

# CITMA REVIEW

ISSUE 434

JUNE 2017

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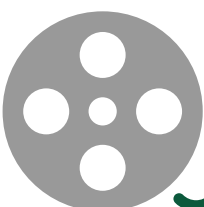
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# We're in Good Company

Look who trusts CompuMark to help protect their valuable brands.

94 out of 100  of The Am Law 100<sup>1</sup>

46 out of 50  of the TOP Pharmaceutical Companies<sup>2</sup>

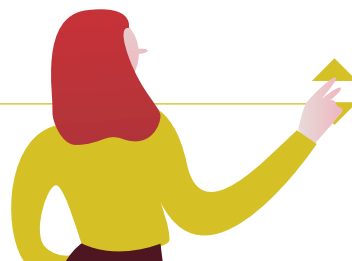
95 out of 100  of the World's Top Grossing Films<sup>3</sup>

9 out of 10  of the World's Most Valuable Brands<sup>4</sup>

Bottom line, they trust us because we deliver for them.

1 Source: The 2016 Am Law 100  
2 Source: Pharm Exec's Top 50 Companies 2016  
3 Source: Box Office Mojo – 2015 Domestic Grosses  
4 Source: Interbrand Best Global Brands 2016

[compumark.com](http://compumark.com)



**W**elcome to the June 2017 issue of the *CITMA Review*, which I hope will mark the beginning of your summer reading. I am delighted that this edition highlights the work of CITMA's volunteers who provide IP information access at the regular IP clinics, as well as the initiative to provide pro bono services for those who cannot afford access to justice (page 6). Most of the requests received by IP Pro Bono are for assistance related to trade marks, and I hope members will be able to assist, despite all the other pressures of the day-to-day. One announcement that may help reduce stress is the welcome introduction of the new groundless threats law, as discussed by Adrian Dykes on page 18.

No issue of the *CITMA Review* would be complete without reference to Brexit, which was a key discussion point at our successful Spring Conference, or to developments outside the UK, which this time sees us looking at IP protection for Italy's creative industries (page 22).

With many best wishes for the summer and hopes for sunshine.

*Kate O'Rourke*

**Kate O'Rourke**  
CITMA President

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**CITMA**



# CITMA | INSIDER

## Chief Executive's bulletin

Highlights from and updates to Keven Bader's 18th April message to members



### **BREXIT: COUNCIL TO ISSUE A FORMAL RESPONSE**

You will hopefully have seen the specific email updates on our Brexit work. Even though Article 50 has been triggered, and the upcoming general election has added another layer of uncertainty, we expect that the UK Government will remain in listening mode over the coming months. The UK IPO continues to hold stakeholder meetings, and CITMA continues to have a seat at the table as we seek to help the UK IPO work through the detail and issues in this area.

A number of members have asked about international designs, and whether, prior to Brexit, the UK will accede to the Hague Agreement Concerning the International Deposit of Industrial Designs. We have published a note that sets out the position recently given by the Minister for Intellectual Property in a written statement confirming that the UK will seek to ratify and join the Hague Agreement. The Minister's statement said the aim is for the UK to ratify it by 31st March 2018, and be in a position to launch the service on 6th April 2018, prior to Brexit. See [citma.org.uk](http://citma.org.uk) for details.

At a recent meeting of the CITMA Council, it was agreed that it would be appropriate to put together a formal position paper. To date, we have issued various "think pieces" on matters relating to Brexit and the options available – but we feel the time is right to take a formal position. Once the paper has been signed off, we will share it with you before submitting

it to various Government departments and stakeholders.

### **PARALEGAL CHANGES COMING SOON**

Over the next few months, we will begin transferring the Administrator category of membership to a new CITMA Paralegal category, bring in a continuing professional development requirement, and rename the Trade Mark Administrators' Course the CITMA Paralegal Course.

The biggest hurdle (as ever) is the IT transition that is required, but we now have a way forward, and the aim is for the change to be completed, at the latest, before the results of the 2017 Trade Mark Administrators' Course are published, which normally happens in August.

### **MEMBERSHIP CERTIFICATES AND PIN BADGES**

Thank you to everyone who has paid their 2017 membership subscription. The new membership certificates, with pin badges, have now been processed and sent out to those who have paid. We hope you like the new design of the certificate, which aligns with our overall branding. I have already seen some people wearing their CITMA pin badges, which is fantastic.

### **DESIGNATORY LETTERS AND TITLES**

Ordinary, Fellow or Corporate Honorary members of CITMA can use designatory letters, and the title "Chartered Trade Mark Attorney". It is important that you use this on your email signatures, profiles, etc, as it helps to raise awareness. For further information



*We have issued various 'think pieces' on matters relating to Brexit, but we feel the time is right to take a formal position*

about the use of designatory letters and titles, see [citma.org.uk](http://citma.org.uk)

### **PLANNED PUBLICATIONS**

The 2016 *CITMA Annual Report* is now available, and gives members the opportunity to look back at what we achieved in 2016. See page 16 of this issue for highlights, and [citma.org.uk](http://citma.org.uk) for further details and to view the entire report.

In 2017, we plan to publish a few surveys as we start to scope out some of the options we have been considering as part of our strategic discussions. The views of members will be important to help ensure we are heading along the right track. Thank you in advance for your engagement.

### **REGULATION UPDATE**

We have been informed by IPReg that its Chief Executive, Ann Wright, will be leaving the organisation later in the year. Plans are already under way to recruit her successor, and we will let you know of any developments as and when IPReg announces them. ■



John Buckby (right) receives the award from Legal 500 Editor Alexander Boyes

## Spearing Waite recognised by Legal 500

At a dinner held at the Guildhall in London to celebrate the 2017 *Legal 500* Awards, CITMA member John Buckby collected the *Legal 500* UK Firm (Regional) of the Year award in the Technology, Media and Telecoms category on behalf of Spearing Waite.

John is a Partner and Head of Intellectual Property & Media at Spearing Waite.

The award recognises the quality of the firm's work on media agreements, trade marks, and contentious and non-contentious IP advice.

## Member moves



Mark Foreman, Richard May and Leanne Gulliver, all previously of Rouse UK, joined Osborne Clarke's London office in February.



HGF is pleased to announce the arrival of Andrew Hawley and Hernán Rios, who joined the firm as Trade Mark Attorneys on 27th March 2017.



Dale Carter has taken up a position as Trade Mark Attorney at Reddie & Grose. Contact him at [dale.carter@reddie.co.uk](mailto:dale.carter@reddie.co.uk) or on 0207 242 0901.

## CompuMark probes the C-suite

Research carried out on behalf of CompuMark (*The Trademark Ecosystem: Through the Lens of the C-suite*) has revealed the outlook of senior management in five countries on infringement and the trade mark management process, including:



79% believe trade mark infringement is increasing



66% will be launching new trade marks in the next year



40% are more concerned about infringement now than they were five years ago



80% would likely launch more trade marks if the clearance process were simpler



34% have changed a brand name due to infringement



41% saw an increase in their clearance budget

Interestingly, the research (released in April 2017) says that industry statistics actually show infringement has remained steady over the past decade.

Access the full report at [compumark.com](http://compumark.com)



## Don't miss this: CITMA Summer Reception

Sea Containers on the South Bank of the River Thames provides the setting for our annual seasonal gathering – the CITMA Summer Reception – on **4th July 2017**. With the amazing views on offer at Sea Containers, networking doesn't get any more spectacular than this.

Book your place now at [citma.org.uk](http://citma.org.uk)



# TGI THURSDAY

*Once a month, there is a reason for some people to be thankful, and a chance for you to be the cause, as Saaira Gill explains*

**A**s many readers may be aware, the UK IPO, in conjunction with CITMA, offers free trade mark advice clinics to individuals or businesses seeking information regarding the protection of their trade mark rights or avoiding infringement. The clinics are held once a month throughout the year (except in August and December) at the UK IPO's central London office.

Six 30-minute appointments are offered, at which members of CITMA (usually registered Trade Mark Attorneys) meet confidentially with those who have come to get advice. The clinics are usually attended by individuals, sole traders or small businesses representing a wide variety of business sectors.

Appointments are free, although a refundable deposit of £50 is required to secure one. They are offered on the condition that the matter under consideration is new (for instance, professional advice must not have previously been sought from a member of CITMA) and paperwork cannot be reviewed by the attorney before the appointment.

Along with IP Pro Bono (see box, page 8), the clinics are a way in which CITMA aims to promote IP education and awareness to the UK business community, particularly smaller businesses that may struggle to understand correspondence they receive or how to protect their own IP assets. But the clinics also offer a

## ABOUT IP ADVICE CLINICS

**WHEN:** Clinics are held on the second Thursday of every month (except August and December) from 5.00pm–6.30pm.

**WHERE:** UK IPO, First floor, 4 Abbey Orchard Street, London SW1P 2BS.

**COST TO PARTICIPANTS:** Appointments are free, although a refundable deposit of £50 is required to secure one.

**VOLUNTEERS NEEDED:** Two CITMA members (usually registered Trade Mark Attorneys).

**HOW TO GET INVOLVED:** Contact Gillian Rogers ([gillian@citma.org.uk](mailto:gillian@citma.org.uk)) to be added to the CITMA clinics mailing list. An email requesting two volunteers will be sent to everyone on the list a month before the next clinic.

valuable learning opportunity for those who volunteer (including me), as I found out by speaking with some other regular CITMA participants.

**Catherine Byfield**, a Chartered Trade Mark Attorney and Associate at Bristows, volunteers twice a year on average. She says that she enjoys “the interaction with small-business owners and entrepreneurs” and being reminded of “how valuable half an hour of our time can be to them”.

Enquiries routinely relate to how best to protect a mark (ie a word versus a logo), she explains, and what goods and services to cover (either before an application has been filed or when the person has received an objection from the UK IPO); or how to respond to a challenge received from a third party.

In addition, there is often an element of giving bad news – eg when attendees have come to the clinic after receiving correspondence from a third party that will require them to change what they are doing in some way.

She says the clinics also highlight the pitfalls for those who do not seek advice early enough: “Often, an application has already been filed by the time the attendee comes to the clinic. Therefore, it is too late to select a better form of the mark to secure broader protection, or to cover a sufficiently comprehensive list of goods and services. Another common problem is that the attendee has become attached to a name without conducting searches, and it later transpires that it is not available.” ▶



For Catherine, clinics also offer a chance to learn: “It is really useful practice in terms of thinking on your feet and explaining the legal position to individuals who often have no knowledge of trade marks at all.” It has surprised her how much she has learned about the trials and tribulations of setting up a business. From a business-development standpoint, Catherine says she always offers a follow-up chat or assistance with tasks, such as drafting specifications. It can lead to an ongoing contact: “Quite a few previous attendees have kept me posted on the progress of their businesses over a number of years; in a handful of cases, the attendee has turned into a paid client. Often, the people seeking advice are not aware of the profession, so the clinics are a way to introduce them to it.”

**Amanda McDowall**, a Chartered Trade Mark Attorney and Associate at CMS, also volunteers at least twice a year, although she may fit in more clinics if her workload allows. Getting involved helps “to keep me on my toes”, she says, because: “You never know what sort of questions you are going to get.” She has been surprised by the complexity of the issues that people face without representation.

The clinics have helped Amanda to hone her client interviewing skills and learn the fine art of delivering essential advice in a short length of time: “You

### IP PRO BONO: ANOTHER WAY TO REACH OUT

IP Pro Bono is a collaboration between a number of leading IP organisations, including CIPA, CITMA, the Intellectual Property Lawyers’ Association, the IP Bar and the Law Society. The scheme aims to respond to the challenge set out by His Honour Judge Richard Hacon: IP legal services providers should come together to provide IP advice and legal support for individuals and small businesses involved in IP disputes that could not otherwise afford to meet the costs of professional representation.

Unlike the IP clinics, IP Pro Bono is designed specifically to help those who are in dispute about IP rights. The idea is to assist with settlement and mediation, before the dispute becomes a court case. If official proceedings have started before the UK IPO, Trade Mark Registry or Appointed Person, IPEC, or High Court, then IP Pro Bono could be able to help.

#### BECOMING A CASE OFFICER

The IP Pro Bono service has been started with a very small group of volunteer case officers who meet regularly to develop a consistent policy for deciding who qualifies for assistance.

A case officer needs a certain amount of time to be able to sift through papers, and make an assessment of the applicant’s eligibility and the type of firm that would be able to provide advice. Case officers need to be able to provide a sympathetic ear, and understand the problem and tease out any facts necessary to establish whether help is appropriate.

The case officer will not provide assistance to the applicant, but will refer them to a firm that has indicated a willingness to help, and make the necessary introduction between applicant and firm.

