

INTERVIEW: PIPCU'S
DI MICK DODGE
HELENE WHELBOURN p6

CONCERNS OVER
LECTURE CAPTURE
IMOGEN FRANCIS p12

TO #TRADEMARK
OR NOT?
CARLTON DANIEL p18

UPPING
THE ANDES
IAN WALL p26

ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

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NOMINET TIPS
AND TRAPS p21
ONEL'S IMPACT p24
A SINGAPORE
STORY p29



EUROPE'S TRADE MARK TRANSFORMATION

PATRICIA COLLIS REVEALS THE CHANGES COMING
TO EU TRADE MARK LAW IN 2016 p14

The wording of Article 8(5) is set to be amended to reflect the decision in the Davidoff case that opposition can be based on a reputation claim, irrespective of whether the goods and

The bigger change in terms of fees is the significant reduction in renewal fees. While the existence of the OHIM surplus meant there was pressure to reduce these fees, account had to be taken of the need to ensure national trade mark systems were not undercut or undermined in deciding on the new levels. The new renewal fees will mirror the application fees (ie €850 for a single class, €900 for two classes and €150 for each additional class). This means a saving of €500 for renewals in one class, and of €250 per class for each class above three, resulting in substantial savings for those with

When the changes come

EUTM

services covered by the opposed application are similar or dissimilar to the goods or services for which reputation is claimed. Where EUTM opposition proceedings are based on earlier EUTMs, the proof of use date is set to change from the date of publication of the opposed application to the date of filing

coverage in several classes and for those with large EUTM portfolios. Application formalities Those wishing to claim priority will have to do so at the time of filing an EUTM application, and will no longer have a further two months from filing within which to do so. Any documents required to support a priority claim will have

into effect, the Community Trade Mark (CTM) will be renamed the European Union Trade Mark (EUTM), and OHIM will become the European Union Intellectual Property Office (EUIPO) The bigger change in terms of fees is the significant reduction in



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Greetings. The CTM is soon to shuffle off this mortal coil and emerge, phoenix-like, as the EUTM. OHIM will also be transformed into the European Union Intellectual Property Office. These are, of course, only the superficial changes in the first real overhaul of the immensely successful system.

In this issue we take a look at the substantive changes in more depth. We also have features on the British Virgin Islands, Singapore and the Andean Community. Closer to home, we rightly recognise those who have

recently passed the Trade Mark Administrators' Course on our ITMA Insider pages. And as the strains of Bing Crosby and David Bowie become ever more imminent, I look forward to seeing many of you at the London Hilton on Park Lane, this year's venue for our London Christmas lunch.

Chris McLeod
ITMA President

Inside this issue

Regulars

04 ITMA Insider Trade Mark Administrators' Course graduates take centre stage

41 Events Diary dates for ITMA members

42 The TM20 Charlotte Blakey reveals her inspiration for working in IP

Features

06 Interview Helene Whelbourn meets PIPCU's deputy head, DI Mick Dodge

11 Threats Sara Ludlam explains why she is pleased with promised changes to legislation

12 Copyright Imogen Francis calls attention to an increasingly urgent issue for the higher education sector

14 EU legislation The coming changes that will transform EU trade mark law are outlined by Patricia Collis

18 Online strategy Carlton Daniel takes on a very modern trade mark quandary

21 Nominet Following her ITMA talk, Dr Patricia Jones explains the tips and traps of making or defending a Nominet complaint

22 British Virgin Islands Katherine Van Deusen Hely hails the modernisation of a Caribbean territory's trade mark laws

24 CTMs Birgit Clark considers the impact of contrasting ONEL interpretations

26 Andean Community Ian Wall introduces a regional initiative that has seen IP expertise flourish

29 Singapore The Court's approach to a Polo case was novel to Prithipal Singh

Case comments

30 [2015] EWHC 1772 (IPEC) Magdalena Borucka covers a case that emphasises the unitary character of a CTM

32 [2015] EWHC 1840 (Ch) Amélie Gérard explains why survey evidence was not deemed useful

33 O/287/15 A famed work fell on the wrong side of standard tests, says Katherine Thompson

34 O/307/15 Nicole Giblin explains why Dreams failed to prevent a competitor registration

35 T-396/14, T-395/14 Luxembourg's General Court decides in favour of Lego, reports Rebecca Costen

36 T-621/14 Inclusion of a registered mark may be deemed confusing, warns Amy Galloway

37 T-398/13 Commercial success wasn't necessary for an MB win, says Tom Nener

38 DRS update A spirited fight leads off Susan Payne's round-up of recent online lessons

ITMA Insider

AP selection complete

Four people have been announced by The Lord Chancellor as Appointed Persons to hear trade mark and design appeals.

Philip Michael Johnson and Edward James Wilson Mellor QC will cover both trade marks and designs, while Martin Russell Thomson Howe QC will cover only designs and Tom George Moseley Mitcheson QC only trade marks.

An Appointed Person is a senior lawyer who is an expert in IP law, and who hears *ex parte* (one side) and *inter partes* (more than one side) appeals from decisions by trade mark hearing officers and by the Intellectual Property Office on registered and unregistered designs, including those resulting from the IPO's design opinions service when launched in October.

Appointed Persons share the jurisdiction for appeals with the High Court in England and Wales, the Court of Session in Scotland and the High Court in Northern Ireland. Although the Scotland Act enables Appointed Persons to be devolved to Scotland.

These appointments are in addition to those people already serving as Appointed Persons.

Member moves



Mark Hiddleston is pleased to announce that he launched a new firm under the name **Hiddleston Trade Marks** on 1 September 2015. You can contact him at mark.hiddleston@hiddleston.com or visit the website at hiddlestons.com.



Stobbs IP is delighted to announce the appointment of **Carrie Bradley** as a Senior Trade Mark Attorney. Bringing a wealth of experience, Carrie will play an integral role in the firm's long-term growth strategy. Carrie may be contacted by email at carrie.bradley@stobbsip.com or on 01223 435240.

New TPN explains cost cap

The IPO has published a Tribunal Practice Notice (TPN), which introduces a cost cap for fast track opposition proceedings. This practice change applies to fast track oppositions filed on and after 1 October 2015.

As a result of the new cap, **the costs awarded in fast track opposition proceedings will not exceed £500**, excluding official fees. According to the TPN, this will comprise:



The TPN also notes that, “as with any cap, this does not mean that costs will automatically be awarded at this level. Most awards will be less.”

FAST TRACK FACTS

232 fast track oppositions were filed up until the end of April 2015

15% of fast track oppositions are filed by litigants in person. A litigant in person is the respondent in around **40%** of such cases.

60% of fast track opposition cases result in the **withdrawal of a trade mark application**

£460 is the average costs award

£1,235 is the average costs award in standard opposition proceedings

ADMINISTRATORS CELEBRATE COURSE COMPLETION

The new cohort of ITMA-qualified trade mark administrators has graduated at a special ceremony held in London's Canary Wharf. The 75 people who successfully completed the course received their certificates from ITMA Chief Executive Keven Bader at the Thomson Reuters Building.

ITMA's Trade Mark Administrators' Course is the official qualification for trade mark administrators and those supporting trade mark attorneys. It tests knowledge of trade mark and design formalities and official procedures to equip candidates with a full understanding of practices within the profession.

ITMA President Chris McLeod commented: "Congratulations to everyone who passed. Completing the course is an important part of the role of trade mark administrators – it's great to see so many gain the qualification yet again this year."

Bader added: "The ITMA Trade Mark Administrators' Course recognises the achievement and importance of the work trade mark administrators undertake. The course continues to be popular and it gives those who pass the chance to become an Administrator Member of ITMA. Well done to all who passed."

Applications to take part in the 2016 course will open soon. It runs from January to May and consists

of two lectures lasting two hours roughly every other week. The exam then takes place in June. For more information, visit itma.org.uk.

The 75 successful students:

Kimberley	Axford
Emma Louise	Barron
John	Beltrami
Hayley	Best
Ivar	Blankevoort
Barbara	Blunt
Sophie	Boyd
Georgia	Brigden
Andreea	Carlan
Scott	Cockayne
Sarah	Coomber
Hayley Jayne	Davies
Tom	Deeks
Claire	Drewery
Aleksander	Dziamecki
Lauren	Easter
Susan	Forrest
Rosalyn	Fowler
Kerry	Gallimore
Lee-Ann	Galway
Kalifa	Garba
Oliver Robert	Gray
Limei	Guo
Charlotte	Herrmann
Deborah Anne	Hughes
Kirstie	Hunter
Siobhan	Inglis
Maria Izabela	Jedrych
Steve	Jeffs
Kaori	Kurokawa
Peter	Lambert

Anna	Lechtanska
Christopher	Lever
Keir	Lynn
Elaine R	Mackie
Sean	Markham
Karen Elizabeth	Marks
Pete	McFarlane
Erin	Meakin
Lorraine	Miller
Victoria	Morrison
Jeanette	Munro
Jack	Newton
Oliver	Oguz
Jurgita	Oleskeviciute
Lindie	O'Neil
Tom	Paris
Alexandra	Peters
Liam	Peters
Janine	Phillips
Jan	Powell
Lindsay	Powton
Alice	Reschwamm
Kane	Ridley
Emma Jane	Rumens
Sharon	Sequeira
Gillian	Shaw
Michael	Smith
Sarah	Smith
Tracey	Spruce
Frederick	Steele
Trecina	Surti
Hannah	Swallow
Georgina	Taylor
Hannah	Turner
Ilse	Van Haaren
Robbert	Van Weele
Tiffany	Vine
Abraham	Vivas
Sara	Wallis
Joanna	Wojcik
Laura Jayne	Wright
Sonya Theresa	Wyeth
Helene	Yeo
Antony	Yerasimou



Liam Peters, Formalities Paralegal at Wynne-Jones IP, earned the highest score on the 2015 exam





SUCCESS IN THE CITY

From its base in the City of London, the Police Intellectual Property Crime Unit has scored significant wins since its launch in 2013. Helene Whelbourn speaks to its deputy head, DI Mick Dodge, who is now putting a particular focus on frustrating online infringers

What positions have you held before this role, and how have they prepared you for this challenge?

I have worked in the City of London Police for 14 years, and since about 2004 in economic crime – specifically in relation to cheque and payment card fraud at the Dedicated Cheque and Plastic Crime Unit. This is another funded unit that the City police operates in conjunction with the Metropolitan Police. There, I was very much focused on the investigation of



DI MICK DODGE

joined PIPCU in April 2015. During a posting to the Dedicated Cheque and Plastic Crime Unit, he gained plenty of experience working with the private sector, trade bodies and law enforcement partners, leading a number of investigations focused on disrupting organised crime groups impacting upon the UK economy.

seriously organised crime groups operating throughout the UK.

Just before I joined the Police Intellectual Property Crime Unit (PIPCU) I worked for a little under two years as the staff officer to our assistant commissioner, supporting him in his role as a leader of the City of London police, and also with his national policing responsibilities.

So I have got a pretty varied background that is strongly operationally focused. And certainly my posting as a staff officer gave me a strategic perspective that really helps me at PIPCU. It allows me not only to deal with the operational side of my business, but also stakeholder-engagement, management and governance. With the broad range of stakeholders that there are within the UK intellectual property landscape, it's helpful to understand how to develop strategies to engage with them.

With just a few months in the role, what has been the biggest "learning curve" for you so far?

The first challenge has been getting to understand the business and the landscape, particularly in relation to the online disruption work we do. This is predominantly focused on digitally pirated content, but also the online sale of counterfeit goods. It is a relatively new area for policing, so it's important that I really understand the processes and everything that sits behind the activity, so that I can then identify how we can be better at fighting it. Conversely, on the investigation side, it's really about understanding the wide variety of stakeholders

we have and their differing needs. I need to take time to understand the particular issues for each sector, and what follows on from that is to consider how we can alter our approach or take a different one to address those particular issues.

What are the primary objectives and challenges for PIPCU right now? And going forward with funding secured until 2017?

In the here and now, we are very much focusing on whether we are being as efficient and effective as we possibly can be. Going forward, there is a lot of work that we would like to do, and are doing, internationally to make sure our reach and our capability can cross borders – to match the reach and capability of the criminals that we investigate.

We are also looking to develop and enhance our disruption capabilities, particularly around online distribution and counterfeit goods, and the online distribution of digital pirated materials such as films, books, music and games. We are looking to see how we can improve those processes through better engagement with all the people who are involved in the internet – the registries, registrars, and at every step along the way, so that we can be very certain that we are applying our skill set to the area that is going to achieve the greatest benefit and ultimately to solve the problems that rights-holders have. That's what we want to do – whether it's through doing some sort of disruption activity or through traditional investigation and



enforcement. We completely get that we cannot solve everyone's problems. But we want to try and solve as many as we can. And if we can't say "We can help you solve that problem," I want to be able to say, "We can't do that, but let's see if we can do something that will bring some value to you." We may not stop the problem, but we can at least try and slow it down.

How do you decide on priorities? What partners do you work with to determine these?

PIPCU's priorities and objectives are very much set by the Intellectual Property Office (IPO) and the various stakeholders that we engage with and that's absolutely right. The IPO is the UK's lead agency for IP and it has got an intelligence hub, so although we remain operationally independent, we take direction and advice from it and others in the industry so we can make sure that we focus our work on areas where there is the greatest harm being done. Specifically, we have a steering group that controls the strategic direction of the Unit on which the DCI sits on behalf of the team.

At the moment we are very much looking towards online connections to the investigations we take on and the activities we do. Frankly, that is the growth area for IP crime.

Do you work closely with other international agencies? How does this help you to better protect UK IP?

