

CITMA REVIEW

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PRESIDENT'S WELCOME

WE MUST ALL STAND TOGETHER

This year has been a challenging and eye-opening time for our profession. It has forced many of us to work in new ways and kept us apart from friends and family. But it has also allowed us to reflect and look at the world from a different perspective.

In this chapter of our history, it is imperative that CITMA moves with the times and provides the necessary support to our members and the wider intellectual property community.

We continue to host virtual coffee mornings to ensure members have the chance to connect with the profession and with us. We also continue to publish resources and relevant news on our Coronavirus hub to support you during these difficult times.

The death of George Floyd and many of the subsequent scenes we have witnessed have been distressing for us all. It is all too easy to deny that this is an issue for the trade mark profession. Likewise, it is easy to condemn the situation in the US, but it is much harder to look inwards and acknowledge our own problems.

We must use this time to reflect, stand together as one community and show solidarity with our black and minority ethnic members and staff by making a stand against racism and discrimination in all its forms.

We are proud of the work that we and initiatives like IP Inclusive do to support diversity and inclusion. However, there is far more for us to do together to enhance and celebrate diversity in the IP community.

We are starting with how we can tackle various conscious and unconscious biases, in order to let people know that, no matter their background, a career in IP could be for them.

After all, a more diverse IP community is a better IP community.

Richard Goddard, CITMA President



Top filers revisited

As we have reported on our website, the table of EUTM applications filed by UK firms, as published in the May issue of the *CITMA Review*, has been confirmed to be incorrect by Corsearch.

Responding to enquiries from members, which were then relayed by the *CITMA Review* team, Corsearch has provided the following apology: "Corsearch sincerely apologises for providing the incorrect data. The EUTM data we provided was mistakenly extracted from an internal test

application, which included duplicative information."

Corsearch has now reviewed the data, and we are happy to be able to provide a revised top 10 of EUTM filers.

The original ranking and this corrected top 10 include only those firms that used a UK address when filing EUTM applications in 2019. Many UK firms are now filing EUTM applications through other offices in EU Member States and were doing so in 2019. It has not been possible to include filings by those firms in the updated list.

OUR WEBSITE JUST GOT BETTER

Booking CITMA events and updating your details online are now easier to do. We have also enhanced the Find a Chartered Trade Mark Attorney directory. Take a look at citma.org.uk



We will be reviewing which data is most relevant for future reporting, bearing

in mind changing patterns of filing following the UK's departure from the EU.

Top 10 EU Trade Mark Filers 2019*

HGF	453
LANE IP	401
STOBBS IP	396
MARKS & CLERK	393
COOLEY (UK)	252
BAKER MCKENZIE	241
MURGITROYD	232
MEWBURN ELLIS	231
WITHERS & ROGERS	200
HASELTINE LAKE KEMPNER	190

**For specific data collection criteria, please see the May issue of the CITMA Review.*



OUR AUTUMN CONFERENCE RETURNS (VIRTUALLY!)

Interactive, informative and innovative are three words we're using to describe this year's Autumn Conference, taking place on 15th-16th October.

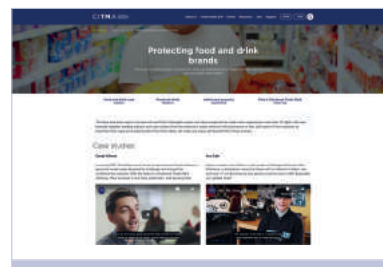
We're bringing you a brand new way of virtually interacting and attending our annual conference. We won't be relying on Zoom or a series of webinars, but instead using an entirely new platform.

You will hear more from us about the conference over the coming weeks, so check our website for more details.

PROMOTING CHARTERED TRADE MARK ATTORNEYS

We have been reaching out to businesses in the food and drink sector about the importance of trade marks and the value of Chartered Trade Mark Attorneys. Thousands of new people have already visited our website.

See the campaign's landing page for yourself at citma.org.uk/tm2020



DEMAND FOR EUTMs GROWS

The EUIPO recorded a 5.2 per cent rise in trade mark filings in 2019 compared with 2018, according to the organisation's latest annual report. A total of 160,377 EUTMs were filed during the 2019 calendar year.

The EUIPO also received its two millionth trade mark application in June 2019.



OUR INDUSTRY FACES DOUBLE TROUBLE

As we emerge from lockdown, Lord Smith highlights a looming challenge

We are living through very strange times. COVID-19 and the accompanying lockdown have totally changed the way we all work and the shape of economic and social activity everywhere. For the IPReg staff, it has meant working from home, with board meetings and discussions taking place online, but with a formidable quantity of work still to do. I can't help thinking how fortunate we are to have put our new CRM system in place last year, which has meant that we have been able to cope well with the shift to a digital working environment.

As I write this, it's difficult to assess the broader impact of COVID-19 on the business of intellectual property protection. There's still a lot of work on patents and trade marks going on, much of which was started before lockdown. But will the economic hiatus that has hit the country mean a subsequent dip in IP activity? I suspect that there may be a bit of an impact, but what's much more important is the realisation that IP will be crucial to any economic recovery that we're going to have. As we all try to lift the UK economy out of a COVID-19-induced recession, it's IP that's going to lead the way, especially as we come to terms with a world unlike the one we were all used to. And you can't have cutting-

“
IP will be crucial to any economic recovery that we're going to have

edge IP work without recognising the importance of trade mark protection.

There is, however, an additional lurking problem that we will have to face, and that (I'm afraid) is the prospect of Brexit happening for real at the end of December. At the moment, we are in a semi-Brexit state: we have left the EU, but we still have transitional arrangements in place which mean that very little has actually changed. That may all come to a juddering halt on 31st December. And while Patent Attorneys have a degree of protection (although there will be impacts), it will be Trade Mark Attorneys who will be especially

affected. At the moment, there is a fundamental unfairness built into the negotiations that the UK Government is conducting. It seems to be conceding that EU-based attorneys should have rights of trade mark representation before the UK IPO, but UK-based attorneys should not have a reciprocal right before the EUIPO. This surely can't be right. It should either be the case that both have reciprocal rights of representation or that neither do. I hope that CITMA's campaign for more even-handedness in this will bear some fruit. It will be especially important for smaller-scale Trade Mark Attorney practitioners.

It's at times of challenge and difficulty that IP really comes into its own. And heaven knows we are in the midst of real challenge and difficulty on more than one front right now. It behoves all of us – practitioners, regulators, representatives and advocates – to make sure we come through this intact. IPReg will certainly be playing its part.



The Rt Hon the Lord Smith of Finsbury
Chair of IPReg



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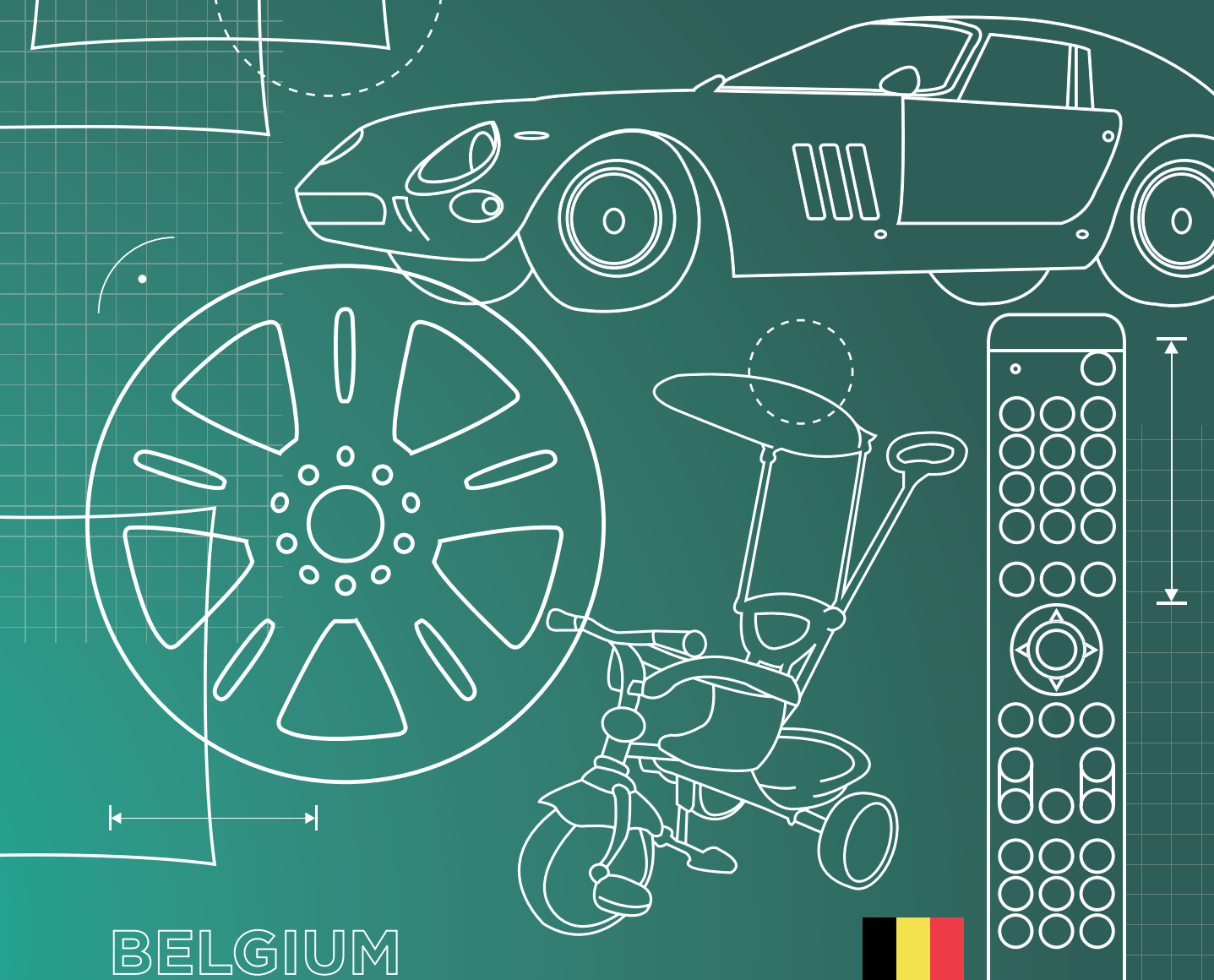
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BELGIUM



AVOID THE PITFALLS OF SUCCESSIVE REGISTRATIONS

In its judgment of 30th August 2019, the Brussels Court of Appeal considered that Telenet and its supplier Universal Electronics did not infringe the registered Community designs (RCDs) asserted by FM Marketing (FM) and Ruwido Austria.

FM, the owner of a series of consecutive designs (shown right), brought an infringement action in Belgium against Telenet's remote control (also shown right).

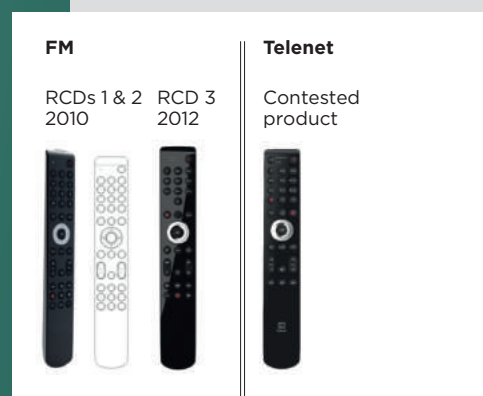
However, Telenet and its supplier Universal Electronics managed to escape a finding of infringement by "squeezing" the scope of protection of the asserted designs against each other.

First, the Court held that since RCD 3 had not been challenged, it could be assumed to be valid and must therefore convey a different

overall impression than the design corpus, including FM's own earlier RCDs, 1 and 2. Later, this finding on the overall impression of the respective RCDs would help to determine the Court's assessment of whether the contested product infringed the asserted RCDs.

Indeed, the Court concluded that since the contested product differed even more from RCDs 1 and 2 than RCDs 1 and 2 differed from RCD 3, the contested product must therefore convey a different overall impression than RCDs 1 and 2. As a result, the Court held that the contested product fell outside the scope of protection of RCDs 1 and 2. Applying similar reasoning based on a comparison between FM's respective RCDs, the Court ruled that the contested product did not infringe RCD 3.

This judgment is important because it illustrates some of the



pitfalls of registering designs that differ from earlier designs in a seemingly minor way. Although the Court's motivation may be subject to critique, designers ought to be wary about the additional arguments that third parties may seek to derive from their own design filing strategy. ▶



BELGIUM

The Smart Trike RCD



The contested FUN product



A BUMPY RIDE FOR FUN

In a case between Smart Trike MNF PTE (Smart Trike) and FUN Belgium (FUN), the Brussels Court of Appeal confirmed on 17th December 2019 that FUN had infringed Smart Trike's RCD No. 788666-0001 for tricycles.

In reaching that conclusion, the Court rejected FUN's argument that the similarities between the RCD and the contested product were dictated by the function and purpose of the tricycle and that these features should not be taken into account when determining the overall impression of the RCD.

Applying the CJEU's teaching in DOCERAM, the Court found that

the features of the RCD were not exclusively dictated by any technical function. Taking into account that Smart Trike had secured design awards and demonstrated the existence of alternative designs for the same product that did convey a different overall impression, the Court concluded that technical functionality cannot have been the only factor determining the design at issue. Rather, it found that "considerations of a visual nature have played a part in the design of the RCD" and that Smart Trike "sought a balance between design, functionality and safety".

Despite FUN's argument that the contested product showed over a

dozen differences from the RCD, and even though it appeared that Smart Trike had been unsuccessful in earlier legal proceedings before courts in France and Germany, the Brussels Court concluded that FUN had infringed Smart Trike's RCD.

Instrumental in reaching this conclusion were the Court's findings: (i) that there was a considerable difference between the RCD and the design corpus, such that the RCD conveyed a strong individual character, and; (ii) that the disputed product shared six out of the seven features which, according to the Court's findings, distinguished the RCD from that design corpus.

As a result, the Court held that small differences do not prevent the contested product and the RCD conveying a similar overall impression and confirmed the lower court's finding that the contested product infringed the RCD.

Reports by Domien Op de Beeck and Alizée Jolie

DENMARK

FLOWER ESCAPES SCOT-FREE

The issue in case BS-10241/2017-SHR, brought on 13th October 2017 at the Maritime and Commercial Court, was whether the baby play mats named "Piece of Heaven" and "Soft Shell" and marketed by Mette Neerup Mariager (trading as That's Mine) are protected as Community designs, and if so, whether Anne-Lise Jensen (trading as KidKii) and Mateusz Skiba (trading as Misioo) infringed the Plaintiff's rights under the Community Design Regulation (CDR) and the Danish Marketing Practices

Act by marketing and selling the play mats named "Flower".

After a trial in December 2019, the Court ruled earlier this year that the Plaintiff's play mats "Piece of Heaven" and "Soft Shell" were unregistered Community designs.

However, the Defendants' play mat "Flower" was not found to be so similar as to trigger a violation of either the Plaintiff's design under the CDR or of the Plaintiff's rights under the Danish Marketing Practices Act.

Report by Mogens Dyhr Vestergaard

The "Flower" play mats



FINLAND



DAIMLER DRIVES AHEAD

The Finnish Market Court has ruled in decision MAO:445/19 (14th October 2019) that certain local Finnish defendant companies had infringed Daimler AG's trade mark and design rights.

The Market Court examined both national and EU-level design legislation in its decision. The conclusion was that sales of the rims/wheels mentioned in the claim had infringed Daimler's RCD (No. 691902-0002), as a well-informed user would find the two products practically identical, despite slight differences. Therefore, the infringing wheel and Daimler's RCD would give a similar overall impression, even to the well-informed user.

After concluding that the Finnish Defendants had infringed Daimler's

RCD, the Court assessed the applicability of the so-called spare part exception referred to in Article 110 of the CDR. For the exception to apply, the Defendants must act in accordance with a duty of care. As it could not be shown that the Defendants had necessarily acted in accordance with a duty of care in the sale of the wheels, the exception did not apply. Further, the Court concluded that the Defendants had also infringed six other Daimler RCDs and ordered all infringing products in the Defendants' possession to be destroyed.

The Market Court also addressed national and EU-level trade mark legislation and concluded that the actions of the Defendants had contravened existing national and European trade mark rules.



Daimler AG's RCD
No. 691902-0002



Infringing design

Finally, a number of important procedural questions, such as questions on joint liability and identification, were also dealt with in this definitive decision.

