

# CITMA REVIEW

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ROYAL  
REGISTRATIONS  
P13

EMPLOYMENT  
AND IP RIGHTS  
P18

ITALY: AN  
IP UPDATE  
P22

## A QUESTION OF PRIDE

*Has an iconic symbol lost  
some of its power?*





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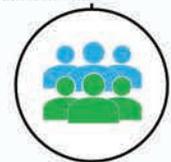
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# CONTENTS

08



## REGULARS

**04** **Insider** CITMA news and updates of interest

**41** **Calendar** Forthcoming learning and social events

**42** **TM20** Lee Curtis, HGF

## FEATURES

**06** **IP Inclusive**  
Your help is needed to increase diversity in the IP profession

**08** **Pride**  
Has success eroded the impact of a familiar multi-coloured flag?

**13** **Insight**  
Reflections on the attempted registration of a royal brand

**16** **UK IPO**  
A visit to the UK IPO's Newport office provided useful insights

**18** **Employment law**  
What is the scope of employee ownership when it comes to IP?

**22** **Italy**  
What the latest EU harmonisation reforms mean for the country's trade mark owners



04

## CASE COMMENTS

26-40

► **Elena Sivoldaeva v Aditya Vitthal Choksi & Others**

► **Nokia Corporation v Shenzhen Road Zhengtong Trading Co. Ltd**

► **Shape of a candy hamburger (3D mark)**

► **The Polo/Lauren Company v Luigi Civile**

► **Monster Energy Company v Hollywood Marketing SLU (t/a Monster.travel)**

► **Match Group v Fönstria AB**

► **Sky Ltd v Guangdong Dabanya Intelligent Technology Co. Ltd**

► **Constantin Film Produktion v EUIPO**

► **Tulliallan Burlington Ltd v EUIPO**

► **Equivalenza Manufactory SL v EUIPO**

► **Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi v EUIPO**

► **ALL STARS (Opposition)**

► **PASTA GO (Opposition)**

► **LIPSY COUTURE (Opposition)**



13



18



26



42

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**PRESIDENT'S WELCOME**  
**BREXIT IS STILL**  
**A CRUCIAL FOCUS**

Supporting you through the coronavirus crisis remains a top priority for us, but it is important that we keep our focus on Brexit as well.

We are reaching one of the most crucial points in that process, so I want to update you on the work we have been doing to fight your corner.

First, we are very concerned about the potential for an unlevel playing field if UK representatives are not able to practise before the EUIPO while EEA representatives remain able to practise before the UK IPO. We have met with UK IPO officials to discuss the matter of UK address for service. They were able to confirm that address for service was not on the UK IPO's agenda.

This prompted us into immediate action. We have appointed a public affairs agency, DRD Partnership, to help us fight for the best possible outcome in a post-Brexit world. Over the past month, we have been working closely together to reach out to key targets within the Government, the opposition and to potential business supporters and allies to force the Government and the UK IPO to change their thinking on UK address for service.

In addition, we wrote to the European Commission to seek clarification of the interpretation of Article 97 of the Withdrawal Agreement. We have also written to the EUIPO to seek clarification that having a subsidiary based in the EEA is sufficient to allow employee representatives to act for it before the EUIPO.

As you can see, fighting your corner for the best possible outcome in a post-Brexit world remains a top priority for us. If you or your firm would like to be involved in our latest Brexit project, please get in touch via [citma@citma.org.uk](mailto:citma@citma.org.uk)

**Richard Goddard, CITMA President**



We have been working hard to provide you with more online resources and events to ensure that you stay connected with the profession and have easy access to relevant information and news. For example:

- You are supported through what are unprecedented times for all of us.

Our coronavirus hub has the latest news, information and advice in one place, to give you easy access to support. To visit the hub, go to [citma.org.uk/coronavirus](http://citma.org.uk/coronavirus)

**Monitoring COVID-19**

Since the outbreak of COVID-19, we have been working hard to ensure:

- You are up to date with the latest news from around the profession;
- You have easy access to relevant guidance;
- You have plenty of opportunities to continue to learn and develop;
- You are able to continue collecting CPD hours; and

**Increasing our CPD offer**

We are offering you more than 25 hours of CPD in total this year through our adapted events programme to support your growth and development. We will also be looking for new ways to deliver an online events programme that works for you. To view our full events calendar, visit [citma.org.uk/events](http://citma.org.uk/events)

## WE'LL KEEP YOU UP TO DATE

We'll continue to provide critical updates on the implications of COVID-19 for IP at [citma.org.uk/coronavirus](https://citma.org.uk/coronavirus)



### Virtual coffee mornings

We know that staying connected has never been more important, so we have been hosting virtual coffee mornings to give you the opportunity to talk to other members about anything, from work to home life.

We have had members sharing their top tips for working from home, dealing with post problems and setting up a home office. They have also shared information on unusual online purchases, which TV programmes to watch and ideas for hosting virtual social events for friends and colleagues.

To find out when our next coffee morning is, visit [citma.org.uk/events](https://citma.org.uk/events)

### Help in hardship

Remember that the CITMA Benevolent Fund is here to support you if you are facing financial hardship. If you or your family need financial assistance or information, visit [citma.org.uk/bf](https://citma.org.uk/bf)

### Global IP webinar series

Following the cancellation of our Spring Conference, we have brought the speakers online for our Global IP Webinar Series. Speakers from around the world are sharing insights into the latest changes and updates from around the profession. For more information, see our calendar on page 41 or visit [citma.org.uk/events/global-ip-webinar-series](https://citma.org.uk/events/global-ip-webinar-series)



## UK TOPS THE WORLD FOR TRADE MARKS

The UK has the best environment in the world for trade marks, a report by the US Chamber of Commerce has revealed. The 2020 International IP Index also revealed that the UK has one of the top two overall environments for intellectual property in the world.

## NEW FACE FOR EUIPO SEARCH ENGINES

The EUIPO has launched improved versions of the world's largest free trade mark and design search engines. The TMview and DesignView websites have undergone changes that have made them more efficient and user-friendly. Australia has also recently joined TMview, giving users access to a total of 74 Offices.



IP Australia has now joined TMview

## IP PRO BONO NEEDS YOUR HELP

IP Pro Bono is looking for firms and practitioners to support applicants. If you or your firm believe you would be able to assist, please email [office@iprobono.org.uk](mailto:office@iprobono.org.uk)

## EUIPO INVOICE ALERT

The EUIPO has received complaints about misleading invoices being sent and is asking users to be especially alert.



# WE'RE TAKING STEPS TO WIDEN OUR INTAKE

Andrea Brewster needs your help to increase diversity in our profession

**A lament I** often hear from IP sector recruiters is that, as much as they would like to employ a more diverse workforce, they simply don't have the right starting materials. So why are so few people from underrepresented groups seeking entry into the IP professions?

First, I think, not enough people know we're here. Many potential recruits have not even heard of IP, much less the career opportunities it provides. That means our intake is limited to people whose friends or relatives already work in IP, or those who attend schools or universities that already have the requisite links.

Second, those who do find us may be discouraged by what they see. The IP professions still don't look very diverse. A BAME person or a disabled person, for instance, might well conclude that our world is not for them.

IP Inclusive's Careers in Ideas campaign is tackling the first issue by raising awareness of IP-related careers. Its website ([careersinideas.org.uk](http://careersinideas.org.uk)) showcases a range of roles, including Trade Mark Attorneys and Paralegals, with information about entry requirements and career development, as well as personal stories from those in the sector. It promotes opportunities such as entry-level vacancies, work experience events and internships. There are also free-to-download resources, including an information booklet, a poster, a presentation and

a "career pathways map", which we'll be updating later this year.

These resources are aimed at students, teachers and careers advisers, but they're also useful for IP professionals who offer careers talks and outreach activities. Given

“

*We need as many IP professionals as possible to help us spread the word*

the current lack of awareness of our sector, getting the message out there is going to prove a massive job. We need as many IP professionals as possible to help us spread the word, in particular among underrepresented groups such as BAME people, disabled people, women in STEM (science, technology, engineering and mathematics) and students from underprivileged backgrounds.

And we need to develop relationships with the external organisations (educational establishments, careers initiatives and charities, for example) that know our target audience.

Of course, Careers in Ideas is only part of the recipe for wider access. Inclusivity further downstream is also crucial. There is no point bringing in more "diverse" recruits if we don't make them feel at home when they arrive. IP Inclusive still has work to do on that front.

A healthy profession needs a diverse range of perspectives if it's to remain credible, relevant and successful. It also needs intelligent, multi-talented individuals, and we are currently struggling to recruit as many as we need. We must attract a wider intake. And once they're here, we must provide inclusive workplaces to keep them happy, healthy, productive and loyal.

To get involved with the Careers in Ideas campaign, please contact [askcareersinideas@gmail.com](mailto:askcareersinideas@gmail.com)

Also look out for our Careers in Ideas Week from 16th-22nd November 2020, featuring a range of outreach activities from IP Inclusive supporters.



**Andrea Brewster OBE**

is Lead Executive Officer at IP Inclusive

Find out more at [ipinclusive.org.uk](http://ipinclusive.org.uk)

# LOOKING TO **GROW** YOUR TEAM?



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**CITMA** The Chartered  
Institute of Trade  
Mark Attorneys

# A QUESTION OF

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Every June, brand owners try to jump on the rainbow bandwagon. What does this mean for the credibility of an iconic symbol?

It's impossible to miss the rainbow flag during the annual Pride festivities, but these days this colourful banner is as likely to be found alongside a corporate logo as it is in the arms of a flag-waving LGBTQ+ activist.

Whether you consider this a welcome form of support for diversity and inclusion or simply opportunistic 'rainbow-washing' on the part of some major brands, the adoption of the multi-coloured flag raises a number of interesting IP issues about ownership, appropriation and free use.

## THE EVOLUTION OF A REVOLUTION

The history of the rainbow flag can be traced back to the 1969 Stonewall riots in New York City. That incident led directly to the birth of the modern LGBTQ+ movement and the election of Harvey Milk to public office in California – one of the first openly gay people to achieve this in the US. It was Milk who encouraged his friend, the gay activist Gilbert Baker, to develop the symbol. Baker's first rainbow flag design featured prominently at the San Francisco Gay Freedom Day Parade in June 1978, just a matter of months before Milk was, tragically, assassinated. ▶

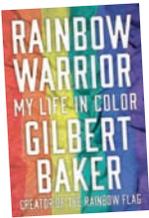
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“ Should a campaigning organisation attempt to control and enforce its symbols or allow them to enter the public domain?

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Why a flag at all? Baker (pictured right) had reportedly been inspired by the US bicentennial celebrations, at which the Stars and Stripes had featured prominently. He wanted to imbue his new symbol with that same feeling of power, but give it a joyous, colourful and positive twist. As he wrote in his memoir, *Rainbow Warrior*: “At this point, the pink triangle was the symbol for the gay movement. But it represented a dark chapter in the history of same-sex rights [...]



It functioned as a Nazi tool of oppression. We all felt that we needed something that was positive, that celebrated our love.”

In 2015, Baker told New York’s Museum of Modern Art (to

which he gifted the prototype rainbow flag for its design collection) that he had hit upon the flag as a symbol because “flags are about proclaiming power”. He added: “It is not just a logo – it functions in so many different ways”. This is also true from an intellectual property perspective, and there are barriers to protecting a symbol such as a flag if it consists of or contains an emblem that has protection under an international agreement.

The rainbow flag is not protected under such an agreement, but it does qualify for copyright protection as an original artistic work. That said, Baker purposefully never enforced his copyright in the flag, as “he wanted it to be owned by everyone”, according to Charley Beal, Baker’s friend and Manager of Creative Projects at the Gilbert Baker Foundation.<sup>1</sup>

Baker did, however, consult an attorney to block an early attempt by an LGBTQ+ advocacy organisation to register a US trade mark for the rainbow flag. Baker reportedly told Matt Coles, the attorney who represented him, that he had “created the flag for everyone and wanted it to remain free for public use”.<sup>2</sup>



GETTY



Brussels Town Hall illuminated in the rainbow colours during a Pride event



Ralph Lauren’s logo flying high over Regent Street, showing rainbow colours to celebrate Pride In London 2019



### FREE, BUT AT WHAT COST?

Whether or not a work is “copyright-free” largely depends on the will of its creator, and Baker’s free-for-all attitude certainly helped the use of the rainbow flag to spread throughout the US and then worldwide, supporting the LGBTQ+ movement’s growth and helping to foster wider acceptance of the community. There are now countless “copyright-free” images of it available online, and the flag has become near ubiquitous in its use to celebrate both Pride events and the LGBTQ+ community in general.