We work very closely with US Homeland Security and we signed up back in March of this year to a Memorandum of Understanding for how we would work more closely together. We work with OLAF, which is the European Anti-Fraud Office, and we work with Europol. As a result of a recent media campaign we have had contact with overseas law enforcement agencies that are interested in working with us. At PIPCU we are always looking to make new relationships, to form new partnerships, and to develop existing ones because, as we've often said, internet crime is borderless and you simply cannot have an effective policing response if you are inhibited by borders.

Are you looking at forming partnerships with agencies in the countries where goods are manufactured or made?

Oh, absolutely. And certainly that's got to be the ambition - to stop something at source and solve the problem rather than try to disrupt it in every other jurisdiction along the way. We've got to recognise that that's not a quick process, and you have to build understanding and trust between jurisdictions and governments. I know the IPO is putting a lot of work into making contact with jurisdictions so that we can do exactly that at a political

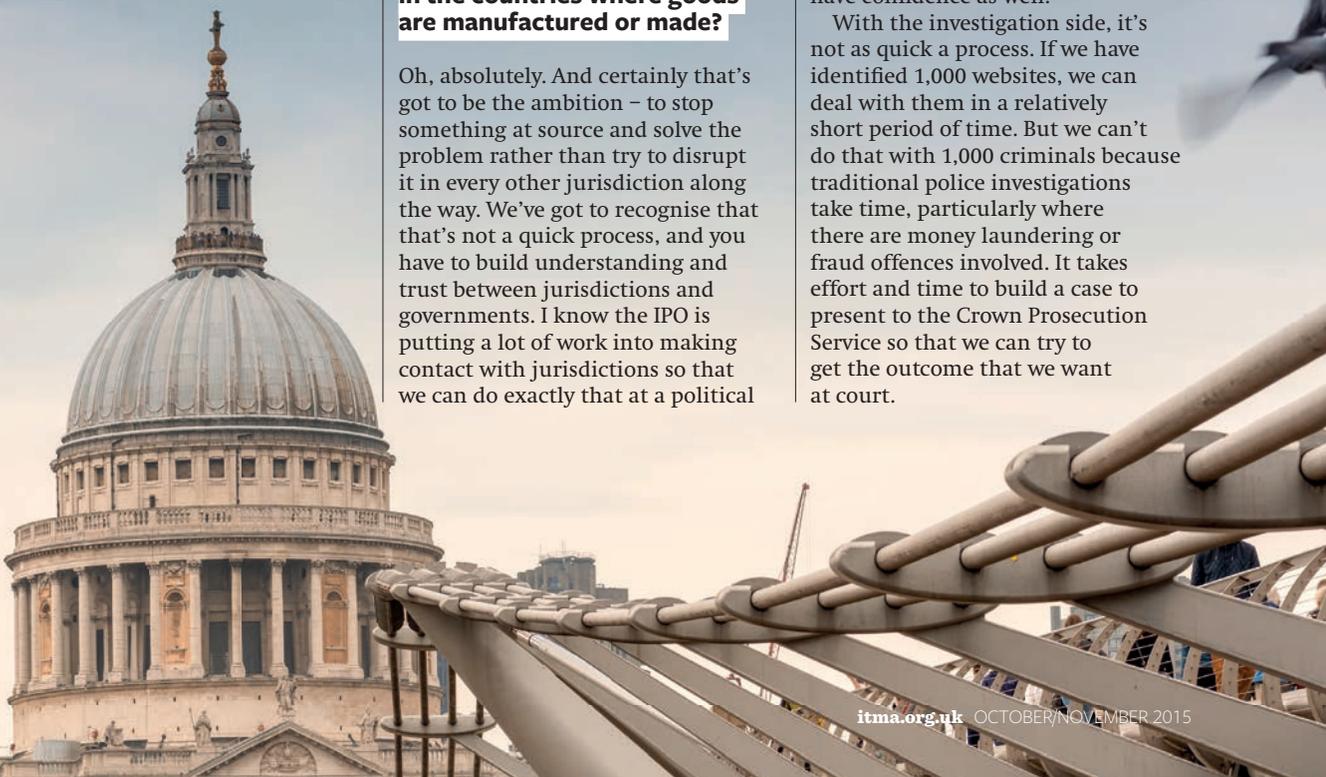
level, so the hope is that effort will filter down to a policing and law enforcement level in an operational context.

How much of your work involves physical goods/movement, and how many actions involve online threats? Is either area growing or diminishing as a problem?

It's quite difficult to split those activities, because they aren't two different areas. Within the online space there are websites selling or trying to sell counterfeit goods or distribute digitally pirated material, and a lot of work goes into identifying those websites. Rights-holders and brands do that and tell us about them, and particularly when they are in the .uk domain tree we can get those websites taken down.

Since 2013 we have taken down over 6,000 websites in the .uk space that were selling counterfeit products to UK consumers. That's a really big focus for us because we want to make the .uk domain space a place where consumers know they can shop with confidence, and in which the legitimate companies that operate in the .uk and Nominet can have confidence as well.

With the investigation side, it's not as quick a process. If we have identified 1,000 websites, we can deal with them in a relatively short period of time. But we can't do that with 1,000 criminals because traditional police investigations take time, particularly where there are money laundering or fraud offences involved. It takes effort and time to build a case to present to the Crown Prosecution Service so that we can try to get the outcome that we want at court.



Is Nominet as reticent with you as with brand owners when it comes to releasing information about the owners of domain names?

We have a good relationship with Nominet and we build on it all the time. In terms of data that Nominet holds, where an individual has opted out, say, we obviously have police powers and there is an established framework under the Data Protection Act that we can use to access that information. Privacy services are a challenge and their nature is always evolving, but so is our response.

What more could brand owners do to make life harder for those engaged in counterfeiting or piracy? Or to make your work more effective?

I think that's very much a business decision that has to be made by the individual brands. We're not here to tell people how to run their businesses; we're here to resolve the criminal activity that impacts upon those brands and rights-holders.

As far as how we can be more effective at working together, we really want brands to speak to us, and to approach us at an early stage when they first suspect criminal activity. That way we can really understand their issues and provide early guidance about whether or not it's a case that PIPCU would consider taking on.

There are many things that maybe a lawyer and a legal department for a brand would consider doing, like a cease and desist letter and so on, that may have implications for a police investigation later down the line. We very much want to be a part of that process of deciding [on strategy] with the more serious issues and certainly the ones that cross the border into criminal activity. Then we can try to maximise as much of the opportunity to disrupt criminal activity as we can.

So, we need early engagement – pick up the phone, call us, and we will be very happy to come out and speak to brands and rights-holders and tell them about PIPCU, how we work, and what we look at when cases are referred in. This will help us

to gain a common understanding and a common set of expectations.

There has got to be criminal activity involved; we are the police and we do not deal with civil law or civil infringements. So if it's a website a brand has identified that is selling counterfeit goods, and it's in .uk, we can do something about that and we want to do something about that. And, you know, maybe brand A will say "Here's a few websites" and maybe half a dozen other brands will give us other websites, but behind the scenes we can do some work that reveals that actually it's the same person [behind all these websites], so that we can then go to the source.

At the other end of the spectrum, you get things that are quite clearly criminal, and quite serious and organised, and they warrant a "traditional" police investigation where people get arrested, where we do search warrants, where people end up in court. And there is a range of options in-between, but we very much want brands to understand when the right time is to speak to PIPCU. There needs to be a dialogue and there needs to be that process of building trust and confidence so that everyone understands what we do and we understand what brands do.

To address our readership directly, is there anything Trade Mark Attorneys or the brand owners we advise can do to make your job easier?

Speak to us. If you have a case that is very concerning and you think there may be ongoing criminal activity and [to stop this quickly] you send a cease and desist letter, what you've done is let them know you are onto them. But if you think it's serious, phone us up. We are very flexible, we can be very dynamic in our response, and we understand that sometimes you have to take immediate action. But we would very much like to be part of

We really want brands to speak to us, and to approach us when they first suspect criminal activity

that [decision-making] process, so we can make sure any opportunities down the road – certainly in terms of court proceedings – are protected and managed so that we can get the best outcome. It's not to say that brands don't speak to us, but there could always be a better dialogue.

So, basically, we should include PIPCU as one of the items in our decision-making process as we determine whether or not action should be taken?

Yes, absolutely. Always have us in the back of your mind. If you think you might want to get the police involved, but are concerned you don't have enough to go on, phone us up and ask us. We will tell you what we think is the best course of action. We want to engage in a dialogue with brands so that they understand our capabilities, but also so that we understand everything that sits behind an issue in terms of the investigation to date, in terms of reputational harm and everything in between. So speak to us and consider us, and don't let it be the last consideration. That's often when things become more challenging for us to investigate. ■



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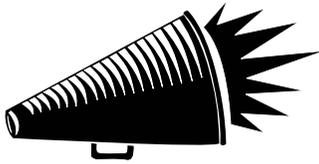
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CHEERING ON CHANGE

Sara Ludlam explains why she is pleased with the direction of promised changes to threats legislation

As an IP litigator with nearly 20 years of experience, I am eagerly looking forward to the promised change in legislation that will mean that legal advisers are no longer liable for making groundless threats.

The legislation exists to protect against abuse by rights owners, but it can be used by recipients of infringement claims to turn the tables. If you are not prepared, this can give the recipient of your threat (the alleged infringer) the upper hand, and, if they escalate the dispute, it can be difficult to obtain settlement on your client's terms.

When advising a defendant to an infringement claim, a groundless threats claim can be a useful weapon in your armoury. When representing a claimant, you want to be sure of your client's rights to avoid becoming a party to a claim for groundless threats.

It is a particularly difficult area of law for attorneys advising clients in relation to design right and patent infringement, as the validity of these rights is usually put in question when an infringement is alleged.

And, the IPEC case of *Cassie Creations Limited v Simon Blackmore and Mirrorkool Limited* [2014] EWHC 2941 (Ch) reminded us to be careful when using online dispute resolution procedures (such as those offered by Amazon and eBay) as well as when writing letters of claim in relation to trade mark, or design right or patent infringement. (See Section 21 Trade Marks Act 1994, and Community Trade Mark Regulation Reg 6(1); Section 26 of the Registered Designs Act 1949 and Regulation 2 of the Community Design Regulations 2005;

Section 253 of the Copyright, Designs and Patents Act 1988; Section 70 of the Patents Act 1977 as amended by the Patents Act 2004.)

When asserting an infringement claim, I used to draw comfort from the fact that damages had never been awarded for a groundless threats claim – but this safety net disappeared last year. In July 2014, in the case of *SDL Hair v Next Row*, the sum of £40,500 plus interest was awarded following an inquiry as to damages for a groundless threats claim. The damages inquiry followed a decision that a patent for induction heating units for hair rollers owned by Next Row Ltd and licensed by Master Distributor Ltd was not infringed and that letters sent by the Defendants' solicitors constituted groundless threats of patent infringement proceedings.

While this decision is bad news for attorneys acting for clients bringing infringement claims, there is still a problem for parties bringing claims for groundless threats. Namely, such claimants are likely to bear significant costs of the trial in which the claim for groundless threats is examined – and usually also defending the counterclaim for infringement – and the cost of the subsequent inquiry (further to being successful at trial and either a judgment that the IP right was not valid or the claimant did not infringe it). Such costs are likely to far exceed any damages awarded.

Legislation that escalates a dispute rather than encourages early settlement must be a bad idea. So roll on the proposed amendments! ■

THREATS IN BRIEF

- **A "GROUNDLESS THREAT"** is a written or verbal threat claiming that a registered trade mark, design right or patent has been infringed, where the claimed right is not valid.
- **AN ACTIONABLE THREAT** is a groundless threat made in the UK in relation to infringement of a UK or EU or International registered trade mark (or UK or EU registered design right or patent); or an application to register these rights and unregistered design rights.
- **WHO IS LIABLE FOR MAKING A THREAT?** IP owners and licensees; companies (for employees' threats); and, currently, companies' professional advisers, including solicitors and Trade Mark Attorneys.
- **WHO CAN BRING THE CLAIM?** "Any person aggrieved"; ie a manufacturer; importer/distributor; buyer or user of an article in which the trade marks (or design rights or patents) are incorporated.
- **REMEDIES** A recipient of a groundless threat of infringement is entitled, subject to some exclusions, to a declaration that the threats are unjustifiable, an injunction and damages.



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CHAPTER CONFERENCES

Imogen Francis calls attention to content capture, an increasingly urgent IP issue for the higher education sector

Following the lifting of student number controls in higher education and subsequent rise in competition for students, many universities and colleges are focusing on the quality of their teaching and learning opportunities, and the need to create a more vibrant and engaging environment. As part of this scrutiny, they have recognised that new ways of learning are key to staying relevant and competitive.

This has ramifications for that most traditional of teaching methods – the lecture. The trend to allow remote learning to engage the widest audience and provide convenience means that lectures, as well as presentations and other teaching events, are increasingly being recorded and made available online. It's a trend that should force serious consideration of IP rights and, in particular, performers' rights.

BALANCE OF RIGHTS

In higher education, the ability to attract students often follows the establishment's ability to attract and retain academic staff with the highest reputation. IP rights arising from the creative output of such individuals are often seen as their rightful property, and so universities and colleges can struggle to find the balance between controlling the rights in such creative

output and recognising the need to share the fruits and benefits with the employed academic.

In addition, entrepreneurial students may be swayed by an establishment's take on ownership of student-created intellectual property and move away from those that take extensive ownership.

In light of the March 2015 Competition and Markets Authority's guidance on students as consumers, and last April's headline-grabbing *Times Higher Education* story on student IP policies, it is clear that blanket assignments of all student IP and unclear, archaic ownership provisions are no longer appropriate. Dealing with IP rights where lecture capture is concerned will inevitably require higher education institutions to review and justify their position on student IP.

Similarly, the recording of lectures and other instruments of teaching will require institutions to address the balance with academics and students explicitly, especially in relation to performers' rights.

