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ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

Issue 404 September 2013 **itma.org.uk**

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ITMA contacts

General enquiries
ITMA Office, 5th Floor, Outer Temple, 222-225 Strand, London WC2R 1BA
Email: tm@itma.org.uk
Tel: 020 7101 6090

Committee chairs

General Purpose & Finance: Maggie Ramage, maggie@ramage.co.uk
Programme: Katie Cameron, kcameron@jenkins.eu
Book: Mark Hiddleston, m.hiddleston@elkfife.co.uk
***ITMA Review*:** Tania Clark, tclark@withersrogers.com
Law & Practice: Imogen Wiseman, i.wiseman@cleveland-ip.com
Public Relations & Communications: James Setchell, james@ramage.co.uk
Education & Training: Alison Melling, amelling@marks-clerk.com
Designs: Chris McLeod, chris.mcleod@ssd.com
Trade Mark Administrators Course: Richard Goddard, richard.goddard2@uk.bp.com

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Editor: Caitlin Mackesy Davies
Advertising: Dalia Dawood, dalia.dawood@thinkpublishing.co.uk
Group account director: Polly Arnold
Publishing executive: Kieran Paul
Senior designer: Clair Guthrie
Senior sub-editor: Gemma Dean

ITMA Review

Review content is provided by members on a voluntary basis, and reader suggestions and contributions are welcome. If you would like to contribute an article to a future issue, please contact Tania Clark by email at tclark@withersrogers.com and Caitlin Mackesy Davies at caitlin@thinkpublishing.co.uk

Welcome to the end of the summer. Now is the time to remind yourself of the brilliant ITMA Summer Reception by studying the photographs in this issue. Are you in the pictures? Did you enjoy networking with the profession? Or did you miss that opportunity – in which case, why not come along to the Autumn Seminar in Birmingham on 10 October 2013 and the reception afterwards?

Whether or not I get to meet you in Birmingham, you can meanwhile steal a march on your non-ITMA colleagues by asking them difficult questions such as, how exactly do Middle Eastern countries treat trade marks? What was the Scottish reaction to the groundless threats consultation? What does "post-Napster" mean?

Three very answerable questions – for those who have read this issue of the *ITMA Review*!

Catherine Wolfe
ITMA President

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Tee time for ITMA

Some of the Bafta Cup players who raised £20 for the Benevolent Fund

In May, I had the pleasure of playing in an invitational golf tournament, the BAFTA Cup. Eight men engaged in golf warfare over two rounds, on two courses. The players in this coveted competition must have a link to ITMA – Rule 42(4)(viii) – and must have some understanding of golf. This is only the second year the tournament has been held and, after picking up the trophy in 2012, Mike Knight (ITMA Honorary Member and Chair of the ITMA Benevolent Fund) was keen to retain the trophy. He did so with his "trade mark" play, pipping Alan Venner to the trophy on the last hole.

Despite only playing a few rounds of golf in a year compared to the seasoned "professionals", I finished in third place. Ex Council member John Caisley trotted home in fourth, with past President Brian March closely following. Media Watch columnist Ken Storey took sixth, with past President Ian Buchan coming in seventh.

Rule 50 requires that any person playing must pay £1 towards the ITMA Benevolent Fund for every ball that is lost. We amassed £20 for the fund. That tells you all you need to know about the standard of our golf!

ITMA Chief Executive Keven Bader

TM10

As everyone will be aware, the UK IPO has now implemented its new IT system – the TM10 project.

Generally speaking, the implementation has been very smooth and the new system offers several benefits for users downstream. This is not to say that there have not been any teething problems.

ITMA's Law and Practice Committee (L&P) has been working with the IPO to rectify these. For example, L&P contacted the IPO when it was noticed that users were not being informed of the publication dates of accepted applications. The IPO acknowledged the problem and it will now reintroduce the publication letter.

ITMA would like to thank those members who have already been in touch highlighting possible issues and also invite anyone who is encountering any problems to email Gillian Rogers so that she may share these with the L&P Committee and the IPO.

Progress on unsolicited invoices

ITMA is pleased to report that the Advertising Standards Authority (ASA) has upheld a complaint made by NBC Bird & Pest Solutions Limited against Trademark Renewal Services Limited about an unsolicited renewal invoice it had received. NBC Bird & Pest Solutions Limited felt the invoice was misleading as it was not clear it had been sent by a private company with no affiliation to the UK IPO. The ASA considered that the presentation of the invoice and mailing was misleading and ruled that it must not appear again in this form. See asa.org.uk for more information.

Member moves

Antony Watson QC joined Hogarth Chambers on 1 June 2013. Antony's practice encompasses all aspects of IP and arbitration, especially in disputes involving technical issues. He has acted in many of the leading IP cases of the past 40 years; these include Amgen v Boehringer and Pavel v Sony. "His wealth of experience will be an asset to Hogarth and his arbitration skills will complement Hogarth's established team of mediators," said Hogarth Chambers.

Welcome Marzia

Marzia Sguazzin joined the ITMA team on 8 August as Administrative Officer. Marzia will be responsible for membership applications and handling membership queries, as well as for organising the Trade Mark Administrators' Course. We hope you will extend her a warm welcome.

Readers rate the *ITMA Review*

Key findings from recent member feedback

The latest *ITMA Review* reader survey happily shows that the publication continues to be highly valued by members, with 98 per cent of the 273 respondents viewing it as a positive member benefit.

It also shows that the key use of the magazine for 79 per cent of readers is for up-to-date and relevant case comments, with the same number enjoying this part of the magazine more than any other.

Features also rate very highly, as 62 per cent of readers state they enjoy this type of content most. And many readers use the *ITMA Review* as part of continuing professional development (63 per cent) and for regular updates about what's happening within ITMA (55 per cent).

When asked about the magazine's content in more detail, readers support ITMA's continuing work to develop international content and features, reflecting the global reach of the membership. ITMA is also looking at ways to provide easy access to case comments carried in the publication for reference, something that was flagged by those who provided specific feedback.

The findings show that the format of existing content matches readers' consumption patterns. While 10 per cent report reading an entire issue in one sitting, more than two-thirds of readers (73 per cent) read the magazine over a longer period as they find time. For 61 per cent of those who replied, this is usually at work. The magazine's style enables readers to dip in and out of the magazine, but many do take time out to read case reviews in more detail.

In the changing landscape of magazines, where digital formats are on the rise, print is still most popular with readers of the *ITMA Review*. Eighty-nine per cent of readers prefer to read magazines in general on paper, despite 76 per cent owning a tablet or e-reader. The survey saw some demand for a tablet or smartphone edition (23 per cent), but print still comes out on top – 85 per cent prefer to get their hands on a paper copy.

Thank you to everyone who participated in the survey.

98% see the *ITMA Review* as a positive member benefit

93% rate the quality of content as good or excellent

90% rate the *ITMA Review's* design as good or excellent

Celia Davidson and Kenneth Mullen (Withers), Robert Buchan (Brodies)

Bob Naismith (Marks & Clerk), Gordon Harris (Wragge & Co)

Sun greets Summer Reception

The intimate garden courtyard of London's historic Stationers' Hall hosted a perfect seasonal and sociable evening event

PHOTOGRAPHY BY **STEWART RAYMENT**

Mark Caddle and Daniel Chew (Withers & Rogers)

Charlotte Blakey (Keltie), Hilde Vold-Burgess (Acapo AS), Sean Cummings (Keltie)

Triona Desmond, Lianne Bulger and Amanda McDowell (Squire Sanders), Patsy Heavey (Formula One Management)

Matthew Spokes, David Sheppard, Jeroen Lallemand (of event sponsor Thomson Reuters)

Robert Williams (Bird & Bird), Mona Asgari (Simmons & Simmons), Donna Trysburg (Boult Wade Tennant), Flora Cook (Kilburn & Strode)

Jennifer Eddis (Cerberus Investigations), Tim Dabin (Priaulx Associates), Alastair Gray (Kroll Advisory Solutions), Duncan Mee (Cerberus Investigations), Bob Boad (Joshi & Welch)

IP pathways

Ordinary member Victoria Wisener feels she's struck lucky in her latest role

INTERVIEW BY **CAITLIN MACKESY DAVIES**

Who:
Victoria Wisener
What:
Trade Mark Attorney
Where:
Virgin Enterprises, Geneva

I grew up with the Virgin brand and, for me, it is one of the most exciting brands in the world. So for a Trade Mark Attorney, I feel I am pretty lucky. Because the Virgin brand covers so many categories I can be looking at airlines one day and bottled water, clothing lines or telecoms the next. From that point of view, it's fantastic. And it is nice to work for a brand that people feel so passionately about, both internally and externally.

In terms of in-house IP roles, the Virgin role is quite special because we work closely with the commercial teams. We have early sight of things that are in the pipeline and are very much at the heart of the Virgin business. This means we help shape the protection, and people here are very aware of how important brand protection is. It's not an afterthought.

What can be challenging is that a lot of the value in the brand resides in people's positive experiences with it, so we, as a legal department, have to follow that through. Even when we instruct local attorneys, we have to choose very carefully, and pass the brand down through anyone who works with us to protect our trade mark.

Early steps

My law degree didn't include any IP modules at all; the options on the table appeared to be Solicitor or Barrister. Many of my friends were going to join City firms, facing the prospect of 10 years of working 12- or 16-hour days. Some others were looking at pupillages, which required a lot of financial support. To be honest, I thought: "Neither of these are for me."

A holiday job found me in the trade mark department at what is now AstraZeneca, where the head of trade marks at the time was Sarah Lambeth, and she was one of these people who was just so inspiring. She took time at the end of the working day to take me through the basics, explain what the career was like, and her enthusiasm rubbed off on me. I enjoyed the work I was doing and, for the first time, Sarah gave me an outline of something different but useful that you could do with a law degree. It was an absolute blessing at the time.

After I graduated a job at Thomson Compumark came up. I studied for foundation-level ITMA exams in the evening and was on the phone all day to Trade Mark Attorneys ordering searches – I learned a lot from the experience. A year later a training position came up at Grant Spencer, where I stayed until 2005, before going in-house at ICI. I was there for six years until I joined Virgin in 2011.

There are a few things I miss about private practice, and starting there gave me a good grounding, but in-house for me has proved to be a much broader experience. In-house anything can happen – from being asked at ICI whether the Dulux dog had any performance rights, to being at Virgin where suddenly I may have to try to buy the domain name for a new short-haul service.

Overall, the world of trade marks has given me the freedom to develop at my own pace. It's been a fantastic journey.

> *The Virgin role is quite special because we work closely with the commercial teams. We have early sight of things that are in the pipeline and are very much at the heart of the Virgin business*

ECTA visits new territory

Keith Havelock files this dispatch from a key European conference

PHOTOGRAPH BY ASHLEY BENJAMIN

The 32nd annual conference of the European Communities Trade Mark Association (ECTA) was held in Bucharest, Romania – the first major IP event to be held in the city. It had long been the wish of the ECTA management to have a meeting in one of the new Balkan EU Member States, and few delegates will have been unimpressed by Bucharest's wide boulevards, Arc de Triomphe and stately buildings.

One such was the main conference hotel, the JW Marriott, where the opening day featured a workshop – moderated by Benjamin Fontaine (EGYP SAS, Spain), Chair of the ECTA Geographical Indications Committee – on the subject of collective and certification trade marks in the EU, topical in light of recent proposals.

The theme for day one was the recent developments in the EU region. These included OHIM's latest practice changes, convergence projects, practice before the Court of Justice of the European Union, and whether the IP Translator case had changed the rules of the game. The conclusion of the speaker on that subject, Franck Soutoul (Inlex IP Expertise, France), was that the literal approach was best.

The afternoon session began with an update on plain packaging. Legal and consumer perspectives were presented by Alberto Alemanno (HEC Paris, France) and Enrico Bonadio (City Law School, UK), while the industry perspective was presented by John Noble (British Brands Group, UK). The day was completed by a double session on case law. The first covered application procedure, design and word marks, and geographical indications, and then oppositions, combined and design marks. Gordon Humphreys (Member of the Boards of Appeal, Spain) conceded that where some Board of Appeal decisions appeared harsh, this was because it was not possible to apply flexibility under current rules.

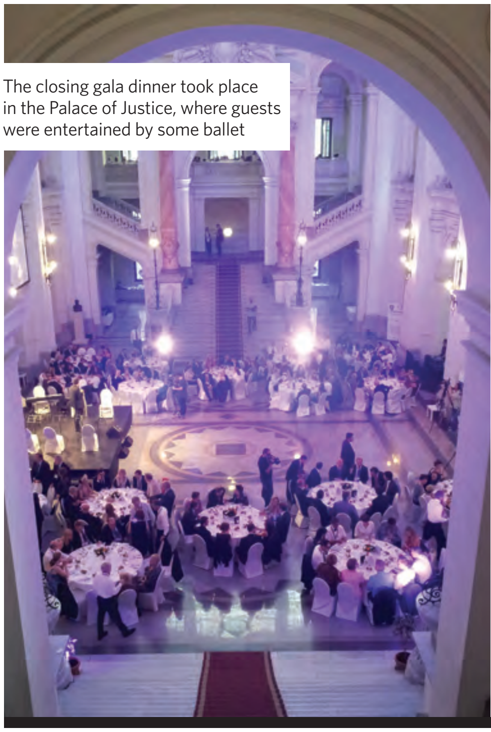
The second session was conducted by Ulla Wennermark (OHIM) and Alexander von Mühlendahl (Bardehle Pagenberg, Germany), the latter giving a whistle-stop review of the latest CJEU decisions and their effect on EU and national jurisdictions.

The final day of the conference centred on proposals for revision of the European system, the Legislative Package. After an overview from Tomás Eichenberg (European Commission, Belgium), who was on the receiving end of some tricky questions from delegates, the other speakers (including Michael Edenborough QC, Serle Court) kept their contributions on the lighter side, which was appreciated by delegates.

An all-female panel followed, which considered genuine use in the EU and in particular the ONEL case. Myrtha Hurtado Rivas (Head of Trade Marks, Novartis, Switzerland) and Prof Dr Alexandra von Bismarck (Head of Trade Marks Germany, Field Fisher Waterhouse, Hamburg) considered the effects of the case on global companies, and small- and medium-sized companies, respectively. Under the chairmanship of Carolin Kind (Greyhills, Germany) the presentations were clearly delivered and to time. Many delegates considered this session a highlight of the conference.

In the closing period, enforcement of Community and national trade marks was the subject of a presentation by Marius Schneider (CEW IPvocate and IPvocate Africa, Belgium), to which Gerhard Bauer (IP consultant, formerly Daimler AG, Germany) and Geraldina Mattsson (Honda Motor Europe Limited, UK) added advice as to what should be told to Customs. Paul Maier (OHIM) updated delegates on the EU Observatory and Paul Tjiam (De Brauw Blackstone Westbroek, the Netherlands) spoke on where and why to sue, and what redress may be obtained.

The closing gala dinner took place in the Palace of Justice, where the entertainment included a ballet performance by Monica Petrica (prima ballerina of the Romanian National Opera House) and Razvan Mazilu, which earned a standing ovation. Later, the inaugural ECTA awards were presented, to Enrico Bonadio (Italy) and Garry Trillet (France). So ended another memorable ECTA conference.



