

CITMA REVIEW

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A stylized illustration of a cyclist from behind, standing on a path next to a lake. The cyclist is wearing a red and black jersey, black shorts, and a red helmet. The bicycle is red with a black pannier bag on the rear rack. The background features a sunset sky with orange and yellow tones, a bird in flight, and a landscape with green hills, a forest of dark green trees, and a body of water reflecting the sky. The overall style is flat and geometric.

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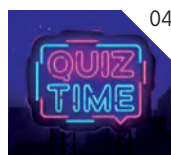


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PRESIDENT'S WELCOME**WE HOPE TO SEE YOU AT OUR SUMMER RECEPTION**

Although you will be reading this in late June, I am writing this welcome not long after my return from the 2022 INTA Annual Meeting in Washington, DC.

It was great to see the UK trade mark profession so well represented at the event. In particular, it was a pleasure to spend time with some of our international members and the rest of the global IP community.

We also had the opportunity to meet with the UK IPO, reaffirming our close working relationship and discussing the key issues facing our industry.

I am looking forward to seeing as many of you as possible at our upcoming Summer Reception, taking place in the Inner Temple Gardens on 5th July. This event has not been able to take place in person for a couple of years, and it will be a great chance to relax and enjoy the summer weather with your colleagues.

The event incorporates the inaugural Sheila Lesley Lecture, which is named for our first female President, who passed away in 2019 and who generously remembered CITMA in her will. The reception will also offer me the opportunity to address you for the first time in my role as President, and to set out my aspirations for my term in this position.

We hope that this invitation to gather as a profession and to embrace the learning and networking available to us will be one you don't want to miss.

Rachel Wilkinson-Duffy,
CITMA President



Gowling pulls off quiz ambush

The return of the CITMA quiz following a two-year hiatus saw our members flex their general knowledge to the limit, with 144 quizzers taking part in the event, making up 26 teams.

In total, the event raised nearly £2,700. The winning team, Ambushed By Cake from Gowling WLG, scored a total of 109 points. The team's chosen cause, The Brain Tumour Charity, will receive half of the money raised. The other half will go to the CITMA Benevolent Fund.

CITMA quiz top scorers:

1. Ambushed By Cake (Gowling IP) – 109
2. Bulgaria (Beck Greener) – 105.5
3. This Isn't a Pub Quiz – It's a Business Meeting with Wine and Cheese (Fieldfisher) – 100.5
4. Fellowship of the Quiz (Fieldfisher) – 100
- =5. It's IP to be 5 New Square (5 New Square) – 96;
Troyd & Tested (Murgitroyd) – 96

For further news about the event, visit citma.org.uk/citmaquiz



WE'RE CELEBRATING SUMMER

Our Summer Reception is just around the corner, on 5th July. Find out more at citma.org.uk/events

TEST YOUR OWN WITS

How well would you have done on these quiz questions our teams tackled on the night?

1. In April the Electoral Commission began an investigation into the refurbishment of Prime Minister Boris Johnson's flat. How much per roll was paid for the new wallpaper in the flat (to the nearest £200)?
2. Which form of gymnastics, involving a ball and hoop and a ribbon, became an Olympic sport in 1984?
3. In which fictional US town is the film *It's a Wonderful Life* set?
4. Which Prime Minister was born in 1916 and died in 2005? His "longest sulk in history" came after he won the Sydney to Hobart Yacht Race in 1969.
5. In which decade was the British monarch's Christmas address first broadcast on television?



SURVEY EARNS CHARITY SUPPORT

As a result of our policy of donating a pound for every person who completes our membership survey, our members have raised £438 for mental health charity Jonathan's Voice. This represents more than a quarter of our members supporting the cause. Visit citma.org.uk/surveyfunds



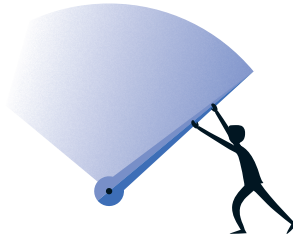
LAWCARE EXTENDS CHAT SERVICE

LawCare has expanded its online chat service, so that help is available from Monday to Thursday, 9am–5pm. The increase in service (from one day a week) will make it more accessible to legal professionals. The new service will be staffed in part by 10 trained volunteers. Visit citma.org.uk/lawcarechat



CHILE JOINS MADRID PROTOCOL

The Madrid Protocol will enter into force for the Republic of Chile on 4th July 2022, with the country having deposited its instruments of accession on 4th April 2022. The announcement follows a process of modernising IP law in Chile to create a more efficient and effective system. Find out more at citma.org.uk/chilemadrid



YOU CAN'T HURRY CHANGE

Lord Chris Smith explains why areas like CPD don't lend themselves to easy answers

When I arrived as Chair of IPReg – now, unbelievably, some three years ago – I realised very quickly that one of the things we needed to do in order to become a modern, professional, efficient regulator that attorneys would welcome being regulated by was to undertake a wide-ranging review of our regulatory rules, guidance notes and requirements. There were too many overlaps and uncertainties, too many rules that had been maintained without anyone really thinking about their impact; too many points where greater clarity was required. So, we set about undertaking precisely such a review. This has been a main focus of IPReg's work over the past year and will be so for the year ahead.

We have recently been consulting our registered attorneys – plus, of course, CITMA, CIPA and other representative bodies – to obtain their views, opinions and ideas, as well as responses to our initial proposals. We will spend the next few months sifting through and analysing all of those thoughts before putting together definitive proposals for further dissemination and then consideration by the Legal Services Board (LSB).

One of the lessons you learn quite rapidly in the field of legal regulation is that you can't (and

shouldn't) effect change in a hurry. You need to bring everyone with you when making change.

One of the areas we are taking a particularly hard look at – and where there are no easy answers – is the question of continuing professional development (CPD). CPD is an essential mechanism

“

If we can get CPD right for the IP sector, that might be more widely applicable too

for keeping attorneys up to speed with current issues, decisions and challenges. It's particularly important if someone has taken a period of time away from day-to-day work in the profession. But how do we ensure that CPD gets done in

a meaningful, engaging way that will have real impact, and not turn into a box-ticking exercise?

How might we, for example, introduce an element of peer review into the CPD accreditation process? Perhaps a record of casework which could truly reflect the extent and nature of the work undertaken. Other ideas, I'm sure, will emerge, but we are very keen to hear from a wide range of people about how we might think about improving the rules. The LSB is also keen to encourage thinking about how CPD regulation can be improved. If we can get it right for the IP sector – or at least get it working better – that might be more widely applicable too.

CPD isn't the only area we are turning our attention to, of course, but it's one of the most important. What I'm fervently hoping will emerge from the whole review is a set of rules and procedures that are clear, fit for purpose and which command wide support. Not a bad goal to aim for, I think.



The Rt Hon the Lord Smith of Finsbury
Chair of IPReg

Sustainable growth through your Intellectual Property

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business success.**

“I ALWAYS KNEW I DIDN'T FIT IN THE WORLD IN A WAY THAT WAS EXPECTED”

Al Skilton explains why even the smallest acknowledgement can make a difference to a non-binary person

I was born in 1972 and grew up in the 1980s, which was not a very tolerant period for LGBT+ people. I always knew that I didn't fit in the world in a way that was expected, and given that I was always attracted to women, I came out as gay to my best friend at the age of 13. I knew my issues were gender-based, but there were no role models and there was no language that fitted how I felt. When I finally heard the non-binary definition in 2018, I suddenly realised, aged 46, that they were talking about me.

We all have many different strands to our identity, which make us who we are. Here's a good starting point: **Gender identity** – how you, in your head, experience and define your gender, based on how you align or don't align with what you understand the options for gender to be.

Attraction (sexuality) – how you find yourself drawn (or not) to others (often categorised with gender).

Sex – the physical traits you are born with, as well as the sex you are assigned at birth.

Gender expression – how you present gender (through your actions, clothing and demeanour, to



give a few examples) and how those expressions are viewed based on social norms.

Non-binary people can identify with various degrees of masculinity and femininity, androgynously, or may have no gender at all. Gender is made up of two key parts: how a person feels inside (their gender identity) and how they show this (their gender expression). These are both distinct from biological sex, which is assigned at birth.

While the term “trans” encompasses people whose gender is not the same as, or does not sit comfortably with, the sex they were assigned at birth, some non-binary people don’t see themselves as trans. It’s always important to respect the language someone uses to define themselves.

“ As I near my 50th birthday, I can honestly say that I am happy where I am now

I identify as non-binary, but I’m not necessarily trans. In the true sense of the definition, I am trans, to the extent that my gender identity is not the same as the one I was assigned with at birth. My gender identity is 50/50 male/female and I am perfectly happy with that. For other non-binary people, the experience can be very different. It is a spectrum. People can be anywhere on that spectrum.

An understanding of these scales can really help when it comes to understanding someone’s identity, and that will help us all to be more tolerant. The most important thing is to listen and respect the way in which people identify themselves.

WHY AM I TELLING YOU THIS?

I’m telling you this because non-binary people are often ignored in the world in which we live. If not ignored, then we are criticised or (my particular favourite) told we don’t exist. A common myth is that identifying as non-binary is somehow “attention-seeking”. The number of transgender hate crimes recorded by police in England and Wales numbered more than 2,600 in 2020/21. Is this really the kind of attention anyone would seek?

I am lucky enough to be the co-chair of an LGBT+ network group which is passionate about changing lives for the better, and this is within an organisation – the UK IPO – which really values difference and which strives to create an environment where people can bring their whole selves to work. This is important, because to really respect one another, it is clearly important that we all understand one another.

In the last ten years, the IPO has introduced a transitioning policy, has an ongoing programme to increase the number of gender-neutral facilities, and has changed the language it uses in policy documents. It is now in the process of assessing all correspondence and guidance to identify language that needs to be made gender-neutral. Most of the time, using non-binary language isn’t difficult. Indeed, we do it by default if we don’t know someone’s identity, eg “They have left their bag on the chair”.

GUIDANCE IS AVAILABLE

The UK’s Office of the Parliamentary Counsel and the Government Legal Department have been promoting the use of gender-neutral drafting for UK statutes and statutory instruments for many years. Both believe there is no reason why gender-neutral drafting cannot become the norm across the profession. They have

HOW TO SUPPORT TRANS AND NON-BINARY COLLEAGUES

- Use the name a person asks you to use. Try not to make assumptions about a person’s gender.
- Include your own pronouns in email signatures. This makes it easier to have conversations on this subject.
- If you’re not sure what pronouns someone uses, ask.
- Advocate for non-binary-friendly policies. It’s important for non-binary people to be able to live, dress and have their gender respected at work, at school and in public.
- Avoid binary language where it isn’t necessary. For instance, say “Good evening everyone”, rather than “Good evening ladies and gentlemen”.
- Use inclusive language in documents.

produced a guide (available at interlawdiversityforum.org) which distils years of work and is well worth a read.

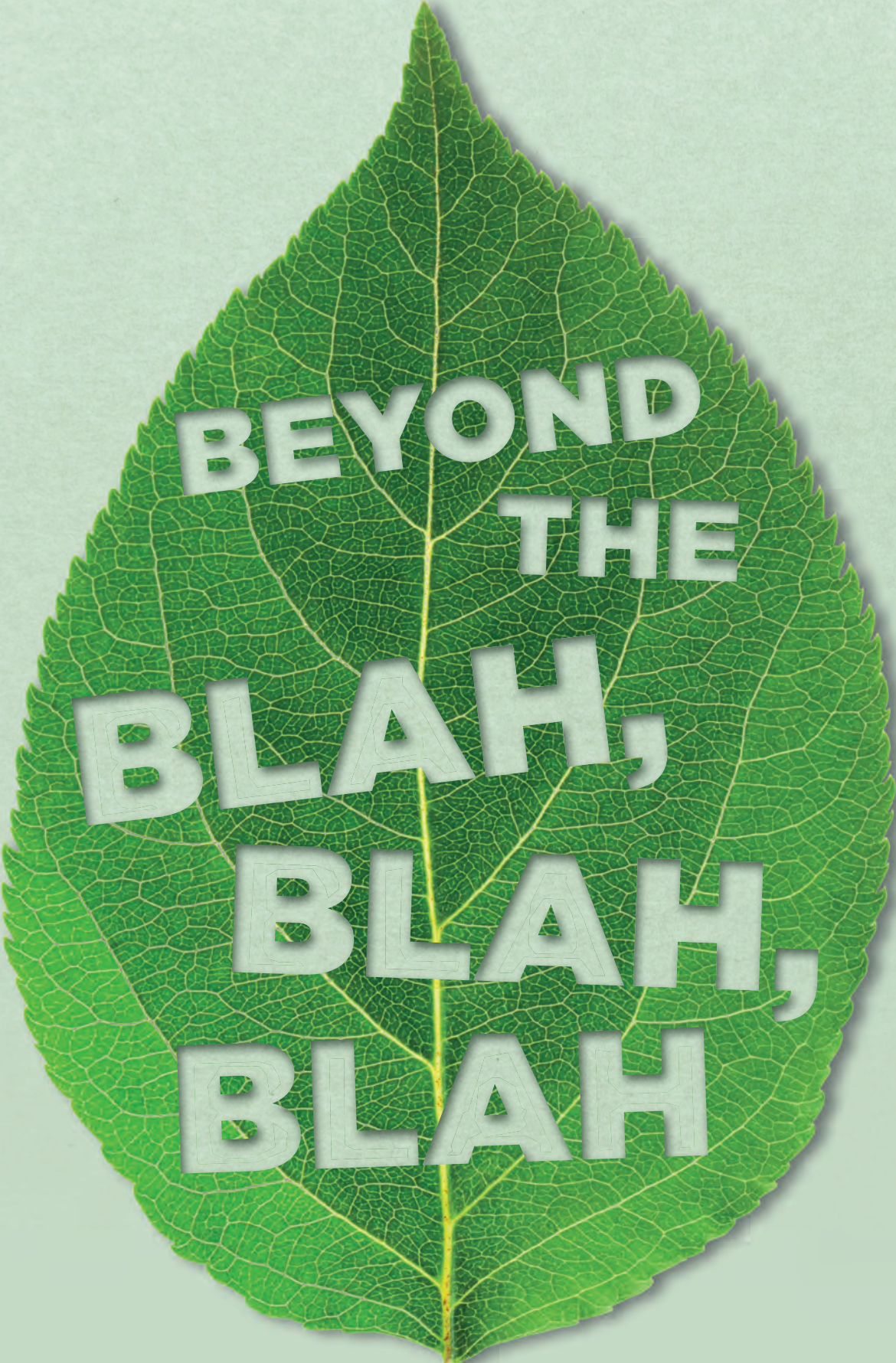
As I near my 50th birthday, I can honestly say that I am happy where I am now. I wish I could have shown my younger self a brief glimpse into the future. I hope that by talking about these issues around International Non-Binary People’s Day, others with similar experiences may realise they are not alone, and still others may think again about their assumptions. I hope that my perspective as a non-binary person and my professional role mean that I am well placed to show others in IP some simple ways to demonstrate support. You wouldn’t believe how the smallest acknowledgement, such as using someone’s pronouns, can make a difference to them. ●



