA Textiles Ltd in respect of class 25, including “technical clothing, footwear and headgear for adventure sport and extreme adventure sport pursuits” under s5(2)(b) of the Trade Marks Act 1994. The Opponent relied on UK trade mark registration No 3191303, filed on 14th October 2016, for MONT NOIR in class 25 for *inter alia* “clothing, headwear, footwear”.

The goods involved were acknowledged as identical. For Mont Noir, the average consumer was deemed to be the general public with a reasonable level of attention. However, in light of the specialist technical clothing covered by the Applicant’s specification, the average consumer for the opposed mark was deemed to have a higher than average level of care and attention.

While both marks were held to be averagely distinctive for clothing, for English-speaking consumers aware that the French terms involved mean “mountain” and “black mountain”, the evocative association weakened the distinctiveness of both marks when considered in relation to adventure sports clothing.

ELEMENT ANALYSIS

Although the distinctive weight of the opposed mark was held to lie predominantly in the word MONT, the figurative element also made a substantial contribution to the overall distinctive character of the mark. For MONT NOIR, as there was no difference in the graphic presentation of the words, the distinctive character of the earlier mark was held to lie in the phrase “Mont Noir” as a whole.

The additional word NOIR in the earlier mark was held to be unlike anything in the contested mark because it doubled the length and number of words. Also, the figurative element of the contested mark had no counterpart in the earlier mark. As a result, there was found to be no more than a medium degree of visual similarity between the two.

It was held that the consumer would pronounce the word MONT in the same way in both marks, so a medium degree of aural similarity was found.

For consumers who understand the meaning of the marks, MONT was held to represent a concept common to both marks, with NOIR as an element of conceptual difference. It was held that MONT would evoke a mountain at large, whereas MONT NOIR suggested the name or description of a specific mountain. Therefore, it was held that the differing concepts behind the marks were readily distinguishable and, overall, the opposition failed.

NUANCED DECISION

Three factors to note in this case are the nuances related to the average consumer, the assessment of French terms and the identification of distinctive character. Despite the marks covering identical goods, the differentiation of the average consumer for the opposed mark added inconsistencies at an early stage of comparison. When reviewing French terms, the view of consumers who would understand the foreign meaning, and those who would not, should be taken into account. Finally, when considering distinctive character, even relatively minor figurative elements can have a significant impact.

KEY POINTS

- ✦ Despite covering identical goods, the average consumer for the marks at issue was different
- ✦ When looking at French terms, the views of consumers both aware and unaware of the translated meanings should be considered
- ✦ Even relatively minor figurative elements can have a significant impact on distinctive character

THE MONT MARK



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Case closed for The Commodores

Gavin Stenton surveys the scene in another music industry dispute

The General Court (GC) has annulled a Board of Appeal (BoA) decision to uphold an opposition brought by Commodore Entertainment Corp against Fifth Avenue Entertainment LLC's EU trade mark (EUTM) application for THE COMMODORES in classes 9 and 41, on the basis that the BoA had failed to take into consideration the fact that the underlying partnership agreement concluded between the founder members of the Commodores had expired.

BACKGROUND

In October 2014, Fifth Avenue Entertainment LLC (authorised to exercise the IP rights of Mr McClary, one of the founders of the band, and the Applicant) applied to register an EUTM for THE COMMODORES in classes 9 and 41. In January 2015, Commodore Entertainment Corp (the Opponent, authorised to exercise the IP rights of former band members Mr Orange and Mr King) opposed the application under Article 8(4) of Regulation (EC) 207/2009 (now Article 8(4) of Regulation (EU) 2017/1001). The Opposition Division dismissed the opposition in May 2016 on the basis that the Opponent had not satisfactorily substantiated its grounds of opposition.

In its appeal to the BoA, the Opponent was able to establish that its opposition was sufficiently clearly based on unregistered UK common-law passing off rights in the COMMODORES name. The BoA annulled the Opposition Division's decision and rejected the application pursuant to Article 8(4) of Regulation (EC) 207/2009. After acknowledging that ownership of the goodwill was at the crux of the dispute, it concluded that the goodwill in the business operating under the name THE COMMODORES was owned by the

Opponent and protectable under UK law, thereby entitling the Opponent to prohibit use of the mark applied for under passing off. It based its conclusion on the terms of a general partnership agreement concluded by the band members on 20th March 1978 (the Agreement) and a subsequent amendment thereto dated 1st July 1981 (the Amendment), under which the band members had assigned their rights to Commodores Entertainment Publishing Corp, a company that subsequently merged with the Opponent.

