

# CITMA REVIEW

ISSUE 451 JULY/AUGUST 2019

## The power of purple

*Tracing the history of  
one of the world's most  
hard-fought hues*

**CITMA** The Chartered  
Institute of Trade  
Mark Attorneys



**INTA: THE  
ROOKIE  
REPORT**  
P8

**GUIDE TO  
THE BEST IP  
PODCASTS**  
P18

**USPTO  
REFUSALS  
ANALYSIS**  
P22

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# WELCOME & CONTENTS



**Tania Clark**  
CITMA President

“  
*The Autumn Conference in Birmingham is likely to be as popular as ever*

trust that you are all relaxing and enjoying a well-earned rest when you read this issue of the *CITMA Review*. While you are, you might want to listen to some of the legal podcasts mentioned inside, which vary from providing advice on wellbeing to exploring developments in technology. To continue our international coverage, we have a summary of our webinar on trade mark protection in China, as well as an analysis of USPTO designation refusals. Our TM20 features the esteemed Spanish attorney Luis-Alfonso Durán, who recently became an Honorary Member of ECTA.

The next major CITMA event is the Autumn Conference in Birmingham on 17th October and it is likely to be as popular as ever – sign up quickly to get a place. We also have two autumn events aimed at CITMA Paralegals, see page 49 for details. And please be supportive of your firms’ paralegals attending such events, since they provide an invaluable opportunity to keep abreast of changes in the law and to network with other paralegals.

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## CITMA REVIEW

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## REGULARS

- 4 Insider *We say goodbye to Roy Scott, and welcome new Council members*
- 49 Events *What's coming up for CITMA members*
- 50 TM20 *Luis-Alfonso Durán follows in the footsteps of tradition*

## FEATURES

- 6 IPReg *Lord Smith looks forward to a season of hope*
- 8 INTA *Reflections from a team of rookie reporters*
- 14 Colour *Mary Bagnall traces the history of a hard-fought hue*
- 18 Media *Carrie Bradley offers a baker's dozen of summer legal listening*
- 22 USPTO *An analysis of the reasons and remedies for Madrid refusals*
- 26 China *Nina Li guides us through the new environment for trade mark protection*

## CASE COMMENTS

- 28 [2019] EWHC 769 (Ch) *Aaron Wood welcomes a move towards more detailed explanations*
- 30 [2019] EWHC 849 (Ch) *Chris Thomas recounts the reasons why an appeal had no power*
- 32 T-555/18 *An advertising slogan was found to lack a compelling link, writes Duncan Balloch*
- 33 T-423/18 *Tom Coop considers the arguments about colour in a common consumer category*
- 34 T-152/18 *An error was made on the assessment of elements, says Leanne Gulliver*
- 35 O/171/19 *Sarah Williams sorts the facts in a Birmingham-based dispute*
- 36 O/170/19 *The difference between beer and spirits was a decider, notes Gavin Stenton*
- 37 O/196/19 *A conceptual disconnect delivered for Sekoya, writes Oliver Tidman*
- 38 O/178/19 *Laura Robyn explains how LinkedIn ironed out a kink*
- 39 O/211/19 *Use it or lose it came to mind for Rose Franckeiss*
- 40 O/226/19 *Good feeling died as partnership dissolved, says Eve Brown*
- 41 O/229/19 *Roshani Muniweera reports a case with an interesting twist*
- 42 000017165 C *The Court didn't find Nirvana's arguments enlightening, says Clare Liang*
- 43 000014030 C *Dale Carter discovered the risk of a geographical reference*
- 44 B 3 051 505 *The Opponent's mark may live long and prosper, writes Aaron Hetherington*
- 45 B 3 002 352 *Saaira Gill reports on a hard day for easyGroup*
- 46 000015152 *Nick Bowie reveals why the Kors case went off course*
- 47 R0820/2018-4 *The meaning of a mark cannot be assessed in abstract, comments Désirée Fields*
- 48 B 3 007 088 *Mark Caddle warns of the need to mind the gaps*

# 5 CITMA COUNCIL'S FIVE NEW FACES

We recently welcomed five new members to the CITMA Council. The Council meets six times a year and sets the strategic direction of CITMA.

Its members are elected for a two-year term at the CITMA Annual General Meeting. Here's a brief who's who.



**TRIONA DESMOND**  
PINSENT MASONS LLP  
Triona advises clients across industries in contentious and non-contentious trade mark, design and copyright matters. She also has in-house experience, supporting a major retail client. She is a member of the IP Out committee, one of the IP Inclusive's support groups.



**LEANNE HALL**  
SERJEANTS LLP  
Leanne started at Marks & Clerk as a trainee Trade Mark Attorney. She was part of the first intake to qualify under the new qualification system. She worked in-house at Rolls-Royce, before moving back to private practice at Serjeants LLP. She handles trade mark, design and copyright issues.



**JADE MACINTYRE**  
ALLEN & OVERY LLP  
Jade specialises in trade mark prosecution and portfolio management, working with major brands and international organisations. Her experience spans advertising and media, entertainment and hospitality, financial services, telecommunications, manufacturing and consumer groups.



**CAMPBELL NEWELL**  
MARKS & CLERK LLP  
Campbell has 30 years of IP experience. He is a senior member of the IP profession in Scotland and has been described as "Scotland's trade mark tzar". Having spent his whole career with Marks & Clerk, he is retiring from active practice in 2019, but he will be continuing as a consultant.



**KATHY WRIGHT**  
ASTELLAS PHARMA EUROPE LTD  
Kathy is a Chartered Trade Mark Attorney working in-house at Astellas Pharma Europe Ltd. She has worked in trade marks for more than 15 years, including more than 10 years' experience in the pharmaceutical industry.

Find out more about the role of the Council at [citma.org.uk/council](http://citma.org.uk/council)

## MARK YOUR CALENDAR: AUTUMN CONFERENCE 2019

The CITMA Autumn Conference 2019 will take place on 17th October at its now-customary venue, the ICC in Birmingham. The focus will be on preparing for change. For further details on speakers and booking, visit [citma.org.uk](http://citma.org.uk)

# IN MEMORIAM: ROY SCOTT



Everyone in the CITMA team was devastated to learn that Roy Scott passed away on Friday 21st June 2019.

Roy, a Senior Paralegal at Keltie LLP, was a great supporter of CITMA and our work over many years. He took a lead in driving forward our work on paralegals and the CITMA Paralegal Course.

He continually helped us to develop and improve our paralegal events and learning opportunities. He was instrumental in the launch of the CITMA Paralegal category of membership and the introduction of continuing professional development (CPD) for CITMA Paralegals this year.

Roy spoke at many CITMA events, sharing his years of experience and expertise as an IP Paralegal with the rest of the profession.

His contribution to the profession was recognised after he made the final shortlist of three in the trade mark paralegal category of the 2019 National Paralegal Awards.

In an announcement, Keltie said the firm “would simply not be the place it is now without Roy’s overwhelming contribution and infectious charisma”.

His passion for the profession and positivity will be greatly missed.

Our thoughts are with his family, friends and his colleagues at Keltie.

## MEMBER MOVES

→ VISIT THE CITMA JOBS BOARD: [CITMA.ORG.UK/JOBS](http://CITMA.ORG.UK/JOBS)



**Magdalena Borucka** has joined the team at Taylor Wessing as an Associate (registered European lawyer). [m.borucka@taylorwessing.com](mailto:m.borucka@taylorwessing.com)



**Clare Mullarkey** took up a position of Associate at Williams Powell in May. Contact her at [clare.mullarkey@williamspowell.com](mailto:clare.mullarkey@williamspowell.com)



**Ese Akpogheneta** recently joined the Legal & External Affairs team at British American Tobacco as Trade Mark Counsel.

# A SEASON OF HOPE

For Lord Smith, the coming months are  
a time to keep calm and carry on

**Just a few** months ago I was seriously worried that by now we might be in a dystopian, post-hard-Brexit world where we'd be struggling to make sense of IP protection work across European boundaries. But 29th March came and went, and, mercifully, we now have an extension to the end of October, with life sort of normal in the meantime.

But of course, life isn't really normal at all. We simply don't know what is going to happen at the end of October. And as I write this, we are in the process of losing one prime minister and gaining a new one from within the ranks of the Conservative Party. Meanwhile, the Brexit clock is relentlessly ticking.

The one certainty is that Theresa May's deal is dead. It was a valiant attempt to square the impossible circle of trying to get rid of the Customs Union, the Single Market and the ECJ while at the same time trying to protect some degree of economic interaction. Given those parameters, it was probably the best she could have secured, but because it tried to do the impossible it ended up being unloved by everyone.

Let's assume for the moment that the Conservative election throws up a hard-Brexit new leader. They will almost certainly try to obtain what they blithely describe

as a "managed no deal". This is, of course, a contradiction in terms, and actually no deal means no deal. The current Parliament has indicated on several occasions that this is not acceptable. And it is right. Chaos would ensue, not least in the world of IP. But it remains the default option.

“

*We simply don't know what is going to happen at the end of October*

If Parliament cannot agree on anything else, we fall out of the EU at the end of October without any sustaining provisions at all.

There are three other possible outcomes. One is a further extension; given the history of recent months, this is probably the likeliest result.

One is that the EEA/EFTA option might resurface and gain support; this would require more time to resolve, but might at least provide a sense of direction. It's unlikely, though. And the third is that the whole thing is put back to the people, because Parliament can't resolve it. A new referendum with a clear choice of no deal or remain. This would be my preferred option, as I believe strongly that remain would win. It's the only sensible get-out-of-jail-free route. But – and it's a big but – is there enough support in Parliament to get us there?

We just don't know. And in the meantime, the uncertainties are still with us. For trade mark practice across European borders, this is seriously disconcerting. And while patent work is less immediately affected, it still has a serious impact. While we wait for it all to be resolved, we simply have to carry on as best we can, making preparations where we can for the worst, but hoping for something better. I still hope.



**The Rt Hon the Lord Smith of Finsbury**  
Chair of IPReg

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info@ip-support.co.uk

A large, stylized graphic of the letters 'IP' in a serif font, centered within a white circular shape. The background is a light grey color with a white curved shape that frames the 'IP' logo.

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Our authors tested  
the waters at the  
INTA Annual Meeting  
2019, held in Boston,  
Massachusetts



# THE ROOKIE REPORT

A team of INTA first-timers provides its advice on thriving  
and surviving at the year's largest trade mark gathering





# INTA:

“It’s one of the few times when it is appropriate to have a dinner conversation about enhanced distinctive character and whether it really increases likelihood of confusion,” says Yana Zhou. She is one of five INTA “rookies” who agreed to report back to the *CITMA Review* on their Boston experience to give next year’s newbies a leg up.

## WHY ATTEND INTA?

“I’ve been told that you’re not a true Trade Mark Attorney until you’ve attended INTA. After Boston, I agree,” says Sinéad Mahon, a Senior Chartered Trade Mark Attorney at Lewis Silkin. “It’s a great opportunity to meet with existing clients as well as contacts from all corners of the world, build on relationships and forge new ones. After corresponding with foreign attorneys over the phone and email for years, it was great to put a faces to the names and spend some time getting to know them.”

Yana Zhou, an IA Manager at Stobbs IP, and Cherry Shin, a Trainee Trade Mark Attorney at Appleyard Lees, echoed that thought, but the reputation of the gathering also gave it a certain allure. For Shin, it’s very much an event that is prioritised and talked about in her firm, and organisation can start up to a year in advance, she says.

“There is a lot of buzz and mystery around INTA,” says Rose Smalley, an Associate at Womble Bond Dickinson LLP. “Frankly, I was quite nervous going into it – especially when several colleagues I met referred to first-timers as INTA virgins and wished me good luck on getting through it!”

## READY, SET...

Attending such a big event can mean big expectations, which can also leave first-timers with mixed feelings as they prepare for the trip.

“I was really looking forward to it, but also feeling slightly nervous,” says Vlotina Liakatou, Senior Trade Mark Associate at Baker McKenzie. ▶

### Vlotina Liakatou

Senior Trade Mark Associate at Baker McKenzie

### Sinéad Mahon

Senior Chartered Trade Mark Attorney at Lewis Silkin Ireland

### Rose Smalley

Associate at Womble Bond Dickinson

### Cherry Shin

Trainee Trade Mark Attorney at Appleyard Lees

### Yana Zhou

IA Manager at Stobbs IP



*“I’ve been told that you’re not a true Trade Mark Attorney until you’ve attended INTA. After Boston, I agree”*

“Had I done everything I was supposed to do in preparation? This included tasks from applying for an ESTA [visa waiver] to making sure I had organised everything to make the most of my time in Boston.” Colleagues can do a lot to help, she says. “I was lucky to have many colleagues who had INTA experience. Their guidance was invaluable, especially on how to prepare. Until we reached Boston, I bombarded them with questions.”

Liakatou made sure to do thorough research before the event, reviewing the meeting programme, special events and attendee list. “This helped me choose the sessions I wanted to attend and work out who I would like to meet. I also did a bit of research regarding Boston, the area around my hotel, the way to the conference centre and the distance between the venues for my meetings to make sure that I would not be late!”

Try to clear as many deadlines as you can before you leave, Zhou recommends. She says it is unrealistic to think that it will be possible to log on in the evening and do some work. “Although I had lots of colleagues poised to cover my work, bearing in mind a number of my colleagues were also out at INTA, I did not want to burden the team any more than I already was.”

But the best piece of advice she received from colleagues was “that the whole process is a marathon and not a sprint. This was important in guiding me in some of the decisions I had to make through the process.”

For Mahon, the majority of her research involved deciding who she should be meeting and what events she should attend. “INTA puts on so many interesting events/seminars that it is hard to choose from them all. It’s also useful to research the distance between meeting points to ensure you allow yourself plenty of time to make the meetings!”

Shin notes that her supervisor wanted her to attend some receptions and meetings alone.

So, she made sure to print out the profiles and pictures of every person she planned to meet with. “This was very handy, because there were over 11,000 people attending this INTA, and the venues were swarming with people dressed very similarly to one another. I also visited everyone’s website a few times and read some of the articles posted. It’s one thing to show preparation, but it’s also important to show attention to detail and genuine interest in the people you may be working with.”

“Four of my colleagues who were also attending are INTA pros so they were on hand to provide me with guidance before and during the event. The best piece of advice was ‘Enjoy it and I did!’” says Sinéad Mahon.

#### **ON-THE-SPOT SUPPORT**

Colleagues can also be handy once you touch down. “I was lucky to attend with a partner who has only missed four or five INTAs in 30 years,” says Smalley, “and it was fantastically helpful. When your schedule is busy, you can split up and see two people at once, and when you’ve had a busy day of networking, seeing a familiar face (even for 10 minutes) can be really refreshing. There is always someone to attend an event or reception with and they may be able to get you into some of the great invite-only parties that are not always on your radar as a first-time attendee!”

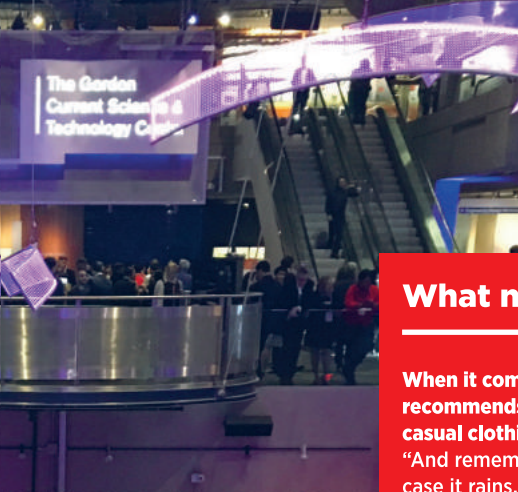
Shin was able to shadow different colleagues, which included attending a meeting with a focus on patents. “This might have seemed off-topic, but it was useful to be there. A few questions on designs and UK trade mark practice came up.” She recommends having a copy of your colleagues’ schedules, so that you can pop along to meetings with them when you have spare time.



