

# CITMA REVIEW

ISSUE 461 OCTOBER/NOVEMBER 2020



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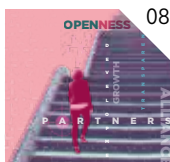


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Interested in getting more involved at CITMA? Check out our volunteer hub at [citma.org.uk/volunteer](http://citma.org.uk/volunteer)

**PRESIDENT'S WELCOME  
NEW PERSPECTIVES  
ARE NEEDED**

Becoming CITMA President was never my plan – the role seemed far too intimidating. I applied to join Council because I felt that there wasn't enough in-house representation within CITMA.

Listening to and representing the interests of all our members across the entire profession is essential to the work we do, and that is why we have launched our new volunteer hub.

Our volunteer hub gives you, no matter your experience, the chance to have an impact on your profession. It lays out all the opportunities we have available to ensure everyone has a chance to get involved.

Volunteering is a fantastic way to broaden your experience and widen your network. For me, the most rewarding part of it is getting to know people from across the profession and gaining an understanding of the different issues people face.

It can seem daunting. When I went to my first Council meeting, I had almost no idea what was going on, but people are ready to help and it is so important to get new perspectives. When I joined, I was the only in-house practitioner; now there are four.

If there's something that you are interested in, or that you'd like to get involved in but aren't sure how, have a look at our volunteer hub or let us know.

Don't wait to be asked. Make the most out of your career by making an impact. Visit our volunteer hub today at [citma.org.uk/volunteer](http://citma.org.uk/volunteer)

Ultimately, the more people we have involved, the better we can represent our members.

Richard Goddard, CITMA President



The need for improvements to its electronic services has emerged as a key theme in the UK IPO's latest benchmarking research. As part of this research, Chartered Trade Mark Attorneys with significant experience of using overseas IP offices were asked to compare the UK IPO with other offices and explain where it could do better. The UK IPO will use the detailed findings to inform

future benchmarking and improvement activities. Suggestions for areas to improve were spread across different aspects of the process. The participants highlighted the following areas:

- **The register:**
  - Search functionality and case detail
- **Specifications:**
  - The office could be more demanding of applicants

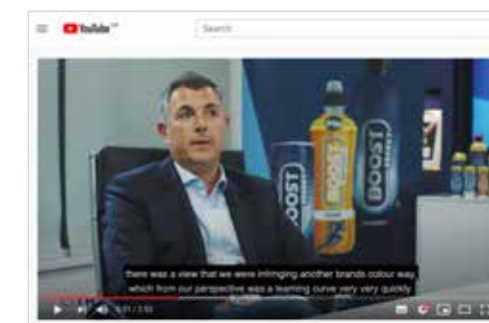
- **The UK IPO website:**
  - Better architecture
- **Non-application processes**
  - Making more help available to clamp down on bad faith actors globally; automation in general; and rectifying the issue relating to EU representatives acting in the UK.
- **The filing process:**
  - Easier review prior to filing, and faster filing receipt
- **Examinations/ applicant response deadlines/oppositions:**
  - TM7A should be renamed and should be free and easy to access
  - Electronic access to files without having to pay a fee

The UK IPO would like to thank the volunteers for their support and Beaufort Research for putting the research together.



**RECORD NUMBER OF UKTM APPLICATIONS FILED**

A total of 12,576 UK trade mark applications were filed in June, the most ever recorded in a single month. The previous high was May 2020, which saw 11,035 applications. Find out more at [citma.org.uk/recordapplications](http://citma.org.uk/recordapplications)



**OUR CAMPAIGN REACHES A BIG AUDIENCE**

The videos we produced for our campaign to raise the profile of IP in the food and drink sector have been viewed more than 60,000 times on YouTube and Facebook. Meanwhile, the written case studies that accompanied them have been read more than 17,000 times, and at the time of writing the 19 blogs published specifically for the campaign have attracted more than 14,000 unique views.

**FIRST TMA TO BE AP**

Former CITMA President Philip Harris has become the first Chartered Trade Mark Attorney to become an Appointed Person (AP). Philip will be working with appeals against the IPO in relation to trade marks and designs.





# WE NEED TO TALK ABOUT BIAS

Let's find ways to turn it to our advantage, says Andrea Brewster

**If you've never** come across a BAME pilot or a female surgeon, your brain sounds alarm bells when you do. Something feels wrong; it doesn't fit the patterns you're used to. You've instinctively lost confidence.

This "unconscious bias" is a natural human reaction, but it has a profound impact on the diversity of the world we live and work in, not least because it's self-perpetuating. We expect to experience – and therefore feel comfortable with – things we've experienced before. The more we see something, the more "normal" it seems.

So, if we rarely encounter BAME IP professionals, we're unconsciously more wary of the ones we do meet. When we're recruiting, therefore, a BAME candidate will have to work harder to reassure us. And because we're less likely to recruit them, there remain fewer of them, so the problem continues.

It can be difficult to overcome these biases, but it's not impossible. Clearly, visibility is key – for women, for BAME people, for disabled people, and for any underrepresented group. We need to create new patterns and new stereotypes for our brains to recognise and accept. We have to normalise the non-white face on the podium, the wheelchair in the meeting room, the female voice at the microphone. Only then can we put a stop to our unconscious alarm response.

Every extra BAME person that we employ and promote is one more role model for other BAME

professionals, one more ambassador to attract new BAME people in, and, importantly, one more defence against our unconscious biases.

There is plenty we can do to help. For example:

- **Acknowledge the potential for bias.** Unconscious bias and allyship training should be a must for all professionals in all roles and at all levels. This is not just for the "evil" people. You don't

ourselves and others when making "gut feel" responses.

- **Incorporate "diversity by design" at the beginning of all decision-making processes.** Deliberately select diverse working groups and speaker panels. Require recruiters to send a diverse selection of candidates, and suppliers to field diverse teams.

- **"Prime" your decisions.** Before you start interviewing, show yourself pictures of BAME IP professionals, read about their work and think about that inspiring BAME speaker you heard at an IP conference. Then, when you see a BAME candidate, they will be more like the "normal" that your brain is expecting.

That last suggestion actually turns unconscious bias to our advantage. It's a way of making our instincts more favourable to things that they might otherwise have feared or dismissed.

These simple improvements could make a huge difference to people in all underrepresented groups, not just BAME professionals. We need to redefine and redistribute our patterns of normality. The more diversity we see around us, the more confident our response to it will be.

“

*Unconscious bias and allyship training should be a must for all professionals*

do unconscious bias training because you are racist. You do it because you're not, and because you don't want to be.

- **Make all decisions as objective as possible.** Use agreed job specifications and score cards for all interviews. Review name-blind CVs at the sifting stage. Ensure diverse teams make the key decisions. We must challenge



**Andrea Brewster OBE**

is Lead Executive Officer at IP Inclusive  
Find out more at [ipinclusive.org.uk](http://ipinclusive.org.uk)

# WOULD YOU DO A

Aligning the employee's aims with the firm's can lead to stronger alliances, argues Aaron Wood

When I first proposed this article, the intention was that it would focus on the new paradigm of work, and on the idea of adopting the principle of "tours of duty" to enable firms and individuals to create more fulfilling workplaces. Since then, the curveball of the global pandemic has added an extra layer of importance to getting the strategy right when it comes to our career options, with a view to not only surviving but also thriving.

The problem of employee disengagement and how to incentivise and motivate employees (and how to find motivating employment that fulfils your own needs) has been around for many years. As long ago as 2013, Reid Hoffman, the founder of LinkedIn, proposed the idea of "tours of duty" in his article "Tours of Duty: The new employer-employee compact", co-written with Ben Casnocha and Chris Yeh. Hoffman argued that businesses need to be agile and entrepreneurial, and that the old concept of a job for life (where employers offered security in exchange for loyalty and more moderate salary demands) is now outdated. Instead of a bond of loyalty, he suggested that the bond needed to be thought of as one of alliance.

This bond of affiliation may seem a slightly strange concept – both to the employer faced with falling levels of loyalty and rising salary expectations (together with the eye-watering one-off costs of recruitment), and to the employee seeing ever-increasing billing targets and a lack of loyalty to staff when times are tough. While far from perfect, the

concept of a tour of duty can help to focus the mind on growth, for both the business and the individual.

## GROWTH TARGET

The concept is simple. Instead of an open-ended contract with limited "targets", the employer and employee agree on a two- to four-year growth target. At the end of that period, a new "tour" is decided upon. Perhaps the employee will continue on the same path. Equally, a new path could be chosen, or the employee might depart for pastures new. As part of each tour, however, the employee and the employer undertake to achieve certain targets and perform certain tasks in the pursuit of the overall benefit to both sides.

A very simple and common example is the training contract in law firms. Here, the firm commits to train and develop a trainee for a period of time, and the trainee promises to stay for that period and put the work in. Each party knows that the trainee won't be retained at the end of the period if they have not reached the expected level. If the firm does not have a place for them in the department they want then they can either stay in a different department or move on.

In this format, everyone knows what is expected, and trainees generally work hard to ensure they are kept on. It is true that it can be a stressful time, but with regular feedback and information there should be no surprises. Those who have trained as Trade Mark Attorneys

without such a training contract will know that life was no less stressful for them. If anything, it can be more stressful, since their employment can theoretically be ended at any point.

*“ The concept of a tour of duty can help to focus the mind on growth, for both the business and the individual*

# TOUR OF DUTY?

## TRICKY TRANSITION

Post-qualification, things get all the more difficult for attorneys. What do we need to learn in order to develop, and what do we need to develop in order to progress? Some firms have grasped the nettle by setting out clear expectations for the ongoing development of attorneys and by offering a suite of training and development opportunities. But this approach is far from universal. For some, development will be presented as an increasing level of autonomy in legal work, or perhaps being handed responsibility for increasingly large and important clients, but it is usual for this to occur in only a piecemeal way.

In order to assist with this, CITMA has produced the Advanced Competency Framework. This focuses

on the legal and management skills that attorneys may want to learn, and it can be viewed on the CITMA website. CITMA is also working to help firms and attorneys bridge the knowledge gap. Beyond that though, each firm will still have to plan for its own future growth and development.

One difficult aspect of tours of duty, however, is the need for the business to have clarity and openness about the firm it is and the firm it wants to be. Take the example of IP litigation. For some firms, it is a strategic thrust leading to investment. For others, it is a potential source of work but for which there are no particular plans. And for others again, it is something they will never do (in part to retain reciprocity or to honour formal tie-ups with law firms). For the sake of the business and the individuals within it, providing transparency as to the approach is important.

Firms may also need to be open about the characteristics, skills and financials/client base required to progress, and then develop a plan to engender that in attorneys. A common issue I have experienced and observed is a situation in which an associate or senior associate is not progressing because something is missing, yet the employer will not address the issue for fear of driving the employee away. This means the employee is left to stagnate. The alternative to this is the hastily organised training programme intended to get an associate "ready" for

partnership, solely because if they don't get it they will leave, taking with them a significant case load.

## NETWORK INVESTMENT

Beyond the tour of duty, Hoffman recommends two further practices. The first is investing in the development of external networks for the employee, and the second is developing an alumni network. The investment in external networks can be as simple as permitting employees to develop a social profile during work time and to be seen as a figurehead for certain work, while the second is aimed at retaining bonds of affiliation with those who leave. If employees are dealt with appropriately, leaving doesn't have to be a negative experience and they may serve as a source of clients, employees and referrals in the future.

There is sometimes resistance to allowing employees to develop their personal networks so that it includes other lawyers. The fear is that they will simply use it to get a new job. But, of course, knowledge of the market generally can be brought back to improve the business and lead to innovation. The key is being open about it and expecting people to bring the information back to benefit the firm.

For those interested in developing tours of duty, the next step is to establish the current skill level of your employees and the long- and medium-term aims of the business and the employees, making it clear that this is not about establishing who will or will not be retained, and instead about trying to ensure that employees are satisfied in their work. Hopefully, these aims will align, but if not this will help to establish any issues that may arise in future. ●



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# OPEN FOR BUSINESS

A recent boost to social mobility in IP may have come from an unexpected quarter

**W**hile it's impossible to overlook the negative impact that the spread of COVID-19 has had on our society and economy, and especially the personal toll that it has had on so many families, it's also true that this terrible crisis has brought about some interesting changes – and one of these could be the prospect of improved access to legal careers, including the specialism of IP.

