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Issue 403 **July/August 2013** itma.org.uk

ITMA REVIEW

The journal of the Institute of Trade Mark Attorneys

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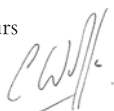
Summer salutations!

Welcome to our summer edition of the *ITMA Review*. I hope we have just met at the ITMA Summer Reception, and that the weather was perfect. (I had to write these words before the reception was held, so there is a measure of tempting fate and hedging bets.)

This edition has a wonderful article by the Rt Hon Sir Robin Jacob, an INTA report and a profile of Toe Su Aung, the UK-based INTA President, but mostly it focuses on designs. We have put together a design dossier of recent EU cases, coverage of a debate on the overlaps and boundaries of trade marks and design, advice on forum shopping and a report on Design Practice Day. There is much to be learnt!

Happy reading, and see you in Birmingham at our Autumn Seminar on 10 October 2013.

Yours



Catherine Wolfe
ITMA President

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Published on behalf of ITMA by:
Think, The Pall Mall Depot, 124-128
Barlby Road, London W10 6BL
Tel: 020 8962 3020
www.thinkpublishing.co.uk
Editor: Caitlin Mackesy Davies
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ITMA Review

Review content is provided by members on a voluntary basis, and reader suggestions and contributions are welcome. If you would like to contribute an article to a future issue, please contact Tania Clark by email at tclark@withersrogers.com and Caitlin Mackesy Davies at caitlin@thinkpublishing.co.uk.

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ITMA business

Member benefits

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In memoriam - Bruce Marsh

We regret to report the death of ITMA Member Bruce Marsh in March 2013, aged 47. Bruce had been fighting a battle with cancer over the past few years, but unfortunately took a turn for the worse following treatment this year. Bruce was born in Cheshire and was educated at King's School, Macclesfield, and Selwyn College, Cambridge. Bruce joined the profession as a trainee with Boulton Wade Tennant in 1989, qualifying there before joining Wilson Gunn in Manchester in 1996. He became a partner of Wilson Gunn in 1998 and subsequently trained several qualified attorneys practising today. Bruce was an excellent attorney and during his



time with Wilson Gunn was involved in many interesting reported cases. He was well known in the profession, being a regular attendee at INTA, where he made friends from all over the world. He was a Manchester City fanatic, a foodie (and "drinkie") and a keen amateur photographer. He enjoyed the odd game of cricket and a dance at the Christmas party. He was a wit and was always good value in any social setting. Most of all,

Bruce was a dedicated father to his daughter, Alex. He is survived by Alex and his loving partner Becky. He will be sadly missed.

Mark Goodwin

Member moves

Nick Phillips has joined Edwin Coe's corporate group as an IP and IT Partner. Nick's practice includes advising on a broad range of IP and IT issues, and encompasses both dispute resolution and non-contentious work. He also has considerable experience of more general commercial matters. Contact nick.phillips@edwincoe.com



Stobbs IP established

Stobbs IP Limited, trading as Stobbs, has now been established under the leadership of Julius Stobbs. The new firm is located in Cambridge. Further information about Stobbs can be found at stobbsip.com. Contact Emma Pettipher at epettipher@stobbsip.com

Media Watch

Good sport, bad sport

Ken Storey gathers some stories that highlight current perceptions of trade mark practice

We kick off this column with news that Gareth Bale (the Welsh international football star) has applied to register his goal celebration as a trade mark, a story that interested many news outlets. He's made two applications in classes 14, 16 and 25: one for the phrase "Eleven of Hearts" and the other for the heart shape he makes with his hand. Much comment has been critical of his attempts to protect what many feel is a generic shape akin to a thumbs-up sign. We shall see how the applications develop and, indeed, how Bale's career goes in the transfer window.

Also on the sporting theme, the *Herald Scotland* reported that a US firm has paid a six-figure donation to charity for breaching the St Andrews trade mark on a range of clothing. Streetwear Inc had been wrongly advised that it would not be infringing the St Andrews Links Trust's trade marks and had produced a range of golfwear products. Both sides recognised that it was an innocent mistake and reached an amicable settlement. I can't believe it would have been one of our members who advised the US firm, but I suspect the culprit is now out in the wilderness.

In a far worse place is ex-Hull FC and Great Britain Rugby League player Gareth Raynor, who is spending nine months in prison for trade mark infringement offences concerning fake computer ink cartridges. According to the *Driffield Times*, he imported

pre-conditioned ink cartridges from China, repackaging them to look like genuine brands. Apparently, he also replicated computer and video games software, and felt the full wrath of the Entertainment and Leisure Software Publishers Association, which worked with East Riding Trading Standards to bring the prosecution.

And, finally, I turn to the *Ham & High* in upmarket Hampstead in London for a story about Golden Balls (thankfully, not related to the Beckhams this time). Inez and Gus Bodur obtained a Community Trade mark (CTM) for GOLDEN BALLS for their sportswear range back in 2001, but have faced a challenge from FIFA, which argues that it infringes its own BALLON D'OR mark (a direct translation of Golden Balls). After OHIM initially took the Bodurs' side, FIFA successfully appealed to OHIM, claiming confusion. In addition to the clothing range, the couple



Gareth Bale has applied to register his goal celebration as a trade mark

ITMA member John Reddington spoke on the patent elements of guitar construction

licensed the mark to Endemol for the game show hosted by Jasper Carrot. The Bodurs have now lodged an appeal, reportedly funded from those licence arrangements, at the Court of Justice of the European Union. They have said that if they are successful they would like to see the laws changed so that small businesses fighting large corporations can get legal aid. That sounds like a good idea, but with clampdowns on legal aid I can't see it happening any time soon.

On the subject of bullying, I was drawn to an article in the *Guardian* on 30 April, headlined "Trademarks: the good, the bad and the ugly". This suggested: "It's time we stopped giving trade mark bullies a free pass to tell us what our own words mean - it's time to take them back." After outlining what the author believes trade marks are for, the article then turns into an attack on trade mark lawyers, citing the costs involved in defending trade marks by the issuing of cease and desist letters. The author's argument is that lawyers use bullying tactics to protect everyday words that have been granted trade mark status, and urges readers to report such occurrences to chillingeffects.org. Readers may like to take a look at the website, which is described as a "clearinghouse" logging online enforcement (and which the author thanks



for help in drafting his piece).

On much more upbeat notes I conclude this column with two articles written by senior ITMA members that take a more balanced view of the trade mark world. In *Retail Focus*, Kate O'Rourke and Catherine Richardson, both of Charles Russell LLP, used the copycat Apple Store case to explain the role of trade mark and design rights. In a similar vein, John Reddington spoke at length to *Guitarist* magazine to explain the whole gamut of IP Rights. As a band member and guitarist himself, John used his own skills to make the piece relevant and managed to cover the design and patent elements of guitar construction in a way that even the most drug-addled rock star might comprehend!



Ken Storey
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View from the regulator

Michael Heap provides his observations on and outlook for the profession

I am grateful for the opportunity to address the readership of the *ITMA Review* and want to use this valuable space to look at several issues that concern the way that IPReg works with you. The first of these is communication. The need for better communication with the profession (both through ITMA and CIPA, and directly with individuals and firms) has been a common theme of the feedback received by IPReg.

There are many ways in which an organisation can try to get its message across, but before it pursues these it needs to answer the question “Who wants to hear what I have to say?” For the IP regulator this is not as simple as it sounds: professionals, consumers and the oversight regulator all have differing expectations. So any communication effort must be balanced in the hope that all constituents feel included.

What IPReg has done so far is to have regular meetings with the Presidents of both ITMA and CIPA and non-council members of the profession, which have formed the basis of a valued dialogue. In addition, continued efforts have been made for more face-to-face meetings, as well as the development of a new IPReg website.

And, of course, the Trade Mark Attorney profession, with its distinctly personal infrastructure, allows for us to meet often – let’s do that.

Common themes

So far, two themes have emerged as I have engaged with you, either in formal meetings or the even-more-valuable informal chats. The first is the development of regulation (is there mission creep?) and the second is Alternative Business Structures (ABS).

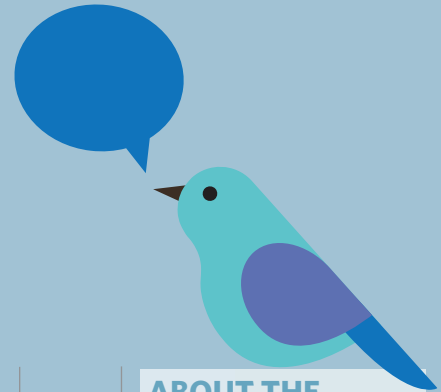
There is a paradox. On the one hand, the Government is calling for less regulation. At the same time, from banks to beef burgers, we’ve seen the absence of effective fetters on bad practice cause public anguish.

The burden of legal regulation does not fall only on the regulator. With each new requirement, individual registrants and the entities that employ them take a hit in terms of time and opportunity costs. But it does not end there, because the reputation of regulation itself and the acceptability of it are tested with each extension of the regulatory expectation. Readers of this article should be in no doubt that these concerns are brought to the attention of the “powers that be” at every opportunity; it is also worth pointing out that many IP professionals would be able to opt out of regulation if they felt that the reputational benefits of being part of a regulated structure were outweighed by the sheer burden of it.

Having got that off my chest, what is the immediate outlook? Even with the restraining hand of the front-line regulators gently placed on the Legal Services Board, there is set to be a continuation of expectation, in line with the requirements of the Legal Services Act 2007. IPReg is expected to meet the levels of regulation observable in other parts of the legal profession in the areas of risk management, diversity and wider market development.

ABS is certainly part of this development. The Board continues with its application to become a licensing authority and the target date remains spring 2014. This very tight timetable is achievable, but continued pressure will be needed to meet it. Already we have received informal approaches as to the benefits that may flow from having external capital and/or expertise within a firm. The traditional partnership model is not the only entity type in the world of IP and there is an expectation of further innovation in business modelling.

In quiet moments, members of the profession have asked whether the ratcheting up of the regulatory requirements for all firms is a result of



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the ABS application. “Maybe this would all go away if there were no ABS on the scene,” I have heard. Not so.

The pressure around risk, diversity monitoring and other regulatory requirements is a reality for all firms and not a product of the ABS application. Indeed, from a consumer point of view the ownership model of a firm has no bearing on the regulatory standards and protection expected.

Drive and energy

Perhaps the greatest impression I have had, as I meet practitioners, is the upbeat nature of you all. Yes, there are economic difficulties, but the drive and energy is there for all to see. The benefit to UK plc of the knowledge economy is a great prize and one worthy of nurture and protection. Regulation plays its part in both nurture and protection, and while a regulator cannot be a cheerleader for the profession, there clearly are strong links between professional excellence, international good repute and economic success. I continue to believe that, in its own way, a proportionate regulatory presence has a positive contribution to make towards your considerable professional endeavour. ■

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On going to the Bar

The Rt Hon Professor Sir Robin Jacob puts forward the case for closer cooperation with counsel

In April, ITMA's dynamic President organised a reception for ITMA members, the Bar and judges. It was in an early kind of trade marks registry – the College of Arms – and was a jolly event for all. It was also where your President collared me and lured me into writing this.

Actually, I am very glad to do it. I have long regretted that relations between the Bar and Trade Mark Attorneys (and Patent Attorneys) are not as close as they were when I started in IP in 1967. Things were very different then. The Bar was smaller than it is now and had a reputation for being a very boring place. I was told not to go to the Patent Bar (no use of the term “IP” then) for that very reason; indeed, the only reason I eventually did was because it seemed no one else wanted me.

What I found there was a profession that was largely engaged in what might be called shadow-boxing. Most patent work was by way of oppositions or belated oppositions in the Patent Office; most trade mark work was by way of oppositions in the Trade Marks Registry. Design and copyright work hardly existed at all. Actual claims in the courts for injunctions, damages and so on were rare – look at the thickness of [1967] RPC and you are looking at all the cases for the year that had even slight significance (the FSR existed but was essentially no more than an early print of what was to come later in the RPC).

Team effort

This world, odd though it was by today's in-your-face standards, was a good school. And one of the reasons for that was the close relationships the Bar had with trade mark and patent agents (as they were then called). The general pattern of litigation went something like this: the proceedings were started by the agent who drafted the pleadings and evidence; a few months before

the hearing counsel was instructed directly – when all the evidence was in; and finally, you had a conference the week before and then argued it before a Hearing Officer. In the case of patents, there were appeals to the Patents Appeal Tribunal (the single patent judge was Lloyd-Jacob J). There were hardly any trade mark appeals. Occasionally there was a bit of passing off in the courts, but not a lot in those pre-piracy days.

It was because the Bar was instructed directly that barristers came to know trade mark and patent agents. Everyone worked together – and there is nothing like working against a common enemy (the other side) to make good

'It is no good trying to get your case right on appeal: if you need evidence, the time to put it in is first time round, and that is also the time to try to make it overwhelming'

friendships. Astonishingly, agents were willing to instruct even a very junior barrister; I began getting my own work in 1968–69. Before that, as a “devil”, I sat in on my Master's conferences and there met young agents learning their trade from their seniors in much the same way as I was (although they were paid, but not a lot).

The familiarity was good for both sides. As I learned more and grew in confidence I began to understand significant differences between the approach of a barrister and that of an agent – particularly of those agents who did opposition work rather rarely. There were two differences. First, the barrister would concentrate on finding the strongest points of attack (or defence). Second, the barrister had a much more acute sense of the significance of evidence. The difference could be exemplified thus, for instance, in a case where evidence that a mark had become distinctive was required. The agent would ask the client for

figures of sales under the mark and would largely be content with that. The barrister would want more – proof that the sales had actually been under the mark, invoices and evidence of customer recognition. The idea was to bury the point beyond argument. I suspect this sometimes still happens – trade mark registries (home and OHIM) are apt not to be too critical and you can often get away with less-than-overwhelming evidence. But one should never count on it.

Learning curve

Thus I began to be less satisfied with the “advocacy-only” role. I needed to be in at the beginning, and was

increasingly able to get my agents to understand that. It meant focusing early on the winning (or at least best) points and having the courage to drop arguable, but lesser, ones. It meant working on the evidence to overwhelm the other side if it could be done. It also meant that it was possible to head off the running of two inconsistent points (for example in patents, the largely incompatible cases of obviousness and insufficiency). The forming – one might even say crafting – of a case at an early stage working with an agent was hugely enjoyable and I believe resulted in more wins (or good settlements – which count as wins) than would have happened with the late instruction model.

One other thing I learned is that trade mark agents in those days were not good if a case was, or was likely to be, a serious fight. Far too many never really understood what is almost a law of nature: that trade mark cases get worse with delay. The agents' usual

mode of working in oppositions was rather relaxed – the IPO allowed it and there was no real hurry. That is likely to be fine for the general run of cases. However, there are others where, from the outset, there is potentially a big fight. As soon as that appears to be the case, a good Trade Mark Attorney will go to the Bar. Even a few days' delay may matter. A change of gear is vital. And all the points I made about evidence become even more important.

I hope that has changed, although I can think of at least one case in the not-so-distant past in which the attorney who started a fight in the registry obviously did not go to counsel and put forward some rather weedy evidence on a point that had obviously not been thought through. Remember, it is no good trying to get your case right on appeal: if you need evidence, the time to put it in is first time round, and that is also the time to try to make it overwhelming.

What then of present-day relations between the Bar and attorneys? It has become less common to work on cases together and consequently relations are apt to be more distant and less satisfactory than when I started. I think attorneys should change that and they can easily do so. Going to the Bar is not difficult, and need not be expensive

(although some of the top barristers naturally command high fees). You do not even have to have a particular barrister in mind; all you have to do is to ring up the clerk to one of the well-known sets and say you want to instruct a barrister. There is no need to go to a senior one – there are a host of very good young juniors. And you need not take the clerk's recommendation – you can see what cases the prospect has been in, and ask your friends for recommendations. It is all very simple – the Bar is no longer stand-offish – indeed if you were to find a stuck-up barrister I suggest you drop him or her. Don't be afraid to negotiate fees – the clerk's first ask is unlikely to be their last! Get your conference early and in that conference work out who is going to do what and by when.

Going to the Bar means you can widen your experience beyond that of your firm, and get ideas from a variety of minds. An old solicitor I knew used to say that going to different members of the Bar was rather like a bee going from flower to flower – there was fertilisation of ideas. And, indeed, within a firm there is a danger of a monoculture of ideas.

So thanks to your President for asking me to write this and please do go the Bar, not only on Friday nights. ■

ABOUT THE AUTHOR



Rt Hon Professor Sir Robin Jacob is a retired Lord Justice of Appeal who, in addition to his work as a professor of IP Law at University College London, accepts appointments as an arbitrator and mediator.



Practice day proves productive

Alicia Instone summarises an informative joint CIPA/ITMA training event on designs

On 16 April 2013, David Stone (Simmons & Simmons), Katie Cameron (RGC Jenkins & Co), Lorna Brazell and Ewan Grist (Bird & Bird) presented a Design Practice Day course organised jointly by CIPA and ITMA and aimed at foundation-level students studying for the exams. The course focused on how to advise clients in practice, based on the statute and current case law, rather than a detailed review of the law.

Stone began the day by using the first morning session to cram in an introduction to copyright, design right and registered designs. He began by making it clear that, as with all other types of IP, each right should be considered individually and should be considered as separate “arrows” in the IP “quiver”. Stone went on to discuss each right in turn, pointing out where the rights were similar and where they were quite different, using a handy tabular format. The talk was supplemented by real-life examples and workshops

‘The course focused on how to advise clients in practice, based on the statute and current case law’

in which groups considered, given tight timescale and budget constraints, how best to protect “revolutionary” packaging using only three trade marks and three registered designs. This was followed up with an assessment of how well each group did in choosing its protection when actual copycat packaging was viewed. Stone then ran through examples of design filings made by big brand owners and the strategies used to protect new products from supermarket copying.

After morning coffee, Cameron discussed the practicalities of applying for registered designs at the UK IPO, OHIM and WIPO (via the Hague System). She ran through the mandatory and optional requirements under each of the three systems, as well as the key

differences and similarities. This included the seven-view limitation at OHIM, which is not present when filing in the UK or at WIPO; the danger associated with requesting deferred publication at WIPO (as not all signatories to the Hague System have a mechanism for deferring publication); and language requirements and costs. Cameron concluded by summing up the key advantages and disadvantages of each of the routes when considering choosing where to file.

After lunch, Brazell looked at designs in practice. She considered the requirements for registration, ie novelty and individual character and the meaning thereof in light of some recent decisions, concluding that the assessment is very subjective and that, essentially, we do not know which way judges will decide! After assessing whether there are any circumstances in which one would not register (essentially none), Brazell then turned to unregistered rights and included lots of practical details about

the records clients should keep (but that, inevitably, they do not) to help prove the existence of such unregistered rights. In considering assessment of freedom to operate – including the registered rights to be searched (and the fact that the class used in filing provides no limitation to protection) and unregistered rights – Brazell came to the conclusion that the task was impossible and that the best place to look would be your client and other people in its field of business. Finally, Brazell split the audience into groups and ran through some real-life examples, including the different types of protection that might be available for various products.

Following afternoon coffee, Grist kept everyone’s attention during the “graveyard slot” by looking at

infringement and recent decisions, including *Procter & Gamble v Reckitt Benckiser*, *Dyson v Vax*, *Jimmy Choo v Towerstone* and *Samsung v Apple*. Grist ran through the details of each case study, looking at the main points that each party submitted, any facts pertinent to the case and the decisions reached, including the reasoning of the judge. After considering cases on registered designs, Grist then discussed *Kohler Mira Ltd v Bristan Group Ltd* in relation to unregistered design rights, and *Designers Guild Ltd v Russell Williams (Textiles) Ltd* (trading as Washington DC) in relation to copyright. Grist brought out in his session the key things to bear in mind when an infringement is spotted, such as threats provisions, type of infringement, putting people on notice to counter any claims of innocent infringement and the remedies available. He concluded his presentation by briefly running through the advantages and disadvantages of each of the rights and the jurisdictions.

