

CITMA REVIEW

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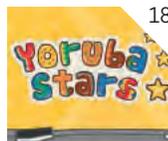
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PRESIDENT'S WELCOME WE'RE BUILDING UP CRUCIAL PARTNERSHIPS

Last year, we were delighted by the success of our campaign on address for service. Since then, we have been in conversation about what more we can do to support the UK profession.

Representation rights before the UK IPO will be a key focus for the rest of this year, and work has already started. Having worked with public affairs firm DRD Partnership on our last campaign, we're pleased to have rehired them for this project. The campaign is overseen by an advisory group that includes CIPA, FICPI-UK and the IP Federation, with whom we will be working closely.

In recent months, we have also entered into partnership with CAFA (Climate Action For Associations). CAFA will support us as we work towards carbon neutrality, offering resources and expertise to us and many other membership and trade associations.

Our work on diversity and inclusion in IP also continues to support the welcoming industry that we all wish to see. Last month, we enjoyed a constructive and informative webinar on what it means to build diverse workplaces and the steps we should be taking to create a culture that is conducive to openness and inclusivity.

We now look forward to our Black History Month seminar in October. Booking is open for this event, which will be chaired by Baron Warren Redfern's Carol Nyahasha.

Bookings for our Autumn Conference are also well under way. The conference will take place using events platform Hopin, allowing us to maximise the learning opportunities and CPD elements we know you value most.

As we go forward with these projects, we are, as always, keen to rely on your support.

Richard Goddard, CITMA President



Stepping up on SUSTAINABILITY

As Richard Goddard noted in his Welcome to this issue, we have recently joined forces with a network of membership associations to continue working towards carbon neutrality.

By joining Climate Action For Associations (CAFA), we will go further and develop a climate action plan specifically tailored to our organisation. This will allow us to continue to improve our practice.

Keven Bader, CITMA Chief Executive, said: "We are excited to take further

practical action in limiting our environmental impact, a choice which we hope will encourage a more climate-aware attitude across the IP sector."

CAFA offers us relevant resources, expertise and community as we continue to develop a sustainable practice, and we will work with the organisation to identify the next steps that we should take.

Our environmental policy emphasises that we will always find ways to minimise our impact to the greatest possible extent. To find out more, visit citma.org.uk/cafa



AUTUMN CONFERENCE – STILL TIME TO TAKE PART

There is still time to register for our Autumn Conference on 14th-15th October. Visit citma.org.uk/events for more information

OUR ENVIRONMENTAL POLICY

- We are committed to promoting sustainability and environmental awareness among our staff and members, wherever we can.
- We are committed to reviewing our business processes and finding ways to reduce further any environmental impact from these processes.
- We believe that we all have a duty to minimise the environmental impact of our activities in the most practical way possible.
- We encourage our members and those with whom we do business to be environmentally aware and to consider their own environmental policies and actions.



NEW ONLINE TAKEDOWN DIRECTORY

The EUIPO has launched a contact directory for 13 major international e-commerce sites, helping brand owners watch out for and take action against online infringements in a more efficient way. Read more at citma.org.uk/ecommerce



IPREG BOARD APPOINTMENT

Congratulations to Justin Bukspan, who has been appointed to IPReg's Trade Mark Regulatory Board, which holds responsibility for maintaining standards in the trade mark industry. Read more at citma.org.uk/board



UK IPO FILING DEADLINE

The UK IPO has issued a reminder that the deadline for UK priority applications based on rights that were pending at the EUIPO on 1st January 2021 falls on 30th September. However, waiting until the last minute may cause delays. Read more at citma.org.uk/deadline



IN SUPPORT OF INTERSECTIONALITY

A range of communities can help address life's complexity, explains Andrea Brewster

I confess that when I first came across the term “intersectionality”, I dismissed it as management jargon. I was wrong.

A woman faces certain types of discrimination and prejudice because of her gender. A Black woman, in addition, faces others to do with her ethnicity. A disabled Black woman is further disadvantaged by our society's tendency to design inaccessible places and systems. A gay Muslim may encounter prejudice because of both their religion and their sexuality. And so on.

These are obvious, unobvious examples, of course. In reality, the situation is far more nuanced. What's important is this: none of us can be defined by one label alone. A person's identity is a complex weave of different, inseparable strands.

“Intersectionality” asks us to recognise that some people face layer upon layer of barriers, each exacerbating the others. The more underrepresented or underprivileged categories you fit into, the harder things get. This presents a dilemma for IP Inclusive. We have networking and support “communities” (six so far) for IP professionals in specific underrepresented groups, including most recently people who are from non-traditional families. Is that appropriate? Or are we perpetuating the tendency to shoehorn people into boxes with divisive labels?

Well, the answer to that first question is yes and no. Members

of each community are united by a certain set of problems. It's important for them to have safe spaces to discuss those problems with others who are in the same boat, even if some of them face other challenges as well.

“

Some people face layer upon layer of barriers, each exacerbating the others

What's vital, though, is that:

- People can be involved with as many communities as they like.
- All are open not just to members of the relevant group but also to allies. Thanks to intersectionality, we can all be allies to those who are less well off than us, even if in other respects we need allies ourselves.
- The communities talk and listen to each other, sharing stories and

acknowledging both their common experiences and the differences.

Intersectionality is not so much a problem in its own right as something that should inform our response to other problems. Allyship is crucial to that response. We must recognise the privileges we have and use them to help others. Most elements of allyship are common to all “minority” groups, and our communities have been working together to encourage and support allies of all types with events, guidance and personal stories. Our North of England network in particular has collaborated with all six communities on projects about allies and intersectionality.

This collaboration will continue. It allows us to reach a wider cohort of people than we could without the individual communities, and it helps to promote understanding and acceptance right across the IP sector. We are all part of the wider IP Inclusive community. The “intersections” are many and complex; we must address them together, sensitive to their individual elements as well as their aggregate effects.

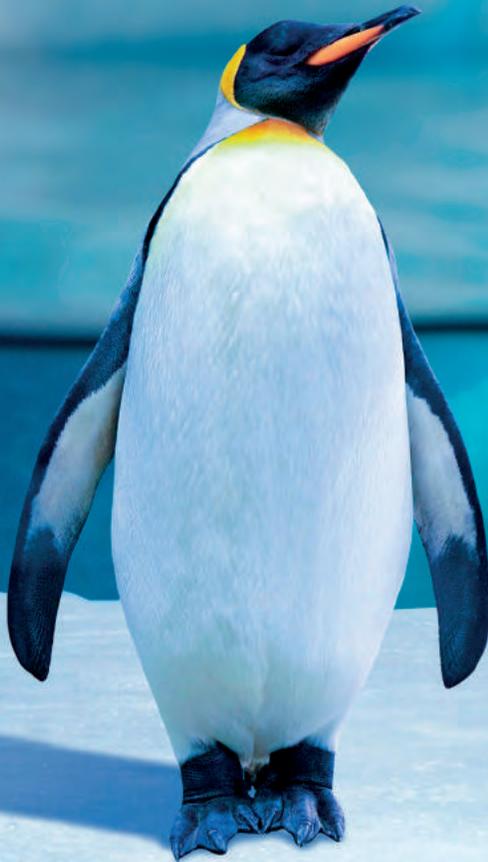


Andrea Brewster OBE

is Lead Executive Officer at IP Inclusive
Find out more at ipinclusive.org.uk

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WHAT'S IN THE PIPELINE FOR THE MADRID PROTOCOL?

Oscar Benito brings us up to date on what's up at WIPO

A number of important changes were approved at the meeting of WIPO's Madrid Working Group last October. This is the forum in which Contracting Parties to the Madrid Protocol and official observer organisations such as CITMA work to improve the international trade mark system. Changes included the partial replacement and the removal of the graphic representation requirement when filing an International Registration (IR).

Currently, replacement is only possible if the goods and services of the earlier national right are fully encompassed by the specification of the IR. Partial replacement will mean that earlier rights that only cover some of the goods and services listed in the IR can also be replaced. This improvement should help trade mark holders to consolidate their portfolios and save costs. Contracting Parties are required to implement this change by 1st February 2025.

MAJOR IMPROVEMENT

The removal of the graphic representation requirement when filing an IR is another significant improvement to the Madrid system. Contracting Parties are required to implement this by 1st February 2023.

It should be noted that there is no actual requirement to amend the national legislation among the Contracting Parties. Therefore, users will need to check carefully whether a graphic representation is still necessary in each of the countries in which they designate an IR.

Over the past two years, there have been discussions about the feasibility of adding Arabic, Chinese and Russian as working languages of the Madrid system. WIPO's Secretariat is preparing a revised study of the cost implications and technical feasibility of gradually introducing these languages. Adding languages is likely to come at a cost, and there is a concern that this will be passed on to users at a time when businesses are struggling as a result of the COVID-19 pandemic.

ADDED COMPLEXITY

Also of concern is that these new languages will add complexity to the Madrid system and increase timelines. Members of the CITMA WIPO Liaison Committee have met with the legal team at WIPO to discuss the risks and the opportunities that these new languages will offer, especially if new countries join the Madrid Protocol. WIPO intimated to CITMA that these costs are not expected to be passed on to users and that if the new languages are introduced in stages, there should be no bottlenecks or significant delays. This topic will be further discussed at the Madrid Working Group meeting scheduled for November this year.

At the November meeting, it is also expected that a proposal from the UK Government, prompted by CITMA, will be discussed – namely to introduce clear deadlines for replying to provisional refusals. This has been a longstanding request from CITMA; CITMA and MARQUES published a joint paper on this topic last year requesting that the date of the deadline for a response to a provisional refusal be clearly stated on the communication from the International Bureau of WIPO to the holder of the IR. This joint paper was also signed by AIM, ECTA and APRAM. It is critical for users to know the exact deadline date for a response to a provisional refusal.

So, on this subject: stay tuned. ●



Oscar Benito

leads CITMA's WIPO Liaison Committee and is a Legal Consultant at Gavi, The Vaccines Alliance (COVAX)

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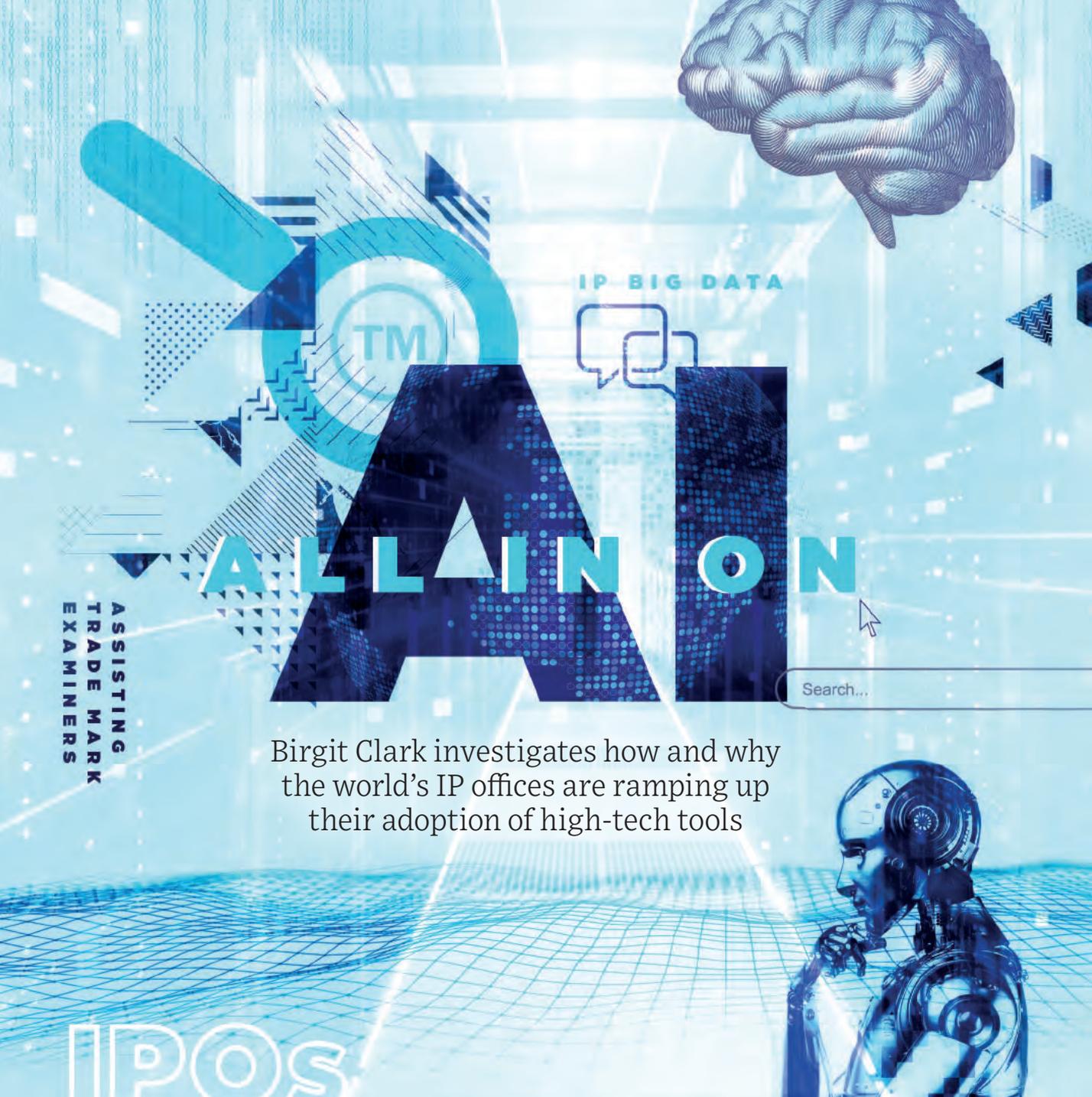
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ALL IN ON

Search...

