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ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

Issue **407** February 2014 itma.org.uk

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is casting media and popular
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N O W I N L O N D O N

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welcome

February 2014



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ITMA Review

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Welcome to our February issue: 2014 is not a leap year, but it is an even year, and even years are times of change for the ITMA officers. Further details will follow soon!

One part of the ITMA year that I hope will never change is the ITMA Christmas lunch, with its pre-lunch drinks kindly sponsored by Thomson-CompuMark. The London lunch had even more guests than usual. Perhaps you can find your picture in the gallery within this issue?

Meanwhile, the Northern lunch, this time in Leeds, also had more guests than last year. Both outings were memorable occasions – so let's make the March Spring Conference another event to remember!

Catherine Wolfe
ITMA President

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ITMA Insider



Cricket opportunities

CIPA-ITMA Cricket Club (CC) nets for 2014 continue and details are set out below. All standards of player are welcome and the nets will cost around £8 per person per net. If you are interested in attending and are not already on the CIPA-ITMA CC mailing list, please email cipaitmacc@gmail.com

Oval (7-8pm):
11, 18, 25 February;
18, 25 March; 15 April
Lord's (7-8pm):
4 February; 4 March;
1, 8 April

And, following on from the success of last year's trip to Serbia, the CIPA-ITMA CC will be travelling to the Croatian island of Vis in September to play the Sir William Hoste CC (viscricket.com). Again, if you are not on the mailing list and wish to receive further details of this, please contact Stuart Lumsden at cipaitmacc@gmail.com

ITMA structure – charting the changes

We have taken significant steps to roll out the new structure announced in October 2013 and highlighted in the Dec/Jan edition. We are keen to ensure that all members are informed about these changes, and to broaden the volunteer network, so we're taking this opportunity to once again explain a bit about the new structure and to ask those interested in becoming involved in any way to get in touch.

Under the new structure, there are five Committees that cover the core elements of the work of ITMA and these are now up and running. The Committees are: Executive, Law & Practice, Events, Education, and Publications & Communications. Delivering much of the work underneath these committees are a number of Working Groups that report to their respective committee. There are approximately 40 Working Groups that have been initially set up and these cover a multitude of areas, activities and projects that currently reflect the work of ITMA – too many to list here, but the ITMA website contains more information, or you can contact the ITMA office for the latest list of Working Groups.

The new structure is designed to provide greater flexibility and allow

more opportunity for members to get involved in delivering the work of ITMA, be it for a short period of time or for a time period that suits the individual. By volunteering you will assist the Institute in supporting and enhancing the profession and we are extremely grateful to all those who currently give so freely of their time.

There is no limit to how many Working Groups an individual can sit on, and there is no requirement for an individual to also sit on a Committee to sit on a Working Group. If an individual wishes to sit on a Committee as well as a Working Group, the Committee does not necessarily have to be the Committee that oversees the Working Group and *vice versa*. Some Working Groups may have a limited period of existence and new Working Groups will be established as and when appropriate.

It has been pleasing to receive interest from a number of new volunteers and we are looking forward to working with them under this new structure. Please contact keven@itma.org.uk if you are interested in volunteering for any of the Working Groups, the Committees or Council, or for more information.

We are keen to ensure that all members are informed about the changes, and to broaden the volunteer network

THE IPT BALL IS BACK!

The Intellectual Property Trainees' Ball will take place on **Saturday 19 July 2014**. All members of the profession, at whatever stage of their career, are welcome to attend. See itma.org.uk/events for further details.

ITMA welcomes Hacon to IPEC

ITMA has welcomed the announcement of Richard Hacon's selection as permanent presiding judge of the IP Enterprise Court (IPEC). "This is the key appointment to the specialist court for IP matters," said ITMA President Catherine Wolfe. "There have been a number of improvements to what used to be called the Patents County Court in recent months, including its renaming as the IP Enterprise Court in early October. However, there has been no permanent presiding judge since April, when Justice Colin Birss QC left to become a High Court Judge, and so this appointment is greatly welcomed."

ITMA is pleased to see that the new judge has experience of working as a barrister on IP cases that have often involved small companies, as well as high-profile disputes involving internationally recognised names. He was one of the barristers involved in Apple's suit against Samsung, claiming that Samsung's tablet devices infringed Apple's Community design for the iPad. In July 2012, Birss J cleared Samsung of infringement, leading to a flurry of media coverage when he remarked that Samsung's tablets were not as "cool" as the Apple design.

"We wish Richard well in his new role," said Wolfe. "His background and experience will stand him in good stead in building on the reputation of the Court."

In Memoriam: Garry Mills



We are saddened to report the death, on 19 October 2013, of IP Solicitor Garry Mills. Garry was 46 and had been fighting cancer for a couple of years.

Garry first studied IP as part of a Masters of Law degree at Bristol University, prior to which he qualified from the College of Law in York.

Trade marks were undoubtedly his favourite area and, shortly after qualifying as a Solicitor, he joined Clifford Chance in 1995, where he worked closely with the trade marks team. During nearly 15 years at the firm, Garry was involved in many notable reported cases. He joined Innovate Legal as Head of Trade

Marks and Brands in December 2009.

Garry was a very calm and knowledgeable lawyer, and was popular with clients and colleagues alike. He was well known in the profession through his work, and through his attendance at TIPLO, INTA and ITMA events, among others.

He was always a pleasure to be around, notwithstanding the fact he was a keen Arsenal fan, regularly attending Highbury and latterly the Emirates. As those who knew him will testify, he was a devoted family man, with his wife, Sarah, and four young children, Oliver, Florrie, Monty and Elsie, at the centre of his world. He will be greatly missed.

Contributed by Simon Miles



JTA anniversary honoured

ITMA was pleased to be able to present President Hori of the Japan Trademark Association (JTA) with a gift of Chivas 21 Year Old Royal Salute to celebrate the 25th anniversary of the JTA. The presentation was made on behalf of ITMA by Atsushi Oshima, a director of the JTA and an overseas member of ITMA.

Reader review

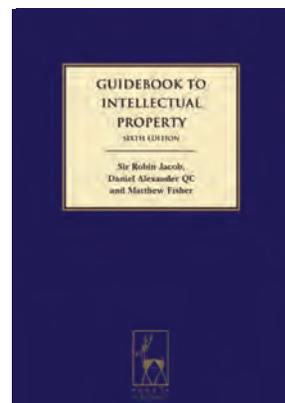
Mark Caddle offers his assessment of the *Guidebook to Intellectual Property*

The Guidebook to Intellectual Property (sixth edition; Hart Publishing; £19.99), by Sir Robin Jacob, Daniel Alexander QC and Matthew Fisher, is both accessible and user-friendly. Despite its brevity, especially when compared with

the corresponding introductory texts in each respective IP field, the substantive quality of its content is not compromised.

It is likely to be of use to brand owners, designers and inventors, as well as students and IP practitioners, given its

avoidance of unnecessary technical jargon, which, as can be appreciated, can act as a deterrent to would-be dabblers in IP law. In summary, the authors have compiled a complete, as well as manageable, guide to the basics of IP law.



ITMA ANSWERS

Three years after our last survey, ITMA again asked the membership what they think of its role and its work priorities

In September 2013, ITMA conducted a survey of its membership to get feedback on its future priorities. We were pleased to receive 442 responses, the majority of which came from Ordinary members (see Figure 1). Thanks to everyone who took part.

Our priorities

When it came to overall priorities, the response was similar to that of 2010. Assisting Trade Mark Attorneys to maintain their professional expertise was once again considered the highest priority (see Figure 2). Although the “increase in membership numbers” objective is not considered as important by those who responded, it is maintained that this should not be discounted wholeheartedly, as it is crucial for the membership numbers to be sufficient to provide the appropriate income to enable ITMA to carry out its work across all areas. While this aim may not be considered a high priority for the membership, it plays a vital role in the ability of the organisation to deliver its strategic objectives.

Responses to a question on the promotion of the profession again mirrored the answers received in 2010, with “Promoting UK Trade Mark Attorneys within the UK business sector” being considered the highest priority (see Figure 3). ITMA sees all of these aspects as important elements of its work and it is encouraging that the

It is encouraging to see the increased support for the ITMA Review and this suggests that the work put in to re-focus the publication has been worthwhile

membership is supportive of ITMA continuing to work in these areas.

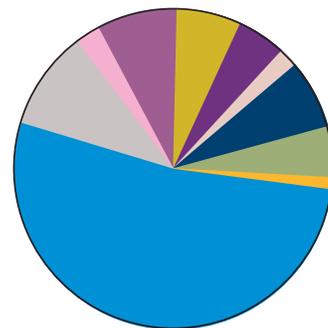
Important activities

When assessing the value of other activities, “running educational events” continues to be of significant importance to the profession (see Figure 4), not least because it reinforces their support for the main objective of the Institute. However, it is encouraging to see the increased support for the ITMA Review and this suggests that the work put in to re-focus the publication has been worthwhile.

Among the specific comments related to what additional activities would be of interest in the future were requests that ITMA organise a greater number of educational events, and help to better illuminate the path from Administrator to Attorney.

Figure 1

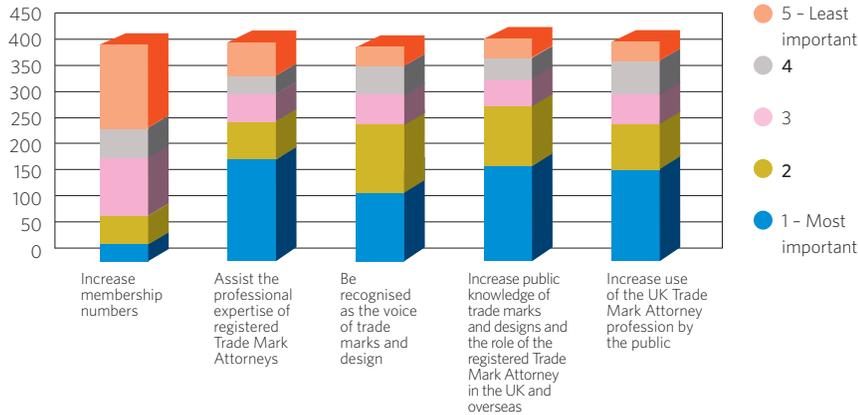
Who responded? Membership categories represented



	Response %	Response %	
Administrator	7.3%	Honorary	0.5%
Affiliate	3.4%	Ordinary	52.4%
Allied	1.7%	Overseas	6.6%
Associate	8.9%	Retired	1.8%
Fellow	6.9%	Student	11.0%

Figure 2
ITMA priorities

What do you consider to be the most important high-level objective of the Institute?



The information presented here contains extracts from the survey analysis report published on 29 November 2013. The full survey analysis report is available to ITMA members in the members area of the ITMA website.

Web presence

The membership appears to be generally content with the website content, although there were some useful comments made in response to other questions that chime with use of the website. The membership would like more information on Law and Practice, which reflects the overall message from the survey that training and education are important to members. We will be looking carefully at the balance between information posted on the website and in the *ITMA Review*, and how we communicate the work undertaken by the Law and Practice Committee and developments in Law and Practice in general. It is hoped that the new Committee and Working Group structure will also help to inform members of developments in the Law and Practice area, as well as other areas of activity. Meanwhile, our current modes of communication – including LinkedIn and Twitter – do seem to meet the needs of members.

Main benefit

Finally, the membership overwhelmingly highlighted two main benefits of ITMA membership: 43 per cent put education and training (including CPD, events and conferences) as the main benefit; and 35 per cent said that being a member of a respected professional body was the main benefit; while 11 per cent said information (including that received via the *ITMA Review*, the website, etc) was the main benefit.

There is, it would seem, general recognition of the role of ITMA as

Figure 3
Promotion of the profession

Please state the priority you would give to the following areas of promotion of the UK profession:

Answer options	High priority	Medium priority	Low priority	Not relevant	Response count
Promoting UK TMA internationally	146	202	52	7	407
Promoting UK TMA within the UK business sector	356	46	3	2	407
Promoting UK TMA within the UK public	166	165	67	8	406
Promoting UK TMA within Government and related organisations	157	190	55	6	408
	Answered questions				409
	Skipped questions				33

the representative body for Trade Mark Attorneys and as the Approved Regulator.