November will see the IP world focus on Careers in Ideas, an initiative launched in 2018 by IP Inclusive with the aim of raising awareness of IP-related

job opportunities. In advance of a week dedicated to this important objective, IP Inclusive hosted a roundtable bringing together a range of voices from the world of legal recruitment to discuss what candidates are seeking in their employers and how diversity and inclusion efforts can play a part.

One of the panel's conclusions: that when it comes to more inclusive recruitment, COVID-19 has brought some unexpected benefits. For one thing, the panel noted that the move to a remote-access selection process has "opened the field to previously excluded or discouraged groups – for example, disabled people, parents and other carers, and people living in less accessible

parts of the country – thus widening the pool of people from which you can feasibly recruit". In addition, remote interviews offer employers an opportunity to "assess a candidate's ability to work and communicate in a virtual space, which is fast becoming a core business skill".

Crucially, the panel reported that COVID-19 has "provided an ideal opportunity to recruit a more diverse intake, which in turn allows us to access a wider and deeper talent pool and bring in new perspectives, making our teams more innovative and effective while also improving our attractiveness to clients and future recruits".

Words: Caitlin Mackesy Davies

### MAKING ROOM FOR MOBILITY

This opportunity will undoubtedly be welcome, even if its root cause is not. That's because social mobility continues to be a huge challenge for the UK. In fact, "the situation is dire," said Sarah Atkinson, Chief Executive of the Social Mobility Foundation



The Sutton Trust's "Pathways to Law" programme offers Year 12 students a chance to explore the legal profession

(SMF), in her response to the latest Social Mobility Commission (SMC) report, released in June. "This report shows that the British promise to young people – work hard and you will be rewarded – is still being broken, and in fact it is where you are born and your family background that determines your life chances. Levelling up is at risk of becoming a cruel joke."

The SMF highlights the scale of the problem in its 2019/20 annual review, noting that: just 5 per cent of students eligible for Free School Meals go on to study at the most selective universities (compared with a national average of 12 per cent); employees in elite occupations who are from working-class backgrounds earn on average £6,400 less per year than their peers from wealthier backgrounds; and, tellingly, 65 per cent of senior judges were privately educated, compared with just 7 per cent of the whole UK population.

With its history of hiring from elite universities, it's no wonder the legal sector can be particularly hard to access for those from less privileged backgrounds. Yet there are ways to pick apart this pattern. For example, the SMF offers an Aspiring Professional Programme and law is one of the 11 sectors targeted. The programme provides mentoring, work placement and upskilling opportunities for young people from age 16, and the

SMF is also working to build a graduate recruitment pipeline. In February, it launched a "Department for Opportunities" with the aim of "raising the profile of social mobility as a cause with the public and building networks with organisations and institutions [including employers] who can improve social mobility across the UK".

Meanwhile, the Sutton Trust has put together a two-year "Pathways to Law" programme, which offers Year 12 students from state-funded, non-fee-paying schools a chance to explore "what entering the legal profession might look like". The programme prioritises students based on a number of criteria, including those who would be the first in their family to attend university or who live in an area with a low rate of progression to higher education or a high level of socio-economic deprivation.

In addition, PRIME – an alliance of more than 60 UK law firms – is working to bring students into the Solicitor profession. In an article on the PRIME website, Katie Faulds of Crasner Consulting highlighted the role of educational opportunity in social mobility, noting that "the fact that the university someone attends plays a significant role in influencing

one's access to graduate jobs and starting salary (with certain 'elite' employers targeting only a selective group of universities) [...] means that, quite frankly, one's careers can be somewhat defined and curtailed at the mere age of five years old, with the choice of school that parents and/or guardians make". "These stifling statistics become even worse when we drill down into the legal profession," she asserts, labelling the situation "scandalous".<sup>1</sup>

### GIVING YOU GUIDANCE

For its part, IP Inclusive has produced a blueprint for firms that want to take action in the form of its Recruiting for Social Mobility guidelines. As the guidelines stress, this is not an exhaustive list (or a replacement for specialist legal or HR advice), nor will the ideas suit all employers, but the hope is that they will provide a useful starting point.

For one thing, it suggests that when you engage in outreach – for instance via careers fairs, exhibitions or talks at schools and universities – you consider how to target or create events that will reach students from less privileged backgrounds. This could include visiting schools or universities that you haven't previously interacted with. Outreach to schools that are underperforming and those in less privileged areas will also provide access to a different

talent pool than you may be used to exploring. Consider also reaching out to students on vocational rather than academic courses.

The way your firm presents itself to be public may be worth reviewing, with an eye on how your firm appears to potential recruits from less privileged backgrounds. Are you broadcasting an environment in which they would feel they are likely to fit in? According to IP Inclusive, using descriptors such as "exclusive" and "technical

fairer recruitment processes may, by contrast, provide encouragement.

### ASSESSING YOUR APPLICANTS

Some ways to improve fairness when you're assessing applications include using "blind" selection processes to draw up a shortlist. This involves omitting some types of information from the selection process, perhaps by removing the names of schools or universities attended (focusing instead on results attained), as well as the years in which qualifications

*“With its history of hiring from elite universities, it's no wonder the legal sector can be particularly hard to access*

excellence" may discourage certain applicants. It suggests looking at whether you could promote qualities such as approachability, client care, innovation and creativity.

### ADVERTISING ISSUES

Take care in how you advertise your vacancies, in case you are inadvertently discouraging people from less privileged backgrounds from taking that first step. IP Inclusive recommends advertising widely, in particular on social media, in directories that are accessible to job-aggregator search engines, and through careers advisers in educational settings, as well as in the local and national press.

Be careful with the language you use in adverts too, so that it doesn't put off people who are less confident of their abilities. Words like "elite" and "high-flying", or suggesting that a degree should be from a "top-flight" university, could have the effect of deterring able candidates from a variety of backgrounds. Stuffy, formal language and IP jargon will also put up barriers.

Mentioning diversity and inclusion credentials, support networks and

were received or the candidates' dates of birth (since people who have not had a positive educational experience may take longer to achieve academic qualifications).

The practice of "contextual recruitment" can also help to broaden the candidate pool. This means taking account of a candidate's background and personal story when assessing their achievements, so that you don't unnecessarily dismiss a talented applicant. A set of high grades earned at a poorer-performing school could tell you more about a candidate than a set of similar results from an elite independent school, for example. Be attuned to other circumstances – illness, trauma or other factors – that might have affected the candidate's ability to achieve academically.

Other ways to consider a candidate's context include:

- Be alert to how gaps in education or attainment are accounted for in cover letters, or ask candidates about such circumstances at interview. Think of their answers as explanations, not excuses.
- While it is crucial not to inadvertently introduce "positive discrimination" (the recruitment

5%

of students eligible for Free School Meals go on to study at the most selective universities

(National average: 12 per cent)

Employees in elite occupations who are from working-class backgrounds earn on average

£6,400

less per year than peers from wealthier backgrounds

65%

of senior judges were privately educated, compared with just 7 per cent of the whole UK population



process must be fair for all candidates), provide a space for contextual information in any standard application form (for instance, to explain gaps in CVs or any unusual subject choices, grades or educational routes).

- Beware of placing too much emphasis on a candidate's sporting or musical talents or any interesting hobbies, since these may be the result of a privileged upbringing rather than the candidate's resourcefulness.
- Equally, IP Inclusive advises that you should not assume that candidates who have reached a "top-flight" university or attended an independent school did so only because of a privileged background. Be attentive to the "back story" that may show they got there through exceptional application and sacrifice.
- And, importantly, ensure the selection process is based on objective criteria. Require selectors to document and justify decisions, for instance using a score sheet for each candidate. Having a number of people involved in the selection process can also be useful so that they can exchange ideas and perspectives on each candidate. Involving experienced HR professionals can also be valuable.

### THE INTERVIEW PROCESS

At interview, the same caveats about objectivity apply, and interviewers

should be appropriately trained and briefed. Factors that can trip up interviewers in terms of bias include: accent; a candidate's level of self-confidence; grammar; and a lack of similar cultural touchpoints to the interviewers.

In light of the current COVID-19 limitations, many interviews will be carried out with web-based tools. In these cases, do be aware that a candidate may not have access to a wide array of devices or software through which to take part.

Whatever the format of the interview, telling candidates what will be expected of them and providing information about who they will speak with, any dress code required and the type of questions that will be asked will help to make those with less interview experience (or those who have not had access to coaching) more comfortable with the process. Do remember to make allowances for nerves, and do whatever you can to help candidates from less privileged backgrounds do their best and demonstrate their full potential.

### AFTER THE INTERVIEW

While it isn't strictly part of the recruitment process, it's worth doing some work to ensure that your new joiners don't become fast leavers. This means giving them support as they settle in as new members of the team.

For example, if you've identified gaps in their education that need to be addressed, consider training in those areas, and allow extra time for them to gain "missing" skills and knowledge. Be sensitive when it comes to socialising, too. They may not be able to afford a meal or drinks out with the team or be comfortable with a quiz night that requires common "cultural capital".

And, crucially, continue to nurture an inclusive environment, where everyone can be comfortable being themselves, share their concerns and experiences, find role models and gain confidence as they pick up experience and skills.

Ultimately, as the IP Inclusive panel also noted, the key factors in attracting and retaining good employees in the future will not change: communication, flexibility, inclusivity, nurturing and trust.

However, the panel concluded: "To be successful after COVID-19, we must embrace the changes it has made possible, rather than insisting on returning to how we were before. This is as important in the context of recruitment and retention as in any other aspect of a business." Securing greater social mobility is surely one of the most positive of the fresh possibilities. ●

1 Katie Faulds, "Talent is everywhere, opportunity is not", February 2020, at: [primecommitment.co.uk/articles/talent-is-everywhere-opportunity-is-not](https://primecommitment.co.uk/articles/talent-is-everywhere-opportunity-is-not)

### MAKE A DIFFERENCE FOR SOCIAL MOBILITY

A task force has been established to build a network of organisations and individual contacts through whom careers resources can be disseminated, or who might collaborate in opening up the IP professions to a wider pool of recruits. If you would like to support the task force in any way, please email Chris Burnett at [chriscareersinideas@gmail.com](mailto:chriscareersinideas@gmail.com)





# WHEN COURT COMES CALLING

Andy Lee provides a comprehensive introduction to IP court proceedings and some ways to improve your chances of being on the winning side

**IP** rights almost always relate to key revenue drivers and are therefore fundamental to a business. Further, a healthy portfolio of IP rights can increase the value of a business, the IP position being a well-researched area of corporate due diligence.

Fundamentally, these rights are negative rights that prevent others from infringing against a business's IP. So it is perfectly reasonable to

ask, "What is the point in obtaining rights if, when transgressed, they are not enforced?" The answer is that failing to act can result in the loss of those rights, as well as potentially damaging the underlying business.

And, importantly, in IP litigation the fight is not usually about money. It's about putting a stop to a given activity (or not). The injunction is the most valuable prize up for grabs. So, investing in proceedings can be a shrewd way of protecting market share and growth.

Sure, not every claim is meritorious. A defendant faces being sued and will need to deploy resources and management time should a threat to its activities arise. Similarly, not all claimants have money to burn, and the choice of whether or not to invest such resources and time in litigation can pose a conundrum.

#### A DIFFERENT WORLD

Bringing IP litigation proceedings opens up a whole different world compared with registry proceedings. For example, registry opposition proceedings operate in a hypothetical world, considering a notional and fair use of both the mark applied and the mark on the register across the relevant specifications of each. They are low-cost and streamlined and do not have many of the features of court proceedings. A registry dispute can result in the non-registrability or loss of the mark (or partial loss), but they do not prevent a third party using that mark. That is what infringement proceedings can achieve, and those proceedings operate with a critical eye as to what is happening in the real world.

Procedurally, IP claims operate as split trials. The court first adjudicates on liability. If a claimant is successful, it can then pursue (through another trial) compensation in the form of damages or an account of profits. A successful claimant is afforded a range of remedies through litigation (injunctions, delivery up, etc). Claims are brought in the full High Court, the Chancery Division or the Intellectual Property Enterprise Court (IPEC, formerly the Patents County Court), which is part of the High Court.

Historically, a problem, particularly for smaller businesses, was the cost of proceedings. For example, a business might be unable or unwilling to commit large amounts of money to fund litigation, or might be deterred from going to court by the prospect of facing a large adverse costs order if unsuccessful.