Birgit Clark investigates how and why the world's IP offices are ramping up their adoption of high-tech tools

IPOS

As policymakers start to decipher the wide-ranging potential impact of artificial intelligence (AI), this technology is already gaining popularity among intellectual property offices (IPOs), including in the context of trade marks. Indeed, an index of AI initiatives in IPOs published on WIPO's website illustrates how widely AI technology is now being used

to facilitate IP and trade mark service delivery in different IPOs globally, encompassing more than 20 offices and territories.

Despite its increasing use, there is still no accepted legal definition of AI. For this reason, there have been various discussions about how a consensus is needed on basic definitions of AI and related concepts to allow a constructive conversation about AI and its implications for IP law and practice. However, it is most

commonly defined as the science of making computers do things that require intelligence when done by humans.

In this respect, the scope of AI includes machine-learning systems, which are designed to perform human-like cognitive tasks and improve their performance in these tasks by learning from data sets without further human input and without being explicitly programmed to do so. The related concept of



50%

**OF SURVEYED IPOs
HAVE STARTED TO
USE AI APPLICATIONS
FOR AT LEAST ONE
BUSINESS SOLUTION,
ACCORDING TO A WIPO
SURVEY FROM 2018**

deep learning refers to a type of machine learning through which artificial neural networks mimic the biological structure of the brain and are able to learn either with or without human supervision.

WHY USE AI?

The main reasons cited by IPOs for using AI tools include gains in the speed, efficiency and accuracy of output and decision making, and therefore, arguably, increased fairness. A spokesperson for IP Australia shared with the *CITMA Review* that they believe “the use of cognitive computing technologies will improve the state of play for IP customers, offices and examiners. In particular, we believe it can improve the quality of output from IP offices. Through AI, we can gain efficiencies in performing administrative tasks, which will enable us to focus more on complex, substantive decision making, with a correlated increase in consistency and quality.”

Many IPOs now include AI as part of their current and future strategy, focusing on their own systems and tools as well as their innovation policies. As AI can analyse large data sets quickly, it can gain insights that may otherwise be hidden within volumes of data. WIPO leads and enables co-operation among various national IPOs in pursuit of the management of IP big data and the use of AI for IPO administration. A WIPO survey from 2018 found that around 50% of surveyed IPOs have started to use AI applications for at least one business solution. A few IPOs are in the process of developing their own in-house systems that are powered by AI, while many other IPOs have started to use AI applications developed by commercial technology service providers.



“ The Office must continue to invest in the latest technology in order to consolidate its digital advance and embrace emerging technologies as enablers to support the Office’s strategy. This will include working on implementing the next-generation digital solutions based on AI, big data, cloud computing, blockchain, and other state-of-the-art technology

EUIPO Strategic Plan 2025

Let’s look at some of these tools in more detail:

Classification tools: AI technology is being used to assist trade mark examiners at various IPOs in correctly classifying trade mark specifications under the Nice and Vienna classifications, drawing on data on previously accepted, or lists of acceptable, terms. AI classification tools, including the Autochecker software tool used by the Singapore IPO and EUIPO’s TMclass classification tool, assists both applicants and examiners when it comes to classifying terms. Similar tools are being used and investigated by China’s National Intellectual Property Administration (CNIPA), the Japan Patent Office (JPO) and Russia’s Rospatent. ▶

Trade mark distinctiveness tools:

A Trade Marks Distinctiveness Checker has been developed by the Singapore IPO, and the Australian IPO has introduced its own Smart Assessment Toolkit, which relies on machine learning from historical data sets during the examination of trade marks. These tools are not making any final decisions, but they do support examiners and users.

Image search and other comparison tools: Various IPOs (and businesses) are using, developing and exploring AI tools that help with the comparison of visual, aural and even conceptual similarity of trade marks. This is clearly one of the most promising use-cases of AI within trade mark practice.

It has already been two years since WIPO launched its state-of-the-art, AI-based search tool for trade marks, which significantly improved on earlier generations of image-search tools. WIPO's tool primarily determines the similarity of trade mark images by identifying shapes and colours in marks. This technology uses deep machine learning to identify combinations of concepts – such

“ It is even conceivable that sophisticated AI solutions may be used for preliminary decisions at all stages of the trade mark life cycle

Task	Potential/current AI use cases
Brand creation	AI solutions are used by branding agencies to create new word marks or logos based on deep learning/natural language processing (NLP).
Clearance searching	AI-enabled human judgement utilising machine learning identifies conflicting legal rights. Relevant for applicants and providers of search services.
Filing a trade mark application	Chatbots, apps and other AI tools can help applicants with the process. Greater automation and interconnectivity between trade mark databases allows increased automation of the application filing process.
Examination by trade mark registry	Classification of trade mark specifications, identification of objectionable terms of goods or services in trade marks, assessing registrability (“distinctiveness”) and comparison with prior registered rights.
Publication for potential opposition/objection by third parties	Smart AI-based assessment toolkits could be used to predict the outcome of an opposition with a high degree of accuracy. Prediction tools are already available.
Registration	AI-enabled automation at some IPOs enables the immediate generation of official electronic certificates.
Maintenance/enforcement	Detection of fake specimens of use/evidence of use. Tools that allow detection of counterfeits online. Tools that predict the outcome and chances of success in infringement or invalidity actions.
Commercial exploitation	Machine learning solutions can be used to analyse the value of trade mark portfolios and licencing agreements.

as an apple, an eagle, a tree, a crown, a car, a star – within an image to find similar marks that have previously been registered. WIPO has explained that this technology produces a narrower and more precise group of potentially similar trade marks, allowing greater certainty in strategic planning for brands that want to expand into new markets.

In addition, by narrowing the results so that there are fewer to scrutinise, there are labour and cost savings for trade mark examiners, lawyers and paralegals, industry practitioners and researchers. It is also being used in combination with other search tools relating to the Vienna and Nice classifications.

Since the advent of WIPO's search tool, this technology has

become more widely used. For example, Singapore's IPO uses image recognition software to find the closest potentially conflicting logo or device application, and this technology is now available to applicants via an app.

In Chile, the National Institute of Industrial Property has an image search tool based on an algorithm developed by the University of Chile's Engineering School. Meanwhile, a team at the USPTO has developed AI prototypes to compare trade mark images, to suggest the correct assignment of a mark's design codes, and to determine the potential acceptability of the identifications of goods and services. A beta test of these AI prototypes through a common user interface with approximately 10



stakeholders began in November 2020, with a view to a potential larger beta test in due course. Similar technology is also being used in the context of trade mark monitoring services.

False specimen detection tools:

The USPTO has tested solutions that allow for the detection of false specimens of use, using a piece of software that was integrated last December into the agency's efforts to identify digitally manipulated specimens of use or mock-ups of web pages. Similar AI tools could potentially be used to check evidence of genuine use of trade marks.

Machine translation tools: WIPO has developed an AI-powered, state-of-the-art neural machine translation tool, known as WIPO Translate, which WIPO is sharing with 14 intergovernmental organisations and various IPOs around the world. Equally, the EUIPO's Strategic Plan 2025 refers to the use of advanced technology for e-learning, including machine translation.

Communication tools: When it comes to communication between AI and humans, IPOs are already – or increasingly looking into – using various AI tools, including chatbots, to field some initial queries using natural language processing and speech recognition. Examples include AI-supported helpdesk services at the Singapore IPO and in Uruguay. A team at the USPTO is also developing an AI-based chatbot to answer frequently asked questions on the USPTO website. Similarly, last autumn, the UK IPO launched its new online tool called Trade Mark Pre-Apply, which uses a number of AI-powered checks

and searches to help applicants through the application process. The EUIPO's Strategic Plan 2025 also refers to the use of advanced technology for interactive tutorials and chatbots as being key to the progress of its initiative on wider and deeper understanding of IP.

So far, the technology seems to be limited to relatively unsophisticated guided pathway solutions. However, as the technology improves and its use spreads among IPOs and the courts, it may become necessary to inform and educate users about what it means for them to be interacting with a machine.

WHAT COMES NEXT?

Greater automation and interconnectivity between trade mark databases and registries is expected, in time, to result in the filing of an application taking place automatically as a result of an AI workstream. AI-enabled automation at some IPOs already allows the immediate generation of official electronic certificates. Beyond these more mundane administrative tasks, and with the AI technology being applied by IPOs becoming more complex, automated decision making could also become a reality. It is even conceivable that sophisticated

Chile's National Institute of Industrial Property has developed an AI-powered image search tool with the University of Chile's Engineering School

AI solutions may, in due course, be used for preliminary decisions at all stages of the trade mark life cycle, including the appeal stage at an IPO, with formal decisions being made by examiners or an appeal board. As AI tools become more sophisticated, more complex questions will arise – for example, whether the decision of an AI tool on the similarity of trade marks or goods and services should have some kind of prejudicial relevance and how this should be considered by examiners, notably in relation to legal certainty considerations.

In summary, AI cannot yet replace an examiner's judgement, human thinking or analysis and is, even in the longer term, unlikely to replace human-to-human client contact entirely. Nonetheless, it seems fair to say that the more routine a trade mark examiner's activities or an IPO's services, the easier it will be to at least supplement these tasks using AI and other technology, freeing examiners up to focus instead on the legal work that adds the most value. ●



Birgit Clark

is a Chartered Trade Mark Attorney and Lead Knowledge Lawyer for Baker McKenzie's global IP and technology practice group

ASK THE EXAMINER

With two decades of experience to draw on, Trade Mark Examiner Ann Wulff gives her insight into life at the UK IPO

CITMA Review: How many trade mark examiners are there at IPO?

Ann Wulff: There are currently 210 examiners, split between 14 examination teams, two international teams and two design teams. Between us, we examine around 750 cases per day.

CR: What does a day in the life of a trade mark examiner look like?

AW: The saying “No two days are the same” comes to mind. We have flexibility to choose our working hours between 5am and 10pm, Monday through Friday. This has been a real help with managing that work and home life balance, particularly when the COVID-19 pandemic hit. The

generous working day bandwidth has helped us plan our days around other commitments.

The UK IPO has always been a family-friendly place to work, and this hasn't changed in recent times. Unsurprisingly, the IPO has even made it into the Top Ten Employers for Working Families Index for the past couple of years.

As well as examining marks, trade mark examiners deal with follow-up written correspondence and telephone calls. There are also plenty of regular meetings to attend about ensuring quality procedures and continuous improvement. As a senior examiner, I offer guidance to the less experienced examiners on the team, and last year I was involved in the virtual training of new starters.

As an office, we are not standing still. We are taking on board the

“ There are currently 210 examiners, and between us we examine around 750 cases per day





feedback from our customers in the Customer Satisfaction Survey. For example, we have been scoring low in terms of our speed of service, but we are currently recruiting up to 75 new examiners. This is on top of the 91 examiners who have joined us since last September. As was reported in the *CITMA Review* recently, the combination of the UK leaving the EU at the end of last year and the COVID-19 pandemic has led to a substantial increase in trade mark applications.