The closing gala dinner took place in the Palace of Justice, where guests were entertained by some ballet

Keith Havelock
is a Consultant Trade Mark Attorney at Alexander Ramage Associates LLP
keith@ramage.co.uk
Keith is a Past President of ITMA.

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CTM SWISS CHEESE?

The Hugh Laddie Lecture recently considered whether CTMs still have unitary effect in the EU. Amanda McDowall was there

On 12 June 2013, Judge Joachim Bornkamm gave the Annual Sir Hugh Laddie Lecture, examining whether the Community Trade Mark (CTM) was a unitary right, and how the case law of the Court of Justice of the European Union (CJEU) tended away from the unitary model of the CTM, to incorporate the differing requirements of Member States' trade mark law and practice.

Judge Bornkamm, who has been the Presiding Judge of the First Civil Chamber (IP, Unfair Competition) of the German Federal Supreme Court since November 2006, and has held an Honorary Professorship at the University of Freiburg since March 2000, set out to explain why the principle of the unitary character of CTMs as laid down in the Regulation has developed holes that are reminiscent of a Swiss cheese. He illustrated his point by referring to issues of: distinctiveness and descriptiveness; what counts as genuine use of a trade mark; whether a mark has a reputation; and whether a mark has acquired distinctive character. He compared the approach relating to CTMs with examples from national German law, observing that both rights were, theoretically, territorially indivisible.

He discussed the approach relating to the distinctive character of CTMs, whereby it was necessary for a mark to be distinctive in all EU Member States. He compared this to the position under German law, which appears to equally regard a mark as descriptive where it is perceived as such, even regionally or by a proportion of the population.

In contrast, when considering reputation and genuine use of a trade mark, the CJEU follows a more territorially limited approach. Judge Bornkamm illustrated this with the Pago case, which decided that, for a trade mark to be considered to have a reputation, as is the case with national law, a large proportion of the relevant public would have to recognise the mark as having a reputation. In the Pago case, a large proportion of the Austrian public was deemed sufficient for the territory of the EU. Judge Bornkamm argued that this runs contrary to the unitary character of the CTM. He suggested that the threshold for determining whether a mark has a reputation in the EU should be higher.

He equally argued that the same non-unitary treatment was afforded to CTMs when considering genuine use. He said that the minimum threshold for showing that a trade mark had been put to genuine use in the EU was not clear, and indicated that this was interpreted differently across the Member States. He gave the example of the German Orion case, in which it was found that the import of 300 television sets to a storage warehouse in Germany, prior to export to other EU states, was sufficient for the purposes of demonstrating genuine use of a mark in Germany. Here it was stated that the use of a mark did not have to be in respect of a consumer to be genuine; what was important was to demonstrate that the registration of the mark was not for the purpose of economic abuse. However, he thought that the threshold for determining genuine use across the EU should be higher. He then highlighted the inconsistency of the CJEU's approach, referring to the DHL v Chronopost case, which took the view the CTM was a unitary right, by confirming that an injunction granted by a French court sitting as a CTM court was applicable to the entire territory of the EU.

> *Judge Bornkamm said that the minimum threshold for showing that a trade mark had been put to genuine use in the EU was not clear*

Theoretically, the CTM should function as a unitary right in the context of a single European market and without territorial limitation. However, given the number of Member States and their linguistic, legal and cultural variations, putting this into practice is more difficult. There is still a level of uncertainty, and whether the CJEU will take a more consistent approach remains to be seen.

Amanda McDowall
is a Trade Mark Attorney at Squire Sanders
amanda.mcdowall@squiresanders.com

IT'S ALIVE!

Is it safe to give abandoned brands new life? Carrie Bradley uncovers some answers

Recently our firm has seen an increase in enquiries regarding the possibility of resurrecting abandoned historic brands. In most cases, we have noted that the brands under enquiry have at one time been the subject of widespread notoriety in their field, often being recognised by a generation of consumers. If they were to be resurrected, there is no doubt that the new adopter would immediately benefit from some degree of instant recognition by nostalgic consumers. So does this practice fall foul of UK trade mark law?

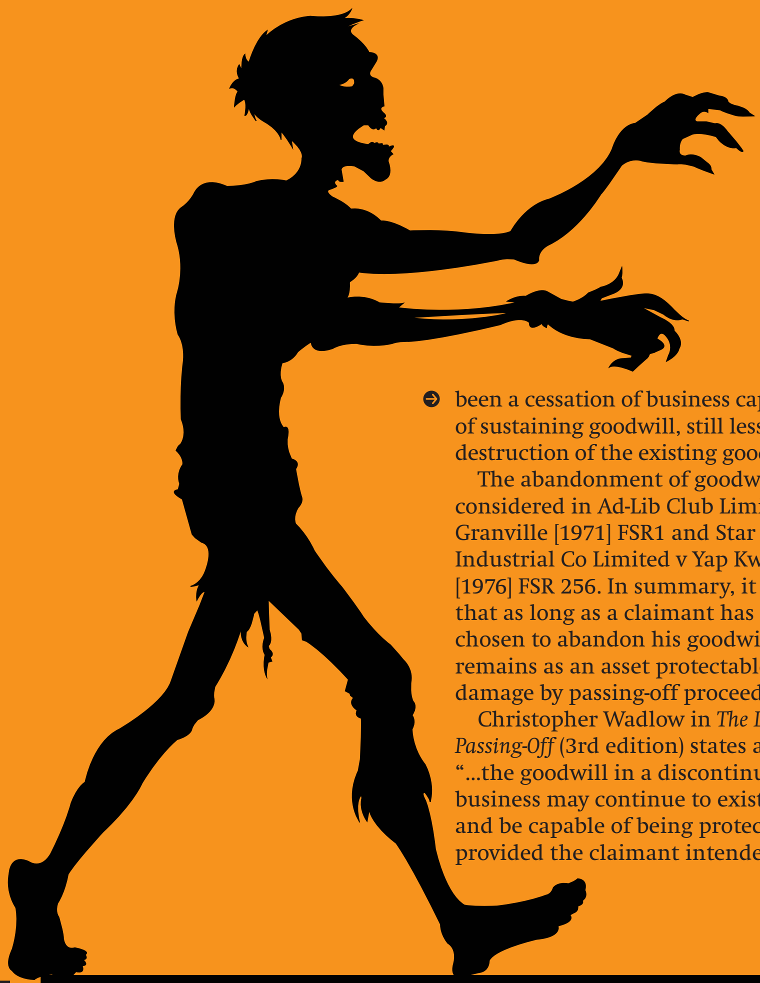
Legal implications

First and foremost, those seeking to breathe new life into orphaned high-profile marks need to be careful to guard themselves against allegations of passing-off and bad faith (assuming that any previous registrations have long since lapsed and therefore infringement is no longer a consideration).

The common-law tort of passing-off will protect an unregistered mark for as long as goodwill subsists in it. It is clear from established case law that such valuable residual goodwill may endure long after use of the mark was abandoned by the original owner and long after the business itself has ceased trading. Indeed, the degeneration of goodwill has been confirmed to be a gradual process.

In Maslyukov v Diageo Distilling Limited and another [2010] EWHC 443 (Ch), Justice Arnold found that the "mere cessation of business is not enough" for a finding that goodwill in a mark has been abandoned. He continued, "...cessation of production of goods or provision of services does not necessarily mean that there has

Those seeking to breathe new life into orphaned high-profile marks need to be careful to guard themselves against allegations of passing-off and bad faith



been a cessation of business capable of sustaining goodwill, still less a destruction of the existing goodwill."

The abandonment of goodwill was considered in Ad-Lib Club Limited v Granville [1971] FSR1 and Star Industrial Co Limited v Yap Kwee Kor [1976] FSR 256. In summary, it seems that as long as a claimant has not chosen to abandon his goodwill, it remains as an asset protectable from damage by passing-off proceedings.

Christopher Wadlow in *The Law of Passing-Off* (3rd edition) states at 3-178: "...the goodwill in a discontinued business may continue to exist and be capable of being protected, provided the claimant intended and still intends that his former business should resume active trading."

> *Those against the resurrection of abandoned trade marks argue that they give the new adopter an unfair advantage when launching their goods or services into the marketplace*

Kerly's Law of Trade Marks and Trade Names (15th Edition) advises (at para 18-060) that: "Where no positive decision is made to abandon goodwill, but trade under the mark has nonetheless ceased with no concrete plans for restarting operations, the question of whether any goodwill survives, and for how long, is a question of fact in each case." This view is supported by Sutherland v V2 Music Limited [2002] EMLR 28.

In Minimax GmbH & Co Kg v Chubb Fire Limited [2008] EWHC 1960 (Pat) Justice Floyd stated that it is difficult to determine a minimum threshold for a finding of residual goodwill. Authorities such as Knight v Beyond Properties Pty Limited [2007] FSR 34 support the view that the greater the reputation originally established, the longer it may be that residual goodwill may continue to exist.

A further factor likely to contribute to a finding of surviving residual goodwill is the extent to which the mark and its reputation have been kept in the public eye. For example, this may be achieved by way of a significant enthusiast following, a thriving second-hand market, and the ongoing provision of spare parts or servicing by the original owner.

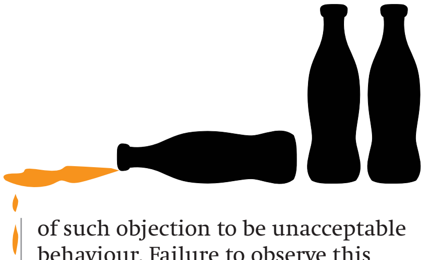
Opinion appears to be divided among trade mark commentators as to whether it should be possible for brands to be revived in this way.

Anti-resurrectionists

Those against the resurrection of abandoned trade marks argue that they give the new adopter an unfair commercial advantage when launching their goods or services into the marketplace, particularly where it is used for the same or similar goods or services as previously. They argue that the adopter is riding upon the coat-tails of the previous owner's existing reputation, benefiting from years of marketing and advertising expenditure; indeed, it is undeniably this that they seek to capitalise on by reviving the brand.

We are all familiar with the case of Gromax Plasticulture v Don&Low Nonwovens [1999] RPC 367, which defined bad faith as "dealings which fall short of the standards of acceptable commercial behaviour". It is easy to see why the adoption of an abandoned historic brand to benefit from the reputation that the mark previously enjoyed could easily be deemed to fall foul of such standards.

Furthermore, it is a fundamental tenet of trade mark law that marks must serve as a badge of origin. Assuming that the original owner has no connection to the new goods or services, including no control over their quality, then one could argue that the use of the mark could deceive and confuse the consumer, thereby undermining one of the core essential functions of the trade mark. That brand must have once been trusted as being an indication of origin from one particular source, but now those duplicated goods derive from another, entirely unrelated, source. For this reason, critics have dubbed revived marks as "zombie marks" – having died, and then been resurrected, but



all is not as it appears since they are not the same entities as once before.

Pro-revival arguments

Conversely, some argue that abandoned, lifeless brands represent wasted opportunities and that brand revival creates consumer choice and generates economic activity. Even if it is nostalgia that motivates the consumers to purchase, they are nonetheless being provided with the goods and services that they have missed and wish to buy.

The same policy considerations underlying the provisions for revocation of a registered mark on the grounds of non-use must surely apply to abandoned marks – namely that unused marks should not be permitted to block the legitimate exploitation of a brand by an active trader in the marketplace.

Some argue that if the original owner considered the brand to be commercially viable and valuable, then it should not, and would not, have abandoned it in the first place. However, the original cessation may have been forced upon the owner by external circumstances, and there might remain a genuine intention to resume business and active trading under the brand.

Practical guidance

We can only conclude that whether or not the resurrection of an abandoned brand is permissible will be highly fact-dependent in each case.

To unravel and interpret those facts, a meticulous process of due diligence must be advised and undertaken. Case law makes it clear that this obligation extends far beyond a simple check that a pre-existing registration has been allowed to lapse, and even that the entity or business concerned has ceased trading, as it is still entirely possible that residual goodwill subsists therein. It follows that a comprehensive use investigation should be undertaken.

The following step of the due diligence process must be for a proactive and direct approach to be made to the original owner to determine whether there would be any objection to the revival of the brand. Indeed, this may assist in rebutting an inference of bad faith. Past case law has demonstrated that the new adopter will be criticised for failing to contact the original owner to confirm if the mark has been abandoned and to ascertain if it has any future intentions for the mark. If the original owner does not, it is surely in its interests to capitalise on that asset by way of its licensing or sale to the new party interested in commercially exploiting it, rather than simply allowing it to fade into history or languish on financial balance sheets.

A further practical way forward may be for the new adopter to reintroduce the brand into the market with the original owner's collaboration, thereby also ensuring the same level of quality and so on.

If an approach to the original owner is met with stiff opposition, then the prospective adopter's original question has thereby been answered. Any reasonable person must consider the subsequent adoption of that brand in the face of such objection to be unacceptable behaviour. Failure to observe this refusal will undoubtedly result in expensive litigation from an enraged original brand owner.

Unfortunately, contacting the original owner may not always be so straightforward. If the company was dissolved, tracing any of its directors, or any possible successors in title (if the marks and goodwill were assigned to others), may not be easy or even possible. Obtaining the last accounts should assist in identifying the directors and the contact details of the accountants or auditors. In these circumstances, it will probably be sensible to employ the services of a professional investigator so that every possible avenue has been explored to try to identify and contact the relevant people, as far as can reasonably be expected.

Careful balance

While one may speculate that it is the recession that has caused these brands to fall victim to abandonment in the first place, the current economic climate may also be giving others the impetus to seek out new forms of commercial advantage.

Ultimately, whichever side of the argument you most empathise with, the law must carefully balance the interests of the original owner, the new brand adopter and the consumer. It seems that brand revival is a growing commercial practice, so it is likely that savvy new entrepreneurs seeking a foothold in the marketplace will continue to raise the question as to whether it is permissible with their trade mark advisors.

Carrie Bradley

is a Trade Mark Attorney and Head of Trademarks and Designs at LOVEN Patents & Trademarks Ltd

carrie.bradley@loven.co.uk

Carrie advises on IP protection, enforcement and dispute resolution. She specialises in trade marks, design and copyright.

PEER PRESSURE

Napster may seem like ancient history, but its echoes are still being felt by those tackling internet-enabled file sharing. George Sevier explains

In 2001, a US appeal court upheld a decision of the Federal Court ordering an injunction against Napster, a website that enabled users to see the MP3 files that other users had on their computers and use software to download copyright files from these peers. While Napster did not itself distribute copyright files, it was held to be a contributory infringer in this activity.

In the post-Napster era, owners of digital media have continued to take steps to curb the activities of websites set up for sharing copies of copyright material. But these websites can generate massive advertising revenues, so their operators have become more sophisticated in looking for ways in which to avoid the force of copyright law and the law has developed in turn.

