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ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

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February 2016



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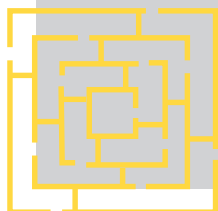
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ITMA Review

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I start by wishing you the very best for 2016, albeit belatedly. Then, cast your minds back to Christmas, please. In case you cannot, this issue provides reports on our successful Christmas lunches in Leeds and London. If you find any photographic evidence, you will know that you were there. This issue also contains our customary quotient of edification. For example, we have an update on the IPO's progress in relation to CP3, the Convergence project on figurative marks containing descriptive words. Further afield, we

hear from the IPO attaché in Brazil, there is an insight into the USPTO's TTAB and an update on bad faith in relation to Irish trade marks. In a four-page preview, we also look forward to our Spring Conference, which is fast approaching.

Chris McLeod

ITMA President

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ITMA Insider

Chief Executive's bulletin

Highlights and updates of Keven Bader's 10 December message to members



04

IP INCLUSIVE

On 30 November 2015, IP Inclusive was officially launched. This is a joint initiative seeking to improve equality, diversity and inclusion (EDI) in the IP profession. One of the areas IP Inclusive has developed is an EDI Charter, to which firms and organisations can sign up and show their commitment to this important agenda.

IP Inclusive has a dedicated website which is being populated with more and more content regularly. You can find out more information about the Charter and the other activities linked to this initiative at ipinclusive.org.uk.

Most firms will already have a commitment to EDI and may have signed up to an alternative type of charter, but that should not stop your firm signing up to this one as well. The requirements for signature are not overly burdensome, deliberately so, and I encourage all firms to at least consider committing to the principles behind the Charter.

REGULATION

There is a lot of talk at present about the future of regulation, cost of regulation and how red tape for regulation can be cut. Much of this work is being led by the Legal Services Board and we are making sure that ITMA is involved in discussions to help influence and shape the conversations.

On 30 November, the Government announced a package of measures, within which were a few related to the legal services sector. The announcement referred to a blueprint for change titled *A Better Deal: Boosting Competition to Bring Down Bills for Families and Firms*.

The main point relating to legal services is a commitment to launch a consultation by spring 2016 on removing barriers to entry for alternative business structures so that it is easier for alternative business structures to offer legal services, and on making legal service regulators independent from their representative bodies.

On the latter point, there is a requirement under the existing Legal Services Act for separation and independence between representative bodies and arms-length regulators, but where that line of independence sits is subject to differing interpretation across the various legal services sectors. All Approved Regulators have a different model for delivery of independent regulation and there is no clear indication of which model is exemplar. ITMA will be looking at the detail of the consultation when it is published and we will update you on any developments.

IPO WARNING – NEW RENEWAL SCAM

The UK Intellectual Property Office (IPO) has issued a warning of a potential new renewal scam notice, bearing the IPO's own trading name on "reminder" letters asking for money for renewing UK trade marks. Please make sure that your clients are reminded that these scams exist and



that they should not pay any transaction relating to their IP without speaking to you first.

Recently, the IPO successfully brought trade mark infringement and passing off action against a “prolific and persistent scammer” which resulted in an order to pay £500,000 plus legal costs.

With any luck, this judgment and the efforts of everyone to raise awareness among registered proprietors of these activities will result in such companies deciding it is no longer worth the financial gain, resulting in the demise of these unscrupulous activities.

ROYAL CHARTER

Our application for a Royal Charter is progressing nicely. We have replied to informal comments received from the Privy Council Office (PCO) about our draft documentation and more recently on points of detail in respect of the draft bye-laws. At the time of writing, we are not aware of any substantive issues. Therefore, we keep everything crossed for the continuing progress of the application and await news from the PCO.

JOBS BOARD

We have listened to comments from members and recruiters and invested time into improving the ITMA jobs board to make it more user-friendly and appealing to those wishing to advertise opportunities, as well as those seeking pastures new. Visit itma.org.uk/job_board/list to see the new layout and view the latest jobs.

And, if you have any thoughts on the jobs board or any aspect of the website, please contact Richard Hayward on Richard@itma.org.uk and we will use that feedback to help us develop and improve.

2016 MEMBERSHIP SUBSCRIPTIONS

Thank you to all those who have paid their subscription renewal. For those who haven't, the closing date for payments is 29 February 2016. If you haven't received an email advising you of your renewal and enclosing an invoice, contact Marzia at the ITMA office on Marzia@itma.org.uk.

- **Left to right: Polly Harling, Dehns; UK IPO Chief Executive John Alty and CIPA President Andrea Brewster; and Keith Hodkinson, International Chairman, Marks & Clerk, all pictured at the IP Inclusive launch**

READER REVIEW

Florian Traub takes time to assess the new edition of Intellectual Property and EU Competition Law

Just as the publisher's description says, the interface between IP rights and competition policy is one of the most important and difficult areas of EU law. There is an indisputable need for the law both to grant and protect IP rights that promote one form of competition (in innovation and quality), even if this is at the expense of other forms of competition (in production and distribution). Both IP rights and competition law have the same

“

The second edition maintains the work's excellent reputation as an authoritative study

ultimate justification, namely boosting the economy, in the one case by encouraging creativity in relation to goods and services, and in the other by encouraging high standards and low prices.

Jonathan DC Turner's second edition maintains the work's excellent reputation as an authoritative study and fulfils its aim of being accessible while maintaining academic rigour. This is a timely and important update on numerous developments that have taken place since the first edition was published in 2010, including: a series of judgments of the CJEU recognising that the EU Copyright directives constitute full harmonisation of most areas

of copyright law; the new EU Directive regulating the conduct of collection societies; the debate on FRAND (fair, reasonable and non-discriminatory) commitments and their impact on IP rights; the revision of the Technology Transfer Block Exemption and Guidelines; the introduction of a new block exemption for Research and Development; and numerous new cases decided by the CJEU in the relevant field.

The work is now split into seven chapters, starting with a concise summary of the fundamental elements of the interface between IP rights and EU competition law. Two chapters are dedicated to application of Articles 101 and 102, with the remaining chapters focusing on a detailed explanation of such issues as technology transfer and FRAND terms, research and development, collecting societies and brand protection by trade marks and other rights.

This book effectively combines theory and academic debate with an in-depth and very practical analysis of the case law in this field.



Intellectual Property and EU Competition Law, Oxford University Press (Second Edition, 8 October 2015) by Jonathan DC Turner. Hardback, 544pp. Also available as an ebook.

Member moves

Leona Ogier has joined Forresters, where she is a Trade Mark Attorney. Leona can be contacted at logier@forresters.co.uk or on 020 7283 7114.

ITMA'S CHRISTMAS KICK-OFF

Our members once again met up at two lively events in December to celebrate the festive season together



IN LONDON

Some 550 ITMA members and guests enjoyed a three-course meal in the magnificent Grand Ballroom at the London Hilton on Park Lane. The meal was preceded by a drinks reception sponsored by Thomson Compu.Mark, and followed by networking in the Crystal Palace suite.





At the London lunch, ITMA President Chris McLeod awarded prizes to the following members, who excelled in 2015:

- **Sarah De'Ath**, BP, received the ITMA award for the highest mark achieved by an ITMA member on Bournemouth University's Postgraduate Certificate in IP Law course
- **Amy Wood**, Marks & Clerk, received the ITMA award for the highest mark achieved by an ITMA member on Queen Mary University of London's Trade Marks Law and Practice Postgraduate Certificate course
- **Annabel Hanratty**, UDL, received the ITMA award for the highest mark achieved by an ITMA member on Nottingham Law School's Professional Certificate in Trade Mark Practice
- **Liam Peters**, Wynne-Jones IP, received the Thomson CompuMark award for the highest mark achieved on the 2015 ITMA Trade Mark Administrators' Course

LONDON Photos: Stewart Rayment and Richard Hayward

1. Guests seated in the ballroom
2. Tara Sarwal (Norton Rose Fulbright), Christopher Martel (McLaren) Helen Stanwell Smith (Orange) and Clare Jackman (Norton Rose Fulbright)
3. The elegant dessert (photo courtesy of @EIP_Brands)
4. Sir John Mummary (Hogarth Chambers), Stewart Vandermark and Malcolm Chapple (Nelsons)
5. Christmas lunch drinks
6. Nicola Rochon and Ben Evans (Blake Morgan)
7. ITMA members networking
8. Chris McLeod gives his address

LEEDS Photos: Keven Bader and Carin Burchell

1. ITMA revellers enjoy time to talk
2. The President's table
3. Rachel Garrod, Chris Hoole, Robert Cumming and Jorandi Daneel (Appleyard Lees)



IN LEEDS

Our Northern Christmas Lunch was held at Blackhouse, the Grill on the Square, in the heart of Leeds and sponsored by Darts-ip. Local members were joined by those from farther afield and IP bar friends. The restaurant was beautifully decorated for Christmas and the food was excellent, which made for a convivial afternoon spent by all in the company of colleagues.

LOOKING TO GROW YOUR TEAM?



Look no further

ITMA members are at the heart of the European trade mark and design profession, and they all receive the *ITMA Review* **eight times per year**

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Brazilian briefing

Sheila Alves brings us up to date on her area of IP engagement

MID-2015 MARKED my third anniversary as the UK IPO's attaché to Brazil. It also marked the start of some significant developments which I hope will add momentum to UK-Brazil cooperation on IP.

First, on 27 July 2015, President of the Republic of Brazil Dilma Rousseff named Luiz Otávio Pimentel as the new President of the National Institute of Industrial Property (INPI). Dr Pimentel announced that one of his priorities is to decrease INPI's backlog of trade mark and patent applications.

A trade mark application in Brazil, if opposed, may take six to seven years to be resolved. Reducing backlogs is a tough challenge in the face of the current financial constraints across the whole of the Brazilian public sector. So I am working with INPI to see how the UK IPO might be able to support this aim within the framework of the existing memorandum of understanding between the two offices. This would cover a wide range of joint cooperation activities, such as the sharing of best practice in the fields of patents, trade marks and examiner training.

Another key date was 28 October 2015, when Brazil's Trade Minister Armando Monteiro met the Business Secretary Sajid Javid in London for the eighth UK-Brazil Joint Economic Trade Committee (JETCO). I travelled to London for this meeting and worked with colleagues from the UK IPO on the innovation strand of the JETCO. The ministers agreed that the UK and Brazil will continue to work together to improve the IP environment for businesses. This includes continuing to share experiences of IP, branding and enforcement around the Olympic Games.

The JETCO gave me an opportunity to lead discussions on the effective management of IP in collaborative research. In particular, I introduced the work that the UK IPO is undertaking with Brazilian partners to support IP management in UK-Brazil research

collaborations. Indeed, in his previous role, Dr Pimentel participated in a workshop with the UK IPO in 2011 on this very subject, demonstrating just how small the world of IP is!

To be an effective link into the Brazilian system, it is also important that I maintain links with local officials. Last September, I participated in a joint federal and state-level event entitled "Consumer Safety Week: Combating Counterfeiting". This brought together government, business and academia to focus on the safety risks of counterfeit goods, and included the seizure and destruction of 8,000 pairs of counterfeit sunglasses.

So, what does the future hold? Brazil has a challenging economic climate at present, but this does not stop British businesses from needing to protect their IP in Brazil, whether they currently export or may export in the future, or perhaps look to collaborate with Brazilian partners in research or enterprise.

This will be a big year for Brazil. The Rio Olympics will be a showcase event, and I will continue to facilitate exchanges between UK and Brazilian experts to share best practice around tackling piracy and counterfeiting and increasing brand protection as part of the Olympic legacy of London 2012.

As ever, I am always available and would love to hear about your experience of IP in Brazil, and where I might be able to help you navigate the complexities of the Brazilian IP system. So please don't hesitate to get in touch if you need some help or support – that's what I am here for! ■



Sheila Alves

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Advocating the active approach

Why Aaron Wood believes that IPEC-style case management is the way forward for the UK IPO

AS *ITMA REVIEW* READERS will know, the key element in the Civil Procedure Rules (CPR) is the overriding objective to enable the court to deal with cases justly and at proportionate cost. This objective informs the whole application of the CPR and many of the elements of discretion (including costs). What this means in practice is that the courts now take far more active control in case management, notably at the case management conference (CMC).

By the end of the CMC at IPEC, the parties will have agreed (or the Court will have determined) the issues in dispute. The Court will then direct as to what evidence may or may not be permitted into the case to establish those issues, with evidence only allowed to be filed if it is permitted by the Court. As a result, parties are expected to know by the time of the CMC exactly what case will be run, so that they can justify that evidence is truly needed to make good their case, and to identify where this evidence will come from. A party may have an adverse costs position if it takes an unreasonable position in demanding proof of a fact.

The UK IPO has taken on the concept of CMCs, but these are very different. No specific permission is required for evidence, and applications for the other side to amend its case are largely rebuffed. When one considers that costs awards are limited in scale, a rational party would overemphasise its case to seek to exert pressure over the other party.

Tribunal Practice Notice 1/2015 deals with some of these excesses by imposing an arbitrary page limit. The problem with this approach is that so long as the evidence comes in under the page limit no alarm bells will sound at the

Registry. And if the evidence proves to be irrelevant then there is no massive costs consequence. Its purpose is to remove “large volumes”, not irrelevant evidence per se.

