

CITMA REVIEW

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Welcome to the May 2017 edition of the *CITMA Review*, in which we look back on the delights of our annual Spring Conference. Also inside this issue, we explore the diverse and sometimes arcane world of consulate formalities, as well as the entirely 21st-century phenomenon of e-cigarette flavours and their potential for trade mark infringement.

Events and news about Europe continue to be a focus of the activities of CITMA, and the guide to CE marks on page 24 is a reminder of just one element of law and practice that we all need to be familiar with.

I hope that many members will be interested in the mentoring initiative supported by Nestlé; do let us know if there are other similar schemes that could be promoted by CITMA.

Two teams that do not need more mentoring are Taylor Wessing, our London charity quiz night winners, and Brodies, triumphant at our first Scotland quiz event – well done to them.

Kate O'Rourke

Kate O'Rourke
CITMA President

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CITMA Review

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CITMA | INSIDER

Ministerial meeting for CITMA

CITMA representatives met with Minister for Intellectual Property Jo Johnson MP to discuss the most important issues facing the IP profession as a result of Brexit

CITMA CONTINUES TO represent members and the rest of the profession at meetings about Brexit with Government and UK IPO officials, keeping up with developments on the implementation of Article 50 and beyond. We continue to push for a solution that ensures continued rights of representation before EUIPO, maximises legal certainty and minimises the burden for business.

As part of this work, CITMA representatives met with Minister for Intellectual Property Jo Johnson MP in mid-March to discuss registered and unregistered IP rights, and rights of representation.



CITMA – alongside CIPA, Anti Copying in Design, British Brands Group, the Intellectual Property Lawyers' Association, IP Federation, the Law Society, and the IP Bar – ensured that Mr Johnson was up to date with the most important issues facing the profession. There was a general consensus that these issues are EU trade marks, registered community designs, rights of representation and the Unified Patent Court.

We brought up the desirability of mutual recognition of professional qualifications, with possible loss of earnings for IP professionals catching the Minister's interest. Mr Johnson outlined the Government's position on the need to consider not only the risks arising from Brexit, but also the possible opportunities to improve our law and practice.

We have made contact with a number of Government departments to arrange meetings – including the Department for Exiting the European Union, the Department for International Trade and the Ministry of Justice. Mr Johnson was keen for us to meet with officials from the departments, so suggested that officials at the UK IPO follow up to ensure the meetings take place soon.

Officers provide UK IPO input

CITMA Second Vice-President Richard Goddard has attended a meeting with the UK IPO on registered rights. We continue to discuss the details of the Tuvalu and Montenegro models, and the issues we have identified, which include:

- ▶ **INTENT TO USE:** In contrast with UK national applications (and UK designations of international registrations), EU trade mark (EUTM) applications do not require a bona fide intention to use the trade mark.
- ▶ **NON-USE CANCELLATION:** Both scenarios raise issues for non-use cancellation of EUTM registrations entered onto the UK register.
- ▶ **SENIORITY:** A substantial number of existing EUTM registrations have UK seniority claims, where the earlier UK trade mark registration has been allowed to lapse.
- ▶ **PENDING APPLICATIONS:** Some provision for pending EUTM applications is required (even if only to explicitly exclude pending applications from transfer).
- ▶ **LANGUAGE:** Some EUTM registrations contain errors in the English language version of the specification of goods and services.
- ▶ **ADDRESS FOR SERVICE:** A mechanism for appointing a UK address for service would be required for many EUTMs.
- ▶ **ONGOING PROCEEDINGS:** At the date of Brexit, there will undoubtedly be ongoing proceedings before EUIPO Boards of Appeal and higher courts concerning EUTM applications and registrations.

CITMA First Vice-President Tania Clark was in attendance at a meeting with the UK IPO to discuss unregistered rights. We will continue to seek to influence and shape the debate around what will happen post-Brexit, and keep you updated with our progress and any developments.

Member *move*



Jade MacIntyre has joined Allen & Overy as a Trade Mark Attorney. Jade can be contacted on 020 3088 3044 or at jade.macintyre@allenoverly.com

Research round-up

PIRACY PROBLEM

A new report entitled *The Economic Impacts of Counterfeiting and Piracy* predicts that the costs of such threats could top \$2 trillion by 2022.

The report, released by the International Trademark Association and conducted by Frontier Economics, predicted a rise in the value of counterfeit goods from around \$923bn in 2013 to between \$1.90 trillion and \$2.81 trillion by 2022. The report expects the effect of this activity to result in worldwide net job losses of 4.2 to 5.4 million by 2022.

ROOTS OF INNOVATION

New research shows that the UK ranks top for IP enforcement, and is second only to the US overall when evaluated across a range of IP indicators related to patents, trade marks, copyright, trade secrets, enforcement and international treaties.

OVERALL SCORES BY COUNTRY – TOP 10

US 36.62
UK 32.39
Germany 31.92
Japan 31.29
Sweden 30.99
France 30.87
Switzerland 29.86
Singapore 28.62
South Korea 28.31
Italy 27.73

ENFORCEMENT – TOP 10

UK 6.51
Sweden 6.39
France 6.38
Germany 6.29
US 6.27
Japan 6.16
Switzerland 5.73
Australia 5.29
Singapore 5.03
Israel 4.94

Source: *The Roots of Innovation, US Chamber International IP Index, Global Intellectual Property Center, US Chamber of Commerce* (February 2017). Accessed 7th March at bit.ly/RootsInnovation

Tim Moss takes top IPO post

The UK IPO has appointed Tim Moss as its new Chief Executive. Moss had been the Registrar of Companies for England and Wales and Chief Executive at Companies House since March 2012.

His extensive work portfolio includes leading on the digital agenda, operational delivery, business strategy and corporate policy.

Before joining Companies House, he spent 12 years in senior operational roles in the manufacturing industry.

CITMA President Kate O'Rourke said: "We very much look forward to working with Tim. CITMA places great emphasis on its relationship with the UK IPO – and we look forward to enhancing that with further collaboration in the future."

IP Inclusive award

IP Inclusive, to whose charter CITMA is a founding signatory, received the Corporate Social Responsibility Award at the 2017 Managing IP Awards in London. The initiative is also celebrating the 100th signatory to its charter for equality, diversity and inclusion.

IP Inclusive is a diversity movement that exists to improve access to the IP professions, regardless of disability, age, gender, sexual orientation, or social, economic and cultural background. The award recognised IP Inclusive's work in uniting IP professionals in the pursuit of greater inclusivity.

TCEs: cover story update

SINCE THE PUBLICATION of "Signs of change" (*CITMA Review*, March/April 2017), the WIPO Intergovernmental Committee has concluded its 33rd session dedicated to considering the protection of traditional cultural expressions (TCEs). Although there is a long way to go to reach consensus on core issues, the session did result in a further draft text, which was generally agreed to be a good basis for ongoing negotiations. Among the main issues that remain the subject of debate between member states, and for which additional alternative proposals have now been included in the draft text for consideration, are: the subject matter and definition of TCEs; scope of protection; beneficiaries; and limitations and exceptions. Discussions will continue in June in the hope of reaching greater clarity.

Find out more at wipo.int/tk/en/igc

TCEs were the focus of the cover feature in the March/April 2017 edition of the *CITMA Review*





Filings focus

Isobel Ferguson relays valuable takeaways from a recent CITMA/CIPA designs round-table discussion

Design filings will generally form a comparatively small percentage of a patent or Trade Mark Attorney's workload – even for the most strategy savvy. Limited exposure to designs, and the minefield of uncertainty caused by Trunki and Brexit, means that careful consideration of design filing strategy has never been more important. With this in mind, a CITMA/CIPA round-table discussion set out to explore strategies adopted by attorneys for filing designs in this changing landscape.

Although design protection is often sold as a “cheap” alternative to patent protection, the cost of preparing, filing and prosecuting an effective design is rising. In an ideal world, following Trunki, designs would encompass computer-aided design (CAD) drawings, greyscale images, photographs and line drawings to ensure exhaustive protection. In addition, in the wake of the Brexit vote, many attorneys are advising simultaneous filing of UK registered designs and registered community designs. However, clients can be reluctant to incur the expense of multiple approaches. A key theme throughout the discussion was how to strike a balance between optimising protection and curbing costs.

For example, should a design be filed as a multiple design application as a matter of course? Here, Trade Mark Attorneys were most likely to use designs as an alternative to a trade mark, such as for packaging or get-up, filing multiple designs encompassing a series of different but overlapping features. Patent attorneys tended to view each design as a claim, first seeking to protect the whole product and then building out to see where narrower protection could be obtained. The discussion highlighted the significance of prioritising the important aspects of a design to inform a decision on whether a multiple design should be filed.

A further point of discussion focused on strategies that anticipate Brexit, after which community design rights will not offer protection

in the UK, and a separate national right will be necessary to maintain design protection. Precautionary measures include: filing a UK registered design alongside a registered community design; and advising clients to continue to file only registered community designs, on the basis that it seems likely that some measure will be put in place to convert this right into a UK design right – if the design is still important to the client when the time comes, the design can be re-registered as a UK right.

Also raised was the point that, post-Brexit, clients will not benefit from the protection afforded by unregistered community designs. They will, therefore, have to consider bringing costs forward and filing a registered community design before expiry of the grace period if protection in Europe is important.

Finally, the discussion focused on international design filings. As design filers will know, it is impossible to submit one perfect set of drawings to cover all territories – eg dotted lines used to disclaim features in Europe may not be allowable in China. Equally, line drawings favoured in Europe often receive objections in the US, where there are more stringent shading and hatching requirements. Many attorneys file multiple drawings suitable for obtaining a registered community design, with the view that any objections raised against subsequently filed foreign applications can be dealt with when they arise. An alternative strategy involves preparing different drawings suitable for multiple jurisdictions and filing all of them in the initial priority-founding application, to be simply lifted out for subsequent international filings. ■



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A version of this article was provided to the CIPA Journal

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A large, stylized graphic of the letters 'IP' in a serif font, centered within a white circular shape. The background is a light gray with a white swoosh that curves around the top and right sides of the circle.

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SCOTLAND JOINS QUIZ TRADITION

For the first time, two CITMA events brought members together in search of general knowledge glory

Long the sole field of battle for CITMA pub quiz enthusiasts, London welcomed a Scottish skirmish into the fold this year. Here are some highlights from these sister events.

LONDON: TAYLOR WESSING IS TOP

Some 20 teams assembled at Penderel's Oak, Holborn, for a spirited competition that saw Taylor Wessing's "Emergency Brexit" team crowned CITMA's 2017 London charity quiz champions.

The team came through the 10 rounds of questions with an impressive score of 176.5 – which included full marks in six of the rounds. They finished just one point ahead of second-placed Beck Greener. Dehns finished third on 169 points.

Half of the £1,863 raised will go to our Benevolent Fund, and half will be donated to Taylor Wessing's chosen charity, Wide Horizons, which provides opportunities for children to experience adventures as part of their education and development.

Special thanks go to markers Marine Body, John Goldham, Bill Hanson, Richard Hayward, James O'Hanlon, Francis Preedy and Serena Totino.

1. CITMA President Kate O'Rourke (far right) was on hand to present the CITMA quiz trophy to the winning team of (left to right) Jason Rawkins, Christopher Benson, Suzy Shinner and Andi Terziu
2. The Mishcon de Reya team ready for action: (left to right) Sally Britton, Jonty Warner, Rose Franckeiss, Cassie Hill and Jaimee Spencer-Bickle
3. The third-placed Dehns team: (left to right) Joanna Furnmston, Julie Glendinning, Elaine Deyes, Clare Mann, Adam Kellett and Christopher Pett



SCOTLAND: BRODIES CLEANS UP

The first Scottish CITMA quiz took place at Edinburgh's ominously named Voodoo Rooms. Happily, the only sacrifice was the dignity of the least impressive team. The area of the venue where the quiz took place may have been called the Speakeasy, but quizmaster Colin Cruickshank provided no easy questions. Teams were challenged to identify film titles from code derived from the periodic table of chemical elements, and faced a variety of challenging history, geography and law questions.

Ultimately, the winner was Brodies' "WIPO the Floor with Them" team, with The Royal Bank of Scotland's "IP IQ" team coming a close second.

This year's event was oversubscribed, so look out for a bigger and even better event next year.

1. The winning team celebrates with the unofficial CITMA quiz trophy
2. The runners-up smile in the face of defeat
3. Quizmaster Colin Cruickshank held the floor



10 TESTING QUESTIONS – HOW WILL YOU DO?

1. Which carbonated soft drink was first introduced to the US in 1893 as Brad's Drink?
2. What did Rowntree's Chocolate Crisp become in 1937?
3. Which game manufacturer derived its name from an earlier company known as Service Games of Japan?
4. What does the "J" stand for in "Donald J Trump"?
5. In which eastern European (and EU) country was the new US First Lady, Melania Trump, born?
6. When were some women first allowed to vote in the UK?
7. In 2016, it was announced that *The Great British Bake Off* would be moving from the BBC to which broadcaster?
8. Which part of a newborn baby is 75 per cent of the size it will be when the child is fully grown?
9. In which year was Princess Elizabeth (later Queen Elizabeth II) born?
10. What is the name of Peppa Pig's younger brother?

