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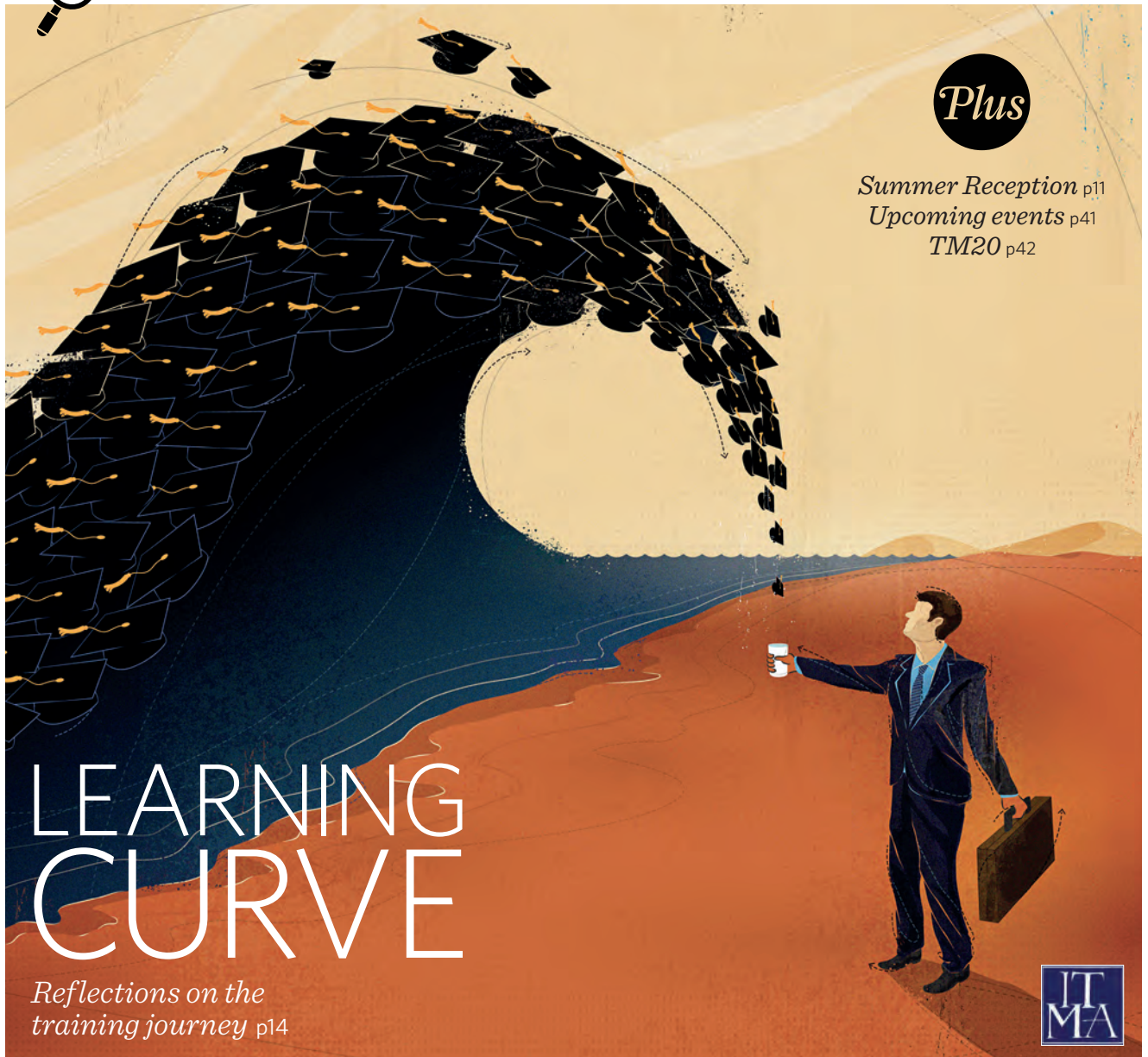
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# ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

Issue **412** September 2014 [itma.org.uk](http://itma.org.uk)



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# welcome

September 2014



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**A**utumn – “season of mists and mellow fruitfulness”, as John Keats would have it. Summer is a distant memory for most of us by now, but we are confident that this issue of the *ITMA Review* will keep you so absorbed that you will not be pining for your summer holidays.

In its pages, we focus on education and training, very important topics for all of us, as are the new IP Act

and OHIM’s practice on black and white marks. And, if that all becomes too much, you can distract yourself with the photos of our very well attended Summer Reception.

**Chris McLeod**  
ITMA President

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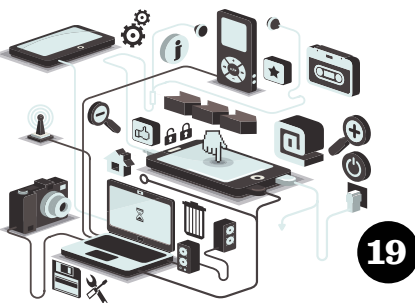
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# i<sup>ITMA</sup> Insider

## CEO bulletin

*Keven Bader recaps an important recent event, as reported to members on 9 July*



**T**his bulletin takes a slightly different approach to the usual information diktat. Instead, I offer members specific feedback from a 2 July meeting held with the Minister for Intellectual Property in the UK, Viscount Younger of Leckie.

The hour-long meeting took place at the Department for Business Innovation & Skills (BIS) and in attendance, along with Lord Younger, were Steve Rowan, Divisional Director of Trade Marks and Designs at the UK IPO, Chris McLeod and myself.

Having discussed several IP issues, the overriding point we took from the meeting was a genuine appreciation of the work and support of ITMA and the profession in helping the Government and the IPO in succeeding in delivering many of their objectives and initiatives. Lord Younger particularly thanked ITMA for its strong contribution in the development of the Intellectual Property Act 2014. We agreed that the key was for the Act to be implemented correctly, and clear and helpful supporting guidance would play a major part in this.

Lord Younger was delighted that the IP Audits Plus scheme had got off the ground and again thanked ITMA and its members for their involvement in advising on its set-up and for participating in delivering audits to many SMEs. The IPO has

committed to the scheme for another year; clearly, it is providing value and we encourage members to remain involved.

In respect of the continuing problem of unsolicited invoices or misleading mail, we were all pleased to see that the IPO had begun passing off proceedings against the persons behind the companies trading as Patent and Trade Mark Office and Patent and Trade Mark Organisation. The issue is one that the Minister and the IPO are taking very seriously and it has been raised at senior levels. It is hoped that awareness-raising and action from numerous angles will lead to a prevention of registrants falling victim to these practices. We encourage members to continually remind clients about these unsolicited approaches and to advise them to share all relevant correspondence with you before signing, or worse paying, in response to such an approach.

Lord Younger also thanked ITMA (and CIPA) for its involvement with the IPO in the various IP awareness-raising initiatives and, in particular, the production of the IP for Business tools. Jerry Bridge-Butler of Baron Warren Redfern, who leads our IPO initiatives working group, and Jim Pearson of Able & Imray were both praised by Lord Younger for the valuable contribution on behalf of the profession(s) that they have made.

We gave assurances that we were keen to continue our involvement with such initiatives and we believe that only positive things can come from these schemes.

Although there hadn't been a full debrief of the International IP Enforcement Summit that took place on 11-12 June, the early indications were that the event was a success. There appears to be a keenness from the IPO and OHIM to continue with further summits, possibly every two years, although not held in the UK and not funded by the IPO. Lord Younger explained that Government departments were

*There was a genuine appreciation of the work of ITMA and the profession in helping the Government and the IPO deliver their objectives*

working much more closely on enforcement and there was clearly a common interest; it was hoped that this cross-Government departmental working would continue. The work of the Police Intellectual Property Crime Unit (PIPCU), set up by the City of London Police and the IPO, was highlighted as a positive development in this area, and we are hoping to bring speakers from PIPCU to ITMA members in the future so that we can hear more about their work. Lord Younger was keen to be involved with ITMA and work closely with us on any activity that we might undertake in this area.

On the subject of standardised packaging of tobacco products, we outlined our position as referred to in our initial response to the consultation by the Department of Health (DoH) on this matter. We said that we would be providing a response to the recently launched second consultation that contained draft regulations. In particular, we will be looking at whether there may be any unintended consequences that might arise from the regulations as drafted. Lord Younger and the IPO confirmed that the Department for Business, Industry & Skills and the IPO had been involved in the consultation, and would be keen to be copied into our response as they will have further discussions with the DoH, therefore it would be useful for them to be aware of any points we raise.

As for the future, the IPO Steering Board was to look at the strategy of the IPO at a forthcoming away-day.

## Update

Since this message was issued, Baroness Neville-Rolfe has been appointed Minister for Intellectual Property, replacing Lord Younger. ITMA's President Chris McLeod has written formally to Baroness Neville-Rolfe to congratulate her on the appointment and to express our interest in continuing to work together on areas of mutual concern.

We hope to have more to report on this subject in the near future.

## Member moves



Kate Symons has recently left the UK to establish Bone-Knell Symons Intellectual Property (BKSIP) with Mark Bone-Knell in Dubai. Email [kate@bksip.com](mailto:kate@bksip.com)



Stobbs IP is delighted to announce that Désirée Fields has joined its trade marks team in Cambridge as a Solicitor. Email [desiree.fields@stobbsip.com](mailto:desiree.fields@stobbsip.com)

## Leaver lessons

*Kara Tompsett and Sarah Brooks recently represented ITMA at an event for law student leavers. Here's what they learned*

Sarah and I spoke to about 45 students attending the University of Law Leavers' Fair on 23 June. The level of interest was quite varied – some students had clearly done research and intentionally set out to speak to us, while others seemed to stumble across us while working their way around the circuit.

Some of the most frequent questions we were asked included:

- Do you need a science background to work in IP? (This was a fairly common misconception, even with students who had already studied IP modules.)
- I have already studied IP on the LPC. Am I exempt from further studying?
- What are the entry requirements?
- Where in the country are most firms based? Are there opportunities outside London?
- Where are jobs advertised? What are the deadlines for applying?
- What are the retention prospects if you qualify?

- Do you train at ITMA or at university?  
Broadly, I think that most students left our stand with something new to think about. However, I got the feeling that, having already obtained LPC/BPTC qualifications, most students were strongly committed to the solicitor/barrister route and reluctant to take on another two years of study. Instead, they seemed to view the Trade Mark Attorney qualification as a back-up option to be considered in the event they couldn't secure

a training contract or pupillage. Sarah and I think that it may be more productive to target undergraduates rather than postgraduates at these kind of events, so that students can consider qualification as a Trade Mark Attorney as a true alternative. Kara Tompsett is a student representative on the ITMA Education Committee. See her article on page 14.



# ROLLS VOICE

*Philip Harris enters the IPEC's inner sanctum to hear how HHJ Richard Hacon is finding his latest role*

**I**t's 5pm at the Rolls Building. The foyer is deserted except for a security guard who eyes me warily. "We're closed," he says. I explain that I have come to interview Judge Hacon. He brightens and calls Christy Irvine, the Judge's clerk. A couple of minutes later I am being ushered into the fifth floor "inner sanctum".

Irvine leads me through the maze to Judge Hacon's office, where he kindly clears a pile of papers from his conference table, greets me warmly and we get started.

**Philip Harris: Was it always your intention to go to the Bar?**

**Richard Hacon:** No... it came after my degree [in microbiology]. While I was doing my degree, I had intended to go into research or something like that. But, like quite a lot of patent lawyers, I discovered that, even if you can do the intellectual stuff, being skilled in a lab is a skill all of its own. I recognised that some people really were very good at getting results in a lab and I was "middling", so I thought "I'll go and do something else".

**PH: Was a career in IP in your mind at that the time?**

**RH:** It was in the back of my mind, yes. But first I spent about two and a half years on the Continent – in Strasbourg, then Paris and Brussels – doing notionally Community law-related things and enjoying myself very much. But then a time came when it was either time to become a permanent ex-pat in Brussels, or to come back to London and do something

else, ie IP law. So I [chose the latter], which I think was the right decision.

**PH: What attracted you to the IPEC role?**

**RH:** I thought it would be nice to have a change of job, really, and something interesting to do.

Inevitably, it's a different way of approaching the law, and I like that. As a Barrister you spend all your time, necessarily, trying to think up the best arguments, the best "spin" for your client's case. You don't have to – and so you don't very much – dwell on what must be the right answer. Whereas a judge does quite the opposite; the one thing you must do is make up your mind, and I quite enjoy it.

**PH: Has your experience as a Barrister prepared you for the judicial role?**

**RH:** Yes, I think it has. As a Barrister I had been watching judges and talking to them for years, so I had a pretty good idea about what the job involved. There were no huge surprises. When you are on the bench it is useful to know what it's like to be the advocate. And when you speak to, as I have, continental judges, they recognise that one of the advantages of our system is that we do have a greater understanding of the advocate's point of view, as opposed to those who have been professional judges from the start.

**PH: How would you describe a typical week for you as an IP judge?**

**RH:** I would have one trial, over one or two days. In between trials I'm either writing judgments



*I think my job is to maintain momentum that my predecessors, especially Colin Birss, built up. It's not my intention to make any big revolutionary change*

or dealing with applications. Sometimes the table is covered with paper applications and that can take up quite a lot of time. They may be extremely simple, and all you've got to do is check it's OK and approve it. But sometimes they are relatively complicated and, especially if they come in from litigants in person, they aren't always the best ordered. I can spend quite a lot of time trying to tease out what the case is really about, whether they have really informed the other side of the application or are trying to pull a fast one.

**PH: What do you think is the biggest challenge that you face in IP?**

**RH:** One of the things I am still finding quite challenging, personally, is giving extempore judgments. It's an important technique to develop, because if you reserve everything but the most simple judgments: a) it consumes a lot of time; and b) it's less useful to the litigants, because for relatively simple applications they want the answer there and then. But it does require you to organise your thoughts, to set out the background to what's happened and give your reasoned conclusion at the end of it. And that isn't a technique that's required at the Bar.

As far as taking the Court forward, mostly I think my job is to maintain momentum that my predecessors, especially Colin Birss, built up. I've made changes to the guide and things like that, but it's not my current intention to make any big revolutionary change. One,

I don't think it's necessary, and two, a degree of "bedding in" is still required.