“ Not all claimants have money to burn, and the choice of whether or not to invest such resources and time in litigation can pose a conundrum

#### COMPLEMENTARY ROUTES

The IPEC's core objective – reiterated by judges on many occasions – is providing access to justice at a proportionate cost for businesses that might otherwise be deterred from bringing or defending an IP case. It looks to achieve its objectives through its own rules and structure, taking the factors that make litigation expensive and controlling them. More active judicial management of cases, limiting evidence and disclosure, and capping costs recovery (£50,000 on liability and £25,000 on damages/account of profits) are all aimed at providing litigation at proportionate cost. Cases should also be capable of being heard in two (exceptionally three) days of trial. IPEC has the jurisdiction to hear all IP rights and can provide the same remedies as the full High Court. However, the nature of IPEC can mean that a client may have to cut its cloth accordingly in advancing a case.

Full High Court proceedings allow larger, more complex and evidentially heavier IP cases to be determined. Measures are in place to manage costs (cost budgeting) and disclosure (through the disclosure pilot scheme), but the effectiveness of these measures is debatable.

Whichever route is taken, parties will deal with common features such as pleadings, disclosure, witness evidence and the trial itself. Each step is part of the process of the court reaching a final determination on the issues. Thinking ahead as to how one step might affect another is important. For example, what you say in a letter of claim (or a reply to one) might be used by your

opponent in cross-examination. A good counsel can have fun with a witness if exaggerated claims have been made or if questionable facts have been advanced in correspondence.

Whether acting for a claimant or defendant, it is critical to agree an objective early. A claimant's objective might be to have the defendant stop selling goods bearing the problematic sign. It is not uncommon for a client to get “carried away” as the litigation progresses, and when presented with a deal which would achieve that objective, cognitive dissonance takes over and the opponent is said to be acting unreasonably.

An early detailed investigation into the facts is critical. Former Supreme Court judge Lord Sumption once said that the “most difficult” thing about practising law was “not the law but the facts” and that “most arguments which pretend to be about law are actually arguments about the correct analysis and categorisation of the facts”. Clients can often tell you what they believe you want to hear. It is important to drill down at an early stage into the client's case. Gaps found early might be able to be plugged; gaps at trial almost never so.

#### DRILLING DOWN

When acting for a claimant, this important first step could be as simple (and critical) as identifying whether the client owns the rights it wants to enforce – for example, goodwill for the purposes of passing off. The business might have changed form over the years, and ensuring a clear line of title to

“ Disclosure should be considered early. It's better to know if documents exist which harm or support the client's case

goodwill will be critical before proceedings start. Similarly, companies might operate on an understanding – for example, that Party A has given permission for Party B to trade using its trade mark. However, Party B may require the execution of an exclusive licence to enable it to sue.

Identifying the defendant(s) is also vital. Nowadays, particularly when businesses operate a mixture of online and physical operations, different (but linked) business may be responsible for different aspects of the whole operation. Ensuring that an injunction will apply to all of them is key.

When acting for a defendant, detailed investigation of the claimant should be made. That might include looking into its means, and whether there has been use of the mark at all (if subject to non-use) or on the scale claimed (in cases where there are claims of acquired distinctiveness or a reputation). Has the claimant just made a groundless threat? Be careful here: such an allegation could force the claimant's hand, making the next piece of correspondence an issued claim.

#### WEAPONS AVAILABLE

If proceedings are launched, a critical analysis of the opponent's pleaded case is crucial. The court offers many weapons that can be

deployed to put your client in a better position. For example, strike out applications and summary judgments can be effective ways of dealing early with a weak claim, or parts of it. If a pleading is unclear, seeking further information from your opponent under Civil Procedure Rule 18 can be useful. If a claimant is of limited means, a defendant may consider asking the court for security for its costs at an early stage. A smaller defendant sued in the full High Court may

also consider applying for transfer to IPEC to limit its exposure.

Disclosure should be considered early. Disclosure is a “cards on the table” requirement. A client will need to disclose documents which both help and hinder. It's better to know early if documents exist which harm or support the client's case and where any gaps might be. Clients often need to understand that an impartial human being will decide their case, most often considering the evidence, and so what can be achieved will often depend on the evidence available or obtainable.

Ensuring witness statements are properly prepared is also key. The purpose of witness statements is explained at s19.3 of the Chancery Guide: “It is not, for example, the function of a witness statement to provide a commentary on the documents in the trial bundle”. Recently, there has been increasing judicial criticism<sup>1</sup> of “overly lawyered” witness statements, so be careful to avoid including anything that

might be interpreted as comment, argument or submission.

Equally, remember that your witness will be cross-examined and that poorly prepared statements leave that person a hostage to fortune and bait for a skillful cross-examiner. A witness who performs poorly will not impress the judge. That could be decisive in which way the case swings.

For the trial itself, neatly prepared working bundles are critical. Few things annoy a judge more than poorly prepared ones. Also, do you really need to include every page of correspondence that has passed between the parties? As Mr Justice Nicklin explained earlier this year: “A good rule of thumb is to ask, ‘Is the court likely to be referred to or want to see this document in the course of the party's submissions?’”<sup>2</sup>

#### A MIX OF GOOD AND BAD

It is also important to bring the court solutions, and not just problems. Judges are not head teachers at an infant's school, refereeing playground fallouts. Whinging to the judge about how nasty your opponent has been will rarely impress. Focus instead on persuading the judge why they should find for your client considering the law, issues and facts. Sir Robin Jacob's cake and turd principle<sup>3</sup> is often helpful: advance your best points and avoid spoiling them with bad ones alongside. ●

*Andy spoke at a recent CITMA webinar on this subject.*

<sup>1</sup> See, for example, Waksman J in PCP Capital Partners LLP & Another v Barclays Bank plc, [2020] EWHC 646 (Comm), 12th March 2020.

<sup>2</sup> Greensill Capital (UK) Ltd & Another v Reuters News And Media Ltd, [2020] EWHC 1325 (QB), 14th May 2020

<sup>3</sup> That a tempting piece of cake suddenly becomes less tempting when a turd is placed near it.



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Jaega Wise of Wild Card Brewing is one of those bringing variety and vibrancy to the UK's craft beer scene

# WILD AT HEART

## Can craft beer brands protect their IP as well as their independent spirit?

**T**he craft beer market in the UK has grown exponentially in recent years and is currently providing consumers with a sensational selection of high-quality brews. Discerning beer drinkers in the UK have their pick of some of the world's best breweries, and the market has become extremely competitive as a result. Meanwhile, thanks to media coverage of several large-scale disputes over the past decade, we've seen that enforcement of IP rights in the brewing space is subject to certain peculiarities, and it has become clear that a specialised enforcement strategy and understanding of the industry are key.

In fact, the craft beer industry in the UK is an unusual beast: craft breweries must strike a balance between maintaining a desirable (and

saleable) spirit of collaboration and community while enforcing IP and protecting their brands. These goals sometimes come into conflict, and breweries leaning too far in either direction will often be penalised through negative PR or commercial brand damage. Enforcement that appears heavy-handed or overly "corporate" may damage a brand beyond repair if made public, but failing to protect one's IP may dilute or damage a brand.

At the same time, given the rise of contract brewing and the corresponding decline in openings of new physical breweries, it has never been easier to get your brand on a product. Traditionally, brewers would need to commit to expensive equipment and space, but these initial overheads can now be avoided and products can be on shelves more

quickly than ever. This has made the branding of individual products vital and the clamour for consumer recognition even greater.

However, despite the growing competition, the craft beer market maintains a strong sense of community. Commenting for this article, Jaega Wise, Head Brewer at Wild Card Brewery in East London, says that "the industry is casual, friendly and ultimately relationship-based". This results in plenty of collaborations between breweries and well-attended events aimed at the brewers themselves. With this in mind, one might wonder how to take a hard stance in protecting brands while still maintaining industry relationships – all against a backdrop of products that qualify as fast-moving consumer goods well-suited to injunctive relief.

### MARKETING MASTERCLASS

A recent incident involving BrewDog and Aldi is a fascinating example of enforcement and collaboration in the

brewing space. BrewDog has announced (at the time of writing) that Aldi will shortly stock a new product named ALD IPA, made by BrewDog. This followed a very public back-and-forth between the two parties over social media. The exchange began with an announcement by ALDI of an "Anti-establishment IPA", the packaging of which carried some visual similarities to BrewDog's flagship Punk IPA – a development that met with BrewDog's disapproval.

A few weeks on, it appears the parties have – perhaps uncannily easily – concluded that dispute in a sensationally beneficial manner for both parties. In creating a new product in collaboration, ALDI will stock another highly desirable beverage and BrewDog will benefit from a huge number of sales while maintaining its disruptive image. Involvement of the public



“ IP issues in the craft beer space can be resolved over the phone 95 per cent of the time

in the lively and good-natured banter between the parties via social media has only furthered the parties' interests. Indeed, Wise considers it a "marketing masterclass", and it's hard to disagree.

Often, however, the most publicised disputes have involved a party outside the brewing industry – and have not been solved so amicably. These sorts of challenges rarely follow the unwritten values of the craft beer world, and those falling short of industry standards risk being subject to a loud and public reaction. One such recent dispute involved a challenge by fashion powerhouse Hugo Boss against small Welsh brewer Boss Brewing over its beers BOSS BLACK and BOSS BOSS. The outcome was a change of name for a few of Boss Brewing's products, but some fairly serious media fall-out for Hugo Boss.

### PLAY IT PERSONAL

So, what are the considerations for IP enforcement for brewing industry brand owners who wish to maintain their market share as well as their appealing and collegiate image?

Importantly, the first discussion about a potential issue should be in person or over the phone. Wise estimates that IP issues in the craft beer space can be resolved over the phone 95 per cent of the time. Since the industry is rife with personal relationships and friendly networks, the likelihood is high that someone within the earlier right-holding brewery will have a contact at the potentially infringing brewery. A phone call or a chat at an event will usually be enough to settle the dispute and may also reduce the

risk of initial correspondence being made public.

Be aware, also, that any written correspondence may be publicised. This is a consideration in all industries, but the danger is potentially greater in the brewing space since it takes relatively little to appear heavy-handed here. If the first contact over a potential infringement is in writing, particularly if it does not come from the brewery directly, it may appear more aggressive than intended. To mitigate this, first contact ought to be made by the brand owner. Draft wording prepared by a legal adviser can be useful, but a friendly tone can pay dividends, especially where you're trying to set the tone for a settlement.

Because a negative decision in registry or court proceedings will often be highly publicised in the industry, it is imperative that brands are cleared and registered from the outset. Negative decisions are often viewed as proof that the losing party was in the wrong. While we know that this is not always the case, the risk of negative PR means that ensuring you have the rights necessary to be successful in proceedings (if needed) is of paramount importance. Breweries are wise to this: from 2009 to 2019, the annual number of trade mark applications filed covering "beer" in class 32 increased by around 530 per cent. This leap is indicative of the growing market and the resulting importance of IP protection.

Ultimately, while 2020 has brought new and serious challenges for the craft beer sector, I have every faith that it will rally and continue to grow, bringing enormous rewards for those who employ a well thought-out IP enforcement strategy. ●

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# TRADING UP

The biggest brands often see African markets as a major prize. But well-known names should proceed with care, warns Chinwe Ogban

**T**he survival of a business and the success of its products in the market are intrinsically connected with the popularity of its brand. It's the brand identity by which consumers distinguish that business from other similar brands or products, usually through unique

symbols, logos, names, insignia, sounds and so on.

This is particularly true of well-known trade marks. Just consider Metro-Goldwyn-Mayer's trademarked sound of a roaring lion, Apple's unmistakable logo of an apple with a bite missing from its right-hand side, or the ubiquitous Coca-Cola signature.

A mark is generally considered to be well-known when it is recognised by consumers in relation

to specific goods or services and is recognisable by consumers within the territory of the relevant trade mark regulation (a country or regional body). In addition, a mark does not always need to be registered in a given country or region in order to receive protection. (See the panel on page 22 for more information.)

Last year, Forbes reported that the 30 most valuable brands in the world are now worth an estimated total of \$1.48 trillion. In this highly esteemed clique are brands such as Google, Facebook and Nike.

However, the popularity of these brands comes at a price. Specifically, that price is trade mark squatting, dilution, counterfeiting, infringement and long-term disputes over the proprietorship of these

marks. A classic case in point is Victoria's Secret v Shanghai Maisi Investment Management Company, a dispute over alleged trade mark infringement.<sup>1</sup> The defendant had used the plaintiff's mark to indicate products in its stores, and the court held that this indicated an intention to mislead consumers as to the origin of the goods.