A short question and answer session followed, rounding off an informative and thorough day. ■

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Alicia Instone is a Patent and Trade Mark Attorney at Scott & York Intellectual Property Law. This report also appeared in the *CIPA Journal*.

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Inside INTA 2013

Adobe's Dan Poliak explains why a presence at this global IP gathering can be so important

It's 11am on Tuesday morning. At least I think it's 11am on a Tuesday morning, but it's hard for me to tell. I'm sitting at a table in the middle of a conference room in the Dallas Convention Center, meeting with counsel from France. It's my third meeting of the morning and probably my 10th meeting of the past two days, and I have to fight off the urge to nap, an urge that is being fuelled by both exhaustion and the rhythmic buzzing of the overhead fluorescent lights.

The conversations and meetings of the past few days have begun to blur into one collective memory, but luckily I have my case notes, as well as my trusty double-iced Americano at my side, both of which I will need to carry me through the rest of the morning and hopefully through the remaining two days of meetings here in Dallas. It's day four of INTA 2013, and it's business as usual.

For those very few in the trade mark profession who aren't already familiar with this event, I should explain that the annual meeting of the International Trademark Association (INTA) takes place every May, and is the largest gathering of trade mark practitioners in the world. More than 10,000 trade mark attorneys, paralegals, administrators and related professionals from around the globe gather for six days of meetings, negotiations, educational seminars, dining, drinking and general networking. It is both informative and overwhelming, and in my opinion there is no event like it in the legal profession in terms of sheer size and global reach.

For both lawyers from law firms and in-house practitioners, INTA offers a variety of critical benefits that aren't

replicated anywhere else. First, INTA offers daily educational seminars on important trade mark legal issues. US attorneys receive Continuing Legal Education credits for attending, but the subject matter of these seminars has international appeal. This year's topics included the roll-out of the new generic top-level domains and the effect that will have on trade mark enforcement, trade mark challenges faced by businesses operating cloud-based services, and an in-depth dissection of new case law worldwide. Second, INTA gives trade mark professionals the opportunity to meet with peers to discuss best practices (or to hire or interview new counsel or service providers). Finally, and

'Importantly for in-house attorneys, INTA provides an opportunity to meet in person with our counsel from countries worldwide and make decisions face-to-face'

probably most importantly for in-house attorneys, INTA provides an opportunity to meet in person with our counsel from countries worldwide. During the conference, my team and I can meet with our lawyers from around the globe, which allows us to resolve issues and make strategic decisions face-to-face. At previous INTA meetings, we had the opportunity to meet with opposing counsel from foreign countries to resolve issues that previously had been pending for months in just a single meeting. We have found these in-person meetings to be of critical importance to maintaining our relationships with foreign counsel and moving matters forward. And, of course, it is always fantastic to put a face to the names that we might not have met before.

At INTA a well-thought out schedule is critical, and it takes several years of attending to figure out its rhythm, its rules and how to pace oneself so as not to burn out. Luckily, in addition to the business meetings and seminars, there are many activities that offer a break from the formal proceedings, often taking

advantage of local attractions or historical sites. This year, for example, a reception was held at the Sixth Floor Museum at Dealey Plaza (in the building from which Lee Harvey Oswald shot at John F Kennedy).

However, while the INTA conference itself offers many benefits, for me the greatest take-away is the relationships that I've formed with trade mark professionals from around the globe during the 15 years that I've attended. In addition to the work necessities of the conference, it is the rekindling of those relationships that I look forward to.

So my 11am meeting has ended and I pull my INTA schedule out of my pocket to see where I need to be next. I look around the conference centre, where I can see furious activity at the tables that surround me. Somewhere at one of these tables is my noon meeting – with Sweden, or perhaps Singapore? I take a swig of my Americano and move on. With two more days to go, I am feeling ready to go home – but I am also looking forward to next year, when this starts all over again. ■

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Dan is responsible for managing the trade mark group at Adobe, which includes supervision of the registration, protection and enforcement of all Adobe trade marks and domain names, as well as the management of Adobe's copyright program.



TOE SU AUNG

Tania Clark profiles the current INTA President



With two parents involved in the shipping industry, International Trademark Association (INTA) President Toe Su Aung initially wanted to practice maritime law. However, when an early job interviewer suggested that it was not an industry suitable for a woman (something that hopefully would not happen now!) she ended up pursuing a career in IP. Many years on, it has proved a fruitful decision, and she is currently serving as General Counsel at BATMark Limited, heading up the anti-illicit-trade unit. Here, Aung is using her education from the National University of Singapore and University of London, as well as experience gained in a previous role at Rothmans International, to fight some of the most aggressive counterfeiting in the global marketplace.

Aung has also recently become the first Asian President of INTA, which involved what she describes as a series of stepping stones. Initially serving as an INTA committee member, then a committee chair, she subsequently sat on the Board of Directors. From there, she was asked to be an Officer, and acted as Secretary and Treasurer, among other posts, before becoming President Elect. With only a one-year tenure in this premier role, she intends to squeeze in as much as possible.

Among her goals is to aid in increasing the globalisation of INTA, and she travels extensively developing relationships and reaching out to other global brand owners. INTA, she feels, can do more and is on the cusp of greatness, particularly in Asia. Although there are many national and some regional brand-owner associations, she believes that none represents brand owners' interests to the extent that INTA does.

International cooperation is important, she feels, and this involves collaborating with other local groups and with international governments to push harmonisation of trade mark laws and procedures. Another primary goal is the accession of different countries to the Madrid Protocol. Where there has been resistance to the Madrid Protocol, this is being broken down by the

continuing advent of new members. Aung would like to see Brazil be next to join.

Aung's third goal is to engage with members and encourage them to become more involved in the Association. This means doing more than networking – education and policy issues also need to be considered. The INTA Board should be used to do outreach, attending industry events and becoming more visible so they can engage with members, she says.

Among the challenges she identifies for INTA and its members is public perception, particularly in Europe – not necessarily a backlash against trade marks, but a lack of understanding of IP. Aung points, for example, to the objections voiced by internet groups against IP rights, and also objections made to efforts to reform the Community Trade Mark, as examples of conflicts that have generated a lot of negativity and anti-IP sentiment. On the positive side of the balance, however, Aung believes that the OHIM Observatory has been well received and is beneficial in highlighting the benefits of IP.

The new generic top-level domains also represent a significant challenge, and INTA is monitoring the development of the new web regime. Having spent most of her career in-house, Aung has always been interested in the public policy side of IP, which has also led her to understand the operational issues in protecting trade marks and advising governments regarding the necessary action required. ■

CURRENT ROLE:

General Counsel, BATMark Limited (London); President, INTA

PREVIOUS

ROLES: Drew & Napier (Singapore); Rothmans International

EDUCATION:

Bachelor of Law, National University of Singapore; Master of Law, University of London

HOBBIES: theatre, dance, opera, hiking and cooking Japanese and Burmese cuisine

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Testing the boundaries

Riecha Sharma reviews a spirited discussion on the intersection between trade marks, designs and copyright

The Cinderella of IP law has finally arrived at the ball. So say many commentators, observing the prominence of design rights in recent case law around the world. But what are the wider implications of this trend? In particular, does the rise of design rights affect other forms of IP, such as copyright and trade marks?

On 16 April 2013, Edwards Wildman launched its “IP is Everywhere” campaign by hosting a debate between Professor Sir Robin Jacob and Professor Dr Alex von Mühlendahl on “Trade Marks, Designs and Copyright: Overlaps and Boundaries”. Sir Robin, a former Lord Justice of Appeal, is currently the Hugh Laddie Professor of IP law at University College London. Professor von Mühlendahl is a former Vice President of OHIM and currently a practising attorney at Bardehle Pagenberg in Munich.

Chairing the debate was Jonathan Griffiths (Senior Lecturer at Queen Mary School of Law), who predicted at the outset that the speakers would not reveal diametrically opposed positions, so the discussion would probably be rather more nuanced than a traditional debate. This proved to be the case, with Sir Robin and Professor von Mühlendahl finding common ground on several issues.

Professor von Mühlendahl began by discussing validity and protection issues relating to IP rights. In particular, he posed two questions: first, whether it was possible to grant concurrent protection of signs; and second, whether the grant of an earlier IP right precluded later IP protection for the same subject matter. Focusing first on trade marks, Professor von Mühlendahl noted that a sign that fulfilled the

requirements of trade mark law may also be protected as a copyright work or a design, and in rare cases, for certain three-dimensional signs, as a technical invention (bearing in mind the exclusion for shapes necessary to bring about a technical result). “What happens”, he asked, “once you have protection under different legal regimes?” In relation to trade marks the answer is clear: a registration would not be invalidated merely by the earlier grant and/or expiry of IP protection under different regimes.

Cutting-edge design

Turning his analysis to design rights, Professor von Mühlendahl noted that a design that fulfils the requirements of design law may also qualify for protection under the trade mark, copyright and/or patent regimes (although not for design features dictated solely by their technical function). In respect of the continued grant of design protection when earlier rights have already been granted or expired, Professor von Mühlendahl noted approvingly that subject to the novelty requirement under design law, and the prohibition on excluding copyright protection for the same subject matter, this could be achieved.

Sir Robin then picked up the discussion with a brief historical perspective on overlapping IP rights, or “parallel rights”, as he described them. He cited the 1902 case related

to US Playing Cards, where the Patent Office had objected to the registration of a trade mark on the back of a playing card on the basis that it was already registered as a design. The judge sitting in that case allowed the registration. Later, legislators realised the potential for overlap between registered designs and copyright and made a policy decision to exclude copyright protection under the Copyright Act 1911 for works used or intended to be used in any industrial process – a positive anti-overlap provision.

Despite this, Sir Robin thought that the provision had not worked particularly well and noted that “on the whole, the system is one of parallel rights at any time... it’s like a bunch of different guns that you can pick and use.” Indeed, Sir Robin was less than positive about this state of affairs, citing trade mark protection for the iconic Charles Eames chair and the Jif lemon case as examples of “a permanent monopoly in what is essentially a design and not really a trade mark at all [which is] somewhat worrying, but no doubt it’s within the aim of many people who are rich and powerful and who can push their cases.” Sir Robin urged policy makers to work out what they want to do with individual IP rights, as they are presently in danger of creating a series of rights with no rational relationship between them.

‘Sir Robin cited trade mark protection for the iconic Charles Eames chair and the Jif lemon case as examples of “a permanent monopoly in what is essentially a design” and somewhat worrying’

The speakers then discussed the deficiencies in the Alicante system of trade mark and design registration. Professor von Mühlendahl acknowledged that there were a substantial number of marks on the register at OHIM that would not have been registered if “proper standards” had been applied – the so-called “false positives”. However, given the resources available to OHIM, Professor von Mühlendahl said this was essentially unavoidable.

Uneven ground

Sir Robin observed that OHIM seemed to err particularly in registering containers that it regarded as original designs even though they lack acquired distinctiveness. Also cause for concern are instances in which applicants put a word element on something that otherwise would not be registrable, and OHIM permits registration. Although such marks could be legitimate composite marks, Sir Robin remarked that they opened the door for rights owners to pursue those who had used only the underlying shape etc, rather than the word mark itself as affixed to that particular shape, effectively widening the scope of their protection.

Similarly, Professor von Mühlendahl noted that the system for design registrations is known for its rapid action, and the vast majority of applications are granted within 24 hours. While this speed is impressive, it would be beneficial if OHIM put resources towards eliminating those “obviously non-designable designs which are simple logos”. Sir Robin noted that the unmerited presence of these designs on the register deterred

would-be producers from legitimately using or incorporating those designs. However, on the whole, both speakers were not overly concerned about the design-law regime, acknowledging that it seemed to be working well, and Professor von Mühlendahl predicted that “actually countries which still examine for designs... like China, Japan and America... may eventually also move into the European direction.”

As the discussion opened to questions from the audience, Mr Justice Arnold asked the speakers for their views on the overlaps between registered designs and copyrights, and particularly the exclusion of copyright protection for designs that had already enjoyed a monopoly right for 25 years. Did the speakers feel this was not a problem, or was it a policy issue that needed to be addressed “square on”?

Both speakers replied that the issue needed to be addressed square on. Professor von Mühlendahl observed that there were problems in how the overlap was defined – was the test “Is it capable of industrial application?” or “Has it actually been put into production?” Professor von Mühlendahl’s proposal was for a rule that registered designs would enter the public domain at the expiration of the design protection; this would avoid abstract evaluations about whether the subject matter was capable of design protection. However, Sir Robin felt that this solution would remove the incentive for rights holders to register a design in the first place.

ABOUT THE AUTHOR



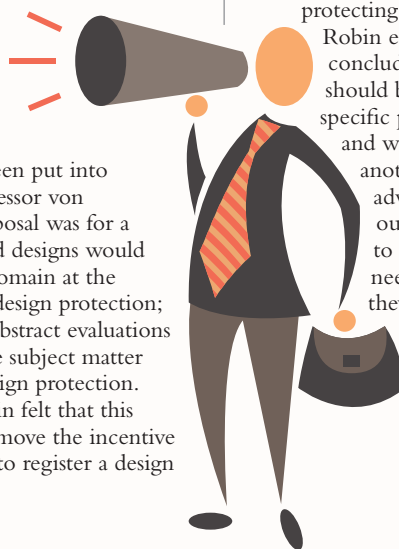
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As the debate drew to a close, Arnold J described the speakers’ positions as being “close to unanimity”, with neither speaker “particularly resistant to the conceptual possibility of cumulative protection... on the basis that trade marks and designs have quite different functions within IP law, serving different purposes and protecting different things”. Sir

Robin echoed this sentiment, concluding that “each right should be tailored for each specific purpose and that’s that, and whether it overlaps with another right is entirely advantageous”. Clearly, as our IP regimes continue to develop, policy makers need to ensure that they are doing so in a coherent manner.

It remains to be seen whether policy makers in the UK and Europe will heed the advice of the speakers. ■





Leaving lessons

Christopher Fisher and Karen Stewart set out the golden rules for protecting your business when key employees leave

Employees are critical to any business's success, and key employees have the potential to cause serious damage if they decide to leave. They may, for example, have had access to valuable confidential information that they could use to assist a competitor or set up in competition themselves. In addition, they may have the ability to persuade important customers or staff to leave with them.

This article looks at the preventative steps an employer can take to protect itself in the event that it loses an important employee. It also provides some practical guidance on handling team move situations in light of recent court cases.

Restrictive covenants

Restrictive covenants are express contractual provisions that place restrictions on what an employee can do following the termination of their employment. Without such covenants, an employer will be unable to prevent former employees from competing, or from poaching staff or customers when their employment ends, provided they are not misusing confidential information (see right). As such, employers should ensure that key employees are subject to restrictive covenants.

'Restrictive covenants should be relevant to a particular individual's role and limited not only by reference to a prohibited activity but also by temporal and geographical limitations'

As a general rule, restrictive covenants will be upheld by a court only if an employer can show that they protect a legitimate business interest, and go no further than is necessary to protect that interest. What is reasonably necessary will depend heavily on the circumstances. As a general rule, however, restrictive covenants should be relevant to a particular individual's role and limited not only by reference to a prohibited activity but also by temporal and geographical limitations.

When imposing restrictive covenants, an employer should consider:

- 1) What is the legitimate business interest that needs to be protected?
- 2) What type of restriction needs to be imposed on this particular employee to protect the legitimate business interest?
- 3) How long does the restriction need to last?
- 4) How far does the restriction need to extend geographically?

Employees' restrictive covenants ought to be updated regularly and in particular when an employee is promoted or their duties change.

Confidentiality clauses

Every employee is required to protect the confidentiality of their employer's trade secrets following the termination of their employment. This is part of an employee's implied duty of fidelity. Trade secrets will include secret processes of manufacture, such as chemical formulae, designs or special methods of construction, and "other information which is of a sufficiently high degree of confidentiality as to amount to a trade secret". Mere confidential information, however, is not protected after termination unless the employee's contract contains an express clause.

The line between what is a trade secret and what constitutes confidential information, however, is not always

clear. A prudent employer will therefore always include an express clause in an employee's contract setting out what information it considers to be confidential and specifically stating that the employee must preserve the confidentiality of that information during employment and after termination.

Garden leave

A particularly effective way of keeping a key employee out of the marketplace for a period of time and diminishing their ability to use customer or confidential information is to place them on "garden leave". This means requiring the employee to spend their notice period at home instead of in the workplace. During any period of garden leave, an employee will continue to be bound by their terms and conditions of employment, including the implied duties of fidelity and confidentiality. They will be prevented, however, from having contact with customers or staff, or having access to confidential information. As time passes, therefore, customer or staff connections, as well as the ability to use confidential information, are weakened.

To have the ability to put an employee on garden leave, there will normally have to be an express garden leave clause in the employee's contract. If such a clause is not in place, an attempt to impose garden leave will be a breach of contract, which will potentially allow the employee to walk free of the notice period and any restrictive covenants. It is recommended, therefore, that such clauses are always included in key employees' contracts of employment.

Team moves

A team move arises when more than one employee leaves their employer to set up in competition or join a competitor. By their nature, team moves have the potential to damage an employer's business or reputation seriously, sometimes beyond repair.

When faced with a team move situation, an employer will need to consider whether members of the team have committed any unlawful acts that could provide the basis for legal action. Express contractual clauses relating to restrictive covenants, confidentiality and garden leave will be of critical importance. Employees may also be in breach of their implied duties of fidelity

or confidentiality. If directors or senior employees are involved, there may also be breaches of fiduciary duties, which are considerably more onerous than an employee's normal implied duties. They include the duties not to make a secret profit, to avoid a position in which personal interests conflict with loyalty to the employer, and to disclose an awareness of threats to the business.

In practice, team moves nearly always involve employees breaching their express or implied terms of employment. In many team move scenarios, however, it will be difficult to prove what financial losses have been caused by the breaches of contract. In recent cases, therefore, employers faced with departing teams have claimed springboard injunctions as an alternative remedy. A springboard injunction prevents an employee from taking advantage of an unfair competitive head start obtained through unlawful activity.

Recent experience

In one of the most recent team move cases (*QBE Management Services (UK) Limited v Dymoke and others*), it was successfully established that three senior employees had solicited each other and various other employees while employed by QBE. They had also solicited broker clients and misappropriated confidential information belonging to QBE for the purposes of their business plan. In these circumstances, it was held that their activities had placed them in a position to launch their rival business far earlier than would have been the case if they had acted lawfully. As a result, a lengthy springboard injunction was granted.

Golden rules

The QBE case is a clear reminder that achieving a team move without committing any breaches of contract will be extremely difficult. Here are some golden rules for employers faced with a team move, which will help expose unlawful activity and potentially mitigate any damage:

- 1) Get legal advice as soon as possible.
- 2) Act quickly. Any delay may be fatal to an injunction application.
- 3) Investigate early. Conduct forensic IT analysis to gain evidence.
- 4) Interview relevant employees once relevant data has been secured (but avoid tipping them off). Communicate with employees separately and write to them reminding them of any restrictive

covenants. Consider incentives to persuade them to stay.