**PH: There used to be a perception that trade marks were the poor relation, certainly in Chancery, to patents. Do you think that's changed?**

**RH:** Well, I'm not sure about that at all. My impression when I was at the Bar was that trade mark cases were often deceptive. The facts always seemed terribly simple and the law was fiendishly complicated, quite often. Whereas with patents it's the other way around – the law isn't terribly complicated, but the technology can be – so it can take quite a long time to understand the underlying facts. Plus, you don't get this torrent [laughter] of cases pouring out of Luxembourg, which you feel you have to keep up with.

Conceptually it's often very difficult, and because it's a difficult point, and occasionally the judgments out of Luxembourg don't clarify things as much as they might, I think trade mark cases are often the most difficult.

**PH: Trade Mark Attorneys now have rights to appear before you. How many are?**

**RH:** My impression over the past six months, if you're looking at hearings, is that about 60 per cent of parties are represented by Counsel. The other 40 per cent of representation is divided about equally between either Patent Attorneys or Trade Mark Attorneys on the one hand and litigants in person. Though, for trials, it's almost always by Counsel. ➔

**PH: The message I get from some practitioners is that there is some reluctance around advocacy. Have you got any tips or reassurance for them?**

I think the biggest reassurance is that the ones I have seen do perfectly well. And so I see no reason at all why others shouldn't do just as well. They won't get shouted at. I can understand why Trade Mark or Patent Attorneys might be nervous, and the reason is that it's not something they do day to day. And that's true of anything. From past experience, they'll do fine.

**PH: Some attorneys may also be concerned that when you look at the White Book, it's an intimidating piece of work, with which a barrister will be completely familiar and they will not be. They may be apprehensive about the pitfalls of Civil Procedure. Is there any advice you can offer them?**

**RH:** What I can't say is: "Don't worry, the rules can be flexible if you are not Counsel." That somehow you'll get a different kind of treatment. That just can't work. The rules are the rules.

And Civil Procedure is unavoidably complex in the sense that you can't help but have these various [Civil Procedure] rules all in the White Book. But what I can say is this: it's unusual for a case to get bogged down in "CPR this" or "CPR that". If you're going to appear in any court, you have to more or less know the basics. But it's not a horrible man-trap you're bound to lose your leg in. The rules are there, they have to be complied with, but don't assume that it's going to be a nightmare. Usually, it won't be.

**PH: And how do you see that fitting in with the independent Bar? Do you think they can coexist?**

Yes, I think so. As I mentioned a moment ago, for trials it's almost always the Bar who represent clients, and when it's not it will be a litigant in person. And I can see why that happens. Cross-examination isn't a skill you can pick up overnight. I think Trade Mark Attorneys and Patent Attorneys and Solicitors could do it, but the difference is that Barristers do it – and the various things you have to keep in mind at a trial – on a regular basis, so they are bound to do it with a bit more confidence. It's inevitable.

I can certainly say this: it won't be the case, ever, certainly in my court, that the judge is trying to make life difficult for somebody who is not very familiar with conducting a trial. That isn't to say that the rules don't have to be followed, because there has to be a level playing field. But there would be no question of the

judge and barrister being "pally" and ganging up on the other side. That would be absurd and that wouldn't happen.

**PH: For some litigants, particularly in trade mark cases, the costs cap of £50,000 is still a big number, and it could be said there should be a differential from patent cases. Is there any thought of looking at that again in the context of trade marks?**

**RH:** I can tell you there are certainly no immediate plans for that. Don't forget there's a Small Claims Court, which has a damages limit of £10,000 – pretty substantial for a lot of litigants. There, it's very unusual for any kind of costs to be awarded. It's quick, it's efficient. You can't get an interim injunction, but you can get a final injunction and so, I think, for a lot of litigants, that's the answer. In the main IPEC, I hear people say the cost cap is still quite high, and then others say it must put off a lot of litigants, because they are never going to get their money back. I think a lot of the reason people do litigate in the IPEC is that there is a sense of control, a feeling that, even on the worst possible expectation, the costs are never going to run riot. And £50,000 is quite a lot, but I think whichever number you pick there would always be a party who wants it higher or lower, so I think it works reasonably well.

**PH: It certainly doesn't seem to be putting anyone off.**

**RH:** Certainly not. One concern is that I am [in June] booking trials in for February and March, and I feel that that's quick compared to the Patents Court, the general Chancery Division, but ideally the IPEC would be faster. But there we are. There is a limit to how much I can do, even with deputies. Again, if somebody doesn't have a claim over £10,000 and they want a quick trial, go to Small Claims, it does an excellent job.

**PH: Is Small Claims suitable for large corporates with simple trade mark cases? Will they be encouraged to "go up" because of their size?**

**RH:** They won't. Even though the main IPEC wasn't designed as a place for multinationals to slog it out, it's not that unusual, and I don't regard it as my job to turn large companies away if they have a relatively modest claim, and if we can sort it out relatively speedily and cheaply. However, I have recommended,





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The Rolls Building in London is the home of IPEC

when I give talks to professionals who tend to have quite large clients, that even large companies can have small problems and I think they would appreciate being told: “While we are looking after this big problem for you, why don’t we take this little problem to Small Claims? We can have it done and dusted in a few months.” I think clients would appreciate that.

**PH: I think so, too. A lot of trade mark issues, particularly between bigger companies, are often more theoretical than about actual confusion, and Small Claims looks to me to be a perfect place to sort that out.**

**RH:** I agree and to some degree I think it’s underused, although lately the statistics have been shooting up. Maybe I have encouraged enough people and maybe I’ll start getting complaints from the District Judges. Instead of saying “Why aren’t you promoting us?” they’ll say “STOP promoting us! Enough!”

The Small Claims guide specifically says that, if it is a registered trade mark case and there is an issue of validity, it probably won’t be suitable. Now the trouble is, with registered trade mark cases, there is almost always an issue of validity, which would seem to unnecessarily push cases out of Small Claims.

I think the three District Judges are concerned they might get cases where there’s suddenly a long list of Court of Justice of the European Union (CJEU) authorities to consider. But, as you say, that needn’t be the case. Broadly, I agree with you. I think there is no reason in principle and in practice why trade mark cases shouldn’t be heard in Small Claims. It’s just that, the trouble with trade marks, as I mentioned earlier, is that what on the face

of it seems like a straightforward claim can turn into something very complex once you scratch the surface. It’s perhaps “once bitten, twice shy”.

**PH: We touched on European Union (EU) jurisprudence, which some people characterise as Delphic utterances that come down from on high. Have you had any thoughts about how difficult or easy it is to apply EU jurisprudence to trade mark cases within IPEC?**

**RH:** Oh, I don’t think it’s any different in the main IPEC to anywhere else. Generally speaking, even if there was quite a knotty problem of law, provided that the case can be heard within the general two-day maximum – and there aren’t going to be cartloads of witnesses coming in to take up a lot of time – then a case would be heard in the IPEC; in which case, the difficulties of dealing with CJEU law are the same for me as any other judge. I don’t think it’s either especially easier or worse.

*I can understand why Trade Mark or Patent Attorneys might be nervous [about advocacy] and the reason is that it’s not something that they do day to day. And that’s true of anything. From past experience, they’ll do fine*

**PH: And interpreting the jurisprudence? As a judge, do you think the EU judges are as clear as you would like them to be?**

**RH:** Oh, not always. But I think it's inherent in a court of that nature that the judgments are never going to be given with the same clarity as in a court with a single jurisdiction. You are combining judges from various national backgrounds and procedures, and they all have different approaches. They've all got to come together with one view. And sometimes it's the lowest common denominator, just to get the judgment done, I'm sure. But that's inevitable. How could it be otherwise? If one is going to try and have the advantages of a trade mark system that allows free movement, so the rules are the same everywhere, then one of the difficulties is that you have a court that sometimes is obviously delivering a compromise answer that isn't as clear as it might be.

And it's the same in the UK. Even with passing off, a purely English course of action. There are always going to be points that need to be resolved. It's just inevitable that there is always something someone had never thought of before, so we have to find out what the answer is.

**PH: Do you have a particular view on the practice of giving a non-binding opinion if the parties ask for one?**

**RH:** Yes, I haven't done one yet. It's cropped up several times. In all but one case, one side wanted it and the other didn't, and I am following Colin Birss's rule that unless both sides want an opinion I won't give it. There was recently one occasion when both sides did want it, so that was fine with me. But then there was a dispute about whether it should be given there and then at the CMC, just on the pleadings essentially, or whether both sides should then file written submissions, and then there would be a kind of mini-trial in writing. Plus, I was reluctant to do it because there was a real risk that I was going to deliver an opinion that said "Well, if the evidence goes this way, this; if it goes that way, that", so I thought it was not an appropriate case. I think it is extremely helpful if, for example, it just turns on a point of law that you can give a view on (non-binding, of course), but if it's likely to turn on that, now's the time to express what your view is.

Occasionally, one has the impression that one side or the other is just unrealistic and a wake-up

call might be useful to them, because they are going to spend a lot of money going all the way to trial and the chances are that they are going to lose and waste their money. And, in either of those circumstances, if both parties ask for it, I would certainly very happily give a preliminary view. But it hasn't happened yet.

I haven't, so far, prompted parties much and said "Do you want me to give a preliminary opinion", perhaps with one exception, and it's the case that parties quite often have spent a month trying to settle their differences, they've tried mediation and by the time they've reached that stage their mindset is: let's get on with it. So that's what they do.

**PH: Have you had any particularly memorable cases so far? *Brundle v Perry (F H Brundle v Richard Perry [2014] EWHC 979 (IPEC))*, in which, after the trial, Mr Perry created and circulated a letter purporting to come from the Judge, springs to mind.**

**RH:** Yes, Mr Perry. He was unusual. A lot of people have asked me why the sanction on Mr Perry was not more severe. I still get people coming up to me and saying: "If that wasn't unreasonable, what is? Are you mad?"

I have taken the view that the cost sanction applies, or the cap is disappplied, if a party behaves unreasonably. On one hand, faking a letter from a judge is fairly unreasonable behaviour. On the other hand, he sent it to my clerk, so he knew I was going to read it and no one was going to take it seriously. I don't think he was being fundamentally dishonest; he was just an unusual litigant with an unusual approach.

**PH: I think he was lucky he got a very understanding judge.**

**RH:** I think I was sufficiently early on in my career; maybe that's the difference. As years go by, maybe I'll get crusty and change my view! I hope not.

**PH: Well, I'm sure you will never get crusty in this role. Judge Hacon, thank you very much.**



### Philip Harris

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Philip is a past President of ITMA and ITMA Council Member, and formerly Head of Trade Marks and Partner at Gill Jennings & Every LLP.



# Summer Reception

*London's historic In & Out Club offered a warm welcome to members attending this popular gathering*

PHOTOGRAPHER | STEWART RAYMENT



**01** John Reddington (Williams Powell), Tim Chapman (Lewyns), Stephen Powell (Williams Powell) and Chris McLeod (ITMA President) **02** Mary Bagnall (Charles Russell), Eric Ramage (Alexander Ramage Associates) and Tania Clarke (Withers & Rogers) **03** Apostolos Dakanalis and Kristina Passmore (HGF) **04** Kate Giannini, Michael Wakefield, Duncan Mee, Jack Wilde and Jennifer Eddis (Cerberus IP) **05** Anthony Tejuoso (AA Tejuoso & Co) and Michael Keogh (BP) **06** France Delord (Taylor Wessing) and Lianne Shaw-Gray (Squire Sanders) **07** Thomas Hooper (Baker & McKenzie), Shiva Mahmoodi and Zoe Dewhurst (Reddie & Grose), and Daniel Joy (Baker & McKenzie) **08** Richard Mair (Abel & Imray) and Ryan Hickey (Wolters Kluwer Corsearch)



# TRIVIAL PURSUIT

*Ending claims of protection for small features is just one of the issues on which the new IP Act has set its sights, as Nicole Giblin explains*

**A**fter a year of consideration, the Intellectual Property Bill finally received royal assent on 14 May 2014. The resulting Intellectual Property Act 2014 (“the IP Act”) will come into force on 1 October 2014. Part 1 of the IP Act is concerned with designs, and this article will outline the key changes of which practitioners and clients alike should be aware of this autumn.

## Design definition

As it stands, UK Unregistered Design Right (“UDR”) is available for “any aspect” of the shape or configuration of the whole or part of an article, and allows right owners to claim protection for very small features of a design. This has led to a tendency to overstate the breadth of UDR and, on some occasions, has led to protection of trivial features of a design.

Under the IP Act, the words “any aspect” have been removed, such that UDR is now only available for “the shape or configuration...” of an article. While UDR will still be available for the design as a whole, and for parts of the design, it will not be possible to claim protection over small or trivial features of the design, or anything that could be considered to be a “part of a part”.

## Meaning of “original”

For a design to be worthy of UDR it must be “original” – ie it must not be “commonplace”. However, the question of exactly where the design could not be commonplace was often disputed and the definition was seen to be too vague.

To bring some clarity to the law, the new IP Act has redefined the meaning of “original”, such that the design would have to be commonplace in a

specific area to fall foul. This area has been defined as being the UK, the European Union (EU) and any other “qualifying countries” that provide reciprocal protection. By clarifying the geographical boundaries of being commonplace, it should, in theory, be easier to prove whether or not a design meets the UDR criteria.

## Ownership

Probably the most significant change relates to the ownership of UDR and UK Registered Designs (UKRD). The present law states that the first owner of a commissioned design is the commissioner. However, under the IP Act, the first owner of a commissioned design will be the designer themselves.

The change, which will be welcomed by practitioners, brings the UK ownership rules in line with those already in place for Copyright and Registered and Unregistered

*It will not now be possible to claim protection over small or trivial features of a design, or anything that could be considered ‘a part of a part’*

Community Designs. For clients, it will now be even more important to ensure that appropriate contracts are drawn up for commissioned works and that such contracts make provision for any resulting UDR or UKRD to be expressly assigned to the commissioner.

It is worth noting here that any UDR or UKRD created in the course of employment will still be owned by the employer, unless contracted otherwise.