WHAT IS A PERFORMANCE?

Some may question whether a lecture can be said to be a "performance", which is defined in law as a dramatic performance, or a reading or recitation of a literary work. Conventional legal wisdom is that performers' rights were

intended to cover such things as a lecturer or teacher conveying wisdom to students, with passionate expressions of thought covered as a dramatic performance, and even dull lectures covered as a recitation of a literary work.

It is therefore likely that a lecturer will own performers' rights in any lecture, and consent, whether through licence or assignment, should be sought to make a recording of the lecture and also to exploit it by copying it, issuing or making copies available to the public or disseminating it by enabling online access.

A recording made without the consent of a performer will be an illicit recording and dealing in illicit recordings is a criminal offence. Furthermore, it is possible for those in office to be criminally liable if the institution commits an offence with their knowledge and consent.

Although there may be instances where student participation in a lecture is substantive and dramatic, their participation will be largely passive and they are unlikely to have their own performers' rights in a lecture.

OTHER CONSIDERATIONS

Any performer in a lecture will also have moral rights in the performance, which will include

New data protection law is on the horizon and is likely to come into effect in the next year

the right to be identified and the right to object to derogatory treatment, and should be dealt with appropriately. These rights cannot be assigned, but can be waived in writing where necessary.

The law also provides for there to be rights for performers to equitable remuneration in certain circumstances, the levels of which will be decided by the Copyright Tribunal in the absence of agreement. This includes where a commercially published sound recording of a performance is exploited. A prudent institution would be wise to tackle this issue and set the parameters in which equitable remuneration would be payable. That is likely to make it easier to persuade lecturers that they should give their consent and allow the institution to control the recording of any lecture and its wider dissemination.

In addition, higher education institutions must also consider other rights participants in a lecture may have.

Copyright exists in the multitude of works arising from the giving of a lecture and the capturing of it – the lecture notes and any film or sound recording of the lecture. Where these are created by an academic or other employee in the course of employment, these will automatically be owned by the university employer. But where students or third-party contractors are

concerned, this will not be the case, unless specified otherwise.

Establishments will want to ensure that all copyright created in a lecture, especially the master copy, will be disclosed to and owned by the university, and that any third-party copyright is used with the proper consents in place.

In addition, establishments also need to consider the personal information captured when a film or sound recording is made, and ensure the correct procedures are in place to process this information fairly and lawfully in line with the Data Protection Act 1998 (“DPA”). This will include the data subject being told what information will be collected and what this will be used for, and asked for consent to process it in this manner.

Currently, informed or opt-out consent to use this information is allowed under the DPA, unless there is sensitive data involved, such as information about ethnic origin or health, where explicit or opt-in consent is required (in writing and signed, agreeing to information being processed). This situation might arise if a blind person is filmed and his/her walking aid is captured, clearly denoting his/her physical characteristic. Institutions should have clear and open policies, with no limitations, in place to allow students to opt out where they wish.

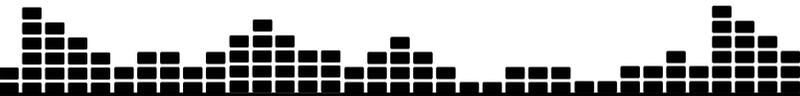
However, new data protection law is on the horizon and is likely to come

into effect in the next year, with the most impactful change being the requirement for explicit consent from the relevant data subject for use of all personal information, whether sensitive or not. Institutions should start anticipating this change.

INSTITUTION ACTION

Typically, the sector deals with these rights either through contracts of employment or through IP policies, consent forms or waivers, and they should not be shy to tackle these, especially performers’ rights, head-on. Some establishments are now incorporating policies dealing specifically with lecture capture. These can be very helpful to set and/or enforce the rules on: ownership and disclosure of IP created; appropriate lecture behaviour; rules on and monitoring of the making of recordings; information of personal information captured, and a clear procedure on opt-out.

The wording in these documents, and the mechanism for consent (ie licence or transfer), will depend on the level of control the institution wants over performances and other rights, in terms of exclusivity and exploitation, whether commercial or not. Careful review of the treatment of all IP and other rights relating to lectures will be needed if institutions are to be able to gain commercially through recording lectures and teaching events, and making them widely available, perhaps even on the international stage. ■



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TRADE MARK TRANSFORMATION

Patricia Collis outlines the changes that are due to come into effect regarding European Union trade mark law in 2016

The wording of Article 8(5) is set to be amended to reflect the decision in the Davidoff case that opposition can be based on a reputation claim, irrespective of whether the goods and

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services covered by the opposed application are similar or dissimilar to the goods or services for which reputation is claimed. Where EUTM opposition proceedings are based on earlier EUTMs, the proof of use date is set to change from the date of publication of the opposed application to the date of filing of the opposed application. Another change that is of differs of the registered mark regardless of whether the mark is also separately registered in the form

The bigger change in terms of fees is the significant reduction in renewal fees. While the existence of the OHIM surplus meant there was pressure to reduce these fees, account had to be taken of the need to ensure national trade mark systems were not undercut or undermined in deciding on the new levels. The new renewal fees will mirror the application fees (ie €850 for a single class, €900 for two classes and €150 for each additional class). This means a saving of €500 for renewals in one class, and of €250 per class for each class above three, resulting in substantial savings for those with

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coverage in several classes and for those with large EUTM portfolios. Application formalities Those wishing to claim priority will have to do so at the time of filing an EUTM application, and will no longer have a further two months from filing within which to do so. Any documents required to support a priority claim will have to be filed within three months of the date of filing of the application. Changes are also to be implemented with regard to search reports. The current

When the changes come

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into effect, the Community Trade Mark (CTM) will be renamed the European Union Trade Mark (EUTM), and OHIM will become the European Union Intellectual Property Office (EUIPO) The bigger change in terms of fees is the significant reduction in renewal fees. Those wishing to claim priority will have to do so at the time of filing an EUTM application, and will no longer have

Following an extensive study carried out by the Max Planck Institute, and input from the European Commission, Council and Parliament, we are set to see the introduction of a new Trade Marks Directive and Regulation in 2016, resulting in a number of changes to the Community trade mark system and further harmonisation of national trade mark systems within the European Union. Here, we consider some of the more practical changes.

At the EU level, the following major changes will come into force:

Names

When the changes come into effect, the Community Trade Mark (CTM) will be renamed the European Union Trade Mark (EUTM), and OHIM will become the European Union Intellectual Property Office (EUIPO).

Fees

In an effort to prevent further clutter on the Register, EUTM application fees will be charged on a per-class basis, rather than the current system in which the basic fee covers up to three classes. The new official fee will be €850 for a single-class application, €900 for a two-class application, and a further €150 per class for each additional class. In practice, this means a slight saving for those filing single-class applications, no change for those with interests in two classes, and an increase for those with interests in three or more classes. The hope is,

of course, that these fee changes will discourage applicants from covering more classes than needed.

The bigger change in terms of fees is the significant reduction in renewal fees. While the existence of the OHIM surplus meant there was pressure to reduce these fees, account had to be taken of the need to ensure national trade mark systems were not undercut or undermined in deciding on the new levels. The new renewal fees will mirror the application fees (ie €850 for a single class, €900 for two classes and €150 for each additional class). This means a saving of €500 for renewals in one class, and of €250 per class for each class above three, resulting in substantial savings for those with coverage in several classes and for those with large EUTM portfolios.

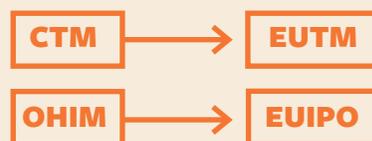
Application formalities

Those wishing to claim priority will have to do so at the time of filing an EUTM application, and will no longer have a further two months from filing within which to do so. Any documents required to support a priority claim will have to be filed within three months of the date of filing of the application.

Changes are also to be implemented with regard to search reports. The current system whereby OHIM automatically provides applicants with the results of a search of the CTM Register will be replaced by an opt-in system for both searches of the EUTM Register and of those national registers that offer such reports. There will be no fee for ▶

MAJOR CHANGES AHEAD

1 NEW NAMES



COMMUNITY TRADE MARK (CTM) WILL BE RENAMED THE EUROPEAN UNION TRADE MARK (EUTM)

OHIM WILL BECOME THE EUROPEAN UNION INTELLECTUAL PROPERTY OFFICE (EUIPO)

2 APPLICATION FEES



€850 SINGLE-CLASS

€900 TWO-CLASS

+€150 PER EXTRA CLASS

EUTM APPLICATION FEES WILL BE CHARGED ON A PER-CLASS BASIS, RATHER THAN THE CURRENT SYSTEM IN WHICH THE BASIC FEE COVERS UP TO THREE CLASSES

3 APPLICATION FORMALITIES



THE NEED FOR A MARK TO BE GRAPHICALLY REPRESENTED WHEN FILING AN APPLICATION WILL BE REMOVED

4 OPPOSITIONS



IT WILL BECOME POSSIBLE TO OPPOSE EUTM APPLICATIONS ON THE BASIS OF PROTECTED DESIGNATIONS OF ORIGIN OR GEOGRAPHICAL INDICATIONS

5 HARMONISATION AT MEMBER STATE LEVEL

BECOMING MANDATORY:



▶ ADMINISTRATIVE PROCEEDINGS FOR OPPOSITION, REVOCATION AND INVALIDITY, TO INCLUDE PROVISION FOR A JOINTLY REQUESTED SUSPENSION PERIOD OF AT LEAST TWO MONTHS IN OPPOSITION PROCEEDINGS. THIS WILL MEAN CHANGES FOR MALTA, BENELUX, FRANCE, SPAIN AND ITALY

▶ BAD FAITH GROUND FOR CANCELLATION



▶ PROVISION FOR REPUTATION-BASED REFUSAL, MEANING AMENDMENTS REQUIRED TO THE LAWS IN LITHUANIA AND CYPRUS



▶ SIX-MONTH GRACE PERIOD FOR LATE RENEWAL OF REGISTRATIONS

the EUTM search report, but fees will remain for the national search reports. Irrespective of whether the applicant has requested a search of the EUTM Register, the EUIPO will send citation letters to the owners of any earlier EUTMs cited, unless they request not to receive such notifications. There will no longer be a requirement for at least one month to pass between the transmission of a search report to the applicant and the publication of their application, which should result in applications being published and registered more quickly.

Two other key changes that are to come into force, and which are dealt with in both the Directive and the Regulation, are the removal of the need for a mark to be graphically represented when filing an application, and the clear endorsement of the “literal meaning” approach to what is covered by class headings.

Regarding the former, it is questionable whether this will make any immediate difference, as there is still a requirement for clarity and precision in what is protected. However, it at least leaves scope for other means of meeting the representation requirements in the future, which could prove useful as technology advances.

Turning to specifications, the new laws codify the approach adopted in the IP TRANSLATOR case, whereby specifications that include class headings are deemed to cover the literal meaning of the terms covered, and nothing more. As we know, for several years, OHIM practice was that class headings were deemed to cover all goods/services falling within a class. In light of this, the new Regulation includes a provision giving proprietors of registered EUTMs filed before 22 June 2012 (ie the date of the IP TRANSLATOR

judgment), and with class heading coverage, a six-month period to file a declaration indicating that their intention at the time of filing was to obtain protection beyond the literal meaning of the class heading(s) involved. Any such declarations should indicate the goods/services in respect of which there was an intention to obtain protection, with the proviso that only those terms included in the alphabetical list of the Nice Classification in force at the filing date shall be accepted. Any “expansion” of protection afforded by such amendments cannot be used to attack use or registration of intervening third-party marks where such use/registration by those third parties could not have been prevented if the literal meaning approach were taken at the time the use commenced or registration was applied for.

Opposition

The new laws will also bring into force some important changes in opposition proceedings, including a change in the opposition deadline for EU designations of International Registrations. For such designations, the opposition period will continue to last three months, but will start one month after publication by the EUIPO, rather than the current six months. This should result in speedier protection, but it is also likely to increase the frequency of instances in which the outcome of substantive examination is not complete before the opposition deadline; although the official opposition fee will still be refunded if opposition is filed and the designation is ultimately rejected on absolute grounds.

In an addition to Article 8(4) of the Regulation, it will become possible to oppose EUTM applications on the basis of protected designations of origin or geographical indications.



The introduction of EU certification marks is likely to be welcomed by those certifying bodies that have interests in multiple EU Member States, particularly those in which national certification marks do not exist

The wording of Article 8(5) is set to be amended to reflect the decision in the Davidoff case that opposition can be based on a reputation claim, irrespective of whether the goods and services covered by the opposed application are similar or dissimilar to the goods or services for which reputation is claimed.

Where EUTM opposition proceedings are based on earlier EUTMs, the proof of use date is set to change from the date of publication of the opposed application to the date of filing of the opposed application. Another change that is of relevance to proof of use is the confirmation of the point decided in the ProtiPlus case; that use of a mark in a form that differs from that in which it is registered can constitute use of the registered mark regardless of whether the mark is also separately registered in the form in which it is used.

Certification marks

The new Regulation provides for EU-wide certification marks. As with UK certification marks, it will be necessary to file regulations governing the use of such marks. The deadline for doing so will be two months from the date of filing the certification mark application.

Furthermore, there is set to be a separate implementing act detailing the requirements that all such regulations should meet.

The introduction of EU certification marks is likely to be welcomed by those certifying bodies that have interests in multiple EU Member States, particularly those in which national certification marks do not exist. While the normal rules relating to conversion will also apply to EU certification marks, it should be noted that it will not be possible to convert such marks into national applications in those territories where national law does not provide for certification marks.