Changing technology

Today, many file-sharing websites operate using the BitTorrent system, through which content files such as MP3s are split into smaller files ("chunks"). A website provides a "torrent" file containing information about the chunks to enable a program installed on the user's computer to download them directly from other users' computers (peer-to-peer). Neither the chunks nor torrent files contain infringing material, so file-sharing site operators do not infringe directly using this model. The downloader, however, is considered to have made a copy of the original file since its computer collates the chunks and constructs the copy file.

Site operators have sought to avoid liability for the users' infringement by drawing an analogy with CBS Songs v Amstrad [1988] 1 AC 1013. Amstrad was not liable for the infringements of the purchasers of tape-to-tape recorders since there were non-infringing uses of the recorders, and the decision to copy unlawfully was made by the purchaser. Therefore, while Amstrad enabled the copying, it did not authorise it. File-sharing websites however, have been considered to go beyond merely enabling infringement, since infringement is fundamental to their business model.

Recent cases

Section 20 of the Copyright, Designs and Patents Act 1988 ("CDPA"), implemented as a result of Article 3 of Directive 2001/29/EC (known as the Information Society – or InfoSoc – Directive), introduced a new form of copyright infringement. It provides that the right to communicate a copyright work to the public is an act reserved for the copyright owner, and is not exhausted by prior distribution.

The courts have adopted a three-part test for this infringement: (i) is there an electronic transmission; (ii) has there been a communication to a public that was not taken into account by the rights holder when authorising the distribution of the works (ie a "new public"); and (iii) did the communication take place in the UK?

Whether there is communication to a new public has been the subject of many references to the Court of Justice of the European Union (CJEU) in the past few years, and it now seems settled law that the recipients of music and movies obtained for free via file-sharing websites are a new public. This follows the logic of the CJEU in joined cases C-403/08 and C-429/08 FA, Premier League v QC Leisure, which considered the activities of a pub transmitting football matches that were intended to be watched in private homes, making the matches available to a new public in the pub.

In Dramatico Entertainment Limited v British Sky Broadcasting Limited [2012] EWHC 268 (Ch), which concerned The Pirate Bay, a website that enabled the download of various material, the Court concluded that an electronic transmission had been made to a new public, but it was unclear whether the communication was required to have taken place at the location of transmitting, or of receiving, the data. While immaterial so far as users were concerned (since UK users were involved as uploaders and downloaders), it was important to the operators of The Pirate Bay, since its servers were outside the UK. Case C-173/11, Football Dataco v Sportradar, concerned database rights rather than copyright, but the CJEU indicated that communication takes place at the location of transmission, and additionally in any place where the public is targeted.

Earlier this year, in EMI Records v BSkyB [2013] EWHC 379 (Ch), the UK public were considered to be targeted since: (i) there were many users in the UK; (ii) the websites were in English; (iii) a large proportion of the visitors to the websites were from the UK; and (iv) the websites listed recordings by UK artists that were in demand in the UK.

In Twentieth Century Fox v Newzbin Limited [2010] EWHC 608 (Ch) rights owners brought an action against the operator of the file-sharing website Newzbin ("Newzbin1"). An injunction was ordered, and Newzbin1 shut down. Soon after, a new website ("Newzbin2") opened at the same URL and operated in the same way, but this time it was based offshore, putting the operators out of reach of the UK courts. In theory, rights owners could take action against individual users in the UK, using Norwich Pharmacal-type orders to get internet service providers (ISPs) to disclose the identities of the users. But obtaining such orders and bringing actions against downloaders would have been expensive, would risk stigmatising the rights owners, and would be ineffective given the massive number of individual users.

The result then was that there was clear infringement on a large scale, but it was fruitless to take action against either the website operators (if they could be identified) or the users.

Involvement of ISPs

So what are the options open to rights owners? Rights owners are often choosing to seek injunctions against ISPs to get access to the sites blocked. Section 97A of the CDPA was implemented as a result of the InfoSoc Directive, and provides scope for an injunction to be granted against ISPs whose service is being used to infringe copyright.

In Twentieth Century Fox v BT [2011] EWHC 1981 (Ch) rights owners used section 97A to tackle the Newzbin2 website. They pointed to the finding of infringement in the Newzbin1, and since the site operated in the same way, they sought an order that BT should block access to the Newzbin2 website. The order was made, and similar orders were subsequently made against BSkyB and TalkTalk.

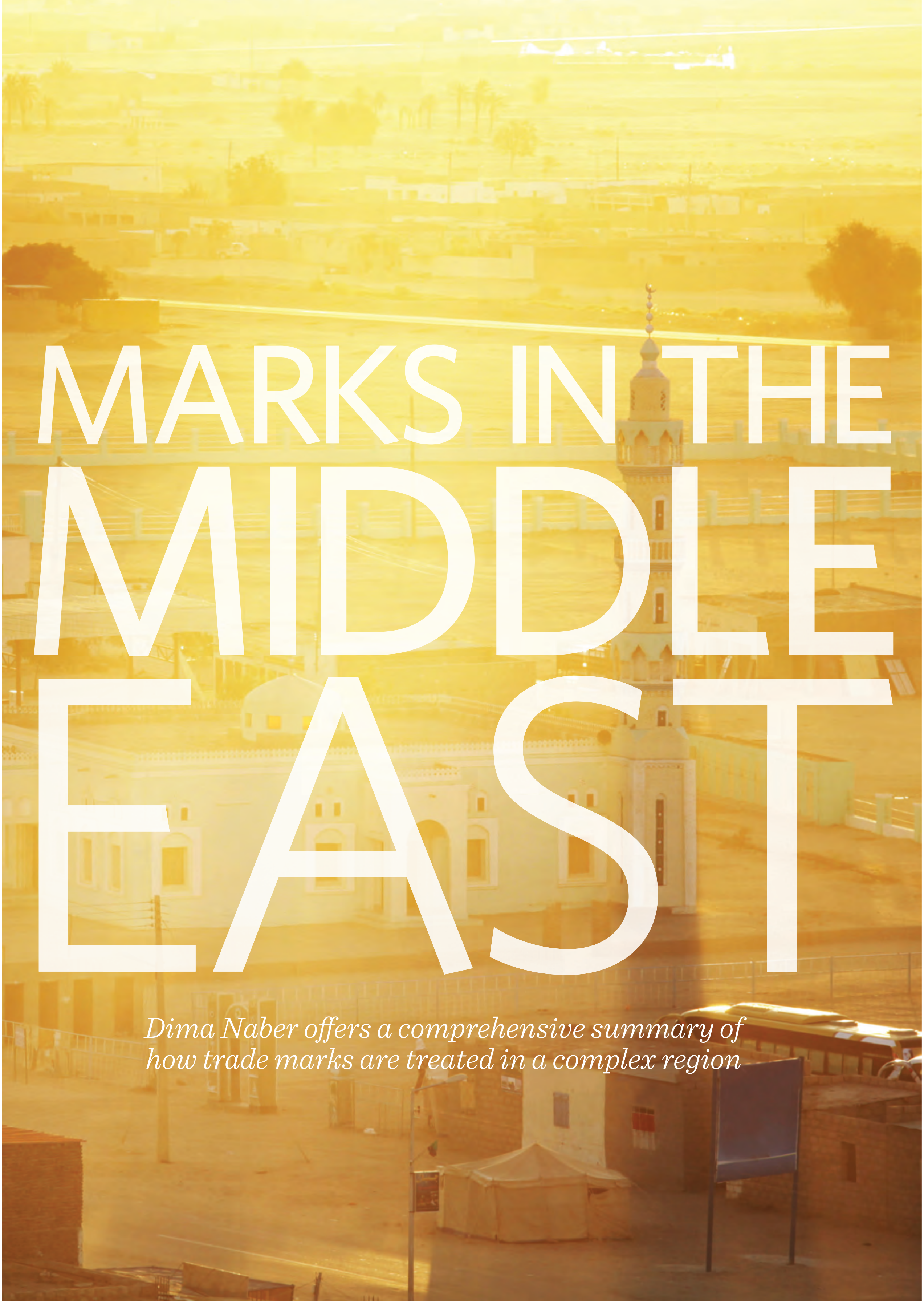
In the case of The Pirate Bay, again the website was based outside the UK and the infringers were unknown. The rights owners started proceedings against the UK's main ISPs. Unlike the Newzbin2 case, there had been no previous finding of infringement, so it was agreed that the issue of whether the users and/or the operators of The Pirate Bay infringed the Claimants' copyrights in the UK would be dealt with as a preliminary issue. The ISPs did not defend this preliminary issue and left it to the court to decide whether or not there was infringement. Infringement was found, and the court ordered the ISPs to block The Pirate Bay website.

In the EMI v BSkyB case, the ISPs and rights owners agreed the terms of the order up-front, and the Claimants used a simplified Part 8 court procedure to seek the courts' confirmation of infringement and an injunction under section 97A.

To date, section 97A has only been used to get ISPs to block file-sharing websites. Given that the process is now more straightforward, however, the process may well become more widespread, and may be used to block access to other websites that have the potential to facilitate infringement.

> *"It now seems settled law that the recipients of music and movies obtained for free via file-sharing websites are a new public"*

George Sevier
is an Associate at Wragge & Co LLP
george_sevier@wragge.com
George advises on IP issues ranging from high-tech patent litigation to providing commercial advice on advertising, marketing and merchandise licensing.



MARKS IN THE MIDDLE EAST

Dima Naber offers a comprehensive summary of how trade marks are treated in a complex region

The Middle East, with the opportunities it presents as a large and developing consumer market, is very attractive for multinational business. The expansion in major foreign investment has brought with it the requirement for high-value brands to gain appropriate IP protection, which has been reflected in a sharp rise in the number of protected trade marks across the region over the past two decades. In particular, at Abu-Ghazaleh Intellectual Property (AGIP) we've seen the greatest interest in filings in Jordan, the Arab Gulf States (Saudi Arabia, the United Arab Emirates, Qatar, Bahrain, Kuwait and Oman) and the North African countries, such as in Egypt, Morocco and Algeria.

The Arabic writing system is very different from Latin script... When simple translation cannot be applied, transliteration is needed

Although, geographically speaking, the countries of the Middle East belong to one region, no unified trade mark system can be said to be in force. National trade mark applications must be filed with national offices in accordance with the respective nation's trade mark law. This article highlights some important trade mark issues to consider when dealing with trade marks in the region, and looks at what can be protected and how.

Protectable signs

Commonly, any sign or combination of signs may be protected as a trade mark, provided that the criteria of distinguishing the goods or services of one undertaking from those of another are met. Such signs may be words, including personal names and slogans, letters and numerals, figures and pictures, two- or three-dimensional (3D) forms, colours, holograms, sound signals or any combination thereof.

There are some countries, however, in which not all of the signs mentioned above may obtain trade mark protection. Single-colour trade marks, for example, cannot be registered in Jordan, Oman, Saudi Arabia, Sudan, Syria, the West Bank, Turkey and Algeria, while certification marks cannot be registered in Iraq, Kuwait, the West Bank, Algeria, the Gaza Strip, Bahrain and Yemen. Similarly, the registration of 3D trade marks is not permitted in certain countries.

The borderline between what constitutes a 3D trade mark and an industrial design is sometimes difficult for companies to define. Generally, 3D marks are used to identify the goods or services of a company, whereas the design relates to the appearance of the goods. Trade mark and design protection are, however, not mutually exclusive, and it is possible to obtain both, although this is not the case in every Middle-East jurisdiction. For instance, there is no possibility to file a 3D trade mark application in Qatar, Iraq, Syria, the West Bank, the Gaza Strip, Pakistan, Jordan, Saudi Arabia and Yemen.

However, some of these countries do provide rights holders with alternative solutions under their respective national laws (see Figure 1, overleaf). In Iraq, for example, an ordinary figurative trade mark or industrial design application may be filed instead of an application for a 3D mark, while in Qatar a series of trade marks can be registered by using images demonstrating the different angles of the design.

Single- or multiple-class applications

The number of classes that may be covered by the application differs from country to country. In general, a separate application shall be filed with respect to each class of goods and services.

In the case of Iraq, the classes of goods and services are subdivided, with the local Iraqi classification being almost identical with the classification of the goods and services under the Nice Agreement.

Figure 5, overleaf, gives an indication of where single- or multiple-class applications are available in the Arab countries.

Arabic script – translation and transliteration

The Arabic writing system is very different from Latin script. In many cases, when simple translation cannot be applied, transliteration of the sign is needed when filing a trade mark application. In some countries the English version and its Arabic translation or transliteration constitute one trade mark application (for example in Algeria, Oman and Lebanon), while in other countries two separate applications must be filed – one for the English

Figure 1: 3D registration and alternatives

COUNTRY	3D TRADE MARK?	ALTERNATIVES
ALGERIA	POSSIBLE	
BAHRAIN	POSSIBLE	
EGYPT	NOT APPLICABLE	Not applicable
GAZA STRIP	NOT APPLICABLE	File as a 2D trade mark
IRAQ	NOT APPLICABLE	File as an industrial design or as a 2D trade mark
JORDAN	NOT APPLICABLE	File as a 2D trade mark and wait for the Registrar's feedback as it is highly expected to request a disclaimer for the general outside shape
KSA*	NOT APPLICABLE	File as an industrial design
KUWAIT	POSSIBLE	
LEBANON	NOT APPLICABLE	Register as an ordinary trade mark
LIBYA	POSSIBLE	
MOROCCO	POSSIBLE	
OMAN	POSSIBLE	
QATAR	NOT APPLICABLE	Register under a series of trade marks, reflecting the different angles of the design
SUDAN	POSSIBLE	
SYRIA	NOT APPLICABLE	Support the application with home or foreign registration certificate reflecting the same class

*KINGDOM OF SAUDI ARABIA

Figure 2: Translation and transliteration

COUNTRY	FILING AND SEARCH TRANSLATION IN ARABIC AND ENGLISH IN ONE APPLICATION	FILING AND SEARCH TRANSLITERATION IN ARABIC AND ENGLISH IN ONE APPLICATION
BAHRAIN	TWO SEPARATE APPLICATIONS	ONE APPLICATION FOR FILING; SEPARATE APPLICATION FOR SEARCH
JORDAN	TWO SEPARATE APPLICATIONS	ONE APPLICATION FOR FILING; SEPARATE APPLICATION FOR SEARCH
IRAQ	ONE APPLICATION	ONE APPLICATION FOR FILING; SEPARATE APPLICATION FOR SEARCH
KSA	TWO SEPARATE APPLICATIONS	ONE APPLICATION
MOROCCO	ONE APPLICATION FOR FILING; SEPARATE APPLICATION FOR SEARCH	ONE APPLICATION FOR FILING; SEPARATE APPLICATION FOR SEARCH
QATAR	TWO SEPARATE APPLICATIONS	ONE APPLICATION
UAE	ONE APPLICATION	ONE APPLICATION
YEMEN	ONE APPLICATION FOR FILING; SEPARATE APPLICATION FOR SEARCH	ONE APPLICATION FOR FILING; SEPARATE APPLICATION FOR SEARCH

Figure 3: Registration time frame

COUNTRY	OPPOSITION PERIOD	COMPLETING REGISTRATION TAKES (MONTHS)
BAHRAIN	60 DAYS	28-30
JORDAN	3 MONTHS	10-12
KSA	30 DAYS	12-18
MOROCCO	60 DAYS	4-6
QATAR	4 MONTHS	10-12
UAE	30 DAYS	9-12
YEMEN	90 DAYS	15

Figure 4: Weekend observed

BAHRAIN	FRIDAY & SATURDAY
JORDAN	FRIDAY & SATURDAY
KSA	FRIDAY & SATURDAY
MOROCCO	SATURDAY & SUNDAY
QATAR	FRIDAY & SATURDAY
YEMEN	THURSDAY & FRIDAY

Figure 5: Single- or multiple-class applications available in Arab countries

BAHRAIN	Single-class application
JORDAN	Single-class application
MOROCCO	Multi-class application
QATAR	Single-class application
LEBANON	Multi-class application
IRAQ	Single-class application*
UAE	Single-class application
YEMEN	Single-class application
SAUDI ARABIA	Single-class application

*CLASSES OF GOODS ARE SUBDIVIDED. FILING FEES DEPEND ON NUMBER OF GOODS UNDER SUBJECT CLASS version and one for the Arabic version of the sign (for example in Bahrain, Iraq and Saudi Arabia). See Figure 2, opposite, for details.