CR: What do you think is the most challenging aspect of a trade mark examiner's role?

AW: It can be challenging making decisions on cases that we refer to as "borderline". These are the marks where there are differing views among the team regarding how to proceed. When opinions do differ, we have a technical lead on the team we can consult and a

training and development team to offer support.

It can be challenging raising a partial absolute grounds objection when the specification is really long. I often break the work into chunks because close attention to detail is needed when deciding exactly what the application can be accepted for.

However, it is really rewarding when we are able to offer ways forward to the applicant so some rights can be gained from their application. It is satisfying when the customer understands we are there to help them in the process.

CR: How do trade mark examiners stay up to date on case law?

AW: There are a few ways. On a day-to-day basis, we use SharePoint to access an online library of case summaries. There are learning points for us and full case decisions, grouped by subject matter, which are quick to access for reference. ▶

“ As an office, we are not standing still. We are taking on board the feedback from our customers ”



“ The process involved in reaching a decision can involve lots of twists and turns along the way

Our website also has a useful search facility through which we can access decisions issued by the IPO and the Appointed Person since 1998.

Once a month, the training and development team presents what we call the Technical Bulletin. If there are any updates on cases or new information we should know about, this is one of the sources we hear it from. The technical lead on the team also passes on information to us at our weekly meetings.

CR: Is there career progression for trade mark examiners to become hearing officers?

AW: There are development opportunities that allow all staff to develop their skills and help put us in the best position when jobs do come up. There is not an automatic progression for examiners into the hearing officer role as such. However, the technical leads on the teams have the opportunity to take part in hearing officer training courses.

CR: Is there a quality review system in place?

AW: Yes, there are a few quality control stages that help the team to achieve the high standard that we aim to maintain. The team leader and technical lead work together to sample our work on a monthly basis. The findings are then discussed with us.

The Peer Review Group (PRG) meets weekly on each team and includes two examiners plus the team leader and technical lead. All cases that are due to be refused pass through this channel. Here we discuss the objections raised and

contribute our own views on the examiner's decision. If the group agrees that the objection was not correct, it is set aside or amended.

The Acceptance Review Group (ARG) meets once a month to discuss 10% of all our examiners' accepted cases. The meeting consists of one examiner from each team, one team manager and technical lead, plus a representative from the training and development team. This is a good opportunity to pull up cases worthy of closer review.

CR: What do you enjoy about the job, and would you recommend the role of trade mark examiner to others?

AW: I was attracted to the role because I was keen to work in a position where I could manage my own workload. I am involved in the complete processing of cases from the beginning at application stage, to issuing the registration certificate.

I was also keen to take on responsibility for decision making in an environment where views are often mixed and the process involved in reaching a decision can involve lots of twists and turns along the way.

I would recommend the trade mark examiner role to others because the work is genuinely interesting and varied. We have a wide-ranging customer base, meaning we have the opportunity to interact with a variety of people, from legal professionals to individuals starting up new businesses. I could be conducting research in the field of computer software in the morning and in the afternoon looking at the latest trends in clothing.

It's also a really sociable job too, because you rely on your colleagues for their thoughts on cases. This hasn't changed during remote working, as we can keep in touch virtually. Often the team will have personal knowledge we can draw upon in the examination process. You learn something new most days! ●

For more information on job roles, recruitment, lifestyle and culture at the IPO, visit vercida.com/uk/employers/intellectual-property-office

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01332 367051
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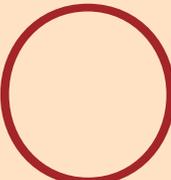


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REACHING FOR THE STARS

Carol Nyahasha reflects on the recent YORUBA STARS outcome and issues a warning to anyone who underestimates the strength of communities that seek to protect their cultural identity



Over the past few months, we have once again witnessed major U-turns by brands that have come up against massive social media backlash because of accusations of cultural appropriation. To give one

example, Michael B. Jordan (star of the *Black Panther* and *Creed* movies) had to make a hasty retreat after launching his joint-venture rum called J'OUVERT, having received a torrent of criticism on social media. The name J'Ouvert is given to a well-known Caribbean carnival and is taken from French phrase "jour ouvert", which means "opening of

the day". The carnival, which traditionally begins just before sunrise, has its roots in Trinidad and dates back 200 years to the arrival of French plantation owners. J'Ouvert evolved from the Canboulay festivals in the 1800s – night-time gatherings at which landowners dressed up and imitated their slaves. Following emancipation, the newly freed slaves

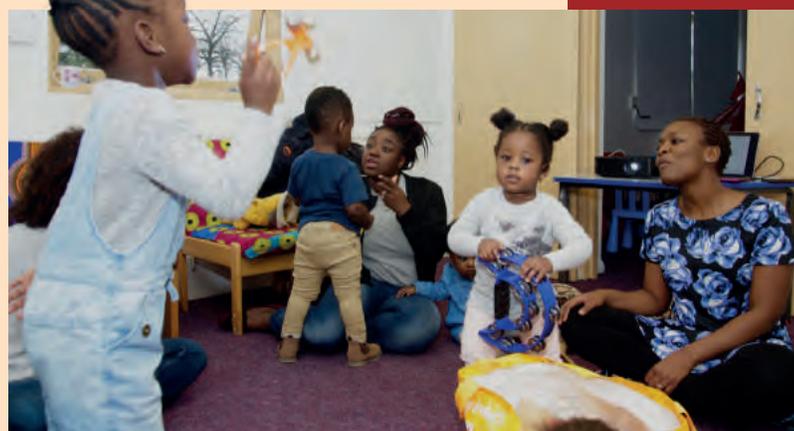
reinvented Canboulay, imitating the former “masters” who had once mocked them. This practice was banned by authorities but was eventually re-established as J’Ouvert. So, you can see why the Caribbean community did not like the idea of its carnival being exploited in such a way.

Closer to home, the UK recently hosted the fight between British clothing company Timbuktu Global and cultural education venture CultureTree, all revolving around the cultural appropriation of the Yoruba name, and the mark YORUBA STARS.

CONTINUING QUESTIONS

So much has been written before about trade marks and cultural (mis)appropriation that when I was tasked with covering this case for the *Review*, it was quite the challenge to figure out a different angle from which to approach it. That’s when it struck me – why do brand owners

CULTURETREE



keep making the mistake of seeking registrations for names that have cultural significance? What can be done to reduce the likelihood of brand owners making this mistake in the future? Are we solely to rely on the ever-watchful social media activists and keyboard warriors who are lying in wait to bring such actions to justice?

It also led me to ask myself a more complex and slightly controversial question: is the ownership of a trade mark that relates or refers to a culture ever appropriate? Who gets to police that and decide if one owner has a more legitimate claim than another?

Which brings me back to the run-in between Timbuktu and



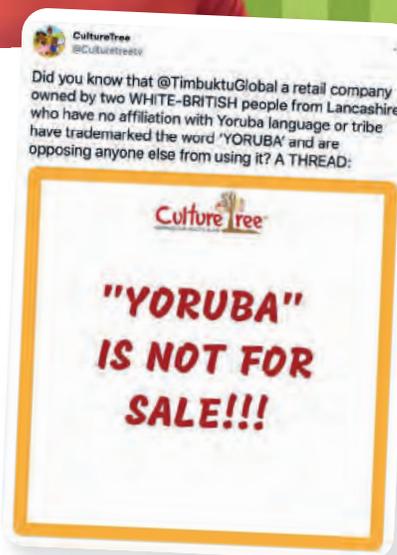
The Yoruba Stars language programme is a popular part of CultureTree's community work

CultureTree. The first is a UK clothing and accessories company based in Lancashire and owner of two trade marks for YORUBA (covering clothing and class 41 services, among other things). The latter, CultureTree Ltd, is a social enterprise business whose mission is to preserve and promote African languages and culture across the world, including Yorùbá, one of the principal languages of Nigeria. CultureTree was attempting to register the mark YORUBA STARS for clothing and entertainment, education and cultural activities. Timbuktu was notified of the application and opposed the YORUBA STARS mark on the basis of its prior rights in YORUBA.

To explore this case in detail, I was pleased to be able to connect with Gbemisola Isimi, the founder and CEO of CultureTree, and get a direct insight into the methods she used to fight for the YORUBA STARS application and consider how these efforts might inform future decisions regarding marks with cultural links.

SOCIAL MEDIA RESPONSE

CultureTree runs a programme that teaches children the Yorùbá language, branded with the YORUBA STARS name. It also runs a parent and toddler play group of the same name. The language programme and play group have both become popular over the years, which is why Isimi decided to seek trade mark protection for YORUBA STARS. She told me she never



imagined she would come up against any resistance to her application, so receiving an opposition from Timbuktu, a company which in her view had no goods or services relating to the Yorùbá culture or language, naturally came as a surprise. In her view, it was wrong for Timbuktu to try and monopolise and claim sole ownership of a birthright belonging to the people of another continent.

Faced with an opposition which would very likely be decided in Timbuktu's favour, and the possibility of that hampering its community work, Isimi and CultureTree took to social media to rally support from the African community. And rally behind them it did! After much tweeting, retweeting and sharing of the story, the #YORUBAISNOTFORSALE movement managed to force Timbuktu to back down and withdraw the opposition action.

The outrage was understandable. For the Yorùbá community (and others), it seemed as though Timbuktu was unfairly exploiting the Nigerian cultural heritage in the name YORUBA for commercial gain, while at the same time preventing CultureTree (whose founder is of Nigerian descent and is Yorùbá) from sharing in that name. I am from Zimbabwe and the Zezuru tribe – one of the Shona-speaking tribes – so I understand why CultureTree felt the need to fight this. I would be equally outraged if a third party with no legitimate claim to being Zezuru trade-marked that name in a similar way.

As Isimi stated in her social media call to action: "Today it's Yorùbá, tomorrow this could be Igbho, Swahili or even the word AFRICA... @timbuktuglobal should not and will not have ownership of our birth right!" In fact, it is worth noting that SWAHILI is registered as a trade mark at the UK IPO and EUIPO for paints and varnishes in classes 2 and 17. (Maybe one for the East African community to take up!)

In the face of the social media campaign, Timbuktu not only withdrew its opposition, but also surrendered both of its YORUBA trade mark registrations (one in class 25 and the other in classes 9, 14, 18, 21, 28, 35 and 41). It appears that its website and e-commerce shop has also been taken down. Isimi told me she considered this "a huge win for the Yorùbá community, as it felt like our birthright was being stolen from us. The community was able to stand together and fight for what we felt was being taken away from us. Personally, it showed me how strongly people felt about their Yorùbá identity and the lengths they'll go to to protect it."

WIDER IMPACT?

It will be interesting to see how the UK IPO deals with any future applications incorporating the Yoruba name or any other cultural expression. The question becomes: should registrations be limited to

those who can prove a legitimate stake in the name? If so, how does a potential right owner go about demonstrating that?

A social enterprise like CultureTree would likely have no problem making its case. In my view, it has a legitimate stake because of the work it carries out for the betterment of the Yorùbá community and the African diaspora as whole. But what if someone of Yorùbá heritage is keen to capitalise on the name in a way similar to Timbuktu's business model? The answer could be the relevant communities of heritage coming together to file a collective trade mark, which is then used with permission. However, the logistics and policing of that would be a nightmare. I am reminded of

and reform these to protect the names of ethnic groups, geographical locations, languages and cultures from being trade-marked in their singular form". At the time of writing, the petition had a long way to go to get to the 10,000 signatures necessary for the Government to respond, but the effort is certainly a start.

ENCOURAGING SIGNS

The Trade Marks Act 1994 allows for trade marks to be refused on the basis that the mark applied for is "contrary to public policy or principles of morality". However, as yet there is no particular provision for excluding marks that are related to a cultural expression, and the granting of the YORUBA trade mark

looking into how to develop an international agreement for the protection of traditional cultural expressions. Yet, while changing the law will go a long way towards curbing the registration of cultural expressions, as practitioners we can also play our part. In the same way that we carry out pre-filing checks for linguistic connotations and prior use, a simple Google search can reveal whether a word is a cultural expression. IP lawyers and brand owners will have to make the conscious (and sometimes brave) decision to consider another name, no matter how alluring the name that has been decided upon is.