- 5) Avoid knee-jerk reactions when employees resign. Consider the tactical use of garden leave to split the team up and allow you to focus on those you may be able to persuade to stay.
- 6) Beware of aggressive tactics to avoid any arguments that you have breached the implied duty of trust and confidence, which may allow employees to leave and argue that they are no longer bound by contractual covenants.
- 7) If you do manage to "turn" any employees, find out if they have signed a new contract. Consider how to deal with any claim that they are in breach of this contract. ■

Mayer Brown International LLP represented QBE in the case of QBE Management Services (UK) Limited v Dymoke and others

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WWW: the wild, wild web

Following up his ITMA conference appearance, Stephen Truick explains how to sort the good on the web from the bad and the ugly

I remember looking out across the audience of the ITMA Spring Conference and hearing myself say: “I don’t do trade marks and I don’t do copyright.” Not the greatest way to introduce myself to an audience of trade mark and copyright experts, agreed. In my defence, I should point out that I had been asked to address the subject of dealing with online infringements.

So what do I do? I spent 23 years in the Metropolitan Police, the last five of these working at the Police Central e-crime Unit, where I ran the infrastructure abuse team. Since August 2012, I have worked as a consultant at the Medicines and Healthcare Products Regulatory Agency and have established my own business, specialising in targeting

websites that commit criminal offences and having them suspended or removed from the world wide web.

The web has become an integral and indispensable part of our society, economy and everyday lives – and as it grew and developed, gaining a foothold, it did not take long for organised crime groups to exploit its infinite accessibility.

In fact, the very things that we like about the web – the freedom it gives, its seeming lack of rules, its global environment and the degree of anonymity it allows – also mean that it is a perfect location to commit crime. Enter the “bad actors”!

Thanks to them, the web is awash with websites selling counterfeit, fake or even dangerous goods. While there are

rules and safeguards to protect us all, not everyone plays by the rules.

In attempting to counter this, I have developed a skill for scrutinising the web and identifying techniques to remove those websites that are engaged in crime. The goal: to have them subsequently removed from our cyberspace.

To have a viable website, you require just three things. First, a domain name, which points towards the second required part of the system – a hosting platform (basically just a server) – and finally, a means to make money. Normally, the third goal is achieved by the use of a merchant trader account, but some websites can make huge amounts of money simply from selling advertising space.

SEO spells success

To be really successful, however, you need visibility, and this can be generated in many ways. You want your website to be the first one that anyone goes to, either by force of repetition or because you are in the top results that pop up on a search.

To achieve this, bad actors can send spam, place sponsored adverts on search engines to generate results, or try to get their website to the top of the organic search results. This last tactic involves a process called search engine optimisation (SEO). Normally, the higher or earlier that a site is ranked on the search results, and the more frequently a site appears in the search results list, the more visitors it will receive from that search engine's users.

Specialist SEO companies know how search engines work, the specific search terms and keywords people tend towards, and which search engines are preferred by their target audience. Changing the contents and coding of a website can increase its relevance to specific search terms and also remove barriers to the indexing spiders of search engines. Yet another factor can be the introduction of links, including backlinks and inbound-links. Disturbingly, though, this SEO tactic is also used by criminal groups throughout the world.

While email spam appears to be on the decline, mainly due to the heightened levels of protection that end-users now have, the bad actors are now using other methods to get their message across.

With our increasing appetite for social media such as LinkedIn, Facebook and Twitter, many businesses now use these venues to expose their products to potential customers – as do the bad actors. The sheer volume of social media traffic can offer unscrupulous organisations limitless opportunities to commit cybercrime. This can include using tools such as YouTube that allow a different form of internet marketing to affect other social media networks and achieve marketing communication and branding goals.

Why pay to send spam or for sponsored adverts when you can just place a short video or a photo with your website link attached and then promote the video or photo? This method is far cheaper and less likely to provoke law enforcement or brand interest.

Alarmingly, very few websites I look at do not have some form of social media attachment. I recently looked at a YouTube video that was selling counterfeit pharmaceuticals; when viewed, a short video was played that gave an introduction to erectile dysfunction. Interestingly, the accompanying hyperlink would conveniently take you to an associated website. In the space of 10 months this video has been viewed 20,253 times. Not all of these people will have clicked the link to the website, but if even half of these people did, the extremely simple link has provided astounding visibility for very little expense.

Fighting back

What are we able to do to combat this? Let me reassure you that there are parts of the web infrastructure on which we can have an influence. These are the domain name, hosting platform and merchant platform.

The crucial element for me, when attempting to get a website suspended, is to know which button to push to get the desired effect; sometimes this requires only a request to the internet service provider (ISP) to de-host the website. An alternative method of suspending the website is to request that the Registrar (the company that issued the domain name) take back the domain. This is much harder to do, but not impossible. Of course you can go through the WIPO route to get control of the domain, but doing this in an effective way can take time and incur considerable cost. Ultimately, of course, it is possible to liaise with the merchant account providers to remove these bad actors' accounts.

Getting a website de-hosted should get rid of the problem. However, it is very easy for the bad actors to simply

re-host the website on a platform (ISP) that isn't as helpful or friendly in responding to requests to suspend the websites.

Where my specialisation comes into effect is the removal of the bad actors' websites from the web. I accomplish this by completing in-depth research into a site, tailoring solutions to the specific needs and online threats, and working with companies to protect their online presence, reduce revenue loss, and improve brand reputation and online users' trust in the relevant brand.

This examination includes completing a harm matrix to target websites that are actively affecting the brand or company and identifying any criminal or other offences that could result in the website or URL being suspended (false Whois data etc). I'll also look at what links exist to other infringing websites (based on website templates, text, image and HTML search stings) and complete both "open source" and "deep web" searches relating to material found during the examination of the website or URL.

Most of these examinations end with the suspension of any offending websites – through cooperation with registries, registrars and law enforcement agencies – but not all. At the core of my decision-making process is recognising when not to take action, which can save the brand concerned unnecessary expense.

In summary, it is fair to say that there is no magic bullet that fixes every online challenge in one go. Each website is different; some are completely legal and some ripe for suspension.

It's not easy, but this is a battle we can win. We just need to reclaim the web, reassert its positive purposes and refuse to allow the bad actors to prevail. ■

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Stephen was a featured speaker at the 2013 ITMA Spring Conference. He is regarded as an innovator and industry and law enforcement expert in the field of internet infrastructure abuse.

Shop talk

It pays to do your homework when protecting designs on the EU stage, says Richard Dissman

The ongoing legal battle between Apple and Samsung about, among other things, the design of their respective tablet computer products has demonstrated that a legal dispute relating to design law can be truly multi-jurisdictional in nature. This case originated in the US, but spread to courts in Germany, Japan, South Korea, the Netherlands and the UK. With more than 50 proceedings pending and billions of euros in damages claimed between the parties, the legal conflict has been aptly named the “battle of the tablets”.

Because of the high-profile nature of the parties and their products and the inevitable ensuing publicity, the general public has become more aware than ever before that the design of a product is capable of receiving legal protection, and that this protection can be enforced through the courts. The case has also demonstrated that courts in different jurisdictions can apply different approaches to a case and reach different results.

In this article, I will explore the phenomenon of “forum shopping” in the context of design law in Europe, how it can be used effectively and its practical effects.

Interlocking options

First, it is important to remember that there is no single Designs Act that regulates the protection of designs across the European Union (EU). Instead, there are several different overlapping and interlocking legal options for the protection of designs.

The most important right for the protection of designs is probably the Community Design, which is a unitary pan-EU right administered by OHIM and available both as a registered right (the Registered Community Design or “RCD”) and as an unregistered right (the Unregistered Community Design or “UCD”). The legal basis for the Community Design is Council Regulation (EC) No 6/2002. While

the UCD has a period of protection of three years from the date the design was first made available to the public within the Community, the RCD is valid for an initial period of five years from the date of filing of the application and can be renewed for up to four successive periods of five years, giving a total potential period of protection of 25 years. The main advantages of the Community Design are that it is straightforward to obtain, and both the registered and unregistered rights offer protection in every EU Member State and, with that, the possibility to obtain pan-EU injunctive relief.

Member States also have national legislation in force to protect national designs, for example the German Geschmacksmustergesetz (“Design Act”) or the UK’s Registered Design Act 1949. Belgium, the Netherlands and Luxembourg have formed a joint protection system for national designs.

‘The general public has become more aware than ever before that the design of a product is capable of receiving legal protection, which can be enforced through the courts’

For most, but not all, of the national design regimes, policy and procedure are aligned with the EU rules applicable to the Community Design regime.

In addition to the regimes specifically implemented for protection of designs, other national and Community regimes may also be applicable to designs. For instance, in many EU Member States, some designs can be protected by copyright. A product’s design can also, in certain circumstances, be protected under unfair competition or passing-off law in some countries. Counterfeiting or imitation of the design of a product

can be considered a violation of fair trade practices and therefore as an infringement.

Finally, but of increasing importance, designs can also be protected as three-dimensional (3D) trade marks under the national or Community Trade Mark regimes, provided that the form is not dictated by a technical need or by the product itself. However, once these legal requirements are satisfied, applicants for 3D trade marks can often struggle to show that the shape of their product is sufficiently distinctive that it can act as an indication of trade origin, and the competent granting offices tend to be strict in applying these requirements (so as to avoid copyright or design protection through the back door). But, if such obstacles can be overcome, 3D trade mark protection for a product's design is a potentially valuable tool for those with highly distinctive product designs.

This multitude of means for protecting a design opens up a number of legal options for a claimant when looking for a legal venue in which to bring a case. The claimant can, for example, sue a defendant on the basis of a Community Design in one country, on the basis of copyright in a second country, and on the basis of unfair competition law in a third country – all at the same time. Since design law, copyright law and unfair competition law also grant slightly different means and scope of protection, the results of these multiple cases are independent of one another and in practice may very well differ.

In addition to the various legal rights that can be asserted, there are also many types of proceedings available. Each EU Member State has its own procedural system, and the mechanics and timing of these proceedings may differ significantly, even when the same legal right is being considered. In the *Apple v Samsung* cases, for instance, the results of this are evident. In the Netherlands, the Samsung tablet was held not to infringe Apple's RCD in the preliminary proceedings of the first instance court and upon appeal. Therefore, no preliminary injunction (PI) was granted. In Germany, however, Apple successfully obtained a PI with effect throughout the entire EU. This PI was, however, later reduced in scope to Germany only and the legal basis for the injunction was changed from the RCD to German unfair competition law. The UK court then reached the same

conclusion as the Dutch court and ruled that the Samsung tablet did not infringe.

This series of events demonstrates the advantages and risks of forum shopping in the context of design law. While forum shopping is possible between EU Member States (for instance, choosing between the UK and German courts for the most sympathetic forum in which to commence, say, an infringement action), it is also sometimes possible within a given Member State. For instance, in Germany, it would be possible to sue an alleged infringer based on an RCD in

'In the *Apple v Samsung* case, the judgment of the UK High Court that was unfavourable to Apple led to a reversal of previous favourable German decisions'

one court, based on a national design in another court, based on copyright protection in a third court and based on unfair competition in a fourth court. Each of these courts would assess the case before it (while being aware of the other pending cases) and make an independent judgment on it. For the rights owner, this can be a very interesting option, because it only requires one of the four courts to grant an injunction to achieve its commercial goal of stopping the defendant from selling its products.

Of course, there are limitations to such practices. One important limitation is that if there is a main action pending with

respect to an RCD in one Member State, another main action based on an identical national design would no longer be possible. However, unlike in trade mark law, where such situations happen more often, in design law the obstacle of a *lis pendens* in another country is rather rare. A more relevant factual obstacle is that negative decisions in one country may backfire on the rights owner and influence the courts in other jurisdictions, which, until then, had been more inclined to grant protection. In the *Apple v Samsung* case, the judgment of the UK High Court that was unfavourable to Apple led to a reversal of previous favourable German decisions. Thus, a rights owner who wants to leverage the options of pan-European forum shopping must also understand the potential risks involved.

In that context, it is crucial to have an international team of enforcement experts who are familiar with cross-border litigation strategies and who can advise on the opportunities and pitfalls of an international enforcement strategy. If such strategies are implemented properly, they can offer a substantial advantage to the rights owner. Defendants may also benefit from adding forum shopping to their defence strategy. ■



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The design dossier

ITMA authors reveal the latest EU decisions that touch upon the subject of designs



Austria

Colour and material as distinguishing features

The Austrian Supreme Court rarely takes on design cases, but in a case (17 Ob 4/10b, 31 August 2010) concerning a dispute between producers of double-walled glasses it confirmed that the Claimant's Community designs were novel and had individual character. With respect to individual character, it held that a Community design has individual character if one of its distinguishing features is not included in any of the pre-existing designs.

The Court went on to say that the same standard applies to the infringement of a Community design. If a distinguishing feature of the conflicting design is not included in the Community design, the conflicting design does not infringe the Community design.

According to the Supreme Court, the colour of the Community design can be a distinguishing feature. If the representation of the Community design is in a certain colour, designs in a different colour that are otherwise identical may not infringe the Community design. However, in the case before the Supreme Court, the representations of the Claimant's Community designs were in black and white. Therefore, the Supreme Court concluded that the colour was not a distinguishing feature.

Similarly, the use of a certain material can be a distinguishing feature. The Supreme Court considered that the representations of some of the Claimant's Community designs showed that the material was "shine-through", whereas the Defendant's glasses were made of clear

and transparent material. The Supreme Court held that the use of clear and transparent material on the one hand and of shine-through material on the other were distinguishing features. It concluded that the Defendant's clear and transparent glasses did not infringe the Claimant's Community designs for double-walled glasses made of shine-through material.

This decision underlines that it is up to the applicant to decide the scope of protection of a Community design. If the representation of the Community design is in colour or shows that the object is made of a certain material, designs in a different colour or material that are otherwise identical may not infringe the Community design. On the other hand, if the representation of the Community design is in black and white or does not show the material, colour and material are not distinguishing features and the scope of the Community design is much wider.

Gabriela Staber, CMS Reich-Rohrwig Hainz



Belgium

Shedding new light on design issues

Friesland v Incopack, President of the Commercial Court of Brussels, 17 November 2010

Dutch company Friesland is a producer of dairy products, including whipped cream sold in spray bottles/aerosol cans. Friesland was, *inter alia*, the holder of European patent EP 1916931 for an aerosol can with a nozzle with several technical features.

Friesland filed the design of its nozzle as Community design number 595947-0001.

The design of the whole aerosol can was filed as Community design number 595947-0002. The two Friesland designs are as follows:



Incopack is also a producer of whipped cream sold in aerosol cans and used a design for its aerosol can that allegedly infringed Friesland's design rights.

Friesland brought injunctive relief proceedings against Incopack before the President of the Commercial Court of Brussels.

The President of the Court decided that essential features of appearance, even if they are new and have individual character, cannot be protected by a Community design if they are dictated solely by their technical function. The President of the Court made a comparison with trade mark law and referred to the CJEU case of Philips v Remington, in which trade mark protection for the shape of a razor was considered.

The President of the Court went on to state that it was irrelevant that other shapes may exist that would achieve the same technical result. The features of appearance of a product will be deemed to be dictated solely by their technical function if these features of appearance of the shape have been patented. The features of appearance will not be deemed to be dictated solely by their technical function if the design extends beyond the purely technical aspect, but this was not the case here.

The President of the Court also decided that the question of whether the features of

appearance of the aerosol can with a nozzle had acquired distinctive character was irrelevant in assessing the validity of the Community design. The President referred here to the CJEU Lego case (C-48/09P, 14 September 2010).

Second, the President of the Court ruled that Friesland's Community designs lacked novelty and individual character. Incopack demonstrated that several competitors in Germany and Austria have marketed aerosol cans and nozzles that created the same overall impression with informed users.

Finally, the President of the Court considered whether technical and functional elements of a design can be protected by copyright law. He decided that they can in theory but, in this case, the designs of the aerosol can and nozzle were dictated merely by their technical function and therefore lacked originality. As a result, copyright protection was refused.

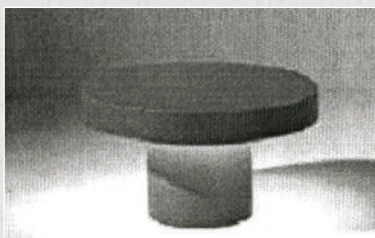
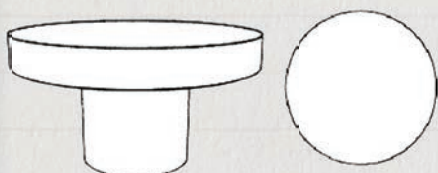
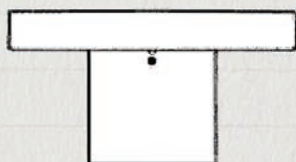
The President granted the counterclaim that was initiated by Incopack and ordered the cancellation of Friesland's Community design registrations. Friesland has appealed this decision, however, and the appeal will be heard by the Brussels Court of Appeal.

Pits v Modular Lighting Instruments, Court of Appeal of Brussels, 26 June 2012

In this case, the Court of Appeal confirmed the validity of the Claimant's registered Community design and the Court found the Defendant to have infringed the Claimant's rights.

The design holder, Pits, had registered Community designs 602487-0001 and 0002 (shown below).

Pits noticed that Belgian public broadcaster VRT used lamps in a popular



television show that were copies of its registered design. Because the broadcaster did not want to replace the lamps, Pits sued both the broadcaster and its supplier, Modular Lighting Instruments. The Court of Appeal had to decide whether the lamps used in the television show constituted an infringement of the Community Design rights and the copyrights of Pits.

The Court ruled that, even if the freedom of the designer is limited by functional requirements, a design can have individual character through differences with earlier designs. Several small differences between lamps can lead to an overall impression that gives a lamp individual character. In that case, the overall impression on the informed user by earlier designs will be different.

The Court of Appeal confirmed the validity of the registered Community designs and examined whether the lamps used by the broadcaster infringed the design rights. The Court found that the lamps used in the television show differed only slightly from the protected design; they were smaller, but this did not create a different overall impression. The Court therefore found the lamps' design to be an infringement of Pits' rights.

'The Court ruled that, even if the freedom of the designer is limited by functional requirements, a design can have individual character through differences with earlier designs'

Because the lamps had been used in a public broadcast, the designer also claimed copyright protection and alleged that there had been a communication to the public of his copyright-protected work without consent.

The Court of Appeal agreed, ruling that the design of the lamps was the personal and original creation of the author. The author had made free creative choices that gave his work the personal touch that is required for an original work

of authorship to be protected by copyright law.

The Court of Appeal ordered the Defendants to discontinue sales of the infringing lamps and ordered them to publish part of the Court decision on their websites to inform the public about the infringement. The Court ordered the broadcaster to stop using the infringing lamps in its television show.

Pommier Furgocar v Boyriven, Commercial Court of Mons, 29 March 2013

In this case, the Plaintiff, Pommier Furgocar, was the owner of registered international design number 061766 for locks that are used to restrict access to trucks. When the Plaintiff noticed that a competitor was offering similar locks for sale, it filed an *ex parte* request with the President of the Commercial Court and applied for a "descriptive seizure". The Plaintiff asked the President to block all allegedly counterfeiting products and to designate an expert to describe the alleged counterfeit products and report on the quantities sold. The President granted the request and the Plaintiff blocked the stock of more than 500 locks. It subsequently brought the case on the merits before the Commercial Court.

The Court examined the different locks that were found during the descriptive seizure. One was found to be a prototype that was never commercialised. It had been published on a website for more than a year before the case was initiated and the statute of limitations barred the claim in relation to this prototype. The Court found

that several other types of locks did infringe the design rights of Pommier Furgocar.

The Court rejected the claims of Pommier Furgocar that were based on copyright law. The locks were not found to have been original works of authorship for which copyright protection could be claimed.

Online option: In September 2012, the Benelux Office opened its database for free online searches at BOIP.int, which allows online searches for data and images of registered Benelux designs. The database

includes all designs that were valid on 1 January 2012 or that were subsequently registered.

