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# ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

Issue 411 July/August 2014 [itma.org.uk](http://itma.org.uk)



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# welcome

July/August 2014



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### Published on behalf of ITMA by:

Think, The Pall Mall Deposit,  
124-128 Barby Road, London W10 6BL  
Tel: 020 8962 3020  
[www.thinkpublishing.co.uk](http://www.thinkpublishing.co.uk)

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## ITMA Review

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**W**elcome to the summer issue of *ITMA Review*, which appropriately for the time of year –

when so many of us enjoy holiday travel abroad – is global in coverage. This includes news of the recent ITMA reception at INTA's annual meeting in Hong Kong, a look at Russian trade mark law and a view from Switzerland on geographical indications.

We also have advice on networking and mediation, contrasting, but both

increasingly important, aspects of modern trade mark practice. On that note, I hope that you all manage some time out of the office and away from your smartphones.

**Chris McLeod**  
ITMA President

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# ITMA Insider

## CEO bulletin

*Highlights and updates from Keven Bader's 29 May message*



04

**W**here else could I start but to congratulate Chris McLeod, who was welcomed in at a New President's Reception on 4 June (see photos on page 8); it was great to hear his ambitions for his term in the role.

Hot on the heels of Chris's election as President we received a letter from the Viscount Younger of Leckie (Minister responsible for IP) to congratulate Chris on his appointment. The minister also offered the opportunity to meet with ITMA to discuss our views on some of the new services being introduced by the UK IPO, as well as ITMA's plans for the future. With a meeting scheduled for early July, look out for a report in a future *ITMA Review*.

### Fast track

The consultation on the possibility of the (re)introduction of a fast-track examination system in the UK closed on 15 April 2014. ITMA has engaged in conversations with officials at the IPO and formally responded to the consultation based on the general view that a fast-track examination is not needed as examination reports are received in approximately three to four weeks under the standard examination system. We await the official response from the IPO, but we would be surprised if the system were introduced. ITMA's response can be found at [itma.org.uk](http://itma.org.uk)

### Marshalling/shadowing

This is a sneaky advance notice that we are confident of securing some further shadowing opportunities for our members. You may recall that we ran a marshalling scheme with His Honour Justice Birss QC who, at the time, was the Intellectual Property Enterprise Court (IPEC) judge. His Honour Justice Hacon, who is the current judge in the IPEC, is keen to continue this programme of marshalling and we are in the process of firming up the details before formally offering it to

*I am confident that we will soon have a modern, integrated website that will lead to a more personalised experience for those using the ITMA website*

members to apply. In addition, we are trying to run something similar with the Appointed Persons and with IPO Principal Hearing Officers. More news will follow on these opportunities as they develop.

### Trade Mark Administrators

This year we have been pleased to be able to offer more learning opportunities for our Trade Mark Administrator members and you may have seen the publicity for two roundtable events planned for London and Birmingham this summer. These events will look to discuss and explore the diversity of the role of a paralegal within the profession.

### Website project

I mentioned in my last bulletin (page 4, *ITMA Review*, May 2014) that we had two major projects underway for this year: a new customer relationship management (CRM) system and a new website. We recently appointed Premier IT to develop and deliver a new website, and I am confident that, at the conclusion of these two projects, we will have a modern, integrated website and CRM that will lead to a more personalised experience for members and for those using the ITMA website, as well as streamlining some of the administrative functions

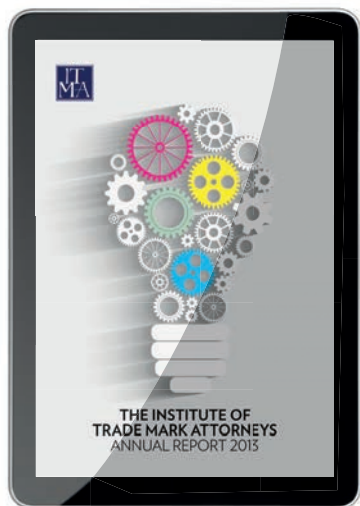


currently carried out within the ITMA office. Updates on this will follow as the projects progress.

## Annual Report 2013

By the time you read this, the Annual Report for 2013 will have been published. I hope you will take the time to read the report that aims to outline many of the activities we have carried out during the course of the year and the achievements realised.

That's all for now. If you have any views or comments on any of the points highlighted in the bulletin, please do not hesitate to drop me an email; my email "door" is always open!



## Member *moves*



The Partners of Keltie LLP are pleased to announce that Ben Britter has been welcomed into the partnership. This appointment falls in line with the firm's long-term future growth strategy.



Sharon Daboul has joined IP law firm EIP as Associate. Sharon is a registered UK and European Trade Mark Attorney and will be based in the London office. Sharon was credited in the 2012 *Legal 500* for her "thoughtful advice". Contact her at [sdaboul@eip.com](mailto:sdaboul@eip.com)

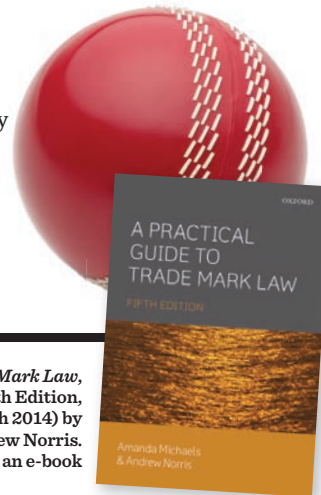


Clare Jackman (MITMA) joined the London office of Norton Rose Fulbright on 19 May, to establish a trade marks filing practice, complementing the existing IP team. Contact Clare at 020 7444 2235, [clare.jackman@nortonrosefulbright.com](mailto:clare.jackman@nortonrosefulbright.com)

Gayle Hodt has joined Richemont as Senior Digital Group Paralegal. Contact Gayle at [gayle.hodt@richemont-ip.com](mailto:gayle.hodt@richemont-ip.com)

## Have a ball

The CIPA/ITMA cricket season got underway on 14 May and continues until 5 August. There may still be an opportunity to take part if you are interested in joining the team. Please email [cipaitmacc@gmail.com](mailto:cipaitmacc@gmail.com) to express your interest. Further details are also online at [cipacc.org.uk](http://cipacc.org.uk)



## Reader Review

*Alistair Craig appreciates an update of a trade mark learning touchstone*

Previous editions of this work have been recognised as a touchstone for practitioners and students alike. It is used as the preferred reference for the Nottingham Law School Professional Certificate course and is therefore a rite of passage for qualifying UK Trade Mark Attorneys. It also remains valuable to these students after qualification. For the student, it introduces core concepts and expands on them with admirable

readability. For practitioners, it maps out the landscape clearly and points the way for reading in greater depth.

The Fourth Edition was published in May 2010. This new text has been updated to include subsequent important decisions of the Court of Justice of the European Union, the Court of First Instance and the English courts. This includes discussion of trade mark functions (L'Oréal v Bellure and Interflora),

discussion on the classification of goods and services (IP Translator), and developments on the application of section 46(2) (Fruit of the Loom, Colloseum, Specsavers and Rintisch). The refreshed content also covers procedures relating to the Intellectual Property Enterprise Court and explores the impact of the internet, including AdWords, internet infringement and domain name disputes.

Pleasingly, the new edition is available as an e-book (Kindle version £51.50), as well as in paperback form (£75). For a reference that is so regularly useful, the availability of a searchable version that can be bookmarked and annotated is very welcome. The Kindle edition remains readable on smartphones, as well as e-readers and tablets. Both formats are highly recommended.

*A Practical Guide to Trade Mark Law, Oxford University Press (Fifth Edition, Oxford University Press, 20 March 2014) by Amanda Michaels and Andrew Norris. Also available as an e-book*

# ITMA at INTA

*We showed our UK colours in Hong Kong, hosting a popular afternoon tea event, as Keven Bader explains*



**T**he Annual Meeting hosted by the International Trademark Association (INTA) in May is a prestigious and renowned event, which sees around 10,000 people ascending or descending from countries far and wide for the five-day programme. This year, with the meeting held for the first time in Asia, ITMA decided that this was an ideal opportunity to host a small, but targeted, reception event.

Working with the UK IPO, UK Trade & Investment and the British Consulate in Hong Kong, we were able to put on a quintessentially British afternoon tea for a select group of invitees, bringing together associations similar to ITMA, particularly from the Asian territories. The event aimed to promote UK business, the work of the UK overseas and, of course, the UK trade mark profession.

We were delighted to be able to hold the event in the British Consulate building, which was beautifully decorated with flags and with Government material promoting IP. With an unmistakably British atmosphere, the room was perfect for our event.

The weather in Hong Kong had been spectacular, but not necessarily

in a good way. Torrential rains and a dramatic thunderstorm on the preceding day, and generally high humidity and high temperatures meant the going was tough for the profession, but this didn't deter our attendees. The event was due to run from 3-5pm, but the first guests arrived at 2.15pm. There followed a steady stream of visitors, representing many different representative organisations – APTMA, AIPPA, AIPLA, JTA, CTA, KPAA, Law Society of Hong Kong, ACPAA, APPA, HKITMP, FICPI Japan, MARQUES, ECTA, GRUR, AIPPI, NZIPA, TPAA, CIPA, to name but a few. The UK IPO was also present along with two of the IP Attachés, as were Hong Kong Government officials and the Trade Commissioner. The ITMA hosts (of which there were about 20) were impeccable in delivering our message, our expected hospitality and flexing their networking muscle. We are grateful for their assistance. Although the venue had a total capacity of only 100, we saw many more than that number of people during the course of the event. It was certainly very full at times, but thanks to good air-conditioning it never quite became over-crowded.

Once we were well underway, ITMA President Chris McLeod gave a short address, welcoming attendees from sister associations in Europe, and

emphasising the strong historical and continued links between Asia and the UK. Two further short addresses were made. Trade Commissioner Stephen Cartwright spoke about the work carried out in Hong Kong and the role that IP and the profession played in supporting many of the major projects taking place. Then Steve Rowan, Divisional Director of Trade Marks and Designs at the UK IPO, spoke about the IP Attaché programme and the objective of the IPO to help and support UK business to exploit opportunities overseas. He endorsed the relationship between the IPO and ITMA, and the desire to continue to work closely with the profession.

The general mood seemed to indicate that the event was a success; those that attended appeared to enjoy the occasion and found it valuable to meet with other representative associations. Shortly after 5pm the remaining attendees exited once more into the humid air of Hong Kong and we reflected on a job well done as we packed down, collated the mass of business cards we had collected, and headed for a well-earned (but short) rest before the next round of meetings and events.





01



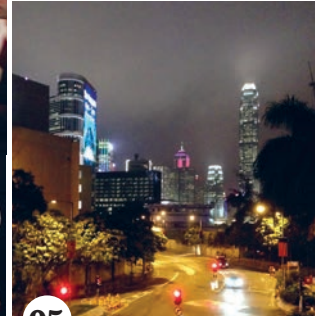
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01 Chiaki Kawai (Japan Trademark Association) and Maggie Ramage (ITMA)  
 02 Keven Bader and Jane Attreed (ITMA)  
 03 Attendees gathered in the British Consulate building  
 04 Simon Miles and Aaron Wood (ITMA), and Ella Cheong (Law Society of Hong Kong)  
 05 Heavy skies in Hong Kong didn't dampen spirits at the event  
 06 It was a very British affair  
 07 Steve Rowan (UK IPO) addressed invitees  
 08 Stephen Cartwright (UKTI), Chris McLeod (ITMA President) and Steve Rowan (UK IPO)  
 09 Chris McLeod





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# A Presidential *welcome party*

*Members met Chris McLeod and mingled on 4 June 2014*



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ITMA's rank and file, as well as invited guests from the IP sector, came together to hear new President Chris McLeod outline his plans for the next two years in London's Innholders Hall – the "home of hospitality" – in early June. Fine wines and a selection of canapes helped to promote a celebratory atmosphere.

- 01) Innholders Hall was the venue for the welcome party
- 02) Mark Devaney, Alice Davies and Rowena Price (Gill Jennings & Every), Emma Dixon (Macfarlanes LLP)
- 03) Past and present ITMA Presidents, Catherine Wolfe (Boult Wade Tennant) and Chris McLeod
- 04) Tom Farrand (Novagraaf UK) and Ryan Hickey (Corsearch – Wolters Kluwer)
- 05) Anka Manole and Andrew Vlad Ratza (Ratza & Ratza), and Ria van der Lee and Trix Ockeloen-Kruit (Knijff Trade Mark Attorneys)
- 06) Simon Miles (Edwin Coe LLP), Maggie Ramage (Alexander Ramage Associates) and Mark Foreman (Rouse)
- 07) Stephen Kinsey (Wildbore & Gibbons LLP), Donald Pennant (K3 Paints/ AkzoNobel), Amanda Michaels (Hogarth Chambers) and Eric Ramage (European Communities Trade Mark Association)
- 08) Joe Cohen (Collyer Bristow), Florian Traub (Squire Patton Boggs (UK) LLP) and Natasha Hinds-Payne (Cath Kidston)

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# Lifeline for leading lights?

*Two recent cases suggest a more European approach is being taken on the protection of personalities.*

*Nick Aries offers an overview*

“Whatever may be the position elsewhere in the world, and however much various celebrities may wish there were, there is today in England no such thing as a free-standing general right by a famous person (or anyone else) to control the reproduction of their image.”

These were the words of His Honour Justice Birss QC, deciding in the Rihanna case last summer (*Fenty and others v Arcadia Group Brands Limited (t/a Topshop) and another [2013] EWHC 2310 (Ch)*). Of course, Birss J went on to find that Rihanna did have the right to prevent the reproduction of her image in that case. A subsequent judgment of the same Judge in the Betty Boop case earlier this year (*Hearst Holdings Inc and another v A.V.E.L.A. Inc and others [2014] EWHC 439 (Ch)*) also addressed the reproduction of famous images – this time centring on a cartoon character. This article considers the implications of these two UK decisions in particular, and aims to also give an overview of the image rights position in France, Germany and Spain.

## Pop start

In March 2012, retail giant Topshop began selling a T-shirt with an image of the singer Rihanna on it without Rihanna’s permission. Rihanna objected to the use of her image on the product on grounds of passing off, and succeeded at first instance (the case is currently on appeal). Before this case, it was generally thought that merely placing a celebrity’s

image on goods without permission did not infringe the celebrity’s rights. Where there is a precedent for preventing use of a celebrity’s image on advertising material (*Edmund Irvine Tidswell Limited v Talksport Limited [2002] FSR 60*), this is the first reported modern case in which a celebrity successfully prevented use of their image on goods.

Why did Rihanna win? The image at issue was itself famous – it was taken during a video shoot that had garnered lots of publicity for being controversial. Topshop had previous associations with celebrity fashion icons, such as Kate Moss, and had in the past run a competition offering a shopping appointment with Rihanna. Rihanna had cultivated a brand in the world of fashion, not just music. In the Judge’s mind, these factors enhanced the likelihood in the purchaser’s mind that the garment had been authorised by Rihanna.

The Betty Boop case was somewhat different. It can be seen as a merchandising case, rather than one about endorsement, and involved a fictional character rather than a real person. In this case, the Defendants were licensing and selling T-shirts and bags bearing an image of the cartoon character Betty Boop. The Claimants were the successor of the originator of that character, and claimed to be the only legitimate source of Betty Boop merchandise in the UK. The Claimants also owned UK and Community Trade Marks for BETTY BOOP and the device shown on page 13.

Birss J found that the Defendants’ activities amounted to passing off, and infringed the trade marks under

sections 10(1), 10(2) and 10(3) of the Trade Marks Act 1994 (and their Community equivalents). The Judge held that the Defendants’ goods were likely to lead the public into thinking that they originated from the same source of Betty Boop merchandise that consumers were familiar with (ie the Claimants – who had been able to show they had been the sole source of such merchandise for 20 years). The public had been educated by the Claimants to see BETTY BOOP as a mark of origin and that there was a single official source of such goods. The presence of an additional mark (RADIO DAYS) did not assist the Defendants as the public did not regard RADIO DAYS to be an alternative source of genuine Betty Boop merchandise. In the Judge’s view, the words “Official Licensee” or “Officially Licensed Product” on the labels significantly enhanced the assumption by a purchaser that the goods were official Betty Boop merchandise.