Alcoholic beverages

The registration of trade marks for alcoholic beverages is strictly regulated in certain countries. The registration of marks in class 33 for alcoholic beverages in general and in class 32 for beer is not permitted in Kuwait, Libya, Qatar, the Gaza Strip, Sudan, the United Arab Emirates, Yemen and Saudi Arabia. In Saudi Arabia, class 33 is completely removed from the list of goods and services available to be registered.

In the Persian state of Iran, the restriction is the most specific: filing an application for alcoholic beverages is considered illegal and therefore prohibited by law, and as such bears certain consequences. Just as in Saudi Arabia, class 33 does not appear on the list of goods and services capable of registration in Iran.

In other Arab countries, such as Algeria, Bahrain, Egypt, Iraq, Jordan, Lebanon, Morocco, Oman, Syria, Tunisia and the West Bank, filing applications for alcoholic beverages is permitted.

Period of registration

Generally speaking, the trade mark registration procedure takes one to two years in the Arab countries (see Figure 3). Lebanon, however, operates a so-called deposit system, which has the effect of significantly shortening the time frame involved, thereby allowing a trade mark registration to be completed within just two weeks. The trade mark is technically deemed as registered following the trade mark office's examination and acceptance of the application and the trade mark applicant's subsequent settlement of the fee for filing the registration. Furthermore, the fact that Lebanese law makes no provision for filing an opposition considerably reduces the period of registration.

Well-known marks

The protection of well-known marks is provided by law in many jurisdictions in accordance with international obligations set forth under the Paris Convention, irrespective of whether they are registered in the country in question. Well-known marks are protected, for example, in Jordan, Qatar and Saudi Arabia. The registration of well-known marks does not differ from the procedure for registering marks generally. The trade mark acts of certain Arab countries – most notably Lebanon, Algeria, the Gaza Strip and the West Bank – however, do not stipulate any specific legal regulations regarding well-known trade marks. Unregistered trade marks may be protected by unfair competition legislation of the respective country, for example, in Syria. It is important to note that the extent to which any given mark may be considered well known to the public shall be taken into account in case of legal action.

The Madrid System

Among the many benefits that multinational businesses may gain from the Madrid Protocol system, the most important is the opportunity to obtain trade mark protection in several countries simply by means of extending the protection granted from filing the initial application. In the Middle East and North Africa, Cyprus, Egypt, Iran, Sudan, Algeria, Morocco and Oman have all joined the Madrid Agreement, and Bahrain, Cyprus, Iran, Syria, Turkey, Morocco, Sudan and Egypt are signatories to the Madrid Protocol.

Deadlines and important dates

In the field of law, whether in terms of prosecution or litigation, deadlines are of considerable importance in protecting our valuables and meeting the legal requirements of proceedings. However, religious traditions may mean that the days considered as weekends and other rest days vary in different parts of the world. In countries in which the majority of the population is of the Muslim faith, the weekend usually falls on Thursday and Friday or Friday and Saturday. Certain countries, however, observe a one-day weekend on Friday and work a six-day week. Although any deadlines falling on these rest days or weekends, including priority deadlines, will be automatically extended to the next working day, it is always advisable to pay particular attention to the expiry of deadlines across the region.

Operating in an environment with such a diversity of regulations and IP systems can pose a great challenge for firms working in the region. AGIP continues to coordinate with Arab governments and international organisations to improve the infrastructure of IP in this emerging region, which is so full of opportunity.

Dima Naber
is the Clients Relations and Service Development Manager at Abu-Ghazaleh Intellectual Property (AGIP). **dnaber@agip.com**
Dima works with clients on their IP rights in the Middle East.

Dr Georgina Busku, Director of the Budapest office of AGIP, acted as co-author. **gbusku@agip.com**

GROUNDLESS THREATS: WHAT'S NEXT?

Colin Hulme revisits the topic of threats legislation, this time giving the Scottish view of proposed reforms

The English Law Commission's Consultation Paper (No. 212) 17 April 2013, "Patents, Trade Marks and Design Rights: Groundless Threats", has been prompted by a request by the Department for Business, Innovation and Skills and the UK IPO. The English Law Commission has suggested to me that the consultation would not have been undertaken if there were no real prospects of legislation to implement the Commission's subsequent recommendations.

The proposals take two approaches. The first, and by far the more likely, is incremental reform to bring trade mark and design rights threats rules more in line with the recently reformed patents rules. The second approach is to adopt the principles of the Paris Convention against unfair competition, which have been developed to protect traders against unjustified threats made to their customer base.

Reforms in summary

At a recent seminar of stakeholders in the Scottish IP community, led by the Scottish and English Law Commissions on the ongoing consultation, there was near-universal agreement that threats provisions, in some shape or form, remain necessary – primarily to protect businesses from unwarranted reputational damage where other remedies, such as defamation actions, don't quite fit the bill. The threats should prevent instances where customers in receipt of threats are inclined to take fright and cease to stock certain goods to avoid becoming embroiled in costly IP litigation in which they have no real interest.

The main impetus behind current amendments is the need to fine-tune the reconciliation between the right to litigate and the risk of unwarranted threats. It has been noted that there is a discord between the encouragement by the courts to engage in pre-action communications (although not mandatory in all cases) and the groundless threats laws, which can often force a matter to court earlier than the parties might otherwise wish as a result of the fear of a threats action. I'd like to highlight points relating to advisor liability, uniformity and the review of trade marks.

Drop advisor liability?

The proposal here is that Solicitors and Patent and Trade Mark Attorneys would not incur liability through issue of a threats letter if it is done in their professional capacity. Such provisions exist in Australia and India.

It was most reassuring and revealing that this topic was only very briefly debated at our meeting. I took this to mean that there can be no real opposition to this proposal (certainly not among that group of authors of such letters). It is perceived as a change clearly needed. While it has been said that "if something is a threat in the mouth of a layman, it is an even more potent threat in the mouth of his solicitor",[1] it seems illogical that a solicitor's protection from personal liability, when acting in good faith for a disclosed principal, should be disapplied in instances of IP disputes.

Making a claim for passing-off is not always a satisfactory alternative and can lead to confusion and drawn-out negotiations, where the real claim lies in registered IP infringement.

Uniformity

There is also a need to unify the rules between trade marks, patents and design rights. The disparities between the threats rules present risks for even experienced IP practitioners. The general consensus from the seminar was that the direction taken in the Patents Act reforms was correct, albeit by no means without flaws. The amended section 70 contains important exemptions for those wishing to assert that rights exist and to enable enquiries to be made to identify the primary infringer. It was my perception that the Law Commission will make general recommendations for trade marks and design rights laws to follow the lead of patents.

Review of trade marks

Primary infringer

In its present form, section 21 of the 1994 Act provides that claims made in relation to application of a registered mark to goods or their packaging, as well as the importing of goods that have the mark applied to them or their packaging, would not be actionable. This means that a letter before action sent to such a primary infringer that slips into referring to sale or marketing of those goods would be actionable.

The English Law Commission proposes to extend this exemption to all threats made to such a manufacturer or importer, which seems entirely logical. A further broadening of the cover is proposed to include those who intend to make or import infringing goods. Provided that the allegations are being directed to the primary source of the infringing activity, objection should not be taken.

Approaches to secondary infringers

Often IP infringement is only detectable at the point of retail. Tracing the primary infringer up the supply chain can be impossible.

Patent legislation allows for the making of enquiries to secondary infringers to establish the identity of the primary infringer without fear of liability. This is particularly useful when the primary infringer acts as distributor only and does not interact with the public at large, making it difficult to ascertain its identity. In certain cases the identity of the true primary infringer can be concealed within complex corporate group structures that are unfathomable from the outside. An ability to make legitimate enquiries would be most welcome.

> *Making a claim for passing-off is not always a satisfactory alternative and can lead to confusion and drawn out negotiations*

Introduced into patent legislation in 2004, this approach has worked well in practice. The ability to strike at the root of the supply chain is the most efficient and effective way of resolving the infringement.

However, enquiries that go beyond a simple questioning as to the identity of the primary infringer have been met with hesitance. Although it was suggested that there would be a requirement to act in good faith, there is a concern that extending the exception is a step too far – enquiries beyond "Who is your supplier?" can be seen as a threat.

The Commission acknowledges that there may be other circumstances where brand holders may wish to contact secondary infringers. I can think of many circumstances where that would be appropriate, but as soon as we open this up we create opportunities for abuse. If such approaches were exempt, you can imagine the effect a mass mailing of offers to licence, perhaps at punitive terms, would have on a market of secondary infringers. If the Commission does introduce such exemptions they will need to be limited by good faith or legitimacy requirements.

Service exemption

Of course, one exemption from section 21 is if the alleged infringing activity is concerned with the supply of services under a registered mark. It has been questioned whether this broad exemption is justified. *Kerly's Law of Trade Marks* supports it, arguing that threats in relation to services "do not present the same danger of damage as threats in relation to goods". This is because, unlike goods, services are not passed down a supply chain. But perhaps that is no longer the case? In our increasingly brand-dominated society the importance of the logo on our coffee or burger is of great influence.

A proposal has been made to restrict the services exclusion to primary infringers who have taken the commercial decision to brand their services with the mark.

The consultation closed on 17 July 2013. I hope you took the chance to contribute on this important issue.

1) HVE v Cuffin Holdings [1964] WLR 378

Colin Hulme
Colin Hulme is a Partner at Burness Paull LLP
colin.hulme@burnesspaull.com

Louisa Mann, Solicitor, Burness Paull LLP, acted as co-author
louisa.mann@burnesspaull.com

BITTER TRUTH FOR CAFÉ CHAIN

Gladys Mirandah explains a case that centred on the issue of similarity

In the recent decision in the case of Sarika Connoisseur Café Pte Limited v Ferrero SpA [2012] SGCA 56, the Singapore Court of Appeal ("the Court") clarified the factors to be considered under section 27(2)(b) of the Trade Marks Act ("TMA") to establish infringement where a similar sign was used for similar goods. Ferrero SpA ("the Respondent") brought an action against Sarika Connoisseur Café Pte Limited ("the Appellant"), the owner and operator of the Connoisseur Concerto chain of cafés in Singapore, for the infringing use of its Nutella trade marks.

The Appellant promoted and sold a drink containing coffee and Nutella under the Nutello sign in its cafés in Singapore. The Respondent is the proprietor of the Nutella trade marks, including the word mark NUTELLA in class 30 for confectionery, baking powder, chocolate products and cream comprising cocoa with or without other ingredients.

While the Court clarified several principles, this article will focus on how it dealt with the test for establishing infringement by similar goods.

Assessing similarity

In determining whether a sign and a mark are similar, it is established that the Court will consider visual, aural and conceptual similarity.

The Court clarified that the distinctiveness of the mark, while important, is not a separate aspect from the three elements of similarity. It is, instead, a factor to be considered. The Court stated that the more distinctive a registered trade mark is, the more essential it was to show sufficient alteration or difference in the sign so as not to be considered similar.

The Court agreed with the High Court that the Nutello sign and NUTELLA were visually and aurally similar, but did not consider them conceptually similar, finding that Nutella and Nutello are invented words without meaning and underlying ideas. Accordingly, it was difficult to determine a concept common to them. Due to the nature and use of the Nutello sign and NUTELLA, visual and aural similarity was considered more important than conceptual similarity. Given this and the distinctiveness of NUTELLA, the Court found that similarity of the Nutello sign and NUTELLA was established.

The Court considered whether the goods were similar. Infringement under section 27(2)(b) of the TMA requires that there is similarity between the goods and services for which the offending sign is used and those for which the mark is registered. NUTELLA was registered in class 30 for chocolate products. The Court considered whether the Nutello beverage could be considered a chocolate product, and was persuaded by evidence that, while not identical, it was similar to chocolate products and that Nutella and the Nutello beverage were similar.

> *The more distinctive a trade mark is, the more essential it is to show alteration or difference in the sign so as not to be considered similar*

Confusion test

It is settled law that the test for determining the likelihood of confusion is whether a substantial portion of the relevant public would be confused. In considering what constitutes a substantial portion, the Court stated that the standard is above *de minimis*, though it is not necessary to show that the majority would be confused. Both parties' survey evidence showed 30 per cent of the relevant public was likely to be confused and the Court held that this constituted a substantial portion.

The Court further clarified whether factors beyond the goods and the marks themselves should be taken into account when determining confusion. Its view was that extraneous factors should be taken into account so that the Court can take a holistic view of the circumstances. In this case, the Court considered that there was a likelihood that a substantial portion of the public would be confused and concluded that infringement of NUTELLA was established.

Although cases concerning similar signs for similar goods will always leave room for argument, the Court has provided some helpful guidance on what is relevant for consideration.

Gladys Mirandah
is the Director of Patrick Mirandah Co.
gladys@mirandah.com

Karla Tuck, Legal Specialist at Patrick Mirandah Co. (Singapore), acted as co-author. **karla@mirandah.com**

CASE IN POINT

0/165/13, Application 2571611 (ZIP) in the name of Allied Global Tobacco Limited and Opposition 102171 thereto by Zippo Manufacturing Company, Appeal to the Appointed Person (Amanda Michaels), 23 April 2013

Appeal succeeds for Zippo

Sharon Daboul reviews another question of confusion for the court

This case was a successful appeal to the Appointed Person by the Opponent. The Hearing Officer had rejected an Opposition by Zippo Manufacturing Company ("Zippo") to the registration of the word mark ZIP by Allied Global Tobacco Limited ("Allied").

The Hearing Officer had found that there was no likelihood of confusion between the applied-for mark for tobacco products and four earlier ZIPPO trade mark registrations covering various goods in class 34 including "lighters, cigarette papers and smokers' articles".

On appeal, the Appointed Person concluded that there had been material errors of principle and genuine errors of approach made by the Hearing Officer in the earlier decision, that there was a likelihood of confusion between the marks ZIP and ZIPPO, and that the opposition should proceed.