MEMBER STATE LEVEL

In addition to the changes above regarding graphic representation and the literal interpretation of class headings, the new Directive will ensure harmonisation at Member State level on various other points, including the following:

- Mandatory administrative proceedings for opposition, revocation and invalidity, to include provision for a jointly requested suspension period of at least two months in opposition proceedings. This means that Malta will have to introduce opposition proceedings, and Benelux, France, Spain and Italy will all have to introduce administrative cancellation proceedings.
- Mandatory bad faith ground for cancellation.
- Mandatory provision for reputation-based refusal, meaning amendments required to the laws in Lithuania and Cyprus.
- Mandatory six-month grace period for late renewal of registrations.

Under the provisions of the new Directive, in those territories with post-registration opposition proceedings, the five-year non-use period shall be calculated from the date when the mark can no longer be opposed or, if opposed, the date on which the opposition was complete, either because it was withdrawn or because the opposition decision became final.

INTERESTING TIMES

With the new Regulation set to come into force just 90 days after the final version is published, and Member States having three years to introduce any changes to national laws required by the Directive (or seven in the case of the introduction of administrative cancellation proceedings), it should be an interesting few years for European trade mark law, as we all get to grips with these new changes. ■

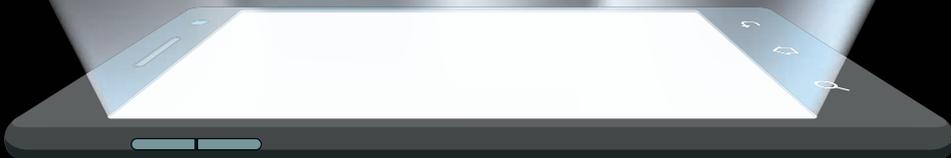


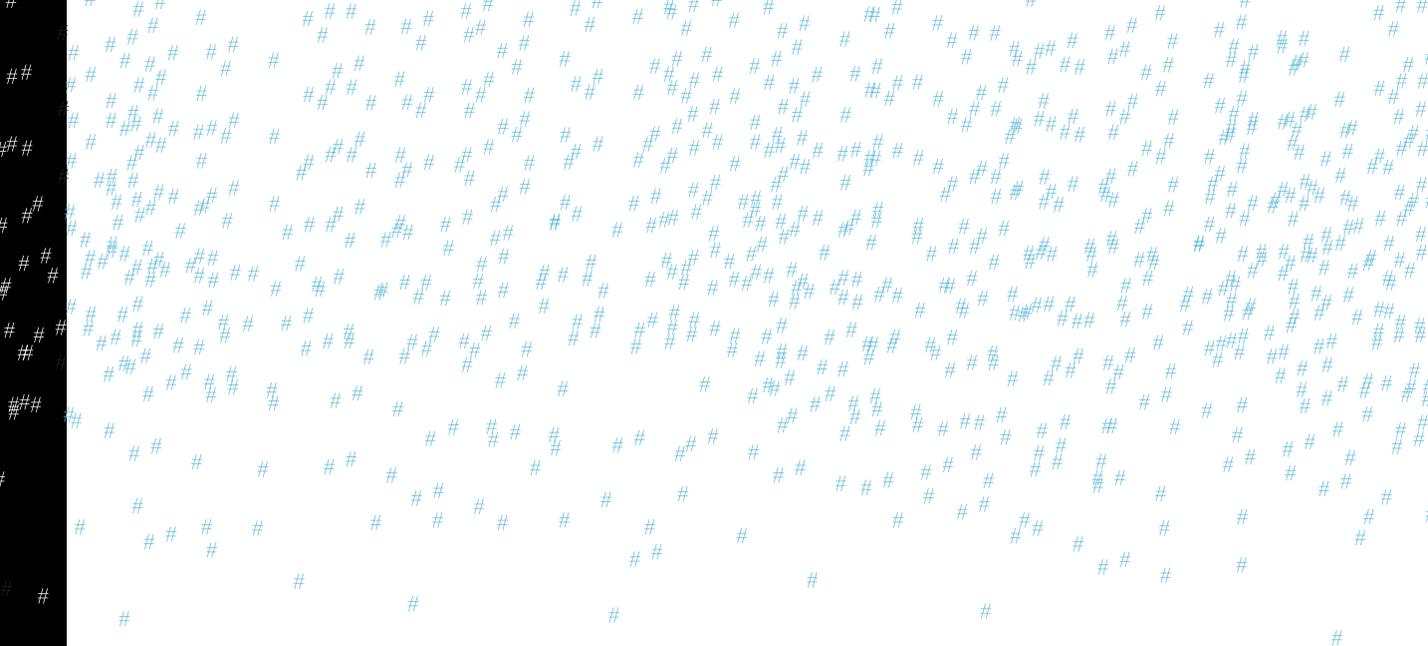
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*Carlton Daniel takes on a very modern
trade mark quandary*

#ToTradeMarkOrNot?





A strong grasp of innovative social media strategies is key to any modern brand's success in building reputation and sales.

In less than 10 years, social media has revolutionised the global marketing industry. Hashtags are a key social media tool, since they enable brands to obtain real-time indicators of a campaign's success and to gauge public opinion. However, using hashtags raises serious questions about the legal protections available under English law.

PRACTICE TO DATE

What if a third party is misusing a brand name in a hashtag? To date, there have been no reported cases of a trade mark owner successfully suing for infringement based on the use of its brand in a hashtag by a third party.

In fact, if the brand name is protected as a registered trade mark under the Trade Marks Act 1994 (the Act) there is no need to register the mark separately with the # symbol to obtain protection in the blogosphere. The brand owner will be able to take action under Section 10(1) of the Act if the hashtag uses the same word as the mark in connection with the goods/services for which the mark is registered. For example, to prevent use of "#RIO2016" in a damaging hashtag in relation to sport, the International Olympic Committee could use its registered trade mark "RIO 2016". The courts will ignore the # when considering whether the hashtag keyword is identical to the registered mark.

What is the position where the hashtag consists not only of the brand, but also of other words/symbols? In this case, a mark owner may be able to take infringement action under Section 10(2) of the Act. This section requires the use of an identical or similar mark in relation to identical or similar goods/services, provided there is a likelihood of consumer confusion. Case law is clear that any additional words that are descriptive will largely be disregarded for the purposes of assessing whether the keyword is "identical" or "similar". For example, if "BRAND" is an existing registered trade mark, the owner can prevent use of the hashtag #brand-is-unsafe, since the courts will not have a problem disregarding the use of the additional non-distinctive elements (assuming the criticism is shown to be untrue). This is similar to the way in which the courts have approached the .com element to domain names when considering trade mark infringement. Even if any words used in addition to referencing a brand in a hashtag are not purely descriptive, there will usually be an argument that there is at least a similarity of marks. Thus, the owner would only need to show identity or similarity of services, together with the requisite confusion, to stop misuse.

For those brands with a reputation, the L'Oréal case (C-487/07) reminds us that the door remains open for a claim under Section 10(3).

Therefore, as a general rule, if a brand that is a registered trade mark is being used within a hashtag, the owner of that mark can likely rely on its existing registrations to prevent third parties from infringing its IP rights.

Social media platforms such as Twitter have also responded to concerns raised by brand owners on the infringement issue. Platform terms tend to prevent users from using a hashtag followed by a company name if such use will mislead or confuse others in relation to the origin of a product or service.

However, the Act permits reference to trade marks for legitimate purposes. For example, competitors for comparative advertising, such as #cheaperthanbrand, will be permissible provided that the comparison meets the requirements of the Misleading and Comparative Advertising Directive (2006/114/EC). In short, key considerations are that a comparison must be objective, it must compare relevant features of the goods/services, and must not be misleading. (See, for example, the O2 case, C-533/06.)

WHAT IS A HASHTAG?
Hashtags are a combination of words or phrases to help users find messages about specific topics. The symbol # is placed in front of a keyword or phrase, and social media platforms, such as Twitter, Instagram and Facebook, group together entries on the same topic.

An action in passing off should not be discounted either – one does not necessarily require a registered trade mark to prevent third-party use of a mark with a reputation if the third party-use is a misrepresentation to the public likely to cause damage, whatever form that misrepresentation takes. The common law is wonderfully flexible in its approach in that respect.

A hashtag that refers to a brand and damages a company's reputation may also give rise to a claim for defamation or malicious falsehood.

REGISTRATION

Although the Act does not specifically address the registerability of hashtags, a careful reading of the Act, together with the relevant case law, makes it clear that many hashtags will be protectable as registered trade marks. Given their importance, it is not surprising that attempts from brands to register hashtags as trade marks are becoming more frequent. Notwithstanding the comments above, demonstrating that existing brands need not be registered separately in order to protect them from unauthorised use in social media, many brands will still wish to protect new keywords that may (or may not) incorporate an existing mark.

For example, earlier this year, Coca-Cola applied to register the hashtags #cokecanpics and #smilewithacoke in the US. Under current UK trade mark practice, keywords that are not distinctive (eg purely descriptive or laudatory words) and do not serve as an origin guarantee for the goods/services to which they relate will struggle to be accepted as trade marks by the UK IPO. In other mediums, an applicant may seek to make such keywords distinctive by incorporating them within a logo or using stylisation. The scope of protection for such marks is narrow.

However, most social media platforms only permit plain text, and thus protective registration of any keywords as stylised/logo trade marks in order to prevent online infringements within hashtags will often be ineffective. Another way in which the owners of such keywords have sought protection is by long-standing and consistent use to build up a reputation for a phrase, which overcomes the non-distinctiveness problem in becoming, in fact, distinctive of the trader's offering. However, even in the case of relatively well-known slogans (as hashtags can typically be characterised) the courts have struggled to accept these for registration (for example, in the Kit Kat "HAVE A BREAK" case, C-353/03).

RISKY BUSINESS?

Consider, too, the commercial merits of seeking protection for a brand's hashtags. While many registrations of simple marks can be quick and simple, where one is seeking to register a mark that is not inherently distinctive it can be an uphill struggle, which means that it is a timely and expensive process. Many hashtags are used for a relatively short time. Would a heavy investment in a registration for #IceBucketChallenge be worth it?

Social media can also go spectacularly wrong. Using #McDStories, McDonald's sought to encourage users to share their positive experiences. In an example of "bashtagging", the hashtag began trending with negative stories about user visits to its establishments. A trade mark for the hashtag would be of

A hashtag that refers to a brand and damages a company's reputation may also give rise to a claim for defamation

little assistance in this scenario, and, in any case, would likely come too late.

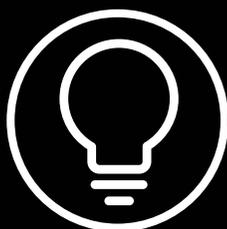
In addition, using registered trade marks within hashtags also runs the more general risks of brand dilution and can contribute to making a mark generic. It can also be risky if a brand abandons use of a mark if the hashtag is no longer trending. Consistent failure to police a brand's use in this way can lead to a mark being liable for revocation.

The question #ToTradeMarkOrNot? is therefore as much of a commercial consideration as a legal one. For many established brands, it will not be necessary to invest the time and expense of obtaining separate trade mark registrations as hashtags. Further, many hashtags would seem unsuitable for protection as registered marks. What is important is that, together with their trade mark professionals, brands develop strategies that will protect their brand's image and goodwill, while appreciating the influence of social media and the benefits and risks such use engenders. ■



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TOWARDS DRS SUCCESS

In Manchester, Dr Patricia Jones talked members through the tips and “traps” of making or defending a Nominet complaint

The Complainant is required to prove to the Expert, on the balance of probabilities, that it has Rights in respect of a name or mark which is identical or similar to the domain name (“DN”) and the DN, in the hands of the Respondent, is an Abusive Registration.

TIP: The dispute is decided on the basis of the parties’ submissions. Ensure that you evidence all assertions made in a submission and exhibit relevant web pages.

Rights are typically registered or unregistered trade mark rights; they include overseas rights but not trade mark applications.

TIP 1: Ensure that the Complainant is the owner/licensee of the Rights.

TIP 2: Exhibit trade mark registrations and any licence.

TIP 3: Provide evidence of use of the mark and that it is recognised by the trade or public as indicating the goods or services of the Complainant (eg sales figures, advertising spend, accounts etc).

Where alleging Abusive Registration on the basis that a DN was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights:

TIP 1: A factor that may be evidence is circumstances indicating the

Respondent registered or acquired the DN primarily to sell, rent or otherwise transfer it to the Complainant or a competitor of the Complainant at a profit. Note that this relates to the Respondent’s motives at the time of registration or acquisition of the DN. The Nominet Dispute Resolution Service (DRS) Policy sets out that trading in domain names for profit is a lawful activity.

TIP 2: Explain why the Respondent knew of the Complainant and/or its Rights at the time of registration or acquisition of the DN.

Or, where alleging Abusive Registration on the basis that a DN has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights:

TIP 1: A factor that may be evidence is circumstances indicating the Respondent is using or threatening to use the DN in a way which has confused or is likely to confuse people or businesses into believing the DN is registered to, operated or authorised by, or otherwise connected with the Complainant. This includes initial

interest confusion; the nature of the DN means the speculative visitor to the Respondent’s website will visit it in the hope and expectation that it is owned or authorised by the Complainant.

TIP 2: Evidence the use of the DN, explain how confusion is likely to occur and provide details of any actual confusion.

When alleging or defending Abusive Registration:

TIP: Refer to paragraphs 3 and 4 of the DRS Policy which set out a non-exhaustive list of factors which may be evidence that the DN is or is not an Abusive Registration.

Some of the factors that may be evidence that the DN is not an Abusive Registration are only likely to apply if they started when the Respondent was unaware of the Complainant’s name or mark.

TIP: Ensure that you provide evidence in support.

Finally, seek guidance from the many sources of help, including the Nominet website and the Experts’ Overview. Good luck! ■



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Patricia has been appointed by Nominet as an expert to adjudge on .uk domain name disputes.