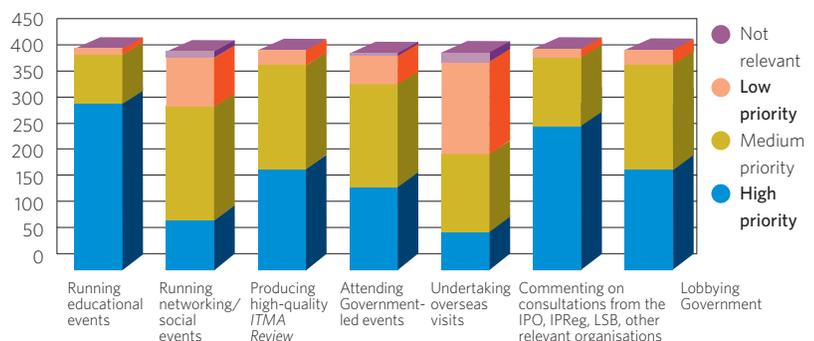
Valuable data

We've found the survey a valuable exercise. It has reinforced existing thoughts of the ITMA Council, and provided opportunities for challenging existing activities and areas on which to concentrate development as the Institute continues to plan for the future. We look forward to acting on this feedback over the coming years.

There is, it would seem, general recognition of the role of ITMA as the representative body for Trade Mark Attorneys

Figure 4
Activities of the Institute

Please state the priority you would give to the following specific activities of the Institute:



Rebecca Silva, Magda Ostrowska (Cleveland)



Catherine Wolfe, Rigel Moss
McGrath (WP Thompson)

Leah Musana, Vicky Hampton,
Claire Evans, Matthew Macleer
(Lane IP)



Julie Glendinning,
Elizabeth Dunn,
David Yeomans (Dehns)

08



Holiday cheer

Two great festive events rounded off the ITMA year

PHOTOGRAPHY BY **STEWART RAYMENT** (LONDON) AND **CARIN BURCHELL** (LEEDS)



Ann Wright (IPReg),
Tibor Gold MBE, Fiona Clark (8 New Square)



Mike Keogh,
Giovanni Visintini (BP)

Michael Wakefield, Cameron Gowlett,
Duncan Mee, Jennifer Eddis, Jack Wilde
(Cerberus Investigations)



Alasdair Hume (Ancient Hume),
Tom Redfern (Redfern Legal), Alison
Lindsay (Limelight Celebrity Management),
Karen Gibson (Ancient Hume)



Timothy Letters, Rachel Hearson



Patrick Cantrill, Laurence Thoo, David Sheppard, David Sutherland, Sally Cooper

Leeds leads off

The season kicked off with a first-time Christmas lunch in Leeds convening at elegant yet lively venue The Restaurant Bar & Grill. President Catherine Wolfe made the journey north and took the opportunity to thank Katy Cullen and Natalie Brindle for their work organising this year's CPD events in the region, Heather Williams and Dick Waddington for organising the day's lunch, and Chris McLeod for his tremendous support throughout the year.

Report by Carin Burchell



Chris McLeod, Bev Robinson



Alan Fiddes, Sarah Atkinson, Graeme Murray, Alex Rushent

Thanks to everyone who attended these enjoyable events!

Back row: Francis Preedy (Nucleus IP), David Sheppard. Front row: Jeevan Retnam, Matthew Ansbro, Rob Davey (Thomson CompuMark)



Corinna Hiscox, Heather Orr (Haseltine Lake)



Viv Garven, Thomas Hannah, Maggie Tilbrook, Rita Khaitan (GSK)



Triona Desmond, Amanda McDowall, Liane Bulger (Squire Sanders), Ria van der Lee (Knijff), Mr Ockeloen-Kruit, Andrew Vlad Ratza (Ratza & Ratza), Trix Ockeloen-Kruit (Knijff)

Capital capers

At London's InterContinental at Hyde Park, more than 600 members and guests met to catch up on the year's news, and enjoy an address by Catherine Wolfe that recapped the changes seen in 2013 and the exciting things to come. Catherine also recognised the year's award winners:

- Adrian Spencer Memorial Award for the candidate with highest marks in Paper T3 (Advanced UK Trade Mark Law and Practice) – Charlotte Blakey, Keltie LLP
- Payne/Bennett Memorial Award for the candidate with the highest mark in Paper T4 (Advanced Trade Mark Search) – David Warrilow, London IP Ltd
- Nick Wilson Memorial Award for the candidate with highest marks in Paper D&C (UK Designs and Copyright Law) – Edward Johnstone, Withers & Rogers LLP
- Prize donated by Thomson CompuMark for highest mark in ITMA Trade Mark Administrators' 2013 Exam – Danielle Jeeves, Cleveland
- Hogarth Chambers Prize for achieving the highest mark by a Trade Mark Attorney in the Intellectual Property Litigation and Advocacy Course – Rigel Moss McGrath of WP Thompson.



RULES OF THE GAMES



Robert Buchan advises on how to avoid aggravation during the XX Commonwealth Games

Scotland has been voted the third-best country to visit in 2014 by *Lonely Planet*, in part due to the fact that Glasgow is hosting the 2014 Commonwealth Games, which will see 4,500 athletes competing in 17 sports for more than 260 medals between 23 July and 3 August. Already, more than one million tickets have been sold, demonstrating the huge commercial draw of global sporting events – events that could not take place or attract international

audiences without significant financial sponsorship and investment.

Given the recent success of the London Olympic Games in 2012, readers may be relatively familiar with the legal protection, including brand protection, afforded to such events. However, unless brand owners and businesses are advised as to what they can and cannot do in the run-up to and during the 2014 Games – particularly those located within areas in which the Games are being hosted – they could find themselves facing civil or criminal liability. To assist those advising on

the issue, this article will first consider the reasons why additional legal protection is required and then provide an overview of the 2014 Games protection that is in place.

Why special protection?

For trade mark professionals – for whom brand protection is clearly close to their hearts – it can be easy to overlook the fact that one person's legitimate brand-protection measures can be seen as another person's inability to show support for something about which they are passionate. Indeed, as evidenced by

Terms of infringement

The tables below contain words that, if used in combination, are likely to give rise to presumption of infringement

Table A

GAMES	GLASGOW
TWO THOUSAND AND FOURTEEN	MEDALS
2014	SPONSORS
XXth	GOLD

Table B

SILVER
BRONZE

some of the press surrounding the enforcement campaign in 2012, this difference in viewpoint can generate negative publicity for an event and its (often large, corporate) sponsors.

However, the reality is that the necessity for significant sponsorship for such high-profile events means that legal protection is required to prevent free-riding on the associated goodwill. The special measures taken are not just about protecting the investments made by current sponsors, but also ensuring that the legacy is maintained to allow future events to take place. And, given the huge amount of spectators involved, public health and safety is also protected by avoiding a myriad of unofficial street traders blocking access to venues.

Whether the measures are seen to be legitimate and proportionate will in large part be judged by the enforcement that takes place in relation to the event. A firm hand in the run-up may generate some negative publicity, but can send out a clear deterrent message and avoid, for example, large-scale ambush marketing during a televised event.

Meanwhile, traditional forms of IP protection still have an important role to play – for example protecting the Commonwealth Games logo, the words “Glasgow 2014”, and the image and name of the official mascot, “Clyde”. Clearly such rights can be enforced in the usual manner. However, this article will focus on the specific additional protection that has been put in place as it is this that is likely to catch people out and, in particular, more likely to be enforced immediately preceding and during the Games.

Overarching legislation

The overarching legislation is the Glasgow Commonwealth Games Act 2008, with the main framework being implemented by the Glasgow Commonwealth Games Act 2008 (Games Association Right) Order 2009 and the Glasgow Commonwealth Games (Trading and Advertising) (Scotland) Regulations 2013.

The Association Right

The 2009 Order came into effect in January 2010. It creates an exclusive legal right known as the Glasgow Commonwealth Games Association Right. It is infringed if, in the course of business, a person uses, in relation to goods or services, any representation that is likely to suggest to the public that there is an association between that person or their goods or services and the Games. This could cover a wide variety of activities, but in essence prevents the use of images or words in advertising, or on the packaging of or the goods themselves, that implies such an association. So, for example, websites looking to promote accommodation or activities in Glasgow by using the Games logo or the “Glasgow 2014” name are likely to fall foul of these rights.

Although not specified in the 2009 Order, guidance issued by the 2014 legal team indicates that, although not conclusive, when assessing infringement, the following are likely to give rise to a presumption of infringement: expressions in which use is made of any two of the words set out in Table A (above); or that contain any word in Table A, together with one or more of the words in Table B.

Therefore, a business making prominent use of “Glasgow Games” may find itself on the sharp end of an infringement action that includes injunctive relief, as well as the delivery up or destruction of infringing materials. The Association Right lasts for six months after the closing ceremony in August 2014.

However, it is not only a one-way track. The 2009 Order provides a remedy for groundless threats of infringement proceedings in relation to the Association Right. In addition, there are several defences, such as legitimate use of a person’s own name or address, use of an existing registered design or trade mark, or continuous use prior to the Order coming into effect in January 2010. In addition, infringement does not occur where the use is honest and relates, for example, to indications →

of kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services. Understandably, from a practical point of view, there is also a defence for use made in a publication or broadcast about the Games.

Trading and advertising offences

In an effort to prevent ambush marketing, the 2013 Order creates trading and advertising offences in “event zones” during the Games. Essentially, this allows the organising committee to control advertising and outdoor trading in the vicinity of venues during, and for a period before, the event. One interesting difference between 2014 Games and the Olympic Games of 2012 is that there is not a central sporting village. Instead, there are 17 event zones in and around Glasgow, including an area in Edinburgh where the swimming events will take place. This is likely to make the work of the appointed enforcement officers (essentially they will act as trading standards officers) more of a challenge.

The trading offence is wide and prevents street trading in or around the event zones. Not only does it prevent the actual sale or offering for sale of goods or services, but it also prevents seeking charitable donations or providing public entertainment. Buildings normally used as retail premises, such as restaurants or shops, are exempt, albeit they will have to ensure their displays of promotional material do not breach the separate advertising offence.

The advertising offence prevents advertising in relation to goods, services or a business in the event zones. It is wide and will prevent billboards, leafleting, providing free goods as part of a sale, branded vehicles or fancy-dress costumes promoting a business. There are specific exemptions for individuals wearing advertising attire, displaying advertisements on their bodies or carrying personal property, except where that individual knew or had reasonable cause to believe that they

were participating in an ambush marketing campaign.

As well as creating criminal offences punishable by fine, the enforcement officers have wide powers to prevent the commission of any offence by, for example, seizing articles or entering any place where they believe offences have been or are likely to be committed.

Interesting times

I am sure that the Games will be a huge success and that the legal protections in place will assist. However, the allure of a global audience for some brand owners and businesses is likely to mean that there will be a need for vigilant monitoring and appropriate enforcement. No doubt some larger sporting brands already have legal advice in place about how they can prominently advertise their brand without falling foul of the various protections. With brands and sports heavily intertwined, it will be interesting to watch both the sporting and branding games this summer.

The allure of a global audience for some brand owners and businesses is likely to mean that there will be a need for vigilant monitoring and enforcement

Robert Buchan

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robert.buchan@brodies.com

Robert specialises in IP and IT disputes in Scotland, is an associate member of ITMA, and is accredited as an IP specialist by the Law Society of Scotland.



Change ahead

Tania Clark summarises the main concerns raised at an ITMA event on EU trade mark reform

On 29 October 2013, Imogen Wiseman of Cleveland IP presented a stimulating insight into the proposed European Union (EU) trade mark reforms, clearly highlighting the main issues involved.

Key proposals and concerns

1) Terminology

The Community Trade Mark (CTM) will be replaced with the “European Union Trade Mark”, while OHIM will be known as the “European Union Intellectual Property Agency”.

2) Graphical representation

The definition of the requirement for a sign to be capable of “graphical representation” is to be amended to: “capable of being represented in the Register of European Union Trade Marks in a manner which enables the competent authority and the public to determine the precise subject of the protection afforded to its proprietor.”

One question is how will this sit with the well-known criteria relating to “graphical representation” set out by the Court of Justice of the EU (CJEU) in *Sieckmann v Deutsches Patent- und Markenamt*, Case 273/100. Perhaps these criteria ought to be reflected in the new legislative provisions? *Prima facie*, it appears that the proposed wording would permit the acceptance of smells and sounds as trade marks, as well as allowing for moving images to be represented by digital methods, rather than a series of stills and an accompanying description.

3) Absolute grounds of refusal

National offices ought to object to trade mark applications that would fall foul of trade mark laws in other Member States. Offices should refuse applications in a foreign language or script that, when translated into an official language of any Member State, would be incapable of registration. This will increase the burden on offices to understand the implications of the translation or transliteration of trade marks.

