

CITMA REVIEW

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CONTESTED TERRITORY

Ian Bartlett offers his perspective on the confusion surrounding antecedent rights

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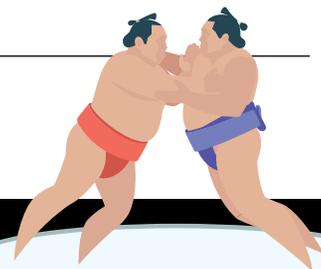
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Welcome to the February edition of the *CITMA Review*. In this issue, we look both backwards and forwards – on page 6, we remember our fantastic Christmas lunches in London and Leeds, while on page 14, we look ahead to our Spring Conference. An international cast of speakers and delegates will be joining us for what is set to be another memorable few days in London. I hope to see you there.

Elsewhere, Mark Hiddleston recounts his experience as one of three CITMA members involved in a recent review of EUIPO opposition decisions (page 8), we hear from Chris McLeod on the importance of soft skills (page 10), and Carrie Bradley gets to the business end of *bona vacantia* (page 11). Also, the Nestlé UK IP team discusses the benefits of pets in the workplace (page 16), and Ian Bartlett provides a personal perspective on antecedent rights (page 20). Finally, Chris Hoole unearths two 2017 nuggets from Nominet (page 24).

I hope 2018 is treating you well. There is much more to look forward to as the year progresses.

Kate O'Rourke

Kate O'Rourke
CITMA President

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Chief Executive's bulletin

Highlights and updates from Keven Bader's 7th December 2017 bulletin to members



BREXIT BUSINESS CASE

Hopefully, you will have seen and read our Brexit business case, published on 5th December 2017. It is pleasing to have completed the research and finalised the report; it took a lot of work to pull it together. I encourage members to use it and share it widely to help CITMA gain as much exposure as possible in relation to the issues raised. If you need any help or advice on sharing the document, particularly with your local MP, please do not hesitate to contact Richard Hayward at richard@citma.org.uk

NEW PUBLICATIONS

Following the publication of *Anti-Counterfeiting: Practice and Procedure*, written by Ralph Wehrle of Briffa (reviewed on page 5), CITMA is releasing a second publication, by Michael Edenborough QC, on the subject of contentious trade mark registry proceedings, which will be available at a discounted price for CITMA members at citma.org.uk/shop

PRIORITIES AND PLANS

With some major projects arising, we have taken a step back and looked again at the priorities and plans for 2018. The CITMA Council, at a meeting in early December 2017, agreed a set of plans, and I look forward to working towards implementing these during the course of this year.

We will be updating the website with more information in due course, but at a high level, our focus will be on: Brexit and continuing our work to raise awareness of the issues for our members

and business; promoting the profession to raise awareness of IP and create business opportunities for members; and delivering an integrated CRM system/website to enhance our delivery of services to members.

We will also continue with many other areas of work, but we are carefully monitoring the resources available, and scaling back where necessary.

VOLUNTEERING

The Law & Practice Committee is looking for volunteers to join the Litigation Working Group. This is an important group, whose work focuses on contentious matters before the IPEC and the High Court. It is represented at the user groups of both forums, and is also responsible for educating the profession in this important area. Volunteers should, therefore, have experience of litigation or, at the very least, a knowledge of and keen interest in the systems. Please email Gillian Rogers at gillian@citma.org.uk to express your interest.

We are always keen to welcome volunteers and will shortly publish more information about particular positions available on committees and working groups. You may also have seen our recent news of two exciting opportunities to which the CITMA Council recently agreed.

In April, we will be looking to appoint to Council representatives from within both the CITMA Student and Paralegal memberships. I hope that there will be plenty of interest in these new positions, and volunteering more generally.



Representing CITMA in China

CITMA Second Vice-President Richard Goddard (pictured above, second right) and CITMA Council member Rachel Wilkinson-Duffy (second left) recently represented the UK trade mark profession on a trip to China. They were joined by representatives from CIPA and the IPO, including its CEO, Tim Moss.

Meetings held in Shanghai and Beijing were an opportunity to share knowledge and best practice, and discuss some of the challenges facing the IP professions in China and the UK.

Member move



Dominic Murphy has moved from Wilson Gunn to HGF, Birmingham, where he has been appointed as Trade Mark Director.

Contact Dominic by calling +44 (0) 121 265 7930, or email him at dmurphy@hgf.com



Charter campaign recognised

CITMA SCOOPED an Association Award in recognition of its Royal Charter campaign at the Associations Congress, held in Manchester in December 2017.

The award, in the “effective voice” category, recognises our campaign to successfully

implement the Royal Charter, and our work to shape perceptions and reposition the organisation and profession.

Keven Bader and Richard Hayward (pictured above, left and right, respectively) accepted the award on behalf of CITMA.



Cricket club ready to welcome all comers

The CIPA CITMA Cricket Club winter nets sessions are now underway, and the club is happy to welcome new members of any ability. The club includes Patent and Trade Mark Attorneys who play friendly midweek games during the summer, with each season finishing with an overseas tour (Alicante visit, 2017, pictured above). Please visit cipacc.org.uk for a fixture list, or email Andy Spurr at cipaitmacc@gmail.com if you'd like to get involved. We welcome two new sponsors for the 2018 season – Dawn Ellmore Employment and Clarivate Analytics.



Reader book review

Mark Bearfoot expects this new guide to become a desktop staple

Ralph Wehrle, *Anti-Counterfeiting: Practice and Procedure* (CITMA, 2017). £79.95 for CITMA members; £99.95 for non-members (includes UK postage). Order online at citma.org.uk/shop

AS TRADE MARK professionals will know, with the ease and reach of modern digital commerce, IP crime has grown in scope, scale and complexity. Counterfeit goods now make up 10 per cent of global trade, and this market continues to grow by some six per cent every year. According to the OECD, in 2013, counterfeit trade cost the UK Government and taxpayers an estimated £3.8bn in unclaimed tax revenue.

Recognising this major challenge for rights holders, CITMA has published *Anti-Counterfeiting: Practice and Procedure*, written by Briffa Partner Ralph Wehrle.

This book provides a detailed overview of the sources of law relating to the practice and procedure of anti-counterfeiting in the UK, while also providing substantial and comprehensive expert analysis.

As a single point of reference on anti-counterfeiting law and practice, the first chapter provides the reader with clear and authoritative advice on developing and implementing an anti-counterfeiting programme. The remaining chapters go on to deliver practical commentary on pursuing criminal and civil proceedings; engaging with the Border Force, HMRC and Trading Standards; and undertaking online enforcement action.

Not only will this book become the leading and most-used work of reference in this field, it also represents excellent value for money. It will, undoubtedly, find its way onto the desks and shelves of most IP practitioners, as well as brand protection and anti-counterfeiting managers in industry.

CITMA IN A FESTIVE MOOD

We welcomed more than 670 guests from the trade mark profession to the London Hilton on Park Lane for our annual CITMA Christmas Lunch

PHOTOGRAPHY BY SIMON O'CONNOR



Northern celebration

The CITMA Northern Christmas Lunch 2017 took place in the cosy setting of the Lost & Found cocktail bar in Leeds.



Top students recognised

At our London lunch, the following CITMA members received awards:

KERRY ALLEN, Wilson Gunn

Highest mark achieved by a CITMA member on Bournemouth University's Postgraduate Certificate in IP Law course

CHRISTOPHER SMITH, Wilson Gunn

Highest mark achieved by a CITMA member on Nottingham Law School's Professional Certificate in Trade Mark Practice

BECKY KNOTT, Barker Brettell

Highest mark achieved by a CITMA member on Queen Mary University of London's Trade Mark Law and Practice Postgraduate Certificate course

LARA ELDER, Carpmaels & Ransford

Hogarth award for the highest mark achieved by a Chartered Trade Mark Attorney on Nottingham Law School's Intellectual Property Litigation and Advocacy course

NICOLA CASEY, Beck Greener (pictured above)

Thomson CompuMark award for the highest mark achieved on the 2017 CITMA Paralegal Course



Alicante: a view from the UK profession

Mark Hiddleston was one of three CITMA members who took part in a recent review of Office opposition decisions

As part of its 2020 Strategic Plan, EUIPO has been conducting a quality review of the services it provides. This included, during 2017, a series of Stakeholder Quality Assurance Panel audits at Alicante, at which members of the trade mark profession across the EU were invited to audit a random selection of opposition decisions from the Office.

Three separate events were held (in March, June and October), and each session was intensive. At each session, representatives were expected to review approximately 50 opposition decisions and make comments as to whether they were correct, or to highlight potential faults.

I was joined by Geoff Weller and Lucy Cundliffe (both of Stobbs IP) in representing CITMA. Representatives also attended on behalf of AIM (European Brands Association), the Association of Trade Mark and Design Law Practitioners, ECTA, INTA, the International Association for the Protection of Intellectual Property, the International Federation of Intellectual Property Attorneys, and MARQUES.

This was a great learning opportunity both for the Office and the representatives who took part. The Office clearly received feedback from the profession, but perhaps just as importantly, representatives had the chance to comment proactively on the Office's internal decision-making processes. In addition, the audits emphasised that, despite 20 years of harmonisation, there remain large disparities in the way that professionals across the EU handle and file oppositions. There are also still areas in which professionals' understanding of Office practice varies from the actual practice applied.

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By the third event, we could see that our input was really valued, but was also making some concrete impact within the parameters of the project

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For Geoff, the occasion was a chance to look closely at the work of the Office.

“The purpose of the audit was to find errors of format or in the opposition practice of the Office, not to point out where we simply disagreed with the conclusions of the substantive assessments,” he explains. “This focused the mind on Office practice and, for me in particular, the use of the Similarity Tool and shortcuts in decisions.”

LANGUAGE LESSON

Geoff also noted the use of language in the process: “Language was a big part of my experience. Not only was it humbling to see my EU colleagues’ fluency in reviewing and arguing in granular detail in English, their second or third language, but the relevance and importance of language to the assessments in oppositions (and ways to influence that) was reinforced for me. By the third event, we could see that our input was really valued, but was also making some concrete impact within the parameters of the project.”

Lucy says: “I was pleased to gain an insight into how much EUIPO cares about the consistency of its decision making. The audits we performed were part of a wider quality-checking exercise, and all decisions reviewed by the stakeholders had already undergone ‘ex post’ quality reviews within EUIPO. Our hosts were very interested to see where we identified the same errors as they did and, equally, where we did not.

“The sometimes lively discussions that ensued revealed a gap in the understanding of some principles of practice between the Office and stakeholders (eg for EUIPO, the concept of ‘dominance’ when assessing marks literally means ‘the visually larger or bolder’, whereas, for the majority of the professional auditors, it evidently means ‘what draws the consumer’s attention’). While our hosts were keen to ensure we stuck to the objective of checking that Office practice was adhered to in decisions (rather than attacking the practice), it was clear that they were not rigidly defending all aspects of the practice, and some of the auditor comments would be helpful in adding weight to internal debates within EUIPO about specific issues that are raised perennially.”

As a user of EUIPO, Lucy continues, “where hearings are unheard of and personal

engagement with examiners is minimal, we can find frustration creeping in when a decision appears very formulaic or bizarrely truncated”. To this end, “being forced to engage closely with ‘the practice’ and having the opportunity to meet some of the people responsible for applying it and appreciate the pressures they are under helped me to understand where some (if not all!) of the decisions are coming from”.

SIGNIFICANT COMMITMENT

From my own standpoint, I found the sessions quite gruelling. Participants were expected to review about eight decisions in advance of each session and submit their initial findings. However, it became quite clear at the first session that this preparation was absolutely necessary in order for the panel to review all of the opposition decisions in the short time frame available.

However, I found the sessions extremely stimulating in terms of the discussions with our colleagues, both those from the UK and those from elsewhere in the EU. It is also an extremely good way to find out EUIPO’s practice on specific topics. To give just one example, I had not previously appreciated that EUIPO currently holds that retail services in connection with one specific type of product are considered similar to all other forms of retail services. This

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I was pleased to gain an insight into how much EUIPO cares about the consistency of its decision making

clarification led to some relatively heated debates among the gathered panellists.

So, although those attending should appreciate that this is a significant commitment, I would thoroughly recommend taking part to any potential attendees. It is a good way to give something back to the Office in circumstances where it is clearly reviewing its internal procedures. It was also heartening to see how the Office took our comments into account. ■

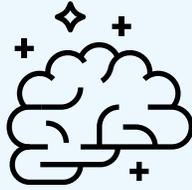
The Stakeholder Quality Assurance Panel audits are part of an ongoing audit review, and it is planned that the Office will extend the audit to examination decisions on absolute grounds later in 2018.



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The author thanks Geoff Weller and Lucy Cundliffe for their assistance with this article.



Thoughts on the soft side

Chris McLeod recently shared his tips on effective trade mark practice

A few months ago, I addressed CITMA members on what is considered the “soft side” of our job – the things that often get in the way of us doing what we are qualified, or are qualifying, to do. These can be more difficult than our core tasks. In this article, I want to set out some of the key thoughts I shared.

BUILDING KNOWLEDGE IS NECESSARY...

