

ITMA REVIEW

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welcome

June 2014



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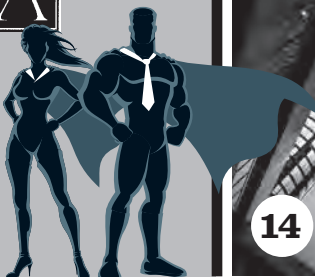
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ITMA Review

Review content is provided by members on a voluntary basis, and reader suggestions and contributions are welcome. If you would like to contribute an article to a future issue, please contact Tania Clark by email at tclark@withersrogers.com and Caitlin Mackesy Davies at caitlin@thinkpublishing.co.uk

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This is my first *ITMA Review* introduction. I am honoured to be the President of ITMA and am already enjoying the beginning of my two-year term. I follow in the footsteps of those who have paved the way and, in particular, Catherine Wolfe. I am fortunate to do so and hope to lead us on in an unflappable and stalwart manner.

Talking of ITMA officers, this issue contains the first in a new Q&A

feature, which this time stars Tania Clark, our new Second Vice President. We also look at plain packaging, .brand top-level domains and music trade marks.

I wish you happy reading and look forward to seeing you at our Summer Reception on 8 July.

Chris McLeod
ITMA President

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ITMA Insider



Meet the new ITMA officers

As many readers will know, the 28 April ITMA Council meeting saw several members take up new positions in the Institute's leadership.

While all of these members have been active in the Institute for many years, readers may enjoy knowing more about their experiences elsewhere, so we've prepared a brief introduction to each of them. Contact details are available at itma.org.uk/about/committee. Members are also invited to meet Chris McLeod at a New President's Welcome Reception on 4 June. For details, see itma.org.uk/events

04



President
Chris McLeod

Chris entered the profession in 1990 and is a Registered UK and European Trade Mark Attorney. He is Director of Trade Marks at Squire Sanders (UK) LLP. He is also a committee member of INTA and member of PTMG. Chris is listed in the 2011 edition of *The Legal 500 UK*, is a *World Trademark Review 1000* (WTR) 2012 Recommended Individual and is also recommended in *WTR 1000 2013*, which states that "benefiting from over 20 years in the field, the tried and tested Chris McLeod has 'earned a great reputation'".



First Vice President
Kate O'Rourke

An ITMA member since 1989, Kate is a Solicitor and Trade Mark Attorney with more than 20 years' experience in trade mark and related copyright, design and internet matters. She leads the trade mark registration and protection team at Charles Russell, and her work includes advising on the adoption, registration and enforcement of trade marks. Many of Kate's clients are in the leisure and retail industries, with interests across the globe. Kate is currently a member of the INTA Committee on non-traditional trade marks.



Second Vice President
Tania Clark

Tania, who is qualified as both a Barrister and a Trade Mark Attorney, began her legal career working in the IP departments of law firms and in-house for a subsidiary of Total. Tania has been a Trade Mark Attorney for the past 15 years and worked for two other major firms of Trade Mark and Patent Attorneys before joining Withers & Rogers LLP in 2006. Tania is a Trustee of the Hurlingham Club and is also the subject of our first TM20 questionnaire on page 42 of this issue.



Treasurer
Richard Goddard

Richard has been a Trade Mark Attorney at BP plc, where his work includes advising on the registration and enforcement of trade marks and designs, and the licensing of trade marks, since 2009. Richard joined the profession in 2003, working in private practice for several years before moving in-house. Richard chairs the ITMA Publications and Communications Committee, and has been involved in running ITMA's Trade Mark Administrators' Course for several years.



Firm first

Mathys & Squire's London office has celebrated its move to new premises, becoming the first law firm to take up residence in The Shard, 32 London Bridge Street, London SE1 9SG. The firm has a 15-year lease for the 15th floor. Email, telephone and facsimile details remain unchanged.



01



02

01) Nannette Quinn, Michelle Stack, Deirdre Naessens and Nicola Scott

02) Julia Greenaway, Joanna Wojcik and Linda Williams

03) Jennifer Ruth McCabe, Rebecca Jones, Sarah Richardson, Julie Potts

04) Donna Tefler and Barbara Blunt




03



04

Member moves



Venner Shipley LLP is pleased to announce the arrival of Birgit Clark, who joined the firm's London office as a Partner on 1 May 2014. Birgit can be contacted on bclark@vennershipley.co.uk

Thomas Hooper has joined Baker & McKenzie as a Junior Trade Marks Practitioner. Thomas can be contacted on thomas.hooper@bakermckenzie.com

ITMA held the first of its 2014 seminars for Administrators on 28 March at Edwards Wildman LLP. 'OHIM: Looking Forward' dealt with European Union (EU) trade mark reform, OHIM's website, seniority and classification, and the implications of a Member State leaving the EU.

The session was opened by Catherine Wolfe, who championed the role played by Administrators and stressed the importance of keeping abreast of changes, noting how ITMA intends to do its best to help with this process. Imogen Wiseman of Cleveland IP kicked off proceedings with an informative summary of the Max Planck review of the OHIM system. Notable points were the possible reduction in official fees, enforcement and OHIM's surplus.

Nicolas Vigneron was the next presenter to step up to the podium. He has worked at OHIM since its inception and is the project manager responsible

for the recent revamp of OHIM's website. He gave some very useful navigational tips and tricks, and the future looks bright with regard to these enhanced website features.

The second half of the seminar looked at seniority claims. Nick Bowie of Keltie LLP outlined the advantages and disadvantages of claiming seniority, formalities and the implications of IP TRANSLATOR on seniority claims and classification. Daniel Smart of Colman+Smart also gave useful theoretical insight into what could happen if a Member State were to leave the EU. His analysis of the possible implications of Scotland becoming an independent state was both topical and thought-provoking in a light-hearted way.

A drinks reception after the seminar offered a chance for speakers and the attendees to mingle and network. *Roy Scott, Senior Paralegal at Keltie LLP and Chair of the ITMA Seminar Working Group*

THE HOT

100

With the help of Corsearch, we delve into which firms have driven UK and Community Trade Mark filings this year

06

This year, we've isolated the highest-filing UK firms in terms of both UK trade marks and Community Trade Marks (CTMs), and are shining the spotlight on the 100 at the top.*

In total, 14,399 CTMs were filed by the firms concerned, with Marks & Clerk LLP firmly in the top spot. Despite a drop in filings from 2012, Marks & Clerk's 606 filings put it ahead of Harrison Goddard Foote (447). With the top 10 spots held by firms of specialist Patent and Trade Mark Attorneys, solicitors Baker & McKenzie also made its presence

felt at number 11, with a 72 per cent rise in filings compared to 2012 (158 to 272).

Of the corporate filers, three familiar names appear: Reckitt Benckiser Corporate Services Limited (140), Batmark Limited (119) and Diageo (104). All three increased their filings on 2012.

While the table is marked by some rapid rises – including Freeman Harris' 275 per cent growth over last year's filings – and several dramatic drops, the result is near equilibrium. With 52 of 100 firms posting an increase, the overall increase is just under 2 per cent.

UK trade marks

Nearly 11,500 marks were registered with the UK IPO during 2013 by the top 100 UK representatives. Again, Marks & Clerk LLP filed the lion's share, with 568. The runner-up is The Trademark Helpline, which accounted for 537. Only two corporates appear in the list: GlaxoSmithKline Services Unlimited and Batmark Limited.

*Figures represent those filers who are the current UK agents for CTMs or UK trade marks for which applications were made in 2013. Where a trade mark's ownership was transferred from one agent to another during the year, both the first representative and new one will be credited. Figures do not represent WIPO-designated filings.

TOP 100 UK FILERS

	TOTAL 2013		TOTAL 2013		TOTAL 2013			
1	Marks & Clerk LLP	568	44	Walker Morris LLP	96	=	Stephens Scoun LLP	46
2	The Trademark Helpline	537	45	Lewis Silkin LLP	89	84	Bristows LLP	45
3	Withers & Rogers LLP	461	46	Morgan Lloyd Administration Limited	86	=	Mei Leng Fong	45
4	Murgitroyd & Company	388	47	Carpmaels & Ransford LLP	85	86	Ancient Hume Limited	44
5	Urquhart-Dykes & Lord LLP	299	48	JA Kemp	84	=	Franks & Co Limited	44
6	Appleyard Lees	292	49	Bayer & Norton Business Consultant Limited	83	88	Dummett Copp LLP	43
7	Groom Wilkes & Wright LLP	280	50	Elkington and Fife LLP	82	89	Alyson Young	42
8	Harrison Goddard Foote LLP	268	51	Reddie & Grose LLP	78	=	Nabarro LLP	42
9	Barker Brettell LLP	266	52	Scott & York Intellectual Property	77	91	Bryers LLP	40
10	Wilson Gunn	262	53	Page White and Farrer	76	=	FRKelly	40
11	Boult Wade Tennant	253	54	Trademarkroom Limited	74	93	IP 21 Limited	39
12	Stobbs	239	55	Sanderson & Co	73	=	The Trademark Cafe Limited	39
13	Batmark Limited	187	56	Bond Dickinson LLP	69	=	Trade Mark Consultants Co	39
14	Novagraaf UK	163	=	Field Fisher Waterhouse LLP	69	96	James Love Legal	37
15	Forresters	159	=	Venner Shipley LLP	69	97	Brand Protect Limited	36
16	Dehns	151	59	Abel & Imray	68	=	Briffa & Co	36
17	Swindell & Pearson Limited	149	=	The Trade Marks Bureau	68	=	Sally Schupke	36
18	Taylor Wessing LLP	145	61	Chapman Molony	67	=	Sheridans Solicitors	36
19	Alexander Ramage Associates LLP	143	=	Eversheds LLP	67		TOTAL	11,459
20	Beck Greener	140	63	Baron Warren Redfern	65			
=	Mathys & Squire LLP	140	=	London IP Limited	65			
22	AA Thornton & Co	139	65	Addleshaw Goddard LLP	64			
=	Cleveland	139	66	Brabners LLP	63			
=	D Young & Co LLP	139	=	Potter Clarkson LLP	63			
25	GlaxoSmithKline Services Unlimited	138	68	RGC Jenkins & Co	60			
=	Silverman Sherliker LLP	138	=	Simmons & Simmons LLP	60			
27	Wildbore & Gibbons LLP	134	=	Williams Powell	60			
28	Bailey Walsh & Co LLP	129	71	Rouse & Co International LLP	56			
29	Nucleus IP Limited	128	72	Squire Sanders UK LLP	54			
30	Harrison IP Limited	127	73	Bates Wells Braithwaite London LLP	52			
=	Wynne-Jones Laine & James LLP	127	=	Foot Anstey	52			
32	Olswang LLP	123	75	NJ Akers & Co	50			
=	RevoMark	123	76	Marcaria.com Corp	49			
34	Baker & McKenzie LLP	121	77	Brookes Batchellor LLP	47			
=	Keltie LLP	121	=	Hogan Lovells International LLP	47			
36	Albright Patents LLP	120	79	Bird & Bird LLP	46			
37	WP Thompson	118	=	Coller IP Management Limited	46			
38	Kilburn & Strode LLP	107	=	Maguire Boss	46			
=	Saunders & Dolleymore LLP	107	=	National Business Register LLP	46			
40	Haseltine Lake LLP	106						
41	Gill Jennings & Every LLP	105						
42	Mewburn Ellis LLP	101						
43	Stevens Hewlett & Perkins	99						

Nearly 11,500 marks were registered with the UK IPO during 2013 by the top 100 UK representatives

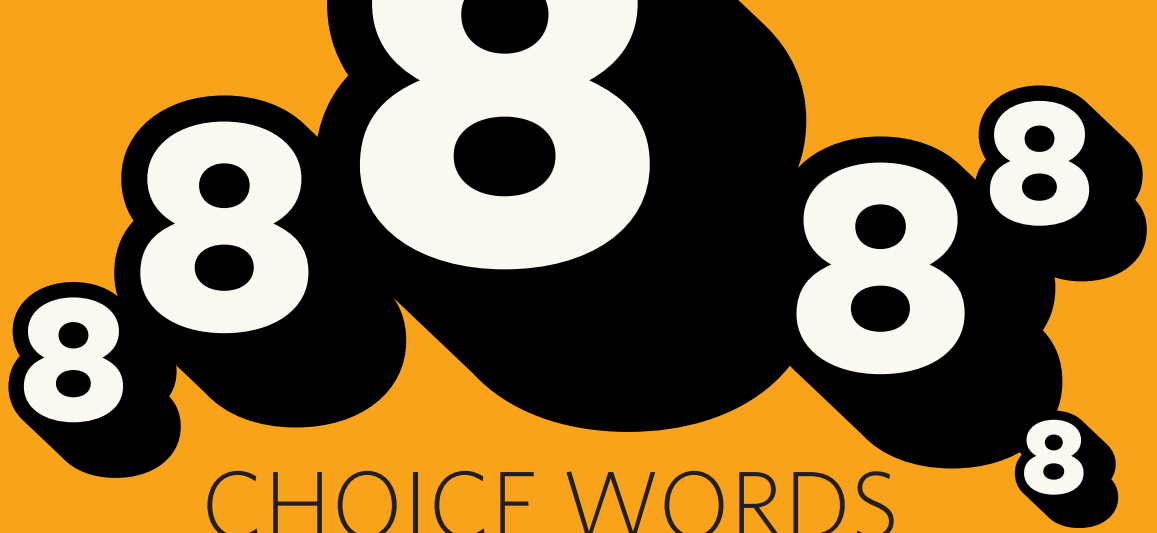
UK CTM FILING AGENT

	2012	2013	% change
➔ 1 Marks & Clerk LLP	732	606	-17
2 Harrison Goddard Foote LLP	453	447	-1.3
3 Withers & Rogers	332	371	11.7
4 D Young & Co LLP	405	361	-10.9
5 Kilburn & Strode LLP	347	336	-3.2
6 Boulton Wade Tennant	373	335	-10.2
7 Urquhart-Dykes & Lord LLP	225	321	42.7
8 Barker Brettell LLP	254	316	24.4
9 Jeffrey Parker & Co	278	295	6.1
10 Forresters	365	279	-23.6
11 Baker & McKenzie LLP	158	272	72.2
12 Field Fisher Waterhouse LLP	310	262	-15.5
13 Stobbs	328	260	-20.7
14 Dehns	252	257	2
15 RGC Jenkins & Co	242	256	5.8
16 Ladas & Parry LLP	174	249	43.1
= Murgitroyd & Co	255	249	-2.4
18 Cleveland	195	232	19
19 Gill Jennings & Every LLP	231	224	-3
20 Lane IP Limited	208	218	4.8
21 JA Kemp	189	216	14.3
22 Mewburn Ellis LLP	248	210	-15.3
23 Page White & Farrer	217	204	-6
24 Taylor Wessing LLP	216	194	-10.2
25 The Trademark Helpline	167	190	13.8
26 Edwards Wildman Palmer UK LLP	145	189	30.3
27 Olswang LLP	155	188	21.3
28 Freeman Harris Solicitors	49	184	275.5
29 Beck Greener	164	173	5.5
30 Keltie LLP	248	172	-30.6
31 Haseltine Lake LLP	175	167	-4.6
= Lewis Silkin LLP	169	167	-1.2
= WP Thompson	155	167	7.7
34 Wilson Gunn	189	155	-18
35 Groom Wilkes & Wright LLP	144	150	4.2
36 Rouse & Co International LLP	140	149	6.4

