

CITMA REVIEW

ISSUE 455 FEBRUARY 2020

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SENSE CHECK

*What does it take to support
colleagues on the autism spectrum?*

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WELCOME & CONTENTS



Tania Clark
CITMA President

“
Find out how our frustrations with the Chinese trade mark system have been somewhat tempered

We have now finalised plans for one of our most international Spring Conferences ever, with speakers and delegates hailing from Asia to South America, and which also includes a Gala Dinner at the Houses of Parliament in all their splendour. Don't miss our preview of the event on page 8. Then find out how our frustrations with the Chinese trade mark system have been somewhat tempered by the recent introduction of new provisions aimed at curbing bad faith applications, on page 16. Finally, IP Inclusive is going from strength to strength and on page 18 we offer an insight into how working practices could be modified to accommodate autistic colleagues.

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We've moved our HQ

What a difference a few metres can make! In January, our CITMA HQ team moved to a new address where we will take advantage of modern facilities and shared meeting spaces. But it didn't mean a complete change of scene: you'll still find us just across from the Royal Courts of Justice and minutes from Temple Tube station. Our new address is Thanet House, 231-232 Strand, London WC2R 1DA.



MILESTONE REACHED FOR MADRID SYSTEM

The World Intellectual Property Organization's (WIPO's) Madrid System has recorded its 1.5 millionth international registration and marks the "important milestone" in the same year the 30th anniversary of the Madrid Protocol was celebrated.

Colombia-based textile manufacturer Coltejer is the owner of the 1.5 millionth registration. On its application it stated 11 designations. In 2018, there were a record number of trade mark applications made via the Madrid System – 60,000 in total.

1.5 MILLION

IT'S TIME FOR OUR SPRING CONFERENCE

See page 8 for a preview of our CITMA Spring Conference – our most international event ever.
Book early to secure your place at citma.org.uk

IN MEMORIAM

In this issue, we pay tribute to two influential members



Sheila Florence Lesley OBE

As a child, it was seeing John Logie Baird, the inventor of the television, walking across the golf course in Bude that first sparked Sheila Lesley's interest in inventions. Then, before university, she worked as an analytical chemist at May and Baker in Dagenham, where a dispute with Boots in relation to sulphonamides brought patents to her attention. She decided not to pursue her original intention of doing chemical research and instead joined Forrester Ketley & Co. (now Forresters IP) in its Chancery Lane offices in 1953.

Sheila qualified under the guidance of the late Reg Howden in 1958, becoming the first woman to do so for 29 years and the third woman to become a Chartered Patent Agent. She became a partner in 1961, joint Senior Partner with the late Bruce Jack in 1983 and

then Senior Partner on his retirement until she retired herself at the end of 1996.

Her training and interests were particularly in trade marks and she was elected a Member and then a Fellow of The Institute of Trade Mark Agents (ITMA), as we were then known, in 1961 and 1986 respectively. She was our first woman President from 1981–1983 and was made an Honorary Fellow in 1992.

Sheila served on our Council and was the Chairman of our Law & Practice Committee for many years. She was its representative on the Standing Advisory Committee for Trade Marks (later Industrial Property). She made submissions and was part of a delegation from the Institute giving oral evidence to the Mathys Committee examining British trade mark law and practice in 1972. In 1982, she led our delegation, which gave oral

evidence to the House of Lords Select Committee on the European Communities (under the chairmanship of Lord Scarman) on the protection of trade marks within the Member States of the EEC. Sheila was also part of UK delegations that went to Brussels to discuss proposals for a Community trade mark, and served on the Community Trade Mark Office Committee.

In 1988, she was appointed OBE for her services in the field of patents and trade marks.

Alan Porteous

Alan was a qualified Trade Mark and Patent Attorney and was a partner at R.G.C. Jenkins, then at Grant Spencer Caisley, which became Grant Spencer Caisley & Porteous following his arrival. He made a significant contribution to the IP professions having served as an examiner for CIPA and ITMA, as well as being a member of our governing Council.

Educated at Chigwell School, Alan gained a degree



in chemistry from the University of Southampton before starting his career in intellectual property law.

He was known for his passion and recall of poetry and literature. He was also a crossword aficionado and came close to winning *The Times* annual crossword competition several times.

As well as his love of poetry and crosswords, his family and colleagues describe Alan as a very generous man who will be remembered for his humanity and kindness as well as for being irrepressibly optimistic.

MEMBER MOVES



Charlotte Duly joined Charles Russell Speechlys as Head of Brand Protection in its intellectual property group on 18 November.



Ruth Bryan moved to Stobbs IP in November to take up the role of IA Paralegal.

→ VISIT THE CITMA JOBS BOARD: CITMA.ORG.UK/JOBS

CITMA Event



SNAPS OF THE SEASON

Enjoy some festive memories from our CITMA Christmas lunches in London and Leeds



LONDON PHOTOGRAPHY:
SIMON O'CONNOR



CHRISTMAS BEGINS AT BROWNS

The CITMA Northern Lunch took place in the elegant environs of Browns Leeds, a former banking hall in the heart of the city.



Left to right: Alexandra Nott, Aaron Hetherington and Danielle Jeeves

CITMA EXAM AWARDS 2019

Some 600 guests in London applauded this year's high-achieving students.

AARON HETHERINGTON, BIRD & BIRD LLP

The CITMA award for the highest mark achieved by a Student member on the Trade Mark Law and Practice Postgraduate Certificate at Queen Mary University of London.

DANIELLE JEEVES, CLEVELAND SCOTT YORK

The CITMA award for the highest mark achieved by a Student member on the Postgraduate Certificate in IP at Bournemouth University.

ALEXANDRA NOTT, DEHNS

The CITMA award for the highest mark achieved by a Student member on the Professional Certificate in Trade Mark Practice course at Nottingham Law School.

DAN HARDMAN-SMART, STOBBS IP

The inaugural Roy Scott Award, formerly the CompuMark Award, for the highest mark achieved on the CITMA Paralegal Course. The award was presented for the first time having been renamed in tribute to CITMA Paralegal Roy Scott who passed away last year.



Spring Conference Preview



ONE STEP BEYOND

The Spring Conference 2020 will be our most international event yet

This year, we're expanding our outlook by inviting speakers from around the world to share their expertise at our Spring Conference 2020, on the theme of "Beyond trade marks: a global perspective". Not only will delegates hear the latest global updates on pharmaceuticals, advertising, case

law and more, but you will also have the chance to learn from speakers from the Americas, Asia, Europe and beyond. We're also offering you a once-in-a-lifetime chance to network with IP professionals from around the globe inside the iconic Houses of Parliament in London.





Rt Hon Lord Smith of Finsbury, Chris Smith, Chairman, IPReg

OUR UK AND INTERNATIONAL SPEAKERS:

AMERICAS

Argentina

Iris Quadrio, Marval, O'Farrell & Mairal

Brazil

Cristina Guerra, Guerra IP

Canada

Susan Keri, Bereskin & Parr

Mexico

Laura Collada, Dumont

ASIA

Hong Kong

Catherine Zheng, Deacons

South Korea

Jay Suh, SungAm Suh International Patent & Law Firm

EUROPE

Switzerland

Tapio Blanc, Hoffmann-La Roche AG

United Kingdom

- Charlotte Blythe, Hogarth Chambers
- Mark Caddle, Withers & Rogers
- Simon Chalkley, Wiggin LLP
- Stuart Helmer, CMS Cameron McKenna LLP
- Dana Narrainen, JC Decaux
- Rebecca O'Kelly, Bird & Bird
- Nick Phillips, Edwin Coe LLP
- Rt Hon Lord Smith of Finsbury, Chris Smith, Chairman, IPReg
- Catherine Wolfe, Boulton Wade Tennant



The Members' Dining Room at the Houses of Parliament

ALAMY

WARM WELCOME

On Wednesday 18th March, delegates will gather in a deluxe private suite at the recently refurbished Brasserie Blanc on London's South Bank for an evening of networking, drinks and canapés. This beautiful venue is just steps from the London Eye and all of the attractions of London's West End.

DINING WITH DISTINCTION

Our Gala Dinner will see us stalk the corridors of power and enjoy a unique dining experience in the Members' Dining Room at the Houses of Parliament. This impressive venue is adorned with beautiful flock wallpaper, wooden relief sculptures and fascinating paintings. The Royal Coat of Arms sits proudly above the main entrance, signifying the connection between the monarchy and parliament.

Before dinner, registered delegates will be able to take a tour of the parliamentary estate, including the House of Commons, Westminster Hall, the Prince's Chamber and more.

Tour places are limited, so these will be allocated to the first 150

delegates who book. Be sure to confirm your interest when you make your booking – and don't delay.

GLOBAL GATHERING

Day one will be a day of learning, discussion and networking at the centrally located IET London: Savoy Place. In the comfort of this recently refurbished venue, we will hear from our impressive speakers, including our keynote speaker The Right Honourable Lord Smith of Finsbury.

Highlights of day two include a panel on Asia, which will update us on the latest IP news around the continent, followed by a discussion on diversity and inclusion.

BOOK YOUR PLACE

Booking is now open, so don't delay. Each delegate place includes the drinks reception and the Gala Dinner.

DELEGATE PLACE

CITMA members: £840
Non-members: £985

STUDENTS AND IN-HOUSE/INDUSTRY DELEGATES

CITMA members: £435 (VAT exempt)
Non-members: £450 (VAT exempt)

WEDNESDAY DRINKS RECEPTION ONLY (NON-DELEGATES)

CITMA members: £55
Non-members: £65



UNITED IN A SHARED VISION

Andrea Brewster looks forward to a continued partnership driving diversity and inclusion

IP Inclusive is a sector-wide initiative. It's open to anyone who works in IP, whatever their role, whether in-house or private practice, and no matter what kind of IP they handle.

CITMA has always shared our vision for a more diverse and inclusive IP sector. It was one of the four founding organisations back in 2015 that helped us set our objectives and also an early Charter signatory. Many CITMA members have been involved since then, attending and hosting our events, signing up to our Charter, joining our regional networks and playing active roles in our networking and support communities (which include IP & ME for BAME professionals; IP Ability for disabled professionals and carers; IP Futures for early-career professionals; IP Out for LGBT+ professionals; and Women in IP – all of which are open to allies as well).

CITMA is also a key player in IP Inclusive Management, the body responsible for overseeing IP Inclusive's activities. This background support ensures the initiative runs smoothly, so that our volunteers can channel their own energy and enthusiasm into more hands-on projects.

It was particularly good to have CITMA involved in our 2019 Mental Health Awareness Week

survey. The input from trade mark professionals provided valuable information about the sector's mental wellbeing and how we can improve it. CITMA was quick to respond to the findings,

“

I believe that diversity and inclusion should be woven into everything we do

President Tania Clark pledging her commitment to working with IP Inclusive, LawCare and CITMA members to tackle the stigma around mental health. That work had already begun when I addressed CITMA Paralegals on the topic in September.

CITMA's 2019 Autumn Conference then saw our Women in IP co-lead, Susi Fish, speaking on the business

case for diversity. It's an important topic and we valued the opportunity to engage with senior trade mark people.

I believe that diversity and inclusion (D&I) should be woven into everything we do as IP professionals. More diverse and inclusive teams are not just happier; they perform better. That matters to our businesses, clients, colleagues and potential recruits.

So it's vital that membership bodies such as CITMA help to spread that message and support their members' D&I efforts.

I'm delighted to be working regularly now with CITMA's D&I group. We'll be collaborating on, for example, mental wellbeing, careers outreach (through our Careers in Ideas initiative), and activities for our five communities.

IP Inclusive is an “umbrella” brand, shared by many different stakeholders. As CITMA members will appreciate, that can be tricky to handle. But I suspect our success lies in that shared vision that guides our relationships with key stakeholders like CITMA: a vision that has inclusivity at its core.



Andrea Brewster OBE

is Lead Executive Officer of IP Inclusive

Find out more at ipinclusive.org.uk

LOOKING TO **GROW** YOUR TEAM?