Report by Ella Mikkola

FRANCE

REPAIR CLAUSE GOES BACK TO SQUARE ONE

In a decision rendered on 20th December 2019 (No. 2019-794 DC), the French Constitutional Council declared that the adoption of Article 110 of Statute Law No. 2019-1428 (the *Loi d'Orientation des Mobilités*, or LOM) had not been carried out in a constitutional manner and should therefore be considered unconstitutional.

Article 110 was the most recent attempt to introduce into French law a repair clause aimed at limiting or paralysing both the effects of copyright and the registration of French designs relating to parts for vehicles or trailers where they may be used to repair a complex product and restore its original appearance.

Article 110 provided for a substantial reduction in the protection of spare parts needed to repair a vehicle. In copyright law, it introduced a new exception for such spare parts to prohibit the author from objecting to the reproduction, use and marketing

of their work. In terms of design law, it was foreseen that this would reduce the protection for certain parts in both duration and scope.

The principle of the repair clause is a point on which European Directive No. 98/71 was never able to reach agreement. In order for the Directive to be adopted, transitional provisions were passed with regard to this exception (Article 14).

It is well known that this exception to design law is controversial, particularly within the automobile sector. EU Member States have therefore applied heterogeneous solutions. Until now, the introduction of a repair clause into French law had been discussed on several occasions at a legislative level and in each case rejected.

For the time being, in France, the rights of holders of French national designs relating to vehicle spare parts are not limited by a repair clause, as illustrated by two recent judgments on this subject handed down by the Paris Court of Appeal and the Colmar Court of Appeal on 22nd October 2019 and 18th September 2019 respectively (CA Paris, docket No. 17/18729, Volkswagen AG v Jumasa Parts

SI, Spact SARL and Depo Auto Parts Industrial Co. Ltd; CA Colmar, docket No. 16/04036, Dr. Ing. HCF Porsche AG v Ultragroup SARL and Acacia Srl).

The outcomes would certainly have been different in these cases had the rightholders relied upon Community designs, since the CDR provides for a repair clause under its own Article 110 (as interpreted by the CJEU in joint cases C-397/16 and C-435/16, 20th December 2017).

Article 110 LOM was censured by the French Constitutional Council, considering that the procedure followed to adopt this article, by way of amendment, was contrary to Article 45 of the French Constitution, in that it was not linked to the provisions contained in the bill on mobility.

If the reason for the rejection stemmed from the legislative procedure and not from the substance, the debate could be relaunched on the future of the repair clause in French law. There is nothing to prevent the French Government from proposing the adoption of a new bill.

Report by Benoît Lafourcade and Géraldine Arbant



GERMANY

CJEU TO PONDER FERRARI QUESTION

In a case concerning the V-shaped “front kit” of one of Ferrari’s top car models, the Ferrari FXX-K, the German Federal Court of Justice (30th January 2020, court ref. I ZR 1/19) has referred a question to the CJEU for a preliminary ruling. The question is whether the disclosure of an overall representation of a product under Article 11(1) and (2) of the CDR can give rise to an unregistered Community design right (UCD) in respect of individual component parts of the product.

At the Geneva Motor Show in 2016, a manufacturer of tuning components for Ferrari cars presented a converted Ferrari 488 GTB under the designation “Mansory Siracusa 4XX”, in which a V-shaped add-on front kit was

used. Ferrari was of the opinion that the V-shaped add-on front kit infringed a UCD in its favour. The Higher Regional Court of Düsseldorf (6th December 2018, court ref. I-20 U 124/17) rejected Ferrari’s claim.

That decision by the Higher Regional Court of Düsseldorf was later assigned to the German Federal Court of Justice, which has now referred the case to the CJEU, asking whether part of the body of a vehicle, interpreted as a component part of a complex product, can be granted protection as a UCD, and if so, under what conditions. In particular, the question is whether the component part needs to have a certain degree of “autonomy and unity of form” which, in the perception of the informed user, makes it possible to establish an overall aesthetic impression of it independent of the overall form.

The Ferrari model



Mansory Siracusa 4XX



HUNGARY

TALKIN’ ’BOUT THE CAR WASH

In proceedings related to a car-washing structure, the Metropolitan Appeal Court of Budapest, acting as the second-instance Community design court, confirmed the relevant criteria for intermediary liability for design infringement.

The subject of the case was an international design (shown below) designated in the EU and relating to a multi-stop car-washing structure with a feature that creates a sinking impression. The Court was required to consider whether the locksmithing company that manufactured, assembled and built the structure was directly liable for design infringement under Article 19 of the CDR or whether it is considered an intermediary under Article 11 of the IP Enforcement Directive and the transposing national law.

The Metropolitan Appeal Court confirmed that despite previous Hungarian case law (SZOLÁRIUMCSŐ), a CJEU decision (C-119/10, Frisdranken v Red Bull GmbH) and commentary

on the CDR referred to by the rights holder, manufacturing and building a structure subject to protection does not necessarily result in direct liability.

This decision is notable because the Court adopted an “exploitation-focused” approach to identifying: (i) the infringer/user; and (ii) the person simply providing services that are used by a third party to infringe an IP right. This distinction was also evident in the Red Bull case, where a person who merely creates the technical conditions necessary for third parties to use the product subject to protection (ie, the intermediary) was distinguished from the actual infringer. The circumstances of each case must be assessed to determine whether there is room for such a distinction.

In this case, the Court paid special attention to the fact that:

- the parameters of the structure, the technical plans and the place of

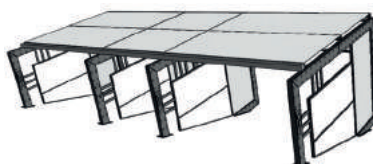
assembly were clearly instructed by a third party;

- the locksmithing company had no influence over or interest in the specific look of the structure;
- the product (ie, the structure) was not mass-produced by the Defendant;
- the product did not enter the distribution and supply chain on the market; and
- the rights of the holder were not principally compromised by the manufacturing and assembly of the structure (but by the actual use of the structure being identical to the design by a third party).

Consequently, the Defendant was not identified as the unlawful user of the design in the sense of Article 19 of the CDR and was not liable for infringement. However, it was prevented from providing services for design infringement as per the Hungarian Design and Patent Acts.

This means that the fact that a manufacturer has no knowledge of the design, no influence over the structure and no interest in the look of the structure does not give them a free pass; additional factors in the case at hand must also be considered. Report by Bettina Kövecses

International registration
No. DM/077 550 (View 1.1)





SLIDE DECISION SORTED?

The Higher Regional Court of Düsseldorf (25th April 2019, court ref. I-20 U 103/18) dealt with a case about a slide sandal, which the Plaintiff had designed together with the well-known singer and businesswoman Rihanna. The shoe was exhibited for the first time at a major fashion show in September 2016. The Plaintiff then filed an application for an RCD for the shoe some seven months later, in April 2017. The Defendant distributed a similar sandal in Germany, so the Plaintiff filed for a preliminary injunction (PI).

As various third parties had disclosed slide sandals with similar distinctive features during the period between the first presentation of the slide sandal in September 2016 and the RCD application in April

2017, the Defendant argued that the Plaintiff's RCD was void. The Higher Regional Court of Düsseldorf upheld the PI and stated not only that the first disclosure of a design falls under Article 7 of the CDR, but that so do any subsequent disclosures too, provided that they are not independent parallel creations.

Article 7(2) is intended to give the designer an opportunity to test their design on the market before applying for an IP right. It would be contrary to this if only the first publication by the designer came

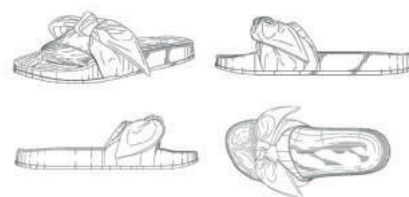
under Article 7(2) but no subsequent third-party disclosures based on it, since these third-party disclosures are then "a result of... action taken by the designer" according to the terms of Article 7(2).

Even so, this decision is broadly advantageous for owners of an RCD. If third-party disclosures only fall under Article 7(3), the owner of the RCD would then have the burden of proof when it came to showing abusive behaviour by a third party.

Reports by Roman Brtka



Slide sandals



ITALY

STORE LAYOUTS GAIN PROTECTED STATUS

The Italian Supreme Court has had the opportunity to confirm whether store layouts are protected under copyright law and to define the scope of that protection.

In 2013, Kiko brought an action against its competitor Wycon Cosmetics, claiming that the latter had infringed its exclusive rights to its store layout, characterised by: an open entrance with two large graphic backlit panels at the side; an interior made up of side stands composed of a sole structure sloping along the walls, self-standing central stands with curved edges and numerous TV screens built into the sloping stands; use of the same combination of colours (black, white and pink/purple); and cold lighting.

The matter referred to the Court was the possibility of protecting Kiko's store layout as an architectural work pursuant to Article 2(5) of Italian Copyright Law. Generally speaking, the Court confirmed that

a work of interior design, in which there is a unitary structure that reveals its own stylistic key or the personal mark of the author can be protected as an architectural work regardless of the requirement of the inseparable incorporation of the furniture elements with the building.

As to this specific case, the Supreme Court judges upheld a decision by the Appeal Court of Milan and confirmed that Kiko's store layout was protectable as the subject of an interior design project consisting of creative choice, co-ordination and organisation of elements within a unitary design and style.

In this regard, the Supreme Court also found it irrelevant that the individual furnishing pieces making up the project were simple or common. On the contrary, the original combination of components by the author, aimed at making the entire environment more functional, was held to be relevant.

Having confirmed that Kiko's store layout was protectable, the Supreme Court confirmed the appropriateness of the Court of Appeal's conclusion

that Wycon's store layout amounted to infringement. Following this decision, there is a good chance of arguing that store layouts are protectable in Italy, not just as registered trade marks (as held by the CJEU in the famous case of Apple's flagship stores, C-421/2013), but also as architectural works. ▶

Kiko's store layout



Wycon Cosmetics' store layout





Ferrari 250 GTO



ITALY

FERRARI 250 GTO GETS COPYRIGHT COVER

In a decision issued on 20th June 2019 (docket No. 3973/2019), the Court of Bologna elevated the Ferrari 250 GTO to a work of industrial design deserving copyright protection under Article 2(10) of Italian Copyright Law.

The order followed preliminary injunction proceedings brought by Ferrari against another Italian company that announced plans to produce “modern replicas” of the most expensive classic car on the market. Ferrari claimed that the replicas infringed its copyright in the iconic 250 GTO design (as well as its relevant 3D trade mark).

According to the Court, which fully reversed the first-instance order, the Ferrari 250 GTO meets the requirements of “creative character” and “artistic value” necessary – until the recent ruling in Cofemel – for an industrial design product to be protected as a work of art.

In fact, the originality of the design in question and, in particular, the creative personalisation of its aesthetic elements has made the Ferrari 250 GTO a unique example in the automotive sector. Further, the recognition of the Ferrari 250 GTO design in numerous official awards, publications and exhibitions, together with the large price tag, clearly demonstrate its artistic value.

The Court then confirmed that the reproduction of a work of industrial design, having creative character and artistic value, constitutes copyright infringement if, despite any differences between the original work and the contested product, the latter takes over the individualising characteristics of the protected design. In a nutshell, the defending party has then reproduced exactly those creative and artistic shapes that allow the Ferrari 250 GTO to access copyright protection.

CLASSIC VESPAS ALSO GAIN PROTECTION

In 2014, two Chinese companies brought an action against Piaggio, requesting that the Court of Turin declare that their scooters did not infringe Piaggio’s rights in the Vespa and that the 3D trade mark portraying the Vespa was void.

In decision No. 1900/2017, the Court of Turin not only recognised the validity and infringement of the Vespa 3D trade mark, but also, through an *ex post* assessment of the additional requirement of “artistic value” (based on its collective recognition by the cultural world), that the shape of the 1945/1946 Vespa and its subsequent elaborations are works of industrial design deserving copyright protection pursuant to Article 2(10) of Italian Copyright Law.

Following an appeal by the Chinese companies, in decision No. 677/2019 (16th April 2019), the Court of Appeals of Turin confirmed that the 1945/1946 Vespa is a work of industrial design deserving copyright protection. As such, although not a requirement, the collective recognition by the cultural world of the artistic value of the work is a proof that this design deserves copyright protection.

The Court also confirmed that copyright protection extends to the design’s subsequent elaborations, as “the object of protection must be identified... with reference to the ‘historic’ Vespa model and thus to the models recognised as its direct emanation”. Further, it offered clarification as to the grounds under which copyright also protects the elaborations of the original work, as deduced from Articles 12(2), 18(2) and 4 of Italian Copyright Law.

Reports by Francesca Rombolà, Cristiana Andreotta and Valeria Meli

The 1946 Vespa 98



NETHERLANDS

TWO-PRONGED ATTACK NOW POSSIBLE

Filing a cancellation proceeding at the EUIPO is often a defendant’s first step in countering an allegation of RCD infringement. But what if the defendant wants to get on with business without waiting until all legal remedies at the EUIPO have been exhausted?

The Hague Court of Appeal’s decision in Tinnus Enterprises (27th August 2019) shows that while a cancellation proceeding is pending at the EUIPO, it is possible to get a declaration of non-infringement

from a national court without the need to suspend proceedings under Article 91(1) of the CDR. After all, according to Article 84(4), invalidity may not be disputed in an action for a declaration of non-infringement.

This offers defendants the possibility of a two-pronged approach: a cancellation action at the EUIPO and a discussion on the scope of protection in front of a national court as part of a separate action for a declaration of non-infringement. The rights holder, on the other hand, can only get a preliminary injunction, as the

national court will have to suspend any proceedings regarding permanent injunctions or declarations of infringement while the EUIPO cancellation proceeding is still pending.



The design in question in TINNUS (RCD No. 1431829-0001)

POLAND

MAKING HAY

HAYKA is a brand created by Polish design studio FOONKA. The brand is protected by a Community design registered under RCD No. 5663481-0001 in Locarno Classification class 06-13 (bed sheets, duvet covers, cot bed linen, bed linen, cushion covers).

In 2019, HAYKA applied to the District Court of Warsaw (the Court) for a preliminary injunction against a Polish entrepreneur (the Respondent) who had placed textile products on the market intended for dog owners, such as beds and mattresses featuring hay and meadow patterns.

In a ruling on 29th April 2019 (court ref. XXII GWO 29/19), the Court supported HAYKA's claims in line with the Act on Combating Unfair Competition. Nevertheless, in respect of the infringement of the Community design, the Court dismissed the claims.

In the Court's view, according to Article 3(2) of the CDR, the indication of the products in which the design will be incorporated excluded protection of the patterns. The rectangular shape of a duvet cover and pillowcases is solely dictated by its function, the Court argued.

As such, the Court found that the distinctive character of HAYKA's design covered only the pattern depicting specific plants and colour combinations and not the concept of representing a meadow on a fabric.

The Court then ruled that the overall impression made by HAYKA on an informed user differs from the impression made by the Respondent's

HAYKA products



products. The idea of a meadow on fabric was not sufficient to be considered similar due to the variety of plants and colours presented.

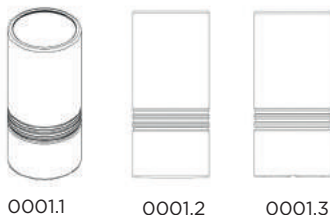
At the time of writing, the Court has not yet issued its final ruling.

CASTING A LIGHT ON CANDLES

Masterplast, a specialist in plastic processing, holds the Community design registered under RCD No. 3123256-0001, presenting a candle in three projections (the Candle).

As shown in the design, the Candle consists of two components: a thin-walled base part containing a pot, and a tube that slides over the top. By increasing or reducing the depth of the overlap, it is possible to adjust the height of the container.

The Candle's RCD



The Respondent's product

The Respondent's products



Masterplast applied to the District Court of Warsaw (the Court) for a preliminary injunction against a Polish entrepreneur (the Respondent) who had placed containers on the market for candles varying in size but with identical operation, shape and geometry. In the ruling on 14th October 2019 (court ref. XXII GWO 87/19), the Court stated that the Candle's appearance to some extent is dictated by its technical function.

In the Court's view, even though the designer's freedom is limited to a certain extent, the functionality of the product does not require the adoption of an identical arrangement of lines, layout and proportions in relation to the individual elements.

