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ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

Issue **409** May 2014 itma.org.uk



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ITMA Review

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This is my last *ITMA Review* introduction. Indeed, as you read this, we have a new President, elected at the end of April. I cannot identify the President, as I write in March, but I know who I will vote for.

One of the new President's first tasks will be to read this first *Review* of the Presidency, and it will take quite a while! I hope the new President, and all readers, will note that this issue contains

Ken Storey's final Media Watch; the column has been a delight and I am pleased that Council has elected him to Honorary Membership of our Institute.

Time runs out, and I have a last chance to break my promise of not writing in Latin during my Presidency. I end with three words: *salve et vale!*

Catherine Wolfe
ITMA President

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ITMA Insider

CEO bulletin

*Updates and additions to
Keven Bader's 5 March bulletin*



04

The first quarter of the year is traditionally a busy time for ITMA and this year seems to be no exception. We have completed our audit of the 2013 accounts and have successfully completed our Spring Conference event, at which I was pleased to see so many of you. For other notable news, please read on.

Anti-counterfeit campaign

Earlier this year, a new global campaign was launched by the United Nations Office on Drugs and Crime (UNODC) to raise awareness about counterfeit goods and their link to transnational organised crime.

The campaign – Counterfeit: Don't buy into organized crime – urges consumers to consider who and what lies behind the production of counterfeit goods in a bid to boost understanding of the multifaceted repercussions of this illicit trade, which is valued at \$250 billion per year.

The public service announcement – Look Behind – can be viewed at youtu.be/tu8zArWI75k, and people are encouraged to use social media, mailing lists, web pages and any other communications platforms available to help us inform the public about this critical issue.

Visit unodc.org/counterfeit for more on the campaign or [youtube.com/unodc](https://www.youtube.com/unodc) for all available language versions of the announcement.

Environmental policy

We have been looking to enhance and promote our green credentials, and we recently published our environmental policy on the ITMA website. We encourage members to look at developing a policy for their respective firms if there is not already one in place and, with that in mind, we have also provided links to a variety of firms that have agreed to share their corporate statements on social responsibility and environmental policy. These can be found at itma.org.uk/about/environmental_policy. This list is not exclusive or exhaustive. If your firm has a policy in place and it is displayed on your website, you can send the link to keven@itma.org.uk, and we will be happy to add your firm's details.

We are planning to launch a new website, which should have a number of enhanced features

Database and web update

ITMA is planning to transfer to a new database or, to use a technical term, a CRM (Customer Relationship Management) system in late June or early July. This is an exciting project for ITMA that will assist us internally in our administrative functions, but should also bring about developments that will help the membership. We are still in the early stages of planning and scoping out the functionality we will require, but I hope to be able to bring you more news on this in the coming months.

We are also taking the opportunity to look at the ITMA website, as this will become integral to delivering some of the functions and features that the new CRM system will provide. Later in the year we are planning to launch a new website, which should have a number of enhanced features and functionality to assist both members and the general public who use our site. Again, we will bring you more information as this project develops.

As a result of this impending work, we have taken on a short-term appointment to help us, in particular, with the office administration of our events programme. We are delighted, therefore, to welcome Teresa Ayme-Siqueira to the ITMA team.

IP Bill: further progress

Following the Second Reading of the IP Bill in the House of Commons on 20 January 2014, the Committee Debate took place on 28 and 30 January 2014.

Perhaps the most significant amendment made to the Bill during the Committee Debate was the introduction of the requirement of an intention to copy in order for the controversial new offence of unauthorised copying of a registered design to be made out. Also, the previous requirement that an offence would be made out by a copied product made exactly or substantially to the registered design was amended, so that the product now has to either be made exactly to the design, or "with features that differ only in immaterial details from that design".

Tabled amendments that were withdrawn included a move to have the definition of qualifying counties for unregistered designs limited to only the UK and other Member States of the European Economic Area, as well as an attempt to get the criminal provisions in the Bill extended to the copying of unregistered designs, a move that the Government opposed.

The Bill then moved to its Report Stage and Third Reading in the House of Commons on 12 March 2014. Yet a further amendment was tabled to extend the criminal provisions to unregistered designs, but again it was withdrawn in the face of continued Government opposition. David Willetts, Minister for Universities and Science, said the Government believed that the risks involved would be too great if the copying of unregistered designs was made the subject of criminal sanctions, in particular because such rights are harder to become aware of and track than designs placed on a Government register. He said that unregistered design right protection can apply to the whole design, or to separate elements of that design, and such rights could be owned by different people and have different time scales left to run on their protection. This, he said, "could create uncertainty over whether a design could be used as the basis for legitimate activity".

The Bill now returns to the Lords for them to consider the Commons' amendments, before it will be ready for royal assent.

Michael Lindsey, Geldards LLP



LinkedIn and Twitter

Remember that you can keep up to date with news and activity from ITMA and around the profession by following ITMA on Twitter (our Twitter handle is @ITMAuk) and/or joining the ITMA LinkedIn group. The number of followers on Twitter and the number of people joining the ITMA LinkedIn group has been steadily rising since we decided to try out these social media platforms to aid our communications.

Manchester move for Mewburn Ellis LLP

Mewburn Ellis LLP is pleased to announce that its Manchester office has now relocated to new premises at Manchester One, 53 Portland Street, Manchester M1 3LD.
Telephone: 0161 247 7722
Fax: 0330 111 4455



Another of the popular student induction days has been organised for **9 June**. This event will include: an introduction to the commercial context of the IP attorney's work; talks on basic business practice, including professional ethics and client care; and a chance to learn more about CIPA, ITMA and IPReg, the CIPA Informals, and the training and qualification systems for both Patent and Trade Mark Attorneys. It is also a great chance for trainees to meet and share experiences. Based on the feedback from previous years, we believe the

day has value not only for new starters but also for those who have been in the profession for six to 18 months.

The full day costs **£25 + VAT** for CIPA or ITMA members (includes a buffet lunch). There is no charge for attending the afternoon only. The CIPA Membership team is kindly administering the event on behalf of both organisations. Please contact events@cipa.org.uk for more information or to book a place. Hurry – places are limited!

There will also be a December induction day for those joining the profession in autumn 2014.

Addresses for sale

ITMA is offering the following domain names for sale to members:

registeredtrade-mark.co.uk, registeredtrade-marks.co.uk, registertrade-marks.co.uk, trade-markfiling.co.uk, trademarksearch.co.uk, trade-marksfiling.co.uk, trade-markssearch.co.uk, trade-marksworldwide.co.uk, trademarkfiling.co.uk, trademarksfiling.co.uk, trademarksearch.co.uk, trademarksworldwide.co.uk, uktrade-mark.co.uk, uktrade-marks.co.uk

These domain names will expire in **June 2014** and are being sold to the highest bidder (minimum offer £50 each). All money raised will go to the ITMA Benevolent Fund. If you wish to bid for any of these addresses, please send your bids to keven@itma.org.uk no later than **23 May 2014**.



SPIRITED SETTING FOR SPECIAL EVENT

*Keith Havelock recounts the highlights
of our 2014 spring gathering*

06

Do you know what “Fast Fashion” is? How about “Brand Citizenship”? Do you know which (if any) country names can be registered as new top-level domains, or what effect the provisions of the Defamation Act 2013 are having on lawyers’ fees?

You would if you attended this year’s ITMA Spring Conference, held at the Church House Conference Centre in Westminster, London SW1 on 19-21 March 2014. Under the banner of “Media, Pop Culture and the Law”, these and many other interesting questions were aired and debated.

The conference venue was the Rotunda of the Church House Centre, the main meeting place of the Church of England in London, close to Westminster Abbey. Around the Rotunda and directly above the speakers’ dais runs a biblical quotation beginning, “Holy is the true Light and passing wonderful...”,

which perhaps inspired the speakers to give their best. One delegate remarked: “How refreshing to meet in a venue other than a hotel.”

The conference was attended by around 200 delegates and guests (swelled by a further 50 who attended only the opening party or the Gala Dinner), representing 38 countries, and addressed by 15 principal speakers. In her opening speech, ITMA President Catherine Wolfe reminded delegates that the conference was in part a celebration of the 80th anniversary of the Institute and that, in addition, attendance at the conference was assisting the Institute in its support of the London Wildlife Trust.

The keynote address was given by His Honour Judge Hacon of the Intellectual Property Enterprise Court (IPEC), formerly the Patents County Court. He gave his impressions of the new court and warned prospective litigants that he intended to stick to a trial date once set (previously it seemed assumed

that adjournments would be readily allowed). Judge Hacon’s address was followed by papers from Markus Frick (Walder Wyss, Switzerland) and Kieron Taylor (Swindell & Pearson), both on the subject of “Famous marks”. Frick considered international aspects, while Taylor dealt with famous marks in opposition proceedings.

The latter part of the morning featured an update on the Company Names Tribunal from Ben Mooneapillay (JA Kemp) and a paper on UK IPO practice relating to famous and historic names, by Dr Bill Trott of the Registry. Mooneapillay emphasised the need to craft an application correctly, while Dr Trott reviewed familiar cases such as the Elvis, Arsenal and Oxford Blue cases. The remaining papers in the morning session were from Phil Lewis of the OHIM Observatory, who gave an update on his organisation’s activities, including its position on “Goods in transit”, and Andrew Norris (Hogarth Chambers), who gave a



01

well-researched paper on personality rights and the Rihanna case.

Finally, Robert Cumming (Appleyard Lees) provided a raft of information and advice on social media topics and their implications for attorneys.

Next followed the ITMA Benevolent Fund and Institute AGMs, and later the Gala Dinner at the Great Hall of the Institution of Civil Engineers at nearby One Great George Street, Parliament Square, where a feast of fine food and wine, conversation and dancing was enjoyed until late (see our full report on page 8).

The second day began with a panel comprising David Butler (Corsearch), Diane Hamer (BBC) and Richard Pringle (Valideus), which discussed the new top-level domain names. Next, Andrew Bellingall (Daniel Advogados) entertainingly reviewed the defences being put into place to counter ambush marketing at this year's World Cup, and Tara Aaron (Aaron Sanders Plc) presented a US perspective on using copyright to protect well-known marks.

Finally, Howard Ricklow (Collyer Bristow) and Duncan Lamont (Charles Russell) gave papers on brand development through licensing and franchising, and recent cases involving TV and news, respectively. Both papers featured personalities and illustrations, including videos, which held the audience's attention to the last.

In her closing remarks, Catherine Wolfe acknowledged the contribution of her co-chair (and frequent questioner), Chris McLeod, and thanked the Institute's sponsors, in particular gold sponsor Corsearch. So ended a very worthwhile and enjoyable Spring Conference.

Keith Havelock

is a Consultant Trade Mark Attorney with Alexander Ramage Associates LLP



02



03



05



04



06

- 01 Markus Frick (Walder Wyss, Switzerland), Keven Bader (ITMA CEO), Catherine Wolfe (ITMA President) and His Honour Judge Hacon (IPEC)
- 02 Keith Havelock (ECTA) and Rita O'Kyere (Web TMS)
- 03 Richard Pringle (Valideus)
- 04 Miles Beckingham (BT), Rachel Hearson (Walker Morris, Leeds) and Cliff Kennedy (Maclachlan & Donaldson, Dublin)
- 05 David Butler (Wolters Kluwer Corsearch)
- 06 Mutlu Yildirim Kose and Uğur Aktekin (Mehmet Gün & Partners, Turkey)
- 07 Robert Cumming (Appleyard Lees, Leeds)



07



THE LIGHTER SIDE

*Details made all the difference,
writes Triona Desmond*

The conference was a raging success and the attention to detail really made all the difference – from delicious food to great music

The less serious side of the 2014 ITMA Spring Conference kicked off with a drinks reception at the funky Foundation Bar in the heart of Covent Garden. Delegates enjoyed cocktails in jam jars and delicious canapés, although some of us struggled with the more-than-a-mouthful gravy, meat and vegetable-filled Yorkshire puddings! Some delegates had travelled from as far as Paraguay and Mexico, and commented on how relaxed the atmosphere felt. The evening set a warm and welcoming tone for the next few days.

The following morning ITMA's 80th birthday was marked in style as mouth-watering macarons carrying the birthday logo were savoured by all. The day's talks were interspersed by a sit-down lunch, followed by a delicate but delicious selection of desserts – some delegates walked this off, enjoying a tour of London before dinner.

The Gala Dinner was held in the Great Hall of the Institute of Civil

Engineers: an opulent, high-ceilinged room with elaborate chandeliers and impressive portraits. The room was decorated beautifully with striking pink flower arrangements.

Before the sumptuous dinner, delegates were welcomed by Irie J, a soulful singer who sounded so much like Barry White that people initially thought he was miming. After Catherine Wolfe's poignant farewell speech as outgoing President, the singer serenaded her. She seemed mildly mortified, but resisted the urge to flee! The tempo of the entertainment was then "upped" and delegates danced the night away.

On the final day the talks continued and even younger delegates who had partied until the early hours were unable to nod off as videos from artists such as One Direction and Lady Gaga boomed out, introducing talks around merchandising and licensing.

The conference was a raging success and the attention to detail really made all the difference – from delicious food to great music, with a chocolate "mudslide" appearing along the way. By the end of it, everyone had made new friends and we all knew a whole lot more about those crazy pop artists.



