

CITMA REVIEW

ISSUE 430

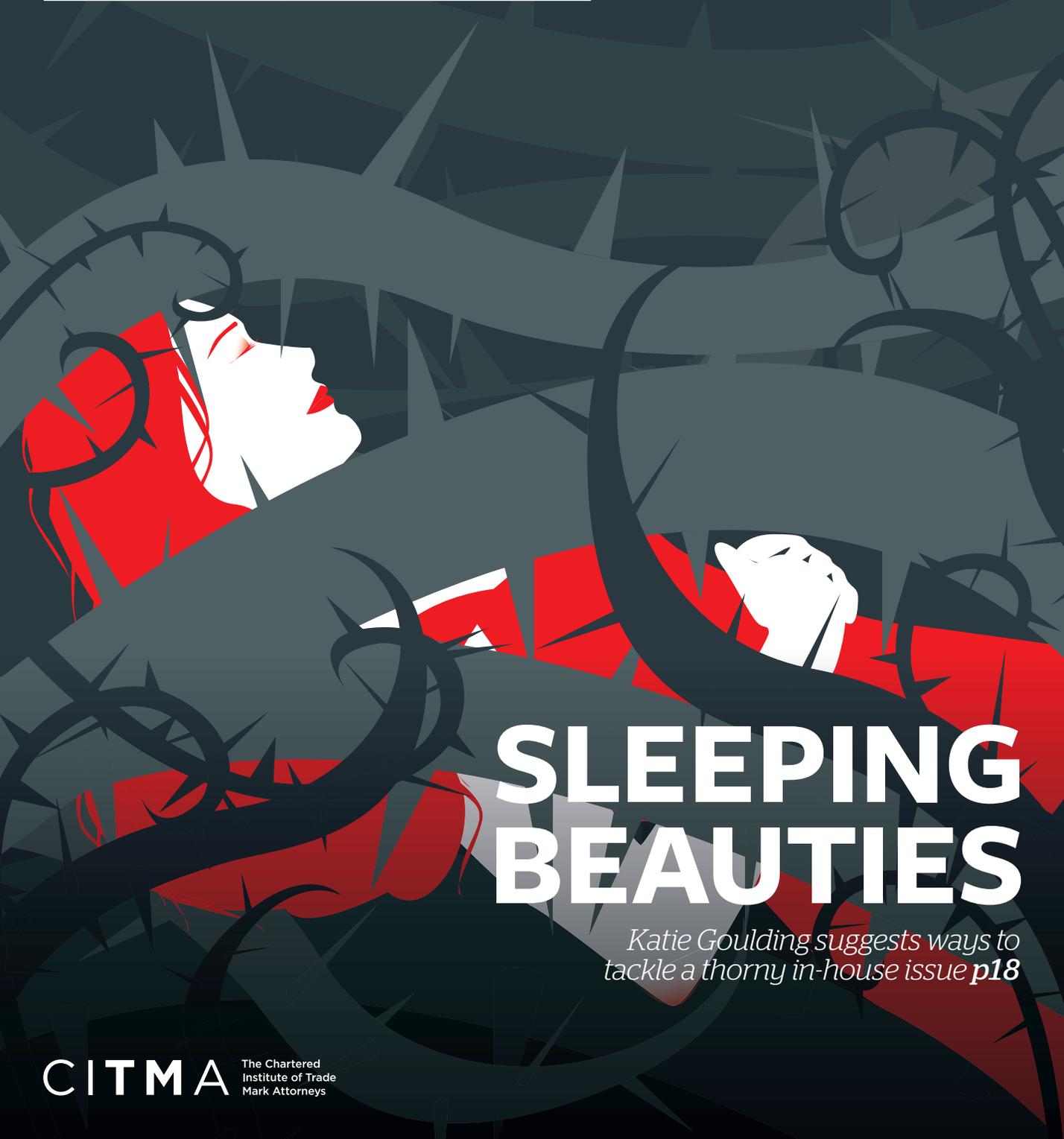
DECEMBER 2016/JANUARY 2017

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The approach of the end of the year is always a good time to reflect on its developments – and 2016 has certainly been a tumultuous one. We had to start planning for the consequences of the UK voting to exit the EU, we helped launch the IP Pro Bono programme and, of course, we celebrated the grant of our Royal Charter.

All of these involved teamwork, not only within CITMA, but across the IP community – and this is, I believe, the message for the future: we are always stronger when we work together and when we are outward looking. This edition of the *CITMA Review* highlights the many varied issues of interest to members both internationally and locally – from new technologies to traditional symbols to designs – and should keep us all entertained over the holiday season, which I hope is happy and peaceful for you all.

Kate O'Rourke

Kate O'Rourke
CITMA President

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CITMA Review

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CITMA | INSIDER

Act fast on renewals

CITMA membership certificate and badge



With membership of CITMA, you have the opportunity to be part of a brand new era for our profession. The grant of a Royal Charter recognises that, since 1934, CITMA has been fighting to bring recognition to the work you do. We also feed your enthusiasm for the profession through regular conferences and events, professional development courses and the *CITMA Review*.

As part of our launch as a chartered organisation, we will be issuing all members with a CITMA membership certificate and an exclusive pin badge.

You should have received important information about your CITMA membership recently, including how to pay to ensure you remain a member. Contact Gavin at the CITMA office with any questions about membership: gavin@citma.org.uk

Email filing is now an option

THE UK IPO has announced an enhancement to the filing system for international trade mark applications.

Following feedback from customers and the help of a number of UK attorneys, in April 2016, the UK IPO trialled the use of email for the submission of international trade mark applications. The trial was a success, and the email-enabled application system was made available to all users from 26 September 2016.

International trade mark applications can now be emailed to the UK IPO at internationaltrademarks@ipo.gov.uk

Please note the following UK IPO guidance:

- Use of the UK IPO version of the MM2 application form is encouraged.
- The MM17/MM18 forms will be accepted if filed with the MM2.
- No other forms or correspondence should be emailed to the above address.

An updated version of the UK IPO's form MM2 can be found at gov.uk in the publications section

CITMA abroad

In October, CITMA Vice-President Tania Clark addressed the American Intellectual Property Law Association Conference in Washington, DC. In November, CITMA President Kate O'Rourke MBE visited India. Brexit was a hot topic at these events, and "business as usual" was the key message.

Brexit tools available



CITMA has created a deck of PowerPoint slides to assist members speaking at events, or internally, about Brexit. By communicating a consistent and common message, we can reinforce the effort to ensure that concerns over the UK's exit from the EU are minimised.

The slides cover the broad details and can be used as a guide for key messaging. They will be continually updated to ensure they stay in line with the latest developments. Download the slides at citma.org.uk

Member *moves*



Redd Solicitors LLP has announced the promotions of **John Colbourn** to Associate Director and **Michael Browne** to Partner.



Elkington and Fife has announced that **Viktoria Vkratsa** joined the firm as a Trainee Trade Mark Attorney in October. Viktoria is based at the firm's London office. Contact her at viktoria.vkratsa@elkfife.com or by calling +44 (0)20 7936 8800.

Merger creates Maucher Jenkins

RGC Jenkins & Co in the UK and Maucher Börjes Jenkins in Germany have combined to become Maucher Jenkins. The combined firm's offices are located in Basel, Beijing, Farnham, Freiburg, London and Munich.

Benevolent Fund silent auction result

Our first ever silent auction helped raise more than £3,000 for the ITMA Benevolent Fund. Fifteen items, ranging from a helicopter ride across London to unique culinary experiences and tickets to the ATP Tour tennis finals, were won by members, helping to raise money for the Benevolent Fund in the process.

In total, £3,012 was raised, including £1,662 from the highest bids for the lots and £1,350 in kind donations.

The lots were donated by members and their firms. The Benevolent Fund's trustees would like to thank everyone who contributed so generously.

The Benevolent Fund is a registered charity set up to provide financial assistance to any member in real financial distress. Visit citma.org.uk for more information.



Reader book review

Economic Approaches to Intellectual Property provides a chance to step out of the legal "silo", suggests Aaron Wood

THIS BOOK IS split into three sections. In the first, readers are introduced to economic theories generally, and the major theories regarding the economic benefits of IP. In the second, the various IP rights are considered against those theories. In the third, the question of how IP adds value is considered (including valuation methods).

In its 300 pages, *Economic Approaches to Intellectual Property* does not delve so deep into the subjects as to be inaccessible to those without an economic background. In fact, a reader could dive into the later sections without reading the "primer" in the initial part.

A significant portion of the book examines patents and copyright. The value and the deleterious effects of patents and copyright are the subject of popular dispute. The tension between the opposing sides of this debate provides a rich seam, which this book mines.

For those only interested in trade marks and designs, there is perhaps too little content on the

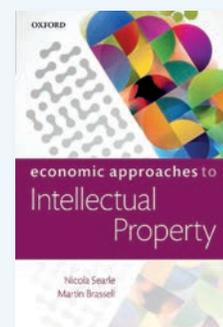
economics of these particular rights. This can be explained by the view that trade marks do not easily fit into the "innovation" model ascribed to the other rights.

Taken as a whole, however, this book provides a good overall picture of IP protection and the rationale behind these rights. Given that a range of governmental and intergovernmental agencies review economic data as part of their consideration of legislative changes, understanding the state of economic data and the broader policy issues is important to members who wish to understand the "direction of travel" of IP law and rules.

In looking at the broader issues, this book also provides a theoretical basis for practitioners to consider the likely commercial effect of advice and action (including how it may be perceived if "leaked" by the other party). As practitioners, the risk is that we become siloed in only considering the purely legal – this book goes some way towards addressing that trend.

Economic Approaches to Intellectual Property, Nicola Searle and Martin Brassell, Oxford University Press (June 2016)

Paperback, 300 pages; also available as an ebook ▼





The end of the unrepresented?

CITMA President Kate O'Rourke is proud that the profession has stepped forward to support the UK's smallest businesses

I was delighted to be involved in the establishment of IP Pro Bono, which was launched on 17 October. The scheme offers free legal advice and support to trade mark, design, patent and copyright holders in legal disputes.

As we all know, it is crucial that individuals and small businesses have access to representation in IP disputes. Unfortunately, many have ended up representing themselves as litigants in person because they cannot afford the professional support they need, sometimes with unfortunate outcomes.

CHALLENGE SET

IP Pro Bono resulted from a challenge set to IP legal-services providers by His Honour Judge Richard Hacon, Presiding Judge of the Intellectual Property Enterprise Court. He proposed that they come forward to offer advice and support to unrepresented claimants and defendants in IP disputes.

At the launch event, we heard from British entrepreneur Mandy Haberman, best known for the Anywayup Cup, about how important representation during IP disputes was in the early days of her own journey. For any entrepreneur with limited funds and everything at stake, an IP infringement could spell the end of the road at a very early point. Those in this position are just the kind of people IP Pro Bono seeks to assist. I will be looking forward to seeing the benefit it brings to small-business owners and individuals like Mandy.

It was also a pleasure to see Sean Dennehey, Acting Chief Executive of the UK IPO, and Hacon J, who spoke at the launch event, supporting the scheme.

COLLABORATIVE ACTION

IP Pro Bono is a collaboration between a number of leading IP organisations. I would particularly like to thank CIPA, the Intellectual Property Lawyers' Association (IPLA) and the Law Society for all they have done to enable the project.

The professional representatives offering the legal advice are CITMA and CIPA members, and IP solicitors, and I am grateful to all of them for giving up their time to assist. Without them, there would be no scheme.

WHO BENEFITS?

The service is generally available to support businesses with an annual turnover not exceeding £100,000, and individuals with an annual income of less than £45,000. A case officer will assess applications and, if the applicant meets the stated criteria, allocate the case to one of the participating firms on a rota basis.

The scheme is not able to support those looking for advice on filing and non-contentious matters. However, both CITMA and CIPA offer free clinics that will continue to provide advice on these issues.

More information about IP Pro Bono is available at ipprobono.org.uk, and I encourage all members to consider whether they may be able to assist, either as case officers or as representatives. Please use the contact form on the website to volunteer your services. Firms are also welcome to assist. ■



KATE O'ROURKE

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Trade Mark Attorney : Yorkshire

CEF48693

Leading IP Firm seeks a Part Qualified or Fully Qualified Trademark Attorney to join their high calibre team. Ideally you will hold experience of 18 months to 4 years in Trade Marks (pre or post qualification). You'll bring great service to exceptional clients in a growing team – this is a really rewarding position.

Trade Mark Attorney : London

CEF48012

Take the bull by the horns in a high profile team. The right Attorney for this role will enjoy a pro-active client facing role, and will be enthusiastic about promoting the profile of the team. A dynamic growing firm offering autonomy and real career progression awaits.

Trade Mark Entrepreneur : Scotland

CEF46316

Develop your career with an executive client portfolio in a fantastic growing firm. You'll be a qualified Attorney who can manage their own workload, and will thrive with the opportunity to develop the business with new and existing clients. Huge rewards await in this client focused role.

Trade Mark Administrator : London

TJB50259

European IP Pioneer seeks a diligent Trade Marks Administrator to thrive and develop in their London office. You'll assist the team and adopt duties including file administration, creation of new cases and filing of documents. IP experience is advantageous, but not essential.

Trade Mark Assistant : London

TJB20280

Wanted: An ambitious and professional Trade Mark Assistant to support a globally acclaimed law firm. You'll ideally hold prior experience, with a real desire to work in a challenging environment. Renewals and records will be your forte, and you'll be expected to maintain the integral trade mark database.

Trade Mark Docketing & Records : London

TJB50279

Make the next move in an international market leading law firm. Duties will include creating records, disputes, objections and oppositions. You'll be responsible for supervisory duties, so communicative and organisational skills are a necessity. Enjoy this challenging and rewarding role, in a firm that values its employees.

Trade Mark Attorney : South West

LKA49526

Well-respected firm, with an excellent reputation locally, nationally & internationally, looking for a client-oriented Attorney to contribute to all aspects of a busy, successful practice. You will enjoy offering clear & practical advice to the Firm's clients, with a defined career structure for those who are eager to demonstrate their potential for full Partnership, whilst enjoying a lucrative bonus structure along the way!

Trade Mark Paralegal : London

TJB50426

Internationally renowned IP leader seeks a Trade Marks guru to flourish as a Paralegal in their busy head office. You'll be responsible for supporting the Attorneys and liaising cross-departmentally, assisting the team with your Trade Marks knowledge. Find out more about this quality role today.

Trade Mark Paralegal : London

VAC50441

Respected boutique IP firm requires a sensational Paralegal to support their Trade Mark, Copyright and Designs function. Thrive in this award winning firm, and enjoy their impressive client portfolio, whilst learning from the best. If you hold the experience and tenacity to fit the bill, enquire today.

Newly Qualified Trade Mark Attorney : Manchester

VAC50594

Award winning Heavyweight IP firm seeks a tenacious newly qualified Trade Mark Attorney! Ideally you'll be newly qualified to 1 years PQE, with a real passion for development. High quality work, big name clients and an expert team of professionals await you – enquire now.

In-House Trade Mark Attorney/TM Lawyer : London

LKA50142

New opening for a Qualified Trade Mark Attorney/TM Lawyer to join an established In-House team. Reporting to a Senior Trade Mark Counsel, you will be able to manage a case-load relatively autonomously and enjoy working with a diverse group of IP and Legal professionals, being part of an ever-evolving, innovative, highly commercial business.

Trade Mark Attorney (Fixed Term Contract) : London

LKA49987

Opportunity for a qualified Trade Mark Attorney to join a friendly, boutique Media & Technology firm. Those applying will be a competent and skilled Trade Mark Attorney with the ability to work independently with minimal supervision, whilst still enjoying being part of a larger group environment. The firm offers a strong work-life balance without compromising the salary available.

Trade Mark Attorney/Assistant : London

LKA50573

Leading international law firm looking for a competent TMA to join their award winning team. Working with clients in world's most dynamic industries, you will enjoy high quality work in a cutting edge environment with ample opportunity to be proactively involved in marketing and business development. Competitive remuneration available.

Trade Mark Attorney : North West

LKA48347

Extremely impressive, successful and supportive regional Practice is keen to recruit a Qualified Trade Mark Attorney to take a lead role as part of their on-going growth plans. The appointed Attorney will enjoy building strong client relationships and be a creative, innovative marketeer. Excellent opportunity with genuine Partnership prospects.

For further information about this selection of opportunities or to discuss any other aspect of IP recruitment, please contact:

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Searching questions



The Class 46 blog selects the best of the discussion points at the latest Question the Judges session

The fifth annual Question the Trade Mark Judges session, organised by MARQUES and University College London's (UCL's) Institute of Brand and Innovation Law, again included a high-profile panel of judges: Paolo Catalozzi (Enterprise Court of Rome), the Hon Mr Justice Carr (English High Court), Oliver Morris (UK IPO Senior Hearing Officer) and Christopher Vajda (CJEU). Professor Sir Robin Jacob of UCL acted as chair for the session.

Here, we highlight the key discussion points and the judges' thoughts.

How do advocacy and the length of a hearing affect a case's outcome?