*Ready to help? To volunteer as a case officer for IP Pro Bono, visit [ipprobono.org.uk/how-to-volunteer](http://ipprobono.org.uk/how-to-volunteer)*



have to be really succinct.” In fact, fitting all of the advice she would like to give into just half an hour is one of the primary challenges of the experience, but it is usually enough time, she says, to answer key questions and point people in the right direction in terms of next steps. Going forward, however, Amanda would welcome the opportunity to have quick fact sheets available for clients to take away – perhaps on registrability of marks, opposition procedure, etc – which could also provide ongoing support. For potential volunteers who might be newly qualified, the primary benefit is “exposure to a range of issues and direct access to clients”.

The subjects that arise at clinic sessions vary widely, although Amanda says she has recently supported a greater number of people who are setting up their own businesses: “Before filing a trade mark application, lots of people come to seek advice in respect of drafting a specification, the registrability of their mark or a potential issue with a third-party rights holder that they have found. Then there are more complex issues, particularly where applicants have filed trade mark applications that have been opposed, or where a party is trying to start a franchise or license a mark.”

While a few clinic users are very savvy, and have made use of the UK IPO’s online resources or the British Library’s Business & IP Centre, the majority of people definitely need pointing in the right direction, Amanda says. She adds that: “This is more noticeable since the UK IPO website changed to a GOV.UK website.”

Amanda says she usually gets instructed by one or two attendees from each session, and often gets follow-up emails offering thanks.

**Daniel Sullivan**, Associate Trade Mark Attorney at Elkington and Fife, says his firm encourages his participation in the clinics, recognising that it supports his development. Daniel takes part up to three times a year.

He has found that some issues brought by clinic participants can be out of the ordinary; the most unusual issue that he has faced was when one of the attendees “seemed to have a particularly involved dispute involving members of his extended family”. Usually, however, attendees want advice on general filing and the benefits of trade mark protection, he says. Some have requested advice on franchising and licensing.

At a time when there is a large number of budget trade mark providers operating, Daniel feels that it is good that people can get quality advice from a qualified Trade Mark Attorney, even if their resources are limited.

**David Yeomans**, a Chartered Trade Mark Attorney at Venner Shipley, is hoping to increase his participation at clinics to three times a year, and appreciates the chance they give him to gain one-to-one, client-facing experience. And although he agrees that it is a challenge that attendees might ask about any type of issue, including questions that involve some complexity, the limited time available means that attendees do not expect attorneys to have all the answers “there and then”. Overall, he says, volunteering at clinics “is great experience. Attendees know that you are giving up your time to see them and so are generally very grateful for any advice you can give.”

#### **AUTHOR EXPERIENCE**

I would echo what our other volunteers have said. In particular, I would emphasise the clinics’ usefulness in developing one’s ability to provide succinct, yet often complicated, trade mark advice to individuals with very limited or no knowledge of trade marks. In addition, volunteering helps raise both your and your firm’s profile in the profession.

Perhaps you would like to get involved and are wondering what it takes? It is crucial that volunteers are

“

*It is useful practice in terms of thinking on your feet and explaining the legal position to individuals who often have no knowledge of trade marks at all*

able to understand the problem and provide advice within the short window available, often without having time to properly review any correspondence received by the attendee. It is also useful to come prepared with knowledge of where attendees can obtain general business advice, as they sometimes require assistance with franchising, licensing or setting up a new business. It also helps to have a good working knowledge of UK IPO and EUIPO practices and current fees.

As most attendees are individuals who are setting up a business, sole traders or small businesses, funds are often quite limited. However, given that most attorneys seem to volunteer for personal reasons, rather than simply for business development, gaining a fee-paying client is generally seen only as a bonus.

Ultimately, volunteering at the clinics is a way of giving back and developing. If you have not volunteered before, I highly recommend it. ■



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# THE B-WORD IS BACK

*Article 50 has been triggered. Arty Rajendra reminds us what that might mean for IP enforcement*

**L**et's get one thing out of the way: no one knows what impact Brexit will have on IP enforcement. This article does not profess to give answers. However, it will hopefully give trade mark owners and those who represent them food for thought as the UK's EU exit rolls out – be the journey “hard” or “soft”.

The pervasive role of EU legislation in domestic IP enforcement cannot be underestimated. At first blush, one might think that Directive 2004/48/EC (the Enforcement Directive) did not radically change UK IP litigation practice. Provisions that enable recall of infringing goods and prescribe how damages should be assessed were largely ignored (“moral prejudice”, anyone?). However, the Enforcement Directive (and the Electronic Commerce Directive 2000/31/EC) played an influential role in the Cartier website-blocking case. Post-Brexit, it is likely that the UK judiciary will continue to offer the sort of relief that is envisaged under the Enforcement Directive and will have an eye to what EU national courts are doing. It is, nevertheless, disheartening that our common-law perspective will no longer influence the EU's approach to IP enforcement.

This article will look at three specific issues: pan-European injunctions, exhaustion of rights and border enforcement measures.

## **EUTMs AND INJUNCTIONS**

After Brexit, the UK will no longer have EU trade mark (EUTM) and community design courts. What does that mean for pending litigation concerning EUTMs? Will that litigation automatically cease? Will UK courts be allowed to continue with the case? Will they follow the jurisprudence of the CJEU?

Since EUTMs will likely cease to have effect in the UK, it is hard to see how the UK courts can continue to hear cases on them. One option is the widely anticipated legislation that enables an EUTM to be split into a UK



child right and will also include provisions so that extant EUTM proceedings in the UK automatically apply to the child UK IP registration. However, in some circumstances, that would still result in depriving the claimant of a remedy it would have expected when commencing proceedings (ie an EU-wide injunction if domicile criteria are met). Most likely, UK courts will continue to facilitate adherence to pan-EU injunctions granted pre-Brexit. They will not be able to grant pan-EU relief post-Brexit, and any ongoing litigation seeking such relief will likely be limited to the UK. This underlines the need for clear transitional provisions that tell us what we can and cannot expect.

If a party can get a result in the UK quickly – either an interim or final injunction – the UK will be a good choice for forum shoppers. If the UK continues to align its trade mark law with the EU and CJEU jurisprudence, a decision here could be highly influential in the EU.

## EXHAUSTION OPTIONS

As we know from *Silhouette*, trade mark rights are exhausted once goods are put on the market in the European Economic Area (EEA) by the proprietor or with their consent. So brand owners can only take action against genuine goods that have been imported into the EEA without their consent. With the UK's exit from the EU, there are a few options for the future:

1) **International exhaustion.** Once the genuine goods are put on the market anywhere, the trade mark rights are exhausted; genuine goods first marketed anywhere in the world can be freely imported and sold in the UK. As in the past, goods that are not of the same quality as the branded version sold in the UK could nevertheless be stopped.

International exhaustion will reduce the price of branded goods, which is great for consumers. But what is the attraction, then, of a large UK national sales force or business unit if any

supermarket or wholesaler can pick up cheap stock from Turkey or Africa and bring it here?

- 2) **EU-plus exhaustion.** The UK could decide unilaterally that rights are exhausted in any goods previously placed on the market in the EEA with consent, and that such goods can freely come into the UK. The UK could also negotiate a bilateral treaty with the EU so that the same rules apply to goods going the other way. This would preserve the current position and has huge attractions, but flatly contradicts the UK's proposal to come out of the single market. It is not politically viable (unless a change of Government softens this line).
- 3) **UK-only exhaustion.** Brand owners will have the right to choose first marketing in the UK and can take action against any goods imported into the UK without consent. This could also lead to higher prices and lower consumer confidence and growth.

Ultimately, the decision on exhaustion of rights will be a political and economic one, not related to what is best for brand owners.

## GOODS IN TRANSIT

New provisions relating to goods in transit were introduced into Council Regulation (EC) No 207/2009 (the EU Trade Mark Regulation, as amended by Regulation (EU) 2015/2424) allowing trade mark owners to take action against counterfeit goods in transit if the importer or declarant cannot prove that they are entitled to market those goods in the country of destination.

The UK Government might now see these highly contentious provisions as a barrier to the UK's growth as a goods transport hub. It is, therefore, not beyond the realms

of possibility that these provisions will be removed or tweaked.

## CUSTOMS-IPR REGULATION

Regulation (EU) No 608/2013 (the Customs-IPR Regulation) enables customs officers and other border enforcement officials to detain goods suspected of being counterfeit or pirated at any point of entry in the EU. It has been a huge success – most big brand owners have a customs application for action that is linked to their EUTMs and has EU-wide coverage. In the post-Brexit world, we will no longer be able to rely on customs in other countries to check goods that might enter here. Commensurately, however, there will be fewer entry points for such goods.

Either way, we will miss intelligence from the cooperation that comes with having an EU-wide enforcement mechanism. Brand owners will potentially be left with having to file two applications for action – one for the UK and one for the EU.

## PREPARATORY STEPS

We have two years to ensure rights holders get the clarity they deserve on all of these issues, but it is clear that:

- There are likely to be more questions as we progress through the exit journey.
- It will be easier if the UK can strike a deal with the EU.
- With or without a deal, litigating in the UK post-Brexit will be different – there will be opportunities to exploit loopholes and implement strategies that take advantage of the uncertainties.
- The UK must get its house in order. Advisors should be ready with an IP enforcement package that works in the UK alone and is not reliant on EU rights, legislation and procedures. ■



### ARTY RAJENDRA

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Arty spoke on this topic at the CITMA Spring Conference.



# GOING UP

What does it take to create equality at the office?  
Catherine Jewell was recently among those learning to help women achieve their full potential in the workplace

**L**ate March saw a number of IP firms in Bath, Bristol, Cambridge, Glasgow, London and Manchester host the first IP Inclusive breakfast webinar. The topic was gender inclusivity, with a focus on “how to be a workplace ally”.

More than 180 people registered to attend across eight venues, with another 30 or so watching from the comfort of their own computers. The subject was a timely choice. Mayor of London Sadiq Khan has recently hit out at the “unacceptable” pay gap between men and women, and published details of the gender pay gap in all organisations in the Greater London Authority (GLA) family, including Transport for London, the Metropolitan Police and the London Fire Brigade. The Mayor said: “Clearly, we all need to do much more to put our own houses in order. I am determined to lead by example.” He is now asking all GLA group organisations to publish action plans to address the pay gap.

In fact, companies’ commitment to gender diversity is at an all-time high, yet women still often fall behind in the workplace.



*Unleashing women’s full potential could be worth £23bn a year to the Exchequer*

The Women and Work Commission (WAWC) has found that unleashing women’s full potential could be worth £23bn a year to the Exchequer. To put this in

context, the central Government’s public spending on education in 2013 totalled £28.6bn. Women make up 47 per cent of the UK workforce, and eliminating gender discrimination in relation to occupation and pay could increase women’s wages by about 50 per cent, and national output by five per cent, according to the WAWC.

Using research and insight recently published by Lean In (an initiative that encourages education and action to advance gender equality), along with their own wealth of experience, the IP Inclusive speakers, Andrea Brewster and Lesley Evans, discussed what we can all do to challenge the stereotypes and unconscious bias that can hold women back. (They also pointed out that these “workplace ally” tips are for men and women, as both can be complicit in holding women back or help them succeed.) They then provided a handy list of six tips for being a workplace ally:

1. Make sure women’s ideas are heard.
2. Challenge the “likeability penalty”.
3. Celebrate women’s accomplishments.
4. Encourage women to go for it.
5. Give women direct feedback.
6. Mentor and sponsor other women.