In 2018, the continent of Africa recorded merchandise-based trade worth more than \$998bn<sup>2</sup>, and the region has been touted by trade experts as one of the fastest growing in the world. As a result, many trade marks that have had success in other regions are now seeking to expand their business interests into African countries by leveraging their fame. The same can also be said for intra-continental business expansion.

However, well-known brands are faced with some Herculean challenges when seeking to register their popular marks in many African markets. First among these is the issue of trade mark squatting.

For successful international brands hoping to break into African markets, it is imperative to understand which African regimes provide protection for well-known marks and the extent of that protection.

## NIGERIA



Nigeria operates a first-to-file system, which makes it difficult to prevent well-known marks from being registered by other entities.

*“ For international brands, it is imperative to understand which African regimes provide protection for well-known marks and the extent of that protection*



In addition, Nigeria is yet to domesticate the relevant provisions of the Paris Convention for the Protection of Industrial Property, meaning it may be more difficult for foreign brands to avail themselves of protection for their well-known marks.

But, despite these challenges, a brand owner can apply to the Registry or Court under s11(a) of Nigeria's Trade Marks Act<sup>3</sup>, which forbids the registration as a trade mark or part of a trade mark “any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice or be contrary to law or morality”.

Although this does not constitute a direct replication of the spirit of the Paris Convention, this provision empowers the Trademarks Registry to refuse or cancel the registration of a well-known foreign or domestic mark on the basis that is likely to deceive or cause market confusion. However, the criteria for determining a well-known mark are largely undecided and will be on a case-by-case basis.

Further, the Nigerian Trade Marks Act provides for defensive trade mark registrations. A registered trade mark owner can apply under s32 for defensive registration of its marks in other classes, even where it has no intention of use. The rationale is that this will help to prevent infringers from profiting from the reputation and goodwill of the well-known mark by selling goods/services in other classes.

Trade in Africa was worth  
**\$998bn**  
in 2018

## GHANA

In Ghana, well-known marks are protected by the amended Trademarks Act.<sup>4</sup> Section 5(b)(f) of the Act provides that a mark shall not be registered if it is identical, confusingly similar or constitutes a translation of a trade mark or trade name which is well known in the country for the identical or similar goods or services of another enterprise.

The provision goes further, to protect well-known marks against the registration of such marks for non-identical goods/services where the use of the mark would likely indicate a connection between those goods or services and the owner of the well-known trade mark, potentially resulting in damage to the original owner's interests.

Under s12 of the amended Act<sup>5</sup>, well-known marks are defined as the trade mark of a person who is:

- (a) a national of a country that is a party to the Paris Convention; or
- (b) domiciled in or has a real and effective commercial establishment in a country that is a party to the Paris Convention, where the trade mark is recognised or known in the relevant public sector as belonging to that person.

## SOUTH AFRICA

South Africa's Trade Marks Act has adequate provisions to protect well-known marks. Under s10(6), owners of well-known marks can oppose trade mark applications for marks similar to theirs, and ▶





they can institute infringement actions under s35. These proceedings can be instituted whether or not the owner is actively carrying on business in South Africa.

Also, South Africa operates a first-to-use system, which means a mark acquires common law rights once it has garnered reputation and goodwill among the relevant public. This implies that an unregistered well-known mark in South Africa can enjoy protection in the country. The requirement for a mark to be regarded as well-known is such that a substantial portion of the public must associate the goods or services as originating from a given source.

Section 34(1)(c) of the Trade Marks Act further provides against dilution by empowering owners of well-known registered marks to prevent the use or registration of similar or identical marks in the course of trade which are likely to deceive or mislead consumers.

In determining whether a trade mark is well known, s35(1)(a) of the amended Act provides that due regard shall be given to the knowledge of the trade mark in the relevant sector of the public, including knowledge which has been obtained as a result of the promotion of the trade mark.<sup>6</sup> The conditions of nationality or domicile in a Paris Convention country also apply to persons claiming entitlement to protection of well-known marks under the Trade Marks Act.<sup>7</sup>

## EGYPT

Article 68 of Egypt's trade mark law<sup>8</sup> provides that the owner of a well-known trade

Sony lost out under Kenya's IP regime



mark, worldwide and in Egypt, shall have the right to enjoy protection, even if the mark is not registered in Egypt.

Article 68's second paragraph domesticates Article 6<sup>bis</sup> of the Paris Convention. It empowers the Trade Registry Department to reject applications to register marks that are identical to existing well-known marks.

The third paragraph of the Article extends the protection for well-known marks where the goods/services being registered are not identical, provided that:

- (a) the well-known mark is registered in a country that is a member of the World Trade Organization and in Egypt; and
- (b) the use of the mark in relation to those non-identical products is intended to lead people to believe that a connection exists between the owner of the well-known mark and those products, and that such a use may be prejudicial to the interests of the owner of the well-known mark.

## KENYA

Kenyan trade mark law recognises protection for well-known marks and defensive registration for goods and services.<sup>9</sup>

Section 15(a) of the Trademarks Act domesticates Article 6<sup>bis</sup> of the Paris Convention and affords protection only to nationals of and entities domiciled in Paris Convention countries.

Section 15(a)(2) provides that a trade mark owner is entitled to restrain by injunction the use of a similar or identical mark that is likely to mislead or confuse the consumer as to the origin of the mark. However, in Kenya, the bar for proving



## THE PRICE OF FAME: MORE ABOUT BEING WELL KNOWN

While not directly defining a well-known mark, Article 6<sup>bis</sup> of the Paris Convention for the Protection of Industrial Property (as amended) provides for the protection of marks that are considered well-known by the competent authority of a member country. This means that each member jurisdiction will be responsible for providing the parameters for a mark to qualify as a well-known mark. Under the Convention, countries are mandated to refuse, cancel the registration for or prohibit the use of a well-known mark either unilaterally or based on an application by an interested party.

Article 16(3) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) expands the scope of protection under Article 6<sup>bis</sup> to cover prohibition and cancellation of use of a well-known mark with respect to goods/services that are not similar to the goods/services with which the well-known mark is associated, provided that such use is likely to mislead consumers that the dissimilar goods originated from the owner of the well-known mark.

that a mark is well-known is quite high. In the case of Sony Corporation v Sony Holdings Ltd<sup>10</sup>, where the court denied the famous plaintiff protection, it ruled that

certain factors had been suggested by the WIPO to determine whether or not a trade mark is well known. These include:

- the degree of knowledge or recognition of the trade mark in the relevant sector;
- the duration, extent and geographical area of the use and promotion of the trade mark;

Brands in the pharmaceuticals industry are at particular risk of infringement and counterfeiting



- the duration and geographical areas of any trade mark applications or registrations;
- the record of successful enforcement of rights in the trade mark; and
- the value associated with the trade mark.

## RELEVANT BODIES

### ORGANISATION AFRICAINE DE LA PROPRIÉTÉ INTELLECTUELLE (OAPI)

OAPI covers 17 mainly French-speaking countries in West Africa. It can be considered a first-to-file jurisdiction, and common law rights are applicable within its regional influence. This implies that well-known marks in use within the Member States can oppose the registration of identical or similar marks. OAPI also recognises protection for well-known brands, as provided under the Paris Convention.

### THE AFRICAN REGIONAL INTELLECTUAL PROPERTY ORGANIZATION (ARIPO)

ARIPO covers 19 mainly English-speaking countries in East Africa.

The Banjul Protocol, which is the relevant treaty of ARIPO when it comes to trade marks, makes no mention of well-known marks. This effectively means that owners of well-known brands and trade marks must look beyond the regional body to identify those individual Member States that protect well-known marks via their national IP legislations.

### NO UNIFORMITY

It is clear from the examples provided that there is no uniform protection for well-known marks in Africa. The situation is even more precarious for brand owners in the pharmaceutical industry, where counterfeits are rising at an alarming rate. The same can also be said for the technology and fast-moving consumer goods (FMCG) sectors.

Therefore, owners of famous brands – and growing, aspirational brands that hope to one day dominate their market – need to proactively protect their brands and business interests in Africa by understanding the range of legal regimes and practices. It's this author's hope that this summary will provide a starting point. ●

1 SPC Gazette, Issue 8, 2017 (No. 250)  
 2 Afreximbank's Africa Trade Report 2019, accessed via [afreximbank.com/africas-output-grew-by-3-4-in-2018-afreximbanks-africa-trade-report-2019-shows/](http://afreximbank.com/africas-output-grew-by-3-4-in-2018-afreximbanks-africa-trade-report-2019-shows/)  
 3 Trade Marks Act Cap. T13, Laws of the Federation of Nigeria 2004  
 4 Trademarks (Amendment) Act 2014, Act 876  
 5 Section 12 amends s52 of the principal Trademarks Act (Interpretation Section).  
 6 Intellectual Property Laws Amendment Act, Act No. 38, 1997  
 7 Section 35(1), Trade Marks Act 1993  
 8 Intellectual Property Rights Law, No. 82, 2002  
 9 Section 30, Trademarks Act  
 10 [2015] Civil Appeal 376, eKLR (2018)

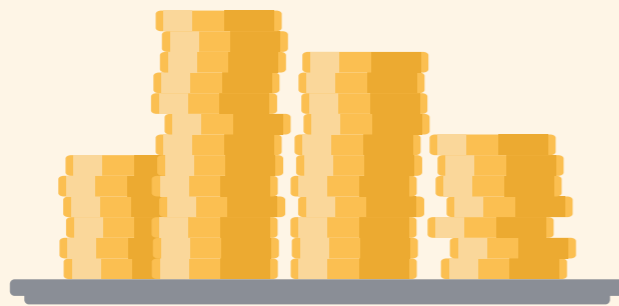


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# A COLLECTOR'S ITEM



Dewdney Drew shares lessons from his experience of enforcing costs awards

There was a time when UK IPO costs awards were not a big deal. Plaintiffs held no expectation of recovering their costs, and defendants did not fear an award. Awards tended to be small, and the logic that the amount was too small to be worth enforcing gave many pessimistic defendants comfort. Now, though, that era is over.

Off-scale costs have been an option since 1993<sup>1</sup> but have become more topical in the wake of the battles between Apple Inc. and Michael Gleissner. For example, in O/118/17,

Apple was the beneficiary of an order to the tune of £38,085.

Off-scale costs are there to punish unreasonable behaviour, and rightly so. But preparation is key if you hope to call upon such an order.

### MAKE YOUR MARKERS

If you find yourself up against an unreasonable litigant, it is advisable to lay down suitable markers along the way on which you can rely later. Examples of tactical action include:

- Noting and keeping evidence of specific instances of unreasonable

behaviour by reply correspondence as and when they occur;

- Formally inviting the other side to withdraw an action or request, using the threat of off-scale costs; and
- Indicating that you would entertain settlement proposals, and reiterating this as needed.

Corresponding on a “without prejudice, save as to costs” basis exclusively between the two parties is the traditional route. However, with a really obtuse adversary it is sometimes better to lay down the markers in open correspondence,

“ The logic that the award was too small to be worth enforcing gave many pessimistic defendants comfort. Now, though, that era is over

copying in the IPO. This can be more effective because it brings the Hearing Officer (HO) along with you. It can also serve as a course-correction measure, should you be misreading the situation.

If you have laid down the markers correctly and given ample opportunity for the other side to refrain from unreasonable behaviour, the HO should be on the same page as you by the time you submit the request. In an ideal scenario, it is then simply a question of summarising the history and pointing to the markers, and an off-scale award should follow.

### SECURITY FOR COSTS

The Registrar’s power to award security for costs comes from the Trade Marks Rules 2008, rule 68, which states that:

(1) The Registrar may require any person who is a party in any proceedings under the Act or these Rules to give security for costs in relation to the proceedings; and may also require security for the costs of any appeal from the Registrar’s decision.

(2) In default of such security being given, the Registrar, in the case of proceedings before it, or, in the case of an appeal, the person appointed under s76, may treat the party in default as having withdrawn their application, opposition, objection or intervention, as the case may be.

