

CITMA REVIEW

ISSUE 442 JUNE 2018

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*Why AI could spell the
end for traditional legal
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WELCOME & CONTENTS



Tania Clark
CITMA
President

WELCOME to the June edition of the *CITMA Review*. In this issue, on page 17, we have included details of the top 100 filers (UK representatives) of UK and EU trade marks in 2017. This popular annual item has once again been compiled using data provided by Corsearch, with analysis from our editorial team. It is always interesting to see how we are faring against competitors and colleagues.

If you did not attend our Designs Seminar on 19th April 2018, there is a full report on page 6. Mr Justice Henry Carr provided us with his insight into trials involving registered designs and unregistered design rights, and other speakers included representatives from the UK IPO and WIPO. Our thanks go to David Stone of Allen & Overy, who chaired and hosted the event.

I hope to see you all at the President's Summer Reception at The Refinery Bar in London in July.

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Chief Executive's Bulletin

*Highlights from Keven Bader's
May message to members*

Strategic plan to bring better services

As a result of Brexit and a requirement in 2018 to change our customer database (CRM) and website (CMS) systems, the CITMA Council agreed, at the end of 2017, a one-year plan for 2018 that prioritises certain areas of work. The new CRM and CMS should enable CITMA to provide better services to members and make some processes a lot easier. For example, we will be introducing a facility for firms who pay the membership subscriptions for their employees to pay in one bulk transaction via the website, improving the public search tool and enabling members to control the information they wish to receive from CITMA.

In addition, we are focusing on developing an advanced competency framework for Chartered Trade Mark Attorneys and a competency framework for CITMA Paralegals. These will feed into creating a focused education and events plan for 2019, with a view to providing upskilling courses. We are also working on the continuing

professional development (CPD) guidance and rules for CITMA Paralegals and will look to publish these in good time before CPD becomes a requirement in 2019. The guidance and rules will largely mirror those in place for Registered Trade Mark Attorneys, which can be found on the IPReg website at ipreg.org.uk

We are also continuing our campaign to promote Chartered Trade Mark Attorneys and create business opportunities for members, and will be carrying out many other activities, such as delivering our educational and social events programme, promoting and supporting IP Inclusive and other corporate social responsibility initiatives, and providing newsletters and information to members.

DATA PROTECTION TAKES CENTRE STAGE

GDPR – in recent months, it seems as though those four letters have been everywhere, and quite rightly

too. The General Data Protection Regulation came into force on 25th May, and means that changes might need to be made in how you and your firm handle data you capture and process.

As there is no one-size-fits-all solution for organisations in becoming GDPR compliant, we encourage all members and their firms to make sure they have considered measures that may need to be taken, and certainly not to think that GDPR does not apply to them.

The Information Commissioner's Office (ico.org.uk) is continually updating its guidance on GDPR and has some useful tips on what changes GDPR will bring and how you can go about ensuring you are compliant. The Law Society has also published some information for law firms, which you may find of use, at lawsociety.org.uk

EUIPO INVOLVEMENT

As an official user association, CITMA is on rota to attend various

SUPPORT IP PRO BONO

The IP Pro Bono scheme continues to look for new firms to provide help and take on cases deemed eligible for assistance.

We would encourage as many firms as possible to help out and support the scheme, which can be beneficial for all those

involved. We know that the IPEC judges are very supportive and are continuously promoting IP Pro Bono.

Further information about what is involved can be found on the IP Pro Bono website at ipprobono.org.uk

DON'T MISS THIS

Our CITMA Summer Reception and welcome drinks for new President Tania Clark will take place on 4th July. Book now for this seasonal highlight in central London at citma.org.uk

EUIPO meetings as an observer in 2018. So far this year, Tania Clark and Kate O'Rourke have attended the Trade Mark Liaison Meeting, and in late May – around the time this issue lands – I will be attending the Management Board and Budget Committee (MB/BC) meetings. These meetings provide a valuable opportunity to hear the views of the national offices and EUIPO on all aspects of EUIPO's work and future plans. For example, at the MB/BC meetings, a shortlist of the candidates for the Executive Director position should be finalised and sent to the European Commission, which will make a decision on who will replace António Campinos as he moves to the European Patent Office.

EYES ON ICE

In March, Past President and Council member Catherine Wolfe and I attended the annual EUIPO User Group meeting. EUIPO provided updates on several areas of work, including convergence programmes, service/performance quality and anti-scam initiatives. We were invited to see a relatively new section called Initial Central Examination (ICE). The ICE is a team of 12 people who review 600

recently examined applications a day (looking at absolute grounds) and discuss borderline cases, referring their findings back to the original examiner. This has led to a reduction in errors and more consistency of practice, and EUIPO is looking to expand this into other areas, such as relative grounds, opposition proceedings and appeals.

ANTI-SCAM STATEMENT SIGNED

CITMA has joined the Anti-Scam Network, coordinated by EUIPO, and signed up to its Joint Statement. The network involves a wide range of organisations, including many national offices, and by working together it is hoped that fraudulent actions can be minimised, if not eradicated. See Kate O'Rourke's article on page 9 for details of where examples of misleading correspondence should be sent.

BREXIT WORK BRINGS AWARENESS

I hope you will have seen and read the updates on our Brexit work at our citma.org.uk news pages. We continue to probe several avenues regarding rights of representation before EUIPO, and will update members as and when there is any significant development. We have been pleased to see that many members have contacted their local MPs to raise awareness of the issue, and also that some MPs are sympathetic and supportive.

A reminder that we have an extensive Brexit resource section on the website at www.citma.org.uk/membership/brexit

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CITMA is on rota to attend various EUIPO meetings as an observer in 2018

MEMBER MOVES



Florian Traub

Pinsent Masons has appointed Florian Traub to establish its European Brand Portfolio Management team. Florian is a dual-qualified English Solicitor and German Rechtsanwalt.



Chris Morris and Michael Conway

Haseltine Lake has appointed Chris Morris and Michael Conway as Partners. They can be contacted at cmorris@haseltinelake.com and mconway@haseltinelake.com



Correction: Patricia Collis

Thomson Reuters has appointed Patricia Collis (Bird & Bird) as Co-General Editor. Her surname was incorrectly reported as Cullens in the March/April issue.

A DATE WITH DESIGNS

CITMA's April seminar provided a variety of views from both the bar and the bench

Report by Simon Bentley and Peter Brownlow



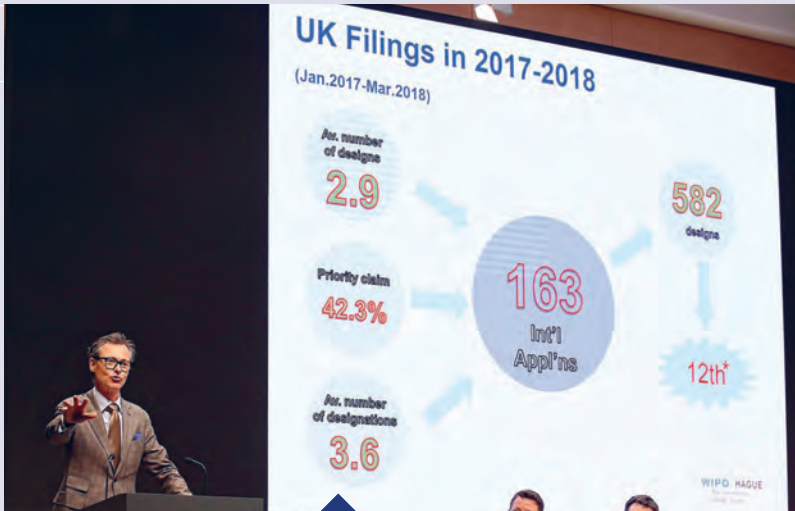
HAGUE PROCESS IN FOCUS

Nathan Abraham, the UK IPO's Head of Examination Practice, Trade Marks and Designs, discussed both the IPO's designs modernisation programme (DMP) and the consultation and legislative process that led to the UK's accession to the Hague system. The review of IP carried out in 2010/11 by Professor Ian Hargreaves described designs as "neglected", and the IPO was therefore keen to promote designs, given their importance to the economy – research shows that design-intensive UK businesses generate more than 11 per cent of UK GDP. The DMP has achieved success, with the number of UK registered designs filed increasing from 7,000 in 2015/16 to 22,000 in 2017/18.

The IPO's consultation of relevant stakeholders showed strong support for accession to Hague, and the UK's decision to leave the EU provided still further impetus for joining. Nathan set out the advantages and main features of Hague and outlined the choices the IPO had made in joining the system. He confirmed that the UK will not be a receiving office for Hague applications, so UK applicants will file directly at WIPO. The UK will be a Level 1 country, with the first design costing 42 Swiss francs (£30) and each subsequent design costing two Swiss francs (£1.50). Finally, the IPO has also decided that it will not republish Hague designs in the UK journal so that the process is as streamlined as possible.

The event, hosted by David Stone of Allen & Overy, attracted around 100 attendees for talks on the Hague system, as well as expert comment on recent design cases.





PRESSING THE BENEFITS OF PRIORITY

Grégoire Bisson of WIPO spoke about the Hague system and, in particular, those members, such as the US, Japan and Korea, that conduct fuller examination of new applications.

Between January 2017 and March 2018, UK applicants filed 163 Hague applications. While the figure is increasing, it is still significantly smaller than the number of applications from countries with comparable economies, such as Germany and France. Grégoire explained that, although designated countries cannot reject design representations on formal grounds, they can object if the representations in the application do not sufficiently disclose the design.

With close reference to the very useful guidance notes produced by WIPO, Grégoire discussed best practice for design representations and pointed to a number of recent success stories for UK applicants. He also provided practice tips for avoiding “unity of design” objections from the US and prior art objections from Japan and Korea. Finally, given that some countries (such as Japan) still require the filing of priority documents directly at the local office, he suggested that UK applicants should consider using Hague as their priority application.



NEW OPTION IS WELCOME

Simon Bentley of Abel & Imray considered the factors for determining whether it is advantageous to use the Hague system or to file national applications, considering the interplay between geographic coverage, cost, speed to registration, deferment and the need under Hague to use the same representations for each country. He also discussed the various proposals relating to designs in the draft Withdrawal Treaty between the UK and the EU.

He noted that, for applicants interested solely in the UK and the EU, it tends to be cheaper to use Hague for applications covering several 2D designs, but that it is always cheaper, in terms of official fees, to file national (UK) and registered Community design applications for 3D designs.

Simon suggested that Hague’s attractiveness could be materially enhanced by allowing applicants, when filing multiple designs, to choose only to designate certain countries for certain designs.

In light of Brexit, Simon considered that Hague would become more attractive for UK applicants.



Simon Bentley thinks Hague will become more attractive for UK applicants post-Brexit

AN EVERGREEN ARGUMENT

Hugo Cuddigan QC of 11 South Square delivered a fascinating talk examining the difficulties inherent in the test for unregistered design right. He took the audience back to one of the first unregistered design cases – *C & H Engineering v F Klucznik & Sons Ltd* [1992] FSR 421, known as the “pig fenders” case – which decided that the test for infringement of unregistered design right required the entire article (rather than a substantial part) to be identical or substantially reproduced.

Hugo contrasted the unregistered design right infringement test with the position in copyright, which deems that it is a substantial part of the work, rather than the entire article, that needs to be reproduced.

Referring to the recent unregistered design decision of *Neptune v Devol Kitchens* [2017] EWHC 2172 (Pat), Hugo argued that the combination of the unregistered design infringement test with the rules to prevent “evergreening” (so that small changes to a design do not give rise to a new right for the whole design) has caused rights owners considerable difficulty. He pointed out the contradiction between: (i) the rule against evergreening in design cases (such that only the first design is seen as the original protectable work); and (ii) the rule in the *LA Gear* case (on copyright), which says that if, in the course of producing a finished drawing, the author produces one or more preliminary versions, the finished product does not cease to be their original work simply because they adapt it with minor variations from an earlier version (thus the last work is effectively seen as the original protectable work).



Hugo Cuddigan QC delved into the intricacies of unregistered design right

A DIVERSE MENU

Mr Justice Henry Carr (pictured below centre) explained that, as a judge, he has come to the view that registered design cases should in most cases be capable of being decided relatively quickly, with little cross-examination or disclosure. This is in contrast with unregistered design right infringement, where issues of copying must be addressed.

Mr Justice Carr also touched on the fact that unregistered design right could be a powerful right, given that, within the constraints of the recent legislative changes, it may be possible for the claimant to rely on a part of the design. He also explained his interpretation of the changes that had sought to restrict this.

The judge gave his views on the reasons for the success of the Shorter Trials Scheme and the fact that, unlike other countries, the English courts now have a menu of procedures to suit the size of the case: IPEC for smaller cases, the Shorter Trials Scheme for more complex cases and the High Court for the largest actions.





SEND IN YOUR SCAMS

Kate O'Rourke explains some new initiatives aimed at ending the scourge of trade mark renewal fraudsters

For many years, businesses and individuals have received unsolicited and fraudulent payment demands, and many have paid for unnecessary or non-existent trade mark and design services.

In an effort to combat these scams, the UK Government has increased its activity in recent years, successfully prosecuting several actions through the Advertising Standards Authority and the UK IPO.

CITMA has now been advised to encourage clients to report misleading invoices not only to the UK IPO, but also via the Action Fraud website (actionfraud.police.uk), a reporting portal for fraud affecting UK citizens and businesses. Reports are collated and analysed by the National Fraud Intelligence Bureau and, where it is warranted, sent to an individual police force for investigation.