	2012	2013	% change
37 Trade Mark Direct	103	148	43.7
38 Mathys & Squire LLP	128	147	14.8
39 Appleyard Lees	148	144	-2.7
40 Albright Patents LLP	102	140	37.3
= Reckitt Benckiser Corporate Services Limited	110	140	27.3
42 Saunders & Dolleymore LLP	95	130	36.8
43 Reddie & Grose LLP	140	129	-7.9
= Venner Shipley LLP	109	129	18.3
45 Batmark Limited	81	119	46.9
46 AA Thornton & Co	140	117	-16.4
47 Wildbore & Gibbons LLP	145	114	-21.4
48 Simmons & Simmons LLP	188	111	-41
49 Stevens Hewlett & Perkins	141	110	-22
50 Wynne-Jones, Laine & James LLP	105	105	0
51 Diageo plc	78	104	33.3
52 Silverman Sherliker LLP	118	100	-15.3
= Swindell & Pearson Limited	83	100	20.5
54 Briffa & Co	70	98	40
55 Alexander Ramage Associates LLP	116	97	-16.4
56 Hansel Henson LLP	43	96	123.3
= King & Wood Mallesons LLP	68	96	41.2
58 Rapisardi Intellectual Property Limited	86	93	8.1
59 Harrison Goddard Foote LLP Incorporating Grant Spencer	84	91	8.3
60 Carpmals & Ransford LLP	95	90	-5.3
61 Harrison IP Limited	71	89	25.4
62 Fox Williams LLP	43	86	100
= Potter Clarkson LLP	173	86	-50.3
64 Bristows LLP	66	85	28.8
65 Charles Russell LLP	34	83	144.1

	2012	2013	% change
66 Berwin Leighton Paisner LLP	96	82	-14.6
= Eversheds LLP	80	82	2.5
68 Bailey Walsh & Co	81	81	0
= SNDRE & SNDRE	54	81	50
70 MW Trade Marks Ltd	41	80	95.1
71 Nabarro LLP	59	79	33.9
72 McDermott Will & Emery UK LLP	45	74	64.4
73 Arnold & Porter UK LLP	58	73	25.9
= Walker Morris LLP	55	73	32.7
75 Clarke Willmott	49	72	46.9
76 Sheridans Solicitors	95	71	-25.3
= Trademarkroom Ltd	65	71	9.2
78 Elkington & Fife LLP	88	70	-20.5
79 Abel & Imray	93	69	-25.8
= Sanderson & Co	73	69	-5.5
= Squire Sanders UK LLP	103	69	-33
82 Avidity IP Limited	62	68	9.7
83 Phillips & Leigh	83	66	-20.5
= Oakleigh IP Services Limited	81	66	-18.5
85 Bird & Bird LLP	134	62	-53.7
= Novagraaf UK	77	62	-19.5
87 Scott & York Intellectual Property	64	61	-4.7
88 Bond Dickinson LLP	52	57	9.6
= Sipara Limited	66	57	-13.6
90 Bridle Intellectual Property Limited	24	55	129.2
91 Nucleus IP Limited	51	54	5.9
92 Berry Davis LLP	56	51	-8.9
93 Graham Watt & Co LLP	53	50	-5.7
= London Voson Intellectual Property Service Limited	60	50	-16.7
= Williams Powell	72	50	-30.6
96 Joshi & Welch Ltd	83	49	-41
= RevoMark	55	49	-10.9
= Chapman Molony	50	49	-2
= Ashfords	36	49	36.1
100 Mishcon de Reya	46	47	2.2
TOTAL	14,144	14,399	1.8

Please note: individual entities have been removed



CHOICE WORDS ON CHINA

Chris Hoole summarises the key points from a Leeds talk on the country's trade mark changes



ur attorney picked bamboo stick number eight. Eight is higher than five, so we won the trade mark.”

This light-

hearted example of the Chinese trade mark registry's approach to deciding ownership of a trade mark application if two identical trade marks are filed on the same day served to begin the 3 March presentation of Tingxi Huo, of Chinese IP firm Chofn, to ITMA members assembled in Leeds. He went on to explain that, if neither party can show prior use and negotiations collapse, the registry will resort to a bamboo cup with 10 numbered bamboo sticks. The highest number wins.

Despite the obscurity of this decision-making process, it was clear to all of those who heard this talk that the People's Republic of China is taking a serious approach to IP rights, starting with a revision of its trade mark law.

The new PRC Trademark Law came into force on 1 May 2014. Tingxi Huo highlighted the following key changes:

1) Statutory fines for trade mark infringement increased from three to five times the turnover, or a maximum of RMB250,000 (previously RMB100,000), where the infringement has resulted in a turnover of less than RMB50,000. Repeat infringers also face increased fines.

2) Claimants are able to seek a wider range of damages recovery, including not only actual loss or an account of profits, but also a royalty fee and an increased fine for bad-faith use. Where the turnover is uncertain, damages increase from RMB500,000 to a maximum of RMB3 million.

3) Previously, anyone could oppose a trade mark application in China on any grounds. After 1 May, only relevant parties (ie prior rights holders) are able to oppose on relative grounds. However, there will be no limitation for opposition based on absolute grounds.

4) Applicants for national Chinese trade mark filings are able to designate multiple classes.

The speaker also provided the audience with tips for registration and use of trade marks in China:

- Most Chinese courts and enforcement officers do not recognise international registrations issued in English. If applying for an international trade mark in China, he therefore suggests applying for a translation certificate.
- To prevent an infringing Chinese version of an English trade mark, apply for the Chinese translation and transliteration.

- It is common in China for well-known brands to be abbreviated by Chinese speakers. He advises registering the abbreviated nickname even if it is not considered a desirable name.
- Production of a product in China bearing the ® symbol (whether or not it is sold in China) is a fineable offence if the trade mark is not registered in China.
- Translate all labelling and catalogues into Chinese. Failure to do so may result in a fine of up to 30 per cent of turnover.

The final subject was an outline of the Chinese enforcement authorities. As well as the police, Customs and court, the State Administration for Industry and Commerce (SAIC) presents a “strong governmental organ”. The SAIC employs 500,000 people and is empowered to issue orders to cease infringement, destroy goods, issue State fines and refer cases for criminal prosecution. While a claimant cannot recover damages via the SAIC, proceedings are often resolved in just one month. Proof of the SAIC's popularity is the fact that more than 120,000 trade mark cases were referred to it in 2012, compared to just 20,000 cases pursued in the courts.



Chris Hoole

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Chris handles contentious and non-contentious IP matters.

MAKING IT PLAIN

ANNA CARBONI SUCCINCTLY EXPLAINS WHY THE
INTRODUCTION OF PLAIN PACKAGING IN THE UK COULD
MARK THE START OF ROCKY TRADE MARK TERRAIN

The UK Government has been considering the introduction of plain packaging for tobacco products for several years. Following a consultation in 2012, the current Government decided against its introduction, but it appears to be back on the agenda. This article considers whether the introduction of plain packaging, be it for cigarettes or sweets, alcohol or fast food, would be compatible with the unitary character of the Community Trade Mark (CTM). The context of this discussion is framed by three recent developments:

Children and Families Act 2014

On 13 March 2014, the Children and Families Act (the “Act”) received royal assent. Part 5 of the Act, entitled “Welfare of children”, contains a provision that enables the Secretary of State for Health to make regulations “if [he] considers that [they] may contribute at any time to reducing the risk of harm to, or promoting, the health or welfare of people under the age of 18”. The Act envisages regulations being made in relation to both the retail packaging of tobacco products and the products themselves (under sub-sections 94(6) to (8)), which may impose prohibitions, requirements or limitations relating to “the use of branding, trademarks or logos” and “any other features ... which could be used to distinguish between different brands of tobacco products”. Such restrictions are, of course, the antithesis of the primary purpose of trade marks, which is to indicate the economic source of the products.

Revised Tobacco Products Directive

On 14 March 2014, the European Council adopted the revised EU Tobacco Products Directive (TPD), following its approval by the European Parliament on 26 February 2014. The TPD is expected to enter into force in May, following which Member States will have two years to transpose it

into national law. The TPD does not mandate the adoption of plain packaging, but Article 24 expressly permits Member States to introduce further measures to standardise the packaging of tobacco products, subject to the measures being: (i) justified on public health grounds; (ii) proportionate and not a disguised means of restricting the free movement of goods; and (iii) notified to the European Commission.

Chantler Review

On 3 April 2014, Sir Cyril Chantler published the results of his independent review into the public health impact of plain packaging, commissioned by the Department of Health. He has concluded that “there is enough evidence to say that standardised packaging is very likely to contribute to a modest but important reduction in smoking”, and the Public Health Minister has said that she is “minded to proceed”.

Unitary nature of the CTM

Article 1(2) of Council Regulation (EC) 207/2009 on the CTM (“CTMR”) states: “a Community trade mark shall have a unitary character. It shall have equal effect throughout the Community: it shall not be registered, transferred or surrendered, or be the subject of a decision revoking the rights of the

proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole Community...” This principle is also set out in Recital (3) to the CTMR and reinforced by Article 7(2), which provides that, where absolute grounds for refusal of a CTM apply in only part of the Community, the application must be refused, and Article 16(1), which provides that a CTM is an object of property that shall only be dealt with for the whole of the Community.

As stated by the Court of Justice of the European Union (CJEU) in C-149/11 *Leno Merken v Hagelkruis Beheer*, a key objective of the CTMR is to enable the proprietor of a CTM “to distinguish his goods and services by identical means throughout the entire Community, regardless of frontiers”. (The current Proposal for a Regulation amending the CTMR retains this objective and the unitary character provisions.)

The unitary principle has been tested in the case law in four key areas:

- 1) **Genuine use:** In C-149/11 *Leno Merken v Hagelkruis Beheer*, a question arose as to whether genuine use in one Member State was sufficient to demonstrate genuine use in the Community under Article 15(1) of the CTMR. Although the CJEU did not rule out the possibility that use in one Member State could be enough, →

The erosion of the unitary character of the Community Trade Mark is potentially damaging to the development of European trade mark law, in a way that is not restricted to tobacco trade marks

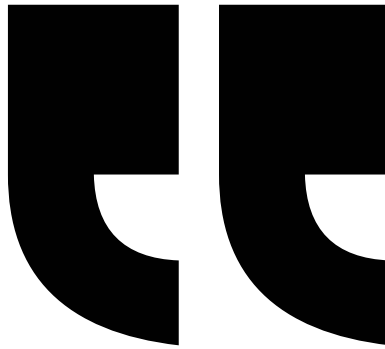
➔ it held that the starting point for assessing use should be that territorial borders of Member States are irrelevant. The CJEU considered that, if particular significance were afforded to the boundaries of Member States, the unitary nature of the CTM would be diminished.

2) **Acquired distinctiveness:**

In T-91/99 Ford Motor Company v OHIM, it was held that Articles 7(2) and (3) CTMR must be read in the light of the principle of unitary character. This means that, if a sign is inherently non-distinctive in any substantial part of the Community, acquired distinctiveness must be demonstrated in that part before it can be registered as a CTM.

3) **Reputation:** In C-301/07 PAGO v Tirolmilch, it was held that a CTM must have a reputation in a substantial part of the territory of the Community to benefit from Article 9(1)(c) protection. In the circumstances of that case, the territory of Austria was considered sufficient to meet the test. In the earlier case of Whirlpool v Kenwood [2008] EWHC 1930 (Ch), it was held that reputation in a single Member State was sufficient for the purposes of Article 9(1)(c), on the more general basis that a CTM should not receive less protection than a national trade mark with a reputation in the same territory (in that case, the UK).

4) **Injunctions:** In C-235/09 DHL Express France v Chronopost, the CJEU held that the unitary character of the CTM necessitates that any injunction to restrain infringement should, as a matter of principle, extend to the entire area of the Community. The CJEU acknowledged that it might be appropriate to restrict the scope of an injunction in certain circumstances, such as where the essential function of the CTM is not affected in parts of the



Community, but the burden appears to be on the defendants to demonstrate this: in *Interflora v Marks and Spencer* [2013] EWHC 1484 (Ch), Justice Arnold ruled that a pan-EU injunction should be granted in the absence of evidence from the defendants to show that the grounds of infringement did not exist outside the UK.

These examples all reflect the principle of unitary character and show how the EU is to be regarded as a single unit for the purposes of the acquisition, maintenance and enforcement of CTMs.

Potential impact

Article 1(2) of the CTMR expressly prohibits Member States derogating from the principle of the unitary character of the CTM “unless otherwise provided for in this

If the UK were to introduce plain packaging without resolving the conflict with the CTMR, any such measures may, in theory, be subject to an action for non-compliance by the European Commission pursuant to Article 258 of the TFEU

Regulation”. The introduction of plain packaging by the UK Government would be an example of exactly such a derogation by imposing a prohibition on use that is not provided for in the CTMR and that would be contrary to the overall objectives of the CTMR discussed above.



Source: ‘Tobacco plain packaging: your guide’, Australian Government Department of Health and Ageing

If the UK were to introduce plain packaging without resolving the conflict with the CTMR, any such measures may, in theory, be subject to an action for non-compliance by the European Commission pursuant to Article 258 of the Treaty on the Functioning of the European Union. The Commission may undertake such action of its own volition or as a result of a complaint from an aggrieved party. Such action might seem incompatible with the Commission's involvement in the TPD, which permits standardised tobacco packaging to be introduced at a national level, but there are other concerns about the consequences of national plain packaging that should also be considered.

Intention to use and non-use

Section 32(3) of the Trade Marks Act 1994 ("TMA") is a home-grown (ie non-harmonised) provision that requires applicants for UK trade marks to make a declaration that they intend to use the mark. It is hard to see how a tobacco company could make that declaration for any elements of branding apart from the mere name of the company or product, thus taking away the choice that most brand owners have between using the national and the Community systems for protection.