## **Newcomer Match Scheme**

**Sinéad Mahon explains her experience with the Newcomer Match Scheme, through which INTA paired her up with another first-time attendee.**

“About a week before INTA, I exchanged emails with my assigned match and we pencilled in a meeting before the First Time Orientation seminar. On the day, we met at the handy Newcomer Match Meeting Point and chatted easily about ourselves, our firms and our expectations/initial experiences of INTA. It was very informal and it was great to have the opportunity to sit down and chat with someone also experiencing INTA for the first time. We then attended the orientation seminar together. Our schedules were too busy to meet up again, but we crossed paths a few times and it was great to know at least one friendly face among the INTA crowds. I’d recommend anyone attending for the first time to sign up to the scheme.”



## What not to wear

**When it comes to packing, our all-female panel recommends including a range of smart and casual clothing, with an emphasis on workwear.**

“And remember to bring an all-weather jacket in case it rains,” says Yana Zhou. When it comes to heels, however, opinion is divided. “Bring flat shoes – I packed 10 pairs!” says Zhou. And Vlotina Liakatou agrees: “Pack your comfy shoes! You will need them, as you will be out all day (and night!),” adding a warning to dress with care because you may not have time to change all day. Cherry Shin, “in what may seem like a mistake to a lot of people”, wore high heels to every meeting and event. “While my feet did hurt, I felt much more confident,” she says.



The Grand Finale at the Science Museum

### MEETING PLANNING

Making contacts is crucial at INTA, so meticulous planning is in order. But it's not easy, says Yana Zhou: “You offer a time, date and place to Person A and wait for them to respond. At that same time, Person B declines your offer and actually proposes the date and time you have offered to Person A but in a different location.

“The planning starts months in advance and you may be trying to arrange more than 10 meetings for every day, including making sure that you are in the right place at the right time for all the meetings and events that follow. This is made even more difficult for a first-timer because you are largely fitting your schedules

around everyone else. This needs to be factored in.

“The other thing I didn't expect was the length of meetings. People don't actually say how long they expect to meet – you have to guess. I would suggest blocking out one hour for meetings as a default (even though most meetings will not go on for that long). This gives you some breathing space.”

Cherry Shin found her background in languages came in very handy when it came to communicating with the international group: “I am fluent in Korean and have studied French and Spanish at university level. This gave me an advantage, allowing me to conduct much more personal meetings with foreign associates and clients.”

She also planned her itinerary in advance and calculated the time it would take to get from one meeting to the other. “Although my schedule changed while I was there, it gave me a good idea of how long it would take me to get to other places.”

Liakatou made sure to familiarise herself with the area around her hotel and the conference centre. She found that INTA's updates on what to do in Boston and how to get around were ▶

“

*It's important to show attention to detail and genuine interest in the people you may be working with*

INTA 2019 President David Lossignol issues The Unreal Challenge at the Opening Ceremony



very useful. Once you are in a meeting, she recommends: “Smile and make the first step – introduce yourself. You will definitely have something common to discuss – trade mark related or not. The professional relationships made at conferences are sometimes more important than the sessions themselves.”

### LOCATION, LOCATION, LOCATION

For Zhou, location is a crucial issue. “One of my first meetings was in the lobby of one of the conference hotels, which was so crowded it was almost impossible to find a place to sit. In the future, I will try to arrange my meetings in places around the conference hotels. In the end, however, I do not believe there is a right or wrong approach – you choose whatever is most appropriate for you and your audience.”

Physical navigation of a new city also offers its own challenges. “While INTA provided a shuttle bus to/from the hotels to the conference centre,” says Mahon, “it only ran at certain times and stopped during the middle of the day, which was a shame as the taxi queue was always really long. I tried to arrange to have all my meetings in the same area but that was not always practical, so I found myself using the hard-pressed local taxis and Ubers an awful lot.”

And while the convention centre where the conference was held was pretty easy to navigate, according to Smalley, it was busy all of the time. She says: “Some of the best meetings I had were away from the convention centre, in bars, cafés and restaurants in other parts of Boston. It was nice to see a bit of the city, stretch my legs and catch my breath after back-to-back meetings.”

“Technology becomes your new best friend at INTA,” concludes Zhou. “I relied a lot on Google Maps and Uber. So, remember to charge your phone and bring a back-up battery

pack! I also relied on my Apple Watch at meetings. It is not always easy to subtly and politely glance at your watch and there may not be a clock nearby. I found it useful to set a timer on my watch for very short meetings; a discreet vibration would then tell me it was time to wrap things up.”

### SET YOUR OWN PACE

INTA is an intense experience, so how did our group manage the process? Says Yana Zhou: “It was incredibly important to me to eat and sleep and stick to my usual routine as much as possible. And pace your alcohol intake – there is a lot on offer! It is often so tempting, especially if it is your first INTA, to try to go to as many events as you possibly can, and quite a few happen past midnight. It takes courage to say no, but it has to be done sometimes.”

Liakatou agrees that maintaining a balance is “tricky, but if you have planned well in advance it should be manageable. Attend your meetings and conference sessions, but also allow some time for catching up for a dinner or drink after a long day. And whatever you do, make sure you get a good night’s sleep, eat well and drink lots of water. It is amazing how easy it is to forget to look after yourself when you are busy running around between meetings, presentations and conference sessions!”

Shin also made an effort to resist temptation: “At our reception, I made the decision to only drink water. The receptions were so much fun, but it was important for me to remember that I would have breakfast meetings the next day. After all, I was there to network, rather than just have fun.”

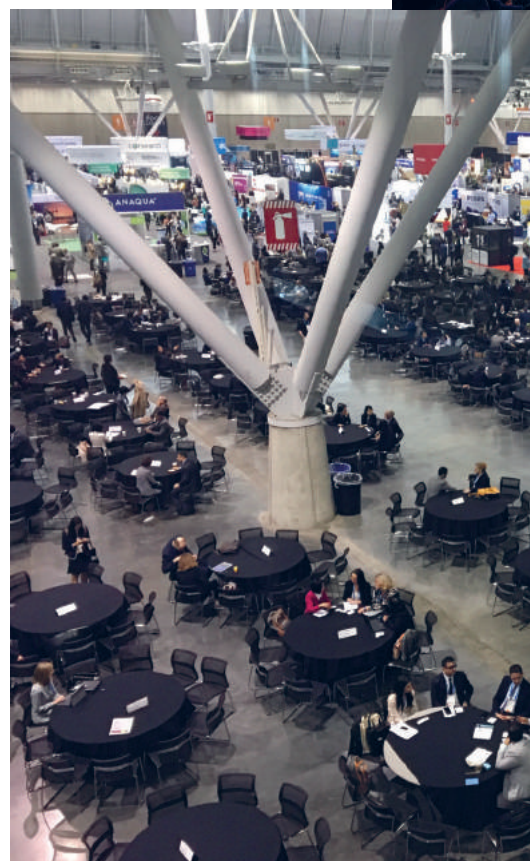
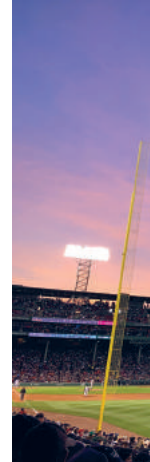
As far as finding time for meals, Shin says that while most receptions had great food available, it wasn’t easy to fit in enjoying it around trying to mingle: “On some days,

*“ Do INTA your own way – not how everyone else tells you it should be done... You’re only wasting your time if you’re not enjoying it*

Top: A baseball game at Fenway Park was one of the networking events our authors enjoyed

Main image: The meeting area at INTA

Bottom left: Appleyard Lees reception





I attended only receptions and found myself starving by the end of the day. On some days, where I had dinners planned, I would be absolutely stuffed!”

Smalley suggests arranging a lunch meeting or two so you know you’ll be eating at some point in the day.

### HIGHLY RECOMMENDED

Asked to identify their personal highlights, Vlotina Liakatou offers two: “The opening ceremony was very informative and the keynote speech by [professional athlete and environmental advocate] Michael Haddad was exceptionally inspirational. It made me realise that some challenges in life can actually be overcome as long as you believe in yourself and you are determined to achieve them.”

Both Shin and Smalley recommend the first-timers’ orientation organised by the INTA committee, which Shin describes as “extremely useful, as the other attendees confirmed everything I was thinking and feeling was OK and normal”.

Smalley also recommends attending the first-timers’ reception: “Everyone there is on the same page in terms of dipping their toes in the INTA water. This makes it very easy to make conversation, find common

*“INTA is like a fairy tale with the good and the bad”*

ground, and share tips on sessions and events.”

And everyone agrees that they hope to be back, perhaps even at INTA 2020 in Singapore, and recommend it to anyone who hasn’t attended yet. Says Liakatou: “INTA is like a fairy tale with the good and the bad, but with a happy ending. The good is the opportunity for networking and learning, the bad is that it can be tiring and overwhelming, but in the end it is a great experience that you really want to live again.”

### FINAL WORDS

For Shin, recognising the value you bring is important: “Although as a trainee I assumed that I would be able to shadow a lot of my colleagues’ meetings, one thing I learned at INTA was that I should take more responsibility. It’s important for every INTA attendee to remember the hefty price tag associated with attending. So, think about what you can do personally to make this trip worthwhile for both yourself and the firm. In my case, it was conducting meetings and attending receptions on my own, as well as attending meetings set up by other colleagues to broaden my education and impact.”

Concludes Smalley: “My advice would be to do INTA your own way – not how everyone else tells you it should be done. If you feel like dancing and drinking the night away, there will be an after-party every night that allows you to do that. Equally, if you’re attending receptions and having a few nibbles (sticking to the soft drinks), that’s OK too!”

“There are so many events, receptions and sessions on offer that INTA is really what you make of it. There are literally thousands of people in attendance, and you’re more likely to make connections with the people who enjoy doing the same things you do. You’re only wasting your time if you’re not enjoying it.” ●

## Top tips from our rookies

- Experienced colleagues are an invaluable source of information and support, both before and during an INTA meeting.
- Try to plan your arrival so that you have some time to settle in and acclimatise to the new location before you dive into the conference itself.
- Be realistic when you are planning your itinerary – you will never be able to attend all the sessions you are interested in, so deciding what you wish to accomplish is key.
- Take advantage of INTA first-timer events; you’ll meet people who are on the same page and in the same situation.
- Meeting locations outside the conference venues will offer a quieter environment and a chance to see some of the host city.
- When scheduling meetings, block out one hour as a default (most meetings will not go on for that long). This gives you some breathing space.
- Pace yourself when it comes to social events and consider scheduling lunch meetings to build food into your day.
- Pack a range of clothing, including something for all weathers.



# THE POWER OF PURPLE

Mary Bagnall, a veteran campaigner for non-traditional marks, traces the history of one of the world's most hard-fought hues



1824, John Cadbury opened a grocer's shop in Birmingham selling cocoa and drinking chocolate. Cadbury introduced chocolate bars in the 1800s and aimed to create a chocolate bar with more milk than the competition – Cadbury Dairy Milk. By 1920, Cadbury Dairy Milk was wrapped in a rich purple colour, known as Cadbury Purple, which has been used by Cadbury on its chocolate products ever since. This particular hue has become so well known that brides choose Cadbury Purple-themed weddings. But why is it so important to Cadbury to protect the colour with a registered trade mark?

Decisions based on colour are made every day – drivers learn to stop at a red light and move off on green, and this colour association also extends to brand messaging, depending on context. A glimpse of green on the fascia of a petrol station, for example, tells the driver that they are approaching a BP station.

Apparently colour increases brand recognition by up to 80 per cent. As 73 per cent of purchasing decisions are now made in-store, catching the shopper's eye and conveying information effectively are critical to successful sales.<sup>1</sup> Single colours can act as brand identifiers in some circumstances: apparently, women's heart rates increase by approximately 20 per cent when presented with a blue Tiffany's box without any other branding being visible.<sup>2</sup>

Elena Ruiu, a packaged food analyst at Euromonitor, said: "Cadbury's strength relies on people's loyal affection; its iconic purple is associated with tradition, family values and heritage."<sup>3</sup> It should come as no surprise, then, that competitors see an opportunity to capitalise on

this non-verbal "brand equity" by adopting lookalike products or packaging.

### POSSIBILITIES PERCEIVED

In 1994, the UK implemented the EU Trade Marks Directive<sup>4</sup> and while there was no prohibition on colour marks under the old law, brand owners perceived much greater possibilities for protecting non-traditional trade marks, including colours.

Cadbury first applied for registration of the colour purple as a trade mark in 1995. It filed a colour swatch and stated "the mark consists of the colour purple". At that time the UK IPO raised a distinctiveness objection and Cadbury responded with substantial evidence of acquired distinctiveness.

During the prosecution of the Cadbury application, the IPO issued a Special Notice on Colour Marks, which stated "an application to register properly represented colour(s) as a trade mark is unlikely to face an objection from the Registrar that it is not a graphical representation of the trade mark if it is made clear... how the colour(s) constitute the applicant's mark. It may be possible to do this for example... by defining the mark as being the colour(s) covering the whole visible surface of, or the predominant colour(s) applied to the visible surface of named items, eg packaging for the goods." The notice made clear that existing applications could be corrected to "make it explicit that the trade mark consists of the colour(s) applied to the goods or their packaging".

Cadbury agreed to adopt the wording of the Special Notice, and as Cadbury Purple (Pantone 2685C) had acquired distinctiveness, the mark was registered for "chocolate in bar and tablet form".<sup>5</sup>

### SIGNS OF TROUBLE

Cadbury's use of and reputation in Cadbury Purple grew and in October 2004, Cadbury applied for another UK mark for Cadbury Purple with a slightly extended specification of goods. Naturally, it adopted the wording in the Special Notice, which the IPO had already accepted. This time it was opposed by Nestlé on the grounds (among others) that the mark was not a sign, nor capable of being represented graphically, and lacked distinctiveness.

Meanwhile, shortly after Cadbury filed its first purple application, Libertel BV filed an application with the Benelux Office (on 27th August 1996) for the colour orange for goods and services relating to its telecoms business. The Benelux Office referred various questions to the CJEU regarding the possibility of registering colour marks without spatial delimitation.

When the CJEU issued its decision in *Libertel* in May 2003 it had the benefit of the *Sieckmann* decision<sup>6</sup> in which the CJEU provided that the graphic representation required by Article 3 must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. The CJEU in *Libertel* found that colours per se were capable of constituting a trade mark (depending on the context of use) provided that the graphic representation complied with the *Sieckmann* criteria. While a colour sample alone was not sufficient, a verbal description could be, and in particular the designation of a colour using an internationally recognised identification code may be considered to constitute a graphic representation.

Nestlé's principal reason for saying Cadbury's mark was not a sign was that it was really an infinite number of signs and that the reference to purple being "the predominant colour" implied another colour could be present, and that this effectively meant the mark was a colour combination, which did not comply with the CJEU's decision in *Heidelberger*.<sup>7</sup>

*Heidelberger* concerned an application to register a colour combination consisting of defined shades of blue and yellow arranged "in every conceivable form". ▶

1 *Substantial research shows why colour matters and how colour plays a pivotal role in all our visual experiences* by Jill Morton, Colorcom – sources: University of Loyola, Maryland study; research by Henley Center

2 *Buyology* by Martin Lindstrom

3 *Brand Strategy* 7th July 2007

4 Council Directive No. 89/104/EEC of 21st December 1988 to approximate the laws of the Member States relating to trade marks

5 Registration No. 2020876A

6 Regarding an application to register a smell: C-273/00



The CJEU decided in *Heidelberger*<sup>8</sup> that the representation of the mark applied for must include a “systematic arrangement” that associated the colours in a predetermined and uniform way. However, meeting this requirement need not involve the use of contours or other methods of spatial definition because such a requirement would exclude colours being designated, “in the abstract”. It was not necessary to show how the colour combination is used in relation to every product in the list of goods.