- 01)** Bahia Elyafi and Tima Hachem (Grant Thornton Alyafi IP, Lebanon and Qatar) and Rita Sunny-Yangs (GH Sigurgeirsson, Iceland)
- 02)** Keven Bader (ITMA CEO) and Sarjo Saine (Gambia)
- 03)** Ana Vargas Ramirez (Iberbrand, SC, Mexico) and Sandra van Dongen (Knijff)
- 04)** Tara M Aaron (Aaron Sanders, USA) and Robert Cumming (Appleyard Lees, Leeds)
- 05)** José Raúl Simões (SGCR, Portugal), Panos Malamis (Malamis & Associates, Greece), Claudia Kaya (Destek Patent, Turkey) and Kristian Elftorp (CSC Digital Brand Management Services, Sweden)
- 06)** Rachel Harrison and Mona Asgari (Bird & Bird) and Panos Malamis (Malamis & Associates, Greece)
- 07)** Victoria Wisener (Virgin Enterprises), Charles Lloyd (Taylor Wessing) and Donald Pennant (ICI Paints)
- 08)** Hilde Vold-Burgess (Acapo, Norway), Bosco Labardini (Bufete Soni, México), Francesca Warrington (Salomone Sansone & Co, Malta) and Paulo Monteverde (Baptista, Monteverde and Associados, Portugal)
- 09)** Julia House (Albright Patents) and Irie J
- 10)** David Butler (Wolters Kluwer Corsearch), Catherine Wolfe (ITMA President) and raffle winner Sean Corbett (Formula One Management)

Triona Desmond
is a Trade Mark Attorney at Squire Sanders (UK) LLP

MEET AND TWEET... 
... how some of those on Twitter recorded our event

Ben Evans @Very_IP Looking forward to the @ITMAuk Spring Conference later this week

Robert Cumming @robertcumming What should brandowners do when social media goes wrong? Last-minute prep for my talk at @ITMAuk #SpringConference

Cherrie Stewart @ansons_cherrie At the ITMA conference. Looking forward to an informative & exciting programme of lectures in the field of media, pop culture and the law



ITMA @ITMAuk Yum yum. Celebrating ITMA's 80th year with our delegates at our #SpringConference

Sanderson & Co @sandco_ip Session now on Rihanna and her clothing. It's a tough job ... @ITMAuk #SpringConference

Rob Davey @robertdavey Looking forward to @robertcumming speaking on twitter and FB take downs @ITMAuk spring conference soon

Tara Aaron @tara_aaron @robertcumming doing an excellent talk on the risks for brands on social media #itmaspringconference #welldone

Martin Chinnery @martinchinnery Fantastic talk from Andrew Bellingall about ambush marketing at the World Cup #INTA



THE VALUE OF VARIETY

Sacha de Klerk explains how one global legal practice is aiming to take a leading role in encouraging inclusiveness

10



An unprecedented number of drivers are collectively propelling diversity and inclusion onto organisations' leadership agendas. For the legal sector, the momentum is even greater, due to the changing demographic profile of the workforce, a stronger regulatory environment (for example, law firms are required by the Solicitors Regulation Authority to report and publish diversity data), globalisation of the legal sector and client pressures.

In the past, diversity objectives have been driven by legislation (ie the Equality Act) and by "visible" differences between people. While this is still relevant, diversity now means more than tokenism; the

value of diversity is in developing an inclusive workplace, and this means changing behaviours, not just developing tolerance and saying the "right" thing. Instead, diversity today is centred on recognising the differences that make each of us unique, such as life experiences, parental status, education and cultural background. Leading organisations see the value that different perspectives bring to the table and the importance of diversity of thought.

This new perspective provides fresh lines of thinking when considering diversity and moves us on from the question of "How can improving gender balance at partner level impact our business?" to "Do we have the right variety of perspectives to deliver innovative solutions to complex global problems?"

This outlook means organisations can move away from box-ticking exercises and see people for the individuals they are, rather than viewing them as representatives of a group. It is no longer good enough to just have a boiler-plate diversity policy in place and to keep tabs on the demographic breakdown of your workforce. The most successful firms can illustrate the impact of diversity initiatives with clear measures of success relating to recruitment, promotion, retention and staff engagement.

Pressure for change

The pressure for culture change on the legal sector is enormous, with achieving a better gender balance a key target. According to the most recent figures from the Higher Education Statistics Agency, the



Considering the gender demographic in the legal sector up to associate level, firms cannot afford to sit on their hands and must put plans in place to engage and retain working parents

graduate population in the UK is nearly 60 per cent female, which is reflected in the gender balance of the trainee intake among legal firms. (In the IP sector, in particular, women are extremely well-accounted for at trainee level – see box on page 13.) This balance is maintained at associate level, but at partner level the change is drastic: across the top 100 UK law firms only 9.4 per cent of the equity partners are women, reported *The Lawyer* in October 2012, slightly lower than the current figure for female FTSE 250 board members – 9.6 per cent.

So where are all the women going and why are they not making it to the top?

Many attribute this attrition to the progression to parenthood, which may not be compatible with the demands of a legal career. This

more often than not affects the advancement of women because, even when both parents work, it is often the mother who takes the role of primary carer or is most responsible for childcare.

Flexible working can assist those who have a carer role, and has been on the agenda for law firms for well over a decade, yet the take-up of flexible working is still minimal and remains the domain of working mothers. The majority of working mothers across the profession are senior associates and partners the minority.

And, while flexible working is challenging in the fast-paced legal environment, in which visibility is seen to be essential and a long-hours culture is linked to work allocation and career advancement, it is not impossible. However, many women who return from maternity leave with

the intention of adopting a flexible work arrangement don't stay, as they struggle to find a balance between work and family commitments.

For firms, the cost of failing to retain women who do not progress to more senior roles is substantial. For example, the cost of replacing an associate was calculated by the Law Society at approximately £125,000 in its 2010 report on the "Obstacles and barriers to the career development of woman solicitors" (a "conservative" estimate that does not include "the impacts of lost client knowledge, disrupted relationships, and loss of organisational knowledge and legal expertise"). Considering the gender demographic in the legal sector up to associate level, firms cannot afford to sit on their hands and must put plans in place to engage and retain working parents. At the current rate →



→ of progress, our granddaughters will still not be equally represented in the boardroom. Now is the time to be forward-thinking and to make bold moves.

Here at Norton Rose Fulbright, we have improved retention following maternity leave by 14 per cent since 2011 (from 71 per cent to 85 per cent, measured one year following return from maternity leave). We asked all women who had been or were still on maternity leave for their feedback on their experience of becoming a parent at the firm and their input on what changes we could implement that they would value most. We launched a three-part maternity group coaching programme, which includes workshops before leave, during leave as part of a structured keeping-in-touch day, and a returners' workshop. A pilot Managing Parenting Transitions workshop and guide to support managers have also been produced.

Correct focus

Progress should not be predicated on changing or "fixing" women, which is the focus of the majority of workplace gender initiatives. Organisations need to start thinking in an entirely different way to adjust attitudes and see real change. Women are different to men. They communicate differently, lead differently and are motivated by different things. This difference represents an opportunity, rather than a difficulty.

Why is this so important? For a start, the client demographic is

changing and often law firms face a panel of female decision-makers across the table. In addition, clients demand that their suppliers are as diverse as they are and are leveraging their influence down their supply chain. In-house teams want to see their panel firms reflect their own diversity and bring new perspectives to the table. These changes to in-house teams provide an opportunity for law firms to engage with clients in a different but meaningful way. The Law Society has put together a "business case" for diversity, available at lawsociety.org.uk, which offers a compelling case on this subject and also advice.

Gender equality is not just a female issue; the role of women in the workplace is a business issue, which therefore needs to be placed at the top of the agenda by women and men alike

International networks

Norton Rose Fulbright has several women's networks internationally. "Our women's networks are an important asset to the firm, and they offer networking and professional development opportunities for members and our clients," says Jane Park-Weir, co-chair of WIN (Women in Norton Rose Fulbright). The network hosts events that are of interest to women, ranging from workshops on confidence and a Women in Law series of talks with Dame Elizabeth Gloster and Baroness Patricia Scotland to an annual Tennis on the Terrace event. Everyone is welcomed at these events. For example, at a recent internal lunchtime event, attendees discussed their views on some of the themes in Sheryl Sandberg's book *Lean In*, and men joined the debate and offered their views. "We actively engage men in the network because we feel that they are part of the solution to gender equality. This is not just a female issue; the role of women in the workplace is a business issue, which therefore needs to be placed at the top of the agenda by women and men alike," says Park-Weir.

We are also looking at addressing problems at the root. In 2009, only 12 per cent of partners in the London office were female. This was attributed to the fact that no women were promoted for two years in a row, women transferring out of London on international assignments and higher attrition of women partners. Today, 23 per cent of partners are female, 33 per cent of the global executive

committee is female and 40 per cent of the Partnership Council is female.

Part of this change is due to a Careers Strategies Programme (CSP), which was launched in 2010 and designed to strengthen the female partnership talent pipeline. The CSP provides core knowledge and skills development, networking opportunities with partners and senior management, and six formal executive coaching sessions. In 2012 and 2013, women accounted for 60 per cent of partner promotions in the London office. The two linked modular development programmes were the first of their kind in the legal sector: the CSP for female lawyers aspiring to partnership and the Career Strategies Sponsors' Programme (CSSP) for their managers.

Other challenges

Nevertheless, simply having a diverse workforce is not enough to deliver positive outcomes. The most important piece of the puzzle is inclusion – the extent to which individuals feel authentic and valued. If people feel comfortable bringing their whole self to work, they are more engaged and will also bring the full spectrum of their capabilities and renewed energy to the table.

An awareness of unconscious bias (that is, a subconscious preference that can result in, for instance, the tendency for a recruiter to favour employees that have similar traits or characteristics to him or herself) and an understanding of how assumptions based on one perspective or frame of reference can have an impact on decisions relating to recruitment, work allocation and promotion is key. With this in mind, inclusive leadership training has been rolled out to all our partners in Australia and the US and some partners in South Africa and the UK.

We consider the full spectrum of diversity and inclusion challenges and, for example, have a very successful lesbian, gay, bisexual and transgender network. We have also recently launched a network for both Muslim and non-Muslim employees, and external contacts interested in Islamic culture and affairs. Our Family Matters network runs lunchtime seminars for working parents and carers on topics such as family finances, first aid for families,

unhealthy relationships and raising resilient children.

In 2012, we joined the London Living Wage Foundation and committed to paying all employees and on-site contractors the London Living Wage, including apprentices. As founding members of Prime, the legal sector initiative to improve access to the profession for young people from disadvantaged socio-economic backgrounds, we have provided work experience and mentoring to more than 80 people. Also in 2012, we launched a guaranteed interview scheme as part of the Disability Two Ticks initiative and offer guaranteed interviews to applicants with a disability who meet the minimum role criteria.

Looking further, in 2012, Norton Rose Fulbright established a global diversity and inclusion advisory council. The council comprises of the chairman or managing partner from EMEA, Australia, Canada, South Africa and the US, supported by a local partner as diversity champion from each region. It is accountable to global management and reports to the global executive committee on a quarterly basis. The council is led by the Global Head of Diversity, Melbourne-based partner Sally Macindoe, and ensures consistency of effort, purpose and execution in diversity and inclusion initiatives around the world, while sharing best practice across all the Norton Rose Fulbright offices.

The council recognises the – perhaps most important – fact that law firms that are leading the field in addressing diversity and inclusion challenges all have something in common: leadership at the most senior level. This is essential in bringing about the cultural change required to create an inclusive culture in which people can be themselves, and firms that champion diversity from the top are more likely to make progress in changing behaviours and affecting cultural change.

GAINING BALANCE: TRADE MARK FOCUS

In a review of the background of those entering the trade mark and patent professions ("Recruitment and Diversity in the Patent and Trade Mark Professions"), IPReg examined gender balance among trainees and found that, for Trade Mark Attorneys identified as qualifying between 1998 and 2000 from the Trade Mark Attorney register, 43.5 per cent were male and 56.5 per cent were female. In the same period, among trainee Trade Mark Attorneys as identified in the ITMA membership list, 25.4 per cent were male and 74.6 per cent female. As far back as 1995, women formed the majority of recruits to the trade mark profession, and that majority is far higher still for recruits between 2010 and 2012.

However, while women are attracted to the trade mark area, they do not continue to be represented in the same high proportions at more senior levels in firms. And, the report notes, as recruitment into the trade mark profession is dominated by the larger firms, there is a need to ensure that attorneys responsible for recruitment are aware of issues related to diversity.

In its own research completed for the Legal Services Board – "Diversity in the Legal Profession in England and Wales: A qualitative study of barriers and individual choices" – the University of Westminster identified several suggestions for beginning to effect change in assisting both female and minority ethnic entrants to the profession, including:

offering bursaries for the Legal Practice Course (LPC) and Bar Professional Training Course (BPTC) stages, and for trainees and pupil barristers;

requiring the disclosure, and monitoring, of diversity data within firms and across specialisms;

providing diversity training;

supporting outreach programmes; and

encouraging the development of formal support networks and mentoring schemes and supporting role models.



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TAKE FIVE

When it comes to assignments, it pays to slow down and answer some deceptively simple questions before going forward, advises Catriona Smith

Trade mark assignments should be easy. But many things can go wrong if you aren't careful. What you do before putting pen to paper can make all the difference between your assignment achieving what you want, or being a disaster.

Crucial questions

1) Which marks are being assigned?

Are all the marks and applications that the assignor owns going to be assigned? Will that include all those specifically listed? Or is the intention to assign only those marks that are listed, with any not listed being retained by the assignor? It may be that the assignor is only assigning marks covering certain territories, retaining the rest for themselves.

Wherever ownership of marks is split, questions arise as to what happens when the marks later brush

up against each other. Businesses change over time, as Apple Corps Limited and Apple Computer, Inc learned to their cost, at one stage spending 100 days in court in the course of a long-running dispute over use by Apple Computer of the APPLE mark in relation to computers for music, long before the iTunes software was ever dreamt of. Thinking through the possibility of a future clash can avoid conflict at a later date.