As far as CTMs are concerned, there have been a couple of cases in which it has been argued that, if use of a CTM is prohibited in part of the Community, then registration of the mark should be denied or cancelled on the basis that it was made in bad faith or was contrary to public policy and accepted principles of public morality. These approaches reflect the unitary nature of the CTM but they have not yet been successful (R-255/2006-1 Johnson Pump v Johnson Pump and T-140/02 Sportwetten v OHIM). It is nevertheless possible that CTMs affected by the restrictions on packaging could be challenged on this basis.

Existing UK trade marks would, under section 46(1) of the TMA, become vulnerable to revocation for non-use after five years unless there

are proper reasons for such non-use. The Australian Government negated the non-use problem for tobacco marks by designating plain packaging as a proper reason for non-use, but the tobacco company is required to rebut any action for revocation for non-use by demonstrating that, but for the restriction, it would have used the mark. Although an equivalent provision could be introduced into the TMA, it is likely to become increasingly difficult to rebut a revocation action as time goes by and the tobacco products market changes (for example, through the introduction of lower-risk products such as e-cigarettes). In summary, it would no longer be possible to obtain new national UK registrations and it would become increasingly difficult to maintain existing ones.

Where tobacco companies have mainly UK rights, they may consider that the best way to maintain their protection would be to file CTMs (for which no declaration as to use is required) and claim seniority from their existing UK trade marks. The tobacco companies would, of course, have to use their CTMs outside the UK to maintain their registrations.

Equivalence principle

CTMs coexist with national trade marks (which have been harmonised); proprietors are able to choose the degree of protection most suitable for their business interests (Leno Marken v Hagelkruis Beheer, at para 40).

As stated above, the protection offered by CTMs and UK national trade marks is, through the process of harmonisation, meant to be broadly equivalent save in relation to the geographical extent of the monopoly granted. As can be seen from the foregoing, if plain packaging were to be introduced, it would still be possible to obtain and maintain a CTM registration, albeit subject to attack as being contrary to UK law, whereas it would no longer be possible to obtain or maintain a UK national mark.

Erosion effect

The introduction of plain packaging legislation in the UK has recently been enabled at both the European and domestic level. However, both sets of enabling legislation focus on the potential health benefits of plain packaging without apparent consideration for any unintended consequences for European trade mark law in particular. The erosion of the unitary character of the CTM is potentially damaging to the development of European trade mark law, in a way that is not restricted to tobacco trade marks. It also cuts across the harmonisation agenda and, more broadly, the free movement of goods within the EU.

Note: Redd has been advising Philip Morris on the implications of plain packaging. However, the opinions expressed here are the authors' own.



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The right stuff

As powerful brands 'change sides' in new TLDs, Sarah Walker looks at how the dot-brand debate is developing

There is already talk of the potential for new TLDs in the future, and, provided phase one is a success, additional companies may be interested in purchasing .brands in phase two

With the passing of ICANN's deadline to apply for new top-level domain (TLD) names for

brands – TLDs that put the brand name to the right of the dot – it seems that companies fell into one of two camps:

- 1) those that did not think that .brands (“dot brands”) would take off and did not want to incur the expense of applying for their own TLDs; or
- 2) those that considered the investment worthwhile and applied for TLDs for their brands.

Those solely advising companies that fell into camp one may be out of the loop with what is currently going on with these TLDs, and the background section in the next column will provide a quick heads-up on what has happened since the end of the ICANN phase one application process for TLDs.

Even if you are not currently involved in advising companies with

.brand TLDs, this update may be useful as there is already talk of the potential for new TLDs in the future, and, provided phase one is a success, additional companies may be interested in purchasing .brands in phase two.

Background on .brands

It became apparent that, while many global companies wanted to own .brands, the Registry Agreement that has to be signed by all TLD applicants and Registry Operators had points that did not really work for companies operating a closed Registry for their own brands.

While it may seem obvious that closed Registries should not be subject to all the same restrictions and provisions as an open Registry (ie sunrise periods, compulsory re-delegation of the Registry itself on termination of the agreement, having to use various Registrars without discrimination), it has taken a good deal of lobbying for this to be officially recognised, even in part.

This lobbying has been done by many .brand-owning companies to gain the same recognition for .brands as was accorded to geographical TLDs – that is, being considered a separate category of new TLDs and so not subject to all of the same criteria as the generic TLDs (gTLDs). This was necessary as, to be exempt from certain points in the Registry Agreement that do not work for .brand Registries, .brands needed to be recognised as a new sub-category of TLDs.

The Brand Registry Group (BRG) in particular has been very active in lobbying for recognition of .brands as a separate category of TLD, with certain exemptions and differences in the Registry Agreement. The BRG is comprised of representatives of many multinational companies, including HSBC, Yahoo!, Amazon, Richemont, KPMG, Microsoft, Gucci, BBC, Sky, BBVA, Ferrero, Virgin and Reckitt Benckiser. The group also has independent legal advisers.

The most crucial changes for which the BRG has been lobbying include:

- 1) A specific .brand definition allowing TLDs that qualify under this definition to be exempt from or subject to slightly different criteria in certain

circumstances than generic TLDs (Specification 13).

- 2) Permission to use countries as domain names on the .brand TLDs (for example: spain.brand, germany.brand, de.brand, uk.brand) without the need to seek special permission from each country.

The second point has not yet been resolved and the BRG, and possibly other smaller groups, intend to keep lobbying for this. However, agreement and action on the first point is now almost finalised following the recent ICANN meeting in Singapore (although there are still certain changes for which the BRG will continue to lobby, including allowing .brands to use one Registrar exclusively for their TLDs).

Specification 13

From the perspective of .brands, the recent ICANN meeting in Singapore was a milestone because Specification 13 was adopted.

There are various specifications attached to the Registry Agreement, the last of these – Specification 13 – is called “.brand TLD provisions” and essentially sets out the definition of a .brand TLD. It also clarifies from which restrictions a Registry Operator that meets this definition, and so qualifies as a .brand TLD, can be exempt in the Registry Agreement.

To summarise, to qualify as a .brand, the TLD string must be identical to a registered trade mark that is recorded with the Trade Mark Clearing House (TMCH) and has been issued with a Signed Mark Data file. That registered trade mark:

- must be owned by and used by the Registry Operator or its affiliate in connection with the goods or services covered by the trade mark;
- must have been issued to the Registry Operator or its affiliate prior to the filing of the TLD Registry application;
- must be used throughout the term of the Registry Agreement continuously in the ordinary course of business (unrelated to the provisions of the services of the TLD Registry) in connection with the goods or services covered by the trade mark;
- must not begin with a period (full stop) or a dot; and



The adoption of Specification 13 in the Registry Agreement may mean that more .brands are now prepared to sign the Registry Agreement

- ➔ • must not be a generic-string TLD. The Registry Operator must also provide ICANN with an accurate and complete copy of the trade mark registration registered with the TMCH. Further, only Registry Operators, affiliates and licensees can register domain names using this TLD string.

Differences defined

So what are the differences in the Registry Agreement for the .brand TLDs?

- For as long as a TLD meets the definition .brand TLD it:
- Will not be required to provide a sunrise period.
 - Will be exempt from complying with the code of conduct (Specification 9 in the Registry Agreement). The code of conduct imposes obligations on the Registry Operator not to, and not to allow, any related entities to register domain names in its own right, with certain exceptions. As closed Registries will need to register domain names in their own right, .brands will now be exempt from this.
 - Will not have to be subject to ICANN re-delegating the .brand Registry to a third party for two years following the termination of the Registry Agreement, provided ICANN does not determine that it is in the public interest to do so (as for other Registries, ICANN can re-delegate the Registry on termination). Even if ICANN determines this, there is a provision in Specification 13 that sets out that ICANN must provide detailed explanation of this determination and that the Registry Operator can dispute this if it does not agree.

To ensure that .brand TLDs continue to meet the definition, internal reviews will have to be completed once per calendar year and the results provided to ICANN. ICANN can then publicly post the results of these reviews, subject to exceptions for confidential information (which the Registry Operator may mark as such).

As mentioned above, the Registrar point is yet to be finalised and is still subject to some possible discussion by and with the Generic Names Supporting Organization (GNSO), which is responsible for developing and amending policies relating to TLDs. ICANN wanted .brands to agree to allow any ICANN-accredited Registrar to access its systems; .brands wanted to control their TLDs by allowing only one exclusive selected Registrar(s) for the TLD. Most Registry Operators for .brands felt that a specific exemption to section 2.9(a) of the Registry Agreement (through which Registry Operators agree to provide non-discriminatory access to all ICANN-accredited Registrars) is required, as many closed Registries will only want to use one exclusive Registrar (and possibly to have the option of a second).

This last point was hotly debated in the build-up to the ICANN meeting in Singapore because many .brand Registry Operators have strong views on it, as it affects a security-related aspect of their operations. Recognising that the original policy recommendations do not suit .brands, ICANN gave the GNSO 45 days to comment on the BRG's proposal to limit Registrar access, after which it would decide whether to finally accept the BRG's proposal.

If at any time ICANN determines that the TLD no longer qualifies as a .brand, it will provide the Registry Operator with written notice of its

determination and the Registry Operator will have 30 days to either:

- meet the requirement of the .brand TLD definition so that it is still considered a .brand Registry; or
- initiate dispute-resolution proceedings. While such proceedings are pending, there will be no change in the status of the TLD so long as the Registry Operator continues to operate in accordance with Specification 13, other than in relation to the disputed issue.

Worth watching

The adoption of Specification 13 in the Registry Agreement may mean that more .brands (those Registry Operators that applied for a TLD for their brand in phase one) are now prepared to sign the Registry Agreement – indications are that most have held back awaiting it.

A very few .brands have pressed ahead and signed the Agreement hoping that Specification 13 would apply to them if accepted. As I understand it, some have done this in the expectation that they would gain an earlier place in the queue of new Registries waiting to launch. And although an earlier launch is not a certainty – there are various other steps that also determine a launch date – certainly delayed signing by some .brands will mean that they are further back in the queue.

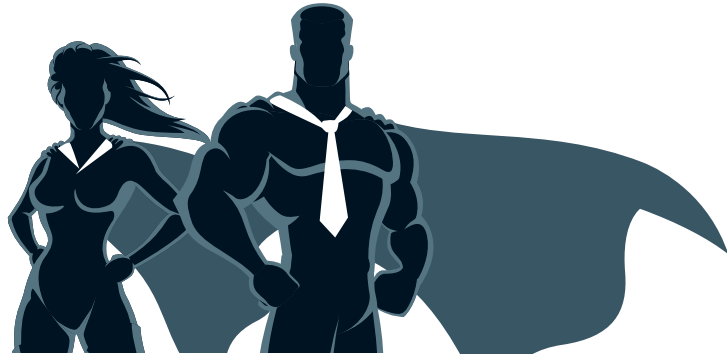
If these Registries are successful when they begin to launch, Specification 13 will be important to other brands thinking of applying for .brand TLDs in phase two. Meanwhile, groups including the BRG are moving forward with discussions on topics such as setting standards for naming structures and conventions for these new .brand TLDs. So, for major brands and their representatives, it is definitely a situation to watch with interest.



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DYNAMIC DUO

At a Birmingham event, Laura Mackenzie learned how marks and designs work together



At a recent ITMA Talk in Birmingham, newly appointed QC Charlotte May (8 New Square) provided an insightful analysis of registered designs and their relationship with trade marks.

Our understanding of the scope of registered designs (according to the Design Directive and Community Design Regulation) has been shaped by case law, which has sought to clarify how we assess key concepts such as design freedom (*Apple v Samsung* [2012] EWCA Civ 1339), the informed user (*Sealed Air Limited v Sharp Interpack Limited* [2013] EWPC 23) and, most recently, the overall impression produced by the designs in question (*Magmatic Limited v PMS International Limited* [2014] EWCA Civ 181). In consequence of these decisions, the registered design monopoly has been carefully curtailed.

May addressed the question, therefore, of whether trade marks – which offer potentially unlimited duration of protection with an arguably broader monopoly – help in seeking to protect a shape.

As we know, there exist numerous challenges to registration of a shape mark; for example, in demonstrating distinctive character (a stumbling block for many shape marks because consumers do not tend to view a shape as effectively communicating the identity of the provider), and Article 3(e) of the Trade Marks Directive and Article 7(e) of the Community Trade

Marks Regulation – under which the Court of Justice of the European Union has sent a clear message that courts should be reluctant to allow registered trade marks or designs for what are functional designs. Such designs should be protected by the limited monopoly of patents.

The question of whether a shape mark is exclusively functional involves an assessment with strong underlying policy considerations. We therefore await guidance in response to the questions referred by the High Court in *Nestlé v Cadbury* [2014] EWHC 16 (Ch) as to:

- 1) whether an association of mark with application is sufficient to demonstrate distinctive character or whether the applicant must prove its mark indicates origin of goods;
- 2) whether a mark can be refused because different essential features fall within Article 3(e) of the Trade Marks Directive; and
- 3) whether a technical result is assessed by reference to the way in which goods are manufactured or the way they work.

This should further clarify our clients' ability to use shape marks in future.

So, in practice, it can be difficult to use trade marks to “plug the gap” in a client's registered design portfolio,

as – to a large extent – the problems with the narrowing scope of registered designs are the same challenges ultimately faced when registering trade marks.

Finally, May left us with a reminder that, should a shape mark achieve registration, a registered trade mark may be used to invalidate a registered design. Article 11 of the Designs Directive and Article 25 of the Community Designs Registration enable trade mark owners to use a mark to knock out a design if:

- 1) a registered design fails to be new or have individual character by reference to an earlier trade mark; or
- 2) a trade mark is used in (and hence conflicts with) a subsequent design.

An example of how this strategy has been used successfully arose in the *Su Shan Chen Case* (T-55/12), in which a trade mark holder invalidated a registered design by showing a likelihood of confusion with its earlier mark. However, it is worth bearing in mind that this approach may not be successful when applied to mere logos, as opposed to 3-D shapes (see *Beifer Group Case*, T-148/08).

Ultimately, the interrelationship between registered designs and trade marks is still developing. It will be interesting to see where it takes us.



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FOR THOSE
ABOUT TO

ROCK!