4) Acquired distinctiveness

There ought to be acceptance of evidence of acquired distinctiveness that originates from after the filing date of the application. This will create an additional administrative burden on the relevant offices to evaluate and place weight on evidence from different stages in the application process. For example, if evidence is submitted only after the filing date, should this be treated with less value as the same evidence dated prior to the filing date?

5) Double identity

Where the marks and goods or services are identical, infringing use must affect the origin function of the trade mark in question. There is no acknowledgement of the other trade mark functions set out in *L'Oréal* – for example, communication, advertisement and investment. This may lead to referrals to the CJEU to

Where the marks and goods or services are identical, infringing use must affect the origin function of the trade mark in question

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clarify the true scope of function(s) of a trade mark.

6) Goods in transit

The European Commission would like to introduce a provision allowing trade mark owners to prevent the import of counterfeit goods into the EU without being released for free circulation, so long as the trade mark is registered in the country of destination.

7) Goods and services

There will be individual class fees for CTM applications; the current model of paying fees for up to three classes will be removed. In addition, the Commission wishes for the IP Translator decision to be codified.

8) Relative grounds for refusal

National offices ought to limit their examination to absolute grounds. This would result in the uniform removal of relative grounds examination across the EU. However, this would be without prejudice to offices providing searches and notifications on a purely informative basis.

9) Marks with reputation

Where cases rely on the reputation of an earlier mark, the reputation must reside in the Member State where the action is brought. For example, when objecting to a French application based on the reputation of a CTM, the earlier mark covered by the CTM must have a reputation in France.

10) Bad faith opposition

The Commission supports allowing owners of earlier marks to oppose bad faith applications in the EU where the contested application might be confused with an earlier mark protected outside of the EU. But why should owners within the EU be omitted from the benefit of this?

The proposed amendments are now being scrutinised by the European Council and we ought to know more about the breadth of the resulting changes in the next six to 12 months.





ROWAN RETURNS

ITMA CEO Keven Bader talks IP with Steve Rowan, Divisional Director of the Trade Marks and Design Division, about his history and his future plans

Keven Bader: What is your background in IP, and trade marks in particular?

Steve Rowan: I joined the IPO in 1991 and I have worked in a number of teams across the Office, but they represent a fair balance of operations and policy work across patents, trade marks and designs. I've also worked on IP enforcement issues and, most recently, copyright policy. During my time in the IPO, I have also spent time on secondment to the Prime Minister's Strategy Unit and working on the Gowers Review of IP at The Treasury.

As for trade marks and designs, I joined the Trade Marks and Designs Directorate (TMD) in 1997, working in the Law Section – now known as the Tribunal Section – and I worked my way up to become a Principal Hearing Officer. I really enjoyed the time I spent in TMD and it was somewhere that I always planned to return to.

KB: We worked together in the TMD Law Section from 1999 to 2003. How different do you think things are in the TMD since you last worked there, and what do you feel are the main differences?

SR: First, it is great to be back in TMD (now the Trade Marks and Design Division). The people in the TMD teams are hard-working, easy to work with and they have made me very welcome, so I'm feeling right at home. Your question is interesting, as it is one I have asked myself. In many ways it all feels fairly familiar, and I've been reading into the recent case law and changes in practice. However, I slipped up the other day when I said there were 42 classes of

goods and services, and was politely corrected by a colleague that there are now 45. I won't make that mistake again.

The main change since I was last in TMD is the introduction of full electronic case working for processing trade marks (known internally as the TM10 project). It has radically altered the way we all work, from new applications, through examination and tribunal cases, through to recording assignments and changes of name. As someone from within the Office, but outside TMD, I know what an effort it was for all the staff to bring in this IT and business-improvement project. I know, too, that it meant changes for our customers and we are grateful for your feedback, which will enable us to make further enhancements to the services that affect you.

I will be taking some hearings and writing some decisions, so I need to be trained how to use TM10!

KB: The post of Divisional Director in the TMD is a new post. How does it fit into the structure of TMD and the IPO, and what are your main responsibilities?

SR: The IPO has restructured its executive board, but most of these changes will be fairly invisible to external customers. The main change was to create two senior roles just below the "CEO and Comptroller General and Registrar" (one person, despite three titles). One of those is the role of Deputy CEO, held by Sean Dennehey, who now has overall responsibility for the Patents Division and the TMD.



My main responsibilities are to oversee the day-to-day running of the operational, policy and tribunal functions of the Trade Marks and Designs Division

This looks like an operations directorate, but it is more than that as both the Patents Division and TMD are responsible for their relevant policy areas and, of course, also have Tribunal Functions.

So my main responsibilities are to oversee the day-to-day running of the operational, policy and tribunal functions of the Trade Marks and Designs Division. I work with colleagues to try to deliver the very best service we can to our customers, including providing advice to the Minister for IP on any trade mark or designs issues.

I also feed into the senior leadership team within Sean's Directorate and also the wider Office. I will also be looking to work with colleagues from the Patents Division on cross-cutting issues, such as customer visits and experiences such as TMD's implementation of major IT projects like TM10.

KB: What are the biggest challenges and opportunities you see in your new role?

SR: That's a big question. Seven weeks in I would say that there are three big challenges that have immediately struck me.

The first is to better understand our customers – what they want and when. This should help us shape our services and targets, so that we're delivering what the customer wants. Current IT projects like MyIPO are clearly part of that, and will impact on the IPO and the way we work. Getting a better understanding of customers might also help us comprehend our current

high level of demand for trade marks and the lack of demand for designs. I'd like to try to understand what drives our demand, so we can plan better and also target our support. Why is it that the UK's design system is underused compared to the French and German systems?

That takes me neatly on to my second point on demand – which for trade marks is currently running 20 per cent higher than last year. September filings were up 26 per cent on the previous September. I think we'll hit around 50,000 trade mark applications this year. We don't know why, and this high level of demand, which has been growing year-on-year for the past five years, is putting pressure on all the teams. At the moment, we're still examining at around 10 to 12 days from filing, but this increase in work is flowing through into *ex parte* hearings, oppositions and post-registration recording of changes of name, assignments, etc. We need to make sure TMD has the necessary capacity and capability to examine and register high-quality rights and to issue timely and high-quality decisions on oppositions, etc. As part of that, we recently ran an external recruitment project for new trade mark examiners and we plan to begin training the successful candidates early this year. I'll want to look with colleagues at succession planning and training, and development across TMD and the wider IPO so we can meet the challenges of this increase in demand.

Finally, I think the international dimension is also interesting. Things have changed a lot since I left TMD and two recent visits to OHIM have



I'd like to build on the already strong relationship that organisations such as ITMA have with the IPO and with the Trade Marks and Designs Division in particular

reinforced my view on the increasing importance of the European and international dimension to the work. Having worked on international policy for several years, I know how important this work is. Much of the framework is now set internationally

or in Europe, and it is vital that TMD influences the debate on issues such as the recasting of the Trade Marks Directive and Regulation – but also on important issues of trade mark and design practice by working with OHIM on establishing common practice across the European Union. The international and European markets are critical to our customers and to the success of their brands in other markets. I want to work with our customers and the international team here at the IPO to make sure that TMD is playing a role in targeting its support in key markets.

KB: Are there any particular things you are looking to change or focus on in the initial months?

SR: Internally, I've concentrated on trying to get to know the various teams and their roles. Externally, I've been looking to meet representative bodies and individuals, and also international contacts. My focus has been on current challenges such as the IP Bill, trade mark reform in Europe and the proposed WIPO Treaty on Design Law. In the past two years I've led the UK delegation to the Beijing and then Marrakesh Diplomatic Conferences, so a potential Diplomatic Conference on designs is interesting.

KB: What role do you see, if any, for ITMA as a representative organisation for the profession in supporting initiatives from the IPO or challenging ideas and policies?

SR: I think it is vital that the IPO has an open and constructive relationship with everyone that uses its services, or who has an interest in policy discussions. I'd like to build on the already strong relationship that organisations such as ITMA have with the IPO and with the TMD in particular. It's equally important that, within that relationship, both sides can challenge each other. No one has a monopoly on good ideas and all good ideas can be improved. I'd also like to look at how we can work together on initiatives.

KB: The Institute has overhauled the training and education programme for qualification as a Trade Mark Attorney. Do you think that the IPO might follow suit and develop a similar arrangement for Trade Mark Examiners?

SR: I'd be interested in learning more about how ITMA has overhauled its training. Training and learning and development are right at the top of the issues I want to address within the TMD. TM10 took a huge amount of time, resource and effort from everyone in the team. Now that TM10 is bedding in and we're starting to address the known teething issues, I want to focus on learning and development for all staff. That means working out what we need to do to make sure that people working in all parts of the division have access to the right training at the right time and can see a career path within the IPO. It ties in with the comment about demand. We'll need more skilled staff if we are to continue to meet our current levels of service.

KB: What are the three most important things that Trade Mark Attorneys could do to make life easier for the IPO in relation to UK applications, proceedings and registrations?

SR: I think it's too early for me to answer this question in any detail. I know that there have been teething difficulties with TM10 and that some of these still exist. We are working on the known issues with the system and various changes are being packaged up for release. So I'd ask for you to be to be patient while we resolve the issues, but I would also ask that you continue to flag up issues with us that you identify. We know our services can be improved further, and we're committed to doing that.

As someone returning to TMD, I'd also welcome comments from people asking questions or pointing out issues for me to look at. We're planning on doing some work on what we call "customer insight" soon. This will be an important piece of work and help us to understand better what you want. In the meantime, just write to me and tell me.

KB: Your opposite number in the Patents Directorate used to, and I presume still does, take hearings. Do you think it's important for the Divisional Director of the TMD to do the same?

SR: I don't think it is essential. Some of my predecessors took hearings, others didn't. The legal side of the trade mark work has always interested me, so I plan to take hearings when I can. I've just been allocated my first case – it's on my desk as we speak – and the eight-week deadline for issuing the decision is ticking!

KB: The Trade Marks Act 1994 will have been in place for 20 years in 2014. Do you think it is still fit for purpose or it is time for an overhaul? Will the European Commission's review of the European trade marks system force the UK to review its own trade mark legislation?

SR: I am pleased to be rejoining TMD at a time when this issue is centre stage. I've discussed the current planned reforms with colleagues in the IPO and with colleagues from other Member States, the European Parliament and the European Commission. I don't think anyone would disagree that the Community Trade Mark

and Directive have been a huge success and that OHIM has been a key part of that success. Equally, I think it became clear very early on that improvements to the system could be made. All legislation needs to be kept under review to make sure that it is meeting the policy objectives it set out to achieve. That's why the UK welcomed the review and has been working hard to make sure that the outcome is good for UK business and promotes growth. It is important that we get this right, as I doubt there will be another opportunity for many years. There is still some way to go on the review and time is ticking with the European Parliament elections scheduled for May. We're working hard with all the European partners to push this dossier along as quickly as possible, but, as I said, we're very mindful that what we agree must be right; it has to improve the current system and not be a backward step. Any changes in the Directive would have to be reflected in UK law. So once we know what the Directive looks like, we'll have to consider what changes we need to make.



All legislation needs to be kept under review to make sure that it is meeting the policy objectives it set out to achieve. That's why the UK welcomed the review and has been working hard to make sure that the outcome is good

THE ITMA SPRING CONFERENCE 2014

MEDIA POP CULTURE AND THE LAW

CPD

9 IPReg hours;
8 Law Society hours
(course code WP/ITMA);
8 Bar Standards
Board hours



*Our Spring Conference
muses on modern issues in
a new historic home*

This March, the international ITMA Spring Conference will cast the media in a starring role. In all its guises, the media forms an increasingly important part of everyday life, fuelled by an on-going stream of technological advances.

Difficulties arise when legal principles, which may have been in place for many decades, are needed to deal with the problems caused by those technological advances, or even to deal with new situations that have occurred following changes in societal behaviour and norms.

As a key theme this year, the conference will examine the current and developing law and practice in these new areas, and will provide

thoughts and advice on dealing with, or advising clients on how to deal with, the novel legal situations that continue to arise.

And of course, as ever, the programme will feature a range of trade mark issues, with a particular focus on remedies and solutions.

Historic new home

Hosting the event is a new home, but we continue to enjoy a very central location. We are delighted to have secured Church House Conference Centre as the main venue for the event.

Church House is within walking distance of both Westminster and St James's Park Underground stations. With amazing views of Westminster Abbey and Parliament, this truly has to be one of the finest locations in London.

From 20-21 March, the striking Assembly Hall, home of the Church of England's General Synod, will provide a historic backdrop to some fabulous presentations from an array of accomplished speakers.

The original Church House was built to commemorate the Golden Jubilee of Queen Victoria. The current building was designed by architect Sir Herbert Baker, and was opened by His Majesty King George VI on 10 June 1940.

