

SLOGAN  
PROTECTION  
FLORIAN TRAUB p8

TRADE SECRETS  
REGIME EXAMINED  
JENNIFER PIERCE p12

FIGURING OUT  
COSTS CHANGES  
SIMON MILES p18

CANADA'S TM  
ARGUMENT  
CYNTHIA ROWDEN p21

# ITMA REVIEW

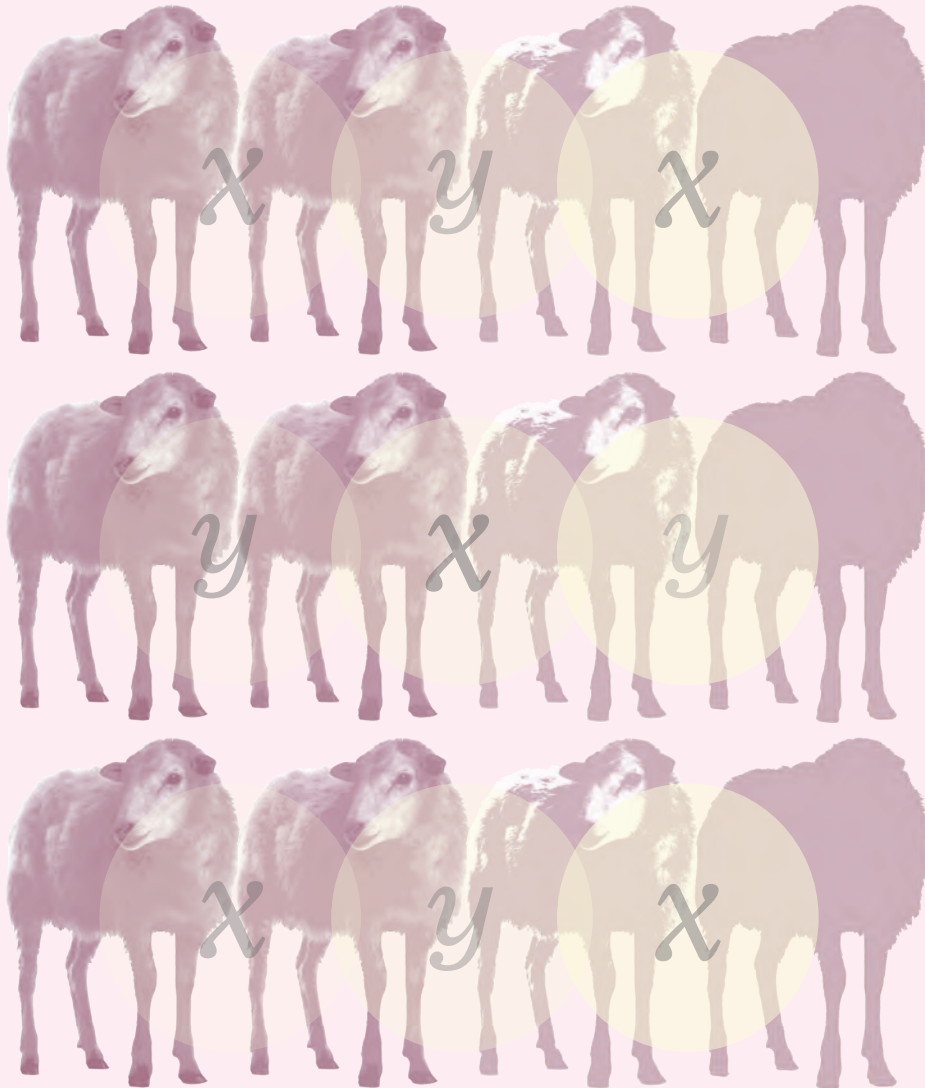
THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

Issue **416** March/April 2015 [itma.org.uk](http://itma.org.uk)



QUIZ NIGHT  
WINNERS p6

EVENTS p41  
TM20 p42



## How to manage multiples

AN INTERNATIONAL PERSPECTIVE ON SERIES MARKS p14





# OUT OF



## THOMSON COMPUMARK PROTECTS 9 OUT OF 10 OF THE WORLD'S MOST VALUABLE BRANDS

It's a fact, more than 90% of Interbrand's Best Global Brands entrust their trademark protection to us. Every day Thomson CompuMark helps thousands of trademark and brand professionals around the world launch, expand and protect strong brands.

If the world's most respected brands trust us, shouldn't you?

Source: Interbrand Best Global Brands 2013, Top 100



THOMSON REUTERS™

[TRADEMARKS.THOMSONREUTERS.COM](http://TRADEMARKS.THOMSONREUTERS.COM)

# welcome

March/April 2015



## ITMA contacts

### General enquiries

ITMA Office, 5th Floor, Outer Temple,  
222-225 Strand, London WC2R 1BA  
Email: [tm@itma.org.uk](mailto:tm@itma.org.uk)  
Tel: 020 7101 6090

### Committee chairs

**Executive:** Catherine Wolfe,  
[wolfe.itma@boulton.com](mailto:wolfe.itma@boulton.com)

**Events:** Maggie Ramage,  
[maggie@ramage.co.uk](mailto:maggie@ramage.co.uk)

**Education:** Philip Harris,  
[pharris@st-philips.com](mailto:pharris@st-philips.com)

**Law & Practice:** Imogen Wiseman,  
[i.wiseman@cleveland-ip.com](mailto:i.wiseman@cleveland-ip.com)

**Publications & Communications:**  
Richard Goddard,  
[richard.goddard2@uk.bp.com](mailto:richard.goddard2@uk.bp.com)

### Published on behalf of ITMA by:

Think, Capital House, 25 Chapel  
Street, London NW1 5DH  
Tel: 020 3771 7200  
[www.thinkpublishing.co.uk](http://www.thinkpublishing.co.uk)

**Editor:** Caitlin Mackesy Davies

**Advertising:** Dalia Dawood,  
[dalia.dawood@thinkpublishing.co.uk](mailto:dalia.dawood@thinkpublishing.co.uk)

**Group Account Director:** Polly Arnold

**Account Manager:** Kieran Paul

**Senior Designer:** Clair Guthrie

**Designer:** Alix Thomazi

**Senior Sub-editor:** Rachel Kurzfield

## 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 Helene Whelbourn by email at [h.whelbourn@novagraaf.com](mailto:h.whelbourn@novagraaf.com) and Caitlin Mackesy Davies at [caitlin@thinkpublishing.co.uk](mailto:caitlin@thinkpublishing.co.uk)

The views expressed in the articles in the Review and at any ITMA talk or event are personal to the authors, and do not necessarily represent the views of the Institute. ITMA makes no representations nor warranties of any kind about the accuracy of the information contained in the articles, talks or events.

© ITMA 2015



I am pleased to present the latest issue of the *ITMA Review*, which sees us all now well into another year of trade marks and life in general. In this issue, we cover the protection of online slogans, which you must read – in fact, JUST DO IT.

We also look at changes to Canadian trade mark law that appear likely to simplify it, or at least bring it closer to trade mark practice on this side of the pond, but which have been somewhat controversial. Among the other content,

there is a feature on series marks, which is a one-off and not itself part of a series.

And once you have edified and educated yourself by reading the above, you can enjoy the photos of the recent ITMA charity quiz night.

**Chris McLeod**  
ITMA President

## Inside this issue

### Regulars

**04 ITMA Insider** OHIM Observer status awarded, diversity, member moves and more

**41 Events** Diary dates for ITMA members

**42 The TM20** Responses from a currently calm Ordinary Member Sarah Talland

### Features

**06 ITMA Charity Quiz** Winners celebrated and a chance to test your wits

**08 Marketing** Florian Traub on how to best provide cover for slogans online and off

**12 Trade secrets** Jennifer Pierce evaluates the new EU regime for protecting confidential information

**14 Series** Thomas Hooper provides a multi-jurisdictional perspective on how to manage multiple marks

**18 Costs management** Simon Miles sums up the significant changes in this area

**21 Canada** Cynthia Rowden outlines the arguments resulting from the alterations to the country's trade mark legislation

### Case comments

**25 O/476/14** Carrie Bradley explains why a composite mark will be revisited

**26 T-53/13** The Court did not see distinction of a Vans device, says Charlotte Blakey

**28 T-506/13** The Court backed the Intervener, reports Katharina Barker

**29 T-524/11; T-525/11** John Colbourn feels that some tension surrounds this Volvo appeal decision

**30 T-484/13** Rachel Conroy describes the dissent that arose from a proposed cosmetics mark

**31 T-450/09** Nina O'Sullivan puzzles out the decision in the Rubik's Cube case

**32 T-556/12** Caspar Rebling reflects on balance in exercising statutory discretion

**33 T-240/13** It is all too easy to be caught out on a technicality, warns Rosalyn Newsome

**34 T-75/13** The Court does not need to provide specifics to Boehringer, writes Verity Ellis

**35 T-272/13** Laura Mackenzie-Mitchell clears up the thought processes in a Max Mara decision

**36 [2014] EWHC 3963 (Ch)** Jonathan Thurgood examines a decision that emphasised the work of a UK entrepreneur

**38 [2014] EWCA Civ 1403** John Coldham outlines the arguments that meant Interflora would rise again

**40 [2014] EWHC Civ 1439** Natasha Hybner explains why two established businesses were believed able to coexist in the same arena

The logo features a large blue dot above the word "Insider" in a bold, blue, sans-serif font. The letters "ITMA" are positioned above the "I" in a smaller, lighter blue font.

# ITMA Insider



## Joining forces on diversity

At a round table forum in late January, ITMA joined a number of other groups representing those in the IP professions in agreeing a joint statement of intent on diversity in the IP professions, which reads as follows:

“We are committed to making the IP professions more inclusive. We believe that there is value, not only to the professions and their individual members, but also to the IP system as a whole and its users, in ensuring that the IP professionals of the future encourage, embrace and sustain a more diverse workforce.

We will work together to ensure that for all those who have the necessary aptitude, regardless of their age, gender, race, sexual orientation, religion, physical ability, wealth or background, the IP professions are:

- **welcoming**
- **accessible**
- **respectful**
- **supportive**

We will encourage the IP professionals within our organisations to adopt best practices for securing increased diversity and inclusion. We will collaborate to train and support IP professionals in such practices, and to raise awareness of relevant issues. We will take a firm stance against any form of unlawful, unfair or otherwise inappropriate discrimination, whether during recruitment to the IP professions or in the working environment.

Following the round table meeting on 27 January 2015, we will commit to a range of joint initiatives aimed at achieving the above outcomes and improving diversity throughout the IP professions.”

### Signatories:

The Chartered Institute of Patent Attorneys (CIPA)  
ITMA  
The IP Federation  
The UK Association of the International Federation of Intellectual Property Attorneys (FICPI-UK)

## ITMA given Observer status at OHIM

We are delighted to announce that at the November 2014 session of OHIM's Administrative Board and Budget Committee (ABBC), ITMA was appointed an Observer to the Committee's meetings. This will work on a rotational basis between User Groups and, therefore, ITMA will assume the position in 2018. We echo OHIM's certainty that our participation and positive involvement alongside all other Observers will enhance further the interaction between all the OHIM stakeholders and positively contribute to strengthening the European Trade Mark and Design Network.

*Our participation alongside all other Observers will enhance further the interaction between OHIM stakeholders*





## ITMA Open Meeting and AGMs

We'd like to invite all members to attend the **ITMA Open Meeting on 25 March**, which will be held at Charles Russell Speechlys in London. The meeting will be a chance to learn about our achievements as an organisation over the past year, activities of the Institute and our application for Charter. The AGMs of the ITMA Benevolent Fund, and ITMA's own AGM directly follow and are open to all Corporate Members (Fellows and Ordinary Members). And what better way to end such activities than with a drinks reception and canapés in the evening! Go to [itma.org.uk/calendar/](http://itma.org.uk/calendar/) for further details.

## IP investigation firm rebrands

**B**ishop Group, the corporate investigations business, has announced the rebranding of its IP arm Farncombe International Ltd. The company has been officially renamed Bishop IP Investigations Ltd. The business, which was originally named after the street in Worthing, West Sussex, on which it was located, will continue to operate from the town.



## Member *moves*



[Mark Holah](#), former partner and head of the trade mark and brand protection group at Field Fisher Waterhouse, joined the London office of leading international IP practice Bird & Bird. With more than 20 years of IP experience, [Mark will play an integral part in the growth of the firm's successful brand management practice.](#)



[Sara Leno](#) joined Trademark Eagle as Trade Mark Attorney in December. She can be contacted at [01223 208624](tel:01223208624) or on email at [sara.len@trademarkeagle.co.uk](mailto:sara.len@trademarkeagle.co.uk).

## In memoriam: Paul Anthony Thomson

8 May 1941 to 13 June 2014

ITMA member since 1977; CPA; EPA;  
Royal Society of Chemistry since 1963;  
Chartered Chemist



Paul Anthony Thomson was born and raised in Wallasey, Wirral. He received his chemistry degree from Aberystwyth University. He was married to Sandra and had two daughters, Rachel and Helen. Paul always wanted

to pursue a career in trade marks and patents and, after training and qualifying at the Patent Office in London, he joined Potts Kerr and Co Patent Agents in Birkenhead, Wirral. He was passionate about chemistry and his work, and thoroughly enjoyed the varied and interesting places it took him – including Canada, Germany, Japan and the US – and particularly the people he met along the way. He prided himself on personal service and also had a keen sense of humour, colleagues report that this ensured he always made an impression. He particularly enjoyed his annual attendance at the International Trademark Association conferences, which provided a chance to put faces to the many names he had dealt with over the year.

Paul remained with the firm his entire career and progressed to partner before his enforced retirement aged 64 after being diagnosed with bowel cancer. He recovered fully after surgery and used his new-found free time to support his beloved Everton Football Club and spend time with his family. With some tutoring, he embraced digital communications and kept in touch with his patent and trade mark colleagues via email. He really enjoyed the window this continued to give him into the world in which he had been such an integral part for his entire working life.

In 2013, Paul was diagnosed with acute myeloid leukemia but never lost his sense of humour or love of life. He defied the odds a second time after contracting pneumonia in July 2013. He enjoyed another eight months of quality time with his family, including several holidays to his daughter's home on the coast, where he did considerable research in his quest for the perfect bacon butty.

*Contributed by Helen Thomson*

To contribute to a remembrance book established for Paul Thomson, send your tribute to [hthomson@btinternet.com](mailto:hthomson@btinternet.com)

# The Ding Dongs dig deepest

Urquhart-Dykes & Lord took the top prize at our annual brain-buster



01



02



03



04



05



06

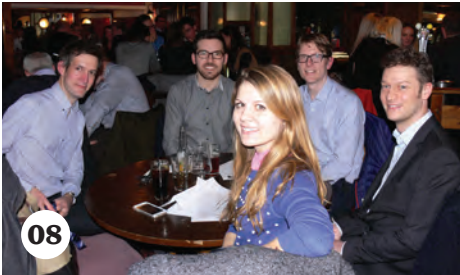


07

## WHAT'S YOUR SCORE?

Pit your wits against some of the evening's questions

- 1 What colour is an orange blossom?
- 2 The Snickers bar was named after what type of family pet?
- 3 Which British Sunday newspaper was the first to include a crossword?
- 4 What colour is the "e" in eBay?
- 5 How many people were aboard Noah's Ark?