HANDLE WITH CARE

UK businesses have also been asked to keep both invoices and accompanying envelopes in a plastic sleeve and handle them as little as possible before forwarding them to the UK IPO. This correlates with initiatives in the US to pursue scammers for mail fraud. If a misleading US trade mark-related offer or notice is received, the advice is to file a consumer complaint with the Federal Trade Commission immediately. Again, the envelope should be kept, along with the offer or notice.

At EUIPO, the Anti-Scam Network has been established to share best

practice internationally and to take direct action. The network includes trade mark offices like the UK IPO and associations such as CITMA.

The network had a recent success in prosecuting scammers in Sweden. With the assistance of MARQUES, EUIPO supported the Swedish authorities in Court of Appeal proceedings against 20 people who were charged with fraud for sending out misleading invoices between 2011 and 2014. All of the victims had applied to register Community trade marks.

Following judgment in December 2017, two people were imprisoned and 18 more offenders were convicted for gross fraud and for assisting gross fraud. The Court of Appeal also approved 74 claims for damages.

TM5 MEASURES

The group of TM5 offices (the EU, the US, Korea, Japan and China) is also coordinating efforts to raise awareness. Measures taken by TM5 offices to combat scams, and encouraging the use of warnings with filing receipts and registration certificates, are detailed on its website. There is

also active coordination between international investigators, law enforcement, prosecutors, consumer protection agencies and users to raise awareness and encourage enforcement.

EUIPO has published a searchable list of the firms and registers that users have reported. Copies of fraudulent invoices are also on the EUIPO website. There are similar lists on the United States Patent and Trademark Office and WIPO websites.

International cooperation is the key to enforcing action against scammers. With the increased efforts of the Anti-Scam Network, we can hope that the scale of the problem will be reduced. This relies on all of us alerting clients, reporting incidents and sending in the relevant invoices and envelopes – even if you have seen the names before.

Where to report: in the UK, send enquiries to misleadinginvoices@ipo.gov.uk. Direct EUIPO enquiries to the Team for Intellectual Property Protection at tipp@euipo.europa.eu, or send materials to information@euipo.europa.eu



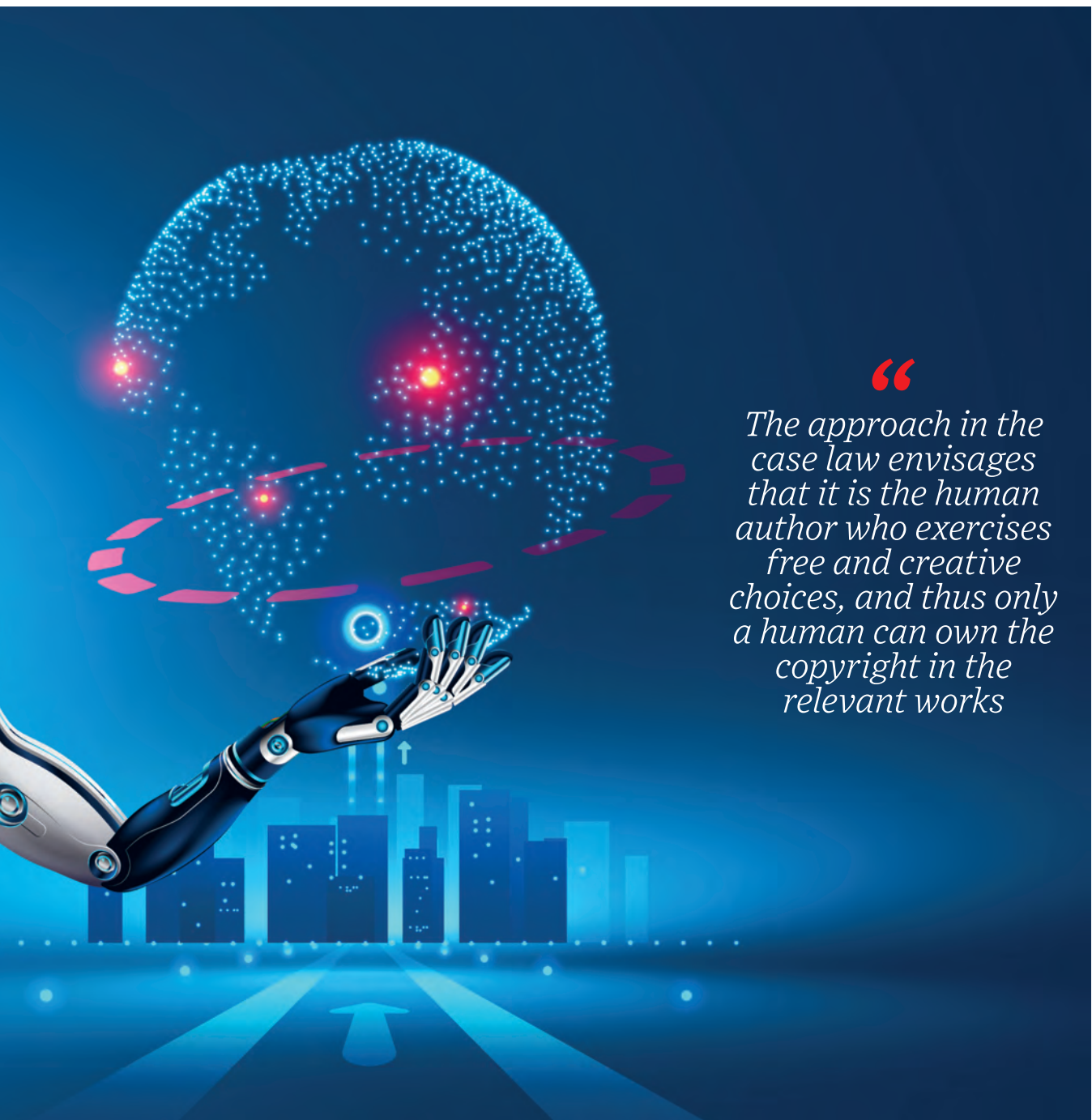
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THE END OF THE ORIGINAL?



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The approach in the case law envisages that it is the human author who exercises free and creative choices, and thus only a human can own the copyright in the relevant works

Mark Cruickshank draws attention to a development that could threaten traditional concepts of IP authorship

The proliferation of products and services enabled by artificial intelligence (AI) now provides a source of daily news, to the extent that the recognition of AI has transcended the rarefied world of specialist computer programming (and arguably the world of science fiction) and entered the consumer mainstream.

AI has the capability to analyse and process vast amounts of complex data to produce accurate and

repeatable results in a fraction of the time that human endeavour would require to return the same result. Enabled by an increase in computer processor speeds and cheaper available memory, AI has developed into an essential tool powering progress in areas as diverse as the automotive industry and financial services, and has disrupted many others (see page 20).

AI's prevalence, popularity and utility mean that it should no ►

longer be viewed as a prospect for the future, but rather as the mode of the present.

But has the law kept pace? For the IP profession, the question is whether IP law is sufficiently flexible to cater for the protection and enforcement of AI technology and work products.

DEFINING AI

First, it may be helpful to provide an overview of the underlying technology. AI is best defined as a way to give computers the ability to replicate human cognitive functions, such as learning, decision-making and speech recognition. In computing terms, AI is a series of algorithms that provide instructions which tell a computer to execute tasks – to process an input or data, make decisions about it and produce a desired output.

The complexity and levels of decision-making involved in AI are based in the fields of probability, statistics and mathematics. This includes use of formal logic, statistical inference and, in particular, decision-making nodes known as neurals.

To take one example from financial services, if an AI tool is created to help identify fraud, there will be a series of neurals created in an artificial neural network (ANN). Each neural makes a decision, which contributes to the outcome. The AI tool will have been given training in the form of data to help it understand the types of activity that would signal an incidence of fraud. The AI tool then assesses which of the neurals are correct and strengthens those connections. When it is presented with a new question, it relies on previous experience to determine the outcome.

As ANNs become more accurate, their ability to recognise and determine correct outputs increases significantly, and their reliability and accuracy improve as a result.

However, it is the application of these decision-making processes using machine learning in AI that has recently given rise to high-profile use cases. Machine learning is a branch of AI that refers to the ability of a

computer to learn without being specifically provided with instructions, and to improve the quality of its outputs based on the experience of previous transactions. In essence, the machine-learning program will write its own code and produce its own algorithms to produce a better outcome or find some enhanced learning.

To continue the earlier financial services example, the AI could be programmed to write its own code, and so to create new neurals or decision points to improve the decision-making process as it learns which outcomes are correct and which are not. It could also identify new patterns in any fraud detected, such as the types of transaction that are being attempted, from which location the fraudulent instructions are received and the amounts typically involved. This learning would accrue entirely independent of human involvement.

It is this capacity for “independent creation” and the ability for an AI machine-learning product to “think for itself” that are likely to give rise to the most challenges in terms of legal protection for IP.

OWNERSHIP OF AI

It is clear that copyright is the principal form of protection relevant to AI, being the form of IP subsisting in computer-generated works such as programs, coding and algorithms. An analysis of copyright law in the UK strongly indicates that it is only ever envisaged that a natural person/human will be the author, even where the works are machine written.

Section 9(1) of the Copyright, Designs and Patents Act 1988 (CDPA)

“ *The task of proving that the purported owner can claim a sufficient nexus with the creation of the work to convincingly claim ownership may well provide a legal battleground in the future*





“ The Software Directive states that the author has the exclusive rights to prevent unauthorised reproduction of the work. Clearly, a computer does not have such capacity

by the computer, whether in interpreting the instructions, executing the program or generating an output that is not specifically carried out by a human, again, the legislation seems clear. The person who makes the arrangements for the computer to operate is the owner. Indeed, this is reflected in the definition of “computer-generated” in s178 CDPDA, which states that this designation includes work “generated by computer in circumstances such that there is no human author of the work”.

But what of the originality requirements for the subsistence of copyright?

Readers will be aware that copyright subsists in computer programs that are original. Following the jurisprudence from the CJEU, it was held that it is not sufficient for the works to be original where the author only exercised sufficient skill, labour or effort in its creation. In the landmark case of *Infopaq (C-5/08)*, the CJEU decided that copyright must be the author’s own “intellectual creation”. This harmonised the approach to originality set out in Article 1(3) of the EU Software Directive and Article 3(1) of the EU Database Directive.

Further, in *Football Dataco*, the CJEU held that the “criterion of originality is satisfied through ... [the] author expressing his creative ability in an original manner by making free and creative choices”. This does not necessarily mean that every part of the work must be original. Rather, it is a test applied to the work as a whole. The approach in the case law envisages that it is the human author who exercises these choices, and thus only a human can own the copyright in the relevant works.

At present, there is a strong case to be made for the human involvement

in AI, so that the creator of the AI program or mechanism is naturally assumed to be the author. It is the person who exercises their intellectual creation in an original manner to create the algorithms who will be considered to be the owner. Even where those creative aspects involve a machine element, such as in the process of machine learning, the author can rely on the fact that they have made the arrangements for the work to be created as a basis to claim ownership. Without the input of the data sets, the setting of the input and output parameters, and the assessment of the outputs, the computer would not be directed to create the specified solution.

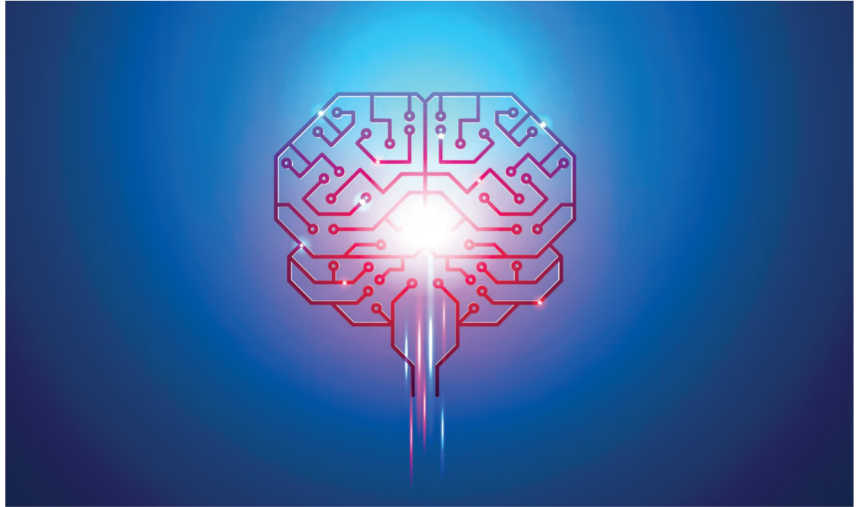
FUTURE COMPLEXITY

But what of the future? The complexity of AI is evolving at a significant rate, and questions of authorship will inevitably come to the fore. A recent collaboration between the University of Cambridge and Microsoft has created DeepCoder, an AI tool that has taught itself to write code with no previous knowledge by taking lines of code from other programs and putting them together. DeepCoder is based on neural networks and demonstrates some human-like characteristics in its decision-making.

Against this background, it seems inevitable that AI will take on more aspects of the intellectual creative process, and exercise free and creative choices. It will have an increasing autonomy that means it doesn’t depend on human instruction. The further away AI moves from human control, the harder it will be to make a sound argument that the author is the person who created the resulting works, or even the person who made the arrangements for those works to be created. ▶

states that the author of a work is the person who creates it. Moreover, s9(3) states that, in the case of “a computer-generated [work], the author shall be taken to be the person by whom the arrangements necessary for the creation of the work are undertaken”.