The Hearing Officer in the opposition to Cadbury Purple considered Nestlé’s arguments under s3(1)(a) in the light of *Libertel* and *Heidelberger*. The Hearing Officer also noted that, as the law had evolved, Cadbury could successfully have asked for registration of the particular shade of purple without encumbering the representation of the trade mark with a description of the specific use of the colour that constitutes the sign – such that it would not have been clear from the representation how (or even whether) the colour would be applied to the packaging of the goods. He found that the potential for the application of the sign to the goods to vary from product to product, in terms of the proportion of the visible surface of the packaging covered by the colour, is not a reason to conclude that the mark is made up of an infinite number of signs; the mark itself (ie the colour purple applied for) is fixed and stable.

Nestlé’s opposition failed and its appeal to the High Court was unsuccessful.

On appeal to the Court of Appeal, Sir John Mummery gave the leading

“  
*If a colour has come  
to be recognised as a  
trade mark, it may  
be advisable to  
define it this way  
from the outset*”

judgment<sup>9</sup>. He said the description of Cadbury’s mark (as set out in the IPO’s Special Notice of 1997) referred “not only to the colour purple as applied to the whole visible surface of the packaging of the goods, but also to an alternative ie ‘or being the predominant colour applied to the whole visible surface...’ The use of the word ‘predominant’ opens the door to a multitude of different visual forms as a result of its implied reference to other colours and other visual material not displayed or described in the application and over which the colour purple may predominate. It is an application for the registration of a shade of colour ‘plus’ other material, not of just of an unchanging application of a single colour, as in *Libertel*.”

The judge found that the description did not constitute “a sign” that is “graphically represented” within Article 2. If the colour purple is less than total, as would be the case if the colour is only “predominant”, the application would cover other matter in combination with the colour, but not graphically represented or verbally described in accordance with *Sieckmann*.

Cadbury’s 2004 application was finally refused, but the original application, which contained the same wording, remained on the register. Cadbury therefore argued that according to the findings of the Court of Appeal, the mark comprised two alternative descriptions: the colour “applied to the whole visible surface of the packaging” and the colour “being the predominant colour applied to the whole visible surface of the packaging”. Accordingly, the mark must comprise two marks as a Series, the second of which, being uncertain, could be deleted. Given that this wording was adopted in place of the description in the mark originally applied for, *Floyd LJ*<sup>10</sup> said that “whilst one can feel sympathy for Cadbury that it is its adherence to the Guidance which has given rise to the breach of these requirements, it would be a potentially far-reaching step to allow the consequent lack of clarity to be read, instead, as an attempt to register a number of marks”.

That meant that Cadbury’s original 1996 mark would also be invalid.

#### DEALING WITH DESCRIPTION

As the description of the mark was the key issue, Cadbury could file a further application to protect Cadbury Purple, but how should it be described?

Discussions in the Court of Appeal in relation to the 2004 Mark indicated that “the colour purple Pantone 2685C applied to the whole visible surface of the packaging of the goods”, or simply “the colour purple Pantone 2685C” (ie a “pure *Libertel* mark”) would be acceptable.



The pale blue of a Tiffany & Co jewellery box demonstrates how, like Cadbury Purple, a single colour can be a brand identifier, even without any other visible branding

- 7 Heidelberger Bauchemie Gmbh, Case C-49/02
- 8 Paragraph 33
- 9 Societe des Produits Nestle SA v Cadbury UK Limited [2013] EWCA Civ 1174
- 10 [2018] EWCA Civ 2715
- 11 O/198/19
- 12 Louboutin v Van Haren Schoenen BV Case C-163/16 regarding “the colour red (Pantone 18 1663TP) applied to the sole of a shoe as shown (the contour of the shoe is not part of the trade mark but is intended to show the positioning of the mark)”
- 13 EU 2015/2436; Article 4 of Regulation (EU)2017/1001 on EU Trade Marks; s. 1 Trade Marks Act 1994 as amended by The Trade Marks Regulations 2018 (S.I. 2018/825)

PANTONE 248C

GERMAN  
REGISTRATION  
DE 305372726



Reproductions of  
colours are  
approximations only

Cadbury therefore filed three further applications in 2013 for the colour purple Pantone 2685C:

- applied to the whole visible surface of the packaging of the goods.
- applied to the packaging of the goods.
- without further description, ie a “pure Libertel” mark.

Nestlé opposed each of them as being contrary to s3(1)(a) and as lacking distinctiveness under s3(1)(b). The 3(1)(a) case has been heard first and the IPO has decided that the first description is acceptable, but that the second and third are not.<sup>11</sup>

The Hearing Officer referred to Libertel and Heidelberger as confirming that it is possible to register colours in the abstract without contours, and confirmed that none of the CJEU’s subsequent case law altered these findings. She said that a requirement for colours to be represented through a series of figurative or positional trade marks such as in Louboutin<sup>12</sup> would be contrary to Libertel and Heidelberger. However, she then refused registration of Cadbury’s “pure Libertel” mark because the representation did not “explain how the colour is used as a sign at all, whether it be on packaging, advertising materials or applied to the goods themselves”.

This contradiction is not assisted by the guidance in the IPO work manual, which confirms that there is no reason why, in principle, colours cannot be registered in the abstract, as opposed to specific applications of colour, such as being applied to the exterior of the goods themselves,

or to their packaging, but gives little guidance as to what would be an acceptable description.

It states only that:

“Applicants should consider whether the way colour is used forms an essential part of the subject matter of their trade mark. For example, if evidence of acquired distinctiveness is likely to show that a specific colour has come to be recognised as a trade mark when used in a particular manner (eg on the sides of the overhead canopy of a fuel service station), it may be advisable to define the mark in this way from the outset.”

That appears to be confusing colours – as contemplated in Libertel, without contours or spatial delimitation – with position marks where there is some spatial delimitation of the colour; or confusing the requirements of 3(1)(a) with 3(1)(b). Cadbury and Nestlé have each appealed, and these have yet to be heard.

Libertel and Heidelberger remain good law, despite the Advocate General in both cases (Leger) opining that both colours and combinations of colours in the abstract do not satisfy the conditions of Article 2 of the Directive. Not only did the CJEU decline to follow his opinions, but colours are specifically included

for the first time in Article 3 of the revised Trade Marks Directive.<sup>13</sup> Therefore it remains possible to register abstract colours that demonstrate the requisite distinctiveness. What is not clear – at least in the UK – is how such colours should be described.

In other territories of the EU, there appears to be no such concern. Abstract colour marks are accepted with a simple description of the colour and colour code. The colour purple Pantone 248C is registered as an EU trade mark by Mars Petcare for foodstuffs for cats without further description of the context of use. There are numerous registrations in Germany for single colours without any description of the context of use, including DE 305372726, described simply as “Verkehrspurpur RAL 4006”, which covers goods in class 17 (both examples shown above).

It seems that Brexit has come early to the UK, where the IPO takes a different approach to other EU Registries. Hopefully the latest appeals of Cadbury and Nestlé will clarify the position. In the meantime, more than 20 years after the first Cadbury Purple trade mark application was filed, we are still in a purple haze. ●

*The author has been assisting Cadbury in the protection of Cadbury Purple for more than 10 years.*



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# NOW HEAR THIS!

Carrie Bradley offers a baker's dozen of summer legal listening

Podcasts may now be considered a mainstream media format, but I was embarrassingly late to the party. To be honest, when I was asked to write an article on the subject of podcasts for the *CITMA Review* I wasn't sure how to download or access them, which player I needed, or even if they were free or required subscription fees.

Above all, I certainly had no idea just how rich the abundance of content on offer really was, ranging

from every genre of entertainment, to politics and culture, news and current affairs, and everything in between. The choice was a little overwhelming at first!

Of particular interest to me was my discovery of all the legal podcasts available, and specifically those that relate to IP, both from a legal practitioner's perspective, and also from a general commercial perspective, discussing innovation and entrepreneurship, marketing and branding, and much more. I now consider podcasts to be an

invaluable tool in staying current and up-to-date and, best of all, I love that I can learn from them during what might otherwise be "dead time", such as while driving or doing mundane household chores.

If you're also a newcomer to podcast listening, then I hope that this piece can persuade you to give them a try, as the rewards available certainly far outweigh the minimal effort needed to learn how to dive into this not-so-new form of media. For those who are already



“  
*I now consider podcasts to be an invaluable tool in staying current and up-to-date*

## 2. TRICKS OF THE TRADE(MARK)

This podcast is produced by Erik Pelton, a US Trade Mark Attorney (and ex-USPTO Examiner). Trade mark protection in the US is undoubtedly the focus of this series, and it is often aimed more at brand owners than IP practitioners, but it nonetheless provides some very useful insights on new developments in US law and practice that are interesting and helpful for UK/EU practitioners. The episodes are usually relatively short and make for easy listening.

## 3. IP FRIDAYS

This is a popular monthly IP podcast that offers insights and updates on developments in IP law and practice from guest speakers from all over the world, so it provides a nice mixed bag of interesting topics. While undoubtedly educational and aimed at IP practitioners, it's not unduly academic in its approach, which makes it an accessible listen. It frequently offers access to online resources, links and guides for listeners to read more about the subject matters discussed. All in all, a handy podcast to follow.

## 4. COPYRIGHT WAFFLE

There have only been eight episodes of this UK series to date, but it's a great little podcast that offers enjoyable chats with guests who are all professionally involved with copyright in some way or another. Past guests have included the Head of Rights & Licensing at the Copyright Licensing Agency. Produced by UK Copyright Literacy, it aims to get people interested in copyright and provides lighthearted insights into topical issues. ▶

well-versed in listening to podcasts, perhaps I can offer some new favourites for you to subscribe to.

For podcast newbies, here are a few podcast player apps and resources that you can easily download or that you may find already installed on your phone: Apple podcasts, Google Play, Spotify, Soundcloud, Castbox, Overcast, Pocket Casts, Stitcher and Podcast Go.

Most offer quick and easy access to the world of podcasts, and although some are more sophisticated than others, all feature searchable libraries for you to browse and through which to find topics of interest. Once you subscribe to a channel, the latest episode will be downloaded as soon as it is released and will appear in your favourites list. Here are a few of mine:

## 1. BRAND & NEW

This is a fortnightly podcast produced by the International Trademark Association and hosted by Audrey Dauvet. Innovation is the common theme, but the subject matter varies widely, covering all facets of topical IP issues. Recent examples of its episodes have discussed what's hot in domain name management, the AI revolution in India, and how to tackle counterfeiting in China, so the subject matter is less US-centric than many may expect. While it is not exclusively aimed at IP legal practitioners, the guest speakers provide informative updates and the insights shared will certainly help practitioners to stay current. Well worth a follow.



#### 5. JURISDICTION

This is an IP law podcast hosted by Don Cameron, an IP litigator based at the Toronto office of the Canadian IP firm Bereskin & Parr LLP. Each episode generally interviews a notable IP law practitioner about an article that they have published, or a recently litigated case. These discussions are high level and in depth, so the episodes are generally on the longer side. It is an excellent resource for competent legal insights and analysis, so it will certainly appeal to those with more of an academic interest in IP law, but the focus does seem to be mostly on US and Canadian IP litigation specifically.

#### 6. UK LAW WEEKLY

For those interested in keeping up-to-date on recent UK legal decisions and news, this weekly podcast will tick the box. It is not IP specific and instead provides topical updates on notable cases across all areas of law that have recently been heard in the UK courts. This makes it a great resource for law students and those keen to keep au fait with significant UK legal developments and talking points generally.

#### 7. THE DIGITAL EDGE

This podcast is for legal practitioners with a particular interest in news and developments in technology. Published monthly, it is part of the Legal Talk Network, and covers topics that it describes as being “at the intersection of law and technology”. The US hosts invite noted authors and speakers to discuss a wide range of technological insights with their listeners, ranging from (most recently) “how can chatbots help your law firm?” to “digital marketing tips for the solo and small-firm lawyer” and beyond.

#### 8. BEYOND BILLABLES

This is a weekly Australian podcast that describes itself as being “a show for lawyers or anyone seeking inspiration”. Each episode generally features an interview with a guest who is often in, or connected to, the legal profession. The conversations are lively and natural and share personal and professional stories that offer unique insights and experience in all areas of business life. It’s an enjoyable, down-to-earth podcast that genuinely offers great value for its listeners.

#### 9. HAPPY LAWYER, HAPPY LIFE

Another Australian podcast, this is produced by Clarissa Rayward, a family lawyer practising in Brisbane, and makes for great listening. *Happy Lawyer, Happy Life* describes itself as being “for lawyers who want to make the best of their life in and outside of law” and I’d agree that it certainly delivers. It offers relatable weekly interviews and energetic discussions on a wide variety of topics all relating to the realities of life as a legal professional – including managing your home/work life balance, managing stress in the workplace and generally how to build a legal career while still living a happy life. It’s an uplifting series that will help you to identify and achieve your own personal priorities.

#### 10. COMPOS MENTIS

*Compos Mentis* is another great resource that deals with well-being in the legal profession. Mental health challenges are discussed openly and with authenticity, and it offers practical solutions that lawyers can implement to help cope with anxiety, develop resilience, improve time management and practise mindfulness. There’s bound to be a new tip in there for everyone.

#### 11. MONETISING KNOWLEDGE

This is a non-legal podcast that will appeal to those with a general interest in business management and the ethos of working smarter, not harder. It offers insights across multiple fields on proven business strategies to leverage existing knowledge, experience and data, all from successful business people that have implemented them in the real world. Topics vary widely, including subjects such as licensing IP, app development, developing your business pitch, monetising social media, the implications of GDPR and many others. An all-round informative and topical general business interest podcast that’s well worth a listen.

#### 12. ON BRAND

Another non-legal podcast, but most Trade Mark Attorneys will likely find these general commercial brand-related insights interesting. Each weekly episode features an interview with a thought leader in the field of branding or a representative from a well-known brand. The discussions cover “on trend” issues relating to brand development, positioning and management, and they provide listeners with the latest social media and digital marketing news, trends and tips.

#### 13. UNINTELLECTUAL PROPERTY

As a fun wild-card suggestion, this is a lighthearted, entertaining podcast where three people who have “no business offering business advice” offer business advice to entrepreneurs. It comes with the disclaimer that they take zero responsibility for any advice given and that they have done no research at all to support their suggestions. Wild and creative business ideas are pitched by the hosts to their guests.



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# WAS IT SOMETHING I SAID

Nicholas D Wells and Allister McManus offer an analysis of the reasons and remedies for Madrid refusals at the USPTO

According to WIPO, approximately 95 per cent of trade mark applications filed in the US via the Madrid Protocol are initially rejected by the USPTO. After years of seeking to resolve these rejections for clients, many Trade Mark Attorneys have a sense of why they typically occur, but little objective evidence to add to the anecdotal. To help redress this gap, this article will provide analysis of the 1,651 Madrid-based applications filed at the USPTO during April 2015 and the factors that caused the USPTO to issue refusals (32,043 applications were filed directly during that month, so about five per cent of US applications came through the Madrid Protocol). The hope is that this will help make using the Madrid Protocol (and dealing with the USPTO) more efficient for our colleagues in future.

## A BIT OF BACKGROUND

As *CITMA Review* readers will likely know, the Madrid Protocol offers several advantages for trade mark owners who want to extend protection of their marks to multiple countries. These advantages include centralised management and the potential of lower costs by avoiding the use of foreign counsel. However, trade mark owners who use the Madrid Protocol to extend protection to the US may face unexpected challenges, specifically:

1. the inability to use the USPTO Supplemental Register if a mark is considered “merely descriptive”;
2. the inability to move incorrectly classified terms to the correct class in the application;
3. the inability to add classes if

- terms are incorrectly classified;
4. a lack of options regarding filing bases (only s66(a) of the US Trademark Act is possible for Madrid-based applications);
5. a weaker registration for enforcement purposes because use in commerce cannot be established prior to a dispute unless the registration is at least five years old;
6. the inability to make “non-material” changes to a mark, such as a redesigned logo, which the USPTO normally allows; and
7. the danger of missing deadlines. Namely, the USPTO imposes separate and distinct maintenance deadlines to that of the 10-year renewal period at WIPO. Specifically, an affidavit to declare

“ Trade mark owners who use the Madrid Protocol to extend protection to the US may face unexpected challenges



use of the mark must be filed between the fifth and sixth anniversary of the date of US registration (not the filing date); and between the ninth and 10th anniversary of the date of US registration and every 10 years thereafter.