### **First marketing**

In relation to UDR, qualification by first marketing will now be determined by reference to the country in which the first marketing takes place, and not the domicile or place of business of the marketer. This change essentially opens up the availability of UDR to designers who first market a product in the UK but are from a non-qualifying country such as the US.

### **Right of prior use defence**

There is currently no “right of prior use” defence to individuals who find themselves in the position that they are using a design, but find that someone else has registered it.

Under the IP Act, such individuals will be able to rely on a right of prior use defence, provided, of course, that they are using the design in good faith and that the design was not copied. Use will, however, be limited to the way in which it was being used originally and/or if “serious and effective” plans had been made

to use the design in a particular way. Expanding the use beyond these definitions will still be actionable by the proprietor.

### **Intentional copying**

The intentional copying of a UKRD or Registered Community Design (RCD) will, in certain circumstances, be considered a criminal offence. The accused party must have acted intentionally, in the course of business, without consent and knew, or had reason to believe, that the registered design in question had been copied. Defendants may find themselves subject to a fine and/or up to 10 years’ imprisonment. The change has not, however, been applied to infringement of UDR, which will still be dealt with as a civil matter.

### **Innocent infringers**

An innocent infringer has no financial liability under the current law. This was seen by many as being too relaxed an approach, and the IP Act has addressed this by allowing the proprietor of a UKRD to seek an account of profit from an innocent infringer. While this is an improvement on the current position, the change does not quite bring the

UK law in line with EU law, which allows for damages to be claimed from innocent infringers.

### **2015 and beyond**

In addition to the changes discussed above, a few other changes are expected to come into effect towards the end of 2015, namely:

- The launch of the UK IPO’s Designs Opinion Service, which will allow parties to request a non-binding opinion not only on the validity of a design but also on the infringement. The opinions will be on public record, but further details on the service are to be announced in due course.
- The UK will be joining the Hague System, which will allow an International Design filing to cover the UK alone. Until now, protection in the UK was only available if the EU as a whole was covered.
- The option to appeal unfavourable design decisions to an Appointed Person akin to the appeal system already available for trade mark matters.

The implementation of these changes will, no doubt, come with some teething problems. However, most will agree that they go some way towards clarifying a few of the grey areas of UK design law.



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# TALKING TRAINING

*Trainee Kara Tompsett explains her expectations and experience of trade mark study so far*

**I** work in a large IP team, where several Trade Mark Attorneys have qualified before me, both under the current training system and the old JEB system. As such, I was able to benefit from a fair amount of anecdotal advice before embarking on my own training in September 2012. As a result, I was prepared for my first year studying for the Certificate in Trade Mark Law and Practice at Queen Mary University of London (QMUL), to focus on an academic approach to trade mark law, and my second year studying for the Professional Certificate in Trade Mark Practice at Nottingham Law School (NLS) to take a more practical approach.

As I reach the end of the Nottingham course I can report that my expectations in respect of both qualifications have been met. The first year at QMUL proved to be primarily lecture-based and evoked hazy memories of studying for my law degree all those years ago. Notwithstanding the varying levels of audience participation involved (usually depending on the willingness of the audience and the perseverance of the lecturer), that year forms a stark contrast to the second year at

Nottingham, which involves relatively few lectures and a great deal of group work on problems and scenarios that may arise in day-to-day practice.

As much as I prefer the NLS approach – being someone who finds it much easier to learn by doing rather than by rote – it would not be possible to participate on the NLS course without the foundation provided by the year at QMUL, which ensures that you have a firm understanding of the law.

## Study highlights

One of the best things about both of the courses is the diversity of students and the range of experience that they have. Enrolling on these courses, you will study alongside trainee Trade Mark Attorneys from across the UK and further afield; students from private practice, from trade mark firms and in-house legal teams in large and small-scale commercial enterprises.

As well as giving students the opportunity to find out a bit about other branches of the profession, it's a great opportunity to make contacts that may come in handy later. Who knows – maybe one day it'll be that little bit easier to pick up the phone

## PROVIDER PERSPECTIVE: CERTIFICATE IN TRADE MARK LAW AND PRACTICE

***“Student questions can be quite challenging and this is the best reward for all those teaching on the programme”***

The idea behind the Certificate in IP Law is to offer a university degree that combines postgraduate study with a professional qualification, embedding a practical approach against an academic context. Teaching on the Certificate, as part of a team that comprises academics and practitioners, is a joy; increasingly, students acknowledge and benefit from this combined perspective, and teachers interact better with the students and with each other. This whole process makes the Certificate a learning experience for all; student questions can be quite challenging and this is the best reward for all those teaching on the programme.

Of course, there are teething problems; the student audience is very diverse in terms of breadth of experience, and the balance between practice and theory is difficult to establish in a way that is engaging for all.

Relying on several internal and external lecturers poses organisational challenges. And the intensity of the programme, combined with the work demands our students face, means that they do not always have the time to immerse themselves into the jurisprudence that is growing so fast; some Saturday sessions can be quite tiring!

But, hopefully, everything falls into place at the end. Exam results are evidence that the Certificate is following an upward trajectory. This year, in particular, we had some exceptional distinctions agreed with our external examiners.

Finally, at Queen Mary University of London, we are always happy to receive suggestions about new aspects that the Certificate must cover. The professional environment is becoming more challenging and the Certificate must adapt to the needs of the profession while retaining its academic rigour.

**Spyros Maniatis, Director of the Centre for Commercial Law Studies, Queen Mary University of London**



and negotiate a mutually beneficial settlement agreement with the other side if you know their representative from your training days!

A diverse intake is also academically beneficial because of the broad range of experience that comes along with it. Inevitably, parts of the syllabus will be brand new to some students and old hat to others; occasionally a student knows more about a particular topic than the lecturers do. The encouragement to do group work and discussion (in particular on the NLS course) means that each individual's knowledge can benefit the whole group. It's not just the straightforward transmission of facts from one person to another. There is frequently more than one solution to a given problem, and having a range of students with various backgrounds means that you may encounter an entirely different approach to the one you usually take. The courses encourage you to think about a range of solutions rather than just one that happens to work. It's a collaborative experience.

In addition to the variety of students, both courses invite a range of guest speakers to give

lectures and, at NLS, to participate in the group activities. The speakers aren't dusty old academics, they're hands-on practitioners and have included Trade Mark Attorneys, solicitors and barristers, as well as the examiners from the UK IPO and OHIM with whom you will eventually be dealing. It's a great opportunity to benefit from their expert insight and they're usually open to answering any awkward questions at the end.

### **Challenges**

Studying at the same time as working full time is a challenge in itself. If you're reading this article, you know that there are a lot of deadlines in this job, and those deadlines won't go away just because you have a week out of the office on study leave. While I imagine that practices regarding cover and deadlines vary wildly from one student to another, most students need to be pretty disciplined to ensure that they don't drop the ball while they're away from the office. With all the will in the world, if a busy period at work coincides with a week when you're away, it can be a bit of a juggling act.

Fortunately, (or perhaps unfortunately, depending on

how you look at it), smartphones and omnipresent Wi-Fi make it easier to manage deadlines while away from the office. It's fairly common to see students attending to their work emails or logging on remotely to do a couple of hours' work between lectures. It's not ideal, of course, but it's preferable to a missed deadline.

Another challenge of all three courses is the weekend studying. The QMUL course runs on Fridays and Saturdays, and the Bournemouth and Nottingham courses tend to run in blocks of three to five days, usually ending in a Saturday session. This being the case, you should expect to give up a significant chunk of your weekends while enrolled on the trade mark courses and this has been a source of frustration for most students at some point or another. (Not to mention the hours you will have to spend reading up before attending the courses and the hours spent diligently preparing for your exams.) You didn't expect to work full time, study part time and have a social life, did you? But on the flip side, the Saturday lessons do make it that little bit easier to juggle work commitments and study.



## PROVIDER PERSPECTIVE: PROFESSIONAL CERTIFICATE IN TRADE MARK PRACTICE

### ***“Assisting students in their development as practitioners is at the heart of the course”***

Launched in 2011, the Professional Certificate in Trade Mark Practice at Nottingham Law School (NLS) is about to enter its fourth year.

The course has been designed to provide a similar type of skill-based education and training to that received by solicitors and barristers. In addition to curriculum mainstays such as searching and reporting strategies, filing options and registry practice, there is also the opportunity to consider areas such as licensing and assignments, domain name disputes, and design law and practice.

In line with the training of all lawyers, students study professional ethics and the IPReg Code of Conduct. As a result of regulatory requirements in relation to the licensing of alternative business structures, the course will shortly also include training on anti-money-laundering procedures.

The development of trade mark contentious skills is also high on the agenda. There is a special module and assessment on practice and procedure before IPEC, as well as classes on case analysis, case management and drafting. This year, a new exercise on the analysis of evidence, drafting pleadings and witness statements was introduced in which the drafts produced by students on an individual basis were marked by the teaching team overnight. This was very well received by the students who said that the session had been helpful to cement the day-to-day work in the office and place it in context.

#### **PRACTICE BASED**

As this is a practice-based course, students also undertake two skills assessments: an interviewing and advising assessment, and an advocacy assessment. Both skills assessments address substantive legal knowledge, as well as client (and court) skills of the practitioner. All assessment questions are compulsory; there is no choice in the written papers. The intention behind this type of assessment strategy is to ensure that the complete syllabus is covered.

Assisting students in their development as practitioners is at the heart of the course. For that reason, NLS staff (who have all practised as lawyers) are joined by practising Trade Mark Attorneys who work with the students in class or attend to give lectures on specific areas. Students have also heard from those working in trading standards, such as practising barristers. They have also had the opportunity to hear from Mike Knight on practice and procedure before the UK IPO.

In response to student feedback, NLS is now developing additional provision using the university's NOW online learning workspace to add lectures and materials that can be accessed by students prior to the course. A new group of practitioner tutors has recently undergone a Train the Trainers session to join the teaching team in October 2014, and NLS is always interested in hearing from members of the profession who would like to contribute to the course.

**Jane Jarman, Reader, Nottingham Law School**

For detailed information on the course, visit [ntu.ac.uk](http://ntu.ac.uk)

**NEW  
ROUTE:  
SIGNIFICANT  
STATS**

*As the new route to qualification begins to bed in, here is some data on its development.*

**55 students** attended the Certificate in Trade Mark Law and Practice (QMUL) in 2012-2013.

*Of these, **52 students** passed; nine with distinction and 19 with merit.*

### **Advice**

Many paralegals and trainees are keen to get on with training and qualification as soon as possible, but it goes without saying that the more practical experience you have, the easier and the more beneficial you will find the training. So it's not necessarily a bad thing if you don't get on to the course as quickly as you would like.

Also, do your research and give some serious thought to the options available. QMUL and Bournemouth University (which offers a Postgraduate Certificate in IP, see box right) offer quite different courses. For example, although QMUL is based in London and convenient for local attendees, the Bournemouth course offers a more intensive learning experience and requires attendees to take less time out of the office.

Once you make it on to the course, be prepared to be organised in both



All **9** students who chose to take the Postgraduate Certificate in IP Law course (Bournemouth) passed the course.

A total of **24** students attended the Professional Certificate in Trade Mark Practice (NLS) for 2013. Of these, 19 passed at first attempt (79.2%).

Source: ITMA Annual Report 2013. Statistics provided to ITMA by the institutions concerned

your work and academic life. Given the amount of material that you will need to cover before your exams, you will need to be on the ball – and better yet, proactive – to ensure you have covered everything you need. If you're struggling, you need to give feedback to your course leader without delay, otherwise you should expect to be in for more of the same!

On a related note, the surest way of succeeding on these courses is to learn on the job. Make the most of all the resources you have around you in your day-to-day working life, both in your firm and in your address book. Regardless of how enjoyable you find the process of conducting your own research, getting a view from colleagues can be invaluable.

Find out more about the qualification process at: [itma.org.uk/careers](http://itma.org.uk/careers)

## PROVIDER PERSPECTIVE: POSTGRADUATE CERTIFICATE IN IP LAW

***“[Student] diversity brings fresh perspectives and insights that challenge conventional ways of teaching law”***

Teaching the students of the Postgraduate Certificate in IP Law is a very rewarding experience. The cohort is diverse and includes students coming from the profession, but also many who have a background in science, business and the humanities. Only a minority of the student body arrives after taking a traditional undergraduate law degree. This diversity brings fresh perspectives and insights that challenge conventional ways of teaching law, and make the learning environment vibrant and productive for both students and instructors.

With this diversity, however, comes also a challenge. Some students experience initial difficulties in familiarising themselves with the legal language and, most importantly, the legal way of reasoning and approaching practical problems. The main challenge for instructors is to introduce legal concepts gradually and systematically, connecting them with professional experience, without losing rigour and depth. Students are rewarded by progressively improving their ability to navigate the intricacies of statutory and common law. Trade mark law does not live in isolation, but is part of a more complex system of law. Assimilating the statutory language and the courts' key arguments is a crucial step on the path towards the qualification as a Trade Mark Attorney.

### **EMPLOYER SUPPORT ESSENTIAL**

The collaboration of the employer is an essential ingredient in a successful completion of the training process. Particularly when the deadline for submitting assignments approaches, students may find themselves running short of time due to professional commitments. Course providers can give an estimate of the time needed to prepare an essay or exam, but this is always rough and based on the experience of previous years, so may not apply to all individual cases. A student may, therefore, need to spend more time on preparing an essay or on completing an e-activity than expected. Employers can support the student by allowing for a more balanced workload and extra time to concentrate on their homework.

**Professor Maurizio Borghi, Convenor, Bournemouth University**



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# TRANSITION DECISIONS

*Jane More O’Ferrall offers her thoughts on how to best navigate the journey as you move from trainee to qualified Trade Mark Attorney*

**O**n the way to qualification there is a wide variance in the range and complexity of work with which a trainee may be involved, and therefore probably no “typical” experience.

If you are in private practice, have you had your own book of work, and have you had sole responsibility for managing client relationships? If not, transitioning to this point will be a key aim after qualification.

If you are in-house, have you had a range of UK and Community Trade Mark experience, as well as coordinating work in other jurisdictions?