Al Skilton

is a Senior Hearing Officer at the UK IPO and Chair of the iPride LGBT+ network

14th July 2022 is International Non-Binary People’s Day 2022.
Perspective articles represent only the views of the author.



**BEYOND
THE
BLAH,
BLAH,
BLAH**

Plenty of businesses are issuing fighting words about fighting climate change – but which firms in the legal sector are actually walking the walk?

“Build back better: blah, blah, blah. Green economy: blah, blah, blah. Net zero by 2050: blah, blah, blah,” chided the climate activist Greta Thunberg at the UN’s Youth4Climate summit in Milan last September. “This is all we hear from our so-called leaders: words that sound great but so far have not led to action.”

Thunberg’s mocking tone signalled a deep exasperation with the state of human progress on our climate challenges, and research indicates that her dismay was well founded. In March, the Independent Energy Agency reported that in 2021, global CO₂ emissions surged to their highest ever level, hitting 36.3 billion tonnes. Although renewable power had enjoyed its strongest ever year of growth, increased coal use driven by a spike in gas prices outplayed it.

With all that in mind, it is hard to think what individual industries can do to face down this daunting trend. But in the UK legal sector, firms are taking the need for action seriously – and backing up their commitments with tangible deeds.

SHARED KNOWLEDGE

At the London headquarters of Charles Russell Speechlys (CRS), Partner David Berry has played a leading role in shaping the firm’s sustainability strategy, a task which began in 2017. That year, Berry established an internal taskforce to tackle environmental matters, dubbed “E-Force”. It was comprised, he says: “Not of environmental lawyers, but of volunteers from across the firm with a passion for this area.”

Initially, Berry explains, E-Force attacked low-hanging fruit by massively increasing recycling facilities, putting these within

easy reach of desks, banishing plasticised cups and switching to compostable containers for canteen food. However, the firm wasn’t yet equipped to calculate its carbon footprint or the impact of its initiatives. It contacted the Legal Sustainability Alliance (LSA) for help.

“That enabled us to find out what other law firms, bigger and smaller, were up to,” Berry says. “In our competitive environment, firms tend to be quite tight on information. But in this domain, refreshingly, there’s a lot of transparency and willingness to share our experiences around various problems and challenges.”

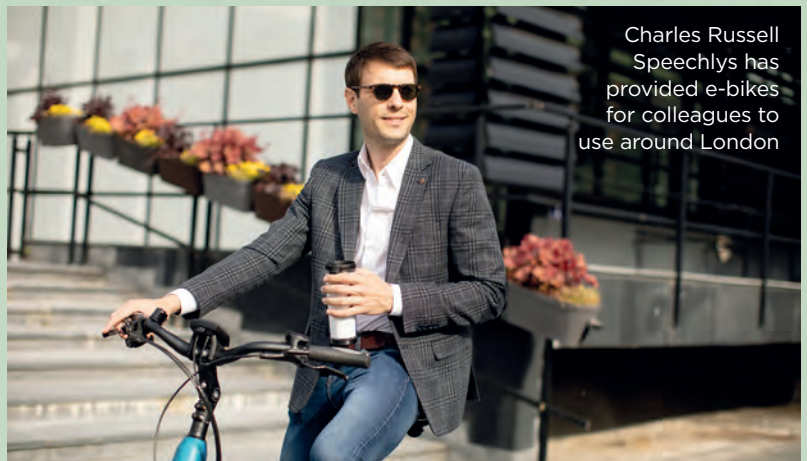
CRS eventually became an executive partner of the LSA,

“Trying to cut corners or failing to take these efforts seriously would be a huge mistake

which involves contributing to its funding. Berry says its “small but high-quality team has helped us learn a great deal about how to move forward”.

When COVID-19 struck, CRS used an employee survey to assess the carbon footprint of its locked-down workforce. “By having an unoccupied office,” Berry says, “we exported energy usage to people’s homes – but it was still part of our carbon footprint.” That measurement is now being expanded to cover employees’ commutes, and the London HQ is now equipped with e-bikes which staff can use for local journeys to client meetings. The firm is now using 100% renewable energy suppliers for its UK offices. It is also working towards a target of being net zero by 2030. “That’s very ambitious and challenging,” Berry admits. “But we think it’s achievable.”

To administrate and measure such initiatives, Berry recommends that a firm in the early days of its sustainability drive should develop an Environmental Management System. That will enable partners to review data on at least a quarterly basis to determine whether they are on track to meet their targets. He also highlights the value of expert consultants. “They will help you to avoid greenwashing,” he says. Brands risk being hugely chastised if they get that wrong. So, he says, “trying to cut corners or failing to take these efforts seriously would be a huge mistake.” ▶



Charles Russell Speechlys has provided e-bikes for colleagues to use around London



EFFICIENCY MEASURES

Another firm which has benefited from external guidance is Appleyard Lees, which last year was certified a CarbonNeutral® company. The accreditation shows that the firm has adhered to the CarbonNeutral Protocol to establish a clear, credible and transparent track record of relevant action. To achieve neutrality, the firm partnered with Natural Capital Partners, who devised and maintain the Protocol. Meanwhile, to annually evaluate its carbon footprint, the firm has teamed up with third-party carbon management specialists RSK.

Partner David Walsh has led the project, together with Trainee Patent Attorney Emily Bevan-Smith, who says: “We started by calculating our carbon footprint and our impact on the environment. This involved measuring our output by examining emission sources associated with our operations, including employee commuting, electricity usage, business travel, water consumption and waste, all in accordance with the GHG Protocol Corporate Standard.”

Bevan-Smith explains that the firm’s goal “is to reduce our carbon footprint to zero by implementing in-house efficiency measures. We are also exploring ways we can reduce our impact, such as by using renewable energy sources.” In parallel, she notes, the firm is looking outside itself: “To offset any emissions which we can’t reduce internally, we’re providing critical finance for external emission reduction projects which deliver positive environmental impacts and which align with our charitable mission to support organisations that create or enable innovation that makes life better.”

The firm is currently supporting three external projects, two of which are related to reforestation or rainforest conservation and providing sustainable livelihoods (in East Africa and Brazil respectively), and one (in India) which uses solar technology to meet energy needs and promote low-carbon development.

Each project’s emission reductions have been independently



External projects supported by Appleyard Lees around the world include solar farms and local community projects

verified, enabling Appleyard Lees not only to offset future emissions, but also to immediately reduce its carbon output via the solar project. In turn, local communities benefit from training in renewable energy technology, access to energy for low-income households, less air pollution, the conservation of biodiversity and better crop yields.

ETHICS ON THE AGENDA

Bates Wells has proudly put ethics at the top of its agenda for more than half a century. In that spirit, the firm announced in 2015 that it had become a B Corporation, or “B Corp”, joining a global list of, at that point, 1,400 companies pledging to uphold high ethical standards across a range of areas, including sustainability. Today, there are more than 5,000 registered B Corps globally. Bates Wells was the first UK law firm to earn that certification – and is now one of just two B Corps in the entire domestic legal sector.

“If you look at our history,” says Partner and Head of Trade Marks Mathew Healey, “B Corp status was a natural step in our continuity as a firm. For example, in 2003, our then Senior Partner, the late Stephen Lloyd, fought the Charity Commission to ensure that it would register the Environment Foundation as a charity. That produced the UK’s first legal ruling that recognised



sustainable development as a charitable activity.”

However, “it’s not just about sustainability,” notes Bates Wells’ Purpose and Impact Manager Angela Monaghan. “It’s about social justice, diversity and inclusion, and how you conduct yourself within your community; as in, the environmental community in the places where you work, as well as your own particular web of business partnerships.”

Bates Wells was directly involved with bringing the B Corp stamp to British shores, via partners who sit on the UK board of the standard’s awarding body, B Lab. Monaghan explains: “Those partners came back to the firm and said, ‘This is such a great fit for our values – we have to be the first UK law firm to do this.’ Given the history and nature of our business, we didn’t have to operate any differently to be registered – if anything, the stamp cemented our desire to retain values we already had.” That said, she stresses: “It’s not easy. The first requirement of B Corp status is to continuously strive to improve, which means that it gets continuously harder



as you go along. But it provides an external mechanism for checking what constitutes best practice now in relation to what it may become, and for considering how you may get from here to there.”

FIRM COMMITMENTS

As part of that drive, Bates Wells made the decision in 2019 to formally recognise the climate and biodiversity crisis within the DNA of its business model – a step the firm took in consultation with internal stakeholders. “We looked at the facts and said, ‘We acknowledge that there’s an emergency. Now we want to be held accountable for our actions in regards to that,’” Monaghan explains. “As such, we established six commitments that we promised to follow to ensure that we would not play a role in exacerbating the crisis through our own actions.”

The first of these commitments was to achieve net zero by the end of 2019. Bates Wells achieved that on schedule. Other commitments were to: (1) take the climate crisis into account while developing the firm’s business strategy; (2) use the law as a means of addressing the emergency; (3) engage the firm’s people in any decisions related to the firm’s impact on the crisis; (4) encourage staff to live in an environmentally friendly way, and (5) collaborate with others to amplify the firm’s positive environmental impacts.

In terms of how it has answered point 3, Monaghan notes: “One example is the support our lawyers provided to charities involved in the recent case *Butler-Sloss and Others v The Charity Commission*, in which two charities had sought the ability to take environmental protections into account when investing their reserve funds.” The outcome provided stakeholders with much-needed clarity on the issue.

Turning to point 5, she says: “We have a sustainable pension that everyone can invest in. We also share resources and information and give our people tools to enable them to make changes at home. So, if you’ve switched to a verified sustainable energy supplier, we will give you a one-off payment to help you meet any additional costs.”

Monaghan adds: “We’re eager for other law firms to come along with ourselves and Radiant Law, which is currently the UK’s only other law-firm B Corp. In a way, it does us a disservice to be the only

“ There’s an emergency. Now we want to be held accountable for our actions in regards to that

two out here. We’re often compared, like apples and pears, to firms who are perhaps talking about these things more than they are actually doing them. We want to see a more environmentally conscious and just transition, supported by as much of the industry as possible.”

COLLECTIVE MOMENTUM

In the interests of galvanising its own and our members’ approach to climate change, CITMA has joined and is currently receiving input from Climate Action for Associations (CAFA). This advisory group takes a whole-sector approach to devising and implementing climate-friendly solutions and initiatives. CAFA aims to decant its knowledge throughout entire industries by supporting professional bodies and industry associations, which can then pass on the relevant know-how to their member organisations.

“It’s a really simple idea,” says CAFA Co-Executive Director Alison Heppenstall. “If we can encourage membership bodies to convene and rally, and to accelerate action across the industries they represent, we will be able to drive much more momentum and generate far greater change at a faster rate. And so far, so good.”

CAFA’s resources are heavily weighted towards application, not just theory. “There’s enough science to convey the meaning and importance of taking action,” Heppenstall says, “but not so much that it would confuse the reader. We have guides, templates and toolkits – for example, a Climate Action Plan and a seven-step Roadmap for Change. There’s a carbon calculator, which will shortly be reissued with much more interactivity. We have a range of policy templates which organisations can use to instil behavioural change, plus how-to guides in the form of checklists and step-by-step methodologies for cutting emissions.”