Certainly, the J'OUVERT and YORUBA STARS incidents should serve as reminder to brand owners to consider their choice of marks carefully, especially if they might include a cultural expression. It would not be ideal for them to find themselves on the other end of a successful and ultimately brand-damaging campaign by those opposing such use.

As Isimi told me: "Our fight is not only for YORUBA but for every ethnic group, language, culture, tribe, location that is in danger of being exploited for commercial gain." With such sentiments in mind, brand owners should not underestimate the power of a community rallying to lend its voice to a cause. Social media has given people an immediate forum to be heard, especially the Davids who have long felt that they did not have the resources to raise their voice against the Goliaths of this world. ●

“ Should registrations be limited to those who can prove a legitimate stake in the name? ”

the Taita community in Kenya, a community of female basket weavers in Kenya's Taita-Taveta County that acquired, with the assistance of the WIPO, a collective mark for TAITA BASKETS ASSOCIATION, thereby successfully protecting the IP and tradition inherent in their handwoven baskets.

Isimi's view is that "no one should own sole rights to the YORUBA name in its singular form. Anyone with a legitimate stake should be able to use a derivative of it in their branding, as we do with YORUBA STARS and YORUBA KIDZ. Filing a collective trade mark would be very difficult to do, and I highly commend the Taita community for being able to do this."

For its part, CultureTree has taken its fight a step further and has launched a petition¹ asking the UK Government (and in essence the UK IPO) to put in place rules to protect cultural expressions. The main purpose of the petition is for the Government "to review the rules for the registration of trade marks,

in the first instance indicates that the threshold of examination of such marks is low. I accept that it is not the UK IPO's remit to police such marks, but perhaps as the world is getting smaller and with information and innovations becoming more accessible, we are likely to see campaigns such as CultureTree's having more of an impact. This may become the catalyst for various trade mark offices taking a step back before granting one single proprietor a potentially perpetual monopoly to a name that contains a cultural expression from which the relevant community will not benefit.

It is also encouraging that WIPO's Intergovernmental Committee² is

1 <https://petition.parliament.uk/petitions/587954>

2 wipo.int/tk/en/igc



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IS CHANGE CREEPING UP?

Cameron Malone-Brown
suggests a Scottish decision
could cramp the style of the
UK's discount retailers



Brand owners have long bemoaned the practices of discount supermarkets in the UK when it comes to imitating reputable brands and positioning their products as low-cost alternatives. Despite a complicated relationship, claims of trade mark infringement and passing off are infrequent, and decisions in favour of a brand owner when claims are raised are rare. The seeming inability of brand owners to successfully challenge discounters has been back in the public eye this past year, due to several high-profile claims against Aldi and Lidl.

A recent Scottish decision, however, may suggest that the landscape is changing – in favour of the brand owner.

THE LEGAL LANDSCAPE

Discounters have long sailed close to the wind, presenting own-brand products with various visual elements similar to those used by well-known brands. These elements are not usually distinctive or are incidental, such as packaging colourways, label placements or fonts. In isolation, these elements may not be capable of protection, but when they are presented together the discounters are often able to bring to mind the relevant third-party brand. Discounters know the legal landscape well enough not to imitate the brand names with such gusto, since these are more readily protectable and capable of enforcement.

One of the keys to the success of the discounter brands has been their ability to walk the line between recognition of brand elements and actually causing confusion. Provided the risk of confusion is low, the third-party brand owner's means of challenge are considerably reduced. Accordingly, the discounters typically avoid the more obvious (and registrable) indicators of commercial origin, and instead seek to create a link in the mind of the consumer with known brands through packaging and get-up.

A recent challenge by Marks & Spencer (M&S) against Aldi's Cuthbert the Caterpillar cake resulted in an online backlash, featuring a predictable element of humour and ridicule owing to the novelty of the goods concerned. Underpinning the ribbing and memes, M&S encountered a degree of apathy: consumers were not surprised that highly similar goods were available or that M&S was concerned about the similarity. It was clear that consumers are entirely familiar with the tactics

mark infringement and passing off. Of note, Alexander J concluded that Lidl had not used "Warren & Sons" to make any connection with Philip Warren, and that it did not consider that the new "Warren & Sons" brand was similar enough to infringe the Claimant's rights. As Lidl's conduct did not give rise to actual confusion, nor "sufficient operative misrepresentation" to have caused material damage to Philip Warren's goodwill, the claims failed.

“ Discounters have been able to walk the line between recognition of brand elements and actually causing confusion ”

employed by the discounters and are not necessarily loyal to the brand owners affected.

This awareness within the market is key because the consumer's understanding of how discounters operate has a direct impact on the ability of brand owners to challenge their methods. Consumers are aware, when shopping in a discounter's shop, that the goods offered are frequently lower-cost versions of familiar brands, greatly reducing the risk of confusion and with it the likelihood of a successful challenge based on likelihood of confusion or passing off. Where the full-price version is neither available nor expected to be available for sale, the consumer is even less likely to mistake a discount version for the real thing.

Earlier this year, Philip Warren & Son Ltd (active under the brand "Philip Warren") challenged Lidl over its use of "Warren & Sons" for meat goods.¹ Daniel Alexander QC, sitting as a High Court judge, found in favour of Lidl, dismissing Philip Warren's allegation of passing off.

The absence of evidence of confusion was crucial here, as it so often is in cases of trade

This decision features many elements common to other disputes brought against the discounters. Here, again, the careful steps to avoid confusion adopted by the retailer in this case meant that the brand owner could not succeed.

A NOTABLE CHALLENGE

The Court of Session in Edinburgh recently awarded an interim interdict to William Grant & Sons², following its challenge to Lidl's sale of a gin product. While the facts of the case are rather specific, many brand owners have welcomed the development.

William Grant is the producer of Hendrick's gin, a popular and well-known brand throughout the UK. In December 2020, Aldi redesigned its "Hampstead" gin product, with the result that it featured many elements of the Hendrick's product.

The following changes were made by Aldi:

- Increasing the ABV and bottle volume to match Hendrick's;
- Altering the bottle shape and colour to closely simulate the Hendrick's bottle;
- Altering the label's placement and shape to match those on the Hendrick's product, and;





M&S's
Colin

• Adding images of juniper berries, similar to those that appear

on the Hendrick's product.

In April 2021, William Grant filed a motion for an interim interdict in Scotland, alleging trade mark infringement due to a likelihood of confusion, as well as unfair advantage relating to the reputation of its earlier registered mark, along with passing off. On 25th May 2021, Lord Clark refused William Grant's claims based on likelihood of confusion and passing off. In essence, the risk of confusion was simply not high enough for either ground to succeed, especially since the products are not sold side by side and the price point is markedly different.

However, Lord Clark did find in William Grant's favour when it came to unfair advantage. As he summarised at paragraph 47 of the decision: "There is of course a difference between, as it is put in the case law, living dangerously but endeavouring to keep a safe distance away (for example, arguably by use of a different name) and on the other hand deliberately intending to cause deception."

The redesigned Hampstead gin product had been on sale for some time, and the changes to the product were all geared towards increasing the similarity with the Hendrick's gin product. As a result, Lord Clark held that the redesign was neither accidental nor coincidental, but intended to free-ride on the reputable Hendrick's brand.

“ Courts are having to stretch the wording of the s10 provisions to address the modern, innovative infringer

This case seemed to turn rather heavily on the recent rebrand and the clear intent of Aldi to ape the Hendricks product. Nonetheless, if this reasoning is maintained at trial, this could constitute a strong precedent for brand owners in Scotland when it comes to challenging the discounters.

THE UNFAIRNESS OF ADVANTAGE

Trade mark law has historically prioritised protecting consumers, in particular by ensuring the origin function of trade marks. This focus underpins the enforcement provisions in s10 of the Trade Marks Act 1994 and preceding trade mark law, while also creating a considerable hurdle for enforcement against a third party in the absence of confusion. However, the nature of branding and commerce has developed considerably over time.

When the Act was drafted, for example, there was no such thing as Google AdWords, the vast majority of purchases were made in physical retail stores, and the discounter retail format was far less prominent. As a result, courts are having to stretch the wording of the s10 provisions to address the modern, innovative infringer.

The courts are increasingly investigating the secondary functions of trade marks, such as advertising, guaranteeing quality and acting as a vessel for the goodwill in the brand. These elements have been discussed at length under the umbrella of the s10(3) "unfair advantage" ground of infringement. Developing from a judicial analysis of unfairness,

the courts have sought to afford brand owners a means of protecting these secondary functions.

One question remains, then: to what extent can an advantage be unfair? The courts have sought to answer this in terms of changes to economic behaviour, free-riding, dilution and tarnishment. But as is shown by the prevalence of the imitation being carried out by the discounters, these categories have still not afforded brand owners an effective means of challenging this behaviour. Indeed, the confidence of the UK discounter market is only increasing, as demonstrated by Aldi's successful marketing campaign from 2019, which claimed it was "Like Brands. Only Cheaper".

As the discounters' market share grows, the likelihood of these practices resulting in confusion among consumers decreases, and with it the ability of the brand owner to enforce. If brand owners are to have an effective means of challenging the practices of discounters, it is likely to arise through judicial creativity, or legislative change.

Given the flurry of challenges facing the discounters and the increasing frustration of brand owners, in a market where both have strong economic power, and bearing in mind the recently increased ability of the UK courts to deviate from EU practice, UK practitioners should be watching this space with interest. ●

1 [2021] EWHC 1097 (Ch)
2 [2021] CSOH 55

ALAMY



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D&I MADE EASY

Five proven and practical ideas for increasing diversity in your firm

Retention, motivation and mobility were some of the main points raised by a panel convened by Women in IP earlier this year to look at quick wins in diversity and inclusion (D&I) for IP Inclusive Charter signatories. We've rounded up a selection of these evergreen ideas to share with *Review* readers:

1 You have to make it happen.

Kate Swaine (Gowling WLG) said that mentoring and sponsorship are good ways to help your people progress, but it doesn't happen by accident. It takes explicit effort and buy-in from the top down to put these programmes in place. When it comes to getting women involved, remember that whereas men are very good at seeking out mentoring on their own, women tend not to do this. Often women don't ask the same questions as men or push themselves forward. Proactively offering mentorship from other women can help.

2 Make sure mentors are a good match.

The key thing in successful mentoring is the relationship between the mentor and mentee, Swaine added. A mentoring relationship has to be a good fit.



A good first step is letting people know that help is available to them or asking prospective mentees who they respect or admire. Who has a story or journey they identify with? Ask also what style of mentoring is wanted – structured or spontaneous, for example. Some of the best mentoring relationships are those that aren't overly formal.

3 Set up safe spaces.

Krishna Kakkaiyadi (Pinsent Masons), a member of IP Inclusive's IP & ME committee, explained how his firm had set up a Faith, Race, Ethnicity and Equality (FREE) network as a vehicle to allow colleagues to share their experiences. He noted the importance of creating safe spaces for conversations about race and ethnicity, and the benefit of making sure these conversations are free from expectations about outcomes and seen just as the start of a process of getting diverse perspectives out into the organisation.

4 Don't go wrong in recruitment.

Jane Burton, Chair of the the Law Society's Lawyers with Disabilities Division, urged employers

to make sure recruitment agencies are bringing disabled candidates forward in the recruitment process. When it comes to advertising, mention disabilities and reasonable adjustments, and perhaps make a contact available for candidates to speak frankly with about any requirements they have, even at the interview stage. Allow people to be open about their disabilities, and relieve their fear that being honest could harm their prospects. Don't quiz people about their disabilities during the recruitment process, and if you have a senior leader who also has a disability, encourage them to be open about this.

5 Make room for social mobility.

Wayne Spillett (Vodafone) emphasised how easy it can be to support social mobility. It's often as simple as arranging an open day or a shadowing opportunity. For example, his firm set up a dedicated Summer Vacation Scheme. These are all ways to make a difference to someone's CV, providing connections that can help them down the line in developing their career. ●

To access a recording of the Women In IP Quick Wins event, visit ipinclusive.org.uk/events and search "Quick Wins"

Court offers clear vision

The BoA was fully entitled to its decision on confusion, reports Eleni Mezulanik

On 25th January 2017, Olimp Laboratories sp. z o.o. (the Applicant) filed an EU trade mark (EUTM) application for the mark shown below in class 5, covering, *inter alia*, pharmaceutical preparations for the treatment of eye diseases and conditions and other medical preparations relating to the treatment of eyes.

