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ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

Issue **429** October/November 2016 itma.org.uk



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Exhibit Q&A

Sarah McPoland seeks answers from survey
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October/November 2016



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ITMA Review

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I hope that those of you who made it to our Autumn Seminar enjoyed it as much as I did. It remains one of the highlights of the ITMA calendar, and you will be able to read more about it in the next *ITMA Review*. In the meantime, I know that Trade Mark Attorneys can occasionally be a bit competitive, which is why I'm sure that many readers will go straight to page six of this edition to check on our tally of the top 100 filers in 2015, supplied by Corsearch. Of course, we all know that it's not just about the numbers!

Increases in fees are always a concern for clients, and developments in the Gulf Cooperation Council countries (page 20) will need watching closely. You can also read about fee changes in Thailand on page 25. Perhaps the article by Jade MacIntyre on a topic related to pop culture (page 10) will be the antidote to fee concerns, while we also feature expert tips on surveys, interviews and strategy.

Kate O'Rourke

Kate O'Rourke
ITMA President

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ITMA Insider

Chief Executive's bulletin

Highlights from and updates to Keven Bader's
8 August message to members



NO BREAK FROM BREXIT

Since a vote to leave the EU was returned on 24 June, ITMA has been on the front foot to ensure that we are well positioned to support the profession as plans develop for the UK's exit from the EU.

We have sent various communications over the past few weeks and months to keep you up to date with developments and what ITMA is doing. We have put together a Brexit Task Force that is looking at and leading on two particular areas: protection of EU registered rights, and professional representation before EUIPO. The latest guidance on these two areas can be found on the ITMA website.

In other areas, we are offering a supportive role to the organisations that have agreed to lead. It is our view that organisations need to work together, and we are pleased that everyone is willing to come together on these important matters.

During September, we had a series of meetings with the UK IPO, and we hope to be able to assist and influence it as work continues in setting out the future plans, procedures and requirements for a post-Brexit world.

Our key message to members has been "don't panic", and that remains the case. It appears the UK Government will not be triggering Article 50 of the Lisbon Treaty this year; therefore, there is still a long way to go before the UK actually leaves the EU and we start to understand the kind of deal the UK will seek. On a recent ministerial trip to China, the Minister for IP and the

accompanying delegation, including ITMA Past President Catherine Wolfe, delivered the message that "Britain is open for business", and the situation is very much "business as usual". We support this and encourage members to continue as normal.

OUR NEW IDENTITY IS GETTING NEARER

In September, I was privileged to see the first concept for the logo and branding to accompany our new identity as the Chartered Institute of Trade Mark Attorneys. It really brought home what a major change our new chartered status will be. I am feeling very positive about the change, both for the organisation and our members, and I am excited about the

platform it will provide for all of us in the work that we do.

INCLUSION ACTIVITY

The IP Inclusive Charter has now been signed by 74 firms, each of which has publicly committed to adhere to the principles of equality, diversity and inclusion. If your firm has yet to sign up to the charter, you can find out more about how to do so at ipinclusive.org.uk. The initiative will be celebrating its first birthday in November; it would be great to reach the 100-firms mark by then.

The scheme is building support networks, with two in place. IP Out, for LGBT people and "straight allies", has already been launched, and the Women in IP network is due to officially launch on 2 November. ■

04 |

ITMA joins China delegation

ITMA Past President Catherine Wolfe (pictured) joined colleagues from the Chartered Institute of Patent Attorneys and other IP organisations to accompany Minister for Intellectual Property Baroness Neville-Rolfe and other Government officials on a visit to China and Hong Kong in August. The group met key officials and delivered presentations promoting the UK's IP system. We'll have a full report in our next issue.



Member *move*



Wildbore & Gibbons LLP is delighted to announce that **Sarah Talland** has become a Partner at the firm as of July 2016. “Sarah has been an integral member of the team and an invaluable colleague since joining the firm. Her promotion is fully deserved,” said Janella Barr, Partner at the firm.



► The successful candidates with their certificates; (inset) Keven Bader addresses the special ceremony

Summer successes celebrated

Congratulations to all of those who successfully completed the 2016 ITMA Trade Mark Administrators’ Course exam and received their certificates at a special ceremony in September. See the full list of names to the right. Particular mention goes to joint high scorers Jade Coggle and Nathan Chambers, who both achieved 97 out of 100. The course attracted a record number of attendees this year, and a record high in exam passes.

The 2017 course is not yet open for registration, but please email marzia@itma.org.uk to register your interest.

Oluwafeyikemi	Akinjogbin
Alison	Andrews
Natalie	Barnard
Laura	Benedict
Anyani	Boos
Thomas	Bradley
Marion	Brown
Tamara	Bukatz
Audrey	Buttle
Laura	Calder
Sarah	Cantrill
Nathan	Chambers
Jade	Coggle
Remmy	Corley
Ionut	Crivac
Mark	Dainty
Hannah	Damjanovic
Kate	Davison
Julia	Dearden
Jonas	Delkurt
Paul	Farrell
Rebecca	Flaherty
Gabriella	Ford
Agnieszka Katarzyna	Gabarczyk
Carlos Eduardo	Galhardi Alves
Charlotte	Gamero
Ariadni	Gemtou
Ahad	Ghanbary
Ioana	Ghiurco
Justin	Gleeson
Genevieve	Graeff
Anne	Hancock

Leila	Harper
Joan	Harris
Mel	Hayward
Annett	Herzog
Sabine	Heusterberg
Lucy	Hollis
Michelle	Holman
Grace	Hooper
Razeena	Hussain
Mehmet Reha	Ilnem
Samantha	Johnson
Sharon	Jones
Janine	Kirby
Charlotte	Knight
Carla	Lee
Sarah	Lees
Chiara	Look
Wan Ming	Lui
Georgina	Lynch
Shiva	Mahmoodi
Loreta Elizabeth	Mencattelli
Martina	Metodieva
Joanna	Moat
Elliot	Moignard
Eunice Teresa	Mounfield
James	Newton
Daniella	Nicola
Stacy	Notman
Johanna	Onslow
Chris	Orbell
Laura	Owen
Jill	Parker
Elvira	Peccerillo
Natalie	Phillips
Amy	Pilkington
Ana	Popa
Allison	Rackliff
Rachel	Robertson
Deana	Rogers
Madara	Rubino
Noemi	Rubio
Gillian	Scott
Jaswinder	Sehangera
Gavin	Shaw
Mark	Shuttleworth
Lynda	Simpson
Kelly	Smith
Monika	Spiewak
Scott	Stanley
David	Sutherland
Alex	Symons
Meera	Taank
Heather	Tandy
Joze	Taylor
Jonathan	Thwaite
Kulpreet	Virdi
Rachel	Watters
Tom	Williams
Charlotte	Woolston
Phil	Wright
Sunny	Yadu
James	Yeo
Metodi	Yurukov

TOP FILERS 2015

Discover which UK representatives filed the most UK and EU trade marks last year

ONCE AGAIN, Corsearch has mined trade mark registration data to provide the *ITMA Review* with a tally of UK Trade Mark (UKTM) and EU Trade Mark (EUTM) filings over the 2015 calendar year. The tables on the following two pages give details of the top 100 firms or representatives in terms of marks filed. Taken together, the top 100 UK agents listed filed a total of 12,538 UKTMs and 15,158 EUTMs.

HGF CORRECTION

The *ITMA Review* has become aware that the figures reported in the May 2015 issue regarding HGF Ltd's filings in the 2014 calendar year were erroneously presented. This was due to an entity being omitted from collation. The revised figures are: UKTM – 376; CTM (now EUTM) – 485. This raises HGF's 2014 ranking from number four

to number two in the top 100 UKTM and CTM filers lists in that issue. Our apologies to HGF for this error.

DATA COLLECTION IN DETAIL

Source: corsearch.com. Figures represent filers that are the current UK agents for EUTMs or UKTMs for which applications were made in 2015. They do not include corporate filers. Where a trade mark's ownership was transferred between agents during the year, both the first and new representative will be credited. Figures do not represent WIPO-designated filings. Where firms have acquired other firms, the full representation of filing statistics may not be captured. Where firms have multiple IPO accounts under separate naming conventions, we cannot guarantee complete representation. For any individual queries, please contact order@corsearch.co.uk.

TOP 100 UKTM FILERS

1	MARKS & CLERK LLP	481	= SIPARA LTD	93
2	MURGITROYD & COMPANY	387	52 BIRD & BIRD LLP	87
3	WILSON GUNN	361	53 FIELDFISHER LLP	85
4	THE TRADEMARK HELPLINE	344	54 OLSWANG LLP	84
5	HGF LTD	338	55 WYNNE JONES LAINE & JAMES LLP	83
6	URQUHART DYKES & LORD LLP	325	56 TRADEMARKROOM LTD	82
7	WITHERS & ROGERS LLP	293	57 KATARZYNA ELIZA BINDER-SONY	78
8	STOBBS	288	= LAWRIE IP LTD	78
9	D YOUNG & CO LLP	277	59 SAUNDERS & DOLLEYMORE LLP	77
10	KELTIE LLP	276	= WALKER MORRIS LLP	77
11	GROOM WILKES AND WRIGHT LLP	268	61 EVERSHEDES	76
12	APPLEYARD LEES	261	= STEPHENS SCOWN LLP	76
13	BARKER BRETTELL LLP	258	63 ABEL & IMRAY	72
14	BOULT WADE TENNANT	255	64 ADDLESHAW GODDARD LLP	71
15	TRADE MARK WIZARDS	239	= BIRKETTS LLP	71
16	DEHNS	210	66 BRISTOWS LLP	69
17	FORRESTER	208	67 NABARRO LLP	68
18	MATHYS & SQUIRE LLP	184	68 BATES WELLS & BRAITHWAITE LONDON LLP	67
19	SWINDELL & PEARSON LTD	175	69 FRKELLY	66
20	NUCLEUS IP LTD	171	70 EDWIN COE LLP	65
21	BECK GREENER	165	= POTTER CLARKSON LLP	65
22	TRADEMARK EAGLE LTD	164	72 CARPMAELS & RANSFORD LLP	63
23	GILL JENNINGS & EVERY LLP	162	= ELKINGTON AND FIFE LLP	63
24	KILBURN & STRODE LLP	156	= FREETHS LLP	63
25	NOVAGRAAF UK	149	= MW TRADE MARKS	63
26	WILDBORE & GIBBONS LLP	146	76 IP21 LTD	62
27	LEWIS SILKIN LLP	144	77 ASHFORDS LLP	61
28	REVOMARK	143	= BARON WARREN REDFERN	61
29	BAYER & NORTON BUSINESS CONSULTANT LTD	141	= KEMPNER & PARTNERS LLP	61
30	STEVENS HEWLETT & PERKINS	139	80 BOND DICKINSON LLP	59
31	HARRISON IP LTD	131	81 BROOKES BATCHELLOR LLP	57
32	TAYLOR WESSING LLP	128	82 FRANKS & CO LTD	56
33	BAKER & MCKENZIE LLP	126	= HARPER MACLEOD LLP	56
=	JA KEMP	126	= TRADE MARK CONSULTANTS CO	56
35	SILVERMAN SHERLIKER LLP SOLICITORS	125	85 DUMMETT COPP LLP	55
36	ALBRIGHT IP LTD	123	= FOOT ANSTEY	55
37	AA THORNTON & CO	120	= LANE IP LTD	55
38	VENNER SHIPLEY LLP	116	= PENNINGTONS MANCHES LLP	55
39	CLEVELAND	115	89 JAMES LOVE LEGAL LTD	54
40	AXIS IP SERVICES LTD	110	90 BRABNERS LLP	53
=	RGC JENKINS & CO	110	= MISHCON DE REYA LLP	53
42	REDDIE & GROSE LLP	108	= SCOTT & YORK INTELLECTUAL PROPERTY LAW	53
43	BAILEY WALSH & CO LLP	104	93 IRWIN MITCHELL LLP	51
=	HASELTINE LAKE LLP	104	94 CHARLES RUSSELL SPEECHLYS LLP	50
45	PAGE WHITE & FARRER	103	95 BLAKE MORGAN LLP	49
46	BRIFFA	101	= FILEMOT TECHNOLOGY LAW LTD	49
47	WP THOMPSON	100	97 BRYERS LLP	48
48	SQUIRE PATTON BOGGS UK LLP	97	= SANDERSON & CO	48
49	MEWBURN ELLIS LLP	95	= THE TRADE MARKS BUREAU	48
50	CHANCERY TRADE MARKS	93	= TRADE MARK DIRECT	48