Although the Judge agreed with the Defendants that the use of a picture of Betty Boop and/or the word “Boop” were also decorative, they were not purely so. Although some purchasers would buy the goods without caring whether they were official Betty Boop merchandise or not, a significant portion of the purchasers wanted Betty Boop merchandise from the official source.

The Judge rejected a defence of use of indications concerning the kind or quality of the goods in accordance with honest practices. The use was not descriptive, particularly given the words “officially licensed” on



*The rise in official celebrity endorsements and the number of spin-offs outside the celebrity's original field means consumers are more likely to expect goods to be officially licensed*



the labels. According to the Judge, there were also several reasons against the use being within honest practices.

Although, in this decision, the Judge was at pains to repeat what he had said in the Rihanna case (no free-standing right by a famous person to control the reproduction of their image), a second success for a Claimant within a few months in an image rights-type case has certainly caught the eye. Interestingly, the Judge observed that it is probably easier to educate the public to believe that goods relating to an invented character derive from a single official source than it might be for a real person, not least because copyright may give the ability to control the reproduction of the character for a long period. In each case, the Judge has emphasised that the decisions turned on their particular facts. However, it is easy to see how they could widen the scope of quasi-image rights in the UK. The key thing is what the public perceives when confronted with goods bearing famous images. The rise in official celebrity endorsements and the number of spin-offs outside the celebrity's original field means consumers are arguably increasingly likely to expect such goods to be officially licensed.

### French evolution

Image rights were introduced in France by case law as a component of personality rights, which are protected under Article 9 of the Civil Code: "one is entitled to have his private life respected." The concept of image rights has, however, evolved over time. Case law has granted a specific status to image rights, as based on Article 9, but distinct from privacy.

Although traditionally considered as a non-economic right, certain cases began to recognise the commercial component of image rights when celebrities began to grant (and monetise) authorisations to third parties to exploit their image commercially: "one has an exclusive right over one's image and can oppose its reproduction or use, even for commercial purposes, without one's authorization" (Versailles Appeal Court, 2 May 2002). This evolution was

more concerned with creating a commercial monopoly in an individual's image than preventing an intrusion into one's private life. The Paris Court of Appeal confirmed this development in a case concerning the image of a famous singer, Henri Salvador, stating that: "when the image of an individual acquires a commercial value because of the notoriety of said individual, the reproduction of the image concerned, without his authorisation, constitutes an infringement of his patrimonial rights, even though it does not relate to his private life/privacy" (Paris Appeal Court, 14 Nov 2007).

Accordingly, French courts have considered that celebrities could validly grant exclusive licences to the commercial exploitation of their image in relation to goods and services. The Paris Appeal Court has also confirmed the validity of sub-licences with regard to the commercial component of a person's image rights (Paris Appeal Court, 22 Nov 2006).

the lines between image rights and IP, and therefore affects the essence of image rights.

The Cour de Cassation (French Supreme Court) regularly recalls that image rights are to remain within the scope of Article 9 of the French Civil Code. In particular, as with any other personality right, image rights cease to exist upon the death of the individual and cannot be claimed by their heirs (Cour de Cassation, 22 October 2009).

### German tradition

Under German Law, there is a long-standing tradition of protecting image rights. The German right to one's own image is a characteristic form of the "general right of personality" (*Allgemeines Persönlichkeitsrecht*) developed by the German Federal Court based on Article 1 and 2 of the German Constitution (*Grundgesetz*) and governed by the German Art Copyright Act (KUG), dated 1907.

*The combination of privacy rights, defamation and rights in passing off mean that an individual is not necessarily without redress in the UK, depending on the circumstances*

In a recent violation of image rights case, the Versailles Appeal Court applied the indemnification mechanism traditionally applied to IP infringement (Versailles Appeal Court, 8 Nov 2012). In that case, a French celebrity's image had been used in Mercedes-Benz adverts without his prior consent. The damages awarded to the celebrity were calculated by estimating what licence fee Mercedes would have paid to the celebrity to obtain his authorisation. Some commentators consider that such a decision blurs

According to these provisions, images of an individual may be spread or published only with the consent of the person, subject to various exceptions. The most important exception applies when persons of "contemporary history" are shown in an editorial context. The German courts then have to balance the interests of the individual and the public interest for information.

Over time, the courts recognised the commercial interest a person may have in their own image and therefore granted stronger protection. In one



famous case, the daughter of Marlene Dietrich sued for damages because of the unauthorised use of her (deceased) mother's image in an advert for a musical about her life. The German Federal Court stated that the general right of personality and the right to one's own image also protects interests of financial value, especially for famous individuals, and that patrimonial interests were also protectable. As a consequence, the right to one's own image may be affected by an unauthorised commercial use. An individual affected by commercial misuse can claim damages based on the usual licence fee.

In a case decided in 2012, the weekly tabloid *Bild am Sonntag* had to pay a licence fee of €50,000 for publishing an image of photographer and author Gunter Sachs reading the publication in a private situation on his yacht with the caption: "Gunter Sachs reads *Bild am Sonntag* – so do more than eleven million Germans." The German Federal Court deemed the publication unlawful because the caption and pictures were connecting Gunter Sachs to the tabloid, creating the impression he was recommending it – which he never did.

According to German First Instance and Appellate Court decisions, the image right also covers an altered and rather artistic use of one's image in the form of pop art paintings. Furthermore, athletes may commercialise their image for use in computer games. The Higher Regional Court of Hamburg held that famous former German goalkeeper Oliver Kahn can control the use of his picture in the FIFA World Championship computer game. The commercial components of the image right can even be asserted by one's heirs.

### Spain's structure

The Spanish Constitution of 1978 protects image rights as personality rights, along with privacy and honorability rights (Article 18.1). The right protects against unauthorised taking and use of the physical features of an individual (Organic Law 1/1982 on the protection of honour, privacy and image rights).

The scope of protection will vary according to the boundaries set by the individual based on their own acts of reliance or estoppel. There is no unlawful act where it is expressly authorised by law or by consent of the individual concerned. This consent – if given – may be reversed at any time, but any damages flowing would need to be compensated (including justified expectations of the person using the image). The right of action belongs to the person whose image rights have been violated, and can be passed on to beneficiaries under a will. If no such designation is made, action can be taken by the spouse, offspring, ancestry or siblings and, ultimately, the Public Prosecutor (*Ministerio Fiscal*).

Unauthorised use of the person's image, voice or name for marketing or commercial (or similar) purposes is expressly prohibited. Image rights are construed broadly, including any feature of appearance – a feature that would permit the person in question to be identified, including fictional characters played by that person. In the Emilio Aragon case (Constitutional Court decision 81/2001), the Defendant was ordered to stop reproducing, in a deodorant advert, the costume of a widely known Spanish singer, consisting of a tuxedo and white sneakers, as the public associated such attire with the Claimant.

Celebrities' privacy rights may be limited when compared with individuals whose ordinary life or business activities are not exposed to the public gaze. However, while capturing a celebrity's image might be legal under certain circumstances (for example during a public performance or in a public place),

the commercial use of such an image may still be prohibited. The Supreme Court decision in case 11/2014, *Mrs Sara et al v Hachette Filipacchi SL (Qué me dices case)* concerned whether the use of a photograph containing the image of a female actor strolling in a public area with her husband, taken without consent, was legitimate for a make-up advert. The Court considered that, although the Claimant's privacy rights were not infringed, the image was being used to make the product appealing to consumers to increase sales. As such, such a use fell within the prohibition and was banned.

The protection of personality rights is well established in the laws of France, Germany and Spain. In each case, the scope of the right has widened over the years to encompass protection against unauthorised commercial use. In contrast to continental European jurisdictions, there is no formal codified image right in the UK. However, the combination of privacy rights, defamation and rights in passing off mean that an individual is not necessarily without redress in the UK, depending on the circumstances. The Rihanna and Betty Boop decisions illustrate that the English Courts are prepared to step in where they perceive that commercial activities

leveraging a famous image have crossed the line.



Thanks to Marc Schuler and Vincent Robert (*Bird & Bird Paris*), Verena Haisch (*Bird & Bird Hamburg*), Thomas Urband (*Bird & Bird Munich*), and Fidel Porcuna (*Bird & Bird Madrid*) for their contributions.



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# REFORM ON RIGHT TRACK

*Colin Hulme casts a largely approving eye over the ELC's threats recommendations*

**F**ollowing a 2013 consultation paper and the Scottish Law Commission's discussions on the review of groundless threats provisions, the English Law Commission (ELC), on behalf of the Department for Business, Innovation & Skills and the UK IPO, has now provided its recommendations for reform.

I think the ELC has achieved a good balance. On the one hand, parties should be entitled to vigorously protect and enforce their IP rights. However, there is a clear need to temper those rights to protect competing, and often smaller, businesses from repression. It is this line that the ELC's recommendations have sought to carefully walk.

As I expected, the ELC recommends the retention of the essential protection against groundless threats of infringement proceedings for patents, trade marks, registered and unregistered design rights, subject to certain refinement. While there is a clear appetite for change, the recommendations are not particularly drastic. Rather, the ELC has taken on board the views of those in practice and suggested changes that should allow us to better assert our client's rights without fear of blowback.

## Primary infringer

The ELC recommends that the primary infringer exception should be extended to cover trade marks and design rights, not just patents. It seems sensible to me that those provisions are aligned.

As matters stand, the exception in relation to trade marks and design

rights relates to primary acts of infringement, as opposed to the status of the party carrying out the act. That means that any claims made to a manufacturer or importer of infringing goods that include allegations of advertisement and sale (which are themselves secondary acts) will trigger the groundless threats provisions. That problem came to light in the case of *Cavity Trays Limited v RMC Panel Products Limited* [1996] RPC 361, which eventually caused the reform of groundless threats provisions in relation to patents. The main aim for many of our clients is to stop infringement by targeting the trade source, and removing the *Cavity Trays* problem across the board seems only right.

## Legitimate commercial purpose

In response to a threat, secondary infringers will often be less inclined to enter into a lengthy dispute in relation to goods they do not produce and therefore have little interest in protecting. Secondary infringers, such as retailers, are therefore considered to be in need of protection against groundless threats to ensure they are not worse off. However, where there is a legitimate commercial purpose, a rights holder should be able to communicate to secondary infringers when acting on

information they reasonably believe to be true. Currently, the mere notification of a right, or the communication of factual information regarding the right, will not constitute a threat, but at what point does this cross the line? Guidance on this is not readily available.

I am interested to see how the drafting will take form. Until then, I am uncertain how this provision will be enforced.

## Adviser liability

Very much welcomed is the proposed protection of solicitors, registered Patent Attorneys and registered Trade Mark Attorneys from liability, where they have acted in their professional capacity and on instructions from their client. Not only does this allow more sensible communications between legal advisers, it also alleviates the potential damage that can be caused to the relationship between the adviser and client.

## Moving forward

There is also talk of widening the legislation to not only cover communications between the rights holder and the potential infringer, but also false or misleading allegations made in the course of trade, for example to its customers and the wider public. Again, that is welcomed.

I am encouraged by the ELC's responsiveness to the appeals of practitioners and really do hope to see the changes brought into force. Perhaps the changes will also make way for the introduction of a formal pre-action protocol for IP disputes.

*The full report can be found at [lawcommission.justice.gov.uk](http://lawcommission.justice.gov.uk)*



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Colin would like to thank Louisa Mann, Solicitor at Burness Paull LLP, for her assistance with this article.

# STRONG

WORDS

**O**ne of the many common mottos to be found upon the numerous grants of arms is *Dat gloria vires* – A good name gives strength – and that might be true of the very nature of an heraldic grant of arms when viewed from a trade mark perspective.

The interplay between heraldry and trade mark protection has been shrouded in a certain degree of mystique, and one little-known fact is that grants of arms are not merely intended for a coterie of ancient noble families. They have also been granted to more than 4,000 corporate entities. The College of Arms, first incorporated in 1484, is charged under statute with a delegated royal prerogative of granting such arms in the form of letters patent. It actively promotes its grants to companies – and the threshold for obtaining a grant is not nearly as high as the commercial world might believe. The College will allow grants to comprise letters, words, numerals and, of course, devices, as well as any combination of those elements.

To understand how heraldry and trade marks work together, one needs to step into the world of chivalry for a moment. Quite independent of registered trade mark law or passing off, is a body of law known as heraldic law, which governs the grant and protection of grants of arms. The exact parameters of that area of law remain to this day uncertain, because it is law that was created under a statute of Richard III and developed through case law that has been poorly documented.

*Mark Engelman explains how an ancient tradition may provide an effective modern-day shield for brands*

Generally, the case law has been concerned with issues associated with inheritance. It rarely concerned itself with the misuse of such grants in the form of trade marks. However, one landmark case brought misuse into sharp focus: *Manchester Corporation v Manchester Palace of Varieties LD HC of Chivalry*, [1955] 2 WLR 440.

The Manchester Palace, a well-known theatre located, as the name suggests, in Manchester, decided to adopt the grant of arms of the Corporation of Manchester, the municipal authority for the area. It used the grant, a shield device, both as an item of decoration within the theatre and also as its company seal. The Corporation petitioned an ancient jurisdiction of the High Court, the Court of Chivalry, to determine whether infringement of the rights of the Corporation as a grantee of arms had taken place. Lord Justice Goff, having first confirmed that the Court of Chivalry could be convened to hear the case (given that the Court had not sat in that form since 1740) decided that the use of the Corporation's grant of arms by the theatre upon its seal was an infringement of the former's heraldic rights. Thus, at least as far as the law of heraldry was concerned, the

reproduction of a grant of arms without authority of the grantee constituted an infringement of its rights. In passing, and quite bizarrely, a short walk down Lamb's Conduit Street in London will take one to a menswear outlet that displays the same coat of arms in its shop windows. In his judgment, Goff J does not discuss the existence of competition between the Claimant's and Defendant's respective areas of business, an issue that lies at the heart of trade mark law. Thus, whether anyone in the marketplace was actually misled by the depiction of the Corporation's grant upon the Manchester Palace's decoration or seal, which would otherwise support a finding of confusion for the purposes of registered trade mark infringement or passing off, was not considered by the Court.

As far as the law of heraldry goes, that one case represents the entirety of the body of law concerned with the misuse of a grant of arms.

## **Protected species**

Grants of arms, as the subject of letters patent, are a protected species of insignia that take precedence over registered trade marks – much in the same way as registered trade marks and passing off rights take precedence over registered domain names.

That respect for them is reflected within the terms of section 4(4) of the Trade Marks Act 1994, which confers upon the Registrar the right to make rules concerning grants of arms. Rule 10 of the 2009 Trade Mark Rules prevents the registration of a mark if a representation of any arms or



## *The extensive protection afforded to a grant of arms coupled with the ease and expense in obtaining one, poses an attractive proposition for commercial entities*

insignia appears in it. The two provisions are intended to transpose Article 6ter of the Paris Convention. However, Article 6ter confers even wider protection by seeking to prevent not merely the application and registration of a mark that contains an heraldic emblem, but also the use of any such device.

Article 6ter circumscribes those cases in which the use of grants of arms would suggest a connection with the rightful grantee. Article 6ter (9), for example, extends that basic protection to other forms of unauthorised use in trade, such as use of the armorial bearings as decorative elements on the packaging or design of goods, or in advertising material if that use would mislead as to the origin of the goods concerned.

Fortunately, unlike the law of heraldry, we have recently been provided with a modern-day example of the application of Article 6bis in a judgment of the General Court in *Prinz von Hannover v OHIM* (T-397/09). Prinz von Hannover is a descendant of the Hannoverian line, which meant, rather unsurprisingly, that his family's grant of arms did not appear too dissimilar to that of Britain's royal family (the heraldic symbol of the UK). His application for a Community Trade Mark was rejected by OHIM under Article 6ter as enshrined in Article 7(1)(h) of Council Regulation (EC) 207/2009. His appeal to the Board of Appeal was similarly rejected. The General Court again dismissed his subsequent appeal, despite Prinz von Hannover's arguments that there existed significant differences between the two competing signs and his

assertion of a prior right through his claim to a common genealogy.