Yes, it is a time commitment, but clients have the right to rely on us being abreast of developments in law and practice, and we have an obligation to fulfil our continuing professional development requirements (if qualified). Far from seeing this as a burden or box-ticking exercise, I suggest that we consider it as a positive task that gives us an edge on our competitors, both in the UK and elsewhere.

... AS IS FINANCIAL HYGIENE

Because we are in this profession at least partly to make money, we need to make sure that we get paid. All of us will have war stories about clients that did not pay bills, but it can be relatively easy to avoid this situation. Clients tend not to like the surprise of a bill that's too high, and our partners, bosses and accounts departments do not like surprises relating to unpaid bills. Being transparent with clients and asking for money on account when appropriate are likely to reduce the prospect of this type of issue arising.

COMMUNICATE WITH ACCURACY

We spend most of each working day communicating with colleagues, overseas associates and other clients. Different means of communication require different levels of formality and nuance, and therefore

flexibility, skill and tact, but accuracy is an essential component.

PAY ATTENTION TO DETAIL

The word “pedant” has negative overtones, but I am not sure that it should. Clients have a right to expect our correspondence to be correct, meaning that both form and substance are important. If the form is correct, the client will be able to focus on the substance and have confidence in the advice. For this reason, I tend to check outgoing correspondence and documents to ensure that they are correct, and a second pair of eyes will often see errors that you don't. It is tempting to give a lower level of attention to what you may perceive to be trivial matters, but I would suggest that attention to detail should apply across the board.

COURTESY COUNTS

Our work tends to happen at an ever-faster pace. Email is now the default means of correspondence, and this means that we are under greater pressure, considering also the ever-present docket of deadlines in our caseloads. It can be easy to lose perspective and a degree of courtesy. While we should be confident in our own ability in the face of an adversary, we should always remain professional (not least because, at some point, we will need to call in a favour from a colleague). Remember, this is a tight-knit profession, in which it is very important to maintain a good reputation. ■



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BONA VACANTIA BURIED TREASURE?

It may sound like a European greeting, but Carrie Bradley gets to the business end of this useful legal concept

It is widely recognised within the profession that a competent, well-rounded Trade Mark Attorney must have a thorough knowledge of trade mark law and practice, as well as a sound appreciation of the commercial considerations that can influence a client's approach or position. Far less widely discussed is the value of Trade Mark Attorneys also having a good understanding of several intrinsically related areas of law and commercial practice. One of these is the area of *bona vacantia* (BV).

Upon first encountering this term, non-Latin speakers may mistakenly imagine it to mean “happy holidays”.

The correct translation – “vacant goods” – is a little less cheery, and refers to any property assets (tangible or otherwise) that no longer have a legal owner.

When a company is dissolved, its property and assets that have not otherwise been assigned automatically pass to the Crown (in accordance with the Companies Act 2006, s1012). This is much akin to the position when an individual with an estate dies leaving no heirs.

IP RELEVANCE

IP practitioners are most likely to encounter BV in the context of a dissolved company's assets, since they

often include valuable intellectual property rights (IPR).

A common situation is to find yourself acting for a client that wishes to use and/or purchase the BV IPR of a dissolved company. A common example arises where clients wish to resurrect abandoned historic brand names. Surprisingly often, the value enshrined in that well-recognised crown jewel of the previous business has been overlooked and left adrift in the sea of insolvency.

Alternatively, you may be acting for a client that is a former member or shareholder of the dissolved company and wishes to claim title to its lost IPR – often for litigation purposes or ▶

during a due-diligence process. A common occurrence is the panicked discovery by a client that it had forgotten to transfer the IPR in question out of a former holding company within its group before dissolving it. Naturally, the company ceases to exist as a legal entity from the date that it is dissolved, meaning that the situation cannot be rectified by way of a hasty assignment from the (now dissolved) company at the time of the subsequent discovery.

In another common scenario, old, unused (but still live) trade mark registrations can come up in a clearance search where the owner has ceased to exist and there is no obvious successor. In this case, understanding how a client can acquire that BV can be helpful.

ACQUIRING BV

If a company's last registered office address was in England or Wales at the time it was dissolved, its BV assets would then be dealt with by the Treasury Solicitor. The Bona Vacantia Division (BVD) of the Government Legal Department is responsible for this function and is the first point of contact for any third party interested in purchasing the BV IPR of a dissolved company.

Once you have notified the BVD of your interest in a specific IPR, it will make investigations to determine the open market value of the BV IPR in question. These "investigations" can include the requirement for a professional valuation, which, you may be surprised (and even a little miffed) to learn, the would-be purchaser is required to pay for. The BVD will then decide if a sale for that value is the most appropriate way for it to dispose of that asset.

If the current market value of the BV IPR is deemed to be minimal, it will nonetheless be subject to a set minimum sale fee, plus BVD costs of £300 per asset and VAT. The current minimum rates set by the Treasury Solicitor are as follows:

- UK trade mark = £1,000 each;
- EU trade mark = £2,000 each;
- copyright = £1,000 each;
- UK patent = £1,000 each.

As you would expect, the execution of a formal deed of assignment is required, and the responsibility and costs for recording it with the relevant IP office are solely the concern of the new owner.

RESTORATION

If you are acting for a former member, shareholder or liquidator of a dissolved

company that wishes to get its hands on "its" BV IPR, it may be possible to apply to restore the company onto the UK companies register (if the company was dissolved less than six years before).

Where this is possible, it is generally the first preference, because, upon restoration, BV no longer exists and the IPR assets automatically revert back to the ownership of the company. Of course, if, in the period during which the company was dissolved, the BVD disposed of the IPR asset in question, the newly restored company will not be entitled to retrieve the asset from (or shout at) the new assignee.

If restoration is not possible, your client must apply to acquire the BV IPR from the BVD for open-market-value consideration (as outlined above), but there is no guarantee that the BVD will be willing.

BV RISKS

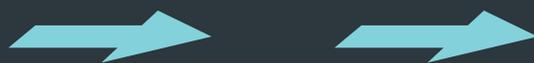
There are two main risks that a purchaser should be aware of. First, there is no title guarantee.

The BVD will not transfer BV IPR with any form of title guarantee or provide any representations or warranties in connection with it (either express or implied). This means that the risk of buying a BV IPR asset rests with the purchaser; so, if there are any past, current or future disputes as to its ownership or use, there is no comeback or liability on the BVD. Normally such guarantees are standard clauses in assignments to protect the purchaser, but not so here.

Second, there is no goodwill.

The BVD makes it expressly clear that if it sells a registered trade mark, it will not include any goodwill that may be associated with it. This could prove to be a huge headache later on if a third party claims to be the rightful owner of any related goodwill.

In the event that there was an assignment of the associated valuable goodwill, and/or if there has been no abandonment of the goodwill, then goodwill may still exist and can linger on long after the mark ceased to be used. This is known as residual





The value of conducting meticulous research into possible successors in title cannot be overstated

goodwill and could provide the assignee with a valid cause of action under passing off to prevent the use, and invalidate the registration, of the BV IPR.

On passing off, the issue of residual goodwill is discussed in *Ad-Lib Club v Granville*¹, where goodwill was held to exist four years after a business closed, and where there had been no intention to abandon goodwill. In this case, the business was a nightclub that had been forced to close as a result of a noise-nuisance injunction, and the Claimants were looking for new premises.

Another more recent example is *Sutherland v V2 Music Ltd*.² A band named LIBERTY, which achieved limited success in 1993 and which was still in existence, was held to have some goodwill in 2001 and succeeded against a new band that formed following the television programme *Popstars*.

*WS Foster & Son Ltd v Brooks Brothers UK Ltd*³ also discusses residual goodwill, although, in this case, residual goodwill was not found 48 years post-assignment of goodwill, and so could not support the Defendant's claim to having a concurrent right to use. This was due to a finding of abandonment, and insufficient evidence of continued trade. On the finding of abandonment, a trade-press article discussing *Peal & Co* (the assignor of goodwill to the Defendant) was critical in *HHJ Hacon's* decision.

A significant length of time will not necessarily be a factor, though – see *Jules Rimet Cup Ltd v Football Association Ltd*⁴, where *WORLD CUP WILLIE* was the mark concerned, and

where its last use was 40 years previously. In this case, the Court stated that the length of time itself is not a bar to a successful assertion of residual goodwill.

PRACTICAL ACTION

What, then, can we recommend in terms of practical advice as regards BV? From the perspective of avoiding future issues, companies that are scheduled to be dissolved should look closely at their IPR, and, where necessary, IPR should be transferred out before dissolution. While the processes outlined above to retrieve BV IPR are not necessarily insurmountable, they will incur time and cost that could otherwise be avoided.

From the perspective of the would-be purchaser, the value of conducting meticulous research into possible successors in title cannot be overstated. If the original company was dissolved many years ago, tracing its directors, accountants, auditors or other possible successors in title may not be easy, or even possible. In these circumstances, it may be sensible to employ the services of a professional investigator to try, as far as is reasonably possible, to identify and approach any relevant, potentially interested third parties.

Trade and other press articles can also be helpful in investigating the history of a dissolved company, and

can provide useful evidence in any proceedings that may arise following the acquisition or use of BV IPR.

If investigations reveal that the original company effectively abandoned the relevant business and use of the mark, where no other third party uses the mark, then the risks of proceedings with purchasing BV IPR should be relatively low.

Insofar as any use of a mark that has become BV has continued through a related or other third party, greater caution should be exercised when a business is deciding whether to purchase and/or use BV IPR. Drilling down into the detail of the identity of the third party using the mark, and how it may be related to the original company, will be key. It may be that the third party has a legitimate claim to the goodwill. Conversely, it may be that you have discovered an instance of brand hijacking, in which case the registered BV IPR may be very useful, unless the third party is deemed to have kept the goodwill of the original company alive or has generated its own “new” goodwill in the same name. All told, having a sound appreciation of the issues and processes surrounding BV IPR is a useful tool in a practising Trade Mark Attorney's arsenal. ■

1. [1970] 2 All ER 300; [1972] RPC 673.
2. [2002] EWHC 14 (Ch); [2002] IP & T 904.
3. [2013] EWPC 18.
4. [2007] EWHC 2376 (Ch).



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IP IN A GLOBAL ECONOMY

Our 2018 gathering will feature our most international line-up ever

This year's CITMA Spring Conference will welcome a global panel of speakers to London's iconic County Hall on 21st–23rd March. With talks on counterfeiting around the globe and debates about IP internationally, we plan to set the world to rights. At a time when countries face increasing challenges in enforcing IP on the global stage, we are proud to be bringing together some of the biggest names in the worldwide trade mark community to discuss the issues.

This year's headline event will see three industry heavyweights – Grant Lynds (President, Intellectual Property Institute of Canada), Richard Baddeley (President, Institute of Patent and Trade Mark Attorneys of Australia) and Shunji Sato (Chair, International Committee, Japan Trademark Association) – talk counterfeiting in their respective jurisdictions. Expect lively debate as they discuss precluding and deterring such activity.

We will also hear from Samantha Foulkes, Richemont International, who will provide an overview of the One Belt One Road Initiative in China, including the anti-counterfeiting issues it raises for her firm.

The UK IPO's criminal division will bring a UK perspective, enlightening us on high-profile seizures of branded counterfeits and how it collaborates with the Police Intellectual Property Crime Unit.

NETWORKING KICK-OFF

The Spring Conference begins with a networking drinks reception at Balls Brothers on Shoe Lane, tucked away from the hustle and bustle of the City. Founded in 1860 as a wine merchant and shipper of ports and sherries, Balls Brothers has been one of London's pre-eminent wine emporiums for more than 150 years, as well as a purveyor of exquisite spirits and classic British food.



GALA DINNER DETAILS

Like our main event, our Gala Dinner will be held at County Hall by Westminster Bridge. An Edwardian Baroque masterpiece, County Hall was opened in 1922 by George V and has recently undergone a programme to restore it to its original splendour.

The Gala Dinner will take place on the fourth floor, where you can enjoy views of the London Eye and across to the City of Westminster. Enjoy a four-course meal while London's nightlife comes into focus outside.

INCREASING ACCESS

This year, CITMA hopes to encourage attendance by in-house trade mark professionals and students so that the widest possible group can engage with our speakers and delegates. With this in mind, we are offering a 50 per cent discount on the cost of attendance for these groups.