Nevertheless, in 2018 approximately 1,500 trade mark applications from UK-based owners were filed in the US via the Madrid Protocol (4,500 were filed directly in the US).

#### METHODOLOGY

A few explanations about our approach are in order. We created a database of application serial numbers using this search string on the USPTO TESS database: 'fd > 20150400 < 20150500 and 66a[cb].

This search provides all records where the filing date is between the first and last days of April 2015, and which have a filing basis of 66a (which encompasses all Madrid-based filings

under the US Trademark Act). The refusals that we studied are not affected by whether the application or registration is still active, so this factor is not part of the search. We used applications from April 2015 because these applications are “settled”. We feared that using a recent month would leave open the possibility of changes to the status of applications that would make our results less relevant.

Of course, the current relevance of our study depends upon the USPTO being consistent over time in the reasons for refusing Madrid-based applications.

We have no reason to doubt that this is the case.

Our team studied the history of each of the 1,651 applications, noting whether an office action was issued. For each office action, our team reviewed the issues raised in that office action and tabulated those issues, along with other details about each application.

### THE RAW RESULTS:

**93% of applications were refused**  
– 1,536 of 1,651.

**86 days median delay between filing and database appearance** considering the number of days that passed between the official filing date and the date when the application appeared in the USPTO database.

**110 days median delay between official filing date and first office action** which compares favourably with the norm stated by the USPTO that applications are examined 90 days after filing. The median delay between the time an application was made available in the USPTO database and the date of the first office action on that application was 18 days.

**75% (1,236) of applications were registered**  
– 415 were abandoned.

**65% (1,071) were applications for standard character marks.**

**2.37 classes in each application on average.**

**2.57 bases of refusal cited** on average; the median number was 2.

**16 common bases of refusal** with an “Other” category providing a catch-all for the unusual cases. See page 25 for details. Those bases that are more heavily shaded generally require a legal brief to overcome and are more likely to result in no registration; those that are not are often easily addressed. But they must be addressed or the application will be abandoned! Column three contains the percentages of refusals based on each refusal basis. Because one office action usually had multiple bases of refusal, the percentages do not total 100.

## **IMPROVING THE ODDS – DOS AND DON'TS**

It is not feasible to expect that all refusals from the USPTO can be avoided. US trade mark examiners are very particular but not very predictable; they often require very minor issues to be resolved before an application can proceed. These issues cannot easily be foreseen without significant experience with US examiners. However, the chance of refusals and the effort required to resolve those refusals can potentially be mitigated by giving attention to the most likely causes of refusal. Below are some recommendations for dealing with each of the refusal bases that occur in more than 10 per cent of Madrid-based applications filed in the US.

### **ID/SPECIFICATION**

#### **Don't use class headings**

As all experienced UK/EU and US attorneys can attest, the USPTO is infamous for the specificity that it requires in a description of goods and services. This is clearly in contrast to the UK and EU, and it is therefore important that clients understand this difference in approach from the outset. Avoid class headings and overly broad terms, and qualify terms such as software, media, DVDs, downloadable files, books, clothing, machines, system, kit, beverages, training, etc, as these will inevitably face an objection and incur costs for clients that could be avoided.

#### **Do use online resources to check what is acceptable**

Useful resources include [bit.ly/451\\_USPTOID](http://bit.ly/451_USPTOID) and [bit.ly/451\\_TMclass](http://bit.ly/451_TMclass), known as TMclass (with USPTO terms only selected). As these are all pre-approved terms, you can be confident that the USPTO is very likely to accept them.

#### **Do search for other published applications or registrations for similar existing terms that have been accepted**

This can also assist, particularly if the registration or application you are reviewing belongs to a competitor offering the same or

*“ Approximately 95 per cent of trade mark applications filed in the United States via the Madrid Protocol are initially rejected by the USPTO*

similar products and services. You can then cross-reference this with searching the above-mentioned classification databases.

### **PRIOR REGISTRATIONS**

#### **Do conflict searches**

Some level of trade mark register searching is always advisable prior to filing. Even a basic check of the USPTO register by a US attorney with some comments can help to identify any obvious conflicts with earlier marks that are likely to result in a refusal and delayed registration, or no registration at all.

### **DISCLAIMERS**

#### **Do consider what words are descriptive**

The USPTO is particular when it comes to marks that feature general descriptive words. You should therefore ensure that you use the appropriate USPTO language, for example: “No claim is made to the exclusive right to use CORPORATION apart from the mark as shown”.

### **TRANSLATIONS**

#### **Do include translations**

If a word is in a foreign language, or you suspect it may look like one to an examiner, add a translation. Alternatively, you can state that the word “has no meaning in a foreign language”. You should also exercise caution with regard to foreign language words in the context of the USPTO's search for earlier rights. For example, the mark LINTU may prompt the USPTO to note that it is the Finnish word for BIRD, and cite earlier marks containing “BIRD”. The USPTO has linguists and uses Google Translate and other resources.

### **MARK SIGNIFICANCE**

#### **Do add an explanation**

If you think an examiner may suspect a word is descriptive, add in this format: “[word] appearing in the mark has no significance nor is it a term of art

in the relevant trade or industry or as used in connection with the goods/services/collective membership organisation listed in the application, or any geographical significance.”

### **ENTITIES**

#### **Don't specify the place of registration as England and Wales, or Scotland**

Use United Kingdom instead.

#### **Do use a designation in this format:**

- “Applicant is an individual, citizen of France” (for example)
- “Applicant is a company registered in the UK” (ie when the applicant is a public limited company)
- “Applicant is a limited liability company registered in the Netherlands” (ie when the applicant is a Besloten Vennootschap).

The USPTO requires that the nature of the owner be specified, as well as the place of registration. Only certain entity types are permitted, though the permitted list includes many foreign entity types. Using an entity type that is equivalent to a US entity type is common: corporation and limited liability company are the most frequently seen.

### **INCREASED BENEFIT**

The benefits of using the Madrid Protocol to enter the US are greatly diminished when 93 per cent of applications require intervention by a US-licensed attorney. We believe that by understanding which issues are most likely to result in a refusal and how US examiners' expectations can be met when designating the US in a Madrid-based application, the prevalence of refusals can be reduced, as can the number and difficulty of the issues that must be dealt with in the refusals that still occur. By doing so, clients can achieve more fully the potential benefits of the Madrid Protocol.



## EXPLANATION OF REFUSAL BASES/OCCURRENCE OF REFUSALS

Basis of refusal	Explanation and comment	Percentage of occurrence
Section 2(d)	Likelihood of confusion with pre-existing registrations	20.77. For those applications that were refused on this basis, the average number of earlier registrations cited by the examiner was 2.48.
Section 2(e)-general	Refused as a “merely descriptive” mark, lacking distinctive character	2.73
Section 2(e)-surname	A sub-type of merely descriptive marks are those that are considered lacking distinctive character because they are likely to be regarded by consumers as merely surnames	1.76
Section 2(e)-geographic term	A sub-type of merely descriptive marks are those that are considered lacking distinctive character because they are likely to be regarded by consumers as merely geographic terms	0.59
Prior applications	Earlier filed applications pose a risk of a likelihood of confusion, if they were to eventually register	5.08
ID	Description of goods/recitation of services	88.41
Information request	The examiner requires answers to specific questions about the applicant’s goods and services in order to fully examine the application (these typically arise when a mark is suspected of being merely descriptive or of requiring a disclaimer)	6.25
Individual consent required	The mark appears to contain the name of an individual, whose written consent must be submitted	3.06
Translation	A term within the mark is suspected to be a foreign word and a full or correct translation was not provided	11.39
Disclaimer	Exclusive rights to a portion of the mark must be disclaimed (given up) because that portion is descriptive or generic	22.01
Mark description	For design marks, a textual description of the mark was missing or incomplete	39.58
Entity issues	The ownership of the mark was not properly set forth	22.53
Colour issues	For design marks, the colours of the mark were not fully or properly set forth	7.36
New drawing required	For design marks, a new drawing of the mark is required, usually because the drawing originally submitted was low resolution or included a Circle-R symbol	2.47
Mark significance	The examiner suspects that a term is descriptive and requires a statement regarding any significance of a word within the applicant’s industry	20.83
Other	A grab-bag of unusual refusals, which include: lack of intent to use the mark; merely a model designation; false suggestion of connection with a famous person; query regarding use of mark as a varietal; duplicate registration; deceptive terms; use of a non-US attorney	



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# BIG CHANGE IN CHINA

Following a CITMA webinar on the subject, Nina Li guides us through the new environment for trade mark protection in China

By 2018, China had been ranked first in the world for the number of new trade mark applications for 16 consecutive years. In the meantime, the Chinese Trademark Law and the practice at the China Trade Mark Office (CTMO) have also gone through various changes, of which the following are perhaps the most notable.

### **PRACTICE CHANGES AT THE CHINA OFFICE**

On 10th April 2018, the new State Market Supervision and Administration Bureau was officially established. It governs the National Intellectual Property Administration, PRC (CNIPA), which has both patent management functions and trade mark management functions. In the past decades, trade mark matters were managed by the CTMO under the State Administration for Industry and Commerce (SAIC) and patent matters were managed by State Intellectual Property Office (SIPO).

In 2018, the examination speed on all kinds of cases, especially new national trade mark applications, e-correspondence between the office and trade mark agents, as well as some other trade mark matters, has significantly improved.

### **CRACKING DOWN ON BAD FAITH**

According to the CNIPA, more than 7.3 million new national trade mark applications were filed in China in 2018. The large number not only shows the importance of the Chinese market but also reflects the problem of bad faith applications.

According to a CNIPA press release, more than 100,000 abnormal trade mark applications were rejected in 2018. The rejections of 24 bad faith applications for marks that are identical to BENTLEY and the B device of the famous car manufacturer, Bentley Motors Ltd, and an invalidation case of a mark similar to BOSCH, are good examples showing the CNIPA's efforts.

As bad faith is a subjective matter, it has been a big challenge to prove it in the past unless the applicant squatted hundreds or even thousands of marks. However, recent experience on opposition cases showed that the threshold to prove bad faith seemed to have been significantly lowered.

### **CHANGES TO TRADE MARK LAW**

In February 2019, CNIPA published Draft Regulations against abnormal applications for comments. The Draft Regulations contain eight articles and clearly state the forms of abnormal applications, how to deal with such applications according to the Trademark Law, and Regulations for the Implementation of the Trademark Law and other methods that can be taken against them.

In addition, the fourth amendment to the Chinese Trademark Law will take effect on 1st November 2019. According to the amendment, trade marks applied for but not intended for use purpose and in bad faith should be



## “ More than 7.3 million new trade mark applications were filed in China in 2018

rejected. It also becomes a ground that can be relied on in opposition and invalidation cases. The maximum amount of damages on trade mark infringement has been increased from RMB 3 million to 5 million yuan.

### ADMINISTRATIVE ACTION

As the Government pays more and more attention to IP protection in China, authorities at different levels are also working in this direction.

When a trade mark owner becomes aware of infringement on its mark, it can bring a lawsuit to people's court, as in many other countries. In addition, China has a unique administrative organ to enforce registered trade marks, the Administration for Market Regulation (AMR), which has the functions of the former Administration for Industry and Commerce (AIC). The trade mark right-holder or an interested party may request that the AMR addresses the dispute.

Late last year, the former Beijing AIC (BAIC) announced some of the typical trade mark violation cases it handled. One case related to running shoes of the Japanese company ASICS Corporation is one of the largest in the past 20 years. According to the related articles of the Trademark Law, the BAIC Fengtai Branch has ordered the infringer, a Beijing company, to immediately cease the infringing acts, has confiscated the infringing running shoes, and has imposed a fine of over £6m, which is five times the

company's illegal business revenue. The fine will go to the Government.

### OEM DISPUTES

During recent years there has been argument over whether use of trade mark in original equipment manufacturer (OEM) production should be deemed as infringement and different courts hold different opinions.

Last year, the Supreme People's Court published a retrial judgment in a trade mark dispute in OEM production. The Plaintiff, Shanghai Diesel Engine Co., Ltd., owns three marks registered last century. Two of them are live marks and were recognised as well-known marks in 2000.

The Defendant is a company from Jiangsu province, which is quite near to the Plaintiff geographically. It is engaged in OEM production of diesel engines exported to Indonesia. The mark used on these diesel engines is identical with the Plaintiff's registered trade marks in China. The consigner of the OEM production is an Indonesian company that holds

the registered trade mark right for the same mark in Indonesia.

In the first instance, Changzhou Intermediate People's Court considered that OEM production doesn't constitute use of trade mark as stipulated in the Trademark Law, and thus doesn't constitute infringement on the Plaintiff's trade mark right in China. In the second instance, the Jiangsu Higher People's Court considered it constituted trade mark infringement.

In the retrial procedure, the Supreme People's Court considered trade mark use in OEM production by the Defendant didn't infringe the Chinese trade mark right owned by the Plaintiff. Thus, the judgment of the second instance was revoked and the judgment of the first instance was maintained. Since this judgment was made by the Supreme People's Court, it has directive meaning for later similar cases. However, for non-use cancellation cases, according to current practice, trade mark use in OEM production can be considered as actual use.

### FURTHER PROGRESS EXPECTED

Although the trade mark protection system in China is far from being perfect, it continues to progress in a positive direction. It is reasonable to believe that more improvement is on the way.



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# Trump grabs High Court

Aaron Wood welcomes a move to giving detailed explanations on more than one ground

**The case was** an appeal by one of the Gleissner companies (Trump International Ltd, TIL) to a decision by the UK IPO to refuse the registration of the mark TRUMP TV for services in classes 38 and 41 in light of opposition by DTTM Operations LLC, the body representing the interests of Donald Trump. The UK IPO decided that the trade mark had been filed in bad faith and did not therefore go on to consider the other grounds of opposition raised by the opponent, namely s5(2), 5(3) and 5(4) EUTMR.

The appeal raised two grounds:

1. that the Hearing Officer (HO) had made a mistake of law in concluding on the basis of the evidence filed that the mark was filed in bad faith; and
2. alternatively, that permission should be given to adduce new evidence and the opposition should fail on that further evidence.

## APPEAL DECISION

Turning first to the relevant test, Mr Justice Carr relied upon the now common dicta of Daniel Alexander QC from case O/017/17 TT Education Ltd v Pie Corbett Consultancy Ltd, which was subsequently approved by Mr Justice Arnold in *Apple Inc v Arcadia Trading Ltd* [2017] EWHC 440 (Ch).

The alleged mistakes of law were threefold:

1. alleged bias in taking into account prior decisions and concluding that Mr Gleissner is a “bad apple” and thus failing to fully examine the case under s3(6);
2. failure to consider the other grounds even though they were taken into account for costs; and
3. a failure to stay the case pending the outcome in *Sky plc and Ors v Skykick UK Ltd and Anor* [2018] EWHC 155.

On the first question, Carr J considered the relevant law on the questions of bias and similar fact evidence, noting in relation to the latter that direct evidence of bad faith was unusual and that (as with an allegation of copying) it was well established that similar

fact evidence was probative and useful. He held that it was unsustainable that the HO was biased, and that he would have found an allegation that the HO relied upon inadmissible material was equally unsustainable: the HO was correct to rely upon the similar fact evidence from prior cases, had taken account of the specifics of the case, and had concluded correctly that the evidence had overcome the prima facie assumption of good faith. Since there was no evidence from TIL to positively explain its intentions, the conclusion of bad faith was correct.

Importantly, and of particular note, the judge had this to say about future applications by Mr Gleissner’s companies:

“[If an] application is in respect of a sign which is identical or similar to a mark owned by a third party, of which there are many examples in the evidence, then [Mr Gleissner] is right to be concerned. Such applications should not be made in the future, whether by Mr Gleissner or by companies which he controls.”

As to the allegation that there was a failure to consider the other grounds, Carr J concluded that this would not have improved TIL’s position. It appeared that these would also have been successful. He did, however, comment that while he had sympathy for the position that it was not necessary to give a decision on the other grounds, he felt the HO could and should have expressed his views briefly in a few paragraphs.