## IMPOSTER PROBLEM

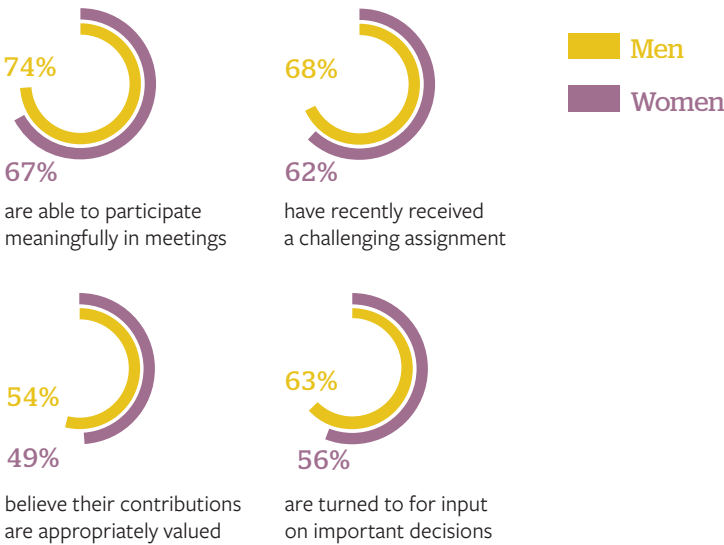
It turns out that encouraging women to go for it in their chosen career means more than just providing a steady stream of general positive feedback. Andrea talked about “imposter syndrome” – the sense of waiting to be ►



## WOMEN IN THE WORKPLACE: LEAN IN LEARNING

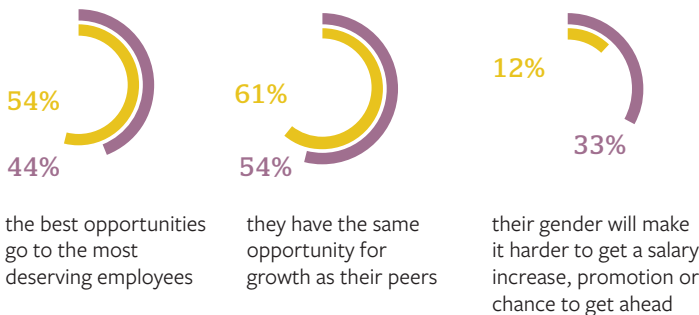
WOMEN ARE SUBTLY DISADVANTAGED IN MANY OF THEIR DAILY INTERACTIONS

Percentage of women and men who...

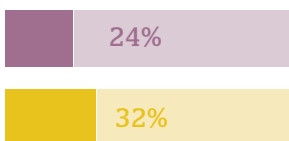


### WOMEN ARE MORE LIKELY TO QUESTION THE FAIRNESS OF THE WORKPLACE

Percentage of women and men who think...



Percentage of women and men who want to be a top executive and believe it is likely that they will become one



GAP IN RATE OF FIRST PROMOTIONS

**For every 100 women promoted to manager level, 130 men are promoted**

“found out” that haunts many women in the workplace – and how best to manage and overcome it. The idea is to encourage women to value their own competence and be bold, and it is vital for women not only to take on challenges, but also to take on the right kind of challenges (eg leadership roles and new projects, rather than just the “office housework”).

According to Lean In, women tend to do a greater proportion of service and support work than men, such as taking notes, organising events and training new hires, which take time away from core responsibilities. This could be addressed by ensuring that those tasks are distributed evenly.

One surprising topic for discussion was the importance of seating choice in meetings. The speakers explained that women tend to sit around the edges of a meeting room, while men tend to take the central seats. Men also tend to talk more and make more suggestions in meetings, while women are interrupted more, given less credit for their ideas and have less overall influence. So, simply having a meeting chair who calls out disruptive or bad behaviour makes a huge difference, allowing people (male and female) to talk without being interrupted and be given appropriate credit for their contribution.

We moved on next to the “likeability penalty” – not a phrase I had previously heard. Essentially, this phrase describes the conflict between the behaviour that is expected from a leader and the behaviour that is (unconsciously) expected from a woman. This most commonly shows itself in the language used to describe women’s workplace behaviour. Men are expected to be assertive and confident, so when they behave in this way in a leadership role it is consistent with expectations and generally welcomed. Women, on the other hand, are expected to be nurturing and collaborative, and going against this expectation creates conflict that is

“  
*In meetings, women tend to sit around the edges of the room, while men tend to take the central seats*

often reflected in the language used to describe their behaviour. For example, assertive behaviour in women is often described as “bossy” or “pushy”, both of which have negative connotations.

### **BODY OF RESEARCH**

There is a growing body of research to support this. For example, in a study by Columbia Business School in the US, two groups of students read a case study about a venture capitalist, with only a single difference in what they read – the gender of the person involved. Half the class read about Howard, while half read about Heidi. Having read the material, students respected both Howard and Heidi, but, whereas Howard was described as likeable, Heidi was seen as selfish and not the type of person one would want to hire or work for.

Andrea and Lesley urged us to challenge the language used in describing women at work, and think about how we would describe the same behaviour in a man and whether our negative reaction would be the same if the person we were reacting to were of the opposite gender.

Appraisals are another situation where choice of language is critical: the key point is to make sure that any feedback given is about the job, not the person. A recent study of performance reviews shows that 66 per cent of women (compared with less than one per cent of men) received negative feedback on their personal style, such as “you can sometimes be abrasive”.<sup>1</sup>

As a workplace ally, an obvious approach is to find and support women and other minority groups. Andrea and Lesley encouraged everyone attending the webinar to reach out as a workplace ally. It need not be in a formal programme; informal mentoring can often be more effective.

Andrea recommended not waiting to be asked and explained that, in her

experience, an informal mentorship can be more of a supportive friendship than an additional source of pressure; you can work together, share your network and make introductions, where possible helping to build each other’s networks through working with others on specific projects rather than simply making introductions without a purpose.

### **WIDER APPLICATION**

Although the webinar was presented with reference to the particular case of women in IP, many of the aspects and approaches discussed in the session would be equally applicable to other inclusivity issues and when considering other diverse minority groups. It is not only women who need workplace allies.

For example, in 2013, YouGov conducted a survey on behalf of the LGBT charity Stonewall that found that one in six (17 per cent) of LGBT employees had experienced verbal homophobic bullying from their colleagues in the previous five years. One in eight (13 per cent) of LGBT employees said they would not feel confident reporting homophobic bullying in their workplace. Just over

a quarter (26 per cent) of LGBT employees are not open to colleagues about their sexual orientation.

The number of judges in the courts of England and Wales on 1st April 2015 was 3,238, of which 817 (25.2 per cent) were female. Of the judges, 2,686 (83 per cent) declared their ethnicity, and of these 2,686 judges there were 159 (5.9 per cent) who declared their background as black or minority ethnic.<sup>2</sup>

Clearly, there is plenty of room for improvement in creating a more diverse working environment in the UK, and in the legal professions in general. IP Inclusive was formed in 2015 and is committed to making the IP professions more inclusive, with the aim of ensuring that the IP professionals of the future encourage, embrace and sustain a more diverse workforce. IP Inclusive aims to ensure that the IP professions are welcoming, accessible, respectful and supportive to all those who have the necessary aptitude – regardless of their age, gender, race, sexual orientation, religion, physical ability, wealth or background. ■

*The author thanks Andrea Brewster and Lesley Evans; IP Inclusive; the Women in IP committee; and host venues Boulton Wade Tennant, Carpmiels & Ransford, EIP, Haseltine Lake, Burness Paull, Mewburn Ellis, Norton Rose Fulbright and Turnbull Lynch IP.*

1. Kieran Snyder, “The Abrasiveness Trap: High-achieving Men and Women are Described Differently in Reviews”, *Fortune* (26th August 2014), for:tn/2p0nTev.
2. Judicial Office, *Judicial Diversity Statistics 2015* (30th July 2015), bit.ly/judicialstats.



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# Nine things

## EVERY CITMA MEMBER SHOULD KNOW

*We have recently released the CITMA Annual Report for 2016, which outlines the organisation's achievements over the 12-month period. Here, we present some of the most notable*

# 1.



*We received our Royal Charter*

*"The Institute of Trade Mark Attorneys fully deserves its chartered status. I am glad its hard work and commitment to achieving the highest levels of both technical and professional knowledge have been recognised"*

**Baroness Neville-Rolfe**, former Minister of State for Energy and Intellectual Property

# 3.



*Tweets from @CITMAuk were viewed 370,442 times*

We continued to develop our Twitter and LinkedIn communities in 2016, growing our Twitter page beyond 2,000 followers. Twitter remains a valuable tool to not only promote our messages, but also drive traffic to the CITMA website. More than six per cent of our website's traffic came via a direct link on social media.

# 2.

*CITMA's conferences, webinars, receptions and lectures attracted 3,885 attendees*

We delivered more than 60 events in 2016, including continuing professional development sessions, webinars, social events and our annual Spring Conference. Our London Evening Meetings saw an 11 per cent increase in attendance, while the Autumn Seminar in Birmingham attracted 107 people, a five per cent increase on 2015. The webinar series continued to attract unprecedented numbers of delegates, with an average of more than 100 people per webinar in 2016.







# 4.

*Our website attracted 25,000 member searches*

The jobs board and members' search tool remain the most viewed pages, after the home page. The jobs board was visited more than 40,000 times, and the members' search tool 25,000 times.

# 7.

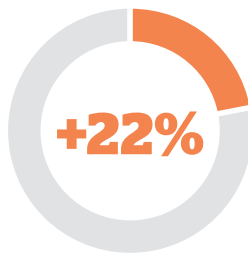
*Our strategic objectives are:*

- to be the pre-eminent body for trade marks and designs in the UK;
- to represent, promote and engage the membership and the wider profession; and
- to equip and support our membership to be competitive and successful.



# 5.

*The CITMA website saw a 22 per cent increase in visitors*



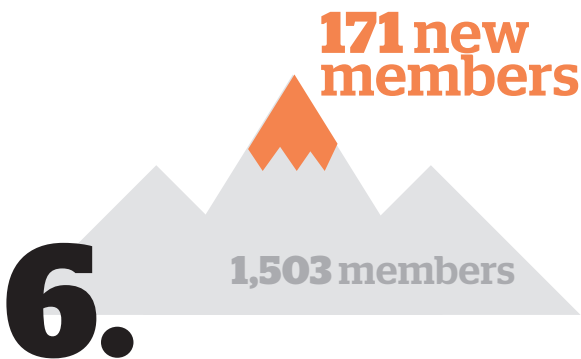
There was a 22 per cent increase in visitors to the [citma.org.uk](http://citma.org.uk) website in 2016. We were able to use the site's functionality to further enhance user experience, creating mini-sites – for example, on Brexit, the Spring Conference and the Royal Charter.



# 8.

*We maintained our international profile*

CITMA representatives spoke at many key events during the year, including in Belgium, China, India, Latvia and the US.



# 6.

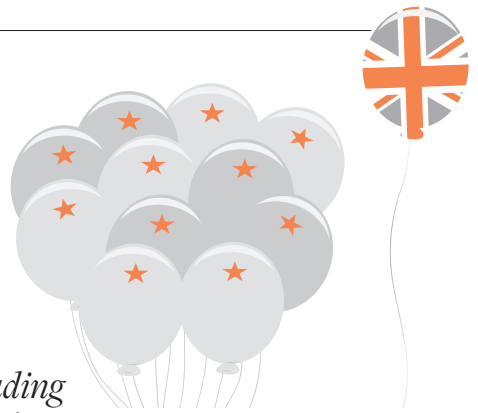
*Our membership rose by 171 to reach 1,503*

This included 29 Ordinary, 39 Student and 70 Administrator members. Unlike in 2015, membership was included without charge for all those who passed our Trade Mark Administrators' Course. As a result, we saw an increase in uptake of new membership in this category of more than 100 per cent.

# 9.

*We are leading on Brexit's impact*

We were prepared for both potential outcomes of the EU referendum and have continued to work hard to keep our members informed while helping to lead the narrative around the possible impact on IP, our profession and business. The work of our Brexit task force has been acknowledged as leading the narrative on the possible implications for EU registered rights and rights of representation.



Read the full report at [citma.org.uk](http://citma.org.uk)



# THE FINAL COUNTDOWN

*Adrian Dykes sums up the coming  
changes to groundless threats law*

**C**urrent IP laws allow persons aggrieved by a threat of infringement proceedings to bring an unjustified threats action against the person making the threat. This applies in the UK to patents, registered EU and UK trade marks, and all design rights. The thought behind this right of redress is that threats of infringement can be abused by rights owners, forcing the threatened party to capitulate when faced with expensive IP litigation, even in the face of an invalid right. A threatened party can seek a declaration that the threats are unjustified, as well as damages and an injunction to prevent further threats. For rights holders, it is a defence to show that the relevant IP right is being infringed.

Threats have been a uniquely British construct for more than 130 years. Criticism has been levied from all sides, and reform has been discussed for more than a decade. It is claimed that the threats provisions are inconsistent with the overriding objective of the Civil Procedure Rules and promote a “sue first, talk later” approach. Indeed, the Law Society recommended abolishing the provisions for trade marks and designs altogether. The provisions have been criticised for being inconsistent among the various IP rights, and therefore confusing and difficult to enforce. Indeed, it has been claimed that a threat is so ill-defined that it is not clear when a communication of facts becomes a threat. And, of course, professional advisors do not want to find themselves on the end of a threats action, particularly in a personal capacity. This, in addition to the added costs of navigating a complicated area of law, made the current law ripe for reform.

