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# ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

Issue  422 December 2015/January 2016 [itma.org.uk](http://itma.org.uk)

*Smell of*



*Success!*

GEORGE SEVIER  
CONSIDERS THE  
NEW POTENTIAL  
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December 2015/January 2016



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### Published on behalf of ITMA by:

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25 Chapel Street, London NW1 5DH  
Tel: 020 3771 7200

[www.thinkpublishing.co.uk](http://www.thinkpublishing.co.uk)

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## ITMA Review

Review content is provided by members on a voluntary basis, and reader suggestions and contributions are welcome. If you would like to contribute an article to a future issue, please contact Helene Whelbourn by email at [helenewhelbourn@outlook.com](mailto:helenewhelbourn@outlook.com) and Caitlin Mackesy Davies at [caitlin@thinkpublishing.co.uk](mailto:caitlin@thinkpublishing.co.uk)

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I'm pleased to preface this bumper Christmas edition of the *ITMA Review*. As we career towards the end of yet another year, we bring you a veritable smorgasbord of content, including coverage of our successful Autumn Seminar in Birmingham, a very useful summary of recent case law on EU designs, tips on blogging and dealing with the press, guidance on trade mark issues in unrecognised states, and much, much more.

On the subject of unrecognised states, I should by now have enjoyed our Northern Christmas lunch with

members and friends in Leeds, and the London lunch will either be imminent or a fading memory by the time you read this.

Which reminds me that it is time to write my speech, and on that note, I wish you all a relaxing break over the Christmas period.

**Chris McLeod**  
ITMA President

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# ITMA Insider



## CEO bulletin

*Updates and additions to Keven Bader's September bulletin to members*

### ROYAL CHARTER UPDATE

We received a positive response to our proposed application for a Royal Charter. As there weren't any objections, we formally submitted our draft petition and supporting documents to the Privy Council in August.

### STRATEGIC DIRECTION

In July, the ITMA Council met to review the strategic direction of the organisation and its current objectives. As an outcome, it was agreed that the general direction of the organisation is still right, but our objectives need revision. From the 10 objectives we currently have, a suggested refinement to three was agreed. The proposed new strategic objectives are:

- To be the pre-eminent body for trade marks and designs in the UK.
- To represent, promote and engage the membership and the wider profession.
- To equip and support our membership to be competitive and successful.

In-depth communication on the outcomes from the meeting will follow, but immediate comments from members are welcome.

### RENEWAL REMINDER

In November, all members should have received their 2016 renewal subscriptions. As part of the renewal process, we hope every member will check the details we have on file, which appear in your profile on the ITMA website, to ensure that they are correct and up to date.

And of course, this is a reminder to make sure your renewal is paid. Online

## Administrators now have a wider skillset so we need to support this

payment through the ITMA website is our preferred payment method as this enables automatic allocation of payment to the appropriate record in our systems.

### TRADE MARK ADMINISTRATOR TITLE

We have been undertaking a piece of work to look at our Administrator category of membership and whether the title Trade Mark Administrator (TMA), which we believe is commonly used, is an appropriate title for the work that is undertaken by TMAs. It is clear that a range of duties are provided by TMAs and firms have differing approaches to the roles and responsibilities given to them. It is also clear that TMAs now have a wider skillset than has historically been the case, so we need to support this.

We recently launched a consultation on this matter and there is still time to contribute. Register your own views until 15 December at [itma.org.uk](http://itma.org.uk). Your comments will be extremely valuable.

### ITMA REVIEW: YOUR OPINIONS WANTED

As a member of ITMA you receive eight copies of *ITMA Review* every year; it's your magazine, written principally by ITMA members and we want to receive your feedback about the publication.

We are conducting a reader survey to learn more about how you read this magazine, which parts you value, what you would like to see more of, anything you'd like to see less of, and any general comments you have.

The *ITMA Review*, now in its 422nd edition, has been a staple of membership for a number of years, and since May 2011 has been produced by Think Publishing.

**To tell us what you think about the publication, simply go to [bit.ly/ITMAReview2015](http://bit.ly/ITMAReview2015) by 8 January 2016 to take part.**

The magazine has always been and continues to be written by IP professionals and there are opportunities for you to contribute to the publication. Get in touch with our editor, Caitlin Mackesy Davies, at [caitlin@thinkpublishing.co.uk](mailto:caitlin@thinkpublishing.co.uk) if you would like to find out more about the process and how you can contribute. ■



# WIPO NOTICE NO 38/2015

*Daniel Smart, member of ITMA's WIPO Liaison working group, explains this recent communication*

**W**IPO's Information Notice No 38/2015 has clarified the status of International Registration to British Overseas Territories (Anguilla, Bermuda, British Antarctic Territory, British Indian Ocean Territory, British Virgin Islands, Cayman Islands, Falkland Islands, Gibraltar, Montserrat, Pitcairn, St Helena, Ascension and Tristan da Cunha, South Georgia and the South Sandwich Islands and Turks and Caicos Islands) and Crown Dependencies (Guernsey, Isle of Man and Jersey). None of these, except

*For the Isle of Man, UK trade mark legislation is extended directly through an Order in Council made by Westminster*

Gibraltar, is a part of the EU. A designation of the United Kingdom in an international application or subsequent designation will cover the Falkland Islands, Isle of Man and Jersey.

Uniquely, for the Isle of Man, this is because UK trade mark legislation is extended directly to the Isle of Man through an Order in Council made by Westminster.

The Falkland Islands and Jersey recognise designations of the United Kingdom through legislation enacted locally. The other territories are not covered by a designation of the United Kingdom in an international application or subsequent designation.

The Information Notice states a designation of the European Union covers Gibraltar. This writer cautions that Gibraltar, as a common law country, has not taken steps to reflect this within its local law.

The UK's membership of the Madrid Protocol is extended to the Isle of Man. Manx companies can therefore file international applications through the UK as Office of Origin.

The Information Notice clarifies that applicants from the British Overseas Territories, Jersey and Guernsey filing international

applications through the UK as Office of Origin must provide an address of a domicile or establishment in the United Kingdom or Isle of Man. This is also true if an International Registration is transferred to an owner from a British Overseas Territory, Jersey or Guernsey. This is the same as any foreign owner claiming entitlement through the UK.

Incidentally, Gibraltarian companies can file international applications through OHIM as Office of Origin. In this case, there does not need to be a change in the local legislation in Gibraltar for them to benefit from the EU's Madrid Protocol membership.

WIPO notes, "The interpretation of what may be considered 'domicile', 'real and effective industrial or commercial establishment' or 'nationality' is a matter for the law of the Contracting Party concerned and is not an issue that the International Bureau of WIPO is competent to concern itself with."

There are International Registrations owned by companies from British Overseas Territories that perhaps should not be and would be open to challenge.

I am not aware of any challenges in any countries to an entitlement to own an International Registration. It could be worthwhile considering entitlement when looking to oppose or cancel a designation of an International Registration.

## Member *moves*



Aaron Wood is pleased to announce the launch of Wood IP Limited – a full service trade mark firm with a particular specialism in contentious matters before the UK IPO, OHIM and the Courts – which opened on 1 October 2015. Aaron can be reached on [aaron@wood-ip.com](mailto:aaron@wood-ip.com), tel: +44 (0)1788 860 060 or fax +44 (0)1788 221 580.



Jorandi Daneel has joined Appleyard Lees as an Associate in the trade mark team. She will be based across the company's Leeds and Halifax offices and can be contacted at [jorandi.daneel@appleyardlees.com](mailto:jorandi.daneel@appleyardlees.com).

## *Thank you to our speakers and supporters*

As the year draws to an end, ITMA would like to thank all of those who took the time to speak at ITMA events and to contribute to *ITMA Review*, helping us to inform and entertain members throughout 2015.

*Many Thanks!*



# Hot topics from in-house

*Dominic Murphy summarises  
the key sessions at the annual highlight  
of the ITMA autumn calendar*

PHOTOGRAPHY BY STEWART RAYMENT



**I**TMA once again kicked off its autumn events with a well-attended Autumn Seminar at the Hyatt Regency hotel in Birmingham. The day focused on in-house perspectives and included talks by representatives of a range of companies, encompassing big names like Rolls-Royce and BP who were supported by voices from relevant legal firms including Charles Russell Speechlys LLP, Saidman DesignLaw Group and Novagraaf.



**This page (left to right):**

Leanne Hall, Trade Mark & Domain Name Advisor, Rolls-Royce plc;  
Jillianne Osborn, Legal Counsel, Vodafone Group plc;  
Giovanni Visintini, Trade Mark & Copyright Counsel, BP plc

**Next page (left to right):**

Perry Saidman, Principal and Owner, Saidman Design LawGroup;  
Eric Siecker, Managing Director, Patents, Novagraaf UK;  
Natalie Charlick, Senior Legal Counsel IP, The Royal Bank of Scotland plc

## Rolls-Royce plc

**LEANNE HALL** from Rolls-Royce plc discussed the issues of obtaining evidence of use when Rolls-Royce is mainly a business-to-business provider of goods and services. Leanne explained that trade mark protection is sought in key markets first, then other markets are considered for filings later, so that Rolls-Royce is “a house of brands, not a branded house.”

Rolls-Royce has the third-highest reputation in the UK and a valuable reputation around the world. Therefore, when enforcing its trade mark rights, bearing in mind that it is a B2B business, Rolls-Royce relies on enforcing its rights as owners of “famous” and “well known” marks. Of course, the evidence needed to lodge such actions is vast and gathering evidence to support trade mark cases can be difficult. Therefore, Leanne has gathered bundles of relevant evidence and records of relevant judgments in favour of Rolls-Royce in advance, to be used in subsequent actions. Leanne also outlined procedures and evidential processes in numerous countries.

In a very handy practice tip, Leanne explained that she had submitted evidence to the Chinese registry demonstrating that certain Rolls-Royce trade marks are well known in China, and that this was done for both the English and Chinese spellings. This was assessed and approved by the Chinese registry, and these trade marks are now officially recognised as being well known marks in China, and evidence of this does not have to be resubmitted during every opposition.

## Vodafone Group plc

**JILLIANNE OSBORN** from Vodafone Group plc gave an enlightening talk detailing that, with a brand worth \$30bn, Vodafone manages infringement by tackling the most serious threats as a priority and working down the list. Jillianne uses a traffic-light system to rank infringing actions according to pre-set criteria. For example, infringing actions are ranked as red if they are derogatory to the brand, distort the logo or are morally unacceptable. To make the initial list of infringing actions, Jillianne works with a set of analysts at NetNames. Once the most serious threats have been identified, Jillianne takes action against the infringements by using NetNames, colleagues at Vodafone, Trade Mark Attorneys and a panel of law firms. Jillianne also outlined procedures and processes that worked well against multiple real-life infringing actions.



## BP plc

**GIOVANNI VISINTINI** from BP plc and **MARY BAGNELL** from Charles Russell Speechlys LLP gave an entertaining talk on registering and enforcing non-traditional trade marks, including the “BP green filling station” trade mark. Apparently, in 1927 all other fuel pumps were red and BP decided to make its pumps green to be in harmony with the countryside. In the case of the “BP green filling station” trade mark application, the fact that BP specifically advertised the green colour of its petrol pumps and stations greatly aided the registration of the mark on the basis of acquired distinctive character. Giovanni gave examples of practical ways to enforce your trade mark registrations in Russia and Uzbekistan, where having a lawyer/attorney who is a good negotiator and knows local customs as well as the law can be extremely beneficial, due to the difficulty of obtaining court judgments in these countries and enforcing those judgments on a practical level via court bailiffs and the local police.



## **Saidman DesignLaw Group**

**PERRY SAIDMAN**, Principal and Owner of Saidman DesignLaw Group, gave an eye-opening talk on how continuation applications, priority claims and appendices can be used to prolong the protection over designs for a staggeringly long period of time if you have the right knowledge of the US design patent system, which Perry clearly has. Perry also discussed an interesting case with a French/German company amusingly called *OuiCopyGut*, which allegedly tried to copy the design of a chair, making some small amendments so that Perry's client's design rights were not infringed. However, Perry astutely disclaimed certain features from the design and filed a continuation design patent covering the chair with the disclaimed features. This resulted in the thwarting of the "design around" attempt, since the essential elements that were allegedly being copied were all present in the modified continuation design patent. This process was used multiple times with respect to the same design patent to great effect.

### **Enjoying the social side:**

The event also allowed plenty of time for delegates to network and catch-up at the post-seminar drinks reception – the mini fish and chip canapés were a particularly popular accompaniment to the wine and beer on offer

## **Caterpillar**

**ERIC SIECKER**, former Head of IP Europe at Caterpillar and now Managing Director, Patents at Novagraaf UK, gave an informative talk on the use of design protection to protect the whole appearance of construction and mining equipment and replacement parts for it, such as the tooth from a digger bucket, against infringement by third parties. Eric noted that, while Caterpillar had around 12,000 trade marks and 14,500 patents, it once had hardly any designs as they were not seen as being as beneficial. However, Eric's determination to file designs resulted in the successful enforcement of the design right in a digger as a whole against a Chinese machine that was an exact copy of Caterpillar's digger.

## **The Royal Bank of Scotland plc**

**NATALIE CHARLICK**, Senior Legal Counsel IP from The Royal Bank of Scotland (RBS), gave an educational talk on how to balance social media with brand protection, illustrated with useful, real-life examples. Natalie discussed the goal of RBS to engage with its customer in just six seconds and how it uses social media to achieve this aim. Natalie's talk gave some highly entertaining and some very serious practical examples of where RBS has managed to balance the use of social media by employees and third parties – in order to avoid potentially damaging attempts to steal information via social media accounts and potential bad press – with enforcement of its trade mark and other rights.





01



03

ARENA PHOTO UK / SHUTTERSTOCK.COM



02

- 01. The striking modern architecture in Birmingham is perhaps best exemplified in its 2013 library building
- 02. Representatives from a number of major companies attended
- 03. Host venue, the Hyatt Regency hotel in Birmingham
- 04. Exhibitors, including legal charity LawCare, interacted with delegates between talks
- 05. Networking opportunities were plentiful



04



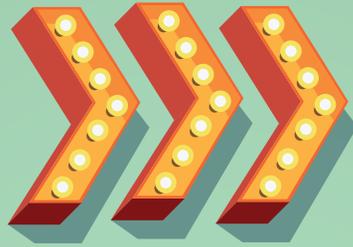
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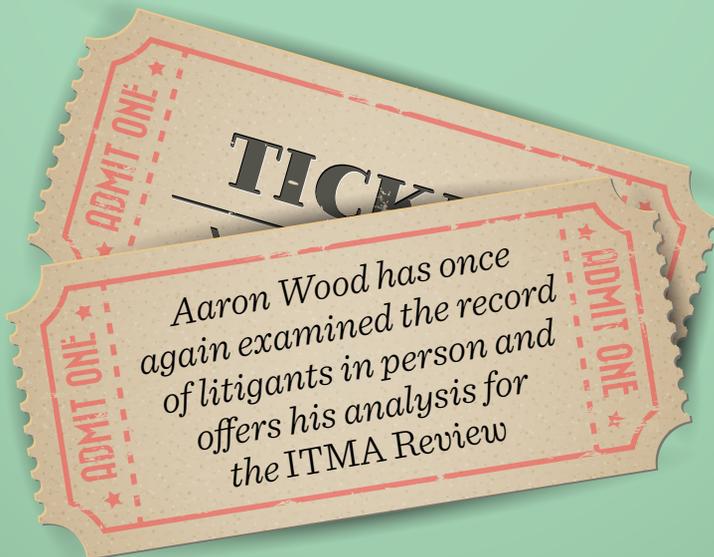
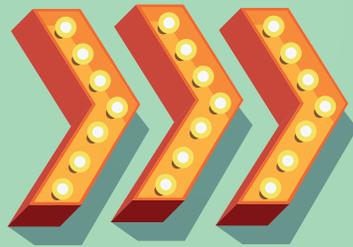
## ITMA SPRING CONFERENCE 2016 – REGISTER NOW

Book your place now at the 2016 ITMA Spring Conference, supported by Gold sponsor Corsearch, for what promises to be three days of great speakers, networking and contact-building. The “History and Heritage” themed event will take place at One Whitehall Place in London. As well as featuring a fantastic range of speakers, the conference includes a Gala Dinner at the iconic Tower of London, where you can network with IP professionals from around the world. Register online at [itma.org.uk](http://itma.org.uk).