Answers: 1. Pepsi 2. Kit Kat 3. Sega
4. John 5. Slovenia 6. 1918 7. Channel 4
8. Eye 9. 1926 10. George



CONFERENCE ON THE CUTTY EDGE

Modern issues met English heritage at CITMA's annual flagship event

PHOTOGRAPHY BY SIMON O'CONNOR

The CITMA Spring Conference, on the theme of “Navigating the Seas of Change”, took place in the shadow of Article 50’s impending activation. Brexit was very much on the mind of participants and the expert panel of international speakers, who offered a global perspective on the issue, among many other topics.

KEY BREXIT TAKEAWAYS

- **Offers of cooperation and reassurance**

“I see a lot of cooperation and business opportunities between the UK and continental Europe,” said **Peter Müller**, Immediate Past President of the European Communities Trade Mark Association. “Let’s continue to talk,” he added. Norwegian attorney **Hilde Vold-Burgess** said: “I’m not too worried about UK trade marks – it will work, like it does in Norway.”

- **UK remains important for US**

Jess Collen of Collen IP, New York, reassured delegates that: “The UK is a very important market

for the US. No matter how Brexit is accomplished, it should not have a substantial impact on American companies and their practice. If US companies have to file separately in the UK, they will. Even if US companies need to file new applications to completely replace EU trade mark registrations, they will.”

- **The importance of IP to the UK economy**

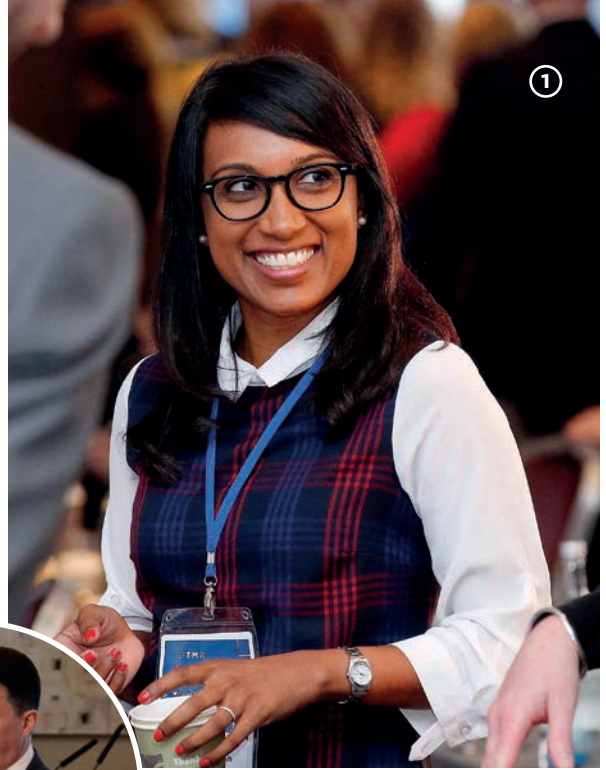
Adam Williams, Director of International Policy at the UK IPO, reiterated the importance that the Government places on IP’s role in the UK economy.

“We know that investment in intangible assets outstrips investment in tangible assets,” he said. “We are clear that we will continue to deliver quality rights-granting services, lead the world in enforcement and engage in international IP discussions. When the negotiations on Brexit do begin, the focus will be on getting the right outcome for UK investors, customers and creators.”

HAGUE IS NEEDED, SAYS SPEAKER

David Stone of Allen & Overy told delegates that: “Brexit makes it even more important for the UK to accede to the Hague Agreement.”

He outlined the potential benefits to the UK of joining the system for registering designs provided under the Hague Agreement Concerning the International Deposit of Industrial Designs. Without Hague, UK businesses will lose the ability to file registered community designs directly. The UK joining the system in its own right would reopen the EU community registered design right to UK business, and enable UK-based attorneys to file them. Under the powers given by the Intellectual Property Act 2014, the UK Government has indicated its intention to accede to the Hague Agreement. Read more of David’s thoughts at citma.org.uk/news



POST-BREAKUP RIGHTS

Djura Mijatovic, who has first-hand experience of how IP rights were dealt with following the breakup of Yugoslavia into multiple jurisdictions, provided insight and lessons learned. Each of the former Yugoslav nations formed a new IP office and passed its own IP laws. Each then adopted its own timeline and method of dealing with validation of those rights. Read more about what he told delegates at citma.org.uk/news

1. International delegate Denise Mirandah of Mirandah Asia 2. An inspiring dinner under the restored *Cutty Sark* 3. “Throwable” microphones – a Spring Conference first 4. Keynote speaker Fraser Morrison of the Edrington Group gave insight into the *Cutty Sark* Whisky brand



PETER MÜLLER



“A huge thanks to CITMA for delivering yet another fantastic conference! The speakers this year offered a number of valuable insights into what we were, by the end of the conference, referring to as ‘the B word’. It was fantastic catching up with old friends and making new ones. I very much look forward to attending again next year”

CARRIE BRADLEY, STOBBS IP, UK

“As an overseas member of CITMA, I particularly appreciated the insight on the legislative and practical changes that are to be expected in the next few years. Hearing views from UK IPO officials, UK practitioners and international attorneys, all providing their countries’ perspectives on Brexit, has given me a deeper understanding of the repercussions for our profession”

SILVIA BERTOLERO, LAMBERT & ASSOCIÉS, FRANCE

- 1. CITMA President Kate O'Rourke dines with speakers
- 2. Coffee-break networking
- 3. Keven Bader addresses delegates
- 4. Tania Clark holds the floor during our Brexit discussion
- 5. The magnificent Gala Dinner
- 6. The team from Gold sponsor Corsearch

“My highlight of this year’s CITMA Spring Conference was the gala evening on the *Cutty Sark*. She was pretty and welcoming. We climbed aboard to experience the smell of old tea, the sight of small bunks and the London chill on the upper deck. What a beauty! Thank you, CITMA”

ERAN SOROKER, SOROKER
AGMON NORDMAN, ISRAEL



4



5



HILDE VOLD-BURGESS



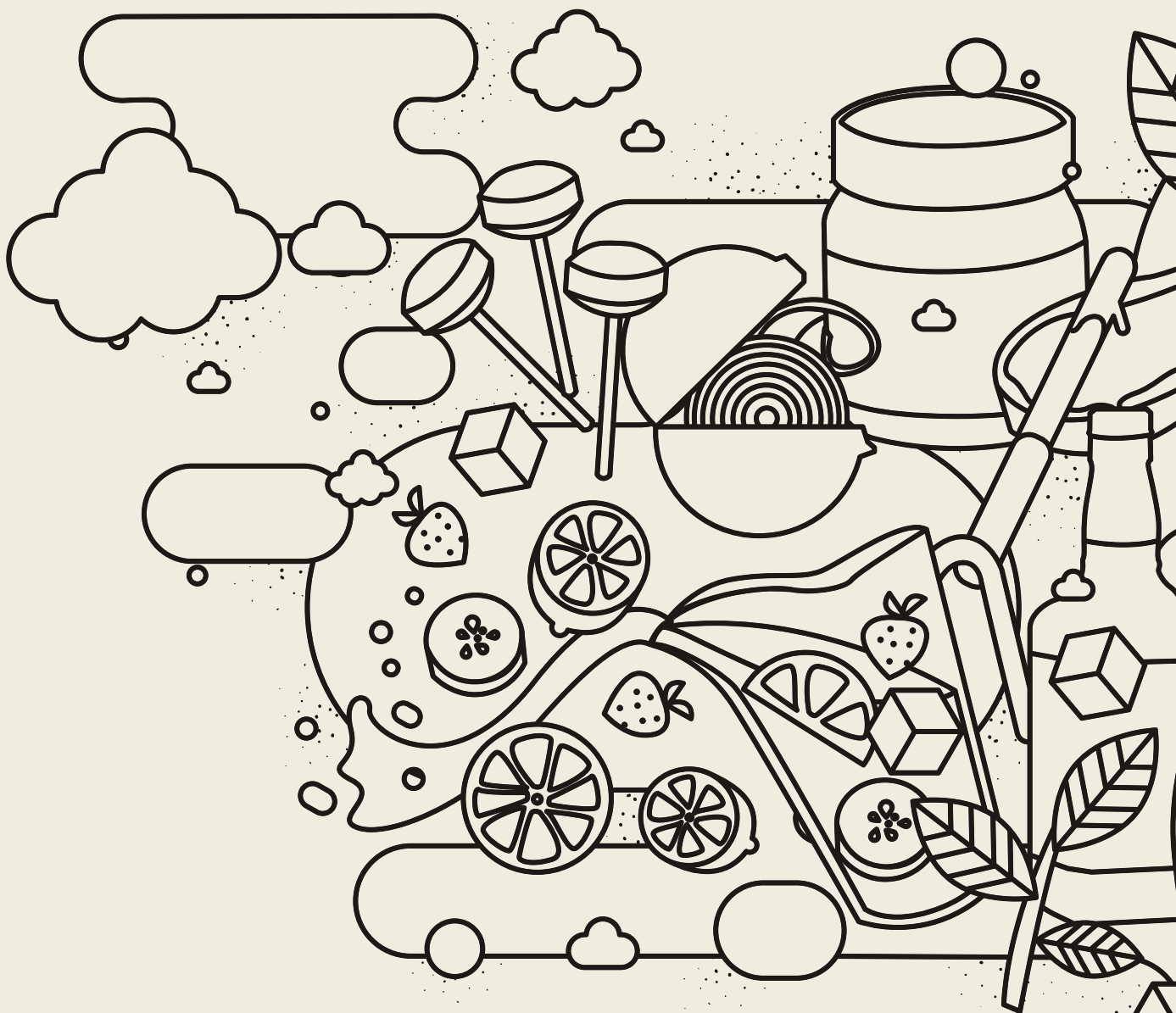
JESS COLLEN

“David Stone, one of the most engaging public speakers in the field of IP law, was the perfect choice to close the final day. I always feel a little sad at the conclusion of the conference, as it means saying goodbye to a fantastic group of international friends and trade mark experts, and this year was no exception”

DÉSIRÉE FIELDS,
DLA PIPER, UK



6



UP IN SMOKE?

As e-cigarette use blows up, so do the dangers of trade mark infringement for well-known brands, as Claire Jones explains



E-liquids have taken hold in the UK at an astonishing speed, with vape shops offering a dazzling array of flavoured products popping up on nearly every high street. But, whether by ignorance or design, many e-liquid products piggy-back on the familiarity and reputation of well-known consumer brands.

From a consumer's perspective, the ability to go into a vape shop and purchase a flavour named after a favourite soft drink or confectionery makes absolute sense. Selections might be made based on nostalgia (perhaps the taste of an ideal childhood breakfast involving a hazelnut and chocolate spread) and brand reputation, but do these e-liquid businesses have the right to use those brand names? Have they licensed the recipes and trade marks, as current practice would suggest? Overwhelmingly, the answer to these questions appears to be no.

HEADY RISE

The modern-day e-cigarette was first launched in Beijing in 2004 by a Chinese pharmacist named Hon Lik. The battery-powered devices are designed to simulate the effects of smoking by heating a nicotine liquid into vapour that is then inhaled by the user. The liquid, which contains propylene glycol, varying levels of nicotine and flavourings, is known as e-liquid or e-juice.

Global use of e-cigarettes and e-liquids has grown exponentially in recent years, and the promotion of such products, especially via the internet and high-street vape shops, is on the rise. Numerous e-liquid strengths and flavours are available

ALIX THOMAZI

from a range of sellers, all of which are in competition with each other to grab a share of this increasingly lucrative market.

As the base liquids are available in numerous flavours – including confectionery and soft drinks – there is rising concern that e-cigarettes are attracting a younger, non-smoking audience, rather than acting as a nicotine-replacement therapy for existing smokers, as they were originally marketed. For brand owners and IP practitioners, however, there is another concern: trade mark infringement.

TASTE THE DIFFERENCE

Common categories of e-liquid flavour include sweets, foods, drinks and cocktails, which are sold alongside the “original” tobacco-flavoured liquids. This can cause issues for brand owners in these sectors. Often, they do not have trade mark registrations in class 34, covering tobacco and tobacco-related products, such as e-liquid – and they may not want their brands to be associated with such products.