## REVIEW TIMELINE

In 2012, the Law Commission (LC) began its review of the threats laws in earnest. The general aim was to balance rights holders’ ability to enforce their IP rights with the rights of others, and to ensure that threats to sue were not being

used as a tool to distort competition. A public consultation was conducted in 2013, and this reported to parliament the following year. As a result, the LC recommended:

- extending to the other types of rights the current exception for threats of patent infringement made to those who have committed primary acts of infringement, and expanding this to relate also to those who are shown to have intended to commit such acts;
- introducing a new exclusion that would cover communications to secondary infringers for legitimate commercial purposes; and
- excluding professional advisors from liability when acting in their professional capacity on instructions from their clients.

The Government broadly accepted the LC’s recommendations, and a draft bill was published in 2015. The draft followed the LC’s recommendations, subject to a few Government tweaks. A Government bill was published shortly thereafter and began its journey through parliament. On 21st March 2017, the Intellectual Property (Unjustified Threats) Bill completed its journey, passing the report stage and third reading without amendment, and it received royal assent on 27th April. The Act is expected to come into force later this year.

## CRUCIAL CHANGES

A key feature of the Act is that threats are harmonised across a greater number of IP rights. The Act substitutes parallel amendments into different pieces of legislation covering trade marks, patents and designs (copyright and passing off remain excluded).

Under the Act, a communication contains a threat of infringement proceedings if a reasonable person in the position of a recipient would understand from the communication that: (i) an IP right exists; and (ii) a person intends to bring proceedings against another person for infringement of that IP right by an act done in the UK or an act that, if done, would be done in the UK.

Under the old law, this test was viewed from the perspective of an “ordinary person”, although the semantic change in the Act is unlikely to have much practical effect, as the courts have interpreted the present law as referring to a “reasonable man”.

Notwithstanding the remaining uncertainties with regard to the implementation of the unitary patent in the UK, the Act has also been drafted to cater for unitary patents. Proceedings threatened at the Unified Patent Court would not be caught by the current law. However, the Act brings unitary patents under the new threats regime with respect to threats made regarding acts done in relation to a unitary patent in the UK.

Like the old law, a threats action may be brought by “a person aggrieved”, not just the person threatened. Often, the person aggrieved will be the manufacturer, distributor, user or buyer of the product – the parties whose commercial interests are likely to be prejudiced by the threat.

For each of the IP rights affected, there are three main exceptions.

First, and as under the current law, the primary acts of infringement are excluded. Distinction is made between the primary actors and those secondary actors that are merely engaged in distribution or dealing. In relation to trade marks, primary infringement covers: (i) applying, or causing another person to apply, a sign to goods or their packaging; (ii) importing, for disposal, goods to which, or to the packaging of which, a sign has been applied; or (iii) supplying a service under a sign. So, these primary infringers cannot bring a threats action.

The Act extends this exception to cover an intention to do these acts, and the additional language, which

appears only in relation to trade marks (ie “causing another person to apply ...”), prevents infringers from circumventing this exception by outsourcing the packaging/labelling.

Second, the Act allows primary infringers to be threatened with both primary and secondary infringement proceedings. This reflects the position under the current patent law. This amendment acknowledges that not all infringers are the same. Some are better placed to determine how justified a threat of infringement truly is. A primary infringer will have often invested more in a product or service, and may be more willing to defend an action. This is not always so for secondary infringers, where often the mere threat of proceedings will be enough to stop, for example, a retailer or customer selling a product or service. Accordingly, rights holders are encouraged to approach the most appropriate business, and the Act goes some distance to protect secondary infringers from unjustified threats.

Third, the “permitted communications” provision, perhaps the most significant change, is intended to clarify what types of communication do not amount to a threat. It allows rights holders to provide certain basic information to a party while avoiding the threats provisions. As threats can be explicit or implied, it was important for the Act to allow rights holders to be certain of the point at which a communication could become an implied threat. By introducing the concept of permitted communications, the Act has sought to add some clarity to the current law.

Within this framework, permitted communications must be made for a permitted purpose. In the case of trade marks, permitted purposes are: (i) giving notice that a registered



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*Professional legal advisors and their employers can no longer be held personally responsible for making threats when acting on a client's instructions*



trade mark exists; (ii) discovering whether, or by whom, a registered trade mark has been infringed by a primary act; or (iii) giving notice that a person has a right in or under a registered trade mark, where another person's awareness of the right is relevant to any proceedings that may be brought in respect of the registered trade mark.

While examples of what amounts to permitted communications are provided, the Act gives courts discretion to treat other situations as for "permitted purposes" if it is in the interests of justice to do so. This suggests a body of case law will evolve to quantify permitted purposes further, and, in this respect, the law is not quite as certain as envisaged by this amendment, although it does provide some flexibility.

The Act also provides examples of what is not treated as a "permitted purpose". In the case of trade marks, this covers requesting a person to: (i) cease use of a sign in the course of trade; (ii) deliver up or destroy goods; and/or (iii) give undertakings relating to the use of a sign. This means that most ordinary cease-and-desist letters to secondary infringers will not be permitted communications.

Furthermore, permitted communications must include information that is necessary for the permitted purpose. For example, this includes a statement that a trade mark exists and is in force or that an application for the mark has been made; and details of a registered trade mark.

Earlier drafts of the Act required a communication to be made "solely" for a permitted purpose. However, the word "solely" has been deleted from the final Act, meaning that courts (and lawyers) will not need to consider the subjective intent of the party that sent

the communication. Such an enquiry would conflict with the objective nature of the unjustified threats test.

Finally, the Act requires that the person making the communication has a reasonable belief that the information related to the threat is true.

## DEFENCES

The Act sets out two statutory defences to a threats action. Unsurprisingly, the first is that the threatened act constitutes infringement (or would constitute infringement if done). Broadly, this reflects the current law for all IP rights. This defence is not available if a trade mark turns out to be invalid. The retention of this defence sits well with the aim of the Act, which is to prevent abuse of unjustified threats, rather than to prevent rights holders from enforcing their rights.

The second defence is carried over from patent law. It is a defence for the person who made the threat to show that, despite having taken "reasonable steps", the person has not identified the primary infringer(s) and has, accordingly, approached the secondary infringer.

This defence acknowledges the practical reality that it is difficult to identify primary infringers, particularly where trade marks are concerned. As above, this amendment distinguishes between the relative culpability of primary and secondary infringers. It is inevitable that questions of interpretation will

arise as to what is encompassed by the phrase "reasonable steps" (which is lower than the standard under the current patent law, ie "best endeavours"). The inclusion of the "reasonable steps" defence is another example of balancing legitimate enforcement with the rights of others.

## ADVISOR IMPACT

The Act will reform the current law to prevent a threats claim being brought against a regulated professional advisor where the professional advisor is acting on the instructions of their client and this is identified in the relevant communication. This ensures professional legal advisors, including Trade Mark Attorneys and solicitors, and their employers, can no longer be held personally responsible for making threats when acting on the instructions of a client. This amendment is to be applauded and should avoid situations where professional advisors find themselves in conflict with their clients and no longer able to act for them.

## RIGHT DIRECTION

The Act in its final form has achieved much of what it set out to do. No doubt the reforms will still have their critics, not least because a threatened party could, as an alternative, seek a declaration of non-infringement rather than pursuing a threats claim. It remains to be seen how much more certain the law has become and we will probably have to wait a few more years to assess this. ■



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# Tools for the trade

*Paola Gelato explains why Italy's creative industries are in a strong position to assert their IP rights*

Over the past five years, Italy has seen an important evolution regarding the protection of intellectual creations.

The Italian system already had a remarkable tradition in enforcing trade marks and designs, and has recently extended the scope of protection, thanks to a new copyright regime that is much more flexible than ever before. This paradigm shift has given rights owners a greater opportunity to ensure the best protection of their rights. In fact, Italian law now offers a range of legal options, grounded on immaterial rights, for protecting creations, as well as actions based on unfair competition that have proven very efficient for preserving creations.

Before the Italian copyright reform of 19th April 2001 (a result of the implementation of EU Directive 98/71/EC), the separability principle governed copyright and design rights. The Italian system did not admit copyright protection on industrial designs unless their artistic value was conceptually separable from their industrial character. This principle has been abolished to allow a cumulative application of both copyright and design protection to industrial objects. However, to be protected under Italian copyright law, a work is currently not only required to be creative, but also to have artistic value. Consequently, in principle, the bar for accessing copyright protection remains rather high.

Nevertheless, recent case law has shown a more flexible approach –

for instance, the Court of Milan has recognised the aesthetic impact of Moon Boot après-ski boots on consumers, which made them iconic for the Italian fashion industry (decision no 8628/2016, 12th July 2016).

The decision constitutes a landmark case, because the Court decided that artistic value, an essential requirement for enjoying copyright protection, can be recognised in industrial design products. Namely, the Court underlined that such value can accrue to industrial designs that have, over the years, gained widespread popularity and critical acclaim. Specifically, the Court took account of the fact that Moon Boots were exhibited at the Louvre as one of the 100 most significant design icons of the 20th century.

## OTHER PROTECTIONS

While EU regulations and national laws provide classic tools for protecting IP (such as trade marks, patents, designs, copyright and know-how), the Italian system offers a singular advantage for trade mark protection: Article 2 of the Italian Industrial Property Code recognises unregistered trade marks as exclusive rights of industrial property, deserving the same protection as registered trade marks. The statute was created to acknowledge the concrete use of a sign that is fully identified by consumers as a trade mark (ie as an indicator of origin) of the relevant goods/services. This Italian particularity echoes

the recognition of unregistered well-known trade marks under Article 6bis(1) of the 1883 Paris Convention for the Protection of Industrial Property, which grants protection to an unregistered sign enjoying public notoriety.

The recognition of unregistered trade marks under Article 2 is a strong asset for rights owners, since it does not require a very high level of notoriety. Therefore, this protection is an affordable way to compensate for the absence of registration of a distinctive sign where that sign concretely identifies services and/or products in the consumer's mind.

## O BAG EXPERIENCE

In particular, Italy has maintained a strong tradition in design protection, recognising the aesthetic appearance and the functional features of the creation. In July 2016, the Court of Milan defined the standards of assessment applicable to a design in the O Bag case, outlining the criteria to be applied both for a design's validity and its infringement. Both requirements shall be assessed according to the standard of the "informed user", who has a higher level of attention than the common consumer. The validity of such a title requires the fulfilment of two conditions: novelty and individual character. Infringement is evaluated according to an overall impression given by the products being compared in the eyes of the informed user, who has knowledge of the market sector concerned.





The Court of Milan, in December 2015, issued an interim decision on the O Bag products after urgent proceedings were begun against Ju'sto Srl by Full Spot SpA, owner of the O Bag trade mark and design. The order found that some of Ju'sto's bags infringed the O Bag registered design, and that the marketing of such bags amounted to unfair competition. The judges first affirmed that the O Bag design met the legal requirements of novelty and individual character. They then affirmed that there was an infringement, because the other party's design produced the same "overall impression" on the informed user.

The judges also assessed the existence of unfair business practices, under Article 2598(3) of the Italian Civil Code, deciding that, because the other party had reproduced a three-model line of products that imitated iterations of Full Spot's own products, this indicated an intention to take unfair advantage of Full Spot's creations and designs.

### UNREGISTERED DESIGNS

According to Italian case law, design disclosure – which is necessary for the enforcement of an unregistered design – requires there to be a "reasonable awareness" of the relevant design on the part of the public. This is a low standard of proof, and easier to achieve for rights owners. For instance, the Court of Milan has ruled that the exhibition of fabric during an international trade show could constitute sufficient evidence of such

reasonable knowledge, and the Italian courts similarly recognise a range of elements as evidence that do not necessarily involve the marketing of the related creation (such as a fashion show or advertisements in a fashion magazine).

For instance, the Court of Naples has acknowledged the existence of an unregistered design for "Glossy" Camomilla bags and granted full protection on the basis of an important promotional campaign carried out by the plaintiff. In other words, reasonable awareness of an unregistered design replaces the knowledge presumption that would result from the publication of a registered design.

On the basis of these criteria, the Court of Turin, in *Blufin v Organizzazione Grimaldi* (25th June 2016 in *GADI 2012*), has assessed the infringement of four unregistered designs created by Blufin and denied the existence of a "creative coincidence".

### ALTERNATIVE AVENUES

In a world where competition is tight and operators observe and copy each other, there is another way to ensure full protection of creations and preserve the goodwill emanating

from them. Article 2598 of the Italian Civil Code provides bases for unfair competition.

The provision includes the "lookalike" action, which aims to punish confusion purposely created by a competitor to take unfair advantage of a genuine creation.

Furthermore, it punishes acts of parasitism ("free-riding"), aiming to preserve the value acquired by a company through intellectual, material and financial investment over time. For instance, Decathlon, which owns a well-known brand, was imitated by a competitor that adopted a similar name and sign to benefit from that brand's high reputation (*Court of Catania*, 11th April 2016, *Usathlon v Decathlon*).