It remains to be seen whether the UK IPO will adopt the more interventionist approach to CMCs favoured by IPEC. In my opinion, doing so would be to the benefit of each side and the IPO. While some have put forward the argument that it complicates the procedure, this seems to ignore the existing complexity and the abuse of the system by some players. An unrepresented party would be better served by a more interventionist approach to the evidence, since this would allow it to be led away from evidence that would not assist the Hearing Officer in reaching a decision (where permission would be refused).

It would also help to avoid abuse by a represented party. Although it would lead to greater up-front cost – by forcing parties to consider their cases carefully at the outset – it may also reduce the evidential burden (which is where much of the cost lies), lead to a greater number of settlements and reveal abuse by parties who currently seek to take advantage of the procedure by filing flabby cases, rehashing old and irrelevant evidence and otherwise abusing the grey areas. ■



Aaron Wood

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 Aaron is a member of the
 ITMA Council.



FRIENDS OF THE BRAND

Roland Mallinson explains the work of the MARQUES Amicus Curiae Team

Brand owners are key stakeholders in our trade mark regimes. Their interests lie in securing greater clarity and certainty in the law, and avoiding any unintended erosion of trade mark owners' rights. This is why MARQUES, the Association of European Trade Mark Owners, maintains a small but active *amicus curiae* team, which submits non-party intervener briefs in cases whose outcome is likely to have important ramifications for trade mark owners.

The aim of the nine-member team is to ensure that the relevant judicial tribunal is provided with not just the legal arguments of the party or parties involved, but with the added perspective of brand owners generally.

We have intervened in the Voss, Kit Kat, LAN Airlines and Nokia cases, amongst others. Most of our cases have involved submissions for consideration by the Court of Justice of the EU (CJEU) or the General Court. The latter are necessarily cases on appeal from OHIM's Board of Appeal, involving an opposition or cancellation action, or rejection of an application on absolute grounds. The former may be a further appeal of a case or a referral from a national court for a preliminary ruling on how it should interpret a piece of European legislation. These latter cases are the most likely to merit an *amicus* brief as they tend to have an impact on future cases. We have also made a submission to the World Trade Organization panel in the tobacco plain packaging case.

There are a number of options open to us in terms of how we intervene before the European court. First, we can seek leave of the court to intervene directly. For example, we have just been given leave by the General Court to intervene in the Red Bull blue-silver colour mark case. In a test case in 2015, we sought leave of the CJEU to intervene in the referral from the Italian court in the Ford v Wheeltrims case. Our request was refused on the basis that third parties may not intervene in preliminary ruling cases. We are open to challenging that interpretation of the CJEU rules in a future reference for a preliminary ruling.

Another option in referral cases is to secure party status in the case before the referring court refers its questions. That means knowing about the case and its likely importance at a very early stage. The downside is that we could commit considerable time, effort and money to securing that status, only to find the national court decides not to refer any questions. To date, we have not done this.

An option for all our cases is to prepare a brief that we submit to everyone with inherent standing to intervene. That means either one or both of the parties and the national



Our aim is to ensure tribunals are provided with not just the legal arguments of the parties involved, but with the added perspective of brand owners generally

governments of all 28 EU Member States. We have done this in a number of cases, including one where a national government adopted our entire submission as its own.

In other cases, our briefs may simply be annexed to a submission or some of the points we make adopted. We are not fussy. For us, the goal is to have the general interests of trade mark owners represented before the court, with or without the MARQUES *imprimatur*. Please let us know if we can help in your cases. ■

For further information about the MARQUES Amicus Curiae Team, see marques.org.



Roland Mallinson

is a Partner at Taylor Wessing LLP

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Roland has been a member of the MARQUES Amicus Curiae Team for six years.

the extra factor

UK IPO Head of Examination Practice
NATHAN ABRAHAM tells Sarah McPoland why the Office is unconcerned about implementing the new Common Practice on figurative marks, which is intended to help harmonise examination practice across the EU

Sarah McPoland: What do you think will be the biggest changes in UK examination practice as a result of implementing harmonised practice, post-CP3?

Nathan Abraham: In all honesty, there should be very little in the way of a perceptible change in UK examination practice as a result of implementing CP3. Although it's not a recognised legal principle, the UK has long referred to the notion of 'surplus' in the context of assessing inherent distinctiveness in composite marks. Put plainly, the IPO's examiners and Hearing Officers have always considered how much 'extra' matter has to be added to an obviously descriptive and/or non-distinctive word before the resulting composite sign (which includes said descriptive/non-distinctive word) is capable of functioning as an indicator of trade origin.

Such assessments have also been part of *ex officio* appeals to the

Appointed Person in cases like Quick Wash Action (BL O/204/04), Sun Ripened Tobacco (BL O/074/08) and Fresh Direct (BL O/367/10). This is effectively what CP3 is all about, so the principles espoused in the common practice should look familiar to UK practitioners.

As the UK Office was one of the first to implement this practice, have you already come across any unforeseen changes?

Not yet. The CP3 Common Communication documents fit into the existing family of published IPO guidance on absolute grounds examination practice, so it will sit alongside familiar documents like the Examination Guide (formerly known as ‘the Work Manual’) and our Practice Amendment Notices (PANs). In the future, it is possible that practitioners will refer to examples set out in the Common Communication in the course of prosecuting trade mark applications, just as they currently do in respect

WHEN IS A FIGURATIVE MARK THAT CONTAINS PURELY DESCRIPTIVE/ NON-DISTINCTIVE WORDS NOT REGISTRABLE?

If the descriptive/non-distinctive word appears in:

1. Basic or standard typeface, as in:

Fresh Sardine
FrEsh SaRdine

This example assumes that the mark covers sardines in the specification.

2. Handwritten-style typeface, as in:

Flavour and aroma

This example assumes that the mark covers coffee in the specification.

ABOUT CP3

The latest Common Practice for trade marks in Europe suggested by the European Trade Mark and Design Network (TMDN), known as CP3, was published in early October 2015.

The objective behind this project is to help harmonise practice across the national offices of the EU relating to examination of figurative marks, containing purely descriptive/non-distinctive words.

This practice was implemented by the UK IPO on 2 October 2015 and it will be implemented by OHIM as this issue of

the *ITMA Review* is delivered. Many other national offices within Europe will be implementing it, too.

There are some differences in the levels of implementation of this practice. The UK IPO has adopted it for applications and invalidity requests filed after the implementation date, whereas OHIM will be adopting it for applications and invalidity requests filed after the implementation date and also those applications and relevant invalidity proceedings pending on the implementation date.

of examples published in the Guide and the PANs.

Is the practice change resulting in more discussion among examiners than would be usual for the sort of marks being considered here?

‘Surplus’, or the net effect of extra matter added to descriptive and/or non-distinctive words in the context of composite marks, has always been one of the areas to generate the most discussion among IPO examiners. Although we’re reasonably familiar with assessing the impact of typefaces, stylised words, geometric shapes, size and position, and colour, the Common Communication’s section on “figurative representation of the goods” has been a particularly welcome addition. Our existing practice materials haven’t specifically addressed this scenario, so that section has given rise to some discussion among examiners and Hearing Officers.

Why did the UK IPO decide only to implement this practice for applications filed and invalidity proceedings started after implementation – and not to all pending marks/proceedings?

We opted for the single “filing date” approach to implementation for



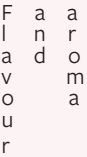


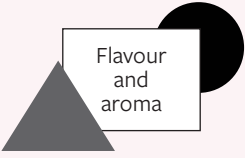





reasons of administrative simplicity. Because CP3 doesn’t represent a significant change of course in terms of absolute grounds practice (whether applied at examination, opposition or cancellation stage), there’s no need for any sort of transitional provisions between applications and actions filed, and the date of CP3 implementation.

Would all typefaces available on a computer be considered standard typefaces?

Like any application, the impact of typeface stylisation on a sign’s inherent capacity to denote commercial origin has to be assessed on a case-by-case basis (including a consideration of other factors, such as the extent of the word element’s descriptiveness and/or non-distinctiveness). That being so, it’s not possible to objectively designate some typefaces as “common” and others as “uncommon”.

It is possible that some typefaces as provided via common word-processors might contribute to a mark’s distinctiveness. However, those involved in the convergence work unanimously agreed that the type of “standard” typefaces as shown in the Common Communication’s examples were most definitely not capable of providing a word with the requisite minimum amount of inherent distinctiveness.

THE NET EFFECT OF EXTRA MATTER

WHAT IF I	FOR EXAMPLE	IS THE MARK REGISTRABLE?
Use bold or italics?	Flavour and <i>aroma</i>	No
Add a colour to the background?		Not usually, although it cannot be ruled out that an unusual arrangement that can be easily remembered may be enough
Add different colouring to each letter?		Not usually, although it cannot be ruled out that an unusual arrangement that can easily be remembered may be enough
Use punctuation marks?	“Flavour and aroma”	No
Create an arrangement in which the word elements are upside down or vertical?		No
Create an arrangement in which the words are arranged in a very unusual way?		Possibly, if the positioning is so unusual that the average consumer may focus on the positioning rather than the wording
Use basic geometric shapes?		No
Use geometric shapes that in combination or through their configuration create a different overall impression to one lone geometric shape in a basic configuration?		Yes
Add a large, distinctive figurative element?		Yes
Add a small, distinctive figurative element?	Flavour and aroma 	No, as it can't be seen by the average consumer and so doesn't add anything
Add a representation of the wording alongside it?		No
a) a representation of the wording itself but in an unusual way?		Yes
b) a figurative mark which is in itself common in the trade?		No

It should be noted that language issues, disclaimers and use of the mark (acquired distinctiveness and use in trade) were not within the scope of this project. For full details and additional examples, see [Common_practice_of_distinctiveness.pdf](#) at gov.uk.

“

Surplus, or the net effect of extra matter in the context of composite marks, has always generated discussion among IPO examiners

Have you found being part of the European Trade Mark and Design Network (TMDN) to be useful for the UK Office?

The IPO has played a significant role in all five of the now-implemented convergence practices, and continues to play a part in the two ongoing design convergence projects.

Reflecting that level of participation, the IPO is very positive on the value of the network, and the numerous projects it has helped to bring about – most importantly in terms of how it improves the landscape for users and business.

The variance in national offices' responses to a survey on distinctiveness completed at the outset of CP3 demonstrated just how much divergence still exists in trade mark examination practices across the EU – even in those areas of law and practice which have been addressed and clarified in CJEU judgments. In that context, convergence (and the wider TMDN initiatives) – including the common practices established as a result of CP3 – has been invaluable for “filling in the gaps” between Community jurisprudence and national practices.

More importantly, the broader objective of convergence has always been to improve consistency and legal certainty for the benefit of businesses across Europe, thereby making our parallel registration systems easier, cheaper and more predictable to use. And the more the UK can lead and influence in matters of pan-European

trade mark practices, the better it should become for UK users of both the national and Community systems.

What one further practice would you like to see harmonised in Europe?

Having just reached agreement on the package of EU trade mark reforms, changes to the Regulation will arrive early this year, and we'll then have up to three years to make the necessary changes to UK law. With that all to come, it may be premature to contemplate too much further change as a result of more convergence at this time.

Nevertheless, alongside the ongoing designs projects (so-called CP6 and CP7), OHIM and national offices are considering where next to take convergence. One area that could benefit from converged practice is that of Geographical Indications (ie Protected Designation of Origin and Protected Geographical Indication), given how provisions set out in both the new Regulation and the recast Directive will affect the way they are assessed and examined. On a similar theme, there may also be value in considering the likely impact of ongoing EU consultations regarding extension of the existing legislation for agricultural GI into the area of non-agricultural products. ■

Download the full Common Communication on the Common Practice of Distinctiveness – Figurative Marks at gov.uk.



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Tania Clark reports on a recent joint event that drew ITMA members to Dublin

AN IRISH PERSPECTIVE

The Irish Perspective, a joint seminar between ITMA and APTMA (the Association of Patent and Trade Mark Attorneys), was chaired by ITMA President Chris McLeod and Simon Gray, his APTMA counterpart, and began with a welcome from Britain's Ambassador to Ireland, Dominick Chilcott. The Ambassador gave an interesting insight into his experiences in the role during the past three and a half years. This was followed by a political discussion on the various EU points to be raised by Prime Minister David Cameron in his letter of "Asks" to Donald Tusk, President of the European Council. The Ambassador contextualised his various comments by noting, for example, the continuing rise in immigration to Ireland.

SESSION DETAIL

The first official session of the day was "An Overview of Opposition Procedure" by Dermot Doyle from the Irish Patents Office. Doyle was critical of the traditional method of adopting the "kitchen sink" approach in oppositions. Extensions of time are frequently requested and irrelevant material is included. Attorneys also have a tendency to make personal comments in their Statutory Declarations, he said.

As far as case law is concerned, reliance should be placed on UK, Irish or CJEU case law rather than OHIM decisions or those of other national offices. Also, he suggested that it is a good idea to consider the Hearing Officer's past decisions and tailor your arguments accordingly, and noted that awards of costs are considerably lower in Ireland than in the UK.

Steve Rowan of the UK IPO then proceeded to explain the UK approach. He suggested that passing off claims need not be included in oppositions when relying on earlier registrations/applications. The author mentioned the recent IPEC decision *The Sofa Workshop Ltd v Sofaworks Ltd*, in which HHJ Hacon decided that use in one Member State may not be sufficient to avoid revocation for non-use.

