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ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

Issue **425** May 2016 itma.org.uk



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welcome

May 2016



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ITMA Review

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In late March, Kate O'Rourke and I had the pleasure of co-chairing the ITMA Spring Conference, and the opportunity to meet many ITMA members. If you were not there, this issue will offer you an opportunity to read about what you missed. What struck me most about the event was the uniformly high quality of the presentations and the willingness of the delegates to participate fully, in addition to the excellent social and networking aspects. As I sail off into the sunset, or at least into the role of Immediate Past President, I am confident

that ITMA will continue to offer such high-calibre events.

In this issue, which many of you may read en route to the 2016 INTA Annual Meeting in Orlando, we report on Harris Tweed's Grant of Arms, look at possible Brexit issues, consider whether the proposed extension of the GI system could be anti-competitive, and report on our research into what you think about the *ITMA Review*.

Chris McLeod
ITMA President

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iTMA Insider

Chief Executive's bulletin

Highlights from and updates to Keven Bader's 10 March missive for members



ITMA ELECTS NEW COUNCIL

Following the recent poll of ITMA members, and in accordance with the ITMA Memorandum & Articles of Association, we are happy to welcome a new cohort of Council members for 2016–2018.

A vote by the corporate members was required, as more nominations (12) were received by the due date of 19 February than the number of vacancies available on Council (11). As a result, on 29 February 2016, a formal ballot was opened using an online voting system via SurveyMonkey. The ballot allowed an individual to vote for up to 11 of the 12 nominees, as there were 11 vacancies available.

In total, 696 invitations were sent out to members listed on the ITMA database and 230 responses were received, which represents a response rate of 33 per cent. The following people were elected:

- Oscar Benito, GSK
- Kelly Clarke, Olswang LLP
- Philip Harris, St Philips Chambers
- Keith Havelock
- Mark Hiddleston, Hiddleston Trade Marks
- Natasha Hinds-Payne, Cath Kidston Limited
- Clare Jackman, Norton Rose Fulbright LLP
- Maggie Ramage, Edwin Coe LLP
- Rachel Wilkinson-Duffy, Baker & McKenzie LLP
- Imogen Wiseman, Cleveland LLP
- Aaron Wood, Wood IP Limited

ITMA PARALEGAL INAUGURATED

Following the recent survey of members on the subject of the designation of “Administrator/Paralegal”, the ITMA Council approved the proposals to change the “Administrator” category of membership to “ITMA Paralegal” and introduced a CPD requirement of eight hours per annum. The survey

“

We will be communicating in more detail the next steps for Administrator members

confirmed that there was support for the proposed changes, and we have been considering how we will proceed to implement them.

The first step in enacting any change is to pass a special resolution to amend the relevant provisions in the Memorandum & Articles of Association. Such a resolution was passed at the AGM on 23 March, and we will be communicating in more detail the changes planned and the next steps for Administrator members. The name changes to the membership category and to the current Trade Mark

Administrators' Course should take place this year, but the CPD requirement will not take effect until 2018.

COMMERCIAL PARTNERSHIPS

ITMA has secured commercial partnership agreements for 2016 with Corsearch, Thomson CompuMark and WebTMS. These agreements really help ITMA to develop our events programme, the courses we offer and the activities we undertake to improve our offering to members and those in the profession.

EU REFERENDUM

What would Brexit look like for the UK Trade Mark Attorney profession? This question is on the lips of many, if not all, ITMA members. To help inform the debate, ITMA has produced a paper, which we hope will spark conversation and make clear what a vote to leave the EU could mean.

Read it at itma.org.uk/membership/resources/eu_referendum

EU DIRECTIVE REFORMS

To make sure members are well informed of the changes to the EU Directive that are underway, and their implications, we have created a set of resources, including podcasts, videos and articles, that are available in the Resources area of the ITMA website. We will be updating the page as the changes progress. Visit itma.org.uk/membership/resources/eu_trade_mark_reforms

READER REVIEW

Peter Vaughan feels that the new, second edition of Domain Name Law and Practice warrants a fresh look

Domain names are of increasing importance to brand owners, allowing a diverse range of options when engaging with consumers, as well as providing an online platform from which to trade and advertise. A domain name is effectively a gateway to your brand online. Unfortunately, domain names also raise questions as to control of brands and trade marks, especially with the new generic top-level domain (gTLD) programme from the Internet Corporation for Assigned Names and Numbers, and the low cost of and ease with which a domain name can be registered.

The second edition of *Domain Name Law and Practice* is a welcome update, and a valuable handbook for those practising domain-name law. First published in 2005, this update provides coverage and analysis of the various developments that have occurred

since, with useful discussion of the developments in case law. It also adds new countries to its remit, bringing Colombia, Israel, Mexico, South Korea, Brazil, Egypt, Portugal and South Africa into the fold. The book provides an important update given the recent introduction of gTLDs and developments in case law as more domain-name complaints have been considered by the various registries.

Split into three main sections, part one provides an overview of the domain-name system and policy considerations, and gives a useful background for the reader. Part two focuses on national domain-name law in 31 countries, providing useful summaries of domain-name provisions and an insight for practitioners into the rights-protection mechanisms. Part three looks at the various different rights-protection mechanisms, including comprehensive coverage

of the Uniform Domain-Name Dispute-Resolution Policy procedure and a significant section on the gTLD programme, with discussion of gTLDs from inception to use.

With more domain-name issues coming to the fore, *Domain Name Law and Practice* is, as the authors accurately describe it, a useful handbook for when questions as to rights-protection mechanisms concerning domain-name registrations are raised and complaints need to be filed.



Domain Name Law and Practice, An International Handbook, Second Edition, Oxford University Press (November 2015), edited by Torsten Bettinger and Allegra Waddell. Hardback, 1,696 pages. Also available as an ebook.

Member moves



Oliver Tidman has joined Burness Paull LLP as a Senior Solicitor. Contact Oliver at +44 (0)131 473 6188, or at oliver.tidman@burnesspaull.com



The Partners of Mewburn Ellis LLP are very pleased to announce that Trade Mark Attorney **Andy King** joined the partnership on 1 April 2016.



Forresters has recruited **Janette Hamer** and **Leona Ogier** from Rouse UK and **Dawn Logan-Keeffe** from Davies Collison Cave in Australia to further strengthen its team of IP experts.



In February, Wragge Lawrence Graham & Co and Gowlings, a leading Canadian law firm, joined forces to become **Gowling WLG**.



► On 25 February, ITMA member Kate O'Rourke of Charles Russell Speechlys was proud to receive her MBE from HRH the Prince of Wales



Call to arms

Recent Evening Meeting speaker Colin Hulme is happy to have a new weapon in his brand-protection armoury

In February, the Harris Tweed Authority (the Authority), the statutory custodian of the Harris Tweed brand, obtained a Grant of Arms from the Right Honourable the Lord Lyon King of Arms, the heraldic authority for Scotland, an equivalent to the English Kings of Arms. The Grant of Arms, secured by the Authority's Trade Mark Attorney, Campbell Newell of Marks & Clerk, is an interesting new weapon in its armoury.

For almost 10 years, I have been involved in enforcement of the Harris Tweed brand around the world. Harris Tweed is a cloth made in the Outer Hebrides of Scotland. To be certified as Harris Tweed, the Authority must be satisfied that the cloth has been made from yarn spun and dyed in the Outer Hebrides and then hand-woven by an islander in a home in the Outer Hebrides (and also that it meets various other technical specifications).

Having a Grant of Arms provides an additional means of helping to protect the integrity of the Harris Tweed brand. In addition to the Harris Tweed Act 1993 and our registered marks, we are continually looking for new ways to help protect this brand, which is critical to the survival of the Harris Tweed industry, so important in this remote outpost of the UK. Much as we hope to be able to secure a non-agricultural Geographical Indication, obtaining a Grant of Arms gives us a new weapon against counterfeiters and those seeking to free-ride on an unjustified association with the brand.

What benefits will having a Grant of Arms offer? Unlike in the rest of the UK, the misuse of Arms is a criminal offence in Scotland, and is treated as tax evasion. Infringements (or rather prosecutions) are brought before the Lyon Court, with the Lord Lyon being the sole judge. Appeals can be made to the Court of Session in Edinburgh. Such cases are brought to the Lyon Court by the Procurator Fiscal to the Court of the Lord Lyon (presently an advocate called Alexander Green, based in Aberdeen). The Court

is the oldest heraldic court in the world still in regular use and, as you would expect, is steeped in history and tradition. However, encouragingly, we have seen evidence that the Lord Lyon has an enthusiasm for ensuring his role has value and relevance in 21st-century brand protection.

The cost of this process is borne by the Court of the Lord Lyon, which is a considerable benefit to securing a Grant of Arms. Misuse of armorial bearings brings with it a power to fine and to ensure that items bearing the offending arms are removed, destroyed or forfeited. It is important to emphasise that the Lord Lyon's interest is limited to instances in which the Authority's armorial bearings are being used and not any misuse of the famous Harris Tweed Orb.

I see the greatest value of having a Grant of Arms coming from the ability to report matters to the Court of the Lord Lyon at minimal cost to the Authority. Another benefit is that, once the armorial bearings are secured, there are no renewal fees or further costs involved. Of course, only time will tell as to the extent to which the Orb will be improperly used within a shield or similar device, leading to prosecution before the Court of the Lord Lyon. ■

Colin addressed ITMA members on certification marks and Harris Tweed at an April Evening Meeting.



► **Harris Tweed's Grant of Arms**



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CROWNING ACHIEVEMENT



*With its backdrop of Whitehall and Royal London,
this year's annual gathering was truly a landmark event*

PHOTOGRAPHY BY SIMON O'CONNOR
AND RICHARD HAYWARD

08

66 **H**eritage has a power that transcends culture and time. Heritage sells." This year's ITMA Spring Conference opened with this strong message from Tugba Unkan (FRAME Denim), who firmly set the scene for a programme of speakers strongly organised around the theme of history and heritage.

Taking the podium after the keynote, Allan James walked us through the UK IPO's own history in numbers, and told us how, back in the day, the mood was one of paternalism, when "user was King", which contrasts with today's "first to file" system, which is the result of a liberalisation of registration requirements introduced with the Trade Marks Act 1994.

We were brought back to the modern day by DI Mick Dodge of the Police Intellectual Property Crime Unit (PIPCU), who reminded us of the darker side of IP and the new challenges we face in our increasingly digital world. IPO funding for PIPCU is confirmed until 2017, and Dodge encouraged brand owners to consider PIPCU in their anti-counterfeiting arsenal; resource will be prioritised, he said, "where threat, risk and harm are greatest".

Next, Robert Buchan and Gill Grassie of Brodies LLP took us to the Outer Hebrides – because how could we talk heritage without a mention of the oldest certification mark of them all, Harris Tweed? Following on was Alan Park (Scotch Whisky Association), who explained that we should be prepared to advise clients in respect of the growing area of Geographical Indications (GIs), and entertained delegates with a range of infringement case studies.

Rounding off the first day were: Nick Phillips (Edwin Coe LLP), who gave us a date for the diary – 31 December 2039 – when works previously unpublished will be falling out of copyright; Carrie Bradley (Stobbs IP), who gave a refreshing and practical presentation on the legal implications of resurrecting (seemingly) abandoned brands; and, last but by no means least, a run-through of the new European Regulation by Charlotte Scott of Hogarth Chambers (pronunciation of EUIPO yet to be decided!).

Day two saw David Stone (Simmons & Simmons) give his top 10 tips in a brilliant designs talk, with some discussion of *that* case (yes, Trunki). Richard Peck (The Royal Warrant Holders Association) answered "Why a Royal ▶



Warrant?” with “Well, if it’s good enough for the Queen, it’s probably good enough for you and me”. He was followed by Clive Cheesman and Christopher Fletcher-Vane on the subject of Coats of Arms. Ending the conference on a high, Irene Bocchetta (Defra) talked us through GIs and customers’ desire to know food provenance, and Sarah McPoland (Nestlé) gave us a detailed, in-house perspective on IP challenges, strategies and what happens when confectionery and shisha collide. By the time we reached the closing remarks, we’d all taken on an informative, engaging, history tour. ■

Report provided by Katie Goulding, a Trade Mark Attorney at HGF Limited



- 1) DEEP IN DISCUSSION OVER COFFEE
- 2) KEYNOTE SPEAKER TUGBA UNKAN ASKING A QUESTION DURING THE CONFERENCE
- 3) IRRESISTIBLE ITMA DOUGHNUTS
- 4) LUNCH AT ONE WHITEHALL PLACE

**EXPERT
SPEAKERS
INCLUDED**



ALLAN JAMES
UK IPO



DAVID STONE
SIMMONS & SIMMONS



ALAN PARK
SCOTCH WHISKY ASSOCIATION



IRENE BOCCHETTA
DEFRA



**KEYNOTE SPEAKER
TUGBA UNKAN
FRAME DENIM**

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- 1) DELEGATES IMMERSSED IN A SESSION
- 2) COFFEE-BREAK NETWORKING
- 3) STEVE STOLFI AND ALEX RUSHENT (CORSEARCH) AT THE TOWER OF LONDON'S OLD ARMOURY
- 4) A GALA DINNER GROUP
- 5) CATHERINE FRENCH (LEFT) AND LISA KELLY (RIGHT) FROM SACCO MANN POSING WITH A BEEFEATER
- 6) SPEAKER ROBERT BUCHAN (BRODIES)



WHAT A GREAT GALA

Report provided by Keith Havelock, a member of the ITMA Council

By common consent, the location for the Gala Dinner could hardly have been bettered.