However, from an IP perspective, such an approach does not come without risks. Here, a number of parallels can be drawn with other iconic copyright-free symbols, such as the widely used “peace symbol”



designed by British artist Gerald Holtom for the Campaign for Nuclear Disarmament (CND) in 1958. As with the rainbow flag, the symbol has

been massively exploited over time, on T-shirts, posters, jewellery – pretty much everywhere – with the danger that its intended significance will or may already have been lost.

A modern parallel can be drawn with the “extinction symbol” logo affiliated with the international movement Extinction Rebellion. Use of the symbol (an hourglass contained within a circle) has been relatively limited so far, probably because of the controversy surrounding the movement’s focus on civil disobedience and disruptive activity. Of course, the same could



### FLIGHT OF FANCY: THE RAINBOW FLAG OVER TIME

Gilbert Baker’s now-ubiquitous rainbow flag has been updated over time. The first iteration featured eight stripes, each with its own specific meaning, as opposed to the six we know today. For various practical reasons and to make the flags easier to manufacture, Baker dropped two of the colours (hot pink and turquoise).

The six stripes in the current version still represent different things: red (life), orange (healing), yellow (sunlight), green (nature), blue (harmony) and purple (spirit). The hot pink and turquoise stripes originally represented sex and magic/art respectively.

Baker wasn’t the first activist to use a rainbow flag to signify hope.



A “peace flag”, featuring seven rather than six colours and the word “Peace” (peace), was first used at a peace march in Italy in 1961. It had been inspired by similar multi-coloured flags used in demonstrations against nuclear weapons across Italy.

The rainbow flag was not Baker’s only flag creation either. He also designed rainbow flags for each of the US states, the District of Columbia and the US territories.



Some of Baker’s rainbow flags for the 50 US states, the District of Columbia and US territories

have been said of the peace symbol in the ’60s and ’70s, and the rainbow flag itself in the early days of the LGBTQ+ rights movement.

### COMMERCIAL USE: HARM OR HELP?

These days, the rainbow flag has also been co-opted by global brands to piggyback on the movement’s success and draw the “pink pound”. This has become known as “rainbow-washing”, a term coined to name and shame those companies that overstep the thin line between supporting the LGBTQ+ community and exploiting it for marketing purposes. In particular, it is levelled at those organisations, governments and businesses that don’t support LGBTQ+ communities at any other time of the year, but happily redesign their logo or products to feature a rainbow flag in the month of June to benefit from the association.

To become an official partner of a Pride parade, brands have to be able to demonstrate to the organisers that they support the LGBTQ+ community throughout the year, but anyone is free to use the rainbow flag in their own advertising at any time.

It’s not hard to find examples of brands that use the rainbow flag or its colours, but it’s not always easy to tell if they’re doing this out of genuine support or simply because it looks good and will make them money. Take, for example, Disney’s “Rainbow Disney” collection, which includes a range of clothing and accessories such as rainbow Mickey Mouse ears. The company also hosts its own Pride event at Disneyland Paris, called “Magical Pride”.

Then there’s Primark, with its “Feeling Proud” collection, through which it also markets a range of clothing and accessories. Costa ▶



Coffee has even previously produced rainbow-coloured cups for Pride.

Meanwhile, other companies have opted to feature the rainbow flag in their logos, including YouTube, Spotify and Coca-Cola. Sportswear giant Nike went one step further in 2019, partnering with the Gilbert Baker Estate to design a “BETRUE” rainbow-themed clothing range.

The flag motif is easily applied, so how do you draw the line? At what point does using it become simply tokenistic or trivialising? How about when it reaches mouthwash? In 2019, Listerine bottles sported a rainbow flag as part of Johnson & Johnson’s CARE WITH PRIDE® initiative, which wasn’t received well by some members of the LGBTQ+ community. Or what about a sandwich? The M&S rainbow-branded BLT sandwich also attracted criticism, despite the fact that both organisations donated to Pride-supporting charities.

Here, parallels can also be drawn to the backlashes against BrewDog and its “Pink IPA”, launched to support International Women’s Day in 2018, and Pepsi, which was accused of co-opting imagery from the Black Lives Matter movement in its 2017 advert featuring model Kendall Jenner.

In these instances, the movement itself didn’t have to take legal action against the brand owner, as the court of public opinion acted on its behalf. But it does occasionally become necessary for campaigning organisations to threaten legal action where they believe a brand owner has overstepped the mark. Such was the case in 2014, when CND threatened to take Unilever to court over its use of the peace symbol in a marketing campaign for Lynx deodorant.

### WITH RECOGNITION COMES POWER

This is the dilemma that faces any campaigning organisation: should it attempt to control and enforce the symbols that represent its interests or allow them to enter the public domain?



A trainer from Nike’s BETRUE range

While it is too late for the organisations behind the rainbow flag and other such copyright-free campaigning symbols to act, any organisation that creates a logo for campaigning use would be wise to take advice on IP protection.

In general, such symbols will qualify for copyright protection and, in theory, already have a degree of enforceability. The problem comes in enforcement itself, as attempts to enforce copyright ownership can be time-consuming and expensive.

If the symbol has been inappropriately copied by a third party, then a policy of publicly “naming and shaming” might be more effective than legal action per se, especially if the third party is trying to exploit the image for profit.

Setting clear guidelines as to how and when the symbol can be used can help to avoid dilution and adverse appropriation, but ultimately the more popular and visible the symbol becomes, the harder it will be to control third-party usage. In many ways, ubiquity is the source of these symbols’ strength, but it is also ultimately a weakness.

By relinquishing any IP control, these symbols and their messages have the potential to spread widely, but this comes with the risk that once-potent images can lose their uniquely persuasive and community-building power. ●

1 [huffingtonpost.co.uk/entry/rainbow-pride-flag-history\\_n\\_5b193aaf4b0599bc6e124a0](https://www.huffingtonpost.co.uk/entry/rainbow-pride-flag-history_n_5b193aaf4b0599bc6e124a0)

2 [aclu.org/blog/lgbt-rights/meet-man-who-kept-rainbow-flag-free](https://www.aclu.org/blog/lgbt-rights/meet-man-who-kept-rainbow-flag-free)



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**T**he issue of the use and registration of trade marks incorporating the word “royal” has recently barged into the public consciousness thanks to controversy and press comment regarding the “stepping back” from official duties of the Duke and Duchess of Sussex, alongside their aborted launch of the SUSSEX ROYAL brand.

Before it became clear that the Duke and Duchess of Sussex were not going to continue with the use and registration of the SUSSEX ROYAL brand, many had questioned whether the couple and their foundation – Sussex Royal, the Foundation of the Duke and Duchess of Sussex – should have been allowed to use or indeed register the trade marks SUSSEX ROYAL and SUSSEX ROYAL THE FOUNDATION OF THE DUKE AND

DUCHESS OF SUSSEX at all, given that they were no longer going to be actively undertaking public duties.

In the meantime, the UK trade mark application for SUSSEX ROYAL encountered a total of 14 notices of threatened opposition, and SUSSEX ROYAL THE FOUNDATION OF THE DUKE AND DUCHESS OF SUSSEX encountered three.

Undoubtedly, many of these notices were prompted by the press interest, given that they are easy and free to file. Ultimately, none led to formal notices of opposition prior to the withdrawal of the applications. Nonetheless, their filing did raise interesting questions over whether there was any realistic grounds of opposition or invalidity on the basis of the incorporation of word “royal” in both trade marks.

#### **WHAT ARE THE RULES?**

The UK Trade Marks Act 1994 (the Act) does incorporate provisions governing the registration of trade marks that incorporate the word “royal”. Obviously, these provisions were not written with the relatively unique circumstances of Harry and Meghan in mind, but rather with a view to stopping third parties who were not members of the royal family and did not have authorisation from the royal family, and in particular The Queen, from registering trade marks incorporating the word.

The most relevant provisions to these questions are in s4(1) of the Act, which reads: “A trade mark which consists of or contains –

“(a) the royal arms, or any of the principal armorial bearings of the royal arms, or any insignia or ▶

“ It is highly unlikely that any opposition or invalidity action under this ground would have succeeded in the absence of opposition by The Queen herself



device so nearly resembling the royal arms or any such armorial bearing as to be likely to be mistaken for them or it,

“(b) a representation of the royal crown or any of the royal flags,

“(c) a representation of Her Majesty or any member of the royal family, or any colourable imitation thereof, or

“(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had royal patronage or authorisation, shall not be registered unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the royal family.”

Although the Duke and Duchess of Sussex have used a stylised H and M logo incorporating a crown for some time, this does not appear to feature one of the royal crowns and does not appear to be the subject of any trade mark applications. Thus, the key provision relates to the registration of the word “royal” within the SUSSEX ROYAL word mark.

In relation to this provision, it bears noting that the registration of trade marks incorporating the word “royal” is not prohibited per se by applicants who are not members of the royal family or who lack a connection to it for many goods and services. The UK IPO’s examination manual makes clear that the word “royal” is unlikely to indicate royal patronage or authorisation for everyday items or services such as insurance or financial services, double-glazing services, provision of electricity, or for goods which are far enough removed from



The Sussex Royal stylised logo has been used for some time

any association with the royal family, such as skateboards, computers, computer games or T-shirts. From a practical point of view, one can no doubt recall the name of several insurance or assurance companies that incorporate the word “royal” in their name, such as ROYAL LONDON and ROYAL & SUN ALLIANCE, neither of which has an obvious connection to the royal family.

Further, the UK IPO makes clear that the word “royal” presented in combination with other words that point away from implying royal patronage (eg, the term “royal flush”) can be accepted *prima facie* for any goods or services, unless the combination is descriptive. Its use in combination with another registrable element (eg, RAYBURN ROYAL or ROYALHARTEX) can also be accepted.

However, the UK IPO also makes clear that issues are likely to arise

from the registration of trade marks incorporating the word “royal” for goods or services where the word “royal” may indicate royal patronage, such as high-quality porcelain and glassware, luxury foods, organic food, confectionery, alcoholic beverages, clothing, organisation of sporting events, tourism, and medical and charitable services. Some of these goods and services were covered by the ROYAL SUSSEX and SUSSEX ROYAL THE FOUNDATION OF THE DUKE AND DUCHESS OF SUSSEX trade mark applications.

The question was therefore whether those two trade mark applications would have fallen under such prohibitions and whether the change in status of the Duke and Duchess of Sussex since the filing of those applications directly impacted the trade mark applications made in the name of their trust or any subsequent trade mark registrations.

We believe it highly unlikely that any opposition or invalidity action under this ground would have succeeded in the absence of opposition by The Queen herself. For one thing, the Duke and Duchess of Sussex are still members of the



royal family, and although they have agreed not to use the title “HRH”, that is not going to change. Further, the Duke remains a royal prince and indeed had explicit royal patronage until April, had royal patronage at the time the UK applications were filed, and post-April would be understood as having had royal patronage “recently”, thereby dealing with the provisions of s4(1)(d) of the Act. As a result, the “royal connection” flowed from the Duke and Duchess through to the owners of the trade marks in the form of their trust.

Also, crucially, it seems that if explicit consent were needed in order to overcome an opposition or invalidity action and was forthcoming from The Queen, that would have ended such a ground of opposition or invalidity. Further, given that the applications had been accepted by

the UK IPO, had The Queen done nothing the applications would have proceeded. This, perhaps, is where we find the crucial turning point in the Sussex Royal saga.

#### **DID HER MAJESTY OBJECT?**

Although The Queen never publicly objected or opposed the applications at the UK IPO, press reports suggest that she implicitly objected or had explicitly expressed displeasure about the brand behind closed doors. And, ultimately, the fate of those UK trade mark applications was always in the hands of HRH. If Her Majesty had expressed opposition to the use and registration of the SUSSEX ROYAL brand, then the fate of those two UK applications would have been sealed.

It was interesting to note that the statement from the royal couple announcing the abandonment of the SUSSEX ROYAL brand included comment that use and registration of SUSSEX ROYAL could not have been prevented outside the UK. While that is technically correct, it seems unlikely that the royal couple would have pursued a multi-brand strategy on a global basis, if only due to the practical, legal and marketing considerations.

The SUSSEX ROYAL trade mark applications highlight another issue that Trade Mark Attorneys may have to manage: namely, intense press interest in applications for marks of public interest. Many trade mark applications in the past have received a large number of notices of threatened opposition, but it is rare for these to materialise as formal notices of opposition. The question, then, is how a Trade Mark Attorney manages such an eventuality. Is it best to ride out the storm by offering no comment to the press or simply issuing pre-agreed responses, or should you form a proactive PR strategy and react aggressively to each press comment? In this royal

saga in particular, we find it hard to believe that any Trade Mark Attorney could have predicted the multiple (often daily) turns taken. However, Trade Mark Attorneys must accept: (a) that there may be intense public and press interest in the applications they file for clients; (b) that filing and prosecution cannot be managed in isolation from the “PR angle”; and (c) that the public and the press often completely misunderstand the desire and need for trade mark protection.