However, Rowan maintained that Hearing Officers were not following this decision and that use in one Member State would suffice.

DISTURBING VISION

This was followed by a disturbing vision of the future from Robert Cumming (Appleyard Lees), in a talk that looked at "Trade Mark Law through Google Glass". The Google Glass project includes a smartphone with an app that can translate signs. This could be developed, through the

inclusion of a microchip in spectacles or even contact lenses, such that users will see the translations of signs as they move around.

David Brophy of FRKelly then asked the question: "Designs – Cinderella of IP, or its Fairy Godmother?" He explained that design registrations are particularly useful for protecting whole or even parts of products, whereas a trade mark is more restrictive. A design can include a graphic or get-up, or even part of a graphic. You could register a stylised word in a multiple design registration and this could include every variation on the word. It would be far too expensive to register every variation as a Community Trade Mark (CTM), the difference being £12,000 for the CTM and £2,300 for the Registered Community Design (RCD) in the example provided. Also, a CTM can be revoked for non-use after five years, whereas an RCD lasts up to 25 with no use requirement. If a mark consists of a descriptive word and device it is likely to be rejected as a CTM despite the inclusion of the device, which is not the case with an RCD. With unregistered designs, you can tailor your claim to parts of the design that are infringing, but they only last for a few years and you must show copying to prove infringement. Further, unregistered designs do not include surface design.

COUNTERFEIT FOCUS

Next came "Anti-counterfeiting Aspects of the New EU TM package – Especially Goods in Transit" by Jeremy Newman of Rouse Legal. The new Regulation (608/13) introduces a number of procedural improvements, including an opt-in, simplified destruction of small consignments and an anti-Counterfeit and anti-Piracy Information System (COPIS) database. Counterfeit goods are now defined as: "goods which are the subject of an act infringing a trade mark in the Member State where they are found and bear without authorisation a sign which is identical to the trade mark validly registered in respect of the same type of goods, or which cannot be distinguished in its essential aspects from such a trade mark". This Regulation is expected to become effective later this year.

As far as goods in transit are concerned, the proprietor of a



registered trade mark will be entitled to prevent third parties from bringing goods into the Member State where the trade mark is registered without being released for free circulation there, where such goods come from third parties and bear without authorisation a trade mark which is identical (or virtually identical) to the trade mark registered. An interested party can challenge detention in proceedings, but the other party has to prove the negative, which puts the burden on traders in fake goods. This could lead to a significant increase in the number of fake items seized by Customs.

It is important to file Customs records and ensure that there are decent supporting materials, routine, timely intelligence and translation into the relevant language. A detailed database is essential to manage the cases and track intelligence: this will increase intelligence matching and the likelihood of success in proceedings.

Christina Gates of Tomkins then gave an introduction to "Ireland's Knowledge Development Box". She contrasted it with the other European Patent Boxes. In Ireland, the Knowledge Development Box relates to computer programs, qualifying patents and Supplementary Protection Certificates for medicinal products and plant protection products or plant breeders' rights.

Finally, David Butler of Corsearch spoke about "Considerations for Digital Brand Solution Strategy". Most solutions offer annual subscriptions or licences and many focus on expensive support systems.



1. ITMA President Chris McLeod co-chaired the event

2. Dominick Chilcott, Britain's Ambassador to Ireland, gave an insight into his role

3. Steve Rowan (UK IPO), Robert Cumming (Appleyard Lees) and Seamus Doherty (Tomkins) enjoy networking at Drury Buildings



The alternative models that should be considered, he said, are a subscription on a per-client basis, a reseller model, or a combination of these methods, which may provide for greater control.

The seminar ended with a convivial dinner at Drury Buildings restaurant. The resounding conclusion was that it had been a great success. ■

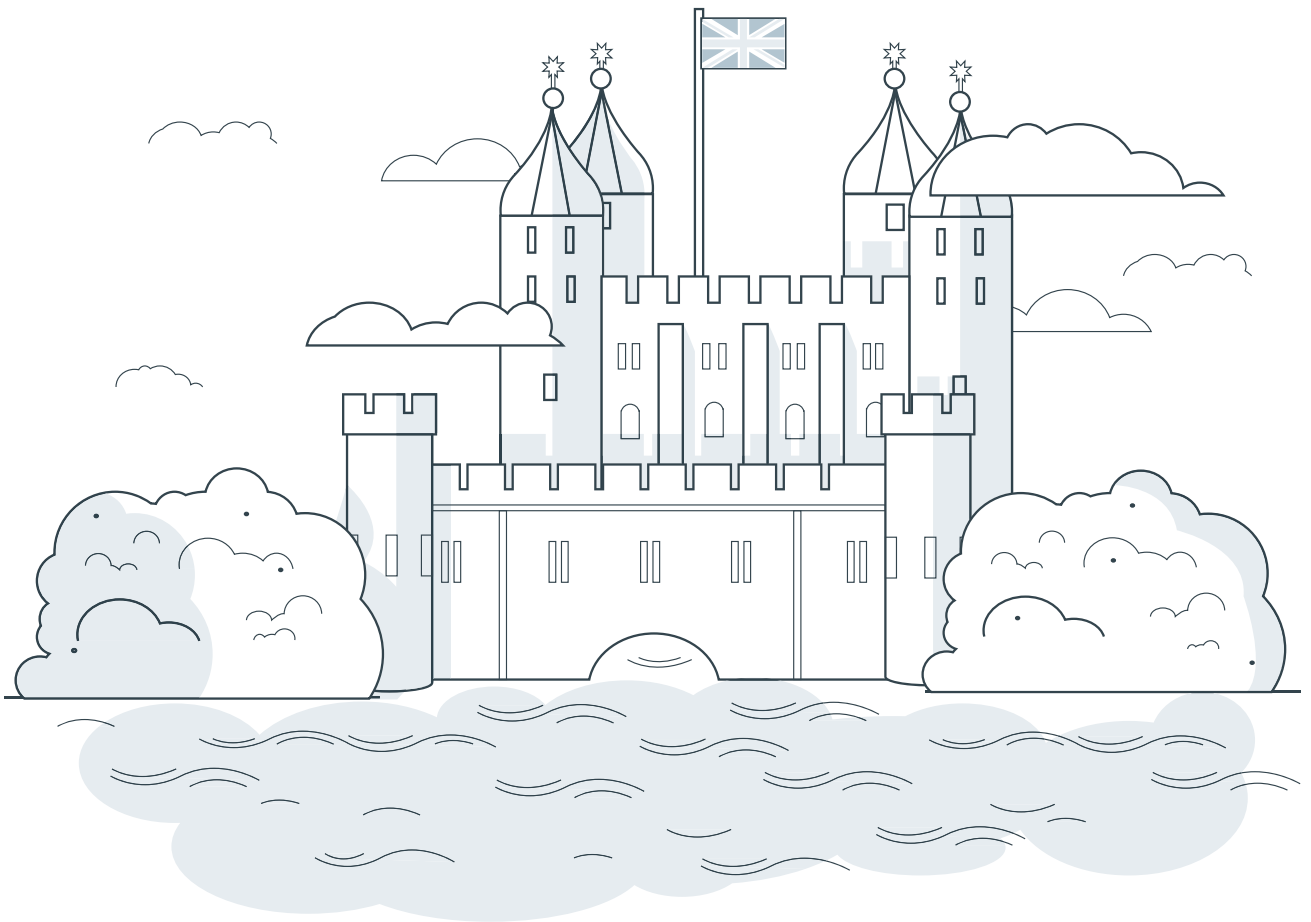


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ITMA SPRING
CONFERENCE



18

JEWEL IN THE CROWN

*This year's Spring Conference takes place in some of
London's most spectacular and historic locations*



CONFERENCE BASE – ONE WHITEHALL PLACE

Our Spring Conference returns to One Whitehall Place for the second successive year. It is ideally located in

the heart of London, a stone's throw from Trafalgar Square, and features stunning views of London, looking out across the Thames to the London Eye and the South Bank, and is the perfect space for our conference.

Designed in the style of a grand French château, this conference headquarters features a wealth of architectural detail and elegance – including intricate plasterwork, lofty ceilings, and a breathtaking, free-standing staircase cut from solid Sicilian marble and reputed to be the largest of its kind in Europe.

It also adjoins the Royal Horseguards Hotel, a perfect choice for those delegates who need overnight accommodation.



WELCOME RECEPTION – JEWEL

On Wednesday 16 March,

join us for an evening drinks reception in the chic, luxurious Jewel bar located in the heart of London's West End, overlooking Piccadilly Circus. This is the perfect way to begin your Spring Conference experience and get to know and network with fellow delegates.

You will meet overseas and UK-based Trade Mark Attorneys, IP barristers, judges and support service providers such as searchers and investigators.

ITMA will have exclusive use of an area in Jewel, and drinks and canapés are included in the price.



GALA DINNER – TO THE TOWER

There's no greater symbol of UK heritage than the Tower of London, steeped in history and legend.

And now it provides the setting for our Gala Dinner on 17 March, when delegates will have exclusive access to parts of this landmark building.

The evening includes a networking drinks reception in the White Tower, the oldest section of the venue, built some 1,000 years ago.

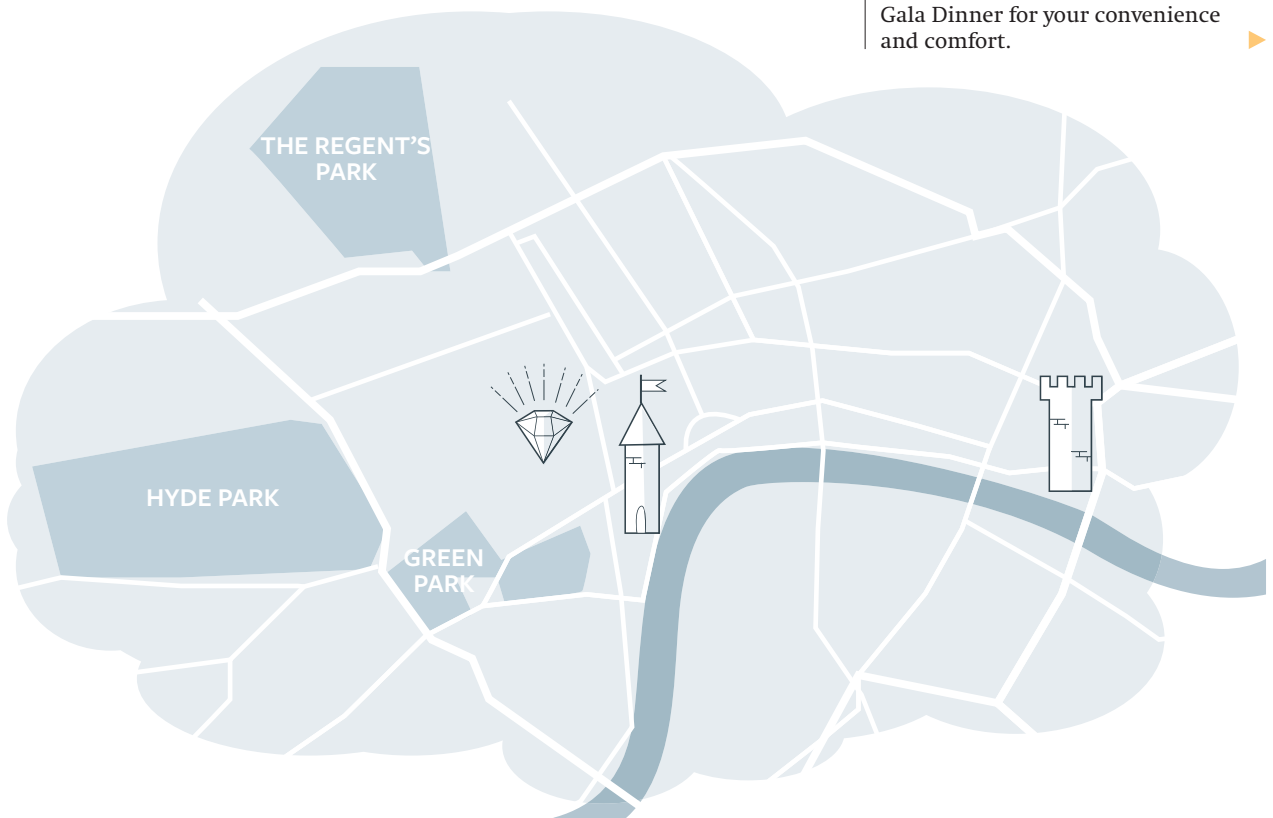
ITMA President Chris McLeod will address delegates, and you will get the chance to continue networking throughout the evening.

Dinner is in the New Armouries part of the Tower. This large, elegant, brick building was built in 1663 for the Board of Ordnance, a British government body created in the 15th century to design, test and produce armaments and munitions.

Yeoman Warders, better known as Beefeaters, will provide exclusive tours round the Tower. You will also experience a private viewing of the Jewel House and see the world's most valuable array of crowns, coronation regalia and jewels.

Between 9.30pm and 10.05pm, the traditional Ceremony of the Keys will take place, during which nobody can leave or enter the venue. The ceremony is the traditional locking up of the Tower of London and has taken place every night, without fail, for at least 700 years.

Coaches will take delegates from One Whitehall Place to and from the Gala Dinner for your convenience and comfort.