From the informed user's perspective – someone frequently visiting cemeteries and lighting candles – the design incorporated in the Respondent's product is similar to the Community design registered by Masterplast. The overall impression is determined in both cases by the simple shape of the container, the arrangement of lines and hollows, and the lack of ornaments or colour contrasts. The similarity is all the more evident when directly comparing the Candle and the Respondent's product.

Under these circumstances, the Court granted Masterplast an injunction. At the time of writing, the Court has not yet issued its final ruling. *Reports by Ewa Kindel-Kaluzna*

APPEAL COURT RULES ON CRISPS CONFLICT

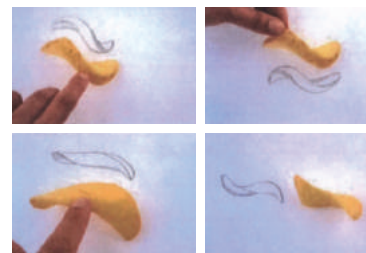
In the long-running cross-jurisdictional dispute between JR Simplot and McCain over curly crisps, The Hague Court of Appeal has held JR Simplot's RCD to be valid and infringed.

In its preliminary injunction decision of 21st May 2019, the Court denied McCain's claim that the RCD's pictures were unclear or inconsistent and concluded that the RCD was novel and had individual character compared with the "crisp" prior art.

The Court refused McCain's argument that the designer's freedom would be limited by technical requirements, and instead decided that given the variety of crisp shapes on the market, the designer had a considerable amount of freedom. Later that year, the EUIPO Board similarly considered the RCD valid.

As a last resort, McCain pointed out that JR Simplot didn't market the curly crisps covered by the RCD in the EU itself. However, the Court concluded that it is not necessary for the rightholder to use the RCD

JR Simplot's RCD



on the EU market in order to obtain an injunction.

Reports by Manon Rieger-Jansen and Nina Dorenbosch



INVESTIGATION IN THE TIME OF COVID

Gavin Hyde-Blake looks at how the professional landscape has changed for his boutique firm and the wider industry

Luckily, because of the nature of our work here at Eccora and the existing structure of the company, we were already set up to work remotely when the COVID-19 lockdown took us out of the office. An investigator gets used to having a working life that might require them to pick up a laptop and an overnight bag at short notice when an investigation is particularly urgent.

Being a small company has its advantages too, as we were able to centralise key functions, adopt new measures and manage the move to a new way of working without any downtime in our service provision. We introduced paperless working into our set-up some time ago, and it

has proved a bonus in recent months. Similarly, with the company's two directors based in different countries, we have used videoconferencing facilities as a tool for running the business for some time and were well equipped to continue that practice. As a result, our day-to-day business processes had to be refined and reinforced rather than radically overhauled. Even so, it has taken some getting used to.

BIG CHANGES

Our experience of working in lockdown has been instructive. For example, it is doubtful we will return to having a dedicated central office. After all, with so many of our

processes already contracted out – accountants, bookkeeping and so on – the logical next step is to take out the physical office space. We also actively encourage our investigators to work as flexibly as they want, structuring their work around their personal circumstances.

This raises the question of whether there are potential downsides if we go down the route of working entirely from home. Will we lose the benefits of office working? What about the sense of teamwork, effective communication and one-on-one training or mentoring? These soft skills need careful consideration if we are to make a longer-term change in our working practices.



“ We have not yet had to have a Zoom call with an infringer, but that is probably very likely going forward

IP Research

While working from home brings numerous benefits, it also brings the possibility of a sense of alienation for staff and the increased prospect of a significant negative impact on mental health. As a director, I have a duty of care to ensure that this is dealt with before it becomes a problem. We are already working towards company awaydays and one-off get-togethers for both work and social reasons as one method of overcoming this before it becomes an issue, as well as the possibility of training to provide mental health first aid.

Our workload has changed considerably since the lockdown started. In-use and clearance work for new trade marks dropped suddenly, as companies put planned product launches on hold, but we have seen a rise in infringement work coming in to take its place. We have had to realign some internal processes to deal with this. This change in focus seems to reflect a wider trend in that direction, with a sharp increase in IP infringements as unscrupulous traders cash in on the COVID-19 outbreak, particularly through counterfeit medicines and medical products.

Of course, these kinds of investigations bring their own risks that need to be managed. For instance, visiting the premises of an infringing trader is not possible now, so a system of test purchases and follow-up contacts is used instead. We have not yet had to have a Zoom call with an infringer, but that is probably very likely going forward!

PRACTICAL DIFFERENCES

We have also had to change our manual handling procedures for any products received, to take into account both the sensible precautions needed to avoid contamination and to retain a clear chain of evidence. Some of our test-purchase programmes were on hold throughout lockdown (primarily in Germany and China), but these are now returning to normal, albeit with much slower postal systems.

COVID-19 also brings in its wake a probable global economic downturn – certainly one has been predicted by most authoritative sources. In previous recessions, we have seen an increase in infringements as companies, struggling to survive, try to find new ways to stay afloat and, wittingly or unwittingly, breach the IP rights of others. We see nothing to suggest that the pattern will be different this time. The medium-term question of identifying and making first contact with infringers at events such as trade fairs remains an unknown at present, and this is something that is out of our hands. However, with several services in place to help attack the problem of infringement, we will be preparing to meet these next waves of challenges and changes too. ●



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ONE STEP BEYOND

Bernadette Mee explains why BT's latest rebrand was more than a simple change of symbol



With origins dating back to 1846, BT is the world's oldest telecommunications company. Formerly part of the General Post Office, it was privatised in 1984 and launched its new British Telecom logo (see panel). For the company, this was a new beginning and a new ethos, which was symbolised by its brand line: "It's you we answer to".

In the first decade following its privatisation, the company acquired a mobile communications business, computerised its directory enquiries service and launched the world's first satellite telephone system on a Boeing 747. However, technology was rapidly changing and in the '90s the company

set up a new organisational structure focusing on specific market sectors. Thanks to a succession of strategic alliances with telecommunications companies worldwide, the company expanded into 170 markets overseas.

This structure was launched under the new trading name BT and the new BT & Piper corporate logo. As British Telecom had regularly been referred to as BT in the '80s, the name was already associated with the company and had substantial goodwill. This was the era of the iconic "It's Good to Talk" adverts

highlighting the launch of BT's residential mass-market internet dial-up services, and BT opening its 1000th broadband-enabled exchange, offering public Wi-Fi access for the first time.

FUTURE FOCUS

In April 2003, BT's identity and values were refreshed again. This meant a new corporate identity, the connected world symbol, and a new brand line: "Bringing it all together". Reflecting the aspirations of a technologically innovative future, the connected world symbol was bright, strong and clear. In this period, BT



“ By 2019, BT was strongly focused on its journey into a new digital era and wanted to ensure that no one would be left behind

connected its 10 millionth broadband line and was at the heart of the 2012 London Olympics and Paralympics as the official communications services provider, a sustainability partner and a lead sponsor. That year was also marked by the 75th anniversary of the 999 emergency service (showcasing BT's long history of managing high-volume call centres), the launch of the BT Sport TV channels and the acquisition of EE. BT had come a long way since privatisation.

INTO THE DIGITAL ERA

By 2019, BT was strongly focused on its journey into a new digital era. As the first provider in the UK to launch 5G – with 50 cities and large

towns connected through its EE business – BT also wanted to ensure that no one would be left behind. It launched a new digital skills programme providing free training to people, families and businesses in the UK. It also announced a return to the high street for the first time since 2002, with dual-branded EE-BT stores now across the UK. Home Tech Experts can visit customers in their homes to help them install new technology, and BT is also running programmes around the world to support digital skills through its partnerships with UNICEF and the British Asian Trust.

As a symbol of these changes and its new direction, BT introduced a new brand line, “Beyond Limits”, which represents its determination to go further than ever to connect more people and businesses across the UK, helping them make the most of technology and equipping them with the skills they need to release their potential. These ambitions are all intended to be symbolised by a new BT logo.

The BT name has been part of the company's history for nearly 40 years, so it seems fitting that its importance has been retained and enhanced. For the first time, it is being used alone as a symbol not only of what BT has achieved, but also of what BT will achieve as a modern technology company, taking full advantage of emerging technologies.

The new BT logo is intended to be simpler and more memorable, which makes it ideal for use in both digital and physical environments, for all BT's lines of business and on all types of media. The new BT logo is used in indigo, white or black, and indigo is also the core BT brand colour, supported by the colour pink. There is a new brand feature called the Portal, born from the new BT logo. This is BT's main graphic asset. It is symbolic of a doorway to the world of BT's networks, products and

EVOLUTION OF A BRAND

BT's logo and brand line have changed several times since the company was privatised in 1984

1984 BRAND ID

The logo features the word "British" in a small, blue, sans-serif font above the word "TELECOM" in a larger, blue, all-caps, sans-serif font. The letters "E" and "O" in "TELECOM" are stylized with horizontal lines.

BT & PIPER LOGO



CONNECTED WORLD SYMBOL

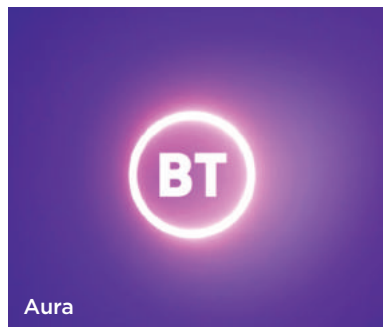
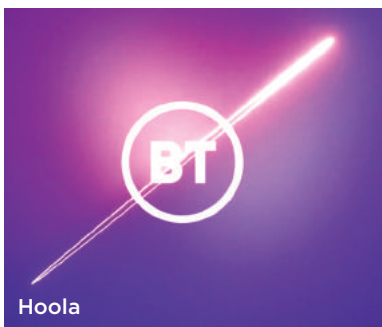
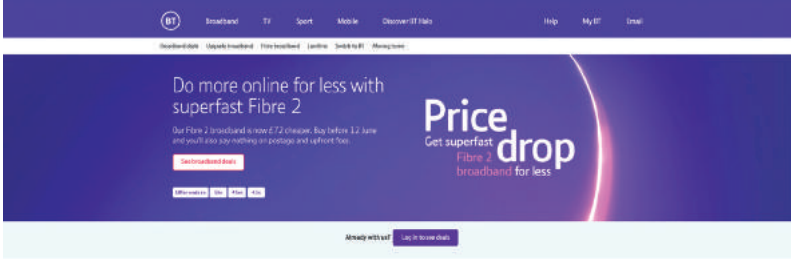


BEYOND LIMITS LOGO



BT IN JAPAN (KATAKANA)





“ The simplicity of the new logo presented challenges in countries where two-letter words are not acceptable

Trade mark filings have been made at both the UK IPO and the EUIPO to protect all aspects of the new BT identity: the BT logo, the “Beyond Limits” brand line, the Portal images and combined images of all the above in both static and animated form.

Filings have also been made in many of the other countries in which BT is active. As the company has existing trade mark registrations for BT and the connected world device in around 165 countries – and has also protected BT (alone) in any country in which it trades and where it is possible to do so – protecting the new BT logo was a simpler process than if the name BT were being used for the first time. However, the simplicity of the new BT logo presented registration challenges in those countries where two-letter, unpronounceable words are not acceptable. Even so, by being inventive, it was possible to come up with a form of the mark consisting of the new BT logo alongside its transliteration or translation in the local language and the relevant script (such as katakana, for Japan). That had the advantage of working well for the company as regards local use and enabled BT to achieve registration in each such country.

So, together with BT’s other brand assets, the latest logo is symbolic of a new journey for BT as it moves into an exciting technological future where everyone is included and challenged to go one step beyond. ●

services. There are three Portal modes: Glimmer, Glow and Power. There are Portal animations and animations in which the new BT logo and the Portal are combined – namely, the BT Logo Loop Aura and the BT Logo Loop Hoola. There is also an animation of the new BT logo with the Beyond Limits brand line and the Portal. Together, these are BT’s new visual identity.

MORE THAN A LOGO

When the rebrand journey started, BT knew that a logo change alone was not enough to signal how much it has changed and its transition from a plain old telephone company to a modern technology company. So BT’s brand change forms part of a far larger picture – not merely a change of the brand’s symbol, but a symbol of the brand’s change.

For example, a TV ad developed for the rebrand campaign focuses on “skills for tomorrow”. First aired in

October 2019, it follows the story of a young girl as she travels through modern Britain to reach her classroom of the future, concluding that this is a journey of optimism and pride and showing that technology can play a positive role in our lives. The ad begins with the girl citing the opening words of Charles Dickens’ *A Tale of Two Cities*: “It was the best of times, it was the worst of times”. Little did we know that within a matter of months the worst of times would be upon us, with a global pandemic affecting all our lives. Keeping the nation connected has never been more essential.



Bernadette Mee

is Principal IP Lawyer (Trade Marks) at BT Legal
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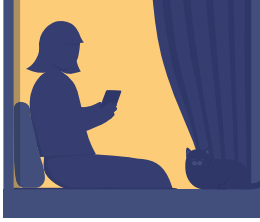
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FIRST THINGS FIRST

The COVID-19 crisis has highlighted the vital role of first responders in safeguarding our society, but don't ignore their importance in your organisation too

If there's one thing that the past few months have taught us, it's the importance of understanding how our organisations can and must support their employees in challenging times. While many employers have changed the way they work to embrace the need to physically distance employees from each other, we've also become aware of how our so-called "new normal" may not feel very normal at all – which means being ready to provide assistance to those who are struggling to cope with mental health challenges too.

With many mental health professionals warning that the effects of COVID-19 are likely to last long after lockdown, now is the time to ensure you're ready. Offering the services of mental health first aiders (MHFAs) within an organisation can be one way to provide a first line of support over the coming months and years.

WHAT IS AN MHFA?

The concept of mental health first aid training was first developed in Australia some 20 years ago and was introduced in the UK in 2007 when the Department of Health included it as part of a national programme to improve public mental health. More than 3 million people have now been trained in mental health first aid across more than 25 countries.

MHFA England, a social enterprise that provides mental health training and other resources for businesses, explains that the role of an MHFA is not to be a therapist or counsellor. Instead, MHFAs are there to "act as a point of contact and reassurance for a person who may be experiencing a mental health issue or emotional distress". MHFA England suggests that organisations should have the same number of MHFAs as they have physical first aiders, as a minimum.

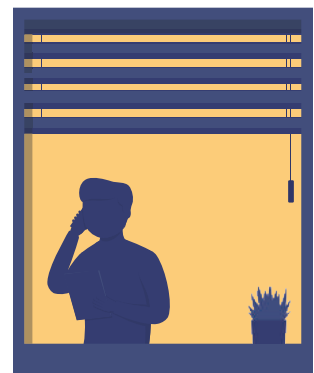
To this end, MHFA England offers a range of training courses for MHFAs, as well as guides for employers about recruiting and supporting MHFAs (ideally as part of a larger wellbeing strategy). There is also advice on signposting other employees to the MHFA's services to ensure they are as effective as possible once in post.

Having attended MHFA England's two-day course, MHFAs should be ready to:

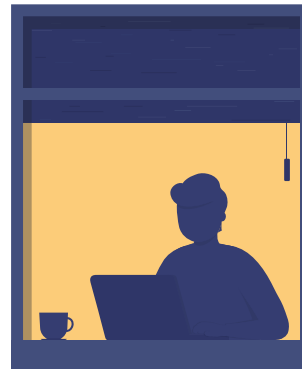
- Understand the important factors affecting mental health;
- Identify the signs and symptoms of a range of mental health conditions;
- Use a five-step action plan to provide mental health first aid to someone experiencing a mental health issue or going through a crisis;
- Listen non-judgmentally and hold supportive conversations; and
- Signpost people to professional help and encourage them to seek support.

As part of the MHFA England training, attendees will be encouraged to challenge the language used around mental health and will learn the factors that can influence it. They will explore the stigma attached to mental health issues and understand what good mental health looks like. Importantly, they will also learn how to support their own mental health through self-care. The courses can be taken by anyone with an interest, and there's no need to have any other background in mental health.

While trained MHFAs will support individuals with their personal challenges, investing in MHFA training also has benefits for the organisation more broadly. For example, MHFA England explains that promoting the role within your



“ Remote working can increase feelings of loneliness and isolation, which are risk factors for mental health



organisation will: help to eliminate barriers that stop people feeling confident enough to speak out about their mental health; encourage people to access support early; empower those who have mental health issues to thrive in the workplace; promote a “mentally healthy environment” and; “embed a long-term positive culture across the whole organisation, where employees recognise that their mental and physical health are supported as equal parts of the whole person”.

