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ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

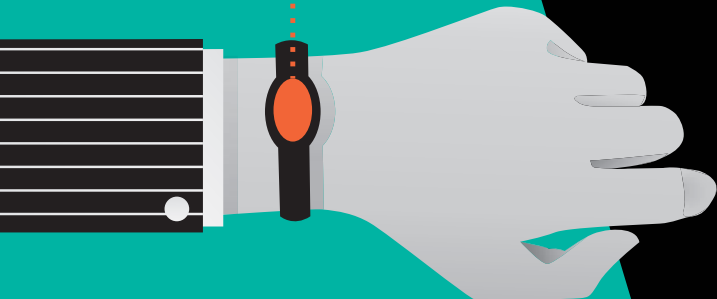
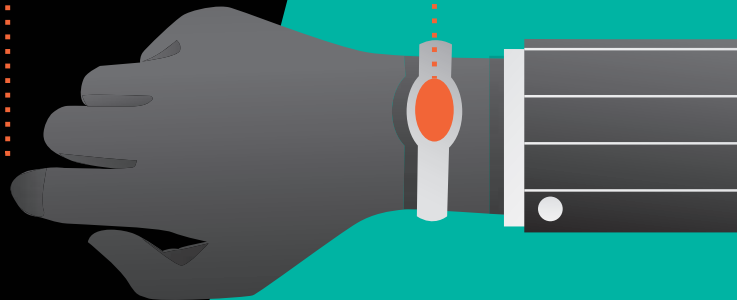
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welcome

September 2016



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ITMA Review

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I hope everyone had an opportunity to relax and recharge their batteries over the summer, and that you are all looking forward to a busy ITMA autumn. In October, we have the Autumn Seminar in Birmingham, at which we will provide an update on our Brexit planning, and explore the interaction between IP and technology, a topic that is also at the heart of this month's cover story.

Also inside is a discussion of the rather more ancient topic of coats of arms. We also welcome the contribution from new

IPReg Chair Caroline Corby, and reports on the evolution of the IPEC and on the likely effect of changes to Section 52 of the Copyright Designs and Patents Act 1988 on designers.

I am also delighted that we have contributions from the Philippines and on the recent European Communities Trade Mark Association meeting in Croatia – to ensure we are not too UK-centric!

Kate O'Rourke
ITMA President

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iTMA insider

Kate O'Rourke outlines ITMA's key priorities



► ITMA President
Kate O'Rourke MBE

At ITMA's Summer Reception, and in her first speech to members, ITMA President Kate O'Rourke MBE revealed her plans for the next two years.

Focusing on the implementation of ITMA's Royal Charter (see page 5), her speech also addressed: the role ITMA will play in EU IP negotiations following the result of the EU Referendum; promoting member engagement; and launching a new pro bono initiative.

On the Royal Charter, Kate said: "I am delighted that we have received this

recognition of our pre-eminent role for trade marks and designs in the UK, the quality of the work of our members, the importance of trade marks and designs in the UK economy and the importance of ITMA itself in representing its members.

"As an institute, we intend to build on this royal grant to use [our Chartered status] as a kitemark to indicate to our IP colleagues, clients and international business that being a member of the Chartered Institute of Trade Mark Attorneys indicates a high quality of service; recognition of our regulated status and excellent examination system; and the fulfilment of compulsory continuing professional development by all our Registered Trade Mark Attorney members."

Kate reassured members following the recent EU Referendum result, saying that ITMA will "fight for the best outcome, in liaison with all of the other members of the IP family in the UK". (See right for ITMA's most recent statement on the UK's exit from the EU.)

Kate's other priorities will include launching a new pro bono initiative and member engagement. She added: "I will be promoting membership engagement, particularly for our younger members and student members, and looking more broadly to the international community."

See our Summer Reception coverage on pages 6 and 7 of this issue.

Brexit update

ITMA has begun conversations with the Government, the UK IPO and others to ensure that we obtain the best possible post-Brexit outcome for the profession, the wider IP community and users of the IP system.

Our taskforce met first on 12 July and ITMA is initially focusing on two areas:

1. the options for the continued protection in the UK of EU trade marks and Registered Community Design rights; and
2. rights of representation for UK practitioners before EUIPO.

On 14 July, ITMA met with the Minister for Intellectual Property Baroness Neville-Rolfe and other key stakeholders for a high-level roundtable discussion. The Minister was supportive and reiterated that ITMA will be an important stakeholder in the forthcoming negotiations.

We also met with UK IPO Acting Chief Executive Sean Dennehey and Divisional Director, Trade Marks and Designs, Steve Rowan on 19 July and presented to them our early work on the options for continued protection of EU-registered rights in the UK.

The UK IPO is keen to have a regular dialogue, and we are delighted that its representatives will be at our London Roadshow on 6 September and our Autumn Seminar in Birmingham on 6 October.

We have written to WIPO and EUIPO to pledge our support and offer to engage with them as matters develop.

Thank you to all who have offered to join the taskforce. It is at capacity, but we will no doubt need more help as matters progress.

We will inform you of developments. In the meantime, please do not hesitate to contact us with your concerns.

Silent auction action

The ITMA Benevolent Fund is running a silent auction throughout September. Please visit itma.org.uk for information on how to bid.

Volunteering vacancies

ITMA's committees and working groups provide a valuable resource for ITMA to achieve our strategic objectives. We have updated the committee and working-group information on the ITMA website to make it clearer where there are vacancies, who is on each committee and working group, and what each does. We have also tried to estimate how much time commitment each committee and working group requires.

All committees and working groups rely on volunteer involvement from members of ITMA. This ensures that members are at the heart of everything we do, and allows us to perform more effectively. We try to make sure that the time commitment for volunteers is not too onerous, and that volunteers can enjoy flexible involvement, depending on the time they are able to offer.

Please take a look at the new web pages, and do put yourself forward if there is an area you are keen to work on, even if, at present, your area of preference does not indicate a vacancy.



ITMA's Royal Charter is undergoing the final stages of preparation before it becomes a legal document

Our Charter moves nearer

Calligrapher **Timothy Noad**, a scribe and illuminator to HM Crown Office at the House of Lords, is currently working on scribing ITMA's Royal Charter onto vellum in readiness for the Crown Office to apply the Great Seal, and for the Charter to become a legal document. Timothy's work is scheduled for completion in September, and we will then have a clearer idea of when we will officially receive the Royal Charter and can become the Chartered Institute of Trade Mark Attorneys.

There is a lot of work going on behind the scenes in preparation for the change, and we hope to have an official launch date pencilled in shortly. Please continue to check itma.org.uk for updates. We will soon be publishing full details about our new status and how you, as members, can use and benefit from it.

Member move



David Rose has joined the Mishcon de Reya IP legal team in London as Partner. Contact David on +44 20 3321 6331 or at david.rose@mishcon.com

UK IPO updates

IP Professional content – Having received a number of queries from the public, the UK IPO is keen to reassure *ITMA Review* readers that the information that had been included in the IP Professional section can now be found under the heading of Law and Practice (gov.uk/topic/intellectual-property/law-practice).

MM2 online – This month marks the first anniversary of the UK IPO's launch of its version of the International Application form (MM2), following feedback from customers, and to reduce the amount of deficiencies raised. The form has been designed to improve the user's experience of the Madrid System, and can be found at gov.uk/government/publications/trade-mark-forms-and-fees/trade-mark-forms-and-fees.

In memoriam

DAVID GOLDRING

ITMA was saddened to hear of the passing of David Goldring at the age of 61. Neil Wilkof posted the following in respect of David's loss on the IPKat blog (ipkitten.blogspot.co.uk) on 30 June: "David was a highly respected trade mark practitioner in London and this Kat was proud to have met him in both his professional and personal capacities. After reading Law at University College London, David practised initially as a UK Trade Mark Attorney and subsequently as a European one. His career encompassed both in-house and private-practice sectors. David's commitment to the trade mark community was best exemplified by his long-term involvement with MARQUES, where he was a founder member and Treasurer of the organisation. In 1984, even before the organisation came into existence, he served as a member of the steering committee that contemplated the establishment of a European trade mark owners' association."

SUN SHINES ON SUMMMER RECEPTION

Inevitably, Brexit was a hot topic at our annual July gathering

PHOTOGRAPHY BY SIMON O'CONNOR



THE POTENTIAL IMPACT of a UK exit from the EU may have brought a serious tone to many of the evening's chats, but welcome sunshine and a bucolic garden setting added a light touch to the ITMA Summer Reception at the Institute of Directors in London.

Welcoming members and guests to the event, ITMA President Kate O'Rourke MBE used her first speech to members to outline the role ITMA will play in EU IP negotiations, update us all on the exciting implementation of ITMA's Royal Charter and promote the launch of a new pro bono initiative.



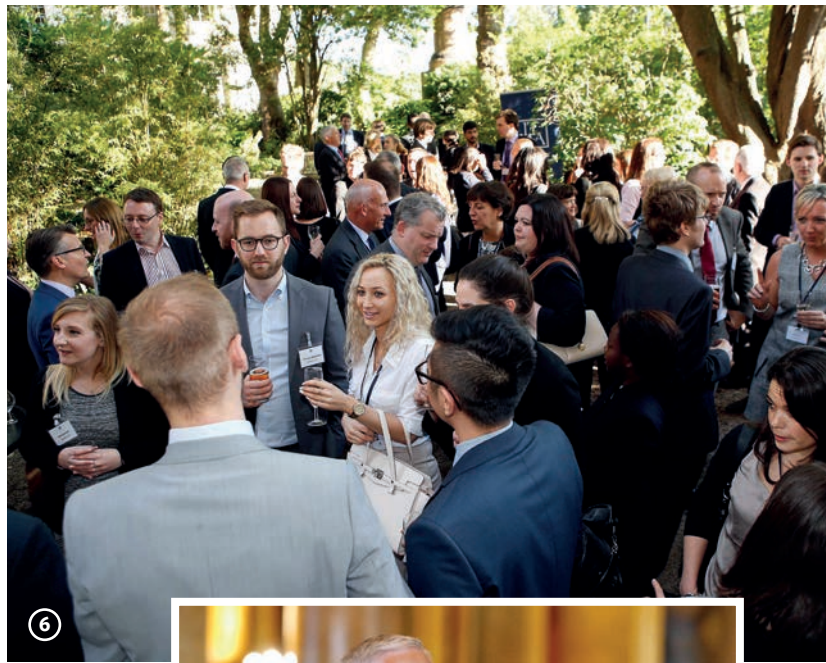


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- 1) Mr Justice Arnold (right) was a special guest at the event
- 2) The IoD's beautiful garden provided a lush setting
- 3) Nick March from event sponsor WebTMS (centre) networks with members
- 4) ITMA President Kate O'Rourke is flanked by CIPA President Tony Rollins (left) and Law Society President Jonathan Smithers (right)
- 5) The IoD is the UK's longest-running organisation for professional leaders
- 6) More than 200 members gathered to meet and mingle
- 7) ITMA's soon-to-be-updated logo greeted members and guests
- 8) The UK IPO's Steve Rowan (left) in lively conversation with Immediate Past President of ITMA Chris McLeod



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President Kate O'Rourke used her first speech to members to outline the role ITMA will play in EU IP negotiations



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Replica repercussions

John Coldham explains the recent change to Section 52 and its likely effect on designers

THE REPEAL OF Section 52 of the Copyright Designs and Patents Act 1988 (CDPA) came into force on 28 July 2016. It has a long-stop date of 28 January 2017 for the final stocks of products that may now infringe copyright to be sold through or destroyed.

Section 52 limited the term of copyright protection for artistic works that had been exploited by an industrial process (where more than 50 articles had been produced) to 25 years, in line with the maximum term available for registered designs. This was significantly less than the duration for other artistic works, which is the artist's life plus 70 years.

TIMELINE

In order to align UK law with the EU following the CJEU's decision in *Flos v Semeraro*, the Enterprise and Regulatory Reform Act 2013 provided for Section 52 to be repealed. It remained for the Government to set a date for the repeal to take effect.

A consultation and resulting Commencement Order set a repeal date of April 2020. Following a judicial review by owners of iconic furniture, the Government repealed that Order in July 2015, and started a new consultation. This resulted in a new Commencement Order, and a 28 July 2016 repeal date.

WHY IS THIS CHANGE SIGNIFICANT?

Section 52 had the tacit effect of making copyright no more useful than registered design rights for the protection of product design. As a result, it was rarely relied upon in the pursuit of infringers. However, removing the 25-year limit could give owners of some designs dating back to the 1960s (or earlier) a new way to pursue copyists.