As to the final point relating to *Skykick*, Carr J noted that TIL had already unsuccessfully applied for a stay pending the outcome in *Skykick*. This was refused because the basis for the bad faith claim was not the making of

“ *The UK IPO decided that the trade mark had been filed in bad faith and did not go on to consider the other grounds of opposition* ”



a false statement of intent to use the mark, and consequently Skykick was not relevant.

As to the alternative claim, that there should be permission to rely upon new evidence, this was refused by Carr J on the basis of the *Ladd v Marshall* principles, as was the decision in *Consolidated Developments Ltd v Cooper* [2018] EWHC 1727 (Ch) (6th July 2018). The new evidence could have been provided sooner, did not improve TIL's case substantially, was not credible and would have required the remission of the case to the UK IPO.

Finally, following intervention from the Comptroller General of Patents, Designs and Trade Marks, Carr J gave various comments on how one may alleviate the issues caused by Mr Gleissner's activities, including strike out of defences before the UK IPO and noting that the declaration under s32(3) may give rise to a cause of action under the Trade Marks Act 1994 and passing off and that the Court may give a non-party costs order in suitable cases.

#### COMBAT TRAINING

The case is interesting for a number of reasons, not least the comments on what affected parties may wish to consider to combat Mr Gleissner's companies. It also suggests that the UK IPO reconsider its practice of not giving decisions on all grounds for reasons of procedural economy. In *O/203/19 BE INSPIRED GYMS*, the Appointed Person Mr Daniel Alexander made similar recommendations at paragraphs 17-24, adding that the failure to consider all the grounds may mean that a decision on costs fails to take into account the work done on grounds for which there is no decision.

These comments seem helpful: many practitioners will have encountered an appellant who is appealing a decision made on a single ground and rue that the limited basis has given an inappropriately rosy hue to a case that is hopeless overall. The existing practice also seems problematic when one considers that a party may use up much of a hearing and incur substantial costs running an undecided s5(3) ground and "win" on s5(2). There is a strong argument that in such a case the award should be reduced if the s5(3) ground would have failed or be awarded even if the evidence was not needed for the s5(2) case.

#### KEY POINTS

Similar-fact evidence is of relevance in bad faith cases, where direct evidence of bad faith is very unusual

Alongside trade mark oppositions, trade mark owners should consider alternative remedies

There is a high bar to cross to be able to raise new evidence on appeal



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# Appeal has no power

Chris Thomas recounts the reasoning behind the judge's support of the HO

## KEY POINTS

While the MANPOWER word mark was descriptive, it was held to have acquired distinctiveness through reputation to create a link in the minds of the public even where MDUK was providing different services

It is the full range of services for which an applicant seeks registration of a mark and not just the services provided under the mark that should be considered when determining whether there is likely to be a detriment/unfair advantage

Competing marks do not have to be registered for identical/similar services to establish a detriment/unfair advantage provided there is a link

**In a judgment** handed down on 11th April 2019, Mr Justice Birss ruled on an appeal from a decision (Decision) of the UK Trade Mark Registry (Registrar) brought by the Appellant, Manpower Direct (UK) Ltd (MDUK). Manpower Group Inc (MPI) was the Respondent to the appeal.

The judgment considers the principles applicable in cases involving grounds of opposition under s5(3) of the Trade Marks Act 1994 (TMA), which states: "a trade mark which is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".

## BACKSTORY

MDUK provides security services in the UK and has done so since 2003. In 2016, MDUK applied to register five word and device marks (the MDUK Marks) featuring the word MANPOWER in classes 45 (for a range of security services) and 37 (installation of CCTV). The Opponent was MPI, a large-scale provider of temporary and permanent employment placements and recruitment services, which has operated in the UK since 1956. MPI opposed registration of the MDUK Marks based on a prior UK registration on 8th September 1995 for the word MANPOWER in class 35 (recruitment and provision of staff) (the MPI Trade Mark).

MPI based its opposition on s5(3) TMA and claimed that registration of the MDUK Marks would take unfair advantage of the reputation in the MPI Trade Mark. Ms Skilton, the Hearing Officer (HO) upheld the opposition and refused registration of the MDUK Marks.

MDUK advanced three grounds of appeal, which were considered by Birss J:

1. the HO had wrongly focused on the services offered by MDUK and not the full scope of the services applied for;
2. the HO failed to address the issue of due cause under s5(3);
3. the HO was wrong to find that MDUK's evidence was not sufficient to establish honest concurrent use.

## JUDGMENT IN SUMMARY

The appeal was dismissed. On ground one, Birss J was satisfied the HO had considered the services applied for and not just those in use by MDUK. The HO did not have to separately set



out the issue of due cause when considering the s5(3) opposition. The HO made a finding of fact in relation to ground three that evidence of honest concurrent use fell “a long way short” of the required standard.

The HO’s decision was reviewed in detail by Birss J, who believed the HO had applied the correct test, which was “to determine which services MPI’s reputation was based on and in the light of those findings to determine whether the use of MDUK’s marks across the full range of services contained within its specifications would cause confusion, damage or take advantage”.

He also found that:

- It was open to the HO to find that MPI had established a strong reputation in the UK in relation to the recruitment and provision of staff under the word MANPOWER and that none of the distinguishing characteristics of the MDUK Marks altered the use of this brand message.
- The HO correctly applied Intel, requiring that a link must be established between the marks in the minds of the public. The factors to take into account include: the degree of similarity between the conflicting marks; the nature of the goods or services for which the conflicting marks were registered; the strength of the earlier mark’s reputation; the degree of the earlier mark’s distinctive character, whether inherent or acquired through use; and the existence of the likelihood of confusion on the part of the public.
- It was open for the HO to find that the MDUK Marks and the MPI Trade Mark were similar and that the dominant

“ *The HO’s decision was reviewed by Birss J, who believed the HO had applied the correct test* ”

element of the MDUK Marks was the word MANPOWER.

- The HO was entitled to find that the level of reputation in the MPI Trade Mark was such that it was highly distinctive of MPI’s services even though the word MANPOWER was descriptive.
- The HO did not need to establish that the services covered by the MDUK Marks and MPI Trade Mark were similar/identical where as a consequence of the highly distinctive character and reputation of the TMI Trade Mark, customers would still make a link between the two.
- The HO correctly considered the test for establishing detriment/unfair advantage as set out in *Aktieselskabet af 21. november 2001 v OHIM*, Case C-197/07P: an applicant does not have to establish actual injury but a risk of a link that is not merely hypothetical.



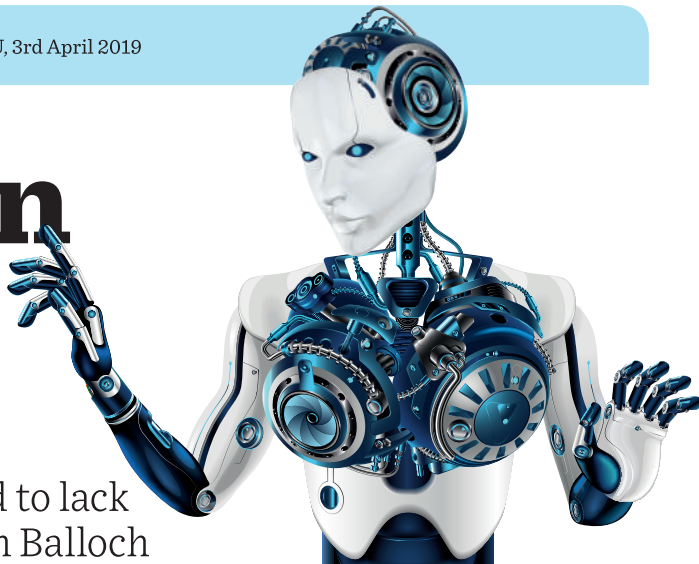
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# More than meets the AI?

An advertising slogan was found to lack a compelling link, writes Duncan Balloch



**Medrobotics Corp** is a private US company that manufactures and sells surgical products incorporating robotic technology. In September 2017, it filed an application at EUIPO for “SEE MORE. REACH MORE. TREAT MORE” covering class 10 goods (medical/surgical devices).

The application was rejected under Article 7(1)(b) EUTMR on the grounds that the mark was devoid of distinctive character. Medrobotics appealed this decision and the appeal was dismissed by the Second Board of Appeal (BoA) of EUIPO in July 2018 on the findings that:

- the goods were intended for a professional, English-speaking public;
- the mark’s structure and language were simple and would be understood literally; and
- there was nothing about the mark beyond its obvious promotional meaning that would enable the relevant public to recognise it as a distinctive trade mark for the goods covered.

Medrobotics argued that the mark would be perceived as a promotional message but only in a subliminal manner because the mark only mildly resonated with the specified goods. Consequently, the mark wouldn’t be immediately deemed a promotional message.

## RELEVANT PUBLIC

Slogans are not generally excluded from registration so long as they are perceived by the relevant public as an indication of commercial origin for the goods or services – the mark VORSPRUNG DURCH TECHNIK has such a function for Audi’s purposes.

There was no question here that the relevant public was a professional, English-speaking

public; however, following the BoA’s decision and in line with recent case law, the Court held that the level of attention would be relatively low when it comes to promotional indications regardless of the “type” of public in question.

## STRUCTURE AND REPETITION

Medrobotics argued unsuccessfully that the slogan had an unusual and incorrect structure as it omitted pronouns, an article and an exclamation mark, with only a weak connection existing between the mark and the goods.

The Court held that the mark, in line with the goods specified, could be immediately understood by the relevant public.

The argument that the brevity, originality and conciseness of the mark amounted to more than an ordinary advertising message was rejected by the Court, which

also found that the repetition of the adverb “more” is a common feature in advertising.

The Court held that this mark was unlikely to trigger a cognitive process in the minds of the relevant public given its clear meaning. The action was dismissed in its entirety.

It is clear from this case that there is still some difficulty in registering slogans when they lack an original element or elicit a link, even a weak one, between the mark and the goods.

## KEY POINTS

- Assessing distinctiveness in slogans is no stricter than for other signs, but the mere absence of information about the nature of the goods concerned is not sufficient for distinctiveness
- Slogan marks may require “striking features” or an “unusual element” beyond simple word repetition
- The attention of even a professional relevant public may be low if the mark is seen as a promotional indication

“

*The mark only mildly resonated with the specified goods*



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# White fight

Tom Coop considers arguments about colour in a common consumer category

## KEY POINTS

✦  
The BoA held the colour white could be an essential characteristic for kitchen equipment. The GC disagreed and held white was not an intrinsic characteristic inherent to the nature of kitchen goods

✦  
Nuance must be considered in assessing the descriptive nature of a trade mark in the context of the relevant goods, and arguably not for colour alone

✦  
The mark must describe an intrinsic characteristic linked to the goods

**This case was** an appeal to the General Court (GC) by Fissler GMBH (Fissler) against a decision of the EUIPO Fifth Board of Appeal (BoA) to refuse registration of the word mark “VITA” for the goods “food processors, electric; pressure cookers, electric; household or kitchen utensils and containers; cooking pot sets; pressure cookers, non-electric; and parts and accessories for the above goods” in classes 7, 11 and 21 (referred to hereafter as “kitchen equipment”). “Vita” is a Swedish adjective meaning “white” in plural form. The GC disagreed with the assessment of the BoA on both descriptiveness and distinctiveness and provided an interesting insight into the acceptability of colour names as trade marks.

## DESCRIPTIVENESS REFUSAL

The GC considered the two bases on which the BoA refused the application on descriptiveness grounds: (i) that kitchen equipment is commonly available in white; and (ii) these goods would be considered to fall in the category of white goods (“vitvaror” in Swedish).

The BoA had taken the view that the colour white could be an essential characteristic for kitchen equipment, as the mark would likely be understood to indicate the goods are completely or mainly white. The GC disagreed. White was held not to be an intrinsic characteristic inherent to the nature of kitchen goods, but a random and incidental aspect that does not have any direct link with their nature. This was contrasted with prior decisions involving trade marks conveying the impression of the colour white, such as “VISIBLE WHITE” for toothpaste and mouthwash and “TRUEWHITE” for LED lights. In these instances, the signs described an intrinsic characteristic linked to the function of the goods that was not apparent for Fissler’s mark “VITA” in relation to kitchen equipment.

The BoA had also taken the view that the kitchen equipment would fall within the known category of white goods and this reinforced the descriptive nature of the mark. Again, the GC disagreed with this assessment for two reasons. First, the application was for “vita” not “vitvaror”. Second, the application covered small household electrical appliances, rather than those considered by Swedish consumers to be white goods, ie large appliances such as fridges. The link was held to be sufficiently indirect for an objection based on descriptiveness to apply. The GC therefore agreed that the BoA had infringed Article 7(1)(c) EUTMR and upheld the appeal under this plea.

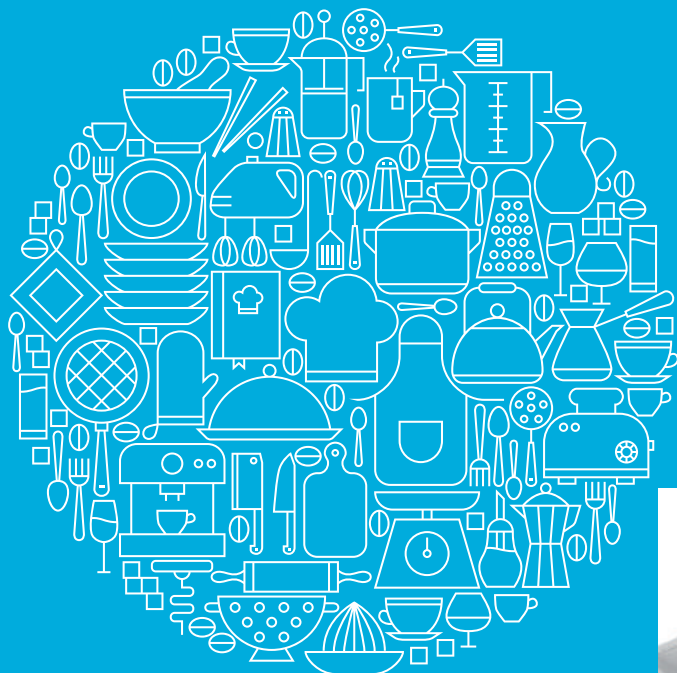
## NON-DISTINCTIVENESS

As the BoA’s decision found the mark to be non-distinctive exclusively as a consequence of its alleged descriptiveness, the GC held that the refusal based on Article 7(1)(b) EUTMR was unfounded.

The appeal was therefore upheld in its entirety and the contested decision annulled.

## NUANCE

This decision highlights the nuances that must be taken into consideration when assessing the descriptive nature of a trade mark in the context of the relevant goods, and arguably not for colour alone. It establishes that the mere fact some goods might have a particular colour is not sufficient and the mark must describe an intrinsic characteristic linked to the goods.



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# Multiplication problem

An error was made on the assessment of elements, says Leanne Gulliver

**The General Court (GC)** has upheld Sona Nutrition Ltd's (Sona's) opposition against Solgar Holdings Inc's (Solgar's) EUTM applications, finding that the Board of Appeal (BoA) had erred in law when assessing the distinctiveness of the marks.

## BEGINNINGS

In February 2015, Solgar applied to register four EUTM applications (shown right) for “vitamins; dietetic substances; food for babies; pharmaceutical preparations; herbal preparations; all for human use” in class 5 (the Applications).

In June 2015, Sona opposed the Applications on the basis that, contrary to Article 8(1)(b) of Regulation (EU) 2017/1001, the Applications were confusingly similar to its earlier Irish trade mark No 161365 for the word mark MULTIPLUS, registered on 27th November 1995 for “vitamins, minerals, nutritional supplements, dietetic products and tonics”.

At first instance, the Opposition Division rejected the oppositions in their entirety on the ground that the signs at issue were dissimilar. Sona appealed to the BoA.