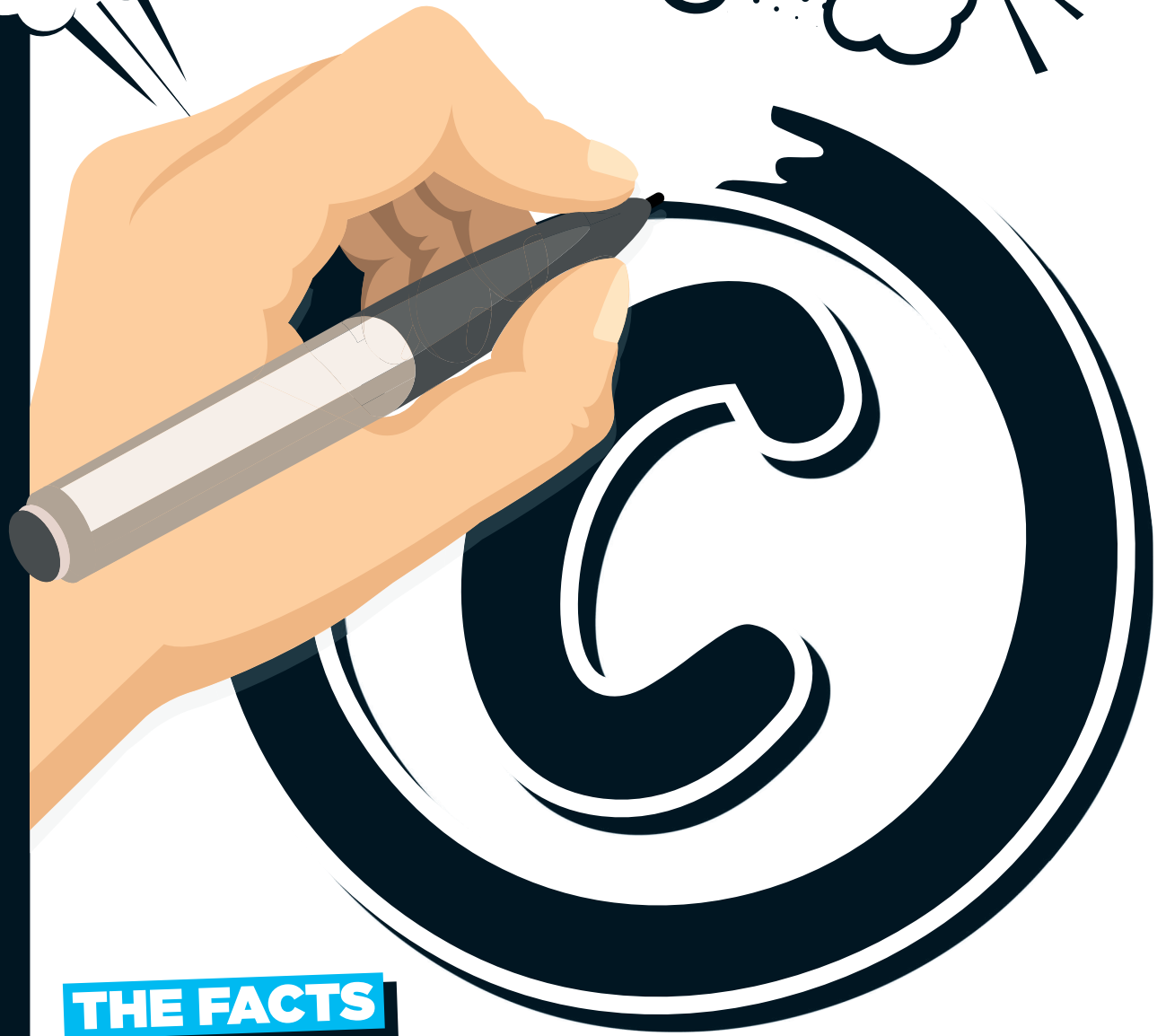
LOOK NO FURTHER

Our 1,600 members are at the heart of the trade mark and design profession.

TO DISCUSS MARKETING OPPORTUNITIES, CALL:

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tony.hopkins@thinkpublishing.co.uk

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Mark Attorneys



THE FACTS

ABOUT FICTIONS

Rights owners are likely to face challenging tests in future as long-lived characters enter the public domain, Adrian Dykes warns

IP practitioners will be well versed in giving advice in relation to the protection of cartoon characters in general – including properly documenting and assigning copyrights, as well as filing registered designs and trade marks for names and appearances to cover entertainment-related goods and services and a wide range of merchandising goods. It's all with a view to creating a reliable thicket of rights around a character.

However, the life expectancy of a cartoon character may exceed by many years the life of its creator (and their IP adviser) and may live its fictional life in the hands of a variety of parties if it is assigned and licensed.

This means that design rights and even copyright may not provide adequate protection: the former are relatively short-lived and the latter may be difficult to enforce decades down the line. For example, the copyright in **MICKEY MOUSE** (to be precise, the *Steamboat Willie* incarnation) would have expired on 31st December 2003 in the US were it not for the US Copyright Term Extension Act 1998 (CTEA). Yet, even with CTEA in place, that expiry date is now around the corner, set at 31st December 2023. It is therefore not surprising that Disney has a portfolio of marks for the **MICKEY MOUSE** character to ensure that its character remains protected beyond 2023.

Trade marks, therefore, can step in to ensure that protection continues, potentially in perpetuity, for characters and their names as badges of origin. Trade mark protection means that the character does not completely enter the public



(Left) Kellogg's Frosted Flakes cereal featuring Tony the Tiger; a vintage Michelin advertisement with one iteration of the Michelin Man

domain when copyright expires, and third parties do not have an unencumbered right to copy, commercialise and tell new stories relating to the character.

BROAD IMPACT

Fictional characters can stem from a number of sources, including literary works (eg *ANNE OF GREEN GABLES*), artistic works (eg *TINTIN*), or cinematic works (such as *E.T.*). Such characters will move between a variety of media and commercial exploitations: from box-office hits to toys, fast food, clothing and theme-park rides.

Primarily, such characters will have an entertainment function, with new stories relating to the characters building on the successes of the past. These characters also have an investment function, with

comprehensive merchandising programmes extending use well beyond the core entertainment classes and providing an immersive consumer experience extending across the generations. Some characters have a narrower brief: **TONY THE TIGER** (incidentally, aged 67) and the **MICHELIN MAN** (aged 125) are two well-known examples with advertising functions, being closely linked to the products they represent.

To ensure that a character is protected via trade marks over a decades-long period necessarily requires the character and its name to be used with respect to the relevant goods and services in order to maintain the registrations. Use also allows the character to be refreshed in order to stay up to date with consumer expectations and market trends. Extensive, continual use as a trade mark usually brings benefits: enhanced distinctiveness, a reputation and a broader scope of protection.

However, the protection afforded by continuing use of a trade mark is kerbed where

a mark becomes a common name in the trade for a specific good or service, giving rise to grounds for revocation. And, particularly where the character name is also a title, simply renewing, using and enforcing the trade marks may not be sufficient to maintain protection. A character can become too famous for its own good, meaning that it is unable to function as a trade mark for certain goods and services.

For example, in 1970 (under the 1938 UK Act), on an appeal from the Registry and the High Court, the Court of Appeal held¹ that the mark TARZAN, “hero of the adventure stories of Edgar Rice Burroughs, a strong agile person of heroic proportions and bearing”, had passed into the English language and “was well-known by every adult and by most children” and that it comprised a direct reference to the character or quality of the goods for which registration was sought, meaning that it was non-distinctive of toys and films.

Nearly 30 years later, under the current Act (and in relation to a real but deceased person), the Court of Appeal refused a registration for ELVIS PRESLEY for class 3 goods, in a case that was considered “indistinguishable” from TARZAN.² The same principle was then applied to the band LINKIN PARK³ and to the late DIANA, PRINCESS OF WALES.⁴

The approach taken in these cases would appear to spell doom for the names of fictional

Hergé’s beloved reporter Tintin



(and non-fictional) characters, at least in relation to certain goods and services. However, the Registrar’s practice has mellowed, with the Manual stating that “the names of fictional characters/stories will be accepted *prima facie* unless they are well-known to the extent that they have passed into common language and culture”.

On the contrary, therefore, if a fictional character’s name has been used by a single undertaking, and/or where the relevant public perceives the name to be under the control of a single undertaking, then the name is likely to be distinctive.

EU ACTIONS

The position is the same for EUTMs. The EUIPO Board of Appeal has decided a case concerning PINOCCHIO⁵, the children’s comic book and character created by Carlo Collodi in 1883. The PINOCCHIO registration (filed in 2006) was declared invalid for goods and services in classes 9, 16, 28 and 41 because consumers would “simply think that these goods and services refer to the story of PINOCCHIO, this being the only meaning of the term... The

subject matter of these goods and services is clearly the title and also the fictional character from a well-known children[’s] book”.

The problem with PINOCCHIO was that it had been published so much over a period of about 130



Pinocchio is far older than the 1940 film

years and further exploited via many film, television and theatre adaptations. As a result, PINOCCHIO had become so well-known that it had entered

the language (or, using the UK test, “passed into common language and culture”). The EUIPO Manual now indicates that examiners will object to famous titles filed in relation to printed matter, films, recordings, plays, shows and possibly other goods and services where the original copyright has expired (the term of copyright having been harmonised in the EU following Directive 2011/77).

It is easy to see how a character or story can be exploited over many decades by a number of different parties. Yet one can also see the policy reasons for isolating folklore from IP rights. If a story is so old and there are no authorial rights protecting it, then the rights to the story should not be “trolled” by a single third party. Of course, it is possible to think of examples of characters that are folklore, Santa Claus being the obvious example.

UNIQUE POSITION

Character names therefore seem to have their own set of rules that defy trade mark law. It is advisable to register the name before it becomes famous and therefore descriptive of entertainment and merchandising goods and services, and to separate the names of stories from the names of characters. Although consumers are used to character merchandising in the market, even extensive use may not be

enough to acquire distinctiveness for such goods and services. Ordinarily, genericide would serve to revoke a registration which has become a common name in the trade, as a result of the actions or inactivity of the trade mark owner, taking effect from the date of the application to revoke. However, when a character's name becomes a cultural icon, any later-filed distinctive trade marks can be invalidated *ab initio* in relation to certain goods or services because of the use made of it, despite it having been distinctive when it was filed.

While the above factors are both relatively high standards to satisfy, they leave no room for complacency. Therefore, although character names are registered for merchandising purposes,

concluded that it was easier to do this for cartoon characters, given that copyright allowed the image of the character to be controlled for a long time. This must be right, as it is copyright which affords protection to the effort, labour and skill required to create an original character.

TIPPING POINTS

There are therefore two tipping points in the life cycle of a famous character which need to be navigated carefully. The first is when it becomes famous enough to be descriptive of the subject



“ Character names seem to have their own set of rules that defy trade mark law

trade mark law may not be a particularly effective tool when it comes to famous characters (or, for that matter, real people), meaning consumers could benefit from a wide range of goods that represent their favourite characters, provided there is no passing off (cf Rihanna⁶).

It seems critical that owners of rights in characters educate consumers that a character name denotes trade origin, and that the Registrar can be convinced of this. This is possible: in *BETTY BOOP*⁷, Birss J found that the Claimant had educated the public that it was the official source of *BETTY BOOP* goods, having imbued the character (ie her name and appearance), with trade mark significance in the mind of the public. It seems, however, that this was not because of her fame as a cartoon character from 80 or so years ago, but because of the use of the name and image for merchandising. The Judge

matter of goods or services, when the character's name enters “common language and culture” and the name cannot be registered for entertainment/merchandise. The second and more fatal point is when the character enters folklore and is unable to be colonised by a particular owner.

Arriving at these points will depend on three things: the use made of the mark by the owner; the extent of the recognition of the character's name as a trade mark; and the copyright term. Trade mark owners are not likely to have control over the last point.