TOTAL: 12,538

TOP 100 EUTM FILERS

1	MARKS & CLERK LLP	572	52	BRIFFA	108
2	BOULT WADE TENNANT	454	=	BRISTOWS LLP	108
3	HGF LTD	441	54	DOLLEYMORES	106
4	KELTIE LLP	383	55	AA THORNTON & CO	104
5	FORRESTERS	366	56	ASHFORDS LLP	103
6	KILBURN & STRODE LLP	362	57	MISHCON DE REYA LLP	102
7	BARKER BRETTELL LLP	358	58	NABARRO LLP	97
8	LANE IP LTD	357	59	DLA PIPER UK LLP	96
9	STOBBS	335	=	SILVERMAN SHERLIKER LLP SOLICITORS	96
10	WITHERS & ROGERS LLP	326	=	SIPARA LTD	96
11	D YOUNG & CO LLP	322	62	ROUSE IP LTD	91
12	BAKER & MCKENZIE LLP	314	63	SCOTT & YORK INTELLECTUAL PROPERTY LAW	89
13	MURGITROYD & COMPANY	304	64	BAILEY WALSH & CO LLP	87
14	JA KEMP	282	=	TRADEMARK EAGLE LTD	87
15	URQUHART DYKES & LORD LLP	253	66	BOND DICKINSON LLP	86
16	DEHNS	246	=	HANSEL HENSON LTD	86
17	GILL JENNINGS & EVERY LLP	245	68	ABEL & IMRAY	84
18	FIELDFISHER LLP	240	=	DECHERT LLP	84
19	JEFFREY PARKER AND COMPANY	238	70	BERWIN LEIGHTON PAISNER LLP	80
20	COOLEY UK LLP	235	=	CHAMPION INTELLECTUAL PROPERTY MANAGEMENT LTD	80
=	MEWBURN ELLIS LLP	235	72	SANDERSON & CO	77
22	PAGE WHITE & FARRER	228	73	DUMMETT COPP LLP	75
23	LEWIS SILKIN LLP	226	74	CLARKE WILLMOTT	73
24	RGC JENKINS & CO	222	=	SWINDELL & PEARSON LTD	73
25	MATHYS & SQUIRE LLP	219	76	CHAPMAN+CO	67
26	BIRD & BIRD LLP	216	77	RENAISSANCE SOLICITORS LLP	65
27	KATARZYNA ELIZA BINDER-SONY	196	78	NORTON ROSE FULBRIGHT LLP	63
28	CLEVELAND	194	79	EDWIN COE LLP	62
29	WILSON GUNN	190	80	TRADEMARKROOM LTD	60
30	BECK GREENER	188	81	OAKLEIGH IP SERVICES LTD	59
=	TAYLOR WESSING LLP	188	=	PHILLIPS & LEIGH	59
32	REDDIE & GROSE LLP	164	=	THE TRADE MARKS BUREAU	59
=	TRADE MARK DIRECT	164	84	CHARLES RUSSELL SPEECHLYS LLP	58
34	APPLEYARD LEES	161	=	SQUIRE PATTON BOGGS UK LLP	58
35	GROOM WILKES & WRIGHT LLP	156	86	GRAHAM WATT & CO LLP	55
36	CARPMAELS & RANSFORD LLP	148	87	HARRISON IP LTD	54
37	THE TRADEMARK HELPLINE	145	88	IRWIN MITCHELL LLP	53
=	WILDBORE & GIBBONS LLP	145	89	NUCLEUS IP LTD	52
39	LADAS & PARRY LLP	143	90	AXIS IP SERVICES LTD	51
40	POTTER CLARKSON LLP	134	=	EIP	51
41	ALBRIGHT IP LTD	130	=	RAPISARDI INTELLECTUAL PROPERTY LTD	51
=	STEPHENS SCOWN LLP	130	=	WILLIAMS POWELL	51
43	HASELTINE LAKE LLP	124	94	CLIFFORD CHANCE LLP	50
44	LOCKE LORD LLP	123	=	REVOMARK	50
45	STEVENS HEWLETT & PERKINS	122	96	BROOKES BATCHELLOR LLP	49
46	WP THOMPSON	121	=	PAGE HARGRAVE	49
47	WYNNE JONES LAINE & JAMES LLP	120	98	FOX WILLIAMS LLP	47
48	OLSWANG LLP	116	=	JAMES LOVE LEGAL LTD	47
=	SIMMONS & SIMMONS LLP	116	100	JOSHI WORLDWIDE IP	46
50	VENNER SHIPLEY LLP	115			
51	SHERIDANS	112			

TOTAL: 15,158

Funny BUSINESS

Jade MacIntyre looks into the IP challenges posed by super fans who create their own art derivative of artistic work created by others

For those who aren't regular visitors at Comic Con or deviantart.com, it may be useful to provide a short introduction to "fan art". Essentially, fan art is unofficial, derivative artistic work created by fans of books, television shows, cartoons or films, and is particularly prevalent in the sci-fi, fantasy and anime genres (the related practice of "fan fiction" is the creation of unofficial, derivative literary works). While not (usually) endorsed by the authors or owners of the original inspiring work (original creators), fan art usually contains identifiable visual elements linking it to the original work or canon of work.

From this brief introduction, it will be clear why fan art is most often perceived to be a copyright issue (particularly where it reproduces to some extent an original artistic work), yet the use of brands and trade marks within fan art causes distinct problems for rights holders due to the nature of those rights. And it also creates an uncomfortable situation for rights holders, who may simultaneously wish to adequately protect their IP and avoid alienating their most ardent fans.

The tension is created because, although somewhat niche, fan art can

be seen as hugely important to original creators where it can be a vehicle to promote and sustain customer or audience engagement. So, when it comes to protecting their IP, original creators are alive to the need to take action to enforce their rights without alienating their most passionate (and vocal) fans and damaging brand perception, but with sufficient robustness that they are effective in preventing their IP becoming, essentially, public domain.

Some original creators have, arguably, got the balance wrong and have gained the reputation of being unfriendly towards their fans (for example, by shutting down any activity on internet forums), while others appear to have embraced their fans' approach. Presumably, the difference in strategy depends upon an analysis of what original creators consider produces the greatest overall benefit for them. It may, for example, depend upon the size of the market and the relative size of the fan-art community, as well as the value that is extractable from the rights at issue through, for example, merchandising deals.

FUNIMATION

The issues that the use of trade marks in fan art creates for original creators ►



are highlighted by US entertainment and anime/manga foreign-licensing company Funimation's 2015 statement¹, in which the company made a distinction between how it will enforce its copyright and trade mark rights. The statement noted Funimation's appreciation of the artistic effort that goes into the creation of derivative works, but stated that, while it will not enforce its copyright against fan art made available in "artists' alleys"², it would take action if the fan art used its trade marks in conjunction with the work. This is indicative of the special status in which Funimation holds its trade mark rights. Funimation did, however, make it very clear that it would strictly enforce both its copyright and trade mark rights, almost without exception, within "dealers' rooms"³, even if the works would ordinarily be considered fan art. It is interesting to note the difference in approach depending upon the location within a convention – the implication being that the dealers' room is a more commercial forum.

The likely reason for Funimation's strict approach to its trade mark rights is that (as distinct from copyright), under US law, proprietors are, essentially, required to enforce their trade marks to avoid them falling into the public domain. Section 45 of the Lanham Act (15 USC § 1127) provides that: "A mark shall be deemed to be 'abandoned' ... When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark."

ORCHIDS AND CACTI

While copyright, if neglected, will continue to thrive, trade marks require more intensive attention. In this respect,



copyright can be likened to cacti and trade marks to orchids. If a copyright holder fails to enforce their copyright, they may suffer the infringement but not the loss of their right. If a trade mark owner fails to take action against an infringer, it may lead to a court making a finding of acquiescence on the part of the right holder⁴, as well as to cause a mark to lose distinctiveness. Such acts of omission have been held, in the US, to include failing to police and take action against infringers.⁵ While English and Welsh law does not expressly place a positive obligation upon a trade mark owner to detect and prevent infringing use of a trade mark, failure to take appropriate action could nevertheless see a trade mark become vulnerable to invalidity attacks (on the basis of becoming generic or non-distinctive).

In respect of fan art, it is foreseeable that there might be a distinction between use of a trade mark within a work (where it may be contextually relevant) and use of a trade mark to promote the fan art for sale. In any event, in either case such use is unlikely to be compliant with brand guidelines and may serve to dilute the distinctiveness of the trade mark and its ability to function as a guarantee of origin.

The provisions of the US Lanham Act relating to deemed "abandonment" of a trade mark necessitate that a right holder exercises adequate supervision of a licensee's activities to ensure that the mark continues to signify a single source and uniform quality. In *Eva's Bridal Ltd v Halanick Enterprises, Inc*⁶, the US court found that the trade mark owner's trade mark had been abandoned due to failure to ensure consistent and predictable quality by its licensee. Engaging in "bare" or "naked" (insufficiently supervised) licensing may therefore result in a trade mark

“

The risk of being deemed to have granted a 'bare' licence to fans to use trade marks is something that original creators should be wary to avoid

becoming unenforceable. Giving his opinion as an expert witness on the English common law of passing off in the *MORTON'S* trade mark invalidity appeal at OHIM (as it was then called)⁷, The Rt Hon Professor Sir Robin Jacob noted that, where such a licence exists, "the business under the mark is in substance and reality conducted by the licensee. It is he who the public, rightly, looks to and relies upon." Although Jacob was giving his opinion in respect of unregistered rights, he also addressed the issue of "bare" licences of registered trade marks, quoting from GE⁸:

"...the principle must be the same whether the mark is registered or not. The really important point is that the public should recognise that the symbol or word in question is being used as a trade mark by someone who is responsible for the product being what it is and having the quality which it in fact has. Provided such responsibility continues to exist and the mark continues to be recognised as indicating such existence, it remains a good mark. This is why it is important that proprietors of trade marks should retain adequate control over the quality of their product and should by careful advertising and use of their marks ensure that the public do not attribute to marks meanings which lead to confusion."



How much authority or control must be exercised by a right holder will likely depend on a variety of factors, including the nature of the business and customer expectations. The risk of being deemed to have granted a “bare” licence to fans to use trade marks is something that original creators should be wary to avoid. It is interesting that, by implication, Funimation sought to use copyright as an additional lever to obtain compliance from fans in respect of trade marks where it might otherwise have had limited ability to enforce its trade marks in their own right (for example, when used referentially within a work of fan art and not to indicate the origin of the fan art). This is an indication of how seriously Funimation takes its trade mark rights. On the flip side, giving its fans a green light to create fan art that is copyright infringing and non-commercial (albeit that sales may occur in artists’ alley areas), shows how seriously Funimation also regards its fans.

FAIR USE/DEALING

However, not all original creators have taken the same approach, and, in response, some conventions have begun limiting the amount of fan art that can be sold to a specified percentage of a vendor’s merchandise, or else have banned it altogether, presumably on the grounds that the copyright infringement is unacceptable to the rights holder. This is potentially an overreaction given that, in the US, users of copyright works may cite the “fair use” defence under US law (17 US Code § 107).

In the UK, the arguably more limited doctrine of “fair dealing” provides an exception to infringement of copyright⁹ and may apply where the purposes for copying are non-commercial research, private study, criticism, review, reporting current events¹⁰ (all with sufficient

acknowledgement), parody, caricature and pastiche.

The relatively new parody, caricature and pastiche exceptions may give fans greater freedom to use copyright works, although considerations of fair dealing will most likely take into account whether fan art is in some way unfairly encroaching on the market for the original work. As such, any commercial exploitation of a derivative work should be considered a potentially actionable infringement.

20th Century Fox Television managed to alienate fans of the *Firefly* television programme by insisting on its rights. One of the programme’s characters, Jayne Cobb, sports a distinctive yellow and orange hat during one of the episodes. The hat quickly became an unofficial “badge of allegiance” for the show’s fan community, with homemade hats available to buy on online marketplaces such as eBay and Etsy. That the hats were homemade was particularly relevant to the fanbase, as the character’s mother in the programme had knitted the hat. The hat in question made a brief appearance in one episode of the show and it wasn’t until the wearing of the hat went viral that Fox sought to commercially exploit it by granting a licence in 2012 to online retailer Ripple Junction to sell “Jayne’s hat”. Reportedly, Fox subsequently began to send cease-and-desist notices to unlicensed sellers (although what specific rights were invoked is unclear).

The move faced widespread criticism from the fan community, and some commentators have

questioned the wisdom of generating such ill will among an otherwise dedicated fanbase. It is interesting to note that the commentary from the fan forums suggests that sellers marketing the hat as “Jayne’s hat” attracted letters of complaint, but those heavily hinting at its inspiration but refraining from the use of the name of the character did not (despite making money from the sales).

It is interesting therefore that Funimation has sought to balance its interests with those of fans while potentially achieving more wide-reaching compliance in respect of trade mark matters than it might otherwise have obtained (or even been entitled to obtain) by force. With the effect of these two opposing strategies in mind, brand owners might want to consider adopting Funimation’s approach or a similarly creative enforcement strategy in addressing their fan-art concerns. ■

- 1) bit.ly/1KFjZxt
- 2) An area in a convention where fans can exhibit and sell their fan art.
- 3) Spaces at conventions where commercial exploitation of derivative works occurs, including the sale of officially licensed merchandise.
- 4) *Sweetheart Plastics, Inc v Detroit Forming, Inc*, 743 F2d 1039, 1047 (4th Cir 1984).
- 5) *Wallpaper Mfrs Ltd v Crown Wallcovering Corp*, 680 F2d 755, 766 (CCPA 1982).
- 6) 639 F3d 788 (7th Cir 2011).
- 7) Appeal No R 46/2014-1 by Morton’s the Restaurant Ltd against declaration of invalidity (6261C) of Community Trade Mark No 3951291 for the mark MORTON’S in classes 29, 30 and 43 in the name of Morton’s of Chicago, Inc.
- 8) *General Electric Co v General Electric Co Ltd* [1969] RPC 418.
- 9) Copyright Designs and Patents Act 1988, Chapter III
- 10) Except for photographs.



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The 8 MINUTES THAT MATTER



Bob Boad knows how to make your crucial interview moments count

According to a survey conducted by insurance company AXA, potential employers reach a decision about a candidate after just eight minutes. Maintaining eye contact was the factor most highly rated as creating a positive impression, scoring slightly higher even than knowledge of the relevant subject. The survey also revealed the factors that can create a bad impression, with swearing and scruffy clothes leading the list of negatives, followed by lack of knowledge of the relevant subject, appearing unprepared and body odour.