SEA CHANGE FOR BVI

Katherine Van Deusen Hely hails the modernisation of this wealthy territory's trade mark laws

One of the last Commonwealth Caribbean holdouts to update its trade mark laws, the British Virgin Islands (BVI) has taken significant steps over the past two years to modernise the local trade mark regime. This long-awaited overhaul went into effect on 1 September 2015, following a proclamation earlier in the year.

The Trade Marks Act 2013 was passed in April 2013, but not until a year later were the draft Trade Mark Rules 2014 published for comment. The local Government finalised and issued the new rules on 15 April 2015.

The BVI consists of the four main islands of Tortola, Virgin Gorda, Anegada and Jost Van Dyke, as well as a number of smaller islands. Of the approximately 28,000 people living in the BVI, more than 80 per cent reside on Tortola, the island home to the BVI's capital city, Road Town. As may be expected, offshore financial services and tourism play a large role in the local industry, which has contributed to this territory becoming one of the wealthiest in the Caribbean.

An English common law jurisdiction, the BVI is similar to other common law jurisdictions in that it grants some rights in a trade mark to the entity first to use the



mark over the first to file. The new act confirms that nothing in it shall affect the common law right of action for passing off or related remedies. However, the act makes clear that there will be no proceedings to prevent or collect damages for infringement of an unregistered mark.

DUAL SYSTEM DONE

For years, the BVI has protected trade marks via a dual system of registration. Trade mark owners holding a UK trade mark registration have been able to use such registrations as a basis for filing in the BVI. The resulting UK-based registration in the BVI would generally mirror the underlying UK registration. Further, the term of validity would be tied to that of the UK registration.

In comparison, applicants without an existing UK registration could register locally for goods only; it has not been possible to register for services except on the basis of a prior UK registration. The classification of goods for local registrations has been according to the old British classification system and not the international classification system. This old classification system covers goods in a total of 50 classes – many of which are somewhat antiquated. As might be imagined, this system has proved unwieldy at times, leaving something to be desired in the protection of the modern trade mark owner's goods.

The new laws eliminate the dual filing system and provide for a unified trade mark registration regime that protects both goods and services according to the latest edition of the Nice Classification system. Class headings will no longer be accepted. For unadvertised applications filed under the old act, applicants may request that examination be conducted in accordance with the new act. Such requests must be made within six months of the commencement date of the new act. All new applications are subject to absolute and relative grounds of refusal.

Paris Convention priority will be available, well-known marks will be recognised and defensive trade marks may be registered – the latter being predicated on the mark becoming “exceptionally well known in the Virgin Islands”. In addition, the act states that the registry shall maintain a register of Geographical Indications. BVI is not a party to the Madrid Protocol and, notably, the new laws do not make provision for joining Madrid.

IMPORTANT PROVISIONS

Oppositions may be waged by any person with an interest in the mark. The opposition period is three months from the date of publication of the application.

Within the Registrar's discretion, extensions of time may be granted for almost any action unless there is good reason not to grant such an extension.

Under the new system, marks will be registered for a period of 10 years and renewed for like periods of 10 years. The change in the period of validity of new registrations will not affect the renewal period for existing registered trade marks, which will continue for the full remainder of their existing terms and thereafter be renewed for periods of 10 years. Existing local registrations are valid for a period of 14 years and UK-based registrations are coterminous with the underlying UK registrations.

Prior use in the BVI is not necessary for registration. Failure to use a registered mark within three years following the date the mark is actually registered may render the mark vulnerable to a third-party revocation action. However, revocation may be avoided if special circumstances posed an obstacle to local use of the mark.

Existing trade mark registrations will be automatically transferred to the new register. UK-based registrations will not require reclassification. As such, registrations would already be classified according to the international classification system. This is in contrast to existing local registrations, for which the new laws provide the Registrar with discretion to reclassify goods previously classified according to the old British system. Before proceeding with reclassification, the Registrar must give notice to mark owners to allow time for objection.

Also within the Registrar's discretion is restoration of a trade mark that has not been renewed within the prescribed time. Restoration may be available within six months of expiration upon application by the owner and payment of late penalty fees.

All disclaimers required under the old laws will be deemed transferred to the new register and shall have effect as if entered under the new law.

Although it was previously difficult to cancel an existing registration in the BVI, the new act provides that any person may make an application for cancellation of a registered mark on various grounds. Mark owners may apply to cancel their own marks for some or all of the goods or services for which the mark is registered. In addition, it will be possible for an aggrieved person to apply for and obtain a declaration of invalidity.

Consistent with the TRIPS Agreement, the new act provides that the proprietor or licensee of a registered mark may give notice to the BVI's Commissioner of Customs to restrict importation of infringing goods, and the court may order the forfeiture and destruction of infringing goods. ■



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IN UNCERTAIN TERRITORY

Birgit Clark considers the impact of the ONEL decision on the future appetite for CTMs

24

Under Article 51(1)(a) Council Regulation (EC) 207/2009 (CTMR) a Community Trade Mark (CTM) shall be liable to be revoked on the grounds of non-use if: “within a continuous period of five years, the trade mark has not been put to genuine use in the Community in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use...”.

Following a referral by the Benelux IP Office concerning the interpretation of the requirement for “genuine use in the Community”, the Court of Justice of the European Union (CJEU) in 2012 held in the now (in)famous ONEL case (C-149/11) that even though the “territorial scope” of trade mark use was important, it was only one of the many factors that must be considered when assessing genuine use. Further, such use must also be in accordance with the essential function of the trade

mark to act as a badge of origin, as well as for the purpose of maintaining or creating a market share within the Community.

Further, use may not merely be “token use” and account must be given to: “all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and scale of the use as well as its frequency and regularity”. Indeed, the market for goods or services covered by a CTM may be restricted to one country so that “territorial borders of Member States should be disregarded” and an abstract assessment should be made based on the use of the mark within the Community as a single territorial entity. Finally, use of the mark need not be over an extensive geographical area in order to be sufficient since this would depend on the characteristics of the product or service.

The CJEU’s decision in this suspected test case was widely seen

as in line with the unitary nature of CTM and the purpose of the CTMR to remove territorial trade barriers. Observers also generally welcomed the Court’s guidance, even though its exact application was seen as leaving room for interpretation, which is reflected by two contrasting interpretations from two national courts revealing unexpected national differences.

GERMAN INTERPRETATION

In June 2013, the German Federal Court of Justice (BGH) in the VOODOO case (I ZR 106/11) assessed the question of territorial scope of use necessary to meet the requirement of genuine use under Article 51(1)(a) CTMR within the context of a trade mark infringement claim, *inter alia*, based on a CTM that was older than five years.

In the decision, the German judges stressed that the same standards applied to German national and Community trade marks due to the harmonisation of EU trade mark laws.

The CJEU's decision was widely seen as in line with the unitary nature of CTM and the purpose of the CTMR to remove territorial trade barriers

Further, the use of a trade mark was genuine if it was used to create or preserve an outlet for the goods and services so that “merely symbolic” use did not suffice. In particular, the Court based its decision on the CJEU’s guidance in ONEL. According to BGH’s reading, the ONEL decision did not exclude the possibility that use of a CTM in only one EU Member State could constitute genuine use in the sense of Article 51(1)(a) CTMR. The judges further expressly confirmed the practice of the lower instance court in this regard, which had focused on the territory of Germany when assessing whether the challenged CTM had been put to genuine use.

The German judges explained that continuous use of the trade mark during the relevant period was not required for genuine use, and even use commenced shortly before the expiry of the five-year grace period could be enough to preserve the trade mark, provided it was “genuine”. The decision is noteworthy because of the confidence with which the court accepted that use in Germany, without claiming any use elsewhere in the EU, was sufficient for maintaining rights in a CTM.

IPEC EXPERIENCE

A very different interpretation of ONEL can be found in a recent decision by the Intellectual Property Enterprise Court, England and Wales, (IPEC) relating to a non-use revocation counterclaim brought in a trade mark infringement claim – *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC) of 29 June 2015.

In this case, the IPEC held that use of the CTMs in question only in the

UK within the relevant five-year period did not amount to genuine use under Article 51 CTMR, concluding that “genuine use” of a CTM generally required evidence that a mark had been used to create or maintain a share in the relevant market at least beyond the boundaries of one EU member state. A review of the evidence in the case, which included advertisements, use on the owner’s website and promotional material, had revealed that the owner of the challenged CTMs had only used its marks in the UK and had realistically only targeted UK consumers.

Similar to the BGH, the IPEC based its decision on the CJEU’s guidance in ONEL, albeit reaching a different conclusion by contrasting it with the CJEU’s *Sunrider* decision (T-24/00), where it was held that the proprietor of a national mark trading in one town may, in due course, have wished to trade all across that country. The IPEC found that this reasoning could not be transferred. It could not be concluded that a trader who was active in one EU country would equally wish to extend his trade to additional EU countries: “... there is a distinction between national marks and Community marks ... For national marks the geographical extent of use is a factor to be taken into account, but it is apparently of no great weight ... In respect of

Community marks the geographical extent of use is, in the general run, crucial: it must extend at least beyond the boundaries of one Member State. By way of a non-exhaustive exception to the general rule, this does not apply where the market for the goods or services is confined to one Member State.”

CONFLICTING OPINIONS

The differences in the interpretation of the ONEL case are surprising. If the IPEC’s view was confirmed by further (higher instance) court decisions in the UK, then this could potentially lead to a situation where there are different “national” requirements for the maintenance of a CTM in the UK and Germany. According to the so-far common reading of ONEL, which is arguably reflected in the BGH decision, the CJEU in ONEL had expressly declined to establish a *de minimis* rule for the size of a territory to satisfy the use requirement. While it might be reasonable to expect that a CTM should be used in a larger area than a national mark, it was not required that such use was in an extensive geographic area.

National differences in interpreting CJEU decisions are not unusual, but in this case they could affect the choice of trade mark protection brand owners will seek and thus have a serious impact on the attractiveness of the CTM system. ■



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UPPING THE ANDES

Ian Wall introduces us to a regional initiative that has seen IP expertise flourish

The Andean Community (originally the Andean Pact), is a regional integration initiative that was created to promote economic growth, through intra-regional trade as opposed to purchasing goods and technologies from foreign countries. Although political attitudes towards “import substitution” in the region may have shifted somewhat since the inception of the initiative, after some initial teething problems the “Community” has gone on to have considerable success in moving towards a uniform approach in the field of intellectual property, with the Tribunal de Justicia de la Comunidad Andina (Andean Tribunal of Justice, or ATJ) developing a considerable amount of jurisprudence in this area following “preliminary references” from member countries.

CURRENT IP LAW

Andean legislation enters into force through various “Decisions”, which

have direct effect in the member states: Bolivia, Colombia, Ecuador and Peru. As in the European Union, where Community legislation exists, the national laws are subordinate. Decision 486 and its predecessor Decision 344 are IP-specific, and brought Andean IP law into line with TRIPS. Although stopping short of creating a unitary trade mark right, this was in fact the overriding end goal when drawing up the trade mark legislation. Certain groundwork provisions were created to this effect, as follows:

1. A prior right application or registration in any member country of the Andean Community entitles the owner to oppose a trade mark application in another Andean country, provided that an application identical to that on which the opposition is based is filed simultaneously to the opposition in order to evidence interest in the market.
2. A non-use cancellation action brought in one member country may be defeated by evidencing use in any other member country.

It is clear that Europe is still seen by the Andean lawmakers as the blueprint for achieving its goals of integration and economic growth

The current system, although not providing for a centralised filing process or unitary right, has promoted a great deal of uniformity and has come to be one of the success stories of the Andean Community, with the caseload of the ATJ being overwhelmingly related to IP and trade marks.

CHANGE AFOOT

The growing recognition at a global level as to the importance of IP rights through the corresponding period of development of the Community has been no less marked in the Andean countries, and has contributed to the increased number of references reaching the ATJ. Subsequently, the largely IP-related workload over this period has enabled the ATJ to develop considerable expertise in this area, at least certainly more so than some of the national courts. In turn, both domestic and international brand owners have been quick to recognise the more favourable conditions in the ATJ forum – not only in relation to the greater level of expertise, but also the fact that the ATJ is independent and free from political and private influence, which is not so easily said about the domestic courts.

However, not every client has the budget or will to take a case, and certainly not every case, to the ATJ. (Appeals from the respective trade mark offices go first to the national courts. The lower national courts are permitted to make references to the ATJ, while the courts of last instance are obliged to do so.) And despite the fact that cross-border discussions as to how to apply the universal law have

improved the overall quality and consistency of decisions at the national level, some of the decisions that emanate both from the IP agencies and the courts are, at times, still perplexing.

Community law reforms, whose aims are to achieve further integration in related spheres, are afoot, with the ATJ currently consulting in the member countries as follows:

1. The ATJ is calling for better protection for consumers, in the sense of more information and more transparency with regard to product information, which it envisages would help to promote cross-border transactions. There are currently national rules relating to such areas as weights and measures, labelling, quality and expiry dates, but these rules vary as to their application, which can lead to non-tariff barriers and impede the free movement of goods and consolidate monopolies.
2. IP-specific Decision 486 contains provisions relating to unfair competition. However, these provisions are limited in scope, applying only to industrial property and acts of confusion, and as such exclude all those acts that do not necessarily include a trade mark or invention etc. Andean Decision 608 is the general legal framework for protecting and promoting *libre competencia* or 'free competition' in the Andean Community, which includes provisions for prohibiting agreements that limit competition and abuse a dominant position. However, Decision 608 contains structural flaws and lacks mechanisms in order to be able to identify such practices. A complete revision of Decision 608 is proposed.
3. Andean Decision 486 provides general rules in relation to geographical indications, whereas the European Union has three separate schemes: Protected Designation of Origin, Protected Geographical Indication and Traditional Speciality Guaranteed. The ATJ is proposing developing more extensive legislation in this area along the same lines. As in the EU, the benefits of such systems are seen to be increased revenue for producers, generating agricultural and rural development, and encouraging better-quality products and more product information for consumers. In addition, the quality and information controls help to promote the products internationally.
4. Each Andean country has its own country mark that serves to promote the identity and image of the country, and they are particularly prominent in the fields of tourism and promoting investment. These types of marks are not just exclusive to the Andean Community, as they are also becoming popular in many other countries. However, protecting such marks from misuse throughout the world is problematic; trade mark registrations may be obtained, but to register in multiple classes and then to maintain the marks in view of the non-use provisions is onerous. In the absence of any such suitable international agreement regarding country marks, the ATJ is proposing at least a regional agreement through the adoption of a new Decision, which would recognise Country Trade Marks and establish mechanisms for their protection against unauthorised use and registration.