Catalozzi J noted that rhetorical skill alone will never win a case, although advocacy can play a role where there is no defined jurisprudence. As submissions in IP cases can be quite voluminous and a "burden" to review, Italian judges will indicate which issues to focus on, with hearings lasting from 10 minutes to an hour.

Vajda J opined that, based on the number of appeals filed by the UK Government, employing a highly reputed lawyer or barrister does not necessarily mean that you will win a case. Indeed, interjected Robin Jacob, parties tend to employ the most experienced lawyers in "hopeless cases". Vajda J explained that there is usually a long delay between the hearing and delivery of a decision at the CJEU, notably since complex cases will be sent to the Advocate General (AG), and the panel will only properly discuss the case once the AG's opinion is received. The discussion will most likely be based on that opinion, rather than the hearing notes. Hearing and written submission will be more important where there is no AG opinion.

At CJEU and General Court (GC) hearings, judges tend to ask specific questions to prevent counsel from repeating the content of written submissions. Since the questions concern legal rather than factual issues, hearings are usually limited to 15 minutes.

Mr Morris added that, while a good advocate is unlikely to win a bad case, a bad advocate may well lose a good one. Indeed, where a case is finely balanced, or where "the other side has less than average skills", advocacy skills are magnified.

Carr J confirmed that advocacy can matter, for example in marginal cases. Taking an extreme case where one side is not represented, if there is no voluntary representation scheme (such as the Chancery Bar Litigant in Person Support Scheme in the UK), and thus no "equality of arms", a lack of advocacy may affect the outcome in 15 to 20 per cent of cases.

On the question of whether hearings in UK courts are too long, Carr J explained the difference between a first-instance hearing, where facts need to be established, and appeal hearings, where 15 minutes will often suffice to discuss legal questions.

Mr Jacob addressed the lack of specialist IP judges at the European courts, given that more



The panellists agreed that there had been a shift from consumer protection to business protection

than 40 per cent of the cases heard at the GC are trade mark cases

Vajda J explained that, even though the number of GC judges has increased from 28 to 47 (each Member State sends two), and specialised judges with diverse backgrounds were desirable, this has not yet been achieved. Catalozzi J agreed on diversity; it would be beneficial if more judges had a litigation background, since experience gathered elsewhere, such as from the EU Commission, may not be transferable. Mr Jacob added that he had “seldom met anyone who did not think that poachers turned gamekeepers was not a good idea”. Carr J pointed out that some of the best Chancery trade mark cases had been decided by non-specialist judges, such as Lord Neuberger. However, this was not necessarily true for patents.

Following the “shape of a London taxi” case, do famous brand names add substantial value to the goods, and is this concept potentially destructive of trade marks?

Carr J agreed with the premise of the question. Nonetheless, taking it too far “will destroy the concept of trade marks”. He recalled the 1990s Philips/Remington case, in which he acted, where the three heads on the Philips shaver could have been regarded as adding substantial value. He helpfully illustrated the concept by referencing the shape of a cut diamond, where the cut adds value to the gemstone.

Mr Morris gently teased that the questioner had got the “wrong end of the stick”. As it was the intrinsic nature of the shape that was important, the changes in the EU Trade Mark Regulation would not make a material difference to

established practice. Because a brand name adds no value to the intrinsic nature of the goods, standard trade marks would not be affected, and iconic shapes, such as the Volkswagen Beetle, would still be protectable.

It was also necessary to disentangle the value

of a trade mark from the value of the shape and how it looks. However, Mr Morris “dodged” a valid audience question on how this rationale could logically apply to celebrity-name brands. Vajda J concluded that it was crucial to get the balance right, since trade mark protection can last forever.

Does trade mark law protect consumers or businesses?

The panellists agreed that, in the context of trade mark law, there had been a shift from consumer protection to business protection. Catalozzi J, in particular, had noted a shift towards business protection over the past 20 years.

Consumer protection, by guaranteeing the origin of a product, likelihood of confusion and distinctiveness, has morphed into protection for marks with a reputation without the need of confusion. Mr Morris found it to be a nuanced shift, since dilution/blurring cases still aim to protect the distinctive character of a mark and, ultimately, the consumer.

Carr J explained that tarnishment cases are essentially protecting the “acquired asset of a business”. There was an argument to limit tarnishment and blurring protection to cases where there was actual damage, ie where a brand was directly linked to something negative. Vajda J agreed that this was not a binary issue, mentioning Intel and parallel import cases, where business interests predominated over consumer interests. Finally, Mr Jacob highlighted the role of passing off/unfair competition, such as in the Colgate toothpaste case.

Are (UK) references to the CJEU a force for good, and will English stay a working language at EU courts?

Vajda J explained that preliminary referrals from national courts can be compared to court pleadings and should be phrased with care: complex sub-points within questions can overcomplicate things. He will miss the references from the UK post-Brexit, since they are typically a “model of clarity”.

Carr J added that references can be a force for good as well as a complicating factor. Referring courts should keep questions short, since they usually only had two potential answers. In Vajda J’s view, English will almost certainly remain a language of the EU courts post-Brexit; he noted that more than 90 per cent of those accessing cases via the Curia website read the English documentation.

Is it fair to consider trade marks, copyright and designs as “soft” IP law, and patents as “hard” IP?

None of the panellists agreed with this distinction, with Catalozzi J pointing out that copyright has an increasing importance. Mr Jacob added that copyright is the most financially valuable IP right.

Carr J preferred a potential distinction along the lines of “creative IP” versus “inventive/innovative IP”. Indeed, while trade mark law may look easy, its legal issues are more complex than those arising in a patent law context, “where there isn’t a great deal of change”. Mr Morris said trade mark cases had more of a legal impact, whereas factual findings in patent law were usually more complex, so that the differences cancelled each other out. Vajda J added light-heartedly that the EU legislator had been wise when allocating patent jurisdiction to another court. ■

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The authors are team members of the official MARQUES Class 46 blog on European Trade Marks. Birgit is also a member of the CITMA Review working group.



ITMA TALKS TECH

*Daniel Sullivan summarises the sessions
at our sold-out autumn gathering*



Left: delegates at the Hyatt Regency Birmingham hotel
Below: Susan Payne of Valideus demystifies domain names



In October, our Autumn Seminar returned to the Hyatt Regency Birmingham hotel for the seventh year, with delegates arriving the day after the Conservative Party conference had been held at the same venue. With a focus on the impact that advances in technology are having on the world of IP, the event included talks from IP practitioners from the UK and US, the UK IPO, as well as in-house representatives from several tech-based companies.

The seminar was opened by Alexandra Brodie of Gowling WLG, who gave an informative talk on the development of wearable technology and the challenges this presents to the legal sector. Brodie traced the evolution of wearable tech, taking us from the Casio calculator watch, so familiar in 1980s playgrounds, to 2016's Apple Watch Hermès. More pertinently, she also addressed the more recent trend of integrated clothing, a category that includes sports jerseys that monitor the wearer's cardiovascular activity (Under Armour) or yoga-pose positioning (We:eX); internet-connected jewellery (Misfit/Swarovski; and LED-fitted evening gowns (Disney/Studio XO).

Given the rapid pace of integration in the technology and fashion/sportswear sectors (Gartner predicts that 26 million wearable technology units will have shipped by the end of 2016 – up from 100,000 in 2014), it was easy to appreciate why Brodie considers that wearable technology could soon mean the end of the more traditional gadget.

In terms of what this means for IP practitioners, Brodie concluded that, when dealing with this new technology, it will no longer be possible to view issues from only a brands, patent or design perspective, and input and cooperation from practitioners in all these areas will be vital. For trade mark practitioners specifically, increased care will need to be taken when preparing specifications, and, as the development of these types of products is likely to involve collaboration between companies, it will be necessary at the outset to clearly define exactly what is owned by whom. This is likely to lead to a very different approach to licensing and, potentially, litigation.

Overall, the talk illuminated an expanding commercial area that may not have previously been considered by those in attendance, and provided a useful guide to addressing the challenges and opportunities it presents.

DOMAIN NAMES: PROTECTING RIGHTS

Matthew Harris of Waterfront Solicitors was joined by Susan Payne of Valideus and Victoria Baxter of King for a discussion of domain names and the options open to brand owners seeking to protect and enforce their trade marks online.

Harris's talk focused on remedies outside the traditional Uniform Domain-Name Dispute-Resolution Policy (UDRP) route to deal with online infringement and cyber-squatting. He confirmed that being

familiar with the rules about the particular domain before taking any action is vital, particularly in cases of the more exotic country code top-level domains. In cases in which obviously false contact information had been provided, contacting the administrative bodies responsible may be worthwhile. For example, Nominet and The Internet Corporation for Assigned Names and Numbers both have procedures to suspend domain names where the registrar cannot provide verified contact information for a domain name holder within a certain time frame. In cases where websites are displaying obviously fraudulent material, it may also be worth contacting the internet service provider (ISP) directly, particularly if it can be argued that the ISP may be jointly liable, or in breach of its own terms and conditions.

Other useful practice guidance points highlighted were:

- It pays to be careful with letters before action in these situations. Not only can these encourage “cyber-flight”, but they may also expose the rights holder to a threats action after the alternative dispute resolution/UDRP proceedings. It is also advisable to be careful with “without prejudice” correspondence, as this can still be brought into UDRP and Nominet proceedings.
- There is a jurisdictional risk inherent in any UDRP complaint. Not informing the complainant of this before filing the complaint is potentially negligent (Prince plc v Prince Sporting Group Inc).
- If the respondent can be identified and the UK court has jurisdiction, bringing

infringement proceedings before the Intellectual Property Enterprise Court (IPEC) can be quicker and more cost effective than filing a UDRP/Nominet complaint.

Payne's talk looked at the rights protection mechanisms (RPMs) introduced to address the heightened infringement risks presented by the new generic top-level domain (gTLD) programme. She provided an overview of the current systems, including the Trade Mark Clearing House and Sunrise priority purchase period for trade mark owners.

Payne confirmed that RPMs are currently under review and that submissions for potential improvements can be made via the CITMA Domain Names Working Group. Measures that Payne considers rights holders should be campaigning to introduce or maintain include:

- a cross-registry block list, similar to the system implemented by Donuts for its new gTLDs;
- protection for trade marks in the clearing house to be expanded to cover typos and 'Marks +' (ie mark plus another non-distinctive element); and
- no dilution of the current UDRP procedures.

Concluding this section of the event, Baxter provided a short history of King (the producer of huge online games such as *Candy Crush Saga* and *Pet Rescue*) and the steps it has implemented to deal with issues surrounding online gaming. Surprisingly, Baxter confirmed that her company had no active trade mark

or domain name watches in place, and said that the majority of King's enforcement efforts are focused on online software-application stores (such as Apple's App Store), as the majority of pertinent infringements occur at this level.

When questioned as to why King had decided not to actively watch infringing domains, Baxter said that there are simply too many sites to monitor effectively, and any prominent infringements usually come to the company's attention quickly via other means. Baxter confirmed that her company always investigates in the event it is notified of potentially damaging sites by customers, and always takes action against phishing and hacking sites. For other sites, the factors dictating whether action will be initiated are: cost v benefit, strength of case, impact of the website, content of the website and whether the domain name is of interest to the company. Baxter also confirmed that action is normally via UDRP complaint, and shared the other panellists' view that the Uniform Rapid Suspension procedure is an unattractive alternative.

GRAPHICAL REPRESENTATION

Nathan Abraham of the UK IPO presented a practical talk on the changes to graphical representation requirements brought about by the implementation of the new Trade Mark Directive. Abraham welcomed the new changes, considering that tying trade

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3D printing allows the same product to be 'manufactured' by potentially thousands of people, so may change the perception of what constitutes 'origin'

mark and design registration to the concepts of two-dimensional graphic representation is now outmoded, and the new legislation will bring these "into the 21st century".

After a brief historical review of the present position, which Abraham feels pushes applicants to settle for the more "conventional" marks (excluding shape marks, non-conventional marks account for only 0.04 per cent of the marks on the UK Register), he outlined the new rules brought about by the Directive. The UK IPO's basic position will be that, provided the subject matter of the mark can be captured with clarity and precision, it will meet the basic requirements for filing. Some examples that would be potentially acceptable by the UK IPO, he said, include the digital encoding of scents via scent printer, digital motion-capture files for "movement" and 3D marks, and sonographs accompanied by a digital



Above (left to right): Susan Payne, Valideus; Victoria Baxter, King; CITMA President Kate O'Rourke; and Matthew Harris, Waterfront Solicitors
Left: Beth Ferrill of Finnegan sharing her insight into 3D printing and its IP implications

BREXIT IS BACK

In the wake of the previous day's announcement by the Conservative Party, in the same building, that Article 50 would likely be invoked in March, it was timely that Patricia Collis of Bird & Bird LLP took the floor during the event to speak on this topic. She elected to avoid speculation as to what the possible outcomes could mean and instead focused on what proactive steps brand owners and practitioners could take now, based on the information available.

After a brief review of the present position, including whether Brexit would affect the implementation of the new Trade Mark Directive, Collis suggested that, rather than waiting for policy announcements, brand holders should review their existing IP portfolios with a view to ensuring that no protection is lost. For example, there may be use issues post-Brexit in relation to EU Trade Marks (EUTMs) that had been used only in the UK. Therefore, refiling the mark in the UK before the projected 2019

exit date may be advisable. The position in relation to Registered Community Designs is not as straightforward in view of the novelty requirements for new applications.

Collis recommended that existing agreements and licensing arrangements should be reviewed and territorial and jurisdictional questions addressed. The differences in the UK and EUTM legislation in relation to licensees bringing infringement proceedings in their own name was one example cited of an issue that may become material. It's conceivable that Brexit may provide a basis for termination of contractual arrangements (*force majeure*, a material adverse change) and therefore it is advisable to address these issues now rather than after Brexit.

Practitioners should have Brexit in mind when entering into new agreements, she said, particularly when defining territorial scope and jurisdiction. In common with other commentators, Collis advised practitioners to monitor the position closely.

sound file for sound marks. He also considered that motion-capture technology will help applicants present design applications more effectively, noting that EUIPO already accepts these.

Abraham feels that the changes to the graphical representation requirements are in line with prevailing trends in IP generally (including the Trunki and IP Translator decisions), with the emphasis being on greater precision – “what you see is what you get”. The removal of ambiguity with regard to graphical representation of marks can only be a good thing for both applicants and practitioners.

3D PRINTING IMPACT

Beth Ferrill of Finnegan, Henderson, Farabow, Garrett & Dunner LLP presented a fascinating talk on 3D printing, first providing a history and current overview of 3D printing and then explaining very convincingly why it represents a sea change for the manufacturing industry.

In terms of the implications for IP, Ferrill considers that the changes in production methods brought about by 3D printing will place a far greater emphasis on the design of the product, as opposed to the product itself, and therefore the licensing of these design files will be paramount. In relation to trade marks specifically, although it would be possible to include branding as part of the design of the finished product, this could be easily removed by an experienced coder. More fundamentally, as 3D printing allows

the same product to be “manufactured” by potentially thousands of people across the world, it may also change the perception of what constitutes “origin” in relation to products and potentially obviate the need for product branding altogether.

DAMAGES AND REMEDIES

Despite being given what he described as the “graveyard slot”, Jonathan Moss of Hogarth Chambers presented a well-received and informative talk on the developing law of damages and remedies, largely brought about via the IPEC (30 per cent of all reported decisions from the IPEC since 2014 have been on this point).

Moss provided a detailed history of the important developments and discussion of the various cases that had brought these about. He also provided useful guidance and practice tips, including:

- Request Island v Tring disclosure in pre-action in order that the claimant can make a more educated assessment when considering whether to request damages or an account of profits.
- When one is pursuing an injunction, the wording must be considered very carefully. Ideally, any injunction requested should reflect the

undertakings offered to settle the case. If the letter before action requested unduly broad undertakings, this may affect the decision on whether an injunction is granted. Overbroad undertakings requested before action may also have consequences for the award of costs.

- *PJS v News Group Newspapers* confirmed that the internet is likely to change perceptions of privacy, and courts may reconsider their approach to granting injunctions if it has become unrealistic. Injunctions may now also be granted if it is clear that they are going to be effective rather than because they work, as was the case previously.
- *Combit Software v Commit Business Solutions* – the CJEU confirmed that, when granting injunctions, if the defendant can show that there was no likelihood of confusion in certain parts of the EU, then there was no infringement in these areas. However, these areas must be strictly defined – but it is difficult to see how this can be reconciled with technical developments such as Google Glass and Amazon Echo.
- The *Lucasfilm v Ainsworth* decision may make it possible for the UK courts to hear cases based on foreign rights. This may make the UK an attractive venue if a claimant is forum shopping, even in a post-Brexit world. ■



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Destination: DESIGNS

*Ewan Grist takes us on a whistle-stop tour
of Europe's latest decisions of interest*





1. Belgium

BOOKSTAND GAINS BROAD PROTECTION

In *Barber v Leuke Dinges BVBA* (20 April 2016), an Australian designer (Barber) asserted a Registered Community Design (RCD) for the design of a beanbag book support against three Belgian companies.