HISTORY & HERITAGE – CONFERENCE PROGRAMME

Wednesday 16 March

18.45–20.15 Networking drinks reception, Jewel Piccadilly

Thursday 17 March

9.15–9.30 Welcome

9.30–9.40 Keynote Speech: Tugba Unkan, Partner, Frame Denim

9.40–10.20 Allan James, UK IPO

10.20–11.00 *Protecting the Public*, DI Mick Dodge, PIPCU

11.00–11.40 Tea & coffee break

11.40–12.20 *Scotching the Infringers*, Robert Buchan and Gill Grassie, Brodies LLP

12.20–13.00 Alan Park, Scotch Whisky Association

13.00–14.20 Lunch

14.20–15.00 *The Legacy Copyright Acts – It's Not Just Peter Pan that Doesn't Get Old*, Nick Phillips, Edwin Coe LLP

15.00–15.40 *Zombie Brands: Is it Safe to Resurrect Abandoned Historic Brands?* Carrie Bradley, Stobbs IP

15.40–16.10 Tea & coffee break

16.10–16.50 *Protecting British Heritage in the Middle East*, Jon Parker, Clyde & Co

16.50–17.00 Closing words

19.00–22.30 Drinks Reception & Gala Dinner, Tower of London

Friday 18 March

10.00–10.10 Welcome

10.10–10.50 David Stone, Simmons & Simmons

10.50–11.20 Tea & coffee break

11.20–11.50 *The Royal Warrant – A Treasured and Respected Institution*, Russell Tanguay, The Royal Warrant Holders Association

11.50–12.30 *Heraldry and Royal Insignia*, Clive Cheesman, Richmond Herald, and the Honorable Christopher Fletcher-Vane, Portcullis Pursuivant, College of Arms

12.30–14.00 Lunch

14.00–14.40 Department for Environment, Food & Rural Affairs (DEFRA)

14.40–15.20 *Evolving Brands, Evolving Challenges*, Sarah McPoland, Nestlé UK Ltd

15.20 Closing words

This programme is subject to change.

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Member £760 (VAT exempt)

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– deadline 8 March

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Social only

Social events can also be booked separately. See itma.org.uk for details.

Delegate fee includes:

- Entry to all Spring Conference sessions
- Welcome drinks reception and canapés on 16 March
- Drinks reception and Gala Dinner on 17 March
- Conference lunches on 17 and 18 March
- Coffee and tea breaks
- All conference documentation
- USB stick with all speaker presentations

EXHIBITOR OPPORTUNITIES

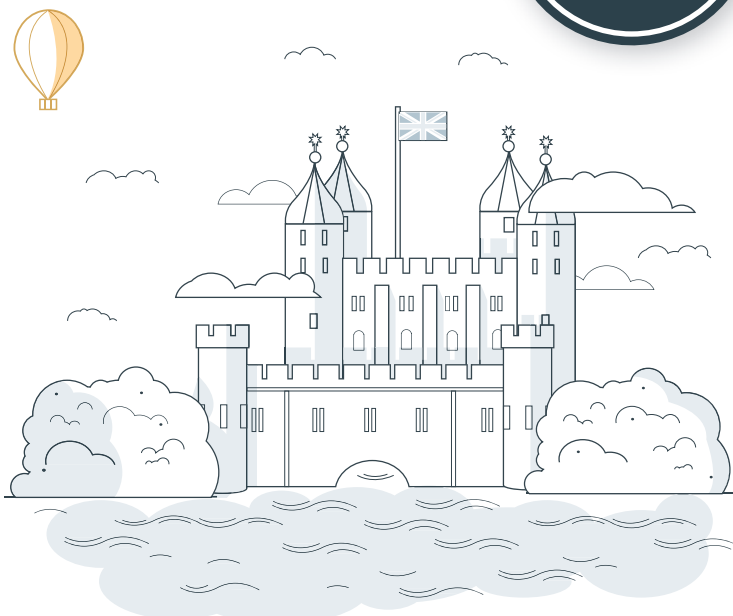
The conference offers an opportunity to present your firm, service or offering to an international audience. Contact conference manager Bev Berridge at bev.berridge@btinternet.com to book a Regular (£900 plus £180 VAT) or Premium (£1,100 plus £220 VAT) stand.

ACCOMMODATION OPTIONS

We are holding a limited number of deluxe double bedrooms at the adjoining Royal Horseguards Hotel at a rate of £250 based on single occupancy, inclusive of VAT and breakfast. Go to itma.org.uk for more information on availability and booking.

This offer is subject to availability until 18 February 2016. More favourable rates may be obtained independently. Alternatively, go to hotelmapp.com/pro/MKA7P for a quick link to other available accommodation options near the event.

OPPORTUNITY
TO EARN
9 CPD HOURS



TOWER OF STRENGTH

We offer an introduction to the long and illustrious history of our fabulous Gala Dinner venue



A nighttime photograph of the United States Capitol building in Washington, D.C. The building is illuminated with warm lights, and its iconic dome is the central focus. A large, bright full moon is visible in the dark blue sky in the upper right corner. The building's reflection is visible in a pool of water in the foreground. The text 'TTAB TOP 5' is overlaid in large, white, serif font across the middle of the image.

TTAB TOP 5

ANDY I COREA BREAKS DOWN THE CRUCIAL
THINGS THAT UK ATTORNEYS NEED TO KNOW
ABOUT THIS US TRIBUNAL

The United States Patent and Trademark Office's (USPTO) Trademark Trial and Appeal Board (TTAB) has the same role as most of its

international counterparts – to adjudicate disputes regarding trade mark applications and registrations. However, TTAB proceedings follow a litigation model and therefore differ greatly from those in most other countries.

Parties considering adversarial proceedings in the US should be aware of the TTAB's procedures and prepare accordingly.



1. The TTAB's jurisdiction is limited to the question of trade mark registration

The TTAB is an administrative tribunal of the USPTO. It is only empowered to determine the right to register trade marks. 15 USC §§ 1067-68, 1070, 1092. The TTAB has no jurisdiction to determine the right to use a trade mark, nor may it decide broader questions of infringement or unfair competition. *FirstHealth of the Carolinas Inc v CareFirst of Md Inc*, 479 F3d 825 (Fed Cir 2007). Likewise, the TTAB has no authority to issue injunctions, award damages or issue monetary sanctions. 37 CFR § 2120(g). Therefore, a decision at the TTAB will not automatically force the losing party to cease use of a mark.

There are four types of adversarial (generally referred to as *inter partes*) proceedings that come before the TTAB: oppositions, cancellations, interferences, and concurrent use proceedings. Oppositions involve a challenge to a published trade mark application. The most common basis for opposition is that the opposed mark is confusingly similar to an existing mark owned by the opposer.

Cancellations are similar proceedings, brought after a registration has been issued.



The TTAB has no jurisdiction to determine the right to use a trade mark, nor may it decide broader questions of infringement

Interferences and concurrent use proceedings are much rarer. Interferences involve conflicts among owners of conflicting pending applications where the TTAB determines that extraordinary circumstances exist; for example, a complete resolution of the issues would require a series of oppositions, all raising substantially the same issues. See *In re Family Inns of America, Inc*, 180 USPQ 332 (Comm'r Pats 1974).

In a concurrent use proceeding, the TTAB determines whether one or more parties is entitled to a registration with conditions and limitations. These often involve geographic restrictions when each party has made use of the mark in a different geographic area.



2. TTAB proceedings follow the model of US litigation and can generate substantial discovery and trial costs

Adversarial proceedings before the TTAB are similar to civil cases in US federal district courts. The TTAB follows the Federal Rules of Civil Procedure and Evidence, with some minor exceptions. After the case commences, the parties are required to confer regarding discovery and make initial disclosures of relevant information and documents.

They can also engage in written discovery and take discovery depositions. After discovery is completed, a trial period occurs

during which each party may submit the evidence it wants the TTAB to consider. After the parties have entered their complete trial testimony, the parties submit written briefs and may also request oral argument.

Discovery

One of the biggest differences in US practice is the availability of discovery. Each party is entitled to take discovery regarding matters raised in the pleadings as well as any matter that might serve as the basis for an additional claim, defence, or counterclaim. *Neville Chemical Co v Lubrizol Corp*, 183 USPQ 184, 187 (TTAB 1974). Each party has a duty to make a good faith effort to satisfy the discovery needs of its adversary. *Luehrmann v Kwik Kopy Corp*, 2 USPQ2d 1303, 1305 (TTAB 1987). The TTAB can assess non-monetary penalties for failure to participate in discovery. See, eg, *Amazon Technologies Inc v Wax*, 95 USPQ2d 1865, 1869 (TTAB 2010). In exceptional cases, it can order judgment against a party that fails to cooperate in discovery. *Benedict v Superbakery Inc*, 665 F3d 1263, 101 USPQ2d 1089, 1093 (Fed Cir 2011) (entry of judgment warranted in view of repeated failures to comply with reasonable orders of the TTAB and no lesser sanction would be effective), *affg* 96 USPQ2d 1134 (TTAB 2010).

The following written discovery methods are available in TTAB proceedings:

- Interrogatories – Up to 75 written questions (including subparts) to the opposing party. These often include

identifying people with relevant information who may later be deposed and identifying documents that must be provided to the adverse party.

- b. Requests for Documents – Requests to produce documents and other tangible items related to the case. Responsive documents generally include written communications, electronically stored information (eg emails), sales information, customer lists, promotional materials, marketing and business plans, and advertising and product samples.
- c. Requests for Admission – Requests that an adverse party admit certain facts. Each Request is considered admitted unless it is denied in writing within 30 days of service.

Each of these discovery mechanisms requires written responses and/or objections. Discovery may require disclosure of highly confidential information, but that information still must be produced and is protected from dissemination by the TTAB's Standard Protective Order (37 CFR §2.116(g)).

In addition, each party may take up to 10 discovery depositions in which a witness is examined under oath before a court reporter. Witnesses may include parties or non-parties with evidence relevant to the proceeding. Typically, a party can expect its key employees with knowledge about the development and marketing of the product



Parties can simplify the presentation of evidence by stipulating to uncontested facts and agreeing to use witness affidavits and declarations

associated with the mark to be deposed.

Motions

Motion practice is another way in which US proceedings differ from most other countries. Parties requesting specific procedural or substantive relief can file written motions. TTAB procedures allow consideration of almost all motions allowed under the Federal Rules of Civil Procedure. These arise most often during discovery disputes where a party moves to compel discovery responses from a non-cooperative opponent or, alternately, a party moves for a protective order to prevent unduly burdensome discovery. In addition, the TTAB frequently rules on Motions for Summary Judgment, in which a party asserts that there are no factual disputes in the case, and it is entitled to judgment as a matter of law.

Trial

The TTAB does not hear live witnesses in trial. Instead, each party takes trial depositions (which are separate from discovery depositions), under oath and subject to cross-examination, of witnesses and submits the transcripts and associated exhibits to the TTAB as evidence. Much like a live trial, testimony in trial depositions must comply with the Federal Rules of Evidence. Parties may also file Notices of Reliance to admit certain types of documents, such as official records and printed publications.

After all evidence has been submitted, each party files written briefs with the TTAB. The brief cannot introduce new evidence; it must rely solely on evidence that has been submitted in the trial phase. A panel of three TTAB members reviews the written record, briefs and hears oral argument (if any) before issuing a written decision. A decision from the TTAB can take as much as seven months from the close of briefing to be issued.



3. The outcome of TTAB cases can affect subsequent litigation between the same parties

Although the TTAB does not have the power to decide trade mark infringement cases, the US Supreme Court recently ruled that TTAB decisions in oppositions can have preclusive effect on the issue of confusion in subsequent District Court litigation. *B&B Hardware Inc v Hargis Industries Inc*, No 13-352, 575 US ___, 2015 WL 1291915 (March 24, 2015).

In *B&B Hardware*, the parties engaged in opposition proceedings, and the TTAB refused registration on the basis of confusion. In subsequent trade mark infringement litigation, the Plaintiff argued that the Defendant could not contest the likelihood of confusion finding because the TTAB had issued a final decision, which the Defendant did not appeal. The Supreme Court agreed and held that the Defendant could not challenge the finding on likelihood of confusion.

B&B Hardware is so recent that its effect on subsequent litigation has not been tested. However, as trial courts apply the decision, it could have substantial implications, particularly in the area of preliminary injunctions.

Plaintiffs in trade mark cases may request that a trial court issue a preliminary injunction prohibiting the defendant from using the disputed mark pending the outcome of the case. A plaintiff seeking preliminary injunction must demonstrate “that he is likely to succeed on the merits, that he is likely to suffer irreparable harm in the absence of preliminary relief, that the balance of equities tips in his favor, and that an injunction is in the public interest.” *Winter v Nat'l Resources Defense Council*, 555 US 7, 20 (2008). The TTAB finding of confusion

is binding on the federal trial court, so it should be sufficient to establish the likelihood of success on the merits. Moreover, many US courts traditionally presume that the existence of a likelihood of confusion is proof of irreparable harm. Although this presumption is no longer uniformly applied, it is still the law in many jurisdictions. Therefore, a TTAB finding of likelihood of confusion may give a plaintiff the ability to obtain an injunction from the trial court without significant additional proof.