So, heed these survey findings of course. But there is plenty more that you can do to help make yourself a stand-out candidate.

SPEND TIME ON RECONNAISSANCE

If you are going for an in-house position, start your research with the company's website, but also conduct wider investigations to discover what the important issues are for the company and its business sector. If the company is a business that interfaces with the public, visit one of its outlets; if it is a manufacturer, familiarise yourself with its products so that you can speak confidently about its commercial reality.

If the position is in private practice, research the firm, its key clients and what makes it different from its competitors. Via trusted personal contacts in the profession, you may even be able to discover how current

and former employees feel about working there. If you can find out who is likely to be involved in the interview, it will help you prepare for their personal preferences and style.

Whatever the firm, try to find out how members of the team you hope to join engage with the wider profession. See what articles existing staff have published or whether they blog, and find out what presentations they have made at conferences. Search out any important IP cases that they have been involved in during the past few years. These can all provide clues as to which issues the team sees as being important, or where it has particular expertise or experience. If the team has supplied committee members,

examiners or tutors for relevant professional bodies, then your own participation in such activity or other training may play well with the interviewer.

KNOW YOURSELF

Be clear about what you are looking to achieve in your career, both in the long term and more immediately in your next position, as well as what you are able to offer your next employer in return.

Don't be surprised to be confronted by several interviewers. It is quite common for a panel of three or four people, each with their own perspective on the recruitment decision, to be involved. Make a note of their names as they are introduced to you and try to address them by name when responding to each of their questions.

Be prepared for the predictable but important questions: "Why do you want to work here?" and "What can you bring to the role that other candidates cannot?" Be prepared to explain what makes a good team player or team leader and, however tempting it may be, resist criticising your existing manager or colleagues. Watch out for a prompt along the lines of, "Tell us about your weaknesses", and have an answer ready – one that is not too damaging.

You will sound much more credible and convincing if you can demonstrate that you have thought carefully about whether you will be an ideal fit for the role and how you can add value for the organisation. It is also important that you have a clear plan for your personal career development and you are able to show how this job fits with that.

KNOW YOUR BUSINESS

There are likely to be questions designed to check that you are keeping up to speed with key developments in the field, and establish the extent of your experience and competency. Refresh yourself on recent high-profile cases and the hot issues in the relevant sector of IP law.

Some of the questions are intended to test skills that may be required in

the role. So, for example, if negotiating settlements is an important element, you may be asked to try to sell the interviewer an everyday object that is in the room.

EXPECT THE UNEXPECTED

Brace yourself for the unexpected questions, aimed at finding out if you can react well to an unforeseen event and think laterally or imaginatively.

Networking with those who have previously been through the interview process may provide a clue to the sort of unlikely question that an individual or organisation likes to fire at candidates. If you aren't lucky enough to know someone who's been through the process, listen carefully to what is being asked and take your time in answering. If necessary, ask the interviewer to restate the question to buy yourself a little time to work out what might lie behind it. Try not to be too flippant or cocky in your answer, but a little humour or originality may be well received.

POLICE YOUR PROFILE

These days, you should also expect that potential employers will check you out using searches of the internet and social media. Hopefully, you have been careful about what you have posted online, but if there is anything that may now embarrass you, it is worth exploring whether it is possible to get it removed. Guidance on how to tackle this is available online and may also be covered in the terms and conditions of the relevant site or media operator.

BRING IDEAS TO THE TABLE

Don't be surprised if you are asked to suggest ways in which your potential employer might improve. If you have been thorough in doing your homework you may well have a few ideas or have spotted potential

opportunities. For example, some years ago we had a candidate for an in-house position who impressed the interviewer by mentioning that, as well as looking at the corporate website, he had been familiarising himself with the company's trade mark portfolio using the UK IPO online search facility. He had noticed that it had a number of single-class registrations of an important mark that would soon be due for renewal and which, under the current legislation, could have been merged into a single registration to significantly reduce the renewal fees. This demonstrated initiative, creative thinking and an awareness of the importance employers place on receiving ideas that may help to reduce costs or drive revenue, helping to make him stand out from other candidates.

QUESTION THE QUESTIONER

In most interviews, you will be asked if there is anything that you would like to ask the interviewer. Make sure that you have at least one intelligent question to ask. However, do take care to avoid anything that might be considered insensitive or could cause embarrassment for the interviewer if they do not know the answer but feel they ought to.

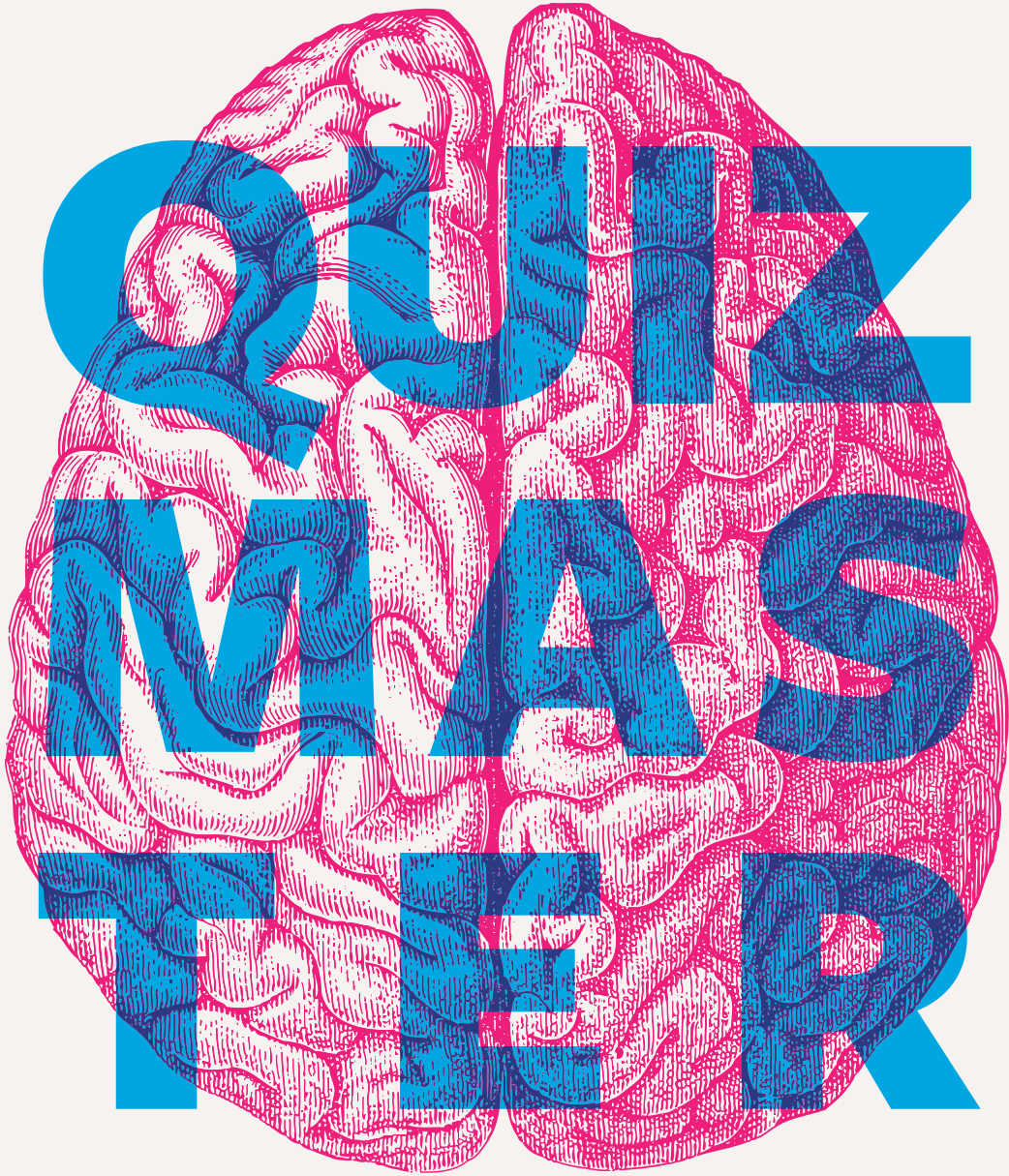
KEEP YOUR COOL

At the end of the session, thank the interviewers for considering you but do not prolong the discussions unnecessarily. If afterwards you think of a better answer to a particular question and consider contacting the interviewer to pass this on, don't – unless they specifically invite you to do so. Relax, and remember the other candidates will feel the same, and that the interviewer will have taken account of interview nerves and will have been grateful for succinct answers, not lengthy learned opinions. ■



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*Sarah McPoland turns the tables on survey specialist
Philip Malivoire to get the latest thinking on this
controversial category of evidence*

Q: The Interflora decisions (see panel, right) were reported as an end to survey evidence being allowed in UK courts. What has the actual impact been on survey evidence and witness selection?

A: Witness selection has been on its way out for a while. It was fine in 2010 in *Henry Hoover*¹ but not in many cases since then, although in *Scrabble*² the Judge seemed to suggest he would have liked to see witnesses.

As for surveys, I have been instructed on the following numbers of survey matters per year over the past four years: 2013 – 12; 2014 – 6; 2015 – 3; and 2016 – 3.

This may show a trend, but it is difficult to determine, as there tends to be cycles in demand. In reading through recent cases, there does not appear to have been many that would have demanded a survey.

Although Enterprise³ confirms that the same test applies regardless of whether survey evidence aims to show confusion or distinctiveness, have you seen any difference in demand in relation to these issues?

As there is only a small number of cases in which this would apply, it is difficult to pick up on trends. Looking at cases such as *Enterprise* and *CRISTAL*⁴ – both distinctiveness cases – and then examples such as *Scrabble*, *SkyDrive*⁵ and *ASOS*⁶ – confusion/deception cases – it may be harder for judges to know if distinctiveness is achieved. It is not as binary as something such as confusion/deception, where judges may see themselves as the consumer.

From a marketer's perspective, what is the difference between a reputation survey and a confusion/association survey? To what extent is a different approach required?

On a certain level, there is very little difference, as you are exposing a group of people to some sort of stimulus and then asking some often broadly similar questions. The key difference is the selection of people if there is a requirement that we give no indication of the nature of the survey. Completing a survey without a recruitment



IN SHORT: SURVEY EVIDENCE IN THE UK

Justice Whitford set out the guidelines for survey evidence in the UK in *Imperial Group plc v Philip Morris Ltd* [1984] RPC 293. In summary these are:

- the interviewees must be selected so as to represent a relevant cross-section of the public;
- the survey size must be statistically significant;
- the survey must be conducted fairly;
- all survey details must be disclosed, including the number carried out, how they were conducted and the totality of the persons involved;
- the totality of the answers given must be disclosed and made available to the defendant;
- questions must not be leading, nor should they lead the person answering into a field of speculation they would never have embarked upon had the question not been put;
- the exact answers (do not use an abbreviated form) must be recorded;
- instructions given to interviewers as to how to carry out the survey must be disclosed; and
- where the answers are coded for computer input, the coding instructions must be disclosed.

In the period between the above criteria being set out and the *Interflora* decisions, it was not unusual for survey evidence to be used in trials, but often via pilot surveys and witness-collection programmes, where statements would be taken from a selection of the pilot-survey respondents, rather than full surveys, in order to save costs.

In *Interflora I* (*Marks and Spencer plc v Interflora Inc and another* [2012] EWCA Civ 1501), Lord Justice Lewison at the Court of Appeal said that survey evidence should only be allowed if the judge is “(a) satisfied that it would be valuable and (b) that the likely utility of the evidence justifies the costs involved”. In *Interflora II* (*Interflora Inc and another v Marks and Spencer plc* [2013] EWCA Civ 319), the Court of Appeal reiterated the points from *Interflora I* and emphasised that, for survey evidence to be allowed, it has to be of “real value”.

Interflora applied to survey evidence regarding likelihood of confusion. However, in *Enterprise Holdings Inc v Europcar Group UK Ltd and another* [2014] EWHC 2498 (Ch), it was decided that the same test applies in relation to distinctiveness.

question causes waste, but it can give purer results. In Enterprise, it was done both ways – with a prior recruitment question and with a qualifying question later on, rather than prior to the initial question. In cross-examination, Mr Justice Arnold seemed more interested in those that knew the subject matter before answering the questions.

Are you noticing a difference in the amount of surveys accepted for EU cases, at EUIPO and in the courts, in comparison with the UK?

I am usually instructed on two to three EU cases per year, and this seems to be unaffected by anything, with the exception of Brexit. At EU level, courts are more prepared to accept online surveys, which are much less expensive. Last year, I undertook online surveys in eight different countries for one case.

Where survey evidence is accepted, are judges or hearing officers relying more on raw data?

It varies enormously. I usually provide the court or hearing officers with a spreadsheet of all questions and answers, and a witness statement along with an overview. In most cases, the answers have been cited in a broad-brush way, examples being Fage⁷, ASOS and CRISTAL. In KIT KAT⁸, the Hearing Officer went through all the raw data, but that is the only case that I have been involved in where that happened.

Are pilot surveys being conducted more as an application to adduce survey evidence than as a way of selecting witnesses?

As I mentioned earlier, witness selection seems to be a thing of a past, but I wouldn't say pilot surveys were just used for selecting witnesses. I would say that pilots are used to help establish whether it is worth going to the time and trouble of a full survey.