EMERGING ARTISTS MAY PREFER TO FOCUS MORE ON MAKING MUSIC THAN ON IP ISSUES, BUT THIS CAN LEAD TO NASTY DISPUTES AND SOUR NOTES DOWN THE LINE, AS ALASTAIR RAWLENCE WARNS

**Source: For Those About To Rock (We Salute You), AC/DC, Angus Young, Malcolm Young, Brian Johnson*

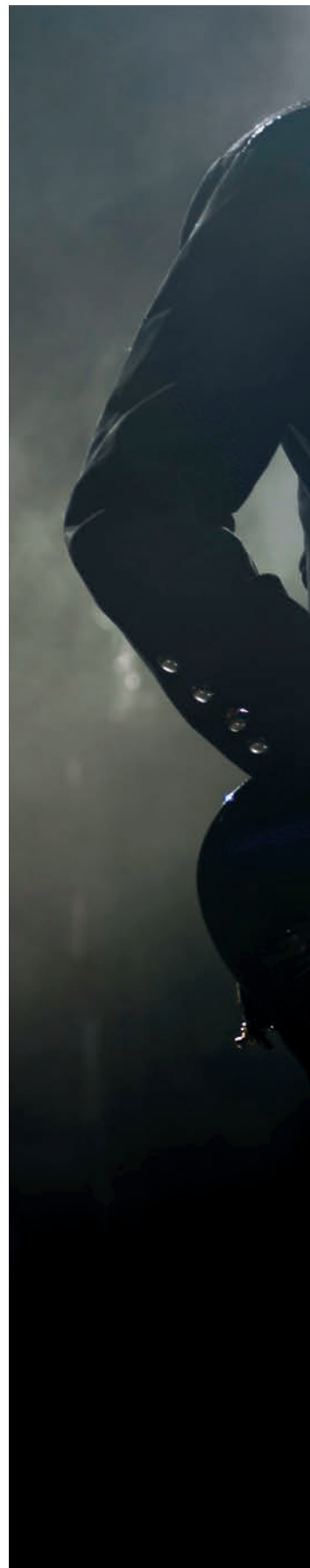
Most bands are like couples planning to get married; they don't want to think about what might go wrong in the future and tend not to regard prenuptial agreements as very romantic. But, of course, like couples, bands do break up, members change and arguments arise, many of these driven by disputes over money.

Over the years, musicians have become more astute about the importance of establishing a band partnership agreement that addresses potentially contentious issues, such as input into business, creativity and performing decisions, equipment acquisition (and ownership), and each members' share of income from performance and royalty payments. However, one issue that frequently still gets overlooked is the question of who owns the band's name. The

history of rock and roll is littered with acrimonious, costly and often embarrassing disputes between former friends and bandmates over the right to use the name of their disbanded musical group.

The value of a good name

Although a band's name may not seem very important to the musicians at the time of a group's creation, it is one of its most valuable assets, particularly when it comes to merchandising. A rock group's promotional activity was once limited to the odd concert T-shirt; these days, many artists have expanded their licensing and endorsement activities into more exotic sectors – from perfume (Britney Spears), make-up (Lady Gaga) and fake eyelashes (Girls Aloud), to condoms (JLS), dolls (One Direction), deodorants (Spice Girls), vodka (Puff Daddy), suntan lotions (Pussycat Dolls) and even butter (John Lydon, Public Image Ltd/Sex Pistols).





Although a band's name may not seem very important to the musicians at the time of a group's creation, it is one of its most valuable assets, particularly when it comes to merchandising

➔ With such potentially high revenues at stake, taking legal advice when choosing and protecting a band name is crucial for every group. Ideally, it should be taken care of before a band becomes popular and big money becomes involved.

Who should own the name?

Just because, say, the guitarist came up with the group's name, it doesn't or shouldn't mean that it belongs to him or her. A band's partnership agreement should clearly address the question of ownership, and what happens if the group splits or changes members. This could specify, for example, that one or all of the band members or even someone (or some entity) outside the band owns the name.

As part of this process, and as with any brand, it is also advisable for bands to undertake a trade mark search to check that no one else is already using the chosen name. Otherwise, they may be forced to change their name at the last minute, as with US band Blink, which changed its name to Blink 182 after receiving a challenge from an Irish band of the same name; Polar Bears, which became Snow Patrol following a threat by Jane's Addiction's former bassist, who was fronting a band of the same name; and The Dust Brothers, which became Chemical Brothers to avoid a conflict with US producers of the same name.

Trade mark registrations in appropriate territories and classes will then shore up the band's right to use its chosen name moving forward. With the range of merchandising activities now so varied, these should extend beyond the obvious goods in classes 9 (video/sound recordings) and 41 (entertainment services) to cover additional products and services. Once registered, the partnership agreement should also set out rules surrounding the ownership and use of those marks, and oblige the parties to relinquish and assign their rights

to use the mark under specific circumstances; for example, in the event of the departure or sacking of a band member.

After the fact

But, what happens if a band hasn't set up a band partnership agreement or addressed within it the question of trade mark or band name ownership?

In the absence of such an agreement and/or registration, the law will consider the original members of the band (who joined at the same time) to be partners, with equal rights to share the profits and



With such potentially high revenues at stake, taking legal advice when choosing and protecting a band name is crucial for every group

assets of the partnership. In other words, all band members will be deemed to have an equal share of the band's name, irrespective of which member actually created it and which member is the face of the band or its main creative force. Unsurprisingly, this often leads to litigation after a band splits and one or more of the members seek to continue using the band's name. High-profile examples, include:

- The legal action by founding member and *The Dark Side of the Moon* lyricist (among other works) Roger Waters to dissolve the Pink Floyd partnership after leaving the group, and to block the group from continuing without him. The case was eventually settled out of court, enabling the other band members to continue performing under the name Pink Floyd. As part of the agreement, Waters reportedly also retained the copyright to the concept behind *The Wall* and his trade-marked inflatable pig.
- The attempt by former (and founding) Sugababes member Mutya Buena to register the band's name as a Community Trade Mark (CTM) in 2009. After lengthy opposition proceedings by the Sugababes partnership and the band's record label, OHIM granted a registration in Buena's favour – but only in respect of "Paper, cardboard and goods made from these materials, not included in other classes; stationery; paper gift wrap and paper gift wrapping ribbons", which is probably not what Buena had initially hoped for.
- The disputes between members of The Beach Boys following the band's split in the late 1980s and, in particular, the infringement action mounted against guitarist Alan Charles "Al" Jardine by his former bandmates after he began touring under different variations of the band's name. Singer-songwriter Mike Love had negotiated a deal with the band's corporate entity, Brother Records Inc, which guaranteed him the rights to the name as the sole licensee. He paired up with the Carl Wilson estate to sue Jardine for \$2.2 million in legal fees.

Bands are advised to draft a partnership agreement that clearly states who owns the associated trade mark rights, and what will happen should they split

Solo move

Sometimes, one band member will decide to register the group's name as a trade mark without involving the others. This was the case with Black Sabbath guitarist Tony Iommi, who obtained registrations in the UK, European Union and US, leading to a lawsuit between him and Ozzy Osbourne in 2009. The parties eventually reached an agreement and all three registrations have now been assigned jointly to Iommi and Osbourne.

A similar dispute arose over the rights to the Frankie Goes To Hollywood name, after frontman Holly Johnson tried to register the iconic name as a UK and CTM right without informing or gaining permission from the other band members following the group's split. His former band members subsequently opposed the application, arguing it was made in bad faith and that they had unregistered rights to the mark acquired through use. Although Johnson had come up with the band's name, his attempt to register the mark was successfully prevented as the UK IPO and OHIM upheld the

opposition, agreeing that the name was owned equally by all original band members and that no one band member had the right to claim exclusivity to that name.

It may seem unfair, but the long-running battle over the rights to the Bucks Fizz band name also shows what can happen to a group member's rights after leaving a band. A trade mark for this group was registered in the name of Heidi Manton, a member of the current line-up using the band's name, and attempts to revoke that registration by the original members have proved unsuccessful. In addition, their application for a trade mark for "The Original Bucks Fizz" was also rejected by the UK IPO, which stated that the original band members had given up any rights to the trade mark after leaving the group.

Bitter, and often silly

These examples illustrate how bitter, and sometimes silly, disputes over the rights to use a band name can become. As with any business or industry, the founding partners may eventually disagree or simply decide to move on or look to enter new ventures. For that reason, bands are advised to draft a partnership agreement that clearly states who owns the associated trade mark rights, and what will happen to them should they eventually decide to go their separate ways.

Much like a prenuptial agreement, the idea is to help make the break-up process as painless as possible, so it should ideally include provisions that address possible scenarios following that split. For example, it could assign the right to use the band name and/or trade mark to the majority of the group members, so that they can continue to perform together. Alternatively, it could assign it to the lead singer only, regardless of who he or she is performing with, or the sole songwriter, or to the record label itself. In certain cases, the band may decide that no one should be allowed to use the name should the group break up. The agreement should also define what "leaving" a band actually means and, if relevant, how many of the original members of the band need to remain to retain use of the band name.

Protecting the band's name in this way isn't just a means of avoiding costly, long-winded and embarrassing disputes between band members, it's also a method of protecting and growing the value of the band name as an asset. Taking the necessary steps at the start – clearing the name, registering it and clarifying ownership – is crucial if a group is to ensure the use of the name without risk of infringement or arguments between band members. Most importantly, it leaves the band free to do what it really wants to do: create music.



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SENSE OF SECURITY

Timothy Creek offers a detailed explanation of Australia's PPSA

22

On 30 January 2012, the Personal Property Securities Act 2009 (Cth) – the PPSA – came into effect. The PPSA changed the law relating to the creation, registration and enforcement of security interests in personal property in Australia, creating one regime applying to all personal property. It created a searchable online register (the PPSA Register) to record security interests. Priority between competing interests in the same personal property is now determined on the basis of that register.

Defining terms

“Security interest” means an interest in personal property provided for by a transaction (including the assignment of personal property) that, in substance, secures payment or performance of an obligation.¹ Personal property includes certain registered and unregistered IP rights such as

rights held by the registered owner of registered trade marks and IP licences.²

The PPSA therefore applies to security interests in registered trade marks, but does not, subject to an exception mentioned below, apply to trade mark applications.³ This is so notwithstanding that the Trade Marks Act 1995 (Cth) (“Trade Marks Act”) treats trade mark applications as a form of personal property capable of assignment⁴, and that, in practice, trade mark applications are commonly assigned. Consequently, the priority and enforcement rules set out in the PPSA will not typically apply to security interests in trade mark applications.

Relevant registers

The Trade Marks Act permits interests in registered trade marks to be recorded on the Trade Marks Register.⁵ Before the PPSA commenced, the Trade Marks Act provided that owners of registered trade marks may deal with those marks subject only to any rights appearing on the Trade Marks Register.⁶ So, owners could not deal with their

registered marks without reference to recorded interests. However, third parties acquiring interests in registered marks would only take those interests free of interests already recorded on the Trade Marks Register if they purchased those interests for value in good faith without notice of any fraud on the part of the owner.⁷ Parties’ rights in a registered trade mark were therefore largely determined by the Trade Marks Register.

Consequential amendments to the Trade Marks Act following the enactment of the PPSA have limited the operation of the Trade Marks Act in respect of recorded interests. Although the two registers operate concurrently, the PPSA Register is now the primary means for determining competing priorities between registered and unregistered security interests in the same personal property. Now, if a security interest is recorded on the Trade Marks Register but is not registered on the PPSA Register, the trade mark owner is free to deal with the trade mark as

Although the PPSA is in its infancy, trade mark owners have already started to adopt practical approaches to its use in transactions

absolute owner without reference to the security interests recorded on the Trade Marks Register.⁸ The PPSA Register is therefore the only relevant register from a prospective interest holder's perspective in terms of security interests in trade marks, as it is the only register that will determine whether a security interest is enforceable and whether that interest is subordinate to other interests. The Trade Marks Register continues to be relevant in respect of all other recordable interests in registered trade marks that are not security interests.

Registration of security interests on the PPSA Register is voluntary. In practice, however, security interests will invariably be registered on it; failing to do so may adversely impact the security interest holder's ability to enforce that interest, for example, by losing that interest if the trade mark owner becomes insolvent.

Transactions

Although the PPSA is in its infancy, trade mark owners and interest holders have already started to adopt practical approaches to its use in transactions involving trade marks. Below are some practical matters trade mark owners and interest holders might consider.

Recording interests

Under the PPSA, the registration of security interests in trade marks on the PPSA Register must describe the trade marks by serial number.⁹ Property described by serial number can only be registered for seven years (compared to registrations that last indefinitely). Such registrations can, however, be renewed upon expiration of this term. Interest holders should therefore ensure that renewal dates are added to deadline databases so they do not lose the right to effectively enforce their interest.

Security interests

Security interests in trade mark applications cannot be recorded on the PPSA Register. Interest holders may nevertheless wish to acquire a security

interest in trade marks at the application stage on the basis that valuable assets will be created upon registration. Such interests may be recorded where the security agreement creating the interest is expressed to include any registrations granted on such applications. In this case, the security interest will be granted in the application and "after-acquired property", creating a registrable security interest under the PPSA.

Assignments and assignments-back

Under the PPSA, a trade mark assignment is a transaction that may provide for registrable security interests. Parties to that transaction can create security interests in the assigned trade marks to secure payment or the performance of an obligation. Assignment agreements may provide for the assignment-back or reversion of the assigned trade mark to the assignor in certain circumstances. To ensure the assignor's interest in the assigned trade mark is protected, the assignor may acquire and register a security interest in the assigned trade mark. Doing so would prevent the assignee from dealing with the trade mark contrary to the assignor's interest.

Licence agreements

Under the PPSA, transactions involving the licensing of trade marks may also provide for registrable security

interests. Trade mark licence agreements often include an obligation on the owner not to assign the trade mark during the licence term. To secure performance of that obligation so that the licensor cannot deal with the trade mark contrary to the licensee's interest, a licensee may take a security interest in the trade mark.

Watching services

Security interest holders can register security interests on the PPSA Register without a trade mark owner's consent. A person registering a security interest must, however, not make an application unless that person believes that the security interest is, or will be, held by the named secured party.¹⁰ Although penalties apply if security interests are registered in breach of this rule, such a contravention does not invalidate the registration.¹¹ Trade mark owners may wish to establish a watching service of the PPSA Register to ensure that no security interests have been fraudulently registered in respect of their trade marks.

Impact

It is early days, yet it is clear that the PPSA will have a legal and practical impact on trade mark asset transactions. Although the PPSA commenced more than two years ago, there have only been a few reported decisions on the operations of the new regime. None of those decisions have required a court to consider the application of the PPSA to security interests in IP rights. As a result, the effect of the key concepts is still to be tested. Trade mark owners and interest holders should ensure that transactions involving trade marks that create security interests are properly recorded on the PPSA Register.

1) Section 12 of the Personal Property Securities Act 2009 (Cth) (PPSA).

2) Section 10 of the PPSA.