With around 100 million inhabitants, a common language, and a relatively homogenous culture, an Andean Trade Mark would be attractive to brand owners

The proposed reforms make for interesting reading. It is no secret that the Andean legal system was closely modelled on Europe with the hope of emulating its success, and, with multiple references to the European “model” within the full report, it is clear that Europe is still seen by the Andean lawmakers as the blueprint for achieving its goals of integration and economic growth. Importantly, the proposals also recognise that Community-level legislation is required if harmonisation is to be achieved, since it is not just conformity of laws that is necessary; the system whereby references are made to the ATJ is essential for a more uniform interpretation of the law, which does

not come into play when only national laws exist.

There is no reference yet within the proposed reforms as to a unitary trade mark right, yet the authors noted at a recent INTA/ATJ consultation in Quito, Ecuador, that there is a will to go further than the current tabled reforms. Whether such will extends as far as carrying through with creating an Andean Trade Mark as originally intended remains to be seen, but such a system would be logical and welcome, and in keeping with the Andean Community desire to model itself on its European counterpart.

A centralised trade mark system as envisaged by the makers of the original legislation would lead to a more harmonised system, as the preliminary reference mechanism already in place could be adapted to enable recourses from a possible “Andean OHIM” to go through to the ATJ, and thereby no need to involve the national courts. There would also be less of an issue as exists in Europe when deciding whether to file nationally rather than Community-wide due to the number of countries. Yet with around 100 million inhabitants, a common language, and a relatively homogenous culture, an Andean Trade Mark would be attractive to brand owners.

Such a system therefore would not only be practical, but also has the

potential to generate greater confidence than that which exists in relation to the current separate national systems. Greater certainty for brand owners and the added practicalities could generate increased investment, benefiting the Community as a whole, as envisaged by its creators more than 40 years ago. For the time being though, European legal practitioners will be interested to watch the developments, taking particular note that their legal system is held in such high regard.

It is also notable that, at a time when the ATJ is putting forward progressive proposals for reforms, the situation in Ecuador continues to be non-conducive to enforcing IP rights; the current Government has been extremely outspoken in its view that IP rights inhibit local production and the dissemination of information to the public, which has affected judicial thinking in favour of infringers and against right holders. For this reason also, it is extremely difficult to obtain settlement agreements with third parties, since infringers are increasingly aware of the courts’ said reluctance to impose sanctions. A unified trade mark system and perhaps even a central forum for infringement would bring about an interesting clash of ideologies if the current trends persist in Ecuador. ■



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A TALE OF TWO PONIES

The Court's approach to a polo dispute was novel to Prithipal Singh

In a recent trade mark opposition, the Intellectual Property Office of Singapore has clarified the factors to be taken into account in the determination of likelihood of confusion, while adopting a rather novel approach to the consumer perception factor.

The opposition was brought by The Polo/Lauren Company LP (PLC) in relation to Singapore Trade Mark Application No T1215440A (the "Application Mark", shown bottom right) in class 9 for a variety of eyewear, filed by United States Polo Association (USPA).

PLC relied on two grounds: similarity between the USPA mark and its own Mark No T9604857H (shown top right) created a likelihood of confusion, and bad faith.

On the first ground, PLC argued that the contending marks are similar and are to be registered for goods that are identical, hence there is a likelihood of confusion. In the assessment of similarity between the marks, the IP Adjudicator ("IPA") adopted the "step-by-step" approach approved by the Singapore Court of Appeal in recent cases:

- **Visual Similarity:** The IPA compared the Single Polo Player Mark against the Application Mark as a whole, without giving special regard to either the device or the text in the Application Mark, and held that while there is a small degree of similarity between the devices, the presence of the text "USPA" in the Application Mark significantly reduces this similarity, and accordingly there is only an extremely low degree of visual similarity between the two marks.

- **Aural Similarity:** The IPA held that the marks are aurally dissimilar.

- **Conceptual Similarity:** The IPA found that there is no dominant component in the Application Mark for purposes of conceptual comparison and, assessing the Application Mark as a whole, observed that the Double Horsemen Device (just like the Single Polo Player) conveys the idea of the game of polo. Further, the presence of the text "USPA" does not add or subtract from this idea. Accordingly, the IPA held that the two marks are conceptually identical.

Looking at the two marks in their totality, the IPA found that the Application Mark and PLC's earlier trade mark are similar, although the degree of similarity was low.

In the assessment of likelihood of confusion, the IPA held that when determining the degree of care that the average consumer will pay when purchasing eyewear, it is inappropriate to consider the relative cost of USPA's and/or PLC's eyewear. The reference point should be the normal or average price of eyewear as a type or category of goods. The IPA observed that eyewear is usually purchased based on visual inspection and hence the visual aspect of the marks is likely to have a greater impact on the consumer, and that in this case there is only a very low degree of visual similarity between

the marks. This factor, when coupled with the fairly high degree of care and attention that the average consumer will pay when purchasing eyewear, points away from a likelihood of confusion. The IPA therefore concluded that there is no likelihood of confusion and the opposition thus failed on this ground.

On the second ground, PLC failed to fulfil the high evidentiary threshold to demonstrate bad faith. Since the opposition failed on both grounds, USPA was awarded costs. PLC has filed an appeal to the Singapore High Court, which remains pending to date. ■

The Polo/Lauren Company Trade Mark No T9604857H



United States Polo Association Trade Mark Application No T1215440A



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Orchestras at odds

Magdalena Borucka covers a musical case that emphasises the unitary character of a CTM

This case considers several legal issues – trade mark infringement, invalidity, passing off and copyright infringement – and emphasises the unitary character of a Community Trade Mark (CTM), and importance of fixation in copyright claims.

The Claimant, The Ukulele Orchestra of Great Britain (UOGB), a UK-based orchestra, which was founded in 1985 and has since garnered some goodwill, claimed infringement of CTM Registration No 009477341 for “THE UKULELE ORCHESTRA OF GREAT BRITAIN” under Article 9(1)(b) and 9(1)(c) of Council Regulation (EC) No 207/2009 (CTMR), passing off and infringement of copyright. In response, the Defendant, which operates under “The United Kingdom Ukulele Orchestra”

(UKUO), and is formed of British musicians based in Germany, counterclaimed for a declaration that the CTM is invalid under Article 7(1)(b), (c), (d) and (g) CTMR.

INVALIDITY

While the CTM is registered to cover goods and services in classes 9, 15, 16, 18, 25, 28 and 41, the case focused only on the concert services in class 41 and CD/DVD goods in class 9. HH Judge Hacon first considered the invalidity claim and, after referencing the relevant case law, in particular *JW Spear & Sons Ltd v Zynga Inc* and *Linkin Park*, decided the mark was descriptive in relation to concert services as well as CD/DVD goods both in the UK and elsewhere in the EU and was, therefore, invalidly registered.

ACQUIRED DISTINCTIVENESS

The Judge then went on to consider the claim of acquired distinctiveness under Article 7(3). Distinctive character has to be proved in the part of the Community in which it initially had descriptive character and that territory depends on the language of the mark. Here, the countries included those where English and/or German (the German *Ukulelenorchester* meant that the mark would be non-distinctive for German speakers) is spoken as a mother tongue or is an official language and where those languages are sufficiently well spoken by average consumers for the descriptiveness of the word to be perceived. Due to the unitary character of a CTM, it would be paradoxical for a Member State to refuse a national registration of a mark because of its inherent lack of

distinctiveness in its territory and then to have to respect a CTM for the same sign because it has acquired distinctive character in another Member State. UOGB provided evidence in support of this claim, referring to its concert performances in the UK and elsewhere in the EU, media appearances, and CD and DVD releases. The evidence, however, did not cover all the relevant countries and, as such, acquired distinctiveness was not established and the registration was deemed invalid.

TM INFRINGEMENT

In case he was wrong regarding invalidity, the Judge also considered the infringement claim referring to two recent cases, *Spear v Zynga* and *Roger Maier and Assos of Switzerland SA v ASOS plc*, and found that the signs were visually, aurally and conceptually similar and that there exists a likelihood of confusion. UOGB provided examples of confusion between the two groups and their concerts (that was largely uncontested). The Judge gave short shrift to infringement under Article 9(1)(c), finding that UOGB did have a reputation in its mark and that UKUO's use was without due cause (as it did not constitute the sort of fair competition contemplated in *Specsavers International Healthcare v Asda Stores Ltd*). Moreover, after considering the recent *Maier v ASOS* case, he found the Defendant's use of its sign was not in accordance with honest practices within the meaning of Article 12(b) (the "own name" defence), and the defence under this article failed. Bearing in mind all of the above, the Judge decided that, should the CTM be validly registered, UKUO would infringe it pursuant to both Articles 9(1)(b) and 9(1)(c).

PASSING OFF

The evidence provided by UOGB to establish acquired distinctiveness was sufficient to prove goodwill in UOGB's business in England and Wales associated with the mark in question. The Judge held that UKUO's use of its

This is a case where a descriptive mark wasn't protected by a registration yet a claim to passing off succeeded

trade name misrepresented that UOGB and UKUO are the same group, or are commercially connected, to a substantial part of the UK public and that such use caused damage to UOGB's goodwill, in particular by loss of control over UOGB's reputation as performers. In this respect, the claim for passing off succeeded.

COPYRIGHT INFRINGEMENT

UOGB claimed copyright in two dramatic works that referred to the format of its performances, which was copied by UKUO. While the Judge accepted that copyright could subsist as a dramatic work in the performance of a musical group, that performance needs to be recorded. Because of the way the evidence was presented – the two performances were not clearly drawn to the Judge's attention and instead two lists of their elements were each characterised as the dramatic works relied on – the claim was

dismissed. The Judge emphasised the importance of certainty in the subject matter of a copyright work; while it is not impossible to claim copyright in a "format" (referring to *Green v Broadcasting Corp of New Zealand*), a claimant still needs to rely on particular works fixed by means of recording the performances, which was not the case here.

UOGB also alleged infringement of both its trade mark and copyright by one of the Defendants who owns a domain name ukulele-orchestra.co.uk, a site that pointed to UKUO's web page showing its full name. Both claims were dismissed.

COMMENT

This is a case where a descriptive mark wasn't protected by a registration yet a claim to passing off succeeded. Had the Claimant provided relevant evidence of acquired distinctiveness in all applicable Member States, it might have been a different story.

The case also reinforces the notion that a CTM has a unitary character protecting trade marks in all Member States and requiring that they are distinctive in all of them. From a practical perspective this means that where a mark is descriptive in English (in particular), evidence of acquired distinctiveness needs to be shown in each of the relevant countries – or at the very least arguments presented to show that there can be extrapolation based on the evidence provided. Consequently, a national registration may be a better choice. This latter point explains the different outcomes. Usually, a trade mark case and a passing off case should come to the same result. Here, had the Claimant had a UK-registered mark, it would have won on that, as well as for passing off.

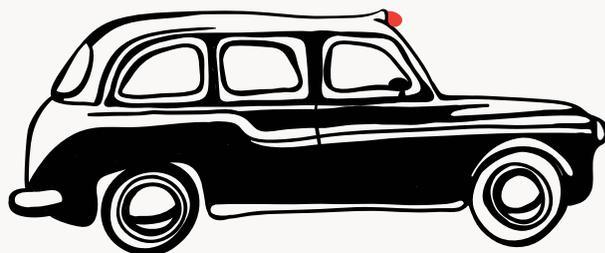


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Cab research not accepted

Amélie Gérard explains why, once again, survey evidence was not deemed useful



The Claimant is a manufacturer of the London black cab and alleges infringement of trade mark registrations and passing off in respect of the appearance of the Fairway, TX1 and TX4 taxi models. The Defendants are concerned with the Metrocab – a zero-emissions taxi.

To assist its passing off claim, the Claimant filed an application to have evidence of a pilot survey adduced, and requested permission to carry out a full survey and to be able to rely on the evidence obtained. The survey included two photographs, one (C2) of the Defendants' Metrocab, and one (M7) of the Claimant's TX4.

Ninety-eight interviews were conducted in and around central London over six days and interviewees were asked to look at photograph C2 before answering 10 questions related to the images, including: "What can you tell me about what you are looking at?" and "What would you say if I told you there was no connection between the company that makes this vehicle [C2] and the company that makes this vehicle [M7]?" (questions one and five respectively). The survey also included several questions related to the interviewees' place of residence (whether they were resident in London or the UK) and use of a London taxi in the past year.

After the first day of interviews, the survey was modified, including the replacement of question five with, "Do you think there is a connection between the company that makes this vehicle [C2] and the company that makes this vehicle [M7]?" and a new question, 5b, "Why do you say that?".