Section 52 only limited protection for copyright works that had been industrially produced. Works of artistic craftsmanship and sculptures are the key areas to be affected by the repeal. These are notoriously difficult to pin down, and are construed fairly narrowly. As a result, it is not

expected that this repeal will open the floodgates to any furniture designer, for instance, to bring claims where design rights are unavailable. It is likely that most furniture designers looking at this route will prefer to claim that their design is a "work of artistic craftsmanship", rather than a sculpture (following the Lucasfilm costume case). However, to succeed, the owner will need to claim that its design is both of high artistic quality and a work of craftsmanship. This is likely to lay down some tricky hurdles. Something may be artistic, for instance, but does it require particular craftsmanship to make it? It is likely that only the most iconic designs will benefit from this repeal.

WHAT HAPPENS NOW?

Sellers of replicas appear to be taking no chances, with many advertising products as the "last chance to buy", as some old works with expired copyright will "come back from the dead". An interesting question arose following the first draft of the second Commencement Order, which has now been resolved. On that draft, mere "possession" in the course of business was considered to be an infringement, so businesses that had previously purchased replicas for their shops, for instance, could have been caught. However, when this was pointed out, the UK IPO clarified the Order so that it expressly does not deal with mere possession. This repeal will also affect 2D images of protected products, which could affect architects, CAD software producers and book publishers where they use images of iconic products. Depending on the product protected, it may be that these organisations will now need a licence. ■



John Coldham

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A FRESH PERSPECTIVE

IPReg Chair Caroline Corby is bringing an experienced eye to a fascinating sector, as she told the ITMA Review



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Why did you want to be the Chair of IPReg?

It's a role that I was attracted to because IP is a fascinating legal area and critical to the success of any business. The profession also has the benefit of being full of very bright people, which certainly makes it even more interesting.

There are approximately 870 Trade Mark Attorneys in the UK, and I have learnt so much about protecting brands while meeting some of them, including members of the ITMA leadership team. I have also visited a number of firms, such as Stobbs IP, and shadowed Trade Mark Attorney Mark Caddle of Withers & Rogers. I am observing His Honour Judge Hacon in October. I am keen to meet as many of you as I can and look forward to representing the sector.

Are you expecting change in the sector?

There's a lot happening in the legal regulatory environment at the moment. There is discussion about whether there should be one regulator to cover all of the legal fields, including the very specialist area of IP. As an

organisation, IPReg sees the value of remaining an independent specialist regulator. The Competition and Markets Authority has also been consulting on the legal sector and issued its preliminary report in July.

What can you bring to the role?

This isn't my first statutory regulatory role. I have a good idea of what is expected of a regulator from being Chair of the Investigation Committee for the General Optical Council and chairing interim order hearings for the Nursing & Midwifery Council.

I have also chaired the London Probation Trust, a non-departmental public body with an annual budget of £130m and 2,700 employees, which was overseen by the Ministry of Justice (MoJ). In addition to chairing IPReg, I am currently a non-executive director of: the Children and Family Court Advisory and Support Service, which looks after the interests of children in the family court; the Criminal Cases Review Commission, which looks into potential miscarriages of justice; and the Parole Board, which decides whether prisoners are safe to release back into the community. I started my career in the City and, during that period, I sat on many private-sector boards across a range

TIVE

of industries. I am currently on the board of a UK consumer-products company. All of this has helped to develop my governance experience.

As a non-executive director, I am not too immersed in an organisation. I can stand back, pause and think. Similarly, I can also bring different but useful views as a lay member, as do other lay members including: David Bream, who manages the SETsquared business incubation programme at the University of Southampton, and works with enterprise start-up businesses in science and technology; Steve Gregory, who offers an international business viewpoint from a career in executive

“

I'm proud to be working for an organisation that has a strong track record for delivering proportionate regulation

roles across global automotive companies; Deborah Seddon, who is Head of Policy and Standards at the Engineering Council, and can share a perspective on educational aspects and how the engineering profession views IP regulation; and Nick Whitaker, a senior accountant who brings a financial and corporate-governance view.

How does IPReg stand out from other regulatory boards?

Trade Mark Attorneys and Patent Attorneys require a different regulatory approach to others in the legal sector. These roles stand out in demanding a combination of a specialist technical background in IP and a legal background. These attorneys have to address the bespoke needs of a company or organisation and also understand the particular asset risks for this area.

However, the hard work and effort applied by attorneys on client work is familiar to me from my background in the City. I was reminded of this recently when I visited firms to introduce myself. It was great to have discussions with professionals so that I could better understand their ways of working and be fully briefed on any issues of concern to them.

How do you ensure quality through IPReg?

I'm proud to be working for an organisation that has a strong track record for delivering proportionate regulation. We have a code of conduct, complaints procedures and other processes to help clients and consumers. The wider public can have confidence in the regulatory framework we have set up.

We set quality thresholds. It's not the business of regulators to limit competition for the public. It's our business to enable the public to make informed decisions on their choice of whether to appoint a regulated or non-regulated advisor.

We are here to help people understand the differences between regulated and unregulated services, and what it means for them in terms of protection, but we don't limit the competition or tell them which organisations to use. Businesses should understand that regulated IP attorneys operate in a regulated environment. This gives confidence that there are appropriate safeguards and high standards.

What do you see for the future of IP regulation?

We want to continue to focus on being a badge of quality and a kitemark for consumers. In this increasingly digital world, we also need to keep up with developing technology. We have to make sure that the IP profession is well regulated in this space. Also, as the profession changes, we need to keep up with things that affect it.

How are you engaging with other IP stakeholders?

Our other stakeholders, such as the Department for Business, Energy & Industrial Strategy, the UK IPO, the MoJ, innovation hubs and universities are all important to us. We work closely with them as and when we're required to. It is great to have such good relationships with them.

However, as a small organisation, IPReg has to work hard to get its voice heard. It's a small regulatory board, because we don't want to be burdensome to the profession and cause unnecessary costs. But the best way of getting your voice heard is by doing a good job, and IPReg does that. ■

Brand owners traditionally known for technology, fashion, luxury goods or sports equipment are increasingly becoming associated with “wearable technology”.

At its most sophisticated, this emerging product set includes full-blown computers in wearable form – for example, the Apple Watch and Google’s controversial Glass. At its most simple, an inexpensive communication chip is added to an everyday object. For example, Tile is a Bluetooth chip that can be attached to an easy-to-lose item, such as a wallet, and transmits its identity in the hope its location is discovered by phones running the Tile app. In between these

extremes is a range of specialist devices, such as Fitbit activity trackers; dual-purpose devices, such as Ringly jewellery, which vibrates to identify calls or messages from selected contacts; smart clothing, for example sports clothing that provides feedback on body position; and technology as fashion, including Studio XO’s LED- and mini-screen-decorated couture.

Whatever the complexity or usefulness of the technology, brand owners need to be aware of the potential hurdles when registering trade marks for wearables and, more generally, the increased risks of brand damage where technology (and especially connected, data-collecting technology) is involved.

THOROUGHLY MODERN MARKS

Jennifer Sander assesses the challenges of brand protection for wearable technology





When seeking trade mark protection for wearable technology, an important consideration is that, because wearable products often combine a technology component with a traditional consumer item, they typically cross multiple classifications of goods and/or services. Brand owners should consider whether the goods covered by any trade mark application include the technology component integrated in the product, as well as the traditional description for the product. For example, a “smartwatch” could be classified both as a portable computer and a watch.

A review of trade mark applications and registrations for marks used in association with wearable goods illustrates this point.

In one approach, wearable goods may be described by their specific functionality. For example, a Canadian registration for the mark FITBIT includes goods for “multifunctional electronic devices, namely wireless activity trackers for displaying, measuring and uploading to the internet information, namely time, date, body and heart rates”.

Another approach is to define wearable goods by their traditional product name, and then to define this traditional product as having a particular electronic functionality. For example, a Canadian application for the mark SAMSUNG GEAR FIT includes “bracelets” as well as

“bracelets that communicate data to personal digital assistants [and] smartphones”. Similarly, the same application also includes “wristwatches” and “watches that communicate data to personal digital assistants [and] smartphones”.

Such applications may include both broad and

narrow descriptions of the goods and/or services. For example, a Canadian application for the mark GOOGLE GLASS includes the broad description of “computer hardware”, as well as a narrower description of “wearable computer peripherals, namely head-worn computing devices, headsets [and] cases”.

Since more classes of goods and/or services may be engaged with wearable products, the trade mark applications for these goods will typically have higher filing costs in those jurisdictions that charge fees for each class of goods and services in the application.

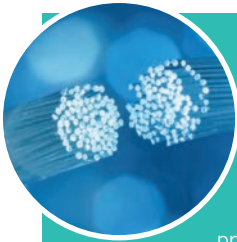
Secondary or ancillary goods and services may flow from the primary wearable product. For example, FITBIT is used in association with wearable activity trackers as well as software applications for tracking health-related information. As such, a further Canadian registration for FITBIT includes “computer software for managing information regarding tracking, compliance and motivation with a health and fitness programme”. There may also be secondary services that flow from the data that is gathered from individuals using the product.

Because these goods cross into multiple product categories, clearance searches must be conducted in a broader manner to cover all aspects of the wearable product. Clearance searches require careful consideration of any marks directed to similar consumer goods, as well as any marks directed to similar electronic technology.

EARLY ACTION

It is important to seek out trade mark protection early, since other parties may anticipate the type of marks that will be used for wearable technology. For example, Apple experienced difficulty in securing trade mark protection for iWATCH because it

It is important to seek out trade mark protection early, since other parties may anticipate the type of marks that will be used for wearable technology



AUTUMN SEMINAR TAKES ON NEW TECHNOLOGY

Find out more about the impact of innovation at ITMA's 2016 Autumn Seminar in October - booking is open now

For all IP professionals, it's important to keep on top of the latest trends in technology and consider their implications on trade marks/designs.

Our Autumn Seminar will address trends including 3D printing, wearables and domain names. Our speakers will share their insight to equip you to face tomorrow's challenges today.

Of course, the EU Referendum result will also have repercussions for the wider IP sector. We will discuss its implications in a special session.

The event will be followed by a drinks and networking reception.

FULL CONFERENCE PROGRAMME

- 9.30am** Registration and refreshments
- 10.00am** Introduction – Kate O'Rourke, ITMA President
- 10.10am** Wearable technology – Alexandra Brodie, Gowling WLG
- 11.00am** Domain names: rights protection mechanisms and other take-down remedies available to brand owners – Matthew Harris, Waterfront Solicitors (Chair) and Susan Payne, Valideus Ltd
- 12.00pm** Lunch
- 1.30pm** Afternoon introduction – Tania Clark, ITMA First Vice-President
- 1.40pm** Brexit and the repercussions in the world of non-contentious IP – Patricia Collis, Bird & Bird LLP
- 2.30pm** Technology and graphical representation – Nathan Abraham, UK IPO
- 3.15pm** Tea and coffee break
- 3.45pm** 3D printing and the implications for intellectual property – Beth Ferrill, Finnegan, Henderson, Farabow, Garrett & Dunner

4.30pm Old law and new technology: how the law of damages and remedies fit a 21st-century market, Jonathan Moss, Hogarth Chambers

5.15pm Summary and closing words – Kate O'Rourke, ITMA President

5.30pm Drinks reception

7.00pm Close

OUR SEMINAR VENUE

We return to the Hyatt Regency in Birmingham, a modern, four-star hotel with a prime central location opposite the Library of Birmingham and five minutes' walk from the exclusive Mailbox and Bull Ring shopping centres.

Delegates are encouraged to secure their booking with the Hyatt Regency or an alternative hotel as early as possible due to high demand in the area at this time of year.

BOOKING DETAILS

Delegate place:

- ITMA members – **£225** (VAT exempt)
- Non-members – **£275** (VAT exempt)

Included in the delegate fee:

- Entry to all seminar sessions
- All seminar presentations post-event
- Delegate pack
- Coffee & tea breaks
- Two-course seated lunch
- Drinks reception & canapés

Drinks reception with canapés:

- ITMA members **£35** (ex-VAT)
- Non-members **£40** (ex-VAT)

CPD

- IPReg – five hours
- SRA – four hours (Ref WT/ITMA)
- BSB – four hours (Ref 1494)

was already registered in several countries by other individuals and companies. Of course, brand owners may also wish to delay registrations where the launch of a new product is a closely guarded secret (as is typical for Apple).

Traditionally, many companies file their trade mark applications well in advance of their products entering the consumer market, generally while products are still in their development phase. For innovative wearable technology, the proper terms or categories for classification of the goods and services may not yet exist. Accordingly, one should ensure that products are described by their traditional designation in addition to describing the functionality of the electronic device. Where a brand owner is unsure of the products or product lines that will be launched, it may consider listing all possible products and functionalities on a proposed-use basis, and then refine the description of goods and/or services at a later date.

For innovative product types, there is a need to develop neutral names for new classes of products to avoid an innovator company's trade mark becoming generic. Trade mark offices are attempting to address the need to provide consistent terminology for new products.