Tom Heremans and Lisbeth Depypere, CMS DeBacker, Brussels



Finland

Scope of protection expanding

Traditionally, Finnish court practice was to grant quite a narrow scope of protection to Finnish designs. Compared to Finnish case law established prior to the implementation of the EC Directive on Designs (98/71/EC), more recent case law and a precedent of the Supreme Court in particular have broadened the scope of the protection of registered designs in Finland.

By issuing the said judgment, the Finnish Supreme Court has established a judicial precedent regarding the basis used when assessing whether the overall impression produced by the product is different from the overall impression produced by the registered design (KKO 2007:103, Finnish Supreme Court, 31 December 2007).

The national Copyright Council (which issues non-binding opinions on the application of the Copyright Act in Finland) has also issued several written opinions on copyright protection of three-dimensional objects.

More recently, the Helsinki Appeal Court has issued judgments on design rights, for instance in a case concerning designs relating to waste containers (nr 10, S 10/207, Helsinki Appeal Court,

5 January 2011). In this case the designs were protected but no infringement was found since the actual products were different from the protected designs. The Court held that the overall impression produced by the product was different from the overall impression produced by the registered design.

Ella Mikkola, Bird & Bird LLP, Helsinki



France

Couture clash

Christian Dior Couture/ Ash Distribution (No 11/02407), Paris Court of Appeal, 8 February 2013

Christian Dior Couture claimed to have created, in the autumn of 2006, a model of shoes named “Extrême Dior”, which it marketed and offered for sale in 2007. Dior discovered that Ash Distribution was selling a “knock-off” of this model and filed an action before the Paris Court against the latter for infringement of both its copyright and its unregistered Community design (UCD) right in this design.

The Paris Court of Appeal granted Dior’s claims in respect of both the copyright and the UCD-based actions. The judgment provides a good picture of French case law with regard to the respective criteria for protection by copyright and UCD, as well as the rules for presuming ownership in copyright and UCD rights.

The ruling is particularly clear with regard to the ownership of both rights claimed by Dior. With regard to copyright, the Court ruled, in accordance with settled case law, that in the absence of any claim of ownership in the design in question by its author, a corporate entity

that markets a work under its own name (here, Dior) is presumed to be the owner of the copyright of such work.

The Court also found that Dior should be considered the owner of the claimed UCD right through the application of Articles 14 (particularly paragraph 3) and 15 (particularly paragraph 1) of the European Community Design Regulation 6/2002, and through the absence of any claim made by an employee of Dior or other person claiming ownership of the design in question.

The ruling also offers a good opportunity to compare the standards for protection through copyright (under French law) and UCD (under the European Community Design Regulation), respectively. As regards copyright, the Court found that the design in question met the “originality” requirement set forth under French law. It held that the design was the result of a creative effort by its author, mainly through a unique combination of elements commonly known by the public, despite the fact that the said elements may lack any such originality in themselves. With regard to UCD, the Court stated that the only applicable criteria were those set out under Articles 5 and 6 of the European Community Design Regulation: novelty and individual character. More

‘The judgment in the Dior case provides a good picture of French case law with regard to the respective criteria for protection by copyright and its UCD’

specifically, the Court emphasised that contrary to what was claimed by Ash, the novelty requirement did not imply the need to show any “creative effort” and therefore was not equal to originality. As Ash did not bring any evidence of a prior disclosure in the Community of a design that was likely to destroy the novelty or individual character of the UCD claimed by Dior, the Court found that the UCD should be held valid.

This judgment serves as a helpful reminder that copyright and UCD regimes should not be confused when filing infringement actions before the French

Courts. Accordingly, each action should be considered separately and filed only if the applicable requirements are met.

**Axel Munier and Nathalie Ruffin,
Bird & Bird LLP, Paris**



Germany

Questions could affect
many Member States

In connection with its decision on *Gartenpavillon* (Garden Pavilion, I-ZR 74/10, 16 August 2012), the German Federal Court of Justice (BGH) submitted six questions concerning the interpretation of the Community Design Regulation (CDR) to the Court of Justice of the European Union (CJEU). The CJEU response is likely to affect the application of substantive law in numerous Member States.

The Claimant held the Defendant liable for infringement of an unregistered Community design that refers to the outer appearance of a garden pavilion.

As set forth in Article 11 of the CDR, an unregistered Community design comes into being once it has been made available to the public within the Community. Such disclosure has to be effected in such a way that the design could reasonably have become known in the normal course of business to the relevant individuals who specialise in the sector concerned operating within the Community. According to the Claimant, the unregistered Community design came into being by way of the first distribution of illustrations to wholesalers. The question of whether the distribution of illustrations to wholesalers suffices so that the design in question could reasonably have become known in the normal course of business to the specialised circles operating within the Community was

answered inconsistently in Germany. For example, according to an opinion widely held in Germany, simple dealers belong to specialised circles in terms of Article 11(2) of the CDR only in exceptional cases because they are usually involved neither in the creation of the design nor in the development or manufacture of products in accordance with the design. The BGH, however, tends to hold the view that the normal course of business of the specialised circles also includes monitoring the market to take the competitive situation and new trends into account when developing products. It thus asked the CJEU whether, under Article 11(2) of the CDR, a distribution of the design to dealers suffices for the assumption that the design could reasonably have become known

'An unregistered Community design comes into being once it is available to the public within the Community'

in the normal course of business to the individuals specialising in the sector concerned operating within the Community.

The Defendant argues that the Claimant's design lacks novelty due to prior publication with reference to: (i) a presentation of the contested, largely identical pavilion in the showrooms of its manufacturer in China, and (ii) the sending of an offer to a Belgian company.

According to the BGH, a presentation in a showroom of the manufacturer is outside the scope of usual market monitoring and can thus reasonably not have become known to the specialised circles operating in the Community. Nor could the occasional disclosure to a Belgian company reasonably have become known in the normal course of business to the specialised circles in the Community. According to the Court, disclosure to a broader circle is usually required in order for specialised circles to obtain knowledge. For final clarification in this regard, however, the BGH submitted to the CJEU the question of whether Article 7(1), sentence 1, of the CDR was to be interpreted to such effect that although a design had been made available to a third party without explicit or implicit conditions of

confidentiality, it could reasonably not have become known in the normal course of business to the circles specialising in the sector concerned operating within the Community if: (i) it was made available to only one company of the specialised circles, or (ii) it was displayed in a showroom of a company in China that was located outside the usual market monitoring.

Subsequently, the BGH turned to the question of property right infringement and ascertained that it was required pursuant to Article 19(2) of the CDR that the contested use resulted from copying. According to the BGH, it is the Claimant that bears the burden of proof under general civil procedure principles that the contested use is to be considered copying. The burden of proof could be reversed, however, if the designs matched in material aspects. *Prima facie* evidence suggested in such cases that the designer had been familiar with the contested design during creation. The BGH also asked the CJEU whether Article 19(2) of the CDR was to be interpreted to such effect that the holder of an unregistered Community design bore the burden of proof that the contested use results from copying the protected design and - if this question were answered in the affirmative - whether the burden of proof was reversed or the holder of an unregistered Community design could benefit from an easing of the burden of proof if the design and the contested use matched in material aspects.

Further aspects critical for deciding the case were whether the Claimant's cause of actions were time-barred or forfeited. While national law in Germany does provide for statutes in this regard, the CDR does not regulate the issue of

'It is the Claimant that bears the burden of proof under general civil procedure'

the requirements for the cease and desist entitlement pursuant to Article 19(2), Article 89(1)(a) of the CDR concerning an unregistered Community design becoming time-barred or forfeited. According to the BGH, this question should be answered consistently within the Community and not be subject to national law. That is why it submitted

these questions to the CJEU for response as well.

Finally, the BGH submitted another question – extremely relevant to practice – to the CJEU for response. The CJEU response to this will affect not only the interpretation of the CDR, but also that of the Community Trademark Regulation. The question arose of whether a court competent as a Community design court with Community-wide power to ascertain and rule on actual facts (*Kognitionsbefugnis*) had to apply its respective *lex fori* or the law of all Member States with regard to asserted annex claims that were not explicitly regulated in the CDR (information, compensation, destruction, etc). The BGH tends to share the latter view.

The CJEU decision on these questions will be awaited with great interest.

**Dr Carsten Menebröcker, LL.M (NYU),
CMS Hasche Sigle, Cologne**

current efforts of Greek courts to be less lenient toward postponement and more understanding towards providing fast relief (by all legal means available, including temporary restraining orders and various injunctions) mean there is a more favourable picture emerging in the Greek jurisdiction when it comes to the protection of design rights (in sync with the efforts affecting the protection of the entire spectrum of IP Rights in Greece – reforms that have been a welcome by-product of the economic turmoil in Greece over recent years).

In relation to case law, a recent highlight on the aspect of protection of designs is a decision (case 7233/2011, Multi-Member Court of First Instance, Thessaloniki, 21 March 2011) related to a famous design of a white salty cheese sold in Greece that was copied by a competitor. The competitor was found to be infringing and was ordered to cease the particular use of its similar design, notwithstanding the various alleged side-differences between the two designs.

All in all, developments in Greece based on the recently amended legislation and case law point towards a positive handling of matters for IP rights-holders, including those holding design rights.

Eleni Lappa, IPWORK.GR, Athens

application to registration, and proved such lack of novelty with internal documents and information sheets and an article published externally.

As the design was registered with a priority date of 3 September 1998, the Hungarian Intellectual Property Office (HIPO) had to decide the case pursuant to the Law-Decree 28 of 1978 (“Law-Decree” had been adopted by the Presidential Committee of Hungary with the force of acts adopted by the Parliament, prior to 1989). This provided that a design had to be deemed new in cases in which it has not been made available to the extent it could be produced by anyone (section 1, paragraph 2 thereof). The new Designs Act – Act 48 of 2001 – expands the requirement by stating that the designs shall be deemed to have been made available to the public when they are made accessible through publication, other communication, exhibition, commercial distribution or otherwise, unless such activities, within the normal course of business, could not reasonably result in disclosure to professionals operating in the European Community.

HIPO refused the application and found that even though the designs were identical, MÁV had not proven that the design had been installed on public trains. HIPO further concluded that closed distribution channels and production-on-order may have restricted access to the given design, and dismissed the claims that the design served merely functionality.

The court of review, the Capital Court, substantially disagreed with HIPO and stated that if anyone within a business activity had the right and capacity to produce the design the novelty requirement cannot be established. The Capital Court found that MÁV had not established confidentiality when it first produced the security locks, and as such, the design had to be considered to be publicly available during the course of the business of MÁV – resulting in the lack of novelty and ineligibility for initial registration. The Capital Court also concluded that all parts of the design served some technical function, and it had not been a result of designer activity.

The case was finally decided by the Capital Court of Appeal, which adopted the original reasoning of HIPO. First, the Capital Court of Appeal stated that the existence of designer activity in relation



Greece

**Reform rejuvenates
design legislation**

Greek legislation on designs has recently changed as per the relevant provisions of Law No 3966/2011 (Article 53) and the main provisions of the new Trademark Act No 4072/2012 put in force in October 2012.

These amendments have been welcomed by both those in industry and legal practitioners as being positive towards right holders and stricter on infringers by introducing faster recourse and harsher penalties than those previously available. These stricter penalties, coupled with the



Hungary

**Novelty and functionality:
a case study**

The content and meaning of “novelty” and “functionality” was decided in the case initiated by the Hungarian Railway Company (MÁV) and presented to the Capital Court of Appeal (Fővárosi Ítéltábla) in 2012 (case 8.Pkf.25.381/2012/5).

MÁV applied for the deletion of a design registered to the Proprietor under the name “Security lock”, on the basis of lack of novelty, further claiming the design was a mere consequence of the product’s technical purposes. MÁV claimed that the design had been made available prior to

to designs that are already known to the public had to be considered to decide whether the design is novel. Such a determination shall be made in the light of the public's overall impression of the exterior of the design. The Court concluded that as the challenged design and MÁV's design were essentially the same, the exact time of public availability had to be established. The Capital Court of Appeal subsequently concluded that MÁV could not prove the date the security locks had actually been installed, which was to the benefit of the Proprietor of the challenged design. The Court further found that the mere fact that a design serves functionality cannot automatically result in ineligibility for protection, as many different designs may serve the same function while preserving originality and individuality. According to the Capital Court of Appeal, MÁV failed to successfully prove that the design had been created solely to fulfil technical purposes.

As a result of the three-tier interpretation, the challenged "security lock" design remained effectively registered.

**Dóra Petrányi and András Losonci,
CMS Cameron McKenna LLP, Budapest**



Italy
IKEA features
in key cases

Angelika Morlein v IKEA ITALIA Retail SRL, Design Authority (Design Self-Regulation Code), 9 October 2012

This case deals with the alleged infringement of articles 4 and 5 of the Design Self-Regulation Code, relating to

unfair competition and the unauthorised exploitation of third parties' industrial design works.

In this particular case, the designer, Angelika Morlein, alleged that IKEA infringed her collection of reading lamps named "Post scriptum" (characterised by particular lampshades representing female dresses), and applied to the Design Authority to prevent IKEA from further distributing the allegedly infringing products and effect their withdrawal from the market.

On 9 October 2012, the Design Authority held that IKEA was not liable for unfair competition, since its disputed products were a reproduction of an older collection by IKEA that was commercialised a few years prior to the Claimant's designs. Furthermore, as a matter of fact, the Authority agreed that lamps shaped like a human body had been available on the Italian and international markets for many years. Thus, Morlein's creations could not be considered as having the necessary requirements of creative character and artistic value expressly provided by Article 2.10 of the Italian Copyright Law.

Titi Fabiani and IFT company v IKEA ITALIA Retail SRL, Specialised Section in Intellectual Property Matters at the Court of Venice, 25 May 2012

The Claimants, who manufacture and distribute bookshelves named "BOOK", applied for a preliminary injunction against IKEA, alleging that the latter's "Billy" bookcase infringed the Claimants' copyright under Article 2.10 of the Italian Copyright Law. The Claimants also claimed unfair competition for slavish imitation.

At first instance, the Court held that even if the "BOOK" bookshelf possessed a "personal author elaboration" that expressed a certain level of originality as required by the law, the Claimants' claim for copyright infringement would have been rejected since the enforced creation lacked the necessary "artistic value". However, the Judge considered that IKEA was liable for unfair competition under Article 2958.1 of the Italian Civil Code and held that the products were confusingly similar.

On appeal, the Appeal Section of the same Court reversed the previous order (decision dated 8 August 2012), affirming that: "In order to depict unfair competition for slavish imitation it is mandatory that the

imitation/repetition concerns exactly the features of the product that have distinctive and personal character, which therefore distinguish the enforced item from similar products, identifying it as originating from a certain manufacturer, in light of both the evaluations of the consumer and through a global appraisal." The Appeal Section also specified that "the so-called 'functional shape', as well as the shape that is necessary for the nature of the product because of its technical or aesthetic profile and those that are standard, cannot be considered as provided with the necessary distinctive character".

The proceedings on the merits are currently pending.

Licia Garotti, Bird & Bird LLP, Milan



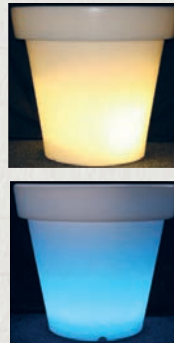
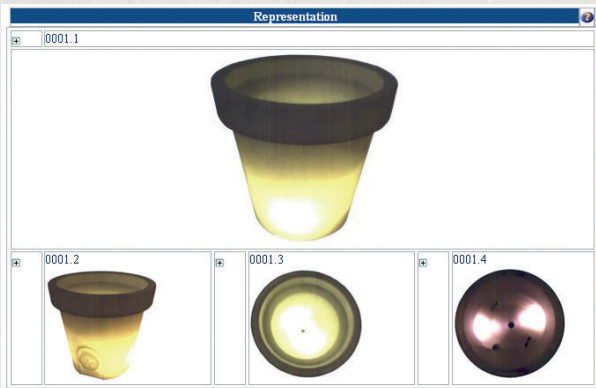
The Netherlands

Reminder of the importance
of a good design registration

In a case that emphasises the importance of filing strategy in relation to design rights, on 13 December 2011 the Court of Appeal in The Hague rendered a judgment in a design infringement case between Slewe and the Groove Garden with respect to flowerpots such as those depicted on page 28.

Slewe was the holder of a registered Community design (RCD) on the BLOOM flower pot, which is both an oversized flowerpot and a lamp.

The Groove Garden marketed the GG-Pot and Slewe lodged infringement proceedings against it. The District Court dismissed the claims of Slewe at first instance and considered that the GG-Pot did not infringe the RCD



Poland
Industrial use
proves problematic

A dispute before the Polish Patent Office between Bakoma Sp zoo (“Bakoma”) from Warsaw and Compagnie Gervais Danone (“Danone”) brings to the fore the fact that three-dimensional (3D) trade marks used to achieve a particular technical result, utility function, or intended to be used as an industrial design, can be invalidated.

In the dispute (case no 513/08, Polish Patent Office), Bakoma requested the Polish Patent Office to invalidate, in part, the rights of protection for the 3D trade mark owned by Danone (IR-700040), used as two parts of a yoghurt container. Bakoma’s application for invalidation was filed in relation to court proceedings between Bakoma and Danone that were initiated by Danone. In its application, Bakoma claimed that the mark in question has been registered by Danone in bad faith to bypass the law. Bakoma argued that the 3D sign lacked distinctiveness and was not intended to be used in the form applied for. It is significant that Danone owns a registered industrial design for similar packaging, which means that the registration of the 3D trade mark was intended only to extend the protection provided for the design.



DANONE

Above: This image was considered in the Court of Appeal.
Top right: BLOOM (Slewe). Bottom right: GG-Pot (Groove Garden)

in the BLOOM flowerpot. Slewe appealed. When comparing the BLOOM RCD with the GG-Pot the Court of Appeal took into account images such as those disclosed in the RCD application (above right).

Referring to CJEU judgment C-281/10P Grupo Promer Mon Graphic/BHIM-PepsiCo (20 October 2011), Slewe argued that in the assessment of the scope of protection of the design the Court of Appeal should also take into account the flower pot as *actually marketed* (cf. article 36 paragraph 6 EU Design Regulation).

Despite Slewe’s arguments, the Court of Appeal considered that the comparison of the actual goods was used only for illustrative purposes to confirm the conclusions already drawn from the RCD.

Consequently, the Court of Appeal confirmed the findings of the District Court and considered that the RCD did not disclose anything more than a pot made of transparent material including one or two light sources,

‘The Court of Appeal concluded that the differences in the designs at issue were sufficient for a finding that they produced a different overall impression on the informed user’

since it was not clear from the application that there was integrated lighting closed off by a double bottom. In addition, because the description explaining the representation of the RCD did not contain the fact that the design concerned a flower pot that could also be used as a lamp, the Court did not take this into consideration. As a result, the Court of Appeal concluded that the differences in the designs at issue were sufficient for a finding that they produced a different overall impression on the informed user. Consequently, the Court of Appeal dismissed the design infringement claim.

Although one can question whether this judgment is fully in line with the CJEU judgment referred to above, this decision illustrates the importance for design right holders to file their designs properly. Luckily for the Claimant, the threshold for copyright protection is relatively low in the Netherlands so Slewe could, in any event, rely on its copyright in the BLOOM flower pot. However, the addition of a clear description and the use of drawings instead of (overexposed) photos in the RCD application would have been a better strategy and might have led to a different outcome in the design infringement claim.

**Manon Rieger-Jansen and
Linda Brouwer, Bird & Bird LLP,
The Hague**

Danone argued that only forms based solely on achieving a particular technical result are unregistrable. Danone argued that the 3D trade mark in question was not based solely on achieving a particular technical result, had acquired a secondary meaning and was genuinely used, and that the design was new at the time of registration.