## BOA ASSESSMENT

The BoA held that the signs at issue, considered as a whole, were dissimilar, and subsequently dismissed the appeals. In its assessment the BoA held that the element “multiplus” in the applied-for signs was non-distinctive for the goods at issue since they include multivitamin and multi-mineral supplements. As result, in spite of its size and position in the signs, it was not the dominant element in the Applications. The BoA took the view that consumers would pay more attention to the figurative element “Solgar”.

Following the judgment in Formula One Licensing v OHIM (C-196/11 P), despite the potentially descriptive nature of the element

“multiplus”, the BoA found that the earlier national Irish mark had at least a certain degree of distinctiveness and that therefore, considered as a whole, the earlier mark had a very low degree. While the term “multiplus” constitutes the only element of the earlier mark, and has some independent distinctive character because it has been registered, it cannot be regarded as having such a high degree of distinctiveness that it gives rise to an unconditional right to oppose the registration of every later trade mark in which it appears (Deutsche Post v OHIM – Post NL Holdings, T-102/14).

## GC DECISION

Sona subsequently appealed the contested decisions to the GC.

When assessing the similarity between two marks, the GC recognised that the comparison must be made by examining each of the marks in question as a whole, which included all

of the elements of figurative marks comprising the Applications, including the typeface, colour and size of the font, colour and shading of the background, the inclusion of the word SOLGAR in a circular logo, and the addition of “since 1947”.

In describing the element “multiplus” in the Applications as being devoid of distinctive character, the BoA erred in law. The BoA should have accorded the element “multiplus” at least a very low degree of distinctiveness. This error marred all of the BoA's reasoning. As a result, the GC upheld the appeal, and dismissed the contested decisions from the BoA.



### Leanne Gulliver

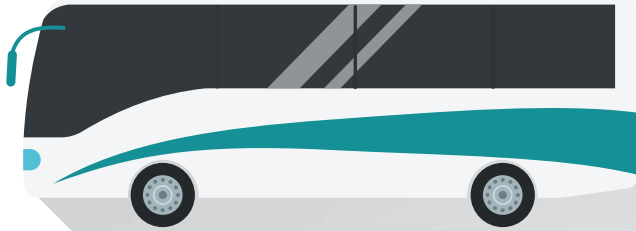
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## KEY POINTS

- ✦ The global assessment of the likelihood of confusion is based on the overall impression given by the signs bearing in mind their distinctive and dominant elements
- ✦ The comparison must be made by examining each of the marks in question as a whole
- ✦ A national mark on which an opposition is based has a certain degree of distinctiveness

## THE SOLGAR APPLICATIONS





# What a bus-tup

Sarah Williams sorts the facts in a Birmingham-based dispute

**On 23rd March 2017**, Thandi Coaches Ltd (TCL, the Applicant) applied to register Thandi Executive Coaches and Thandi Coaches for a selection of services in class 39. The applications were opposed by Amardeep Thandi (AT) on the basis of his earlier UK registration No 2389858 for THANDI covering services also in class 39. The UK registration was later assigned to Mibbo Singh Thandi (MST) and the grounds were subsequently amended to include:

- s5(2)(b) – similar marks and similar services, therefore a likelihood of confusion would exist;
- s3(6) – bad faith on the grounds that AT’s father was a founding partner of Thandi Coaches and that, as part of the deed of dissolution, the Applicant (and his family) had no right to use the name; and
- s5(4)(a) – passing off due to AT’s use of THANDI COACHES since May 1985.

As part of its defence, the Applicant alleged that the name THANDI was first used by an unincorporated business comprised of three brothers, one of whom was the Opponent’s father and another the father of the sole director of the Applicant, Suki Singh (SS). This business was liquidated in 1991 and the assets auctioned off.

A new business, THANDI COACHES, was incorporated by SS in 2011 offering services also within class 39. TCL also trades under a second company, Thandi Transport Ltd, which operates local bus routes. TCL and MST both operate from depots in Birmingham and have done so for many years. The Applicant states that MST has been fully aware of its use for many years and has never objected.

On 26th January 2018 SS applied to invalidate MST’s registration. The action was based on the following:

- s5(4) – SS has used THANDI COACHES since

1992 and has acquired goodwill and reputation in the name; and

- s3(6) – AT would have been aware of the use of THANDI by SS and therefore the mark was registered in bad faith.

As part of the consolidated proceedings, both parties filed evidence and asked for an award of costs.

The invalidity matter failed on both grounds. In connection with passing off, it was noted that through the evidence filed both parties had a period of cooperation and coexistence and have shown existence of concurrent goodwill, and it appeared that SS has accepted MST has a right to use THANDI.

The oppositions based on s5(2) failed as the Opponent did not provide sufficient proof of use of the mark. Following the usual similarity test under the likelihood of confusion (without any further factors) the oppositions would have been deemed a success. However, the Registrar decided that given the “peaceful coexistence” and a lack of misrepresentation, the oppositions under s5(4) and s3(6) also failed. Given that there was an element of “success” on both sides, neither side was awarded costs.

This case serves as a good reminder of the factors that should be taken into consideration when using the grounds of bad faith. Given that SS had previously colluded with MST regarding the use of THANDI in the 90s with effective consent from SS, he cannot contend that the mark was later filed in bad faith.

## KEY POINTS

- ✦ Be careful when preparing and filing evidence and arguing opposite cases in cross oppositions/invalidity proceedings
- ✦ A lack of objection to the historic use of a mark may prevent an opponent from being able to prevent the registration of an otherwise confusingly similar mark



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# Opponent comes up Blanc



Once again, the difference between beer and spirits was a decider, notes Gavin Stenton

The UK IPO has resolved a dispute between two alcoholic drinks manufacturers over the use of the mark MONT BLANC. James Duncan Abbott (the Applicant) applied to register the mark MONT BLANC WHISKY/MONT BLANC WHISKIES in respect of “whiskies” in class 33, prompting Alpes Marques (the Opponent) to oppose relying on two senior registrations (both shown right). First, a UK designation under an International registration for the mark MONT BLANC covering “beers” in class 32; second, a UK registration for the mark MONT BLANC Whisky covering “alcoholic beverages, whiskies” in class 33. In response, the Applicant applied to revoke both marks for non-use.

## REVOCATION PROCEEDINGS

The Hearing Officer (HO) criticised the “very poor” evidence of use submitted in relation to the Opponent’s MONT BLANC mark, in particular the lack of explanation of the products and invoices provided. The HO also criticised the failure to provide overall figures for sales or details of advertising in the UK, citing established case law. Nevertheless, the HO ultimately accepted that the Opponent’s MONT BLANC mark had been put to genuine use in the UK in relation to beers, and the revocation application was dismissed.

No evidence was provided of use of the Opponent’s MONT BLANC Whisky mark. The HO concluded that the proven use of the Opponent’s MONT BLANC mark in relation to beer was insufficient to establish genuine

use of the Opponent’s MONT BLANC Whisky mark in relation to whisky. The Opponent asserted that it intended to open a whisky distillery, and had purchased equipment and raw materials for this purpose, even having had a label designed for the whisky bottles. However, in the absence of any advertising or indication of plans to launch a product imminently, the HO dismissed the evidence, upholding the revocation application.

## OPPOSITION PROCEEDINGS

The HO found the Applicant’s MONT BLANC WHISKY/MONT BLANC WHISKIES marks to be “highly similar, almost identical” to the Opponent’s MONT BLANC mark, noting that the descriptive element WHISKY/WHISKIES would have no distinctive value in relation to whisky-related products.

However, in comparing beer and whisky, the HO found there to be no similarity, citing past decisions comparing rum with wine and tequila with beer. This finding appears to be at odds with the majority of previous UK and EU decisions. Despite the significant similarities between the marks, with no similarity between the goods there could be no likelihood of confusion.

Having found there to be no likelihood of confusion, the HO concluded that the use of the Applicant’s mark in relation to whisky would not cause a misrepresentation and there could not therefore be passing off. The opposition was dismissed.

## KEY POINTS

- ✦ In revocation proceedings, the burden lies with the proprietor to establish use. Proprietors should always accompany evidence of use with a witness statement explaining the evidence that has been filed
- ✦ The mere intention to launch a product at some unspecified time will not be sufficient to constitute genuine use of a mark, even if certain preparatory steps have been taken. Preparations to secure customers must be under way
- ✦ The assessment of the similarity between beer and various spirits remains a contentious topic, with some inconsistency in Office practice

THE OPPONENT’S REGISTRATIONS

**MONT BLANC**

**MONT BLANC** whisky



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# House & Garden

A conceptual disconnect delivered for Sekoya, writes Oliver Tidman

**On 13th December** 2017, Sekoya Hotels & Resorts Ltd (Sekoya) applied to register the SOHO GARDEN device mark (shown right) in classes 41 and 43. The application was opposed by Soho House Ltd (Soho) under s5(2)(b) and 5(3) of the Trade Marks Act 1994 (the Act), based on its earlier EU trade mark registration for SOHO HOUSE.

Soho claimed that the words SOHO HOUSE had a reputation for “entertainment” and “club services” (entertainment or education) in class 41 and class 43 services. It also argued Sekoya’s mark would take unfair advantage of and be detrimental to the repute and distinctive character of Soho’s SOHO HOUSE mark.

## AVERAGE CONSUMER

Sekoya filed a counterstatement denying the grounds of opposition. As a preliminary matter, the Hearing Officer (HO) stated that the existence of other traders using the word SOHO, as submitted by Sekoya, was not relevant to the conflict between the marks in issue. Interestingly, Sekoya made no submissions regarding the average consumer of its services under the mark. The average consumer was considered to be a member of the public or a business user.

## NO ASSOCIATION

When analysing Sekoya’s mark, the HO noted the absence of the word HOUSE, with the shared word SOHO alone being attributed less weight as a well-known entertainment district in London. Due to its size and central position, the insect device was the dominant distinctive element. The word HOUSE in Soho’s mark and GARDEN in Sekoya’s mark, with the insect device not being pronounced, created a point of aural difference to a medium degree.

However, there were significant visual and conceptual differences between the marks, leading the HO to conclude that the level of visual and conceptual similarity was low. The HO reasoned that the word GARDEN is more likely to be seen by the average consumer as a reference to a green area in Soho rather than a reference to a garden belonging to a particular house as argued by Soho. In dismissing Soho’s s5(2)(b) ground, the HO found that the marks were not similar enough to cause confusion.

Soho filed evidence of reputation in its SOHO HOUSE mark in the UK. Taking into account the market share held by SOHO HOUSE, the intensity, geographical extent and duration of its use, and the promotional investment made by Soho, the reputation was considered to be in respect of private members’ club services only. It could not be relied on to support a claim to reputation extending to a substantial part of the relevant public for all the services in order to establish a link between the marks. Soho’s s5(3) ground was therefore rejected.

## KEY POINTS

- ✦ Geographical place names shared between marks are unlikely to suggest a connection leading to indirect confusion
- ✦ Conceptual and visual differences between the marks were enough to avoid confusion for similar services
- ✦ Evidence of use of a mark for the purpose of establishing enhanced distinctive character or reputation requires the mark to have been used for the registered goods or services

THE SEKOKA MARK



SOHO GARDEN



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# Reputation leads to rejection

Laura Robyn explains how LinkedIn ironed out a trade mark kink

**This case concerns** an opposition by LinkedIn Ireland Unlimited Company against an application to register the mark KINKEDIN in class 45 for personal introduction, networking and online dating services filed by JK Solutions (the Applicant). The Applicant was not professionally represented.

Relying on its earlier EU registrations, the Opponent claimed a likelihood of confusion exists as well as a reputation and goodwill in LINKEDIN for all its class 45 services including “social introduction and networking services; licensing of computer software and other technology”.

## SECTION 5(2)(B)

Considering the Opponent’s strongest base, the Hearing Officer (HO) found identity between the personal introduction and dating services in the application and “social introduction and networking services” in the earlier LINKEDIN word mark registration. The applied-for licensing services were similar to a medium degree to the Opponent’s “licensing of computer software and other technology”.

The HO determined the average consumer for networking services is a member of the general public paying a medium degree of attention. By contrast, the consumer of licensing services is a professional paying a reasonably high degree of attention (given the long-term ramifications). The purchasing act for both was held to be primarily through visual means, and possibly oral recommendations.

Turning to the Opponent’s evidence the HO remarked it “could have been stronger” but found the mark had become distinctive to a reasonably high degree. The marks were found to be visually and aurally highly similar, but conceptually different since KINKED would be easily understood by UK consumers to mean “abnormal” (including in the context of “unusual sexual proclivities”), whereas KINKEDIN does not have a clear, immediate meaning. Conversely, LINKEDIN would be understood to mean “being connected”. The conceptual difference of the marks counteracted their visual and aural similarity.

Consequently, there was no confusion and the s5(2)(b) claim fell.

## SECTION 5(3)

The Applicant explicitly conceded that the Opponent has a significant reputation for all services relied on. Applying intel, the HO employed the same findings of (dis)similarity between the services as in the s5(2)(b) claim and concluded the strong reputation and closeness of the marks were sufficient to establish the link.

She then turned to two of the three heads of damage advanced by the Opponent: tarnishing and unfair advantage. Noting that while the Applicant’s services are not unpleasant or obscene, the sexual connotations of KINKEDIN would nevertheless sully the Opponent’s professional networking reputation.

With regard to unfair advantage, based on the Opponent’s evidence showing the Applicant’s social media made reference to LINKEDIN, the HO concluded that the Applicant “subjectively intended to exploit the Opponent’s reputation”. This non-hypothetical risk of unfair advantage being taken was sufficient. There was no need to consider detriment to distinctive character as the s5(3) claim succeeded.

## SECTION 5(4)

Noting that the Opponent had a protectable goodwill in respect of business networking services, the HO confirmed the passing off claim failed as there was no likelihood a substantial number of the Opponent’s consumers would be deceived, so use of KINKEDIN could not constitute misrepresentation. The opposition was successful on the basis of the reputation claim, and the application was rejected in its entirety.

## KEY POINTS

- ✦ Despite finding a reasonably high enhanced degree of distinctive character in LINKEDIN, the HO concluded the conceptual difference between KINKEDIN and LINKEDIN was sufficient to defeat the high degree of visual and aural similarity and the primarily visual purchasing act
- ✦ A limited but targeted amount of evidence can be sufficient to show a mark has an enhanced distinctive character
- ✦ Where there is no likelihood of confusion (s5(2)(b)), a claim for passing off based on the same trade mark is also likely to fall at the misrepresentation hurdle
- ✦ In the absence of representation, the Applicant made an important concession on reputation and did not put the Opponent to proof of use, so the latter was entitled to rely on notional use across the full width of the specifications of its three earlier rights



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# Car wars

Use it or lose it came to mind for Rose Franckeiss

**Chevron Cars Ltd (CCL)** owns UK trade mark No 2616321 for the CHEVRON logo (the Mark) in class 25 (various clothing, headgear and footwear). In May 2018, WDK Holdings/Motorsport Ltd (WDK) brought proceedings to revoke the Mark under s46 of the Trade Marks Act 1994 (the Act).

In 2012, CCL split into two separate undertakings: CCL and Chevron Heritage Ltd (CHL). The arguments before the UK IPO allude to the fact that the Mark and goodwill may have been split, with the goodwill from use of the Mark sitting with CHL.

The UK IPO decision focuses on the revocation action under s46(1)(a) of the Act (ie that the Mark had not been put to genuine use in the UK). The Hearing Officer (HO) conducted a review of the case law on genuine use of trade marks as set out in *The London Taxi Corporation Ltd*. In particular, he referred to the fact that there is no de minimis rule when it comes to the law on genuine use.

However, it is clear that genuine use must be more than merely token (*Ansul*). The use must be consistent with the essential function of a trade mark and it must be by way of real commercial exploitation of the trade mark.

Quantity is essential when determining genuine use, and minimal use may qualify if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. In this regard, the HO identified the General Court (GC) decision in *Naazneen Investments Ltd v OHIM, Case T-250/13* as a benchmark. There, the GC upheld a decision that sales of €800 of non-alcoholic beverages under a trade mark over a five-year period did not amount to genuine use of the mark.