The building suffered a direct hit in the early part of World War II, but only minimal damage was done. Prime Minister Winston Churchill was so impressed by this that the building was refurbished for use by the two Houses of Parliament for the remainder of the war. This truly is a historic building and a venerable venue for the ITMA conference.

PROGRAMME HIGHLIGHTS

REGISTERING FAMOUS AND HISTORIC NAMES

WHAT TO DO WHEN THE BRAND GOES BAD

RELYING ON WELL-KNOWN MARKS IN OPPOSITION PROCEEDINGS

USING COPYRIGHT TO PROTECT YOUR WELL-KNOWN BRAND – AN INTERNATIONAL VIEW

AN OLYMPIC UPDATE – HOW DID RUSSIA DO, AND POINTERS FOR BRAZIL

WHAT'S INCLUDED

Attendance at all conference sessions

All conference documentation

Coffee and tea breaks as shown in programme

Welcome Drinks Reception and
Canapés on Wednesday 19 March

Conference Lunches on Thursday 20 and Friday 21 March

Drinks Reception and Gala Dinner
at One Great George Street on
Thursday 20 March

USB containing all speaker presentations

ACCOMMODATION OPTIONS

ITMA is pleased to offer these options for
local quarters:

4* Park Plaza Westminster Bridge

Offering the ideal central London location, near
numerous attractions, including the Houses of
Parliament, the London Aquarium and the London
Eye, this hotel (below) features several services to
meet the needs of the business and leisure traveller.



4* Crowne Plaza London St James

Experience Edwardian grandeur with a modern spa
and sumptuous dining.

4* St Ermin's Hotel

St Ermin's boasts the grand spaces and modern
facilities of a large hotel, while offering the
individuality of a boutique guesthouse.

5* InterContinental Westminster

Voted as Best New Business Hotel in the World
at the Business Traveller Awards 2013, this luxury
London hotel is located in the heart of Westminster.
Its prestigious façade complements a beautifully
renovated interior within a historic building to
create superb and spacious accommodation.

See itma.org.uk for
rates and details

ARE YOU READY TO REGISTER?

Book by 14 February
at itma.org.uk to save
money with our early bird
registration fees or call
+44 (0)20 7101 6090

Registration closes at 5pm
on **7 March 2014**

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Westminster Abbey

This 700-year-old structure has witnessed the most important royal occasions and is the resting place of kings, queens, statesmen, soldiers, poets and priests.

Open 9.30am to 6pm, 19 March; 9.30am to 3.30pm, 20-21 March. Entry: £18 with audio guide.



Tate Britain

Millbank. After a £45 million renovation, the home of British art has now re-opened its doors. Enjoy the revived building and the best of British art.

Open 10am to 6pm daily. Entry free.



Houses of Parliament

Book online and in advance if you'd like to take a tour of the UK's seat of political power. Available are guided tours, and even afternoon tea, or you can watch live political debate in the public galleries.

Go to parliament.uk for details and booking.

LOCAL GUIDE

This year's conference venue puts visitors at the heart of the UK's greatest political and historical highlights. Here are a few of the unique ways to take advantage of your stay

© IWM (Imperial War Museums)



Churchill War Rooms

King Charles Street. Visit the wartime bunker that sheltered the Government during the Blitz.

Adult admission £17.50. Open daily from 9.30am to 6pm (last admission at 5pm); iwm.org.uk

Lord North Street

Said to be "the most political row of houses in the country", this stately street was home to Prime Minister Harold Wilson and many other political players. See a remnant of World War II outside number 8 – a faded sign pointing the way to underground public shelters.



London Film Museum

County Hall, Queens Walk, South Bank. Go just across the river to "discover the magic behind the movies".

Adult admission £13.50. Open 10am to 5pm, Monday to Friday; 10am to 6pm, Saturday; 11am to 6pm, Sunday.

OUT OF HOURS



Urinetown

St James Theatre, 12 Palace Street.
A Tony-award-winning musical about
a revolution in a city of the future.
stjamestheatre.co.uk

Wicked

The nearby Apollo Theatre has
hosted hit musical *Wicked* since
2006. Book at atgtickets.com

FOOD & DRINK

The Red Lion

48 Parliament Street. BBC Parliament
channel is on the TV, and a Division
Bell scatters drinkers that need to rush
back for a key vote. Original features,
including impressive cut-glass mirrors,
make this a must-visit venue.



Regency Café

17-19 Regency Street. Join the queue for a
legendary slice of old-school British café
fare. Featured in the film *Layer Cake*, this
establishment was founded in 1947, and
95 per cent of the customers are regulars
drawn from across the London spectrum.

Quilon

41 Buckingham Gate. On the other end of
the scale, this Michelin-starred restaurant
focuses on south-west coastal Indian
cuisine under the direction of Chef
Sriram Aylur (a former law student).
Contacts: +44 (0)20 7821 1899,
info@quilonrestaurant.co.uk

Inn the Park, St James's Park

St James's Park. Travel across the park's
central Blue Bridge for a fairytale view
of Whitehall and settle down in this
"restaurant for all seasons". Best
enjoyed on a sunny day.



SHOPPING

Houses of Parliament shop

12 Bridge Street. Nip out quickly for a
pot of House of Commons Gunpowder
Mustard or a Home Secretary tea mug
and take a bit of Parliament home
with you. Open Monday to Thursday,
9.30am to 5.30pm; Friday, 9am to 4pm.

Royal Collection Trust shop

7 Buckingham Palace Road. If you
want to gather a royal remembrance,
visit the Royal Collection Trust shop,
selling royally appointed merchandise.
Go to royalcollectionshop.co.uk
for details. Open 9.30am to 5pm.

Farlows

9 Pall Mall. Outfitting the discerning
for outdoor pursuits for more than
170 years, this shop offers over 6,500
square feet of hunting, shooting and
fishing merchandise. Open 9am to
6pm, Monday/Tuesday/Wednesday/
Friday; 9am to 7pm, Thursday;
10am to 6pm, Saturday.

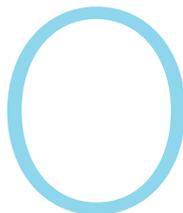
Floris

89 Jermyn Street. Venture north of
St James's Park to visit the "Purveyors
of The Finest Perfumes & Toiletries to
the Court of St James's Since the Year
1730". Open 9.30am to 6pm, Monday
to Friday; 10am to 6pm, Saturday.



BRACE FOR IMPACT!

Joanne Goodchild advises on how brand owners can survive the domain name explosion



Once domain name applications can be accepted under the new generic Top-Level Domains (gTLDs), the online landscape will be vast. The first few

gTLDs are already operational (at the time of writing, four non-Latin script gTLDs) and the remainder are expected to roll out over the next two to three years. However, there remains an air of complacency in the business world that could be explained by the lack of easily digestible information on how businesses can preserve and optimise their position in the online marketplace when the new registries are open, as well as the risks they could face if they do not.

Trade marks will be vital to safeguarding interests in the new domain space and Trade Mark Attorneys should be advising now that budgeting for defensive measures will be justified if they prevent, or make it easier to take action against, misuse of a trade mark in a new gTLD. This is one of the reasons we register a trade mark in the first place, and the registration of a trade mark opens up many of the rights protection mechanisms that have been woven throughout the gTLD process. While big brands will have the security of control over their own gTLD, such as *.gucci*, the majority of businesses will not, so it is even more important that they understand the implications of the introduction of the new gTLDs and

take advantage of the defensive measures that have been created specifically for brand owners.

In addition to the risk of mere inclusion of a client's trade mark in a domain name (as at present), there will be greater scope for contextual confusion as referred to in a legal rights objection case that arose during the gTLD objection window, relating to the .moto gTLD (Motorola Trademark Holdings LLC v United TLD Holdco Ltd: LRO 2013-0054).

Here, the Applicant knew about the MOTO trade mark, but its use of "moto" was consistent with its claim that it chose .moto as a description for motorcycles. Motorola was concerned about the possibility of domain names such as *cellular.moto* causing confusion, but the objection was dismissed because "moto" has a dictionary meaning and use of this as a gTLD in itself would not cause confusion. Beyond this, it was stated that the domain name registrants seeking domain names with the .moto gTLD would themselves be legally responsible if their registration caused confusion. It is suggested therefore that *cellular.moto* would be an actionable combination.

Preparation

So what action should be taken to avoid the risks involved in the gTLD explosion?

Portfolio review

Clients should identify all important trade marks and fill any gaps in trade mark protection as soon as possible. The UK trade mark registration system, being one of the fastest in the world, should be particularly attractive to those seeking a swift registration for the purposes of gTLD action, as there is no concept of geographical limitation in this arena at present.

Trade Mark Clearinghouse (TMCH)
Log trade marks with the TMCH to access the benefits of:

Registration. Logging a valid, preferably registered, trade mark with evidence of use will entitle the client to grab the corresponding domain name before the gTLD is opened generally. Registering its own important trade marks as domain names within each registry of interest is also a pre-emptive measure that might save the client time and money, as well as being a marketing tool, and an asset.

The UK trade mark registration system, being one of the fastest in the world, should be particularly attractive to those seeking a swift registration for the purposes of gTLD action

Notification. Applicants will be notified about any trade marks logged with the TMCH that correspond to the domain name they are seeking to register, together with details of any successful actions that "abused labels" have filed. If the Applicant is not deterred by this and proceeds to registration, the trade mark owner will be informed. It can then determine what, if any, action should be taken.

Watching

The TMCH has limitations in that early domain name registration access for trade mark owners and the notification facility lasts only for a limited period after each gTLD becomes operational. It is therefore advisable that clients also subscribe to a watching service so that they will be notified of anyone registering a conflicting domain name after this period.

Monitoring

A close eye should be kept on the gTLD registries that are opening so that clients can see whether they want to acquire domain names within them or to police potential infringements. At present, it would be prudent to identify each gTLD in

terms of the following and take action accordingly:

An opportunity. Clients can register domain names in that gTLD to enhance their business. Trade mark owners with rights logged with the TMCH are best placed to get domain names relevant to their brand.

A potential threat. Registration would be the obvious precaution if opportunistic or competitor registration seems possible. It is more difficult to remedy the position than to prevent it. However, if the trade mark owner is too late, then it should be prepared to take action using the dispute resolution procedures in place (the Uniform Domain-Name Dispute-Resolution Policy and the Uniform Rapid Suspension System).

Neither opportunity nor threat. No action required.

A word of caution

Unsolicited communications from third parties are already causing issues for clients. In previous rounds of Top-Level Domain name introductions, clients were contacted by Registrars "advising" that third parties were trying to register domain names corresponding to their trade marks. The solution "helpfully" suggested by the Registrar was to block the application by registering the domain name first. In many cases where the trade mark owner declined to act, the third party and their domain name never materialised. By logging rights with the TMCH and/or subscribing to a watching service through a trusted trade mark adviser, clients can be reassured that the legitimate communications emanate from a single source.

The new gTLDs could open up opportunities in the global online marketplace, but, given the potential risks, businesses could benefit from guidance from their Trade Mark Attorneys on putting in place an effective gTLD strategy.

A full list of the gTLDs applied for and their current status can be found at: <https://gtldresult.icann.org/application-result/applicationstatus>

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HANDLE WITH CARE

Mark Caddle was one of those hanging on our webinar speaker's words about handling client monies. He provides this report

Chris Beanland, a Solicitor and Associate Professor at The University of Law, provided an insightful overview for ITMA members of the guiding principles that must be adhered to when handling client monies, as part of an ITMA/CIPA webinar in the autumn.

Through his experience as a legal practitioner in the field of insolvency law, Beanland has developed an advanced knowledge of client care and management, particularly in respect of the handling of client monies. His aims in this webinar were to introduce general issues surrounding the care of client monies and the best practices underpinning this process. To ensure the focus was on core issues, he vowed to avoid giving a detailed insight into accounting principles.

Given that we are part of a regulated profession, rules on client monies are imposed on the profession by IPReg. As fiduciaries to our clients, we owe them a duty of care and must protect their best interests. Such duties are of fundamental importance when considering the handling of client monies. As one would expect, there are principles that influence and guide the undertaking of such duties.

Basic principles

Client money is money that is held for, or received from, a client (for example up-front costs for a specific piece of work, payment of disbursements etc). As a general rule, it is all money that is not attributable to the firm ("office money"). Office money includes, for

As fiduciaries to our clients, we owe them a duty of care and must protect their best interests. Such duties are of fundamental importance when considering the handling of client monies

example, money received in respect of a bill paid by a client for work carried out on its behalf.