While the guidance provided in the Trade Marks Manual (Tribunal Section, 5.6) focuses on overseas companies or individuals, a domestic company or individual with insufficient assets is equally susceptible to such an order. In a recent decision, Mr Phillip Johnson noted that while “a request for a security for costs must include material adequate to suggest that a party has insufficient funds to satisfy any costs order, there is a limit to what can be expected”.<sup>2</sup> In that case, evidence of overdue

accounts from Companies House was deemed sufficient and this was regarded as “reflect[ing] what a party can be reasonably expected to produce without going to disproportionate expense (by, for example, instructing inquiry agents)”.

So, if the other side is a company, check Companies House. If the other side is an individual, various public domain checks can be run to determine whether they are bankrupt or have any judgments against them, for example. Prior unpaid UK IPO costs orders (or indeed EUIPO costs orders) could provide convincing evidence.

If you are able to establish a prima facie case, the presiding HO will call for the other side to file evidence in reply, to rebut your claim. If they fail, an order for costs will normally be given (unless there are discretionary reasons not to do so). If the other side does not pay the necessary amount into a UK IPO account, they cannot proceed.

### ENFORCING ORDERS

Section 68(2) of the Trade Marks Act 1994 provides that: “Any such order of the Registrar may be enforced – (a) in England and Wales or Northern Ireland, in the same way as an order of the High Court; (b) in Scotland, in the same way as a decree for expenses granted by the Court of Session.” Nonetheless, collection agencies often scratch their heads when they are instructed to collect one. The uncertainty extends to High Court Enforcement Officers (for Scotland, Sheriff Officers). This is probably due

to the rarity with which these awards are enforced.

This author once had a case where the client felt very strongly about enforcing a small on-scale order against a member of an extremely wealthy family. It took a lot of following up, but the order was paid. Without recommending a specific collection agency, the key to success is persistence. More specifically:

- The collection agency needs to be guided into understanding that the order has the same status as a High Court order and should then reassure the enforcement officers that the order has the necessary weight.
- It is helpful to have an original (paper) document to pass to the enforcement officers. If you do not have one, the UK IPO can provide one.
- Give the collection agency up-to-date details regarding the name, address and contact information of the entity or person against whom the order was made. It’s a simple point, but reducing the complexity when it comes to enforcing an unfamiliar type of order helps a great deal.

In summary, unless you have a client that is happy to spend double or triple the value of an on-scale costs award, it is unlikely to be enforced. The fact that collection agencies seem to be unfamiliar with UK IPO costs awards usually means paying for the Trade Mark Attorney to cajole, inform and chase it.

If you have put in the groundwork for an off-scale award and secured one, the cost-to-benefit ratio may be much more favourable, and enforcement is the way forward. And in this author’s experience, the Trade Mark Attorney is an important link in the chain. ●

<sup>1</sup> Rizla Ltd’s application, RPC 365  
<sup>2</sup> Appeal from O/261/20, DOUGLAS OF DRUMLANRIG, Decision on security for costs, 20th July 2020



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# Public perception tips the balance

Its role as an authority was an asset for British Gymnastics, reports Alex Deacon-Viney

**This case saw** the British Amateur Gymnastics Association (British Gymnastics) succeed in its claim against UK Gymnastics Ltd, its related company and sole director (together, UK Gymnastics) for trade mark infringement under s10(2) and s10(3) of the Trade Marks Act 1994 (the Act) and passing off.

## BACKGROUND FACTS

British Gymnastics is recognised as the National Governing Body (NGB) for the sport of gymnastics in the UK and previously operated under the name “the British Gymnastics Association” from around 1982 to 1997. From 1997 onwards, it used logos incorporating the words “British Gymnastics”.

The first Defendant, UK Gymnastics Ltd, provided membership services to individual gymnasts, gymnastics clubs and coaches, and also organised competitions, courses and educational services for coaches and gymnasts under the sign “UK Gymnastics” from at least 2015. The second Defendant, UK Gymnastics Affiliation Ltd provides administrative services for UK Gymnastics Ltd and runs an online store on UK Gymnastics’ website. The third Defendant, Christopher Adams, is the sole director of the first and second Defendants.

In 2019, British Gymnastics brought a claim against UK Gymnastics for trade mark infringement and passing off. British Gymnastics’ claim was based on the marks and signs shown opposite. Its passing off claim also relied on the parties’ respective get-ups, both of which featured the colours red, white and blue, and images of gymnastic-style motion in coloured swirls.

## EVIDENCE

British Gymnastics relied on witness evidence from Jane Allen, the CEO of British Gymnastics, and Phil Smith, Director of Sport at Sport England.

UK Gymnastics relied on witness evidence from its director, Mr Adams, and Jason Wise,

who oversees its operations. One of the key issues in dispute was whether UK Gymnastics could be classed as an NGB. UK Gymnastics claimed that it is an NGB, while British Gymnastics refuted this claim.

The Court heard evidence based on Sports Council recognition and Sports England guidance, as well as examination of both parties’ governance and safeguarding policies. British Gymnastics’ clear recognition as an NGB was important to Her Honour Judge Clarke in reaching her conclusions, particularly regarding the reputation and passing off claims. She ultimately found that UK Gymnastics had infringed British Gymnastics’ marks pursuant to s10(2) and s10(3) of the Act, for the reasons below.

## LIKELIHOOD OF CONFUSION

The services in class 41 were found to be identical, and the goods in class 28 were found to have a medium degree of similarity. UK Gymnastics admitted that the dominant element of the marks is the wording, and the words have enhanced distinctiveness. HHJ Clarke noted the high degree of conceptual similarity, due to “UK” and “British” referencing the same general geographical area, and the connotation of some form of formal and official status that those words give. In addition, the use of red and blue in both the marks and signs enhanced the conceptual similarity and overall “Britishness”. However, the aural and visual similarity between the marks and signs was considered to be low.

A likelihood of confusion, including a likelihood of association, was found. The medium level of similarity was offset by the stronger similarity of goods and services. HHJ Clarke also noted that the average consumer (child gymnasts, their parents and spectators) would be paying a lower degree of attention, which was exacerbated by the assumption that there had only ever been one NGB for the sport. There had also been one instance of

actual confusion, where UK Gymnastics had been able to hire a space only because an employee believed it was affiliated with British Gymnastics.

## DETRIMENT

British Gymnastics’ position as the only recognised NGB for gymnastics gave it considerable responsibility in relation to the sport and the public. Where the use of the signs creates a link between the two entities in the eyes of consumers, the public may assume that the UK Gymnastics services are provided to a similar level of quality, safety and scrutiny. HHJ Clarke found a serious risk that use of the signs would be detrimental to the distinctive character and reputation of the marks.

## UNFAIR ADVANTAGE

The evidence suggested that it was more likely than not that UK Gymnastics’ use of the signs was intended to and did in fact take unfair advantage of the distinctive character and repute of the marks. UK Gymnastics stated that it was deliberately distancing itself from British Gymnastics, but use of highly similar motifs on the proficiency badges, websites and similar documents strongly suggested otherwise.

Consumers would therefore expect a service of identical or similar nature in terms of quality, regulation and compliance with relevant codes or standards, even if they were not confused by the similarity of the marks and signs. Alternatively, consumers would expect that UK Gymnastics has the essential characteristics of a national body, changing consumers’ economic behaviour to benefit UK Gymnastics and causing detriment to British Gymnastics.

## PASSING OFF

Given her findings regarding infringement, HHJ Clarke did not hesitate in finding passing off. UK Gymnastics misrepresented itself as an NGB, which it was not, and this was likely to mislead consumers and cause damage to the goodwill of British Gymnastics.

On an initial review of the marks relied on in this case, it may well have seemed that

British Gymnastics would have difficulty enforcing the term “gymnastics” with a geographical component, being descriptive of the services and location. However, the majority of the findings against UK Gymnastics hinged on its representing the organisation explicitly as an NGB, which it was not.

In particular, the fact that the public perceived there to be just one NGB for gymnastics in the UK was a factor against UK Gymnastics. In addition, the importance of the governance and safety role that NGBs take on, and specifically the vulnerability of gymnasts and children, amplified the continued risk of confusion to a consumer group that was found to be less attentive than average.

It is therefore important to consider what conclusions consumers might reach based on a business’s activities in its particular field, and how much trust may be placed in a business based on these conclusions. These factors may outweigh any differences between competing marks.

## KEY POINTS

- Businesses should be aware of how their activities may affect consumer assumptions and trust in the business, especially if consumers are not likely to be particularly attentive
- A high degree of conceptual similarity can offset low visual and aural similarity

## MARKS

UK00003226097

British  
Gymnastics

British  
Gymnastics  
More than a sport

UK00003281771

British  
Gymnastics

British  
Gymnastics

UK GYMNASTICS’  
SIGNS

UK GYMNASTICS

UK  
GYMNASTICS

WORD SIGN  
UK Gymnastics



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# Lay approach found lacking

A more experienced applicant may have conveyed the necessary nuance, says Charlie Bond

**On 28th July 2019**, the unrepresented Louis Bollard applied for the figurative UK trade mark shown below (application No. 3417088).

In return, on 18th October 2019, German clothing retailer Blutsgeschwister GmbH (the Opponent) filed an opposition under s5(2)(b) of the Trade Marks Act 1994, relying on its EU trade mark No. 14647606, registered on 6th June 2016 (shown below).

The specifications for both marks covered items of clothing in class 25.

The Applicant argued that it only intended to use the mark on T-shirts marketed and sold to female Christians through limited UK-based distribution channels (eg, at Christian festivals). The Applicant contended that, in contrast, the Opponent sold its goods predominantly in Germany, through stores and online.

The Registrar found these arguments misconceived because the Opponent's mark had not been registered for more than five years and so it did not need to prove use. Instead, all that was needed was a fair and notional comparison of the specifications.

The Registrar relied on the inclusion principle, by which goods designated by an application are identical if they are included in a general category designated by an earlier mark. Here, the term "clothing" appeared in both specifications, which encompassed all the goods in the Applicant's specification.

The Registrar then defined the average consumer as:

1. Reasonably well informed and circumspect;
2. A member of the general public, and not necessarily a Christian;
3. Selecting goods based primarily on visual considerations in shops/on websites; and
4. Someone who will pay a medium degree of attention to selection, having in mind cost, size, colour, material and item compatibility.

## COMPARISONS

The Registrar compared the marks, referencing the established principles that the average consumer normally perceives marks

as a whole, with visual, aural and conceptual similarities being compared by reference to the overall impression they create, bearing in mind their distinctive and dominant components.

The Registrar found medium visual similarity, considering there are differences, but bearing in mind the size of the heart and cross in the Applicant's mark and the fact that a cross and heart appear at the start of the Opponent's mark.

As there are no word elements, there was no aural comparison. As regards conceptual comparison, the Applicant argued without evidence that the equals sign in its mark is important because it explains that Christianity is love, whereas the Opponent's mark stems from seafaring. The Registrar found that because both marks evoke the concept of a sequential cross and heart there is a medium degree of conceptual similarity.

## LIKELIHOOD OF CONFUSION

Given the medium degree of visual and conceptual similarity, the goods being identical, the inherent distinctiveness of the earlier mark (because it does not allude to the registered goods) and the average consumer not making direct comparisons, the Registrar found that there was a likelihood of direct confusion, so the opposition succeeded.

The decision is uncontroversial, but had the Applicant produced evidence of, for example, how its mark would be conceptualised by the average consumer, it may have won. This is therefore primarily a lesson in the importance of seeking legal expertise when a trade mark application hits the rocks.



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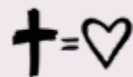


## KEY POINTS

- Unrepresented applicants can often miss or misunderstand the legal nuances of an opposition
- Arguments must be backed up with supporting evidence or they will lack persuasiveness
- When the specified goods are identical, this fact can be used to compensate for a less clear similarity between the marks themselves

## MARKS

APPLICATION  
3417088



THE OPPONENT'S  
MARK (EUTM NO.  
14647606)



# KO-CO case shows cracks

Survey evidence did not cement its arguments, notes Sharon Kirby



**KO-CO Foods Ltd** (the Applicant) began trading at the end of 2018 and filed UK application No. 3390030 in April 2019 for various chocolate-based and cocoa products in class 30 (shown below). This was opposed by First Grade International Ltd (the Opponent) under s5(2)(b) of the Trade Marks Act 1994, based on three earlier registrations (Marks 1–3).

The Opponent started out supplying coconut-based products to manufacturers, producing its first retail item, a coconut-based dairy alternative to milk, by 2010. The line was later expanded to include yoghurt- and cheese-alternative products. The Opponent's evidence showed strong growth in the UK, with stockists including major supermarkets.

