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ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

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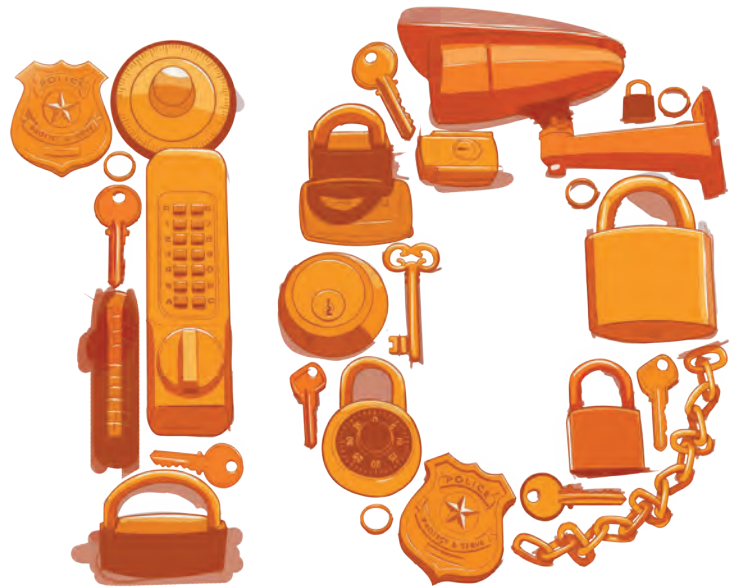
**EXPLORING THE WORLD OF
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ITMA Review

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By the time you sit down to read this issue, many of you will have enjoyed our Autumn Seminar in Birmingham, and Christmas will be fast approaching. When you have docketed the date of our London and/or northern Christmas lunches (you will see me at both), please tuck into this varied and exciting array of contents.

If you thought ASEAN was a typo, you will be interested in the very useful article on trade mark protection in this

region of ever-increasing importance. We also have fascinating statistics on representation of clients at the UK IPO, and a feature on fashion trade marks in Italy. On which note, *ciao*.

Chris McLeod
ITMA President

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ITMA Insider

Administrator success

ITMA would like to congratulate all of those who successfully completed the Trade Mark Administrators' Course 2014. Those candidates are:




Particular congratulations to Haydn Lambert of RGJ Jenkins & Co, who achieved the highest score in this year's exam.

Amanda Allcroft
Andrew Birkin
Simone Bosch
Elaine Cicco
Rachel Cusack
Neil Duffy
Samantha Evans
Rachel Garrod
Tanja Gualtieri
Lee Guest
Sedella Ann Hearson
John Roderick Cecil Hillen
Louise Hirst
Natasha Hosier
Lee Anthony Huggins
Sarah Anne Jack
Eleanor Johnston
Stephanie Jones
Victoria Kane

Mathew Kilbey
Jiri Kocab
Nicola Kopp
Haydn Lambert
David Charles Laws
Clara Lopez-Torrijos
Sophie May
Arun Mazumder
Karen McCartney
Elena McConnell
Carolyn McDade
Justine Milligan
Joanne Morgan
Laura Morris
Samantha Moutou
Louise Mulloy
Xavier Muniesa
Samantha Nagle
Heather Oldham

Laura Orchard
Terri Parish
Andressa Gabrieli Pimentel
Pooja Rathore
Siân Reeve
Angelika Rose
Amy-Louise Salter
Lizzie Sergeant
Michelle Grace Smith
Leticia Marie Soper
Aimee Swayne
Rebecca Thompson
Jessica Vallis
Rebecca Elizabeth Walsh
Laura Weston
Karen Whitehouse
Carmen Witte
Carole Wood
Debbie York



Exam scripts

Copies of unmarked examination scripts are available at a cost of £25. If you would like to receive a copy, please contact Marzia Sguazzin at marzia@itma.org.uk. Payment can be made by cheque, credit/debit card or bank transfer. Scripts will be destroyed on **17 November 2014**.

Plain packaging response

In August, ITMA published its comments in respect of the Department of Health's consultation on the introduction of regulations for standardised packaging of tobacco products

Commenting only under Question 3 of Appendix A, ITMA expressed the view that "counterfeiting is likely to increase under the new proposals".

ITMA noted that: "ITMA does not comment on health-related subjects and is non-partisan on the generality of plain packaging per se, but is greatly concerned that trade mark law is stable, cohesive and strong. The proposals in this consultation, in schedule 4, sections 14-18, are clear and address a number of issues, especially some of the concerns previously raised

over the Trade Marks Act 1994 in sections 32(2), 5(1) and 10(1). However, tensions remain within sections 5(2), 5(3) and 5(4)a, and 10(2) and 10(3) of the Act. Perhaps that has been assessed as an unavoidable consequence. Nonetheless we ask for guidance on these, and for confirmation that the new regulations will be kept under review and might be amended again in the event of unforeseen consequences or unwelcome results."

The full response is available at itma.org.uk

ITMA-IPO away-day

ITMA was pleased to have been asked to join an away-day organised by the UK IPO for the Trade Marks Tribunal Section

The event took place on 10 July 2014 at Tredegar House, just outside Newport, Wales, and was attended by a large number of Tribunal staff.

Aaron Wood and Imogen Wiseman, who gave “an outsider’s perception of the Tribunal”, represented ITMA.

The discussions gave us the chance to discuss a wide range of areas. Of particular interest were the talks on case management conferences in contentious proceedings, and the way in which complex negotiations can often affect the conduct of opposition proceedings.

What was particularly encouraging was not only the fact that it allowed ITMA the opportunity to explain some of the background to perceived problems, but also the fact that there was already so much common ground between ITMA and Tribunal staff.

The session is just one of the collaborations between ITMA and the IPO, others being ITMA’s involvement with the Marks and Design Forum, the annual meeting of the Presidents, and meetings between the IPO and ITMA’s Law & Practice Committee.

Thank you to all the ITMA members who submitted questions for us to ask.

There was already much common ground between ITMA and Tribunal staff

Member *moves*



Michelle Ward has joined Wynne-Jones IP as Trade Mark Attorney. Michelle will join the team in the Cardiff office and can be contacted at [02920 786535](tel:02920786535); michelle.ward@wynne-jones.com



Potter Clarkson LLP is pleased to announce that Katie Smith has been promoted to Associate in the trade marks department. Katie can be contacted at katie.smith@potterclarkson.com

Loven is delighted to announce that Ruth Bond has joined the firm to support the continuing growth of its trade mark department. Ruth is a qualified Trade Mark Attorney and can be contacted at ruth.bond@loven.co.uk

Firm makes Munich addition

Withers & Rogers LLP has opened an office in Munich as part of a strategic move to stay close to the European Patent Office (EPO) and further improve services for UK and international clients seeking patent protection in Germany and across Europe.



Passing off progress

ITMA welcomed the news from the UK IPO that its first legal action under the common law of passing off has been successful. The IPO’s website reported that:

“Two of the most blatant offenders – ‘Patent and Trademark Office’ and ‘Patent and Trade Mark Organisation’ – and the persons behind these organisations, Aleksandrs Radcuks and Igors Villers, have admitted and settled our claims and agreed to be bound by an Order of the Intellectual

Property Enterprise Court prohibiting them from further acts of passing off. This means that, if they pass themselves off again as the IPO, they will be in contempt of court and liable to imprisonment. Part of the settlement is a substantial payment to the IPO that will cover some of our legal costs.”

The IPO also notes that similar proceedings are pending, so we will join members in watching for further developments.



**DR MICHAEL JEWESS LEADS
US THROUGH THE WORLD
OF ATTORNEY-CLIENT PRIVILEGE**

VOYAGE OF DISCOVERY

On balance, attorney-client privilege is in the public interest, even though it protects some people who ignore legal advice

Imagine you, a practitioner, have a client who proposes to launch a new handheld mobile telecommunications device branded as MEGAFIRE. You perform a clearance search. You write to the client with the opinion that the product launch would infringe third-party registrations in force in relevant territories, suggesting that the client should devise another mark (unless the client can obtain the agreement of the third party).

The circumstances of such advice might be, for instance: (a) that the identical mark is registered and in use for similar devices in the relevant territories; or (b) that (in regard to relevant European Union (EU) territories) the third party is a fire extinguisher manufacturer with (near)-complete coverage of class 9 by an identical Community Trade Mark registration that is in its first five years and therefore as yet unchallengeable on grounds of non-use or limited use.¹

The client who disregarded the practitioner's suggestion and simply proceeded with MEGAFIRE in circumstance (a) would normally just be inviting trouble – but nevertheless they might. The client who did likewise in circumstance (b) might calculate that the odds are stacked against the trade mark owner finding out about the infringement and (if it does) it will not bother to take action – but the client is nevertheless putting its product on the line.

Whatever the practitioner thinks of the client taking such risks, the client is free to choose to take them.

Now imagine that the client does take the risk and gets sued. If it is sued in a common-law jurisdiction, discovery (“disclosure” in England) is probable. It would prejudice the client if the practitioner's earlier adverse advice were exposed to the court (and especially to a US jury). But if attorney-client privilege exists in relation to the advice, then it is protected from discovery.²

The rationale behind attorney-client privilege, generally, is this: if a client cannot obtain legal advice without risking prejudice in a later action, then it is less likely to do so. Compared with those who do not obtain legal advice, those who do obtain it are, on average, less likely to unlawfully inconvenience others and to take up the time of the courts. On balance, therefore, attorney-client privilege is in the public interest, even though it protects some people who ignore legal advice.

This advice on MEGAFIRE, if given by a UK Trade Mark Attorney, would attract privilege in UK courts under the Trade Marks Act 1994 (“TMA”), section 87. The question arises whether it would attract privilege in other common-law countries where the client would be prejudiced by discovery. This is illuminated by several patent infringement actions in which the defendant has sought discovery of correspondence

1) A survey by the author of trade mark cluttering, despite covering only a short (recent) time period, revealed broad class 9 Community Trade Marks owned by a famous soft drinks company, a famous football club, a fitness club and a yacht club.

2) *Litigation privilege* applies only to documents created once a litigation is contemplated or commenced, and is not the subject of this article.

between, on the one hand, inventors or patentees and, on the other, patent advisers outside the territory of the litigation.³ In the US courts, the assertion of privilege in relation to non-US advisers may involve the significant expense of a mini-trial on the matter. But the good news is that US courts have accorded attorney-client privilege to communications with UK Patent Attorneys; this is because, in comity, they choose not to order discovery of documents that a UK court would consider privileged under the Copyright, Designs and Patents Act 1988 (“CDPA”), section 280. One infers that communications with Trade Mark Attorneys and covered by the TMA would be treated similarly. However, the Australian and Canadian courts may be more problematic for UK Trade Mark Attorneys’ clients than the UK or the US courts.

In European Commission competition investigations, UK and other national laws on privilege are substantially disregarded.

Implications for routine practice

The practitioner doing a job today, with no litigation (or Commission investigation) in prospect, can adopt measures that improve its client’s chances of being able to rely on attorney-client privilege should it later wish to. However, the prospective privilege “tail” cannot be allowed excessively to wag today’s “dog” of doing the work efficiently. What action is proportionate will depend on the client, practice, and/or job, and what follows is a description of the various measures that can be taken in routine UK trade mark practice, with an assessment of how proportionate they are.

Housekeeping measures

Attorney-client privilege depends on the lawyerly status of the adviser. Housekeeping measures to enable this status to be proved later can be implemented cheaply (and are often no-brainers):

- Ensure that the authorship of documents is clear so that it can be later established that the author (and its practice, if private) was on the relevant list (for example, IPReg) at the time the document was created. This should extend to initialling and dating of manuscript annotations.
- So as to facilitate the identification of documents in electronic discovery as candidates for being withheld from the court, ensure that outgoing emails carry a lawyerly term that a junior litigation lawyer would naturally use as a computer search term, such as “attorney” or “counsel” (the latter being a common job title in-house).⁴ Private practices can incorporate “attorney” in their email footers. In-house practices communicating with their clients via internal company email probably have to set up Microsoft Outlook® signature blocks for each member of the department.

Not all lawyers are equal

Beware of areas of the law to which your privilege does not extend:

- UK Trade Mark Attorneys should minimise their handling of inventions and technical information (whether in incoming communications or outgoing comments), because privilege under the TMA does not cover them – contrast a Patent Attorney’s privilege under the CDPA. This is a pity, because a Trade Mark Attorney is otherwise a good first port of call for a client who does not already have a Patent Attorney.
- UK Trade Mark Attorneys are often knowledgeable on copyright, but their



³ The correspondence with the adviser who drafted the priority application is particularly valuable to the defendant. Inventors at this stage may incorrectly denigrate their inventions, while the adviser quite properly takes a devil’s advocate position, so its correspondence could be spun rather damagingly to a US jury.

⁴ “Privilege(d)” is a uselessly unselective search term, because all sorts of organisations include this word in their footers. The string “Privilege review required” is much more selective, and can be usefully adopted in addition to a lawyerly term.

clients enjoy no privilege if they consult them in relation to, for instance, a pure literary work, such as a report or book. If the matter is minor or otherwise insensitive (for example, advising on copyright markings), it may well be in the client's best interest for an attorney, if competent, to go ahead and advise. However, on more significant matters (for example, considering an approach to the client from a collecting society), then it may be worthwhile to involve a solicitor or barrister, for instance the client's in-house solicitor or a specialist private practice IP solicitor to whom the attorney writes: "This is what I think; do you agree?"