4. The parties can agree to a streamlined process to control costs and receive a faster decision

Although TTAB proceedings have the potential to be long and expensive, the Accelerated Case Resolution (ACR) procedure allows parties to streamline their case and receive a faster decision. Where the parties agree that resolution of the case does not require extensive discovery and trial periods, they can submit a stipulation to use ACR. The ACR stipulation will set out an expedited and relatively contained discovery and trial schedule. Moreover, the parties can also simplify the presentation of evidence by stipulating to uncontested facts and agreeing to use witness affidavits and declarations in lieu of deposition testimony. The parties submit the documentary evidence with their briefs, and the TTAB issues a final decision within 50 days.

ACR is not suitable for every case. Proceedings requiring substantial discovery, factual disputes, or contested evidence are better handled through the standard TTAB process. However, if the parties anticipate stipulating to many facts or relying on one or two witnesses and a relatively minimal record, they

should consider ACR. Counsel should review potential TTAB disputes closely to determine if ACR is an appropriate mechanism.



5. There are two distinct mechanisms to appeal TTAB decisions

The TTAB's decisions may be appealed to the US Court of Appeals for the Federal Circuit or by initiating a proceeding in a federal district court.

The Federal Circuit is an appellate court that hears appeals from certain federal administrative agencies (including the USPTO) as well as cases involving specific subject matter, including patents. An appeal to the Federal Circuit is taken on the existing TTAB trial record. 15 USC § 1071(a)(4). The TTAB decision will be upheld unless it is not supported by substantial evidence. *Recot Inc v Becton*, 214 F3d 1322, 1327 (Fed Cir 2000).

In contrast, the district court option offers a more expansive review. The parties may take additional discovery and introduce additional testimony and evidence. 15 USC § 1071(b)(3). The district court reviews all the evidence without deference to the TTAB's finding. *Swatch AG v Beehive Wholesale, LLC*, 739 F3d 150, 155 (4th Cir 2014). Moreover, the dispute can be expanded to include claims of infringement and unfair competition – to the extent permitted under the Federal Rules of Civil Procedure. *Id.*

EFFECTIVE AVENUE

The TTAB process can be difficult to navigate for parties who are used to adversarial matters in other

TTAB: IMPORTANT CONSIDERATIONS

- ☆ It may require more resources than venues in other countries.
- ☆ You will need to anticipate discovery and prepare for it.
- ☆ Consider the binding nature of the proceedings. Will this be an issue later on?
- ☆ Do you have clear goals and reasonable expectations?

countries. However, once the differences in procedure are understood, TTAB cases can be managed more effectively.

Parties should recognise that involvement in any TTAB case will require more resources than corresponding cases in other countries and should adjust their strategy, expectations and budgets accordingly. They should anticipate discovery and identify key documents and other information requiring disclosure. They should establish a case management plan to develop evidence that can be used at trial. Likewise, they should recognise that the findings at the TTAB could bind them in later proceedings and consider whether the TTAB is the best forum for adjudicating the dispute.

If settlement is a serious consideration, this should be addressed early, and the parties should consider suspending the case to allow for negotiations.

Most importantly, parties should clearly identify the goals of the proceedings and develop reasonable expectations of the outcome and a suitable strategy. ■



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A B B A A D

F A A I T T H

B R E A K E

T H R O U G H

Ireland's High Court has at last provided a set of principles for an ambiguous legal concept. Alistair Payne elaborates



he assessment of bad faith has not been defined in legislation and is necessarily a subjective matter based on inferences

drawn from the particular factual circumstances. The classical formulation comes from *Gromax Plasticulture Limited v Don & Low Nonwovens Limited* [1999] RPC 367, in which the English and Welsh High Court noted that, apart from dishonesty, bad faith includes dealings that fall short of standards of acceptable commercial behaviour.

More recently, in *Marie Claire Netherlands BV v Controller of Patents, Designs and Trade Marks, Marie Claire SA and Brandwell (Irl) Limited* [2013 No 582Sp], 1 April 2014, the Irish High Court reversed the Controller's decision as to bad faith, in spite of the fact the parties did not appear to be business competitors, and even though it upheld the opposition on the basis of the Opponents' demonstration of prior goodwill, which it found to be protectable under the law of passing off.

The point of interest in this case for practitioners is that, in giving its decision, the Court made a rare judicial consideration of what amounts to an application for the registration of a trade mark made in bad faith, and distilled this into a set of principles based on previous case law.

MARIE CLAIRE FACTS

In 1993, Brandwell applied to register the trade mark MARIE CLAIRE in Ireland in class 25. (Brandwell had been importing hosiery, lingerie and swimwear products bearing the MARIE CLAIRE trade mark since 1992 from a Spanish-based predecessor of Marie Claire SA.) The application was opposed by way of two separate opposition proceedings. In 1997, while these oppositions were still pending, one of the Opponents made an application for the same mark also in class 25 for "clothing, headgear" (the

application was subsequently assigned to Marie Claire BV – that is, the Marie Claire magazine group). Marie Claire SA and Brandwell (the Opponents) opposed this application at the Irish Patents Office on the basis that: (i) it was made in bad faith; (ii) use of the MARIE CLAIRE mark by Marie Claire BV would amount to passing off of the goodwill and reputation attaching to the MARIE CLAIRE mark owned by Marie Claire SA; and (iii) Marie Claire BV had no intention to use the mark at the time of the application. The opposition by the Opponents was upheld on the grounds of bad faith and passing off.

The decision of the Patents Office was appealed by Marie Claire BV to



The concept of bad faith is subjective and neither the relevant European nor Irish legislation offers a definition

the Commercial Court, a division of the High Court of Ireland that deals, in particular, with IP cases. The Commercial Court dealt with the appeal by way of rehearing the opposition. Therefore, the grounds of opposition before the Court were that: (i) the application was made in bad faith; (ii) there was no bona fide intention to use the mark by the Applicant; and (iii) the application was liable to be prevented in Ireland by the law of passing off.

BAD FAITH DIFFICULTY

Allegations of bad faith are rarely alleged and difficult to prove. The concept of bad faith is subjective and neither the relevant European

nor Irish legislation offers a definition.

In this case, the Opponents argued that the application by Marie Claire BV to register the mark MARIE CLAIRE was tainted by bad faith because: (i) at the time of the application, Marie Claire BV was fully aware that the mark MARIE CLAIRE was not free for use in Ireland (it was used by Brandwell with the permission of Marie Claire SA), and (ii) Marie Claire BV was making the application for the purpose of preventing the registration in Ireland of the trade mark that was the subject of Brandwell's earlier application in 1993.

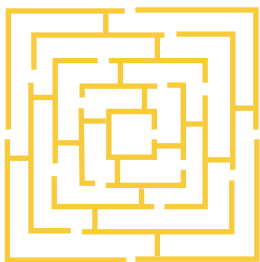
This judgment reviews the relevant cases, including *Chocoladefabriken Lindt*¹, *Hotel Cipriani*² and *Rautaruukki*³, and identifies a range of 18 principles that have emerged from the courts in Ireland, the UK and Europe:

1. Bad faith includes dishonesty;
2. Bad faith includes dealings that fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced people in a particular area;
3. A relevant factor in determining whether there is bad faith is whether there has been a failure by the person against whom a charge is levelled to address that charge;
4. Awareness that a party has been using an identical or similar mark for an identical or similar product in a least one EU Member State is not per se conclusive as to bad faith;
5. Consideration must be given to an applicant's intention at the time of filing an application for registration; intention to prevent a party from marketing a product may be an element of bad faith;
6. A key issue is whether a mark is being used for its essential purpose: to aid consumers in distinguishing products;
7. The fact that a third party has long used a sign for an identical or similar

1) C-529/07.

2) [2008] EWHC 3032.

3) [2012] EWHC 2920.



An allegation of bad faith is a serious allegation that must be proved by cogent evidence on the balance of probabilities

product capable of being confused with the mark applied for and that such a sign enjoys some level of legal protection is a relevant factor when determining whether an applicant has acted in bad faith;

8. A person is presumed to have acted in good faith unless the contrary is proved;
9. An allegation of bad faith is a serious allegation that must be proved by cogent evidence on the balance of probabilities;
10. It is not enough when seeking to establish bad faith to prove facts that are also consistent with good faith;
11. Where a third party cannot maintain a relative ground of objection to registration, bad faith involves some breach of legal or moral obligation by the applicant towards the third party;
12. Bad faith may exist where an applicant has sought or obtained registration of a trade mark for use as an instrument of extortion;
13. Bad faith is not pertinent in a situation where there is a bona fide conflict between the trade mark rights, or perceived rights, of different traders;
14. It is not bad faith for a party to seek a trade mark where third parties are using similar marks and/or are using them for similar goods or services;
15. The fact that one party is aware of and has previously clashed with another is not the same as saying the trade mark application by one of those parties is made in bad faith;
16. Seeking to protect one's commercial interests where one considers that one's activities do not impinge on the core activity of another is not bad faith;
17. Bad faith is the opposite of good faith; it generally involves (but is not limited to) actual or constructive fraud; it may merely involve a design to mislead or deceive or some other sinister motive; and
18. In determining whether there is bad faith, knowledge of third-party use, an intention to prevent a third party

marketing a product and the lack of intention to use a trade mark, as well as the extent of the reputation of the third party's sign at the time of the application, are all relevant.

MARIE CLAIRE CONCLUSION

The Judge concluded that the application by Marie Claire BV to register the mark MARIE CLAIRE was not tainted by bad faith. Instead, it was an "honest application by Marie Claire Netherlands to register a genuinely disputed mark". Accordingly, he overturned the decision of the Controller that Marie Claire BV had acted in bad faith, on the basis that it had made the application with knowledge and for the purpose of damaging the Applicant's business.

It is difficult to reconcile the differing conclusions of the Hearing Officer acting for the Controller and the High Court on the same facts, and in light of the circumstance that Marie Claire BV's application was for clothing and headgear in class 25 but that it had never had a business under the mark in relation to these goods and was not in competition with Marie Claire SA. Considering the High Court's findings in relation to prior user, goodwill and passing off, this finding is all the more surprising, even if the ultimate outcome of the opposition was the same.

INTENTION TO USE

The Irish Trade Marks Act requires the applicant for a trade mark to state that the mark is being used or that there is a bona fide intention

to use it. The Court characterised this as "a procedural requirement, not a substantive ground of objection" but did not expand upon its reasoning for this surprising conclusion. In any event, it found there was no evidence before it of the absence of a bona fide intention to use the mark and rejected this ground of opposition.

PASSING OFF

In a relatively straightforward application of the three-part test for passing off, the Judge was satisfied that, through the substantial sales and promotion of their products in Ireland since 1992, the Opponents had developed the requisite goodwill attaching to the mark MARIE CLAIRE.

The Judge went on to find that the use of the MARIE CLAIRE mark by Marie Claire BV would lead members of the trade or general public to conclude, erroneously, that Marie Claire BV's goods were those of Marie Claire SA, or that there was at least some association with Marie Claire SA. This misrepresentation by Marie Claire BV would damage the goodwill of the Opponents. Accordingly, passing off was made out. The Judge upheld the opposition and refused Marie Claire BV's application to register MARIE CLAIRE as a trade mark.

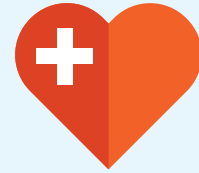
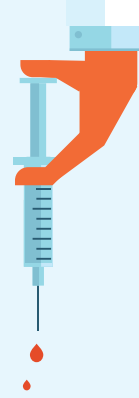
Marie Claire BV was denied leave to appeal the judgment to the Supreme Court of Ireland. ■

Note: this article is based on an unapproved version of the judgment, as was available at the time of writing.



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Bad blood

Chris Morris considers a charity application that has returned to the Registry

THIS CASE CONCERNS an appeal against the rejection of a UK application to register BEATING BLOOD CANCERS under Section 3(1)(b) of the Trade Marks Act 1994. The Applicant charity, Leukaemia and Lymphoma Research (LLR), asked the Appointed Person (AP) to overturn the decision or remit it to the Registry for further consideration. The AP agreed the case should be returned to the Registry.

ORIGINAL DECISION

The mark was applied for in 10 classes and originally accepted for a limited specification. LLR requested a hearing, but the Hearing Officer decided that the examiner had been too lenient, and refused the application entirely. The Hearing Officer stated that if a sign is “unpossessed of distinctive character” then an objection will arise, even if it doesn’t designate a particular characteristic or even vaguely reference the goods and services applied for. As regards the phrase involved, the Hearing Officer opined that: “the words express a laudable medical objective and nothing more”, so that consequently it is “hard to see exactly what about it as a whole could ever conceivably perform the essential function of a trade mark”.

Even where there is a lack of an obvious connection between the phrase and the goods and services, a phrase may not function as a trade mark. The Hearing Officer drew a distinction between a charity’s name (eg OXFAM), which could indicate origin, and the sign at issue, which merely makes a link to an objective, not to a particular charity.

Likewise in the case of services, the laudable aim would be seen as part of a company’s corporate responsibility efforts.



The appeal claimed that the Hearing Officer should have taken into account different average consumers for goods and services

APPEAL

The appeal claimed that the Hearing Officer should have taken into account different average consumers for different goods and services and the levels of distinctive character BEATING BLOOD CANCERS would have for different goods and services.

While rejecting the argument that the Hearing Officer had failed to take proper account of the correct average consumer for each part of the specification, the AP did take issue with how the Hearing Officer decided whether the mark was objectionable for different categories of goods and services, saying that it is “plainly a

practical approach” to apply generalised reasoning for refusing a category or group of goods and services, rather than specific reasons for each individual item, but general reasoning can go too far. While concurring with the Hearing Officer’s view that the sign “is liable to be seen in some, possibly in many, contexts as no more than an origin-neutral, laudatory phrase”, the AP said “signs which cannot operate as a mark of origin at all without ‘educating the public’ are relatively rare”.