Shedding light on the case

In his comparison of the marks, the Hearing Officer found a "reasonably high degree" of visual and aural similarity on the basis that the ZIP element was shared and would be pronounced identically. In terms of conceptual similarity, the Hearing Officer concluded that the marks ZIP and ZIPPO were "neither similar nor dissimilar". Overall, he deemed there to be a "moderate level of similarity" between the marks. He went on to find that although the level of consumer attention may be higher for tobacco products than for other consumer goods, the goods shared a "moderate degree of similarity". He came to the conclusion that while ZIP may bring the earlier mark ZIPPO to mind, the consumer is not likely to confuse the marks.

One of Zippo's arguments on appeal was that it was inconsistent to find that the marks have a reasonably high degree of visual and aural similarity yet to find only moderate overall similarity due to the neutral conceptual confusion. The Appointed Person agreed with Zippo that it was not logical to conclude that the lack of conceptual similarity produced a lower level of similarity between the marks overall and referred to the importance of the global appreciation test. She found this to be a genuine mistake in approach on the part of the Hearing Officer and a material error.

Zippo submitted that this error was carried through into the Hearing Officer's overall assessment test. The Appointed Person agreed that the Hearing Officer had given undue importance to the lack of conceptual similarity, such that he had made an error of approach in his assessment of the global appreciation of a likelihood of confusion between the marks.

Finally, Zippo submitted that the Hearing Officer had not given due weight to the high level of distinctiveness of the earlier ZIPPO marks. The Hearing Officer had proclaimed the ZIPPO marks to be inherently distinctive and earlier in his decision had found there to be a reputation in the UK for lighters. However, when it came to assessing the likelihood of confusion on the global appreciation test, the Hearing Officer had not given sufficient weight to the distinctiveness of the earlier marks in his decision. It is established case law that there is a greater likelihood of confusion where an earlier mark has a highly distinctive character. The Appointed Person agreed that this was another material error.

Conclusions

The Appointed Person felt it sufficient to substitute her own conclusions on the likelihood of confusion. She considered the reasonably high level of visual and aural similarity between ZIP and ZIPPO, the degree of similarity between the goods in class 34, particularly their method of sale, the moderate degree of attention paid by the average consumer of the products, and the highly distinctive nature of the earlier ZIPPO marks.

In the Appointed Person's view, consumers may mistake ZIP for ZIPPO or they may find a trade connection between the two companies. It was on this basis that the Opposition succeeded.

This case is a useful reminder of the considerations relevant to the likelihood of confusion test under section 5(2)(b) of the Trade Marks Act 1994. The assessment of confusion must be balanced, with correct weight given to the visual, aural and conceptual similarities, ie not placing too much weight on the lack of conceptual similarity between trade marks.

Sharon Daboul
is a Registered Trade Mark Attorney at MW Trade Marks
sharon@mwtrademarks.com
Sharon has experience in handling UK, Community Trade Mark and international trade mark portfolios, including searches, filing, prosecution and maintenance of trade mark rights.

CASE IN POINT **O/214/13**, LOVE, Opposition, UKIPO, 21 May 2013

Love is a battlefield

Whether adult products were complementary was one of the key issues in this case, reported by Emma Reeve

LRC Products Limited ("LRC") is the registered proprietor of a Community Trade Mark ("CTM") Registration No 3052768 LOVE [word] in classes 5 and 10 for, *inter alia*, liquids and creams, hygienic lubricants and condoms, contraceptive, hygienic or prophylactic devices, as well as UK Trade Mark Registration No 2433028 WE MAKE LOVE [words] in classes 3, 5 and 10 for, *inter alia*, lubricants for personal use, condoms, body massagers and vibrators. LRC opposed Application No 2519091 LUV [word] filed in the name of Ms Sandra Amalia Mary Elliott in class 10 for, *inter alia*, massage instruments, sexual massage devices, vibrators and sex toys.

LRC opposed the application on the grounds of section 5(2)(b) of the Trade Marks Act 1994 ("TMA") because it asserted that there would be a likelihood of confusion with its earlier marks.

LRC submitted that the earlier marks and the later mark are phonetically and conceptually identical, and the goods in the application were complementary to those of the earlier marks. In opposition proceedings the Hearing Officer rejected the opposition and allowed the application to be registered.

LRC appealed against the decision on the grounds that the Hearing Officer had erred in her decision in the following respects:

1) in the approach to application of the principles relating to complementarity;
2) in the emphasis given to the visual appreciation of the marks; and
3) in the evaluation attributing no distinctive character to the earlier mark.

Daniel Alexander QC, hearing the appeal, considered each ground in turn.

Complementary goods

Alexander commented that the Hearing Officer's reasoning relating to the use of condoms, lubricants and vibrators together appeared to take the complementary test to a new level. The Hearing Officer questioned and answered whether the goods are used together.

Alexander disputed the Hearing Officer's finding that it is not necessary to use the goods together. He held that the evidence shows that vibrators are commonly purchased for use by couples who may use condoms on the same occasion a vibrator is used. He stated that the evidence established that lubricants are likely to be used with vibrators and similar products. Alexander concluded that the Hearing Officer's approach was incorrect in the finding that the goods are not complementary.

The Hearing Officer concluded that the methods of use of condoms, vibrators, lubricants and sex aids are different, and are not in competition with one another.
In the appeal to the opposition decision Alexander drew a comparison between the goods at issue and cricket equipment. He explained that cricket bats, cricket pads and cricket nets enable people to play cricket. Likewise, condoms, lubricants and vibrators are all goods that are to be used for an intended purpose of lovemaking.

Visual appreciation

The Hearing Officer summarised that the marks LOVE and LUV are aurally and conceptually identical. Alexander commented that the marks are not conceptually identical. His reasoning was that LUV is the slang version of LOVE. It was held that the marks were visually similar.

LRC criticised the Hearing Officer for emphasising the visual aspect of the purchasing process for the goods in issue. At appeal Alexander asserted that there was no convincing evidence that word of mouth plays a role in the purchasing of such goods. It was concluded that the spelling of LUV and LOVE would come to the consumers' attention, as the marks would be predominantly recognised visually. It is true that there are visual differences between LOVE and LUV. It is submitted that LRC was right to criticise the Hearing Officer's emphasis.

The Hearing Officer at first instance held that the evidence from both parties showed that the purchasing process for these goods is visual. If the evidence shows that the average consumer relies heavily on the visual appearance of the brand, the question that then must be asked is why so little emphasis was placed on the interchangeable use of LOVE and LUV.

In the UK Trade Marks Manual, at the heading "PHONETIC EQUIVALENTS of objectionable words (misspellings)", paragraph 3 reads:

"With the advent of sending text messages via mobile phones, a virtually completely new language has evolved, centred around using abbreviations rather than the full word. Indeed there are dictionaries available which detail the meanings of such abbreviations. Further, goods and services are now commonly promoted through advertisements in the form of text messages delivered to mobile phones."

It is submitted that, although this guidance is in reference to the registrability of words, it should be taken into account when assessing the similarity of a normal word and an abbreviated slang version of the same word. In innovative branding and advertising there is a strong possibility that a slang word would be substituted for a normal word.

The Court of Justice of the European Union in Sabel BV v Puma AG has confirmed that it is not enough to conclude that marks are similar when the later mark brings to mind the earlier mark. There is prevalent use of abbreviated words. It is submitted that when an abbreviated word is used there is recognition that the word is an abbreviation of a normal word. Such recognition is made by eye. The recognition cannot be made by phonetic differences because the words are phonetically identical. Bearing in mind the widespread use of abbreviations, it is possible that a consumer relying on the imperfect picture is likely to be confused.

This decision highlights the difficulties in the decision-making process of the use and registration of a trade mark

Descriptiveness

LRC's final ground of appeal was the Hearing Officer's approach to assessing the distinctive character of the earlier mark and that the evaluation amounted to attributing no distinctive character to that mark. Alexander upheld the Hearing Officer's decision and drew attention to the fact that "LOVE" for the goods in issue is weakly distinctive.

Alexander concluded that as the goods are used in the course of making love, an average consumer would not assume that there is an economic link between the two marks and therefore there is no real risk of confusion. On appeal, the point was made that the importance of the descriptiveness of the mark was dependent on the facts. Alexander also claimed that it is futile to search for principles in this area of law. It is submitted that, although these cases are fact-dependent, this does not assist a trade mark owner looking for certainty, and the matter therefore has to be decided by the courts.

Dismissed

The appeal was dismissed on the basis that the marks are sufficiently different to avoid confusion. However, this decision highlights the difficulties in the decision-making process of the use and registration of a trade mark for a trade mark owner and its advisors.

Emma Reeve
is a Part-qualified Trade Mark Attorney at Groom Wilkes & Wright LLP
ereeve@gwwtrademarks.com

CASE IN POINT **[2013] EWHC 1291 (Ch)**, Interflora Inc and Interflora British Unit v Marks and Spencer plc and Flowers Direct Online Limited, High Court, 21 May 2013

More fight for Interflora

The most recent blows thrown in this floral fracas, summarised by Stephanie Burns

Although widely reported, a recap of the case is as follows: Interflora runs a flower delivery service and owns Community and UK trade mark registrations for INTERFLORA ("the Interflora marks"). Marks and Spencer ("M&S") also sells flowers for delivery from its website. M&S purchased the "interflora" keyword via Google's AdWord program and advertisements for M&S were displayed in sponsored links whenever a user entered the search term "interflora" into Google.

Interflora brought an action against M&S on the basis that use of the keyword "interflora" in this way was an infringement of the Interflora marks. Following a reference to the Court of Justice of the European Union (CJEU), the case returned to the UK courts for a decision on the facts.

Latest developments

Justice Arnold provided a useful summary of the evidence presented at trial. In particular, noting that members of Interflora's network typically displayed Interflora branding, but were not allowed to brand themselves as Interflora. It was also noted that Interflora had existing relationships in place with several large retailers.

Finally, Arnold J turned to Google's AdWords program, specifically noting that due to a policy change in May 2008, third parties were free to bid on keywords registered as trade marks – including for use in relation to goods or services for which the trade marks were registered.

Arnold J turned then to a review of the relevant legislation. To succeed in a claim under Article 5(1)(a) of the Council Directive 2008/95/EC ("the Directive") or Article (1)(a) of the Council Regulation 40/94/EC ("the Regulation"), it is necessary to satisfy the following six conditions: (a) there must be use of a sign by a third party within the relevant territory; (b) the use must be in the course of trade; (c) it must be without the consent of the proprietor of the trade mark; (d) it must be of a sign that is identical to the trade mark; (e) it must be in relation to goods or services that are identical to those for which the trade mark is registered; (f) it must affect or be liable to affect the functions of the trade mark. In the present case, it was clear that points (a) to (e) were satisfied. With respect to point (f), Interflora alleged that M&S's use of the keyword "interflora" affects or is liable to affect the origin and investment functions of its trade marks, whereas M&S relied on the fact that the CJEU has held that keyword advertising has no effect on the advertising function.

> *M&S had not done enough to ensure that it would be clear from its advertisements that the goods and services it offered were not connected with Interflora*

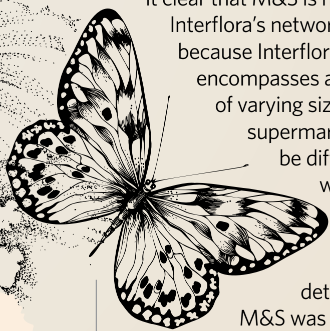
Turning to Article 5(2) of the Directive or Article 9(1)(c) of the Regulation, Arnold J considered that four requirements must be satisfied to succeed, namely: (a) the trade mark has a reputation in a particular territory; (b) the sign gives rise to a link between the sign and the trade mark in the mind of the average consumer, even if the consumer is not confused; (c) the trade mark proprietor must establish the existence of either detriment to distinctive character, detriment to the repute of the mark and unfair advantage taken of the distinctive character or the repute of the mark; and (d) the use of the sign is without due cause.

Arnold J also considered the case of C-236/08, Google France v Louis Vuitton (among others), in which the

Court held that the function of indicating origin of a trade mark is adversely affected if the advertisement does not enable normally informed and reasonably attentive internet users (or enables them only with difficulty) to ascertain whether the goods and services referred to in the advertisement originate from the trade mark proprietor or an economically linked entity, or a third party. Furthermore, if the advertisement appears on screen immediately after the entry of the trade mark as a search term, the internet user may be unsure of the origin of the goods and services. Therefore, use of another's trade mark is liable to create an impression that there is a link between the goods and services in question and the trade mark proprietor. It was concluded that if an internet user is unable to determine whether there is a link between the goods and services offered in the advertisement and the trade mark proprietor, the conclusion must be that there is an adverse effect on the function of the trade mark.

In reaching his decision, Arnold J responded to the key factors as identified by the CJEU:

a) Whether the well-informed and reasonably observant internet user is aware that M&S's flower delivery service was not part of the Interflora network, but in competition with it. Arnold J concluded that this was not generally known as of May 2008 (the date of Google's policy change), nor was he satisfied that it was generally known as of the date of the decision.
b) Whether M&S's advertisements enable the well-informed and reasonably observant internet user to ascertain whether M&S's flower delivery service is part of the Interflora network, but in competition with it. Arnold J was not persuaded by M&S's argument that because its advertisements did not appear in the natural results, but in the sponsored links, that it was clear that its advertisements were those of a competitor. Instead, Arnold J considered that there was nothing in M&S's advertisements that makes it clear that M&S is not part of Interflora's network. Furthermore, because Interflora's network encompasses a range of retailers of varying sizes, including supermarkets, it may be difficult for the well-informed and reasonably observant internet user to determine whether M&S was part of the Interflora network, particularly if there is no indication from the advertisement.
c) The CJEU noted that the nature of the Interflora network makes it difficult for the well-informed and reasonably observant internet user to determine whether (in the absence of any information in the advertisement to the contrary) M&S was part of the network. Arnold J agreed with this view and reiterated that because the members of Interflora's network are not branded as "Interflora", and because Interflora has arrangements with large retailers, it would be plausible to consider that M&S was indeed part of its network.
d) Finally, it was held that if it was not clear to the well-informed and reasonably observant internet user whether the advertisement generated as a result of the use of the sign originates from the trade mark proprietor, a connected undertaking or a third party, such use will be liable to adversely affect the origin function of the trade marks concerned.



On this basis, Arnold J concluded that M&S had infringed Articles 5(1)(a) of the Directive and 9(1)(a) of the Regulation. Arnold J dismissed Interflora's arguments in respect of Article 5(2) of the Directive and 9(1)(c), largely because he was not convinced that M&S's use of the Interflora marks was without due cause.

The case clearly turned on the specific facts of Interflora's business and the fact that members of its commercial network continue to use their own names. M&S had not done enough to ensure that it would be clear from its advertisement that the goods and services it offered were not connected with Interflora, or that M&S was not a member of the Interflora network.

At the time of writing, M&S has been given permission to appeal, to be heard in January 2014.

Stephanie Burns
is a Trade Mark Attorney at Berwin Leighton Paisner LLP
stephanie.burns@blplaw.com
Stephanie works in the London office of BLP's IP team and advises clients on a range of trade mark issues in a variety of industry sectors.