In the current version of the Nice international classification of goods and services, class 9 for goods includes the terms "smartwatches", "smartglasses" and "wearable activity trackers". WIPO continues to accept proposals for changes to the Nice classification from various national trade mark offices, but the expansion and amendment typically lags behind products' entry into the marketplace. Brand owners may therefore seek to proactively lobby for such changes. They should also complain about use of their trade marks in trade to describe product classes – with the aim of minimising the risk of

THE DEADLINE FOR BOOKING IS 9AM ON 29 SEPTEMBER 2016

invalidation on the basis of genericisation as a consequence of the brand owner's inactivity.

RELATIONSHIPS

Wearable goods are frequently marketed and co-branded between two companies, especially a fashion brand and a technology brand. This is the case, for example, in Fitbit's collaboration with Tory Burch, while Fossil watches have Google's Android operating system, and Hermès supplies straps for the Apple Watch. Accordingly, attention should be given to these business relationships and the possible impact on trade mark rights and registrations.

It may also be possible to protect wearable products through non-traditional trade marks, such as colour, sound and distinguishing guise (eg trade dress in the US) for non-functional design features. In conjunction with trade mark protection, companies with wearable products should also consider other forms of IP protection, such as design rights; industrial designs and design patents for the shape and design of the products; and patents (and utility patents in the US) for the underlying technology. For example, Apple has several registered Canadian industrial designs for the graphical user interfaces displayed on the Apple Watch, and a US utility patent was recently issued to Google for its electronic display device worn on the head of a user.

HOT MARKET

Wearables are a hot and fast-growing market. This year, Fitbit sold more than one million "Blaze" fitness trackers in the first month after launch. This is attracting new market entrants bringing rival products and, with them, increasing risks of infringement. Brand owners should ensure they continually monitor the marketplace for any activity infringing their marks or other IP.

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Wearables are a fast-growing market. This is attracting new market entrants bringing rival products and, with them, increasing risks of infringement. Brand owners should continually monitor the marketplace for any infringing activity

BEYOND IP

Looking beyond trade marks and other IP, brand owners should be aware of some of the reputational and liability risks of making their products "smart".

Wearable technology devices typically collect user data that is either personal in itself (such as height, weight, fitness levels, sleep hours, friends, credit card details, etc) or that could be sensitive when combined with other information (such as GPS coordinates when combined with who or what is located there). The General Data Protection Regulation, coming into force across the EU from May 2018, has increased the requirements for obtaining informed consent for data collection and set the fines for failure to protect personal data at the greater value of €20m or four per cent of worldwide annual turnover. Even if the financial liability can be passed on to a technology partner, any brand damage from data loss or hacking may be unavoidable.

Getting technology right is difficult, and companies such as Apple have created high consumer expectations. Brand owners should take care over their choice of technology partners to ensure that "user experience" –

including app design, compatibility, battery life, managing software updates, the obsolescence cycle, etc – is appropriate to the brand.

As more products interconnect and share data, brand owners need to be wary of services that "creep out" their customers. For example, some smartwatches and smartphones can be configured to listen continuously for search commands. Last year, concerns over smart TVs doing the same led to unflattering comparisons in the media with George Orwell's *Nineteen Eighty-Four*.

Clearly, there is much for brand owners to consider, and they may have little choice over whether to enter the market. First, consumer demand for wearables is growing: the (estimated) 12 million Apple Watches sold by a company with no previous presence in the watch market must have got the attention of the timepiece industry. Second, good wearable devices become embedded in a customer's lifestyle and may offer opportunities for daily interaction between a brand owner and its customers. This prize, therefore, is hopefully worth overcoming the attendant challenges. ■



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POSITION *of* PRIVILEGE

Reprising his Spring Conference address, Richmond Herald Clive Cheesman reveals the role of coats of arms and their unique place in trade mark practice

Coats of arms are a specific form of mark regulated by their own branch of law: the law of arms. The Crown operates control over them and their use since they are also technically in the nature of an honour. In today's world, for the corporate sector, this means they represent a sign of good reputation and standing.

The registration and use of coats of arms is administered on the Crown's behalf by the heralds, or "officers of arms". In England, Wales, Northern Ireland and much of the Commonwealth, the relevant heralds are those who work at the College of

Arms in London. In the first half of 2016, 70 new grants of arms were formally initiated, of which 10 are to corporate or impersonal bodies, including: local authorities; English universities celebrating their 50th anniversary; a Commonwealth university; a major public school; an unincorporated association; a computer-gaming company; and the British Olympic and Paralympic Associations, collectively known as Team GB (see Figure 1).

REGULATORY AUTHORITY

The College was first incorporated in 1484 and since 1522 it has been a regulatory authority on heraldic

matters. Its three senior officers have the delegated royal prerogative to grant new coats of arms to appropriate entities and individuals within their jurisdiction. Inclusion in the College's official records constitutes the defining criterion for the legality of a coat of arms. If a coat of arms is on record there, it is legally recognised as a coat of arms in the jurisdiction; if not, it is a heraldic-style mark, which – depending on the extent of the resemblance – ought to be subject to a proper grant before being used publicly.

INTERVENTIONS

The College is in regular contact with the UK IPO over applications to register marks that are identical to or resemble coats of arms, including marks that sample or hint at heraldic emblems. In some cases – such as that of Donald Trump (see Figure 2) – intervention by a heraldic authority has led to the regular grant of a new coat of arms to replace a mark that was uncomfortably close to an existing heraldic design. In such cases, the new and legitimate coat of arms invariably looks many times better than the unofficially created version.

Officers of arms also frequently advise proprietors of coats of arms on ways to use, deploy and protect their heraldic assets. While the place of the law of arms as a part of the law of England is clear, the most convenient judicial statement of the fact is in the 1954 case of *Manchester Corporation v Manchester Palace of Varieties*. Some of the features of this case may be a little surprising to trade mark practitioners. One is the distinction between “use” and “display”. The law of arms allows *bona fide* display of someone else's coat of arms in a way that does not amount to using the arms as one's own. The context will

affect what constitutes use, but there are well-established modes of unlabelled display (such as on buildings, vehicles, flags, corporate seals and letterheads) that are likely to create the impression that this is an instance of a person using their own coat of arms.

Other features of heraldic law to note are that a coat of arms cannot be alienated (granted on to a third party) by the grantee body. Nor can a grantee divest itself of its coat of arms unless the grant is expressly cancelled by the Crown or the heralds on the Crown's behalf, perhaps by a grant of different arms in lieu of and in substitution for the original one, which does sometimes happen. Even if the grantee ceases to exist, the coat of arms will continue to refer to it unless transferred by the Crown to another body. Successor bodies – even those defined in statute or otherwise as taking over all the rights, obligations, assets and liabilities of the grantee body – do not receive the coat of arms unless it is expressly transferred.

A coat of arms cannot technically be licensed for use by others, even partner or collaborator organisations; but, in line with the above, it can be displayed by others with explicit labelling that conveys the true ownership. This is helpful in an age in which so many public services are undertaken by private contractors in a long-term relationship with the relevant authority. It is quite normal and regular, for instance, to see the arms of a local council on the side of a dustcart that gives the name of the private contractor and says “working with” alongside the name of the council. The council can, of course, protect itself by retaining ownership of the artwork of the coat of arms and licensing that to its contractors.



Figure 1: Coat of arms granted to the British Olympic and Paralympic Associations in 2016, for use as Team GB in the Rio and subsequent Olympic and Paralympic Games.



Figure 2: Coat of arms of Trump International Golf Club Scotland Ltd, granted by the Scottish heraldic authority in 2012.



Figure 3: Three of the many versions of the coat of arms of the University of Oxford used by Oxford University Press. From *Representations of the Arms of the University of Oxford in use at the University Press and Elsewhere* (Oxford 1956).

As this point makes clear, coats of arms can benefit from protection from other parts of the law – either common or statutory. The royal arms are expressly protected by statute under Section 4(1) of the Trade Marks Act 1994 (TMA). An action for passing off may lie against someone using your coat of arms if you can meet the relevant criteria on harm and goodwill. Use of a coat of arms belonging to someone else in trade may also be subject to the Consumer Protection from Unfair Trading Regulations 2008, especially regulation 5(6), which covers the nature, rights and attributes of the trader. It also includes several points that are closely relevant to the role of heraldry. It is likely that you will possess copyright in at least some specific artwork of your coat of arms, and you can ensure that this is the one that people see and associate with you and your legitimate partners.

DIFFERENT APPROACH

And, of course, the proprietor of a coat of arms can register it as a trade mark – or, preferably, several versions of it. This is where another difference of approach between heraldry and trade mark practice becomes important.

Heraldry takes a very laid-back approach to type identity, in other words what constitutes the same coat of arms. Colour is ignored in the sense that monochrome versions of a given coat of arms – whether black and white or in shades of another colour – are automatically treated as identical to the colours laid down in the originating grant. It treats the main component parts – including the

“
*One coat of arms
 can be endlessly
 reinvented stylistically
 or artistically,
 retaining its identity
 across different versions*”

shield, crest and any supporters – as severable and independently protected. And, most importantly, it has regard to content rather than artistic style. Thus, three very different representations of the arms of the University of Oxford (see Figure 3, page 17) would be identical from a heraldic point of view, but it is unlikely that they would be treated as such under trade mark law. Evidently, the heraldic point of view is broader than the trade mark point of view.

One area where this observation may not apply is in relation to state emblems and official signs or hallmarks protected under Article 6ter of the Paris Convention, which is enacted domestically in Section 57 TMA. Here, the law prohibits not just precise copies but also “any imitation

from a heraldic point of view” – apparently inviting a very wide application. But the meaning of this provision is much discussed and its judicial application has been rather inconsistent. And it is unlikely, for the time being at any rate, that wider trade mark practice will converge with that relating to state emblems on this point. The advice for a body that has a coat of arms and wishes to use it commercially must therefore be to register a range of versions of it. Professional advice from the College of Arms can be helpful in the selection of appropriate and correct versions of coats of arms.

PARTNERSHIP POTENTIAL

Coats of arms work very well as trade marks, and the flexible approach that heraldry takes to the identity of an individual coat of arms means that one coat of arms can be endlessly reinvented stylistically or artistically. It retains its identity across versions while achieving quite radically different looks. Due to the exclusively privileged position that the grantee body has in relation to its own coat of arms, at least when it comes to registering marks, it alone can exploit this infinite reinventability. Despite differences of approach, it may be no exaggeration to say that heraldry and the world of trade marks have great potential to work in partnership. ■



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Clive spoke on this topic at the ITMA Spring Conference in March.



Of rogue waves and crosswinds

Cheng Tan reflects on the ironic timing of discussions of EU change

Set in stunning Dubrovnik, the European Communities Trade Mark Association (ECTA) Annual Conference (under the banner of “Rogue Waves and Crosswinds”) was intended to focus the mind on the challenging and fast-changing issues in IP.

Most sessions were dedicated to the latest changes in the reformed EU trade mark system. Discussions surrounding the new criteria were given considerable attention. Examples of sound, smell and taste marks were considered, as were some likely exclusions applying to perfume, due to its arguably functional purpose. Other examples, such as tartan designs and red soles, which give substantial value to goods, could also be excluded. Many such questions have been posed, and answers are awaited from EUIPO.

PERTINENT CONTENT

On the issue of Article 28 (8) of Council Regulation (EC) No 207/2009 (EUTMR), it was noted that declarations to amend specifications to reflect more accurately the goods/services provided have not been overwhelming, with about 1,100 declarations received by EUIPO. This may be a reflection of a prevailing attitude that partial surrender when the time comes could be a better option than filing a declaration within the timescale provided.

On the issue of seizure of counterfeit goods, Sylvie Harding (Senior Counsel, Trade Mark and Anti-Counterfeit Department, Chanel, France), discussed small-consignment procedure and provided valuable insight on the balancing act of costs against compensation where storage and destruction costs have a significant impact on a company’s enforcement strategy. Ninoslav Babić of Croatia’s

Customs Directorate discussed the application of Philips v Nokia in the recent customs enforcement of goods in transit, and contrasted this with the common-sense approach adopted by Croatia even prior to joining the EU.

Emil Tedeschi, President and CEO, Atlantica Grupa, Croatia, gave the inspiring keynote speech, and Mladen Vukmir, of Vukmir & Associates, Croatia, gave a charismatic presentation on “The past and the future of intangible assets in a digital, networked world”.

During a series of split sessions, I was particularly impressed by three speakers. Dr Florian Drücke provided insight into the challenges of digitisation in the music industry, and how legal action against internet piracy has led to a significant decline in such piracy in Germany. Léon Dijkman spoke on copyright and the internet of things, and posed questions on smart objects being authors of copyrighted works. Finally, Professor Niklas Bruun spoke on copyright exception and contrasted this with fair use with reference to: the Marrakesh Treaty 2013; Article 13 of the Agreement on Trade-Related Aspects of Intellectual Property Rights; the InfoSoc Directive; and the US debate on the scope of the fair-use exception.