Following Audi, the fact a sign is “promotional” is not sufficient to find it devoid of distinctiveness. The Hearing Officer went too far in saying BEATING BLOOD CANCERS could not operate as a trade mark, without examining the goods and services applied for “individually or in coherent categories”.

WHAT NEXT?

The parties asked for appropriate guidance for reconsidering the application. The AP suggested LLR identifies a discrete series of sub-categories for consideration by the Registry and detail which category each item applied for fell into, as a basis for further discussion. The case usefully reminds us that registrability must be considered alongside all goods and services applied for, not at a more general level.



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A vintage victory

Fast action by the rights owner provided for protection of a premium brand, writes Oliver Tidman

THE HIGH COURT of Justice has decided in favour of luxury champagne house Champagne Louis Roederer (Roederer) in its trade mark infringement claim against the use of the sign CRISTALINO by J Garcia Carrion SA (JGC) for Spanish cava.

Roederer produces a number of brands of champagne, but one of the best-known is Cristal. Cristal was initially made for the exclusive consumption of Tsar Nicholas II, who hoped that the clear, flat bottoms of the bottles would help to detect whether any poison or explosives had been inserted into the bottle. It has been sold internationally since the fall of the Russian monarchy in 1917. The mark CRISTAL is registered to Roederer in the UK in respect of champagne wines and as a Community Trade Mark (CTM) in respect of wines, sparkling wines, and wines of French origin with the designation champagne. JGC is a large producer of sparkling wine and also registered proprietor of a UK trade mark and CTM for CRISTALINO JAUME SERRA in respect of wines and sparkling wines.

Roederer sought to prevent the sale of JGC's brand of cava, which was launched in the UK under the mark CRISTALINO, and retailed in supermarkets for about £5 per bottle. Roederer brought proceedings for trade mark infringement on the basis of a likelihood of confusion and on the basis of its reputation, alleging tarnishment, unfair advantage (free-riding) and detriment to distinctive

character and repute. The claim was also issued against UK supermarkets ASDA and Morrisons, which quickly settled with Roederer and subsequently withdrew sales.

In relation to Roederer's likelihood of confusion argument, JGC argued that it did not use the sign CRISTALINO in isolation, but rather together with the additional JUAME SERRA element. However, the Court dismissed this claim, finding multiple instances in which the CRISTALINO part of JGC's mark either appeared on its own or was emphasised in some way. Accordingly, the Court was satisfied that it was comparing the marks CRISTAL and CRISTALINO.

REPUTATION

Roederer commissioned a number of surveys in order to establish that CRISTAL has a reputation in the UK. This survey evidence was crucial as, despite the fact that only around 40,000 bottles of CRISTAL are sold in the UK each year, Mrs Justice Rose found that CRISTAL enjoys a substantial reputation among wine connoisseurs. This reputation extends to celebrities and into popular culture, as Cristal has appeared in hip-hop lyrics and featured in music videos. The decision cites a *Daily Mail* article that stated that: "... in the rap world, to be seen drinking Cristal signified that you had arrived, you were a 'playa' ... The practice has found its way to London – most notably in Mo'Vida. It was from here that reports emerged of a French investment banker spending £41,000 on Cristal in one night." The Judge placed particular significance on the results of a survey which demonstrated that 14 per cent of unprompted respondents recognised the word

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The Court did not go so far as to say that use of a similar trade mark on cava constituted tarnishment, as that could imply that cheaper products would always cause tarnishment



CRISTAL as a brand of champagne. This was deemed to be significant considering that most respondents were unlikely to have ever bought or tasted the champagne. Consequently, Rose J concluded that Cristal had a strong reputation in the UK.

DECISION

The Court held that the marks were visually, phonetically and conceptually similar and therefore found that JGC infringed Roederer's trade marks on the grounds that:

- there was a likelihood of confusion between the marks because CRISTALINO was similar to CRISTAL and the goods were identical in the case of the CTM (because Roederer's CTM covered sparkling wine) and similar in the case of the UK trade mark, under Article 9(1) of Council Regulation (EC) No 207/2009 (CTMR) and Section 10(2) of the Trade Marks Act 1994 (TMA) respectively;
- the CRISTAL mark has a reputation in the UK/EU and use of the CRISTALINO mark took unfair advantage and was detrimental to the distinctive character and repute of the CRISTAL mark. The Court accepted Roederer's arguments that use of the CRISTALINO mark diluted the CRISTAL mark, particularly as the former mark was used for inexpensive cava and therefore could damage the prestigious nature of the CRISTAL mark.

The Court held that the lack of actual confusion was not an issue, but also mentioned that indirect confusion could have arisen with the sale of more "second wine" (a more affordable wine produced by a winemaker alongside its premium

brand and sometimes with a related, diminutive brand name) from the champagne houses. Furthermore, the use in the UK of the composite mark CRISTALINO JUAME SERRA with CRISTALINO used in a larger font did give rise to a likelihood of confusion.

With regards to tarnishment, the Court did not go so far as to say that use of a similar trade mark on cava constituted tarnishment, as that could imply that cheaper products would always cause tarnishment. However, it did conclude that CRISTALINO was free-riding on the reputation of CRISTAL based on examples from social media where consumers had bought CRISTALINO and had jokingly made reference to CRISTAL, giving the inference that CRISTALINO was in effect a "poor man's CRISTAL". The Court held that there had been a change in the behaviour of cava buyers, who had opted for the CRISTALINO brand because they felt it had an affinity with CRISTAL.

In addition to the findings of infringement, Roederer succeeded in invalidating JGC's UK trade mark and CTM for CRISTALINO JAUME SERRA on the basis of earlier registrations.

DECISIVE ACTION

Although the outcome in this case is perhaps not surprising, the decision

is important for brand owners in the fight against copycat brands because it underlines the need to act quickly in the face of a potential infringement, even where a product may only have limited circulation.

The case also confirms that actual confusion does not have to be proved. Finally, it is also worth noting that survey evidence played a key role in supporting the reputation claimed despite JGC not putting forward arguments to the Court.

The Roederer CRISTAL bottle



The CRISTALINO bottles

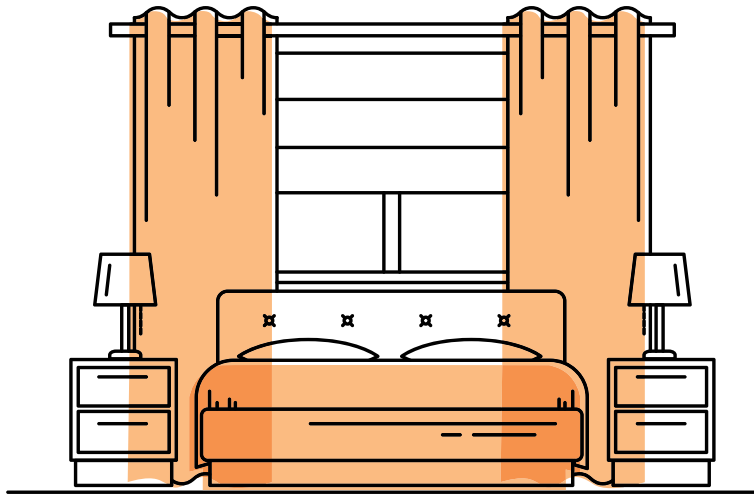


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Linen case ironed out

Nick Bowie reviews the wrinkles that arose in this copyright dispute

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THE CLAIMANT, T&A Textiles and Hosiery Ltd, brought an action for infringement of copyright in several artistic works and for infringement of UK registered design No 4010499 against Hala Textile UK Ltd, Mr Abdul Hadi Shehezad and Mr Irfan Ahmad.

The copyright claim focused on 11 distinct bed-linen products sold by Hala, which were said to infringe copyright with respect to 11 original artistic works created by Mr Aslam, Director and employee of the Claimant. The evidence at trial concentrated on two works in particular: those referred to as “Chantilly” and “Manhattan” by the Claimant. The Defendants’ alleged infringing products

with respect to these were called “Richmond” and “Stephanie” respectively.

The registered design infringement claim centred on the label for packaging and it was accepted by the Defendants at trial that if the design registration was registered validly, it was infringed. However, the Defendants challenged the validity of the registration on the

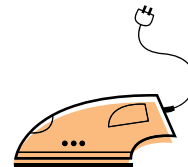
grounds of two prior uses, one of which was made by the Defendants five years before the Claimants’ design registration date of 10 March 2009.

In addition to the invalidity counterclaim, the Defendants included a claim of groundless threats of infringement proceedings relating to the registered design. The claims of unjustified threats were categorised into: (a) threats issued to third-party companies (including, in particular, Designer Textiles and Nice Carpets); and (b) correspondence between the Claimant and eBay.

At the case management conference held before HHJ Hacon on 5 March 2015, the Claimant was given permission to submit one witness statement of fact, and the Defendants were given permission to submit three witness statements of fact.

The Defendants submitted four statements of fact, including that of Mr Muhammed Amin – who claimed to have designed the infringing products. After Mr Douglas Campbell (sitting as Deputy High Court Judge of IPEC) directed the Defendants that one of the four witness statements submitted must be excluded, the Defendants dropped that of Mr Ahtram-Ul-Haq, the partner owner of Imperial Packaging.

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The Defendants included a claim of threats of infringement proceedings”



EXTRA EVIDENCE

Six months after the conference, both parties applied to serve extra evidence; neither opposed the other's application. The first category of evidence (conventional reply evidence that was permitted by HHJ Hacon) was admitted. The second category of evidence was a video in which Mr Amin alleged that Mr Aslam had visited him in Pakistan and offered cash incentives to sign documents, threatening Mr Amin when he refused to sign. Engaging Part 63.23(2) of the Civil Procedure Rules (CPR), Mr Campbell permitted both parties to rely on this evidence on the grounds that: (a) both parties considered the evidence was important to their respective cases; and (b) serious allegations had been levelled by both parties against one another.

The third category of evidence was expert evidence which the Defendants sought to adduce in relation to electronic files of the artistic works relied upon by the Claimant. Again, Part 63.23(2) was engaged but, in the absence of exceptional circumstances, Mr Campbell refused permission.

Neither party disputed the law in this case. Both sides agreed that the works in question were to be treated as artistic works as per Section 4, Copyright, Designs and Patents Act 1988. Further, both sides approached the issue of infringement on the basis that all 11 works stood or fell together.

TRIAL EXPERIENCE

At trial, the core witnesses were Mr Aslam, Director and employee of the Claimant, and Mr Shehezad, Second Defendant and Director of the First Defendant.

Mr Aslam submitted various creation dates for the bedding designs relied on in this action (his Manhattan drawing was created on 6 March 2012 and Chantilly on 11 January 2010). Regarding the Manhattan design, during cross-examination Mr Aslam confirmed that he had been inspired by a friend's table linen and, subsequently, obtained an image from a photograph library and used that to create a drawing in

Photoshop. He did not state what changes he had made to the library image. "Most" of the other drawings had been created from Mr Aslam's own drawings.

Accordingly, and absent any argument to the contrary by the Defendants, Mr Campbell held that all drawings other than the Manhattan were original works.

As an aside, the creation dates of electronic copies of the drawings submitted in support of Mr Aslam's witness statement did not correlate to the dates pleaded. Mr Campbell held that the discrepancies were most



The Defendants argued they had sold the products alleged to infringe prior to the dates given for creation

likely due to computer error rather than fabrication of evidence.

The Defendants' key argument was that they had sold the particular products alleged to infringe, in the UK, prior to the dates given by the Claimant for creation of its designs. Accordingly, there could be no copyright infringement and the Claimant's UK registered design must be invalid.

As part of Mr Shehezad's evidence, several invoices, packaging lists, and delivery notes were submitted in relation to its Richmond and Stephanie designs. The Defendants also provided a schedule of all other alleged infringing products, from which it could be seen that they were shipped to the UK before the creation dates of the Claimant's designs.

Mr Shehezad was subjected to a very limited degree of challenge at

trial, though the Claimant raised criticisms of this evidence a week after trial. Given that the written submissions were filed far too late, Mr Campbell could not accept the submissions and, therefore, accepted Mr Shehezad's evidence that all of the products complained of had been shipped to the UK before the creation dates of the Claimant's designs.

Accordingly, the allegation of copying was rejected, as was the allegation of copyright infringement.

As regards the allegations of registered design infringement, Mr Shehezad had signed a Statement of Truth on the Grounds of Invalidity alleging that the First Defendant's own packaging formed part of the state of the art in that it had "been made available, and has remained unchanged since ... around 2004". Neither this statement nor the supporting evidence was challenged by the Claimant. Accordingly, Mr Campbell held that the registered design was invalid.

Further, the threats action succeeded in relation to the letters sent to Designer Textiles and Nice Carpets. Further, while the initial take-down notice sent to eBay by the Claimant did not constitute a threat, a subsequent letter from the Claimant's solicitors alleging infringement and notifying eBay of proceedings did constitute an actionable threat, such that the counterclaim succeeded.

CLOSING THOUGHTS

This case reminds us of the importance of seizing opportunities to cross-examine during the prescribed periods and to adhere to case management conference directions. In addition, the case gives useful guidance on what are considered to be "exceptional circumstances" in the context of Part 63.23(2) CPR, in addition to the interpretation of unjustified threats.