- With trade mark-related EU competition law matters, often serious enough to warrant extra expense, privilege is best preserved by involvement of a private practice solicitor or of a barrister in chambers.
- Communications with trainees and formalities staff in in-house practices may not enjoy privilege, so sensitive documents prepared by them should be signed by a suitably qualified colleague.

Client behaviour

The client also needs guidance:

- The client can destroy privilege in correspondence with the adviser by disclosing it non-confidentially (or even confidentially to the wrong people). Therefore, the practitioner should consider heading particularly sensitive advice "LEGALLY PRIVILEGED AND CONFIDENTIAL - NOT TO BE FORWARDED", and sending the advice directly to all those within the client organisation who need to have it. Sending advice only on paper (not electronically) reduces the chance of ill-considered forwarding.
- Also, in general IP or legal awareness sessions, the client should be warned against internal or amateur email

discussions of sensitive matters, which are in general discoverable.

Sanitising the advice and purging the files?

Clearly, if the practitioner gives adverse – or partially adverse – advice only orally, and/or the practitioner and the client routinely purge files and electronic records on a shorter timescale than litigation is likely, then the client is protected after a quite different fashion from above because there is no significant document to be discovered. Arguments against adopting such measures are as follows. First, a client who has no written document to discuss internally is more likely to do the wrong thing and to get into avoidable litigation in the first place. Second, if there is no written record, extra costs are incurred if a similar matter arises again. Finally, if adverse advice is given only orally, the client may later assert that it was in fact favourable and accuse the adviser of negligence.

Of the above measures for addressing discovery or privilege, the author least favours the sanitising/purging one, but suggests that the other measures warrant a considered place in routine UK trade mark practice.

For a full discussion of this topic, see Chapters 2 and 8 of "Inside intellectual property – best practice in IP law, management, and strategy", at researchinip.com/iip.htm

The prospective privilege 'tail' cannot be allowed excessively to wag today's 'dog' of doing the work efficiently



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He lectures and writes frequently on IP subjects.



Keeping up appearances

Aaron Wood has been examining which firms and individuals have been most often represented at oral hearings. Here's what he found

Could greater activity be returning to the Tribunal Section? If the number of appearances at hearings is an indicator, a slight increase in the 2014 figures over 2013's may suggest an affirmative response – just. The number of appearances at hearings for the years from 2010 to 15 August 2014 were: 170, 225, 163, 114 and 115, respectively. There was a clear spike in 2011, followed by a trough in 2012 and 2013. However, it is worth remembering that there is a lag from filing an action to the final decision, so the change in figures could be seen as a reflection of the state of the economy.

The percentage of cases proceeding based upon a decision on the papers was around 48 per cent in 2010 and 2011, but rose sharply in 2012 to 60 per cent and further still in 2013 to 66 per cent, suggesting that oral hearings were becoming a substantial minority. Based on the period studied, 2014 shows a more even distribution, with a split of approximately 50/50 between oral hearings and hearings on the

papers. Analysis of the figures revealed that several attorneys appearing reasonably frequently in 2010 and 2011 had low figures for 2012 and 2013, perhaps skewing the numbers slightly.

Counsel v attorney/solicitor

On this point, the percentage balance is approximately 48 per cent v 52 per cent in favour of counsel, although in 2010 and in the portion of 2014 examined the percentage is reversed. There was an outlier in 2012, which saw a bump in counsel use to 63 per cent based upon a larger number of cases in that year (the number being taken by attorneys were flat that year when compared with 2011).

In the entire period, 83 members of counsel were identified as having appeared, compared with 172 Trade Mark Attorneys (“TMAs”) or solicitors (see figure 1).

In respect of TMAs and solicitors, this is largely the pattern one would expect to see (an inverted exponential curve with the number having more appearances dropping off significantly). For barristers, this

again confirms expectations – that a few names are known and favoured, with rungs of popularity below that. While we may choose counsel (leading to some getting the lion's share), among attorneys and solicitors one sees a normal pattern up to seven, with a different pattern thereafter.

Trends in representation

Over the period examined, the “8+” club in the UK IPO for TMAs (those people making eight appearances or more) includes Julius Stobbs (Stobbs IP), Alan Fiddes (Urquhart-Dykes & Lord LLP), Martin Krause (Haseltine Lake), Ian Bartlett (Beck Greener), Rowland Buehrlen (Beck Greener), Kieron Taylor (Swindell & Pearson Limited), Kate Széll (Venner Shipley LLP) and Ian Wilkes (Groom Wilkes & Wright LLP). It is worth noting that of those on this list, six hold the Higher Courts Litigation Certificate, with another having completed the academic stage towards obtaining one. The appearance rate puts them ahead of more than 80 per cent of counsel

FIGURE 1:
2010-2014 APPEARANCES BY TYPE OF REPRESENTATIVE

NO OF APPEARANCES	1	2	3	4	5	6	7	8	9	10-14	15-19	20+
Barrister	25	17	8	2	6	6	4	6	1	3	3	2
TMA/solicitor	106	23	18	12	2	2	1	4	0	3	0	1

The perception that counsel make regular appearances at the UK IPO is true only of a very small handful of counsel, and this depends heavily on one's perception of the word 'regular'

who have appeared at the IPO in that period.

Just over half of counsel appearing have appeared two times or less over the period examined (so on average less than once every other year), which may be a surprise to some. The perception that counsel make regular appearances at the IPO is true only of a very small handful of counsel, and this depends heavily on one's perception of the word "regular".

Causes for concern?

The tables showed that among some firms, only one or two attorneys ever appear, even where the firm is a sizeable one – and many large and well-regarded practices have oral hearings only rarely.

The list of attorneys who have appeared reveals several very established and well-respected names (most with one appearance in the period), with few (if any) younger attorneys. Many major firms have not had a single *inter partes* hearing in the period, let alone had a member of their firm appear in that hearing. This suggests two issues for firms in bringing through attorneys and coaching their advocacy skills:

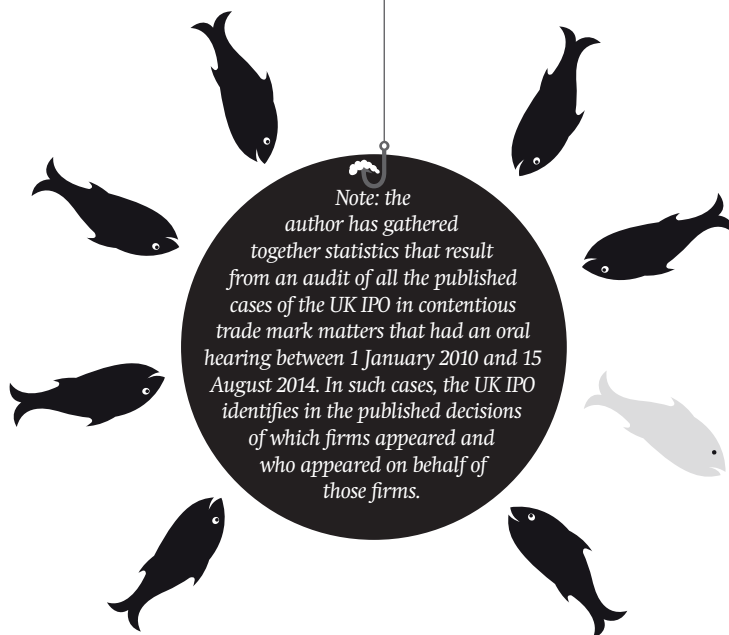


TABLE 1:
2010-2014
APPEARANCES
BY 20 TOP FIRMS

1	Marks & Clerk
2	Stobbs IP*
3	Beck Greener
4	Swindell & Pearson Limited
5	Cleveland
=	Forresters
=	Urquhart-Dykes & Lord LLP
8	Groom Wilkes & Wright LLP
9	Harrison Goddard Foote*
10	Mewburn Ellis LLP
11	Haseltine Lake LLP
=	Wynne-Jones, Lainé & James
13	Murgitroyd
14	D Young & Co
=	Keltie
16	Bristows
=	Bromhead Johnson
=	JA Kemp
=	RGC Jenkins & Co
=	Taylor Wessing

*Stobbs IP includes work conducted by Julius Stobbs prior to the establishment of that firm during the relevant time period; HGF figures incorporate Grant Spencer.

- 1) a lack of opportunities; and
- 2) a lack of experience among the majority of the profession in the area of advocacy, such that they would not be able to coach more junior team members.

I don't believe it is unfair to suggest that those who never appear (or have never instructed counsel to appear) would be less likely to see the relevance and value of an oral hearing and suggest it to the client, or be able to justify the cost if the client is reticent to proceed. The consequence of this is that their lack of experience is perpetuated. Conversely, those who appear regularly may well be more likely to have an understanding of the potential value of an oral hearing, an eye for where an oral hearing may assist and sufficient experience to be able to explain the value by reference to their personal experience. These attorneys may then continue to gain instructions to appear and gain even more experience in oral advocacy, perhaps enough to involve others and coach them on their performance.

A silver lining

The positive message is that (at least in relation to IPO proceedings) most representatives are in a very similar position, such that few representatives appearing at the IPO should feel that their opponent has a substantial advantage in terms of experience, whether the other side is represented by a fellow attorney or a barrister. There is, however, the possibility that some firms may accelerate away from others in this specialist practice.

**TABLE 2:
TOP 25 TMA/SOLICITORS
APPEARANCES 2010-2014**

NAME	FIRM
1 Julius Stobbs	Stobbs IP
2 Alan Fiddes	Urquhart-Dykes & Lord LLP
3 Martin Krause	Haseltine Lake
4 Ian Bartlett	Beck Greener
5 Ian Wilkes	Groom Wilkes & Wright LLP
= Kate Széll	Venner Shipley LLP
= Kieron Taylor	Swindell & Pearson Limited
= Rowland Buehrlen	Beck Greener
9 Linda Harland	Reddie & Grose LLP
10 Bruce Marsh	Wilson Gunn
= David Crouch	Bromhead Johnson
12 Aaron Wood	Swindell & Pearson Limited
= Alan Bernard	Cleveland
14 Alastair Rawlence	Novagraaf
= Andrew Marsden	Saunders & Dolleymore LLP
= Angela Fox	RGC Jenkins & Co
= Barbara Cookson	Filemot
= Bernard Whyatt	Brandprotect
= Chris McLeod	Squire Patton Boggs
= Jeffrey Parker	Jeffrey Parker & Company
= John Groom	Groom Wilkes & Wright LLP
= John Reddington	Williams Powell
= Paul Kelly	
= Robert Sales	Swindell & Pearson Limited
= Ross Manaton	Bromhead Johnson

**TABLE 3:
TOP 25 BARRISTERS
APPEARANCES 2010-2014**

NAME	FIRM
1 Simon Malynicz	3 New Square
2 Michael Edenborough	Serle Court
3 Jesse Bowhill	8 New Square
4 Denise McFarland	3 New Square
5 Benet Brandreth	11 South Square
6 Andrew Norris	Hogarth Chambers
7 Ian Silcock	Hardwicke
8 Guy Tritton	Hogarth Chambers
9 Guy Hollingworth	1 Essex Court
10 Benjamin Longstaff	Hogarth Chambers
11 Christopher Hall	11 South Square
= Fiona Clark	8 New Square
= Hugo Cuddigan	11 South Square
= Jacqueline Reid	11 South Square
= Thomas St Quintin	Hogarth Chambers
16 Giles Fernando	(formerly 11 South Square)
17 Iona Berkeley	8 New Square
18 Jonathan Hill	8 New Square
19 Tom Alkin	11 South Square
20 Amanda Michaels	Hogarth Chambers
= Anna Edwards-Stuart	11 South Square
= Douglas Campbell	3 New Square
= Emma Himsworth	1 Essex Court
= Malcolm Chapple	New Square Chambers
= Peter Colley	Hogarth Chambers

While portfolio management risks becoming ever more commoditised in the eyes of clients and open to challenge from online firms and companies that specialise in legal process outsourcing, current trends suggest that a handful of firms will obtain a significant advantage in the area of contentious proceedings over the remainder and will be able to genuinely claim to have a competitive advantage.

We may find that not all firms are created equal, and that the size and shape of these firms – and the experience of working at them – may begin to diverge substantially.

Trends suggest that some firms will obtain an advantage in contentious proceedings and will be able to claim to have a competitive edge



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Aaron is a member of ITMA's Higher Rights working group. He has appeared before the UK IPO (including before the Appointed Person), the High Court, IPEC and the Court of Appeal.



State of confusion

In light of 'saucy' proceedings and potential new civil powers for brand owners, Nick Smee brings us up to date on the issue of lookalikes

The Department for Business, Innovation & Skills (BIS) is considering whether to grant brand owners a new civil injunctive power to tackle lookalike packaging. The objective is to address a perceived enforcement gap, with brand owners seeking to combat the seemingly ever-increasing range of lookalike products lining the shelves. A consultation calling for evidence on the matter closed on 19 May this year, and the results were due to be released as this issue was being prepared for print. But what options do brand owners currently have, and will the proposed new

regulations shift the balance of power in their favour?

Potent weapon

Trade marks can often be the most potent weapon in a brand owner's arsenal. Lookalike packaging incorporating a sign that is similar to a registered trade mark and used in respect of the same or similar goods will infringe that trade mark if it causes a likelihood of confusion on the part of the public.