Client money must be:

- 1) kept separate from the firm's money (ie there must be at least one separate client bank account);

- 2) identifiable and kept in a separate bank account (this does not require a separate bank account for each client; this can be satisfied by having individual ledgers for each client); and
- 3) used for client matters only.

Furthermore, it is the responsibility of those handling client monies to:

- 4) establish and maintain proper accounting systems; and
- 5) establish proper internal controls over systems and provide training to those responsible for client monies.

In applying these principles, there are no prescribed rules that must be followed. Compliance with these obligations is to be determined by those handling the monies, which are likely to be under the care of an accounting department. Therefore, the principles are fluid in their effect.

In handling client monies, the terms and conditions that are authorised by the client at the time of engagement govern when money can be withdrawn from its accounts. For example, the terms and conditions may stipulate that a firm can make payment of disbursements and any payments that are instructed by the client – for example, official fees and service charges related to a piece of work. Therefore, Chris emphasised, setting out clear, accurate and understandable terms and conditions is vital.

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Discretion dispute

Carrie Bradley reports on a decision related to late submission of evidence in opposition proceedings

This case concerned an appeal all the way up to the Court of Justice of the European Union (CJEU) in respect of an OHIM Opposition Division (OD) decision. The OD had rejected an opposition on the ground that the Opponent had failed to prove, within the time limit set, the existence and validity of the earlier marks relied upon in support of the opposition.

The Opponent had supplied copies of the relevant registration certificates, together with translations into the language of the proceedings, but had failed to provide renewal certificates in respect of the marks registered more than 10 years ago, nor translations thereof. The OD considered that the translated registration certificates were not sufficient to establish that the earlier registrations were valid at the relevant time, and the online extracts submitted that indicated a renewal date could not be taken into account since they had not been translated.

Upon receipt of the Notice of Opposition, the OD had advised the Opponent that further evidence and translations were required in this regard. The Opponent, however, failed to substantiate the opposition within the time allowed.

The Opponent appealed to the Fourth Board of Appeal (BoA) of OHIM, which promptly dismissed the appeal without assessing the merits of the opposition, finding that the OD's decision had been correct. The BoA stated that neither the OD nor itself had discretion under Article 74(2) of Council Regulation (EC) No 40/94 (now replaced by Council Regulation (EC) 207/2009 – the Community Trade

Mark (CTM) Regulation) to take into account evidence that was submitted in support of an opposition after the expiry of the period set for that purpose. Its reasoning on this point was that the provision (expressly laid down in Commission Regulation (EC) No 1041/2005) outlining the legal consequence for this deficiency, namely the rejection of the opposition, could cease to have any practical effect if the BoA can simply exercise its discretion to overrule it.

The Opponent sought an annulment of the contested decision with the General Court (GC), but the

GC concurred with the BoA and dismissed the action. Consequently, the Opponent then asked the CJEU to set aside the decision of the GC.

The CJEU found that there had been an error in law that vitiated the judgment under appeal. The CJEU determined that the BoA does in fact enjoy such discretion, as expressly provided by the third subparagraph of Rule 50(1) of the Implementing Regulation. However, in considering what circumstances preclude supplementary evidence from being taken into account, the CJEU went on to deem that the error concerned could not lead to the setting aside of that judgment, since the GC's rejection was well founded on other such legal grounds.

Conclusion

This case serves as a reminder to practitioners that, while the requisite discretion has been conferred upon the BoA to admit late submissions, it will only do so if the surrounding circumstances are capable of justifying the delay. The fact that the Opponent was in possession of the necessary proof of renewal, but failed to submit it together with a translation, offered no justification for the BoA to exercise its discretion in this case.

This case also confirms that an appeal must state precisely the contested elements of the judgment that the appellant seeks to have set aside, in addition to the legal arguments specifically advanced in support of the appeal, failing which it will be deemed inadmissible (see also on this point Case C-487/06 P *British Aggregates v Commission* [2008] ECR I-10515, para 121).



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 Carrie advises on all aspects of IP protection, enforcement and dispute resolution.



Zoo to-do

Decision sees two sport marks sufficiently similar, says Simon Miles

On 24 February 2010, Zoo Sport Limited ("Zoo Sport") filed a Community Trade Mark (CTM) application for the figurative mark "zoo sport" covering classes 18, 25 and 35, shown on this page (top). On 29 June 2010, K-2 Corp filed a notice of opposition pursuant to Article 41 of Council Regulation (EC) No 207/2009 (the CTM Regulation). K-2 Corp relied on, among others, the CTM shown on this page, registered on 8 June 2007, covering classes 25, 35, 36 and 41.

On 13 May 2011, the Opposition Division upheld the opposition pursuant to Article 8(1)(b) of the CTM Regulation, in so far as it was based on the earlier figurative mark, for all of the goods in classes 18 and 25. By a decision of 9 August 2012, the OHIM Board of Appeal allowed Zoo Sport's appeal for the goods "sports bags" (being different to goods in class 25) and dismissed the appeal as to the remaining goods. The simple plea in law by Zoo Sport was that the Board should have found that the signs as a whole were different.

General Court decision

In looking at the visual, phonetic and conceptual similarities between the marks, the General Court upheld the Board of Appeal's decision, deciding that:

- The marks had an average degree of visual similarity. The first three letters of the dominant and most distinctive element of the earlier figurative mark, "zoot" or "zootz", are the same as the element "zoo". The marks also had the element "sport" in common.
- The differences between the marks, including the position of the various elements of the marks, the font, and



There was an average visual and phonetic similarity of the marks, and the comparison did not establish a significant difference

the fact that the word "sports" appears twice in the earlier figurative mark were considered to be minor.

- Notwithstanding Zoo Sport's arguments that the earlier figurative mark must be pronounced in its registered form, "sports-zoot-sports", this was unlikely. In the public's perception, that mark presented in the graphic form is thus "zoot sports" or "zootz sports".
- In short, the phonetic impact of the last letter "t" or "z" did not offset the global similarities resulting from the pronunciation of the common element "zoo".
- While Zoo Sport argued that the term "zoot" and "zoo" were conceptually different, with the former being a creative syntax of the English word "suit" and the latter being a zoological garden, "zoo sport" taken as a whole would not be understood by the public as meaning a zoological garden. In addition, the term "zoot suit" is not part of the common vocabulary.

The General Court therefore found that the marks have a conceptual difference owing to the use of the elements "zoo" and "zoot", which is not totally neutralised by the low degree of conceptual similarity caused by the use of the word "sport" or "sports" on the marks.

Ultimately, the General Court held that the Board of Appeal was correct

to conclude that there was a likelihood of confusion between the marks. The goods in class 25 were identical, there was an average visual and phonetic similarity of the marks, and conceptually the comparison of the marks did not establish a significant difference between them.

This case highlights the importance of a systematic approach in weighing up the visual, phonetic and conceptual similarities and differences of marks where conflict occurs.

THE CONTESTED MARKS



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Isdin is back in play

*A long-running pharmaceutical dispute is returned for review.
Rupert Bent reports*

Isdin SA (“Isdin”), the Claimant in this case, is a pharmaceutical company that develops products for dermatological conditions. On April 2008, Isdin filed an application for the registration of a Community Trade Mark (CTM) relating to the word ZEBEXIR in classes 3 and 5.

The Defendant, Bial-Portela & Ca SA (“Bial”), is also a pharmaceutical company, which in 2008 developed a drug known as ZEBINIX currently used in the treatment of epilepsy. Bial registered ZEBINIX on 14 March 2005 as a Community Word Mark in classes 3, 5 and 42.

The specifications for the overlapping classes are as follows:

- 1) Class 3 – “Bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices”; and
- 2) Class 5 – “Pharmaceutical, veterinary and sanitary preparations; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides”.

Bial applied to the Opposition Division in an attempt to deny Isdin’s application to register ZEBEXIR as a trade mark. This was based upon the fact that Bial had registered the mark ZEBINIX prior to Isdin’s application, and that, as per Article 8(1)(b) of Council Regulation (EC) No 207/2009 (the CTM Regulation), it believed there was a likelihood of confusion between the two marks.

This opposition was rejected. It was found by the Opposition Division that there was no likelihood of confusion between the trade marks and so the application was allowed to proceed.

Appeal process

Bial therefore filed an appeal on 13 October 2009 with OHIM under Articles 58-64 of the CTM Regulation.

The issue was considered by the First Board of Appeal of OHIM, which once again rejected Bial’s appeal in its entirety. This decision was based upon the fact that there were phonetic as well as visual differences between the marks, and that these differences were sufficient to exclude a likelihood of confusion.

Undeterred, on 16 July 2011, Bial took the matter to the General Court of the European Union (EU), seeking an annulment of the decision reached by the First Board of Appeal, and an order requiring OHIM to refuse to register Isdin’s mark.

To support its appeal, Bial raised a single plea in law, alleging infringement of Article 8(1)(b) of the CTM Regulation, which sets out the relative grounds under which a trade mark may be refused registration. Bial contended that the Board of Appeal had not applied such grounds correctly when considering the issue of confusion on behalf of the typical EU consumer.

The General Court held that Bial’s request for the court to issue an order to OHIM was inadmissible, but was in agreement concerning the point of law. Key findings of the General Court included that:

- 1) The two marks should be considered visually similar despite the existing differences referred to by OHIM. The fact that the first half of the word, “ZEB”, was duplicated in both marks created an impression of similarity that would in all likelihood confuse the reasonably observant consumer of an EU member.
- 2) The pronunciation of the words phonetically was sufficiently close so as to create confusion.
- 3) The fact that some of the products bearing the mark ZEBEXIR were actively being marketed to customers (for instance in supermarkets) was of importance when assessing the significance of visual similarity with a view to determining the overall likelihood of confusion.

In relation to the third point above, it should be noted that not all of the products being sold under the mark ZEBEXIR (specifically many listed under class 5) were to be actively marketed to customers. The General Court did not take into account such products in its decision-making process.

Isdin and CJEU

Isdin applied to the Court of Justice of the European Union (CJEU) seeking to set aside the judgment of the General Court. This appeal was endorsed by OHIM, which agreed with Isdin that the judgment was erroneous.

The key basis of Isdin’s appeal was that the General Court had failed to correctly apply the law to the issue at hand. When considering a mark for the purposes of confusion, the overall mark should be assessed, rather than individual components of that mark.

When considering a mark for the purposes of confusion, the overall mark should be assessed, rather than individual components of that mark

Further, where a court does feel it is necessary to draw a distinction between certain elements of a trade mark, it must give reasons for doing so, as per Article 36 of the Statute of the CJEU.

First, therefore, Isdin alleged that the General Court had not considered the fact that some goods under class 5 would not be marketed to the public under the mark ZEBEXIR (such as those sold at a pharmacy) when coming to its decision concerning the likelihood of confusion. It had not considered the overall impression of the mark, rather only part of it.

Second, as the General Court had taken it upon itself to draw a distinction between various goods in class 5 (based on the manner in which they were marketed), it was under an obligation to set out the reasons why it had decided to draw such a distinction.

Decision

The appeal was allowed and the judgment of the General Court was set aside on 17 October 2013. The CJEU has referred the issue back to

the General Court to be reconsidered. The case has yet to be listed.

It was ruled that “it must be held that such an assessment is lacking as regards the other goods in that class 5 [those not marketed to consumers directly] which are covered by the trade mark application at issue” and that “it was incumbent on the General Court to set out reasons for its decision with regard to each group of goods which it had established within that class”.

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Water woes

Delayed evidence helped sink the Applicant's argument, explains Joanna Lucas Munce



On 5 May 1999, SFC Jardibric (“SFC”) filed an application for registration of the trade mark AQUA FLOW (stylised) as a Community Trade Mark (CTM) in respect of goods in, *inter alia*, classes 6, 11, 17 and 21 for a range of watering systems and installations, tubes, valves and accessories relating thereto. Registration was granted on 6 March 2001 and renewed on 17 May 2009.

On 12 May 2009, the intervener, Aqua Center Europa SA (“Aqua Center”) lodged an application for a declaration of partial invalidity of the CTM in respect of goods covered by the CTM in classes 6, 11, 17 and 21. The application was based on Aqua Center’s Spanish national registration for VAQUA FLOW (stylised) dated 7 December 1998 covering “apparatus for the distribution of water” in class 11.