08



09



10

01) The Gare Bears of Greenberg Traurig get busy 02) ITMA President Chris McLeod presents the trophy to UDL's team leader 03) A jubilant winning UDL team, whose chosen charities will receive half of the £1,675 raised. ITMA's Benevolent Fund will also benefit 04) JA Kemp's Top Marks failed to live up to its name 05) Quizmaster Steve James 06) Dehns' Distinctive Characters 07) Redd Solicitors' The Increddibles 08) Abel & Imray's Brand of Brothers 09) The BP Ultimates, front-runners at half time 10) Withers & Rogers' entry Bill & Ted



Relief in dealing with  
administrative tasks  
is only a step away

Dennemeyer & Associates has developed a notably reliable and easy procedure to undertake **IP recordals** with utmost diligence.

**Your benefits:**

- Precise and transparent cost estimates provide an authoritative forecast
- Single point of contact eases the process and reduces your involvement
- Expert know-how and a streamlined workflow secure fast register updates worldwide
- Ready for signature powers of attorney and assignment deeds for all jurisdictions



Contact us now to learn more about your benefits:  
[info@dennemeyer-law.com](mailto:info@dennemeyer-law.com)  
[www.dennemeyer.com/recordal-services/](http://www.dennemeyer.com/recordal-services/)



**DENNEMEYER**  
& ASSOCIATES



# TAKE COVER ©

*Avoid exposure to infringement from online slogans  
by following the advice of Florian Traub*



## *Advertising agencies who add ambiguity or word-play to their slogan will give trade mark professionals much better arguments to overcome a possible objection*

**T**he internet has established itself as a significant marketing and sales tool for trade mark owners across the world. The value of online sales in the UK accounted for 11.5 per cent of all retail sales between November 2013 and November 2014, according to the Office for National Statistics, while online sales increased by 12.9 per cent. It is, therefore, not surprising that brand owners increasingly target the online market with campaigns whose success often depends on a memorable slogan.

However, brand owners should be aware of the risks: what makes a successful advertising slogan attractive to them also makes it attractive to those looking to trade off the rights of legitimate owners or to participate in the success of competitors' brands. It is, therefore, vital to protect online slogans as early as possible.

### **Minelfield**

Registering a slogan as a trade mark is, however, not easy to navigate. Despite the attempts of the Court of Justice, other courts and trade mark registries to provide guidance, it is still difficult to predict, even for experienced trade mark advisers, whether a slogan can be successfully registered.

At least the legal framework is well known. According to the Trade Marks Directive (2008/95/EC, "TMD") and Trade Marks Act 1994 (TMA), a trade mark may consist of any sign capable of being represented graphically,

provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. However, a mark cannot be registered if it has no distinctive character or if it consists exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services for which registration is sought.

In a case concerning the slogan DAS PRINZIP DER BEQUEMLICHKEIT (meaning "the principle of comfort"), the Court of Justice of the European Union (CJEU) confirmed that there is no reason for applying a stricter criterion to the registration of slogan marks than other kinds of marks.<sup>1</sup> Indeed, the CJEU later clarified in its leading case concerning the Audi slogan VORSPRUNG DURCH TECHNIK (meaning "advance or advantage through technology"), that an advertising slogan cannot be required to display "imaginativeness" or even "conceptual tension which would create surprise and so make a striking impression" in order for such a slogan to be distinctive.<sup>2</sup>

Furthermore, the mere fact that a mark is perceived as a promotional formula and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient in itself to support the conclusion that a slogan mark is devoid of distinctive character.<sup>3</sup> The fact that a slogan can be understood both as a promotional formula and as an indication of the commercial origin of goods or services is not enough to render it devoid of distinctive character.<sup>4</sup>

### **Practice principles**

But what does the above case law mean in practice? From the perspective of brand owners, trade mark registries perhaps too often reject the registration of slogans with the formula that the relevant public's perception is not necessarily the same in relation to slogans<sup>5</sup> and that the slogan in question solely conveys a laudatory statement that is incapable of distinguishing the goods and services as to their commercial origin. Yet, brand owners can do much to improve the prospects of successfully registering their online slogan, by taking the following principles into account from an early stage of developing a new online campaign:

- **Keep it succinct.** A shrewd, fanciful and/or succinct slogan is more likely to proceed to registration than a descriptive slogan. Advertising agencies who add ambiguity or word-play to their slogan will give trade mark professionals much better arguments to overcome a possible objection. If the slogan's meaning is vague, difficult to understand, or requires interpretation by the targeted consumers, an examiner will find it hard to attribute a specific meaning to the slogan in relation to the services applied for.
- **... but not simple.** Conversely, slogans that are composed of a grammatically correct combination of words with a clear laudatory meaning in relation to the goods and services in question have no real prospect of being accepted as a word mark. →

## Additional insight

The following decisions can offer an insight to brand owners as to the level of distinctiveness required in order for such a mark to be accepted by UK IPO or OHIM.



1 • Coca-Cola Company's appeal against the refusal of its UK application for NO HALF MEASURES,<sup>8</sup> the Appointed Person deemed the mark had "a certain originality or resonance", which made it easily memorable in relation to the entertainment services specified. The average consumer would have to interpret the causal link with the specified sporting activity services in order to understand it and there was an "element of unexpectedness" with regard to educational services due to the mark being "atypical of marketing speak". The appeal was allowed.



2 • A UK application for GOOD HAIR DAY, EVERY DAY<sup>9</sup> was refused for hair products, and associated products, as well as services in classes 38 and 41. Referring to Audi, the Appointed Person stated that the mark was unlikely, in the mind of the average consumer, to have the quality of having multiple meanings, being a play on words, or being imaginative, surprising and unexpected, because "the phrase 'good hair day' is one that is already firmly entrenched and understood". Furthermore, the addition of EVERY DAY "simply amplifies... the permanence of effect". The slogan did not possess the required distinctiveness to function as a trade mark.



3 • O2 Holdings Ltd's application for the mark WE'RE BETTER, CONNECTED was partially refused by the IPO Hearing Officer in respect of classes 38 and 39, and some of the goods and services in classes 9, 35, 41, 42 and 45.<sup>10</sup> The application was accepted for services in classes 36, 37, 43 and 44. The Hearing Officer held that the mark was particularly transparent when used in relation to telecommunications goods and services, and a motivational statement to reinforce the personal benefits of being connected to others. Taking guidance from Audi, the mark did not exhibit any linguistic imperfection, peculiarity, inventiveness or other creative element to allow it to function as a trade mark in respect of the refused goods and services.



4 • The General Court upheld OHIM's decision to reject Deutsche Bank's EU designation for PASSION TO PERFORM<sup>11</sup> on non-distinctiveness grounds as it would be perceived as a laudatory statement consisting of grammatically correct English words that convey a clear message that Deutsche Bank will "perform with passion" and does not require interpretation by the relevant consumer in relation to the services in classes 35, 36, 38, 41 and 42.



5 • OHIM's Second Board of Appeal upheld the decision that the relevant consumer would perceive the slogan SERVE WITH LIBERTY as nothing more than a laudatory expression that describes the specified charitable services.<sup>12</sup>



6 • The decision of OHIM's Second Board of Appeal to uphold the decision not to invalidate the mark WET DUST CAN'T FLY<sup>13</sup> for goods and services in classes 3, 7 and 37 was based on the concept of 'wet dust' being fanciful, and the idea of dust 'flying' being exaggerated. Despite conveying an objective message, the mark possessed originality and resonance, and would set off a cognitive process in the mind of the relevant consumer.<sup>14</sup>



7 • OHIM's First Board of Appeal dismissed the appeal by Novartis AG relating to its application to register the mark CARE TO CARE<sup>15</sup> for educational and medical services. The mark was considered to be a banal expression, which the relevant public would perceive to be designed to promote or advertise, rather than to indicate commercial origin of the specified services.



8 • WE RESTORE, YOU RECOVER was accepted following an appeal to OHIM's Second Board of Appeal.<sup>16</sup> The mark was not considered to consist exclusively of a sign that designated the services in question, namely carpet cleaning services (among others). The play on words of the secondary clause YOU RECOVER is a surprising, unexpected linguistic trick, and the inversion of the subject from 'we' to 'you', as well as the alliteration of the letter 'R' afford the mark distinctive character.

*Adding distinctive graphic elements to a non-distinctive term has been described, with justification, as 'a figurative fig leaf of distinctiveness'*

- **Create a combo.** Combining a slogan with a distinctive word or graphic will make the application most likely to be registrable. While such a registration will still serve as a deterrent against possible infringers, the trade mark owner may find it difficult to enforce its rights. This is because the courts or registries may disregard the slogan element in the overall assessment of the composite mark, and reject a claim of a likelihood of confusion.<sup>6</sup> Adding distinctive graphic elements to a non-distinctive term has, therefore, been described, with justification, as “a figurative fig leaf of distinctiveness”.<sup>7</sup>
- **Get the registry right.** In general terms, the chances of obtaining registration may be higher at the UK IPO than at OHIM, mainly for three reasons: first, the practice of conducting telephone or video conference hearings before the UK IPO means that the trade mark applicant has *ex parte* a better forum for presenting arguments than in written proceedings. Second, the UK examiner will only object to slogans that have a clear and unambiguous meaning in a language that is understood by the public in the UK. Therefore, slogans in a language spoken or understood in many other EU Member States have a better chance of being accepted than before OHIM. Finally, the trade mark applicant will find that, in most cases, it is easier to overcome a rejection issued by the UK IPO on the basis of acquired distinctiveness through use than in proceedings before OHIM.
- **Use time wisely.** As indicated above, in cases where the trade mark registries maintain the refusal of the application in relation to the inherent distinctiveness of the slogan mark, it may be possible to proceed to registration on the basis of the

distinctiveness that the mark has accrued because of the brand owner’s use of the slogan. For example, Audi’s “Vorsprung durch Technik” was eventually only registered as a Community Trade Mark on the basis of acquired distinctiveness. Since this path to registration requires significant use over a substantial period of time, this option will not be available to newly developed online advertising campaigns.

### Eyes wide open

Having overcome the many hurdles of registering an advertising slogan, brand owners may be tempted to stay away from further legal challenges. However, they are well-advised to monitor the use of the marks by third parties, be it offline or online. Otherwise, they risk the most important benefit of a trade mark registration, ie the monopoly right to use the slogan for their own commercial purposes.

Successful advertising campaigns are quickly exploited by competitors, particularly in the fast-moving online world. It is, therefore, crucial to challenge any unsanctioned use of a slogan so the phrase does not become commonplace and retrospectively lose its ability to serve as an indication of commercial origin. The cancellation of the registered trade mark may be the end result. A number of service providers will very efficiently monitor the internet and advise of online trade mark infringements. A less expensive option is to frequently enter one’s own slogan into search engines to

check search results and contextual advertisements. While it may seem too burdensome and costly to pursue all infringers, the investment pays off – not least because infringers realise that the brand owner will not allow them to persist in their illegal activities.

- 1) OHIM in Erpo Möbelwerk GmbH, Case C-64/02 P, DAS PRINZIP DER BEQUEMLICHKEIT, paragraph 32.
- 2) Audi v OHIM, Case C-398/08 P, VORSPRUNG DURCH TECHNIK, paragraph 39; see also Smart Technologies v OHIM, Case C-311/11 P, WIR MACHEN DAS BESONDERE EINFACH (meaning ‘we make special [things] simple’), paragraph 28.
- 3) Audi v OHIM, Case C-398/08 P, paragraph 44; Smart Technologies v OHIM, Case C-311/11 P, paragraph 29.
- 4) Audi v OHIM, Case C-398/08 P, paragraph 45; Smart Technologies v OHIM, Case C-311/11 P, paragraph 30.
- 5) Cf. Audi v OHIM, Case C-398/08 P, paragraph 37.
- 6) Cf. decision of OHIM’s Grand Board of Appeal, Case R 1462/2012-G, ‘ULTIMATE GREENS/ULTIMATE NUTRITION (Fig. Mark) et al.’, paragraph 59.
- 7) Mr Justice Arnold in 1.Starbucks (HK) Ltd & Ors v British Sky Broadcasting Group plc & Ors [2012] EWHC 3074, at paragraph 117.
- 8) Case O-079-10 Coca-Cola Company’s Appeal at paragraphs 38, 39 and 59.
- 9) Jemella Limited v UK IPO, Case O-292-14 paragraph 18.
- 10) O2 Holdings Limited v UK IPO, Case O-246-10 paragraphs 20, 21 and 25.
- 11) Deutsche Bank AG v OHIM, Case T-291/12 paragraph 48.
- 12) Liberty Mutual Insurance Company v OHIM, Case R 2215/2013-2 paragraph 27.
- 13) Cf. decision of OHIM’s Second Board of Appeal, Case R 211/2012-2 Pro-Aqua International GmbH v Rexair LLC paragraph 21.
- 14) The decision was appealed to the General Court, Case T-133/13.
- 15) Novartis AG v OHIM, Case R 953/2012-1 paragraph 23.
- 16) Rainbow International Carpet Dyeing & Cleaning Company v OHIM, Case R 2197/2011-2 paragraphs 16 and 24.



#### Florian Traub

is a Partner at Squire Patton Boggs (UK) LLP  
[florian.traub@squirepb.com](mailto:florian.traub@squirepb.com)

Harry Rowe, Trainee Trade Mark Attorney at Squire Patton Boggs,  
 co-authored the article. [harry.rowe@squirepb.com](mailto:harry.rowe@squirepb.com)



# Safe and sound?

*Jennifer Pierce evaluates some of the strengths and potential areas of weakness of the new EU regime for protecting confidential information*

12

**R**ecent reports on the current protection of confidential information within the European Union vary, depending on the jurisdiction of the writer, but they all reach the same conclusion: current protection is inadequate in the majority of EU territories.

In some, there is limited protection (most notably Cyprus and Malta), but elsewhere there are problems regarding the adequacy of remedies and potentially damaging disclosures that are required in the course of proceedings. The European Commission has, therefore, proposed a directive to partially harmonise the protection of confidential information within the EU, while including measures intended to safeguard against abuse of the new system.

It is clear that some Member States favour greater protection, while others fear abuse. Broadly, English laws are among the most protective, and the writer heard evidence given to the Commission by one multinational to the effect that it is preferable to conduct research in the UK as a result. The Commission's first

proposal was for full harmonisation, which would have created a level playing field, but would have weakened some existing protection. So, the current proposal is a diplomatic compromise, which creates a system within which there will potentially be various applicable laws to consider in cases where there is cross-border breach of confidence.