Find out more at citma.org.uk ■

Last year's Gala Dinner took place under the gleaming hull of the



Audience members will have the chance to put questions to our expert speakers

Confirmed speakers

Among those who will contribute to our packed programme are:

- Grant Lynds, IPIC, Canada
- Shunji Sato, JTA, Japan
- Richard Baddeley, IPTA, Australia
- Matt Cope, IPO, UK
- Kate Swaine, Gowling WLG, UK
- Andrew Bellingall, ABO IP, Brazil
- Samantha Foulkes, Richemont International, UK
- Chris Schulte, Merchant & Gould, US
- Aaron Wood, Wood IP, UK
- Cameron Crowe, Gough Square Chambers, UK
- Yana Tsygankova, Rouse, Russia
- Mark Bearfoot, Harley-Davidson Europe, UK
- Selma Ünlü, NSN Law Firm, Turkey
- Denise McFarland, Three New Square, UK
- Handley Brustad, HMRC, UK
- Jonas Kölle, Merck Group, Germany

Exhibitor opportunity

Our flagship event will bring together the strength and vibrancy of the IP profession, and is a perfect place to exhibit services. The main exhibition floor is combined with break-out areas, creating a real buzz, while maintaining a relaxed atmosphere – the perfect conditions in which to network with delegates. For further details, including current stand availability, contact jane@citma.org.uk

Rates (including VAT)

Full delegate place, including conference and socials:

- Early bird (book before 31st January) – CITMA member: £685; non-member: £825
- Full rate (1st February to 7th March) – CITMA member: £800; non-member: £940
- Student/in-house practitioners receive a 50 per cent discount; use code SPRING18 at checkout

Socials-only tickets:

- **Wednesday networking drinks reception** – CITMA member: £54; non-member: £72
- **Thursday Gala Dinner** – CITMA member: £99.60; non-member: £140.40

REGISTRATION CLOSES AT 9AM ON 12TH MARCH 2018

Delegate fee includes:

- Entry to every session
- Documentation from the conference
- USB stick with speaker presentations
- Welcome drinks reception on 21st March
- Conference lunch on 22nd March and optional lunch on 23rd March
- Drinks reception and Gala Dinner on 22nd March
- Tea and coffee
- Nine earned hours of CPD



PAWS FOR THOUGHT

At Nestlé's UK head office, the IP legal team is among those reaping the benefits of canine colleagues, as Laura Vallance explains

If you are a dog-owning employee, you won't need any persuading about the arguments in favour of bringing your dog to work. Who wouldn't want to have their four-legged best friend beside them all day? But if you are an employer, you may be wondering: what's in it for me? Why should I go to the bother of rearranging the office to make it comfortable for canines?

For over 14 years, Purina PetCare has encouraged its employees to bring their pets to work, recognising the positive impact pets can have in a professional environment. When the company moved into offices with its parent company Nestlé in 2014, it wasn't long before the entire business sniffed out the benefits. November



“

The company's three-step 'pawthorisation' process involves a detailed questionnaire about the dog's habits

(L-R) Catherine Regan, Senior Legal Counsel at Nestlé, with her West Highland White Terrier, Fred; Siobhan Ferguson, Legal Counsel at Nestlé, with her miniature Chihuahua, Lulu

Why pets work: the key benefits

Research from Purina has found that:



41% of companies that have dogs in their offices have seen them calm and de-stress the workforce



32% of employees say that having a dog in the office is a morale booster, and that dogs raise confidence, enthusiasm and levels of creativity



29% of employers with office dogs say the pets encourage social interactions between staff; 46 per cent say dogs in the office create a friendlier atmosphere



40% of companies with the Pets at Work toolkit in place suggest that work-life balance is the top reason for introducing it. The scheme helps staff with dog-care issues so that overtime is less of an issue. It also frees up pay that might have gone towards daily pet care or dog walkers

2017 marked three years since Nestlé began allowing its 1,000-plus employees to bring their dogs into its City Place headquarters in Gatwick.

So far, over 100 staff have chosen to go through the company's three-step "pawthorisation" process. This involves a detailed questionnaire about their dog's habits, and behavioural evaluations, both at home and in the office, by an independent dog specialist. The dog then joins Nestlé's Pets at Work (PAW) programme and gets its own "passpaw".

Employees can choose to bring their dogs (aka canine colleagues) to meetings



in designated dog-friendly rooms or let them off the lead in Central Bark (a dedicated dog garden), but most of the time the dogs can be found chilling out, leads fastened to their owners' desks.

"There is a perception that having dogs in the office could be disruptive, but it isn't. If the legal dogs aren't in, you can forget that we have dogs in the office at all until you see one walk past or hear the odd bark," says Sarah McPoland, Chartered Trade Mark Attorney at Nestlé UK and Ireland. The average number of canine colleagues present at Nestlé's City Place offices averages at just eight per day, despite 120 dogs being enrolled overall.

Sarah continues: “The legal dogs are fairly quiet when they are in, and as a dog lover with no dog of my own, I really like having them around. I can be guilty of not leaving my desk at lunchtime, so having a dog to take to our dog park can also encourage me to go outside for a break during the working day.”

Siobhan Ferguson, Legal Counsel at Nestlé and owner of miniature Chihuahua Lulu, is reaping the benefits of joining a dog-friendly company: “The PAW scheme was a key selling point in my decision to join the Nestlé legal team. Bringing Lulu into work has made me happier and healthier. She spends most of her day asleep under my desk, only occasionally stirring for a treat and a belly rub.”

Not only does Lulu benefit from her time in the office, but Siobhan has seen the positive wellbeing impact of Lulu’s presence: “Where I might previously have indulged in coffee and cake to reduce my stress levels, I now take Lulu for a quick walk and return to my desk refreshed and focused. Other team members (and their four-legged friends) often join us in the dog park, which is great for morale. In fact, Lulu has helped me to network and build relationships across Nestlé – the legal team has never been so popular! At Nestlé headquarters, our offices are completely open plan; if we can make it work, then I think any company can.”

However, despite the many benefits of having a pet-friendly workplace, some careful considerations need to be made before rolling out a policy to introduce four-legged friends into a workplace.

As the person who looks after the PAW initiative, I would like to strongly encourage any business which wants to implement a pet-friendly policy to undertake a proper consultation process with all employees. Everyone’s views need to be taken into consideration, particularly those who suffer from pet-related allergies or asthma. At Nestlé Purina, we take these considerations seriously and have measures in place to ensure that both dog owners and non-owners feel comfortable and safe at work.

Appetite for the scheme continues to grow, with one new dog passport application submitted per week, showing just how successful a pets-at-work policy can be if proper precautions and processes are put in place. Employers are catching up quickly, and new research has revealed that, across the UK, 42 per cent of those aged 18–34 would like or enjoy a dog-friendly workplace.¹

Nestlé Purina is so convinced by the benefits that it has launched a toolkit to help other businesses looking to adopt pet-friendly policies at work.

I have found that, without doubt, the perceived complexity of implementing a pets-at-work policy can be a barrier for organisations. From our own experience, we know that pet-friendly workplaces lead



Siobhan Ferguson sees several health benefits in the PAW scheme

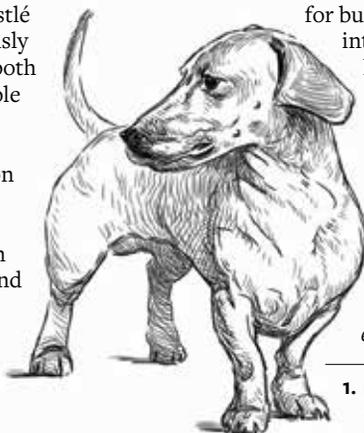


Where I might previously have indulged in coffee and cake to reduce my stress levels, I now take Lulu for a quick walk and return to my desk refreshed and focused

to a range of positive benefits, and we want to show others that many of the perceived barriers are actually fairly easy to overcome and don’t entail a huge time or cost investment on the part of the business.

The toolkit, launched as part of the Pets at Work (PaW) Alliance, offers a six-step approach for businesses of any size to successfully introduce their own scheme. It contains health-and-safety advice, responsible pet-ownership guidelines, advice on workspace requirements and ready-to-use resources. Nestlé Purina aims to help 200 organisations open their doors to pets by 2020. ■

For more information on the PaW Alliance and to access the toolkit, visit purina.co.uk/pins/pets-at-work or email pawallianceuk@purina.nestle.com



1. Nestlé Purina research conducted by Opinium in June 2017 across 1,122 UK workers (over 18) and 252 UK employers (decision makers, senior management and above).

LAURA VALLANCE

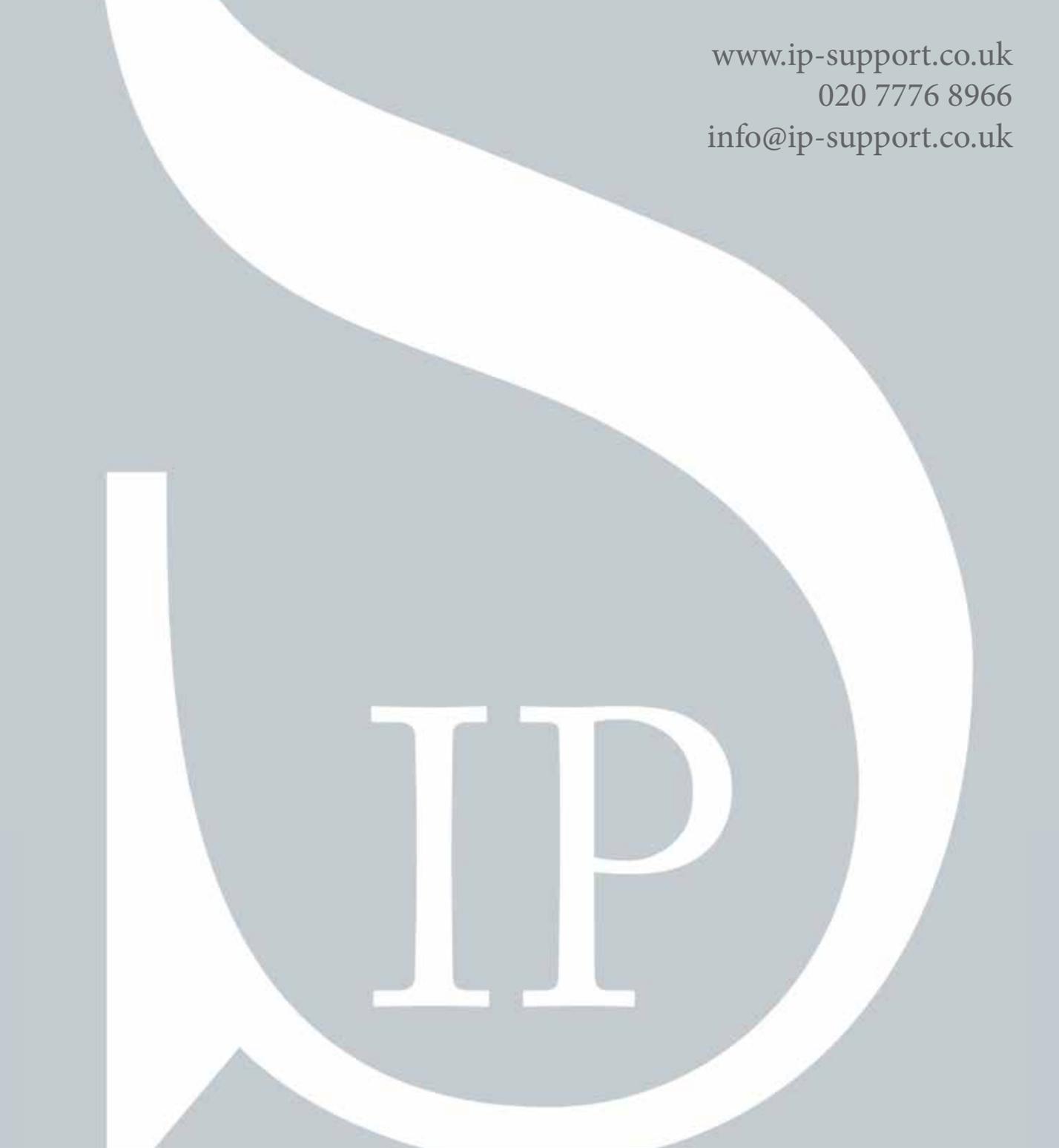
is Corporate Affairs Manager at Nestlé Purina

With thanks to **Sarah McPoland**, Chartered Trade Mark Attorney at Nestlé UK and Ireland.

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IP

A selection of our current vacancies:

PQ or Qualified Trade Mark Attorneys - London

Senior Trade Mark Administrator - London

Trade Mark Formalities Clerk - Yorkshire

Imagine that a new client asks you to register its mark. You run a search and find a problem – an identical mark for identical products put on the EU register by an Italian company a few months earlier. You report the bad news. Your client tells you it has been using its mark for several years, and well before the priority of the registration you have just located. “What can be done?” the client asks.

You first consider an invalidation based on passing off. You look at the Italian owner of the registration in more detail and find that it has also been in business, at least in Italy, for decades, and its website has an English-language version. On the other hand, its list of distributors does not include any in the UK, and it is not clear that its products have ever been sold in the UK. If they have been, sales were sporadic and in small quantities. What do you advise?

The question of who has the better right in this scenario is familiar. Yet the law surrounding the issue is strangely obscure. I have been involved in several disputed cases recently, including *Casablanca*¹, where the point has been in play, and I continue to believe that the correct approach is in need of clarification.

LEADING OPINION

The leading case in the higher courts, though one at a relatively high level of generality, is *Maier v Asos*.² In *Maier*, the issue was again the interplay between the parties’ registered and unregistered rights, and, in particular, which party had the better UK claim to its respective mark. Kitchin LJ gave the principal judgment in the Court of Appeal. At paragraph 164, he considered the claim that *Maier*’s EU registration was invalid in the face of *Asos*’s previously established goodwill and consequent passing off right. He then observed at 165:

“There is a further complication, however.

Under the English law of passing off, the relevant date for determining whether the claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of.”



The judge went on to state how the matter was to be resolved, as follows:

“The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the Community trade mark would have amounted to passing off. But if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

There was clear evidence that *Maier* had continuously been selling *ASSOS* branded clothing in the UK for at least two years prior to the date on which *Asos* commenced use of its mark. Therefore, *Asos* would not have had any right in passing off to prevent use of *ASSOS* by *Maier* when the latter’s use began. The Court therefore refused *Asos*’s claim and upheld *Maier*’s registration.