As part of research into this topic, Novagraaf undertook an initial internet search, which brought up numerous sites selling e-liquids that were also using registered brands or images of identical/similar packaging to sell their products. Some examples from easily found web shops include:

- “Skittles” e-liquid,
- “Chocolate Orange” and “Pimms” e-liquids,
- “Jack Daniels” and “Vimto” e-liquids,
- “J2O” and “BubbleGum (Hubba Bubba)” e-liquids, and
- “Swizzels Lolly” and “Nutella” e-liquids.

PLANS OF ACTION

If a company selling e-liquids markets its goods under a brand name, what can be done?

Without a trade mark registration, it is not possible for the brand owner to claim trade mark infringement on the basis that the goods are identical or

E-CIGARETTES: EXTENT AND IMPACT

By 2014, there were nearly 500 e-cigarette companies, and worldwide e-cigarette sales totalled \$7bn.

Action on Smoking and Health (ASH) released the following statistics in May 2016:

- An estimated 2.8 million adults in the UK use e-cigarettes (6 per cent of the adult population), up from 700,000 in 2012.
- Awareness of e-cigarettes is widespread, with 96 per cent of smokers, and 93 per cent of non-smokers, aware of them.
- After tobacco flavours (which are popular with current smokers), the most popular flavours of e-liquids are fruit and menthol flavours.

In 2010, the Electronic Cigarette Industry Trade Association (ECITA) was established to set policy and regulation relating to the e-cigarette industry. Its website (ecita.org.uk) provides advice for consumers and companies in the industry on compliance with European and UK directives and regulations, and features a code of conduct.

ECITA also runs a range of seminars. If there is an issue with a company that is an ECITA member, it may be worth contacting the organisation to see if it can offer any assistance.

confusingly similar. Therefore, any infringement claim would need to be based on reputation, unfair advantage or detriment under s10(3) of the Trade Marks Act 1994:

“A person infringes a registered trade mark if he uses in the course of trade in relation to goods or services a sign which (a) is identical with or similar to the trade mark, where the trade mark has a reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.”

A mark has a “reputation” if it is known either by the public at large or by a significant part of the public concerned by the product or services covered by that mark, and if there is a link with the mark. If the infringing mark calls the earlier mark with a reputation to mind, that is tantamount to the existence of such a link in the mind of the average consumer.

An alternative (in the UK) would be for a brand owner to bring an action for passing off, a common-law action that provides protection against

misrepresentation of a trade mark and the damage that can subsequently be caused.

However, the responsibility of proving reputation for the purposes of infringement or passing off can be burdensome and expensive for brand owners who simply want to prevent their brand being used in relation to tobacco/nicotine products, such as e-liquids. Not only will there have been significant investment in the creation of such brands, but also they may include family-oriented products, and links with tobacco replacements can be seen as detrimental to the ethos of the brands involved.

In the US, General Mills (Cinnamon Toast Crunch), Ferrara Candy Company (Fruit Stripe) and Girl Scouts of the USA have all recently taken action against trade mark infringement in this area, and the number of lawsuits relating to e-liquid flavours in the US is growing. In its complaints about trade mark infringement, Girl Scouts of the USA noted the questionable ethics of selling flavours based on products aimed at the youth market.



Interestingly, Trading Standards recently became involved in a number of e-liquid disputes and removed six brands from the market

In the UK, energy-drink company Red Bull took similar action against third-party use of the Red Bull brand in connection with the sale of unauthorised e-liquids in 2015. Red Bull issued proceedings at the IPEC for trade mark infringement against thevapourplanet.co.uk and its sole director. The action was successful, and the Court granted an order restraining the Defendants from infringing Red Bull's rights and ordering them to pay Red Bull's costs.¹

TAKING STEPS

As brand owners and IP practitioners know all too well, trade mark registration is only the first step in the effective use and protection of a chosen brand, company or product name; these assets also need to be monitored for unauthorised and potentially damaging use.

The starting point in any e-liquid infringement action will generally be to send a cease-and-desist letter to the infringer, informing it of a brand's rights/trade marks and requesting that the infringing products are removed/rebranded. Further action can then be assessed in light of the response received (if any). If a company is receptive and removes the infringing mark, the costs of infringement or passing off actions can be avoided. Remember also that, if the e-liquid companies use

platforms like eBay and Facebook, such websites have in place protection measures to take down infringing products quickly and easily.

As a general rule, the earlier trade mark infringement or misuse is identified, the easier it is for a company to enforce its trade mark rights. Early detection helps in identifying and considering the level of risk (and in which markets), and allows brand owners to amass a portfolio of evidence of misuse and use it in action against infringements. Here, online trade mark watching also plays a crucial role.

Monitoring for infringement online can be something of a headache for brand owners; however, tools are available to help. For example, Social Mention (socialmention.com) provides an effective, real-time alert system that monitors keywords across more than 100 social media sites, including Twitter, Facebook and YouTube – while Image Raider (imageraider.com) allows users to undertake image searching to locate websites using brand images without permission.

Trade mark watching is an equally important tool in the proactive monitoring of registered marks and devices, but cost can be an issue. To be truly effective, a trade mark watching strategy needs to take into account the size and reach of the brand owner's portfolio.

If a company owns a sizeable portfolio and trades globally, it may not be possible or cost-effective to watch every trade mark in every jurisdiction. Where that is the case, it is generally advisable for the brand owner to focus its efforts by identifying and prioritising core

brands and jurisdictions that warrant complete protection, in contrast to the “nice to have” or secondary brands. The same applies, of course, to markets, and it is here that infringing use by e-liquid providers must be assessed for risk and impact on a brand and its reputation.

Interestingly, Trading Standards recently became involved in a number of e-liquid disputes and removed six brands from the market, including an e-liquid whose packaging was identical to the McDonald's apple pie box, and another presented in a Krispy Kreme-style box.

While this is clearly good news, these actions were taken on the basis that non-food products cannot resemble food, and that the packaging did not contain adequate labelling warning of the harmful effects of certain chemicals. However, these actions do provide potential additional avenues for brand owners to explore.

WATCH AND WAIT?

At present, e-liquid companies appear able to sell products with infringing names without notable repercussions. As more brand owners take action, however, the use of infringing names will become less attractive. Incorporating vaping websites and sales channels – including social media and auction sites – in trade mark watching strategies will help brand owners gather the evidence needed to battle this growing source of trade mark infringement, and also educate the vaping market against launching infringing flavours. ■

1. Claim No. IP.2015.000119.



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Keeping it legal

Charles Henshaw leads us around the dynamic and diverse world of consulate formalities

Many attorneys have, at one time or another, found the legalisation of documents to be a complex and frustrating venture, fraught with surprising twists and turns. In fact, if you are an individual, company, Trade Mark Attorney or notary who regularly deals with cross-border transactions, this feeling will be all too familiar. And, for those who do not deal with legalisation full time and are therefore unfamiliar with the ever-changing documentary requirements of each consulate, the process can be particularly frustrating.

Each consulate has its own unique quirk that must be accommodated for a private or commercial document to enjoy smooth processing.

PRACTICALITIES

Authorities abroad, such as notaries, registries and banks, may request that a document that has originated in the UK be “legalised” for it to be submitted successfully. Relevant documents must be lodged at the legalisation department of the Foreign & Commonwealth Office (FCO) to obtain the apostille stamp. The FCO, which registers notaries and the authorised officers of such Governmental authorities based in the UK, will then confirm that the signature, seal or stamp of a notary or a UK public official (ie a Governmental authority) on the document is genuine.

Once the document bears the apostille stamp, it is deemed legalised, and will be accepted in countries such as Germany

“

Once the document bears the apostille stamp, it is deemed legalised, and will be accepted in countries that have signed up to the Apostille Convention

and Spain, which have signed up to the Apostille Convention.¹

There are, however, many countries that require a document to be further legalised (or consularised) for it to be acceptable for use. This involves sending the document that bears the apostille to the UK-based consulate of the receiving jurisdiction to obtain a second stamp that verifies the apostille.

It is of the utmost importance to ascertain the origin of a document that is to be legalised. UK documents must undergo different formalities to those from abroad, British Overseas Territories or Crown Dependencies. If a document originates from a British Overseas Territory, such as the British Virgin Islands or Gibraltar, it must first be legalised using the apostille of that particular jurisdiction, then sent to the UK to be legalised by the FCO apostille, and finally forwarded on to the relevant consulate to complete the process.

Exceptionally, if the origin of the document is one of the Crown Dependencies (ie the Isle of Man or the Channel Islands), it is usually possible to forward the already legalised document (bearing the apostille of that Crown Dependency) directly to the consulate in question without any need for the FCO apostille to be obtained beforehand.

SPECIFIC REQUIREMENTS

The **Chinese** embassy requests copies of a company director's passport, proof of directorship and a signed letter requesting that the document be legalised. (The agent lodging the documents to be legalised must produce a letter of authorisation.) Furthermore,

documents that are not bound will not be accepted.

The **Taiwanese** consulate demands a signed application form from the client, a copy of the passport of the person signing the application, and a notarised power of attorney authorising the agent to submit the document to be legalised to the consulate.

Documents for Middle Eastern countries such as **Iraq** and **Saudi Arabia** are to be processed not only by the FCO (by virtue of the apostille stamp), but also by the Arab British Chamber of Commerce (ABCC) and respective consulate of the country in question. To complicate matters further, the ABCC only accepts documents on the headed paper of the attesting notary. Given the timeframe for legalising documents by the ABCC alone (approximately one week), this must be addressed immediately, as the client will not appreciate any further delay.

Regarding documents for **Kuwait**, any contract signed by two parties cannot be processed directly by the Kuwaiti consulate; it must be processed by ABCC beforehand.

The consulate of the **UAE** will not accept the bundling of documents, even if they all refer to the same company, so this must always be considered, even at as early a stage as the notarisation of the documents. It would be advisable to have them attested separately in this regard.

The **Lebanese** consulate requires that any dual-language documents are translated and bound together, showing their dual languages on separate pages as opposed to dual columns on one page.

With respect to powers of attorney, the **Bangladeshi** consulate requests passport copies for the principal and any witnesses, proof of directorship, and passport-sized photos for the principal and attorney (and, in some cases, the notary).

Documents that are being lodged at the **Indonesian** consulate must show a UK address in the body of the document. This applies to documents for both individuals and companies.

There are consulates in other territories that require translation of documents into their official language before they will process an application. The **Angolan** consulate requires that all documents be translated into Portuguese before submission.

Not every country has diplomatic representation in the UK. Therefore, in the case of **Haiti**, for example, it is necessary to seek legalisation at the British consulate in Brussels. **Syria** also does not have any consular representation in the UK at present.

There are, of course, different reasons why a document will not be legalised in the UK. These are not just due to the strict requirements of a consulate. The client, for example, may want to avoid expensive consulate disbursement costs – in the case of the UAE consulate, it is £500 per commercial document at the time of writing – and seek an alternative route, such as travelling to the country concerned to do business in person. However, this is not usually practical – especially when carrying out multiple simultaneous transactions, or for a company with business interests in different jurisdictions.

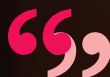
As more countries become party to the Apostille Convention (Brazil and Chile joined last year) – whereupon they are satisfied with the apostille alone – legalisation should be more straightforward in future. Unfortunately, this is a process that takes time. In the interim, to avoid delays for representatives and clients, it is crucial to stay up to date with the requirements of the various consulates by regularly checking the consular websites or calling the consulate in question to confirm the requirements before lodging documents. ■

1. The Hague Convention of 5th October 1961 Abolishing the Requirement of Legalisation for Foreign Public Documents.



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ALIX THOMAZI

WHO DO YOU KNOW?

It could be the question that makes or breaks a legal career. And, as Sarah McPoland reports, it is hoped that a new scheme will help make some influential introductions

On 31st January 2017, Nestlé UK & Ireland launched a new mentoring scheme to enable students from the University of Greenwich to receive guidance from people holding a variety of roles in the legal profession. The scheme will help give the students involved an idea of the different routes into the legal profession, and provide guidance as they look to begin their own legal careers.

CITMA is supporting the scheme by providing an additional Chartered Trade Mark Attorney (CTMA) as a mentor, and by allowing the two students being mentored by CTMAs to attend some of CITMA's evening lectures to help them

understand more about CITMA and give them access to the profession, so that they can begin to create their own networks.

GLOBAL EFFORT

The mentoring scheme is one way in which Nestlé's global legal team is supporting the organisation's Alliance for YOUth initiative, which provides work experience and training for young people across Europe; legal mentoring schemes have been launching in various countries. As part of deciding how best to provide support in the UK and Ireland, the local legal team considered what we could do to make a difference, and agreed that diversity would be our theme.

It is still the case that a large proportion of legal professionals in the UK comes through universities ranked in the top 10 for law, or those considered "old universities", including the Russell Group. In an attempt to widen the potential intake, we decided to work with a newer university ranked outside the top 10.