With regard to AI, it seems a straightforward proposition that the person who writes the computer program will be the owner of it. Even where there is a “contribution” made



“ The alternatives of ‘no ownership’ of AI or classifying AI as some form of ‘orphan work’ are unattractive and could leave uncertainty

Moreover, if a machine autonomously creates a program or code, it seems unlikely that any human will have exercised their own intellectual creation by the terms of the existing legal definition. The jurisprudence from the CJEU, the Software Directive and the Database Directive only envisage that a human author will be the owner of the works. This is consistently applied by the provisions in the Software Directive, which states that the author has the exclusive rights to prevent unauthorised reproduction of the work. Clearly, a computer does not have such capacity.

Similarly, if the relevant AI-enabled tool had created other forms of IP, then detailed considerations may be required. Section 7 of the Patents Act 1977 states that the inventor of a patent is a “person or persons”, and s2(3) of the Registered Designs Act 1949 states that the author of a design is the “person who creates it”. Neither statute considers the possibility that a non-human could be the inventor or the designer.

COMING BATTLES

In one sense, ownership of AI is a theoretical problem, because most commercial arrangements that deal in AI set out who the owner will be. While the evolution of AI has made great advances, not one of them has

yet raised a challenge of ownership. However, it has the potential to raise other practical issues that could be difficult to resolve in the current legislative landscape.

For example, when licensing or assigning the AI, the licensor or the assignor would usually be expected to provide a warranty that it owns the necessary IP that is the subject of the agreement. The licensor or the assignor would have to satisfy itself that it had met the criteria to be the author of the relevant works. The issues set out above regarding who the author is and whether the work is the author’s intellectual creation would then come to the fore.

Moreover, in a claim for copyright infringement, it is a common tactic for the defending party to raise the issue of ownership and place the burden of proving ownership of the relevant works on the claimant/pursuer. The task of proving that the purported owner can claim a sufficient nexus with the creation of the work to convincingly claim

ownership may well provide a legal battleground in the future.

In considering how such issues might be resolved, the scenarios set out above certainly make for interesting academic discussion. However, the alternatives of “no ownership” of AI or classifying AI as some form of “orphan work” are quite unattractive. Such approaches are unsatisfactory from a legal perspective and could leave uncertainty in an important technological field. Further, if such innovation cannot be protected, it would diminish any commercial incentive to develop the state of the art.

Instead, it is hoped that the courts will take a practical approach and extend the flexibility offered by s9(3) CDPA to include situations in which AI has been developed by a function of machine learning. Case law may also be required to evolve to take account of a more “machine driven” creative process. Copyright is a flexible mode of IP and should be extended to preserve and incentivise investment in the creation of AI.

Post-Brexit, it will fall to the UK Government and courts to create sufficient protection that balances the technological evolution with a common-sense approach to ownership and exploitation. ●



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A large, stylized logo consisting of a white 'I' and 'P' inside a white circle, set against a grey background. The 'I' and 'P' are in a serif font.

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WHAT NEXT FOR NESTLÉ?

Richard Ferguson suggests a strategic change for the company following its recent appeal setback

Kit Kat is one of those rare trade mark cases that prompts big press headlines and gets friends suddenly interested in IP. The Advocate General's (AG's) recent opinion offered another chance for headline wordplay, and although it was a disappointing result for Nestlé, it is an encouraging development for brand owners looking to show acquired distinctiveness in the EU.

For those readers who are unfamiliar with the case, here's a recap: Mondelez UK Holdings & Services unsuccessfully applied to invalidate Nestlé's 3D ("Kit Kat 4 fingers") EU trade mark (EUTM) for non-distinctiveness, with acquired distinctiveness in the product's shape throughout the EU rescuing Nestlé. The General Court (GC) subsequently annulled EUIPO's decision, finding that Nestlé had acquired distinctiveness in only 10 out of 15 Member States.

Nestlé has appealed to the CJEU on the basis that the GC's interpretation that it is necessary to show acquired distinctiveness in each Member State was incompatible with the unitary character of an EUTM and the single market. The AG has recommended that the CJEU uphold the GC's decision that the Kit Kat shape is invalid. While the CJEU isn't required to act on the AG's opinion, that does seem to be the likely endgame.

NO LICENCE TO OVERLOOK

The underlying theme is that proving acquired distinctiveness in parts of the EU is not a licence to overlook national/regional markets because the principles of unitary character and the single market exist. And

although the AG's recommendation might appear negative, the reasoning is far more promising for applicants of difficult marks.

Nestlé failed to show acquired distinctiveness in Belgium, Greece, Ireland, Portugal and Luxembourg. In addition, it did not file evidence to show that these markets were comparable to those Member States for which sufficient evidence was filed, allowing for extrapolation (eg that Spain would also cover Portugal). As the AG commented, evidence in Germany, Belgium or France would have sufficed to cover the Luxembourg market. In other words, had Nestlé submitted market comparison evidence, the AG might well have reached a different opinion.

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PRAGMATIC APPROACH

This is a pragmatic approach, which, if adopted by the CJEU, would provide further clarification on acquired distinctiveness for difficult marks (see Lindt C-98/11, and Louis Vuitton T-359/12, T-360/12). It is conceivable in this scenario that, if evidenced and pleaded properly, registration would be possible based on extrapolated evidence in, say, 23 of 28 Member States.

So what next for Nestlé? It owns EUTMs for one- and two-finger iterations and some national four-finger registrations. One big challenge it faces is that the national courts do not mirror EUIPO's finding of acquired distinctiveness in certain Member States. The UK courts, for example, have refused the mark because evidence showed only that consumers recognise the shape, not that they rely on it when making a purchase.

Looking at the Kit Kat product and brand, it is difficult to identify what steps have been taken since the invalidity challenge and how it might overcome the legal hurdles. My suggestion: feed the learning from the legal test into its marketing and branding. Educate consumers, for example, by accentuating the product shape via packaging redesigns or explicit advertising campaigns.



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TOP FILERS 2017

*Which UK trade mark representatives were most active last year?
Turn the page for details of our latest top 100*

DATA COLLECTION DETAILS

Data supplied by Corsearch (corsearch.com). Figures represent filers that are the current UK agents for EU trade marks or UK trade marks for which applications were made in the 2017 calendar year. Figures do not include corporate filers or representatives of

single corporate entities. Where a trade mark's ownership was transferred, both representatives will be credited. Figures do not represent WIPO-designated filings. Where firms have acquired other firms during the period, the full representation of filing statistics may not be captured. Where

a named individual can be identified as employed by, or affiliated to, a firm, figures have been combined or the affiliated company indicated. Where firms have multiple IPO accounts under different naming conventions, we cannot guarantee complete representation.



TOP 100 UK TRADE MARK FILERS

	Name	Filings			Filings
1	Marks & Clerk LLP	626	51	Ashfords LLP	137
2	Murgitroyd & Company	609	52	Potter Clarkson LLP	136
3	Trademark Eagle Ltd	567	=	FRKelly	136
4	HGF Ltd	499	54	Trademarkit LLP	133
5	D Young & Co LLP	494	=	Qun Chi	133
6	Boult Wade Tennant	484	56	Wynne-Jones, Laine & James LLP	126
7	Stobbs	440	57	A A Thornton & Co	125
=	Wilson Gunn	440	=	Haseltine Lake LLP	125
=	Barker Brettell LLP	440	59	Stevens Hewlett & Perkins	123
10	Urquhart-Dykes & Lord LLP	377	60	Stephens Scown LLP	118
11	Keltie LLP	373	=	Mei-Leng Fong	118
12	Trade Mark Wizards Ltd	363	62	Maucher Jenkins	117
13	Beck Greener	356	=	Dolleymores	117
=	Withers & Rogers LLP	356	64	Trademarking4u Ltd	112
15	Bird & Bird LLP	345	65	Mishcon de Reya LLP	111
16	Groom Wilkes & Wright LLP	333	=	ip21 Ltd	111
17	Gill Jennings & Every LLP	322	67	Baron Warren Redfern	110
18	Kilburn & Strode LLP	315	=	Womble Bond Dickinson (UK) LLP	110
19	Appleyard Lees IP LLP	305	69	Bristows LLP	105
20	CSY	302	70	Harrison IP Ltd	103
21	Forresters IP LLP	294	71	WP Thompson	102
22	Axis IP Services Ltd	270	72	Lawrie IP Ltd	101
23	Bayer & Norton Business Consultant Ltd	267	73	Carpmaels & Ransford LLP	99
24	CMS Cameron McKenna Nabarro Olswang LLP	252	74	Irwin Mitchell LLP	96
25	Novagraaf UK	242	=	Penningtons Manches LLP	96
26	J A Kemp	238	76	Kempner & Partners LLP	95
27	Mathys & Squire LLP	234	=	James Love Legal Ltd	95
28	Swindell & Pearson Ltd	226	78	Trade Mark Consultants Co	94
29	Dehns	221	79	K Binder-Sony (LegalForce RAPC Worldwide)	93
30	Fieldfisher LLP	215	80	DLA Piper UK LLP	91
=	Briffa	215	81	Osborne Clarke LLP	90
32	Mewburn Ellis LLP	210	82	Eversheds Sutherland (International) LLP	88
33	Lewis Silkin LLP	202	=	Simmons & Simmons LLP	88
34	Lane IP Ltd	201	=	Franks & Co Ltd	88
35	The Trade Marks Bureau	196	85	Edwin Coe LLP	87
36	Wildbore & Gibbons LLP	192	=	The Trademark Café Ltd	87
=	Taylor Wessing LLP	192	87	Hogan Lovells International LLP	86
38	Trade Mark Direct	184	88	Marcaria.com LLC	85
39	Nucleus IP Ltd	182	89	Sipara Ltd	84
40	Reddie & Grose LLP	181	90	Chancery Trade Marks	82
41	Baker McKenzie LLP	180	91	Agile IP LLP	81
42	Albright IP Ltd	175	92	Hiddleston Trade Marks	80
43	Cooley (UK) LLP	171	93	Peng Xiao Pan	79
44	Venner Shipley LLP	167	=	Trademarkroom Ltd	79
45	Elkington and Fife LLP	165	95	Laytons LLP	76
46	Page White and Farrer	162	=	Wiggin LLP	76
47	RevoMark	158	97	Qizhao Ding	75
48	Peter Fuhrman	148	98	Ansons	74
49	Bailey Walsh & Co LLP	144	=	Blake Morgan LLP	74
=	Abel & Imray	144	100	London IP Ltd	73
				Total	19,374

TOP 100 EU TRADE MARK FILERS

	Name	Filings		Name	Filings
1	Marks & Clerk LLP	433	51	Sipara Ltd	101
2	HGF Ltd	425	52	Sheridans	100
3	Forresters IP LLP	412	53	Dolloymores	96
4	Stobbs	396	54	Wynne-Jones, Laine & James LLP	94
5	Boult Wade Tennant	390	=	Page Hargrave	94
6	Barker Brettell LLP	332	56	Abel & Imray	93
7	Kilburn & Strode LLP	319	=	Wildbore & Gibbons LLP	93
8	D Young & Co LLP	309	58	Swindell & Pearson Ltd	85
9	Fieldfisher LLP	288	=	Hansel Henson Ltd	85
10	Withers & Rogers LLP	279	60	Finnegan Europe LLP	79
11	Cooley (UK) LLP	270	61	Daniel Smart (Colman + Smart)	71
12	Lane IP Ltd	268	=	Briffa	71
13	Urquhart-Dykes & Lord LLP	264	63	Norton Rose Fulbright LLP	70
14	The Trade Marks Bureau	254	64	Dummett Copp LLP	69
15	Gill Jennings & Every LLP	248	65	A A Thornton & Co	68
16	Keltie LLP	245	=	Stevens Hewlett & Perkins	68
17	CSY	228	=	Sanderson & Co	68
18	Mewburn Ellis LLP	226	=	Fox Williams LLP	68
19	Reddie & Grose LLP	224	69	Harrison IP Ltd	67
20	J A Kemp	221	70	Kempner & Partners LLP	66
21	Murgitroyd & Company	210	71	Bailey Walsh & Co LLP	65
=	Page White and Farrer	210	=	Osborne Clarke LLP	65
23	Baker McKenzie LLP	205	73	Oakleigh IP Services Ltd	64
=	Wilson Gunn	205	74	Novagraaf UK	62
25	CMS Cameron McKenna Nabarro Olswang LLP	189	75	Axis IP Services Ltd	61
26	K Binder-Sony (LegalForce RAPC Worldwide)	180	76	DLA Piper UK LLP	59
27	Ladas & Parry LLP	175	=	Jessie Leung	59
28	Mathys & Squire LLP	174	78	Squire Patton Boggs (UK) LLP	55
29	Jeffrey Parker & Company	171	79	Baron Warren Redfern	54
30	Dehns	166	80	Eversheds Sutherland (International) LLP	53
31	Trademark Eagle Ltd	165	81	Global IP Law Ltd	51
32	Maucher Jenkins	164	82	Lopera Li	49
33	Ardeshir Matini (Montecristo LLP)	158	83	Williams Powell	48
34	Lewis Silkin LLP	157	=	EIP	48
35	Taylor Wessing LLP	151	85	Edwin Coe LLP	47
36	Bird & Bird LLP	150	=	Irwin Mitchell LLP	47
37	Trade Mark Direct	147	87	Trade Mark Wizards Ltd	46
38	Potter Clarkson LLP	146	88	Ashfords LLP	45
39	Venner Shipley LLP	133	=	Allen & Overy LLP	45
40	Carpmaels & Ransford LLP	131	=	Paul Price (Trademarking4u Ltd)	45
=	Albright IP Ltd	131	=	Penningtons Manches LLP	45
=	Haseltine Lake LLP	131	92	JAG Shaw Baker	44
43	Beck Greener	115	93	Bryers LLP	43
44	WP Thompson	111	=	Joshi Worldwide IP	43
45	Bristows LLP	107	=	MW Trade Marks Ltd	43
=	Mishcon de Reya LLP	107	96	Nucleus IP Ltd	42
47	Eugene Johann Pienaar (RevoMark)	106	=	James Love Legal Ltd	42
=	Appleyard Lees IP LLP	106	98	Filemot Technology Law Ltd	41
49	Groom Wilkes & Wright LLP	103	=	Renaissance Solicitors LLP	41
=	Locke Lord LLP	103	=	Cam Trade Marks & IP Services	41
			Total		13,637