CONTESTED TERRITORY

Ian Bartlett voices his concerns about confusion surrounding antecedent rights



“

The right approach where the defence of an antecedent right is raised is to keep in mind the underlying equitable principle that the senior user is entitled to continue with conduct which, in its inception, was innocent

In view of its facts, *Maier v Asos* was a relatively straightforward application of the principle that *Kitchin LJ* expounded. Yet the question of whether or not the antecedent “use” the defendant puts forward is sufficient to create a relevant antecedent “right” is not always so clear.

For example, in *Multisys*³, *Daniel Alexander QC*, sitting as the Appointed Person, was required to determine the Applicant’s defence to an opposition based on passing off – that its use of *MULTISYS* was antecedent to the establishment of the Opponent’s goodwill under the mark and it therefore had a defence of an antecedent right. In a thoroughgoing review of the authorities, *Alexander* cast the issue in terms of the date at which the existence or otherwise of the opponent’s goodwill is to be assessed. In the normal case, this would be the filing date (or priority date if any) of the opposed application. But what if, as in *Multisys*, the Applicant claimed to have used the sign in question at an earlier date?

Alexander took his lead from the decision of *Walker J* in *Barnsley Brewery*⁴ and concluded the relevant date for assessing the claimant/opponent’s goodwill would be the earliest date on which the applicant’s use or intended use of the mark could have been restrained by an action in passing off.

In *Barnsley Brewery*, *Walker J* (as he then was) considered competing claims to the mark *BARNESLEY BITTER* for beer. As in many passing off cases, the factual background was complex, unusual and imperfectly evidenced. In summary, however, as part of his deliberations, the judge

considered whether the relevant date for determining the Claimant’s alleged goodwill under the *BARNESLEY* mark was: (i) when the Defendant’s solicitors formally put the Claimant on notice of its intention, at some time in the future, to launch under the *BARNESLEY BITTER* mark; or (ii) some months later when that intention crystallised with actual use. He decided, on the facts, that a *quia timet* action by the Claimant to prevent a threat of passing off at the earlier of these dates would probably have been premature, in that the Defendant’s intentions as expressed in their solicitor’s letter were too vague. On the other hand, as *Alexander* noted in *Multisys* at paragraph 44:

“Implicit in that approach was that in some passing off cases it may not even be necessary for there to be actual use of a mark to fix the date for assessment of goodwill: a sufficiently tangible threat to use the mark may suffice.”

Taking this observation at face value and translating it into a registration case, it would be open to an applicant to claim that it had an antecedent right, not on the basis of having commenced developing any UK goodwill in the mark, but on the basis that it had tangible plans to do so.

IMMUNITY ISSUE

IPO tribunals routinely refer to the decision in *Multisys* when determining the issue of antecedent rights. It is respectfully submitted, however, that if *Multisys* advances the principle noted above, the net it casts is too wide and can lead to unjust results. If the principle were correct, tangible plans by an applicant, formed at some point in the past, to launch a UK business under the mark in question (plans that might be unknown to the opponent) could immunise that applicant for an indefinite period in the future against a passing off claim or a passing off based opposition.

It is often stated in UK passing off cases that mere preparations to trade do not give rise to a

protectable goodwill (even where there has been substantial and expensive pre-launch advertising⁵). If preparations to trade in the UK are insufficient to provide a claimant/opponent with a sword, it would seem surprising if such preparations, let alone a mere intention to trade, might provide a defendant/applicant with an effective shield. It is worth noting here that the decision of Walker J in *Barnsley Brewery* was on an *inter partes* motion by the Claimant to continue, pending trial, an interlocutory injunction previously granted *ex parte*. The judge declined the application, allowing the parties “free competition” until the matter could be fully evidenced and tried. He made no final determination on the question of the date of assessment (and had he done so, it appears his findings would have been *obiter dicta*).

Plainly, a claimant in a *quia timet* application for an order preventing a threatened act of passing off would have to demonstrate to the court that, at that point in time, it had the requisite goodwill and reputation in the sign in question. It does not appear to follow, however, that the date on which such a threat by a defendant might first have arisen should, in passing off cases generally, fix the date on which the claimant’s goodwill must be determined.

Professor Christopher Wadlow appears to agree with this proposition. On defences, he writes that: “No defence of antecedent user can arise from mere preparations for trading (even if costly) which are not such as to generate goodwill.”⁶ Interestingly, Wadlow cites *Barnsley Brewery* as authority for this proposition, suggesting a different reading of Walker J’s decision in that case than the one seemingly taken in *Multisys*.

UNDERLYING PRINCIPLE

It is submitted that the right approach where the defence of an antecedent right is raised is to keep in mind the underlying equitable principle that the senior user is entitled to continue with conduct which, in its inception, was innocent (as in *Stacey v 2020 Communications plc*⁷). However, that is too compressed a statement immediately to solve all but the most straightforward cases, for it begs numerous questions, including what characteristics the “user” must have to render it “senior” and the related question of what constitutes the “inception” for the purposes of the defendant’s use.

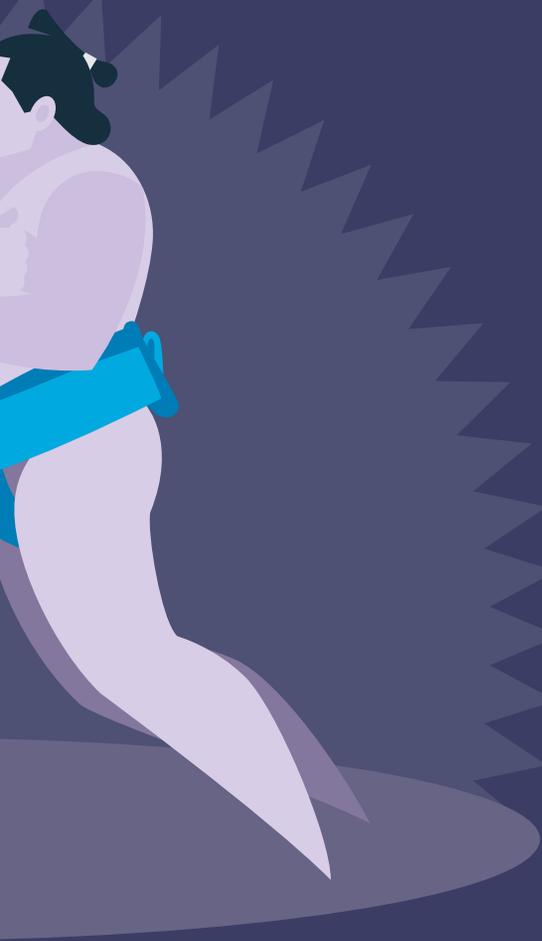
For example, a defendant/applicant might claim that its historical importation into the UK of a single item bearing the disputed sign many years previously was sufficient to provide it with the defence of an antecedent right in a passing off action (or in a passing off based opposition), brought against it years later. Plainly, such an importation could have been restrained in an action for passing off (had such a relevant passing off right existed) and so might have satisfied the *Multisys* test as being actionable.



Under a strict application of *Multisys*, that long-ago point in time could be the date at which the tribunal would be obliged to assess the claimant’s goodwill. But would it be equitable to accept a defence of antecedent rights in such circumstances? Taken to its extreme, a single importation of a single item could protect a defendant for all time from facing a passing off claim on the basis of a later-acquired goodwill. Translating this into a registration case, a single act of importation – perhaps many years ago – might provide eternal immunity to an applicant against a passing off right that came into existence between that single historic act of importation and the date of the filing of the application in question.

Similar considerations could apply if the defendant/applicant were able to show historical but only sporadic importations into the UK, or perhaps frequent but small-scale importations.

It may have been in recognition of these specific concerns that Kitchin LJ, in *Maier*, expressed the correct approach as follows (emphasis added): “But if the Community trade mark has in fact been used from an earlier date than that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”



“

Taken to its extreme, a single act of importation – perhaps many years ago – might provide eternal immunity to an applicant against a passing off right that came into existence between that act and the date of filing

He also referred earlier in this paragraph to the “date of the commencement of the conduct complained of”.

The terms “commencement”, “used from” and “began” in that passage suggest that some degree of ongoing activity is required between the date of the “inception” of the defendant/applicant’s alleged antecedent use, and the date of the issue of the claim form (or to put it in terms of registration, the filing or priority date of the opposed trade mark application). This would avoid the “eternal immunity” point made above, and perhaps also deal with cases of mere sporadic use.

What, then, of a claim to an antecedent right where the defendant’s UK use might be said to be in some sense continuous, yet on a very small scale? Relentless Records⁸ is often cited as a passing off case where any goodwill that, at the date of the claim, had been generated by the claimant was so slight and ephemeral as to have been “very minimal”. It was not so much that the activity in Relentless Records had not been continuous, but rather, as Jacob J (as he then was) put it at paragraph 43: “The whole scale of the thing was too small for any protectable goodwill or any damage.”⁹

Of course, this does not necessarily answer the question of whether, in the face of the defendant’s adoption of the mark in question, the unsuccessful

claimant might find itself on the wrong end of a counterclaim or future action in passing off from the erstwhile defendant. As already mentioned, in general, a senior user is entitled to continue with conduct that, in its inception, was innocent.

That was the position in Stacey, referenced above. The Claimant’s small and local reputation was considered protectable despite having been swamped by a newcomer such that, by the time of the claim, the sign in question had generally come to be recognised by the public as meaning the Defendant rather than the Claimant. It is submitted, however, that even use that might be considered “continuous” could nevertheless be so minimal as to avoid any antecedent right arising. In such a case, the date of the commencement of that minimal use would not be the date on which the claimant’s rights should be assessed. Not until the defendant’s use became sufficiently substantial to begin attracting a more than minimal goodwill might a potential defence of antecedent right arise. If this were only to occur after the claimant had established its own (more than minimal) goodwill, it would no longer, of course, be “antecedent”, and the corresponding defence to a passing off claim (or an opposition) would not then arise.

In conclusion, once they have begun to be unpacked, the issues surrounding the defence of “antecedent right” will often raise questions that may not be easy to assess against the factual background of the case in question.

To return to the fictional scenario with which this article opened, much more would need to be known about the Italian company and the history and extent of its activities in the UK. Even then, until further clarification by the case law is provided on these issues, how a court or a registration tribunal might determine the client’s position may be impossible to predict. ■

1. *Marriage Frères v TWG Tea Company Pte Ltd (WEEKEND IN CASABLANCA)* O/349/16.
2. *Roger Maier and Assos of Switzerland SA v ASOS plc and ASOS.com Ltd* [2015] EWCA Civ 220.
3. *Advanced Perimeter Systems Ltd v Keycorp Ltd (MULTISYS)* O/410/11.
4. *Barnsley Brewery Company Limited v RBNB* [1997] FSR 462.
5. For discussion of this issue, see Lord Neuberger in *Starbucks v BSKyB* [2015] FSR 29 at 66.
6. Professor Christopher Wadlow, *The Law of Passing-Off: Unfair Competition by Misrepresentation*, 5th ed, at 9.88.
7. *Stacey v 2020 Communications plc* [1991] FSR 49.
8. *Hart v Relentless Records Ltd and others* [2002] EWHC 1984 (Ch).
9. See also Laddie J in *Kevin Floyd Sutherland and others v V2 Music and others* [2002] EWHC 14 (Ch) at 22: “The law of passing-off protects the goodwill of a small business as much as the large, but it will not intervene to protect the goodwill which any reasonable person would consider trivial.”



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NUGGETS FROM NOMINET

Chris Hoole selects the most instructive cases from the domain-name resolution system in 2017

Last year was another busy one for Nominet. In this article, I pick out a couple of interesting nuggets that I think help to remind us of Nominet’s core functions, and key differences with infringement proceedings.

Let’s start with a quick recap of an applicable scenario. When, as a rights holder, you find out that a third party has registered a .co.uk domain name that includes your brand or a similar name, you’re faced with quite a few choices. You could do one or more of the following: make a friendly approach; put the other party on notice of your rights; send a cease and desist; start injunctive proceedings in the courts; or initiate a domain dispute.

The latter, if successful, could result in the transfer of the “dodgy” domain. However, the rules are different from infringement proceedings. The question here is not simply: does the mark infringe? There is another set of rules to follow, which, for .co.uk domains, is laid down in Nominet’s Dispute Resolution Service Policy.

Under paragraph 2(1) of that policy, the complainant must prove that it has rights in respect of a mark or name that is identical or similar to the domain, and that the domain in the hands of the respondent is, or has become, an “abusive registration”. Paragraph 5 of the policy sets out a number of possible examples that could be considered abusive, including domain squatting, unfairly disrupting businesses or a pattern of abusive registrations. At paragraph 8, however, is a list of non-abusive factors, such as making demonstrable preparations to use the domain name, generic or descriptive use, or legitimate non-commercial fair use.

A POOR FIT?