In *Ferragamo v DC Brands* (3rd May 2016, decision no 5732/16), the Court of Milan decided that the infringer had imitated all the characteristics of the Ferragamo word and figurative trade mark (a horseshoe), which is widely recognised as the symbol of Ferragamo's style and reputation. The Court considered that the imitation made by the infringer diluted the Ferragamo brand's strength and frustrated the promotional investment made to support it.

Finally, the Court of Milan, in a case of 14th May 2015 involving Morellato jewellery, confirmed the case-law trend in the matter of parasitism, finding the existence of unfair competition due to a systematic imitation of a competitor's creativity and work, with a consequent moral and patrimonial prejudice. The Court considered, in particular, that the moral prejudice corresponded to 50 per cent of the patrimonial prejudice.

In summary, and as I hope I have demonstrated, European and Italian law offer a range of tools for protecting creations against counterfeiters and competitors, and ample encouragement for rights owners to continue to promote and protect the results of their creative efforts. ■



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# One in the eye for Argos

*Jade MacIntyre sums up a transcontinental tussle*

**THE CLAIMANT, UK-BASED** catalogue retailer Argos UK Ltd (Argos UK), is the registered proprietor of two relevant EU trade mark registrations for the mark ARGOS. It has traded under that name in the UK since 1973. In 1996, Argos UK registered the domain name [www.argos.co.uk](http://www.argos.co.uk), which was used for its online shopping offering from 2004.

The Defendant, Argos Systems Inc (Argos US), is a US-based company that offers computer-aided design systems for residential buildings. Argos US has operated solely in North America since 1991; in 1992, it registered the domain name [www.argos.com](http://www.argos.com).

Central to this case was the question of whether the display of Google-generated adverts for the Claimant's goods or services that were displayed on the Defendant's website – in conjunction with use of the Claimant's trade mark in the domain name of that website – would amount to an actionable claim for trade mark infringement or passing off.

Google offers two forms of advertising service: Google AdWords and Google AdSense. Google AdWords is a pay-per-click advertising service that allows advertisers to bid on keywords or phrases. If those words or phrases are typed into the Google search engine, the



advertiser's adverts will appear above or near to the search results, and on the websites of its network of partner sites.

Google AdSense, in contrast, delivers contextually relevant Google AdWords adverts on Google's partner sites. These adverts often allow viewers to click through to the advertiser's home page, generating an income for the registrant of the partner website that hosts the adverts.

For the purposes of these proceedings, Argos UK was a customer of the Google AdWords service and Argos US was a partner to the Google AdSense service.

### WEB TRAFFIC

In 2004, Argos US experienced a significant increase in traffic to its website from the UK and Ireland. This increase coincided with Argos UK's launch of its e-commerce platform. In 2008, Argos US started displaying adverts on its website by becoming a partner to Google's AdSense service. When UK and Ireland-based users reached Argos US's website, the adverts generated and displayed by Google were usually "click-through" adverts for Argos UK, but also sometimes for its competitors. This generated an income for Argos US, which it submitted was used to offset the cost to its business of the increased bandwidth required to manage the UK and Ireland-based visitors to its website who had arrived there by mistake. These adverts were visible to all visitors to the website until 2012, when Argos US created a website that was only visible to users from North America.

The Google AdSense adverts were not shown on the North American version of Argos US's website, but remained visible on the version of the website available to the rest of the world. Having reviewed its website analytics, Argos US determined that the UK and Ireland-based consumers generally reached its website by mistyping Argos UK's website address, believing that Argos UK owned the [www.argos.com](http://www.argos.com) domain name. Argos US submitted that, in 2012, around 89 per cent of the traffic to its website was from the UK and Ireland (approximately 7.2 million clicks) and that 99.98 per cent of these visitors left the website within 10 seconds of arriving.

When it signed up to Google AdWords, Argos UK was required by the terms and conditions to grant Google and its partners any such rights that were necessary for the

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*It was common ground that Argos US's use and registration of the [www.argos.com](http://www.argos.com) domain name would not amount to infringement or passing off*

operation of the AdWords programme.

This included granting consent to the use of Argos UK's trade marks, along with the right to publish, display, transmit and distribute its adverts, and the right to place those adverts on any website provided by Google and its partners for that purpose.

In 2013, Argos UK reviewed its Google advertising spend and became aware of the significant volume of UK and Ireland-based traffic received by the Argos US website. It was around this time that Argos UK became interested in acquiring the [www.argos.com](http://www.argos.com) domain name. Following repeated refusals from Argos US to sell it, Argos UK commenced proceedings for trade mark infringement in the High Court of England and Wales under Articles 9(1)(a) and (c) of Council Regulation (EC) No 207/2009 (the Regulation), and for passing off. Argos US counterclaimed for a declaration of non-infringement in respect of its two websites, and an indemnity under the AdWords contracts made between Argos UK and Google under the Contracts (Rights of Third Parties) Act 1999.

### UK CLAIMS

It was common ground at the outset that Argos US's use and registration of the [www.argos.com](http://www.argos.com) domain name would not amount to trade mark infringement or passing off. However, in bringing its claim, Argos UK sought to argue that, by displaying adverts for Argos UK on a website whose domain name included the word "Argos", Argos US had crossed the line into trade mark infringement and passing off. In dismissing Argos UK's claims, Mr Richard Spearman QC (sitting as a Deputy Judge of the Chancery Division) held that, by agreeing to the terms of use for Google's AdSense service, Argos UK expressly consented to Argos US's



use of the sign ARGOS in the domain name www.argos.com and to the display of Argos UK's adverts on Argos US's website. As such, Argos UK was unable to rely upon that use as the basis of any claims that Argos UK might otherwise have had against Argos US.

Further, Mr Spearman held that neither the whole nor any sufficient part of Argos US's website was targeted at the UK and, as such, Argos US did not use the sign ARGOS in the UK. In coming to this conclusion, Mr Spearman reiterated the position of Mr Justice Arnold in *Stichting BDO and others v BDO Unibank, Inc and others*<sup>1</sup> that "the mere fact that a website is accessible from the territory covered by the trade mark is not a sufficient basis for concluding that the offers for sale displayed there are targeted at consumers in that territory". Argos US did not use the sign ARGOS in relation to goods or services that were identical to those for which Argos UK's marks were registered, and Argos US's use of the sign ARGOS did not affect the functions of Argos UK's marks.

Moreover, Argos US's use of the sign ARGOS did not give rise to a link between the sign and Argos UK's marks in the mind of the average consumer. Indeed, of the four emails provided in evidence by Argos UK, all appeared to have been generated by a mistaken assumption on the part of the sender that Argos UK's website was www.argos.com. Given that there was no actual evidence of confusion caused by any action taken by Argos US, Argos UK's claim under Article 9(1)(a) of the Regulation failed.

Although Mr Spearman found that Argos UK had a reputation in the UK, because Argos US's use of the sign ARGOS was not in the UK, the use did not give rise to any detriment to the distinctive character or repute of Argos UK's mark, nor did it take unfair advantage of the distinctive character or the repute of Argos UK's marks. Additionally, he found that Argos US's use of the sign ARGOS was not without due cause. As such, Argos UK's claim under Article 9(1)(c) of the Regulation also failed.

Mr Spearman went on to add that, even if Argos US's use of the sign ARGOS was infringing use under Articles 9(1)(a) and (c), Argos US was entitled to use the "own name defence" under Article 12 of the Regulation as its use of the word "Argos" was use of its own name and in accordance with honest practices in commercial matters. It should be noted that this defence is no longer available to company

names, being restricted to natural persons following amendment of the Regulation in March 2016. Although it was not disputed that Argos UK had goodwill in the UK, Mr Spearman held that it had not established that a material misrepresentation to the public had been made by Argos US's use of the ARGOS mark. Neither did Argos UK establish any actual damage or the likelihood of damage, or that Argos US's domain name was an instrument of fraud. As such, Argos UK's claim for passing off also failed.

### COUNTERCLAIMS

Mr Spearman also dismissed Argos US's counterclaim in respect of the indemnity on the basis that it applied only in respect of liabilities to third parties that are not parties to the Google AdWords contracts. He was of the opinion that the various Google AdWords contracts did not provide Argos US with an indemnity in respect of any liability to Argos UK as a result of displaying Argos UK's ads on its website. Finally, the Deputy Judge held that Argos US's claim for a declaration of non-infringement was to be dealt with after the judgment was handed down and once both Argos UK and Argos US had had an opportunity to agree a draft order that reflected his ruling.

### CONCLUSION

The case was hard fought, yet the Court declined to intervene in a situation where one entity had happily traded as Argos in the UK and Ireland for many years, and one had happily traded as Argos in the US for many years.

UK brand owners wishing to "recover" a domain name containing their trade mark will do well to ensure that the registrant of the domain name is actively targeting consumers in the UK before bringing an action. Care should be taken before commencing such a claim, especially in cases where it appears to be a commercially led attempt to obtain the validly registered domain name of a third party.

### KEY POINTS

- ▶ This decision confirms that the simple registration of a domain name containing the trade mark of a third party would not itself support a claim of infringement or passing off
- ▶ The mere display of Google-generated adverts for a claimant's goods and services on a defendant's website would not be sufficient to support such claims

1. [2013] EWHC 418 (Ch).



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# No accounting for taste

*A decision not to produce evidence was a costly choice for Cristal competitor, writes Rachel Fetches*

**THE HIGH COURT** ordered J Garcia Carrion SA (JGC) to account to Champagne Louis Roederer (Roederer) for €1,332,844.64, which the Court held was the profit JGC made on sales of its cava under the infringing sign Cristalino, despite JGC's failure to disclose any information.

Roederer's Cristal champagne has been sold in the UK since 1949 and retails at upwards of £175 per bottle. Roederer was the registered owner of the UK and EU trade mark for the word CRISTAL. JGC claimed to be the largest Spanish producer of wines in Spain and the EU. JGC launched a brand of sparkling wine under the name Cristalino and retailed it in the UK from 2004 to 2011. Roederer issued proceedings for trade mark infringement. In October 2015, JGC was found to be liable for trade mark infringement.

## CONFUSION

Mrs Justice Rose held JGC liable for trade mark infringement on the basis that its Cristalino product was likely to be confused with Roederer's well-known prestige champagne, Cristal, and on the basis that the use of the Cristalino name had the effect of diluting and taking unfair advantage of Roederer's CRISTAL marks.<sup>1</sup>

Following judgment, Rose J declared that Roederer was entitled to either an account of profits or an inquiry as to damages for the infringement. To assist Roederer with its choice, Rose J ordered JGC to give Roederer disclosure of the number and value of sales in the UK of Cristalino products since 19th March 2004 (being the date six years prior to the issue of the proceedings), together with the sums received by JGC in respect of such sales. As it had done previously, JGC failed



“  
*Documents from foreign proceedings and retailers were considered to provide sensible information that the Court could rely on*

to comply with that order, despite further orders providing for service via email.

Nevertheless, Roederer elected for an account of profits and provided its own evidence of sales by JGC. This was based on evidence produced by JGC in other disputes at the Commercial Court in Brussels, the UK IPO and the US District Court of Minnesota, as well as information from supermarket retailers that had supplied the infringing product in the UK.

### COURT APPROACH

In light of the total and continued non-compliance by JGC, in the absence of a request by JGC to cross-examine Roederer's witnesses, the Court directed that Roederer's evidence would stand unchallenged. Based on that evidence, the Court found that the number of infringing bottles sold by JGC in the UK market during the relevant period was 2,868,183. This took into account a temporary non-infringing name change by JGC from 2007 to 2008, and the effect of the 2008 global economic downturn on luxury products.

The Court considered the likely profit obtained by JGC in two parts. The first was the determination of the gross profit, namely the profit secured by JGC having regard to the direct costs incurred in the production of the infringing product. The Court held that a contribution margin figure of €0.4647 per bottle was correct, based on material placed before the US District Court of Minnesota by JGC. This was an appropriate proxy for the gross profit obtained by JGC from the sale of each bottle, being the contribution that the sale of each bottle made towards the general costs of JGC's business, after the payment of the direct costs incurred in the production of

that bottle. Based on the number of bottles sold, the gross profit figure was found to be €1,332,844.64.

### DILUTION QUESTION

Second, the Court considered whether the profit should be diluted or reduced by way of further allowance or discount against the gross profits, to reflect an element of the general overheads of JGC's business. The evidential burden of proving that there were any relevant overheads attributable to the infringing activities was on JGC. Without evidence from JGC, any allocation would have been speculation; therefore, following *Hollister v Medik*<sup>2</sup>, no allocation of general costs could be made. The general overheads are only deductible from gross profit where they are properly attributable to the infringing activity.