# A RETURN APPEARANCE



## 2015: MOST APPEARANCES

Firm: Swindell & Pearson
Barrister: Thomas St Quintin
Trade Mark Attorney/Solicitor: Aaron Wood

## TOP 20 FIRMS: APPEARANCES 2011-2015

Firm	2010-2014
1 Stobbs IP	2
2 Swindell & Pearson	4
3 Marks & Clerk	1
4 Beck Greener	3
5 Cleveland	=5
6 D Young & Co	=14
= UDL	=5
8 Groom Wilkes & Wright	8
= Haseltine Lake	11
= Forresters	=5
11 HGF	9
= Mewburn Ellis	10
13 Bird & Bird	-
= Taylor Wessing	=16
= RGC Jenkins	=16
= Keltie	=14
= Wynne-Jones	=11
18 Fieldfisher	-
= Bristows	=16
20 Boulton Wade Tennant	-

## TOP 10 BARRISTER APPEARANCES 2011-15

Name	Chambers	2010-2014
1 Simon Malynicz	3 New Square	1
2 Michael Edenborough	Serle Court	2
3 Thomas St Quintin	Hogarth Chambers	=11
4 Jesse Bowhill	8 New Square	3
5 Denise McFarland	3 New Square	4
6 Benet Brandreth	11 South Square	5
7 Andrew Norris	Hogarth Chambers	6
8 Guy Hollingworth	One Essex Court	9
9 Amanda Michaels	Hogarth Chambers	=20
10 Fiona Clark	8 New Square	=11

## TOP 10 TMA/SOLICITOR APPEARANCES 2011-15

Name	Firm	2010-2014
1 Julius Stobbs	Stobbs IP	1
2 Ian Bartlett	Beck Greener	4
3 Martin Krause	Haseltine Lake	3
4 Kieron Taylor	Swindell & Pearson	=5
5 Alan Fiddes	UDL	2
6 Aaron Wood	Wood IP *	12
7 Rowland Buehren	Beck Greener	=5
8 Linda Harland	Reddie & Grose	9
9 John Reddington	Williams Powell	=14
10 Chris McLeod	Elkington & Fife LLP*	=14

\* Indicates that the cases were undertaken at previous firms

The number of UK IPO hearings is slightly up on last year, with approximately 52 per cent being decided on the papers. However, the distribution patterns reported last year (see *ITMA Review*, Issue 413) remain. There is still a "long tail" of advocates with only a single case this year; only 37 had an average of more than one case a year over the period, and only 14 had two or more per year on average.

### ADVOCATE EXPERIENCE

In the period 2010–2015 (six years) there was a total of 295 different representatives, of whom approximately 6 per cent had their first or only appearance in 2015. Overall, 47 per cent of the representatives to have appeared in 2010–2015 have appeared just once.

The top 12 per cent of representatives, taken overall,

account for 50 per cent of all hearings, with the top 5 per cent accounting for approximately one-third of all hearings and Simon Malynicz accounting for some 8 per cent of all appearances (82 appearances since 2010).

As of the collection date in 2015, the top 10 per cent of representatives account for 29 per cent of all hearings, with the split of appearances coming to 45 per cent non-counsel and 55 per cent counsel. Only a small number of the non-counsel representatives identify themselves as solicitors. This is a slight dip on 2014, when the split was 50/50.

### FIRM REPRESENTATION

From 2010–2015, 238 firms of representatives have appeared. Approximately 40 per cent have only had one case in this period. Again, 50 per cent of all appearances involve a small percentage (13 per cent) of all firms to have appeared in the period, the top 10 firms comprising approximately 25 per cent of all hearings. Most firms in the top 10 use exclusively, or predominantly, their own professionals as the advocates. ■

*Note: the author has gathered data regarding 2015 appearances for the period 1 January–8 October 2015. Other years' data represents the calendar year.*



### Aaron Wood

is Founder of Wood IP Ltd

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Aaron would like to thank Swindell & Pearson Ltd for allowing use of the data produced last year.

# Smell of Success?

GEORGE SEVIER  
RECONSIDERS THE  
POTENTIAL FOR EU  
REGISTRATIONS  
BASED ON OLFACTION



**A**pparently memories are evoked more reliably by smell than any other sense. So smells would seem well suited to identifying the origin of goods. Indeed, there was a spate of applications for smell trade marks in the 1990s. However, the number of applications fell when it became clear that smells were almost impossible to register as trade marks in Europe, where a fundamental requirement has been the ability to represent the mark graphically. Now, with that need disappearing in the impending European trade mark reforms, is it time to start thinking about registering and using smell marks again?

### CHANGING LEGISLATION

Article 4 of Council Regulation (EC) No 207/2009 (CTMR) provides: "A Community Trade Mark [CTM] may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings."

In theory, smells are signs capable of registration, but the requirement for graphical representation has in practice proved difficult to surmount. The OHIM *Guidelines* for examination state that there is currently no means of graphically representing smells in a satisfactory way. If there were a universally recognised way of classifying particular smells, akin to the Pantone database of colours, things might be different.

The European trade mark reforms, likely to come into force in 2016, envisage that the requirement for graphical representation will be removed. The removal of this need should make it easier to register smell (also referred to as scent or olfactory) trade marks, but we are unlikely to see a flood of them. The graphical representation requirement is not the only obstacle to their registration.

### EUROPEAN EXPERIENCE

Several applications for smell marks were made in the 1990s, typically addressing the requirement for graphical representation by providing a verbal description of the smell. For example, John Lewis applied for a registration for "the smell, aroma or essence of cinnamon" for furniture (UK Trade Mark Application No 2000169).

John Lewis's application failed, but some smell marks have made it onto the Community and UK trade marks registers. For example "the strong smell of bitter beer applied to flights for darts" (UK Trade Mark Registration No 2000234) and "a floral fragrance/smell reminiscent of roses as applied to tyres" (UK Trade Mark Registration No 2001416) were both registered in 1996. The former continues to be on the register. "The smell of fresh cut grass" for tennis balls achieved registration as a CTM in 2000 (CTM Registration No 428870), but has since lapsed due to non-renewal.

However, a 2002 European Court of Justice (ECJ) case marked a turning point, and no smells have been registered as Community or UK trade marks since. In Case C-273/00, the ECJ considered a request for a preliminary ruling made by the Bundesgerichtshof (German Federal Court of Justice). A German national, Ralf Sieckmann, sought a trade mark for a smell "balsamically fruity with a slight hint of cinnamon" in respect of a variety of services. The smell was represented by three methods: a verbal description, a chemical formula and the submission of a specimen of the smell.

The ECJ considered the essential requirements of the graphical representation requirement and held that signs that are not in themselves capable of being perceived visually, such as sounds and smells, can constitute trade marks, provided that they can be represented graphically. The ECJ ruled that graphical representation would need to be by means of images, lines or characters and be "clear, precise, self-contained, easily accessible, intelligible, durable and objective" (the so-called "Sieckmann criteria"). The requirement would not be satisfied by a chemical formula, a description in written words, the deposit of an odour sample, or by a combination of those elements. Mr Sieckmann's trade mark application failed.

While the requirement for graphical representation is set to be removed, it will nevertheless be required that a sign is capable of being represented on the register "in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor".

In 2005, a CTM application described by the words "smell of ripe strawberries", together with an image of a ripe strawberry, in respect of a variety of goods, such as soaps, stationery and underwear, was rejected by the Court of First Instance (Case T-305/04, Eden SARL).

That application failed not so much for the lack of graphical representation, but because the smell

*The graphical representation requirement is not the only obstacle to the registration of smell trade marks*

of a ripe strawberry might vary from one variety to another. As a result, the description was considered not to be sufficiently precise. The issue is not limited to strawberries. The perception of a smell described in words is subjective, and will vary from one person to the next. Until there is a clear, precise and unequivocal way of identifying and classifying smells, it is difficult to envisage the EU Intellectual Property Office (as OHIM will soon be renamed) or the UK Intellectual Property Office accepting applications for smell marks.

### FURTHER OBSTACLES

There are further obstacles to registration. First, the smell must be distinctive or must have acquired distinctiveness through use. In Decision R0711/1999-3, the OHIM Third Board of Appeal rejected “the scent or smell of raspberries” for engine fuels on the ground that the mark was not distinctive in relation to the goods concerned. Similarly, the application by John Lewis, referred to above, was rejected on the basis that the smell of cinnamon was not sufficiently distinctive in relation to furniture. According to the Hearing Officer in that case, “it is quite common for furniture to smell of polish which contains the perfume of various fragrances including cinnamon”, and John Lewis could not prove that distinctiveness had been acquired through use (Decision 0/024/01).

Second, the distinctiveness of the trade mark must not result from the nature of the goods themselves. An application to register as a UK trade mark the scent of Chanel No 5 perfume was rejected because the smell was considered to be the essence of the product. The same approach might be taken with other products that have a scent in order to make their use more pleasant, such as fabric softener or lemon-scented detergent, for example. Even paper or an eraser might have scent added to increase the product’s appeal to consumers; should such products be treated in the same way?

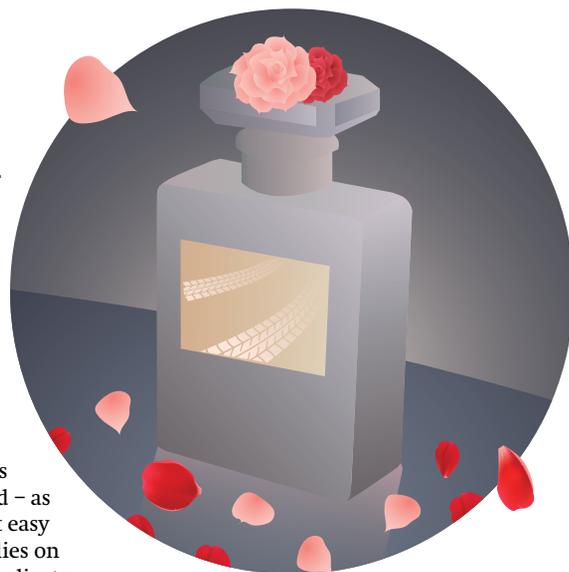
The difficulty arises that consumers of fragranced goods are unlikely to

attribute the origin of the products to a single trader based on the fragrance. A smell may be distinctive as a trade mark if it is added by the applicant to identify their goods (such as the smell of roses for tyres), rather than being an inherent or natural characteristic of the goods. The smell must be recognised by the public as indicating trade origin and – as Nestlé will attest – it is not easy to show that the public relies on non-traditional marks to indicate trade origin.

### US LEARNING

At first glance, it appears a number of smell marks have achieved registration in the US. However, these are mainly on the Supplemental Register, which lists those marks that are not inherently distinctive and have not (yet) shown acquired distinctiveness. To make it onto the Principal Register, the mark owner needs to show that the mark is actually used by consumers to identify the origin of the goods or services concerned – that it has acquired distinctiveness. Europe does not have an equivalent of the Supplemental Register; a mark that does not have sufficient inherent or acquired distinctiveness is simply not registerable.

In fact, only two smell marks have been able to progress to the US Principal Register: a registration for the “cherry scent” of “synthetic lubricants for high performance racing and recreational vehicles” (US Trade Mark Registration No 2463044), and a registration for “high impact fragrance primarily consisting of musk, vanilla, rose, and lavender” in relation to Moroccan oil’s “hair conditioners, namely curl creams,



hydrating styling creams, intense moisturising masques, and styling and finishing oils” (US Trade Mark Registration No 4057947).

The fact that these two marks have progressed to the Principal Register shows that smells can serve as origin identifiers – the owners of the marks will have had to produce substantial evidence of acquired distinctiveness to get them there. However, the tiny number suggests demonstrating acquired distinctiveness may be just as big a hurdle as the requirement for graphical representation has been.

### NO FLOOD TO COME

Consumers do not currently expect to discern the origin of goods or services by smelling them, and few examiners will be convinced that a smell mark is inherently distinctive. If an applicant is to succeed in showing acquired distinctiveness, it will need to educate the public to look to the smell as denoting the origin. This has been shown to be hard enough to do even with the shape of goods, let alone their smell. So, while the removal of the need for graphical representation might make it marginally easier to register smell marks, it will not open the floodgates. ■



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# How to be a blawger\*

\*blawg: n. a blog that focuses on legal issues



*Experienced web author Robert Cumming kicks off our masterclass on how to write well online – and why*

**J**ack Dorsey, one of the founders of micro-blogging website Twitter, described the company's naming process to the *LA Times*: "We came across the word 'twitter', and it was perfect. The definition was 'a short burst of inconsequential information.'"

Presumably, he then called his Trade Mark Attorney and arranged the appropriate clearance searches.

Since that moment in 2006, the micro-blogging site has grown rapidly and Twitter now has around 300 million users. LinkedIn has about 380 million. Whether it's a celebrity "breaking" the internet or a Trade Mark Attorney offering thoughts on

the latest case, blogging is now ubiquitous. Anyone can do it. But doing it well takes a little practice. Do it carelessly and you might inadvertently find your 15 minutes of fame turn into weeks of infamy. So why bother doing it at all?

Blogs – or "blawgs" – make IP law accessible. While there is no substitute for reading judgments to appreciate the nuances of a specific issue, in the world of the intangible, blogs can make a subject real. They talk about specific cases involving brands that we recognise in a context to which we can relate. They provide a bite-sized insight into how the law is applied, which complements our busy lifestyles.

## **REASONS TO WRITE**

The law is in a constant state of flux. New legislation and cases tug and stretch at the boundaries of what is permissible and what constitutes infringement. Reading about others' interpretation of the world is convenient, but immersing yourself in the detail and distilling that cognition into a blog is more likely to confer a professional advantage than glossing over the headlines. We're all permanent students of IP law and by writing about it we can increase our knowledge and boost the value of our personal brand.

And the rewards don't stop there. Networking is a key skill for a modern Trade Mark Attorney and

opportunities to impress can be scarce. As a digital manifestation of your brain, a blog keeps your mind sharp, which offers a huge marketing advantage, for instance creating conversation about an interesting legal issue.

Once you've finalised your piece, it can be incredibly satisfying posting it to your blog and then publicising it. It represents a lot of effort; you've improved your online profile and probably learnt a bit along the way.

But that is not the end of the journey. If you keep the momentum up those carefully composed posts can be built upon, improved and adapted so that the original article becomes a full-blown presentation leading to further opportunities. Soon you become an expert in your field.

## FINDING YOUR VOICE

Perhaps one of the most difficult aspects of blogging is to find your "voice" or writing style. Too formal and people may get bored, too colloquial or inconsistent and you could undermine your credibility. Using a muse, such as a simple yet enthusiastic superhero cat (see page 19), creates a level of accessibility that is well suited to blogging, but it takes real skill to achieve the delicate tonal balance between cheekiness and credibility.

A good rule of thumb is to write for an intelligent 10-year-old: someone who can grasp advanced concepts so long as they are explained in simple terms. Don't be scared to show some personality, either. People relate to people, and remember that on the internet there is an audience for everything.

Blogging takes time and, like any pursuit, the more you put into developing your skills, the more you will get out. It doesn't have to be a big commitment. Retweeting someone else's post on Twitter takes less than a minute. Finding an IP angle to a non-IP story and then offering a paragraph about your thoughts to a LinkedIn group might take slightly longer and work that grey matter a bit harder.