APPRECIATIVE AUDIENCE

Many delegates remarked that Friday afternoon’s session with Mr Justice Arnold, “Infringement under Article 10(2) (a) of the Directive and the effect on the functions of the trade mark”, was especially worthwhile. In addition, an update on the case law of the Board of Appeal and the Court of Justice by Christoph Bartos (Member, Boards of Appeal, EUIPO) was helpful in comparing the position of the courts in assessment of absolute grounds of refusal. Meanwhile, Fabio Angelini (ECTA Council member, and Attorney, De Simone and Partners, Italy) expounded the case of Iron & Smith v Unilever and the application of Article 8(5) EUTMR.

Evening events included a welcome reception on Copacabana Beach and an evening at the Lazareti complex, one of the world’s first quarantine compounds. The conference came to an end with an elegant gala dinner.

The ECTA Conference hailed Croatia as one of the newer members of the EU, so it was somewhat ironic that the outcome of the UK’s EU Referendum vote was announced on its last day. Little did we know that “rogue waves and crosswinds” would serve, too, as an apt description of the days beyond. ■



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INNOVATION ROLLS ON

Sarah Barber attended our recent event at which our honoured speaker explained the evolution of the IPEC and other court forums

In his latest talk outlining the recent changes and initiatives in the Rolls Building, Mr Justice Colin Birss looked back on the success of the Intellectual Property Enterprise Court (IPEC) in recent years, and how the lessons learned from it can be implemented in other court forums. Sir Colin noted the IPEC's ability to handle a multitude of cases, its encouragement and examination of a range of different points of law, and its potential to offer dispute resolution on a more commercial timescale. In particular, he credited the IPEC's ongoing success to its well-structured procedures, streamlined processes and protocol, and hands-on approach.

The Judge then touched upon the impetus for introducing the Shorter Trial Scheme and Flexible Trial Scheme, which followed a recommendation by a working group of judges seeking to achieve shorter and earlier trials. The courts situated in the Rolls Building have been operating a pilot for these schemes since October 2015, and will continue for a period of two years until September 2017. Sir Colin explained that the schemes were designed to take the key attributes of the IPEC and attempt to replicate its success

in the High Court. Both schemes seek to offer parties the opportunity to resolve disputes in a substantially shorter period of time, at a reduced cost, and are intended for commercial and business cases not requiring extensive disclosure or witness or expert evidence.

UPTAKE ENCOURAGED

As expected with the introduction of all new systems, there has been a relatively slow uptake of both schemes by litigants, with only 10 cases having adopted the Shorter Trial Scheme at the time of writing, and no parties yet adopting the Flexible Trial Scheme. Sir Colin, however, highlighted the importance of parties considering the schemes in order to support the concept and fully take advantage of the streamlined procedures and case management that they offer. He noted that if parties do not use the schemes they are unlikely to be permanently adopted.

The key difference between the Shorter Trial Scheme and the Flexible Trial Scheme (both of which are governed by Practice Direction 51N of the Civil Procedure Rules) is that the former adopts a more traditional, court-controlled approach. In contrast,



The Shorter Trial Scheme and Flexible Trial Scheme were designed to take the key attributes of the IPEC and attempt to replicate its success in the High Court



ALAMY

under the Flexible Trial Scheme, the parties maintain greater control over the litigation process, with the court usually enforcing and adopting the outcomes agreed between the parties. The latter scheme is thus based on the flexible and consensual approach favoured by arbitration proceedings, resulting in a more expedited procedure than the full trial procedure currently provided for under the Civil Procedure Rules.

Mr Justice Birss also detailed the various benefits of using the Shorter Trial Scheme, including the opportunity to be assigned a docketed judge (a designated judge with relevant expertise, who is, as far as possible, assigned the case for the duration), a concept that has been successful in the IPEC and has allowed judges to participate in active case management. Other notable features include the advantage of having a trial date fixed not more than eight months after the case management conference, with judgment six weeks thereafter.

CONTAINED PROCESS

The new schemes also benefit from the trial being contained to four days, including reading time. Equally, the schemes promote a strict management of time, a controlled cross-examination with only the principal part of the case being put

to the judge. Lastly, costs budgeting will not be applicable; instead, costs will be assessed summarily.

On the theme of efficiency, Sir Colin discussed a further Rolls Building initiative: the introduction of a new electronic file- and document-management system, CE-File. Practice Direction 51O provides the framework for the implementation of this new e-filing system, which will have an impact on how parties interact with the court. CE-File was first piloted in the Technology and Construction Court and, from October 2016, will be extended to all forums within the Rolls Building. CE-File is set to make it mandatory for firms to provide the court with forms, applications and general court correspondence electronically. The objective of the system is to modernise the way parties interact with the court and also provide the court with an easily accessible and searchable database to improve internal efficiency. It is hoped that the implementation of electronic filing will simplify legal proceedings and assist litigants in person. CE-File will not replace the requirement to file

hard-copy paper bundles. This is, however, on the court's radar.

FURTHER CHANGE AHEAD

Mr Justice Birss also discussed the recent Briggs report, which analysed the current workload of the Court of Appeal. It was noted that the Court is operating over capacity, and reform will be needed to ensure that its future efficiency and quality are maintained. It is therefore proposed that the High Court be used as the forum for appeals from the County Court, in an attempt to reduce the caseload. While this will relieve pressure on the Court of Appeal, it will undoubtedly add to the workload of the High Court. Sir Colin also discussed the implementation of an online court to provide a new forum for smaller-value claims (up to £25,000), which, it is hoped, will streamline the process and improve access to justice for litigants in person.

It was clear from Sir Colin's entertaining and informative talk that the Rolls Building is evolving to adapt to modern litigation and is prepared to be innovative to achieve its objectives. ■



Sarah Barber

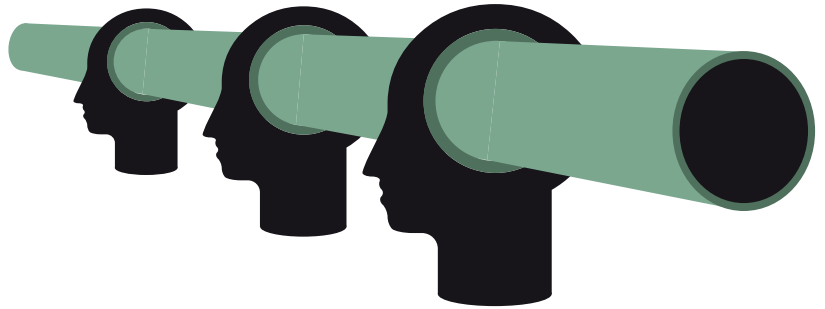
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WE ARE
the weakest
LINK

*When it comes to bias, every one of us
has to shoulder some blame.
Jon Atkins explains why*



If they are being honest, most HR professionals and business leaders will admit the diversity movement has stalled. While the concepts of equality, diversity and inclusion have been debated for decades, and diversity training exists in one form or another in most organisations, it doesn't take a genius to realise that progress has been slow. Most organisations still struggle to achieve fairness and inclusion as a standard.

Nonetheless, the benefits of diversity and inclusion (D&I) are clear. A two-year study by Deloitte, published in 2015, concluded that organisations that truly embed D&I into talent-management strategies and leadership development: experience 2.3 times higher cash flow per employee over a three-year period; are 1.7 times more likely to be seen as innovative leaders in their industry; will be 3.8 times more able to coach people for improved performance; and are 2.9 times more likely to identify and build future leaders.

While this business case is strong, you've got to ask yourself why we even need one. Surely creating a culture in which people feel valued and respected



We have spent too long considering the financial returns from D&I and not enough time focusing on the weakest link in the chain: us

for what they do is simply common sense? We don't seem to need a business case for health and safety, so why do we need one for D&I?

Herein lies the issue. The key reason for slow progress in this space is that we have spent too

long considering the financial returns from D&I and not enough time focusing on the weakest link in the chain: us. As human beings, we are the ones who make the decisions on who to hire or fire, who to engage with or ignore, and who to support or exclude.

Unfortunately, as much as we like to think of ourselves as rational, objective and fair when making such decisions, the reality can be quite different.

'SIMPLE' PROBLEMS

Take a look at this puzzle:

A bat and a ball together cost £1.10.

The bat costs £1 more than the ball.

How much does the ball cost?

If you're like most people, your instincts will tell you the ball costs 10p. And like most people, you are wrong. Look again. The ball costs 5p. Work backwards from your instinctive answer. If the ball costs 10p, then the bat must cost £1.10, leading to a grand total of £1.20. Do the same with the starting point of the ball costing 5p, and you arrive at a different – and correct – answer.

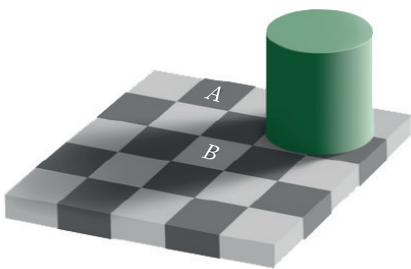
PSYCHOLOGICAL PUZZLE

This is one of many puzzles and illusions that psychologists have been using for years to provide insight into how our minds work. In this instance, our minds substitute a complex problem for one that is easier.

As readers may remember from Dr Christian Scheier's article in the March/April 2016 issue of the

ITMA Review, Nobel Prize-winning Professor Daniel Kahneman coined the terms “System 1 thinking” and “System 2 thinking” as ways of further illustrating how our minds work. System 1 (“fast”) thinking is a tendency to approach situations and decisions quickly and on autopilot. By contrast, System 2 (“slow”) thinking allocates more conscious attention and effort to complex problems, analysing and computing data more objectively. In situations that demand a more considered approach (eg who to select from a round of interviews), we should rely on System 2. However, in reality, we tend to default more to System 1, using intuition to guide our judgments. We are inherently lazy in the way we think, and this can lead to bias creeping into our decisions.

Look at the picture below and ask yourself if the square marked “A” looks darker, lighter or the same shade of grey as the square marked “B”.



This is an optical illusion created by Edward Adelson, Professor of Vision Science at Massachusetts Institute of Technology. While square A looks darker than square B, they are in fact identical shades of grey. If you don't believe me, cut them out and compare them – you will be surprised!

However, we struggle to convince the unconscious part of our minds of the reality. Instead, our unconscious trawls through huge data sets of past experiences of checkerboards (dark

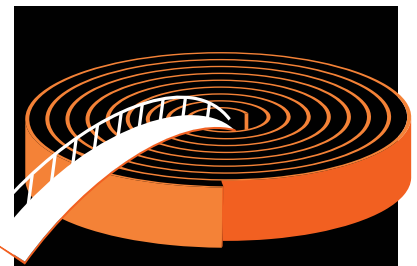
squares next to light squares) and the effect of shadows (making things appear darker than they probably are) and uses these to guide our expectations of what we should see. Such expectations lead to confirmation bias, or a tendency to look for things that confirm our often unconscious conclusions, rather than objectively interpreting what is in front of us.

Let's do another exercise. Quickly count up how many times the letter “F” appears in the sentence below.

FINISHED FILES ARE THE RESULT OF YEARS OF SCIENTIFIC STUDY COMBINED WITH THE EXPERIENCE OF YEARS

The correct answer is six. For those who spotted three, you are not alone. I would bet that you missed the word “of” three times. This is another potential source of bias called selection attention. In effect, we attune ourselves to information that we think we need to make an accurate decision, but in reality our unconscious is constantly filtering information, leading us to overlook critical data.

Taken together, these examples are just a small illustration of how our mind processes information and can lead us to make faulty, even biased, decisions. Consider a typical recruitment situation in which you are interviewing a number of diverse candidates. Your desire is to make a fair decision based on merit and capability. However, you notice from their CV that one candidate has worked for Company X. You have past experience of people from Company X and have built a stereotype that such people tend to be “geeky, analytical and a little socially weird”. A reliance on System 1 thinking coupled with confirmation bias and selection attention means you spend the



RESEARCH ROUND-UP: UNCONSCIOUS BIAS IN SELECTION

- Some researchers suggest it takes approximately **120 milliseconds** to unconsciously identify the colour of someone's skin. We recognise this before anything else about them.
- Women are **just as likely** to have a gender bias as men, challenging the view that diverse interview panels (for example) will lead to fairer selection decisions.
- In a **60-minute** job interview, the decision whether to hire someone is made in the **first four minutes**. The rest of the time is spent reinforcing that decision.
- **Tall, good-looking men** are more likely to get the job and receive a higher starting salary.
- When identical application forms were sent to *The Times'* top 100 companies, **50 per cent** selected Andrew Evans but rejected Ramesh Patel.



whole interview attuning yourself to information that simply supports your unconscious beliefs and intuitive judgment that the candidate is, indeed, a weirdo.

However, ask yourself honestly, did you make the right decision? Did you make a fair decision? Or did you just rely on stereotypes and unconscious biases?

The research on this is clear. We are all biased. And this is natural. Such biases are products of our evolution, our upbringing and the society around us. What matters are the conscious actions you take to mitigate against the risks of unconscious bias.

WHAT CAN YOU DO?