She adds: “As we see the emergence of organisational standards and compliance around climate change and sustainability, the legal sector will be under increasing scrutiny to ensure that it is leading by example.” ●



FACING THE MUSIC

Allister McManus gives a hearing to some music-related cases which offer important lessons for IP practitioners

The start of a solo artist or musical group's career (and the camaraderie and excitement that goes along with that) has a tendency to cloud good business sense, particularly regarding IP. During those formative moments, the main focus is on getting a record deal, writing and recording music, and promoting this precious product to the masses, not to mention trusting management to "sort it all out".

This has inevitably led to a rich seam of music-related disputes, some of which offer important lessons for artists and IP/legal practitioners. This article will examine a selection

of these, which encompass not just trade marks but also delve into copyright and contract law. It will also discuss relevant aspects of US law, as the author has been fortunate enough to be able to call upon the insight of US attorney David Perry, a Partner at Blank Rome LLP.

LEGAL HAZE

A series of disputes that deserve a generous amount of detail relates to legendary guitarist Jimi Hendrix, who seems to have signed some questionable contracts back in the day. This made his legal affairs more a case of "peace, love and misunderstanding". The resulting legal mess which followed his

untimely passing in 1970 included an ongoing lawsuit filed against him by his music publisher PPX. Hendrix's legal woes and the loss of control over his back catalogue resulted in the release of recordings of dubious quality for many years after his death, threatening his musical legacy and brand.

Enter Experience Hendrix (EH), successor in title to Hendrix's estate. At first, this was administered by Hendrix's father, James 'Al' Hendrix, along with the family attorney, and later an LLC formed by James Hendrix and his daughter Janie. The family eventually gained full control of Hendrix's affairs in 1995, after pursuing protracted litigation in

Seattle against the family lawyer and former companies involved in the estate's administration.

EH has wasted no time with a clean-up operation since taking over. This has included pursuing PPX for breach of a 1973 settlement agreement, which Hendrix would probably have seen as karma at its best. Most importantly, EH set about restoring the quality, accuracy and consistency of Hendrix's back catalogue by signing with Universal/Sony. It has issued well-received posthumous albums of unreleased material, such as the successful *First Rays of the New Rising Sun*, and substantially shored up trademark protection.

The EH website summarises the organisation's intent well: "Experience Hendrix is the official family company charged with managing the name, likeness, image and 100% of the music of Jimi Hendrix's legacy... Sister firm Authentic Hendrix LLC manages the name, likeness and image of Jimi Hendrix and oversees the licensing and development of new merchandise opportunities".

As to why it took the family so long to regain control of Hendrix's estate and establish the LLC, CEO Janie Hendrix explains: "It took us two and a half years. Prior to that, we never thought we were out of control. We thought that our attorney had our best interests at heart and that he was handling it in our best interests."¹

The EH website provides everything from "Quick-Link License Request Downloads" to permission forms to reprint any portion of Jimi Hendrix's lyrics. The site makes it clear that those wishing to be involved with Hendrix products should play by the rules.

When asked about musical licence and master recording requests which EH receives for soundtracks, movies, television usage and DVD products, Janie Hendrix confirms that the estate gets around 25 such requests a week, not all of which are approved. She says that the first soundtrack usage EH ever approved was the Nicolas Cage and Meg Ryan film *City Of Angels* in 1998. This turned out to be a smart move, as the soundtrack achieved quadruple platinum status

Hendrix's re-releases now come via his estate



and brought Jimi Hendrix's music to a wider audience.

From the start, EH has sought to expand the business to include affiliated companies dealing with specific aspects of Jimi Hendrix's music. A good example is its offshoot, Dagger Records, which handles high-quality bootlegs, acquiring tapes of whole concerts or jams. It advertises releases which are "restored from original tapes, remastered to the highest industry standards...". This canny arrangement reduces EH's issue with bootleggers and offers releases that can only be found on the Dagger Records website and in its catalogue.

The EXPERIENCE HENDRIX and later AUTHENTIC HENDRIX word and device marks, which feature on

an official and high-quality Jimi Hendrix product.

As for strategy, EH has filed for protection of the EXPERIENCE HENDRIX mark in numerous territories since at least 1997, including marks for JIMI HENDRIX and variations, notably the stylised signature mark (shown overleaf). What's more, EH has demonstrated a consistent approach to trademark protection and expanding its portfolio, with new applications filed as recently as July 2021.

The estate has also shown no fear in resolving, pre-emptively issuing and defending legal proceedings concerning everything from trademark issues to breach of contract suits and royalty claims, to ensure that Jimi Hendrix's former business dealings do not unfairly exploit his legacy and value.

For example, in 1973 and before the family took over control as EH LLC, the estate settled the ongoing proceedings issued by Jimi Hendrix's previous publisher PPX against him for breach of an agreement dated 15th October 1965.² The agreement committed Jimi to "produce and play and/or sing exclusively" for PPX for three years from that date. In addition: "He was to make his services available at PPX's request with a minimum of 10 days' notice to produce no more than four titles per session, with a minimum of three sessions per year." He would receive in return the nominal sum of US\$1, plus "1% of the retail selling price of all records sold for his production efforts". PPX had the right to

“Hendrix's estate has shown no fear in pre-emptively issuing and defending legal proceedings

all physical albums, DVDs/Blu-rays and digital releases, are great examples of how trade marks can facilitate trust between consumers and the sellers of products they purchase. These marks have, since the late '90s, provided fans with confidence that they are purchasing

Hendrix at the famous
Isle of Wight Festival
in 1970



Selected Hendrix marks

UK trade marks nos. 2509594,
904798526, 908198400, 911816485



UK trade mark no. 902960938



UK trade marks nos. 2509592 &
902963239, 908300733, 904798724



UK trade mark no. 913608567
VOODOO CHILD

UK trade mark no. 917877398
PURPLE HAZE

UK trade mark no. 917877399
ARE YOU EXPERIENCED

UK trade mark no. 917877401
FOXLEY LADY

UK trade mark no. 3671085
JIMI HENDRIX MUSIC ACADEMY

reimburse itself from first profits for “all cost of studio, musicians, etc”.

Hendrix argued at the time that the agreement was invalid because it was harsh and unconscionable and/or an unreasonable restraint of trade. The settlement finally reached and incorporated in a court order on 7th March 1973 provided that PPX was entitled to the masters of some of Hendrix’s recordings listed in Schedule A of the settlement agreement, provided PPX paid royalties to EH.

However, in 1995 and 1999, PPX granted licences to masters not listed in Schedule A. EH sued for breach of the original agreement and unpaid royalties. This then led to an appeal filed by EH, which raised an interesting principle of English law on whether a court can and should order the recovery of damages or an account of profits where it is difficult to prove financial loss. This was because there was no indication as to what retail sales these licences led to, or what royalties were earned by PPX under them. EH admitted that it had no evidence, nor could it ever get any, to show or quantify the financial loss suffered as a result of PPX’s breaches.

In its judgment, the Court of Appeal decided that it was appropriate to grant an order “requiring PPX to account to [EH LLC] in accordance with... the settlement agreement”. There had, the Court of Appeal said, been “a deliberate breach by PPX of its contractual obligations for its own reward”.

EH recently found itself back in the news in January this year, in a dispute with the estates of Hendrix’s former bandmates Noel Redding and Mitch Mitchell – bassist and drummer for The Jimi Hendrix Experience respectively – regarding claims for

historic royalties. The dispute started when EH’s label Sony received a letter in December 2021 from UK attorney Lawrence Abramson, representing Redding and Mitchell’s estates. The letter claimed that the label and EH owed them royalties for some 3 billion streams of The Jimi Hendrix Experience’s material, suggesting that the amount for “such streaming figures and sales is estimated to be in the millions of pounds”.³

In a rapid response, EH and Sony filed a pre-emptive suit in the US District Court for the Southern District of New York. This was filed on the basis that “[the Mitchell and Redding estates’] threats of suit have created a real and reasonable apprehension of liability on the part of [the Hendrix estate and Sony Music].” EH claims that Redding and Mitchell signed agreements in the early ’70s which released the Hendrix estate from legal claims, while also agreeing not to sue the estate in the future. According to EH, Redding and Mitchell were compensated for signing, and the agreements remain valid.

On the basis of the activities we’ve summarised, EH arguably sets the benchmark for how the estates of artists should operate. To put it bluntly, you don’t want to mess with this family. Indeed, the primary lesson is to have your business and legal affairs in order from the start. Of course, this was easier said than done in the ’60s and ’70s, when the music industry and its approach to contract negotiations were very different than they are today.

In the event that things are left in a mess, an estate and its lawyers should waste no time in beefing up trade mark protection, disposing of legal issues where possible, and forming a robust marketing, IP protection and enforcement strategy. Decide on how you want to present and protect the artist’s legacy and associated IP rights, and consider EH’s approach to be the model answer.

SEMI-CHARMED RIGHTS

The Californian pop rock band Third Eye Blind, known for its catchy ’90s rock anthem “Semi-Charmed Life”, has been involved in numerous court cases in the US. These tend

to involve claims from disgruntled ex-band members about ownership of the group, finances, royalties, songwriting credits and trade mark disputes, usually targeting frontman Stephan Jenkins.

Apparently quite the shrewd businessman, Jenkins first found himself sued by the band's original guitarist Kevin Cadogan following the latter's unpleasant split from the band in June 2000. Cadogan filed a multi-million-dollar lawsuit against the band and its management, claiming fraud, wrongful termination and breach of contract.

Cadogan shared songwriting credits with Jenkins on 16 of the 27 songs on the band's first two albums, including the hit "Semi-Charmed Life". He claimed that he was fired without warning because he refused to agree to a deal that would have included a US\$1m advance to record an EP and start an Elektra Records imprint. To make matters worse, after the band's gig at the Sundance Film Festival in January 2000, Cadogan claimed he was left stranded in Utah and stuck with a hotel bill, while the rest of the band raced off to perform on a late-night talk show with Cadogan's replacement.

Cadogan and the band finally reached a settlement in June 2002, for an undisclosed (but probably eye-watering) amount, just before trial began in the US District Court in Oakland, California.

Cadogan later claimed in interviews that Jenkins had set up the Third Eye Blind corporate entity predominantly in his favour and that it was not the partnership he thought it to be: "I was leveraged out of the group because I wanted shares to be given to the rest of the band members, not just to one guy."

Unfortunately, Third Eye Blind's relationship with Cadogan's replacement, Tony Fredianelli, also fizzled out in around 2009. He filed proceedings against Jenkins and the

band in 2011 for, among other things, unpaid touring funds, songwriting credits and royalties, in a trial which revealed some harsh realities about interband politics.

In 2013, a court in California dismissed the majority of his claims but awarded Fredianelli US\$447,329 in unpaid touring revenue (minus US\$9,256 for making personal charges on the band's credit card). The Court rejected most of his breach of contract, partnership and royalties claims, finding no admissible evidence of the consent of the other band members to enter into a co-ownership agreement.

As the owner of three US trade mark registrations for THIRD EYE BLIND (nos. 3714056, 3714057, 3608823) and one for "3eb" (no. 88452720) in classes 9, 16, 25 and 41, Jenkins issued cease and desist letters in 2016 alleging trade mark infringement by former members Cadogan and Aaron Salazar. The pair had been performing Third Eye

and partnership, it is important to maintain a cohesive approach among band members and ensure that you have an understanding of company law and ownership when forming a band. Attorneys should advise clients to create a legal document that clearly sets out the rules in the event that members depart or the band breaks up.

LES PAUL IS MORE

Another fascinating case involves an interesting point of US trade mark law relating to infringement in the context of the relevant consumer and degree of attention. It particularly demonstrates how finely balanced trade mark law is for 3D/shape marks. In 2001, luxury guitar brand Paul Reed Smith (PRS Guitars), which has been endorsed by the likes of Carlos Santana, released its single-cut guitar model, which arguably resembled the traditional Gibson Les Paul.

Subsequently, Gibson Guitar Corporation filed trade mark

“ Third Eye Blind’s saga demonstrates the difficulties that bands can face with differing personalities and opinions



American rockers
Third Eye Blind

Blind songs together and had mentioned being former members in show listings. Jenkins and Third Eye Blind successfully convinced ticket service Eventbrite to

remove all mentions of the mark THIRD

EYE BLIND from the Cadogan-Salazar event listings. Cadogan called the cease and desist letter to Eventbrite an extension of Jenkins' harassment. Most recently, in 2019, Cadogan filed proceedings for disputed royalties following the band's anniversary deluxe re-release of its debut album.

This saga demonstrates the difficulties that bands can face with differing personalities and opinions, especially when it comes to business decisions. Like any corporate entity

infringement proceedings against Paul Reed Smith on the grounds that the model infringed Gibson's US trade mark registration no. 1782606 for its Les Paul single cut-away guitar. At first instance, a Federal District Court ruled that the PRS Singlecut was an imitation of the Gibson Les Paul and granted Gibson injunctive relief.⁴ This required PRS to cease manufacturing of that model by the end of 2004.