O/219/13, The Unite Group PLC v Unite the Union, Appeal to the Appointed Person Anna Carboni, UK IPO, 17 May 2013

Unite marks cause for discord

Chris Hawkes of Stobbs IP, discusses a case where potential tarnishment was top of the agenda

This case concerns an Appeal from a Registry decision under section 5(3) of the Trade Marks Act 1994 ("the Act"), in particular in relation to its findings on "tarnishment".

Unite the Union ("Union") – formerly Amicus – applied to register two marks, the subject of UK Application numbers 2453838 (figurative mark, shown below) and 2453833 (word mark). Unite is the largest trade union in the UK.

The Unite Group PLC ("Group") is concerned in development, management and co-investment in commercial and residential property developments, and lets out property to students. Group opposed both of Union's applications under sections 5(2)(a), 5(2)(b), 5(3) and 5(4)(a), on the basis of its own UNITE marks, including 2401561 shown below.

Group's opposition was upheld in part under section 5(2)(a) (in the case of application number 2453833) and section 5(2)(b) (in both cases), where there was good overlap in the goods and services specifications of the respective marks for comparison. Group's section 5(4)(a) case was found to be no more beneficial, and so was not dealt with.

Group's opposition under section 5(3) was found to fail. In particular it was found that Union's use of its marks applied for would not be detrimental to the repute of the earlier marks relied on by Group. Group appealed to the Appointed Person ("AP"), in an attempt to limit the scope of Union's eventual registrations or to stop its registrations altogether.

Section 5 (3)

Notwithstanding the ultimate finding of the Registry Hearing Officer ("HO") in respect of section 5(3), the HO decided that Group's marks enjoyed a reasonably high degree of inherent distinctive character, enhanced through use, that each had a reputation for the purposes of section 5(3) in relation to "the provision of serviced accommodation to students", and that Union's marks were identical or similar. These findings were accepted by both parties for the purposes of the Appeal.

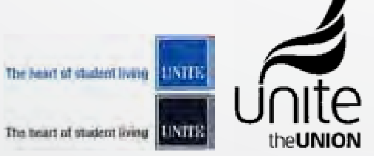
At Appeal, the HO's previous finding that Union's marks may bring to mind Group's marks, and thus there was a link, was relied on by Group and uncontested by Union. As Union did not raise a defence of due cause, the "without due cause" requirement was not dealt with by the HO or AP. Group's appeal therefore was directed solely at the HO's finding of lack of detriment to repute of the earlier marks.

Grounds of appeal

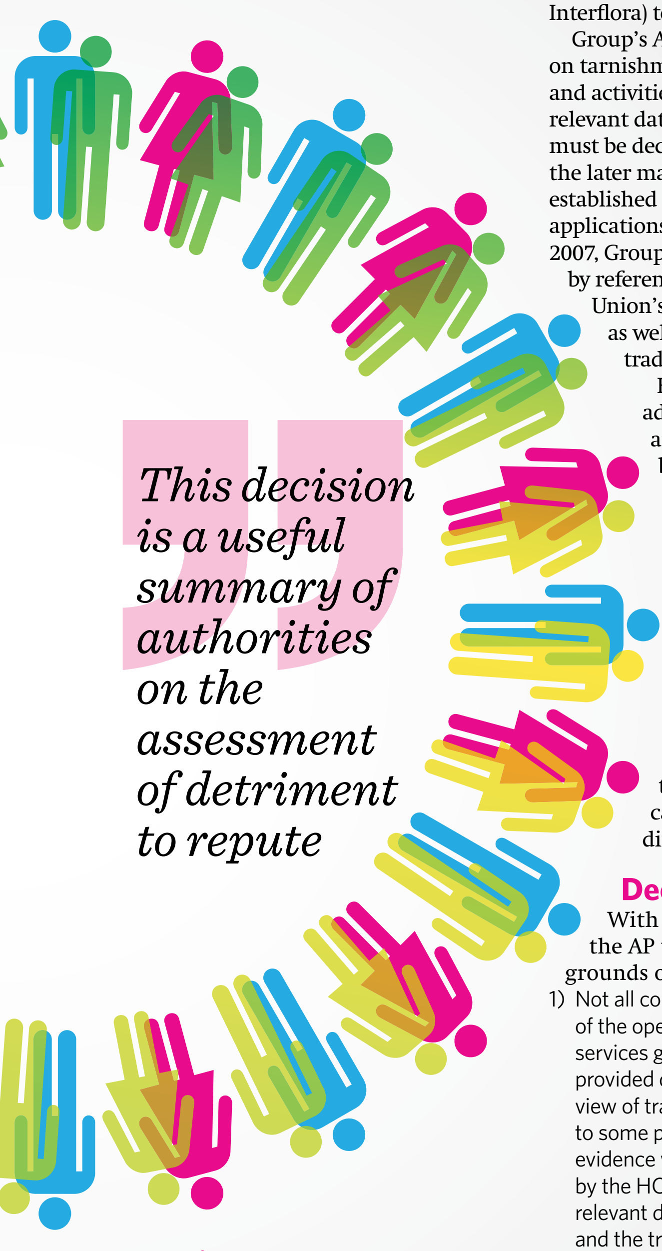
Group's appeal was founded on four grounds, in summary:

1) The HO failed to give correct regard to evidence of the public's negative perception of Union's activities.
2) The HO imposed too high a burden of proof on Group, whereas the grounds under section 5(3) could have been made out based on an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector, as well as all other circumstances of the case.
3) The HO was wrong to require Group to show there would be a change in economic behaviour of the consumer for the purposes of the claim of detriment to repute.
4) The HO did not properly consider the goods or services for which Union sought protection when assessing the risk of detriment to repute.

CONTESTED FIGURATIVE MARKS



UK 2401561 2453838



> *This decision is a useful summary of authorities on the assessment of detriment to repute*

Detriment

Before making a finding in respect of the appeal grounds, the AP looked at the facts to be considered in oppositions that allege detriment to repute.

Court of Justice of the European Union (CJEU) authorities Intel and L'Oréal v Bellure focus attention on the likely perception of the public of the goods or services for which the later mark will be used, and in particular whether those goods or services possess a characteristic or quality that gives rise to the likelihood of detriment ("tarnishment" in Interflora) to the repute of the mark.

Group's Appeal, however, was based on tarnishment given Union's identity and activities. In oppositions, the relevant date upon which section 5(3) must be decided is the filing date of the later mark. As Union had been established from May 2007 and its applications were filed on 26 April 2007, Group attempted an argument by reference to the context of Union's identity and activities, as well as the activities of trade unions generally.

However, authorities advanced by both Group and Union, were all found by the AP to confirm Intel and L'Oréal v Bellure – thus context such as identity and activities appear not to be strictly relevant in oppositions.

The AP acknowledged there may be some narrow exceptions in which context could be relevant to the assessment under section 5(3), but stated that the facts of the present case did not justify a different conclusion.

Decision

With tarnishment considered, the AP turned to each of the grounds of appeal, and decided:

1) Not all consumers would disapprove of the operations of Union, or of its services generally. The evidence provided did indicate some negative view of trade unions, but also pointed to some positive activities – the evidence was only briefly reviewed by the HO, but correctly. At the relevant date Union did not exist, and the trade marks applied for had not been used – so the consumer, at the relevant date, would not have had a negative reaction.
2) An Opponent must produce *prima facie* evidence of a future risk, which is not hypothetical, of unfair advantage or detriment. A conclusion of future risk may be established, in particular, on the basis of logical deductions made from an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector, as well as all the other circumstances of the case. However, the Applicant applied the wrong 'relevant commercial sector', turning from the correct objective assessment of goods and services of the application, and arguing on the contextual basis of the applicant's identity and activities. Further, so far as logical deductions are concerned, such deductions have to be ones that the relevant average consumer could have made at the application date – at which time, the consumer would have had no idea of Union's identity or activities.
3) The AP was not able to conclude whether it is necessary to produce evidence of a change of economic behaviour to establish detriment to repute. It was not necessary for the AP to refer the point to the CJEU, and she agreed with the HO's decision even if there was no requirement of evidence of a change in economic behaviour of consumers, for the reasons stated under grounds (1) and (2).
4) There was nothing inherent in the nature of any of the goods and services covered by the trade mark applications that could cause tarnishment. Again, whether an entity's identity and activities are obvious is not relevant to the assessment and, further, as at the relevant date the relevant consumer would not have known of Union, there could be no tarnishment.

This decision is a useful summary of authorities on the assessment of detriment to repute, and the correct approach to take in the context of opposition proceedings. The case shows the importance of the relevant date of assessment for claims under section 5(3), and the perils of arguing other than on the standard assessment.

Chris Hawkes
is a Solicitor at Stobbs IP
chawkes@stobbsip.com

Chris advises on a broad range of trade mark, design, copyright and online IP issues, and leads acquisition, prosecution and enforcement work.

T-284/11, Metrópolis Inmobiliarias y Restauraciones, SL v OHIM, CJEU, General Court, 25 April 2013

End of the line for MIR mark

Links to goods and services were the decider, says Triona Desmond

The General Court has upheld a decision of OHIM's First Board of Appeal to reject Metrópolis Inmobiliarias y Restauraciones, SL's (MIR) application for a Community Trade Mark (CTM) for METROINVEST on the basis of an opposition by MIP METRO Group Intellectual Property GmbH & Co KG (MIP) because the mark was deemed similar to the earlier figurative mark METRO covering identical services in class 36.

In July 2008, MIR filed a CTM application for the word mark METROINVEST for financial services, insurance services, cash transactions and real estate services in class 36.

In November 2008, MIP opposed the application under Article 8(1)(b) of Council Regulation (EC) 207/2009 ("the Regulation") based on the earlier German figurative registration covering goods and services in classes 1 to 45, including in class 36: "insurance services; financial services; cash transactions; real estate services." The opposition was also based on a CTM application for the figurative mark for various goods and services in classes 1 to 42.

The opposition was upheld and an appeal by MIR was dismissed. The First Board of Appeal found that the relevant public consisted of German general consumers, as well as professional customers whose level of attention was above average. It found the services to be identical and the marks visually and phonetically similar.

MIR appealed to the General Court, alleging infringement of Articles 6 and 14 of the European Convention for the Protection of Human Rights and Fundamental Freedoms (ECHR) and infringement of Article 8(1)(b) of the Regulation.

Regarding its second plea, MIR claimed that as there was no visual, aural or conceptual similarity between the marks, there was no likelihood of confusion, even if the services were found to be similar or identical. The services covered by the respective marks were found to be identical.

> *Even if a mark has an obvious meaning to the relevant consumer, it can be distinctive for certain goods and services*

The Court noted that if all other components of a mark are negligible a similarity assessment can be carried out on the basis of a dominant element. It also pointed to prior case law demonstrating that where a mark is composed of word and figurative elements, the former are judged more distinctive than the latter.

The Court found that some degree of visual similarity existed between the marks as they both contained the element "metro". Phonetic similarity was also found.

Conceptually, the Court found a very weak similarity; for the German public there was no link between the word "metro" and the services in question. MIR's argument that the element "metro" referred to "metropole", and therefore that there was a conceptual difference between the marks, was rejected.

Because the common term "metro" had no meaning in relation to the services concerned, the Court found it distinctive. It also found "invest" – the root of the German verb "investieren", meaning to invest – to be descriptive of the services concerned. The marks were deemed similar overall.

Regarding its first plea, MIR claimed that the Board of Appeal had infringed its obligation to state reasons under Article 6 of the ECHR and the principle of equal treatment under Article 14 of the ECHR. MIR claimed that the word "invest" was not included in any German dictionary, unlike the word "metro". It argued that the two words were devoid of distinctive character.

Regarding Article 6 ECHR, the Court held that the challenge to the Board's findings did not concern such infringement but a potential error of law under Article 8(1)(b) of the Regulation. Therefore, this plea was rejected.

Regarding alleged infringement of Article 14 ECHR, the Court found that the Board was not inconsistent when it found the word "metro" distinctive in relation to the services concerned and the word 'invest' descriptive of the same services. As a result this plea was also rejected.

This case emphasises the importance of assessing distinctiveness in accordance with the goods and/or services in question. Even if a mark has an obvious meaning to the relevant consumer, it can be distinctive for certain goods and services, as Apple is for electrical equipment.

Triona Desmond
is a Trade Mark Attorney at Squire Sanders (UK) LLP, London
triona.desmond@squiresanders.com
Triona advises on the filing and prosecution of trade marks, copyright, designs and domain names. Triona conducts brand clearance searches and advises on new brands.

CASE IN POINT

T-579/10, macros consult GmbH – Unternehmensberatung für Wirtschafts- und Finanztechnologie v OHIM, MIP Metro Group Intellectual Property GmbH & Co KG (intervener), CJEU, General Court, 7 May 2013

Macros misses out

It had a long name but was short on evidence, explains Robert Cumming

The unitary nature of the Community Trade Mark (CTM), as set out in Council Regulation (EC) 207/2009 ("the Regulation"), is fundamental to the proper functioning of the EU's harmonised system. Without it, free movement of goods and services would remain fragmented along historical political boundaries and the "progressive abolition of restrictions on international trade" set out in the preamble to the Treaty on the Functioning of the European Union (C-83/47) would go unfulfilled.

But the *acquis communautaire* does afford one indulgence to localised rights owners in the form of Article 8(4) of the Regulation, which bars registration if, upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance: (a) rights to a sign were acquired prior to the date of application for registration of the CTM, or the date of the priority claimed for the application for registration of the CTM; or (b) the sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

A declaration of invalidity of a CTM can be rejected if only one of those conditions is not satisfied (joined cases T-318/06 to T-321/06 Moreira da Fonseca v OHIM – General Óptica (GENERAL OPTICA) [2009] ECR II-649). In alliance with the unitary character provision, owners of unregistered rights under national law can effectively torpedo a CTM application – if they prove their rights, that is.

In case T-579/10, the sesquipedalian macros consult GmbH – Unternehmensberatung für Wirtschafts- und Finanztechnologie ("Macros") unsuccessfully opposed the registration of MIP Metro Group Intellectual Property GmbH & Co KG's application for makro. The trade mark was filed on 23 March 1998 and *registered* on 21 April 2005.

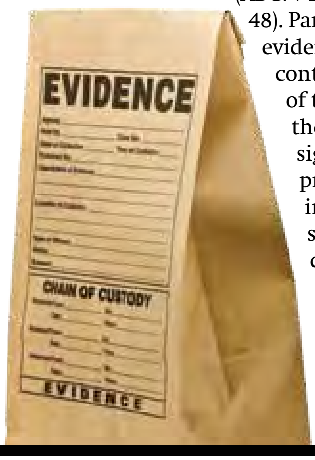
Macros sought a declaration of invalidity under Article 53(1)(c) on the basis of its unregistered rights in Germany. OHIM's Cancellation Division rejected the application, stating that the Applicant had failed to demonstrate that the name was used in the course of trade at the date of application for registration of the conflicting mark. The Board of Appeal found: (i) the existence of an earlier right at the date of the application had not been established; (ii) a general reference to section 5 of the *Markengesetz* (an article in German law that protects several different types of rights) was insufficiently precise; and (iii) the evidence submitted was insufficient to prove the existence of an earlier right.