The Court also considered whether there was any proper basis for further allowance or discount to reflect that part of the profit that was not attributable to the infringement but, for example, reflected the intrinsic value of the product such that the sale was not "driven" by the infringement. The Court considered that *Rose J*'s findings on infringement indicated that the demand for the product was driven by the infringing use of the Cristalino label and get-up. Without evidence from JGC to refute this, the Court could not make any deduction to the profit figure.

### ABSENCE ISSUE

This case is interesting, as it demonstrates a party evidencing an account of profits in the absence of disclosure. Had JGC engaged in the Court process, it may have been able to significantly reduce the award. In this case, documents disclosed by JGC in foreign proceedings and documents produced by retailers of JGC's product were considered to provide commercially sensible information that the Court could rely on in determining the account of profits.



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### KEY POINTS

- ▶ Parties cannot pursue a policy of non-compliance with the court process as a means to avoid an account of profits
- ▶ If a defendant does not provide disclosure for an account of profits, it is important to collate material that provides a credible and coherent case on the likely sales of an infringing product that the court will deem commercially sensible

1. *Champagne Louis Roederer (CLR) v J Garcia Carrion SA and others* [2015] EWHC 2760 (Ch).
2. [2013] FSR 24.



# Gold standards

*Even long-standing use and recognition did not translate into a monopoly trade mark right, writes Chris Morris*

**THIS CASE CONCERNED** a UK trade mark application to register the word SOVEREIGN for “gold commemorative coins”, filed by The Royal Mint Ltd (RM). The application was successfully opposed by the Opponent, The Commonwealth Mint and Philatelic Bureau Ltd (CMPB), with that decision then appealed by RM to the High Court.

## CASE FACTS

“Sovereign” coins have been struck since 1489, first by The Royal Mint, and latterly by RM in its current status as a private limited company. Sovereign coins are manufactured and produced by other mints, and are legal tender in countries and territories such as Andorra, Cyprus, Gibraltar, the Isle of Man, Jersey, New Zealand and Tristan da Cunha (a British Overseas Territory).

It was common ground in the proceedings that no party other than RM can issue a sovereign as legal tender in the UK. There is no prohibition on trade in the UK in sovereigns issued outside the UK.

Sovereign coins produced by RM do not bear the word “sovereign”, in contrast to many of those made in other territories.

## OPPOSITION

CMPB opposed the application on absolute grounds under s3(1)(c) and (d) of the Trade Marks Act 1994 – descriptiveness, and customary in trade, respectively – arguing that: “The word SOVEREIGN is in common use in and beyond the trade, and is widely recognised, as a word describing coins of a particular type and denomination that may be legal tender in any one of a number of countries/territories.”

The Hearing Officer (HO) agreed with CMPB on both grounds, and further

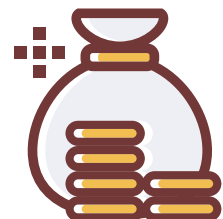
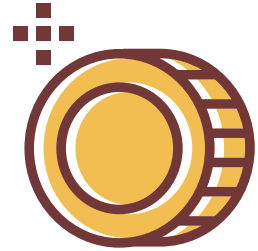
concluded that SOVEREIGN had not acquired distinctiveness through use.

In assessing whether a descriptiveness objection under s3(1)(c) should apply, the HO had to consider whether “the sovereign is not a kind of coin [as CMPB argues] but a name which distinguishes coins from a particular source” (ie RM). He concluded:

“Although the denominative value of a sovereign is nominal, sovereigns are legal tender in the UK with a face value set down by statute. Secondly, the evidence shows that RM itself draws attention to the denominative meaning of sovereigns in its marketing material, particularly in its certificates of authenticity. Thirdly, RM’s promotional material uses ‘sovereign’ in an analogous way to other obvious denominations, such as ‘The Official Queen’s Diamond Jubilee UK £5 Coin’. This is likely to have reinforced the denominative significance of ‘sovereign’ to UK consumers. Fourthly, although the quality of the sovereign coins issued by RM is closely controlled, this is true of all coins minted by RM to meet statutory requirements, including legal tender for general circulation, such as pound coins. No one would say that ‘pound’ is a trade mark for coins. Consequently, although quality control of goods sold under the contested mark is consistent with sovereign being a trade mark, it is not sufficient to establish that it is perceived as a trade mark (rather than as a kind of legal tender coin) by relevant average consumers.”

The objection was therefore upheld.

As regards the s3(1)(d) ground, the HO found that the average consumer may be aware that most sovereigns available in the UK are produced by RM, but will also be aware of the availability of commemorative sovereign coins from elsewhere.





Consequently, even though by far the majority of sovereign coins are RM tender, the word alone could not guarantee trade origin, due to it having become customary in the current language, or *bona fide* and established practice in the trade.

Again, the objection was upheld. RM appealed.

#### APPEAL POINTS

The first point of interest on appeal was the lack of weight given by the HO to two expert witnesses. Both were experts in coinage (“it is unlikely that there is anyone more knowledgeable”, according to RM), and that very expertise counted against them, with the HO concluding that their views were, consequently, unlikely to represent those of the average consumer. The Judge on appeal saw no reason to diverge from this position.

The second point of appeal attacked the conclusion that sovereign is a denomination in the UK, albeit (the HO concluded) a nominal one, with coins worth far more than their face value. RM argued that because sovereign does not form part of a “coherent currency system”, in contrast to the pound and penny, the name does not indicate the value, but rather the type of coin, being struck exclusively by RM.

Considering the evidence that had been presented to demonstrate various clear usages of sovereign as having a denominative value – including Acts of Parliament and materials produced by RM – the Judge again found the conclusions reached were reasonable.

A third ground of appeal was the argument that the HO failed to find that RM has a legal monopoly to make and issue coins called sovereigns in the UK – the claimed logical conclusion being that sovereign must, then, distinguish goods of RM.

The Judge reiterated the HO’s finding that, while RM is the only entity that can produce sovereigns as legal tender, a trade in sovereign



*Though by far the majority of sovereign coins are RM tender, the word alone could not guarantee trade origin, having become customary in the current language*

coins produced elsewhere is ongoing and legal. The Judge confirmed that the fact that no one but RM can produce sovereign coins does not mean the word is distinctive of its coins, because of the trade in international sovereign coins.

Having concluded as above, the Judge found that an appeal against the HO’s conclusions in respect of s3(1)(d) must also necessarily fail. Sovereign is customary in the trade.

This case shows that a near monopoly on sovereign coins in the UK and extremely long-standing evidence of use is not, in itself, enough to obtain a monopoly trade mark right if customers cannot be shown to perceive the sign as a trade mark. It also demonstrated the need for right holders to police their own use, and to ensure that it is proper trade mark use. The potential pitfalls of putting reliance on expert advice offered an interesting subplot.

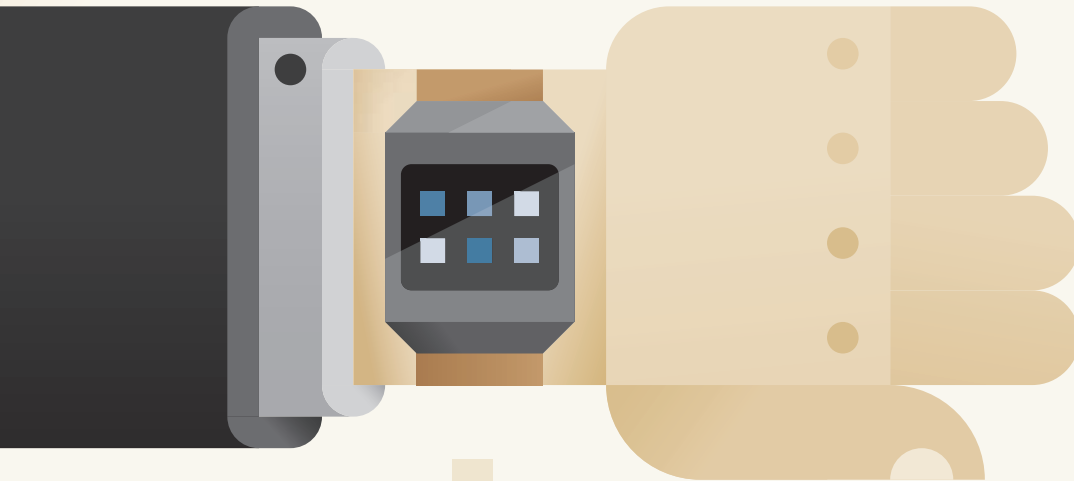
#### KEY POINTS

- ▶ The word “sovereign” alone could not guarantee trade origin, due to it having become customary in the current language, or *bona fide* and established practice in the trade
- ▶ Expert witnesses called on by RM were held to have views that were unlikely to represent those of the average consumer
- ▶ A near monopoly on sovereign coins in the UK and long-standing evidence of use is not, in itself, enough to obtain a monopoly trade mark right if customers cannot be shown to perceive the sign as a trade mark



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# Watch words

*Kate Swaine reports on a decision that explored the boundaries of “descriptive”*

**APPLE INC ACQUIRED** a third party’s application to register IWATCH in classes 9 and 14. Following examination, the application was rejected by the UK IPO in respect of goods in class 14, and opposed by Arcadia Trading Ltd in respect of goods in class 9 on the grounds that it was descriptive or devoid of distinctive character.

At the UK IPO, the Hearing Officer (HO) was satisfied as to the registrability of IWATCH for the following goods in class 9: “security devices; cameras; computer peripherals; radios; [and] accessories, parts, components and cases for all of the foregoing goods”.

However, the HO upheld Arcadia’s opposition, and so refused to permit the application to proceed to registration in relation to the



following goods in class 9: “computer software; computers; monitors and monitoring devices; computer hardware; wireless communication devices; audio and video devices; global positioning system devices; [and] accessories, parts, components and cases for all of the foregoing goods”.

Apple made an appeal to the High Court in which Mr Justice Arnold considered and answered three questions, summarised below.

1. Was the HO wrong to hold that the class 9 specification covered smartphones in the shape of a watch, or smartwatches?

No. A multipurpose product could be classified in more than one class. The HO had correctly determined that smartwatches had dual functionality and were proper to class 9 as well as class 14.

For a trade mark to be registrable in respect of a category of goods, it must be free from objection on absolute or relative grounds with respect to any goods in that category. A number of the class 9 goods were broad enough to embrace smartwatches, and so the HO had not erred in considering registrability with respect to such goods.

The fact that smartwatches were not specifically included in the list of goods in class 9 in the 10th edition of the Nice Classification (the edition in force at the time) was immaterial, and it fell to the HO to determine the correct classification of the goods in accordance with the 10th edition.

The Judge also commented (as counsel for Arcadia had argued) that, in principle, it would have been open to Apple to try to devise a more restricted specification of goods that excluded smartwatches. However, Apple made no attempt to do so either before the HO or on appeal (presumably because, for Apple, this would have deprived the mark of its commercial value).

2. Was the HO wrong to hold that IWATCH was descriptive for computer software?

No. Smartwatches depend for their operation on the computer software they incorporate; the HO had not erred in concluding that the mark was descriptive of such software, and specifically computer software incorporated in smartwatches.

3. Was the HO wrong to reject Apple’s case of acquired distinctiveness?

No. The HO had concluded that a trade mark (here, IWATCH) could not acquire distinctive

character as a result of the use of different marks (such as IPHONE and IPAD) that shared a feature with the first trade mark (here, the “I-” prefix).

The Judge was satisfied that none of the authorities relied on by Apple (Nestlé v Mars C-353/03, Il Ponte Finanziaria v OHIM C-234/06, Future Enterprises Pte Ltd v EUIPO T-518/13) established that the HO’s interpretation of the legislation was wrong in this respect. With regard to Future Enterprises, the Judge noted that, although the General Court talked about the prefix “Mc-” having “acquired its own distinctive character”, this prefix was not descriptive of any characteristics of the goods or services in question. Nor were any of the relevant trade marks, including the contested trade mark, viewed as a whole. The Judge concluded that it did not necessarily follow from this case that a trade mark that is descriptive (or otherwise lacks distinctive character) can acquire distinctive character as a result of the use of other trade marks with which it shares a common feature.

However, conscious that the point had not received the “fullest of arguments”, he declined to express a “concluded view” on the interpretation of Article 3(3) of the Trade Marks Act 1994 unless necessary to do so; and he decided that it was not.

The Judge was satisfied that the HO had correctly concluded that Apple had not established that IWATCH had acquired a distinctive character in any event. Apple had relied on use of the marks “IPHONE”, “IPAD”, “IPOD” and “ITUNES”. The Judge agreed with the HO that it did not follow that the average consumer would perceive the trade mark IWATCH, presented, for example, in the form “Iwatch”, as denoting goods from the same source.