Well, first, accept that we are all biased and acknowledge the impact it can have. Legislation has its place, but individuals have a responsibility to identify, accept and manage their own biases.

It is then up to organisations to motivate people to change. Training and contact with others can help create an environment in which people can challenge bias where they see it. It is also important to create conditions that are favourable for fair, objective and consistent people-related decisions (for example, through the use of inclusive competency frameworks and the application of robust talent-management systems).

Finally, it is up to leaders to model effective behaviour and demonstrate inclusive leadership. Research shows that leaders who are recognised as being more inclusive will see increases in employee engagement

UNDERSTANDING YOUR BIAS: A SIMPLE STRATEGY

Harvard University's implicit-association test is a long-established and well-proven tool for understanding our own unconscious biases. This simple, free-to-do test asks you to pair words associated with two constructs, for example male and female names paired with words associated with family or words associated with careers. By recording the speed with which pairs of words are associated at an unconscious level (eg male names with career-centric words), it can pick up on a subconscious link whereby you may naturally associate men with work and women with family. While we may not like to think we have an underlying gender bias, this test provides excellent insight into the reality of our unconscious biases.

Find out more at implicit.harvard.edu

and discretionary effort, higher levels of productivity and creativity, and lower levels of staff turnover.

So, while society has become less tolerant of explicit prejudice and stereotyping, this does not mean they have gone away. Instead, the nature of bias has simply changed; it has become more subtle and unconscious, but is nevertheless still there. Left unchecked, it can create barriers to developing a diverse workforce, so organisations need to be innovative and creative.

Ultimately, we need to change the way we view D&I and the actions we take in this space. The traditional approaches – creating a diversity strategy, training on legislation and raising awareness of the business case – are all valuable. But they are not enough. It is only through a better understanding of how we think, make decisions and forge relationships that we can really get to grips with the challenge ahead. ■

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While society has become less tolerant of explicit prejudice and stereotyping, this does not mean they have gone away



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Battle over the PAPA bottle

Jennifer D Fajelagutan explains how the Philippines Supreme Court recently reasserted its strength

In 2002, Barrio Fiesta Manufacturing Corporation sought to register the “Papa Boy and device” mark in class 30 for *lechon* (roast pork) sauce, a popular Filipino condiment. UFC Philippines Inc, a subsidiary of Nutri Asia Inc and proprietor of the PAPA mark since the 1980s – which is registered *inter alia* for banana ketchup sauce in class 29 – opposed the application. Both marks are shown below.

Nutri Asia’s opposition was based on the following grounds: the marks were confusingly similar; its mark was an earlier-registered mark; approval of the Barrio Fiesta mark would violate its rights to the exclusive use of its registered PAPA mark and its variations thereof; approval of Barrio Fiesta’s mark would cause damage to Nutri Asia; and Barrio Fiesta filed its mark in bad faith.

In 2008, the Bureau of Legal Affairs of the Intellectual Property Office of the Philippines (IPOPHL) found in favour of Nutri Asia and refused Barrio Fiesta’s application. Unsatisfied, Barrio Fiesta petitioned the Court of Appeal (CA). The CA adopted the holistic test – whereby both marks are considered as a whole in order to determine confusing similarity – and held that Barrio Fiesta’s application be allowed registration.

ESCALATION

The matter was escalated all the way to the Supreme Court of the Philippines (SC), which found in favour of Nutri Asia and upheld the IPOPHL’s findings. The SC ruled that the CA erred in adopting the holistic test, given the nature of the products, and in reversing the decision of the IPOPHL.

The SC held that both products were regarded as everyday all-purpose products, likely to be found near each other in grocery stores and not subject to great attention among consumers. Approval would be likely to lead to public confusion, and Nutri Asia’s extensive goodwill would inadvertently be associated with Barrio Fiesta’s products.

In considering similarity, the SC agreed with the IPOPHL that the dominant feature of Barrio Fiesta’s mark was the word “papa”, located at the top of the mark and therefore drawing the attention of consumers. The SC also agreed that the phrase “papa boy” would dominate a consumer’s memory. Imperfect consumer recollection meant that the origin of both products may be confused by the public.

The SC also considered the concept of notional fair use. It was concerned that if Barrio Fiesta’s registration were allowed it would almost certainly prevent Nutri Asia from expanding its scope of business to include *lechon* sauce, and acquiring and enjoying further IP rights and protection.

IRONIC RULING

The SC ruled that the CA was wrong in finding that “papa” – a common term for a father – was a word over which Nutri Asia could not claim exclusive ownership. Ironically, it held that this was just why the term “papa” could be used in this regard. A father has no logical bearing to banana ketchup, which therefore affords the mark sufficient distinctiveness. The SC reiterated that the PAPA registration by Nutri Asia reflected the family name of the original owner of the brand, Neri Papa. It noted that the mark had been used commercially since the 1950s, establishing awareness and extensive goodwill among consumers.

The SC in its judgment stated that: “The findings of fact of the highly technical agency, the IPOPHL, which has expertise in this field, should have been given greater weight by the Court of Appeal.” This shows the significance of the IPOPHL’s decisions. ■

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Imperfect consumer recollection meant that the origin of both products may be confused by the public

Petitioner’s mark



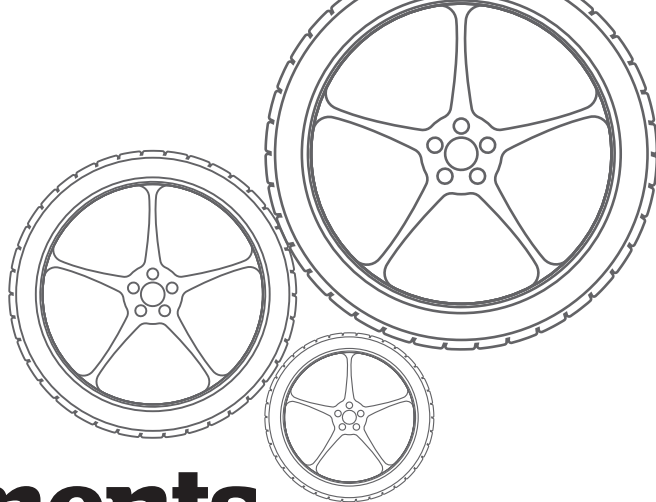
Respondent’s mark



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Initial arguments

Martin Delafaille believes there remains a ray of light for Volkswagen, despite a loss

THIS WAS AN unsuccessful appeal by car manufacturer Volkswagen AG against the Hearing Officer's decision to reject its opposition to an application for the word mark V W DERRINGTON in class 12 for "automobile steering wheels; automobile wheels; fuel lines for vehicles; motor cars for racing; racing motor cars; [and] rearview mirrors". The grounds of opposition were Sections 5(4)(a) and 5(2)(b) of the Trade Marks Act 1994. The thrust of Volkswagen's appeal was that it did not agree with the Hearing Officer's conclusions on how members of the public would perceive the mark.

TWOFOLD APPEAL

Volkswagen relied on its passing off rights under Section 5(4)(a), and the appeal was twofold.

First, Volkswagen argued that the Hearing Officer did not give sufficient weight to the strength of its goodwill in VW. However, this argument was a non-starter. The Appointed Person (AP), Daniel Alexander QC, concluded that the Hearing Officer had not only clearly acknowledged that Volkswagen's goodwill was very strong, but had also rejected the Applicants' claims that they had earlier unregistered rights.

Second, Volkswagen contended that the Hearing Officer had failed to perform a proper comparison of the marks, and so wrongly concluded that there was no misrepresentation. This line of argument

also failed as the AP agreed with both the Hearing Officer's detailed analysis and his conclusion that the addition of the surname Derrington meant the mark would be perceived as "a name with initials", and not, for example, a Volkswagen dealership or sub-brand. He concluded that a substantial number of consumers would not be deceived into believing there was an economic link between the Applicants and Volkswagen.

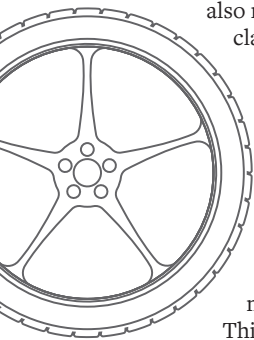
The AP applied the same reasoning to Section 5(2)(b). Although it was held that the VW mark was "strongly distinctive", the fact that consumers of motor vehicles generally take a good deal of care when making their purchasing decisions led to the Hearing Officer's conclusion that the average consumer was unlikely to be confused on the distinction between VW and V W DERRINGTON.

TAKE-AWAY POINTS

At first glance this outcome is perhaps surprising, given that VW is widely recognised as a trade mark of Volkswagen. However, the AP reaffirmed that appeals of this kind are not by way of a rehearing, but are reviews. As the Hearing Officer's decision was carefully considered, he did not err in principle and he was clearly not wrong in that the appeal had to fail.

It is likely that Volkswagen expected, as would many other famous brand owners, that the Applicants would immediately cave in and withdraw their application. However, since the opposition failed, Volkswagen probably had little choice but to launch an appeal.

In any event, as the AP rightly highlighted, while the Applicants now have a trade mark that includes V W, it could be used in an "unfair way" – for example, if V W was larger than or in a different colour to DERRINGTON. This could give rise to a cause of action for passing off, which means that all is not lost for Volkswagen.



SERGEY KOHL / SHUTTERSTOCK.COM



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Shield proves powerful



Rosalyn Newsome wonders whether there was some sympathy for the Opponent's appeal, despite a decision to dismiss

THIS DECISION CONCERNS

UK application No 2619857 for SUPERFOODS NATURE'S BEST SELLERS! (logo) in classes 5, 35 and 42 in the name of Pharm Med Limited (the Applicant), which was opposed by Merck Consumer Healthcare (the Opponent) on the basis of its prior use and registration of NATURE'S BEST. Opposition was filed on the basis of Sections 5(2)(b), 5(3) and 5(4) of the Trade Marks Act 1994, but was unsuccessful under each claim. Merck appealed on five grounds, but the appeal failed on each.

VISUAL SIMILARITIES

Comparisons of the marks occurred, applying the principles of *Medion v Thomson*, and concluded that a low degree of visual similarity existed between the earlier word mark NATURE'S BEST and the Applicant's complex logo mark (see right). The additional element of the shield was deemed visually dominant in the Applicant's mark.

The aural similarity was "very low", as the Applicant's mark was likely to be referred to as SUPERFOODS, with no reference to the overlapping element NATURE'S BEST. It was acknowledged that some conceptual similarity existed between the marks; however, the allusion to SUPERFOODS in the Applicant's mark created a conceptual gap between it and the earlier mark. On appeal, the Appointed Person (AP) therefore concluded that the Hearing Officer had correctly applied the principles of *Medion*.

Another ground for appeal was a failure to correctly apply the interdependency principle.

In making a decision, the Hearing Officer referenced *Canon v Metro-Goldwyn-Mayer* and *Sabel v Puma*, and concluded that, as the trade marks only had a very low degree of similarity, with a number of distinguishing features, this must mean there was no likelihood of confusion arising, despite the identical nature of some of the goods. Again, the AP supported the Hearing Officer's evaluation and rejected this ground of appeal.

The Opponent criticised the Hearing Officer for failing to adequately evaluate the distinctiveness of its mark and the associated goodwill. This criticism was dismissed. The Hearing Officer concluded that NATURE'S BEST had a relatively weak distinctive character, which was supported by the fact that it only secured registration on the basis of acquired distinctiveness. Although the Opponent provided examples of adverts in national newspapers from 2005–2012, there was no context provided around the circulation figures, and thus the exposure the adverts created. Similarly, sales figures provided no indication of units sold or the market share held by the Opponent. This is a stark reminder that facts and figures, without context, are never going to be sufficient to support alleged goodwill and/or reputation.

Finally, a discussion followed as to the level of attention likely to be paid

to nutritional supplements by the average consumer. The Hearing Officer concluded that "the average position is that such purchases are likely to be at least reasonably considered". While the AP was critical of the word "average" in the original assessment, the fact that the overall conclusion held the purchases would be "reasonably considered" meant the assessment was upheld.

AP SYMPATHETIC?

In dismissing the appeal, the AP observed that: "It struck me in considering the case that the mark applied for was slightly odd in that the term NATURE'S BEST SELLERS seemed like a somewhat artificial designation which may have been chosen to make a subtle association, albeit falling short of a link of the kind required by Section 5(3)."

Did this mean the AP had some sympathy with the Opponent? Possibly, but due to the deficiencies in the evidence submitted and the lack of contextual industry information, there was no scope to overturn the decision under Section 5(3).

UK application No 2619857



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An original dilemma

This decision flagged up interesting issues related to what constitutes in-country use, says Chris Morris

THIS CASE CONCERNED non-use revocation actions against UK trade marks owned by Johnny Rockets: all variants on the Johnny Rockets name/logo covering restaurant services. The unusual element in the case was that all the use made of the challenged marks was on board cruise ships operating under a foreign flag.