The Cancellation Division of OHIM upheld the application for invalidity in respect of goods in classes 6 (for “junctions or connections of metal, for tubes or piping used for watering

or for water supply; watering systems, mobile or fixed, above or below ground”), 11 (for “water supply, watering or irrigation installations”) and 21 (for, *inter alia*, “watering systems, mobile or fixed, above or below ground, sprinklers, sprayers, diffusers...”), but refused it in respect of goods in class 17 (for, *inter alia*, “flexible tubes, not of metal, piping, not of metal, valves, junctions, not of metal, for such tubes and piping...”) under Article 53(1)(a) in conjunction with Article 8(1)(b) of Council Regulation (EC) No 207/2009 (the CTM Regulation – CTMR).

In reaching its decision, the Cancellation Division rejected SFC’s submission that Aqua Center was prevented from seeking a declaration of invalidity of the CTM under Article 54(2) CTMR on the basis that it had acquiesced in the use of the CTM in Spain for a continuous period of five years. SFC had failed to provide the Cancellation Division with any evidence of Aqua Center’s acquiescence.

THE CONTESTED MARKS:

AQUA FLOW	SFC Jardibric
VAQUA FLOW	Aqua Center

SFC filed a notice of appeal against the decision on several grounds, including the infringement of Article 8(1)(b) and Article 54(2) CTMR. In support of the appeal, SFC filed before the Board of Appeal for the first time evidence that Aqua Center had been aware of its use of the AQUA FLOW trade mark, including invoices sent to Aqua Center by SFC.

The Board of Appeal dismissed the appeal holding that it was not equitable to take account of the evidence filed late by SFC. In any event, SFC's statements in themselves did not fulfil the conditions of acquiescence within the meaning of Article 54(2) CTMR. Further, the Board confirmed the Cancellation Division's assessment of the likelihood of confusion between the marks under Article 8(1)(b).

SFC appealed to the General Court.

The General Court

The General Court upheld the Board of Appeal's decision under both Articles 54(2) and 53(1)(a) in conjunction with Article 8(1)(b).

Article 54(2)

The Court held that, while the late submission of facts and evidence by parties to proceedings before OHIM remains possible under Article 76(2) CTMR, OHIM has a wide discretion to disregard such facts or evidence. In the context of invalidity proceedings, OHIM is justified in taking account of facts and evidence filed late where it considers that the material is relevant to the outcome of proceedings and that the stage of proceedings at which the late submission takes place does not argue against the matter being taken into account.

In this case, the Board was correct in finding that the facts and evidence submitted before it for the first time on appeal were known to SFC at the beginning of the cancellation action.

It was also right to conclude that the evidence demonstrated the complexity of the commercial relationship between SFC and Aqua Center, and that this gave rise to new questions that made it impossible to conclude that the evidence, on the face of it, was relevant to the issue of acquiescence and the outcome of the proceedings. As such, it was not equitable to admit that evidence into the proceedings on appeal.

Moreover, the arguments put forward by SFC, in themselves, were not sufficient for a finding of acquiescence on the part of Aqua Center: the fact that Aqua Center had

purchased goods under SFC's trade mark, AQUA FLOW, did not mean that it was aware of the CTM or that it acquiesced in the use thereof in Spain.

Article 8(1)(b)

The Court confirmed that the Board of Appeal had been correct in finding the existence of a likelihood of confusion.

It was right to take the view that the goods designated by Aqua Center's earlier trade mark in class 11 were identical to those of SFC's CTM in that class, and that there is an average degree of similarity between those goods and the goods specified by the CTM in classes 6 and 21, which can be fittings and spare parts for such goods.

Further, it was correct to find an average degree of visual and conceptual similarity and a high degree of phonetic similarity between the marks. Unsurprisingly, the Court rejected SFC's arguments that the differences in presentation of the marks, as well as the presence of the letter "V" at the beginning of the earlier mark, were sufficient to distinguish the marks before the relevant public.

The decision provides a helpful summary of OHIM's approach to the matter of the late submission of facts and evidence in proceedings before it, and confirms the importance of filing all information and documentation known to the parties and relevant to their arguments at the earliest possible stage.

The fact that Aqua Center had purchased goods under SFC Jardibric's trade mark did not mean that it was aware of the CTM or that it acquiesced in the use thereof in Spain

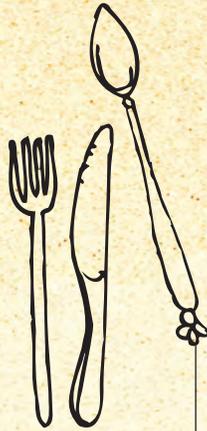
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Bristol fashion

IPEC's first case revealed a local trend in café names, as Nina O'Sullivan reports



There was a real likelihood that a significant number of people would be confused into thinking that there was a connection between the two businesses due to their similarities

On 14 October, the newly constituted Intellectual Property Enterprise Court (IPEC) issued its first decision, a straightforward passing-off case between two Bristol venues. The decision is a reminder that the court will often be able to form its own view as to likelihood of confusion in cases concerning ordinary consumer goods or services, without the need for actual witnesses.

Background

The Claimant, Bocacina, runs the successful Bocabar, a restaurant and gallery in Bristol. Opened in 2005, in recent years it has recorded a turnover of more than £1 million per year. The Defendants started the Boca Bistro Café, with more of a Portuguese theme (“Boca” means “mouth” in Portuguese), in 2012, which is also in Bristol (about three miles from the Bocabar). They registered BOCA BISTRO CAFE as a UK trade mark. At some point in 2013, the first Defendant ceased trading and the name of the café at those premises changed to “Bica Bistro Café” (it was not wholly clear who was behind the new venture).

Bocacina decided not to amend its claim to cover this new incarnation, but to reserve its position. The Enterprise Judge thought that this approach was in accordance with the IPEC’s overriding objective of assisting small and medium enterprises in resolving their disputes at low cost. He did not see that there would be any estoppel or abuse of

process if Bocacina began future litigation; and the Defendants could always apply for a declaration to alleviate any concerns they may have over permissible use.

Passing off

The Enterprise Judge decided that the Defendant’s use of the name Boca Bistro Café was passing off – and, accordingly, the Defendant’s mark was invalid under section 5(4)(a) of the Trade Marks Act 1994.

Bocacina had the requisite goodwill, which was substantial, though it did not extend beyond Bristol and the surrounding area.

Further, there was a real likelihood that a significant number of people would be confused into thinking that there was a connection between the two businesses due to the similarity of the names, the proximity of the businesses, and the type of food and services offered. The case was, the Judge noted, similar to *Wagamama v City Centre Restaurants* [1995] FSR 713. Justice Laddie had found a likelihood of confusion between WAGAMAMA and RAJAMAMA in that some would think the businesses were associated, “in the sense that one is an extension of the other...or otherwise derived

from the same source”. Further, while there was only limited evidence of confusion (and it had not been tested under cross-examination), the evidence submitted provided sufficient support for the Court’s conclusions.

Early opinion

At the case-management stage, His Honour Judge Birss QC (as he then was) had (following Bocacina’s request, to which the Defendants agreed) given a preliminary non-binding indication that the claim was likely to succeed. As the Patents County Court (PCC) Judge, he had instigated this practice in early 2012, and it is one of the Court’s tools to reduce costs and promote settlement. At a recent seminar, Birss J indicated that he had given such opinions in five or six cases in the PCC; while, in this case, it did not lead to a settlement of the dispute, it has done so in several of those other cases.

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Wishful thinking

The Defendant was deemed unable to use a venerable rock moniker, writes Katy Cullen

The case involved the band Wishbone Ash, which was formed in 1969. In common with many bands of the era, there was no agreement made between the members of the band regarding ownership of the name.

The line-up changed over time and by 1994 the Claimant was the only original member remaining. The departing members did not attempt to use the name Wishbone Ash, save for a brief period when the ex-guitarist Ted Turner formed a band in 1983. At that time, the Claimant issued a cease-and-desist letter and the use ceased.

In 1998, the Claimant applied to register WISHBONE ASH as a Community Trade Mark (CTM).

In the same year, the Defendant registered the domain name wishboneash.co.uk and established a related website. He subsequently formed the band Martin Turner's Wishbone Ash.

Claim and counterclaim

The Claimant issued proceedings claiming infringement of the CTM pursuant to Articles 9(1)(a), (b) and (c) of Council Regulation (EC) No 207/2009 – the CTM Regulation (CTMR) – relating to use of Martin Turner's Wishbone Ash and the domain name wishboneash.co.uk (“the Signs”).

The Defendant denied infringement claiming that:

- 1) The Signs were not identical and the use of MARTIN TURNER dispelled any likelihood of confusion.

- 2) The website contained factual information and was honest descriptive use permitted by Article 12(b) CTMR.
- 3) There was no detriment to the distinctive character of the CTM.
- 4) The CTM should be revoked on grounds of bad faith under Article 52(1)(b) CTMR. The Claimant was dishonest or fell short of the standards of acceptable commercial behaviour when he filed the CTM in his sole name without any reasonable belief that he was entitled to do so.

The Defendant also claimed a share in the goodwill in the Wishbone Ash name.

Decision

It was held the CTM was valid and infringement had occurred under Articles 9(1)(b) and (c) CTMR.

Regarding bad faith, when the CTM was filed, the Claimant was the only party using Wishbone Ash. The remaining original members did not appear interested in performing under the name nor had they sought to prevent the Claimant's use. The CTM was therefore valid.

As to goodwill, in 1998 the Claimant was the sole owner of the goodwill in the name. This was not simply because he was the “last man standing”, but

Although the Signs were not identical, they were similar and were for identical services... therefore, the qualifier had little or no meaning and did not prevent the likelihood of confusion

because all other contenders for ownership had acquiesced to the Claimant's exclusive use.

In assessing infringement, although the Signs were not identical, they were similar and were for identical services. The average consumer did not have knowledge of the Wishbone Ash band or its changing line-ups. Therefore, the qualifier “Martin Turner's” had little or no meaning and did not prevent the likelihood of confusion. The CTM had a reputation and the Defendant's competing use would cause detriment without due cause.

This is a salutary tale for music bands. Although legal agreements might seem the antithesis of artistic collaborations, if those relationships sour, an agreement clarifying the position could save expense and uncertainty in the long run.
Walker Morris acted for the Claimant

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The “Paella approach” to distinctiveness was not palatable, writes Laura Mackenzie

The Court of Appeal dismissed Mattel’s appeal against the High Court’s decision that its tile mark was invalid for non-compliance with Article 2 of the European Trade Marks Directive 2008/95/EC of 22 October 2008 (the Directive). This case is a reminder of the importance of exercising caution in drafting a mark description or limitation on a UK or Community Trade Mark (CTM) application form.

Background

This was a conjoined appeal against two separate judgments; the other being the Court of Appeal reversal of previous decisions to cancel Cadbury’s UK registration for the colour purple (Société des Produits Nestlé SA v Cadbury UK Limited [2013] EWCA Civ 1174). Both judgments applied the Sieckmann criteria (case C-273/00) of what amounts to a sign

capable of graphical representation so as to be registrable: namely that the representation of the sign must have the required clarity, precision, self-containment, durability and objectivity for both the registrar and competitors to know what is covered.

This case relates to a challenge to the validity of Mattel’s SCRABBLE trade mark (“Tile Mark”) – registration no 2154349 for goods and services in classes 9 (computer game adaptations of board games), 28 (board games) and 41 (organisation of competitions and exhibitions, all relating to board games).

Mattel originally claimed against Zynga Inc (“Zynga”) for infringement of the Tile Mark in its SCRABBLE WITH FRIENDS game. In response, Zynga counterclaimed for revocation of the Tile Mark and on 26 October 2012 applied for summary judgment on this counterclaim, which was

granted on 28 November 2012 by Mr Justice Arnold, who declared the Tile Mark invalid for non-compliance with Article 2. Mattel appealed, bringing us to the present decision.

Arguments on appeal

Mattel argued that Arnold J had been wrong to decide summarily that the distinctiveness of the Tile Mark (which Mattel had intended to prove at trial) was irrelevant in determining whether the first two conditions of Article 2 were satisfied: the requirement of a “sign” and requirement that the sign is capable of “graphic representation” (the third condition being that the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings, as in *Dyson v Registrar of Trade Marks* [2007] ECR I-687).

Zynga argued that the Tile Mark did not meet these requirements as the



registration sought to extend the monopoly of the mark, much like a patent, across a large variety of representations – effectively the concept of an ivory-coloured three-dimensional tile of indeterminate size with a letter and a numeral somewhere on its upper face. Mattel already has three-dimensional trade marks for game tiles used in SCRABBLE. Zynga provided examples of the ways in which the Tile Mark description might be employed across a wide range of permutations, some of which would clearly overlap with third-party marks or be non-distinctive (see illustration, below left).