Justice Lewison in Interflora⁹ was down on witness collection. On a micro level, I think that was justified, as this case was looking at uncharted territory

If the case is about the public being misled or deceived, it seems appropriate that the public should be part of the justice process

with Google results, and there was some experimentation with different questions. And, of course, it was just a pilot with a very small sample size. Also, a lot of the comments in Interflora were directed at witness finessing. I believe that witnesses obtained from a well-crafted, full survey with a good sample size would counter many of the criticisms mentioned in Interflora. In cases like Associated Newspapers¹⁰, witness collection was deemed acceptable, and seeing the witnesses give evidence was very interesting.

Do you often have clients come to you to do a full survey when they have done their own pilot survey? If so, what are the common mistakes made by non-experts?

Yes, but fewer and fewer. Some lawyers show a survey to the secretaries in their office as a pilot. You see fewer trainees interviewing people in the street these days.

In terms of common mistakes, if lawyers or their trainees do a pilot survey, they often know too much about the case and can influence the answers where a trained interviewer would not. In addition, an expert drafting the questions is more likely to be aware of points of criticism. As well as conducting surveys myself, I am also instructed to review and criticise the surveys conducted by others. In the Fage case, I criticised the recruitment question and it was held to be a valid criticism. I think that could have been avoided if an expert had been involved from the start.



Is there any merit in an omnibus survey, for example one that includes questions for several separate surveys?

EUIPO still seems to be happy with omnibus surveys, but they don't

have merit in the UK. They have been superseded. Omnibus surveys are conducted for speed, and you don't get the opportunity to brief the interviewer.

Cost is a critical factor in the court's decision to allow such evidence.

What can litigants do to reduce the cost of survey evidence but ensure it remains statistically significant?

The cost of the survey itself is a small part of the overall survey costs. A much larger part of the costs would be rebutting and anticipating the criticism of the survey. There could be more proportionate ways to criticise a survey. In some instances, people argue the direct opposite at different points of a survey, and sometimes the same points can come in for criticism twice: at the application stage and at full survey. In the ASOS case, somebody was sent down to be interviewed and criticised the interviewer, specifying a couple of very trivial departures from the script. Time and money was spent with that statement and for me to consider a response. Getting the experts together to discuss things and trying to keep costs down by only criticising the points that have substance would be an option, or you could get a court-approved expert. I do think if the case is about the public being misled or deceived, it seems appropriate that the public should be part of the justice process.

How narrow or broad would you consider a cross-section of the relevant public to be? For example, if you have a matter specifically



GERMANY'S THREE-STEP TECHNIQUE

The test set out as part of the examination rules of the German Trade Mark Office (*Deutsches Patent-und Markenamt*) is:

Step 1 – Do you know sign X in relation to good Y?

Step 2 – Do goods with sign X derive only from undertaking or from different ones?

Step 3 – What is the name of the undertaking?

The questions act as a filtering mechanism. Only positive answers move the interviewee to the next stage.

involving tea, do you include only the participants who said that they drink tea, or those that said that they drink hot beverages?

It would need to be done on a case-by-case basis, as some cases would need a tighter survey. To address your example, narrowing to tea drinkers could be finessing the sample too much, but it may be the right thing to do. The extent of protection sought can help determine this. Sitting down with the lawyers involved and discussing the benefits and drawbacks of a qualifying question is the only way to proceed.

How do you ask the participants if they are tea drinkers without making the survey appear leading?

The recruitment question is important. The Scrabble case seemed to be doomed from the moment of the recruitment question being prepared. In your example, you could mask or obscure tea by putting it in with, say, eight other beverages and asking which is consumed, but you cannot reject the possibility that people could link subsequent questions with tea. One difficulty I remember was in the 1991 Gucci case¹¹ when a long list of designer brands was given and, on cross-examination, there were questions as to why certain other designer brands were not included in the list.

What would you consider to be a sufficient survey size?

Interflora has brought about a statistical re-emphasis. A sample size of 500 had not previously attracted

criticism, but after Interflora larger samples were demanded. For example, during the design stage in the ASOS case, 500 interviews had been agreed, but Interflora came out before interviewing and a larger sample was requested. With a survey result of 25 per cent, the margin of error for a sample size of 500 is +/- four per cent, and for a sample size of 1,000 the margin of error is +/- three per cent, so a sample size from 500 to 1,000 does not seem proportionate to me. However, as 1,000 is the current vogue, it seems no client is going to want to test this by doing less. In the old days, you almost only ever increased the sample size to generate sufficient numbers of witnesses if needed.

How can you prevent participants speculating? Do you have to discount speculative answers?

You can ask them very direct questions, but I understand why that is not acceptable. An open question can encourage speculation and some people do guess answers, but in the main I believe that people answer questions straightforwardly. Sometimes you only know if they understand what you are asking with later questions. When I

analyse results, I often give those that say “I think” or “perhaps” less weight.

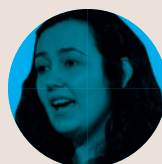
What do you see as the main differences between the so-called “three-step” survey technique used in Germany [see panel, left] and the EUIPO and UK approach?

I don't really like the three-step test. It seems more leading, and showing brand recognition seems to be the name of the game. The 50 per cent benchmark for recognition accepted by most courts seems to be arbitrary and I understand the interviewers can keep trying if they don't reach that. I believe that surveys can provide helpful evidence among other evidence and are not a binary pass-or-fail test.

Do you think Brexit will have any impact on the acceptance of survey evidence in the UK?

I can't see it affecting the UK, but I fear the EU work may end up being run out of other offices and not the UK. ■

- 1) Numatic International Ltd v Qualtex (UK) Ltd [2010] EWHC 1237 (Ch).
- 2) JW Spear & Sons Ltd and another v Zynga Inc [2013] EWHC 3348 (Ch).
- 3) Enterprise Holdings Inc v Europcar Group UK Ltd and another [2014] EWHC 2498 (Ch).
- 4) Roederer v J Garcia Carrion SA and others [2015] EWHC 2760 (Ch).
- 5) British Sky Broadcasting Group plc and others v Microsoft Corporation and another [2013] EWHC 1826 (Ch).
- 6) Assos of Switzerland SA v ASOS plc [2013] EWHC 2831 (Ch).
- 7) Fage UK Ltd and another v Chobani UK Ltd and another [2014] EWCA Civ 5.
- 8) Soci  t   Des Produits Nestl   SA v Cadbury UK Ltd [2013] ETMR 25.
- 9) Marks and Spencer plc v Interflora Inc and another [2012] EWCA Civ 1501.
- 10) Associated Newspapers Ltd and another v Express Newspapers [2003] EWHC 1322 (Ch).
- 11) Guccio Gucci v Paulo Gucci [1991] FSR 81.



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CLIMB AFTER CLIMB?

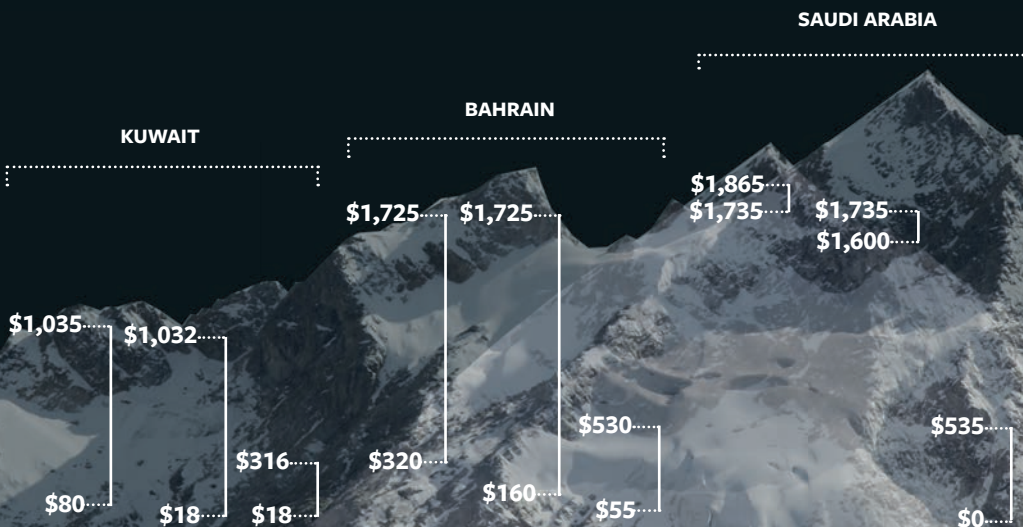
Are fee rises inevitable as a new trade mark law rolls out? Rob Deans finds out

The Gulf Cooperation Council (GCC) Trade Mark Law is a unified law dealing with the protection, enforcement and commercialisation of trade marks across each of the GCC Member States: Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and the United Arab Emirates (UAE). To date, the GCC Trade Mark Law has been enacted in Kuwait and Bahrain, with Saudi Arabia set to follow shortly. With substantial increases in official fees accompanying the introduction of the law in Kuwait and Bahrain, are increased official fees inevitable when the law is introduced in the remainder of the participating countries? And why?

THE STORY SO FAR

Kuwait was the first to implement the GCC Trade Mark Law on 28 December 2015. At the same time, it introduced across-the-board increases to the official fees payable to the Kuwaiti Trade Mark Office; for example, the charges for:

- registering a trade mark (from filing through to registration) increased from approximately \$80 to \$1,035 (an increase of 1,200 per cent);



- renewing a trade mark registration increased from \$18 to approximately \$1,032 (an increase of 5,600 per cent); and
- opposing a trade mark increased from \$18 to approximately \$316 (an increase of 1,600 per cent).

On 29 May 2016, Bahrain

implemented the GCC Trade Mark Law, and this was also accompanied by increases in the official fees charged by the Bahrain Trade Mark Office. For example, the charges for:

- registering a trade mark (from filing through to registration) increased from \$320 to \$1,725 (an increase of 440 per cent);
- renewing a trade mark registration increased from \$160 to \$1,725 (an increase of 980 per cent); and
- opposing a trade mark increased from \$55 to \$530 (an increase of 860 per cent).

These very significant increases have led to speculation that further rate hikes are on the way when the GCC Trade Mark Law rolls out completely.

And the above summary only covers very recent history. In fact, trade mark offices in GCC countries have traditionally charged high official fees compared with their counterparts outside the region, and these fees have been increasing.

Since 2010, all of the GCC countries except Oman and Qatar have increased their official fees for filing and registering trade marks. The official fee for registering a trade mark (from filing through to registration) now exceeds \$1,000 in each of the GCC countries except Oman and Qatar.

DESIRE TO DIVERSIFY

Looking at the broader economic perspective can help us understand the context in which these high fees exist.

In many countries, government departments operate under a mandate to cover their costs on a stand-alone and non-profit basis. On this basis, creating a surplus can be a problem, and this has resulted in official fees being decreased by some trade mark offices in order to avoid excessive surpluses building up.

The GCC states have operated on a virtually tax-free basis for decades, with governments using a variety of other means to generate revenue. The

generation of a surplus by a government department is far from a problem – it is a positive contribution to government revenues.

With oil prices high, the diversification of government revenues has not been a high priority for some of the GCC countries. There have been long-standing discussions on the diversification of government revenues through the introduction of taxes. However, while revenues remained strong, there was no real pressure to move these discussions forward.

Now, with oil prices lower than they have been for years, these discussions seem to have made progress, with the introduction of a GCC sales tax reported to be planned for 2018.

It may be coincidental that the GCC Trade Mark Law is in the process of being implemented at the same time that a decision has been reached to introduce a sales tax across the region. However, this coincidence does highlight that the diversification of government revenues is very much a high-priority topic in the region at the moment, and that this is set to continue.

It is therefore of little surprise that fee increases accompanied the implementation of the new law in Bahrain and Kuwait, and we can expect each of the GCC Member States to review their official fees as they implement the law in turn.

SAUDI EXPECTATIONS

The GCC Trade Mark Law is a unified law. It is founded on the principle of consistency – with the same law being in place in all six GCC Member States.

However, this principle of consistency is subject to an exception when it comes to the fixing of official fees. The very last provision of the Implementing Regulations to the GCC Trade Mark Law (Article 40) provides each Member State with the discretion to determine whatever official fees it

wishes to charge under the law.

Accordingly, although Kuwait and Bahrain have introduced substantial increases in official fees when implementing the law, there was no obligation on them to do so.

It appears likely that Saudi Arabia will be the next to implement the GCC Trade Mark Law. On 1 July 2016, the law and its Implementing Regulations were published in the Saudi Arabian *Official Gazette* and they are expected to be in force within a few months. The official fees published in Saudi Arabia do not show an across-the-board increase; instead, this is more of a mixed bag, with, for example, the charges for:

- registering a trade mark (from filing through to registration) decreasing from \$1,865 to \$1,735 (a decrease of seven per cent);
- renewing a trade mark registration increasing from \$1,600 to \$1,735 (an increase of eight per cent); and
- opposing a trade mark increasing from zero to \$535.

Putting this into context, the official fees in Saudi Arabia were already some of the highest in the region. It is therefore perhaps not surprising that Saudi Arabia may not see the need to increase its fees to the same extent as Kuwait and Bahrain.

This is, however, encouraging as we await the implementation of the GCC Trade Mark Law in each of Oman, Qatar and the UAE.

It is also worth bearing in mind that the purpose of introducing a tax regime is, of course, to diversify government revenues so that they are less reliant on income from oil and gas. Whether in the medium term this also takes pressure off individual government departments to raise revenue remains to be seen.