PRS appealed, and in 2005 the US Court of Appeals for the Sixth Circuit reversed the decision and dismissed Gibson's suit and injunction, allowing PRS to resume production.

The Court of Appeal's decision was primarily based on the understanding that guitar-buying consumers are acutely aware of various guitar brands, used to imitations and not easily confused when making a purchase, particularly at PRS and Gibson's retail prices. It is a classic example of the importance of the degree of attention and the relevant



PRS Guitars' 2018 Graveyard II Limited

consumer in trade mark disputes, and the difficulty in enforcing shape marks. It also demonstrates the need for a manufacturer to form a view on whether a new product will infringe before starting production, as an injunction will cause substantial financial loss.

BAD BLOOD

The savviest of all the subjects in this article is surely Taylor Swift, who was denied the music artist's copyright Holy Grail of owning her own master recordings after her previous label, Nashville-based Big Machine Records, was bought by media proprietor Scooter Braun. As part of the sale, Braun owned all of the master recordings, music videos and promotional artistic works owned by Big Machine, including Swift's first six studio recordings and related content. Braun later sold Swift's masters and related works to investment firm Shamrock Holdings for US\$300m, on the condition that he would continue to earn revenue from the works.

Swift has claimed that she tried to buy the masters for years, but Big Machine had offered unreasonable conditions, which the label denies. Swift was also unhappy with the sale to Shamrock Holdings and turned down its offer of an equity partnership. The dispute reached boiling point after Swift alleged that Big Machine had prevented her from using her older material for the 2020 Netflix documentary *Miss Americana* and added insult to injury in the same year by releasing "Live from Clear Channel Stripped 2008" without Swift's approval.

Swift took the audacious decision to gain ownership of her first six

“ Swift’s bold action has earned many supporters in the music business ”

recorded works by re-recording them – essentially creating new masters. Swift has distinguished the new releases as “Taylor’s Version” and sweetened the deal for fans by ensuring that each release includes a second “side” of rarities relating to that album cycle.

Despite Scooter Braun’s complaints about being villainised in the press, Swift’s bold action has earned many supporters in the music business. The move has, so far, proved to be a resounding success, with the first two “Taylor’s Version” album releases, *Fearless* and *RED*, topping the album and singles charts. Many radio stations replaced the original recordings with “Taylor’s Version”, giving Swift all of the radio spins. Clearly, the music-buying public wants Swift to reap the rewards.

It’s hard not to see echoes of Experience Hendrix LLC in Swift’s desire to control her copyright and musical legacy, and there is much to admire in her innovative approach. As for lessons, while it can be difficult to negotiate at the start of a career when an artist lacks star power, an

agreement which allows an artist a reasonable opportunity to buy their masters, or which grants the label a limited term in which to exploit the works, should be the ultimate goal.

A LADY A DISPUTE

Bringing us up to date is a recent US trade mark dispute featuring country music band Lady A, when changing its name from Lady Antebellum.

The band had decided to change its name over the perceived link between the word “Antebellum” and slavery, but it faced a dispute with blues singer Anita White, who has performed as Lady A since the 1980s. White argued that the band was trying to “erase” her as Lady A. The band’s transformation therefore hit a stumbling block, with White asserting herself as the senior user of the mark and criticising the band for rebranding without contacting her.

However, in a motion filed in Nashville in February 2022, the parties asked the court to dismiss their lawsuits and reached an undisclosed settlement. The terms of their agreement, including who can continue to use the name, have not been made public.

It would be easy to say that this dispute highlights the importance of carrying out thorough pre-filing register and common searches, but it’s difficult to be overly critical of Lady A, the members of which found themselves caught between a rock and a hard place. Trade mark merits aside, it highlights a tricky scenario of cultural shifts and the unexpected need to course-correct, despite the ramifications such a move can have where a senior user emerges. ●

1. Interview with Janie Hendrix, see bit.ly/3MqT9e6
2. [2003] EWCA Civ 323, *Experience Hendrix LLC v PPX Enterprises Inc*
3. [2022] *Experience Hendrix LLC v Noel Redding Estate et al*, see bit.ly/3NrI8d0
4. [2004] *Gibson Guitar Corp v Paul Reed Smith Guitars*, see bit.ly/3zighso



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A young boy with brown hair and freckles is looking up at a red apple balanced on a tree branch. An arrow with blue and red fletching is stuck through the apple. The background is a lush green forest with sunlight filtering through the leaves.

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WHAT'S IN A WITNESS STATEMENT?

Denise McFarland provides a survey of best practice when it comes to preparation

January 2021 saw the introduction of CPR Practice Direction 57AC, which applies to witness statements for trials in the Business and Property Courts (BPC) which were signed after 6th April 2021. Although we are already more than a year beyond that date, the implications of the practice direction (PD) are, perhaps, not as widely understood as the judiciary would like. In several recent cases, judges have stressed the importance of using the Statement of Best Practice (contained in the Appendix to the PD) as a basis on which to ensure compliance with the new PD, noting that there can be “little excuse for lack of awareness of the PD and its applications”. All practitioners, parties and those involved in the litigation process are “urged to read” the PD and the Statement.

COMPLIANCE GUIDANCE

The PD was the product of the work done by the specially convened “Witness Evidence Working Party” and is intended to improve the quality of witness statements and to reduce their associated costs. The PD is currently limited to the BPC and witness statements for trial, but practitioners are already (and sensibly in my view) adopting this best practice for all witness statements, whether for interim hearings, oppositions or to support other applications.

Sir Michael Burton concluded that the new PD had not changed the law concerning the admissibility of evidence – see *MAD Atelier International BV v Manes*.¹ However, a couple of recent cases have gone further, and are well worth review and consideration, as they provide much more detailed guidance about compliance and the effects of non-compliance.

The first case is *Mansion Place Ltd v Fox Industrial Services Ltd*², in which Mrs Justice O’Farrell summarised the background to the new PD and what it means in practical terms. In so doing, she affirmed Sir Michael Burton’s statement as to admissibility in *MAD* and expressed concern at the possibility of costly satellite litigation arising from disputes over compliance with PD 57AC.

She expressly encouraged parties to find a more efficient and cost-effective way to deal with such disputes.

O’Farrell J also explained that the purpose of the PD was to: “eradicate the improper use of witness statements as vehicles for narrative, commentary and argument”. She stated that the Statement of Best Practice should be followed by “anyone involved in producing” witness statements, and it should be considered a “checklist” by Parties.

In relation to non-compliant witness statements, while the Court retains its full range of sanctions, the PD particularly notes that there may be a resultant strike-out of the whole or part of the witness statements, and/or wholesale withdrawal of permission to rely on it (or them). If re-drafting is required, adverse costs sanctions are an obvious likely effect. The Court may also strike out for non-compliance a statement which is not properly endorsed with a “certificate of compliance” – a new requirement – and effectively ensuring that the Party preparing the statement and wishing to rely on it should ensure its form and content are appropriate and compliant (see PD 57AC, Para 5).

In *Blue Manchester Ltd v Bug-Alu Technic GMBH*, His Honour Judge Stephen Davies, sitting as a judge of the High Court, noted that the



requirements of the PD ought not to be “onerous” and that the Court should take a “realistic approach” to issues of compliance.³ He refused to strike out witness statements for non-compliance with the PD, but he ordered the statements to be redrafted in a number of important respects, in order to comply with the requirements.

The judge further expressed the hope that as PD 57AC becomes more familiar and the principles become clearer, “such heavily contested, time-consuming and expensive applications become the exception rather than the norm”. He added that “parties who indulge in unnecessary trench warfare in such cases can expect to be criticised and penalised in costs”.

His judgment contains many helpful guiding points. These include a reminder that the statement must be written in the first person. He also notes that if multiple witnesses use identical language across their respective statements, it is no excuse or justification to say that this is explicable since a single person took lead responsibility for their preparation. He also stressed the importance of use of a witness’s own wording and phrasing. And he notes that on “important disputed matters of fact, a trial witness should, if practicable: (1) state in the witness’s own words how well they recall the

matters addressed; [and] (2) state whether, and if so how and when, the witness’s recollection in relation to those matters has been refreshed by reference to documents, identifying those documents.”

If a witness considers that it is impracticable to comply with the requirements relating to important disputed matters of fact, they must justify why that is the case.

RELEVANT REFERENCES ONLY

In terms of substantive content, the judge confirmed that the statement should only contain reference to documents where they are “relevant and reference is necessary”, and that lawyers had to be “prised away from the comfort blanket of feeling the necessity of having a witness confirm a thread of correspondence”.

Further particular points to note from the decision include the fact that the judge rejected statements that were surrogate skeletons or submissions. He didn’t accept that even where there is a witness against whom allegations are

made, whether in a professional negligence action or otherwise, then that witness is, in effect, “given carte blanche to disregard PD 32 or PD 57AC by replying to the allegations in a way which includes argument, comment, opinion and/or extensive reference to, or quotation from, documents”.

Parties have many available means to counter such allegations: via their pleadings, skeleton arguments, opening and closing submissions, and in some cases expert evidence or additional material derived from the documents. In short, there is no justification for the trial witness statements to respond to the allegations other than in compliance with PD 32 and PD 57AC.

In summary, this author agrees with the judiciary that a good look at the PD is best practice. If you haven’t already done so, now’s the time to get reading. ●

1. [2021] EWHC 1899 (Comm)
2. [2021] EWHC 2747 (TCC)
3. [2021] EWHC 3095 (TCC)



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OUT OF OFFICE



We asked a selection of CITMA members to let us in on what they get up to in their off-work hours. Here's what they told us about the things that bring them balance



THE CYCLIST

Chris Hoole

I rode at a club level as a junior, but my interest in cycling waned slightly during my university years. In the late 1990s and early 2000s, competitive cycling was still relatively niche, lacking sufficient popularity for the smallest of university clubs, even in what is now regarded as the UK's cycling centre, Leeds.

Fast-forward to 2014. Leeds had just hosted the Tour de France Grand Depart, and cycling fever was raging through the UK. That same year, I was introduced to a local, growing cycling club, Alba Rosa. Having had a longstanding itch to race at senior level, in just a few months I moved from competitive commuter to obsessive, amateur racer.

A year later, I joined Appleyard Lees. I soon learnt that the firm had a strong contingent of runners and cyclists, and that it embraced and encouraged active and competitive sport. It's a good fit: one key advantage of cycling is the ability to train around work. Commuting to and from the office made up a large part of my training, with evening and weekend rides providing just enough hours to reach Category 2 level. After several years, finally competing with a breakaway club which we called "FTR", I finally ended my racing 'career'. Although training seven to nine hours a week allowed me to maintain a reasonable fitness, I had found myself competing against younger cyclists who were averaging double the training hours.

Fortunately, I was able to combine my passion for cycling with business. In mid-2015, I participated in my first business networking ride. It was evidently "the new golf", but

the rides were still organised like weekend sportives, with fluctuating hilly courses, causing large groups to fracture and little opportunity to talk on the bike. Later that year, with the firm's support, we organised our first networking ride, AL Velo, with entry fees going towards our designated charity. Taking on board my experience of group riding, we organised small groups of similar speeds, over a flat route north of Leeds. The event was a success, growing year on year, with around 80 riders attending in 2019. After a short break due to COVID-19, we will be back this year, hosting the AL Velo ride in Cambridge, five years after we opened an office in the region. Having moved to Cambridge

myself just a few years ago, I've embraced the local cycling community, participating in weekly time trials through Cambridge Cycling Club. Appleyard Lees is also

proud to sponsor Cambridge University Cycling club this year, providing support to young talent in what is a now very competitive university league.

For me, cycling is a way of maintaining an important balance with the stresses of work and life, and I'm fortunate that it fits around my day. I have a short, 20-minute commute to the office, which takes me through local meadows and past picture-postcard university grounds, but that's long enough to help me arrive refreshed and ready for the day ahead.

- **Chris Hoole is a Chartered Trade Mark Attorney and a Partner at Appleyard Lees**

“
*I've embraced
the local cycling
community and the
weekly time trials*”



THE PILOT

Darren Olivier

My flying journey started three years ago, when our family decided to school our children in Grahamstown, some 900km and typically a 10-hour drive from our home in Johannesburg. Getting there by plane would save several hours, make financial sense (almost) and be a lot more fun than driving or flying commercially. And, as my daughter said, “YOLO – you only live once”.

Since then, given COVID-19 and the opportunity to work remotely, we have moved to Grahamstown and I commute to Johannesburg for work. I now have my private pilot’s licence (PPL), which means that when the stars align (ie, there’s good weather and no time-sensitive meetings) I can fly myself to the office.

Getting a PPL can take four to six months full time, but for a person in their late 40s with work and family commitments, such an expectation must be managed. You’re required to have at least 45 hours of flying time, as well as to have completed 18 air exercises – including scary things (for me anyway) like stalls, spins and steep turns. You also have to sit eight exams on everything flying-related, from aircraft engines, weather and flying principles to understanding the basic human disposition to err (which is the closest the course came to trade mark concepts – that of imperfect recollection). I am still a novice pilot, so my focus now is on building up my hours, because with that comes safety. I hope to get at least 75 hours flying per year, because then it starts to make more financial sense and, of course, staying competent is part of being a safe pilot.