To a greater or lesser extent, depending on your background, you will benefit during the transitional phase from being exposed to:

- making judgement calls under time pressure regarding freedom to use a new brand or new packaging;
- a range of contentious work;
- supervisors or clients (internal or external) who challenge your advice and how you deliver it;
- professional or industry events, where you can begin building a network of trusted contacts; and
- training (of administrators or new recruits to the attorney profession) and wider management responsibilities.

Your own practice will benefit if, at your place of work, there are:

- qualified Trade Mark Administrators and/or dedicated secretarial support;



- collaborative colleagues and a culture of discussion and sharing ideas on difficult issues; and
- a bespoke trade mark records and case-management system.

An in-house role may typically provide most exposure to related legal areas such as copyright, advertising regulations and licensing. There will likely be departmental budgets, and one of your roles may be conducting price negotiations with external suppliers.

In private practice there will always be an emphasis on productivity in terms of billed hours or fee income, as well as on business development activities. In this environment you may be exposed to a wider variety of legal problems relating to trade marks and designs.

It goes without saying that good time management and work methodologies are important in all roles.

Finally, some understanding of litigation is increasingly important for Trade Mark Attorneys. Even if you do not see yourself as a natural advocate and dislike the idea of standing up in court, a knowledge of the sharp end can assist with opposition practice, in negotiations with third parties, and with giving sound strategic advice. Further, in the evolving global trade mark environment, there may be a limited place for Trade Mark Attorneys whose practice is only prosecution-based. You should take any opportunities to become involved in inter

partes proceedings at the UK IPO or OHIM, and to develop your advocacy skills through ex parte and inter partes hearings at the UK IPO.

Whichever route you choose, there are many exciting opportunities available for qualified and experienced attorneys. We work in a fast-moving area of the law and good practitioners never stop learning.

Good luck!

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Jane served on the ITMA Committee that established the current CPD scheme for UK Trade Mark Attorneys.



## SOCIAL MEDIA IS NOT JUST FOR TEENAGERS

*Why have attorneys been slow to grasp the opportunities that social media presents? Bernard Savage offers an explanation*

**T**here are several possible reasons for the slow adoption of social media applications such as LinkedIn, Twitter, Facebook and blogs by attorneys.

For one, the IP profession is naturally slow to adopt new marketing and business development tools, when compared to other professional service firms. For example, Customer Relationship Management (CRM) tools have been used in the legal and accountancy sectors for more than 10 years, but only over the past two years or so have IP firms begun exploring the opportunities that CRM presents.

There is an aversion to “fluffy” marketing, which is not seen as scientific, and the outputs of which are difficult to measure.

There is a lack of in-house or external marketing and business development expertise. And, without prompting, attorneys will revert to type and do what they are

comfortable and familiar with. In other words, not social media.

However, there is another reason... a misconception that social media is the preserve of teenagers, given the universal popularity of Facebook with that group. Yet, social media is not just for teenagers; particularly when LinkedIn is employed, it can be a powerful channel through which to build both personal and firm visibility at negligible cost.

So what exactly are the benefits of marketing online and what should be the priority for time-poor and sceptical attorneys? Here are three compelling reasons to embrace social media:

- 1) Staying visible to clients, referrers and targets. Winning business is largely down to being likeable and staying visible. The best way to do this is to maintain regular face-to-face contact. When so many important contacts are located overseas this can be difficult and expensive in practice, but social media can fill any gaps.
- 2) Positioning yourself or your firm as go-to experts. Contributing to blogs,

LinkedIn group discussions and sharing articles via social media applications can help position your brand. Posting content on such vehicles amplifies key messages, for example sector credentials or specialist technical capabilities.

- 3) It provides a powerful research tool to help you get closer to key markets and individuals.

The key thing to remember is that, even if you are not a believer in social media, some 85 per cent of the business world is – so people will check your profile to evaluate you and your firm. What conclusions will they reach if: personal profiles don't exist for your firm's members; profiles are incomplete; and/or profiles are not in tune with the brand promises?

Not all social media tools are the same, or for the same audience, and LinkedIn is the best-fit tool for attorneys. A little-and-often approach is the smartest way to get value from this powerful tool. The easiest way to implement this method is to use the Shared Update facility on LinkedIn to promote events via hyperlinks and to contribute to discussions via the Group facility.

*ITMA operates a LinkedIn Group and invites all members to join.*



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# BLACK AND WHITE

(AND READ ALL OVER)

*Claire France brings news of how OHIM has implemented new common practice for examination of monochrome marks*

**O**HIM has been pursuing its convergence programme in conjunction with The European Trade Mark and Design Network, with the aim of harmonising the practice of the European national trade mark offices. Most recently, it has included in its Examination Guidelines guidance in common practice relating to the scope of protection of black and white and greyscale trade marks.

Before this practice change was announced, the generally acknowledged approach in Europe was that registering a mark in black and white gave protection for all colours. However, certain national offices within the European Union (EU) state that these marks are only protected in black and white. The common practice provided guidance for marks registered in black and white and/or greyscale, and set out how to determine

whether the same mark in colour is to be considered identical with regard to priority claims, relative grounds for refusal and proof of use.

## **Common confirmation**

On 2 June 2014, OHIM issued a press release confirming that the agreed common practice on black and white and greyscale marks has been implemented into its Examination Guidelines.

The following sections have been updated to incorporate the agreed common practice:

*Priority claims – OHIM Guidelines for Examination – Part B, Examination, Section 2 Examination of formalities*  
OHIM states that this new guideline broadens the scope of “identity”. Whereas previously OHIM would object to any difference in the marks, it now considers that, where there is an insignificant

difference, a mark in colour and the same mark in greyscale or black and white will be considered “identical”.

This means in practice that if a trade mark owner applying for a Community Trade Mark (CTM) wishes to claim priority from a black and white mark for a colour filing, the trade mark owner will need to show that the addition of colour is an “insignificant” change that would go unnoticed by average consumers. It will be interesting to see how this is applied and what level of difference between a colour and a greyscale mark would be considered “insignificant”. OHIM has helpfully provided several examples of acceptable and unacceptable priority

claims in the updated guidelines.

*Relative grounds – OHIM Guidelines for Examination – Part C, Opposition, Section 2 Identity and likelihood of confusion, Chapter 3 Comparison of Signs*

In a similar assessment to the priority claim, the guidelines note that, for the marks to be identical, the difference between the prior mark in colour and the same mark in greyscale or black and white needs to be so insignificant it could go unnoticed by the average consumer. In particular, the guidelines state: “It is only under exceptional circumstances that the signs will be considered identical.”

To support this point that black and white marks do not cover all colours,

OHIM also includes a reference to a General Court decision – T-623/11, ‘Sobieraj (MILANÓWEK CREAM FUDGE) – that states: “The proprietor of a mark may use it in a colour or a combination of colours and obtain for it, as the case may be, protection under the relevant applicable provisions (...) does not mean (...) that the registration of

a mark which does not designate any specific colour covers ‘all colour combinations which are enclosed with the graphic representation’.”

This means that trade mark owners will not be able to rely on the identity of two marks where their earlier mark is registered in black and white, and the later mark they are challenging is in colour. They will therefore need to rely on the likelihood of confusion grounds in opposition proceedings.

*Proof of use – OHIM Guidelines for Examination – Part C, Opposition, Section 6 Proof of use*

The amendment to the guidelines clarifies that a change in colour alone does not alter the distinctive character of the mark for the purposes of assessing use, provided that:

- the word or figurative elements coincide and are the main distinctive elements;
- the contrast of shades is respected;
- the colour or combination of colours does not have distinctive character in itself; and
- colour is not one of the main contributors to the overall distinctiveness of the sign.

This approach should give trade mark owners with a black and white registration protection

in respect of colour versions of the same mark, to the extent that the mark is not distinctive by virtue of the colours used.

However, if the owner of the registration wants to show genuine use of its black and white mark by use in colour, it will need to show that the distinctive character of the mark is not altered, meaning that the layout of the device is identical and the colour is not the core distinctive element. It will also need to show that the colour contrasts or shading are substantially the same as between the two versions of the mark.

## Position in practice

In light of this implementation, trade mark owners will need to more carefully consider the colours in which a mark is intended to be used as this will affect the assessment in an opposition proceeding and could also have a bearing on whether a mark is vulnerable for non-use.

Overall, trade mark owners will need to think strategically about whether they will need to file applications for both black and white and colour versions of the mark, particularly where the colour is a key element of its distinctiveness.

*Trade mark owners will need to more carefully consider the colours in which a mark is intended to be used*



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## NATIONAL MARK HOLDS FIRM

*Gunnar Sigurgeirsson  
introduces readers  
to a recent case of  
interest in Iceland*

**O**n 6 April 2011, a national application was filed with the Icelandic Patent Office for the word mark “sushisamba” (application 1030/2011), for “restaurant services” in the name of Sushisamba ehf, (the Applicant) Reykjavik, Iceland. The application was published on 15 July 2011, registration number 489/2011.

On 8 August 2012, a notice of opposition was filed by a local agent on behalf of Samba, LLC (the Opponent) against the registration at the Icelandic Patent Office, based on the argument that the mark was registered contrary to Articles 7 and 9, paragraph 1, Article 14 of the Icelandic Trade Mark Act No 45/1997, cf Article 30 and Article 28 of the same Act, claiming administrative cancellation.

### **Background facts**

The Opponent owns the trade mark SUSHISAMBA, registered in several countries around the world, and also restaurants of the same name in

New York, Miami, Chicago, Las Vegas and in London. Although it does not own a registration for the mark in Iceland, the Opponent claims that the Applicant should have been aware of the trade mark “Sushisamba”, as well as the allegedly world-famous restaurants and, therefore, applied for the mark and used it for the Sushisamba restaurant in Reykjavik in bad faith and to use the good reputation of the Sushisamba trade mark and restaurants abroad.

The Applicant refused the above opposition, claiming that it is not sufficient to prove that a mark is well known in other countries for it to automatically gain protection in Iceland. Instead, it must be proved that a trade mark is well known in

and with OHIM for the same level of service at the time of the application submitted in Iceland.

According to appeal rulings on industrial property rights, provisions 7cl, paragraph 1, Article 14 of the Trade Mark Law applies for trade marks that are either registered or used in Iceland, but, with regard to Article 6bis Paris Convention for the Protection of Industrial Property, protection is granted in the country if the mark is considered to be “well known” cf Appeal ruling no 6/2004. In assessing whether a particular trade mark is considered well known in a country within the meaning of that provision, one must look to whether the mark is considered well known within the relevant business group of the product

known about the foreign mark does not alone satisfy the requirements of the provision regarding proof of bad faith; it may be necessary to check each applicant’s intention regarding the hindrance of another person’s involvement in the local market. The intention of the applicant is the subjective factor that must be evaluated based on all incidents, including objective facts of each case, cf, for example, paragraph 36, C-320/12.

In addition to the above, it must be thought that the owner was, at the time of the application, a professional with extensive experience and knowledge of the restaurant business, as the Applicant in this case claims. Given that, it is likely that the owner did know, or should have been aware of, the existence of the Opponent’s mark when the application for registration of the mark was filed.

## *The Opponent claims the Applicant should have been aware of the trade mark as well as the allegedly world-famous restaurants*

Iceland among a large part of the possible target group; because the Opponent’s mark is not registered in Iceland nor proved to have been used in the country before, this should not be possible.

### **Crucial issues**

The parties agreed that the assessment of bad faith in this matter should be based on the OHIM guidelines on examination of Community Trade Marks. These note that no definition exists of the term “bad faith” as used in the Community Trade Mark Regulation, and that “good faith is presumed until proof to the contrary is adduced”.

According to Article 14 of Iceland’s Trade Mark Act, a trade mark cannot be registered if it is likely to be confused with a trade mark deemed well known in the country at the time of application. It is beyond dispute that the Opponent’s trade mark has been used as an identifier for a chain of restaurants in the US and the mark was registered in the US, China, Russia

and/or service. The Opponent did file with his arguments several documents as a proof of how well known the restaurants are in Iceland, all printouts of private blogs and online forums used by small groups of people. On these grounds, it seems unproved that the Opponent’s mark was well known in this country on the day of application.

Recent European case law<sup>1</sup> deals with the interpretation of bad faith in understanding Article 4(4)g of Directive 2008/95/EC, and establishes the expectation that an overall assessment of the prevailing circumstances as they were at the time the application for registration of the mark was filed will be conducted. Furthermore, that the applicant knew or should have

### **Office conclusion**

In spite of the aforesaid, the conclusion of Iceland’s Patent Office is that the use of the trade mark and goodwill abroad is not considered to have acquired legal protection in Iceland for the Opponent’s mark. It has not, in the opinion of the Patent Office, been demonstrated conclusively that the Applicant’s purpose, in submitting an application for registration of the mark for restaurant services, was to prevent the involvement of the Opponent in the Icelandic market, or to take advantage of the goodwill or benefit financially from the registration process. Furthermore, the petitioner has not taken steps to acquire trade mark protection in Iceland, despite having used the mark for 12 years.

Therefore the conclusion is that the mark “Sushisamba” shall remain in effect in Iceland.

<sup>1</sup> cf judgments in C-529/07, Chocoladefabriken Lindt & Sprüngli, 7 February 2002; C-320/12, Malaysia Dairy Industries Pte Limited v Ankenævnet for Patenter og Varemærker, 27 June 2013



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# USE IT (CORRECTLY) OR LOSE IT

*Exemplary behaviour is now required by brand owners,  
warns Barbara Sullivan*

**T**he recent High Court of New Zealand case of *Tasman Insulation New Zealand Limited v Knauf Insulation Limited* [2014] NZHC 960 (9 May 2014) highlights how important it is for brand owners to use their trade marks correctly.

The Applicant for revocation of a trade mark registration was unsuccessful as its evidence failed to prove that the mark had become a common name for the products listed under the registration and that, even if the public were using the mark as a common name, this was not caused by the brand owner's acts or inactivity.

This case is significant as it discusses in detail, for the first time, the provision in the New Zealand Trade Marks Act 2002 under which a registered trade mark may be revoked because it has become a generic term as a consequence of the actions (or inaction) of the brand owner.