However, it is certainly possible that we are currently witnessing a peak in official fees in the GCC countries and that, over time, they will fall to levels that are more in line with countries outside the region. ■



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WIDE OF THE MARK



IN LIGHT OF SKYSCAPE, **ROBERT BUCHAN**
WARNS OF DEPENDING ON TOO BROAD
A SCOPE WHEN EMPLOYING A DNI

When making an application for a declaration of non-infringement (DNI), how likely is the court to approach the question of who the “average consumer” is when assessing likelihood of confusion? What are the primary tests to be considered? And what difficulties might business owners face when trying to challenge a well-known mark?

The June 2016 case of *Skyscape Cloud Services Ltd v Sky plc* and others¹ provides a useful reminder and a cautionary tale relevant to all of these points – and can teach practitioners some of the strategic points to consider when advising clients on a DNI or defending one.

CASE IN SUMMARY

The Claimant in the case, *Skyscape Cloud Services Ltd* (*Skyscape*) provides cloud-computing services to UK public-sector organisations. The claim was defended by *Sky plc* and other entities holding trade marks within the *Sky* group (*Sky*). *Sky* is a well-known provider of a number of satellite and digital services, including broadcasting.

Sky had been in correspondence with *Skyscape* in relation to its use of the *Skyscape* name in connection with online and digital services, which *Sky* claimed infringed various marks it owned. In support of its claims, *Sky* cited the decision in its favour against *Microsoft* in relation to the latter’s use of the term “*SkyDrive*” in relation to cloud-computing services in *British Sky Broadcasting Group plc v Microsoft Corporation*.²

Skyscape declined to give the undertakings sought by *Sky* and took the tactical decision to apply for a DNI

that its *Skyscape* sign did not infringe *Sky*’s trade marks.

In assessing whether to grant *Skyscape*’s application, the Court considered the burden to be satisfied by a party seeking a DNI. His Honour Judge Hacon began by making reference to the six criteria to be satisfied to establish infringement under Article 5(1)(b) of EU Directive 2008/95/EC:

1. there must be use of a sign by a third party within the relevant territory;
2. the use must be in the course of trade;
3. it must be without the consent of the proprietor;
4. it must be of a sign that is identical with or similar to the trade mark;
5. it must be in relation to goods or services that are identical with or similar to those for which the trade mark is registered; and
6. it must give rise to a likelihood of confusion.

The first three criteria were not disputed. The Court went on to make clear, with reference to the decision in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation*³ and *JW Spear & Sons Ltd v Zynga Inc*⁴, that the threshold requirement for both criteria four and five is low. There needs to be at least some faint similarity between the mark and sign. Crucially, in the case of a DNI, the burden is reversed and becomes a heavy one for the claimant, who must establish that there is not even some faint similarity between its sign and the mark or marks in suit.

On the sixth criterion, in considering the likelihood of confusion, the Court examined the “average consumer” of *Skyscape*’s services. It then dismissed the application, essentially agreeing there was a likelihood of confusion.

In assessing the marks, the Court referred to three key principles

identified in *Nokia Corp v InterDigital Corp*⁵: (i) the decision to grant a DNI is a question of discretion rather than jurisdiction; (ii) the DNI needs to have a “useful purpose”; and (iii) the underlying issue must be sufficiently clearly defined to render it properly justiciable.

In the *Skyscape* case, the Court found that the first two principles were satisfied but that *Skyscape*’s DNI was drafted too widely to satisfy the third principle. The Court found that *Sky* only had to prove one claimed use (of the many put forward by *Skyscape*) would be infringing, and it was invited to put forward its “best case”. As a result, *Skyscape* was required to put forward its case for non-infringement against *Sky*’s best case, deemed to be *Sky*’s use of its mark in connection with the provision of email services.

It is vitally important when making an application for a DNI that it is properly scoped and narrowly defined. The list of uses should be exhaustive and unambiguous in order to allow the court to decide the issue with sufficient clarity to make it properly justiciable.

CONSUMER WAS CRUCIAL

In assessing the question of whether the *Skyscape* sign would infringe *Sky*’s marks, the Court first had to define who the average consumer of cloud-based services was.

Skyscape argued that the average consumer for its goods/services for the purposes of assessing likelihood of confusion is someone carrying out a role within the UK public sector. It also argued that it would be inevitable that such a person would be aware of *Sky* as a trade mark, at least in relation to its core services, such as television.

Skyscape’s argument was that its services are accessed by those working in the UK public sector via a portal

known as the “G-Cloud”, a digital marketplace for public bodies that Skyscape claimed was only accessible by civil servants. Skyscape argued that since its typical customer is a “well-informed and careful civil servant ... generally spending a substantial amount of money ... a very high level of care will be expended in making the appropriate choice of service provider”. Although the Court agreed with the evidence, it disagreed with Skyscape’s assessment of the average consumer.

CONCLUSIONS

At paragraph 81 of the judgment, Hacon J made clear that the average consumer for the purposes of likelihood of confusion is a person who is “employed by or otherwise carries out a role in a small public entity such as a nursery school, a church or a social club, that role including the arrangement of an email account ... He or she is aware that Sky is a very well-known mark for TV and other core services.” Significant to the Court’s conclusion was the fact that Skyscape’s DNI made reference to a very wide range of public authorities. The Court decided that public-sector entities can be very small and would be unlikely to have an IT expert or department; and no evidence was provided to suggest that there are public-sector entities that do not procure their cloud digital services through the G-Cloud online portal. The Judge stated that the “key event in the hypothesis is that the average consumer encounters the use of the ‘Skyscape’ sign for email services”.

Hacon J concluded the average consumer for the purposes of likelihood of confusion to be someone with knowledge of IT who is also aware of the UK Government cloud-services marketplace. This definition was much broader than the definition upon which Skyscape had tried to rely.

Three clear issues arise from the court’s decision in *Skyscape v Sky* that advisers should consider when raising or defending a DNI.

“
*It is important
when making an
application for
a DNI that it is
properly scoped and
narrowly defined*”



LESSONS LEARNED

First, following the *SkyDrive* decision in favour of Sky against Microsoft, this case serves as another example of the strength of Sky’s marks in the online space. It is a cautionary tale for providers in the cloud-services market that are looking to use or incorporate the word “Sky” into any of their goods or services. The decision also affirms the breadth of protection that is afforded to well-known trade marks when properly applying the test for likelihood of confusion and the reversed burden of proof.

Second, parties should be very careful in their attempts to define the “average consumer” of their products and services when assessing the likelihood of confusion for the purposes of a DNI.

Skyscape sought to present a narrow definition of the average consumer as someone who would be relatively well informed and circumspect in relation to procuring services for public bodies. However, its DNI made reference to a wide range of public-sector organisations that could use the

services it offered. This led to the conclusion that the average consumer was not so narrowly defined.

THE COURT’S APPROACH

While it is understandable that a claimant may wish to present as narrow a scope as possible of the average consumer to minimise the risk of infringement, it should be mindful of the Court’s approach in this case. It demonstrates that a court can prefer a much wider definition based on what is set out in the DNI about who may purchase the relevant goods or services. Finally, the case reinforces the importance of clearly specifying the DNI order you require when coming to court, and the not insignificant challenges a claimant will encounter when attempting to convince the court there is no likelihood of confusion between a well-known mark and its own. ■

- 1) [2016] EWHC 1340 (IPEC).
- 2) [2013] EWHC 1826 (Ch).
- 3) [2016] EWCA Civ 41.
- 4) [2013] EWHC 3348 (Ch).
- 5) [2006] EWHC 802 (Pat).



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Tracking Thailand's TMs

Gladys Mirandah provides an update on changes to trade mark law and practice


READERS MAY BE interested to learn of amendments to the Thailand Trademark Act that came into force on 28 July 2016 and reflect the preparation being made for Thailand to join the Madrid Protocol by the end of this year. The amended Act introduced changes to the trade mark registration process, extended marks' protective scope and revised the applicable deadlines and fees (see box below).

Among the most crucial changes is the extension of the time available to oppose or respond to an Office action: from 60 days to 90 days. The time available to pay fees, however, has shrunk to 30 days from 60. Meanwhile, the need to register marks with the same character or which are very similar to one another as associate marks has been abolished.

Termination of licence agreements used to depend on the terms of the agreement; now, they will not be terminated from the transfer or inheritance of the right unless otherwise agreed.

A new addition is a rule related to unauthorised refilling: reusing or refilling packages or containers bearing a trade mark belonging to a third party is prohibited.

When it comes to distinctiveness, marks that contain invented words, numbers, characters and devices that are not directly descriptive of the character or quality of goods/services will be presumed to have inherent distinctiveness. A mark that lacks inherent distinctiveness will be registrable if it has acquired distinctiveness from use in Thailand to the extent that it is well known to the public.

CHANGES	PREVIOUS POSITION	CURRENT POSITION
Partial assignment allowed?	No ✗	Yes ✓
Sound marks registrable?	No ✗	Yes ✓ (if not directly descriptive of the applied goods/services)
Shape marks recognised?	No ✗	Yes ✓
Multiple-class applications allowed?	No ✗	Yes ✓
Renewal grace period	No ✗	Yes ✓ (Post-expiry date, if renewal application is filed within six months of the expiry date; pay an additional 20 per cent of the official fee)
Official fees 	New application: → THB500 per item	New application: → Up to five items = THB1,000/item/class → More than five items = THB9,000/class
	Registration fees: → THB300 per item	Registration fees: → Up to five items = THB600/item/class → More than five items = THB5,400/class
	Renewal fees: → THB1,000 per item	Renewal fees: → Up to five items = THB 2,000/item/class → More than five items = THB 18,000/class



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Take deep breaths...

Désirée Fields calmly tackles the puzzle of Glaxo's colour mark registration

IN A SUMMARY judgment application brought by Sandoz Ltd in its counterclaim for a declaration of invalidity of Glaxo's "two shades of purple" colour trade mark for inhalers, the High Court held that Glaxo's trade mark was invalidly registered. This is because it allowed multiple variations and did not meet the requirements of clarity and precision set out under Article 4 of Regulation (EC) No 207/2009 (EUTMR).

Glaxo owned an EU Trade Mark registration for "inhalers" in class 10. The mark was accompanied by a visual representation of the inhaler and a colour photograph of the product, and was described in the following terms: "The colour dark purple (Pantone code 2587C) applied to a significant proportion of an inhaler, and the colour light purple (Pantone code 2567C) applied to the remainder of the inhaler."

The certificate of registration designated the mark using the internationally agreed Numbers for the Identification of (bibliographic) Data (INID) code number 558. INID is part of a coding system developed by WIPO. INID code 558 means a "mark consisting exclusively of one or several colours".

Glaxo brought infringement proceedings against Sandoz, which applied for summary judgment

dismissing Glaxo's infringement claim and counterclaimed for a declaration of invalidity. Sandoz claimed that the mark did not conform to the requirements of Article 4 EUTMR as it was neither a sign nor capable of being represented graphically.

The CJEU had previously found that a combination of colours may be registered as a trade mark provided that the combination of colours is a sign, and that sign is capable of graphical representation and of distinguishing the goods or services of one undertaking from those of another.

MEETING REQUIREMENTS

The requirement for graphical representation is to define the mark and determine precisely the scope of the protection afforded to its proprietor. Similarly, competitors and other economic operators must be able to acquaint themselves with the marks of their actual or potential competitors. Case law therefore provides that a graphical representation of a mark consisting of two or more colours, designated in the abstract and without contours, must be "systematically arranged by associating the colours concerned in a predetermined and uniform way".

Applications to register colours as trade marks have consistently failed

where the requirements that the mark be a "sign" and "capable of graphical representation" have not been satisfied. For example, the application to register a colour mark described as "Pantone 2685C ... being the predominant colour applied to the whole visible surface, of the packaging of the goods" was successfully opposed. The use of "predominant" opened up such a range of possible permutations of the mark that it was neither a "sign" nor capable of being "graphically represented". Permitting the mark would grant the applicant an unfair competitive advantage.

His Honour Judge Hacon considered that the interpretation of a trade mark application or registration should be conducted through the eyes of the court and not the "average consumer". He took the view that there is no automatic precedence as between the visual representation and description of a mark. However,



where, as in this case, the application or registration is designated with INID code 558, this provides an “inflexible starting point”, and the necessary qualities of clarity, precision and uniformity become particularly important. Accordingly, the mark had to be construed as consisting exclusively of one or several colours, and the Court was required to “do its best” to reconcile the visual representation and the description in the absence of strict congruence. It is clear from the CJEU’s judgments that, in order to satisfy Article 4 EUTMR, a colour mark must be a singular sign; a trade mark cannot exist in various forms.

SOLVING THE PUZZLE

The issue with the mark was that any reader of its description was essentially “set a puzzle”. Reading the words alone, there was something close to a “complete freedom” with regard to the relative proportions of the light and dark purple and how they were presented. While the description of the two Pantone shades was unambiguous, there was ambiguity in the description of the respective proportions of dark and light purple. The three possible solutions to the puzzle were as follows: first, a mark with the outline of the visual representation; second, a freedom of many alternative marks according to the words from the description; and third, a pattern abstracted from the visual representation.

However, only the first solution was capable of being a single sign. Clearly, the second, with the possibility of many permutations,

could not constitute a single sign. Even the abstraction gave rise to the possibility of multiple variations. Overall shape, in this instance, was a key factor, as the mark had to be applied to an inhaler. The mark was therefore not a colour mark in the sense that had been seen previously, where the mark could be adapted without change to any overall shape.

Hacon J concluded that the mark had been invalidly registered as it did not satisfy the requirements of clarity and precision under Article 4 EUTMR.