Over the coming years, as characters from the early part of the 20th century enter the public domain, the limits of trade mark

protection for characters and their names are likely to be tested further, with the courts having to

decide whether consumers see character names as having trade mark significance and what the boundaries are between fame and entering the language and folklore. Given the commercial importance of character merchandising, this area of the law is only in its infancy. ●

- 1 [1970] R.P.C. 450
- 2 [1999] R.P.C. 567
- 3 [2006] E.T.M.R. 74
- 4 [2001] E.T.M.R. 25
- 5 R 1856/2013-2 *Yves Fostier v Disney Enterprises Inc.*
- 6 *Robyn Rihanna Fenty and others v Arcadia Group Brands Ltd and another* [2015] EWCA Civ 3
- 7 *Hearst Holdings Inc and others v AVELA Inc. and others* [2014] EWCH 439

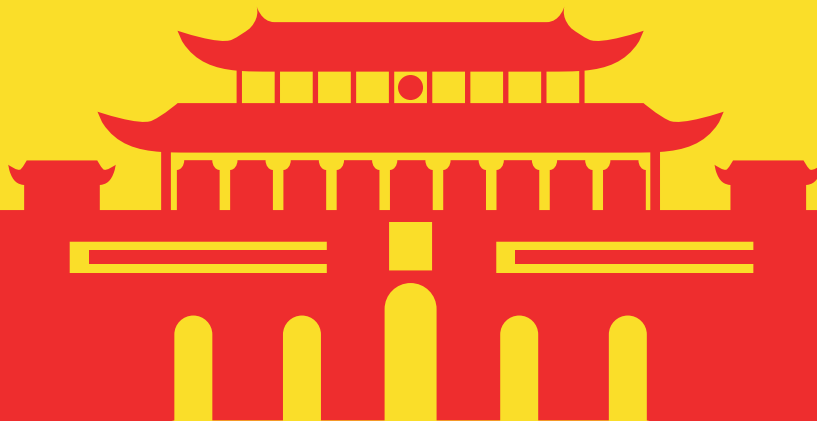


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BAD FAITH BLITZ



Xuefang Huang outlines how China is addressing its most pressing IP problem



s *Review* readers may know, China operates on the “first-to-file” principle when it comes to trade marks. Applicants

do not need to provide evidence of use or prove an intention to use in order to obtain registration. This leaves the system open to abuse by bad faith filers whose motivation is to copy, imitate and pre-emptively register marks belonging to others. In fact, in the first half of 2018, nine out of the 10 top filers were alleged to be squatters. With this in mind, bad faith filing constitutes the most pressing IP challenge in China.

The problem is acknowledged by the authorities and, in response, legislative, judicial and administrative bodies in China have introduced a number of measures aimed at addressing the situation.

For example, as of November 2018, the China National Intellectual Property Administration (CNIPA; formerly China Trade Mark Office) began to accept reports from rights owners or agencies relating to alleged bad faith filers. When an applicant’s bad faith has been established, CNIPA examiners should proactively refuse its applications by citing violations of the principles of honesty and credibility. This step amounts to an exceptional administrative initiative squarely aimed at tackling bad faith applications that seek to pre-emptively register famous brands.

STRICTER GUIDELINES

On 23rd April 2019, the Standing Committee of the National People’s Congress introduced the Fourth Amendment to the Trade Mark Law, which came into effect on 1st November 2019. Highlights include directions that: (1) applications filed with no intent to use shall be refused; (2) agencies shall not represent applicants that have no actual intent to use trade marks and non-compliance may result in disciplinary action and/or penalties; (3) oppositions and invalidations may be based on a claim of violation of the intent-to-use requirement, or by citing the prohibition that precludes IP agencies themselves from seeking registration for goods or services

outside the scope of IP services; and (4) maximum statutory compensation for infringement when actual loss or illegal gain is difficult to assess is raised from a multiple of three to a multiple of five times the licence fee, or RMB5m (circa US\$770,000; up from circa US\$460,000) if the licence fee cannot be determined.

On 24th April 2019, the Beijing Higher People’s Court issued a judicial guideline that seemingly removes the five-year limitation on the invalidation of trade mark registrations obtained in bad faith by interpreting such registrations as being acquired by “improper means”. Previously, the copying of another’s trade mark was a relative ground in the context of invalidation proceedings, so the five-year time bar applied (there are rare exceptions in the context of “well-known” marks). In a recent administrative case involving invalidation of a registration (Bobdog (China) Children’s Products Co Ltd v TRAB), the Beijing Higher People’s Court affirmed the new rule that seems to extend the vulnerability to invalidation of bad faith registrations beyond the five-year limit.

On 17th October 2019, the State Administration for Market Regulation issued the Provisions for Regulating Trade Mark Application Actions, which came into effect on 1st December 2019. These Provisions enumerate examples of improper filing behaviour, such as imitating well-recognised marks, pre-empting prior influentially used marks, registering others’ commercial signs, repeatedly filing applications for obvious improper purposes, hoarding trade marks, etc. They also hold to account agencies that seemingly conspire with squatters.

PRACTICAL MEASURES

Practical measures are specified in the Provisions aimed at curbing improper activities, such as requiring applicants to submit evidence of use

“ More can always be done in the fight against bad faith filers

or explanations, interviewing agencies and imposing disciplinary measures if bad behaviour is established, suspending the licence of agencies in cases of serious infraction, publicising accounts of improper behaviour of applicants and agents, and maintaining records in the National Credit Resource platform for further disciplinary consideration. If fraud is involved and the circumstances are serious, then criminal liability may be imposed.

As a result of the efforts being introduced in China, the number of obvious bad faith trade mark applications appears to have dropped dramatically in 2019. A measure of the success of the new regime is that in the first half of 2019, nine out of the top 10 trade mark filers are legitimate businesses or industry giants known to all. A report dated 20th December 2019 says that nearly 130,000 bad faith trade mark applications have been rejected since 2018 in the process of examination and through the opposition and invalidation proceedings.

FURTHER AMENDMENT MOOTED

The measures that have been introduced, while very welcome, do not represent a complete panacea and more can always be done in the fight against bad faith filers. China is now proposing a Fifth Amendment to the Trade Mark Law and it remains to be seen whether more changes will be introduced to further improve the situation.

In the meantime, it is gratifying to know that China is listening to the concerns of legitimate domestic and overseas rights-holders. ●



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YOU KNOW IT MAKES

It doesn't take huge adjustments to make colleagues on the autism spectrum more comfortable, writes Chris Clarke

Imagine that a work colleague comes up to you and says: "There is something that we need to talk about right now." From the words alone, you can't tell whether this is a good something or a bad something. But you would probably pick that up from the context, tone of voice, body language, etc - in fact, it has been said that as much as 90 per cent of communication is non-verbal.

Now imagine that you found a piece of paper on your desk saying the same

thing. This time you have no cues to help you understand the context. A natural reaction would be to worry that you had done something wrong. You might find the situation quite stressful. This latter scenario illustrates what life is like for many people on the autism spectrum (AS), because they miss out on much non-verbal communication.

This is just one of the points made during an IP Inclusive webinar, which also discussed what it means to be on



SENSE

the autism spectrum and what you can do to ensure your behaviour and workplace enables inclusion of AS colleagues. At the event, Katy Samuels, Employment & Development Coordinator at Autism Spectrum Connections Cymru, started by explaining that autism is defined as a developmental difference that is characterised by difficulties with social communication and social interactions and restricted patterns of behaviour, interests and activities.

As the name implies, autism can manifest in a wide range of different ways. It is a lifelong condition experienced by one in 66 people and is often diagnosed in adult life. The prevalence of AS is apparently four times higher in males than in females – but this may not accurately reflect the ratio in the population because women may be better at disguising the condition. AS people often are perceived as being needy, inflexible or pedantic

– but as Samuels explained, these apparent characteristics reflect how AS people experience and cope with the neurotypical-based world in which we all live.

STARTING POINT

The starting point to understand the AS experience is our senses. In addition to the usual five (visual, auditory, gustatory, olfactory and tactile), in the main, people also have three others that are often overlooked: ►

- proprioception – the sense of movement and spatial awareness (for example, when you move an arm with your eyes closed, you don't need to open them to work out where your arm is);
- vestibular – the sense of balance and spatial orientation; and
- interoceptive – the sense of the body's internal stimuli (such as pain, emotion, anxiety and excitement), for example, when the fight-or-flight response heightens other senses.

Most of us have an inbuilt equaliser that balances out our experience of all this sensory input – think of a music producer with lots of sliders that can be moved up and down to achieve a balanced sound. However, AS people often experience sensory input more or less intensely than neurotypical people. This can result in some apparently strange behaviours, such as wearing sunglasses or shaded

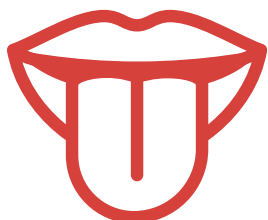
lenses indoors (in order to tone down visual stimuli) or wearing lots of clothes in summer (in order to increase the tactile stimuli from feeling the weight of the clothes).

Samuels summarised some typical characteristics of AS people. In order to avoid sensory overload, AS people may need to focus on one thing and exclude others: for example, taking in only the verbal communication and blocking out non-verbal aspects. They may not maintain eye contact – but don't assume that this means that they aren't listening. They may find hypothetical concepts or abstract thinking difficult and need context. For example, instead of saying "X generally happens", an AS person would find it easier if you said "X happens approximately 75 per cent of the time". They may find it difficult to cope with change. Change can lead to anxiety and AS people may experience anxiety differently from neurotypical people. To manage this, AS people often put in place structures, plans and routines. These could be perceived as being inflexible or pedantic, when the underlying reason is not apparent. The importance of not disrupting them – in order to avoid causing anxiety – might not occur to a neurotypical person.

Samuels offered an example of a colleague asking: "Please could I borrow you for a moment?" Most people would understand that to mean: "Have you got a few minutes to talk to me about something?" And you would probably happily reply: "Of course, no problem." But for an AS person, such a request could be a significant cause of anxiety: it has come out of the blue, with no context or hint of what it might relate to, and moreover, it's expressed in figurative language.

ADAPTATIONS REQUIRED

Once you have some insight into how AS people experience the world, and provided that you understand that they can't move themselves into the neurotypical world, it quickly becomes apparent that your normal working practices could be adapted to make things easier for your AS colleagues. For employers, this is a legal requirement of the Equality Act



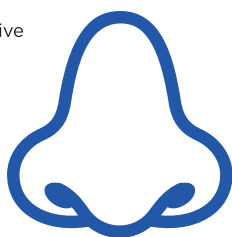
Gustatory



Visual



Interoceptive



Olfactory

IP ABILITY – CREATION OF A COMMUNITY

The webinar summarised was organised by IP Inclusive in support of the November 2019 launch of IP Ability, the latest community created under the IP Inclusive umbrella. IP Ability came together when a group of individuals each contacted IP Inclusive Lead Executive Officer Andrea Brewster to express an interest in matters that concerned people with disabilities and their carers. She recognised our shared interest and suggested we form the committee of a new IP Inclusive community.

Those of us on the committee have varied experiences of disability and caring responsibilities (according to gov.uk there are over 11 million people in the UK with a limiting long-term illness, impairment or disability). What unites us is our desire to improve the experience of people with disabilities or caring responsibilities who work within the IP professions, and to help those people access and contribute to the professions to their fullest possible extent. We hope that by supporting IP professionals, informing employers and sharing news, events and resources of relevance to disability, we can help remove barriers and empower community members. We aim to provide a supportive and informative network focusing on the issues relating to disability and long-term health conditions of all kinds, be they mental or physical, visible or invisible, permanent or temporary, sudden onset or progressive.

IP Ability's first activity was a survey of the experiences and needs of those within the IP professions who have disabilities or caring responsibilities. The results will help to identify common problems and hopefully start to suggest solutions.

If you are interested in being part of the committee or taking more of an active role in the community, please email us at IPAbilityNetwork@gmail.com or join our LinkedIn group ([linkedin.com/groups/13756630](https://www.linkedin.com/groups/13756630)). We would love to hear from you, whether with questions, offers of help or suggestions for future activities.

2010. The Act requires employers to make adjustments for disabled workers in order to make sure that, as far as is reasonable, a disabled worker has the same access to everything that is involved in doing and keeping a job as a non-disabled person.

The practical implications of this were covered by Nik Dowell, the founder of iThink, the UK IPO's staff neurodiversity network. The network provides colleagues with autism and dyslexia with peer support forums and empowers them to seek changes within the IPO to make it a more autism- and dyslexia-friendly place to work. The network has contributed to a number of awareness-raising initiatives within the IPO and is currently working to improve recruitment procedures for those with autism or dyslexia.

Dowell explained the benefits of having AS people working at the IPO.

- Manage change carefully – give as much advance warning as possible and provide an explanation and context for it.
- Think about where AS colleagues sit: are they close to a window which gets bright sunlight? Is there a blind so that they can adjust the light? Are they near a door or a walkway that could be a source of disturbance? They may find hot-desking very difficult, so can you let them have their own space?
- Provide quiet spaces (or at least noise-cancelling headphones).
- Adjust targets; help AS colleagues to analyse the job, for example, by breaking tasks down into smaller sub-tasks.
- Allow flexibility in timing of work hours; for example, heavy traffic may be a source of anxiety for AS colleagues.
- Provide training for neurotypical colleagues so they can become allies.