Heather Fox, Senior Counsel at Nestlé, brought the scheme to life in the UK by working with White & Case LLP to make it available to students at the University of Greenwich (ranked 27th for law in the UK by *The Guardian*). Greenwich advertised the scheme internally and, after screening, matched applicants with the mentors who were the best fit for the careers that the students hoped to pursue.

Mark Bearfoot: why I mentor

I first became involved in mentoring when I was considering my own career development at The Coca-Cola Company. I was advised by my general counsel at the time that a mentor would be extremely valuable for my development, particularly given my unusual career path. I therefore reached out to a global trade mark counsel at another multinational brand owner who I knew and respected. She kindly agreed to become my mentor. This relationship allowed me to gain valuable insight into the skills I would need to fulfil my career ambitions. But, more importantly, she helped me develop these skills through agreed assignments. The hardest of these assignments was undertaking a 360-degree review by colleagues, in which I received anonymous feedback on my various competencies.

When I joined Harley-Davidson, I wanted to share my experiences with people who were just starting out on their own career paths, so I established a legal internship as part of the company's existing internship programme. This is a 12-month, paid internship that gives graduates the opportunity to gain valuable work experience. When we began the recruitment process in the first year, it gave me my first real exposure to graduate recruitment. It quickly became apparent that there were candidates with significant potential who were losing out, simply because they lacked the basic skills of drafting effective cover letters/CVs and interview technique.



Whoever the successful internship candidate is, I always make sure I dedicate a sufficient amount of time to mentoring that individual, so that, when they finish their internship, they have the necessary skills to succeed in the legal profession and hopefully secure a training contract – preferably as a Trainee Trade Mark Attorney.

Having just completed my fourth year of sifting through internship applications, I have learned that you should never judge a candidate based solely on a cover letter or CV. It is important to include a "wild card" in the interview round, because that person might just surprise you. My most successful intern was a wild card in his year of application.

To conclude with some food for thought, in 2015, a total of 15,431 students graduated with degrees in law from universities in England and Wales – yet, in the same year, there were only 5,457 new traineeships registered with the Solicitors Regulation Authority. That is a significant number of potentially great candidates that the legal profession is losing.

Mark Bearfoot is Brand Protection Manager EMEA at Harley-Davidson Europe Ltd

Almost the entire legal team at Nestlé UK & Ireland is involved in this scheme, acting as mentors, including our marketing paralegal, our data protection officer and a number of solicitors. White & Case LLP has also put forward various lawyers to act as mentors. Representing CITMA members, I am helping students who would like to consider becoming CTMAs, and Mark Bearfoot of Harley-Davidson is acting as a mentor (see box, left).

ADDED EMPLOYABILITY

According to Sally Gill, Principal Lecturer and Director at the Legal Advice Centre at the University of Greenwich, the mentoring programme adds to the strong employability ethos in place at the university: “Many of our students are the first in their families to go to university: a scheme like this really makes a difference to diversity in the legal profession, and ensures that our students compete on a more level playing field.”

Students involved are equally enthusiastic. Siraat Rangari, a 2016 LLB graduate from Greenwich, said: “I was absolutely ecstatic when I was offered a mentor, as well as an invitation to an evening where I could network with high-profile lawyers. I view it as a fantastic opportunity to receive precious guidance on careers in law, and I am pleased to be part of the first year of the scheme.”

When I was a student, I didn't know any Trade Mark Attorneys or solicitors who could guide me or introduce me to people offering work experience opportunities, etc. I just want to be able to help somebody else who may be in the same position as I was during those early days. It will be a bonus if I can help raise awareness that students without connections in the legal profession could be at a disadvantage and need the help of those who have qualified and established themselves in the profession.



When I was a student, I didn't know any Trade Mark Attorneys or solicitors who could guide me. I just want to be able to help somebody else who may be in the same position as I was during those early days

BREAKING BARRIERS

It is established that a network that provides access to those in the law profession can have a significant impact on students' ability to find opportunities, such as internships and work placements, that will form their views of, and perceived suitability for, the legal profession.

In a 2010 paper on barriers to the legal profession, the Legal Services Board (LSB) considered an array of research on the subject and concluded that: “The provision of legal services at the highest levels and in the most prestigious firms is dominated by white, male lawyers from the highest socio-economic groups. Our belief is that such an outcome does not occur as a result of overt discrimination but instead barriers to entry and progression occur over the lifetime of individuals seeking a career in law from initial education, to training, to gaining experience within a law firm.”¹

In discussing the importance of early work experience to those hoping to gain a training contract, the LSB paper acknowledged that: “Social background is significantly related to the success of gaining work experience with those from privileged backgrounds more likely to achieve

this ... This lack of social diversity may be due to firms receiving requests for work experience from family members of clients or colleagues, with one large firm allocating three of its ten vacation placements to such individuals ... Those from a background in which internships are commonplace are more likely to know of their existence and have the social networks to know the qualities that the firms are looking for.”

While the LSB paper was written almost seven years ago, and addresses the solicitor and barrister, rather than CTMA, career paths, many of the points raised are still thought provoking.

It points out that: “Ethnic minority law graduates are significantly more likely than their white equivalents to have studied at a new university with 87% of African Caribbean having done so.”

This would suggest that our scheme is on the right track. To increase diversity in law, newer universities are the obvious place to begin. Hopefully, this Nestlé initiative will see us begin to make a real impact. ■

1. Legal Services Board, *Barriers to the Legal Profession* (2010), bit.ly/LSBreport



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CE MADE SIMPLE

Thomas Hooper offers a user's guide to this European Economic Area mark

Will CE marking considerations come into play as part of a day-to-day trade mark role? Probably not, but many clients with whom IP professionals work will be required to have the CE mark affixed to their products. This might ultimately affect a client's branding decisions, and will most certainly affect its choice of manufacturer if a particular company refuses to add the mark to products, or does so incorrectly. Therefore, as trusted advisors, trade mark professionals should have some knowledge of how and when CE marking considerations come into play.

WHAT IS THE CE MARK?

A CE mark is a mark that appears on a wide variety of products traded in the European Economic Area (EEA). In its simplest form, the CE mark is a type of branding that indicates that certain products are compliant with European laws. The term is an abbreviation of *conformité européenne*, French for "European conformity".

Common products that carry the markings include: glasses, phones, televisions, machinery, medical devices and children's toys. By affixing the CE mark to a product, the manufacturer is declaring that it conforms with the relevant European laws and directives regarding safety, health and environmental protection

requirements, and that it has carried out the necessary assessment procedures to come to that conclusion. Once affixed with the CE mark, the products can move freely in the single market, even if they have not been made there. It is then the duty of the distributor (or the EEA importer) to check that the mark has been applied correctly to the relevant products, and that it has documentation to prove this.

Not all products must have the CE mark affixed, however. In fact, it is forbidden for the CE mark to be affixed to products that are

not covered by European directives. The most commonly noted products that do not require CE marking include cosmetics, pharmaceuticals and foodstuffs.

A list of products that are required to be affixed with a CE mark can be found at bit.ly/CEguidance.

WHY DOES IT MATTER?

CE marks matter because they affect our clients, especially start-ups. More importantly, they give consumers satisfaction that our clients' products meet the necessary health and safety laws. It also means





Remember: it is very important not to simply add the CE mark ‘just in case’, because this can have serious repercussions

that businesses can have certainty that their products can be traded in the EEA without restriction.

While a parent might not check their children’s toys for the CE mark, a distributor or retailer most certainly will. It is, therefore, crucially important that the manufacturer knows whether or not the products are intended for sale in the EEA, even if the products will be imported from outside. Counterfeit product considerations could also come into play here, as such products are less likely to have the CE mark applied correctly, if at all.

WHAT IT LOOKS LIKE

To ensure compliance, and so that the product is safe for sale in the EEA, the CE mark needs to be reproduced in the correct format (see below). The mark consists of the standard letters “CE”, and the minimum height is 5mm. If the mark is enlarged in size, it must be done so proportionally.

Interestingly, there are no specific colour requirements for the letters and background, but we most often see the letters in white on a dark background. This is fine, provided that the colours chosen are sufficiently complementary that the logo is clearly visible.

NEED TO KNOW

Depending on the product being sold, there are specific directives that govern how and when the CE mark should be applied. Before attaching the mark or considering whether it is needed, it is necessary to establish which European directive applies.

This is important, because there are sanctions if the mark has not been applied, or has been applied incorrectly. These differ by Member State, but, depending on how serious the offence is, the manufacturer, distributor or importer could be liable to a fine or, in serious circumstances, imprisonment. If the product being sold is not considered an imminent safety risk, the manufacturer may be given time to amend or affix the mark.

Generally, the CE mark is attached to the product itself, but it may also appear on the packaging, or in the user manual or supporting literature.

There are bodies that enforce CE marking legislation to prevent the mark’s misuse. These bodies maintain the high standard of products, ultimately for our safety.

In the UK, the following bodies are responsible for the enforcement of CE marking requirements:

- Trading Standards,
- the Health and Safety Executive,
- the Medicines and Healthcare Products Regulatory Agency,
- the Vehicle Certification Agency, and
- the National Measurement Office.

DESIGN CONSIDERATIONS

When designing a new product, CE marking should be considered from the outset. If conformity is required, this can have a significant effect on design decisions, and can save making costly redesigns if modifications are found to be required. Similarly, if the CE mark is to appear on the product or its packaging, this needs to be considered well before manufacturing commences.

It can sometimes be very difficult to establish whether a new product requires the CE mark. While some classifications are quite straightforward – for example, “hot water boilers” – others, such as “machinery” or “toys”, can be open to

interpretation. Confusion can particularly occur if the product you wish to create is novel or can be used in a variety of ways. For example, some may consider a teething ring for babies to be a toy (particularly if it is styled in a fun way). But should it perhaps be viewed as a medical device, as it alleviates a symptom?

Even in a category such as “toys”, there are certain exclusions that may not seem obvious. For example, jewellery for children should not be CE marked, even though many would consider such items to be toys. But remember: it is very important not to simply add the mark “just in case”, because this can have serious repercussions.

Once it is established that a mark is required, it may be necessary (depending on the specific classification) to retain information relating to: the manufacturer chosen; the processes involved in producing the parts; the storage environment; compliance with any standards relating to the product; and any modifications made to the product or its packaging once production begins. To conform, it will be necessary to work closely with both the designers and manufacturer to keep files up to date and maintain compliance.

If a design agency is involved, it is likely that it will be able to provide some input on CE requirements. However, if there is any doubt or confusion regarding classification, the best advice is to get an independent view from a professional body specialising in CE certification and compliance. ■

► The CE mark: required design template



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THE COURT OF Appeal has dismissed an appeal against an unsuccessful claim of misuse of confidential information against British Sky Broadcasting Ltd (Sky) in relation to the format for a television programme. Although it is rare to have a decision handed down in this area, it is still uncertain what analysis is required when certain elements, rather than the whole, of a proposed format are alleged to have been copied.

FIRST INSTANCE

Brian Wade and Geraldine Perry, creators of a concept for a music talent show television programme called “The Real Deal” (TRD), brought a claim against Sky for misuse of confidential information in relation to its programme *Must Be the Music* (MBTM).

TRD was pitched to Sky via Microsoft PowerPoint slides (the deck). About six months after Wade and Perry’s pitch, Princess Productions (PP) pitched to Sky a music programme called “Got to Sing” (GTS). Shortly thereafter, Wade and Perry were told that Sky would not be commissioning their programme.

Revisions were made to PP’s GTS format through a series of communications between PP and Sky, which led to the creation of MBTM. Like the TRD concept, MBTM also allowed same-day downloading of live performances by contestants, which were eligible for the charts.

At first instance, Mr Justice Birss set out the three requirements in *Coco v Clark* for breach of confidence:

- a) Information in respect of which relief is sought must have the “necessary quality of confidence about it”.
- b) The information must have been imparted in circumstances importing an obligation of confidence.
- c) There must be an unauthorised use or disclosure of that information.

Birss J found that the pitch satisfied the second requirement.

As to the first requirement, that the information was confidential, this was complicated by the fact that Wade and Perry alleged the copying of ideas within the deck, rather than the whole television programme format. Putting that analysis to one side, and persuaded by Sky’s evidence that MBTM was an independently derived idea, Birss J found the third requirement of *Coco v Clark* was not satisfied, and Wade and Perry’s claim failed.

APPEAL THEMES

Wade and Perry appealed Birss J’s decision. Giving the leading judgment, Lord Justice Briggs addressed three main “themes” of the appeal.

Errors of law

Wade and Perry alleged Birss J failed to carry out a detailed chronological analysis of how Sky developed MBTM, including obvious overlaps

No change of tune

Sky was not found to be a bad actor in this television format case, writes Loren Ravenscroft

with TRD. Briggs LJ did not agree; Birss J clearly noted the importance of the timing of events in his judgment. For example, this led him to find that the evidential burden shifted to Sky to prove it had independently created its programme.