Upon arrival at the Tower of London, arguably London's most iconic landmark, guests were led directly into the Jewel House, where there was time for a leisurely inspection of the treasures on show – crowns, orbs, sceptres, jewelled swords and much more, all available to us without the pressure of big crowds. Most touching for me was the tiny coronet, sparkling with diamonds, that Queen Victoria wore after the death of Prince Albert.

Next, Beefeaters directed us along cobbled streets to the Old Armoury in the White Tower, where drinks were served. The building was gloriously floodlit. After an inspection of the armour held there (both human and equine), it was downstairs to the New Armoury, where dinner featured a main course of roast cannon of Kentish lamb. Prior to the meal, Chris McLeod gave what was probably his penultimate speech as President. He was in his usual urbane form.

He then drew the winning ticket for the evening's raffle in favour of Simon Gray, President of the Irish Association of Patent and Trade Mark Attorneys, who had himself entertained ITMA members in Dublin at the joint meeting last November. The prize was a Garmin smart watch, donated by Corsearch.

A stentorian announcement regarding security from a Beefeater – who must surely also have been an old-fashioned company sergeant-major, so loud was his voice – preceded “carriages at 10.30”, while outside the Ceremony of the Keys was taking place, as it has each night, just before 10pm, for the past 700 years. A final glimpse of the incredible floodlit buildings of the City brought a very memorable evening to a close. ■





Code of silence

Michael Edenborough QC argues that proposals to extend the GI system to non-agricultural products have the potential to stifle competition

GEOGRAPHICAL INDICATIONS (GIs) are highly contentious, and they are about to become even more so, because of the proposed extension from food-related products to non-agricultural products. In order to place this proposal in context, it is necessary to examine the current scheme and where it fits into the wider issue of intellectual property rights (IPRs) as a whole.

IPRs are a matter of public policy; they attempt to balance the rights of individuals against those of society as a whole. The core rights are copyright, patents and trade marks, which, between them, protect the creative, innovative and commercial integrity of entities, be they natural or corporate. Over the years, additional rights have come into existence that extend the scope of IPRs. In all cases, the right allows a rights-holder to stop some activity being done by another party, and in so doing fetters the freedom of that other party. Commonly, commercial activities are restricted, impinging adversely upon free trade.

DUAL DEVELOPMENT

GIs are the result of two strands of development. First, there are such rights as collective and certification trade marks, whereby a group of traders could form a cooperative, and each member could use the collective mark, or a trade society could certify products as satisfying a certain standard; anyone who complied with that standard could then use the certification mark. As an alternative to registered trade marks, common-law jurisdictions commonly provide that the tort of passing off may confer protection from imitators in suitable cases. Second, the *appellation d'origine contrôlée* system relates a specific product to a particular *terroir*. The combination of rights akin to trade marks and the link to the *terroir* resulted

in the present-day GIs for certain agricultural products and their derivatives.

At the European level, GIs are now regulated by Regulation (EU) No 1151/2012. The principal forms of protection are the Protected Designations of Origin (PDOs), Protected Geographical Indications (PGIs) and Traditional Specialities Guaranteed (TSGs). The reputed quality of the product is dependent upon its link to the particular geographical area under consideration, often combined with strict rules on the method of production.

However, the strength of the link to a particular region is different for the various GIs. For PDOs, the product must originate in a specific place and its quality or characteristics must be “essentially or exclusively due to a particular geographical environment with its inherent natural and human factors”; all the production steps must take place in the defined geographical area (as with Stilton cheese, for example). For PGIs, it is only necessary that “the given quality, reputation or other characteristic is essentially attributable to its geographical origin” and “at least one of the production steps” takes place in the defined geographical area (for example, Melton Mowbray pork pies or Cornish pasties). Finally, for TSGs, there is no requirement for a specific geographical link; rather, the name must relate to a specific product or foodstuff that results “from a mode of production, processing or composition corresponding to a traditional practice” (for example, traditionally farmed Gloucestershire Old Spots pork, and *pizza napoletana*). In addition to these core GIs, there are other, less well-known, optional quality terms, such as “mountain product” and the proposed “product of island farming”.

In addition to prohibiting direct or indirect commercial use of the registered GI, the

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A GI gives great power to stop others producing an identical product and trying to identify it as being in any way related to the protected product

Regulation also prohibits “any misuse, imitation or evocation, even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’ or similar”.

As such, a GI gives those eligible to use it great power to stop others producing an identical product and trying to identify that identical product as being in any way related to the product protected by the GI. The strength of GIs may be contrasted with the more limited power conferred by the tort of passing off, which cannot stop the use of such terms as “style” (as in “Greek-style yoghurt”) in cases where the protected product does not benefit from a GI, but still forms an identifiable class that has a collective goodwill that may be enforced by any qualifying member of the relevant group of genuine producers.

DIFFICULT SITUATION

It is relatively easy to justify granting monopoly rights to a group of traders who produce a product that is characterised by distinctive geographical qualities. It is more difficult to justify prohibiting competing traders from indicating truthfully that their product, which does not originate from the defined geographical area (or otherwise comply with the requirements), is nonetheless otherwise identical, and indicating this distinction from the genuine article by the use of such terms as “style”, “type”, “method” or similar. The tort of passing off allows such a distinction to be drawn because, fundamentally, it allows traders to tell the truth. GIs do not even allow competing traders to tell the truth – they are silenced altogether. This, it may be argued, is a step too far in protecting the legitimate commercial

interests of producers of regional products, because it denies the informed consumer the option of purchasing a product that possesses certain characteristics of the genuine product in the knowledge that it is not the genuine product: for example, a yoghurt that was made in the same way as Greek yoghurt, but was not made in Greece. Whether the experience was wholesome or not, the consumer has sufficient information to repeat or decline that choice in the future, thereby protecting the genuine producers from any unfair competition.

The current system has noticeable quirks. For example, Stilton cheese may not be so-called if produced in the village of Stilton, because that is located outside the prescribed region in which genuine Stilton cheese may be produced. In contrast, Melton Mowbray pork pies may be produced outside (as well as within) the village of Melton Mowbray, because the prescribed region is more widely defined than the village.

The proposals to extend the GI system to non-agricultural products might distort competition. The proposals would extend the right to locally manufactured products, such as Menorcan sandals or Basque berets. An important justification for the GI system is the link to the *terroir*, and its influence upon the essential characteristics of the product. If that link is weakened further, such that all that is required is a history of local manufacture of a particular type of artisanal or industrial product, then the room for informed consumer choice will be reduced. In particular, it is foreseeable that there will be a conflict between such proposed rights and generic terms that are used to describe a particular type of product.

Finally, just over the horizon looms the Transatlantic Trade and Investment Partnership. The US does not like GIs because (it asserts) they fetter competition. So, just as the EU is set to increase the scope of GIs to non-agricultural products, the likely trade agreement between the US and the EU is likely to see their curtailment, or at least restriction in scope. Interesting times lie ahead. ■



Michael Edenborough QC

is a Barrister at Serle Court
medenborough@serlecourt.co.uk
 He has acted for, and advised, many interested parties on GI issues.

It has recently been announced that 23 June 2016 will see a public referendum on whether the UK should continue to be a member of the EU. A “no” vote from the majority of the British public would lead to so-called “Brexit” taking place approximately two years later (once a withdrawal agreement had been negotiated between the EU and the UK and entered into force). Brexit would obviously have no effect upon UK national IP rights (although they could no longer serve as a tool to bar EU-wide protection), but the impact upon EU-wide IP rights would be significant.

While EU legislation provides for the extension of European Union Trade Mark (EUTM, previously CTM) or Registered Community Design (RCD) protection to new countries joining the EU, it is surprisingly silent as to what happens if a Member State leaves the EU. As unitary rights that have effect throughout the EU, there is much conjecture that existing

EUTMs and RCDs could not possibly continue to have any legal effect in the UK once the EU treaties cease to apply.

That being the case, it is widely speculated that transitional mechanisms would need to be established in order to allow existing EUTM and RCD rights to be converted into corresponding UK national rights, ie “successor” rights. Such provisions could possibly mimic Articles 112–114 of the current Council Regulation (EC) No 207/2009 (EUTMR), which enable EUTMs to be converted into national trade mark registrations if they satisfy certain criteria.

The importance of retaining the priority date of any such rights cannot be overstated, but whether such a conversion should be automatic or at the request of the owner is open to debate. EUTM owners would no doubt argue that this imposed conversion process should not incur any official fees, but this view would need to be balanced against the administrative burden

that such a sudden deluge of conversions would have upon the workload of the UK IPO.

Moving forward under this position, IP rights-holders requiring protection in the UK and EU would need to file separate applications, as EUTMs and RCDs would no longer afford them any protection in the UK. An obvious consequence of registering rights under multiple systems is an increase in filing and renewal costs for IP rights-owners. One wonders if EUTM and RCD official fees should be reduced to take account of the fact that there would be a diminution in the number of territories being covered. Also of note is the fact that such post-Brexit marks could no longer feasibly be sustained by virtue of any use made of the mark in the UK.

Alternatively, some hold the view that new legislation could instead be passed to confirm that existing pre-Brexit EUTMs and RCDs (ie those obtained between 1996 and the date of Brexit) would be deemed to still

THE BREXIT EFFECT

Carrie Bradley considers what a UK exit from the EU could mean for EU-wide trade mark and design rights



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Advisors may include special provisions in new licences to future-proof them – for example, by triggering an obligation to execute any necessary additional licences

apply to the UK up to the date its EU exit became effective. This could echo the way that existing EUTMs are deemed only to cover new countries joining the EU with effect from their accession date. Under this model, while EUTMs and RCDs filed post-Brexit would not cover the UK, conversion would not be required in order for existing EUTMs and RCDs to continue to apply to the UK (for that period) and a host of priority issues could thereby arguably be avoided. Likewise, such pre-Brexit EUTMs could presumably still rely upon any use of the mark made in the UK before the date of Brexit.

However, Brexit would also present a host of other wrinkles to be ironed out. For example:

- **Free movement of goods.** The principle of exhaustion of rights permits goods to be traded freely within the European Economic Area (EEA) market after their first sale by (or with the consent of) the EUTM/RCD rights-owner. Since exhaustion of rights applies EEA-wide, if the UK opts to remain in the EEA post-Brexit, this legal position would remain unchanged. Conversely, if the UK left the EU and the EEA, without any form of alternative free-trade agreement in place, then the opposite would apply. This would mean that EUTM and RCD owners could prohibit exports from the UK into the EU, and vice versa. An interesting question would then arise as to whether

the owners of any UK successor rights would be entitled to prohibit the importation/sale of goods in the UK that were first placed on the market in the EU before the date of Brexit.

- **EU-wide licences.** Perhaps it's a question of contractual interpretation, but one wonders if, post-Brexit, existing EU-wide licences would continue to cover the UK and if they would automatically include any new UK successor rights. Advisors may therefore wish to give thought to including special provisions in any new licences to future-proof them – for example, by way of triggering an obligation to execute any necessary additional licences.
- **Pan-EU injunctions.** It is currently possible for the UK courts to issue pan-EU injunctions against IP infringers. Obviously, this remedy would no longer be available to UK courts, nor would such future pan-EU injunctions have effect in the UK. It follows that the next logical question is whether parties with existing injunctions in place can continue to rely upon them insofar as the UK is concerned. While one might assume so, it is a point for clarification.
- **Representation rights before OHIM.** According to Article 93(1)(a) EUTMR, OHIM representation rights are dependent upon a legal practitioner being qualified in one of the EU Member States, such that they may act before their local IP office in trade mark and/or design matters. On this basis, it seems that UK-qualified practitioners could possibly lose their OHIM representation rights post-Brexit, since they would no longer be qualified in an EU Member State. That being the case, simply securing a business address for service within one of the EU Member States would surely be insufficient to

get around this issue. Of course, if the UK subsequently re-joined the EEA post-Brexit, then this would be likely to enable UK practitioners to retain their OHIM representation rights.