## BLAWGS TO WATCH

*Justia's BlawgSearch ([blawgsearch.justia.com](http://blawgsearch.justia.com)) lists no fewer than 383 active IP blogs. Here's a quick pick of the bunch to kick start your online exploration:*

- [IPKat, ipkitten.blogspot.com](http://IPKat, ipkitten.blogspot.com)  
The Kats have covered copyright, patent, trade mark, info-tech and privacy/confidentiality issues from a mainly UK and European perspective since 2003.
- [IPBiz, ipbiz.blogspot.com](http://IPBiz, ipbiz.blogspot.com)  
"Intellectual property news affecting business and everyday life" from patent lawyer Lawrence B Ebert.
- [DuetsBlog, duetsblog.com](http://DuetsBlog, duetsblog.com)  
Offering "Collaborations in creativity and the law", this US-based blawg hopes to bring together "legal and marketing types" and offers thoughts on a slew of topics including trade marks.
- [likelihoodofconfusion.com](http://likelihoodofconfusion.com)  
Another US blawg offering, described as "Ron Coleman's blog on trade mark, copyright, internet law and free speech".
- [Class 46, marques.org/class46](http://Class 46, marques.org/class46)  
"Enthusiasts" offer their thoughts on European trade mark law and practice.
- [SoloIP, soloip.blogspot.co.uk](http://SoloIP, soloip.blogspot.co.uk)  
With bloggers including ITMA members, this is a community discussion group for sole IP practitioners.
- [trademarkologist.com](http://trademarkologist.com)  
This blawg's stated goal is "to help you select a brand name or logo by providing insight on how others have selected and protected their brands" and "make you chuckle a few times" in the process. Powered by Stites & Harbison, PLLC.
- [Afro-IP, afro-ip.blogspot.co.uk](http://Afro-IP, afro-ip.blogspot.co.uk)  
News, information and comment on African IP law, practice and policy.

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We have access to the largest and most easily accessible archive of information in the history of civilisation. We have access to the broadest spectrum of opinions ever

known on pretty much every topic imaginable. If you can find the inspiration and time to blog, creatively and consistently, this demonstrates not only a willingness to embrace a challenge, but also the ability to form an opinion and support it with reasoned argument. For lawyers, those skills are essential. There is a lot of vapid content on the internet, but a good legal blog can seriously improve your professional credentials and will definitely help you stand out from the crowd. ■



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Robert has contributed to a number of legal blogs including IPKat, and is the originator of the IPIT blog at [robertcumming.eu](http://robertcumming.eu).



## TIPS FROM THE IPKAT

*Jeremy Phillips' IPKat blog is an acknowledged leader in the field and he provides this learning on online authorship from his own experience*

### SET YOUR OBJECTIVES

The important thing is to have a set of objectives before you start. Even if you are going to have to change those objectives as time goes on and as you discover what your readers care about.

### START OUT WITH AN ARCHIVE

Don't go live until you have an archive of 10 or 12 pieces. So when people go on the blog and look at a piece, they will discover there are other pieces they can look back at.

### MOVE WITH THE TIMES

To be an effective legal blogger you have to be constantly flexible. If a big issue comes up, which doesn't interest you but interests everybody else you have got to go with it. You have to engage. At IPKat, we feel that it is very important that we should always be seen as a place where people go if they want to engage with current issues.

### CONTROL COMMENTS...

What to do about readers' comments is very important. IPKat is very strict on moderation and we will not allow abusive, obscene or offensive comments onto the blog. To avoid accusations of stamping down on free speech, however, we have asked two other bloggers to act as arbitrators in the event that anyone complains that

we have not allowed a fair comment. We give the details of these people on the sidebar of the blog.

### BUT DON'T EXCLUDE THEM

They are difficult to deal with, but if you don't have comments, you may as well issue a newspaper. The point of social media is that it engages people and some of our most interesting or controversial blogs have had upwards of 100 comments. And these have provided some of the most useful reference sources for people working in a particular field at a later stage, which enriches the blog as a research resource. We have getting on for 10,000 searchable articles just based on reader comments now.

### AVOID ADVERTISING

We don't take advertising because we want to be free to criticise people who might be advertisers, and we don't advertise ourselves. We know that the best way of getting known is when somebody else cites you, or tells somebody else they must look at the blog.

### GIVE IT TIME

Always leave twice as much time to produce the blog as you think it is going to take you. Dealing with people is slow, and you will always get software crashing and technical problems. I would always recommend that people don't try to maintain a

blog along with their full-time job unless they can do it with other people, who can cover at times when they are busy.

### QUALITY IS KING

The main thing is quality. If your blog is interesting, good and reliable, people will come back to it again and again. At IPKat, we have rule that anybody on the team can take down and amend or delete anyone else's post if they are not happy with it. The object of the exercise is to produce a very, very good product that people really want to read and find useful. It only takes two or three poor blogs, one after another, for people to lose confidence in your product.

*Comments are difficult to deal with, but if you don't have comments, you may as well issue a newspaper*

# WRITING FOR THE WEB



*Content strategy and user experience expert Tim Tucker offers his advice for making the most of your internet presence*

## WATCH YOUR TONE

Blogs typically use a conversational style of writing, and they often focus on a particular specialism or area of interest. Adopt the same tone that you would use when speaking to people that are passionate about your interest or topic, and avoid formal language or jargon. Some blogs are more personal in approach, and publish a writer's thoughts, experiences and opinions. Beware of being too flippant though – remember that your clients and your colleagues may read what you are writing online.

## CHOOSE YOUR HEADLINE

The title of your post is effectively the headline of the piece. According to Copyblogger research, on average eight out of 10 people will read headline copy, but only two out of 10 will read the rest of the post. Make sure the headline is totally to the point and provides as much information on the content of the post as possible.

It is imperative that you optimise your content to ensure it gets indexed and ranked in search engines, such as Google. The title plays a vital role in ensuring that these search engines return the topic and content of your post in search results.

## TARGET YOUR CONTENT

Before you start typing, ask yourself: "Is my post useful, interesting or

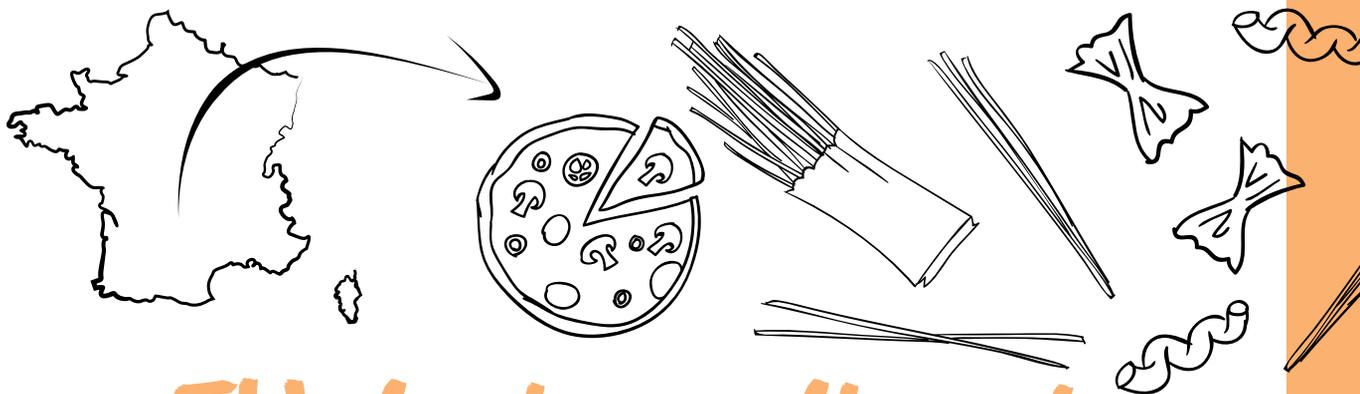
entertaining for my audience?" Try to stick to one topic when posting, as this ensures that the post doesn't go off the point.

## SHORT AND SCANNABLE

According to Tony Haile of attention measurement and monetisation company Chartbeat, the average website visitor spends less than 15 seconds on your site. As well as not staying long on your blog, the average reader also won't read much of it. Readers tend to scan content rather than read it word-for-word, and studies consistently show that the average person only comprehends about 60 per cent of what they read. To ensure your content is scannable, write shorter sentences and paragraphs, and include formatting like bulleted and numbered lists.

## TWO-WAY TOOL

Remember that blogs are designed to be interactive, where the flow of information is two-way between writer and reader. That 'comment' link after each story is an invitation to your readers to join in and discuss, and this provides a major way for you to create a community around your blog. Make it a focus to encourage comments on your posts. Identify which posts are more likely to generate a response, and don't forget to actively ask your readers for a response on topics that you think might kick-start a conversation.



# EU designs digest

*Ewan Grist has gathered a casebook of European design law judgments that may be of interest*

## FRANCE: THIRD-PARTY VALIDITY CONSIDERED

In *Via Del Gusto & Alfred Pacchiolo vs Bella Via, Antico Forno A Legna & Cramer Foods* (4 April 2014, Case 11/125564), the Paris Tribunal considered the validity of a Community design incorporating intellectual property belonging to a third party. The French distributor of fresh pasta and pizza products (the “Distributor”) accused its former Italian supplier (the “Supplier”) of infringing its Registered Community Design (RCD) for pizza packaging. The Supplier argued that the RCD was invalid because it incorporated an earlier Community Trade Mark registered and owned by the Supplier, as well as a picture, in respect of which the Supplier owned copyright.

Articles 25(1)(e) and (f) of Council Regulation (EC) 6/2002 (CDR) provide that a Community design must be declared invalid if a prior distinctive protected sign is used in the design without authorisation from the

rights holder, or if the design constitutes an unauthorised use of a work protected under copyright law. Referring to these provisions, the Tribunal held that although the Distributor had been allowed to use the Supplier’s trade mark in the course of trade, it was not authorised to acquire a monopoly of the trade mark through the registration of the RCD. The Tribunal also ruled that the picture incorporated in the RCD was eligible for copyright protection under French law because it fulfilled the “originality” criteria and because the Distributor had not been authorised to include it in the RCD. The RCD was therefore found to be invalid in its entirety, even though only certain elements belonged to the Supplier.

## BELGIUM: DESIGN FREEDOM DECISION

In *Smart Trike MNF PTE Ltd v Fun Belgium NV* (15 April 2015, IEFbe 1301), the Brussels Court of

Commerce found, in ‘fast track’ cessation proceedings on the merits, that an RCD for children’s tricycles was valid and infringed by a leisure retail and wholesale company. The Court found that the RCD merited a broad scope of protection because the design differed significantly from the existing design corpus, due to a combination of distinctive features. In addition, a large degree of design freedom was demonstrated with at least

eight design features being unconnected to a technical function (and hence these could be freely designed). In comparing the RCD to the Defendant’s tricycle design, the Court gave more weight to the similarities than to the differences, finding that the overall impression created on the informed user was the same. Also, the fact that the Defendant had obtained a more recent design registration (outside the EU) was deemed irrelevant to the finding of infringement. The Court granted injunctive relief throughout the EU under Article 83(1) CDR and also ordered a product recall from the market.

## THE NETHERLANDS: NOVELTY AND PRACTICALITY

In *Eichholtz* (14 August 2015, ECLI:NL:RBDHA:2015:9643), the District Court of The Hague considered in preliminary proceedings which prior designs should rightly be taken into account when assessing the novelty and individual character of an RCD. The dispute concerned the validity and infringement of an RCD for a coffee table. The prior art was for various jewellery designs. The Court found that the prior art was incapable of destroying the novelty or individual character of the RCD because it would not have been known to the circles specialising in the sector concerned with the RCD (in this case, table designers).

This decision is interesting in view of the recent controversial judgment from the General Court (GC) in *Group*

*A Community design must be declared invalid if a prior distinctive protected sign is used in it without authorisation*

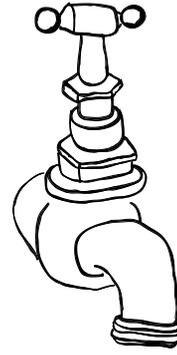


Nivelles v OHIM – Easy Sanitary Solutions BV (13 May 2015, T-15/13), in which the GC surprisingly distinguished between prior art eligible for a novelty attack and prior art eligible for an individual character attack. Unlike the Dutch court, the GC considered that all prior designs, irrespective of the type of product to which they were applied, could be considered for the purposes of assessing novelty, but only prior designs for the same type of product as that of the contested design could be considered for the purposes of assessing individual character. The GC’s decision is currently being appealed to the CJEU.

In *KOZ v Adinco* (20 February 2015, C/09/480095/KG ZA 14-1576), the District Court of the Hague held that various RCDs for a design for cable blocks for the wiring of cables registered by KOZ in 2006 would likely be invalid for lack of individual character over earlier RCDs, also filed by KOZ in 2005.

The small difference between the 2005 and 2006 RCDs was insufficient to create a different overall impression. Unfortunately for KOZ, the Court also considered it likely that the 2005 RCDs would be invalid for lack of individual character. The differences compared with an earlier German design were said to be solely dictated by their technical function, and therefore the 2005 KOZ RCDs were also invalid.

This judgment demonstrates the difficulty when designing a product which is practical to use, while also ensuring that the product is not merely functional and is sufficiently different from competing products in order to merit design protection. Furthermore, this case confirms that registering the design of a new generation of a product may be problematic where changes over the previous generation are only slight.



### ITALY: COPYRIGHT WITHOUT REGISTRATION

In *Flo v Mondo Convenienza Holding SpA et al* (16 June 2015, no. 7432/2015), the Court of Milan confirmed that the design of a bed can be protected under copyright as a work of industrial design, even if no relevant design registration was ever filed. The Court considered the reasoning of the ECJ in the *Flos v Semeraro* judgment (27 January 2011, C-168/09), in which the ECJ noted that “it is conceivable that copyright protection for works which may be unregistered designs could arise under other directives concerning copyright, in particular Directive 2001/29, if the conditions for that directive’s application are met, a matter which falls to be determined by the national court”. The Court confirmed that a correct reading of this decision would allow for the protection of an industrial design under copyright, regardless of whether it had been registered. It also confirmed that this interpretation was consistent with Article 5(2) of the Berne Convention, which ensures the enjoyment of copyright without the need for registration.

### SPAIN: SUBSIDIARY NOT SUPPORTED

In *Hansgrohe AG & Hansgrohe SA vs Grifería Tres, SA* (25 June 2014, 2804/2014), the Supreme Court considered which parties were entitled to recover damages for alleged infringement of an international design registration for a tap. The claim was originally brought jointly by Hansgrohe AG (the “parent company”), which owned the design registration, and its Spanish subsidiary Hansgrohe SA



*The Court ruled that a subsidiary does not become a licensee simply because its parent company owns a registered design*

(the “subsidiary”) before the Commercial Court of Barcelona. In the first instance decision, the Court found infringement and awarded damages to the design owner (ie the parent company) but rejected the standing of the subsidiary to be a co-claimant, as no licence had been granted to it by the parent company.

This first instance decision was appealed to the Court of Appeal by both the Defendant and the subsidiary (which sought to challenge the decision on standing). The Defendant’s appeal was upheld with the Court of Appeal finding that there had been no infringement and so no damages were payable to either the parent or the subsidiary.