THE AI EFFECT

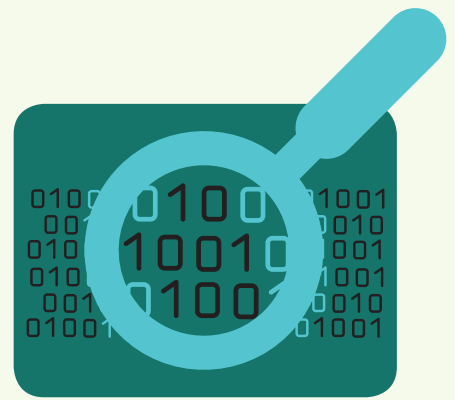
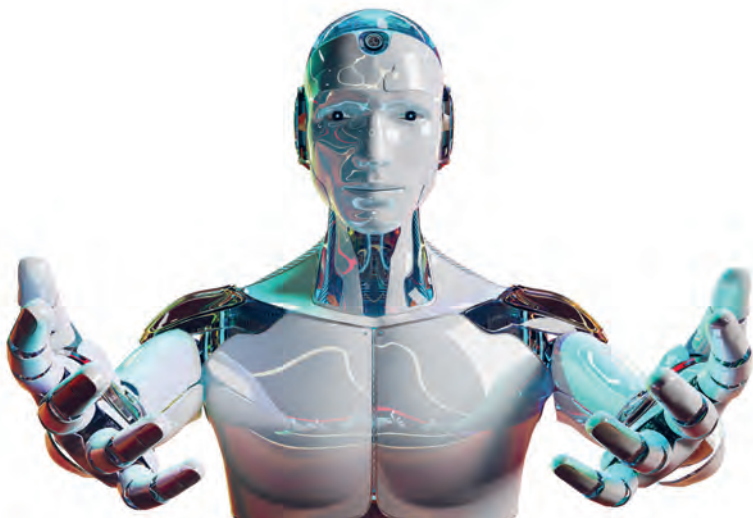
Birgit Clark offers a first-hand assessment of how technology is affecting the modern legal workplace

Utopian – and dystopian – tales of sentient machines have long been the province of science fiction. Yet, beyond film and literature, artificial intelligence (AI) has been identified as one of the most transformative technologies of the so-called fourth industrial revolution, which will be “driven by exponential increases in computing power and by the availability of vast amounts of data”, as Klaus Schwab, Executive Chairman of the World Economic Forum, wrote in 2015.

More recently, the Law Society’s 2017 report *Capturing Technological Innovation in Legal Services* envisaged the legal sector engaging with new technology, such as advanced automation, machine learning and AI, “which will allow machines to augment the skills of human lawyers in ways that were unimaginable even a decade ago”.

There is no legal definition of AI as yet, but it is most commonly defined as the science of enabling computers to perform tasks that require intelligence when done by humans. As discussed earlier in this issue (see page 10), falling within its scope are “machine learning” systems, designed to perform human-like cognitive tasks, and which improve their performance by learning from data, but without further human input. Another category is “deep learning”, a type of machine learning whereby specific algorithms, so-called artificial neural networks, mimic the biological structure of the brain.

Use of a range of AI-enabled systems in the legal industry seems to be in full swing, but how are they being used and by whom? And what might be the impact of their spread?



Instant classic

A classic legal application of AI was “e-discovery” and, subsequently, any type of document review, notably in due diligence and transactional IP work, where large amounts of material must be reviewed quickly. Basic AI and Boolean search-based tools – which look for keywords or eliminate duplicate documents – have since been superseded by AI technology that can search documents and emails for context, concepts and even tone. Using “predictive coding”, lawyers are able to leave the first cull to the AI tool, then review its results. The AI-assisted workflow (an example of machine learning) then continuously learns from the user which results are relevant and applies this as the review process progresses.



Costs and research

AI applications are used by law firms and their clients to assist with the billing process and analyse productivity and efficiency (including against competing firms), and may be combined with case management tools. They also assist with detailed legal research. One of the most well-known AI applications, ROSS Intelligence, uses a natural-language processing (NLP) tool to allow users to search in plain language, as opposed to Boolean search strings.



Contract automation

Already in use in many larger law firms, contract automation tools use automated templates or “form documents” to generate standard legal documents based on data input. The perceived advantages are time and efficiency gains, as well as a reduction of the inherent risks of manual drafting. There are also AI document management tools that can organise and analyse existing contracts based on key data, such as terms or dates. However, AI technology is already attempting to do a lot more, such as creating the first draft of patent applications by, for instance, reviewing published patent data using NLP algorithms, data mining and automated reasoning.



Analytics and prediction

A 2016 study by researchers at University College London, the University of Sheffield and the University of Pennsylvania found that AI technology could accurately predict the outcome of cases in the European Court of Human Rights nearly 80 per cent of the time. And AI software that forecasts a potential litigation outcome already exists. Using data from, for example, existing case law, or a judge’s or IP rights owner’s previous actions, predictive tools can identify underlying trends.

“ AI tools identify the relevant clauses, and you are left with the task of legally assessing the information

INDUSTRY UPTAKE

Almost all large UK law firms are implementing AI and/or machine learning applications, and I have had the chance to test several such applications. Based on my experience, these tools allow for efficiency gains, as you would expect, and also improve the quality of output. Instead of staring at a screen (or paper) to look for the relevant clauses, AI tools identify these for you – or at least reduce the amount of clauses you have to review – and you are left with the more rewarding task of legally assessing the detected information.

It is equally fascinating and unnerving to observe how an AI application is able to learn which information is relevant and then fine-tune its output. For example, use of legal technology does not end document review. Yet colleagues in my firm’s China offices are already successfully using document automation tool Contract Express to automate comparatively simple documents (such as assignments or power of attorney documents), and applying automation tools to create the first draft of trade mark prosecution submissions.

AI cannot (yet) replace a lawyer’s judgment or analysis, and, even in the longer term, is unlikely to replace human-to-human client contact. However, it seems fair to say that the more routine a lawyer’s activities or services are, the easier it will be to (at the very least) reduce the volume of these tasks. Inevitably, clients will demand this service as a matter of course, and expect their lawyers to use and invest in new technologies so that senior legal counsel can focus on “value added” legal work.

The increasing use of legal technology will also affect how lawyers are trained, not least because many traditional trainee tasks are being automated. Another important task lawyers will face in this context will be to collect relevant information, as AI and machine learning require large and “good quality” data sets to improve their output and work effectively.

So, while AI’s impact is an unfolding story, it’s obvious that the lawyers of the (near) future will be expected to be more technologically savvy, and use AI and other tools to work more quickly, more efficiently and – in some cases – more accurately. And the law firms of the present will be required to act decisively in response. ●

DID YOU KNOW?

80%
OF TOP 10
FIRMS AND

57%
OF TOP 11-25 FIRMS
HAVE ALREADY
ESTABLISHED OR
BEGUN PILOTING
AI SOLUTIONS

SOURCE: TIME FOR
CHANGE: PWC LAW
FIRMS’ SURVEY 2017



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SPLIT

Red Bull has opened a can of worms when it comes to colour marks. Katie Goulding looks at the factors that have divided opinion

Psychologists and marketers frequently cite the fact that more than 80 per cent of visual information that we take in is related to colour. It's also well understood that the incidence of colour can radically increase our recollection of content – colour evokes an emotional response – and, importantly from a customer loyalty perspective, brand recognition.

So it is not surprising then that colours have (for some time) been accepted as capable of performing the trade mark function. In more recent years, recognition of their importance and, in turn, investment in their development and protection have really grown. In crowded markets in which the consumer is overloaded with information, colours can take centre stage for influencing purchasing decisions.

However, following the decision of the General Court (GC) in *Red Bull GmbH v EUIPO*¹, the rhetoric among many has been that, rather than evolving along with common practice, trade mark law is making it more difficult to protect colours and, in particular, colour combinations. Some commentators have gone so far as to say that the decision introduces additional

hurdles that effectively render the registration of colour combinations impossible.

So, have the goalposts truly moved? And, if so, where does this leave brand owners who have brand value in colour combinations?

THE RED BULL RESULT

The GC dismissed an appeal by Red Bull to annul Board of Appeal (BoA) decisions to invalidate two registrations for a blue and silver colour combination mark, both with the visual representation shown right but with variants on their accompanying descriptions:

- (1) “Protection is claimed for the colours blue (RAL 5002) and silver (RAL 9006). The ratio of the colours is approximately 50%-50% [Reg No 2534774].”
- (2) “The two colours will be applied in equal proportion and juxtaposed to each other [Reg No 9417668].”

The Pantone colour codes were also given. Both marks specified “energy drinks”.

The case of *Heidelberger Bauchemie* was central to the decision², being the leading case to confirm that colour combinations per se are eligible for trade mark protection, and setting out the criteria at paragraphs 33–34 that:

- (1) a graphic representation consisting of two or more colours, designated in the abstract and without contours, must be systematically arranged by associating the colours concerned in a predetermined and uniform way; and
- (2) the mere juxtaposition of two or more colours, without shape or contours, does not exhibit the qualities of precision and uniformity.

According to the GC, Red Bull's marks allowed for various combinations of the colours, which left room for ambiguities and prevented third parties from knowing with clarity and precision the scope of the rights conveyed by the registrations. If the representation was intended to be limited to the colour blue on the left and silver on the right, with those colours juxtaposed and divided into equal proportions by a central vertical line, then an explicit description should have been given to that effect.

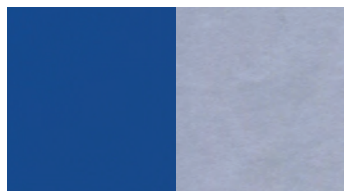
¹ Joined cases T-101/15 and T-102/15, General Court, 30th November 2017.
² Case C-49/02. Judgment of the Court (Second Chamber) of 24th June 2004.

DECISION

THE RED BULL MARKS



THE REGISTRATIONS: VISUAL REPRESENTATION



A MORE STRINGENT TEST?

The suggestion is that the requirement has shifted from “what you see is what you get” to one which necessitates an “explicit description”. A number of authors have suggested that the requirement for an explicit description is an additional hurdle unsupported by case law and practice.

By the time the second Red Bull registration was filed (2010), EUIPO was seemingly moving to a practice which recognised that some circumstances necessitated an accompanying description, notwithstanding the wording of Rule 3(3) of Commission Regulation (EC) No 2868/95: “the application *may* contain a description of the mark [emphasis added].” The 2008 Guidelines provided that: “Where there is more than one colour the proportion of each colour and *how they will appear must be specified*. If this has not been done in the application the examiner will notify the deficiency [emphasis added].” They also provided that: “The



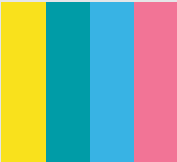



representation of the mark together with a description, if any, must be sufficient for the examiner to see and understand what is being sought to be registered. *Any deficiency can be remedied only by supplying or amending a description [emphasis added].*”

However, case law at the time, while recognising descriptions as a method for helping define the subject matter of the application, had not gone so far as to say that marks for colour combinations in the abstract necessitated a description. Nevertheless, the GC said, at paragraph 43:

“It follows from the *Libertel* decision that a description of a sign may be required ... In fact, a necessary description forms an integral part of the sign’s graphical representation and thus also serves to define its scope of protection. Whilst the sign’s description indeed may not be used to broaden the scope of protection of what may be derived from the sign’s graphical representation itself (“what you see ▶

“ *A number of authors have suggested that the requirement for an explicit description is an additional hurdle unsupported by case law and practice*

RECENT APPLICATIONS – SPOT THE DIFFERENCE

DECISION (YEAR)	TRADE MARK DESCRIPTION	SPECIFICATION
Registered (2015) 	A combination of the colours yellow-green (Pantone 388), blue (Pantone 313) and black (Pantone coated black 6C), which cover the visible surfaces of the products cited in the list of goods. Ratio: yellow-green 40%, blue 30%, black 30%.	Tools in classes 7 and 8.
Refused (2015) Non-distinctiveness and any number of combinations. Also – more colours, less likely to be perceived as a trade mark. 	A contourless colour mark for the products specified, consisting of the colours moss green (RAL 6005), red (Pantone 485) and black (Pantone coated black 6C). The colours are applied to the products listed in the specification in the ratio moss green 80%, red 10%, black 10%, whereby the products appear predominantly green, with red and black elements.	Tools in classes 7 and 8.
Registered (2016) 	This colour trade mark comprises a combination of colours: yellow (Pantone 107C), teal (Pantone 320C), blue (Pantone 298C) and pink (Pantone: 190C). Each colour represents 25% of the figure.	Dental apparatus in class 10.
Refused (2016) 	Protection is claimed for the colours yellow (Pantone 102C) and black (Pantone 419C), as shown in the representation of the colour mark applied for. The ratio of the colours is approximately 50:50.	Various goods in class 9, including class heading.
Registered (2017) 	The mark contains the colours hyper green (PMS 388C), dark grey (PMS 446C) and light grey (PMS Cool Grey 5C). The ratio of colours to each other is hyper green 58%, dark grey 38% and light grey 4% as applied to the exterior of the goods covered by the application.	Tools in class 7, batteries in class 9 and lights in class 11.
Refused (2017) Distinctiveness only. 	The colour mark includes a combination of red (Pantone 485) and green (Pantone 568C). The colours each make up approximately 50% of the image.	Various chemicals and lubricants in classes 1, 3 and 4.

is what you get’), it may therefore be indispensable to be taken into account when defining the sign’s subject matter.”

