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# ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

Issue **417** May 2015 [itma.org.uk](http://itma.org.uk)



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## ***BARRIER GRIEF?***

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# welcome

May 2015



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## ITMA Review

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**W**elcome to the May 2015 issue of the *ITMA Review*. Many of you will be preparing to attend the INTA meeting in San Diego. If so, you might take this issue to make time fly on the outward journey. You can then, amongst much other enlightening content, read about the successful recent IPO/ITMA event in Bristol, find out where your firm was ranked in the

2014 table of trade mark filings by UK agents, catch up with the highlights of our Spring Conference, and learn how to delegate better. Of course, if you are en route to San Diego, you should already know how to do this.

**Chris McLeod**  
ITMA President

## Inside this issue

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# ITMA Insider

## CEO update

*Highlights and updates to Keven Bader's 19 February member bulletin*



04

The world of ITMA continues at a fast pace and, as usual, the first quarter of the year proved to be a particularly busy period for us. Here are a few snippets of information about what we've been up to so far.

### Code of Conduct – Rule 11

I start this bulletin with an update on a matter that has been causing some confusion among those in the IP profession. The new Code of Conduct from IPReg came into force on 1 January 2015 and there were some concerns about the requirements for compliance with Rule 11 – Financial Matters. ITMA, along with CIPA, has been trying to obtain clarity on this rule and I am pleased to report that IPReg has published guidance on the matter of whether a true “on trust” client account is required or whether a second bank account maintained for the holding of client money is sufficient. The guidance, which can be found at [ipreg.org.uk](http://ipreg.org.uk), states that it is the latter, which we hope will allay concerns and provide greater clarity.

### ABS explanations

Also concerning regulation, we recently, in conjunction with CIPA, ran a webcast to explain the application process for alternative business structures (ABS).

This live webcast, featuring

Keith Hodkinson from CIPA and Maggie Ramage from ITMA, took an in-depth look at the ABS licensing requirements and included a step-by-step guide to completing the application process and putting in place the documentary evidence required by IPReg. The webcast can be viewed at <http://responsive.policyreview.tv/conference/1008.html>. We will also be carrying an article in a future issue of the *Review*, to recap this important information.

*The world of ITMA continues at a fast pace and, as usual, the first quarter of the year proved to be a particularly busy period for us*

### Membership subscriptions

Thank you to all members who paid their membership subscriptions by our extended deadline of 31 March. Having overcome the technical issues that prompted us to allow extra time, we are confident that next year's subscription renewal process will proceed smoothly.

### IP attachés

You may have read that the IPO has appointed a new IP attaché, Vijay Iyer, covering the Indian market. Chris McLeod and I met with Vijay in early March. If you have any particular issues of which you think Vijay should be aware, or if you have experiences that you have encountered related to transactions within the Indian jurisdiction, please email me so that we can feed them in to the continuing conversation.

### Council, Committees and Working Groups

We have mentioned previously that we carried out a restructure of the Committees of the Institute and introduced Working Groups to spread the workload and provide more opportunities for ITMA members to volunteer to help with particular pieces of work. It is just over a year since this new set-up was introduced

and by and large it has worked well. We would, however, benefit from more volunteers and I urge anyone interested and who has some spare time to put their name forward.

There is basic information on the website about the Council, Committees and Working Groups, therefore please take a look and see what might interest you. If you would like more information or you wish to offer to volunteer, please feel free to email me directly or contact the ITMA office.

### ITMA webinars are free!

We are pleased to report that this year's programme of ITMA webinars will be free of charge to ITMA members. Therefore, if there's a certain subject matter you'd like to hear about or if you're keen to speak at an ITMA webinar yourself, please contact the lead of our Webinar Working Group, Christian Ziar at [ziar@njakers.com](mailto:ziar@njakers.com)



### Trade mark clinics – volunteers needed

As members will know, the Institute holds free advice clinics on the second Thursday of every month (except August and December), where members of the public can put forward and discuss trade mark queries. Currently, there are six half-hour sessions available for the public. For each session, we offer two qualified Trade Mark Attorneys who are available to give advice at three of the half-hour sessions. The sessions are held at 5.00, 5.30 and 6.00pm. Currently the clinics take place at [The IPO, 4 Abbey Orchard Street, London, SW1P 2HT](#).

ITMA has a pool of attorneys that it can call upon to staff these clinics, but we would like to increase this as we have, on occasions, struggled to find attorneys to attend. If you are interested in taking part in these free advice clinics, on the basis that you would attend no more than two a year – or you require additional information – please contact [Gillian Rogers](mailto:Gillian.Rogers@itma.org.uk) at the ITMA office on 020 7101 6096 or at [gillian@itma.org.uk](mailto:gillian@itma.org.uk).

## In memoriam: William Robert McAllen (‘Mac’) Spence

15 May 1936 –  
29 January 2015



It is with profound sadness that Spoor & Fisher announces the death of our dear friend and colleague, Mac Spence.

Mac was a highly respected member of the legal profession, and a pre-eminent authority on African IP law and practice for several decades.

Mac spent much of his life in Kenya, having arrived there in 1939 at the age of three. From 1948 to 1953 he was educated at the Prince of Wales School in Nairobi, and then, after a brief period working for a law firm in Mombasa, he was called up for compulsory emergency service in the Kenya Regiment. He was on active (operational) duty from 1954 to 1956, and remained in the Territorial Reserve until Kenyan independence in 1963. From 1956 to 1959, Mac worked in the Registrar General's office, before being asked to join the leading local law firm of Hamilton Harrison & Mathews. He stayed with the firm for 25 years, becoming a partner and an advocate of the High Court of Kenya.

Mac and his family moved to England in 1984, but they maintained close links with Kenya and visited often. For four years, Mac managed a small solicitor's office in Lechlade-on-Thames, before accepting an offer to join Spoor & Fisher Jersey in 1988. He retired from the partnership in 2004, but remained very much involved in the firm as a consultant. With a meticulous eye for detail, and a complex understanding of the context and evolution of IP law, he specialised in legal research and drafting, and was a contributor to a number of prestigious international journals and reference works.

An affable and unassuming man, Mac combined wise counsel with kindness, sharp observation and wit. He was immensely popular, and will be much missed by everyone at Spoor & Fisher. It was a privilege to have known him.

Mac was happy in Jersey, but Kenya remained his spiritual home, and it is entirely fitting that he was on one of his many visits to the country when he passed away.

## Member *moves*



Eversheds LLP is pleased to welcome [Carol Nyahasha](#) as a Trade Mark Attorney to its Branding Team in Manchester. Carol can be contacted on 0845 497 8655 and 07469 123 880, or at [carolnyahasha@eversheds.com](mailto:carolnyahasha@eversheds.com)



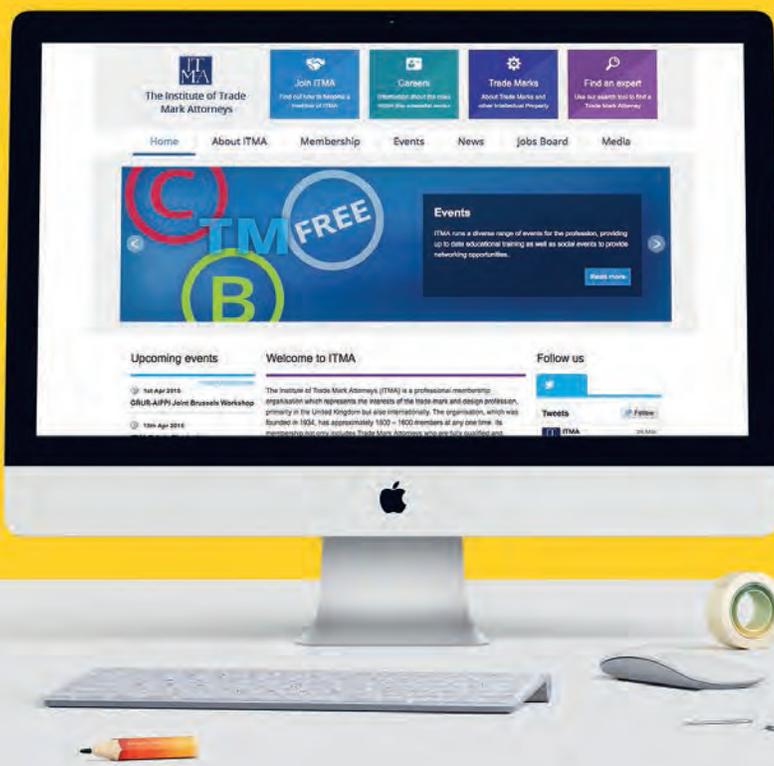
Appleyard Lees has welcomed [Chris Hoole](#) to the team at its Leeds office. Training as a Trade Mark Attorney, Chris joins as an Associate and brings a wealth of knowledge particularly in contentious and non-contentious IP matters. Chris can be contacted at [chris.hoole@appleyardlees.com](mailto:chris.hoole@appleyardlees.com)



Potter Clarkson LLP is expanding its Trade Mark Group and is delighted to announce the appointment of [Shaun Sherlock](#) who joined the firm on 7 April 2015 as a Senior Associate. Shaun was previously at Novagraaf UK and prior to that spent 13 years at Marks & Clerk LLP.

# Fresh new face for ITMA

*ITMA CEO Keven Bader reviews the benefits of the organisation's updated web presence*



**I**n January, ITMA soft-launched a new website full of enhanced features and functionality, with a splash of updated look and feel. The ultimate aim of this project was to deliver a beautifully baked website that provides both members of ITMA and the general public with a better user experience and, to continue the cooking analogy, a taste sensation that offers a feeling of fullness and satisfaction.

In addition, the added functionality aims to increase efficiency in the administrative tasks undertaken by the ITMA office and we are confident that it delivers additional benefits for members. To continue to support the launch and

ensure that members get the maximum benefit from the new features, we'd like to highlight some of them once again.

## Feature boxes

One of the main design changes has been the introduction of 'feature boxes' across the top of the Home page ([itma.org.uk](http://itma.org.uk)), providing quick navigation to information about:

- How to join ITMA as a member.
- Information about careers in the Profession.
- General information about Trade Marks and IP.
- How to 'Find an Expert' for advice.

The increased visibility of these is intended to draw visitors quickly into the relevant section of the website.

## Profiles

Every member of ITMA has their own profile on the website. This contains information about your activity with the Institute and provides members with the ability to amend certain information themselves. So, if you take that exciting new position, you can update your contact details rather than communicating the change to ITMA head office. The majority of information contained in the profile is synchronised with our Customer Relationship Management (CRM) system, therefore it is important to keep your details up to date. You can also add a profile picture that will also be visible if your details are viewed via the Public and Members Search tools, so strike a

pose (maybe not a selfie!) and upload a profile picture. To access your profile you will need to be logged in.

## Search options

Talking of search tools, we have made enhancements to the Public Search Tool and the Members Search Tool, so that finding an expert for advice or finding another member of ITMA is a lot easier. The information returned from any search should be more relevant than from the search via our old website. We have added a map feature so that results can be displayed in that form as well as in a standard list format. As a reminder, the Public Search Tool returns results of Fellow, Ordinary and Corporate Honorary members of ITMA (qualified Trade Mark Attorneys) in private practice. The Members Search Tool allows you to search all categories of membership, but to use this facility you have to be logged in, otherwise you will only be searching as if you were a member of the public.

## Membership renewal

We have added a facility for individual members to pay their subscription renewals through the website. However, in recognition that many firms pay membership subscriptions for their employees, we are in the process of developing this facility further. We hope, in time for the 2016 subscriptions, to be able to offer a facility through which a named contact at a firm can settle, in one transaction, the subscriptions for all those employees who are members and for whom they wish to pay.

## Event booking

As ITMA puts on more than 60 events a year, we wanted to improve the booking procedure for these. Through the new website, events can be booked online, so there are no more PDF forms to print, complete, scan and send. Online bookings can be completed – including payment – by both members and non-members. Repeat users should find previously entered information, such as address details, already populated, making the process quicker and easier. Payment is online and booking information is fed back into reports, which are easier for the ITMA office to view, and there is no more data entry into spreadsheets or endless piles of paper for us to manage.

Feature boxes



ITMA information

Event booking

## Joining ITMA

We have transformed the application to join ITMA into an online experience. Again, this means there are no PDF forms to print, complete, scan and return. The information provided in the online form is sent through to our CRM, negating the need for data entry by the ITMA office and allowing us to streamline the joining process.

## ITMA information

The website showcases both what ITMA is and does, and what the Profession is and does. There is now more information about ITMA in the 'About Us' section and we urge all members to peruse this. We will continually review the website to ensure it is fit for purpose, editing and adding content as required, so we recommend that you visit regularly.

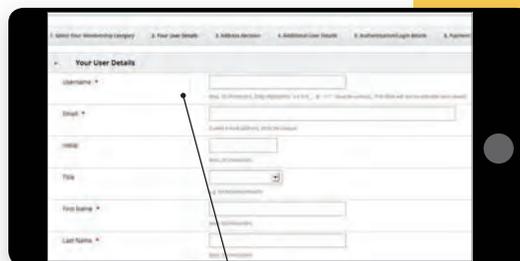
## More to come

Finally, there are further developments in the pipeline and additional features to try out. In the second phase of the project, as well as developing the bulk renewals

mentioned above, we are looking to integrate the events fully with our CRM system and enhance the 'Jobs Board' facility. We plan to provide more information about what the Council, Committees and Working Groups are working on, so that you can get a better sense of what ITMA is doing for you and the Profession. We will also be trying out new features, such as the facility to run mini-polls.