Both the parent and subsidiary then appealed to the Supreme Court, arguing that there was an implied licence granted by the parent company to the subsidiary due to the relationship of the parties (the subsidiary was the parent company’s distributor in Spain). The parent and

subsidiary also argued that Article 13 of the Enforcement Directive (2004/48/EC), allowed injured parties to claim for damages suffered. The Supreme Court dismissed the appeal confirming the lack of standing of the subsidiary, given that no formal licence had been granted to it. The Court ruled that a subsidiary does not become a licensee simply because its parent company owns a registered design, even where the subsidiary is wholly owned by the parent company. Further, Article 13 of the Enforcement Directive refers exclusively to the rights holder and not to any other injured parties (“to pay the rights holder damages appropriate to the actual prejudice suffered by him/her as a result of the infringement”). Moreover, although Article 61.2 of the Spanish Design Law allows the licensees to take part in the infringement proceedings in order to seek damages, the Court considered that the subsidiary failed to prove that it was a licensee. ■



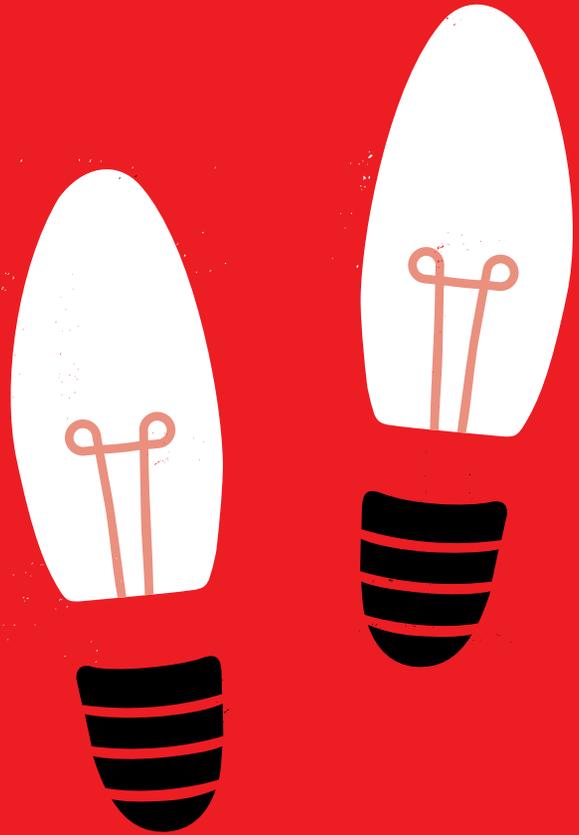
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Ewan wishes to thank Linda Brugioni, Elisabetta Bandera, Domien Op de Beeck, Benoît Lafourcade, Linda Brouwer, Nina Dorenbosch and José Ángel García-Zapata for their help.

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# PRESENTING TO THE PRESS

*Richard Hayward provides his best-practice advice for making the most of a media opportunity*

**G**etting quotations published in the press, seeing your face on television or hearing your firm mentioned on the airwaves are all great ways to boost the reputation of you and your firm. But how do you ensure you make the most of the opportunity your press officer has worked hard to secure, and what do you need to avoid?

## KEY MESSAGES

The first thing to remember is that you are in control of what comes out of your mouth. This presents an opportunity to not only get a name-check, but to contribute to

debate, be engaging and thought-provoking and convey key messages.

The whole purpose of making a press appearance is to get across a particular set of points to a captive audience – and you must go into an interview with those crucial messages well defined and prepared.

Don't overdo it, though; three messages is plenty. And I advise delivering them as soon as you can in the interview – you don't want to be left disappointed when the journalist or producer calls time before you've said what you wanted to.

Remember, also, that your key messages must be related to the topic of the interview – it's unlikely you'll be able to slip that cutting-edge

development at your firm into a conversation about the latest KitKat trade mark ruling, or that veering off topic will be welcomed.

## HAVE AN OPINION

Journalists and broadcasters are looking for something interesting from you as an expert. They want you to extend the debate, add a new perspective and break from convention. You must have an opinion and be clear in what you stand for. It's not a time for sitting on the fence – be confident in what you think; you're the expert.

However, don't say something you don't believe just to give a soundbite – you'll get found out down the line.

**Remember that, when speaking to a journalist, everything you say can be quoted. There's no such thing as 'off the record'**

## CONTROL THE CONVERSATION

Don't fear journalists. They aren't going to back you into a corner – after all, you aren't a politician defending a broken promise or the chief executive of a major company explaining a scandal.

However, a journalist might ask you a leading question, and you should be on your guard. Politicians are notorious for not answering the question asked, but this is a skill they have learned from extensive training and there are elements you can take from their behaviour.

Use the questions as prompts to give the answers and raise the points you want to get across – maintain control. If asked a direct question, do not answer yes or no; answer it with a well-rehearsed and relevant point that extends the debate.

Take a recent issue in our sector: plain cigarette packaging. You might be against plain packaging, but that does not mean you are in favour of people becoming seriously ill from smoking. A journalist may ask a leading question, such as, "Do you think that if this saves one life it will be worth it?" Here you need to turn it around and get your point across. Your answer might start with, "What's absolutely critical to remember is [insert key message]." That way you are both getting a point across and not getting drawn into saying something you don't want to.

Finally, remember that, when speaking to a journalist, everything

you say can be quoted. There's no such thing as "off the record".

## HOW TO PREPARE

Before any interview, it's vital you get to know the journalist and the publication or channel you are being interviewed for. You should tailor your messages accordingly and remember the journalist's name.

Then, write notes and prepare your key messages. Even if you are confident about your subject and it's a phone interview with a trade journalist you are familiar with, conducted from the comfort of your office or kitchen, notes will help you stay on point and get those three key messages across.

If you are appearing live on television it will be hard to have notes with you, but if you are doing over-the-phone interviews for print or radio, it's advisable to have some good, concise bullet points to hand.

## PERSONALITY AND PLAIN ENGLISH

Ensure your personality comes through – look and sound interested. Speak clearly and passionately to show you enjoy and are knowledgeable about your subject.

People are more likely to listen and take in what you say if you come across as enthusiastic.

Speak in short, concise sentences; you want to be easily quotable and find that soundbite. If you waffle, the journalist will get bored and will find it hard to find a suitable sentence to use from your conversation.

Although you are likely discussing legal and technical subjects, avoid jargon, technical terms, acronyms, Latin words and unnecessarily long words that are not part of people's everyday parlance.

Relating whatever you say to the real world and what it means to the audience is vital. When preparing, think about the impact of an issue for the viewer or reader, and express it in a way that will be understandable.

## ENJOY YOURSELF

My final point is to enjoy the experience and the publicity that being involved with the media can bring. I have seen positive media coverage change colleagues' standings in their field drastically. It's something that should be embraced rather than shunned.

But take on board the above advice, and if a journalist contacts you directly, please refer them to your media team. ■



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# BEYOND *TRADE MARKS*

*Summarising his recent presentation to members, Iain Connor takes us into less familiar legal territory*

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**T**he Intellectual Property Enterprise Court (IPEC) is proving to be a rich source of case law, allowing practitioners to give clear advice as to how the courts are likely to decide intellectual property infringement actions. In particular, IPEC's abridged procedure, cost caps and short trials mean that IP litigators are developing new strategies with IPEC at their heart; not least because, in IPEC, both liability and quantum are heard together (unlike in the High Court) and so we are finally getting to know what the court thinks "a case is worth".

## CONVOYED SALES

The case of Alfrank Designs Ltd v Exclusive (UK) Ltd & Anor [2015] EWHC 1372 (IPEC), 18 May 2015, shows how putting the right evidence of loss before the court results in a favourable damages award. IPEC assessed the damages to which the

Claimant, furniture wholesaler Alfrank, was entitled in respect of the infringement of its design rights in two dining tables.

The case is particularly interesting because Justice Hacon awarded additional damages in respect of "convoyed sales". Convoyed sales are products sold at the same time as the product about which the complaint has been made. Where a claimant can show that sales of the protected product drive sales of other "convoyed" products, damages for loss of profits on such convoyed products are also recoverable.

Here, Hacon J found that, as a result of the infringement, Alfrank had missed out on 20 per cent of the sales made by the Defendant and therefore it was entitled to the profit it would have made, not only on the dining tables, but also the convoyed goods sold with the tables. With regard to the remaining 80 per cent of sales of the infringing tables, he awarded a royalty of 25 per cent of

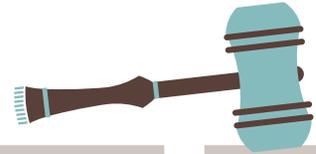
the Defendant's profits. In hard cash this amounted to a royalty of £100 per table.

## PROFITS RECOVERABLE

In Lumos Skincare Limited v Sweet Squared Limited & Ors [2015] EWHC 1313 (IPEC), 19 May 2015, we get to see why it is worth including all the parties in a supply chain as defendants in the action.

IPEC awarded just over £42,000 to the Claimant, assessed by way of account of profits, in this passing off case in relation to the Claimant's LUMOS cosmetic range.

A couple of interesting points arise. The first is the fact that some of the award related to goods invoiced before the date of the infringing activities. The second is that the Court took all the parties in the supply chain to be acting in common design and so included the profits made by each party in the supply chain in the account of profits. As the infringement was found to have



*Summary judgment is often seen as a risky strategy, because if you don't get judgment, the claimant can think that the prospects of success at trial are damaged*

taken place when the goods were put on the market in the UK, the US manufacturer said profits made by it on products invoiced before the date they were put on the market should be discounted.

However, the Court found that the passing off was as a result of the common design of all the parties in the supply chain, which enabled the goods to be sold in the UK, and so all the illicit profits made had to be accounted for.

### **SPEED WINS, BUT...**

One of the main advantages of IPEC is the speed of the justice. Often, delay caused by the court process is a real cause for concern for the parties to a High Court action. In *British Gas Services Ltd v Vanclare SE LLC* [2015] EWHC 2087 (IPEC), 17 June 2015, the Claimant tried to get a quick result in a revocation action before IPEC but was thwarted by the realities of the IPEC timetable.

UK courts hate “bifurcated” intellectual property actions. If there is an action to revoke the IP right – in this case a patent – whether as part of the defence or in the registry proceedings, courts usually make sure that the infringement action is either stayed completely or heard at the same time to ensure that any finding of infringement is on the basis of a valid right and consistent with the judgment on revocation.

Here, Justice Arnold said that the IPEC revocation case would not be any quicker than the High Court infringement action and so transferred the IPEC case to the High

Court so the actions could be heard together. Given that the patent had only five more years to run, any delay caused by bifurcation would be unjust to the patentee and so there was no reason to move away from the normal practice.

### **GOOD CASE, DON'T WAIT**

In the case of *Karen Davies Sugarcraft Ltd v Croft* [2015] EWHC 2035 (IPEC), 9 June 2015, IPEC granted summary judgment in relation to a registered design right infringement action about cake decoration moulds.

Summary judgment is often seen as a risky strategy because if you don't get judgment, the claimant can think that the prospects of success at trial are damaged. In this case, Hacon J made clear that the key question to be decided on a summary judgment application was whether there was a proper defence. In a reference to a famous Dickens character, Hacon J said it was “Micawberism”, and fanciful of the Defendant to think there was a defence. It was clear to him that the moulds alleged to infringe the registered designs incorporated designs that did not produce on the informed user a different overall impression from the protected moulds.

As is usual in IPEC, the judge was keen to stress this was a case in

which the Court could reach a view through the eyes of the user, without the benefit of expert evidence.

The lesson is that, if you have a good case, don't wait for trial; go for summary judgment.

### **EMPLOYEE TROUBLE**

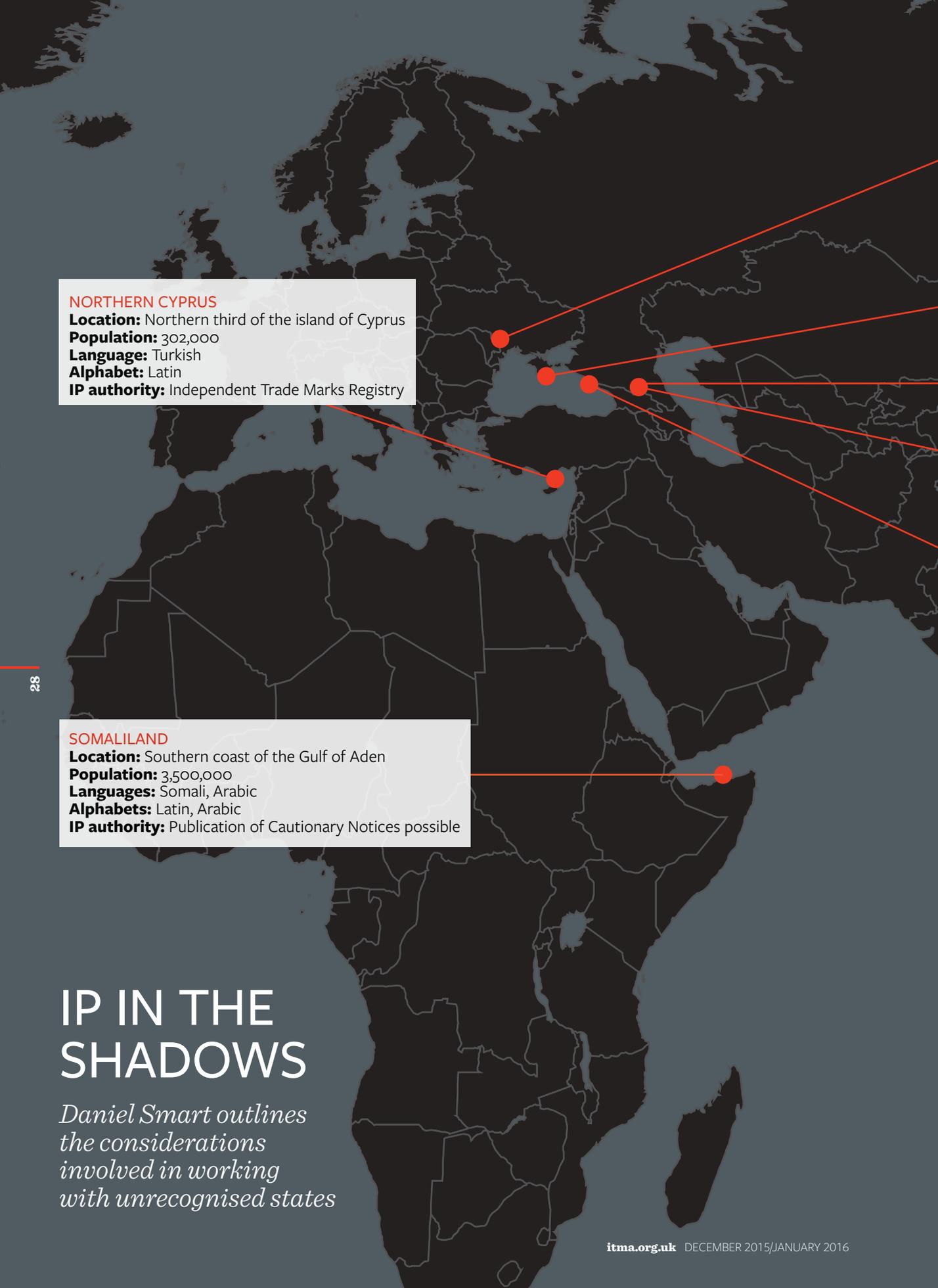
Finally, we get to see how IPEC regards the actions of a well-meaning but misguided employee in *Vertical Leisure Ltd v Poleplus Ltd* and another [2015] EWHC 841 (IPEC), 27 March 2015. This case demonstrates the potential problems when trying to defend individuals and companies in related actions.