- **Unregistered Community Design rights.** Nationality or membership of the EU is not a requisite to benefitting from this right, so UK businesses should still be eligible, providing that disclosure of the design takes place within the territory of the (remaining) Member States of the EU.
- **Effect on case law.** EU legislation and CJEU case law would also be significantly affected by Brexit. The UK would need to give up representation in the European Parliament and European Council, and there would no longer be a UK judge on the CJEU panel. The UK would no longer be required to defer to the CJEU on points of law and, presumably, the UK would no longer need to transpose the recent Directive 2015/2436 into national law. Of course, there are a number of alternative models for a relationship with the EU that the UK could adopt post-Brexit. For example, the UK may seek: membership of the EEA and European Free Trade Association (EFTA), similar to the approach of Norway; EFTA membership with additional bilateral agreements, similar to Switzerland; or World Trade Organization membership, possibly augmented by negotiating its own free-trade agreement with the EU. Whichever route the UK opts for should an EU exit be supported, it is evident that the legal position ahead will remain unclear until the exact nature of the UK's EU relationship and memberships are determined. So, until the votes are counted, EU-wide IP rights-owners face uncertain times. ■



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Coffee and connection

Bernard Savage explains the value of a simple invitation

Anyone who has read my previous articles for the *ITMA Review* will be familiar with my mantra: “Stop selling and drink coffee.” But do you know who to invite for coffee? What’s the easiest way to ask? What do you do if you get no response? How do you follow up a coffee contact? These are some of the most common questions IP professionals ask me.

Let’s start with targeting people to invite. Review your sources of business in the past two years and create a list of clients, referrers and professional contacts, such as people in trade bodies, journalists and event organisers. Who has created opportunities for you? Who do you feel comfortable with? Perhaps they share your interests or you just “click” with them. Who can you possibly reciprocate with?

EFFECTIVE FILTERS

The key to targeting is to be focused, and that means using filters. There are hard filters, such as fees, sector credentials and strategic fit. And there are soft filters, such as like-mindedness. Think more about who these contacts might be able to refer you to or make introductions to, versus simply the direct business opportunity.

Having created a draft “coffee” list based on history, look ahead. Who do you want to begin conversations with? Which sectors will you target? This will generate names you haven’t identified in the initial exercise. Again, remember to include connectors – for example, those people who have a strong personal network.

IMPORTANT QUESTIONS

You are now in a position to hone your list. In tidying up this list, ask yourself two things. How likely is this person to accept an invitation? And can I help this person? Relationships that flourish are based on reciprocity.

Next create a “coffee plan”. Decide how many face-to-face contacts you want over the next 12 months and plan when you want these to take place. Put yourself in your contacts’ shoes; consider the business planning cycle, their financial year, holidays etc.

EMAIL INVITATIONS

How do you ask for a coffee meeting? Email works best. It’s less obtrusive than a phone call and more efficient. You also don’t get into the problem of leaving messages, and playing telephone ping pong. In your email message, be direct and suggest specific dates and times. It’s better to suggest dates a few weeks ahead rather than just a few days; you will appear more relaxed and there is more probability that your contact will be available.

OUTWARD FOCUS

In your email, make the reason for the meeting centre around your contact, not yourself and your firm. So, you might want to learn more about a new client initiative or service line. You might be interested in seeing your contact’s new premises or manufacturing plant.

FINAL STEPS

A common mistake is to assume that when you don’t get an immediate response to an invitation there is no interest in an informal meeting. In my experience, this is not generally true. Your contact might be on holiday, have just returned from holiday, be off work sick, have forgotten or delegated the scheduling to a PA. Persistence pays. So, email again a week or so later with an attention-grabbing phrase in the subject line and a polite reminder in a friendly tone of voice. Alternatively, try contacting the person by telephone or via LinkedIn messaging.

Finally, after your coffee meeting, follow up quickly via email outlining agreed actions and delivering on any promises.

Then, stay visible and repeat. A full coffee cup is the best way to maintain a healthy sales pipeline. ■



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.OPPS



Nick Wood highlights the issues and opportunities faced by brands as they embrace new gTLDs

By now, every ITMA member with an interest in domain names and their interaction with IP knows that the domain-name system is expanding. Some will be aware that the Internet Corporation for Assigned Names and Numbers (ICANN), which administers the domain-name system, was created in 1998, not just to ensure technical inter-operability, but also to enhance competition. After two “proof of concept” new generic top-level domain (gTLD) rounds in 2000 and 2004, which gave us extensions as “useful” as .aero, .biz and .pro, ICANN threw open the doors to round-one new gTLD applicants in January 2011. Six months later, it announced it had received 1,930 applications and banked \$357m.

Thirty-four per cent of the applications (664) came from brand owners. Why did so many apply? As Figure 1 shows, the most common reasons revolve around the value of communicating under one globally applicable master brand, though the opportunity to heighten security was also important.

BANKING BREAK-OUTS

In the use of .brand registries, the financial sector leads the way. Barclays is launching new services under its .barclays registry every month, while BNP Paribas has migrated its core internet banking site to its new .brand, under mabanque.bnpparibas and mabanquepro.bnpparibas. The idea appears to be that “if it doesn’t end in .paribas, its not Paribas”.

To see how BNP Paribas is building added-value sites with second-level domains in English and French, look at innovandconnect.bnpparibas, a banking programme dedicated to startups, or histoire.bnpparibas, which traces the history of the bank.

However, for every brand that is exploring the potential of its new registry with websites optimised for search engines, there are 25 proceeding with caution. This is partly because confidence in something so new has evaporated as ICANN’s process of delegation has limped along for more than 24 months. Where once a company had an enthusiastic, cross-disciplinary team featuring IT, information systems, marketing and digital experts, there is often now an isolated champion, probably in the trade mark team. Costs have not increased, but carrying forward a budget of \$100,000 year after year is not easy.

WORTH WAITING?

Certainly, some round-one .brand applicants think they should have waited for round two, and the arrival of so-called “universal acceptance” by internet users, engineers and designers of the new extensions. ICANN’s Policy Development Process for round two began at the end of February 2016. Insiders expect it will arrive in late 2017 or early 2018. Commentators expect significantly lower prices and a simpler application process, tailored for different types of applicant.

“There could be 5,000 round-two applications or as many as 10,000,”

said Jean-Jacques Sahel, ICANN’s Vice President for Europe, in January 2016. For brand owners struggling to address the impact and strategic implications of round one, this may not be welcome news. The universe of domain registries has grown by more than 300 per cent in the past three years – as the 24 legacy gTLDs and 320 country-code top-level domains (ccTLDs) open to business have been complemented by 1,200 new gTLDs.

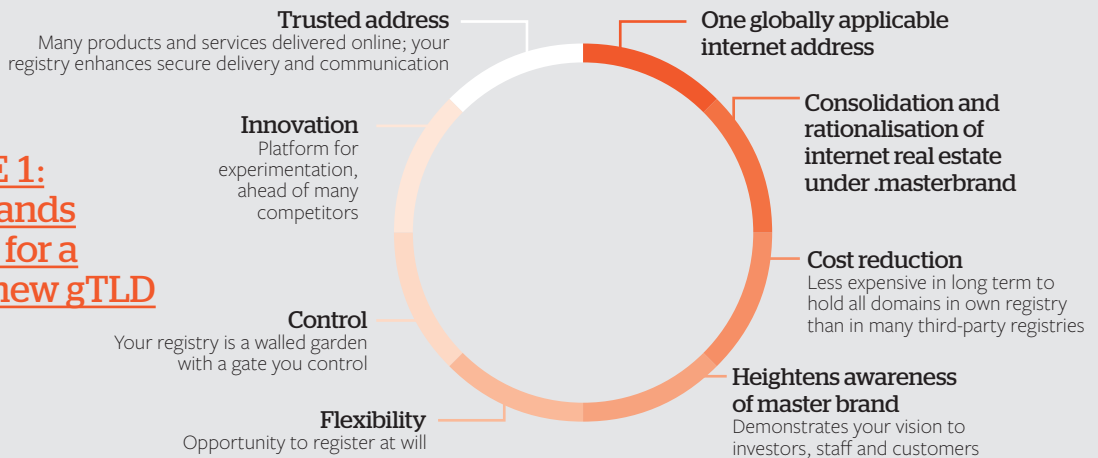
PROTECTION CHALLENGES

The tapestry of rights-protection measures ICANN created to wrap around the new gTLD programme has not been an unqualified success. The Uniform Rapid Suspension scheme was created as the little sister of the Uniform Domain-Name Dispute-Resolution Policy (UDRP) to tackle slam-dunk cases of abusive registration. Since Facebook won the first complaint in August 2013, more than 320 cases have been filed, with



The IP community must stay engaged, submitting comments and lobbying for beneficial change

FIGURE 1:
Why brands
applied for a
.brand new gTLD



rights-owners winning 90 per cent of the time. However, the rate of filing is slowing. Perhaps this is because it does not allow the transfer of a domain, only suspension until the date of renewal and, optionally, another 12 months. Certainly, some complainants find the strict rules of procedure make it hard to win, as there should be “no open questions of fact”. Since the bad guys chalked up a few high-profile victories (see branson.guru, alibaba.website, stuartweitzman.email), the number of UDRP filings has increased as brands turn to this less complicated and more predictable mechanism.

At the end of 2015, ICANN published its *Preliminary Issue Report on the Current State of the UDRP*, recommending a thorough review of the only proven global/borderless tool to combat cyber-squatting other than the courts. Already some parties,

including the Internet Commerce Association, which represents “domain investors”, have called for limitations on trade mark rights. WIPO is not amused. “The issue is not whether the UDRP can be improved, but whether it could effectively survive an ICANN process nominally directed to that end,” says Brian Beckham, Head of WIPO’s Internet Dispute Resolution Section. “Especially at a time of massive DNS expansion, the UDRP should be left to do its job.”

The Trademark Clearinghouse (TMCH) is on shaky ground, too. Created to take cost out of the process of protecting a brand across hundreds of new registries, it turned out to be complex and expensive. In December 2015, after three years of operation, it held only 40,000 records, a fraction of the total number of unique registered trade marks in the world; lapses have

now passed 10 per cent and are rising. The TMCH may have sent out over 200,000 notifications to trade mark owners, but it provides less value than more competitively priced, conventional domain-name watching, which covers all domain extensions (not just new gTLDs).

RAPID ACCELERATION

The total number of registrations under the new gTLDs now exceeds 14 million. A million registrations were added in both January and February 2016. This is a mere 4.5 per cent of the total of 300 million domains in the world, but the rapid rate of acceleration signposts popular adoption of the new gTLDs, which brand owners should not ignore. As ICANN develops round-two policy, the IP community must stay engaged, submitting comments and lobbying for beneficial change.

The good sense exhibited by most brand owners in the past three years in registering with great discretion only in relevant Open Registries points the way ahead for the short term. In the longer term, if round two offers a better-value application process, then it might be that .brand registries will become the norm, and the place where consumers go for authentic content. ■

FIGURE 2: Top 10 new gTLD registries by volume at end of February 2016

New gTLD	Registry	Domains
.xyz	XYZ.COM LLC	2,576,216
.top	Jiangsu Bangning Science & Technology Co Ltd	1,604,127
.win	First Registry Limited (Famous Four Media)	798,502
.club	Club Domains LLC	718,510
.wang	Zodiac Registry Limited	651,058
.网址 (xn--ses554g)	KNET Co Ltd	346,174
.science	dot Science Limited (Famous Four Media)	342,680
.site	DotSite Inc (Radix FZC)	313,756
.bid	dot Bid Limited (Famous Four Media)	305,134
.link	Uniregistry Corp	301,281



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Review responses

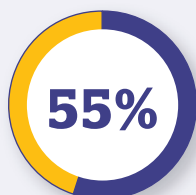
We recently surveyed members on their views of our magazine. Here are some highlights of what we learned

Recognising the importance of the *ITMA Review* to our membership, we have once again surveyed members and readers on their opinions of the magazine – how it fits into their professional practice and provides content of interest, and what they value most about this member benefit.

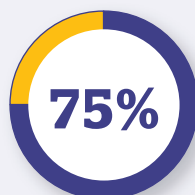
Once again, readers appear to be happy with their publication, and we were particularly pleased with the number of people who asked to receive more information about how they can contribute. Everyone who expressed an interest has now been contacted, and we look forward to working with them on articles of value in the future. We have also communicated with those who expressed an interest in completing the TM20 questionnaire for a future issue.