The first part appears to stretch Libertel, which provided that a verbal description could assist an application for a colour per se to satisfy the requirements of graphical representation, provided the remaining Sieckmann criteria were met – it principally addressed descriptions of the colour itself to circumvent the lack of durability of a colour sample. That said, it is logical that, if a combination of colours is not defined in specific arrangement, it fails the Heidelberger test for being imprecise and being able to take on a multiplicity of forms. How else would one satisfy the criterion (which isn’t new) if not by verbal description?

It seems that the practice has changed to demand stricter adherence to the case law. This may be the result of incorrect decisions being taken on examination in the past, but that is no reason to undermine the underlying interests of enabling consumers to repeat the purchase experience with certainty or for other operators to be able to understand, without ambiguity, the scope of the monopoly that is being granted to an earlier holder.

The first of these is inextricably bound with the *raison d’être* for using and seeking to protect distinctive colour combinations in the first place. Some have suggested that the requirements are now much stricter for combinations than single colours per se. But it must be borne in mind that colours per se face a tougher time on distinctiveness.

It is apparent, however, that the interplay between a description and representation is unclear and, at times, contradictory, and the record must be set straight.

A CONTRADICTION

Red Bull ran the argument of “what you see is what you get”, ie that the arrangement of the colours is as seen in the image – consisting of the colour blue on the left and silver on the right (and presumably this relationship persists also in a vertical construction) – such that the arrangement of the colours was

“ The interplay between a description and representation is unclear and, at times, contradictory, and the record must be set straight

sufficiently precise. This was not accepted. Claiming a broader protection than that afforded by the representation was apparently in direct contradiction to “what you see is what you get”.

How can this be? If a description cannot be used to broaden the scope of protection, but instead is a means to help interpret the subject matter of the mark, isn't the GC's conclusion also a contradiction? By saying that the description made a broader claim, the GC acknowledged that the description broadens the scope of protection, and, surely, it must therefore be concluded that the description is thereby given precedence over the image. This does not seem to accord with paragraph 48 of the BoA's decision, which provided that the graphical representation and description must be evaluated in combination.

So which is it? Is the starting point the description? Or does the description merely qualify the image? This is yet to be answered, but Red Bull would suggest that a description that is broader than the image itself will not be interpreted as being confined to the additional explanation it gives over the representation (ie to help interpret the subject matter), but rather will be assessed separately to the image to ensure it meets the requirements of Sieckmann and Heidelberger.

If the description and representation are to be taken in conjunction with each other (as it is believed they should be), then why is it not the case that the scope of protection is defined by their totality, such that a description can supplement a representation to make clear any ambiguous aspects, but can also be limited by what appears in the image?

So, for example, to take the case here: the image defines the vertical relationship, and the left and right

positions of the two colours, whereas the description defines the ratio of the colours in relation to each other and indicates their colour code. In their totality, the result is (some might argue) a mark with a systematic arrangement qualified by the “what you see is what you get” principle.

WHAT IS THE OBJECTIVE?

Clearly, more certainty is desirable, but the question must always be asked: “What do you hope to achieve with this?” Red Bull observed that an abstract colour mark should grant protection over the two colours being used in different ways, provided the colours still indicated a specific origin. But there is a slight friction between this and the “what you see is what you get” approach that it also advanced.

There is an obvious attraction to securing as broad a monopoly right in a colour combination as possible to enable it to be invoked against any number of variant lookalike products, or to keep competitors in abeyance. However, monopolies have to be clearly defined. Trade mark registrations grant exclusive rights against confusingly similar signs. If, in fact, this is enough to maintain and grow brand value and give enough visual information to consumers, so that there is distance with other products on the shelf, then those drafting applications should not lose sight of such objectives in the pursuit of limitless permutations. ●

USING COLOUR – PRACTICE POINTERS

SAY WHAT YOU SEE

Until further guidance is given on the interplay between representation and description, ensure there is congruence between them and opt for a description that is narrower than the image might suggest, rather than appearing to be attempting to broaden the scope of protection.

RELATIVITY

Be more specific about relationships. For example, what is the relative position of the colours? Are they vertical, horizontal, diagonal?

DIRECT LANGUAGE

Consider using language that makes a direct reference to the specific arrangement shown in the representation. However, bear in mind that the representation is without shape and contour, and such wording may not be seen to define the arrangement.

RATIO NO-NO

Leave out “approximate” ratios – this margin of similar marks is likely to be captured by the scope of the exclusive right anyway.

SEPARATE APPROACH

If it is absolutely paramount that the colour combination is protected in various forms, consider separate applications for the most commercially significant variants.



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Is the sky no longer the limit?

Brand owners should consider filing narrower specifications, cautions Désirée Fields

Sky is one of Europe's largest media and telecommunications companies and an active enforcer of its vast trade mark portfolio, which includes several EU and UK trade marks for a mixture of "Sky" figurative and word marks. When SkyKick, a US cloud-based IT services start-up, expanded into Europe in May 2016, Sky brought an action in the High Court alleging that SkyKick had committed trade mark infringement and passing off through use of its SkyKick signs.

Sky relied on specific registrations in classes 9 and 38 (including "computer software" and "telecommunications services"). However, the full specifications of goods and services covered by Sky's registrations were extremely broad (with some specifications exceeding 8,000 words).

In response, SkyKick sought a declaration that Sky's trade marks were wholly or partially invalid on two grounds:

- i. The specifications of the goods and services lacked sufficient clarity and precision; and
- ii. The applications had been made in bad faith.

In relation to the first, SkyKick argued that Sky's registrations for goods such as "computer software" lacked sufficient clarity and precision (as required by IP TRANSLATOR).

In relation to the second, SkyKick argued that Sky had no intention to use its trade marks in relation to all of the goods or services covered, hence the allegation of bad faith. Indeed, under cross-examination, Sky was unable to produce a commercial rationale for some of the goods and services listed (such as "insulation materials" and "whips").

NO PASSING OFF

Arnold J dismissed Sky's claim for passing off (due to lack of consumer confusion and misrepresentation), but held that, if Sky's trade marks were validly registered for the goods and services relied on by Sky, SkyKick had infringed them, because the average consumer was capable of perceiving "SkyKick" as a sub-brand of Sky.

BROAD SPECIFICATIONS

As established in IP TRANSLATOR, class headings only cover those goods and services that are clearly encompassed by the literal meaning of the class heading, and, therefore, applicants should specify with sufficient clarity and precision the scope of goods and services included in their application.

As an example, Arnold J held that the general term "computer software" was too broad, as it covers any type of computer software, regardless of its function, and confers on the owner "a monopoly of immense breadth which cannot be justified by any legitimate commercial interest" (at 171). However, he held that it did not necessarily follow that such a term lacked clarity and precision. He considered (and favoured) the US-style approach, which necessitates specifying both the function and field of any software.

Arnold J concluded that the law was unclear as to whether a trade mark should be found invalid (either in whole or in part) because parts of its specifications are lacking in clarity and precision.

He further concluded that (at the date of filing) Sky's trade mark applications had included goods and services for which Sky had "no reasonable commercial rationale for seeking registration" (at 250) and no intention to use. He also noted that the law was not clear on whether a trade mark application could be made partly in good faith and partly in bad faith, and whether this would invalidate the entire registration.

KEY POINTS

✦ In the future, EU trade mark owners may need to consider a US-style approach to specifications, clearly indicating the field of use and purpose of goods and services

✦ Brand owners should avoid claiming wide-ranging goods and services that they do not intend to use

✦ Owners of trade marks with broad specifications should consider filing narrower trade mark applications for core goods and services

“ *Arnold J’s comments indicate that, in line with IP TRANSLATOR, it would be best practice to adopt a US-style approach to specifications* ”

QUESTIONS FOR THE CJEU

Accordingly, Arnold J referred the following questions to the CJEU:

1. Can an EU or a national trade mark be declared wholly or partially invalid on the ground that some or all of the terms in the specification are lacking in sufficient clarity or precision to enable the competent authorities and third parties to determine the extent of the protection conferred by it?
2. If the answer is “yes”, is a term such as “computer software” lacking in sufficient clarity or precision?
3. Can it constitute bad faith to apply to register a trade mark without an intention to use it in relation to the specified goods or services?
4. If the answer is “yes”, is it possible to conclude that the applicant made the application partly in good faith and partly in bad faith if it had no intention to use the trade mark in relation to some of the specified goods or services?

ACTION INDICATED

The notion that a trade mark could be found invalid because it contains unclear terms or cites irrelevant goods and services is, for brand owners, a cause for concern. To maximise protection, many brand owners file broad specifications of goods and services, often using class headings followed by more specific terms. Depending on the CJEU’s answers, this may no longer be the best approach.

In addition, brand owners should review their existing registrations and current use of their marks. Where specifications are very broad, a cautious approach would be to file new and narrower applications covering only those goods and services that are fundamental to their business.

Arnold J’s comments indicate that, in line with IP TRANSLATOR, it would be best practice to adopt a US-style approach

to specifications, where the field of use and purpose of goods and services are clearly indicated.

FUTURE EFFECTS

Depending on the CJEU decision, there is a possibility that a trade mark registration could be cancelled for lack of clarity or precision, or at least significantly narrowed in scope. The CJEU may take a similar approach as it does in situations where a trade mark owner has to prove use of a mark: if use is proven in relation to some, but not all, goods and services, the mark remains valid in respect of the goods and services where use can be proven. Similarly, as bad faith is a serious allegation, it would seem draconian for a registered trade mark to be declared invalid in its entirety on the basis of covering a broad range of goods and services where many are, indeed, being put to genuine use. However, until the CJEU provides answers to these questions, the position is unknown.

There is further uncertainty regarding how the CJEU’s answers will be applicable in the UK post-Brexit. According to the draft Withdrawal Agreement published on 19th March 2018, the EU’s position is that CJEU decisions handed down either before the end of the transition period (31st December 2020), or after the end of the transition period but where proceedings were started before that date, shall have full binding effect within the UK. The UK Government has not accepted this position. It is therefore unclear whether the English courts will apply the answers of the CJEU post-Brexit.

SKY’S FIGURATIVE MARKS

SKY
sky

SKYKICK SIGNS COMPLAINED OF

#SkyKick
skykick



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Student users spread brand's reach

Customer profile proves an important point, explains Chris Morris

This case concerns a dispute between two providers of accommodation for university students. Student Union Lettings Ltd (SUL) claimed that the rebranding of Essex Student Lets Ltd's (ESL's) business to SU LETS was an infringement of its UK registered trade mark SULETS and also constituted passing off.

SUL is a company with charitable status, owned by the students' unions of the University of Leicester and De Montfort University. It provides letting agency services, supplying student accommodation in halls of residence. It owns a UK registration for SULETS (accommodation letting agency services). The mark was used in the format as registered, as well as in the logo variant shown opposite (with and without the strapline).

ESL is a wholly owned subsidiary of the University of Essex Students' Union, providing students with accommodation in private properties. The company originally traded under the name Essex Student Lets, then Student Lets. Following a rebrand across various services offered by the Students' Union ("SU [service]"), the name SU LETS was adopted. The main logo used by ESL is shown opposite. This was subsequently amended to the second version, increasing the gap between SU and LETS, also shown opposite (the Court surmised that this was in response to a letter of claim issued by SUL).

Having issued a letter of claim in May 2016, SUL brought proceedings for trade mark infringement and passing off in January 2017.

CORE ISSUE

The core issue to be decided in the case was whether ESL could avail itself of a s11(3) defence: that a registered trade mark is not infringed by use in the course of trade in a particular locality of an earlier right which applies only in that locality. ESL denied

infringement and passing off, but accepted this was the key point.

The main factual issues to be considered in this regard were:

- whether ESL had goodwill in the SU LETS sign prior to the filing date of SUL's trade mark application; and, if so
- whether SUL had existing goodwill at that earlier date, which would trump the defence.

On the second point, ESL did not argue that SUL had no goodwill, but rather that it was restricted, and local, to Leicester.

INFRINGEMENT

The Court considered the question of infringement under ss10(1) and 10(2) of the Trade Marks Act 1994.

Following a brief comparison of the marks and applicable case law (notably the High Court finding that WEB-SPHERE was identical to WEBSPHERE), the Court found that SU LETS was identical to SULETS. There was, on that basis, trade mark infringement under s10(1).