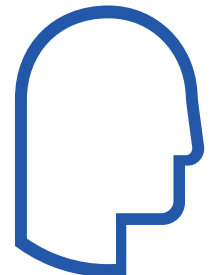
Vestibular



Tactile



Auditory



Proprioception

“ AS people typically have skills that are well-suited to the IP professions

In addition to the advantages that having a diverse workforce brings in general, AS people typically have skills that are well-suited to the IP professions, such as a STEM (science, technology, engineering and maths) background, good attention to detail and being happy to work independently.

Dowell explained the types of adjustments that the IPO has made for its AS colleagues. For example, it endeavours to:

- Use written communication. An AS colleague may find it easier to receive an email than a phone call.
- Be literal and specific (eg say “Nine times out of 10” rather than “usually”) and avoid metaphors or analogies.
- Allow time for the information to be processed and check that the message has been understood – eg follow up a face-to-face discussion or meeting with a written summary by email.
- Make “unwritten” workplace rules explicit rather than assuming that AS colleagues will pick up on them.
- Avoid disrupting routines – AS colleagues may find it difficult to do things at the drop of a hat.

Jonathan Andrews, a trainee IP solicitor at Reed Smith, shared his personal experiences as a legal professional on the autism spectrum. Andrews doesn't view AS as something that holds him back – it's just part of who he is. He disclosed his condition to his employer and has been explicit about how it affects him and the traits that it brings. He backed up Dowell's experience that the adjustments required for AS people are “soft” – not major, and generally easy to make – for example, he requested to visit the room in which he was going to be interviewed beforehand, so that he knew what to expect.

EASY ADJUSTMENTS

The key take-home message for me was that typical adjustments

are very practical, easily attainable in most workplaces, and not costly to make – in other words, they are certainly reasonable. However, they could have a huge impact on an AS person, thus enabling them to thrive in the working environment. It really struck me that this is a clear example of people who have a condition that does not make them inherently any less able than others to perform a job, but who could easily be “disabled” by society failing to understand their needs and make simple, practical adjustments for them. ●

Find out more: Webinar materials are available at ipinclusive.org.uk/resources/colleagues-on-the-autism-spectrum-webinar



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SELECT EFFECT

The Courts have unleashed a potent weapon against online platforms, explains Paola Gelato

Selective distribution systems (through which brands appoint particular distributors for their products) represent a useful instrument for companies selling luxury products, especially in a context dominated by online platforms such as Amazon and eBay. After the approval of EU

Reg. 330/2010 on vertical agreements and concerted practices and the CJEU decision in the leading Coty case (C-230/16, 6th December 2017), selective distribution systems have been gaining a more prominent role, managing to tread a delicate but convincing balance as regards unfair competition regulations.

In particular, the CJEU has stated that a selective distribution system is in compliance with EU laws if the net is aimed at preserving the luxury nature of the products, resellers are selected through qualitative, objective and non-discriminatory criteria and if these criteria are proportional with the aims of the distributive system.

However, the effectiveness of these selective nets largely depends on National Courts' trends and approach to them.

In this regard, it is worth mentioning that each Member State has been interpreting the criteria established by the CJEU in a different way, especially in connection with the delicate issue of internet sales and online platforms.

THE ITALIAN APPROACH

Italian courts, in the past few months, have issued important and interesting decisions confirming and summarising Coty's ruling according to the particularities of local rules. These go in the right direction for a more effective protection of trade mark owners and may serve as an example for other jurisdictions.

On 3rd July 2019, the Court of Milan, with a decision issued in favour of Italian cosmetic brand Sisley, prohibited Amazon from selling or promoting through its platform Sisley's products in Italian territory. It also fixed a penalty of €1,000 for each day of delay in the accomplishment of the relevant injunction. The preliminary injunction was issued in consideration of the fact that the characteristics of Amazon's platform, which sold Sisley's products in breach of its selective distribution system, have been judged to be likely to prejudice the image of the trade mark and consequently to dilute it.

Indeed, the Judge has acknowledged that Sisley's products were presented and sold alongside lower-quality products bearing different trade marks and even with different kinds of goods. The Court of Milan has focused its attention on the luxurious nature of Sisley's brand, so recognising the legitimacy and validity of its selective distribution system.

This decision represents a remarkable outcome for trade mark owners, providing them protection against breaches of their selective nets by online platforms. Moreover, the enforcement of IP rights – in cases of torts committed on the web – may be even more effective, with the granting of pan-European injunctions, foreseen by Article 131 II par. of EU Reg. 1001/2017, which prohibits similar sales across the EU.

BRICKS AND MORTAR

The recent developments in Italian case law are not limited to the protection of selective distribution from online platforms. For example, the Court of Naples has issued two important decisions on selective distribution systems that relate to

infringements by bricks-and-mortar shops. In these cases, Japanese perfumery and cosmetics company Shiseido challenged the sale and promotion of products bearing its trade marks by a shop outside the selective distribution system. This shop applied hard discounts and presented Shiseido's luxury products alongside low-quality goods.

In a decision confirmed on 30th September 2019, the Court of Naples acknowledged the validity and legitimacy of Shiseido's selective distribution system and recognised its criteria as objective and uniformly applied. The Court stated that sales offered by the Defendant, as well as its promotional activity through social networks, was in breach of Shiseido's selective net and constituted trade mark infringement, as ruled by Article 20 of the Italian IP Code.

In this regard, the Judge recalled that the existence of a valid selective distribution system constitutes a legitimate reason, which may be

by the recent reform. In particular, the Court of Naples has considered sufficient the potential risk of dilution of the reputation of a distinctive sign, arising from the unauthorised sale of the relevant branded products at discounted prices and with an inadequate presentation, in order to inhibit the challenged offer on sale, as well as the seizure of the relevant products.

In any event, in this model fact situation the Judge has concluded that there is a real and concrete risk of dilution of the brand's distinctiveness and reputation. The Defendant's behaviour has been sanctioned by the Naples Judge, also in terms of unfair competition, for misappropriation of values and customers' diversion, according to Article 2598 II and III par. of the Italian Civil Code, since, indeed, along the reasoning of the Naples Judge, the creation of an unauthorised parallel distributive net at discounted prices is likely to erode the trade mark owner's market.

“ *Selective distribution systems have been gaining a more prominent role* ”

opposed by trade mark owners against the application of the principle of exhaustion, as ruled by Article 5 of the Italian IP Code and by Article 15 II par. of EU Reg. 1001/2017.

RECENT REFORM

It is worth mentioning that the Naples Judge has expressly recalled the recent Italian reform of the IP Code, with the issuing of Law Decree n. 15, implementing EU Directive 2436/2015 in February 2019. As a matter of fact, the Judge has focused on the reputation of the trade mark, whose protection has been enhanced

In conclusion, Italian case law has shown a significant trend over recent months towards enhanced protection of selective distribution systems, in part thanks to an effective application of the recent reform of the IP Code, which grants an enhanced value to famous and well-known trade marks. We will see, in the very near future, whether this trend will be confirmed by other courts in Italy, and in other Member States – especially in relation to online platforms, which remain a challenging issue for IP, and unfair competition regulations. ●



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With thanks to Stefano Vergano for his contribution.

NOMINET IN 2019

Chris Hoole once again picks out cases of interest over the past year

This examination of 2019's year in Nominet sees me go back to a previously reported decision that returned on appeal, and review another that illustrates that even a combined force of well-known brands may not be enough to overcome legal hurdles.



PARKING CHARGES

In *CITMA Review*, Issue 447, I reported on the Expert's final decision in *Zoetis Services LLC and Zoetis, Inc v Trifega Ltd (D00020412)* concerning the domain name *equest.co.uk*. As readers will recollect, the domain was held not to be an abusive registration, the Expert finding that, while the Complainant had established earlier rights, *EQUEST* was not an unusual term and registered without knowledge of the Complainant. The Expert was particularly critical of the Complainant's disregard for mediation, which he stressed should be explored by all parties to DRS disputes.

The Complainant appealed the Expert's final decision on the substance (*DRS20412*). DRS appeals, unlike registry or court proceedings, proceed as a rehearing. However, the primary basis of this appeal related to events that occurred after the Expert's decision. The Complainant alleged that, following the decision, the Respondent, with full knowledge of the Complainant's business, nevertheless went on to link (in the

form of a landing/parking page) to various products including "horse wormers", which is the core product range offered under the mark *EQUEST*. Evidence of the updated landing page for *equest.co.uk* was filed by the Complainant, although without any timestamp.

The Respondent made several observations, primarily questioning the veracity of the link to "horse wormers", and gave several explanations for it appearing (if it had) on the landing page. According to the Respondent, the link may have appeared due to: (i) a user searching for "horse wormers" in the search ad box on the page (since relisting the parking page four of five visits included searches for horse wormer-related terms); (ii) using Photoshop; or (iii) by manipulating the Sedo parking algorithm through a combination of related searches. It submitted that the Complainant, in bad faith, had manipulated the keyword algorithm on the parking page.

In dealing with the evidence and matters before the Expert, the Appeal Panel promptly reaffirmed his findings. As regard to the alleged

subsequent use of the domain, the Panel reiterated that, under the DRS Policy, no new evidence should be admitted, unless the Panel believes that it is in the interests of justice. Under paragraph 21.2, where new evidence of a material change of circumstances arises after the original complaint is determined by an Expert, the Policy also dictates that the appropriate course is to file a repeat complaint. In accordance with the Policy, and finding no reason to depart from the norm, the Appeal Panel promptly declined to admit the new evidence. The appeal was dismissed.

The Appeal Panel also provided some useful guidance in relation to parking pages generally, stressing that, where the complaint relates to a parking page, the complainant should provide: appropriate technical information to explain the origin of the link; evidence relating to the third-party page generated by clicking on the link; the number and frequency of interactions with the landing page and the link; an explanation as to how the screenshot was obtained; and



that the Respondent’s “northern roots” explanation was implausible.

The first question for the Expert was whether the Complainants had established earlier rights as defined by the DRS Policy and, if so, in what marks. While there was no doubt in the mind of the Expert that the Complainants had established rights in the names eBay and Gumtree respectively, the evidence did not show any use in combination, nor that the public was aware of their common ownership. The assessment as to similarity proceeded on the basis of the independent marks, not the two marks in combination. In addressing similarity, and despite acknowledging an enhanced reputation, the Expert found a low degree of similarity as regard to both eBay and Gumtree, noting in both cases a slight visual and oral similarity but conceptual dissimilarity.

As to whether or not the domain was abusive, the Expert was unconvinced by the Complainants’ submission that the domain was not chosen as a play on words but as a combination of the marks ebay and gumm. On the balance of probabilities, and taking all the evidence into account, the Expert was content to believe the Respondent. The Expert was also unconvinced that the Respondent’s domain was intended or had the consequence of creating a link with the Complainants’ marks. And, while the Complainants also sought to allege that the domain name was a blocking registration, this too was given short shrift. The Complainants’ application failed.

The decision highlights that where a complainant seeks to rely on a combination or portmanteau of its brands, it must establish rights not just in the marks independently but also when combined or used in conjunction, even if well-known. ●

“ The Complainants submitted that the Respondent’s ‘northern roots’ explanation was implausible

any influence that cookies, location or browsing history may play.

NORTHERN RIGHTS

In an Expert’s final decision on eBay Inc and Gumtree.com Ltd v Auto Claims UK Ltd (D00021406) the Complainants are both well-known online marketplace platforms.

The Respondent registered the domain ebuygumm.co.uk in 2016, which was subsequently used by Ebuygumm Ltd with consent to operate a buy-and-sell website, set up with the purpose of directly competing against the Complainants. It differentiated its platform by not charging fees and offering a mechanism for holding payment until products are received. The Respondent submitted evidence to illustrate its northern ethos (despite the individual behind the Respondent being based in Birmingham), including advertising material

featuring mascots Ernie, Buddy and Gummy (a pigeon, ferret and whippet), all of which have cultural connotations related to the north of the UK. The domain name also embodied the well-known northern phrase “ee bah gum” meaning “oh my god”. The Respondent had also secured a trade mark registration for the figurative mark ebuygumm and had invested significant sums in the business.