However, lookalike packaging can often merely remind consumers of branded goods, without necessarily confusing consumers into believing

they are from the same or an economically linked undertaking. Confusion can be difficult for brand owners to prove, as consumers are becoming increasingly used to seeing retailers' own-version products on the shelves. Retailers can also reduce the risk of confusion by displaying their own name prominently on the packaging.

Nevertheless, a trade mark infringement action may still be effective where the retailer has done enough to negate a risk of confusion. The Trade Marks Act 1994 provides enhanced protection for trade marks with a reputation, where use of a

sign takes “unfair advantage” or is detrimental to the distinctive character or repute of that trade mark. Unfair advantage taking clearly lies at the heart of the lookalike issue. In *L’Oréal v Bellure*, the European Court of Justice (as it was then known) defined this concept as “riding on the coat-tails” of the mark to benefit from its power of attraction, reputation and prestige. This provides a strong basis of attack for owners of trade marks with a reputation. There is no need to prove that consumers are likely to be confused, nor that actual damage has been caused.

However, this course of action is only available where the brand owner has registered a similar trade mark. For this reason, lookalike products will often mimic the get-up of the branded products, without necessarily using wording similar to the brand name or logos similar to device marks registered by the brand owner. A good example of this is the *United Biscuits v Asda (Penguin v Puffin)* case, where the word “Puffin” was found to be insufficiently similar to the Penguin trade mark to amount to trade mark infringement.

A possible solution to this problem is to register trade marks for the packaging as well as the brand name. The Saucy Fish Co did just that. In a rare public case between a brand owner and a major retailer, The Saucy Fish Co, which features on this year’s list of Britain’s CoolBrands®, has issued High Court proceedings against discount retailer Aldi. We are yet to see whether The Saucy Fish Co will succeed, but notably it has pleaded infringement of a device mark depicting the packaging for its fish and sauce products, registered in a series of different colours. Aldi has consented to a limited interim injunction, requiring it to remove the lookalike products from its shelves pending the final outcome of the claim. It is unclear why the parties consented to this injunction, but it involves some risk for The Saucy Fish Co as it will have to compensate Aldi for its losses if Aldi successfully defends the claim.

In most cases the lookalike packaging must actually deceive the consumer into purchasing that product in the mistaken belief that it is buying the branded product



Get-up marks can provide invaluable protection, but of course this type of trade mark is only useful to the extent that the trade marks are kept up to date to resemble the current packaging used by the brand owner.

Where no suitable trade mark is available, the tort of passing off may come to the rescue. The *Penguin v Puffin* case is a great example of a successful passing off claim against a lookalike product, even where the trade mark action failed. However, in lookalike disputes, the “misrepresentation” element of the tort can often be even trickier to prove than a likelihood of confusion – in most cases the lookalike packaging must actually deceive the consumer into purchasing that product in the mistaken belief that it is buying the branded product. This was the stumbling block that derailed Moroccan Oil Israel Limited’s recent action against Aldi over its Miracle Oil product (see page 30, *ITMA Review*, September 2014).

Design rights and copyright

Brand owners may also consider registering UK or Community designs to increase their protection. Registered designs are infringed by a product that does not produce a different overall impression on the informed user.

Brand owners may also have unregistered rights in their packaging. Copyright and unregistered design rights subsist automatically, and may be infringed where the original branded packaging has been copied in the lookalike version.

UK unregistered designs are unlikely to be helpful in lookalike cases, as they do not cover surface decoration. On the other hand, Community unregistered design rights could well be useful. The drawback of the Community regime is that protection only lasts for three years. A common stumbling block is proving that the brand owner actually owns the copyright or design, particularly where a design agency has been used. Brand owners therefore



need to ensure that their house is in order when packaging is first developed, by, for example, obtaining written assignments from agencies.

Commercial considerations

Disputes over lookalike products rarely make it to the courts. One of the main reasons for this is that brand owners are often understandably reluctant to take legal action for fear of harming a key commercial relationship or, worse still, losing shelf space. One of the interesting features of The Saucy Fish Co case is that Aldi did not stock The Saucy Fish Co's products when the claim was brought and so The Saucy Fish Co may have considered there to be a lower risk from a commercial relationship point of view. This is also the position in respect of the Moroccan oil case.

It is important for brand owners to consider carefully how long they will allow a lookalike to remain on the market without taking action. Some retailers have been seen to adopt the practice of incrementally getting closer to the "look" of the product they originally copied over a period of time. The result of this "creep" effect may be that it becomes much harder to take action against the latest iteration, as a lookalike producer will point to how minor the changes are to its own previous version, and will say that it "copied" its own product, rather than the brand owner's.

Potential new powers

The Consumer Protection from Unfair Trading Regulations 2008 (CPRs) seek to protect consumers against unfair commercial practices. In particular, they target practices that influence consumers to make a purchase decision that they would not otherwise have taken.

The CPRs prohibit "misleading" actions and omissions, as well as "aggressive" practices, which are all assessed by reference to their effect on the transactional decision of the "average consumer". There is also a

blacklist of practices that are deemed to be unfair in all circumstances, which includes "promoting a product similar to a product made by a particular manufacturer in such a manner as deliberately to mislead the consumer into believing that the product is made by that same manufacturer when it is not". Furthermore, there is a general ban against commercial practices deemed to be "unfair" that do not fall within the other specific prohibitions. The penalty for an offence can be a fine and/or up to two years' imprisonment.

Brand owners do not have the right to take action under the CPRs directly against a competitor. Under current law, if a brand owner wants to enforce these provisions in relation to a lookalike product, it must apply to Trading Standards, which will base its decision on whether or not to act on the local enforcement policies, priorities and available resources. Trading Standards has traditionally taken the view that lookalike products do not create sufficient consumer detriment and so has generally not prioritised the issue. Consequently, some brand owners consider there to be insufficient resources to tackle the problem of lookalikes.

In response to complaints from brand owners that there is an "enforcement gap", the BIS decided to review the need for granting businesses a civil injunctive power for taking action against lookalike products under the CPRs. In April this year it launched a call to brand owners for evidence. A key focus of its review is the extent to which consumers are suffering from lookalike products.

The new law would give businesses a direct civil injunctive enforcement action against lookalike products only. The test for the court would focus on whether consumers have been misled and whether or not competitors have lost business.

Trading Standards has given a negative response to the proposals. It is concerned that the new powers would only be used by larger businesses that can afford to take legal action, and that this would be unfair.

If implemented, however, this new power would give brand owners another weapon in the fight against lookalike products. How powerful that weapon will be in practice, and whether it will help warn off potential infringers, is yet to be seen.

Trading Standards is concerned that the new powers would only be used by larger businesses that can afford to take legal action, and that this would be unfair



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Jet-powered justice

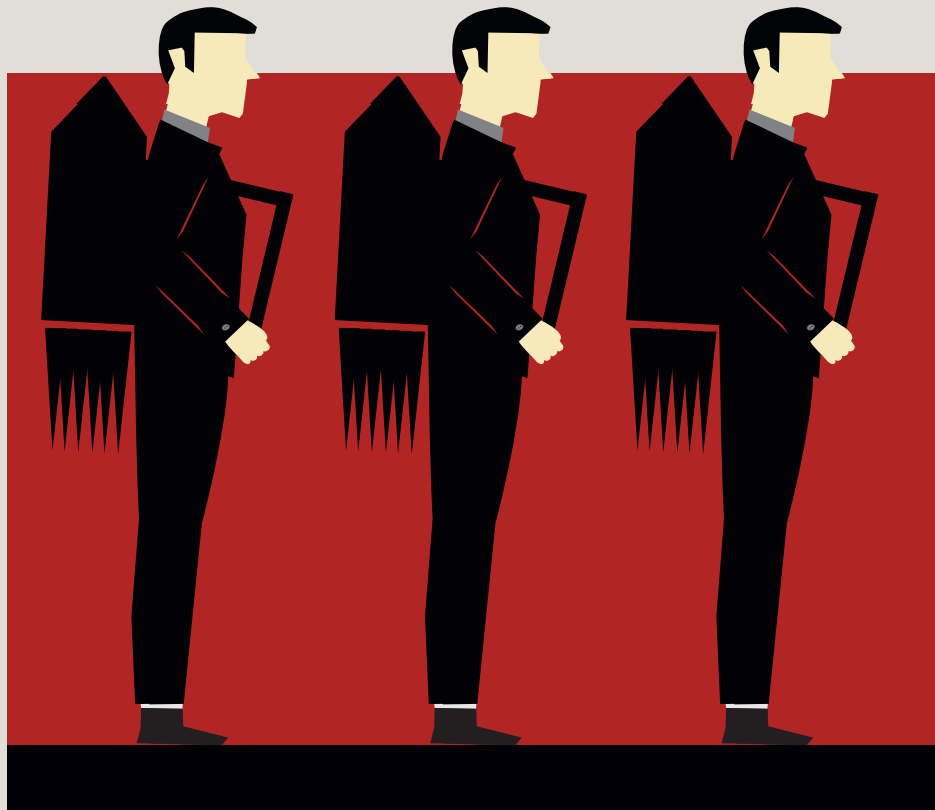
'Vivit ex parte sunt',¹ says Denise McFarland, offering some ancient inspiration for those involved in modern IP litigation

The use of legal Latin in Court may be rare these days, but even rarer still is an example of taking a case from first knowledge of infringement to full judgment in less than two weeks.

Such jet-propelled justice is of course a naturally rare phenomenon, and the Civil Procedure Rules (CPR) include a range of suitable checks and balances to ensure that the fair dispensation of legal remedies is not compromised simply because speed is of the essence. However, in the right case, on the right facts and with the right approach, the wheels of the Court can turn with exemplary swiftness.

In a case earlier this year (*The Conair Group v Fineness Curl and others*, as yet unreported – claim number IP14M02178), involving the well-known and exceedingly popular BaByliss brand of hair styling products, Mr Justice Birss, who heard the matter during the May short vacation, was satisfied that the intended Claimant's legal team had provided sufficient evidence to justify the grant of an injunction and interim order, without notice, and on the basis of a then-intended, but not yet issued, action. In previous parlance, it could have been termed an "ex-parte application", based in part on "quai timet evidence".

The Claimant, Conair Group Limited (which has based its headquarters in Hampshire) is part of the global Conair Group under the parental control of Conair Inc in the US. Conair has an enviably wide-ranging IP portfolio,



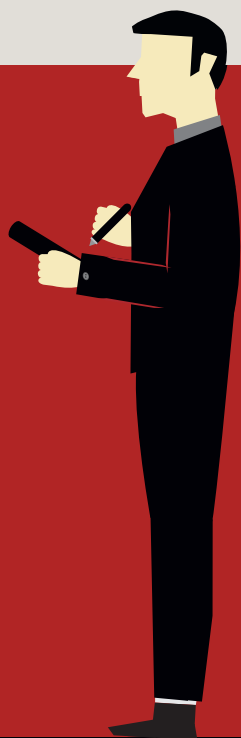
and is diligent in the protection and fortification of its rights. This case involved trade marks, registered designs and patent issues. In this matter, the UK High Court was sitting as both a domestic court and a court of the European Community (for trade marks and designs).

The Defendants had come to the attention of the Claimant a few days before the first application was made to the court, after the Defendants had been seen at a trade fair, apparently offering counterfeit products for sale and supply, in person, via sales leaflets

and also online. Conair's rapid response team of attorneys (Nigel Brooks, ably assisted by Angeline de Hartog and Stephanie Brickell) was able to pull together comprehensive and detailed evidence in a very short space of time, by undertaking searches and diligent digging online to find out more about the Defendants, their trading history and current commercial presence. It appeared that they were trading from domestic premises in the Midlands, and if they had a warehouse or storage facility, its location was unknown. Interestingly,

*'Salus
populi
suprema
est lex'*

TRANSLATION:
*The health of the people
should be the supreme law*



and perhaps unusually in cases involving unlawful copies, the prices charged by the Defendants were not particularly cheaper than the retail prices for the genuine products, and the adoption of words and phrases that appeared to mimic the publicity of the Conair Group were all persuasive of the illegitimate manner in which the Defendants were undertaking the acts giving rise to complaint.

When the first Court Order was granted, on an *ex-parte* basis, it required the Defendants to comply with certain mandatory requirements for the provision of information and details to enable the Claimant to understand the true extent and nature of the web of unlawful trade of which the Defendants appeared to be a part.

A return date was imposed a week later, enabling the Defendants to then appear before the court and explain their position, or submit to further relief.

IP specialist solicitor Mark Furber, together with a professional process

server, served the Court Order and papers on the Defendants and found them willing to take active steps to comply with bringing a rapid resolution to the matter.

Choices and concerns

In cases of this type, a claimant obviously has choices to make, and can turn to Trading Standards officers or even the police to gain suitable relief and remedies to seek to ensure a lock-down of rogue traders. But in this instance it is hard to believe that any other route would have achieved such a quick and comprehensive result.

