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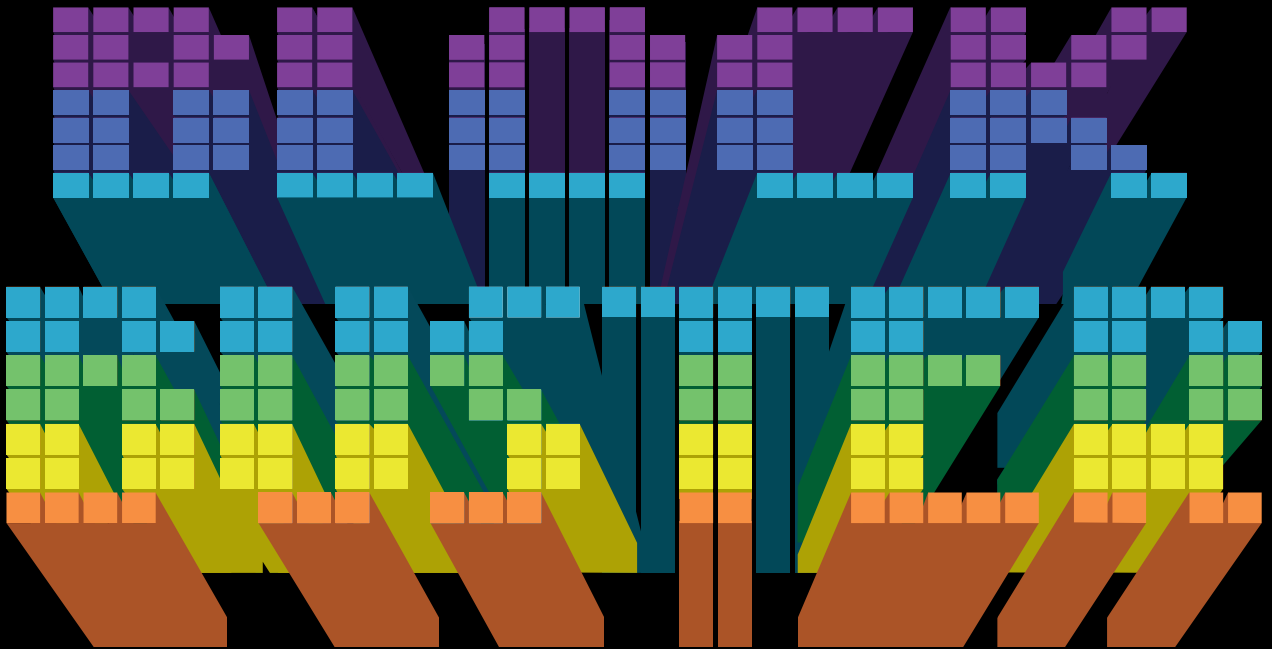
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ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

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MESSAGE FROM THE PRESIDENT:



Bastiaan Koster
FICPI President

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I look forward to welcoming you to my home city!

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February 2015



ITMA contacts

General enquiries

ITMA Office, 5th Floor, Outer Temple,
222-225 Strand, London WC2R 1BA
Email: tm@itma.org.uk
Tel: 020 7101 6090

Committee chairs

Executive: Catherine Wolfe,
wolfe.itma@boulton.com

Events: Maggie Ramage,
maggie@ramage.co.uk

Education: Philip Harris,
pharris@st-philips.com

Law & Practice: Imogen Wiseman,
i.wiseman@cleveland-ip.com

Publications & Communications:
Richard Goddard,
richard.goddard2@uk.bp.com

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Think, The Pall Mall Deposit,
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www.thinkpublishing.co.uk

Editor: Caitlin Mackesy Davies

Advertising: Dalia Dawood,
dalia.dawood@thinkpublishing.co.uk

Group Account Director: Polly Arnold

Account Manager: Kieran Paul

Senior Designer: Clair Guthrie

Designer: Alix Thomazi

Senior Sub-editor: Rachel Kurzfield

ITMA Review

Review content is provided by members on a voluntary basis, and reader suggestions and contributions are welcome. If you would like to contribute an article to a future issue, please contact Helene Whelbourn by email at h.welbourn@novagraaf.com and Caitlin Mackesy Davies at caitlin@thinkpublishing.co.uk

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We are pleased to present the first *ITMA Review* of 2015 proper. I hope that you all enjoyed some time with family and friends over the holiday season, and those of you who were able to attend either the Northern or London ITMA Christmas lunch enjoyed it. It was certainly a pleasure to see so many of you at these events.