2) Whither goes goodwill?

It is tempting to assign goodwill without much thought, but that goodwill will be fairly meaningless if nothing else is transferring. If the business – including manufacturing capability, promotional material, business records and staff – does not all transfer, what goodwill has the assignee really acquired?

3) What title?

Assignments often say that the marks are being assigned with “full title guarantee”. That phrase has a specific meaning under the Law of Property (Miscellaneous Provisions) Act 1994. It implies that: (i) the proprietor has the right to dispose of the marks; (ii) the proprietor will do all it reasonably can to give the title it purports to give, at its own expense; (iii) the assignment is free from all charges, encumbrances and adverse rights, except any about which the proprietor does not know and could not reasonably be expected to know. Is that what the assignor thinks it is promising?

An alternative is to assign with “limited title guarantee”. Instead of point (iii), the assignor implies only that it has not, and as far as it is aware no one else has, charged or encumbered the mark or granted any third-party rights under it. Is the assignee happy with that? Or does it want to reduce the price to reflect the additional risk it is bearing?

Insolvency practitioners will sell the mark with “such right, title and interest” as they may transfer. So the assignee buys “as is” – not the time to be agreeing to pay a high price.

4) Which assignor?

It is quite remarkable how often a trade mark turns out to be registered

It is tempting to assign goodwill without much thought, but that goodwill will be fairly meaningless if nothing else is transferring. If the business does not all transfer, what goodwill has the assignee acquired?



in the name of a different entity from the expected one. Sometimes this can be because a company name change hasn't been registered on the relevant register, or because an earlier assignment hasn't been recorded. In both cases, steps will have to be taken to correct the register before the new assignment can be recorded, which can be expensive and time-consuming, especially if an earlier assignment, or proprietor, has vanished into thin air. An early register search can save later heartache.

5) Which assignee?

Answering this question may not be as easy as it seems. It may be that a business is being broken up into several parts, with different purchasers for each of those parts. Some of the marks may be used by more than one of the resulting businesses. A choice will have to be made as to who the new owner should be. The other businesses using the marks will either have to agree to stop using them or will have to be licensed to continue, even after they are in separate ownership. This requires careful thought, before decisions are made, and may require agreement as to what should happen if the marks end up in the "wrong pockets".

The formalities

While trade marks can be transferred by way of gift, or by testamentary disposition or operation of law, the most usual method is an assignment.

Assignments need to comply with the legal requirements that make an agreement legally binding. In English law, that means there must be an offer, acceptance, consideration (payment), an intention to create legal terms, certainty of legal terms and, for trade mark assignments, a document in writing signed by the assignor (UK marks) or by all the parties (Community Trade Marks). Making sure the person signing has authority to sign may be obvious, but



is often overlooked. If there is no consideration, the assignment will be effective if it is by way of deed.

Other clauses will cover matters such as warranties, further assurance clauses (for instance, outlining who pays for all the recordal work or what help the assignor will give with proving genuine use), and the right to sue for past infringements.

Recordal

There is no deadline for recordal, and there may be good reasons not to rush to record. However, only the registered proprietor can oppose or sue third parties. A registered proprietor's ability to recover costs in infringement proceedings will be affected if it doesn't register the assignment within six months without good reason.

There are also provisions in both the Trade Marks Act 1994 and the Community Trade Marks Regulation to the effect that an assignment cannot be enforced against a third party acquiring a later conflicting interest in ignorance of the earlier right. Registration has advantages.

Putting it right

Experience shows that most things that go wrong can be put right. For example, while no assignment (including *nunc pro tunc* assignments) can take effect with a date in the past, confirmatory assignments will often achieve an equally good result. Assignments are deceptively simple. Time spent on getting the answers to some simple questions can save much time and expense later.

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Latin America's constant economic growth and business opportunities make the region very attractive for investment and activity. But, just as the countries that range from Mexico down to Argentina vary widely from a cultural perspective, they also offer differing challenges for those pursuing effective trade mark protection. My aim with this article is to offer an insight into trade mark issues and requirements in Argentina, and across this exciting region.

Argentine essentials

What and who. In Argentina, any word or sign having distinctive capacity – including containers, labels and slogans – can be registered in connection with products or services. The applicant can be anyone with a legitimate interest.

Duration. The duration of registration is 10 years, renewable indefinitely for similar terms.

Use requirements. Use within the five years preceding the expiration date is necessary to be eligible to renew the registration. Anyone may bring action in the courts to have a registration declared lapsed if the trade mark has not been used in Argentina within the five years preceding the commencement of the lapsing action.

Classification. Argentina adopted the Nice Classification of goods and services for purposes of registration of trade marks. A separate application is required for each class. There is no multi-class system. Thus, a separate application is required to protect each class of goods and services.

Information required. The following information and material is required for a trade mark application:

- Full name and address of applicant.
- Specimens of prints of trade mark, unless it is a plain word.
- Identification of the goods or services to be covered. The full class can be covered.
- A Power of Attorney ("POA") including Notarial attestation, and Consular legalisation or Apostille.

- POA must be received no later than 40 working days after the filing of the application.
- If priority is to be claimed under the Paris Convention, the date and number of the basic foreign application followed within not more than three months by a certified (unlegalised) copy thereof.

Renewal. A Sworn Declaration by the applicant that the trade mark has been used within the five years preceding the expiration date is needed. No legalisation is necessary. Use on any product (not necessarily those covered by the registration) is sufficient, as well as use for services or as part of a trade name. The Declaration should specify goods, service or activity for which use has been made.

Opposition. Once a trade mark application has been filed, it takes approximately two months to be published for opposition purposes in the *Trademark Gazette* (*Boletín de Marcas*). As from the publication date, there is a non-extendable one-month period to file opposition. It is the responsibility of the Argentine Trademark Office to serve notice of oppositions upon applicants through the publication of oppositions in the *Trademark Gazette*. As of the date of publication of the opposition, there is a 60-day window in which to obtain copies of such oppositions at the Trademark Office.

Once the 60-day term ends, the applicant will have one year to reach a friendly settlement with the opposer or take the case to court, in the absence of which the application will be abandoned. If the matter is not resolved amicably as a result of private negotiations, the applicant should complete mandatory pre-trial mediation proceedings – in which an attorney for each party is required by law to participate – prior to instituting court action.

Mediation. It is relevant to mention that Argentina is presently the only Latin America country in which mediation is mandatory in connection with trade mark →

LATAM IP: FAST FACTS

SINGLE OPTION?

It is not possible to obtain trade mark registration for all countries in the region with a single application. Trade mark applications should be filed on a country-by-country basis.

TIMING TROUBLE

While some Latin American trade mark offices suffer from considerable delays in the prosecution of applications (with responses taking years rather than months), in other countries a trade mark registration may be obtained within a six-month term if no opposition or official action is posed.

PROTOCOL NOT POPULAR

Few Latin American countries are members of the Madrid Protocol.

DELAY DANGER

The majority of the countries require notarisation and legalisation of Power of Attorney and other documents, which can cause delays due to the need to obtain these in the countries of origin.

CLASS CAUTION

Not all countries allow multi-class trade mark filings.

WELL-KNOWN MARKS

Although well-known trade marks are recognised and gain protection through court decisions, few countries have included special provision for their protection in their trade mark law.

THAT'S NICE

All countries follow the Nice Classification of goods and services.

LATAM AT A GLANCE

OPPOSITION



COUNTRY	CAN APPLICATION BE OPPOSED?	OPPOSITION PERIOD BEGINS	OPPOSITION PERIOD DURATION
Argentina	Yes	Day after the application is published in the Trade Mark Gazette	30 days
Bolivia	Yes	Day the application is published	30 days
Brazil	Yes	Day the application is published in the Official Bulletin	60 days
Chile	Yes	Day the application is published in the Official Bulletin	30 business days
Colombia	Yes	Day the application is published in the Official Bulletin	30 business days
Costa Rica	Yes	Two months from the first publication date	60 days
Cuba	Yes	Day of publication	60 days
Dominican Republic	Yes	Day of publication	45 days
Ecuador	Yes	Day the application is published in the National Gazette	30 business days
El Salvador	Yes	First publication date in the Official Gazette	60 days
Guatemala	Yes	First publication date in the Official Gazette	60 days
Honduras	Yes	Day of last publication	30 days
Mexico	No		
Nicaragua	Yes	Day legal ad is published in the Gazette	60 days
Panama	Yes	Day after the application is published	60 days
Paraguay	Yes	Day of publication	60 days
Peru	Yes	First working day following publication	30 days
Uruguay	Yes	Date of publication	30 days
Venezuela	Yes	Date of publication	30 days

Warning! LatAm opposition procedures do not allow extension terms.

TRADE MARK DURATION/RENEWAL



	GRACE PERIOD FOR RENEWAL	USE COMPULSORY FOR RENEWAL?
Argentina	No	Yes (declaration of use)
Bolivia	Yes (6 months)	No
Brazil	Yes (6 months)	No
Chile	Yes (30 days)	No
Colombia	Yes (6 months)	No
Costa Rica	Yes (6 months)	No
Cuba	Yes (6 months)	No
Dominican Republic	Yes (6 months)	No
Ecuador	Yes (6 months)	No
El Salvador	Yes (6 months)	No
Guatemala	Yes (6 months)	No
Honduras	Yes (6 months)	No
Mexico	Yes (6 months)	Yes (declaration of use)
Nicaragua	Yes (6 months)	No
Panama	Yes (6 months)	No
Paraguay	Yes (6 months)	No
Peru	Yes (6 months)	No
Uruguay	Yes (6 months)	No*
Venezuela	No	No

POA?
YES
(All countries)

TRADE MARK TERM (YEARS) OF ALL COUNTRIES
10 YEARS
(With the exception of Venezuela, with 15 years)

*Article 187 of Law No 19.149 modifies Article 19 of the Law No 17.011, establishing the mandatory use of a registered trade mark and implementing the possibility of initiating a cancellation action for non-use in certain circumstances. Nevertheless, for the purposes of renewal, it is not required to submit evidence regarding the use of the trade mark.



TRADE MARK PROSECUTION

Required documents and deadlines

The documentation to be submitted when filing the trade mark application, as well as the deadlines for the late filing of same may vary from country to country.

COUNTRY	PERIODS FOR LATE FILING	
	POA	PRIORITY DOCUMENT
Argentina	40 days	90 days
Bolivia	60 days	9 months
Brazil	60 days	4 months
Chile	60 days ¹	90 days
Colombia	60 days ¹	3 months ⁴
Costa Rica	3 months	3 months
Cuba	60 days	3 months
Dominican Republic	2 months	3 months
Ecuador	60 days ¹	6 months
El Salvador	3 months	3 months
Guatemala	30 days ¹	30 days ¹
Honduras	30 days ¹	30 days ⁵
Mexico	2 months ¹	No ⁶
Nicaragua	2 months	3 months
Panama	2 months ²	9 months
Paraguay	60 days	90 days
Peru	60 days	9 months ³
Uruguay	30 days	90 days
Venezuela	No	9 months ³

- 1) Counted as from official notice.
- 2) Within this term it is also necessary to file a Declaration of Existence.
- 3) Counted as from the filing date of the priority application.
- 4) It is possible to file a scanned copy.
- 5) Legalisation is required.
- 6) It is only necessary to mention the filing date and number of the priority application.



Argentina	Guatemala	Bolivia
Chile	Nicaragua	Brazil
Colombia	Panama	Ecuador
Costa Rica	Paraguay	Honduras
Dominican Republic	Peru	Mexico
El Salvador	Uruguay	Venezuela

REGIONAL DIVISIONS

CAFTA-DR:

Dominican Republic, Costa Rica, El Salvador, Guatemala, Honduras, Nicaragua and the US.

THE ANDEAN COMMUNITY:

Bolivia, Colombia, Ecuador and Peru. Argentina, Brazil, Chile, Paraguay and Uruguay are associate members.



MERCOSUR:

Argentina, Brazil, Uruguay and Paraguay, Venezuela, Chile, Colombia, Ecuador, Peru and Bolivia are now associate members. A Protocol for the Harmonization of Rules on IP in the Area of Trademarks, Indications of Source and Appellations of Origin was adopted in 1995 to harmonise trade mark legislation and practice within the Mercosur countries. At present, however, Argentina and Brazil have not yet ratified this Mercosur Protocol, so, while in principle it is binding on Paraguay and Uruguay, it has never been put into practice.

Online issues

The rate of trade mark infringement on online auction sites in Argentina has increased notably in recent years. Most of these sites have adopted IP rights programmes to address the claims filed by rights holders.

In this regard, notice and takedown proceedings are a cost-effective solution for dealing with this problem and reduce the quantity of counterfeit products available via the internet.

There is no specific regulation under Argentine law regarding the liability of internet service providers (ISPs). Some bills were discussed in Congress, but were not approved. Consequently, the general regime on contractual or tort liability and related statutes apply.

To ascribe liability for an act or omission, the following standards must be proved:

- unlawful conduct;
- damage;
- a causal relationship; and
- determination of liability.

In the absence of specific regulations governing ISP liability for IP infringements, the courts have addressed the matter pursuant to the general principles of tort liability, particularly in cases filed by actresses and models against web search engines such as Google and Yahoo!. The question before the courts as to whether ISPs face liability for the content published on the websites is controversial. Some courts have held that ISPs are responsible for the content of the website, while other courts have rejected liability claims.

Several of these decisions have been appealed before the Supreme Court – the highest court in Argentina. The Supreme Court is expected to issue a decision that should put an end to this controversy and rule on the liability criterion to be applied to ISPs for damages caused by the contents of the websites that they host.