REMOTE SUPPORT

While their work has traditionally been carried out in workplace settings, MHFA services don't have to stop if your organisation has decided to keep working from home on a permanent basis. In fact, MHFA England says that in cases where we are physically distant, human connection is all the more important, as “remote working can increase feelings of loneliness and isolation, which are risk factors for mental health. Fortunately, the principles

of mental health first aid are the same whether you are supporting someone face-to-face or from a distance. However, the way you apply these principles might be different.”¹

Ensuring that MHFAs can be effective during physical distancing will mean making sure they are easy to contact by phone, email or messaging apps so that people who require help can access it quickly. MHFA England also suggests that support should be offered via video calls so that useful visual cues such as facial expressions, posture and body language can be assessed. Where the nature of the support requires setting up meetings with line managers, this can continue using remote conferencing tools. Just remember that external resources may be different where a person is working away from their usual setting.

IS FIRST AID EFFECTIVE?

MHFA England has commissioned a three-year research project from the Centre for Mental Health and London South Bank University to study the impact of mental health first aid in the workplace. In the meantime, a three-part Mental Health First Aid in the Workplace study from the University of Nottingham and the Institute of Occupational Safety and Health has looked at what training is available and surveyed 81 organisations that had received this mental health first aid training. The top-line results were encouraging in terms of its value. For example:

- 91 per cent of employees reported an increased understanding of mental health issues in their workplace;

- 88 per cent reported increased confidence around mental health issues; and
- 87 per cent said that more conversations about mental health were taking place at work.

Perhaps just as compelling as the hard data are the reflections of David Hammond, an MHFA at Haseltine Lake Kempner, on the website of Jonathan's Voice, a charity set up to reduce the stigma associated with mental health issues and support workplace best practice following the death by suicide of Patent Attorney Jonathan McCartney in 2017.

As a friend of Jonathan, David found himself blindsided by his death. Even so, he writes: “The one thing that I did resolve to do was to make sure that I did everything in my power to try and stop this happening to anybody else. Not on my watch.

“Jonathan's death will stay with me forever. But becoming a mental health first aider has helped me make some sense of it all, and has left me feeling better in myself and more importantly better equipped to be there for others.

“It doesn't take two minutes to check on a colleague or friend and ask how he or she is doing, but it could change their view of the world and of their workplace, to know that someone cares and is there to listen.” ●

If you are interested in training MHFAs for your organisation, or training as one yourself, you can find further information and resources at mhfaengland.org

¹ *Being a Mental Health First Aider: Your guide to the role*, MHFA England, 2019

MAKING MENOPAUSE MANAGEABLE

Mandy Laurie offers some observations on supporting employees through this natural (but not yet normalised) process



Research commissioned by specialist retailer Health & Her has revealed that 14 million working days are lost annually due to symptoms of the menopause, with 370,000 women reporting that they have considered resigning their position because it is too hard to manage their symptoms in the workplace.

Recognising that there is a real business imperative when it comes to retaining women within the age category most likely to experience menopause symptoms (40 to 50), Burness Paul hosted a series of roundtable discussions exploring how best to tackle the problem.

The results were fascinating.

Several key themes emerged:

- Raising awareness among all staff of the potential symptoms and effects of the menopause was considered the most effective way to support women and normalise discussion of the menopause in the workplace;
- There was a preference for raising menopause awareness and support as part of a wider wellbeing initiative, rather than as a specific diversity and/or inclusion initiative; and
- General workplace policies, such as agile and flexible working, could greatly assist menopausal women without singling them out.

Other insights were also uncovered, which could help any organisation looking to devise a strategy for supporting women through the menopause in their work environment.

AGREEMENT ON AWARENESS

The menopause will have a different effect on every woman. Often a woman will not know that she is going through the menopause (or the perimenopause transitional phase beforehand) because the symptoms are misdiagnosed or they experience few symptoms.

With this mind, several examples were provided where an HR team's knowledge of the menopause (due to its members being female and of a certain age) had helped employees identify that the menopause was the cause of their symptoms. However, there were differing views on whether HR was the best place for an awareness of menopause symptoms to reside. Some felt that this should not be an HR-specific role, as it was important that all staff felt able to identify colleagues in need of support and discuss the menopause. Others felt that employees may feel more able to confide in HR because of the sensitive nature of the conversation.

All participants did agree that there was an indisputable business need to raise awareness of the menopause. But this raises another question: how do you bring the matter out into the open?

It was acknowledged that many line managers would welcome the opportunity to learn more in order to support their staff, get the best out of their team and be the first to spot women in need of support. Managers should be equipped to handle the initial conversation and make it meaningful. However, it was also recognised that women will often not want to be singled out as going through the menopause. For this reason, strategies such as dedicated "menopause mentors" were greeted with reluctance. Businesses also often have various roles such as mental health first aiders and equality champions, which could be called upon here to help.

Overall, participants agreed that raising awareness for all was the best way to help staff recognise, understand and support women

14m

working days are lost annually due to symptoms of the menopause

370,000

women say they have considered resigning because of menopause symptoms

40-50

the age range in which most women experience the perimenopause. It's also a time when men are more likely to suffer from serious mental health issues

going through the perimenopause or the menopause. As part of this, organisations may wish to consider compulsory training for management and HR, as well as including information regarding menopause in newsletters or displaying information at coffee points. Ultimately, it's essential to create an inclusive culture in which women experiencing the difficult symptoms that arise from the menopause are recognised and supported without stigma.

IS THIS ABOUT INCLUSION?

There was a lively debate around whether the matter should be considered as part of an employer's ►

“ Raising awareness among all staff of the potential symptoms and effects of the menopause is the most effective way to support women

health and wellbeing provision or within its diversity and inclusion (D&I) initiatives. Some participants felt that D&I was the necessary and appropriate framework in which menopause discussions should take place. Others felt that making it a gender-specific issue was a major turn-off, not only for those women it affects but also for their colleagues and line managers.

Raising awareness as part of D&I work may also lead to stigma or result in a focus on what a woman is not able to do, rather than on what she can offer during what is just one phase of her working life.

Participants also discussed the fact that the age range in which most women experience the perimenopause – between the ages of 40 and 50 – is also a time when men are more likely to suffer from serious mental health issues. So men too are more likely to leave an organisation during that period due to a lack of support or understanding.

As a result, a more holistic approach to supporting the health and wellbeing of both sexes could be very beneficial. For example, employers could offer anyone over the age of 40 a general “health MOT”. While this would clearly cost an employer, it is perhaps a genuine benefit to workers that could save a business money. More importantly, it could improve workers’ health and wellbeing and avoid absences.

THE ROLE OF PROFESSIONALS

As noted earlier, the menopause can be difficult to diagnose and women are often misdiagnosed as suffering from, for example, depression when presenting with menopause-related symptoms. Participants felt that this was an area in which occupational health specialists could be more fully trained, offering a service to employers to train and support their workforces. Employers might also offer employee assistance programmes and should ensure that any such service is also able

to recognise and understand the menopause and its symptoms.

The right medical input can be crucial for employers if an employee is absent from work or struggling with their performance. However, it was recognised that a referral to occupational health, particularly at a certain age and stage of life, may be seen by the employee as ominous and be met with resistance. Therefore, the general preference remained a more proactive but invested approach to the health and wellbeing of individuals at this stage of their life, across both sexes.

The participants noted that there is a wealth of information and guidance available for employers on menopause policies and adjustments that could be carried out. However, most of the guidance was felt to be quite generic and often not practical in terms of the approach that should be taken when assessing whether an individual is going through the menopause, or when considering how discussions should take place. A number of guidance documents contained stereotypical pictures, such as a woman with a fan on her desk and jokey references. Businesses should be careful to avoid this kind of humiliating content.

SUPPORT AND ADAPTATION

Supporting staff going through the menopause will not always result in a legal obligation to make workplace adjustments, but best-practice employers should consider whether there are any adaptations they can make. For example, a general policy of agile working – providing added flexibility in terms of hours and

KEY STEPS TO CREATING A MENOPAUSE-FRIENDLY WORKPLACE:



Consider the best framework to use to raise awareness within your organisation, ideally within your health and wellbeing agenda.



Raise awareness among all staff of the menopause, its symptoms and its effects.



Seek to normalise discussions regarding the menopause in the workplace by ensuring that there is an open-door culture and demonstrating management-level commitment to understanding and supporting menopausal women.



Consider adaptations that could be made to working arrangements and the work environment to support women going through the menopause, regardless of whether or not there is a legal obligation to make those adjustments. For example, can flexible and agile working policies be introduced or used to better effect?



Work with occupational health professional and other health providers to ensure that they are sufficiently equipped to recognise and support women going through the menopause.



Create guidance and provide training on conducting health and safety risk assessments for menopausal women.



Manage the menopause in the same way you would approach any other sensitive health issue. Address the matter with the employee promptly and in a supportive manner, seeking medical input where required.



location of work – could assist greatly. However, agile working is not possible for all organisations. So how does an employer ensure that such workers are catered for?

Individuals may feel that during this period they would like a temporary career change, perhaps remaining in the organisation but changing role for a limited period. Some may feel that a career break would benefit them. Employers able to accommodate such changes may avoid having to address absences or performance issues through a formal process. To avoid discrimination claims and attract and retain the best staff, such options would ideally be available to all workers.

LEGAL CONSIDERATIONS

Since there are additional legal obligations around the earlier stage of a woman's life – such as protection against redundancy during pregnancy – should there be any additional protection afforded to women during the menopause stage? On the whole, participants felt that there was probably enough legal protection available for women going through the menopause.

For example, the provisions of the Equality Act 2010 that cover sex and disability can protect women who have suffered unfavourable treatment based on their menopause symptoms. Employees may also be able to file unfair dismissal claims if they are dismissed due to their menopause symptoms.

Workers are also protected against harassment relating to symptoms of the menopause. If this kind of mistreatment seems unlikely, remember that we have already witnessed a Deputy Governor of the Bank of England refer to the economy as “menopausal”, with the inference that it is slow, sluggish and old.

The legal obligation to carry out a risk assessment under the Health & Safety at Work Act 1974 also applies where an employee is menopausal. Risk assessments are something



“ The benefits to a business of supporting menopausal women in the workforce should be tangible

that could benefit employees and could also assist an employer in defending against claims that they have failed to make a reasonable adjustment. In the public sector, in addition to the general duties under the Equality Act 2010, there are also additional obligations under the Public Sector Equality Duty, which can help to promote and protect menopausal women. We are only just beginning to see claims at the Employment Tribunal relating to the menopause, but as awareness of its impact in the workplace grows, it is likely that more claims will arise.

If a woman is struggling with her work performance or attendance as a result of menopause symptoms, this should be addressed as usual, consulting with the individual and potentially seeking an occupational health referral. Informal early consultation may be sufficient to avoid the need for a formal process.

Where a worker's symptoms affect their performance or attendance at work, and they are not taking any of the recommended steps in relation

to self-care or therapy, what should be done? Would an employer be able to dismiss fairly on the grounds of capability if the worker did nothing to help themselves? It would certainly be a very sensitive and perilous case due to the risk of a discrimination claim, unless it could be shown that the worker was clearly rejecting useful medical or therapeutic help for no good reason, or had shown no improvement over a prolonged period of time and their symptoms were adversely affecting the business.

SUPPORT IS SUPPORTED

Ultimately, at all of the roundtables, it was clear that there is a real desire to support menopausal women in the workforce. The benefits to a business of doing so should be tangible. Not only will such measures mitigate against legal claims and potentially help to close the gender pay gap, but they should also help to reduce absenteeism, increase productivity and support the engagement and retention of a richly talented intergenerational workforce. ●



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Raw food fight offers real insight

Khemi Salhan believes the Defendant made a dog's dinner of disclosure

Here, a claim was brought (successfully) by a boutique pet food brand against a competing, goliath pet food brand for trade mark infringement and passing off. The marks in dispute are shown below. The substantive issues were whether the Defendant's use of its signs amounted to passing off and trade mark infringement, under s10(2) and 10(3) of the Trade Marks Act 1994. Also notable was the guidance provided regarding disclosure in IPEC proceedings.

In relation to s10(2), the Judge adopted the summary set out by Mr Justice Arnold in *Sky plc & Others v SkyKick UK Ltd & Another*¹, explaining the global appreciation of the likelihood of confusion. In relation to s10(3), the parties relied on the summary of the law used by the Trade Marks Registry and taken from the jurisprudence of the Court of Justice, which the Judge gratefully adopted. He noted too that once the elements of infringement are established, it is for the defendant to show that the use has been with due cause.

In light of *THOMSON LIFE*² and *Aveda Corporation v Dabur India Ltd*³, adding a distinctive and reputed house mark to a mark that maintains its independent character does not avoid infringement. Applying these principles, a key issue was assessing the claimant's reputation, which is essential for establishing s10(3) infringement. The Claimant's evidence in this context was "overwhelming", its brand being one of the leading brands within the raw pet food market.

Assessing infringement under s10(2), the Judge found that the marks were: similar to a medium degree; visually similar to a low

degree; aurally similar to a medium degree, and conceptually similarity to a high degree. In addition, the Defendant accepted that the goods sold under the signs were identical.

As a result of the above assessments, the Judge considered that a likelihood of infringement existed. Infringement under s10(2) was therefore established, without consideration of any alleged instances of actual confusion. Nevertheless, the Judge did review six instances of confusion reported by the Claimant's employees and ex-employees (an approach considered appropriate for the IPEC). He concluded that there were clear examples of consumers having been confused, which could not be discounted as "low-level administrative muddle" (as the Defendant sought to portray them). This confirmed the finding of likelihood of confusion already reached.

Turning to s10(3), the reputation and enhanced distinctive character of the marks would likely cause a link between the two businesses in the mind of the average consumer. The logical deduction was that consumers' economic behaviour would change, causing detriment to the Claimant's repute. Further, the trust shown in the Claimant's brand indicated that the Defendant was likely to receive a "leg up" as a result of the link formed in consumers' minds, and that advantage was unfair. The conditions for liability being satisfied, the Defendant failed to establish that its use was with due cause. Infringement under s10(3) was therefore established.

On the law of passing off, the Judge adopted Lord Oliver's summary in the *Jif Lemon* case.⁴ While noting that likelihood of confusion in



trade mark law and misrepresentation in the law of passing off should not be conflated, the Judge held that his findings in relation to likelihood of confusion could be carried over into the passing off claim. Goodwill and misrepresentation having been established, it was not seriously contested that damage would follow. The Claimant's passing off claim therefore succeeded.

DISCLOSURE

The Defendant had provided two witness statements confirming it was aware of customer queries asking whether it was the Claimant. Receiving the witness statements, the Claimant requested that any records showing confusion be disclosed as part of the parties' obligation to disclose known adverse documents.

At the case management conference, His Honour Judge Hacon had directed that "the parties will make and serve on the other... a list in accordance with Form N265 of documents in their control *and* upon which they will rely in support of their case" [emphasis added].

Both parties accepted that they were also under an obligation to disclose known adverse documents. While the Disclosure Pilot under Practice Direction 51U (PD 51U) does not apply to the IPEC, disclosure of known adverse documents is standard practice in IPEC proceedings. The *IPEC Guide* states: "Usually, whether or not other disclosure is ordered, the parties will be expected to disclose any known adverse documents within the meaning of Paragraph 2 of PD 51U".

A dispute arose as to whether the Defendant was required to look for documents evidencing confusion and to disclose them. The Judge concluded that the "and" in HHJ Hacon's order was conjunctive in nature (ie, that the obligation was to disclose documents that were both in the Defendant's control *and* upon which the Defendant relied in support of its case). Since

the Defendant did not wish to rely on instances of confusion, it was not required to disclose the documents (or search for them) under that direction. However, the Judge noted that "if a search is conducted and [documents] are found or otherwise come to the attention of the party, they need to be disclosed", adding that it was highly likely that instances of confusion would have been recorded in "documents" (eg, Facebook messages and emails) and that the Defendant was likely aware of them. These documents should therefore have been disclosed.

LOOKING FOR LIKELIHOOD

This case serves as a reminder that the court need only find a likelihood of confusion, rather than actual confusion. While evidence of actual confusion may help, it can be hard to come by and many cases are run without any.

Litigants and their representatives should keep in mind all of their obligations when litigating. These obligations are not limited to those listed in court orders. Orders provide practical boundaries as to what the litigation will cover, particularly in the IPEC, but wider obligations under court guides still apply.