Omnivision GmbH (the Opponent) filed an opposition under Article 8(1)(b) EUTMR against the EUTM application in respect of all goods on the basis of its EUTM for HYLO-VISION in class 5, covering “Dietary supplements and dietetic preparations; medical and veterinary preparations and articles”. The Opposition Division upheld the opposition on the basis that there was a likelihood of confusion in respect of all goods covered by the EUTM application.

On 4th December 2018, the Applicant filed a notice of appeal with the EUIPO. Bearing in mind that both marks contained the element “vision” and that the element “hydro” in the application had a weak distinctive character in relation to the goods, the Board of Appeal (BoA) of the EUIPO dismissed the Applicant’s appeal. The combination of the element “vision” with the element “hylo” conferred on it an average inherent degree of distinctiveness. Therefore, when considering each mark as a whole, the BoA held that the goods in question were identical, that the signs in question were visually and phonetically similar overall, and, to a certain extent, conceptually similar. Further, no element of the marks could be regarded as being more dominant than another. As such, there was a likelihood of confusion at the very least for a portion of the German-speaking public.

An appeal to the General Court (GC) was filed but was not successful. The Applicant argued that the earlier mark is devoid of distinctive character, that the element “vision” is commonly used in the marketplace by competitors to

designate class 5 goods and is therefore descriptive and lacks distinctiveness, and that the marks are different such that there is no likelihood of confusion.

The relevant public was important here: bearing in mind the goods in question, the relevant public consists of medical professionals, pharmacists and patients belonging to the general public. Medicinal products, whether issued on prescription or not, can be regarded as receiving a heightened level of attentiveness on the part of consumers who are normally well informed and reasonably observant and circumspect.

COMPARISON DECISIONS

The GC did agree that the goods are identical. It considered the distinctive and dominant elements of the marks, bearing in mind the established principle that the comparison of marks must be made by considering each mark as a whole. As such, the assessment of similarity can only be carried out on the basis of the dominant element where all the other components of the mark are negligible. With regard to assessing the distinctive character

“ *The differences did not outweigh the overall similarities* ”

of an element in a mark, the GC emphasised that account should be taken of the inherent characteristics of the element in question in the light of whether it is descriptive of the goods for which the mark is registered.¹

The GC agreed that the stylistic components of the EUTM application were used primarily for decorative purposes and that the additional figurative element had a weak distinctive character. It further noted that none of the elements of the EUTM application were more visually dominant

KEY POINTS

✦ The assessment of the similarity of the signs must take into account the overall impression of the marks, regardless of any shared non-distinctive or descriptive elements

✦ The weak distinctive character of an earlier mark cannot, on its own, exclude a likelihood of confusion

MARK

THE OLIMP APPLICATION

Hydrovision

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ISION**



than the others and that the prefix “hydro” had a weak distinctive character as it was likely to refer to the characteristics of the relevant goods. The element “vision”, common to both marks, was descriptive and had a low degree of distinctiveness.

Further, the GC determined that the element “hylo” of the earlier mark was distinctive and that it was insufficient to conclude that the relevant public would perceive the term as referring to sodium hyaluronate. The low degree of distinctiveness of the element “vision” and the allusiveness of “hylo” were taken into account when assessing the distinctiveness of the earlier mark. It was found that the earlier mark had an average degree of distinctiveness.

Visually, it was held that the marks were similar, sharing nine identical letters and being of similar length. Both marks share “hy” at the beginning and end with “vision”. As such, the differences between the prefixes “hylo” and “hydro” were not sufficient to counteract the similarity of the marks when considered holistically.

Bearing in mind that both marks have five syllables that are similar and that the pronunciation of the marks follows

a similar rhythm, the GC agreed that the marks have a high degree of phonetic similarity. The difference in the middle of the marks was not sufficient to outweigh the overall similarities. The marks were considered conceptually similar insofar as “vision” would be understood as being a reference to sight. However, overall, the marks differ conceptually as a result of the different prefixes.

Bearing in mind the above, the GC agreed that the BoA was fully entitled to hold that there was a likelihood of confusion on part of the relevant public.

1. See the judgments of 13th June 2006, (T-153/03) *Inex v OHIM*, paragraph 35, and 13th December 2007, (T-242/06) *Miguel Cabrera Sánchez v OHIM*, paragraph 51.



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Power element has limited force

Charlotte Wilding explains the basis of a partial success for Infineon

Infineon Technologies AG (Infineon) has been partially successful in its opposition against Electronica Olfer's (Olfer) INFINIUM POWER device in class 9 (shown opposite).

The background to this decision is as follows. On 30th June 2020, Infineon filed an opposition against Olfer's EU trade mark (EUTM) application for an INFINIUM POWER device in classes 9 and 11, filed on 27th February 2020 (the Opposed Application).

Infineon opposed on the basis of Article 8(1)(b) EUTMR, likelihood of confusion, relying upon its earlier EUTM registration for INFINEON in class 9.

EUIPO ASSESSMENT

In reviewing the contested goods, the EUIPO held that the class 9 goods were either identical, highly similar or similar to a low degree. The highly similar goods were

found to be produced and sold by the same undertaking that manufactures the end-product, and also to target the same purchasing public. Further, the goods were held to be complementary. The goods which were similar to a low degree, although different in nature and purpose, were found to have the same distribution channels, to be addressed to the same public and could be manufactured by the same kind of companies.

However, the class 11 goods were found to be dissimilar. In particular, these goods have different natures and methods of use, different producers and a different relevant public to the class 9 goods of Infineon's earlier mark. Even if some of the goods in conflict occasionally coincide in distribution channels – for instance, in big commercial stores – in such outlets the goods at issue

“ Similarity of goods is a necessary condition for the application of Article 8(1)(b) EUTMR

are sold in specialist departments which, even though they may be close, are nonetheless separate. In such circumstances, the distribution channels cannot be considered to be the same. A number of the goods were found to be neither complementary nor in competition.

ASSESSMENT OF MARKS

Moving on to the assessment of the marks, taking INFINEON versus INFINIUM POWER, the EUIPO held that the marks were visually similar to a low degree, phonetically similar to an average degree and conceptually similar.

Although the marks both begin with “Infin” and have the same number of letters in the “Infineon” and “Infinium” elements, the addition of the word “Power” and the figurative element reduced the level of visual similarity. However, the “Infineon” and “Infinium” elements share a number of phonetically identical and similar elements and, given that “Power” is non-distinctive and will likely play a secondary role in the mark, this means that the beginning element of the Opposed Application is likely to be the element referred to aurally. Finally, although these elements do not have a specific conceptual meaning, the EUIPO found that they were likely to be linked with the ideas of “infinity” or “infinite”, an outcome that was made more likely by the inclusion of the infinity symbol in the Opposed Application.

On the issue of distinctiveness, although Infineon claimed an enhanced distinctiveness in the mark, it did not provide evidence to confirm this position. Accordingly, the earlier mark was considered to have a normal level of inherent distinctiveness.

CURRENT DECISION

The EUIPO found that the marks had two highly similar and distinctive verbal and conceptual elements, such that the additional non-distinctive elements would have less impact on consumers, with the result that consumers may believe the marks are from the same or economically linked undertakings.

The EUIPO noted: “The contested sign has as its first element the word ‘Infinium’

which coincides with the earlier mark ‘Infineon’ in their beginnings ‘INFIN-’, in their number of letters, syllables and in the fact that they convey a very similar overall impression. In spite of the fact that the contested sign introduces other elements such as the verbal element ‘power’ and a figurative element consisting of the infinity symbol, these elements are less distinctive or will have in any case less impact than the initial words, on which consumers usually focus their attention. Consequently, the signs were visually lowly similar, but aurally and conceptually similar. The goods were found to be partially identical and partially similar, whereas the attention of the general public will mostly be average but can be higher in certain cases.”

Accordingly, the EUIPO rejected the Opposed Application in class 9. However, the Opposed Application was allowed to proceed in respect of the dissimilar class 11 goods, “as similarity of goods is a necessary condition for the application of Article 8(1)(b) EUTMR, [and so] the opposition based on this article and directed at these goods cannot be successful”.

Given that the opposition was only partially successful, the parties were instructed to bear their own costs. They were given an early August deadline to appeal should they wish to do so.

This case is a reminder that goods/services must be considered similar, even to a low degree, in order for a likelihood of confusion test to succeed. Also, when assessing marks, non-distinctive and figurative elements (even large figurative elements) may not be sufficient to overcome a finding of similarity – particularly if such an element serves only to increase the conceptual similarity.

KEY POINTS

- ✦ Even if a mark is considered to be similar, the goods/services also need to be similar to satisfy a likelihood of confusion test
- ✦ Figurative elements of a mark may assist in the conceptual assessment

MARK



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Hair pair face off

The Opponent was allowed to pursue its best case, says Claire Breheny



On 14th May 2019, Hairconcept Professional S.L.L. (the Opponent) filed an opposition against all goods under EU trade mark (EUTM) Application No. 18020078 for the word mark PANTENE HAIR BIOLOGY (the Applied-for Mark) in the name of the Procter and Gamble Company (the Applicant). The Opposition was based on an earlier EU trade mark for HAIR CONCEPT BIOLOGICAL (the Earlier Mark) under Article 8(1)(b) EUTMR.

Perhaps unsurprisingly, the opposition was rejected in its entirety due to lack of perceived consumer confusion. Further, although the Applicant had requested proof of use of the Earlier Mark during the course of the proceedings, the Opposition Division (OD) did not consider it appropriate to undertake an assessment of the evidence of use submitted. The examination of the opposition proceeded as if genuine use of the Earlier Mark had been proven for all of the goods relied on, which gave the Opponent its best possible case.

The goods that the opposition was based on were in class 3: “Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices”. The Applicant had applied for the following class 3 goods: “Preparations for the care, treatment and beautification of the hair and scalp of adults”.

Given that the contested goods were contained within the broader category of, or otherwise overlapped with, the Opponent’s “hair lotions” and “cosmetics”, the goods

“ A coincidence in a non-distinctive element will not normally lead to a likelihood of confusion on its own

were considered identical. The Office found that these types of goods would be directed at the public at large and that the degree of attention paid would be average.

When comparing the Earlier Mark to the Applied-for Mark, the OD noted the Earlier Decision of the Fourth Board of Appeal (BoA) in case R 2288/2020-4 (22nd April 2021). There, the BoA held at paragraph 18 that the word “hair” is a basic English word that would be seen as non-distinctive on goods which are either explicitly intended for use on the hair or scalp (or may so be used), as it will be perceived as designating the nature or purpose of the contested products at issue. In the same decision, the BoA went on to hold that the English word “biology” denotes “the science concerned with living things” and would be understood throughout the relevant territory (the EU) due to its proximity with other European languages in which the “bio” element remains the same.

Interestingly, the Earlier Decision featured the same applicant as in the present case, but with a different opponent.

In terms of the Earlier Mark in the present case, on the basis of the reasoning of the

Earlier Decision, the OD decided that the “hair” element would be seen as non-distinctive and, given the closeness between the words “biological” and “biology”, it was held that “biological” would be considered weakly distinctive in relation to the goods in question.

WEAK LINKS

The word “concept” was deemed to have meaning in certain jurisdictions, such as those where French and English are understood. The OD decided that the meaning of “concept” did not directly refer to the goods in question. It did, however, decide that the combination “hair concept” may be perceived as possessing some unitary meaning because “concept” is qualified by the word “hair”. Therefore, in relation to some class 3 goods, it would enjoy a weak distinctiveness. However, it was decided that the words “hair concept biological” did not convey any clear or obvious unitary meaning regarding the goods in question.

In terms of the Applied-for Mark, the word “hair” was considered non-distinctive and the word “biology” weakly distinctive. “Pantene” was deemed to have no meaning for the relevant public and therefore was considered normally distinctive. The word combination “hair biology” was held to have weak distinctive character.

Regarding the visual and aural comparisons, the marks coincided with the element “hair” and almost coincided with the words “biological/biology”. They differed in the inclusion of “concept” in the Earlier Mark and “Pantene” in the Applied-for Mark. The OD concluded that the signs were visually and aurally similar to a low degree.

In terms of conceptual similarity, the coinciding elements were either weak or non-distinctive, leading to a finding that the consumer is likely to focus on the fanciful word “Pantene” in the contested sign and the conclusion that there would be a below-average conceptual similarity.