→ matters. The experience of pre-trial mediation has been very positive and fruitful for the parties involved. If mediation is unsuccessful, a complaint in court should be filed before the expiration of the one-year term. Such action is in the nature of a full lawsuit before the Federal Courts, which lasts approximately 18 months, until a Court of First Instance hands down a decision. If the opposition is withdrawn after the lawsuit has been filed, the opponent will be liable for the other party's legal costs.

The opposition system in Argentina is such that the filing of an opposition automatically blocks the prosecution of an application, at a low cost, forcing the applicant to move forward towards obtaining a satisfactory settlement based, in most cases, on the amendment of the specification of goods or services, letters of undertaking, etc.



SINGLE- OR MULTI-CLASS APPLICATIONS

SINGLE

Argentina, Bolivia, Brazil, Ecuador, Guatemala, Honduras, Mexico, Paraguay, Venezuela

MULTI

Chile, Colombia, Costa Rica, Cuba, Dominican Republic, El Salvador, Nicaragua, Panama, Peru, Uruguay

Alert system. The Argentine Tax Authorities, by AFIP/Customs Resolution No 2216, has created a so-called “alert system”, which became effective on 3 April 2007, whereby trade mark owners can obtain information and inspect goods identified with their trade marks before those goods are released into the marketplace.

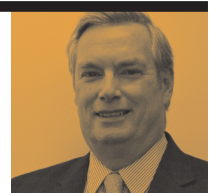
To benefit from the alert system, trade mark owners must provide Customs with the following:

- a certificate of trade mark registration issued by the Argentine Trademark Office;
- identifiable features of the genuine goods, including samples;
- positioning of the goods in the Mercosur customs Classification of Goods (*Nomenclatura Común del Mercosur*);
- ports of entry to Argentina of legitimate goods; and
- the name, fax number and email address of a local representative or attorney.

Registration of trade marks with Customs will be valid for two years, renewable for similar periods of time. The alert system is an important tool through which trade mark owners can control the importation of counterfeit goods and parallel importation of genuine goods into Argentina.

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GOING BEYOND GOOGLE

Simple online searches may leave you missing out on crucial evidence in IP investigations, warns Graham Robinson

20

My colleagues and I are frequently asked whether the availability of such a great deal of information online has killed, or at least seriously wounded, the business of investigations when it comes to IP rights infringement questions. While it is true that online sources can sometimes provide enough information to enable judgements to be made, brand owners and their legal advisers should be wary of basing decisions on information obtained solely through online research.

I am old enough to remember the genesis of the internet as a widely used commercial tool. More years ago than I care to remember, I was a trainee solicitor at a major London law firm. There was a locked office housing a machine connected to some online wizardry that was accessible only to a privileged few. "The internet" was talked about in hushed tones.

Nowadays, of course, access to the internet is nearly universal. People have access not only on their desktops, but also on their phones and tablets (and soon via watches, glasses and so on, it seems). Twitter, Facebook and other social networking sites make information not only readily available but at times difficult to escape. Many of our clients now have dedicated research departments capable of obtaining information from around the world. One of the traditional services provided by any IP investigator, the trade mark use search, can often be completed in a few minutes to some degree of satisfaction if the mark can be found on the proprietor's website. Job done. No need for investigation. Or so clients assume.

However, a 2012 survey by Harris Interactive found that 98 per cent of Americans distrust the information

they find online.

The two major reasons were that the information was believed to be outdated or self-promotional. In our experience, outdated and self-promotional material is often found on the websites that are assumed to be accurate, such as a company's own website. And there is every reason to be cautious. For example, finding a product or service on a company's website is no guarantee that it is currently on offer, that it has recently been offered or that it is offered in the particular country of interest.



As many have discovered, Google Street View™ is another tool that can be useful. However, the images available may not be entirely up to date, so it is difficult for users to be absolutely confident that an online image of a particular premises is current.

Even some official databases have idiosyncrasies of which less experienced investigators may not be aware. For example, individuals frequently have several different listings as a company officer at Companies House. As a result,

it is all too easy to fail to identify all the companies with which an individual is involved. And, while Companies House accepts data provided to it in good faith and places it on the public record, it does not verify or validate the information.

Other very well regarded commercial databases will derive information from official sources such as Companies House, and may also obtain information through interviews with representatives of companies. These are therefore valuable resources, but it is usually worthwhile doing additional research to corroborate information drawn from interviews, which may be inaccurate or out of date.

Unmoderated or crowd-sourced websites can also be an issue. We recently worked on a case in which our client had found information on Wikipedia (which is based on freely contributed content from volunteers) indicating that the assets of a trade

mark owner had been transferred to a third party. The client concluded that there had been no subsequent use of the trade mark. When we were instructed to confirm the finding we discovered that the mark had been transferred to a different entity and was still very much in use. Had the client relied on Wikipedia alone, the consequences could have been serious.

Investigators are frequently asked to examine businesses whose existence is found online and that appear to be infringing a third party's IP. The businesses may provide telephone numbers, physical and email addresses, and have the veneer of authenticity. However, when you dig below the surface, it often becomes apparent that there is no substance to the business. Sometimes, it will be a bogus website established for fraudulent purposes.

While there are legal caveats to carefully consider, sophisticated



DEEPER DATA: HOW TO IMPROVE YOUR RESEARCH

If you aren't ready to call in an expert, here are some key points to consider:

Corroborate contact and ownership information through several sources.

Check any local search engines available to give your research the broadest possible reach.

Ensure you have access to language skills relevant to your key markets, so that you can search non-English sites and sources.

Enhance and confirm your online search results with on-the-ground human intelligence, including interviews.

➔ investigation companies will deploy their own covert resources to facilitate their information gathering. That may include setting up front companies, email accounts and websites. It takes the experience of daily research in this area to become adept at detecting unreliable or false information.

Many companies now trade globally and with emerging-market nations, and those investigating IP issues therefore need to be able to find, translate and understand online information in a variety of languages. Automated online translations have severe limitations, so access to sophisticated language skills is an issue. Farncombe has devoted considerable attention in recent years to recruiting staff with fluency in western European, eastern European, Latin American and Asian languages – including Russian, Portuguese and Arabic, and two native Chinese speakers.

Just because information is not found via Google, it does not mean it is not on the internet. Although Google is reportedly the most-used search engine, it does not thoroughly index the deep web, which includes library catalogues, official government documents, phone books and other useful data. Similarly, if you are looking for information from Russia, China, South Korea or Japan, should you use Google or would it be better to use Yandex, Baidu, Naver or Yahoo!? What about metasearch engines, which retrieve and aggregate data from a variety of sources, including other search engines and databases? An investigator's starting premise should be that the information is

there, and, if it isn't initially found, then another path must be tried.

The work requires skill, creativity, perseverance, a methodical approach, experience and some understanding of the subject to be effective.

Human intelligence

Once you have found the information you need online, is that the end of it? It comes from an apparently official source, such as the company's website, and it fits with what you expected, so that's all you need, right? Maybe.

Ideally, you should be able to confirm the information through interviews with people who are well placed to provide corroboration – for example, company representatives, customers, suppliers and distributors. Frequently, our clients have concluded that a mark either is or is not in use because they found what they believe to be incontrovertible evidence online. Interviews with sources later reveal that, in fact, the opposite is the case. Similarly, it may seem that a business is not trading in certain goods (often they have been warned by a brand owner not to do so) because those goods do not appear on its website. However, when you talk to the company it will quite happily offer the same products for sale.

A thorough investigation usually involves two indispensable elements: detailed public records research and targeted human source enquiries. Online information should never be regarded as fact. It is too easy to fabricate or simply get wrong.

We were recently asked to arrange delivery of documents to an individual in the north of England. Everything on the public record indicated that he lived at a certain address. Land Registry records confirmed that he owned the property. He had appeared on the electoral roll at the address for many years, and the same address was also recorded with his Companies House appointments. However, when we visited the property, we were told by neighbours that the individual had been working overseas for many years and the house was occasionally tenanted. Through our conversations with the neighbours we were able to identify the estate agent the individual used to arrange tenants, and through the estate agency we were able to open a line of communication with the householder overseas. That's a good illustration of both the limitations of public records and the value of interviews.

It may seem self-serving for an investigations company to recommend that clients leave all research to it. Certainly some online research can be conducted quickly and easily, and an initial internet search can sometimes provide enough information for judgements to be made. However, organisations rarely have the time, resources or expertise to conduct research as efficiently and cost-effectively as experienced investigators. Moreover, very few clients will have the skills, persistence or desire to identify, locate and interview sources who may prove elusive and unfriendly, but whose contribution to an inquiry may be invaluable.

Graham Robinson

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Graham is a former litigation lawyer and now specialises in IP investigations for brand owners and their legal representatives.



Queensberry: the final round?

A clear opening strategy might have shortened this fight, suggests Katy Cullen

This case is the third and hopefully final round in a dispute involving the mark QUEENSBERRY. The Claimant, Boxing Brands Limited (“BBL”), initially obtained an interim injunction against four Defendants who were all connected with Sports Direct. At trial, the Court found in favour of BBL and held that infringement had occurred in relation to clothing. At the subsequent hearing to determine the consequences of the judgment, it transpired that the trial had not addressed:

- i) whether the Defendants’ QUEENSBERRY sports equipment infringed the Claimant’s marks; and
- ii) whether the Court should order an inquiry on the Claimant’s cross-undertaking in damages.

Sports equipment

Mr Justice Birss was not impressed by both parties’ failure to initially address the issue of use beyond clothing. He considered BBL had failed to ask for details of goods other than clothing because, if it had been given such additional information, it would then have had to take action in relation to it. Likewise, the Defendants should have asked the Claimant to clarify whether any other goods were considered to infringe. He therefore went on to consider the merits.

The Defendants’ sign at issue was the device mark QUEENSBERRY, as shown on the right. This was held to be similar to the Claimant’s earlier marks, which included the word mark QUEENSBERRY.

BBL also successfully argued that the Defendants used or would use the stand-alone word QUEENSBERRY

and that this was identical to the Claimant’s earlier marks for QUEENSBERRY and similar to its earlier marks for QUEENSBERRY RULES.

Having found the Defendants’ marks identical and similar to BBL’s earlier marks, the Judge went on to analyse the sporting equipment that the Defendants provided in a schedule and categorised as:

- a) goods ordered prior to the injunction;
- b) goods they had intended to order; and
- c) additional items the Defendants envisaged ordering in the future (this list was subsequently changed to “additional items that the Defendants intended to order”).

After a detailed analysis of the goods, it was held that most items

did infringe, but seven kinds of items did not.

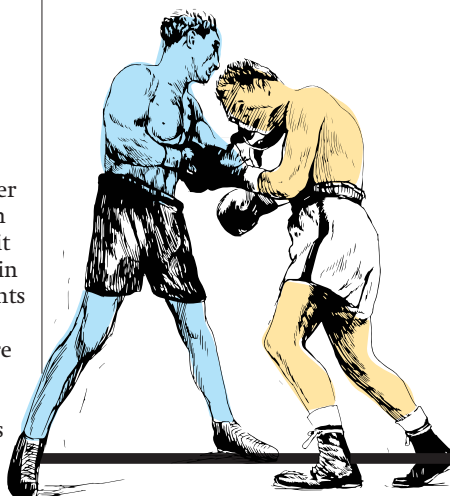
On cross-undertaking

The interim injunction restrained the Defendants from making sales of goods beyond clothing. As one would expect in this scenario, BBL had provided a cross-undertaking in damages. The Defendants argued that, to the extent that any of its sporting equipment did not infringe BBL’s earlier rights, it was now entitled to an enquiry.

However, in exercising his discretion, the Judge considered an enquiry would be costly and unmerited. He was not satisfied that the Defendants intended to launch a boxing equipment range separately from clothing. As such, they suffered no real loss caused by the interim injunction. Had he found that all or substantially all of the Defendant’s boxing equipment range did not infringe any of BBL’s rights, he might have directed an enquiry.

Comment

One can understand why the Defendants would not invite BBL’s opinion on infringement, as BBL would likely claim infringement by all goods. However, the case does illustrate that, if clarity is not initially sought, further disputes are likely to arise in the long run.



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Greek goodwill gets go-ahead

The Court confirmed the value of this dairy designation, reports Salmah Ebrahim

The Court of Appeal has confirmed a trial Judge was entitled to find in favour of Claimants who had brought proceedings to restrain the Defendants from passing off American-made yoghurt as “Greek yoghurt”. The trial Judge had not erred in concluding that a substantial proportion of Greek yoghurt buyers in the UK thought the product was made in Greece and that, because this mattered to them, describing yoghurt not made in Greece as Greek yoghurt involved a material misrepresentation, causing actual damage.

Background

Chobani UK Limited and Chobani, Inc (collectively “Chobani”) appealed against the trial judge’s finding in favour of FAGE UK Limited and FAGE Dairy Industry SA (collectively “FAGE”) in relation to its claim to restrain Chobani from passing off its American-made yoghurt as “Greek yoghurt”.

FAGE had imported from Greece and sold throughout the UK yoghurt it described as “Greek yoghurt” since the mid-1980s. In September 2012, Chobani introduced yoghurt it made in the US, which it also described as Greek yoghurt, into the UK.

FAGE argued a valuable goodwill had been generated under the phrase “Greek yoghurt”, denoting a yoghurt made in Greece, having particular qualities of thickness and creaminess, and that FAGE shared in that goodwill. It followed that sale of Chobani’s US-made “Greek yoghurt” amounted to passing off; although Chobani yoghurt’s thick and creamy texture had been achieved by

straining, the product had not been made in Greece. FAGE also relied on a 25-year-old labelling convention in the UK in accordance with which use of the description “Greek yoghurt” is limited to yoghurt that has been made in Greece and rendered thick and creamy by straining. FAGE also pointed to the UK practice of using the phrase “Greek-style yoghurt” to describe yoghurts that were not made in Greece, whose thick and creamy texture had been achieved through the addition of thickening agents.