Bakoma argued that the 3D trade mark in question, when used for containers, had functional and technical features because it solved the problem of mixing two separate yoghurt components together. Bakoma argued that the utility functions of this trade mark demonstrated that Danone did not intend to use the mark in the form applied for, but as a design, and that Danone wanted to obtain a monopoly over this technology by registering the trade mark. Bakoma suggested that this demonstrated that Danone had acted in bad faith.

The Polish Patent Office agreed with Bakoma and invalidated the 3D trade mark in question used for yoghurt containers. The related court proceedings between Bakoma and Danone are ongoing.

Katarzyna Kloc, CMS Cameron McKenna, Warsaw



Portugal Copyright and industrial property

A recent decision from the Guimarães Court of Appeal (Guimarães Court of Appeal, 27 February 2012, No 1607/10.3TBBRG.G1) has touched on

a controversial topic regarding the interrelation of industrial property protection of designs and the protection that designs benefit from copyright law.

According to Article 200 of the Portuguese Industrial Property Code, “any registered design [ie a design protected by an industrial property design registration]

‘The Court decision is consistent with the doctrine through which industrial designs are protected’

benefits from protection under the laws of copyright as from the date on which the design was created or fixed in any form”. This rule, which was an almost literal transposition of Article 17 of Directive 98/71/EC of the European Parliament and of the Council on the legal protection of designs, has led to different interpretations by doctrine on what should be considered as the extent of the protection conferred to designs, and what is the material liaison between copyright and industrial property rights protection regarding designs.

The three legal protection systems that are usually defended are the following:

- a cumulative protection system *per se*, where designs benefit simultaneously from the protection of copyright and industrial property rights;
- a system that prohibits combining the protection of copyright and industrial property rights for designs; and
- a system in which designs can benefit from cumulative protection as long as they meet the requirements provided for in copyright law (Portuguese Author’s Rights and Related Rights Code, Decree-Law No 63/85, of 14 March 1985) and industrial property law (Industrial Property Code, Decree-Law 36/2003, of 5 March 2003).

The majority of the doctrine has opted for the latter, ie the interpretation that an industrial design that cannot be perceived as an artistic creation – according to the Portuguese Author’s Rights and Related Rights Code – should not benefit from copyright protection, even if it is registered as an industrial design and fulfils the requirements of novelty and individual character.

The decision of the Guimarães Court of Appeal of 27 February 2012 relates to a conflict between copyright and posterior applications and registrations of Portuguese and Community designs representing similar wash-basin taps.

The Court of Appeal decision explicitly stipulated that copyright protection for either industrial design entails the following requirements:

- a) an industrial property design registration must exist; and
- b) the industrial design must consist of an artistic creation.

For the Court, an artistic creation is what arises from art, a work activity related to an aesthetic and spiritual manifestation and likely to generate emotions or feelings in people. A line of wash-basin taps does not represent, in principle, an artistic creation. Copyright protection was therefore refused in these proceedings.

The Court decision is consistent with the aforesaid doctrine, through which industrial designs are not deprived of protection by means of copyright. Notwithstanding this, they must meet the requirements of the Author’s Rights and Related Rights Code to be perceived and protected as artworks.

**Hugo Monteiro de Queirós,
CMS Rui Pena & Arnaut, Lisbon**



Romania Milestone decisions

Somet SA v the Romanian State Office for Inventions and Trademarks, Case 5979/3/2012, High Court of Bucharest

On 18 March 2010, Somet SA filed for the application of a design in the shape of a rail track under No f 2010 0082. The Design Examination Commission of the Romanian State Office for Inventions and Trademarks

found that the design was not new and lacked individual character, as an identical design was part of a prior invention filed and registered by another Romanian company – it noted that two pictures of the earlier invention were published in Official Bulletin 5/2007, before Somet SA filed for its own design.

In fact, the invention to which the Design Examination Commission pointed when rejecting design No f 2010 0082 had only been partially accepted to registration. Moreover, the images showing the design said to be identical with the “rail-track” design No f 2010 0082 were excluded from being part of the invention and, therefore, were not published. In such circumstances the pictures containing the relevant images were not in fact made public prior to the filing by Somet SA of its design.

‘The Somet SA case is a milestone since it should clarify the notion of a design made public’

In an appeal to the decision of the Design Examination Commission, Somet SA did not base its arguments on the fact that the pictures were not part of the earlier invention and not published. Its only arguments related to minor differences between the images in the pictures and the design *per se*.

The appeal was rejected.

Somet SA then changed its legal strategy and filed an appeal with the High Court of Bucharest and against the decision of the Appeal Commission. The new appeal was based on two main arguments: first, the fact that the pictures containing the images identical with the design in the shape of a rail track – No f 2010 0082 – were not part of the invention and not published prior to the filing of the design; and second that there are major differences between the images in the pictures and the design *per se*.

This case is a milestone since it should clarify the notion of a design made public.

Sertic Vanja v SC Look Media Advertising SRL and Ambient Media World Wide Ltd (formerly Look Media Advertising Ltd),

Case 23041/3/2009, Court of Appeal of Bucharest

On 23 June 2009, Sertic Vanja filed two court actions against SC Look Media Advertising SRL (“Look Media”), as follows: i) on the merits to permanently stop Look Media from using a shape of an advertising product allegedly identical with one of Sertic Vanja’s RCDs; and (ii) an injunction to temporarily stop Look Media using a shape of an advertising product allegedly identical with one of Sertic Vanja’s RCDs, up to the moment when a final decision is reached on the merits.

The temporary injunction was fought only between Sertic Vanja and Look Media and was won by Sertic Vanja. The High Court of Bucharest decided that the shape of the advertising product was identical with one of Sertic Vanja’s RCDs, and therefore concluded that Look Media should stop selling such products on the Romanian market. No appeal against the decision was filed by Look Media.

On the merits of the case, Look Media decided to file a request for the court to include Ambient Media World Wide Ltd (“Ambient Media”) in the court procedure, a request based on a contract in place between the two entities. Such contract provided a warranty to Look Media that the advertising products were genuine and did not infringe the IP of any third party.

Ambient Media then registered an RCD for the design of the advertising product that Look Media was selling on the Romanian market and which was the object of the case. An application was subsequently made to OHIM and Ambient Media’s design was registered. This registration was presented in court, together with other prior rights of third parties, to emphasise the fact that none of Sertic Vanja’s RCDs were identical with the design of the advertising product Look Media was selling on the Romanian market.

The High Court of Bucharest decided in favour of Ambient Media and Look Media. Sertic Vanja filed an appeal against the decision, which was rejected by the Court of Appeal of Bucharest on 12 February 2013. This case is very important as a precedent with respect to acquired rights after filing of the court action.

Dr Andra Musatescu, Andra Musatescu Law & Industrial Property Offices, Bucharest

Andra Musatescu Law & Industrial Property Offices acted for Somet SA in front of the High Court of Bucharest and for Ambient Media World Wide Ltd in all legal procedures



Spain

Complex case favours car-maker

Ruling 303/2012 of the Court of Appeal of Alicante (Board 8), 28 June 2012 (id Cendoj 03014370082012100461)

The Spanish CTM Court has ruled in favour of BAYERISCHE MOTOREN WERKE AG (BMW) in a case of Community design infringement relating to the online sale of wheel trims.

The allegation of infringement was part of a claim in which BMW also alleged Community, international trade mark and international design infringement. The Defendant was the owner of a website that facilitated the sale of car wheel trims very similar to several Community designs registered by BMW.

The Court of First Instance ruled in favour of BMW and ordered the Defendant, *inter alia*, to stop selling the infringing trims, to destroy any remaining stock and to pay compensation for damages suffered by BMW.

The Defendant filed an appeal at the Court of Appeal in Alicante based on several grounds. Among them, the Defendant argued that the judgment violated the Third Transitional Provision of the Spanish Act 20/2003 on Designs (known as the “repair clause”) and its connection with Article 14 of the Directive 98/71/EC of 13 October 1998 on the Legal Protection of Designs.

The Court of Appeal referred to previous judgments relating to the distinction between spare parts and accessories and its application to wheel trims, where Article 110 of the Regulation on Community designs had been interpreted and it had been concluded that the exception provided by the repair clause did not apply to car wheel trims.

Article 110.1 of the Regulation on Community designs provides that: "Until such time as amendments to this Regulation enter into force on a proposal from the Commission on this subject, protection as a Community design shall not exist for a design which constitutes a component part of a complex product used within the meaning of Article 19(1) for the purpose of the repair of that complex product so as to restore its original appearance."

In the previous cases referred to by the Court of Appeal, the Defendants had argued that the trims were components of complex products (the car), so it was necessary to apply the legal exception to the registered design, whereby the sale of trims to replace pieces of the complex products was completely lawful and did not infringe any third-party rights.

The Court stated that the activities of the Defendant could not be considered as intended to allow the reparation of a complex product (the car) to restore its original appearance for several reasons: (1) the trims were exchangeable elements in cars, so it was not feasible to consider that their sale was intended to allow the reparation of the car to restore its original appearance; (2) it had been proved that the Defendant offered a range of trims that could be fitted in any model of car, so it was not possible for the Defendant to argue that the offer and eventual sale of the trims was intended to restore the car's original appearance, since that was unknown to the buyer; and (3) the reason for replacing the trims may not be a repair but merely aesthetic.

As a result of the above, the Court dismissed the appeal filed by the Defendant and confirmed the judgment issued at first instance.

José Ángel García-Zapata and Fidel Porcuna, Bird & Bird LLP, Madrid



Sweden

Hopes for court clarification

In a case concerning a claim for the cancellation of a chimney cap design, a Swedish Court of Appeal found no reason to grant leave to appeal. However, with the decision then overruled by the Supreme Court there are hopes that there will soon be some clarification on how Swedish courts should assess technical functions of designs and the overall impression on the "informed user".

The owner of the disputed design approached JLM, a company that manufactures and sells chimney caps, claiming that JLM infringed his design right. JLM brought an action for cancellation of the right holder's design registration. The District Court ruled in favour of JLM, stating that the right holder's design was substantially limited by its technical function and lacked novelty and individual character.

The right holder appealed this judgment on a number of grounds. First, it disputed the District Court's conclusion that the design lacked novelty and individual character. At first instance, in support of its claim that the design lacked novelty and individual character, JLM asserted prior designs of chimney caps, which the District Court had found to be similar to the design now in question. The District Court had held that the informed user's (defined as a person who intends to buy or recently has bought a chimney cap and who has knowledge of

the range of chimney caps and different models on the market) overall impression of the prior designs asserted by JLM did not differ from the overall impression created by the right holder's registered chimney cap design. This conclusion was, *inter alia*, based on the fact that the informed

'There are hopes that there will soon be some clarification on how Swedish courts should assess technical functions of designs'

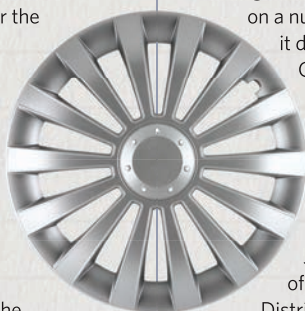
user's observation of chimney caps was made when users were standing on the ground. The District Court's statement was questioned by the Appellant, who asserted that it was unreasonable to assume that the informed user would only observe and obtain the overall impression of the chimney caps from ground level; this may be the case for people in general, but not for the informed user.

The right holder also questioned the Court's conclusion that the design was limited by its technical function. The Appellant argued that the technically functioning parts of the chimney cap could be created through other variations and designs, and thus the design was not limited by its technical function.

The right holder also asserted that the District Court's findings were poorly explained and that the Court had misinterpreted the applicable provisions.

The Court of Appeal did not grant the right holder leave to appeal. The right holder then appealed the Court of Appeal's decision to the Supreme Court. The Supreme Court mentioned in its decision (Ö 4325-11) that the applicable legal provisions in the case had not yet been examined by the Supreme Court since their implementation in Swedish law in 2002 (the applicable provisions correspond to Articles 5 and 7 of the Design Directive 98/71/EC). The Supreme Court considered that it was of importance that higher courts provide guidance in this regard, and granted the right holder leave to appeal in light of the lack of guidance in Swedish case law on the application of the relevant provisions. The case is now under examination by the Göta Court of Appeal (case T 1519-12).

Per Svantesson and Sara Sparring, Bird & Bird LLP, Stockholm



Land of opportunity

Nick Holmes explains why changes to Australian legislation may be of benefit to UK rights holders

In April 2013 Australian trade mark law underwent its most significant change since the new Trade Marks Act was introduced in 1995. Along with the significant changes to trade mark opposition proceedings discussed in the *ITMA Review* June 2013, the changes include welcome amendments to the Australian Customs seizure provisions and the penalties available for trade mark enforcement. This article highlights these key changes.

Customs seizure

The owner of an Australian trade mark registration can lodge a Notice of Objection with the Australian Customs Service, to help prevent the importation of counterfeit or unauthorised goods into Australia. The Notice instructs Customs to watch for and seize counterfeit goods or other goods that may infringe an Australian trade mark registration, and provides a cost-effective means of preventing such goods entering the Australian marketplace.

Prior to the recent changes, once Customs seized goods under a Notice of Objection the trade mark owner needed to either commence infringement proceedings against the importer or obtain the importer's written consent to forfeit the imported goods, within ten working days from the date of the seizure notice (extendable by ten days). In practice, this required trade mark owners to take urgent action to persuade the importer to forfeit the goods. If the importer did not agree to forfeit the

goods then the trade mark owner was required to either commence proceedings or otherwise accept that Customs must release the goods to the importer.

The Raising the Bar Act 2012 introduced three major changes to the Australian Customs seizure procedures, all of which benefit the trade mark owner. The main effects of these are that:

- 1) The initial onus shifts from the trade mark owner to the importer once Customs seizes any goods relating to a Notice of Objection. The seized goods will be forfeited to Customs unless the importer makes a written claim for those goods. Australia is one of the only jurisdictions in the world to apply such "reverse onus".
- 2) The trade mark owner can obtain additional information from Customs

- 3) The trade mark owner may now inspect samples of the seized goods in certain circumstances, rather than just relying on photographs to determine whether the goods are genuine or counterfeit. In many cases such physical inspection is necessary to confirm that the goods are indeed counterfeit.

In practical terms these welcome changes should reduce the input required from trade mark owners to maintain an effective trade mark border protection programme. In many cases a trade mark owner will no longer need to send a letter of demand to the importer or otherwise incur significant legal costs each time Customs seizes an importation.

'These welcome changes should reduce the input required from trade mark owners to maintain an effective trade mark border protection programme'

regarding the importer to help identify the source of the importation. Since the changes took effect Customs has been able to provide much more information to trade mark owners regarding the origin of the seized goods than it was previously able to provide. This information can help trade mark owners, in a broader global sense, to identify the source in a foreign country from which counterfeit goods have originated.

The new procedure works as follows:

- 1) The owner of a trade mark registration lodges a Notice of Objection with Customs listing the registered Australian trade marks that it would like to protect. Numerous trade mark registrations can be covered by a single Notice of Objection that remains in force for four years, renewable thereafter.

- 2) If Customs seizes any goods that bear a trade mark listed on the Notice of Objection it will issue a seizure notice to the importer with copy to the trade mark owner or its agent. The seizure notice will provide the name and address of the importer and trade mark owner and its agent, and set out relevant deadlines. The importer will then have ten working days to lodge a “claim for release” with Customs. This claim requires the importer to provide full contact details and specify the grounds on which the importer seeks to have the seized goods released. Unless this claim is lodged within the requisite period the goods are automatically forfeited to Customs for eventual destruction. While there is some provision for late claims to be filed by the importer, these are allowed only under reasonably tight conditions.
- 3) If the importer does lodge a claim for release of the goods, the trade mark owner has 10 working days to institute Court proceedings against the importer or persuade the importer to forfeit the goods. Under the former regime this period could be extended by a further 10 days. The new provisions do not allow any such extension, which creates a very tight time frame for trade mark owners.

These changes should make it easier and less expensive for the owner of an Australian trade mark registration to prevent the importation of counterfeit goods into Australia. The only disadvantage the new procedure presents is the tight 10-day time frame, which is created if the importer does lodge a claim for release. Under the former regime the 10-day period could be extended by a further 10 days. The new provisions do not allow any such extension.

Similar provisions have also been introduced to the Copyright Act 1968, relating to protection of copyright works.

Strengthened enforcement for infringement

The changes introduced by the Raising the Bar Act increase the penalties and remedies available for trade mark infringement to bring them in line with those for copyright, design and patent infringement matters. These include:

- 1) Increase to maximum penalties – the maximum penalty for indictable trade mark offences has been increased from two to five years’ imprisonment and 550 “penalty units”. The offences themselves remain largely the same as those that existed previously and include falsely applying a registered mark, altering or removing the trade mark without permission of the trade mark owner, or applying a registered mark to goods or services without the trade mark owner’s consent.
- 2) Broader assessment of damages – when a Court comes to assess damages it may now include an additional amount relating to issues such as the flagrancy of the infringement, the infringer’s conduct (including after it was advised of the infringement) and the need to deter such infringement from occurring again.

- 3) Summary offences – a range of new summary offences have been introduced that apply a “negligence” fault element or one of strict liability, which effectively reduces the burden of proof necessary to establish that an offence has been committed.
- 4) Extended jurisdiction – the Federal Magistrate’s Courts’ jurisdiction (now referred to as “Federal Circuit Court”) has been extended to cover trade mark matters, which may result in trade mark owners being able to pursue a trade mark infringement action more quickly and at lower cost than was previously the case.

Lessons for UK mark owners

In light of the ease with which UK-based businesses now market their goods globally through online means, these changes provide an incentive for UK-based businesses to register their trade marks in Australia promptly, to help secure the marketplace there. As a mark may be registered in Australia without the need to demonstrate use, and noting that an Australian registration will not become vulnerable to third-party challenge for non-use until it has been registered for five years (or immediately if there is no intention to use), these changes significantly increase the benefits afforded by an Australian trade mark registration. ■

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Turkish turnaround

The court concluded that a bad faith filing can constitute unfair competition, as Selma Ünlü explains

A well-examined decision of Bakırköy IP Civil Court (2007/18 E 2009/61 K, 11 July 2011), which ruled that bad faith actions “exceeding the limits of rights arising from trade mark registration” cannot be protected, was approved by the 11th Court of Appeal.

According to previous decisions of the Court of Appeal, the use of a registered trade mark on goods and services or against third parties – even if it was filed in *bona fide* or *mala fide* – did not constitute infringement or unfair competition. Accordingly, compensation due to the infringement was not possible. In the case subject to this article, in contrast, the IP Court judge clearly took into account the peculiarity of the dispute and examined the matter in a different way.

Background

In this particular case, the Claimant – the producer of motorcycles carrying a disputed logo trade mark – requested the cancellation of the subject trade mark and claimed pecuniary and non-pecuniary damages. The Defendant was the owner of a registered logo trade mark identical to the Claimant’s trade mark, and was the previous distributor for the Claimant.

Specifically, the Claimant alleged that it sold motorcycles to the respondent company before the registration date of the disputed trade mark. In accordance with the submitted evidence, this fact was accepted by the Court. In addition, after the registration date of the disputed trade mark, the Defendant revealed on its own website that it was the distributor of the Claimant.

Before the action was filed, the Defendant had the Claimant’s

motorcycles stopped at Customs, based on its registered trade mark. As a consequence, the Claimant had to bear several costs, related to the Customs action, and to the cost of transportation of the goods from China to Istanbul and from Istanbul to China. Therefore, the Claimant demanded pecuniary and non-pecuniary damages from the Defendant.