The Claimant was particularly motivated by concerns for the public at large and for the professional market, which is well served by Conair. If unlawful copies were allowed to find their way to hair salons and/or into the hands of domestic customers, significant damage could be wrought if such products failed to operate as they should, or, worse still, were found to be dangerous. In some instances involving foreign litigation conducted by Conair in the past, faulty wiring and non-standard plugs had been found to be used by unlawful traders, so the “protection of the public” was a particularly high-priority concern. And as Marcus Tullius Cicero himself put it so succinctly: “*Salus populi suprema est lex.*”²

The hearing on the return date was dealt with by Henry Carr QC sitting as a Judge of the High Court. Carr was both patient and considerate in dealing with the litigant in person who appeared for the Defendants. Judgment was entered in favour of

In the right case, on the right facts and with the right approach, the wheels of the Court can turn with exemplary swiftness

If you are seeking urgent relief, you must dot every 'i' and cross every 't'. The court and the recipient need to see that all aspects have been fully covered

the Claimant on the basis of consent by the Defendants. The Defendants were intelligent and capable entrepreneurs, having previously operated other businesses, and having an astute awareness of the IP issues raised, but, when faced with solid evidence and a determined legal team, the Respondents were persuaded to recognise the sense of adopting early dispute resolution.

Speedy suggestions

If you are hoping to effect such a fast-paced resolution, some points to note:



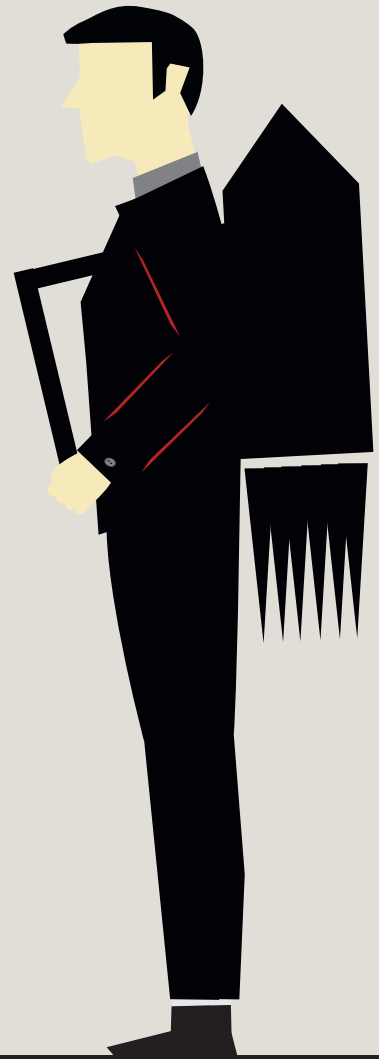
Unusual can be useful.

Don't be shy of making an application on an unusual basis. If the facts fit, the rules provide for the grant of rapid and robust relief.



Don't cut corners.

There is no sense in trying to present "evidence-lite" to a judge. If you are seeking urgent relief, you must dot every "i" and cross every "t". The court and the recipient need to see that all aspects of the case have been fully covered. The doctrine of providing "full and frank disclosure", as it is often colloquially termed, is enshrined in the CPR at 25.3.5. And, indeed, if there has been material non-disclosure by the applicant, this can be a proper basis upon which the respondent can seek to discharge or vary any injunction or other order granted. (See CPR 25.3.6.)

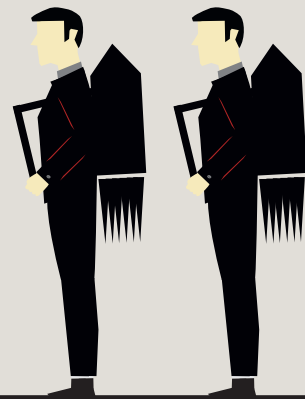


If there are complex chains of title or sub-licensing arrangements, or if certain assignments require detailed comment, then don't shirk from embracing such matters and explaining them in the evidence. You will hopefully not need to focus on them, but they need to be dealt with.



Don't over-egg the pudding.

Let the facts speak for themselves ("*Res ipsa loquitur*"³). If you have a strong and meritorious case, the chances are that the judge will be able to see the strength of the case on infringement, passing off, or whatever it may be, without having to resort to a detailed analysis. Indeed, it ought to be so, otherwise there is a compelling reason for the defendants to be present in order that the court may provide a balanced assessment. In the



BaByliss case, the design of the goods complained of, and claims made about them, were clear from the images posted on the Defendants' website and from their printed flyers.



Act in private. An application made without notice almost certainly ought to be made in private, otherwise the object of the exercise may be lost (see CPR 39.2.2 and 39.2.3). However, the ultimate decision is for the judge to make. The judge must be provided with a compelling and properly reasoned argument to take such an unusual step, which is contrary to the general policy of hearings being dealt with in an open court.



Delay is a death knell. Remember Ovid's warning: "*Tempus edax rerum.*"⁴ It can be very hard to get clients to move with the alacrity required to prepare evidence and the papers necessary to present to the court. However, because delay on the part of an applicant can, of itself, be a basis on which a respondent can seek to vary or set aside an order, then, in the words of Lord Justice Simon Brown⁵, it is advisable to act with "all reasonable celerity in the circumstances". That, in practical terms, almost certainly means working long hours, into the evening and weekends (if necessary), to prepare the papers for court. Successful without-notice applications are not for slackers.



Use belt and braces. Prepare evidence of service just in case the defendant chooses not to appear on the return date or fails to acknowledge service

of any of the papers. It is worth engaging the services of a properly qualified person or persons to ensure that full and proper service is effected, so that they can prepare an affidavit or other certification. In the BaByliss case, a belt and braces approach included asking the court to allow duplicate service of documentation via the email addresses known for the Defendants, as well as direct service to ensure that tangibility and reality over-ride any potential vagaries of "virtual" service.



Don't skimp on detail. Ensure that every part of the relief sought in your draft Court Order(s) can be fully justified and explained. Interim remedies are discretionary remedies, not rights, per se. However, by appealing to the wider case management powers of the courts to gain relief, information, early disclosure or inspection of goods or documents, there is a real prospect of bringing matters to a full conclusion with rapidity and robustness.

History lessons

Finally, it is sometimes comforting to remember that there are few

novelties in life and even fewer in the law. And for every trade mark, copyright or design case with which you may be grappling today, there will lie somewhere a dusty scroll or wax tablet that bears witness to the case brought in the 1st century AD by Gaius Lucius Portas of Via Portico, a well-known supplier of high-quality sandals and belts, which were stamped with his personal maker's mark of the Trident and Rope. These marks were cruelly and deceitfully replicated, to the dismay of ladies and gentlemen high-born and free-born alike, by one Apollonius Quintus, who, making inferior goods, did without permission or due reason, knowingly cause to be marked upon such goods a device of a Rope and Trident. Shame on you Apollonius Quintus.

For those of you contemplating 21st-century protection of the most satisfying and comprehensive kind for your client's IP rights, I would commend to you these ancient parting words, to guide you and give you inspiration. From Horace, Roman poet and philosopher:

*"Dimidium facti qui coepit habet
Sapere aude Aequam memento rebus
in arduis Servare mentem."*

Or: remember that to have begun is half the job – be bold and be sensible. And when the going gets rough, remember to keep calm.

- 1) The ex-parte application is alive and well
- 2) The good of the people is the chief law
- 3) The thing speaks for itself
- 4) Time, the devourer of everything
- 5) Regency Rolls Limited v Carnall [2000] EWCA Civ 379



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What's my line?

Roy Scott was one of the experienced speakers helping to define the role of the paralegal at two informative summer events

The Oxford Dictionary definition of the role of a paralegal is “a person trained in subsidiary legal matters but not fully qualified as a lawyer” – an interesting definition that is interpreted in many different ways in both the UK and US. It also provided a stimulating topic for discussion at ITMA's July and August roundtable discussions for Trade Mark Administrators.

ITMA President Chris McLeod opened proceedings by addressing the audience and giving his interpretation of the role of a paralegal and how this varied from firm to firm. To highlight this point, the later discussions were focused around the role of a paralegal in-house, in a law firm and in a Trade Mark Attorney business. Three speakers were lined up to provide the attendees with insight into their differing roles.

First was Debbie Hallissey, an in-house Paralegal from Norgine. Hallissey's role could be considered to be specialised given the pharmaceutical nature of the business. She mentioned how she started out as a patent secretary, before moving into the patent formalities department. Following

a short break from work, Hallissey rejoined the profession and started to focus on a career in trade marks.

Hallissey's day-to-day paralegal duties are varied, and cover the whole life cycle of a trade mark, from filing through to registration and renewal. In addition, she highlighted areas of her duties that could be considered to be primarily in-house, such as divestments, management reporting, parallel imports, name creation, branding guidelines and checking artwork for products. Because Norgine is a pharmaceutical company, various regulatory constraints have to be adhered to. For example, it is vital to identify the differences between a parallel import and the real product. Hallissey's role in this process includes conducting an initial review of the parallel import, reporting any differences to her supervisor and agreeing on what action, if any, needs to be taken. This proved to be an area of particular interest to the attendees, as many of them had not come across this type of work in their roles.

Complex career

It was my turn, then, to provide the second presentation of the session. My career spans several decades and includes paralegal roles in the

Government, a Trade Mark Attorney business and a law firm, and I spoke specifically about the third role.

My presentation highlighted how a law firm paralegal could be providing corporate support one day, for example in the form of a due diligence exercise following a merger or acquisition, and the next be handling regular filing of trade mark applications at the UK IPO, OHIM and overseas. My duties also covered searching, reporting (acceptance, publication, registration, renewals) and handling registerable transactions, such as assignments and licences.

One interesting point I aimed to highlight was that paralegals in law firms tended to be treated as fee-earners with hourly charge-out rates and billable targets. So understanding Law Society accounting rules with regard to billing was essential in this role.

Tanya Buckley, a qualified Trade Mark Attorney from RGC Jenkins, completed the speaker line-up. She talked about her time as paralegal in a Trade Mark Attorney firm and how she was able to make the transition to being a qualified Trade Mark Attorney. Buckley gave a whistle-stop tour of her career, which saw her start as a billing

clerk, progress to a Trade Mark Administrator and move on to become a trade mark searcher, before obtaining a role as a trainee Trade Mark Attorney.

She provided her own interpretation of the term paralegal as “someone who is not a qualified attorney but assists an attorney in numerous tasks”. She also pointed out that there is no specific qualification in the field for a paralegal and highlighted that the paralegal structure in the UK is less rigid than it is in the US.

The three presentations and subsequent discussions proved that there were similarities in the type of tasks carried out by paralegals, including reporting, filing, advertisement, registration and preparing costs estimates for recording changes of name, address, assignments or licences. Paralegals can also be involved with notarisation, legalisation, preparation of evidence and preparing invoices. But what became abundantly clear was that the role of the paralegal not only varies from firm to firm, but can vary from individual to individual within a business.

Uniting principles

All paralegals need to have excellent time management and organisational skills, with a keen eye for detail. They can be involved in various aspects of the running of a business, such as the practice management system, business development and have direct client contact.

What is also important, for a paralegal to have a varied and

exciting career, is to find a mentor. This should be someone who is willing to encourage their development and is keen to provide the paralegal with duties that may not be considered part of their everyday role. By the same token, the paralegal needs to be proactive in seeking a Trade Mark Attorney who can act as a mentor, for instance by volunteering to do tasks that are not part of their current duties or doing that little bit extra with regard to an existing job for which they are already responsible.

However, it is not always possible to do this, as certain working environments are not flexible enough to allow roles to be interchangeable and fluid. That being said, there is no harm in asking, and that appeared to be the main concern of the paralegals at the roundtable: the inability to get exposure to other roles to expand their experience and knowledge base.



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The role of the paralegal not only varies from firm to firm, but can vary from individual to individual within a business



Taking ASEAN action

Local expert Gladys Mirandah provides the quick-start guide to seeking trade mark protection in a fast-evolving region

The best-translated trade marks are those that sound the same as the original trade mark



**SINGLE
OR MULTI-CLASS
APPLICATIONS**

SINGLE:
Cambodia, Laos,
Malaysia and Thailand

MULTI:
Brunei, Indonesia,
Philippines, Singapore
and Vietnam

**NON-USE
CANCELLATION?**

Philippines, Malaysia,
Thailand and Indonesia
**YES, AFTER A PERIOD OF
THREE CONSECUTIVE YEARS**

Singapore, Laos, Cambodia,
Brunei and Vietnam
**YES, AFTER A PERIOD OF
FIVE CONSECUTIVE
YEARS**

The Association of Southeast Asian Nations (ASEAN) is a political and economic organisation made up of 10 countries in Southeast Asia. Originally formed in 1967 by Indonesia, Malaysia, the Philippines, Singapore and Thailand, its membership has since expanded to include Brunei, Cambodia, Laos, Myanmar (Burma) and Vietnam. In 2006, the ASEAN, as a region, was granted observer status in the United Nations General Assembly.

In spite of the challenges faced by the Philippines and Thailand in 2013, the region's performance has shown resilient growth in the past years

supported by strong domestic consumption and investment, leading *Forbes* magazine to describe it as "one of the most rapidly growing regions of the global economy".

To a company venturing into these tempting, but largely unknown territories, brand protection is top priority. However, there is little information written on the intricacies of seeking trade mark protection in ASEAN Member States, so a local guide can prove a very valuable resource.

Hopefully, then, the information provided here will serve as a jumping-off point, helping to prepare brand representatives to make informed business decisions when entering this promising growth area.

The registration process

There is no central trade mark registration system in the ASEAN region. Hence, marks have to be protected by filing an application in each and every jurisdiction.