At the appeal, Chobani contended that the phrase “Greek yoghurt” was a general term, which was entirely apt to describe a very broad range of products, and that FAGE had wholly failed to prove the phrase had become sufficiently distinctive of a defined category of goods so as to provide a proper foundation in law for a passing off claim. Chobani further sought to rely on a point not argued before the trial judge, namely that the Court had no power to grant injunctive relief to protect geographical indications other than pursuant to and in conformity with the provisions of Regulation (EU) 1151/2012 (the “Regulation”) relating to Protected Denominations of Origin and Protected Geographical Indications.

Issues

The issues were summarised as falling under two headings:

- 1) *Distinctiveness and deception*
 - What was the meaning of distinctiveness in this context?
 - What degree of distinctiveness must be established to sustain a claim of extended passing off?

2) *The Regulation*

- Did the Regulation preclude all national laws that prohibit the potentially misleading use of geographical denominations?

The law

This case relates to what is called extended passing off. In this type of case the claimant alleges that the name under which the goods are sold has acquired a secondary meaning as indicating goods with defined qualities so that it distinguishes goods sold under the name from competing goods. The reputation in the name is shared by those who produce goods with the distinctive qualities and sell them under the name relied on. The authorities¹ established:

- 1) Geographical denominations are *prima facie* descriptive of many different kinds of goods. Nevertheless, names that were at one time descriptive may be protected in a passing off action if they acquired a secondary meaning and so became distinctive of the goods of one or more traders.





The trial Judge had been entitled to find that a substantial proportion of Greek yoghurt buyers in the UK believed the product came from Greece

secondary meaning, extended passing off is not limited to geographical names.

- 2) Advocaat and Jif Lemon authoritatively explained the essential elements of a passing off claim: goodwill, misrepresentation and damage. A claimant must show that its name is sufficiently well known and sufficiently distinctive that the activities of the defendant, in using the same or similar name in relation to different goods, amounts to a misrepresentation that is calculated to cause it damage.
- 3) A claimant must establish a likelihood of confusion among a substantial number of persons.
- 4) Extended passing off is no different in principle from conventional passing off. Although the earlier cases on extended passing off related to geographical names, provided the name relied on has the necessary
- 5) A claimant in an extended passing off case is entitled to protect itself against the erosion of the distinctiveness of the name of its goods and so the loss of its goodwill.
- 6) A claimant in an extended passing off case must show that the class of traders of whose products the name is said to have become distinctive can be defined with reasonable precision.
- 7) Extended passing off should not trespass beyond the legitimate area of protecting goodwill into the illegitimate area of anti-competitiveness.
- 8) European Union law did not preclude the application of national rules for the protection of geographical denominations that did not fall within the material scope of the Regulation.

Applying the law

In light of the preceding points and based on the evidence, the trial Judge had been entitled to find that a large proportion of Greek yoghurt buyers in the UK believed the product came from Greece, and further believed that the description conveyed that the yoghurt to which it was applied was in some way special. This proposition had powerful support from:

- a) trade witnesses;
- b) the labelling convention in the UK;
- c) advice warning Chobani that describing its yoghurt as Greek yoghurt in the UK would indicate it was made in Greece;
- d) the premium price of Greek yoghurt in the marketplace; and
- e) Chobani's own recognition of the reputation enjoyed by Greek yoghurt and its determination to take commercial advantage of it.

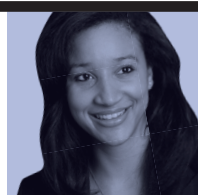
The class of traders of whose products the phrase "Greek yoghurt" had become distinctive had been defined with reasonable precision, to comprise those traders whose yoghurt had been made in Greece and rendered thick and creamy by straining. Traders who made yoghurt in accordance with that specification could join the class and complain of the misuse of the phrase, provided they had used it for a sufficient period of time so as to acquire a share in the goodwill associated with it.

¹⁾ J Bollinger and others v Costa Brava Wine Co Limited (No 2) [1961] 1 WLR 277 (the Spanish Champagne case); Vine Products Limited and others v Mackenzie & Co Limited and others [1969] RPC 1 (the British sherry case); John Walker & Sons Limited v Henry Ost & Co Limited [1970] 1 WLR 917; Erven Warnink Besloten Vennootschap and another v J Townend & Sons (Hull) Limited and another [1979] AC 731 (the Advocaat case); Reckitt & Colman Products Limited Borden Inc [1990] RPC 341 (the Jif Lemon case); Chocosuisse Union des Fabricants Suisse de Chocolat v Cadbury Limited [1999] RPC 826 (the Chocosuisse case)

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Micro makes its mark

Alex Watt was a bit surprised that this appeal was a success

Investrónica, SA (“Investrónica”) has successfully appealed a decision of the Fourth Board of Appeal of OHIM, which had rejected its opposition to the registration of a figurative mark in class 9 (photographic apparatus and instruments, digital cameras, interchangeable lenses, and parts and accessories therefor as far as included in class 9), on the basis that there was a likelihood of confusion with an Investrónica mark.

Background

In December 2008, Investrónica opposed the registration of the figurative mark based on its earlier Spanish figurative mark (both shown on the right). In December 2010, the Opposition Division upheld Investrónica’s opposition, which was made pursuant to Article 41 of Council Regulation (EC) 207/2009 (“the Regulation”).

As the goods in question were identical, the Board of Appeal was wrong to find that there was no likelihood of confusion between the marks

Olympus Imaging Corp’s successful appeal annulled the decision of the Opposition Division, on the basis that the signs were dissimilar and there was no likelihood of confusion. It was held that the common word element “micro” was descriptive, so could not be viewed by the relevant public as the distinctive and dominant element of the marks. The distinctive and dominant elements of the marks (the stylistic and colour elements) were found to be so different as to not create a likelihood of confusion within the meaning of Article 8(1)(b) of the Regulation.

General Court

Investrónica argued that the mark was contrary to Article 8(1)(b) of the Regulation and based its argument on:

- the descriptiveness of the word “micro” did not necessarily mean that it cannot constitute the distinctive element of the figurative mark;
- the visual difference between the signs was low and was offset because the signs are phonetically identical; and
- the signs were conceptually identical in that they had the same meaning in the relevant language.

Therefore, it claimed, due to the strong visual similarity, the phonetic and conceptual identity, and the identity of the goods, there was a likelihood of confusion within the meaning of Article 8(1)(b).

The General Court upheld the appeal and applied Peek & Cloppenburg and van Graaf v OHIM – Queen Sirikit Institute of Sericulture (Thai Silk), which says that certain circumstances may justify that a descriptive element of a mark has a dominant character. The Court stated that “the public eye is necessarily attracted” to the MICRO word element, so it could “only be considered as dominant, even assuming it was descriptive”.

The General Court held that the marks were conceptually and phonetically identical, and that they were “visually highly similar”. As the goods in question were identical, the Board of Appeal was wrong to find that there was no likelihood of confusion between the marks.

Likelihood of confusion

While it is not sufficient to compare only the colour and stylistic elements of a device mark when judging likelihood of confusion, it is surprising that a word as descriptive as “micro” should be given protection because of its dominance. It seems likely that Investrónica registered the sign MICRO as a device precisely because it could not register the word MICRO as a word mark for its “micro” products because it would be descriptive; to provide protection because it is the dominant element allows it to have successfully circumvented that.

THE OLYMPUS PROPOSED MARK

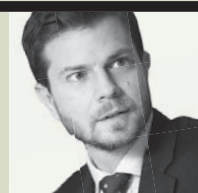


INVESTRÓNICA'S REGISTERED MARK



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Forever fall-out

The strength of words in a combined mark was reiterated, reports Vlotina Liakatou

Aloe Vera of America, Inc (“the Applicant”) applied to register as a Community Trade Mark the figurative mark shown on the right, incorporating the image of a bird of prey and the word FOREVER for drinks and juices in class 32.

The application was opposed by Diviril – Distribuidora de Viveres do Ribatejo, Lda (“the Opponent”) – on the basis of its earlier Portuguese registration for the figurative mark 4 EVER, shown on the right, covering juices in class 32.

The Opponent was put to proof of the use made of the earlier Portuguese mark. The OHIM Opposition Division held that the evidence submitted was sufficient to prove genuine use. It also found that a likelihood of confusion existed on the part of the relevant public.

The Applicant appealed, challenging the Opposition Division’s decision on both grounds. The Board of Appeal (BoA) upheld the decision and the Applicant subsequently filed an appeal before the General Court (GC).

On genuine use

The evidence submitted by the Opponent consisted of 26 invoices of which only 12 were dated within the relevant period and showed use of the earlier mark for approximately 26 months.

The GC concluded that, in the circumstances, although the extent of use to which the earlier mark was put was relatively limited, this use could not be considered to be merely token or minimal.

Likelihood of confusion

The GC found a low degree of visual similarity between the marks, despite

the figurative element included in the Applicant’s mark. It noted that, in the case of a mark consisting of both word and figurative elements, while the word elements will generally be regarded as more distinctive or dominant, the figurative elements will be perceived by the relevant public as decorative only.

In relation to the phonetic and conceptual comparison of the marks, the GC distinguished between the part of the Portuguese public that has at least a basic knowledge of the English language and the part of the public with no such knowledge. It was found that the part of the relevant public that has sufficient knowledge of English would understand the number 4 as referring to the preposition “for”, and would thus pronounce and perceive the earlier mark 4 EVER in the same way as FOREVER. Since

THE ALOE VERA MARK



THE OPPONENT’S MARK



the marks shared the same ending, EVER, the marks would be phonetically similar and conceptually neutral for the part of the relevant public with no knowledge of the English language.

On the basis of the global assessment, the GC found a likelihood of confusion in this case and upheld the BoA’s decision.

This decision serves as a reminder that, in the case of marks consisting of both word and figurative elements, it is the word element that plays a decisive role in the assessment of the likelihood of confusion when the figurative element is less distinctive. It also illustrates that even limited evidence of use of an earlier mark can be considered to be sufficient when assessed in the context of the relevant goods, the market and the frequency of use.

It is the word element that plays a decisive role in the assessment of the likelihood of confusion when the figurative element is less distinctive

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Standing firm on slogans

Benjamin Thomas finds that marks that are used as slogans were scrutinised by the Court

This was an appeal to the General Court brought by Novartis AG against a decision by OHIM's First Board of Appeal (case R 953/2012 1). This had rejected Novartis's application to register CARE TO CARE as a Community Trade Mark (CTM) on absolute grounds.

Background

Novartis had applied to register CARE TO CARE as a CTM for "Educational services, including caregivers and patient's relatives support program relating to Alzheimer's disease" in class 41 and "Medical services, including providing medical information to caregivers and patient's relatives relating to Alzheimer's disease" in class 42.

The examiner had rejected the application on the ground that the mark promoted the properties of the services and did not function as an indication of origin, contrary to Article 7(1)(b) of Council Regulation (EC) 207/2009. This was upheld by the Board of Appeal, which considered CARE TO CARE to be a banal expression plainly referring to the progression from one type of care to another, and indicating the inherent nature of the services. The sign would not identify the origin of the designated services, thus failing to perform the essential function of a trade mark.

General Court

Novartis appealed to the General Court, arguing that OHIM had infringed Article 7(1)(b).

The Court held that the relevant public was professionals with a high level of attention and families of Alzheimer's patients, who would be particularly well informed. The Board had correctly relied on the

facts that Alzheimer's disease is an incurable, progressive condition, and that transfers between home and institutional care form part of its management. These were not mere assumptions, as argued by Novartis, but were well known to the relevant public. The Board had therefore not infringed the rules on apportionment of the burden of proof.

The Court considered that "care" is closely linked with the health sector and that the relevant public knows that the progression of Alzheimer's

Novartis had also argued that the Board had failed to apply the correct case law on slogans, particularly Audi v OHIM. However, the Court concluded that "care to care" does not possess the necessary degree of originality or resonance, requiring at least some interpretation. It would immediately be understood by the relevant public as a slogan relating to the services covered.

Finally, Novartis had argued that OHIM had infringed its previous practice, referring to other similar marks. However, the Court stated that, while OHIM must take into account its previous decisions in respect of similar applications, its decisions must be consistent with the principle of legality. Examinations of applications must be stringent and undertaken in each individual case. Here, Novartis could not rely on other CTM registrations to cast doubt on OHIM's conclusions.

The Court rejected Novartis's appeal, upholding OHIM's decision.

The expression did not have a sufficient degree of originality to be capable of indicating the commercial origin of the services

requires changes in care. Given that, "care to care" would be perceived as a reference to such changes and as a banal expression alluding to an inherent characteristic of educational and medical services relating to Alzheimer's. Accordingly, the expression did not have a sufficient degree of originality to be capable of indicating the commercial origin of the services, and was devoid of distinctive character.

Comment

Although CARE TO CARE is not a particularly imaginative mark, it is arguably not directly descriptive. It could also be seen as a clever use of language. This decision by the General Court is therefore yet another demonstration that the test applied to marks that are deemed to be slogans remains uncompromising.

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Fortunes rise for Sun Fresh

Rosalyn Newsome agrees with this purposeful decision

On 6 August 2007, Nannerl GmbH & Co KG filed a Community Trade Mark (CTM) application for the word mark SUN FRESH for: beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages. On 6 March 2008, The Sunrider Corporation ("Sunrider") filed opposition on the basis of an earlier CTM registration, SUNNY FRESH, designating herbal nutritional supplements in class 5 and several national rights in the UK, Ireland, Hungary and Benelux also designating the class 5 goods, as well as *inter alia*

herbal beverages, herbal teas and herbal preparations in class 32.