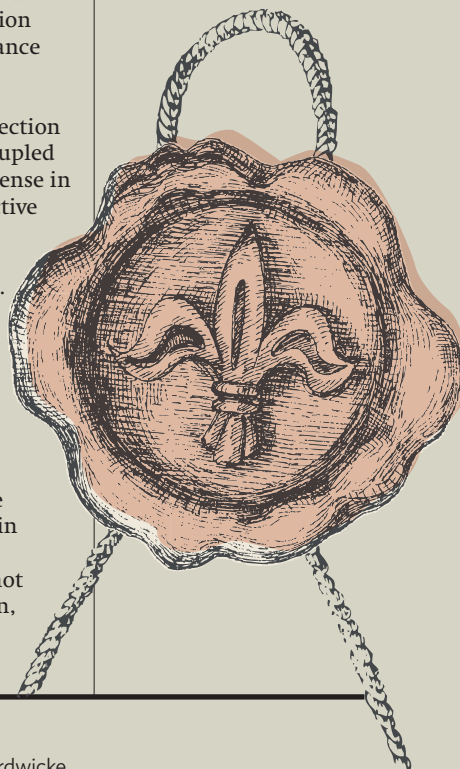
While no actions in the English courts have concerned Article 6ter, many concern disputes over devices that comprise elements of coats of arms. Take a recent dispute over the right to use of the White Rose of the House of York by both Samuel Smith Brewery and a competitor microbrewery, in *Samuel Smith Old Brewery (Tadcaster) v Philip Lee (t/a Cropton Brewery)* [2011] EWHC 1879 (Ch). His Honour Justice Arnold tweeted the four-day trial live from court to the population of Yorkshire given the importance and interest of the white rose symbol to that county.

However, the extensive protection afforded to a grant of arms coupled with the relative ease and expense in obtaining one, poses an attractive proposition for commercial entities as an adjunct to their existing trade mark portfolios.

For example, an Article 6ter action, in principal, only requires a mark-for-mark comparison (no need to examine any similarity or identity in the respective goods or services) of two competing signs, avoiding one of the usual factors operative in a global appreciation test. The *Prinz von Hannover* case did not entertain any such comparison, despite the involvement of a large number of trade mark

classes. Such an action would be akin to a section 10(3)/Article 5(2) trade mark infringement action, but without the usual requirement of establishing some of its more onerous essential conditions, namely, reputation, nor the adverse consequences of either tarnishing, free riding and/or dilution. In essence, the test for infringement is, within the terms of Article 6ter, use that would suggest a connection with the rightful grantee: could that be a link without the need to establish real damage? Nor is it clear whether the infringer need take the entire grant of arms; merely a component part of a grant of arms might provide a sufficient basis for a claim.

Might we now, therefore, expect to see a grant of arms comprising an apple with a bite taken from it, a grant with the word Nike through it, and a new heraldic motto: good names given even greater strength?



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**I**n 2010, “app” was voted the word of the year by the American Dialect Society and, in 2013, around 27 billion apps were downloaded for iPhones alone, generating revenues of \$6.4 billion. Meanwhile, in the business-to-business market, companies in the US are predicted to spend more than \$13 billion on cloud computing and managed hosting services this year. What new or increased opportunities or challenges does this burgeoning market, with its eye-watering sums and exponential growth, present for trade mark owners, who are already grappling with the implications of AdWords, cybersquatting and brand-jacking?

For one thing, there may be a greater risk of confusion. As more brands set up shop in the online world, and in a way that is compatible with mobile devices, the brand message has to fit in an ever-smaller space, and this is particularly true of apps. For example, the app will probably be accessed via a launcher icon, which, for an iPhone, will be just 60mm x 60mm, or a single tile (as with the Windows® 8 operating system). Depending on the platform and device, there may be nowhere to put a logo or, at best, only a small space in which to do so.

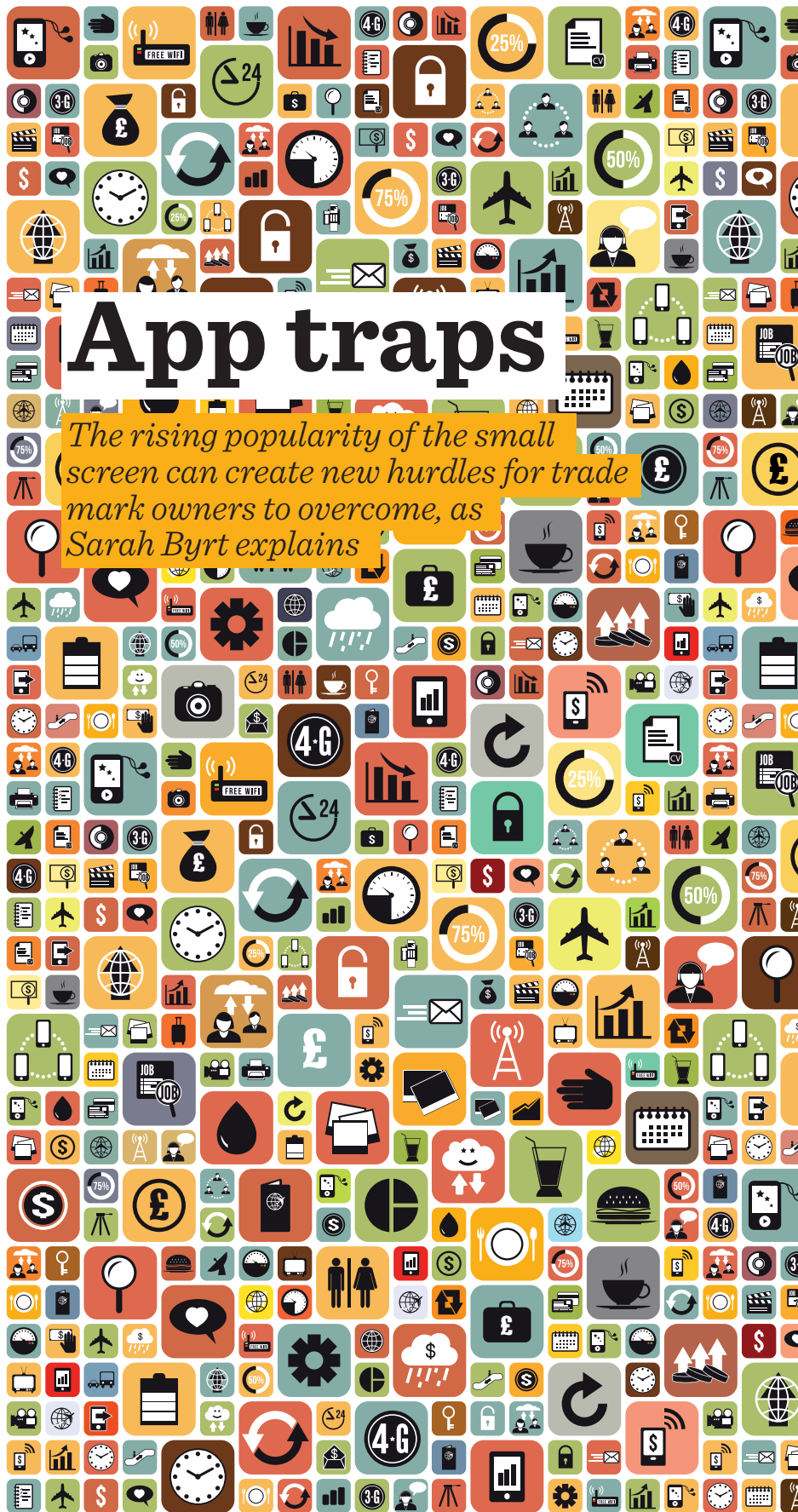
From a trade mark point of view, this can mean that brands that usually appear alongside a house mark in the physical world end up being seen in isolation, so heightening the risk of infringement. The SKYDRIVE case (see panel opposite) is a good illustration of this, as Microsoft’s name was only included in the small print at the bottom of a screen or was, in many cases, completely absent.

### Dilution dichotomy

Dilution may be easier to prove, but may be exacerbated by third-party code users. In the SKYDRIVE case, the court found that the loss of

# App traps

*The rising popularity of the small screen can create new hurdles for trade mark owners to overcome, as Sarah Byrt explains*





## *THE SKYDRIVE SCENARIO*

The 2013 case of British Sky Broadcasting Group plc and others v Microsoft Corporation and another [2013] EWHC 1826 (Ch) concerned a dispute over Microsoft's use of the name SKYDRIVE for a cloud-based storage facility for files and photographs.

The Microsoft® SkyDrive product, which launched in 2007, was originally part of the Windows Live® suite of services and was called Windows Live SkyDrive. It then evolved into a stand-alone offering and Microsoft made the developer code available to third parties so that they could integrate apps with SkyDrive. Thanks to this, subsidiary apps were created, with names such as Sky Wallet.

The product was available not just via one of the start-up tiles pre-loaded on a PC as part of the Windows® 8 operating system, but also on smartphone and other platforms, such as Xbox®, gaining some three million users in the UK. The branding focused on SkyDrive alone as part of Microsoft's "strategy to focus on the individual product names rather than the Windows Live service".

These factors made it hard, if not impossible, for the end user to realise that there was any connection between SkyDrive and Microsoft. This was doubly true for those receiving emails with links to content being shared with them by SkyDrive users, since the recipients did not necessarily have a Microsoft or Windows Live account, in which case they would not have accessed SkyDrive through such an account. The small print on the relevant page of Windows Phone® app store for the SkyDrive app did state "Publisher: Microsoft Corporation", but whether the user even saw this depended on their device's screen size and whether they bothered to scroll down. Once the app was in use on a telephone, the Microsoft name was not visible at all, for example to someone looking at a friend's phone. In short, in the words of the judge, "Whilst the sign is not to be stripped of its context ... even before SkyDrive was set free in effect as a separate brand in 2011, the

distinctiveness, triggered by Microsoft's choice of product name, was compounded by its having made code available to developers to encourage the creation of compatible products. This therefore bolstered Sky's case under section 10(3) of the Trade Marks Act 1994.

Where an app developer makes code available in this way, the licence terms (which will tend to be non-negotiable) should reserve the right for the licensor to control the names of subsidiary apps (just as any other trade mark licensor would do), including giving it the right to withdraw permission to use its brand if it has to undergo a rebranding exercise. The more sophisticated app licensors already do this, but it may not be front of mind for others. By the same token, claimants in Sky's position should think about the terms of the judgment that they are seeking in an infringement action and how to bring an end to the ripple effect of any infringing brand use down the chain of licences by third-party developers using the defendant's code. There may be a proliferation of small players, all making apps available for little or no money using the offending name, and the claimant will not want to

have to take action against each one separately. As I'll explain in the next section, however, it may be able to call on an app store owner to help with enforcement.

### **Owner assistance**

As in other online contexts, trade mark owners have an extra weapon in their armoury when taking action against infringements in that they can ask online service providers – in this case, the relevant app store, or a cloud service provider – to exercise take-down powers, or to disable access altogether (as applicable) under their user terms. To take just one example, Facebook has apparently used the take-down procedure to ask one app store to remove more than 40 third-party apps bearing the Facebook name, some representing a genuine desire by the app developer to improve the user experience and other apparently bare-faced attempts to give the appearance of emanating from Facebook itself.

This can be a rough-and-ready solution, given that the service providers are not in the best position to judge the strength of an infringement claim – and frankly may have little incentive to do so if



being asked by a significant customer to take down a small company's products. What is more, trade mark owners will already be used to the risks of criticism in the online "court of public opinion" when they seek to enforce their rights. In 2013, when Amazon took down the e-book *Spots the Space Marine* following a complaint by Games Workshop that this infringed its SPACE MARINE trade marks, used in its Warhammer series of games and associated books, the online community came to the author's rescue. They claimed that the name was a sci-fi icon that had been used since the 1930s and Amazon reinstated the e-book on its site. That move was reported on the website of the Electronic Frontier Foundation (which had been at the forefront of the outcry) under the headline, "Trade mark bully thwarted".

### Quality control

This final point relates to cloud computing. Of course, many brand owners rely on third parties in circumstances in which underperformance of the third party can damage brand value – whether they are selling through bricks-and-mortar retail outlets, outsourcing fulfilment of orders to a logistics company or using an offshore call centre to respond to customer complaints. In that sense, cloud computing does not give rise to completely new brand-protection issues, but merely accentuates the risk. After all, I may not think less of a washing machine brand if the shop that sells me the machine has poor customer care, but if what I am buying is an online service (such as LinkedIn), I will most likely think less of that service if, behind the scenes, a cloud provider fails to enable me to connect to it in a consistent and reliable way.

While cloud computing promises both cost savings and increased business agility, risks include inroads into data security (such as the danger of inadvertent disclosure of sensitive information) and concerns over the provider's uptime and disaster recovery. As one blogger put it: "99.99% uptime may sound impressive until you work out

**Cloud computing does not give rise to completely new-brand protection issues, but merely accentuates the risk**

the cost of 0.01% downtime." Any business that is considering using an external cloud services provider in relation to the way it interfaces with its customers will therefore think very carefully about both the provider's technology and how to use contractual terms to help ensure a high level of reliability. Technical concerns and brand protection will be closely aligned in seeking to offer the best customer experience.

### THE SKYDRIVE SCENARIO CONTINUED...

evidence clearly shows that it was often free of all Microsoft context."

Sky successfully opposed Microsoft's application for a Community Trade Mark and then sued for trade mark infringement (based on various registrations for the word SKY) and passing off. Technology played a part in coming up with evidence of confusion: Sky was able to search its call centre management database, while most of the evidence was elicited by putting a message on the company's intranet. This revealed that some Sky subscribers had called its customer helpline when encountering problems with SkyDrive, which they assumed was a Sky product. This evidence carried much greater weight than Sky's survey. (It is easy to predict that other uses of technology will make it easier to capture evidence of confusion in the future, such as chat forums, user comments and tweets.)

Sky was victorious on both counts and, following a settlement, Microsoft has since rebranded its product as OneDrive™.

### WHAT IS CLOUD COMPUTING?

According to the US National Institute of Standards and Technology's definition, "Cloud computing is a model for enabling ubiquitous, convenient, on-demand network access for a shared pool of configurable computing resources (for example networks, servers, storage, applications and services) that can be rapidly

provisioned and released with minimal management effort or service provider interaction." This in turn uses models known as "infrastructure as a service", "platform as a service" and "software as a service".

Examples of services that use cloud computing include Facebook, LinkedIn, Hotmail and Flickr.



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# NETWORKING IS NOT JUST FOR EXTROVERTS

*Missed INTA's latest big meeting? It might have been for the best, according to Bernard Savage*



**D**o you go to networking events grudgingly to show your commitment to business development? Can you remember how you felt the last time you walked into a crowded room of strangers? In my personal experience of working with attorneys, many find the whole networking experience can be quite miserable and fruitless.

The solution to a networking issue is based around the premise that one size does not fit all. Different personality types should approach building visibility and cultivating relationships in different ways. There really are alternatives to big formal events, where the topic of conversation might not steer away from football and the World Cup in Brazil, or you find yourself stuck finding common ground with a balding middle-aged man in a scruffy grey suit.

Unfortunately, a myth has been peddled that networking is only for extroverts and that success hinges on your ability to work the room and deliver a sales pitch (often referred to as an elevator script). This is hocus-pocus. Introverts really can network, a sales pitch is not required, and smaller and more informal gatherings can actually be more productive than crowded headline events.

In fact, anecdotal research indicates that the IP profession

has more than its fair share of introverts. So how should this group approach networking? First, it should shun large, traditional events and seek smaller more intimate forums. This might mean asking a few clients and referrers to invite a friend or two along and meet after work for a drink. When taking this route, make it clear you are not staging a hospitality event, but simply getting some people together to facilitate introductions and share news. Put a nominal sum of money behind the bar for the first two rounds and people will appreciate the gesture. These type of events position you as a go-to person and it's a good way to generate new opportunities, too.

Second, focus on engaging with like-minded people rather than people you simply see as a means to an end because they hold the purse strings of potential clients. Like-minded people will help you and know others in their own network who are responsible for IP. It's much easier to do business with people you like as trust can be established more quickly.