However, it should be noted that Singapore [2000], Vietnam [2006] and Philippines [2012] have joined the Madrid Protocol, making it possible to extend the protection of an international registration to these countries. Indonesia and Thailand are expected to jump on to the Madrid System bandwagon soon.

Except for Myanmar, which follows a Cautionary Notice system, the trade mark registration process is, in general, marked by four milestones:

1) Completion of formality requirements

Except for Brunei and Singapore, a Power of Attorney is necessary to start the filing process. While most Powers of Attorney only require the signature of an authorised representative of the trade mark owner, some jurisdictions, such as Cambodia, Laos and Thailand, require a notarised Power of Attorney.

Further documents, such as a Statutory Declaration of Bona Fide Ownership of Mark or Statement of Mark Owner are required for Malaysia and Indonesia, respectively.

2) Substantive examination

The application will be examined based on absolute and relative grounds in accordance with the local practice of each jurisdiction.

3) Opposition period

After substantive examination, marks are generally published for opposition by third parties, except in Vietnam where applications are published after formality examination. The publication period for each country varies (see table on page 25).

4) Registration or renewal

When publication is cleared, a certificate of registration is issued by the local trade mark registry. The registration will be in force for 10 years. However, the determination of the protection period may differ according to jurisdiction (see table on page 26).

In Myanmar, trade marks and the process by which they are





APPLICATION LANGUAGE

*Also known as an alphasyllabary, a segmental writing system in which the consonant-vowel sequences are written as a unit

registered is contained in several statutes, most notably: the Penal Code of 1860, which gives the definition of a trade mark; the Private Industrial Enterprise Law, which provides that no business is allowed to “distribute or sell its goods without trademark”; and, most importantly, the Registration Act, which governs the procedure and requirements for registration of all property, including trade marks. At present, a mark owner must execute a Declaration of Ownership of Trademark pursuant to section 18 of the Registration Act and publish a Cautionary Notice in a Myanmar newspaper, making known to the public the mark’s ownership. It is also customary and advisable to republish the Cautionary Notice every three years to keep third parties on notice of the mark’s ownership. Currently, WIPO and INTA are closely working with the Myanmar Government to pass appropriate IP laws to be enacted in the near future.

IP regimes

Indonesia, Laos, Philippines, Thailand and Vietnam follow the first-to-file system, but Brunei, Cambodia, Malaysia, Myanmar and Singapore are based on first-to-use. While a first-to-use system can be seen to mean that registration is not necessary, and rights over the mark may be acquired through adoption and use, it is always recommended that marks be registered in each jurisdiction.

Language and script

Crucially, in the ASEAN region, it is important to conduct a pre-filing search and a local trade mark agent can be vital in this regard.

In addition to the usual search report to identify identical and confusingly similar marks in a local trade mark registry, the trade

mark owner should seek an opinion on whether there are negative connotations of the mark in a local language or culture that would suggest a delay of launch or even warrant the reformulation of the brand.

Moreover, it will also be helpful to request a local trade mark agent to conduct a search of the mark using a local search engine to provide a local flavour of the market being considered.

It is important, also, to consider the language in which the mark application will be filed with the local trade mark registry.

Brunei, Cambodia, Malaysia, Myanmar, the Philippines and Singapore accept trade mark applications filed in English. However, alternative local languages are likewise accepted in Cambodia (Khmer), Malaysia (Bahasa Malaysia) and Myanmar (Burmese). On the other hand, Indonesia, Laos, Thailand and Vietnam will only accept applications filed in their local language: Bahasa Indonesia, Lao, Thai and Vietnamese, respectively.

It should also be noted that Laos, Myanmar, Thailand, Cambodia and Vietnam have their own local scripts – as opposed to Malaysia, Brunei and

Indonesia, where the local language is written in roman characters – while Vietnam has its local language in Latin characters with diacritics.

In countries where a different language and script is involved, it is best for a trade mark owner to determine and file a separate application to register the most suitable translation or transliteration of its mark, especially when the script to be used in the country of interest is a script other than the Latin alphabet. The process of determining the translation or transliteration is important considering that the translated mark will be used to promote and sell the products or services in the local market. Needless to say, consumers will be able to recognise the brand only when they are able to identify the mark and make a connection on a practical level.

There are different ways to act when considering a translation of a mark in local script: a literal translation, a phonetic translation or a combination of these.

A literal translation takes place when an English mark is translated word for word into the local script. This type of translation works when the trade mark has a specific meaning. On the other hand, a trade

ASEAN trade mark practice at a glance

OPPOSITION	
COUNTRY	PUBLICATION PERIOD
Brunei	3 months
Cambodia	90 days (from publication of the mark after registration)
Indonesia	3 months
Laos	No provision in law
Malaysia	2 months
Philippines	30 days (extendible)
Singapore	2 months (extendible)
Thailand	90 days
Vietnam	Any time between publication and grant of registration (approximately 9 months)

COUNTRY
MYANMAR
ACCEPTABLE
Burmese or English
LANGUAGE SCRIPT
Local script (abugida)

COUNTRY
PHILIPPINES
ACCEPTABLE
English
LANGUAGE SCRIPT
Latin English alphabet

COUNTRY
SINGAPORE
ACCEPTABLE
English or Latin
LANGUAGE SCRIPT
English alphabet

COUNTRY
THAILAND
ACCEPTABLE
Thai
LANGUAGE SCRIPT
Local script (abugida)

COUNTRY
VIETNAM
ACCEPTABLE
Vietnamese
LANGUAGE SCRIPT
Latin alphabet with diacritics

ASEAN trade mark practice at a glance... continued

REGISTRATION		
COUNTRY	TERM	TERM DETERMINED FROM
Brunei	10 years	Registration date
Cambodia	10 years	Filing date
Indonesia	10 years	Filing date
Laos	10 years	Registration date
Malaysia	10 years	Filing date
Philippines	10 years	Registration date
Singapore	10 years	Filing date
Thailand	10 years	Filing date
Vietnam	10 years	Filing date

mark owner runs the risk that some or all of the local characters will sound different than the original trade mark when pronounced by the local population.

A phonetic translation involves creating a local character name that sounds like your original trade mark. This method is preferable when the trade mark has a reputation among local-language-speaking consumers.

The best-translated trade marks are those that sound the same as the original trade mark and at the same time evoke a distinguishing aspect of the brand or show a positive meaning using the local language.

Specification of goods or services

While only Malaysia and Singapore are contracting parties to the Nice Agreement, the other ASEAN trade mark registries also use the Nice Classification for the purpose of the registration of marks. So adoption of class headings is often used to achieve the broadest protection for the trade mark owner. However, this strategy will not be effective in Brunei and Thailand, where the local trade mark registries require a specific enumeration of the

goods and services to be protected. Here, it is necessary to ensure that all possible goods and services are included in the application. In Vietnam, class headings are acceptable provided the item is listed in the alphabetical list of goods and services of the Nice Classification.

Once the specification of goods and services is finalised, the trade mark owner should also be mindful of the countries in which multi-class applications are accepted to minimise filing costs. Currently, Brunei, Indonesia, the Philippines, Singapore and Vietnam accept multi-class filing. By way of strategy, while multi-class filing of application is acceptable in Indonesia, it is recommended to file single-class applications to prevent further delay in the event one of the classes receives an objection.

Use requirements

While Cambodia and the Philippines oblige a trade mark owner to file a Declaration of Use during the term of the trade mark registration, no such requirement is imposed by the other ASEAN countries.

In Cambodia, the trade mark owner is required to file an Affidavit of Use/Non-Use any time between the fifth and sixth year from date of registration. Failure to file will result in the removal of the registration. However, the act of removal is not automatic upon the local Trade Mark Registry.

The Philippines requires a trade mark owner to file a Declaration of Actual Use ("DAU") on two occasions: within three years from filing date (third year DAU), and at any time between the fifth and sixth year from date of registration (fifth year DAU). In both cases, failure to file the DAU will result in the automatic removal of the registration.

There is also a minimum period required by the law of each country during which a mark should be put to genuine use in commerce by the trade mark owner, or become vulnerable to a non-use cancellation action by a third party. Indonesia, Malaysia, the Philippines and Thailand expose a mark to a non-use cancellation after three consecutive years. Brunei, Cambodia, Laos, Singapore and Vietnam provide for a period of five consecutive years before non-use cancellation action provisions kick in.



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Pole position

Paola Gelato picks out front-running cases that reflect the Italian courts' view of unconventional marks

Non-traditional trade marks, while not belonging to a conventional category, can nonetheless be apt at fulfilling the function of uniquely identifying the commercial origin of the product and/or the service they characterise. Indeed, such signs have become increasingly appealing for marketing and advertising experts, since they are, per se, endowed with a very significant communication and selling power, with respect to more traditional signs. At the same time, the notion of what constitutes a distinctive sign has changed over the years, now conveying a brand culture – a message that goes beyond the simple indication of origin of products or services.

In Italy, according to Article 7 of the Intellectual Property Code and Article 4 of Council Regulation (EC) No 207/2009, all signs can be registered as a trade mark – including shades, colours, shapes of products and so on, capable of distinguishing products or services of one undertaking from another one – provided they can be graphically represented. And this is the greatest difficulty for non-traditional trade marks.

Colour contrasts

Case law, in searching to balance clashing interests, is oriented towards defining the principle of the trade mark in the light of the general assumption that the semantic element has a distinctive capacity.

So the role of shape or colour must appear to be a primarily distinctive one, and only secondarily shall it appear useful or decorative.

The Court of Justice of the European Union (CJEU), in *Libertel* (C-104/01, *Libertel Groep BV v Benelux-Merkenbureau*, 6 May 2003), recognised protection for single colours provided they are clearly defined (ie identification through an international Pantone number).

On this point, the Italian Supreme Court's decision number 3666, dated 14 March 2001 (in *Foro It.* 2001, 2539), states that: "even colour can constitute a trade mark, that can be registered, provided that it does not have a role that intrinsically describes the product, but it is linked to it by purely original and effectively individualising imagination." It is necessary that the connection between colour and product represents the manifestation of a creative act, without any risk of monopoly. Hence, distinctive character can be recognised only if colours have very particular shades, or are completely unusual compared to the relevant product (see Supreme Court, 1st Section, 2 December 2009, no 3478, in *Riv Dir Ind* 2009, 48).

In this matter, the Court of Venice, with a decision of 13 June 2008 (unpublished), recognised that a colour could be construed as a valid distinguishing trade mark, identifying the proprietary firm, also due to the acquired distinctive capacity arising from prolonged use of the trade mark, so that such use allowed the colour shade to become a symbol.

In this connection, the Milan Court on 11 September 2008 (unpublished),

has considered that the red Ferrari unregistered colour trade mark shall be legally protected, as per Articles 1 and 2 of the Italian Industrial Property Code, taking into account customers' perception and its acquired secondary meaning resulting from its extended use in commerce and advertising.

In spite of this decision, in Italy it still appears difficult to register and protect single-colour trade marks. In contrast, under certain conditions a combination of colours may be protected. In *Guccio Gucci SpA v Guess Inc* (case number 6095/2013 of 10 January 2013), the Court of Milan held that the Gucci red and green trade mark, consisting of coloured



stripes, was validly registered, despite the absence of the Pantone number; the Court considered that the trade mark was endowed of distinctive character and capable of identifying the origin of products.

However, Italian courts have recently shown themselves to be more open in enforcing single-colour marks, in particular, when secondary meaning and/or intensive use and notoriety of the sign are proved by consumers and/or press recognition (even lacking the

Pantone identification), since the Italian legal system recognises protection also to non registered but well-known trade marks.

Therefore, while assessing distinctiveness of a colour brand, or more generally, of a non-traditional sign, it is crucial to consider all factual circumstances – such as the duration of the use of the sign, promotional investments on the same, and consumers' perception of the brand – identifying a certain undertaking – as to let the trade mark acquire a semantic signification totally independent from the product in question.

More specifically, for single colours in the field of fashion, on 10 September 2012, Bologna IP Court (in an unpublished decision) allowed protection for the Christian Louboutin red sole trade mark, granting a preliminary injunction against

an Italian infringer that sold red-soled high-heeled shoes. In granting the requested preliminary injunction, the Court recognised the highly distinctive character of Louboutin's famous colour trade mark, underlying its well-known character and high level of recognition acquired among the consumers and professionals.

The Court also emphasised how the choice of the red colour, as applied to the shoe outsole was original, creative and not linked to any functional aspect of the product, underlining that the red colour does not express typical physical qualities of shoe soles, but appears to be imaginative, arbitrary and also, due to the secondary meaning effect, has acquired an additional distinctive strength.

Strong position

In the Louboutin case, the Judge considered that the balance point between distinctive trade marks and the need to avoid creating unjustified monopolies appears →





correct. The decision of the Bologna IP Court has been further confirmed by other Italian court decisions, and particularly by the Naples Court on 9 October 2012 (unpublished decision).

Louboutin's red sole trade mark can also be defined as a "position" sign, destined to be always affixed in the same position in the same proportions (see C-49/021, Heidelberg Bauchemie, 24 June 2004). Positional trade marks are not distinctive per se, but gain a distinctive character due to their particular position on the specific object.