## EVIDENCE SUPPLIED

CCL filed two witness statements. The evidence included two company invoices for clothing for CCL employees (it is well documented that internal trade mark use will not be deemed sufficient). There were two sales invoices, amounting to sales of nine shirts and three baseball caps. However, there was no evidence of sales records (including online sales), marketing or promotional materials, or marketing figures. Further, there was no narrative of how CCL had sought to sell the goods for which the Mark was registered.

The HO concluded such “use” was insufficient in the context of the UK clothing sector and the Mark will be revoked in full. A costs award of £1,400 was also made in favour of WDK.

## IMPROVEMENT IDEA

This decision highlights why a proprietor should actually use its trade mark – the phrase “use it or lose it” springs to mind. It also flags the importance of targeted, actual evidence of use in revocation proceedings. As the HO noted, the “sheer paucity” of CCL’s evidence was the most striking feature of the case. The position may have been improved by filing evidence of CHL’s use of the Mark (as licensee), which may have been more substantial and might have provided more chance of maintaining the registration.

## KEY POINTS

- ✦ In revocation proceedings, the proprietor of a trade mark must show that it has made genuine use of the mark upon the goods and services in question
- ✦ A proprietor has to adduce the right level and type of evidence to persuade the decision-making body as to the actuality of a mark’s use
- ✦ While use of a trade mark need not always be quantitatively significant, it must be justified in the sector concerned for the purposes of creating or preserving a market share for the relevant goods and services



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# Bad romance

Any good feeling dies as partnership dissolves, says Eve Brown

**The Defendant**, Geoffrey Deane, was fleetingly a member of the British pop band Modern Romance. The goodwill in the band's name was vested in a partnership jointly held between Deane and fellow band member David Jaymes from 1980 until Deane's departure in 1982. Drummer and Claimant to these proceedings Andy Kyriacou continued to use the band name MODERN ROMANCE long after Deane and Jaymes had left the band.

Kyriacou's use between 1999 and 2017 meant that he had accrued goodwill in the name. He was able to invalidate a UK trade mark application filed by Deane for MODERN ROMANCE for identical services on 4th July 2017 under s5(4)(a) Trade Marks Act 1994 (TMA) by furnishing proof of misrepresentation and damage.

Applying Last Minute<sup>1</sup>, the Registry held that the relevant date in invalidity proceedings for assessing goodwill under s5(4)(a) TMA was the filing date (4th July 2017). Deane's counterargument was that he owned goodwill in the mark MODERN ROMANCE at the relevant date, owing to the goodwill accrued during Deane's two-year presence in the band. He argued that Kyriacou was trading on the reputation of the original band, which was, by default, Deane's own reputation. It was held that since Deane had left the band 35 years before filing the trade mark application, any goodwill in the first partnership that dissolved in 1982 had dissipated.

The decision applied the ratio in Saxon<sup>2</sup>:

- a. Where a band performs as a partnership, the goodwill associated with the name of the band is an asset of the partnership, not of the individual members [para 19]
- b. The departure of a member will, in the absence of an agreement to the contrary, result in the

dissolution of the original partnership and formation of a new one [para 26]

- c. With such a dissolution of partnerships (whether through one person leaving or the partnership simply being broken up), in the absence of special circumstances to the contrary the goodwill generated by the partnership remains owned by the partnership [para 24].

Unfortunately for ex-band members such as Deane, the lack of use of the band name by him over time and the use of MODERN ROMANCE by another band member meant that the goodwill once associated with his partnership

had dissipated and been replaced. A fan of the Claimant tweeted about their "disappointment" and confusion at seeing Deane perform at a gig under the band name MODERN ROMANCE and instead expecting to see Kyriacou.

Considering the nature of goodwill – being the "attractive force", "good name" or "reputation" – the Registry's decision to dismiss Deane's counterargument that Deane had retained goodwill in the name at the date of filing was the correct one. This case is no exception to the common problems that arise in band-name dispute cases such as acquiescence and the absence of written agreements, but it serves as a reminder of the importance of them in practice.

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Goodwill once  
associated with  
his partnership  
had dissipated

## KEY POINTS

- The date of filing is the relevant date in invalidity proceedings under s5(4)(a) TMA
- When assessing goodwill in band partnerships, Saxon applies
- Act quickly and ensure agreements are in writing

1 Joined Cases T-114/07 and 115/07 Last Minute Network v OHMI  
2 Byford v Oliver & Anor [2003] EWHC 295 (Ch) (25th February 2003)



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# FROOT for thought

Roshani Muniweera reports a case with an interesting twist

**This case concerns** an opposition by Kellogg Company (Kellogg) against Fuller Smith & Turner Plc's (Fuller) two UK trade mark applications for FRUIT LOOP marks. Fuller's applications both cover "beer; ale; lager; stout and porter; non-alcoholic beers" in class 32.

Kellogg opposed the applications under s5(3) of the Trade Marks Act 1994 based on its earlier EU trade mark registration for FROOT LOOPS, covering a range of goods in class 30. Kellogg claimed it had a reputation in the mark FROOT LOOPS for "preparations made from cereals" and use of Fuller's mark would ride on the coat tails of its reputation and marketing efforts and give Fuller an unfair advantage. In addition, it claimed it would dilute the distinctiveness of the FROOT LOOPS mark and the association with alcoholic beverages would cause detriment to its reputation. Fuller denied all the claims and put Kellogg to proof of use.

Based on the evidence filed by Kellogg, consisting of two witness statements, the Hearing Officer (HO) found against it. While Kellogg stated its Froot Loops product was launched in 1963, it failed to mention whether this was in the UK. In addition, it did not provide UK sales figures and did not set out how many packets of "Froot Loops" were sold in the UK. Consequently, the HO found that Kellogg had not submitted sufficient evidence of use of its mark even though such data must have been available. The HO found that Kellogg had also not established that its FROOT LOOPS mark has a reputation.

However, the HO went on to consider a seemingly inadvertent statement made by Fuller in its submissions: "It is accepted that consumers of the applicant's ale sold under the word mark and the label mark would likely be aware of the opponent's mark for breakfast cereal by reason of the opponent's long-standing usage of the opponent's mark..." The HO considered this comment as an expression of Fuller's opinion of Kellogg's use of its mark and an admission that Kellogg's proof of use and reputation requirements were met. As such, the HO then evaluated the requirements under s5(3) to assess whether a significant part of the public will form a link between the marks and held the following:



- FRUIT LOOP (3288748) is similar to the Opponent's mark to a medium degree.
- The Applicant's mark 3288758 is similar to the Opponent's mark to a low degree.
- Kellogg has a low degree of reputation in the UK.
- Kellogg's EUTM for FROOT LOOP has an average degree of distinctiveness but cannot benefit from any acquired distinctiveness. The goods of Kellogg and Fuller are not similar although both will be purchased by the general public. The HO therefore found that the average consumer would not make a link between the Kellogg and Fuller marks, and the opposition under s5(3) failed.

Following the recent EUIPO decision on BIG MAC, this case also highlights that big companies cannot be complacent when filing evidence of use. Registered proprietors must draw upon all the resources they have available to provide conclusive evidence of their use of a mark or their reputation. And most importantly, every statement made in submissions should be carefully considered to avoid inadvertently assisting the other side.

## KEY POINTS

- ✦ The importance of providing conclusive evidence of use cannot be overestimated
- ✦ If you make a claim as to reputation, make sure you submit the evidence to back it up
- ✦ Choose your words carefully in your submissions – do not risk them unintentionally assisting the other side

THE FULLER MARK  
3288758



THE FULLER MARK  
3288748  
FRUIT LOOP



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# Insight not in evidence

The Court didn't find Nirvana's arguments enlightening, says Clare Liang

**This case concerns** an application for invalidity filed by Advanced Nutrients Ltd (the Applicant) against EU trade mark (EUTM) No 15412281 NIRVANA registered in classes 1, 11 and 21 in the name of Garden Care Bidco Ltd (Garden Care). The goods covered included a range of growing media, plant food, gardening appliance systems and containers. The decision highlights the importance of ensuring claims are substantiated and that the probative value of evidence and its credibility will be taken into account by the EUIPO.

The Applicant invoked Article 60(1)(c) EUTMR in connection with Article 8(4) and sought to rely upon its earlier unregistered Danish trade mark NIRVANA, which was purported to have been used in relation to plant nutrients in class 1.

The Applicant also made a rather unusual request to the EUIPO that if the application for invalidity failed, a limitation would be applied to the specification in class 1 to exclude plant nutrients.

The evidence submitted by the Applicant in support of the application for invalidation included:

- Extracts from the Danish Trade Marks Act and a Danish Law textbook, and a decision of the Danish Supreme Court;
- A picture of the Applicant's product marketed under the mark NIRVANA
- An excerpt from an undated catalogue showing a product bearing the mark NIRVANA; and
- Invoices issued by Balkan Plant Sciences Ltd. (a subsidiary company incorporated in Bulgaria) to various recipients in Denmark and to various recipients in EU Member States.

The evidence was heavily criticised by Garden Care and the credibility of the evidence

showing use of the mark was called into question. The mark did not appear on every invoice and did not always seem to fit the layout. The EUIPO commented that the discrepancies cast some doubt over the probative value of the documents.

In reply, the Applicant explained that Balkan Plant Sciences Ltd. is a distributor and a wholly owned subsidiary of it. However, no evidence was provided to support this statement and the Applicant did not address or give any explanation as to the discrepancies identified.

The Cancellation Division considered that the invoices issued by Balkan Plant Sciences Ltd. were insufficient to show that the earlier

unregistered mark had been used by the Applicant in the course of trade and that any such use was of more than mere local significance because there was no link established from the invoices to the Applicant. Furthermore, the EUIPO was not able to conclude from the evidence submitted

whether, under Danish law, use by Balkan Plant Sciences Ltd. meant that the Applicant became the proprietor of the unregistered mark.

Failure to establish proprietorship of the mark meant that the application for invalidity failed and costs were awarded to Garden Care. The EUIPO also found the Applicant's request to limit the specification to be inadmissible as there is no legal ground that allows the EUIPO to limit ex officio the specification upon request.

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*The credibility of the evidence showing use of the mark was called into question*

## KEY POINTS

✦ In EUIPO proceedings, ensure that earlier rights are substantiated, especially when relying on unregistered rights and provisions of local laws in individual EU Member States

✦ There is no legal basis for the EUIPO to ex officio limit the specification of a registration

✦ Ensure that the applicant for invalidity is the true proprietor of any earlier rights relied upon



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# Supermarket feels the chill

Dale Carter discovered the risk of a geographical reference

**Iceland Foods Ltd** (the supermarket) has had its EU trade mark (EUTM) registration declared invalid following an application by The Icelandic Ministry of Foreign Affairs and others (the Applicant). The supermarket registered the word mark ICELAND in 2002 for machinery goods in classes 7 and 11, paper goods in class 16, food and beverage goods in classes 29-32 and retail services in class 35. The Applicant claimed that the mark was non-distinctive, descriptive and misleading. The Cancellation Division (CD) agreed in part, cancelling the registration for descriptiveness; it did not consider the other grounds.

## GEOGRAPHICAL DESCRIPTIVENESS

The Applicant argued that ICELAND cannot function as a trade mark because it will be perceived as descriptive of the geographical origin of goods and services. It claimed that the country Iceland enjoyed an international reputation as a producer of machinery, literature, food and beverages, and supported these claims with tourist surveys, export data and information about various Icelandic companies.

The supermarket maintained that the Applicant had misrepresented the country's reputation for the goods in question, referring to EU-export figures that were either trivial or non-existent for anything other than fish and aluminium. It argued that when a geographical name has a reputation for a narrow range of goods, use of that name on goods outside of this narrow range will not have a "competitive impact".

The CD agreed that the Applicant had exaggerated its reputation. However, when public knowledge of a geographical name is established the relevant public will generally perceive that name to be an indication of geographical origin, or may do so in the future. Consumers would therefore perceive products marked ICELAND as having been produced in the country or in an Icelandic style. Likewise, the use of ICELAND on goods in classes 7, 11



and 16 would be seen as an indication of their place of manufacture. This applied also to the retail of the corresponding goods in class 35.

## ACQUIRED DISTINCTIVENESS

The supermarket submitted evidence of acquired distinctiveness through use. The CD determined that the relevant public consisted of consumers not only in EU Member States where English is the official language, but also in those where English is widely spoken.

The supermarket proved acquired distinctive character in the UK and Ireland, but failed to file evidence of use in the Netherlands, Scandinavia and Finland, being territories in which English is widely understood. The supermarket argued that its use evidence in other Member States could be extrapolated to reach findings in the Netherlands, Scandinavia and Finland. The CD disagreed because extrapolation of the evidence is only possible where there has been some use of the mark in the Member States concerned, which was not the case in the Netherlands, Scandinavia and Finland.

This decision, which is perhaps surprising in the context of in-store retailing, nevertheless highlights the difficulties that trade mark proprietors face in demonstrating use in all relevant territories of the EU for the purpose of proving acquired distinctiveness.

## KEY POINTS

✦ In order to prove acquired distinctiveness for an English language mark, evidence of use may be required in Member States where English is not an official language but is widely spoken

✦ If a geographically descriptive mark refers to a large area, such as a country, then a place-goods association is presumed to exist in the mind of the average consumer

✦ In order for the Office to extrapolate evidence of acquired distinctiveness from one Member State into another, there must have been some use of the mark in that other Member State



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# Live long and prosper

This seems the outlook for the Opponent's mark, writes Aaron Hetherington

**On 26th January** 2018, Star Trek Private Equity LLC (the Applicant) filed EU trade mark (EUTM) application No 17741497 for the STAR TREK SPORT NUTRITION figurative mark (shown right) in relation to "dietary and nutritional supplements" in class 5.

CBS Studios Inc, the successor of all rights associated with the *Star Trek* television series, and all related series, films and merchandise, opposed the application. The opposition was filed on the basis of CBS's EUTM registration No 5150446 for the word mark STAR TREK and on the grounds of Article 8(5) EUTMR.

CBS submitted a large volume of EU-focused evidence, including evidence of significant box-office sales figures, on the basis of which it was found that CBS's STAR TREK mark enjoyed a substantial degree of recognition among the relevant public. Reputation in the EU was established in relation to cinematographic films. The evidence made little or no reference to the remaining goods/services claimed.

The marks were found to be similar to an average degree overall, and conceptually highly similar. It was found that the goods applied for by the Applicant were dissimilar to the goods protected by CBS's earlier registration. This was because they had a very different nature and purpose, did not share distribution channels and were not complementary.

The EUIPO did, however, take the view that, due to the level of reputation of CBS's earlier mark and its striking similarity with the applied-for mark, there was at least a possibility that, when encountering the contested mark, the relevant consumers would associate it with CBS's mark. In other words, they would establish the required mental "link" between the signs.

Turning to CBS's claim that use of the contested application would take unfair advantage of the repute of its earlier registration, the Court accepted that CBS's mark was capable of conveying an image of strength, health and longevity on the basis that *Star Trek's* famous Vulcan characters possessed such characteristics. Since these qualities were exactly what the public would seek from the Applicant's supplements, that image could be transferred to the Applicant's goods. Thus it was held that the use of the contested mark was likely to take unfair advantage of the distinctive character or repute of CBS's earlier registration.

It was further observed that since cinematographic films' merchandising activities could cover a wide range of goods offered under the same brand, it was plausible that a consumer would expect a STAR TREK dietary product or supplement to originate from CBS (or be associated,

controlled or licensed by it), thereby reinforcing the risk of injury.

The opposition therefore succeeded and the contested mark was refused registration.

Notably, this case demonstrates the broad scope of Article 8(5) and the ability for brand owners to rely solely upon their reputation to prevent registration of a mark, even when the goods or services are totally dissimilar. Importantly, it also highlights once again the need for strong EU-focused evidence to succeed with a reputation-based claim.