CONSIDERATIONS

The two likely abstractions of the visual representation (the circular and rectangular marks) could both, in principle, have been registered as trade marks, thereby limiting the possible variations and interpretations of the mark. Similarly, had either or both of the abstractions been registered as trade marks, there would have been greater congruence between the visual representation and the description. Arguably, the abstractions would be sufficient to constitute a “graphical” representation as per EUTMR, so it may not have been so crucial to scrutinise both the visual representation and the description.

Brand owners should therefore carefully consider either adducing additional graphical representations

or registering abstractions of their mark as separate trade marks, alongside the initial filing.

Similarly, brand owners should be cautious about using product photographs as visual representations for anything other than instances where the mark claims a certain form of packaging. In particular, photographs are less appropriate for colour marks, which may not be confined to any specific shape of goods.

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In order to satisfy Article 4 EUTMR, a colour mark must be a singular sign; a trade mark cannot exist in various forms



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Court backs anti-counterfeit tool

George Sevier looks at the latest decision on blocking orders and considers what brand owners must do to obtain one

THE COURT OF APPEAL has upheld the 2014 decision of Mr Justice Arnold, confirming that the UK's leading internet service providers (ISPs) – namely Sky, BT, EE, TalkTalk and Virgin Media – can be ordered to prevent their customers from accessing websites advertising counterfeit (trade mark infringing) goods.

Over the past five years, copyright owners have been able to obtain injunctions ordering the UK's main ISPs to block access to websites that make available copyright-infringing content. So-called “blocking orders” have been an effective tool in the fight against the illegal acquisition of music, films and ebooks.

Richemont, the owner of luxury brands such as Cartier, brought a test case, seeking blocking orders in respect of websites selling counterfeit goods. Arnold J concluded that the High Court had sufficient jurisdiction to make this new type of blocking order. His decision was appealed, but on 6 July 2016 the Court of Appeal overwhelmingly upheld Arnold J's judgment. The Court of Appeal's decision is to be reviewed by the Supreme Court.

THE COURT'S JURISDICTION

Article 3(1) of Directive 2004/48/EC (the Enforcement Directive) requires EU Member States to make available to right holders remedies necessary to combat infringement of IP rights. Article 11 includes a requirement that “rightholders are in a position to apply for an injunction against intermediaries

whose services are used by a third party to infringe an intellectual property right”. The Enforcement Directive was transposed into domestic law; however, there was no specific implementation of this aspect of Article 11.

At first instance, Arnold J had found that specific implementation (into the Trade Marks Act 1994, for example) was not necessary, since the court has jurisdiction to grant such injunctions by virtue of section 37(1) of the Senior Courts Act 1981. Section 37(1) provides that: “The High Court may by order (whether interlocutory or final) grant an injunction ... in all cases in which it appears to be just and convenient to do so.”

On appeal, the ISPs disputed this, including on the basis that they had neither invaded any legal or equitable right vested in Richemont nor behaved in an unconscionable manner, or threatened to do so (as required by old case law). Lord Justice Kitchin, giving the leading judgment in the Court of Appeal, disagreed, saying “that would impose a straightjacket on the court and its ability to exercise its equitable powers which is not warranted by principle.”

COSTS BURDEN

The Court of Appeal (Lord Justice Briggs dissenting) confirmed that the ISPs should bear the cost of implementing blocking orders, while brand owners should bear their own costs of seeking the order, and of monitoring the website for changes following implementation of the block.

The costs burden on the ISPs may be relatively small – in Twentieth Century Fox Film Corporation and others v British Telecommunications plc¹, BT estimated the cost of implementing a blocking order to be in the region of £5,000 per website. However, Richemont said that it had identified more than 200,000 potentially infringing websites, so it is no surprise that the ISPs are reluctant to accept the position that they should bear the costs. This is likely to be a key point of dispute before the Supreme Court.

ESTABLISHED PATH

Unless and until the Supreme Court rules otherwise, it has been established that the High Court has the jurisdiction to order ISPs to block websites offering counterfeit goods. The Court of Appeal has confirmed the factors to be satisfied for a blocking

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ISPs have systems that can block access to individual websites, and it has been shown that blocking injunctions are very effective and dissuasive

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order to be warranted. Brand owners will need to demonstrate that:

- (i) The users or operators of the website are infringing the brand owner's trade mark (for example, by advertising counterfeit goods).
- (ii) The users or operators of the website are using the ISP's services. Showing this in respect of one ISP is likely to be enough – there is an inference that the other main ISPs would be similarly involved, as together they cover 95 per cent of UK broadband users.
- (iii) All the concerned ISPs have been put on notice of their services being used to infringe the trade mark. This is as straightforward as sending a letter.

Assuming those threshold conditions are met, the Court then needs to be satisfied that a blocking injunction would: (i) be necessary; (ii) be effective; (iii) be dissuasive; (iv) not be unnecessarily complicated or costly; (v) avoid barriers to legitimate trade; (vi) be fair and equitable, and strike a “fair balance” between the applicable fundamental rights; (vii) be proportionate; and (viii) be applied in such a manner as to provide safeguards against its abuse.

The regime that has been adopted in relation to blocking copyright-infringing websites has paved the way for many of these conditions to be satisfied. For instance, the ISPs

have systems that can block access to individual websites, and it has been shown that blocking injunctions are very effective and dissuasive. With the exception of proportionality, the conditions are likely to be relatively easy to satisfy in future cases.

PROPORTIONALITY

There are a number of factors that have an impact on the proportionality of granting a blocking injunction. Arnold J considered the key question to be whether the likely costs burden on the ISPs is justified by the likely efficacy of the blocking order and the consequent benefit to the brand owner, having regard to the alternative measures available – such as making domain-name complaints, or asking hosting registrars to take down the websites.

It would assist with demonstrating that a blocking order is proportionate if it can be shown that the activities of counterfeiters cause significant damage to the brand owner, and

that the websites concerned are highly visited. While the costs burden on the ISPs may be relatively small, if a brand owner seeks an order that requires the ISPs to implement the blocks in a way that could increase the burden on them, this could be enough to tip the balance away from an order being proportionate.

WEBSITE WEAPON

Website blocking orders will not be suitable in every case – for instance, the sale of infringing goods via eBay, Amazon or Alibaba is unlikely to justify blocking the public's access to those websites, given that the vast majority of listings are for genuine goods. However, they provide another tool in the fight against counterfeiters, and could dramatically cut the number of visitors to websites touting counterfeit goods. Brand owners will keenly await the decision of the Supreme Court.

1) [2011] EWHC 2714 (Ch).



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Great Scott!

A Hollywood connection played its part in a surprising decision for DeLorean, says Ben Evans

THIS CASE CONCERNED

consolidated opposition and revocation proceedings brought by DeLorean Motor Company of Texas (Texas) against an application for De Lorean/DE LOREAN (a series) in class 12 and an earlier registration for the same mark, also in class 12, both in the name of DeLorean Motor Company Ltd of Stockport (Stockport).

The opposition was brought under Section 5(2) (a) of the Trade Marks Act 1994 (TMA) based on alleged earlier unregistered rights in the De Lorean mark. The revocation application was brought under Sections 46(1) (a) and 46(1) (b) TMA for reasons of non-use.

The Hearing Officer heard from both parties, and found that there had been no genuine use of Stockport's registered mark; thus, it was revoked pursuant to Section 46(1) (a) TMA. At the same time, the Hearing Officer found that Texas had failed to prove protectable goodwill in the UK, and thus rejected the opposition.

APPEAL DETAIL

Both parties appealed, and it fell to Professor Ruth Annand, the Appointed Person (AP), to render a decision.

The AP upheld the Hearing Officer's decision in finding that there had been no genuine use of Stockport's mark. The only uses that Stockport could identify were: (i) various parked domain names containing advertising that, over a six-year period, yielded less than €1 in revenue; (ii) a shared website that appeared to advertise two car parts (sills) as "DeLorean nearside sill" but for which no orders were received, nor sales made; and (iii) an enquiry from a potential supplier.

The Hearing Officer was of the view that none of these examples constituted use of Stockport's class 12 trade mark. The parked domain name was at best a retail or portal service, the car part appeared to be descriptive of parts for DeLorean cars and the enquiry was entirely unrelated.

In dismissing Stockport's appeal, the AP concluded that the Hearing



Texas had failed to demonstrate a protectable goodwill in the UK and, instead, merely had a reputation

Officer was entitled to arrive at the finding she did and that, even if the examples were to constitute use of Stockport's class 12 mark, it was so limited in extent that it could not constitute genuine use.

Texas relied on unregistered rights in certain variations of DE LOREAN (and similar) first used in the UK in 1995 for certain clothing and memorabilia, and

since 1999 in relation to class 12 goods including parts and fittings for motor vehicles. While it had no physical base in the UK, it did have evidence: modest sales to the UK, a website offering goods for sale and marketing in the UK (through attending DeLorean owner events).

The Hearing Officer rejected the opposition, finding that Texas had failed to demonstrate a protectable goodwill in the UK and, instead, merely had a reputation. However, the AP found that this decision was "arrived at in error", and that the niche nature of the DeLorean spare-parts market combined with the accepted reputation of Texas in the UK was sufficient for Texas to demonstrate a protectable goodwill in the UK, even though this reputation was, in part, due to the sale of clothing and memorabilia rather than car parts.

INTERESTING EXTENSION

The AP's decision in upholding the revocation decision is not surprising given the type and extent of use demonstrated by Stockport. What is more interesting is the AP's confirmation that reputation built, at least in part, through the use of a mark on items of clothing and memorabilia can be used to demonstrate a protectable goodwill in that mark for other goods.



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Authorities in agreement

*Stephanie Taylor examines the details
and decisions in an unsuccessful appeal*



THIS CASE WAS an appeal against the decision of the Hearing Officer in respect of opposition No 401219 filed by TWG Tea Company Pte Ltd (the Opponent) against UK TM Application No 3010407 CASABLANCA (the Application) in the name of Mariage Frères, SA (the Applicant).

In the opposition decision, the Hearing Officer rejected the opposition to the Application in respect of goods in classes 21 and 30 (covering tea and tea pots, tea filters and other related accessories) on the basis of Section 5(4) (a) of the Trade Marks Act 1994 and, in particular, the Opponent's earlier rights in the mark WEEKEND IN CASABLANCA used in respect of tea. While the Hearing Officer did agree that the Opponent had rights in the mark WEEKEND IN CASABLANCA prior to the date of the Application, it was found that the Applicant owned rights in the mark CASABLANCA that predated the first use of the mark WEEKEND IN CASABLANCA by the Opponent.

In the Grounds of Appeal, the Opponent challenged the Hearing Officer's finding that the Applicant had prior rights.

THE REVIEW

The Appointed Person reviewed the analysis of the evidence conducted by the Hearing Officer relating to the Opponent's use of the mark WEEKEND IN CASABLANCA since 2009, as well as the Applicant's evidence in support of its earlier use of the mark CASABLANCA since 2006. The Hearing

Officer had concluded that "the Opponent's goodwill ... was, at the relevant date, although extremely modest in terms of volumes of sales, sufficient to be protected under the law of passing off ... Notwithstanding the Opponent's goodwill, the Applicant was the first to use CASABLANCA on the goods concerned and ... had built up [its] own goodwill in respect of tea and tea tins since it was used in the UK as early as 2006." The Hearing Officer therefore determined that the Applicant had established itself as the senior user of the CASABLANCA mark, and the passing off claim by the Opponent was dismissed.

OPPONENT'S ISSUES

In the appeal, the Opponent alleged that the Hearing Officer had failed to address two points: (i) the Opponent's submissions as to what use is capable of constituting earlier use for the purposes of defending a claim of passing off; and (ii) the Opponent's critique of the Applicant's evidence of earlier use.

From the case law used by the Hearing Officer (in particular Roger Maier and another v ASOS plc and another¹), the Appointed Person determined that generation of goodwill

by the Applicant is not required, because it is the Opponent that must show that it had the necessary goodwill to render the Applicant's use actionable on the date it began, although recognising that if the activity by the Applicant ceased or materially changed between the date of first use and the date of Application, then this must be taken into account. On this basis, the Appointed Person determined that the Hearing Officer did not err in law in her assessment.

ULTIMATE DECISION

As for the application to the facts, the Opponent submitted that, even if it was not a requirement to demonstrate goodwill, the evidence of use by the Applicant was merely sporadic and insufficiently continuous to justify that a finding of passing off should be based on anything other than the application date. However, in the absence of an error in law by the Hearing Officer, the Appointed Person did not take a view on this point.

On this basis, the Appointed Person considered that the Hearing Officer had not acted in error and dismissed the appeal.

¹ [2011] EWHC 2714 (Ch).



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Running renewals

Oliver Tidman believes this clarification on timing will be welcomed

THIS WAS AN appeal to the CJEU by Nissan Jidosha KK (Nissan) to have judgment T-572/12 of the EU General Court (GC) set aside, following the GC's refusal to allow Nissan's request for partial renewal of an EU Trade Mark (EUTM) registration.

Nissan had partially renewed its EUTM registration for the figurative mark CVTC (the Mark) in respect of goods in classes 7 and 12. However, EUIPO refused a subsequent request by Nissan to renew class 9 goods.

ANNULMENT APPEAL

The First Board of Appeal (BoA) of EUIPO dismissed Nissan's appeal, finding that its initial, partial renewal request constituted a surrender of the Mark in respect of the class 9 goods. Also, noting that the partial renewal of the Mark had been registered by EUIPO and notified to Nissan (upon which it had been effective *erga omnes*), the BoA found that, for reasons of legal certainty, Nissan could not be allowed to reverse its decision not to renew the Mark in respect of the class 9 goods.