In this case, while the Defendant was under no obligation to search for known adverse documents, it was highly likely to know that such documents existed. As and when such documents appeared during a disclosure search, the Defendant should have disclosed them.

To avoid making a dog's dinner of the disclosure process, parties should consider which categories of adverse documents are likely to materialise before undertaking their search for documents. They can then look out for those in particular. Of course, this may raise questions about how the scope of the disclosure search conducted (a keyword search versus a trawl through files) has influenced the kinds of adverse documents that were ultimately disclosed.

KEY POINTS

- ✦ Evidence of actual confusion is helpful, but it is not a requirement. A likelihood of confusion is sufficient to prove infringement under s10(2)
- ✦ Court orders concerning disclosure will not relieve a party from its general disclosure obligations (whether under the Civil Procedure Rules or the applicable court guide)
- ✦ There are still some outstanding questions regarding the scope of the disclosure search to be conducted, and whether you are obliged to carry out a search if you suspect, or if it is highly likely that, such documents exist

MARKS

THE CLAIMANT'S TRADE MARK

Natural Instinct
Only the Good Instinct is natural, otherwise.

Natural Instinct
Only the Good Instinct is natural, otherwise.

THE DEFENDANT'S SIGNS

TRUE INSTINCT

TRUE INSTINCT



- 1 [2018] EWHC 155 (Ch), at 287
- 2 C-120/04, *Medion v Thomson Multimedia Sales*
- 3 [2013] EWHC 589 (Ch)
- 4 *Reckitt & Colman Products Ltd v Borden Inc*, [1990] RPC 341, at 406



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No free ride for FreePrints

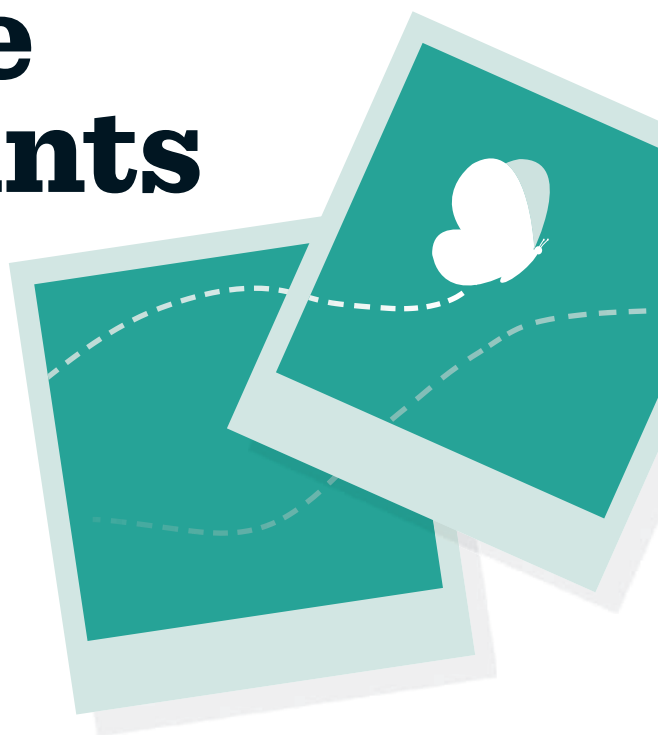
A mixed result gives an insight into the mobile context, says Joel Smith

With this decision, the High Court provided a reminder of the approach to determining whether descriptive terms have acquired distinctiveness, which is the global assessment applied to likelihood of confusion and the approach used under passing off. It also made interesting comments regarding the commercial context of mobile applications.

The Claimants had operated a mobile application on digital platforms such as Apple's App Store since 2014. The application provides a photo-printing service under the name "FreePrints". The Claimants used an icon to identify their application, consisting of a square shape with rounded corners. The interior was shaded light blue, and a slightly darker blue polka dot pattern was just visible. This square contained a simple drawing of a butterfly in white lines with hollow interiors. Beneath was the word "FreePrints". The Claimants held a registered UK trade mark for a stylised image with the word FREEPRINTS beneath, and this image should be what is seen on a user's mobile device once the application was installed.

The Defendants had launched a competing service in 2019 under the brand "Photobox Free Prints", using an icon which also consisted of a light blue/turquoise background applied to a square with rounded corners, with a drawing in white outline over the top. This drawing was reminiscent of a pile of Polaroid photo prints. Once the application was downloaded, it would be presented on the user's device as an icon with the words "Free Prints" beneath it (without the word "Photobox"). The Defendants also had a registered UK trade mark for PHOTOBOX FREE PRINTS that predated the Claimants' trade mark.

Following an unsuccessful interim injunction application, the Claimants issued proceedings on the basis of trade mark infringement under



s10(2) and s10(3) of the Trade Marks Act 1994 and passing off. They also sought an order that the Defendants' registered trade mark for PHOTOBOX FREE PRINTS was invalid, on the grounds of bad faith.

In making his judgment, Mr Daniel Alexander QC initially saw the attraction of the Defendants' position that the Claimants had clearly chosen highly descriptive terms in order to inform users of what their application did but could not now claim a monopoly over common English words. However, the Court ultimately found for the Claimants on some counts and for the Defendants on others.

SECTION 10(2)

The Court found significant aural and visual similarities between the Claimants' trade mark and the Defendants' icon, as well as some conceptual similarity. It noted that the Apple App Store guidelines required the application's name to appear below the icon and held that in the context of a mobile application, the average consumer would expect the term below an application icon to have trade mark significance.

The Court noted that there was no requirement to show actual confusion or a change in consumer behaviour as a result of confusion; the question was whether there was a likelihood of confusion. The Court then applied the global appreciation test, taking into account the

“ *Mobile applications often use descriptive terms, given the small space available for advertising* ”



various features of each of the trade marks and the Defendants' icon overall. The Court noted that distinctiveness was relevant to the global test and found that consistent use of the icon together with the words "FreePrints" by the Claimants needed to be taken into account. It found a likelihood of confusion within the meaning of s10(2).

The Court declined to find infringement in respect of two other signs used by the Defendants, which appeared at other stages of the customer experience: on the store page for their application, and as used in emails. Both included prominent placement of the word "Photobox". This took the use outside the criteria for infringement, primarily due to the impact upon the origin function. The user would recognise that the parties offering the application were the Defendants where they had placed the word "Photobox" before "Free Prints", and "Free Prints" would be considered descriptive as a result. The Court may have had in mind that, on mobile application stores, it is common for the name of the party offering the application to appear before a description of the application.

SECTION 10(3)

The Court found that the Claimants' trade mark had acquired sufficient reputation to bring a claim and that

consumers would link the trade mark and the Defendants' icon. It also found that the extensive use of the Photobox icon would damage the distinctive character of the trade mark by impairing its origin function. Further, the Defendants had taken unfair advantage of the Claimants' reputation – regardless of whether or not they intended to.

Conversely, this claim failed for the other two signs containing the word "Photobox", due again to the dominant presence of that word.

PASSING OFF AND INVALIDITY

The Court was satisfied that the threshold for a passing off claim had been met. The Claimants had acquired goodwill in the mark "FreePrints" when combined with the dominant features of their icon as a whole. However, the Court found no misrepresentation. In this case, the Defendants' icon only appeared when the user had already selected and opted to download the application. In search results and on the application store page for the Defendants' application, it was made clear that Photobox was the developer and that "Free Prints" was being used descriptively. Therefore, there was no misrepresentation (and consequentially no damage). The action to revoke the Defendants' registered trade mark on the grounds of bad faith failed.

UNCOMMON CONTEXT

The case raised interesting points regarding the marketing of mobile applications and what impact this can have when considering trade mark infringement. It is common for mobile developers to use descriptive terms on app storefronts, given the small space available for them to advertise their applications to users. This case demonstrates that these terms can become distinctive when used with a distinctive icon, especially given the massive potential audience for digital applications. It also shows the importance for rivals aiming to displace an incumbent application that is protected by a trade mark to add distinguishing brand names to their application to avoid confusion.

KEY POINTS

- + Mobile application stores and the way in which the user views marks of origin in the context of selecting and downloading applications can have a bearing on considerations of trade mark infringement
- + Descriptive terms can become distinctive when used with a distinctive icon
- + Those aiming to displace an incumbent application could add distinguishing brand names to their application to avoid confusion



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Court comeback for cult band

Patrick Cantrill sounds off on how a legendary group won back its name

This High Court decision follows some fiercely fought cancellation proceedings before the UK IPO¹ between the Bonzo Dog Doo-Dah Band (the Band) and Anglo-Atlantic, a company controlled by Robert Carruthers, a promoter that for a while had been involved with the Band. The dispute concerned the UK registration in classes 9 and 41 of figurative mark No. 3129760 (shown below), which had been designed by or on behalf of Carruthers.

The central issue was the ownership of goodwill in band names, especially where over time the line-up of the band members may have changed, with little, if anything, having been discussed – let alone agreed – about the fate of such assets.

CULT FOLLOWING

Formed in 1962, the Band became well-known for its witty, often surreal, compositions. It garnered a cult following throughout the 1960s with hits such as “I’m the Urban Spaceman”. The Band broke up over the course of the 1970s, with some members pursuing other ventures. Nevertheless, the members would periodically regroup to record and perform together.

The Registry had ruled that even if, starting in 2005, the promoter had invested significant time and money in the Band, there was residual goodwill. According to the “last man standing principle”², any goodwill generated after 2005 would still vest with the Band. The Registrar cautioned that “persons or businesses who engage with a band... should not be registering trade marks the effect of which would be to put them in complete control of the name of the band they represent”. The registration was found to be invalid on grounds of bad faith. In addition, it was held that the Band had earlier rights (under s3(6) and s5(4) of the Trade Marks Act 1994, respectively).

STRIKING OUT

Prior to the conclusion of the Registry’s proceedings, Anglo-Atlantic had issued High Court proceedings claiming that the Band

had engaged in:

- (1) conspiracy to injure;
- (2) malicious falsehood;
- (3) misrepresentation, and
- (4) trade mark infringement.

The Band sought to have these claims struck out on the basis that the pleadings did not disclose any reasonable grounds and were otherwise an abuse of the court process.³

Anglo-Atlantic’s claims were held to be wholly without merit and, in a scathing judgment, the Judge awarded indemnity costs to the Band. In particular, the Judge dismissed the infringement allegations on the basis of *res judicata* in that the Registry, being a court of competent jurisdiction, had properly and openly held that the Band owned goodwill in its name and thus that the registration was invalid, as per the FIRECRAFT decision.⁴

CAUSE CÉLÈBRE

The road to winning back this name was long and tortuous, and the dispute has led The Musicians’ Union and others to back a campaign requiring proof of ownership as a prerequisite of registering the names of bands. The case is also a reminder of the benefit of legal representation. Before both the UK IPO and the High Court, the Registrant had been a litigant-in-person and no doubt a poor understanding of law and procedure had led to proceedings that were needlessly protracted and convoluted.

1 O/664/19

2 BL O-369-13

3 Civil Procedure Rules, 3.4(2)

4 [2009] EWHC 2784 (Ch)



KEY POINTS

- ★ This case again highlights issues with ownership of goodwill in the names of music bands
- ★ The Judge dismissed the infringement allegations on the basis of *res judicata*
- ★ A lack of legal representation can prove dangerous

MARK

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Cooking up a storm

Leanne Gulliver gives us a taste of a food industry dispute

In this case, Shine TV Ltd (STL), the British media production company behind the well-known *MasterChef* television series, defended an invalidation action filed by Mana YA Ltd (MYA), an Israeli frozen and packaged food company, against its UK registration No. 3267851 for MASTERCHEF (the 2017 MASTERCHEF Registration) in classes 29 and 30, before successfully opposing MYA's UK application No. 3324139 (the Application) for goods in classes 29 and 30.

STL opposed the Application on the basis that, contrary to:

1. Section 5(2)(b) of the Trade Marks Act 1994 (the Act), the Application was confusingly similar to STL's earlier UK and EU registrations for the mark MASTERCHEF for goods and services in classes 8, 9, 21, 29, 30, and 43;

2. Section 5(3), use of the mark would take unfair advantage of its reputation, and dilute the distinctiveness of the UK and EU MASTERCHEF registrations for entertainment and production services in class 41; and

3. Section 5(4)(a), use of the mark would lead to misrepresentation and cause damage because STL owned goodwill in the MASTERCHEF sign for entertainment services.

Subsequently, MYA sought to revoke STL's UK trade marks, No. 2596545 and 2596542, for MASTERCHEF in classes 29 and 30 (the Registrations) on the basis that the Registrations had not been put to genuine use in the UK in the five years since being registered. However, before the UK IPO rendered the revocation decisions, STL registered the 2017

MASTERCHEF Registration.

MYA counterclaimed that contrary to s3(6) of the Act, the 2017 MASTERCHEF

Registration should be declared invalid on the basis that STL

had applied for the mark in bad faith, simply to prevent MYA registering the Application, and had no intention of using the mark on the goods for which registration was sought.

DECISION ON INVALIDITY

The Hearing Officer (HO) held that the mark had not been filed in bad faith, and invalidity under s3(6) therefore failed. STL's evidence demonstrated that it had for some considerable time intended or wished to use its brand and registered trade marks upon foodstuffs, as a logical extension of its reputation in television programmes about cookery.

While STL recognised that the revocation actions would succeed, it still intended to exploit its reputation by finding a partner to push a line of ready meals and/or food boxes. It also wanted to protect its reputation by ensuring others did not use similar trade marks for foodstuffs, over which it would have no quality control and which could ultimately sully its reputation.

DECISION ON OPPOSITION

STL relied on the 2017 MASTERCHEF Registration, and the opposition succeeded under s5(2)(b) and s5(4) of the Act. The HO concluded that a likelihood of confusion existed as: (i) the Application covers identical or similar goods, and (ii) the marks are highly similar.

Further, STL's evidence demonstrated goodwill in the mark MASTERCHEF in respect of cookery television programmes in the UK. Use of MYA's mark upon foods and drinks would cause a misrepresentation to the viewers of STL's programmes, as they would consider the provision of food and drink to be a perfectly natural extension of STL's business.

The HO did not consider s5(3) but commented that given its previous findings it would no doubt have also found this ground to be successful too.

KEY POINTS

✦ A possible or contingent intention to use a mark in relation to goods/services covered by an application would normally be sufficient to prevent a finding of bad faith on the grounds of no intention to use a mark

✦ A person is presumed to have acted in good faith unless the contrary is proved. The standard of proof is on the balance of probabilities, but cogent evidence is required due to the seriousness of the allegation

MARK

UK APPLICATION
No. 3324139



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A dog-eat-dog decision

Rob White sums up the outcome for a brewery brand

Christopher Corbett (the Opponent)

owns UK trade mark No. 2147516 for the mark HAIRY DOG, filed in October 1997, in respect of services in class 42¹ for “provision of food and drink; catering, restaurant, public house, bar and wine bar services” (the Earlier Mark).

He opposed UK trade mark No. 3327909, filed in July 2018 by Hairy Dog Brewery Ltd (the Applicant), for the mark HAIRY DOG BREWERY for “craft beer” in class 32. The Opposition was based on the Earlier Mark under s5(2)(a) and (b) of the Trade Marks Act 1994. The Applicant put the Opponent to proof of use of the Earlier Mark.

The Opponent’s evidence showed use of the Earlier Mark over more than two decades for a family pub that offered food. The Applicant argued that the use had not been across the full specification of services. The Hearing Officer (HO) made an assessment as to what a fair specification would be, with reference to case law², rejecting the Applicant’s argument that “family pub-restaurant services” would be appropriate.

The HO felt that “family” went too far and “would strip the Opponent of protection for services which the average consumer would consider to belong to the same category as those for which the mark has been used.” Therefore, the HO concluded that a fair specification without artificial limitations would be “restaurant, public house and bar services”.

In applying the established test for s5(2)(a) from the CJEU in LTJ Diffusion SA, the HO felt that the additional word BREWERY was non-distinctive for “craft beers” but would not go unnoticed by the average consumer. As a result, the marks were not identical. The opposition under this ground failed.

In terms of s5(2)(b), it was clear that the distinctive and dominant components of the

respective marks were the words HAIRY DOG. In applying the established tests, the HO concluded that the marks were visually and aurally highly similar and conceptually very similar. The assessment therefore fell to comparing pub services against the “craft beer” goods. Applying the CJEU decision in Kurt Hesse³, the HO stated that complementarity is an autonomous criterion and can be the sole basis for a finding of similarity.