I am in no doubt that the website is not yet the perfectly baked signature dish, but I hope you will all agree that it is a significant improvement, more modern and more user-friendly for both the public and the membership. We are always happy to receive comments about the website, both positive and negative, so please get in touch if you have any thoughts.

*The website showcases both what ITMA is and does, and what the Profession is and does*



Membership renewal/Joining ITMA

# ITMA CONVERGES ON LONDON

*A star-studded evening was just one of the highlights of this year's annual gathering, as our reporters explain*

PHOTOGRAPHY BY KAT HANNON  
AND STEWART RAYMENT

## IP AMID THE OPULENCE

This year's Spring Conference was a complete success – ITMA got it right on every count, from the food and entertainment, to an impressive venue and informed speakers.

First off on Thursday was the Hon Mr Justice Richard Arnold, whose keynote speech on the conference theme of IP convergence emphasised the importance of harmonisation of legislation and case law in the EU. Steve Rowan (UK IPO) followed, announcing that a record 50,000 trade mark applications were filed in the UK in the last financial year. The UK IPO is moving towards convergence with the EU in a number of IP areas. In fact, that morning the consultation on the proposed designs opinion service was launched and it was confirmed that the UK will seek to join the Hague International Design System.

José Miguel Lissén Arbeloa (Gómez-Acebo & Pombo Abogados S.L.P.) then updated us on the amendments to the European trade mark system, which will improve consistency and provide further harmonisation of EU laws. The reform package should be final by December 2015. Mark Bearfoot (Harley-Davidson) and Sarah Jeffery (GSK) gave an insightful presentation on the strategies involved in capturing counterfeits both inside and outside the EU. We learned of the difficulties faced in seizing goods and enforcing legislation, in particular in Africa.

Next, Cameron Gowlett and Duncan Mee (Cerberus) informed us about the perils of conducting investigations, with some evocative visual aids. Afterwards, the Iron and Smith case was examined by Péter Lukácsi (SBGK). He spoke about the importance of CTMs with reputation, territorial scope and the questions referred to the CJEU. Following a tea break with indulgent



01) The red carpet is rolled out at Madame Tussauds, the setting for the Gala dinner 02) Guests mingle amidst the waxworks at the Gala drinks reception 03) Baroness Neville-Rolfe, Minister for IP, delivers a speech to Gala attendees, endorsing the work of ITMA and the IPO 04) Catherine Wolfe (Boulton Tennant) enjoys Breakfast at Tiffany's with Audrey Hepburn 05) Guests ascend to enjoy a night with the stars 06) Chris McLeod addresses attendees at the Gala dinner

cake pops, Matthew Dick (D Young & Co) spoke of the dangers of converging trade marks, focusing on the Yourview v Youview case.

On Friday, Dominic Farnsworth (Lewis Silkin) gave a presentation that covered gaming and the law. The case involving the Lady GooGoo game, in relation to which Lady Gaga successfully proved trade mark infringement, was a talking point at the tea break.

Amanda Michaels (Hogarth Chambers) and Clare Jackman (Norton Rose Fulbright LLP) gave a fantastic talk on the convergence of approach to shape, sound and movement marks. Chris Schulte (Merchant & Gold) then entertained us all with his witty presentation on viewing the EU Specsavers case through the lens of the US mutilation doctrine, and we all learned about “squint tests” and “phantom marks”. Next, trade mark use issues in Europe were highlighted by Anne Marie Verschuur (NautaDutilh NV) and the final speaker was Debbie Roenning (WIPO), who updated us on the expansion of WIPO Members and some improvements that are on the horizon, such as the possibility of the removal of “central attack”. Chris McLeod closed the conference and everyone who attended left in agreement and complete harmony.

Report from Triona Desmond,  
Squire Patton Boggs (UK) LLP



*“A great night with a load of dummies”, was ITMA President Chris McLeod’s comment on the Gala event.*





*The Hon Mr Justice Richard Arnold's keynote speech on the conference theme of IP convergence emphasised the importance of harmonisation of legislation and case law in the EU.*



*On Friday, Dominic Farnsworth (Lewis Silkin) covered gaming and the law. The case involving the Lady GooGoo game was a talking point at the tea break.*



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07



08



09



10



11



**07)** (l to r) Callum Smith (Envoy Renewals), Philip Lapin (Smart & Biggar Fetherstonhaugh, Canada) and Péter Lukácsi (SBGK, Hungary) at the drinks reception **08)** Michalis Christodoulou and Firas Qumsieh (both NJQ and Associates, Jordan) gear up for a round with Muhammed Ali **09)** Guests ascend the staircase at Madame Tussauds **10)** The Reading and Writing Room at the main conference venue, 1 Whitehall Place **11)** Julia House (Albright IP Limited) relaxes with George Clooney at Madame Tussauds

## SOCIAL EVENTS SET THE BAR

Events organised by ITMA never lack vibrancy and those accompanying this year's Spring Conference were no exception. With the conference commencing on Thursday morning, the evening before provided a suitable time for an unofficial kick-off. Sway Bar provided a welcome mix of Victorian grandeur and modern chic and certainly 'set the bar' for what was to come.



Victorian grandeur meets modern chic at SWAY BAR

The playfulness and prestige of Madame Tussauds are undeniable. Indeed, it must rank as one of the world's most famous museums. And at Thursday's Gala Dinner guests were 'chauffeured' to the opening drinks reception on a 'Spirit of London Ride'. This may have had particular impact on our overseas colleagues as it provided an insight into the history of the host city. Following the enlightening 'cab ride', guests were able to share a refreshment with the stars. With this in mind, the evening may have set a new record for the number of selfies taken at an ITMA event.



Anita Cordeiro Guerra, Kazner Leonardos Intellectual Property, at MADAME TUSSAUDS

Alongside the star spotting, Chris McLeod addressed the attendees in his usual witty manner and guests also had the pleasure of the company of Baroness Neville-Rolfe, Minister for IP. In her speech, she endorsed the work of ITMA and the IPO, and praised IP specialists for the valuable work they do in assisting businesses to protect their IP assets.



CHRIS MCLEOD addressed attendees

Mark Caddle, Withers & Rogers LLP



ITMA retweeted

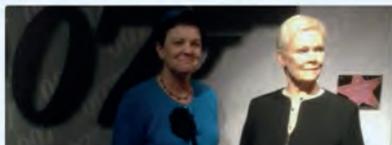


**Sanderson & Co.** @sandco\_ip · Mar 20

Dominic Farnsworth, @LewisSilkin: computer games market bigger than films, in 10yrs bigger than films + music @ITMAuk #SpringConference

ITMA @ITMAuk · Mar 20

Not often you get a Dame and a Baroness to pose for a picture together #SpringConference @MadameTussauds @The\_IPO



ITMA retweeted



**Tima Hachem** @TimaHachem · Mar 20

As usual very special sessions and program @ITMA #SpringConference

3 1

# Inside China's IP

*Catherine Wolfe caught up with Shi Hui, IP Officer at the British Embassy Beijing, for a briefing on the developing IP environment*

**Q Catherine Wolfe: How are you seeing the impact of the revised Chinese Trademark Law?**

**A Shi Hui:** The revised Law came into force on 1 May 2014. Many of the changes it introduced – such as the principle that applications are made in good faith and enhanced protection for prior rights – were welcomed by users of the Chinese trade marks system. But it will take time to see the impact of the new measures as cases progress through the system.

The China Trademark Office (CTMO) receives huge volumes of applications, including 2.3 million single-class applications in 2014. Combined with new statutory time limits for various parts of the trade mark examination process, this is putting significant strain on the system. The CTMO has also hired a new cadre of examiners and changed its HR systems.

So far, most feedback from users that we've seen relates to concerns around inflexibility on examination formalities and inconsistency in examination quality as examiners adjust to the new law. In addition, the online trade marks database is experiencing technical difficulties and opposition proceedings have seen delays as resources are diverted to clearing examination backlogs.

Looking ahead, the key point for us is to distinguish between initial growing pains, which are understandable as the CTMO adapts to the new system, and any underlying systemic problems. The UK Intellectual Property Office will incorporate discussion of these

issues into our 2015 bilateral technical exchanges with the State Administration for Industry & Commerce, the parent ministry of the CTMO, and the Trademark Review and Adjudication Board (TRAB).

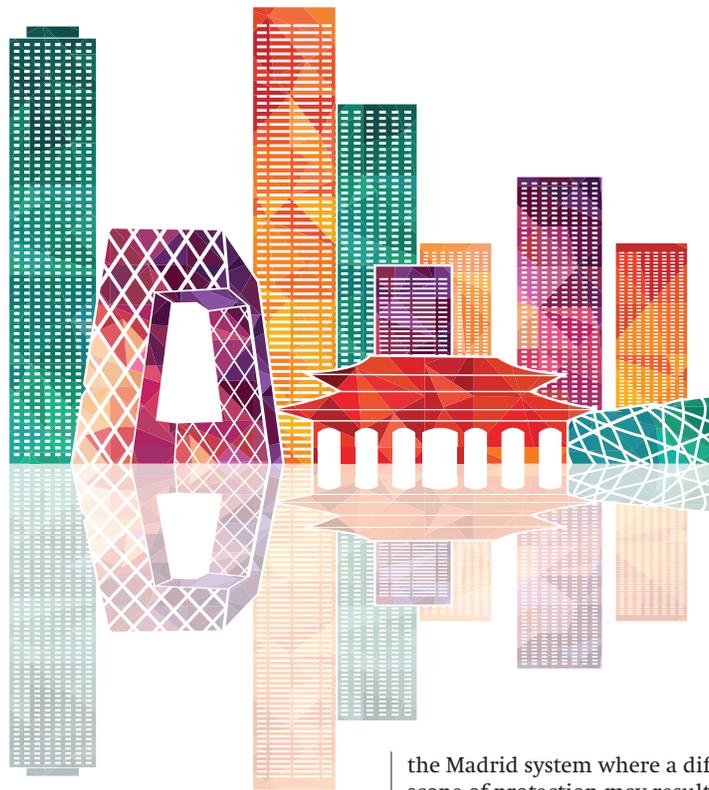
**Do you think we have finally turned the corner on bad-faith filings ("unexpected third-party entrepreneurial filings") in China?**

Not yet, but we do see light at the end of the tunnel. Positive evidence includes efforts to improve the quality of the Chinese trade mark attorney profession. For example, the new Trademark Law does not allow trade mark agencies to directly apply for marks on goods and services beyond the agency's core business. Proactive implementation of this policy by the CTMO will help erect barriers against more opportunist trade mark squatters. Also, the China

Trade Mark Association (CTA) issued several measures, including reviving the Trade Mark Attorneys' examination, indicating government commitment to a higher-quality, better-regulated Trade Mark Attorney industry in China, as well as preventing collusion between attorneys and bad-faith applicants.

In addition, the Supreme People's Court has developed guidance for courts hearing judicial reviews to trade mark examination, opposition and other review decisions issued by the CTMO and TRAB. This guidance includes provisions that strengthen protection against large-scale, targeted, bad-faith applications, for example where a single individual





makes a large number of applications for famous international marks in a particular industry.

**Do you think the Chinese sub-classification system will ever be abolished?**

Given the high volume of trade mark applications in China, the CTMO tends to treat trade mark examination in a highly mechanical manner. The CTMO divides each Nice class into its own unique system of sub-classes, each of which contains a list of standard items of goods or services. When examining a trade mark application, CTMO examiners usually only cross-check an application against a narrow list of sub-classes. More generally, the Chinese trade mark system takes a narrow view on which sub-classes are considered “similar”. This approach is out of line with other international Offices and often results in applicants receiving narrower coverage than they anticipated. Currently, the CTMO has no plans to change the sub-classification system.

Businesses are advised to be aware of the gaps between international practice and the national Chinese trade mark application system, and to take account of the Chinese system of sub-classification when drafting applications and specifications. This is especially important when considering an application through

the Madrid system where a different scope of protection may result in China, in comparison with other countries or regions.

**Can a Trade Mark Attorney contact you for help with a client in China? Do we need supporting documentation?**

A Trade Mark Attorney representing a UK client can get in touch directly with the IP team in the British Embassy. We support hundreds of cases each year and are happy to share this experience with British companies and their counsel. In some cases, the Embassy can consider making representation on behalf of British companies, although this obviously needs to be in line with the legal or administrative strategy pursued by the company.

Our online resources can also provide concise and up-to-date advice. On the gov.uk website there are factsheets outlining the structure of the IP system in China and delving into detail in relation to particular topics, such as obtaining well-known trade mark status. The UK’s IP attaché has also delivered a number of IP-focused webinars, which can be found on the website of the China-Britain Business Council (cbbc.org).

**If there was one piece of advice you could give to UK Trade Mark Attorneys, what would it be?**

Mainland China should be considered as a priority in the filing strategy of



**Backstory:**  
**Shi Hui 石慧**

Shi Hui joined the British Embassy as the IP Officer (Policy) in January 2013. Her *China IP Newsletter* helps UK stakeholders become better informed about IP policy developments in China. Her UK-China IP Salon events are benchmarked as a model on how to engage on IP in China. She also supports the IP attaché to build bilateral relations with Chinese IP-related government agencies.

Prior to joining the Embassy, Shi Hui was an attorney-at-law for an IP law firm in Beijing. She assisted clients from many countries in implementing IP protection in China, with regards to both administrative enforcement and litigation.