If you would like to contribute and did not communicate this through the survey, please do get in touch with the editor, Caitlin Mackesy Davies, at caitlin@thinkpublishing.co.uk. Our forthcoming copy deadlines for the remainder of the year are: 25 May, 6 July, 19 August and 13 October. All content is planned in advance with the assistance of the editorial working group, so if you are interested in preparing copy for any of these collection dates, contact Caitlin for further guidance. ■

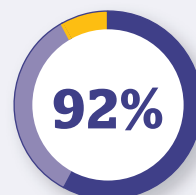
FAST FACTS



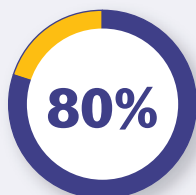
OF READERS ARE AGED 35-54



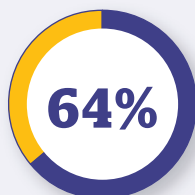
OF READERS HAVE BEEN A MEMBER OF ITMA FOR MORE THAN FIVE YEARS



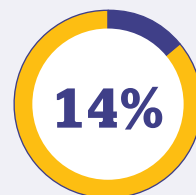
OF READERS ENJOY THE *ITMA REVIEW* EITHER
■ AT WORK (58%) OR
■ DURING THEIR COMMUTE (34%)



OF READERS STILL PREFER TO READ THE *REVIEW* IN PRINT, RATHER THAN AN ELECTRONIC VERSION



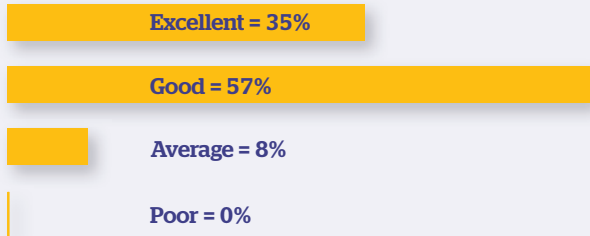
OF READERS KEEP COPIES FOR FUTURE REFERENCE



OF READERS READ IT COVER TO COVER IN ONE SITTING

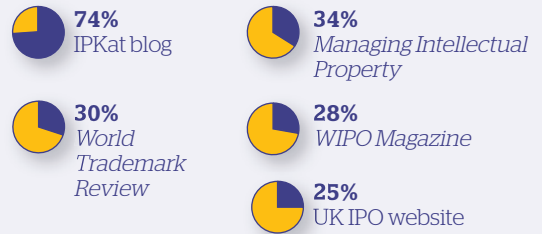
KEY FINDINGS

HOW DO YOU RATE THE ITMA REVIEW AS A MEMBER MAGAZINE?



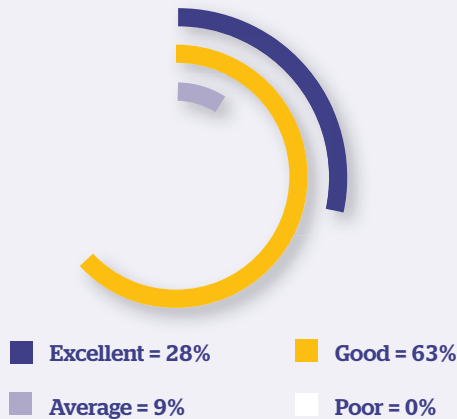
OTHER SOURCES OF INFORMATION – TOP FIVE*

ITMA Review readers also regularly read:

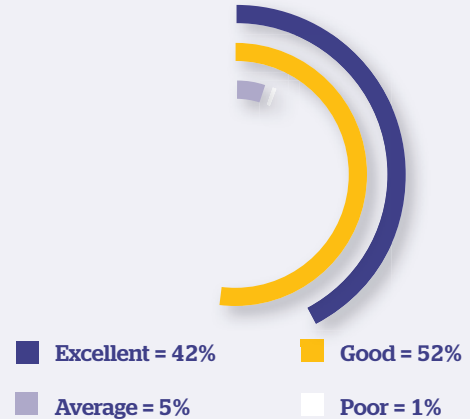


*excludes publications listed under the "Other" response

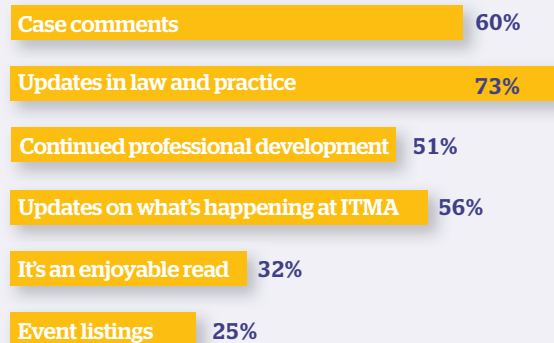
HOW DO YOU RATE THE EDITORIAL QUALITY OF THE ITMA REVIEW?



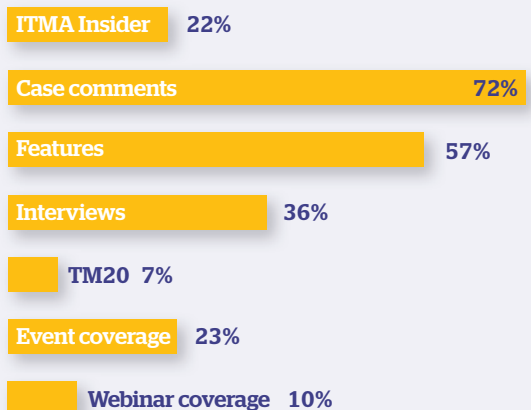
HOW DO YOU RATE THE QUALITY OF DESIGN OF THE ITMA REVIEW?



REASONS FOR READING – MULTIPLE CHOICES ALLOWED



READERS MOST ENJOY READING – MULTIPLE CHOICES ALLOWED



SEND US YOUR FEEDBACK

We are always happy to receive constructive comments and suggestions for feature topics of interest from *ITMA Review* readers. Do get in touch at caitlin@thinkpublishing.co.uk

BREAK FOR THE BORDERS



It's time to wake up to the benefits of effective new border-protection changes in South America, recommends Santiago O'Connor

The constant economic growth of Latin America, together with governmental stability in the region, is highlighting its opportunities for worldwide investors.

These opportunities are made more attractive by the efficient tools available in the fight against counterfeiting, assisted by sophisticated software, in a geographical zone in which this issue has historically been a headache (especially for foreign companies that wish to commercialise and sell their products and services safely).

The registration of IP with customs is an excellent instrument through which to avoid, at a first stage, the introduction of counterfeit goods into these countries. This is especially valuable, because the countries involved are large; consequently, the fight against counterfeiting once the products breach their frontiers can be difficult and time consuming.

However, during more than 30 years of IP practice, I have noted that foreign companies are reluctant to use this tool, which can be a beneficial preventative measure.

This article will focus on the IP border-protection systems available in Argentina, Brazil, Colombia, Chile, Panama, Paraguay and Uruguay, and aim to reassure readers that these systems are effective.

ARGENTINA



The Argentine tax authorities, under AFIP/ Customs Resolution No 2216, have created a so-called “Alert System”, which came into effect in 2007, whereby trade mark owners are able to obtain information and inspect goods identified with their trade marks before they are released into the marketplace. It is an important tool through which trade mark owners can control the import of counterfeit goods and parallel importation of genuine goods into Argentina.

To benefit from the Alert System, trade mark owners must provide Customs with the following:

- (i) a certificate of trade mark registration issued by the Argentine Trademark Office;
- (ii) identifiable features of the genuine goods, including samples;
- (iii) the category of the goods under the Mercosur Customs Classification of Goods;
- (iv) ports of entry to Argentina of legitimate goods; and
- (v) the name and email address of a local representative or attorney.

Registration of trade marks with Customs will be valid for two years, and renewable for similar periods of time.



BRAZIL

According to Brazilian industrial property law (Law No 9.279/96) and Customs regulations (Decree Law No 6.759/2009), Customs authorities, *ex officio* or at the request of an interested party, may seize any product in violation of IP rights (copyright, software or trade marks).

Based on the above provisions, the intellectual property rights (IPR) holder may file an inspection request with the Central Coordination of Customs Affairs (COANA) in order to present a list of IP rights and to trigger surveillance of any illegal imports.

Requests directed to major Brazilian ports and airports can also be made, which will overcome any lack of communication between COANA and the local Customs authorities.

In order to ground its request, the IPR holder has to present copyright, software or trade mark certificates of registration and any information that helps Customs to identify the products imported illegally (without

the proper IPR holder’s licence).

It is also advisable to attach a report bearing the names of the companies in Brazil that are authorised or licensed to import the products.

In addition to the written request, it is important to schedule a meeting with the Customs authorities, so that the IPR holder may clearly explain their concerns and make the local authorities familiar with the property that is being infringed.

The above strategy, together with a specific training programme for the Customs agents, generally gives the IP owner a better chance of having any illegal shipment automatically blocked at Brazilian ports and airports.

As a matter of procedure, if Customs authorities identify a shipment of counterfeit products, the IP owner is immediately notified to examine existing samples in order to verify their origin (and determine whether they are illegal) and to present a formal statement confirming

this condition. For this reason, it is important to determine who will be the contact person to receive Customs notifications concerning possible illegal shipments. This person can be anyone appointed by the IPR holder.

In addition to the border measures, to facilitate the interaction between the Brazilian enforcement authorities and the IPR owners, the National Council to Combat Piracy, in partnership with the Brazilian Patent and Trademark Office, has assembled a database known as the National Directory to Fight Counterfeiting. The database contains information regarding protected trade marks and contact details of IPR owners and their legal representatives. Access to this data is restricted to the Federal Police, Federal Highway Police, Internal Revenue Service, Customs, Federal Public Prosecutor, State Public Prosecutor, State Public Security Departments and State Criminal Institutes.



CHILE

Chilean Customs keeps a directory of registered trade marks with the National Institute of Industrial Property (INAPI). Holders who have registered with the INAPI will be able to register with Chilean Customs to aid in preventing the importation of any infringing products.

The trade mark directory database comprises information on all trade marks, including logos and any data useful for detecting counterfeit products. Chilean Customs officials constantly monitor imports that enter the country in order to preclude the entry of any goods infringing on registered trade marks. Furthermore, owners will be able to access the database directory from any port in Chile.

The documents required to carry out the registration are: a power of attorney from the trade mark holder; the trade mark registration certificate; and, if possible, a manual or similar document that may help Customs identify a counterfeit product. The Customs directory is valid throughout the period during which the trade mark is effective at the INAPI. It takes approximately one to three months to obtain the corresponding certificate.



COLOMBIA



Colombia has a Customs trade mark registration system, administered by The National Directorate of Taxes and Customs (DIAN), for the purpose of preventing any activity that facilitates an infringement on any rights comprised in the Customs directory from entering Colombian territory.

Customs trade mark registration is regulated by Decision 486 of the Andean Community of nations, an inter-governmental organisation ruling industrial property in Colombia, Peru, Ecuador and Bolivia.

Border measures in Colombia work as follows:

- The owner of a trade mark who has grounds to believe an import or export of any products infringing on their trade mark is occurring can request the appropriate authorities to void that Customs procedure.
- It is of the utmost importance that the owner of the trade mark files a written petition for this measure to be enforced, enclosing a certified copy of the trade mark.
- Border measures can also work *ex officio* at the moment the appropriate authorities consider

that there are sufficient grounds to use that tool. In that case, the DIAN will endeavour, if possible, to establish a direct contact with the trade mark holder or, if unable to do so, contact the Superintendency of Industry and Commerce to get through to the trade mark holder.

- Once a petition of annulment has been filed, Custom Authorities will inspect the goods and, if they instruct that such Customs procedure be annulled, the trade mark holder will be allowed a period of 10 days to file an infringement complaint. This complaint may be criminal or civil, whatever the trade mark holder decides.
- It is also important to note that, within the 10-day period, the trade mark holder must file a bond in order to secure any damages the importer or exporter might suffer.
- It will be necessary to submit evidence that a court action has been started and that the aforementioned bond has been filed; otherwise the Customs procedure suspension will be lifted.
- While the court decides on the controversy, the goods will remain in the custody of Customs authorities



and, once the legal process is completed in favour of the trade mark holder, the judge hearing the case will decide on the final destination of the merchandise.

When applying border measures, the role of the DIAN is most significant. It is facilitated by the inclusion of trade mark registration and industrial designs in the DIAN directory, which enables the holders of trade marks and their agents to be contacted should a trade mark infringement occur. Once the information is included in the DIAN's directory, Customs Authorities will be able to contact the rights-holder.

PANAMA



The Panamanian legal framework allows trade marks to be registered with the General Customs Administration. The requisites are: power of attorney; and the name, class, registration number and holder of the trade mark as registered with the Directorate General of the Industrial Property Registry (DIGERPI). It is desirable, though not required, to provide a sample of the goods, as well as the name of the distributor and/or licensee, if applicable. The registration process will take approximately two months.

The term of effectiveness of the certificate of registration with the Customs administration will be the same as the Panamanian certificate of registration with DIGERPI (10 years) and the certificate can be renewed for further 10-year periods, as long as the trade mark is also renewed. Finally, as soon as the trade marks have been registered, the national Customs administration will be empowered to carry out discretionary investigations on the existence of counterfeit marks within Customs premises throughout the country, including the Colón Free Trade Zone.