In terms of the distinctiveness of the mark, the Earlier Mark was deemed to have no meaning for the goods in question and therefore it must be treated as normal despite the presence of non-distinctive or weakly distinctive elements within the mark.

GLOBAL VIEW

When proceeding to a global assessment, the OD identified that in the later mark the word combination “hair biology” would be perceived in a unitary manner, being weakly distinctive. Therefore, the consumer in its

view was likely to focus on the fanciful and distinctive word “Pantene” at the beginning of the sign. Given that the goods were fairly ordinary consumer products and that consumers are “guided by the visual impact” of the mark they are looking for, it was relevant to take this factor into consideration where the signs have been found to be visually similar to a low degree.

Taking everything into consideration, the OD felt that the differences between the signs were sufficient to exclude a likelihood of confusion. In its view, a coincidence in an element which is only distinctive to a low degree will not normally lead to a likelihood of confusion on its own. Therefore, given the non-coinciding word “Pantene” is normally distinctive and visually significant at the start of the mark, and given the low degree of similarity (visually and aurally), there would be no confusion on the part of the public.

The Opponent, in its submissions, also referred to use of the Applied-for Mark in the marketplace to try and demonstrate a likelihood of confusion. As has been held in several prior cases, only use of the Earlier Mark is relevant for an assessment of likelihood of confusion, at least in the absence of a claim of coexistence (which was not the case here).

PROCEDURAL INTEREST

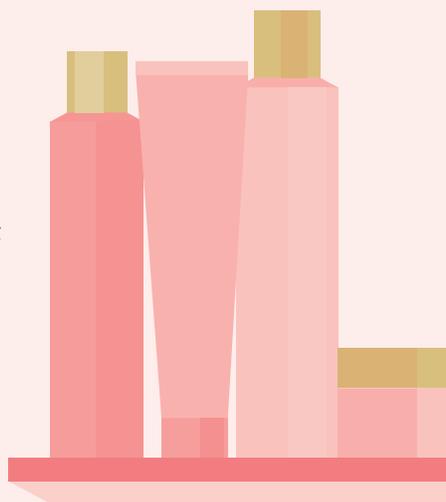
The opposition was rejected in its entirety. This is not hugely surprising, given the coinciding elements of the marks enjoying little or no distinctiveness and the later mark having a visually striking first element which was distinctive. Procedurally, however, this case is interesting in that the OD decided not to review the evidence of use despite it being requested, presumably for reasons of procedural economy. At the time of writing the decision was in the appeal period, and it will be interesting to see whether the Opponent takes up the opportunity.

KEY POINTS

✦ A coincidence of an element between two marks which is only distinctive to a low degree will not normally lead to a likelihood of confusion on its own

✦ It can be relevant to consider whether the goods at issue are ordinary consumer products, as consumers of these products are “guided by the visual impact” of the mark they are looking for, particularly where the signs are less visually similar

✦ The Opposition Division can decide not to review the evidence of use despite a request to do so (giving the Opponent its best possible case), typically for reasons of procedural economy



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Word play doesn't work out

Milena Velikova feels there may be some sympathy for the Proprietor here

AirBnb, Inc. (the Applicant) applied to invalidate a device mark incorporating the textual element “Hairbnb” filed by Allan Ritchie (the Proprietor), shown opposite. The mark was registered for various services in class 43, which all exclusively relate to animals, such as boarding for pets, cattery services, pet day care services and so on. The invalidity action was based on s5(2) and (3) of the Trade Marks Act 1994.

The Hearing Officer (HO) considered the services in question, which belong to class 43 for both marks. The Applicant’s covered broad terms, such as “arranging temporary housing accommodations” and “providing online reservation services for temporary lodging”, while the Proprietor’s covered boarding and day care services for pets. To carry out his assessment, the HO relied on various case law and legal doctrines, such as: complementarity of services; identity of services included in a more general category versus using a narrower terminology; and not straining language unnecessarily to produce a narrow meaning of the services.

The HO concluded that the degree of similarity between the services in question sits between low and medium,

since the terms relating to short-term, alternative accommodation overlap, and the intended purpose of the services possess a certain level of complementarity, as the users of the Applicant’s services may also seek cattery services or animal boarding if they own a pet.

ELEMENTS OF IMPORTANCE

When comparing the marks, the HO observed that the elements of importance which need to be taken into consideration are the textual elements “hair” and “bnb” in the Proprietor’s mark, since the additional elements, such as the colour combinations, the paw print and the roof device will not affect the overall distinctiveness of the mark. When these elements were compared to the Applicant’s wholly textual mark AIRBNB, the HO concluded that the marks are visually similar to a medium degree but aurally similar to a high degree, due to the fact that the letter “H” in “Hairbnb” would



HAIRBNB





“ Proprietors with longstanding use of a particular mark should always rely on s5(3)

be pronounced softly, meaning the mark could be misheard as “Airbnb”.

The average consumer in this case was determined to be a member of the general public who will pay a medium to high degree of attention when selecting the services at issue. This, combined with the comparison of marks and services above, and the enhanced and acquired distinctive character of the Applicant’s mark, still led the HO to the conclusion that there is no likelihood of direct or indirect confusion between the marks in question.

REPUTATION

The evidence put forward by Airbnb was sufficient to demonstrate that the mark AIRBNB enjoys a strong reputation in the UK in relation to the provision of an online marketplace which allows users to view and book accommodation. This evidence included press releases, awards, information on the popularity of the website, the number of stays booked through the platform and even a report from the European Commission that includes a case study on the Applicant. Therefore, the HO was of the opinion that a link could be established between the Applicant’s mark and the Proprietor’s mark in the mind of the consumer, that the Proprietor may benefit from the positive image associated with Airbnb and its mark, and that this positive image could transfer to the Proprietor and his mark. The HO considered that this may

lead to an attraction towards the Proprietor’s services that may not otherwise have been the case and will therefore give the Proprietor an unfair advantage by increasing demand for his services.

NATURAL CONCLUSION

This case is a reminder of the importance of pleading s5(3), even when you think there is a good chance that a likelihood of confusion will be found. A natural conclusion can also be drawn that, where a mark has a reputation, the threshold for proving indirect confusion appears to be much higher than that used for proving that a link can be established between two marks in the mind of the consumer. This conclusion emphasises that proving likelihood of confusion can be very difficult and that proprietors with longstanding commercial activities and use of a particular mark should always rely on s5(3) within their pleadings.

Many readers may sympathise with the Proprietor in this case, a small businessman based in Scotland with a knowledge and love for his furry friends, and who – as he pointed out in his counterstatement – believes that the public will recognise the name of his business as a pun and appreciate that there is no connection with Airbnb.

Unfortunately for the Proprietor, in the world of trade marks, where brands are often viewed in a vacuum, it may be harder to see where the pun ends and the infringement begins.

KEY POINTS

- ✦ If a mark has been used for some time and the owner has an opportunity to prove reputation, it should always supplement a likelihood of confusion claim with a s5(3) claim, as it may turn out to be the strongest case
- ✦ The threshold for proving indirect confusion appears to be much higher than for proving that a link can be established between two marks in the mind of the consumer

MARK

THE PROPRIETOR’S MARK



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KP takes a pop

This partial victory suggests the power of reputation, writes David Birchall

In 2018, KP Snacks Ltd (KP) opposed applications by Nairn's Oatcakes Ltd (Nairn's) to register both "POP OATS/Pop Oats" as a series (the Word Application) and the composite mark shown opposite (the Composite Application) as UK trade marks. Both applications covered goods in class 30, including "preparations made from cereals; snacks, snack foods, crisps made of cereal".

KP opposed both applications under s5(2)(b) and s5(3) of the Trade Marks Act 1994 (TMA), based on its EU trade mark (EUTM) for POPCHIPS and its EU designation of a stylised version (shown opposite), both protected for class 29 "potato-based snack foods; vegetable-based snack foods" and class 30 "corn-based snack foods, excluding breakfast cereals and cereal bars".

Following Nairn's request that KP prove use of its EUTM, it was held that KP had proven use on those class 29 goods.

UNREGISTERED RIGHTS CLAIM

KP also opposed the applications under s5(4) TMA, claiming unregistered rights in both of its marks as a result of use throughout the UK since March 2012 in relation to snacks, snack foods, potato-based snack foods, vegetable-based snack foods and corn-based snack foods. KP asserted that its marks had acquired a significant reputation in the EU, including the UK, and cited UK sales in major supermarkets including Tesco, Sainsbury's, Asda and Waitrose, as well as outlets such as Ocado and Starbucks. It also pointed to various

endorsements and promotions. KP claimed that consumers would assume that goods sold under the opposed marks originated from KP either directly or under licence, that Nairn's use would free-ride on KP's reputation, and that use on inferior goods would be detrimental to KP's reputation.

Nairn's filed evidence showing the number of registered UK trade marks and EUTMs incorporating the word POP or POPPED in classes 29 and 30 and the results of internet searches for "pop/popped" and "snack", and "popped" and "foods", which showed a range of snack and food products featuring the words "pop" or "popped" on the product packaging or in a description. Nairn's also exhibited pages of KP's website showing the words "pop" and "popped" used by KP to describe its product and the method used to cook the potatoes.

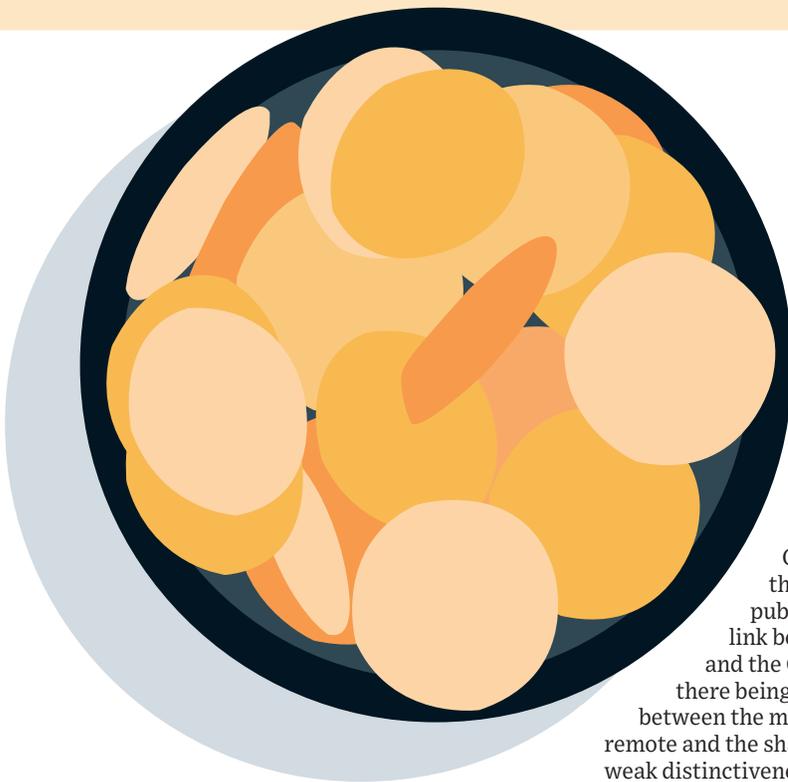
The Hearing Officer (HO) found that the words "pop" and "chips" are common, easily understood words in the English language and that, in the context of potato crisps that are popped with heat and pressure, POP and POPCHIPS are weak in distinctiveness. The HO commented that, when comparing marks, any level of descriptiveness of the common elements should be borne in mind.

In relation to the Composite Application, the HO found that in the context of goods that could be made from or contain oats, "popped oats" would be seen as referring to an ingredient of the products (oats) and the way that ingredient is prepared (popped). The HO found that the Composite Application comprised much more than simply the sole shared element "pop", and that the impact of the other elements – such as NAIRN'S, which would be pronounced – could not be discounted. The HO found that the coincidence of the element "pop" is not particularly noticeable in the overall impression of the composite mark – for example, it does not have an independent distinctive role and does not dominate the overall impression created by the mark – and that any similarity would therefore be very low indeed.

Assessing the Word Application, the HO commented that the average consumer knows that the word "pop" is weak in distinctiveness

“ The average consumer is aware that ‘pop’ is a term that alludes to a method of cooking with air ”





and found any similarity with KP's marks low. The HO then found that the use shown did not significantly enhance any likelihood of confusion and found the Composite Application easily distinguishable. She found that the average consumer would not reduce the Composite Application down to "popped oats" and that the differences are not consistent with a brand extension. The HO held that the average consumer is aware that "pop" is a term that alludes to a method of cooking with air, a meaning about which KP's marketing had educated consumers. The HO found that there was no risk of confusion between KP's marks and either of the opposed marks. The oppositions under s5(2)(b) therefore failed.