Indeed, in this case, the Duke and Duchess of Sussex rightly pointed out that their actions were not out of line with the trade mark protection efforts of the Royal Foundation, now run exclusively by the Duke and Duchess of Cambridge. However, we suspect some of the negative press comment in the case of SUSSEX ROYAL was driven by the failure of the Duke and Duchess to communicate effectively how the brand would be used amid concerns about the commercialisation of royal connections. In the absence of a clear message, the public and press came to their own conclusions.

Ultimately, the SUSSEX ROYAL and SUSSEX ROYAL THE FOUNDATION OF THE DUKE AND DUCHESS OF SUSSEX UK trade mark applications were withdrawn on 25th February 2020. In light of this, it will now be interesting to see what happens with all the spurious applications made in their wake. In the US, there were eight pending applications for the SUSSEX ROYAL mark (or similar) at the time of writing, none of which were filed by the Duke and Duchess. A further search on the TMview database revealed another 27 applications in various countries for the SUSSEX ROYAL mark, again none of which have been filed by the Duke and Duchess.

In short, the Duke and Duchess may no longer have an interest in the SUSSEX ROYAL brand, but the interest of others may persist. ●



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Find out more about Lee in the TM20 Q&A on p42.

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# HELLO, IPO!

What did a group of newly qualified attorneys learn from going behind the scenes in Newport?

Last year, the UK IPO, in conjunction with CITMA, offered a marshalling scheme for newly qualified attorneys, which included welcoming a delegation to the Newport office for a day. The programme included presentations, workshops and insights from Examiners and Hearing Officers, including Head of Tribunals Oliver Morris and Ex Parte Hearing Officer Mark Jefferiss. The hope was that the attorneys would gain practical tips that would support their future prosecutions. The *CITMA Review* caught up with them to ask why they took part and how the visit has helped them in their practice.

## BACKSTAGE ACCESS

“This was a fantastic opportunity to attend the UK IPO, as it was the first time invitations were open to newly qualified attorneys,” explains Jasmine Sihre, a Trade Mark Attorney at Lewis

Silkin. She adds that she was “keen to link my practice directly with the practicalities and processes of the UK IPO”. Jennifer Heath, an Associate at D Young & Co., echoes this thought, having heard from some of her patent colleagues that they had found a similar visit to be very useful.

Laura Tennant, an Associate Trade Mark Attorney at Burges Salmon, “thought that a ‘backstage tour’ of the UK IPO would be a good experience”, giving her a chance to meet and put faces to the names of some of the Examiners and Hearing Officers that she deals with on a regular basis.

Robecca Davey, a Trade Mark Attorney at Baker McKenzie, and Dan Hardman-Smart, an Intangible Assets Executive at Stobbs IP, were also keen to see behind the scenes. For Hardman-Smart, the visit was “a great opportunity to see not just what they are doing but how”.

## DID IT DELIVER?

When asked if they thought that the day would help them move forward in their practice, Tennant says that she took away some useful pointers. Davey agrees and says she has found the tips on preparing opposition submissions and evidence of use helpful, as well as the advice on hearings. As a result, she “feel[s] more confident about the prospect of conducting an ex parte hearing in the future, having now met a Hearing Officer and come to understand the process better”.

It took Heath as little as 24 hours to see the benefit. The day after the visit, she spoke to a Hearing Officer that she

had met while in the course of her practice. “It was nice to put a face to a name and remember that the people working at the UK IPO will do what they can to find the best outcome for parties where it is in the public interest,” she says.

Gavin Shaw, an in-house Trade Mark Attorney at JSP Ltd, has found that the people and departments at the IPO “don’t feel so distant now, which will assist me in future interactions with the organisation”.

Both Sihre and Hardman-Smart found the exposure to the Registry system particularly useful. For Hardman-Smart, this was a “a valuable insight into Registry practice that you cannot get from the Manual”, while Sihre says that, in addition to broadening her appreciation for the “various departments and roles,” the experience will “now assist me in best serving my clients when I communicate with the IPO”.

Julia King, an Associate at Taylor Wessing, has been able to capitalise on what she learned about how Hearings Officers like to have evidence presented and what types of evidence they consider useful. She has put this knowledge into practice in a workshop session to cement and share this knowledge.

#### **MOST VALUABLE MOMENTS**

Davey says that she found the day to be well thought-out overall, but particularly enjoyed the “really informative” talk by Mark Jefferiss. She also describes a working lunch with Oliver Morris and other members of the team as “insightful”. “They were there to answer any questions we had,” she explains.

King also welcomed the insight that she picked up about ex parte hearings, noting that they provide newly qualified attorneys with a

good forum in which to practice their oral advocacy skills.

Adam Kellett, a Trade Mark Attorney at Dehns, most valued getting “time to talk with the Examiners” and suggested that it could be extended with similar open days in the future. Tennant, Heath and Sihre agree, with Tennant describing the session as “a great glimpse of the ‘other side’ of trade mark examination”. For Heath, being taken through some example cases proved helpful. She notes that, from a practical perspective, “it was a useful reminder that if you disagree with an examiner, they are open to hearing from you!”

For Sihre, the event highlighted the need – and opportunity – for better communication. “As part of our day-to-day role, interaction with examiners is very much reactive, and the experience showed me that lines of communication between the examiners and attorneys should be open and transparent. This type of insight into the role of an examiner

“ *The visit was a great opportunity to see not just what they are doing but how*

is rare.” Shaw agrees, saying that he “came away with a much better understanding of various aspects of the role”.

For Hardman-Smart, a face-to-face meeting with officers of the Tribunal Section was invaluable. “We may be familiar with Tribunal practice but hearing their personal dos and don’ts was useful,” he says.



Jack Kenny (Marks & Clerk), Becky Knott (Barker Brettell) and Adam Kellett (Dehns) at the IPO in Newport

Would attendees recommend the day to colleagues? Both Hardman-Smart and Heath say they would, and Davey has already done so. She also believes that a similar day would benefit colleagues in more senior roles. “While the scheme was aimed at junior-level attorneys, I think it would also benefit mid-level attorneys who are more likely to be working on disputes and could use the opportunity to pick Hearing Officers’ brains on issues they face regularly and get an insight into how the Examiners and Hearing Officers make their decisions.”

Both Shaw and Tennant say the day undoubtedly gave them a better understanding of the inner workings of the UK IPO. Shaw believes that this has given attendees “extra confidence and patience with the world-class systems, which are developing and improving all the time, and confirmed that the IPO is open to feedback to help them do that.” ●

*With thanks to Becky Knott, Chartered Trade Mark Attorney at Barker Brettell, who gathered this feedback for the CITMA Review.*

OWNERSHIP

IP



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# WHO OWNS WHAT?

Kate Swaine defines the scope of employee ownership when it comes to IP

All businesses own and use intellectual property, whether they are an innovative patent- or design-led business or simply applying a name to their goods. These rights come into being in a number of ways, and understanding what IP rights exist and where they vest is crucial to maximising a company's ability to protect and use its IP and strengthen its business.

In particular, it is vital that any business understands its IP rights in the context of arrangements with employees and third-party contractors, and this article aims to explain who owns what, across a range of relevant rights.

## REGISTERED RIGHTS

Of course, the *prima facie* owner of a registered IP right is the individual or entity identified as the applicant and owner of it. This is the case, for example, for registered trade marks, registered designs, domain names and patents of all types. Therefore, all applications for such rights should be made in the name of the business or individual intended to own the right. If the registration is made in the wrong name or needs to be changed at a later date, it can be transferred to the correct entity by

way of assignment, assuming the relevant parties agree.

However, if the relevant parties are not in agreement, resolving the issue may not be straightforward. For example, consider the position between a company and a former contractor who decides to seek trade mark rights in the name of a product they created, or to seek a declaration of invalidity in relation to a trade mark registration on the basis that the application was made in breach of s3 or s5 of the Trade Marks Act 1994. If successful, the registration would be declared invalid as opposed to being transferred to the company. The company could then file a fresh application in its own name, but it would not have the benefit of the filing date of the original application. To avoid this, it is vital that there is clarity from the start as to ownership of the rights created.

“ It is vital that there is clarity from the start as to ownership of the rights created

## UNREGISTERED RIGHTS

For unregistered rights, the general rule is that works created by an employee will be owned by the employer, provided that the works were created during the course of their employment. This is the case, for example, with copyright, unregistered design rights and rights in databases. It is possible to contract away from the statutory position in the employee's favour, but doing so will not usually be in the interests of the employer.

Ownership of unregistered rights, as between an individual and the business for which they are working, depends on a combination of factors, including the individual's employment status, the terms of that agreement, the context in which the relevant work is undertaken and the statutory position in respect of the relevant type(s) of IP right. This is the case for copyright, unregistered design rights, rights in inventions, rights in confidential information and trade secrets more generally.

Although the general rule is that works created by an employee will be owned by the employer, provided that the works were created “in the course of employment” (the legislation is worded slightly

differently for inventions, as noted below), the case law indicates that disputes sometimes arise as to whether an individual counts as an “employee” and whether the relevant work was indeed done “in the course of employment”.

Commentators have noted that, when addressed in IP contexts, there is often a desire to show that the individual was an employee and hence the company owns the IP in question. In this respect, contrasting approaches can be seen in *A Fulton Co. v Grant Barnett & Co.*<sup>1</sup>, where the individual designer was chairman, chief executive and director with no service contract, but was held to be an employee. On the other hand, in *Ultraframe v Fielding*<sup>2</sup>, the director (and sole shareholder) was held not to be an employee.

Whether the relevant work was done “in the course of employment” will also be a question of fact. Factors to be taken into account include whether the work falls within the employee’s normal duties or as an additional duty specifically assigned to the employee. For example, just because work is done during working hours does not necessarily mean that the criteria is met and that the IP arising from the work is owned by the employer. Conversely, work done outside working hours but within the job description of the employee may fall within the course of employment.

For workers who are not employees, such as consultants, the individual will usually be the first owner of any IP arising in works created in the course of their services. In order to ensure that such IP becomes owned by the “employer”, provisions expressly stating that to be the case should be included in the contract governing the relationship between the parties.

Similarly, if a company commissions another party to create a work, such as a logo, the first owner of rights arising in the logo (for example, copyright and an unregistered design right) will be the individual who created it or that individual’s employer. Again, in order for the commissioning company to own the IP in the logo and to be able to fully enforce it against an infringer, the contract

governing the commissioned work needs to make provision for the assignment of all IP arising in the logo to the commissioning company. It is usually easier to agree this before any work is undertaken or an agreement signed. Retrospectively trying to secure an assignment can prove expensive for the commissioning party and result in a request for additional payments.

#### OTHER RIGHTS

A few other particular rights are worth considering. Let’s begin with moral rights. These arise in favour of the creators of copyright-protected works. Moral rights are owned by the creator of the work (even if they are an employee) and cannot be assigned away. Instead, if the employer would prefer not to recognise the creator of the relevant work(s) on all subsequent copies and wants to avoid difficulties with subsequent editing or adaptation, they should seek an express waiver of moral rights from the employee.

Other considerations govern confidential information and trade secrets. Between a company, its employees and other workers, obligations of confidentiality will be determined by both contractual terms (express and implied) and the equitable obligation of confidence. This is an area of common law, the leading cases being (the wonderfully named) *Faccenda Chicken v Fowler*<sup>3</sup> and *Vestergaard v Bestnet*<sup>4</sup>, as recently confirmed and applied in the context of the 2016 EU Trade Secrets Directive in *Trailfinders v Travel Counsellors*.<sup>5</sup>

Common law distinguishes between various types of information that become known by an employee, each affording different levels of protection. The most secret information will continue to remain protected after an employee’s employment has ended. A lesser category of information must be treated as confidential during the term of employment but, once learned, becomes a part of the employee’s skill and knowledge. This information may be used by them after the termination of their employment. Information that

## IP IN EMPLOYMENT: GET IT RIGHT

- 1 It is vital that there is clarity from the start as to ownership of the rights created.
- 2 Applications for registered rights should be made in the name of the business or individual intended to own the right.
- 3 A contract governing commissioned work must make provision for the assignment of all IP arising in the work.
- 4 An employer that wishes not to recognise the author of the relevant work(s) on all subsequent copies should seek an express waiver of moral rights from the employee at the outset.
- 5 A company’s contractual arrangements with employees and other workers should be prepared with sensitivity to the individual’s role and the level of confidential information that is likely to come into their knowledge.
- 6 Contractual arrangements must clearly reflect agreed expectations about the ownership and management of IP. There is little legal recourse for employers where contractual arrangements are deficient.

is trivial or in the public domain cannot be treated as confidential.