PARAGUAY



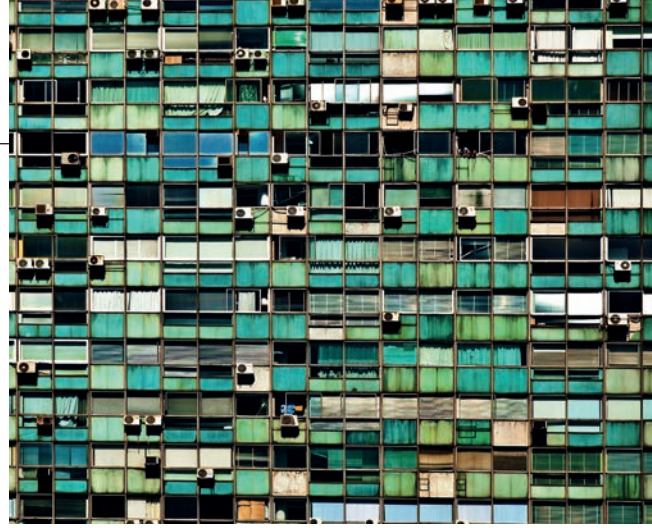
Paraguay implemented a trade mark directory in January 2008. This initiative was adopted for the purpose of intensifying the fight against piracy and counterfeiting in Paraguay. The Customs directory complies with the Agreement on Trade-Related Aspects of Intellectual Property Rights, which has been endorsed by Paraguay.

Once a trade mark is registered, and appropriate documents for the cancellation of Customs taxes and the import of trade marked goods have been filed, it can be verified whether an importer is other than the enrolled person or company. If goods are being imported by another person, Customs officials will automatically retain the merchandise and order the interruption of the import process. They will send written notice to the Intellectual Property Agent enrolled with Customs and will enclose a copy of the original documents submitted for the shipment.

Within 24 hours, the Agent will notify its client and trade mark holder that goods have been retained and then inform Customs whether its client requests the definitive retention of the goods. If no notice is received within the aforementioned period, Customs will instruct its officials to proceed with the import process. This procedure will not be applied to containers or cargo shipped into Paraguay by local firms that have been authorised by the trade mark holder. To register, the following must be supplied:

- a Customs form completed by an Industrial Property Agent, with a certified copy of the trade mark registration title issued by the Paraguayan Directorate of Industrial Property, and a power of attorney granted by the owner of the trade mark;
- a description of the products protected by such trade marks;
- identification of the name and address of the authorised distributor(s) in Paraguay, if any; and
- product catalogues.

After Customs has approved the registration application, it will enter the trade mark into the Trademark Directory. Once complete, it will issue a certificate, which will expire on the same date as the trade mark registration.



URUGUAY



Uruguayan legislation does not include a Customs trade mark registration. However, at present, the Intellectual Property, Asset Laundering and Drug Trafficking Division of the National Customs Administration holds an informal directory of trade marks with Customs. Such registration is not required, but it is up to each party to decide whether it chooses to register its trade marks with the Division.

It is worth noting that, if a trade mark is registered, as soon as Customs verifies that there has been a possible counterfeiting of a product in Uruguay, whether within its territory or within Customs premises, the holder or local representative in Uruguay will be notified, so that they appear in court to report the presumed counterfeiting. If a complaint is filed, the presumably counterfeit products will be confiscated and eventually destroyed, since such products would be infringing on the rights of a registered trade mark.

Finally, when a trade mark is entered into the aforementioned informal directory, the Division also makes it possible for the trade mark holder to apply for a provisional Customs safeguard, by reporting the details of any presumed infringement so that Customs authorities become aware of the situation and can act promptly.

→ INTEGRATED APPROACH

Nowadays, fighting against counterfeiting is a 24-hour battle, which requires integrated and easy implementation of a series of actions involving not only filing civil and/or criminal prosecution, but also taking advantage of advanced software in order to expedite and prevent counterfeiting.

However, as I hope I've shown, South America's main players have now adopted efficient IP border-measures systems that will empower IP owners in the fight against counterfeiting. ■



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Stylisation altercation

*This decision leaves Luke Portnow
pondering an important question*

THIS DECISION COMES to us from an appeal to the Appointed Person of a UK IPO opposition. The Royal Academy of Arts had filed to register the plain word mark RA, claiming goods and services spanning 19 classes, and was opposed by Erreà Sport SpA (Erreà) based on a stylised Community Trade Mark (CTM) registration, shown below, for goods and services falling in classes 9, 14, 16, 18, 24, 25, 28 and 41.

The Hearing Officer's decision was that, while all of the contested goods and services were either identical (or at least highly similar), the Opposition was to be rejected in its entirety. Although the word elements were aurally identical, when taken as a whole, the marks were visually dissimilar under the "global appreciation" test.

It was held that the relatively high distinctiveness of the earlier Erreà mark was attributable only to its "heavy stylisation". Since this was absent from the later-filed mark, it

“

The Appointed Person held that the difference between 'no' and 'a low degree of' visual similarity is subjective and impossible to define

did not increase any likelihood of confusion, particularly as the decision for purchasing was likely to be made on a visual basis for the goods and services at issue. No visual similarity was deemed to exist.

SUBJECTIVE TEST

The Opponent appealed this decision, based on the Hearing Officer's finding that there existed no visual similarity between the marks. The Appellant argued this was wrong, and that the Hearing Officer should have found a low degree of visual similarity and a resulting likelihood of confusion.

The Appointed Person held that the difference between "no" and "a low degree of" visual similarity is not only impossible to define, but quite subjective. He agreed with the Hearing Officer's decision, and held that, in the case of the heavily stylised earlier mark, taking aural similarities alone would ignore its real substance and distinctive character, and would likely lead to an erroneous result.

The Appointed Person also dismissed the Opponent's argument that, even if there had been no error in principle, the Hearing Officer had been "plainly wrong" and unreasonable under the Reef criteria. This was flatly rejected by the Appointed Person, who

also deemed it an unfair "wholesale re-arguing" of the case, and would not consider it, as it was not foreshadowed in the Appellant's Grounds of Appeal.

TAKE-HOME THOUGHTS

There are two main points to take away, along with an overriding question. First, significant stylisation in an earlier mark can lead to a finding of no likelihood of confusion, even when the later-filed mark comprises an identical word or letter element and claims identical goods and services. Second, any arguments submitted at such a hearing, however worthy, should always be set out in advance under the Appeal's supporting Statement of Grounds.

It is unclear whether a similar decision could be reached were the facts reversed: could a likelihood of confusion be found between an earlier plain word mark and a later-filed mark that is stylised but comprises the same word elements? From this decision the answer is unclear. However, based on its reasoning, it may well be "yes".

The Erreà Sport CTM



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High Court to hear Gap case



Emily Mallam shows how opposing parties were able to agree on a way ahead

GAP 360 LTD (the Applicant), a company specialising in gap-year travel, applied to register GAP 360 in classes 35, 36, 39 and 41. The services applied for in classes 36 and 41 were limited by the words “all relating to gap travel”.

The application was opposed by the clothing company Gap (ITM) Inc (the Opponent). The opposition was upheld in relation to classes 35 and 39 and rejected in relation to classes 36 and 41, the Hearing Officer placing importance on the limiting effect of the words “all relating to gap travel”.

The Applicant appealed to the Appointed Person against the rejection of its application in classes 35 and 39 and the Opponent appealed against the rejection of its opposition to the registration in classes 36 and 41. The Opponent contended that:

- 1) the words “all relating to gap travel” should have been disregarded for lack of clarity and precision;
- 2) even taking those words into account, they should have been found to be a deficient limitation; and
- 3) even upon giving operative effect to the words “all relating to gap travel”, the wording should have been found to render the application in classes 36 and 41 no less objectionable than in classes 35 and 39, which the Hearing Officer rejected.

The Opponent requested that the Applicant’s appeal be referred to the High Court under Section 76(3) of the Trade Marks Act 1994, or stayed, pending the appeal to the High Court. The Applicant and the Registrar

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The Appointed Person was satisfied that the overlap between the pending appeals made it undesirable for consideration by both the High Court and the Appointed Person

opposed. The Appointed Person’s decision in relation to the Opponent’s request is detailed below.

AP OPINION

The Appointed Person referred to the principles set out in Elizabeth Emanuel Trade Mark [2004] RPC 15. He found that the Applicant’s appeal raised no issues of fact or law that warranted referral to the High Court if assessed independently to the Opponent’s appeal. In relation to the first and second of the Opponent’s three propositions, it was found that

the absence of the words “all in relation to gap travel” from the services in classes 35 and 39 meant that there was no need to consider them in order to determine the Applicant’s appeal.

In relation to the third of the Opponent’s propositions, the Appointed Person was satisfied that the overlap between the pending appeals made it undesirable for consideration by both the High Court and the Appointed Person. However, he was concerned that a referral of the Applicant’s appeal to the High Court would put the Applicant under financial pressure, leading it to withdraw from both appeals.

ACTION AGREEMENT

The parties subsequently agreed, among other things, that the Applicant’s appeal could be referred to the High Court, subject to capping the costs liability to the significantly lower costs available in an Appeal to the Appointed Person. The Appointed Person was therefore satisfied that the Applicant’s appeal should be referred to the High Court.

This is a good example of the parties agreeing to a way forward that assists the resolution of the matter.



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Decision confirms similarity between foodstuffs and related services, says Nicole Giblin

IN MARCH 2014, J Sainsbury plc (Sainsbury's) applied to register SAINSBURY'S TOP DOG in relation to the following goods in class 29: "meat, poultry and game; hot dogs; meat extracts; meat products; meat pies; sausages; mincemeat; hamburgers; beef burgers; poultry products; snack foods; prepared meals; [and] constituents for meals".

Top Dogs Eats Limited (Top Dogs) filed opposition on the basis of its earlier UK and Community Trade Mark registrations for TOP DOGS, covering a range of restaurant and catering services in class 43. The services covered included "services for providing food and drink".

IMPORTANT DISTINCTION

The opposition decision found that the trade marks were visually, phonetically and conceptually similar to a medium degree. However, the focal point of the decision concerned whether there was any similarity between services for providing food and drink in class 43 and the "raw" and "processed" foods in class 29.

The Hearing Officer found partially in favour of Top Dogs in that "hot dogs; meat products; meat pies; sausages; hamburgers; beef burgers; poultry products; snack foods in class 29; [and] prepared meals in class 29" were considered to be similar to services for provision of food and drink in class 43. In particular, these

foods were "ready to eat" and could be "selected as an alternative to eating at a catering venue". As such, the respective goods and services targeted the same end user and were also in competition with one another.

The opposition was, however, refused for the remaining goods in class 29 ("meat, poultry and game; meat extracts; mincemeat; [and] constituents for meals"). These goods were considered "raw" ingredients not requiring further processing. The Hearing Officer considered that they were "a step removed" from catering services and found no similarity.

DECISION APPEAL

Top Dogs appealed the decision to the Appointed Person on the basis that the Hearing Officer had erred in distinguishing between the "raw" and "processed" goods in class 29 when compared with services in class 43. Top Dogs argued that processed goods are subsets of raw goods and that the raw goods should also have been found similar to the class 43 services.

The Appointed Person found in favour of Top Dogs and commented

that all of the class 29 goods have been prepared for consumption and that "raw" goods such as meat do not necessarily require further processing before being "ready to eat". Decision O/001/10, Cucina Trade Mark, was quoted in its finding that "meat ... will include products which have been cooked ... not just products in a completely unprocessed form". As such, there was no logical reason to draw a distinction between the goods in Sainsbury's application. Reference was also made to the class heading which contains the term "meat" and it was concluded that the processed goods were subsets of the goods identified in the class heading. The Appointed Person allowed the opposition in full, finding that all of the Sainsbury's class 29 goods were similar to Top Dogs' class 43 services.

The decision is not the first to find these two classes to have similarity. However, with many restaurants now providing own-brand products, brand owners may find it comforting that the UK IPO continues to find a similarity between foodstuffs and services in class 43.



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New media, new issues

Peter Brownlow reviews how the internet ended a once peaceful coexistence

THIS DECISION CONCERNS

a dispute relating to the use of MERCK between two multi-national pharmaceutical companies with a common origin. In 1955, the businesses entered into a worldwide coexistence Agreement relating to how and in which countries each of them could use MERCK. In 1970, minor amendments were made to the Agreement (the 1970 Agreement).

A dispute arose as to how the 1970 Agreement applied to the internet. Proceedings for UK trade mark infringement and breach of contract commenced in May 2013. The Court had previously decided that German law governed the 1970 Agreement.

The decision is of interest in considering the application of coexistence agreements to new media, as well as the extent of the resulting relief.

