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ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

Issue 418 June 2015 itma.org.uk



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The ABCs of ABS

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summarised p6





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Congratulations to all of you who have survived another INTA, either doing your colleagues' work while they have been marketing relentlessly in San Diego, or marketing relentlessly in San Diego while your colleagues have held the fort. With normal service resumed, I invite you to edify yourselves with the latest *Review*. In particular, I am sure that you will enjoy John Noble's summary of the very valuable activities of the British Brands Group

over the past 20 years. I would also urge you to read our ABS feature, a very helpful and informative overview. Finally, let me take this opportunity to remind you about our Summer Reception at the Little Ship Club on 8 July. I look forward to seeing you on board.

Chris McLeod
ITMA President

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ITMA Insider

Giving students an IP steer

Jerry Bridge-Butler offers some answers about a resource recently developed with the help of ITMA



Q What is IP Tutor?

A IP Tutor is an online teaching resource for students, which gives them an insight into all areas of IP. The aim is to provide them with enough background knowledge to identify what can be protected, and how to go about protecting it. The hope is that the innovators and business leaders of the future will be more IP savvy than in the past, with the knock-on benefits that would bring to the Professions, and to the UK economy.

How did ITMA get involved?

ITMA's involvement grew out of a new PR collaboration between ITMA and the UK IPO. In an effort to improve relations with the IPO, and to offer ongoing attorney expertise and assistance for any PR or public-facing project the IPO was engaged in, the two bodies set up a PR liaison committee last year. It is now a joint ITMA and CIPA liaison committee. There are three dual-qualified ITMA members, alongside various IPO policymakers. It was through that group that we learned about the IPO's intention to create a learning tool for students, and we offered to help to create it.

What was ITMA's involvement?

The IPO established an online collaborative working group comprising a number of volunteer academics and business people from around the country, as well as myself. The group was provided with drafts of various sections of the tool over several months, and asked to provide our feedback. The academic input was principally about how best the messages should be presented and what issues concern students today, while my input was required to ensure that those messages were correct, meaningful and to the point. It was very tough to get those messages across in a manner and format that the academics approved of! In the end, large sections of IP Tutor were written by me.

Why was it felt necessary to create it?

Both Trade Mark Attorneys and Patent Attorneys are aware from their own experience that university graduates and young start-up companies can be ignorant of even basic elements of IP. This is an acute issue for them, and a problem for us, so anything ITMA can do to address that problem is a priority. The UK IPO

came at this with a grander view of the merits for the British economy, given the reliance now placed on IP rights and their value. The IPO has been reaching out to the public to promote IP for several years now, and in numerous interesting ways, and IP Tutor is the latest part of that.

What are you most proud of in IP Tutor?

The best thing about IP Tutor is how it is separately structured for students studying different things, so the issues that concern a particular kind of student are made prominent for them. Users enter the tool as either creative, STEM, humanities or business, law and accounting students. The order in which the areas of IP are taught, and the various illustrative examples, are then tailored to their area. This means that an art student, for example, is taught about copyright first, a STEM student learns first about patents, while a law student's route begins with a module on the importance of IP to businesses, and how they can best exploit it.

What difference did ITMA make to IP Tutor?

The biggest impact without doubt was bringing practical experience and knowledge to the table. The IPO knows about IP registration, but it lacks an attorney's knowledge of strategy and how best to use the system to your advantage. IP Tutor is bristling with useful tips and illustrations that the users will find beneficial, and much of that came from ITMA's involvement.

Jerry Bridge-Butler is a Partner at Baron Warren Redfern



In memoriam: David Butler

David Butler, Vice President, Anti-Counterfeiting and Vaccines at GSK - GlaxoSmithKline - passed away on 8 February 2015 in Shanghai.

David's premature and tragic death at the age of 41 remains a massive shock to all of those who worked with him, including his colleagues at GSK, all of whom miss him greatly.

David joined GSK's legacy company, SmithKline Beecham, in November 1996 as a trainee solicitor. He qualified first as a solicitor in the Trade Mark Department and subsequently as an ITMA Trade Mark Attorney. David supported the GSK global Vaccines business, as well as leading GSK's global anti-counterfeiting enforcement programme.

For the past two years, David was seconded to GSK China, where he focused on strengthening GSK's anti-counterfeiting activities.

David was passionate about his work and communicated that passion brilliantly to those who he was working with. His dedication, sense of humour, kindness and honesty were much appreciated by all.

He was a devoted husband and father to two young daughters. Our thoughts are with his family.

Sophie Bodet

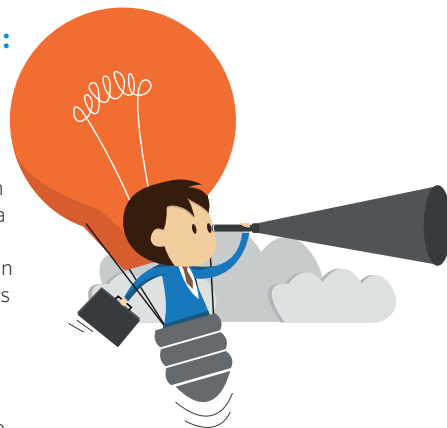
FIRM OPENS RIYADH BASE

Clyde & Co has further formalised its existing intellectual property capability in the Kingdom of Saudi Arabia with the opening of its fully integrated office. The newly-formed structure will provide a full-service offering through an office located in Riyadh.

The office is headed by Abdulaziz Al-Bosaily. Ben Cowling, a partner of Clyde & Co, who has been resident in Saudi Arabia since 2012, will continue to be based in Riyadh and assist with the management of the office.

LOOKING FORWARD: YOUR VIEWS

The Council of ITMA has set a meeting in July to review the **strategic objectives** of the Institute and look ahead at the plan for the coming years. There seems to be a trend at the moment to plan for 2020. Maybe it is the puns that can be created in relation to 20/20 vision or simply that it is five years away! In all seriousness, it is important to look ahead at what might impact the Profession, what the focus of the organisation should be and what members will want and need in the future. If you have any particular views, do not hesitate to **share them with Keven Bader by emailing keven@itma.org.uk**, as the views of members will assist us in our discussions and planning.



IP Ball to benefit GOSH

This year's IP Ball will take place on **18 July 2015**, at **Drapers' Hall in the City of London**. Organised, as always, by a volunteer group of IP trainees, the ball will once again raise money to support Great Ormond Street Hospital. The theme this year will take its cue from children's classic *Alice in Wonderland*, so a colourful night should be in store.

Visit [facebook.com/theipball](https://www.facebook.com/theipball) for more information and for details on how to buy tickets.



ITMA COMMITS TO LAW CARE

As CEO Keven Bader, recently announced to members, ITMA has now committed to providing support for LawCare, a registered charity that provides a dedicated helpline for those within the Profession who may be experiencing emotional, personal or professional problems.

A LawCare helpline is available to ITMA members, their staff and families who might be in need of help and advice. It is free to call and is completely confidential. The helpline number is **0800 279 6888** and is staffed 365 days of the year.

The trained staff and volunteers who take calls have worked in the law and understand the demands of a legal career. LawCare has helped thousands of legal professionals cope with issues such as stress, workplace bullying, disputes with colleagues and alcohol misuse.

In addition to the helpline, LawCare provides counselling, befriending, training and various information packs. See the website, lawcare.org.uk, for further information. We will be featuring further information on LawCare in future issues of the *ITMA Review*.

The
ABCs
of **ABS**

*Keith Hodgkinson
succinctly summarises the main points of
the new licensing regime*





New licensing requirements for firms that are “alternative business structures” (ABS) – as defined by the Legal Services Act 2007 (LSA 2007) implemented, in the case of IPReg-regulated firms, by the IPReg Registered Bodies Regulation 2015 – came into force on 1 January 2015.

The new rules provide transitional provisions for existing and new ABS firms under Section 18, LSA 2007, giving existing ABS firms three months to apply for a licence. New firms should preferably apply in advance of trading, though it is arguable that the law allows you to set up and trade and apply for a licence within three months of doing so. If you contemplate doing so, get specific legal advice first.

Why does ABS matter?

“Licensing” and “regulation” by IPReg are different animals, though very similar in operation, and the rules governing regulated and licensable firms are much the same. This is fair and reasonable, given that the public should expect the same standards of protection from any firm whose conduct is supervised by IPReg. However, certain additional safeguards apply where “non-authorised” persons own or manage a firm.

Regulation covers those firms that offer reserved legal services under the LSA 2007 and whose owners and managers are all “authorised persons” (a term discussed below). All other firms will be ABS and will need to be licensed as such.

A new firm may be seeking registration or, if it will be an ABS, a licence. An existing firm may be registered, but need to apply for a licence because it is an ABS.

The decision whether you are an ABS is an important one and an issue that IPReg will treat seriously. It is a criminal offence for a firm to trade if it is not registered or licensed and should be. IPReg has indicated a willingness to investigate and discipline firms it believes are ABS and should have applied to be licensed. Also, my understanding is that Pamia Limited’s terms of insurance cover do not in principle extend to the costs of disciplinary or criminal proceedings by IPReg arising from a failure to seek an ABS licence when it is considered to be required.

Are you an ABS?

The only cast-iron way to find out if IPReg thinks you are licensable is to read the LSA 2007, but in particular Section 11(2), which says:

- (1) A body (“B”) is a licensable body if a “non-authorised” person—
 - (a) is a manager of B, or (b) has an interest in B.
- (2) A body (“B”) is also a licensable body if—
 - (a) another body (“A”) is a manager of B, or has an interest in B, and (b) non-authorised persons are entitled to exercise, or control the exercise of, at least 10 per cent of the voting rights in A. ➔

The only cast-iron way to find out if IPReg thinks you are licensable is to read the LSA 2007, but in particular Section 11(2)

- (3) For the purposes of this Act, a person has an interest in a body if—
- the person holds shares in the body, or
 - the person is entitled to exercise, or control the exercise of, voting rights in the body.
- [Author's note: not just proprietary or purely legal interests...]*
- (4) A body may be licensable by virtue of both subsection (1) and subsection (2).
- (5) For the purposes of this Act, a non-authorised person has an indirect interest in a licensable body if the body is licensable by virtue of subsection (2) and the non-authorised person is entitled to exercise, or control the exercise of, voting rights in A.
- [For example by contract or trust.]*

Who is a “non-authorised person”?

Put simply, a “non-authorised person” is a person who is not already a UK Registered Patent Attorney, UK Registered Trade Mark Attorney, Solicitor of England and Wales with a practising certificate, a barrister at law with the right to practice before the English and Welsh Courts, a CILEX certified legal executive or a “registered foreign lawyer”.

Thus, for example, a European Patent Attorney is not an authorised person; nor is an Irish Patent Attorney or a Scottish solicitor, nor an OHIM professional representative whose right to be on the OHIM register derives from an overseas IPO registration.

In deciding whether these rules encompass your business you may find it helpful to read and fill in the

IPReg ABS licence application form. If you tick any of the boxes in the section of the form concerning ownership and management you will be very likely to be regarded as an ABS by IPReg. The form is available from Rachel Greensides, the ABS licensing officer at IPReg.

In reading the LSA 2007 and the IPReg form it is important to note the definitions that are not intuitive, including Owners, Managers, Authorised and Approved Persons, and Associated Persons (the IPReg form provides a useful precis of these definitions of most relevance to patent and trade mark firms, although not the full legislative list).

ABS examples

Many smaller firms are ABS, but may not realise it. For example:

- Many arrangements designed to give tax efficient income to family of the professional running the firm (by way of directorships, share dividends and the like) may well be caught by the ABS rules even if those persons have no day-to-day involvement or influence on the operating business.
- Even if a corporate (and non-corporate) owner is itself made up entirely of authorised persons it will still need to be authorised as an Owner and the firm will be licensable. So an LLP with a member that is a Limited Company, even though all the shares in the Limited Company are owned by Authorised Persons, will be an ABS.
- Some in-house departments may be ABS if hived off as separate divisions or businesses servicing group businesses.



Even if the shareholding is very small (less than 1 per cent) and gives no material influence, the business will need to be licensed. If you do not want the complications of ABS for what might be a relatively small tax gain you may consider removing these persons from their ownership or role, although if you do, your position between 1 January 2015 and before the transitional period expires is uncertain on my reading of the LSA 2007.

Additional approvals

Once you are found to be an ABS, a second set of questions on “material influence” will be asked to determine if further authorisations are needed. The business will need to apply to be licensed and also provide an individual application for approval of every non-authorised manager or owner to whom any one of the following statements applies:

- Holds at least 10 per cent of the shares in your business or a parent undertaking;



- Exercises significant influence in your business or a parent undertaking as a result of their shareholding;
- Exercises or controls 10 per cent of the voting rights in your business or a parent undertaking;
- Exercises significant influence in your business or a parent undertaking as a result of their exercise or control of voting rights in the business or parent undertaking;
- Has the ability to impose directions on the operating of financial policies of the business or the parent undertaking including by articles or contract;
- Has the unqualified right to appoint or remove a majority of directors of the business or parent undertaking;
- Has any right to veto or otherwise exercise a dominant influence, passive or active, in voting in your business or parent undertaking.

Substantially more details are required of these persons, and IPReg may independently investigate their suitability.

If the shareholding is very small, and the shareholding gives no material influence, you may not need to get the persons approved or fill in the full profile forms – though IPReg may take a different view on this. IPReg has asked for details of persons who are notified to be owners even if they do not meet these material influence criteria, though their basis for doing so is unclear.

Approving the HOLP and HOFA

A Head of Legal Practice (HOLP) and Head of Financial Affairs (HOFA) must be appointed. This may be one and the same person. This person or these persons are responsible to IPReg for the conduct and finances of the licensed firm. As such, fuller details of these persons (and of their professions' regulators if they are "non-authorized" persons acting in the role, eg an accountant

regulated by the ICAEW) will be required. Additional checks may be undertaken as to the suitability of these persons.