It's also important to remember that networking should not be limited to meeting new people. For many attorneys closer to the introversion end of the spectrum, this should be good news. Instead of homing in on strangers, focus on getting face time with people you already know – clients, new and lapsed, international agents and other professional referrers of business. You don't need to sell. More important is to build rapport, listen attentively to find ways to help and stay visible by following up after your meeting.

The truth is, networking is a business development strategy that is open to all, extroverts and introverts alike. If you are a quieter, more reflective individual, don't go to "scary" events such as INTA, but instead spend more time with people who share your interests. Focus on building visibility, not selling. The instructions will flow naturally when you spend more time with people with whom you genuinely and naturally get on.



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# Assess Success



22

**W**hat is the best news for IP professionals coming out of the recent

UK IPO report on the effectiveness of IP audits? Perhaps the fact that customers gave those with whom they worked high ratings across the board for a range of skills, including knowledge (9.02/10) and competence (8.99/10). In addition, says the report: "Overwhelmingly, businesses believe that the IP professional understood their business (74 per cent to a great extent and 25 per cent to some extent). Furthermore, the majority (88 per cent) indicated that they would recommend their IP professional to a business similar to their own."

Clients suggested that the IP professional they worked with offered a perspective that they would not have been able to access in another way, which enabled them "to think of protecting or capitalising on areas they would not have thought

*Recent research suggests IP audits have so far made an impact in supporting SMEs*



of had they not had the opportunity to consult with the professional”.

In addition, where recommendations for actions were given as a result of an audit, businesses were satisfied with them; 88 per cent gave a score of at least 7 out of 10 on this point.

So, lots to enjoy. However, the fact that, when it comes to finding an IP professional, nearly half of audited businesses were referred by an IPO Audit Partner (GrowthAccelerator, Scottish Enterprise, Welsh Government), also points out that, when it comes to connecting with potential audit customers, there is further work to do in ensuring businesses take advantage of this tool.

What could help your firm to build a persuasive business case with which to entice new audit clients are some of the report’s other findings, which strongly support the idea that businesses are seeing real benefits as a result of these IP investigations. According to the text of the report, these include the fact that:

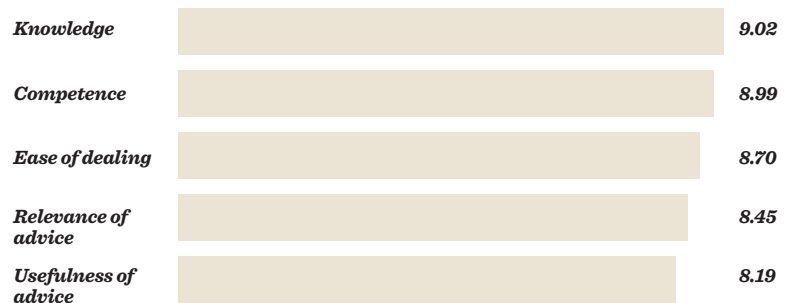
- Three out of ten (31 per cent) businesses reported that their recommendations identified new business opportunities.
- More than four in ten (43 per cent) have identified new opportunities to exploit their IP through initiatives such as licensing and franchising.
- One in six (17 per cent) have been able to secure more business as a result of their IP assets.
- Some businesses report financial benefits as a direct result of the IP audit; around three in ten (28 per cent) indicated that they have seen some financial gain as a result.

The new awareness and strategic forward planning that can be informed by the audit has also led to some businesses reporting that they have generated new funding streams – such as equity funding (23 per cent) and grant funding (30 per cent).

### Advice to action

When it comes to acting on recommendations, 73 per cent indicated that they are likely to

## REPORTED SATISFACTION WITH IP PROFESSIONALS FOR...



Scores are a mean score out of 10, where 10 is very satisfied and 0 is not at all satisfied.  
(Base: all businesses participating – 100)

implement at least some recommendations, and 38 per cent reported they already had. Yet there is some evidence suggesting that businesses can be slow to act, with the greatest barriers to implementation being costs (44 per cent) and resource limitations (31 per cent). Some businesses also mention the need for ongoing support (15 per cent) to ensure that they are still on track with IP. This was described as “IP surveillance” by one business that took part. The report suggests that, following on from this knowledge, offering businesses a staged action plan would potentially be of benefit. This is particularly so for the smallest of audited businesses, who also could benefit from an initial, less-detailed IP health check, before undertaking a full audit.

In addition, some businesses expressed a desire that the report break down actions into those that represent quick wins, medium-term and long-term goals. Notes the report: “recommendations in easily digestible segments may influence them to take action quicker as they can focus on the easy wins.”

### Cost contradiction

What emerges is a very positive picture of the IP audit process. Having undertaken one, awareness of IP issues is much higher on businesses’ agenda (79 per cent). And, among those surveyed, there is widespread acknowledgement of the value of the IP process. Overall, the findings indicate that IP audits have had a positive impact in helping businesses to raise their awareness of IP value and to capitalise on previously untapped opportunity.

Nonetheless, this doesn’t directly translate into a greater willingness to fund such audits, and the investment required is still seen as high and the subject remains low on businesses’ operating priorities. Just one quarter of businesses indicated that they would self-fund an audit, even given their positive views of their experience. So there is still work needed to provide support and to build on the positive momentum that has been recorded so far.

Find the full IPO report at [gov.uk/government/publications/intellectual-property-ip-audit-evaluation](http://gov.uk/government/publications/intellectual-property-ip-audit-evaluation)

# DECIDING FACTORS

*The speakers at a recent ITMA meeting on OHIM and UK IPO decisions share a trio of insights with Review readers*

**T**hree topics formed the basis for the Evening Meeting on 24 April, each offering an insight into current OHIM and UK IPO thinking.

## Likelihood of confusion

Despite 20 years of harmonised Community Trade Mark law, the vital question of how to assess a likelihood of confusion between trade marks is still open to debate. The problem is not that there is no answer to the question, but that there are too many answers to it.

A case that is symptomatic of the difficulties is C-57/08, *Gateway Inc v OHIM* [2008] ECR I-188. Gateway opposed an application to register the mark “Activy Media Gateway” for computing goods and connected services, under Articles 8(1)(b) and (5) of the Community Trade Mark Regulation (“CTMR”) on the basis of its earlier marks, including “Gateway”. The opposition was dismissed on the grounds that “Gateway” was descriptive, the dominant element of the Fujitsu mark was “Activy” and so the marks were not similar. The finding of no similarity, effectively ignoring the use of the Gateway name, may seem

particularly odd given the Court of Justice of the European Union’s (CJEU) decision in C-196/11, *Formula One Licensing v OHIM*, 24 May 2012.

Possibly in response to *Gateway* or similar decisions, the Grand Board of Appeal handed down a significant decision in R-1462/2012-G, *Lifestyle Supplies v Ultimate Nutrition* on 18 September 2013, which was intended to be and has been followed by OHIM. The mark applied for was “Ultimate Greens” and the Opponent had two device marks (shown opposite), both of which included the words “Ultimate Nutrition”.

The Opposition Division had found a likelihood of confusion. On appeal, the Grand Board held that the level of protection for any mark “goes hand in hand with the distinctive character” – weak marks get only weak protection. The Grand Board did not hold back from expressing its view of the lack of distinctive character of the earlier marks and their potential vulnerability.

It held that non-distinctive elements of marks are not perceived as indicative of origin, and, if a proprietor chooses to register a mark with low distinctiveness, it must accept that its competitors will be entitled to use the

same or similar components.

This means, first, that one cannot adopt a mechanistic approach to the assessment of likelihood of confusion (similarity of goods + similarity of marks = likelihood of confusion); and, second, that non-distinctive elements will not be given too much importance in assessing likelihood of confusion.

The decision has since been applied, for instance, in: R-2182/2011-2, *Grand City Hotel GmbH v City Hotels Hispania*, 28 October 2013; R-1624/2012-2, *HT Health Trade v Bach Flower Remedies*, 29 January 2014; and R-25/2013-4, *Elixirs & Co v Bach Flower Remedies*, 20 February 2014.

## Proving genuine use

Several recent cases emphasised the importance of filing a sufficient quality of evidence to prove genuine use.

In BL-O/181/14, *Noble Foods Limited v McDonald’s International Property Company Limited*, 21 March 2013, McDonald’s unsuccessfully opposed the registration of two marks, “Happy Sandwiches” and “Happy Quiche”, for sandwiches and quiches respectively, on the basis of its earlier marks for “Happy Meal”. The evidence filed by McDonald’s consisted of one brief witness statement, which stated that

**If a proprietor chooses to register a mark with low distinctiveness, it must accept that its competitors will be entitled to use the same or similar components**

Happy Meals had been sold in enormous quantities but failed to explain how Happy Meals had been promoted or what food was comprised within the Happy Meal menu. Evidence of the extensive reputation of the Happy Meal mark was held insufficient to get McDonald's home on proof of use across the full range of goods protected by the mark. Interestingly, Iain Purvis QC, sitting as the Appointed Person, also held that evidence that a mark has an enhanced reputation is not automatically a "turboboost" to an opponent's case on likelihood of confusion: "the tribunal must consider what is the actual nature of the reputation, and then ask whether it is of a kind which will tend to increase the likelihood of confusion."

A similar story was seen in the case of BL-O/441/13, Guccio Gucci SPA v Gerry Weber International AG, 5 November 2013, in which Gucci's GG trade mark (shown right) was revoked in respect of a range of goods, including watches and handbags. Gucci's witness statement from its in-house counsel focused too much on Gucci's general reputation and not enough on detailing advertising and sales figures in relation to the specific goods and trade mark in issue.

In the case of Healey Sports Cars Switzerland Limited v Jensen Cars

Limited [2014] EWHC 24 (Pat), [2014] ETMR 18, an appeal from the UK IPO to the High Court, Henry Carr QC, perhaps somewhat optimistically, commented that, in trade mark cases, evidence of fact should not be given by legal representatives, but by people with first-hand knowledge of relevant facts.

### Black and white marks

On 15 April 2014, OHIM published its "Common Communication on the Common Practice of the Scope of Protection of Black and White ('B&W') Marks", with the aim of converging European practice on the handling of B&W trade marks in relation only to priority, relative grounds for refusal (identity) and genuine use. The Common Practice establishes that:

- a trade mark in B&W from which priority is claimed is not identical to the same mark in colour unless the differences in colour are insignificant;
- an earlier B&W trade mark is not identical to the same mark in colour unless the differences in colour are insignificant;
- use of a B&W trade mark in colour will constitute genuine use of that mark as long as the change in colour does not alter the character of the mark. Such will be the case if: the word or figurative elements coincide and are the main distinctive elements; contrast of shade is respected; colour does not possess distinctive character in itself; and colour is not one of the main

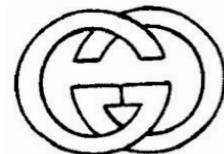
contributors to the overall distinctiveness of the mark.

The Common Practice appears to pose more questions than it answers (for one, how this will tie in with the judgment of the CJEU in C-252/12, Specsavers v Asda Stores, 18 July 2013), but a few things seem certain. First, B&W trade marks are now set to provide much more limited protection, at least in proceedings at OHIM, than previously assumed. Second, brand owners will need to review their trade mark portfolios to ensure that their B&W marks are not vulnerable to non-use and that their colour marks are sufficiently protected. Finally, a reference to the CJEU is sure to follow...

#### Ultimate Nutrition's device marks



#### Gucci's trade mark



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# THE BEAR FACTS

*Daria Pettus leads us through Russia's trade mark registration landscape*



**T**he main provisions related to the protection of trade marks in Russia are stipulated by Part IV of the Civil Code of the Russian Federation adopted on 18 December 2006.

Russia is also a member of all international treaties in the sphere of trade mark protection, including the Paris Convention for the Protection of Industrial Property, the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, and the Singapore Treaty on the Law of Trademarks.

The agency responsible for trade mark registration, also performing several other trade mark-related administrative functions, is the Federal Service for Intellectual Property of Russia (Rospatent).

Trade mark rights in Russia are acquired on the basis of registration. The actual trade mark use in

commerce is not taken into consideration for registration purposes. This is why the concept of priority is very important in local trade mark prosecution and litigation. The priority date is usually the same as the filing date of a trade mark application, unless priority under the Paris Convention is claimed.

Any company that is serious about carrying on business in Russia, and especially companies that already have established trade marks in other countries, should seek registration of their trade marks in Russia early on. There is always a risk that another company may have already registered or applied for an identical or a confusingly similar trade mark, sometimes acting in bad faith, and, if such trade mark has an earlier priority date, it will block the registration of the more recent mark. The procedure for trade mark registration is quite straightforward. The examination of a trade mark application is divided into two parts. The formal examination takes around a month from the filing

date of the application. At this stage, Rospatent verifies that the application contains all the necessary information and that this information corresponds to the legal requirements.

Multiple-class applications are allowed and the official fee depends on the number of classes claimed. When drawing up the list of the claimed goods and/or services, it is important for the applicants to bear in mind that Rospatent requires the use of the same terminology as in the most recent edition of the International Classification of Goods and Services (currently, the 10th edition). Rospatent has been particularly strict about this requirement lately and often issues office actions if the terms used in an application do not correspond to the terminology of the International Classification or are not quite clear to the Examiner.

If such office action is issued, the applicant will be required to make amendments to the list of the

claimed goods and/or services by either rephrasing the term, deleting the term or, in some cases, moving the term to a different class. Any amendments to the list of the claimed goods and/or services involve the payment of an official fee, which is why it is advisable to ensure that the claimed goods and/or services comply with the terminology of the International Classification before filing an application.

If the application is accepted into consideration upon the results of the formal examination, the substantive examination starts, usually taking around 12 months to complete. At this stage, a Rospatent Examiner verifies that the trade mark is registrable as far as the absolute grounds are concerned and conducts a comparative search to reveal any possible identical or confusingly similar registered trade marks and pending applications with earlier priority dates.

If the Examiner does not see any obstacles to the registration of the trade mark in Russia, a registration decision is issued. Within one month from the receipt of a document confirming the payment of the registration fee, the trade mark is recorded in the State Register of Trademarks and Service Marks of the Russian Federation. A trade mark certificate is issued within one month from the recordal of the trade mark in the State Register.

If a Rospatent Examiner believes that the trade mark cannot be registered either on absolute or relative grounds, an office action is issued. The applicant is given six months from the date of the issuance of the office action to provide its response and arguments, which are taken into consideration by the Examiner when the final decision is issued.

If the final decision is a refusal, the applicant can file an objection against it within three months from its receipt with the Chamber of Patent Disputes, which is an administrative body within Rospatent.

A registered trade mark is valid in Russia for 10 years and may be renewed an unlimited number of times, each time for 10 years, during the last year of trade mark validity. A grace renewal period of six months from the expiration of trade mark validity is also available to trade mark owners.

A trade mark owner is required by law to inform Rospatent of all and any changes to the trade mark registration

## TM REGISTRATION TIMELINE (ON AVERAGE)

<b>Application to formal examination</b>	1 month
Substantive examination	12 months
<b>Registration fee paid to recordal</b>	1 month
Recordal to issuance of trade mark certificate	1 month
<b>Trade mark valid</b>	10 years (unlimited renewals)

## FAST ANSWERS

<b>Multiple-class applications allowed?</b>	<b>Yes</b>
Can application be opposed?	No, an opposition may only be filed against a registered trade mark
<b>Grace period for renewal?</b>	<b>Yes, 6 months</b>
International treaties?	Yes, Paris Convention, Nice Agreement, Singapore Treaty on the Law of Trademarks
<b>3D marks registrable?</b>	<b>Yes, except for: realistic images of goods (in respect of the goods they depict); 3D objects whose shape is determined exclusively by their function</b>
Possible to stop goods in transit?	Yes, if they are counterfeit and the producer has a registered trade mark in Russia; not for parallel imports (an infringement suit may be filed once goods enter Russia)

details, including the change of the owner's name or address and the limitation of the list of the claimed goods and/or services. Such changes are recorded in the State Register, and an addendum to the trade mark certificate with the new information is issued.

Licence, assignment and franchise agreements in respect of trade mark registrations are also registered with Rospatent and are deemed invalid without such registration.

Although the Russian legislation does not require any proof of trade mark use to be submitted to Rospatent, after three years from its registration date a trade mark becomes vulnerable to cancellation due to non-use, which means that any interested party can file a non-use cancellation action against it.