My team at Adams & Adams have known about my flying since

my journey began and have been very supportive. They have lived through stories of my terrors of landing and going solo for the first time – even an engine failure after take-off! The rigour, discipline and checks in flying are useful in my daily work, so, if I have brought any part of flying to the work I do, I hope it is that.

When you’ve been filing trade marks and living in law firms for 25 years, learning something completely new is beneficial in so many ways, and I enjoy all of that. Flying is as exhilarating as it can be downright scary. My instructor was in her early twenties, and the planes I trained on were older than me. Trusting her was significantly easier than trusting those planes, but both were excellent. I certainly learnt humility and patience.

Going forward, I hope to immerse flying into my daily work, not just as a potential commute, but as a way of promoting IP and innovation in Africa. As some wise chap is reported to have said: “Once you have tasted flight, you will forever walk the earth with your eyes turned skyward, for there you have been, and there you will always long to return.”

- Darren Olivier is a Partner and Attorney at Adams & Adams, and a frequent blogger for Afro-IP



Cows compete for the runway at Grahamstown airfield

THE DJ

Chris Hawkes

I’ve always had an interest in music and musical instruments. From around the age of six, I was taught to play the keyboard. When I moved up to secondary school, I started taking lessons at a local music studio and went on to learn how to sequence and remix music – in particular, dance music.

In my mid-teens, I was asked to play music at some private parties. My sister was also dating a DJ who ran his own club nights. I loved the idea of playing music that moved me and seeing other people move to that same music. I decided I needed some turntables. Once I got hold of some, I was hooked; I spent about three months in my bedroom perfecting my beat matching and mixing technique, before a chance meeting led to an opportunity to DJ on local radio. I used to cycle down with a box of 80 vinyl records on either side of my handlebars! Around the same time, I taught some friends to DJ and we ended up playing regularly at two clubs in my hometown before we were even 18.

Once I made it to university, my DJing had really started to take off. I was playing up to six nights a week – local clubs, for national event brands and even secret, invite-only raves. I was at the forefront of dance music and rubbing shoulders with some pioneers of the time.

Ultimately, despite being offered some very tempting opportunities which would have allowed me to further my career in music, I decided to focus on pursuing a career in law. But music wasn’t done with me yet!

I have ended up getting involved in lots of work in the music industry, as well as music industry initiatives. I’ve also had some fantastic cases for clients whose names I used to see on record sleeves. I’ve acted for hip-hop royalty, Motown masters, rock legends and some of the freshest dance-music



artists in the world today. I have enjoyed a residency at INTA, playing the GLINTA parties in support of the Trevor Project. It's funny how often I've made connections with trade mark colleagues who approach me thinking I'm "the DJ", only to learn that I could also advise on their trade mark strategies.

Music equals life for me. I met my wife when I was DJing, and I have a lot to thank music for. I've met lifelong friends through the scene. And I've also been able to help a lot of people, especially through teaching music production and DJing. In one case, a friend attributed it to having saved him when he was at his lowest ebb. I'm happiest when music is on and around me. To be able to bring that happiness to other people is an incredible feeling.

Sadly, COVID shut down the music industry in a big way and it has been a struggle to get back. During that time I also became a dad, and so hung up my headphones for a while. But I have built a small studio in my garden and got back into writing music, which is what led me to get into DJing in the first place. As the world is getting back on its feet, the phone is ringing again and I'm being asked to work with and run nights all over the country. I'm looking forward to being back out on the scene.

-
Chris Hawkes is an IA Director at Stobbs IP

THE GUITARIST

Sharon Daboul

I have been interested in guitars since I was around eight years old, when my father bought me a classical one from the Argos catalogue. I went on to take lessons in piano and violin, but I started teaching myself electric guitar when I was 14. It was the mid-90s, and guitar-based music was really popular. I was keen to play the songs I was listening to on the radio.

I started collecting guitars in earnest around 20 years ago, when I realised that I wanted instruments which would lend themselves to different sounds. I had always had a Stratocaster, which has single-coil pickups, but now I wanted something with "humbuckers" (guitar pickups which produce a heavier sound).

I also upgrade guitars in my spare time, and I find it's a good way to try out different instruments. I currently have around 14 guitars, but I have had up to around 20 in my collection at any one time. I keep a record of each one, and 46 guitars have passed through my hands at the time of writing.

I have also learned how to set up guitars to a professional level. This is all about making fine adjustments such as to the height of the strings and the curvature of the neck to tailor an instrument to your liking. During the COVID-19 lockdown period, I was able to devote a couple

of hours a week to working on my guitars. I even set up a soldering station in the shed. I taught myself how to use a soldering iron, replaced some of the electronics in my guitars and built a few effects pedals and speakers too.

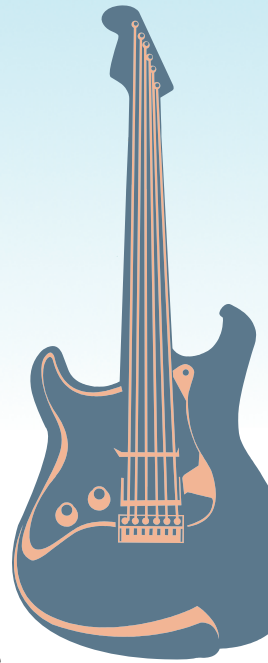
I have also written and recorded an album of music with a friend, and I am constantly working on my playing ability. I now spend a larger proportion of my spare time practising and learning new songs. I try to allocate around 10 minutes each day, and I find that if I can make those first 10 minutes happen, I usually have more time available.

My ultimate goal is to build a complete guitar from start to finish. I have already built an electric slide guitar using an old cigar box, and it was a good exercise in problem-solving, as I encountered a number of hurdles along the way.

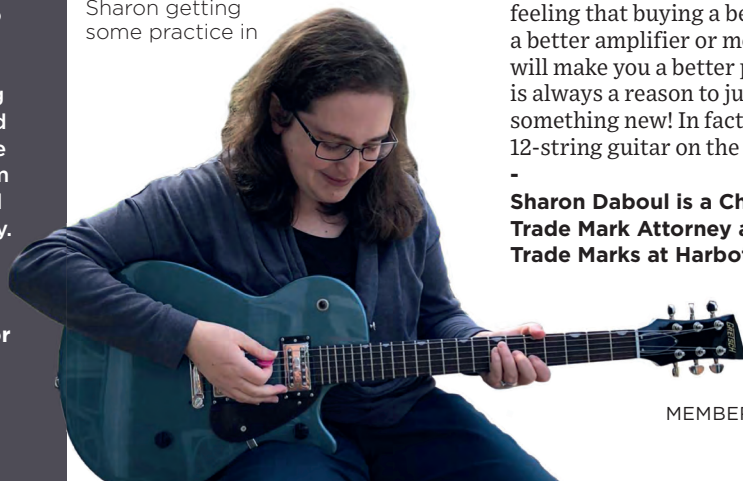
Many of my colleagues know about my hobby. I'm in the newly reformed Harbottle & Lewis band, and we were about to start regular rehearsals with a view to playing a live concert just before the first lockdown.

Gear Acquisition Syndrome (or GAS) is a phenomenon that can affect guitarists. Essentially, it's a feeling that buying a better guitar, a better amplifier or more pedals will make you a better player. There is always a reason to justify buying something new! In fact, I have a new 12-string guitar on the way.

-
Sharon Daboul is a Chartered Trade Mark Attorney and Head of Trade Marks at Harbottle & Lewis



Sharon getting some practice in



Something to wine about



Joseph Letang warns against claiming rights in descriptive terms

The High Court has recently dismissed an appeal by Wineapp Ltd following a failed opposition at the UK IPO, which sought to prevent a mark's registration under s5(4)(a) of the Trade Marks Act 1994 on the grounds of passing off. The case serves as a warning against claiming rights in descriptive terms.

Mr Johnson (the Applicant) applied to register the trade mark "winesapp" plus device (shown opposite) in the UK on 26th September 2019 for "sommelier services" in class 43. Wineapp Ltd (the Opponent) filed an opposition to this application in December 2019, claiming that its unregistered sign ("wineapp" plus device, also shown opposite) had been used since November 2018 throughout the UK.

“ Small differences can be sufficient to avert confusion where a mark is mainly descriptive ”

OPPOSITION BACKGROUND

Before the UK IPO, the Opponent submitted witness statements and exhibits as evidence that its unregistered trade mark possessed sufficient goodwill to suggest passing off on the part of the Applicant. The Opponent claimed that its mark had been used since November 2018, specifying further that such use was in relation to "wines, live sommelier chat, wine selection, wine advisory services, wine algorithmic recommendations, wine

consumer/community reviews and wine delivery services, all via an app". The Opponent referred to turnover of £1.9m since the start of the mark's use, advertising expenditure of £302,000, and approximately 160,000 app downloads on iOS and Android devices up to July 2020. The Opponent's evidence included, but was not limited to, copies of confirmation emails sent to customers bearing the Opponent's mark; screenshots from the Opponent's social media platforms showing use of the mark; and features and reviews from a few media outlets and websites. The evidence showed that the Opponent's main business was wine, including by the bottle, for speedy home delivery in London. Notably, there was no consumer evidence suggesting that actual and potential customers might associate the Opponent's business with the Applicant's mark.

The Applicant filed a witness statement and a single exhibit, and claimed that the greater proportion of the Opponent's sales were made following the filing of the application in September 2019. The exhibit presented by the Applicant included a screenshot from the Wine and Spirits Trade Association website, showing that the UK wine market was valued at £10.6bn in 2018. In the evidence in reply, the Opponent submitted a revision to the evidence that was previously given to include only business activity that took place in the 10 months prior to the relevant date, including revising the quoted turnover figure from £1.9m to just over £165,000 (around 30,000 bottles of wine) and the number of app downloads to around 33,000.

“ The Opponent’s failure to submit any consumer evidence was inevitably going to jeopardise its prospects

THE OPPOSITION - DECISION

As the Applicant had not used his mark prior to submitting the application, the Hearing Officer (HO) confirmed that the relevant date for assessing whether s5(4)(a) applied was the application date of 26th September 2019.

The HO went on to mention the three-step test to reach a finding of passing off, as laid out in *Reckitt & Colman v Borden*.¹ Then, applying *Lumos Skincare Ltd v Sweet Squared Ltd* and others², the HO found that the Opponent’s mark had established a “small, but not trivial” level of goodwill at the relevant date in relation to the goods and services claimed, even though Wineapp Ltd only delivered wine to customers in the London area.

The HO then proceeded to the second step of the test for passing off, regarding misrepresentation. In doing so, the HO considered the descriptiveness of both marks, applying *Office Cleaning Services Ltd v Westminster Window & General Cleaners Ltd*³, where it was held that comparatively small differences in words would be sufficient to avert confusion where a mark consists wholly or partly of descriptive words. In this instance, the HO found that the verbal elements of each mark, “WineApp” and “winesapp” essentially possessed identical meanings and were descriptive of an app referring to “some aspect of wine such as retail or sommelier recommendations”. As such, the HO determined that the relevant consumer would deem the shared element a “coincidental use of descriptive language”, and so would rely on the dissimilar device elements of each mark to distinguish between the two businesses. Consequently, the HO found in favour of the Applicant,

as without misrepresentation, damage could not occur. The Opponent then appealed to the High Court.

THE APPEAL

In considering the 10 grounds for appeal submitted by Wineapp Ltd, the judge focused on the HO’s assessment of the verbal elements as part of her decision, where she held that these were “virtually identical” to one another, and so the distinctiveness of the marks emanated from their respective device elements. The judge deemed the HO to have applied the authority of *Office Cleaning Services Ltd* correctly and, additionally, it was determined that the term “wineapp” had not achieved a secondary meaning and, therefore, was not distinctive by itself.

The judge found “no reason to interfere with the decision” of the HO and dismissed the appeal.

TAKEAWAYS

Firstly, compiling quality evidence to support your argument is vital. In this case, as the onus of establishing a misrepresentation (and subsequently, a likelihood of deception or actual deception) was on the Opponent, its failure to submit any consumer evidence was inevitably going to jeopardise its prospects in a case where a substantial part of both marks was descriptive.

Secondly, if part or all of a trade mark consists of descriptive words in the context of the relevant goods or services, it will be extremely difficult to enforce such a mark in reliance on those words. Slight differences, especially where visual in nature (such as a device), will likely be sufficient to avert an instance of misrepresentation.

Finally, goodwill can be found after a relatively short period of use and as a result of use in a limited locality.

Note: Dehns represented the Applicant in this case. To the authors’ knowledge, the decision is not under appeal.