Shi Hui studied English at Beijing Foreign Studies University and holds a Masters in IP Law from China Renmin University.

most UK companies. Filing early in China is especially important given the global manufacturing and logistics capabilities of Chinese companies (both for legitimate and infringing products). The high risk of suffering from bad-faith applications – and the inability of the Chinese system to effectively tackle bad-faith filings – should also mean that China is prioritised in a global filing strategy. After obtaining a trade mark in China, companies should monitor the registration for bad-faith applications and also monitor the marketplace to ensure that it is not being infringed.

Finally, Trade Mark Attorneys should remember that Hong Kong and Macao operate trade mark systems fully separate to the Chinese Mainland system.



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# Star attraction

*John Coldham explains why litigators should take particular notice of G-Star*

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**D**esign law used to be seen as a niche subject. Now, however, we are seeing more and more cases in both the Intellectual Property Enterprise Court (IPEC) and the High Court, and later this year the Trunki case will be heard by the Supreme Court. More than ever, both patent and trade mark practitioners need to be able to advise their clients on design protection and enforcement.

With this in mind, when a design case reaches the High Court it should be considered carefully, and the latest case that offers guidance in this area is *G-Star Raw v Rhodi and others* ([2015] EWHC 216), which concerned UK unregistered design rights in jeans.

G-Star is one of Europe's leading denim fashion brands. Its designers created a jean design – the “Arc Pant” – with emphasised, stretched, bent (three-dimensional) knees with an “anti-fit” effect and an extreme amount of fabric around the knee, moving away from G-Star’s successful Elwood design from the mid-1990s. G-Star alleged that various Rhodi styles (sold under the name “Voi Jeans”) were made to the design of

the Arc Pant and, as such, infringed G-Star’s UK unregistered design rights. Rhodi contended that its styles were not copies. Rather, they were created “without reference to the Arc Pant” and were “following general fashion trends in the denim market, and to the extent that their styles have similarities to the Arc Pant this is due to them sharing generic features which had... become common”.

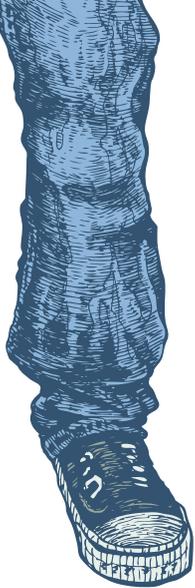
The trial took place in October 2014, with the Judge, Richard Spearman QC, reserving judgment until early February 2015. Ultimately (on 6 February) G-Star succeeded in proving that all nine of Rhodi’s styles infringed its design rights and that four of the Rhodi companies were liable for those infringements.

## Useful lessons

While the case did not provide much in the way of new law, it provided a useful recap of the requirements for success when bringing a design right claim, and some salutary warnings for would-be litigators.

### *Expert evidence*

The Court of Appeal (perhaps most notably in *Procter & Gamble v Reckitt Benckiser*) has criticised the use of



expert evidence in registered design cases. But is such evidence useful in unregistered design cases?

The original permission for expert evidence in this case was on the issue of commonplace, but the Defendants dropped this plea long before trial (but after service of their expert evidence). Although the Judge found G-Star's design to be highly original, the frequency with which parties plead commonplace in unregistered design right cases only to drop it later is a reminder of how difficult it can be to prove. It is much easier to prove lack of subsistence of registered designs and community design right.

In light of the changes to the pleaded case, permission was granted for broader expert evidence. Rhodi's expert argued that he had found "use of the style ideas of which the design aspects are examples, both before late 2007 [the date of design of the Arc Pant] and afterwards". He suggested that these would assist the court to "compare and assess the significance of the similarities between these other uses and the ARC Pant". His evidence largely dealt with where these "style ideas" had been used, and in relation to the differences between G-Star's Arc Pant design and Rhodi's styles he said: "It is only when I closely looked at the work of Estelle Moore and other people that I realised, actually, you know, there are differences that I can spot."

The problem was that the Judge found the evidence of Estelle Moore (a fact witness for Rhodi) to be "simply, and significantly, wrong... misleading and unreliable". In addition to the fact that Rhodi's expert could only see the differences between the Arc Pant and the Rhodi styles when relying on such

*These events are a forceful reminder to parties to litigation to ensure that the fact evidence is both strong and reliable*

misleading evidence, the Judge criticised him for looking at the pleaded designs at too high a level of generality when comparing them with the design corpus.

Finally, Rhodi's expert was found to have put some points a little too strongly. For example, he said that Rhodi's design of a third pattern piece along the inside leg was "not doing the same ergonomic job [as the equivalent section of the Arc Pant] and its purpose is purely aesthetic". However, when during cross-examination he was shown the respective pattern pieces in isolation and asked which was which, he got them the wrong way round. As a result, the Judge questioned the reliability of his evidence.

These events are a forceful reminder to parties to litigation to ensure that the fact evidence is both strong and reliable and that the expert focuses on the question they are being asked, rather than taking a step back and answering a more general question.

However, if the evidence is strong it can be useful. Here the Judge found G-Star's expert evidence in particular to be helpful in providing "coherent and persuasive" analysis as to why Rhodi must have copied.

#### *The independent design plea*

It is common for a defendant to a design right claim to argue that it came up with the design independently. The Judge in G-Star provided useful guidance on the standards expected of defendants in proving their defence: he "expected the Defendants to take care to preserve a full paper trail of the alleged independent design process".

The Judge considered the reversed burden of proof on copying, as set out in *Designers Guild v Russell Williams*:

"If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features claimed to have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying."

The Judge held that the burden was indeed reversed in this case, and that Rhodi did not succeed in discharging the burden in its favour for numerous reasons. These included a lack of evidence from those who allegedly designed Rhodi's styles (except one employee, who was "bad at drawing" and "communicated his design ideas with samples... produced by other manufacturers"), and "glaring gaps" in Rhodi's disclosure, some of which caused the Judge to be "very sceptical about the Defendants' good faith". The lack of disclosure of the design process was seen as telling, and the Judge appears to have drawn an inference from the lack of documentary support for any independent design process that none existed.

Although it was clearly the Judge's view in this case that the lack of disclosure and satisfactory evidence was not simply a result of poor record-keeping, this case should remind all those involved in design of the importance of being able to document the design process. This is true whether you are likely to be a claimant in an action or could be accused of copying. G-Star impressed the Judge with its ability to demonstrate the skill, labour and originality that went into its design, and Rhodi was unable to

## The G-Star Raw Arc Pant



demonstrate that it had employed any independent creativity at all.

### Knowledge

Rhodi's products were manufactured by third parties overseas. As a result, the case concerned secondary infringement. G-Star therefore had to prove either actual knowledge on the part of Rhodi that its styles comprised infringing articles or that, objectively, Rhodi had "reason to believe that this was so". When Rhodi attempted to blame the factories, the Judge said that it would be:

"an unfortunate result... if a person who is aware of the risk that his mode of conducting business may result in copying other people's designs could escape liability for infringement by giving general instructions to foreign manufacturers to produce articles similar to popular designs and then say that if those manufacturers choose to fulfil those instructions by copying other people's designs that is not something that can be laid at his door if he has not looked to see whether copying had occurred".

As this is a common answer given to an allegation of infringement, it will be encouraging for designers to see the Court will give such arguments short shrift.

### Correct test for UKDR infringement?

The Judge conducted a detailed analysis of the infringement test and how it differed to the corresponding test for infringement of copyright. He concluded the difference between

*The lack of disclosure of the design process in this case was seen as telling*

copyright and design right in this respect was simply that "the question of 'part' comes in at the stage of subsistence of the right, rather than at the stage of infringement".

Overall, the Judge held that "the substantial reproduction of the shape and configuration of the Arc Pant Designs and, indeed, the Arc Pant, is evident from comparing [the photographs of each]". He held that "any changes are insubstantial, in that they will not be significant in the eyes of consumers to whom the designs are directed". The guidance he gave should be useful for all would-be litigators of designs:

"Provided the claimant identifies correctly the part(s) of his design which he claims to have been taken exactly or substantially, he will obtain protection against unfair misappropriation of the time, skill and effort that he has expended on creating that design. In those

circumstances, no purpose is likely to be served by investigating the extent to which other aspects of his design are also 'original'. Conversely, if he pleads his design right case too widely, that may cause the claim to fail even if it might have succeeded if it had been advanced on a narrower basis, and the day will not be saved by saying that there are some aspects within the claimed right that are 'original'."

So, it is key to remember that while one must come up with some form of words in pleading to represent the characteristics of the claimed right, they should be sufficiently precise and, ideally, linked to an actual photograph or article, that the court is clear what the rights are. The court can then establish whether the defendant has misappropriated the time, skill and effort and judgement of the claimant and, consequently, whether there has been infringement.



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## CORSEARCH HAS ONCE AGAIN CRUNCHED THE NUMBERS ON WHO'S REPRESENTED THE MOST FILINGS IN 2014

**I**n the tally of filings by UK agents for UK trade marks or Community Trade Marks (CTMs) for 2014, the top billing was taken by Marks & Clerk LLP, with 570 filings for UK trade marks and 702 for CTMs, according to Corsearch's latest data, which was compiled for the *ITMA Review*. Next in line in both mark categories was Barker Brettell LLP, representing 366 UK trade marks and 445 CTMs for its part.

This year's figures represent filings made during the 2014 calendar year, and the tables on the following pages

reflect those UK representatives that made it into the top 100.

Withers & Rogers LLP appears in the top 10 of both lists, third in the volume of UK trade mark filings (362), and fifth in the CTM list (353). Meanwhile, HGF Limited holds a firm fourth in both tallies, with 353 UK trade mark filings and 356 CTM filings. Boulton Wade Tennant also makes a strong showing, just missing the top 10 for UK trade marks (261) and ranking sixth for CTMs (350). Stobbs IP moved into third place in CTM filings, with a robust total of 382 over the 2014 calendar year.

While our tables represent external representatives only, in-house trade mark operations remain active. Corporates that were also the most active in filings include both Batmark Limited with 236 and GlaxoSmithKline (Service Unlimited and Legal Global Trade Marks) with 274. In the tally of CTM filers, Batmark ties with Reckitt Benckiser at 115, with Diageo coming in at 68 and Topps Tiles keeping busy with 62.

Overall, the figures reveal that 12,094 UK trade marks and 14,576 CTMs were filed by the top 100 UK representatives.



# TOP 100 UK TM FILERS

1	MARKS & CLERK LLP	570	=	BIRD & BIRD LLP	102	74	SQUIRE PATTON	60
2	BARKER BRETTELL LLP	366	43	OLSWANG LLP	101		BOGGS UK LLP	
3	WITHERS & ROGERS LLP	362	44	FIELD FISHER	99	75	PETER FUHRMAN	59
4	HGF LIMITED	353		WATERHOUSE LLP		76	ALBRIGHT IP LIMITED	58
5	WILSON GUNN	342	45	WALKER MORRIS LLP	96	=	BRABNERS LLP	58
6	APPLEYARD LEES	339	46	TRADEMARK	93	=	MEI LENG FONG	58
7	URQUHART DYKES & LORD LLP	337		EAGLE LIMITED		79	EVERSHEDS LLP	57
8	MURGITROYD & COMPANY	326	47	SAUNDERS &	90	80	ROUSE IP LIMITED	56
9	GROOM WILKES & WRIGHT LLP	283		DOLLEYMORE LLP		81	LINCOLN IP	55
10	THE TRADEMARK HELPLINE	264	48	BAYER & NORTON BUSINESS	86	=	POTTER CLARKSON LLP	55
11	BOULT WADE TENNANT	261	=	CONSULTANT LTD		83	BLAKE MORGAN LLP	54
12	STOBBS	249		WYNNE JONES LAINE	86	=	MISHCON DE REYA	54
13	D YOUNG & CO LLP	226		& JAMES LLP		=	SERJEANTS LLP	54
14	KELTIE LLP	201	50	RGC JENKINS & CO	85	86	DLA PIPER UK LLP	53
=	REVOMARK	201	51	ALEXANDER RAMAGE	84	=	FRKELLY	53
16	NOVAGRAAF UK	196		ASSOCIATES LLP		=	LONDON IP LTD	53
17	BAKER & MCKENZIE LLP	173	=	STEPHENS SCOWN LLP	84	89	ALBRIGHT PATENTS LLP	52
=	THE TRADEMARK	173	53	BIRKETTS LLP	83	=	MORGAN LLOYD	52
	HELPLINE LTD		54	MEWBURN ELLIS LLP	80		ADMINISTRATON LIMITED	
19	WILDBORE & GIBBONS LLP	172	55	ABEL & IMRAY	78	=	PENNINGTONS	52
20	MATHYS & SQUIRE LLP	166	=	CARPMAELS & RANSFORD	78		MANCHES LLP	
21	SWINDELL & PEARSON LTD	156		TRADE MARKS LLP		92	JEFFREY PARKER	50
22	DEHNS	149	57	HASELTINE LAKE LLP	77		& COMPANY	
=	KILBURN & STRODE LLP	149	58	BATES WELLS &	76	93	TRADE MARK WIZARDS	48
24	TAYLOR WESSING LLP	147		BRAITHWAITE LONDON LLP		94	COLLER IP MANAGEMENT	47
25	FORRESTERS	140	59	BARON WARREN REDFERN	75		LIMITED	
26	BECK GREENER	130	60	BRIFFA	74	=	SANDERSON & CO	47
=	GILL JENNINGS & EVERY LLP	130	61	THE TRADE MARKS BUREAU	73	96	FREEMAN HARRIS	46
=	STEVENS HEWLETT &	130	62	CHANCERY TRADE MARKS	71		SOLICITORS	
	PERKINS		63	ELKINGTON AND FIFE LLP	68	=	NABARRO LLP	46
29	CLEVELAND	129	=	HANSEL HENSON LIMITED	68	98	BROOKES BATCHELLOR LLP	45
30	FRANKS & CO LIMITED	127		IP21 LTD	68	=	BRYERS LLP	45
=	WP THOMPSON	127	66	BOND DICKINSON LLP	65	=	CHAPMAN+CO	45
32	SIPARA LIMITED	126	=	HOGAN LOVELLS	65		<b>Total</b>	<b>12,094</b>
33	SILVERMAN SHERLIKER LLP	123		INTERNATIONAL LLP		68		
34	HARRISON IP LIMITED	119	68	BRISTOWS LLP	63			
35	LEWIS SILKIN LLP	113	=	IRWIN MITCHELL LLP	63			
36	NUCLEUS IP LIMITED	112		TRADE MARK	63			
37	PAGE WHITE & FARRER	111		CONSULTANTS CO				
38	JA KEMP	110	=	VENNER SHIPLEY LLP	63			
39	TRADE MARK DIRECT	108	72	SCOTT & YORK	62			
40	AA THORNTON & CO	103		INTELLECTUAL PROPERTY				
41	BAILEY WALSH & COLLIP	102		LIMITED				
			=	TRADEMARKROOM	62			
				LIMITED				