The Court found that the RCD was valid. In reaching this conclusion, the Court found that the fact that Barber's beanbag product was also protected by patent rights did not imply that its shape was exclusively determined by its technical function. The determining factor was whether the features of its shape were chosen exclusively for the purpose of designing a product that performs its function, or if aesthetic considerations were completely irrelevant.

The Court also found that the RCD was new and had individual character. It was irrelevant that Barber had exhibited the design at certain local markets before the RCD filing date. The Court did not think the design could reasonably have become known in the normal course of business to persons specialised in the sector, and hence such a prior disclosure did not affect the validity of the RCD.

The Court found that the RCD was considerably different from earlier book-support designs, a finding that led to it being afforded a broad scope of protection. The relatively minimal differences between the RCD and the allegedly infringing designs were deemed insufficient for a finding of non-infringement. The Court ordered a pan-EU injunction.

2. France

COURT APPLIES COPYRIGHT DEFENCE

In *Piganiol v L'Oréal*, the Court of Appeal of Paris examined whether the reproduction of a registered design in an advertising campaign should be regarded as an act of infringement, as such use is not expressly provided for in Article L 513-4 of the French Code of Intellectual Property.

Piganiol brought registered design infringement proceedings against L'Oréal for its reproduction of Piganiol's umbrella design in miniature in an advertisement for L'Oréal's hair products. L'Oréal argued that (i) the use of the design within an advertisement was made for illustration purposes only; and (ii) the design, being in miniature, was merely an accessory to the advertisement as a whole. However, the Court rejected L'Oréal's defence.

The Courts considered that, because L'Oréal had not complied with all the relevant legal requirements (*inter alia*, quoting the right holder's name and the design registration number), the illustration defence could not apply. In addition, the principle of "accessory" is a copyright defence and has no equivalent in design law. Despite this, the defence was still considered by the Court, which came to the conclusion that the umbrella was all the more meaningful, since, as it was miniaturised, it therefore created a significant visual effect when compared with the tall mannequin holding it. Consequently, L'Oréal's use of Piganiol's registered design was infringing.

This case is notable for two reasons: (i) this is the first time that the Court has ruled on the illustration defence in design law; and (ii) it suggests that the borders between copyright and design law are somewhat blurred, as the Court was willing to at least consider the copyright principle of accessory in a design-law case. ▶

3. Italy

ICONIC BOOTS GAIN PROTECTION

In *Tecnica Group v Aniel* (12 July 2016), the IP Court of Milan granted copyright protection to Moon Boots, the iconic après-ski boots originally launched by Tecnica in the 1970s, recognising that a competitor's similar boots infringed Tecnica's copyright in the Moon Boots.

The Court confirmed that the Moon Boots met the "creative character" and the "artistic value" requirements set by Article 2, No 10 of the Italian Legge Autore for a design to qualify for protection under copyright law. The Court stated that the Moon Boots "completely changed the aesthetic standards of the après-ski boot, becoming a true icon of Italian design and of its ability to encapsulate the style of a particular era in relation to everyday items".

The product won many national and international awards, and was the subject of several articles on Italian and international contemporary design. It was even selected by the Louvre as one of the 100 most significant symbols of 20th-century international design. In the Court's opinion, these were all indications that, in certain circumstances, industrial design can bring art into everyday life and, on such occasions, deserves to be protected by copyright.

4. Germany

CLARIFICATIONS AND FURTHER QUESTIONS

Of note in Germany over the past year is the *Armbanduhr* or "Wristwatch" case (28 January 2016). Here, the German Federal Supreme Court found that, when assessing the overall impression of a design, it is the informed user's perception of the product – perceived during its designated use, in advertising or at the point of sale – that matters.

Also of interest is a decision dated 2 June 2016 in which the German Federal Supreme Court considered whether vehicle rims fall within the scope of Article 110(1) of the Community Design Regulation, which relates to the protection of designs for component parts of complex products and reads: "... protection as a Community design shall not exist for a design which constitutes a component part of a complex product ... for the purpose of the repair of that complex product so as to restore its original appearance." The Court has referred a number of questions relating to the interpretation of this provision to the CJEU, including whether the application of the Article 110(1) exemption is limited to fixed-shape parts (ie those parts whose shape is in principle immutably determined by the appearance of the product as a whole and cannot therefore be freely selected by the customer, such as rims for motor vehicles).

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When assessing the overall impression of a design, it is the informed user's perception of the product that matters



DESIGN AND COPYRIGHT: THE WORK OF CITMA'S WORKING GROUP

The CITMA Design and Copyright Working Group is responsible for monitoring all developments relating to the law of design and copyright on behalf of the CITMA membership. Comprising Trade Mark Attorneys, solicitors and counsel who specialise in the field, it has two key objectives:

1. To review and provide comments on proposed developments to both law and practice in the field. This can take a number of forms, in particular by way of providing responses to consultations undertaken by the UK IPO and other IP agencies and bodies. It also provides (for the time being at least) comments on EUIPO's biannual proposed amendments to the Guidelines on Design Practice, as well as to the UK IPO in respect of design and copyright case references pending before the CJEU.
2. To communicate developments in the design and copyright fields, both proposed and implemented, to the CITMA membership. This may be by placing articles in the *CITMA Review*, but the group also now posts articles on design and copyright issues on the CITMA website, which means we can update members quickly and easily. Simply go to citma.org.uk and click on the Designs & Copyright tag.

5. The Netherlands

DUTCH COURTS CONSIDER COLOUR AND COPYRIGHT

In *Wibit-Sports v Aquaparx* (2 September 2015), the District Court of The Hague considered the scope of protection of Registered Community Designs (RCDs) that are registered in black and white. The case concerned the infringement by Aquaparx of Wibit-Sports' design rights in various inflatable water toys. In addition to the ultimately unsuccessful attempt to invalidate Wibit-Sports' RCDs for, *inter alia*, lack of novelty and individual character, Aquaparx also asserted that the allegedly infringing products created a different overall impression due to the distinct colours used by Aquaparx – which differed both from the colours used by Wibit-Sports in practice and from the black and white in the RCDs. However, the District Court ruled that only the designs as registered should be compared with the allegedly infringing products, and that the lack of any colours in the RCDs actually indicated that they were meant to protect the shape of the products, regardless of the colours used.

In *Burgers v Basil* (19 February 2016), Burgers had, at first instance, been found liable for copyright infringement, having copied Basil's wicker bike basket. However, the Court of Appeal of The Hague ruled that the wicker basket was not protected by copyright as it was not considered a "work" due to lack of a "personal stamp of the maker". Strangely, though, the Court of Appeal found that the basket did meet the criteria for an Unregistered Community Design (UCD), as the design was considered to be new and to have an individual character. According to the Court of Appeal, Burgers had infringed the UCD. The Court of Appeal thus set the bar for protection under copyright higher than for UCD rights. While the Court of Appeal concluded that Burgers had infringed only Basil's UCD, it maintained the ancillary claims and penalties that had been imposed in first instance on the basis of copyright infringement.

6. Poland

COMPANY INVALIDATES ITS OWN DESIGN

In a decision dated 7 December 2015, the Polish Patent Office (PPO) had recognised the legal right of a company to invalidate its own design. Kromet Factory decided on this unusual course of action after the design's creator, a former employee, demanded payment for the use of the design (an electric pan) by the company. The PPO was bound by a former judgment of the Voivodeship Administrative Court in Warsaw, dated 18 September 2014, in which the Court found that a design owner can have a right to invalidate its own design if it is able to establish sufficient grounds for invalidation. The Court referred to the Polish Supreme Administrative Court's judgment of 30 October 2013 by analogy, in which the Court ruled that an applicant had a right to invalidate its own patent.

In a separate decision dated 28 January 2016, the PPO dismissed an application to invalidate the registration of a design (of an ice cream with a cow's-spots pattern) by a Polish ice-cream manufacturer, Zielona Budka. The application was submitted by Zielona Budka's competitor, Mlekpól, which was the owner of a mixed (verbal and graphical) trade mark "Łaciate" (the Polish word for "spotted", which was combined with graphical representations of a cow's spots) that it used on its milk products. The PPO ruled that, because the Łaciate trade mark was not exclusively graphical, but rather a mixed trade mark, it could not be the basis for the invalidation of a design. A design's nature is purely visual, whereas the cow's spots were only a visual element of a mixed trade mark. As such, the cow's spots alone did not possess the necessary distinctiveness required to successfully establish grounds of invalidation.



In Burgers v Basil, the Court of Appeal set the bar for protection under copyright higher than for UCD rights

ARE YOU PROTECTING YOUR SLEEPING BEAUTIES?

Katie Goulding suggests ways to tackle a thorny in-house issue

Recently, I delivered a talk on brand revival. Not about the likes of Burberry, whose brand has undergone a revival through reinvention, but about “abandoned” brands – the ones that have been banished to the archives for whatever reason. You may have heard them referred to as “zombie brands” or, more romantically, as “sleeping beauties”, waiting for their Prince Charming to rouse them from their slumber.

Some of these dormant brands find “resurrection” at the hands of a new owner. This is a fairly perilous business, the risks of which will need to be measured through careful investigation and due diligence until one is as confident as one can comfortably be that the brand truly is abandoned, and that any goodwill has been extinguished.

And those undertaking this activity should remember that the Trade Mark Register is the first place to look, but it certainly isn't the last. It will never give a full picture, only a suggestion of the brand owner's state of mind at the time the status of its registrations changed. Carrie Bradley gave a great talk on these issues at the ITMA Spring Conference in March, and I refer you to her article on the

same topic in issue 404 of the *ITMA Review* for more detail.

But what I'd like to concentrate on are the issues of brand revival from the perspective of the original brand owner. As a number of cases have shown, whatever the fallout that might have caused a brand to be abandoned, a brand owner may at some point recognise (or be reminded) that the brand still holds value capable of re-articulation in the modern day.

CONSUMER DRIVERS

As consumers, we often respond to marketing messages that remind us of the “good old days”, and revived brands are perfectly equipped to capitalise on this. They call upon their heritage and nostalgia to reach into a consumer's psyche and to memories buried, but not forgotten. Interestingly, this demand doesn't just flow one way, which means long-lost brands are sometimes revived because consumers are calling the shots.

For example, take the case of Surge, a tropical drink developed by Coca-Cola in the 1990s and intended to rival Pepsi's Mountain Dew. It gained a following in a nascent energy-drink market, but was eventually discontinued in the early noughties. However, the brand continued to have

a devoted following – to the extent that a Facebook group was set up by a “Surge Movement” to try to bring the drink back. The group attracted some 200,000 likes within a month. The story goes that the members even pooled money to buy a billboard within half a mile of Coca-Cola's headquarters in the US that read: “Dear Coke, We couldn't buy Surge, so we bought this billboard instead.”

The outcome of the group's action? Surge was returned to sale in selected US stores, some nine years after its discontinuation. It marked the first time a Coca-Cola brand was launched solely on social and digital media, and also a landmark distribution through Amazon Pantry. Similar social media movements have brought back Cadbury's Dairy Milk Tiffin and, thanks to the power of protest, the Wispa bar.

These examples clearly show that, while brand owners may have no intention of reviving their abandoned brands, this can change overnight – particularly if demand is consumer driven, which has a number of benefits. If the consumer demands a product revival, a degree of risk is removed in the product (re)launch. And where social media plays a part, the demand is likely to be more easily quantifiable and located on a map. When the public



takes some of the promotion in hand, and assuming the desired message is being conveyed, this type of brand revival may not require as much financial investment as for a brand-driven launch (depending on the goods, of course; the revival of a luxury product is likely to require a more sensitive launch with a large marketing spend).

VALUE DRIVEN

There are, of course, instances where a brand revival is driven from within the business. A recent example that has received much positive coverage is the revival of The Co-operative Group's

cloverleaf logo. This is what I call a “value-driven” revival – a return to a brand identity that for many years symbolised the way in which the Co-op placed members at the heart of its business. In the late 1990s and early noughties, the business had rebranded after the impact of the cloverleaf logo was believed to have become diluted, and a more “corporate” brand was felt to strike the right tone. In 2006, the Co-op even received the title of “most trusted” retail operator on the high street in one consumer poll. However, in the face of the economic downturn in 2013/14, not only was the most recent identity considered too

corporate, but also to be a symbol of where the company had gone wrong.

This year, new life was breathed into the cloverleaf logo of the 1960s, recalling the strong foundations of its heyday values, along with a modern rewards scheme to put the Co-op's members back at its heart.

Louis Mikolay of North, the design agency behind the revival, hit the nail on the head: “In older generations, it evokes nostalgic memories of local shops and ‘divi’ [dividend] stamps, while, to younger generations, it suggests a modern brand of the future, ready to live and breathe in the digital world.”



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PROTECTION POINTERS

So, what can brand owners do to protect their sleeping beauties in case consumer demand or a change of corporate strategy calls for their revival?

The first obvious move is to maintain trade mark registrations. Clearly, the costs of renewal will not always be justified, and I'm certainly not suggesting that it's never right to let registrations lapse. What I would say, however, is that IP professionals should make more detailed enquiries of brand owners when discussing renewal. If someone were to ask the brand owner to create a lookbook to tell the story of the history of their brand, would the one being abandoned feature in it? If so, for the relatively small cost of renewal, it may be a keeper.

Sure, the owner might be on bad terms with it right now, but businesses change hands, feelings change, consumers protest and, one day, the brand owner may want to prevent someone else grabbing a piece of its heritage. (Happily, the Co-op maintained its 1997 UK registration for the old cloverleaf logo, so could call on it when it saw the value.)

Owners might also consider refile projects to deflect non-use provisions, but advice around strategy will be needed for those countries where statements of *bona fide* intention to use are a requirement.

Action can be taken to mitigate risks of revocation. In the UK/EU, use of a trade mark includes use in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was registered. Provided this is adhered to and the use is in respect of the goods covered, there is nothing preventing a brand owner from changing how the brand is usually used – the exact product need not continue. This fact is not always known by the brand holder. One option might be to use the brand as a sub-brand, even for limited periods through the year or as part of a promotion.

For example, to celebrate Halloween 2015, Cadbury launched a Twitter campaign using the hashtag #CadburyCraveyard. Followers were

asked to vote whether they wanted to “resurrect” either of two old favourites: the Fuse and Marble chocolate bars. One hundred lucky followers were sent a winning bar. In less than a week, the hashtag was used more than 12,000 times. I've seen many an argument that promotional use is not genuine use with reference to the case of Silberquelle. However, the fact that goods are offered free of charge does not prevent genuine use from being established (T-289/09, Omnicare Clinical Research, paragraphs 67, 68; Case C-320/07 P,



Whatever the fallout that might have caused a brand to be abandoned, a brand owner may at some point recognise that the brand still holds value in the modern day



Antartica v OHIM, paragraphs 29, 30). Silberquelle must be read more closely to ensure the facts can be distinguished to support use with the aim of penetrating the market to create or maintain a market share.

Arguably, the #CadburyCraveyard campaign would be sufficient to show genuine use of the trade marks for Marble/Fuse, but one must also be careful of public statements – Cadbury tweeted that it would not be selling either of the chocolate bars again. This might undermine an argument of use to maintain a market share and the attorney on the other side might argue that the campaign was token use merely for the preservation of the registered rights.

If registrations have lapsed in the UK/EU and genuine use cannot be established, brand owners should look further afield if an international portfolio is owned. A battle between craft brewer Thunder Road Brewery and Foster's-owned Carlton & United Breweries (CUB) over a portfolio of heritage beer brands in Australia illustrates how a brand's heritage can be used as a shield in revocation actions. Thunder brought revocation actions against 54 trade mark registrations in the name of CUB. Despite the fact that use could not be shown, 41 of the 54 registrations were successfully defended.

Through the use of the word “may”, the Australian Trade Marks Act grants the registrar a discretion to allow a registration to remain on the register if it is reasonable to do so, taking into account all circumstances, including special circumstances that make it appropriate not to revoke the registration. The registrations were not revoked because CUB successfully established a residual reputation in the heritage brands. In other words, capping off the potential markets available to a Prince Charming may allow a Beauty to sleep another day.

Brand owners would be advised to collate evidence of third-party references or social media followings to evidence residual goodwill and reputation in abandoned brands in the same way as they might for key brands with continuing registrations. This places them in the strongest position to defend a piece of their brand history. Whatever the fallout, and whatever the intention for the abandoned brand, nothing reignites interest like someone else saying they want it. A spokesperson for Foster's explained it beautifully during the CUB dispute: “In some ways, it is the equivalent to somebody coming into your house and wanting to take your family photographs.” ■



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Katie spoke on this topic at HGF's annual IP in Retail conference.

An aerial night view of a dense Chinese city, likely Shanghai, showing a vast number of illuminated skyscrapers and residential buildings. The lights create a vibrant, colorful scene with a mix of warm yellow and cool blue tones. The buildings are packed closely together, creating a complex, layered urban landscape.