The training of these people and information about their suitability must be provided to IPReg even if these persons are already "authorised persons" under the LSA 2007 (eg a Registered UK Patent or UK Trade Mark Attorney). Their assistance and resources must be specified – to show the means at their disposal for fulfilling the responsibilities and their dependence on non-authorized persons.

How do I apply?

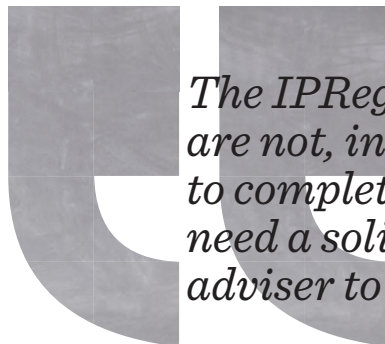
To apply, fill in the IPReg forms – which are lengthy, but less intrusive and more straightforward than the Solicitors Regulation Authority (SRA) forms – attach the supporting evidence and information, and send a cheque.

Surprisingly, at least in the initial application phase, there appears to be no need to send in your partnership, LLP or Limited Company agreement, unlike the corresponding process before the SRA, but instead you need to draw up governance structure and ownership structure charts – which may be more difficult or time-consuming. The ownership structure will require details and shares of the owners of the business, of the parent business (if any), beneficial owners

(eg under a trust and certain "associates" of any persons or bodies identified, which means a spouse/civil partner/child/stepchild/director/employee/person having an agreement to buy shares).

You will also need quite a few documents. These include, at the minimum:

- Business plan (although it is unclear whether this includes a budget)
- Latest audited accounts
- Written terms of business
- Complaints handling procedure
- Your anti-money-laundering policy
- The number of professional indemnity claims made against you and claims paid out by you or your insurers in the recent past
- Conflict of interest procedure
- Client account if taking client money on account – see the latest modified guidance
- Insurance cover details
- Privilege and confidential information staff training procedure
- Proof of training procedures to ensure compliance with code of conduct
- Information on key outsourcing agreements
- Details of sources of external funding
- History of insolvency etc of any managers/owners or their previous firms
- Full details of all professional staff, including non-qualified fee earners
- Details of coordination or unified management with other businesses. ➔



The IPReg forms themselves are not, in most cases, hard to complete. You do not need a solicitor or other adviser to help

Some of these policies or documents can be very short, and some applicable content can be sourced from the IPReg Code of Conduct. Model templates for some have been produced by the joint business practice committee of CIPA and ITMA. Others will have to be bespoke to your firm. All are fairly common-sense documents each firm should have.

The IPReg forms themselves are not, in most cases, that hard to complete. You do not need a solicitor or other adviser to help. However, remember that full disclosure is essential. Do not hide anything. If in doubt put it in and expect IPReg to decipher what else is needed.

You are at least partially protected from consequences while your application is under examination and you may have the chance to change things if required to do so: it's better to notify than take the risk, even if you think you are not licensable – you will get your money back (we think). Filling in the forms honestly at least gives you some mitigating arguments if you get it wrong.

The SRA ABS help guidelines can be helpful, but they can also be “false friends” in requiring too much detail.

How much does it cost?

The fee starts at £121 for a sole practitioner with non-authorised investors or managers. In broad terms, the cost is equal to one year's practice fee for the entity. Thereafter, changes will cost money (eg registering a new authorised person will cost £200).

How long does it take?

The form and its attachments are not the end of the story; further information may be requested by IPReg. The application gives permission for IPReg to make extensive enquiries about you and

people associated with you. Conditions may be imposed on a firm before a licence is granted. The LSA 2007 prescribes a maximum timescale for examination of an ABS licence application of six months, with a possible three-month extension.

Anti-money laundering and ABS

Although CIPA does not believe that anti-money-laundering regulations (AML) apply to the IP professions, it is a condition of applying for an ABS licence that you provide details of your processes to deal with AML. Don't panic! It is easy to overstate what needs to be done under AML. This is always a risk-based assessment. Checks are proportionate to risk. Even the much stricter SRA makes it clear that you do not have to make enquiries into every source of funding from other parties. However, you must always be alert to warning signs and in some cases you will need to get more information. In some circumstances, cleared funds will be essential for transactions and clients may want to provide cash to meet a completion deadline. Assess the risk in these cases and ask questions if necessary. See the article in the May issue of the *ITMA Review* (page 20) for a reminder of some indications that may raise a red flag about a transaction.

Closing thoughts

The ABS application process is not as bad as some feared. IPReg has gone rather “lite” compared with the SRA.

The process is not as bad as some feared. Much of what IPReg asks for is required and sensible for any firm, even if it is not an ABS

Much of what it asks for is required and sensible for any firm, even if it is not an ABS. It is undoubtedly a pain, but it is the price we pay for the privileges we enjoy under the LSA 2007, which regard us as very like solicitors or barristers. And to be fair we have long argued for rights of audience and representation before court and for privilege legal analogous to those professions. Much of the ABS regime has come or will come into force for non-ABS firms too. The alternative for an ABS firm is not to conduct reserved legal activities and join the unregulated community. However, that too is a very serious decision and one that is not to be taken lightly.

NOTE: This article does not constitute legal advice from CIPA, ITMA or the author and should not be relied upon in reaching a decision over whether or not to apply for an ABS licence. IPReg encourages firms to contact IPReg for advice and assistance on ABS, but please be aware that informal enquiries may not be answered and a formal application may need to be made in order for IPReg to assess the information provided.



Keith Hodkinson

is a Director of Pamia Ltd and a Partner in Marks & Clerk LLP
KHodkinson@marks-clerk.com

Keith is a member of the CIPA/ITMA Joint Business Practice Committee and a member of the CIPA Council.

The motorcycle man

Brand loyalty is the pride of Mark Bearfoot, Brand Protection Manager, Harley-Davidson Motor Company, who discussed his career development with Tania Clark

Q **Tania Clark: Can you tell us a little about your role?**

A **Mark Bearfoot:** I am responsible for all aspects of IP enforcement and anti-counterfeiting activities across Europe, the Middle East and Africa. This includes managing infringement proceedings, our online enforcement activities, and removing counterfeit goods from e-commerce platforms. I also train law-enforcement agencies on the identification of genuine Harley-Davidson products and manage our enforcement guidelines on the World Customs Organization Interface Public-Members tool (WCO IPM) and EU Enforcement Database. I draft legal agreements, such as coexistence and settlement agreements, and liaise with our trade mark filing team in Milwaukee, Wisconsin.

What's it like working at Harley-Davidson?

Harley-Davidson is a unique place to work. Everyone is so dedicated to the brand and are personally offended when they come across infringements in the market. Nearly all of my matters are referred from colleagues.

What's also inspiring is that, despite being 112 years old, it is still a growing business. We are continuously expanding geographically, but also innovating. Last year saw the launch of Project Livewire, a customer-led, grass-roots

approach to product innovation for an electronic motorcycle, and the first such approach by any major motorcycle company.

How did you come into trade marks?

I started at the age of 16. I never enjoyed school due to my dyslexia and decided to leave as soon as I could. I got myself an office assistant role at Interbrand and within 12 months was given a junior formalities role in its trade mark subsidiary, Markforce. The Head of Formalities, Kendrick Leong, recognised my potential and invested in my development, which is when I attended the ITMA Administrators' Course. After three years I decided to join the Trade Mark Owners Association (now Nucleus) as a Senior Formalities Clerk, though after a year I moved to Rouse as a Paralegal. I stayed at Rouse for almost four years before being offered a Paralegal role at FieldFisher. However, soon after joining I was sent on a 12-month secondment to Coca-Cola and never returned.

I stayed at Coca-Cola for almost eight years where I assisted in the management of its IP portfolio in Europe and enforcement activities across Central and Eastern Europe, and was responsible for the European

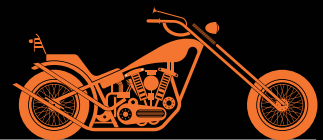
domain name portfolio. Some of my proudest achievements include creating and implementing its ambush marketing strategy for the London 2012 Olympic Games and drafting the European protection and enforcement strategy for the famous "Contour" bottle. It was during my time at Coca-Cola that I decided to qualify as a Registered Trade Mark Attorney and I finally completed the Nottingham Practice Course last year.

Who has influenced you?

Danise Lopes (née van Vuuren), who is now Global Head of IP at Coca-Cola, has been the biggest influence on my career. Danise not only gave me my first break in-house, but she taught me how to utilise my skills to be both a good lawyer and a business partner. I would be incredibly proud if I could emulate her career.

Is there anything that you don't like about your job?

I would have to say budget management, particularly at financial year end. Having said that, I enjoy the innovative aspects of budget management, particularly coming up with creative solutions to infringements - for example pursuing criminal or other disruptive enforcement measures rather than the more costly civil measures.



Tania Clark is a Partner at Withers & Rogers LLP
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INTO THE LION'S DEN?



AARON WOOD BRINGS TOGETHER COMMENT AND
ADVICE FROM SEVERAL EXPERTS ON HOW TO TAME
THE DANGEROUS TECHNIQUE OF CROSS-EXAMINATION



OUR FEARLESS PANEL:

BENET BRANDRETH
A Barrister
at 11 South Square

ALLAN JAMES
Head of Trade Mark
Tribunal at the UK IPO

DENISE MCFARLAND
A Barrister at
Three New Square

JULIUS STOBBS
Principal
of Stobbs IP



LITIGATION

Even for those who have the confidence to appear before courts and tribunals, cross-examination can still strike fear into the heart. To help ITMA members better grasp the importance and challenges of this element, I put together a panel including two barristers who appear regularly, and Allan James of the UK IPO, to get the benefit of their collective experience in this area.

Do you think enough use is made of cross-examination in the Registry?

Julius Stobbs: No. There seems to be very little use.

Benet Brandreth: Cross-examination is a time-consuming and expensive element of any proceedings. It doesn't appear to me to be something one should expect to see as a regular part of Registry proceedings, which are intended to be low-cost and relatively rapid. However, I do think it has an important place and particularly so where the grounds of opposition involve allegations of dishonesty or where the challenge to the opponent's position involves saying that the evidence is false.

Denise McFarland: I agree – it is relatively seldom that the facts or circumstances of a particular case warrant the extra costs and administrative complexity of seeking permission to cross-examine, let alone to carry it out.

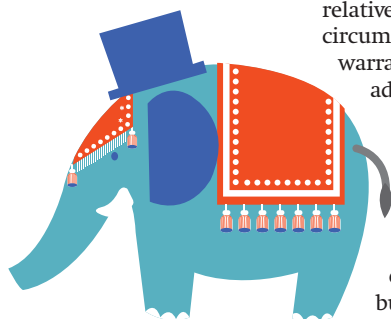
Allan James: Overall, yes. There are cases where the facts are disputed and cross-examination may have helped, but there are others where it was

misused, usually to put pressure on the other side, or to test statements that were really just opinions. In my experience, cross-examination is most productive when the motives of the registrant are in issue. Most often these are bad faith cases, but may also be cases where the applicant is said to be taking unfair advantage of an earlier mark with a reputation. Cross-examination may also be helpful where a witness's account of the use made of a mark is disputed. However, the need for this has lessened as a result of the realistic position taken by the Appointed Persons, that even previously unchallenged evidence must be assessed for what it is worth. This shift of emphasis reflects a more general trend for the courts to attach more importance to the presence (or absence) of documentary records when assessing the credibility of a witness's evidence, for example, the judgment of Arden L.J. in *Wetton v Ahmed and Others* [2011] EWCA Civ 61.

I have sometimes wished that witnesses had been cross-examined, usually when both sides provided differing, but equally plausible, accounts of the same facts – and where those facts mattered. In those relatively few cases, cross-examination may have made it easier to get to the truth. However, the amount spent on a case has to be proportionate to its commercial value. Some trade mark cases are not worth enough to justify the cost of the sort of fully fledged approach to evidence customary in the higher courts.

What do you see as the major risk in cross-examination?

BB: As a practical matter, cross-examination is extremely difficult to do effectively and efficiently.



It requires practice. That is why the criminal bar is so much better at it, generally speaking, than the civil bar. It is a more central part of their practice and as a result they have more experience of it. From the outside it may look like no more than a conversation, but it is a very demanding skill to do well.

Inexperienced practitioners may generate a cross-examination that is unfocused, or challenge the honesty of a witness without laying adequate foundation to do so. That is a particular danger where the evidence is, in its written form, already weak and inadequate and the cross-examination simply provides the witness with an opportunity to fill in any gaps and appear stronger.

DM: Again, I agree with Benet – the risk is that unforeseen answers undermine your hoped-for purpose in cross-examining the witness. As a witness, then, the major risk is that you will be shown to be an unreliable, untruthful or otherwise less-than-satisfactory witness via the medium of the process of cross-examination.

JS: Yes. The cross could allow the witness to clarify points that were not clear. While technique will guard against this in the main, it is open to the Hearing Officer to ask questions also and he may have a different agenda than you do.

Is there one thing that would improve the effectiveness of the decision to cross-examine?

BB: Consideration of whether one has the material to make good the questions asked. The cross-examiner needs to have the material to make good the points they wish to make in the face of any denial by the witness. Sometimes one suspects that a witness is lying but can't prove it – what then is the point of the cross-examination other than to expose that you can't prove them to be lying or mistaken?

DM: A fully mature reflection on all the possible risks and costs and administrative steps involved.

AJ: In IP cases, parties should only cross-examine on issues about which they believe that they already know the true facts. If you don't know what facts will come out, think twice about asking. If you go fishing you will be landed with whatever fish you catch. If it's the wrong kind of fish for your purposes, there will be no way to throw it back in.