3) Curiously, however, the Personal Property Securities Regulations 2010 (Cth) (the Regulations) provides for registrations of security interests in trade marks to be described by reference to a trade mark application

number (see Schedule 1, Part 2, paragraph 2.2(3)).

4) Sub-section 106(1) of the Trade Marks Act 1995 (Cth) (TMA).

5) Part 11 of the TMA. Before the PPSA commenced, an application to record an interest in a registered trade mark must have been made by the security interest holder jointly with the trade mark

owner. That requirement has, since the PPSA commenced, now been removed.

6) Sub-section 22(1) of the TMA.

7) Sub-section 22(2) of the TMA.

8) Sub-section 22A of the TMA.

9) Section 153 of the PPSA; Schedule 1, Part 2 of the Regulations.

10) Sub-section 151(1) of the PPSA.

11) Sub-section 151(6) of the PPSA.



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THE STATE OF SALARIES

Recruitment firm Fellows and Associates has once again taken the temperature of compensation in the IP profession. Here's a selection of its latest insights

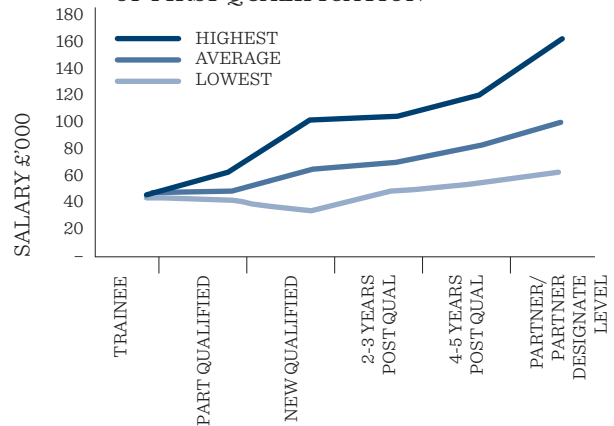
SALARY TRENDS

2014 has only seen inflationary increases for certain levels of qualification and experience similar to those in 2013. The lack of newly qualified attorneys coming through has begun to turn around, with more movement leading to higher salaries at this level. Similarly, the increase for those qualified in 2010 relates to those with three to four years' post-qualification experience.

AVERAGE SALARY BY YEAR OF FIRST QUALIFICATION



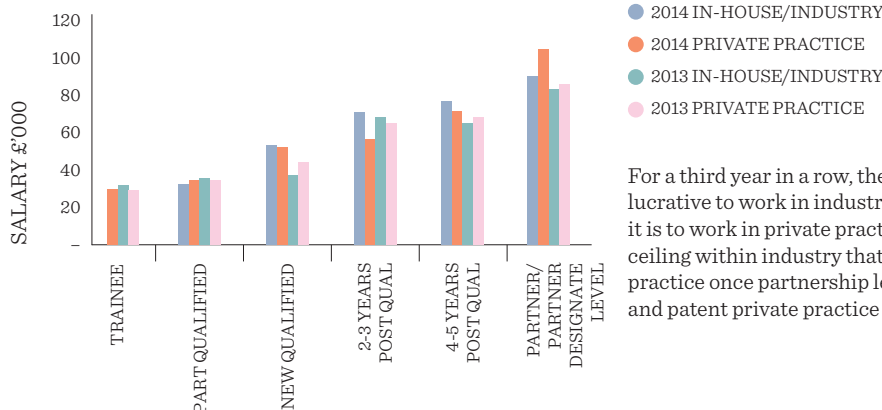
UK SALARY RANGE BY YEAR OF FIRST QUALIFICATION



When considering range by year of qualification, variances documented are likely to be down to the type of qualification held and the respondent's technical specialism. Those specialising in telecommunications/software and

chemistry/pharmaceuticals were among those earning the highest salary across the spectrum, while those that specified trade marks/copyrights/design lagged most other sectors among those fully qualified.

AVERAGE SALARY BY EMPLOYMENT TYPE



For a third year in a row, the data indicates that it is more lucrative to work in industry once qualified for a few years than it is to work in private practice. However, there is an earnings ceiling within industry that does not exist within private practice once partnership level is attained, when trade mark and patent private practice offers the highest average salary.

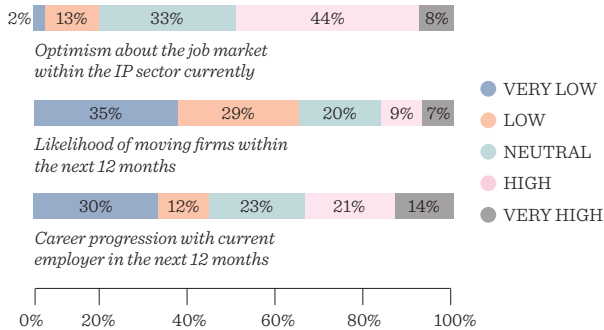
MARKET VALUE

Fellows used the data and its experience to produce a “market value” (average earnings, excluding bonuses) based on certain technical backgrounds.

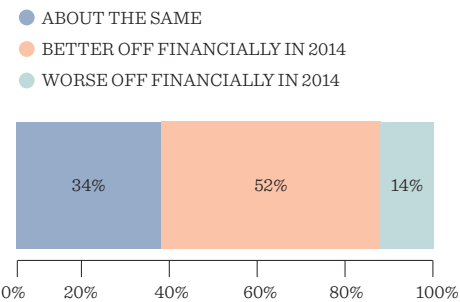
GBP £'000	TRAINEE	PART QUALIFIED	NEW QUALIFIED	2-3 YEARS POST QUAL	4-5 YEARS POST QUAL	SALARIED PARTNER LEVEL
CHEMISTRY/PHARMACEUTICALS	29-30	34-38	53-60	58-66	75-85	80-110
ELECTRONICS/PHYSICS	27-30	35-40	63-67	65-75	85-95	95-125
MECHANICAL ENGINEERING	29-30	34-38	60-65	64-72	75-90	80-110
TELECOMMUNICATIONS/SOFTWARE	28-30	38-43	64-68	70-80	80-95	100-130
BIOTECHNOLOGY	28-30	34-38	57-62	59-64	75-85	85-120
TRADE MARKS/COPYRIGHTS/DESIGN	25-30	33-37	52-60	55-62	65-80	70-100

OUTLOOK

OPTIMISM REGARDING CAREER



FINANCIAL STABILITY IN THE COMING YEAR



EXPERIENCE AND EDUCATION

Respondents were an experienced group, with 40 per cent at Partner/Partner Designate Level. Those with 2-5 years' qualification made up 30 per cent.

They are also well qualified: 20 per cent hold a single qualification; 68 per cent hold two; 11 per cent hold three and

1 per cent four. Thirty-six per cent of respondents hold a PhD.

The survey ranked the most commonly attended universities, with Oxford and Cambridge Universities ranked at first and second (shared with the University of Bristol), respectively. Interestingly,

there was no direct correlation found between average salary and attendance at Oxford or Cambridge University. The report found that, for new entrants to the field, “it appears to be far less of a differentiator than it might have been historically”.

PARTICIPANT PROFILE

85% INDICATED DAILY INVOLVEMENT IN PROSECUTION, 50% IN DRAFTING, WITH STRATEGY AND MANAGEMENT FOLLOWING AT 31%.

Data was collected between 3 December 2013 and 28 February 2014 through an online survey. For the complete report, go to fellowsandassociates.com

SURVEY STATS

236 RESPONDENTS

88% UK-BASED

64% OF RESPONDENTS ARE IN PRIVATE PRACTICE (TRADE MARK OR PATENT)

11% ARE IN PRIVATE PRACTICE AT A LAW FIRM

25% WORK IN-HOUSE/INDUSTRY

70% OF RESPONDENTS WERE MALE

Consumers were left with the overall impression that the products displayed originated from the brand owner displayed on the page

Lush life

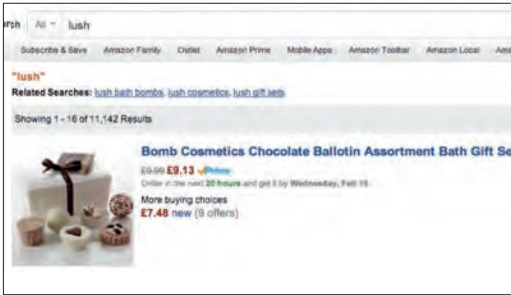
Fragrant cosmetics brand smells sweet success in keyword infringement battle with Amazon, reports Robert Cumming

Just as a tree grows and blossoms with age, so too do principles of law. That is clearly apparent from the latest High Court judgment in this case, in which the Lush cosmetics and toiletries brand sought to prevent the use of LUSH in online advertisements by the retailer Amazon.

Up until 2010, the only oasis of guidance in a barren legal landscape on the use of keywords was the

English Court of Appeal's 2004 judgment in *Reed v Reed*.¹ That case established that consumers were aware that online search results had "much rubbish thrown in" and that, unless there was evidence of direct confusion, it would be difficult for a claimant to succeed. Now, four years after the first shoots appeared in the Court of Justice's decision in *LVMH v Google France*,² we have a rich thicket of European jurisprudence, which

1) [2004] RPC 40
2) Joined cases C-236/08 to C-238/08
3) Case C-323/09
4) Case C-2/00
5) Case C-206/01
6) Case C-17/06
7) Case C-533/06



provides a solid framework for assessing liability. Every case is unique to its facts but the principles have now taken deep root.

The English High Court’s judgment in *Lush v Amazon* is the latest to consider the circumstances in which the use of a third party’s trade mark is justified and when, on the contrary, it will infringe. It is based heavily on the guidance given by the Court of Justice of the European Union in *Google France, L’Oréal v eBay and Interflora*,³ but also considers “auto-complete” functions and the use of consumers’ search terms within a retailer’s website.

Lush is the owner of certain trade mark registrations for the sign LUSH in respect of cosmetics and toiletries, such as Community Trade Mark number 1388313. Crucially, it does not sell its products through Amazon’s retail platform because it saw a difference between its standards of environmental and ethical concerns and those which it attributes to Amazon. However, winning the battle for the moral high ground is much more challenging, given Lush’s application to register as a trade mark the name of Amazon’s Managing Director, a move the Court described as “bizarre”.

Lush’s claim

Lush complained that the world’s largest online retailer damaged the origin function, the advertisement function and the investment function of its marks when it:

- i) purchased the keyword LUSH so that third-party search engine results pages (such as those on Google) would display advertisements that used the word LUSH in relation to cosmetics;
- ii) purchased the keyword LUSH so that third-party search engine results pages would display generic advertisements in relation to cosmetics; and
- iii) used the word LUSH in results pages generated by Amazon’s search engine embedded in its website (see above).

In the European Union, the test for infringement under Article 5(1)(a) of Directive 2008/95/EC and the interpreting case law requires:

- i) use in the course of trade;
- ii) of an identical sign;
- iii) in the relevant territory;
- iv) in relation to identical

goods or services for which the mark is registered;

v) without the consent of the proprietor; and

vi) the use must be liable to have an effect on one of the functions of the trade mark.

(See *Holterhoff v Freiesleben*,⁴ *Arsenal v Reed*,⁵ *Celine*,⁶ *O2 v Hutchison 3G*.⁷)

The Court also noted the requirement laid down in Article 6 of Directive 2000/31 (the E-Commerce Directive) that the identity of the person making an electronic commercial communication must be made clear.

It is against this backdrop that the Court considered whether Amazon’s advertisements would: “enable reasonably well-informed and reasonably observant internet users, or enables them only with difficulty to ascertain whether the goods or services referred to by the advertisement originate from [Lush]... or on the contrary, originate from [an unconnected] third party.”

In short, if consumers were able to appreciate that Amazon’s advertisements and search engine results did not relate to Lush’s products, then there would be no infringement. That depended on the average consumer’s perception of Amazon’s retail business, as well as the content of the advertisement and the context in which they appeared.

Amazon infringement?

Deputy Judge John Baldwin QC found:

- i) Amazon did infringe when advertisements were triggered in

search engine results pages that used the term LUSH because consumers would expect to see Lush products on the Amazon website;

- ii) Amazon did not infringe when generic advertisements were triggered in search engine results pages because consumers are familiar with sponsored advertisements appearing from competitors;
- iii) Amazon did infringe by providing an “auto-complete” function for LUSH within the search facility embedded in its website because the consumer’s expectation is that the items displayed are Lush products.

In reaching his decision, the Deputy Judge recognised the role Amazon’s services played in allowing consumers to enjoy the benefits of technology. However, that right:

“does not go so far as to allow a trader... to ride roughshod over intellectual property rights, to treat trade marks such as LUSH as no more than a generic indication of a class of goods in which a consumer might have an interest.”

He placed a strong emphasis on the fact that Amazon’s results pages did not show a “No results found” message, but rather simply showed items that were alternatives but which in his view were not clearly indicated as alternatives. The consequence was that consumers were left with the overall impression that the products displayed originated from the brand owner displayed on the page.

Where now?

In conclusion, businesses can still bid on competitors’ keywords. However, if the context and content of any search engine results page and advertisement mean that there is any doubt as to the origin of the goods or services, there is likely to be infringement. In making that assessment, the consumer’s perception of the brand and the retailer will be highly significant.



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Trunki case will roll on

Oliver Tidman reviews the Court of Appeal's different interpretation of scope of design

On 28 February 2014, the Court of Appeal handed down its ruling in *Magmatic Limited ("Magmatic") v PMS International Limited ("PMS")*, finding that PMS' Kiddee Case did not infringe Magmatic's registered Community design (RCD) for its Trunki children's suitcases, thereby reversing the decision of Justice Arnold in the High Court from July 2013.

To recap the principles: an RCD should protect any aspect of the appearance of the whole or a part of a product resulting from its lines, contours, colour, shape, texture or the materials from which it is made. The design must be new and have individual character compared to the prior art. An RCD shall confer on its holder the exclusive right to use it and to prevent any third party from using it without consent. Use covers the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated. The scope of protection conferred by an RCD includes any design that does not produce on the informed user a different overall impression.

The particular designs in question are (shown above, left to right): Magmatic's original award-winning Rodeo; Magmatic's RCD; Magmatic's Trunki product as marketed; and one of PMS's Kiddee Case products, which PMS admitted was inspired by the Trunki and was intended to be a discount version.

At first instance, Arnold J held that the Magmatic RCD protected the shape of the case only and therefore the proper comparison was with the shape of the PMS Kiddee Case. Other aspects of the design of the Kiddee Case, such as any graphical designs on its surface, had to be ignored in the comparison. Applying this interpretation, Arnold J held that the Kiddee Case infringed Magmatic's RCD as it created the same overall impression on the informed user.