At first instance, the Hearing Officer found that there was no use of the marks in the UK and, therefore, they must be cancelled. Johnny Rockets contended that it was wrong to find that restaurants on cruise ships, which carry UK customers and travel in and around the UK, do not constitute use in the UK.

Because the Hearing Officer appeared to draw a distinction between the UK (as a land mass) and its territorial waters, and seemingly reached his conclusions on the basis of land (non-) use only, the Appointed Person (AP) considered it necessary to consider afresh whether use on board a ship is genuine use, for the purpose of a Section 46 revocation claim.

CONSIDERATIONS

The AP found that:

- it is clear the Trade Marks Act 1994 extends and applies to foreign ships in UK waters; and,
- if a customer buys services in the UK, which it enjoys outside of the UK, this might be use in the UK.

The AP then referred to the UN Convention on the Law of the Sea and the concept of “innocent passage”. A finding that a shipboard third party was using a trade mark in the course of trade (ie infringement) while the ship was passing through the UK’s

territorial waters would interfere with innocent passage. On that basis, any use of a trade mark on board a foreign ship that is engaged in innocent passage through UK waters is not use in the UK and cannot be taken into account for the purposes of assessing genuine use.

In terms of booking the cruise, the fact that UK customers may board a ship and have services provided while on board is not relevant. The transaction that took place while in the UK was a decision to take a cruise. That purchase increases market share for a cruise company, not the restaurant market for an on-board establishment (the AP likened the position of “all-inclusive” cruises to that of earlier decisions around free gifts).

A mark is, however, used in the UK while the ship is docked in the UK.

DECISION

Having concluded that use “at sea” is not relevant, the findings by the Hearing Officer that UK passengers would likely have dined at Johnny Rockets is not material.

Promoting dining opportunities at Johnny Rockets on the cruise company’s UK website was also not relevant. Adverts and sales served, as discussed above, to increase the cruise company’s share of the market, and

was not relevant to restaurant services. There was no evidence of pre-departure reservations being made.

The appeal was dismissed and the marks revoked.

INTERESTING TWIST

This case is an interesting twist on revocation actions (and passing off cases) where use is not self-evidently in the UK. It raises the question of the limits of territorial protection for trade marks: when would use on board a ship constitute infringement of any national rights?

The AP did stress that the decision may have been different had the ships sailed under a British flag (potentially, though controversially, rendering it “British territory” regardless of geographical location) or if a foreign ship’s workload substantially involved travel between two UK ports.



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THE LONG ROAD taken towards implementing The Standardised Packaging of Tobacco Products Regulations (the Regulations) reached a (potentially) decisive point with Mr Justice Green's mammoth decision on the judicial review, which was jointly launched by the four biggest tobacco producers in the UK (the Claimants).

The review was based on a large array of grounds, ranging from the legality of the European Directive on which the Regulations are based, to how the evidence provided by the tobacco companies was treated during the consultation period. It also covered the proportionality of the Regulations and the violation of the principle of respect for property.

For the trade mark community, the most relevant grounds discussed in the judgment relate to whether the Regulations amounted to an expropriation of trade mark rights without adequate compensation.

EXPROPRIATION V CONTROL OF USE

The Claimants submitted that the Regulations constituted a *de facto* expropriation of their trade mark rights, as the Regulations curtailed their ability to use the marks in such a manner, meaning that the "real world" substance of the trade marks was destroyed. The argument involved a consideration of whether trade mark rights are negative in nature (for example, to prevent use of the mark by a third party) as argued by the

Secretary of State on behalf of the Government, or positive in nature (for example, to be the subject of commercial exploitation), as argued by the Claimants.

Green J agreed with the Claimants that the economic value of the trade marks lay with their use, as well as their ability to exclude a third party's use. However, although he conceded that the substance of the trade mark rights had been significantly and even substantially diminished, he considered that it had not been wholly destroyed, as the Regulations still allowed for the brand and the product variant to appear within the packaging (albeit in a very circumscribed manner and in a standardised font).

In the Judge's view, there was no expropriation and the Regulations merely amounted to control of use: the trade marks remain the property of the Claimants and the restrictions were far from total, as the Claimants remained entitled to affix a brand name and the name of their own manufacturer to the packaging.

The Judge indicated that the trade marks could still perform the function attributed to them by EU law, both in terms of preventing unauthorised use and as a badge of origin. However, it is notable that his findings focused solely on the origin function, and there was no mention of the loss of other trade mark functions, such as investment or advertising. At first sight, it seems clear that such functions will suffer from the Regulations' implementation.



There was no mention of the loss of other trade mark functions, such as investment or advertising

Plain packaging: *new perils*

Roberto Pescador sees the potential for public policy to trump brand owners' rights following this long-awaited decision



The treatment of non-word marks seems to be very controversial. The Claimants argued that, even if the Court's reasoning above was legitimate in relation to word marks, figurative marks would be more severely affected: they are independent and important property rights, and the Regulations effectively prevent their use altogether.

The Judge concluded that his findings applied to the Claimants' trade marks when viewed collectively, regardless of whether they are word or figurative marks. While he accepted that non-word trade marks are in theory independent property rights, he stated that the commercial role they have played over a long period of time has been complementary to word marks. This is because of the legal restrictions on advertising tobacco products which, the Judge concluded, prevented non-word marks developing an ability to be seen as identifiers of origin on their own.

DIFFICULT REASONING

In my view, Green J's findings in relation to non-word marks are difficult to reconcile with basic principles of trade mark law.

First, no assessment based on the perception by the relevant public was carried out. The relevant public would be the members of the population over 18 years old who smoke and who, when purchasing a packet of

cigarettes, would, for example, identify the red roof of Marlboro or Camel's depiction of a camel in the Egyptian desert as identifiers of origin of a particular product. This demographic would likely recognise those identifiers even when they appear on their own and where no advertising has been made. In fact, when the initial advertising restrictions on tobacco products were introduced in the late 90s, the get-up of tobacco brands was used on its own, raising awareness as badges of origin. For example, the liveries of Formula 1 cars, many of which were sponsored by tobacco companies, removed word marks but maintained for some time distinctive elements of the relevant brand.

VALUE RETENTION

It is also unclear how figurative marks can retain any value where they cannot be used in relation to the products at all. Green J stated that, following Regulation 13 (which relates to the preservation of trade mark rights and features measures to prevent the cancellation of registrations on the grounds of non-use), the registrations

as such are not affected. This might be the case from a theoretical point of view, but, in the "real world" (to mimic the expression used in the judgment), it is difficult to understand how these registrations can be of any use to their owners. They will not be able to use them in relation to tobacco products, and it seems unlikely that the marks will retain any value to be relied upon in a reputation claim.

POLICY PRECEDENT

All in all, the decision seems to be heavily driven by public policy, trumping other rights – such as trade mark rights – along the way. It might also set a precedent whereby public-health grounds could deprive other industries that promote particular types of lifestyle that have a proven impact on the health of consumers. This would have an effect on branding, whether in relation to alcoholic beverages, sugary drinks or fast food.

However, it also appears that some of the Claimants are considering an appeal of the decision, so we might see yet another chapter in the plain-packaging saga.



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Bird & Bird was not involved in this case, but has previously acted for Philip Morris in relation to plain-packaging issues.

Saving grace for series marks

At last there is certainty around the compatibility of these marks with EU law, as Nick Smees explains



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THE COURT OF APPEAL has held that the practice of registering trade marks as a series does not contravene the EU requirement that a trade mark must be capable of being represented in a clear, self-contained, easily accessible, intelligible, durable and objective manner. The decision removes the uncertainty over the validity of tens of thousands of UK marks registered in this way, and means that this practice can continue.

The decision also marks another victory for Comic Enterprises Ltd (Comic) in its long-running dispute with Twentieth Century Fox Film Corporation (Fox) over hit TV show *Glee*.

THE APPEAL

Comic operates a chain of live comedy and music venues in the UK. It brought trade mark and passing off proceedings against Fox in September 2011. In February 2014, the High Court found that Fox had infringed Comic's trade marks, but that its activities did not amount to passing off.

Fox appealed the decision, and in February 2016 the Court of Appeal

upheld the High Court's findings on both trade mark infringement and passing off, but leaving one final issue to be heard and decided.

SERIES OF TRADE MARKS

Comic is the registered owner of a series of two marks, depicted opposite, that has been registered since 1999 for a range of services relating to the provision of live comedy and music.

A "series of trade marks" is defined in Section 41 (2) of the Trade Marks Act 1994 as a number of trade marks that resemble each other as to their material particulars, and differ only in non-distinctive ways not affecting their identity. The practice of registering trade marks as a series can help to streamline the examination procedure, and in return the UK IPO offers applicants a discounted filing fee.

Fox contended that Comic's trade mark, being a series mark, is not "a sign" in the sense of being a single sign, and/or is not capable of being "graphically represented" within the meaning of Articles 2 and 3 of the Trade Marks Directive.

These requirements of EU trade mark law were interpreted by the

CJEU in a series of decisions dealing with "exotic" marks, starting with Sieckmann. The decisions made it clear that a "sign" must be capable of being "represented graphically" in "a clear, precise, self-contained, easily accessible, intelligible, durable and objective way". It is worth noting that these requirements have since been enshrined in the new Trade Marks Directive, which requires that a sign must be 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". Series marks fall foul of these requirements, argued Fox.

EU PRINCIPLES

Following the reasoning of Richard Arnold QC (as he then was) in Sony Ericsson, Fox argued that series marks took effect as a registration of a single trade mark. Mr Arnold had noted in particular that the concluding words of Section 41 (2) refer to the identity of "the trade mark" (in the singular). It followed that it was necessary to identify a "single point of comparison"

between all of the marks in the series for the purpose of assessing infringement. Fox contended that this was inevitably an uncertain exercise and so was contrary to the established EU principles.

Given the potentially widespread repercussions of this issue, the Court of Appeal invited the Comptroller General of Patents, Designs and Trade Marks to attend the hearing. The Comptroller argued that a series of trade marks is actually a bundle of individual trade marks, albeit under a single registration number, each of which is individually entitled to the protection afforded to every trade mark under EU law.

MEETING CRITERIA

The Court of Appeal agreed with the Comptroller, holding that a series of trade marks gives rise to a bundle of individual marks. It followed that such marks were capable of satisfying the EU's "clear and precise" criteria in the same way as any other trade mark.

In reaching this conclusion, the Court considered many factors, including the wording and structure of the Trade Marks Act 1994. In particular, Section 1 defines a trade mark as "any sign" and not "a series of signs", while Section 41 is clearly expressed to be a supplementary provision intended to facilitate the effective operation of the application and registration systems. It does not purport to create a new and *sui generis* kind of trade mark. The words in Section 41, referring to "a series of trade marks" (emphasis added), were consistent with this interpretation, and the use of "trade mark" in the singular at the end of Section 41(2) was too flimsy a basis for contending that a new kind of right was being created.

Fox argued in the alternative that, should the Comptroller's interpretation of marks registered as a series be preferred, the form in which such marks are presented in the trade mark register renders them misleading and is contrary to EU law. Fox submitted that the presentation of trade marks together under a single registration highlights and stresses the existence of the marks as a family, and so emphasises their common elements to a much greater extent than if they appeared on the register separately.

The Court of Appeal disagreed. The circumstances in which marks could be considered as a "family", which had been decided previously by the Court of Justice in *Il Ponte*, applied in the same way to marks registered separately as to those registered as a series. The Court could see no difficulty in such assessments being made in the future.

In reaching its conclusions, the Court of Appeal noted that matters of registration procedure and the form of registration are not harmonised by the Trade Marks Directive. Consequently, there was no scope for a reference to the Court of Justice.

IMPORTANT DECISION

This decision marks an important victory for Comic in its long-running dispute with Fox. It is also expected to be widely welcomed by brand owners holding (or interested in holding) UK trade marks registered as a series.

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The Comptroller argued that a series of trade marks is actually a bundle of individual trade marks, albeit under a single registration number

The Comic marks



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Sweet survey falls short

Paul McKay is moved to speculate on the Applicant's unusual strategy

THE APPLICANT, German confectionary company August Storck KG (Storck), filed an application for an international registration designating the EU for a figurative mark (shown below) covering a range of confectionary goods in class 30.

EUIPO's examiner found the mark to be devoid of distinctive character – a view that was upheld by the Board of Appeal (BoA).

Upon further appeal, the General Court (GC) upheld the BoA's decision. The Applicant had argued, *inter alia*, that: (i) the square shape of the mark added to its distinctiveness, even if that shape did not depart from the norms of the sector; (ii) the curved diagonal across the packaging – which, according to the Applicant, depicted snowy hills against a blue sky – was unusual and stood out from other designs; and (iii) the BoA had erred in its decision not to take into account a survey conducted in Germany. Interestingly, the Applicant did not make a claim of acquired distinctiveness in accordance with Article 7(3) Council Regulation (EC) No 207/2009 (EUTMR).