## Key messages

Brand owners can learn the following lessons from the decision:

- Brand owners must ensure their use of their own trade marks is "exemplary".
- Market leaders should provide members of the trade and the public

with a generic name to use for a product that can serve as a noun to the adjectival function of the trade mark.

- To the extent possible, brand owners must be vigilant in monitoring for inappropriate use of their trade marks and must have policies in place for taking action to prevent misuse.
- Careless or ignorant use by the public of a trade mark as a generic term is not necessarily fatal to the registration, unless it is coupled with acts or inactivity by the brand owner that contribute to the generic use.
- There is a "heavy burden" on the applicant for revocation to prove that the brand owner's actions (or failure to act) caused the trade mark to become a common name in general public use.

## Background

*Tasman Insulation New Zealand Limited* ("Tasman") has sold fibreglass insulation segments in New Zealand since at least 1973 under the PINK®, BATTIS® and PINK BATTIS® trade marks, and it has maintained a registration for the BATTIS trade mark since this time.

Knauf Insulation Limited ("Knauf") exported to New Zealand some of its insulation products that featured the words "batt" and "batts" on the packaging and in the installation

instructions. Knauf considered these words to be generic terms (as they are in Australia and the US).

A shipment of Knauf's products was detained by New Zealand Customs. This provoked an application by Knauf under section 66(1)(c) of the Trade Marks Act 2002 ("the Act") to revoke Tasman's registration for BATTIS on the basis that, as a consequence of acts or inactivity of Tasman, the term "batts" had become a common name used by the New Zealand public for insulation products. Tasman counterclaimed on trade mark infringement grounds.

## Revocation for non-use

Knauf's first attack on the validity of Tasman's BATTIS registration was based on the proposition that Tasman had not been making genuine use of BATTIS as a trade mark. Hence, the BATTIS registration ought to be cancelled on the ground of non-use.

In other words, was Tasman's own use of BATTIS "consistent with the essential function of a trade mark as a badge of origin"?

Knauf argued that the consistent use of BATTIS solely in conjunction with the trade mark PINK (which was a mark licenced to Tasman) meant that BATTIS was, at best, a "limping" trade



mark.<sup>2</sup> At worst, BATTs did not operate on its own as indicating to consumers the origin of the products.

The Judge, Justice Brown, noted that “it is possible for a mark to acquire distinctiveness even as part of another mark”. He concluded that it therefore follows that use of a mark in conjunction with another registered trade mark does not disqualify it from consideration as genuine use.<sup>3</sup>

Importantly, Tasman used the ® symbol with BATTs. This helped the Judge find that Tasman used BATTs in “a style calculated to signal that its role was to denote the source of the goods and hence to function as a badge of origin”. Use of the ® symbol is not mandatory in New Zealand, however, so this serves as a timely reminder to brand owners that it is good practice to use the symbol as a notice to the world at large that a mark is registered.

## Key questions

Section 66(1)(c) of the Act provides that a trade mark registration may be revoked on the ground: “That, in consequence of acts or inactivity of the owner, the trade mark has become a common name in general public use for a product or service in respect of which it is registered.”

So has the trade mark become a common name in general public use for the product in this case?

After referring to the “heavy burden” faced by an applicant for revocation, the Judge held that Knauf’s evidence had not established that the trade mark BATTs was a common name for insulation materials in New Zealand.

This was despite noting that the evidence demonstrated a “not insignificant amount of what appears to be generic use”,<sup>4</sup> as well as “a degree of loose terminology”.<sup>5</sup>

The case makes it clear that becoming a household name does not make a trade mark the generic name for a product.<sup>6</sup>

Next, if the mark is a common name, did this occur as a result of acts or inactivity by the trade mark owner?

The Judge then considered, in case he was wrong on the common name point, whether Knauf had established

*The case makes it clear that becoming a household name does not make a trade mark the generic name for a product*

that any common use of BATTs was as a result of Tasman’s acts or inactivity. He found that Knauf had failed to prove this causation limb.

A review of Tasman’s marketing materials and packaging concluded that Tasman’s own use of its trade mark was “almost exemplary”.<sup>7</sup> Tasman was able to produce evidence of regular internal communications and style guides aimed at ensuring correct use by staff. Hence, Knauf was not able to establish that Tasman’s own actions had caused BATTs to become a common term.

Tasman also produced evidence of its compliance programme. It sought the cooperation of customers to alert it to

misuse of the BATTs trade mark. The compliance programme inevitably included a policy to prioritise the prevention of misuse in commercial marketing and sales, rather than general internet or media misuse or misuse in academic papers.

The Judge noted that Tasman’s failure to conduct television or print advertising campaigns regarding the status of BATTs did not constitute “inactivity”. The Judge also found that Tasman was “slow to recognise”<sup>8</sup> the damage caused by third-party misuse on an online trading website. However, this did not constitute inactivity.

## Infringement

Having upheld the BATTs registration, the Judge considered whether or not Knauf’s use of “batt” or “batts” in its installation instructions constituted trade mark infringement. This required an assessment of whether Knauf was using “batt” or “batts” in such a manner as to render the use likely to be taken as being use as a trade mark.

The Judge focused on the impression that the use of the words would have had on members of the public who encountered them at the time the products were being sold. Knauf used “batt” and “batts” in the same font size and colour as other text in densely written instructions. In this context, the Judge concluded that the public would not perceive this as being use as a trade mark therefore there was no infringement.

However, the Judge also considered Knauf’s use of “Batt” in HTML code on its website. This “invisible” use of a word as a metatag was found to be use as a trade mark and an infringement (because the mark “can be accessed and viewed by an informed internet user”).

Both parties have appealed this decision.

<sup>1</sup>) Tasman Insulation New Zealand Limited v Knauf Insulation Limited [2014] NZHC 960, at paragraph 75, citing *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 (ECJ) <sup>2</sup>) See *Philips Electronics BV v Remington Consumer Products* [1998] RPC 283, at 296 <sup>3</sup>) *Tasman Insulation New Zealand Limited v Knauf Insulation Limited* (supra), at paragraph 81 <sup>4</sup>) *Ibid*, paragraph 135 <sup>5</sup>) *Ibid* <sup>6</sup>) *Ibid*, paragraph 93 <sup>7</sup>) *Ibid*, paragraph 173 <sup>8</sup>) *Ibid* <sup>9</sup>) *Ibid*, paragraph 236



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# COLOUR CATCH-UP

*Joseph Calvaruso brings us up to date  
on the subject of enforcement and protection  
of colour marks in the US*

Consumers in the US are constantly bombarded in the media with advertisements for various products and services. As a result, they are used to associating such products and services with their respective brands or trade marks, including word marks, name abbreviations, logos and slogans. Historically, however, consumers have not perceived a colour to be an identifier per se for a singular source of goods or services. Nonetheless, as we will see, colour trade marks can be both registered and enforced if they are able to distinguish one source from another and are not functional or merely ornamental.

US law defines a trade mark as: “Any word, name, symbol, or device, (1) used by a person... to identify and distinguish his or her goods, from those manufactured or sold by others and to indicate the source of the goods.” 15 USC § 1127.

The statutory definition of a trade mark is very broad and, on its face, can

include just about anything. However, prior to the mid-1980s, the courts, as well as the United States Patent and Trademark Office (USPTO), were not very receptive to granting trade mark protection to colour marks.

## Qualitex effect

The breakthrough for the protection of colour marks was the US Supreme Court decision in *Qualitex Co v Jacobson Prods Co*, 514 US 159 (1995). In *Qualitex*, the goods were press pads and covers for press pads for use in connection with dry-cleaning presses. The Applicant sought to register a “special shade of green-gold color” applied to the press pads. *Id* at 160. The USPTO had allowed the mark to register, but when suit was brought to enforce the mark against a competitor, both the District Court and Court of Appeals held the registration to be invalid.

The Supreme Court reversed, holding that:

- “[T]he language of the Lanham Act describes [the universe of things that can qualify as a trade mark] in the

*broadest of terms... [s]ince human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally is not restrictive.”* (Emphasis added)

- “When a color meets “ordinary legal trademark requirements... no special legal rule prevents color alone from serving as a trademark.” *Id* at 174. *Qualitex* made clear that when a colour has attained secondary meaning, and is able to identify a particular brand, colour can, indeed, function as a trade mark and source identifier.

## Remaining obstacles

So the good news was that a colour can be a trade mark. And colours of certain goods have been able to become source identifiers for well-known brands. For example, the luxury jeweller Tiffany & Co has registered its famous Tiffany Blue colour as a trade mark. Described in USPTO documents as “a shade of blue often referred to as robin’s egg blue”, the hue has been captured in a private,

## The process of actually registering and enforcing colour marks is not smooth sailing

custom colour by Pantone, under number 1837.

Notwithstanding *Qualitex*, however, the process of actually registering and enforcing colour marks is not smooth sailing. The courts have generally held that a colour mark is not inherently distinctive, and they require proof of secondary meaning.<sup>1</sup> Colour marks can also be vulnerable to attack on the basis of functionality.

### *Secondary meaning*

A mark has secondary meaning when it can be shown that the consuming public associates the mark with a single source.<sup>2</sup> One way to prove secondary meaning is by direct evidence, such as testimony from individual purchasers, or consumer surveys showing that the mark is associated with a single source. Secondary meaning can also be proven through indirect evidence, such as substantial advertising expenditure, the types and extent of advertising, the length, manner and exclusivity of use, sales success, and unsolicited media coverage of the goods or services. See 37 CFR § 2.41; TMEP § 1212.06.

A good illustration of how an applicant can establish secondary meaning in a colour mark is illustrated in the case of *In re Owens-Corning Fiberglass Corp*,

774 F.2d 1116 (Fed Cir 1985). In the *Owens-Corning* case, the Federal Circuit upheld the registrability of the colour pink for home insulation material and allowed pink to operate as a trade mark and source identifier.

The Court considered advertising and sales information demonstrating that Owens-Corning's pink colour had established secondary meaning. For example, Owens-Corning had advertised its colour pink for home insulation for about 30 years and had spent upwards of \$40 million dollars on its advertising and promotion. Significantly, the advertising emphasised the pink colour of the product by using the slogan "Think Pink" and incorporating the famous Pink Panther cartoon character.

### *Functionality*

The courts have held that a feature is functional and thus not protectable, if:

- it is essential to the use or purpose of the product; or
  - it affects the cost or quality of the product and would put competitors at a significant non-reputation-related disadvantage.
- (*Traffix Devices, Inc v Mktg Displays, Inc*, 532 US 23, 33, (2001); *Qualitex Co v Jacobson Prods Co*, 514 US 159, 165 (1995))

Certain colours are clearly functional in nature. For example, the USPTO notes that yellow and

orange are examples of functional uses for safety signs.<sup>3</sup> The colour of pharmaceutical products has also been held to be functional in so far as colour identifies a particular medication and/or a certain dosage.<sup>4</sup>

### **Fashion and functionality**

Colour is important to the appeal of fashion designs. Does that mean colour cannot be protected in fashions?

A recent high-profile case involving a well-known colour mark in the fashion industry was *Christian Louboutin v Yves Saint Laurent*, 778 F Supp 2d 445 (SDNY 2011). *Louboutin* owns US Registration No 3,361,597, which covers the colour red as used on the soles of shoes.

*Yves Saint Laurent* marketed shoes that had red soles. In fact, the *Yves Saint Laurent* shoes were entirely red in colour. *Christian Louboutin* sued *Yves Saint Laurent* for trade mark infringement and sought a preliminary injunction. The District Court denied the preliminary injunction, holding that *Louboutin's* registration was likely not valid based on aesthetic functionality. The Court held:

"[W]hatever commercial purposes may support extending trademark protection to a single color for industrial goods do not easily fit the unique characteristics and needs – the creativity, aesthetics, taste and seasonal change – that define production of articles of fashion." 778 F Supp 2d at 451-453.

The Court's decision was very controversial. There was no real dispute that *Louboutin* had shown its mark had acquired secondary meaning and was distinctive. →

Consumers of high-fashion designer women's shoes readily recognised red-soled shoes as originating with Louboutin. So the Court's holding that a well-recognised colour mark was not entitled to any protection in the fashion industry set off alarms throughout the trade mark community.

The Court of Appeals for the Second Circuit reversed the District Court's finding, holding that a single colour can, indeed, serve as a trade mark in the fashion industry so long as secondary meaning is established.<sup>5</sup> The Court held that there was substantial evidence showing that Louboutin's Red Sole mark had acquired secondary meaning and was therefore a distinctive indicator of source. There was proof of extensive advertising expenditures, media coverage, sales success and consumer surveys. However, the Court did qualify, to some extent, its holding of secondary meaning. Specifically, the Court noted that, while Louboutin had established secondary meaning in the marketplace, such secondary meaning only applied to shoes where the red sole contrasted with the colour of the remainder of the shoe.

Consequently, the Appellate Court held that the Red Sole mark was strictly limited to the use of a red sole in a shoe with a contrasting upper, and that Yves Saint Laurent's use of a red sole without a contrasting upper does not infringe.

The Second Circuit then took an additional, very interesting step, operating under a provision of the Trademark Law that generally gives the court power over trade mark registrations.

In particular, the Court ordered: "Pursuant to 15 USC § 119, the Director of the United States Patent and Trademark Office shall make appropriate entry upon that Office's records to reflect that US Trademark Registration No 3,361,597 held by Christian Louboutin and dated January 1, 2008, is limited to a red lacquered outsole on footwear that contrasts with the color of the adjoining ('upper') portion of the shoe." (Emphasis added)



## *The Red Sole mark was limited to the use of a red sole in a shoe with a contrasting upper*

### Colour in practice

So it is clear that colour marks can be registered and enforced in the US. However, colour marks are a special breed of trade marks, and there are certain actions a trade mark owner should consider to successfully register and enforce one.

For example, it is a good strategy to emphasise the colour mark in promotional materials and advertising. In addition, the trade mark owner should collect any customer complaints or inquiries regarding infringing products that may demonstrate a likelihood of confusion between marks. The trade mark owner also should

gather third-party press articles and examples of independent, unsolicited media statements that reference the colour mark. Each of these types of evidence will be important in demonstrating that the colour mark has acquired distinctiveness and can therefore function as a source indicator.