The Complainants argued that the selection of the name was a reference to and, in essence, a combination of, eBay and Gumtree, and submitted

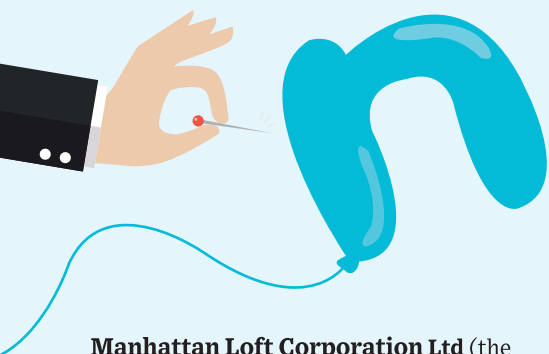


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A fair point

A one-letter difference was not sufficient to squash the opposition, reports Julie Canet



Manhattan Loft Corporation Ltd (the Applicant) sought to obtain registration of the trade mark HH HOTELS for services relating to temporary accommodation and food and drink in class 43. The application was opposed by NH Hotel Group SA (the Opponent) on the basis of s5(2)(b) of the Trade Marks Act 1994. The Opponent relied on three earlier EU trade mark registrations, which are stylised versions of nH HOTELS, nH and nH HOTEL GROUP, all covering class 43.

COMPARISON

The Hearing Officer (HO) assessed the Opponent's nH HOTELS mark (shown right), which was closest in terms of similarity to the Applicant's mark.

The Applicant had accepted that the services were identical and/or highly similar. Applying the Meric principle, the HO noted that both parties had cover for the provision of food and drink, temporary accommodation and hotel services. Information and advisory services relating to those were deemed highly similar.

It was considered that all services were aimed at the general public, which would have a reasonable level of attention regarding accommodation and a medium degree of care regarding food and drink.

When comparing the marks, the HO indicated that HOTELS was a descriptive element and because the letters "nH" are larger and more prominent, they dominate the overall impression of the Opponent's mark. On the other hand, in the Applicant's mark the two elements contribute roughly equally to the overall impression.

The marks were found overall to be similar to a medium degree.

EVIDENCE

The Opponent's evidence, which was technically deficient due to an undated witness statement, was considered either irrelevant or insufficient to prove the enhanced distinctive character of the mark.

The Opponent had submitted, *inter alia*, TripAdvisor reviews, revenue figures and awards. The HO held that the turnover figures were unremarkable, the awards were industry awards and the TripAdvisor reviews were after the relevant date.

Internet search results relating to hotel names had been attached to the Opponent's written submissions in lieu of hearing instead of being filed as evidence. The HO ruled that this was unacceptable and this information was not taken into account.

DECISION

The Applicant unsuccessfully referred to the stylisation and colour in the Opponent's mark. The HO stated that the stylisation is unremarkable and reminded that notional and fair use covers both upper and lower case, and use in different colours.

In conclusion, the HO highlighted that the one-letter difference between the marks was not enough to mitigate the likelihood that the marks will be imperfectly recalled. The NH Hotel Group was successful in its opposition and the HH HOTELS application was refused.

This decision follows the Big Mac revocation case (EUIPO Cancellation No 14788C) in reminding that there will be close scrutiny of the nature and extent of evidence filed to demonstrate trade mark use. However, if here the HO did not need this evidence to decide there was a likelihood of confusion, the NH Hotel Group was not as lucky in its opposition against an NG HOTELS mark at EU level (EUIPO Opposition No 3059620, rejected).

KEY POINTS

- ★ An undated witness statement renders evidence technically deficient
- ★ Evidence should be filed as such and not attached to submissions in lieu of hearing
- ★ Notional and fair use covers use of word marks in both upper and lower case, and in different colours

MARKS

OPPONENT'S MARK

nH
HOTELS

APPLICANT'S MARK

HH HOTELS



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Counted out

Claire Sugden explains that evidence should be of public use in order to support a registration under attack



110 years ago, Lord Lonsdale (Hugh Cecil Lowther, 5th Earl of Lonsdale) introduced “The National Sporting Club’s Challenge Belt” as a trophy for the British champion in each of eight boxing weight divisions. Twenty years later, the British Boxing Board of Control Ltd (the Proprietor) was established. The Board issued a new belt that became known as “The Lonsdale Belt”.

In this UK trade mark revocation case, with regard to goods in class 14, it was submitted by the Proprietor that use of THE LONSDALE BELT as the name of a trophy was genuine use of the mark and supported the core services of organising and administering the British Boxing Championships for which The Lonsdale Belt is awarded.

Lonsdale Sports Ltd, the revocation Applicant, argued that use of THE LONSDALE BELT as a trophy name was not use as a trade mark, as it did not guarantee the origin of the trophy in a trade mark sense. The Hearing Officer (HO) held that the trophy is not a marketed product and consumers cannot buy or trade in it, remarking that it is an award bestowed on boxers regulated by the Proprietor.

EVIDENCE

In essence, the evidence did not show any public use of the trade mark for trophies but rather suggested that the Proprietor, as part of its services as organiser of boxing tournaments, gives an award to the winners.

The HO acknowledged that the Proprietor clearly has a long history of organising and administering the British Boxing Championships. However, the HO said that the Proprietor was not attempting to create or maintain a market for those goods.

It was therefore held that genuine use of the mark was not demonstrated for trophies and related awards.

ANALYSIS

The HO’s analysis is interesting as there are a number of trade mark registrations for marks that are the name of an award given at the end of a sporting tournament and that cover trophies in class 14. Examples include the DAVIS CUP for tennis tournaments (this EUTM registration covers goods in class 14 to include medals and medallions, figurines, statues and statuettes of precious metal) and the AMERICA’S CUP (an EUTM registration covering trophies, medals and statuettes in class 14).

IMPLICATIONS

Following the HO’s decision, where it is not the case that replica trophies are made and sold, class 14 is not the correct class to cover a related term or name in making a trade mark application. Indeed, though the award name is clearly important here to the Proprietor, it is the organisation and overseeing of boxing events (the service provided) that is the core area of its business.

Note: The author represented the Proprietor at the UK IPO

KEY POINTS

- ✦ The awarding of a title and trophy to winners of a sporting match is not the same as supplying trophies as goods to the consumer
- ✦ Where a physical replica of a trophy is not for sale, class 14 is not the correct class to rely on
- ✦ The core business will be the primary basis for determining the appropriate trade mark class



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The Real deal

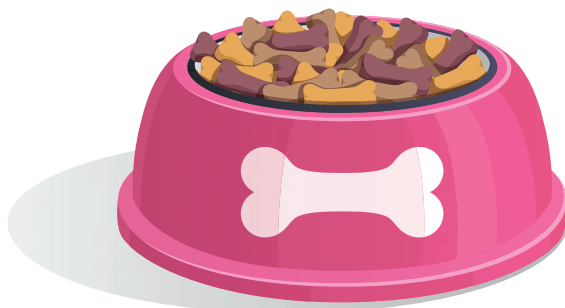
Visual representations of unregistered rights played a central role, writes Sarah Brooks

This comment concerns the consolidation of two opposition proceedings before the UK IPO. In the first, VIP Topco PTY Ltd (VIP) applied to register a logo for REAL PET FOOD COMPANY (see right). The Real Petfood Company (Real) opposed the application on the basis of s5(4)(a) of the Trade Marks Act 1994 (the Act) relying on its unregistered rights in the signs THE REAL Petfood COMPANY and a logo. Real claimed to have been using the signs throughout the UK since at least 2000 for foodstuffs for animals and related goods, and advertising, marketing and promotion services in relation to these goods.

In the second, Inspired Pet Nutrition Ltd (Inspired) applied to register THE REAL PETFOOD COMPANY as a trade mark for goods including foodstuffs for animals, advertising services, wholesale and retail services relating to foodstuffs for animals and business management and related services. VIP opposed that application based on s5(2)(b) relying on its earlier UKTM and EUTM applications for the REAL PETFOOD COMPANY logo and on the basis of s3(1)(b) and s3(1)(c) of the Act. Both the UK mark and EUTM relied on by VIP were under opposition by Real.

FIRST PROCEEDINGS

Here, a dispute arose over the depiction of the unregistered rights relied on by Real. Its notice of opposition relied on THE REAL Petfood COMPANY and the black logo shown right. Real's skeleton arguments referred to the blue logo shown right and THE REAL PETFOOD COMPANY. Given that it had not sought to amend its pleadings or to clarify the sign that it was relying on, the opposition proceeded only on the basis of the word mark.



VIP also challenged Real's eligibility to oppose its application, given the relationship between Real and Inspired. Inspired had taken a majority shareholding in Real in 2008 and, in 2015, Real became a wholly owned subsidiary of Inspired. Under a licence agreement between the companies, the goodwill remained with Real, but Inspired owned the overall rights. The Tribunal accepted that Real owned the goodwill and was the correct entity to bring the opposition.

Assessing the evidence, the Tribunal concluded that Real's "goodwill rests in pet food snacks, treats and manufacture, retail and wholesale of the same". However, Real had not produced evidence of advertising to third parties, so the opposition succeeded against all goods and services in VIP's application except for "advertising and promotional services".

SECOND PROCEEDINGS

VIP's UK mark could now only be relied upon for advertising and promotional services. The Tribunal held that there were sufficient visual differences between THE REAL PETFOOD COMPANY and VIP's EU application to avoid direct confusion. However, there was a likelihood of indirect confusion for class 31 ("foodstuffs for animals; edible treats for animals") and class 35 ("advertising, wholesale and retail services relating to foodstuffs for animals, edible treats for animals"). The opposition failed in respect of "business management; business administration; office functions" where there was no similarity of services. Finally, as "real" was not a characteristic of pet food, the mark was held not to be descriptive.

The decision in the second proceedings is provisional, pending the outcome of opposition proceedings before the EUIPO against VIP's EUTM application.

KEY POINTS

- ✦ When relying on unregistered rights, ensure that signs are accurately depicted in the notice of opposition and consistently referred to throughout the proceedings
- ✦ Ensure that changes in ownership of trade mark rights and related goodwill are accurately documented, via assignment and licence agreements

MARKS

VIP's UKTM
3188527



VIP's EUTM
015876832



REAL'S EARLIER LOGO



THE SIGN REFERRED TO IN REAL'S SKELETON



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You only lose once



Lack of distinctiveness was one of the factors that proved deadly, says Laura Robyn

This case concerns an opposition against an application to register the device mark YOLO (shown below right) in classes 16, 18 and 25 for stationery, luggage and clothing filed by Yolo Products Ltd (the Applicant). The Opponent, CBM Creative Brands Marken GmbH, claimed that a likelihood of confusion exists (s5(2)(b)) with its earlier EU registration “yobo” and that the mark applied for is devoid of distinctiveness (s3(1)(b)).

The Applicant did not file evidence. In its counterstatement, it listed a number of registered marks consisting of or containing YOLO. This was swiftly dismissed by the Hearing Officer (HO), citing the General Court’s decision in *Zero Industry*: the existence of a number of marks on the register is insufficient to show a weakened distinctive character as there are no indications as to how many of those marks are used in the market.

SIMILARITY

The HO considered the class 18 and 25 goods in the application to be identical and the stationery goods in class 16 dissimilar to goods in other classes covered by the earlier mark.

In comparing the marks, the Applicant’s assertion that the mark applied for could be read in a number of ways due to the vertical arrangement was rejected. Instead, the marks were found to be visually similar to a medium degree and aurally highly similar.

Rejecting the Applicant’s unsupported contention the mark will be viewed as an acronym for “Your own life organised”, the HO turned to conceptual considerations. She divided the pool of average consumers into those familiar with YOLO as an acronym for “You only live once”, and those viewing the mark as a made-up word or unknown acronym. For the former group, the marks were held conceptually dissimilar, and for the latter, conceptually neutral.

LIKELIHOOD OF CONFUSION

The HO found “yobo” inherently distinctive to a medium degree for consumers

recognising its slang meaning of “hooligan; bully”, and highly distinctive for consumers viewing the mark as an unknown acronym or made-up word. The HO concluded that since for a significant proportion of the average consumers the marks were conceptually indistinguishable there must be a direct likelihood of confusion in respect of the class 18 and 25 goods.

The HO went on to find an indirect likelihood of confusion also exists: even if the visual differences between the marks allowed consumers to differentiate them, without a conceptual hook to assist in recalling the acronymic letters, a significant proportion would see the marks as alternatives used by the same/linked undertaking(s).