The Applicant appealed the BoA decision to the GC on the basis that: (i) the Opponent had not accrued goodwill; and (ii) the Applicant owned, at the very least, separate goodwill from that of the Opponent, allowing it to use the sign in parallel. In doing so, the Applicant highlighted that the term of the Agreement was limited to seven years. The Agreement had therefore expired, and the rights had reverted to the band members.

GC AGREEMENT

The GC agreed. It held that the BoA had erred by failing to examine the legal effects resulting from expiry of the Agreement, and by failing to acknowledge that the Agreement had expired. With goodwill at the crux of the dispute, the BoA had, mistakenly, "omitted to examine whether the applicant was the co-owner of that right and ... the impact of such co-ownership in the light of the national law relied on" and overlooked the fact that "in certain circumstances, several persons can simultaneously own separate goodwill in a name, with the result that they are permitted to use that name simultaneously". The GC annulled the BoA's decision and held that it was not necessary to examine the other grounds of appeal raised by the Applicant.

KEY POINTS

- ★ When asserting trade mark or related rights, check the chain of title in order to ensure that the rights exist and/or have not reverted to a third party
- ★ When drafting agreements between band members, particular consideration should be given to the termination and post-termination provisions, in the event that a member leaves or a new member joins, as well as the dispute resolution clauses in the event of a disagreement arising between band members



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Sarah Emery, an Associate (FCILEx) at Penningtons Manches LLP, assisted.

Not all monsters are the same

Confusion wasn't the conclusion, notes Leanne Gulliver

Energy drinks brand Monster Energy Company unsuccessfully opposed EU trade mark (EUTM) application No 0131182811 (the Application) for the figurative mark shown below right (the MONSTER DIP Mark) filed by Marco Bösel. Bösel applied to register the MONSTER DIP Mark for goods and services in classes 2, 37 and 40, which include paints, coatings, the painting of vehicles and the customisation of coating preparations.

Monster Energy appealed the Opposition Division's (OD's) decision, which was upheld by the Board of Appeal (BoA), before appealing the decision to the General Court (GC).

ACTION HISTORY

Monster Energy had opposed the Application on the basis that: (i) it was confusingly similar to its earlier trade marks; (ii) Monster Energy's earlier trade marks enjoy a reputation, which affords them broader protection to prevent the registration of the Application; and (iii) Monster Energy owns unregistered rights in the UK that are sufficient to prohibit use of the Application.

Monster Energy relied on several earlier EUTM registrations, including the word marks MONSTER ENERGY (classes 9, 14, 24, 26, 28 and 35) and MONSTER (classes 7, 8, 11 and 21), and two figurative marks (shown right) containing the verbal elements MONSTER ENERGY (covering classes 5, 9, 14, 24, 26, 28 and 32).

The OD rejected the opposition in its entirety, and Monster Energy appealed the decision to the BoA, which upheld the OD's decision.

Monster Energy further appealed the decision to the GC on the basis that the BoA wrongly found that: (i) the goods and services covered by the MONSTER DIP Mark were dissimilar to the goods and services covered by the earlier marks, in particular the goods "stickers", "decals" and

"transfers" in class 16, covered by the earlier EU figurative mark MONSTER ENERGY; and (ii) there was no conceptual similarity between the EU figurative mark MONSTER ENERGY and the MONSTER DIP Mark.

REJECTION

The GC upheld the BoA's decision, and rejected the opposition. It agreed with the BoA that the goods and services covered by the parties' marks were dissimilar. None of Monster Energy's class 16 goods could be considered to be identical or similar, particularly given that the goods and services in question differ in their nature, intended purpose, users, distribution channels and points of sale. As the goods and services are not complementary, the BoA was not required to examine similarity between the signs.

Further, the GC concluded that the BoA was correct to find that the relevant public would not have established a connection between the earlier EU figurative mark MONSTER ENERGY and the MONSTER DIP Mark. Consequently, the use of the latter would not injure the distinctiveness of that earlier figurative EUTM. The BoA had correctly carried out its assessment, taking into account all the elements of the marks at issue, and rightly held that the marks were similar only to the part of the EU public that would understand the meaning of "monster".

“
The GC agreed with the BoA that the goods and services were dissimilar

KEY POINTS

- ✦ The lack of similarity between goods and services at issue precludes any likelihood of confusion within the meaning of Article 8(1)(b)
- ✦ When assessing similarity of goods or services, all the relevant factors relating to those goods or services should be taken into account
- ✦ If an argument relies on reputation, the relevant public only has to be able to establish a link between the marks, and not necessarily to be confused

THE MONSTER DIP MARK



THE MONSTER ENERGY MARKS



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Pet peeves

The Court picked holes in the Appellant's appeal, reports Jasmine Sihre



In 2013, Comercial de Servicios Agrigán, SA (the Opponent) registered THE PET CUISINE ALIMENTO PARA MASCOTAS FELICES GENIAL (device) in classes 31, 35 and 39 at EUIPO. TDH Group (the Appellant) filed an international registration (the IR) for PET CUISINE (device) in class 31, designating (among others) the EU.