Where there is a dispute, the terms of the relationship between the parties, the relevant facts and the context of those facts will be relevant to determining the outcome. A company’s contractual arrangements with employees and other workers should therefore be prepared with sensitivity to the individual’s role and the level of confidential information that is likely to come into their knowledge.

As regards inventions and patents, the broad position is that the employer will own rights arising in inventions made by an employee in the course of carrying out their normal duties, or duties that were specifically assigned to them in circumstances such that an invention was reasonably expected to result. For employees with a special obligation towards the employer

(eg, directors), the employer will own inventions created while carrying out their duties. Further, the Patents Act 1977 provides for compensation to employee inventors for inventions (and patents) that prove to be of outstanding benefit. A recent example of a dispute in this area is the case of *Shanks v Unilever*<sup>6</sup>, in which an employee was awarded compensation of £2m in respect of

which contained employer-favoured clauses. The copyright agreement featured a clause assigning to Mulberry “all copyright works and designs originated, conceived, written or made by you during the period of your service”.

Gray had signed the employment contract but refused to sign the copyright agreement on the basis that she believed it could capture

appropriate to the real-world operation of their relationship. The employment agreement or other contract should be clearly drafted and make arrangements for IP appropriate to the type of agreement, the role of the individual and the context of their work.

Best practice, with a view to avoiding dispute as to the meaning of “in the course of employment”, is to clearly define the scope of the employee’s role. If the role is likely to include inventing and/or designing something, making improvements, or generating or coming into contact with confidential information, it should include a requirement for notification of new designs, inventions and so on. Proactive employer engagement with key inventors and designers – for example, appropriate recognition and sensitive rewards for any advancements made – may assist in maintaining positive relationships and avoiding the statutory regime for inventor compensation being called upon. Remember also that contracts and descriptions should be updated when duties change.

For some roles, a periodic review and capture of any IP rights (including confidential information) that are likely to have arisen or come within the individual’s knowledge may be appropriate. As well as keeping the relationship between, and the positions of, the parties clear, this review process may also support best practice in IP management by the business itself. Capturing what was created, when and by whom underpins effective IP use for commercial success. ●

1 [2000] EWCA Civ 513  
2 [2003] EWCA Civ 1805  
3 [1987] Ch 117  
4 [2013] UKSC 31  
5 [2020] EWHC 591 (IPEC)  
6 [2019] UKSC 45

## “ Just because work is done during working hours does not necessarily mean that the IP arising from the work is owned by the employer

patents obtained on inventions by *Shanks* both within and outside his usual working hours.

### FREEDOM OF CONTRACT

The importance of ensuring that contractual arrangements reflect agreed expectations on the ownership and management of IP is clear. Although UK law provides employers with a reasonable default position with respect to employees, there is little backup for employers where contractual arrangements with other types of workers are deficient. For non-employees, the default is that unregistered IP vests with the individual.

It is possible for IP provisions in contractual arrangements to differ from the default positions provided by statute, with some exceptions. Most notably, it is not possible to vary by contract, to the detriment of the employee, the statutory default provided in respect of inventions and patents. Any contract purporting to do so will be unenforceable to that extent.

Recently, the Court of Appeal’s judgment in *Gray v Mulberry*<sup>7</sup> strengthened the position of employers seeking deep and comprehensive IP provisions in a contract of employment. Gray had taken a job with Mulberry as a Market Support Assistant. Mulberry required its employees to sign both an employment contract containing a confidentiality clause and a copyright agreement, both of

her artistic activities away from work (as a writer and filmmaker). She was eventually dismissed for her failure to sign.

Gray ultimately bought a claim for discrimination on the grounds of belief, defined as “the statutory human or moral right to own the copyright and moral rights of her own creative works and output, except when that creative work or output is produced on behalf of her employer”. She was unsuccessful at each instance. The Court of Appeal’s view was that Gray’s “crisis of conscience” about signing the copyright agreement could be described as purely commercial and designed to protect her own private interests. As such, the alleged belief lacked sufficient cogency to qualify as a philosophical belief protected under the Equality Act 2010.

### RECOMMENDATIONS

Ultimately, all working relationships between businesses and individuals should be governed by contract. The parties should be clear about the nature of the relationship sought and satisfy themselves that it is



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# Harmonisation

## NEW CODE, NEW OPTIONS

Wondering what EU harmonisation means for Italy's trade mark owners? Paola Gelato breaks down three important changes

**L**egislative Decree 15/2019 came into force in Italy on 23rd March 2019, implementing EU Harmonisation Directive 2015/2436 and introducing significant amendments to the Italian IP Code.

This article will focus on three fundamental aspects of the reform: enhanced protection of trade marks with reputation; the provision of new rules on acts preparatory or contributing to infringement; and the controversial reversal of the burden of proof in actions for revocation based on non-use.

### **1 RAMPED UP PROTECTION FOR MARKS WITH REPUTATION**

The new Decree has further extended the protection of well-known trade marks, amending Article 20 of the Italian IP Code. That Article now expressly protects the different functions of the sign, beyond its primary role as an identifier of commercial origin, from any form of infringement. In particular, this substantially enhances the investment and advertising functions of the trade mark. Further, amendments to Article 12(e) of the Code now expressly specify that protection

for well-known trade marks extends to identical, similar and non-similar products and/or services.

The reform has implemented the general goals of EU Harmonisation Directive 2015/2436 and is in line with the overall aim of the EU trade mark package: that Member States shall enlarge the scope of protection of well-known trade marks. In this spirit, Italy has added, among the grounds of opposition, the notoriety of the trade mark. This is now expressly provided by Article 176(2) (b) of the Italian IP Code, in combined application with Article 12(e). These modifications will

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surely make it easier to oppose trade mark applications where they may prejudice a prior sign or its reputation.

It is clear that the enlarged protection of well-known brands enhances the advertising function of the sign and its message of quality and style, which often supersedes the original function of commercial identification.

This recent reform is perfectly in line with consolidated Italian case law, which had already tended to highlight and protect the different functions of the trade mark. For instance, in a decision of 30th June 2016, the Court of Milan expressly stated that the trade mark, being a fundamental company asset, does not exhaust its role in the primary function of commercial identification. It also plays a key promotional and advertising function, which deserves to be attentively protected.

The Court of Milan has also interpreted the traditional notion of competition in a broader way, stating that the functions of the trade mark, other than that of commercial identification, may be easily infringed by parties that are not direct competitors but

that may harm the communicative value of the brand and its image.

This judgment has defined the notion of unjust profit taken from the distinctive character and/or the reputation of a trade mark, which it summarised as follows: “This notion is known as parasitism and free-riding, and is directly connected to the advantage taken by a third party from the use of an identical and/or similar sign, including the possibility of transferring the image of the renowned trade mark, with an evident undue exploitation of the brand’s reputation, also independently from the goods/characterised by the relevant sign.”

What’s more, over the past two decades, Italian courts have ▶

“ *These modifications will surely make it easier to oppose trade mark applications where they may prejudice a prior sign or its reputation* ”



granted important damages where blatant violations of the image of a trade mark have resulted in the dilution of the reputation of a brand. In some cases, the evaluation of the prejudice to the image of the brand has amounted to 25 per cent of the award granted. For instance, in 2007 the Court of Florence granted an award for damages of €160,000 to a famous fashion house following infringement proceedings. Of that, €120,000 was for the economic prejudice and €40,000 was for the dilution of the image of the brand.

Consumers will also benefit from this new reform, since it will be more difficult for infringers to exploit the reputation of third parties' trade marks, with the subsequent reduced risk of confusion among the public. Indeed, it is impossible to justify the enhancement of the protection of trade marks with reputation without also highlighting the concurrent enforced defence of consumers' interests and rights.

## 2 STRENGTHENED PROTECTION AGAINST INFRINGEMENT

The Legislative Decree has also enlarged the protection of trade marks in general. In particular, Article 20 of the Italian IP Code has been amended to allow trade mark owners to block unlawful behaviour even before the sale or circulation of infringing products. Trade mark owners may forbid third parties from applying their distinctive signs to labels, packaging, tags or security devices – conduct that is considered to be an act preparatory or contributing to infringement.

In this respect, Italian intervention perfectly mirrors the aspirations of the EU Harmonisation Directive. Article 11 of the Directive foresees that Member States shall provide rules for sanctioning acts preparatory to infringement.

Moreover, the Italian reform is in line with Article 10 of EU Trademark Regulation 2017/1001, which sanctions acts preparatory



Milan's Palace of Justice  
(Palazzo di Giustizia)

to infringement. The Regulation expressly notes that third parties are prohibited from affixing a trade mark owner's signs on labels and the like.

The recent reform also extends protection against infringement and acts preparatory to infringement to goods in transit, for example products coming from a non-EU country and destined for an EU country other than Italy. Potentially

especially the ADM and the Guardia di Finanza (the Italian Financial Police).

Finally, it is worth noting that Article 122 of the Italian IP Code has been amended so that exclusive licensees are entitled to start an infringement proceeding, having informed the trade mark owner, if the latter does not take the initiative. What's more, non-

*“ A more prominent role for licensees in the enforcement of trade mark protection constitutes a remarkable development ”*

infringing products will be released by Italy's Customs and Monopoly Agency (ADM) when the holder proves that the trade mark owner does not have the right to prohibit the introduction of the goods into the country of final destination.

The aim of this significant enlargement of the protection is to help trade mark owners prevent the circulation of the infringing products and, consequently, to substantially reduce the damages produced by third parties' unlawful behaviour. However, the effectiveness of the reform will require a deeper co-operation between trade mark owners and the authorities,

exclusive licensees may have the right to act as plaintiff or defendant in infringement proceedings with the prior authorisation of the trade mark owner. Although this may appear to be a minor procedural adjustment, a more prominent role for licensees in the enforcement of trade mark protection constitutes a remarkable development, since licensees may intervene more promptly than trade mark owners as a result of their deeper knowledge of the relevant markets and local legal systems.

In broad terms, the reform has now codified the consolidated Italian case law, which already tended to grant to exclusive licensees active

legal standing, unless the relevant license agreement expressly excluded the licensee's entitlement.

### 3 A REAL REVERSAL OF THE BURDEN OF PROOF?

The Decree has also modified Article 121 of the Italian IP Code, relating to the burden of proof concerning trade mark use in cases where an action of revocation is based on non-use. Previously, the burden of proof was on the petitioner (ie, the party claiming the relevant right or raising an objection). However, it is often very hard to prove the non-use of a third party's distinctive sign. The challenge is sometimes so great that the standard required has been called the *probatio diabolica* (the devil's proof).

Article 121 now provides for the burden of proof to be put on the trade mark owner. This remarkable reform follows the general principle of "proof proximity", according to which it is reasonable that the party that may give evidence more easily is charged with the burden of proof.

As a result, trade mark owners are well advised to keep evidence of use of their distinctive signs so that they are ready at any time to discharge the burden of proof. This evidence might include promotional material, accounting documents and any document attesting to the sale of products bearing the relevant trade mark, such as catalogues.

However, the real extent of the reform is somewhat disputed, especially by those commentators who try to interpret the new Regulation in line with the EU Harmonisation Directive. Indeed, Article 17 of the Directive refers to actions of infringement, in which the defendant may object to the plaintiff on the grounds of the latter party's non-use of the trade mark in question, discharging the burden of proof to the plaintiff. The aim of the European intervention, then, was to balance the parties'

positions in the context of infringement proceedings.

On the other hand, the Italian implementation has apparently extended the reversal of the burden of proof to actions of revocations for non-use, so that the plaintiff claiming the revocation of the defendant's trade mark is not required to give any evidence of the other party's non-use, whereas the burden of proof would be exclusively discharged by the defendant. In fact, within infringement proceedings, Article 121 of the Italian IP Code does not introduce a difference between actions of revocation for non-use and objections raised.

It is clear that a similar interpretation implies several problems of balance between the parties, since it would be illogical to charge the defendant of an action for non-use with the entire burden of proof such that the plaintiff, paradoxically, would obtain the requested decision without giving any concrete evidence.

As such, it is likely that the new rule will be interpreted in line with the aim of the EU Harmonisation Directive, thereby distinguishing between actions of revocation for non-use and objections within infringement proceedings.

In this sense, it may be argued that, especially in the case of actions for revocation, the burden of proof will not be entirely discharged by the trade mark owner, since the party claiming the revocation will, in any case, provide hints of the other party's non-use.

We should also remember that prior to the recent reform, Italian case law had repeatedly stated that

the burden of proof as it pertained the party that had to give evidence of the non-use was somewhat weakened and could rely upon hints and presumptions.

All told, the revolution of the reversal of the burden of proof may be less substantial than it appears at first glance. The practical extent of the changes, though, will largely depend on the interpretation of the courts of merits.