Appeal judgment

The Court of Appeal found (with Lord Justice Kitchin giving the leading judgment) Arnold J's reasoning to be flawed in two respects:

1) Surface ornamentation

The Court of Appeal held that the first instance judge was wrong to base his assessment only on the shape of the Kiddee Case, while ignoring other aspects, such as the graphical surface ornamentation, because he had failed to carry out a "global comparison". Disagreeing with Arnold J, the Court of Appeal took account of the various aspects of surface decoration on PMS' product to produce the overall impression of the product, and decided that the surface decoration was relevant because the judge had failed to appreciate that the RCD is "a design for a suitcase which, considered as a whole, looks like a horned animal".

In contrast, the alleged infringing Kiddee Case created the impression of



The scope of protection conferred by a registered Community design includes any design that does not produce on the informed user a different overall impression

a "tiger with ears", which in the words of the appeal judge is "plainly not a horned animal". The Court of Appeal relied upon *Samsung Electronics (UK) Limited v Apple Inc* [2012] EWCA Civ 1339 to conclude that the surface ornamentation of the Kiddee Case "significantly affects how the shape itself catches the eye" and these differences should be taken into account. Kitchin LJ added that "...the overall impression created by the Trunki registered design is that of a horned animal. It is a sleek and stylised design and, from the side, has a generally symmetrical appearance with a significant cut-away semicircle below the ridge. By contrast, the design of the Kiddee Case is softer and more rounded, and evocative of an insect with antennae or an animal with floppy ears. At both a general and





a detailed level, the Kiddee Case conveys a very different impression.”

2) Colour contrast

Although the RCD representations were in monochrome, meaning that the design was not limited to particular colours and thus PMS could not argue the colour of the Kiddee Case as being a point of distinction, each of the representations showed a distinct contrast in colour between the wheels and the strap, on the one hand, and the rest of the suitcase, on the other. The Court of Appeal held that this colour contrast between the wheels and the body of the RCD was a striking feature not present in the Kiddee Case design. On this point, Kitchin LJ referred to Procter & Gamble Co v

Reckett Benckiser (UK) Ltd [2006] EWHC 3145 (Ch). While Kitchin LJ agreed that this authority meant that PMS could not argue the colour of the Kiddee Case as being a point of distinction, it did not prevent PMS from relying on the Kiddee Case’s lack of colour contrast.

In light of these two points, the Court of Appeal found that the overall impression created by the two designs on the informed user was “very different”.

Comment

As to the scope of protection afforded to an RCD, both the surface ornamentation and colour contrast points undoubtedly warrant clarification by the UK Supreme Court and even a referral to the Court of Justice of the European Union. Peculiarly, the Court of Appeal decided that a feature of the Trunki cases was “horns” and that the absence of horns in the Kiddee Case contributed significantly to its decision that the two cases gave a very different overall impression, despite Trunki’s case handles also representing ears or antennae, depending on the child’s interpretation of its travel “companion”.

Furthermore, the colour contrast point looks to depart from established design law in Procter & Gamble, notwithstanding Kitchin LJ’s effort to distinguish it and despite the fact that several versions of the Kiddee Case do in fact have contrasting wheels.

The decision does not change the ruling by the first instance judge that PMS had intentionally copied certain unregistered UK design features of the Trunki design, for which the Court ruled PMS must pay Trunki royalties. *Briffa represent Magmatic (Trunki).*



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Toy fight takes a further turn

Angela Thornton-Jackson reflects on an unfortunate aspect of OHIM practice

This case before the General Court involved two actions brought against decisions of the fourth Board of Appeal that had been rendered in connection with two sets of opposition proceedings between Diset SA (“Diset”) and Mega Brands International, Luxembourg, Zweigniederlassung Zug (“Mega Brands”). The General Court was asked to reconsider findings made

as to likelihood of confusion and to the distinctive character of the earlier trade mark. However, the decisions it made still left it unable to finally determine the original opposition due to OHIM’s practice of not adjudicating on all rights relied upon in the proceedings.

The two trade marks applied for by Mega Brands were the logo (opposite) and word mark MAGNET.

In each case the goods claimed were: “Toys and playthings, in particular multi-part construction toys, its parts, its accessories and its fittings.”

Diset filed oppositions, relying, in particular, on earlier national rights in a registered Spanish trade mark for the word MAGNET 4. The earlier right covered: “games, toys, gymnastic and sports articles not included in other classes; decorations for Christmas trees.”

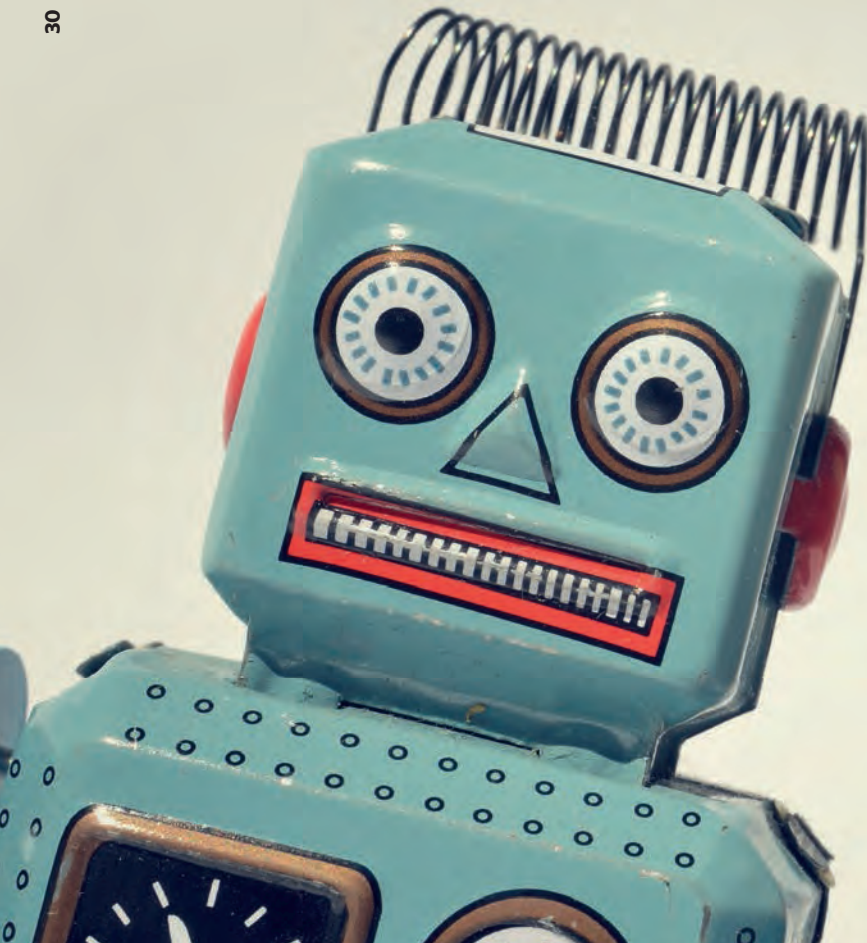
The oppositions succeeded on the basis of Article 8(1)(b) of the Council Regulation (EC) 207/2009 (the Regulation), with the Opposition Division finding a likelihood of confusion between the respective trade marks. The Applicant appealed, but the Board of Appeal dismissed both appeals.

Mega Brands did not contest the Board of Appeal’s assessment of the relevant public (the average Spanish-speaking consumer), nor its finding that the relevant goods were similar. However, Mega Brands did dispute the assessment made by the Board of Appeal that the signs at issue were visually similar to a certain degree and phonetically similar to a medium degree. Mega Brands also argued that the signs at issue were conceptually dissimilar.

Mega Brands additionally challenged the Board of Appeal’s assessment that the earlier mark MAGNET 4 had an average distinctive character.

Mark specifics

With regard to the logo mark, the General Court found that the mark clearly separated into two component parts: “mag” and “next”. The excessive size of the capital letter X and its stylisation had the effect that the relevant public would retain an image of the English word “next”, producing a specific visual impression not created by the sign MAGNET 4. Similarly, the capital letter X was found to give rise to a clear pronunciation of the second component of the figurative mark. Combined with the visual separation of the two elements, this would result in a phonetic reproduction of the mark as two words. In contrast,



the earlier mark would be pronounced as a single word “magnet” and the number 4.

The General Court therefore concluded that the figurative mark applied for had only a very weak degree of visual and phonetic similarity to the earlier mark.

However, since the word mark MAGNEXT lacked the stylisation of the logo mark, it was held to have an average degree of visual and phonetic similarity to the earlier mark MAGNET 4.

Conceptually, the General Court found that the conflicting marks were different. There was no conceptual similarity between either the word or figurative mark applied for and the Spanish word mark MAGNET 4. The word MAGNEXT did not exist in Spanish and would be perceived as being fanciful, whereas the word MAGNET would be associated with the Spanish word “magnético”, and would be understood to denote products having magnetic properties.

With regard to the assessment of the distinctive character of the earlier mark, the General Court had already noted that the relevant public would associate it with objects with magnetic properties. Evidence produced by the Applicant showed that the promotion of the magnetic properties of games and toys was common practice among operators active in the sector, including the owner of the earlier mark. In those circumstances, the General Court found that the earlier trade mark sent a message about the characteristics of the products for which the mark had been registered. Contrary to the finding made by the Board of Appeal, the distinctive character of the earlier trade mark was not medium, but weak.

Accordingly, in the context of the global assessment of a likelihood of confusion, taking into account the very slight degree of similarity between the figurative mark applied for and the weak distinctive character of the earlier mark, the General Court found that the Board of Appeal had made an error in its assessment by finding a likelihood of confusion between those respective trade marks

It is unfortunate that OHIM does not adjudicate on all of the earlier rights relied upon in an opposition. This case highlights one of the outcomes of that practice

for the purposes of Article 8(1)(b) of the Regulation. Even if the products covered by the marks in question were partly identical, the overall impression given to the consumer was sufficiently different to avoid a risk of confusion.

However, since the similarity between the word mark MAGNEXT and the earlier mark MAGNET 4 was greater, the Board of Appeal’s finding as to likelihood of confusion was upheld, despite the weak distinctive character of the earlier mark. The refusal of Mega Brands’ application for the word mark was therefore maintained.

Logo findings

With regard to the logo mark, although Mega Brands had successfully overturned the findings of the Board of Appeal, it did not succeed in dismissing the opposition




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to its application entirely. While OHIM had chosen to decide the opposition on the basis of the Spanish national right only, in fact the Opponent had also based the opposition on a figurative Community Trade Mark (CTM) incorporating the words “Diset Magnetics”.

No assessment had been made with regard to that right and consequently a final judgment could not be given. The General Court held that it could not dismiss the opposition.

Unfortunate conclusion

One assumes that the case will now be returned to the Opposition Division for adjudication based on the earlier CTM, and the parties will have to make recourse to the Board of Appeal and General Court for a second time if they are unhappy with the ultimate decision. This is obviously very unsatisfactory for Mega Brands in particular, whose application has now been pending since January 2008 without final determination.

It is an unfortunate practice that OHIM does not adjudicate on all of the earlier rights relied upon in an opposition. This case highlights one of the outcomes of that practice. Equally inconvenient is the situation in which OHIM decides an opposition on only one of several European Union national rights, leaving the unsuccessful CTM applicant free to convert the application into those other Member States and the earlier right holder is put to the expense of separate national opposition proceedings. From a tactical perspective, this practice means that opponents might be advised to choose their strongest right as basis for an opposition (preferably a CTM), rather than relying on several different national rights.

Clear-cut in Caldea

Settled case law provided a straightforward guide, says Eleni Mezulanik

On 22 July 2010, Semtee filed a Community Trade Mark application for the word mark CALDEA for, *inter alia*, “soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices” (class 3), “consultancy relating to business management of leisure premises, non-medical, making use of water, in particular heated water, for relaxation, leisure, physical maintenance of and keeping fit in the field of health” (class 35) and “personalised consultancy, advice and assistance relating to the operation of a leisure centre, non-medical, relating to water, in particular heated water, for relaxation, leisure, physical maintenance and keeping fit in the field of health” (class 44).

The application was published on 20 September 2010 and dm-drogerie markt GmbH & Co KG (“dm-drogerie”) filed a notice of opposition against registration of the mark for the above-mentioned goods and services based on its earlier international trade mark No 0894004, BALEA, in classes 3, 5 and 8 (covering, *inter alia*, “soaps, perfumeries, essential oils, preparations for hygienic and beauty use”) designating protection in the

European Union (EU). The Applicant claimed infringement under Article 8(1)(b) of Council Regulation (EC) No 207/2009.

The Opposition Division rejected the opposition and dm-drogerie filed a notice of appeal with OHIM against the decision.

The appeal

The First Board of Appeal of OHIM (the Board) assessed the likelihood of confusion, bearing in mind the likelihood of association between the marks, to ascertain whether the application should proceed to registration.

The Board considered the average consumers in all European Member States, who were judged to be reasonably well informed and reasonably observant and circumspect. In accordance with settled case law, the Board assessed the marks as a whole, taking into account the visual, phonetic and conceptual aspects, considering their distinctive and dominant elements.

Decision

While there may exist some visual similarities on account of the

coincidence of the two-letter sequences, _AL and _EA, in the marks, there are sufficient differences between the marks when perceived as whole.

Phonetically, the Board found that the marks had a low degree of similarity, irrespective of the fact that they contained the same number of syllables and sequence of vowels.

The marks were not conceptually similar as the mark applied for has no meaning and the earlier mark has a meaning of which only a small population of the EU is aware.

Overall, the marks were visually and conceptually dissimilar and had a low degree of phonetic similarity. The Board held that the average consumer will pay more attention to the visual perceptions of the signs. Further, the degree of phonetic similarity should not be given much weight unless contact between the goods of interest and the public is established by means of sound. As a consequence, the marks were dissimilar when considered in their entirety.

This appeal was dismissed as a likelihood of confusion did not exist, even for the identical goods in class 3. The decision was not affected by the alleged reputation of the earlier mark, particularly in Germany, nor was such evidence assessed as the signs had been found to be dissimilar overall.

While this decision is, perhaps, unsurprising, it provides a useful example of the straightforward application of settled case law concerning the assessment of a likelihood of confusion.



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Music mark makes case

Chris Morris sounds out the arguments in two recent appeals

In these cases, the General Court considered appeals against successful oppositions brought by Lidl Music spol sro (“Music”) on the basis of its earlier Czech national registration for the first mark shown on this page (top), covering musical instruments.

The oppositions were directed against two marks (shown right), covering the identical goods, musical instruments.

OHIM accepted the proof of use supplied by Music to sustain the oppositions and upheld them on the basis of a likelihood of consumer confusion.