As for well-known position trade marks, case law has recognised that Adidas' three-stripes logo has acquired distinctive character and reputation through use, thanks to the position of stripes placed on sport and leisure garments. Because the sign in its particular positioning is perceived as distinctive by consumers, the relevant public is likely to understand that the goods characterised by the three-stripes logo come from the same undertaking (see C-408/01, Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Limited, 23 October 2003). Moreover, the CJEU, in C-102/07 (in Adidas AG and Adidas Benelux BV v Marca Mode CV and others, 10 April 2008), has pointed out that the public's perception of a decorative sign cannot constitute a restriction to its protection, even if the sign lacked distinctive character in itself, but then has acquired it through use. So, under these circumstances, a trade mark owner's rights shall not

be examined in the light of the availability requirement. In fact, in the determination of the extent of protection to be granted to a trade mark formed by a sign not endowed per se with distinctive character, particular attention shall be paid to distinctiveness, acquired through a process of the sign becoming customary.

However, in K-Swiss (T-85/13, K-Swiss Inc v OHIM, 13 June 2014), the General Court ruled that five stripes appearing on the side of an item of

footwear would not be perceived by consumers as a trade mark, but instead would be seen as a merely decorative element, considering that evidence filed by K-Swiss did not prove that the mark would be noticed by consumers, "without the intrinsic characteristics of the shoes, being simultaneously perceived". In fact, consumers are not in the habit of making assumptions as to the commercial origin of products on the basis of signs, which are undistinguishable from the appearance of the goods themselves. As for the K-Swiss five stripes, these are likely to be perceived as a technical means to reinforce the shoes or as a pure embellishment of an indistinct common nature.

The peculiar combination of a colour position trade mark and its enforceability has also been judged by the Milan Court. On 3 January 2011, in the Vibram case (IP Italian Specialised Courts 2012), the Court acknowledged distinctive character in a colour sign, due to the habitual central positioning of the mark (a yellow-coloured trade mark, always affixed in the same position in the central part of the outer sole), and also thanks to the large spread of the products in question, each characterised by the presence of the colour position trade mark.

To conclude, following European and Italian case law, a non-conventional sign – for example, a colour – although originally devoid of distinctive character, or which, in principle, shall be kept available for use of all traders, can become registerable and be protected against third-party infringement if it has acquired distinctiveness and reputation through use, and is perceived by the public to identify products originating from the trade mark owner – giving an opportunity to restrict its use by third non-authorised parties, and overcoming the so-called "availability requirement".

The Court acknowledged distinctive character in a colour sign, due to the habitual central positioning of the mark



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Too pedantic with the ‘P’?

A failed opposition raised interesting questions for Geetha K

Do you find the marks shown in Figure 1 substantially similar? Is the letter “P” dominant in both marks?

Is it so dominant that the other elements in the mark are negligible?

These were some of the questions the IPO of Singapore (“IPOS”) had to contend with when faced with an opposition by Pirelli & C. S.p.A. (“Opponent”) against Tao, Hsiu-Chih (“Applicant”).

The Applicant owns CSL Sunmaster Enterprises Co, Limited, a Taiwanese company that designs and supplies curtains, blinds, sunshades and parts thereof. The Applicant has registered its mark in class 20 (Bamboo curtains; indoor blinds of reed, rattan or bamboo (*sudare*); curtain hooks and related products) and class 24 (Woven fabrics and knitted fabrics; non-woven textile fabrics; curtains of textile or plastic; shower curtains; curtains and such) in the European Union (EU) and Australia.

The Opponent is the fifth-largest operator in the world in the premium tyre sector. In addition to the PIRELLI trade mark, it relied on several trade marks filed in Singapore to support its opposition (see Figure 2).

The Opponent submitted that the elongated P is the dominant component of the marks, and that use of that element by the Applicant causes a likelihood of confusion in the public and is an act of passing off.

Interestingly, the Opponent initiated this opposition in Singapore, having failed in two jurisdictions – the EU and Australia – in the past. In fact, that the Opponent lost those oppositions was advantageous to the Applicant here as excerpts from those decisions were used in this case.

According to the Applicant, the question to ask is whether the



common element of the competing marks is so dominant as to render the different elements ineffective in eliminating the similarity between the marks.

On this issue, the Hearing Officer (“HO”) in Australia opined that, *inter alia*, the elongated P was not the portion of the trade mark “which will so overwhelm a person’s mind that they will not remember the word ‘Project’ or ‘Pirelli’ and confuse these two trade marks.”

A similar decision was delivered in the EU, where the marks were held to be visually similar to a very low degree and were not phonetically, or conceptually, similar.

Relying on the known “overall assessment test” and *Matratzen (Matratzen Concord GmbH v OHIM, Case T-6/01 [2002] ECR II-4335)*, the IPOS HO concurred and found that the marks in dispute are not visually,

aurally or conceptually similar. In particular, the HO held that, *in verbatim*, “the marks are visually similar in that they have one component, the elongated P, in common. However, this is not sufficient to make an overall finding of visual similarity as the application mark contains other components that are not of negligible significance”.

The Opponent’s argument for passing off failed due to insufficient evidence to prove goodwill in Singapore at the relevant time.

The business nuggets one could walk away with from this case are: when selecting a device for your trade mark, select one that is not common (letters are found to be common); and understand that decisions and arguments used in other jurisdictions (where the decisions are comprehensive and well-thought out) will be used to the applicant’s advantage.

Figure 1



Figure 2



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Ain't no thing like IP and bling!

Chris Hawkes reviews recent DRS decisions in the luxury goods industry

Luxury Austrian crystal brand Swarovski has had a recent spate of activity using Nominet's Dispute Resolution Service (DRS), with many summary applications granted in its favour. Domains have included swarovskilondonshop.co.uk, swarovskishop.co.uk, swaro.co.uk, sswarovskionline.co.uk, swarovskidiscountshop.co.uk and swarovski-uk-sale.co.uk.

Summary decisions are available if a respondent does not submit a response. After the relevant notification from Nominet, the complainant can apply for a summary decision within 10 days for only £200.

An appointed expert will only grant an application for a summary decision if three set criteria are satisfied:

1) it has communicated the complaint to the respondent correctly; 2) the complainant has shown that it has rights in a name or mark that is identical or similar to the domain name *and* the domain name is an abusive registration; and 3) no other factors apply that would make a summary decision unconscionable in all the circumstances.

If the expert grants the summary application, the domain name will be transferred to the complainant.

In respect of all of Swarovski's DRS cases, the experts involved were satisfied that the criteria applied. This shows how applications for summary decisions can be a cost-effective way to retrieve a portfolio of domain names from multiple

parties where it is likely or suspected that no response will be filed.

Class glass

With only one domain name at stake, albeit a key domain name, expensive "sporoptic" sunglasses brand Vuarnet (a concern named for French Olympic gold medal alpine ski racer Jean Vuarnet) has also recently employed the DRS service in relation to the domain name vuarnet.co.uk.

In summary, the DRS policy requires a complainant to show on the balance of probabilities that: it has rights in respect of a name or mark that is identical or similar to the domain name; and the domain name, in the hands of the respondent, is an abusive registration.

Vuarnet relied on its Community Trade Marks for VUARNET and its VUARNET logo mark, covering spectacles, glasses and sunglasses in class 9, and also its domain names vuarnet.com and vuarnet.net. The Expert acknowledged these rights in the decision, and found that the Complainant had the requisite rights in the name.

In this case, however, the Respondent filed a response,

which forced a full decision and brought into question whether its registration of the domain name was abusive.

Interestingly, it appears that the Respondent had previously entered into an agreement with the Complainant via the prior owner of the Vuarnet brand, which granted the Respondent exclusive distribution rights in the UK for successive renewed periods of one year, without formal notice to the contrary (as required by the agreement). The new owner of Vuarnet was apparently not aware that the agreement was in place at the time of filing the DRS complaint.

The Expert found that the domain name did not amount to an abusive registration given that there was an apparently valid agreement in place before the present owner's complaint, and there was no unfair advantage taken of or detriment to the Complainant's rights.

This decision shows the importance of carrying out due diligence checks to include IP and brand considerations when taking over any brand, and the importance of factoring domain names into the process.



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Questions of context

How, when and where were important to this lost appeal, explains Peter Vaughan

This is an appeal against a decision of the Hearing Officer (“HO”) rejecting joint oppositions against applications for CCB INTERNATIONAL and CCB INTERNATIONAL (plus device and Chinese characters) in the name of China Construction Bank Corporation. The Opponent (and Appellant) was Groupement des Cartes Bancaires and the opposition relied on earlier trade mark registrations for the marks CB and CB (stylised, shown below) under section 5(2)(b) and section 5(3) Trade Marks Act 1994.

The HO found that the word mark CB had not been used and that the device mark CB had been only used with respect to a few class 36 services. Therefore, there was no likelihood of confusion between the marks and nor was there acquired distinctiveness or reputation. These points were appealed.

The Appointed Person (“AP”) was critical of the lack of context in which the evidence of use of the word mark was placed. Without contextual evidence demonstrating how, when and to whom the press releases and annual reports had been issued, the evidence did not support use. Likewise, the website evidence was not in context, failing to show how often and where it was accessed, and whether it was available to the public. The Opponent suggested that in the absence of this contextual evidence, the HO should have used its general knowledge – in particular regarding who receives annual reports.

The device mark altered the character of the word mark and so had to be looked at in isolation

The AP reaffirmed that this is inappropriate, especially as in this case the annual report was issued by a French company and therefore it was further outside the HO’s general knowledge than would have been the case had it been a UK company. Even then it would only be appropriate for the most basic of general knowledge



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to be imported. Supporting background information should be included in a witness statement by someone with knowledge.

The AP also rejected the assertion that the device mark showed use of the word mark. The device mark altered the distinctive character of the word and therefore had to be looked at in isolation. Here, this meant that the mark had to be assessed without knowledge that the device was meant to be the letter combination CB. When the device mark was viewed in this somewhat artificial isolation it was not clear that it represented the letters CB. The device was independently distinctive and therefore use of the device could not support use of the word mark.

The Opponent also appealed the point that its earlier mark had a distinctive character and reputation outside the UK, and that this should have been considered. The AP agreed with the HO on the point of acquired distinctiveness, but accepted that the HO had been wrong to not consider the reputation of the mark in France.

However, reviewing section 5(3), the AP concluded that, as the mark only had a reputation outside the UK, it was difficult to support a finding of damage caused by use of a mark in the UK. The requisite link between the marks could not be established, and the 5(3) claim failed.

The appeal was therefore refused.



Elephant rules the room

Savan Bains takes issue with an outdated concept of goodwill

The Appointed Person (“AP”) recognised that there is only one elephant in the room as it paid homage to the GOLDEN ELEPHANT UK trade mark registration in the name of Hoo Hing Holdings Limited (“the Registered Proprietor”). This case is a second victory for the Registered Proprietor, whose unregistered UK rights in the GOLDEN ELEPHANT mark were confirmed in 2011, in a successful judgment from the Court of Justice of the European Union (CJEU).

Background

On 9 July 2014, the AP upheld the Hearing Officer’s decision to reject the invalidity application brought by Tresplain Investments Limited (“the Applicant”) under section 47(2)(b) based on section 5(4)(a) of the UK Trade Marks Act 1994, against UK registration number 2144319 for GOLDEN ELEPHANT (figurative) in class 30 (shown next page, left).

Proceedings in the UK were originally initiated by the Applicant on 3 December 2004, on the basis of sections 47(2)(a) and (b), relying on sections 5(2), 5(3) and 5(4)(a). However, following the Registered Proprietor’s successful invalidity action at the CJEU, against the Applicant’s Community Trade Mark (CTM) registration number 241810 GOLDEN ELEPHANT BRAND (figurative) (shown next page, right),

the registration was declared invalid. Consequently, section 47(2)(a) of the Applicant’s UK claim fell away, and along with it also sections 5(2) and 5(3). The Applicant’s claim was now solely based on the English law of passing off under section 5(4)(a), relying on its earlier unregistered rights in GOLDEN ELEPHANT BRAND (figurative) mark for rice.

Goodwill argument

The Applicant, which has a business in Hong Kong, argued that the Registered Proprietor was passing off its GOLDEN ELEPHANT mark in the UK as the Applicant’s own GOLDEN ELEPHANT BRAND mark, for rice. To establish passing off, the Applicant is required to show goodwill in the UK market. However, as we know from case law, establishing goodwill is a cumbersome task when the Applicant has no local presence or business in the UK. In this case, the AP followed the traditional approach, finding that for goodwill to be present in the UK a foreign entity must conduct business in that jurisdiction and have UK consumers.

This case brings into question whether the law of passing off needs to evolve further to recognise the changing concepts of goodwill and a UK consumer in today’s increasingly globalised and interconnected commercial world. Although foreign entities have a statutory right

available to them under Article 6b of the Paris Convention to protect their famous marks, it is of no benefit to them if they are not significantly well known. In comparison, the law of passing off is an extensive right that can be relied on by entities with varying degrees of fame, as long as they can establish goodwill in the UK. This is ultimately an obstacle for foreign entities, as they cannot demonstrate goodwill in the UK, having no UK consumers in the traditional sense of the test. The far-reaching nature of passing off is unnecessarily restricted and ring-fenced by the requirement of UK consumers in the UK territory for the establishment of goodwill and is therefore not evolving to adequately meet the current needs of the modern market.