DECISION

Since the s5(2)(b) claim was successful only in part, the HO turned to the distinctiveness claim in respect of the class 16 goods. This pleading was based on YOLO being a well-known acronym for the phrase “You only live once”, which, it was claimed, would be viewed as a mere advertising slogan.

Revisiting her findings on conceptual similarity, the HO agreed with the Opponent. The mark was objectionable under s3(1)(b) in respect of those goods, which often carry slogans since a significant proportion of average consumers would be familiar with the YOLO phrase.

Except for a few general paper and stationery goods, the opposition largely succeeded on both the s5(2)(b) and s3(1)(b) grounds.

KEY POINTS

- + Conceptual neutrality does nothing to distinguish marks
- + Particularly in the context of consumer goods carrying slogans, acronyms for popular phrases can be found to lack the required degree of inherent distinctive character to be registrable
- + State of the register evidence is not persuasive in showing a mark’s inherent distinctive character is weakened

MARK

CONTESTED APPLICATION



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Welsh business wins out

Conceptual assessment played a decisive role, suggests Serena Totino

The concept behind a trade mark often decides a brand's success, due to the association that consumers make with a variety of references, including puns. In this case, the UK IPO has provided an interesting point of view on conceptual similarity between trade marks.

In June 2019, the proprietor of the UK trade mark THE ROCK & SOLE PLAICE (the Earlier Mark) filed an opposition against the UK trade mark application ROCK & SCALLOP (the Opposed Mark) based on the similarity between the trade marks, the identical services in class 43 (ie restaurant services), and the long-term reputation of the Earlier Mark in the UK, which, according to the Opponent, would result in passing off its goodwill.

BACKGROUND

The proprietor of the Earlier Mark has operated a restaurant named THE ROCK & SOLE PLAICE in London's Covent Garden since 1974. The Applicant's restaurant, ROCK & SCALLOP, is located in the South Wales Valleys. Although the Opponent has just one place of business in the UK, it claimed reputation throughout the UK and the Applicant responded with a request to prove use of the Earlier Mark.

Genuine use of the Earlier Mark was established through recourse to the Wayback Machine and citations in national newspapers, food guides and reviews. However, use was not proved beyond the Opponent's single establishment.

KEY CONSIDERATIONS

According to the UK IPO, both the Earlier Mark and the Opposed Mark are composed of equally distinctive words and the differentiating elements of the marks (ie SOLE PLAICE v SCALLOP) appear similar to a low to medium degree from a visual and aural perspective.

With regard to conceptual similarity, it was held that the relevant public (in this case, likely to apply an average level of attention) will perceive a certain difference between the marks due to the punning reference to

“Rock 'n' Roll” or “Rock and Soul”, as well as the play on the word “plaice” understood as “place”, contained in the Earlier Mark. By contrast, the Opposed Mark relies on its literal meaning. Therefore, it is unlikely the public will make a connection between the marks and assume that the restaurants are economically linked.

The extent of goodwill and reputation of the Earlier Mark was found to be limited to London. Therefore, the threshold of a “substantial number of assumers” required in *Phones 4 U Ltd v Phone 4U.co.uk Internet Ltd* ([2006] EWCA Civ 244, RPC 5) to substantiate a passing off claim was not met.

OUTCOME

The UK IPO rejected the opposition and allowed the Opposed Mark to reach registration. However, it was prevented from awarding costs to the Applicant due to the absence of a costs pro-forma.

This case is a useful reminder that conceptual similarity between trade marks may have a decisive role in the context of an opposition and that opposition strategies should take into account the geographical extent of a business goodwill when considering a claim based on reputation or passing off.

KEY POINTS

- ✦ When the distinctiveness of the earlier mark lies in a pun, the absence of a pun in the opposed mark decreases the likelihood of confusion
- ✦ A claim of passing off cannot be substantiated based on the presence of some “mere wonderers”, but a substantial number of “assumers” would be required
- ✦ Award of costs is not made in absence of a costs pro-forma



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Society reigns supreme

But Charlotte Wilding believes an opportunity may have been wasted

The Soho Society (TSS) applied for a UK trade mark application in class 32 on 29th June 2018 for the circular logo shown right (the Opposed Mark). This was opposed by Soho Brewing Ltd (SBL) on the basis of a likelihood of confusion with its earlier UK and EU trade mark registrations for a number of marks in class 32, also shown on this page.

TSS denied the claim of likelihood of confusion and filed evidence in the form of a witness statement, which focused on TSS's prior use of the Opposed Mark and the fact that Soho is the name of an area in London.

The fact that TSS claimed to have prior use of the Opposed Mark is not a defence to the opposition. Instead, TSS should have sought to invalidate SBL's earlier registrations and suspend the opposition pending the invalidation actions. However, TSS did not take this route.

It was noted that as "beer" appears in the specifications of both TSS and SBL, the goods are identical.

The average consumer is a member of the general public over 18 years, with a medium degree of attention when purchasing the goods. The goods are likely to be primarily purchased due to visual elements, with some aural components also.

COMPARISON OF MARKS

The Hearing Officer considered that the only overlapping element of the marks is SOHO. As the additional wording, devices, colours and background elements all differ, there is a low degree of visual and conceptual similarity.

The aural similarity was considered to be low to medium because although LAGER, PILSNER, PALE ALE and PORTER may not be pronounced due to being descriptive, likewise OUR NEIGHBOURHOOD IS YOUR BUSINESS may not be pronounced due to it being a

smaller size in the logo, so that the words THE and SOCIETY and BREWERY LTD are distinguishable.

CHARACTER AND CONFUSION

SBL did not claim enhanced distinctive character and therefore the inherent distinctive character was determined to be no more than low to medium.

Although the goods were identical, given the low visual and conceptual similarities and the low to medium degree of aural similarity and distinctive character, there is no likelihood of direct or indirect confusion.

It was held that the marks were unlikely to be mistakenly recalled or misremembered as each other. Further, the SOHO element was more likely to be seen by consumers as a link to Soho in London and not indicating linked businesses. The opposition failed and TSS was granted a contribution to its costs.

CLOSING WORDS

This case demonstrates that while a dominant element of one mark may be identical to the dominant element of another, and even where they relate to identical goods or services, this does not automatically result in a finding of confusion. Further, it is not possible to rely on earlier use as a defence to an opposition. Instead, you must bring a separate invalidation action to have the marks removed from the Register.

“
The SOHO element
was more likely
to be seen by
consumers as a link
to Soho in London

KEY POINTS

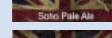
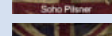
- Identical dominant elements between marks may not be enough to find similarity
- You cannot claim earlier use of a mark as a defence in a trade mark opposition

MARKS

THE OPPOSED MARK



SBL MARKS



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Road to refusal

Adam Kellett finds this decision a useful guide to shape mark obstacles

This case concerns six trade mark applications filed by Jaguar Land Rover Ltd (JLR), to register the shapes of its Series 1, Series 2 and Defender cars in the UK. The applications covered a range of goods and services in classes 9, 12, 14, 28 and 37.

JLR successfully overcame descriptiveness and non-distinctiveness objections during examination. However, the applications were then opposed on numerous grounds by Ineos Industries Holdings Ltd (Ineos), a company that wished to produce cars in the shape(s) of JLR's discontinued Defenders. The Oppositions were consolidated.

SECTIONS 3(1)(B) AND (C)

With reference to *The London Taxi Corporation Ltd v Fraser-Nash Research Ltd and Another* [2017] EWCA 1729 (Civ), the Hearing Officer (HO) considered whether the shapes, when viewed in their entirety, depart significantly from the norms and customs in the passenger car sector.

The assessment focused, in particular, on features that render the shapes “boxy” and counter-aerodynamic, and on the Defender vehicles’ “arrow-shot” and “alpine” windows.

When compared in their entirety against the vehicles of third parties, the HO determined that while the Defender shapes have some “unusual” features, these are merely “minor variations” from the norms. Accordingly, all of

the shapes were found to be devoid of inherent distinctive character for (land-based) vehicles.

The fact that the vehicles look “old-fashioned” was considered relevant. However, on the basis that consumers are “well aware” of “retro” designs, the HO did not consider this enough to find that the shapes depart significantly from the norms.

The HO found the marks non-distinctive for toys and models, which can assume the shapes of cars, and that the shapes may indicate the intended purpose of goods/services that relate to cars. Additionally, the HO found the marks non-distinctive for goods such as cufflinks and key rings, which can take the shapes of cars for decorative purposes.

However, the HO found the shapes to be inherently distinctive for statues and statuettes, which were deemed to typically take the form of people or animals, and for Christmas decorations, commenting: “There is nothing about [the shapes] which evokes Christmas.”

In addition to certain goods in classes 9 and 28, the HO found the marks to be inherently distinctive for “apparatus for locomotion by air and/or water” in class 12. This followed the General Court’s decision in *Jaguar Land Rover v OHIM, T-629/14* that such shapes depart significantly from the norms and customs for waterborne and airborne vehicles.

For the remaining goods, the HO found no evidence that the shapes had, per s3(1)(d), become customary in the *bona fide* and established practices of the trade. The HO also dismissed grounds under s3(1)(a) that the signs were not capable of being graphically represented or distinguishing the goods/services of a particular undertaking.

“ The HO found that consumers rely primarily on the names of manufacturers and/or models of cars, rather than their shapes

ACQUIRED DISTINCTIVENESS

JLR did not succeed in establishing that the shapes of its Series 1 and Series 2 cars had acquired distinctiveness through use. Sales of new cars had ceased 44 years earlier, and the (possibly incidental) presence of the cars in films and TV shows was not persuasive.

Sales of 136K Defender vehicles between 1994 and 2017 were deemed to represent a “tiny fraction” of the passenger car market in the UK, and only a “small proportion” of the 4x4/SUV sub-sector.

JLR presented survey evidence, from which the HO deduced that between 20 and 40 per cent of respondents were confident that the pictures they were shown depicted a Defender, representing a “significant but not overwhelming degree of recognition”.

Evidence that third parties had sold cars based on the shapes, seemingly without confusion or objection by JLR, was influential.

The HO explained that it was not necessary for JLR to evidence that the shapes had, in the past, been used and relied on as trade marks absent LAND ROVER or DEFENDER. JLR simply needed to prove that a significant proportion of the relevant consumers would perceive the shapes alone as distinguishing its goods/services. Ultimately, the HO found that consumers rely primarily on the names of manufacturers and/or the model names of cars, rather than their shapes, and that the Defender shapes had not acquired distinctive character.

When assessing inherent and acquired distinctiveness, the HO expressed hesitance to place too much weight on the analyses and statements of design experts and motoring journalists, which were not deemed representative of the average consumer’s perspective.

SECTION 3(2) GROUNDS

The HO determined that the shapes have essential characteristics that are not generic or likely to be sought in competitors’ products, and that are “counter functional” and/or possess a “residue of form over function”.

As to whether the shapes give substantial value to the goods, the HO commented that this was a “difficult and developing area of law” about which he was “reluctant to decide... without having heard the full argument”.

Accordingly, the decision does not provide further insight into the application of this tricky ground.

SECTIONS 3(3)(A) AND 3(6)

Ineos essentially argued that JLR was seeking to misuse the trade mark system to contravene the time period restrictions of design law. The HO deemed this public policy

ground “misconceived and unfounded”, on the basis that s3(2) safeguards against such concerns, and found there was no genuine and sufficiently serious threat to the interest of society. The HO likewise found no bad faith on that basis.

However, the HO did find bad faith for some goods, on the ground that JLR did not have a *bona fide* intention to use the marks. Despite having found the shapes to be inherently distinctive for “apparatus for locomotion by air and/or water”, the HO considered it “very unlikely, if not wholly implausible” that the shapes could be used for such goods, and therefore decided that protection was sought in bad faith. There may be some tension between these parts of the decision, though one supposes that an Applicant intending to use the shape of a car for an airborne or waterborne vehicle, such as an amphibious car, should be in a position to evidence this and thereby overcome a bad faith objection.

The decision provides a useful roadmap for the various grounds for refusal that may or may not apply to shape marks. It also provides further practical insight as to how unusual and/or widely recognised the shape of a product must be in order to attain registration as a trade mark.