## KEY POINTS

- ✦ A reputation cannot be assumed, it must be evidenced
- ✦ Reputation-based claims are more concerned with whether there is (a mental link and) unfair advantage or detriment to the opponent's mark

THE APPLICANT'S MARK



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*CBS's mark was capable of conveying an image of strength, health and longevity*



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# Hard day for easyGroup

It wasn't able to rely on its family of marks, reports Saaira Gill



**The Opponent**, easyGroup Ltd, opposed an EU trade mark (EUTM) application for EASY BOUQUET filed by Anecoop S. Coop (the Applicant). The application covered, inter alia, processed fruits and vegetables in class 29, fresh fruits and vegetables in class 31 and non-alcoholic beverages in class 32. The opposition was directed against all goods covered by the application, was based on Article 8(1)(b) EUTMR, and relied upon eight earlier EUTM registrations (EASYJET, EASYGROUP, EASYFOODSTORE, EASYPIZZA, EASYCOFFEE, EASYESPRESSO, EASYCAFE and EASYGIFTS). The opposition was based on goods in classes 29–33 and services in classes 35, 39 and 43. For reasons of procedural economy the Office did not undertake a full comparison of the goods and services, but ruled that some of the contested goods are identical or similar to the goods and services upon which the opposition is based.

## DISTINCTIVENESS

The Office examined the opposition in relation to the first earlier mark, namely an EUTM registration for EASYJET. The word JET was considered to be distinctive to an average degree. Predictably, the word EASY was found to be non-distinctive, as previously confirmed by the Board of Appeal in 2017. For the contested mark, the word Bouquet was found to be distinctive to an average degree, and Easy non-distinctive. The marks were found to be visually and aurally similar to a low degree and conceptually similar to a very low degree.

## REPUTATION CLAIMED

easyGroup had claimed a reputation in the earlier mark and had submitted a range of evidence in support of this claim. Upon examination of the evidence, the Office found that EASYJET has a certain degree of recognition among the relevant public and concluded that EASYJET enjoys enhanced distinctiveness, but in relation to transportation services only. Consequently, for the contested goods the distinctiveness

of the earlier mark was normal, and it was found that the differences between EASYJET and EASY BOUQUET were sufficient to exclude any likelihood of confusion.

easyGroup had also claimed that the earlier trade marks constitute a family of marks and argued that this would give rise to a likelihood of confusion. However, it was unable to satisfy the two cumulative conditions required. Its evidence failed to establish that it is using a family of EASY marks and there was no convincing information to demonstrate that consumers would be aware that there is a family of marks used in the same field of goods as covered by the application. easyGroup had referred to various EUIPO opposition decisions that confirmed it had a family of marks. However, the Office found that the previous cases relied upon belonged to a much earlier period of time, at least 11 years before the publication date of the application, and the evidence submitted in those cases was not the same as the present case. So, the Office did not take the previous cases into account.

The Office examined the seven other earlier marks relied upon but reached the same conclusion, and accordingly dismissed the opposition in its entirety.

## KEY POINTS

- ✦ easyGroup failed to prove that it uses a family of EASY marks
- ✦ Previous decisions of the EUIPO, which confirmed that easyGroup has a family of marks, were not taken into account as they were too old and related to different evidence
- ✦ Simply having registrations for a family of marks is, in itself, not sufficient and evidence of use must be filed in order to rely on a family of marks



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# Kors case goes off course

Nick Bowie reveals why an invalidity argument was unconvincing

## KEY POINT

It is customary for the relevant public of clothing to recognise a fashion designer's initials as a trade mark, such that initials may play a subordinate and dependent role within a composite mark, despite being the dominant element

THE PROPRIETOR'S MARK



THE APPLICANT'S MARK



**This case concerns** an invalidation action by Michael Kors (Switzerland) International GmbH (the Applicant) against EU registration No 14785141 of Julong Wang (the Proprietor) for the MIK logo (shown left), in relation to clothing and fashion accessory products in classes 9, 18 and 25. The Applicant relied on its earlier EU registration No 14273304 for the MK logo (shown left) in invoking Article 60(1)(a) EUTMR in connection with Articles 8(1)(b) (likelihood of confusion) and 8(5) (unfair advantage or detriment to a reputation without due cause).

The Applicant claimed that its business and MK logo have achieved worldwide recognition in the fashion and accessories industry over several decades. The Applicant submitted evidence of its reputation under its earlier mark, including but not limited to examples of printed and online media, internet archive pages depicting use of the mark in relation to bags and eyewear, brand recognition certificates issued by Spanish regional chambers of commerce, details of awards won by the Michael Kors brand and past decisions that acknowledge the fame and reputation of Michael Kors' trade marks.

The Cancellation Division (CD) reviewed the evidence both in the context of: (a) the Applicant's reputation; and (b) whether its trade mark enjoyed broader protection as a result of high distinctive character obtained through market recognition. To prove that a mark enjoys a reputation, the Applicant is required to demonstrate a sufficient level of exposure to the relevant public of its reputation in the MK logo, whereas to demonstrate an enhanced degree of distinctiveness in a trade mark, it is not necessary to meet this higher threshold.

The CD concluded that the majority of evidence referred to the use of the sign

"Michael Kors" together with the depiction of products bearing the earlier mark "MK" (ie on bags, wallets, etc) and therefore the link between the capital letters "MK" and the house mark "Michael Kors" could be established. The CD determined that the evidence as a whole was sufficient to prove that the MK logo enjoyed an enhanced degree of distinctive character in relation to "handbags" but was insufficient as regards the extent of the relevant public's awareness for reputation also to be considered proven. Therefore, Article 60(1)(a) relating to Article 8(5) EUTMR was dismissed.

## REPUTATION EVIDENCE

While the CD found identity between all goods, it held that the MK element of the Applicant's

trade mark would be recognised by the relevant public as the initials of the designer. Thus, despite being the dominant element of the trade mark, the MK element played a subordinate and dependent role to the wording Michael Kors. The CD held that the common terms M and K placed within a non-distinctive circle device

produced a low degree of aural and phonetic similarity between the trade marks which, even given the identity of the conflicting goods and an enhanced degree of distinctiveness of the trade mark in respect of "handbags", was insufficient to find a likelihood of confusion.

Accordingly, the application for invalidity was dismissed in its entirety.

“  
*The Applicant claimed that its MK logo had achieved worldwide recognition*”



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# To protect or attack?



The meaning of a trade mark cannot be assessed in abstract, comments Désirée Fields

In May 2017, Axon Enterprise, Inc. applied to register the sign PROTECT LIFE as an EU trade mark (EUTM) for various goods and services in classes 9, 13, 14, 35, 38, 41, 42 and 45. EUIPO partially refused the application under Articles 7(1)(b), 7(1)(c) and 7(2) EUTMR holding that PROTECT LIFE was descriptive and devoid of distinctive character in relation to the goods and services applied for in classes 9, 13, 35, 41 and 45.

Axon appealed. EUIPO's Fourth Board of Appeal (BoA) held that the appeal was partially well founded insofar as the mark PROTECT LIFE was neither descriptive nor lacked distinctive character in respect of advertising services in class 35, which were rendered merely to promote or sell goods and services as opposed to defending life as such. Upholding the remainder of the refusal, the BoA found that PROTECT and LIFE were both meaningful English words that required no interpretive effort to be understood as referring to protection or defence of people or other living beings. There was nothing unusual or surprising about the phrase in relation to the goods and services applied for, which covered, among others, life-saving apparatus, weapons, educational services in relation to weapons, and security services.

## MULTIPLE MEANINGS

The BoA rejected Axon's argument that the relevant public would not make any descriptive link between PROTECT LIFE and weapons "because a weapon was traditionally thought of as causing rather than preventing harm", noting that it was well known that a weapon could be used either to defend and protect or attack and that lethal and non-lethal weapons were used by security forces and the police, whose core mission was to defend society

and the life of its citizens against dangers and threats.

Accordingly, in respect of goods in classes 9 and 13, the sign PROTECT LIFE described a quality of the goods immediately informing consumers of their purpose to defend against harm to life. Many of the services in classes 41 and 45 explicitly referred to the goods in classes 9 and 13 and were related to using those goods to defend against threats to life.

Commenting that a descriptive mark

necessarily also lacked distinctiveness, the BoA upheld the refusal in respect of classes 9, 13, 41 and 45 under Articles 7(1)(b) and 7(1)(c) and remitted the case to the examiner to determine Axon's subsidiary claim of acquired distinctiveness.

## BOA UNCONVINCED

Without context, the vast majority of consumers would be unlikely to

make an immediate and direct connection between PROTECT LIFE and weapons, which are traditionally perceived to cause harm, not to prevent it. However, the assessment of whether a mark is descriptive or lacks distinctive character is carried out with reference to the actual goods and services applied for. Here, the BoA clearly remained unconvinced that consumers would need to use interpretation skills to make a connection between PROTECT LIFE and the characteristics or purpose of the goods and services applied for.

“

*A weapon was traditionally thought of as causing rather than preventing harm*

## KEY POINTS

- +
- The meaning the relevant public will attribute to a mark must be examined in light of the goods and/or services applied for
- +
- The public need not understand precisely how goods function but only that the sign constitutes a description that they bear such a function
- +
- It is irrelevant how commonly a sign is used but rather that a sign could be used for the purpose described by the mark



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# Mind the gaps

Mark Caddle warns of the need for solid evidence

**The Applicant**, Charalampos Rosios, applied to register the mark (shown right) as an EU trade mark (EUTM) in class 43 (“the Application”). Transport for London (TfL) opposed the Application on the basis of a likelihood of confusion with its EUTM registration (shown right) in classes 30, 32, 33 and 43, pursuant to Article 8(1)(b) EUTMR.

TfL also relied on alleged unregistered rights in several other marks (right) by virtue of extensive use in the UK for a variety of services, including those in class 43.

## COMPARISON

In concluding the Applicant’s and Opponent’s marks are similar to a low degree from a visual perspective only, the Opposition Division (OD) noted that both consist of a circular device with a “horizontal bar through the central position, which crosses the rim of the circular device. In both cases, the depiction includes a word, the lettering of which runs the length of the central bar.” It also highlighted the difference in the backgrounds of the horizontal bar: dark

for TfL and black on a white background for the Applicant. The similar figurative elements were deemed non-distinctive due to their rudimentary nature.

UNDERGROUND was held to be distinctive, but COFFEEBAR, notwithstanding the R in reverse at its end, would be understood by the relevant consumer for some of the services in class 43 and, thus, was not distinctive.

## EVIDENCE EVALUATION

Despite evidence submitted by TfL, it was decided that its earlier mark was to be treated as having normal levels of distinctiveness. In a damning critique of the evidence filed by TfL, the EUIPO noted that “pictures, history of the opponent, the allocation of licences and other legal relationships with third parties, the use of the mark at festivals that take place once a year, excerpts from catalogues, social and/or economic activities or those in the service sector only, do not allow a final assessment on the extent of use of the earlier mark”. The OD concluded that the evidence submitted indicated substantial use of TfL’s mark for “transport in metro”, at best.

As alluded to above, in assessing the evidence from TfL to substantiate the unregistered rights claim, the OD was not influenced by the evidence filed. The evidence was not able to show that TfL’s marks had acquired any goodwill in the UK.

In assessing the “holy trinity” for passing off cases (goodwill, misrepresentation, damage), the OD noted that submitting evidence in bulk and without clear demarcation as to which ground it supports will not be sufficient to satisfy the EUIPO that passing off has occurred.

The OD dismissed the opposition in its entirety.

## STRICTER CLIMATE

This case illustrates the consequences of not substantiating claims to passing off with evidence in the appropriate manner. Following the BIG MAC decision, the EUIPO has again demonstrated its strictness in assessing evidence filed by trade mark proprietors. The decision is also a reminder of the limited distinctiveness of basic figurative elements, especially where such marks do not enjoy enhanced levels of distinctiveness.

## KEY POINTS

- ✦ Another reminder of the importance of abiding by EUIPO rules on evidence to fully support claims, especially those relying on unregistered rights
- ✦ TfL’s evidence was insufficient to establish a claim of passing off

THE APPLICANT’S MARK



THE TFL APPLICATION



ADDITIONAL TFL MARKS



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# Events

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

DATE	EVENT	LOCATION	CPD HOURS
9th August	CITMA Webinar* The use requirement in United States trade mark law	Log in online	1
3rd September	CITMA Webinar* Mental health and wellbeing across the legal community	Log in online	1
6th September	CITMA Paralegal Seminar Ownership	Wedlake Bell, London EC4	3
24th September	CITMA Lecture – London* Evidence in registry proceedings	Carpmaels & Ransford, London WC1	1
8th October	CITMA Webinar* Artificial intelligence	Log in online	1
10th October	CITMA Quiz – Leeds	The Lamb and Flag, Leeds LS2	
17th October	CITMA Autumn Conference – Birmingham*	The ICC, Birmingham B1	5
12th November	CITMA Paralegal Webinar* The Chinese “super trade mark”	Log in online	1
14th November	CITMA Webinar* UK case law update	Log in online	1
26th November	CITMA Lecture – London* Fashion and IP	Allen & Overy LLP, London E1	1
28th November	CITMA Lecture – Leeds	Womble Bond Dickinson, Leeds LS1	1
3rd December	CITMA Webinar* Introduction to patents	Log in online	1
6th December	CITMA Northern Christmas Lunch**	TBC	
13th December	CITMA London Christmas Lunch***	London Hilton Park Lane, London W1	

## SUGGESTIONS WELCOME

We have an excellent team of volunteers who organise our programme of events. However, we are always eager to hear from people who are keen to speak at a CITMA event, particularly overseas members, or to host one. We would also like your suggestions for event topics. Please contact Jane at [jane@citma.org.uk](mailto:jane@citma.org.uk) with your ideas.

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**THE  
TRADE  
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# Luis-Alfonso Durán

follows in the footsteps of tradition

**I work as...** a Patent and Trade Mark Attorney in Spain, at Durán-Corretjer, SLP.

**Before this role, I...** studied engineering at the Polytechnic University of Barcelona and law at the University of Barcelona. I found that a combination of a technical and legal background was very useful in becoming an IP professional.

**My current state of mind is...** confused, concerning Brexit and the trade war between the US and everybody else. It looks like the trend is reversing all progress achieved in trade globalisation. But I am optimistic that logic will prevail.

**I became interested in IP when...** I was born into a family involved in IP for three generations. My great-grandfather, grandfather and father were IP attorneys. I never felt I needed to follow the tradition, but I decided by myself to go into IP and have never regretted it. It is a fantastic profession.

**I am most inspired by...** the many colleagues who have shown me that hard work and motivation combined



*I decided by myself to go into IP and I have never regretted it*

are very important to progress in the IP profession.

**In my role, I most enjoy...** speaking with clients and associates to devise the best strategy to achieve their goals. I was fortunate to obtain trade mark protection before EUIPO of two non-conventional marks (appearance of wine bottles) after 15 years of prosecution, going three times to the Board of Appeals, twice to the General Court and once to the Court of Justice.

**In my role, I most dislike...** negotiating reduction of fees with clients. Professional work should be valued by its real added value, not by its cost.

**On my desk is...** my computer, where I have all the tasks I have to do, and my notebook.

**My favourite mug says...** “Abuelo enrollado” (cool grandpa).

**My favourite place to visit on business is...** Paris, London and New York. But I love to live in Barcelona.

**If I were a trade mark, I would be...** Porsche, Ferrari, Morgan, BMW – I love cars.

**The biggest challenge for IP is...** that users’ interests prevail versus the interests of big and strong IP offices (EUIPO, WIPO, etc).

**The talent I wish I had is...** playing a musical instrument. I love listening to music; to play it must be much better.

**I can’t live without...** my family and my friends.

**My ideal day would include...** music, nice conversation and good wine.

**In my pocket is...** my phone, my credit cards and my handkerchief.

**The best piece of advice I’ve been given is...** give the best of yourself.

**When I want to relax I...** listen to good music.

**In the next five years I hope to...** continue working on cases I like and spend more time travelling for pleasure.

**The best thing about being a member of CITMA is...** as an overseas member I am not able to join most of the events, but the information that I get is very good and useful.



Hometown: Barcelona

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