Wade and Perry also contended that Birss J erred by approaching issues in the wrong order; for example, rather than looking at the elements of the TRD format separately, Birss J should have looked at the effect of the individual parts combined for establishing whether there was copying, and whether the elements had the necessary quality of confidence. Briggs LJ disagreed, confirming that it was right for Birss J to look at elements separately before then looking at any combination of them. He noted that Birss J had clearly looked at “what he regarded as the best available combination” for Wade and Perry, in relation to both whether there was the necessary quality of confidence, and whether there was copying.

Further, Wade and Perry asserted that Birss J did not consider sufficiently whether Sky had subconsciously copied the TRD format. Rather, he “blinded himself to that probability by his erroneous conclusion that there were ‘no gaps’ in Sky’s evidence about independent creation”. Again, Briggs LJ was not persuaded. Birss J’s “no gaps” comment was to be read in context, and he did not consider that “no gaps” meant that Sky’s evidence was a perfect corroboration of events. Rather, it was in reference to Sky calling all those involved in the collaboration with PP as witnesses to the trial.

Failure to apply the civil burden of proof

The second “theme” was the assertion that Birss J’s comment that evidence presented by Wade and Perry to displace Sky’s case of independent creation was not “strong evidence” meant that he had failed to apply the civil burden of proof.

Again, viewing “strong evidence” in context, Briggs LJ quickly dismissed this argument. Birss J appropriately weighed the evidence, commenting on the strength or weakness of each party’s evidence, and it was clear that Sky’s case of independent creation had been proven far beyond the civil burden of proof.

Inferential findings were wrong

Finally, Wade and Perry challenged certain inferences drawn by Birss J. Briggs LJ noted the relevant restrictions in overturning judicial inferences, not least because of the benefit the earlier court had of hearing the oral evidence. Even when an earlier court’s inference of primary facts is challenged, Briggs LJ noted that: “The appellate court must give real respect to the trial judge’s multi-factorial assessment.”

“

It was right for Birss J to look at elements separately before then looking at any combination of them

Faced then with the task of having to “surmount very serious hurdles” for this part of its appeal, it is not surprising that Wade and Perry did not succeed. For example, Briggs LJ disagreed that Birss J should have ascribed more weight to evidence that both TRD and MBTM used lapel badges as a form of branding.

RESPONDENT’S NOTICE

Sky had served a Respondent’s Notice, in which it argued *inter alia* that Birss J should have tackled the issue of whether individual elements of TRD had the necessary quality of confidence (it did not agree that they did). Briggs LJ found it unnecessary to address Sky’s Respondent’s Notice in light of the fact that none of the grounds of appeal had succeeded. In relation to whether the combination of elements of the pitch had the necessary quality of confidence, Briggs LJ did not address this point, agreeing that Birss J did not have to either, since his finding that MBTM was an independent creation was correct.

FINAL WORD

While any new television programme may contain many facets of the initial idea, the programme as eventually broadcast rarely ends up being exactly the same as the format first pitched, due to intervening development and production steps. Arguably, it is a shame that this case failed to address the clearly important consideration of whether individual elements of a format for a programme have the necessary quality of confidence. What this case does highlight again, however, is the probative weight given to oral witness evidence – in this case, in proving that work was independently created.

KEY POINTS

- ▶ Whether individual elements of a format for a television programme have the necessary quality of confidence remains unclear
- ▶ This case provides a reminder of the probative value of oral witness evidence – in this case, for proving that work was independently created



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Clash of the Titanics

Action to rectify any confusion saw the Defendant off the rocks, says Rachel Fetches

MR JUSTICE CARR has held that, although there was past infringement and passing off of the TITANIC SPA mark, in light of the steps taken to avoid confusion or misrepresentation, there was no likelihood of future infringements by Titanic Liverpool Hotel (TLH), whether relying on an “own name” defence or otherwise.

The owner of TLH, Titanic Belfast (TB) was successful in its appeal against revocation of its TITANIC QUARTER mark, with the finding that its late-filed evidence should have been allowed into UK IPO proceedings. However, the TITANIC QUARTER mark was not infringed by the use of the TITANIC SPA sign, nor did it invalidate the later-filed TITANIC SPA mark. Carr J also granted a declaration to TB and TLH that they were legitimately entitled to use the signs TITANIC QUARTER and TITANIC QUARTER HOTEL LIVERPOOL, as well as a device mark, in the UK in relation to hotels.

BACKGROUND

TB owned and licensed its TITANIC QUARTER marks to TLH, with the earliest mark, UK no 220115 (the 115 mark), filed in June 1999. Titanic Huddersfield (TH) was the owner of the TITANIC SPA mark, filed in April 2011. TH had operated the Yorkshire-based Titanic Spa, offering luxury spa treatments and accommodation since 2005. Belfast-based property-development business TB opened TLH in June 2014. TB had undertaken regeneration of the Titanic Quarter in Belfast.

TH sought revocation of the 115 mark at the UK IPO, and also brought a claim for passing off and trade mark infringement against TLH at the IPEC. TB brought trade mark infringement proceedings against TH separately at the High Court. Following the revocation by the UK IPO



“

The services were identical. However, there had been no confusion, which Mr Justice Carr attributed to their different geographical locations

of the 115 mark for non-use, the appeal was consolidated with the IPEC and High Court proceedings.

UK IPO APPEAL

TB appealed the Hearing Officer's (HO's) refusal to admit additional evidence of use, submitted days before the hearing. Carr J held that, in failing to form her own view of whether the further evidence was material, citing potential for an adjournment or delay when there was none, as well as failing to consider the significant prejudice to TB if the evidence was excluded, the HO had erred in principle. Although Carr J was critical that TB had not prioritised filing the evidence sooner, he held that the evidence should have been admitted.

Having admitted the late-filed evidence, Carr J considered the fair specification for the use of the 115 mark. He rejected all of TH's proposed limitations to the specification of the mark in classes 41 and 45, and upheld TB's appeal.

IPEC CLAIM

TH complained about TLH's use of the signs TITANIC, TITANIC HOTEL, TITANIC LIVERPOOL, TITANIC HOTEL SPA and SPA AT THE TITANIC HOTEL. Carr J did not accept that "Titanic" was the dominant element of the TITANIC SPA mark, but TITANIC SPA had enhanced distinctiveness. There was both visual and aural similarity between the mark and signs. Furthermore, TITANIC HOTEL was conceptually similar to TITANIC SPA, because consumers would be aware that it was common for hotels to have spas. The services offered by TLH were identical or highly similar to those for which TITANIC SPA was registered. On that basis, Carr J held that there was a likelihood of confusion under s10(2) of the Trade Marks Act 1994 (TMA). Carr J also took account of evidence of "wrong way round" confusion by consumers.

TLH ran an "own name" defence under s11(2) TMA against TH's claim. TLH also offered and took a number of steps to avoid confusion, such as rebranding the spa as "Maya Blue" in 2016. Carr J considered that there were facts that supported and undermined TLH's claim that use of the signs was in accordance with honest practices. In its favour, the name was not chosen to cause confusion, being a logical extension of the earlier Titanic Quarter brand. The spa services were offered in the context of a wider hotel business, and TLH had taken steps to minimise confusion, such as the rebranding, offering to

put a disclaimer on its website, and ensuring that the keywords "Titanic Spa" were not used in online advertising. However, there was only a limited distinction between the services offered, there was actual confusion, and TLH's use commenced after TH had used the mark extensively and obtained a registration. Furthermore, this use commenced despite an awareness on TLH's part of that registration, and in light of a decision not to conduct further clearance searches before TLH's launch. On that basis, Carr J held that the own-name defence did not succeed in respect of past infringement by TLH, but that, following the rebrand of the spa, it was available as a defence to infringement.

TB alleged that the TITANIC SPA mark infringed and was invalid due to its earlier TITANIC QUARTER marks. This would have been a "squeeze" had Carr J held that the dominant distinctive element of the TITANIC SPA mark was "Titanic". Although there were visual and aural similarities between the marks, conceptually they were different. TITANIC QUARTER, while distinctive, conveyed the message of an area or geographical location, and TITANIC SPA conveyed the different message of a spa facility. The services were identical. However, there had been no confusion, which Carr J attributed to their different geographical locations. Overall, Carr J held that there was no infringement, and that the earlier marks did not invalidate the TITANIC SPA mark.

PASSING OFF

Carr J then considered TH's claim for passing off against TLH. Although TH had acquired goodwill in TITANIC SPA, this was not substantial throughout the UK. Carr J found that, prior to the rebranding of TLH's spa to Maya Blue, there was misrepresentation that had been damaging to TH's goodwill. However, following the rebrand, in addition to the other steps offered by TLH to minimise confusion, there was no longer any misrepresentation or real likelihood of damage. On that basis, Carr J held there had been passing off up to the rebrand, but not thereafter.



KEY POINTS

- ▶ The factors that must be considered when a party is seeking to admit late-filed evidence are: (i) materiality; (ii) justice and fairness of the burden on the other party; (iii) prejudice to the other party that cannot be compensated (eg excessive delay); and (iv) fairness to the application, and prejudice if the party is unable to rely on the evidence
- ▶ The ability to rely on the "own name" defence can differ depending on the nature of the activities being undertaken and how they impact on the requirement for "use in accordance with honest commercial practices"



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eXtreme justice

A competitor did not prove a locker design commonplace, reports Emily Gittins

THE IPEC RECENTLY considered the various principles that apply when assessing infringement of a UK unregistered design right (UDR).

A UDR protects the shape and configuration of an article, and automatically attaches to any original design once it has been recorded in a design document, or an article has been made embodying the design.

In finding that the Defendants' "SuperTuff" lockers infringed the UDR subsisting in the Claimant's "eXtreme" lockers, His Honour Judge Hacon looked at whether or not:

(i) the design was original; (ii) the design was commonplace; (iii) part of the Claimant's locker was a "method or principle of construction"; (iv) the "must fit" exclusion applied; and (v) there was infringement.

Although he touched on what the removal of the words "any aspect of" from s213(2) of the Copyright, Designs and Patents Act 1988 (CDPA) means, and when the change is to take effect, Hacon J was not required to provide clarification on either point, and did not do so.

ORIGINALITY

The Defendants alleged that the design of the whole of the Claimant's locker lacked originality. However, they went on to admit that five features of the locker were, in fact, original. Even though the Claimant designed its eXtreme locker with an earlier "Remcon" locker "very much in mind", Hacon J considered that there were sufficient differences that the eXtreme locker, as a whole, was original.

COMMONPLACE

Hacon J summarised the relevant principles (at paragraph 37) and went on to reject the Defendants' argument that the design of the eXtreme locker was commonplace.

It was also notable that Hacon J did not agree with the Defendants' view that, rather than being set out in pleadings, the commonplace issue was better explored through expert evidence. Pleading a broad commonplace design argument would likely lead to unfocused expert reports, which would result in wasted resource.

“
Hacon J did not agree with the Defendants’ view that the commonplace issue was better explored through expert evidence”

KEY PRINCIPLE

Under s213(3)(a) CDPA, design right does not subsist in a method or principle of construction. With reference to this principle, the Defendants targeted two design features of the eXtreme locker: the tapered ribs on the side and the shape of the rear panel. However, the Court did not consider that the various functions of these features could be achieved by the particular shape of those features.

“MUST FIT” EXCLUSION

The “must fit” exclusion (under s213(3)(b)(i) CDPA) essentially excludes a designer from gaining design right protection for features of the shape or design of a product that allow the whole or part of the product to connect to something else.

The Claimant sold the eXtreme lockers as stackable units, with the shape of the top and bottom panels of the lockers allowing them to be placed on top of each other. Hacon J identified that, for the “must fit” exclusion to apply, there must be a degree of precision. For example, he commented that, although the design of contact lenses to enable a proper fit between the lens and the eyeball will be excluded from protection by UDR under the CDPA, it would be surprising if the handle of a mug were refused design protection only because it was shaped to enable a hand to pick the mug up.

Despite the fact that the top and bottom panels of the Claimant’s eXtreme lockers did not meet so securely that they could form a stable stack without any further support, Hacon J held that the precision of the fit between those panels enabled enough stability

that they were caught by the “must fit” exclusion. Accordingly, those panels did not attract design right protection, and they were not considered to be part of the rest of the design of the eXtreme locker.

INFRINGEMENT

Hacon J summarised the principles of the law on infringement at paragraph 88, and applied them to consider whether or not, disregarding the top and bottom panels – which were not protected by design rights – the Claimant’s eXtreme locker had been directly or indirectly copied by the Defendants.