The Opponent opposed the IR on the basis of likelihood of confusion under Article 8(1)(b) of Regulation (EU) No 2017/1001.

EUIPO upheld the opposition and refused protection of the designation, resulting in an appeal to the Board of Appeal (BoA). This appeal was dismissed.

In 2017, an appeal was filed at the General Court (GC), contending that the BoA had incorrectly:

- declared evidence relied on as inadmissible;
- found the relevant public's level of attention to be merely average;
- compared "foodstuffs for animals" covered by the earlier mark with the contested goods of the IR; and
- assessed the distinctiveness and dominant character of the term PET CUISINE.

APPELLANT ARGUMENTS

During the appeal stage, the Appellant sought to rely on a study supporting the claim that pet owners do not switch pet-food brands easily, and thus to demonstrate the relationship between pets and owners. The GC held that the claim and study were submitted for consideration for the first time before the GC in a breach of Article 65 of Regulation (EC) No 207/2009. The evidence was held to be inadmissible.

The Appellant submitted that the relevant public's level of attention is more than merely average, and that the relevant public displays

a "high level of attention owing to the impact of animal foodstuffs on the health of pets". The GC held that likelihood of confusion in this case would exist even if the relevant public paid a high level of attention to the goods.

The Appellant reiterated that if one type of foodstuff is fed to a species of animal, it does not necessarily mean that it would be classified under "foodstuffs for animals". However, the GC concluded that the goods may be regarded as identical when the goods designated by the earlier mark are included in a more general category.¹

AUDIENCE UNDERSTANDING

The Appellant maintained that the earlier mark and the IR were dissimilar with regards to the visual, phonetical and conceptual qualities, and further submitted the importance of considering the marks as a whole. However, the GC held that, even if consumers remembered the smaller visual differences between the marks, the presence of PET CUISINE would amount

to an understanding that both goods came from economically linked undertakings.²

Ultimately, the submissions put forward by the Appellant were rejected. The GC upheld a finding of likelihood of confusion in this case and dismissed the appeal in its entirety.

KEY POINTS

- ✦ Evidence not submitted during the administrative procedures before EUIPO may subsequently be declared as inadmissible
- ✦ Specific goods and services may be considered identical if a broader term is registered for that mark first
- ✦ A mark that may appear unregistrable in the UK may well be registrable in non-English-speaking countries, so launching an early invalidity challenge to an opponent's rights may be advisable

- Judgment of 7th September 2006, Meric v OHIM and Arbora & Ausonia (PAM-PIM'S BABY-PROP), T-133/05, EU:T:2006:247, para 29
- See, to that effect, judgment of 30th November 2006, Camper v OHIM and JC (BROTHERS by CAMPER), T-43/05, not published, EU:T:2006:370, para 89 and the case law cited

“
The GC held that likelihood of confusion would exist even if the relevant public paid a high level of attention to the goods



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Grate expectations

The time isn't right for tastes to receive copyright protection, confirms Rebecca Campbell

This case concerns the “Heks'nkaas” spreadable cream-cheese dip produced by Dutch company Levola Hengelo BV. A patent for the method of manufacture was granted in 2007. However, when rival Smilde Foods began producing its “Witte Wievenkaas” cheese product, Levola relied on another area of IP law.

Levola brought a claim for copyright infringement before the Gelderland District Court in the Netherlands, alleging that the production and sale of Smilde's product infringed its copyright in the “taste” of Heks'nkaas. It asked the Court to rule that the taste was its manufacturer's own intellectual creation and therefore eligible for copyright protection as a “work”, and that the taste of Smilde's product was a reproduction of that work.

IS TASTE PROTECTABLE?

The Court held that it was not necessary to rule on the question of whether the taste of Levola's product was protectable under copyright law, as Levola hadn't indicated the elements that gave its product its unique character. Levola appealed to the Regional Board of Appeal, arguing that taste may be classified as a “work” of literature, science or art eligible for copyright protection. It referred to the 2006 judgment of the Supreme Court of the Netherlands in Lancôme, which accepted the possibility of copyright arising in a perfume scent.¹ The Regional Court noted that there was divergence between national supreme courts in the EU on the related issue of whether scent may be protected by copyright, and made a reference to the CJEU for a preliminary ruling.

Two questions were referred, although the CJEU found it necessary to answer only the first. This asked whether Directive 2001/29/EC (the Directive) precluded the taste of a food product from being protected by copyright and whether it precluded national legislation from being

interpreted in such a way that it would grant such protection.