THE LAW

The principles and guidance concerning the admission of surveys and evidence derived from surveys is found in the recent *Interflora* and *Zeebox* decisions. Nonetheless, the Claimant argued – among other points – that a survey would help the trial Judge as he may not be familiar with the public perception of the shape of London taxis, or the reaction of tourists to the taxis. The Claimant also felt that the considerations below must be taken into account:

1. *Interflora 1* and *Interflora 2* were trade mark cases – the legal test in a passing off case is different.
2. Surveys are typically undertaken by claimants, therefore any proposal that the defendants might conduct a survey should be discounted when undertaking the cost-benefit analysis.
3. The practices complained of in *Interflora 1* (witness collection programmes) and *Interflora 2* (failure to rely on the raw data of answers) were avoided.
4. There are cases showing properly conducted surveys can be of real value: *D Jacobson & Sons v Globe Ltd*; *Numatic International v Qualtex*; *Enterprise v Europcar* (costs).

DECISION

The Deputy Judge found that the survey failed both the real value test

and the cost-benefit test, and so rejected the application.

In particular, the Deputy Judge was, "not persuaded that there is anything that is likely to be unfamiliar or not readily understandable to the trial Judge in the present case such as would tend to suggest that he or she is likely to need, or derive assistance from the admission of, the results of the pilot survey, the results of a full survey, or the evidence derived from either of those surveys".

This case further confirms that surveys and evidence obtained from surveys are unlikely to be relevant to the case, unless there are exceptional circumstances in which the Court requires further assistance.

The survey images



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Historic diary deemed descriptive

A famed work fell on the wrong side of standard tests, says Katherine Thompson

The Applicant, Anne Frank-Fonds, applied for the marks THE DIARY OF A YOUNG GIRL and THE DIARY OF ANNE FRANK in relation to a range of content carriers and guided tours in classes 9, 16, 39 and 41. Both applications were refused by the Hearing Officer under Sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994, who found that the marks lacked both inherent and acquired distinctiveness. The Applicant appealed to the Appointed Person (AP), who upheld the Hearing Officer's decision. The decision shows the difficulty of demonstrating that consumers perceive titles as indicators of origin rather than as descriptive of a work's subject matter.

INITIAL REFUSAL

The marks were initially refused on the basis that they are descriptive of the theme or subject of a book or film and, as such, they designate a "characteristic" of the goods. While the Applicant argued that a title can serve both to indicate subject matter and to convey origin, the AP held that the descriptive meaning remains and the title is therefore descriptive. The decision recognises that there should be moderating factors to prevent the excessively broad application of the distinctiveness objection, but takes the view that when the standard tests from the existing case law were applied, these marks fell on the wrong side of the line.

ACQUIRED DISTINCTIVENESS

The Applicant submitted evidence of the huge number of adaptations and

reproductions of Anne Frank's diary sold in the UK since 1952. It was recognised that it is one of the most widely read books in the world. All reproductions were produced under licence from the copyright holder (the Applicant). Generally, reproductions of the work identified the Applicant by name (Anne Frank-Fonds) as the owner of copyright in the licensed works.

However, they did not in any way indicate that they were made under the imprimatur of the Applicant in a way which would have constituted trade mark use. The different entities producing and marketing these reproductions did so under their own trade marks.

It was held that there was no trade mark use of "Anne Frank-Fonds" and no trade mark use of the titles, which were seen as indicating subject matter, not origin. As such, there was no use of the marks in a way which could contribute to the marks acquiring distinctiveness.

COMMENT

The decision is clear that the marks were not refused as part of a blanket ban on the registration of book or film titles. Each application is to be considered on its own merits and the same criteria applied in each case.

There was no use of the marks in a way which could contribute to the marks acquiring distinctiveness

This decision highlights the importance not only of appropriately controlling and licensing IP, but also of indicating this to consumers. Despite the huge number of licensed reproductions on which the work's fame rests, the decision takes the view that the single source of these reproductions (for copyright purposes) was not appropriately indicated to consumers (for trade mark purposes).

Parties that own the rights to titles that they consider to be brands may wish to ensure that their use of these titles is perceived as "brand use" in order to educate their customers. Maintaining control over how licensees reproduce these works, adding trade mark notices and "TM" symbols, together with ensuring that use is qualitatively "brand use", may help avoid similar issues.



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Nightmare for Dreams

Nicole Giblin explains why the retailer failed to prevent registration of third-party trade mark

In May 2013, Pure Imports Limited (“Pure”) filed a UK Trade Mark application for the mark shown below right in class 35. The application covered a range of retail services for the sale of beds and mattresses.

The application was opposed by Dreams Limited (“Dreams”) under Section 5(2)(b) of the Trade Marks Act 1994, based on its earlier Community Trade Mark (CTM) registrations for DREAMS (plain word) and DREAMS (stylised). Both marks were registered in class 35 for retail services for the sale of bedroom furniture, including beds and mattresses.

In a decision dated 22 October 2014, the Hearing Officer dismissed the opposition, finding that the marks were dissimilar and that there was no risk of direct or indirect confusion. Dreams appealed the decision to the Appointed Person (AP).

APPEAL

Dreams’ grounds of appeal focused primarily on the Hearing Officer’s apparent failure to consider the effect of imperfect recollection and that the Hearing Officer had not properly assessed the visual similarities of the trade marks – namely the inclusion of the word DREAM in each mark.

Dreams also argued that the Hearing Officer was wrong to ignore settled case law that the word element of a composite trade mark is generally given more weight than any figurative elements. In particular, Dreams challenged the Hearing Officer’s finding that the word and figurative elements of Pure’s mark were equally prominent. This was coupled with comments that the

rejection of the concept of initial interest confusion was flawed.

DECISION

On 2 July 2015, the AP upheld the Hearing Officer’s initial opposition decision, which was found to contain no material error of principle such that the Hearing Officer was entitled to find in favour of Pure.

The decision’s key points are:

- The Hearing Officer was correct to find that the three words within Pure’s mark comprise a “complete phrase” and that the word DREAM does not form an independent distinctive role. Dreams was criticised for “salami slicing” Pure’s mark in order to find similarity.
- Even though Dreams had used the dark blue background colour against the word DREAMS for some time, there was no material evidence to show that the public had come to associate the dark blue colour with Dreams alone. As such, it was irrelevant that Pure’s mark also contained a dark blue background.
- The Hearing Officer was correct to consider the marks as a whole and not to give any greater weight to the words than to the figurative elements. In this case, the figurative elements were “roughly equal” to the word elements.
- The Hearing Officer was entitled to find that the word DREAMS is not the “most striking” of words used in relation to the sale of beds and that the average consumer would not be surprised to

find different undertakings using DREAM or DREAMS.

- Regarding initial interest confusion, this was acknowledged as being a highly controversial doctrine, and that in light of the observations in *Interflora v Marks & Spencer* [2014] EWCA Civ 1403, it had no role to play in the present matter. The Hearing Officer had therefore been correct to find that there was “not even a fleeting aspect of confusion” which would support a finding of initial interest confusion.

AUTHOR VIEW

The decision will be somewhat disappointing to Dreams. Although the services were identical and the later mark contained the word DREAM, Dreams’ rights may now be difficult to enforce against parties who use or apply for composite marks containing several word and figurative elements.

The Pure mark



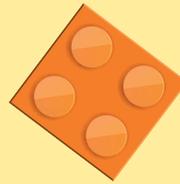
The Dreams stylised mark



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Lego figure finds favour

Luxembourg decides that Lego's "manikin" shape CTM is valid, reports Rebecca Costen

Lego Juris A/S has a Community Trade Mark (CTM) registered for goods in class 28 (which includes playthings) for the three-dimensional "manikin" figure (no. 50450, "the Mark").

Best-Lock (Europe) Ltd sought declarations of invalidity of the Mark for the above goods, on grounds including the shape exclusions under Article 7(1)(e) of Council Regulation (EC) No 207/2009. OHIM rejected Best-Lock's applications. Best-Lock appealed and on 16 June 2015 the General Court returned its decision, which supported OHIM's conclusions.

Best-Lock submitted that, as prohibited by Article 7(1)(e), the Mark consisted exclusively of: (i) the shape resulting from the nature of the goods themselves (the "First Ground"); and (ii) the shape of the goods necessary to obtain a technical result (the "Second Ground"). On both grounds, Best-Lock failed to provide arguments to demonstrate that the Board of Appeal's rejection of its assertions were incorrect.

THE FIRST GROUND

The General Court held that Best-Lock's submissions were inadmissible because it had failed to adduce sufficient evidence to support its assertions. Pursuant to Article 21 of the Statute of the Court of Justice of the EU and Article 44(1)(c) of the Rules of Procedure of the General Court, an application must state the subject matter of the proceedings and a summary of the pleas of law on which the application is based. Applications must be sufficiently

clear and precise to enable a defendant to prepare its defence and the court to rule on the application. The General Court held that general reference to other documents, even those annexed to Best-Lock's application, cannot be a substitute for the essential legal arguments, which must appear in the application.

THE SECOND GROUND

The General Court held that the terms "exclusively" and "necessary" in Article 7(1)(e)(ii) prohibit the registration of shapes that only incorporate a technical solution, and whose registration would therefore impede the use of that technical solution by other undertakings. To succeed on Article 7(1)(e)(ii) all of the essential characteristics of the shape must perform a technical function. The presence of non-essential characteristics with no technical function was irrelevant. In this case, the head, body, arms and legs gave the "manikin" its human appearance and were the Mark's essential characteristics. These characteristics simply conferred human traits enabling the "manikin" to be used as a plaything, but did not provide a technical function.

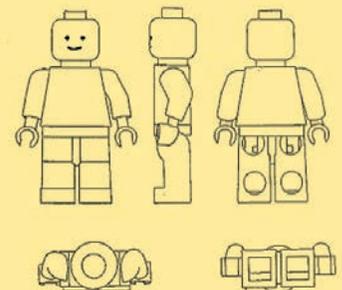
The graphical representation of the hands, the protrusion on the head

and the holes under the feet did not constitute "essential characteristics". Therefore, whether they served any technical function or not was irrelevant, and Best-Lock's challenge under Article 7(1)(e)(ii) failed.

Submissions that the Mark was devoid of any distinctive character under Article 7(1)(b) and that it had been registered in bad faith also failed.

This case is a good reminder that applications in European proceedings must fully explain the arguments and evidence being adduced. It should not be assumed the arguments and evidence submitted at earlier stages of proceedings have been, or will be, considered.

The Lego shape mark



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Rebecca specialises in contentious IP matters, with particular focus on trade marks, copyright and brand protection.

Need for caution is highlighted

Inclusion of a registered mark may be deemed confusing, warns Amy Galloway

On 2 December 2011, Infocit – Prestação de Serviços, Comércio Geral e Indústria, Lda (“Infocit”) filed a Community Trade Mark (CTM) application for DINKOOL in a range of classes including 1, 2, 3 and 16. Deutsches Institut für Normung eV (“DIN”) opposed on the basis of its International trade mark (shown below, right), which designates various European Member States, registered in classes 1 to 34, under Article 8(1)(b) and (4) of Council Regulation (EC) No 207/2009 (CTMR). The opposition was rejected and upon appeal, on the basis of Article 8(1)(b) CTMR only, the decision was annulled and Infocit’s CTM refused. Infocit appealed to the General Court to overturn the Board of Appeal’s decision. The General Court dismissed Infocit’s arguments and maintained the decision to refuse the application.

Infocit had argued that there was a lack of genuine use by DIN, as the mark was used only to certify the goods, but this argument was ruled inadmissible as Infocit had not raised it before the earlier tribunals.

KEY CONSIDERATIONS

Addressing the issue of the likelihood of confusion, the Court held that the relevant public was Germany and, due to the technical nature of the goods, the general public’s level of attention was higher than normal.

The Court found the signs to be visually similar. Any dissimilarities between the marks (such as the additional letters KOOL) were not striking enough to distinguish the

signs. The Court explained that the public was likely to give more importance to the first part of the word – DIN – which is the common element in both signs.

In terms of phonetic similarity, the Court ruled that, given the slight difference in rhythm and intonation, there was a limited degree of phonetic similarity.

In relation to conceptual similarity, the Court explained that even though consumers normally view the mark as a whole, when perceiving a word mark the consumer would break it down into word elements that have specific meaning or resemble known words. The relevant public in Germany would either identify DINKOOL as a fantasy word or associate the element DIN with the activities of the company DIN, and KOOL as a misspelling of “cool”. Contrary to the view of the Board of Appeal, the Court stated that there was conceptual similarity of the signs in the second case, where the consumer would break down the mark, but not in the first case.

Infocit had argued that the decision by the Court would mean that signs containing DIN, such as dingo, would be regarded as similar to the earlier mark. This argument was rejected as the word dingo does have a meaning in German.

There was identity and similarity in the goods of the respective marks, similarity of the signs, and therefore a likelihood of confusion

The Court ruled that there was identity and similarity in the goods of the respective marks, similarity of the signs, and therefore a likelihood of confusion between the marks.

LESSON

This case shows how cautious applicants should be if they wish to incorporate into their sign the entirety of an earlier registered trade mark. As this case has shown, it is not inconceivable for there to be a finding of a likelihood of confusion, even if the suffix of the marks would tend to emphasise their respective dissimilarity.

The International registration



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Any provides advice on trade mark, design and domain name matters for a wide range of national and international clients in various industry sectors.

Court recognises MB intention

Commercial success wasn't necessary for genuine use, says Tom Nener

On 19 February 2007, TVR Italia filed an application to register a Community Trade Mark (CTM) for the trade mark below, right.

The application was made on the basis that TVR Italia claimed that it was the successor to the business of the then-defunct British sports-car manufacturer. On 25 April 2008, Muadib Beteiligung GmbH (MB) filed a notice of opposition based on: (1) the earlier Community word mark "TVR", registered on 14 April 1998, covering "motor cars and parts and fitting therefor" in class 12, and (2) the earlier word mark "TVR", registered in the UK on 27 February 2004, covering goods and services in classes 9, 11, 25 and 41.