The Applicant then tried to differentiate “craft beer”, but the HO found this to be a category of beer that would be sold in pubs, which did not rule out at least a degree of complementarity. The goods/services were thus deemed similar to a medium degree.

The HO concluded that there would be a likelihood of at least indirect confusion, due to similarities found between the marks and the degree of similarity between the goods and services.

Although the outcome is not surprising, this case is a reminder that complementarity alone between goods/services can be enough for a court to find similarity. Further, a claim under s5(2)(a) will likely fail if a mark contains an additional, non-distinctive word.

1 These services would now be in class 43.
2 O/345/10; [2016] EWHC 3103 (Ch)
3 C-50/15 P (Kurt Hesse v OHIM)

KEY POINTS

- ✦ Complementarity between goods/services can be the sole basis for finding similarity
- ✦ When assessing evidence of use, although a specification can be reduced to particular categories, it would be unfair to make terms too precise
- ✦ With a s5(2)(a) claim, if one mark has an additional word, even if non-distinctive, the marks are unlikely to be considered identical

“
The HO felt that the word BREWERY would not go unnoticed by the average consumer



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Band on the run?

Sharon Kirby awaits a final answer

Mark Lee filed a UK registration for THE UB40 EXPERIENCE on 3rd September 2018, covering services including “arranging and conducting live entertainment events and musical group entertainment services”. Lee had been in a UB40 tribute band with Andrew Bagnall, who here was the Applicant for Invalidity under the Trade Marks Act 1994, s47(2).

Bagnall had set up the band with bassist Anthony Porter in 2013, claiming that all “members” aside from themselves were freelance musicians. When Porter left in July 2017, they later said he was merely on a break.

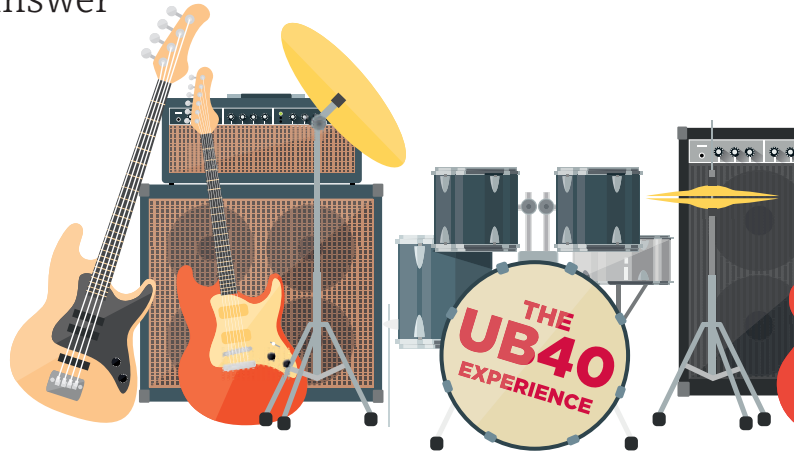
Lee joined in August 2017, he said, as a permanent replacement for Porter. He claimed that the band was managed as a collective, with all members on an equal footing. Lee’s position was that Bagnall was “sacked” in August 2018. Bagnall then set up a new band with Porter, which happened to use the same name. Bagnall’s action claimed both passing off and bad faith (stating that a key purpose of Lee’s filing was to prevent Bagnall from continuing to play under the name).

SHARED GOODWILL

Guided by SAXON¹, the Hearing Officer (HO) held that at the application date and in the absence of an agreement, there was a partnership-at-will. The goodwill generated by the regular performers would be shared among them in undivided shares. When Bagnall left, this effectively dissolved that partnership and a new partnership-at-will was then formed without Bagnall.

Nine days fell between the dissolution of the former partnership and the application date. Lee’s new partnership would not have acquired goodwill independently in that time. Bagnall did not consent to the new group taking the same name and did not give up his claim to goodwill. In using the same name for the same services, the new partnership would damage the former partnership’s goodwill, including by diverting bookings.

As a result, the former partnership was able to prevent the new partnership from doing so under passing off. The fact that the new partnership included members of the previous partnership made no difference,



as they are legally distinct entities. Hence the invalidation ground succeeded.

PRELIMINARY DECISION

However, the proceedings should not have been solely in Bagnall’s name, but by Bagnall on behalf of “the partnership that existed at 24th August 2018 and traded as The UB40 Experience”. The HO invited the Applicant to substitute himself in the proceedings if successful overall. The bad faith ground failed. The filing was carried out as part of a genuine commercial dispute.

This was a preliminary decision only. If the Applicant were substituted, the decision would be confirmed. Otherwise, it would be rejected. The proprietor could file submissions on whether the substitution should be allowed. At the time of writing, a final decision had not been issued.

In SAXON, it was clear that relevant former members had abandoned their goodwill in Saxon alone, which neatly allowed one party to claim the rights to the name. The situation here was not so clear. A suitably drafted partnership agreement may have avoided the stalemate.

1 [2003] EWHC 295 (Ch)

KEY POINTS

- + Bands without a contract form a partnership-at-will, with assets in undivided shares
- + Invalidation should be brought by the “original” partnership, not individual members



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Marketplaces may have cards marked

Blake Robinson believes Amazon may not escape future scrutiny

This article explores the implications of the CJEU's recent judgment in response to the preliminary reference request of the Bundesgerichtshof (Germany's Federal Court of Justice). When looking into the liability ramifications of the storage of infringing products by Amazon, the following question was referred to the CJEU, regarding the interpretation of Article 9(2)(b) of Regulation 207/2009 and Article 9(3)(b) of Regulation 2017/1001:

“Does a person who, on behalf of a third party, stores goods which infringe trade mark rights, without having knowledge of that infringement, stock those goods for the purpose of offering them or putting them on the market, if it is not

that person himself but rather the third party alone which intends to offer the goods or put them on the market?”

The CJEU's response to this question had the potential for severe ramifications for marketplaces such as Amazon. In the end, what we have now received from the CJEU is the result of a narrowly framed question, but may be a sign of future developments.

FAMILIAR CIRCUMSTANCES

The background to this case will be familiar to many brand owners. Coty Germany GmbH, as the licensee of the DAVIDOFF brand, became aware of infringing “Davidoff Hot Water Eau de Toilette 60ml” perfumes for sale on Amazon and sent a letter to the third-party seller requesting cessation of the sale of the goods. The goods, which were stored in the Amazon FC Graben warehouse as part of the Fulfilment by Amazon (FBA) scheme, were subsequently sent



“ Once a marketplace becomes aware of an infringement, it must act or face secondary liability

to Coty by Amazon. Some of the stock sent to Coty belonged to a different seller, and Coty requested disclosure of the name and address of this seller, which Amazon refused.

The FBA scheme allows members to store their wares at an Amazon warehouse. However, in the words of Amazon: “FBA helps your business grow while doing the heavy lifting for you”. Amazon can provide support in relation to storage, delivery, customer service, returns, pricing optimisation, business analytics and business recommendations, as well as boosting the visibility of products.

CLEAR RESPONSE

Coty argued that the FBA scheme in itself amounted to infringing use of a trade mark. However, Coty’s hurdle was showing use in relation to Amazon’s own commercial communication. The referring court accepted that the argument turned on whether a person who stores goods that infringe trade mark rights stocks those goods in order to offer them for sale, even if it is only a third party who intends to sell those goods.

The CJEU’s judgment offered a clear and unsurprising response to the question asked. The Court felt – in short – that what Amazon did, based on the question asked, was not use for the purposes of infringement. This is an issue that has been explored many times before, but in the end boils down to the fact that any infringing activity must be carried out in relation to one’s own commercial communications, not the creation of “technical conditions” necessary for a third party to use.

IMPLICATIONS

This decision is not necessarily a defeat for brand owners. The question referred by the German court was narrow, and significant aspects of Amazon’s fulfilment service were not scrutinised as a result.

Looking at the opinion of the Advocate General (AG), who explored the issue in a wider context, the potential implications are clear.

If the additional elements of the FBA scheme were scrutinised, it is likely that the issue of control and commercial communication would have been less problematic.

In fact, the answer to the question provided by the AG, in the context of the whole Amazon offering, is more favourable for brand owners. The AG felt that the Articles should be interpreted as follows:

- A person does not store for a third-party seller products infringing the rights of a brand for the purpose of their offer or their placing on the market when it is not aware of this infringement and when it is not itself but the third party which intends to offer the products or put them on the market.
- However, it is possible to consider that this person stores these products for the purposes of the third party’s offer or placing on the market if it is actively involved in their distribution, within the framework of a programme with the characteristics of the programme called Fulfilment by Amazon, to which the seller subscribes.
- The fact that this person is unaware that, under such a programme, the third party offers or sells the products that contravene the rights of the trade mark owner does not exempt him from his responsibility, when it can reasonably be expected for him to use the means at his disposal to detect this violation.

The AG also looked at the Directive on Electronic Commerce. He confirmed that under this directive, it is still the case that once the marketplace becomes aware of the infringement, it must act or face secondary liability. This is a confirmation that there are still clear steps to take regarding infringing content on marketplaces.

So, while this judgment may seem like a victory for Amazon, brand owners should not see this as a loss. It seems that there are still areas of the FBA scheme to be scrutinised, and if this is done, it is possible that a new route to enforcement on marketplaces could be established, if active involvement can be shown.

KEY POINTS

- This case does not end the possibility to bring Amazon into infringement actions in relation to products sold under its Fulfilment by Amazon scheme
- If you can find evidence of a marketplace’s active involvement in the sale of infringing products, it is possible that said marketplace could also be liable for infringement
- Under the Directive on Electronic Commerce, marketplaces are obligated to remove infringing content once they have been notified of it



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Link puts an end to lengthy dispute

Gavin Stenton reports on Gugler France's decade-long campaign

On 7th February 2002, Gugler France was registered in the commercial and companies register of Besançon, France. The company, acting as a distributor in France, managed the sale and installation of doors and windows produced and assembled by a German entity, Gugler GmbH. On 6th July 2002, Gugler GmbH acquired 498 shares in Gugler France.

On 25th August 2003, Gugler GmbH filed an application for a Community trade mark (CTM) under Regulation No. 40/94 for the mark shown below, in classes 6, 17, 19, 22, 37, 39 and 42. This mark (the Contested Mark) proceeded to registration on 31st August 2005 (No. 3324902).

“ The economic link between the two parties precluded a finding of likelihood of confusion ”

The Contested Mark was later assigned to A Gugler, an employee of Gugler GmbH and the son of its Managing Director, K Gugler.

On 24th August 2010, Gugler GmbH, K Gugler and A Gugler brought proceedings against Gugler France in France for infringement of the Contested Mark and sought damages of €5m.

In response, on 17th November 2010, Gugler France filed an application for a declaration of invalidity against the Contested Mark claiming, first, that the Contested Mark had been filed in bad faith within the meaning of Article 52(1)(b) of Council Regulation No 207/2009 (the Regulation) and, second, that under French law Gugler France's company name allowed it to prohibit use of the Contested Mark within the meaning of Article 53(1)(c) of the Regulation, read in conjunction with Article 8(4).

Under Article L711-4 of the French Intellectual Property Code, “signs may not be adopted as trade marks where they infringe earlier rights, in particular... a company name

or corporate name, if there is a likelihood of confusion on the part of the public”.

INITIAL DECISIONS

The Cancellation Division (CD) upheld the application for invalidity, finding that Gugler France's company name had been used in the course of trade (of more than mere local significance) prior to the Contested Mark's filing date and that, according to French law, Gugler France's company name conferred on it the right to prohibit the use of the Contested Mark. Having found in favour of Gugler France on this ground, the CD did not consider the second ground for invalidity relating to bad faith.

On appeal by A Gugler, the Fourth Board of Appeal (BoA) annulled the CD's decision and dismissed the invalidity application, finding that Gugler France had not established a prior right that enabled it to prohibit the use of the Contested Mark.

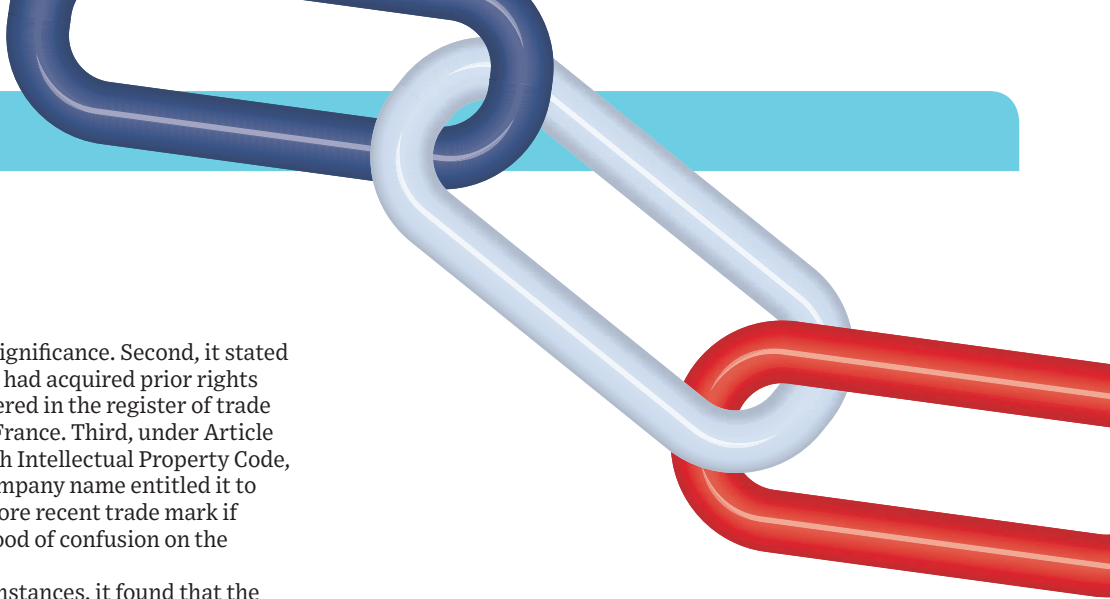
Further, Gugler GmbH was not considered to be acting in bad faith when it filed the application for the Contested Mark. The BoA's view was that filing an application for registration of a CTM was an obvious and completely justified action because Gugler GmbH “had had an active business producing, selling and exporting doors and windows under the name GUGLER for many years”.

NEXT STEPS

On appeal by Gugler France, the General Court (GC) annulled the Fourth BoA's decision on the basis that it had not stated the correct reasoning when it ruled on both grounds of invalidity.

When revisiting the case, the First Board of Appeal (First BoA) upheld the application for a declaration of invalidity of the Contested Mark on the basis of Article 53(1)(c) of the Regulation, in conjunction with Article 8(4).

It found that Gugler France's company name had been used in the course of trade with more



than merely local significance. Second, it stated that Gugler France had acquired prior rights when it was registered in the register of trade and companies in France. Third, under Article L711-4 of the French Intellectual Property Code, Gugler France’s company name entitled it to prohibit use of a more recent trade mark if there was a likelihood of confusion on the part of the public.

Under the circumstances, it found that the Contested Mark and the earlier sign were highly similar, the contested goods and services were identical or similar to the activities of Gugler France and there was therefore a likelihood of confusion, meaning that the conditions set out in French law for prohibiting the use of the Contested Mark were satisfied.

THE GC’S DECISION

Next, A Gugler sought annulment of the First BoA’s decision, alleging that it had incorrectly assessed the conditions of Article 8(4) of the Regulation and incorrectly assessed the likelihood of confusion.

The GC found that, at the filing date, business relations existed between Gugler France and Gugler GmbH. Gugler France was the distributor of Gugler GmbH’s goods in France, their business relationship dated back to 2000 and Gugler GmbH had held 498 shares in Gugler France since July 2002.

Further, in 2003, Gugler GmbH formed, with French partners (some of whom were founders of Gugler France), Gugler Europe SA, which has been the proprietor of the French figurative mark GUGLER since 28th August 2003, and that Gugler Europe had granted a licence for that mark to Gugler France.

In light of these factual circumstances, the GC held that, as Gugler France was distributing Gugler GmbH’s goods, consumers would believe that the goods in question came from economically linked undertakings, and there would be no error as to their origin and thus no scope for confusion.

As such, it held that the First BoA had erred in finding that there was a likelihood of confusion, since the economic link between

“ *The fact that Gugler France also sold third-party goods was irrelevant* ”

Gugler France and Gugler GmbH precluded such a finding. Consequently, it annulled the First BoA’s decision.