What are your top three pointers for effective cross-examination?

DM: First, be prepared and know the facts and documents very well. Second, expect the unexpected. Third, be prepared to stop or "back off" if you sense that things can only get worse for your client if you proceed!

Allan James answers CMC OPPORTUNITY FOR CROSS-EXAMINATION?

Would you be keen to see the question of cross-examination dealt with at the case management conference?

Where cross-examination is permitted or ordered, we already require the parties to identify the witnesses, the issues and the time required. If we do not think cross-examination is necessary, a CMC is appointed to resolve how much (if any) is necessary and on which issues.

On the wider control of evidence, we have to balance

our desire to receive only helpful and relevant evidence with the cost to the parties of procedural intervention. We also have to work within our resources. There are more than 1,000 new contested trade mark cases each year and only 11 Trade Mark Hearing Officers (who also cover registered design and company name cases). However, TPN 1/2015 introduces new measures aimed at excluding irrelevant and unnecessary evidence. The new practice will mean that we will be intervening

more in future in order to focus the evidence we receive onto the relevant issues.

If a party wants to cross-examine (or seek disclosure), or subsequently exceeds the "agreed" borders of the case set at the CMC, should they be concerned with the cost implications?

I do not think that seeking cross-examination or disclosure should automatically take costs outside the scale. Either course of action may be necessary in order to prosecute the case effectively. However, acting unreasonably may justify a different approach to costs. Making unnecessary requests for cross-examination

and/or disclosure may constitute unreasonable behaviour, as may flouting directions as to the scope of cross-examination. However, there is a difference between flouting directions and making an honest mistake. The former may have cost implications, but the latter should not.

The costs of cross-examination are already covered by the scale. Exposing weaknesses in the other side's case is not a reason to go "off-scale". Although, if a party is exposed as having tried to mislead the tribunal with its evidence (as a result of cross-examination or otherwise), the Registrar can and will treat that as unreasonable behaviour and award appropriate compensatory costs.



BB: I agree with Denise that you absolutely must know the issues and documents in the case back to front. I'd add that you must lay the groundwork for the question you really want to ask by first asking questions that close off potential avenues of escape. Also, make sure you ask short, clear, focused questions that contain only one issue.

JS: I would just add: one, know the materials better than the other side; and two, target the cross. There are specific things you will want to get out of the cross – clarify x, undermine y, etc. Target questions to this and this alone, and know when to stop!

AJ: For my part, most cross-examination I have seen in recent years has been relevant, well targeted and proportionate. In the past I have sometimes had to endure cross-examinations that went on for longer than was productive and/or tested inappropriate or irrelevant issues. I learned lessons from this about how to conduct efficient case management in this area; Tribunal Practice Note (TPN) 3/2010 on the procedure for cross-examining witnesses was the result.

Do you think the Registry allows counsel/attorneys enough leeway with witnesses, not enough, or is too slow to stop questions that are clearly not getting anywhere?

JS: The only comment that I would make on this is that the UK IPO is sometimes too willing to restrict the scope of the cross beforehand – ie, looking at the justification for the cross and limiting it before the event.

BB: Cross-examination in the Registry is, by the nature of the proceedings, always going to be shorter and more focused than in the Court. Where the Hearing Officers may err is in not appreciating that the key question needs to be worked up to before being asked. However, in my experience, the Hearing Officers have been good about allowing adequate amounts of time for cross-examination without permitting overrunning. It is up to the advocate to help them in that task by very carefully preparing their cross-examination so that the danger of flab is minimised.

DM: Yes, as far as my own experience is concerned, the IPO Hearing Officers

handle matters very well and do not restrict the proper conduct of the process of cross-examination.

Is there anything you would like to add on this subject?

DM: I would observe that in the IPEC (and, to an extent, in the High Court) there is now a tendency to rather put the brakes on cross-examination; to “guillotine” time permitted for cross-examination and also to limit it quite stringently to specific and pre-determined issues and, in some cases, specific questions. Before the UK IPO, it is obviously much more relevant in situations where the cases are irreconcilable, the Hearing Officer must resolve which witness is to be preferred, and usually the only practical manner in which this can be done is via the action of cross-examination.

AJ: We are not aiming for a perfect system of justice for those who can afford the cost of it. Our aim is to provide a system that is fit for the purpose of resolving trade mark oppositions and cancellations. The quality of our decisions has long been well respected. Our challenge is to maintain or enhance that level of quality while at the same time making the system accessible and affordable to all those businesses with a need to use it. Cross-examination has its place in such a system, but it should only be used when necessary, and where the cost of it is proportionate to the likely significance of the evidence at issue and the commercial significance of the IP right at stake.

JS: Our hearings (and the fact that they are accessible) are a stand-out point for the UK against many other systems, including OHIM. We should champion this and make the UK a centre of excellence – cross is a high-level tool reflecting an advanced and subtle approach to evidence and is one of the things that will help us to stand out.



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MASTERCLASS:
Denise McFarland

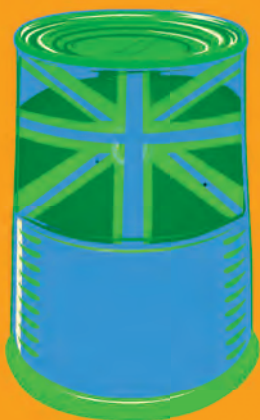
Is there a “type” of witness that is toughest to cross-examine?

The witness who appears relaxed, open and friendly, but is usually voluble and, despite “doing his best”, gives answers that appear reasonable (ie, “I can’t fully recall”, or “that may be so”) but are in fact evasive and unhelpful. Or the witness who is keen on being cross-examined so that they can let loose the floodgates and suddenly a huge amount of (and for the witness’s own side, very helpful and persuasive) additional evidence comes flooding out! Once the genie is out of the bottle, and that material is in the case, you cannot seek to strike it out or have it ignored by the Tribunal. You have allowed it to be introduced by asking questions and you must live with those consequences.

How does cross-examination in the Registry compare to that in the courts?

There is no discernible difference save that in some isolated cases one feels that the witness is, perhaps, less “intimidated” or “in awe” of the Tribunal than they are when they are called to the witness box in the High Court.





The UK's brand champion

John Noble celebrates two decades of advocacy and achievement by the British Brands Group

The 1994 Trade Marks Bill coincided with a significant shift in UK grocery. Retailers' own-label products that had been around for decades and were typically (but not exclusively) the cheapest on display were being re-positioned as quality products in direct competition to branded products. The re-positioning presented a challenge: how to convince shoppers that new proposition was worth trying?

Rather than adopt the costly traditional free offers, sample packs and lower prices to prompt trial, some supermarkets chose to adopt pack designs that mimicked familiar brands. An example was Sainsbury's Classic Cola, which looked like Coca-Cola and attracted national media headlines.

Brand owners were not flattered. Not only were direct competitors copying them, diluting their distinctiveness and misleading shoppers, but now their retail customers were joining in. Meanwhile, legal advice indicated that taking action would be costly and the

outcome uncertain. Frustrated by the lack of an effective remedy, the Bill was seen as an opportunity to improve matters. Looking around for an organisation to represent them, none could be found that was either willing or did not have a conflict. Undeterred, brand owners set up their own advocacy concern, the forerunner of the British Brands Group.

The principles that guided the Group 20 years ago are still relevant today. There continues to be a shared belief that shoppers are best served where there is vigorous but fair competition and a climate that encourages brand investment. The outcome is a wide choice of quality, innovative and reputable products, distinctively presented.

Early lesson

An early lesson was that people do not necessarily understand branding and the contribution it makes. In the 1990s, the case for brands was not well articulated and 'brand' could mean 'product', 'trade mark' or 'corporate identity', depending on who you spoke to. The Group and others started to fill this void with articles on the



consumer and economic value of brands, covering topics such as why anti-sweatshop campaigners should be pro-brand. In 2000, the Brands Lecture series was launched and, more recently, in-depth studies have been commissioned on the relationship between brands and responsible business, and the role packaging plays in competitive markets, for instance.

One study, commissioned from the Westminster Business School in 2008, looked for the first time at the value of brands to the UK economy. It found that companies spent some £33 billion per year (the equivalent of 2.3 per cent of GDP) building brand equity, an investment that contributed some £16 billion to the UK economy, around 12 per cent of all intangible investment.

This latter finding was significant. Some economists considered branding a zero-sum game, a question of rivalry between competitors with no wider economic benefit. The study, however, pointed to some significant benefits – the reassurance that products and markets were safe, the faster take-up of new ways of living and working, a spur to innovation as companies fought to sustain reputations, and that brands strengthen the reputation of British products abroad, supporting exports.

The 2013 WIPO report *Brands – Reputation and Image in the Global Marketplace* built on this work. It highlighted the dearth of data on brand investments, citing the US as the only country with a dataset that covered the range of activities involved in brand building. It concluded that brand investments are at least twice as large as previously estimated, exceeding investment in R&D and design combined. Interestingly, it found that brand investments correlated closely with the level of economic development and that middle-income economies such as China and India are investing more in branding than high-income economies did at a comparable stage of development. To companies intent on building strong brands, these findings are not surprising. As Jeremy Bullmore, former Chairman of JWT, articulated in his Brands Lecture, ‘Posh Spice and Persil’, brands rest in the

In the 1990s, the case for brands was not well articulated and ‘brand’ could mean ‘product’, ‘trade mark’ or ‘corporate identity’

minds of individuals and are not owned by companies. They are built over time, like birds build nests, using material from many sources. Strong brands represent strong connections between companies and individuals and are the source of competitive advantage. As such they are often a company’s most important assets, in many cases accounting for well over 40 per cent of their market value.

Policy focus

The Group is intent on ensuring brands are taken into account in key policy decisions. Branding and national health policy recently came together over plans to place tobacco products in standardised packaging, a significant intervention in the market with important IP implications. The Group pressed for the policy to be evidence-based, with the risks of dramatically weakening branding in a market to be taken into account. These were reflected, in turn, in the Impact Assessment, although evidence on the impact remains controversial.

A world-class, effective, user-friendly IP regime is an important goal for the

Group, which made submissions to the Gowers and Hargreaves Reviews and has an ongoing, important dialogue with the Intellectual Property Office. At European level, a representative of the Group chairs the AIM (European Brands Association) Trade Mark Committee, which is closely involved in the detail of the Trade Mark Package and contributes to a number of OHIM committees, all with the goal of improving the trade mark system in Europe. While a constant focus on the UK’s IP regime is important, the Group’s policy work has wider scope. A mission to support vigorous but fair competition takes it into areas of competition policy, selective distribution and fair dealing.

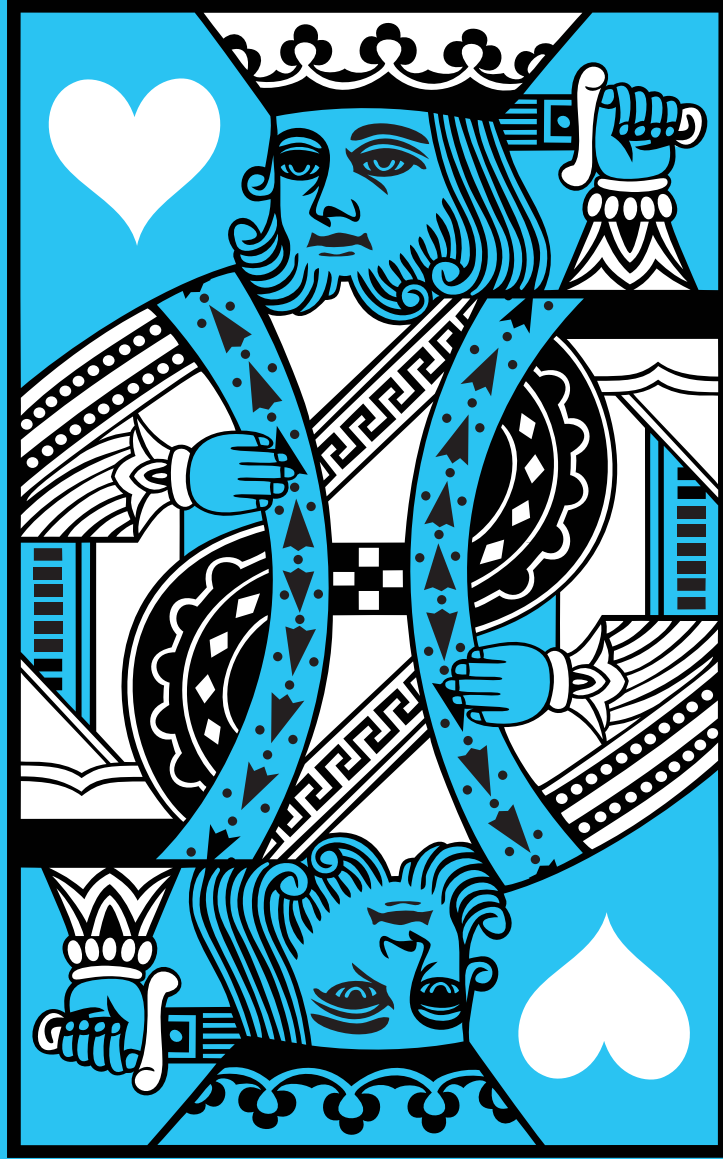
Since 2001, when the Competition Commission first sought to remedy anti-competitive practices in the grocery sector, the Group has monitored the efficacy of the Supermarket Code of Practice and, more recently, its stronger successor, the Groceries Supply Code of Practice (GSCOP), introduced in 2010. The Group helps members use the Code, keeps them informed, monitors practices and trains their teams on how to use it appropriately.