CHINA CHECK-IN

A team of IP professionals once again joined UK Government representatives to cement relationships in China

TMA and CIPA were delighted to be invited for the second time to join a ministerial-level delegation to China to promote the UK patent profession and represent the interests of UK and European IP holders in China.

Headed by Baroness (Lucy) Neville-Rolfe, Minister of State for Energy and IP, and with the participation of His Honour Judge Richard Hacon, the delegation took on an intensive city-a-day tour around Hong Kong, Shenzhen, Xi'an and Beijing, culminating in a UK-China IP symposium, and flitting between various sub-meetings in the meantime.

ITMA was represented by past President and Council member Catherine Wolfe and the multi-talented Dave Musker, with trade mark support from Frederick Mostert. The CIPA delegation was headed by Catriona Hammer (Council member and former President) with the support of Gwilym Roberts (Kilburn & Strode LLP), Saiful Khan (International Liaison Committee), Peter Garratt and Beijing-based Handong Ran. The range of legal and practical expertise this group brought was invaluable.

PACKED PROGRAMME

The delegation started off in Hong Kong, where we enjoyed a taste of ministerial treatment at Hong Kong Airport, receiving VIP credentials and being whisked through security. The luxury treatment stopped there, as we were due at our first meeting around 30 minutes later, at 4pm on Sunday. The visit started in earnest on Monday morning, when CIPA and ITMA were represented at a breakfast meeting with the British Consul General in Hong Kong, which was also attended by the minister and various Hong Kong IP

luminaries. The meeting was followed by a large public event, at which Hacon J, representing the judiciary, was quizzed yet again on the Intellectual Property Enterprise Court, which continues to get worldwide attention.

The members of the delegation then dispersed to take part in a range of meetings in Hong Kong, including a private meeting with the Hong Kong Intellectual Property Department (IPD). CIPA and ITMA then attended a roundtable with Hong Kong IPD and various Hong Kong professional associations to discuss developments in Hong Kong patent law and trade mark practice – including the new “original patent grant” proposal that is going through the legislative process at the moment – and the Madrid Protocol. Several areas were identified for cooperation between the UK and Hong Kong professions with a view to building strong future relationships.

The delegation then headed for Shenzhen and meetings with the top IP brass at major Chinese companies Tencent and Huawei. It then flew on to Xi'an, where the traditional visit to the terracotta warriors was replaced by meetings with the Shaanxi Regional Intellectual Property Office and local businesses, together with an “IP salon” hosted by Wolfe at Xi'an's Northwest University. As always, there was the opportunity to discuss enforcement issues within China, and also to promote the UK patent and trade mark professions. In Xi'an, we noted the real interest, which we've seen throughout the Chinese provinces, in learning from the UK profession and building relationships, an interest that, in the long term, can only be of benefit to CIPA, CITMA and British business.

GROWING RELATIONSHIP

After Xi'an, the delegations headed to Beijing and the UK-China workshop on trade marks, brands and economic growth, opened by Baroness Neville-Rolfe, closed by the UK IPO's China head Willa Huang and with talks from Hacon J, Mostert, Wolfe and Dids Macdonald of Anti Copying in Design. There were also meetings with the China Trademark Association and the All China Patent Attorneys Association, which arranged a seminar on recent updates on designs and patents for

60 attendees, which was greatly appreciated. Again, this is a relationship that stays strong and grows. The trip finished with the IP seminar, at which we gave updates on Brexit, case-law developments and design practice. It was a great opportunity to clear up misconceptions and confirm that it is very much business as usual in the UK IP world.

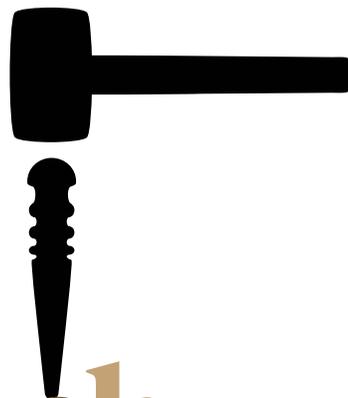
Friday was the UK-China IP symposium, opened by Baroness Neville-Rolfe and Shen Changyu, Commissioner at the State Intellectual Property Office (SIPO), and with presentations from: Hacon J; Martyn Roper, Deputy Head of Mission at the British Embassy in Beijing; Neil Feinson and Elizabeth Jones of the UK IPO; Macdonald and China-Britain Business Council's Mick Ryan; Hammer and Wolfe; Mostert and Harris Moure's Mathew Alderson; as well as senior Chinese delegates, including He Zhimin, Vice-Commissioner at the SIPO, and Wu Kai, Director-General, International Cooperation Department, at the SIPO. This was also the opportunity to launch a guideline on IP in Europe, issued jointly by the UK IPO, British Embassy Beijing, CIPA and ITMA, adding to the documentation extolling UK services for Chinese business. During the afternoon was a meeting with Zhongguancun local government, and some of the CIPA representatives visited Lenovo for talks with its IP team, mainly answering questions on unitary patents and the Unified Patent Court and discussing Lenovo's patent-filing strategies.

Our thanks go to the minister for her unfailing support for the UK's IP efforts and to the UK IPO for arranging such a succession of successful interactions with the Chinese Government, business and IP profession. There are too many people to thank individually, but Tom Duke, our Beijing IP attaché, and Willa Huang deserve special mention. It was a welcome and timely opportunity to spread the message “Brexit: business as usual”, which was well received in China, and to increase further awareness of the UK profession as a natural home for the handling of European work. ■

Report by Catherine Wolfe, Gwilym Roberts and the IP delegations

“
The traditional visit to the terracotta warriors was replaced by meetings with the Shaanxi Regional IPO”

Unpacking the punch



Mary Johnson briefly explores the history of the hallmark and how these traditional symbols can have tactical significance to trade mark practice today

When a woman steps out in a pair of diamond-encrusted platinum stilettos crafted by House of Borgezie – some of the most sought-after and expensive shoes in the world – she is perched atop jewellery that requires “the same time and craftsmanship that is used to make the finest royal crown”, says Chris Shellis, designer for and founder of the House of Borgezie. It is no surprise that Shellis ensures that each shoe bears a series of identifying marks that provide a physical record of the maker and the metal used – in this case, a “sponsor’s mark” reflecting his own initials and the Birmingham Assay Office’s assay and date marks.

These marks, themselves beautifully and skilfully affixed to the sole, serve to ensure that every shoe is recognisable as an article he has produced with his iconic, flamboyant style and expert craftsmanship. They also provide a reminder of how a very ancient practice can be valuable in a modern context. The use of a sponsor’s mark on any article of precious metal is a brand marketing opportunity that should be exploited to its full potential. However, doing so requires an understanding of the hallmarking, assay and related registration processes, the basics of which this article will discuss.

HALLMARK HISTORY

Hallmarking articles made from precious metals is one of the oldest ways of guaranteeing their origin and quality – the original requirements were enacted in England during the reign of Henry III in the 13th century. The motivation behind the idea

of imposing minimum standards of fineness of the precious metal used in an article was a compelling need to protect the public against the fraudulent use of inferior metal by dishonest manufacturers.

More recently, the Hallmarking Act 1973 (HA 1973) set out the legal requirements governing the processes involved in the manufacture and hallmarking of articles of gold, silver, platinum and palladium. Every article manufactured from these metals must be branded with official hallmarks (unless it is exempt from the requirement under HA 1973) before it can be sold in the UK, the countries signed up to the International Hallmarking Convention and/or the European Economic Area.

THE ASSAY PROCESS

Hallmarks confirming an article is of the appropriate fineness as specified by HA 1973 are applied to it once it has been submitted to and tested by an assay office (AO). There are only four remaining AOs in the UK – in London, Birmingham, Sheffield and Edinburgh – and each has a unique mark.

Techniques for assaying and hallmarking articles made from precious metals are improving all the time. For example, traditional punch marking is being replaced by more sophisticated laser techniques that decrease the risk of bruising and damaging an article in the hallmarking process.

SM ESSENTIALS

A hallmark comprises several compulsory and optional symbols, including a sponsor’s mark

ASSAY OFFICE MARKS



LONDON



BIRMINGHAM



SHEFFIELD



EDINBURGH



This ring bears the AO mark of Birmingham (anchor) and a pre-1975 fineness mark stating it is nine-carat gold (ie 37.5 per cent purity). The “b” on the right means it was punched in 1901

(SM). The SM is the mark of the maker, designer or manufacturer of the article, and any SM to be used on any article in the UK must be approved and formally registered at one of the four UK AOs. It is possible for the manufacturer to mark the article with the SM prior to assaying or, by agreement with the AO, for the AO to mark the article with the SM. Each AO will keep a register of SMs registered at it.

An SM is valid only if registered with the AO for 10 years from the date of registration. An application for registration of an SM costs £60 (plus VAT). Renewal of the registration is required 10 years from the original date of registration, when a further fee of £30 (plus VAT) is payable.

A registered SM, under the provisions of HA 1973, must be different from any existing SM registered at each particular UK AO. Previously, an SM was required to consist of at least two letters within a surround (shield) that could be chosen from a range provided by the AO.

An amendment made to s3(3) (a) HA 1973 on 8 February 2013 removed the requirement to include in the SM the initial letters of the name or names of the manufacturer or sponsor. The requirement for an SM is now as

follows: “Any sponsor’s mark which is registered under this section shall be of such design as may be approved by an assay office.” However, AOs continue to recommend the use of the traditional mark, comprising at least two initials within a shield.

Meanwhile, the amendment of s3(3) (a) has widened the scope of what is now capable of being registered as an SM. The amendment has made it possible to register a trade mark and/or registered/unregistered design or copyright design for use as an SM.

TM REGISTRATION GUIDANCE

The British Hallmarking Council (BHC), the statutory body that oversees the activities of AOs, has issued guidance notes (not Regulations made under HA 1973) outlining the requirements for approval of a trade mark as an SM, which are as follows:

- (a) The supplier must provide the AO with an authorised hard copy of the registered trade mark or other registered design.
- (b) The supplier must provide the AO with a written undertaking that it has the authority to use the trade mark.
- (c) The AO is not responsible for validating ownership of the design or its use, or for verifying its registration.

ANATOMY OF A HALLMARK

A hallmark comprises several compulsory and optional symbols

Compulsory

- **Sponsor’s mark**
The mark of the maker/designer/manufacturer of the article
- **Metal fineness mark**
This indicates the metal content of the article with the shape of the surround indicating the type of metal fineness of the article
- **Assay Office mark**
The mark of one of the four AOs (opposite) that assayed the article

Optional

- **Decorative fineness marks**
These indicate one of three types of silver (Sterling, Scottish Sterling and Britannia) or palladium, gold or platinum
- **Date letter**
The year of manufacture
- **Common control mark**
The UK is a signatory of the International Convention on Hallmarks. UK hallmarks are recognised by all convention countries and convention country hallmarks are recognised in the UK, so items from convention countries do not have to be re-hallmarked in the UK



◀ A diamond-encrusted stiletto from House of Borgezie

OFFENCES UNDER THE HALLMARKING ACT 1973

It is an offence:

- ▶ to strike an article with a mark purporting to be an SM without authority (s3(8) HA 1973);
- ▶ to make an addition, alteration or repair to an article bearing approved hallmarks, except in accordance with the written consent of an AO (s5(1) HA 1973), and subject to further exceptions under s5(3) to s5(5) HA 1973;
- ▶ to remove, alter or deface any mark struck on an article, except in accordance with the written consent of an AO (s5(2) HA 1973), and subject to the exceptions under s5(3) HA 1973;
- ▶ to describe in the course of trade or business articles as being made totally or partly of gold, silver, platinum or palladium, or to supply or offer to supply an article that is made of gold, silver, platinum or palladium that has not been hallmarked (s1(1)(a) and s1(1)(b) HA 1973);

- ▶ to make a counterfeit of any die or mark with intent to defraud or deceive (s6(1)(a) HA 1973);
- ▶ to remove any marks from an article of precious metal with intent to transpose them on any other article (whether precious metal or not) or to affix to any article (whether precious metal or not) any mark that has been removed from an article of precious metal (s6(1)(b) HA 1973);
- ▶ to utter any counterfeit of a die or utter any article bearing a counterfeit of a mark (s6(1)(c) HA 1973);
- ▶ to have in one's custody or control without lawful authority or excuse a counterfeit die or mark that one knows or believes to be a counterfeit of a die or an article (whether of precious metal or not) that bears a counterfeit of any mark (s6(1)(d) HA 1973); and
- ▶ to fail to display a Dealer's Notice (s11(1) HA 1973).

Enforcement of the provisions of the HA 1973 is the duty of the relevant weights and measures authority, which is generally the trading standards section of local Councils (s9(1) HA 1973).

- (d) The trade mark design must allow the mark to be clearly distinguished and described.
- (e) Numbers alone will not be approved.
- (f) Trade marks or designs resembling the character of a current or ancient hallmark will not be approved.
- (g) Any trade mark or design to be used as an SM must be of a size that allows it to be made into a punch that is useable as part of the hallmark while remaining legible. It may not be possible to make more than five characters into a satisfactory punch.

To date, there has been no dispute over the registration of an SM that has resulted in the need for any appeal procedure to be invoked. However, the absence of a publicly available register means it is not possible to search in advance of applying to register a mark as an SM. So, conflicts may arise with the AO's view on acceptable scales of similarity or distinctiveness between an existing registered SM and a new one proposed to be registered. Before

going to the expense of designing a mark to be used as a trade mark and/or SM, it is worth getting verification from the AO that a proposed trade mark or design is not the same or too similar to an SM already on the AO Register.

The BHC has also issued guidance notes for affixing a logo, design or trade mark to an article of precious metal that has been hallmarked where the additional element has not been registered as an SM. This guidance would need to be followed for its inclusion as a mark additional and extraneous to an article's hallmark.

AVOIDING CONFUSION

It is imperative to avoid confusion between use of a logo, design, trade mark or decorative mark affixed on articles extraneous to the hallmark, and the hallmark itself. In order to ensure there is no such confusion, the BHC has also issued guidance on the use of a logo:

- (a) It must be principally for decorative purposes.
- (b) It must not give the impression that it is a present or formerly authorised hallmark.
- (c) It must not give or purport to give additional information about the standard of the metal contained in the article, the AO or the date it was marked.
- (d) It must not be part of a hallmark.
- (e) It must only take the form of a motif in a shield if it is clearly distinctive and could not be mistaken for a hallmark.
- (f) It must not consist of numbers that could be interpreted as identifying the fineness of the precious metal.
- (g) It must not consist of marks of former or defunct AOs, unless legally permitted, for purposes that are clearly decorative and distinctive from authorised hallmarks.
- (h) It must not be the same or similar to a current or former registered SM.
- (i) It must not damage or distort any hallmark, or its legibility.

- (j) It must not be applied in such a way as to form part of the pattern of a hallmark.
- (k) It must be sited on the article to avoid conflict with the hallmark (in practice, it is normally required to be sited two spaces away from the hallmark).
- (l) Marketing or other information must not be used in connection with the use of a logo that breaches or contributes to a breach of the AO requirements.
- (m) It may be applied by an AO or by other persons (s3(1) HA 1973).

APPEAL OPTIONS

The BHC is able to hear appeals from the refusal of an AO to hallmark an article, but there are no formal regulations made under HA 1973 that govern this process. The BHC has, however, issued guidelines that govern the appeals procedure (see the BHC pages at gov.uk for details). Such an appeal would need to be lodged within a reasonable period of time from the date of refusal and, in any event, within three months of the date of refusal.

There are no regulations or guidelines governing an appeal process from an AO's decision to refuse to register a trade mark as an SM. Nonetheless, several conversations I have had with assay masters and the solicitor for the BHC suggest that, should an appeal be required against an AO's refusal to register an SM, the BHC is likely to adopt the same appeals procedure as for refusal to hallmark an article.

An appeal against the decision of the BHC to uphold the decision of an AO to refuse to hallmark an article, or to refuse to register a mark as an SM, would be by way of judicial review under the requisite and applicable principles, legislation

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There are surprisingly very few trade marks registered as SMs at the four UK AOs: London, Sheffield and Edinburgh report less than one per cent, and Birmingham reports none

and civil procedure rules governing judicial review.

TACTICAL CONSIDERATIONS

There are surprisingly very few trade marks registered as SMs at the four UK AOs: London, Sheffield and Edinburgh report less than one per cent, and Birmingham reports none. Instead, a large number of manufacturers of articles of precious metals choose to add their logo, design or trade mark as an additional mark alongside the hallmark. Such a mark is not part of the official hallmark and so has to be sited away from it. Yet this is a tactical decision, which must turn on the respective benefits of the protection afforded.

A logo/design/trade mark that is not registered as an SM and is copied and/or used without the consent of the owner would allow for the pursuit of offences under the Trade Marks Act 1994 (TMA 1994), the Copyright, Designs and Patents Act 1988 and the Registered Designs Act 1949, but not for unauthorised use of the logo/design/trade mark under HA 1973.

Proceedings brought for the infringing and/or unauthorised use of a registered trade mark under s10 and/or 92 TMA 1994 where a trade mark is used on a hallmarked article and extraneously to the hallmark will

present the usual challenges to the trade mark's validity and genuine use, should either of these matters be raised as defences in any such proceedings.