### SIGNIFICANT BENEFITS

The implementation of EU Harmonisation Directive 2015/2436 has resulted in amendments to several other sections of the Italian IP Code too. In particular, there have been significant changes in the relationship between opposition proceedings and actions on the merits, with greater emphasis on the role of the Italian Patent and Trademark Office. These new procedural rules will enter into force in 2023. The reform has also introduced new rules on certification, collective and geographical trade marks.

However, the changes highlighted above constitute the most prominent good news for trade mark owners, enabling them to enforce their exclusive rights more effectively. When the courts of merit begin to apply the new rules, we will understand how and to what extent trade mark owners and consumers will feel the benefits. But should Italian courts apply the new regulations in a faithful and coherent way, the benefits for consumers and trade mark owners alike will surely be significant. ●



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# Low marks for luxury goods decision

Victor Povid questions the conclusions reached by the EUIPO

**In this decision**, the EUIPO Opposition Division (OD) upheld in its entirety an opposition by Elena Sivoldaeva, a designer of “exclusive jewellery” (the Opponent), against the extension of protection within the EU of international registration No. 1434875, filed by Aditya Vitthal Choksi and others (the Holder).

The opposition was based on the single ground of Article 8(1)(b) EUTMR (risk of direct or indirect confusion), and although the decision entailed a straightforward comparison of the respective trade marks and goods using the well-established tests, it appears to this author that the OD came to a questionable conclusion when comparing the marks, which concerned class 14 (jewellery, precious and semi-precious gems, and the like).

## COMPARISON OF THE SIGNS

The OD carried out a comparison of the marks taking into account a global appreciation of visual, aural or conceptual similarity (as per SABEL<sup>1</sup>), and considered that both marks may be perceived by part of the relevant public as figurative marks consisting of combinations of curved or spiral lines without any particular resemblance or meaning. However, another part of the public may perceive the signs as being composed of the letters E and S in a highly stylised typeface. Therefore, the OD found it appropriate to limit its examination to that part of the public. In this regard, the OD stated that if a significant part of the relevant public for the goods at issue may be confused about the origin

of the goods, this is sufficient to establish a likelihood of confusion, and it is not necessary to establish that all actual or potential consumers of the goods are likely to be confused.

The OD found that the combination of the letters E and S in both marks has no particular meaning for the relevant goods and therefore was distinctive to a normal degree. Although the letters in the contested sign are surrounded by an ellipse, the OD found that for marks consisting of both verbal and figurative components, their verbal component usually has the stronger impact on the consumer, since the public more easily refers to these signs by their verbal elements (as per SELENIUM-ACE<sup>2</sup>).

Visually, the OD found the signs to coincide in the letters E and S and that the letters “share a very similar stylised typeface”, since the ends of the letters in each mark are curved or spiral-shaped and the lower part of the letter E overlaps with part of the letter S. It conceded that the signs differ in the ellipse around the letters in the opposed sign and in the position of the letters, with the S being placed slightly in front of the E in the case of the earlier mark. Therefore, the OD concluded that the marks are visually similar to an “average degree”.

## CONTRARY ARGUMENT

In this writer’s opinion, it is possible to argue the contrary. The earlier mark could be perceived as “SE” and the later mark as “ES”, and the stylisation in the marks is only superficially similar since the stylisation of the letters in the earlier mark gives the letters a more uniform appearance. This would not go unnoticed by the average consumer (taking into account the OD’s observation that a relatively high degree of attention on the part of the consumer is assumed for many of the goods in question, as they fall into the luxury category and may be given as gifts).

“ The OD made some questionable assertions, as the earlier mark could be read as ‘SE’ rather than ‘ES’ ”



Aurally, the OD found that the signs are identical, given that they coincide in “all of their sounds”, namely “ES”. Again, this writer finds this to be a stretch, to say the least, bearing in mind that the earlier mark could arguably be considered as “SE”, given the order in which the letters S and E appear and the tendency to scan letters from left to right, even though the letter S is placed lower than the letter E.

Conceptually, the OD found that neither of the signs has a meaning for the relevant public and this aspect did not influence its assessment of the similarity of the signs.

The Opponent did not claim its mark to be distinctive by virtue of intensive use or reputation, and the OD found the earlier mark to have no meaning for the goods in question from the public’s perspective. Therefore, its distinctiveness was considered normal in the global assessment of likelihood of confusion.

#### QUESTIONABLE ASSERTIONS

The OD decided: that the contested goods were partly identical and partly similar to varying degrees when compared to the Opponent’s goods, with the average consumer’s degree of attention varying from average to high; that the earlier mark had a normal degree of inherent distinctiveness; and that the marks were visually similar to an average degree, aurally identical but conceptually neutral since they have in common the letter combination “ES” stylised in a very similar way.

It also decided that the marks differ only in some less relevant aspects, such as the ellipse around the letters “ES” in the contested sign. As a result, the OD found a likelihood of confusion or indirect confusion, and that even the part of the public that pays a higher than average degree of attention may be confused regarding the origin of the goods in question.

In this author’s opinion, when making its comparison of the marks, the OD made some questionable assertions, the biggest being to overlook the fact that the earlier mark could be considered as “SE” rather than “ES”, as well as in stating that the stylisation is similar and that the marks were “aurally identical” because they contained the same letters (even though they appear in a different order). These factors, together with the OD’s finding that the average consumer would pay a relatively high degree of attention before making a purchase, should arguably have led the OD to conclude that there would be no likelihood of confusion.

This raises the issue of whether the average consumer would be likely to confuse the letters “ES” and “SE”, since: (a) it is trite trade mark law that the average consumer would pay more attention when comparing shorter marks; and (b) the average consumer would pay careful attention given the goods in this case. As the OD noted, letters play a more important role since the average consumer finds it easier to refer to marks by their verbal elements than by their stylisation. Therefore, it is arguable that the fonts would not overcome the differences between the verbal elements. Moreover, if the average consumer of these goods is paying a greater degree of attention, the stylisation may actually serve to further distinguish the marks.

1 [1997] C-251/95  
2 [2005] T-312/03

#### KEY POINTS

- ✦ The OD overlooked the fact that the opposed mark could be perceived as “SE” rather than “ES”
- ✦ The OD’s assertion that the marks were “aurally identical” is questionable
- ✦ Letters are often key because the average consumer refers to marks by their verbal elements

#### MARKS

##### EARLIER MARK



EUTM No. 13745609

##### CONTESTED SIGN



IR No. 1434875



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# Court says no to Nokia

An unusual opinion on pronunciation caught the eye of Rose Smalley

**The EUIPO Opposition** Division (OD) has rejected an opposition filed by Nokia, based on its EU and Finnish trade mark registrations for NOKIA in classes 9, 38 and 42 (the Registration), against the registration of a figurative mark including the word KOKIYA in class 9 (the Application), after finding that no likelihood of confusion exists.

At the outset, the OD reiterated that the global assessment to establish whether a likelihood of confusion exists includes evaluating a number of interdependent factors: (a) similarity of the signs; (b) similarity of the goods/services; (c) the distinctiveness of the earlier mark; (d) the distinctive and dominant elements of the conflicting sign; and (e) the relevant public.

The OD proceeded regarding (b) as if the contested goods were identical to those covered by Nokia's specification (as the best light in which the opposition could be examined) and, regarding (c), assuming that Nokia's Registration had some form of enhanced distinctiveness.

## THE RELEVANT PUBLIC

The reasonably well-informed, observant and circumspect average consumer was identified as a member of either the public at large or a professional public (engineers active in the field of electronics, for example), whose degree of attention would vary from average to high depending on the nature of the goods or services, frequency of purchase and price.

## COMPARING THE SIGNS

Despite the letters O, K, I and A occupying the same part of both signs, the OD emphasised that consumers would focus on the difference in their first letters, which are "clearly perceivable and pronounceable".

Verbally, although it is usual for the verbal component of a sign to have a stronger impact than figurative elements, the OD stated that the Application's highly stylised, feminine silhouette was "striking", at the front of the

contested sign and of significant size. It therefore found a low degree of similarity.

In what may come as a surprise to UK-based readers, the OD held that the relevant public will pronounce NOKIA as only two syllables, whereas the Application's sign has three. The unusual conjunction of the letters I and Y also had a strong impact, leading the OD to find the signs aurally similar to an average degree.

While the word elements of the signs conveyed no meaning, the figurative element of the Application was sufficient for the OD to find that the signs were not conceptually similar.

## LIKELIHOOD OF CONFUSION

Notwithstanding finding some similarity between the signs, and assuming the goods to be identical, the OD still held that a likelihood of confusion or association could be safely excluded – even where only an average degree of attention is paid. The OD observed that the overall impression was "entirely different" based on the dissimilarities identified, adding that the signs' short length would facilitate the relevant public to "perceive easily all their differences".

The OD also dismissed Nokia's further arguments: first, based on distinguishable earlier case law (by which the OD was not bound, in any event); and second, stating that there was no reason for consumers to believe the Application to be a new or extended version of NOKIA. Nokia's observation that it enjoyed a reputation came too late to be considered (after the expiration of the opposition period).

At the time of writing, the decision is still open to appeal.

## KEY POINTS

- + Dominant or distinctive figurative features in a composite mark can distinguish a sign and eliminate confusion, even where the verbal elements are similar
- + Differences in the first letters of a verbal element can be persuasive given consumers' usual focus
- + All arguments on which you seek to rely must be made prior to the expiration of the opposition period
- + Any case law referenced should be genuinely comparable, but is not binding on the EUIPO

## MARK

THE APPLICATION



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# About a burger

Using practical experience was deemed appropriate, reports Leanne Gulliver

**Perfetti van Melle** SpA (Perfetti), an Italian confectionery manufacturer, sought to register the 3D shape shown below in relation to a candy hamburger for class 30 goods under EUTM No. 18003438 (the 3D Mark). The Board of Appeal (BoA) upheld the Examination Division's (ED) decision refusing the registration of the 3D Mark for some of the class 30 goods.

The ED had accepted the application for "sugar; coffee; cocoa" in class 30, but refused the registration of the mark for the remainder of the class 30 goods on the basis that, contrary to Article 7(1)(b) EUTMR, the 3D Mark is devoid of any distinctive character for "caramels [candy]; confectionery; sponge cakes; chewing gum; chocolate; confectionery containing jelly; fruit jellies [confectionery]; gum sweets; lollipops; toffee; candy mints; non-medicated lozenges; liquorice [confectionery]" (together, the Refused Goods).

The ED decided that the relevant public would not instantly recognise the shape mark as identifying the origin of the product, particularly as the appearance of the 3D Mark does not significantly depart from the norms and customs of the relevant sector.

Perfetti argued that: (a) the ED did not substantiate the claim that the shape of the mark does not differ from the forms commonly used in trade; and (b) its own evidence (namely, Google searches) demonstrated that the 3D Mark was atypical of what is in the market (for example, because the "hamburger" is sliced into six equal, triangular parts).

In maintaining its refusal, the ED held that it may base its examination on facts resulting from practical experience acquired from the marketing of mass consumer goods. It also held that the six-piece configuration does not serve to identify origin; only that the product may be shared. Perfetti then appealed to the BoA.

## BoA DECISION

In dismissing the appeal, the BoA held that the 3D Mark does not differ substantially from shapes commonly used in trade and will not enable the target consumer to immediately distinguish Perfetti's goods from those with a different commercial origin.



Perfetti's own evidence disclosed examples of confectionery shaped as hamburgers, which served to demonstrate that the shape is likely to be regarded by the consumer as a way of presenting the goods and not as an indication of their commercial origin.

The ED was correct to base its examination on facts resulting from practical experience. An applicant is expected to provide specific and substantiated information demonstrating the distinctive character of the trade mark applied for, given that it is in a more appropriate position to do so thanks to its knowledge of the market.

## ALTERNATIVE PROTECTION

Perfetti has since appealed the BoA's decision, but it was not possible at the time of writing to determine the arguments on which this was based, or whether it has reserved its right to a secondary claim of acquired distinctiveness. Notably, another, similar application by Perfetti, EUTM No. 18003180 (shown right), was also refused for being non-distinctive in respect of the same Refused Goods.

While Perfetti has been unable to secure registered trade mark protection for the product, it has protected the shape through two registered Community designs – a route which does not include any substantive examination.