In an earlier summary judgment, IPEC had found that the registration of certain domain names by a company employee amounted to passing off. In the subsequent case against the employee's company, IPEC held that the company was both vicariously and jointly liable in passing off. In what seems like quite a harsh decision, IPEC held that, because the employee was trying to protect the company, and the employee's job included registering domain names, the company was vicariously liable. Further, given the personal relationship between the employee and the sole director, the employee was acting with the full authority of the company. ■



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**NORTHERN CYPRUS**

**Location:** Northern third of the island of Cyprus

**Population:** 302,000

**Language:** Turkish

**Alphabet:** Latin

**IP authority:** Independent Trade Marks Registry

**SOMALILAND**

**Location:** Southern coast of the Gulf of Aden

**Population:** 3,500,000

**Languages:** Somali, Arabic

**Alphabets:** Latin, Arabic

**IP authority:** Publication of Cautionary Notices possible

# IP IN THE SHADOWS

*Daniel Smart outlines the considerations involved in working with unrecognised states*

### TRANSNISTRIA

**Location:** East bank of Dniester river between Moldova and Ukraine

**Population:** 505,000

**Languages:** Russian, Moldovan, Ukrainian

**Alphabet:** Cyrillic (for all three languages)

**IP authority:** Independent Trade Marks Office

### CRIMEA

**Location:** Peninsula in the Black Sea

**Population:** 2,000,000

**Languages:** Russian, Ukrainian, Crimean Tatar

**Alphabet:** Cyrillic (for all three languages)

**IP authority:** Russian trade mark registrations cover the 'Crimean Federal District' (disputed by Ukraine)

### SOUTH OSSETIA

**Location:** South Caucasus

**Population:** 52,000

**Languages:** Ossetian, Russian, Georgian

**Alphabets:** Cyrillic (Ossetian and Russian), Georgian (Georgian)

**IP authority:** No known Trade Marks Office at this time. Russian trade marks may be of use (Georgia considers its trade marks to cover South Ossetia)

### NAGORNO-KARABAKH

**Location:** South Caucasus

**Population:** 147,000

**Language:** Armenian

**Alphabet:** Armenian

**IP authority:** Considers Armenian trade mark registrations provide protection

### ABKHAZIA

**Location:** Eastern coast of the Black Sea

**Population:** 243,000

**Languages:** Abkhaz, Russian

**Alphabet:** Cyrillic (both languages)

**IP authority:** Independent Trade Marks Office (disputed by Georgian Trade Marks Office)

**F**rom time to time, clients or business colleagues may express interest in protecting trade marks in unrecognised states or states with limited recognition. Many such states will be *de jure* part of a recognised country but, on the ground, reality may differ.

Not that I've put my feet on the ground in these places. That would typically go against Foreign Office travel advice, but the fact the Government can provide limited to zero consular assistance is an admission of sorts that these areas

are not under the control of the recognised central government.

You may question the morality of filing in some of these states, which may exist through bloodshed and atrocities. Pragmatically, however, the requirements of your clients and colleagues may override these ethical considerations. And there are plenty of recognised countries in which trade marks are filed which have questionable human-rights records.

However, the purpose of this article is not to express support, or censure, for these unrecognised states. It is not designed to be controversial or cause

offence. It is neutral, and will look at some of the considerations you may like to take into account if you are active in the territories discussed.

### FIRST, WHY FILE?

While unrecognised, the territories covered on these pages are regarded as functioning states. While banking can be an issue, and there can be difficulties with remitting funds, entrepreneurs are doing business in them. They are, for the large part, stable, and therefore represent markets for trade mark owners. Import-export restrictions may make

## Patent Attorneys in Crimea can file directly at both the Russian and Ukrainian offices, an interesting commercial opportunity

them more challenging to penetrate, but sanctions have typically not been as stringent as for, say, Iran.

They may not always follow our standards. As they are not internationally recognised, Western powers can be reluctant to put pressure on them for fear of providing their governments with legitimacy. As such, they can be centres for counterfeiting. This means that having a local trade mark in your arsenal may prove useful, although it is accepted that it may be difficult to predict the outcome of any legal actions taken locally. On the flip-side, trade mark owners may need to be wary of being outed as owners of registrations in “rogue” states due to negative publicity.

### DEFINING THE SCOPE

There are actually quite a few states to consider, so I’ll define my terms. Kosovo and Taiwan are at least partially recognised (the UK recognises Kosovo) and could be considered “mainstream” trade mark jurisdictions, so will be skipped here. The ever-changing Islamic State will also be avoided.

Instead, I will take a tour to the Mediterranean, eastern Europe, the Caucasus and the Horn of Africa.

#### *Turkish Republic of Northern Cyprus*

One place in which many readers will have registered trade marks is Northern (Turkish) Cyprus. It has effectively been around since the 1970s. Although many IP databases I have used refer to this area as the Turkish Federated State of Cyprus,

it has not called itself this since it declared independence in 1983.

The Turkish Republic of Northern Cyprus is claimed by the Republic of Cyprus and is recognised only by Turkey. Nearly everything that travels there does so via Turkey. Mail is sent “Via Mersin 10, Turkey” and visitors usually fly in via Turkey (although it is now possible to cross the border with the south). Tourism is growing and includes a number of visitors from the UK – hopefully attracted by its climate and not the large number of products of uncertain provenance apparently sold along its beaches.

The Trade Marks Act in force mirrors that in force when the island was effectively split and is highly similar to the UK’s 1938 Act. This means registrations are granted for an initial seven years and service marks are not yet registrable.

#### *Pridnestrovian Moldavian Republic*

In eastern Europe, Transnistria declared its independence in 1990 as the Pridnestrovian Moldavian Republic while the Soviet Union was falling apart. It is not recognised by any UN country and is *de jure* part of Moldova. It borders Ukraine and there is also a border with Moldova proper.

The republic is a multi-ethnic state with Moldovans, Russians and Ukrainians almost equal in numbers (28-32 per cent of the population each). Russian, Moldovan and Ukrainian are official languages. All three are written using Cyrillic script, including Moldovan (essentially the same as Romanian), which is written using a Latin alphabet elsewhere.

Particular care should therefore be taken when filing Cyrillic script trade marks if protection in the three Cyrillic forms is required, in case there are differences between them.

It runs an efficient trade mark registration system through which certificates are issued in just a few months or less.

#### *Crimea*

In Crimea, the situation is different. Following its declaration of independence and brief period as an unrecognised state, it applied to become a part of the Russian Federation. Following its annexation in 2014, a transitional arrangement was put in place by the Russian IP Office to allow Crimean holders of Ukrainian trade mark registrations to re-register them in Russia.

Going forward, for Crimean locals and foreigners alike, it is governed by Russia, and registration is required in Russia or through an International Registration designating Russia. Ukraine considers Crimea territory under occupation. Theoretically, Patent Attorneys in Crimea can therefore file directly at both the Russian and Ukrainian offices, an interesting commercial opportunity for them that, in practice, they may not have taken up.

#### *Abkhazia*

Another post-Soviet “frozen conflict” arises in Abkhazia. *De jure* a part of Georgia, it claimed independence in 1999. It is recognised only by Russia, Nauru, Nicaragua and Venezuela.

A Trade Marks Office began granting registrations (with five-year

terms) in 2011 and this met with a furious reaction from Sakpatenti, the Georgian IP Office: "... in compliance with the Law of Georgia 'On Occupied Territories', the activity of the State Administration of Standards, Metrology and Certification of the so-called Republic of Abkhazia is illegal and any act issued by this office is considered void and does not give rise to legal consequences."

I am not sure if this has deterred potential applicants from filing in Abkhazia. The Russian energy giant, Gazprom, disclosed on its website that it owns Abkhazian registrations.

#### South Ossetia

The political situation in South Ossetia is very similar to Abkhazia, although it is unclear if a Trade Marks Office is operational yet. I understand regulations were passed in August last year to set up a Committee for Standardization and Metrology of the Republic of South Ossetia. The practicalities involved in running a Trade Marks Office may have meant this has not got off the ground. South Ossetia has a very small population. With a population nearly five times as large, Abkhazia has only two Patent Attorneys.

#### Nagorno-Karabakh Republic

Another unrecognised part of the Caucasus, the Nagorno-Karabakh Republic does not operate a Trade Marks Office. However, I have previously been advised by its Ministry of Economic Development that an Armenian registration would be legal in the Nagorno-Karabakh Republic, too. This would be despite

the fact that Armenia does not officially recognise the state.

In fact, it is unrecognised by any UN member and *de jure* is a part of Azerbaijan.

#### Somaliland

In Africa, a state that has come about by virtue of a completely dysfunctional "mother country" is Somaliland. Formerly a British protectorate, it received its independence on 26 June 1960. Five days later, as scheduled, it merged with the former Italian Somaliland to form Somalia.

Since the collapse of the Somali state, a government has been established in Somaliland, which asserts its pre-merger position as an independent state.

It is constitutionally obliged to follow laws previously promulgated by Somalia prior to its declaration of independence, provided they do not conflict with Sharia law. This includes trade mark legislation. However, there is no Trade Marks Registry and Cautionary Notices are being published instead.

It is believed that action for passing off could be undertaken under the inherited Civil Code of 1974, taking note of Article 176, which states that "a person who, without just cause enriches himself to the detriment of

another person is liable, to the extent of his profit, to compensate such other person for the loss sustained by him".

#### **EYES WIDE OPEN**

While we are largely in an era of rapid globalisation, and are forging ahead with harmonisation, in some regions we can find the world being fractured into smaller pieces. For example, the Republika Srpska (the Serb-governed part of Bosnia-Herzegovina) and regions in eastern Ukraine may have the wherewithal to go it alone and establish themselves even without international community support (albeit they could have the unofficial support of at least one neighbouring country). For all these unrecognised states, it may be worthwhile obtaining protection in the *de jure* country (although for Somalia this is not currently possible) as well as covering the unrecognised state in case the global community does offer some form of public recognition.

As trade mark professionals, we must keep an eye on this fragmentation and consider its impact. If we do not, the trade mark owners we represent may find that the geographic coverage of their trade marks is not quite as comprehensive as they think. ■



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# AN ESSENTIAL QUESTION

*Gill Grassie dives into a decision that throws doubt on the concept of EU trade mark co-operation*

**T**he Court of Justice of the European Union (CJEU) recently delivered its ruling in *Diageo Brands BV v Simiramida-04 EOOD* (C-681/13), a case concerning parallel imports of Johnnie Walker whisky from Georgia into Bulgaria. The dispute stemmed from the import of 12,096 bottles of genuine, branded Johnnie Walker whisky into Bulgaria by Simiramida. The bottles had originally been placed on the market by Diageo, the brand owners outside the EEA. Diageo had not consented to the imports into the EEA and it had the goods seized upon entry by the Bulgarian authorities as illegal parallel imports. Simiramida appealed against the seizure. After the order was initially lifted, Diageo appealed. Nonetheless, around a year later the goods were ultimately released. Diageo then brought proceedings in the City Court of Sofia, Bulgaria, alleging trade mark infringement. That court held that Diageo's rights in respect of the whisky had been exhausted by virtue of the Diageo-branded bottles having been placed in the market outside the EEA with Diageo's permission. The infringement action therefore failed. The Sofia City Court, in making its decision, indicated that it had done so because it was bound by an interpretative decision – *Vårhoven kasatsionen sād (VKS)* – of the Supreme Court of Bulgaria.

Diageo did not appeal the first instance decision and Simiramida then sued Diageo in the Netherlands, seeking recovery of an alleged loss

of €10 million stemming from the “unlawful” seizure.

## CJEU STEPS

Diageo argued in defence that the Sofia City Court decision should not be recognised in the Netherlands as it was manifestly contrary to public policy there, in terms of Article 34(1) of Regulation 44/2001 (now Article 45(1)(a) of the recast Brussels Regulation 1215/2012). It argued that the court had misapplied EU law, as the VKS interpretative decision was vitiated by substantive error and also by its failure to refer questions to the CJEU for a preliminary ruling. After the Amsterdam district court accepted these arguments and dismissed the case, Simiramida appealed successfully to have the Bulgarian judgment recognised. At that stage, Dutch Supreme Court the Hoge Raad asked for a preliminary ruling from the CJEU on whether or not the Bulgarian ruling ought to be recognised in the Netherlands. On the face of it, that ruling seems to misapply the Trade Mark Directive (2008/95/EC), as interpreted (in its former guise as Directive 1989/104) in existing ECJ jurisprudence where it is clear that parallel importers cannot rely on the exhaustion of rights doctrine in circumstances where the products have been imported into the EEA without the trade mark owner's consent. Nevertheless, the CJEU ruling was to the effect that the Bulgarian Court's judgment should indeed be recognised in the Netherlands. At first glance, this judgment seems somewhat surprising, as its effect is to recognise a decision that is clearly a serious misapplication of EU law.

## ANALYSIS

It is important to point out that the CJEU stopped short of endorsing the



substance of the judgment of the Bulgarian court. Rather (and perhaps deliberately) it refused to stray beyond ruling that the judgment should be recognised. According to the CJEU, recognition could only be refused if the judgment was manifestly contrary to public policy in the Member State in which recognition is sought, and not solely on the basis that the court in the Netherlands considered the Bulgarian court to have misapplied EU law.

Clearly, it is vitally important that the judgments of other Member States are respected, mutually recognised and enforced in other EU courts, save in exceptional

*It is surprising that a party that was so clearly and manifestly correct at first instance ended up losing so comprehensively*

circumstances. The CJEU makes the valid point that a judgment should not be disregarded just because the court asked to recognise it would have decided differently. Instead, the decision would need to infringe a fundamental principle and be at variance to an unacceptable degree with the legal order of, in this case, the Netherlands. However, the Bulgarian judgment was not just at variance with Dutch national law but also with harmonised EU trade mark law. It would, it seems, not just be the Dutch court that would decide the point differently, but every other court in the EU, including (ironically) the Bulgarian court itself. This is apparent given the first question that the Hoge Raad asked the CJEU was as follows: “Must article 34(1) of the Regulation (EU) No 44/2001 be interpreted as meaning that that ground for refusal is also applicable in a case where the decision of the

court of the member state of origin is manifestly contrary to EU law and that fact has been recognised by that court?” This wording suggests that the Bulgarian court only made its decision because it felt bound by the higher court’s decision on interpretation, which it acknowledged was wrong.

In summary, in its decision, the CJEU is saying that a court in one Member State cannot refuse to recognise the judgment of a court in another Member State simply because the judgment was, or contained a misapplication of, its national law or EU law, provided the law in question is not an “essential rule” of EU law.

But how is what is “essential” decided? If a misapplication of the clear provisions of the harmonised Trade Mark Directive would not satisfy the test, then what would? One might argue perversely that recognition of a judgment of a foreign court that has knowingly misapplied EU law

is in itself manifestly contrary to public policy in the State that is being required to recognise the judgment – and throughout the EU for that matter. It is relatively easy to understand why a misapplication of a principle of national law, as yet unharmonised, might not meet the exceptional “manifestly contrary to public policy” test. However, if the principle is one which has been harmonised in EU law and based on a Directive as well as settled EU and national case law, and which could have a direct effect on the function of the EU internal market, should it not be capable of qualifying?

## PRACTICAL IMPACT

The CJEU has not endorsed the substance of the Bulgarian court’s decision. It remains the position under EU law that placing branded goods on the market outside the EEA where the trade mark owner does not consent to them being placed on the market in the EU will not exhaust a trade mark owner’s rights in respect of those goods within the EEA.

Nonetheless, it is surprising that a party that was so clearly and manifestly correct at first instance ended up losing so comprehensively. This may undermine confidence in a purportedly harmonised EU-wide system when basic principles can be ignored just because a national court got it wrong. Following this case, judgments directly in contravention of clear principles of EU law may still be required to be recognised throughout the Community, regardless of how universally accepted misapplication might be.

As a result, trade mark owners may be more reluctant to bring infringement actions or seize imports in less frequented EEA jurisdictions, particularly newly-acceded states which don’t have a reliable track record of dealing with exhaustion of rights and EU IP issues. Forum shopping may become more frequent, with due diligence of the court systems and history of the importing states being more key to decisions on where to bring action. But it will not always be possible to sue somewhere other than the importing state, so the options may be stark – to sue or not to sue. Meanwhile, rights owners who spend time and money devising and protecting logos and brands may be disappointed that the rights they acquire are not considered important enough to merit protection from judgments in EU states which fail to apply basic principles of EU law. ■



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# NO MORE DELHI DEFAULT

*Adarsh Ramanujan explains how the Supreme Court of India has recently put a dampener on forum shopping*

**T**hose who are familiar with IP enforcement in India would generally be aware that the Delhi High Court is preferred for IP enforcement, especially for trade mark and copyright enforcement. The Delhi High Court is reasonably well known for its relatively swift docketing and its one-day *ex parte* injunctions for alleged infringement. In the specific context of trade mark and copyright enforcement, a special rule of jurisdiction created by law has enabled more disputes to be filed before the Delhi High Court than any other court in India.