Nannerl was put to proof of use of all the earlier marks relied on in accordance with Article 42(2) and (3) of the Council Regulation (EC) 207/2009. The evidence for the relevant five-year period consisted of, among other evidence, 167 invoices relating to sales of 498 SUNNY FRESH mini-packs, each containing 10 bottles of 15ml dietary supplements, which were distributed to customers in Ireland, the Netherlands, the UK, Austria, Sweden, Belgium, France and Germany.

On 6 October 2010, the Opposition Division accepted the proof of use as supporting the earlier registrations relied on and upheld the opposition. The SUN FRESH application was rejected in its entirety.

On 3 December 2010, Nannerl filed a Notice of Appeal before OHIM, which was successful. The Appeal centred on the incorrect conclusion

that Nannerl maintained had been drawn by the Opposition Division from the proof of use filed and the resulting scope with which the earlier registrations were held to have been used. The Board of Appeal agreed with Nannerl that the evidence of use as filed only showed use on a dietary supplement based on a herbal concentrate. Consequently, the Board of Appeal concluded that proof of use had only been provided in relation to the CTM class 5 rights and that no use had been shown on the class 32 goods. It therefore annulled the decision of the Opposition Division and allowed Nannerl's request for registration on the basis that the applied for goods in class 32 were different to Sunrider's earlier class 5 rights.

Sunrider disagreed with the Board of Appeal's interpretation of the proof of use filed and argued that any liquid intended for human consumption, which may have a thirst-quenching or refreshing function aside from any supplemental nutritional purpose, should be seen as falling within the definition of a beverage in class 32.

This argument was rejected and the Board of Appeal found that herbal nutritional supplements in class 5 were readily distinguishable from herbal beverages, herbal teas, preparations and essences for making beverages, syrups for beverages in class 32. The Board of Appeal stated that the main consideration should be the purpose of the goods. The explanatory sentences at the start of the Nice Classification guide for class 5 indicate that it is designed to protect goods having a pharmaceutical and medical purpose. In contrast, the explanatory note at the start of the class 32 classification states that, in addition to non-alcoholic beverages, as well as beer, beverages for medical purposes are expressly excluded from its scope.

This decision is a reminder of the need to consider the nature of the evidence filed and whether it can support the registration in question.



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It takes two

Rebecca O’Kelly reviews a case that highlights the interdependence of similarity of goods and similarity of marks

Schuhhaus Dielmann GmbH & Co KG (“Schuhhaus”) appealed against the Board of Appeal of OHIM’s decision to partially uphold an opposition to its application for the word mark CARRERA PANAMERICANA on the basis that the Board of Appeal had failed to give reasons for its finding and that it erred in finding a likelihood of confusion between Schuhhaus’ application and an earlier mark, shown below right.

The General Court rejected the argument that the Board of Appeal had failed to give reasoning, stating reasoning is sufficient as long as it states (T-304/06, Reber v OHIM – Chocoladefabriken Lindt & Sprüngli (Mozart) [2008] ECR II 1927, paragraph 46):

- the grounds for refusing the mark;
- the corresponding legislative provision; and
- the facts that were proved which justified the finding.

The General Court found each of those elements had been provided by the Board of Appeal.

Schuhhaus also alleged infringement of Article 8(1)(b) of Regulation 40/94 (now Article 8(1)(b) of Council Regulation (EC) 207/2009) in finding a likelihood of confusion between the earlier mark and the application.

The General Court also considered how likelihood of confusion should be assessed, finding it must be assessed globally considering the perception the relevant public has of the signs and of the goods (T-162/01, Laboratorios RTB v OHIM), including the interdependence of any similarities (C-39/97, Canon).

The General Court confirmed that the earlier mark and the application had to be compared based on the

overall impression given by each, including having regard to any distinctive and dominant components. Therefore, while marks were to be looked at as a whole, the average consumer might still perceive a component of one of the marks to be dominant (C-334/05, OHIM v Shaker). The General Court upheld the Board of Appeal’s finding that the word “Carrera” was the dominant part of the earlier mark as the background highlighted that word and it was how the average consumer would refer to the mark. Given that “Carrera” was also the first word of the mark applied for, it could also catch the public’s eye first (T-183/02 and T-184/02, El Corte Ingles v OHIM). Therefore, despite the second word in the application, the Board of Appeal was correct in finding a degree of visual and aural similarity between the marks. In addition, Spanish-speaking consumers would find the two conceptually similar.

The General Court found inadmissible new evidence that Schuhhaus produced regarding a classic car race in Mexico called the Carrera Panamericana because it was not produced at the Board of Appeal.

The Applicant did not dispute that the Board of Appeal was correct to determine that certain of the goods were found to be identical and others were found to be similar.

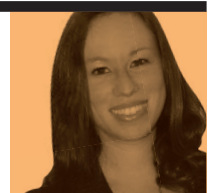
Having regard to the similarity/identicalness of the goods, the marks were found to be sufficiently similar to warrant the partial refusal of the application

Therefore, having regard to the similarity/identicalness of the goods, the marks were found to be sufficiently similar to warrant the partial refusal of the application.

This case highlights that, even where a figurative mark is being compared to a word mark that includes additional words, the two can still be sufficiently similar to cause a likelihood of confusion, particularly where the goods to which they relate are very similar or identical. This emphasises the need to consider the interdependence of similarity of goods and similarity of marks.



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Distinction decider

A clarification on Medion was ultimately of no help to Bimbo, writes Chris Morris

In *Bimbo SA v OHIM*, the Court of Justice of the European Union (CJEU) was asked to consider the application by the Community Trade Mark (CTM) Office of the Court's earlier judgment in *Medion* (C-120/04, *THOMSON LIFE*). In his opinion, Advocate General (AG) Mengozzi reviewed the case law following *Medion* and recognised that judicial application of the decision has been somewhat inconsistent.

Facts of the case

The facts of this case are that *Bimbo SA* applied to register *BIMBO DOUGHNUTS* as a CTM in class 30. *Panrico* successfully opposed the application on the basis of, among other marks, its earlier Spanish national registration for *DOGHNUTS*. Both *OHIM*'s Board of Appeal and the General Court upheld that decision. *Bimbo* appealed to the CJEU.

In its appeal, *Bimbo* argued that the General Court misapplied *Medion* when reaching its conclusion, and attributing an independent distinctive role within *BIMBO DOUGHNUTS* to the *DOUGHNUTS* component. *Bimbo* argued that the General Court erroneously inferred that, from the fact that *DOUGHNUTS* is meaningless to the average Spanish consumer, the element plays an independent, distinctive role within the mark applied for.

In *Medion*, the CJEU found that an earlier trade mark used by a third party in a composite sign that includes a company name could still have an independent distinctive role in that composite sign, without necessarily constituting the dominant element. AG Mengozzi reviewed

subsequent case law and found that the scope of *Medion* has tended to be interpreted more widely than the specific situation expressly contemplated: namely, "use by a third party, where the goods are identical, of a composite sign in which a reproduction of an earlier trade mark of independent distinctiveness is juxtaposed with the company name

If Advocate General Mengozzi's approach is adopted by the General Court, it will provide helpful clarity for, and boundaries to, the application of Medion going forward

of that third party or a mark belonging to that third party". In short, a rule has been inferred to apply in all situations where an earlier trade mark appears as a component of a later composite sign.

Having detected some uncertainty in the case law, AG Mengozzi proposed a definition of the actual scope of *Medion*. His view is that the ruling merely states that a likelihood of confusion cannot be ruled out where a composite mark is used as part of a later composite sign, albeit it is not the dominant element of that sign. There is no justification for a separate rule, assessing the similarity of marks on a different set of criteria for particular categories of marks.

This clarification did not help *Bimbo*, however, in the eyes of AG Mengozzi, who found that the General Court had properly assessed the likelihood of consumer confusion and proposed that the CJEU dismiss *Bimbo*'s appeal.

If AG Mengozzi's approach is adopted by the General Court, it will provide helpful clarity for, and boundaries to, the application of *Medion* going forward, along with a reminder that likelihood of confusion cannot be assessed by reference to a single rule, but must be assessed in light of all the relevant factors of the particular case.

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Board decision bounces back

As this case returns to the General Court, Rupert Bent explains why an appeal decision was deemed correct by the CJEU

This case dates back to 23 August 2006, when the German supermarket chain Lidl Stiftung & Co KG (“Lidl”) filed an application for registration of a Community Trade Mark (CTM) relating to the word WESTERN GOLD in class 33. The description of this class was amended by Lidl to include alcoholic beverages, and specifically include the wording “Spirits, in particular whisky”.

A notice of opposition to this application was filed on 14 March 2007 by WeserGold Getränkeindustrie GmbH & Co KG (“WeserGold”), a German company primarily involved with the export of non-alcoholic beverages. This opposition was based upon the fact that WeserGold possessed five similar pre-existing registered trade marks, and that, as

per Article 8(1)(b) of Council Regulation (EC) 207/2009 (the CTM Regulation), it believed there was a likelihood of confusion between these marks and Lidl’s application.

The marks WeserGold sought to rely on are as follows:

- 1) CTM word mark “WeserGold”, registered on 2 March 2005 in classes 29, 31 and 32;
- 2) German word mark “WeserGold”, registered on 27 February 2003 in classes 29, 31 and 32;
- 3) international word mark “Wesergold”, filed on 12 March 2003 in classes 29, 31 and 32;
- 4) German word mark WESERGOLD, first registered on 16 February 1973 in class 32; and
- 5) Polish word mark WESERGOLD, registered on 11 May 1999 in class 32.

This opposition was upheld by the Opposition Division of OHIM on 11 June 2009, and Lidl’s application was rejected. The Opposition Division deemed that there was a likelihood of confusion arising between Lidl’s proposed mark WESTERN GOLD and the CTM word mark “WeserGold” registered by WeserGold.

Appeal process

Lidl filed an appeal on 13 July 2009 with OHIM under Articles 58-64 of the CTM Regulation. The issue was considered by the First Board of Appeal, which decided to annul the Opposition Division’s decision.

This decision hinged upon several factors:

- a) the goods covered by the mark applied for – specifically alcoholic beverages under class 33 – were sufficiently different to the non-alcoholic goods covered



- b) by the marks WeserGold had already registered;
- b) while there were some visual and phonetic similarities between marks, they were conceptually different; and
- c) the word “gold” in WeserGold’s registered trade mark was not viewed as particularly distinctive.

On this basis, it was decided that the differences were sufficient to exclude a likelihood of confusion.

WeserGold then took the matter to the General Court of the European Union on 21 June 2010, seeking an annulment of the decision reached by the First Board of Appeal. In support of this, WeserGold raised four appeals at law. However, the General Court only considered the first of

The Opposition Division deemed that there was a likelihood of confusion arising between Lidl’s proposed mark and the CTM word mark registered by WeserGold

OHIM held that the decision the General Court had arrived at was a misinterpretation of Article 8(1)(b) of Council Regulation (EC) 207/2009



these, namely that the decision was an infringement of Article 8(1)(b) of the CTM Regulation, which sets out the relative grounds under which a trade mark may be refused registration.

The General Court ultimately upheld WeserGold's first plea in law and subsequently annulled the contested decision arrived at by the First Board of Appeal. This decision was widely considered to be controversial due to the fact that, during its judgment, the General Court had made findings that were inconsistent with the final verdict. To provide some examples, the General Court decided during its judgment that:

- 1) there was only a low degree of similarity between the spirits covered

by the mark applied for by Lidl and the non-alcoholic beverages covered by the previously registered marks of WeserGold;

- 2) the signs were conceptually different (due to the difference in meaning between "western" and "weser"), despite visual and phonetic similarity; and
- 3) as per paragraph 58 of its judgment, the General Court stated that the signs at issue were dissimilar overall.

Despite this, the General Court ruled in favour of WeserGold on the grounds that the First Board of Appeal had failed in its duty to carry out an examination of the enhanced distinctiveness of the previously registered WeserGold marks, and had not stated its findings relating to this. This error meant that the First Board of Appeal had failed to examine a potentially relevant factor in assessing the likelihood of confusion, and therefore any decision reached had to be annulled.

Perhaps unsurprisingly, OHIM (with the support of Lidl) appealed to the Court of Justice of the European Union (CJEU) on 23 January 2014 seeking to set aside the judgment of the General Court.

OHIM put forward three grounds of appeal, although its core line of argument revolved around the fact that, when trade marks are

considered to be dissimilar, specific examination of enhanced distinctiveness is not necessary. In any event, OHIM suggested that such examination would not have had any bearing on the overall decision, so should not have influenced the judgment of the General Court. It held that the decision the General Court had arrived at was therefore a misinterpretation of Article 8(1)(b) of the CTM Regulation.

Appeal allowed

The appeal was allowed, and the judgment of the General Court was set aside. The CJEU has referred the matter back to the General Court to be reconsidered.

The CJEU considered that: "Since the General Court had already found that the marks at issue were dissimilar overall, any likelihood of confusion had to be ruled out and the possible enhanced distinctiveness of the earlier marks, acquired through use, could not offset the lack of similarity between the marks at issue".

On this basis, the CJEU decided that the Board of Appeal had not erred by failing to examine the enhanced distinctiveness of the marks, and that the General Court should not have annulled the Board's decision.