## KEY POINTS

+

The shapes of goods and their packaging are capable of being registered as trade marks. However, for a mark to fulfil its origin function, it must be distinctive

+

All categories of marks are to be treated equally, but the average consumer is accustomed to identifying origin by use of a word mark or figurative mark and not a shape or the shape of packaging alone

+

Only marks that depart significantly from the norms of the relevant sector may have the necessary distinctiveness to fulfil the origin function

## MARKS

EUTM No.  
18003438



EUTM No.  
18003180



RCD  
3757277



RCD  
4681435



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# Polo gains partial victory

Yet Dale Carter believes too narrow a view was taken

The EUIPO Opposition Division (OD) refused registration of the Contested Sign shown below for various types of protective headgear in class 9 and leather goods and bags in class 18 following an opposition from The Polo/Lauren Company (the Opponent). However, the opposition failed in respect of various types of safety equipment in class 9 and “gut for sausages” in class 18. The opposition was based on Articles 8(1)(b), 8(4) and 8(5) EUTMR, but was decided under 8(5) and 8(1)(b).

The OD led its assessment of the opposition based on Article 8(5) for the Opponent’s second pleaded mark. That registration had a reputation for bags and wallets in class 18 and clothing, footwear and headgear in class 25, arising in part from the Opponent’s fashion products, as well as its sponsorship of various sporting events, including via branded clothing.

The OD found the marks similar and that a link would arise for certain goods, but not others. For example, a connection was found between the Opponent’s headgear and the Applicant’s protective headgear. The rationale put forward was that protective headgear could relate to sport, and consumers of sports equipment may overlap with consumers of the Opponent’s clothing. Where a plausible connection existed between goods, the OD found that unfair advantage would be taken of the Opponent’s mark.

However, the OD found that there was no connection between Opponent’s reputed goods and the Applicant’s safety, rescue and life-saving

apparatus because such items would not relate to the “fashion sector”. A plausible connection existed between the Opponent’s reputed goods and the Applicant’s class 18 goods because the contested goods were fashion accessories, or raw materials for fashion accessories.

For the goods surviving the Article 8(5) opposition ground, the OD went on to assess a likelihood of confusion vis-à-vis the Opponent’s first and fourth pleaded marks. As regards the first, no likelihood of confusion was found because the goods were deemed dissimilar. Despite there being some identical and similar goods in play for the fourth mark, there was no likelihood of confusion because the marks were deemed distinguishable.

Ultimately, this decision reminds us that although Article 8(5) applies to dissimilar goods, there is no guarantee that a reputed mark can be successfully enforced against all goods. There must be a plausible connection between the goods to enable consumers to associate the marks and for this to give rise to damage.

Here, the OD appears to have applied Article 8(5) relatively narrowly, confining the “connection” between goods in classes 9 and 25 to categories for which there is an overlap in producers, distribution channels and the relevant public. Arguably, the OD should have upheld the opposition under Article 8(5) in respect of the Applicant’s “safety apparatus [for protection against accident or injury]” where these could be used in a sports setting.

Despite citing a number of earlier decisions relating to figurative “Polo” marks of a similar nature, the OD seems to have tried to distance itself from those earlier decisions. Perhaps this is why it considered it appropriate, in this instance, to apply Article 8(5) relatively narrowly.

## KEY POINTS

As a ground of opposition, Article 8(5) EUTMR is not certain to prevail against all goods and services. There must be a plausible connection between the goods and services for a link to be established

The OD may choose to assess an evidence-heavy opposition ground first, despite there being alternative grounds which do not require evidence to be considered

The EUIPO is not bound by its previous decisions

## MARKS

### CONTESTED SIGN



THE OPPONENT'S FIRST PLEADED MARK



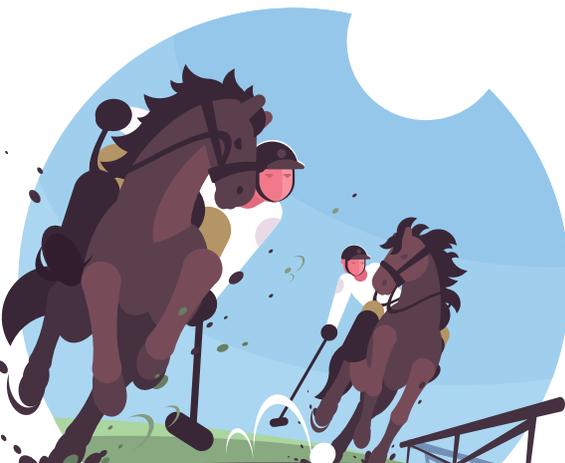
THE OPPONENT'S SECOND PLEADED MARK



THE OPPONENT'S FOURTH PLEADED MARK

POLO RALPH LAUREN

EUTM No. 11943578



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# Is Monster out of energy?

Its recent opposition certainly missed the mark, writes Emila Petrossian

**Monster Energy Company** (Monster) brought an opposition against an EU trade mark (EUTM) application by Hollywood Marketing SLU (Hollywood) for MONSTER in classes 35 and 43, based on Monster's earlier EUTM registrations for MONSTER ENERGY and its unregistered UK right for MONSTER.

## CONFUSION QUESTION

When considering the similarity of the services, the Opposition Division (OD) found that the class 35 services in relation to advertising, promotional, online advertising and publicity services were similar and coincided in the general nature, purpose and method of use. However, the remaining class 35 terms and the entirety of class 43 were dissimilar as they were of a different nature, purpose and method of use.

Monster had argued that both companies were offering their services on the same website and therefore there would be a likelihood of confusion. However, this was merely an exception and not a rule, so it was held that normally the commercial origin and the distribution channels for the services were different.

As similarity of the services was held only in part in class 35, the average consumer was identified as a business consumer with specific professional knowledge and expertise. This narrowed the average consumer group considerably.

Moving on to the marks, although Monster's earlier registration was for MONSTER ENERGY, not MONSTER per se, the general focus of the consumer's attention is on the beginning of a sign, as this is typically the first element that catches their attention. Therefore, as the word MONSTER appears at the beginning of Monster's earlier registration, the general impression created is that the marks are similar to an average degree.

The OD therefore rejected Hollywood's application for MONSTER in respect of

services connected to advertising and publicity in class 35.

## PASSING OFF

The claim for passing off was based on Monster's earlier UK unregistered mark for MONSTER in respect of "non-alcoholic beverages" only, because promotional services had been assessed in the first part of the opposition.

However, as the OD had already compared the services in the first part of the opposition and found that the remaining services in classes 35 and 43 were dissimilar, there was no misrepresentation and the claim for passing off failed.

At the time of writing, no appeal had been filed.



## KEY POINTS

- + Likelihood of confusion will only exist where the relevant public believes or is likely to believe that the goods and services in question come from the same undertaking or are economically linked
- + Claims of passing off will fail if any one of the requirements is not satisfied
- + Passing off may fail if the goods and services are not identical or similar, as it requires there to be evidence of misrepresentation



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# Game, set and match



Gavin Stenton reflects on a defeat for Dogmatch

**The EUIPO Opposition** Division (OD) recently upheld an opposition by Match Group (Match) against Fönstria AB's (Fönstria) EU trade mark application for the figurative mark shown below (the Contested Sign) in classes 35, 38 and 45.

Match invoked Article 8(5) EUTMR (among other grounds) claiming a reputation in its EU trade mark registration for the word mark MATCH.COM in class 42 (the Match Mark) and arguing that use of the Contested Sign would take unfair advantage of, or be detrimental to, the distinctive character or repute of the Match Mark.

## CONVINCING EVIDENCE

In doing so, Match filed a "vast" amount of evidence (much of which was confidential in nature) in support of its reputation in the Match Mark for "information and consultancy services in the nature and field of online dating and introduction services" in class 42. This evidence, the majority of which related to Match's UK operations, demonstrated use of the Match Mark over a substantial period, a substantial market share, extensive press coverage, significant advertising campaigns, and very large turnover, subscriber and viewer figures.

On the basis of the UK's size and population, the OD concluded that Match's evidence was sufficient (in geographical terms) to demonstrate a high degree of recognition among the relevant public in the EU, especially in the UK, for the services mentioned above.

## SIMILARITY

Having established a reputation, the OD then went on to hold that the marks in question

were visually, aurally and conceptually similar to at least an average degree, and that, considering the high degree of recognition enjoyed by the Match Mark, it was "likely that the relevant consumer would link the Contested Sign to [MATCH.COM], as [it] could be seen as referring to a specific type or a segment of the services offered under [MATCH.COM]".

“*The Contested Sign would exploit the attractive powers and distinctiveness of the Match Mark*”

Indeed, the extent of the Match Mark's reputation was such that this link was held to apply to all of the services covered by the Contested Sign (including, by way of example, advertising services in class 35 and animal adoption services in class 45), and not just those relating expressly to social networking and chatroom services.

Turning to the issue of unfair advantage, the OD concluded that the Match Mark's image would be transferred to the Applicant's services and the Contested Sign would therefore exploit the attractive powers and distinctiveness of the Match Mark, thereby giving the Applicant an unfair advantage/boost by free-riding on the considerable reputation of the Match Mark.

Consequently, the OD upheld the opposition under Article 8(5) EUTMR and did not go on to consider any other grounds for reasons of procedural economy.

## KEY POINTS

- ★ This case presents a useful reminder of the type and volume of evidence required to establish a reputation, and shows that evidence of a reputation in a single EU Member State can be sufficient
- ★ Rights owners should retain detailed, dated evidence and records showing the use and reputation of their registered trade marks across all relevant markets and territories
- ★ After the Brexit transition period, UK-only rights and reputation will no longer be invocable against EU trade marks

## MARK

CONTESTED SIGN



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# Sky launches another attack

A figurative addition didn't guarantee distinctiveness, reports Jasmine Sihre

**Given Sky Ltd's** vast reputation in its SKY marks and its thorough enforcement of its IP rights, it does not come as a surprise to see the EUIPO's Opposition Division (OD) uphold an opposition against a third party that filed a SKY formative mark for identical goods.

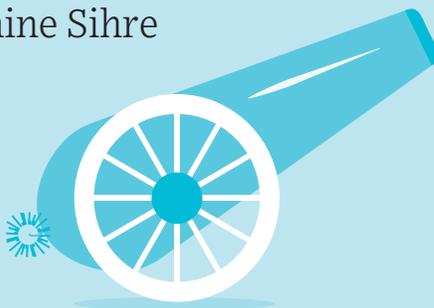
Guangdong Dabanya Intelligent Technology Co. Ltd (Guangdong) filed an EU trade mark application for a SKY DOLPHIN mark in class 9. Sky Ltd (Sky) opposed that, relying on its stylised and word marks for SKY on the grounds of Articles 8(1)(b), 8(4) and 8(5) EUTMR.

## AMPLE EVIDENCE

Sky filed observations to supplement the opposition, including a large amount of evidence arguing the likelihood of confusion and demonstrating the vast reputation of the SKY mark in the EU. This included evidence of continued use of the mark for more than 30 years in the EU, generating a group revenue of more than £7bn between the years 2013 and 2017. Guangdong did not file any observations in reply, and the OD proceeded to assess the merits of the opposition based on a comparison of the marks and the evidence filed by Sky.

The OD considered the evidence and decided that it was sufficient to establish a successful opposition based on Article 8(1)(b). The OD therefore held that it did not need to consider the other grounds of opposition, namely Articles 8(4) and 8(5) EUTMR.

First, the OD looked at the overlap in the class 9 goods. The goods covered by Sky's earlier trade mark included "chargers; battery chargers; video screens; [and] telephone apparatus". The goods in the application included "chargers; battery chargers; video screens; [and] smartphones". The OD found that there was an identical overlap in the goods, including in "telephone apparatus" and "smartphones", because "smartphones" are included within Sky's broader term "telephone apparatus".



## DISTINCTIVENESS WEIGHED

Next, the OD compared the signs and weighed up the distinctiveness of the marks. The OD considered the marks to be visually, aurally and conceptually similar to one another. In particular, the OD found that the first and dominant parts of both the Application and the earlier mark is SKY. That part of the marks attracts the consumer's attention first, because the consumer reads from left to right.

While the word DOLPHIN and the Dolphin Device add some distinctiveness to the application mark, the OD decided that even a highly attentive consumer may consider that the application mark is a new version or a brand variation of Sky's marks. This raises a risk that consumers would be confused between the businesses and the business offerings. At the very least, the consumer would associate the application mark with one of Sky's marks and/or brands.

Based on these comparisons, the OD did not find the need to compare all the marks which Sky relied upon and was able to successfully uphold the opposition, awarding costs against Guangdong.

The decision was open to appeal at the time of writing.

## KEY POINTS

- + Adding stylisation, distinctive words and/or device elements to a mark will not necessarily be enough to distinguish that mark from another company's earlier rights, especially where the goods and services are identical
- + In a specification, narrowly defined terms may still be considered identical to the goods/services of the earlier rights holder if the earlier registration has broad and non-specific terms in the specification

## MARKS

### EARLIER MARKS



### CONTESTED SIGN



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# Beyond bad taste?