Lidl Stiftung (“Stiftung”) appealed to the General Court arguing, first, that no genuine use of the Czech right had been demonstrated and, second, that in any event there was no likelihood of confusion.

Proof of use

Stiftung submitted that the few photos and invoices provided by Music did not, of themselves, demonstrate effective and genuine use of the registered mark.

In considering this argument, the Court ran through the overall assessment criteria, and confirmed that regard must be had to the “place, time, extent and nature of use of the earlier trade mark”.

Undated photographs showing the earlier mark emblazoned on a flute and harmonica were found to be use consistent with the distinctive function of the mark, ie trade origin. Invoices supplied by Music were found to demonstrate the place, time and extent of use, and, taken overall, genuine use was proven.

Stiftung’s second prong of attack on the evidence furnished by Music centred on the fact that another mark (shown above, second from top) was used.

According to Stiftung, the absence of the figurative element present in the registered mark (the circle containing an ornate LM device) changes the distinctive character of the mark, even though the word elements remain unchanged. To accept use of the words alone as genuine use of a complex mark with figurative elements would give broader protection than its use merited.

The Court reiterated that use of a mark in a form differing in elements that do not alter the distinctive character of the mark will constitute “use”. This allows commercial flexibility to a brand owner, enabling it to adapt to marketing and promotional requirements.

It is settled case law that, where a mark is composed of word and figurative elements, the words are, generally, more distinctive. In this case, the device is merely a stylised presentation of the two words and has no inherent semantic content of its own. No error was made and genuine use was correctly found.



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

The Music marks



The Stiftung marks



T-225/12



T-226/12

Likelihood of confusion

The Court then went on to consider likelihood of confusion. Comparing the marks overall, the verbal elements were more likely to affect the consumer than the figurative elements. LIDL was the first element in each mark, so would be considered the element to which consumers generally attach more importance. LIDL is also highly distinctive, with no conceptual meaning in Czech.

Taking all of this into account, it was correct that the signs are similar and that consumer confusion is likely. The oppositions should be upheld.

This case provides an interesting example of how use of a different sign can constitute genuine use of even a figurative registered trade mark, and just how different that sign can be. This is a relevant consideration both when thinking about opposition or other contentious proceedings, and when right holders conduct a brand audit.

Teen troubles tamed

Katie Goulding tackles a fashionable trio

On 27 February, the General Court (“GC”) upheld findings of a likelihood of confusion (“LoC”) under Article 8(1)(b) of Council Regulation (EC) No 207/2009 (“CTMR”) in three separate actions concerning Advance Magazines Publishers, Inc (the “Applicant”):

- Case T-509/12 – The contested mark TEEN VOGUE covering “clothing; footwear; headgear; parts and fittings for all the aforesaid goods” (class 25) and earlier Swedish trade mark registration No 126124 for VOGUE (word mark) in the name of Nanso Group Oy covering hosiery (class 25) (limited to these goods following a request by the Applicant that Nanso Group Oy furnish proof of genuine use of the earlier mark pursuant to Article 42(2) and (3) CTMR).
- Case T-37/12 – The contested mark TEEN VOGUE covering “goods of leather and/or imitation leather; clothing; belts, collars and leads for animals; whips; harness and saddlery; umbrellas; parasols; walking sticks; animal skins; hides; luggage; bags; shopping bags; trunks; travelling bags; hand bags, shoulder bags, backpacks and rucksacks; bicycle bags; purses; wallets; key fobs and key cases; parts and fittings for all the aforesaid goods” and earlier Spanish trade mark registration No 496371 for the word mark VOGUE covering “all kinds of umbrellas, sunshades, handles, ribs and canes for these” in class 18 in the name of Eduardo López Cabré.
- Case T-229/12 – The contested mark VOGUE (stylised), covering the same

above-mentioned goods in class 18 with the addition of accessories, and earlier Community Trade Mark No 2082287 for the word mark VOGUE, covering umbrellas in class 18 also in the name of López Cabré.

T-509/12

The submissions of the Applicant were two-fold: (i) LoC extended only to hosiery, and (ii) insufficient consideration was given to the effect of the element TEEN on the overall impression given by the contested sign. The GC confirmed the decision of the Board of Appeal (“BoA”), holding that:

- Notwithstanding the Applicant’s arguments that hosiery and headgear are not aimed at the same public and not necessarily sold in the same outlets, they share the same purpose of “clothing people fashionably” and are distributed by the same undertakings.
- Even though hosiery and footwear are not in competition, there remains a degree of complementarity between them – the public likes them to match.
- The marks had an average degree of visual and phonetic similarity. The position of TEEN at the beginning of the contested mark does not endow it with greater importance than the element VOGUE – the assessment of the marks must take into account their overall impression; the earlier mark is wholly encompassed by TEEN VOGUE.
- In respect of the conceptual comparison of the marks, the GC stated that the BoA had not carried out a complete examination of the marks.



In concluding that a conceptual comparison could not be carried out since neither of the marks had a meaning in Swedish, the BoA erred in failing to take into consideration the abilities of the Swedish public to discern their meanings. The ability of the relevant public to speak English should have been considered. Nevertheless, the finding of LoC remained the same.

T-37/12

The BoA had once again held that a conceptual comparison was not possible since neither of the marks had a meaning in Spanish. However, the GC did not question whether this had affected the legality of the decision; presumably because the number of English speakers in Spain is not significant.

The Applicant advanced the same arguments in respect of the element TEEN at the forefront of the contested mark and these were once again dismissed for the same reasons, which led to a finding of average similarity.

The Applicant also submitted that: (i) the BoA erred in law by carrying out a global assessment of the evidence of



genuine use furnished by the opponent, and (ii) the level of attention of the relevant public was greater for the goods at issue. Dismissing the claims, the GC held that:

- Evidence of genuine use is not required to be assessed on a piece-by-piece basis. Rule 22(3) of Regulation 2868/95 does not require that each piece of evidence bear indications concerning the place, time, extent and nature of use of the mark. The provisions concerning use are not in place to assess the commercial success of an undertaking, but rather to restrict the number of conflicts

between two marks. Otherwise, a finding of genuine use would be precluded in some cases where an overall assessment would show real commercial exploitation of the mark.

- Taken together, invoices and catalogue extracts were sufficient, not least because the former included product

codes corresponding with products appearing in the latter.

- Contrary to the Applicant's assertions, the goods are everyday items and do not demand a higher level of attention on the part of the relevant public.
- The BoA was correct to uphold the finding of LoC; the contested goods were identically replicated by the earlier goods and there was an average level of visual and phonetic similarity of the marks.

T-229/12

The BoA upheld this opposition as regards “umbrellas, parasols and accessories”. The Applicant argued that: (i) the BoA erred in failing to take into account the fact the contested mark had been used in relation to fashion magazines since 1917 and had a distinctive character in relation to the goods at issue, and (ii) the finding of similarity should only have applied to “accessories for umbrellas” as opposed to accessories in their entirety. Annulling the decision in part, the GC held that:

- The Applicant did not indicate the nature of the goods with sufficient precision and clarity when specifying “accessories”. Without stating what was to be understood by this description, it was not possible for BoA to find the goods to be similar to umbrellas without erring in law. The decision was annulled in respect of this part.
- In contrast, the BoA had not erred by not taking into consideration the alleged distinctive character of the contested mark. It is the distinctiveness of the mark being invoked in support of the opposition that is relevant.

The goods under comparison were considered identical (umbrellas) or to have a low degree of similarity (parasols and umbrellas) or were not sufficiently identifiable (accessories) as required by Article 26(1)(c) CTMR in conjunction with Rule 2(2) of Regulation 2868/95.



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*Marks don't have to appear on goods to prove
persuasive, reports Roberto Pescador*

This decision of the General Court provides a useful insight on the evidential requirements to establish genuine use of a trade mark and confirms that use of a mark can be proven even when it is not affixed to the goods.

Anapurna GmbH (“Anapurna”) applied to revoke Annapurna SpA’s (“SpA”) Community Trade Mark registration for ANNAPURNA (the mark) on the grounds of non-use. SpA filed evidence in support of the registration consisting mainly of invoices for goods sold under the mark and photographs of the goods themselves. However, the evidence did not include substantial examples of use of the mark affixed to the goods.

The Cancellation Division partially revoked the mark in relation to some of the goods covered by the registration. On appeal, the Board of Appeal (“BoA”) revoked the mark for a further set of goods, but maintained the registration in relation to bags (class 18), bed covers and bed linen (class 24), and clothing, slippers and headgear (class 25).

At the General Court, Anapurna alleged that SpA had failed to prove the place, duration and extent of the use of the mark. Further, it argued that the use was not consistent with the registered form of the mark. Anapurna also submitted that use was not demonstrated in relation to the goods for which the mark had been maintained. The specifics of these arguments are:

Place and date of use

Anapurna contended that, although the evidence filed comprised a significant number of invoices showing that SpA had sold products in countries across the European Union, those invoices did not constitute genuine use, as they did not show the mark affixed to the goods. The General Court dismissed this ground of appeal; the invoices contained the mark affixed to the top of the page, were dated, and stated the goods sold and the address of the purchaser.

Use not consistent with the registered form of the mark

The BoA had surprisingly held that use of the signs 5+1 ANNAPURNA and ANNAPURNAPULSE did not alter the distinctive character of the mark. Unfortunately, the General Court did not take the chance to clarify this point as it considered there was sufficient evidence that the mark had been used

as registered. Therefore, it was not necessary to consider whether the use of the sign with the extra elements altered the mark’s distinctiveness.

Use not in relation to the goods

Anapurna claimed that genuine use could not be established by relying on several invoices in conjunction with undated photographs of the goods, as it was not sufficient to establish with certainty that the goods had in fact been sold under the mark.

The General Court dismissed this argument. It confirmed (following the Court of Justice’s decision in C-17/06 Céline SARL v Céline SA and the General Court’s decision in T-132/09 Epcos v OHIM) that a connection between the mark and the goods could be established without it being necessary for the mark to be affixed to the goods. The General Court established that the invoices, which had the mark affixed at the top, established a clear connection between the mark and the goods. Although the photographs had a limited probative value, they reinforced the findings that such a connection existed.

Accordingly, the appeal was dismissed.



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Roberto is a Spanish-qualified lawyer and has extensive experience in trade mark and design prosecution, and in brand portfolio management and protection.

Knives out (again) on trade marks

Mark Daniels cuts right to the heart of this kitchenware case

In 1999 Yoshida Metal Industry Co (“Yoshida”), a Japanese manufacturer of kitchen knives, applied to register two-dimensional Community Trade Marks for “cutlery, scissors, knives, forks, spoons, whetstones, whetstone holders, knife steels, fish bone tweezers” and “household or kitchen utensils and containers (not of precious metal or coated therewith), turners, spatulas for kitchen use, knife blocks for holding knives, tart scoops, pie scoops”, in classes 8 and 21. The trade mark applications were represented as shown on this page (below right).

The applications were initially rejected by the examiner on the ground that the signs at issue were devoid of any distinctive character within the meaning of Article 7(1)(b) of Council Regulation (EC) No 40/94 (the Regulation), but that decision was annulled and the marks proceeded to registration.

Pi-Design and Bodum applied for revocation of the marks on the ground that they had been registered in breach of Article 7(1)(e)(ii) of the Regulation, namely that they were signs that consist of the shape of goods that is necessary to obtain a technical result. They relied on the appearance of the knives that Yoshida sold and on Yoshida’s own patents that referred to the handle of the knives as having “a nonskid structure comprised of an array of semispherical dents ...for preventing the knife from slipping in the user’s hand”.

The Cancellation Division of OHIM rejected Pi-Design and Bodum’s applications, but their subsequent appeals were upheld by the First Board of Appeal.

The CJEU found that, when assessing the trade marks’ essential characteristics, it was relevant to take into account other material outside the marks

The First Board of Appeal held that all trade marks (whether figurative or not) must comply with the technical function test. Turning to Yoshida’s trade marks, it found that the handle frame represented the outline of a knife handle and that the black dots were concave dents necessary to obtain the technical result of preventing the knives from slipping in the user’s hand.

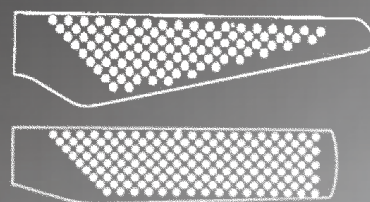
Yoshida appealed the decisions to the General Court, which found that the Board of Appeal had “reverse engineered” the trade marks, contrary

to Article 52(1)(a) of the Regulation, in that “in concluding that the dots were concave in character [it] did not refer to the sign as filed, but to representations of the goods actually marketed by the applicant”.

Pi-Design and Bodum then appealed to the Court of Justice of the European Union (CJEU), which disagreed with the General Court’s findings on “reverse engineering”. It found that, when assessing the trade marks’ essential characteristics, it was relevant to take into account other material outside the trade marks themselves (whether or not this material was in existence as at the date of the trade mark application). Such material could include “surveys or expert opinions, or data relating to intellectual property rights conferred previously in respect of the goods concerned”. Having made this finding, the CJEU sent the case back to the General Court.

One can see that material in this case (Yoshida’s patents and the products that it marketed) will become relevant to the nature of those dots on the handle, and therefore to the question of whether the trade marks fall foul of Article 7(1)(e)(ii).

Those challenging the validity of marks would be wise to consider introducing evidence of the “proper context” of the trade mark application/ registration, including an assessment of the appearance of goods in the classes covered by the trade mark as marketed and sold; it’s all relevant.



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Mark specialises in IP dispute resolution involving infringement and validity of patents, trade marks, designs and copyright, as well as reputation management and domain name disputes.

Cases don't get Tuffer than this!

A clear conceptual meaning made the difference, writes Dominic Murphy

In this case, Mr Gazzard (the Defendant) successfully defended an invalidity action against his trade mark registration for TUFFER, based on the earlier mark TUPPER registered for identical goods, on the basis that the clear conceptual meaning of TUFFER meant that there was no likelihood of confusion.

The Defendant had filed UK Trade Mark Application No 2642900 for TUFFER, claiming “drinking vessels/ tumblers” in class 21, which was registered on 1 March 2013 (the Registration). On 3 May, Dart Industries Inc (the Applicant) filed an invalidity action against the Registration based on its Community Trade Mark Registration No 7335813 for TUPPER, claiming, *inter alia*, “glassware, porcelain and earthenware; tumblers”. The invalidity action was based on an earlier similar mark registered for similar or identical goods where there exists a likelihood of confusion on the part of the public, under sections 47(2)(a) and 5(2)(b) of the Trade Marks Act 1994.