Macros had filed evidence of an application for a German national mark dated 14 March 1998, as well as an application for registration of a company name. However, neither was found to prove that there was economic activity at the relevant time and the abandonment of the application and, indeed, the difference between the company name registered and the name Macros relied on to challenge the validity of the right assisted in that conclusion.

The Court noted that its authority under Article 65 of the Regulation did not allow it to consider new evidence or carry out an autonomous assessment of whether the Applicant may rely on the sign protected by Article 5 of the *Markengesetz*. It could not therefore substitute its own interpretation of German law for that carried out by the Board of Appeal.

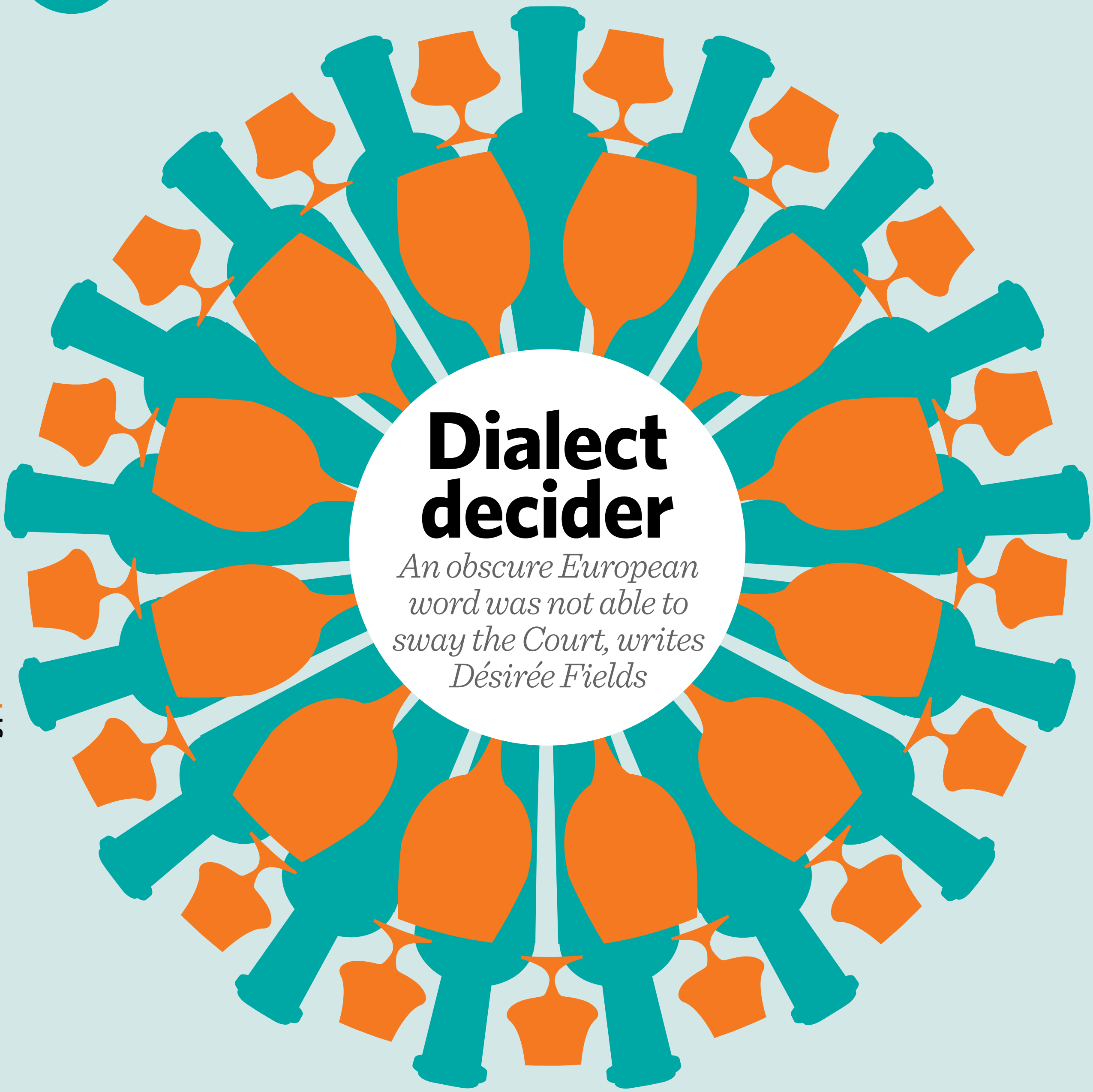
Citing C-263/09 P Edwin v OHIM [2011] ECR I-0000, the General Court noted that it was the Applicant's burden to establish the content of the law and to prove that it is entitled under the applicable national law to lay claim to a particular right. Taking into account the paucity of the evidence filed, the Board of Appeal was found to have reached the correct conclusion.

This case is a reminder of the consequences of failure to properly particularise and substantiate a claim under Article 8(4) and is consistent with the principle under English law that a court will not "make an untutored examination of exhibits" (ABC! v fifT [1996] 1 Lloyd's Rep 48). Parties should provide evidence concerning the content and interpretation of the national law and the reasons why their sign benefits from its protection. Proof of use in the course of trade should be clearly demonstrated, as vague or inconsistent evidence, as well as evidence of mere isolated use, is unlikely to be sufficient.



Robert Cumming
is a Solicitor and Registered Trade Mark Attorney at Appleyard Lees
robert.cumming@appleyardlees.com
Robert advises clients in a broad range of industries on brand protection, exploitation and enforcement.

T-393/11, Masottina SpA v OHIM, CJEU, General Court, 14 May 2013



Dialect decider

An obscure European word was not able to sway the Court, writes Désirée Fields

In this case, Masottina filed a Community Trade Mark (CTM) application for the word mark CA'MARINA for "alcoholic beverages, in particular wine, sparkling wine, spirits, liqueurs". Bodegas Cooperatives de Alicante, Coop V brought an opposition under Article 8(1)(b) of Community Trade Mark Regulation 207/2009/EC (CTMR) based on its prior Community word mark registration for MARINA ALTA in relation to "alcoholic beverages (except beers)".

The opposition was upheld on the grounds that the goods concerned were identical and that the similarities between the respective marks outweighed their dissimilarities. The OHIM Board of Appeal dismissed Masottina's appeal, finding that consumers who had been exposed to wines, among other beverages, sold under the MARINA ALTA trade mark, and who were offered wines or other beverages under the name CA'MARINA, were likely to believe that CA'MARINA was a new line of wines created by the owner of the earlier MARINA ALTA mark or that there was a commercial connection between the parties. Masottina appealed to the European Union (EU) General Court (GC).

Additional evidence

Masottina sought to introduce additional documents for the first time before the GC, including a list of CTMs containing the term "marina" registered in respect of goods in class 33. The GC did not take these into consideration, noting that the purpose of the GC was to review the legality of decisions, not to re-evaluate facts in light of documents produced for the first time before it.

Masottina disputed the Board of Appeal's finding that the goods concerned were identical, arguing that the wine sector included several categories and types of wine. Agreeing with the Board of Appeal, the GC found that both marks covered alcoholic beverages and therefore identical goods. The GC disagreed with Masottina's assessment that the goods concerned were different because the mark applied for related to high-quality goods sold at a high price for which consumers would have to turn to a specialised distribution channel, noting that this was irrelevant since registration was not only sought for wines, irrespective of their quality, but also for sparkling wines, spirits and liqueurs. Further, since particular marketing strategies for goods could vary over time, the assessment of the likelihood of confusion between two marks could not be dependent on marketing intentions. OHIM could take account only of the list of goods as it appeared in the trade mark application. Further, even if the goods concerned were of different qualities or distributed via separate channels, this did not prevent a likelihood of confusion since the goods could be perceived as designating product lines from the same producer.

General Court findings

The GC agreed with the Board of Appeal that the marks were visually similar as both included the term "marina", which was the longest term composing the respective marks. The additional elements of the respective marks, "ca" and "alta", did not reduce their similarity significantly. The GC further found that even if Masottina's argument that the term "marina" was a commonly used term was accepted, it did not follow that it was negligible. Only where an element in a complex mark was dominant to the point of rendering all other elements negligible could an assessment be carried out solely on the basis of a dominant element. Masottina's arguments that the apostrophe following the word "ca" was visually striking was equally unconvincing.

The GC found that while the respective marks had a different number of syllables and that, in certain EU languages, the emphasis may be placed on the last word of each of the marks, those differences were not capable of overturning the Board of Appeal's finding of a phonetic similarity between the respective marks due to the presence of the word "marina" in each of them. The phonetic differences between the marks did not make the word "alta" the dominant element of the earlier mark to the point that consumers did not perceive the word "marina".

> *Only consumers who understood the dialect of Venice would recognise the mark applied for as 'marine house'*

The GC did not agree with Masottina's argument that the term "ca" in the mark applied for, which in a dialect peculiar to the Italian city of Venice meant a house situated on the coast of Venice, would immediately be understood by the average EU consumer. Rather, only consumers who understood that dialect would recognise the mark applied for to mean "marine house"; other consumers would perceive it as relating to a "marina", a term that referred, at the very least for the relevant public who spoke French, English, German or Spanish, to the sea or a place bordering the sea or a marina.

With respect to the earlier mark, the GC agreed with the Board of Appeal's assessment that the element "alta", which would be understood by Italian and Spanish consumers as meaning "high", was a qualifier of the noun "marina" and did not substantially affect the strong evocative power and impression that noun conveyed, in particular as it was the second element in the earlier mark. Given that those not familiar with Italian or Spanish would be unlikely to understand different meanings of the two marks and would realise that both marks relate to the sea, the GC agreed with the Board of Appeal that they were conceptually similar.

Accordingly, the GC found a likelihood of confusion between the ALTA MARINA and CA'MARINA marks.

Conclusions

The Board of Appeal's assessment was not called into question by Masottina's argument that the term "marina" did not have distinctive character because it was commonly used and appeared in a large number of CTMs, including marks registered for goods in class 33. The GC considered that the fact that the earlier mark had been registered meant that it had a minimum degree of distinctiveness, noting that if Masottina believed that the earlier mark had been registered contrary to the provisions of Article 7 CTMR, it should have submitted a declaration of invalidity.

In any event, Masottina's evidence that the term "marina" was devoid of distinctive character was inadmissible as it had only been submitted for the first time before the GC. The decision thus serves as an important reminder to consider all arguments carefully and to submit available evidence at the first stage of opposition proceedings. It also reiterates that OHIM can only take into account the specification of goods or services applied for and not the actual or intended marketing practices of applicants in making an assessment pertaining to the likelihood of confusion.

Désirée Fields
is a Senior Associate at McDermott Will & Emery UK LLP
dfields@mwe.com
Désirée focuses on all aspects of IP law, with emphasis on trade mark and brand protection, and manages the firm's Community and UK trade mark prosecution practice.

CASE IN POINT

T-353/12, Aleris Holding AB v OHIM, CJEU, General Court, 16 May 2013

Aleris answer bittersweet

Complicated sub-categories were of great concern in a case covered by Rupert Bent

CareFusion 303, Inc ("CareFusion"), formerly ALARIS Medical Systems Inc, filed an application at OHIM for a Community Trade Mark (CTM), for the word mark ALARIS in classes 10, 37 and 42 ("the Mark"). The Mark was subsequently registered under number 571521 for goods and services related to medical instruments and equipment.

OHIM's Cancellation Division received a request by Aleris Holding AB ("Aleris") seeking a revocation of the Mark based on alleged infringement by CareFusion of Article 51(1)(a) of Regulation (EC) No 207/2009 ("the Regulation"). Article 51(1)(a) provides that a CTM may be revoked if it has not been put to genuine use in the European Community within a continuous period of five years in connection with the goods or services in respect of which it is registered. The application was rejected in respect of the goods and services in classes 10 and 37, but it was agreed that the services in class 42 should be revoked.

A further attempt by Aleris to annul the decision in respect of class 37 and the goods in class 10 (with the exception of the sub-category "volumetric infusion pumps and syringe pumps") then failed before OHIM's Fifth Board of Appeal, on the basis that genuine use had been made of the Mark in the EU in relation to the goods and services listed in classes 10 and 37.

Aleris then brought an action against OHIM before the Court of Justice of the European Union's Fifth Chamber ("General Court"), claiming that the decision of the Board of Appeal should be annulled on the basis of Article 51(1)(a) and Article 51(2). Article 51(2) states that, where grounds for revocation exist in respect of only some of the goods or services for which the CTM is registered, the proprietor is to be declared to be revoked in respect of only those goods or services.

OHIM argued that this action should be dismissed.

Genuine use

The General Court noted that, for there to be genuine use of a trade mark, the mark must be used in accordance with its central function. Referring to C-40/01 Ansul [2003] ECR I 2439, the Court explained that its central function was to guarantee the identity of the origin of the goods or services for which it is registered to preserve an outlet for those goods or services.

One of Aleris' claims was that the Board of Appeal did not take into account secondary-market purchasers of the medical instruments and equipment when it argued that the nature of the goods meant that service and repair is infrequently put to use (as, it argued, most repairs would be carried out while the products are under warranty). However, Aleris failed to submit evidence to support this and failed to establish that only limited use was made of the services.

The General Court also stated that, in determining whether use of a trade mark is genuine, it must have regard to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real. Proof that a mark has been put to genuine use in relation to a part of those goods or services affords protection only for the sub-category in which goods or services have actually been used. The Court's view was that, when it serves a real commercial purpose, even minimal use of a mark can be sufficient to establish genuine use.

Sub-categories

In the General Court's opinion, the Board of Appeal had correctly considered that the overweening category "Medical instruments and equipment" was sufficiently broad that sub-categories capable of being

viewed independently existed within it. Despite this, the Board incorrectly determined that "Medical instruments and equipment" contained only one single sub-category, namely "infusion pumps and controllers", in the mistaken belief that the products are related because, in practice, they are used together. If a trade mark has been registered for a category of goods or services that is sufficiently broad for it to be possible to identify within it several sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods affords protection only for the sub-categories in which the trade mark has actually been used.

The protection conferred by the Mark extends only to the sub-categories in which the trade mark has actually been used

OHIM had not followed established case law on how to sub-categorise the nature of the products. The General Court stated that the purpose or intended use of the product or service is vital for ensuring that consumers benefit from this form of guidance and is crucial in the definition of a sub-category of goods or services. Proof of genuine use was established in relation to some of the goods covered by the Mark falling within class 10.

Increased scrutiny

The General Court upheld the Board's decision, with the exception that the products covered within class 10 should remain on the registration only where proof of genuine use was established. The decision suggests that the registration only of CTMs within certain sub-categories of classes may fall under greater scrutiny by OHIM when considering future applications.

The General Court also considered its powers to annul part of the original decision of the Cancellation Division. Aleris applied under Article 64(1) of the Regulation for the General Court to adopt the decision that Aleris deemed the Board of Appeal should have adopted when the first appeal was lodged.