1. [1990] UKHL 12
2. [2013] EWCA Civ 590
3. [1946] 63 RPC 39

KEY POINTS

- + If part or all of a trade mark consists of descriptive words in the context of the relevant goods or services, it will be extremely difficult to enforce such a mark in reliance on those words
- + Goodwill can be found after a relatively short period of use and as a result of use in a limited locality
- + Compiling quality evidence to support your argument is vital

MARKS

The Applicant’s Mark



winesapp

The Opponent’s Mark



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F&F gains the front foot

This case reiterates fundamental issues of infringement, says John Coldham



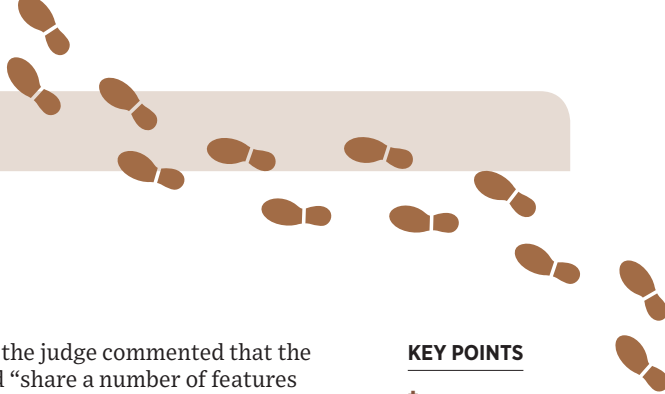
The crux of this case was a dispute regarding a fashion riding boot that was copied through multiple variations and sold to consumers. The Claimants relied on both registered and unregistered rights in the design of the boot to allege infringement by the Defendants, which had released three variations of a similar boot. The judge ultimately found that the Claimants' registered and unregistered design rights were valid, and that the Defendants had infringed the original design in two out of three of the variations.

This a refreshing example of a registered design being found valid and infringed. While this judgment did not break new ground, the judge usefully reiterated the relevant elements to consider when submitting evidence and the tests parties should have in mind in considering both prior art and design infringement.

FACTS FIRST

Fairfax & Favor (F&F) is a luxury leather business, and this case centred on its design of a fashion riding boot known as the Heeled Regina. This is a tall, sleek, riding-style boot with an elasticated gusset down the length of the back. It was designed by Mr Parker, a director and employee of F&F. Manufacturer Lazo y Duque produced the prototypes. In relation to the design of the Heeled Regina, F&F filed a Registered Community Design (RCD) on 21st January 2016 for footwear, relying on seven distinct features of the boot, including decorative features such as a fan and tassel.

House of Bruar (Bruar), an independent country fashion retailer that sells well-known fashion brands alongside artisan products, released a similarly designed boot known as Version 1. As a result of F&F's design infringement concerns, Bruar modified its design twice, resulting in Versions 2 and 3; both would come under scrutiny in the proceedings.



Throughout 2015 and 2016, F&F and Bruar were in discussions regarding a proposed commercial agreement, but this was unsuccessful and did not result in any sales. However, in 2016, a Bruar employee purchased a Heeled Regina boot using the company credit card and ordered the boot to be delivered to the designer of Bruar’s 2017/18 catalogue. This catalogue contained images of both the Heeled Regina and Bruar’s Version 1 boot.

Shortly after, Bruar placed an order for the Heeled Regina boots with F&F. F&F believed that this order signalled that Bruar would be stopping the sale of the Version 1 boots and so decided not to issue a letter of claim for infringement. However, Bruar continued to sell the Version 1 boot and advertised both boots in its 2018/19 catalogue. This prompted F&F to send a letter of claim to Bruar, and Bruar developed the Version 2 boot as an alternative. Bruar then later ordered the Version 3 boots from Lazo y Duque. These had similarities to the Heeled Regina, including an elasticated gusset, although in the Version 3 boot this was located at the side of the boot instead of the back as in the Heeled Regina.

In August 2019, F&F issued design infringement proceedings against Bruar, alleging that its Version 1, 2 and 3 boots infringed the design rights in the Heeled Regina, relying on the UK equivalent of its RCD, and the UK unregistered design rights. Bruar contested the validity of F&F’s designs and the RCD. It alleged that UK unregistered design rights did not exist in the Heeled Regina boot designs, whole or partial, due to the design being “commonplace”.

THE JUDGMENT

The judge was required to analyse the following five pieces of prior art relied upon by Bruar:

- An earlier version of one of the Claimant’s designs;
- 1620: a Spanish riding boot from Lazo y Duque’s 2010 catalogue;
- Central Hipica: a flat boot with an elasticated panel with thin strips of leather attached;
- Bota Kate: a slimmer, less rugged version of the 1620 (also by Lazo y Duque); and
- Cejudo: a boot created by Manuel Cejudo from Valverde.

Although the judge commented that the prior art did “share a number of features with the F&F designs in issue, such as a tassel hanging from the zip pull and a perforated or decorated fan shape at the top of the boot”, she held that none of the prior art had all of the relevant features of the Heeled Regina.

The Cejudo boot was possibly Bruar’s strongest argument in terms of similarities to the Heeled Regina. Although any similarities were denied by F&F from the outset, F&F also argued in the alternative that even were the Cejudo boot similar, this was not sufficient to suggest its designs to be commonplace because the Cejudo design was obscure. Individuals from both the Claimant and Defendant stated that, despite being aware of Valverde, they had not heard of the designer, Mr Cejudo. Further, Bruar had supplied detailed evidence of its prior art searches, a decision that proved fatal to its defence. The Cejudo design was not found in the Defendants’ initial comprehensive prior art searches, but instead through a separate lengthy and thorough research process. As such, the judge considered the Cejudo boot to be obscure prior art and held that the Defendants had not shown that the Cejudo boot (or any of the other prior art relied upon) were in the minds of the designers of the Heeled Regina at its

KEY POINTS

- Thorough prior art searches can indicate obscurity of the design
- Documentary evidence is important in proving copying in cases relating to design infringement

“ While not breaking new ground, this a refreshing example of a registered design being found valid and infringed ”

creation. The Heeled Regina was deemed not a commonplace design, with the judge commenting: “So far as the Heeled Regina is concerned, it seems to me that it is not, as [Bruar] contended, a design consisting simply of a combination of run-of-the-mill features”. Consequently, the design rights were valid.

The judge then proceeded to consider the extent to which the partial designs should be compared to the prior art. The judge highlighted that one had to consider the partial designs as a whole, not simply pick those individual features that could be considered similar to certain features of the prior art. This is especially necessary ▶

“ Exceedingly obscure prior art may not be useful and could strengthen the claimant’s case by highlighting the novelty of the design

in relation to fashion goods, as certain arrangements of individual features often create an aesthetic effect that elevates the item above the commonplace. Here, the judge held that the combination of particular features did not produce a new aesthetic effect and so the partial designs were commonplace. As such, unregistered design rights did not subsist there.

The judge also held the RCD to be valid on the basis that the elasticated gusset or rear panel, indicated to the informed user by the vertical lines on the back view of the representation, distinguished the Heeled Regina from the prior art.

The judge then considered the question of infringement, stating that “s226(2) [of the Copyright Designs and Patents Act 1988] is clear: infringement requires copying and the allegedly infringing design must be made ‘exactly or substantially’ to the design”. In relation to the notion of copying, the Court was shown a range of correspondence in which Mrs Meikle of Bruar referenced F&F when discussing pricing or designs with other parties. Mrs Meikle then attempted to explain these through varying excuses such as competition. However, the judge found the response “incredible”, concluding that “the denial of copying is incompatible with the documentary evidence”.

Therefore, it was held that Bruar’s Versions 1 and 2 boots had infringed F&F’s Heeled Regina design. However, largely due to the lack of an elasticated gusset, Version 3 did not infringe the Heeled Regina.

IMPLICATIONS

This case confirms the potential positive and negative impact that reliance on extensive prior art searches can have on a party’s case for validity. Having a range of prior art can be a useful tool to counteract notions of novelty of design, but having multiple earlier

designs to rely upon that do not have many similar features to the disputed design may not be worth the time and expense, as they can potentially demonstrate design freedom.

Further, although some defendants may be eager to conduct detailed searches to find extraordinary cases of similarities, we see that exceedingly obscure prior art may not be useful in showing that a design is invalid. In fact, such obscure prior art could strengthen the claimant’s case by highlighting both the novelty of the design and the broad scope of design freedom. Those bringing invalidity claims should consider specifically whether the prior art really could have been current in the thinking of designers in the field at the time of creation of the designs.

Indeed, this case provides a further warning against supplying detailed evidence of any lengthy and thorough searches conducted in an attempt to support an application against novelty. Here, defendants risk their evidence being used against them to suggest the prior art was obscure due to the sheer amount of effort taken to search for them.

Consideration should also be given as to what makes a design stand out. A comparison between the disputed design and prior art must not simply focus on similarities and differences between individual design features but look at the aesthetic of the design and the features as a whole.

Finally, this case shows the importance of documentary evidence when demonstrating copying for infringement. Companies should heed Bruar’s downfall here and may want to educate their designers and buyers as to how their emails and correspondence can be used to demonstrate copying of other brands.

Note: To the authors’ knowledge, this case is not under appeal.



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Funtime is over

Sarah Jeffery reports on why Funko was successful this time round

A recent IPEC decision found that use of the names FUNTIME FREDDY and FUNTIME FOXY in relation to licensed videogame character merchandise did not infringe earlier registrations for a series of marks used on toys for babies and toddlers.

Chinese toy manufacturer Luen Fat Metal & Plastic Manufactory Co. Ltd (Luen Fat) has imported toys into the UK and EU via a sole agent and distributor since 1989. It also owns a UK registered trade mark in class 28 consisting of a series of three

word marks – FUNTIME, FUN TIME and FUN-TIME (the Marks) – and an EUTM (and subsequent UK clone registration) for FUNTIME. These are all registered in respect of “games, toys and playthings and electronic games”.

The Defendant, Funko UK Ltd (Funko) manufactures goods under merchandising licences, including figurines and plush toys of characters from films, TV shows and video games. These goods include plastic figurines and plush toys representing characters from the popular series of video games known as *Five Nights at Freddy’s* (FNaF). Two characters from the fifth game in the FNaF series, launched in 2017, are called FUNTIME FREDDY and FUNTIME FOXY (the Names).

Proceedings were issued in May 2020 for trade mark infringement under s10(1), 10(2) and 10(3) of the Trade Marks Act 1994 (TMA), as well as the equivalents under Article 9 EUTMR, as proceedings were issued prior to the conclusion of the Brexit transition period.

Funko raised a defence that the Names were not being used in a trade mark sense but to descriptively reference characters from the FNaF game. The Defendant was also put to proof of use of its Marks. Ultimately, the judge rejected all three heads of claim. However, the judgment raises interesting points regarding evidence of both use and enhanced distinctiveness.

PROOF OF USE

When challenged to prove use of the Marks, Luen Fat provided evidence only in relation to toys aimed mainly at babies and toddlers. While Funko accepted that the Marks had been used in relation to toys, it questioned what a fair specification reflecting actual use would be. Luen Fat claimed in submissions that it produces toys for older children but did not evidence this. As a result, the fair specification was reduced to “toys, games and playthings for babies and pre-school children”.

Notably, the Marks were often moulded into the plastic toy itself, with the goods

KEY POINTS

✦ Claimants should submit evidence of use of a mark across as broad a spectrum of goods and services as possible when put to proof in infringement proceedings in order to avoid narrow interpretation of a fair specification

✦ If a mark relied upon has only been used in conjunction with another mark, the prominence of each mark will be considered when assessing both use evidence and any claim of enhanced distinctiveness

✦ Sales figures submitted without context may not be sufficient to evidence enhanced distinctiveness. Consideration should be given to all relevant factors



marketed in packaging bearing the brand of the end retailer. Invoices and shipping documents submitted as evidence of use did not reference FUNTIME but referred instead to the retailer (eg, “Wilko Play Spinning Horse”). This limited use in conjunction with a third-party brand had a negative impact on both the assessment of evidence of use and also on the claim of enhanced distinctiveness.

The average consumer was held to be the same for the goods of both parties, paying medium attention. In the case of Luen Fat’s goods, consumers may be buying cheaper toys for babies and toddlers, but would have to be careful to ensure the toy was age-appropriate. In the case of Funko’s goods, consumers may take some care, as they would be selecting more expensive, collectible items.

DISTINCTIVENESS EVIDENCE

In order to prove the distinctiveness of its Marks, Luen Fat adduced evidence previously submitted to the UK IPO and EUIPO during the registration process, thereby flagging that both registries had likely required evidence of acquired distinctiveness to overcome absolute grounds objections. The Claimant sought to rely on a previous failed invalidity attack as evidence of enhanced distinctiveness of its Marks, but this was not accepted.¹

An overall assessment of evidence of use takes into account a wide variety of factors, including market share, intensity, geographic spread and duration of use, as well as investment into promotion of the mark. Evidence from the trade and consumers is also relevant. While sales of more than five million toys since 2003 sounded significant, no evidence of market share was submitted. Sales data was not divided geographically, and other types of evidence were lacking.

Ultimately, as no challenge against the validity of the Marks had been made by Funko, there was little option but to find the Marks distinctive to a minimal degree and enhanced distinctiveness existing to a limited extent in the UK (but not the EU).