However, the recent judgment of the Supreme Court of India in *Indian Performing Rights Society Ltd v Sanjay Dalia & Anr*<sup>1</sup> fundamentally changes this litigation strategy. While filing predominantly in the Delhi High Court may have enriched that particular court's knowledge and experience in such matters, the Supreme Court's judgment highlights how this litigation practice results in defendants located in other jurisdictions being impermissibly inconvenienced.

## KEY QUESTION

The appeal before the Supreme Court of India was an IP enforcement action

before the Delhi High Court, where all parties concerned were headquartered outside Delhi, but had branch offices in Delhi. The question presented before the Supreme Court was whether Section 62 of the Copyright Act, 1957 and Section 134(2) of the Trade Marks Act, 1999 permits such a dispute to be initiated in the High Court of Delhi. These provisions create a special and additional rule of jurisdiction, permitting trade mark and copyright holders to initiate enforcement actions in the jurisdiction where they reside, carry on business, or personally work for gain. This contrasts with the general rules of jurisdiction, whereby emphasis is on the location of the defendant or where the cause of action arose.

## RULING

The Supreme Court of India clarified that the aforesaid special rules were enacted for the sake of convenience of plaintiffs, rather than with the intention to cause inconvenience to defendants. It was created because authors/right-holders may find it difficult to enforce their IP rights on account of financial constraints in cases where the defendant may be residing elsewhere than the plaintiff's place of residence or business, or when the cause of action

(the act of infringement) may be occurring entirely within a third jurisdiction within India.

On the other hand, IP holders who may not necessarily suffer from such constraints may have offices/branches in several locations within India. In this situation, the choice of one location over another is not intended to be remedied by the law in question. Rather, this would potentially result in inconvenience for the defendants, without necessarily catering to the objective of the relevant laws.

Accordingly, the Supreme Court of India clarified that the aforesaid special rule should indeed be construed narrowly and concluded the following:

1. A trade mark or copyright enforcement suit can be filed in the jurisdiction in which the headquarters of the plaintiff is located.
2. A trade mark or copyright suit cannot be filed at a place merely because a plaintiff has a subordinate office (or branch office) in that jurisdiction. This rule has three exceptions:
  - a. If there is proof that the whole or part of the cause of action arose in that jurisdiction of the subordinate office (infringing act).
  - b. If the defendant resides or the defendant's principal office is in the jurisdiction of the plaintiff's subordinate office.
  - c. If the defendant's subordinate (or branch) office is located in that jurisdiction and if there is proof that the whole or part of the cause of action arose in that jurisdiction (infringing act).

### E-COMMERCE IMPACT

The decision does not directly deal with infringement in the digital and e-commerce space. In case of

infringements through websites (eg domain name infringement, online sale of infringing goods), prior decisions have clarified that a plaintiff can show territorial jurisdiction of a forum by proving that the defendant "purposefully availed" itself of the jurisdiction of the forum court.<sup>2</sup> For instance, a plaintiff in India can prove this requirement by establishing that the defendant's acts show an intent to conclude a commercial transaction with website users in that jurisdiction and that the specific targeting of the forum state by the defendant resulted in an injury or harm to the plaintiff within the forum state.

There is also the question of whether a plaintiff's website can be used to prove existence of jurisdiction in the forum state. Again, the Delhi High Court did not deal with this issue in the present case, though in the earlier judgment of *World Wrestling Entertainment v Reshma Collection*<sup>3</sup>, it was decided that where customers from within the forum state purchase or intend to purchase something from the website, by placing an order on the website within that forum state and initiating the transfer of payment from within that forum state, arguably, the plaintiff "carries on business" in that forum state "to a certain extent".<sup>4</sup> Whether this confers jurisdiction on a court in the forum state would depend on the facts.<sup>5</sup>

As per an earlier Supreme Court decision, the mere fact that a corporation's "goods are being sold at a place would thus evidently not mean that it carries [on] a business at that place"<sup>6</sup> and is insufficient to confer jurisdiction; instead, an "essential part" of the business must take place in that jurisdiction.

Nothing in the latest decision in *Indian Performing Rights Society Ltd v Sanjay Dalia & Anr* suggests that it intends to affect these principles from the above cases.

### CONCLUSION

The present state of affairs in terms of seeking enforcement actions in Delhi by simply ensuring the presence of a subordinate office in Delhi will have to come to a halt. Plaintiffs will now have to evaluate jurisdiction as an important factor in formulating their litigation strategies, rather than simply assuming the possibility of a suit in the Delhi High Court. This decision may effectively "decentralise" trade mark and copyright enforcement. ■

- 1) *Indian Performing Rights Society Ltd v Sanjay Dalia & Anr*, 1 July 2015 (Supreme Court of India, Civil Appeal Nos. 10643-10644 of 2010).
- 2) *Banyan Tree Holding (P) Limited v A Murali Krishna Reddy*, 23 November 2009 (High Court of Delhi, CS (OS) 894/2008).
- 3) 15 October 2014 (Delhi High Court, FAO (OS) 506/2013).
- 4) *Ibid.* paragraph 21.
- 5) *Ibid.* paragraph 22.
- 6) *Dhodha House v. SK Maingi*, 2006 (9) SCC 41, paragraph 47.



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# Considered answers on “impulsive”

Commercial realities were recognised in this reputation case, reports Chris Morris

This case concerns questions referred to the Court of Justice of the European Union (CJEU) by the Municipal Court of Budapest in Hungary, regarding Community Trade Marks (CTMs) with a reputation, and the geographical extent of that reputation.

## BACKGROUND

The Applicant, Iron & Smith, applied to register a figurative trade mark in Hungary incorporating the words “be impulsive”. Unilever opposed on the basis of, among other things, its earlier CTM for IMPULSE.

Unilever was unable to prove that its IMPULSE sign was widely known in Hungary. However, the Hungarian Office found that advertising and sales in the UK and Italy meant that the reputation of the CTM had been proved in a “substantial part” of the Union. It found that use of the “be impulsive” sign, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or repute of Unilever’s earlier right.

Iron & Smith appealed, primarily complaining that a reputation had been established on the basis of a five per cent UK market share and 0.2 per cent Italian market share.

The referring court found that the CTM Directive (Directive 2008/95/EC) does not offer any indication as to the

relevant geographical territory within the EU in order to establish a reputation. Nor was it clear whether, even if a mark does have a reputation, use by a third party could take unfair advantage of, or be detrimental to, that reputation or distinctive character if the mark is unknown in the Member State in question.

The Municipal Court elected to stay proceedings and make a referral to the CJEU.

## CJEU QUESTIONS

1. Is it sufficient, for the purposes of proving that a CTM has a reputation within the meaning of Article 4(3) of the Directive, for that mark to have a reputation in one Member State, including where the national trade mark application which has been opposed on the basis of such a reputation has been lodged in a country other than that Member State?
2. May the principles laid down by the court regarding the genuine use of a CTM be applied in the context of the territorial criteria used when examining the reputation of such a mark?
3. If the proprietor of an earlier CTM has proved that that mark has a reputation in countries other than the Member State in which the national trade mark application has been lodged – which cover a substantial part of the territory of the EU – may he also be required, notwithstanding that fact, to adduce

conclusive proof in relation to that Member State?

4. If the answer to question 3 is no, bearing in mind the specific features of the internal market, may a mark used intensively in a substantial part of the EU be unknown to the relevant national consumer and therefore the other condition for the ground precluding registration in accordance with Article 4(3) of the Directive not be met, since there is no likelihood of detriment to, or unfair advantage being taken of, a mark’s repute or distinctive character? If so, what facts must the CTM proprietor prove in order for that second condition to be met?



*Advertising and sales in the UK and Italy meant that the reputation ... had been proved in a ‘substantial part’ of the Union*

## COURT ANSWERS

The Court dealt with the first three questions together, as they concern the conditions required for a CTM to be regarded as having an EU reputation.

Referring to its earlier decision in PAGO (C-301/07) the Court confirmed that: “reputation” assumes a certain degree of knowledge among the relevant public, which must be considered to be reached when the CTM is known by a significant part of the public concerned.” Taking into account all relevant factors, including “market share ... the intensity, geographical extent and duration of its use, and the size of the investment made”, the reputation condition is fulfilled when a CTM has a reputation in a significant part of the Community which “may, in some circumstances, correspond to the territory of a single Member State”.

If an EU reputation is established, the Court continued, the proprietor is not required to provide evidence of a reputation in the specific Member State in which the opposed mark has been filed. The question of genuine use is separate and not required for a finding of reputation. The answer to the first three questions, therefore, is:

If the reputation of an earlier Community mark is established in a substantial part of the territory of the European Union, which may, in some circumstances, coincide with the territory of a single Member State, which does not have to be the State in which the application for the later national mark was filed, it must be held that that mark has a reputation in the European Union. The criteria laid down by the case law concerning the genuine use of the CTM are not relevant, as such, in order to establish the existence of a ‘reputation’ within the meaning of Article 4(3) thereof.

On the fourth question, where the relevant public in the Member State

concerned does not know the CTM, no link between it and use of the later mark will be made. Thus, unfair advantage cannot be taken, nor will the use be detrimental to the earlier mark. However, if a commercially significant part of the relevant public in the Member State is familiar with the CTM then, subject to a global assessment, the relevant link, and consequent injury, may occur. The answer to the fourth question is, where the CTM proprietor has a reputation in the EU but not in the individual Member State concerned:

The proprietor of the CTM may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar

with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors ... either actual and present injury to its mark, for the purposes of that provision or... a serious risk that such injury may occur in the future.

## AUTHOR COMMENT

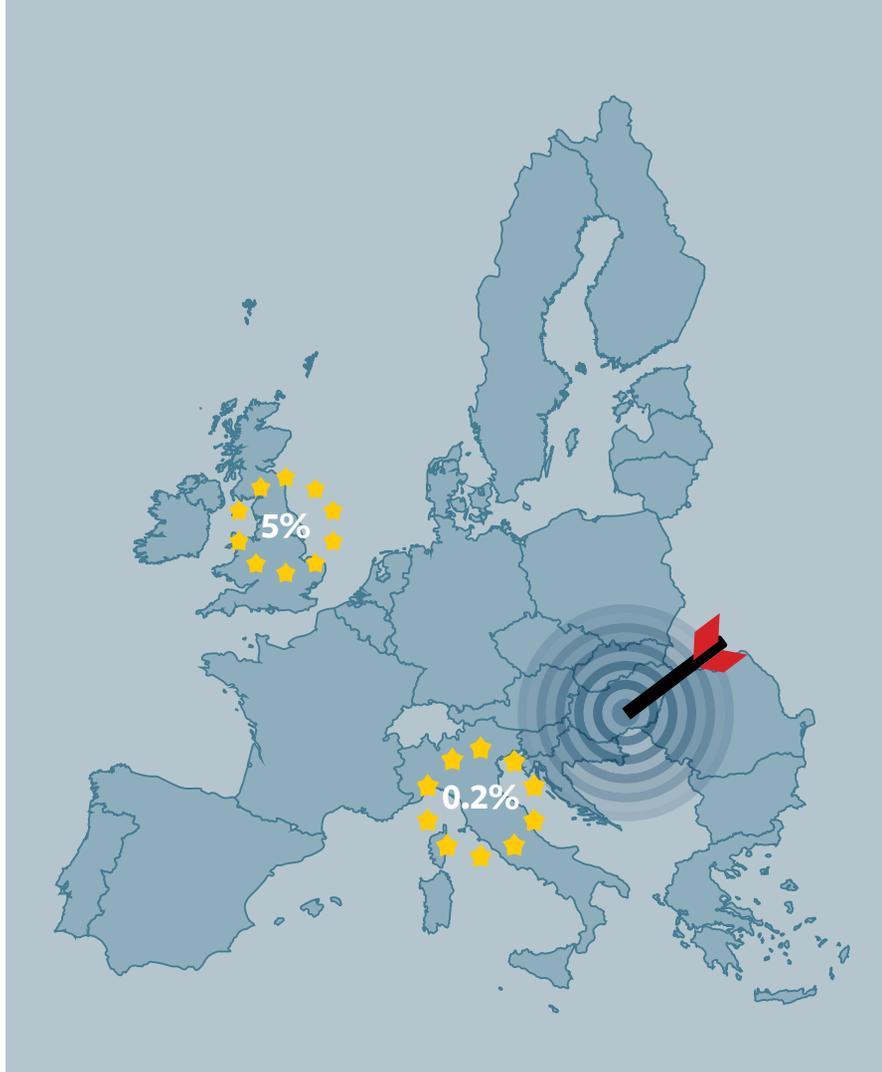
The answers are consistent with the Court’s earlier decisions. It allows right holders to rely on a reputation established in the EU (preserving the CTM’s unitary character) while maintaining the need for some recognition in the Member State at issue. Thus, actions are grounded in commercial reality rather than a legal construct.



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# EU offers clarification

Joel Smith gives a taste of the latest decision on KitKat

**T**he Court of Justice of the EU (CJEU) has recently clarified the position on shape marks, finding that a shape mark will be precluded from registration under Article 3(1)(e) of Directive 2008/95/EC if there are grounds for refusal of registration that are fully applicable to the shape at issue. In assessing distinctive character, the Court found that the relevant public must perceive the shape as exclusively designating origin.

## BACKGROUND

This case arose from Nestlé's application on 8 July 2010 to register the KitKat chocolate bar shape shown opposite as a UK trade mark for various goods in class 30.

The application was opposed by Cadbury and the case was heard by Mr Justice Arnold in the High Court, on appeal from the UK Intellectual Property Office (UK IPO).

The shape had three essential features, as follows:

- 1) The basic rectangular "slab" shape;
- 2) the presence, position and depth of the grooves dividing the bar into "fingers"; and
- 3) the number of the grooves which, together with the bar's width, determined the number of fingers.

Article 3(1)(e) of Directive 2008/95/EC sets out the exclusions for registration of shape marks. Arnold J found that feature 1 resulted from the nature of the goods themselves and therefore contravened Article 3(1)(e)(i) of the Directive; and that features 2 and 3 were necessary to obtain a technical result and contravened Article 3(1)(e)(ii). Arnold J referred three questions to the CJEU in relation to the interpretation of the Directive.

## CJEU DECISION

Question 1: in order to establish that a trade mark has acquired distinctive character, is it sufficient for the applicant to prove that a significant proportion of the relevant class of people recognised the mark and associated it with the applicant's goods, in that, if they were asked to consider who marketed the goods bearing the mark, they would identify the applicant; or must the applicant prove that a significant proportion of the relevant class of people rely upon the mark (as opposed to any other marks that may also be present) as indicating origin of the goods?

The CJEU found that the applicant must prove that the relevant class of persons perceive the goods and



services as designated exclusively by the mark applied for, as opposed to any other mark that might also be present. It is of note that the CJEU used the word “perceive”, as opposed to “rely upon”. These words do not have the same meaning in trade mark law and it is a matter of debate as to whether the CJEU actually answered the question referred on distinctiveness. The CJEU’s finding may be unhelpful to Nestlé as, in the case of the KitKat bars, this means that people should perceive the shape applied for (which does not have the KitKat logo embossed on it) as indicating origin in its own right.

Question 2: is registration of a shape consisting of three essential features (of which one results from the nature of the goods themselves and two are necessary to obtain a technical result) precluded under Article 3(1)(e)(i) and/or Article 3(1)(e)(ii)?