Regarding primary infringement (that copying had occurred, and that the Defendants’ SuperTuff lockers were produced exactly or substantially to the Claimant’s design), Hacon J found that, taking all the features of the design into account, the Defendants’ SuperTuff lockers were made substantially to the overall design of the Claimant’s eXtreme lockers.

Hacon J also found in favour of the Claimant in relation to secondary infringement, holding that the Defendants had the requisite knowledge that their SuperTuff locker infringed the eXtreme locker.

RECOMMENDATION

Hacon J followed up the conclusion of his judgment by commenting on the usefulness of parties using design charts in pleadings. Such charts could be used by a party alleging infringement to set out the significant features of their design and the extent to which they are found in the alleged infringer’s articles. The alleged infringer could then admit or deny the extent to which it believes such significant features exist in the design in question, or propose amendments. The alleged infringer could also admit or deny the existence of such features in the design of its own article.

KEY POINTS

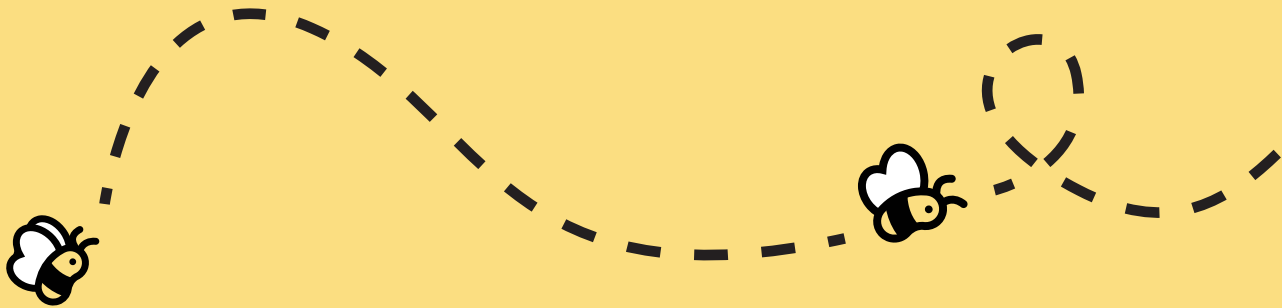
- ▶ It is still unclear what the removal of the words “any aspect of” from s213(2) CDPA means, and to what time period the change applies
- ▶ Parties in design right cases should strongly consider using design and infringement charts in their pleadings either to set out the significant features of a design and the extent of alleged infringement, or to admit or deny the existence of such features and propose amendments



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A moving tale

A former association member was found wanting with regards to its own online claims, reports Mathilda Davidson

THE NATIONAL GUILD of Removers and Storers Ltd (NGRS) has partially succeeded in a passing off claim against its former member Bee Moved Ltd and two of the latter's director shareholders. NGRS contended that adverts for Bee Moved that referred to NGRS amounted to passing off by suggesting that Bee Moved was still a member of the NGRS trade association.

NGRS succeeded in respect of one advertisement on Bee Moved's own website, but failed in respect of a second advertisement on a third-party directory website, which appeared to have reverted to out-of-date information following a website crash.

ADVERTS

By the time the case came to trial, NGRS's claim related to two adverts:

- 1) a page on Bee Moved's own website (www.beemovedremovals.com) that featured a checklist advising customers to "use a removal company who is a member of the National Guild of Removers and Storers" (the Bee Moved Web Page); and
- 2) listings for Bee Moved at www.reallymoving.com (the Really Moving Website) that included the claim "Member of NGRS".

NGRS had originally claimed in respect of a further two adverts on third-party websites, despite accepting in witness evidence (submitted more than a year before trial) that it faced evidential difficulties in relation to showing that the Defendants had actually placed the adverts in question. Sitting as Recorder, Douglas Campbell QC criticised NGRS for running the claim in relation to these two further adverts almost right up to

trial, dropping them only on service of its skeleton argument one working day before the trial.

LEGAL PRINCIPLES

Mr Recorder Campbell QC summarised the relevant legal issues in respect of the passing off claim:

- i) In order to succeed the Claimant has to prove goodwill or reputation; misrepresentation; and damage. See eg *Reckitt & Colman Products v Borden* [1990] RPC 341, HL.
- ii) Trade associations can bring an action for passing off. See *Society of Accountants & Auditors v Goodway* [1907] 1 Ch 489; and more recently *National Guild of Removers & Storers v Silveria* [2010] EWPCC 015, a decision of the predecessor to this Court involving the same Claimant.
- iii) The question of whether there is a likelihood of deception is a matter for the Court, not the witnesses: see Lord Parker in *Spalding v Gamage* [1915] 32 RPC 273 HL at [286].
- iv) The Court must assess whether a 'substantial number' of the Claimant's customers or potential customer[s] are deceived but it is not necessary to show that all or even most of them are deceived: see *Neutrogena* [1996] RPC 473 and *Interflora v Marks & Spencer* [2013] FSR 21.
- v) Misrepresentation must be more than transitory: see



Mr Recorder Campbell QC noted that NGRS had failed to run similar arguments successfully in two previous cases

Woolley v Ultimate Products [2012] EWCA Civ 1038 at [4]; Moroccanil Israel Limited v Aldi Stores Limited [2014] EWHC 1686 (IPEC) at [17]–[28].”

THE BEE MOVED WEB PAGE

The relevant web page was headed with Bee Moved’s logo and the title “HELP WITH MOVING HOME”, and dated from sometime in 2011, which is after Bee Moved ceased to be a member of NGRS.

The web page featured a “Moving checklist”, which recommended that customers “use a removal company who is a member of the National Guild of Removers and Storers”.

Mr Recorder Campbell QC agreed with NGRS that this was not just “general advice”, but implied that Bee Moved was a member of NGRS. This implied representation was damaging to NGRS’s business and goodwill. The fact that the web page did not carry the NGRS logo was not enough to dispel the misleading impression conveyed.

The Defendants were therefore liable for passing off in relation to the Bee Moved Web Page.

THE REALLY MOVING WEBSITE

Four near-identical listings for Bee Moved appeared on the Really Moving Website, each featuring the claim “Member of NGRS”. Bee Moved had joined the website in 2004 and had supplied information about its services via a login page. However, it was accepted that the statement was no longer true when the advert appeared during 2013.

Bee Moved put forward evidence that it had not been aware of this directory page before receiving a letter before action from NGRS (though it accepted that the claim may have been based on information it supplied when originally registering with the website). On receiving the letter before action, it contacted the Really Moving Website and was told that there had been an issue with the website that had caused the system to crash and then replicate itself based on a previous version of the website. Bee Moved requested that the wording immediately be removed from the website.



Rejecting this part of NGRS’s case, Mr Recorder Campbell QC commented: “First, I fail to see how the Defendants can be responsible for acts done by an independent third party in circumstances where ... the Defendants did not know of such acts nor did they intend them, and no question of agency, authorisation, or procuring arises. Secondly if the Claimant’s argument is correct, and for some reason Really Moving had declined to remove the text in question when the Defendants asked Really Moving to do so, then it would seem to follow that the Defendants still remain liable forever.”

Mr Recorder Campbell QC also noted that NGRS had failed to run similar arguments successfully in two previous cases: National Guild of Removers and Storers Ltd v Derek Milner¹, and National Guild of Removers and Storers Ltd v Luckes.² In the latter case (which also turned on the “mysterious reappearance” of text on the Really Moving Website), the passing off claim failed even without evidence of an intervening website crash.

This criticism of NGRS’s reliance on arguments that had previously failed against other defendants, and of its late changes to its pleaded case in this action, demonstrates the need for parties to be proportionate, timely and responsive in dealing with issues, and to refine their approach where it is sensible to do so.

KEY POINTS

- ▶ Bee Moved and its director shareholders were liable for passing off in respect of an advert on the company’s own website
- ▶ However, they were not liable for passing off where the offending advertisement had been generated by a third party (the Really Moving Website)
- ▶ NGRS was criticised for its reliance on arguments that had previously failed against other defendants, and for last-minute pretrial changes to its case, despite acknowledging evidential difficulties at least a year before trial

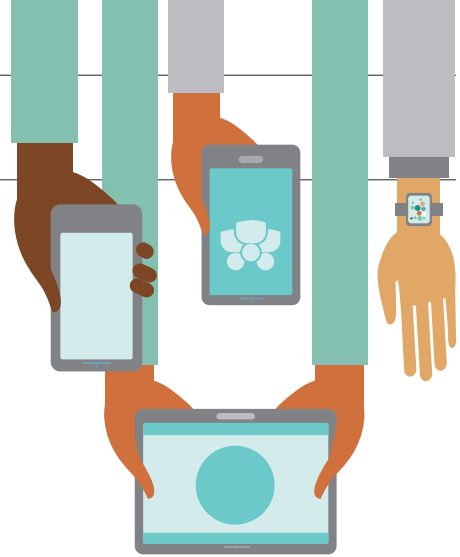
1. [2014] EWHC 670 (IPEC).
2. District Judge Hart, unreported, 7th March 2016.



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Revocation investigation

While not unblemished, Apple found support for claims of abuse of process, explains Azhar Sadique

BETWEEN OCTOBER AND 13th December 2016, Sherlock Systems CV, American Franchise Marketing Ltd and Fashion International Ltd (the Applicants) filed 68 applications to revoke trade marks owned by Apple Inc for non-use. These included Apple's iPhone, iTunes and Apple marks. All of the applicant entities filing the actions were controlled by Mr Michael Gleissner.

Apple claimed that the applications were an abuse of process and should be struck out. It argued, among other things, that:

- The applications were part of a wider network of systematic revocation actions in a number of territories based on Apple registrations for SHERLOCK, and were filed as collateral to coerce Apple into surrendering its registrations.
- The costs and time associated with defending against so many revocation applications was disproportionate to any likely benefit to the Applicants.
- Companies under Mr Gleissner's control had filed applications at EUIPO to revoke 120 of Apple's EU trade marks for non-use, and had then filed some of these marks in their own names.
- Mr Gleissner owned thousands of UK companies, and opportunistic domains and trade marks (such as EU IPO in the name of EUIPO International Ltd, and others identical to established brands such as BAIDU and THE HOME DEPOT).

The Applicants denied all claims and countered that Apple was abusing the trade mark system by routinely registering marks that it did not intend to use. They further claimed that legislation has not limited, nor made conditional, the right of third parties to challenge the use of registered marks.

QUESTION OF PURPOSE

Although previous examples of opportunistic trade mark squatting by Mr Gleissner were difficult to ignore, the telling reason in support of an abuse of process was the timing of the revocation actions as a means of acquiring SHERLOCK in multiple jurisdictions.

The Registrar stated that, in this case, it did not matter if Apple was abusing the trade mark system, or that there may have been an element of disproportionality between the cost of defending the marks and the lack of commercial benefit to the Applicants. The Registrar held that the applications for revocation were brought for an ulterior purpose, without which these proceedings would not have been commenced.

ENCOURAGING SIGNS

Having been on the receiving end of a multi-platform/multi-jurisdiction abuse of process case recently, I am encouraged to see ulterior purposes being determined when evidenced.

However, this case also points out the need to ensure that trade marks do not become vulnerable to non-use revocations in the first place, even if registrations remain on trade mark registers as a point of strategy. Removing the opportunity of being outmanoeuvred would appear to be a stronger position to be in than having to bring an abuse of process proceeding.

KEY POINTS

- ▶ The timing of the revocation actions was a key factor in the Court's decision
- ▶ It is beneficial to conduct thorough investigations when attempting to evidence systematic and planned attacks against a trade mark owner



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Cutting through the clutter

The Court was influenced by unchallenged evidence, writes Caspar Rebling

IN THIS CASE, an opposition based on rights in a distinctive word was upheld in relation to an application for a composite mark for identical goods incorporating that distinctive word among other largely non-distinctive elements. While the outcome was not surprising, the decision demonstrates that, in certain circumstances, hearsay evidence may have a useful role to play in proceedings.

In November 2015, Supercrease Ltd (the Applicant) applied for a device incorporating the word “nutmeg” (as a series of two: one black and white, the other in colour) in class 25. Ipsolus Ltd (the Opponent) opposed the application based on s5(2)(b) of the Trade Marks Act 1994 in relation to its earlier UK word mark NUTMEG in class 25. In January 2017, the Hearing Officer (HO) upheld the opposition.

The case involved discussions about the average consumer, and dominant and distinctive elements. The HO only compared the black-and-white marks, regarding the addition of colour as not altering the distinctive character of the series mark. The average consumer of clothing, in the HO’s view, and considering the New Look decision¹, primarily perceives brands visually.

VISUAL COMPARISON

In the HO’s opinion, on visual comparison, the display of two single letters at 45- and 90-degree angles in the word “nutmeg” in the Applicant’s mark, and the additional elements “lifelong crease” and “the permanent garment crease”, were negligible. The latter were found to be descriptive in relation to clothing goods. In the HO’s view, the respective marks shared an average degree of visual and aural similarity, and a higher than average degree of conceptual similarity. The word “nutmeg” was of a normal degree of inherent distinctiveness for those goods. The goods were identical.