INFRINGEMENT

In relation to s10(1), the judge considered that the average consumer would not dissect the Names but would instead

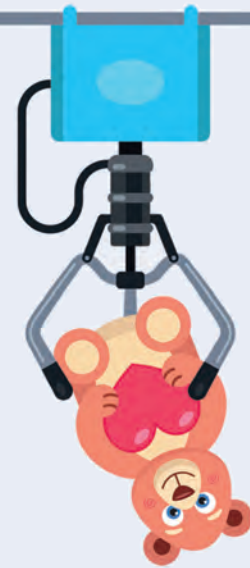
consider them in their entirety. On this basis, the Marks and the Names were not identical and the s10(1) claim failed.

In relation to s10(2), despite an argument that visual and/or aural similarity was offset by conceptual dissimilarity, the Marks and the Sign were found to be similar to a medium degree.

After adjustment of fair specification, plastic figurines were considered similar goods to those of the Claimant, while plush toys were found to be identical, despite Funko’s arguments as to differing categories (toys versus collectibles).

Importantly, the plush toys were not labelled with FUNTIME. They instead featured a sewn-in label and a swing tag referring to FNaF. Any outer packaging that might bear the Names was added by the retailer and was therefore outside of Funko’s control.

Despite the fact that it is possible in some circumstances for a sign to be both descriptive and to function



“ Consumers familiar with the FNaF games would consider the Names descriptive



“ The judge highlighted that Funko’s toys are actually quite cute... It is only the underlying FNaF video games that may adversely impact small children

as a trade mark, the Court accepted Funko’s argument that use of the Names was purely descriptive of the video game characters.

Notwithstanding this, an important consideration was whether the average consumer would consider the Names purely descriptive. Those consumers familiar with the FNaF games or seeing the Funko products displayed for sale alongside other game merchandise (as often happened) would consider the Names descriptive and see Funko and FNaF as the indicators of origin. Conversely, consumers buying online, where items are listed alone, and consumers unfamiliar with FNaF, would potentially consider the Names as a sub-brand with an origin function.

CONFUSION AND REPUTATION

In assessing likelihood of confusion, the judge explored whether there was a risk that the average consumer would think the goods came from the same or economically linked undertakings, as well as applying a global assessment of likelihood of confusion in the context of all relevant facts. No evidence of actual confusion was provided, despite sales of Funko’s products having continued for some four or five years.

While the position differed for plush toys (being suited to preschool children and therefore considered identical goods), it was still held as unlikely that consumers would believe the name FUNTIME had been licensed from Luen Fat, particularly as many of the plush toys did not bear the Names at all. In the end, no likelihood of confusion was found, even where the Names may be seen as badges of origin, leading to the failure of the infringement claim under s10(2) TMA.

Considering the earlier finding of enhanced distinctive character of the UK Mark, reputation was also found for the purposes of s10(3). A global assessment found that the relevant public would

establish no link between the Names and the Mark, particularly as the Claimant had never sold plush toys. The s10(3) claim therefore also failed.

The remaining aspects of the 10(3) claim were explored in case of appeal. Luen Fat adduced witness evidence from a school teacher that the allegedly frightening and unpleasant nature of Funko’s products would cause detriment to its Marks and risk tarnishing. The judge, however, highlighted that Funko’s toys are actually quite cute and therefore not intrinsically scary. It is only the underlying FNaF video games that may adversely impact smaller children.

Seeking to evidence unfair advantage, the Claimant submitted that sales of merchandise built popularity for the video games (rather than vice versa). It was held that the success of Funko’s goods would stem from the link to FNaF and not the Marks, so this argument also failed.

One final note of caution: while the Court accepted that the Names were used descriptively rather than as an indicator of origin, it would not always be the case that a character merchandising licence from a third party would provide a defence of due cause to use a name. If infringement had been found, then the licence would have been immaterial as a licensee can only license the IP rights to which it is entitled; it cannot be granted a licence to infringe the rights of a third party.

Note: It is not clear at the time of writing whether the decision will be appealed.

1. [2019] EWHC 118 (IPEC)

MARKS

FUNTIME FOXY IN USE



FUNKO PLUSH TOY



A FUNTIME BABY’S TOY FROM LUEN FAT



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Monster mashed

Chris Hawkes explains why a huge reputation will not always help

KEY POINTS

+ Brands with a reputation will not always succeed in oppositions, even where their reputation is undeniable or clear to see

+ Unregistered rights cases before the EUIPO need to be properly substantiated or they risk failing at the first hurdle

MARKS

M LOGO 018288036



MONSTER MARKS
(REPRESENTATIVE)



This is a decision of the Opposition Division (OD) of the EUIPO in relation to EU trade mark Application no. 018288036 in classes 12, 25 and 35 (the Application) in the name of Cheng Shin Rubber Ind. Co., Ltd. (CSR), and Opposition no. B003138565 thereto by Monster Energy Company (Monster).

The Application was for a stylised “M” as shown below. CSR’s trade mark application covered classes 12 (tyres and related goods), 25 (clothing/ footwear), and 35 (retail of 12/25 goods, promotion services).

Monster’s grounds included Article 8(1)(b), Article 8(5) and Article 8(4) EUTMR. Monster based its opposition on several EU trade marks covering its core class 32 goods and the same classes as the Application. It also relied on unregistered German and Spanish rights.

ARTICLE 8(1)(B)

In its decision, the OD found that Monster’s goods and services were identical to those covered by the Application.

It also determined the relevant public to be formed of either the public at large or business customers with specific professional knowledge or expertise, whose degree of attention may vary from average to high depending on the specialised nature of the goods/services, the frequency of purchase and their price.

It decided that Monster’s earlier marks may be perceived as a claw device or a highly stylised letter “M”. Neither of these has any meaning in relation to the goods/services and so the marks are distinctive. Their distinctiveness is also enhanced through Monster’s reputation.

Visually, it determined that the marks are dissimilar as “on the whole, there is absolutely nothing that would visually link the contested sign to the earlier marks”. Aurally and conceptually, the marks were considered identical for the relevant public, who perceive the signs as a letter “M”, but dissimilar for the public, who perceive the signs as purely figurative.

As for the global analysis, it was felt that the main similarity in the marks is that they coincide in the letter “M”, and so the presentation of the respective logos would be



determinative. The OD found that the impact of the visual and conceptual similarity was minimal overall, where the marks were both simply the letter “M”. On that basis, the OD found that despite the identity of the goods/services and the enhanced distinctiveness of the earlier marks, there could be no likelihood of confusion.

ARTICLE 8(5)

In relation to this Article, Monster claimed a reputation in relation to its class 32 goods, principally carbonated/ non-alcoholic drinks, in relation to several of its marks. Monster submitted evidence from its Senior Vice President and Deputy General Counsel. Its evidence focused on the breadth of protection around its brand, sales volumes, market share, independent recognition and awards, brand engagement, and sponsorship activities. Unsurprisingly, the OD found Monster to have a “solid reputation” in relation to “energy drinks” in class 32.

The OD referred to its analysis of the signs under the Article 8(1)(b) ground, but also assessed distinctiveness in relation to the class 32 goods, for which a reputation was claimed and found. For the “M” logo marks, its findings were the same as under the Article 8(1)(b) grounds, but for the other M MONSTER ENERGY marks, the OD found that they were even less similar due to their additional elements.

The OD found that due to the lack of any likelihood of confusion, and the dissimilarity of class 32 goods versus the goods/services of the Application, there could be no risk of an *Intel* link in the mind of the relevant public.



“ *Monster’s reputation seems to have been at the centre of its strategy* ”

Overall, the OD therefore found that the opposition was not well founded under Article 8(5) EUTMR.

ARTICLE 8(4)

Finally, Monster claimed non-registered rights in Germany and Spain in relation to four of its marks. In respect of its unregistered rights in Germany, Monster pleaded on the basis that its marks had acquired recognition as trade marks through use within the relevant trade circles (s4(2) of the German Trade Mark Act).

In order to succeed, Monster needed to show: (i) double identity; (ii) a likelihood of confusion; or (iii) unfair advantage/detriment to the distinctive character/repute of the earlier marks (s14 of the German Trade Mark Act). The OD referred to its findings in relation to the Article 8(1)(b) and 8(5) grounds, dismissing the prospect of this claim succeeding, and deciding that the Article 8(4) claim based on unregistered rights in Germany must fail.

In respect of its Spanish rights, Monster fell foul of the requirement in Article 7(2)(d) EUTMDR to provide a clear identification of the content of the national law relied upon. Although Monster provided the guidelines of the Spanish Patent and Trade Mark Office, it failed to substantiate the content (text) of

the Spanish law protecting the earlier non-registered trade marks, which it could have done by providing the official text of the law itself. Due to these deficiencies, the OD found the opposition was not well founded under Article 8(4) EUTMR on the basis of earlier non-registered marks in Spain.

The OD also found that even if Monster had sufficiently substantiated the applicable Spanish law, the opposition would still have failed. This is because earlier non-registered trade marks in Spain can only be relied upon provided that they are well known and that there exists either double identity or a likelihood of confusion. The prospect of either of those had been dismissed by the OD in its earlier findings.

Monster’s undeniable reputation seems to have been at the centre of its strategy. However, this is an unsurprising decision given the dissimilarities in the marks and the dissimilarity between those goods for which Monster enjoys a reputation and the goods/services applied for by CSR.

This case is a useful reminder that having a huge reputation will not help to overcome all hurdles in establishing an Article 8(1)(b) case, and that a reputation alone isn’t sufficient to succeed on Article 8(5).



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Watch power

Long-term brand investment pays off in opposition, writes Henry Schlaefli

This decision concerns an opposition filed at the EUIPO by Rolex S.A. (Rolex) and directed against parts of an EU trade mark application for ROLLSTIME. The opposed goods in class 14 included watch winders, presentation rolls, cases and boxes for watches, clocks and jewellery.

In its decision, for reasons of procedural economy, the EUIPO examined one ground of opposition only: an Article 8(5) EUTMR claim concerning marks with a reputation. The mark relied upon was a single word mark for ROLEX covering watches and jewellery in class 14.

The case is interesting as it demonstrates the power of marks with a reputation, particularly in cases where on first impression it seems that a likelihood of confusion is unlikely.

FIRST HURDLE

The first hurdle for the Article 8(5) claim was to evidence that Rolex had a reputation for its jewellery and watch goods in class 14. In this regard, the Opponent filed, *inter alia*, the following:

- examples of press coverage from 2001 to 2011;
- copies of advertisements run in the UK, Spain, Germany and Sweden;
- further advertising and press articles from 2014 to 2020;
- judicial and administrative decisions in national EU courts;
- surveys in various EU Member States between 2006 and 2010;
- lists of sponsored sports and cultural events;
- brand rankings featuring Rolex; and
- invoices for various models of watches sold in Europe from 2013 to 2018 and examples of influencer and celebrity endorsements of Rolex timepieces.

On the basis of the documents before the EUIPO, it concluded that the ROLEX mark had acquired a significant reputation in the EU. The evidence did not refer to every EU Member State, but the EUIPO confirmed that the evidence submitted for France, Germany, Spain and Italy was sufficient to conclude that there was a reputation for the whole of the EU.

Although the surveys submitted were old, the EUIPO concluded that the Opponent continues to significantly invest in advertising the sign. The later examples of advertisements were sufficient to reinforce this. The fact that ROLEX was also considered one of the top 100 trade mark brands in the world was relevant, though not directly applicable to the reputation of the mark within the EU.

Although no direct sales figures or marketing spend were submitted, the evidence of the actual marketing campaigns, the event sponsorship and extensive product

“ This case demonstrates the power of marks with a reputation, particularly in cases where on first impression a likelihood of confusion is unlikely



“ The element “TIME” would be considered descriptive for timepieces, and thus its distinctiveness is almost negligible for the goods related to watches

placement were also relevant in supporting the conclusion that the ROLEX mark has a significant reputation.

The EUIPO then turned to the analysis of the similarity between the marks. On first assessment, it does not seem immediately apparent that the shared prefix of the three letters “ROL” would be sufficient for there to be a conclusion of a link between the marks. However, the EUIPO came to that conclusion after the following analysis of the dominant and distinctive components of both marks:

(1) Both marks are made-up words and have no meaning. Therefore they both have a normal degree of distinctive character.

(2) Although the verbal element ROLLSTIME is an invented word, in respect of the watch-related class 14 goods, a part of the public will recognise the word “TIME”. It is a basic English word, and consumers tend to break verbal elements down into elements which resemble common words or have concrete meanings.

(3) The contested sign will be broken down into the elements “ROLLS” and “TIME”.

(4) “TIME” has a direct meaning for the English-speaking public, for English consumers and for the relevant part of the consumers in other EU Member States.

In light of this, the element “TIME” would be considered descriptive for timepieces in relation to the goods at issue, and thus its distinctiveness is almost negligible for the goods related to watches, including their cases and winders.

Visually and aurally, then, the marks were determined to be similar to an average degree for the goods for which the “TIME” element is non-distinctive, and similar to a low degree for the remaining goods. Conceptually, since ROLEX has no meaning, the signs were not considered conceptually similar.