However, if a registered trade mark is also registered as an SM, unauthorised use of it under HA 1973 is unlikely to risk the complete or partial loss of the registered trade mark – a risk it could face under TMA 1994. Such a trade mark would also benefit from the concise and straightforward protection regime provided to it by HA 1973, under which it is an offence “to strike an article with a mark purported to be an SM without authority” (s3(8)). This provision requires only proof of the striking of the SM in the absence of authority in order to be established. The common-law remedies under the law of passing off of both the registered SM and/or the logo/design/trade mark (whether registered or unregistered) would also remain available. ■



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Iraq's new rules for pharma marks

Firas Qumsieh outlines the added demands now placed on class 5 filers

On 3 April 2016, the Iraqi Ministry of Health sent a new regulation to the Trademark Office in the Ministry of Industry and

Minerals requesting that all trade mark applications in class 5 should contain the following information to proceed to registration:

- scientific name of the product;
- trade name of the producer;
- pharmaceutical formula of the product;
- name of manufacturing company if not the applicant; and
- name of local distributor, if any.

The above information was required by the Department of Technical Issues for the purpose of endorsing new pharmaceutical products in Iraq. However, in August 2016, the Department amended that regulation so that this requirement is now only relevant for applications filed in class 5-a (since Iraq follows a multi-class filing system and each class is divided into sub-classes).

The system is expected to be similar to that of Syria, which imposes filing requirements that are specific to class 5. The Trademark Office, in cooperation with the country's Ministry of Health, will decide upon the underlying applications before they are placed for examination.

Accordingly, it is expected that applications will be rejected on formal grounds if the applicant fails to provide all the required information.

REQUIREMENT REMINDER

It may be useful to recap Iraq's general filing requirements:

- power of attorney legalised by the Iraqi Consulate – the legalisation stamp must appear on the back page of the document; and
- a legalised copy of the priority document if claimed.

The power of attorney can be submitted within six months of the filing date. Where multiple classes are filed, additional fees of \$75 apply for each sub-class, regardless of the number of classes involved.

NEW REGULATIONS

Earlier in 2016, the Trademark Registrar issued new regulations regarding the procedures of certain trade mark transactions, effective since 3 March 2016, as follows:

- When submitting applications for recordal of assignment, change of name and address, and merger, original copies of the required documents should accompany the application.
- A grace period of six months from the filing date is allowed for the late filing of the power of attorney with respect to new trade mark applications.



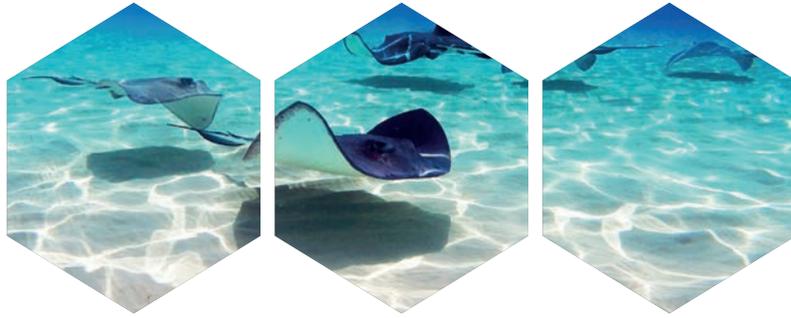
The system is expected to be similar to that of Syria

- It is no longer required to provide transliteration for non-Arabic trade marks. This will not affect previously filed applications, meaning that publication of pending applications will include the transliteration of the mark; additionally, renewal of expired trade marks will show the transliteration on the renewal certificate.
- Applicants are required to submit an examination request for each mark in each class (even if the mark is filed as a multi-class application) after payment of the prescribed fees. The examination result is expected to be issued within 10 days of the date of payment of the examination fees.
- The Registrar will inform the applicant if any sub-class gets refused. ■



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Cayman cuts loose

Independence is on its way for Cayman Islands trade marks, explains Katherine Van Deusen Hely

The Cayman Islands is shaking off its dependence on UK and EU trade marks and preparing to implement a fully independent, local system of trade mark registration.

On 31 August 2016, the Cayman Islands released to the public its proposed Trade Marks Bill, 2016. This bill provides for local registration of trade marks in the Cayman Islands. Once implemented, it will no longer be required nor possible to register a trade mark in the Cayman Islands on the basis of an existing UK registration, EU Trade Mark or international registration designating the UK. Until now, local registration of marks in the Cayman Islands was available only if a trade mark owner could present evidence of one of these three pre-existing registrations.

Although the current dependent path to registration in the Cayman Islands is relatively fast and straightforward, it has long been a point of frustration for brand owners without one of the prerequisite registrations. Of course, there are brand owners who do business in the Caribbean but not in the UK or EU. The Cayman Islands' existing system presents two options for such brand owners: acquire a trade mark registration for which they do not actually have a need (and which may present maintenance problems), or forgo registration in the Cayman Islands completely.

Because the jurisdiction is a hub for offshore financial services, tourism and a number of other industries, it is important that there is a framework of modern IP laws for brand owners. The proposed bill will implement the needed local trade mark system.

Of the six British Overseas Territories in the Caribbean (which also include Anguilla, Bermuda, the British Virgin Islands, Montserrat and the Turks and Caicos Islands), the Cayman Islands will be the last to adopt a local trade mark system. The other territories already provide either a fully independent system or a dual-registration system (meaning both local or UK-based registrations are available). The British Virgin Islands was the territory that most recently implemented a major update to its laws, replacing its dual-registration system with a local-only system last year.

Under the proposed Cayman Islands law, applications will be examined on the basis of absolute and relative grounds. Third parties will be able to oppose applications on various grounds during a 60-day period from publication of a mark. This is in stark contrast to the current practice, whereby opposition by third parties is not

possible. The bill does not speak specifically to Paris Convention priority.

Marks will be registered for an initial 10-year period, with renewal possible for successive 10-year terms thereafter. A six-month grace period will be allowed for late renewals. Annual fees are currently required to maintain one's rights in a mark and will continue if the proposed law is passed. The prior practice of paying the maintenance fees in advance was eliminated by the registry earlier this year. The proposed law will maintain the requirement of paying the fees only when due, between 1 January and 31 March of the year concerned. Fees paid after the end of March will be considered late, and a penalty will be imposed.

The bill contains minimal transitional provisions. Thus, it is not entirely clear how existing registrations would be treated under the new law. Mark holders and counsel must await the issuance of implementing regulations to learn more about how the transition will affect existing registrations and pending applications. Proposed regulations should not be expected before the bill passes the legislative assembly and gains the assent of the sovereign. ■



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CHOICE WORDS

Chris Hoole unearths two pearls among this year's sea of Nominet cases

Among the sea of Nominet decisions generated each year (in excess of 200 in 2016) there are always a few pearls. Nominet provides a table to assist in finding some of the most precious. In scouring the decisions, two cases immediately piqued my interest, both on appeal.

MARK OF POLO

The first, Polo Enterprises Ltd T/A Ascot Park Polo Club (Ascot) and Mr Nick Beitner, is an appeal decision concerning the domain names polo.co.uk and polo.uk. Ascot filed the complaint on 18 November 2015, and the Expert's decision was issued on 15 April 2016. Unlike UK courts, Nominet appeal proceedings (under paragraph 10a of the Nominet UK Dispute Resolution Service Policy) take the form of a full redetermination of the merits, and the appeal does not review the earlier decision in detail. We are told that the Expert, at first instance, found that Ascot had rights in the name POLO, which was identical or similar to the domain names, and

that they were abusive registrations. The Expert found in favour of Ascot and ordered the transfer of the domains. Beitner appealed.

Nominet's Dispute Resolution Service (DRS) is intended to provide an efficient, cost-effective alternative dispute-resolution procedure. For this reason, there is no operative provision for cross-examination of witnesses.¹ Submissions must therefore clearly address all the relevant facts and, where possible, refer to key documents. In this case, the Nominet appeal panel was critical of the "lengthy and repetitive" submissions filed by both parties, leaving the case, it said, "on the fringes of the scope of the DRS".

The case also rested on the determination of informal contractual dealings between the parties. This was frowned upon by the panel, which stressed that, unless the facts "speak for themselves", it should not feel obliged to reach a definitive answer. The ambiguity of the submissions was instrumental in the decision.

Turning to the facts, Ascot had operated a polo club since 1978. From

1994 to 2014, Beitner, whose background is in computer science, had been a member of the club. During this period, he received discounted membership fees, initially as a student. In 1995, Beitner filed to register polo.co.uk in the name of Ascot Park Polo Club. The name was changed to Polo Enterprises Ltd in 2011, and then to Beitner's own name in 2013. For most of this time, the website was dedicated to Ascot Park Polo Club. The polo.co.uk extension was also used for the club's email addresses.

Ascot had never paid any renewal fees for the domains, but Beitner had never sought to charge for them. Interestingly, correspondence showed that Ascot often asked Beitner to arrange the renewal of all Ascot-owned domains, including the POLO domains. Beitner never questioned ownership. However, on 12 June 2015, Beitner wrote to Ascot stating that he would be prepared to allow Ascot to continue using the domains "on the proviso that [his] outstanding [membership] balance of £365" was waived. This letter led to the dispute.

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The Dispute Resolution Service is not equipped to, nor intended to, replace the UK court system, where oral evidence can be scrutinised and cross-examined

In support of the complaint, Ascot argued that there had been an offer (by Beitner to register the domains), acceptance (agreement by Ascot to register), intention to create legal relations (both parties in business) and consideration (discounted polo services). In reply, Beitner argued that the web services and discounted fees had not been based on a contract, but on “friendship and goodwill”.

While email exchanges appeared to illustrate that Ascot believed it owned the domains, such as during renewal, the position was inconclusive on paper. As such, the appeal panel was unable to reach a definitive view on either explanation. Consequently, it found that Ascot had not discharged the burden of proving on the balance of probabilities that the domain names were abusive registrations.

The panel did not order the transfer and concluded that finding “in favour of the Complainant and accepting its case would in effect amount to the panel concluding that the Respondent was lying”. It added that, while a panel “can make such a finding in clear cases ... it should be cautious of doing so where matters are complex and different scenarios exist, particularly ... on inference ... [The DRS] is inherently unsuitable for deciding disputed questions of truthfulness.”

In other words, the DRS is not equipped to, nor intended to, replace the UK court system, where oral evidence can be scrutinised and cross-examined. Unless arguments can be presented cogently with factual evidential support, the DRS may not be the appropriate forum. Choose wisely.

ON YOUR BIKE

The Bicycle Association of Great Britain Ltd (BAGB) and Identity Protect Ltd (IDP) is an appeal decision concerning the domain names bicycleassociation.co.uk and bicycleassociation.uk. At first instance, the Expert found that the BAGB had rights in the mark and that the domain names were abusive registrations.

IDP, a privacy provider, was the named Respondent in the proceedings, but was not the owner of the domains. It had transpired that the owner was C 2 Zero Ltd, a company that manages a bicycle trade association called the Association of Cycle Traders Ltd (ACT). The web of ownership took some unwinding, since, behind IDP, the named owner was actually a five-year-old boy. The conduct of the ACT and C 2 Zero was scrutinised by the Nominet appeal panel as the organisations standing behind the domains.

Both ACT and the BAGB have represented the cycle industry in the UK since around 1970. In fact, they are the only two organisations of this kind in the UK. In 2004, the BAGB registered and used the domain bagb.com, and latterly (since 2012) the domain bicycleassociation.org.uk. ACT had for many years used the domain theact.org.uk, but in 2010 it registered bicycleassociation.co.uk (bicycleassociation.uk was registered in 2014). From 2016, theact.org.uk redirected to bicycleassociation.uk.

In support of its response, the ACT argued that it was only in 2012 that the BAGB had begun marketing itself as the “Bicycle Association”, which, the

ACT argued, was also a generic term. On the evidence, however, the panel found that the BAGB had done enough to acquire unregistered rights in the mark BICYCLE ASSOCIATION, irrespective of whether those rights began in 2012 or earlier (it is only required to prove rights at the time of the complaint). The BAGB was the only organisation using this name.

Turning to whether the registrations were abusive, the panel concluded that, as the only two trade associations in their industry, the ACT must have known of the BAGB when it registered the domains. The ACT must therefore have appreciated that this was confusing. In any case, when the BAGB came to use the domain names in 2016, the ACT must, at least at that point, have appreciated the likelihood of confusion with the BAGB, whether a user had searched via a search engine or by guessing the appropriate domain name. Ultimately, the panel found that, at least from 2016, the registration of the domain names was abusive. Any actions prior to this date were redundant. The domains were transferred to the BAGB.

This case is important, as it illustrates that a registration of a domain, while it might predate the rights of a complainant, can become abusive through later use if deployed in a manner that takes unfair advantage of, or is unfairly detrimental to, the complainant’s rights. ■

1. We are told that paragraph 14a of the Nominet Dispute Resolution Service Procedure provides for the possibility of an in-person hearing in exceptional circumstances, but this has never been implemented.



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Not in my name?

Joel Smith examines the dangers of contracting to sell your brand when your own name is part of the package

TO PROVIDE A brief background to this case, Karen Millen (the Claimant) started a fashion business in 1981 and traded under the mark KAREN MILLEN. In June 2004, the Karen Millen business was sold by way of a share purchase agreement (SPA). The SPA contained a number of restrictive covenants as to the Claimant's future conduct, as well as a further assurance clause.

Among other things, clause 5.1.7 of the SPA prohibited the use of the name "Karen Millen" or any other name "confusingly similar". The further assurance clause imposed on the parties an obligation to do or procure the doing of such acts as reasonably necessary to give "full effect to the SPA". The parties also submitted to the jurisdiction of the English courts.

In 2011, the Claimant held a press interview, stating her intention to return to the fashion business under the name "Karen". Proceedings were brought in the UK concerning the Claimant's intentions in the UK. Under a later settlement agreement in 2015, the Claimant agreed not to use the marks KAREN or KAREN MILLEN in the UK and the EU. The settlement, however, did not address the position in the US or China.

In October 2014, the Claimant sought declaratory relief from the High Court that certain acts would not breach the SPA, including:

- carrying on a business under the name KAREN MILLEN in relation to homeware in the US; and
- using the mark KAREN in respect of any goods and services.

DECISION

The approach of the English courts to contractual interpretation emphasises the importance of the language used by the parties

in the contract; this is an objective test, based on what the reasonable business person – with all the background knowledge that would reasonably have been available to the parties – would have understood the parties' intentions to have been at the time (see *Rainy Sky v Kookmin Bank*¹, and *Arnold v Britton*²). These are the key principles upon which the Court relied when interpreting the scope of the restrictive covenants in the SPA.

As for declaratory relief, it needs to serve a useful purpose, and the court must be in a position to make a decision with clarity across the whole scope of the relief sought.

RESTRICTIVE COVENANTS

The Court found that the use of KAREN MILLEN for homeware would breach the SPA, since consumers who observed the Claimant's homeware products might think they originated from the same person as Karen Millen clothing.

Although the Karen Millen business sold a range of goods other than women's clothing (such as belts, bags, scarves and footwear) and had never expanded into homeware, the Court

reasoned that there was an underlying business objective to continue to expand the portfolio of products, as well as the global reach of the brand. The Court also considered the extensive debate between the parties about whether "Karen Millen" was a "bridge luxury" brand, a "niche specialist retailer" brand or a "lifestyle" brand, and concluded that consumers

This is another instance of an entrepreneur selling their original business and then later being prevented from using their own name



would be aware that fashion brands often expand to associated products or businesses. The Court further agreed with the Defendants that there was a “natural connection” between fashion and interiors, in the sense that both are “about colours and proportions”, and that consumers would not necessarily know a business’s full range of products.

Regarding the use of KAREN (with or without stylised elements), the Court acknowledged that “Karen” is an ordinary female name and it was the combination with MILLEN that gave the mark its distinctiveness. However, the Court refused to grant any declaratory relief.

While the Court was satisfied that the declaration sought by the Claimant would probably have served a useful purpose, it was unable to determine and address the claim in its full scope, as the declarations sought were not clear or specific enough. A negative declaration could only be granted where the “underlying issue is sufficiently clearly defined to render it properly justiciable”. The Claimant’s very broad descriptions of goods and services left too much uncertainty.

The Court seemed reluctant in reaching this decision, emphasising that this aspect of the claim could have succeeded if only the Claimant had defined the intended use in more specific terms.

FURTHER ASSURANCE

The Court held that the Claimant was required to execute documents to consent to the KAREN MILLEN trade mark applications filed by the Defendants in order to give “full effect” to the further assurance clause in the SPA. In fact, the Defendants’ action in seeking and maintaining trade mark applications in the US and China was an “important, natural and foreseeable way of putting the SPA into effect”.

FAMILIAR DILEMMA

Overall, Mr Richard Meade QC, sitting as a Deputy Judge of the High Court, held that the SPA barred the Claimant from using KAREN MILLEN or any other “confusingly similar” name in connection with any business that is “similar to or competes with” the Karen Millen business.