THE FINAL CHAPTER

Gugler France appealed the GC’s decision, alleging infringement of Article 8(1)(b) and (4) of the Regulation and of Article L711-4 of the French Intellectual Property Code, reasserting its claim that there was a likelihood of confusion between the Contested Mark and its company name.

The CJEU nevertheless upheld the GC’s decision, holding that, at the filing date, there was a veritable economic link between Gugler GmbH and Gugler France SA because the goods in question were manufactured by Gugler GmbH and, since July 2002, Gugler GmbH had held 498 shares in Gugler France.

In doing so, it rejected Gugler France’s argument, based erroneously on *Schweppes SA v Red Paralela SL*¹, that the GC should have assessed the economic link only from Gugler France’s perspective, as the prior right owner. According to the CJEU, an economic link does not have to originate with one party. Further, the fact that Gugler France also sold third-party goods did not in any way detract from the fact that there was an economic link between it and Gugler GmbH.

¹ C-291/16

KEY POINTS

✦ Likelihood of confusion is unlikely to be established where an economic link exists between the relevant parties, irrespective of the source of the link

✦ The sale by a distributor of third-party products in addition to those of the brand owner does not detract from the existence of an economic link between the brand owner and distributor

✦ Brand owners and their distributors should carefully document the legal terms of their relationship, paying particular attention to the use and registration of IP rights both during the term of the contract and following its expiry/termination

MARK

THE CONTESTED MARK



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Firm guidance on “wobble” questions

Luke Portnow is keen to see how a Supreme Court decision will be deployed

April saw the CJEU revisit the issue of the registrability of 3D shape marks. In answer to questions referred by the Hungarian Supreme Court, we have been given welcome clarifications on how the aesthetic and technical functionality of 3D shape marks should be assessed when determining registrability.

ENGINEERING ODDITY

In 2015, Gömböc Kutató, Szolgáltató és Kereskedelmi Kft (Gömböc) applied to register the sign shown below in classes 14, 21 and 28 (decorative items, crystal ware and chinaware, toys). The shape was created by two Hungarian engineers and is the first known homogenous object with only two points of equilibrium. Lacking a counterweight, it always returns to its initial position on a horizontal surface. In other words, it “wobbles around” and then returns to its original position.

Examination of the application by the Hungarian IPO, at that time, mirrored Article 3 of EU Directive 2008/95 (now Article 4 of EU Directive 2015/2436), which deals with absolute grounds of refusal.

Registration is prohibited under Article 4(e) for signs which consist exclusively of: (i) the shape, or another characteristic, which results from the nature of the goods themselves; (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result; and (iii) the shape, or another characteristic, which gives substantial value to the goods.

The Hungarian IPO refused registration for the goods in class 28 on the basis of point (ii) and in classes 21 and 14 on the basis of point (iii). It focused on evidence relating to Gömböc’s website, the publicity the product had received and how this would be perceived by the average consumer. Put simply: for toys, the shape was deemed necessary to obtain a technical result, as it allowed it to function as a toy, always returning to its point of stable equilibrium. For the decorative goods, the shape was a “striking



and attractive shape, deemed an essential element in the marketing of the goods in question”, giving substantial value. The Hungarian IPO found that consumers buy decorative items mainly for their shape.

Gömböc appealed all the way to the Hungarian Supreme Court, at which point the CJEU was asked questions which can be summarised as:

- In determining whether a shape is necessary to obtain the technical result, do we rely only on its graphic representation in the application, or can the perception of the relevant public also be taken into account?
- Do we determine that a 3D mark should be refused registration because its shape alone gives substantial value to the goods, only by taking into account the perception or knowledge of the buyer, when looking at how the mark is graphically represented?
- Also, when assessing substantial value, do we automatically refuse registration if the sign already enjoys protection as a Registered Design, or only focus on the aesthetic appearance which gives the product a certain value?

“ *It now appears that pretty much anything can lend a shape substantial value* ”

The Hungarian referral highlighted some important issues in relation to examining solely on the basis of a trade mark’s representation. Should the perception of the relevant public be taken into particularly close consideration if the product has become well known? And what if additional information is needed, as the “technical result” cannot always be ascertained from the shape’s graphic representation on the application form?

CJEU DECISION

The introductory wording of the CJEU’s ruling appears to accept that its recent case law had not removed all doubt on how to assess registrability. And we now have some welcome clarity resulting from the CJEU’s answers (again provided in summary).

1. To establish whether a sign consists exclusively of the shape of goods necessary to obtain a technical result:

- a) assessment is not limited to graphic representation on the application form;
- b) this is a two-stage process in which the competent authority identifies the shape’s

essential characteristics and then establishes whether they perform a technical function;

c) to establish the essential characteristics of the sign, the perception of the relevant public can be used; and

d) to ascertain whether a shape’s characteristics perform a technical function of the goods, other information may be used – but must only originate from “objective and reliable sources” (eg, not the average consumer, but experts and scientific publications, for example).

2. To determine that the shape alone gives substantial value to the goods:

- a) characteristics not connected to the shape (the technical function/qualities or reputation) must be irrelevant;
- b) following Hauck¹, the perception of a sign by the average consumer can be used;
- c) the fact that a sign is the shape of a decorative item does not mean this ground of refusal should be automatically applied; and
- d) registration should be refused if it is apparent from objective and reliable evidence that the decision to purchase the product in question is determined by the essential characteristics of the shape.

3. The fact that a shape is protected as a Registered Design should not automatically attract a refusal, as “the legal regimes concerning the registration of designs and trade marks are independent, without any hierarchy”.

GOING FORWARD

The CJEU’s answers provide clarity that “technical function” and “substantial value” of shape marks should be considered, and relevant grounds for refusal raised, ultimately on an objective basis. It suggests that substantial value may be found in this case (in light of the perception and knowledge of the relevant public), in that the shape is the tangible symbol of a mathematic discovery.

After Hauck, and now this, it appears that pretty much anything can lend a shape substantial value. But at least we know how the sign will be examined to arrive at such a decision. It will be interesting to see how the Hungarian Supreme Court applies the CJEU’s answers.

¹ C-205/13



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KEY POINTS

- Technical function should be assessed from the perspective of relevant experts
- Registration should not be refused simply because a sign consists exclusively of the shape of a decorative item
- The existence of Registered Design protection is not fatal and does not prevent a shape from also obtaining protection as a trade mark

MARK

THE GÖMBÖC SIGN



BoA isn't backed up

Vishal Dattani looks closely at an eye-opening decision

On 5th March 2020, overturning an earlier decision from the Board of Appeal, the General Court (GC) found no likelihood of confusion on the part of the relevant public between the marks **BACKEYE** and **CORNEREYE** for identical goods.

EARLIER ACTIONS

It was back on 3rd March 2016 that Exploitatiemaatschappij de Berghaaf BV (the Applicant) filed an application to register EU trade mark **CORNEREYE** in class 9 in relation to: “Cameras; monitors; apparatus for the recording and reproduction of images; data-processing apparatus”. The mark was opposed by Brigade Electronics Group plc (BEG) under Article 8(1)(b) of Regulation 2017/1001 (likelihood of confusion), relying on its EU trade mark **BACKEYE** in class 9 for: “Closed circuit television apparatus comprising television cameras and television monitors, all for mounting on vehicles or mobile apparatus, and for use in assisting drivers in manoeuvring, parts and fittings for the aforementioned goods; all goods in class 9”.

The Opposition Division upheld the initial opposition and therefore refused registration of the mark. The Applicant’s subsequent appeal was dismissed by the Board of Appeal (BoA) in the contested decision of 24th July 2018, when it had concurred with the EUIPO’s decision.

The Applicant then filed an action before the GC, relying on two pleas in law:

- i) Infringement of Article 95(1) EUTMR; and
- ii) Infringement of Article 8(1)(b) EUTMR.

The GC rejected the first plea since its purpose was to establish infringement of the principle in Article 95(1) EUTMR. The Applicant’s arguments, in seeking solely to establish that the BoA did not correctly assess evidence of use of the earlier mark in relation to its enhanced reputation, were ineffective in this context.

COMPARISON OF THE SIGNS

In comparing the signs, the GC found that the relevant public would “perceive the signs at issue as a juxtaposition in one word of two inherently weak elements, each of which is descriptive, or at least evocative, of the essential characteristics of the goods concerned”. It held that the marks coincide visually and aurally in relation to “eye” but differ in relation to “back” and “corner”, noting that the first part of a mark generally has a greater visual impact. The additional syllable of the opposed mark would also result in more stress being placed on the beginning of the sign in terms of pronunciation.

As to the conceptual comparison, the GC found that, while “back” and “corner” can both refer to the position of a camera on a vehicle or to the concept of the field of vision, they do not convey the same concept. This was contrary to the BoA’s view that these elements had conceptual similarity to an average degree, both indicating distance and being semantically connected. The GC agreed with the Applicant, who maintained that the term “back” differed conceptually because it would be understood by consumers as referring to something situated behind or in the rear, while “corner” refers to a blind

corner. As such, the BoA should have found that these elements are conceptually dissimilar.

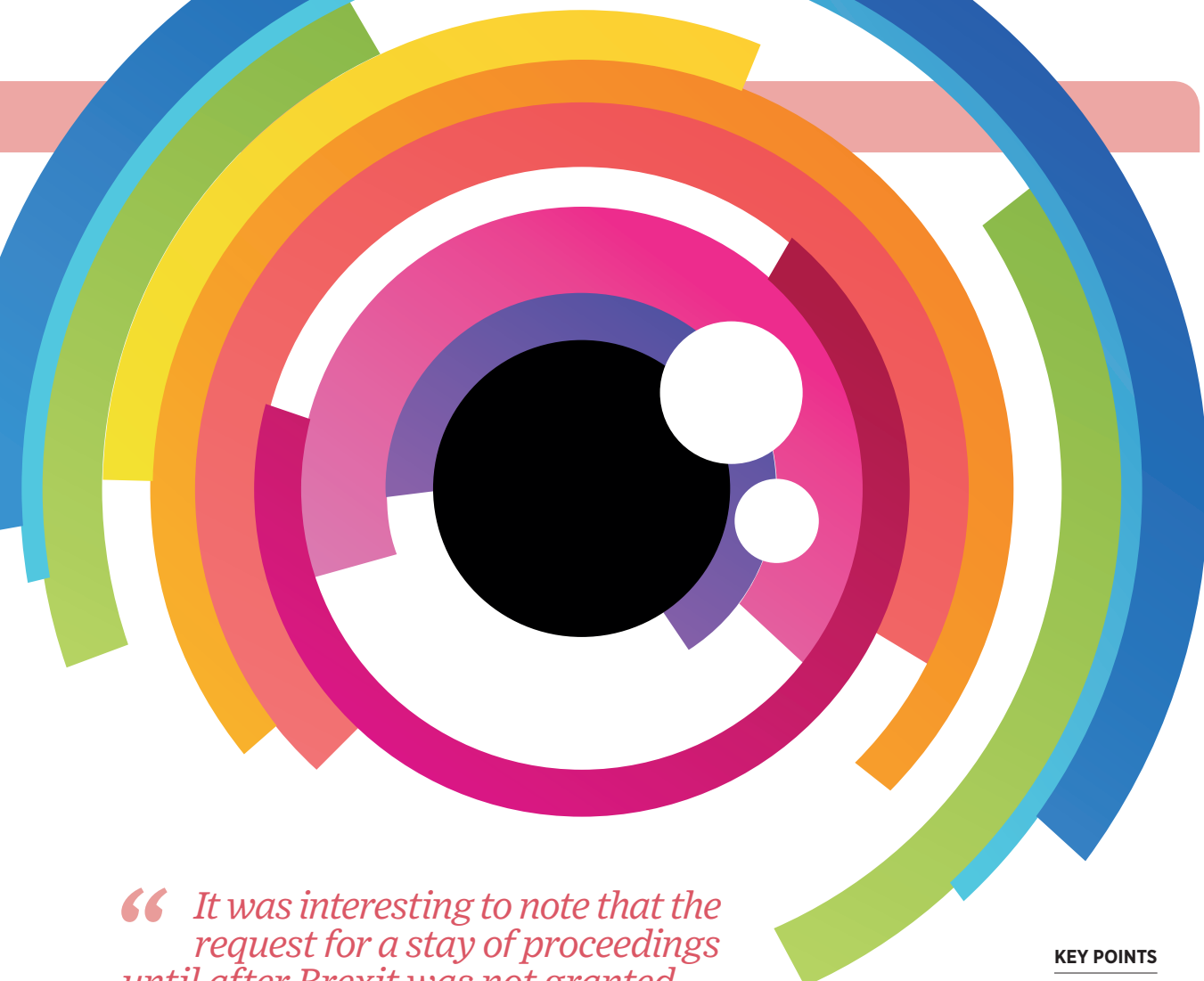
In addition, the BoA erred in the contested decision by taking account of the words “back” and “corner” as they relate to distance for the purposes of a visual and phonetic

comparison, a point that the EUIPO itself acknowledged at the hearing.

ASSESSMENT ERROR

In relation to the component “eye”, the GC agreed with the Applicant, finding that it will be perceived by the relevant public as referring directly to the function of the goods at issue, namely to facilitate vision while driving by way of a camera. It is therefore descriptive

“ The decision reminds us that particular care must be taken when comparing inherently descriptive marks



“ *It was interesting to note that the request for a stay of proceedings until after Brexit was not granted* ”

of an essential characteristic of the goods. The mere presence of this descriptive element does not automatically imply that the signs are visually, aurally and conceptually similar.

There was therefore no dominant element to the signs and each element was held to be descriptive of the goods in question, or at least one of their characteristics. When comparing each element of the signs separately and as a whole, it was not possible to conclude that there was a similarity between the signs.

In conclusion, the BoA was wrong in its overall assessment in finding that there would be a likelihood of confusion among the relevant public. The GC found no similarity between the marks due to the element in common – “eye” – being descriptive, its position at the end of the marks and the resulting lack of visual and phonetic similarity between the signs. These visual differences cannot be offset by any degree of conceptual similarity, since the terms “back” and “corner” have different meanings.

This finding was not affected by BEG’s submissions that its mark had acquired enhanced distinctiveness through use.

A BREXIT TWIST

The decision reminds us that particular care must be taken when comparing inherently descriptive marks. If the signs coincide only in non-dominant, descriptive and non-distinctive elements, and are dissimilar in other aspects, even though the goods are identical, other factors such as the weak distinctive character of the earlier mark, the low degree of visual and aural similarity, and conceptual dissimilarities between the marks may be sufficient to exclude a likelihood of confusion.

It was interesting to note that the Applicant’s request for a stay of proceedings until the EU Treaty and FEU Treaty cease to apply to the UK was not granted. This further adds to the uncertainty of Brexit. Watch this space.

KEY POINTS

- +
- The presence of shared descriptive elements does not automatically mean two signs will be visually, aurally or conceptually similar
- +
- Even if an earlier mark is considered to have acquired enhanced distinctiveness through use, if the signs are different overall because there is no degree of similarity, there cannot be a likelihood of confusion on the part of the relevant public



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Four and oh...

Charlotte Wilding explains why Armani was left counting the cost despite a quartet of arguments

Giorgio Armani SpA (Armani) filed an EU trade mark registration for the figurative sign shown below in classes 18 and 25 on 29th December 2014. Felipe Domingo Asunción opposed on the basis of a likelihood of confusion (under Article 8(1)(b) EUTMR) with his earlier Spanish registrations for LESAC in class 18, and in classes 25 and 35.

Armani put Asunción to proof of use, but the Opposition Division found genuine use in class 35, so the opposition was successful. Armani's appeal was dismissed on 13th August 2018. Armani then appealed to the General Court (GC) either to alter the decision by finding that the appeal was well-founded or to annul the decision. Armani's first claim was dismissed because the power to alter a decision is provided only so that the GC can adopt the decision that the Board of Appeal (BoA) ought to have taken. As the BoA does not have the power to decide on the registrability of an application, neither can the GC.

ANNULMENT CLAIM

In support of its second claim, Armani argued four points:

1. Infringement of Article 94(1) EUTMR due to the BoA having found, without giving the parties opportunity to comment, that the earlier trade mark had been put to genuine use in class 35.
2. Infringement of Article 8(1)(b) EUTMR as regards the scope of protection in class 35. The EUIPO erred, it said, in finding that the services protected were "retail sales services

in relation to handbags, purses and wallets made from leather, ready-made clothing and footwear" and not the broader term registered, "retail sales services", for which Armani said there was no use.