On this point, the CJEU ruled that a trade mark shall be precluded from registration in the situation referred, provided that at least one of these grounds for refusal (a shape resulting from the nature of the goods themselves or a shape being necessary to obtain a technical result) is fully applicable to the shape at issue. Therefore, when shapes have multiple essential features that make up the shape as a whole and one of these features falls foul of the shape mark exclusions, the mark could potentially still be registered provided that all of the other features do not fall foul of the same exclusion.

Question 3: should Article 3(1)(e)(ii) be interpreted as precluding registration of shapes that are necessary to obtain a technical result with regards to the manner in which the goods are manufactured, as opposed to the manner in which the goods function?

## *The CJEU decision on acquired distinctiveness is not clear-cut and may require a further reference to the CJEU*

The Court ruled that Article 3(1)(e)(ii) should not be interpreted as applying to the manner in which the goods are manufactured. The Hearing Officer in the UK IPO had previously held that Article 3(1)(e)(ii) embraced both kinds of technical result and there was nothing in the wording of the Directive which limited it to the function of the goods. The CJEU clarified that the technical result exclusion only applies where the shape is necessary to achieve a technical result, not where it was merely necessary to obtain a technical result with regard to the manner in which the goods were manufactured.

The CJEU was keen to emphasise the public policy rationale for the grounds of refusal of shape marks

as set out in Article 3(1)(e) of the Directive, referencing its previous judgments in Hauck (C-205/13) and Lego (C-48/09 P). The aim is to prevent monopolies over technical solutions or functional characteristics that users are likely to seek in the goods of competitors. The grounds of refusal serve to prevent an exclusive and permanent right (a trade mark) extending indefinitely the life of other rights that the EU legislature has made subject to a limited period.

### **FUTURE DIRECTION**

This decision is a useful addition to the limited body of case law concerning 3D shape marks. However, the CJEU’s decision on acquired distinctiveness is not clear-cut and may require a further reference to the CJEU.

If the trade mark application is ultimately refused by the High Court, it is of note that Nestlé will continue to have protection for the shape of its KitKat bars by way of its Community Trade Mark (CTM) for the same shape, albeit the CTM does not extend to “chocolate”. We await the decision of the High Court to see if Nestlé will be permitted to extend its existing monopoly for the shape of the four-fingered bars by the addition of a UK national mark to its portfolio.

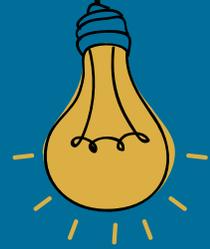
### **The KitKat chocolate bar shape**



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# No joy for Gold Crest

The Court took a dim view of Mighty Bright arguments, writes Dr Antje Gruneberg

**A**ccording to OHIM and the General Court's findings, the word mark MIGHTY BRIGHT indicates the properties of the goods for which registration was sought by Gold Crest LLC. In fact, OHIM found that the reading lights and bulbs for which the word mark was registered "were capable of emitting powerful, strong light, thus eclipsing any impression that the sign applied for could indicate a commercial origin".

## BACKGROUND

The background of the case can be summarised quickly. Gold Crest LLC filed with OHIM an application for the Community word mark MIGHTY BRIGHT for portable clip-on reading lights and light bulbs. The examiner rejected the application arguing that the mark does not have any distinctive character for at least the English-speaking part of the

Community (Article 7(1)(b) and Article 7(2) Council Regulation (EC) No 207/2009). Gold Crest's appeal to the Second Board of Appeal failed. Thus, Gold Crest applied for annulment of OHIM's decision arguing that the mark applied for had distinctive character because the combination of MIGHTY and BRIGHT is grammatically "wrong" and thus unusual; the correct grammatical use would be MIGHTILY BRIGHT. Further, in Gold Crest's view, the mark has acquired distinctiveness through use, and finally, OHIM's decision shows an abuse of discretion and infringement of the principle of equality considering the various other cases in which similar trade marks were registered.

The General Court rejected all three pleas and upheld OHIM's decision. As to the word mark's lack of distinctive character, the General Court found that "mighty bright" as an expression "immediately informed the relevant public" that the goods covered by the word mark are "powerful, bright lights and light bulbs". The semantic content of the words are synonymous and their juxtaposition seems to be a duplication. Even though the word combination does not comply with grammatical rules, "the designation 'mighty bright' does not deviate

enough from everyday language". The descriptive message that is inherent in the word combination remains.

Denying distinctiveness through use, the General Court held that the material presented by Gold Crest, eg internet search results and two consumer reviews, cannot show a perception of the consumer which indicates a commercial origin of the word mark. In fact, respective online reviews from just two customers "who are familiar with the applicant's goods" do not qualify as proof for distinctiveness through use.

Finally, the General Court dismissed the plea alleging an abuse of discretion and infringement of the principle of equality arguing that (almost) all of the trade mark registrations referred to by Gold Crest cover different goods and, thus, are to be considered non-comparable cases.

## CURRENT CASE LAW

It is interesting to the author, though, that the General Court admitted that the trade mark registrations MIGHTYBULB for 'light bulbs' and MIGHTY for 'apparatus for lighting' bear a similarity to the present case. However, these cases do not sufficiently support Gold Crest's plea, since the applicable case law would, nowadays, not allow registration of said trade marks.

*Online reviews from customers "familiar with the applicant's goods" do not qualify as proof for distinctiveness through use*



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# Why YSL won

Alice Stagg summarises a recent handbag design dispute

**Y**ves Saint Laurent SAS (YSL) had obtained its Community design registrations for two handbags (shown below) in November 2006. H&M Hennes & Mauritz BV & Co KG (H&M) sought to invalidate the registrations, on the basis that they lacked the necessary individual character in light of its earlier “Fantastic Shopper” design (front of design shown). H&M was not successful before OHIM’s Opposition Division and Board of Appeal and so appealed to the General Court.

## A HANDLE ON THE CASE

Whether a design has individual character is determined by the overall impression that it produces on the informed user. The Board of Appeal characterised the informed user here as “an informed woman, who is interested, as a possible user, in handbags”. Neither of the parties challenged this definition, and the General Court apparently approved it, albeit rather unclearly.

This can be contrasted with the definition adopted in a High Court decision of Mr Justice Floyd in relation to a Jimmy Choo handbag design in *J Choo (Jersey) Limited v Towerstone Limited and others* [2008] EWHC 346 (Ch). In Floyd J’s view, the informed user would be “someone with a knowledge of handbag design; not the woman in the street, not a handbag designer”.

The greater the designer’s freedom in developing a design, the less likely it is that minor differences between designs will be sufficient to produce different overall impressions on an informed user. The Court approved

*Whether a design has individual character is determined by the overall impression that it produces on the informed user*

the Board of Appeal’s finding that, in the context of fashion items like handbags, the designer’s degree of freedom is high. This is not by itself determinative in the assessment of the individual character of a design. However, it is a factor that has to be taken into consideration in that assessment.

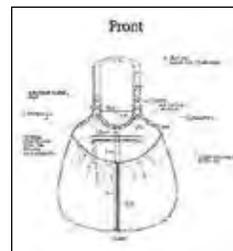
The Court agreed with the Board of Appeal’s finding that the two sets of designs created different overall impressions on the informed user, focusing particularly on three features of each: their overall shape, structure and surface finish.

In the case of the YSL designs, the Court held that the overall impression was of a bag design characterised by classic lines and a formal simplicity, whereas the H&M design gave an impression of a more “worked” bag. The Court also emphasised that the manner in which the bag represented by the design is used is relevant to the assessment of the overall impression produced on the informed user. The YSL design represented a bag to be carried solely by hand, whereas the earlier design represented a bag to be carried on the shoulder.

## The YSL registered designs



## The H&M design



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# Pattern marks refused again

But there is still value in attempting to protect this type of sign, believes Lucy Cundliffe

**E**E Limited made four Community Trade Mark (CTM) applications for grey, blue, yellow and ivory versions of the same sign, each consisting of a repeating pattern described as: “The combination of the specific Pantone colour [colour name] No. [Pantone code] with white particles in a certain infinite pattern.” The marks covered a wide range of goods and services relating to, *inter alia*, the telecommunications sector.

The examiner and the Board of Appeal (BoA) found the two-colour pattern devoid of inherent distinctive character under Article 7(1)(b) of Council Regulation (EC) No 207/2009 (CTMR). No plea was made for acquired distinctiveness under Article 7(3) CTMR, so the applications were rejected. The General Court upheld the BoA decisions. The conjoined decisions illustrate the known challenges of securing registered trade mark protection on an inherent basis for recurring coloured patterns unlimited by contours.

## DECISION

Noting established case law that consumers do not usually perceive colours per se or the appearance of products as indicators of commercial origin, the BoA held that the two-colour pattern, whether applied to the surface of products or in marketing material for goods or services, was nothing more than the sum of its individually non-distinctive features. The various colours were commonly used in communications and advertising and the repeating “simplified checkerboard pattern”

was banal, being a basic pattern that commonly serves decorative and technical functions.

The Court held that the BoA had conducted an appropriate analysis of the sign as a whole and that it was for the Applicant to demonstrate – by way of concrete evidence – precisely what it claimed was “striking” or “atypical” in the combination of features, especially as it appeared not to contest the BoA’s findings that the individual features were not distinctive. It was not satisfied that the Applicant had a clear understanding of what made the sign distinctive, holding that the amended description of the mark<sup>1</sup> relied on before the Court served only to reinforce the impression that the Applicant was “not entirely sure what exactly its sign represents”.

## COMMENT

Get-up is an important element of any brand, especially for service

providers, and what EE Limited was trying to achieve with these applications is plain.

Clearly, signs of this nature can function as indicators of commercial origin – think of the O2 bubbles or UPS brown – and trade mark protection was an appropriate avenue to have explored.

However, there are two types of registrable trade mark – those which are inherently distinctive and those which are distinctive through use – and this decision is a useful reminder that the hurdle for acceptance as inherently distinctive is very difficult for colour combination marks to clear.

The Court (rightly) considered flawed the Applicant’s contention that the use of colours by other telecoms operators that had (allegedly) acquired distinctive character meant consumers in that sector were now predisposed to rely on similar signs as indicators of commercial origin.

While the present decision feels correct on the facts, brand owners should not be put off attempting to register signs of this nature as trade marks. There is clearly value in obtaining protection for such signs and this is achievable with a creative yet realistic approach and strategy.

The mark in grey, yellow, blue and ivory



<sup>1</sup> “The mark consists of a pattern comprising a solid uniform background colour with different sized white particles spaced equidistant from each other in a square grid formation which, due to the placement and sizing of the individual particles, creates a three-dimensional impression.”



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BANK

IA

Y

# An elemental lesson

Roberto Pescador reflects on the comparison of signs in Bankia

The General Court has partially upheld the Board of Appeal's decision in the opposition brought by Banco ActivoBank (the "Opponent") against an application by Bankia SA (the "Applicant") for the mark BANKIA (figurative) on the basis of an earlier Portuguese mark for the word BANKY. However, the Court overturned the Board's decision with regards to "real estate services", considering these to be dissimilar to the "financial services" covered by the earlier mark.

This decision is interesting for two reasons: in relation to, first, the comparison of signs and, second, the comparison of "real estate services" and "financial services", both in class 36.

## SIGN COMPARISON

The Applicant argued that the word element BANK in both the earlier mark and the application was essentially descriptive of the services and, therefore, greater weight should be given to the remaining elements of the marks (IA and Y), which, it argued, were sufficiently different to avoid a likelihood of confusion.

Not surprisingly, the Court agreed with the view of the Opposition Division and Board of Appeal, namely that, merely because an element of a composite trade mark has weak distinctive character, this does not necessarily mean that element cannot be the dominant part of the sign; on account, in particular, of its

position in the sign or its size, it may make an impression on consumers and be remembered by them.

The Court also agreed with the Opposition Division and Board of Appeal that the average consumer would not break down the respective signs separating the word "bank" from the rest of the signs. On that basis, it concluded that the respective signs were highly similar phonetically and had a certain degree of visual and conceptual similarity.

The Court also rejected the Applicant's argument that the mark applied for had a highly distinctive character on account of the reputation it had acquired through use. The Court rightly reminded the Applicant that, although a highly distinctive character would be relevant in the context of absolute grounds for refusal or invalidation of a mark, it is irrelevant in the context of relative grounds (other than in relation to the earlier mark).

## SERVICE COMPARISON

The Court, however, disagreed with the Board of Appeal in relation to its finding that real estate services and

financial services were similar. The Court stated that the different nature, intended purpose, and method of use of the respective services meant that they were dissimilar. It also refuted the Board of Appeal's finding of complementarity: such services are usually provided by separate branches of financial institutions, so that financial activities are separate from any real estate activities, and it could not be argued that consumers looking for a property would turn to a financial institution.

## USEFUL GUIDANCE

This decision, although not groundbreaking, provides useful guidance for potential conflicts based on earlier rights, as it clarifies, first, the potential relevance of elements with a low level of distinctiveness within a sign and, second, the relationship between financial services and other services covered under the same class.

### Bankia mark



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# Up in the air

Dale Carter awaits the outcome of the recent Jumpman hearing with interest

In a decision issued in October 2014 (O/451/14) the UK IPO considered the issue of genuine use in the Community in opposition proceedings brought by an earlier Community Trade Mark (CTM) right holder. The parties were Nike International Ltd ('Nike') as Applicant and Intermar Simanto Nahimas as Opponent ('Intermar'). The marks at issue were JUMPMAN (Nike: covering *inter alia* 'clothing, footwear, headgear' in class 25) and JUMP (Intermar: its CTM covering identical goods in class 25). Intermar opposed Nike's UK application under Section 5(2)(b) Trade Marks Act 1994 and, in the course of the proceedings, Intermar was put to proof of use.

## EARLIER EVIDENCE

Intermar filed evidence to show use of its mark. The Hearing Officer accepted the JUMP mark was used in relation to the goods sold and the primary form of footwear sold was trainers. The evidence could be summarised as:

- **Before the relevant period:** 53,000 pairs of footwear were sold to a total of four businesses in Germany, Finland, Spain and Greece; 802 pairs of footwear were sold to a single business in Bulgaria.
- **During the relevant period:** 55,000 pairs of footwear (approximate value \$476k) were sold to a Bulgarian company called Runners during the last 16 months of the five-year period. The JUMP products were sold through one Runners shop in Bulgaria, which had an area dedicated to JUMP footwear (one year before the end of the relevant period), displaying JUMP signage. Runners sold 170 pairs of the footwear to a Romanian company.

- **After the relevant period:** Sales to Runners continued, as did sales through its Bulgarian shops.

Despite accepting that Intermar's use did not reflect a business operating at a sham or token level, the Hearing Officer decided that the small scale and geographically limited use over the last 16 months of the relevant period was insufficient to constitute real commercial exploitation of the mark in the EU. Consequently, Intermar's opposition was rejected.

## COMMENT

It is clear from the jurisprudence that when assessing genuine use, all relevant facts and circumstances are to be taken into account and that there is no quantitative threshold (C-259/02 La Mer Technology). Genuine use is not intended to reward commercial success or restrict trade mark protection to where large-scale commercial use has taken place (T-427/09 Centrotherm Clean Solutions) and geographical extent is only one factor to be considered (C- 416/04 P Sunrider). In ONEL (C-149/11), the CJEU stated that territorial borders of EU Member States are to be disregarded when assessing genuine use in the Community.

Intermar's evidence demonstrated low-level, customer-facing commercial exploitation of the earlier mark in the EU and use before, during and after the

relevant five-year period. The Hearing Officer's decision to reject its evidence appears to have been influenced by the large size of the footwear market and Intermar's few sales in that context, the lack of frequency of Intermar's sales and the limited geographical spread of the sales.

Recent cases from IPEC (Sofa Workshop Ltd v Sofaworks Ltd) and the General Court (GC) (T-278/13 Now Wireless Ltd) demonstrate an inconsistent approach to the application of earlier jurisprudence on genuine use. In Sofa Workshop Ltd v Sofaworks Ltd, Judge Hacon held that extensive use of the Claimant's mark throughout the UK was insufficient to be deemed use in the Community. In contrast, in Now Wireless Ltd, the GC upheld an earlier OHIM appeal decision that use of a CTM in the Thames Valley region constituted genuine use within the Community.