## What is covered

The Commission chose the definition of confidential information in TRIPS as its starting point, and with this comes another potential snag. According to Article 2, a trade secret refers to information that meets all the following requirements:

- (a) is secret in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question;
- (b) has commercial value because it is secret;
- (c) has been subject to reasonable steps under the circumstances by the person lawfully in control of the information, to keep it secret.

The first two limbs of that definition are basic requirements of the English law of confidence, and they also reflect the EU's Technology Transfer Block Exemption Regulation. Under English law, a variant of the requirement in the third limb may arise in the context of an action against a former employee who is using information obtained from a former employer after employment has ceased, but it is not a general prerequisite for protection.

It is worth noting that the first limb covers what is sometimes known as a mosaic, ie a collection of information from different sources, where individual components may be in the public domain, but the collection is not. That said, it is still subject to the second limb.

Recital 8 includes an important clarification: "Such definition should exclude trivial information and should not extend to knowledge and skills gained by employees in the normal course of their employment and which are generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question."



*The current proposal is a diplomatic compromise, which creates a system within which there will be various applicable laws to consider*

#### The extent of the prohibition

The protection would cover “acquisition, use or disclosure” of a trade secret without the consent of the “trade secret holder” (Article 3). The description of “acquisition” relates to physical objects, including electronic files. All other information is covered by a general category of “any other conduct which, under the circumstances, is considered contrary to honest commercial practices”. It is clearly a key provision that will need to be clarified by case law.

While there is no substitute for the eventual judgment, the note to Article 39 of the TRIPS Agreement may be of some assistance in this regard, although it would introduce an element of circularity. It states that “a manner contrary to honest commercial practices” shall mean “at least practices such as breach of contract, breach of confidence and inducement to breach, and includes the acquisition of undisclosed information by third parties who knew, or were grossly negligent in failing to know, that such practices were involved in the acquisition”.

“Use and disclosure” (Article 4) includes unlawful acquisition, breach of confidentiality agreement, “any other duty not to disclose the trade secret” and “any other duty to limit the use of the trade secret”, in each case without the consent of the trade secret holder. With the exception of

the breach of contractual duty, they will all need to be clarified by case law so, until that time, it is best to impose contractual duties of confidence to achieve certainty. The duty attaches to a person who knowingly deals in information that has been acquired as a result of a breach. Similarly, dealing in “infringing goods”, which benefit from the breach of confidence, also constitutes breach.

#### Exceptions

Reverse engineering is permitted without limitation, in respect of products or objects in the public domain or which are lawfully acquired without a prohibition on “reverse engineering.” (Note, however, that this is subject to the provisions regarding reverse engineering in the Software Directive – 2009/24/EC.) There is also an exception for “any other practice which, under the circumstances, is in conformity with honest commercial practices”, another area in which clarification is required. There are further exceptions for: (1) compliance with EU and national laws; (2) freedom of expression and information; (3) whistle-blowing; (4) trade secrets disclosed by workers to their representatives as part of the legitimate exercise of their representative functions to the extent necessary for that exercise; and (5)

protecting a legitimate interest recognised by EU or national law. The exceptions are among the mandatory safeguards against abuse, which must limit existing national laws.

#### Limitation

There is a maximum limitation period of six years (Article 7).

#### Proceedings and remedies

Remedies and procedures must be fair and equitable and “not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays”. Again, this is mandatory, and it is another area that will require judicial interpretation. Indeed, some of these issues could be highly contentious in view of the very different judicial processes within the EU.

Permanent and interim injunctions are available as well as seizure and delivery up, but there is also provision for guarantees “intended to ensure the compensation of the trade secret holder” as an alternative to a preliminary injunction.

#### Timing

It is hoped that the Directive will be adopted by the third quarter of this year, and that there will be compliant legislation in Member States at least 24 months after that.



#### **Jennifer Pierce**

is a Partner at Charles Russell Speechlys  
[jennifer.pierce@crsblaw.com](mailto:jennifer.pierce@crsblaw.com)



# How to manage multiples

*Thomas Hooper provides an international perspective on protection of series marks*

14

**I**f you were to ask any UK trade mark attorney what is the most common question asked by clients, it may be: “How can I protect all the different variations of my mark in the broadest possible way?”

However, depending on where you need to protect the mark, the avenues available vary widely and what seems to be the most straightforward answer may not be the best.

In the UK, one avenue for protecting multiple versions of a mark is through an application for a series mark, which allows trade mark owners to secure multiple registrations through a single application. This, for obvious reasons, has universal appeal. Yet, being able to use these provisions assumes that the distinctive character of the marks presented is essentially the same, differing only by elements of insignificant or minor distinction.

The position outside the UK is more complex, as few countries have

provisions for the protection of more than one version of a trade mark in a single application, with the result that inconsistencies in cross-border registration can leave trade mark owners confused as to the best options available to protect their brand. This exploration into managing multiple trade marks in three important jurisdictions will, hopefully, provide a useful guide to some key principles.

## **UK: moving market?**

In the UK, the provisions on series marks means applicants will be able to protect between two and six variations of the same mark – with one single application – provided the group falls within the statutory definition of what constitutes a series under Section 41(2) Trade Marks Act 1994. This requires the marks to: “Resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.”

It is no longer possible to divide an application for a series of marks into multiple applications should an objection arise that the marks do not constitute a series, but you can delete marks from the application.

The UK offers an established line of authority on the subject of series registration and trade mark owners have not shied away from filing such marks, although these authorities come from the Appointed Persons at the UK IPO rather than from jurisprudence of national or Community courts.

The most useful guidance can be found in LOGICA (BL O/068/03) in which Professor Ruth Annand set out the following criteria for a series of marks to be acceptable:

- i) The marks must resemble each other in their material particulars;
- ii) The marks must differ only in respect of matters of non-distinctive character, and;
- iii) The marks must not differ in ways which do not substantially affect the identity of the marks.

**FIGURE 1: UK SERIES MARKS – SUCCESSFUL**

<ol style="list-style-type: none"> <li>Chartered Institute of Horticulture</li> <li>Chartered Institute of Horticulture</li> </ol> <p>Trade Mark No. 3066111</p>	<ol style="list-style-type: none"> <li>PRESSIDIUM</li> <li>PRESSIDIUM</li> </ol> <p>Trade Mark No. 3071810</p>	<ol style="list-style-type: none"> <li>Physiocentric</li> <li>Physiocentric</li> </ol> <p>Trade Mark No. 3071469</p>
<ol style="list-style-type: none"> <li>pinnygirls</li> <li>pinnygirls London</li> </ol> <p>Trade Mark No. 3071810</p>	<ol style="list-style-type: none"> <li>Fruitful</li> <li>Fruitful Saving</li> <li>Fruitful Mortgages</li> </ol> <p>Trade Mark No. 3068919</p>	<ol style="list-style-type: none"> <li>SCARECROW BIO-ACOUSTIC</li> <li>SCARECROW BIO-ACOUSTIC 180</li> <li>SCARECROW BIO-ACOUSTIC 360</li> </ol> <p>Trade Mark No. 3074190</p>

Source: Trade Mark Journal No. 2014/043, 17 October 2014

**FIGURE 2: UK SERIES MARKS – UNSUCCESSFUL**

<ol style="list-style-type: none"> <li>financial ear</li> <li>investment ear</li> <li>insurance ear</li> </ol>	<ol style="list-style-type: none"> <li>Growright</li> <li>Gro Wright</li> </ol>	<ol style="list-style-type: none"> <li>SUSAN JEFFIELDS</li> <li>Susan Jeffields</li> </ol>
--	---	--

Source: IPO Manual of Trade Marks Practice

In practice, all visual, aural and conceptual differences must not substantially affect the identity of the earlier mark(s) in the series. Slight variances can exist, provided these are non-distinctive. This means that series registration can be used for multiple colour variations of the same mark, or when a distinctive house brand (KODAK, for example) is combined with individual descriptive terms (such as FILM or LENS). If device logos differ only by weak stylisation or typography, they may also be accepted together.

Figure 1, above, shows a selection of recently published UK series marks and illustrates the types of marks that are acceptable as a series.

In contrast, Figure 2 includes examples of marks that are not acceptable as a series in the UK. These examples demonstrate that in order for a series registration to be successful, there must be a high degree of homogeneity between the

marks. This is for the Examiner to judge based on the view of the average consumer and the alternations between the marks.

The ability to protect a series will, therefore, vary depending on the level of attention and common traits of the average consumer of the goods or services claimed (see Digeo Broadband BL O/305/03, Gateway BL O/322/03 and F500 BL O/138/06). For example a series application for the marks KODAK FILMS and KODAK LENS may be accepted for cameras and related goods, but will not be worthy of registration for goods or services that have nothing to do with photography.

So, while a series registration does reduce registration and renewal costs, and can help marketing departments in the initial stages of brand or product development, it is always worth considering whether the distinctive element of a mark should be protected in its own right.

Finally, the UK has a long history and an established position with regard to series marks and so would seem to offer a stable environment for making decisions on such marks. However, changes to the rules around these marks do occur from time to time depending on decisions issued on borderline cases. Debates on whether series marks conflict with EU laws on harmonisation could also bring into question whether they will survive forever.

### India: finding its feet

Although Indian law follows UK law quite closely to some degree, the practice of filing series marks is still in its infancy. For those approaching India's market from a UK perspective, a number of differences between practices can lead to confusion.

In the UK, the number of marks that can comprise a series is limited to six and, once filed, a series application cannot be divided into ➔

applications for separate marks if they are found not to constitute a series. In contrast, India allows for any number of marks to be filed as part of series. It is also possible to divide an application into separate marks at any time prior to publication, at the discretion of the Examiner.

In India, the essential requirement to qualify for registration as a series is that the differences in the marks should be only in respect of non-distinctive matters, such as size or colour.

Whether a series application will be accepted for registration depends heavily on the type of mark being applied for, ie if it is a word or logo. The Registry will generally object to a mark when the series application comprises word marks. A series containing a device or stylised marks is generally accepted without serious objection, unless the marks are descriptive or non-distinctive.

Finally, if the applicant is able to prove use of one of the marks, this is sufficient to prove use of all the marks in the series (as associated trade marks).

In common with the UK, an applicant that is able to secure a series registration in India broadens its rights from both a defensive and enforcement perspective. Each mark in the series is individually enforceable in its own right. If a third party uses or attempts to register a mark that is confusingly similar to just one of the variations, the owner will be in a better position to object than if it had registered just one version of the mark with less similarity overall. Applicants also

benefit from the obvious reduced costs and complexity, as just one application needs to be filed and then, later, renewed.

However, because the concept of series marks is still relatively new in India, there are some issues that should be considered before filing. Although it is possible to file for any possible number of marks as part of the series, and in multiple classes, attempting to register more than five marks as part of the series is usually discouraged; the Registry often fails to publish all of the marks at once, and so additional costs are not uncommon at this stage.

It is also worth considering whether to file a multi- or single-class application for the series. If a multi-class series application is filed and later challenged in any single class, the application is barred in all classes until the issue is resolved. Filing single-class series applications may expedite registration for the uncontested goods or services.

In summary, series registration in India is an efficient time- and cost-saving strategy for applicants wishing to claim rights to several trade marks that are closely related. Because series registration is a relatively new tool, however, there are no established precedents or guidance into the registration procedure or scope of protection granted, particularly from the Supreme Court of India.

### US: alternate option

There are no series provisions in the United States. A trade mark application may seek to register

only a single representation of a mark. So, the applicant must carefully consider the distinctive and protectable elements of its brand and how it intends the marks to be used in commerce.

However, when an applicant seeks a US registration for a mark with changeable elements, the filing strategy will depend heavily on the element subject to change. Under US trade mark law, some elements of a mark may be changeable without affecting registrability or enforcement of the associated rights. For example, when a mark will be displayed in a variety of colours, it is generally recommended that the mark be filed in black and white; this would, under US practice, protect all colour variations.

If the owner then goes on to use the mark in a different form to that protected, for example by incorporating changeable elements, problems can arise.

One crucial consideration for US registrations is the use requirement; US applicants are required to show actual use of the mark in commerce in order to obtain registration. Similar evidence of use is also required during maintenance and renewal of the registration. The US Patents and Trademark Office (USPTO) will refuse an application where the use of the mark is a “material alteration” to the overall commercial impression of the original mark.

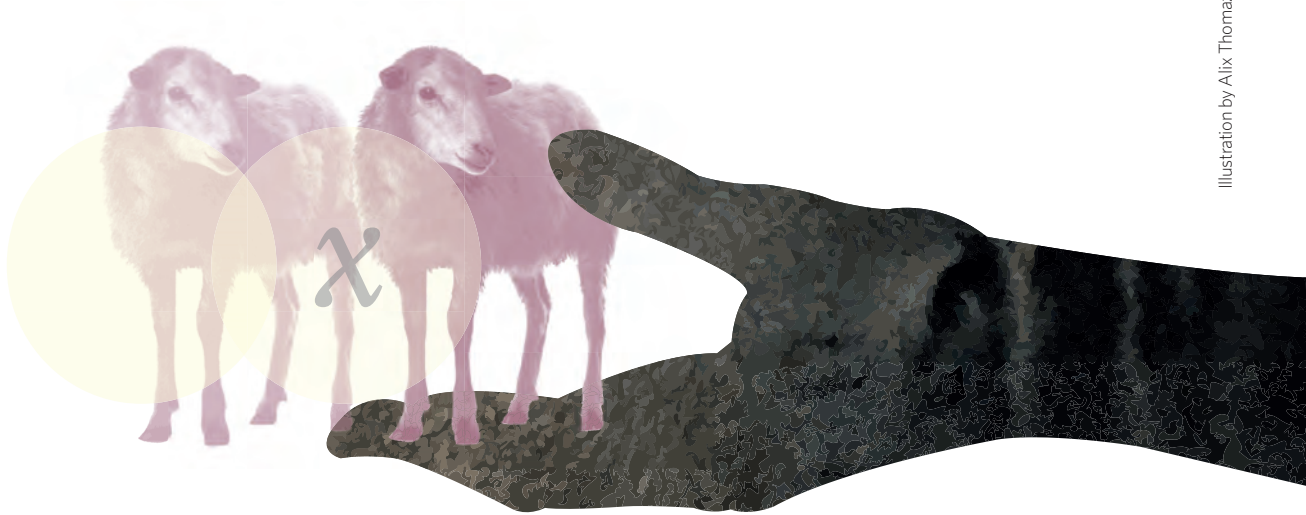
If a registration can be secured for a particular version of a mark, such as a distinctive word mark or logo, and this is then used in combination with a descriptive or generic term, it is difficult to predict what elements the USPTO will deem generic or descriptive. A registration could be removed if the mark in use is not materially the same as that which is protected.