- 1) Walmart Stores, Inc v Samara Brothers, Inc, 529 US 205, 211-212 (2000)
- 2) TMEP § 1212.03 Inwood Labs, Inc v Ives Labs, Inc, 456 US 844, 851 n.11, 214 USPQ 1, 4 n.11 (1982)
- 3) TMEP § 1202.05(b)
- 4) Shire US Inc v Barr Labs, Inc, 329 F.3d 348 (3rd Cir 2003)
- 5) Christian Louboutin v Yves Saint Laurent, 696 F.3d (2d Cir 2012)



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# Non-starter for Jumpstar

*The Defendants' arguments failed to spark, says Jake Campbell*

**T**his case concerned the validity of the trade mark JUMPSTAR in class 9 for batteries, battery chargers, etc in defence of an infringement claim. The JUMPSTAR product charged vehicle batteries through car cigarette lighters. Although technically it didn't "jump start" the vehicle, it was advertised as such. The Defendants admitted infringement, but claimed that JUMPSTAR was invalidly registered on the following three grounds, all of which ultimately failed.

*1) JUMPSTAR designates a characteristic of the goods – Trade Marks Directive, Article 3(1)(c)*

The Defendant argued that JUMPSTAR was so highly similar to the word "jumpstart" that the average consumer would mistake one for the other, and the mark was therefore descriptive. The central point of debate was whether the lack of a "t" at the

end of the word made any difference to the average consumer's perception of the mark and whether they would see that distinction as significant. The Defendants' evidence that: (1) they had ordered 1,000 JUMPSTAR batteries but had described them as a "Jump Start Battery"; (2) their trade mark agent's staff had sometimes typed letters including the "t" by mistake; and (3) counsel for the Defendants said that accents of some people may not pronounce the "t", were unable to persuade the Judge that the average consumer would perceive JUMPSTAR to mean JUMPSTART. The Judge held that "the mark JUMPSTAR, accurately perceived, alludes only to the twin ideas of jump and star", and was therefore not precluded from registration under Article 3(1)(c).

*2) JUMPSTAR is devoid of distinctive character – Article 3(1)(b)*

The Defendants claimed that the mark had already been used by multiple traders and so could not distinguish the goods of one undertaking from those of another. They pleaded six uses of JUMPSTAR by parties other than the Claimants prior to the mark's application date in October 2012. However, the Defendants adduced insufficient evidence at trial and failed to show that the mark's capacity to serve as a badge of origin had been diminished. This claim therefore failed.

*3) Bad faith – Article 3(2)(d)*

The case is a helpful reminder that, merely because a trade mark applicant knows that other parties are already using a mark in relation to the same goods and services, this does not preclude it from applying to register the mark. The Claimants were aware that the Defendants were using the mark. However, the Judge held that, if a trade mark owner believes they have a superior right to the mark, then the application cannot have been filed in bad faith. This case was complicated by the fact that the Chinese company from whom the Claimants purchased the JUMPSTAR batteries had given them the exclusive right to use the JUMPSTAR name in the UK, despite being only a co-owner of the rights. Nonetheless, the Judge was content that the Claimants' Managing Director held a belief that the Claimants held a superior right in the mark and filed in good faith.

## Final thoughts

The case demonstrates the importance of importers into the UK clarifying their relationship with their foreign business partners when it comes to conferring trade mark rights. Both parties had imported JUMPSTAR batteries from China, but neither could demonstrate who owned the JUMPSTAR mark in China, which is why the Defendants thought their bad faith argument had some weight.

It is surprising that the case made its way to court given the limited evidence. The most interesting aspect is the Defendants' assertion that, because JUMPSTAR alluded to a characteristic of the product, it was merely descriptive. Trade mark owners can take comfort in the Judge's comments that "the power of a trade mark to allude to attractive qualities can make for a commercially valuable (and valid) trade mark".

The case demonstrates the importance of importers into the UK clarifying their relationship with their foreign business partners



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# The problem with passing off

*It may take a miracle to convince the Court, believes William Miles*

**P**assing off has always been a difficult claim to pursue and something with which our European colleagues have never had to trouble themselves. This recent decision, in favour of a company that actively advertises the similarities between its products and major brands, highlights to practitioners the importance of misrepresentation in the classic trinity of passing off.

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## Background

The Claimant, Moroccanoil Israel Limited (“MIL”), is an international haircare brand that has enjoyed great success in the UK since the launch of its products in 2009. By far the most popular product in its range is a hair oil known as “Moroccanoil”. This product is contained within a brown apothecary-style bottle packaged inside a blue and orange box.

The Defendant (“Aldi”) is a well-known supermarket with a reputation for selling products with a similar look and feel to major brands, but at a fraction of the price. In March 2012, it began selling a hair oil under the name “Miracle Oil”, which was also contained within a brown apothecary bottle inside a blue and orange box.

## The law

Both parties agreed that for MIL to succeed it had to establish the three points set out in *Rickitt & Colman Products Limited v Borden Inc* [1990] 1 WLR 491; [1990] RPC 34 (“Jif Lemon”), namely:

- 1) Goodwill - in relation to both the product name and the get-up.
- 2) Misrepresentation - regardless of intention.

- 3) Damage - as a consequence of selling the product.

Unsurprisingly, much of the legal debate in this case focused on the possible forms of misrepresentation and the actual definition of confusion.

MIL suggested that misrepresentation could take three distinct forms. First, a scenario in which a consumer sees Miracle Oil in an Aldi store and mistakenly believes it to be Moroccanoil (Jif Lemon). Second, the consumer sees Miracle Oil and assumes, due to its striking similarities to Moroccanoil, that it must also have been made by MIL (United Biscuits (UK) Limited v Asda Stores Limited [1997] RPC 513). Third, as an extension of the second, that a consumer believes Miracle Oil is made under licence from MIL.

His Honour Judge Hacon warned early on in his judgment that the term “confusion” was not helpful in a passing off claim, although it had encroached on many other such claims as a result of trade mark legislation (trade mark and passing off actions having frequently been fought together). Confusion – for example, where a member of the public wonders if the products are the same – is distinct from deception, for example, when a member of the public assumes that the products must be: (a) the same; (b) from the same manufacturer; or (c) produced under licence.

It is well established that a substantial proportion of the relevant public will need to make the incorrect assumption to establish a claim in passing off. Although both Counsel agreed that 15 to 20 per cent was probably the most accurate quantification of a substantial proportion, HHJ Hacon held that a fixed percentage was not particularly useful, and said:

“I think the better approach is instead to consider what evidence there is relating to the assumption in issue, to take into account the cogency of that evidence, in broad terms the size and nature of the



market in question and the channels of sale, and then assess whether it is likely that sufficient individuals have made or will make the false assumption such as to cause material damage to the goodwill of the claimant.”

On the question of initial interest confusion, the parties relied on different judgments. Counsel for MIL – citing Och-Ziff Management Europe Limited and another v Och Capital LLP [2010] EWHC 2599 (Ch), [2011] FSR 11 – said that there could be passing off even if the misrepresentation is dispelled before the customer reaches the till. Counsel for Aldi

referred to Woolley and another v Ultimate Products Limited and another [2012] EWCA

Civ 1038 and argued instead that,

if a purchaser is misled initially but their confusion disappears before making the purchase, then there is no actionable misrepresentation.

HHJ Hacon held that the two judgments did not actually conflict, but instead referred to different forms of passing off. He said that the key distinguishing factor was damage. In Och-Ziff there was goodwill and a likelihood of a false assumption as to the trade origin made by the relevant public. There was no pecuniary loss (as the confusion had been dispelled before the purchase). However, Arnold J had found the probability of other damage. In Woolley, this other damage was not found and, because there hadn't been damage caused by the purchase of the product, there was no actionable claim for passing off.

MIL accepted that there was no explicit evidence of confusion in this case, but cited Samuel Smith Old Brewery (Tadcaster) v Lee (trading as Cropton Brewery) [2011] EWHC 1879

### Moroccanoil



### Miracle Oil



(Ch), [2012] FSR 7 in its submission that absence of any actual confusion is not relevant to the assessment of passing off. The Court followed Arnold J's assessment of this and held: "Absence of evidence of actual confusion is not conclusive, but in considering the weight to be attached to that absence it is relevant to consider what opportunity there has been for confusion (a) to occur and (b) to be detected."

Counsel on both sides agreed that damage could be inferred if misrepresentation was established.

### Decision

The Court found that MIL had successfully shown that goodwill existed both in the name of its product and the get-up.

On the issue of misrepresentation, however, HHJ Hacon held that the evidence presented – the high point of which was several consumer blogs – was not enough to show that the public would believe that Miracle Oil was Moroccanoil or that there was some sort of connection or licence in operation between the parties.

Interestingly, the Court found that Aldi had intended to make the public think of Moroccanoil when it designed Miracle Oil and that it had succeeded in that respect. However, it had not gone so far as to cause a false assumption or even initial interest confusion.

As misrepresentation could not be established, there was no possibility for damage to occur.

### Passing off problem

This decision highlights a difficult problem for practitioners. On the one hand, evidence in some form seems crucial to overcome the most important hurdle of misrepresentation. However, with the constrictions on evidence-gathering highlighted in cases such as Interflora, it may only be possible to succeed in a passing off case if completely natural evidence of misrepresentation has already presented itself.

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# Mira showered with success

*Claire O'Brien assesses the impact of a substantial award at inquiry*

**F**ollowing a damages enquiry that took place in the IPEC in April this year, Kohler Mira Limited ("Mira") has been awarded more than £227,000 plus interest and costs for unregistered design infringement by the Bristan Group Limited. The designs were embodied in Mira's striking Azora shower.

The cost of an inquiry into damages, combined with the limited cost recovery cap in the IPEC, makes such inquiries rare. However, as no acceptable settlement offer was made, Mira fought on.

Bristan raised an innocence defence pursuant to section 233(1) of the Copyright, Designs and Patents Act 1988 for the first time at the quantum stage. The discretion to allow such a defence fell to be exercised by reference to policy considerations. It failed for that reason, the Judge (His Honour Judge Hacon) holding that parties should know where they stand once the pleadings are closed.

Mira framed its main claim on the basis of lost profit on sales of showers it would have made had Bristan not infringed, plus a royalty on any additional sales of infringing showers by Bristan.

There was a significant price difference between the Mira showers, which embodied the protected designs, and Bristan's infringing showers. It could not reliably be inferred therefore that the absence of infringing showers from the market would have led to equivalent sales of Mira's originals. Mira argued that some sales would be lost in that category and others in its lower price band.

Mira's lower-priced products do not embody the designs that had been

infringed. It is possible to claim for damage to a secondary interest that is unprotected by the right that has been infringed, so long as such damage is foreseeable, caused by the wrong and not excluded by public or social policy.

The Judge held that there was not enough evidence to establish the extent to which Bristan's customers would have regarded Mira's lower-priced range of products as suitable alternatives. He thought the losses under the lost profits head were "too speculative" to provide a useful basis for calculating damages, even on a rough-and-ready basis. One wonders what kind of evidence the Judge was envisaging could be provided in the context of the IPEC to determine the case on that basis.

Damages were therefore calculated on the basis of a reasonable royalty on

infringing sales. In the absence of any comparable licences, Hacon HHJ used the "available profits" method. The Judge accepted that Mira's products had been recognised as a breakthrough in the industry. Consequently, he awarded Mira 30 per cent of the total profits available, which gave an effective royalty rate of 6.7 per cent.

No award was made for Mira's advertising and promotional costs, and there was no "moral prejudice" under the IP Enforcement Directive.

Although damages recoverable in the IPEC are capped at £500,000, in practice the awards tend to be much lower. This award is the second-highest to date in the IPEC and will help to increase awareness of the commercial value of design rights.

*Wragge Lawrence Graham & Co represented the Claimant.*

*This award is the second-highest to date in the IPEC and will help to increase awareness of the commercial value of design rights*



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Claire advises on contentious IP across the full range of IP rights. She has particular experience in the IPEC, having managed three trials in that Court since the 2010 reforms.





# LV locked out

*Stephanie Taylor unpicks an argument about distinctiveness*

**T**he case concerned an appeal to the Court of Justice of the European Union (CJEU) in respect of an application for invalidity filed by Friis Group International ApS (“Friis”) in respect of the Community Trade Mark (CTM) registration shown on this page.

## Background

In March 2004, Louis Vuitton Malletier (“LV”) applied to register the trade mark as a CTM in respect of goods in classes 9, 14, 18 and 25, and the application proceeded to registration in July 2005. In February 2007, Friis filed an application under Article 52 of the Council Regulation (EC) No 207/2009 (“CTMR”) for a declaration of invalidity on the basis that it considered the mark lacked distinctive character. The Cancellation Division at OHIM rejected the application and Friis filed an appeal in respect of classes 9, 14 and 18 only. The Board of Appeal held that the mark was invalid in respect of those goods in classes 9, 14 and 18, where LV had not successfully proven that the mark had acquired a distinctive character through use.

In 2008, LV filed an appeal to the General Court. The General Court found that the Board of Appeal had been incorrect in determining that the mark was devoid of any distinctive character in relation to some of the goods in classes 14 and 18.

The Court noted that consumers are not used to perceiving locking devices as indications of the commercial origin of goods. The Court applied existing law in respect of three-dimensional (3D) marks, namely, that only a mark which

departs significantly from the norm or customs of the sector is capable of having the requisite distinctiveness, which the Court agreed that the mark possessed in respect of certain goods in classes 14 and 18.

LV then appealed to the CJEU, on the basis that it considered that the General Court had misapplied to the case law relating to 3D marks, particularly on the basis that the mark applied for was not a 3D mark. The CJEU held that the criteria for assessing distinctiveness of 3D marks would apply here and that, in principle, the assessment should be no different to that applied to word and logo marks. However, as average consumers are not in the habit of making assumptions relating to commercial origin on the basis of the shape of goods or their packaging, it may be more difficult to establish distinctiveness in relation to a 3D mark than in relation to a word or logo mark. The CJEU therefore agreed with the General Court when stating that such a mark must significantly depart from the norms and customs of the sector to demonstrate distinctive character.