The High Court’s decision in this case demonstrates how trade mark law continues to adapt to technological developments, and how brand owners may face limits regarding prefixes’ brand association for consumers (and the courts).

**KEY POINTS**

- ▶ A multipurpose product may be properly classified in more than one class specification
- ▶ The mark IWATCH was descriptive of computer software, as smartwatches depend on computer software for their operation
- ▶ The trade mark IWATCH could not acquire a distinctive character as the result of the use of different marks that shared a feature with the first trade mark



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# Soul survivor

*Emily Gittins explains why Matalan's mark finished ahead of a cycle fitness brand's prior registration*

**SOULCYCLE INC**, the US-based fitness company famed for its intense indoor cycling classes, has lost an appeal against a decision of the UK IPO in which the Hearing Officer (HO) dismissed an opposition made by SoulCycle to the registration of the figurative mark SOULUXE (shown below) by the UK-based fashion retailer Matalan Ltd.

In June 2015, Matalan applied to register the figurative mark in relation to goods and services in classes 18, 25 (which included various articles of clothing), 28 and 35.

SoulCycle asserted its opposition under s5(2)(b) of the Trade Marks Act 1994 on the basis that it had registered prior rights consisting of a number of UK and EU marks for various goods and services that incorporate the word “soul”, either by itself or as part of a longer word or composite mark. In some cases, the “o” is replaced by a bicycle-wheel emblem (although the High Court interpreted this as a “flower-like” emblem in the appeal). For the purposes of the opposition and appeal, it was accepted that confusion should be assessed on the basis of SoulCycle’s registration for the word SOUL, registered in relation to various articles of clothing in class 25.

Mr Oliver Morris, acting as HO at the UK IPO, dismissed the opposition in its entirety.

In his decision dated 22nd September 2016, he found that there was no likelihood of confusion between SOUL and SOULUXE.

## CLASS CONSIDERED

The HO held that there were two different classes of average consumer that must be considered: (i) those who would not separate the word “soul” from SOULUXE, but rather see SOULUXE as a wholly invented (or

“portmanteau”) word (the Unit Group); and (ii) those who would break the mark down into its component parts and appreciate that it began with the word “soul” (the Soul Group).

The HO concluded that there was no likelihood of confusion “for obvious reasons” in relation to the Unit Group. Although he appreciated that, for the Soul Group, there was some conceptual similarity between the marks, this “should not be placed at a high level because of the way in which that word combines with the rest of the verbal element ... creating either a meaningless word as a whole, or invented word combination ... that indicates luxury as well as the meaning of SOUL”.

The HO did not feel that it was a “normal way” in which a sub or variant brand would be presented, and that this was not aided by the fact that the common “soul” element does not perform an independent, distinctive role in the mark. Even if “luxe” is able to connote luxury, the “unusualness” of the end result (SOULUXE) does not indicate a variant or sub-brand of SOUL. Therefore, the HO held overall that there can be no likelihood of (in) direct confusion.

## APPEAL

In the appeal, counsel for SoulCycle criticised the HO’s failure to give proper effect to the view that “soul” would be an apparent word at the beginning of the new mark SOULUXE, and argued that the HO was wrong to proceed on the basis of two different classes of the average consumer, “each determined by their own perception of the mark as opposed to being defined by reference to a matter extrinsic to the mark”. Instead, counsel submitted that there ought to have been only the Soul Group. Mr Justice Mann distilled the “real question” at issue: whether the HO ought to have recognised the primary purpose of the Soul Group, and that it was unavoidable that, by the nature of those individuals in the



*Mann J rejected arguments that the Hearing Officer had applied too narrow a test with regard to confusion*



group, their recognition of “soul” and the concept would lead to confusion, because the “luxe” element only added a perception of luxury.

Mann J, following Mr Justice Arnold’s reasoning in *Interflora*<sup>1</sup> that there is no “single meaning rule” in trade mark law, did not consider that the HO had erred by considering two different classes of people within the same apparent type of consumer (ie retail purchasers). It was, therefore, correct to define people by reference to how they perceived an aspect of the mark.

Mann J went on to disagree with SoulCycle’s submission that the HO had merged the Soul Group and the Unit Group by discussing how conceptually similar the Soul Group would find the marks. By saying that average consumers in this group would see SOULUXE as starting with the word “soul”, yet the mark as meaningless, the HO was merely acknowledging that the Soul Group’s appreciation of “soul” was part of a meaningless whole – whichever way members of the group recognised “soul”, its significance was ultimately reduced due to its position in the mark and its combination with characters that follow. SOULUXE as a whole need not be meaningless only to the Unit Group.

Finally, Mann J rejected arguments that the HO applied too narrow a test with regard to

confusion when he dismissed the idea that SOULUXE presented itself as a sub-brand. This line of analysis was prompted by consideration of a test originally proposed by SoulCycle’s counsel at first instance. Mann J found that not only had the HO clearly understood the submission, but that he actually went on to consider matters that SoulCycle’s counsel seemed to be saying he ought to have considered in the first place – in particular, by considering whether and the extent to which the word “soul” in SOULUXE performed a distinctive role in the mark.

Mann J dismissed the appeal in its entirety.

### NO REWRITE

While this decision does not necessarily rewrite any rules, it does serve to highlight principles that are important in assessing confusion in arguably “meaningless” marks, and that multiple classes of people within the same type of consumer can be considered when assessing likelihood of confusion.

### KEY POINTS

- ▶ Opposition to SOULUXE was dismissed on appeal
- ▶ There was no likelihood of confusion with prior mark SOUL, since it did not perform an independent distinctive role, and the addition of “luxe” as a composite mark did not suitably indicate a variant or sub-brand

- ▶ The Matalan mark

souluxe  
● ● ● ●

<sup>1</sup> *Interflora v Marks & Spencer plc* [2013] EWHC 1291 (Ch).



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**Tobias Hawksley Beesley**, an Associate at Bird & Bird,  
 co-authored this article.



# Force fight

*Richard Ferguson reports on how the “dark side” won in this bad faith case*

IN A GALAXY far, far away... Brand Protection Ltd (BPL) applied for COME TO THE DARK SIDE (application no 3133517) for clothing and accessories in classes 14, 21 and 25. ABT Merchandising Ltd (ABT) opposed BPL's class 25 coverage in full. ABT submitted that the application should fail under s3(1)(a) and (b) – not a trade mark per s1(1), and lack of distinctive character, respectively – of the Trade Marks Act 1994 because the mark was commonly used as a slogan, did not serve as an indicator of origin and was associated with the *Star Wars* film franchise. ABT also claimed s3(1)(6) – bad faith – on the basis that BPL wanted to monopolise the marketplace by registering commonplace or third-party designs before filing takedowns to remove them from online stores.

The Hearing Officer (HO) found the mark to be non-distinctive for goods “apt to carry phrases”, such as T-shirts, under s3(1)(a) and (b). This is arguably an artificial distinction, given that merchandising is capable of applying to all and sundry, particularly “gymnastic shoes” and “shower caps” (allowed here).

Despite receiving less attention, the bad faith decision makes for interesting reading. Bad faith is not defined under s3(1)(6), but Red Bull v Sun Mark<sup>1</sup> summarises the general principles (at 130–138). The HO recited these principles before rejecting ABT's bad faith claim.

The HO stated that granting a monopoly in a commonly used slogan was not a solid basis for bad faith. This is sound logic for a banal slogan (say, WE ALWAYS LOAN for financial services), but the existence of an identifiable third-party rights holder and BPL's conduct makes this case distinguishable from that scenario. Questions

also remain unanswered as to whether BPL's application for the “non-merchandising” goods in class 25 referred to a set of goods wider than that for which BPL intended to use the mark.

The HO took further issue with ABT's evidence for only showing BPL registering and blocking other marks, not the present mark. Here, the HO appears to have given little weight to the evidence that cast light on BPL's past general conduct.

Bad faith will be found where an applicant knows that the mark belongs to another. Despite BPL acknowledging the *Star Wars* origin and the HO taking issue with the mark applied for being wider than BPL's use (eg COME TO THE DARK SIDE, WE HAVE COOKIES), bad faith was not found. How such conduct does not fall short of acceptable behaviour is questionable.

This case serves as a reminder that, because the bad faith bar is high, it is unwise to rely on it as a sole basis for opposition. A party making such an allegation must also ensure that its pleadings and evidence are as watertight as possible. Despite the fact that anyone is able to mount an opposition on absolute grounds, had Lucasfilm brought the claim, it may have provided the tribunal with a more persuasive foundation on which to base its decision.

## KEY POINTS

- ▶ The HO appears to have given little weight to evidence of the Applicant's past conduct
- ▶ It is unwise to rely on bad faith as a sole basis for opposition

1. [2012] EWHC 1929 (Ch).



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# Point of appeals

Nick Bowie suggests that questioning the Court can be productive

**THIS CASE CONCERNED** an appeal by M. I. Industries, Inc (MI) against a decision of the EUIPO Board of Appeal (BoA) in which the BoA found that none of the evidence adduced by the Applicant showed genuine use of the earlier marks for the goods in respect of which they were registered.

On 7th May 2013, MI opposed EU application No 011438074 for the logo shown below, covering a range of foodstuffs for dogs and cats in class 31. The opposition relied on Article 8(1)(b) of Council Regulation (EC) No 207/2009, namely likelihood of confusion with MI's earlier EU registrations for INSTINCT and NATURE'S VARIETY, both covering "pet foods and pet treats in class 31". In response to Natural Instinct Ltd's request to furnish proof of genuine use of the earlier marks, MI produced, *inter alia*:

- three invoices bearing the sign NATURE'S VARIETY and the name "instinct", addressed to MI's German distributor, Cats' Country;
- an affidavit from the owner of Cats' Country, Ms S; and
- a graphic representation of a product label bearing the word "instinct".

The BoA found that the evidence submitted as a whole did not demonstrate that goods bearing the INSTINCT and NATURE'S VARIETY marks had entered the German market during the relevant period. The BoA appeared to base its reasoning on the premise that use of a mark can be classified as genuine use only if its proprietor adduces evidence that the goods covered by it have been marketed to end consumers.

The General Court (GC) held that the BoA erred in its assessment, finding that

the relevant goods bearing the INSTINCT trade mark did not have to be sold to end consumers for that use to constitute "outward" and "public" use of the mark.

Further, the BoA held that the affidavit from Ms S should be given a lower probative value than that of third-party statements, bearing in mind that a contractual link existed between MI and Cats' Country. However, the GC found that the BoA had been incorrect insofar as a contractual link to the proprietor, on its own, is not a reason to apportion lower probative value to an affidavit.

Against this background, the GC held that the BoA's global assessment of the genuine use of the earlier mark INSTINCT was incorrect. As the evidence adduced in relation to NATURE'S VARIETY indicated no trade mark use, the BoA's decision was partially upheld.

Therefore, the BoA's decision was annulled insofar as it concluded that there was no genuine use of the mark INSTINCT. As no assessment of likelihood of confusion was conducted by EUIPO and the BoA, EUIPO was directed to draw appropriate inferences from its operative part and grounds.

While we wait to see how this case plays out, it does underline the potential merits of an appeal to the GC.

## KEY POINTS

- ▶ The BoA based its reasoning on the premise that use of a mark can be classified as genuine use only if its proprietor adduces evidence that the goods covered by it have been marketed to end consumers
- ▶ The GC held that the BoA had been incorrect insofar as a contractual link to the proprietor, on its own, is not a reason to apportion lower probative value to an affidavit
- ▶ The BoA's decision was annulled insofar as it concluded that there was no genuine use of the mark INSTINCT

- ▶ The contested mark

**Natural Instinct**  
Dog and Cat food as nature intended



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# A vintage victory

*Time was the key to keeping hold of a heritage mark, says Harry Rowe*

**THIS CASE CONCERNED** Lambretta, a vintage scooter brand. Lambretta itself has not manufactured scooters for many years. However, Scooters India Ltd, which owns the registered EU trade mark (EUTM) LAMBRETTA, uses the mark in relation to spare parts. The EUTM, which dates back to 2000, is registered for, *inter alia*, the class 12 class heading “vehicles; apparatus for locomotion by land, air or water”.

## REVOCATION PROCEEDINGS

In 2007, Brandconcern sought to revoke Scooters India’s registration for these goods on the basis of lack of genuine use. Scooters India unsuccessfully appealed the Cancellation Division’s subsequent decision to partially revoke the registration, with the First Board of Appeal (BoA) confining its examination of the genuine use in respect of the class 12 goods to the literal sense of the class heading. The BoA found that it could not be inferred from Scooters India’s evidence relating to the sale of spare parts that the proprietor had manufactured and sold any vehicle.