Conceptual meanings

The Applicant argued that the marks were visually and aurally similar, and that, on a conceptual level, the marks would either be perceived as surnames or as invented words, and so would not be differentiated on a conceptual level. The Defendant argued that the marks were visually and aurally dissimilar, and that, on a conceptual level, while the mark TUPPER has no meaning, the mark TUFFER immediately and directly brings to mind the word “tougher”, and so conveys the clear concept of strength and resilience.

It is well established that a clear conceptual difference between trade marks may be enough to counteract the visual and aural similarities between those signs (T-292/01 Philips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS), paragraph 54). However, for there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately (T-147/03 TIME ART v OHIM, paragraph 98 and C-206/04 P Mulhens v OHIM (SIR/ZHIR), paragraph 33). Having reviewed the submissions by both parties, the Registrar decided that the average consumer would pay (at best) a moderate level of attention to the purchase and that the goods are identical. Regarding the marks, the Registrar decided TUPPER has a high degree of inherent distinctive character and that the marks were

at least moderately visually similar and aurally similar to a high degree. However, the Registrar decided that, while TUPPER has no meaning, TUFFER would bring “tougher” to mind, and so the marks are conceptually dissimilar.

The Registrar concluded that the importance of the visual aspect of the competing marks to the selection process, and the very clear and specific conceptual meaning that will be conveyed by the Defendant’s mark, were sufficient to counteract the visual and aural similarities so that there is no likelihood of confusion.

This case is an important demonstration that if one mark has a very clear and specific conceptual meaning this can counteract visual and aural similarities even when the aural similarity is ranked as “high” when an overall view is taken.

Dominic Murphy represented the Defendant in this case.

While TUPPER has no meaning, TUFFER would bring ‘tougher’ to mind, and so the marks are conceptually dissimilar



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Scooting around genuine use

The Court focused on the qualitative, says Yana Zhou

This recent Appointed Person decision confirms, on a substantive level, that an Appointed Person will not revisit a case *de novo* as laid down in the Reef trade mark case ([2003] RPC 5, “Reef”), and that the assessment around evidence of use is a qualitative exercise, with quantitative elements being relevant but not conclusive. The case is also set against an interesting background regarding the split ownership of a famous brand.

The Lambretta brand (including the rights to the LAMBRETTA mark) was bought out by the Indian government from Innocenti in 1972, thus creating Scooters India Limited (“SIL”). The core of that business revolved around scooter manufacturing. SIL’s production seemingly ceased in the 1990s and it appears that the scooters are now manufactured by Lambretta SRL (“LSRL”). However, the UK and Community Trade Mark (CTM) registers feature several applications and registrations by both entities, which relate to ownership of the right to use the LAMBRETTA mark.

Range of goods

SIL had five registrations in the UK covering a range of goods, from vehicles to clothing. The first registration, 874581, dated from 1962. Brandconcern BV (“Brandconcern”), an entity that we can assume is connected with LSRL, sought to revoke these five registrations based on non-use. An examination

of the UK Register reveals that SIL has opposed a number of LSRL’s applications for the mark LAMBRETTA as CTMs. In what we can assume to be retaliation, Brandconcern brought cancellation proceedings against SIL’s five UK registrations, which partially formed the basis of SIL’s oppositions against LSRL’s CTM applications.

The Hearing Officer, Allan James, found that there had not been use of the mark in relation to motor vehicles in class 12, and therefore revoked SIL’s registrations 831769 and 874581 in their entirety. There was some use of the mark in relation to clothing, so registration 2107935 was revoked in its entirety except in relation to clothing. The finding that there was some use in relation to watches meant that registration 2122788 was revoked in its entirety except in relation to watches. Finally, registration 2134922 was revoked in its entirety except in relation to clothing and watches essentially.

Brandconcern then appealed to the Appointed Person, claiming that all registrations should be refused in their entirety and requesting a

re-examination and reassessment of the evidence. However, the Appointed Person, Geoffrey Hobbs QC, restated the notion that such a process would go beyond the principles in Reef and would result in the tribunal inappropriately determining the revocation in the first instance.

The Appointed Person further reaffirmed that evidence should not be separated into elements – rather it should be viewed as a whole. He saw the test for genuine use as qualitative, with quantitative aspects being relevant but not conclusive, in keeping with the conclusion in C-259/02 La Mer Technology Inc v Laboratories Goemar SA [2004] ECR I-1159 (and later [2005] EWCA Civ 978). He was satisfied that the Hearing Officer in this instance correctly applied the law.

Cases like this also remind us how cluttered and confusing the trade mark registers can be. For entities owning the same mark as another entity in a separate industry area, it will be useful to ensure that these marks are being genuinely applied. As for SIL, non-use on certain goods inevitably led to the mark scooting away.



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Yana handles various trade mark, design, copyright and domain name matters for clients across a range of sectors, and has experience in revocation proceedings.

Law of averages

The likely perception of the average consumer dictated this decision, reports Kayleigh Walker

In this judgment, the Appointed Person dismissed an appeal by Intersnack Knabber-Geback GmbH & Co KG (“Intersnack”), agreeing with the Hearing Officer’s decision to uphold the validity of the trade mark registration (2563779) for CHIQUO, shown below.

Background

In 2010, Chiquo Limited (“Chiquo”) applied for the mark CHIQUO (device mark) in classes 29, 30 and 31. Shortly after registration was granted, Intersnack brought invalidity proceedings under section 5(2)(b) of the Trade Marks Act 1994 based on its prior registered Community Trade Mark (CTM) for CHIO in classes 29 and 30.

At first instance, the Hearing Officer (Oliver Morris) decided that there wasn’t a likelihood of confusion between CHIQUO and CHIO. Although acknowledging that certain goods in class 29 (nuts/snacks prepared from nuts) were identical and that there was a good deal of similarity between other goods, Morris’ view was that there was insufficient similarity between the marks for there to be a likelihood of confusion.

Intersnack’s appeal

On appeal, Intersnack argued that Morris had erred in concluding that there wasn’t a likelihood of confusion based on the factual determinations that were made. Intersnack further argued that the Hearing Officer had failed to take into account other relevant factors when considering similarity between the two marks, such as the fact that CHIO is entirely

included in CHIQUO, that both marks have two syllables and that the position of the letters QU (in the middle of the word) reduced their significance – they would have been of more significance if they were at the beginning of the word.

The Appointed Person (Geoffrey Hobbs QC) rejected the appeal. He remarked that the evaluation of “similarity” is a means to an end; it enables the decision-maker to gauge whether there is similarity of marks that is liable to give rise to perceptions of relatedness in the mind of the average consumer. This called for a realistic appraisal of the net effect of the similarities and differences between the marks and the goods or services in issue, giving the similarities and differences as much or as little significance as the average consumer would have attached to them at the relevant point in time.

In the view of the Appointed Person, the fact that CHIQUO is a word out of which CHIO can be extracted by a process of

The fact that CHIQUO is a word out of which CHIO can be extracted by a process of dismemberment was not important

dismemberment was not important as this was not a process in which the relevant average consumer would engage. The pivotal issue for determination by the Registrar was whether there was enough visual, aural and conceptual individuality in the mark CHIQUO to enable it to coexist peacefully with the mark CHIO in use in the UK in relation to goods of the kind in issue. The Appointed Person held that it was not legitimate for him to set aside the Hearing Officer’s decision on the basis of the Applicant’s contention that he should have attached less weight than he did to the letters QU as a characterising feature of the distinctive word CHIQUO.

The case highlights the fact that, when assessing the likelihood of confusion under section 5(2)(b) of the Trade Marks Act 1994, the significance of the differences and similarities should be assessed in line with the perceptions of an average consumer.



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events

More details can be found at itma.org.uk

Date	Event	Location	CPD hours
4 June	New President's Reception	Innholders Hall, London	
9 June	Student Induction Day	CIPA Hall, London	
20 June	ITMA/CIPA CPD Webinar Marketing Skills - Winning Work, Bernard Savage, Size 10 ½ Boots		1
24 June	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
8 July	ITMA Summer Reception	The In & Out Club, London	
19 July	Intellectual Property Trainees' Ball	The Rosewood, London	
21 July	ITMA /CIPA CPD Webinar Marketing Skills- Business Development Strategy, Bernard Savage, Size 10 ½ Boots		1
22 July	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
23 July	Trade Mark Administrators' Roundtable The Role of Paralegals	Marks & Clerk, London	
13 August	Trade Mark Administrators' Roundtable The Role of Paralegals	Barker Brettell LLP, Birmingham	1
23 September	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
25 September	ITMA Autumn Seminar*	Hyatt Regency, Birmingham	5
28 October	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
18 November	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
9 December	ITMA London Christmas Lunch**	InterContinental Park Lane, London	



Trade Mark Administrators' Roundtables take place this summer in London and Birmingham

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I work as... a Partner in the London office of Withers & Rogers LLP. I am also Second Vice President of ITMA.

Before this role... I qualified as a barrister and subsequently worked in firms of solicitors including SJ Berwin. I have also worked in-house for a subsidiary of Total and had a career break for three years following the birth of my third child. I then made the decision to become a Trade Mark Attorney and worked for Nucleus IP and Haseltine Lake. I joined Withers & Rogers in 2006 and have been a partner since 2009.

My current state of mind is... a mixture of weariness (year end) and excitement – I am off to Miami and Key West on holiday in a few days!

I became interested in IP when... a Patent Attorney friend of mine suggested that it would be a better way of achieving a work-life balance compared to working in a firm of solicitors. I am also very interested in brands generally and am one of those people who will read billboards and advertising with great interest.

I am most inspired by... Professionally, I admired John Groom (a past ITMA President) for his client skills.

In my role, I most enjoy... the international aspect to my work and the opportunity to travel, particularly in the US and to INTA conferences.

I most dislike... firm politics.



Tania Clark fills in the blanks in the first of a new regular section that offers a window into the ITMA membership

On my desk is... an Andy Warhol cube puzzle, a blue leather pen-holder and a coaster that says: "So many men, so few who can afford me."

My favourite mug... is of a Banksy mural.

My favourite place to visit on business is... San Francisco.

If I were a trade mark/brand, I would be... a Louboutin red sole – it's subtle and understated.

The biggest challenge for IP is... For me, this would probably be the

expansion of emerging markets where the efficacy of their registration system is yet to be fully established. As these markets grow, so too will the desire of IP proprietors to exploit their rights and gain registered protection in these territories.

The talent I wish I had is... giving witty speeches.

I can't live without... my iPhone and watch; I am obsessed with time and emails.

My ideal day would include... a chocolate bar.

In my handbag is... perfume, wallet, a plaster, a hair clip, lipsticks, mirror, iPhone, keys and business cards (mine and other people's!).

The best piece of advice I've been given is... tailor your advice to the client.

When I want to relax, I... go to the Turkish baths at the RAC.

In the next five years, I hope to... increase my involvement with ITMA and become its President.

The best thing about being a member of ITMA is... the collegiate feel and being part of such an inclusive organisation.

If you are an ITMA member interested in taking part in the TM20 in a future issue, contact caitlin@thinkpublishing.co.uk

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Dawn Ellmore Employment specialises in the recruitment of trade mark and patent attorneys, at all stages of qualification, on a permanent, contractual or consultancy basis. We also have a dedicated support team which is able to assist across the board on the support side, including trade mark/patent secretaries, managers, supervisors, paralegals, formalities and records assistants, accounts and billing specialists, searchers, receptionists, general office and much more.

A selection of our current vacancies is shown below. Whatever your recruitment needs, we would be pleased to hear from you – please do not hesitate to contact us for a confidential discussion.

PQ/FQ TM Attorney – London

A new opening has arisen at a highly reputable law firm for a PQ/FQ Trade Mark Attorney. The impressive client list includes many household names, and the successful candidate will assist the partners to develop the practice. Ideally, candidates will have approx. 2 – 5 years' experience in the profession, with extensive experience in trade mark prosecution work. The firm offers first class support and excellent prospects for progression.

TM Formalities Assistant – London

There is nothing more satisfying than seeing the Trade Marks that you work on in the public eye! By joining this Trade Mark team you will get the chance to provide administrative support on an impressive Trade Mark portfolio that can be seen on every high street. Candidates must have a sound knowledge of all Trade Mark formalities and procedures and be able to work well under pressure whilst maintaining a meticulous attention to detail.

FQ TM Attorney – West Midlands

This renowned firm is the first stop for many burgeoning start-ups, SMEs and corporations. Having carved out an excellent reputation, the firm is pleased to invite applications from candidates with a similarly outstanding reputation. The position calls for applicants with an impressive track record, and the firm is particularly interested to hear from current trade mark attorneys with a maximum of 5 years' post qualification experience.

Trade Mark Secretary – London

We are working on an exclusive basis for this thriving firm of attorneys which is currently seeking a Trade Mark Secretary for its London office. Gaining such a great reputation doesn't come easily, and this firm rightly prides itself on what it has built. The successful candidate will be expected to deliver a first rate support service to both the attorneys and clients to ensure that this great level of client care is maintained.

Senior Level TM Attorney – London

A highly regarded private practice is seeking applications from qualified TM attorneys with over 5 years' PQE. Candidates will have a high-level academic record, and a background in a well-regarded law firm or private practice. As well as having experience in a range of IP matters, ideal candidates will possess demonstrable business development skills and will preferably be in a position to bring a following of work.

TM Secretary (x2) – Yorkshire

Over the past few decades this firm have been a rising star in the North. They are recognised for investing time in their staff knowing that a strong and happy workforce will only help drive the business even further forward. Success is evident in that they now require a further two Trade Mark Secretaries to join their highly skilled team. This is an excellent opportunity for anyone wanting to take the next step in their career.

Trade Mark Partner – Yorkshire

This rare opening represents an opportunity to be involved in a new chapter of one of the country's best established practices. This could be a career-making move for a senior associate, or the perfect opportunity for a partner looking for a new challenge at a new firm. As well as a first class standing in the profession, a reputation for providing excellent client service and producing excellent results is essential.

Trade Mark Manager – London

Candidates must have an impressive library of Trade Mark formalities knowledge and be able to offer direction on how to enhance an already established and efficient team. Excellent communication skills are a must as you will be responsible for answering any colleague or client queries. In return this leading firm offers a competitive salary and benefits package and a chance to shape the future of the department.

Trainee TM Attorney – London

We have taken on a new vacancy at a leading law firm for a trainee Trade Mark Attorney, to be based in the firm's London office. The firm is expanding its IP department and requires a trainee, ideally with previous trade mark working experience, to join its dynamic, energetic and forward thinking team. Candidates should have excellent verbal and written communication skills and be capable of working on their own initiative.

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