*\*Figures represent those filers who are the current UK agents for CTMs or UK trade marks for which applications were made between 1 January 2014 and 31 December 2014. Where a trade mark's ownership was transferred from one agent to another during the year, both the first representative and the new one are credited. Figures do not represent WIPO-designated filings.*

# TOP 100 CTM FILERS

1	MARKS & CLERK LLP	702	=	WP THOMPSON	134	77	HANSEL HENSON LIMITED	69
2	BARKER BRETTELL LLP	445	43	SAUNDERS & DOLLEYMORE LLP	129	78	BROOKES BATCHELOR	67
3	STOBBS	382	44	BRISTOWS LLP	126	=	CHARLES RUSSELL SPEECHLYS LLP	67
4	HGF LIMITED	356	=	FIELD FISHER	126	80	GRAHAM WATT & CO LLP	66
5	WITHERS & ROGERS LLP	353	=	WATERHOUSE LLP	121	=	RAPISARDI INTELLECTUAL PROPERTY LIMITED	66
6	BOULT WADE TENNANT	350	46	STEVENS HEWLETT & PERKINS	121	82	SCOTT & YORK INTELLECTUAL PROPERTY LAW	65
7	D YOUNG & CO LLP	343	=	WILDBORE & GIBBONS LLP	120	83	GLOBAL IP LAW LTD	62
8	KILBURN & STRODE LLP	320	48	APPLEYARD LEES	113	84	DECHERT LLP	60
9	RAY YOUNG	298	49	POTTER CLARKSON LLP	113	85	REVOMARK	59
10	FORRESTERS	282	=	SIMMONS & SIMMONS LLP	112	86	MISHCON DE REYA SOLICITORS	57
11	JEFFREY PARKER AND COMPANY	277	51	SILVERMAN SHERLIKER SOLICITORS	109	87	ELKINGTON AND FIFE LLP	55
=	LANE IP LIMITED	277	52	LOCKE LORD LLP	105	88	JOSHI & WELCH LIMITED	54
13	BAKER & MCKENZIE LLP	276	53	VENNER SHIPLEY LLP	101	89	STEPHENS SCOWN LLP	51
14	MURGITROYD & COMPANY	268	54	BRIFFA	98	=	WALKER MORRIS LLP	51
15	DEHNS	264	55	BERWIN LEIGHTON PAISNER LLP	98	91	PHILLIPS & LEIGH	49
16	URQUHART DYKES & LORD LLP	261	=	NOVAGRAAF UK	97	92	BARON WARREN REDFERN	48
17	JA KEMP	241	57	WYNNE JONES LAINE & JAMES LLP	90	93	JEANETTE WOOD	46
18	THE TRADEMARK HELPLINE	220	58	AA THORNTON & CO	88	=	MW TRADE MARKS LTD	46
19	CLEVELAND	209	59	COOLEY UK LLP	88	=	NUCLEUS IP LIMITED	46
20	GILL JENNINGS & EVERY LLP	204	=	TRADEMARKROOM LIMITED	87	96	ASHFORDS LLP	43
=	RGC JENKINS & CO	204	61	FOX WILLIAMS LLP	87	97	CHAPMAN+CO	42
22	CARPMAELS & RANSFORD TRADE MARKS LLP	202	=	NABARRO LLP	85	98	FILEMOT TECHNOLOGY LAW LTD	40
23	TRADE MARK DIRECT	200	63	SANDERSON & CO	84	99	BRIDLE INTELLECTUAL PROPERTY LIMITED	38
24	PAGE WHITE & FARRER	195	64	HARRISON IP LIMITED	83	100	ANSONS	37
25	MEWBURN ELLIS LLP	191	65	ROUSE IP LIMITED	81	<b>Total</b>	<b>14,576</b>	
26	LEWIS SILKIN LLP	189	66	SQUIRE PATTON BOGGS UK LLP	80			
27	MATHYS & SQUIRE LLP	188	67	CLARKE WILLMOTT	77			
28	GROOM WILKES & WRIGHT LLP	183	68	BAILEY WALSH & CO LLP	77			
29	FREEMAN HARRIS SOLICITORS	182	=	KING & WOOD MALLESONS LLP	77			
30	WILSON GUNN	178	=	OAKLEIGH IP SERVICES LIMITED	76			
31	KELTIE LLP	177	71	CHAMPION INTELLECTUAL PROPERTY MANAGEMENT LIMITED	76			
32	OLSWANG LLP	170	=	SIPARA LIMITED	75			
33	REDDIE & GROSE LLP	165	73	BOND DICKINSON LLP	73			
34	TAYLOR WESSING LLP	159	74	ABEL & IMRAY	71			
35	BECK GREENER	158	75	ALEXANDER RAMAGE ASSOCIATES LLP	71			
36	SWINDELL & PEARSON LTD	154	=	WILLIAMS POWELL	71			
37	LADAS & PARRY LLP	153						
38	ALBRIGHT IP LIMITED	151						
39	HASELTINE LAKE LLP	141						
=	SHERIDANS SOLICITORS	141						
41	BIRD & BIRD LLP	134						

Overall, the figures reveal that 12,094 UK trade marks and 14,576 CTMs were filed by the top 100 representatives

# BARRIER GRIEF?



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**"GATEKEEPER" INITIATIVES MEAN THAT TRADE MARK ATTORNEYS MAY NOW FEEL THEY ARE ON THE FRONT LINE IN THE FIGHT AGAINST FINANCIAL CRIME, BUT THERE ARE A FEW BENEFITS TOO, AS JANE JARMAN EXPLAINS**

The IPReg Code of Conduct states that “every regulated person” must ensure they comply with all legislation pertaining to “money laundering” and “proceeds of crime”.<sup>1</sup> The ongoing requirements (to train staff in money laundering compliance; appoint a money laundering reporting officer; screen clients; develop a system to detect and prevent money laundering; and to keep records) can seem excessive in the context of the intellectual property sector, where the risks can seem very low.

As it is common ground that straightforward trade mark registration does not fall within the specific ambit of the Money Laundering Regulations (MLR), why is anti money laundering (AML) compliance an issue? Is it worth the fuss and cost? The problem hides in plain sight. While a simple registration may not be covered by the regulations, other activities are higher risk. Assisting in the due diligence clearance of a portfolio, drafting or reviewing the assignment of a mark, or being caught up in the chain of advice in the event of a deliberate over-valuation in the securitisation of a portfolio casts the attorney as an actor in a potential criminal enterprise.

Yet the rationale behind the rules – to “freeze out” the proceeds of crime from the legal and financial sector – is critical. While the practitioner is not required to go on an unpaid detecting spree to find criminal conduct, research indicates that the legal profession is vulnerable to sophisticated money laundering

techniques. Research also shows<sup>2</sup> that money laundering techniques have moved beyond the traditional heartland of conveyancing into a variety of legal sectors. In fact, lawyers are specific targets, as they add credibility to the transaction. The trade mark lawyer is not immune.

### Defining terms

Some money laundering offences can be committed by anyone, while others can only be committed by those in the “regulated sector”. More of those distinctions later. First, what actually is “money laundering”? The most common definition is an action that aims to disguise the origins of the benefits of criminal conduct. The aim is to place “dirty money” into the financial system via a series of transactions through which the money is “layered” in until it is fully “integrated” and “clean”. Of course, it is unlikely that a lawyer will find a client in reception with £10,000 in a bag marked “swag”. Lawyers are used at the “integration” stage in order to further disguise its criminal provenance. The wide definition of criminal provenance is pivotal.

The Proceeds of Crime Act 2002 (POCA), in Section 340, defines criminal conduct as that which:

“(a) constitutes an offence in any part of the United Kingdom, or

(b) would constitute an offence in any part of the United Kingdom if it occurred there.”

Section 340(3) defines property as criminal property, if:

“(a) it constitutes a person’s benefit from criminal conduct or it represents such a benefit (in whole or part and whether directly or indirectly), and

(b) the alleged offender knows or suspects that it constitutes or represents such a benefit.”

The definition in Section 340 is wide. There is also a curious *mens rea* element embedded in the definition of “criminal property”, in that property “becomes” criminal property if a person knows or suspects that the property constitutes or represents a benefit from criminal conduct. The benefit need not necessarily be hard cash. Knowledge is key.

Unfortunately, the term “suspicion” is not used consistently. It appears in various guises in the legislation: suspect/reasonable grounds to suspect/reasonable cause to suspect. The courts have struggled to provide a succinct definition, although *R v Da Silva* is the most compelling: “The essential element in the word ‘suspects’ and its affiliates, in this context, is that the defendant must think that there is a possibility, which is more than fanciful, that the relevant facts exist. A vague feeling of unease would not suffice.”<sup>3</sup> To that extent, there must be a settled suspicion that money laundering is taking place.

What emerges from the case law is a need to be specific about the nature of suspicion. A blanket view along the lines “this feels a bit odd” is insufficient. This is a relief!

### Potential problems

Considering this background, there are two types of offence that could be committed by a Trade Mark Attorney. The first is a “primary” money laundering offence under Section 327-329 of POCA, which can be committed by anyone. The second



is a “satellite” offence of “failing to report”, which can only be committed by a party in the “regulated sector”. The problem for the lawyer is that it is possible to slip into both categories.

Section 327: concealing, disguising and transferring

Section 327 makes it an offence to conceal, disguise, convert criminal property or remove criminal property. Section 327(3) states that concealing or disguising includes “concealing or disguising its nature, source, location, disposition, movement or ownership or any rights with respect to it”. There is no *de minimis* clause. Just forming one small link in the transactional chain is enough.

Section 328: arrangement

Section 328 states that a “person commits an offence if he enters into or becomes concerned in an arrangement which he knows or suspects facilitates (by whatever means) the acquisition, retention, use or control of criminal property by or on behalf of another person”.

The Financial Action Task Force noted that lawyers are especially vulnerable to this offence, as launderers seek to use professionals to clean the proceeds of their criminal conduct. It is easy to fall into this type of offence, even if the attorney is one of a team of professionals working on a transaction.

Section 329: acquisition, use and possession

According to Section 329, a person commits an offence if he:

- (a) acquires criminal property;
- (b) uses criminal property;

## RED FLAGS

What are some warning signs that point to money laundering? The Financial Action Task Force’s extensive study of the vulnerabilities of the legal profession worldwide<sup>5</sup>, identifies a number of “red flags” to aid risk analysis concerning client identity and beneficial ownership, of which the most important are:

### CLIENT BEHAVIOUR

- Evasive about beneficial ownership or source of funds.
- Uses an intermediary for no reason.
- No internet presence or presence involves an unusual domain name.

### SOURCE OF FUNDS

- Multiple bank accounts are used without good reason.
- Source of funds is unusual; a high-risk country is involved or third-party payment is requested for no good reason.

### THE NATURE OF THE RETAINER

- Unusual transaction because of size, nature, frequency or manner of execution.
- Client requests short cuts or there is unexplained speed required in completion.

(c) has possession of criminal property.

This offence can be committed by using criminal property, or passively or inadvertently coming into possession of it, subject to relevant *mens rea*. A necessary component of the offence is that the defendant had requisite knowledge that the property represented the benefit from criminal conduct. It is a defence to any one of the primary money laundering offences under Section 327 to 329 to make an “authorised disclosure” to the National Crime Agency (NCA) under Section 338 of POCA by way of the firm’s money laundering reporting officer and then await consent, which is either actual consent or implied by expiration of a specified moratorium period.<sup>4</sup> The Suspicious Activity Report (SAR) notification is a link in the chain against organised crime.

Section 330: the “gatekeeper” offences

At the inception of POCA, Section 330 proved the most controversial. The requirement (indeed duty) on those in the “regulated sector”, of which the provision of legal services is one<sup>6</sup>, to make SARs where they “know or suspect” or “have reasonable grounds for knowing or suspecting” seemed an imposition. This is the “gatekeeper” provision. The higher standard of client due diligence (CDD) that underpins the scheme aims to deny money launderers the commercial oxygen of the legal system.