An organisation that started as a single-issue lobby group seeking an amendment to the Trade Marks Bill has evolved into a highly active collective voice with important successes under its belt: a growing membership; a growing appreciation of the value of brands; improving trading relationships in grocery; a trade mark exhaustion regime that reflects the high costs of business in the EU and the importance of innovators; and a government study and consultation on parasitic copying, the catalyst that prompted the formation of the Group 20 years ago. IP remains a fundamental part of its work, being an essential building block for brands, and that is unlikely to change.



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WHO WILL RULE OVER WHOIS?

*Paul McGrady Jr reports on preparations for a handover
of power over domain name registration data*

Accuracy, accessibility, and verification and validation for domain name registrations remain hotly contested issues within the ICANN community

For intellectual property rights holders, investigating possibly infringing domain names and website content usually begins by searching for the registered owner of the domain name. But this information can be inaccurate, protected by privacy services, or hidden by proxy services, which frustrates investigative efforts. Though progress to increase accuracy and reliability has been slow at the Internet Corporation for Assigned Names and Numbers (ICANN), reforms are finally being implemented and clearer policies are beginning to emerge. And by 2017 an entirely new system and set of policies for domain name registration information is due to be in place.

ICANN coordinates, pursuant to a contract with the US Government, the Internet Assigned Numbers Authority (IANA) functions, which are the technical services for operating the internet's Domain Name System (DNS). This system allows internet users to connect with other computers with the use of unique identifiers, through names or numbers.

As readers may be aware, to register and operate a domain name (to become a "registrant") the individual, business, organisation or government must go through an ICANN-accredited registrar or registry. A registry is responsible for the delegation and operation of an entire top-level domain (TLD), eg ".com" or ".guru". Most open TLDs, like .com or .guru, are administered by a registry but then sold through registrars acting as

retailers. Registries have traditionally not been in the business of selling individual domain names; the more common method by which one registers a domain name is through a registrar. The registrant information for a domain name can be held with the registrar or registry, depending on the TLD.

Registrars and registries are subject to agreements with ICANN. These agreements require, among other things, that any registrants with which they do business provide accurate identifying and contact information. This information, which may include a name, address, email, and telephone number, is commonly known as "WHOIS data".

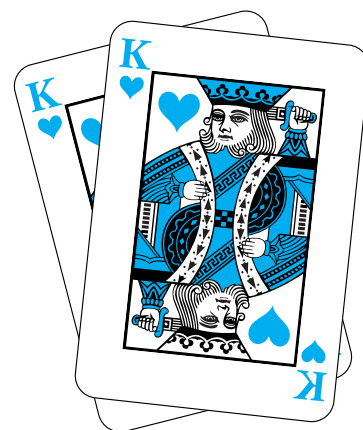
WHOIS requirements have remained largely unchanged since 1999, but have generated a lot of debate in the ICANN community, mainly between those involved in trade mark, copyright, and law enforcement on one hand and registrars on the other. Recently, though, policies aimed to advance the accuracy of registrant WHOIS data have prevailed and are being implemented. Further, something close to a complete overhaul of the WHOIS system is in development. With these changes, accuracy, accessibility, and verification and validation for domain name registrations remain hotly contested issues within the ICANN community.

New obligations

All obligations for WHOIS data exist in the accreditation agreements. These agreements are occasionally revised and updated, and in the 2013

Registrar Accreditation Agreement (2013 RAA) several important updates went into effect. Privacy and proxy service providers were previously outside of the scope of the agreements, but the 2013 RAA obligates registrars to require privacy and proxy services used by its registrants to disclose service terms, publish an abuse or infringement point of contact, disclose business contact information on their websites, and publish terms of service and a description of procedures on their websites.

In addition, the 2013 RAA imposes a WHOIS accuracy specification, providing for the verification of the registrant's listed email or telephone details through the use of an automated code or a link to authenticate. The 2013 RAA also requires validation of the presence of data in all required information fields, that email addresses and telephone numbers are properly formatted, and that postal addresses are properly



formatted for the applicable country or territory. Upon a failed verification, the registrar must either validate the information manually or suspend the registration. As of October 2014, more than one million domains had been suspended and many have complained that there is no evidence these suspensions have reduced domain name fraud and abuse.

The current verification system creates an all-or-nothing suspension option upon a failed validation, and registrars consider that an inelegant option. Registrars complain that because of the size, scale and speed of the industry, validation is difficult to administer and there has been no discussion on an acceptable level of false positives. From a law-enforcement perspective, however, investigations of fraud, abuse, or other nefarious behaviour, begin with attributing that conduct early in the investigation process and thus validation requirements are justified.

Updates to and guidance on the 2013 RAA requirements to make WHOIS data more accessible will continue to develop as there has been strong support from members of the ICANN community. Most recently, for example, ICANN announced additional requirements for making available sponsoring registrar

The current verification system creates an all-or-nothing suspension option upon a failed validation, and registrars consider that an inelegant option

information, including the status codes used by registries and registrars, and clarifications to the 2013 RAA requirements that must be implemented by 31 January 2016. Hopefully, the trend towards more accessible and accurate information for WHOIS users will continue.

Accuracy reporting

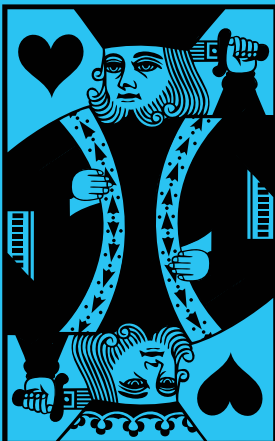
While the 2013 RAA changes were being developed and put into effect, the 2012 ICANN Board had mandated a project called the WHOIS Accuracy Reporting System (ARS) to produce statistical reports on the accuracy of WHOIS data. ARS was designed to identify existing inaccurate WHOIS records, explore the use of automated tools, forward potentially inaccurate records to registrars for their action, and publicly report on resulting actions. The project sought to provide transparency to the accuracy of WHOIS records, derive data to inform changes to WHOIS policy, determine whether the 2013 RAA contractual changes and policy changes increased accuracy, and enhance ICANN's contractual compliance activities through access to automated tools to examine data elements in the WHOIS record.

As part of ARS, the National Opinion Research Center at the University of Chicago, in collaboration with other private and public sector validation specialists, conducted an accuracy pilot programme to assess WHOIS validation efforts, which

studied syntactic and operational validation for emails, postal addresses and telephone numbers by using live WHOIS data. Syntactical validation assesses whether WHOIS data exists or is missing from within data fields and if it meets standards of formatting and structure. Operational validation assesses if contact information works and involves the use of non-WHOIS data to inform accuracy.

Preliminary findings were published in October 2014 and reflected, not surprisingly, that the 2013 RAA contributed to improved accuracy rates. The study and its methodology were open for comments in February 2015.

The more controversial and contested issue is whether the ARS should include identity validation checks. Identity validation seeks to confirm that WHOIS data corresponds to the person or entity listed as the registrant by attempting to contact the listed registrant based on the WHOIS information. Due to cost, complexity and time, the study did not pursue identity validation, but discussion sessions were held in early February at the ICANN conference in Singapore. ICANN is currently seeking requests for proposals for an identity validation system and considering vendors that can provide those services. Many feel, however, that identity validation requires additional policy development to determine whether the process is warranted or



even permissible. That sentiment stems from the understanding that WHOIS is about managing points of contact and not about preserving or managing identities; that is, verifying what is contained in the WHOIS data is not the same as verifying identity. Moreover, some have voiced the opinion that community members should simply lobby their governments for website disclosure laws instead of requiring that policy to develop within ICANN. Additional syntactical and operational validations will be conducted through 2015. There are no plans at the moment for identity validations.

Future development

Also in the works is a replacement for the entire WHOIS system. ICANN policymakers were deadlocked on how to balance privacy, accuracy and accountability, and so a working group was formed in 2012 to make a recommendation for a WHOIS successor: the Registration Directory Service (RDS). The group's recommendations were released in June 2014 and will serve as the foundation of the RDS. The RDS has moved now to the early stages of a policy development process. The report proposed a "gated access" system for registration data; only a minimal amount of public data would be available, and access to more data would require the searcher to identify, agree to be held accountable, and declare some permissible purpose for access. The permissible purposes are, to name a few, domain name control, legal actions, criminal investigations, regulatory contractual enforcement, and academic DNS research.

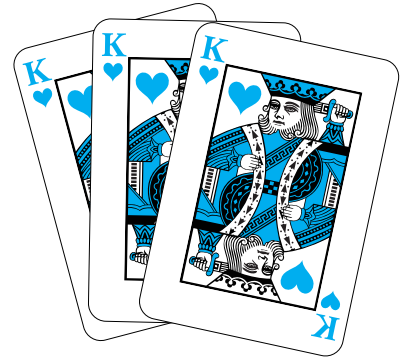
The working group's report also gave recommendations to improve the validation of all gTLD registration data at the time of collection and periodically. The working group also recommended that there could be the possibility for a prevalidation feature. Due to these additional obligations,

registrars maintain that the validation procedures suggested in the final report and in the ARS pilot programme are overly burdensome. The implementation of the new RDS is expected by 2017, when the 2013 RAA expires. Currently, ICANN is in the early stages of developing its new policies, though the working group's final report is a reliable indicator of their likely shape. ICANN is beginning its policy development process in April and May of this year, and a final report is expected in December 2016, with ICANN Board approval in early 2017.

Also expected to take effect by 2017 is the new privacy service and proxy service accreditation programme. There is expected to be a final report on policy recommendations in June 2015 with ICANN Board approval in July 2015. Implementation work will then begin, leaving the community rushing toward a 1 January 2017 deadline set by the 2013 RAA, though it appears that ICANN staff have begun pre-implementation preparations. The 2013 RAA interim specifications will remain in effect until development of the privacy and proxy service accreditation programme is concluded or until the deadline in the 2013 RAA. One hopes that registrars will not filibuster the effort.

Critical transition

All of these WHOIS developments take place during a critical time in the evolution of internet governance. Dominating much of the attention of the internet community is the upcoming IANA stewardship transition. The operation of technical functions for domain names is currently overseen by IANA, and



ICANN operates these functions under a contract with the National Telecommunications and Information Administration, an agency of the US Department of Commerce. The contract is set to expire this year on 30 September (although the US can renew) and the US has asked ICANN to convene global community stakeholders to facilitate and develop proposals for the stewardship handover to the multi-stakeholder community, in the hope that it can be done before the contract's expiration. Accordingly, members of the internet community have been working to prepare a transition plan that meets the US Government's requirements. Despite the focus on the IANA stewardship transition, implementing WHOIS reforms and establishing policy at this juncture are still absolutely necessary to ensure that, no matter what system is in place after the transition, the process by which registration data is collected and made available is accurate and reliable.



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DAYS IN DESIGNS

*Ewan Grist examines the past 12 months
in design and copyright law*

There have been a number of interesting developments in design law in past 12 months, driven both by the courts and sweeping reforms to design legislation in the UK.

The number of design cases involving the fashion industry has been particularly notable, the first of which was the *John Kaldor Fabricmaker UK Ltd v Lee Ann Fashions Ltd* [2014] EWHC 3779 (IPEC). The Claimant's claim for copyright and unregistered Community design right infringement failed as it could not demonstrate that the Defendant had copied the fabric designs in question. While there was an

opportunity to copy and sufficient similarity between the designs to give rise to a rebuttable presumption of copying, the Defendant was able to satisfy the Court that it had created its design independently. This case again demonstrates the importance for designers (both as potential claimants and defendants) of keeping complete, contemporaneous records of the design creation process.

In *G-Star Raw CV v Rhodi Ltd* [2015] EWHC 216 (Ch), covered at length in the May issue of the *ITMA Review*, the Judge held that the Defendant's jeans infringed G-Star's unregistered UK design rights for its "Arc Pant" jeans design. The Judge noted that the test of infringement of unregistered design right was different to that of

infringement of copyright: the former requiring that the design is copied so as to produce articles exactly or substantially to the design, the latter requiring that a substantial part of the work is copied. However, he said that the extent to which the two tests would produce different results would depend on how the design right was framed. In the case of unregistered design rights, the question of "part" came in at the stage of subsistence of the right, rather than at the stage of infringement. Interestingly, the Defendant's squeeze argument (ie that the similarity of the design corpus to the Arc Pant design should reduce the scope of protection afforded to it) was rejected. Squeezes are clearly legitimate in respect of registered

design cases, where the scope of a registration is determined by its degree of novelty and individual character, but are of more limited application in unregistered UK design right cases, where the design need only be original and not commonplace.

Instructive decisions

There were also instructive decisions on remedies for design infringement. In *Kohler Mira Limited v Bristan Group Limited* [2014] EWHC 1931 (IPEC), the Court had to consider, for the purposes of recovering damages for unregistered design right infringement, whether the Defendant knew or had reason to believe that design right subsisted. The Court noted that a defendant is generally likely to have good reason to suppose that design right subsists in an industrial article unless it has a particular reason to believe otherwise. The Court ultimately decided that damages were to be calculated on a reasonable royalty basis at 6.7 per cent of the net sales price of the infringing products.

In *Ifejika v Ifejika* [2014] EWHC 2625 (IPEC) (on account of profits), the Court had to determine the proportion of profit attributable to the infringing design feature of a product that comprised both infringing and non-infringing features. The Court did so on the basis of the functional importance, rather than the physical proportion, of the infringing feature.

At the Court of Justice of the European Union (CJEU), a notable designs judgment was *Karen Millen – Case C 345/13 Karen Millen Fashions Ltd v Dunnes Stores (Limerick) Ltd* – in which the CJEU answered various questions referred to it by the Irish Supreme Court concerning how individual character was to be assessed in respect of unregistered Community designs. The CJEU ruled that, in order for a design to be considered to have individual

character, the overall impression on the informed user must be different from that produced, not by a combination of features drawn from a number of earlier designs and mosaicked together, but by one or more earlier designs taken individually. This decision therefore recognises, if there were any doubt, that even if all of the constituent features of Community design were known in the design corpus, their combination may still be protectable.