Similarly, registering a highly distinctive mark such as KODAK but using it in connection with a generic term (KODAK FILM or KODAK LENS, for example), would likely be sufficient to support registration/renewal of the KODAK mark.

In that example, the KODAK element creates its own commercial impression apart from KODAK FILM or KODAK LENS.

*Depending on where you need to protect the mark, the avenues available vary widely and what seems to be the most straightforward answer may not be the best*





To avoid a refusal due to the differences in the marks (“mutilation” of the mark), best practice is that trade mark owners display the additional terms not covered by the registration in a different font or on a separate line. This strategy helps to ensure that the marks create a distinct commercial impression apart from the additional terms not covered by the registration.

**Summary considerations**

Does the availability of series registrations improve the situation for those wishing to protect multiple marks? Certainly, series registration is an available and useful tool to many applicants in the UK and India.

Nonetheless, the relative infancy of the Indian provisions means that waters are still being tested as regards their practice and the actual scope of protection. Meanwhile, in the UK, a mature system should offer stability, yet the potential tightening of the rules to date is a reason to tread cautiously. It is, therefore, debatable how much series provisions actually enhance a trade mark owner’s rights.

Accordingly, it is useful to consider whether alternative strategies are available that will protect the distinctive element of the marks and the multiple variations. This will, of course, be case-specific, but registering only the distinctive element may, in fact, provide sufficient protection, particularly when it comes to word marks that will be used in combination with other non-distinctive and descriptive words.

***INFRINGEMENT AND SERIES: VIEW OF THE UK COURTS***

UK trade mark owners that have secured a series registration can rely upon these in infringement proceedings. This matter was recently addressed by The Hon Mr Justice Birss in *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch), which confirmed the approach taken by Roger Wyand QC in *Comic Enterprises Ltd v Twentieth Century Fox Film Corp* [2014] EWHC 185 (Ch) (the Glee case).

In both cases it was confirmed that: “When faced with a series mark it is necessary to bear in mind that there is only a single registered trade mark. All the instances in the series are manifestations of the same mark.” This means that in order to assess the alleged infringement of a series of marks, the UK courts will first identify exactly what the single mark is. This will require the marks to be assessed in isolation.

In the *Thomas Pink* case, the series of marks relied upon (shown below) were held to include a box and a background colour outside of the word PINK. As the background colour within the box in each mark in the series was different, this could be of any colour.



**Trade Mark No. 2565078**

Rather than interpreting each mark in the series separately and assessing the correlation between each of the marks and the alleged infringement, the UK courts will look at the series mark as a single registered sign. This way, the courts are able to make a single point of comparison between the registered signs and the sign that is alleged to infringe.

The view of the courts demonstrated in these cases, may give further reason for UK trade mark owners to consider protecting only the distinctive elements of the sign, rather than filing a series application for all variations of that mark.



**Thomas Hooper**

is a Trainee Trade Mark Attorney at Baker & McKenzie LLP  
[Thomas.Hooper@bakermckenzie.com](mailto:Thomas.Hooper@bakermckenzie.com)

Thomas wishes to thank Gunjan Paharia (Managing Director, ZeusIP) and Justin Welch (IP Associate, B&M Dallas) for their contributions to this article.

**T**he past two years have been a busy time for those concerned with costs in trade mark litigation cases. In the High Court, the Jackson reforms, which came into force in April 2013, have heralded the biggest changes to how parties must conduct High Court litigation since the Civil Procedure Rules replaced the old Rules of the Supreme Court in 1999. For those involved with smaller cases, recent times have been no less remarkable. The re-constituted Patents County Court (now the Intellectual Property Enterprise Court (IPEC)) introduced a costs-capping regime, which, together with the new streamlined procedure, has made it the forum of choice for lower-value IP disputes.

## Jackson

The reforms put forward by Lord Justice Jackson were intended to be “a coherent package of interlocking reforms, designed to control costs and promote access to justice”. They are certainly wide reaching:

### CFAs/ATE premiums

From April 2013 the attractiveness of Conditional Fee Agreements (CFAs) to claimants has been diminished, with parties no longer being able to claim either the success fees or the After the Event (ATE) insurance premium from the other side. In have come Damages Based Agreements (DBAs), which allow the successful party’s lawyer to be paid an amount equal

to up to 50 per cent of any damages that are awarded.

### Costs management

Ensuring costs are proportionate is at the heart of the reforms. They are considered proportionate if they bear a reasonable relationship to:

- The sums in issue in the proceedings;
- The value of any non-monetary relief in issue in the proceedings;
- The complexity of the litigation;
- Any additional work generated by the conduct of the paying party;
- Any wider factors involved in the proceedings, such as reputation or public importance.

One of the main ways this is achieved is through costs management. What this means in practice is that in all cases commenced after 1 April 2013, both parties must file and serve a costs budget that sets out their anticipated costs at each stage of the proceedings, up to – and including – trial. The form for these budgets is Precedent H, which must be signed off by a senior legal representative with a statement of truth.

The parties have an obligation to try to agree their budgets, but ultimately it is for the court to approve the budgets at the cost management conference (CMC). Experience so far appears to indicate that this is placing a larger administrative burden on the courts and has led to long waits for CMCs to be listed, and cases being delayed. This may, however, improve as both the courts and the parties become



# Go figure

*Recent Evening Meeting speaker Simon Miles sums up the significant changes that have occurred in the area of costs management*



*Costs budgeting needs to be taken extremely seriously by the parties. Its potential impact on litigation is huge*

more experienced in dealing with costs budgeting.

Costs budgeting needs to be taken extremely seriously by the parties. Its potential impact on litigation is huge. Parties will not be able to recover significantly more than their approved budgets unless developments in the litigation warrant such increases and where those increases are approved by the court or agreed between the parties. Failure to pay close attention to costs, to prepare sensible budgets and to review and update them regularly will, therefore, lead to a significant shortfall between what a successful party can recover from the unsuccessful party and what it must pay its legal advisors.

#### Relief from sanctions

The Jackson reforms also heralded an important change in the way that the courts dealt with the question of relief from sanctions, for example for non- or late compliance with a procedural step. The amended rules stress the need to deal with cases in a just manner, to take account of proportionate cost and to enforce rule compliance.

This approach probably reached its high-water mark in the now infamous case of *Mitchell v News Group Newspapers* [2013] EWCA Civ 1537, when the Conservative MP Andrew Mitchell was prevented from claiming any more than court costs ➔

in his high-profile defamation dispute with News Group Newspapers because his solicitors filed his costs budget a few days late.

Subsequently, the Court of Appeal has retreated from Mitchell and in three joined appeals heard together in July 2014 (*Denton v TH Ltd* and another, *Decadent Vapours Ltd v Bevan* and others, and *Utilise TDS Ltd v Davies* and another [2014] EWCA Civ 906) set out the following three-stage test for the courts to adopt when considering applications for relief from sanctions:

- Stage 1 – Identify and assess the seriousness of the non-compliance. Is the breach “serious or significant”?
- Stage 2 – If it is serious, why did the default occur?
- Stage 3 – Consider all the circumstances of the case in order to deal with the application “justly”, including (a) the need for litigation to be conducted efficiently and at proportionate cost and (b) the need to enforce compliance with rules, directions and court orders.

As a result of these new rules, it seems clear that trivial breaches will not be punished, but that if parties wish to escape the consequences of more serious breaches then they will need to demonstrate good reasons why they occurred.

## IPEC


IPEC is not subject to the costs management regime now in place in the High Court. Instead, it has its own costs-capping regime, in place since October 2010 with maximum costs of £50,000 and £25,000 available for the liability and quantum stages of the proceedings, respectively.

### New rules

Recent changes have increased the maximum costs allowed at each stage for cases commenced or transferred into IPEC after 30 September 2013, while leaving the overall caps unchanged. The updated rules have also taken Court fees outside of the cap and the caps do not apply on costs incurred pre-transfer, where there is an abuse of process or a certificate of contested validity.

### Exceeding the cap

The principles on which the Court will approach costs assessments in



*If parties wish to escape the consequences of more serious breaches then they will need to demonstrate good reasons why they occurred*

IPEC have remained largely unchanged from the early cases of *Westwood v Knight* [2011] EWPC 11 (general approach to assessment of costs) and *BOS v Cobra* [2012] EWPC 44 (approach when not all issues are decided in one party's favour). More recent cases have underlined the warning given in *Westwood* that only in rare and exceptional cases will the Court exceed the cap on costs. In *Henderson v All Around the World Recording Ltd & Anor* [2013] EWPC 19 the Court did not feel that a serious imbalance between the financial resources of the two parties took the case into exceptional circumstances. Similarly, in *Brundle v Perry* [2014] EWHC 979 a letter that Mr Brundle had represented as coming from the Judge and some colourful language from Mr Brundle

did not justify exceeding the cap. The Court did, however, indicate that the circumstances in which it would contemplate exceeding the cap for individual stages needed to be less exceptional than the circumstances that would be required to exceed the cap overall.

### Multiple defendants

IPEC has also taken a similarly robust approach to the cap on costs in cases in which there were multiple defendants, indicating that such cases would not justify each defendant seeking a separate £50,000 costs limit (*Liversidge v Owen Mumford Ltd* [2012] EWPC 40) – even in circumstances in which the defendants had been separately represented or raised different defences – or allow the claimant to claim a separate £50,000 worth of costs against each defendant (*Gimex International Groupe Import Export v Chill Bag Co. Ltd* [2012] EWPC 34).

### Part 36

Also noteworthy is the Court's approach to Part 36 offers. It has confirmed that the rule stipulating that costs are assessed summarily at the end of a trial applies equally where a Part 36 offer has been accepted (*PPL v Hamilton* [2013] EWHC 3967). It has also made it clear, in *Abbot v Design & Display & Anor* [2014] EWHC 3234, that there is no reason why it should not apply the new Part 36.14(3)(d), which is designed to encourage defendants to accept claimant Part 36 offers by penalising those who do not accept such offers and then fail to do better at trial. This rule, brought in by Jackson, allows the Court to order the defendant to make an additional payment of 10 per cent of the damages awarded and IPEC has ruled that such a payment is neither costs nor damages so can be ordered in addition to the damages and costs caps in place.



### **Simon Miles**

is a Registered Trade Mark Attorney, Solicitor and Partner in the IP team at Edwin Coe LLP. [simon.miles@edwincoe.com](mailto:simon.miles@edwincoe.com)

**Nick Phillips**, a Solicitor and Partner in the IP team at Edwin Coe LLP, also spoke at the Evening Meeting and co-authored this article. [nick.phillips@edwincoe.com](mailto:nick.phillips@edwincoe.com)



# A use-less argument

*Cynthia Rowden outlines changes to trade mark legislation that have provoked widespread protest from Canada's IP practitioners*

**C**anada's slow and steady approach to changing its IP laws took a turn in 2013 and 2014, with unprecedented – and very surprising – changes to the Trade-marks Act, as well as other IP statutes. Many changes were precipitated by international trade negotiations (following hot on the heels of Government announcements to pursue a Canada-Europe trade agreement and a consequential commitment of best efforts to have Canada join the Madrid Protocol, the Singapore Treaty and the Nice

Agreement), but the most surprising amendment relates to the elimination of use as a trade mark registration requirement, and the implied impact this will have on trade mark clearance, filing requirements and enforcement.

Changing directions from a system based totally on use to one in which use is not required will have long-term implications for trade mark owners and businesses operating in Canada. It is not clear that the Government fully considered these changes, since there was no advance consultation with trade mark practitioners or interested





groups, and no changes to the legislation despite widespread and consistent concerns.

The following outlines the most important changes.

### Combating Counterfeit Products Act

In answer to international complaints about the lack of effective border controls to prevent the importation or exportation of counterfeits, in 2013, the Government introduced Bill C-56, replaced by Bill C-8, the Combating Counterfeit Products Act (“CCPA”), proposing amendments to the Trade-marks Act and Copyright Act to clarify that infringement would apply not only to making and selling, but importing and exporting infringing goods. In addition, criminal sanctions were added to the Trade-marks Act. Acts of knowingly making, selling, importing and exporting infringing goods will now attract criminal sanction.

In addition, a new procedure, described as a “request for assistance”, has been created, whereby copyright and registered trade mark owners may record their

IP rights with the Minister of Public Safety and Emergency Preparedness and, specifically, with the Canada Border Services Agency, permitting Customs officials to temporarily seize suspected counterfeit merchandise and provide the IP owner with enough information to determine if the goods are counterfeit. The IP owner may then elect to commence an action, in which case the goods will remain in detention, or take no action. Detention costs, which have yet to be determined, will be borne by the IP owner if an action is started.

These were the main objections to the new measures:

- Costs of detention, if set too high, would effectively discourage brand owners from using the request for assistance procedure, especially if “bonded” warehouse detention was required. To date, there is no indication, at all, of detention costs.
- The CCPA excluded “goods in transit” through Canada to another country from the request for assistance procedure. That exclusion has been passed into law.
- There are no “quick” or summary proceedings as an alternative to an action.

- Statutory damages for trade mark infringement should have been added, to ease the plaintiffs’ costs of proving damages.

No changes were made in response to those concerns.

Parts of the CCPA came into force by 1 January 2015. The amendments related to requests for assistance provide that a fee may be required, but the Government has apparently elected to proceed without a fee (which would probably have necessitated regulations and delayed implementation of the amendments). A request form has been created but, as of the date of writing, the Canada Border Services Agency has had little experience with these new proceedings.

### Use-less trade marks

As previously explained, the most important and controversial amendment is to eliminate the requirement to use a mark in advance of registration, a change the Government claimed, inaccurately, was required for compliance with international treaties. Canada’s trade mark laws, for more than a century, have required use for both registration and enforcement.



Currently, a Canadian trade mark application must identify filing grounds, namely actual use in Canada with a named date of first use, proposed use in Canada (to be followed by a declaration of use before registration), or use somewhere, with a home country registration. The amendments permit applications with no filing grounds: only the applicant's name and address, the mark, and the goods/services must be included in the application. However, the amendments create a prerequisite to filing, namely that the applicant be entitled to use, and have used, or propose to use, the mark in Canada. Actual use before registration is not required. In addition, there is no change to the rights of registration – a registrant, even one with a registration obtained without use, would be entitled to the exclusive right to use the mark across Canada for the registered goods/services, to sue for infringement, and presumably, unless case law establishes otherwise, obtain both damages and an injunction. At the same time, despite eliminating specific filing grounds, the

Trademarks Office declared its intent to continue to examine for both inherent registrability and relative rights, and will permit oppositions based on lack of use/intent to use. Accordingly, the new system is an interesting hybrid of the Canada and United States trade mark systems that generally require “use” for registration and enforcement, and the European system, with neither filing grounds or pre-conditions, nor relative examination.