BREACH OF CONTRACT

Under German contract law, it was necessary to ascertain the intention of the parties, rather than adhere to the precise words of the contract. The 1970 Agreement permitted Merck Sharp & Dohme Corp (MSD) to use “Merck & Co Inc” as all or part of a corporate name, provided it was given a geographical identifier of equal prominence (such as “Rahway, New Jersey, USA”). This implicitly prevented the use of the word “Merck” alone, since the purpose of the contract was to ensure that, when MSD used a name including “Merck”, it had to be clear that the entity was located in the US.

The Judge decided that, although the internet had not been contemplated when the Agreement was first negotiated, it did govern use of the word “Merck” as all or part of a trade name or trade mark on the internet.

The Judge dismissed MSD’s argument that these websites were really targeted at the US and Canada, where it was permitted under the 1970 Agreement to use MERCK, and that their accessibility from the UK was unpreventable “overspill”.

The Judge also rejected arguments that a statement in the terms of use of MSD’s website that it “is intended for use by residents of the US” made any difference, as it was contradicted by the content of the site.

However, the Judge held that MSD had used merck.com and @merck.com email addresses outside the US and Canada for two decades. As a consequence, he decided that any injunction would not prevent the use of @merck.com email addresses by MSD employees based in the US and Canada.

TRADE MARK CLAIM

On the non-use revocation claim, the Judge partially revoked the Claimant’s UK Trade Mark in respect of a few

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The Judge decided that, although the internet was not contemplated when the Agreement was negotiated, it did govern use of the word ‘Merck’ as a trade mark online

sub-categories of goods and services, but stated that the changes were “pinpricks” and did not affect the substantive claim.

As to infringement, the Judge decided that MSD’s websites were undoubtedly global websites with specific UK content directed at UK individuals. He held that, where use of MERCK created an impression of a link between relevant goods and services, there was trade mark infringement under Section 10(1) Trade Marks Act 1994 (TMA). He held that, if it had been necessary, he would have also found infringement under Sections 10(2) and (3) TMA. Finally, he rejected MSD’s own name defence.



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Where will Nestlé go next?

James Moore believes the future of three-dimensional marks may hang on the next KitKat chapter

THIS CASE CONCERNS a three-dimensional mark – in particular, the issue of acquired distinctiveness, following use within the meaning of Article 3(3) of Directive 2008/95, and the necessary and sufficient requirements for such distinctiveness to be established.

The Appellant, Société des Produits Nestlé SA (Nestlé), applied to register the three-dimensional sign corresponding to the shape of its four-finger KitKat product, but without the logo embossed on each of the fingers (the Trade Mark) in the UK for various goods in class 30. This application was subsequently opposed by Cadbury UK Limited (Cadbury). Nestlé argued that the mark had acquired distinctiveness. However, finding against Nestlé, the Registrar of Trade Marks held that the Trade Mark was devoid of inherent distinctive character in respect of all goods apart from “cakes” and “pastries”. Nestlé appealed and Cadbury cross-appealed against the decision.

REFERRED QUESTIONS

While considering the case, Mr Justice Arnold first referred to previous case law. In particular,

he pointed to Société des Produits Nestlé SA v Mars UK Ltd, in which the CJEU stated that, to acquire distinctive character through use, the identification of the source of origin of a product or service must result from the mark’s use as a trade mark (ie, so it fulfils its basic function of indicating the source of origin). However, it does not need to be used independently. Subsequently, he referred three questions to the CJEU for a preliminary ruling. The parties didn’t disagree over the outcome of the second or third questions. However, the final judgment did discuss question one. It asked whether:

- 1) it is sufficient for the applicant to prove that, at the relevant date, a significant proportion of the relevant class of persons recognises the mark and associates it with the applicant’s goods in the sense that, if they were to consider who marketed goods bearing that mark, they would identify the applicant; or
- 2) the applicant must prove that a significant proportion of the relevant class of persons relies upon the mark (as opposed to any other trade marks that may also be present) as indicating the origin of the goods.

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While distinctive character may be acquired when used in conjunction with other marks, the mark in question needs to identify the source of origin by itself

TRANSLATION ISSUES

As repeatedly pointed out by the Judge, a certain degree of inaccuracy appeared in this case as a result of translation issues. In his opinion, the Advocate General changed the words “rely upon” to “regard” in the original question and opined that it is not sufficient to prove the recognition and association of the Trade Mark for the purpose of acquiring distinctiveness through use. Rather, in the Advocate General’s opinion, it is necessary for the trade mark in respect of which registration is sought (as opposed to any other trade mark which may also be present) to indicate the exclusive origin of the goods concerned, without any possibility of confusion.

While distinctive character may be acquired when used in conjunction with other marks, the mark in question needs to fulfil the function of identifying the source of origin by itself. Therefore, the question the court needs to answer is whether the four-finger shape, when used independently of its packaging or any references to KitKat, serves to identify the product without any possibility of confusion.

CJEU JUDGMENT

The CJEU reformulated the question, which was criticised by the Judge, who believed this resulted in the final answer being incomplete. The reformulated question asked whether an applicant must prove that the relevant class of persons perceives the goods or services designated exclusively by that mark, as opposed

to any other mark which might also be present, as originating from a particular company; or whether it is sufficient to prove that a significant proportion of the relevant class of persons recognises the mark and associates it with the applicant’s goods. The Court concluded that, regardless of whether the sign is used as part of or in conjunction with a registered trade mark, the applicant must prove that the relevant class of persons perceives the mark alone as identifying the goods to which it relates as originating from a particular undertaking.

Arnold J seemed rather unhappy with the answer he was given and blamed the uncertainty on the translation issues. In his analysis, the CJEU’s judgment and the Advocate General’s opinion seemed to be in line, and therefore he concluded that, while a simple recognition and association is not sufficient, it needs to be proven that, at the relevant date, a significant proportion of the relevant class of persons perceives the relevant goods or services as originating from a particular undertaking because of the mark in question.

JUDGMENT

The Judge agreed with the Hearing Officer’s reasoning that Nestlé had proved recognition of the Trade Mark, but not that consumers rely on it to identify the source of origin. He also maintained the Officer’s position

regarding applying the law as stated in Vibe. In the light of the CJEU’s answer, Arnold J concluded that the Appellant’s submission that association is sufficient to establish the acquisition of a distinctive character was incorrect. What’s more, the Judge agreed with the Hearing Officer that the survey presented during the original proceedings was not enough. There were likely to have been a number of other similarly shaped products by other undertakings on the market, and there was no evidence that consumers thought that those were KitKat products. Accordingly, this was inconsistent with the Trade Mark having acquired a distinctive character.

REQUIREMENT RISK

There is a risk that, by this judgment, Arnold J has raised the requirement for registrability so high that virtually no three-dimensional marks will be able to be registered. This case established that, in order for a mark to acquire distinctive character, it must fulfil its basic function – to identify the source of origin to consumers – on its own and without the help of other indications. In practice, it is hard to see what form of evidence might be accepted as establishing this. However, an appeal appears to be pending and, if this judgment is overturned by the Court of Appeal, the future of three-dimensional marks may be brighter.



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[2016] EWHC 52 (Ch), The London Taxi Corporation Limited v Frazer-Nash Research Limited and Ecotive Limited, High Court, 20 January 2016

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The Court held that consumers would perceive the Trade Marks to be a variation of the typical taxi shape, so they were held to be devoid of distinctive character

THE CLAIMANT, The London Taxi Corporation Limited, trading as The London Taxi Company (LTC), is the successor in title to the manufacturer of the Fairway, TX1, TXII and TX4 models of London taxi. The Defendants, Frazer-Nash Research Limited and Ecotive Limited, are successors in title to the manufacturer of the Beardmore, Oxford and Metrocab models of London taxi.

LTC initiated proceedings against the Defendants for trade mark infringement and passing off on the basis of its Community Trade Mark (CTM) Registration No 951871 for its London taxi three-dimensional shape mark in *inter alia* class 12, covering “motor vehicles, accessories for motor vehicles; parts and fittings for the aforesaid” (dated 5 October 1998), and UK Registration No 2440659 in class 12, covering “cars; cars, all being taxis” (dated 1 December 2006) (the Trade Marks). The three-dimensional shape mark of LTC’s UK Registration forms the subject matter of LTC’s UK Registered Design No 2069313 (the registered design was not relied upon by LTC, nor was copyright).

LTC claimed that the Defendants threatened to infringe the Trade Marks; threatened to commit passing off by marketing a new model of London taxi (the Metrocab); and had intentionally copied the shape of its black cabs in designing the Metrocab to deceive both taxi drivers and the public that it originated from

More work on knowledge needed

Education of the public might have given LTC useful ammunition, suggests Eleni Mezulanik

LTC. The Defendants denied these claims and submitted that: the LTC Trade Marks were invalidly registered as they lack distinctive character and add substantial value to the goods; and, in the alternative, that the CTM should be revoked for non-use. LTC relied on acquired distinctiveness and disputed the allegation of non-use.

The average consumer was a taxi driver, because members of the public that hired the taxis were considered only consumers of taxi services.

VALIDITY ISSUES

The Court applied the principles of settled case law (C-344/10 P and C-345/10 P, Freixenet SA v OHIM, [2011] ECR I-10205), in particular that a three-dimensional mark that departs significantly from the norm or customs of the sector fulfils its essential function of indicating origin and is not devoid of distinctive character (C-136/02 P, Mag Instrument v OHIM [2004] ECR I-09165, paragraph 30).

As average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape ([2004] EWCA Civ 1690, Bongrain SA, Re Trade Mark Application, [2005] RPC 14), it proves difficult to establish distinctive character in relation to a three-dimensional mark. The Court held that the average consumer would perceive the Trade Marks to be a mere variation of the typical taxi shape, so they were held to be devoid of distinctive character.

Mr Justice Arnold applied his interpretation of the CJEU's ruling in the KitKat case and considered that, in order to demonstrate that a mark has acquired distinctiveness, a significant proportion of the relevant class of persons must perceive the goods or services to originate from a particular entity because of the trade mark. LTC failed to demonstrate that the Trade Marks acquired distinctiveness among a significant proportion of taxi drivers in the UK (or even in London).

Bearing in mind that LTC has a UK Registered Design, Arnold J considered the key purpose of

Article 3(1)(e)(iii) of the European Parliament and Council Directive 2008/95/EC (the Directive) to prevent trade marks from being used indefinitely to extend the time-limited protection of other IP rights. Arnold J held that the shape of the taxis gave the Trade Marks substantial value and upheld the objection of validity of the UK Registered Mark, which would prevent LTC from obtaining a permanent monopoly for the three-dimensional mark, rather than a 25-year monopoly.

REVOCATION

LTC argued that it made genuine use of the mark during the relevant period through sales and other disposals of used Fairway taxis, and, in the alternative, relied on sales of the other models during this period as being use of the CTM in a form differing in elements which did not alter the distinctive character of the CTM. Arnold J did not make a final decision on whether second-hand sales can amount to genuine use. However, in this case, it was held that use of the CTM did not constitute genuine use in the Community; and the CTM should be revoked in respect of class 12.

INFRINGEMENT

The Court held that the Trade Marks were of low distinctive character and that there was a low degree of similarity between the appearance of

the new Metrocab and LTC's taxis. Despite the low degree of attention paid by consumers, all infringement claims were rejected due to there being no likelihood of confusion. Further, it was held that the Defendants had a defence under Articles 6(1)(b) or 12(b) of the Directive.

PASSING OFF

The Court considered that "it is more difficult to acquire a sufficient reputation and goodwill in the shape or get-up of a product", as the shape and get-up are not normally considered for such a purpose ([2010] EWHC 1237 (Ch), Numatic International Ltd v Qualtex UK Ltd, [2010] RPC 26 at [39]). It was held that the Metrocab denoted that a vehicle was a licensed London taxi and that there was no evidence that its shape was likely to lead consumers to believe it came from LTC. There was no finding of deception or damage on behalf of the Defendants, and as such the claim for passing off failed.

CLOSING COMMENT

This case explores the difficulty associated with shape marks and reiterates the fact that the public is not used to mere shapes conveying trade mark significance. Therefore, it is prudent for trade mark owners to educate the public that a shape mark acts as a badge of origin so that it can be a valid registered trade mark.