The decision reiterates that applications for negative declarations will be carefully examined by the courts and that applicants should be very careful when framing the scope of the declarations sought.

More importantly, this is another instance of an entrepreneur selling their original business and then later being prevented from using their own name for a new venture. This decision serves as a useful reminder that, when entering into restrictive covenants in relation to IP rights, the individual should think carefully about what plans it has for expansion of the brand or launch of a new business, even if remote at the time. Clearly, there is the option to start a new venture under a different mark – a difficult choice given the sense of attachment that often comes with building a brand under one’s own name. Alternatively, the individual should attempt to retain ownership of its trade mark and license it out to a partner where necessary. However, few purchasers would agree to the acquisition of a business that did not include ownership or broad access to valuable brands.

KEY POINTS

- ▶ Declaratory relief must serve a useful purpose
- ▶ The Court could not address declarations sought by the Claimant, as they were not specific enough
- ▶ Individuals should consider future plans carefully before agreeing to covenants that restrict IP rights

1. [2011] UKSC 50.
2. [2015] UKSC 36.



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Court provides fee clarity

This case offers useful guidance on the question of what payment is required on issue of a claim, writes Chris Morris

TRADE MARK INFRINGEMENT (and other IP) claims are split into two elements: liability and quantum. A quantum assessment will not be carried out until liability is established, so the actual value of claim will be unknown at the outset of an action. Following changes, however, which mean that fees can be as high as £10,000 for a claim greater than £200,000, but just £528 for a non-monetary issue, this lack of initial certainty has become a very important concern.

CLAIM COMPARISON

In the case at issue, an initial claim was brought in respect of both trade mark infringement and inducing a breach of contract. The Claimants paid the non-monetary issue fee (then £480). The Defendants asked for the claim to be stayed until the Claimants paid the correct fee.

The Claimants sought an order for “payment of all sums due by way of an inquiry as to damages or at the Claimants’ option an account of profits” with an undertaking that they would pay the appropriate court fee if they succeeded on liability. This was expanded in the particulars to confirm that the relief sought was:

1. an inquiry to damages for the inducement to breach claim; and
2. an inquiry to damages, or alternatively an account of profits for the trade mark claim.

The Claimants argued authority suggested that account of profit claims are non-monetary and, as such, only the lower fee was payable (as in *Page v Hewetts Solicitors*¹).

Following a case management conference, Master Clark issued a decision on the Defendants’ application. She found that “the fact that an inquiry requires an assessment by the court as [to] the amount of damages is not sufficient for it to be a non-money claim.” On that basis, the claim should be stayed, because the correct fee had not been paid in respect of the breach of agreement claim.

However, Master Clark went on to consider the position had the claim been for trade mark infringement alone. In that scenario, she found the appropriate fee had been paid. Agreeing with *Page v Hewetts Solicitors*, ie that an account of profits is a non-monetary claim, she decided that “it is a process by which the court investigates whether the defendant has in fact made any profits from his wrongdoing to which the claimant is entitled. The result of the process may be a finding that the defendant holds no profits and no monies are payable.”

The fact that a claim to an enquiry to damages was included as an alternative does not matter. While the court fee schedule is not easy to construe, she continued, “it would be anomalous if a claimant with sufficiently early information about the defendant’s activities to enable it to elect for an account of profits in its claim form could pay only [the lower non-monetary fee], but a defendant without that information must pay the higher fee. Further, the two forms of relief are not mere alternatives, but are mutually exclusive; and it is not until a claimant elects for an inquiry (which it may not do) that it can be said that its claim is to recover money.”

PRACTICAL APPLICATION

The approach taken in this case should mean that, in purely IP cases, claimants will be able to bring cases without having to pay potentially very high fees at the beginning of a claim whose true value is unknown.

KEY POINTS

- ▶ Master Clark found that an inquiry requiring an assessment of the amount of damages is not a non-monetary claim
- ▶ She clarified that account of profits claims are non-monetary

1. [2013] EWHC 2845 (Ch).



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Sweeping conclusions

Nick Bowie looks at a fast-track case that focused on two Sooty sole traders

THIS CASE CONCERNS a fast-track opposition filed by Reece Vernon Forbes-Sinclair (the Opponent) on the basis of Section 5(2)(b) of the Trade Marks Act 1994, claiming a likelihood of confusion with his earlier UK trade mark registration for SOOTY THE SWEEP, covering chimney sweeping in class 37.

The opposition was directed against UK trade mark application No 3138684 (SOOTY AND SWEEP), filed by All UK Ltd (the Applicant) covering identical class 37 services. Neither party was professionally represented.

COMMON ARGUMENT

The allegations of similarity between the respective marks and the respective services were not denied. The Applicant did, however, assert that several sole traders use the names “Sooty the Sweep” and “Sooty and Sweep” in connection with chimney-sweeping services.

Rules 20(1)–(3) of the Trade Marks Rules 2008 (which address filing evidence) do not apply to fast-track oppositions. However, rule 20(4) does, and requires parties to seek leave in order to file evidence in fast-track oppositions, other than proof of use evidence.

The Applicant did not seek leave to substantiate its argument that “Sooty the Sweep” is a common term in the trade. Nor did the Opponent seek leave to support the claim he had spent “tens of thousands of pounds in advertising ... to promote ... our brand”. Thus, the Hearing Officer was limited to considering inherent characteristics.

The Applicant submitted there could be no likelihood of confusion, given the Applicant’s and Opponent’s respective operations were 200 miles apart. However, the rights conferred by a UK trade mark registration extend throughout the UK, such that arguments relating to use are not pertinent.

The established tests were applied in finding a high degree of similarity between the respective marks, and a high degree of identity

between the respective services. The average consumer (homeowners and/or landlords who have wood- or coal-burning fireplaces) was deemed to have a higher than average level of attention. As “Sooty the Sweep” alluded to the Opponent’s services, it held a moderate degree of distinctive character. Even allowing for the earlier sign’s moderate distinctive character and the average consumer’s higher than average level of attention, the Hearing Officer held that the differences in the marks would go unnoticed by a significant portion of the relevant public.

Thus, the Hearing Officer found a likelihood of confusion and refused the application, making an award of costs in favour of the Opponent in line with Tribunal Practice Notice (2/2015).

PROCEDURAL CONSIDERATIONS

This case does not represent a significant departure from established case law. However, it does point out some of the procedural considerations of fast-track proceedings – namely, the need to seek leave to file evidence not related to proving use of an earlier registration older than five years.

It is also a reminder that a trade mark registration confers rights throughout the UK, leading to notional comparison of goods and services rather than use.

As an aside, one might question the wisdom in arguing that both the Opponent’s and Applicant’s signs were in common use before the filing date of the Opponent’s earlier registration, effectively exposing the Applicant to future challenge on absolute grounds.

KEY POINTS

- ▶ The Applicant argued the distance between operations negated likelihood of confusion. However, a UK registration’s rights extend across the UK
- ▶ Parties are required to seek leave to file evidence in fast-track proceedings



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Appearance is everything

It seems that visual distinctiveness is as important in the trade mark world as in the cosmetics industry, says Amy Wood



ON 27 AUGUST 2010, L'Oréal designated the UK under International Registration No 1020177 (INOA) for various cosmetic goods in class 3, including shampoos, cosmetic hair products and hair dyes.

In January 2011, this application was opposed by Cosmetica Cabinas SL (the Opponent) on the basis of EU Trade Mark No 2720811 (AINHOA), registered for cosmetic products in class 3. The Opponent invoked Section 5(2)(b) of the Trade Marks Act 1994, claiming that, due to the similarity of the marks and identical nature of the goods, there was a likelihood of confusion.

The goods in question were held to be everyday consumer goods aimed at the general public and haircare professionals. The level of attention paid by the general public was held to be at least average, considering that many consumers weigh up various factors, such as ingredients, scent and suitability to hair and skin types, before purchasing. In comparison, professionals would likely pay more attention, as they would also consider business needs.

The Hearing Officer did not undertake a full comparison of the goods, proceeding instead on the assumption that all of the contested goods were identical to those covered under the earlier trade mark – the Opponent's "best case".

STRIKING IMPRESSION

While the Hearing Officer felt that the marks were of medium aural similarity when considered from an English language perspective (as would be the case), the visual differences between the marks were held to create a "striking impression" – particularly due to the placement of the characters and the different letters at the start of the marks. Conceptually, as both were likely to be seen as invented marks, the position was neutral.

Aside from stating in its Statement of Grounds that the marks were "phonetically

and visually similar", the Opponent did not later substantiate its arguments as to the visual similarities. This was perhaps to the Opponent's detriment, as L'Oréal argued that the visual comparison should be given more weight, submitting that the usual method of purchase for the goods meant it was very much a visual purchase.

Agreeing with this line of argument, the Hearing Officer also held that, while professionals would be more likely to order over the phone (increasing the importance of aural similarities), this would be offset by the fact they would likely pay more attention, and so there was less risk of confusion. Accordingly, the opposition was dismissed.

INDIRECT ISSUES

The possibility of indirect confusion was also considered. The Hearing Officer felt, however, that there were no instances whereby a common element or theme would lead the purchaser to believe that the mark applied for was another brand, or a brand extension, of the Opponent.

This case reiterates the importance of how goods are sold to the average consumer. Effective consideration of this point in this instance meant that more weight was given to the visual differences between the marks.

There are ongoing EU opposition proceedings involving these parties. So, while L'Oréal may have temporarily succeeded in brushing off Cosmetica in these UK proceedings, the companies are still splitting hairs at EU level.

KEY POINTS

- ▶ The Hearing Officer found the visual differences between the marks at issue to be "striking"
- ▶ How the goods were sold – in this case visually – determined the finding in favour of the Applicant



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Third time not lucky for Trinity

Repeated attempts to block a fashionable mark were ultimately unsuccessful, reports Emily Gittins



IN THIS DECISION, the EU General Court (GC) ruled that the EU Trade Mark (EUTM) VOGUE (the Contested Mark, shown right) was not descriptive, devoid of distinctive character or applied for in bad faith.

Advance Magazine Publishers, Inc (the Intervener) is the holder of the Contested Mark, registered in relation to various beauty and baby-care products in class 3. Trinity Haircare AG (the Applicant) filed an application for a declaration of invalidity relating to the Contested Mark. The Cancellation Division rejected the application, and the Board of Appeal (BoA) dismissed the Applicant's subsequent appeal. The Applicant further appealed to the GC.

LINK LACKING

It was not disputed that the relevant public was the average English- or French-speaking consumer who is reasonably well informed, observant and circumspect. The GC agreed with the BoA that, in both French and English, the word “vogue” means “popularity, use or general acceptance; [and] popularity with the audience”. The GC also agreed that the Applicant had not demonstrated that “vogue” was used as a synonym for the expressions “in vogue” or “en vogue”, which mean “fashionable tendency”.

In finding that the Contested Mark was not descriptive of the goods at issue under Article 7(1)(c) of Council Regulation (EC) No 207/2009 (EUTMR), the GC said that there was nothing in the definition of “vogue” to indicate that it had a direct, concrete link with the goods in question that would enable the relevant public to perceive a description of any of the characteristics of those goods. The GC said that the characteristic function of beauty and baby-care products is care or beauty care, which does not fall within the area of fashion. As a result, it was hard to

see how “vogue” was descriptive of those products.

In relation to the contention that the Contested Mark was devoid of distinctive character under Article 7(1)(b) EUTMR, the GC found that, since the mark was not descriptive, the Applicant had erred in attempting to show that it was devoid of distinctive character on the basis of its allegedly descriptive nature.

BAD FAITH?

The third ground of invalidity on which the Applicant relied was that the Contested Mark had been applied for in bad faith under Article 52(1)(b) EUTMR. It argued that, between 1962 and 2003 (ie before the Contested Mark was filed), the Intervener had repeatedly submitted the mark VOGUE in a number of EU Member States for goods included in class 3 without having any intention of using them. The evidence submitted in support of this related to registrations for the word mark VOGUE and three figurative marks for VOGUE in a style different from that of the Contested Mark. The GC therefore found that there was no evidence of any repeated lodging of applications for the Contested Mark.

The GC went on to agree with the BoA's finding that submitting an application for an EUTM to obtain protection over and above that granted by national marks already registered in Member States is not, in itself, an act of bad faith.

► The Contested Mark

VOGUE

KEY POINTS

- VOGUE was deemed not to be descriptive of the characteristics of the goods in question
- Submitting an application for an EUTM to gain additional protection to that afforded by national marks was not deemed to be an act of bad faith



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Victoria victory

*Iram Zaidi summarises a decision
with a Spanish flavour*

THE EU GENERAL COURT (GC) has dismissed an action brought by Victor International GmbH (the Applicant) to annul EUIPO's decision to partially uphold an opposition to its EU Trade Mark (EUTM) application by the owners of the figurative mark VICTORIA (Figure 1). The GC confirmed that Gregorio Ovejero Jiménez and María Luisa Cristina Becerra Guibert (the Opponents) had genuinely used the mark despite the addition of figurative and word elements (Figure 2) in relation to "footwear (except orthopaedic)" in class 25. The GC also confirmed that there was a likelihood of confusion between the word mark VICTOR, sought for registration in relation to sports clothing and retail services, and the earlier Spanish mark containing the stylised text VICTORIA, registered in relation to clothing.

EARLY ACTIONS

On 7 July 2009, the Applicant filed an EUTM application for the word mark VICTOR in classes 25 and 35. On 18 December 2009, the Opponents, owners of the figurative mark VICTORIA, registered in class 25, filed a notice of opposition against the application. The Applicant requested that the Opponents furnish proof of use of the mark, and only use in relation to "footwear (except orthopaedic)" was provided.

EUIPO's Opposition Division partially upheld the opposition, finding the marks to be visually, phonetically and conceptually similar. It concluded there was a likelihood of confusion for the public in Spain with regard to the goods and services covered. The Applicant filed a notice of appeal, and, on 22 January 2014, EUIPO's Second Board of Appeal (BoA) dismissed the appeal with regard to the goods in class 25, finding that genuine use of the VICTORIA mark had been proved, and that the distinctive character of the earlier mark had not been altered. The Applicant appealed to the GC.

The GC upheld EUIPO's decision on all points, despite the Applicant's arguments that: the addition of a figurative element and colours

to the earlier mark in-market altered its distinctive character as it was registered; the evidence provided by the Opponents didn't establish genuine use of the earlier mark; and the BoA had erred in finding there was a likelihood of confusion.

First, the GC found that the addition of figurative elements and colour to the earlier mark enhanced its distinctive character, and that the relevant public would perceive the additions as purely decorative elements.

Second, it held that catalogues containing images of the products identified by codes, descriptions and colours corresponding to those used in invoices established a sufficient link between the mark and the products, and therefore indicated genuine use, despite the figurative mark not appearing on the goods.

Third, the GC found the goods in class 25 were identical, and there was a similarity between the goods and services concerned in classes 25 and 35, respectively "footwear (except orthopaedic)" and retail services. It held that the principles applicable to the comparison of the goods also apply to the comparison between goods and services, and that in this case they are complementary.

Finally, the GC confirmed that the signs were visually, phonetically and conceptually similar. On the basis of the above, the GC dismissed the action.

GENUINE USE

What is interesting here is the indication that the GC may be willing to find genuine use even if the evidence does not demonstrate use of the mark directly on the goods. It will, however, continue to assess the evidence in context and as a whole.



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► Figure 1

► Figure 2



KEY POINTS

- The addition of figurative elements and colour to the earlier mark enhanced its distinctive character
- The GC may find genuine use even where the evidence does not show use of the mark directly on the goods



The Court turns critic

In the EU, a sound mark didn't have a unique voice, writes Mathilda Davidson

BRAZILIAN TELEVISION CHANNEL Globo Comunicação e Participações S/A (Globo) has been refused registration of a sound sign, represented graphically by the musical notation shown right. Globo sought registration of the mark in classes 9, 16, 28 and 41, but EUIPO rejected the application on the grounds that the mark was “too banal” to be capable of distinguishing origin. Globo appealed, but the General Court (GC) has now dismissed its appeal and endorsed EUIPO’s view.

Globo appealed to the GC on two grounds: first, that the EUIPO Board of Appeal (BoA) had infringed its obligation to state reasons in relation to each of the relevant goods and services; and second, that EUIPO had erred in its assessment of the distinctive character of the mark under Article 7(1)(b) of Council Regulation (EC) No 207/2009 (EUTMR).

APPEAL DISMISSED

The GC dismissed the first argument quickly on the grounds that the goods and services concerned were sufficiently linked (“media for the dissemination of information electronically ... orally ... or by means of television”) so as to form a homogeneous category, entitling EUIPO to formulate a single conclusion based on the same ground for refusal.

The GC noted that, in the television and media sectors, it is common for the consumer to identify the origin of a product or service by a sound element or jingle. However, for registration, it is necessary for the relevant sign “to have a certain resonance which enables the target consumer to perceive and regard it as a trade mark and not as a functional element or as an indicator without any inherent characteristics”.