Legislative changes

A number of important changes to UK design law were introduced by the Intellectual Property Act 2014 and came into force on 1 October 2014. Of these, the following are perhaps the most interesting:

Intentional copying of a UK or Community registered design

Previously, criminal offences for IP infringement were confined to copyright and trade marks, but it is now a criminal offence to intentionally copy a UK or Community registered design in the course of business, knowing or having reason to believe that the design is a registered design. It is, however, a defence to

show that the defendant reasonably believed that the registration of the design was invalid or not infringed and so businesses may be well advised to seek formal invalidity/non-infringement opinions before launching new products. The penalty on conviction is a fine and/or up to 10 years' imprisonment. The ramifications of this new offence are potentially significant for all businesses making or selling products. It remains to be seen how frequently and in what circumstances the authorities will be willing to pursue prosecutions.

Ownership of commissioned UK registered or unregistered designs

Contrary to the previous position, UK registered or unregistered designs in commissioned works will now be owned by the designer, unless it is specified otherwise in the commission contract.

Restriction on cropping UK unregistered design right

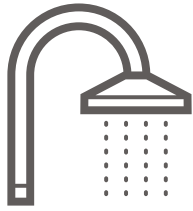
Previously, UK unregistered design right protected “the design of any aspect of the shape or configuration... of the whole or part of an article”. The words “any aspect of” have now been deleted with the intention of preventing the excessive “cropping” of the asserted design to just those small or trivial parts that may have been replicated in the allegedly infringing design. It is questionable whether this amendment will achieve its goal since design right can still subsist in “any part of an article”. The judges who have had to grapple with this amendment have thus far concluded that it made no difference at least on the facts before them.¹

Copyright

Much like design rights, copyright has been an active area of IP law over the past year. In particular, the CJEU has handed down several decisions relating to the fundamental way

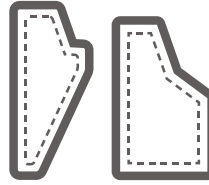
There must be a balance of the rights of copyright owners with the need to encourage innovation in new technologies

12 MONTHS IN 8 CASES



02

The **Karen Millen** decision recognised that even if all of the constituent features of a Community design were known in the design corpus, their combination may still be protectable.



04

In **Ifejika v Ifejika**, the Court determined a complex issue of infringement by considering the functional importance, rather than the physical proportion, of the infringing feature.

Kohler Mira Limited v Bristan Group Limited put the way in which damages are calculated in the spotlight.

01



John Kaldor Fabricmaker UK Ltd v Lee Ann Fashions Ltd John Kaldor failed to demonstrate that Lee Ann Fashions had copied the fabric designs in question.

03



that consumers use the internet, what is and is not permitted on websites, and what jurisdictional issues arise regarding online infringing activity. In addition, England and Wales legislated for several new exceptions from copyright infringement last year at the same time that the CJEU was making decisions regarding those same exceptions.

Case law

In June 2014, the CJEU handed down its much-anticipated judgment in *Public Relations Consultants Association v Newspaper Licensing Agency and others* (the *Meltwater decision*)² in which it held that general browsing of the internet by users did not infringe the exclusive right to reproduce a copyright work. Instead it held that the on-screen and cached copies of copyright material that are generated during the browsing/using process fall within the exceptions set out in Article 5(1) of the InfoSoc Directive, and as such, no authorisation or licence was required from the copyright owners of the material viewed. Considering the requirements of Article 5(1), the CJEU held that when a user visited a web page (in which copyright subsists), any reproduction made is only:

- temporary – users leave a web page for another (so the on-screen reproduction also goes) and the cache within a user's computer system will eventually be automatically replaced;
- incidental in nature – neither the material reproduced on-screen nor in the cached copy exist independently or have an independent purpose other than to permit a user to use the internet (ie the reproductions occur whether or not the consumer wants them to);
- an integral and essential part of the technological process of internet browsing in that the internet cannot function on a computer without those reproductions occurring.

In making its decision in the *Meltwater* case, the CJEU stated that when a national court is considering a defence under an exception to an exclusive right, the exception must be narrowly interpreted to protect the underlying right. However, it went on to state that there must also be a balance of the rights of copyright owners with the need to encourage innovation in new technologies.

In a series of cases³, culminating in *Pez Hejduk v EnergieAgentur.NRW GmbH*⁴, the CJEU stated that when determining the jurisdiction in which a claim for online copyright

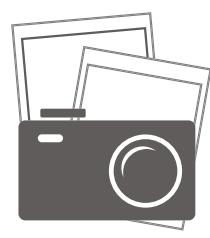
infringement can be brought (eg where copyright material could be purchased online in one EU Member State, but the servers hosting the website were in a different Member State), pursuant to Article 5(3) of the Brussels Regulation⁵ the action can be brought either in the place of the causal event of the damage or in the place where the damage occurred (provided the right which has been infringed is recognised in that jurisdiction). However, if the claimant chooses the jurisdiction where the damage occurred, it is limited to recovering only the damages that occurred in that jurisdiction (ie not damages for all infringing activity which would be available if the claim is brought in the jurisdiction where the causal event occurred). Therefore, while it may be more attractive for a claimant to bring an action in its home jurisdiction, this may have consequences as to the amount of recoverable damages.

UK exceptions

In June and October 2014, several new exceptions to English copyright law came into force. The June exceptions related mainly to extending the permitted use of copyright material to disabled people, educational and

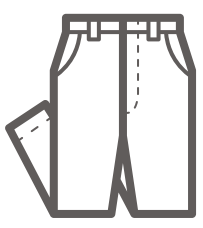
08

In **G-Star Raw CV v Rhodi Ltd [2015] EWHC 216 (Ch)**, the Judge noted that the test of infringement of unregistered design right was different to that of infringement of copyright.



06

Meltwater saw the CJEU decide that general browsing of the internet by users did not infringe the exclusive right to reproduce a copyright work.



07

The outcome of **Pez Hejduk v EnergieAgentur.NRW GmbH** suggested the choice of jurisdiction may affect the amount of damages recoverable.



05

Deckmyn determined that parody is a general concept which is to be applied consistently throughout the EU.

public bodies, and for the purposes of non-commercial research and private study. However, it was not until October 2014 that the more highly debated exceptions were enacted. The first of these exceptions is personal copying for private use.⁶ The new exception has several limitations, including the following:

- it does not extend to the copying of computer programs;
- it only relates to copying of lawful, permanent, purchases (therefore will not extend to copying from subscription-streaming services);
- the copies must be for back-up, format

shifting and made on personally accessible storage only (ie not in storage facilities open to multiple users); and

- the exception cannot be contracted out of.

This exception is currently under judicial review, as Article 5(2)(b) of the InfoSoc Directive states that exceptions to the exclusive rights of copyright owners can only be made where the rights holder receives fair compensation for that restriction. This requirement was recently upheld by the CJEU in the case of *ACI Adam*⁷ relating to levies being placed on blank CDs and CD-Rs that could be used for private copying purposes. The second major exception enacted in October 2014 is that of permitting the use of copyright material for the purposes of caricature, parody or pastiche.⁸ The legislation does not define what is meant by “parody”, however guidance on this point can be found in the recent CJEU decision in

*Deckmyn*⁹ in which it found that parody is a general concept which is to be applied consistently throughout the EU, the essential characteristics of which are that it:

- evokes an existing work;
- is noticeably different from that existing work; and
- is an expression of humour or mockery.

Whether something is a parody must also be considered in the light of local morals, therefore making it susceptible to different interpretations from one Member State to another.

Finally, an exception permitting the making of quotations¹⁰ for any purpose has also been introduced, provided that:

- the work quoted had been previously available; and
- the quote:
 - *complies with the requirements of fair dealing;*
 - *is no more than is required; and*
 - *is accompanied by a sufficient acknowledgement.*

¹ DKH Retail Limited v H Young Operations [2014] EWHC 4034 (IPEC) and Whitby Specialist Vehicles Ltd v Yorkshire Specialist Vehicles Ltd & Ors [2014] EWHC 4242 (Pat).
² Case C-360/13, 5 June 2014.
³ Peter Pinckney v KDG Mediatech AG, Case C-170/12, 3 October 2013; Hi Hotel HCF SARL v Spoeing, Case C-387/12, 3 April 2014.
⁴ Case C 441/13, 22 January 2015.
⁵ Council Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters.
⁶ Section 28B of the Copyright Designs and Patents Act 1988.
⁷ ACI Adam BV and others v Stichting de Thuiskopie and others, Case C 435/12, 10 April 2014.
⁸ Section 30A of the Copyright Designs and Patents Act 1988.
⁹ Deckmyn and another v Vandersteen and others, Case C-201/13, 3 September 2014.
¹⁰ Section 30(1ZA) of the Copyright Designs and Patents Act 1988.



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Parallel thinking

The Court clarified the test applied to market access in this pharma case, writes Antony Craggs

Madaus GmbH manufactured trospium chloride, an anti-muscarinic agent for the treatment of overactive bladder symptoms. It sold the drug in two forms (20mg and slow-release 60mg) via a distribution network in the EU under three brands in different jurisdictions, including CÉRIS in France, URIVESC in Germany and REGURIN in the UK. Its exclusive distributor in the UK was Speciality European Pharma Ltd. The large proportion (88.65 per cent) of prescriptions written for 20mg trospium chloride in the UK are written generically; 8.61 per cent are written by reference to the REGURIN brand, and 2.74 per cent are written by reference to other brands. UK prescription rules allow a prescription written generically to be satisfied by a branded or non-branded

product, but a prescription for a brand (such as REGURIN) can only be satisfied by that particular branded product.

In 2005, Doncaster Pharmaceuticals Group Ltd purchased CÉRIS-branded trospium chloride and over-stickered the box with the name of the active ingredient. It did not use the trade mark REGURIN. It then imported the goods into the UK. In 2009, the patent for trospium chloride expired. As a result, a number of generic

manufacturers entered the market. Doncaster Pharmaceuticals' parallel import was unable to compete with the price of the generic trospium chloride. Further, due to UK prescription rules, it could not satisfy prescriptions written for the brand REGURIN. As a result, on importing its CÉRIS- or URIVESC-branded trospium chloride, Doncaster Pharmaceuticals placed stickers on the packaging bearing the UK trade mark REGURIN. Consequently, Speciality European Pharma brought a claim against it for trade mark infringement. At first instance, it was successful. Doncaster Pharmaceuticals appealed to the Court of Appeal.

The issue

The Court of Appeal was left to decide the answer to this question: "[w]hen a pharmaceutical manufacturer

markets the identical product in EU Member State A under trade mark X and in EU Member State B under trade mark Y, in what circumstances can a parallel importer take the goods (marked X) from state A to state B and re-brand them with mark Y?" In particular, does the parallel importer need to show that it is hindered from entering a substantial part of the market, or is it a higher burden, for example, that it is prevented from access to any part of the market?

The law

The Treaty on the Functioning of the European Union prohibits "[q]uantitative restrictions on imports and all measures having equivalent effect..." (Article 34) unless they are "justified on grounds of ... the protection of industrial and commercial property [which includes trade marks]..." However, the "protection of industrial and commercial property" cannot constitute "a means of arbitrary discrimination" (Article 36).

This test is referred to as the "artificial partitioning of the market". In *Bristol-Myers Squibb v Paranova* [1997] FSR 102, the Court of Justice of the European Union (CJEU) explained that: "By stating that the partitioning in question must [not] be artificial, the Court's intention was to stress that the owner of a trade mark may always rely on his rights as owner to oppose the marketing of repackaged products when such action is justified by the need to safeguard the essential

function of the trade mark...” It then listed five conditions that must be satisfied by the parallel importer if the trade mark owner was not to be able to enforce its trade mark, one of which is: “Necessary to repackage to market the product.” For the purposes of the case at hand, it fell to be determined whether it was necessary for Doncaster Pharmaceuticals to use the UK REGURIN trade mark to market its parallel import.

In *Pharmacia & Upjohn SA v Paranova A/S* [2000] 1 CMLR 51, Upjohn marketed an antibiotic using the trade mark DALACIN in Denmark, Germany and Spain, DALACINE in France and DALACIN C in other EU Member States. Paranova purchased the antibiotic branded DALACINE and DALACIN C in France and Greece respectively, rebranded them DELACIN and imported them both into Denmark. Upjohn brought a claim for trade mark infringement. The matter was referred to the CJEU, which held that: “[t]his condition of necessity is satisfied if, in a specific case, the prohibition imposed on the importer against replacing the trade mark hinders effective access to the market of the importing Member State.”

“[H]inders effective access to the market” was expanded further by the CJEU in *Boehringer Ingelheim v Swingward* [2002] FSR 61. A specific question raised by the reference was the existence among consumers of a resistance to relabelled as opposed to repackaged goods. The Court held



The focus is not on what part of the market the parallel importer has access to, but on what part it does not have access to

that: “[t]he answer ... must therefore be that replacement packaging of pharmaceutical products is objectively necessary ... if, without such repackaging, effective access to the market concerned, or to a substantial part of that market, must be considered to be hindered as the result of strong resistance from a significant proportion of consumers to relabelled pharmaceutical products.”

The Court, therefore, needs to establish whether the parallel importer has been hindered from access to a substantial part of the market; not access to the market as a whole.

Decision

Lord Justice Floyd gave the leading judgment, reversing the decision at first instance and concluding that Doncaster Pharmaceuticals’ use of the REGURIN trade mark to market its parallel import was necessary. On the facts he reasoned that, in lieu of competing with the generics (which it could not do on price), Doncaster Pharmaceuticals would have to satisfy branded prescriptions. It could not do this unless it established CÉRIS, URIVESC or its own brand in the UK.