In this issue, we look back at those lunches and also forward to our Spring Conference, which will take place at One Whitehall Place from 18 to 20 March.

We also look at registration of beverage bottle shapes, an appropriate post-Christmas/New Year topic, focus on the latest in the dispute between

Specsavers and Asda, and hear from Aaron Wood on the details of preparing for and attending court proceedings, which is a useful insight into an area on which our practices tend to have an increasing focus.

I realise that we are now well into 2015, but let me take this belated opportunity to wish you the very best for this year. I am sure that it will be another busy, interesting and productive year for ITMA members.

Chris McLeod
ITMA President

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ITMA Insider

CEO update

Highlights and updates to Keven Bader's 4 December member bulletin



04

By now we've all had time to reflect on 2014 – and what a year it was. By my own admission I have been guilty of not sending as many bulletins as I would have liked, but I hope this has not prevented you from keeping in touch with the work ITMA has been undertaking on behalf of its members and the profession, some of which is detailed on this page.

Membership renewals

Hopefully, you all received a subscription renewal reminder at the end of last year, which was sent through our new CRM system. Please note that the deadline for payment of your 2015 subscription is 28 February so if you haven't received a renewal reminder yet, please contact Marzia Sguazzin (marzia@itma.org.uk) at the ITMA office. The new system is more robust on lapsing unpaid membership subscriptions. Therefore, if you have not yet sent your remittance, I would encourage you to do so before the deadline to ensure your membership is not cancelled.

Pro bono survey

We are grateful to the 81 members who took the time to complete our recent survey on pro bono work. Our Pro Bono Working Group will be analysing the results and considering its recommendations.



Annual report

Work has started on the 2014 Annual Report, which will include a comprehensive overview of the work undertaken during the course of the year. The Report can help members to understand more

about what ITMA has been doing on your behalf, what it has achieved and its areas of focus. Look out for publication details soon. Previous reports can also be found at itma.org.uk.

Induction days

In December, ITMA President Chris McLeod and I attended two new member induction days, events held jointly with CIPA. These events are largely aimed at student members entering the profession and we ran specific sessions to introduce ITMA to that group. We were also able to explore what new members expect from their professional association, what information they might like to receive, and how they would like to

receive it. Furthermore, the events provided an opportunity to explain what ITMA does, how it operates and how members can get involved.

Charter

At the time of going to press, we were awaiting the view of the Privy Council on our memorandum of intention to file an application for a Royal Charter. Once we have received a response, we will consider the options available and, if the view is that we should consider a formal application, we will commence a more formal consultation.

The events provided an opportunity to explain what ITMA does, how it operates and how members can get involved

In memoriam: Roger Keyes

30 October 1919 – 22 October 2014

Roger Keyes was named after Admiral Sir Roger Keyes, and his interest in naval things lasted for a lifetime – even to painting pictures of Thames barges in a retirement art class.

Roger left school when he was 14, and worked as an auctioneer's clerk until he was called up and served with the Irish Guards during the Second World War. After the war, an Irish Guards officer found him a job as a clerk with a firm of patent and trade mark agents. He became office manager in another firm, and was encouraged by one of the partners to sit the exams of the Institute of Trade Mark Agents. He was admitted as a member of the Institute in 1960 and was proud to be elected an Honorary Fellow in 1993. This recognised his significant contribution to his profession. His superb memory, attention to detail and flair with people made him popular with colleagues and with clients – but also effective in the Chancery Court.

Dave Richards, a former colleague, recalls working with Roger after he had given up full-time work and taken up a role as a consultant at Page White and Farrer. At that firm, Dave writes: "We became firm friends, and I can honestly say that there was nobody I trusted more, either personally or professionally.



"Roger was one of the leading trade mark agents of his generation and was deeply respected for his ability, his integrity, and his detailed knowledge of trade mark law and practice. He was also a formidable opponent; he could be tough behind that gentlemanly exterior."