HEARSAY EVIDENCE

Hearsay evidence on the use of the Opponent’s mark came in the form of a witness statement from the Opponent’s representative. The HO applied s4 of the Civil Evidence Act 1995 in deciding not to question any part of the evidence on the grounds that: (i) the evidence had not been challenged; (ii) the representative had been acting for the Opponent for a number of years and was assumed to be fairly familiar with its business; and (iii) the representative had access to the Opponent’s records.

The HO commented on the lack of information on turnover and advertising expenditure, but news coverage of the Opponent’s business, the launch of the NUTMEG brand and its initial success painted a picture of successful commercialisation of the mark since 2013. The HO assessed the evidence in its entirety, including a news article published four months after the relevant date. She stated that, partly because the evidence was not challenged and “despite its deficiencies”, based on a collective view, it did evidence enhanced distinctiveness of the mark for children’s clothing.

The HO emphasised that the decision turned on her finding of identical goods and high conceptual similarity, creating a likelihood of direct and indirect confusion. This would have been the decision regardless of her conclusion that the Opponent’s mark possessed enhanced distinctive character for children’s clothing.

KEY POINTS

- ▶ A word mark of normal distinctive character may be safe from a cluttered mark that incorporates that word
- ▶ The average consumer of clothing primarily perceives brands visually
- ▶ Evidence is assessed with a collective view
- ▶ Always challenge evidence

- ▶ The device mark



1. T-117/03 to T-119/03, and T-171/03.



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Fundamental question

Sinéad Mahon covers the Court's answer on the right to information after infringement proceedings

THIS CASE CONCERNED a request for a preliminary ruling, referred from the Czech Supreme Court to the CJEU, as to the interpretation of Article 8(1) of Directive 2004/48/EC of the European Parliament and of the Council of 29th April 2004 on the enforcement of intellectual property rights (the Directive).

It involved New Wave CZ and Alltoys, and concerned the infringement of New Wave's MEGABABE trade mark. New Wave filed a claim against Alltoys for using the MEGABABE mark without New Wave's consent. The Czech court declared that Alltoys had infringed New Wave's rights in the MEGABABE mark. It ordered Alltoys to refrain from the infringing conduct and withdraw the infringing products that were already on the market. New Wave sought to modify its claim to request that Alltoys provide it with all information relating to the goods concerned. However, the court did not allow New Wave to change its application.

Once the first action was concluded, New Wave brought a new action before the City Court in Prague, seeking that Alltoys provide it with all information pertaining to the goods bearing the MEGABABE mark. This included information on: the origin and distribution networks of the goods; suppliers; stockists; distributors; and quantities supplied, stocked

and sold, both at that time and in the future. The City Court dismissed New Wave's application on the basis that such a claim may only be asserted by an application to the court in proceedings concerning infringement of a right. In the City Court's opinion, the action concerning infringement of a right had already been terminated in the first action, so the claim was rejected.

New Wave appealed to the Prague Court of Appeal,

which ordered Alltoys to provide New Wave with the requested information. Alltoys appealed this decision to the Czech Supreme Court, which observed that there was a difference in wording between its law and the wording of the Directive. The Supreme Court referred the following question to the CJEU for consideration:

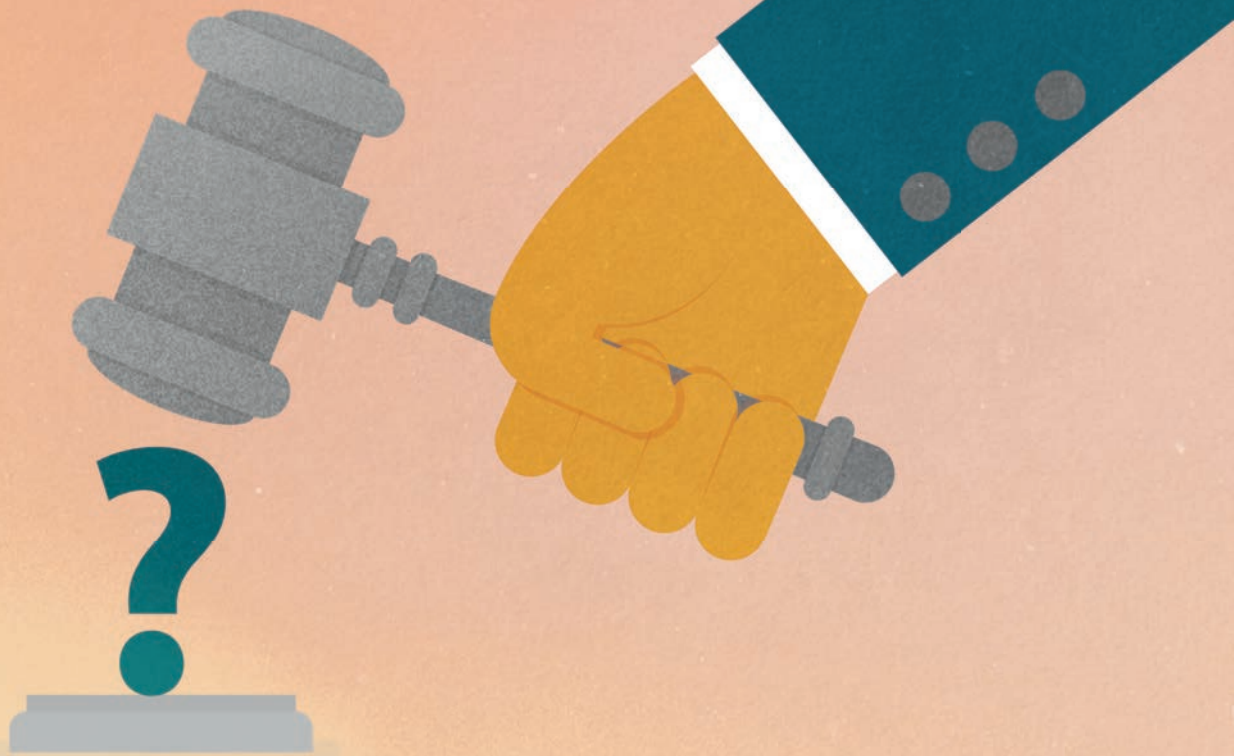
"Must Article 8(1) ... be interpreted as meaning that it is in the context of proceedings concerning an infringement of an intellectual property right if, after the definitive termination of proceedings in which it was declared that an intellectual property right was infringed, the applicant in separate proceedings seeks information on the origin and distribution networks of the goods or services by which that intellectual property right is infringed?"

WHAT IS ARTICLE 8(1)?

Article 8(1) refers to the "right of information", and the key points are set out below:

- "1. Member States shall ensure that, in the context of proceedings concerning an infringement of an intellectual property right and in response to a justified and proportionate request of the claimant, the competent judicial authorities may order that information on the origin and distribution networks of the goods or services which infringe an intellectual property right be provided by the infringer and/or any other person who:
- (a) was found in possession of the infringing goods on a commercial scale;
 - (b) was found to be using the infringing services on a commercial scale;
 - (c) was found to be providing on a commercial scale services used in infringing activities; or
 - (d) was indicated by the person referred to in point (a), (b) or (c) as being involved in the production, manufacture or distribution of the goods or the provision of the services.
- "2. The information referred to in paragraph 1 shall, as appropriate, comprise:
- (a) the names and addresses of the producers, manufacturers, distributors, suppliers and

“
The Court considered the right of information as a specific expression of the fundamental right to an effective remedy



other previous holders of the goods or services, as well as the intended wholesalers and retailers;

- (b) information on the quantities produced, manufactured, delivered, received or ordered, as well as the price obtained for the goods or services in question.”

IN ANSWER

In relation to the wording of Article 8(1), the CJEU observed that: “The expression ‘in the context of proceedings concerning an infringement of an intellectual property right’ cannot be understood as referring solely to proceedings seeking a finding of an infringement of an intellectual property right.”

The CJEU noted that this does not exclude Article 8(1) from covering separate proceedings initiated after the definitive termination of proceedings in which it was held that an IP right was infringed. In its judgment, the CJEU also stated that it is not always possible to request all of the information at the time of the first proceedings, as the extent of the infringement might become apparent only after final termination of those proceedings. Following this reasoning, the CJEU pointed out that, without knowing the full extent of the IP infringement, the injured party could not accurately calculate the damages it is entitled to.

In its assessment, the CJEU also found that Article 8(1) is not only directed at the infringer, but also at “any other person” as outlined in

Article 8(1)(a) to (d). These “other persons” will not always be parties to the proceedings in which a finding of infringement is sought.

FUNDAMENTAL RIGHT?

The Court also considered the right of information as a specific expression of the fundamental right to an effective remedy, guaranteed in Article 47 of the Charter of Fundamental Rights of the EU.

The answer to the question referred is that: “Article 8(1) of the Directive 2004/48 must be interpreted as applying to a situation, such as that at issue in the main proceedings, in which, after the definitive termination of proceedings in which it was held that an intellectual property right was infringed, the applicant in separate proceedings seeks information on the origin and distribution networks of the goods or services by which that intellectual property right is infringed”.

This decision is noteworthy, as the CJEU suggests that Article 8(1) does not bar re-litigation where there is a claim for information. However, it is unclear how this will tie in with the principle of *res judicata*.

KEY POINTS

- ▶ The CJEU confirmed that the right to information continues beyond a specific infringement action
- ▶ The right to information may also apply to parties not involved in legal proceedings
- ▶ However, it is unclear how this CJEU answer will tie in with the principle of *res judicata*



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A common problem

It was an error not to consider distinctiveness in relation to goods and services, Catherine Byfield explains

IN THIS OPINION, the Advocate General (AG) recommended that the CJEU dismiss an appeal by EUIPO against a decision of the General Court (GC) where EUIPO was held to have erred in law when assessing whether a figurative mark (the Mark, shown below) containing the word “deluxe” was non-distinctive.

The application was refused in respect of a range of goods and services in eight classes, each broadly related to films. The Examiner and the Board of Appeal (BoA) held that the Mark lacked distinctive character for all of the goods and services. On appeal to the GC, it was held that the BoA failed to conduct the prescribed examination of the distinctive character in relation to all of the goods and services, or at least in relation to the categories they might constitute.

GC APPEAL

Aside from the distinctiveness of “deluxe”, the appeal raised the important question: does EUIPO have the right not to conduct a detailed analysis of the relationship between the mark applied for and the relevant goods and services?

The BoA found that the Mark would be viewed by consumers as a commonplace promotional tag, consisting of a “claim of superior quality”. Further, the term “deluxe” fell within the category of terms that must be exempt from trade mark monopoly, and the device element was insufficient to confer distinctive character. The GC criticised the BoA for failing to refer to each of the goods and services in question when examining distinctiveness: the BoA was incorrect to apply general reasoning without finding a sufficiently direct link so as to form a uniform category.

EUIPO submitted that the GC erred in law when it sought to limit the Office’s right to provide a general statement of reasons. EUIPO also put forward a broad definition

of uniformity: a common feature between goods and services should be sufficient, even if they fall within different sectors.

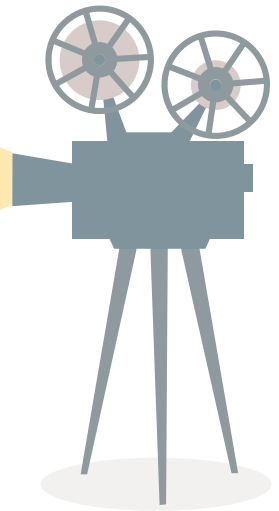
AG ANSWERS

The AG agreed with EUIPO that, if it establishes a complete lack of distinctive character in a mark, generally applicable to all types of goods and services, there is no point conducting an assessment in relation to individual terms. However, it was wrong to apply that principle here. The figurative element means more consideration is required. The qualities that would generally be attributed to the word “deluxe” may be attributed to certain goods and services, but not to others.

It was not established that the Mark was completely devoid of distinctive character in relation to all goods and services; therefore, the appeal had to fail.

The AG held that it was necessary to identify intrinsic elements and links that group the goods and services into categories. The categories should then be compared with the sign. If a common element is identified, giving a degree of uniformity, then a general assessment of the distinctive character can be made in relation to the category. The analysis should be conducted in relation to the qualities of the goods and services, not the mark in relation to the relevant public.

This opinion makes a lot of sense, and clearer decisions with a transparent reasoning provided can only be good for applicants.