### New Court

Until recently, non-use cancellation cases were examined in an administrative procedure by the Chamber of Patent Disputes and, later, by the Arbitration Court of Moscow.

From July 2013, such cases are heard by the newly established IP Court.

The IP Court is a specialised arbitration court located in Moscow that acts as the first instance court in cases arising from the regulatory legal acts of Rospatent affecting the rights and legitimate interests of the applicant in respect of IP.

It also acts as the court of cassation in cases heard by it in the first instance and cases arising from the protection of IP rights heard by the arbitration courts of the constituents of the Russian Federation in the first instance and by arbitration appeal courts.

The nature of IP being specific and different from other types of property, and the idea of establishing a court devoted to cases arising out of IP disputes was certainly welcome in Russia. So far, the IP Court has proven to be an effective institution, handling cases in a timely and efficient manner, and has helped lessen the load of other arbitration courts, which has been beneficial to the judicial system in Russia in general.

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## *Looking into location*

*Dr Mark Schweizer seeks to shed light on a peculiarity of Swiss IP practice*

**T**he Swiss IPO – the Institute for Intellectual Property (IIP) – is notoriously strict regarding applications for trade marks containing geographical terms. This article will try to shed light on some peculiarities of the Swiss practice, and shows how an objection can potentially be overcome, specifically regarding geographical indications and the presumption of understanding geographical terms as geographical indications.

According to Swiss practice, a (known) geographical name will be understood as a geographical indication. It is up to the applicant to demonstrate that the relevant consumers do not understand the term in its geographical sense. This can be successful, for example, when the non-geographical meaning is emphasised by an accompanying figure (for instance displaying a bird in connection with the term PHOENIX, which will then be understood as reference to the mythical creature rather than the city in Arizona).

If the products for which the mark is sought to be protected are used by different classes of consumers – for example, both the general public and a professional audience with special knowledge – it is sufficient



for a rejection that one part of the body of consumers understands the term in its geographic sense. For example, when seeking to register WILSON for tobacco products, the applicant has to show that even consumers of tobacco products do not understand the term WILSON as a reference to the city of the same name in North Carolina, which may not be well known by the general public but is known for its tobacco products.

### YUKON factors

Even if a trade mark contains a geographical indication, it may still be registered if one of the YUKON factors is applicable. Under the Federal Supreme Court's YUKON practice (BGE 128 III 454), a trade mark containing a geographical indication can be registered if:

- a) the geographical indication is not recognised as such by the relevant public (example: SAVANNAH does not refer to the city of the same name in Georgia, but rather to a type of vegetation);
- b) the geographical indication designates a territory that is - in principle and also for the foreseeable future - unsuitable for the production of the products in question (examples: ALASKA for menthol cigarettes, or YUKON for industrial goods, but not CAPRI for tobacco products, because theoretically, tobacco could be grown on the Italian island of Capri);
- c) indications of type - for example, "telephone model VENICE"; or
- d) geographical indications that have become generic terms for a type of good, for example HAMBURGER for meat patties, or EAU DE COLOGNE for perfume (obviously, these will only be registered in combination with a distinctive sign).

### Misleading marks

According to Swiss practice, trade marks containing a geographic indication, such as VIRGINIA SLIMS NO 602 are refused as misleading if the goods covered by the application do not actually originate from the indicated territory. This is quite remarkable - the European approach is only to refuse such marks in case they are descriptive (for the

*Trade marks containing a geographic indication are refused as misleading if the goods covered by the application do not originate from the indicated territory*

### RECENT IIP APPEALS RELATED TO GEOGRAPHICAL TERMS

GREY <i>Objection overcome</i>	RED <i>Objection sustained</i>	RELEVANT MEANING ACCORDING TO FEDERAL ADMINISTRATIVE COURT
TRADE MARK/ PRODUCTS COVERED	RELEVANT MEANING ACCORDING TO IIP	
KALMAR <i>for engines</i>	<i>town in southern Sweden</i>	<i>squid with 10 arms</i>
WILSON <i>for tobacco products</i>	<i>town in North Carolina, USA</i>	<i>surname</i>
BURLINGTON <i>for cosmetics, clothing</i>	<i>town in Vermont, USA</i>	<i>name</i>
BÜRGENSTOCK <i>for hotel services</i>	<i>mountain in Switzerland</i>	<i>mountain in Switzerland</i>
SAVANNAH <i>for clothing</i>	<i>city in Georgia, USA</i>	<i>type of vegetation</i>
QATAR AIRWAYS <i>for services of an airline</i>	<i>Qatar, Arab Emirate of</i>	<i>Qatar, Arab Emirate of</i>
FRANKONIA <i>for retail services</i>	<i>as Franconia, the region of the Franks</i>	<i>many, other meanings are more prevalent</i>
AUSTIN <i>for explosives</i>	<i>city in Texas, USA</i>	<i>city in Texas, USA</i>
VICTORIA CUP <i>for sport events</i>	<i>province in Canada</i>	<i>first name</i>
GERRESHEIMER	<i>as reference to Gerresheim, a district in the city of Düsseldorf, Germany</i>	<i>name</i>
ZACAPA <i>for rum</i>	<i>province in Guatemala</i>	<i>province in Guatemala</i>
AMALVI <i>for furniture</i>	<i>as reference to Amalfi, a town in Italy</i>	<i>fantasy name</i>
MILANELLO <i>for several goods and services</i>	<i>as reference to the city of Milan, Italy</i>	<i>as reference to the city of Milan, Italy</i>
PARIS RE <i>for insurance services</i>	<i>as reference to the city of Paris, France</i>	<i>as reference to the city of Paris, France</i>

geographic origin of the goods in question).

## Objection options

Considering these examples, how could the applicant, or you as its representative, successfully deal with an objection by the IIP?

### 1) Limit the list of goods and services

If you can, limit the list of goods and services to “goods originating from” the indicated territory, such as the US for the VIRGINIA SLIMS NO 602 mark mentioned earlier. This is often not possible, because the goods in question do not actually come from the indicated place, but if it is an option, it is the easiest way to deal with an objection.

Note that it is not recommended that the list of products be limited to goods originating from a place from which they do not actually come. The IIP will not object; however, should you ever try to enforce the trade mark after the five-year grace period for non-use, the trade mark is most likely unenforceable for non-use because it is not actually used for the goods it covers.

### 2) Argue the geographic term is not understood as such

The IIP, unfortunately, will almost always argue that a geographic term is understood as a reference to the place with the same name. However, this is one area where the Federal Administrative Court often sides with the applicant. You must try to argue that the place is unknown, of limited economic importance, far away from Switzerland, and has no touristic significance. Additionally, or alternatively, you can try to argue that the geographic reference is only a secondary meaning, and the term is primarily understood in a non-geographic sense, for example as a personal name.

The table on page 29 shows the appeals against objections by the IIP based on misleading geographical terms to the Federal Administrative Court, and their outcome, during the past three years. As you can see, success is by no means guaranteed, but the rate of success is far greater in this

domain than in any other domain of trade mark law.

Since the determination of the relevant meaning of a term is a factual enquiry under Swiss law, an appeal to the Federal Supreme Court, while theoretically possible, is almost always futile, because the review by the Supreme Court is limited to legal issues. This cuts both ways – a rejection by the Administrative Court is practically final, but so is a decision allowing the registration of the mark (the IIP has the right to appeal such decisions to the Supreme Court).

### 3) Add a figurative sign to your application

If you can – ie, if the application is not an international one – and you face the objection that your mark contains a term that is primarily understood as a geographic indication, try adding a figurative sign that consumers will associate with the non-geographic meaning of the term, like the bird in connection with the term PHOENIX. This will lead to a new filing date, and a limited scope of protection, but may be preferable to abandoning the application. There are no official fees due for such a change.

### 4) Show secondary meaning

Finally, you can try to show that your mark has acquired secondary meaning rather than geographic indication. The IIP’s practice is rather strict, however, and you should be prepared to back up your claim with a demographic survey of Swiss

consumers (the IIP is very sceptical that any valid inferences can be drawn from consumer surveys in other countries).

## ... and what not to do

There are two arguments that it is tempting to make, but are almost certain to fail.

### 1) Claiming equal protection

While in principle, applicants have a constitutional right to equal protection under the law, arguing that your trade mark should be registered because a similar trade mark – or an identical mark for similar goods – has been registered in the past is almost certain to fail. The IIP and the courts always find grounds to distinguish the cases.

### 2) Pointing to corresponding foreign registrations

“But the [OHIM/UK IPO/USPTO] registered the same mark for the same goods,” is never going to convince Swiss courts. While in principle it is recognised that, in close cases, foreign registrations should be given some weight, in practice the IIP and the courts almost always insist that the specific case is not a close case. As frustrating as it may be, the fact that the rest of the world has accepted your application does not amount to much in Switzerland.



**Combined with the image of a bird, the term PHOENIX will not be understood as reference to Phoenix, Arizona**



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# On marks and mediation

*Not all trade mark matters are suited to mediation, warns Michael Edenborough QC*

**R**ecently, much has been written and said on the subject of mediation in IP matters. Usually, the focus has been upon mediation in general and little, if any, emphasis has been placed on matters peculiar to trade marks. This article aims to address that omission.

First, it is relevant to note that mediation is proposed as an alternative to formal litigation that is conducted in the context of a judicial system, be it a tribunal or a court. It is important to remember that a tribunal or court may make orders that are not available in mediation, most obviously an injunction, the breach of which is punishable by contempt proceedings. In mediated settlements any breach is merely a contractual breach, which would require the aggrieved party to issue court proceedings. Less obvious, though, are remedies that deal with the cancellation of a registration, be it a declaration of invalidity or revocation. In a mediation, the closest equivalents would be either the surrender of the registration or letting it lapse. The latter solutions differ from the former ones by, for example, having different consequences for third parties (as is also the case with forfeiture and destruction). Another difference is that a court may certify that the validity of the mark was contested, yet it was found to be valid. Such a certificate has cost consequences on subsequent litigation that would not be available following a mediation. Finally, in this regard, care needs to be taken concerning any agreed

amendment to a trade mark specification, as it might not be accepted by the relevant Office. Therefore, provision needs to be made to deal with that eventuality.

Second, the question of whether to use a mediator who is experienced in the subject matter of the dispute or one who is a generalist seems to be particularly vexed in IP disputes. In this context it is important to remember that the mediator is not there to provide any legal advice to either party. It is for the parties themselves to ensure that they have the appropriate advice. The choice of whether to use a specialist or not depends upon whether one wishes the mediator to act as an informal arbitrator on the merits, or as a facilitator to reaching an acceptable settlement.

## Meeting in the middle

If the mediation is envisaged to be an informal determination on the merits, then trade mark experience might be sought. However, an experienced facilitator might well be able to bring the parties together in a way that an arbitrator could not. A compromise solution might be to use a mediator skilled in facilitation and also well versed in trade marks, and who can (if pure facilitation has failed to resolve the matter) assume an arbitrator-like

role on the express understanding of the parties involved. However, too often in practice there is too little facilitation and too much opining on the merits as viewed by the mediator. That can work against the party with the greater merits, as the party with the lesser merits might well resent the situation and so walk away from a possible settlement, which might be to the disadvantage of both parties eventually.

In summary, a mediated settlement can mimic (broadly) any financial award that a court or tribunal may award, but cannot replicate the non-pecuniary relief. In general commercial disputes, financial relief is often the central issue; in trade mark disputes that might not be true. These differences need to be appreciated and accommodated.

The strength of mediation is the chance to resolve a matter free from the constraints of a formal judicial framework. That strength can be lost if a mediator opines too readily on the merits of the case instead of trying to facilitate a resolution. While mediation has an important part to play in resolving trade mark disputes, not all cases are appropriate for it; some need the special attributes of a judicial decision, for example to act as a legal precedent for other cases.



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# Moving target

*George Sevier recounts a decision that considered the role of collective marks*

A recent case in the Intellectual Property Enterprise Court (IPEC) concerned the apparent continuing use of a trade mark following termination of a licence agreement. The former licensee avoided any finding of trade mark infringement, copyright infringement and passing off. His Honour Judge Hacon also had to address whether the licensor's ordinary trade marks had been filed in bad faith, and had been put to genuine use, since they were used in the manner of collective marks, but not applied for as such.

## Background

Derek Milner runs a removals and storage business in Wiltshire. He had been a member of The National Guild of Removers & Storers (NGRS), but his membership (and his licence to use the NGRS name and logo) ended on 30 November 2010.

Adverts for Milner's business in the 2010-11 editions of Yellow Pages and Thomson Local continued to feature the NGRS name and logo, and NGRS threatened proceedings, but the matter was settled by a £6,000 payment from Milner.

Since then, NGRS noticed an advert for Milner's business, which featured the NGRS logo, in a 2012-13 edition of Thomson Local. NGRS sued Milner for infringement of its UK trade mark no 2425258 (NGRS's logo), infringement of the copyright in NGRS's logo and passing off. It alleged that, if Milner was not directly responsible, then he had authorised or procured the infringement and was jointly liable, or alternatively Thomson Local was Milner's agent and therefore its

publication of the logo rendered Milner liable as principal.

NGRS also sued for passing off, in respect of a website for Milner's business at [www.wiltshireremovals4less.co.uk](http://www.wiltshireremovals4less.co.uk) ("the Website"), which indicated that his business was a member of the "National Guild of Removals" and that it was "Ombudsman-accredited and inspected".

Milner denied infringement and counterclaimed for revocation of trade mark no 2425258 and three other marks owned by NGRS under section 3(6) of the Trade Marks Act 1994 ("the 1994 Act") on the basis that the marks had been registered in bad faith, because at the time of filing each mark, NGRS had intended to use the mark as a collective mark and not a trade mark. He also argued that the special nature of use meant that the marks had not been put to genuine use, leaving them liable to revocation under section 46(1) of the 1994 Act.

## Defence

Milner's defence to infringement was that he was responsible for neither the Thomson Local advert nor the Website.

Milner sent a proposed advert to Thomson Local, which did not contain the NGRS logo. Thomson Local inserted the logo against his instructions. Milner informed Thomson Local that he was not allowed to use the logo, but ultimately the advert was published including the NGRS logo.

Milner said that he was not aware of the Website until NGRS complained about it. He explained

that it had been created by British Telecom (BT) as part of a business package in connection with his advertising in BT directories, and he assumed that BT had based the content on his website at [www.wiltshireremovals.com](http://www.wiltshireremovals.com). By chance, he had sent a letter to BT (addressed to its head office) on 2 December 2010 saying that his business should not be referred to "in connection with the NGRS in any way". He did not know about the Website at that point, but the letter applied to his advertising with BT generally.

The Judge found that Milner had not directed or authorised the use of the NGRS logo or any association with NGRS.

There was no evidence that Thomson Local had held itself out as Milner's agent, and the Judge gave short shrift to the suggestion that there was an agent/principal relationship.

## Collective mark issue

Collective marks are a form of trade mark. Whereas ordinary trade marks distinguish the goods or services of the owner of the mark from those of other traders, collective marks are directed at distinguishing the goods or services of members of the association that owns the mark from those of non-members. Applications for collective marks must fulfil a series of requirements, including payment of an additional fee, and publication of the association's regulations concerning who is entitled to use the mark and conditions of use. There are also additional grounds for revocation on top of the standard grounds that apply to ordinary trade marks. By applying for ordinary trade marks rather than collective marks, NGRS avoided those additional grounds.

Milner argued that NGRS's applications for ordinary trade marks were made in bad faith, since NGRS had no intention to use them as trade marks (as opposed to collective marks). He also argued that the



marks should be revoked as per section 46(1) of the 1994 Act, since they had not been put to genuine use.

The Judge was referred to IPO Practice Amendment Notice (PAN) 2/01. In short, PAN 2/01 states that the IPO should refuse to register identical marks of different statuses (for example as an ordinary mark and a collective mark) for identical goods or services, because: (a) a mark cannot distinguish the goods or services of a trade mark owner from members of an association (and so the mark cannot satisfy the requirement in section 1(1) of the 1994 Act, which is ground for refusal under section 3(1)(a)); and (b) registration would be contrary to public policy, or of such a nature as to deceive the public (which are grounds for refusal under section 3(3)(a) and (b) of the 1994 Act).