The Applicant's evidence included a Facebook survey purporting to show the level of public confusion. However, this was defective and not given any weight. For example, the survey did not allow for a comparison of the marks alone. Where images of the Opponent's goods were included, these were for a non-dairy milk product bearing Mark 1, did not include the other marks registered by the Opponent, and did not include any of the other types of goods relied upon.

The absence of evidence of actual confusion was not conclusive. This might be due in part to the relatively short time the Applicant had been supplying products.

The Hearing Officer (HO) reiterated that where an opponent's marks are not subject to proof of use, a notional and fair use should be considered for the marks and the whole specifications protected. In comparing Marks 1 and 2 to the



opposed mark, the HO found that there was a high degree of similarity because the marks: had three of four letters in common; included palm tree motifs; had a similar aural identity; and evoked coconuts (or alternatively cocoa).

Due to the dominant element "KOKO" ("DESIRE" being somewhat laudatory), there was a medium degree of similarity overall between the opposed mark and Mark 3. The Opponent's marks were held to possess a medium degree of inherent distinctive character. Finally, in comparing the goods, the conclusion was that several items were either identical or highly similar. Terms protected in the earlier rights, such as "dessert products", were allowed a broad reading.

The HO found no direct confusion. Rather, it was a case of indirect confusion, namely "where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related" (applying LA Sugar v Back Beat, BL-O/375/10). This was true even in the case of low-value goods, which would not require a high degree of attention during a purchase.

In comparing Marks 1 and 2 with the opposed mark, the HO felt that consumers would see the commonalities and also notice the differences in spelling and the placement of the palm trees. Hence, consumers might suppose that the Applicant's product was a variant or updated version of the Opponent's earlier line. A conclusion of indirect confusion was reached in respect of the third mark also. The opposition succeeded in total.

## KEY POINTS

- Informal Facebook survey evidence was problematic, particularly where it did not involve all of the Opponent's marks and the goods relied upon
- Indirect confusion may be found even with low-value goods where only minimal care is taken in purchasing

## MARKS

UK APPLICATION  
NO. 3390030

**KO-CO**

THE EARLIER  
REGISTRATIONS

MARK 1



MARK 2



MARK 3

**KOKO Desire**



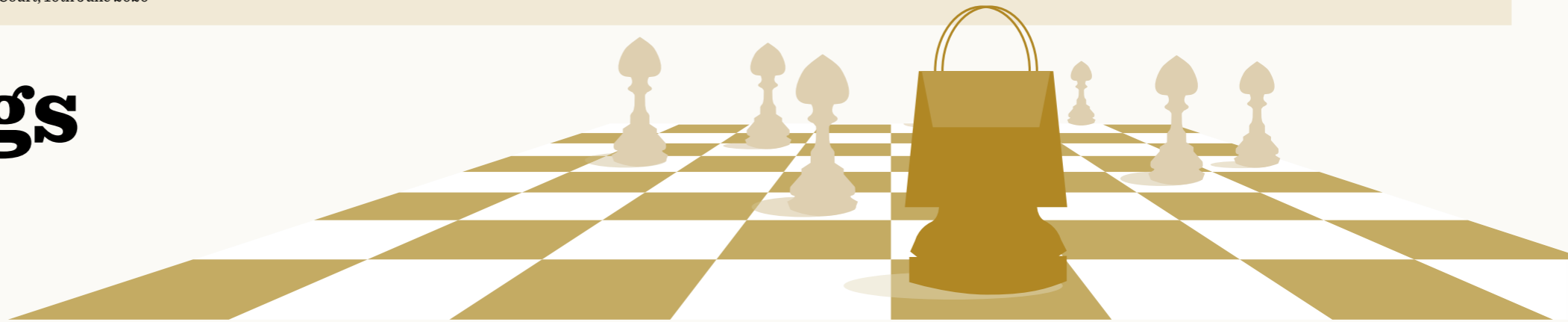
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# Vuitton bags a victory

But a further decision is still in the works, reports Maria Muntean



**On 10th June 2020**, the General Court (GC) annulled the decision of the Second Board of Appeal (BoA) concerning the invalidity of luxury fashion brand Louis Vuitton's chequerboard pattern. Ruling in favour of Louis Vuitton, the GC held that the BoA had erred in its assessment regarding the acquired distinctiveness of that pattern.

## BACKGROUND DETAILS

In November 2008, Louis Vuitton Malletier (the Applicant) filed an International Registration designating the EU for the figurative mark shown opposite (the Contested Mark), in relation to class 18 goods. The mark was granted protection in November 2009.

In June 2015, Norbert Wisniewski filed an invalidity action against the Contested Mark, based on Article 52(1)(a) and Article 7(1)(b), (c) and (e) of Regulation No. 207/2009 (now replaced by Regulation 2017/1001).

The Cancellation Division held that the Contested Mark lacked inherent distinctive character and that the provisions relating to acquired distinctiveness were not applicable to the case, so the invalidity action was entirely successful.

This decision was unsuccessfully appealed by the Applicant. The Board of Appeal (BoA) held, in particular, that the Contested Mark consists of a commonplace pattern that does not depart significantly from the norm of the sector concerned. In reaching this conclusion, the BoA gave account to the purportedly well-known fact that the chequerboard pattern "had always existed and had been used in the decorative arts sector". In addition, the BoA held that the mark had not acquired distinctive character through use throughout the EU.

In this appeal to the GC, the Applicant argued that the BoA: (1) erred in its assessment of the inherent distinctive

character of the mark; and (2) carried out an incorrect assessment of the distinctive character acquired through use.

## INHERENT DISTINCTIVE CHARACTER

Louis Vuitton primarily argued that the BoA's reliance on well-known facts that were not evidenced by either party compensated for the insufficient evidence provided by the applicant for invalidity. As such, Louis Vuitton argued that the BoA carried out a fresh assessment of the inherent distinctiveness of the Contested Mark, which it was not entitled to do.

*“ This GC decision recognises the heavy burden on trade mark proprietors in showing acquired distinctiveness ”*

The GC recalled that although the EUIPO cannot examine facts of its own motion when it comes to invalidation proceedings (as opposed to examination proceedings) and must limit itself to the arguments submitted by the parties involved, the EUIPO is not precluded from relying on well-known facts when examining the arguments and evidence put forward by the parties.

As such, the GC held that the BoA had not carried out a fresh assessment of the distinctive character of the mark, but merely found the arguments put forward by the applicant for invalidity to be supported by well-known facts.

Furthermore, the GC agreed with the BoA that the chequerboard pattern does

not depart significantly from the norm in the sector concerned and that this can be considered a well-known fact. The GC noted that the Applicant was open to provide evidence to the contrary but chose not to do so. Consequently, this first ground of appeal was dismissed.

## ACQUIRED DISTINCTIVENESS

Under the second ground of appeal, the Applicant argued that the BoA had erred in its assessment regarding acquired distinctiveness by limiting its analysis to only part of the evidence submitted.

The GC reiterated that acquired distinctiveness must be shown in respect of all EU Member States in relation to which the mark lacks inherent distinctive character (being all the Member States in the present case) and that if acquired distinctiveness cannot be shown for even one of these Member States, then the mark cannot be considered to have acquired distinctive character. It was also recalled that the evidence provided does not need to be in respect of each individual Member State, but instead can relate to Member States grouped based on commonalities.

In carrying out the assessment, the BoA divided the Member States into three groups: the first comprising States in respect of which Louis Vuitton provided evidence (including opinion polls allegedly demonstrating acquired distinctiveness); the second comprising States in respect of which the evidence relating to group one could purportedly be extrapolated; and the third group comprising States in which the Applicant had no shops but argued that relevant consumers would recognise the Contested Mark as originating from the Applicant.

For procedural economy, the BoA started its assessment in respect of group three (which was the least likely to have acquired

distinctive character). However, it limited itself to examining only some of the evidence submitted by the Applicant (eight out of the 68 exhibits provided) that related expressly to the Member States in group three. The remaining evidence was not examined by the BoA, nor did the BoA explain why it would be irrelevant.

The GC found that the BoA erred in law by undertaking such an approach, because some parts of the excluded evidence related to all of the EU or to groups of Member States including those in group three. As a result, the appeal succeeded on this ground.

## THE BOTTOM LINE

This decision is, however, not the end of the road for Louis Vuitton, as the GC did not go on to assess whether the evidence provided would be sufficient to show acquired distinctiveness of the mark. Therefore, the case will return to the BoA for further review.

Nevertheless, this decision provides a reminder of the approach taken to assessing distinctive character (either inherent or acquired) throughout the EU, and to examining evidence for the purposes of establishing acquired distinctiveness.

This GC decision is in line with previous established case law on acquired distinctiveness and recognises the heavy burden on trade mark proprietors in showing acquired distinctiveness. It reaffirms that, while evidence is not required for each Member State, acquired distinctiveness must be demonstrated across the EU.

## KEY POINTS

✦ The EUIPO may rely on well-known facts when examining the arguments of the parties in invalidation proceedings, but these facts may be contested by the interested party

✦ EUTMs have unitary character and must have distinctive character throughout the EU, whether inherent or acquired through use

✦ Evidence of acquired distinctiveness may include evidence relating to the whole of the EU or to groups of Member States

## MARK

THE CONTESTED MARK



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# Closing the retail gap

Trade mark law may be catching up with the digital era, suggests Anousha Vasantha



**In this decision**, the Advocate General (AG) agreed with the General Court (GC) that “retail services” and “online trading services” are similar, albeit to a low degree. If the CJEU follows the AG’s opinion, it will likely be a positive outcome for retailers – which have already borne a heavy negative impact from the digital movement and expansion of e-commerce over the years. Is this a sign of trade mark law catching up with the digital era?

#### CASE HISTORY

The Appellant in this case, Wallapop SL (Wallapop), is a Spanish online marketplace provider through which users can buy and sell items online and through a mobile app. Wallapop filed an EU trade mark on 18th September 2014 (application No. 013268941, shown opposite) and protection was sought for, *inter alia*, “online trading services” in class 35.

Unipreus SL (Unipreus), a Spanish footwear retailer that operates both online and in physical stores, brought opposition proceedings against Wallapop’s application. Unipreus’ opposition was based on Article 8(1)(b) EUTMR, alleging likelihood of confusion with its earlier figurative Spanish trade mark (shown opposite) which includes the word element “Wala<sup>w</sup>” (registration No. 28741010). Unipreus’ earlier registration covers “retailing of sporting articles” in class 35.

At first instance, Wallapop’s opposition was rejected by the EUIPO Opposition Division (OD) on the basis that there is no likelihood of confusion because the services are dissimilar. The Fifth Board of Appeal (BoA) agreed with the OD’s decision that the services are dissimilar, dismissing Unipreus’ appeal to annul the OD’s decision.

Unipreus appealed to the General Court (GC). In 2018, the GC overturned the BoA’s and the OD’s decisions and instead held that the services are, at the very least, similar to a low degree. The GC noted that the notion of retail includes both sales in physical premises and online and that, contrary to the BoA’s conclusion, “retailing of sporting articles” encompasses online sales as well.



In its grounds of appeal, Wallapop claimed that the GC erred in law by concluding that the services covered by Wallapop’s mark are similar to a low degree to the services covered by Unipreus’s earlier registration. Wallapop claimed first that the GC misconstrued the concept of “online marketplace”, referring to Article 4(1)(f) of Regulation 524/2013, and secondly that the GC misconstrued the relevant factors that should be taken into account in the assessment of the similarity of services.

#### KEY QUESTION

The key question that arose from the judgment under appeal was: are online trading services relating to the operation of an online marketplace different or similar to retailing services? In considering this, the AG considered whether: (1) the distribution channels of the marks in question are similar; (2) the services to which Wallapop’s application refers are in fact “retail services”; (3) the intended purposes and public perception of the services in question are similar; and (4) the services in question are in competition.

The AG referred to the reasoning of the Court in *Praktiker* (C-418/02), where the Court concluded that offering a variety of services aimed at inducing the consumer to conclude a transaction is encompassed within “retail services”. The AG also followed *Tulliallan Burlington* (C-155/18 P to C-158/18 P), in which the CJEU confirmed that the operator of a luxury shopping arcade falls within the notion of “retail”. Here the CJEU noted that retail services are the services separate from the act of sale, bringing together a variety of goods and services which seek to ensure that the consumer purchases those goods sold in the store.