Scooters India appealed this decision to the General Court (GC), which found that the class heading had to be interpreted as including the alphabetical list in class 12, and that the BoA should have examined whether or not there had been genuine use for the many fittings and parts encompassed, even if “spare parts for scooters” was not explicitly included. The GC also found that examination of the use of the mark in relation to spare parts had to be made in accordance with the criteria set out in *Ansul*.<sup>1</sup> The GC annulled the contested decision.

Brandconcern appealed to the CJEU on the ground that, *inter alia*, the GC had erroneously found that Scooters India was entitled to

protection for all goods in the class 12 alphabetical list.

## CJEU DISMISSAL

The CJEU dismissed the appeal, finding that Scooters India had requested the annulment of the contested decision to revoke its registration for the goods in class 12, including “parts and accessories for vehicles and apparatus for locomotion by land” and, in the same application, submitted that those goods were a sub-category of the class heading.

The CJEU deemed that it cannot be held that the IP Translator<sup>2</sup> judgment sought to question the validity of the approach before the delivery of that judgment. Therefore, the rule that applicants must specify whether or not the application covers the full alphabetical list is not applicable to the LAMBRETTA registration, since the filing date was before the delivery of that judgment. Moreover, Brandconcern had failed to state which points of the GC’s judgment it was appealing.

This judgment confirmed that IP Translator can only be applied to applications or registrations filed after the date of that judgment. In accordance with IP Translator and Article 28(8) of Council Regulation (EC) No 207/2009, if a mark was filed in respect of the class heading before 22nd June 2012, it should be interpreted as covering the alphabetical list of that class.

## KEY POINTS

- ▶ IP Translator cannot be applied to applications/registrations filed before 22nd June 2012
- ▶ Specifications filed for class headings before 22nd June 2012 will be interpreted as covering the relevant alphabetical list

1. C-40/01, paras 40–43.
2. C-307/10, para 61.



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# Soft landing for Land Rover

*Victoria Leach dissects a recent General Court decision*

**THIS CASE CONCERNED** an opposition by Jaguar Land Rover Ltd (JLR) to Nissan Jidosha KK's (Nissan's) EU trade mark (EUTM) application for the word mark LAND GLIDER in respect of "electric vehicles (concept cars), except two-wheel vehicles" in class 12. Nissan's application coincided with the launch of its Land Glider two-seater, zero-emission vehicle in 2009. JLR opposed the application based on a number of earlier EU, German and UK registrations for LAND ROVER and the LAND ROVER figurative mark shown below.

The Opposition Division upheld the opposition on the basis of Article 8(5) of Council Regulation (EC) No 207/2009, deciding that the shared element "land" was distinctive for consumers who do not speak English, German or Dutch.

The Board of Appeal (BoA) overturned that decision and rejected the opposition under Articles 8(1)(b) and 8(5). In relation to Article 8(5), it decided that the common element "land" was descriptive of the class of goods (ie land vehicles, as distinct from vehicles used in the air, on water or on rails) and would be widely understood by consumers of cars (who would display an enhanced level of attention) across the EU.

## ANNULMENT

JLR appealed to the General Court (GC), which, having considered the Article 8(5) objection only, annulled the BoA's decision. The GC decided that the shared element "land" was distinctive for consumers who do not understand English, Dutch or German.

First, the GC rejected Nissan's arguments that "land" had found its way into all languages in the EU. Second, it did accept that some terms forming part of very basic English vocabulary are widely known to consumers throughout the

EU – eg "snack", "star" and "food". It considered whether or not "land" falls into the same category and looked at the various meanings of "land" beyond that considered by the BoA ("the designation of the solid part of the Earth's surface" and "countryside"), such as "country", "some kind of territory" and "kingdom".

The GC concluded that "land" in the sense of the meanings considered by the BoA did not form part of such a basic vocabulary that it could be assumed to be widely known throughout the EU. So, for a considerable part of the relevant public, "land" was not a descriptive element of the mark.

## FURTHER FINDINGS

The GC further held that the BoA had erroneously assessed the similarity between the marks and whether or not the relevant public would establish a link between them, given its incorrect premise that "land" was a weak element of the trade marks. The BoA had also failed to examine the earlier trade marks' reputation and the risk of unfair advantage in sufficient detail.

This decision emphasises the relatively high hurdle in establishing descriptiveness of components of trade marks across all relevant consumers of the EU in opposition proceedings. Even words that native English speakers may assume are widely recognised cannot necessarily be considered descriptive or weak for all of the relevant EU public.

## KEY POINTS

- ▶ In the course of opposition proceedings, for an element of a trade mark to be considered descriptive or a weak component of the mark, its meaning must be widely understood across all of the relevant public across the EU
- ▶ The GC considers that the word "land" is not descriptive for vehicles for a considerable part of the relevant public in the EU
- ▶ The Land Rover figurative mark



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# Lessons in language

*Dale Carter considers a case where linguistic knowledge was a focus*



**THIS DECISION OF** the General Court (GC) reaffirmed the unitary character principle of EU trade marks (EUTMs) and highlighted the importance of considering the perception of non-English-speaking consumers in assessing whether or not a likelihood of confusion exists between EUTMs comprising English words and pronouns – in this case, INWEAR and IWEAR.

On 9th February 2012, Lauritzen Holding AS (the Applicant) filed an EUTM application for the mark IWEAR covering goods in classes 18, 25 (class headings) and 28. The application was published for opposition purposes on 8th March 2012.

On 7th June 2012, DK Company A/S opposed the application in respect of goods in classes 18 and 25 based on a likelihood of confusion, under Article 8(1)(b) of Council Regulation (EC) No 207/2009, with its earlier EUTM for INWEAR covering, on the face of it, identical and similar goods by virtue of class 18 and 25 class headings.

On 2nd August 2013, the Opposition Division (OD) issued its decision upholding the opposition in respect of the majority of goods in class 18 and all goods in class 25.

## CONCEPTUAL LEAP

Although weakly distinctive from the perspective of the English-speaking consumer, INWEAR was held to be a mark of normal distinctiveness, because it had no meaning for part of the relevant public (ie those from non-English-speaking parts of the EU). The OD found the marks to be highly similar visually and phonetically from the perspective of these consumers. Conceptually, the marks were found to be dissimilar from the perspective of the English-speaking consumer; however, to the non-English-speaking consumer, they have no concept and so could not be compared. Based on a global assessment, a likelihood of confusion was found to exist.

The Board of Appeal (BoA) agreed with the OD's assessment regarding the high degree of similarity between the marks and that there was a likelihood of confusion. When it came to the conceptual assessment, the BoA stated that, although a significant majority of consumers in all Member States will recognise basic English words, there was no evidence to indicate that they would have the capacity to “mentally decompose” the marks at issue and assign a meaning to their individual parts.

The GC upheld the findings of the OD and BoA after considering conceptual similarity both ways: on the one hand, the average EU consumer's knowledge of English could not be regarded as being sufficiently extensive and sophisticated to make the conceptual associations proposed by the Applicant; on the other, if the average EU consumer is able to understand the meaning of the “WEAR” element of the marks, this would lead to the marks having a degree of conceptual similarity.

## KNOCK-ON EFFECT

This case reminds us of the unitary character of EUTMs and that, if grounds of refusal exist in one part of the EU, this is sufficient to lead to refusal across the whole of the EU. Although conceptual counteraction can still serve to distinguish between marks, offsetting visual and phonetic similarities, it can only do so where the concepts of the marks are capable of being grasped and are sufficiently different in the minds of all relevant consumers.

## KEY POINTS

- ▶ The unitary character principle of EUTMs was reaffirmed
- ▶ If grounds of refusal for an EUTM exist in one part of the EU, this refusal can extend to the whole of the EU



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Dale has worked in both industry and private practice. He provides strategic trade mark advice to clients across many sectors on a wide range of issues.



# events

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DATE	EVENT	LOCATION	CPD HOURS
8th June	<b>CITMA Lecture – Glasgow</b> Domain name update	Brodies LLP, Glasgow	1
14th June	<b>CITMA Webinar</b> Advocacy and evidence	Log in online	1
16th June	<b>CITMA, CIPA, AIPLA &amp; FICPI-UK Diversity Talk and Networking Breakfast</b>	Holborn Bars, London EC1	TBC
16th June	<b>CITMA, CIPA, AIPLA &amp; FICPI-UK Seminar</b>	Holborn Bars, London EC1	TBC
20th June	<b>CITMA Lecture – London*</b> Register less/register more: best practices in domain management and enforcement	Royal College of Surgeons, London WC2	1
23rd June	<b>CITMA Administrators' Webinar</b> Diversify or status quo? Are IP professionals sufficiently aligning trade marks with domain names?	Log in online	
27th June	<b>CITMA Lecture – Bristol</b> A sovereign affair	Burges Salmon LLP, Bristol	1
4th July	<b>CITMA Summer Reception</b>	Sea Containers, London SE1	
5th July	<b>CITMA/CIPA Commercial Skills Webinar</b> Professional ethics	Log in online	1
6th July	<b>CITMA Administrators' Webinar</b>	Log in online	
18th July	<b>CITMA Lecture – London*</b>	58VE, London EC4	1
13th September	<b>CITMA Webinar</b>	Log in online	1
26th September	<b>CITMA Lecture – London*</b>	58VE, London EC4	1
12th October	<b>CITMA Autumn Conference – Birmingham*</b>	Hyatt Regency Birmingham	5
24th October	<b>CITMA Lecture – London*</b>	58VE, London EC4	1
27th October	<b>CITMA Administrators' Seminar</b>	Keltie LLP, London SE1	

## SUGGESTIONS WELCOME

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

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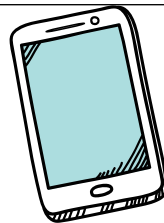
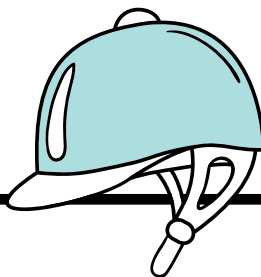


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## THE TRADE MARK 20

# Q&A



**I work as...** a (newly) Chartered Trade Mark Attorney at Hansel Henson.

**Before this role, I was...** a part-qualified Trade Mark Attorney, working as a Trade Mark Paralegal at Rouse IP.

**My current state of mind is...**

enthusiastic and ambitious. I am extremely happy in my role and feel very grateful to be able to learn and build on my experience in my firm.

**I became interested in IP when...** I got a job as a Legal Secretary and decided I wanted to work my way up to be a Trade Mark Attorney. After moving into a Legal PA position in trade marks and passing the CITMA Trade Mark Administrators' Course, I moved into a Paralegal position. After studying at Queen Mary University of London and Nottingham Law School, I accomplished my goal.

**I am most inspired by...** my son. He has always given me the strength and determination to live my dream. I have taken great pride in showing him you can achieve anything if you work hard enough.

**In my role, I most enjoy...** helping smaller clients fight for their brand, especially as they tend to have strong emotional ties to it.

**In my role, I most dislike...** billing.

**On my desk is...** my phone, a hot chocolate and *A Practical Guide to Trade Mark Law*.

**My favourite mug says...** "Keep calm, I'm an Essex girl!"

**My favourite place to visit on business is ...** EUIPO in Alicante. I hope to travel more in the future.

**If I were a brand, I would be...**

Innocent smoothies – full of goodness!

**The biggest challenge for IP is...**

trying to assess the impact of Brexit. Clients ask regularly how they can protect their brands, and this is an area where safeguarding their position is challenging.

**The talent I wish I had is...** to be part of the British Equestrian eventing team. I have grown up with horses and just don't get the time to compete anymore. But, going by Nick Skelton, I still have time!

**I can't live without...** my iPhone; it is always by my side.

**My ideal day would include...** waking up to sunshine and crashing waves, sunbathing by the pool with my partner and taking my son to a water park.

**In my pocket is...** nothing, it is all in my handbag, and there's too much to list!

**The best piece of advice I've been given is...**

you are better off being at the bottom of a ladder you want to climb, than halfway up a ladder you don't want to climb.

**When I want to relax I...** can't! At the weekends, I am too busy being a "soccer mum" – my son's football commitments are six times a week.

**In the next five years I hope to...** finish doing up my house, keep working up the career ladder and have a good client base.

**The best thing about being a member of CITMA is...** the *CITMA Review* and the lectures. They are very informative and keep you up to date with the relevant case law. They are also a great opportunity to network.



We find **Caroline Phillips** enjoying qualified life

“

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# The IP Canvas in India is Changing Rapidly!



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