Taking into account the stated similarity of the signs, the high degree of reputation of the earlier mark, the high degree of inherent distinctiveness, and the overlap between the Opponent’s goods and the watch-related Opposed goods, the EUIPO concluded that there was a link between the marks. For the remaining goods relating to jewellery and cases, the EUIPO concluded that since these

were luxury items likely to be sold side by side and the cases and presentation of such goods are part of their luxury allure, there was also a sufficient link between the contested signs for the relevant goods.

RISK OF INJURY

Finally, the last ingredient required was a risk of injury. Rolex argued that due to the extensive reputation of the earlier mark, the Applicant would take unfair advantage of the recognition of their earlier sign. The Applicant’s sign would be detrimental to the Opponent’s image because consumers buying the products would expect the same quality of goods as those of the Opponent. That would cause detriment to the reputed sign if they were not to the same standard. On unfair advantage, given the fact that the contested goods were likely to be sold in similar stores, and the extent of Rolex’s reputation, consumers were likely to think that there is a connection between the Applicant’s goods and Rolex.

The EUIPO therefore concluded that the Application would take unfair advantage of the distinctive character and repute of the earlier mark. Since only one risk of injury is necessary for the opposition under Article 8(5) to succeed, the EUIPO did not assess whether other types of damage were likely to occur.

In conclusion, the EUIPO found the opposition well founded and refused the class 14 part of the application. Reasonable minds differ in these types of assessment, but due to the very granular analysis of the individual components of the Application, it seemed inevitable that the EUIPO would find enough similarity between the marks for there to be a link, and unfair advantage, particularly given the ROLEX mark’s repute.

KEY POINTS

- + Reputation-based claims are often a powerful tool when there is unlikely to be a likelihood of confusion
- + The EUIPO’s granular breakdown of the elements of the mark can have a significant impact on similarity assessments



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Counted out on clarity

Emilia Petrossian sets out why this Appellant failed to make a dent in the existing decision

On 9th November 2021, Eos Products Sàrl (the Appellant) filed an appeal in the European Court of Justice (ECJ) against a Court of First Instance (CFI) decision from 8th September 2021 and requested annulment of the judgment. The appeal was dismissed as the Appellant did not comply with the requirements of appeal procedure and did not state correct reasons for appeal.

In order to understand the Appellant's reasons for appeal at the ECJ, and its subsequent failures, it is first important to consider the events leading up to the appeal.

TIMELINE

- **6th October 2016:** the Appellant applied to register a 3D mark (shown overleaf) in classes 3, 5 and 21.
- **17th October 2016:** the application was objected on the grounds of Article 7(1)(b) EUTMR, the objection stating that: "the three-dimensional mark applied for

constituted the appearance of the product itself or its packaging, and did not depart significantly from other shapes of packaging that are customary on the market." The Appellant maintained its claim of distinctiveness and filed supporting documents. The application was subsequently accepted and published.

- **23rd April 2018:** a third party filed observations that the mark lacked distinctive character and claimed that at the time of the application there were already numerous round and oval shapes available for goods in class 3 and therefore the sign did not differ from the norm.

- **8th October 2018:** the Examiner once again objected to the application on the basis of Article 7(1)(b), claiming the mark was non-distinctive and the sign did not deviate from the usual forms of packaging for lip balm. The Appellant again maintained its position and submitted further evidence

“ The fact that the Appellant is the only one to produce spherical or ovate packaging does not necessarily prove distinctive character, nor does it evidence reputation

and claimed acquired distinctiveness of the mark through use.

• **18th July 2019:** the Examiner held that the Appellant had not provided sufficient proof of distinctiveness, as the evidence provided was only in relation to use in five out of the then 28 EU Member States, relating mainly to the German market. The application was subsequently rejected. The Appellant filed an appeal against the Examiner’s refusal, requesting the decision to be annulled.

• **8th June 2020:** the Board of Appeal (BoA) issued a decision dismissing the appeal. The BoA agreed with the Examiner’s findings that the mark was devoid of distinctive character and that the Appellant did not prove acquired distinctiveness through use, as it must be proved in relation to all claimed parts of the EU. The BoA held that the intensity of advertising expenditure is irrelevant in relation to an assessment of the distinctiveness of the mark. The Appellant

did not raise any objections to the decision that class 21 does not depart significantly from the customary range of shapes for cosmetic containers. The Appellant appealed against the BoA’s decision and requested a limitation of class 21.

• **8 September 2021:** the CFI dismissed the action and gave a number of reasons:

(1) The Appellant’s attempt to limit class 21 during the CFI hearing was rejected on the basis that such a limitation at that stage would alter the subject matter of dispute.

(2) The fact that the Appellant is the only one to produce spherical or ovate packaging does not necessarily prove distinctive character, nor does it evidence reputation. The features of the form – such as a flattened underside, a horizontal line and a dent – provide functional features. Novelty or originality are not relevant in the assessment of the distinctive character of a trade mark.

(3) In relation to concrete examples, the BoA is not required to provide examples.

(4) The shape of the mark did not differ from other storage containers, dosing dispensers and appliances for applying cosmetics such as cream rouge or skin cream.

(5) The relevant public with at least an average level of attention will not perceive the form of the mark as an indication of the commercial origin of the goods. In accordance with the regulations: “a trade mark may be registered only on the basis and within limits of the application filed, and not in relation to evidence provided by the Appellant in the form of press or internet comments”.

(6) Search results provided to reflect the market conditions were irrelevant. The CFI’s role is to review the legality of the BoA’s decision and not to review the facts submitted to for the first time.

(7) The BoA was not bound by the decisions of the German courts, on which the Appellant was relying, as the EU rules state that the decision must be assessed solely on the Regulations.

(8) Finally, the CFI rejected the Appellant’s claim that the BoA did not take into account evidence provided; the BoA considered the evidence but came to the conclusion that the mark was non-distinctive.

The Appellant did not decide to contest the decision in relation to the findings

that the mark had not acquired distinctive character through use.

• **9th November 2021:** the Appellant brought an appeal against the CFI's decision of 8th September 2021, requesting annulment of the decision.

DECISION

The appeal was not allowed. The Appellant in its application for appeal had failed to follow form of order and raise questions of importance for the unity, coherence or development of EU law, which are requirements under Article 58a(3) of the Statute of the CJEU. It further failed to provide all the information necessary for the Court to rule on that application.

The ECJ stated that: “an application for leave to appeal must, in any event, clearly and precisely state the grounds on which the appeal is based, identify equally precisely and unambiguously the point of law raised by each ground of appeal, explain whether that question is relevant to the unity, coherence or development of EU law and, more specifically, explain why that question is relevant in the light of the criterion relied on.

“ *The Appellant had failed to raise questions of importance for the unity, coherence or development of EU law* ”

“As regards, in particular, the grounds of appeal, the application for leave to appeal must contain details of the provision of EU law or case law allegedly infringed by the judgment under appeal or by the decision challenged. An appeal must set out in summary form the existence of the error of law allegedly committed by the General Court and point out the extent to which that error affected the outcome of the judgment or decision under appeal.

“If the alleged error of law is the result of a failure to recognise the case law, the application for leave to appeal must set out in a concise but clear and precise manner, first, where the alleged contradiction is to be found, indicating both the paragraphs of the judgment or decision challenged by the appeal, which the appellant calls into question, and the paragraphs of the decision of the Court of Justice or the Court of First Instance; which are alleged to have

been disregarded and, second, the specific reasons why such a contradiction raises a question of importance for the unity, coherence or development of EU law.”¹

CFI CRITICISM

In its application, the Appellant firstly criticised the judgment under appeal, which did not provide clarity and legal certainty as to what requirements are to be met for registration of a 3D mark in the EU and how they differ from standards or industry practices because of unusual visual effects. The Appellant claimed that this raises important questions about how an applicant can prove that such mark can fulfil its essential function (indication of origin).

The Appellant also criticised the CFI for stating that the evidence filed in support of the distinctive character of the mark applied for was inappropriate, and further for applying the law in error as regards the requirements for proving the distinctive character of a 3D trade mark, which is contrary to the uniform and consistent application of trade mark law in the EU and leads to considerable uncertainty in trade mark practice.

However, the ECJ held that the Appellant did not satisfy the requirements of leave for appeal but merely submitted more generally that the judgment of the CFI gave rise to a lack of legal certainty. The Appellant did not clearly refer to points of law relevant to the unity, coherence or development of EU law or why those questions are intended to be relevant.

Further, the Appellant did not identify paragraphs of the judgment of the CFI, nor explain the nature of the error of law committed by the CFI in relation to its assessment of a 3D mark. Finally, the Appellant did not identify errors made by the CFI in relation to assessment of the evidence.

Note: This report is based on translations of documents in French and German.

1. Order of 10th December 2021, EUIPO v The KaiKai Company Jaeger Wichmann, C-382/21 P, paragraph 22



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KEY POINTS

• CJEU appeals must follow the rules under Article 58a(3) of the Statute of the CJEU

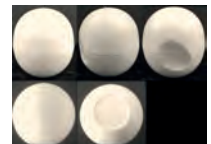
• New claims and/or evidence cannot be brought in at appeal. They should be presented during administrative proceedings

• The role of the courts of appeal is to assess the legality of a decision

• Appeals must be clear and to the point, pointing to errors of law and potential effects on EU law, supported by evidence and with reference to previous decisions

MARK

The Appellant's 3D mark





Our next Autumn Conference, taking place on 12th October, will be in person. Go to citma.org.uk/events to find out more

Calendar

Our upcoming events for members

DATE	EVENT	LOCATION	CPD HOURS
5th July	Summer reception, featuring the Sheila Lesley Lecture	Inner Temple Gardens, London	1
6th July	CITMA Webinar Company names tribunal	Online	1
14th July	CITMA Paralegal Webinar Update on Chinese trade mark filings	Online	1
13th September	CITMA and UK IPO roadshow	Barker Brettell, Birmingham	2
22nd September	CITMA Paralegal Seminar	London	3
28th September	CITMA and UK IPO roadshow	Womble Bond Dickinson, Leeds	2
29th September	CITMA and UK IPO roadshow	Brabners, Manchester	2
12th October	CITMA Autumn Conference	The Library, Birmingham	5
18th October	CITMA Paralegal Webinar Update on non-use requirements	Online	1
8th November	CITMA Webinar UK case law update	Online	1
17th November	CITMA and UK IPO roadshow	Foot Anstey, Bristol	2
2nd December	Christmas Lunch	Royal Lancaster, London	

THE TRADE MARK 20

Q&A



Eve Brown

knows where to get a great wig

I work as a... Chartered Trade Mark Attorney at Marks & Clerk LLP.

Before this role, I was... a Barrister's Clerk. I got acquainted with the inner workings of the courts, worked in a great team, and discovered the best places in London to buy wigs!

My current state of mind is... positive. I'm excited about the world opening up again and the opportunities for business and travel.

I became interested in IP when I... undertook work experience at an advertising agency. This prompted me to consider the work of the Advertising Standards Authority, and I found it fascinating.

I'm most inspired by... young high achievers. I often tune in to Steven Bartlett's podcast *The Diary of a CEO*, where he interviews entrepreneurs across a range of sectors.

In my role, I most enjoy... drafting legal submissions, witness statements and gathering evidence.

In my role, I most dislike... working late into the evenings, because I'm a morning person. Thankfully, this doesn't happen too often.

I can't live without my... running trainers. I've signed up for my first half-marathon this year, and I only have four weeks to go as I write this.



“
*I'm excited about
the world opening
up again for
business and travel*”

On my desk is... a cup of coffee that I just bought from a pop-up kiosk near the station.

In my pocket is... my iPhone. Like many Millennials, I like to keep it close at all times.

The talent I wish I had is... the ability to speak Mandarin Chinese.

My ideal day would include... a trip to Paris with friends to spend some time in the Louvre.

My favourite place to visit on business is... Glasgow. I'm a foodie and a big fan of Ashton Lane, a cobbled street with some great restaurants and bars.

If I were a brand, I would be... Barbour. I like to think that I'm versatile and practical, and I enjoy spending time in both the city and the countryside.

The biggest challenge for IP is... protecting and enforcing non-traditional marks such as a shape or pieces of trade dress. In Marks & Clerk's Fashion and Retail group, we regularly discuss creative solutions for clients facing these challenges.

My favourite mug says... nothing, but the handle is the “right” shape!

The best piece of advice I've been given is... not to assume anything.

When I want to relax I... go swimming.

In the next five years I hope to... travel to Japan. I work with some fantastic clients there, and it would be great to meet them in person.

The best thing about being a member of CITMA is... being part of the Education, Qualification and Standards Committee. I get to work on projects that further the development of education within the profession, and I really enjoy the work we do.



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Candidates should have good working knowledge in trade marks and be prepared to learn further. Time-keeping, dedication and personal organisation will make you stand out. If you feel you meet our clients requirements, please don't hesitate to get in touch!

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This role would suit an individual with 3+ years' experience in trade marks - if you have patent experience this is a plus, however full patent training will be given. This is a great opportunity for those looking for a new challenge in IP and to work for a bigger company.

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Dawn Elmore
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