While the HO held that KP had demonstrated the required goodwill at the relevant date for potato-based snack foods and vegetable-based snack foods, she found no misrepresentation, so the oppositions under s5(4) failed.

REPUTATION EVIDENCE

To support the s5(3) claim, KP had filed evidence showing an approximate retail sales value for POPCHIPS products in the UK of £115m over the period 2012-2019, with more than £8m spent promoting the products between 2011 and 2018. It also showed that it had a 13.3% share of the UK market in healthier bagged snacks in the 52-week period before 8th August 2018 and was the third biggest brand in the market in 2018-2019. KP also filed evidence that its Twitter and Instagram pages had

significant numbers of followers. The HO accepted that KP's marks had a moderate reputation in the UK, primarily in relation to potato-based snack foods.

The HO rejected the s5(3) opposition against the Composite Application on the basis that the relevant public would not make a mental link between KP's registrations and the Composite Application, there being too many visual differences between the marks, any similarity being too remote and the shared element "pop" having weak distinctiveness. However, the s5(3) opposition against the Word Application was upheld in relation to "preparations made from cereals, snacks, snack foods, crisps made of cereal" on the basis that a link would be made, and that consumers of KP's potato snack products, for whom KP's POPCHIPS mark has a reputation, will recall KP's products on seeing POP OATS used on any of these goods, all of which cover crisps made of popped oats. The HO held that despite the weak distinctiveness of the shared element, the closeness of the goods enhanced the likelihood of risk, giving Nairn's an unfair advantage.

Nairn's launched its product under the POP OATS mark in 2018, so the successful Composite Application was perhaps only a back-up plan. While marks incorporating descriptive elements have the advantage of being easily understood by consumers, this case is a reminder of the difficulties in enforcing registrations of marks composed of descriptive elements. The decision is also a reminder of the wisdom of relying (where the necessary evidence exists) on reputation in an opposition where the shared element has weak distinctiveness.

KEY POINTS

- ✦ While the test for misrepresentation is different from the test for likelihood of confusion, it is doubtful that the difference between the legal tests will produce different outcomes
- ✦ A finding of indirect confusion should not be made merely because the two marks share a common element
- ✦ The rule remains that the public compares the marks as a whole and will not artificially dissect them

MARKS

NAIRN'S
COMPOSITE
APPLICATION



THE KP
REGISTRATION



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GPC plays it straight

For one polo club, a successful defence proved fairly simple, says Simon Miles

This High Court trade mark infringement and passing off action involved the alleged infringement of the Beverly Hills Polo Club stylised trade mark shown opposite (the BHPC logo), owned by the Claimant, Lifestyle Equities CV (LE), through the use of various stylised Greenwich Polo Club signs (the Greenwich Signs, shown opposite) on clothing and textiles, and through the supply of certain promotional services by a licensing agent. The Defendants comprised the owner of the Greenwich signs, Greenwich Polo Club Inc., its exclusive licensing agent, the Copyrights Group Ltd (Copyrights), a director of Copyrights, a sub-agent, and four licensees (the Licensee Defendants) who produced goods bearing one of the Greenwich Signs.

LE and Lifestyle Licensing BV are the owner and exclusive licensee, respectively, of a

number of EU and UK trade marks for the BHPC Logo. Beverly Hills Polo Club is not an actual polo club, but rather a lifestyle brand drawing on the luxury of Beverly Hills and the glamour of the aristocratic sport of polo.

In contrast, Greenwich Polo Club (GPC) is a well-known polo club based in Greenwich, Connecticut. GPC owns and licenses a number of registered trade marks for logos consisting of a polo pony or ponies and rider(s) with mallet(s) and the text “Greenwich Polo Club”.

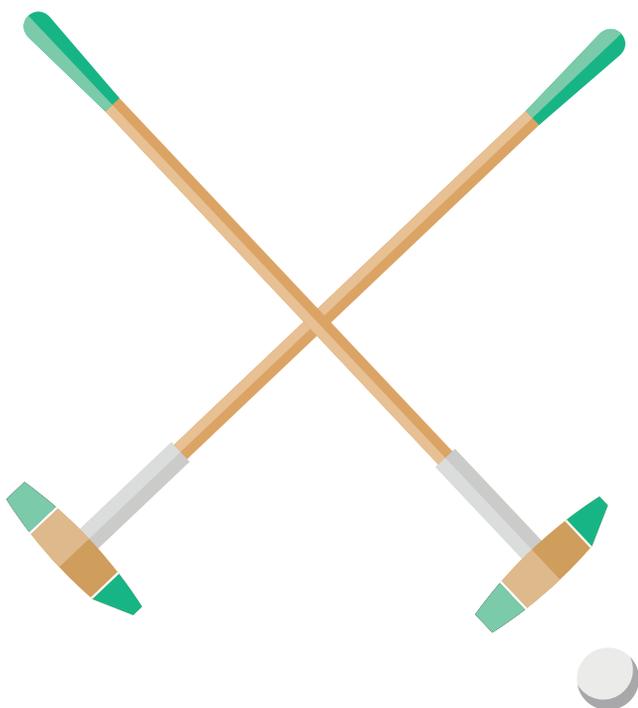
As it has done on a number of occasions against other polo club brands, LE brought proceedings in the UK courts for trade mark infringement and passing off – this time against GPC and the seven other Defendants. LE alleged that each Defendant had, at some stage in the trading process, used or threatened to use in the course of trade in the UK and/or the EU signs that infringed and/or passed off LE’s marks.

The Judge first dealt with the alleged primary infringing conduct of the Licensee Defendants, because they had caused goods bearing the GPC logos to be put on the market.

On the evidence, the Judge found that only Greenwich Sign 3 had been used in relation to products, and even then only in Greece, Cyprus and Bulgaria.

SIMILARITY AND CONFUSION

The Defendants argued that the respective marks were not similar enough and there was no likelihood of confusion because, taking into account the fact that a polo pony and rider motif symbolises the sport in general, many brands, clubs and entities deploy a polo pony and rider motif in their branding, nearly always with an additional word element to designate the club, origin or brand. The Defendants submitted a considerable amount of evidence of third-party polo brands in the marketplace to show that there was a developed market for consumer items for such brands, and that consumers know that they come from different owners.





“ The words ‘Beverly Hills’ and ‘Greenwich’ actively sought to differentiate between originators

The Judge agreed with the Defendants on this point and ultimately concluded that a polo horse and rider motif added nothing to the distinctiveness of the BHPC logo, save to make clear that there was a generic link to polo.

After comparing the visual elements of the marks, the Judge found that the similarities between the figurative elements were low but that, importantly, the critical distinction between the marks was that the words “Beverly Hills” and “Greenwich” actively sought to differentiate between originators.

The Judge therefore held that the marks were insufficiently similar and the reasonably well-informed and reasonably circumspect consumer could not be confused between the marks in question. The Claimants had sought to minimise the distinctiveness of the word element of the Greenwich Signs by suggesting that in the relevant territories – Greece, Cyprus and Bulgaria – the consumers use a different alphabet, thus accentuating the importance of the figurative elements. In the Greek and Cyrillic alphabets, the words “Polo Club” are, when translated, the same, but the words “Beverly Hills” and “Greenwich” are different. The Judge thought that this fact served to emphasise the point that these words, and the links and concepts that they reference, are very different.

The Judge went on to find that that there was no infringement under Article 9(2)(b) EUTMR or s10(2) of the Trade Marks Act 1994 (TMA). The passing off case fell with the Article 9(2)(b) case.

The Judge then considered infringement under Article 9(2)(c) EUTMR or s10(3) TMA and found that the Claimants’ evidence of reputation was lacking in the EU territories in which the relevant goods had been sold. Taking into account the findings on similarity, the Judge was disinclined to believe that

the average consumer in the territories in question would make a link between the Greenwich Sign used and the BHPC logo. As such, the reputation-based case also failed.

JOINT AND SEVERAL LIABILITY

Having concluded that the claim for infringement against the Fifth to Eighth Defendants was unsustainable, it followed that the other Defendants were not liable as accessories to a non-infringement.

Similarly, the case against the individual director failed. The Judge made it clear that he did not consider that the potential liability of a company like Copyrights, contracted by the owner of a brand like GPC to license and manage that brand, should automatically be equated with the potential liability of a director of that company. He would therefore have required a lot of persuading that the limited activity of this Director rendered him liable as a joint tortfeasor.

STRAIGHTFORWARD DEFENCE

The Claimants have had success in the past in infringement actions under the BHPC logo, including against another “lifestyle” brand, Santa Monica Polo Club. In that case, a surprisingly broad range of marks was held to infringe.

The thrust of the defence in the GPC case was actually quite straightforward. First and foremost, asserting that the name of the polo club differentiates it from BHPC. Secondly, that the proliferation of other brands on the market served to limit the extent of any monopoly owned by LE under its existing registrations. In this case, the Judge agreed.

Edwin Coe LLP acted for the First to Third Defendants, including Copyrights and GPC.

KEY POINTS

- ✦ The marks of two different polo club brands were found not to be similar
- ✦ The critical distinction between marks of this kind is the word designating the polo club’s origin, not the polo and rider motif, which symbolises the sport in general

MARKS

BHPC LOGO



THE GREENWICH SIGNS

Greenwich Sign 1



Greenwich Sign 2



Greenwich Sign 3



Greenwich Sign 4



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Smart move?

Katharina Barker raises some interesting questions about future defensibility

KEY POINTS

✦ The case shows that an eye-catching and seemingly simple mark that, on the face of it, is descriptive, can be registered if an owner is careful about which goods and services are included

✦ Whether Nike will go on to use the FOOTWARE mark on smart shoes themselves remains to be seen

This is Puma's appeal against a UK IPO opposition decision in which the Hearing Officer (HO) rejected Puma's opposition to Nike's FOOTWARE application in respect of goods and services in class 9 (computer hardware modules, electronic devices and computer software; computer software and firmware; software for electronic devices; computer software for network and device security; computer software); class 38 (telecommunication services); and class 42 (application service provider [services]; cloud computer featuring software [services]; providing temporary use of non-downloadable cloud-based software [services]).

Puma's original opposition, filed in November 2020, was based not only upon s3(1)(b) and (c) of the Trade Marks Act 1994, but also included a "common descriptor" ground under s3(1)(d). In its statement of grounds, Puma claimed that:

- "Footware" was an ordinary descriptive term for relevant goods and services and failed therefore to possess sufficient distinctive character for registration. It was not striking, surprising, unusual or arbitrary.
- The mark is an obvious portmanteau combining "footwear" and "hardware" or "software", and these goods were claimed in the application. Therefore, the mark was descriptive of the kind of goods and services.
- The mark has become a common descriptor of relevant goods and services and is now customary in the relevant trade.

In the decision, the HO concluded that "foot" was not descriptive of any of the goods or services for which registration was sought and was therefore distinctive. She accepted that "ware" was not inherently distinctive in relation to goods in class 9 or services in class 42, as it may be perceived as referring to software, hardware or firmware. However, "footware" is not a combination of two non-distinctive elements where the combination fails to amount to more than the sum of its parts. She also concluded that "ware" was distinctive in relation to the services in class 38.

While the HO permitted Puma to advance an additional argument that "footware" is an obvious misspelling of footwear, she rejected this argument. She concluded that the term is a neologism which changes the meaning and requires some mental effort on the part of the consumer.

As to the question of descriptiveness of the term "footware" as a whole, the HO accepted that the term was likely to be perceived as a play on the word "footwear" and that software, hardware and firmware have some application in footwear with embedded technology.