NGRS made the point that there is nothing wrong in law with a trade mark proprietor granting licences to use a trade mark. Such a trade mark would not be capable of distinguishing the goods or services of the proprietor or a licensee from those of another licensee; but so

what? Judge Hacon agreed: the mark is still capable of distinguishing goods and services of one trader from those of another, in the sense that the goods bearing the mark either come from the trade mark's owner or from someone authorised by the owner. He found that NGRS's marks offended neither section 3(1)(a) nor the public policy concerns addressed by section 3(3). The Judge commented that he would "find it hard to think of a circumstance in which an association entitled to apply for a collective mark could not avoid the cost and inconvenience of those provisions... by applying instead for a trade mark".

The Judge held that use of a trade mark as if it were a collective mark will qualify as genuine use. The

allegation of non-use failed (except to the limited extent that NGRS had admitted ordinary non-use), and he held that there was no bad faith in making the application for the trade marks.

The Defendant was the overall winner as he was found not to be liable for infringement, and was awarded his costs less a discount of 40 per cent owing to the time spent in relation to his failed arguments of bad faith and non-use. Since the case was in the IPEC, the ultimate award of costs will be subject to the stage caps and the overall cap of £50,000.

In light of this judgment, it is difficult to see why associations would choose to register collective marks if ordinary trade marks can be used for the same purpose.



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# Fortune favours NLC at CJEU

*Charlotte Blakey now looks forward to the Court's fresh ruling*

**T**he National Lottery Commission ("NLC") obtained a Community Trade Mark (CTM) registration for the mark shown opposite on 2 October 2007 ("the contested mark").

The Applicants, Mediatek Italia and De Gregorio, filed for a declaration of invalidity at OHIM on 20 November 2007, on the basis of Article 52(2)(c) of Regulation No 40/94. They requested a declaration that the contested mark was invalid due to the existence of an earlier copyright, owned by Mr De Gregorio, also shown opposite ("the *mano portafortuna*").

The Applicants filed a copyright assignment document, dated 16 September 1986, evidencing the creation of the *mano portafortuna*, and of their status as owners of the copyright ("the 1986 agreement").

NLC claimed the evidence was fraudulent because: the 1986 agreement referenced the maximum duration of copyright protection as 70 years (this duration has only existed since 1996); the date of the post office stamp on the 1986 agreement was a Sunday (a day on which post offices are closed in Italy); and the difference of quality and design between the drawing of the *mano portafortuna* and the other drawings appended to the 1986 agreement suggested that the *mano portafortuna* had been added at a later date. The Cancellation Division of OHIM granted the declaration of invalidity due to the earlier existence of a copyright, protected by Italian legislation, for a virtually identical sign to the contested mark.

The decision was appealed by NLC, but the appeal was dismissed by the First Board of Appeal of OHIM on the

ground that all the conditions required by Article 53(2) of Council Regulation (EC) 207/2009 were satisfied.

The Board of Appeal found that the 1986 agreement demonstrated the Applicants' status as owners of the *mano portafortuna* and the abnormalities referred to did not give grounds for doubting its authenticity.

NLC brought an action for annulment, which the General Court granted on 13 September 2012. OHIM filed an appeal against this decision, which leads us to the current appeal.

## Latest appeal

The appeal has been assessed with regard to the provisions of Regulation No 40/94, as Regulation No 207/2009 was not in force on 2 October 2007 (date of registration of the contested mark) or 20 November 2007 (date of the declaration of invalidity).

OHIM relied on three pleas in law to support its appeal:

- 1) infringement of Article 76(1) of Regulation No 207/2009 and of Rule 37 of the Implementing Regulation;
- 2) infringement of the right to be heard, in so far as OHIM's right to be heard regarding the judgment of 14 June 2007 was not observed; and
- 3) manifest inconsistency and distortion of the facts, which affect the reasoning followed and the conclusion reached by the General Court.

## First ground of appeal

This ground of appeal has two branches to it – OHIM argued that the General Court could not rely on either Article 2704 of the Italian Civil Code or the judgment of 14 June 2007, as these two issues had not been invoked by the parties



and therefore did not fall within the subject matter of the dispute. OHIM also felt it was not clear whether the General Court regards applicable national law as a question of law or fact.

The Court of Justice of the European Union (CJEU) held that the burden of providing OHIM with particulars showing that the Applicant satisfies the necessary conditions, in accordance with the national law of which he is seeking application, to be able to have the use of a CTM prohibited by virtue of an earlier right, applies here (C-263/09 P, *Edwin v OHIM*, paragraph 50).

OHIM is also required to assess the authority and scope of the particulars submitted to establish the content of





Therefore, should OHIM and the General Court do no more than examine the documents submitted by the applicant to establish the content of the applicable national law, or should they exercise a power of verification regarding the relevance of the law invoked that involves, if necessary, obtaining information of their own motion on the conditions of application and the scope of the rules of national law relied upon?

The CJEU held that, as the application of national law can lead to a finding that there is a ground for invalidation of a registered CTM, it seems necessary for OHIM and the General Court to be able to ascertain the relevance of the evidence produced by the applicant with regard to the taking of evidence concerning the content of that national law.

The CJEU also found that the General Court did not exceed the limits of its power to seek information of its own motion to ascertain the content, the conditions of application and the scope of the rules of national law relied upon by the Applicant.

In view of the above, both branches of the first ground of appeal were rejected.

### Second ground of appeal

The CJEU reiterated the fact that the right to a fair trial is a fundamental

principle of EU law, laid down in Article 47 of the Charter of Fundamental Rights of the European Union. To satisfy the requirements relating to the right to a fair hearing, it is important for the parties to be apprised of, and to be able to debate and be heard on, the matters of fact and of law that will determine the outcome of the proceedings (Commission v Ireland and others, paragraphs 55 and 56, and C-472/11 Banif Plus Bank Zrt v Csaba Csipai [2013] ECR, paragraph 30).

In this case, although the General Court invited the parties to put forward their points of view on the provisions of Article 2704 of the Italian Civil Code, via a letter of 7 February 2012, the parties were not put in a position to submit their observations on the judgment of 14 June 2007, as no reference was made to this judgment in the letter. Because the content of the judgment of 14 June 2007 was crucial to the General Court's line of reasoning in its decision, it follows that the General Court infringed the principle that the parties should be heard.

The CJEU held that the second ground of appeal should be upheld.

### Third ground of appeal

The CJEU held that it is not appropriate, at the present stage of the proceedings, to examine OHIM's third ground of appeal.

### Outcome

The CJEU has set aside the General Court's judgment of 13 September 2012, meaning that the General Court will now be required to make a fresh ruling on the merits of the action.

*Keltie acts for Camelot UK Lotteries Limited, which conducted the appeal on behalf of the National Lottery Commission. On 1 October 2013, the National Lottery Commission merged with the Gambling Commission.*

the rule of national law that is relied on (Edwin v OHIM, paragraph 51).

The General Court has jurisdiction to conduct a full review of the legality of OHIM's assessment of the particulars to establish the content of the national law (Edwin v OHIM, paragraph 52).

Despite OHIM's claims, the CJEU felt that it was not clear from paragraphs 50 to 52 of Edwin v OHIM that a rule of national law should be treated as a purely factual matter and the existence of which OHIM and the Court merely establish on the basis of the evidence before them. Instead, the CJEU found that these paragraphs had intended to emphasise the scope of the review that is required.

**The contested NLC mark**



**De Gregorio's mark**



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# The slogan slog

*Richard Ferguson reviews a financial sector case that reaffirms the Court's high bar for slogans*

The General Court recently upheld a decision of the Fourth Board of Appeal of OHIM (R2233/2011-4), rejecting Deutsche Bank's application (an international registration, designating the European Union) to register the advertising slogan PASSION TO PERFORM for a range of services on the basis of absolute grounds.

Two interesting points to note from this case relate to the level of attention accorded to the relevant public in the case of slogans, and the problems that a finding of a clear and unequivocal message can have on imbuing an indication of origin on a mark so that it becomes more than a promotional laudatory statement.

The Court held that the Board was correct in finding that the relevant public (consisting of average end-consumers and commercial undertakings) would have a low level of attention because of the mark's promotional nature and its composition from everyday words. Indeed, the Court added that this could potentially be the case even in instances where the consumer might be more attentive, for example, financial affairs under class 36. By focusing on the advertorial nature of the mark over the goods and services for which registration is sought, though, stricter criteria for assessing a slogan's distinctive character compared to another word mark are arguably in operation by the registries and courts.

The Court also rejected Deutsche Bank's argument that the Board had acted contrary to established jurisprudence<sup>1</sup> by applying stricter

criteria for assessing a slogan's distinctive character per Article 7(1) (b) of Council Regulation (EC) No 207/2009. The Court held that the Board was entitled to find that the mark possessed no distinctive character where the indication of the commercial origin of the goods or services in question could not be perceived immediately.<sup>2</sup>

PASSION TO PERFORM was held by the Court to have a clear and intelligible meaning, namely that Deutsche Bank was promising its clients that it would perform the services with passion. Although Deutsche Bank submitted in evidence various meanings of each of the words making up the mark, the Court did not consider that, taken as a whole, these constituted credible alternative meanings. Similarly, the originality of the mark on the basis that it did not convey any information about the nature of the goods or services concerned was also insufficient to make the sign distinctive. An undertone of the decision, though, was a reluctance to find multiple meanings, which were held in the Audi case (C-398/08 P) to contribute to a finding of a trade origin function, because a single meaning had been deduced. An alternative meaning in this instance, for example, being that Deutsche Bank was passionate in its

*Brand owners are faced with the unenviable task of creating slogans that inform of trade origin and contain a thought-provoking element*

anticipation to perform the service rather than the execution of the service itself.

The decision is a reminder of the difficulties faced by brand owners seeking to register a slogan due to the need to show that it is distinctive (inherently or via use) and not simply descriptive. Brand owners are therefore faced with the unenviable task of creating slogans that inform of trade origin and contain a thought-provoking element and also appeal to relevant members of the public with low attention levels. While there exists no panacea, an applicant's prospects of achieving a successful slogan registration may be increased, albeit on compromised terms, by either delaying filing to show acquired distinctiveness or filing a stylised version of the mark with a narrow specification; as one well-known retailer might say, every little helps.

<sup>1</sup> OHIM v Erpo Möbelwerk [2004] ECR I 10031 (C-64/02 P) and Audi v OHIM ECR I 535 (C-398/08 P) (Audi)

<sup>2</sup> Formanu v OHIM (Qualität hat Zukunft) (T-22/12)



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# Proof imperfect

*Désirée Fields issues a sharp reminder on the scope of use*

In 2008, Intesa Sanpaolo SpA (“Intesa”) filed a Community Trade Mark (CTM) application for the figurative mark EQUITER in classes 9, 16, 35, 36, 38, 41 and 42. An opposition to the application was then filed by equinet Bank AG (“equinet”) based on its earlier Community word mark for EQUINET, registered for services in classes 35, 36 and 38. The opposition was based on all the services covered by the earlier mark and directed against part of the goods and services applied for, namely, those in classes 9, 35, 36 and 38.

Intesa requested proof of the genuine use of the earlier mark. The Opposition Division rejected the opposition, finding that, even if the evidence was able to show the place, time and extent to which the earlier mark had been used, it did not sufficiently demonstrate the nature and use of the mark. The First Board of Appeal annulled the Opposition Division’s decision and remitted the case to the Opposition Division. The Board held that the evidence submitted – which consisted of: (i) audited financial accounts for the years 2005 and 2007, showing that the equinet group earned a sizeable amount in the financial services field; (ii) invoices addressed to various clients; and (iii) excerpts from its website showing use of the mark in relation to financial services – proved genuine use of the earlier mark for financial services, valuation and research services, public relations services and business consultancy and advisory services.

On appeal to the General Court, Intesa argued that the Board had

made errors relating to the place, time, extent and nature of the use of the earlier mark, the link between its use and the services for which it was registered, and the link between the earlier mark as registered and the mark used. Agreeing with Intesa, the General Court annulled the decision.

At the heart of the matter lay the fact that the Board had failed to state reasons for its decision, in so far as the services in relation to which the Board had found genuine use were not included among the services for which the mark was registered. Accordingly, it was not possible to identify the services for which the mark was registered in respect of which it has been put to genuine use. The fact that certain services in class 36 could be described as financial

services did not remedy the Board’s failure to state reasons for those services because the Board did not specify that, by “financial services”, it was referring to all or part of the services in class 36. The lack of precision made it impossible to apply Article 42(2) of Council Regulation (EC) 207/2009, which required that, where genuine use was shown only for part of goods or services, it should be deemed to be registered only for those goods and services.

With respect to the finding of genuine use for “business consultancy and advisory services”, the General Court found again that the Board had failed to state the grounds on which genuine use of the mark has been demonstrated for those services.

Trade mark owners faced with a request for proof of genuine use are starkly reminded of the need to carefully review the scope of protection of any earlier marks relied upon to ensure that, as far as possible, the evidence provided shows genuine use in relation to all goods and services for which the marks are registered.

*Trade mark owners faced with a request for proof of genuine use are reminded of the need to carefully review the scope of protection of any earlier marks relied upon*



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# Reputation confirmation

*An opposition will not succeed if marks are not similar, says Roisin Waddicor*

**A**ava Mobile Oy filed a Community Trade Mark (CTM) application for AAVA MOBILE in classes 9, 38 and 42 for a range of telecoms-related products and services, which Oracle America, Inc opposed on the basis of its prior CTM registration for JAVA in relation to goods and services also in classes 9, 38 and 42 (among others). The grounds of opposition were based on Articles 8(1) (b) and 8(5) of the Council Regulation (EC) 207/2009 (the CTM Regulation).

At first instance, the Opposition Division rejected the opposition, ruling that, as the marks were not similar, there was no likelihood of confusion and that Oracle's prior JAVA mark had no reputation. Oracle appealed, but the Board of Appeal broadly confirmed the previous decision. The Board did, however, hold that Oracle's mark had a massive reputation, albeit that this was insufficient, without the marks being similar, to succeed under Article 8(1) (b) and/or 8(5). Oracle appealed once again, to the General Court.

## Applying precedent

In assessing the similarity of the signs, the General Court followed precedent that a comparison must be made by examining each mark as a whole and that only if all other components of a given mark are negligible should an assessment be based solely on a dominant element. Despite MOBILE being descriptive in English of some of the goods and services applied for, the word was not negligible within Aava's mark. The

General Court found that neither AAVA nor MOBILE were capable of being dominant and that the Board had not erred in considering the overall impression created by the whole mark, rather than just considering the element AAVA as Oracle submitted.

Despite the combination of AAVA letters being common to both signs, the General Court found that the marks overall were not visually similar due to the difference in each mark's first letter and the unusual repetition

of "a" at the beginning of Aava's mark. This followed well-established case law that consumers generally take more note of the beginning of a sign than its end.

The Board had found a low level of phonetic similarity between the marks, but the General Court disagreed holding that there was no similarity since, as it was right to consider the whole mark, the overall number of syllables in Aava's mark was four or five (depending on the language spoken), of which the only common syllable with the earlier mark was -VA.

The General Court found that the marks were not conceptually similar. Since AAVA only has meaning in Finnish (translating to "open", "expansive" or "wide" in English) and may appear invented to non-Finnish speakers, Aava's whole mark has no particular meaning, but will call to mind telecoms and mobile hardware or services due to the MOBILE element. Speakers of all European Union languages, however, may associate Oracle's mark with the island of Java.

The General Court upheld the decision that there was no likelihood of confusion between the marks. While not a groundbreaking judgment, this case confirms that even where the goods and services covered by a mark are identical, the issue of a prior mark's reputation is not relevant where the signs are not similar. In addition, descriptive words within a composite mark are not necessarily negligible when assessing the mark as a whole.



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# So...? Unique?

*Sharon Daboul reports on a recent decision concerning family marks in the European Union*

**D**ebonair Trading Internacional Ld<sup>a</sup> (“Debonair”) filed an opposition against Ibercosmetica, SA de CV’s application to register SÔ :UNIC in class 3 (perfumery, cosmetics...), based on 24 earlier registered national and Community Trade Marks (CTMs) including: SO... ? (CTM), SO... ? ONE (UK), and SO... ? CHIC (CTM).