## MLR 2007 – in or out?

The Money Laundering Regulations 2007 (MLR) apply to “independent legal professionals”<sup>7</sup> providing “legal services...when participating in financial or real property transactions”



in relation to “the managing of client money...or other assets.”<sup>8</sup> So, it is necessary to consider, for each retainer or transaction (and during its currency), whether the lawyer is a “relevant person” for the purpose of the regulations and an error in interpretation is a criminal offence.

Initially, barristers were not “in”, unless, of course, they were barristers advising on tax law or acting under new direct access arrangements. Solicitors have adopted MLR clearance measures across the board, as have insurers. Life insurance is “in” and general insurance is “out”, but MLR compliance is seen as best practice.<sup>9</sup>

The regulations promote a “risk-based” approach. It is based upon a metric of client type demographic and high/low risk areas of law. A “risk-based approach” and any CDD protocols are based on the nature of the client, the type of instructions and the type of transaction. CDD is concerned with identity verification, beneficial ownership and the purpose of any transaction. There should be a system outlining the circumstances when Simplified Due Diligence and Enhanced Due Diligence procedures are indicated<sup>10</sup> and a protocol for NCA disclosures. A stable client base for trade mark renewals would be seen as low risk.

**CDD: Regulation 17 MLR**

Is it possible to rely on MLR clearance by a foreign agent? The only viable answer is: “It depends.” While it is possible to rely on another regulated party to complete CDD checks for you, if they get it wrong, you still remain liable. On a risk-sensitive basis, instructions from a UK solicitor to

undertake work is very low risk, given their regulatory obligations.

The position is more difficult outside the UK. In the EEA you may rely on an independent legal professional if they are subject to mandatory professional regulation and the 3rd Money Laundering Directive has been enacted in that jurisdiction. Outside the EEA you must be satisfied that they are an independent legal professional, subject to the regulatory requirements (including supervision) of at least an “equivalent”<sup>11</sup> nature to the 3rd Directive. A tall order for a short instruction. What is the best response?

The best source of information on this issue is the IBA’s AML Forum<sup>12</sup>, which provides a snapshot of AML compliance worldwide. Also, “flag” that you are relying on the party instructing you to ensure compliance with their own AML requirements. Some countries are not compliant.

At the end of the day, you do need to make some form of risk assessment. If you then decide that a particular type of introduction is of a low-risk nature, document why this is the case.

**Final thoughts**

MLR compliance is an administrative factor, but it should not be a disproportionate burden. The “gatekeeper” initiative limits the vulnerability of the sector to

launderers and promotes the definition of specific retainers and beneficial ownership of various IP rights. Not quite two for one, but a useful by-product of the regime.

- 1) Rule 11: Financial Matters, Rules of Conduct for Conduct for Patent Attorneys, Trade Mark Attorneys and Other Regulated Persons (2015) (“the Code”).
- 2) See FATF Money Laundering and Terrorist Financing Vulnerabilities of Legal Professionals (June 2013). See IBA in conjunction with the ABA and the CCBE, A Lawyer’s Guide to Detecting and Preventing Money Laundering (October 2014) <http://www.anti-moneylaundering.org/AboutAML.aspx>
- 3) R v Da Silva [2006] EWCA Crim 1654 para 16.
- 4) The NCA website provides very helpful information as to the system for online SAR reporting, as well as the rationale for its use. <http://www.nationalcrimeagency.gov.uk/about-us/what-we-do/specialist-capabilities/ukfiu/the-sars-regime>
- 5) FATF Money Laundering and Terrorist Financing Vulnerabilities of Legal Professionals (June 2013) <http://www.fatf-gafi.org/media/fatf/documents/reports>
- 6) Ie caught by the Money Laundering Regulations 2007.
- 7) Regulation 3(1)(d).
- 8) Regulation 3(9).
- 9) See Lloyd’s of London Market Bulletin Y4161 (13 June 08).
- 10) A good deal of trade mark work will be low risk, especially when introduced by other professionals such as lawyers, where the attorney will be able to rely on clearance by another regulated professional (Regulation 17) or perhaps simplified due diligence procedures (Regulation 13) given the nature of the client.
- 11) Equivalence is a difficult issue. The Joint Money Laundering Steering Group has provided some guidance notes but remember that your relationship with a particular professional as agent is a “risk sensitive” element. The clearance requirements should be proportionate to the work being undertaken. In terms of appreciating red flags in compliance the IBA website is more user friendly.
- 12) <http://www.anti-moneylaundering.org/Default.aspx> is an excellent source of important and up-to-date information.



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# Rare opportunity to reach IPO

*Chris Morris recounts an evening that offered updates and insights on the work of the UK Office*

**O**n 12 February, Burges Salmon LLP hosted around 80 delegates for a joint ITMA and IPO seminar. The IPO brought almost 40 representatives to the Bristol event, with a similar number of ITMA members also attending. The event, a repeat of one held at the same venue two years ago, offered a rare opportunity for the two sides to meet outside of proceedings.

After a welcome from ITMA President Chris McLeod, Jeremy Dickerson (Head of IP at Burges Salmon) and Sean Dennehey (IPO Director of Patents, Trade Marks & Designs), the first of four presentations from the IPO began.

Nathan Abraham, Head of Examination Practice, provided an update on *ex parte* proceedings. He

opened with some statistics on the continuing buoyancy of the UK's national trade mark system. Application figures continue to rise, with around 50,000 new applications in the year 2014/15. Consequently, the IPO has recruited, and is now training, a new batch of examiners.

## Convergence updates

Abraham also provided an update on various OHIM convergence programmes, from the UK perspective. CP4, on the scope of

protection of black-and-white marks, and CP5, on how to compare trade marks with common elements of little or no distinctiveness, are both settled and in place. Attendees were provided with a range of indicative examples of how the practice will be applied, which should provide a useful tool for practitioners. We also heard about the yet-to-be-endorsed convergence programme on "surplus" – in other words how much, and what, extra matter needs to be added to an otherwise unregistrable

*The IPO is keen for the conversation with users to carry on*



## Trade mark application figures continue to rise, with around 50,000 new applications in the year 2014/15

sign to get it over the line. Abraham indicated that this had proved to be a tricky area for a common practice, with diverging views across Member States, particularly in relation to the use of colour.

Oliver Morris followed Abraham and gave us an *inter partes* update, also opening with some figures. While the number of oppositions continues to rise (15 per cent year on year) the proportion of applications opposed remains broadly static at 4 per cent. Processing speeds continue to be impressive, with 84 per cent of proceedings reaching a decision within 15 months (against a target of 75 per cent). Next year the aim is for 75 per cent to reach a decision within only 12 months. Case management conferences were pointed to as a key driver here.

Morris then provided some insights in relation to recent revocation decisions and proof-of-use requirements. He ran through a selection of tips on how to structure evidence, how and what to file, and some comments on late filing of evidence, referring especially to the Gucci decision.

### Reform review

Simon Haikney spoke next, with an update on the EU trade mark reform package and the IPO's efforts in the



lengthy negotiation process. He outlined the UK's priorities in negotiations, with a focus on benefits for SMEs (hence the UK arguing for retention of OHIM search reports in some form, with formal watching services felt to be prohibitively expensive for small business).

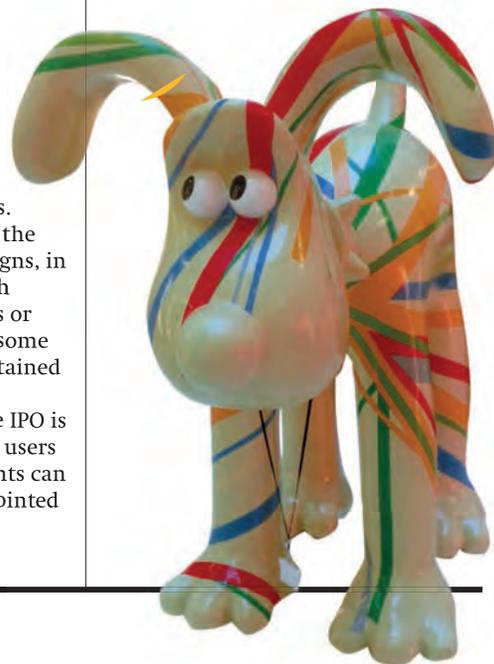
Haikney stressed the negotiator's mantra that "nothing is agreed until everything is agreed", but provided examples of where it looks like consensus has been reached. The hope and intention is that the process will be concluded before the end of the Latvian presidency in June.

Finally, Lynda Adams outlined the IPO's plans for modernising registered designs. She gave a frank assessment of the current problems with UK designs, in particular when compared with Registered Community Designs or the German system, as well as some even more frank comments obtained from users.

As the system is updated, the IPO is keen for the conversation with users to carry on so that improvements can continue to be made. Adams pointed to a statistic that, following consultation and the resultant

changes to the application form, formalities-type errors in applications have dropped from 88 to 47 per cent.

Following an audience Q&A session, the evening concluded with drinks and an opportunity for more informal discussions, as well as one-to-one demonstrations of the IPO's work-in-progress online design application form.



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# How to do delegation better

*Bernard Savage puts an end to the idea that people that pass on a task are simply passing the buck*

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**L**eadership in some IP firms is largely misunderstood. The tendency is for grey hair to take precedence as a selection criterion over an aptitude to lead. In truth, excellent attorneys do not always make the best leaders. And why should they? It's a completely different activity. One activity centres on people and soft skills and the other on technical knowledge. This is compounded in most firms by the lack of investment in non-technical skills training and a culture where delegation is regarded as "passing the buck" and not a strategy for developing future leaders. So what is going wrong in leaders' management of delegation, what should be delegated and how can it be done better? Perhaps the problem lies in how people think about delegation. Many wrongly regard it as being about abdicating responsibility and giving people tasks to do that they don't want to do themselves. Another incorrect assertion is that you can only delegate to subordinates in an



organisation, usually direct reports. Key to making progress is rethinking what delegation is and isn't.

### Right tasks, right people

Delegation is about assigning the right tasks to the right people. Identifying the right people is a leadership role and is based on making an informed commercial evaluation. How do you do that? It's a combination of calculating the cost of everyone's time in the firm and then matching activity to skill set. In simple terms, if Janice is the team leader and, as a partner in the firm, has a £350 per hour charge-out rate, it is more cost-effective for John, an attorney with a £175 per-hour tariff, to complete activities that don't realise £350 per hour value. Similarly, in assigning business-development activities, it makes commercial sense for confident networkers to host client events and those with an aptitude for writing to be delegated the task of producing client publications and getting articles placed in targeted press.

There are three questions a leader should ask in respect of a potential task to be delegated:

1. Who else could do this job?
2. Who could do it better?
3. Can the job be done at a lower cost?

Another thing that makes delegation more difficult and poorly implemented is time management. When tasks are delegated at the last minute, the person being delegated to will feel "dumped on" and a project brief is likely to be poor. This results in a poor-quality end result. Leaders must be respectful of others' time (even those of lower rank) and practise strong time management. Delegating tasks on realistic timescales ensures that delegation is better received and delivered.

### Corporate lessons

Ask fee earners in your firm: "What percentage of your continuing

professional development points have been in non-technical skill development?" and the answer is likely to be under 5 per cent. This is where the conundrum lies, since commercial success is more to do with a firm's leadership, communication skills, time management, marketing and business development and, yes, delegation – all of which come under the umbrella of "people skills". Such skills are not always as carefully shepherded within IP firms as by these organisations' corporate clients. In fact, there are some important lessons that professional services firms, such as IP firms, can learn from the corporate world:

1. **Engagement is more important than carrots and sticks.** Much bookshelf space is given to rewards and punishment, but the smarter way to boost internal morale and get things done is to focus on engaging employees. It is critical to be clear, consistent and to communicate regularly using all channels available.
2. **People are motivated by different factors.** Business leaders must know the psyche of people who report to them and to whom they are likely to be delegating work. Is "John" motivated by money, personal appreciation or public recognition?
3. **People have preferred communication styles.** Some people like to have information presented to them in writing, others respond better to an oral brief, some interpret the world around them visually, others through touching and feeling objects and materials. Leaders need to understand these personal differences and communicate accordingly.

### 4. Emotional buy-in must come first.

People only do what they really want to. They may pay lip service to ideas and appear to toe the line, but getting them to take action is another matter. Leaders who are most able to effect change and delegate tasks understand this principle of influence and will invest more time up-front explaining the context and relating what is being asked to personal drivers, such as a promotion or a new role.

5. **Transparency is necessary.** If people can see how a task relates to personal goals and measures, they are likely to be more receptive to what is being delegated, as they feel it's a positive activity that will contribute to them achieving their desired outcomes.

6. **Give clear instructions.** Effective delegation highlights what needs to be done, why, when and how.

7. **Remove obstacles.** An effective leader identifies barriers that are getting in the way of people and finds ways to remove them.

It's important to also recognise that improving delegation is a two-way process. It's not all about leaders, those being delegated tasks need to have the right mind-set too. Delegation is, after all, an opportunity to learn, grow and flourish. Promotions and new opportunities can be a result of rising to the challenge of successful delivery of tasks one has been delegated.



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# Enterprise beats rival Europcar

Yet James Sweeting has misgivings about the Judge's approach to injunctive relief

**E**nterprise, the Claimant in this case, is the largest vehicle rental company in the world.

Defendant Europcar is a large European-based vehicle rental company. Between them, Enterprise and Europcar have more than 50 per cent of the market share in the UK for vehicle rental.