The GC went on to state that “a sound sign which did not have the capacity to mean more than the mere banal combination of notes of which it consists would not enable the target consumer to perceive it as functioning to

identify the goods and services at issue, since it would be reduced to a straightforward ‘mirror effect’, in the sense that ... it would refer only to itself and to nothing else. It would not therefore be capable of engendering in the target consumer a certain form of attention which would enable him to perceive that sign’s necessary identifying function.”

The mark applied for consisted of the repetition of a sound that resembled a ringtone, a sound sign characterised by excessive simplicity and not capable of conveying a message that could be remembered by consumers, with the result that they would not regard the sound as a trade mark, unless it had acquired distinctive character through use. Accordingly, the GC took the view that the Globo mark provided no indication as to commercial origin.

The fact that the mark has been registered as a sound mark in France and the US is irrelevant. The EU Trade Mark system is autonomous, and has its own rules and objectives that apply independently of any national system. The second plea was therefore also rejected and the appeal dismissed.

DISTINCTIVENESS HURDLE

The removal of the graphical representation requirement in the upcoming changes to the EUTMR has prompted speculation that more exotic marks, such as shape, smell, sound and colour marks, will become more common. This case demonstrates that any mark still has to overcome the distinctiveness hurdle, which is often the greatest challenge for exotic marks.

► The Globo application



KEY POINTS

- The GC found the Applicant’s sound sign too banal to indicate origin
- Distinctiveness is still a key hurdle for exotic marks, despite upcoming changes to the EUTMR



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Dog bone or dumb-bell?

The Court recognised commercial reality in coming to its decision, reports Richard May

IN 2002, HYPHEN GmbH secured registration of an EU Trade Mark (shown right) in classes 3, 5, 9, 24, 25 and 42 (the Hyphen Registration). In 2012, Skylotec GmbH applied to revoke the Hyphen Registration on the grounds of non-use. It was alleged that the Hyphen Registration had not been put to genuine use over a continuous period of five years. Instead, it was alleged that Hyphen had used three signs different from the form registered (the Hyphen Signs, also shown right), contrary to Article 15(1) (a) of Council Regulation (EC) No 207/2009.

EUIPO's Cancellation Division upheld the action for certain goods because of a lack of sufficient use. However, it dismissed the action for the remaining goods, finding the "banal decorative component" (ie the outer circle) in the Hyphen Signs did not alter the distinctive character of the Hyphen Registration. The Fourth Board of Appeal (BoA) disagreed, upheld Skylotec's appeal and revoked Hyphen's registered rights for the remaining goods.

The interpretation of Article 15(1)(a), which provides that use "in a form differing in elements which do not alter the distinctive character of the mark in the form in which it is registered" is sufficient to avoid revocation for non-use, was key in this case. The Cancellation Division observed that the question of whether a registration's distinctive character is altered turns on whether the added component is itself distinctive. The BoA found this approach incorrect; in its view, it is the distinctive or "distinguishing" character of the registration that is determinative.

The BoA also held that "distinctive character" within the meaning of Article 15(1)(a) refers not to a mark's ability to perform an origin function, but simply to its overall impression.

Subsequently, the BoA found that the Hyphen Registration was a mark of extreme simplicity that could be perceived as a dog bone or dumb-bell. The addition of an outer circle transformed the bone or dumb-bell into a button, and the original association

with a bone or dumb-bell in the registered form disappeared. Consequently, the additional circle component altered the "overall impression" produced by the signs.

BoA OVERTURNED

The General Court (GC) annulled the BoA's decision. It quickly dismissed the BoA's interpretation of distinctive character, reaffirming, using established case law, that distinctive character in this context means the ability of a mark to indicate trade origin.

The GC also made it clear that, when considering if the distinctive character of a registration has been altered, one must assess the distinctive character of the additional component on the basis of its intrinsic quality, as well as its position within the mark. Accordingly, the GC found that all three Hyphen Signs continued to draw distinctive character from the Hyphen Registration, which remained unaltered, although it did note that, in Sign 3, consumers' attention would be drawn to both the word and figurative elements.

PRACTICAL VIEW

The GC remarked that the purpose of Article 15(1)(a) is to allow right holders flexibility, and that strict conformity to the registered form would be impractical. It also observed that the scope of the provision is limited to situations in which the sign used differs from the registration only in "insignificant respects" and where the two are "broadly equivalent". This case provides further guidance on Article 15(1)(a) and how the GC is willing to consider the commercial realities of trade mark use.

► The Hyphen Registration



► The Hyphen Signs

Sign 1



Sign 2



Sign 3



KEY POINTS

- The BoA found the addition of an outer circle altered the distinctive character of the registration
- The GC affirmed that the question of whether a registration's distinctive character is altered turns on whether the additional component is itself distinctive



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Nina name holds sway

Sinéad Mahon discusses why a designer's surname held particular power



ON 17 FEBRUARY 2012, Arrom Conseil (the Applicant) filed an application for the figurative mark “Roméo has a Gun by Romano Ricci” (shown right) in classes 3, 25 and 35. On 7 February 2013, Nina Ricci SARL (the Intervener) filed a notice of opposition pursuant to Article 41 of Council Regulation (EC) No 207/2009 (EUTMR) based on earlier EU Trade Marks NINA RICCI and RICCI, which covered goods in class 25. On 13 February 2014, the Opposition Division rejected the opposition. On 11 April 2014, the Intervener filed a notice of appeal with EUIPO, pursuant to Articles 58 and 64 EUTMR, against the Opposition Division's decision.

BoA POINTS

On 13 April 2015, the Board of Appeal (BoA) upheld the appeal in part. It held that there were certain visual and phonetic similarities between the marks, since the earlier mark RICCI was entirely reproduced in the mark applied for.

The BoA considered the goods in class 25 to be identical. It considered there to be a low degree of similarity between the goods applied for in class 3 and the goods of the earlier mark in class 25, as fashion houses often diversify into perfumery. It held that there was a low degree of similarity between “presentation of goods on communication media, for retail purposes of footwear and clothing” in class 35 in the mark applied for and class 25 goods of the earlier mark.

The BoA found that there was a likelihood of confusion in respect of the identical and similar goods and services due to the overall similarities between the marks.

On appeal to the General Court (GC), the Applicant alleged infringement under Articles 8(1)(b) and 8(5) EUTMR. The GC rejected both pleas and agreed with the BoA's decision.

GC AGREEMENT

The Applicant alleged that the BoA only assessed the similarity of the dominant element of the mark applied for (ie “by Romano Ricci”) and underestimated the additional elements. The GC agreed with the BoA, and it was held that the element “by Romano Ricci” would be perceived as the house mark, which had an independent, distinctive position. It rejected arguments that the dominant element of the mark applied for was “Roméo has a Gun” owing to its position and size. Consumers would perceive the mark applied for to contain a reference to Romano Ricci as the author of the creative work “Roméo has a Gun”. The GC held that the additional elements of the mark applied for do not create sufficient differences to displace the similarity.

The GC upheld the BoA's decision that the relevant public was likely to make a connection between the two marks because of the reputation of the earlier mark NINA RICCI. The earlier mark enjoyed a reputation in the EU as a mark containing romantic concepts. As the mark applied for had a romantic connotation (a reference to Shakespeare), it was held that it would take unfair advantage of the reputation of the earlier mark. Despite the additional elements, the BoA was fully entitled to conclude that there was a likelihood of confusion in the marks at issue and the goods in question.

This decision is another example of the power of surnames in fashion. Trade mark owners should remember that a “dominant” element may not always be the most sizeable.

- ▶ The Arrom Conseil figurative mark



KEY POINTS

- ▶ The GC found the fashion designer's name to be the dominant element in the mark applied for
- ▶ Likelihood of confusion was established due to the reputation in the EU of two earlier Nina Ricci marks



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Punto di vista

*Désirée Fields explores global assessment
from an Italian point of view*

IN SEPTEMBER 2012, Excalibur City sro (the Applicant) filed two trade mark applications for MERLIN'S KINDERWELT, one for the word sign and one for a figurative sign including a stylised wizard, shown opposite. The applications covered a broad range of services in class 41, including education; training; entertainment and amusement games; and sporting and cultural activities.

In March 2013, Ferrero SpA (the Opponent) opposed both applications under Articles 8(1)(b) and 8(5) of Council Regulation (EC) No 207/2009 (EUTMR) relying on two earlier Italian registrations for KINDER, covering "education; providing of training; entertainment; sporting and cultural activities" in class 41 and "cakes, pastry, confectionery, cocoa products and chocolate" in class 30.

The Opposition Division rejected the opposition in respect of the word mark but upheld it in respect of the figurative mark. On appeal, the EUIPO Board of Appeal (BoA) upheld the decision in respect of the word mark and dismissed the appeal in respect of the figurative mark. The Applicant appealed both decisions to the General Court (GC).

ASSESSMENT CRITERIA
Giving its opinion, the GC noted that the likelihood of confusion

had to be assessed globally, according to the relevant public's perception of the signs and the goods and services concerned. Given that the Opponent had relied on Italian trade marks, the likelihood of confusion had to be examined from the point of view of the average Italian consumer.

The GC observed that the global assessment of the likelihood of confusion had to be based on the overall impression created by the signs, bearing in mind their distinctive and dominant components, while remembering that the average consumer would normally perceive a mark as a whole, rather than analysing its various details. In assessing the dominant character of the components of a composite trade mark, the GC needed to take account of the intrinsic qualities of each of these components by comparing them with those of other components, including their relative position in the arrangement of the composite mark.

Although the marks had to be compared and examined as a whole, the overall impression conveyed to the relevant public by a composite mark could, in certain circumstances, be dominated by one or more of its components. Only where all the other components of a mark were negligible could the assessment be carried out solely on the basis of the dominant element. Here, the GC found that none of the elements dominated the overall impression created by the marks applied for. The signs therefore had to be considered as a whole.

The GC noted that the words 'kinder' and 'kinderwelt' were German and had no meaning for the relevant Italian-speaking public

VISUAL COMPARISON

The GC found that the marks were not visually similar, notwithstanding that they both included the element “*kinder*”.

First, the respective signs were clearly distinguishable by their length; the marks applied for contained 17 letters and an apostrophe, whereas the earlier marks contained only six letters.

Second, the element “*kinder*” was merged with the element “*welt*” so that they had no specific independent existence. The elements had the same visual significance and formed a harmonious unit in which the two constituent elements had become barely perceptible, especially for the relevant Italian-speaking public. These special features showed that the element “*kinder*” was not simply attached to the element “*welt*”, and nor was it the dominant element. In respect of the figurative mark, the stylised font of the element “*kinder*” also meant that the mark applied for did not visually resemble the earlier KINDER marks, which were depicted in a traditional font.

Third, the element “*kinder*” in the marks applied for was merely part of the element “*kinderwelt*” and of no greater importance compared with the element “Merlin’s”. Visually, the element “Merlin’s” attracted the public’s attention first, so that the element “*kinder*” was somewhat neutralised. In the figurative mark, the element “Merlin’s” was visually the focal point, because it was prominently placed above the element “*kinderwelt*”. The graphical addition of a wizard supported the conclusion that the element “*kinder*” was neutralised, as the image would strike consumers first.

Fourth, the element “*kinder*” was found in the marks applied for in between two other elements, namely, “Merlin’s” and “*welt*”.

PHONETIC COMPARISON

Finding that the marks were not phonetically similar, the GC noted that, although the marks shared the same sequence of letters (to create the word “*kinder*”), they were not pronounced with the same rhythm or intonation. The earlier marks contained only two syllables, whereas the marks applied for had five, only two of which were shared. In addition, the element “Merlin’s” in the marks applied for was pronounced first and caught the attention of consumers first. Therefore, consumers

would attach most importance to it, and the element “*kinder*” was somewhat neutralised by the element “Merlin’s”.

CONCEPTUAL COMPARISON

The GC noted that the word elements “*kinder*” and “*kinderwelt*” were German terms that had no meaning for the relevant Italian-speaking public. Even if the element “Merlin’s” in the marks applied for had a certain evocative force and referred to the character of “Merlin the magician” or “Merlin the wizard”, it had to be considered that the element “Merlin’s” was accompanied by the element “*kinderwelt*” to form the expression “Merlin’s *kinderwelt*”, which had no meaning to the relevant Italian public. Moreover, regardless of whatever the evocative force of the element “Merlin’s” may have been for the relevant public, the element was not present in the prior marks, and the marks were therefore conceptually different.

Overtaking the decision of the BoA, the GC concluded that the respective marks were overall not similar and that the BoA had erred in finding that there was a likelihood of confusion under Article 8(1)(b) EUTMR. The GC found it unnecessary to examine the plea under Article 8(5), stating that the provision did not apply, as the respective signs were neither identical nor similar.

INSTRUCTIVE

This judgment is instructive as to how to assess similarities between two trade marks where one mark is a composite mark encompassing an earlier mark. It also highlights the importance of considering the meaning of trade marks from the point of view of the relevant public. In this case, while the comparison of the marks would have been slightly different from the point of view of a German-speaking public, it seems highly doubtful that the overall assessment would have changed the outcome. In other cases, an examination of the matter from the point of view of a different section of the public of the EU may lead to a different conclusion.

► The Applicant’s mark



KEY POINTS

- The Applicant’s and Opponent’s marks were found to be overall not similar
- The average Italian consumer constituted the relevant public, as the Opponent relied on earlier Italian marks



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On further thought...

Later evidence deserved a look, writes Chris Hawkes

SIX YEARS AFTER securing registration for the mark FITNESS, Nestlé's registration was attacked by European Food SA (EF), which sought a declaration of invalidity under Article 52(1)(a) of Council Regulation (EC) No 207/2009 (EUTMR).

However, EF's application for invalidity was rejected by the Cancellation Division, and its subsequent appeal was dismissed by the Board of Appeal (BoA). The BoA held that the burden of proof lay with the cancellation Applicant to establish that the grounds for invalidity applied at the date that the registered mark had been filed.

In its assessment, the BoA found that EF's evidence either post-dated the mark's application date or concerned the territory of Romania before its accession to the EU. Moreover, new evidence filed before the BoA that did relate to the relevant time period ("the further evidence") was rejected for being belated without being taken into consideration. The reasoning for this was based upon Rule 50(1) of Commission Regulation 2868/95 (EUTMIR), which provides that, in appeal proceedings, the BoA shall limit its examination to the facts and evidence presented within the time limits set.

EF appealed to the General Court (GC), seeking an annulment of the contested decision. EF's appeal was based upon three pleas, but ultimately the GC considered only its first plea regarding the BoA's refusal to take account of the further evidence.

THE EF POSITION

EF presented three main arguments: (i) the BoA had infringed Article 76 EUTMR by failing to examine facts of its own motion (including the further evidence), and that it has an obligation to do so in cases involving absolute grounds; (ii) Rule 37(b)(iv) EUTMIR does not expressly preclude the filing of additional evidence in invalidity proceedings; and (iii) Rule 50(1) EUTMIR concerns appeals from the Opposition Division and so is not applicable to invalidity

proceedings. EUIPO countered that Rule 50(1) is not a derogation from Article 76(2), which provides that EUIPO may disregard facts or evidence that are not submitted in "due time".

GC REACTION

In its judgment, the GC found that: (i) the BoA is not required to examine facts of its own motion; (ii) that Rule 37(b)(iv) does not specify when evidence in support of an invalidity action must be filed, or otherwise be considered belated, and that neither the EUTMR nor EUTMIR contains any provision setting a time limit for the production of evidence in invalidity proceedings; and (iii) that Rule 50(1) cannot apply as it expressly relates only to appeals against decisions of an Opposition Division.

Following this line of reasoning, the GC found that Article 76 does not expressly provide that evidence submitted for the first time in invalidity proceedings before the BoA must be regarded as being belated. Moreover, the further evidence in dispute went to the very heart of the key validity issues; it could have altered the substance of the contested decision. Accordingly, the GC found that a procedural irregularity had occurred; hence, it was proper for the BoA's decision to be annulled.

PROCEDURAL LESSON

The outcome of this case may surprise many practitioners and so it is useful in highlighting key procedural differences between opposition and cancellation proceedings before EUIPO. Most notably, it demonstrates that, in invalidity proceedings, it is possible to submit new evidence even at the later appeal stage.

KEY POINTS

- ▶ In invalidity proceedings, it is possible to submit new evidence even at the later appeal stage
- ▶ EUIPO's failure to take account of such evidence may result in the annulment of a decision on appeal, where the contested decision might have otherwise been substantively different



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Fair question

Punctuality, not nationality, was the issue, reports Rachel Garrod



ON 2 MAY 2013, University College London filed an application at EUIPO for CITRUS SATURDAY in class 25. Subsequently, Ana Isabel Pinto Eliseu Baptista Lopes Canhoto (the Applicant) filed a Notice of Opposition based on her earlier Portuguese registration for CITRUS in class 25.

The Applicant was required to submit a copy of the Portuguese registration certificate, together with an appropriate translation, in accordance with Rule 19 of Commission Regulation (EC) No 2868/95 (EUTMIR). The Applicant was granted additional time – until 12 May 2014 – to submit the documents. A copy of the requisite documents was sent on 7 May 2014, by way of registered letter, but received by EUIPO only on 21 May 2014.