A key focus of the appeal for Mattel was the summary nature of the judgment; it argued that the case should be allowed to go to trial in the usual way to determine the relevance of distinctiveness in the assessment of Article 2.

It also argued that the degree of precision required for registration of a trade mark depends on the mark itself and its distinctive character, and that for any mark there is a degree of permissible variation in its graphical representation. Therefore, it is impossible to determine the appropriate degree of precision without reference to the mark's distinctive character.

Further, Mattel argued that the three requirements of Article 2 are interrelated and cannot be viewed independently of one another; so to determine the sign you must first know what its distinctive character is. Zynga, however, argued that the previous case law rejected this so-called “paella approach” to Article 2; thus, the first two conditions must be decided separately, in stages and in that order, prior to assessing distinctiveness. Sir John Mummery agreed.

Mattel sought to distinguish Dyson, which, it argued, did not go as far as deciding that any mark that is capable of being represented in a variety of different forms is uncertain and not a sign. Dyson was described as a case in which the graphical representation did not capture the entirety of what was claimed in the subject matter of

Zynga argued that this case was more extreme than Dyson, as the representation of the Tile Mark gave no example of how the letter and the numeral are presented

the application (only examples were represented that did not capture the class); whereas in this case, Mattel argued, the Tile Mark representation did not cover anything outside the scope of the graphic representation, which captured the class completely. Zynga, however, argued that this case was more extreme than Dyson, as the representation of the Tile Mark gave no example of how the letter and the numeral are presented.

Mattel gave the example of a word mark, where the distinctiveness resides in the sequence of letters forming the word that is recognised, but that can theoretically be represented in an infinite number of ways (ie as to typeface, size, colour, layout and combinations of each). Zynga, however, observed that a word mark on the register is a single sign that is precise, intelligible and self-contained, as opposed to an instance of class, because it is distinctive on its own whatever

the representation of it. This submission was supported by reference to the provisions of section 41 of the Trade Marks Act 1994, governing the representation of a “series of trade marks” that resemble one another as to material particulars and differ only as to matters of non-distinctive character not substantially affecting the identity of the trade mark. Registrations of up to six marks may be made in that way, each being a separate registration. Here, however, registration of a series could not be made because of the different letters and numbers involved.

Decision

The appeal was dismissed; the Court of Appeal rejected Mattel's criticism that Arnold J had misapplied the law stated by him to the facts found by him.

It reiterated that the Tile Mark was not a single “sign” as required by Article 2 and potentially covers many signs achieved by numerous permutations of the subject matter of the registrations.

Further, there was no graphic representation of a sign as required by the second condition of Article 2 that met the requirements of clarity, precision and objectivity.

Comment

In light of this decision, and the concurrent decision in the “Cadbury purple” case, applicants should be particularly cautious in drafting their mark description or limitation on a UK trade mark or CTM application form, as this will be used in defining the scope of an applicant's mark as graphically represented, whether you intended it to be given this emphasis or not.

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THE CONTESTED MARKS:

The Erol mark



The Lonsdale marks

"554 Mark"



"127 Mark"



"935 Mark"



Look-a-like lesson

Nick Boydell takes note of a case that will interest those representing famous faces



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Justice Norris recently allowed an appeal by Lonsdale Sports Limited ("Lonsdale") against the Hearing Officer's decision to reject its opposition against Mr Erol's trade mark application on the basis of section 5(3) Trade Marks Act 1994 (TMA).

Background

Erol filed a UK trade mark application for registration of a mark for articles of clothing and related items in class 25 (the "Mark").

The Mark was opposed by Lonsdale under section 5(2)(b) TMA and section 5(3) TMA on the basis of various marks, all registered for goods in class 25: the 554 Mark, the 127 Mark and the 935 Mark.

On 27 February 2013, the Hearing Officer rejected the opposition. In reaching her decision, the Hearing Officer selected two of the marks on which Lonsdale had based its opposition, which in her view represented Lonsdale's strongest case, being the 554 Mark and the 127 Mark.

The Hearing Office found that there had been no genuine use of the 554 Mark on the basis that it had only been used in conjunction with the word Lonsdale and not "as and of itself". With regard to Lonsdale's opposition under section 5(2)(b) TMA, the Hearing Officer found that there was a degree of visual similarity between the Mark and the 127 Mark. However, the differences between the marks outweighed any similarities and there was no likelihood of confusion between them.

With regard to Lonsdale's opposition under section 5(3) TMA, the Hearing Officer found that it was unclear what advantage Erol would gain from his registration; and that there was no reason why the capacity for Lonsdale's registered marks to distinguish Lonsdale's goods would be diminished by the Mark.

High Court appeal

Lonsdale appealed the decision of the Hearing Officer, including on the following basis:

- The Hearing Officer erred in selecting only the 554 Mark and the 127 Mark for consideration, and should have considered the 935 Mark; and Lonsdale was unable to address the tribunal on the marks selected.
- The Hearing Officer was wrong to find that there had been no genuine use of the 554 Mark on the basis that it had not been used "as and of itself".
- The Hearing Officer erred in finding that the word "London" was the dominant element of the Mark, since that element was not distinctive.
- The Hearing Officer was wrong to conclude that there had been no unfair advantage gained by Erol, and had not given any grounds for this decision.

Findings of Norris J

Norris J agreed with Lonsdale that the 935 Mark should have been among the best case selection of marks to take into account when assessing Lonsdale's opposition. This was in particular because it contained the word "London", which is the dominant feature of the Mark. However, Norris J found that this did not affect the outcome with regard to likelihood of confusion. Norris J stated that since consumers know Lonsdale clothing because it distinctively bears the word "Lonsdale", they are not likely to be confused as to the origin of an item of clothing that bears the word "London". The text may at first glance appear to be similar to something on a Lonsdale product, but, when making the purchasing decision, the average consumer will be under no illusion that the product is from Lonsdale. Instead they will think that it is look-a-like branding.

The 554 Mark represented an elongated "L". Norris J agreed with Lonsdale that the Hearing Officer had erred in law in finding that there was no genuine use of the 554 Mark on the basis that there was no use "as and of itself". Norris J considered the

judgments of the Court of Justice of the European Union in *Nestlé v Mars* [2005] ETMR 96 and in *Colloseum Holding AG* [2013] ETMR 34. The authorities held that the criteria for finding use giving rise to acquired distinctiveness prior to registration is the same as the criteria for finding use when assessing whether a mark has been genuinely used following registration. Since a distinctive character can be acquired both from use as part of or a component of a registered mark, and from the use of a separate mark in conjunction with

In relation to section 5(3) TMA, Norris J held that, taking the factors in *Intel Corporation* [2009] RPC 15 into account, a link existed between the Mark and Lonsdale's marks. Furthermore, Erol had advanced no case of due cause. Norris J agreed with Lonsdale's submission that it was plain from the face of the Mark itself that there was a clear intention to ride on the coattails of Lonsdale's reputation. In addition, Norris J held that putting into circulation products that do not proclaim distinctiveness, but rather affinity with the Lonsdale

Norris J held that putting into circulation products that do not proclaim distinctiveness, but rather affinity with the Lonsdale brand, would dilute that brand

another registered, it was incorrect to prevent Lonsdale from relying on the 554 Mark on the basis that it had been used "as and of itself". However, for use to be genuine use, it must still be perceived as being indicative of origin. Norris J found no evidence of any particular distinctiveness attached to the 554 Mark, and in particular no evidence that consumers would perceive Lonsdale as associated with products simply because of use of the elongated "L". Therefore, although the Hearing Officer had erred, this did not affect the actual outcome.

With regard to the comparison of signs, Lonsdale submitted that the Hearing Officer erred in finding that "London" was the dominant element of the Mark, since it was accepted by the Hearing Officer that this element was not distinctive. However, Norris J rejected this argument, and accepted Erol's contention that "London" can be dominant whether or not it is distinctive.

brand, would undoubtedly dilute that brand.

Norris J therefore allowed Lonsdale's appeal under section 5(3) TMA.

Demonstration

The case is an interesting demonstration of the court's approach to look-a-like products that will be particularly useful for those representing famous brands. While the courts may be unwilling to find a likelihood of confusion between a famous brand's marks and look-a-like products, an opposition or infringement action may succeed under section 5(3) TMA. In addition, it is a reminder that genuine use can be shown of a mark even where it is used as component of another registered mark; and that, where an element of a trade mark is not distinctive in a trade mark sense, this does not mean that it cannot be the dominant component of a trade mark when performing the assessment of likelihood of confusion.

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M&E marks its territory

Chris Hawkes reviews recent DRS decisions that show how rights owners are taking on the common threat of cybersquatters

This article briefly summarises four Dispute Resolution Service (DRS) complaints with full decisions: three successful, one unsuccessful. All were brought by brand owners in the media and entertainment (“M&E”) sector. This article demonstrates ways in which M&E brands may be targeted, and how the DRS can be used to counter any attempts by cybersquatters to capitalise on the value in M&E brands.

In summary, the DRS policy requires a complainant to show on the balance of probabilities that: a) it has rights in respect of a name or mark that is identical or similar to the domain name; and b) the domain name, in the hands of the respondent, is an abusive registration.

Delay point dismissed

Palm Green Capital Limited v GEECOM concerned the domain names hmv-go-online.co.uk and hmv-shop.co.uk. These were registered by the Respondent on 15 January 2013, the same date on which the much-loved retailer HMV entered into administration.

Palm Green Capital Limited, which later acquired the HMV chain, rightly sought to take action against the opportunistic registration of the domains by the Respondent. With a well-pleaded case on its registered and unregistered rights, and with good submissions and evidence provided to the Expert on how the domains amounted to abusive registrations, the Complainant was successful – neither the Respondent’s use of generic terms alongside the HMV brand, nor its weak submissions saved it.

One interesting point the Respondent did raise, however, was the Complainant’s delay in bringing the DRS. Although this point was dismissed by the Expert, a brief but useful discussion on how the equitable doctrine of laches (unreasonable delay) may apply in a DRS complaint was provided by the Expert at the end of para 6 (citing DRS 8634, Emirates v Toth).

Sport success

World Wrestling Entertainment, Inc v Oversee Domain Management concerned the domain name wweshop.co.uk.

WWE is the acronym of the world’s leading wrestling brand – World Wrestling Entertainment – which is publicly traded on the New York Stock Exchange and enjoys an impressive market capitalisation of around \$768 million.

The Respondent in this case is (of its own admission) in the business of mass registration of domain names – it owns approximately 397,000 domains. Although it claimed in its response that it does not target brands, it is interesting to note at the time of writing that the Respondent is registrant of 4Musiic.com (reminiscent of Channel 4’s brand 4Music), and ItaloBrothers.net (ItaloBrothers being a famous German Dance music duo).

The Complainant based its complaint on rights it owns (trade marks, company name, trade name and domain names) in WWE, in particular its WWE and WWESHOP trade marks, and its ownership of wweshop.com. These rights were accepted by the Expert.

The Complainant stated the domain registration was abusive, *inter alia* for its corresponding website’s use of a “parking site” (a place-holder page that may contain ads) and pay-per-click site, and for its unauthorised and misleading content.