Jaguar Land Rover Ltd and TalkTalk Business Group Ltd (as Registrant on behalf of Lynda Beaumont t/a Essex Jaguar Spares)¹ was an Appeal decision concerning the domain name essexjaguarspares.co.uk. The Expert’s decision was issued on 2nd June 2017, and found in



This decision illustrates that, in certain cases, while more costly and less streamlined, court proceedings may be the best course of action

favour of the Respondent, despite her having had a previous decision concerning “jaguar” domains made against her earlier in 2017. The Appeal proceeded as a full redetermination on the merits.

Jaguar, the well-known car manufacturer, has a portfolio of registered rights in the mark JAGUAR dating back to 1943. The domain in question was registered on 17th October 2012 by TalkTalk on behalf of Lynda Beaumont, who runs a business in Essex selling spare Jaguar parts and offering related services.

The question posed by the Panel was: is the domain name, which is linked to a business that provides genuine goods and related services, abusive? In reaching its findings, the Panel referred to the case of wwe-shop.co.uk, which laid down some guidance for this type of case, which is relatively common to Nominet. Following wwe-shop.co.uk, taking into consideration all the facts, a domain may be found abusive if use of the trade mark was in an unadorned form, or if it is used in conjunction with terms that could be associated with the owner. However, it is less likely to be abusive if combined with a term or terms with the result that a domain name would not readily be considered to be that of the owner.

Terms such as “approved”, “dealer” or “official” were, according to the Panel, likely to suggest an economic link, “specialist” and “unofficial” less so. However, the word “spares” was borderline and, if used on its own (as in jaguarspares.co.uk), could well be abusive. However, when used with a “further modifying geographic term”, the Panel, absent any evidence that authorised dealers commonly used the formula [geographical area]jaguar[spares].co.uk or of any confusion, was of the view that the domain “with two modifying terms” made the domain descriptive, but not misleading. Overall, it did not find the domain abusive, upholding the Expert’s original decision.

In reaching its conclusion, the Panel stressed the difference between the Dispute Resolution Service (DRS) system and court proceedings, stating: “... the DRS system is not intended to provide an alternative remedy for trade mark infringement cases. It is intended to provide a convenient and low cost system for dealing with the abusive registration of domain names. Given that a losing registrant will be deprived without compensation of the domain name in issue it is intended to apply only to clear cut cases.”

This decision illustrates that, in certain cases, while more costly and less streamlined, court proceedings may be the

best course of action, especially where the transfer of the domain is less important to the complainant.

SKIMPY ARGUMENTS

Oralect Licensing Ltd and Tracey Bell Clinic² concerned the domain name fastbraceisleofman.co.uk. At first instance, the Expert concluded that the Complainant had rights in the name FASTBRACES, which was similar to

the domain name, but failed to show that the Respondent’s registration was abusive.

The Panel ultimately upheld the decision of the Expert, but, in reaching its decision, made some very useful points regarding the level of detail required in domain dispute proceedings. The Panel acknowledged that, ultimately, the DRS system is intended to be a relatively informal, quick and economic means of resolving disputes. However, parties must still follow the rules and guidelines promulgated by Nominet, all of which are clearly, and helpfully, explained on its website.

In this case, the Panel was critical of the Complainant’s approach, finding that it “seems to have paid little attention to the rules or the guidelines”. Interestingly, if a complaint is filed using Nominet’s online system, and Nominet detects that the complaint is short or unaccompanied by evidence, it will, before accepting the complaint, generate a warning and invite a prospective complainant to reconsider its evidence. In the case at issue, despite receiving this very warning, the Complainant proceeded, relying on limited background, which it failed to support in reply to the Respondent’s arguments. Only on appeal did the Complainant seek to introduce new evidence, quickly rebutted by the Panel, which reiterated the general rule that no new evidence can be filed on appeal, unless it is in the interests of justice.

Given the brevity of the facts, the Panel was unable to find in the Complainant’s favour, noting that it may have reached a different decision had the Complainant fully explained its case. The simple takeaway from this decision: don’t ignore the obvious warning. ■



1. Case D00018271.
2. Case D00017552.



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Taking stock

UK presence was central to this international enquiry. Report by Andrew Hawley

THE UK HIGH COURT partially overturned an appeal from IPO proceedings concerning the decision to revoke two international trade mark registrations relating to ABANKA, owned by Abanka DD, and an unsuccessful opposition based on those marks against an application for registration of ABANCA in stylised form, filed by Abanca Corporación Bancaria SA.

As the ABANKA marks had been registered for a wide range of financial services and Abanca sought to register ABANCA as a trade mark for financial services, the proceedings were brought based on the likelihood of confusion.

Given the case concerned use within the UK banking sector, in making her decision, the Hearing Officer (HO) considered that Abanka was a Slovenian bank without a UK banking licence and had only very minor activities in the UK in the context of the UK banking sector. Further, any UK activity primarily centred on serving the UK's expatriate Slovenian community. There was no evidence that it was possible to open an account with Abanka from the

UK, although it was possible to carry out online banking once opened.

INTERNATIONAL NATURE

On appeal, the main issue centred on the nature of international transactions of banking customers.

On the one hand, while customers can transact internationally, this does not mean the bank has a share in the international banking market. In other words, a customer using a debit or credit card abroad, or a cheque for payment in a foreign country, does not mean that the “home” bank necessarily has a presence on the banking market in a jurisdiction in which that card is used.

This was weighed against a different perspective. Insofar as undertakings accept a relevant payment instrument in the UK on the strength of its origin with a foreign financial undertaking, ultimately there appeared to be no reason why that should not be treated as constituting use of the trade mark in the jurisdiction where the instrument is presented.

Given there was no relevant case law dealing with this issue expressly, this case provided interesting commentary on issues regarding the use of a mark in different jurisdictions.

ANALYSING USE

A number of services were relied on to prove use in the UK, including advanced payment guarantees, cheques, card holders, website use and a flotation on the London Stock Exchange.

While many of these services would ultimately be completed in the UK, the Court distinguished between use of the mark ABANKA to an undertaking in the UK and use of it by Abanka in the UK. This meant that providing services using the ABANKA mark, such as advance payment guarantees and cheques, to customers in Slovenia did not mean that the marks were commercially exploited in the UK.

As for the website, having an English-language website and the website being accessible from the UK were not considered sufficient to prove use with UK customers. These factors, in conjunction with the fact that Abanka is not authorised by the financial regulator to provide banking services in the UK, meant that Abanka's services were not necessarily UK-targeted.

Credit and debit cards had been supplied to Slovenian customers resident in the UK. However, there was a lack of certainty around how many of the cards were provided on the basis of Abanka being a Slovenian banking service. Although the cards may have been delivered to a UK address, and even used in the UK, this did not amount to a presence on the UK banking market.

Abanka had been nominated for an award from a UK magazine, and featured in a press release. While the award was given in London and publicised in an English-language banking journal with a significant UK readership, the Court considered that the award was for Abanka successfully recapitalising itself in Slovenia. As such, the Court did not consider that Abanka's passive receipt of the award proved use of the mark in the UK.

GENUINE USE

The above factors having met no success, Abanka's application for admission to the London Stock Exchange met a more positive reception. The HO initially based her decision on the fact that the purpose of issuing the bonds was to raise funds for Abanka itself. However, the Court considered bonds as



This decision confirms that a mark is only treated as being used in the UK where the proprietor has actively pushed its business and mark into the UK

objects of commerce that are both advertised and sold in a particular location, and therefore equivalent to goods or services.

Given Abanka's reputation was important in deciding whether to purchase its bonds from the London Stock Exchange, this factor, alongside the sales and marketing, could establish use, in spite of £1m in bonds being comparatively small in the context of listings. The Court therefore overturned the HO's decision on this point.

ACTIVE SALES

This case considered that an international financial services company could establish use in the UK where payment cards are actively provided in the UK (even if incidental to holding a bank account in a foreign country) where it has a significant number of UK customers. Use of the financial services company's name in relation to banking services cannot be constituted, however, where there is a mere presence of a small number of account holders bearing cards with the mark.

This decision confirms that a mark is only treated as being used in the UK where the proprietor has actively pushed its business and mark into the UK. In this instance, the ABANKA mark was "pulled" into the UK by its UK-based customers abroad, and this was not sufficient to amount to use.

This key conclusion decided by the UK High Court was also reached in parallel decisions in France, Spain and Switzerland. To avoid revocation, trade mark owners must therefore ensure active use of their marks is being made in all relevant territories.

KEY POINTS

- ▶ Abanka did not directly promote its business in the UK. Use was "pulled" from existing Slovenian customers located in the UK
- ▶ Given there was no relevant case law, this case provided interesting commentary on issues regarding the use of a mark in different jurisdictions
- ▶ A mark is only treated as being used in the UK where the proprietor has actively pushed its business and mark into the UK
- ▶ Trade mark owners must ensure active use of their marks is being made in all relevant territories



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That's owl for Metropole

Steven Jennings discusses a recent case of likely-hoot of confusion

THESE PROCEEDINGS concerned a dispute between financial asset management companies Metropole Gestion SA and M&G Ltd. Metropole opposed the applications of three M&G UK trade marks in classes 9, 36 and 42, all containing a green owl device (the M&G Owl, shown below). Metropole's opposition was based on its prior use and registration in the EU of its black-and-white owl device (the Metropole Owl, also shown below) in classes 35 and 36. Specifically, Metropole claimed:

1. that the M&G Owl was too similar to its earlier Metropole Owl and covered identical or similar goods/services (s5(2)(b) of the Trade Marks Act 1994 (TMA));
2. its earlier Metropole Owl had a reputation in the EU of which the registration of the M&G Owl would take unfair advantage (s5(3) TMA); and
3. use of the M&G Owl would amount to a misrepresentation to the public, causing confusion and damaging the goodwill (in the UK) built up in the Metropole Owl (s5(4)(a) TMA).

Metropole also brought an invalidation claim against M&G's existing registration containing the green owl.

SIMILARITY

In assessing the marks, the Hearing Officer (HO) dismissed the similarity arguments submitted by Metropole, instead focusing on the sophistication of the average consumer. In respect of financial goods/services, the average consumer is likely to pay an above average level of attention, and so should be able to differentiate between the respective businesses. The HO commented that M&G's cartoon-like owl made a strikingly different overall visual impression to the life-like silhouette of the Metropole Owl. There was therefore only a low degree of visual similarity between the marks.

Further, though owls are often associated with wisdom and knowledge – important attributes in the financial services industry – the HO stated that this is only an allusive reference to the quality of the services. The Metropole Owl thus had a normal level of inherent distinctiveness. However, the evidence submitted did not support a finding that the Metropole Owl benefited from any enhanced distinctiveness through use. In reconciling all of the above, the HO was not persuaded that there existed a likelihood of confusion between the marks and Metropole's opposition, and invalidation based on s5(2)(b) failed.

PASSING OFF

Given the finding that the M&G Owl was not confusingly similar to the Metropole Owl, the HO concluded that Metropole was also unable to show that use of the green owl device would amount to a misrepresentation to the public. Accordingly, Metropole's opposition and invalidation based on s5(4)(a) also failed.

REPUTATION IN THE EU

Despite finding that Metropole had a reputation in the wider EU, the HO held that the relevant UK public would not make any link between the parties' marks. Accordingly, Metropole's opposition and invalidation grounds in relation to reputation and unfair advantage per s5(3) failed.

Ultimately, in industries which command a moderate to high degree of consumer attention, such as financial services in the current case, trade mark owners can expect the IPO to apply a higher threshold when assessing similarity of marks, even where goods and services are identical.

KEY POINT

- ▶ In industries that demand a moderate to high degree of consumer attention, trade mark owners can expect the IPO to apply a higher threshold when assessing similarity of marks, even where goods/services are identical

- ▶ The M&G Owl



- ▶ The Metropole Owl



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Verve la difference

Rachel Garrod spells out how use of an altered mark meant trouble

THESE WERE consolidated proceedings involving the following:

- i) Capallini LLP's opposition (No 406683) against the registration of trade mark No 3149189 by Arlec Australia Pty Ltd; and
- ii) Arlec Australia Pty Ltd's application (No 501210) to revoke on the grounds of non-use registration No 2526097, owned by Capallini LLP.

In February 2016, Arlec Australia Pty Ltd filed a UK application for VERVE DESIGN (figurative mark). Capallini LLP filed an opposition under ss5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). The first two grounds were based on Capallini's earlier UK trade mark registration No 2526097 (shown right), and the third ground on its use of the earlier mark.

In Arlec's defence, it put Capallini to proof of use of its earlier registration. Arlec also filed an application to revoke Capallini's registration on the grounds of non-use, relying upon s46(1)(a) of the Act.

USE WITH CONSENT

Capallini filed evidence of use that was "under agreement" with Kessler UK Ltd. A witness statement confirmed that Kessler and Capallini "are a single entity in these proceedings and that [Kessler] have unfettered use of [the trade mark]".

On making its decision, the IPO first addressed the issue regarding the relationship between Capallini and Kessler. While the IPO acknowledged that no formal evidence of any licence agreement had been filed, the Act simply required consent, and such consent may be implied. The IPO therefore accepted that Capallini could rely on Kessler's use of the mark.

USE OF THE MARK

Section 46(1)(2) permits the use of a mark to be relied upon in a different form, so long as that form does not alter the distinctive character from the form in

which it is registered. Arlec argued that none of the evidence filed showed use of the mark as registered.