Nissan appealed for annulment of the BoA's decision (case R 2469/2011-1). The GC dismissed this for the same reasons.

Undeterred, Nissan appealed to the CJEU alleging infringement of Articles 47 and 48 of Council Regulation (EC) No 207/2009 (EUTMR) relating to the renewal of EUTMs, maintaining that there was no express wording to preclude such a request.

CJEU JUDGMENT

The CJEU held that partial-renewal requests relating to different goods and services protected by the same EUTM registration can be submitted at different times during the renewal period.

Article 47(3) EUTMR grants the proprietor of an EUTM one year to renew the mark, divided into two six-month periods before and after the last day of the month in which protection ends. The CJEU considered the wording of this particular provision (including in languages other than English) and concluded that neither the division of the period under Article 47(3) into two parts (where the sole difference between the parts was the additional fee payable for requests submitted in the second part as a late renewal), nor the wording or scheme of the provision precluded the submission of successive requests for partial renewal.

The CJEU dismissed arguments that permitting successive requests would lead to lack of legal certainty, noting that EUIPO was not obliged to register a partial renewal until the end of the grace period for renewal.

Accordingly, the CJEU set aside the judgment of the GC and annulled the decision of EUIPO to refuse Nissan's request to renew the class 9 goods. The Court also ordered EUIPO to bear its own costs and to pay those incurred by Nissan, both in relation to the proceedings at first instance and to the appeal.

CONSISTENT DECISION

The CJEU's interpretation is consistent with the general objective of the EUTMR to facilitate the retention of trade mark rights and will be welcomed by brand owners.



The CJEU dismissed arguments that permitting successive requests would lead to lack of legal certainty



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Brussels decision brushed off

Decision shows the limits of res judicata in trade mark matters, writes Daniel Joy

THIS CASE CONCERNED the principle of *res judicata*, and whether infringement decisions from the national trade mark courts should be binding in related opposition matters before EUIPO. *Res judicata* is a legal principle stating that a matter that has been finally decided by a relevant court may not be further contested by the same parties.

Apple and Pear Australia Ltd and Star Fruits Diffusion (the Opponents) opposed Carolus C BVBA's EU Trade Mark (EUTM) application for ENGLISH PINK in class 31, based on prior EU registrations for PINK LADY. EUIPO dismissed the opposition, and the Opponents filed an appeal.

ANNULMENT DECISION

Before the appeal decision was handed down, however, the Opponents successfully brought an infringement action against Carolus's Benelux mark ENGLISH PINK in the Brussels Commercial Court (a competent EUTM court). The Brussels Court annulled Carolus's Benelux mark and ordered that it stop using the mark in the EU.

The Opponents alerted EUIPO to the Brussels Court decision, expecting that it would affect the outcome of the opposition appeal proceedings. However, the EUIPO Fourth Board of Appeal (BoA) rejected the appeal as it considered that the marks were not sufficiently similar.

The Opponents applied to the General Court (GC) seeking annulment or alteration of the BoA's decision on the grounds that, by not taking into consideration the judgment of the Brussels Court: (i) the BoA did

not adhere to the principle of *res judicata*; and (ii) the decision was contrary to the principles of legal certainty. The GC found that the decision of the BoA should be annulled because it did not take account of the Brussels Court's decision. It did not,

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The Appellants appealed, claiming that the General Court 'committed an error of law' in finding that it could not order the alteration

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however, order an alteration to that decision based on the principle of *res judicata*.

The Opponents – now Appellants – appealed, claiming that the GC “committed an error of law” in finding that it could not order the alteration. Furthermore, they argued that the GC failed to give effect to the principle of *res judicata*.

In its findings, the GC acknowledged that there is no provision in Council

Regulation (EC) No 207/2009 (EUTMR) expressly stating that EUIPO is bound by EUTM court decisions in infringement matters. However, the overarching purpose of the EUTMR and the EUTM system is to encourage harmonised protection of rights throughout the EU.

Nonetheless, it is understood that court decisions from Member States – and EUIPO decisions that have become final – can give rise to *res judicata* provided that the proceedings have the same parties, subject matter and causes of action.

In the present matter, the GC accepted that the parties were the same, but found that the subject matter and causes of action were not the same. The matter before the Brussels Court concerned a Benelux mark, whereas the one at issue involved an EUTM for ENGLISH PINK. Therefore, *res judicata* did not apply.

STRICT INTERPRETATION

The appeal was rejected on the basis that the GC did not err in finding that *res judicata* did not require that the BoA be bound by the Brussels Court decision. This shows how strictly *res judicata* is interpreted, but also how opposition and invalidity proceedings are treated as being separate to infringement matters.



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FC Barcelona's late play

Mark Caddle sets out why a common supporter nickname didn't score points with the Court

ON 22 APRIL 2011, Kule LLC (the Applicant) filed an EU Trade Mark application for the word KULE in classes 14, 18 and 25. The application was opposed by Fútbol Club Barcelona (Barcelona) on the basis of its earlier Spanish registrations for CULE in classes 14, 18 and 25. Barcelona also relied on the well-known status of its CULE mark pursuant to Article 6bis of the Paris Convention for the Protection of Industrial Property.

Barcelona was requested to prove use of its earlier registrations as they were more than five years old. *Culé* is a colloquial term used to denote supporters and players of FC Barcelona. In Catalan, *culé* means bottom. Before moving to its behemoth Nou Camp stadium, Barcelona's home ground was much smaller, with many spectators sitting on the stadium's outer walls to witness the action. For those passing the stadium, they were exposed to a continuous line of bottoms. Hence the advent of the *culé* nickname.

INSUFFICIENT EVIDENCE

Barcelona submitted evidence to show genuine use of its marks:

- an extract from a Spanish dictionary defining the term *culé*;
- eight print outs from Spanish sports news websites and a Wikipedia extract referring to Barcelona players and supporters as "*culés*"; and
- a print out of a Google search for the term *culé*, in which two of the suggested links referred to its meaning in an online dictionary and two referred to Barcelona.

Barcelona filed some of the news print outs and its Google search

documents outside the time limit set by EUIPO for it to substantiate its opposition.

The Opposition Division rejected Barcelona's opposition due to the above evidence not being sufficient to demonstrate genuine use of the earlier CULE trade mark. The Board of Appeal (BoA) agreed.

APPEAL BASES

The first plea related to the BoA's finding that the documents produced out of time could not be relied upon. The General Court (GC) confirmed that EUIPO has a wide discretion to consider evidence that is filed out of time. In this instance, it was held to have exercised its discretion effectively, as the late-filed documents did not provide any information concerning the place, time or extent of the use of the earlier trade marks and were, therefore, likely to be irrelevant.

The second plea focused on the sufficiency of the evidence submitted to support the genuine-use claim. The GC agreed with the BoA's conclusion that the evidence submitted did not show genuine use of the CULE trade mark in connection with the goods registered. The evidence provided by Barcelona demonstrated that the Spanish term *culé* is used as a nickname of its supporters or players and is not a guarantee of origin of



Barcelona's shortcomings were due to its not using culé in a manner consistent with that prescribed by trade mark law

particular goods offered by Barcelona. As genuine use could not be established, Barcelona's well-known mark claim also fell.

SHORTCOMINGS

Barcelona's shortcomings were due to its not using *culé* in a manner consistent with that prescribed by trade mark law. There could be no genuine use of CULE as it had not been used by the club to denote particular products. Barcelona's chances of success may have been increased had it utilised this brand in merchandising, for example. Also, although EUIPO has discretion to admit late-filed evidence, it is best practice to ensure deadlines are adhered to, which will avoid any risk of the dismissal of evidence.



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Character reference

Angela Thornton-Jackson reviews the Court's decision on whether distinctive character was demonstrated

SALESFORCE.COM, INC (the Applicant) sought registration of **SOCIAL.COM** in respect of goods/services in classes 9, 35, 41, 42 and 45. The Examiner rejected the application under Articles 7(1)(b) and (c) of Regulation (EC) No 207/2009 (EUTMR).

An appeal was dismissed. The Fourth Board of Appeal (BoA) found that the connection between the sign and the goods/services was sufficiently close that the sign came within the scope of Article 7(1)(c); the normal meaning of “social” connected to the concept of “society”.

GENERIC FINDING

The BoA found that the element “.com” was a generic term and would be perceived as referring to an internet address or web domain. **SOCIAL.COM**, as a whole, would be understood as “internet-based social interaction”. With regard to the goods/services, it would be seen as a direct and specific reference to “social media” and “social networks”, which refer to computer-mediated tools that allow information, ideas, photographs and videos to be created, shared or exchanged in virtual communities and networks.

The Applicant had not provided any evidence that the sign applied for had

acquired a distinctive character by use, in accordance with Article 7(3) EUTMR.

The Applicant appealed to the General Court (GC). Essentially, the appeal alleged a failure on the part of the BoA to properly substantiate its reasoning or precisely analyse all of the goods and services involved. These arguments were rejected, with a finding that the BoA:

1. had explained why the connection between the word “social” and the concept of “society” was preferred (the BoA indicated that the source of those definitions was the *Oxford English Dictionary*);
2. had provided descriptions of the expressions “social media” and “social networks”;
3. was entitled to use only general reasoning for all goods/services that are sufficiently directly connected that they comprise a category of goods or services of a sufficient level of homogeneity;
4. found that all the goods and services concerned were related to social

media or social networks. That is, they are core elements of social media platforms, or possible content that is subject to social media or administrative support services for the proper functioning and maintenance of social media platforms and social networks. Thus, all the goods and services are related to social media or social networks in a sufficiently direct manner and form a group of goods and services of sufficient homogeneity.

GC DECISION

In view of all the above, the GC held that the BoA correctly considered the word mark **SOCIAL.COM** as being descriptive within the meaning of Article 7(1)(c) EUTMR. There was therefore no need to consider Article 7(1)(b).

Although, on appeal, the Applicant had claimed that the mark had acquired a distinctive character through use, this could not be considered outside the conditions set out in Article 7(3) EUTMR.



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A Universal failure

Particulars were lacking for challenges based on national rights, as Lauren Somers explains

ON 11 JUNE 2012, Universal Protein Supplements Corp (Universal) filed applications for declarations of invalidity against two EU Trade Mark registrations for figurative marks containing the word ANIMAL in class 25. Universal's applications were made on the basis of: Article 53(1)(c) of Council Regulation (EC) No 207/2009, read in conjunction with Article 8(4); its claimed unregistered rights to the word ANIMAL; and its use in relation to clothing in the EU since 1993.

EVIDENCE OF USE

Universal, during the invalidity proceedings, produced evidence of use of the mark ANIMAL in various EU countries, but did not provide details of the provisions of the relevant national laws on which it wished to rely under Article 8(4). The proprietor of the challenged registrations, H Young Holdings (Young), submitted observations to EUIPO in this regard.

In response, Universal claimed that it had demonstrated use of its unregistered trade mark in Austria, Belgium, the Czech Republic, France, Germany, Hungary, Italy, Luxembourg, the Netherlands, Romania, Slovakia and Sweden. Also, in respect of the relevant national law, it submitted an extract from the EUIPO Guidelines entitled "National rights which constitute 'earlier rights' within the sense of Article 8(4) of Regulation No 207/2009".

The Cancellations Division rejected the invalidity applications and held that Universal had not produced any information relating to the rights relied on, or to the conditions that must be satisfied in order to prohibit use of the

contested marks in accordance with the rights in each of the relevant Member States. This decision was upheld by the EUIPO Board of Appeal, which considered that a general reference to the table in the EUIPO Guidelines does not enable EUIPO to identify the national right upon which the application for invalidity is based. The table contains a list of rights that could constitute earlier rights within Article 8(4) and a summary of the conditions, but does not cite any provisions of the national laws it refers to.

On an appeal brought by Universal against EUIPO with Young as Intervener, the General Court concluded in favour of EUIPO. It noted that Rule 37(b)(ii) of Commission Regulation (EC) No 2868/95 provides that an application for invalidity must contain particulars of the right on which the application is based and, if necessary, particulars showing that the applicant is entitled to adduce the earlier right as a ground for invalidity.

COURT CLARIFICATION

The Court stated that Universal had failed to identify in an unambiguous and precise manner the provisions of the national laws on which it based its applications for invalidity. It added that a general reference to the table taken from the EUIPO Guidelines was not

“

Universal had failed to identify in an unambiguous manner the provisions of the national laws on which it based its applications for invalidity

sufficient to identify such provisions or to apply the contents of those provisions and allow the registrant to exercise its rights of defence.

APPROPRIATE ACTION

The Court also considered a second plea by Universal that EUIPO should, of its own accord, have applied the facts of the case. The Court clarified that EUIPO must carry out a verification of the facts and the law presented to it; it does not have a duty to identify the relevant law on a party's behalf and also apply the facts to that law.

As a result, Universal's appeal was unsuccessful and it was ordered to pay EUIPO's and the registrant's costs.



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Hammer falls on Mc

Chris Morris explores this example of how families of trade marks can offer wide protection

IN JANUARY 2010, Singaporean company Future Enterprises Pte Ltd (Future) successfully registered MACCOFFEE as a Community Trade Mark – now EU Trade Mark (EUTM) – in classes 29, 30 and 32 for various food and beverages. McDonald's did not file an opposition prior to registration, but subsequently filed an application for a declaration of invalidity in August 2010. The action was based on its earlier EUTM McDONALD'S, as well as several other marks that included the “Mc” prefix, such as McFISH, McCHICKEN and McMUFFIN.