Under Article 64(1), the Board of Appeal may annul the decision of the section of OHIM that ruled at first instance. Such annulment, therefore, falls within the measures that may be taken by the General Court in the exercise of its power to alter decisions under Article 65(3), which states that the CJEU has jurisdiction to annul or alter the contested decision.

Examining its powers under Article 65(3), the General Court said that this provision did not allow it to substitute its own reasoning for that of the Board of Appeal and that it was limited to situations where the General Court is in a position to determine what the Board of Appeal was required to decide.

On the facts, the Board of Appeal had incorrectly analysed the question of genuine use of the Mark. However, in respect of the independent sub-categories within class 10, the General Court stated that it was not its responsibility to carry out that analysis and the application was dismissed.

Rupert Bent
is a Legal Director at Pinsent Masons LLP
rupert.bent@pinsentmasons.com

Daniel Glover, Trainee Solicitor at Pinsent Masons LLP, acted as co-author. **daniel.glover@pinsentmasons.com**

CASE IN POINT

T-178/11, Voss of Norway v OHIM, CJEU, General Court, 28 May 2013

Voss loss

The court reached a reasoned conclusion, disregarding previous registration, observes Azhar Sadique

On 3 December 2004, the Applicant, Voss of Norway ASA ("Voss"), obtained registration under No 3156163 for a 3D Community Trade Mark (CTM) with respect to a cylindrical bottle ("the contested trade mark"). The mark was registered in respect of classes 32 and 33 of the Nice Classification.

On 17 July 2008, Nordic Spirit AB applied for a declaration of invalidity in respect of that mark. By a decision of 10 March 2010, the Cancellation Division rejected Nordic Spirit AB's application for a declaration of invalidity in its entirety. In essence, the Cancellation Division took the view that the shape of the contested trade mark was not "common" on the beverages market. It stated that cylindrical bottles were not routinely used for beverages and that consumers were more familiar with beverage bottles having a curved shape. Accordingly, the Cancellation Division concluded that the contested mark could function as a trade mark.

Nordic Spirit AB brought an appeal before OHIM and submitted that the cylindrical shape of an aluminium can was customary, adding that consumers were familiar with stylised versions of bottle shapes. Nordic Spirit AB also argued that the average consumer did not choose a product, or distinguish it from a competitor's, merely on the basis of its packaging. As such, it submitted that consumer habits in the marketplace should have been considered prior to assessing the distinctiveness of the shape of the bottle.

In its decision of 12 January 2011, the First Board of Appeal annulled the Cancellation Division's decision and upheld the application for a declaration of invalidity. While the Board confirmed that a bottle can be registered as a trade mark, it held that such a trade mark must be distinctive to qualify for registration. Furthermore, the Board agreed with Nordic Spirit AB and confirmed that the assessment of the distinctive character of a trade mark that exclusively consists of the design of a product or its packaging should be carried out not in the abstract, but with reference to the branding practices prevailing on the relevant market. The Board considered a range of common beverages and held that they were never sold in unmarked bottles. It stated that labels attached to such products would be recognised as the trade mark of that product and the bottles would be seen as the container.

In its assessment, the Board was of the view that consumers would not rely on the outline or shape of a product to determine its origin unless that outline or shape was well known to consumers (eg, in the case of the Coca-Cola bottle). The Board further added that it was unlikely that consumers will perceive the logo and the bottle as two separate trade marks. Accordingly, the Board concluded that consumers would instinctively look for a verbal or graphic sign on the product to identify the source of that product and distinguish it from competitors rather than attempt to infer the source based on the appearance of the bottle.

Court comments

Voss appealed the decision, citing the following pleas:

- That there was an infringement of Article 7(1)(b) of Council Regulation (EC) 40/94 (replaced by 207/2009, "the Regulation") and a misinterpretation of the case law concerning the distinctive character of three-dimensional marks. In particular, that in the test laid down by the case law to assess the distinctive character of a three-dimensional trade mark in terms of the packaging of a liquid product where the trade mark is the very appearance of the product (a test that consists of determining whether the mark departs significantly from the norms and customs of the relevant sector), the Board of Appeal substituted another test based on the weight to be given to labels or other branding practices in use in the sector.

The Board added that it was unlikely that consumers will perceive the logo and the bottle as two separate trade marks

- That there was an infringement of Article 7(1)(b) of the Regulation and distortion of evidence as regards the significant departure from the norms and customs of the relevant beverages sector, in that the Board of Appeal found incorrectly that the contested trade mark was devoid of distinctive character.

- That there was an infringement of Article 99 of the Regulation and of Rule 37(b)(iv) of Commission Regulation (EC) 2868/95 in that the Board of Appeal had unduly shifted the burden of proof onto the Applicant for the distinctive character of the contested trade mark when it was registered and enjoyed a presumption of validity.

The General Court (GC) reaffirmed the decision of the Board of Appeal and reinforced its reasoning:

- The GC stated that it was possible for a composite mark to be distinctive if the individual and non-distinctive components of that mark were presented in an original manner. However, in the present case, the individual items were no more than the sum of the parts that make up the contested trade mark – that is to say, a bottle with a non-transparent cap. The GC stated that such a shape is capable of being commonly used, in trade, for the presentation of the products referred to in the application for registration. Accordingly, the GC confirmed that the Applicant's contested trade mark did not depart significantly from the shape of other containers used for beverages and was devoid of distinctive character within the meaning of Article 7(1)(b) of the Regulation (T-399/02, Eurocermex v OHIM (Shape of a beer bottle), paragraph 43, paragraph 33).

- The GC further confirmed that the branding practices to which the relevant consumer is being subjected must be taken into consideration when assessing the ability of a sign to function as a trade mark.

- As the mark was found to be devoid of distinctive character, the GC rejected the plea that the Board of Appeal had infringed the presumption of validity of a CTM under Article 99 of the Regulation, and had unduly shifted the burden of proof onto it under Rule 37(b)(iv) of Commission Regulation (EC) 2868/95.

The conclusions of the GC emphasise the importance of three-dimensional composite marks possessing a sufficient distinctiveness in order to be registrable. The decision confirms that a three-dimensional composite mark may still be considered distinctive where it is made up of individual components that may be non-distinctive when assessed individually, providing that when such a mark is viewed as a whole it is a significant departure from the norms and customs of the sector. This case is a good example of the GC reaching a reasoned conclusion giving no weight to the fact that the mark had initially been found to be registrable before OHIM.

Azhar Sadique
is a Trade Mark Assistant at Keltie
azhar.sadique@keltie.com

CASE IN POINT

T-231/12, Rocket Dog Brands LLC v Julius K-9/OHIM, CJEU, General Court (Seventh Chamber), 17 May 2013

Watch your words

A focus on figurative elements meant failure for Rocket Dog, says Nicole Giblin

Julius K-9 ("Julius") filed a Community Trade Mark (CTM) application for JULIUS K9 covering a range of leather goods in class 9 and footwear and clothing in class 25. The application was opposed in both classes by Rocket Dog Brands LLC ("Rocket Dog") on the basis of a likelihood of confusion with its earlier figurative CTM registrations for K9 and Dog Device in class 25, shown on this page.

The opposition was rejected by both the Opposition Division and the Board of Appeal on the basis that although the goods concerned were identical in class 25, and similar in class 18, the trade marks were visually very different. As such, the trade marks were deemed to create different overall impressions and no likelihood of confusion was found.

Rocket Dog appealed to the General Court in relation to class 25 and argued that the Board of Appeal had erred in its comparison of the overall impression of the trade marks. It was also argued that the Board had failed to take account of the distinctive character of Rocket Dog's earlier trade marks and had failed to apply the THOMSON LIFE decision (Medion AG v Thomson Multimedia Sales Germany and Austria [2005] ECR I-8551).

Rocket Dog was of the view that the dominant element of Julius' trade mark was the alphanumeric combination K9, which was identical to the K9 element of its earlier figurative marks. The General Court however, found that JULIUS was the dominant element of JULIUS K9. Even though Rocket Dog's trade marks contained the alphanumeric combination K9, it was overshadowed by the larger dog and bones device. As such, the consumer would be more likely to remember the figurative elements than the element K9. The General Court also refused to accept that the trade marks were conceptually similar, as K9 was not sufficiently well known as being a reference to canines and dogs.

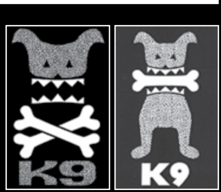
Rocket Dog went on to argue that the Board did not acknowledge the enhanced distinctive character of its earlier trade marks. The General Court commented that the Board had not acted unlawfully by not commenting on whether Rocket Dog's trade marks were particularly distinctive. In any event, the General Court held that the distinctiveness of a trade mark cannot be inferred from the mere fact that it is sufficiently original to function as a trade mark. Even if Rocket Dog had successfully shown that the public recognise K9 as meaning "canine", this would not have increased the distinctive character of the trade marks.

Applying a precedent

Finally, Rocket Dog criticised the Board for not applying the THOMSON LIFE decision. In particular, Rocket Dog argued that the K9 element of JULIUS K9 retained an independent, distinctive role, such that the trade mark was similar to Rocket Dog's earlier marks. The General Court rejected this argument and commented that JULIUS K9 was "not composed by juxtaposing an element with one of the earlier marks...[rather] the mark applied for included only one of the elements from the earlier trade marks" that did not form the main element. The Board had therefore been correct in stating that the elements played an important role in the assessment of the likelihood of confusion, and should not be ignored in favour of the alleged independent role of K9.

Overall, the General Court upheld the Board's decision. This emphasises that trade mark proprietors should secure protection for the word elements of composite trade marks, rather than the composite mark alone. The outcome may have been different if Rocket Dog were relying on a CTM for K9, rather than such a highly stylised figurative mark.

ENFORCED MARKS



Rocket Dog relied on the above figurative marks to overcome JULIUS K9

Nicole Giblin
is a part-qualified Trade Mark Attorney at Withers & Rogers LLP
ngiblin@withersrogers.com
Nicole joined the firm in March 2011 and spends time in both the Bristol and Leamington Spa offices.

events

More details can be found at itma.org.uk

Date	Event	Location	CPD hours
12 September	**ITMA Edinburgh Talk** The Guardians of the Orb: A case study on the protection of Harris Tweed, Certification Marks, Acts of Parliament and much more	Burness Paull LLP, Edinburgh	1
16 September	**ITMA CIPA Leeds Afternoon Talk** The Guardians of the Orb: A case study on the protection of Harris Tweed, Certification Marks, Acts of Parliament and much more	Walker Morris, Leeds	1
24 September	**ITMA London Evening Meeting**** Copyright and Design Update, David Fyfield, Charles Russell LLP	Royal College of Surgeons, London	1
10 October	**ITMA Autumn Seminar****	ICC Birmingham	5
29 October	**ITMA London Evening Meeting****	Royal College of Surgeons, London	1
7 November	**ITMA Glasgow Talk** Brand protection for Glasgow Commonwealth Games 2014 and IP considerations in the Scottish independence debate	Brodies, Glasgow	1
12 November	**ITMA Webinar** PCC and small claims court, Jane Lambert		1
26 November	**ITMA London Evening Meeting**** CJEU and General Court Update, Désirée Fields and Hiroshi Sheraton, McDermott Will & Emery	Royal College of Surgeons, London	1
5 December	**ITMA Edinburgh Talk** Co-existence agreements: the risks and how best to avoid them. A round-up of key IP developments in 2013	Pinsent Masons LLP, Edinburgh	
10 December	**ITMA Christmas Lunch***	InterContinental, London	

ITMA's Autumn Seminar in October will discuss the general to the particular

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Media Watch

A drinks debate, musical mess and Wimbledon winner are on the radar for Ken Storey this month

ILLUSTRATION BY **PHILLIP COUZENS**

Those of you who helped celebrate ITMA's 75th anniversary on 24 November 2009 may recall that the sponsor of the evening was InBev, owner of the iconic Bass Red Triangle trade mark, the first on the Trade Marks Register. *The Grocer* magazine, among others, has reported that InBev is rebranding its Bass Pale Ale to Bass Trademark No 1, which brings a new dimension to the request "I'll have a trade mark please." Attorneys need no longer hide their light under a bushel when going into pubs and can now proclaim their profession. It may be a while before an ITMA brand is produced, but maybe it's an idea for the 100th anniversary celebration?

On a slightly less positive note, InBev attracted criticism in the *Daily Mail* and on the website just-drinks.com for sending a cease and desist letter to a London microbrewer over its use of the name Belleville, out of concern that the Belleville name was too close to the name of its own Belgian beer, Belle-Vue.

Just-drinks.com reported that Belleville's owner, Adrian Thomas, said that he would probably have to change the name to Northcote, a famous market near to the brewery, as "world domination is not on my agenda". Sensible man.

Elsewhere, Apple's application to the Japanese Trade Mark Office for the trade mark "iWatch" generated widespread coverage suggesting it was ready to launch a new gadget for which it apparently has patent protection. The application has since been rolled out to other countries, suggesting that a launch is imminent.

Subsequent press reports have suggested that Sony (with Smartwatch2) Samsung (with Gear) and Google are planning to launch similar gizmos. As a technophobe, however, I won't be buying these "toys".

Also attracting enormous coverage is a dispute between Will.i.am and Pharrell Williams. Will.i.am owns a trade mark for "I AM" in the US and instructed lawyers to send a cease and desist letter to Williams over his attempts to register "I am OTHER". Subsequently, Will.i.am claimed never to have planned to sue Williams, but only to try to protect his trade mark. Williams has now filed a lawsuit asking a judge to rule that he has not violated any trade marks. I am a bit perplexed how a trade mark for I AM can be enforceable, but I am merely a commentator… enough "I AMs", I think!

Back home, two cases concerning companies previously covered in this column involve Chanel and Fred Perry. In the case of Chanel, the UK IPO has refused Chanel's application to register the name Jersey as a trade mark for its latest fragrance. This follows opposition from Jersey's Economic Development Department. It is unusual for trade marks to feature in *Vogue* magazine, but in this case it reported the IPO's decision. *Vogue* referred to the fact that the application included the capital letter J for Jersey, which linked the perfume to the island, but the IPO ruled that the name should be limited to items made on the island.

In the most recent case concerning famous-name label Fred Perry, *Retail Gazette* reported that an online fashion retailer, Secret Sales, admitted selling counterfeit polo shirts and had agreed to pay damages and legal costs, and not to sell such items in the future. I wonder if we will ever see the day when Andy Murray shirts and sportswear become so popular and the subject of such flattery by imitation!

Finally, I was happy to pick up a press release from journalism.co.uk that reported that the Advertising Standards Authority has upheld a complaint made by NBC Bird and Pest Solutions Limited against Trademark Renewal Services Limited, over an unsolicited trade mark renewal reminder it received that created the impression that it came from the IPO. The report carried quotes from Jerry Bridge-Butler, a stalwart member of ITMA's PR and Communications Committee, who said: "We strongly welcome the decision. It may not penalise Trademark Renewal Services, but it does at least demonstrate that the tactics that it, and others like it, employ are unscrupulous". ITMA has fought this issue long and hard, and, although only a minor victory, it is a significant step forward.