He concluded that this would not be practicable. He pointed to the evidence of Mr Wilson on behalf of Doncaster Pharmaceuticals, who said: “I think it would be very difficult to convince a doctor to prescribe a brand when they know that quite frequently, due to matters beyond our control, the supply will be interrupted. I think it would be a very difficult proposition to present to a doctor.” Mr Wilson later characterised this as a “fool’s errand”.

Author comment

To date, the jurisprudence of the CJEU has tended to be construed as meaning that, when assessing if a trade mark owner can enforce its rights, it is important to assess if the parallel importer has access to a substantial part of the market. In his leading judgment, Floyd J has clarified this test. He explains that the focus is not on what part of the market the parallel importer has access to, but on what part it does not have access to. The question is, then, if this is substantial. In this case, 8.61 per cent of the market (which accounted for prescriptions written for the REGURIN brand) was deemed substantial.



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Decision revolves around remit

Angela Thornton-Jackson reminds readers of the need for grounds to be considered and reasoned separately

Eriks Industrial Services Limited (Eriks) filed UK Trade Mark Application 2557947 REVOLVO on 7 September 2010 in relation to a range of goods and services broadly described as bearings and parts and fittings for bearings in classes 7 and 12, and consultancy and design services relating to bearings and parts and fittings for bearings in class 42. Volvo opposed the application under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act), relying on a number of earlier UK and Community Trade Marks for the word VOLVO in classes 7, 12 and 42, and unregistered rights in VOLVO for a broad range of goods/services in the automotive industry.

The Hearing Officer refused the opposition under section 5(2)(b) of the Act because he found that there was no likelihood of confusion between REVOLVO and VOLVO in class 12 (although the goods were found to be identical or highly similar).

Although he found moderate visual and aural similarity between the trade marks, he found that the marks were conceptually different, as the average consumer (agreed by the parties to be a specialist consumer) would see REVOLVO as an invented word (evocative of “revolve”) and that VOLVO was not the dominant

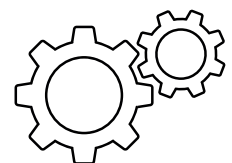
component in that word. The relevant consumer would know that the primary purpose of bearings was to rotate (revolve) to reduce friction. The Hearing Officer did not consider the Applicant’s goods or services in classes 7 and 42, or the Opponent’s grounds under sections 5(3) or 5(4)(a) of the Act because, to his mind, the Opponent’s position could be no stronger. The Opponent appealed on the basis that the Hearing Officer was wrong to have found no likelihood of confusion under section 5(2)(b) of the Act and erred fundamentally in failing to consider the oppositions under sections 5(3) and 5(4)(a) of the Act.

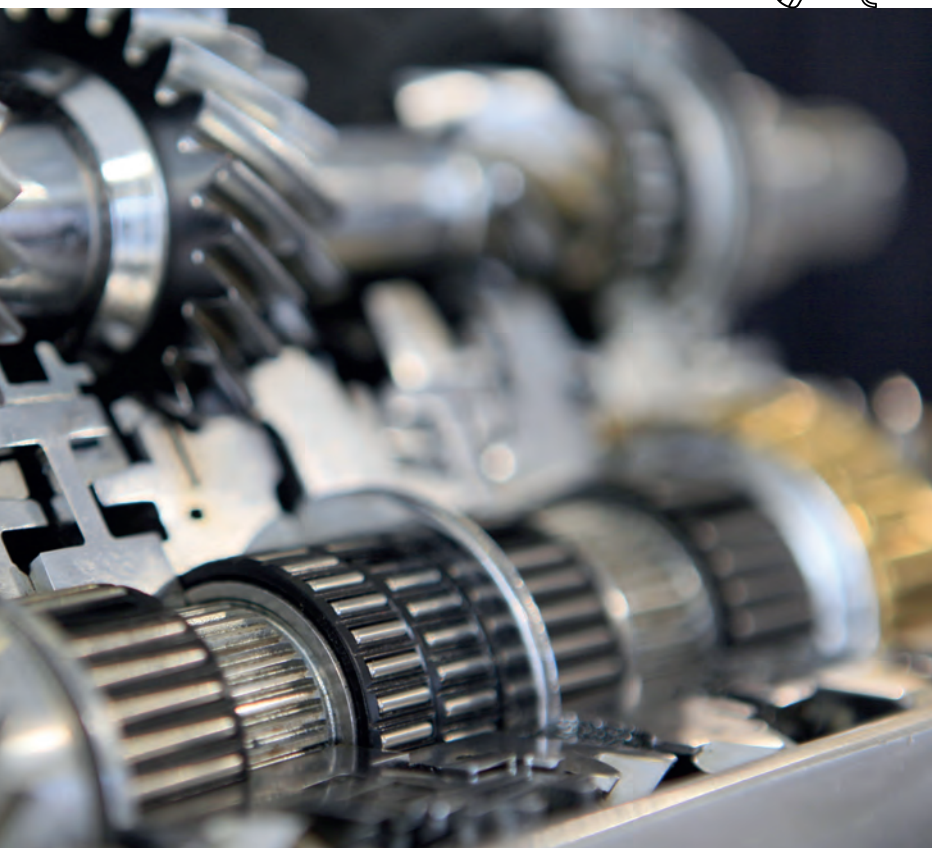
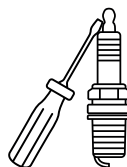
First ground

The first ground of appeal against the Hearing Officer’s findings under section 5(2)(b) of the Act was dismissed by the Appointed Person, Professor Ruth Annand. It was reaffirmed that an appeal is a review and not a re-hearing and, whatever the Appointed Person’s own assessment, she could not interfere with the decision in the absence of material error by the Hearing Officer (REEF Trade Mark [2003] RPC 5, paragraphs 28-29, BUD Trade Mark [2003] RPC 25, paragraph 12 and DALSOUPLE Trade Mark [2014] EWHC 3963 (Ch), paragraphs 34-35).



This case is a useful reminder of the remit of both the Hearing Officer at first instance and also that of an appeal





As the Hearing Officer had correctly directed himself as to the law governing the application of section 5(2)(b) of the Act, there was no error of principle and Professor Annand found that he was well within his decision-making powers in making the finding that the relevant public would not confuse the respective trade marks REVOLVO and VOLVO. In the absence of any survey or other evidence as to how the public would perceive REVOLVO in the context of the goods and services, the Hearing Officer needed and was entitled to form a view.

Further grounds

The second and third grounds of appeal succeeded. The Appointed Person found that the Hearing Officer failed either to consider the grounds for opposition under section 5(3) of the Act properly, or to give adequate reasons for rejecting it and failed to

properly consider the ground of opposition under section 5(4)(a) of the Act, even though the Opponent had fully argued that ground and provided extensive evidence.

Professor Annand pointed out that the issue was not academic. The Opponent had legal concerns (supported by evidence and argument) that, irrespective of likelihood of confusion, registration and use of REVOLVO in the UK for the subject goods and services would cause relevant damage to the reputation of VOLVO, not least because the Opponent would be unable to control the quality of bearings parts sold

under the later mark by the Applicant or its successor in future. The Opponent rightly had legitimate expectations that its case under section 5(3) of the Act would properly be heard and determined. With regard to section 5(4)(a) of the Act, Professor Annand pointed out that the test is not the same as for section 5(2)(b). Section 5(4)(a) is dependent on use, not registration, and the viewpoint is that of a substantial proportion of customers, not the average customer (Marks & Spencer PLC v Interflora Inc. [2012] EWCA Civ 1501, paragraph 34, Interflora Inc v Marks & Spencer PLC [2014] EWCA Civ 1403, paragraphs 107-128, Joined cases T-114/07 and T-115/07, Last Minute Network Ltd v OHIM [2009] ECR II-1919, paragraphs 60-65).

The Hearing Officer indicated that he had not considered the ground of opposition under section 5(4)(a) of the Act and Professor Annand thought it inescapable that the Hearing Officer had based his rejection of the case under section 5(4)(a) on his determination of section 5(2). The Opposition has been remitted to the Registrar for the grounds of opposition under sections 5(3) and 5(4)(a) to be determined by a different Hearing Officer.

Remit reminder

This case is a useful reminder of the remit of both the Hearing Officer at first instance and also that of an appeal. Although it is now well established post-REEF that the Appeal Tribunal may not simply substitute one opinion for another, the Hearing Officer must properly advance his reasons for deciding the case in the way that he did. Each ground of opposition must be considered and reasoned separately and tests under different grounds of opposition may not be conflated.



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Solid decision on Fetim

Once again the independence of national decisions was confirmed, reports Amy Galloway

On 6 February 2007, Fetim BV (Fetim) filed a Community Trade Mark (CTM) application for the mark shown in Figure 1 in class 19 for various building and flooring materials. Solid Floor Ltd (SFL) filed an opposition against the mark based on its UK trade mark for the mark shown in Figure 2 registered in classes 19 and 37, under Article 8(1)(b) of Council Regulation (EC) No 207/2009. The Opposition Division rejected the opposition and upon appeal the Second Board of Appeal of OHIM annulled the decision and refused Fetim's CTM. Fetim appealed to the General Court to overturn that decision and sought costs.

Fetim argued that, given the weak distinctive character of "solid floor", the Board of Appeal should not have taken into account the word element in order to compare the marks.

The Applicant also argued that SFL's mark had been accepted by the UK IPO based on acquired distinctiveness and that this distinctiveness stemmed more from the figurative elements than from the word element. Fetim also claimed that the Board of Appeal should have taken into consideration an earlier decision where the UK IPO had upheld an opposition brought against SFL's word mark for "solid floor" on the basis of the lack of distinctiveness. Had the Board of Appeal considered the UK IPO's decisions and confined its analysis to the figurative elements, then, according to Fetim, OHIM would not have concluded that there was any likelihood of confusion.

The General Court dismissed Fetim's arguments and maintained the Board of Appeal's decision to refuse the CTM application.

Mark comparison

Upon comparison of the marks, the General Court agreed that, given the size, position and secondary nature of the other word and figurative elements of the marks, the relevant public would view the dominant elements as being "solid floor". The fact that the word element has weak distinctive character does not imply that it cannot constitute the dominant element and is still capable of making an impression.

When addressing Fetim's arguments regarding the earlier decisions by the UK IPO, the General Court noted that, while the parties and the Court can draw on national case law, such law is not binding on the Court. The registrability of a CTM should be assessed by reference to the relevant Community rules and the Board of Appeal had not been bound to follow the UK IPO's analysis or decision when comparing the signs.

The General Court upheld the Board of Appeal's decision and ruled that there was partial identity and partial similarity in the goods and services of the respective marks,

which, together with the similarity of the signs, meant that there was likelihood of confusion between the marks.

Reminder

This case highlights that the lack of distinctive character in an earlier mark does not prevent a finding of likelihood of confusion in relation to a later mark.

Lack of distinctive character is just one factor to take into account. Moreover, an element of a sign (in this case the words SOLID FLOOR) can be dominant even if it has weak distinctive character.

The ruling also serves as a reminder that, due to the autonomous nature of the CTM system, national case law and registry decisions are not binding on OHIM when it assesses issues of registrability.

Figure 1: Fetim's mark



Figure 2: Solid Floor Ltd's UK trade mark



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T-505/12, Compagnie des montres Longines, Francillon SA v OHIM – Cheng (figurative mark) and **T-76/13**, Compagnie des montres Longines, Francillon SA v OHIM – Staccata (QUARTODIMIGLIO QM and device), CJEU, General Court (Fifth Chamber), 12 February 2015

Longines suffers clipped wings

Dual decisions were a blow for watchmaker, believes Donna Trysburg

Swiss watchmaker Compagnie des montres Longines (Longines) had a bad time in February, as a brace of decisions handed down on the same day by the General Court of the Court of Justice of the European Union confirmed that the OHIM Opposition Division and the OHIM Boards of Appeal (BoA) were both correct to dismiss two oppositions brought by Longines against device marks it believed to be similar to its so-called “winged hourglass” device. The decisions will be a blow for Longines, which has the distinction of owning the world’s oldest international registration for a trade mark still in use as originally filed, although that particular mark (an earlier version of its winged hourglass device) was not at issue in this dispute. Nonetheless, Longines would have been fairly confident of its reputation in its modernised winged hourglass logos, which were relied on, and which, according to Longines, had been in use since at least 1874.

The earlier marks

Longines relied upon the three marks depicted on page 33: Mark 1 (the solely figurative winged hourglass device); Mark 2 (a composite mark consisting of the winged hourglass device and the stylised word LONGINES); and Mark 3 (the same as Mark 2, but with a different stylisation of the word LONGINES and with the figurative element larger in

the overall composition). Longines’ rights stemmed from one Community Trade Mark (CTM) registration and a number of International Registrations designating various EU Member States and covering, broadly, a wide range of goods in class 9 and watches, watch accessories, jewellery and timing instruments/installations in class 14. Only Mark 1, covering class 14, was relied upon in case T-505/12.

Contested applications

The cases concerned oppositions brought by Longines against CTM applications for trade marks, each of which also contained a figurative winged element, on the basis of Article 8(1)(b) and 8(5) of Council Regulation (EC) No 207/2009 (CTMR). The CTM applications were filed by third parties who were unrelated to each other.

In case T-505/12, the opposed CTM application No. 8483562 was for a figurative mark (the “winged B device”) depicted on page 33, filed by Xiuxiu Cheng (Cheng) of Budapest,

Hungary, who sought registration of his mark for the goods “optical sunglasses” in class 9 and “clothing, footwear and headgear” in class 25.

In case T-76/13, the opposed CTM application No. 009260597 was for a composite mark (the “winged quartodimiglio device”) depicted on page 33, filed by Italian company Staccata Srl (Staccata), which sought registration of the mark for a wide range of goods in class 9, roughly corresponding to the Nice class heading, and “precious metals and their alloys, jewellery, precious stones, horological and chronometric instruments” in class 14.