First instance court

The judge of the IP Court referred to previous judgments of the Court of Appeal and stated that, under normal circumstances, production or sale of the motorcycles by the Defendant based on its registered trade marks or use of its registered rights against a third party would not constitute unfair competition – even where the Claimant is the genuine right holder – until said trade mark rights are cancelled.

However, in this case the Defendant, despite its knowledge that the genuine right owner of its registered trade mark was the Claimant, not only registered the subject trade mark before the Turkish Patent Institute, but also had the goods of the Claimant stopped at Customs and caused the damages previously mentioned. The judge clearly stated that this action completely exceeded the limit of a trade mark right.

Consequently, the IP Court judge ruled the cancellation of the trade mark and awarded pecuniary and non-pecuniary damages, since the subject file has a special feature.

Surprise approval

As a result, the Court of Appeal approved the judgment of the IP

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Court and refused the Defendant’s Opposition. It stated that the Defendant had the motorcycles stopped at Customs in bad faith, based on its registered trade mark, which had been obtained in bad faith as well. In previous decisions, the Court of Appeal ruled that “bad faith is a cancellation reason all by itself”. Through this decision, the Court of Appeal approved the IP Court’s decision on the damages, stating that the Defendant used its rights on the registered trade mark in bad faith and caused the damages mentioned above.

There is no question that this decision is surprising, since it supported the well-grounded and reform-minded decision of the Bakırköy IP Court, extending the previous entrenched jurisprudence of the Court of Appeal. It will be interesting to see how judges in similar cases respond in the future. ■

Case in point: O/093/13, Claro (Opposition), UK IPO, 27 February 2013

Bright future for Claro mark

An application to register a competitor's mark was bad faith, writes Joseph Letang

Claro SA ("Claro") is based in Brazil and is one of the largest telecoms companies in Latin America. Telecoms services have been provided under the mark CLARO in Latin America since the 1990s. Telefónica SA ("Telefónica"), a direct competitor of Claro, is the dominant Spanish telecoms provider and also operates in the Latin American market.

Telefónica filed an application to register the mark CLARO as a Community Trade Mark (CTM) in 2000. The mark achieved registration in 2005 (002017341). Claro filed its own CTM applications, 005229241 CLARO (device) and 9191263 CLARO, in 2006 and 2010 respectively. Telefónica opposed both applications on the basis of CTM Registration 002017341. In response to these oppositions, Claro filed a non-use revocation action against Telefónica's registration. Prior to a decision being taken in that action, Telefónica surrendered the registration and converted it into national applications in the UK (2579750), Germany and Spain, retaining a filing date from 2000 (Article 112(3) CTMR). Claro sought to close this EU loophole by opposing the UK conversion.

Since Claro had been unable to obtain registered rights in the CLARO mark in the EU and had not yet used the mark in the UK, the Opposition was based solely on section 3(6) of the Trade Mark Act 1994. The Notice of Opposition and Statement of Grounds (TM7) stated that the application was made in bad faith because:

- 1) the Applicant had no *bona fide* intention to use the mark in the UK;
- 2) the Opponent had established a significant reputation in the mark in several overseas jurisdictions and the Applicant was aware of this reputation; and
- 3) the Applicant knew that the mark belonged to the Opponent and knew (or should have known) that the Opponent wished to use and register the mark in the UK and had filed the application

simply to block any application by the Opponent.

The Opposition was supported by extensive evidence of use of the CLARO mark in Latin America since 1998. The evidence was filed appended to a witness statement from Claro's Brazilian attorney, which stated that there had been no use of the mark Claro by Telefónica and that it was Claro's belief that the original CTM application and the resulting national conversions had been filed with the express purpose of blocking Claro from using its mark in the EU and hindering its plans for expansion into the EU market.

Telefónica did not file evidence in response, but preferred to rely on submissions at a hearing that was held at the UK IPO in December 2012. Claro was not represented at that hearing and filed no written submissions.

Telefónica argued at the hearing that all the evidence submitted by Claro was irrelevant since it related only to use of the mark in Latin America and had no bearing on the position in the UK.

Oliver Morris on behalf of the UK IPO disagreed, finding that there is no formal requirement that an applicant for a UK mark that results from the conversion of a CTM must have a *bona fide* intention to use the mark (Article 114(2) CTMR), so lack of intention to use *per se* cannot constitute bad faith. Nonetheless, if there is some "added ingredient" this may be sufficient.

The added ingredient was present in this case: Telefónica's actions were designed to block Claro's expansion. While conceding that the evidence filed did not establish that Telefónica knew of Claro's plans to expand into Europe, Morris took the view that telecommunications was a field in which expansion was a "fairly obvious" step. He also found that the non-use of the mark by Telefónica

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and the circumstances leading up to the conversion of its CTM were persuasive. Claro was found to have established a *prima facie* case that, without rebuttal, was accepted.

It is also of note that Telefónica claimed to have decided not to file evidence to keep down costs because the evidence submitted by Claro "lacked cogency". The Hearing Officer commented unfavourably on this decision, stating that Telefónica was only required to establish a *prima facie* case.

This case is a reminder that, without rebuttal, only a *prima facie* case need be established to show bad faith, that evidence solely from outside the UK can be sufficient and that there is no formal intention-to-use requirement for CTM conversions into the UK. ■



A slice of the action

Caffè Kimbo won a partial success in this case that turned on the popularity of a packaged bread brand, reports Désirée Fields

The EU General Court has upheld a decision of the OHIM Board of Appeal allowing a Community Trade Mark (CTM) application for the figurative mark CAFFÈ KIMBO to proceed to registration in relation to a limited scope of goods. The General Court confirmed that while the signs at issue were similar, the opposition could succeed only in relation to those goods that were identical or similar to those for which the prior mark BIMBO was well known, namely packaged sliced bread.

The Intervener in these proceedings, Café do Brasil SpA, filed a CTM application for the figurative mark CAFFÈ KIMBO covering, among other goods, “coffee, tea, cocoa, sugar, rice, tapioca, sago coffee substitutes; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacles; yeast, baking-powder; salt, mustard; vinegar sauces (condiments); relish; ice” in class 30. Bimbo SA brought an opposition under Article 8(i)(a) and (b) of Community Trade Mark Regulation 207/2009/EC (CTMR) on the basis of its prior Spanish word mark registration for BIMBO covering “cereals, milling industry, baking, pastry and starch” in class 30. Bimbo also claimed a reputation in respect of these goods, arguing that the BIMBO mark was well known in Spain in respect of those goods within the meaning of Article 8(5) CTMR.

The opposition based on the earlier Spanish trade mark was rejected because Bimbo had not proved its renewal within the time limit set by OHIM. Therefore, the assessment had to be carried out on the basis of the earlier unregistered right for BIMBO, which Bimbo claimed was well known in Spain.

Board of Appeal

The Opposition Division upheld the opposition in respect of parts of the goods at issue, namely in relation to

“flour and preparations made from cereals, bread, pastry and confectionery, ices; yeast, baking-powder”. On appeal by Café do Brasil, the OHIM Board of Appeal annulled part of the decision. The Opponent’s evidence showed that the BIMBO mark was only well known in Spain for packaged sliced bread. Accordingly, the Board of Appeal rejected the application in relation to “preparations made from cereals, bread and pastry” only. Bimbo appealed to the General Court, arguing that there had been various procedural errors relating to the infringement of Articles 64, 75 and 76 CTMR, and that the assessment of a likelihood of confusion should have been carried out against goods other than merely packaged sliced bread.

GC decision

The General Court rejected the various procedural grounds raised and went on to uphold the Board of Appeal decision. It confirmed that the Board of Appeal had correctly examined the evidence provided to substantiate the existence and scope of the well-known trade mark relied upon, and concluded that the signs at issue were similar overall. Accordingly, the Board of Appeal had been correct to find a likelihood of confusion in respect of the goods covered by the application, which were found to be similar to goods for which the well-known character of the earlier mark was established. The well-known character of the mark had been

established only in respect of goods related to “packaged sliced bread”. Consequently, the opposition had to be upheld in relation to “preparations made from cereals, bread and pastry”. With respect to “flour, confectionery, ices, yeast and baking-powder”, the General Court found that the Board of Appeal had rightly concluded that these goods were dissimilar to “packaged sliced bread” covered by the earlier mark because they had a different nature, purpose and method of use. There was no likelihood of confusion in respect of those goods.

The decision highlights the importance of ensuring that all evidence pertaining to an opponent’s case, including the subsistence of earlier rights, is presented in a timely manner. Although Bimbo was partially successful in its opposition proceedings, the evidence submitted was only able to demonstrate that its mark was well known in relation to a very limited number of goods. If Bimbo had submitted evidence that its Spanish registration was valid and subsisting, it would have been able to rely on a broader range of goods and may have been able to remove further goods from the specification of the opposed mark. Of course, its prior Spanish registration may have been challenged on the grounds that it was partially vulnerable to cancellation for non-use, in which case the end result may well have been the same. ■

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Case in point: T-537/11, Hultafors Group AB v OHIM, CJEU, General Court, 19 April 2013

Confusion conclusion

The court kicked out Hultafors' claims in this CTM decision here covered by Azhar Sadique

In this case, the decision of the Fourth Board of Appeal was upheld by the General Court confirming that there was a likelihood of confusion between a figurative Community Trade Mark application incorporating the word SNICKERS (see mark below right) and an earlier Italian registration for the word mark KICKERS for goods in class 25. Both marks covered goods including "clothing, footwear and headgear".

Background

In March 2004, Hultafors filed an application for the mark shown on this page in classes 8, 9 and 25. The application was successfully opposed by Società Italiana Calzature SpA, under Articles 8(1)(b) and (5) of the Community Trade Mark Regulation (Regulation No 207/2009) on the basis of its Italian word mark KICKERS covering "clothing items, shoes, headgear".

In December 2010, Hultafors filed an appeal with OHIM, which was dismissed by the Fourth Board of Appeal. The Board confirmed that the Opposition Division was correct to conclude that there was a likelihood of confusion between the marks.

General Court plea

Hultafors appealed to the General Court and relied upon on a single plea alleging infringement of Article 8(1)(b). It argued that the signs at issue are not visually, phonetically or conceptually similar, that the mark applied for has a high distinctive character and that there is therefore no likelihood of confusion within the meaning of Article 8(1)(b).

Hultafors argued that consumers pay attention to both the mark and the product and are able to remember even minor differences between similar marks for identical products. It further argued that words ending in "ickers" are not uncommon and that the consumer's attention is directed towards the

beginning of the words. It argued that the signs did not create a similar phonetic impression and that the intonation and stress of the earlier mark were different from those of the mark being applied for, the latter being pronounced with a distinctly voiced "s" and clear stress on the initial letter of the first syllable. Hultafors further claimed that the average Italian consumer would be aware of the term "kicker" and its plural form "kickers", but would not know the meaning of the word "snickers". As such, Hultafors claimed that the mark applied for was highly distinctive and dissimilar to the earlier mark.

While the court agreed that the word "snickers" was not known by the average Italian consumer, it disagreed with the remainder of Hultafors' submissions, finding that when a mark is composed of word and figurative elements the former should be considered more distinctive than the latter, since the average consumer will refer to the goods in question by citing the word elements over the figurative elements (T 312/03, *Wassen International v OHIM* [2005] ECR II, paragraph 37). The court said that even if part of the relevant public shows a higher level of attention when buying the goods, Hultafors had failed to demonstrate that this concerns all of the relevant public.

The court reaffirmed the decision of the Board of Appeal. It confirmed that the word element "Snickers" was the dominant element of the mark applied for and that the figurative element had a low degree of distinctiveness and would be perceived as decorative. It found that the signs coincided in six letters out of seven and eight, respectively, and that the signs displayed an average degree of visual similarity. In its phonetic comparison, the court stated that the average consumer will not stop at the first letter of the marks, but will consider at least the first syllable. As the following letter was "i" in both marks, the first

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syllables were similar and the second syllables were identical. The courts pointed out that in Italian the words "snickers" and "kickers" are pronounced with two syllables and that in both cases the stress falls on the first syllable, and rejected Hultafors' arguments that the marks have a different rhythm.

The court confirmed that the signs showed an average degree of similarity from a visual and phonetic perspective and that the goods were identical, and that the board was correct to conclude that there was a likelihood of confusion between the marks.

The conclusions of the General Court confirm OHIM's position on this issue. It is important to remember that where figurative marks are based on word elements, those marks may be deemed similar to earlier word marks if the word elements are visually and phonetically similar. ■

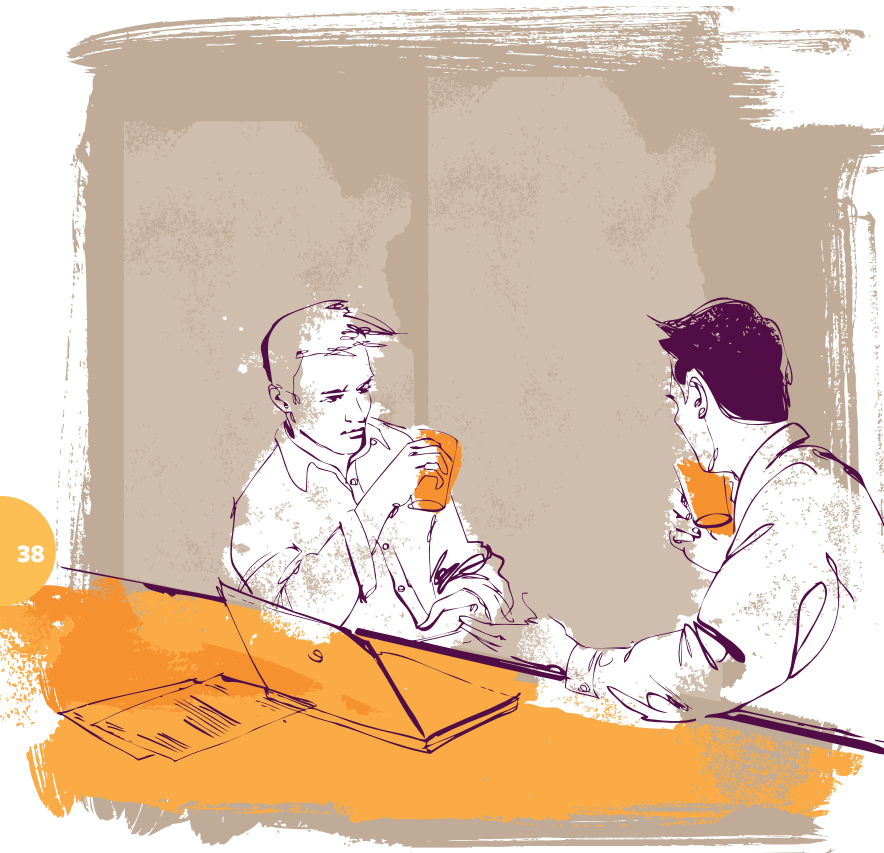
The disputed mark:



Case in point: [2013] UKSC 18, Public Relations Consultants Association Limited v The Newspaper Licensing Agency Limited and others, Supreme Court, 17 April 2013

Browsing is free – for now

Oliver Tidman reviews a UK Supreme Court decision that has the potential to touch every internet user



On 17 April 2013, the UK Supreme Court handed down its ruling on the internet law case of Public Relations Consultants Association Limited v The Newspaper Licensing Agency Limited and others [2013] UKSC 18, provisionally overturning the decisions of the High Court and Court of Appeal. The Supreme Court held that end-users of a news monitoring service did not need a licence from the copyright owners to view copyrighted content on a web page.

The question arose as to whether the copies created when accessing a web page are exempt from copyright protection by reason of the temporary copies exception provided by section 28A of the Copyright, Designs and

Patents Act 1988 (“CDPA”), which gives effect to Directive 2001/29/EC (“the Copyright Directive”). The Supreme Court found that cache copies are stored automatically by browsing and deleted automatically by a lapse of time coupled with continuing browser use, rather than being dependent on discretionary human intervention. Accordingly, it felt that the exception in section 28A of the CDPA and Article 5.1 of the Copyright Directive applied to temporary copies generated by an end-user of the internet and, as such, a licence should not be required.

The ruling is nevertheless provisional, as a referral has been made to the Court of Justice of the European

Union (CJEU) for a preliminary ruling before any order is made in the case, which is of importance to anyone who browses the internet or makes content available via the internet, but will be especially relevant to business users of media monitoring or news aggregator services.

One such news aggregator is Meltwater, provider of a commercial online media monitoring service called Meltwater News. This service is aimed at PR consultants, and automatically trawls through online articles looking for keywords that are of interest to its paying business clients (end-users). The customised results of Meltwater’s searches are made available to the end-users in a report sent by email or are accessible via Meltwater’s website.

Each search result contains summaries of the articles in which a specified keyword appeared. The summary contains the article headline, the opening words of the article, an extract from the body of the article showing the keyword in context, and a hyperlink to the original article.

The Newspaper Licensing Agency (NLA), a licensing and collection agency for UK newspaper publishers, claimed that media monitoring service providers (such as Meltwater) and end-users who received such services based on articles published by NLA members should be required to obtain a licence from the NLA to be entitled to do so.

Meltwater and the end-users of its service initially refused to purchase the relevant licences. As a result, NLA brought proceedings against Meltwater, Meltwater’s Dutch parent company and the end-users – via the Public Relations Consultants Association (PRCA), an industry body representing them – alleging copyright infringement. The proceedings against Meltwater were eventually stayed when Meltwater purchased the relevant licence.

However, the end-users persisted in their refusal, and therefore the High Court had to decide if end-users required a licence to receive and use Meltwater's search results.

The High Court held, and on appeal the Court of Appeal agreed, that headlines are capable of constituting copyright works, and that some of the text extracts could constitute a substantial part of the articles from which they were taken and therefore could be copyright works. It further held that the end-users were not covered by an implied licence for receiving and reading Meltwater News when clicking on a hyperlink to a full article. By following the link, the end-user was making a further copy

'Hopefully, the CJEU will offer guidance on whether those who receive temporary copies of material protected by copyright will be required to agree licensing terms'

of the copyright work that was not covered by Meltwater's licence. Such copying therefore infringed section 17 of the CDPA. There was also copyright infringement when end-users used the share function available to forward the article on to a third party, as the end-users were issuing copies of the work to the public, contrary to section 18 of the CDPA. These findings were not appealed to the Supreme Court.

Temporary copy exception

Despite the above findings, the PRCA claimed that the otherwise infringing copying came within an exception in section 28A of the CDPA, which allows a party to copy copyright works without infringing the copyright in the work if such copying is transient or incidental. The High Court and the Court of Appeal disagreed and held that the copying that took place when end-users received an email or accessed Meltwater's website was not transient or incidental, but was the end that the process was designed to achieve.

The PRCA appealed to the Supreme Court on whether end-users would

need a licence to receive Meltwater News if the reports were only made available on Meltwater's website. It was agreed on appeal that receiving an email would not come within section 28A of the CDPA as emails are permanent until the end-user deletes them.

Subject to the preliminary ruling of the CJEU, the Supreme Court overturned the decision of the High Court and Court of Appeal in relation to the section 28A exception. It stated that it has never been an infringement for a person to view or read an infringing article in physical form. Considering recent CJEU case law (including C-429/08, *Karen Murphy v Media Protection Services Limited* [2012] 1 CMLR 769), it held that such acts of copying in the process of viewing copyright material on the internet (but not the downloading or printing of such material) was covered by section 28A of the CDPA. This is the case even though electronic equipment used to browse the internet incidentally involves the creation of temporary copies, such as in the transmission of the data by the internet service provider, by displaying the data on screen and storing the data in the internet cache on the hard disk.

The Supreme Court explained that it would create an "unacceptable result" if such temporary copies were not covered by section 28A, and noted that: "If it is an infringement merely to view copyright material, without downloading or printing out, then those who browse the internet are likely unintentionally to incur civil liability, at least in principle, by merely coming upon a web page containing copyright material in the course of browsing. This... would make infringers of many millions of ordinary users of the internet across the EU who use browsers and search engines for private as well as commercial purposes."