MB was the true successor of the business of the British sports-car manufacturer, and TVR Italia demanded evidence of use of the

earlier trade marks. On 21 September 2010, the Opposition division partially upheld and partially rejected the opposition. Importantly, it was held that MB had produced evidence of genuine use of the earlier Community word mark in respect of "sports cars and parts and fitting therefor" (the important categories).

TVR Italia filed a notice of appeal with OHIM and filed an application with OHIM for revocation of the earlier CTM on the basis of non-use in respect of all goods in class 12. The Cancellation division rejected the application for revocation on the grounds that MB had furnished genuine proof of the use of the earlier trade mark. But the OHIM Board of Appeal dismissed the opposition on the grounds of non-use of MB's earlier CTM, which led MB's trade mark rights successor, TVR Automotive, to appeal to the General Court.

TVR APPEAL

The General Court allowed TVR Automotive's appeal against the OHIM Board of Appeal decision and found the following:

1. The Board of Appeal was not entitled to conclude that the opposition had to be rejected on the basis of insufficient use of the earlier UK trade mark and it was right to restrict its analysis to proof of use of the earlier CTM;

2. It rejected the claim that the Board of Appeal should have taken into account the ruling of the Cancellation division that found there had been genuine use. Revocation and opposition are different procedures and the subject matter is not identical. For instance, the five-year periods in respect of which genuine use is assessed under each procedure may be different depending on filing dates.
3. There had been genuine use, despite MB having financial difficulties during the relevant period of use and, despite its lack of actual sales, the evidence did demonstrate that MB had wanted to create and preserve an outlet for the goods and services in its CTM.

CONCLUSION

The case is a useful reminder that when assessing genuine use, commercial success is not the only factor relevant and the Court will look beyond sales figures to infer that a party intends to maintain its market share held in the CTM.

The TVR Italia mark



The evidence did demonstrate that MB had wanted to create and preserve an outlet for the goods and services in its CTM



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NEWS FROM NOMINET

► A SPIRITED FIGHT LEADS
OFF SUSAN PAYNE'S
ROUND-UP OF RECENT
ONLINE LESSONS FOR
RIGHTS HOLDERS ■

UKS UPDATE

We all know that it is vital as a brand owner to maintain strict control over your IP, but it bears repeating. The first two cases in our round-up of recent decisions highlight the challenges encountered by a complainant in seeking to recover domain names where a former business connection has broken down and the domain ownership was not properly addressed at the outset.

IN GOOD SPIRITS

The first, Northumbria Spirit Ltd v Andrew Haddon (D00015178), concerned the name northumbriaspirit.co.uk. Drinks company Northumbria Spirit ("NSL") was formed by three shareholders including Andrew Haddon ("Haddon"), the Respondent in the case. Shortly prior to the incorporation of NSL, Haddon registered the Domain Name, and subsequently paid for all renewals. This was then used for the operation of NSL's website until August 2009, when a trade mark dispute with a third party led NSL to adopt an alternative address. From this point on, the Domain Name redirected to the new website address.

After a falling-out among the shareholders, Haddon left the company. Given the nature of the underlying dispute between the parties, there were complex and disputed questions of fact. These



It is not automatically unfair for a reseller of genuine goods to incorporate a trade mark into a domain name

included the basis of the original registration of the Domain Name and whether it was assumed by the parties that it belonged to NSL or to Haddon. While the Expert was somewhat sceptical of Haddon's claims, he considered it outside of his remit to resolve such complex issues of fact and decided he must assume that Haddon's explanation was true.

It was not disputed that, as between the parties, NSL had rights in relation to the "Northumbria Spirit" name. The case therefore turned upon whether there was an Abusive Registration. The Expert concluded there was not, because:

- It could not be said that the original registration took unfair advantage or was unfairly detrimental to NSL, since it had always been used for the benefit of that business.
- NSL argued that Haddon was threatening to use the Domain Name for a new project, which would be detrimental. While there could clearly be cases where such a change of use would be so unwarranted and prejudicial as to amount to unfair advantage or unfair detriment, the Expert concluded that this was not such a case: the word "spirit" had multiple connotations, and NSL could itself only use the Domain Name in a very limited manner due to the trade mark issue.

UNFAIR TO OLFA?

The second case concerned the domain name *olfa.co.uk* (OLFA Corporation v Absolutely Shaw Limited D00015258). Olfa is a Japanese manufacturer of utility knives, and owns a number of registered trade marks for its long-standing OLFA brand. Absolutely Shaw Ltd (ASL) was its UK distributor

between 2002 and 2004 and registered the Domain Name in June 2004, apparently with the agreement of Olfa. At the end of the relationship, ASL attempted to sell the Domain Name, outstanding stock and customer records to Olfa, but no deal was concluded. It continued to use the Domain Name to sell genuine Olfa products sourced from other distributors and no complaint was made by Olfa until 2012. The question for the Expert was whether this was an Abusive Registration, likely to confuse people or businesses into believing the Domain Name was registered to and used by Olfa or a commercial connection. In finding for ASL, the Expert considered the following:

- It is not automatically unfair for a reseller of genuine goods to incorporate a trade mark into a domain name. If the use of the domain name falsely implies a commercial connection to the complainant, or if a competitor's goods are being sold, these factors would favour a finding of Abusiveness. However, it is a multifactorial assessment, requiring the conduct of both parties to be taken into account.
- Without countervailing factors, the Expert might have found the use Abusive. However, they had been in a proper commercial relationship and, while the Respondent was trying to secure payment for the Domain Name in excess of out-of-pocket expenses, it was not primarily acquired for this purpose.
- The parties had made no provisions for what would happen to the Domain Name upon termination of the relationship. It was not reasonable in

this case to argue that it should be transferred when Olfa had allowed ASL to use the Domain Name for eight years without objection, and waited a further two years to actually bring proceedings, without any explanation for the delay.

DELAY ALWAYS FATAL?

Although delay was a crucial factor in Olfa, it need not always be. *Lucasfilm Ltd., LLC v ABSCISSA.COM Ltd* (D00015788) concerned various Star Wars Domain Names, including in particular, *starwars.co.uk* and *starwars.uk*. The *.co.uk* name was registered in January 2003 (and assigned to ABSCISSA in 2005). ABSCISSA had also owned another name since March 2003 (together, the 2003 Names), and acquired the matching *.uk* names in July 2014 when Nominet introduced such names, by virtue of its priority based on the 2003 Names. At the same time it registered a selection of other *.co.uk* and *.uk* names (the 2014 Names).

The Domain Names were used to redirect to ABSCISSA's Jokers' Masquerade website at *jokes.co.uk* where it sold fancy dress costumes, including genuine Star Wars costumes. Lucasfilm's complaint therefore covered some registrations that were more than 10 years old.

In considering whether the Domain Names were Abusive Registrations, the Expert concluded:

- As mentioned above, where the registrant is a reseller of genuine goods this will not automatically be an unfair registration but it depends on the facts. The Expert considered it highly likely, however, that any user searching for



A case concerning a generic, dictionary term would require a higher standard of argument and evidence than is common

Star Wars and arriving at ABSCISSA's website would have suffered initial interest confusion and falsely inferred a commercial connection to Lucasfilm.

- As established in *Emirates v Michael Toth* (D08634), delay alone is not a ground on which a Complaint may be denied. In this case, since the delay was not prejudicial to the proper consideration of the issues, it was not fatal to a finding that each registration was Abusive and should be transferred.

Based on the decisions alone, it is somewhat difficult to see why consumers reaching the ABSCISSA website, *jokes.co.uk*, would falsely infer a commercial connection, whereas visitors to *olfa.co.uk* in the previous case would not. A finding of Abusiveness is a question of all the facts in each case, as perceived by the Expert, however, and no doubt includes the distinctiveness and fame of the trade mark, whether there are any additional factors which suggest an intent to take advantage of the brand (such as perhaps registering the 2014 Names after having received Lucasfilm's letter and threatening to revamp the website in readiness for the new Star Wars film) and generally how believable both sides' evidence is.

In terms of the delay, while not mentioned in the decision, presumably a key difference to the *Olfa* case is that there had never been any commercial connection between the parties and thus it was not a clear case of Lucasfilm having knowingly ignored the registration for all this time. Nevertheless this seems a harsh ruling for ABSCISSA, which has been using the 2003 Domain Names for 10 years and sells genuine merchandise. Not surprisingly, this decision is, at the time of writing, the subject of an appeal.

MANGO MISSTEP

Finally, a reminder of the pitfalls of assuming that the fame of your trade mark is self-evident and not getting your case in order. In *Consolidated Artists B.V. v Mr Garth Piesse* (D00015585), the owner of the MANGO clothing brand not only did not get the Domain Names *mango.co.uk* and *mango.uk* assigned to it, but the panellist found the owner guilty of reverse domain name hijacking.

While Consolidated has a number of trade mark registrations and numerous domain names containing the MANGO brand, it submitted relatively little evidence to substantiate its use and goodwill in the name, just some examples of advertising campaigns without dates or target territories and a printout of some Google search results from 2015, two years after the Domain Name registration. Consolidated also alleged that Piesse's registration of 18,000 domain names demonstrated a pattern of improper registrations, but without going the further step of identifying any which correspond to well-known brands.

In making his finding, the Expert held:

- A case concerning a clearly generic, dictionary term would require a higher standard of argument and evidence than is perhaps common. Consolidated had not put forward anywhere near

sufficient or persuasive evidence to show that the term MANGO has acquired a strong secondary meaning or that the Domain Names could have been registered to target it or its rights.

- It is commonly known in the domain name industry that generic, dictionary words tend to have a high value irrespective of any potential secondary meaning. Registrants of such domain names are under no obligation to sell, or even enter into negotiations. Should they choose to do so, they are entitled to start negotiations at any price they wish. Mere negotiations to sell a domain name consisting of a generic, dictionary word are not and should not be indicative of an Abusive Registration.
- Based on the lack of evidence, the conclusion is that Consolidated brought a speculative complaint in bad faith in an attempt to deprive Piesse of the Domain Names. This justified the finding of reverse domain name hijacking.

This is one of only a handful of Nominet cases to result in such a finding. Although reverse domain name hijacking does not carry an immediate penalty, if a complainant is found on three separate occasions within a two-year period to have brought such a complaint in bad faith, this would bar it from any further complaints for a period of two years. And, of course, there is the bad publicity such a finding brings.



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events

More details can be found at itma.org.uk

Date	Event	Location	CPD hours
20 October	ITMA London Evening Meeting* OHIM Case Law Update	Royal College of Surgeons, London	1
22 October	ITMA CPD Webinar The NOW case		1
29 October	ITMA Scottish networking drinks reception	The Western Club, Glasgow	
29 October	ITMA Trade Mark Administrators' Afternoon Seminar Behind the scenes at the UK IPO	Marks & Clerk LLP, London	
12 November	ITMA Scottish Evening Meeting Discussion of recent OHIM cases	Brodies LLP, Edinburgh	1
13 November	ITMA & APTMA Day Seminar and Dinner The Irish Perspective	Hilton Dublin (seminar) and Drury Buildings (dinner)	4-5
24 November	ITMA London Evening Meeting* CJEU and General Court Decisions – 2015	Royal College of Surgeons, London	1
7 December	New Members Induction Day	CIPA, London	
11 December	ITMA Christmas Lunch**	London Hilton on Park Lane	
16-18 March (2016)	ITMA Spring Conference History & Heritage	One Whitehall Place, London	9
17 March	ITMA Gala Dinner (part of the Spring Conference)	Tower of London, London EC3	



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I work as... a Senior Associate within the trade mark department at Keltie LLP.

Before this role... I was a student at the University of Birmingham. I joined Keltie straight out of university and before I had my results (which was nerve-wracking, because if I didn't get my predicted results, I might not have had a job), and started training for the foundation and advanced trade mark exams.

I became interested in IP when... my grandpa, Gerald Holdcroft, now a retired Patent and Trade Mark Attorney (and also an ITMA member), first introduced me to it. I also studied IP in my law degree at university, which further increased my interest.

I am most inspired by... my grandpa, both professionally and personally.

In my role, I most enjoy... the variety of work and clients, from established portfolios to new start-ups.

In my role, I most dislike... paperwork – which is handy, as we are now paper light!

On my desk is... an organised mess.

My favourite mug... is the obligatory huge Sports Direct mug we have in the office. Although I don't drink tea or coffee, it holds a lot, which I've been told is a good thing!



Ordinary Member
Charlotte Blakey
explains her family
connection to IP

My favourite place I have visited on business is... Vienna.

If I were a trade mark or brand, I would be... Cadbury, so I could have all the best chocolates!

The biggest challenge for IP is... educating clients (or potential clients) as to its importance in business. More often than not, clients discover this only when a problem arises and needs fixing.

The talent I wish I had is... to be able to play the drums, like my dad – who can pick up any instrument and play it!

My current state of mind is... excited. I've got a wedding to plan for in February. That said, being used to daily deadlines at work is quite handy for organising a wedding!

I can't live without... the biscuit drawer at work. Oh, and my husband-to-be.

My ideal day would include... a barbecue at home with friends and family. In our house, we've been known to start the barbecue season as early as March and finish as late as October.

In my handbag are... endless amounts of extremely important items, which never seem to be the item I actually need.

The best piece of advice I've been given is... to just be yourself – don't try to be anyone else. And try not to talk about yourself too much.

When I want to relax I... listen to music and pour myself a glass of wine (or three).

In the next five years I hope to... tick a few more countries off the "must see" list.

The best thing about being a member of ITMA is... the free *ITMA Review*, of course.

If you'd like to appear in TM20, contact caitlin@thinkpublishing.co.uk

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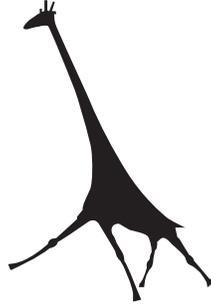
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