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C-98/13, Martin Blomqvist
v Rolex SA, Manufacture
des Montres Rolex SA,
a request for a preliminary
ruling from the Højesteret
(Supreme Court), Denmark,
CJEU, 6 February 2014
(language of case: Danish)



Fortress Europe bars ersatz Rolex

*Customs' broad reach is confirmed
by the CJEU. By John Ferdinand*

This decision of the Court of Justice of the European Union (CJEU) confirms that customs authorities are permitted to suspend, release and, ultimately, destroy counterfeit goods they identify, even where they are purchased by an individual consumer in the EU from a third-party website that is not targeted at the EU. This decision is welcome news for owners of IP rights in the EU. It illustrates the broad powers of EU customs authorities provided under the Customs Regulation, and highlights the value of registering IP rights with EU customs authorities so that action can be taken against counterfeiters at little or no expense to the IP right owner.

Background facts

The facts of this dispute concern the purchase by a Danish individual, Martin Blomqvist, of a watch described as a Rolex through the English website of a Chinese online retail platform. The product was then dispatched from Hong Kong to Blomqvist in Denmark.

At this point, customs authorities in Denmark suspended the release of the product on suspicion that the watch was a counterfeit copy of a genuine Rolex watch and that there was breach of copyright subsisting in the design of the original model. Customs then informed both Rolex and Blomqvist of the seizure of the product. Rolex confirmed it was counterfeit and requested Blomqvist's consent to destruction of the product. Blomqvist refused and argued that he had bought the watch legally.

As a result, Rolex brought an action before the Danish Maritime and Commercial Court seeking that Blomqvist allow the suspension of release and destruction of the product in accordance with provisions of the Customs Regulation. This claim was granted by the Court and Blomqvist appealed to the Danish Supreme Court.

In the course of the Appeal, the question was raised as to whether an IP right had actually been infringed in

Denmark. After all, Blomqvist could not really have been said to infringe any copyright or trade mark rights under Danish law since he had bought the product for personal use only and the Chinese seller had not specifically targeted the EU. As discussed above, the matter concerned an alleged infringement of copyright, but there was a request from the Danish Court for the CJEU also to consider questions arising from this in the context of trade mark infringement.

Legal context

The framework for customs to seize and destroy counterfeit products is laid down in the Customs Regulation (this was amended in January 2014, but, for the purposes of this case, the wording used for interpretation, and reproduced below, was that used in the original Regulation No 1383/2003). In particular, this Regulation includes reference to action that can be taken by customs in respect of counterfeit goods and pirated goods, as discussed below:

- 1) Counterfeit goods are defined as goods "bearing without authorisation a trade mark identical to the trade mark validly registered in respect of the same type of goods, or which cannot be distinguished in its essential aspects from such a trade mark, and which thereby infringes the trade mark holder's rights".
- 2) Pirated goods are defined, *inter alia*, as "goods which are or contain copies made without the consent of the

holder of a copyright or related right or design right, regardless of whether it is registered in national law".

The scope of possible action by customs authorities is therefore dictated by whether the goods in question infringe copyright, trade mark or other IP rights as defined by the EU and national legislation behind those rights.

In this case there was a need to consider the wording of the Copyright Directive, the Trade Mark Directive and Community Trade Mark (CTM) Regulation.

Article 4(1) of the Copyright Directive provides that owners of copyright enjoy the "exclusive right to authorise or prohibit any form of distribution to the public by sale or otherwise".

Likewise, and as readers will know, the Trade Mark Directive and CTM Regulation (at Articles 5 and 9 respectively) provide that trade mark owners can prevent third parties without their consent from "using in the course of trade" identical or similar trade marks. Definitions of "use in the course of trade" include offering goods for sale under the mark, putting them on the market, or importing or exporting the goods.

The problem here was that Blomqvist had only bought the product for personal use, while the seller of the product was based in China and had not specifically targeted the EU with the website from which the product was sold.

Questions referred

Accordingly, the Danish Court decided that there was a need to clarify the scope of the wording "distribution to the public" and "use in the course of trade" in this context, and sought answers to the five questions summarised below.

- 1) Would the requirement of "distribution to the public" for copyright-protected goods apply if an undertaking enters into an agreement via a website in a third country for the sale and dispatch of the goods to a private purchaser with an

The scope of possible action by customs authorities is dictated by whether the goods infringe IP rights

- address in the EU Member State where the copyright is protected, receives payment and effects dispatch to that Member State, or is it also a condition that the goods must have been offered for sale or advertised, or targeted at the Member State where the goods are delivered?
- 2) and 3) Would the requirement of “use in the course of trade” for infringement of trade mark rights outlined in the Trade Mark Directive and Community Trade Mark Regulation be satisfied in the same circumstances as discussed at question 1)?
- 4) and 5) In order for customs authorities to take action against suspected infringing goods and for action to be taken against goods later proven to have infringed IP rights, is it a requirement that the pirated or counterfeit goods must have been distributed to the public or used in the course of trade in accordance with the answers to questions 1), 2) and 3) respectively?

Decision

In a very short and succinct judgment, the CJEU found definitively that goods could be seized and destroyed in this context even where the seller had not targeted any EU countries.

The Court distinguished the case at hand from reasoning laid down in *L'Oréal and others*, in which it was held that the mere fact that a website is accessible from the territory covered by a trade mark is not a sufficient basis for concluding that offers for sale are targeted at consumers in the territory in question. Instead, it referenced the decision of the Court of Justice in *Philips*, which held that rights can be infringed where, even before arrival in the territory covered by that protection, goods coming from non-Member States are the subject of “a commercial act directed at consumers in that territory, such as sale... or advertising”.

As such, it was found that the wording of the Customs Regulation means that the holder of an IP right in the EU is entitled to request customs to seize and destroy goods sold to a person residing

in the territory of that Member State through an online sales website in a non-Member State at the time when those goods enter that Member State merely by virtue of the acquisition of those goods by the buyer. There is no requirement for the goods to have been the subject, prior to the sale, of an offer for sale or advertising targeting consumers of that Member State.

The decision therefore also implies that, provided the other requirements for infringement are satisfied, the sale of the goods in question could constitute an infringement of copyright or trade mark rights in similar circumstances.

Implications

On the one hand, the outcome in this case will be of concern to private consumers in the EU, who may well, as appears to have been the case here, mistakenly purchase counterfeit goods in tiny quantities from websites outside the EU. The decision also supports the view that right holders may request customs authorities to take action against importing of third-party goods using identical or similar marks in other countries that may infringe their rights but that are not necessarily counterfeits in the traditional sense (the scope of the Customs Regulation includes marks bearing identical marks and “marks which cannot be distinguished in their material respects” from registered trade marks).

However, in the context of the principle of “Fortress Europe”, and the inherent validity and purpose of EU IP rights in preventing the sale

This decision shows how broad the scope of the Customs Regulation is in enabling the authorities to detain and destroy potentially infringing goods

of counterfeits and causing confusion in the marketplace, the decision makes sense.

This decision shows how broad the scope of the Customs Regulation is in enabling the authorities to detain and destroy potentially infringing goods. IP right owners should strongly consider registration of their rights with customs authorities. Aside from possible translation of documents or a requirement to bear the reasonable cost of destruction of counterfeit products by the authorities, there is no official fee to arrange for recording IP rights with customs centrally across the whole of the EU and, at the initial stage, there is no evidential burden on the right holder to show an infringement has taken place.

The Decision is also useful in supplementing the reasoning laid down in *L'Oréal and others*, and *Philips*, on the question of internet and foreign website copyright and trade mark infringements generally. Accordingly, and if customs action is not appropriate or is not taken by the authorities, IP right owners could consider filing claims for copyright or trade mark infringement where a purchase of infringing products has been made in similar circumstances.

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A bullish approach

Rachel Wilkinson-Duffy looks forward to a final finding after confirmation on due cause



Photography: © Stefan Holm/Shutterstock.com

In this preliminary ruling, the Court of Justice of the European Union (CJEU) provided useful guidance on whether prior use in good faith may constitute due cause in the context of Article 5(2) of the First Council Directive 89/104/EEC (“the Directive”), even where the national laws of a Member State do not recognise unregistered rights.

Background

The Claimants, Red Bull GmbH and Red Bull Nederland BV (“Red Bull”), brought an action to the Rechtbank Amsterdam against Leidseplein Beheer BV and Hendrikus de Vries (“de Vries”) for trade mark infringement on the basis of a national Benelux registration for RED BULL KRATING-DAENG (“the Red Bull Mark”) covering *inter alia* non-alcoholic drinks in class 32.

Among other grounds, Red Bull argued that de Vries’ use of THE BULLDOG in relation to energy drinks would, without due cause, take unfair advantage of the distinctive character or repute of the Red Bull Mark.

The Red Bull Mark was registered on 11 July 1983 and it was common

ground between the parties that De Vries had been using THE BULLDOG as a trade name for hotel and restaurant services involving the sale of drinks prior to that date (such use was claimed by de Vries since 1975). The existence of a reputation in the Red Bull Mark was also common ground between the parties, although not prior to de Vries’ use.

The Rechtbank Amsterdam rejected all of Red Bull’s claims at first instance. However, on appeal, the Gerechtshof te Amsterdam held that, due to the common element BULL within both marks, the necessary link was established, even if consumers were unlikely to mistake one for the other. De Vries argued that the continued use of THE BULLDOG, albeit expanded use in relation to energy

drinks after the relevant priority date, constituted due cause and thus avoided infringement. This was rejected on the basis that de Vries had not demonstrated sufficient need to use THE BULLDOG in relation to energy drinks, such that use could not reasonably be expected to desist.

De Vries appealed to the Hoge Raad der Nederlanden, resulting in a stay of proceedings and the reference to the CJEU for guidance.

Preliminary ruling

The CJEU ruled that Red Bull was incorrect in its submission that a national system for the protection of marks only through registration precludes the scope of the rights of a registered proprietor from being liable to restriction. While Article 5(2) of the Directive provides broader rights for trade marks with a reputation, such rights are not unconditional and a balance must be struck between the interests of the proprietor and the interests of other economic operators. The concept of due cause, therefore, cannot be restricted to objectively overriding reasons.

The Court confirmed that two factors must be taken into account when determining whether prior use constitutes due cause under Article 5(2) of the Directive: (i) how the used sign was accepted by the relevant public and its reputation; and (ii) the intention of the person using the sign, in particular whether use was in good faith. The more substantial the repute of the used sign at the relevant date, the more likely that continued use will be necessary and thus constitute due cause.

As the proximity between goods and/or services is a key factor, the writer will watch with interest as to whether or not the application of the CJEU’s ruling will result in a finding by the Hoge Raad der Nederlanden that prior use in relation to services constitutes due cause for subsequent use in relation to energy drinks.

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Quasar fails to find mark

Its appeal was wide of the target, explains Charlotte Blakey

38

This article concerns an appeal by the proprietor (Quasar) of UK Trade Mark No 2409353 Q-ZAR in classes 25, 28 and 41 (“the mark”) against the decision issued on 11 March 2013, which revoked the mark’s protection in all goods and services of the registration pursuant to section 46(1)(a) of the Trade Marks Act 1994 (“the Act”), namely:

Class 25: Clothing, footwear, headgear.

Class 28: Games and playthings; gymnastic and sporting articles not included in other classes; electronically activated toys; electronically activated chest pack amusement games utilising electronic weapons and target apparatus for simulating combat conditions; toy guns, laser activated toys and video game machines; protective padding.

Class 41: Entertainment services; amusement centre services and recreational services.

Quasar appealed on two grounds:

- 1) The evidence was not properly evaluated and the Hearing Officer ought to have held sufficient use had been shown; and

- 2) The approach to assessment of use of the mark in a particular form was wrong. Even if the mark is not maintained for all goods and services, there is evidence to establish use for “electronically activated chest pack amusement games utilising electronic weapons and target apparatus for stimulation combat conditions” in class 28.

There was no oral hearing at first instance or on appeal.

Evidence of use

With regard to evidence of use, Quasar relied on a single witness statement, and exhibits consisting of invoices from 2008 to 2009 relating to sales of equipment to various undertakings in Europe (two invoices were to the UK), with descriptions such as “Q-Zar Gun and Body Armour”. While the goods appear to have been supplied to undertakings in Europe, they were manufactured in or supplied from the UK. Images showing the use of Q-Zar were provided (see image, above right).

Section 46(2) of the Act provides exceptions to the rule that use of a mark must take place within the UK

to constitute genuine use, stating that: “... use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.”

Quasar argued that the invoices in respect of the exported goods demonstrated that Q-ZAR had been put to genuine use for purposes of maintaining the registration. The Hearing Officer did not agree and felt there was no evidence showing that the goods were exported with Q-ZAR affixed. Quasar argued that the Hearing Officer failed to give adequate regard to the inference that could be drawn that guns of the kind shown in the image were those referred to in the invoices.

The Appointed Person agreed with Quasar that the invoices demonstrated use of Q-ZAR on laser guns. In this regard there would, it said, be “no reason why an undertaking which is in fact making and supplying laser



guns which are in the picture shown clearly marked with the Q-ZAR mark and describing them as Q-ZAR guns in its invoices would not be marking and supplying such Q-ZAR branded guns for export”.

In addition, the Appointed Person felt that: “Even if the word mark Q-ZAR only appeared physically on the guns rather than on the rest of the apparatus, because the guns were not separate items (in at least some of the sales), but were apparently integral to the game system as a whole, it would be right in the specific circumstances of this case to treat the game as a whole as being marked with the Q-ZAR mark for the purpose of section 46(2) in virtue of the key element of it (the laser gun) bearing that word mark.”

However, the Appointed Person considered Quasar’s written arguments and evidence seriously deficient, and specifically declined to criticise the Hearing Officer in regard to the invoices: “It is hardly surprising that the Hearing Officer did not accept it since it is only faintly to be detected even in the arguments on this appeal.”