Where are we now?

The Supreme Court has now referred for a preliminary ruling to the CJEU the question of whether the requirements of Article 5.1 of the Copyright Directive are satisfied and, in particular, whether requirements that acts of reproduction should be: (i) temporary; (ii) transient or incidental;

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and (iii) an integral and essential part of the technological process, are satisfied, having regard in particular to the fact that copies may remain in the cache after the browsing session that generated them has ended or until overlaid by other material, and that a screen copy will remain on screen until the browsing session is terminated by the end-user.

Should the judgment receive the support of the CJEU, end-users of the internet (such as the PRCA's members) will not be required to purchase a licence to view the copyrighted material. As a result, it is most likely that media monitoring firms such as Meltwater would be required to pay a greater licence fee, which the Supreme Court considered more satisfactory than the collection of minuscule sums from hundreds, or perhaps millions, of internet users. Furthermore, online publishers may need to review their revenue-collection models with a focus on the licensing of distributors and content aggregators rather than end-users.

Hopefully, the CJEU ruling will offer guidance on whether those who receive temporary copies of material protected by copyright will be required to agree to licensing terms, regardless of the level of content they receive or the fact that they merely view the information online without making substantial use of or reproducing such material. Accordingly, the judgment has the potential to greatly influence the way in which we all browse and consume information online. ■

Case in point: T-109/11, Apollo Tyres v OHIM – Endurance Technologies Pvt Limited, General Court (Second Chamber), 23 April 2013



Test of endurance

Carrie Bradley covers a case that saw persistence pay off for the Opponent

On 9 November 2007, the Applicant, Apollo Tyres AG (“Apollo”), filed a Community Trade Mark (CTM) application for the word mark ENDURANCE, covering “tyres, tubes and flaps for automobiles” in class 12, and a range of services in classes 35 and 37 (some of which were directly related to the class 12 goods).

Apollo’s application was opposed by Endurance Technologies Pvt Limited (“the Opponent”) in respect of all classes on the grounds of Article 8(i)(a) and (b) of Council Regulation No 40/94 (now Article 8(i)(a) and (b) of Council Regulation No 207/2009, “CTMR”). The Opponent relied on its earlier CTM Registration No 5819149 for the figurative mark ENDURANCE, which features three blue and white ellipses positioned above the black typeface, registered for goods in class 12, in particular “...parts, fittings and accessories for land vehicles”.

The Opposition Division (“OD”) issued its decision on 24 February 2010, upholding the opposition in part, namely in respect of all the goods covered by class 12 in the application, and also in respect of some of the services in class 35, *inter alia* “retail and online retail services connected with tyres, tubes and flaps for automobiles” on the ground that there was a likelihood of confusion within the meaning of Article 8(i)(b) CTMR.

According to the OD, such a likelihood of confusion existed, in particular, among the non-English-

and non-French-speaking section of the relevant consumers. Its reasoning concerning the lack of understanding of the meaning of the word “endurance” was a decisive factor in the determination of the dispute.

Partial rejection

On 16 April 2010, Apollo appealed against the decision of the OD. The Opponent submitted its response requesting, *inter alia*, that Apollo’s CTM application be rejected in its entirety. On 25 November 2010, the First Board of Appeal of OHIM (“BoA”) dismissed the appeal and upheld the OD’s decision not only in respect of all goods in class 12 and part of class 35, but also in respect of “repair”, “installation”, “fitting services for tyres” and “repair and replacement of tyres” in class 37.

‘Although the Community Trade Mark application consisted of the made-up word “endurance”, it so closely visually resembled the word “endurance” that it may be regarded by reasonably observant consumers as a simple misspelling’

Since the scope of Apollo’s CTM application had thereby been even further restricted, Apollo duly contested the BoA’s decision, requesting that the General Court annul it in relation to both the rejection of the relevant goods and services, and in relation to the order for Apollo to pay costs to the Opponent. Apollo further requested an order for the Opponent to pay all the costs that it incurred before the OD, the BoA and the General Court. OHIM countered that the action for annulment should be dismissed in its entirety.

General Court judgment Similarity of the marks

In the contested decision, the BoA had found that, although the CTM application consisted of the made-up word “endurance”, it so closely visually resembled the word “endurance” that it may be regarded by reasonably observant consumers as a simple misspelling thereof. The BoA also considered the marks to be nearly identical aurally.

In its submissions before the Court, Apollo countered that the words “endurance”, “endurance”, “enduracers” and “enduro” are understood throughout the European Union (EU) as denoting the ability (of the goods at issue) to exert themselves for a long period of time. Apollo reasoned that, since the word endurance is therefore

an “ordinary” word in French and English, it is devoid of distinctive character and, accordingly, the consumer will place more focus on the figurative element within the earlier mark, thereby rendering it dissimilar. In this regard, the BoA had found that there may be consumers in many parts of the EU who might not understand or be aware of that word, and hence would be unable to derive any conceptual meaning from the marks, thereby throwing the emphasis onto the visual and phonetic comparison of the marks.

The Court agreed with the BoA and found that the word “endurance”

endurance n. 1 the ability to endure an unpleasant or difficult process or situation without giving way; 2 the capacity of something to last or to withstand wear and tear.

cannot be considered to be a basic English word, the meaning of which would be understood by any EU consumer. The Court distinguished this finding from that in *CheapFlights International v OHIM* (T-461/09) on the basis that, in the present case, “it is neither well known nor proven that there is, throughout the territory of the European Union, such frequent use of the word ‘endurance’ that it would be understood even by a substantial part of the non-English or non-French speaking relevant public.”

In this regard, OHIM had countered that some of the evidence produced by Apollo before the Court in support of its submissions, namely web page extracts demonstrating knowledge of the word in four other Member States, was inadmissible because it was not submitted in the course of the administrative procedure. In this regard, the Court found that the documents submitted were indeed different from the evidence submitted before OHIM. Accordingly, the Court ruled that the new evidence must be excluded without any assessment as to its probative value since “it was for the Applicant to provide, on that particular point, if necessary, all of the evidence in support of its application in the procedure before OHIM”.

Furthermore, the Court considered that the word has no resemblance to, or common root with, its equivalents in other European languages, and the difference in pronunciation, due to the mere absence of the letter “n” in the mark applied for, was found to be marginal in comparison with the identical sound of the eight other letters. The Court therefore found that this one-letter difference would not neutralise it in most conceivable pronunciations for a non-English- or non-French-speaking consumer. Consequently, given the lack of conceptual understanding of the word, and the visual and aural degree of similarity, the Court found that the BoA had rightly concluded that the marks were sufficiently similar that it was reasonable to infer a likelihood of confusion between them.

Similarity of the goods or services

The Court was also asked to review the BoA’s finding that the goods in class 12 of Apollo’s CTM fall within the category of “parts, fittings and accessories” for automobiles as protected by the

Opponent’s earlier mark. OHIM submitted that Apollo’s claims in this regard amounted to “denying the obvious, since the first of the above-mentioned categories of goods is included within the second”. The Court found in favour of the BoA on this point, commenting that Apollo had provided no actual evidence to support its statement that the goods covered by the earlier mark are limited to goods made solely “of metal and/or aluminium”, and as such differ in their nature, function and intended purpose, and neither was there any such express limitation in the Opponent’s specification of goods.

Apollo also sought to rely upon two decisions of US courts concerning the comparison of goods such as tyres and automobile parts. However, the Court was quick to point out that these decisions were not relevant to the resolution of the present dispute since the CTM regime is an autonomous system, with its own set of rules that apply independently of any national system.

Useful reminder

This decision serves as a reminder to practitioners that, in the words of the Court, “the purpose of actions brought before the General Court is to review the legality of decisions of the Boards of Appeal of OHIM within the meaning of Article 65 of Regulation No 207/2009; it is not therefore the Court’s function to review the facts in the light of documents produced for the time before it”. It therefore reiterates that documents produced before the General Court for the first time will be deemed inadmissible if they could have been submitted in the

course of the administrative procedure before OHIM. Clearly, the Applicant failed to support some of its stronger points with the necessary evidence at the relevant time, a point that the OD and BoA had relied on heavily in reaching their decisions. Ultimately, in the absence of the subsequently inadmissible evidence, the Court had no reason to annul the BoA’s decision. The decision also confirms the Court’s familiar stance on the persuasiveness of decisions from overseas jurisdictions. ■

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Carbon case asserts OHIM independence

Katy Cullen discusses a case that demonstrates the limits of a national decision

An innocent bystander could be forgiven for thinking that if an English word mark is deemed distinctive and non-descriptive at a UK national level, OHIM will take a similar view. However, the recent case concerning CARBON GREEN is a reminder that OHIM will form an independent and sometimes contrasting view when assessing the descriptive and distinctive nature of English word marks.

The facts

The Applicant, CBp Carbon Industries Inc, applied to register CARBON GREEN in the UK and as a Community Trade Mark (CTM) in class 17 for: “Reclaimed rubber, namely, recycled carbonaceous materials, namely plastic, elastomeric, or rubber filled materials obtained from pyrolyzed tire char and plastic, elastomeric, or rubber compounds formulated using such filler material.”

The UK mark sailed through the application process and achieved registration within a year.

However, the CTM application was refused on the basis that CARBON GREEN was deemed to denote a characteristic of the goods and hence fell foul of Articles 7(1)(c) and (2) of Council Regulation (EC) 40/94 (now Articles 7(1)(c) and (2) of Council Regulation (EC) 207/2009), which state that the following shall not be registered:

Article 7(1)(c)

“Trade marks which consist exclusively of signs, which may serve... to designate the kind... of the goods.”

Article 7(2)

“Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.”

The application was also refused on the basis that the impact of the mark

on the relevant public was primarily descriptive and, as such, its trade origin could not be distinguished. The mark was therefore devoid of distinctive character and fell foul of Article 7(1)(b) of Regulation 40/94 (now Article 7(1)(b) of Regulation 207/2009), which states that the following shall not be registered:

“Trade marks which are devoid of any distinctive character.”

Appeals action

The Applicant appealed. However, the First Board of Appeal dismissed the appeal. The goods were technical in nature, so the relevant public were specialised English-speaking consumers well versed in the carbon-based nature of the goods and the general meaning of “green” to denote environmentally friendly products. CARBON GREEN was therefore wholly descriptive, not capable of indicating trade origin and, as such, devoid of distinctive character.

The Applicant appealed to the General Court alleging infringement of Article 7(1)(b) and Article 7(1)(c). With respect to the latter, it argued that the Board of Appeal had:

- 1) erred in assessing the descriptive character of the mark;
- 2) failed to provide evidence establishing descriptiveness; and
- 3) erred in its assessment with regard to the case law on the public interest.

Regarding (1), the Applicant claimed that “carbon” was normally associated with air pollution and its combination with “green”, which denotes ecology, was contradictory. As such the combination CARBON GREEN should not be deemed descriptive.

Unfortunately, the Applicant’s specification sounded the death knell to this argument. The goods included “carbonaceous materials” and “reclaimed” and “recycled” goods. The General Court therefore considered

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that CARBON and GREEN denoted characteristics of the goods. Although paradoxical, CARBON GREEN was nevertheless descriptive.

Concerning (2), the General Court held that registrability should be assessed on the basis of European Union (EU) legislation as interpreted by EU case law alone and further independent evidence was not required. The Applicant’s second argument was therefore also rejected.

With respect to (3), the Applicant claimed the relevant sector should have been analysed to establish the likelihood of other traders wanting to use CARBON GREEN. The General Court disagreed, stating that there was no requirement to make this analysis. Given its highly descriptive nature, it was reasonable to assume the relevant public might immediately perceive CARBON GREEN to denote the characteristics of the goods.

Resounding rejection

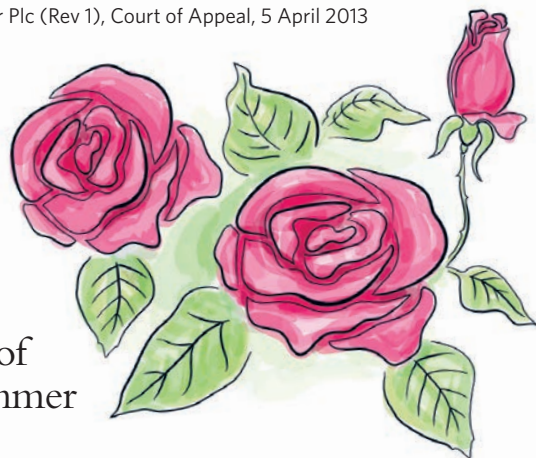
The General Court therefore upheld that CARBON GREEN was descriptive and its registration should be rejected according to Article 7(1)(c). It was settled case law that a descriptive mark was also devoid of distinctive character and as such the appeal based on Article 7(1)(b) was also rejected.

With such a resounding rejection, the case is a useful reminder that even if English word marks are not in the common parlance of native speakers, and indeed achieve UK registration, OHIM may still take a strict approach. ■

Case in point: [2013] EWCA Civ 319, *Interflora Inc and another v Marks & Spencer Plc* (Rev 1), Court of Appeal, 5 April 2013

Interflora back in the news

Despite the issues involved, it seems the days of survey evidence are not over, says Bonita Trimmer



The ongoing trade mark infringement dispute between Interflora and Marks & Spencer has already resulted in a handful of judgments, including one from the Court of Justice of the European Union. As has been extensively reported in the *ITMA Review* and elsewhere, the main dispute concerns the use of competitors' trade marks as sponsored internet keywords or search terms. However, the more recent hearings have concerned what consumer evidence can be used to support trade mark infringement claims.

In April 2013, the Court of Appeal handed down the second of its judgments that relate to whether consumer evidence of a "likelihood of confusion" based on answers to questionnaires should be admitted in trade mark disputes. In an earlier judgment, the Court of Appeal had indicated that such evidence (ie where obtained via a witness-gathering exercise) should not be admitted, unless it was shown that it was likely to be of "real value" and that value justified the costs incurred by parties in obtaining and considering it.

However, the Court of Appeal's disapproval of such witness-gathering exercises and surveys, in general, appeared to stem in a substantial part from the fact that such evidence is prompted by "artificial stimuli". Spontaneous evidence from consumers who were, in fact, confused has historically been admitted without issue. Accordingly, Interflora went looking for consumers who had been confused by Marks & Spencer's past use of "Interflora" as an internet key word. It did this by posting a questionnaire to selected customers on its mailing lists, which, it said, was intended to identify consumers who had actually been confused, and obtained initial evidence from them. Customers who

answered the questionnaire in a way that suggested to Interflora's team that they had been confused were then asked to provide a witness statement.

In the High Court, Arnold J decided the witness evidence Interflora had obtained as a result of this new exercise should be admitted; it related to "actual confusion", it would be of "some value" and the costs involved were mostly already "sunk". Marks & Spencer appealed this decision.

Loud and clear

Lewison LJ, who gave the leading judgment in the Court of Appeal, firmly disagreed with the approach taken by the High Court judge, saying: "With the benefit of hindsight, perhaps I did not make my message clear enough in *Interflora* 1. Let me say it again, but more loudly: a judge should not let in evidence of this kind unless the party seeking to call that evidence satisfies him (a) that it is likely to be of REAL value; and (b) that the likely value of the evidence justifies the cost."

The Court of Appeal also heavily criticised the following question in the questionnaire that Interflora sent to selected customers on its mailing list, which was included to unearth evidence that consumers had been confused: "From your memory of these [internet] search results, what, if anything, do you think the results tell you about any relationship between Interflora and M&S?"

Lewison LJ concluded it was not possible to describe the answers to this question "as real world responses to the M&S advertisement". "On the contrary," he said, "since [this] question was only to be asked if the interviewee failed to mention a connection arising out of his or her experience in the real world [in answer to earlier questions], it was plainly an attempt to elicit an answer by means of an artificial stimulus".

The Rt Hon Sir Robin Jacob agreed with the leading judgment, but was a little more reserved. He thought the key consideration was the negative impact this question had on the value of the evidence obtained. The value of the witnesses who had been exposed to this question was "nil", which left only five consumer witnesses, and these remaining witnesses could not be assumed to be representative of the average consumer.

So is that the end of surveys and witness-gathering exercises in trade mark disputes in the UK? Not quite. Sir Robin Jacob should be given the last word on this subject here, as in the judgment: "This decision does not mean that the days of survey evidence are over. It is possible to conduct fair surveys and they may indeed lead to witnesses of value. And that may turn a case..." ■

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Case in point: T-571/11, El Corte Inglés, SA v OHIM, CJEU, General Court (Fourth Chamber), 20 March 2013

Courts go against El Corte Inglés

Spanish national practice held no weight here, explains Anne Wong

In May 2004, Groupe Chez Gérard Restaurants Limited filed a Community Trade Mark (CTM) application for the word mark CLUB GOURMET in respect of the following:

- Class 16 - stationery, paper coasters, table cloths, table mats and table napkins of paper, paper gift bags
- Class 21 - basting spoons, non-electric blenders, bottle openers, brushes for cooking, ceramics for household purposes, coffee grinders, coffee percolators, confectioner's decorating bags, cookery moulds, cooking skewers, cooking utensils, corkscrews, food presses, funnels, graters, griddles, ice buckets, ice-cube moulds, kitchen containers, kitchen mixers, kitchen utensils, mills for domestic purposes, mixing machines, mixing spoons, noodle machines, nozzles, pepper and salt mills, pipettes, pitchers, pots, rolling pins, tableware services, spatulas, sprinklers, tea-balls, tea caddies, tea infusers, tea services, trays, vacuum flasks, and wine tasters; food storage containers, glassware, porcelain and earthenware
- Class 29 - preserved, dried and cooked fruits and vegetables; jellies, jams, meat, fish, poultry and game, charcuterie, cheese, soups, yogurt, olive oil, pâtés
- Class 30 - coffee, pasta, tea, cocoa, flour, sugar, bread, pastry, confectionery, cakes, ice creams and sorbets, sandwiches, honey, treacle, mustard, vinegar, sauces, condiments and spices, fruit sauces
- Class 32 - beers, mineral and aerated waters and other non-alcoholic drinks, fruit drinks and fruit juices, syrups and other preparations for making beverages

- Class 33 - alcoholic beverages (except beers); wines; liqueurs.

The application was opposed in its entirety by El Corte Inglés, SA on the basis of four earlier marks: Spanish figurative mark Registration 1817328 in class 35; Spanish word mark Application 2229135 in class 16; Spanish word mark Application 2589335 in classes 29, 30, 31, 32, 33 and 34; and CTM word mark Application 3789054 in classes 29, 30, 31, 32, 33 and 35.

Subsequently, CTM Application 3789054 was dismissed by the Second Board of Appeal, a decision that has become final. The Applicant renounced Spanish Applications 2229135 and 2589335 as a basis for opposition. The opposition proceeded based only on Spanish figurative mark 1817328 - CLUB DEL GOURMET, EN.... El Corte Inglés and device - registered for the following services in class 35: "An advertising sentence". It will be applied to the products covered by the trade marks 1013156 (class 29), 1013157 (class 30) and 1815538 (class 31), 1815539 (class 32), 101358 (class 33), 1815547 (class 42), "El Corte Inglés" (figurative), "the earlier mark".

Opposition was based on Articles 8(1) (b) and (5) of Council Regulation (EC) 40/94, now Articles 8(i)(b) and (5) of Council Regulation (EC) 207/2009. On 3 September 2010, the Opposition Division rejected the opposition.