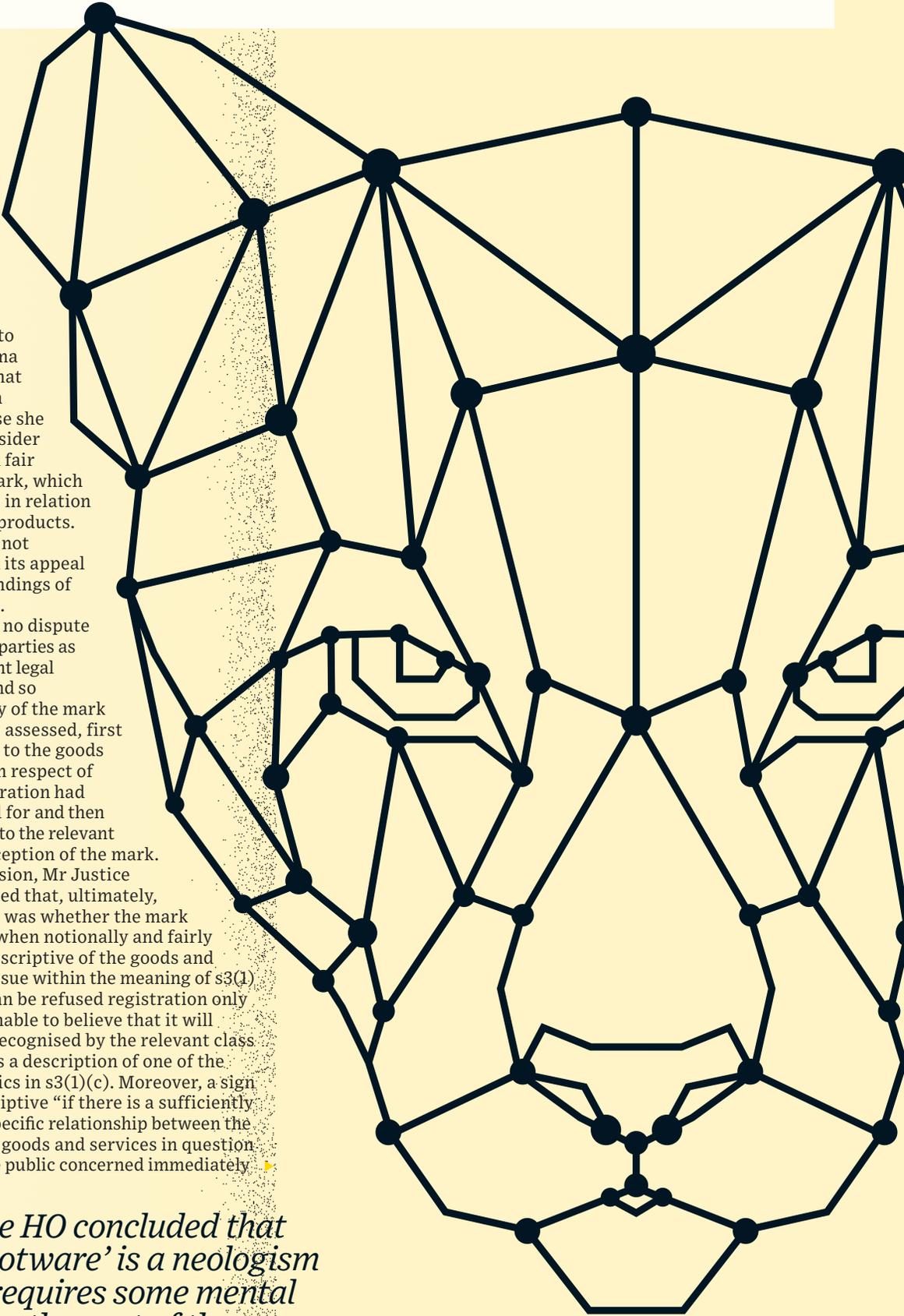
It was also noted that the evidence included a number of footwear products, mainly sports shoes, that feature computer technology to collect data, but that there was no evidence of the term "footware" being used to describe any of the relevant goods or services. The HO concluded that the evidence provided in relation to "smart" footwear did not constitute use of the mark in relation to the contested goods and services.

In terms of the evidence provided by Puma in relation to s3(1)(d), the HO noted that there was only limited evidence of the term "footware" in use in the UK, and still less evidence of its use in relation to any of the goods or services at issue. It was concluded that the evidence was wholly insufficient to establish that use of the term had become customary in the trade for any of the contested goods or services at the relevant date.

APPEAL GROUNDS

Puma appealed on the following grounds:

- With regard to s3(1)(b) and (c), it stated that the HO erred in failing to consider the notional and fair use of the trade mark across the full range of its very broad specification of goods and services.
- Further, it claimed that had the HO considered notional and fair use in relation to the goods and services where Puma contended that the mark is descriptive, she could only have concluded in agreement with Puma.



- Finally, with regard to s3(1)(d), Puma contended that the HO again erred because she failed to consider notional and fair use of the mark, which included use in relation to footwear products.

Puma did not challenge on its appeal any of the findings of primary fact.

There was no dispute between the parties as to the relevant legal principles, and so registrability of the mark needed to be assessed, first by reference to the goods or services in respect of which registration had been applied for and then by reference to the relevant public's perception of the mark.

In his decision, Mr Justice Zacaroli stated that, ultimately, the question was whether the mark applied for, when notionally and fairly used, was descriptive of the goods and services at issue within the meaning of s3(1)(c). A sign can be refused registration only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of the characteristics in s3(1)(c). Moreover, a sign will be descriptive "if there is a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned immediately

“ *The HO concluded that ‘footwear’ is a neologism which requires some mental effort on the part of the consumer*

to perceive, without further thought, a description of one of the characteristics of the goods and services in question”.

SECTION 3(1)(C)

With regard to Puma’s first contention that the HO failed to apply the “notional and fair use” of the trade mark across the whole range of goods and services for which registration was sought, Mr Justice Zacaroli noted that the HO had carried out the necessary assessment.

Further, it was pointed out that the HO had quoted the principles of Starbucks (HK) Ltd v British Sky Broadcasting Group plc¹, including that the signs referred to were “merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought” and the concept of notional, not actual, use.

He recognised that the HO had identified the precise subset relied upon by Puma (software, hardware and firmware having “some application in footwear with embedded technology”) but concluded that the term “footwear” would not be considered descriptive of such goods and services. He was satisfied that the HO had considered the full range of possible goods and services for which registration was sought, including the subset relied upon by Puma, and therefore concluded that neither “foot” nor “footwear” was descriptive of them.

In addition, Mr Justice Zacaroli dismissed Puma’s argument that “footwear” was simply a misspelling of “footwear” and therefore descriptive of footwear with embedded technology. No error of principle in the HO’s decision could be found.

Finally, the evidence relied on as to the use of “footwear” in other contexts was rejected as it did not

show descriptiveness in relation to footwear embedded with technology.

SECTION 3(1)(D)

With regard to Puma’s contention that the evidence in the case shows the use of “footwear” in the UK in relation to all of the class 9, 38 and 42 goods and services, such that the trade mark has become customary in the trade for all of those goods and services, Mr Justice Zacaroli found that there had been no error of principle and that the HO had considered all of the evidence. It was further noted that most of the evidence was not from the UK and was therefore irrelevant to the argument under s3(1)(d).

“ Nike now seems to be in at least an arguable enforcement position

Mr Justice Zacaroli therefore dismissed the appeal, although at the time of writing it remained to be seen whether Puma would take the matter to the Court of Appeal.

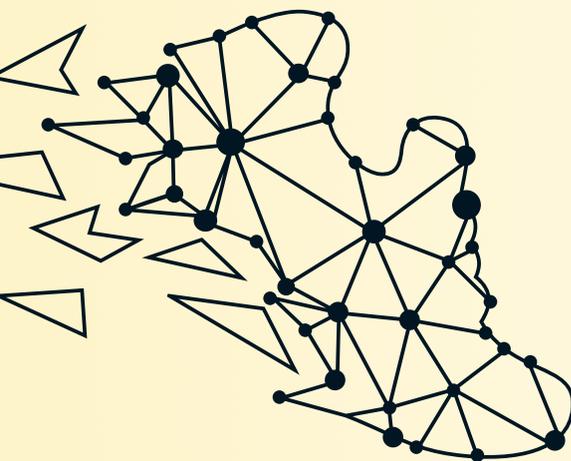
This case shows that a mark that would likely be descriptive for footwear can be eye-catching and innovative for the complementary goods and services included in Nike’s application. Whether Nike goes on to use the FOOTWARE mark on “smart” shoes remains to be seen, but the decision does lead to some speculative questions.

If Nike encounters competitor use of FOOTWARE on “smart” shoes, it now seems to be in at least an arguable enforcement position due to its registration of the mark on ancillary goods and services. It may have been a smart move not to put “footwear” in its description of the goods, so as to avoid a finding that the mark was descriptive on those goods. As it is, there is no such finding, and so any competitor wishing to use FOOTWARE on shoes – specifically “smart” shoes – would have to work harder to establish a defence on descriptiveness or non-distinctiveness.

1 [2012] EWHC 3074 (Ch)



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We're just putting the finishing touches to our Autumn Conference line-up. Find out more at citma.org.uk/events

Calendar

Our upcoming events for members

DATE	EVENT	LOCATION	CPD HOURS
8th September	CITMA Webinar Ethical considerations in advising clients	Online	1
22nd September	CITMA Paralegal Webinar* Oppositions and disputes	Online	1
29th September	CITMA Webinar Online platforms and bad faith in China	Online	1
12th October	CITMA Paralegal Seminar Managing change	Online	3
13th October	CITMA Webinar Black History Month: Looking back, looking forward	Online	1
14th-15th October	CITMA Autumn Conference** Reputation, resolution and revolution	Online	6
20th October	CITMA Webinar Brand protection: Facing the digital surge	Online	1
21st October	CITMA Student induction	Online	1
4th November	CITMA Webinar Contentious proceedings at the UK IPO	Online	1
25th November	CITMA Paralegal Webinar* Renewals and maintenance	Online	1
30th November	CITMA Mediation Seminar	Online	2
15th December	CITMA Webinar UK case law update	Online	1

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THE TRADE MARK 20

Q&A



Cherrie Stewart

prefers to keep her outlook positive

I work as... a Chartered Trade Mark Attorney and Director with MacLachlan & Donaldson (Ansons) in Belfast.

Before this role, I was... an administrative assistant to a patent and trade mark attorney in the same office.

My current state of mind is... calm and positive, which is my preferred state of being as I'd much rather look on the bright side of life. As Eeyore says: "It never hurts to keep looking for sunshine".

I became interested in IP... when I covered the maternity leave of a receptionist in an IP firm 22 years ago.

I am most inspired by... a challenge. I'm at my best when trying to solve a problem within a deadline.

In my role, I most enjoy... educating people about the need for good IP protection. At the start of a seminar to students in a university start-up programme, I asked how many of the participants thought they had IP in their business. Only two or three put up their hands. I asked the same question at the end and they all had their hands in the air. Job done!

In my role, I most dislike... advising clients who have received a C&D to rebrand. It is so disappointing for them and so often could have been



avoided if only they had conducted a thorough clearance search before adopting a mark.

On my desk is... a bag of dog treats, in an attempt to keep my dogs (two miniature schnauzers, Bonnie and Bailey) quiet as I work from home, plus my "100 books bucket list".

My favourite mug is... a *Friends* Central Perk giant tea cup. Obviously I'm a child of the '90s.

My favourite place to visit on business is... Boston. It's an amazing historic city, with the *Cheers* pub and the Red Sox stadium.

If I were a brand, I would be... Levi's. I don't tend to follow fashion trends, but "quality never goes out of style".

In my pocket is... my iPhone and more dog treats.

The talent I wish I had is... the ability to play a musical instrument well. I learned classical guitar as a child but didn't take time to practise.

I can't live without... my Kindle™.

My ideal day would include... a long walk with the dogs, a bubble bath with a good book, and a meal out with my husband, family or some friends.

The biggest challenge for IP is... spreading awareness about the importance of intangible assets and how a lack of protection can affect a business's future growth.

The best piece of advice I've been given is... don't compare yourself to others. You are you, so be the best you that you can be.

When I want to relax... I take a long walk around Lough Fea or through a forest with my dogs.

In the next five years I hope to... spend more time with my family and friends. Among other things, the pandemic has taught me the importance of meaningful contact with loved ones.

The best thing about being a member of CITMA is... the opportunities to stay informed and to learn from the experience of my peers and colleagues.

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

A large, stylized graphic of the letters 'IP' in a serif font, centered within a white speech bubble shape. The background is a light blue-grey gradient.

IP

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Our client is seeking an experienced individual with around 5 years+ trade mark formalities experience and the ability to hit the ground running in this exciting new role. A highly attractive starting salary and benefits package are on offer along with a great work/life balance.

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TRADE MARK PARALEGAL LONDON

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