CTM No 951871



UK No 2440659

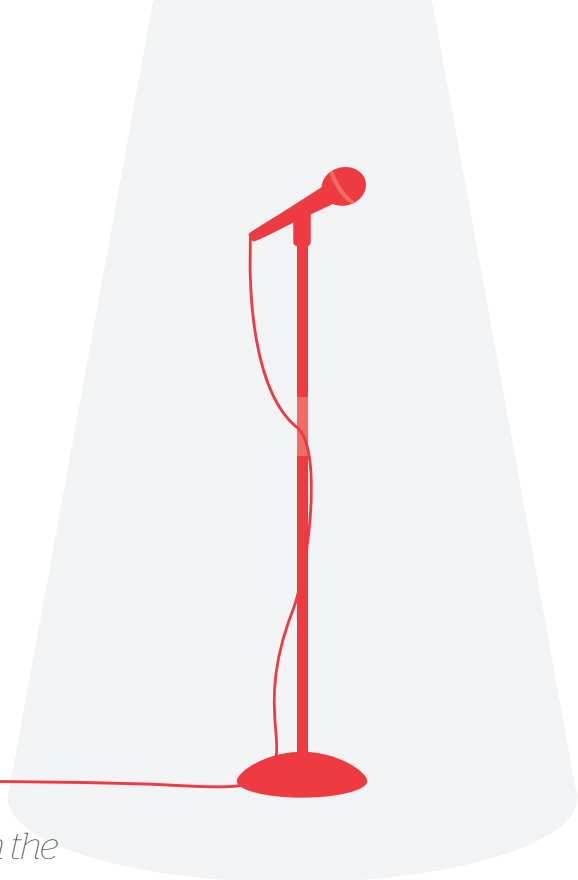


The Metrocab



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Reverse logic

Nick Smee explains the latest decision in the dispute over hit TV show Glee

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THE COURT OF APPEAL has confirmed that a series of two device marks owned by Comic Enterprises (Comic) has been infringed by Twentieth Century Fox’s (Fox’s) hit TV show *Glee*, but that Fox’s activities do not amount to passing off. The validity of Comic’s trade mark remains to be determined, following Fox’s challenge to the validity of all series marks.

SETTING THE SCENE

Comic operates venues in Birmingham, Cardiff, Oxford and Nottingham, offering stand-up comedy, live music, cabaret and night-club entertainment. It registered UK Trade Mark 2200698 (the Mark, shown below) in 1999 in relation to a number of services, including entertainment services, comedy services, and the provision of live and recorded music.

Fox’s television series *Glee* follows an American high school singing club at the fictional William McKinley High School, Ohio.

Comic brought a claim for trade mark infringement under Sections 10(2) and (3) Trade Marks Act 1994 (TMA) and a claim for passing off. Fox counterclaimed that the Mark was invalid and the specification was too broad.

In February 2014, the High Court partially revoked the Mark for non-use, but services including “live comedy services” and “provision of live and recorded music” were retained within the specification. The TV show was found to infringe under Sections 10(2) and 10(3) TMA, though Comic’s passing off claim was unsuccessful. Fox appealed the finding of

trade mark infringement; Comic appealed on passing off.

The Court of Appeal considered that the first-instance Judge had fallen into error, but, nevertheless, his findings in respect of both trade mark infringement and passing off were upheld.

Infringement under Section 10(2) TMA requires a likelihood of confusion. Usually, members of the public who are already aware of the mark come across the infringing sign and are confused into believing it came from the same or a connected undertaking. However, in this case, most of the evidence of confusion was the other way around, ie members of the public who were aware of the *Glee* TV show came across the Mark for the first time and were confused into believing that the two were connected. It fell to be determined whether such “wrong-way-round confusion” was relevant to the assessment of infringement.

Fox contended (among other arguments) that “wrong-way-round confusion” is irrelevant as a matter of law, given that such confusion can only arise after the relevant date of assessment (the date on which the sign first started to be used).

The Court of Appeal disagreed. Lord Justice Kitchin, who gave the leading judgment, ruled that, in every case, the test for infringement remains the same: whether, having regard to a notional and fair use of the mark in relation to all of the goods or services for which it is registered and having regard to the use of the sign, there is a risk that the average consumer might think the goods or services come from the same or linked

**Comic’s Mark
2200698**





The cast of Fox's TV show *Glee*
RANDY MIRAMONTEZ / SHUTTERSTOCK.COM



undertakings. The analysis involves an element of looking forward, and evidence that comes to light after the first use of the sign may assist the court in answering the statutory question. However, he warned that evidence of “wrong-way-round confusion” must be assessed with care, along with all the other evidence that may assist in answering the question in the context of any particular case.

The Court concluded that there was a likelihood of confusion.

OTHER KEY DECISIONS

For a finding of infringement under Section 10(3) TMA, the average consumer must establish a “link” between the mark and sign. Fox contended that, since Section 10(3) is founded upon the reputation of the registered trade mark relied upon, the requisite ‘link’ must be made by average consumers who are already familiar with the mark.

However, applying Intel, the Court of Appeal held that a global assessment of all relevant factors was required, including the similarity between the mark and sign, and between the related services; the mark’s distinctive character and reputation; and the existence of a likelihood of confusion. It concluded

that the Mark would be called to mind. The evidence of “wrong-way-round confusion” helped to demonstrate that Fox’s use of “glee” would cause average consumers to make the requisite connection. The Court also found that the scale of Fox’s use of “glee” was having a serious impact upon Comic’s business and its ability to use its Mark for the purpose of identifying and promoting its venues.

The Court of Appeal found that there was no passing off. Kitchin LJ was not persuaded that the launch of the *Glee* TV series amounted to a misrepresentation such as to cause a significant number of consumers to believe that the business behind the Birmingham and Cardiff venues (which predated the TV show) was the same as or connected to the business behind the show. The goodwill associated with the Birmingham or Cardiff venues had not been materially affected by the launch of the series. The real problems came

to light when Comic later opened its Nottingham and Oxford venues.

CONCLUDING REMARKS

The Court of Appeal’s judgment provides important guidance on the relevance of “wrong-way-round confusion” in the assessment of trade mark infringement and of the complementary but distinct nature of trade mark law and passing off.

One further issue still remains to be determined, namely whether the Mark, being a series mark, is invalid, because Section 41 TMA, which allows series marks to be registered, is not compatible with the requirement in EU law that a trade mark must be “a sign” in the sense of being a single sign capable of being graphically represented. Clearly this could have far-reaching implications, not only for Comic’s mark, but for all UK series marks. Look out for a further update on the case soon, once this important issue has been determined.



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Sticky situation

Tony Dylan-Hyde examines a less than simple ice-cream opposition



THIS CASE CONSIDERS the often sticky issue of the assessment of, and place of, the UK action for passing off within Article 8(4) of Council Regulation (EC) No 207/2009 (the Regulation) – the opposition ground for “user/unregistered rights”. To make matters more complex, it incorporates a seniority claim in the mix of considerations made as to the existence of an earlier right in the UK.

On 2 November 2010, BR IP Holder LLC (BR IP), the IP rights-holder for the Baskin-Robbins brand, filed opposition against a CTM application by Greyleg Investments Ltd (Greyleg) for the mark HOKEY POKEY for “confectionery”, which included a claim to seniority to a UK registration with a 17 April 2000 filing date. BR IP opposed under Article 8(4) of the Regulation in particular, claiming protection by means of passing off based on its own use of the

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Article 8(4) requires that the national law of the relevant Member State be given due weight and authority

identical mark in the UK since 1997 for “confectionery, namely ice cream”.

OPPOSITION DISMISSED

OHIM dismissed the opposition in view of BR IP’s failure to show that the mark had been used in the context “of more than mere local significance” within the meaning of the second condition of Article 8(4); according to the Opposition Division, BR IP’s evidence, in particular with regards to its sales volume and advertising efforts for the period 1997 to 2010, was inadequate.

While agreeing with the Opposition Division, OHIM’s Fourth Board of Appeal (BoA) employed a different approach and considered whether BR IP had met the fourth condition of Article 8(4) – that is, whether BR IP had an absolute right to prohibit the use of Greyleg’s mark as of 17 April 2000 (the filing date of Greyleg’s earlier UK registration, from which the CTM claims seniority). The BoA found the relevant evidence for this shorter period to be insufficient, with the result that Greyleg was pronounced the senior rights-holder in HOKEY POKEY.

ANNULMENT

Annuling the BoA’s decision, the General Court based its ruling not on the merits, but instead solely on procedure. First, when the BoA analysed and eventually refused BR IP’s appeal, it focused on substantiating the fourth condition of Article 8(4), which requires that the national law of the relevant Member State be given due weight and authority. It is not clear from the contested decision, however, whether the BoA made any effort to consider UK law when assessing this condition. Second, Article 75 of the Regulation mandates that decisions issued by OHIM “shall state the reasons on which they are based”. On this, the General Court found the contested decision silent as to the national rules the BoA allegedly considered in determining the existence of an earlier right. Given these omissions, the General Court settled that it could not weigh the BoA decision’s lawfulness.

The case is yet another illustration of the technicalities (and often confusions) of trade mark opposition under Article 8(4) and, in particular, those based on user rights in the UK.



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No win for Mini Wini

Descriptive elements will not generally be considered to be distinctive or dominant, writes Désirée Fields

IN JUNE 2011, Salumificio Fratelli Beretta SpA filed a trade mark application for the figurative sign depicted below. Protection was sought in respect of “meat, poultry and game” in class 29 and “services for providing food and drink” in class 43. In October 2011, Meica Ammerländische Fleischwarenfabrik Fritz Meinen GmbH & Co KG (Meica) filed an opposition under Article 8(1)(b) of Council Regulation (EC) No 207/2009 based on its earlier Community Trade Mark registration for MINI WINI for goods in class 29, including meat, poultry and game.

OHIM’s Opposition Division partially upheld the opposition in respect of class 29 and rejected it in respect of class 43. OHIM’s Board of Appeal (BoA) annulled the decision in its entirety, finding no likelihood of confusion between the marks and declaring Meica’s submissions in respect of class 43 inadmissible as they widened the scope of the appeal.

APPEAL ISSUES

On appeal, the EU General Court upheld the BoA’s decision that there was no likelihood of confusion between the figurative mark, which included the word “MiniMINI” and the earlier word mark MINI WINI in respect of goods in class 29. While the respective goods were identical, the Court held that the marks only had a low degree of visual, phonetic and conceptual similarity. The Court rejected Meica’s argument that the dominant element of the respective marks were “MiniMINI” and MINI WINI, noting that the marks must be examined as a whole. In particular, the element “Beretta”, which stood

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While the goods were identical, the Court held that the marks only had a low degree of visual, phonetic and conceptual similarity

out visually, was not negligible in the overall impression created.

The element “MiniMINI” was descriptive of the small size of the goods concerned and not distinctive. Further, the respective marks only had a low degree of phonetic similarity, as the relevant public would direct its attention to the more distinctive element “Beretta” and, to an extent, the element “Stick”. Conceptually, the marks only shared the word “mini”, which merely described a characteristic of the goods concerned. Accordingly, there was no likelihood of confusion. The Court found that the earlier mark had an average, as opposed to an enhanced, inherent distinctive character.

However, the Court annulled the BoA’s decision to reject Meica’s submissions challenging the OHIM Opposition Division in relation to

services in class 43 and noting that Article 8(3) of Commission Regulation (EC) No 216/96 did not limit a defendant’s right to the pleas in law already raised in the appeal. In fact, the provision made clear that submissions could relate to a point of law that was not raised in the appeal. Accordingly, a decision of the Opposition Division could be challenged either in separate proceedings or in submissions provided for under Article 8(3).

COMMENT

Although successful in its appeal to have its submissions in relation to class 43 taken into account, Meica lost the battle because the Court found no confusion between the respective marks. The “MiniMINI” element may have been the most sizeable element in the mark applied for, but this did not assist Meica, given that a descriptive element will not generally be considered to be the distinctive and dominant element of the overall impression conveyed by a mark.

The Applicant’s figurative sign



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Word of WARNING

*Jade MacIntyre explains why a composite
mark was ripe to be challenged*

THE GENERAL COURT has upheld an opposition decision of likelihood of confusion between Bristol Global Co Ltd's (Bristol's) mark AEROSTONE (stylised word, shown below) and Bridgestone Corporation's (Bridgestone's) mark STONE (plain word). In doing so, the Court dismissed Bristol's claims that the Board of Appeal (BoA) had failed to consider all arguments or fully explain its reasoning, and confirmed that a composite mark could be challenged on the basis of an earlier mark occurring at the end of the wording in the applied-for mark.

BACKGROUND

On 22 June 2011, Bristol filed a Community Trade Mark (CTM) application for AEROSTONE in respect of the following goods in class 12: "vehicles; apparatus for locomotion by land, air or water; [and] automobiles tyres".

Bristol's application was published on 20 September 2011 and opposed on 20 December 2011 by Bridgestone,

a tyre manufacturer, which based its opposition to the application on a number of earlier rights in the marks BRIDGESTONE and STONE, claiming likelihood of confusion under Article 8(1)(b) of Council Regulation (EC) No 207/2009 (CTMR). Bridgestone's strongest earlier right was deemed to be CTM No 6912711 for the mark STONE in class 12 (the Earlier Mark), which covered "vehicle parts, namely shock absorbers; tires; wheels for vehicles; inner tubes, rims and covers for vehicle wheels; inner tubes for vehicle tires; bicycles; [and] parts and fittings for all the aforesaid goods".