By analogy with the CJEU’s rationale in *Tulliallan Burlington*, it was the AG’s opinion that Wallapop’s retail online platform is, in effect, “a form of ‘virtual’ shopping arcade which can be accessed via the internet”. Essentially, the AG’s reasoning was that although Wallapop claimed it is not engaged in “retailing” as such, the intermediation services that Wallapop provides are sufficient to fall within the class 35 definition of “retail services”. The AG agreed with the GC that all the services Wallapop provides, including providing

business information that is useful for sales, fall under the definition of retail services since, ultimately, these services have the objective of inducing the sale of products to consumers.

The AG also noted that the traditional distinction between shops selling to consumers in bricks-and-mortar premises and those entities engaging in direct online sales has been undermined by technological developments and changing patterns of consumer behaviour. He pointed out that consumers who are searching for particular sports footwear could find the same products on both websites, even though the sellers on Wallapop’s site are third-party sellers. The AG stated that consumers can compare the offer for the same product on Unipreus’ site and on Wallapop’s site. On this basis, the AG concluded that there is a risk of confusion as they share similar channels of distribution and are indeed in competition with each other.

Ultimately, in the AG’s opinion, the GC’s reasoning was sound and there was no error in law. The AG disagreed with Wallapop’s submission that the online nature of its intermediation services takes it outside the scope of retail services. Wallapop’s trade mark application contained, *inter alia*, “providing evaluative feedback and ratings of sellers’ goods and services and providing of business information” and in the AG’s opinion, these terms are offerings separate from the act of sale that are principally similar to the offerings that a traditional shopping arcade owner would provide. Therefore, Wallapop’s online trading services are similar in nature to “retail services” for the purposes of class 35. The AG proposes that the CJEU dismisses Wallapop’s appeal and upholds the decision of the GC.

The AG in this matter raises interesting points regarding the distinctions between intermediate online services, online trading and retail trading in physical stores. It remains to be seen whether the CJEU will adopt the AG’s opinion. However, following *Praktiker* and *Tulliallan Burlington*, it is likely that the CJEU will follow precedent in encompassing the facilitators of sales within the definition of retail sales.

#### KEY POINTS

+ The services provided by the operators or facilitators of online marketplaces might fall under “retail services” in class 35 even if the operators are not selling goods directly to consumers

+ The provision of certain informational services might be viewed as part of a retail service if they aim to facilitate the sale and ensure the consumer purchases those goods

#### MARKS

EUTM APPLICATION NO. 013268941



REGISTRATION NO. 28741010



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# Scope question is settled

What constitutes use has been given concrete dimensions, writes Amelia Skelding

**This case concerns** a referral to the CJEU for clarification on the scope of “using” a trade mark in the course of trade through the internet, as contained within Article 5(1) of Directive 2008/95 (now replaced by Article 10, EU Directive 2015/2436).

To provide background, German law firm MBK Rechtsanwälte (MBK) owned a German trade mark, MBK RECHTSANWÄLTE, for legal services. Another German law firm, mk advokaten (MKA), offered its services under the name “mbk rechtsanwälte” and the corresponding name in Dutch, “mbk advokaten”. Following an action for infringement brought by MBK, MKA was prohibited from using the letters “mbk” for legal services.

Subsequently, MKA ceased using any marks that contained the letters “mbk”. However, searches on the internet for the term “mbk Rechtsanwälte” continued to bring up references to websites that displayed adverts for MKA’s legal services.

## NATIONAL PROCEEDINGS

It is settled German case law that where an advertisement placed on a website infringes another person’s rights, the person who ordered that advertisement must not only arrange for it to be deleted from that specific website but must also ensure that the operators of other websites have not reproduced the advertisement. If it has been duplicated, that person must try to have all subsequent references deleted. Therefore, it is for the infringing party to ensure that all instances of the advertisement concerned are removed from the internet.

“ *The term ‘using’ in Article 5(1) of Directive 2009/95 involves active conduct and direct or indirect control of the act constituting the use* ”

MBK took the view that MKA was not complying with the prohibition and requested that the Court impose a fine. MKA argued that it had removed the only advertisement published on its behalf, in the Das Örtliche online directory, and was not under any other obligations as it had not requested that the advertisement appear on any other websites.

The Regional Court upheld the request for a fine because it believed that MKA had failed to remove all instances of the advertisement. MKA appealed the decision to the Higher Regional Court, which decided to refer a question to the CJEU.

## QUESTION REFERRED

The referring court expressed doubts as to the compatibility of German case law with Article 5(1) of Directive 2008/95, in particular, the interpretation of “using” the mark in the course of trade. Consequently, the Higher Regional Court requested a preliminary ruling on the following question:

“Is a third party referenced on a website in an entry that contains a sign identical with a trade mark ‘using’ that trade mark, within the meaning of Article 5(1) of Directive 2008/95, if the entry was not placed there by the third party itself, but was reproduced by the website’s operator from another entry that the third party had placed in infringement of the trade mark?”

In answer, the CJEU highlighted that where a person operating in the course of trade orders, from the operator of a referencing website, the

MBK

K

publication of an advertisement the display of which contains or is triggered by a sign that is identical with or similar to another person’s trade mark, that person must be considered to be using that sign, within the meaning of Article 5(1) of Directive 2008/95.

By contrast, a person cannot be held liable for the independent actions of other economic operators, such as referencing website operators with whom that person has no direct or indirect dealings and which do not act by order and on behalf of that person, but on their own initiative and in their own name.

The term “using” in Article 5(1) of Directive 2009/95 involves active conduct and direct or indirect control of the act constituting the use. However, that is not the case if that act is carried out by an independent operator without the consent of the advertiser.

The provision cannot therefore be interpreted as meaning that a person may, irrespective of its conduct, be considered to be a user of a sign that is identical with or similar to another person’s trade mark on the sole ground that such use is capable

of providing a financial benefit to the former.

## DIRECT CONNECTION?

It is now for the referring court to decide whether there is a direct or indirect relationship between MKA and the operators of the websites in question, as well as whether the operators placed the advertisement online by order and on behalf of MKA. If a relationship is not found, it should be concluded that MBK is not justified in bringing an action against MKA on the ground that the advertisement was published online on websites other than the Das Örtliche directory.

This would not alter the fact that MBK could try to claim restitution from MKA, where appropriate, for its financial gain on the basis of national law and bring an action against the operators of the websites in question.

Ultimately, the answer to the question referred is that Article 5(1) of Directive 2008/95 must be interpreted as meaning that a person operating in the course of trade who has arranged for an advertisement which infringes another person’s trade mark to be placed on a website is not using a sign identical to that trade mark where the operators of other websites reproduce that advertisement by placing it online, on their own initiative and in their own name, on other websites.

## KEY POINTS

✦ The term “using” in the context of Article 5(1) involves active conduct and direct or indirect control of the act constituting the use

✦ Where a person operating in the course of trade orders, from the operator of a referencing website, the publication of an advertisement that contains or is triggered by a sign that is identical or similar to another person’s trade mark, that person is considered to be using that sign



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# Stormy weather for a subcategory

Elena Valuiskich describes why this opposition foundered on a subtle distinction

In December 2012, ACTC GmbH (ACTC) filed an EU trade mark application for the word sign TIGHA. Taiga AB (Taiga) opposed the application to the extent that it covered goods in classes 18 and 25. The opposition was based on the likelihood of confusion with Taiga's earlier EU word mark TAIGA. ACTC put the opponent to proof of use.

At the EUIPO, the Opposition Division held that the proof of use and comparison of the goods were irrelevant and rejected the opposition in its entirety, finding that the marks were dissimilar due to their conceptual difference. However, the Board of Appeal (BoA) found the marks to be similar and Taiga's proof of use satisfactory. The BoA partially annulled the decision, rejecting the application for the goods in class 25.

ACTC appealed to the General Court (GC), arguing that the proof of use provided referred only to the subcategory of goods "weather-protective outdoor clothing" and not the more general category "clothing, outer clothing." ACTC also contested the BoA's assessment of the similarity of both the goods and the signs. The GC dismissed the action in its entirety, upholding the BoA decision.

ACTC then appealed the decision to the CJEU, arguing that the GC had been wrong to consider only whether "weather-protective outdoor clothing" constituted an independent subcategory in relation to the goods in class 25, and to that extent it did not correctly apply the criterion of the purpose and intended use of the goods in question in order to determine if there was an independent subcategory. It also contended that the GC had failed to take into account the fact that the goods at issue were aimed at different publics and sold in different shops.

The CJEU rejected ACTC's claims as unfounded. The Court based its decision on a number of principles distilled from the opinion of the Advocate General in the present case and relevant case law, including:

- The need to assess in a concrete manner whether the used goods constitute an independent subcategory, so as to link these goods to the challenged goods;
- The definition of an independent subcategory of goods must be based on the same criteria, whether in relation to a request for restriction of the list of goods covered by an application or in an opposition as part of an assessment of the likelihood of confusion;
- The purpose and intended use of the goods are essential criteria for defining an independent subcategory of goods capable of being viewed independently;
- Where the goods concerned have several purposes and intended uses, it is not possible to determine whether there exists a separate subcategory of goods by considering the purposes of those goods in isolation;
- The fact that the goods are aimed at different publics and are sold in different shops is not relevant for defining an independent subcategory of goods.

In light of these principles, the CJEU found that the GC had correctly linked Taiga's weather-protective outdoor clothing to the more general category of "clothing" and rightly concluded that those articles could not be regarded as substantially different.



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## KEY POINTS

- The purpose and intended use of the goods or services are essential criteria for defining an independent subcategory
- The fact that goods are aimed at different publics and are sold in different shops is not relevant for defining an independent subcategory, but will be useful for assessing the relevant public



# Ferrari latest to lose out

Even an automotive icon can struggle to produce convincing evidence, writes Leanne Gulliver



In 2008, Ferrari protected the 3D shape of its iconic 250 GTO (production of which ceased in 1964) under EU trade mark No. 6543301 for goods in classes 12, 25 and 28 (the Registration).

In 2018, ARES Performance AG (ARES) designed a reinterpretation of that classic model for an unnamed client and was considering launching it to other clients, with a €1m price tag. ARES' CEO, Dany Bahar, formerly Senior VP, Commercial and Brand at Ferrari, reportedly confirmed that the design was "a modern reinterpretation, not a copy" of the original 250 GTO.

## REVOCATION APPLICATION

In December 2018, ARES applied to revoke the Registration on the basis that, contrary to Article 58(1)(a) EUTMR, it had not been put to genuine use in the EU between 12th December 2013 and 11th December 2018 (the Relevant Period).

Ferrari filed proof of use, including media articles, reports from the private auction houses Sotheby's and Bonhams, details of private and specialist vintage sales and invoices issued by Ferrari for the repair, maintenance and restoration of the cars.

The Cancellation Division (CD) recognised that in certain circumstances, use of the mark may be considered genuine if those goods had been sold at one time and were no longer available (C-40/01, MINIMAX). This includes the sale of spare parts and aftersales services (eg, maintenance and repair services).

However, the CD held that Ferrari's evidence merely demonstrated that a vehicle model in the shape of the mark was built between 1962 and 1964, and was insufficient to demonstrate use of the Registration for the class 12 goods during the Relevant Period. Sales in the Relevant Period were made by third parties, not Ferrari, and although aftersales services took place they did so under the trade marks FERRARI, FERRARI

CLASSICHE and the prancing horse logo (see below).

While Ferrari's evidence confirmed use of the Registration on 250 GTO toy-car models and scale-model cars during 2017 and 2018 in Italy, Holland, Poland and Spain, this use was insufficient to maintain class 28 in its entirety, and the CD curtailed the specification to those exact goods. The evidence in respect of class 25 was also found to be insufficient.

## SECTOR CHALLENGE

This is just the latest in a line of cases looking at the challenges manufacturers have faced when relying on trade mark protection for car designs. At the time of writing, Jaguar Land Rover had just lost its legal battle before the High Court to protect the design of its Defender model, clearing the path for INEOS to build its Grenadier. Likewise, the London Taxi Company has struggled to enforce its shape marks before the UK court.

Predictably, Ferrari has appealed class 12 of the decision. However, even if it is successful, Ferrari may not ultimately reach the chequered flag. ARES also filed a declaration of invalidity on the basis that the Registration is non-distinctive, that the sign consists exclusively of a shape that gives substantial value to the goods, and that the application was filed in bad faith.