The registered mark and the mark as used are shown on this page. Capallini argued that the mark as used did not alter the distinctive character of the mark as registered, and could therefore be relied upon.

The IPO found that although the word VERVE was the dominant element, the stylised letter "e" made a "reasonable contribution" towards its distinctive character. Its omission therefore created a meaningful alteration to the distinctive character of the mark. Consequently, there was found to be no genuine use of the registered mark, and Capallini's registration was revoked. Capallini was therefore unable to rely upon this registration, and the grounds under ss5(2)(b) and 5(3) of the opposition failed.

PASSING OFF

For a successful claim under s5(4)(a), the IPO indicated that Capallini must be identified as the owner of the goodwill in the UK. While it was accepted that Kessler's use in the UK was with consent, it did not follow that all forms of consensual use would result in any goodwill generated being owned by the consenting party. As such, it could not be assumed that Capallini owned any goodwill. Further, given that the earlier mark was held to have not been used, its claim under s5(4)(a) also failed.

This outcome provides a useful reminder that the mark that is used should be the mark as registered. If there is even the slightest inkling that the distinctiveness of the registered mark has been altered, it is safer to file a new application for the mark that is actually in use.

KEY POINTS

- ▶ The trade mark should be used as registered. If the mark in use is different to the mark as registered, it is safer to file a new application for the mark actually in use
- ▶ Ensure that there is evidence to support which parties are authorised to use the mark, such as a licence agreement, and that it is clear who owns the goodwill in it

- ▶ Capallini's earlier registration

- ▶ The mark as used



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Scooter coup

*BrandConcern can
again declare victory,
confirms Kate Swaine*



IN THE LATEST instalment of Brandconcern BV's campaign against Scooters India Ltd (SIL) to have the LAMBRETТА mark revoked in various jurisdictions, it achieved another victory, with the IPO revoking the marks for non-use.

This story began in 2007, when Brandconcern filed several EU trade mark applications for LAMBRETТА, causing tension between the parties that culminated in Brandconcern's successful revocation of the Italian national trade mark.

Brandconcern made three separate revocation applications against two different UK LAMBRETТА marks, meaning there were a total of six revocation applications being considered by the IPO. All were for revocation on the basis of non-use for an uninterrupted period of five years without proper justification (s46(1)(b) Trade Marks Act 1994). The first four applications related to two different periods of non-use and were consolidated, following which Brandconcern issued the final two applications relating to another, more recent period of non-use.

NO DEFENCE

SIL did not defend the final applications and accepted that the marks would be revoked for non-use, but it did not accept that the non-use period should be that specified in the earlier applications, and so the effective revocation date had still to be determined.

Confusingly, by the time of the hearing, it was not disputed that the marks had been used in the UK in the relevant five-year period in relation to goods that were the subject of the registrations. However, the use was by three UK companies that were sub-licensees of a company that, for a period, had a licence from SIL to use LAMBRETТА. The question, therefore, was whether SIL had consented to this use. Were the answer "no", the marks would be

revoked from the earlier of the dates specified by Brandconcern.

The IPO found that there was no consent, and therefore no use had been shown, for the following reasons:

1. In the early part of the relevant five-year period, SIL's licence had been terminated, and therefore the sub-licences also automatically terminated.
2. In relation to the period before the licensing arrangements ended, there was no evidence that SIL had policed or defended the brand it was licensing. Indeed, the licensor had to defend previous revocation proceedings itself.
3. A separate licence was entered into by two third-party companies relating to another UK LAMBRETТА mark, which was then used in relation to the relevant goods, but royalties were exchanged between these companies rather than with SIL, and the latter took no action to prevent this taking place.

SIL therefore failed to show genuine use of the relevant marks during the specified five-year period, either on its own account or with its consent, so the marks were revoked from the earlier date requested by Brandconcern.

The IPO's decision is fairly logical, but it does reinforce that, for a trade mark owner to show it has consented to a third party using its brand, a positive action of some sort is needed. Merely not objecting to use of a mark is insufficient.

KEY POINTS

- For a trade mark owner to show it has consented to a third party using its brand, a positive action of some sort is needed. Merely not objecting to use of a mark is insufficient
- Monitor the actual use of competing trade marks, because attacking for non-use remains a useful tool for revocation purposes
- If a brand owner is to get the most out of its trade mark portfolio, active management is required



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Tea for trade

Professional customers were a key consideration, as Oliver Tidman explains

THIS CASE CONCERNED a declaration of invalidity brought by Chris Howard against UK trade mark registration No 3057981 MONSOON TEA in the name of Bradley Jean-Pierre (the Applicant), covering “teas” in class 30. Mr Howard’s invalidity proceedings were brought under s47 of the Trade Marks Act 1994 on the grounds of ss3(1)(b), (c) and (d), and 5(4)(a).

EARLIER RIGHTS

Since 9th October 2009, Mr Howard had used the sign MONSOON ESTATES in relation to various goods (including tea and coffee) and services. Mr Howard argued that the Applicant’s mark should be prevented under s5(4)(a), as it would constitute a misrepresentation to the public that the goods sold under that mark were connected to him.

The Hearing Officer (HO) considered that, by the relevant date, the level of turnover of Mr Howard’s business was fairly low and, despite the awards it had won, the degree to which it was known was also likely to be low. Although some sales of tea had been made, the HO took the view that Mr Howard’s business was associated primarily with coffee, particularly as products were being sold to the public in branded MONSOON ESTATES COFFEE CO packaging. Therefore, the extent of the goodwill associated with tea was considered trivial.

In an earlier decision between the parties, a likelihood of confusion was found between MONSOON TEA and MONSOON ESTATES insofar as tea and loose tea were concerned. However, for a claim of passing off to succeed, it must be established that substantial numbers of the public were likely to be deceived. The HO was not persuaded that a substantial number would assume that MONSOON TEA was connected to Mr Howard’s business, and this ground therefore failed.

DESCRIPTIVENESS

Considering the ground under s3(1)(c), the HO took the view that the UK public knew little



about various tea flushes, particularly the monsoon flush variety (Darjeeling and Nepali).

However, as tea is not a product normally grown in the UK and is imported, the position of the UK tea trade in relation to the average consumer also needed consideration. The sign MONSOON TEA would clearly be perceived as a description that the tea had been produced in the monsoon flush season or had a monsoon geographical origin. As the HO viewed the mark to be descriptive, he did not consider it necessary to address the other s3(1) grounds in any detail.

FINAL WORD

This case reinforces the position that, in order to assess descriptiveness, a mark must be assessed by reference to the goods or services for which it is registered and from the point of view of the average consumer, which includes trade consumers. The HO was persuaded that those in the tea industry would read the mark to mean that the tea was harvested during the monsoon season or came from a geographic region known for its monsoons, such as Darjeeling, or that the quality of the goods was influenced by monsoon weather.

KEY POINTS

- ▶ MONSOON TEA was deemed to be descriptive of the characteristics of the goods in question
- ▶ The list of specific characteristics contained in the descriptiveness objection is not exhaustive
- ▶ It is necessary to take into account the view of the average consumer, whether in trade or otherwise



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Hung out to dry

It was a less than super result for Superdry, reports Rupert Bent

DKH RETAIL (the Opponent), owner of the world-famous Superdry clothing brand, has failed in its recent attempt to oppose a UK trade mark application for SPRAY DRY in respect of a range of class 25 goods. Relying on its extensive catalogue of previously registered trade marks, the Opponent pursued its opposition under ss5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994.

ANALYSIS

The analysis focused on the marks in question, as both parties conceded in their submissions that the goods were identical.

The Applicant argued that the first word in each mark is visually distinguishable from the other because they are different. The Opponent, however, submitted that the respective marks were highly similar as they were identical in length, and shared the same initial letter and final three letters. The Hearing Officer (HO) decided upon a medium level of visual similarity. Applying similar reasoning, a medium level of aural similarity was found to exist.

A conceptual distinction was drawn between the marks by the HO, with SUPERDRY being found to convey a message of “very dry”, whereas SPRAY DRY was deemed to convey a message that the goods have been sprayed to keep wetness out. The difference in meaning between SUPER and SPRAY was further relied upon to support the finding of a low level of conceptual similarity.

The HO found that the purchasing of clothes by the public would generally involve a reasonable degree of care and attention.

Interestingly, SUPERDRY was found to allude to keeping the wearer of its clothing dry, and therefore was considered to have a low level of inherent distinctive character. However, upon factoring in Superdry’s £600m of UK sales in the year prior to the relevant

date for these proceedings, the HO sensibly concluded that this resulted in an enhanced level of distinctive character.

IDENTITY ISSUE

In applying the relevant case law, and the findings as set out above, the HO decided that the difference between SPRAY and SUPER would have the effect of changing the conceptual identity of the marks. As such, an average consumer was not likely to believe that the marks originated from the same or linked undertakings. The opposition based on s5(2)(b) therefore failed. Applying similar logic, the HO went on to dismiss the opposition under s5(4)(a), as the large number of differences between the two marks meant that no economic connection would ever be made by the average consumer.

Turning to the s5(3) arguments, it was quickly established that SUPERDRY enjoyed the requisite reputation in the UK. However, the HO dismissed these arguments on the basis that the Applicant’s mark would not bring the Opponent’s mark to mind.

SUPER DECISION?

It seems likely that the Opponent will appeal. Yet this decision highlights the importance of conceptual differences in a situation where, visually and aurally, the marks are similar. Showing conceptual difference in cases where there is a substantial level of visual and aural closeness can be enough to tip the scales away from a finding of similarity.

KEY POINTS

- ▶ The prefix was given greater weight than the suffix when undertaking the comparison
- ▶ SUPERDRY was deemed to have a low level of distinctive character before factoring in marketing spend
- ▶ Conceptual difference was given great weight in the analysis



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Face-off

Swatch took just “one more step” too far, says Yana Zhou

APPLE AND SWATCH have come head to head again, with this dispute concerning Swatch’s international registrations for SWATCH ONE MORE THING and ONE MORE THING. Apple opposed the two UK designations under s5(4)(a) of the Trade Marks Act 1994 on the basis of its earlier unregistered rights, and under s3(6), arguing that Swatch “sought to hijack the mark for its own benefit, either to parody Apple, divert trade from Apple or make use of the reputation subsisting in that mark”.

Apple filed evidence that Steve Jobs, its co-founder, used the phrase “one more thing” towards the end of his keynote speeches before revealing a new Apple product, service or similar. Apple suggested the applications were not appropriate, an act of “trolling” and “poking fun at Apple”. Swatch filed evidence of use of the phrase “one more thing” by the television detective Columbo, and of its themed watch collections over the years.

NO DISTINCTION

For s5(4)(a), the Hearing Officer (HO) found that the evidence demonstrated that ONE MORE THING was not being used as a sign distinctive of Apple goods. He stated that this alone would be sufficient to dismiss the claim. However, he considered whether there had been misrepresentation and concluded that the relative lack of knowledge, on the part of the UK public, of Apple’s use of ONE MORE THING, combined with the nature of that use, would not lead to a substantial number of people being deceived.

Under bad faith, the HO was satisfied that Swatch knew of Apple’s use of ONE MORE THING when it applied for the trade marks. He rejected the arguments that Swatch had no intention to use the marks, otherwise there would be no parody, diversion of trade or benefit from reputation, which would depend on there being use of the mark. He also rejected the notion of “hijacking”, finding under s5(4)(a) that there was no deception



and that there would be no diversion of trade given his findings regarding the degree of knowledge and nature of use.

PARODY POSITION

However, in relation to the allegation based on parody, the HO concluded that press articles regarding Swatch’s applications gave some credence to the suggestion that it may have intended to parody Apple. He noted it could be no coincidence that Swatch applied for the applications shortly after the Apple Watch was launched, at a time when the parties were already at loggerheads. In his view, all of this strongly supported the argument that the applications were filed as a retaliatory measure, and this fell short of the standards of acceptable commercial behaviour.

The case succeeded on bad faith grounds, but, at times, it almost felt like the HO was trying to regulate the somewhat tense relationship between the parties. He reprimanded Swatch in this instance for going one step too far.

This case also reminds brand owners that they should consider registered protection for brand elements: Apple would have had an easier case if it owned a ONE MORE THING trade mark.

KEY POINTS

- ▶ Apple opposed two of Swatch’s UK designations of international registrations under s5(4)(a) and s3(6)
- ▶ The HO dismissed the claim under s5(4)(a), concluding that the evidence did not demonstrate that Apple used ONE MORE THING as a trade mark and there had been no misrepresentation
- ▶ Apple succeeded on bad faith, with the HO finding that Swatch’s behaviour fell short of standards of acceptable commercial behaviour
- ▶ Brand owners should consider registered protection for all brand elements they wish to use



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No going back

Here, the Court held that IP Translator and Praktiker were not retroactive, Richard May reports



IN 2009, Ms Isabel Rodriguez filed an EU trade mark (EUTM) application for the sign depicted below (No 8489643) for plant-related goods and services. In 2010, Cactus SA (the Opponent) opposed the application under Article 8(1)(b) of Council Regulation (EC) No 207/2009. The opposition was based on two EU registrations (also depicted below) registered in 2001 and 2002, and covering several classes, including class 35. Notably, the Opponent's marks were registered using class headings, but neither these headings nor the Nice alphabetical list in force at the time the marks were filed expressly covered "retail services" in class 35.