Mirroring Sieckmann, the CJEU said that subject matter to be protected under EU copyright law in the EU must be expressed in a way that makes it identifiable with sufficient precision and objectivity.² Otherwise, it could not qualify as a “work” as referred to in the Directive. Authorities needed to be able to clearly and precisely identify subject matter, and this needed

to be capable of being expressed in a precise and objective manner.

The CJEU held that such precision was not possible in relation to the taste of food products. Taste sensations and experiences are subjective and depend on various factors, and there are currently no technical means of precisely and objectively identifying and distinguishing these.

In view of the need for a uniform application of

EU law, the CJEU said that national legislation could not be interpreted in a way that granted copyright protection to a food product's taste.

ROOM FOR IMPROVEMENTS

The decision raises an interesting question about whether improvements in current technology could open the door to such unusual “works” in the future. In the meantime, other forms of protection including trade secrets and patents should be considered when seeking to protect complex elements of a product, such as taste.

KEY POINTS

✦ To be classified as a “work” protectable under EU copyright law, subject matter should be identifiable with sufficient precision and clarity

✦ The taste of food products can't be protected because the way we taste them is difficult to determine with any precision and objectivity

“
The CJEU said that national legislation could not be interpreted in a way that granted copyright protection to taste



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1. NL:HR:2006:AU8940, Lancôme v Kecofa
2. C-273/00, Sieckmann v Deutsches Patent- und Markenamt

The CITMA AGM will be held on 27th March, in accordance with our Royal Charter. See details at citma.org.uk



Events

More details can be found at citma.org.uk

DATE	EVENT	LOCATION	CPD HOURS
27th March	CITMA AGM	London	
18th April	CITMA Webinar New environment for trade mark protection in China	Log in online	1
30th April	CITMA Lecture – London Domain name disputes post-GDPR	London	1
14th May	CITMA Paralegal Webinar	Log in online	1
13th June	CITMA Webinar	Log in online	1
16th July	CITMA Webinar Canada's new trade mark laws	Log in online	1
3rd September	CITMA Webinar EU case law update	Log in online	1
6th September	CITMA Paralegal Seminar	London	TBC
24th September	CITMA Lecture – London	Carpmaels & Ransford, London WCI	1
8th October	CITMA Webinar Artificial intelligence	Log in online	1
12th November	CITMA Paralegal Webinar	Log in online	1
14th November	CITMA Webinar UK case law update	Log in online	1
26th November	CITMA Lecture – London Fashion and IP	London	1
6th December	CITMA Northern Christmas Lunch	TBC	
13th December	CITMA London Christmas Lunch	London Hilton 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.

THE TRADE MARK 20

Q&A

Sinéad Mahon

loves to bring new brands to life

I work as... a Senior Chartered Trade Mark Attorney at Lewis Silkin.

Before this role, I was... working for an Irish IP firm for a number of years.

My current state of mind is... excited. I recently joined Lewis Silkin and have spent a few months at the London office, exploring all that the city has to offer. I'm also excited to now be returning to Ireland to the Lewis Silkin Dublin office.

I became interested in IP when... I took an IP law module as part of my undergraduate commerce degree. I then went on to study it further as part of my law degree and specialised in IP for my LLM.

I am most inspired by... my mum. Having lost most of her sight a few years ago, she is an inspiration to all that meet her.

In my role, I most enjoy... seeing new brands come to life.

In my role, I most dislike... receiving very urgent last-minute instructions.

On my desk are... the usual bits and pieces of stationery, two mobile phones, my travel mug from New Zealand and a box of Barry's teabags.

My favourite mug says... "Tea keeps me going until it is acceptable to drink wine!"

My favourite place to visit on business is... clients' offices! I always love having a snoop inside other organisations and it's even better if they are based in a foreign country.



The talent I wish I had is... the ability to sing and dance. I was not blessed with those genes.

My ideal day would include... travelling somewhere new. I was lucky enough to go to Australia, New Zealand, Dubai, Spain, Mexico, Guatemala and Belize in 2018 alone.

In my pocket is... my work ID badge.

The best piece of advice I've been given is... what's meant for you won't pass you by.

When I want to relax, I... go to my mum's house for a Chinese takeaway and a glass of wine (or two).

In the next five years, I hope to... tick a few more countries off my travel bucket list.

The best thing about being a member of CITMA is... all of the lovely people I meet at the events. It's great to be able to meet up with peers regularly, especially at the Spring Conference, when people travel from all over the world to attend. See you there!

“
It's great to be able to meet up with peers regularly, especially at the Spring Conference, when people travel from all over the world to attend”

If I were a brand, I would be... Baileys – full of Irish spirit!

The biggest challenge for IP is... still Brexit, at the time of writing, and the implications that it may have for IP in the UK.

I can't live without... my phone.



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