Both oppositions were dismissed in their entirety by the Opposition Division. Longines appealed and the BoA dismissed both appeals, →





confirming the decisions and reasoning of the Opposition Division in full. Longines subsequently appealed to the General Court.

The decisions

No infringement of Article 8(1)(b)

In relation to the “winged B device” applied for by Cheng, the General Court held that the BoA was correct to find that the goods at issue were dissimilar. It followed that the BoA did not need to consider the similarity between the marks or any other factors relevant to the global assessment of the likelihood of confusion, the conditions for Article 8(1)(b) to apply being cumulative. The General Court went to great lengths, over paragraphs 49-80, to explain why the goods were dissimilar and dismissed all of the arguments put forward by Longines as irrelevant. The Court found that while goods such as sunglasses and watches/jewellery may belong to “adjacent market segments” and there may be a certain degree of “aesthetic complementarity” in consumers’ decision-making process, such as when a consumer buys jewellery to complement clothing, this was in itself too weak a link for the goods to be considered similar within the meaning of Article 8(1)(b). It also refused to accord any sort of special treatment to goods in the luxury sector, and pointed out that the goods, as defined in the application, could be sold at any price point.

In relation to the “winged quartodimiglio device” applied for by Staccata, it was not disputed that the goods were identical. When

comparing the marks, the General Court noted that the only feature in common was the representation of wings. However, the wings in each mark had different graphic designs, and this, combined with the inclusion of the verbal elements QM and QUARTODIMIGLIO in the later mark and LONGINES in some of the earlier marks distinguished the marks from each other, as consumers are more liable to recall and refer to the verbal elements of a mark for the goods in question. A “very low” degree of visual similarity was found. Consequently, the General Court held that the BoA was correct to find that there was no likelihood of confusion between the marks, due to the significant visual differences between them, the presence of the word elements and the high level of attention of the relevant public.

No infringement of Article 8(5)

The General Court found in both cases that Longines had proven a reputation in the relevant territories (a number of EU Member States) for watches and jewellery in their composite mark consisting of the stylised word LONGINES along with the winged hourglass device, but had not proven a reputation in the marks consisting solely of the winged hourglass device (with no verbal elements). Thus the purely figurative mark was excluded from the 8(5) comparison. The Court also considered whether the relevant public, having been faced with use of the composite mark, had noticed and memorised the figurative sign on its own, and concluded that it had

not, to the extent required to prove a reputation, despite the substantial quantity of evidence of use of the composite mark filed by Longines.

In relation to the “winged B device” applied for by Cheng, the only earlier mark relied on was the purely figurative winged hourglass device. The Court held that the BoA was correct to find that Longines had not proven a reputation in this mark, and so the Article 8(5) claim failed at the first hurdle. In relation to the “winged quartodimiglio device” applied for by Staccata, the Court found that the earlier composite marks relied on differed from the applied-for CTM in such a significant way, both visually and conceptually, that consumers would not make the necessary link between them, and so the claim under Article 8(5) CTMR failed. Weight was accorded to the stylistic differences in the respective wings, the Longines wings being thin and longer and the later marks being short and thick, and the presence of the words LONGINES and QUARTODIMIGLIO respectively, since consumers are more likely to focus their attention on the word elements for these goods.

Warning shot

The cases can be seen as something of a warning shot against trade mark owners with famous marks who try to extend their scope of protection beyond the monopoly granted by the law, in particular luxury brand owners, which may seem unfair as it is they who are most in danger of having unfair advantage taken of their prestige. It could be argued that

The cases can be seen as something of a warning shot against trade mark owners with famous marks who try to extend their scope of protection beyond the monopoly granted by the law

it shows a lack of pragmatism on the part of the Court to state that: “the fact that certain commercially successful fashion designers ... now manufacture not only clothing and footwear ... but also accessories ... constitutes, at the very most, an indication of a recent phenomenon which must ... be held to be somewhat marginal in the overall assessment of the market sector...” The commercial reality is that there is a huge degree of crossover in most fashion and accessories brands nowadays, across the whole price spectrum. Even for a brand that has started off in one particular product area it is the norm rather than the exception for that brand to diversify into other product areas following success. While the marks in question were not necessarily confusingly similar, arguably the Court should have found at least a low degree of similarity between the goods and proceeded to carry out the complete global assessment.

The cases also show that even long-standing use of a figurative element does not necessarily equate to enhanced distinctiveness or a reputation if used together with a word element. While surveys relating to confusion may no longer be welcomed by the courts, they do still have a role to play in relation to questions of acquired distinctiveness and reputation. Practitioners should note that if submitting evidence of use of a composite mark in support of a registration for a purely figurative element, some sort of specific evidence, such as opinion polls, consumer surveys or

independent trade evidence, should also be submitted to show that consumers recognise that figurative element alone as a source of trade origin.

Final observations

Practitioners and clients should also give thought to the composition of composite marks that they apply to register. The BoA had stated that its finding regarding whether or not use of the composite mark proved a reputation in the figurative mark could have been different, had the verbal element LONGINES been smaller in the overall composition of the mark and/or appeared below instead of above the graphic element, and the General Court appeared to agree with this statement.

Examiners will always attach significant weight to verbal elements of a mark; Longines was successful in a recent BoA decision for another “winged” mark without a verbal element whose design was arguably no more similar than the figurative elements of the marks in the cases discussed here.

It is also useful to note that the BoA agreed to take into account evidence filed before it that was not provided to the Opposition Division. The approach of OHIM is inconsistent in this respect, but this case shows

that, while ideally you should provide all evidence as early as possible in proceedings, there is no harm in trying to submit additional evidence at BoA stage, should it become available.

It is not yet known whether the decisions will be appealed.

Longines’ marks (“winged hourglass” with and without LONGINES)

Mark 1:



Mark 2:



Mark 3:



Cheng’s mark (“winged B device”)



Staccata’s mark (“winged quartodimiglio device”)



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Another round of the name game

Proof of use should be timely and clear, says Nick Bowie

This case concerns an opposition filed by Sucesores de Miguel Herreros, SA (the Opponent), the predecessor in title to the Intervener, Gestión de Activos Isorana, SL (Isorana) on the basis of Article 8(1)(b) Council Regulation (EC) No 207/2009 (CTMR), claiming a likelihood of confusion with its earlier Spanish trade mark registration for LOREN SCOTT, covering “clothes for ladies, men and children, included [sic] boots, shoes and slippers” in class 25.

The opposition was directed against Community Trade Mark (CTM) application No. 005190368 for L'Wren Scott, filed by L'Wren Scott in her own personal name and subsequently assigned to LS Fashion, LLC (the Applicant), covering goods in class 25. Within administrative proceedings, the Applicant requested of OHIM that the Opponent furnish proof of use of its earlier mark, which it duly did. Both the OHIM Opposition Division and Fourth Board of Appeal of OHIM (BoA) upheld the opposition, having found that the evidence submitted by Isorana of the earlier mark proved sufficiently that genuine use had been made of that mark.

Furthermore, the BoA held that the goods in question were identical or similar and that the signs at issue had an average degree of visual and

phonetic similarity, leading to a likelihood of confusion. On 24 November 2011, the Applicant brought an action against the BoA's decision to uphold the opposition. In support of the action the Applicant made two pleas: first, that the BoA was wrong to find that the evidence submitted by Isorana constituted genuine use of the earlier mark; and second, that the BoA failed to consider the inherent distinctiveness of the mark L'Wren Scott, resulting in the incorrect conclusion that similarity of the marks at issue resulted in a likelihood of confusion.

In support of its second plea, the Applicant submitted new evidence intended to prove that the mark L'Wren Scott was well known in Spain prior to the filing date of its CTM application. In doing so, it intended to prove that L'Wren Scott was conceptually dissimilar from Isorana's earlier mark, rendering the marks dissimilar and disproving the BoA's finding of likelihood of confusion.

Evidence dismissed

As it is not the Court's function to re-evaluate the factual circumstances in light of new evidence that has been adduced before it for the first time, the Court declared the Applicant's new evidence to be inadmissible and carried out its review of the legality of the BoA's decision based on the evidence disclosed during the administrative proceedings.

First plea

To prove that its earlier mark had been put to genuine use in Spain during the five years preceding the

This case provides a helpful reminder of the principles to be applied when considering genuine use of a trade mark

date of publication of the application against which opposition was filed (namely, from 15 January 2002 to 14 January 2007), Isorana submitted:

- several samples of clothing items upon which the LOREN SCOTT mark was affixed;
- a catalogue dated 2004 showing the LOREN SCOTT mark for clothing and headgear articles and indicating four addresses of Isorana in different towns on the island of Tenerife and a website;
- twelve invoices dated from 22 January 2002 to 12 April 2007, bearing the mark LOREN or LOREN SCOTT and totalling slightly more than EUR 600. The invoices were numbered and this numbering was spaced out, indicating the invoices submitted were purely illustrative.

Taking guidance from established case law regarding genuine use, the Opposition Division held that, while

the commercial volume and revenue from goods sold under the earlier mark was not high, it was offset by the fact that use of the mark was very regular and the unit cost of the goods was low. Given the invoices submitted as evidence formed part of a larger collection of invoices (which were not submitted), it was held that the invoices submitted reflected an illustration of the level of sales, rather than an absolute reflection of sales. As a result, in this case the Opposition Division held that use of the earlier mark was quantitatively significant in order for use of the earlier mark to be deemed genuine, a conclusion that the BoA upheld.

The Court was satisfied that the BoA had carried out an overall assessment of factors governing whether the mark had been put to genuine use, deciding that the evidence demonstrated that the sales effected constitute use that objectively was such as to create or preserve an outlet for the goods concerned. Therefore, the Applicant's first plea was rejected.

Second plea

The Applicant submitted several documents in support of its claim that its mark was wellknown in Spain. Of those, only one press article pre-dated

the date of application for registration such that the remaining evidence was not taken into consideration. The contested decision concluded that the admissible evidence did not show that Ms L'Wren Scott had celebrity status among the relevant Spanish public, with the consequence being that the relevant public would perceive the mark applied for as forming an autonomous conceptual unit, rather than as the mere association of two elements, namely 'l'wren' and 'scott'. It followed that the mark as applied for did not convey strong conceptual differences from the earlier mark. Thus, the Court agreed with the Opposition Division and BoA's finding that the signs at issue had an average degree of visual and phonetic similarity, leading to a likelihood of confusion. Therefore, the second plea was rejected and the action dismissed in its entirety.

This case provides a helpful reminder of the principles to be applied when considering genuine use of a trade mark, as well as ensuring that any evidence relates to the relevant timeframe.



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Board rejects bad faith

Jennifer Dzafic attempts to rein in a convoluted CTM case

A complicated ownership story can be read in the case report, but suffice it to say, a Mr Cx invented an “experimental learning” product and the name COLOURBLIND in 1991, and set up a company called Pangyrus Limited (Pangyrus).

In 1998, Cordyn Group Limited acquired shares in Pangyrus. Following the acquisition, Mr Cx continued to be employed as Creative Director until he resigned in 2003. He went on to set up another company, RSVP Design Limited (RSVP), the Intervener. On 28 August 2003, Mr Cx signed a document transferring his rights in the unregistered trade mark COLOURBLIND to RSVP. On 3 September 2003, RSVP applied to register the Community Trade Mark (CTM) COLOURBLIND. In December 2007, Pangyrus submitted an Application for a Declaration of Invalidity based on a claim that it had an unregistered right stemming from its use of the mark COLOURBLIND in the UK and a claim that RSVP acted in bad faith in applying for the CTM.

A first decision upheld the Application for Invalidity. The Cancellation Division decided that there was a common understanding between Mr Cx and the majority shareholder of Cordyn Group (Mr P) that the trade mark was owned by Pangyrus in 2003. Although Mr Cx was aware of this, RSVP (and Mr Cx) chose to file the CTM application, behaviour that the Division felt demonstrated that RSVP had acted in bad faith.

Key points

RSVP successfully appealed. The Board of Appeal (BoA) decided that

Pangyrus had not proved that it had used the earlier sign prior to the CTM application, and therefore did not have the requisite unregistered (passing off level) rights. Furthermore, the BoA decided that the bad faith ground also failed, as Pangyrus had not discharged its evidential burden (ie it had not shown any evidence that demonstrated Mr Cx had transferred the trade mark COLOURBLIND to Pangyrus or from which a transfer could be inferred).

Among the points discussed, the BoA decided that there was insufficient evidence of prior use by Pangyrus and no clear documentary proof of a goodwill owned by it. Invoices provided as evidence referred to a company called Future Factory, not Pangyrus. The invalidity action based on the ultimate 8(4) right had to be brought by the clear owner of the goodwill. There was nothing to support a claim to an implied licence between Pangyrus and Future Factory, underlining the importance of making sure the right party brings the action. Even though Mr Cx would have been aware of the use of the trade mark COLOURBLIND by these other companies, mere awareness of someone else’s use is not sufficient grounds to establish bad faith and does not preclude

The BoA decided that there was insufficient evidence of prior use by Pangyrus and no clear documentary proof of a goodwill

registration of that same mark as a CTM. The Applicant’s intention in applying for the trade mark must also be taken into account. There was no evidence that Mr Cx and RSVP wanted to stop Pangyrus from using the mark. It was found that RSVP had a clear commercial intention to use the mark when it applied and it was common ground that it then went on to use the registered trade mark.

Conclusion

This convoluted story is a good example of the difficulties facing those who wish to claim bad faith, and illustrates the importance of having evidence to back this claim up, no matter the strength of the emotions involved.