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Decision demonstrates class creep

A large reputation can shelter seemingly unrelated services, says Nick Smee

THE APPLICANT Alexandra Dellmeier sought to register LEXDELL as a Community Trade Mark (CTM) for goods and services in classes 16 (paper, card and other materials), 25 (clothing; footwear and headgear), 41 (provision of training, education and instruction) and 45 (licensing of trade marks and hallmarks – legal services). Relying on its earlier Community figurative mark (shown below), Dell Inc (Dell) successfully opposed the registration based on Articles 8(1)(b) and (5) of Council Regulation (EC) No 207/2009 (CTMR) when the General Court agreed with OHIM’s Opposition Division and Board of Appeal (BoA).

COURT REASONING

According to Article 8(5) CTMR, an application for a CTM can be opposed on the basis of a pre-existing mark which has a reputation in the Community, where use without due cause of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of that mark.

The Court agreed that Dell’s mark had a reputation in the Community, particularly in classes 9, 37, 40 and 42, which relate to computer hardware manufacture, maintenance and consultancy. Survey evidence placed Dell consistently in the most valued brands category and it had a sizeable market share. The Court dismissed the Applicant’s appeal on this issue because she disputed the surveys but failed to address the other evidence.

The Court agreed with the BoA’s finding that there was visual and

conceptual similarity between the marks, and a lower degree of phonetic similarity. The addition of the LEX element did not cancel out the common element DELL.

The General Court upheld the BoA’s verdict that the use of LEXDELL for the services sought in classes 41 and 45 would take unfair advantage of, or be detrimental to the distinctive character or the repute of Dell’s mark. A number of factors contributed to this, including:

- the degree of closeness between “legal services in respect of intellectual property” (part of the services applied for) and the technology which forms the subject matter of the IP for which Dell is known;
- the word LEX is often used to refer to legal services, and the relevant public might therefore understand that LEXDELL referred to the legal arm of Dell.

Further, the facts that: (i) the Applicant succeeded in registering LEXDELL as a national trade mark in Germany in 2001, before Dell’s mark was sought in 2007; and (ii) that LEXDELL was an amalgamation of the Applicant’s forename and surname, did not provide “due cause”. The relevant public would be ignorant of the reasons behind the name; and the earlier national registration could not be used to circumvent the

requirement of Article 8(5) CTMR in respect of the whole of the territory of the EU.

Regarding Article 8(1)(b) CTMR, the BoA had ruled that the goods in classes 16 and 25 for which registration was sought were identical or similar to those protected by Dell’s mark and a likelihood of confusion would result. The Court found the Applicant’s arguments on appeal to be insufficiently intelligible to exercise its power of review. It also dismissed arguments on the absence of similarity between the signs at issue for the same reasons as noted above in the context of Article 8(5).

TECH TEACH

The decision serves as a reminder that, where a business has a very significant reputation, it may successfully object under Article 8(5) to a range of seemingly unrelated services. For businesses in the tech sphere this is particularly pertinent, as technology today supports so many market sectors that until relatively recently were considered unconnected.

The Dell mark



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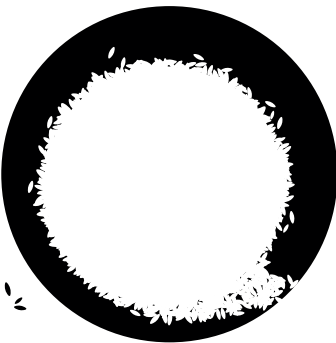
Trainee Eeshma Qazi assisted with this article.

Basmati rice causes a stir

A reversal of opinion asserts Tilda's rights, reports Rupert Bent

THE OPPONENT, Tilda Riceland Private Limited (Tilda), a well-known exporter and manufacturer of Basmati rice, opposed a Community Trade Mark application by Siam Grains Co Ltd (Siam) for the below figurative mark (BASMALI) in 2004. Siam does not sell Basmati rice, but instead is an exporter of Thai rice.

Tilda sought to bring a claim for passing off in the UK and relied on the grounds set out in Article 8(4) of Council Regulation (EC) No 207/2009. It sought to protect the reputation and the goodwill attached to the term Basmati for all Basmati rice



exporters and manufacturers.

In 2008, Tilda's opposition was rejected on the basis that it did not submit the required evidence to show how the company exported and marketed Basmati rice in the UK. Tilda therefore did not prove it had acquired the requisite goodwill in Basmati (the Mark), as required in a passing off action.

Tilda appealed the decision but, in 2009, the First Board of Appeal of OHIM dismissed the appeal. The

Board of Appeal questioned Tilda's ownership of the Mark and also the mark's generic features. It explained that as Tilda wanted to bring a passing off argument in the framework of Article 8(4), it would have to show both ownership of the goodwill and ownership of the Mark.

REALLOCATION

In 2012, the General Court annulled the Board of Appeal's decision on the basis that it had "erred in rejecting the opposition on the ground that the applicant had not proved that it was proprietor of the sign ... without analysing specifically whether the applicant had acquired rights over that sign in accordance with the law of the UK".

The case was therefore reallocated to the Fourth Board of Appeal. Here Tilda argued that it had established goodwill in its passing off action as the First Board of Appeal had not doubted its ownership, but merely came to the incorrect conclusion that ownership in the goodwill was not sufficient because Tilda was not deemed to be the proprietor of the Mark. However, the Fourth Board of Appeal applied the test in *Advocaat* and concluded that Tilda had not provided adequate proof that its use of the Mark resulted in the public identifying its economic activity with

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The Court concluded the Mark could be classified as distinctive 'if it serves to identify certain goods or services in relation to other similar goods or services'”

the Mark. It also stated that Tilda had not evidenced the Mark as being distinctive. Tilda merely showed that the individuals interviewed knew the name Basmati or that the rice exists.

RE-EVALUATION

Just when a verdict was thought to have been reached, the General Court (Sixth Chamber) annulled the above decision. The Court concluded that the Mark could be classified as distinctive "if it serves to identify certain goods or services in relation to other similar goods or services".

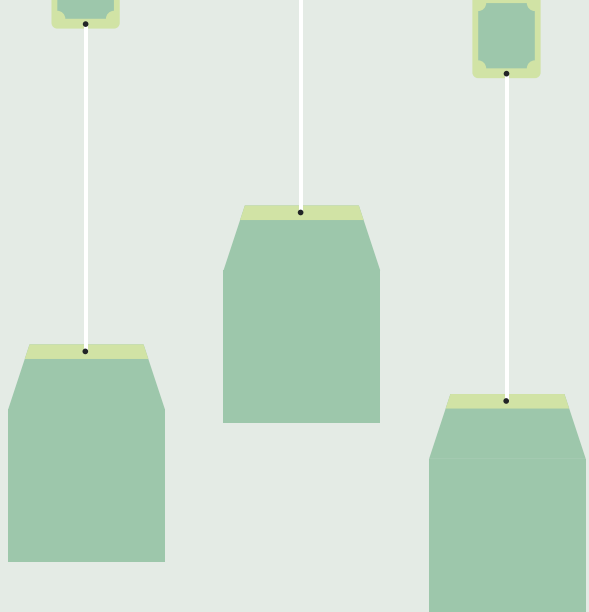
The Court referenced *Chocosuisse Union Des Fabricants Suisses de Chocolat & Ors v Cadbury Ltd* [1999] EWCA Civ 856 and explained that the "extended" form of passing off allows numerous traders to have rights over a sign that has acquired a reputation in the market. Therefore, the fact that the Mark is used by other suppliers and manufacturers does not mean that Tilda cannot claim proprietorship over it.

The Siam mark



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Take two for tea case

Bex Heard explains why a reputation case requires another look

DELTA LINGERIE FILED Community Trade Mark (CTM) applications for four DARJEELING formative marks in classes 25, 35 and 38, which were opposed by The Tea Board, the proprietor of two collective marks registered for “tea” in class 30. One of these marks was for the word DARJEELING, the other a figurative mark including that word.

The opposition was based on Articles 8(1)(b) and 8(5) Council Regulation (EC) No 207/2009 (CTMR). The Tea Board had been unsuccessful before the Opposition Division and the Board of Appeal (BoA). Unsurprisingly, the BoA held that the goods and services applied for were not similar to “tea” and the opposition under Article 8(1)(b) failed. On appeal, the Court agreed, notwithstanding the fact that the earlier collective marks were registered as marks designating the geographical origin of a product. The Tea Board had argued that the goods/services being compared must be similar simply because they could have the same geographical origin; this argument was not successful.

In relation to Article 8(5), the Opposition Division had held that The Tea Board did not provide sufficient indications concerning volume of sales, market share or the extent of promotion of the earlier marks and, therefore, had not demonstrated a reputation in them. However, the BoA had not decided whether the marks had reputations, and if so to what degree, but rather proceeded upon the assumption that the marks’ reputations were “exceptionally high”.

The BoA also did not determine whether there was a link between the signs at issue, and proceeded to assume there was. The General Court found that proceeding hypothetically on these issues was an error, and the BoA needed to determine these.

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The BoA had not decided whether the marks had reputations but proceeded upon the assumption their reputations were ‘exceptionally high’

Under Article 8(5), The Tea Board needed to show that use without due cause of the applied-for mark would be: (i) detrimental to the distinctive character; or (ii) detrimental to the reputation of the earlier mark; or that use without due cause would (iii) take advantage of the earlier mark’s reputation. The Court agreed with the BoA that on the first two

points there was insufficient evidence to support The Tea Board’s case.

With respect to taking advantage, however, the Court found that if, as the BoA had assumed, the earlier mark had an “exceptional” reputation, the reputation might be transferred to some of the class 25 goods applied for (as well as for some of the retail services relating to goods in class 25). Consequently, the opposed mark’s power of attraction would be strengthened. The BoA’s decision denying this could thus not be supported.

The General Court remitted the case to the BoA to determine whether The Tea Board’s mark had a reputation, and if so to what degree. Then, it needs to determine if that reputation could be transferred to the opposed mark if it were used without due cause.

This judgment makes it clear that the essential function of a collective mark is the same as for ordinary marks; while the case law in some areas is different, it is not because they have a different function. As with any other mark, for example to demonstrate a reputation in a collective mark, substantial amounts of evidence may be needed, and care should be taken to ensure evidence before the tribunal is sufficient.



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Professional Support Officer **Philip Davies** assisted with this article.

Cheese choice

Recent rejection of marks related to a crucial Cypriot product is unlikely to be the last word, reports Désirée Fields

IN FEBRUARY 2013, the Republic of Cyprus filed two Community Trade Mark (CTM) applications for the word signs HALLOUMI and XΑΛΛΟΥΜΙ. Protection was sought in respect of “cheese; milk and milk products” in class 29.

LACK OF DISTINCTION

The OHIM examiner rejected both applications on the grounds that the signs were devoid of distinctive character and descriptive of the goods and services applied for in accordance with Articles 7(1)(b) and 7(1)(c) of Council Regulation (EC) No 207/2009 (CTMR). OHIM’s Board of Appeal (BoA) upheld the examiner’s decision, finding that the marks applied for referred to a speciality cheese from Cyprus and therefore described, at least for the Cypriot public, the kind and geographical origin of the goods. The signs were therefore necessarily found to be devoid of distinctive character.

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The Board of Appeal found that the marks applied for referred to a speciality cheese from Cyprus and therefore described the kind and geographical origin of the goods

Cyprus appealed the decision to the General Court, which upheld OHIM’s decision to refuse registration of the signs, holding that the BoA had been correct in assessing the signs in relation to the Cypriot public alone and that the signs referred to a speciality cheese from Cyprus and were consequently descriptive of the goods applied for. The fact that the Court had acknowledged in HELLIM (Case T-534/10) that the Community collective mark HALLOUMI had a weak distinctive character was insufficient to counteract the descriptiveness of the mark. The same reasoning applied to the sign XΑΛΛΟΥΜΙ.

The Court rejected the argument that the CTMR allowed for the registration of certification marks. Rather, certification marks could be registered as individual trade marks as long as they were not in conflict with one of the absolute grounds for refusal listed in Article 7(1). Cyprus argued that it had since 1992 owned two national certification marks for the identical word signs HALLOUMI and XΑΛΛΟΥΜΙ. Agreeing with the BoA, the Court found that, even if Cypriot consumers had for several years been perceiving the signs at issue as certification marks guaranteeing compliance with a specific set of legal requirements,

that perception did not affect the descriptive character of the marks for those consumers or other consumers, who did not make the connection with the certification mark.

COMMENT

Halloumi is one of Cyprus’s biggest overseas exports. In July 2014, the Turkish side of Cyprus (where halloumi is known as “hellim”) jointly filed a protected designation of origin (PDO) application with the Greek side of Cyprus in an effort to obtain the same protected status for halloumi that parmesan enjoys, so that only cheese produced in Cyprus could be called halloumi or hellim. The application received a number of objections, including from Britain, which objected on the basis that halloumi is a generic name for a type of cheese. It remains to be seen whether halloumi will obtain PDO status. In any event, Cyprus will probably welcome the introduction of EU certification marks once the revisions to the CTMR have been implemented and might take a stab at applying for an EU certification mark at that point. Given the importance of halloumi to Cyprus’s economy, the rejection of the word signs HALLOUMI and XΑΛΛΟΥΜΙ as CTMs is unlikely to be the last chapter in this story.