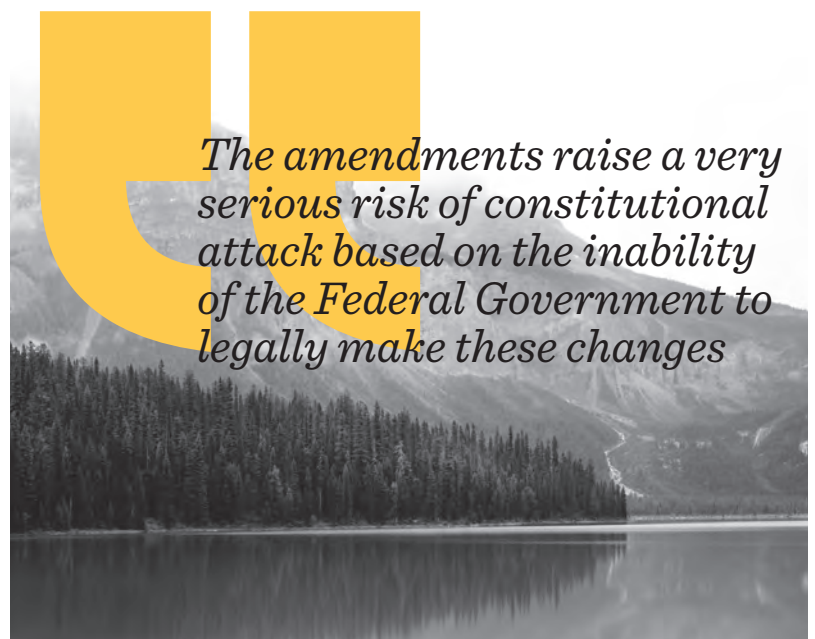
Other amendments relating to implementation of the Madrid Protocol, and other treaties, including changing the renewal term to 10 years and classification requirements, are also included in the amendments.

### Immediate reaction

Reaction was immediate and consistent. Groups including the International Trademark Association, the Canadian and American Bar Associations, and the Intellectual Property Institute of Canada, as well as major Canadian and international companies, academic research groups and trade groups including the Canadian Chamber of Commerce, and hundreds of Canadian IP lawyers and agents raised concerns about the impending clash between common law and registered rights, with concomitant uncertainty of the reaction of the courts, increased

search costs and risks, over-reaching registrations that reflect hopes and dreams v actual trade mark rights, possible piracy, and the impediments to opposition analysis caused by the lack of useful information about use.

In addition, the amendments raise a very serious risk of constitutional attack based on the inability of the Federal Government to legally make these changes. Canada's constitutional system splits law-making powers between the Federal Government and the provinces. While many areas of legislative power are specifically set out in the Constitution Act, power to make laws about trade marks was omitted. Case law has held that the Federal Government can enact laws regarding trade marks to regulate interprovincial trade and commerce, or international trade. The provinces, on the other hand, retain the power to enact laws regarding property and civil rights. Earlier decisions have found specific provisions in the Trade-marks Act dealing with acts “contrary to honest commercial usage in Canada” to be *ultra vires* the Federal Government. Scholars and trade mark experts questioned the right of the Federal Government to enact laws that create exclusive rights in trade marks in the absence of any trade or commerce. The Government merely responded that it had considered this issue. →



As Professor David Vaver wrote in *Intellectual Property Law: Copyrights, Patents, Trade-Marks, 2d* (Irwin Law, Toronto, 2011, at pages 471 to 472), reflecting the importance of use as a prerequisite to trade mark rights in Canada: "Without 'use' a trade-mark is nothing. It cannot be registered; if registered, it can be expunged. Anyone holding an unused mark probably cannot or does not want to invest in it, may just want to play dog in the manger and block competitors from using it, or may want to get into the business of selling marks, not goods or services. None of this is worth encouraging and the system treats him as an undesirable."

Canadian courts, including the Supreme Court of Canada, have echoed such views for decades. Despite briefs, submissions and letters from interested groups, no changes were made to the Bill. Government spokespersons dismissed concerns as being from self-interested lawyers, and asked why anyone would file an application if they didn't intend to use the mark.

As an observation, Canada sits halfway between China, where pirating of trade marks has reached epidemic proportions, and Europe,

benefits of registration remain with the registrant.

The amendments to the Trademarks Act from Bill C-31 were given Royal Assent in June 2014, but have not yet been proclaimed in force. Major updating to IT systems in the Trademarks Office is required, as well as a full regulatory package.

In that regard, the Trademarks Office released a discussion document regarding regulations at the beginning of October, with a two-month period (now closed) for receipt of comments. The regulations propose a new "letter of protest" procedure permitting third parties to contact the Office to object to applications during prosecution, set new filing requirements of non-traditional marks, fully implement the Madrid Protocol by regulation, set new rules for opposition deadlines, filing of opposition documents and permit the Opposition Board to manage opposition proceedings by limiting issues, evidence and deadlines. A second consultation on classification fees, likely to impact filing and renewal costs, is expected in 2015.

A certain fall-out from the system is higher search costs, since

**U** Commentators have noted the IT demands of the Madrid Protocol, as well as the need for quick examination

where that problem does not seem to be so bad. It certainly remains to be seen whether trade mark piracy will become an issue in Canada.

However, there has been growing discontent with other aspects of the European model, most specifically, the widespread registration of marks not in use, and for goods and services well beyond the interests of the owners, features that are bound to be copied under the new trade mark laws. Canadian law, unlike those in other countries, permits any party to challenge a registration for non-use after its third anniversary, providing some relief for over-reaching and registration of marks not in use, but the costs are borne by such third parties, while the

information will no longer be included in applications or registrations permitting parties to easily determine if, or for how long, marks have been used, plus higher uncertainty and risk relating to the adoption and use of both trade marks and business/corporation names. Since the constitutional concerns were widely discussed among IP lawyers, there is no doubt this issue will arise in early decisions relating

TM's IN CANADA:  
**WHAT TO DO NOW?**  
THE BEST ADVICE FOR COMPANIES  
SEEKING TO SECURE RIGHTS IN  
CANADA IS:

**Do so now, before classification fees are implemented.**

Register marks at risk of counterfeiting, to take advantage of the new "request for assistance" programme that covers only registered trademarks and copyright.

**Consider protection of marks used in Canada now, before rights are pre-empted by an applicant with no use at all.**

Ensure watch services extend to Canada to avoid third-party claims by applicants with no intent to use their marks in Canada.

to registrations secured under this new regime. Ultimately, all agree that these changes will bring more work to trade mark lawyers in Canada.

Commentators have noted the significant IT demands of the Madrid Protocol, as well as the need for quick and accurate examination. Canada's current IT capabilities for trade marks are well behind those of other countries, and examination has been chronically slow for years. Much will need to change to keep up with the demands of the Madrid Protocol. The current best estimate of implementation of the latest round of changes is late 2015 or early 2016.

The next few years will pose interesting challenges for owners of Canadian trade marks, or businesses active in Canada. With new examination criteria, and new rights that no longer depend on use, there is uncertainty about how the Trademarks Office examining branch, the Opposition Board and the courts will respond to the new laws.



### Cynthia Rowden

is a Partner and Head of Trademarks Group at Bereskin & Parr, Toronto, Canada. [crowden@bereskinparr.com](mailto:crowden@bereskinparr.com)  
Cynthia specialises in all areas of trade mark and copyright law. She is a member of INTA's Trademark Office Practices Committee.



# Pet food problem postponed

Carrie Bradley explains why a composite mark will now be revisited

**T**his matter concerned an appeal to the Appointed Person (AP) in respect of the UK IPO's dismissal of Opposition No. 104285 by the Hearing Officer, Mr M Boyle, on 5 December 2013.

The contested application (No. 2632956) was for BARKERS BREW/ barkers brew (series of two) in respect of pet foods in class 31 filed on 28 August 2012 by Barking Brew Limited, which subsequently changed its name to R2 Pets Ltd (the Applicant). The application was opposed on 27 December 2012 by Société des Produits Nestlé SA (the Opponent) under Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (the Act) on the basis of its earlier UK trade mark registration No. 2137189 for the mark BAKERS (series of 3) in class 31.

The Hearing Officer found there was a reasonable degree of visual similarity and a moderate degree of oral similarity between the marks, although no conceptual similarity. The respective goods were held to be identical and the proof of use filed by the Opponent established that the Opponent's mark had acquired a high degree of enhanced distinctiveness in the UK through use in relation to the relevant goods by the filing date of the contested application.

Despite this, the Hearing Officer found that the average consumer encountering BARKERS BREW on dog food would not bring BAKERS to mind. As such, there was no likelihood of confusion (direct or indirect) for the purposes of 5(2)(b) and the requisite link between the marks was not established for the purposes of 5(3).

The Opponent had submitted that the single element BARKERS within the composite mark BARKERS BREW retained an independent and distinctive role, such that a likelihood of confusion would still arise between the marks at issue. The Hearing Officer disagreed, finding that: BREW is not a purely descriptive word and had at least a moderate degree of distinctiveness; the average consumer would normally regard BARKERS as having a significance independent of the mark as a whole; and that the two words "hang together".

## Medion impact?

The Opponent appealed to the AP under Section 76 of the Act

*The decisive question is whether the composite mark forms a unit having a different meaning than it would were its components taken separately*

contending that the Hearing Officer wrongly interpreted/applied the Medion principle.

The AP found that the issue at hand was not so much Medion, but related to a general principle. Namely, the overall impression the Applicant's mark would have on the pet-owning public. In this regard, the AP noted that BAKERS was one of the most recognised brands on the UK pet food market and concluded that the Hearing Officer had failed to take proper account of the evidence. The AP also noted that the Court of Justice of the European Union makes it clear in *Bimbo* (*Bimbo SA v OHIM*, Case C 591/12 P, 8 May 2014, para. 25) that "hanging together" is not the determinative criterion in assessing a composite mark. Rather the decisive question is whether the composite mark forms a unit having a different meaning than it would were its components taken separately.

The AP allowed the appeal and referred the opposition back to the Registrar for a ruling by a different Hearing Officer (as per *MISS BOO* Trade Mark, BL 0/391/14, para. 26).

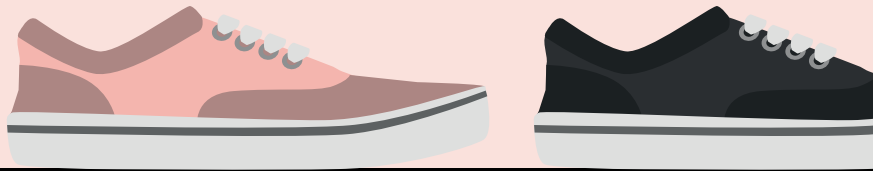


### Carrie Bradley

is a Senior Trade Mark Attorney and Head of Trade Marks & Designs at LOVEN IP

[carrie.bradley@loven.co.uk](mailto:carrie.bradley@loven.co.uk)

Carrie advises on IP protection, enforcement and dispute resolution.



# Vans stripe strikes out

The Court failed to see the distinction of the sportswear device, says Charlotte Blakey

Vans applied to register the sign shown on page 27 in classes 18 and 25 on 14 September 2011 (No. 010263838). This application was refused on 7 March 2012 on the basis of Article 7(1)(b) of Regulation (EC) No 207/2009 as the mark “consisted of a wavy line which slants and curves” and was devoid of distinctive character. Evidence submitted to show acquired distinctiveness had a number of gaps such that it was held not to be possible to ascertain the degree of recognition by the relevant public.

The appeal filed on 2 May 2012 was dismissed by the Fifth Board of Appeal (BoA) on 14 November 2012. The BoA held that the mark was devoid of any distinctive character as the average consumer would see the mark as a “concept of a wavy line”, which is too vague as a badge of origin.

Graphic line stripes are common in respect of goods in classes 18 and 25, such that the relevant public would view the mark as “exclusively ornamental”. The existence of earlier national registrations was irrelevant and evidence regarding acquired distinctiveness insufficient.

The action to the General Court (Fifth Chamber) was filed on 31 January 2013.

## The Vans arguments

### **1) Infringement of Article 7(1)**

The BoA did not take account of certain annexes, which showed that a number of device marks identified were inherently distinctive and had not acquired, despite what the BoA stated, distinctive character through use. Nor did the BoA examine the sales figures or the evidence from independent sources demonstrating acquired distinctiveness.

### **2) Infringement of Article 7(1)(b)**

The goods applied for had a number of sub-categories such that they could not be regarded as one category for which one general statement of reasons was sufficient. Also, the mark is not exclusively decorative.

### **3) Infringement of Article 7(3)**

First, evidence provided in respect of Germany, Spain, France, Italy and the United Kingdom is sufficient to prove distinctive character for the European Union as a whole. Second, evidence submitted in respect of footwear is also applicable to the other goods.

## *An affidavit by itself cannot be considered sufficient proof in demonstrating acquired distinctiveness*

Third, in the majority of the evidence submitted, the mark applied for does not have a decorative function. Fourth, its page on Facebook is relevant evidence. Fifth, evidence of the revenue generated by goods featuring the side stripe is sufficient.

### **General Court decision** **1) Infringement of Article 76(1) – rejected**

The annexes were taken into account, as shown in the appeal decision, and dismissed. Also, OHIM is not bound by previous decisions such that the registrations of earlier device-only marks are irrelevant. While the BoA erred in stating that the registrations could have been based on the acquisition of distinctive character through use, this cannot constitute an infringement of Article 76.

Additionally, a superficial examination of the evidence, which

Vans alleges the BoA carried out, even if found, does not constitute an infringement of Article 76.

### **2) Infringement of Article 7(1)(b) – rejected**

Where the same ground for refusal is given for a category or group of goods/services, a general reasoning for all of the goods/services concerned is sufficient and the class 18 and 25 goods do, indeed, form a homogenous category.

Finally, “the mark applied for does not have any characteristic element, nor any striking or eye-catching feature capable of distinguishing it from the customs of the sector and conferring on it a minimum degree of distinctive character, and enabling the consumer to perceive it otherwise than as a simple decoration”.

### **3) Infringement of Article 7(3)**

The evidence provided was insufficient to show that the relevant class of persons would be able to identify the goods covered by the mark simply because of that mark, or that they would consider the mark to be an indication of the commercial origin of the goods.

### **Comment**

The General Court rejected the action in its entirety.

It is also worth noting that the Second BoA held that Vans’ mark lacked inherent distinctiveness in relation to services (including retail services relating to footwear) in class 35 (Case R363/2013-2 Vans, Inc v OHIM decision issued on 20 August 2013). This application has since been withdrawn.

The decision reiterates that a ‘simple’ device mark will be considered inherently unregistrable and decorative unless evidence of acquired distinctiveness can be provided. This evidence will only be considered sufficient if it demonstrates that consumers consider the mark, by itself and without the need for education, to be a badge of origin for the goods and services applied for.