The dispute arose when, having decided that it needed a brand refresh, Europcar began to use a logo (the 'e-moving logo') in 2012, which it deemed more adaptable and capable of being used as a symbol or 'icon' to stand for Europcar, particularly in the digital environment.

Following the introduction of this new logo, Enterprise alleged that Europcar had infringed 10 UK Registered Trade Marks and Community Trade Marks (CTMs) and committed passing off.

## Logos and use

There was substantial evidence of Enterprise having used its 'e' logo in 'solus' form (see image overleaf) in green, including use on customer-facing vehicles and signage. Use was

also found to be prominent in the digital environment, including in social media.

In considering the Europcar use, the Judge identified three different categories of use that had taken place since the brand refresh:

*Category 1:* Solus use (for example, as the icon for an app):



*Category 2:* Use in combination with a 'secondary brand', for example:



*Category 3:* Use in combination with the word 'Europcar':



## Infringement - colour

The Judge based his assessment of infringement on Enterprise's CTM registered in black and white for services including vehicle rental services (shown right).

There was a green trade mark in suit, but Europcar had applied to OHIM for this mark to be revoked for non-use, so the infringement claim was stayed pursuant to

Article 104 Regulation (EC) No 207/2009 (CTMR) insofar as it related to that mark. Enterprise asked that the stay be lifted and the Judge criticised Europcar for not agreeing to that, saying: In my view, Europcar should have agreed to the stay being lifted, so as to enable all the issues between the parties with regard to infringement in the UK to be resolved in one trial."

As it happened, the Judge (citing the Court of Justice of the EU - CJEU - in *Specsavers*) did not consider this to be an issue. *Specsavers* made it clear that where a CTM is not registered in colour, but has been used extensively in a particular colour, and so has become associated in the mind of a significant portion of the public with that colour, that is relevant in the global assessment of the likelihood of confusion or unfair advantage.

## Survey evidence

In addition to evidence of use, scope of use and trade evidence, Enterprise had commissioned street surveys to support the proposition that its mark was deserving of enhanced protection. While the tide is against the notion of consumer surveys being able to provide the Court with reliable evidence of confusion, Enterprise had successfully sought permission from Mr Justice Morgan to get this evidence in for the purpose of establishing enhanced distinctiveness. Arnold J remarked that he favoured the survey carried out by Enterprise, which provided the respondents with market sector context when asking them whether they recognised the



## A key benefit of a CTM is the potential for the proprietor to obtain EU-wide injunctive relief on a finding of infringement

mark. In his judgment on costs, the Judge confirmed that he had found the survey evidence to be of “real value” in assisting him to reach his finding that Enterprise’s mark did have an enhanced distinctiveness, thereby perhaps paving the way for similar exercises in the future.

### *Average consumer*

The Judge considered the notion that, as set out in *Interflora III* by the Court of Appeal, the average consumer is a legal construct and “does not amount to a single meaning rule or a rule restricting consideration to the reactions of a single hypothetical person”. He also considered the transnational nature of vehicle rental and accepted that attitudes of non-UK nationals should be factored in to the assessment (albeit with caution).

### *Similarity and context*

Although the Judge found that there was some but “not a great deal” of similarity, the average consumer who had an imperfect recollection of the Enterprise logo and then saw the Europcar logo could mistake the latter for the former. He looked, in

particular, at the context of use and made it clear that he felt the ‘e-moving logo’ was a unifying factor across the Europcar brand.

### Decision and relief

The Judge found in Enterprise’s favour on Article 9(1)(b), taking the above factors into consideration (together with evidence of actual confusion) in determining infringement. He also found there to be passing off.

A key benefit of a CTM is the potential for the proprietor to obtain EU-wide injunctive relief on a finding of infringement. The CJEU in *DHL* (C-235/09) – in part a double identity case – confirmed that, to ensure uniform protection, a prohibition against further infringement or threatened infringement must, as a rule, extend to the entire area of the EU. This may not be the case in circumstances where “the defendant proves that the use of the sign at issue does not affect or is not liable to affect the functions of the trade mark”. Note here that the burden of proof is on the defendant.

In *Enterprise*, Arnold J said that 9(1)(b) and 9(1)(c) infringements did not follow the same logic as under Article 9(1)(a) and he reversed the burden, placing the onus on the Claimant to show that there is justification for an EU-wide remedy. In this case, he determined that Enterprise had not gone far enough in satisfying that burden, as much of the evidence on distinctiveness and

confusion was pointed towards the UK. Arnold J accepted: “It is far from clear that interpretation of the law is correct.”

### Conclusion

The first judgment appeared to provide clear guidance for practitioners on successfully deploying evidence of distinctiveness and confusion to win a trade mark and passing off case. However, the outcome of the relief hearing means that, in 9(1)(b) and 9(1)(c) cases, a claimant (rather than simply relying on a CTM) may also have the burden of having to deploy a vast body of pan-European evidence to support pan-European relief. It remains to be seen whether higher courts will accept this as the right approach.

#### The Enterprise marks



Solus form



Black and white CTM

#### Europcar logos



Pre-refresh (1989) version



2012 ‘e-moving logo’



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# Whitby's van victory

In this design rights case infringement was almost inevitable, concludes Dr Brian Whitehead

**T**his case concerned registered designs, UK unregistered design right (UKUDR) and registered trade marks in relation to ice cream vans. Although the legal issues considered were entirely conventional, the decision sets out a useful summary of the approach to deciding validity and infringement of registered designs and UKUDR.

The Claimant, Whitby, is a major manufacturer of ice cream vans in the UK. Manufacture of these vans involves fitting a body and interior to a commercial van chassis. Whitby created the design in question, known as the Mondial, in 2006.

The First Defendant was a company owned by the Second and Third

## As well as constituting trade mark infringement, the existence of the mould was powerful evidence of copying

Defendants, who are brothers. The Fourth Defendant was the father of the aforementioned and his involvement in the First Defendant's business was disputed.

### Registered design

Mr Justice Arnold set out a detailed summary of the applicable law. These points were of particular relevance:

- In general, the greater the degree of the designer's freedom, the broader the scope of protection given to a registered design.
- Similarly, if a registered design is markedly different to the design corpus, it will generally receive a broader scope of protection than a design that differs only slightly from it.
- Although it is relevant to look at similarities and differences between respective designs, the main thing to consider is the overall impression produced on the informed user, having regard to the design corpus and the degree of freedom.

The Mondial was acknowledged to be an evolution of earlier Whitby designs, and had a number of features in common with them. It was held to be sufficiently different to the earlier designs to possess individual character, and the registered design was therefore valid. Although the scope of protection was relatively narrow, given that there were only "minor differences" between the Defendants' van and the registered design, infringement was made out.

### UKUDR

With regard to the UKUDR, Arnold J again set out a detailed summary of the law, the key features of which are:

- Whether or not an alleged infringement is made substantially to the protected design is an objective test, to be decided through the eyes

of the person to whom the design is directed.

- The above issue must be decided at an appropriate level of abstraction, which will not normally be at a higher level than that exhibited by the article that embodies the design.
- Similarly, the issue of whether a design is commonplace must be decided at that same level of abstraction.

The original version of Section 213(2) of the Copyright, Designs and Patents Act 1988 (CDPA) read: "In this Part 'design' means the design of any aspect of the shape or configuration (whether internal or external) of the whole or part of an article."

On 1 October 2014 the words "any aspect of" were deleted from the above, pursuant to the Intellectual Property Act 2014. In the earlier case of DKH Retail Ltd v H Young (Operations) Ltd, [2014] EWHC 4034 (IPEC), it had been common ground that the amendment was fully retrospective. Arnold J doubted the correctness of that, but declined to rule on it, as it would have made no difference to the outcome of this case.

Similarly, whereas the Judge was prepared to assume that the word "original" in Section 213 CDPA has the same meaning as in copyright law, thereby importing a requirement of creativity on the part of the designer into UKUDR law, he declined to rule on the issue, which will have to be decided in a future case.

Whitby alleged infringement of UKUDR in 19 different designs in

various aspects of its Mondial van. The Judge held that all the designs were original, most were not commonplace and most were not excluded on the basis of the "must fit" or "must match" grounds. Given the similarities between the Defendants' van and the Mondial, and their late admission that the Mondial had been copied, a finding of infringement was made.

### Infringement

The Defendants had originally denied copying. However, Whitby produced a photograph, downloaded from the Defendants' Facebook page, of a mould of the Mondial's drive shaft cover bearing the words "WHITBY MORRISON" in reverse. As well as constituting trade mark infringement, the existence of the mould was powerful evidence of copying.

### Liability

The Judge found the Second and Third Defendants liable for the company's infringements and also, despite the Defendants' assertions to contrary, found the Fourth Defendant jointly liable. The Judge was critical of the Defendants' evidence on this point, holding that the Second and Third Defendants were covering up their father's involvement, and that the Fourth Defendant had not told the truth as to his involvement.

### Summary

Given the degree of similarity between the respective designs and the strong evidence of copying, a finding of infringement was almost inevitable. It may be that it was only the Defendants' approach to this litigation – denying copying, only to admit it under cross-examination when faced with evidence – that made a full trial necessary. If so, the Defendants may have cause to regret their intransigence when presented with the inevitable costs order against them.



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# Topshop flop

Rihanna ruled victorious in this fashion dispute, writes Olivia Gregory

Over the past few years, pop star Rihanna and Topshop have put on quite a show for us in relation to a top, which featured an image of Rihanna. It has been a very entertaining case to follow, but the time has come for those involved to, to quote a Rihanna hit, “take a bow”. The appeal was decided on 22 January 2015 and Rihanna has again emerged victorious.

In summary, in 2012 Topshop began to sell tops bearing the image of Rihanna, as shown on this page. The copyright in the image, owned by an independent third-party photographer, was licensed to Topshop but Topshop did not seek permission from Rihanna herself to use it on the merchandise.

In some territories, such as certain US states, France, Germany and Spain, it is possible to establish image rights (rights over the reproduction of an individual’s image). However, in the UK, as set out in the original decision from Justice Birss, there is “no such thing as a free-standing general right by a famous person (or anyone else) to control the reproduction of their image” (Fenty and others v Arcadia Group Brands Limited (t/a Topshop) and another [2013] EWHC 2310 (Ch)).

When Rihanna wanted to challenge Topshop’s activities, she had to do so on the grounds of “passing off”. For a successful passing off claim, it would need to be shown that: (i) Rihanna has goodwill in the image; (ii) Topshop has misrepresented the image so a substantial number of consumers will be deceived into believing that Rihanna authorised the product; and (iii) Rihanna has suffered damage because of this.

It was decided by Justice Birss and upheld on appeal that Rihanna successfully met all three requirements. That Rihanna is known in the fashion industry and as a fashion icon, that the image was famous (it was taken during a video shoot that was much publicised) and that Topshop has forged links with Rihanna in the past were all material in reaching this decision.

## Unusual attention

The case has received much press attention and the fact that a celebrity has been able to prevent the use of their image on goods is unusual. However, it should not be confused

## The Topshop product



*When Rihanna wanted to challenge Topshop’s activities she had to do so on the grounds of ‘passing off’*

with being legally groundbreaking. In this decision, Lord Justice Kitchen reiterates that “passing off is not designed to protect a person against fair competition” [33] and Lord Justice Underhill comments that he “regard[s] this case as close to the borderline” [63]. Therefore, in the UK, there is nothing to stop images of celebrities being reproduced without permission and it may often be perfectly legal. However, someone famous is not excluded from preventing the reproduction of their image where consumers are deceived into believing that the images used are used with permission. A case involving a celebrity image will be treated in the same way as any other passing off case. It just so happens that in this instance and on these particular facts, this well-known image of Rihanna on tops sold by Topshop amounted to a situation in which consumers would assume an authorised link between the two that wasn’t there.



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# Imperial cedes CTM territory

Questions about UK reputation contributed to the Opponent's loss, reports Mark Caddle

**O**n 13 March 2013, IC Music and Apparel GmbH applied to register the mark IMPERICON as a UK Trade Mark in classes 25 (including clothing, footwear and headgear) and 35 (including wholesale and retail services connected with the sale of various accessories, textiles, clothing, footwear, headgear and headwear, online and offline).

The Application was opposed by Imperial S.p.A. on the basis of two earlier European Community Trade Mark (CTM) registrations for the mark IMPERIAL in classes 25 and 35 (the Earlier Marks). The Opponent relied on Sections 5(2)(b) and 5(3) of the UK Trade Marks Act 1994. As the Earlier Marks are more than five years old, the Applicant requested the Opponent prove they had been put to use in the EU. In light of the evidence provided, the goods and services of the Opponent's Earlier Marks were limited to reflect a fair representation of those the Opponent was actually offering in the EU, namely:

- Class 25: Clothing, ready-made clothing for ladies and gentlemen; namely coats, shirts, jackets, trousers, jerseys, bomber jackets, overcoats, neckties and handkerchiefs.
- Class 35: Retailing and wholesaling of ready-made clothing and accessories, footwear, hats, caps and jewellery via shops and department stores.

## Key factors

The average consumer of the Applicant's goods and services was deemed to be the general public. For wholesale services in class 35, the average consumer will be business

consumers and a selection of these services will generally involve an increased level of attention and negotiation during purchasing.