MARKS

VIEWS OF THE JLR SHAPE MARKS



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KEY POINTS

- + The HO found it unlikely or implausible that the Applicant could intend to use the shapes for airborne or waterborne vehicles, the only types of vehicles for which they were found inherently distinctive
- + A 20-40 per cent rate of confident recognition was insufficient to convince the HO that the shapes were distinctive of the Applicant’s goods to a significant proportion of the relevant public
- + An “old-fashioned” appearance is relevant when considering if a shape mark is inherently distinctive. However, this is by no means decisive, especially if consumers are particularly aware of “retro” designs in the relevant sector

Thin evidence for fitness brand

Clare Liang offers an insight into proof of use evidence

This case concerns an opposition filed by Rachael Woolston (the Opponent) against UK trade mark application No 3246259 for Fit Bitch Club in classes 25 and 41 in the name of FIT B CLUB (the Applicant). The Opponent represented herself and the Applicant was represented by Ms Linda Cerminara (of the same address as the Applicant).

It offers an interesting insight into when proof of use evidence will be considered to be genuine use even where the mark used is not as registered, and the extent of use required to satisfy the proof of use requirements.

The opposition was based on ss5(2)(b) and 5(3) of the Trade Marks Act 1994 and relied upon UK trade mark registration No 2522513 (logo below right) registered for “fitness boot-camp classes” in class 41. The mark had originally also been registered in relation to clothing in class 25 but had been partially cancelled through a revocation action filed by Linda Cerminara. In those proceedings, Ms Cerminara did not seek to revoke the class 41 services but in the present opposition the Applicant did request proof of use of the mark in relation to fitness boot-camp classes.

PROOF OF USE

Much of the Opponent’s evidence fell outside of the relevant period for proof of use or was undated. This included copies of press excerpts and of testimonials on the Opponent’s website. The Hearing Officer (HO) considered the Opponent’s evidence to be thin on both detail and dating.

The evidence that fell within the correct time period comprised an article in *Sainsbury’s Magazine*, an article in the *Daily Express*, an invoice showing sales of seven T-shirts, two invoices showing costs for merchandising and printing for 15 vests and 11 hoodies, and a spreadsheet showing

bookkeeping for provision of regular fitness classes in three locations in Sussex.

None of the evidence provided showed use of the mark as registered but showed use of “Fitbitch Boot Camp” and “Fitbitch”. Interestingly, the HO found that the Opponent’s use of the plain word form constituted normal and fair use. The figurative elements of the registered mark, and the words “Building

better bodies”, were found to be lacking in distinctive character.

As a result, their omission – and the omission of stars emanating from the “i” in “bitch” – did not alter the distinctive character of the mark. Finally, the HO

confirmed that because

there was no colour claim for the earlier mark, the absence of colour did not alter the distinctive character of the mark.

DECISION

The HO, finding genuine use in relation to fitness boot-camp classes, went on to find a likelihood of direct confusion in relation to the Applicant’s “fitness classes; sports club” as well as indirect confusion with “fitness clothing; activewear”. The Opposition failed in respect of “fan club organisation; fan club services; fan club services (entertainment); fan clubs; fan club purposes”.

With such light evidence, it is no surprise that the Opponent failed to show evidence of reputation in the earlier mark and therefore the s5(3) ground failed.

“
The figurative elements of the registered mark were found to be lacking in distinctive character”

KEY POINTS

✦ The owner of the earlier mark provided no evidence of the mark as registered, but use of a mark that differed only in elements that lacked distinctive character, or which did not alter the distinctive character of the mark, was accepted and considered to be fair and normal use

✦ Ensure evidence is properly dated and that the date is within the correct time period for proving use

MARK

EARLIER MARK



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Madamecoco is free to go

A Turkish brand was free of tarnishment or coat-tail riding, reports Angharad Rolfe Johnson

Deha Magazacilik ev Tekstili Urunleri Sanayi Ve Ticaret Anonim Sirketi (the Applicant) applied to register the trade mark MADAMECOCO in respect of goods and services in classes 20 and 35, on 16th January 2018.

Chanel Ltd (the Opponent) opposed the application in respect of class 35 services, including retail services of tools and implements related to personal beauty care, based on s5(3) of the Trade Marks Act 1994 (the Act) and in relation to the series mark COCO MADEMOISELLE (one form shown right) registered for class 3 goods.

Chanel was not put to proof on “women’s perfumes” but was asked for proof as regards the remainder of the class 3 goods relied on, including “perfumes” at large. Following a review of the evidence, the Hearing Officer (HO) found that Chanel could rely on: “Women’s ancillaries, namely, preparations for application to or care of the skin or hair, soaps, non-medicated toilet preparations; women’s perfumes” [emphasis added]. Therefore, use on “women’s perfume” alone was not sufficient to support the broader term “perfumes”.

Chanel conceded that much of the promotional efforts evidenced had been directed towards women’s perfume but argued that this had a “spill-over” effect into “women’s ancillaries”. The HO agreed but noted a distinction between “women’s perfume” (significant reputation) and “women’s ancillaries” (a more limited reputation).

The marks were found moderately similar. The HO also found a link, focusing primarily on the application’s retail services for hair management and beauty care tools and apparatus. Chanel’s reputation in women’s perfume was enough to overcome the distance between the parties’ goods and services. The ancillary goods had a lower reputation but were closer to the Applicant’s specification. Therefore, the link found for both categories of goods was “no more than medium”.

Due to this, the differences between the marks and the distance between the goods and services of the parties, there was no dilution or unfair advantage found.

The Applicant acknowledged there existed potential for overlap between the relevant consumers. However, in the HO’s view, it was not obvious that the economic behaviour of the average consumer of Chanel’s goods would change them on encountering the Applicant’s services rendered under MADAMECOCO. He also found it unlikely that there would be a transfer in the image of Chanel’s marks to the Applicant and that any link created would be too weak for the Applicant to ride on the coat-tails of Chanel.

In a late-stage request to amend the TM7 to include tarnishment (omitted initially due to a typographical error), Chanel tried to draw a connection between the Applicant’s marketing strategy in Turkey, which included selling its products to discount outlets, and possible detriment to Chanel’s reputation. However, the HO was reluctant to find a market strategy decisive.

Taking the medium strength of the link and the distance between the parties’ goods and services into account, a transfer of negative impression was unlikely to occur, even if the Applicant provided retail services connected to the sale of low-end and discounted versions of its goods in the UK.

The opposition therefore failed on all three counts.

KEY POINTS

✦ Use on “women’s perfume” alone was not sufficient to support the broader term “perfumes”

✦ The reputation of COCO MADEMOISELLE in perfumes was such that it was deemed to have “spilled over” into “women’s ancillaries”

✦ A late-stage request to amend the opposition to include tarnishment as part of the s5(3) claim was allowed

MARK

THE CHANEL MARK

COCO
MADEMOISELLE



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Halloumi is cheesed off

David Birchall considers contrasting rights

The Advocate General's opinion on this appeal to the CJEU is an interesting examination of the merits of a protected designation of origin versus a collective trade mark registration when opposing an application to register a similar mark as an EUTM.

Where a case before the CJEU raises a new point of law, the CJEU asks an Advocate General (AG) to produce a legal opinion before the judges deliberate and deliver their judgment. The opinion of an AG is advisory and does not bind the Court – but is usually very influential.

PDO RECAP

The EU permits the registration, as a Protected Designation of Origin (PDO), of a food product name designating a food product where every part of the production, processing and preparation process of the product bearing the name takes place in a specific region and the product has distinct characteristics from that region. An application for a PDO must contain a specification detailing the raw materials and the main physical, chemical and microbiological characteristics, including details of taste and smell. The application for PDO status must first be filed with the relevant

national body in the relevant EU Member State. Once the national body of the EU Member State is satisfied, the application is passed to the EU Commission. The EU Commission later advertises it for opposition purposes and if no opposition is filed within the relevant period the food product name will be entered on the EU's register of PDOs.

CYPRUS APPLICATION

Cyprus applied in July 2014 for a PDO for HALLOUMI for cheese in a rectangular or semicircular shape weighing between 150 and 350 grams, made from fresh sheep's and/or goat's milk with a permitted addition, up to a certain proportion, of cow's milk. The PDO application was advertised by the EU Commission for opposition purposes but, at the time of writing, PDO status has not yet been granted.

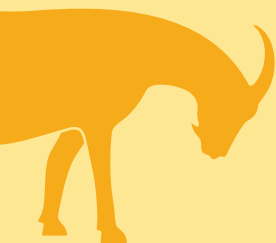
Prior to this, the Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi (The Foundation) registered HALLOUMI as a collective EUTM for cheese in class 29. A collective trade mark is a trade mark that indicates that the goods/services bearing the mark originate from members of a trade association, rather than just one trader.

In 2014, a Bulgarian entity applied to register, as an EUTM, the stylised mark shown right containing the word BBQLOUMI for, *inter alia*, cheese.

Without the benefit of a PDO for HALLOUMI, The Foundation opposed this EUTM application on the basis of likelihood of confusion with its collective EUTM for HALLOUMI for which it claimed reputation.

The EUIPO rejected the opposition and both the Appeal Board and the General Court upheld that rejection, finding that The

“ *The Foundation argued that a collective EUTM necessarily enjoys increased protection* ”



“ The AG queried whether HALLOUMI is even uniquely associated with Cyprus

Foundation’s collective EUTM for HALLOUMI, since it corresponds to the name of the well-known cheese, had only a minimum degree of distinctive character and that, in light of the differences between it and the mark applied for, there was no likelihood of confusion with the BBQLOUMI mark.

The Foundation has appealed the General Court’s decision to the CJEU and the AG has been asked to provide an opinion.

The Foundation argued, *inter alia*, that a collective EUTM necessarily enjoys increased protection, a factor to which the General Court did not give sufficient consideration, that the General Court applied an incorrect criterion in assessing the likelihood of confusion and that there were errors in the handling of the appeal.

GEOGRAPHICAL ORIGIN?

Article 7(1)(c) EUTMR provides that marks that consist exclusively of signs designating the geographical origin of the goods or services may not be registered. However, Article 66(2) (subsequently renumbered to 74(2)) EUTMR provides that: “By way of derogation from Article 7(1)(c), signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute EU collective marks.”

The AG agreed with the EUIPO’s finding that The Foundation’s collective EUTM does not appear to be a mark within the meaning of Article 66(2), since HALLOUMI is not a geographically descriptive term given that there is no city, region or mountain range bearing that name. Setting aside that it does not designate a specific place, the AG queried whether HALLOUMI is even uniquely associated with Cyprus, since the cheese appears also to be widespread across other countries in that region.

The AG nonetheless considered the position if The Foundation’s mark did indeed fall under Article 66(2). The AG referred to

the Darjeeling case (C-673/15 P to C-676/15 The Tea Board v EUIPO), which clarified that only trade marks capable of distinguishing the goods or services of the association that owns the trade mark from those of other undertakings may constitute EU collective marks and that Article 66(2) does not remove that requirement. The AG stated that the distinctive character of a geographical collective mark should be assessed according to the extent to which it identifies the collective commercial origin of the goods/services.

In the AG’s opinion there was no error in the decisions since the General Court’s factual findings had been that the HALLOUMI mark identified the commercial origin to, at most, a low degree.

ANALYSIS

The AG confirmed that proprietors of geographical collective marks still enjoy minimum protection, permitting them to prevent registration of identical marks for the same products, and that they can influence the perception of their mark if they use it in such a way that it acquires distinctive character.

The AG repeats the EUIPO’s assertion that it would be contradictory if producers’ associations could obtain equivalent or even stronger protection for geographical designations on the basis of trade mark law than through the PDO system.

The CJEU’s decision is awaited but, in the meantime, the AG’s opinion underlines the value of a PDO when opposing applications to register similar marks as EUTMs.

KEY POINTS

✦ Only a trade mark capable of distinguishing the goods or services of the association that owns the trade mark from those of other undertakings may constitute a collective EUTM

✦ It would be contradictory if equivalent or stronger protection could be obtained for geographical designations on the basis of trade mark law than through the PDO system

MARK



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Eyes to the Sky

All attention is now fixed on the CJEU, says John Coldham

Most trade mark decisions focus on the marks themselves. This case, however, looks at what the trade marks cover – ie the specifications of goods and services. These are, of course, central to trade marks, as they set out the scope of the trade mark's monopoly. Protection of the proprietor's legitimate commercial interests must be balanced with the need to avoid the stifling of competition.