The conceptual difficulty of defining and understanding goodwill is that it is largely immeasurable. UK courts have in the past substantiated goodwill by reference to sales, marketing and advertising in the jurisdiction in which goodwill is being claimed. But goodwill is not necessarily fixed to the place where a business is operating; it is more of a transferable element that consumers take with them because of habitual exposure to and consumption of the product. Consumers carry with them knowledge of the product, the company name and reputation, in



Account needs to be taken of the transferable nature of goodwill and its ability to move with consumers across borders

whatever territory they are in. The concept of goodwill should not be defined physically for, as this case highlights, although goodwill may initially be generated from consumers in Hong Kong, it can spread geographically to Chinese-speaking residents in the UK.

The transaction between the retailer and the consumer may therefore not need to be conducted on UK territory at all. The judgment of Justice Arnold in paragraph 216 of *Hotel Cipriani Srl and others v Cipriani (Grosvenor Street) Limited and others* [2009] EWHC 3032 (Ch) confirms that “it is sufficient for goodwill to exist in the

United Kingdom where the claimant has customers or ultimate consumers for his goods here”. In the *GOLDEN ELEPHANT* case, it can be assumed that many of the persons entering the UK from Hong Kong in the period 1980-1996 remained resident in the UK, so many of the Applicant’s “ultimate consumers of its goods” were in the UK. These consumers are therefore “the attractive force that brings in custom”, which is the all-important goodwill requirement to distinguish the Applicant’s goods from other goods on the market.

Unfortunately, however, the Applicant’s ability to expand into the UK market was frustrated by the Registered Proprietor’s introduction of rice under the similar brand of *GOLDEN ELEPHANT*. Due to the law of passing off being constrained to actual use and trade in the UK, the Applicant (the senior rights user) was precluded from registering its rights in the UK and ultimately prevented from stopping the Registered Proprietor (the junior rights user) who had both registered and unregistered rights in the UK.

Conclusion

The concept of a UK customer for establishing goodwill under the English law of passing off needs further clarification. Account needs to be taken of the transferable nature of goodwill and its ability to move with consumers across borders, especially in today’s international modern market. This case highlights that brand owners outside the UK who are not famous and are not using their rights in the UK, should register their trade marks to ensure they are protected against future users of similar marks.

Julius Stobbs, instructed by Stobbs IP, appeared for the Applicant.



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Skull marks butt heads

Eleni Mezulanik reviews a clear case of bad faith

On 30 March 2009, Alison Hendrick applied to register the skull device (shown below) and the word mark ARTJUNKIE in classes 24 and 25.

On 11 June 2009, Tony Knight, trading as Too Fast To Live Too Young To Die Apparel, applied to register a shutter glasses skull device (also shown below) in class 25. This application registered on 16 October 2009 under number 2518310.

These applications were the subject of the following actions.

Opposition No 99597 to Application No 2512392

Knight opposed Hendrick's skull device in class 25 under section 3(6) (bad faith), section 5(4)(a) (passing off) and section 5(4)(b) (copyright) of the Trade Marks Act 1994 ("TMA").

The Statement of Grounds provided no supporting details in connection with section 5(4)(b). Sections 3(6) and 5(4)(a) were supported by allegations in a witness statement that Hendrick's skull device was "virtually identical" to his skull device, which he claimed he had been using since 1994.

Hendrick filed a counterstatement, which asserted that: "the Opponent has taken her intellectual property and is passing off his wares as those of the Applicant".

Opposition No 99437 to Application No 2512470

Knight also objected to Hendrick's application for ARTJUNKIE in class 25 under section 5(4)(a) on the basis that SAINT ART JUNKIE was a fashion label established in 1994 by Knight, which established a reputation.

Knight made allegations that Hendrick had a reputation for stealing trade marks of other companies.

Hendrick filed a counterstatement identical to that filed in Opposition No 99597.

Application No 83630 for Invalidation of Registration No 2518310

Hendrick filed an invalidity action against Knight's registration under section 3(6), 5(4)(a) and 5(4)(b).

Under section 3(6), Hendrick asserted that Knight was aware of, and copied, her trade mark. Under section 5(4)(a), Hendrick submitted that goodwill and reputation had been established in her mark through use on the eBay auction site in the UK since 7 July 2008. Under section 5(4)(b), as the registration was created by Hendrick in June 2008, it was subject to copyright. Hendrick provided evidence of earlier use, including PayPal payments, eBay purchase details and screenshots from Wayback Machine.

Knight denied the allegations made, maintaining that he created the design in 2002. He did not submit evidence to support his claims.

Decision and appeal

The oppositions were dismissed and the invalidity action successful.

In terms of the oppositions, the Hearing Officer ("HO") held Hendrick created both skull devices. Also, Hendrick demonstrated that she had been using the mark Artjunkie since November 2004.

With regard to the invalidity action, it was held that Knight acted in bad

faith and the registration was made contrary to section 47(6) of the TMA. As Knight submitted fraudulent, incomplete and unreliable evidence, this was taken into consideration in relation to the award of costs.

Knight appealed to the Appointed Person ("AP") under section 76 of the TMA on the basis that the HO: "failed to carry out full and proper investigation into the evidence sent"; "made some slanderous comments"; and "had been influenced by statements made in judgments delivered by His Honour Judge Birss in proceedings which had been brought against him by Dame Vivienne Westwood OBE in the Patents County Court". The AP rejected Knight's assertions and upheld the HO's decision dismissing the appeal.

Comment

This is a clear case of bad faith, which confirms established case law based on the rights of the senior user and reinforces the inextricable link between section 3(6) and sections 5(4)(a) and 5(4)(b).

Hendrick's device



Knight's device



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Killer case closed

Personal perception was key to final decision, says Kirsty Morton

This was an appeal by Syngenta Limited (“Syngenta”) against the Hearing Officer’s (“HO”) rejection of Syngenta’s opposition to Sumitomo Chemical Company Limited’s (“Sumitomo”) application to register the mark FORGE for herbicides (class 5). Syngenta opposed on the basis of section 5(2)(b) of the Trade Marks Act 1994 and relied on its Community Trade Mark, FORCE, registered for insecticides (class 5).

Background

In rejecting the original opposition, the HO decided that, when considering the matter globally and taking the principle of interdependency into account, the goods (insecticides and herbicides) were not similar or complementary. Even when taking imperfect recollection into account, the difference between the marks and goods was such that there was no likelihood of confusion. The only evidence filed by Syngenta related to its own use.

Syngenta appealed, contending that there were two errors in the HO’s decision: the approach to assessing the similarity of the goods, and the incorrect application of the interdependency principle when deciding whether there was a likelihood of confusion.

Decision details

Similarity of goods

There was no suggestion that the HO misstated the relevant law for determining the similarity of goods. However, Syngenta criticised this assessment for two reasons.

First, Syngenta submitted that given the Hearing Officer had found

four of the six factors set out in *British Sugar plc v James Robertson & Sons Limited* [1996] RPC 28 to “match” this was sufficient to find a degree of similarity resulting in a likelihood of confusion. However, the Appointed Person (“AP”) highlighted in her decision that the list of British Sugar factors (respective users, respective uses, physical nature, respective trade channels, whether goods are found on the same supermarket shelf and whether goods are in competition) was not exhaustive, and the weight the factors should be given was dependent on perception. She acknowledged that there was room for more than one view when making such a decision but, in the absence of any evidence, the HO was entitled to make the findings he did.

Second, Syngenta argued that herbicides and insecticides share a purpose and are therefore similar or complementary. The AP disagreed. She explained that determining similarity between goods was a

matter of perception and, as such, to substantiate such a claim the proprietor must provide relevant evidence to demonstrate likely consumer confusion. As Syngenta had not done so, the HO was entitled to take the view he did.

Interdependency

The HO was also held to have correctly summarised the interdependency principle, namely that the purpose of assessing similarities and differences is to determine the net effect of the similarities and differences. In this case, the HO had not disregarded any material factors and had not taken immaterial factors into account. He had rightly concentrated on the impact of the dissimilarity of the goods (insecticides kill insects whereas herbicides eradicate weeds or plants), the degree of visual and aural similarity of the marks, and the dissimilarity in the conceptual meaning of the mark.

In light of this, the appeal was rejected.

Conclusion

This case serves as a reminder that in the absence of evidence to prove a likelihood of confusion, the HO is entitled to make findings based on its perception, and it may be difficult to overturn these findings on appeal.

Even when taking imperfect recollection into account, the difference between the marks and goods showed no confusion



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A total triumph

Emily Mallam covers a case that turned
on the issues of clarity and confusion

This is the latest instalment in a long-running battle between the parties regarding the use of the sign “youview” (“the Sign”). The High Court found that YouView’s use of the Sign on its television set-top boxes was an infringement of Total’s trade mark for YOUR VIEW (“the Mark”) and rejected YouView’s counterclaim for invalidity.

Background

Total provides bespoke telecommunications services with a focus on the provision of such

services to businesses, serving about 37,500 users. From September 2009, Total marketed and provided an online platform for its “Your View” service, which allows customers to manage spending on telecommunications and monitor and control the use of company mobile devices.

The Mark was registered in November 2009 in respect of: “Database programs and Databases” in class 9; “Provision of commercial business information by means of a computer database; computerised

database; management; compilation of information into a database” in class 35; and “Providing access to computer databases; telecommunications services” in class 38.

YouView is a joint venture between the BBC, ITV, BT, Channel 4, TalkTalk, Agriva and Channel 5. In May 2012, YouView launched a set-top box that allows reception of free-to-air digital radio and television broadcasts, incorporates a recording facility, and provides access to catch-up television services over the internet.

In 2010, YouView applied to register the “youview” mark in six different guises. Total successfully opposed the registration at the UK IPO, a decision that was upheld in the High Court by Justice Floyd in November 2012.

Despite its failure to register the “youview” mark, YouView continued to supply set-top boxes operating the “youview” service and licensed to be sold with “youview” brand markings on them. As a result, Total brought this action for infringement of the Mark and YouView counterclaimed that the Mark was invalid.

Validity

Relying on C-307/10, Chartered Institute of Patent Attorneys v Registrar of Trade Marks (IP Translator), YouView argued that the Mark should be found invalid due to lack of clarity and precision in its specification, particularly in relation to the specification of “databases” in classes 9 and 35 and “telecommunications services” in class 38.

Total submitted that it was clear to the *acte clair* standard that lack of clarity or precision in the goods or services for a trade mark is not a ground of invalidity once a trade mark is registered and can only be raised as a ground of objection to the registration of a trade mark. In rejecting Total’s submission, the Judge (Justice Sales) noted that it was not hard to imagine a case where a national registration authority allowed registration of a trade mark without hearing representations in opposition from a competitor or potential competitor – where the competitor may have been entirely unaware of the application or not aware of its eventual scope of activity. Such competitors should be able to challenge the mark later when threatened with infringement proceedings.

The Judge went on to say that there was an expectation that trade mark specifications would have some element of uncertainty because of the use of short words or formulations in the context of often complex fields and variable activities. In this case there was no unreasonable or unacceptable uncertainty in the

It was found that there was no lack of clarity or precision in the specification of the goods and services in relations to which the Mark was granted

concepts used for the purposes of defining the categories of goods and services covered by the Mark. Subsequently it was found that there was no lack of clarity or precision in the specification of the goods and services in relation to which the Mark was granted.

In finding that the Mark had distinctive character, the Judge said that, although the phrase “your view” is used in normal language to refer to a person’s opinion or particular visual perspective, the Mark is being used to describe an interactive and responsive telecommunications service of which the viewing of data is only one element. Therefore, in the context of the Mark, the phrase “your view” would be taken by consumers to refer distinctly to the provider of the service, not a description of the service and thus fulfils the requirement of being an indicator of origin.

Total’s final attack on the validity of the Mark was that it was registered in bad faith. The Judge rejected this, finding that Total applied for the Mark in relation to an entirely

legitimate business purpose, and not to obtain registration of a mark that could be used oppressively against YouView. The Judge found the specification of goods and services adopted by Total to be legitimate as at the time of the registration it would have foreseen the need to expand into related areas of activity in the future to remain competitive.

Infringement

The Judge found that the goods and services in relation to which the Sign is used are identical or similar to those for which the Mark is registered.

YouView submitted that it supplies goods in the form of set-top boxes, rather than any sort of service equivalent or similar to that which Total provides. The Judge rejected this argument and, referring to survey evidence, said that the set-top boxes were the vehicle for the provision of a “youview” service that was complementary to the supply of the relevant goods.

It was held that the dominant Mark and Sign were orally and conceptually similar.

In finding that there was a likelihood of confusion, the Judge was influenced by the convergence of the television and telecommunications markets, and evidence showing that the “youview” set-top boxes are often supplied together with telecommunications services offered by telecommunications companies in partnership with YouView.

Finally, the Judge considered that YouView’s use of the Sign adversely affected the essential function of the Mark since the average consumer was likely to be confused as to the origin of the goods and services being offered to it.

In conclusion, the Judge held that YouView’s activities infringed the Mark and dismissed its counterclaim for invalidity.



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Emily qualified as a solicitor in 2012 and also holds a master’s of engineering in materials science from the University of Oxford.

Turbulent flight for Orvec

Chris Hoole argues the case
for keeping terms clear

The Claimant, Orvec International (“Orvec”) trades in textile products, such as pillows and blankets, which it sells to airlines. The Defendant (“Linfoots”) is an advertising agency which, from 2002 until 2011, provided marketing services (advertising material, website and photographs) for Orvec. Linfoots’ services were carried out under its standard terms and conditions, which stated: “... 5. The use of the design is limited to the items in the estimate. 6. Copyright remains the property of the company unless otherwise assigned.”