The GC took the view that the case law for 3D marks was applicable, and held that the BoA had been correct in its assessment that the shape of the mark did not add to its distinctiveness, since square shapes were common and essential for the goods at issue. Further, the mark was unable to fulfil its essential function of identifying the origin of the goods.

The judges confirmed that any characteristics of the mark that were not expressly set out in the application could not be taken into account. The Applicant had set out the colours in the description, but did not specify that the white element represented a snow-covered hill and the blue element represented the sky.

EVIDENCE LACKING

The GC further confirmed the rejection of the Germany survey evidence, which was not appropriate to establish the distinctive character of the mark in respect of the EU. The Applicant had argued that the mark was *ab initio* distinctive, or that it at least possessed the minimum level of distinctiveness required. However, the survey responses had indicated that the majority of the participants were familiar with the mark before being surveyed. The Court stressed that the survey evidence in the context of inherent distinctiveness must show that consumers did not need to become accustomed to the mark through the use made of it. Since the Applicant had not made a claim of acquired distinctiveness under Article 7(3) EUTMR, the study did not do this.

In addition, the restricted scope (1,000 participants) and extent of the survey were not deemed appropriate.

The decision reiterates that a shape mark must depart significantly from the norms and customs of the sector in order to be registered. It notes that it is advisable to add a description of any aspects of the mark that applicants may wish to rely upon at a later date.

This decision also serves as a reminder of the difficulties surrounding survey evidence. Relying on one country is inadequate, especially if the sample size is not representative of that country, let alone the EU. It is unclear why the Applicant chose not to rely on Article 7(3); however, it may have felt that German consumers believing the marks to be inherently distinctive would be considered more representative of the EU consumer than an argument of acquired distinctiveness, which the Applicant may have known did not extend beyond its domestic market.



The Storck mark



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Fight or fall

The relevant public should be considered at the filing stage, writes Désirée Fields

IN OCTOBER 2012, Zuffa, LLC (the Applicant) filed an EU trade mark (EUTM) application for the word mark **ULTIMATE FIGHTING CHAMPIONSHIP** in classes 9, 16, 28 and 41. In May 2013, EUIPO rejected the application in respect of classes 9 and 41, and the majority of goods in classes 16 and 28, finding the mark applied for to be descriptive and devoid of any distinctive character in relation to the rejected goods and services under Articles 7(1)(b) and 7(1)(c) of Council Regulation (EC) No 207/2009. EUIPO also found that the mark had not acquired distinctiveness through use. EUIPO's Board of Appeal dismissed the Applicant's appeal.

ULTIMATE DEBATE

The EU General Court noted that the mark **ULTIMATE FIGHTING CHAMPIONSHIP** served as an "identification of a mixed martial arts" competition, which clearly involved a "fighting championship". The addition of the laudatory term "ultimate" did not make the expression any less descriptive. EUIPO considered whether the mark applied for had acquired distinctiveness through use, noting that at least a significant proportion of the relevant public had to be able to identify the goods or services applied for as originating from a particular undertaking through use throughout the relevant territory. The Applicant's evidence showed that consumers in the UK and Ireland could have been aware of the Ultimate Fighting Championship brand for almost 20 years. There was also clear evidence that the term "Ultimate

Fighting Championship" referred to a specific martial arts competition and not a style of fighting. The General Court found that the competition was well known to the specialist public of fans who would recognise that "Ultimate Fighting Championship", "Ultimate Fighting", or even the acronym "UFC", were terms that referred to a specific mixed martial arts competition.

PUBLIC PERCEPTION

Within the evidence submitted, the mark **ULTIMATE FIGHTING CHAMPIONSHIP** often appeared with the acronym UFC. The General Court found that a slightly different use of the mark, such as "UFC" or "Ultimate Fighting", would be regarded by the relevant specialist public as equivalent to **ULTIMATE FIGHTING CHAMPIONSHIP** and could be taken into account.

The General Court concluded that the evidence was inadequate to show that the mark applied for had acquired sufficient renown for the English-speaking general public in the EU. However, it proved that, for the specialist public consisting of mixed martial arts fans, the mark referred to a specific competition, and that the goods and services covered by the application were marketed under the mark **ULTIMATE FIGHTING**



CHAMPIONSHIP. Accordingly, EUIPO found that the mark had acquired distinctive character in respect of those goods and services in classes 9 and 41 (such as CDs and DVDs featuring mixed martial arts competitions) that were intended for a specialist public consisting of English-speaking mixed martial arts fans in the EU.

SPECIALIST OPPORTUNITY

Applicants should remember that evidence of acquired distinctiveness will be assessed through the eyes of the relevant public. Where marks have been in use and goods and services are targeted at a specialist public, applicants should consider the scope of their applications at the filing stage. While broad specifications of goods and services are desirable, applying for goods and services for which the mark is actually known among that specialist public may significantly increase the chances of registration.



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More questions over class

Once again, a careful approach to class designations was proved to be necessary, notes Saaira Gill

ON 30 APRIL 2012, Grup Supeco Maxor, SL (Grup Supeco) filed an EU trade mark (EUTM) application for the figurative mark SUPECO, shown below. Protection was sought for, *inter alia*, “auctioneering” and retail services in class 35. On 16 August 2012, El Corte Inglés, SA (El Corte) filed a notice of opposition, claiming a likelihood of confusion, under Article 8(1) (b) of Council Regulation (EC) No 207/2009, with its EUTM registration for the figurative mark SUPER COR, also shown below. El Corte based the opposition on services in class 35, which covered “advertising; business management; business administration; [and] office functions”.

EUIPO DECISIONS

The Opposition Division partially upheld the opposition, finding that there was a likelihood of confusion between SUPER COR and SUPECO, and refused the application for all of the contested services in class 35. In considering the scope of protection of the earlier registration, the Opposition Division took the view that El Corte had intended to cover all of the services included in the alphabetic list for class 35, basing this on Communication No 2/12 of 20 June 2012 concerning the use of class headings.

Grup Supeco filed a notice of appeal against the decision. The Board of Appeal (BoA) partially upheld the appeal, annulling and altering the Opposition Division’s decision to uphold the opposition for auctioneering and retail services. The BoA said that the scope of the opposition brought by El Corte was limited to services expressly listed in the notice of

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The Court noted that the requirements of ‘clarity and precision’ must be regarded as binding upon the opposing party

opposition. It noted that auctioneering services were not listed in the notice of opposition, and that El Corte had never claimed that the opposition was based on any services other than those specifically listed. The BoA accordingly found that the services in question were dissimilar.

GENERAL COURT APPEAL

El Corte appealed to the General Court, invoking Communication No 2/12. The Court noted that it cannot be inferred from the Communication alone that the broad interpretation for class headings also applies to the notice of opposition. Rule 15(2) (f) of Commission Regulation (EC) No 2868/95 (EUTMIR) requires that the notice of opposition must contain the goods and services on which the opposition is based. Rule 17(4)

EUTMIR states that the opposition will be rejected as inadmissible if the requirement under Rule 15(2) (f) is not met. Furthermore, the Court noted that the requirements of “clarity and precision” must be regarded as binding upon the opposing party in relation to the designation of goods and services upon which the opposition is based, for the purposes of allowing EUIPO to decide on the opposition, and for the applicant for the opposed application to prepare its defence. The Court accordingly dismissed the appeal.

TRIMMING REQUIRED

This serves as a reminder for opponents to carefully consider the goods and services upon which the opposition is based, or, if in doubt, base the opposition on all goods and services covered by the prior mark, ensuring the list is trimmed as proceedings progress.

The Grup Supeco mark

Supeco 

The El Corte mark



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Oil mark slips up

*Conceptual differences made the difference,
reports Oliver Tidman*

THE EU GENERAL COURT has upheld an EUIPO decision to dismiss an opposition, holding that there was no likelihood of confusion between the word mark CHEMPIOIL and a figurative mark, consisting of the word element CHAMPION, relating to identical and similar goods.

On 9 March 2011, UAB SCT Lubricants (the Intervener) obtained the international registration designating the EU for CHEMPIOIL for goods in classes 1, 3 and 4. On 23 January 2012, Wolf Oil Corp (the Applicant) filed a notice of opposition pursuant to Article 42(1) of Council Regulation (EC) No 207/2009 (EUTMR) against the Intervener's EU designation for CHEMPIOIL.

The opposition was based on the Applicant's earlier international registration designating the EU for the figurative mark CHAMPION, reproduced below, for identical and similar goods in classes 1, 3 and 4.

On 18 July 2013, the Opposition Division concluded that there was a likelihood of confusion between the respective marks and upheld the opposition. On 31 October 2014, the Board of Appeal (BoA) upheld an appeal by the Intervener and rejected the opposition, concluding that there was no likelihood of confusion between CHEMPIOIL and the earlier rights relied on by the Applicant in respect of CHAMPION, whose existence and, where applicable, genuine use had been proven. The Applicant appealed to the General Court.

ULTIMATE DECISION

Despite their visual and phonetic similarities, the Court agreed that the BoA had correctly concluded that there was no likelihood of confusion between the marks under Article 8(1)(b) EUTMR. In particular, it found that the earlier mark had an average level of distinctiveness, and that it had not been demonstrated that its distinctiveness was high. As to the BoA's reference to the UEFA Champions League and to the song

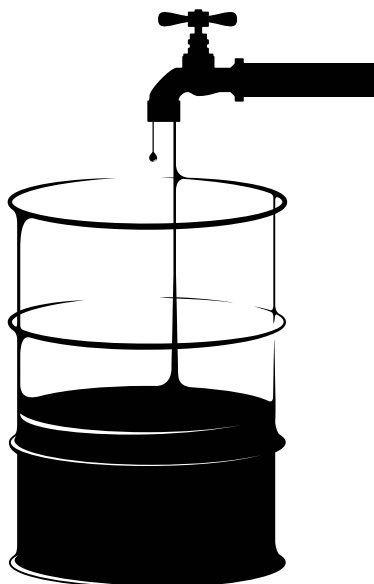
"We are the Champions", performed by the band Queen, whose fame in the eyes of the EU public was disputed by the Applicant, the Court said that even if part of the relevant public does not know either of those two examples, the fact remains that the word "champion" is commonly used in various fields.

CONCEPTUAL CASE

As the marks share six letters in common, they are visually and phonetically similar. However, there are considerable conceptual differences. The BoA was entitled to find that the word "champion" is widely understood by consumers in all EU Member States, including Estonia and Slovakia, as it is used extensively in various fields, particularly sport.

In contrast, CHEMPIOIL does not have a specific meaning immediately capable of being understood by the relevant public. Although it might be associated with the words "chemical" and "oil", it would not be perceived as a variant of the word "champion".

The Wolf Oil Corp mark



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Hit for six

*Joel Smith reflects on a long journey
towards an unremarkable Diset decision*

FOLLOWING REFERRAL OF the case back from the CJEU, the EU General Court has issued a revised decision rejecting opposition to an application to register MAGNEXT as an EU word mark, based on a prior Spanish registration for MAGNET 4. The original decision was found to be procedurally flawed, in that it failed to take into account all elements of the applied-for mark in assessing likelihood of confusion.

BACKGROUND

In 2010, Mega Brands International (Mega Brands) applied to register the word mark MAGNEXT as an EU trade mark (EUTM) in class 28, covering “toys and playthings”. Diset SA (Diset) opposed the application on the basis of its earlier Spanish word mark MAGNET 4, which also covered “toys”. Diset relied upon Article 8(1)(b) of Council Regulation (EC) No 207/2009. This precludes registration of a mark upon opposition by an earlier proprietor if there exists a likelihood of confusion by the public in the territory in which the earlier mark is registered, based upon identity

“

*Conceptual difference
was capable of
counteracting, or
even cancelling, the
marks’ visual and
phonetic similarities*

with, or similarity to, the earlier trade mark, and the marks’ respective goods or services.

In its original judgment, the Court dismissed Mega Brands’ application to annul EUIPO’s decision upholding the opposition on the basis that the two signs were – although conceptually dissimilar – visually and phonetically similar “to a medium degree”, and that a likelihood of confusion existed. Mega Brands then appealed to the CJEU.

CJEU ANALYSIS

The CJEU found the Court’s decision to be procedurally flawed, as it failed to consider the marks in their entirety in assessing likelihood of confusion. In particular, in assessing similarity, the Court did not take into account the impact of the number “4” in the earlier mark. As such, its finding of likelihood of confusion was based upon “an insufficiently substantiated assessment concerning the dominant character of the element ‘magnet’” in the earlier mark.