As well as Article 8(1)(b) of Council Regulation (EC) 207/2009, the opposition was based on Article 8(4), citing several non-registered word marks in the European Union (EU) containing the element “so”, most often as part of the expression “so... ?”.

OHIM’s Opposition Division and Board of Appeal (BoA) rejected the opposition, finding that there was no likelihood of confusion under Article 8(1)(b) because SÔ :UNIC could not be considered a part of the same family of marks as that which might have been formed by the “so...?” marks. The application did not correspond to the pattern of the earlier marks as it did not reproduce the initial part identically. Furthermore, the term “UNIC” was not an English expression, unlike the expressions following the element “so...?”, and was a fanciful expression. The General Court (GC) confirmed this decision, noting that the graphic and semantic differences between the marks were significant.

Regarding the Article 8(4) ground, the GC annulled the BoA’s decision that the Notice of Opposition was inadmissible under Rule 15(2)(b)(iii)

*To find a likelihood of confusion with a family of earlier marks, the application must fit into the pattern of those marks*

of the Community Trade Mark Implementing Regulation (CTMIR). Debonair had based the opposition on non-registered marks used in the course of trade in the EU, whereas such a category of IP rights did not exist; non-registered trade marks are national rights and do not give EU-wide protection. The GC found that Debonair’s error did not render the opposition on Article 8(4) inadmissible in so far as the UK and Ireland were concerned. The letter accompanying the Notice of

Opposition had expressly cited the UK and Ireland, together with the opposition basis of passing off. The information provided had therefore made it possible to understand the nature of the earlier signs at issue, and what right those signs were supposed to grant Debonair. The action was dismissed for the remaining territories as they were not sufficiently specified.

The opposition has been sent back to the BoA to decide on the merits of the Article 8(4) ground.

## Primary points

There are two key points for trade mark practitioners to note from this decision:

- 1) To find a likelihood of confusion with a family of earlier marks, the application must fit into the pattern of those earlier marks.
- 2) When preparing a Notice of Opposition before OHIM, practitioners must ensure that the “EM” box is only ticked where they are relying on an earlier right that exists in the whole of the EU. Non-registered trade mark protection is a national right and the Member States must be selected individually.



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# No go for Golam

*Rupert Bent explains why confusion was considered likely by the Court*

In Golam v OHIM, the General Court found that there was a likelihood of confusion between the proposed Community Trade Mark, "Focus Extreme", and an earlier German registered mark, "FOCUS".

Ms Golam filed an application with OHIM on 11 March 2010 to register a Community Trade Mark (shown below) that featured a red star to the left of the word "FOCUS" in black text, and the word "extreme" placed at an angle in smaller, lower-case, red letters. The goods sought to be registered were in "clothing, shoes and headgear" in class 25.

On 19 October 2010, Derby Cycle Werke GmbH (the Intervener), filed a notice of opposition to the registration of Golam's mark. This was on the basis that it had already registered the word-only mark "FOCUS" in Germany, covering "clothing, footwear and headgear".

The Opposition Division found that, as the goods were identical and the marks were similar, this was likely to cause confusion, and rejected Golam's application. Golam's subsequent appeal to the OHIM Board of Appeal was also dismissed.

## General Court

Golam appealed the Board of Appeal's decision to the General Court, arguing that:

- 1) The goods were not identical. Golam claimed she would actually be selling "dietary supplements", despite attempting to register the mark for "clothing, footwear and headgear". The Court felt compelled to look instead at the list of goods as applied for.
- 2) Visually, the mark was not similar, as it contained a star and an extra word.

*The Opposition Division found that, as the goods were identical and the marks were similar, this was likely to cause confusion, and rejected Golam's application*

The Court was not convinced, finding the marks "similar to a degree above average".

- 3) Phonetically, the marks were not similar, as consumers would pronounce both of the words forming the application "Focus Extreme". Golam failed to provide any supporting evidence and the Court was persuaded by the suggestion of the Board of Appeal that, in practice, it was likely only "focus" would be pronounced.
- 4) She had received a declaration from the graphic artist that had designed the sign, that it was "original". The Court found this argument to be irrelevant.
- 5) She had "temporal priority" as she was applying for a Community Trade Mark

and the Intervener only had a German trade mark. The Court found that a proprietor of a mark in a Member State was entitled to oppose the registration.

- 6) The right of opposition had been exercised abusively and unlawfully by the Intervener. However, Golam failed to offer any evidence to support this and this argument was rejected.

The Court dismissed Golam's appeal, deciding that the similarities between the marks and the fact the goods covered were identical was likely to cause confusion to the German public. The Court found that, in assessing the likelihood of confusion, the Board of Appeal had been correct to assess the German public, as the earlier mark was German and Golam was seeking to register a Community Trade Mark.



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# Active ingredient

*The public’s knowledge was the key component in this case, reveals Nadine Archer*

**T**he European Union General Court (“the Court”) has annulled a Board of Appeal (“Board”) decision by finding OCTASA and PENTASA to be confusingly similar in respect of “preparations and substances for preventing and treating diseases and disorders of the gastro-intestinal tract” in class 5.

## Background

The application to register OCTASA was opposed by Ferring BV who owned several PENTASA national marks that designated various pharmaceutical uses in class 5. Despite finding Tillotts Pharma AG’s (“the Applicant”) request for proof of genuine use inadmissible, the Opposition Division rejected the opposition.

The Board held that “asa” was descriptive of mesalazine, also known as “5-aminosalicylic acid” and “5-ASA”, which is the active ingredient in the PENTASA product. In view of the descriptive character of the suffix “-asa”, the Board concluded there was no similarity between PENTASA and OCTASA.

## Court decision

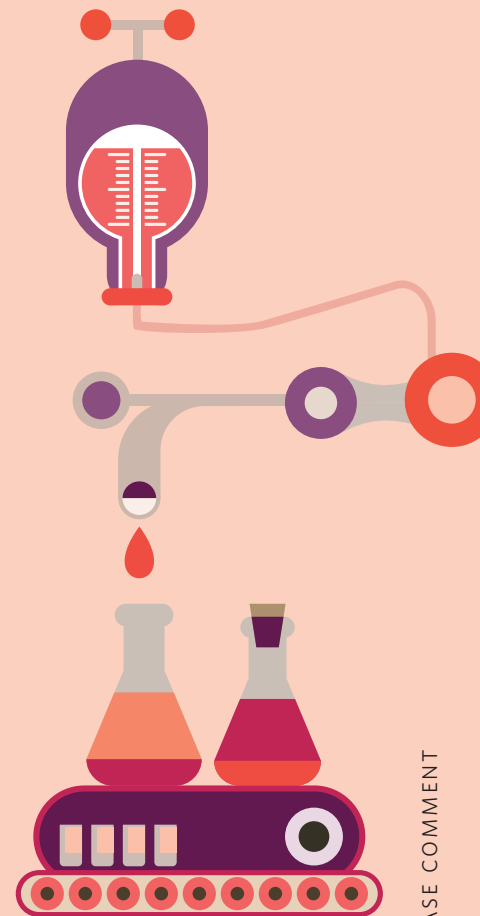
The Court held that the relevant public must be assessed by considering the products in respect of which the marks are registered, rather than the products for which the marks are actually used. The Board had wrongly limited its assessment to goods that contained mesalazine as the active ingredient and had, therefore, incorrectly based its decision on a relevant public that consisted solely of medical professionals. The Court found that

the relevant public consisted of both medical professionals and end users of preparations and substances for preventing and treating diseases and disorders of the gastro-intestinal tract in general.

No evidence had been submitted showing that end users were aware of the name 5-aminosalicylic acid or its acronym 5-ASA, or that such users associate those names with the active ingredient mesalazine. It could not, therefore, be established that the relevant public would immediately interpret, without further thought, the suffix “asa” as a description of the active ingredient.

OHIM relied on the judgment of 31 January 2013 in T-54/12, K2 Sports Europe v OHIM – Karhu Sport Iberica (SPORT), which discussed the descriptive nature of “sport”, to argue there was a “reasonable presumption” that the suffix “asa” was descriptive. However, the Court dismissed this argument because: “neither ‘asa’ nor 5-aminosalicylic acid nor 5-ASA is among the basic English words and expressions with which consumers not having a thorough knowledge of English are likely to be acquainted.”

By viewing the marks as a whole, the Court held that there was a visual and phonetic similarity owing to the common suffix “tasa”. The



Court also held that the Greek origin of “Oct” and “Pent” resulted in a weak conceptual similarity.

The Court, despite finding no evidence to suggest that “asa” was descriptive, ultimately decided it was unnecessary to come to its own conclusion on this issue given the similarity between the signs.

## Conclusion

This decision emphasises the importance of the relevant public when assessing the similarity between two marks. The distinction between the goods for which a mark is registered and the actual products on which the mark is used must be considered, particularly when pharmaceutical products are involved, as this could result in a drastic change in the make-up of the relevant public and the outcome of opposition proceedings.



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# Peace out

*An absence of evidence of confusion doesn't prove peaceful coexistence, says Carrie Bradley*

**T**his case concerned an appeal against UK IPO decision (O/070/12) in respect of the consolidated opposition and invalidation proceedings brought by Red Bull GmbH ("Red Bull") against Stute Nahrungsmittelwerke GmbH ("Stute") in respect of its "Red Z" (figurative) trade marks (examples shown below) that covered goods in class 32.

The Hearing Officer ("HO") had found in favour of Red Bull in respect of both matters, allowing both actions on the grounds of similarity with Red Bull's earlier word mark "RED-X" (UK Trade Mark Registration 2238189). Stute appealed on the grounds that (*inter alia*) the HO had failed to give any, or adequate, weight to the absence of evidence of confusion between the marks in making his assessment of the likelihood of confusion. In essence, its appeal called for a finding that Red Bull's objections should yield to the reality of "peaceful coexistence".

## Appeal findings

The Appointed Person ("AP") determined that it is clear from decided case law that:

- it is for the person relying upon an alleged coexistence of trade marks to prove that the consumers targeted are accustomed to seeing those marks without confusing them;
- absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark;
- the provisions in the legislation relating to infringement are not simply reflective of what is happening in the marketplace, rather they must also

consider notional use of the registered trade mark extended to the full possible width of the classification of goods and services; and

- when considering the weight to be attached to the absence of any evidence of actual confusion, it is relevant to consider what opportunity there has been for confusion to occur and to be detected.

With the burden of proof clearly resting on Stute's evidence of coexistence, the AP concluded that what had been put before the HO had been "too flimsy" and insufficient to establish evidence of peaceful coexistence such that it may counter his *prima facie* finding of a likelihood of confusion. As the HO had originally noted, the concurrent use of the respective marks had been relatively limited (both in terms of the period of time and the extent of use). As such, it was found that the capacity for confusion had not been adequately tested.

This case demonstrates that establishing a successful argument



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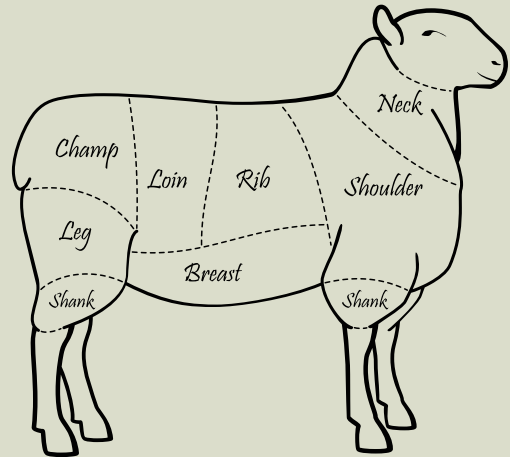
*Establishing a successful argument of peaceful coexistence carries a significant burden of proof upon the party who seeks to rely upon it*

of peaceful coexistence carries a significant burden of proof upon the party who seeks to rely upon it. The simple absence of evidence of confusion will not assist in and by itself, and the evidence of peaceful concurrent use adduced cannot be negligible. On the contrary, it would appear that such evidence would need to demonstrate a considerable duration and extent of side-by-side use to adequately test and overrule any notional risk of confusion.

It also reminds practitioners that, to bring a successful appeal, one must satisfy the AP that there has been an error of principle or a distinct and material error in the HO's decision. Appeals are not intended to offer a full re-hearing of a case, hence there must be a serious basis for an AP to interfere with the HO's finding on appeal.

# Cold case

*Gemma Kirkland examines the evidence in a geographic argument*



**T**his appeal demonstrates the difficulty of registering a geographic name without evidence of acquired distinctive character through use, where it is foreseeable that consumers may expect the name to be an indication of geographic origin of the goods.

Iceland Foods Limited (“IFL”) filed an application for the marks shown below, covering “meat, fish, poultry and game” (among others). The application was successfully opposed on the basis that ICELAND was descriptive under section 3(1)(c) of the Trade Marks Act 1994 (“TMA”), because it was foreseeable from the evidence that UK consumers may view ICELAND as a geographical indication for the goods in question. IFL appealed to the Appointed Person.

The Opponents introduced fresh evidence at the appeal, which enclosed documents regarding the import of meat, poultry and game from Iceland into the UK from 1990 to 2002. The evidence was directed towards the Hearing Officer’s difficulty in assessing the impact of Icelandic exports into the UK from the original evidence filed. The Appointed Person allowed the evidence as it was deemed crucial in clarifying the extent of Icelandic meat exports to the UK by the Opponents.

IFL claimed that the Hearing Officer had wrongly taken his own consciousness into account in holding that meat, poultry and game were goods that were often stamped with the name of the country from which

they originated, such that consumers in the UK would expect to be told the origin of these goods. The Appointed Person disagreed, and, following the decision in Marks & Spencer plc v Interflora Inc and another [2012] EWCA civ 1501, para 50, held that the Hearing Officer was entitled to rely on his own experience in his findings. The Hearing Officer had provided reasons for his belief that it was foreseeable that consumers may see ICELAND as a geographical name for meat, poultry and game, especially as it was not uncommon for meat products from other countries to be stamped with the name of the country from which they originated (eg New Zealand lamb). The Appointed Person held that it was reasonable to assume that, even if no association in the minds of consumers between Iceland and meat, poultry and game exist now, such an association may exist in the future, considering the characteristics of the country and the nature of the goods in question. Accordingly, the Hearing Officer was entitled to conclude, on the basis of the evidence submitted, that it was in the public interest to refuse the application for the contested goods,

a conclusion that was supported by the fresh evidence introduced by the Opponents on appeal. Accordingly, the appeal was unsuccessful.

## Think ahead

Arguably, the ICELAND name is known to a large proportion of UK consumers. If IFL had been able to show evidence of acquired distinctive character arising from use of ICELAND in the UK, the decision may well have been different. Brand owners looking to use geographical names as trade marks should keep any evidence showing an acquired distinctive character of their trade mark in case they should need to demonstrate this character in the future.



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# Five-year fallout

Time ran out on genuine use,  
as Emma Reeve reports

44

**F**urniture Village Limited (“FV”) held UK Trade Mark Registration 2401897 for FURNITURELAND in classes 20, 27 and 35. On 20 June 2011, Furnitureland.co.uk Limited (“FURL”) applied under section 46(1)(a) of the Trade Marks Act 1994 (“the Act”) for revocation of FURNITURELAND on the ground that there had been no genuine use for any of the goods or services for which it was registered during the five-year period ending at midnight on 10 March 2011, with effect from 11 March 2011.

FV admitted that there had been no genuine use of FURNITURELAND during the relevant five-year period for the class 27 goods, but maintained that there had been genuine use in respect of the goods and services in classes 20 and 35. FV did not raise a defence under section 46(1)(a) of the Act that there were proper reasons for any non-use during the relevant period and under section 46(3) of the Act that genuine use of the trade mark had

commenced or resumed after expiry of the relevant period.

The Hearing Officer concluded that FV had shown use of FURNITURELAND during the relevant period for a limited specification of goods and services.