Rose Franckeiss looks forward to future tests of a liberal approach

**Fack Ju Göthe** is a 2013 German comedy film, which was followed by the sequels *Fack Ju Göthe 2* and *Fack Ju Göthe 3*. The phrase is clearly an intentional misspelling of “f\*ck you (Goethe)”, which is commonly understood

to be a vulgar English-language expression.

The first film was very successful and reached an audience of almost 7.4 million in Germany.

In 2015, Constantin Film Produktion (Constantin), one of the films’ production companies and the Appellant in these proceedings, filed an EU trade mark application for the word mark FACK JU GÖTHE (the Sign), covering 13 classes of goods and services. The EUIPO Examiner refused the application on the basis of Article 7(1)(f) EUTMR, deciding that the Sign was contrary to accepted principles of morality. Constantin appealed the decision to the EUIPO Board of Appeal and the General Court, but was unsuccessful in both instances, and so it appealed to the CJEU.

## WAS THE PHRASE IMMORAL?

The CJEU held that the phrase “accepted principles of morality” refers to the fundamental moral values and standards to which a society adheres at a given time, as determined by reference to the social context, including (where appropriate) cultural, religious and philosophical differences. The examination cannot be

confined to an abstract assessment of the mark applied for.

So, in order to fall foul of this ground, the sign in question must be perceived by the relevant public as being contrary to such norms. Simply being “in bad taste” is not sufficient. Taking these principles into account, the CJEU found that the General Court had erred in law by finding that the Sign was contrary to them.

Proceeding with its own application of these principles to the Sign, the CJEU referred to the commercial success of the films in question and noted that their titles did not appear to create any controversy at the time of their release. Further, no concrete evidence had been put forward to suggest that the German-

speaking public at large would perceive the Sign as contravening the fundamental moral values and standards of society. The CJEU therefore concluded that the registration of the Sign was not precluded by this ground.

## CONTEXT IS CRUCIAL

This decision highlights the importance of context and the perception of the relevant public when assessing an objection to registration under this ground. Arguably, this decision indicates a relatively liberal approach and it will be interesting to see how examiners deal with the application of this ground moving forward.

“*The CJEU referred to the commercial success of the films and noted that their titles did not appear to create any controversy*”

## KEY POINTS

- ✦ The CJEU held that the sign FACK JU GÖTHE is not contrary to accepted principles of morality
- ✦ Such an examination is based on “the perception of a reasonable person with average thresholds of sensitivity and tolerance”, meaning that social context will be considered
- ✦ Concrete evidence will be required to support any decision to reject an application under this ground



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# Arcade owner wins out

Adeline Weber Bain hails the end of a lengthy saga



## KEY POINTS

+

The GC's finding that there was no risk of a reduction in the "attractiveness" of the earlier marks was not sufficient to prove that there was no risk of unfair advantage being taken of the distinctive character or repute of those marks

+

The line of authority derived from *Praktiker* does not affect the protection of trade marks registered before that judgment was delivered

+

The absence of any precise statement of the goods to which the "retail services" covered by the earlier trade mark may relate would not result in the rejection of an Article 8(1)(b) ground of opposition from the outset

## MARKS

IR No. 1017273



IR No. 982021



IR No. 1007952



**This judgment** of the CJEU has put an end to an 11-year legal battle, as Tulliallan Burlington (Tulliallan), the owner of a famous luxury shopping arcade in London, has finally claimed victory against Burlington Fashion GmbH (BF), a German retailer of socks.

### CASE HISTORY

In 2009 and 2010, Tulliallan filed oppositions against BF's applications for the protection of its international registrations in the EU for the word mark BURLINGTON and three figurative marks containing that same word, covering classes 3, 14, 18 and 25 (all shown below). Tulliallan invoked its three earlier UK trade mark registrations (registered in 2003) and its EU mark, covering classes 35, 36 and some also covering class 41. Tulliallan objected to BF's goods in classes 3, 14 and 18, relying on three grounds: the infringement of articles 8(5), 8(4) and 8(1)(b) EUTMR.

The Opposition Division (OD) upheld the oppositions, but the Board of Appeal annulled these decisions. The cases then went before the General Court (GC), which dismissed Tulliallan's pleas in their entirety.

### INFRINGEMENT OF ARTICLE 8(5)

The GC found that Tulliallan had not shown that the use of the marks applied for would make the earlier trade marks "less attractive".

The CJEU disagreed with the GC's finding and reminded us of the three cumulative conditions required to show infringement of Article 8(5): (a) a link; (b) reputation of the earlier mark; and (c) a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

The CJEU found that the GC had not assessed the evidence provided by Tulliallan in support of the ground of opposition and erred in law in the way it concluded that the third condition was not satisfied. Indeed, the GC's multiple references

to "attractiveness" were ambiguous and insufficient to show that there was a risk of unfair advantage or detriment to the distinctive character or repute of the earlier mark. Moreover, the GC's finding did not relate directly to any of the tests in Article 8(5).

### INFRINGEMENT OF ARTICLE 8(1)(b)

When assessing infringement of Article 8(1)(b), the GC relied on *Praktiker* [C-418/02] and argued that the concept of "retail services" in class 35 includes a shopping arcade's services. However, it then concluded that the goods and services here were not similar or complementary.

With regards to the GC's approach, the CJEU first pointed out that Tulliallan's three UK registrations were not affected by the obligation arising from *Praktiker* because they had been registered before the judgment was delivered.

Secondly, the absence of a precise statement of the goods that may be sold in the various shops comprising a shopping arcade (such as the shopping arcade referred to by Tulliallan's earlier trade marks) could not immediately preclude any association between those shops and the goods of the mark applied for.

Finding as the GC had done would mean precluding a trade mark owner from relying upon its earlier mark to oppose a later one, and not recognising the distinctive character of an earlier mark, even though it is still registered and has not been declared invalid. Essentially, it would be possible to determine the precise goods covered by the "retail services" by requesting proof of use during the proceedings.

The GC therefore erred in law when assessing infringement of Articles 8(5) and 8(1)(b).



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# Going for global

Roshani Muniweera offers the tale of a problematic appeals decision

**This case relates** to opposition proceedings between Equivalenza Manufactory SL (EM) and ITM Enterprises SAS (ITM). In brief, EM filed an EU trade mark application for a mark, shown below, covering “perfumery”. ITM opposed EM’s application under Article 8(1)(b) EUTMR, on the grounds there was a likelihood of confusion with its earlier mark (also shown below), protected in several EU territories and covering “cologne, deodorants for personal use (perfume), [and] perfumes”. The Opposition Division upheld ITM’s opposition on the grounds that there was a likelihood of confusion on the part of the relevant public in the Czech Republic, Hungary, Poland and Slovenia. EM appealed.

The EUIPO’s Second Board of Appeal (BoA) dismissed the appeal, holding that the goods were identical and, while the marks were conceptually dissimilar, there was an average degree of visual and phonetic similarity between the signs, resulting in a likelihood of confusion when assessed globally.

EM then brought an action before the General Court (GC) to annul the BoA’s decision. The GC upheld the appeal, finding that the signs at issue have an average degree of phonetic similarity, produce a different overall visual impression and are conceptually different due to the additional words BLACK and BY EQUIVALENZA. The GC annulled the BoA’s decision, holding that it had erred in law in finding a likelihood of confusion.

## NEXT STEPS

The EUIPO appealed the GC’s decision, arguing that the GC contradicted itself by noting a low degree of similarity due to the presence in both signs of the letters L, A, B, E and L, yet going on to exclude visual similarity by stating that the overall impression produced by each sign was “visually different”. The CJEU agreed with

the EUIPO’s allegation of “contradictory reasoning” when it came to the visual similarity of the signs.

The EUIPO also submitted that the GC made a “methodological error” by taking into account the circumstances in which the goods were marketed at the stage of comparing the signs. Further, the EUIPO claimed that the GC committed “errors of law” affecting the assessment of the similarity of the signs at issue. The CJEU agreed, noting that the GC had incorrectly given visual differences between the signs precedence over phonetic similarity.

In addition, the CJEU found that the GC had erred in law by dispensing with the global assessment of the likelihood of confusion on

the basis that it had found that the conceptual dissimilarity between the signs outweighed their phonetic similarity. The CJEU explained that the GC may only dispense with the global assessment of the likelihood of confusion where, despite visual or

phonetic similarities, one of the signs has a clear and specific meaning that can be grasped immediately by the relevant public, producing a different overall impression. The GC had not indicated that this was the case.

The CJEU therefore supported the BoA’s conclusion that there is a likelihood of confusion between the signs and that the presence of the additional elements BLACK and BY EQUIVALENZA are not sufficient to rule it out. EM’s appeal was rejected and the CJEU dismissed the action.

## KEY POINTS

- ✦ Following some inconsistent case law, the CJEU makes clear that marketing factors are not to be taken into account at the stage of assessing similarity. Marketing factors are relevant only at the stage of the global assessment of the likelihood of confusion
- ✦ Conceptual differences between signs may outweigh visual and phonetic similarities where one of the signs has a clear and specific meaning that can be grasped immediately by the relevant public. Only in such an exceptional case can you dispense with the global assessment

## MARKS

EM’s EUTM



ITM’s EUTM



“  
*The Court may only dispense with the global assessment where one of the signs has a clear and specific meaning that can be grasped immediately*”



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# Gloomy days for Halloumi

Assessment of collective trade marks should be no different from that of traditional trade marks, notes Désirée Fields

**The Foundation for** the Protection of the Traditional Cheese of Cyprus named Halloumi is the proprietor of the EU collective mark HALLOUMI, registered for cheese. The Foundation opposed an application by MJ Dairies EOOD, a company established in Bulgaria, to register the word and figurative sign shown below as an EU trade mark for cheese and related products.

The EUIPO's Opposition Division rejected the opposition, and the Fourth Board of Appeal dismissed the Foundation's appeal, finding no likelihood of confusion between the two marks pursuant to Article 8(1)(b) of Regulation (EC) No. 207/2009 (as replaced by Regulation (EU) 2017/1001).

The Foundation's subsequent appeal to the General Court (GC) was dismissed on the basis that, due to the weak distinctive character of the earlier mark, the existence of a low degree of visual, phonetic and conceptual similarity was insufficient to establish a likelihood of confusion despite the respective goods being partly identical. The Foundation appealed to the CJEU.

## CRITERIA ESTABLISHED

The CJEU confirmed that previous case law establishing the criteria for an assessment of likelihood of confusion was applicable to cases involving collective marks. Further, despite collective marks designating the geographical origin of goods or services being capable of registration, the CJEU did not find that this allowed such signs to be devoid of distinctiveness. They still had to fulfil their essential function of distinguishing the goods and services of the proprietor's members from those of other undertakings.

Accordingly, the GC had not erred in law in including this factor in its assessment of the likelihood of confusion, after concluding that the term "Halloumi" was of weak distinctiveness, as it designates a type of cheese produced according to a certain recipe.

However, the CJEU reiterated that the likelihood of confusion assessment is a global one, taking into account all relevant factors and their interdependence. Here, the GC had relied on the premise that, in cases where the earlier mark is of weak distinctiveness, a likelihood of confusion must be ruled out as soon as it is established that the similarity of the marks, in itself, does not allow such a likelihood to be established. This was found to be incorrect, as the weak distinctive character of an earlier mark did not preclude the existence of a likelihood of confusion.

Accordingly, the GC had erred in failing to examine whether the fact that the marks were only similar to a low degree was offset by, among other things, the identity of the goods concerned, namely cheese.

## CLEAR DIRECTION

From here, the case goes back to the GC to conduct a global assessment of the likelihood of confusion, including an assessment of whether the low degree of similarity of the marks is offset by the higher degree of similarity, or even identity, of the goods covered by them. It is clear following this judgment that case law relating to likelihood of confusion applies also to collective marks and that the assessment of the distinctiveness of such marks should not differ from that of other trade marks.



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With thanks to Hannah Hallaway, Trainee Solicitor.



## KEY POINTS

✦ The consideration of the distinctiveness of an earlier mark for the purposes of assessing likelihood of confusion should not be different for EU collective marks

✦ When assessing the likelihood of confusion in cases concerning a weak distinctive character of the earlier mark and low similarity between the marks concerned, it is necessary to consider whether this can be offset by other factors, such as the identity of the goods covered

## MARK

### CONTESTED MARK



# An all-star game?

Sarah Husslein suggests it might have been, had the Applicant taken the offensive

**In this decision**, the Hearing Officer of the UK IPO (HO) found that the application for ALL STARS (shown below) should be refused under s5(2)(b) of the Trade Marks Act 1994 (the Act).

## BACKGROUND

On 23rd March 2018, Samera Hussain (the Applicant) filed an application to register the ALL STARS figurative mark in respect of “services for providing food and drink; restaurant, bar and catering services” in class 43 (the Application).