The Application claimed protection for the broad terms "clothing, footwear and headgear" in class 25. Therefore, the clothing items covered by the Earlier Marks were held to be identical to these goods. In addition, the Opponent's class 25 goods were held to serve the same purpose as the Applicant's footwear and headgear goods. They are, therefore, similar. Also, they are often found in the same departments of retail outlets.

It was also held that the class 35 services of the Opponent are reasonably similar to those claimed in class 35 of the application (with the exception of some related to e-commerce and advertising, which consist of commercial services offered by businesses to other businesses).

In comparing the marks, the following assessment was made:

1. Overall, there is a low-to-moderate degree of visual similarity between the marks. The initial six letters of the marks are identical, but the endings -CON and -AL are very different.
2. There is a low-to-moderate degree of aural similarity between the marks. The marks at hand comprise four syllables, but only the first syllable will be pronounced identically. The word

endings sound quite different.

3. The marks were held to be conceptually different. The average UK consumer will immediately recognise the word IMPERIAL due to its obvious meaning. On the contrary, the mark IMPERICON will be unknown to the average consumer as it is an invented word.

## Decisions

Since IMPERIAL will be recognised by the average UK consumer and IMPERICON will not, there is no likelihood of confusion, even when the marks are used in connection with identical goods and services. The conceptual differences between the marks offset their low-to-moderate level of aural and visual similarity. On that basis, the opposition under Section 5(2)(b) failed.

The Opponent also alleged that its Earlier Marks enjoy a reputation in the UK. However, there was no evidence of advertising in the UK or promotional material targeted at UK consumers. Although the Opponent's marks may be reputed in the EU, such reputation does not extend to the UK *per se*. The Opponent's assertions pursuant to Section 5(3) were unsuccessful. The Opposition was refused in its entirety and an award of costs was made in favour of the Applicant.



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# No sweet ending for Sonafi

Yana Zhou illustrates why a new confectionery mark was decided to be descriptive

The Hearing Officer's reasoning in this decision reminds us of the importance of ensuring that one's use of a brand is not in a descriptive sense, of noting how a mark is being used in the marketplace and of filing for a registration as soon as possible.

The Applicant, Sonafi, applied for International Registration No. 1155277 BLOND designating the UK for a range of cocoa products including pastry and confectionery. The UK IPO provisionally refused the application under Section 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 – that the mark consisted exclusively of a sign which may serve in trade to designate the characteristics of the goods, eg confectionery that is blond in colour.

## Shades of blond

The Applicant requested the specification be restricted to "chocolate". The Examiner was not persuaded and referred to internet articles in which parties were using the term "blond" descriptively for chocolate. These sources were, however, essentially about the Applicant. The Applicant sought an *ex parte* Hearing.

In the Hearing, the Applicant provided several submissions: that "blond" almost exclusively refers to hair colour, that "blond" is not normally used to describe chocolate, that colour is not associated with the flavour of the chocolate, that "blond" would differ significantly from the usual way of designating chocolate, that it would be incorrect to deny registration based on the vague

possibility that other traders may wish to use it (Case 0/391/12 Sushi) and that the internet references raised by the Examiner referred to the Applicant.

The Hearing Officer was not convinced. The Applicant submitted a form TM5 and requested the full reasoning behind the Hearing Officer's decision – such a request is usually a precursor to an appeal.

In her reasoning, the Hearing Officer concludes that, in relation to section 3(1)(c), "blond" is a common word that would be understood to refer to a light brown shade – so when used on chocolate products, it would be understood by average consumers to describe a characteristic (ie the colour) of the chocolate.

Such a conclusion may have been a big leap were it not for the various other internet sources to which the Hearing Officer referred (in addition to the internet sources referred to by the Examiner). These sources included third-party uses of the word

"blond" descriptively for chocolate and recipes that referred to "blond chocolate" and "blond brownies" – one of them dated before the filing date of Sonafi's application. Accordingly, she maintained the refusal under Section 3(1)(c) grounds.

Further, the Hearing Officer maintained the Section 3(1)(b) objection on the basis that if a mark is entirely descriptive of the characteristics of goods or services then it will also lack any distinctive character.

## Conclusion

In this case, the Applicant's own use of the sign may have undermined its application. However, it was always likely to have been a difficult case because of the descriptive uses of "blond" found by the Hearing Officer. By the time the application was filed, the fate of the appropriate registered protection for BLOND was more or less "solidified". Indeed, the case reminds us of the importance of filing for a registration before momentum grows in a brand that has the potential to be descriptive. For this particular Applicant, though, that bitter aftertaste unfortunately lingers a little longer.

*If a mark is entirely descriptive of the characteristics of goods it will also lack any distinctive character*



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Yana handles various trade mark, design, copyright and domain name matters for clients across a range of sectors.

# Court answers Simply

The public was unlikely to get mixed messages, says Emma Reeve

**T**he Applicant, Tesco Stores Limited, filed the trade mark under Application No. 2653270 for SIMPLY (word) in classes 32 and 33 on 7 June 2013. The Opponent, International Supermarket Stores, filed an opposition against the application under Section 5(2)(a) of the Trade Marks Act 1994.

The opposition was based on the Opponent's earlier Community Trade Mark No. 5410998 for SIMPLY (word) registered on 24 April 2008. The Opponent relied on these services in class 35 at opposition, "retail services in relation to food products, household or kitchen goods".

The Opposition focused on two issues: (i) the proof of use provisions of the Opponent; and (ii) Section 5(2)(a) of the Act.

## Proof of use

The Hearing Officer held that there is insufficient use that can be relied upon to show the word "simply" being presented to the relevant public so as to meet the test for genuine use. The Opponent's evidence showed use in the form (logo) shown on this page.

The Applicant argued that the distinctiveness of the registered word mark SIMPLY was very limited, but obviously resides in the word only. As a result, it was submitted that the stylisation significantly added to the mark's distinctive character.

The evidence also presented the SIMPLY logo with the word "MARKET" included in the tail of the letter "Y".

The Hearing Officer concluded that the same applies to the use of the phrase SIMPLY MARKET. The Hearing

Officer came to the conclusion that the combination of the words "simply market" may be seen as a phrase, as opposed to the brand "Simply" and a description of the relevant services, so this may also alter the distinctive character from SIMPLY alone.

## Section 5(2)(a)

The Opponent and the Applicant argued over whether the term "food" included drink or whether the terms were different. This was important because if "food" encompassed drink, the goods being retailed by the Applicant are identical to the actual goods of the Opponent. The Hearing Officer concluded that the nature and method of use differ and are not in competition; therefore the similarity between the goods in classes 32 and 33 and the above services is low.

Regarding likelihood of confusion, the Hearing Officer considered that the average consumer would not be surprised to find two different undertakings using "SIMPLY" to send a clear and obvious suggestive message. In summary, the identity in the marks would be attributed to

### The SIMPLY logo



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*The Hearing Officer concluded that the nature and method of use differ and are not in competition*

coincidence, rather than an indication of an economic connection.

## Conclusion

Regarding the proof-of-use provisions at opposition, the case highlights that trade mark holders do need to put their trade marks, as registered, to use, and keep a record of this use.

Finally, holders should strongly consider registering trade marks of low distinctive character. This case shows that it is difficult to enforce trade mark rights where the average consumer is not likely to be confused by various undertakings using a mark to send a message.

# Cola clash

The Court departed from the established script in finding for Coke, explains Azhar Sadique

**O**n 10 May 2010, Modern Industrial & Trading Investment Co. Ltd (Mitico) filed a Community Trade Mark (CTM) application for the food and drink classes 29, 30 and 32, which included “cola flavoured aerated waters”.

On 14 October 2010, Coca-Cola Company (Coca-Cola) filed an opposition against the application based on four of its earlier figurative CTMs (shown opposite). The Opposition was also based on the earlier UK figurative mark, covering goods in class 32, namely “aerated waters”. The grounds relied on in support of the opposition were Article 8(1)(b) and Article 8(5) of Council Regulation (EC) No 207/2009 (CTMR).

In summary, Coca-Cola submitted:

- that the signs were sufficiently similar to create a likelihood of confusion;
- that the similarity of signs should be perceived in respect of the distinctive way in which the words are depicted in “Spencerian script”;
- that Mitico was marketing soft drinks in such a way that the overall impression created was similar to a typical Coca-Cola product (evidence shown opposite).

The Opposition Division rejected the opposition in its entirety and the decision was upheld by the Second Board of Appeal.

In its decision on Article 8(1)(b), the Board of Appeal felt that the signs at issue were not at all similar on the

basis that the word elements of those signs (“Coca-Cola” and “Master” respectively), which were more distinctive than their figurative elements, had practically nothing in common apart from a “tail” on the letters “c” and “m”. It further held that while Coca-Cola was the proprietor of a range of well-known trade marks commonly depicted in Spencerian script, it was not the proprietor of the script itself. Lastly, it dismissed Coca-Cola’s assertions that Mitico was supplying products bearing labels mimicking those found on Coca-Cola products.

OHIM did not examine the second basis for opposition, involving dilution of Coca-Cola’s reputed trade

marks, holding that similarity is a precondition in the application of Article 8(5).

In its submission to the General Court (GC), Coca-Cola raised a single plea in law, alleging infringement of Article 8(5), and that OHIM had:

- conflated the assessment of the similarity of the marks at issue under Article 8(1)(b) with the assessment under 8(5);
- had erred in concluding that there was no similarity between the signs as a whole, despite acknowledging a certain degree of similarity between the letters “c” and “m” and the Spencerian script;
- disregarded relevant evidence relating to the commercial use of the mark by Mitico, which demonstrated the intention of an unfair advantage being taken.

The first submission was rejected by the GC, which stated that “whilst it is true that the degree of similarity between the signs at issue is among the factors relevant to the overall assessment under Article 8(5) as to whether a link exists between those signs, the fact remains that the existence of a similarity between those signs, of whatever strength, is a precondition for the application of that provision”.

### Difference of opinion

In relation to the next submission, the GC took a different view to the Board of Appeal in its assessment of similarity. It agreed that where a mark is composed of verbal and figurative elements, the former should be considered more distinctive than the latter, subject to exceptions depending on the circumstances. The GC stated that food products were typically sold in supermarkets where consumers select products directly rather than asking for them. Selection would often occur without there being a full assessment of all of the information on the various products and consumers would be guided by the “overall visual impression” of the packaging. Accordingly, the figurative elements and the visual impression of the products assume more of a significant role when the similarity of the marks is assessed.

The GC held that the Board of Appeal had failed to identify an element of visual similarity between the signs by incorrectly isolating the Spencerian script from the words “Coca-Cola” and “Master”, and had not considered the way in which the words are depicted as a whole.

The GC also accepted Coca-Cola’s submission in respect of the typeface of the marks. The GC held that while an attempt to monopolise a particular font conflicts with the strict conditions of Article 8(1)(b) and Article 8(5), the shared typeface would be relevant for the purposes of assessing the visual similarity of the marks. The GC did not believe that Coca-Cola was attempting to obtain a monopoly in the Spencerian script (which it considered not to be commonly used in contemporary business) but considered the script to be a shared element of similarity between the signs in addition to the “tail” and the letters “c” and “m”, which rendered the marks sufficiently visually similar overall, despite both the aural and conceptual differences.

Coca-Cola’s final submission in respect of OHIM disregarding relevant evidence was also upheld.

The GC held that the Board of Appeal’s refusal to take into consideration Coca-Cola’s evidence departed from the case law on this area (T-47/06 Nasdaq), which states that “a claim of free riding under Article 8(5) of the regulation may be based on logical deduction and consideration of the usual practices in the relevant commercial sector”. This analysis should be based on all the circumstances of the case, including similar packaging.

The GC held that the evidence submitted by Coca-Cola relating to the commercial use of the mark by Mitico was relevant evidence for the purposes of establishing a risk of free riding.

### Concluding thoughts

The findings of the GC highlight the important issue of assessing the similarity of marks as a whole, taking into account all shared elements, irrespective of whether those elements are present in the public domain. The case also provides a useful guidance point in establishing the risk of free riding or tarnishment by including relevant and researched references to usual practices in a particular commercial sector.

#### The Mitico mark and marketing examples



#### The Coca-Cola UK TM



#### The Coca-Cola CTMs



Trade Mark  
No 8 792 475

Trade Mark  
No 3 021 086

Trade Mark  
No 2 117 828

Trade Mark  
No 2 107 118



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# Bosch bests ‘perfect’ opponent

Once again, similarity is the crux of the argument, reports Stephanie Taylor

**A**rçelik A.Ş. (Arçelik) applied to register the trade mark AQUAPERFECT in respect of a range of goods in class 7 in February 2009, predominantly kitchen apparatus. The application was published for opposition purposes in November 2011. In February 2012, BSH Bosch und Siemens Hausgeräte GmbH (BSH) opposed the application on the basis of its earlier Community Trade Mark registration for WATERPERFECT, which also covered a range of goods in class 7, particularly household and kitchen machines and apparatus. The opposition was successful and in February 2013, Arçelik appealed.

The OHIM Fourth Board of Appeal upheld the appeal in December 2013 on the basis that even though the goods covered by the Arçelik application were identical and similar to those covered by the BSH registration, there was no likelihood of confusion between the Arçelik mark and the BSH registration.

## Marks and signs

BSH then appealed to the Court of First Instance on the basis that there was a likelihood of confusion between the marks AQUAPERFECT and WATERPERFECT and, therefore, this infringing Article 8(1)(b) of Council Regulation (EC) No 207/2009 (CTMR).