KEY POINTS

- ▶ The presence of a figurative element meant that more consideration in relation to distinctive character was required
- ▶ Analysis should be conducted in relation to the qualities of the goods and services, not the mark in relation to the relevant public

- ▶ The Mark



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Two Morgans too many

Nellie Jackson warns of the danger posed by common elements

IN FEBRUARY 2013, Morgan & Morgan Srl International Insurance Brokers (M&M) filed an EU trade mark application for a figurative sign (shown below) incorporating the words “Morgan & Morgan”, covering various insurance and financial services in class 36.

Grupo Morgan & Morgan (GM&M) opposed, relying on Article 8(1)(b) of Regulation (EC) No 2007/2009, based on its earlier EU figurative sign (shown below) also incorporating the words “Morgan & Morgan” and registered in relation to insurance and financial services in class 36.

The opposition was rejected, as the common element “Morgan & Morgan” was not considered to be the dominant one. Therefore, the visual and phonetic differences were found to be sufficient.

In contrast, the First Board of Appeal (BoA) thought consumers were more likely to identify M&M’s sign by way of the name Morgan & Morgan than by the figurative element, and to identify GM&M’s sign as designating a trust that is a member of the Morgan & Morgan group. On appeal, a likelihood of confusion was established, and M&M’s application rejected.

FURTHER APPEAL

On further appeal, the General Court (GC) reiterated the necessity to take account of the relevant public for all services for which registration is sought – in this case, covering services intended for both specialist consumers and the general public – and confirmed its satisfaction that the services covered by the marks are largely identical.

Then, turning to the crux of the case – the comparison of the signs and the particular role played by “Morgan & Morgan” – the GC stated that, while comparison must be made between the marks as a whole, this does not mean the overall impression conveyed may not be dominated by one or more of a mark’s components.

In assessing the overall impression of M&M’s sign, the GC agreed with the BoA that the figurative element occupied an important position, but felt that the relevant public would focus on the identifying name, especially as the figurative element reflects and highlights it.

Regarding GM&M’s sign, the GC agreed with M&M that “Morgan & Morgan” occupied a secondary position, but it still found that element of some importance, due to its capacity to provide consumers with information as to the origin of the services. With reference to financial services, consumers attach particular importance to the provider’s name, the GC said, and would likely perceive MMG Trust as a member of the Morgan & Morgan group.

Consequently, the GC found there was a degree of visual similarity based on the similarity in structure, the similarity between the figurative elements (albeit low), and the presence of the common element, which necessarily means that there was also a degree of phonetic and conceptual similarity.

Overall, given the identity of the services, the degree of similarity and the shared element, the GC held that there was a likelihood of confusion.

CAREFUL CONSIDERATION

This case highlights the need to take common components into careful consideration, not only where the commonality might dominate, but also where it is seen to occupy a secondary position. It is particularly important to interrogate the role and meaning of shared words, slight or otherwise.

KEY POINTS

- ▶ A comparison must be made between marks as a whole, but the overall impression conveyed may be dominated by one or more of a mark’s components
- ▶ With reference to financial services, consumers attach particular importance to the provider’s name
- ▶ Take common components into careful consideration, particularly a shared word

- ▶ The M&M sign

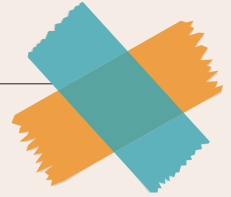


- ▶ The GM&M sign



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Strong bonds crumble in court

Richard May outlines an unsuccessful bid to prove a slogan had distinctiveness

IN OCTOBER 2014, Solenis Technologies LP (the Applicant) filed an EU trade mark application for STRONG BONDS. TRUSTED SOLUTIONS. in class 1 for various chemicals and chemical agents. EUIPO rejected the application on the basis of Articles 7(1)(b) and 7(2) of Regulation (EC) No 207/2009, on the ground that the sign was devoid of distinctive character. The Board of Appeal (BoA) dismissed the Applicant's appeal.

Upholding the BoA's decision, the General Court (GC) highlighted that it is inappropriate to apply stricter criteria for slogans than for other types of signs when assessing distinctiveness. It also noted that a slogan will have distinctive character if, apart from its promotional function, it is perceived immediately by consumers as an indication of trade origin.

The GC went on to consider that a trade mark must make it possible to identify the goods in question as originating from a particular undertaking. If it fails to do so, consumers who purchase those goods will be unable to choose to purchase them again if it was a positive experience, or avoid doing so if it was negative.

CRACKS APPEAR

The Applicant disputed the BoA's interpretation of "bonds", namely that the word refers to the technical properties of the goods in question. According to the Applicant, the slogan, as a whole, would negate the meaning of "bonds", and consumers would perceive the slogan as referring to the qualities of the undertaking that markets the goods.

The GC disagreed and stated that the BoA was right to find that STRONG BONDS. TRUSTED SOLUTIONS. consisted of a word sequence that, taken as a whole, would be easily understood by consumers as meaning that the Applicant's

goods provide solid adhesive strengths that constitute reliable answers to problems, or that the goods are trusted solutions.

In other words, when faced with the slogan, consumers would understand that the goods in question are reliable, quality goods, and would not, beyond that promotional message, be led to perceive the slogan as an indication of commercial origin.

NO ERROR

The GC concluded that the BoA did not make an error in finding that the slogan would ultimately be perceived as a simple promotional slogan that has a laudatory meaning in respect of the goods in question.

This finding was not called into question by the various claims of the Applicant. The GC said that the BoA was right to reject the Applicant's argument that consumers would perceive "bonds" as referring to emotional ties or bonds of affection. Even if the Applicant's definition was accepted, the slogan would still be banal; its laudatory meaning would be clear and unequivocal. The Applicant claimed that, since not all of the goods in question had adhesive properties, the slogan could function as a trade mark in relation to those goods. In rejecting this, the GC confirmed that the mere fact that the semantic content of a sign does not convey any information about the goods is not sufficient to make that sign distinctive. Consequently, the application was rejected.

KEY POINTS

- ▶ The Applicant failed to convince the BoA and GC that its slogan was more than an obvious advertising message
- ▶ The GC found that the slogan would be easily understood as meaning that the Applicant's goods provide solid adhesive strengths that are reliable and/or trusted, but did not indicate commercial origin



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events

More details can be found at citma.org.uk

DATE	EVENT	LOCATION	CPD HOURS
9th May	CITMA Administrators' Webinar	Log in online	
16th May	CITMA Lecture – London* Tips on effective trade mark practice	Royal College of Surgeons, London WC2	1
8th June	CITMA Lecture – Glasgow Domain name update	Brodies LLP, Glasgow	1
14th June	CITMA Webinar	Log in online	1
20th June	CITMA Lecture – London*	Royal College of Surgeons, London WC2	1
27th June	CITMA Lecture – Bristol	Burges Salmon LLP, Bristol	1
4th July	CITMA Summer Reception	Sea Containers, London SE1	
5th July	CITMA CIPA Commercial Skills Webinar Professional ethics	Log in online	1
6th July	CITMA Administrators' Webinar	Log in online	
18th July	CITMA Lecture – London*	58VE, London EC4	1
13th September	CITMA Webinar	Log in online	1
26th September	CITMA Lecture – London*	58VE, London EC4	1
12th October	CITMA Autumn Conference – Birmingham*	Hyatt Regency Birmingham	5
24th October	CITMA Lecture – London*	58VE, London EC4	1
1st November	CITMA Seminar for Litigators – London	Carpmaels & Ransford, London WC1	25
15th November	CITMA Webinar	Log in online	1
28th November	CITMA Lecture – London*	58VE, London EC4	1
8th December	CITMA Christmas Lunch – London**	London Hilton on Park Lane, London W1	

SUGGESTIONS WELCOME

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

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** Pre-lunch drinks sponsored by

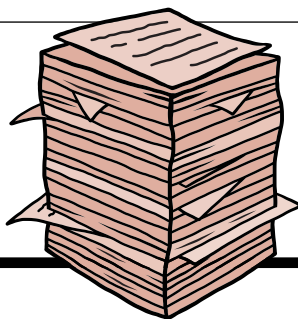


Refurbishment at the Royal College of Surgeons means our London lectures will move to a new venue on Victoria Embankment from July. Register now at citma.org.uk



THE TRADE MARK 20

Q&A



I work as... the Chief Executive of CITMA.

Before this role, I was... a civil servant working on various employment relations policies within central Government. Before that, I worked at the UK IPO in the Trade Marks Law section (now known as the Tribunal section).

My current state of mind is... zen-like (I wish). I try to stay calm whatever the situation, as I prefer to be happy and positive. I don't see any fun in being the opposite.

I became interested in IP when... I learnt about it through my time at the UK IPO. Before that, I hadn't really appreciated what IP was or what value it added. I owe a lot to the people at the UK IPO who believed in, mentored and supported me.

I am most inspired by... people who work hard or who have overcome a difficult situation while maintaining a smile on their face and enjoying life. Also, those who give up their time voluntarily to give back to their community.

In my role, I most enjoy... the variety of duties and responsibilities. In a single day, I can be dealing with a myriad of different situations and issues, which makes each day different and (by and large) enjoyable.

In my role, I most dislike... the time it can sometimes take to make changes and implement new ideas. It is the nature of membership organisations, because of the governance arrangements they need to have, but it can be frustrating when you feel valuable time is being lost.

On my desk is... too much paper. It is hard to implement a zero-paper policy when even I can't comply! But, at CITMA, we are continually trying to improve our environmental credentials.

My favourite mug says... nothing. I don't have a mug in the office as I try not to drink too much tea. I succumb to the local Pret instead.

My favourite place I have visited on business is... South Africa. I went there to benchmark and advise the South African registry on its *inter partes* procedures. I was lucky to be given a personal tour of many parts of the country, and I was privileged to see inside the townships where tourists wouldn't normally go, as well as the more traditional tourist spots.

If I were a trade mark/brand, I would be... Coca-Cola – “always the real thing”.

The biggest challenge for IP is... the impending changes as a result of Brexit. I am hopeful we will have certainty about these soon so that our members and the wider profession can plan and make the most of any opportunities that arise.

The talent I wish I had is... to excel in sport or music. I think I am fairly competent in both, but it would have been great to have the opportunity to have done either professionally (before joining CITMA, obviously).

I can't live without... air and water.

My ideal day would include... the perfect mix of work, rest and play.

In my pocket is... very little cash – it's scary how quickly contactless cards are becoming the normal method of



Keven Bader
is currently both
restless and cashless

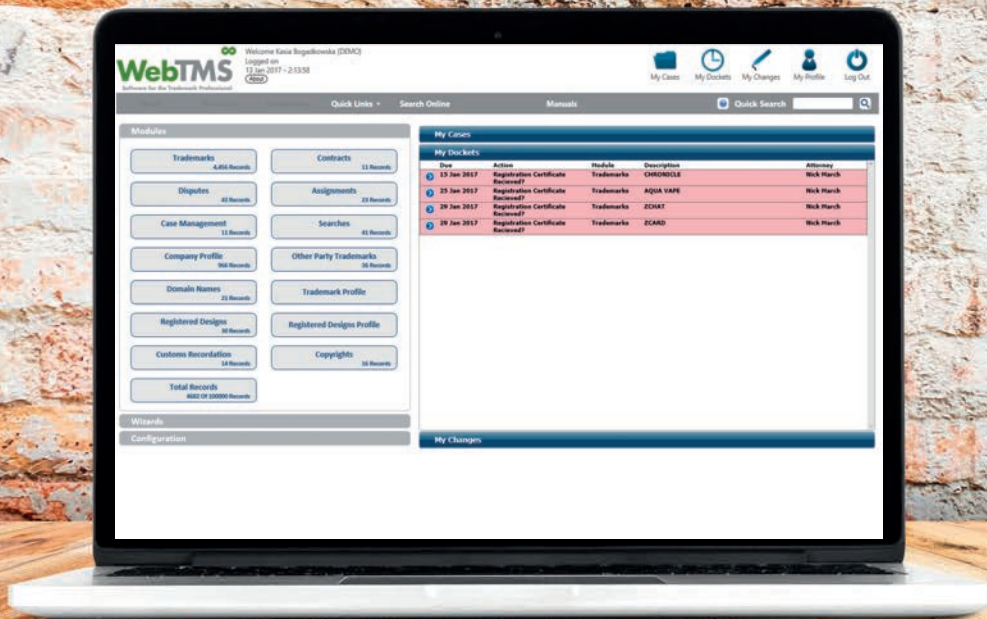
payment. Oh, and my annual season train ticket to get me to work and back, sometimes without delays.

The best pieces of advice I've been given are... always be optimistic – and flattery will get you everywhere!

When I want to relax... I don't think I ever really do relax unless I am sleeping. My family tell me that I should stop pottering and try to relax from time to time!

In the next five years I hope to... have arranged an epic adventure, such as trekking in the high peaks of the Himalayas.

The best thing about being a member of CITMA is... that's an interesting question, as I am not actually a member of CITMA – maybe I will be one day!



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