In the main UK proceedings (*Sky Plc & Ors v SkyKick UK Ltd & Or* [2018] EWHC 155 (Ch)), the Claimants claimed that the Defendants infringed five EU and UK trade marks comprising the word SKY, through their use of SkyKick (and variants) and had committed passing off. SkyKick denied the claims and counterclaimed a declaration that the trade marks were wholly or partly invalidly registered. This was based on terms in the specifications being insufficiently clear or precise (eg "computer software"). Furthermore, SkyKick argued that Sky's applications had been made in bad faith, as Sky lacked intention to use the marks in relation to the full breadth of the terms within the specifications (eg "bleaching preparations").

Mr Justice Arnold (as he then was) referred five questions to the CJEU relating to the role and function of trade mark specifications, allowing consideration of this problematic area of the EU trade mark system.

The Advocate General (AG) first considered whether a trade mark can be declared wholly or partly invalid due to some or all terms in its specification being insufficiently clear and precise to enable authorities and third parties to determine the extent of protection conferred. The AG considered the second question at the same time, namely whether terms like "computer software" were too general and covered goods too variable to be compatible with a trade mark's function as indication of origin and to enable determination of the extent of protection conferred.

In the infamous IP Translator case, a lack of clarity and precision was a ground for opposition but not for invalidation of a registered trade mark. The AG could not introduce this as a new ground for invalidity, as legislation provides an exhaustive list. Therefore, a lack of clarity and precision may be considered during assessment

of an application, but a registered trade mark cannot be declared wholly or partly invalid on such grounds alone.

However, the AG inferred from case law that an insufficiently clear or precise trade mark may be covered by the ground for refusal or invalidity of marks being contrary to public policy, per Article 3(1)(f) First Council Directive 89/104, 21st December 1988 and Article 7(1)(f) of Council Regulation No 40/94, 20th December 1993. Following Mr Justice Laddie's reasoning in *Mercury v Mercury*, registration for "computer software" "is unjustified and contrary to the public interest because it confers on the proprietor a monopoly of immense breadth, which cannot be justified by any legitimate commercial interest".

The AG said intention to use should mirror revocation on grounds of non-use. This would not change examination of applications, but third parties could seek declarations of invalidity after grant, or in opposition proceedings alongside objections on absolute grounds.



“ Trade mark owners should review their filing strategies so as to assess potential risks

INTENTION TO USE

The third question concerned whether registering a trade mark without an intention to use across the full specification could constitute bad faith.

The CJEU judgment of 12th September 2019, *Koton Mağazacılık Tekstil Sanayi ve Ticaret v EUIPO* (C-104/18 P, EU:C:2019:724) ruled that the absolute ground for invalidity applies where an EU trade mark owner has filed the application with the intention of undermining third-party interests or of gaining an exclusive right “for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin”.

The AG considered that where an applicant lacks intention to use the mark, an intention to prevent third parties is irrelevant: “The applicant is improperly seeking a monopoly [...]. That amounts to an abuse of the trade mark system.” Therefore, a deliberate intention to acquire rights without an intention to use them could constitute an element of bad faith, particularly where registration is sought solely to exclude potential competitors and where there is evidence of an abusive filing strategy.

RISKY QUESTION

The fourth question related to whether an application can be made partly in good faith and partly in bad faith where an applicant intends to use the mark in relation to only part of the specification. This question carried a lot of risk for brand owners – if it cannot be part and part, then there is a risk that an entire trade mark would be invalidated if there were just one term considered to be bad faith. The AG said that following Article 51(3) of Regulation No 40/94 and Article 13 of Directive 89/104 the relevant mark would be declared invalid in part, in relation to those goods or services applied for in bad faith.

The fifth question concerned whether s32(3) of the UK’s Trade Marks Act 1994 is compatible with EU law. S32(3) provides that an application shall contain a statement of

bona fide intention of use in relation to the specification. No such statement is required when applying for an EU trade mark. The AG said this cannot be a ground for invalidity, but rather it is a procedural requirement for an application. The statement may assist as evidence of bad faith. Therefore, it is compatible provided it is not used as the sole basis for finding bad faith.

If the CJEU adopts this opinion, registration authorities would likely take a narrower approach towards terms used in specifications. Prospective trade mark owners could consider using a greater number of precise terms in order to obtain the required scope of protection, rather than fewer, broader terms.

The thousands of trade marks covering “computer software” could face partial invalidation. These terms are common, as are similar terms such as “financial services”. The scope of protection of such marks would therefore be narrowed. Proprietors should review their trade mark specifications and look out for other terms that might be considered insufficiently clear or precise so as to be contrary to public policy.

During the filing and prosecution of trade marks we expect to see an increase in challenges citing a lack of intention to use a mark in relation to specifications, as an element of bad faith. There would also be an increased risk of susceptibility to revocation after grant.

Trade mark owners should review their filing strategies, particularly where defensive, broad specifications have previously been adopted, without an intention to use trade marks to the extent covered by specifications, so as to assess potential risks of bad faith challenges. Meanwhile, all eyes will be on the CJEU for the resolution of this important case.

KEY POINTS

- ✦ A lack of precision in a trade mark’s specification of goods and services is not a new ground for whole or partial invalidity, but may be considered during assessment of an application
- ✦ However, terms such as “computer software” confer on a proprietor a monopoly of immense breadth, which cannot be justified and are therefore contrary to the public interest
- ✦ A deliberate intention to acquire trade mark rights without an intention to use them could constitute an element of bad faith
- ✦ A mark could be declared invalid in part where an applicant intends to use the mark in relation to only part of the specification
- ✦ S32(3) TMA, in relation to the statement of *bona fide* intention of use that is submitted with a trade mark application, is compatible with EU law provided it is not used as the sole basis for finding bad faith



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Thrown into reverse

Yet Dale Carter sees future opportunities for a Volvo comeback

In 2015, Paalupaikka Oy (the Applicant) applied to register the figurative mark shown below right for “wheels” of varying sorts in class 12. Relying on a collection of earlier marks under Articles 8(1)(b) and 8(5) EUTMR, Volvo Trademark Holding AB (Volvo) opposed but was unsuccessful at first instance and on appeal.

In overturning a decision of the Fourth Board of Appeal (BoA) the General Court (GC) confirmed that, when relying on Article 8(5) in opposition proceedings, a finding of partial identity in one or more relevant aspects of two marks is sufficient to trigger an analysis of the additional cumulative elements of Article 8(5).

VISUAL COMPARISON

The GC’s decision turned on a visual comparison between the marks. The BoA had found that the dominant elements of the later-filed mark and the VOLVO word mark were not even “slightly similar” on a visual level, were aurally dissimilar and that no conceptual comparison could be undertaken. As regards a comparison of the Applicant’s mark and Volvo’s figurative marks the BoA found there was no similarity on account of “even wider” differences between them. In light of the BoA’s finding that the marks were dissimilar, it did not go on to consider the other conditions of Article 8(5).

The GC criticised the BoA’s approach and held that the BoA had failed to recognise the existence of numerous identical elements in the dominant parts of the marks in question. These similarities necessitated a finding that there was a low level of visual similarity which, according to the GC, was sufficient to require analysis of the other elements of Article 8(5).

In particular, the BoA had erred in overlooking the near identity of the letter V and the prominence of this letter in the marks, a similar combination of colours and the presence of a circular shape in both. These similarities were not negligible, notwithstanding the significant differences between the marks. The GC annulled the



BoA decision and remitted it to the BoA for reconsideration.

ARTICLE IMPACT

This decision is likely to be seen as strengthening Article 8(5) in the sense that a full analysis of the conditions of this article are necessary even where only a low level of similarity exists between two marks.

It leaves open the possibility for the BoA to find that the similarities between the Applicant’s mark and Volvo’s marks are sufficient to bring the earlier marks to mind and to give rise to damage under Article 8(5). Volvo may be able to rely on the Applicant’s past conduct to point to an intention to take unfair advantage of Volvo’s trade marks. In this regard, and although not considered as part of the present case, the writer notes that the Applicant has filed (and has had refused) other applications for trade marks reminiscent of famous motor vehicle brands. In light of such conduct it may also be difficult for the Applicant to argue that it had “due cause” when adopting the V V-WHEELS mark.

KEY POINTS

- + In assessing similarity under Article 8(5) EUTMR a small degree of similarity between dominant elements is sufficient to require an analysis of the additional conditions of Article 8(5)
- + The existence of common elements in marks that are clear and can be immediately perceived is sufficient to find similarity under Article 8(5). This can include colour combinations

MARKS

APPLICANT’S MARK



V-WHEELS

OPPONENT’S MARKS CONSIDERED BY THE GC



OTHER MARKS PREVIOUSLY FILED BY THE APPLICANT



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In May, CITMA's Paralegal Seminar will explore the obstacles to trade mark registration. Find out more at citma.org.uk



Calendar

What's coming up from CITMA and other IP events of interest

DATE	EVENT	LOCATION	CPD HOURS
5th February	CITMA Lecture – Leeds The scope of protection available for designs in the UK	Womble Bond Dickinson, Leeds LS1	1
11th February	CITMA Charity Quiz Night	Salsa! Temple, London WC2	
19th February	IP Inclusive Webinar Unconscious bias: the basics	Online	1
25th February	CITMA Lecture – London	Venue TBC	1
26th February	IP Inclusive Webinar Inclusivity and the menopause	Online	1
27th February	CITMA Paralegal Webinar The Madrid applications process and foreign filing formalities	Online	1
18th March	CITMA Welcome Drinks Reception* Part of the CITMA Spring Conference	Brasserie Blanc Southbank, London SE1	
19th-20th March	CITMA Spring Conference*	IET London: Savoy Place, London WC2	9
19th March	CITMA Spring Conference Gala Dinner*	House of Commons, Palace of Westminster, London SW1	
25th March	CITMA, ITMA and CITMA Benevolent Fund AGM	London	
31st March	Joint CITMA/CIPA Designs Webinar John Coldham (CITMA) and David Musker (CIPA)	Online	1
12th May	CITMA Lecture – London	CMS London, London EC4	1
22nd May	CITMA Paralegal Seminar Obstacles to trade mark registrations	Keltie LLP, London SE1	3

■ CITMA event ■ IP Inclusive event

SUGGESTIONS WELCOME

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

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THE TRADE MARK 20

Q&A

Dewdney Drew

seems to know a lot about security!

I work as... Director, Trade Marks at Murgitroyd.

Before this role, I was... a Trade Mark Attorney for Murgitroyd and, before that, a solicitor in South Africa.

My current state of mind is... full of new ideas! Murgitroyd has always encouraged innovation within the firm and new ideas are always welcomed.

I became interested in IP when... as a young boy, my dad bought a Lacoste polo shirt and someone explained that the crocodile denoted a brand (“like a badge”) rather than a decoration. This required an explanation in a country that had actual crocodiles – but I liked the concept.

The biggest challenge for IP... is keeping pace with the rise of artificial intelligence. Especially in the area of searching, I expect machine learning to make big advances in the next few years.

In my role, I most enjoy... bringing order to chaos, be that winning an opposition, reaching a win-win settlement or simply organising a trade mark portfolio.

In my role, I most dislike... obstacles to progress that don’t make any sense, be they unfounded objections or obtuse opponents.

On my desk is... as little paper as I can manage. I like to keep a clear desk and work from our online records system. Working remotely is mostly seamless, provided there is good wi-fi.



“

The best piece of advice I’ve been given is... ‘go the extra mile’

My favourite mug says... STARBUCKS; not very original, but I like the coffee and their mugs are the only ones that tend to last.

My favourite place to visit on business is... the United States. I prefer Europe for holidays, as I love the old buildings and

culture, but the States is geared for business and has facilities and attitudes to match.

I am most inspired by... Elon Musk. He is from my home town and I continue to be amazed at the scope of his ambition and imagination.

If I were a brand, I would be... Ralph Lauren, because I like the understated style and the fact that the founder started from the shop floor and built the company from scratch.

The talent I wish I had is... being really good at the martial art of jiu-jitsu. I trained at it a few years ago and it’s amazing for body and mind, but I started too late in life and had to give it up after a few injuries.

I can’t live without... good music.

My ideal day would include... a swim, a glass of wine and a sunset.

In my pocket is... an RFID wallet, an iPhone and a YubiKey (which provides global password protection).

The best piece of advice I’ve been given is... “go the extra mile”.

When I want to relax, I... spend a weekend in the Devon countryside with my family.

In the next five years, I hope to... further expand the firm’s UK client base and bring some interesting cases before the UK IPO.

The best thing about being a member of CITMA is... the friends you make along the way.



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