While it must be accepted that cases turn on their specific facts, it is difficult to reconcile the approach taken by certain Courts and Tribunals in assessing what constitutes genuine use of a trade mark in the Community. The uncertainty arising from such decisions will be a concern for all and clarification of this issue is needed.

Decision O/451/14 is currently under appeal by Intermar to the Appointed Person.



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# The word is not enough ...

Désirée Fields queries the usefulness of the series provision

**O**n 19 December 2012, Lidl Stiftung & Co KG filed a UK trade mark application to register five representations of the word SIMPLY as a series of trade marks for a wide range of goods in classes 3, 5, 29, 30, 31, 32, 33 and 34.

The fourth and fifth representations were deleted following an objection from the UK IPO that they did not form a series, as defined in section 41(2) of the Trade Marks Act 1994 (TMA), with the preceding signs.

Subsequently, the UK IPO refused the application on absolute grounds. The Examiner took the view that the word SIMPLY was devoid of distinctive character and descriptive of the goods applied for under Sections 3(1)(b) and (c) TMA, respectively. The Hearing Officer upheld the decision, finding that the word SIMPLY was descriptive of the goods' simplicity and naturalism. Whilst the mark contained an element of punctuation (an ellipsis following the word in each mark), the stylised font did not add distinctive character. The ellipsis added a dramatic pause but did not displace the descriptive meaning of the combination as a whole in the minds of the average consumer.

The Hearing Officer noted that even if the ellipsis negated the descriptive character of the mark, the mark was devoid of distinctive character because the average consumer would not recognise it as emanating from a particular supplier. Accordingly, the word SIMPLY could not indicate trade origin without first educating the public.

## CHANGE OF DIRECTION

On appeal to Geoffrey Hobbs QC sitting as the Appointed Person, Lidl accepted that the Hearing Officer's decision was correct in relation to the second and third signs of the series, but maintained that the first sign possessed distinctive character by reason of its graphical appearance. This position was contrary to the proposition put forward when applying for the series mark under Section 41(2) TMA.

Hobbs QC upheld the decision of the Hearing Officer, noting that the cursive script and quasi-brushstroke style of representation in the first sign would not be perceived and remembered as anything more than a mildly stylised version of the word "Simply". It was an ordinary and traditional style used in daily life or in professional context, and unremarkable from the perspective of the average consumer.

Visually, Hobbs QC noted that the mark was dominated with the verbal message of the word "Simply", connoting that the goods applied for were plain, pure or natural. He reiterated that trade mark registries should be astute of the consequence of registering descriptive marks "under the cover of a figurative fig leaf of distinctiveness", as it led to trade

*The UK IPO is clamping down on descriptive marks hiding behind that 'figurative fig leaf of distinctiveness'*

mark owners obtaining protection for marks purely because of those figurative elements which could subsequently be invoked against signs that did not include the same or similar elements.

Hobbs QC was not persuaded by examples of other signs featuring the word "Simply", which had been accepted as UK or Community trade marks. He concluded that the sign had been rightly denied registration for lack of distinctiveness, but did not express a view whether the mark was descriptive of the goods applied for.

## END OF AN ERA?

Occasionally, the series provision under Section 41(2) TMA is used by applicants uncertain as to whether a word mark application would be accepted for registration. This decision illustrates that the UK IPO is astute to this use and is increasingly clamping down on descriptive marks hiding behind that "figurative fig leaf of distinctiveness". Is this the end of the series provision as a practical filing tactic?



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# Registry decision upholds high bar

It remains difficult to prevail in an appeal to the Appointed Person, writes Peter Vaughan



This appeal was to the Appointed Person, Emma Himsworth QC, against a decision of the registry to refuse UK Trade Application No. 3006534 AXYS ACCOUNTANTS (Series of Two) on the basis of the Opponent's earlier right in Community Trade Mark (CTM) Registration Numbers 2220473 AXYS CONSULTANTS and 2220739 AXYS CONSULTANTS (Figurative Plus Device). The appeal was refused.

Having accepted the earlier marks had been used, the Hearing Officer in the original decision found that the goods and services were identical or highly similar. This included a finding of business management and accountancy and taxation services being similar.

In comparing the marks the Hearing Officer discounted CONSULTANTS and ACCOUNTANTS as descriptive and focused primarily on AXIS and AXYS. He found the marks to be visually and phonetically similar. Although CONSULTANTS and ACCOUNTANTS were not similar, as the dominant and distinctive part of the marks was AXIS /AXYS, this had little bearing on the overall impression.

The Hearing Officer concluded that as a result of the similarities between marks and identity/similarity between the goods, and notwithstanding a higher degree of attentiveness on the part of the average consumer, there was a likelihood of confusion. He did, however, dismiss a Section 5(3) Trade Mark Act 1994 claim as the evidence submitted related to France.

The Applicant appealed. The appeal had two prongs: 1) that the similarity

of the services was incorrect, especially with respect to taxation and accountancy being similar to business management; and 2) that the marks as a whole were not similar. The Opponent did not take part in the appeal.

The Appellant argued that business management and business administration were vague terms not closely related to accounting. He argued that the target market of his mark was small and UK based. It would seem that some French opposition proceeding decisions were referred to. The Appointed Person dismissed these arguments.

## REAL-LIFE USE

Although the French case law was noted, it was not seen as being of assistance in UK proceedings. The argument that the Appellant's target market was small and in the UK, while the Respondent's was in France, was also not accepted as relevant in the opposition proceedings. This would "illegitimately introduce" "real life" circumstances of use into the question of similarity to be conducted from the perspective of a UK average consumer and on the basis of the specifications. This was a Section 5(2) TMA assessment.

Looking at the second point of appeal, the Appointed Person accepted that it was not right to "salami slice" marks. However, she confirmed that the dominant and distinctive elements are to be taken into account and that the Hearing Officer's decision was not incorrect. The appeal was therefore dismissed.

## HIGH BAR

The high bar in place for appeals to the Appointed Person is confirmed. It is perhaps telling that the Applicant (and Appellant) was a litigant in person. The main point of note is the comment that in opposition proceedings, introducing "real life" circumstances will be difficult, especially where this is an attempt to show no overlap of operation. These were not infringement proceedings, but instead dealt with issues of registration. Although it may have appeared to be a brave step by the Opponent not to take part, it shows that in some cases no action can be a viable option, at least where the facts are fairly clear.



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# No play for popular mark

A contrived approach to language was rejected, reports Azhar Sadique

This matter concerned an appeal to the Appointed Person (“AP”) regarding the UK IPO’s refusal of UK Trade Mark Application No. 3012530 “SERIOUSLY POPULAR” of Associated Newspapers Limited (“ANL”) by decision of the Hearing Officer, Ms Bridget Whatmough, on 24 March 2015 (O/125/15).

By way of background, the UK IPO initially objected to the application on the basis of Sections 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”). With regard to 3(1)(c), the UK IPO held that the sign may serve to designate a quality of the goods or services covered by the application (eg electronic publications, which are extremely popular). However, the objection on 3(1)(c) was rightfully waived by the Hearing Officer on the basis that there wasn’t a direct link between the sign and the goods and services covered.

At the hearing, the Hearing Officer maintained the objection in respect of 3(1)(b) on the basis that the sign was devoid of any distinctive character in relation to the goods and services for which protection was sought.

## ORIGIN NEUTRAL

The Hearing Officer stated that the sign “SERIOUSLY POPULAR” lacked any power to individualise such goods and services to a single economic undertaking and considered the mark to be entirely “origin neutral”. She further rejected ANL’s contentions linked to the reasoning of the Court of Justice of the European Union (CJEU) in Case C/398/08, Audi AG v OHIM, to the effect that a sign which

*The Hearing Officer stated that ‘Seriously Popular’ lacked any power to individualise such services to a single economic undertaking*

conveys a promotional message can, by combining verbal elements with an element of wordplay, possess distinctive character.

ANL appealed to the AP under Section 76 of the Act, contending that there was a play on words in the designation “SERIOUSLY POPULAR”. ANL contended that the word “seriously” could be open to interpretation as meaning either “extremely” or “gravely” popular and would be seen as a quirky or idiosyncratic, and hence

distinctive, expression. As such, ANL submitted that the sign should be considered distinctive for the goods and services covered.

The AP confirmed that the Hearing Officer had correctly applied Section 3(1)(b) of the Act and was right to reject ANL’s submissions, stating that there was no ‘double entendre’ in the way in which the sign “SERIOUSLY POPULAR” would be understood by the average consumer.

The AP also supported the Hearing Officer’s finding that there was no individualising message of the kind that a trade mark must convey in order to serve as an indication of provenance in relation to the goods and services for which it is used.

The AP held that the argument put forward by ANL involved an unnatural and contrived approach to the meaning of the use of the words. The word “seriously” is widely used and well-established as a refinement of the words “really” and “happy”. The word “popular” relates to the status of being well-liked and appreciated. As both words qualify each other, the AP held that “saying something is seriously popular is the same as saying that it is really very well-liked and appreciated”.

The AP was clearly not playing with his words, concluding that the application was entirely unsustainable. The appeal was dismissed.



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# Clear cut case

This is a textbook example of Ansul principles in use, believes Kireth Kalirai

**A**t the heart of these two cases was the issue of whether there was genuine use of the mark in question under Section 46(1) of the Trade Marks Act 1994 (TMA). “VAUX” was registered on 25 August 2006 in respect of “Beer, ale, stout and porter, all included in class 32”, by Vaux Beers Limited (“Beers”). On 22 May 2012 VSES Projects Limited (“VSES”) applied for revocation for non-use, and the next day filed an application to register the mark “VAUX” in class 32, which was opposed by Beers on the basis of its 2006 registration. The two cases were consolidated, and proof of use was requested within the context of the opposition proceedings.

*‘Mere’ ownership of a domain name cannot constitute genuine use of a mark, as it does not maintain or create market share for goods*

The Appointed Person, Emma Himsworth QC, reviewed the Hearing Officer’s decision that Beers’ trade mark, “VAUX”, should be revoked for non-use. The Appointed Person categorised the points of appeal into three categories, all of which had been considered by the Hearing Officer at the first instance, and all of which failed on appeal.

## USE QUESTIONS

The first category was the assessment of whether there had been genuine use of the trade mark, and the Appointed Person referred to the Court of Justice of the European Union (CJEU) in Case C/40/01 Ansul BV v Ajax Brandbeveiliging BV [2003] ECR I-2439 at paragraph 37. Central to Beers’ claim of genuine use was the purchase of domain names, including the word “vaux”, however, unsurprisingly, the Appointed Person held that “mere” ownership of a domain name cannot constitute genuine use of a mark, as it does not maintain or create market share for goods.

The second category concerned Section 46(3) TMA (commencement or resumption of use after expiry of the initial five-year period), which was held not to apply as

there was no genuine use by Beers prior to the filing of the application for revocation.

The third category, “proper reasons for non-use”, also failed to impress the Appointed Person on the facts. It was held that “loss of protection by reason of non-use of a mark is properly to be regarded as the rule and not the exception”. The death of an uncle of the director of Vaux Beers in 2008 was dismissed as a proper reason for non-use as it did not justify relaxation of the five-year period. A delay in obtaining recipes for “original” “VAUX” beer and adverse publicity surrounding the closure of the original brewery (Beers had argued that this meant it wasn’t possible to successfully launch a new beer under the “VAUX” name) were also discounted.

## AUTHOR COMMENT

This case is a clear example of the Ansul principles of genuine use. Mere ownership of domain names and blank landing pages do not maintain or create a market for goods. Furthermore, once the lack of genuine use is established, it is incumbent upon the party who seeks to rely upon the “proper reasons” exception to establish the same.



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Kireth has a strong interest in brands and the FinTech sector.

# events

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



Date	Event	Location	CPD hours
19 January	<b>Mock Trials</b>	Bristows, London EC4	2
26 January	<b>ITMA London Evening Meeting</b>	Royal College of Surgeons, London	1
23 February	<b>ITMA London Evening Meeting</b>	Royal College of Surgeons, London WC2	1
16 March	<b>ITMA Drinks Reception</b> Part of the ITMA Spring Conference	Jewel, London W1	
16-18 March	<b>ITMA Spring Conference</b> History & Heritage	One Whitehall Place, London SW1	9
17 March	<b>ITMA Gala Dinner and Drinks Reception</b> Part of the ITMA Spring Conference	Tower of London, London EC3	
20 April	<b>ITMA London Evening Meeting</b>	Royal College of Surgeons, London WC2	1
10 May	<b>ITMA London Evening Meeting</b>	Royal College of Surgeons, London WC2	1
28 June	<b>ITMA London Evening Meeting</b>	Royal College of Surgeons, London WC2	1
20 July	<b>ITMA London Evening Meeting</b>	Royal College of Surgeons, London WC2	1
27 September	<b>ITMA London Evening Meeting</b>	Royal College of Surgeons, London WC2	1
25 October	<b>ITMA London Evening Meeting</b>	Royal College of Surgeons, London WC2	1
22 November	<b>ITMA London Evening Meeting</b>	Royal College of Surgeons, London WC2	1

Our **Spring Conference Gala Dinner** will be held in the dramatic environs of the Tower of London

**ITMA London Evening Meetings and the ITMA Spring Conference, including Gala Dinner and drinks receptions, are kindly sponsored by**





**I work as ...** a Trainee Trade Mark Attorney at HGF Ltd in Leeds.

**Before this role, I was a...** student at the University of Glasgow and occasional intern at law firms in the UK and US.

**My current state of mind is...** excited about what lies ahead. I am only 12 months into my career, and I am excited to learn and grow in my role at HGF.

**I became interested in IP...** when I covered the area as part of a very small section of a Commercial Law module in my undergraduate degree at University College Cork in Ireland. Although it was only a couple of lectures, that snippet was enough to prompt me to pursue an LLM in Intellectual Property Law at the University of Glasgow.

**I am most inspired by...** David versus Goliath success stories. For example, Greece winning the European Championship in 2004 offers regular inspiration to us hopeful (deluded?) Irish football supporters.

**In my role, I most enjoy...** the adversarial aspect of the work. I've always been partial to a good argument.

**In my role, I most dislike...** the limitations of my own ability and



Student member  
Sean McDonagh  
shares his excitement

knowledge at this early stage in my career. Despite being somewhat inevitable, it can be frustrating at times.

**On my desk is...** an organised mess!

**My favourite mug says...** "There could be gin in this."

**My favourite place to visit on business is...** Having effectively just started out, I've not had the opportunity to go anywhere on business just yet. I suspect I'll have to wait a while before I get to say I have a "favourite".

**If I were a trade mark or brand, I would be...** Guinness – because I'm a proud Irishman! (And it's good for you, too.)

**The biggest challenge for IP is...** Again, it's probably too soon for me to say with any great certainty, but a challenge I've noticed so far is the fragmentation regarding, and inconsistencies in, how IP is dealt with across the world – and the greater costs and uncertainties that are the result.

**The talent I wish I had is...** to be able to write and compose great music.

**I can't live without...** my family.

**My ideal day would include...** a summer music festival on the beach with a group of good friends.

**In my pocket is...** my Leeds bus pass.

**The best piece of advice I've been given is...** "It's better to remain silent and be thought a fool than speak and remove all doubt."

**When I want to relax, I...** play guitar and (attempt to) sing.

**In the next five years I hope to...** be a fully qualified Trade Mark Attorney.

**The best thing about being a member of ITMA is...** the number of networking possibilities.

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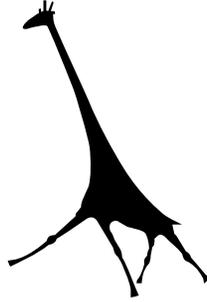
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