REVISED DECISION

Following the CJEU’s judgment, the Court revised its assessment of similarity based upon the low degree of visual similarity and “very low” phonetic similarity between the marks, largely due to the presence of “4”, which would be visible and

pronounced as a separate element in the earlier mark (“*cuatro*” in Spanish). It maintained that the marks were conceptually dissimilar, based upon a perception that goods branded MAGNET 4 would suggest applicable magnetic properties, whereas the sign MAGNEXT would be perceived by a Spanish-speaking public as a “fanciful” word. Taking into account that the earlier mark had only weak distinctive character, the Court ultimately found the conceptual difference between the marks was capable of counteracting, or even cancelling, their visual and phonetic similarities, so that there was no likelihood of confusion for the purposes of Article 8(1)(b). More than six years after the application was filed, the Court rejected Diset’s opposition.

SLOW PROCESS

This case documents the requirement to consider marks in their entirety when assessing likelihood of confusion, even where they differ by apparently minor components. Only truly negligible components of a mark may be discounted in assessing similarity. While a seemingly clear legal principle, the length of these proceedings illustrates the potential uncertainties for branding and marketing strategy that are often created by the slow-moving EUTM procedure.



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Victoria Horsey, a Senior Associate, co-authored this article.

Shape marks in the slammer

Registering a shape mark now means scaling an even higher bar, reports Dominic Farnsworth

LOOPS LLC is the manufacturer of a toothbrush which is, according to its website, “engineered for safety of inmates and correctional officers”, and notable for its “non-shank design”, which results in it being “weapon proof”.

While one might struggle to imagine a toothbrush that is particularly suitable to weaponisation, the test for registrability is, of course, whether the shape departs significantly from the norms and customs of the industry, not whether the functionality does.

THE LOOPS REGISTRATION

The Court confirmed that the test for registration of a shape mark is that the mark must serve to identify the goods for which the mark is applied as being those of a particular undertaking, and thus distinguish those goods from those of other undertakings. It went on to state, however, that consumers are not in the habit of identifying the origin of products from their shape, and shapes for which registration is sought must depart significantly from the norms and customs of the sector in order to indicate origin.

No doubt the product design industry would argue that consumers do, in fact, pay attention to the shape of goods, and associate the shapes of certain goods with brands. Nevertheless, the above principle is now part of CJEU jurisprudence, as various brands have found to their cost.

UNUSUAL SHAPE

It is apparent from looking at the shape of the Loops toothbrush, shown on this page, that it is unusual.

However, after assessing the key features of the shape, the Court decided that, being simply a “variant” of a “normal” toothbrush, it did not depart sufficiently from those norms to be capable of indicating origin. Accordingly, the Court dismissed the appeal, upholding the Board of Appeal’s (BoA’s) assessment that the mark lacked distinctive character.

Interestingly, the BoA had based its decision partly, it seems, on the fact that the shape was “immediately” identifiable as being that of a toothbrush. So, the BoA said, there was a presumption that the shape did not depart significantly from the norm. The Court, while not expressly endorsing the argument, did tacitly accept it.

UNACHIEVABLE STANDARD

In the authors’ view, this approach is taking the bar for registrability of product shapes to unachievable levels. Had the EU legislature wanted to limit registrability of shape marks, it could have provided for such an objective in the recently amended EUTMR. However, it is at least arguable that this decision is authority for the proposition that, if a shape is immediately recognisable as being whatever kind of product it is, it is unlikely to be registrable. So, if you are seeking to register a bottle, it may

be unlikely to be registrable if it is immediately recognisable as a bottle. The same applies with a car, a chocolate bar and so on...

For those rights holders who seek to enforce their shape marks, this decision will be a concern. Leaving aside any arguments about acquired distinctiveness, for an owner of a trade mark with a shape that is instantly recognisable as being whatever category of product it is (eg a car), how confident can that owner be that the “infringer” would not be able to invalidate the mark with relative ease?

This decision will therefore increase the attraction of seeking to register a design in lieu of, or in addition to, a shape mark. This, in addition to unregistered rights, such as passing off, copyright and unfair competition (where available), would provide the best available protection to brand owners to mitigate against copycats or those seeking to utilise similar designs.

The Loops LLC registration



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T-312/15, Market Watch Franchise & Consulting, Inc v EUIPO and Glaxo Group Ltd (MITOCHRON), CJEU, General Court, 13 May 2016

Stuck in the middle

Similarity at both the beginning and end of marks meant a win for Glaxo, says Charlotte Wilding

40 CASE COMMENT

ON 4 SEPTEMBER 2012, Market Watch Franchise & Consulting, Inc (MWFC) applied to register an EU trade mark for MITOCHRON in classes 3, 5 and 35. On 8 April 2013, Glaxo Group Ltd (Glaxo) opposed the class 5 registration on the basis of Article 8(1)(b) Council Regulation (EC) No 207/2009 in respect of its earlier UK registration for MIVACRON in class 5.

The Opposition Division upheld the opposition. This decision was appealed and dismissed by the Second Board of Appeal (BoA) on 20 March 2015. MWFC subsequently brought an action at the General Court requesting that it annul the decision, reject the opposition and order EUIPO to pay costs.

SINGLE PLEA

MWFC relied on one plea: infringement of Article 8(1)(b), meaning that the BoA was wrong to find a likelihood of confusion. The Court reviewed the BoA's findings in respect of the following factors:

Relevant public

The BoA held, and the Court agreed, that the relevant public is composed of professionals in the pharmaceutical and medical sectors, and general end consumers, all of which have a high level of attention. Further, as Glaxo has an earlier UK mark, the BoA was correct in assessing a likelihood of confusion on the basis of the relevant public in the UK.

The Court found that MWFC's arguments regarding the relevant public were inconsistent; it stated that the relevant public has both a high level of attention and a limited

and vague memory of trade marks. Either way, MWFC's arguments simply confirmed the position of the BoA.

Comparison of goods

Neither party disputed that the goods were partly identical and partly similar, and so the Court did not assess this.

Comparison of marks

The BoA held that the marks were visually similar as they share their first letters, "mi", and last letters, "cron/chron", and are of a similar length. Although the marks differed in their third and fourth letters, and the mark applied for also contains an additional letter, those letters did not alter the overall impression because they are in the middle of the marks.

As the marks have three syllables, the first being identical and last being virtually identical, with the additional "h" of the mark applied for being silent, the differences in the middle syllables are insufficient to alter the impression of phonetic similarity.

While MWFC argued that the marks are phonetically dissimilar, such that the marks are dissimilar when considered in their totalities, the Court noted that MWFC failed to indicate precisely what the differences are. Therefore, MWFC's arguments that the phonetic dissimilarities outweighed the visual similarities were dismissed.



Marks of the same or similar length, and with similar beginning and end elements, will likely be considered visually and phonetically similar

As the marks have no conceptual meaning, this was not assessed.

Accordingly, the Court held that the BoA was right to find the marks visually and phonetically similar.

Likelihood of confusion

In view of the above, the Court dismissed the action and held that the BoA was right in its assessment when finding a likelihood of confusion.

CONSISTENCY NEEDED

This case reiterates the fact that marks of the same or similar length, with the same or highly similar beginning and end elements, will likely be considered visually and phonetically similar. This should be considered when reviewing marks for similarity during searches.

It also highlights the need to ensure consistency in arguments advanced.



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events

More details can be found at itma.org.uk



Date	Event	Location	CPD hours
14 September	ITMA Webinar* Effective enforcement of designs and other IP rights		1
27 September	ITMA London Evening Meeting† Update on the registration of non-traditional trade marks	Royal College of Surgeons, London WC2	1
6 October	ITMA Autumn Seminar & Drinks Reception† New technology and IP	Hyatt Regency, Birmingham	5
13 October	ITMA Administrator Session Webinar Sanctioned countries §		
25 October	ITMA London Evening Meeting† Discussion of recent EUIPO cases	Royal College of Surgeons, London WC2	1
3 November	Seminar for Litigators	Edwin Coe LLP, London WC2	2.5
9 November	ITMA Webinar* Middle East spotlight – the shifting sands of trade marks		1
17 November	ITMA Scottish Talk Case law update	Marks & Clerk LLP, Edinburgh	1
22 November	ITMA London Evening Meeting†	Royal College of Surgeons, London WC2	1
24 November	ITMA Administrator Session The career path for Administrators §	Olswang LLP, London WC1	
30 November	ITMA Wales & SW Talk Drafting and negotiating trade mark contracts: the devil is in the detail	Ashfords LLP, Bristol	1
7 December	ITMA Northern Christmas Lunch	TBC	
9 December	ITMA Christmas Lunch and Drinks Reception*	London Hilton on Park Lane, London W1	

Don't miss our Autumn Seminar, which focuses on new technology and IP, in Birmingham in October

SUGGESTIONS WELCOME

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

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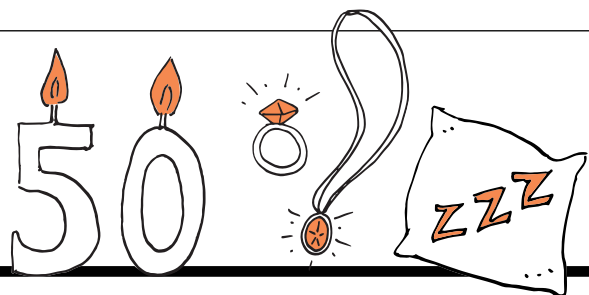


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THE TRADE MARK 20

Q&A



I work as... Formalities Manager, specialising in trade marks, at Tomkins & Co in Dublin.

Before this role, I was... a Trade Mark Attorney with another IP firm in Dublin. I qualified as a Trade Mark Attorney in 1995. I subsequently worked as an Attorney until 2002, at which time I transferred to Administration Management.

My current state of mind is... excited. I celebrate a special birthday this year and am consumed with organising not one but three parties – well, you're only 50 once, right?

I became interested in IP when... in 1990, I was employed at a leading Dublin IP firm as PA to one of the Trade Mark Partners. Before then, I don't think the words "trade mark" were even in my vocabulary! While entering the IP world was purely accidental, I found the work fascinating and was both encouraged and supported in obtaining a diploma in law from the Dublin Institute of Technology, and qualifying as a Trade Mark Attorney at the same time.

I am most inspired by... positive people. Someone who has recently moved me is Sheryl Sandberg, COO of Facebook. While her book, *Lean In: Women, Work and the Will to Lead*, made for very interesting reading, the real inspiration for me came from her description of the first 30 days following the tragic and sudden death of her husband last year. Despite what she



Deirdre Naessens,
Overseas Member, is
in a celebratory mood

was going through, she still wanted to give something back. To have such poise and elegance at a time of great personal trauma was truly amazing.

In my role, I most enjoy... the variety; no two days are the same. I also enjoy training new staff and problem solving.

In my role, I most dislike... the possibility of making an irremediable error. Of course, I hope this will never happen!

On my desk is... apart from the usual files, hand cream and a personalised glass coaster from a renewals company.

My favourite mug says... "I'm usually beautiful and glamorous, but it's my day off today".

My favourite place to visit on business is... Alicante – sunny people, sunny climate.

If I were a trade mark or brand, I would be... Felix – I am so inquisitive (or perhaps just plain nosey), that I think I was a cat in a former life.

The biggest challenge facing the IP industry is... keeping up to date with continuous change.

The talent I wish I had is... to be more creative in my jewellery making.

I can't live without... lots of sleep.

My ideal day would include... a lie-in and no overthinking.

In my pocket are... keys, gloves and tissues.

The best piece of advice I've been given is... "always read the file".

When I want to relax I... watch TV with my husband (other than the Champions League) and/or make jewellery.

In the next five years I hope to... still be happy and healthy and have all my loved ones around me.

The best thing about being a member of ITMA is... on a personal level making some wonderful friends, and on a professional level keeping abreast of the ever-changing world of trade marks.

Newly Qualified Trade Mark Attorney Brighton

Dehns is one of the largest firms of patent and trade mark attorneys in Europe and we are looking to welcome a newly qualified trade mark attorney into our substantial trade mark practice. We are consistently recognised by the Legal 500 for providing an impeccable service to our clients, and our attorneys are well known in the industry for their commitment and passion for quality and innovation.

The trade mark team, including those attorneys based in our Brighton office, works with a diverse range of clients from individuals and SMEs to blue chips and multi-national corporations, who originate from a whole host of industries including entertainment; tourism; finance; fashion and beauty; medical technology; publishing; food and beverage; and engineering. We invest heavily in our visibility and our attorneys are encouraged to actively network, speak at conferences and contribute to firm/industry publications. With this in mind, we require our attorneys to be passionate, commercially minded and comfortable working closely with high profile clients from day one.

You will be responsible for handling all aspects of trade mark work, including the initial stages of clearance searching, the filing and registration of trade mark applications, dealing with domain name disputes, passing off and infringement issues, as well as the continuing management and enforcement of your clients' portfolio. You will be expected to work closely with your clients, guiding them through each stage of the process and offer commercially sound and pragmatic advice to ensure they are fully protected against any eventuality.

Ideal candidates will have recently passed the Professional Certificate in Trade Mark Practice course, although those with up to 1 year's PQE will also be considered. You will need to have an impeccable academic track record, with excellent results achieved at GCSE, A Level and degree level.

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