In the event that the conclusion that the marks were identical was wrong, then, for the purposes of s10(2), the Court needed to consider the additional strand of a likelihood of consumer confusion. The Court briefly considered some instances of purported actual confusion, comprising three emails intended for ESL being sent to SUL, one payment intended for ESL being made to SUL, and three telephone calls to ESL meant for SUL. The "confused" individuals did not provide

KEY POINTS

✦ The facts of this case are an interesting demonstration that goodwill can accrue across a far broader geographical area than a consideration of where services are provided may suggest

✦ Section 11(3) defences require a right in a locality, and a national goodwill may destroy the defence





“ *The services being provided were not ‘inherently localised’ or analogous to those of an estate agent* ”

only in a particular locality (Essex). If it were nationwide, the defence would fail.

The Court heard no specific arguments on this point, but found that it was highly improbable that most or all of ESL’s customers were local. In that case, the goodwill could be on a national (albeit small) scale, and ESL could not rely on the s11(3) defence.

Irrespective of the above, the s11(3) defence would also fail if SUL could demonstrate an even earlier goodwill, as at September 2014.

SUL presented evidence of continuous activity since 2012, and ESL did not seriously contest that it had goodwill at the relevant date, but simply that the goodwill was confined to Leicester. The Court disagreed. The services being provided were not “inherently localised” or analogous to those of an estate agent. The Court discussed the “long tradition” of students leaving their home town to attend a university far afield. As such, SUL seeks customers from far outside the Leicester area, many of whom will return home. For that reason, SUL’s goodwill is national, and the s11(3) defence must fail.

Having found trade mark infringement, the Court dealt very briefly with the passing off claim. Having already found that SUL enjoyed goodwill and concluded the respective signs were, at least, very closely similar, findings of misrepresentation and damage were fairly self-evident. The claim for passing off succeeded.

CLEAR CUT

While the trade mark infringement question was fairly clear cut, the discussion of the s11(3) defence, and how and where goodwill may accrue, is an interesting one. Student letting services for an institution in one city would immediately seem to be a local service, with all the connotations for goodwill that implies. It is an important illustration of the need to consider very carefully who customers are and the fact that, as always, passing off turns on the evidence.

evidence, and the Court struck a cautious tone about the relevance of these incidents, hypothesising that it was unlikely the parties would become aware of any confusion that occurred.

On the question of whether there was a likelihood of confusion, the Court found the answer to be “yes”. The use of the identical or highly similar sign for identical services would lead to a likelihood of confusion. References in ESL’s materials to the University of Essex did not preclude this finding, or a connection being made to SUL.

S11(3) DEFENCE

Having found in favour of SUL on the infringement point, the Court considered the defence. Following a discussion of recent case law, the Court went on to consider the two core points outlined above.

ESL adopted the SU LETS branding in September 2014. The application date for SUL’s UK trade mark was March 2015. The evidence supplied in support of the defence was, in the Court’s words, “rather unsatisfactory”. Nevertheless, it found that “the evidence is sufficient to show that some goodwill would have been built up by March 2015”. The fact that ESL had previously used the STUDENT LETS name was found to have eased this build-up, as existing customers would have understood the evolution.

In addition to showing goodwill existed, for s11(3) to bite, ESL needed to show it subsisted

SUL’S LOGO



ESL’S LOGOS



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Wave goodbye

Sarah Williams sets out why a soft-drink mark was not successful

PepsiCo, Inc (the Applicant) filed an application for a declaration of invalidity against UK trade mark registration No 3175612 (the Registration) in the name of Teng Yun International PTE Ltd (the Proprietor), relying on ss5(2)(b), 5(3), 5(4)(a), 5(4)(b) and 3(6) of the Trade Marks Act 1994. The Registration featured a surfer and wave device (shown below right, bottom) covering “soft drinks and non-alcoholic drinks”.

The Applicant is the proprietor of UK and EU trade mark registrations for the PepsiCo device in respect of “mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages”.

The Applicant submitted evidence to substantiate a reputation in its trade marks (used since 2009), which, among other things, highlighted that, together, Pepsi Max and Pepsi had a market share of 11 per cent of the UK’s carbonated drinks market in 2015. It highlighted that the Pepsi globe (shown right, top) is used on its own and in addition to the word “Pepsi”, and that the brand appeared prominently in television campaigns featuring Beyoncé.

COMPARISON

The UK IPO found that the goods covered by the Registration were identical to those covered by the Applicant’s earlier mark. As part of the global comparison of the marks, it found that, although “there is a certain degree of similarity between the dominant and distinctive elements of the marks”, ultimately, “there is a low degree of visual similarity”. Despite arguments and evidence of enhanced distinctiveness, the Applicant was unable to establish that a likelihood of confusion would exist.

CONFUSION

The IPO accepted that the Applicant owned substantial goodwill in a business trading in carbonated soft drinks in the UK at the relevant date. However, the Registry was not persuaded that there would be instances of confusion, and



therefore found that “it is unlikely that a substantial number” of the Applicant’s customers or potential customers would be “deceived in this way”.

REPUTATION

The IPO decided that the earlier trade marks had a strong reputation in the UK/EU in relation to carbonated soft drinks and that the degree of similarity between the marks was sufficient for a significant section of the public to make a link between them. The Applicant successfully argued that the Proprietor intended to free-ride on the reputation of the earlier trade marks in order to obtain a marketing advantage, which it had not paid for. It was deemed that the get-up of the Proprietor was sufficiently similar to the get-up of the Pepsi product as to be intended to take advantage of it. It was decided that the contested mark would take unfair advantage of the earlier marks, and the invalidity action was successful on these grounds.

REMAINING ISSUES

While there was no real need to decide on the ss5(4)(b) and 3(6) grounds, the IPO did consider them, and the application for invalidity would have also failed on the basis of these grounds. It would be interesting to see whether the same decision would have been reached if the background of the Registration had not been blue.

KEY POINTS

- It is not necessary to show that a proprietor of a conflicting mark intended to take unfair advantage, only that it could
- Though we are often encouraged to rely only on the earlier right, consider reputation and distinctive character in respect of unfair advantage, not only likelihood of confusion

THE PEPSICO LOGO



THE REGISTRATION



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Style over substance?

Descriptive marks can be difficult to enforce, warns Rachel Hearson

On 18th March 2016, Muhammad Awais and Ishtiaq Ahmad (the Applicants) filed a UK trade mark application for the mark shown bottom right covering “retail services in relation to foodstuffs” in class 35. Whole Foods Market IP, LP (the Opponent) opposed the application on the basis of ss5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994, relying on an EU trade mark registration, also shown below, covering class 35. Following a hearing, the UK IPO refused the opposition in its entirety.

SUFFICIENT EVIDENCE

The UK IPO concluded that the Opponent’s evidence was sufficient to show that it had goodwill in the UK in relation to supermarket or convenience store services, with an emphasis on natural and organic products. Goodwill was found in both its logo and the word mark WHOLE FOODS MARKET, but not, as the Opponent claimed, in the word mark WHOLE FOODS.

The IPO went on to consider misrepresentation and the potentially descriptive nature of the Opponent’s marks. Although dictionaries and other standard reference works have been consulted in previous decisions, in this case, the IPO spent significant time considering definitions for the Opponent’s marks and asked the parties for their views on this point. It held that, while the Applicants’ and Opponent’s marks shared the words WHOLE FOOD(S), the words WHOLE FOODS in the Opponent’s marks were entirely descriptive of the type of goods being sold. The differences between WHOLE FOODS MARKET (stylised or otherwise) and the Applicants’ mark were sufficient to avoid misrepresentation.

The “mere wondering” on the part of a consumer as to a trade connection between undertakings was not sufficient for passing off. Consequently, the s5(4)(a) opposition failed.

DISTINCTIVENESS OF MARKS

Stating that the distinctive character of the Opponent’s mark rested in its stylisation, and not the words WHOLE FOODS, the IPO held that the visual and conceptual differences between the marks were sufficient to avoid confusion. The average consumer was unlikely to consider that the common presence of a descriptive term such as WHOLE FOOD(S) was a result of the same or related undertakings. Further, it stated that there could be no unfair advantage when the Applicants were simply using the same descriptive words as part of their mark, and nor would the distinctiveness of the Opponent’s mark be diluted. On this basis, the ss5(2)(b) and 5(3) oppositions failed.

FINAL WORD

This decision serves as a useful reminder as to the difficulties surrounding the enforcement of descriptive trade marks. While registrations for such marks can be obtained in a stylised format, the distinctiveness of such

marks often lies in the stylisation itself, and any protection for the descriptive word element(s) is likely to be weak. Further, even if goodwill has been acquired, the descriptive nature of such marks means that it can be difficult to show how misrepresentation can arise. Registrations for descriptors in stylised or logo formats can provide some protection and occasionally act as useful deterrents. However, trade mark owners should be reminded that they cannot claim a monopoly in descriptive word marks and will struggle to prevent third parties from using them.

“
The Applicants
were simply
using the same
descriptive words

KEY POINTS

- + While registrations for marks can be obtained in a stylised format, protection for the descriptive word element(s) is likely to be weak
- + Even if goodwill has been acquired, the descriptive nature of the mark means that it can be difficult to show how misrepresentation can arise

THE OPPONENT’S LOGO MARK



THE APPLICANTS’ MARK



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No go for storage sign

Attempts to limit scope proved no help, says Richard May

In August 2016, Go Box Self Storage Ltd (the Applicant), which operates a self-storage business, filed a series application in the UK for the signs depicted below right in class 39 for “self-storage of goods; self-storage of containers and cargo; transit of goods to and from self-storage; *none of the aforesaid being transport, delivery or courier services* [emphasis added]” (the Application).

GO! Express & Logistics (Deutschland) GmbH (the Opponent) opposed the application under s5(2)(b) of the Trade Marks Act 1994. The Opponent is the owner of a mark (also depicted below right) which covers class 39 and offers transport and logistics services.

The Applicant’s case largely rested on two points: (1) the express limitation “none of the aforesaid being transport services” removed any overlap with the Opponent’s transport services; and (2) the actual use of the applied-for mark was not in relation to transport and logistics services – it was used in relation to a self-storage business.

When considering the Applicant’s first point and comparing the contested services, the Hearing Officer (HO) considered the Postkantoor principle: exclusions should remove categories of goods and services, not their particular characteristics. Following this principle, the HO found that the exclusion of “transit of goods to and from self-storage; none of the aforesaid being transport” lacked clarity. The HO concluded that the exclusion made no sense and could not operate correctly because it is not possible to have a “transit of goods” that is not “transport”, as the act of something being transited is identical to transporting something. Accordingly, the HO found the contested transport/transit services identical.

QUESTIONS OF USE

When considering the Applicant’s second point, the HO reminded herself of the

concept of notional use and that rights holders are entitled to protection against a likelihood of confusion with an applicant’s mark based on the “notional” use of the earlier mark for all the goods and services listed in the registration. The HO decided that nothing would turn on the actual use of the contested marks because the current marketing or trading patterns of the parties may change.

CONFUSION

The HO went on to compare the contested marks and found them to be similar. She found that GO! dominated the overall impression of the Opponent’s mark because of the descriptiveness of EXPRESS & LOGISTICS. She then found that GO BOX dominated the overall impression of the Application because the words MOBILE SELF STORAGE and the basic square device element lacked distinctiveness for the services applied for. Consequently, a finding of confusion followed, and the Application was rejected.

LIMITATION LESSON

This case highlights that a specification limitation must be considered carefully. If it makes no sense, even if accepted on examination, an HO will discard it. In addition, the concept of notional use was applied once more, and the Opponent was able to prevent a similar mark from proceeding to registration, even though, in practice, the actual use of the Application might not cause confusion.



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KEY POINTS

- The HO applied established case law and discarded an ambiguous exclusion of services, which rendered the contested services identical
- The Opponent succeeded in arguing a likelihood of confusion based on the notional and fair use of the contested marks

GO BOX’S UK APPLICATION NO 3179177



GO! EXPRESS’ EARLIER EU REGISTRATION NO 10795144



Bad news for bears

More active use may have changed this outcome, says Oliver Tidman

Orkla Confectionery & Snacks Finland AB (the Opponent), owner of the popular Panda confectionery brand, has been moderately successful in its recent attempt to oppose a request by “Grand Candy” LLC (the Holder) for an international trade mark registration (the IR) for a panda device (the “Grand Candy” Panda, shown below right) to be protected in the UK. Relying on a number of previously registered and unregistered trade marks in the UK and EU, the Opponent pursued its opposition under ss5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 in respect of a range of class 30 goods.

As part of its evidence, the Opponent submitted a “brand tracking report” that consisted of survey evidence that Panda was the best-rated brand of liquorice in Finland. The Holder argued that this report should be excluded because it was survey evidence. Given that the Holder should have objected at the time the evidence was filed or when filing its evidence in response, the Hearing Officer (HO) decided that it was too late to raise the issue of admissibility. Nonetheless, the HO took the Holder’s criticism of the survey into account and decided to give it marginal evidential weight.

HO ANALYSIS

The further analysis focused on the marks in question, and whether the Opponent had made genuine use of its trade marks.

The Opponent claimed to have used the word PANDA and a panda device (the Orkla Panda, shown right) in the UK since at least 1982 and 1993, respectively, in relation to both chocolate confectionery and liquorice confectionery. It was accepted that the Opponent had used PANDA and had also acquired goodwill in the UK in relation to liquorice confectionery. However, the HO considered there to be insufficient, or no, evidence that the Orkla Panda had been put to genuine use in the EU during the relevant period. Accordingly, the Orkla Panda could not be relied on for the purpose of the opposition proceedings.