Further, the point was made that an affidavit by itself, particularly one that is made by an employee of the Applicant, cannot be considered sufficient proof in demonstrating acquired distinctiveness.

Therefore, filing evidence of acquired distinctiveness must be carefully thought out and not only a compilation of all documentation provided, if any, by the Applicant.

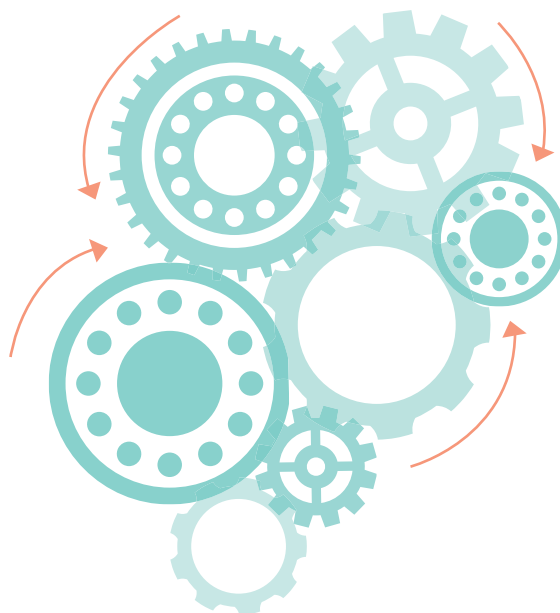
### **The Vans Figurative Sign**



### **Charlotte Blakey**

is an Associate at Keltie LLP  
[charlotte.blakey@keltie.com](mailto:charlotte.blakey@keltie.com)

Charlotte acts for clients on the filing and prosecution of UK and Community trade marks.



# Faith restored

The Court backed the behaviour of the Intervener here, reports Katharina Barker

**O**n 20 September 2013, Romanian bearings manufacturer Urb Rulmenti Suceava SA (the Applicant) brought action against a decision of the Fourth Board of Appeal of OHIM of 12 July 2013 (Case R 1309/2012-4). The decision dismissed its appeal against the Cancellation Division's rejection of its application for a declaration of invalidity against a Community Trade Mark (CTM) registration for the sign URB (word) in the name of Harun Adiguzel (the Intervener).

In support of the action in the CJEU, the Applicant claimed that the Board was wrong to find, first, that it could not file an application for declaration of invalidity; and, second, that the Intervener acted in bad faith when filing the application for registration of the mark.

The Applicant's original argument had relied upon the existence of earlier "URB" marks, which had been in use since the 1960s, when Romanian bearing production was passed from a state-owned industrial plant, CIROA, to a private company, S.C. URB – a company that subsequently registered the marks with the Romanian State Office for Inventions and Trade Marks (OSIM) and the World Intellectual Property Office (WIPO), while also authorising both the Applicant and the Intervener to continue to use the marks.

## First plea

The first plea in the present case, alleging breach of Article 53(1)(a) of Council Regulation (EC) No 207/2009 (CTMR), rested on the claim that, although the Applicant was not the proprietor of the earlier marks, it still had the authority to use them and take action against the registration of the CTM. However, this was disputed by OHIM and the Intervener, and the plea was again rejected on the grounds that the Applicant was not the proprietor of the marks, and had not been authorised by the proprietor to file an application for a declaration of invalidity.

## Second plea

With regard to the second plea, which alleged breach of Article 51(1)(b) CTMR, the Applicant asserted that all the companies authorised to use the earlier marks had the same rights and that no third party had the right to register any of the marks. However, no evidence was found that the Intervener was bound by any obligations concerning the earlier marks. In fact, the documents

presented in court suggested that the Applicant's right to use the earlier marks actually expired in 2002 (several years before the Intervener registered the CTM) following an amendment to the regulation documentation, which removed the list of authorised undertakings.

The Court pointed out that, from a commercial point of view, it was understandable that the Intervener should want to extend the protection on the URB mark by registering it as a CTM, especially as it could demonstrate turnover of goods in several Member States.

Furthermore, the Applicant's assertions of bad faith – which usually rely upon arguments such as the Intervener carrying out a registration of artificial nature or attempting to block others from entry into the marketplace by registering a mark it would not use – could not be sustained. Therefore, the Court concluded the Intervener did not act in bad faith when it filed the application for the CTM. This upheld the decision of the Board of Appeal and dismissed the case.



### Katharina Barker

is a Trainee Trade Mark Attorney at HGF Limited  
kbarker@hgf.com

# A link too far?

John Colbourn finds some tension in the appeal decision assessing a link where no similarity has been found

These cases concern two oppositions by Volvo against applications by Hebei Aulion Heavy Industries Co, Ltd for figurative marks for LOVOL (shown below), based on earlier rights in the mark VOLVO (word and figurative) for identical and similar goods.

Volvo's oppositions were based on Article 8(1)(b) (likelihood of confusion) and Article 8(5) (mark with a reputation) Council Regulation (EC) No 207/2009, but both were rejected by the Opposition Division on the basis that the marks were not "similar". The Board of Appeal upheld the decisions and Volvo appealed to the General Court. Volvo's appeal was confined to the word mark for VOLVO and the Board's rejection of the Article 8(5) ground.

## Mere coincidence

On the point of similarity, Volvo first argued that: the marks shared similar features, as both were five-letter words constructed from 'v', 'o', and 'l'; that both marks are characterised by the two syllables 'vol' and 'vo' "and/or their inversion"; and that each was pronounced as a combination of the syllables 'vol', 'vo' and 'lov', which have striking similarities.

The General Court rejected Volvo's arguments entirely. Volvo failed to put in any evidence of languages that would break the opposed mark into 'lov' and 'ol', as opposed to 'lo' and 'vol'. The Court also added useful guidance to the decisions in InvestHedge (v Hedge Invest, T-67/08) and Metromeet (v meeting metro, T-407/08) to the effect that, while in those cases the marks were "similar"

because they were composed of inversions of two identical (or essentially identical) and clearly identifiable components, what mattered was that they were combinations of words – not combinations of syllables, which otherwise have no separate meaning.

In relation to conceptual similarity, Volvo argued that consumers would "ask themselves" whether the LOVOL marks had any connection with a brand they already knew – and would think of Volvo. Volvo also relied on a scientific article about how readers recognise words, which supported its case. The Court pointed to contradictory paragraphs in the same article, dismissed Volvo's arguments on conceptual similarity and noted that it was not based on case law. Accordingly, the Court found against Volvo's appeal, stating that the condition of similarity under Article 8(5) was not satisfied.

## Connection question

Having referred to the cumulative nature of the conditions for engaging Article 8(5), the Court stated that the mere fact of coincidence of letters between the marks was "not capable of creating a connection between those signs in the minds of the public or of causing that public to establish a link between them". The Court

*Volvo argued that consumers would "ask themselves" whether the LOVOL marks had any connection with a brand they already knew*

added the coincidence of letters could not be sufficient "similarity" to engage Article 8(5).

In Ferrero (Case C-552/09 P, Ferrero v OHIM – Tirol Milch) the CJEU explained that marks must be found to be similar before a global assessment is carried out of whether a link would be made by the relevant public. Although it may not have affected the outcome in this case, the Court's consideration of a link as part of the question of similarity appears to be in tension with the approach laid down by the CJEU in Ferrero.

The marks opposed:



## John Colbourn

is a Senior Associate at Redd Solicitors LLP  
john.colbourn@redd.eu

John covers all aspects of IP and related issues, with particular focus on trade marks and copyright.

# Experts decision draws fire

Rachel Conroy describes the dissent arising from a proposed cosmetics mark

**T**he Applicant, Lumene Oy, appealed the Board of Appeal's rejection of its Community Trade Mark (CTM) designation for THE YOUTH EXPERTS for all goods covered by the application (classes 3 and 5). The CTM had been refused on examination only in relation to some goods on the grounds of lack of distinctive character under Article 7(1)(b) Council Regulation (EC) No 207/2009 (CTMR).

The Court, of its own motion (since it is a ground of public policy), raised a plea in law alleging lack of competence of the Board of Appeal; specifically that it had exceeded its powers with regard to the first sentence of Article 59 CTMR ("Any party to proceedings adversely affected by a decision may appeal") in that it had taken up afresh the examination of the CTM in respect of all goods covered by the application, when the examiner had allowed registration of the mark in respect of some of the goods.

Although the Applicant sought annulment of the examiner's decision in its entirety, in accordance with Article 59 if, as in this case, the examiner has refused a CTM only in respect of some goods, the appeal can lawfully relate only to the refused goods. The Applicant may not legitimately appeal the examiner's consent to registration of some goods (*Airbus v OHIM (NEO)*, T-236/12, paragraph 24, 3 July 2013).

Consequently, the Board of Appeal was legitimately seized of the appeal only to the extent that the lower authority had rejected the Applicant's claims.

The Court held, therefore, that the Board exceeded the limits of its powers in so far as it re-opened, of its own motion, the examination of the CTM for the non-contested goods, and it annulled the contested decision to the extent that the CTM was declared devoid of distinctive character in relation to the non-contested goods in respect of which the examiner had allowed registration.

## Distinctive character

The Court upheld the Board of Appeal's conclusion that the relevant public would not be led to perceive the mark as an indication of origin but as purely promotional information promising expertise in a particular field.

The Applicant's claim that the Board of Appeal took only one message conveyed by the mark when it conveys at least three different meanings was also dismissed. The Court held that the Board of Appeal did, in fact, take into account the various messages conveyed by the mark when it found that the mark conveyed the self-explanatory laudatory message that the goods were designed, produced or made by young experts with an extensive knowledge in the relevant field, which would reassure the consumer as to the quality of the

*This judgment reminds us of the importance of precision when filing an appeal and the need to fully substantiate any argument with evidence*

goods in question (being based on an improved formula or recently developed, for example).

The Applicant claimed that its mark held a minimum degree of distinctiveness sufficient to render the mark registrable since the link between the goods and sign at issue is too indeterminate for the mark to be regarded as being completely devoid of distinctive character. This was also dismissed by the Court because the Applicant did not adduce any evidence to substantiate the assertion, which was formulated in a vague and general way.

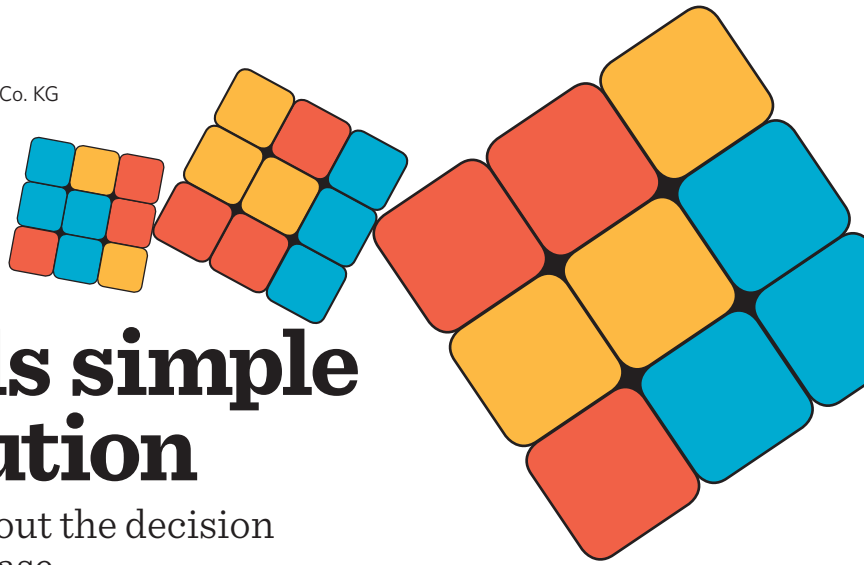
This judgment reminds us of the importance of precision when filing an appeal and the need to fully substantiate any argument, with evidence where possible.



### Rachel Conroy

is a Trade Mark Attorney at Boulton Wade Tennant  
[rconroy@boulton.com](mailto:rconroy@boulton.com)

Rachel has a broad range of experience in trade mark searching, filing strategies, prosecution and contentious matters.



# Court finds simple Rubik solution

Nina O'Sullivan puzzles out the decision in a multi-dimensional case

The Rubik's Cube, the cult toy with roughly 43 quintillion different ways to combine its colourful squares, was registered as a three-dimensional Community Trade Mark (CTM) in 1999 (see below).

In 2006, German toy manufacturer Simba Toys challenged the validity of the CTM under Article 51(1)(a) of Regulation No 40/94, now Article 52(1)(a) of Council Regulation (EC) No 207/2009 (CTMR) on the basis that the CTM was contrary to Articles 7(1)(a), (b), (c) and (e) (i), (ii) and (iii) CTMR. Following the dismissal of its application by both the Cancellation Division and the Board of Appeal, Simba appealed to the General Court.

There were a number of different strands to its appeal, all of which were rejected. This article will deal with the arguments under Articles 7(1)(e)(ii) and 7(1)(b) respectively.

## Shape of goods

The public interest underlying Article 7(1)(e)(ii) is to prevent a business obtaining a monopoly through a trade mark registration for technical solutions or functional characteristics of a product.

The Court agreed with the Board of Appeal that the essential elements of the CTM were the cube itself and the black line grid structure on each surface. It rejected Simba's argument that the black lines performed a technical function and were also the consequence of a technical function: providing the ability of individual elements of the cube to rotate.

Instead, it agreed with the Board of Appeal that the grid structure was not suggestive of a technical function.

*The Court agreed with the Board that the essential elements of the CTM were the cube itself and the black line grid structure on each surface*

The rotation of the Rubik's Cube was not due to the grid structure and lines, but was an internal mechanism that was not visible in the graphical representation of the CTM.

Accordingly, the Court concluded, the case was different to Philips (C-299/99) and Lego Juris (T-270/06) where, in both cases, the technical functions of the marks were apparent from their graphical representations; so the function of shaving was clearly apparent from the head of the razor in Philips, and assembly of toy bricks could be logically inferred from the

graphical representation in Lego. In contrast, here, it could not be inferred with sufficient certainty from the graphical representation that the cube was made up of moveable elements and was rotatable.

The Court also rejected Simba's public interest argument that the effect of registration was to confer a monopoly right against any rotating, three-dimensional puzzle. The Court pointed out that the CTM protected the shape of the cube and the grid structure, not the rotating capability.

## Distinctive character

The General Court also agreed with the Board of Appeal that the CTM was inherently distinctive, given that the cubic grid structure departed from three-dimensional puzzles already on the market.

The General Court's decision shows that, despite all the different configurations possible, the Rubik's Cube (trade mark) has a rather straightforward solution after all – subject of course to any appeal to the CJEU.