With regard to the body armour per se, the Hearing Officer felt that the mark shown was not use of the mark as filed. Instead, he held that “the average consumer may well not see the first element as the letter Q but a stylised form of the letter O”. The Appointed Person felt this finding

was too narrow. The body armour and laser gun were part of the same kit, such that the average consumer would likely consider the mark on the body armour to be Q-ZAR, particularly given the use of Q-ZAR on the laser gun.

The Hearing Officer also held that the invoices were insufficient to establish or continue a market. Again, the Appointed Person disagreed with this, taking into account the evidence of substantial sales in other territories as proof that Quasar intended to maintain its market: “The Hearing Officer did not take into account, again because he was not actually invited to do so by the proprietor, the fact that systems of this kind were likely to be infrequent purchases...the proprietor’s evidence was very weak.”

The Hearing Officer and the Appointed Person were both of the same opinion that Quasar failed to demonstrate use of Q-ZAR in respect of all goods and services

However, the Hearing Officer and the Appointed Person were both of the same opinion that Quasar failed to demonstrate use of Q-ZAR in respect of all goods and services.

Quasar also sought to submit evidence after the Hearing Officer’s decision in the form of a letter from the curator of the Laser Tag Museum, Louisville, Kentucky, and a letter from Quasar to Laser Arena Nottingham containing a trade mark licence. However, this evidence was inadmissible given that Quasar failed to explain why the materials were not available from the outset. In addition, it had no important influence on the outcome of the case. Furthermore, the Appointed Person remarked that: “This material is not even evidence. It is not exhibited to any witness statement and cannot properly be taken account of for that reason alone.”

The appeal was dismissed bar the following class 28 goods:

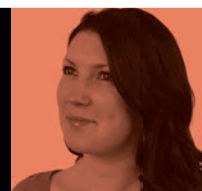
“Electronically activated chest pack amusement games utilising electronic weapons and target apparatus for simulation of combat conditions; protective padded body armour specifically for use in such games; toy laser guns specifically for use in such games.”

The inadequacy of Quasar’s evidence and submissions was also taken into account in the award of costs.

This case highlights the need for careful and thorough preparation of evidence and written arguments, particularly where there is to be no oral hearing.

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Just let it be

This case serves as a reminder that an Appointed Person appeal is not a rehearing, suggests Richard Burton

In this decision, Amanda Michaels reminds us that, on appeal to the Appointed Person (AP), it must be shown that there has been an error of principle or a distinct and material error in the decision; an appeal is not to be treated as a rehearing.

C J Bowen, the Hearing Officer (HO), had upheld an opposition by Ulrich Jüstrich Holding AG (“UJH”) against a trade mark application made by Gail Bryden for the mark shown below right (top). UJH had opposed the application on the basis of section 5(2)(b) of the Trade Marks Act 1994, relying on an earlier UK registration. The HO found that there was a likelihood of confusion in respect of the goods in class 3 and services in class 44. The opposition therefore succeeded in part and Bryden appealed that part of the decision that went against her.

The AP noted – as per Reef Trade Mark [2003] RPC 5 (“Reef”) and BUD Trade Mark [2003] RPC 25 (“BUD”) – that this was not a rehearing. Therefore, neither surprise at a HO’s conclusion nor a belief that he had reached the wrong decision was sufficient to justify interference. Only being satisfied that there had been a distinct and material error of principle or that the HO was clearly and genuinely wrong would suffice. Even if the AP would not have reached the same conclusion as the HO, the decision should not be set aside.

Bryden’s grounds of appeal consisted primarily of four arguments:

1) *The HO failed to take into account certain parts of the evidence.*

Bryden had argued that several third parties used “Just” marks in relation to cosmetic products (in class 3). The HO had criticised the lack of evidence submitted in support of this argument. According to the AP, the dismissal of the evidence submitted did not amount to an error of principle or material error. Therefore, the ground of appeal failed.

2) *The HO erred in his assessment of the similarity of the marks.*

Bryden argued that the HO erred in assessing aural similarity and that UJH’s mark is pronounced as “Yoost”, not as the English word “just”; however, the AP said the average member of the relevant public in the UK would not be aware that it should be pronounced in that way. Bryden also argued that the HO erred in assessing the visual and conceptual differences; however, the AP did not find any material error in the decision.

3) *Comparison of the marks in use and as marketed demonstrated that there was no likelihood of confusion.*

Bryden submitted that the HO had been wrong to find that the differences in the ways in which the parties’ marks are used and marketed demonstrated that there was no likelihood of confusion, especially in relation to the class 44 services. The AP refused to

accept that there was any error of principle or material error in the HO’s conclusion.

4) *The HO was wrong to discount Bryden’s argument that the marks had co-existed on the market without confusion, suggesting that there was no likelihood of confusion.*

Bryden submitted that the HO had failed to give sufficient weight to the fact that the parties had used their marks in parallel in the UK for years without evidence of any confusion having arisen. The AP found that the HO seemed to have approached this point by suggesting that this was a case of honest concurrent use. She noted that it was possible that the HO had misunderstood Bryden’s argument. However, she considered that, even if the HO had approached the point in this way, the decision would not have changed.

Since all four grounds of appeal were dismissed, the appeal was refused in its entirety. This case serves as a useful reminder of the standard of review in appeal cases. Rather than a second attempt to establish the previous case, an appeal to the AP should only be pursued where it is considered that there has been an error of principle or material error in the decision.



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events

More details can be found at itma.org.uk

Date	Event	Location	CPD hours
1 May	ITMA Glasgow Talk Plain Packaging, Katharine Stephens, Bird & Bird LLP	Burness Paull, Glasgow	1
19 May	ITMA/CIPA CPD Webinar How to network effectively both informally and formally to build individual and firm visibility		1
20 May	ITMA London Evening Meeting* Six things you may not know about the TMA 1994, Michael Edenborough, Serle Court	Royal College of Surgeons, London	1
9 June	Student Induction Day	CIPA Hall, London	
20 June	ITMA/CIPA CPD Webinar How to use social media as part of your personal and firm wide marketing		1
24 June	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
8 July	ITMA Summer Reception	The In & Out Club, London	
19 July	Intellectual Property Trainees' Ball	The Rosewood, London	
22 July	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
23 September	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
25 September	ITMA Autumn Seminar*	Hyatt Regency, Birmingham	5
28 October	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
18 November	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
9 December	ITMA London Christmas Lunch**	InterContinental Park Lane, London	



ITMA's Summer Reception will be held at London's In & Out Club on 8 July

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Media Watch

Ken Storey ends his stint as press pundit with a trip down memory lane

ILLUSTRATION BY PHILLIP COUZENS

And so this is it: my final Media Watch column!

Back in the days when I attended business start-up exhibitions, one of the key issues concerned the naming of new enterprises. The advice proffered by my colleagues was that entrepreneurs should check any name they had thought of was not already in use and that the name met the criteria for registration. It never ceases to amaze me how many cases reported in the media could have been avoided if that rudimentary advice had been followed.

For example, *Cumberland News* reported on a Penrith couple that set up an online directory aimed at people getting married in the county, called "Hitched". Unfortunately, a global wedding website with the same name contacted the couple, who have now changed the name of their company. Even the quickest Google search would have alerted them to the conflict, so it was unfortunate they didn't realise they couldn't operate in the same market with the same name.

On the other hand, the creators of a new digital currency were well aware that their chosen business name was in use, because they called it "Coinye West". Even I have heard of musician Kanye West and would have associated the currency business with him, especially as the chosen logo was a caricature of the rapper in his signature sunglasses. Kanye filed for trade mark infringement and persuaded the digital

currency traders – who posted the message "Coinye is dead. You win, Kanye" on their website – to back down.

While the Cumbrian company may have been unfortunate, in that it was a local company that came to the attention of the global brand, the world wide web ensures even the smallest firms can be seen by all.

I am hoping the next case doesn't suffer as a result of its visibility. In October 2013, Alex James, Blur's bass player, applied for the trade mark BRITPOP for fizzy drinks. *The Guardian's Culture* magazine outlined his action and I particularly enjoyed this quote: "Twenty years after taking on the Gallagher brothers in the charts, James will now be taking on a different Oasis on the supermarket shelves."

I noticed that James has not used the services of a Trade Mark Attorney in filing his application. I only hope he doesn't meet with too many oppositions or, if he does, that he turns to an ITMA member for help – a chance for an ITMA Blur groupie to step up to the plate?

I must admit my pop era was more along the lines of The Beatles v The Rolling Stones, but it does bring to mind how quickly time flies! The recent flurry of activity surrounding the ruling of Deputy Judge Roger Wyand QC on the dispute between 21st Century Fox Film Corporation and Mark Tughan (owner of Glee Club comedy venues in the UK) rang so many bells that I grabbed my past issues of *ITMA Review* and discovered

that I had first reported on this story nearly two years before, when the case was referred from the (then) Patents County Court to the High Court. The High Court ruling in February 2014 was widely reported in national and local papers, and saw Wyand rule in favour of Tughan, which could mean that TV programme *Glee* disappears from our screens. However, I have a feeling this case isn't over yet.

The last story I turn to is from the *Daily Mail*, which reported that the Duke and Duchess of Cambridge have set up companies to protect their brand and IP rights. Prince Harry has also set up a company to protect his rights. It is to be hoped that this move will prevent the problems the Diana, Princess of Wales Memorial Fund had when it tried to stop the production of Diana dolls following her death.

And this is where I come in. Shortly after I joined ITMA on 11 August 1997, the dramatic news came of the death of Princess Diana. This triggered a huge amount of media interest and some of it centred on how her name and image was being used on merchandise. It proved a busy time for us in briefing the media about trade marks. Sadly, the media's attention span is often short and enquiries dwindled. However, as I have tried to highlight in this column, the media still gets agitated about IP matters. They may sometimes get it wrong, but I hope we have helped to correct the misconceptions. With that, I bid you all a fond adieu.



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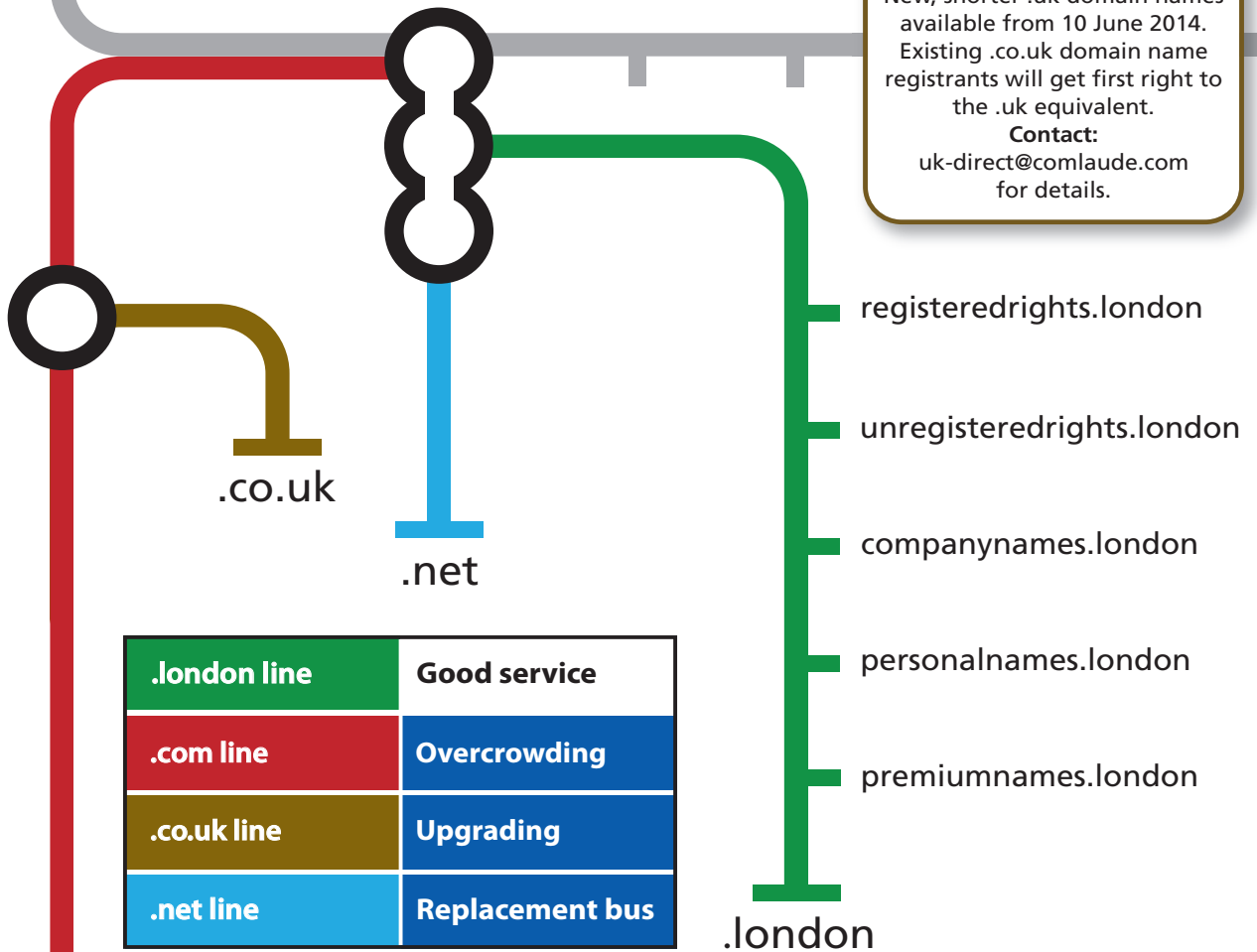
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