MACCOFFEE was declared invalid and cancelled because it took unfair advantage of the reputation that existed in the earlier McDonald's mark. Future appealed to the First Board of Appeal (BoA), which upheld the cancellation decision, and then again to the General Court (GC).

CANCELLATION BASIS

The cancellation was based on Article 8(5) of Council Regulation (EC) No 207/2009, which provides broader protection for marks that can demonstrate reputation within the EU. The appeal reconsidered the two strands of Article 8(5) under which McDonald's had succeeded:

1. The MACCOFFEE and McDONALD'S marks are similar. It was held that there was sufficient overall similarity between the two marks, despite arguments put forward by Future that “Mac” and “Mc” are phonetically



This case is a reminder of the boosted protection that Article 8(5) gives to marks with a reputation and against attempts to ‘free ride’

different and that “mac” is simply American slang used to address a stranger in a friendly manner.

The finding of similarity then led the Court to find that the relevant EU public would mentally establish a link between the contested mark, the McDONALD'S mark and, importantly, the family of Mc-prefixed marks, which were widely in use by McDonald's.

2. Use without due cause of the MACCOFFEE mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark (McDONALD'S). The GC wholly upheld the BoA's

findings on this point. The MACCOFFEE mark would take unfair advantage and “ride on the coat-tails” of McDonald's trade marks, benefiting from its reputation and prestige. Use of MACCOFFEE could cause a transfer of the image of McDonald's trade marks to the goods covered by MACCOFFEE. Consequently, the appeal failed.

DE FACTO MONOPOLY?

This case suggests it would currently be very difficult for a third party to register a trade mark for foods or beverages that combines the name of that food or beverage with the prefix “Mc” or “Mac”. The findings of the Court around the reputation of McDonald's suggest the fast-food giant enjoys a *de facto* monopoly in signs following that particular construction.

More generally, it is a reminder of the boosted protection that Article 8(5) gives to marks with a reputation and against attempts to “free ride”. It provides comfort to brand owners that the significant investment and marketing expenditure that goes into creating and protecting such reputations, and the effort to prove it, is worthwhile.



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Total wipeout

Charlotte Wilding reports on a catfight that turned on the principle of totality

ON 30 NOVEMBER 2012, Mad Catz Interactive, Inc (Mad Catz) applied to register an EU Trade Mark for the mark shown on this page in classes 9, 25 and 28. On 16 May 2013, Monster Energy Company (Monster) opposed the class 25 goods on the basis of Articles 8(1)(b) and 8(5) of Council Regulation (EC) No 207/2009 in respect of its earlier EU registrations in class 25, also shown below.

The Opposition Division dismissed the opposition on 23 June 2014. This decision was appealed and dismissed by the Fourth Board of Appeal (BoA) on 21 May 2015.

APPEAL DECISION

The BoA held that there were no visual, phonetic or conceptual similarities between the marks, and that the additional elements to the earlier marks made them even more different. The fact that MAD CATZ and MONSTER both begin with the same letter was not sufficient.

Monster brought an action at the General Court (GC) against the dismissal, alleging infringement of Articles 8(1)(b) and 8(5) and requesting that the GC annul the decision, reject the mark applied for and order EUIPO to pay costs.

Monster argued that the BoA wrongly assessed the overall impression created by the marks and that its subsequent finding of a lack of confusion was also wrong.

Monster claimed that consumers would establish a conceptual link between representations of claws or marks made by claws, such that the marks would be seen as confusingly similar. Further, it claimed that

monsters and cats, particularly “mad cats”, are conceptually similar, creating a further link between the marks.

However, the GC held that the BoA was right in its assessment of the marks and that the marks were sufficiently distinguishable so as not to be confusingly similar.

In this regard, the relevant public is considered to be the general public with an average degree of attention. It is accepted that the average consumer views a mark as a whole and does not analyse each individual detail. The marks are therefore to be assessed in their totalities.

The GC found that the orientation and number of lines, the style of the lines and the backgrounds of the marks are visually different.

Furthermore, the mark applied for contains MAD CATZ, such that it would be referred to as “mad cats”. However, Monster’s marks would either be considered to be a stylised “M” or referred to as MONSTER RIPPER/ENERGY, depending on the mark. Therefore, the marks are phonetically different. Regarding conceptual similarities, while Monster argued that consumers would consider the marks to be claws or marks made by a claw, it failed to provide evidence to that effect. The GC felt that Monster was simply putting forward the interpretation most favourable to its arguments and any

conceptual similarity would only be on the low end of the scale.

Because a finding of similarity between the marks is a precondition of Articles 8(1)(b) and 8(5), these Articles could not form a basis for refusal of the Mad Catz application, even if Monster could prove a reputation in the marks. Monster’s claim of infringement was dismissed.

CONFIRMATION

The case confirms that marks are to be assessed in their totalities. The GC reiterated that: “It is only if all the other components of the mark are negligible that the assessment of similarity can be carried out solely on the basis of the dominant element.”

The Mad Catz mark



The Monster marks



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Seeing beyond the surface

Industry context saw the Court reconsider, writes Nellie Jackson

IN FEBRUARY 2012, Materis Paints Italia SpA (MPI) registered the sign CALCILITE in a stylised format (shown below) as an EU Trade Mark covering “paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colourants; mordants; raw natural resins; [and] metals in foil and powder form for painters, decorators, printers and artists” in class 2 and “pargets” in class 19.

A few days later, Alpha Calcit Füllstoffgesellschaft mbH (Alpha) filed an application for a declaration of invalidity based on its earlier EU word mark CALCILIT covering “crystalline calcium carbonate as a filler (CCCF)” in class 1 and “marble in the form of granules, grains and powders” in class 19, relying ultimately on only Article 8(1) (b) of Council Regulation (EC) No 207/2009.

The Cancellation Division rejected Alpha’s application on the basis that the goods covered by the respective registrations were neither identical nor confusingly similar. On appeal, the Fourth Board of Appeal (BoA) reiterated the view that the goods were not similar and dismissed the appeal.

RECONSIDERATION

On reconsideration by the General Court (GC) as to the similarity of the goods, with respect to “paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colourants; [and] mordants”, the GC found that the BoA failed to identify the relevant public for the purposes of assessing likelihood of

confusion. The BoA noted that CCCF is not intended for private individuals or non-industrial professionals. It should have followed, therefore, that the relevant public could not extend beyond the professional public in the industrial sector.

THE CONSUMERS

Subsequently, with respect to the BoA’s finding that CCCF is a raw material and MPI’s goods are finished products, the GC noted that simply because a product is described as a finished product does not preclude it from also being used in industry as an ingredient, raw material or component in the manufacture of another product.

The concept of a finished product is one ready to market, whether to end consumers or industry. The fact that paints, colourants and the like are often purchased by private, individual DIY enthusiasts does not mean that industrial professionals are not also consumers of these products.

Indeed, if the BoA had identified the relevant public correctly, the only assessment that had to be made was whether industry professionals were also likely to use these goods in the manufacture of their own products. The GC answered this question affirmatively and therefore annulled

the BoA’s decision in respect of “paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colourants; [and] mordants”.

Conversely, with respect to “raw natural resins”, the GC considered that Alpha’s argument that the products complement each other was entirely unsubstantiated and rejected the plea on the basis that they are not competing or similar products to CCCF. With respect to “pargets”, the GC confirmed the BoA’s conclusion that CCCF and pargets do not share a common consumer, but instead have a different nature, function and method of use and, therefore, also rejected this plea.

CONTEXT WARNING

This case highlights the need to always consider the circumstances within the context of specific industry practices. One size doesn’t fit all and, as the GC put it, “relying on irrelevant and questionable considerations” without carrying out a specific examination is clearly to be avoided.

MPI’s sign

CALCILITE



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Difficult finding for Easy marks

Richard Burton debates a decision that borderline descriptive marks remain enforceable



THE EU GENERAL Court (GC) has upheld a finding of likelihood of confusion between two figurative marks containing the descriptive words “easy credit” in relation to identical services.

Easy Asset Management AD (Easy Asset) filed an application for a declaration of invalidity in respect of an international registration for the mark shown below, which was registered by TeamBank AG Nürnberg (TeamBank) in 2012. The action was based on Easy Asset’s earlier Bulgarian national registration for this mark, also shown.

MARK COMPARISON

Due to the identical services, the dispute focused on the question of whether the marks were similar. EUIPO had initially rejected the invalidity application, finding that the marks coincided only in their respective word elements, which were manifestly descriptive, while their figurative elements, in which the distinctive character resided, were unrelated. The BoA upheld the appeal, however, finding that there was a likelihood of confusion due to the strong similarity of the signs. It found that neither of the signs was sufficiently stylised to change their overall visual impression.

On appeal to the GC, TeamBank maintained that there was no likelihood of confusion and that the word elements were descriptive and not distinctive and, therefore, must not be taken into consideration. They submitted that the signs should be compared on the basis of the figurative elements, which differed.

The GC found that the marks coincided in their word elements, and

that the figurative elements were of lower importance. It therefore rejected the argument that the word elements must be disregarded. Only where all the other components of the mark are negligible may the assessment of the similarity be carried out solely on the basis of the dominant element (as recognised in *Société des Produits Nestlé v OHIM*¹). However, given their respective size and position, the GC held here that the word elements could not be regarded as negligible.

Interestingly, the GC did recognise that the word elements “easy credit” were common and would easily be understood by the relevant public as an indication of the type of services in question. Nonetheless, these elements were considered to occupy a central position in the signs and dominate the overall picture. Accordingly, the GC concluded that there was a likelihood of confusion.

QUESTIONABLE OUTCOME?

No doubt, the BoA and GC were correct in finding that the registration of a national mark implies that the earlier mark has a minimum of inherent distinctiveness. However, the way in which the GC has reached a finding that this minimal degree of distinctive character is sufficient in this case is noteworthy.

On one hand, the GC appears to recognise that the word element “easy credit” will easily be understood by the relevant public as being descriptive of the services in question; yet, it contradicts itself by finding that the identical word elements are sufficient to reach a finding of likelihood of confusion. The GC appears to stress that the word elements are dominant and cannot therefore be considered negligible; but are they distinctive?

It is perhaps arguable that, rather than assessing the dominance of the word elements, the GC should have removed them from the equation having acknowledged that they were descriptive. Then, there would have been only one logical outcome: that the marks are, based on the remaining figurative elements, dissimilar.

¹) C-193/06 P.

The TeamBank mark

**e@sy
Credit**

The Easy Asset registration

EasyCredit



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events

More details can be found at itma.org.uk

Date	Event	Location	CPD hours
25 October	ITMA London Evening Meeting* Discussion of recent EUIPO cases	Royal College of Surgeons, London WC2	1
27 October	ITMA North-East Region CPD Talk Designs and the role of dotted lines	Bond Dickinson, Leeds	1
3 November	ITMA Seminar for Litigators	Edwin Coe LLP, London WC2	2.5
9 November	ITMA Webinar† Middle East spotlight – the shifting sands of trade marks		1
17 November	ITMA Scottish Talk Case-law update	Marks & Clerk LLP, Edinburgh	1
22 November	ITMA London Evening Meeting* Update on UK IPO and UK court decisions	Royal College of Surgeons, London WC2	1
24 November	ITMA Administrator Session§ The career path for Administrators	Olswang LLP, London WC1	
30 November	ITMA Wales & SW Talk Drafting and negotiating trade mark contracts: the devil is in the detail	Ashfords LLP, Bristol	1
7 December	ITMA Northern Christmas Lunch	TBC	
9 December	ITMA Christmas Lunch and Drinks Reception†	London Hilton on Park Lane, London W1	

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THE TRADE MARK 20

Q&A



My role is... Trade Mark Partner in the London office of Elkington and Fife LLP.

Before this role... I was the Director of Trade Marks in the London office of a large US law firm.

My current state of mind is...

content because the sun is shining and I am about to go on holiday, and not so content because my house currently has no roof.

I became interested in IP...

when I started my first job in London, translating specifications of goods and services from French and German.

I am most inspired by... people

who face and overcome adversity. They make me realise that my problems are usually very insignificant.

In my role, I most enjoy... finding creative solutions to problems and achieving good results for clients.

In my role, I most dislike... deadlines and invoices.

On my desk is... a constantly evolving to-do list and a calculator.

My favourite mug says... "I am silently correcting your grammar."

My favourite place to visit on

business is... Miami Beach because the climate is usually perfect and the architecture is stunning.

If I were a trade mark/brand, I would be... Vegemite, because it is less divisive than Marmite.

The biggest challenge for IP is... the UK's relationship with the EU.

The talent I wish I had is... singing and dancing. Of course, I can do both, but not together.

I can't live without... newspapers and coffee.

My ideal day would include...

culture, fresh air, food and drink, and maybe some retail therapy.

In my pocket is... my Oyster card.

The best piece of advice I've been given is... that you are only as good as your last mistake.

When I want to relax I... play football, drink wine, cook and/or eat nice food, read or watch *MasterChef* with my wife.

In the next five years I hope to... keep doing what I am doing, at work and at play.

The best thing about being a

member of ITMA is... the support network. There are always volunteers working on behalf of the members, and without them and the office we would not be where we are today. ITMA is also very good at social events – there is always someone friendly to talk to.



We found Fellow
Chris McLeod in
a sunny mood

“

There are always volunteers working on behalf of ITMA members, and without them and the office we would not be where we are today

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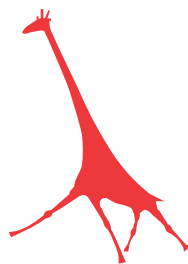
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