Désirée Fields

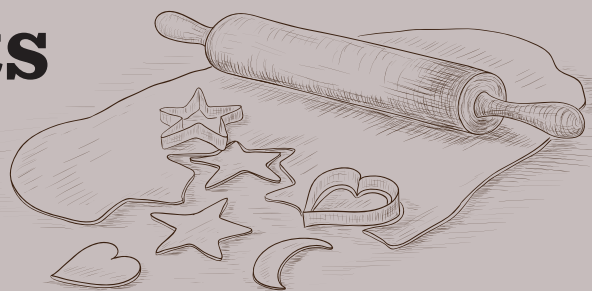
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Désirée’s practice focuses on trade marks and brand protection.

Smiley suggests further study

Katie Goulding questions the thinking behind a Court contention



THE CJEU PARTIALLY annulled three decisions of the OHIM Board of Appeal (BoA) to reject The Smiley Company's applications to register as three-dimensional trade marks: (i) the shape of a face with horns, (ii) the shape of a face with a hat or halo and (iii) the shape of a face in the form of a star, in respect of foodstuffs in classes 29 and 30.

The initial objection under Article 7(1)(b) CTMR was raised in respect of "jellies; preserved frozen, dried and cooked fruits and vegetables; milk products; preparations made from cereals; pastry and confectionery; ices" and maintained by the BoA. It was reasoned that:

- the marks do not depart significantly from the norms/customs of the sector;
- there is no distinctive feature that would enable the signs to function as indicators of origin without additional branding. Faces are especially popular decorative elements;
- these are goods which are selected and purchased quickly and with no great attention to detail;
- a decision cannot be reached on the basis of previous practice and so the 2,071 registered CTMs consisting of or containing cartoon figures submitted by the Applicant are not relevant;
- the Applicant did not provide evidence that consumers are accustomed to perceiving shapes of this kind as trade marks.

The CJEU annulled the decision in respect of "preserved, frozen, dried and cooked fruits and vegetables; milk products" after a more

considered assessment of the marketplace. It reasoned:

- in order for the BoA to be able to base its analysis on practice experience acquired generally from the marketing of the goods, it would also have been necessary that those facts were likely to be known by anyone or could be learnt from generally accessible sources;
- it is not widely known that these particular goods are offered with a variety of decorative elements, although the fact that they are offered in basic geometrical shapes is;
- milk products in liquid/cream form cannot take such a shape;
- fruit and vegetables are usually packaged and presented in their natural form and without such decoration;
- the exceptional nature of the habits in the sector in presenting these particular goods renders the mark capable of distinguishing the Applicant's goods from those of others despite the fact the average consumer does not generally pay attention to the shape of foodstuffs.

So what, then, of a smiley face with heart-shaped eyes? Well, it shouldn't go without mention that less than one month after the examination reports on the first three applications were issued, a fourth for this shape was rejected only in respect of "preparations made from cereals; bread, pastry and confectionery" and upheld on appeal (Case T-656/13) but was not rejected for jellies and ices as was the case in the first three applications. What about the fact jellies and ice lollies are, according to examiner number one, products consumers are used to seeing in a variety of shapes and decorations?

Regarding assessment of the 3D trade marks there is nothing especially controversial about the decision here, but one continues to question the accuracy of the contention that consumers are unlikely to pay attention to the shape of products or to make a choice solely on the basis of their perception of it.

The Smiley Company marks



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Mo monsters, mo problems

The Court took a strict approach,
believes Dominic Farnsworth

IN AN INTERESTING assessment of similarity, the General Court of the European Union has rejected an opposition by energy drink brand Monster to an application to register MO MO MONSTERS as a Community Trade Mark (CTM).

THE APPLICATION

Monster is a brand well known for its energy drinks containing caffeine and added vitamins and minerals. Monster opposed the MO MO MONSTERS application, relying on its earlier word marks for MONSTER and MONSTER ENERGY, and a claw/slash device featuring the word MONSTER. The registration for MONSTER covers a limited specification in Class 30 for “coffee-based beverages and coffee-based beverages containing milk in Class 30”. Monster argued that the CTM application should be rejected relying on Article 8(1)(b) and 8(5) of Council Regulation (EC) No 207/2009 (CTMR), for example that:

1. MO MO MONSTERS was identical or similar to the MONSTER marks;
2. the goods applied for were similar to those covered by the registered marks;
3. there was a likelihood of confusion on the part of the relevant public; and
4. MO MO MONSTERS would take unfair advantage of, or be detrimental to, the distinctive character or repute of the MONSTER marks.

BEFORE OHIM

The opposition was partially upheld, but the Board of Appeal (BoA) subsequently overturned that decision, finding that there was no similarity between the goods covered by the application, ie confectionary

and sweets, and those covered by classes 29 and 30 in the MONSTER word mark, ie dairy-based beverages containing coffee and coffee-based beverages containing milk.

GENERAL COURT

Monster appealed on the ground that the BoA’s decision infringed Article 8(1)(b) CTMR by finding that the goods were dissimilar and that there was no likelihood of confusion.

Monster argued that the goods contained in its registration and the goods contained in the application came within the same “sweet-snacks category”, served the same purpose and were competing. The Court rejected those arguments finding that: the beverages as registered were not within the “sweet-snacks category”; the respective goods served different purposes (satiating hunger versus quenching thirst); and that they were not in competition as there was no interchangeability.

The Court also rejected an argument that the respective goods were complementary as the goods applied for were not absolutely indispensable to or important for the consumption of the goods covered by the registration. Finally, the Court rejected the argument that similarity was established by virtue of the fact that the respective goods are sold in

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The Court rejected that similarity was established by the fact that the respective goods are sold in the same premises and share the same distribution channels

the same premises, share the same distribution channels and are aimed at the same consumers. Having made those findings, the Court went on to reject the argument that there was a likelihood of confusion.

COMMENT

This case is not new law, although it is quite a strict application of existing law. Many brands seek to rely on perceived complementarity of goods/services being applied for or sold by a third party. However, the Court has made it clear that this is a high hurdle and will be of assistance to applicants in opposition proceedings and defendants in infringement proceedings.



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Dominic is a jointly qualified solicitor/Trade Mark Attorney advising many of the world’s leading brands and advertising agencies.

Associate **Oliver Fairhurst** assisted with this article.



No go for Quo Vadis

In the end, appeal didn't meet with success,
explains Stephanie Taylor

ON 10 FEBRUARY 2010, Francisco Gómez Hernández filed an application for the mark "QUO VADIS" covering classes 29, 33 and 35, including alcoholic beverages in class 33. Upon publication, the application was opposed by *Éditions Quo Vadis*, the owner of two earlier French registrations for the mark QUO VADIS covering classes 9, 16, 38 and 42, including time planners in class 16. The opposition was based on Article 8(1)(b) and 8(5) of Council Regulation (EC) No 207/2009 (CTMR).

The Opposition Division rejected the opposition on the basis of Article 8(1)(b) but, finding that the Opponent had demonstrated that it had a reputation in France for the mark QUO VADIS used in respect of time planners, partly upheld the opposition in respect of Article 8(5), namely in respect of alcoholic beverages in class 33 and retail of alcoholic beverages in class 35. An appeal was filed by the Applicant and the Board of Appeal (BoA) annulled the Opposition Division's decision.

The Opponent then appealed to the General Court. In support, the Opponent: a) argued that the BoA erred in its finding that the general public would not establish a link between the Applicant's mark and the Opponent's marks because the goods and services have a different nature, purpose and method of use and should have considered the fact that the Opponent's marks have a strong reputation and distinctive character; b) pointed out the negative connotations of the goods covered by the Applicant's mark; c) cited French legislation which restricts direct or indirect advertising in respect of alcohol and the risk that the

Opponent would be inhibited in advertising via its trade mark as it may be associated with the Applicant's; and d) claimed the application was made without due cause.

The General Court held that, while the signs were almost identical, the

in various sectors in connection with a range of goods and services and the Opponent's marks were held to have average distinctive character. As no link was established, it is unlikely that the Applicant's mark would take unfair advantage of or be detrimental to the distinctive character of the Opponent's marks.

Turning to arguments b) and c), the Court held that wine and spirits are not inherently harmful and so do not convey any negative connotation which would conflict strongly with the Applicant's image.

Furthermore, the risk that the Opponent's own advertising may be restricted because it was associated with the Applicant's mark is the result of national legislation; the Community Trade Mark regime applies independently of national law. Therefore, the legality of BoA decisions should be assessed by reference to CTMR (as interpreted by the European Courts) and not on the basis of national law.

Regarding due cause, the Court held that an examination of the existence of one of the three types of risk covered by Article 8(5) must logically precede an assessment around due cause and where it is established that no risk exists, the registration of the later mark cannot be prevented on those grounds. Therefore, the appeal was dismissed.

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It is unlikely that the Applicant's mark would take unfair advantage of or be detrimental to the distinctive character of the Opponent's marks

goods and services covered by the marks were different. Furthermore, there is no obvious link between alcoholic beverages, the sale of alcoholic beverages, and time planners – their producers and suppliers are active in different fields without any overlap. When considering whether there is a link between marks at issue, it was demonstrated in *Intel* that the earlier marks' distinctive character should be considered. In this case, it was held that the mark QUO VADIS appears to be used by third parties



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events

More details can be found at itma.org.uk

Date	Event	Location	CPD hours
3 February	ITMA Charity Quiz Night	Penderel's Oak, London WC1	
22 February	Afternoon Seminar & Drinks Reception with the JPAA	CIPA Hall, London WC2; Gray's Inn, London WC1	3
23 February	ITMA London Evening Meeting: Patent Plus Designs – Pros and cons of a blended IP portfolio	Royal College of Surgeons, London WC2	1
16-18 March	ITMA Spring Conference History & Heritage	One Whitehall Place, London SW1	9
16 March	ITMA Drinks Reception Part of the ITMA Spring Conference	Jewel, London W1	
17 March	ITMA Gala Dinner and Drinks Reception Part of the ITMA Spring Conference	Tower of London, London EC3	
23 March	ITMA 2016 Open Meeting; ITMA AGM & ITMA Benevolent Fund AGM; Drinks Reception	Charles Russell Speechlys LLP, London EC4	
20 April	ITMA London Evening Meeting	Royal College of Surgeons, London WC2	1
10 May	ITMA London Evening Meeting	Royal College of Surgeons, London WC2	1
28 June	ITMA London Evening Meeting	Royal College of Surgeons, London WC2	1
20 July	ITMA London Evening Meeting	Royal College of Surgeons, London WC2	1
27 September	ITMA London Evening Meeting	Royal College of Surgeons, London WC2	1
25 October	ITMA London Evening Meeting	Royal College of Surgeons, London WC2	1
22 November	ITMA London Evening Meeting	Royal College of Surgeons, London WC2	1



Our **Spring Conference Gala Dinner** will kick off in central London once again this year, with a focus on History & Heritage. See more on page 18

ITMA London Evening Meetings and the ITMA Spring Conference, including Gala Dinner and drinks receptions, are kindly sponsored by





I worked as... Senior Partner, at Graham Watt & Co, Patent and Trade Mark Attorneys. I personally handled both patent and trade mark matters.

Before this role... I was Head of Patents and Trade Marks for Simon Engineering Limited.

My current state of mind is stressed... I thought I would have more leisure time when I retired in 2003 but this has not been the case. On the other hand, I thrive on moderate stress.

I became interested in IP... when a friend joined Reddie & Grose. I then learned more from the Appointments Board at Cambridge in 1959.

I am most inspired by... my wife Gwendoline, who I married in 1959, and my grand-daughter Charlotte Blakey who is a Trade Mark Attorney with Keltie (and an ITMA member).

In my role, I most enjoyed... attending hearings before the Trade Marks Registry.

In my role, I most disliked... problems with IT equipment, and the awful phone services pre-privatisation.

On my desk are... a bust of Queen Victoria, a Winston Churchill bulldog, some meerkats and an untidy mess.

My favourite mug... says "The Lot", commemorating the taking of all 10



Retired member Gerald Holdcroft shows unprompted ITMA appreciation (thanks!)

wickets in the second innings of a Test match against Australia by the England off-spin bowler Jim Laker in 1956. Jim also took nine wickets in the first innings of the same match. One has to be quite old to remember Jim Laker.

My favourite place I have visited on business is... Boston, Massachusetts.

If I were a trade mark or brand, I would be... ITMA, because not only have I much appreciated being a member of the Institute of Trade Mark Attorneys, but the initials afforded me much entertainment in the 1940s

when they stood for a radio show called "It's That Man Again" featuring the comedian Tommy Handley. Again, one has to be quite old to remember Tommy Handley.

The biggest challenge for IP is... bureaucracy, particularly in trans-European organisations such as OHIM.

The talent I wish I had is... a better ability to read and speak foreign languages.

I can't live without... Gwendoline and my bicycle.

My ideal day would include... joining Keith Havelock in a glass of champagne when Charlton Athletic regain their place in the Premier League - not likely to happen soon!

In my pocket is... believe it or not, a pocket watch; I collect them.

The best piece of advice I've been given is... to seek a career in IP.

When I want to relax I... take exercise such as cycling or walking or listen to soothing music. (Or I may occasionally have a small whisky.)

In the next five years I hope to... stay alive.

The best thing about being a member of ITMA is... the excellent *ITMA Review*, which keeps me informed in my retirement.



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