Despite this, the General Court (GC) found that the earlier marks had been put to genuine use in respect of retail services, and were protected for, among other things, "retailing of natural plants and flowers, grains; fresh fruit and vegetables" in class 35. This conclusion effectively handed the Opponent victory. The CJEU affirmed the GC's decision, leading to questions about how class headings should be interpreted for EUTMs registered prior to the CJEU's judgments in *IP Translator* (12th June 2012) and *Praktiker* (7th July 2005).

GROUNDINGS OF APPEAL

EUIPO appealed the GC's decision to the CJEU on the basis that the GC had erroneously concluded that a full class heading extends the protection of a mark to all services included in that class, including retail services for "all possible goods" in class 35, and thus misinterpreted *IP Translator* and *Praktiker*. The GC held that neither of those judgments applied to trade marks registered before their delivery dates. EUIPO argued

the GC's position was flawed because it disregarded the retroactive effect of case law.

CJEU DECISION

The CJEU referred to its own recent decision in *Brandconcern v EUIPO and Scooters India* (C-577/14 P), which makes it clear that its judgments in *IP Translator* and *Praktiker* provided clarifications only on the requirements relating to new EUTM applications, and do not concern trade marks that were already registered when those judgments were delivered. In the CJEU's view, this approach is consistent with the principles of legal certainty and legitimate expectations.

While *Cactus* makes interesting reading, the CJEU's judgment may not have an impact on disputes decided under the new Regulation (EU) 2017/1001. The new regulation and Article 33(8) (old Article 28(8)) in particular make it clear that all EUTMs featuring a class heading and not subject to an Article 28 declaration, regardless of age, will be deemed to extend only to goods and services clearly covered by the literal meaning of the class heading (not necessarily all goods and services). The CJEU seems to acknowledge this by stating, at paragraph 49 of *Cactus*, that the new codified regulation was not applicable at the date of the decision. However, further CJEU guidance on class headings may yet be required.

KEY POINTS

- ▶ The CJEU confirmed *IP Translator* and *Praktiker* are not retroactive and do not apply to EUTMs registered before their delivery dates
- ▶ However, the *Cactus* judgment may not have an impact on disputes decided under the new codified Regulation (EU) 2017/1001

- ▶ EUTM application No 8489643

CACTUS OF PEACE

CACTUS DE LA PAZ

- ▶ Earlier *Cactus SA* EU registrations:

No 963694
CACTUS

No 963595



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Finding the missing link

Désirée Fields explains why failure to assess the strength of an earlier mark may prove fatal

ON 6TH JUNE 2009, PP Gappol Marzena Porczyńska (Gappol) filed an EU trade mark application for the figurative mark GAPPOL (shown below) in respect of “furniture” in class 20 and various clothing items in class 25. Gap (ITM), Inc opposed the application based on Articles 8(1)(b) and 8(5) of Council Regulation (EC) No 207/2009, relying on various earlier GAP marks covering “clothing, footwear, headgear” in class 25. The opposition was partially upheld in respect of class 25. Gappol appealed and Gap cross-appealed, requesting that the application also be refused for class 20. EUIPO’s Board of Appeal (BoA) rejected Gappol’s appeal and upheld Gap’s cross-appeal. Gappol appealed to the General Court (GC).

GC ANALYSIS

Partially upholding the opposition under Article 8(1)(b), the GC confirmed that the respective parties’ goods in class 25 were identical, and that the marks were visually, phonetically and conceptually very similar. The differences between them were not sufficient to eliminate the likelihood that the relevant public could believe the goods originated from the same undertaking or from economically linked undertakings.

The GC confirmed that the earlier GAP mark had acquired a reputation in the UK and was well known in respect of “clothing”, and considered that the UK was a substantial part of the EU.

The GC noted that there had to be a global assessment as to whether there was a link between the two marks, taking into account all factors relevant to the case, including: the degree of similarity between the marks; the nature of the goods or services covered, including the degree of closeness or dissimilarity between them; the relevant public; the strength of the earlier mark’s reputation and degree of its distinctive character; and the existence of a likelihood of confusion on the part of the public.

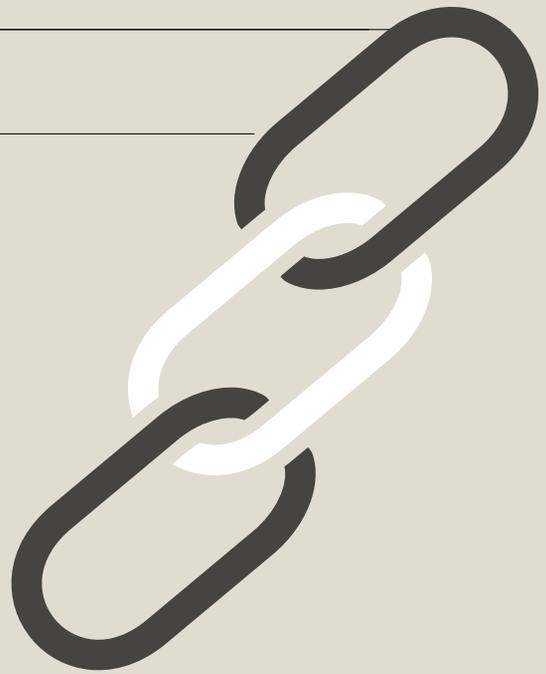
While the BoA had correctly held that the marks had a degree of visual, phonetic and

conceptual similarity, the GC found a very limited proximity between “furniture” and “clothing, footwear, headgear”. The goods had a different nature, purpose and method of use, were neither complementary nor in competition, and did not belong to the same or neighbouring product markets. It was also uncommon for them to be sold in the same outlets or store departments.

Crucially, the GC noted that the BoA had not specified the strength of reputation and degree of distinctiveness of the earlier mark, both relevant in assessing the existence of a link between the respective signs. The degree of distinctiveness of the earlier mark was also relevant when assessing whether the infringement constituted taking an unfair advantage of the distinctive character or repute of that mark: the stronger the earlier mark’s distinctive character and reputation, the easier it would be to accept that detriment had been caused to it.

GAP IN ASSESSMENT

The outcome of a reputation-based trade mark infringement action depends particularly on the degree of similarity between the respective marks and goods or services, and the degree of distinctiveness and reputation enjoyed by the earlier well-known mark. Here, the BoA’s failure to assess the degree of distinctiveness of the GAP mark proved fatal to the reputational claim. The GC was unable to intervene, as the BoA had not carried out a complete assessment of the requirements governing Article 8(5).



KEY POINTS

- ▶ The strength and reputation of an earlier mark is relevant in finding a link between two signs
- ▶ The stronger the distinctive character of an earlier mark, the more likely the relevant public will call the earlier mark to mind
- ▶ The GC cannot alter a decision where EUIPO has failed to carry out a complete assessment of the requirements governing Article 8(5)

- ▶ The GAPPOL mark



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The waiting game

A delayed challenge was the wrong move, writes Tom Hooper

IN AUGUST 2014, Forest Pharma BV (the Applicant), which operates a pharmaceutical company, filed an EU trade mark application for the word COLINEB covering pharmaceutical products and medical devices in classes 5 and 10 (the Application).

Ipsen Pharma SAS (the Opponent) opposed the Application under Article 8(1)(b) of Council Regulation (EC) No 207/2009 (now Regulation (EU) 2017/1001). The Opponent is the owner of the stylised German registration for COLINA (shown below) covering goods in class 5. It also operates in pharmaceutical fields.

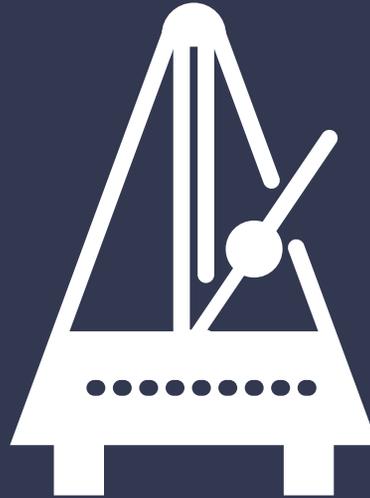
The registration relied upon was more than five years old (registered in 1925), and so the Applicant requested proof of use. The EUIPO Opposition Division found that the Opponent had shown use, but only in relation to “pharmaceutical drugs and products for the treatment of gastrointestinal disorders”. In the first instance, it held that there was a likelihood of confusion between COLINEB and the stylised COLINA mark. The Opposition was upheld for all the contested goods.

FAST ACTION

The Applicant filed a notice of appeal. The EUIPO Board of Appeal (BoA) dismissed this appeal within just six months, on the basis that neither party disputed the fact that the Opponent’s earlier mark had been put to genuine use in Germany during the relevant period.

At both levels of EUIPO, the Opposition succeeded. It was found that the goods in class 5 were identical and those applied for in class 10 were similar to the Opponent’s goods to a low degree. Finding that the signs at issue were similar and that the earlier mark enjoyed a normal degree of distinctiveness, a likelihood of confusion followed. This was despite the high level of attention paid by the German consumer or end user of the pharmaceutical products and medical devices applied for.

The Applicant again appealed to the General Court (GC) on the same grounds, but adding



the fact that the Opponent had not sufficiently proved genuine use of its trade mark, and some use differed to the form registered.

GC AGREES

The GC agreed with EUIPO’s assessment of the marks and the goods. Since the Applicant did not put forward arguments to challenge the evidence of genuine use before EUIPO (at any level), it was not for the GC to decide whether use had been established.

Comparing the marks, the GC found them visually similar. Five letters in both marks were identically placed, and the stylisation of the Opponent’s earlier mark was not very striking. When spoken, the marks could only be distinguished by their last syllables, so there was a high level of aural similarity. Since the Opponent had a German registration, it was the public in that country that was considered, for whom neither COLINEB nor COLINA had any particular meaning. Accordingly, a conceptual assessment was not possible.

This case is a useful reminder that any grounds for challenge should be contested early, and not raised for the first time before the BoA or the GC. In this case, the Opponent waited for the GC appeal to contest genuine use. This meant the Court could easily dismiss those arguments, regardless of how broad the Opposition Division’s assessment of use may have been, or if the mark was used in a slightly differing form.

KEY POINT

- ▶ All grounds for challenge should be contested early and not raised for the first time before the BoA or GC
- ▶ The Opponent’s mark (German number 338874)



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A French connection

*Why did the NRJ mark lack power?
Frédérique Bodson explains*



BRITISH SKY BROADCASTING Group plc applied to register an EU trade mark (EUTM) for SKY ENERGY in classes 9, 35, 38, 41 and 45. The NRJ Group filed a notice of opposition based on its earlier EUTM for NRJ, covering, *inter alia*, services in classes 35, 38 and 41.

The EUIPO Opposition Division rejected the opposition, finding that there was no likelihood of confusion between the marks under Article 8(1)(b) of Council Regulation (EC) No 207/2009 (now replaced by Regulation (EU) 2017/1001). Upon NRJ's appeal, EUIPO's Board of Appeal (BoA) only partially upheld the opposition in relation to goods and services in classes 9, 38 and 41 specific to radio and broadcasting.

The BoA found the marks visually different but phonetically and conceptually similar overall for the relevant French-speaking public, since both referred to the term "energy" with the letters "NRJ" being pronounced as "en-er-gie"/"e-ner-gie" in French. While the earlier mark enjoyed enhanced distinctiveness, it did so only in France, and only in relation to "radio broadcasting" and "radio entertainment", with a merely average degree of distinctiveness in relation to the remaining services. The BoA concluded that the relevant public might confuse the marks when used for the goods and services that were identical or similar to "radio broadcasting" and "radio entertainment", but only those aimed at the general public. Where the mark appeared only visually – eg online – the marks would, however, be distinguishable.

CONFIRMATION

Upon NRJ's further appeal, the General Court broadly agreed with the BoA: there was a likelihood of confusion under Article 8(1)(b) between both marks with regard to those goods and services covered by the application that were identical or similar to the services for which the earlier NRJ trade mark enjoyed enhanced distinctiveness. The Court confirmed the BoA's view that both marks were phonetically and conceptually similar for the relevant French-speaking public, and that the

NRJ mark possessed enhanced distinctiveness only in France, limited to "radio broadcasting" and "radio entertainment" services.

The Court also agreed that the relevant public included both the general public and professionals. There was a likelihood of confusion for those goods and services covered in classes 9, 38 and 41 specific to radio and broadcasting. There was, however, no likelihood of confusion with regard to those goods and services aimed at professionals with a higher degree of attention. Finally, the Court agreed that there was no likelihood of confusion for the goods and services in relation to which the mark appeared visually, since consumers would see the trade mark or a logo on their computer or telephone screen and notice the visual differences.

PROTECTION LIMITS

This case illustrates the limits of the protection granted to trade marks with enhanced distinctiveness under Article 8(1)(b) and the differences of perception of marks depending on the context of their use. If the opposition had been based on Article 8(5), by claiming reputation on one of NRJ's earlier French marks and assuming NRJ could demonstrate reputation, the outcome might have been different.