INITIAL ACTIONS

The Opposition Division found in favour of Bridgestone on the grounds that the Earlier Mark was similar to the AEROSTONE logo and the goods covered were identical to or similar to all the goods of the application, except "apparatus for locomotion by water". Bristol appealed the decision, with the BoA holding that, in light of the

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inclusion of the word element 'stone' in the mark applied for and the at least equal weight of that element with regard to the element 'aero' in that mark, there was a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 207/2009 with the earlier mark".

APPEAL

In making its appeal to the General Court, Bristol argued that the BoA had not set out all of its reasons for its decision (in contravention of Article 75 CTMR) and that the BoA had erred in its finding of similarity between the AEROSTONE logo and the Earlier Mark.

The Court dismissed the first plea, holding that, while OHIM must set out all of its reasons for making a decision, the BoA is not obliged to do so, provided that its reasoning is implicit and enables the persons concerned to understand how the decision was reached. Indeed, the Court went so far as to say that: "when the [BoA] confirms a lower-level decision of OHIM in its entirety, that decision, together with its statement of reasons, forms part of the context in which the [BoA's] decision was adopted, which is known to the parties and enables the Court to carry out fully its judicial review as to whether the [BoA's] assessment was well founded". Further, the Court confirmed that the BoA was not required to provide a line-by-line response to all of the arguments put forward by Bristol.

With respect to the second plea, Bristol claimed that the BoA had erred in its decision to uphold the finding that the AEROSTONE logo was similar to the Earlier Mark because the relevant public pays more attention to the beginning of marks than the end of them.

*The Court stated that an
additional word element in a
mark cannot exclude a finding
of similarity where an identical
word element is in both marks*



ILLUSTRATION: ALIX THOMAZI

The Court stated that, according to settled case law, two marks are similar for the purposes of Article 8(1)(b) CTMR where, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (*T-286/02, Oriental Kitchen v OHIM – Mou Dybfrost, KIAP MOU*).

ASSESSMENT ISSUE

When considering the global assessment of the marks, the Court stated that the presence of an additional word element in a mark cannot exclude a finding of similarity where there is an identical word element in both marks. Further, assessment of the similarity between two marks means that:

...comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components ... It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*C-334/05 P, OHIM v*

Shaker, LIMONCELLO). That could be the case, in particular where that component is capable on its own of dominating the image of that mark which members of the relevant public retain, with the result that all the other components are negligible in the overall impression created by that mark (*C-193/06 P, Nestlé v OHIM, QUICKY*).

Accordingly, the Court held that the BoA was right to consider that the distinctive and dominant element of the AEROSTONE logo was the word “stone” on the grounds that: the stylisation of the AEROSTONE logo as a whole was weak and the figurative wings on the letter “A” were too small to hold the attention of the relevant public; and the English-speaking public would understand the word “aero” to be a descriptive prefix meaning “air”, allowing the element “stone” to retain a semi-independent role, which would not prevent the public from recognising the

similarities between the two marks. The Court held that, because the marks were aurally and visually similar and, in respect of the English-speaking consumer, conceptually similar, there existed a likelihood of confusion between the AEROSTONE logo and the Earlier Mark, thus dismissing the appeal.

CONFIRMATION

This decision confirms that the distinctive and dominant element of a mark does not have to occur at the beginning of a composite mark for a finding of likelihood of confusion to be made. Prospective brand owners will need to consider whether affixing a word to a third party’s mark will make the composite mark sufficiently distinctive to avoid objections.

The Bristol stylised mark

AEROSTONE



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Mis-step on Kicktipp

Charles King explains the Court's clarification on substantiating earlier rights

IN THIS CASE, the General Court was asked to consider two questions. The first concerned the filing of a renewal certificate as evidence of the existence, validity and scope of protection of marks upon which an opposition is based, and the second concerned the similarity of the word marks KICKTIPP and KICKERS.

The trade mark application for KICKTIPP had been filed by Kicktipp GmbH (Kicktipp), a football gambling website, and sought to protect clothing in class 25. Società Italiana Calzature Srl (SIC), the owner of the Kickers brand in Italy, opposed the application on the basis of its registrations for KICKERS, MISSKICK and KICK'S, all in class 25. The Board of Appeal (BoA) having upheld the Opposition Division's earlier ruling in favour of SIC, Kicktipp brought two pleas in law before the General Court. At this stage, the Italian word mark KICKERS was the only registration at issue on the part of the Opponent. The first plea concerned infringement of Rules 98(1) and 19(1) and (2) of Commission Regulation (EC) No 2868/95. Kicktipp claimed that SIC had not properly established its earlier rights. It claimed that the documents were not duly translated, and that the certificates filed in order to establish the earlier rights were not sufficient.

EVIDENCE FILED

On filing its Notice of Opposition on 7 June 2010, SIC had appended documents and translations intended to substantiate its earlier rights. These documents, however, consisted solely of an application for renewal (and

translations) of the Italian KICKERS registration. In a further statement on 8 November 2010, SIC set out the grounds of opposition and filed additional documents to substantiate its earlier rights, including the renewal certificate and a translation. However, that translation only covered the first two of four pages.

Kicktipp argued that the BoA had erred in that Rule 19(2) (a) (ii) required that a renewal certificate could only be filed in addition to the registration certificate, and that the translation had to reflect completely the subject matter and structure of the original document.

DECISION ON EVIDENCE

After closely scrutinising the text of Rule 19(2) (a) (ii), the General Court held that, while it was unclear if both a renewal certificate and registration certificate had to be provided, the wording also allowed for the opposing party to produce "equivalent documents emanating from the administration by which the trade mark was registered". Crucially, reliable "proof" of the existence, validity and scope of protection of the earlier trade mark upon which the opposition is based should be made available to OHIM. Accordingly, "the production of a

document emanating from the competent authority and containing the same information as that which appears in a registration certificate" met that requirement. A renewal certificate satisfied those criteria.

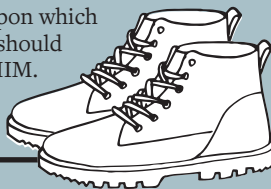
However, the application for renewal, filed in June 2010, was not sufficient, as it was not apparent that the earlier mark had been renewed. This would only have been acceptable if the Italian registry had not yet confirmed the trade mark's renewal.

As regards the translation, the fact that it did not reflect the entirety of the documents submitted was of no consequence, as the information found in the translated sections was sufficient to establish the existence, validity and scope of protection of the earlier trade mark. Kicktipp's first plea was therefore rejected.

LIKELIHOOD OF CONFUSION

In a more routine examination of the similarity of the marks at issue, the General Court found that there was no likelihood of confusion between KICKTIPP and KICKERS, based on the fact that, within the clothing retail sector, visual differences

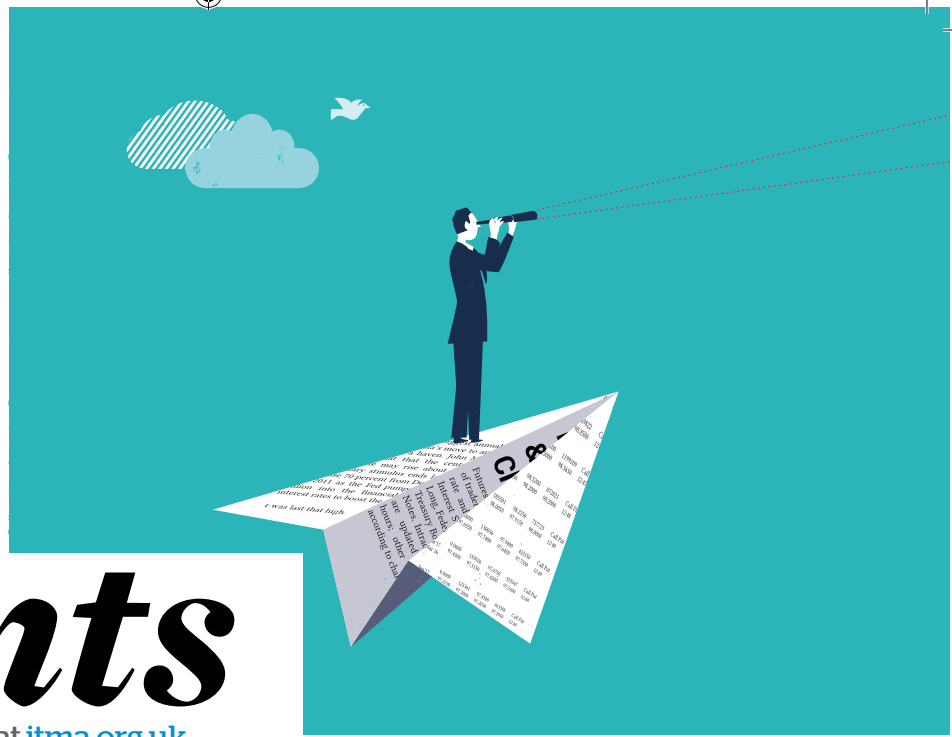
would have more impact than aural similarities. Accordingly, the BoA's decision was annulled.



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Our next London Evening Meeting
will look at what the future holds
for the new EUTM



events

More details can be found at itma.org.uk

Date	Event	Location	CPD hours
10 May	ITMA London Evening Meeting The future of the EUTM	Royal College of Surgeons, London WC2	1
12 May	IPO & ITMA Roadshow	Maclay Murray & Spens, Edinburgh	1
14 June	IPO & ITMA Roadshow	Burges Salmon, Bristol	1
28 June	ITMA London Evening Meeting Up to date in the Rolls Building	Royal College of Surgeons, London WC2	1
5 July	ITMA Summer Reception and President's Welcome Drinks Reception*	Institute of Directors, London SW1	
20 July	ITMA London Evening Meeting	Royal College of Surgeons, London WC2	1
6 September	IPO & ITMA Roadshow	Charles Russell Speechlys LLP, London	1
27 September	ITMA London Evening Meeting	Royal College of Surgeons, London WC2	1
6 October	ITMA Autumn Seminar & Drinks Reception	Hyatt Regency, 2 Bridge St, Birmingham	5
25 October	ITMA London Evening Meeting	Royal College of Surgeons, London WC2	1
22 November	ITMA London Evening Meeting	Royal College of Surgeons, London WC2	1
9 December	ITMA Christmas Lunch and Drinks Reception**	London Hilton on Park Lane, London W1	

SUGGESTIONS WELCOME

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

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My role is... Partner at Boulton Wade Tennant (and Past President of ITMA).

Before this role... I was at Trinity College, Cambridge, for my degree in Oriental Studies (Chinese) and then my PhD in Anglo-Saxon Literacy. Then I became a Trade Mark Attorney.

My current state of mind is... happy. Why? Too many reasons and I'm not tempting fate by listing them!

I became interested in IP... when my favourite pancake place on King's Road, Asterix, had to change its name, even though it had a large cartoon on the wall that Albert Uderzo, the illustrator of the indomitable Gauls, had drawn for them when he visited – and a proud sign saying “Uderzo était là”. The owners explained it was an IP issue, so they had to change the name. I was about nine.

I am most inspired by... my mother.

In my role, I most enjoy... corresponding with other Trade Mark Attorneys in the UK and around the world to find practical solutions.

In my role, I most dislike... those very rare Registry decisions which seem both unfair and unappealable – not in the UK, but in other jurisdictions.

On my desk are... two piles of files and a cup of coffee on a mat which says “I'd rather be in Aldeburgh”.



A comic character propelled Fellow member Catherine Wolfe into IP

My favourite mug is... a Penguin mug with “Great Expectations” written on it. It was a mild joke while I was pregnant and it still cheers me up.

My favourite place to visit on business is... Beijing; last time I visited, I saw a bird's nest made out of coathangers, and my present ambition is to find the bird that made it.

If I were a trade mark or brand, I would be... Nescafé Gold Blend or Jameson whiskey: reliable, consistent and decent.

The biggest challenge for IP is... the uncertainty around the issue of

Brexit, especially in relation to Community Trade Marks.

The talent I wish I had is... to be able to be in two places at once.

I can't live without... my husband, my children and my coffee.

My ideal day would include... reading papers in my dressing gown, going to the Registry for a successful Hearing, having lunch in the office, doing a few hours of work, then going to the British Museum with the family for an evening opening, and back home on the Tube.

In my pocket are... lip salve and tissues. And in my coat pocket is a map of Paris, some business cards, my daughter's hair slide and an unidentifiable coin.

The best piece of advice I've been given is... “In trade marks, nothing is ever simple.”

When I want to relax I... go to Aldeburgh and lie down on the pebble beach with a book.

In the next five years I hope... everything will be exactly the same as it is now.

The best thing about being a member of ITMA is... the people – especially the camaraderie on Council and in the Working Groups.



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