The HO found no visual similarity between the earlier marks and the contested IR, as the three-dimensional representation of the panda incorporated into the packaging of the Holder’s goods made a strikingly different visual impression to the earlier marks.

Although the marks were found to be conceptually identical, the HO considered the visual differences between them to be too great to result in a likelihood of direct confusion.

In reconciling all of the above, the HO was persuaded that use of the IR in relation to liquorice confectionery would cause a significant proportion of average consumers to believe that the IR was a new mark of the Opponent and result in a likelihood of indirect confusion. Therefore, with the exception of liquorice confectionery, the opposition based on s5(2)(b) failed in respect of all class 30 goods in the contested IR.

Given the finding that the Opponent had not shown evidence of genuine use of the marks in relation to chocolate confectionery, goodwill in the UK could not be established. Accordingly, the HO concluded that the opposition based on s5(4)(a) failed.

SWEET DECISION?

Although both parties had a measure of success, the ultimate outcome provides a useful reminder that it is for the proprietor to show that actual use has been made of its marks.

KEY POINT

- Trade mark owners must demonstrate active genuine use in relation to all goods or services of their marks in all relevant territories

THE “GRAND CANDY” PANDA



THE ORKLA PANDA



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Dilution denied

Yet the opposition succeeded on confusion, reports Nick Bowie

This decision relates to the Opposition by Bridgestone Corporation (the Opponent) to UK application No 3142642 by Campagnolo Srl (the Applicant) for the POTENZA 11 logo shown below left, covering a range of parts and components for bicycles.

The Opponent relied on two earlier EU trade marks (EUTMs) for POTENZA (No 4165809, entered in the register on 21st February 2006) and POTENZA S007 (No 11868734, entered in the register on 15th October 2013). The former covers a broad range of parts and components for vehicles, while the latter protects a range of tyres and inner tubes for vehicles, including bicycles. The Opponent claimed a likelihood of confusion pursuant to s5(2)(b) of the Trade Marks Act 1994. In the context of EUTM No 4165809, it also applied to add s5(3) (unfair advantage or detriment to a reputation) as a ground for opposition and introduce evidence of a reputation in the POTENZA trade mark in the UK, after the Applicant had filed its initial counterstatement (in which EUTM No 4165809 was put to proof of use).

Following a case management conference (CMC), the Hearing Officer (HO) accepted the request to add s5(3) and relevant evidence, ordering the Opponent to pay the Applicant £350 to cover the cost of filing an amended defence. After a second CMC, a short extension of time was granted to the Opponent, despite “quite weak” arguments in support. The HO also accepted the Applicant’s request to consider a specification limited to “gears, derailleurs, controls, brakes, chains, cranks, being parts and components of group sets for racing bicycles”, as an alternative to the original specification.

CONFUSION

The Opponent’s evidence established that EUTM No 4165809 had been used in the relevant period in relation to “tyres for motor cars” and was limited accordingly. The HO found that the marks POTENZA and the POTENZA 11 logo were similar, but the goods dissimilar, not least because of the differences in application of the relevant goods to cars versus bicycles. The s5(2)(b) ground based on EUTM No 4165809 was dismissed.

In the context of EUTM No 11868734, the HO held that the marks were visually and aurally similar to a high degree. The most relevant goods protected by the earlier right, namely “tyres for bicycles; inner tubes for bicycles”, were deemed similar with the Applicant’s goods to a low degree. In the HO’s view, the high degree of similarity between the marks outweighed the low degree of similarity between the goods, irrespective of which specification was considered. The s5(2)(b) ground based on EUTM No 11868734 succeeded.

REPUTATION

The HO acknowledged a “medium” reputation in the POTENZA mark in the UK and concluded that UK consumers could make a link between two undertakings. However, absent a likelihood of confusion with EUTM No 4165809, the risk of unfair advantage and detriment was hypothetical only. The s5(3) ground was rejected.

Therefore, the Opposition succeeded on s5(2)(b), and an award of costs of £1,750 was made in favour of the Opponent (after £500 was deducted).

In summary, to avoid an impact on an award of costs, consider setting out grounds for opposition from the outset and introducing relevant evidence in reply only. In the context of a s5(3) claim (in particular, dilution of reputation), success is unlikely in the absence of a likelihood of confusion pursuant to s5(2)(b).

KEY POINTS

- + To avoid an impact on an award of costs, set out grounds from the outset
- + In the context of a s5(3) claim, success is unlikely in the absence of a likelihood of confusion pursuant to s5(2)(b)

UK APPLICATION
NO 3142642



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Chainsaw mark lacks teeth

Dale Carter reveals why a colour mark was felled

Andreas Stihl (Stihl) is a well-known manufacturer of power tools, especially chainsaws. In 2006, Stihl applied to register the trade mark shown below right (Image 1) in the EU for goods in class 7. The mark was registered in 2008 based on evidence of acquired distinctiveness. In 2008, Stihl applied to register a colour trade mark, also shown below right (Image 2), covering “chain saws”.

The application included appropriate colour indications and a description: “The colour orange is applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw.” Stihl’s application was accompanied by an image of a chainsaw exhibiting an orange and grey livery (Image 1), and evidence demonstrating acquired distinctiveness through use. The mark was registered in 2011 (the 2011 Registration).

Giro Travel Company (Giro) imports and sells chainsaws in Romania, some of which are coloured orange and grey. Stihl commenced proceedings against Giro for infringement of the 2011 Registration. Giro then applied to declare the 2011 Registration invalid on the grounds that it was registered in breach of Articles 7(1)(a), (b) and (d) of the EU Trade Mark Regulation, and arguing that the mark had been filed in bad faith.

The Cancellation Division rejected Giro’s invalidity application, finding that the description, the colour representation and the other elements furnished at the time the EU trade mark was filed were clear and precise. Further, those elements enabled a systematic arrangement of the colours to be perceived in a predetermined and uniform way.

While the 2011 Registration was found to be devoid of inherent distinctive character, Stihl’s evidence of acquired distinctiveness was sufficient to overcome this. Having found Stihl’s mark to be distinctive through use, it was not necessary to consider the Article 7(1)(d) objection. Giro’s bad faith claim failed.

APPEAL PHASE

Upholding Giro’s appeal under Article 7(1)(a), the Board of Appeal found that the graphical representation of Stihl’s mark lacked clarity and precision. It had no shape or contours and the colours could be combined in different ways. The description was imprecise, as the arrangement of colours could take a variety of forms.

The Cancellation Division had erred in considering Image 1 when assessing graphic representation – it did not form part of the representation and was not included in the publication of the mark in the Register. Even if it had been acceptable to consider this, Image 1 rendered the written description ambiguous by not clearly identifying the top (or bottom) of the chainsaw housing. Further, the mark that constituted the 2011 Registration indicated that the ratio of colours was 50:50, which was not supported by Image 1.

COLOUR CHALLENGES

Stihl’s attempts to provide clarity and precision by including a description and an illustrative example were its undoing, because these were too vague, introduced ambiguity and permitted the mark to be used in a plurality of forms. Perhaps Stihl should have protected images of each of its chainsaws bearing its distinctive livery, rather than relying on a colour combination trade mark to catch all variants. This case is a reminder that, where colour marks are sought, care is needed to ensure the combination shows the systematic arrangement of the colours in a uniform and predetermined manner.

KEY POINTS

- ✦ Attempts to protect a combination of colours that could be used in a variety of forms do not meet the requirements of Article 4 EUTMR
- ✦ Where descriptions are included, they will be assessed in conjunction with the mark

IMAGE 1: STIHL MARK 2008



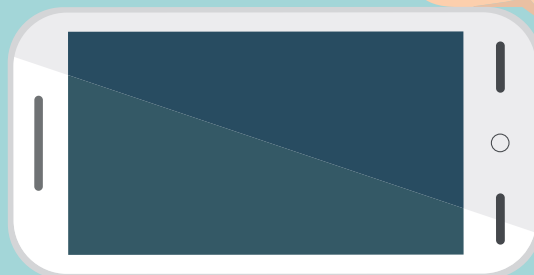
IMAGE 2: STIHL MARK 2006



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Better late than never



Tardy evidence was still admitted, writes
Melanie Stevenson

The Appellant, mobile.de GmbH, challenged the entitlement of the Board of Appeal (BoA) to take into account proof of use of the earlier right relied on by the Applicant for invalidity, Rezon OOD, filed for the first time on appeal. The General Court (GC), and now the CJEU, has upheld the BoA's decision.

BACKGROUND

The Applicant applied to declare invalid the Appellant's Community trade mark registrations for MOBILE.DE word and figurative marks (registered in classes 9, 16, 35, 38 and 42) under Article 53(1) of the EU Trade Mark Regulation (EUTMR), corresponding to Article 8(1)(b) EUTMR, relying on its earlier Bulgarian registration of the figurative mark shown below right for services in classes 35 and 42. The Applicant was put to proof of use of its mark. EUIPO's Cancellation Division considered that it had not adduced sufficient evidence and rejected the invalidity applications accordingly.

On appeal, the Applicant filed additional proof of use of its earlier mark. The BoA, taking this late-filed evidence into account, decided that the Applicant had proved genuine use of its mark in respect of advertising services for motor vehicles, and referred the cases back to the Cancellation Division for further examination. The Appellant appealed to the GC, which upheld the BoA's decisions. The Appellant's request to reopen the oral part of proceedings following the Advocate General's opinion was denied.

THE APPEAL

The Appellant appealed the GC's decision to the CJEU on a number of grounds, including whether or not the BoA was correct, or even permitted, to take into account the proof of

use filed for the first time on appeal. The Appellant contended that there was no need for this evidence to have been filed late – indeed, it predated the original invalidity applications. Moreover, in contrast to oppositions – where opponents have to carry out their evidence-gathering exercise within a prescribed, relatively short time frame – cancellation applicants face no such constraints, and so should be able to put forward their best case in full at the point of filing the invalidity action.

The CJEU dismissed these grounds of appeal. According to settled case law, EUIPO has broad discretion to accept late-filed evidence. Such evidence is more likely to be accepted where it is, on the face of it, likely to be relevant to the outcome of the proceedings, and where it is not precluded by the circumstances of the stage of the proceedings. In this case, the GC had established both that the evidence was relevant and that the proceedings were at an appropriate stage to allow for consideration of new evidence.

The remaining grounds of appeal were also dismissed as inadmissible and/or unfounded. Many amounted to a request for reconsideration of the facts, rather than a review of the points of law, and so fell outside the remit of the CJEU.

WORTH THE EFFORT

If evidence becomes available after the time frame allotted for its submission, it is worth filing it. Provided that it is relevant and that the stage of proceedings does not preclude examination of further evidence, EUIPO may well take it into account.

KEY POINTS

- + It is settled case law that the late submission of facts and evidence is possible
- + EUIPO is given broad discretion to decide whether or not to take late evidence into account. Factors include the relevance of the evidence on the outcome of proceedings, and the stage of proceedings at the point of filing

THE APPELLANT'S
FIGURATIVE MARK



THE APPELLANT'S
FIGURATIVE MARK



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Keeping time

The court again demonstrates that late appeal evidence may be accepted, observes David Kemp

Here, Philip Morris Brands Sàrl (PMB) applied to invalidate an EU trade mark registration for a cigarette pack label filed by Explosal Ltd, shown below. The action was based on a likelihood of confusion and a registered mark with reputation under Articles 8(1)(b) and 8(5) of the EU Trade Mark Regulation (EUTMR). PMB relied on a number of earlier figurative rights, but the Cancellation Division (CD) compared Explosal's mark to the WIPO mark shown below right (bottom), designating the EU.

The CD rejected PMB's action, because there was no likelihood of confusion between the marks and, as far as the 8(5) claim was concerned, PMB had not submitted any evidence of reputation.

CURIOUS OMISSION

Curiously, PMB did not file any evidence of reputation before the CD to support either enhanced distinctiveness or a reputation in the EU. PMB had intended to file evidence after Explosal's observations, but, as Explosal did not reply, the adversarial proceedings were closed, and PMB was unable to submit its evidence. When PMB appealed, the Board of Appeal (BoA) rejected this argument, saying the evidence should have been filed at the time of the invalidity action. Moreover, the BoA agreed with the CD that the marks lacked similarity because the dominant elements at issue were MARLBORO and RAQUEL, respectively, which were dissimilar.

On appeal, PMB filed evidence in support of its original claim for the first time, consisting of a copy of an earlier decision against the trade mark SUPER ROLL (figurative), where a reputation in PMB's "rooftop" device was confirmed. PMB also filed documentary evidence. However, this was rejected as being new. Even had it been admissible and the reputation proven, the BoA said, the very low degree of similarity between the marks was insufficient for a link to be made.

PMB next appealed to the General Court (GC), which held it was not for the Court to rule on the invalidity of Explosal's registration. Central to the GC's decision was PMB's reliance on SUPER ROLL and the late evidence. The GC held that the BoA had made a procedural error in breach of the principle of "sound administration", because the evidence was genuinely relevant to the outcome of the proceedings. Being able to make a fully informed decision when ruling on proceedings was part of this principle, and the BoA should have admitted the evidence, even if only to dismiss it, having reviewed it. The BoA's

decision was therefore annulled, and the case remitted to the BoA for a decision on the invalidity.