KEY POINTS

- ▶ This case illustrates the limits of the protection granted to trade marks with enhanced distinctiveness under Article 8(1)(b) and the differences of perception of marks depending on the context of their use
- ▶ If the opposition had been based on Article 8(5), the outcome might have been different



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Peak problem

SDSR faced too high a mountain to climb, writes Jessica Harris

THIS DECISION refers to an appeal by Sports Division SR, SA (SDSR) against a decision of EUIPO's Second Board of Appeal (BoA) to uphold an opposition to refuse SDSR's application for a composite mark (the Application, shown below) consisting of an image of a mountain, followed by the words BERG OUTDOOR, in classes 18, 22 and 25. Berghaus Ltd successfully opposed the Application based on Articles 8(1)(b) and 8(5) of Council Regulation (EC) No 207/2009 (now 2017/1001), relying upon various earlier rights, including for the word mark BERGHAUS, covering identical and highly similar goods to the Application.

SDSR appealed the BoA's decision to the General Court (GC). The sole basis for its appeal was infringement of Article 8(1)(b). It argued that there was no likelihood of confusion between the marks at issue on the basis that: (i) the marks had coexisted on the market without confusion; (ii) the mark applied for had a reputation; and (iii) the mark applied for had its own distinctive character.

COEXISTENCE

The GC held that SDSR had not provided sufficient evidence to demonstrate that the marks at issue had coexisted peacefully on the EU market. SDSR's evidence contained partial reproductions from its websites without publication dates; lacked supporting documents to show use of the Application of independent origin; did not show the Application being used across all EU Member States; did not indicate the duration of use of the Application; and related only to the Application, not any of Berghaus Ltd's earlier marks. The GC further held that the evidence did not concern the manner in which the relevant public had been exposed to the Application or Berghaus's earlier marks on the relevant market. Accordingly, the GC deemed it "impossible" to find that the marks at issue coexisted on the market, and therefore considered it an "unsupported assertion" by SDSR.

REPUTATION

The GC confirmed that only the reputation of Berghaus's earlier marks, and not the Application, was relevant in the context of

assessing likelihood of confusion. Therefore, SDSR could not rely on the reputation of the Application to establish the absence of a likelihood of confusion between the marks at issue.

DISTINCTIVE CHARACTER

The GC held that the differences between the Application and Berghaus's earlier marks did not outweigh the overall similarity, owing to the element BERG that appeared at the beginning of both marks. In particular, the decision discussed how this term would be understood by the relevant members of the public with knowledge of German, Dutch or Swedish as meaning "hill/ mountain". As such, there was a strong conceptual similarity between the marks for this portion of the relevant public. In addition, the word BERG was considered to be one of the most dominant elements in each mark when a global assessment was made.

IMPORTANCE

This case highlights the importance of filing relevant evidence and provides helpful guidance as to what is required in order for such evidence to be persuasive. It also reiterates the principles for assessing likelihood of confusion.



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KEY POINTS

- ▶ The GC confirmed that only the reputation of Berghaus's earlier marks was relevant in the context of the assessment of the likelihood of confusion
- ▶ The differences between the Application and Berghaus's earlier marks were not enough to outweigh the overall similarity

- ▶ The SDSR mark





Delay could pay

Rose Smalley recommends a strategic slowdown when it comes to showing evidence



IN THIS CASE, the General Court (GC) upheld a Board of Appeal decision in respect of SCATTER SLOTS, an EU trade mark (EUTM) application filed by Murka Ltd in class 41 for goods and services including betting services, casinos and electronic games services. The GC held that SCATTER SLOTS was:

- a) descriptive of the services in question under Article 7(1)(c) of Council Regulation (EC) No 207/2009;
- b) devoid of distinctive character under Article 7(1)(b); and
- c) ineligible for acquired distinctiveness through use under Article 7(3).

INVENTION OVER DESCRIPTION

Referencing OHIM v Wrigley¹, the GC found that if at least one possible meaning of a mark is descriptive it must be refused registration under Article 7(1)(c). This must be assessed by reference to the relevant public's perception of that mark and the goods/services concerned.² In relation to betting services, the GC held that SCATTER SLOTS clearly and unequivocally meant "services connected with gambling machines characterised by the 'scatter' function"³ in the mind of the relevant public.

This decision illustrates the worth of invented words that are devoid of any inherent meaning and wholly distinctive, eg Opodo and Kodak. Failing that, EUTM applicants should incorporate words that are unrelated to and distinct from the relevant services provided in order to avoid refusal under Article 7(1)(c).

The GC also reaffirmed that, as an absolute ground for refusal under Article 7(1)(c) applied, it was unnecessary to rule on the second plea relating to distinctive character under Article 7(1)(b).

EVIDENCE IS KEY

The GC made a number of observations in relation to evidencing acquired distinctiveness.

First, it observed that regard should be had to the trustworthiness of affidavit evidence.⁴

The GC held that evidence from third parties or unconnected persons will carry more credibility and reliability than evidence from an applicant's director, who will naturally have a vested interest in the outcome.

Second, only evidence that predates the filing date of the relevant mark will be taken into consideration.

Further, the GC re-emphasised the evidential requirements for acquired distinctiveness as reported in BIC v OHIM⁵ – namely, evidence must substantiate:

- a) the market share held by the mark;
- b) the amount invested in promoting the mark;
- c) how intensive, geographically widespread and long-standing the use of the mark had been;
- d) the proportion of the public identifying the goods as originating from a particular undertaking; and
- e) statements from chambers of commerce, industry, trade or other professional associations.

Accordingly, where an EUTM applicant seeks to register a descriptive or non-distinctive mark, it may be prudent to delay the application (where possible) in order to collate sufficient pre-filing evidence of acquired distinctiveness. That evidence should focus on and clearly quantify the relevant information outlined above. In this case, evidential shortfalls hugely prejudiced the Applicant's arguments for acquired distinctiveness.

This decision provides a useful reminder of the evidence required in the context of acquired distinctiveness, and the inter-relationship between the absolute grounds for refusal.

KEY POINTS

- ▶ Where an EUTM applicant seeks to register a descriptive or non-distinctive mark, it may be prudent to delay the application (where possible) in order to collate sufficient pre-filing evidence of acquired distinctiveness
- ▶ Evidence should focus on and clearly quantify all relevant information

1. C-191/01 P, paragraph 32.
2. T-34/00, Eurocool Logistik GmbH v OHIM, paragraph 38.
3. Paragraph 40.
4. T-303/03, Lidl Stiftung & Co KG v OHIM, paragraph 42.
5. T-262/04, paragraph 64.



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Fall from grace

The timing wasn't right for an Aldi success, says Saaira Gill

ON 22ND FEBRUARY 2013, Aldi GmbH & Co KG filed an EU trade mark (EUTM) application for the figurative mark shown below for goods in classes 6, 9, 18, 20, 21 and 22.

Sky plc filed an opposition against the application in respect of all the goods in classes 9 and 18. The opposition was based on a number of earlier marks, including an EUTM word mark registration for SKY, registered on 8th August 2012 in a large number of classes, including 9 and 18. The grounds of opposition relied upon were Articles 8(1)(b), 8(4) and 8(5) of Regulation (EU) 2017/1001 (the Regulation).

Aldi requested that Sky provide proof of use of its earlier marks. However, EUIPO advised that the request could not be taken into consideration because the earlier marks had not been registered for at least five years at the date of publication of the application. The opposition was upheld, and the application was refused in classes 9 and 18. Aldi appealed the decision, but the appeal was dismissed. The case then went to the General Court.

PROGRESS

Aldi submitted that even though the marks relied upon in the opposition had not been registered for at least five years at the date of publication of the application, which is the period laid down in Articles 47(2), 47(3) and 18(1) of the Regulation, EUIPO should have required Sky to produce proof of genuine use of the earlier mark. Between 1995 and 2009, Sky had developed a practice of refile applications for identical trade marks as EU or national marks, in particular for goods in classes 9 and 18.

Aldi argued that the application of the aforementioned articles was, exceptionally, necessary in this case due to repeated

applications of an earlier mark. Aldi argued these applications sought to circumvent or prolong the grace period of five years for use of a mark, and for that reason were abusive.

In support of this argument, Aldi relied upon Board of Appeal (BoA) decisions in PATHFINDER (R 1785/2008-4) and KABELPLUS (R 1260/2013-2).

CONFIRMATION

The Court confirmed that the BoA was fully entitled to hold that the request for proof of use of the earlier mark was not admissible because the earlier mark had not been registered for more than five years at the date of publication of the application. The Court also confirmed that, in the context of opposition proceedings, EUIPO cannot examine whether a mark fulfils criteria that constitute an absolute ground for invalidity within the meaning of Article 59(1).

Aldi's second plea in law was an infringement of Article 8(1)(b). The Court confirmed that the BoA was correct in its finding that there was a likelihood of confusion in the mind of the English-speaking part of the relevant public between the marks SKYLITE and SKY.

This case confirms that despite cogent arguments and persuasive evidence that shows that an opponent has acted in bad faith, EUIPO cannot take this into consideration in opposition proceedings.

KEY POINT

► This decision is contrary to EUIPO's decisions in PATHFINDER and KABELPLUS, where opponents were forced to file "proof of use" of earlier marks, no matter how old they were at the date the application was published, if the earlier marks were deemed re filings of earlier registrations that were more than five years old

► The Aldi mark

SKYLITE



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events

More details can be found at citma.org.uk

DATE	EVENT	LOCATION	CPD HOURS
27th February	CITMA Lecture – London*	58VE, London EC4	1
8th March	CITMA Scottish Quiz	Le Monde Hotel, Edinburgh	
14th March	CITMA Webinar*	Log in online	1
21st March	CITMA Intensive Training Seminar IP contracts	Bird & Bird, London EC4	3
21st–23rd March	CITMA Spring Conference* IP in a global economy	County Hall, London SE1	9
21st March	CITMA Networking Drinks Reception Part of CITMA Spring Conference	Balls Brothers, London EC4	
22nd March	CITMA Gala Dinner Part of CITMA Spring Conference	County Hall, London SE1	
28th March	CITMA AGM & CITMA Benevolent Fund AGM	Charles Russell Speechlys, London EC4	
10th April	CITMA Lecture – London*	58VE, London EC4	1
19th April	CITMA Designs Seminar – London	Allen & Overy, London E1	2.5
9th May	CITMA Webinar*	Log in online	1
20th June	CITMA Webinar*	Log in online	1
17th July	CITMA Lecture – London*	58VE, London EC4	1
15th August	CITMA Webinar*	Log in online	1
25th September	CITMA Lecture – London*	58VE, London EC4	1
17th October	CITMA Webinar*	Log in online	1
14th November	CITMA Webinar*	Log in online	1
27th November	CITMA Lecture – London*	58VE, London EC4	1
7th December	CITMA Northern Christmas Lunch	TBC	
14th December	CITMA London Christmas Lunch	London Hilton on Park Lane, London W1	

SUGGESTIONS WELCOME

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In April, Allen & Overy's London office will host our Designs Seminar. Look out for details at citma.org.uk



THE TRADE MARK 20

Q&A



I am a... Chartered Trade Mark Attorney at Brand Protect Ltd, a boutique IP firm in Oxfordshire.

Before this role, I was... working at a law firm in Watford in its commercial department. Although I gained some useful experience there, I much prefer the work I do in my current role.

My current state of mind is... happy. I enjoy my job and I'm getting married in the summer, so life is good!

I became interested in IP when... I talked to a Trade Mark Attorney while I was at university. I liked the idea of it being a very niche industry, but integral for almost all businesses.

I am most inspired by... Leonardo da Vinci, after visiting one of his residences at Amboise, France. To be a gifted inventor, architect and engineer is impressive. To be perhaps the world's most famous painter in addition to that is incredible.

In my role, I most enjoy... obtaining favourable outcomes for my clients in trade mark disputes.

In my role, I most dislike... unpaid bills.

On my desk is... a computer, *Kerly's* and the file I was working on this morning. I try to keep my desk as tidy as possible.

My favourite mug says... "dishwasher safe". I can confirm that it is.

My favourite place to visit on business is... Barcelona. I went for the INTA Annual Meeting last year. It was a very interesting city, although I didn't get a chance to see much of it on that occasion.

If I were a trade mark or brand, I would be... Land Rover. Not out of place in a city, but much happier in the countryside.

The biggest challenge for IP is... Brexit at present, but it will be 3D printing in the near future.

The talent I wish I had is... fluency in all languages. When abroad I like to try to speak the local language, even if I do it badly.

I can't live without... a strong cup of tea to start my day.

My ideal day would include... skiing on a beautiful day in the Alps with my friends and family.

In my pocket are... my phone, keys and wallet.

The best piece of advice I've been given is... "If a job's worth doing, it's worth doing well." My father gave me that advice when we were doing some DIY together, but it can be applied to any work.

When I want to relax, I... walk my parents' dog. He's a very energetic English Pointer with a penchant for chasing deer. An afternoon with him is always entertaining.

In the next five years, I hope to... travel more. My first venture into Asia will be Vietnam. I'm particularly looking forward to hiking in the mountains and visiting the caves and tunnels, as well as exploring Hanoi.

The best thing about being a member of CITMA is... the events – they are always thought-provoking.



Soon-to-be married
Adam Mash professes
admiration for
da Vinci, and more

“

I liked the idea of IP being a very niche industry, but integral for almost all businesses

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