The Opposition was rejected, as the Applicant failed to submit the documents within the prescribed time. An appeal filed by the Applicant was dismissed. The Applicant then appealed to the General Court (GC), based on two pleas, both of which were rejected.

DEADLINE DISPUTE

First, the Applicant alleged infringement of Rules 19 and 20 EUTMIR, and Article 76 of Council Regulation (EC) No 207/2009 (EUTMR). The Applicant argued that: the documents were sent before the deadline; the context in which they were sent justified the delay; and the Board of Appeal (BoA) should have examined the documents of its own volition.

The GC dismissed these arguments. It is irrelevant when the documents are sent – the critical date is when the documents are received by EUIPO. This is in line with the wording of Rules 19 and 20 EUTMIR. Furthermore, the GC found that the BoA must exercise its discretion in terms of Article 76 EUTMR restrictively, and may allow the late submission of documents only if the circumstances are likely to justify the delay. The Applicant had sufficient time to submit the documents and did not provide any reasons to justify the late submission. The

alleged postal constraints could not constitute exceptional circumstances capable of justifying the late submission of the documents.

Second, the Applicant alleged infringement of Articles 21, 41(1) and 47 of the Charter of Fundamental Rights of the European Union, and Article 18 of the Treaty on the Functioning of the European Union. The Applicant submitted that her right to an effective remedy and a fair hearing had been overlooked by EUIPO's refusal to examine the documents. Furthermore, she alleged discrimination on the grounds of nationality.

The GC stated that the Opposition Division's decision can either be revoked or annulled under appeal in terms of the EUTMR, which protects the Applicant's right to an effective remedy. The GC further excluded the possibility of relying on the right to a fair "trial" since proceedings before the BoA are administrative not judicial.

COURT CONCLUSION

The GC highlighted that the Opposition was rejected only because the documents were submitted after the expiry of the prescribed period. This fact was completely unrelated to the Applicant's nationality; time limits apply regardless of where a party is based. The Applicant could also have sent the documents electronically or by other means to ensure that they were received on time.

Although it may leave a bitter taste for the Applicant, this outcome provides a useful reminder that the basic requirements must be met in opposition proceedings, and a deadline is met only once the necessary documents are lodged with (ie received by) the office.

KEY POINTS

- ▶ The Opposition was rejected, as the Applicant failed to submit the supporting documents within the prescribed time
- ▶ Alleged postal constraints did not constitute exceptional circumstances capable of justifying the late submission



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Court backs Benelux

Rebecca Heard unravels a question of jurisdiction intersection

WHERE SHOULD AN action to invalidate a Benelux trade mark be brought? This case, a referral from the District Court of The Hague in the Netherlands, considers this and relates to the interaction between the first Brussels Regulation 44/2001 (Brussels I) and the Benelux Convention on Intellectual Property (BCIP). Under Article 22(4) of Brussels I, actions in respect of the validity of a trade mark needed to be brought in the Member State where the mark was registered.

QUESTION OF JURISDICTION

Luxembourg entity Brite Strike Technologies SA (BS LU) was a distributor for US entity Brite Strike Technologies Inc (BS US). BS LU registered BRITE STRIKE in Benelux. BS US consequently brought revocation proceedings in the Netherlands on the grounds of bad faith. BS LU argued that it should have been sued in Luxembourg. The CJEU was asked to decide whether the Brussels I rules prevailed or the BCIP rules could continue to be applied.

In responding to this question, first the CJEU noted that the answer would have been simple had the BCIP appeared in the list of conventions in Article 69 of Brussels I, which would be unaffected by the Brussels Regime. However, as the BCIP postdated Brussels I, it is not surprising that it did not. Therefore, the CJEU looked to Article 71 of Brussels I, which provides that the Brussels I rules are not intended to affect other conventions to which Member States are parties in relation to particular matters.

Second, Article 350 of the Treaty on the Functioning of the European Union (TFEU) provides that EU law does not preclude the Benelux countries from completing the union between them. This has been held by the CJEU

to include permitting the Benelux countries to derogate from the EU rules where the Benelux union is more complete than the EU as a whole. This was persuasive authority that the BCIP rule could be allowed to exist notwithstanding the Brussels I rule.

Third, the CJEU saw that the EU itself had derogated from Article 22(4) of Brussels I with respect to the EU Trade Mark jurisdictional rules, whereby a *sui generis* jurisdictional system was set up. Permitting the BCIP to have its own jurisdictional rule in respect of its trade marks could not, therefore, be said to be too dangerous or damaging.

BCIP PREVAILS

The CJEU ruled that Article 71 of Brussels I, read in the light of Article 350 TFEU, does not preclude the application to those disputes of the rule of jurisdiction for disputes relating to Benelux trade marks and designs laid down in Article 4.6 BCIP. In short, Article 4.6 BCIP prevails.

As the District Court of The Hague already considered in its referral decision, if Article 4.6 BCIP prevails, that Court would not be competent, as BS LU has no address for service in the Netherlands (but does in Luxembourg). Also, there is no place where the obligation in dispute has arisen in the Netherlands (ie there was no infringement claim in the Netherlands or elsewhere).

KEY POINTS

- ▶ The CJEU was asked whether Brussels I or BCIP prevails in determining where proceedings related to a Benelux mark should be brought
- ▶ It found that Brussels I does not preclude the application of the rule of jurisdiction related to disputes over Benelux marks set out in Article 4.6 BCIP



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Rebecca thanks Hidde Koenraad, Partner at Simmons & Simmons' Amsterdam office, who contributed significantly to this article.



Final thoughts on Pensa

Thomas Hooper offers an assessment of a prolonged and complex opposition project



THE CJEU HAS dismissed an appeal brought by Pensa Pharma SA in which it attempted to have the decision of the General Court (GC) set aside. Pensa had filed EU Trade Mark (EUTM) applications for the word mark PENZA PHARMA and the figurative mark PENZA (shown right) in classes 3, 5 and 44.

On the last day of the opposition period, Ferring BV and Farmaceutisk Laboratorium Ferring A/S filed oppositions against both applications on the basis of their earlier registered national trade marks for the word mark PENTASA, covering “pharmaceutical preparations” in class 5. The oppositions were later withdrawn, and invalidity actions were filed against a slightly narrower range of goods and services. EUIPO’s Board of Appeal (BoA) upheld the invalidity actions.

BoA REASONING

Although the earlier PENTASA marks were registered in a number of EU Member States, the BoA agreed with the Cancellation Division’s assessment that it was sufficient for a likelihood of confusion to be established in one single Member State for an EUTM to be declared invalid. The Cancellation Division’s assessment of confusion in Benelux and France was therefore perfectly sound. The relevant public consisted of consumers in those territories, and it was found that PENTASA had enhanced distinctiveness there. Further, the contested goods/services were either identical to “pharmaceutical preparations” or at least similar, so that a likelihood of confusion followed.

Interestingly, Pensa’s marks were registered following a coexistence agreement between the parties. Although consent to the registrations was argued, this had no bearing on whether a likelihood of confusion existed.

Following an unfavourable decision in the GC, each of the four grounds of appeal raised against the declaration of invalidity of the PENZA mark was dismissed without much ado.

Pensa requested that the earlier judgments be set aside and annulled on the basis that there had been a distortion of the legal context, facts and evidence that led the GC to uphold the earlier decision. However, the CJEU found that it was not clear what evidence had been distorted. An interesting point arose about whether the GC should have verified the validity of the earlier marks relied upon. However, whether two of the earlier registrations had expired before the BoA had assessed the appeal was not a plea relating to a matter of public policy that the GC should have examined by its own motion. Had it been raised earlier, or in an admissible manner, it might have been accepted and considered.

The CJEU also confirmed that new arguments submitted for the first time before the GC must be rejected as inadmissible. Further, it reiterated that the assessment of similarities between the marks was a factual issue, and it will not re-examine the GC’s visual, phonetic or conceptual comparison unless evidence and facts have been distorted.

CLOSING THOUGHTS

This case confirms that withdrawal of an opposition does not bar the original opponent from filing an invalidity action post-registration, even where there is a coexistence agreement in place. It is also yet another reminder to introduce early all facts and evidence for the BoA and GC to consider, ensuring that all grounds the parties wish to rely upon are in. Otherwise, unsurprisingly, they will be rejected.

► The Pensa mark



KEY POINTS

- An earlier coexistence agreement between parties was not relevant in assessing likelihood of confusion
- The Appellant argued that earlier evidence had been distorted, but the CJEU could not establish which evidence
- Evidence needs to be submitted early in the proceedings, and new arguments submitted for the first time before the GC will not be admissible



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Precision is required

The Court has called for complete clarity on territorial scope, says Catherine Byfield



THIS CASE INVOLVED a referral to the CJEU by the Düsseldorf Higher Regional Court regarding the scope of a prohibition order where the CJEU finds that there is a likelihood of confusion in some Member States but not others.

Combit Software was the proprietor of German and EU Trade Mark (EUTM) registrations for COMBIT for goods and services in the computer industry. Commit Business Solutions sold software under the mark COMMIT in a number of countries via its website.

Combit brought proceedings for trade mark infringement at the Düsseldorf Regional Court, seeking an order, on the basis of its EUTM, that Commit refrain from using COMMIT in the EU in relation to software; or, in the alternative, on the basis of Combit's German registration, that it refrain from using COMMIT in Germany. The Regional Court dismissed the first claim in relation to the EU, but upheld the second claim in relation to use of the COMMIT mark in Germany.

Combit filed an appeal with the Higher Regional Court, which found that there was a likelihood of confusion among German-speaking consumers, but not in relation to English-speaking consumers. The conceptual differences between the marks, which would be apparent to English-speaking consumers, were held to outweigh the phonetic similarities.

Given it had found a likelihood of confusion in respect of some Member States and not others, the Higher Regional Court was unsure about how to apply the principle of unitary character, as laid down in Article 1(2) of Council Regulation (EC) No 207/2009, in terms of the appropriate prohibition order referred to in Article 102(1) of the same regulation.

QUESTION REFERRED

In the assessment of the likelihood of confusion of an EU word mark, what is the significance of a situation in which there is a likelihood of confusion in respect of consumers from some Member States, but not in respect of consumers from other Member States? Two further questions arise:

- a) In assessing the likelihood of confusion, is the perspective of some Member States, of the other Member States, or of a fictive EU average consumer decisive?
- b) If there is a likelihood of confusion only in some Member States, has the EUTM been infringed across the EU, or must the Member States be differentiated individually?

CJEU RULING

Where an EU court finds that there is a likelihood of confusion in one part of the EU but not in another part, it cannot conclude that there is no infringement of the trade mark. The court must limit the territorial scope of the prohibition. It is important that the court identifies with precision the part of the EU where it finds there is no infringement, so that it is clear which part of the EU is not covered by the prohibition on use of the relevant sign.

Importantly, the CJEU stated that a prohibition regarding use of a sign that applies to the whole of the EU, with the exception of the part for which there has been found to be no likelihood of confusion, does not undermine the unitary character of the EUTM.

KEY POINTS

- ▶ Where an EU court finds a likelihood of confusion in one part of the EU but not another, it must limit the territorial scope of the prohibition
- ▶ EU-wide prohibition, with the exception of a part where there is no likelihood of confusion, does not undermine unitary character



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events

More details can be found at citma.org.uk

DATE	EVENT	LOCATION	CPD HOURS
10 January	CITMA North East Regional Talk Non-traditional trade marks	Leeds	1
24 January	CITMA London Evening Meeting*	Royal College of Surgeons, London WC2	1
25 January	CITMA Moot Trial	Bristows, London EC4	2
6 February	CITMA North East Regional Talk	Withers & Rogers LLP, Sheffield	1
21 February	CITMA London Evening Meeting*	Royal College of Surgeons, London WC2	1
22 February	CITMA Webinar	Log in online	1
23 February	CITMA Scotland Pub Quiz	Voodoo Rooms, Edinburgh	
15–17 March	CITMA Spring Conference* Navigating the Seas of Change	Hilton Tower Bridge, London SE1	9
15 March	CITMA Drinks Reception* Part of the CITMA Spring Conference	More, London SE1	
16 March	CITMA Gala Dinner and Drinks Reception*	<i>Cutty Sark</i> , London SE10	
29 March	CITMA AGM	London, venue to be confirmed	
25 April	CITMA London Evening Meeting*	Royal College of Surgeons, London WC2	1
16 May	CITMA London Evening Meeting*	Royal College of Surgeons, London WC2	1
14 June	CITMA Webinar	Log in online	1

SUGGESTIONS WELCOME

We have an excellent team of volunteers who organise our programme of events. However, we are always eager to hear from people who are keen to speak at a CITMA event, particularly overseas members, or to host one. We would also like your suggestions on event topics. Please contact Jane at jane@citma.org.uk with your ideas.

Our Spring Conference Gala Dinner will take place aboard the historic *Cutty Sark* in Greenwich. Register now at citma.org.uk

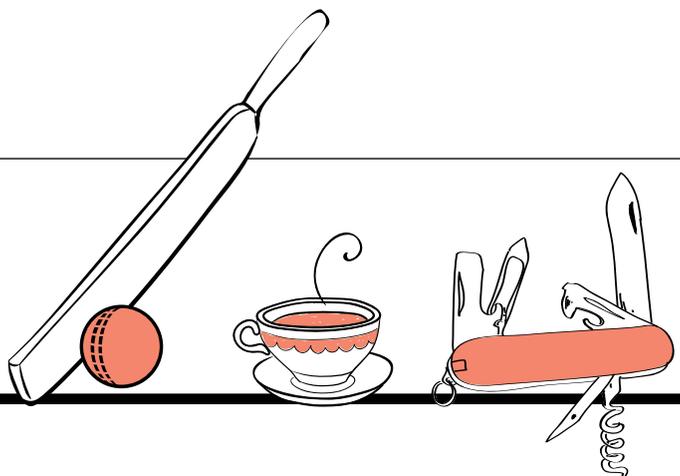


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THE TRADE MARK 20

Q&A



I work as... a Solicitor and Partner at Geldards LLP, in our Cardiff and London offices, specialising in all aspects of IP law, particularly contentious IP. I am also Chair of the CITMA Design and Copyright Working Group.

Before this role, I was... IP Partner at another leading firm in South Wales.

My current state of mind is... worried, about a number of things, including Brexit, Donald Trump, the future of the Labour Party, whether Portsmouth will manage to get promoted to League One this season, and the future for litigation in the UK.

I became interested in IP when... in the early 1990s, my previous firm asked if anyone would like to volunteer to retrain in the field. I had very little idea what IP was, but guessed it must be more interesting than acting for negligent conveyancers. Fortunately, I was correct.

I am most inspired by... the late David Sheppard, Lord Sheppard of Liverpool, because law, cricket and the Christian faith all play a part in my life. He studied law (and history) and played cricket for England while a student (later captaining his country). He was then ordained into the Anglican Church and became Bishop of Liverpool, where he worked tirelessly in fostering ecumenical cooperation, opposing racism and championing the poor and marginalised – antagonising Margaret Thatcher to such an extent that some believe it caused him to miss out on being appointed Archbishop of Canterbury.

In my role, I most enjoy... working on big cases with colleagues in a team to deliver a high-quality service to clients.

In my role, I most dislike... those (fortunately few) clients who try to avoid paying for the high-quality service they have enjoyed.

On my desk is... a mound of paper, which is made up of my own work documents, and articles and cases accessed online, all of which I print off to read/check. I expect that the younger people in the office think I am both mad and bad.

My favourite mug says... Villeroy and Boch (on the bottom).

My favourite place to visit on business is... London. While fun, each visit serves to reinforce my excellent decision to move to Wales 28 years ago.

If I were a trade mark/brand, I would be... Marks & Spencer: extraordinarily middle class, middle of the road, unthreatening, conservative (with a small “c”) and in tune with the interests of those of a certain age.

The biggest challenge for IP is... currently, in the UK, Brexit.

The talent I wish I had is... the ability not to worry so much about things.

I can't live without... my family: Liz, John and Catherine.

My ideal day would include... a walk in the sunshine to the cricket ground with my family and friends, and then a private box with food and drink on hand to accompany the match.

In my pocket is... a Swiss Army knife (bartender model), a handkerchief and some coins.



Meet the (maybe)
mad and bad
Michael Lindsey

The best piece of advice I've been given is... “Get a hobby; it's cheaper than therapy” – the immediate result being the area of earth that I dug in my back garden in which I try to grow vegetables each year.

When I want to relax I... cook, preferably with a glass of dry Riesling or pinot noir in hand.

In the next five years, I hope to... increase my woefully inadequate pension pot so that retirement might become a possibility before I am 80.

The best thing about being a member of CITMA is... qualifying to play for the CIPA-ITMA Cricket Club, involving winter nets at Lord's and the Oval, matches at Ally Pally and tours (which I am far too old to survive) to obscure destinations in the hope of finding opponents who can be beaten.

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