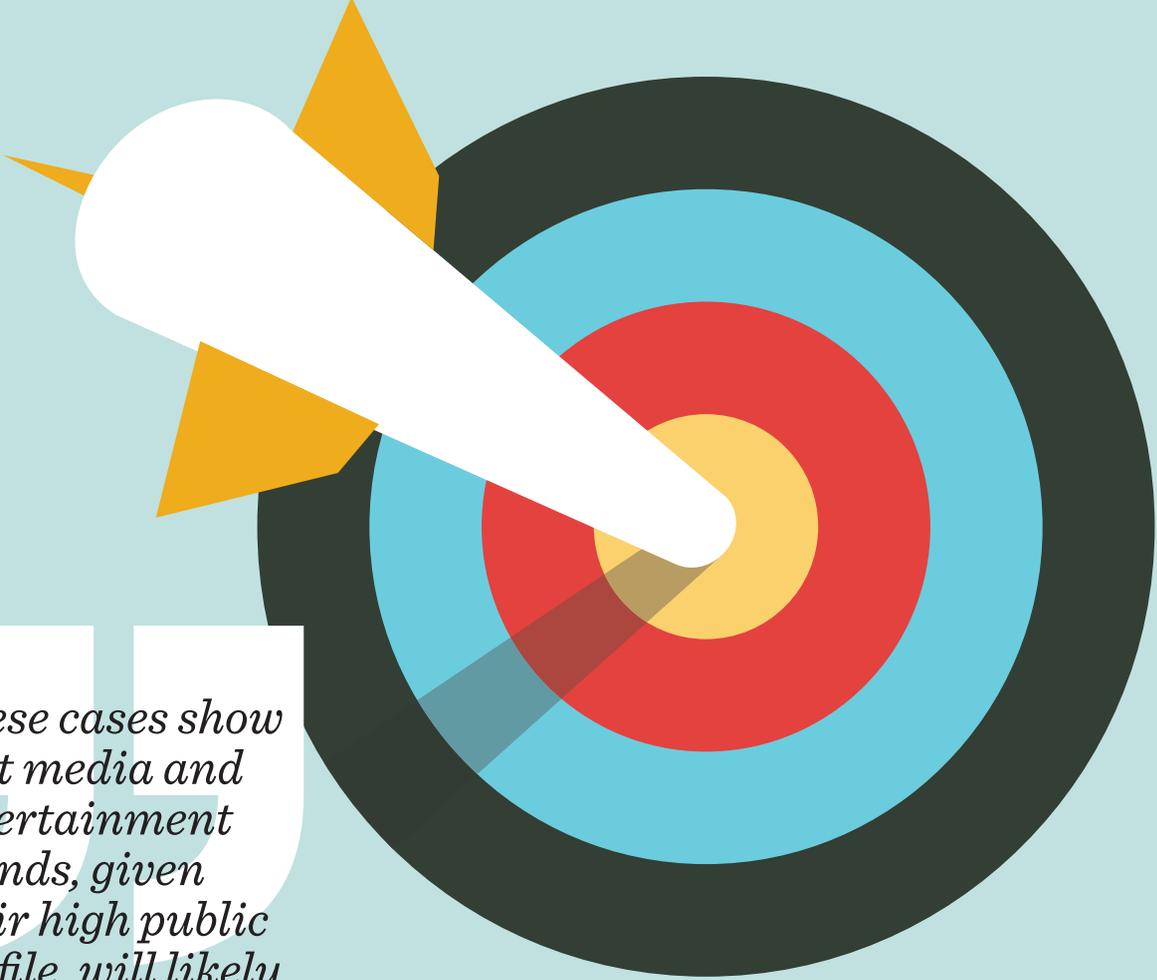
Ultimately the Complainant was successful. Citing DRS 3027 (epson-inkjet-cartidge.co.uk) and DRS 248 (seiko-shop.co.uk), the Expert found that the Respondent’s registration caused initial interest confusion, and made false representations sufficient to satisfy the abusive registration criteria under section 3a of the DRS policy.

The Complainant made very clear and concise submissions on both limbs of the DRS test and in particular on how the Respondent’s registration amounted to being abusive. This was reflected in the Expert’s clear decision.

Beaten by BT

British Telecommunications (BT) plc v Mr Qureshi concerned several domain names: btvision.co.uk, btsporthd.co.uk, btvhd.co.uk and btvisionhd.co.uk

BT, possibly one of the most famous brands in the UK, is no stranger to domain name proceedings, being involved in the “One In a Million” case (British Telecommunications plc and others v One In A Million Limited and others [1998] EWCA Civ 1272, 23 July 1998). BT VISION and BT SPORT are offerings that have been well publicised by BT from around 2006, and are now incorporated under the umbrella brand BT TV, which launched in May 2013. The Respondent registered three of the domain names four days after the launch of BT TV.



These cases show that media and entertainment brands, given their high public profile, will likely be exposed to cybersquatting

Despite the Respondent's somewhat entertaining claims that BT was an acronym of "BIG TIME" and that HD stood for "HOLIDAY DESTINATION", the Respondent's response failed, as would be expected on the facts of the case – it was otherwise too great a coincidence for the registrations to be legitimate given the Complainant's reputation.

Evidence issue

Safepay Malta Limited v Charity King concerns the domain name *betsafe.co.uk*. Again, this decision highlights how big names in the M&E sector can be easy targets.

On this occasion, with the Complainant owning registered trade mark rights in Community Trade Mark (CTM) "betsafe" in class 35, "betsafe.com" (CTM in classes 9, 28, 35, 38, 41) and BETSAFE (CTM in classes 9, 41 and 42), the first limb of the DRS test could not perhaps, at first thought, be more suitably satisfied.

However, this case highlights the need to provide DRS Experts with all pertinent information and evidence at the outset of DRS proceedings. On this occasion, asserting trade mark rights alone was insufficient, thus, contrary to expectation, the decision went in favour of the Respondent, notwithstanding the strong Registered rights position.

The Complaint failed because the Complainant did not furnish the Expert with evidence on both limbs of the test, and particularly as evidence was necessary, given the domain registration predated the earliest of the Complainant's asserted Registered CTMs.

The Expert gave useful guidance on what can and cannot form part of an Expert's DRS decision at paragraphs 6.4 to 6.6.

Exposed position

These cases show that M&E brands, given their high public profile, will likely be exposed to cybersquatting when going through any transition or transaction, or when launching a new brand or sub-brand.

Therefore, any company considering a change or addition to its brand(s) should ensure its brands are protected and have all necessary checks in place to alert it to – and the tools with which to counter – any attempts by third parties to take advantage of them.

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Air pair

Arguments didn't fly for two major UK airports, explains Patricia Collis

In a case involving trade mark applications for the names of two UK airports, Professor Ruth Annand, sitting as the Appointed Person, reminds us that the state of the Register is largely irrelevant when considering the registrability of new applications, and that the UK IPO's practice guidance is just that – guidance – rather than legal rule.

In February 2011, Cardiff International Airport Limited filed a trade mark application for the mark CARDIFF AIRPORT, covering a range of services in classes 35, 36, 37, 38, 39, 42, 43, and 45. On the same day, Belfast International Airport Limited filed an application for the mark BELFAST INTERNATIONAL AIRPORT, covering the same services.

While both marks were deemed registrable in relation to the majority of the services covered, objections were raised under section 3(1)(b) and section 3(1)(c) of the Trade Marks Act 1994 as regards various transport and travel-related services in class 39, including taxi services and car parking services. The objection, which was upheld by the Hearing Officer at first instance, was essentially that the marks are both descriptive (and thus also non-distinctive) in relation to such services, as they are likely to be seen as merely an indication of the geographical origin or destination of the services.

The main grounds of appeal put forward by the Applicants were that there had been a breach of the principle of equal treatment, as other

airport marks had been accepted for the services in question, and that the Registrar's Practice Guidelines, which had been followed by the Hearing Officer, drew an arbitrary distinction between certain class 39 services that were acceptable and others that were not acceptable for marks consisting of airport names.

As regards equal treatment, the Appointed Person considered the examples raised of airport marks that had been accepted for the services in question. She commented that, for three of these marks, the inclusion of additional matter meant that different distinctiveness considerations applied, and, for the fourth, the timing of the application meant that it may have been examined before the introduction of the current practice. In dismissing this ground of appeal, she pointed out that the Hearing Officer had examined each of the marks applied for on its own merits, and had considered the equal treatment point. This approach did not contain any legal error.

Considering the practice as regards airport names, the Appointed Person concluded that, whether the line drawn in the practice guidance was

arbitrary or not, it did not ultimately affect the issue of whether the marks are actually registrable in relation to the services in question. This ground was therefore also dismissed.

Comment

One of the reasons the Applicants had sought protection for the services in question was to prevent consumer confusion between official and unofficial services, such as car parks serving the airports. While this is an understandable consideration, it is questionable whether obtaining registrations for the word marks would have made it easier to pursue this aim. There will always be "unofficial" parties who offer services to transport consumers to and from airports, and who operate car parks serving airports. Registrations for the word marks would not have prevented such parties from referring to the airport names descriptively in offering their services. Official logos for the airports, which are well marketed to consumers and registered as trade marks, are likely to achieve this commercial aim much more easily, and are less likely to encounter registrability objections in relation to the services in question.

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events

More details can be found at itma.org.uk

Date	Event	Location	CPD hours
18 February	ITMA London Evening Meeting Modern Mediation Methods in IP Disputes by Michael Cover, Michael Cover ADR Ltd and Jon Lang, Jon Lang Mediation	Royal College of Surgeons, London	1
19 March	ITMA Drinks Reception**	London TBC	
19-21 March	ITMA Spring Conference**	Church House Conference Centre, Westminster, London	
20 March	ITMA Gala Dinner**	One Great George Street, London	
29 April	ITMA London Evening Meeting	Royal College of Surgeons, London	1
10-14 May	INTA 136th Annual Meeting	Hong Kong	
20 May	ITMA London Evening Meeting	Royal College of Surgeons, London	1
24 June	ITMA London Evening Meeting	Royal College of Surgeons, London	1
19 July	Intellectual Property Trainees' Ball	TBC	
22 July	ITMA London Evening Meeting	Royal College of Surgeons, London	1
23 September	ITMA London Evening Meeting	Royal College of Surgeons, London	1
23-26 September	Marques Annual Conference	Copenhagen	
25 September	ITMA Autumn Seminar*	Hyatt Regency, Birmingham	
28 October	ITMA London Evening Meeting	Royal College of Surgeons, London	1
18 November	ITMA London Evening Meeting	Royal College of Surgeons, London	1



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Media Watch

Deep winter is cheered up by Ken Storey's latest news review

ILLUSTRATION BY PHILLIP COUZENS

The holiday season was a relatively quiet period for news stories concerning trade marks. However, as a reminder of the winter break, I picked out a festive tale to begin this report.

Many of you will be aware of the saying, "A dog is for life, not just for Christmas." The Dogs Trust, which came up with the phrase 35 years ago, celebrated the occasion by including the following on its website:

"Our famous slogan was created by Clarissa Baldwin, Chief Executive, in 1978 but is still as relevant today. The longstanding campaign aims to raise awareness of the consequences of treating dogs as gifts or toys. Every year hundreds of thousands of children plead for the latest fad or top toy on the market, only to discard them a few weeks after Christmas when the novelty wears off. Unfortunately, the same perception is also apparent with dogs. We are continually seeking to change this."

Unlike many trade mark owners, the charity takes it as a compliment that the slogan has been copied so many times. Baldwin, who was head of PR when she came up with the slogan, said: "It's simple, memorable and easily customisable – not something I thought about initially, but I think that helps it stick in people's minds." I particularly enjoyed some of the slogans built around the Dogs Trust slogan, such as "Sprouts are for life..." from Sprouts Bite Back, "A goat is for life..." from FARM Africa and one

from Ann Summers, which has me baffled – "A rabbit is for life..." Each to their own!

Staying with the festivities and the giving of presents, one story that attracted quite a bit of coverage was the dispute between a company called Zynga and Mattel, which owns the SCRABBLE trade mark. Mattel went to the High Court claiming that Zynga's SCRAMBLE WITH FRIENDS infringes its SCRABBLE trade mark. Mr Justice Peter Smith ruled that there was no confusion between the two names, but considered that there was a likelihood of confusion between the logos. He ruled that the curly letter M in the Zynga logo "gives the impression that the word is Scrabble when one looks at it quickly..." This means that

Zynga will have to change the game's logo, but not the name itself. Manchesterwire.co.uk was unable to get any comment from Zynga, but a spokesperson for Mattel expressed disappointment against the ruling and said it intended to appeal.

Logos also featured in another story that attracted the attention of the *Mail on Sunday*: Hells Angels' US trade marks for the death head winged-skull logo and patch. Hells Angels has taken action against rapper Young Jeezy's 8732 Apparel line and the department store Dillard's, which is making and selling hats, shirts and vests that are "confusingly similar" to the death head symbols. Let's hope the matter is settled in the courtroom rather than on the streets.

I know who I would back – probably in either setting.

And so to a more cuddly story. But, sadly, this one comes with a twist in the tail. The *Solicitors Journal* reported on a Court of Justice of the European Union ruling that resulted in a victory for Berlin Zoo, which had objected to a Community Trade Mark (CTM) application from Knut IP Management for a trade mark "Knut-der Eisbär". Berlin Zoo objected on the grounds that it was too similar to the name "Knut", which it had registered as a CTM for goods including books, games, toys and dolls, following the birth in captivity of a polar bear in 2006. There had been much publicity following the birth and subsequent abandonment of the bear by its mother and the fact that it was being hand-reared by keepers. The *Solicitors Journal* set out the detail of the judgment but omitted to mention the fact that Knut the bear died in 2011.

Finally, the UK IPO recently launched its new toolkit, IP Equip, which is intended to help businesses identify assets that could be protected by IP rights. ITMA President Catherine Wolfe was quoted alongside Lord Younger in *EN For Business*, saying that: "By focusing on the commercial value of IP, these tools make it clear that it pays to get expert help at an early stage. Having an effective IP strategy can be crucially important to business." An apt message with which to sign off this media report.



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