3. Infringement of Articles 18 and 47(2) EUTMR, as the evidence of use was not sufficient and that there were instances of use of a different mark (shown below).

4. Infringement of Article 8(1)(b) EUTMR, regarding the existence of a likelihood of confusion among the relevant public.

POINT BY POINT

The first point was dismissed as the right to be heard under Article 94(1) EUTMR extends to factual and legal matters, not to the final position that the authority intends to adopt. The second was also dismissed, on the basis that the original specification was not too broad at the time of filing and it is appropriate to hold that use of a mark in respect of a limited range of retail services is sufficient to maintain the whole term.

As regards point three, the GC found the evidence of use sufficient. Further, it noted that "it must be borne in mind that graphic additions are a common practice in trade, in particular in the fashion sector, and tend to establish that the commercial exploitation of the mark in question is real".

Armani argued that both the number 11 and knowledge of "le sac", meaning "bag/garment" in French, were important factors in distinguishing the marks. However, the GC held that the Spanish public would not have sufficient knowledge of French. Also, the marks' average to high degree of similarity, coupled with similarity between the goods/services, meant that there was a likelihood of confusion.

The appeal was dismissed and Armani was ordered to pay costs.

KEY POINTS

✦ Knowledge of a foreign language is not automatic and evidence that the relevant public would understand the terminology is needed

✦ Genuine use of a mark in respect of a restricted range of goods/services may be sufficient to maintain the broader term

MARKS

THE ARMANI MARK

le Sac
11

THE EARLIER SPANISH REGISTRATION

lesac

THE ADDITIONAL MARK


LESAC
-St. Tropez 1984-



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Miley not so smiley

David Yeomans summarises one of the latest name-related disputes



An EU trade mark application by Smiley Miley Inc (SMI) to register the mark MILEY CYRUS in classes 9, 16, 25, 28 and 41 was opposed by Cyrus Trademarks Ltd (CTL) on the basis of a claimed likelihood of confusion with the figurative CYRUS registration (shown right), protected for various goods in classes 9 and 20.

SMI argued that because Miley Cyrus is a famous American singer, the marks are sufficiently distinguishable conceptually. The Opposition Division (OD) did not agree, deeming the marks to be confusingly similar. The opposition was dismissed in relation to class 25 on the basis that the respective goods were dissimilar. However, it succeeded in relation to the majority of the other goods and services applied for. SMI then appealed to the Board of Appeal (BoA).

OD ERROR?

In its appeal, SMI claimed that the OD had erred in deeming the marks confusingly similar. It supplemented its arguments that MILEY CYRUS is highly distinctive with evidence in the form of internet pages and images from social media. It contended that the marks were conceptually different since the earlier mark would be seen as a reference to Cyrus, a Persian king, and the mark applied for was a reference to Miley Cyrus, the American singer.

The Board of Appeal (BoA) rejected SMI's arguments. It stated that the marks would not be perceived as names and that, even if they were, it would not assist SMI because the element MILEY is more common and therefore less distinctive than the element CYRUS. Accordingly, consumers may believe that MILEY CYRUS is the full name of Cyrus, or, conversely, that CYRUS is the mark belonging to Miley Cyrus where the first given name has

simply been omitted. The BoA determined that in each of these examples the respective marks would refer to the same perceived name – in other words, have the same commercial origin.

The BoA also dismissed SMI's arguments regarding the distinctiveness of MILEY

CYRUS. While the Opponent's mark may benefit from enhanced distinctiveness through use or reputation, in opposition proceedings the Applicant's mark cannot. This is because, according to EUIPO practice, when considering whether or not a trade mark

application falls foul of any of the relative grounds for refusal, events or facts that arose before the filing date cannot be used in support of the application.

NO RIGHT TO REGISTER

This case illustrates that in EU opposition proceedings the distinctiveness of the mark applied for cannot be more than normal, even if it relates to a famous person. It is also a reminder that an applicant may, in certain circumstances, have the right to use their own name in commerce, notwithstanding a conflicting third-party registration. However, this is not relevant in assessments of a likelihood of confusion because it does not extend to a right to register a personal name.

“
The right to use your name in commerce does not extend to a right to register”

KEY POINTS

- + The Applicant could not rely on fame or reputation
- + A right to use a personal name does not equate to a right to register it as a trade mark

MARK

THE CTL
TRADE MARK




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USA not A-OK

Laurie Bray explains why a famous festival failed to prove EU use of its mark



This case concerns a non-use revocation action filed by winery Bodegas Vinos de Leon against EU trade mark registration No. 5832712 for the mark COACHELLA, owned by AEG Presents Ltd (AEG). The action succeeded against all of the goods and services bar a small number of class 41 services, on the basis that AEG had failed to provide sufficient evidence of use. Despite AEG's mark being used in relation to one of the world's most famous music festivals, the Cancellation Division (CD) found that the majority of the evidence did not demonstrate use within the EU.

ASSESSMENT OF EVIDENCE

The registration covered a range of goods and services in classes 9, 16, 25, 35 and 41. AEG filed a substantial amount of evidence, primarily relating to its operation of the Coachella music festival, which takes place annually in California and attracts revellers from all over the world, including from the EU.

The CD evaluated each of the relevant factors for assessing genuine use, the crucial one in this instance being the place of use. Despite AEG's arguments and evidence demonstrating that a large number of EU consumers attend the festival each year, the CD pointed out that use in respect of services is considered as taking place outside the relevant territory if the user can only take advantage of the services by visiting a place outside the EU.

The fact that consumers from the EU could book and attend the festival was irrelevant, since the services themselves were provided only in the US. The CD therefore found that use of the mark in relation to the organisation and production of a festival in California does not constitute genuine use within the EU, and held that AEG had failed to prove use in relation to the majority of the class 41 services.

Turning to the goods in classes 9, 16 and 25, despite some evidence of use in relation to

merchandise, the CD found that the evidence was insufficient as it did not show to what extent such goods had actually been sold to EU consumers. The CD also gave short shrift to the evidence in respect of class 35 services, pointing

out that advertising one's own goods and services does not constitute the provision of advertising and promotion services.

The revocation action failed, however, in respect of a small number of class 41 services. AEG had been able to show use of the mark

COACHELLA in respect of online music broadcasting, which was available from the EU and watched by millions of EU-based viewers. The CD therefore considered that sufficient use had been shown in relation to such services.

PRIOR NATIONAL DECISION

AEG also referred to a decision of the Spanish Trade Mark Office in which its COACHELLA mark was held to be a "notoriously well-known trade mark". However, while such decisions should be given due consideration, in this instance the Spanish decision was deemed irrelevant since the CD did not have access to the evidence filed before the national office.

“
Advertising one's own goods and services does not constitute the provision of advertising and promotion services”

KEY POINTS

- ✦ Provision of services that can only be accessed by visiting a place outside the EU will not constitute use of an EU trade mark, even if EU consumers can make their initial purchase or booking from within the EU
- ✦ Evidence of genuine use must show the place, time, extent and nature of use
- ✦ Prior decisions of EU national offices should be taken into consideration by the EUIPO if relevant, but may be of limited value



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See Yoo later

Appeal goes the wrong way for a WeWork competitor, says Laura Robyn

This case relates to an opposition against an EU trade mark application to register YOO@WORK for office and business services and workspace rental services in classes 35 and 36, filed by Yoo Holdings Ltd (the Applicant). The Opponent, WeWork Companies Inc (WeWork) relied on its earlier EU trade mark for WEWORK, covering classes 35 and 36, arguing both a likelihood of confusion and damage to the reputation in that mark.

Notwithstanding the identical and closely similar services and a finding that consumers are likely to pay a high level of attention, the Opposition Division (OD) rejected the opposition. The marks were similar only to a very low degree visually and aurally, mainly due to the differing word elements at the start of each mark. This excluded a likelihood of confusion. The OD also held that evidence of favourable references to WEWORK in press articles is not sufficient to show the requisite degree of recognition to establish a reputation.

ARGUMENTS ON APPEAL

The Opponent appealed, alleging that: (1) the OD failed to take into account the evidence, which should lead to a finding of enhanced distinctive character; (2) the word element YOO would not be perceived by the English-speaking consumer as a Korean surname; and (3) the OD was wrong to find no reputation.

The Applicant sought to dismiss the appeal, arguing that: (1) YOO has multiple meanings; (2) the YOO brand has a considerable reputation for residential and hotel design; (3) the strong Korean community in the EU bears relevance to the OD's decision; (4) the inherent distinctive character of the WEWORK mark is weak, and; (5) the Opponent's physical presence in just four EU Member States is not sufficient to establish a reputation.

Finding identical and closely similar services, the Board of Appeal (BoA) confirmed that the assessment should focus on the English-speaking public and the relevant business customer. It disagreed with the OD, however, noting first that there is "a considerably larger part of the relevant public" which does not form part of the EU's Korean community, and second, that while

the co-working-related services can involve large sums of money, they can also be offered for very short periods of time. The level of attention is therefore only average.

Comparing the marks, the BoA disagreed with the OD's finding that YOO will be read by the relevant consumer as a Korean surname. It will be perceived either as meaningless, or more likely as the pronoun "you". On this basis, the BoA found a low degree of visual similarity, a slightly higher degree of phonetic similarity and, construing the marks as meaning "We work" and "You at work", some conceptual similarity.

Taking into account both the Opponent's "old" and new evidence, the BoA concluded that although the earlier mark is inherently very weak for the English-speaking public, the Opponent has demonstrated enhanced distinctiveness in the UK. The Applicant's assertion that the YOO brand has a reputation was dismissed as irrelevant.

STRENGTHENED SIMILARITY

Taking into account the identical and closely similar services, the BoA concluded that the conceptual similarity "further strengthens the overall similarity" of the marks. Paired with the enhanced distinctiveness for most of the services at issue in the UK, this gives rise to a likelihood of confusion. The opposition therefore succeeded and there was no need to consider the reputation claim.

KEY POINTS

- ✦ For marks low in inherent distinctiveness, demonstrating enhanced distinctiveness can be sufficient to push them over the line to a finding of a likelihood of confusion, even if only in one EU Member State
- ✦ A degree of conceptual similarity can be sufficient to offset a low degree of visual and aural similarity
- ✦ Reputation of the contested mark is not relevant in opposition proceedings



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One sparkling victory

Champagne made a great showing, Francesco Simone reports

On 16th March 2017, Bredway (the Applicant) filed an application to register the word CHAMPAGNOLA as an EU trade mark. The application initially covered bakery goods in class 30, bakery services in class 40 and services for the provision of food in class 43. Comité Interprofessionnel du Vin de Champagne (the Opponent) filed an opposition on the grounds of Article 8(4)(a), now Article 8(6) EUTMR, based on the Protected Designation of Origin (PDO) for Champagne, protecting wine by virtue of Regulation No. 1308/2013 (the Wines Regulation). Class 43 was then removed from the application following a parallel successful opposition.

The Opposition Division (OD) was satisfied that the extensive evidence filed by the Opponent proved that Champagne has an outstanding reputation, but the opposition was ultimately rejected. The OD's reasoning was that the word CHAMPAGNOLA does not evoke the PDO Champagne and that the contested goods and services are not comparable to wine. The Opponent appealed the decision.

DECISION

In assessing Article 8(6) EUTMR, the Board of Appeal (BoA) clarified that, as a result of the combined application of Articles 102 and 103 of the Wines Regulation, when an application is filed for goods and services that are not comparable to wine, registration of the contested sign must be refused if it constitutes a misuse, imitation or evocation of the PDO, where the PDO has a reputation and use of the contested sign would exploit that reputation. The BoA stated that the test for exploitation of a reputation is in essence that outlined in Article 8(5) EUTMR. On this point, the BoA explicitly criticised the OD's reasoning for misconstruing the provisions of the Wines Regulation.

Evocation of a PDO under the Wines Regulation covers a situation where the contested sign triggers in the consumer's mind the image of the protected product.¹ As the contested sign was likely to be perceived as a derivative form of Champagne, this was found to be an evocation of the PDO.

The Opponent's evidence successfully proved the reputation of Champagne, due in particular to the "immense sales figures", export figures and publications. The Opponent also proved that bakery goods can be flavoured or simply consumed together with Champagne wine.

The BoA held that it is sufficient that the average consumer will get the impression of a vague connection with Champagne and found that there is exploitation of the PDO's reputation. The application was therefore rejected in its entirety.

WEIGHT OF REPUTATION

The key factor that tipped the balance in favour of the Opponent was Champagne's enormous reputation. It is often a paradox of highly reputed brands that they can take their reputation for granted and fail to prove its weight in trade mark proceedings. In this case, however, the Opponent properly supported its reputation claim with extensive evidence.

This decision is also a clear warning to trade mark applicants that even a vague connection with a reputed PDO may be fatal to the registration of a trade mark.

¹ C-87/97, at 25

KEY POINTS

✦ Under the Wines Regulation, the scope of protection of a PDO extends to products which are not comparable to wine when use of the contested sign would exploit the PDO's reputation

✦ The test for exploitation of a PDO's reputation under the Wines Regulation applies in the same way as the provision in Article 8(5) EUTMR

✦ "Evocation" of a PDO under the Wines Regulation applies where the contested sign triggers in the consumer's mind the image of the protected product



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Calendar

Our upcoming events for members,
plus other IP events of interest

DATE	EVENT	LOCATION	CPD HOURS
15th September	CITMA Webinar Copyright	Online	1
17th September	CITMA Webinar Online enforcement	Online	1
28th September	CITMA Webinar EU case law update	Online	1
29th September	CITMA Live Mock CMC & Hearing <i>Inter partes</i> proceedings with the UK IPO	Online	3
30th September	CITMA Paralegal Seminar Part 1	Online	1.5
2nd October	CITMA Paralegal Seminar Part 2	Online	1.5
15th-16th October	CITMA Autumn Conference	Online	5
12th November	CITMA Webinar SkyKick	Online	1
16th-22nd November	Careers in Ideas Week	Various	
24th November	CITMA Webinar UK case law update	Online	1
4th December	CITMA Christmas Lunch	London	

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THE TRADE MARK 20

Q&A



Cara McGlynn

finds brand ingenuity inspiring

I work as... a Senior Solicitor in the intellectual property disputes team at Brodies LLP in Edinburgh.

Before this role, I was... a Trainee Solicitor and worked in the IP department as part of my training.

My current state of mind is... positive. The sun is shining and I did lots of DIY at the weekend that I had been putting off for ages.

I became interested in IP when... I was at university, although unfortunately I did not have the opportunity to take an IP module. When I got the chance to work in the IP department as part of my traineeship, I jumped at it and never looked back.

In my role, I most enjoy... how diverse IP is. It covers such a broad spectrum of rights and interests, and I love working with people across all industries.

In my role, I most dislike... time recording.

I am most inspired by... the creativity of brands, from the new names that are bringing something fresh to the market to those that have been around for decades and are still evolving.

The talent I wish I had is... the ability to play guitar. I have tried and failed to learn many times.



“

IP covers such a broad spectrum of rights and interests

On my desk right now is... my laptop, headset, water bottle and hand cream. Like most people, I've been working from home recently so I've set up a makeshift workspace in my flat.

My favourite mug says... nothing. But it is a travel mug as I'm trying to be more sustainable with my takeaway coffee habit.

The biggest challenge for IP is... ensuring rules and legislation evolve to keep up with advancements, particularly in technology. Also, ensuring that rightsholders have appropriate protections and powers.

My favourite place to visit on business is... a client's premises. It's nice to meet face-to-face and see the inner workings of their business.

If I were a brand, I would be... Ray-Ban. You can't beat a good pair of sunglasses, and Ray-Ban makes timeless products of great quality.

I can't live without... cheese.

My ideal day would include... sunshine, good food and nice wine, all enjoyed with friends and family. Hopefully it's something we can do safely soon.

In my pocket is... my phone.

The best piece of advice I've been given is... trust your gut.

When I want to relax I... go for a wander in the Scottish countryside. You can't beat the fresh air and the beautiful scenery.

In the next five years I hope to... continue to develop professionally and travel more. I was hoping to tick off 30 countries before I turn 30 next year, but I still have a few to go and with COVID-19 I might have to make it 40 before I turn 40.

The best thing about being a member of CITMA is... the support within the community. I've only recently become a CITMA member and I've felt so welcome.



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