BSH argued that the relevant consumer would pay a higher-than-

average level of attention in view of the nature of the goods concerned, which was not disputed by Arçelik. The Court held this was true in respect of some of the goods but, as others were daily consumer goods, the relevant consumer could also be the average consumer.

The Court did not examine the similarity of the goods concerned on the basis that the Board of Appeal had found the goods to be identical and similar, and that this had not been disputed by the parties.

The Court considered that the signs differed on a visual basis due to the different prefixes “WATER” and “AQUA”, noting that consumers generally pay the greatest attention to the start of marks (*L’Oréal v OHIM – Spa Monopole (SPA THERAPY)*, T-109/07). However, the Court noted that the marks are similar in length and both contain the identical suffix PERFECT. As such, the Court held that the marks are visually similar to an average degree. Turning to the phonetic assessment, the signs differ in their first two syllables but share the remaining two. On this basis, the

Court held that the marks are phonetically similar to an average degree. When assessing conceptual similarity, the Court considered that Portuguese, Spanish and Italian consumers would understand the term “AQUA” means “water” as the word is similar in these languages and, furthermore, would be recognised as the Latin for “water”.

The Court, therefore, held that a large part of the relevant public would understand the message conveyed by both marks as being that of “water” and “quality”. The Court noted that previous case law has held that “a linguistic difference between signs is not automatically sufficient to exclude the existence of conceptual similarity from the point of view of relevant consumers”, but also that it may prevent an immediate conceptual comparison (*Oetker Nahrungsmittel v OHIM – Bonfait (BUONFATTI)*, T-471/09). As such, the Court held that the marks were conceptually similar and, on the whole, similar to an average degree.

## Court conclusion

The Court overturned the OHIM Board of Appeal decision and found that a likelihood of confusion was established on the basis of the identity and similarity of the goods, coupled with the similarity of the signs, and that this finding was not altered by the weak distinctive character of the BSH registration.



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Stephanie advises clients on a range of trade mark issues in a variety of industry sectors.



# BlackRock phrase blocked

Slogans remain a difficult sell when it comes to registration, says Roberto Pescador

Ever since the Court of Justice of the European Union's decision in Audi v OHIM, C-398/08 P (Audi), concerning the slogan Vorsprung durch Technik, the case has taken centre stage in most OHIM decisions relating to the registrability of slogan marks. While Audi confirmed that slogans were not required to display "imaginativeness" or "conceptual tension", and it would be sufficient for them to have some level of originality or resonance, in subsequent cases the OHIM Boards of Appeal and the General Court have tended to determine the effects of the case strictly.

In this case, BlackRock, Inc. applied for registration of the slogan INVESTING FOR A NEW WORLD as a Community Trade Mark (CTM) in relation to a range of financial services in classes 35 and 36. OHIM refused the application on the grounds of lack of distinctiveness pursuant to Article 7(1)(b) of Council Regulation (EC) No 207/2009 (CTMR). The Board of Appeal (BoA) upheld the examiner's decision and BlackRock appealed to the General Court.

## Appeal pleas

BlackRock's appeal contained two main pleas:

- First, that the BoA had erred in finding that the mark had no distinctive character. BlackRock argued that the mark was endowed with a certain resonance given that it had multiple meanings (one of the factors discussed in Audi) and would not be perceived as a banal slogan.
- Second, that the BoA had misinterpreted Audi in distinguishing

*The mark was not sufficiently original or resonant to require at least some interpretation by the relevant public*

the slogan in that case on the basis of evidence of long-standing use.

## General Court's decision

The General Court dismissed the appeal. First, the Court confirmed that while having potential multiple meanings was a characteristic that was likely to endow a sign with distinctive character it was not the decisive factor. Further, all of the possible meanings of the Applicant's mark still denoted positive connotations in relation to the services at issue. Therefore, the mark was not sufficiently original or resonant to require at least some

interpretation by the relevant public (the Court noting that, although the relevant public were specialist consumers, their level of attention would be relatively low in respect of promotional indications).

Second, BlackRock argued that the BoA had incorrectly described the assessment of the mark in Audi as having been based on acquired distinctiveness through use, rather than inherent distinctiveness. Accordingly, the BoA was wrong to distinguish the slogan in Audi on the basis that it had been used for many years before for the application. The Court rejected BlackRock's argument and clarified that the BoA had simply stated that Audi's long-standing use of the slogan, among other factors, added resonance to it.

## Conclusion

This case, together with other recent General Court decisions upholding refusal of marks such as SMARTER SCHEDULING (T-499/13) in relation to business management systems and SO WHAT DO I DO WITH MY MONEY (T-609/13) in relation to financial services, is a reminder that unless slogans contain some originality or resonance that makes them easy for the relevant public to remember, they remain difficult to register.



## Roberto Pescador

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Roberto is a qualified Trade Mark Attorney and a Spanish-qualified lawyer and has extensive experience in trade marks.

# Now hear this

Harry Rowe recounts the reasons for the failure of this multi-pronged appeal

In 2004, Starbucks (HK) Ltd (no relation to the coffee chain) applied to register the mark “now and device” as a Community Trade Mark in classes 35, 41 and 42. Now Wireless Ltd applied to revoke the registration in 2010 on non-use grounds. The registration was revoked in respect of classes 35 and 41 but, following limitation of the class 42 services, the Cancellation Division upheld the registration for the class 42 services. The Second Board of Appeal of OHIM later dismissed Now Wireless’s appeal against that decision. Now Wireless then appealed to the General Court.

## Appeal arguments

Now Wireless’s arguments consisted of four parts, the first of which was that Starbucks had not demonstrated use of the mark. Starbucks had submitted extensive evidence in the course of the OHIM proceedings, including images of modems carrying the mark, extracts from databases detailing engineer visits to customers, and a national radio advertisement. It also provided evidence of use relating to supply of access to electronic networks from UK Broadband Ltd, an economically linked company. The Court found the evidence did demonstrate use of the mark, at least in part of the EU.

Now Wireless next claimed that the Board of Appeal had incorrectly assessed the use in relation to the services, as they had not been subdivided precisely or narrowly. The Court agreed with the Board of Appeal that no significant subdivisions were reasonable within

the category concerned because the services provided – first, installation of modems, broadband cards and associated software, and, second, call-out services to resolve issues with those modems and that software – all met the same need. The end-user of each of those services wishes to access the electronic networks and relies on all of those services for that purpose.

Third, Now Wireless claimed the Board of Appeal had wrongly presumed consent in respect of use of the mark for all of the services concerned, despite express consent in the contract between Starbucks and UK Broadband that limited use to wireless broadband services. The Court confirmed that the use of the mark was not limited by the licensing agreement to wireless broadband services, as the agreement stated that UK Broadband could use the mark “in rendition of all appropriate services and activities associated with the operation of the Business”. Consent of the proprietor is deemed to constitute use by the proprietor.

Fourth, and finally, Now Wireless claimed the Board of Appeal had incorrectly assessed the extent of genuine use. The Court found the Board of Appeal was right to find that use of the mark in London, the largest urban area in the EU, and the Thames Valley, was genuine use.

*Starbucks had submitted extensive evidence in the proceedings, including images of modems and a national radio advertisement*

Paying particular attention to press clippings and national radio broadcast evidence, the Board of Appeal’s conclusion that the extent of use was fairly significant was correct.

## Case conclusion

The Court rejected all four parts of the single plea in a decision that emphasises the importance of documented evidence of use and also highlights that, in some circumstances, use in even part of one EU Member State may be sufficient to constitute a defence of a Community Trade Mark registration against an application for revocation on the basis of non-use.



**Harry Rowe**

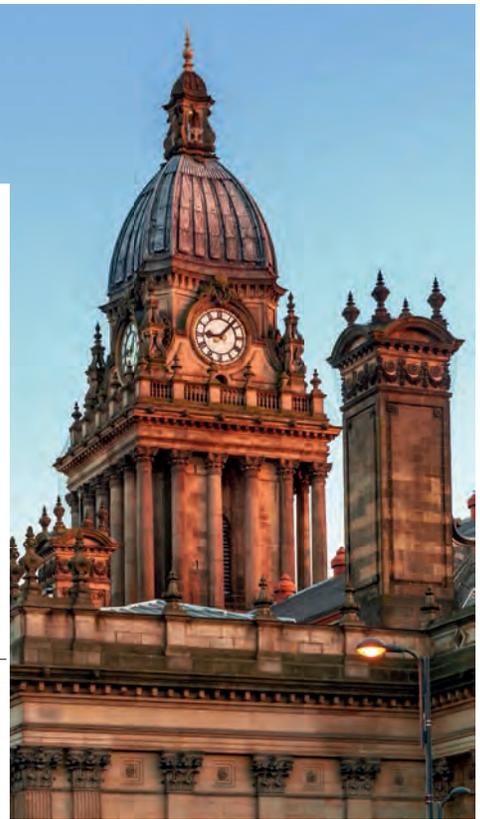
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The city of Leeds will host our June event looking at colour

# events

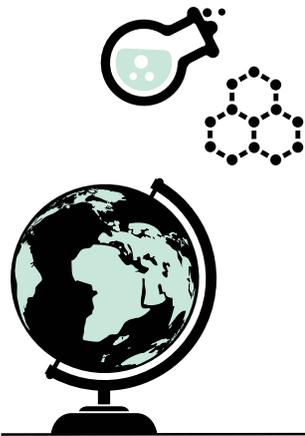
More details can be found at [itma.org.uk](http://itma.org.uk)

Date	Event	Location	CPD hours
28 April	<b>ITMA London Evening Meeting*</b> Designs and the role of dotted lines, Adrian Froment, Serle Court	Royal College of Surgeons, London	1
29 April	<b>ITMA Talk in Glasgow</b> Competition law issues for trade mark practitioners, Catriona Munro and Jennifer Marshall, Maclay Murray & Spens LLP	Maclay Murray & Spens LLP, Glasgow	1
19 May	<b>ITMA London Evening Meeting*</b> Colour Issues, Simon Malynicz, Three New Square	Royal College of Surgeons, London	1
17 June	<b>ITMA &amp; CIPA Talk in Leeds</b> Colour Issues, Simon Malynicz, Three New Square	Bond Dickinson, Leeds	1
23 June	<b>ITMA London Evening Meeting*</b> IP Valuation, Jan Lindemann	Royal College of Surgeons, London	1
8 July	<b>ITMA Summer Reception</b>	The Little Ship Club, London	
21 July	<b>ITMA London Evening Meeting*</b>	Royal College of Surgeons, London	1
17 September	<b>ITMA Afternoon Seminar</b> Representing before the Registry	Royal College of Surgeons, London	2-3
22 September	<b>ITMA London Evening Meeting*</b>	Royal College of Surgeons, London	1
23 September	<b>ITMA Autumn Seminar</b>	Hyatt Regency, Birmingham	5
23 September	<b>ITMA Autumn Drinks Reception</b> part of the ITMA Autumn Seminar	Hyatt Regency, Birmingham	
20 October	<b>ITMA London Evening Meeting*</b>	Royal College of Surgeons, London	1



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**I worked as...** a Trade Mark Attorney and a partner in Marks & Clerk Patent & Trade Mark Attorneys LLP before retiring in 2012. I also qualified and practised as a Patent Attorney.

**Before this role...** I was, variously, a Partner in Edward Evans & Co., in Marks & Clerk Hong Kong, in Stanley, Popplewell, Poole and in Stanley, Popplewell, Francis & Ross.

**My current state of mind is...** generally, one of contentment. I am enjoying my retirement, which has included foreign travel, improving my Photoshop skills and learning more about the UK's Roman roads.

**I became interested in IP when...** having left Liverpool University with a chemistry degree and taking up an industrial research chemist position, I soon realised that the chemicals I was working with could kill me. I accepted a job in an industrial patent department, which turned out to require a happy combination of science skills and a facility with the English language and I was entirely in my element.

**I am most inspired by...** travel. In particular to places not overwhelmed by tourism or by first-world values.

**In my role, I most enjoyed...** the advocacy aspects of the work – hearings at the Registry and disputes with third parties.

**In my role, I most disliked...** chasing clients to pay their bills.



“Good Grief”, and other remarks from retired member Mike Lynd

**In front of me now...** is a five-foot-high teak panel of a Cambodian apsara.

**My favourite mug...** says “Good Grief”. I have been a fan of *Snoopy* since childhood.

**My favourite place to visit on business was...** Chiang Mai in Thailand, where the Asian Patent Attorneys Association (APAA) held one of its annual conferences.

**If I were a mark, I would be...** the BASS red triangle, which represents tradition and quality, and has a dash

of culture since it appears in Manet’s *A Bar at the Folies-Bergère*.

**The biggest challenge for IP is...** the protection afforded to copyright. When the most vital invention gets patent protection for just 25 years, I see no justification for giving every doodle protection for 70 years from the author’s death, regardless of merit.

**The talent I wish I had is...** the ability to play boogie piano.

**I can’t live without...** my wife and family; Stilton; my bright red Morgan, and Ceol Ila malt whisky.

**My ideal day would include...** sunshine, a country drive and a pub lunch by a river.

**In my pocket is...** my Freedom Pass.

**The best piece of advice I’ve been given is...** be a professional – someone who is prepared to give advice against his/her own interest.

**When I want to relax I...** read, plan the next holiday or attend lectures.

**In the next five years, I hope to...** see the birth of my first grandchild.

**The best thing about being an ITMA member is...** the continuing contact it gives me with the profession. It helps me pretend that I am still a real TMA instead of an OAP.

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