“

Late filing of evidence during the appeal stage may be acceptable

AGE OF UNCERTAINTY

This decision illustrates that, in some cases, late filing of evidence during the appeal stage may be acceptable to enable the full facts to be considered.

The potential for uncertainty, however, illustrates that evidence should always be filed in a timely manner.

The amendments to the EUTMR that came into effect on 1st October 2017 in respect of arguments and evidence in support of invalidity and revocation proceedings bring into line procedural rules on cancellation and opposition proceedings. The changes allow submissions and evidence to be filed at a later date, rather than with the application, which should be well before the proprietor files its response.



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KEY POINTS

- + This decision illustrates that in some cases, late filing of evidence during the appeal stage may be acceptable to enable the full facts to be considered
- + The potential for uncertainty, however, also suggests that evidence should always be filed in a timely manner

EXPLOSAL LTD'S MARK



THE PMB FIGURATIVE MARK COMPARED



Court finds clear difference

“Sol” marks were sufficiently distinct, says Emmy Hunt

This decision concerns an application by Claro Sol Cleaning, SLU for the EU trade mark shown below right (bottom) for services in classes 35, 37 and 39. Solemo Oy opposed the application on the basis of its prior Finnish registration for the figurative mark also shown below right (top) covering services in classes 35, 37 and 39.

CASE HISTORY

The Opposition Division found the marks insufficiently similar to permit a successful opposition under Article 8(1)(b) of the EU Trade Mark Regulation, despite the identity/close similarity of the majority of the specified services. There was a low degree of visual similarity, limited phonetic similarity and no conceptual similarity (as the word “sol” did not convey any meaning in Finnish). The level of attention of the relevant public was average to high.

The Board of Appeal (BoA) partially annulled the Opposition Division’s decision, finding a likelihood of confusion among the Finnish public. It agreed that the level of attention of the public was average to high, but found that consumers would view the elements “Claro” and “Sol” as dominant. Consequently, the opposition was successful in relation to all of the services found to be identical or similar.

GC DECISION

The Applicant argued that the BoA’s assessment of similarity was incorrect. In particular, the BoA had not properly taken into account the relevant public when determining whether a likelihood of confusion existed. Re-examining the issue, the General Court (GC) found that:

1. “Claro Sol” was not dominant within the mark applied for, which also included several other elements and figurative aspects. “Claro” and “Sol” visually stood out from the mark and were more likely to be noticed. The words “desde 1972” would not be understood in Finland (and were not negligible), and the distinctive figurative aspects of the mark

were viewed equally, and were different to the figurative aspects of the prior mark. It was necessary to take into account the overall impression of the marks, rather than individual features.

2. Visually, the common elements “sol”; the colour red and the graphical lines were insufficient to create similarity. In the context of the overall impression, these were offset by the visual differences.
3. The phonetic similarity of the marks was limited, because the application included multiple phonetic elements. “Desde 1972”

was a relevant part of the overall impression of the mark applied for. The element “Facility Services” was found to be insignificant, because, as English words, they would be widely understood in Finland.

4. The parties

acknowledged some conceptual similarity between the marks, as “sol” is Swedish for “sun” and would be widely understood in Finland (Swedish is an official language). However, the other elements of the mark (such as the musical note) lessened the conceptual similarity overall.

ENTIRETY CONCEPT EMPHASISED

The GC found that there was no likelihood of confusion between the marks, despite the similarity between the services. The decision emphasises that marks must be viewed and compared in their entirety, and that careful thought should be given to the local language(s) of the relevant public in different parts of the EU as required under the earlier rights relied upon.

“
Marks must
be compared in
their entirety”

KEY POINT

- Reviewing the dominant and distinctive aspects of the marks, the GC found sufficient difference between a composite logo mark featuring “Claro Sol” and an earlier Finnish logo featuring “Sol” to avoid a likelihood of confusion

THE SOL MARK



THE CLARO SOL MARK



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Crocs is crushed

The mighty brand fell prey to a novelty attack, as John Coldham explains

US footwear manufacturer Crocs, Inc has been highly successful, selling over 300 million clogs globally since 2002. However, in March it was dealt a major blow and lost legal protection in Europe for its most famous clog design.

Precipitating this action was an application on 22nd November 2004 by Western Brands LLC to register a Community design, claiming the priority of a US design patent application filed on 28th May 2004. The Community design was registered in February 2005 (No 257001-0001) and was transferred to Crocs in November 2005.

The dispute at issue began in March 2013, when French retailer Gifi Diffusion filed an application to invalidate the design with EUIPO. Gifi Diffusion alleged that the design lacked novelty because it had been disclosed more than a year before the priority date, here defined as the date Crocs filed the application for a US design patent (28th May 2004).

Under the Community Designs Regulation, designs must be novel and possess individual character. However, these attributes can be destroyed if the design is made public more than a year before the priority date. This can often apply even if the design is first disclosed outside the EU.

EARLY ATTEMPT

Gifi Diffusion presented evidence of prior disclosures by way of: (a) an exhibition at a boat show in Florida; (b) the sale of 10,000 pairs of clogs in America; and (c) display on Crocs' website. However, in February 2014, the Invalidity Division declared that there was insufficient evidence of prior disclosure, as some evidence was of poor quality and was not dated. As such, Gifi Diffusion's first attempt to invalidate the design was dismissed.

In response, Gifi Diffusion filed a notice of appeal and produced to the Board of Appeal

(BoA) better versions of the evidence previously submitted. Taking this evidence into account, the BoA annulled the decision of the Invalidity Division, and declared the design invalid on 6th June 2016.

Perhaps unsurprisingly, given the importance of the design to its business, Crocs appealed the decision to the General Court. On appeal, Crocs focused on its website disclosures of the design, claiming that this disclosure concerned events that could not reasonably have become known in the normal course of business to shoemakers operating in the EU. The Court rejected this, concluding that anyone in the EU could have accessed the design. Further, the Court agreed with the BoA that disclosures prior to 28th May 2003 had destroyed the design's novelty. Ultimately, the Court found no sufficient basis to reverse the BoA's finding.

CAUTIONARY TALE

This decision serves as a cautionary tale for designers, reminding them to file for design protection early and to be careful about prior disclosures. Many industries operate in an international market and, therefore, disclosure outside the EU is likely to form the basis of a novelty attack. Companies would be well advised not to rely on the grace period in any event; it is all too easy to forget that, in other parts of the world, grace periods are shorter or nonexistent.

KEY POINT

✦ Designers should file for design protection early and be mindful of prior disclosure to avoid exposure to a novelty attack



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Alexandra Mierins, a Trainee Solicitor at Gowling WLG, co-authored.

No respect paid to Mafia mark

Public policy was paramount here, as Richard Burton reports

In 2006, Spanish company La Honorable Hermandad, SL (succeeded by La Mafia Franchises, SL) filed an EU trade mark application for the mark shown below right in relation to, *inter alia*, “catering services”.

The mark was registered in 2008. In 2015, the Italian Republic sought to invalidate it on the basis of Article 7(1)(f) of Regulation 2017/1001, namely that it was contrary to public policy and to accepted principles of morality. The EUIPO Cancellation Division held that the mark promoted the criminal organisation known as the Mafia, and that the full text of the word elements of the mark conveyed a message of conviviality and trivialised the word element “La Mafia”, thereby distorting the serious connotations of that word. La Mafia Franchises sought to annul that decision before the General Court (GC).

GLOBAL UNDERSTANDING

The GC dismissed the action, confirming the EUIPO first instance decision. It emphasised that “La Mafia” was the dominant element of the mark and would be understood worldwide to refer to a criminal organisation that resorts, *inter alia*, to intimidation, physical violence and murder in carrying out its activities. According to the Court, those criminal activities breach the values on which the EU is founded. Moreover, the Court said, given their cross-border dimension,

the Mafia’s criminal activities are a serious threat to security throughout the EU. The Court therefore said that “La Mafia” manifestly brings to mind, for the public, the name of a criminal organisation responsible for particularly serious breaches of public policy.

The fact that La Mafia Franchises intended the mark to allude to film series *The Godfather*, with no intention to shock or offend, was considered irrelevant. The Court also explained that the reputation acquired by the Spanish company’s mark and the concept of its theme restaurants, connected to the film series, was irrelevant for the purpose of assessing whether the mark was contrary to public policy. Further, the fact that there are many books and films on the subject of the Mafia in no way was considered to alter the perception of the harm done by that organisation. Finally, the Court sided with EUIPO and Italy’s assessment that the association of the word element “La Mafia” with the sentence “*se sienta a la mesa*” (meaning “takes a seat at the table” in Spanish) and with a red rose was liable to contribute to a trivialisation of the criminal activities of that organisation.

OFFENCE LIKELY

The mark was therefore considered likely to shock or offend not only the victims of that criminal organisation and their families, but any person who, on EU territory, encountered the mark and had average sensitivity and tolerance thresholds. It was therefore declared invalid.

A review of the EUIPO register shows that a number of marks consisting of, or containing, MAFIA are registered. However, recently, a series of applications appear to have been rejected, suggesting that the Office is tightening its grip on marks liable to cause offence.

KEY POINTS

- ✦ The lack of intention to offend did not mitigate the potential of the mark at issue to cause offence
- ✦ Decision trends suggest that EUIPO is tightening its grip on marks that are liable to cause offence

THE MARK AT ISSUE



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Join us at The Refinery Bar in July for the New President's Summer Reception →



Events

More details can be found at citma.org.uk

DATE	EVENT	LOCATION	CPD HOURS
14th June	CITMA Lecture – Glasgow The impact of company values on trade mark issues	Brodies, Glasgow G1	1
20th June	CITMA Webinar* A question of geography: 12 months of EUTM judgments	Log in online	1
27th June	CITMA Paralegal Webinar Madrid Protocol – the WIPO perspective	Log in online	
4th July	CITMA New President's Summer Reception	The Refinery Bar, London EC4	
17th July	CITMA Lecture – London* Sports trade marks: A personal view	58VE, London EC4	1
15th August	CITMA Webinar* UK IPO and EUIPO procedure – legally harmonised but procedurally different	Log in online	1
25th September	CITMA Lecture – London* Latin America: Trade marks as a tool for investments and innovation in a 4.0 environment	58VE, London EC4	1
12th October	CITMA Paralegal Seminar	Lewis Silkin, London EC4	
17th October	CITMA Webinar* An update on groundless threats	Log in online	1
1st November	CITMA Seminar for Litigators – London	TBC	2.5
8th November	CITMA Autumn Conference*	Birmingham	
14th November	CITMA Webinar*	Log in online	1
19th November	CITMA Paralegal Webinar	Log in online	
27th November	CITMA Lecture – London* Update on UK IPO and UK court decisions	58VE, London EC4	1
29th November	CITMA Lecture – Leeds Emerging professional liability risks for IP professionals	Walker Morris, Leeds LS1	1
7th December	CITMA Northern Christmas Lunch	TBC	
14th December	CITMA London Christmas Lunch	London Hilton on Park Lane, London W1	

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.

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**THE
TRADE
MARK 20**
Q&A

Amelia Skelding

is an advocate for empowerment

I work as... a Trade Mark Assistant at Keltie LLP.

Before this role, I was... a law student at Durham University.

My current state of mind is... ambitious, because I am at the start of my career, and looking forward to what the future holds.

I became interested in IP when... I studied an IP module in the final year of my law degree.

I am most inspired by... successful and strong women – and particularly by Emma Watson, because she is a well-educated woman who uses her fame and influence to address important issues, in particular the #HeForShe gender equality campaign.

In my role, I most enjoy... the diversity of the work I deal with – you never know what the next trade mark will look like or be in relation to.

In my role, I most dislike... complicated cost estimates.

On my desk is... my water bottle, my phone and lots of paper.



The biggest challenge for IP is... Brexit. Full stop.

The talent I wish I had is... mind reading, because I'm curious to know what people are really thinking.

I can't live without... my phone.

My ideal day would include... walking lots and eating treats.

In my pocket is... nothing at all. Unfortunately, my dress doesn't have any pockets, but if it did, I would have my phone, train ticket and work pass in them.

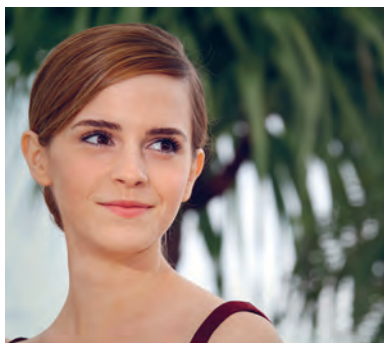
The best piece of advice I've been given is... "failing to prepare is preparing to fail".

When I want to relax, I... go for a walk with my mum or boyfriend.

In the next five years, I hope to... qualify as a Trade Mark Attorney.

The best thing about being a member of CITMA is... the events; they are a great way to expand my knowledge, experience different venues around London and network with intellectual individuals.

“
*You never know
what the next
trade mark will
look like or be in
relation to*”



My favourite mug says... "Empowered Women Empower Women".

My favourite place to visit on business is... I haven't yet been anywhere on business, but I would love to go to America.

If I were a trade mark/brand, I would be... Hotel Chocolat, because I am a chocoholic!





Trade Mark Attorney – retirement sale

- Retirement sale of this well-established firm (that also handles some patents through patents agents)
- Turnover £706,000 per last accounts Y/E 31 January 2018
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- Owner will remain for a reasonable handover period

Contact Stephanie Van Moerbeke

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