While LV attempted to argue that in the fashion sector modifications were made to elements of products such as locks to distinguish particular fashion houses, the CJEU

*It may be more difficult to establish distinctiveness in relation to 3D marks than in relation to a word or logo mark*

concluded that LV had not succeeded in demonstrating that customers were likely to make assumptions as to the commercial origin of goods based on such elements. Furthermore, the CJEU confirmed that it was correct to apply the law relating to 3D marks to an assessment of a two-dimensional mark on the basis that the trade mark was a figurative mark representing the shape of part of the goods.

### The contested mark



### Stephanie Taylor

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Stephanie works in the London office of BLP’s IP team and advises clients on a range of trade mark issues in a variety of industry sectors.

# Confidence booster

*This case confirms that decision-makers can come together, says Thomas Hooper*

The General Court has dismissed an action by Eni SpA (“Eni”) to annul the decision of the Fourth Board of Appeal of OHIM, which, agreeing with the Opposition Division, rejected in part an application for the word mark ENI on the basis that there was a likelihood of confusion with the earlier rights of EMI (IP) Limited (“EMI”), a well-known music recording and publishing company.

This case highlights the fact that, at least on this particular occasion, the opposition and appeal divisions at OHIM can apply settled case law consistently and in line with the General Court of the European Union.

## Background

On 25 July 2008, EMI opposed a Community Trade Mark (CTM) application filed for the word mark ENI (CTM 6488076) in a wide range of classes. The opposition was based on two prior marks for the word EMI (CTM 4197315) and a figurative mark in which the word EMI is dominant (CTM 6167357), shown opposite. These marks also covered a broad range of goods and services.

Following a restriction of the goods and services by the Applicant and a strategic request for the division of the contested trade mark, the goods and services to be compared for opposition purposes were “clothing, footwear and headgear” (class 25) for the contested mark and “the bringing together for the benefit of others, of a

variety of goods, enabling customers to conveniently view and purchase clothing, footwear and headgear” (class 35) for the Opponent’s figurative mark. The divisional application (CTM 9093683) then proceeded to registration without opposition being filed against it.

On October 2010, the Opposition Division upheld EMI’s opposition on the grounds of Article 8(1)(b) of Council Regulation (EC) No 207/2009 (“CTMR”) and the likelihood of confusion between the marks.

## Opposition decision

The Opposition Division rendered the figurative EMI mark to be sufficiently similar to the word ENI.

The first and last letters of the marks were the same, and only differed by the central letters “N” and “M”. Unsurprisingly, these differences had a limited visual impact due to the similarity of these consonants.

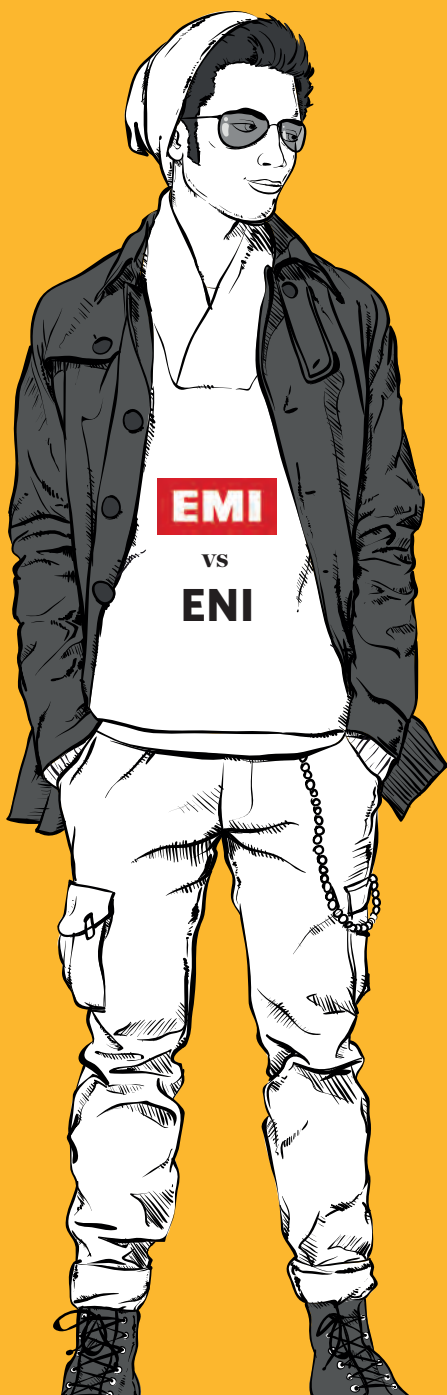
The length of the marks was also important for the aural assessment as both marks contain the same vowels and thus display an identical rhythm.

After applying the case of *Praktiker* (C-418/02, *Praktiker Bau- und Heimwerkermärkte AG*, 7 July 2005), the contested goods in class 25 were deemed similar to the retail services specified in class 35. It was considered that, although the nature of goods and services were not the same, the manufacturers of the clothing products specified will also develop their activities in the same area of the retail services specified. A consumer could therefore approach either the manufacturer or the retail service provider to acquire the products. As the marks were visually and aurally similar, and the figurative sign of low-level distinctiveness, a likelihood of confusion was found.

The Applicant’s argument that both marks had developed their own

*As the marks were visually and aurally similar, and the figurative sign of low-level distinctiveness, a likelihood of confusion was found*

*This decision provides a useful insight into the interpretation between goods and retail services*



conceptual meaning through long use and consumer recognition was unfounded. To claim a conceptual meaning capable of reducing the likelihood of confusion, the mark(s) must be truly well known.

### Appeal

The Applicant appealed the decision on the grounds that the Opposition Division erred when it decided the goods in class 25 were similar to the class 35 retail services, and also argued that both entities had developed their own distinct conceptual identity. The first Board of Appeal of OHIM dismissed the appeal, coming to the same conclusion as the Opposition Division.

The Board confirmed the General Court's finding in *O Store (T-116/06, Oakley v OHIM – Venticinque, 24 September 2008, paragraphs 42-62)* that retail services relating to “clothing, headgear, footwear, athletic bags, backpacks and knapsacks and wallets” are similar to the goods themselves. The same is true of the present case.

### General Court

The General Court dismissed the Applicant's action to annul the contested decision on the basis of similarity between the goods and services.

After applying settled case law, the General Court found a likelihood of confusion between the marks,

and the respective goods and services. Overall, the marks were visually and aurally similar, and had no conceptual meaning in any of the relevant languages of the Community.

### Comment

While this decision is, perhaps, not surprising, it provides a useful insight into the interpretation between goods and retail services, confirming that protection for retail services does not in any way give an applicant for a CTM the “possibility to have protection for all goods just by filing one class – class 35”. Instead the goods, or types of goods, covered by the retail services must be precisely specified by the applicant to be capable of registration.

The decision also provides confidence that the General Court can agree with the findings of OHIM following settled case law. In these circumstances, the use of the divisional application as a tactic to isolate a disputed trade mark and expedite the registration for the remainder is also worth considering.



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Thomas advises on all aspects of trade mark registration, protection and enforcement.

# Potent points

*Dracula bites hard on the neck of genuine use, writes Harriet Berridge*

The recent decision of the General Court in T-495/12 to T-497/12, European Drinks SA v OHIM, SC Alexandrion Grup Romania Srl intervening, serves as a warning to those trying to show genuine use of their trade mark at OHIM.

Dracula's most recent victim is European Drinks SA ("ED"), which had its oppositions dismissed because it failed to show genuine use of its earlier Romanian registration, DRACULA (stylised),<sup>1</sup> registered for "alcoholic beverages" in class 33 and services in class 35. ED relied on its earlier mark to oppose three Community Trade Mark applications filed by SC Alexandrion Group ("AG") for three figurative marks for DRACULA BITE<sup>2</sup> also covering "alcoholic beverages" and services in class 35 (shown right).

Accordingly, AG required ED to show that the DRACULA mark had been put to genuine use in the relevant period.<sup>3</sup>

ED claimed to have used its DRACULA mark on vodka. In support of this use, it submitted six invoices from the period spanning 2 February to 24 April 2009 bearing the mark DRACULA, which demonstrated total overall sales of 2,592 units. It also submitted a photograph of its product and a copy of promotional text relating to DRACULA vodka.

The case law has established that, to show genuine use, a proprietor must show that use is intended to create or maintain a market share in the economic sector concerned and must not be token use made solely to maintain the registration.<sup>4</sup> La Mer<sup>5</sup> suggests that minimal use may be sufficient, so long as the intention

to create or maintain a market share is evident. In certain market sectors, this test may be satisfied by small quantities of use, as long as the quality of the evidence and general context of the use is enough to show commercial purpose.

ED's evidence of use fell short of the established tests because the period of use was short (less than three months) and the volume of sales shown during this period was low. There were also questions around the form in which the mark was being used. However, there was no ruling on this point and the Court did not explore this issue in detail.

## Comment

The case underlines the importance of providing the full picture when preparing evidence of use. Use does not need to be continuous, but if only for a short period, or for low volumes of sales, other factors will be relevant in the assessment.

The author feels that, while this decision may seem harsh in light of previous decisions, it serves as a potent reminder to practitioners of what is required when showing use. If use is limited, this could have a negative impact on the overall assessment of genuine use. In such cases, it will be necessary to provide further all-round context to whatever

use has been made. In some cases, this will prove to be a tough hurdle to overcome.

- 1) See T-495/12 to T-497/12, paragraph 6
- 2) Ibid, paragraph 2
- 3) T-203/02, Sunrider v OHIM – Espadafor Caba, paragraphs 36 to 38
- 4) C-40/01, Ansul BV v Ajax Brandbeveiliging BV, paragraph 43
- 5) T-418/03, La Mer Technology v OHIM – Laboratoires Goëmar, paragraph 57



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# Picked apart

*Chris Morris explains why the Applicant's arguments didn't stand up to scrutiny*

**T**his case concerns an application to register RACEPARTS UK as a trade mark, covering “retail services connected to parts and fittings for vehicles, parts and fittings for racing vehicles of all types”. The UK IPO originally objected to the application both on the basis that it did not form a series (alongside the sign RACEPARTS) and that the sign was inherently unregistrable.

On appeal to the Appointed Person (“AP”), the Applicant, Raceparts (UK) Limited (“Raceparts”), confirmed that it wished to proceed with the mark RACEPARTS UK only. Raceparts also confirmed that it was not contesting the Hearing Officer’s finding that the sign is descriptive of, and non-distinctive for, retail services. The appeal instead focused on Raceparts’ contention that the Hearing Officer did not give adequate weight to the evidence filed and that the sign had, in fact, acquired distinctiveness through use.

Raceparts raised two main grounds in support of its appeal.

## Use of RACEPARTS UK

The “overwhelming majority” of the use shown in the evidence filed by Raceparts was of the sign RACEPARTS (UK) LTD, often in conjunction with a logo shown right.

Raceparts relied on earlier Court of Justice of the European Union (CJEU) jurisprudence stating that a sign can still acquire distinctiveness from use as part of a mark or when used in conjunction with another mark. The Appointed Person (“AP”) did not dispute this, but pointed out

that not all uses of a mark will result in an element or elements of it acquiring distinctive character.

Raceparts sought to liken its case to “McDonald’s”, “Mattel” or “John Lewis”, but the AP distinguished those examples. RACEPARTS UK is descriptive of the goods, and their geographic origin, subject of the retail services. The words therefore characterise those services in a way that the examples put forward by Raceparts do not.

Also, while LTD is a non-distinctive addition, it cannot be ignored because it individualises the otherwise descriptive RACEPARTS UK.

In conclusion, the Hearing Officer was correct to find that RACEPARTS (UK) LTD is a different mark and the Applicant did not show that the public would perceive RACEPARTS UK as an indicator of origin.

## Testimonial evidence

The second limb of Raceparts’ appeal related to testimonial evidence it filed in support of its claim, comprising letters from a former racing driver, three race

engineers, the Marussia Virgin Racing team, Demon Tweeks Direct and *Autosport* magazine.

The AP upheld the Hearing Officer’s objection that all but the last two letters emanated from the top end of motor racing, whereas the coverage of the application was far broader, spanning a vast market and range of relevant consumers. The Demon Tweeks and *Autosport* letters covered the broader market, but were inadequate in the context of the size of the market as a whole and the inherent weakness of the mark.

Raceparts offered a limitation to “...parts and fittings for motor racing vehicles of all types”, but the AP found this would still cover a far broader spectrum of racing and consumers than Raceparts’ evidence.

The refusal of registration was upheld.

## Conclusion

This case is a good demonstration of the need for evidence of acquired distinctiveness to take into account the complete market to which goods and services are offered, and to consider very carefully how a sign has been used and presented in practice, how it is perceived by the consumer and what, therefore, the trade mark actually is.



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# Getting sweaty over JUST COOL

*Just file first is the lesson here, suggests Emma Reeve*

**N**orty Limited (“Norty”) held the UK trade mark JUST COOL BY AWDIS registered in classes 25 and 26. Norty trades under the name “Awdis” and specialises in the production and wholesaling of plain clothing intended for branding with corporate names and logos.

Roy Daley-Smoother (“the Applicant”), who works in the field of personal development and motivation, applied to invalidate Norty’s trade mark on the following grounds:

- The application was made in bad faith and should be cancelled under section 3(6) of the Trade Marks Act 1994.
- Use of JUST COOL BY AWDIS in relation to any of the goods and services for which it was registered would amount to passing off. He contends that the registration should be cancelled pursuant to section 47(1) because it was prohibited from registration under section 5(4)(a).

The Applicant appealed the decision of the Hearing Officer to the Appointed Person. The Applicant represented himself at the tribunal and on appeal. Both decisions found in favour of Norty.

Norty’s trade mark application was filed on 30 April 2010. The Applicant claimed that, by 30 April 2010, he had established goodwill under the name JUST COOL in the clothing sector.

Norty denied that it had any knowledge of the Applicant’s brand at the relevant date and that the Applicant had not built up any actionable goodwill, or that there was any likelihood of confusion.

## Bad faith

The Applicant did not challenge the law, but instead questioned the finding of the Hearing Officer – in particular that Norty was unaware of his use of JUST COOL at the application date. The Appointed Person focused on the evidence raised at the hearing, including the oral evidence Norty’s General Manager gave in cross-examination.