## KEY POINT

- Genuine use includes any use that maintains a share in the market, use that relates to goods or services that have already been marketed, and use on parts that are integral to the goods or services, such as aftersales services relating to them

## MARKS

EUTM NO. 6543301



THE PRANCING HORSE LOGO



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# Microphone appeal heard

But the final word was given to the Examiner, explains Chris Thomas

On 7th January 2019, Logitech Europe SA (Logitech) applied to register a 3D mark in class 9 for “microphones”. The Examiner refused the Application under Article 7(1)(b) EUTMR on the basis that the mark consisted of a combination of presentational features typical of the shape or appearance of a spherical microphone head with visible parts. The sign was held not to be markedly different from basic shapes commonly used in trade. At the time of writing, a claim that the mark had acquired distinctiveness through use under Article 7(3) was yet to be examined.

Logitech appealed, maintaining that the Examiner had failed to assess evidence that showed that the sign was a significant departure from the norm.

## KEY PRINCIPLES

The Board of Appeal (BoA) summarised several key principles in relation to the assessment of 3D marks, following established case law. These included the fact that:

- For a mark to possess distinctive character under Article 7(1)(b), it must serve to identify the goods and services as originating from a particular undertaking;
- The average consumer must be able to distinguish the goods without conducting an analytical or comparative examination and without paying particular attention;
- The more closely the mark resembles the shape taken by the product, the greater the likelihood of the mark being devoid of distinctive character; and
- A feature displayed in a 3D mark which is functional will generally not confer distinctiveness as it will be associated with that function for the purposes of Article 7(1)(b).

The BoA held that supporting statements from individuals in the industry who were familiar with the microphone shapes did not mean that the mark enabled goods to be distinguished from those of undertakings from the perspective of the average consumer.

The Applicant’s position that the shape of the microphone was a significant departure

from the norm was not borne out by its evidence. For example, the ball shape served a necessary function as a receptacle for mechanical/electronic components, while the grid shape was influenced by the spherical shape of the microphone head and did not confer distinctive character on the sign. Accordingly, the appeal failed and the case was referred to the Examiner to examine the Article 7(3) claim.

## PUBLIC INTEREST AT PLAY

The CJEU and General Court have consistently held that there is a public interest in barring registration for 3D shapes where a trade mark extends beyond the essential function of distinguishing goods and moves towards monopolising the shape of certain goods, technical functions of goods, or goods with an aesthetic value.<sup>1</sup>

Even where Article 7(1)(e) exclusions are not applied, unless the shape of a mark significantly departs from the norm for shapes commonly used in trade for the goods of the application, it will not be capable of distinguishing the goods of an undertaking and will not fulfil the essential function of a trade mark for the purposes of Article 7(1)(b).

However, if Logitech succeeds in demonstrating that the mark has acquired distinctiveness under Article 7(3), it is open to the Examiner to reconsider the application under Article 7(1)(e).<sup>2</sup>

1 C-299/99, Phillips v Remington; C321/03 Dyson v Registrar; C-102/07 Adidas v Marca Mode; T-508/08 Bang & Olufsen v OHIM; T-205/13, Hauck GmbH v Stokke A/S  
2 T-508/08, Bang & Olufsen



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## KEY POINTS

• 3D marks risk being refused under Article 7(1)(b) even if Article 7(1)(e) exclusions do not apply

• The shape of a mark must significantly depart from the norm for shapes commonly used in trade in order to be registrable

• Statements from industry experts familiar with a shape might not assist with proving inherent distinctiveness from the point of view of the average consumer

## MARK

THE LOGITECH 3D MARK



# PetsHome sent packing

Global assessment cemented the decision, says Charlotte Wilding

Here, Pets at Home Ltd (the Opponent) opposed Guangzhou Shanglin Trading Co. Ltd’s EU trade mark for PETSHOME (the Opposed Mark) in classes 9, 18 and 35. It based its opposition on its earlier UK trade mark registration PETS AT HOME in classes 11, 16, 18, 20, 21, 25, 28, 35 and 36 under Article 8(1)(b) (likelihood of confusion) and Article 8(5) EUTMR (reputation).

The opposition initially succeeded in respect of some of the goods and services in classes 18 and 35, which were held to be similar to a low degree to those of the earlier trade mark. However, the opposition failed on the grounds of reputation due to the parties operating in different market sectors, such that it was held that there was unlikely to be a mental connection between the two marks by the relevant public.

## APPEAL PURSUED

Guangzhou Shanglin Trading Co. Ltd (the Applicant) appealed, arguing that the marks were not similar because they were structurally different. The earlier registration consisted of three words, PETS AT HOME, whereas the opposed mark, PETSHOME, was one word and a fanciful term.

However, the Board of Appeal (BoA) disagreed. On a comparison of the signs, the BoA noted that the Opposed Mark coincided in key elements. Specifically, the entire Opposed Mark was the beginning and ending of the earlier mark. This created an average

degree of similarity between the marks, both visually and aurally.

Further, the BoA found that the signs were highly similar conceptually, as the meaning of both is the same; the only difference being the preposition AT in the earlier registration.

The Applicant also argued that the Opponent’s specification was too broad

and that it was therefore not similar to the Opposed Mark. However, the BoA, referring to the Nice classification explanatory notes, clarified that the goods in fact belonged to the group of terms referred

to under the Opponent’s earlier registration. It held that the goods and services in classes 18 and 35 were similar to a low degree.

By taking into consideration a global assessment of the marks and the relevant public, the BoA confirmed that the Opposed Mark was similar to the earlier mark. It also noted that, for a significant part of the relevant public, the Opposed Mark would be seen to have “fully reproduced a verbal element which has an independent distinctive role in the earlier mark”.



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## KEY POINTS

• Likelihood of confusion in marks will exist where the verbal element that has a distinctive role in the earlier mark is fully reproduced in the later mark

• Goods and services covered under class headings may be held to be similar to the specific goods and services of the later mark that also fall under the terms specified by the class heading

“*By taking into consideration a global assessment of the marks and the relevant public, the BoA confirmed that the marks were similar*”

# No red flag for Toro

Dale Carter expects the Opponent will be raising a glass

**Viña Concha y Toro SA (Toro)**, a wine producer whose brands include Casillero Del Diablo, will be raising a glass to the Board of Appeal (BoA) for twice overturning decisions by the EUIPO Opposition Division (OD) and upholding its opposition based on its reputation in a word mark containing the non-distinctive term WINE LEGEND.

Toro's appeal succeeded based on the word mark CASILLERO DEL DIABLO, WINE LEGEND, registered for "wines and sparkling wines" in class 33. Toro relied on this mark, together with a complex figurative mark containing the same word elements, when opposing an EU trade mark application for the mark WINE LEGEND by Bingliang Hu for a range of business-related and advertising services.

Toro's opposition relied upon Articles 8(1)(b) and 8(5) EUTMR. At first instance, the OD rejected Toro's opposition on all grounds. Toro's first appeal was successful on the grounds that the OD had failed to evaluate the strength of its reputation and the degree of distinctiveness of Toro's earlier marks. The case was remitted back to the OD, but the OD again rejected the opposition under Article 8(1)(b), because the respective goods and services were different, and under 8(5), because a link would not be created between the signs.

Toro's second appeal was successful under Article 8(5), as the OD had erred in ignoring the reputation that Toro had established in WINE LEGEND in the UK and in deciding that

the UK public would rely on CASILLERO DEL DIABLO because WINE LEGEND would be considered non-distinctive. On the contrary, the BoA found that the WINE LEGEND element was important because the UK public would find CASILLERO DEL DIABLO difficult to pronounce.

Toro's evidence in support of its reputation centred on an award-winning advertising campaign spanning between 2011 and 2016, which promoted the concept of a wine legend. The evidence consisted of TV and print advertising, sponsorship of televised events, and independent evidence that demonstrated a significant increase in brand awareness, brand penetration and sales linked to the campaign in which WINE LEGEND played a central part. Based on the evidence, the BoA decided that Toro's mark enjoyed a considerable reputation for wines in the UK, a substantial part of the EU.

In deciding that a link would be created between the signs and unfair advantage would be taken of Toro's registration, the BoA considered the signs to be similar, Toro's mark to be distinctive and that there was a proximity between the goods and services in question, emphasised by the nature of the Applicant's mark and because it had been partially rejected under Article 7(1)(b) for "alcoholic beverages".

As the Applicant's mark was partially refused under Article 7(1)(b), the BoA's decision may appear generous. However, it will be encouraging to brand owners that have obtained defensive rights in a combination of distinctive house marks and non-distinctive terms. Those rights may be more valuable than previously thought. Toro may now feel emboldened to seek protection for the term WINE LEGEND in the UK for wine, based on the mark having acquired a distinctive character through use.

## KEY POINTS

Where Article 8(5) has been invoked, even the faintest degree of similarity between the signs is enough to justify assessing all relevant factors to determine whether a link will be established in the mind of the relevant public

Widespread use of a registered word mark comprising two distinct verbal elements, one of which is highly distinctive and the other of which lacks inherent distinctiveness, can give rise to a reputation in the mark as a whole

## MARKS

EARLIER MARKS:

EUTM NO. 3199395

**CASILLERO DEL DIABLO, WINE LEGEND**

EUTM NO. 6666044



CONTESTED SIGN:

**WINE LEGEND**



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Our Paralegal webinar series continues on 28th October. Register now at [citma.org.uk/events](http://citma.org.uk/events)

# Calendar

Our upcoming events for members, plus other IP events of interest

DATE	EVENT	LOCATION	CPD HOURS
21st October	CITMA Webinar How to adapt your business development in a constantly changing world	Online	1
21st October	How to be a better ally	Online	1
28th October	CITMA Paralegal Webinar Customs enforcement	Online	1
30th October	An intro to asexuality and aromanticism	Online	1
4th November	CITMA Seminar for Litigators	Online	4
5th-6th November	CITMA Autumn Conference Rising to the challenge	Online	6
12th November	CITMA Webinar SkyKick	Online	1
16th-22nd November	Careers in Ideas Week	Various	
19th November	STEM: Branching out	Online	1
24th November	CITMA Webinar UK case law update	Online	1
25th & 27th November	CITMA Paralegal Seminar Obstacles to trade mark registration	Online	3

■ CITMA event ■ IP Inclusive event

## YOUR INPUT IS WELCOME

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

# THE TRADE MARK 20

Q&A



## Francesco Simone

believes good food is good for business

**I work as...** an Associate and Chartered Trade Mark Attorney at WP Thompson.

**Before this role, I was...** a Part-Qualified Trade Mark Attorney at WP Thompson.

**My current state of mind is...** calm. I'm trying to stay patient, hoping the COVID-19 outbreak will end sooner rather than later.

**I became interested in IP when...** I was studying law in Italy. The IP law module focused exclusively on copyright, but I wanted to learn about trade marks as well.

**I am most inspired by...** the people who have given their lives (and those who continue to do so) working on the front line against COVID-19.

**In my role, I most enjoy...** devising worldwide trade mark strategies, because of the flexibility and creativity it requires. I also enjoy opposition work, because of its often challenging nature.

**In my role, I most dislike...** trade mark owners who want to rule the world without paying any fees.

**In front of me right now is...** my laptop, my phone and a notebook to scribble notes in when I receive phone calls (always in my incomprehensible handwriting).



“

*More work needs to be done to make sure IP rights reflect genuine interests*

**My favourite place to visit on business is...** any place with good cuisine, because good food is good for business too.

**My favourite mug says...** nothing, but it has drawings of cats.

**If I were a brand, I would be...** Ferrero, because I like the story of Nutella spread. It all started with one man's determination to realise his dream of creating a sweet treat during World War II.

**The biggest challenge for IP is...** finding the right balance between monopolies and competition when it comes to intellectual property. More work needs to be done to make sure IP rights reflect genuine interests rather than mere attempts to stifle competition.

**The talent I wish I had is...** cooking like a top chef, to make all my culinary dreams come true.

**I can't live without...** my wife, my family and coffee.

**My ideal day would include...** good food for sure. It wouldn't be my ideal day without it.

**In my pocket is...** nothing right now. I'm working from home, and I don't usually carry anything in my pockets in the house.

**The best piece of advice I've been given is...** always reread what you just wrote.

**When I want to relax I...** make myself a good coffee.

**In the next five years I hope to...** buy a house and make some more progress professionally.

**The best thing about being a member of CITMA is...** the high-quality information and knowledge provided to members.