The Rubik's Cube mark



### Nina O'Sullivan

is Professional Support Counsel in the IP Department at King & Wood Mallesons LLP [nina.o'sullivan@eu.kwm.com](mailto:nina.o'sullivan@eu.kwm.com)

Vikki Leitch, a Trainee Solicitor, acted as co-author [vikki.leitch@eu.kwm.com](mailto:vikki.leitch@eu.kwm.com)

# Discretion dissection



Caspar Rebling reflects on the balance required in exercising statutory discretion

In a recent decision, the General Court annulled the Board of Appeal's decision not to suspend a Community Trade Mark (CTM) opposition appeal based on a cancellation action by the Applicant against the Opponent's earlier national right and, in doing so, fleshed out the criteria under which the Board must exercise its statutory discretion to suspend.

## The facts

Royalton Overseas Ltd (Royalton) in July 2010 applied for the CTM for the figurative sign shown below. This was subsequently opposed by S.C. Romarose Invest Srl (SC), based on its earlier (May 2010) Romanian word mark KAISERHOFF. In October 2011, the Opposition Division partially upheld the opposition.

Royalton appealed. Subsequently, the firm requested suspending the proceedings before the Board of Appeal pending a cancellation decision of the earlier Romanian mark by the national court. This request was refused and the Board of Appeal decided to reject the appeal.

In its decision, the Board did not take into account the cancellation action as: i) it was launched after the appeal had been lodged; and ii) the Board of Appeal had doubts as to the Applicant's intentions in submitting the request for suspension, particularly as the Applicant had brought other unsuccessful cancellation actions against the earlier trade mark in the same court.

Royalton appealed this decision, alleging breach of the principles of equality before the law and impartiality, in that the Board of

*The Board had only taken into account the interests of the Opponent and had failed to consider those of the other parties*

Appeal did not take into account the evidence produced in support of its request for suspension, thereby demonstrating its lack of impartiality.

## Decision

The General Court dismissed the Board of Appeal's two main reasons for rejecting Royalton's suspension request. First, the fact that a cancellation action was launched after the Appeal was not a valid reason to refuse the request. Second, the Board of Appeal erred in its assessment of the facts in concluding the third cancellation action by Royalton was launched in bad faith. The Board of Appeal failed to properly review the two earlier cancellation decisions which, in fact, resulted from formal errors and not – as assumed by the Board – substantive assessments. Therefore, it failed to exercise its duty of diligence or to examine carefully and impartially all

the relevant factual and legal aspects of the case. The Board's decision was annulled because, in exercising its statutory discretion, it had only taken into account the interests of the Opponent and had failed to consider those of the other parties.

## Final thoughts

This decision addresses a common cascade of rights scenario, the interaction between an opposition and a cancellation action, and the scenario in which a party seeks to suspend an opposition on this basis. On these facts, the General Court clarified the extent to which the Board of Appeal is required to strike a balance when exercising its statutory discretion to suspend.

### The Royalton CTM



### Caspar Rebling

is a Trainee Trade Mark Attorney at Stobbs  
crebling@stobbsip.com

Caspar works on a range of design and trade mark prosecution and infringement matters.



# Aldi's print-out predicament

It's all too easy to be caught out on a technicality, warns Rosalyn Newsome

On 29 October 2010, Alifoods, SA filed a Community Trade Mark (CTM) application for a figurative sign shown below, the "Alifoods logo", for food goods in classes 29, drinks in class 32 and associated services in class 35. Aldi Einkauf GmbH & Co. oHG opposed the application on 7 April 2011 on the basis of an earlier International word mark 870896 ALDI, which designated the European Union for services in classes 35, 38, 40, 41 and 42. The opposition was filed solely on the basis of Article 8(1)(b) of Council Regulation (EC) No 207/2009 and was rejected in its entirety. Aldi filed an appeal on 25 November 2013 to the Fourth Board of Appeal of OHIM, which was also dismissed.

The recent appeal is not based on the issue of whether ALDI and the Alifoods logo are confusingly similar marks as one might expect, but rather is centred on a technical issue concerning the supporting documentation filed.

Aldi filed a print-out from the OHIM database in support of the EU designation of International registration 870896. OHIM rejected this as evidence of proof of the existence, validity or scope of protection of the International trade mark quoting, among others, Rule 20(1) of Regulation No 2868/95, which states that "the opposition is to be rejected as unfounded if, by the expiry of the period referred to in Rule 19(1) of that regulation, the opposing party has not yet proved the existence, validity and scope of

*OHIM rejected [the print-out] as evidence of proof of the existence, validity or scope of protection of the International trade mark*

protection of his earlier mark or earlier right, as well as his entitlement to file the opposition".

The Board of Appeal agreed with the Opposition Division in that the print-out from the OHIM database did not constitute a copy of the relevant registration certificate or equivalent document emanating from the administrative office responsible for the trade mark being registered, in this case the World Intellectual Property Organisation (WIPO).

Consequently, since OHIM is not responsible for managing International registrations and is not the administrative office responsible for registering the International registration, the document submitted by Aldi – being an extract from the OHIM database – was insufficient to show the validity of the International registration. The Board of Appeal continued that under Article 152 of the Regulation No 2868/95, the OHIM publication relating to an International registration designating the European Union is only an extract reflecting limited data, such as the mark and classes of goods or services protected, but not an actual list of those goods or services. Therefore, it was concluded that the Board of Appeal was correct to reject the opposition on the basis of the print-out from the OHIM database.

This is, of course, a cautionary tale and one that shows how important it is for practitioners to be fully aware of the interpretation of the Regulation to ensure they are not caught unawares.

The Alifoods logo



**Rosalyn Newsome**

is a Trade Mark Attorney and Partner at Barker Brettell LLP  
rosalyn.newsome@barkerbrettell.co.uk

# Brevity is backed

The Court does not need to provide judgment specifics, writes Verity Ellis

The General Court has ruled on a long-standing dispute between Nepentes S.A. (Nepentes) and Boehringer Ingelheim Pharma GmbH & Co. KG (Boehringer), following an appeal of the decision of the Board of Appeal of OHIM, which had held that Boehringer was unsuccessful in its opposition (based on its earlier Community word mark for LONARID) against Nepentes' application for MOMARID. This decision partly annuls the Board of Appeal's ruling in relation to some goods.

The first plea by Boehringer was on the basis of Article 75 Council Regulation (EC) No 207/2009 (CTMR), which compels the Court to clearly state the reasoning behind its judgment. However, the General Court reminded Boehringer that while the Board of Appeal's explanation was brief, such reasoning was sufficient for the parties to understand (clearly, as Boehringer then appealed on two grounds).

## A careful comparison

The second plea concerned Article 8(1)(b) CTMR, which states that a mark must not be registered if, due to its similarity or identity to an earlier mark, together with a similarity or identity of the respective goods/services, there exists a likelihood of confusion on the part of the relevant public.

Boehringer questioned the Board of Appeal's judgment regarding the: (i) attention of the relevant public; (ii) comparison of the goods/services; (iii) comparison of the marks; and (iv) finding of no likelihood of confusion.

Of particular interest is point (ii). Before completing a re-comparison of the respective goods/services, the General Court highlighted the need to consider the nature, method of use and distribution channels of the goods/services, together with their intended purpose and the identity of the targeted consumer.

In reviewing the comparison by the Board of Appeal, the General Court found an inconsistency in that certain goods ("chemicals of pharmaceutical use") had been held to not be aimed at end consumers, but the Court felt that such a general term was so vague that it could also encompass "pharmaceutical preparations" and so could be identical goods. Further, while the goods do have different intended purposes, the Court held that they were still "similar", albeit to a low degree. Therefore, the General Court held that the Board of Appeal had erred in ruling that "chemicals of pharmaceutical use" were dissimilar due to their different

consumer base but held that other goods were similar.

However, given the low degree of similarity for the goods, the Court agreed there was no likelihood of confusion except for "chemicals for pharmaceutical preparations", where the potential identity meant that a likelihood of confusion could not be ruled out.

Following the finding that such goods were similar, it followed that the ruling concluding no likelihood of confusion in respect of these goods was annulled. Other than this point, the previous decision prevailed.

## Looking forward

This case is a reminder that the Court does not need to provide lengthy explanations of its judgments and such explanations can be implied and do not have to be explicit. Parties should analyse the minutiae of a decision, as this may uncover inconsistencies that can lead to appeal. The case also highlights that use of general phrases should be discouraged.

*The Court reminded Boehringer that while the Board's explanation was brief, such reasoning was sufficient*



### Verity Ellis

is an Associate Solicitor at D Young & Co LLP  
vee@dyoung.com



# Max mix-up?

Laura Mackenzie-Mitchell clears up the thinking in this fashion decision

In 2010 Mackays Stores Ltd (Mackays) filed a Community Trade Mark (CTM) application for the mark shown below, for goods and services in classes 25 and 35.

Max Mara Fashion Group Srl (Max Mara) filed a notice of opposition in respect of the goods applied for, based on its own figurative sign, which was registered as:

- a CTM (No. 1174333), designating services within classes 35 and 42, in 2001;
- a CTM (No. 1838663) designating goods within classes 18 and 25, in 2001;
- an Italian mark (No. 793820) designating goods within classes 18, 24 and 25, in 1999 (and renewed 2010).

The opposition was also based on the Italian word mark MAX&CO. (No. 479779), designating goods in classes 18, 24 and 25, and registered in 1987.

The mark was opposed under Article 8(1)(b) (identity/similarity of marks and goods would result in a likelihood of confusion) and Article 8(5) (use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark) of Council Regulation (EC) No 207/2009.

In May 2012, the Opposition Division rejected the opposition. An appeal by the Applicant was dismissed by the Second Board of Appeal of OHIM, which held there was no likelihood of confusion between the marks and, specifically, that the element common to both marks – ‘&co.’ was not distinctive. This decision was also appealed.

The General Court dismissed Max Mara’s appeal. It stressed that the assessment of similarity between two marks involves a comparison made by examining each mark as a whole – although the overall impression can, in certain circumstances, be dominated by one or more of its components (OHIM v Shaker, EU:C:2007:333). It is only if all other components of the mark are negligible that the assessment of similarity can be carried out solely on the basis of the dominant element (Nestlé v OHIM, C-193/06 P, EU:C:2007:539).

## Distinctiveness

Max Mara argued that the Board of Appeal had not shown that the element ‘&co.’ was negligible and had wrongly reduced the comparison of the signs to a mere comparison of the elements ‘max’ and ‘m’. The General Court disagreed. It stated that, on the contrary, the Board of Appeal had found that the word element ‘max’ was the dominant element of the earlier mark, whereas for the mark applied for neither the ‘M’ nor ‘&co.’ element was dominant.

The Board of Appeal specified that a descriptive element forming part of a compound mark, such as ‘&co.’, cannot be considered by the public as the distinctive dominant element of

the overall impression conveyed by that mark (‘&co.’ is often used in business names, and used and understood internationally). Accordingly, it took account of all the components of the signs in question, following Repsol (Repsol YPF v OHIM – Ajuntament de Roses (R), T 89/12, EU:T:2013:335). The General Court agreed with this approach.

## Derivative application?

Max Mara had also argued that the goods/services covered by the application might be regarded as a further line of goods covered by its earlier marks. In its view, the letter ‘m’ in the mark applied for would be perceived as an abbreviation of the element ‘max’ in its earlier marks. In response, OHIM contended that the earlier marks (MAX&Co.) might be regarded as an abbreviation of Max Mara, and the argument was rejected.

## Disputed marks

### The Mackays Mark

M&Co.

### The Max Mara Mark

MAX&Co.



### Laura Mackenzie-Mitchell

is an IP Solicitor at Browne Jacobson LLP  
laura.mackenzie-mitchell@brownejacobson.com

Associate Bonita Trimmer acted as co-author  
bonita.trimmer@brownejacobson.com

# French fight

Jonathan Thurgood examines a decision that saw a UK entrepreneur rewarded for his marketing vision

**T**his case has its beginnings in 1940s Saumur, France. There, a manufacturer of rubber products, Dalsouple Société Saumuroise du Caoutchouc (Dalsouple France), began re-treading car tyres, eventually branching out in the 1960s into rubber flooring, in particular floor tiles. These were largely seen in France as an unexciting commodity product. It was not until the 1980s, when Timothy Gaukroger, a director of British company Jaymart, encountered the Dalsouple product and recognised its potential for development, that this reputation began to change.

## Initial arrangement

Gaukroger persuaded Raymond Mortoire, the owner and head of Dalsouple France, to grant Gaukroger's own company, The Launch Rubber Company Limited, exclusive rights to the sale of Dalsouple flooring in the UK. Gaukroger initially acted as France's agent, but soon he and Mortoire concluded that it would be mutually beneficial for Gaukroger's company to become a distributor – entering into sales contracts with UK buyers, making orders from France in its own name and taking title of the products. To mark the change in status, Gaukroger sought and obtained written permission for his company to adopt Dalsouple as part of his company's name. Thus, in 1991, his company changed its name and began trading as Dalsouple Direct Limited (Dalsouple UK).

The business relationship went from strength to strength. Gaukroger's vision and marketing ability turned an ordinary product into a sought-after floor covering. While the French business focused on factory production and selling into its domestic market, the firm's real revenue growth came from its

relationship with the UK business. At one point, Dalsouple UK was responsible for 70 per cent of the French company's turnover.

The companies continued to work together until Dalsouple France was sold. The buyer then began changing the terms of business and long-standing financial arrangements with Dalsouple UK, attempting to wrest back titles to trade marks registered to Gaukroger or his company.

It was the ownership of the UK rights to the DALSOUPLE trade mark that gave rise to the dispute to which this decision relates. In 1998, Gaukroger obtained registration of the DALSOUPLE mark in the UK in his own name. Following the sale of Dalsouple France in 2009, the company sought in 2011 to register the DALSOUPLE mark in the UK. Dalsouple UK opposed that on the basis of its prior UK and Community Trade Mark (CTM) rights in DALSOUPLE and the goodwill it claimed to have established. Dalsouple France applied to have Dalsouple UK's British registration declared invalid (having already begun invalidity proceedings against the CTM).

Dalsouple UK contended that Mortoire had given verbal consent to Gaukroger to register the DALSOUPLE trade mark in his own name. Under cross-examination before the IPO, Gaukroger recalled the circumstances giving rise to the consent. He recalled that Mortoire's son Bruno Mortoire, who was on the sales and marketing side of the business, encouraged him to register the mark in the UK, pointing out that its German agent had registered the mark there. Gaukroger stated he had also obtained permission from Raymond Mortoire.

## UK IPO decision

The Hearing Officer took the view that Gaukroger provided considered and plausible answers. Weighing up the evidence, he concluded on the balance



## A key issue at trial was the question of the relevant nature of consent and the standard of evidence to be applied



of probabilities that oral consent to the registration of the DALSOUPLE mark by Gaukroger had been given. Accordingly, France's allegation that Gaukroger's registration had been applied for in bad faith was rejected and Dalsouple UK's opposition to Dalsouple France's application was upheld. In light of this, the Hearing Officer decided not to consider the parties' competing claims to ownership of the goodwill in the UK.