The Applicant submitted that Norty’s witness was unreliable, on the basis of his oral evidence, because the General Manager was unable to remember exactly who first suggested the mark JUST COOL BY AWDIS in a brainstorming session.

The Hearing Officer concluded that “there is nothing implausible in not knowing which member of staff came up with the initial idea”, and concluded “this did not undermine my opinion of [the] witness”.

The Appointed Person reasoned that it was not surprising that Norty could not recall who first suggested the name in a brainstorming session, which by its very nature includes the input of multiple people.

The Applicant submitted that it is implausible that Norty would not have discovered JUST COOL in the course of internet and/or trade mark searches that it carried out in 2010 in relation to JUST COOL BY AWDIS.

First, there was no evidence to suggest that the Applicant was of such size or prominence that it was bound to have appeared on a Google search. Second, there was no evidence to suggest that Norty performed domain name searches that found the Applicant’s domain names. Third, there was no evidence to suggest that the UK trade mark search found any reference to JUST COOL.

The Applicant contended that his strapline LOOK COOL, FEEL COOL, BE COOL had an “unbelievable” likeness to Norty’s strapline LOOK COOL, FEEL COOL, STAY COOL. The Appointed Person agreed with the Hearing Officer’s reasoning that the phrase was: “Pretty unremarkable, particularly when it is clear from Norty’s evidence that the garments it produces under its mark are designed to wick sweat away from the body.”

The Applicant finally submitted that the Appointed Person apply the “come off it” test. This is a phrase apparently used orally by Geoffrey Hobbs QC sitting as an Appointed Person. The Applicant argued that, when the evidence was taken together, the reaction of a reasonable tribunal to the evidence of Norty’s witness would have been to say

*The Appointed Person was of the view that the Hearing Officer’s decision on the question of goodwill should stand*





“come off it, you cannot expect me to believe your story”. The Hearing Officer rejected this submission as follows:

“I found Mr Jumani to be an excellent witness. His written evidence stacks up well with the answers he gave during cross-examination. He has put forward a very reasonable explanation for the coining of the mark. He has stated and maintained under cross-examination that he knew nothing of Mr Daley-Smoother’s business at the relevant date. There is nothing implausible in his evidence. His evidence is to be believed. I come to the clear view that Mr Jumani, the controlling mind of Norty, knew nothing of Mr Daley-Smoother’s

The Applicant contended that his strapline LOOK COOL, FEEL COOL, BE COOL had an “unbelievable” likeness to Norty’s strapline LOOK COOL, FEEL COOL, STAY COOL

business at the relevant date. Given this, no question of bad faith arises as Norty had no relevant knowledge.”

The Appointed Person agreed with the decision of the Hearing Officer that Norty was acting in good faith.

### Section 5(4)(a)

The Applicant made complaints about the approach the Hearing Officer took to the question of goodwill, which are as follows:

- 1) That the Hearing Officer had placed too much emphasis on the need to show sales and that in the fashion industry it was important to make one’s name and create a “buzz”.
- 2) That the Hearing Officer should have been more prepared to draw inferences as to the strength of his goodwill from the quality of the people and institutions that in the evidence were associated with his brand.

The Appointed Person considered it right that the Hearing Officer in his reasoning considered the lack of evidence of any sales, as the “goodwill is the ‘attractive force that brings in custom’. If there is no custom because there is nothing to buy, it will soon wither and die.”

The Appointed Person was of the view that the Hearing Officer’s decision on the question of goodwill should stand, as his approach to the evidence was extremely thorough and properly structured.

### Conclusion

The outcome of this case reinforces the first-to-file system in the UK. If a brand owner has an intention to use a trade mark it should put its flag in the sand and file. By applying to register a trade mark it will not have to object, with tenuous evidence, to an application or registration by an applicant who happened to get there first.



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# Cutting Edge

*An appeal regarding partial assignment favoured Future, reports Carrie Bradley*

This matter concerned an appeal to the Appointed Person (“AP”) in respect of the UK IPO’s refusal (decision O/283/12 of David Landau, 25 July 2012) to record a partial assignment of UK Trade Mark Registrations 2552136 and 2552147 (“the Marks”).

The Marks were filed on 5 July 2010, and subsequently registered on 25 November 2011, in the name of Future Publishing Limited (“Future”). On 7 March 2012, Edge Interactive Media Inc (“Edge”) filed an application with the UK IPO for the recordal of an assignment-in-part of the Marks. The Form TM16 identified Edge as “the assignee” for the purposes of Rule 48(a)(i) of the Trade Mark Rules 2008, and 5 July 2010 (the filing date) as “the date of the assignment” for the purposes of Rule 48(a)(ii).

When notified of the filing of the Form TM16, Future objected to its recordal on the basis that there had been, and could be, no assignment susceptible of recordal in favour of Edge. The application for recordal therefore proceeded as a contested inter partes proceeding between Edge and Future.

In accordance with sections 24(3) and 27(1) of the Trade Marks Act 1994 (“the Act”), Edge had to be able to produce a valid and effective assignment transferring to it in writing the property it claimed to have acquired on 5 July 2012. In this regard, Edge sought to rely upon clause 2.8 of a Concurrent Trading Agreement and Deed of Trademark Assignment that had been made between the parties on, and with effect from, 15 October 2004 (“the 2004 Agreement”).

By way of background, the parties had been in dispute over the implementation and provisions of the 2004 Agreement at the time that the Marks were filed on 5 July 2010. Future alleged that breaches had been made by Edge, such that the 2004 Agreement had been repudiated with effect from 2 July 2010. Consequently, the parties had litigated their dispute over this issue in the Chancery Division of the High Court, culminating in a judgment delivered by Justice Proudman on 13 June 2011 (under reference [2011] EWHC 1489 (Ch), reported at [2011] ETMR 50). As part of a comprehensive order for relief, Proudman J declared that the 2004 Agreement had “terminated with effect from 20 August 2010”. The judgment and order of the Court became final on 7 February 2012 upon refusal of Edge’s application to the Court of Appeal for permission to appeal. It was shortly thereafter (namely 7 March 2012) that Edge had filed the Form TM16.

On behalf of the IPO, the Hearing Officer refused to record the Form TM16 for several reasons, principally that clause 2.8 of the 2004 Agreement was not sufficient, in and of itself, to effect an assignment of the Marks, and that the clause could not be invoked,

*The Appointed Person held that the Hearing Officer had been correct to refuse the Form TM16 on the bases identified in his decision*

in any case, after the 2004 Agreement had ended.

Edge appealed to the AP under section 76 of the 1994 Act, contending that the Hearing Officer’s decision was wrong in all respects. With regard to clause 2.8, the AP held that, under its provisions, Edge had no more than an equitable interest in the Marks filed by Future on 5 July 2010, and that, furthermore, no assignment of the Marks existed on 5 July 2010. For this reason, the AP held that the Hearing Officer had been correct to refuse the Form TM16 on the bases identified in his decision. The AP also held that it was not open to either party to contend that the 2004 Agreement terminated on any other date than 20 August 2010, since this issue had been conclusively determined by the final order of Proudman J.



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# events

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

Our focus moves to Birmingham for the annual Autumn Seminar on 25 September

| Date         | Event  | Location                           | CPD hours |
|--------------|--|------------------------------------|-----------|
| 12 September | <b>ITMA Seminar</b><br>Copyright: when to call for help and issues around providing it, Guy Tritton, Hogarth Chambers and Nick Cunningham, Wragge & Co | Norton Rose Fulbright, London      | 2         |
| 23 September | <b>ITMA London Evening Meeting*</b><br>Copyright and design update, Alaina Newnes, One Essex Court   | Royal College of Surgeons, London  | 1         |
| 23 September | <b>ITMA/CIPA Webinar</b><br>Money laundering, Chris Beanland, The University of Law  |                                    | 1         |
| 25 September | <b>ITMA Autumn Seminar*</b><br>The Trade Mark Perimeter: outside the everyday  | Hyatt Regency, Birmingham          | 5         |
| 28 October   | <b>ITMA London Evening Meeting*</b><br>Update on law and practice in China, Jimmy Huang, Zhong Lun Law Firm  | Royal College of Surgeons, London  | 1         |
| 29 October   | <b>Litigators' Refresher Course</b>  | Carpmaels & Ransford LLP, London   | TBC       |
| 30 October   | <b>ITMA Autumn Drinks</b>  | Royal Over-Seas League, Edinburgh  |           |
| 18 November  | <b>ITMA London Evening Meeting*</b>  | Royal College of Surgeons, London  | 1         |
| 20 November  | <b>ITMA Talk in Glasgow</b><br>Assignments, Tania Clark, Withers & Rogers LLP  | Marks & Clerk LLP, Glasgow         | 1         |
| 9 December   | <b>ITMA London Christmas Lunch**</b>   | InterContinental Park Lane, London |           |

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**I work as...** a Director of Colman+Smart Limited in Manchester. I specialise in IP administration, primarily in trade marks, but also handling designs. I've made a niche for myself in dealing with remote and unusual jurisdictions.

**Before this role...** I was a trade marks paralegal for Novartis, first at its HQ in Basel and then in its generics division, Sandoz, near Munich.

**My current state of mind is...** positive. I'm a glass-half-full person.

**I became interested in IP when...** I was in my first job, as a post boy at the Trade Mark Owners Association (as it then was).

**I am most inspired by...** helping people. I enjoy it when clients say "you've got us out of a hole there".

**I most like...** an opportunity to make things work better. In Germany, I was able to help a department by taking a step back and then being given the responsibility to bring in changes.

**I most dislike...** commuting. I spent 11 years going back and forth between Hertfordshire and London, where the best opportunities in our field are.

**On my desk is...** a list of renewals.

**My favourite mug is...** an FC Basel mug that has followed me from Switzerland. I am also a long-suffering Tottenham Hotspur fan and my home town team, Bishop's Stortford, is



*Football victories loom large in the thoughts of Administrator Member Daniel Smart*

similarly success-starved. It's nice to support one team that wins things!

**My favourite place to visit on business is...** Basel. Having lived there, it feels like going home.

**If I were a trade mark or brand, I would be...** the Netherlands (if a country can be a brand). A liberal, open-minded and tolerant approach to life fits with my ideals.

**The biggest challenge for IP is...** difficult to predict. Few of us, for instance, could have dreamed how the internet would take off; and the challenges it has created for IP, which

sometimes appear to overshadow the solutions it has also provided.

**The talent I wish I had is...** the patience and discipline to study (I might then be a Trade Mark Attorney). And I wish my German was a lot better.

**I can't live without...** the internet.

**My ideal day would include...** pleasant weather, watching one of my teams win and with no lingering IP deadlines. Optimistic!

**In my pocket is...** my mobile phone.

**The best piece of advice I've been given is...** for work: "Read the correspondence." We learn how to scan-read standard documents, but the non-standard stuff is coming from multiple sources with different styles. It causes delays when things are not read and responded to correctly.

**When I want to relax I...** have a beer.

**In the next five years, I hope to...** don't know! In 2006, I nearly left the trade mark field to teach English in China. Instead, I was given an opportunity that led me to Switzerland and Germany.

**The best thing about being an ITMA member is...** it has expanded my network. I've also enjoyed the company of attendees at ITMA events, and the staff at "ITMA Towers" are fantastic.

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

# What is WebTMS?

## A COMPREHENSIVE, USER FRIENDLY, WEB-BASED TRADE MARK MANAGEMENT SYSTEM

WebTMS is a web based management suite for your trademark and IP portfolio, there is a module for each type of IP case. Each record within that module can store full case details, associated images and any related electronic documents, including e-mail. (integration with Outlook is also possible). The system was originally designed by trademark attorneys for trademark professionals, and is continuously improved by user input. It contains numerous workflow wizards and utilities to maximize your firm's efficiency.

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# Dawn Ellmore Employment



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## Patent, Trade Mark & Legal Specialists

### FQ Trade Mark Attorney – London

This prestigious firm is the first stop for many burgeoning start-ups, SMEs and corporations. Having carved out an outstanding reputation, our client is particularly interested in employing a trade mark attorney with a maximum of 5 years' post qualification experience to help maintain the impressive track record the firm has acquired over the years.

### Trade Mark Formalities Clerk – London

We are delighted to be representing this leading company in their search for an experienced trade mark formalities clerk. The role will be working in their expanding London office, reporting to the TM Formalities Manager. The ideal candidate should have current trade mark experience, and knowledge of formalities procedures, renewal rules and legislation.

### Trade Mark Secretary – London

A new position has arisen for a reputable IP firm. Our client has an opening for a TM secretary with a minimum of two years' experience in the profession either from private practice or in-house. Candidates should have excellent typing skills, the ability to prioritise their workload and have a flexible and confident approach to their work. Motivated individuals will progress quickly.

### Trade Mark Partner – London

Fuelled by a rapidly expanding workload, our client's expansion has reached partner level. Firmly placed at the forefront of the profession, this dynamic firm is well known and respected for producing high quality work. An attorney with a genuine commercial outlook and at least 10 years of post qualification experience would fit in well with the existing partnership of the firm.

### FQ Trade Mark Attorney – Midlands

A well established and renowned firm have a new requirement for a trade mark attorney to help service an increase of work in their Midlands office. The highly regarded attorneys of this firm work hard to create a friendly but dedicated and professional working environment. Practical experience and a can-do attitude are essential for this role.

### IP Marketing Assistant – London

Over the upcoming months, the BD/Marketing department of this leading firm is evolving and there is the need for an extra pair of hands to assist the Head of BD. With the department growing considerably, there is the prospect of excellent future career opportunities. Candidates should have at least 2 years' experience in a professional services firm and a marketing qualification.

### Trade Mark Administrator/Paralegal – West Midlands

This is an opportunity to be exposed to an impressive and broad portfolio of trade marks, many of which are well known both locally and across the globe. A familiarity of all trade mark formalities from filing through to the registration and oppositions stages is a must in order to meet our client's requirements.

### Trade Mark Associate – Middle East

Working within a large multi-national law firm's flagship office in the Middle East, you will be involved with a broad IP work load. This leading IP practice is seeking a newly qualified solicitor (with up to 1 years' PQE) or a qualified trade mark attorney with experience of a range of contentious and non-contentious IP matters in their current role.



Attorney vacancy contacts:

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