Board of Appeal

On 6 October 2010 El Corte Inglés ("the Applicant") filed notice of appeal

at OHIM. On 28 July 2011 the First Board of Appeal of OHIM dismissed the Appeal. It found that the description of services covered by the earlier mark, "an advertising sentence", did not allow any comparison with the goods designated by the mark applied for, as it designated neither goods nor a service. Even if the earlier mark were considered to cover "advertising services" in class 35, the goods and services covered by the marks at issue are dissimilar. It considered the marks at issue to be overall visually and phonetically dissimilar, with only a weak degree of conceptual similarity. Furthermore, OHIM held that it is not possible to extend the protection of the earlier mark to goods in other classes or to goods and services protected by other rights that were not relied upon as the basis of opposition.

The Applicant filed an application to annul the decision of the Board of Appeal.

General Court appeal

In the Appeal to the General Court ("the GC"), the Applicant provided an explanation about a practice followed by the Spanish Patent and Trade Mark Office (SPTMO) until 1997 in relation to slogan marks. It submitted that the practice meant that the earlier mark is protected not only for services in class 35, but also for all the goods and services designated by one or more "basic marks", specifically goods and services in classes 29, 30, 31, 32, 33 and 42 as covered by the registrations listed

in the earlier mark's description of services. It argued that those goods and services, as well as those in class 35, should be taken into account when comparing the earlier mark with the mark applied for.

The GC first ascertained the scope of the description of goods and/or services for which the earlier mark was registered. The GC took the description of services covered by the earlier mark to be a single service in class 35, namely "an advertising sentence", whose intended use is then indicated. It is not apparent from the wording of the specification that the earlier mark is supposed also to designate goods. It is not possible from the list alone to know which goods are intended to be designated by the marks listed in the specification as the goods are not identified.

New information

The GC went on to assess additional information provided by the Applicant in relation to the practice of the SPTMO. The GC confirmed that it is settled case law that the purpose of an

'The General Court rejected the argument that national law forms part of the EU law framework within which the Court examines the legality of OHIM's decisions'

action before the GC is to review the legality of the decision of the Boards of Appeal of OHIM within the meaning of Article 65 of Regulation 207/2009. Facts not submitted by the parties before OHIM cannot be submitted on appeal to the GC and the GC cannot review the factual circumstances in the light of evidence brought before it for the first time.

At no stage prior to the Appeal to the GC did the Applicant explain that the earlier mark covered any goods or services other than class 35 services. On the contrary, the Applicant's evidence indicated that the earlier mark designated class 35 services only.

OHIM's obligations

The GC found that there was no obligation for OHIM to take into account the practices of Spanish national law in relation to the protection conferred by the earlier mark. For the institutions of the European Union (EU), determining and interpreting rules of national law is a matter of establishing the facts. The only law that is applied is EU law.

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In accordance with the provisions of Rules 19(2) and 20(1) of Commission Regulation (EC) 2868/95 of 13 December 1995 Implementing Council Regulation 40/94, it is for the opposing party to file proof of the scope of protection of the earlier mark, not for OHIM to investigate such matters.

The GC rejected the argument that national law forms part of the EU law framework within which the GC examines the legality of OHIM's decisions. It is for the party relying on national law to show that it supports its claims.

From the description of the services designated in the earlier

indication "an advertising sentence" did not correspond to any of the goods or services listed by the Nice Classification, was not a product or service within the meaning of Article 8(1)(b) of Regulation 207/2009 and could not be interpreted as "advertising services" as this would constitute extending the scope of the registered services. The Applicant argued that the services designated in class 35 are similar, complementary or closely linked to the goods designated by the mark applied for. The GC decided that the Applicant's arguments did nothing to challenge the assessment made by the Board of Appeal and the Appeal was dismissed in its entirety.

Significant factors

Significant factors in this case are the unorthodox wording of the specification covered by the earlier mark and the practice peculiar to Spanish national law relating to slogan marks. In a case in which wording is unclear, the onus is on the party to put forward its best case to explain the protection afforded by that wording. On specific points of practice under national law, it is unsafe to assume that OHIM is familiar with such practices or that OHIM will investigate such practices of its own accord. ■



Pocket points

Lisa Ormrod details the findings of the Court in this European case

This report concerns a ruling by the Court of Justice of the European Union (CJEU) on whether use of a registered trade mark through another composite mark or in conjunction with another mark constitutes genuine use for the purpose of Article 15(i) of Council Regulation No 40/94 (now Article 15(i) of Council Regulation No 207/2009).

Background

Levi Strauss & Co (“Levi”) is the proprietor of a multitude of trade marks, including German Registration No DD 641 687 for a pocket with a red tab on the upper left-hand seam displaying the word LEVI’S and Community Registration No 2292373 (registered on the basis of acquired distinctiveness) for a pocket with a plain red tab protruding from the upper left-hand seam. The first mark, referred to by the Court as “Mark No 3”, covers trousers, shirts, blouses and jackets for men, women and children. The second mark, covering trousers, was referred to by the Court as “Mark No 6”. Both registrations are more than five years old.

Levi sought to prevent Colloseum Holding AG’s (“Colloseum”) sale of trousers with small, rectangular, red tabs on the upper part of the outer-right seam of the right rear-pocket displaying its own brand names.

Happily for Levi, the referring court (the German Bundesgerichtshof) found there to be a likelihood of confusion between Mark No 6 and Colloseum’s trousers, which avoided the need to overcome the impact of the differences between the brand names on the basis of Mark No 3. However, as keen denim wearers will know, Levi always displays the LEVI’S word mark on the red tab in the form of Mark No 3. Because Mark No 6 differs from Mark No 3 in elements that alter the distinctive character of the mark, Levi could not rely on Article 15(2)(a) of Regulation 40/94 to prove use. To seek clarification in relation to use of a registered mark as part of a composite mark, the referring court chose to refer two questions to the CJEU.

Is Article 15(i) of Regulation 40/94 to be interpreted as meaning that:

- 1) a trade mark that is part of a composite mark and has become distinctive only as a result of the use of the composite mark can be used in such a way as to preserve the rights attached to it if the composite mark alone is used?
- 2) a trade mark is being used in such a way as to preserve the rights attached to it if it is used only together with another mark, the public sees independent signs in the two marks and, in addition, both marks are registered together as a trade mark?

CJEU answers

The fact that Mark No 6 had been registered on the basis of acquired distinctiveness played a major role in the CJEU’s decision, with many references made to the HAVE A BREAK decision (C-353/03, *Société des Produits Nestlé SA v Mars UK Limited* [2005] ECR I-6135). It has long been established that a sign can be registered on the basis of acquired distinctiveness as a result of its use as part of a registered trade mark, or in conjunction with the registered trade mark only, provided that use of the sign on its own would be capable of enabling the relevant class of persons to perceive the goods or service as originating from a given undertaking.

In this case, the evidence of acquired distinctiveness filed by Levi, showing use of the red tag in conjunction with the LEVI’S word mark, had been found to be sufficient



proof that consumers identified the plain red tag as an indication of origin.

The CJEU found that the HAVE A BREAK principle ought to apply equally in relation to genuine use of a registered trade mark, provided the registered trade mark used only as part of a composite mark or in conjunction with another mark continues to be perceived as an indication of origin of the goods or services concerned. As a result, the CJEU answered the questions referred to it in the affirmative.

Fair finding

This is a fair and rational decision that will be pleasing news to brand owners who wish to protect individual aspects of their branding and get-up. It would be difficult to comprehend how a particular use would be sufficient to acquire trade mark protection yet insufficient to preserve that protection. Following this decision, it would be wise for brand owners in Colloseum’s position to attack the validity of the registration on the basis that it should never have been granted protection in the first place. ■

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Case in point: O/147/13 concerning Opposition numbers 72160 and 72161 by Tonyson's Trade Links (Overseas) Limited and Revocation Application number 83853 by Naturex, Appeal from a decision of Oliver Morris dated 27 October 2011, UK IPO, 8 April 2013

Balance tilts away from Tonyson's

The need for professional advice was highlighted, says Amanda McDowall

The Appointed Person ("AP") has emphasised the importance of the timely submission of evidence in proceedings, and the rare circumstances in which an appeal court will consider fresh evidence that has not been considered at first instance. In addition, this decision is yet another reminder of the advantages of seeking professional trade mark advice before the UK IPO.

The revocation action concerned UK Trade Mark Registration 2042736 NAT in class 3, in the name of Tonyson's Trade Links ("Tonyson"), filed in 1996. This registration was the basis for oppositions against two trade mark applications for NAT SELECT and NAT PROTECT, covering goods in classes 3 and 5 in the name of Naturex. During opposition proceedings, Naturex challenged the validity of the earlier NAT registration on the basis of non-use, and also filed an application for the revocation of Tonyson's earlier registration. As the issue of genuine use was important to both proceedings, the Hearing Officer dealt with this first.

Evidence

The Director of Tonyson, Mr Hamalis, who acted without professional representation, submitted a witness statement, asserting that the mark had been used in relation to all of the goods covered by the UK trade mark registration. Several letters from suppliers and a UK agent were exhibited in addition to the witness statement. Naturex challenged the sufficiency of this evidence and the matter was discussed at a case management conference. Hamalis did not file any further evidence on the grounds that Naturex was a competitor and that the information was commercially sensitive.

The Hearing Officer considered the evidence that had been submitted and deemed it insufficient to demonstrate that the mark as registered had been genuinely used in the relevant periods,

as the evidence did not show whether or how the mark had been presented to the public or the range of goods on which the mark had been used. The revocation action was therefore accepted.

Appeal

Tonyson appealed this decision on the basis that it had, since the decision, taken proper advice from a Trade Mark Attorney. No further evidence was lodged and no formal application to submit fresh evidence was made.

The AP invited Tonyson to submit further evidence for consideration and a further witness statement was filed. The AP considered whether it would be appropriate to grant Tonyson permission to adduce this fresh evidence.

The AP considered the relevant case law of *Du Pont* [2003] EWCA Civ

'The Hearing Officer considered the evidence that had been submitted and deemed it insufficient to demonstrate that the mark as registered had been genuinely used'

1368, *Ladd v Marshall* [1954] 1 WLR 1489 and *Wunderkind Trade Mark* [2002] RPC 45. The AP distilled the guidance from these cases, deeming the following considerations to be relevant:

- 1) Difficulties in obtaining fresh evidence.** Hamalis argued that he had to obtain the evidence from the company's accountants in Cyprus, which had taken time. However, as he had stated in the case management conference that he wouldn't provide further evidence on the basis that it was of a commercially sensitive nature, the AP did not accept this as a valid argument – especially since Hamalis had been made aware that the evidence that he had originally submitted was not sufficient.
- 2) Whether the evidence would have an important influence on the outcome**

of the case. The additional evidence contained some turnover figures that were relevant, but they were only in respect of medicated soap, and for only some of the years for which the information had been requested. The AP deemed that the evidence had narrow scope, but was still not greatly significant.

- 3) Whether the fresh evidence is believable.** While the evidence

contained errors there was no reason to doubt its authenticity. Although several thousand sales per year was arguably sufficient to demonstrate that the mark had been used in relation to medicated soap, the evidence failed to show that the mark had been used in relation to any other products.

- 4) The potential prejudice to the other party.** Naturex would be prejudiced in the event that the fresh evidence was taken into account, as it would affect the outcome of the opposition based on the NAT mark.

The AP considered that on balance there were more arguments in favour of not accepting the further evidence. Despite the evidence being of some validity it was refused and the appeal was dismissed. ■

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Case in point: T-353/11, Event Holding GmbH & Co v OHIM, CJEU, General Court, 21 March 2013

Non-event for German firm

Similarity doesn't always signal confusion, reports David Kemp

In 2008 a German company, Event Holding GmbH & Co ("Event"), opposed a Community Trade Mark (CTM) application for the figurative mark **EVENTER**, **EVENT MANAGEMENT SYSTEMS** in classes 35 and 41 ("the opposed Application"). The Opposition was based on a German national registration for the word **EVENT** registered in class 43 for "development of hotels, hotels, restaurant services, temporary accommodation". Event relied on Article 8(i)(b) of Council Regulation (EC) 40/94, now Council Regulation (EC) 207/2009 ("the Regulation"), but the Opposition Division rejected the Opposition in March 2010 having decided that the services covered by the respective signs were dissimilar.

In May 2010, Event appealed the decision to the OHIM Second Board of Appeal and its case was dismissed. Event filed a further appeal with the General Court of the Court of Justice of the European Union, which was also dismissed.

Similarity of signs

The Board of Appeal held that the respective signs were of low visual similarity given the common element **EVENT**. The addition of **ER** and **EVENT MANAGEMENT SYSTEMS** and the two vertical line devices either side of the words were sufficient to ensure that the signs should not be seen as any more similar. The Court agreed. It also agreed with OHIM that the signs were phonetically similar. It was accepted that the words **EVENT MANAGEMENT SYSTEMS** would probably not be pronounced by the relevant public.

The Court again sided with OHIM in ruling that there was some conceptual similarity between the respective signs. **EVENTER** could be construed by the German public as being associated with **EVENT**, particularly as **EVENTER** was followed by the words **EVENT MANAGEMENT SYSTEMS**.

However, the similarities between the signs were insufficient for there to be a likelihood of confusion, even though the Court decided that the terms "business management" and "business administration" in class 35 of the opposed Application were similar to "development of hotels" in class 43 of Event's earlier right.

Relevant public

The Court's analysis of what was the relevant public was crucial to this last determination. The Court held that the majority of services on which registration was based were aimed at German professionals and not the general German public as Event had claimed. It is accepted that members of the general public pay less attention when choosing goods or services than professional people seeking specialist goods or services. It is also accepted that a consumer's level of attention will vary according to the relevant goods or services.

The Court confirmed the Board of Appeal's decision that all the services in class 35 and services relating to "arranging and conducting exhibitions" in class 41 covered by the opposed Application, and "development of hotels" in class 35 covered by Event's earlier right, were targeted at professionals with a high level of attention.

The Court set out some useful comments on its thinking. In summary:

- "Developments of hotels" - services targeted at entrepreneurs wanting to make investments in that activity.
- "Business management; business administration; office functions services" - such services are used by entrepreneurs or by persons engaged in a liberal profession.
- "Organisation and conducting of exhibitions and events services" - services performed by professionals whether for commercial, advertising or for cultural, educational, amusement and sports purposes. The general public are more likely to take part in such events than to organise or conduct them.

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- "Advertising and publicity of texts" - performed by professionals and directed at professional undertakings, rather than the general public.
- "Wholesaling, commercial retailing and selling via global computer networks of computer hardware and software" - such services are normally used by those who create computer hardware or produce software and offer it for sale.

Evidence admissibility

The Court also considered Event's attempt to adduce new annexes, internet print-outs and decisions of the German Courts in support of its contention that "operation of hotels" protected by its earlier right were similar to services covered by the opposed Application. While documents not presented before OHIM were inadmissible, further submissions would be accepted.

This case highlights the point that even when signs and goods or services are similar, the public is a key factor in determining whether confusion will exist. A finding of similar signs and similar goods or services is not a guaranteed finding of confusion. ■

Case in point: T-505/10, Höganäs AB v OHIM, CJEU, General Court, 10 April 2013

Making the grade

How high is the bar for coexistence?
This case gives a guide, writes Louise Goodsell

This case is useful to practitioners as it reminds us that the bar for proving that two marks coexist on the market in an attempt to support that there is no likelihood of confusion (in the context of an opposition at OHIM) is high. It also gives us examples of the type of evidence that doesn't make the grade, and reminds us that even if coexistence were appropriately evidenced it would not necessarily be decisive in a finding of no likelihood of confusion.

The Applicant, Höganäs AB ("Höganäs"), applied to register ASTALOY as a Community Trade Mark (CTM) in respect of "Iron-based metal powders for industrial use" in class 6. This was opposed on the basis of an earlier CTM for HASTELLOX covering goods in class 6. The opposition ground was a likelihood of confusion (Article 8(i)(b) Council Regulation EC No 207/2009, "CTMR").

At first instance, the Opposition Division, having found genuine use of the earlier mark on an least some of the goods, held there was a likelihood of confusion between the marks. Höganäs claimed that it had demonstrated that the marks coexisted on the marketplace and that there was, therefore, no likelihood of confusion.

Höganäs appealed first to the Board of Appeal and then subsequently to the General Court ("Court"). The most relevant and pertinent discussion in the Court's decision is, in my view, the one regarding the place of coexistence in the likelihood of confusion assessment and the evidence that Höganäs submitted to support its claim.

Höganäs had mustered what appeared to be an impressive case. It had its own sales figures for its mark for the period in various Member States, and the evidence submitted by the Opponent (for his proof of use) for sales

under his mark. Höganäs supplemented this with articles and presentations from specialist journals, exhibitions and conferences. It also included affidavits from a former employee and a consultant in the field of powder metallurgy supporting the view that consumers of such products were aware of both marks and not confused.

The Court noted that coexistence of the marks on the market is a potentially relevant circumstance in the likelihood of confusion assessment, but that there are significant caveats.

A previous decision had held that (emphasis added): "the possibility that the coexistence of earlier marks on the market could reduce the likelihood of confusion found to exist can be taken into consideration *only if, at the very least...* the applicant for the Community Trade Mark has *demonstrated to the requisite legal standard that such coexistence was based upon the absence of any likelihood of confusion...*"

The Court noted two key evidential requirements.

- 1) Territorial breadth. Given the likelihood of confusion being presumed across the European Union (as the earlier mark is a CTM), the coexistence of the marks must be shown across the whole EU.
- 2) Temporal breadth. For two marks to be deemed to coexist, it is essential that they be present together on the market

over a sufficiently long period before the filing date of the CTM.

However, where Höganäs fell down (perhaps not surprisingly) was in the need to show not only that the marks had coexisted but that "the evidence produced indicates clearly that such coexistence was based upon the absence of any likelihood of confusion between those marks". Thus, it had to "adduce conclusive evidence that the consumers of the products covered by each of the marks at issue did not confuse them prior to" the filing date.

The Court felt the Höganäs affidavits did "not constitute sufficient evidence of the fact that the coexistence of the marks at issue was based on the absence of any likelihood of confusion between the marks for the products in question. There are only two such affidavits, neither of which come from one of the consumers of the products at issue."

And then to drive home the overarching point, the Court noted that "even if such coexistence between the trade marks at issue were to be established, it would not in itself be sufficient to establish an absence of a likelihood of confusion", as that assessment "requires all relevant factors be taken into account, factors which include not only the coexistence of the marks at issue, but also the similarity of the marks and the products." ■

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Birmingham will host ITMA's annual Autumn Seminar

Date	Event	Location	CPD hrs
23 July	ITMA London Evening Meeting* Case management in the IPO Allan James, IPO	Royal College of Surgeons, London	1
12 September	ITMA Edinburgh Talk Certification marks - a case study on Harris Tweed	Burness Paull & Williamsons, Edinburgh	1
17-20 September	MARQUES Annual Conference	Monte Carlo	
24 September	ITMA London Evening Meeting* Copyright and Design Update David Fyfield, Charles Russell LLP	Royal College of Surgeons, London	1
2-5 October	FICPI 14th Open Forum	Sorrento, Italy	
3-4 October	CIPA Congress 2013	Lancaster London Hotel, London	Up to 11
10 October	ITMA Autumn Seminar*	ICC Birmingham	5
29 October	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
7 November	ITMA Glasgow Talk Brand protection for Glasgow Commonwealth Games 2014 and IP considerations in the Scottish independence debate	Brodies, Glasgow	1
12 November	ITMA Webinar		1
26 November	ITMA London Evening Meeting* CJEU and General Court Update Désirée Fields and Hiroshi Sheraton McDermott Will & Emery	Royal College of Surgeons, London	1
5 December	ITMA Edinburgh Talk Co-existence agreements: the risks and how best to avoid them A round-up of key IP developments in 2013	Pinsent Masons LLP, Edinburgh	
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