From about 2006, under the Terms, Linfoots photographed Orvec’s products (“the Photographs”) as content for Orvec’s website. Some of the products photographed were made by Orvec, others were supplied to it by Intex Company Limited (“Intex”). In 2011, the parties went their separate ways.

In September 2012, Intex asked Linfoots to supply photographs for use in its hard copy and online advertisements. Orvec argued that some of these images included the Photographs, claiming breach of contract and passing off.

Breach of contract

Orvec argued that the Terms implied the grant of a perpetual and exclusive licence under copyright in the Photographs, and that, in supplying these to Intex, Linfoots acted in breach of Orvec’s exclusive rights.

Of the photographs that Orvec claimed had been used by Intex (none of which had been annexed to the particulars of claim), the Court held that it could only rely on three as Orvec had failed to raise the others

prior to the hearing. However, on hearing the evidence, the Court found that Orvec had only shown that one image came from the Photographs, namely the “BA Pillowcase”. Its breach of contract claim therefore rested on the use of this photograph.

In considering the test for inferring an implied term, Judge Hacon referred to the decision in *Refinery (Westernport) Proprietary Limited v Shire of Hastings (Victoria)* [1977] 180 CLR 266, 282-283, which set out a “collection of different ways” in which judges have tried to assess a contractual inference:

“(1) it must be reasonable and equitable; (2) it must be necessary to give business efficacy to the contract, so that no term will be implied if the contract is effective without it; (3) it must be so obvious that ‘it goes without saying’; (4) it must be capable of clear expression; (5) it must not contradict any express term of the contract.”

Judge Hacon added a sixth factor: “A usual characteristic of an implied term is that it is simple.”

Orvec argued that because some of the Photographs included its trade marks, livery and/or trade marks of its clients, Linfoots had no right to use the Photographs and so the licence must be exclusive. While Hacon stated that this might be implied with regard to the design of a logo, if the work

created is a photograph displaying a third party’s trade mark, he could see no reason for an implication that exclusive rights were granted to the Claimant. In applying his minimalist approach, this also meant implying no more than is sufficient, which meant a non-exclusive and perpetual licence in the Photographs. Linfoots was held not to be in breach of any licence that may be implied into the Terms.

Passing off

Orvec further claimed that Intex, by using the Photographs, deceived members of the trade, leading them to believe that the products originated from the Claimant. It argued that Linfoots caused and procured Intex’s acts of passing off.

The Court held that Orvec failed to evidence misrepresentation and that customers would see use of photographs simply as Intex setting out its stall of products. No false representation was found and Orvec’s case in passing off failed.

Conclusion

The need for unambiguous, express terms can never be underestimated and this case clearly illustrates that parties, particularly when dealing in commission agreements, must create a clear flight path of rights, pre and post contract, hopefully preventing a turbulent landing.



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Chris handles contentious and non-contentious IP matters.

Disclosure decision

Exemplary conduct paid off for the Defendant, explains Nina O'Sullivan

Article 8 of the Enforcement Directive (2004/48/EC) stipulates that national laws should provide for the possibility of disclosure relating to the origin and distribution networks of infringing products, including names and addresses and the quantities involved.

Article 8 has not been implemented in England and Wales (it has in Scotland) because of the pre-existing jurisdiction to make such an order pursuant to *Norwich Pharmacal Company and others v Customs & Excise Commissioner* [1974] AC 133. An order of disclosure under the Norwich Pharmacal regime is a matter for the Court's discretion and involves an assessment of the balance of irreparable harm, akin to that applied by the Court when considering an application for an interim injunction. In most cases where there has been a finding of infringement it is difficult to imagine circumstances where the Court would not order such disclosure. However, in *Wilko Retail Limited ("WRL") v Buyology Limited*, the Intellectual Property Enterprise Court (IPEC) refused such an order.

Background

WRL runs Wilkinson, a major UK retail business selling a range of consumer products. It brought infringement and passing off proceedings against Buyology, a smaller operation specialising in end-of-line and discontinued stock, in relation to the sale of WILKO-branded products. Buyology admitted that it had sold goods bearing the WILKO sign without consent and the IPEC entered judgment on admissions.

The sole issue before the IPEC was whether WRL was entitled to

an order that Buyology disclose the names and addresses of its suppliers. While WRL's letter before claim sought such disclosure, there was no reference to it in either the Particulars of Claim or the consent order disposing of the matter.

Discretion position

Having decided that the absence of such a provision in the consent order did not preclude WRL from seeking disclosure, the IPEC decided that it should exercise its discretion against ordering disclosure.

In particular, the IPEC was persuaded that given the small and close-knit nature of the retail industry and the risk that a disclosure order would lead to suppliers having a complete lack of trust in Buyology, its business might well suffer irreparable harm. HHJ Hacon did reflect on the counterargument, namely that a defendant who has sold infringing products "has only itself to blame", but decided that the worst that could be said about Buyology's conduct was

that it had not been as efficient as it might have been, once on notice, in ensuring that no Wilko products were sold without being de-branded. There was no suggestion it was aware that the goods were infringing (until put on notice by WRL), its defence had been "exemplary" in admitting the wrongdoing and it had readily accepted the terms of WRL's proposed order.

Comment

The decision can be compared with *Eli Lilly & Company Limited v Neopharma Limited* [2008] EWHC 415 (Ch), where, in patent infringement proceedings, the High Court decided the balance was in favour of an order of disclosure of customer records. Despite the Court noting that it should be more cautious in respect of information relating to customers as opposed to suppliers, the Court was persuaded that the Defendant's conduct in that case justified the making of an order. WRL will consider itself unfortunate that the IPEC exercised its discretion in the manner it did.



The IPEC decided that it should exercise its discretion against ordering disclosure



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An engaging Enterprise

The acceptance of survey evidence is reason to take interest, as Chris Morris reports

Justice Morgan begins his judgment: “This is another case about survey evidence in relation to a trade mark. In this case, the survey evidence relates to the distinctiveness of the Claimant’s marks... The survey evidence does not relate to the possibility of confusion between the Claimant’s marks and any sign or device used by the Defendants...”

So, while the main case centres on a trade mark infringement claim, the purpose of this hearing was to consider the application from Enterprise Holdings Inc (“Enterprise”) for permission to rely on survey evidence. The surveys sought to establish that Enterprise’s marks benefitted from enhanced distinctive character, the Defendants (“Europcar”) having not admitted the point.

Morgan J began by running through the law around distinctive character and, in particular, evidentiary requirements for a successful claim that a sign has acquired distinctive character through use. He then moved on to legal principles as to surveys, referring specifically to the OHIM guidelines confirming the suitability of surveys for assessing the “degree of knowledge” of a mark. He highlighted the fact that the Community Trade Mark Office must assess the probative value of a survey, but does not perform a gatekeeper role in advance, requiring a party to seek permission to conduct or submit a survey.

The Judge acknowledged that recent case law, in particular the *Interflora v Marks & Spencer* cases, had set a high hurdle for admissibility of survey evidence: per Lord Justice Lewison “only if the court is satisfied that the

evidence is likely to be of real value should permission be given... Even then the court must be satisfied that the value justifies the cost”.

Morgan J confirmed that the same test should apply when considering distinctiveness survey evidence as applies to evidence of confusion. However, he distinguished the potential outcomes of the “real value” test, with a judge possibly happier to determine the likelihood of confusion than whether a sign has acquired distinctiveness. Also, a confusion survey seeks to predict the likelihood of an event, while a distinctiveness survey has the more concrete aim of determining whether something has happened.

Having considered the validity of the surveys (sample size, demographics, coding of answers, etc), Morgan J addressed whether they were likely to be of real value.

Enterprise’s mark had primarily been used in conjunction with another mark, so, he said: “it is likely there will be difficulty in assessing whether [it] had acquired distinctive character.” On that basis, Morgan J found that surveys would be of value, including providing a guard against any decision being “idiosyncratic or not fully formed”. There is no need to assess whether a survey would be of value in addition to other, so far unseen, evidence.

This judgment will be welcomed by litigators as a loosening of the previous apparent near-embargo on surveys in trade mark proceedings

Moving on to consider whether value justifies cost, Morgan J confirmed the costs/benefit test must be for the purpose of saving money for the opposing party. In this case, Europcar had spent more defending this application than its estimated costs at trial if the survey was admitted. Those costs were, in turn, low when compared to total trial budgets. Permission was given.

Europcar intends to appeal but, if upheld, this judgment will be welcomed by litigators as a loosening of the previous apparent near-embargo on surveys in trade mark proceedings.



Chris Morris

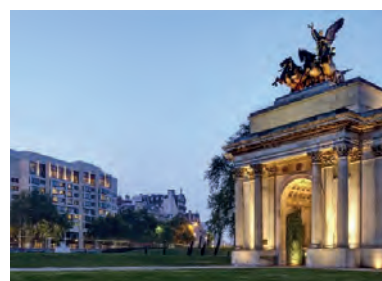
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Chris is a member of the firm’s IP team.

events

More details can be found at itma.org.uk

Date	Event	Location	CPD hours
28 October	ITMA London Evening Meeting* Update on law and practice in China, Jimmy Huang, Zhong Lun Law Firm	Royal College of Surgeons, London	1
29 October	Litigators' Refresher Course Chris Ryan, Nottingham Trent University, and Andrew Norris, Hogarth Chambers	Carpmaels & Ransford LLP, London	2-3
30 October	ITMA Autumn Drinks	Royal Over-Seas League, Edinburgh	
5 November	ITMA & CIPA Talk in Leeds Intellectual Property Act 2014 - an overview of the major changes, James Love, James Love Legal	Lupton Fawcett Denison Till, Leeds	1
18 November	ITMA London Evening Meeting* Speaker: Simon Miles Edwin Coe LLP	Royal College of Surgeons, London	1
20 November	ITMA Webinar The Interflora Appeal Decision, Iain Connor, Pinsent Masons		1
20 November	ITMA Talk in Glasgow Assignments, Tania Clark, Withers & Rogers LLP	Marks & Clerk LLP, Glasgow	1
5 December	ITMA Northern Christmas Lunch	Jamie's Italian, Manchester	
9 December	ITMA London Christmas Lunch**	InterContinental Park Lane, London	



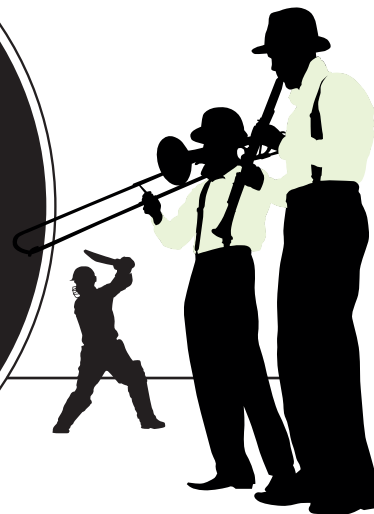
Our London Christmas Lunch at the InterContinental Park Lane is a highlight of the ITMA annual calendar

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I work as... a Consultant to Alexander Ramage Associates LLP.

Before this role... I spent 10 years as Secretary General of ECTA following my retirement from full-time professional practice. Before that, I was a Partner of D Young & Co for 18 years (Senior Partner in my last year).

My current state of mind is... contented and still most interested in IP, particularly trade mark law and practice, including geographical indications. I first joined ITMA's Law and Practice Committee in 1972, at the time of the Mathys Committee, and have been connected with it more or less ever since.

I became interested in IP when... the patent agent father of a friend gave a talk on the subject to our youth club in Claygate, Surrey. I subsequently joined his firm, against the advice of my father, who said it was a mistake to work for a friend, but I received a training second to none.

I am most inspired by... the brilliant people I have met and worked with. The ability of senior Counsel such as Geoffrey Hobbs QC, Michael Silverleaf QC and Roger Wyand QC to think on their feet in clients' interests was deeply impressive.

In my roles, I most enjoyed... the variety and interest of the work.



Well-travelled Honorary Member Keith Havelock takes his turn

I most disliked... once or twice having to terminate employments.

On my desk is... the usual keyboard and stuff, a lamp, a ruler, some INTA running trophies and copies of *Just Jazz* magazine and *ITMA Review*.

My favourite mug... bears the word "Dallas" in red on black, being a souvenir of an INTA Annual Meeting in that city. It's big!

My favourite place to visit on business is... Singapore – bring on the heat and the humidity. I also love New Orleans (where I could not believe my luck in having a client), which I revisit regularly.

If I were a trade mark or brand, I would be... Burberry or Pepsi – two of my favourite former clients.

The biggest challenge for IP is... to achieve harmonisation in spite of local and global complications.

The talent I wish I had is... to be more able in practical and DIY matters.

I can't live without... music, mainly jazz, sport and family.

My ideal day would include... nice weather, something interesting to do, friends and a bacon sandwich.

In my pocket is... an engagements diary, cash, cards and a clean white handkerchief.

The best piece of advice I've been given is... you get what you want in life, but not the way you wanted it.

When I want to relax I... go to a jazz event or cricket match.

In the next five years, I hope to... keep fit and give back what I can.

The best thing about being an ITMA member is... all the great people I have been able to work, socialise and become friends with, from all over the world.

If you'd like to appear in TM20, contact caitlin@thinkpublishing.co.uk

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We look forward to hearing from you.

Applications should be made via our website by 5pm, Friday 24 October 2014.