## Evidence

FV asserted in evidence that it had used the trade mark FURNITURELAND and relied on an advertisement published in the *Daily Star* newspaper on Thursday 10 March 2011. No evidence of the advertisement appearing in any other publication or at any other time was provided. The evidence confirmed that the domain name [www.furnitureland.uk.com](http://www.furnitureland.uk.com) went live on 25 March 2011, of which no dates or figures were provided for any traffic to the website. Invoices were exhibited by FV showing marketing consultants’ fees between 28 March 2011 and 4 May 2011. Information was not provided as to actual deliveries of any items of furniture

into or out of stock at any warehouse used by FV. FV did not provide in evidence dates or figures of actual sales or supplies of any items of furniture by FV under the trade mark FURNITURELAND.

## The appeal

FURL appealed to the Appointed Person on the basis that the Hearing Officer was not open to finding that the evidence showed genuine use during the relevant period.

The Appeal decision focused on the evidence submitted by FV. Geoffrey Hobbs QC, hearing the appeal, stated that the Hearing Officer should have concluded:

- “i) that the advertisement published in the *Daily Star* newspaper on 10 March 2011 was an isolated announcement, ahead of effective implementation, for a website at [www.furnitureland.uk.com](http://www.furnitureland.uk.com) which was not said to have gone live before 25 March 2011;
- ii) that it could not be ascertained when or to what extent the website had actually been operated as an outlet

(or conduit to an outlet) for the supply of any particular goods identifiable as furniture, beds, mattresses, bedheads, bed bases, bed frames or bedsteads or for the supply of any service of bringing together any identifiable variety or varieties of goods for viewing or purchasing either in a retail store or by means of telecommunications; and iii) that it could not be ascertained when or to what extent the website had been operated as an outlet (or conduit to an outlet) for the supply of any such goods or service under or by reference to the trade mark FURNITURELAND used in accordance with its essential function...".

The evidence submitted by FV did not show genuine use of FURNITURELAND. When assessing genuine use, the Registrar must have regard to all the facts and circumstances as outlined at paragraph 29 of the judgment of the Court of Justice of the European Union in *C-149/11, Leno Merken BV v Hagelkruis Beheer BV* [2013] ETMR 16: "... regard must be had to all the facts and circumstances relevant to establishing whether there is real commercial exploitation of the mark in the course of trade, particularly the usages regarded as warranted in the economic sector concerned as a means of maintaining or creating market share for the goods or services protected by the mark, the nature of those goods or



## *This case reinforces the need for Trade Mark Attorneys to educate clients on how to use trade mark registrations to ensure that they do not risk losing their investment*

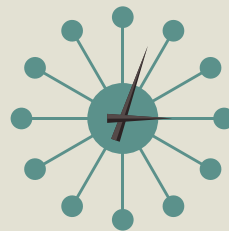
services, the characteristics of the market, and the scale and frequency of use of the mark."

Hobbs QC concluded that:

"the evidence on file in the present case simply did not establish that the single advertisement published in the *Daily Star*... pertained to any particular goods or services identified or identifiable as being at that time already marketed or about to be marketed under or by reference to the trade mark FURNITURELAND so as to constitute real commercial exploitation of the mark in the course of trade consistently with usages regarded as warranted in the economic sector concerned as a means of maintaining or creating market share."

### **Education needed**

The outcome of this case reinforces the need for Trade Mark Attorneys to educate their clients on how to use trade mark registrations to ensure that they do not risk losing their investment. Brand owners must be aware of the five-year non-use period and should maintain archives of relevant materials showing a real commercial exploitation of the mark in the course of trade and be ready to provide these materials as evidence when the need arises. By not educating brand owners, and by submitting immaterial information in proceedings, there may be cost implications.



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*Once again we are reminded that only an error can derail a Hearing Officer decision, writes Rob White*

**R**enault SAS recently failed in an appeal to the Appointed Person (“AP”) having lost its original opposition against a stylised mark for “masterPRO” (shown opposite), based on its earlier registration for MASTER for identical and similar goods.

The Applicant, Euro Car Parts (“Euro”) applied for the mark shown in respect of various vehicle-related goods in classes 8, 9 and 12, following which Renault opposed the application under section 5(2)(b) of the Trade Marks Act 1994 based on its MASTER registration for goods in classes 8 and 9 and *inter alia* in

respect of “land motor vehicles, motor cars for transport on land, their spare and/or replacement parts” in class 12.

#### **Earlier decision**

In the original decision – having made a visual, aural and conceptual comparison of the respective marks as required – the Hearing Officer (“HO”) rejected the opposition despite the existence of a moderate degree of similarity between some of the goods in classes 8 and 9, and identity of goods in class 12 coupled with “a moderately high degree of similarity between the marks”. However, the

dominant and distinctive element of Euro’s mark was stated by the HO as being the combination of the two words “master” and “PRO”, together with a device element. An assessment of the nature of the relevant public was also made where, for example, it was observed that the general public may not see certain products before they are fitted to vehicles and that, for most goods, the purchasing act would be “primarily visual”.

The HO also determined that the element “MASTER” had a low degree of distinctiveness and, despite the Opponent claiming an enhanced



distinctive character based on use, this was only found to exist in respect of “vans” from the evidence filed. Nevertheless, the HO went on to say that: “in the absence of evidence to the contrary, the earlier mark must be attributed with at least the minimum level of distinctiveness to satisfy the requirements for registration.”

On making an assessment based on the global appreciation test and rejecting the opposition, the HO found that no direct or indirect confusion would arise between the marks, notwithstanding the identical nature of certain goods, the moderately high degree of similarity between the marks and the risk of imperfect recollection.

Some practitioners may find this decision unexpected given the assessment made of the marks and the goods. It is perhaps no surprise, then, that Renault appealed to the AP.

Renault’s two main strands of criticism of the original decision in the notice of appeal were:

- 1) the HO misdirected herself when considering the nature and habits of the relevant public as she only considered purchasers of vans; and
- 2) in her assessment of the likelihood of confusion, the HO did not apply the conclusions reached elsewhere in the decision with consistency and thus the decision was “somewhat confused”.

The AP reiterated the standard position for appeals, which is that they are a review of the original decision and not a re-hearing and that there should be a “reluctance to interfere in the absence of a distinct and material error of principle” (REEF [2002] EWCA Civ 763 and *Ototoks Limited v Fine & Country Limited* [2013] EWCA Civ 672).

The first ground relating to the habits of the relevant public was dismissed by the AP who determined the HO had not made any unwarranted findings and that it was justified for her to rely on her own experience and knowledge to reach such conclusions. This common-sense approach has also been applied in recent decisions,

*With appeals, it is vital to remember the lesson that an error of law or legal principle must be shown to have occurred if any appeal is to succeed*

such as *Marks & Spencer plc v Interflora Inc* and another ([2012] EWCA Civ 1501). The HO had undertaken a review of all goods, considering their nature and the level of attention of the public for each of them, so there was no evidence that she confined her assessment only to van purchasers.

Under the second ground, Renault essentially argued that the HO had given “inadequate and improper value” to similarities – some high – that she had said existed between certain goods. The Opponent felt “an illogical conclusion” had been reached because, in its view, if there was both a moderately high degree of similarity between the marks and identity or moderate similarity of goods, a likelihood of confusion should be inevitable, resulting in a successful opposition.

### Salient statements

In the rejection of this ground, the AP made some statements that all practitioners should bear in mind when considering appealing a decision.

She stated that the Opponent’s apparent reason for raising this ground was that it essentially disagreed with the weight given by the HO to an element in the multifactorial assessment. The AP said “giving too much or too little weight to certain factors in the multifactorial assessment is not an error of principle warranting interference”.

The AP ruled that the HO had summarised her findings and taken all necessary factors into account in the required global assessment so was entitled to reach her conclusion. Therefore: “the fact that a different weight could have been given to certain factors in the multi-factorial global appreciation test does not provide the basis for an appeal in the absence of an error of principle.”

With appeals, it is vital to remember the lesson that an error of law or legal principle must be shown to have occurred if any appeal is to succeed. If the original decision followed and properly applied the correct tests, an appeal will likely fail. What will be required is to show something was taken into account by the HO that should not have been, that something was omitted from the global appreciation test, or perhaps that no reasonable HO would have arrived at the decision based on the facts and evidence provided.

It is also worth remembering that an appeal to the AP is final and so, strategically, it may be worth considering filing any appeal to the Court where further appeals are possible.



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Rob deals with all aspects of managing both local and global trade mark and domain name portfolios and design matters across many business sectors.

# A touch of class

*Services that appear in different classes aren't necessarily dissimilar, advises Kristina Passmore*

Professor Ruth Annand, sitting as the Appointed Person, has reminded us that for the purpose of section 5(2)(b) oppositions, services may not be considered dissimilar simply because they appear in different classes.

The Opponent was the large estate agency, Winkworth Franchising Limited, which was opposing an application to file the UK trade mark WINKWORTH INTERIORS. The Hearing Officer partially allowed the opposition in class 42, but the Opponent argued that the trade mark should also be refused in class 37 (construction and fit-out services). The Opponent's earlier mark was a UK trade mark WINKWORTH in classes 35, 36 (property management and rental of property and real estate services) and 42 (surveying services).

## Preliminary issue

A preliminary point regarding the grounds of appeal was dealt with first. The Applicant objected to the inclusion of a point in the Opponent's skeleton because it was not stated in the Opponent's statement of grounds.

The point was that the Hearing Officer should have extended her comparison of the Opponent's surveying services in class 42, not only to the Applicant's design and build services in class 42, but also to the Applicant's construction and fit-out services in class 37.

However, the Appointed Person held that it was sufficient that the statement of grounds included reasons why the Hearing Officer's decision in relation to the Applicant's class 37 services was wrong,

including the assertion that she was wrong in finding that the Applicant's services in class 37 were dissimilar to the Opponent's services (which would encompass class 42).

The Hearing Officer held that a statement of grounds of appeal need not contain the totality of an appellant's arguments, which is the role of the skeleton on appeal.

## The appeal

The crux of the Appeal was the Hearing Officer's determination in relation to the Applicant's class 37 services (that they were dissimilar to the Opponent's services).

The Hearing Officer held that the Opponent's surveying services in class 42 were similar to the Applicant's "design and build fit-out contractor services in the commercial property sector; planning of offices" also in class 42, because there would be an element of surveying in these services.

However, the Hearing Officer did not compare the Opponent's surveying services in class 42 with the Applicant's "construction services in relation to the fit-out of existing commercial buildings; office fit-out services" in class 37, but only compared the Opponent's class 36 services, which were considered dissimilar. The Opponent argued that the same logic followed here,

*The Hearing Officer held that a statement of grounds of appeal need not contain the totality of an appellant's arguments, which is the role of the skeleton on appeal*

that surveying services can also accompany actual construction works and the users can be the same.

The Appointed Person agreed that the Hearing Officer erred in this regard, although stated that it was not clear that the Hearing Officer's decision in relation to the Applicant's services in class 37 was motivated by "classification prejudice" (as the Opponent argued), rather than a mere oversight.

In reconsidering the opposition case in class 37, the Appointed Person found that there was some degree of similarity between the Opponent's surveying services and the Applicant's class 37 services. Therefore, the Appointed Person agreed that the application should be refused in its totality.

## Conclusion

Opponents and applicants must remember that all goods are capable of comparison, regardless of class, and that factors, such as whether the services are complementary and whether the users and providers can be the same, should be taken into account.



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Kristina advises on IP law, including trade marks, patents, domain names and copyright. She works on the enforcement and protection of IP rights by litigation.

# events

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

Date	Event	Location	CPD hours
21 July	<b>ITMA /CIPA CPD Webinar</b> Marketing Skills- Business Development Strategy, Bernard Savage, Size 10 ½ Boots		1
22 July	<b>ITMA London Evening Meeting*</b>	Royal College of Surgeons, London	1
23 July	<b>Trade Mark Administrators' Roundtable</b> The Role of Paralegals	Marks & Clerk LLP, London	
13 August	<b>Trade Mark Administrators' Roundtable</b> The Role of Paralegals	Barker Brettell LLP, Birmingham	1
3 September	<b>ITMA Talk in Edinburgh</b> Benefits of mediation in resolving IP disputes, Lindsay Low, The Scotch Whisky Association, and John Sturrock QC, Core Solutions Group	Brodies LLP, Edinburgh	1
12 September	<b>ITMA Seminar</b> Copyright: when to call for help and issues around providing it, Guy Tritton, Hogarth Chambers, and Nick Cunningham, Wragge & Co	Norton Rose Fulbright, London	2
23 September	<b>ITMA London Evening Meeting*</b>	Royal College of Surgeons, London	1
25 September	<b>ITMA Autumn Seminar*</b>	Hyatt Regency, Birmingham	5
28 October	<b>ITMA London Evening Meeting*</b>	Royal College of Surgeons, London	1
18 November	<b>ITMA London Evening Meeting*</b>	Royal College of Surgeons, London	1
20 November	<b>ITMA Talk in Glasgow</b> Assignments Tania Clark, Withers & Rogers LLP	Marks & Clerk LLP, Glasgow	1
9 December	<b>ITMA London Christmas Lunch**</b>	InterContinental Park Lane, London	



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**I worked as...** a Partner at Kilburn & Strode in the seven years before my retirement, dealing almost exclusively with trade mark work.

**Before this role...** I was involved in both patent and trade mark work – over the course of a 43-year working life. For the first 25 years I did mainly patent work, then, for 10 years, worked as a solicitor in a City law firm, where I litigated the first case under section 10(6) of the Trade Marks Act 1994.

**My current state of mind is...** relaxed! I still maintain an interest in all IP matters, but my main focus is my family: two married children and five gorgeous grandchildren. Very stimulating; for instance, when my six-year-old granddaughter reacts to one of my jokes by asking: “Granddad, why is that funny?” Obviously she has a future as a critic.

**I became interested in IP when...** I was heading for a rather indifferent degree in Physics and a university careers adviser thought IP would suit me. I had no idea what that entailed, but in desperation I thought I’d give it a whirl. I left uni with an exam-phobic mindset, but after a few months as an IP trainee I realised I liked it even with the prospect of hard exams ahead.

**I am most inspired by...** fairness, helpfulness, social justice and the struggle against all discrimination.

**In my role, I most enjoyed...** the incredible camaraderie of all branches of the profession.



*Sunshine and big smiles feature in the highlights from Honorary Member Tibor Gold*

**I most disliked...** arguing with non-paying or slow-paying clients.

**On my desk is...** a lovely new edition of Amanda Michaels’ and Andrew Norris’ fifth edition of *A Practical Approach to Trade Mark Law* to review.

**My favourite mug says...** “I am allergic to mornings”, as “thought” by Snoopy, but it’s tied for first place with one that represents my fanatic love of West Ham United and has a picture of my idol Bobby Moore (shows my age).

**My favourite place to visit on business is...** Los Angeles. I have

good friends there, it is very varied and cosmopolitan with lots to do (if you know where to look) and in parts surprisingly walkable.

**If I were a trade mark or brand, I would be...** a smiley icon – I’d love to convey an aura of good feeling.

**The biggest challenge for IP is...** to remove patent and trade mark thickets; in other words, to stop the “gaming” of the systems.

**The talent I wish I had is...** to sing well and/or to play music with others.

**I can’t live without...** family and friends, “moistened” with red wine.

**My ideal day would include...** sunshine, family, friends and a good book.

**When I want to relax I...** combine my previous two answers.

**In my pocket is...** a hanky and my iPhone.

**The best piece of advice I’ve been given is...** to think before speaking.

**In the next five years, I hope to...** survive in reasonable health to watch my grandchildren grow up.

**The best thing about being an ITMA member is...** the camaraderie.

*If you are an ITMA member interested in taking part in the TM20, contact [caitlin@thinkpublishing.co.uk](mailto:caitlin@thinkpublishing.co.uk)*

# Hostile work environment?







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If any of these positions appeal or you would just like to have an informal chat you can call us on +44 20 7903 5019 or email: [contact@fellowsandassociates.com](mailto:contact@fellowsandassociates.com). Pete Fellows and Philippa Field are looking forward to your call.

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### Qualified Trade Mark Attorney – Scotland

To assist with our client's expansion plan, we are looking for an individual with business development skills who has the potential to capitalise on a rare opportunity in the industry. The ability to communicate efficiently and effectively with colleagues, a commercial approach and genuine flair are all essential. A generous salary and benefits are on offer.

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