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Staggering decision

Jonty Warner feels there is still confusion surrounding renewal periods

The General Court has decided that, due to requirements of legal certainty, it is not permissible for requests for partial renewal of Community Trade Marks (CTMs) to be staggered over the initial and grace periods provided for renewal in relation to different classes.

Background

Nissan Jidosha KK (Nissan) owns a figurative CTM for CVTC for goods in classes 7, 9 and 12 (see right). In 2011, Nissan requested renewal of the mark in respect of the class 7 and 12 goods only. OHIM subsequently informed Nissan that the registration for the class 9 goods had been removed from the Register. It rejected Nissan's subsequent requests to include the class 9 goods in the renewal.

The First Board of Appeal dismissed Nissan's appeal on the grounds that its request for renewal in respect of the goods in classes 7 and 12 constituted an express and unequivocal partial surrender in relation to the goods in class 9.

Nissan appealed, arguing that (*inter alia*) Article 47 of Council Regulation (EC) No 207/2009 (CTMR) permits requests for renewal of CTMs to be staggered over time. The first sentence of Article 47(3) provides that a request for renewal must be submitted within a period of six months ending on the last day of the month in which protection ends ("the initial period"). The third sentence of Article 47(3), meanwhile, provides that "failing this" requests may be submitted and fees paid within a further period of six months ("the grace period"),

provided that an additional fee is paid within that period.

General Court decision

The General Court determined that the Board of Appeal was wrong to treat Nissan's request for partial renewal as equivalent to an express and unequivocal partial surrender in respect of the class 9 goods.

However, the Court dismissed Nissan's appeal. In particular, the Court held that it was clear from the wording of Article 47(3) and the use of the word "failing" that the six-month grace period is conditional upon the proprietor not having submitted a request for renewal during the initial period of six months. Further, neither the wording

of Article 47(3) nor its broad logic permitted submission of successive requests for partial renewal during the initial period and the grace period in respect of different classes of goods or services. Given that a renewal of a registration takes effect *erga omnes* ("towards everyone") from the day following the expiration of the existing registration, legal certainty required that the proprietor of a mark could not be allowed to supplement its request for renewal after the renewal has taken place.

Comment

This case shows that great care and foresight is needed when dealing with partial renewal of registrations, since submitting a partial renewal during the initial period will bar further renewal requests in respect of the same mark during the grace period.

The Court did not, however, clarify if this prohibition on "staggering" extends to the submission of requests for partial renewals made within the same stage of the renewal process. Although the Court did not consider this point, such a practice would arguably be acceptable since legal certainty would not be affected.

The figurative CTM for CVTC



KEN WOLTER/SHUTTERSTOCK.COM



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Court says no to Sanskrit connection

Sharon Daboul is not at all surprised by this decision

Munindra Holding BV (the Intervener) had applied to register a Community Trade Mark (CTM) for the word PRANAYUR in classes 5 and 30, covering “herbal preparations”, among other goods. Three-N-Products (the Applicant) filed a Notice of Opposition on the basis of four CTM registrations, including the word mark AYUR and three figurative marks, all containing overlapping goods. The grounds relied on were Articles 8(1)(a) and (b) of Council Regulation (EC) No 207/2009 (CTMR).

The Opposition Division rejected the opposition and a notice of appeal was filed.

In the contested decision, the fourth Board of Appeal dismissed the appeal. The visual and phonetic similarity between the marks AYUR and PRANAYUR was rendered low, and any conceptual comparison was irrelevant; an insignificant part of the relevant public would understand either sign to be a reference to the Sanskrit word “ayurveda”. Any likelihood of confusion between the word marks was excluded, despite the identical and similar nature of the goods. In relation to the figurative marks, their similarity was even lower.

The Intervener, in the meantime, brought a successful action for a declaration of invalidity against the AYUR word mark (upheld upon appeal), leaving the Applicant to rely upon the three figurative marks only.

The Applicant sought an order that would annul the Board of Appeal decision and refuse registration of the mark PRANAYUR, alleging that OHIM did not analyse the likelihood of confusion between PRANAYUR and the earlier figurative marks, having based its analysis solely on a comparison with the earlier word mark.

The decision

The Court found that the analysis had correctly taken place; the earlier decision noted that the figurative marks included the word element “ayur” as well as additional elements of differentiation. It then concluded that there was no likelihood of confusion between each of the figurative marks and the mark applied for, having already determined that there was no confusion between AYUR and PRANAYUR.

The Court then considered the risk of consumer confusion. While the parties agreed that the goods were partly identical and partly similar, the Applicant argued that the signs at issue were also similar, due to the shared element “ayur”, a word that has an Indian origin, which it

claimed would be understood by the average EU consumer.

The Court agreed with OHIM that, visually, the marks were different, despite the common word element, and phonetic similarity was low due to the only shared element being the last syllable. The Court held that the general public would not easily make the connection between “ayur” and the Sanskrit word “ayurveda” (a form of traditional Hindu medicine) and a conceptual comparison was therefore impossible.

The Court held that there was no likelihood of confusion between the figurative “ayur” marks and the PRANAYUR mark.

Comment

This decision is not surprising to the writer. It confirms the importance of considering all the relevant factors in an assessment of likelihood of confusion between two marks. It also confirms that even when a mark has meaning to a part of the relevant public (in this case, the degree of attention was found to be average), where that meaning is not commonly understood it will not be significant to a conceptual comparison.



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Feature teacher

Philip Davies explains how narrowing the relevant public can be powerful

This was an invalidation case under Article 53(3) of Council Regulation (EC) No 207/2009 (CTMR). The General Court reviewed the Board of Appeal’s determination that FSA’s trade mark, FSA K-FORCE, should be declared invalid. The Intervener, Motokit, had relied on its earlier mark, FORCE-X, to support this claim.

The General Court disagreed with the Board of Appeal’s analysis and annulled its decision for several reasons, two of which stand out: first, the importance of identifying the relevant public, and second, that the Court of Justice’s judgment in Medion (THOMSON LIFE) should be narrowly applied.

Both the trade marks in question were registered for goods in class 9 (cycle helmets) and class 12 (bicycles and spare parts). It was not challenged that the goods in question were identical. Before the Board of Appeal, FSA had presented an argument that the goods in question were high-quality and expensive products, and thus the relevant public would pay more attention than the average consumer when purchasing them. This argument failed. In the General Court, FSA refocused its argument, saying that the goods had “specific technical characteristics”, and (for the helmets) a “protective objective”. This argument persuaded the General Court that the relevant public would be more attentive than the average consumer.

Successfully narrowing the relevant public can be powerful: it provides the context for the other tests the courts employ. Here, the determination that the relevant public was more attentive

than average gave context to the finding that the relevant public would find the word “FORCE”, which was present in both marks, to be descriptive and banal.

Marks comparison

In Medion, the Court of Justice was asked whether there could be a likelihood of confusion when a company name was added to a registered mark to try to create a new mark. The Court determined that when a company name had an independent distinctive role, but did not determine the overall impression of the mark, a likelihood of confusion could be found.



OHIM attempted to rely on Medion, arguing that because of the similarity between K-FORCE (which was contained within the later mark) and FORCE-X, essentially all FSA had done was to add its company name to the start of its mark. The General Court rejected this on the basis that the later mark did not contain the earlier mark. In other words, as K-FORCE and FORCE-X are not the same, the Medion test could not be applied.

Comment

This case teaches us that the claim that goods and services are expensive may not be persuasive, and that this is not the only way to narrow the relevant public.

Identifying what feature(s) of the goods distinguishes the relevant consumers can be much more successful. There is some room for creativity: that the consumers might be particularly risk-averse is a very good example. It also shows that Medion applies only to a situation in which an earlier mark is exactly repeated in a new mark. This finding is contrary to Mr Justice Arnold’s ruling in *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch) and a reminder that, except where an earlier mark is exactly reproduced in a later mark, whole marks will be compared, not just the parts of the marks that are similar.



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UK Husky marks its territory

Mira Haddag reviews the facts of a dog-eat-dog case

The Czech clothing company Husky CZ s.r.o. (Husky CZ) filed a revocation action against the Community Trade Mark HUSKY – a word mark registered by the UK company Husky of Tostock (Husky) Ltd on 6 April 1996 in classes 3, 9, 14, 16, 18 and 25 and renewed on 2 April 2006 – on the grounds that the mark had not been put to genuine use in connection with the goods in respect of which it had been registered.

Undated documents

After being granted several extensions of time, justified by the fact that the mark was used by a licensee and therefore it was difficult to provide timely evidence, Husky provided several documents including images and invoices that were undated. The Cancellation Division of OHIM granted in part the application for revocation, but allowed the mark to remain registered for bags, clothing and footwear.

However, Husky CZ sought cancellation for all goods and filed an appeal against the Cancellation Division decision. It claimed that Husky had failed to show evidence of genuine use within the relevant period and argued that OHIM erred in taking undated documents as a basis.

Unconvinced by Husky CZ's arguments, the First Board of Appeal

stated that the documents referred to by the Applicant were solely intended to show how the mark was displayed on the relevant goods and the fact that they were undated was irrelevant. The Board of Appeal also noted that the judgment in *Il Ponte Finanziaria v OHIM* (C-234/06), on which Husky CZ relied in its defence, was not applicable in relation to the genuine use of the mark.

Following the judgment, Husky CZ brought an action before the EU General Court.

Court decision

The EU General Court upheld the Board of Appeal decision and reaffirmed what has been established in previous cases (*Case T-418/03 La Mer Technology v OHIM – Laboratoires Goëmar*; *Case T-203/02 Sunrider v OHIM – Espadafor Caba*): that the assessment of genuine use should be overall and that all the relevant factors of a particular case should be taken into account. It is not necessary that each document provide indication of place, time, extent and nature of use. As a result, undated documents should be taken

Use of a slight variation of a mark can support registration when it does not alter the distinctive character of the mark itself

into account if they are relevant to establishing whether the commercial exploitation of the mark is genuine. The Court also reiterated that the use of a slight variation of a trade mark could support a registration when the use does not alter the distinctive character of the mark itself.

Conclusions

This case is a reminder of the correct approach to the assessment of evidence of use, and that the Court will consider the big picture when all relevant documentation is provided. It also highlights the importance of using a trade mark as closely as possible to the mark applied for, to prevent the loss of registration.



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events

More details can be found at itma.org.uk

Date	Event	Location	CPD hours
17 June	ITMA & CIPA Talk in Leeds Colour Issues, Simon Malynicz, Three New Square	Bond Dickinson, Leeds	1
17 June	ITMA Webinar Evidence in Trade Mark Proceedings, Amanda Michaels, Hogarth Chambers		1
22 June	ITMA Talk in Leeds Overlapping trade mark and passing-off actions in the UK and OHIM, Michael Edenborough, Serle Court	Bond Dickinson, Leeds	1
23 June	ITMA London Evening Meeting* IP Valuation, Jan Lindemann	Royal College of Surgeons, London	1
8 July	ITMA Summer Reception	The Little Ship Club, London	
21 July	ITMA London Evening Meeting* Domain Name/ICANN Issues, Susan Payne, Valideus	Royal College of Surgeons, London	1
17 September	ITMA Afternoon Seminar Representing before the Registry	Royal College of Surgeons, London	2-3
22 September	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
23 September	ITMA Autumn Seminar	Hyatt Regency, Birmingham	5
23 September	ITMA Autumn Drinks Reception	Hyatt Regency, Birmingham	
20 October	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
13 November	ITMA & APTMA Day Seminar and Dinner	Dublin	4-5



Our Summer Reception will set sail in July at the Little Ship Club in London

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I work as... Counsel at Locke Lord LLP in its London office. I also write for the *IPKat* and *MARQUES Class 46* blogs.

Before this role... I originally qualified as an Attorney-at-Law (*Rechtsanwalt*) in my home country of Germany and later as a Trade Mark Attorney, as well as a Solicitor. I have been lucky to work both in trade mark and patent attorney firms and law firms since coming to the UK.

My current state of mind is... curious.

I became interested in IP when... I studied law at Tübingen University back in Germany. I was most intrigued by a 1950s Bundesgerichtshof personality rights case in which a famous German equestrian objected to the unauthorised use of his photograph in adverts for erectile dysfunction drugs. With personality rights falling under the wider umbrella of IP rights, this is where it all started...

I am most inspired by... Professor Jeremy Phillips, academic and *IPKat* blogmeister extraordinaire – for his enthusiasm for all things IP and his humbling humanity.

In my role, I most enjoy... being at the forefront of legal developments, something that was unexpected and has proven rather exciting. I also like that it allows me to conduct research, write articles and speak at conferences abroad.



Birgit Clark,
Ordinary Member,
adds some
international flavour

In my role, I most dislike... the restricted opening hours of the firm's otherwise excellent canteen.

On my desk is... a photograph of my son and a picture calendar of the beautiful university town of Tübingen.

My favourite mug... says "Give up bad coffee for good".

My favourite place to visit on business is... Munich, despite not being Bavarian myself.

If I were a mark, I would be... VW Golf, understated but surprisingly nippy and efficient. (Even though my English husband believes that the equally German brand ALDI would be a better fit!)

The biggest challenge for IP is... the expansion of social media with all the benefits and challenges it brings for brand owners.

The talent I wish I had is... being able to cook food that other people will eat (and enjoy) too.

I can't live without... my family, black coffee, classical music, my deadline list and my secret stash of gluten-free crackers.

My ideal day would include... playing with my son, a sushi dinner with my husband, followed by an opera at the Royal Opera House in Covent Garden.

In my handbag are... all the usual items you would expect and a Lego toy car (Lightning McQueen).

The best piece of advice I've been given is... to always make the best of things because "that which does not kill me, makes me stronger".

When I want to relax I... listen to JS Bach's *Goldberg Variations* as played by Glenn Gould, 1955 recording.

In the next five years, I hope to... stay healthy.

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