### The appeal

Dalsouple France appealed to the High Court. It argued that the Hearing Officer did not have enough information on which to find that consent had been given, that it was not clear what had been consented to, that the consent needed to be in writing, and that the consent was not sufficiently clear, specific and unequivocal. At appeal, Dalsouple France also sought to adduce evidence from Bruno Mortoire to deny that the conversation referred to by Gaukroger under cross-examination had taken place – implicitly asserting for the first time that Gaukroger was lying.

Mr Justice Arnold delivered an *ex tempore* judgment dismissing the application to adduce further evidence. He held that Dalsouple France had clear and reasonable opportunities to adduce witness evidence of Bruno Mortoire both before and during the first IPO hearing, but had elected not to do so. It was not open to Dalsouple France to, on appeal, accuse Gaukroger of lying in his testimony when that charge was not put to him under cross-

examination. In his written judgment, Arnold J dismissed all of Dalsouple France's grounds of appeal.

A key issue at trial was the question of the relevant nature of consent and the standard of evidence to be applied. Arnold J held that consent to the registration of the DALSOUPLE trade mark must be "unequivocally demonstrated" (Zino Davidoff, joined cases C-414/99 and C-416/99 [2001] ECR I-8691), but accepted that an express statement of consent (which was claimed here) did amount to valid consent. Accepting that the IPO is an expert tribunal and had seen and heard the key witnesses, he found no fault with the Hearing Officer's decision.

### Key lessons

The case illustrates the importance of recording business-critical and legally significant decisions in writing and obtaining formal agreement between the parties.

In addition, cross-examination of witnesses can be crucial in evaluating claims that can be impossible to adjudicate by reference to written statements alone. Therefore, counsel skilled at cross-examination can make the difference in a case that depends on testing the credibility of witnesses.

Choosing the right help can be crucial. The Agency Agreement referred to in the case did not properly record the nature of the business relationship as it was by the date that it was drawn up. Had the commercial lawyers who drew up the Agreement discussed the matter with their IP department, a more suitable document would likely have been produced. There was some argument as to the meaning of an Amendment to the Agency Agreement that had been drafted/proposed by a firm of accountants. A properly drafted Amendment document ought to have avoided the particular arguments that occurred in this case.

*The author acted for Dalsouple UK.*



### Jonathan Thurgood

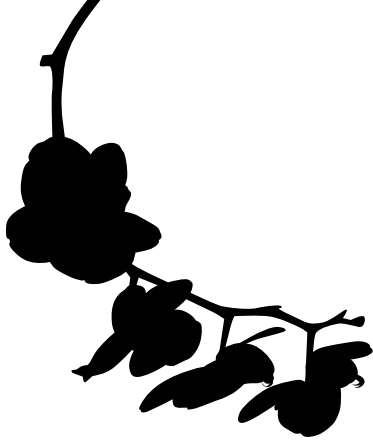
is a Partner and Trade Mark Attorney and Litigator at Carpmiels & Ransford (Trade Marks) LLP [jmt@carpmiels.com](mailto:jmt@carpmiels.com)

Jonathan has significant experience advising and acting for companies in trade mark and related contractual disputes.



# "INTERFLORA" RISES AGAIN

John Coldham outlines the arguments that  
will mean two opponents will continue  
their epic court battle



## *The Court of Appeal said that a doctrine of “initial interest confusion” could be positively misleading... an unnecessary gloss on the tests of the CJEU*

**O**n 5 November 2014, at the third outing at the Court of Appeal, Marks and Spencer (M&S) was successful for a third time in overturning a decision of Mr Justice Arnold in its (very) long-running case involving Interflora and concerns about the use of trade marked terms in internet keyword advertising. What’s significant about this latest chapter in the saga? It has overturned the Judge’s finding of infringement, with a retrial ordered. What follows is a discussion of the key points of interest of this decision.

### **User concerns**

The Court of Appeal held that internet advertising on the basis of keywords corresponding to trade marks is not inherently objectionable because its purpose is, in general, to offer internet users alternatives to the goods or services of the trade mark proprietors.

When considering the average internet user, Arnold J had found that internet literacy has increased over the past five years. He held that the majority of internet users were aware of the distinction between sponsored and natural search results. However, the Court of Appeal held that the Judge focused too much on the proportion of users who did not appreciate the distinction.

When looking at keyword advertising, the Court of Justice of the European Union (CJEU) has held (in Google France and others) that advertisers bidding on third-party trade marks must ensure that their advertisements enable the reasonably well-informed and reasonably observant internet user to ascertain, without difficulty, that the advertised goods or services originate not from the trade mark proprietor but from an unconnected third party.

Despite the fact that the onus is on the advertiser to ensure that its advertising falls the right side of the

line, when it comes to proceedings, this does not mean that the burden of proof is reversed; it does not have to show that use of the sign in context is sufficiently clear that there is no real risk of confusion on the part of the average consumer as to the origin of the advertised goods and services.

In fact, the Court of Appeal held, the onus is on the trade mark proprietor, who must establish that: “the advertisement complained of does not enable normally informed and reasonably attentive internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to by the advertisement originate from the trade mark proprietor or an undertaking economically connected to it or, on the contrary, originate from a third party”.

### **Controversial concept**

In the High Court judgment, Arnold J introduced the concept of “initial interest confusion” into his analysis. The expression derives from the US, is highly controversial and, as the Court of Appeal notes, has been used to describe a range of situations. Here, the Judge defined it as “confusion on the part of the public as to the trade origin of the goods or services in relation to which the impugned sign has been used arising from use of the sign prior to purchase and, in particular, confusion arising from the use of the sign in promotional or advertising materials”. In short, use of a trade mark to draw in a potential customer by confusing it into thinking there is a link, even if, by

the time of purchase, the consumer is no longer confused.

The Court of Appeal said that such a doctrine is “not helpful”, at least in relation to use of a trade mark as a keyword. The Court went as far as to say that such a doctrine could be positively misleading, describing it as an unnecessary gloss on the tests of the CJEU and it should form no part of the analysis of the national courts in this kind of claim.

The main reason for this is that, as internet advertising on the basis of keywords is not inherently objectionable, it is better to view it from the point of view of the tests set out by the CJEU, which incorporate various checks and balances. The national court is required to consider the matter from the perspective of the average consumer and decide whether the advertiser has enabled that average consumer to ascertain the origin of the advertised goods and services – and so make an informed decision. This is a positive obligation; it is not the duty of such advertisers to avoid confusion.

### **Retrial ordered**

The Court of Appeal allowed M&S’ appeal; if the Judge had not made the various errors he did, the Court believes he could have come to a very different result. The Court of Appeal decided, however, that it could not determine the issue of infringement itself, as it was not taken to all the documents and did not hear the oral evidence. The Court has remitted the case to the High Court for a retrial, and this saga looks set to continue!



### **John Coldham**

is a Director at Wragge Lawrence Graham & Co.  
[john.coldham@wragge-law.com](mailto:john.coldham@wragge-law.com)

John advises clients in relation to a variety of areas, with a particular focus on designs and brands law.

# Sphere of influence

Natasha Hybner explains why two established businesses were believed able to coexist in the same business arena

The Claimant in this case, IPC Media, publishes *Ideal Home* magazine, which dates back to 1920. The Defendant, Media 10, is the organiser of the Ideal Home Show, which was the first exhibition of its kind and dates back to 1908.

The dispute arose due to both companies' natural expansion into the online shopping sector. In 2012, Media 10 expanded its website and developed the "Ideal Home Show Shop", prompting the litigation from IPC Media.

IPC Media claimed its UK Trade Mark Registration No. 2435081 for "Ideal Home" for retail services in class 35 was infringed by this expansion. Media 10 denied this and counterclaimed for invalidity on the basis of its prior rights.

## First instance decision

At first instance, Mr John Baldwin QC held that although there was potential confusion in the use of "Ideal Home Show" in connection with Media 10's online shopping business, it did not impair the guarantee of origin provided by IPC Media's registered trade mark. Any confusion that would be caused was to be expected due to the parties' overlapping interests. The effect of the use of "Ideal Home Show" by Media 10 would not be any more detrimental to IPC Media's trade mark than that which already occurred due to both companies' long-standing use of the phrase in separate businesses (considering *Budweiser* [2012] EWCA Civ 880).

With regards to validity, it was concluded that both parties' sale of

home interest goods was "sufficiently in the middle of the spectrum between the respective core businesses for neither to be able to succeed against the other in a passing off claim". Both parties appealed.

## Appeal decision

Lord Justice Kitchin reconsidered whether or not the use by Media 10 of the name Ideal Home Show in relation to internet retail services was liable to have an adverse effect upon the functions of the registered trade mark in light of the very many years during which the words "Ideal Home" were used in connection with the parties' respective businesses.

Kitchin LJ agreed with the decision at first instance and concluded that "Ideal Home", when used for online retail services, did not indicate to average consumers that the services in question are that of a single company, but always the services of both parties. It was concluded that the companies' natural expansion into online retail services was to be expected and was not the major change portrayed by the Appellant.

On validity, it was concluded that Media 10 had failed to establish that it could have prevented – by way of a passing off action – IPC Media's normal and fair use of the mark "Ideal Home" in relation to online

retail services. When IPC Media obtained its registration in 2006, online retail services were an area of interest that both parties might reasonably have wished to expand; such normal and fair use by IPC Media would not, therefore, have amounted to passing off.

## Conclusion

This decision demonstrates the Courts' willingness to allow coexistence where honest concurrent use of the mark has occurred such that it can reasonably be said that the use complained of will not have an adverse effect on the essential function of the trade mark.

*The companies' natural expansion into online retail services was not the major change portrayed by the Appellant*



**Natasha Hybner**

is a Trade Mark Advisor at Swindell & Pearson Limited  
Natasha.hybner@patents.co.uk



ITMA's Gala Dinner in the historic surroundings of Madame Tussauds will be a highlight of our Spring Conference



# events

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

Date	Event	Location	CPD hours
11 March	<b>ITMA &amp; CIPA Leeds Talk</b>	St Philips Chambers, Leeds	1
18 March	<b>ITMA Spring Drinks Reception</b>	Sway Bar, London	
18-20 March	<b>ITMA Spring Conference</b>	One Whitehall Place, London	9
19 March	<b>ITMA Gala Dinner</b>	Madame Tussauds, London	
25 March	<b>ITMA Open Meeting</b> <b>ITMA Benevolent Fund AGM</b> <b>ITMA AGM followed by drinks reception</b>	Charles Russell Speechlys LLP, London	
16 April	<b>ITMA Manchester Talk</b>	Marks & Clerk LLP, Manchester	1
28 April	<b>ITMA London Evening Meeting*</b>	Royal College of Surgeons, London	1
16 June	<b>ITMA London Evening Meeting*</b>	Royal College of Surgeons, London	1
17 June	<b>ITMA Leeds Talk</b>	Bond Dickinson, Leeds	1
21 July	<b>ITMA London Evening Meeting*</b>	Royal College of Surgeons, London	1
22 September	<b>ITMA London Evening Meeting*</b>	Royal College of Surgeons, London	1
23 September	<b>ITMA Autumn Seminar</b>	Hyatt Regency, Birmingham	5

IMAGE: IGOR MATIC/SHUTTERSTOCK.COM

\*Kindly sponsored by





**I work as...** a Registered Trade Mark Attorney at Wildbore & Gibbons LLP.

**Before this role...** I was studying for my Law degree at Cambridge and trying to decide whether I wanted to become a solicitor or barrister (or neither of these).

**My current state of mind is...** calm. After two years of exams I am finally qualified and on the Register.

**I became interested in IP when...** I came across an article written in my university's career magazine by a recent graduate who had entered the profession.

**I am most inspired by...** those attorneys who juggle several professional responsibilities at once.

**In my role, I most enjoy...** learning more about the businesses of clients, both existing and new.

**In my role, I most dislike...** those letters sent directly to clients from agencies purporting to offer "registration services" for a grossly inflated fee.

**On my desk is...** a blue travel mug from a US law firm, a stress ball and a silver teapot.

**My favourite mug...** has the name of a local business on it, as it was a freebie. Perhaps more uplifting is my Oyster card holder, which says "The World is Your Oyster"; a nice thought when I'm facing Tube delays.



## Post-exam responses from relaxed Ordinary Member Sarah Talland

**My favourite place to visit on business is...** so far, Paris, which I had the opportunity to visit last year for a conference.

**If I were a brand/mark, I would be...** the colour purple, the progress of which I have followed closely as a fan of non-traditional trade marks. It also reminds me of the colour scheme at my wedding.

**The biggest challenge for IP is...** the ability to adapt to modern approaches to branding. Social media and online promotion means many businesses are

using non-traditional trade marks, as well as non-traditional means of promoting their brands, and IP systems need to be flexible enough to offer the necessary protection to these.

**The talent I wish I had is...** fluency in a second language. I do speak some Spanish, but not as well as I would like.

**I can't live without...** my diary; I would be useless without it.

**My ideal day would include...** receiving a favourable decision in a case where such an outcome seemed unlikely.

**In my handbag is...** a purse, keys, mirror, business cards and an umbrella.

**The best piece of advice I've been given is...** keep it simple. Don't use 10 words when three will do and, where possible, keep your advice to one page.

**When I want to relax I...** book a weekend break somewhere with a spa.

**In the next five years, I hope to...** establish myself as a Registered Trade Mark Attorney and become more involved with ITMA.

**The best thing about being an ITMA member is...** keeping in touch, both with new legal developments and good friends!

*If you'd like to appear in TM20, contact [caitlin@thinkpublishing.co.uk](mailto:caitlin@thinkpublishing.co.uk)*



# WebTMS

SOFTWARE FOR THE TRADEMARK PROFESSIONAL



## Web Based

You can access WebTMS anywhere you have an Internet connection and on any device, e.g. Laptop, Macbook, PC, Apple Mac, Tablet, Smartphone (all brands).

## Excellent Customer Support

The whole team is dedicated to the WebTMS software only, anyone who picks up the phone will be able to help. Unlimited technical support via telephone and email is part of the service.

## User Friendly Software

WebTMS is very intuitive and user friendly without sacrificing power or functionality.

## 17 Years Experience

The WebTMS team have been creating, developing and supporting the WebTMS software for 17 years, including data migration and conversion.

To learn more about the WebTMS software, book a demonstration or request a free trial, please e-mail [sales@ippo.com](mailto:sales@ippo.com)

[www.WebTMS.com](http://www.WebTMS.com)

# 20 years

of exceptional IP recruitment service

Leading providers of IP and Legal  
recruitment in the UK and abroad.

Visit us at [www.dawnellmore.co.uk](http://www.dawnellmore.co.uk)



**Dawn Ellmore  
Employment**



Patent, Trade Mark & Legal Specialists