All Star Leisure Group Ltd (the Opponent) filed an opposition, alleging a likelihood of confusion with its UK and EU trade mark registrations for the figurative marks shown below, covering various recreational services in class 41 and/or services for providing food and drink in class 43 (the Earlier Marks). The Applicant denied the Opponent’s claims. However, while all the Earlier Marks had been registered for more than five years and were therefore subject to a use requirement, the Applicant did not put the Opponent to proof of use. Neither party filed evidence or requested a hearing, but the Opponent filed submissions instead.

## COMPARISON

The HO focused on the general public and worked on the basis that consumers are likely to select the services via visual means, having seen the mark at the venue, via the internet or through advertisements. However, while confirming that the selection process will be primarily visual, the HO felt that aural considerations cannot be entirely ignored, notably relating to word-of-mouth recommendations.

The HO considered the services to be identical, either because they use the same wording in

their respective specifications or because they fall within the broad category of services covered by the other side’s mark.

Turning to the comparison of the marks, the HO found the words ALL STAR to be dominant in the Earlier Marks due to their size and position within the marks. The other elements would play a lesser role in the overall impression because they either describe the nature of the services or are merely decorative. The same reasoning was applied to the Application. The HO confirmed that the inherent distinctiveness of the Opponent’s Earlier Marks is average.

Next, the HO confirmed a medium-to-high visual similarity between the marks, as they are dominated by the words ALL STAR(S) on a circular background. The HO denied the Applicant’s argument that the colour combination used in its Application would help in distinguishing the marks. Indeed, despite being registered in black and white, the Opponent’s Earlier Marks could be used in any colour combination, including the same ones as the Applicant’s. Likewise, the aural similarities lie in the identical words ALL STAR(S). Finally, the HO considered the conceptual similarity to be high, as the words ALL STAR(S) would be viewed in the context of American culture, describing a group of people excelling within their particular field.

Overall, the HO found that the Application could be mistaken for the Earlier Marks, leading to a likelihood of confusion. Therefore, the opposition succeeded under s5(2)(b) of the Act, and the Application was refused registration.

## AN IMPORTANT REQUEST

It is not surprising that the HO found in favour of the Opponent here. Ultimately, this decision is a reminder that requesting proof of use from an opponent can be a good defence and could change the outcome of an opposition.

## KEY POINTS

- ✦ It is likely that services for providing food and drink will be selected by visual means
- ✦ The HO found a likelihood of confusion on the part of the relevant public, so the opposition succeeded under s5(2)(b) of the Trade Marks Act 1994
- ✦ Requesting proof of use from the opponent constitutes an important defence and may well have changed the outcome of these proceedings

## MARKS

### THE APPLICATION



### EARLIER MARKS



EAT • DRINK • BOWL



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# No Go for proof of bad faith



Once again the bar was set high, says Sarah De'Ath

**PASTA GO (the Applicant)** applied to register the trade mark shown below for “takeaway food and drink services” in class 43. Kamil Kruk opposed the application under s3(6) of the Trade Marks Act 1994 (the Act), claiming that it had been filed in bad faith.

## BACK STORY

Kruk is the operator of a restaurant chain named Pasta Go! in Poland and owned a Polish registration for a similar logo (shown below). He claimed that the Applicant copied not only the mark but the whole business concept after visiting Kruk’s premises in Poland. He argued that the Applicant sought to gain an economic advantage, to block him from entering the UK market and to trade off the repute of his business. Finally, he claimed that the Applicant had stolen a picture of a takeaway pot from his website and used it in a social media post. Kruk submitted that this behaviour fell short of the standards of acceptable commercial behaviour.

Lukasz Newelski, the controlling mind of the Applicant, denied that he had copied the mark and argued that he had applied for the mark as a way of maintaining “the name and health” of his business.

To support his case, Kruk filed evidence in the form of a witness statement. His evidence also included business accounts, promotional material featuring the mark and used in Poland, and Facebook messages between the Applicant and the Opponent regarding the allegedly stolen image.

## EVIDENCE EXAMINED

The Applicant filed submissions, which included some material considered by the

Registry to be evidence of fact. However, since the Applicant did not refile the evidence of fact in the correct format, it was deemed to be inadmissible.

Nevertheless, the Hearing Officer (HO) found that the evidence submitted by the Opponent was insufficient to support a finding of bad faith. After considering the case law in relation to s3(6) of the Act, as set out in *Red Bull v Sun Mark*<sup>1</sup>, the HO noted that the mere appropriation of a name registered and used abroad is not sufficient to find bad faith – there must be something else involved.

No evidence had been submitted by Kruk to suggest that his restaurants were well known within the UK or that he had a reputation outside Poland. There was also no evidence to suggest that Newelski was aware of Kruk’s intention to enter the UK market. The HO quoted Geoffrey Hobbs QC in the case of *DAWAAT*: that “a vague suspicion that a foreign proprietor may wish to extend its trade in the UK is insufficient to found an objection under s3(6)”<sup>2</sup>. She also noted that the phrase “Pasta Go” was allusive for the goods in question and that the colour combination of red and green is typical for an Italian-themed restaurant. The similarity of the marks was therefore not a decisive factor when assessing the s3(6) ground.

This decision is a reminder that there is a high bar for showing bad faith. An allegation of bad faith should not be made lightly and must be distinctly proved.

<sup>1</sup> [2012] EWHC 1929 (Ch)  
<sup>2</sup> [2003] RPC 11

## KEY POINTS

- + Mere knowledge of another mark outside the UK is not sufficient on its own to support a finding of bad faith
- + Evidence of fact must be filed in the correct format or it will not be admitted by the Registry

## MARK

THE APPLICATION



EARLIER MARK



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# Extend at your own risk

Exercise care when broadening the scope of rights, warns Amelia Skelding

**Maxine Waugh filed** UK Trade Mark Application No. 3356250 for LIPSY COUTURE on 26th November 2018, covering, *inter alia*, “fillers, implants and pharmaceutical preparations for the treatment of lines, wrinkles and other skin conditions” in class 5 and “medical and surgical apparatus and instruments” in class 10. Ownership was assigned to MJW Lipsy Couture Ltd (the Applicant) on 1st April 2019.

The application was opposed by Lipsy Ltd (the Opponent) on 7th March 2019, relying on s5(2)(b), s5(3) and s5(4)(a) of the Trade Marks Act 1994. The Opponent relied on UK Trade Mark No. 3266691 for LIPSY (the 691 mark), covering class 3, *inter alia*, for the s5(2)(b) claim and UK Trade Mark No. 3297238 for LIPSY (the 238 mark) covering classes 25 and 35 for the s5(3) claim. The Opponent also claimed goodwill in the sign LIPSY for the goods and services covered by the earlier marks in respect of the s5(4)(a) claim.

## MARK COMPARISONS

The Opponent argued that COUTURE was non-distinctive in connection with the goods applied for, but the Court affirmed that the word did contribute to the overall impression, albeit less than the more dominant word LIPSY. Overall, the marks were held to be highly similar visually and aurally but only conceptually similar to a medium degree. The 691 mark was not subject to the proof of use requirement so the Opponent could rely on all its class 3 goods, which covered mainly cosmetics and perfumery. The Court held that the goods in the Opponent’s class 3 and the Applicant’s class 5 were both designed to improve the appearance of the user and so were highly similar.

The goods in class 10 were held to be similar only to a medium or low degree. The 691 mark was found to have higher than average inherent distinctiveness, but in the absence of sufficient evidence of use,

it did not benefit from enhanced levels of distinctive character. In respect of the goods in classes 3 and 5, the average consumer was held to be the general public. For class 10, the average consumer was held to be a medical or beauty professional whose level of attention would be average or higher than average. In light of this, a risk of direct confusion was found for a majority of the goods, with the exception of some medical and surgical goods in class 10.

The Opponent’s 238 mark was found to have a reputation in relation to women’s clothing and footwear in class 25 but not for retail services in class 35. Although no likelihood of confusion was found due to the dissimilarity of the goods, the Court found that the average consumer would make a link between the marks because it was plausible that a fashion company might move into goods designed to enhance the physical appearance of the user. However, no link was identified with surgical and medical goods in class 10.

With regards to damage, the claim for unfair advantage was successful but no dilution or risk of detriment to repute was found. The passing off claim also failed.

## LIMITED PROTECTION

While both parties enjoyed some success in this case, it highlights that the protection afforded to big brands is limited and that enhanced distinctiveness typically only relates to the industry in which they operate.

Although some degree of brand extension is acceptable, care must be taken not to extend the scope of rights artificially.

## KEY POINTS

- Non-dominant parts of a mark are not necessarily negligible and may still contribute to the overall impression



- In order to claim enhanced distinctiveness in an earlier right, it is necessary to submit evidence of significant and intensive use in the relevant industry and territory



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# Calendar

Learn, develop and earn CPD hours at our events

We realise that circumstances may have changed for you over the past few months, but we want to reassure you that there are still numerous ways to learn, develop and earn CPD hours with us through our revised events programme.

There are also many ways to earn additional CPD on top of the hours you earn by attending events, including watching recordings of our past events.

For more information about how you can earn CPD hours from home, visit [citma.org.uk/earncpd](http://citma.org.uk/earncpd)

Meanwhile, our confirmed events and those hosted by IP Inclusive are listed below, and we will continue to arrange new, topical virtual events for you. Look out for updates at [citma.org.uk/events](http://citma.org.uk/events)



Our Global IP Webinar Series continues with a look at IP contracts. Find out more at [citma.org.uk/events](http://citma.org.uk/events)

DATE	EVENT	LOCATION	CPD HOURS
22nd June	IP Inclusive – Annual diversity breakfast	Online	1
24th June	Global IP Webinar Series UK: IP contracts	Online	1
7th July	Global IP Webinar Series Latin America: challenges	Online	1
10th July	CITMA Paralegal Webinar Trade mark infringement	Online	1
14th July	CITMA Webinar – IP rights in advertising and on social media, avoiding the #pitfalls	Online	1
15th September	CITMA Lecture – London* Copyright	Allen & Overy, London E1	1
28th September	CITMA Webinar EU case law update	Online	1
12th November	CITMA Webinar SkyKick	Online	1
24th November	CITMA Lecture – London* UK case law update	Baker McKenzie, London EC4	1
4th December	CITMA Christmas Lunch	London	

■ CITMA event ■ IP Inclusive event \* If necessary, in-person events will be moved online

# THE TRADE MARK 20

Q&A



## Lee Curtis

believes he's struck lucky

**I work as...** a Partner and Chartered Trade Mark Attorney in the Manchester office of HGF.

**Before this role, I was...** a Chartered Trade Mark Attorney at Pinsent Masons in Leeds, but I started my career and trained at Cleveland Scott York in London.

**My current state of mind is...** a combination of anxiety about the COVID-19 emergency and feeling reassured that everything still seems to work for me at home. The transition has been seamless.

**I became interested in IP...** through necessity. I left university with an economics degree at the tail end of the recession in the early '90s. By chance, I saw an advert for a Trainee Trade Mark Attorney position and applied, reading up on basic trade mark law before the interview. To my surprise, I was hired. Otherwise, I would probably have become a banker. Sometimes you get lucky.

**In my role, I most enjoy...** trying to marry up the branding objectives of a client and the analytical side of trade mark law.

**In my role, I most dislike...** meetings that last more than an hour.

**My favourite mug says...** nothing, but it has a picture of a koala bear on it. A similar mug has appeared on *I'm a Celebrity... Get Me Out of Here*.



“

*I want to be the first Trade Mark Attorney to go into space*

**In front of me right now is...** a very small chess board and the book *Where to Go When* – soon to be read and hopefully followed. (I'm writing this at home, in case you think I have a very unusual desk.)

**I am most inspired by...** helping others establish a career and build a good life off the back of it.

**My favourite place to visit on business is...** Melbourne, Australia.

**If I were a brand, I would be...** Nike, because of the slogan “Just do it”. I don't like indecision or delay.

**The biggest challenge for IP is...** educating the public and the press about what it actually is.

**The (sort of) talent I wish I had is...** being taller.

**I can't live without...** food and water. I'm pretty sure I could live without most other things.

**My ideal day would include...** having a new experience or meeting someone new and having an interesting conversation.

**In my pocket is...** my wallet, my house keys and an accumulation of odd change.

**The best piece of advice I've been given is...** keep it simple. As Albert Einstein is meant to have said: “If you can't explain it simply, you don't understand it well enough”.

**When I want to relax I...** read, switch on Netflix or work out (after 44 years of avoiding it). Occasionally, I do all three at the same time.

**In the next five years I hope to...** be doing what I currently do and still enjoying it. (And then I want to be the first Trade Mark Attorney to go into space.)

**The best thing about being a CITMA member is...** being asked to answer these questions – and maybe even making a reader laugh!

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