Member moves



Harry Rowe has joined Squire Patton Boggs as a Trainee Trade Mark Attorney. Contact Harry at harry.rowe@squirepb.com; 020 7655 1054.



Marks & Clerk LLP is pleased to welcome Samantha Collins as an Associate to its Oxford trade mark team. Sam can be contacted at 01865 397900, scollins@marks-clerk.com or connect with her online via her LinkedIn page.



Nicole Giblin joined the IP/Commercial Team at Clyde & Co in Dubai at the end of October. Contact Nicole at nicole.giblin@clydeco.ae



After 30 years in practice as a Trade Mark Attorney/Solicitor, former ITMA President Philip Harris has re-qualified as a Barrister. He is practising in the IP team of St Philips Chambers in Birmingham, Leeds and London, specialising in trade marks and other "soft" IP cases. He can be contacted at pharris@st-philips.com, or on 0121 246 7000/0113 244 6691 and 020 7467 9444.

ITMA calls attention to business threat

In December, ITMA issued a press release to call attention to the threat posed by unofficial trade mark registers. The release highlighted recent UK IPO research which reported:

- That despite progress via combined industry and government efforts, some forms of IP confusion still persist
- A 45 per cent annual rise in the number of UK companies reporting payment requests from unofficial "registers"
- This contrasts with a drop in misleading "renewals" letters (cases down by 29 per cent).

The statement acknowledged that while rapid progress has been made in tackling more open types of fraud, the reported rise in the number of misleading demands is a cause for concern.

At an average cost of approximately £1,000 per unofficial demand, this phenomenon has the potential to cost the UK's small firms a total of £1.25 million per year in unnecessary fees alone. However, the true cost could be higher as such registers offer no legal protection.

In the first three-quarters of 2014 there were an average of 312 instances per quarter of unofficial organisations offering companies a place on their own "trade mark register", unconnected to official registers of intellectual property. This represents an increase of 45 per cent compared to 2013, up from an average of 215 cases per quarter last year.

The growing issue of unofficial "registers" comes despite successful new measures to tackle the parallel problem of misleading "reminders" ahead of trade marks that approach renewal.



Seasonal soirée

PHOTOGRAPHER | STEWART RAYMENT



Another great holiday event was held at the InterContinental Hotel, Hyde Park, London, where 500 members were greeted by ITMA President Chris McLeod, enjoyed a Christmas lunch and recognised the achievements of this year's winners:

- Haydn Lambert of Jenkins, receiving the Thomson Reuters prize awarded to the student who achieved the highest mark in this year's Trade Mark Administrators' Course.
- Eleanor Merrett of Olswang, receiving the prize awarded by Hogarth Chambers to the student who achieved the highest mark in the IP Litigation and Advocacy Course.





Merry, merry Manchester

The ITMA Northern Christmas lunch returned to Manchester this year, to Jamie's Italian on King Street. The food was excellent, if a little unusual for a Christmas meal in England, starting off with sharing platters of mozzarella balls, polenta, olives and cold meats. A turkey main course was also prepared in an innovative way – with a white sauce and salad leaves.

ITMA President Chris McLeod delivered a particularly short Christmas lunch speech (competing with piped music) but we all got the gist of good wishes for the season and for the following year. A big “thanks” goes to Anne Lacaze and Pam Withers for arranging a lovely

lunch. The venue was also well placed for a saunter through the Christmas markets on the way back to Manchester Victoria station – a great start to the festive season. *Report and photos from Carin Burchell, of BRANDED!*



01 ITMA President Chris McLeod (Squire Sanders), Rita Okyere and Nick March (WebTMS) **02** Robert Jackson (Dehns), Nick Wise, Martin Williams, Callum Beamish, Tom Jones and Ashton Chantrielle (8 New Square) and Stuart Baran (Three New Square) **03** Kelly Clarke and Eleanor Merrett (Olswang) with Sarra Adams, Danielle Dudelzak and Andrea Garford-Tull (Dentsu Aegis Network) **04** Overview with Rob Jarrett and Matthew Lee (Pitmans), Nick Mercer, Jonathan Critchley, Nick Foot and Victoria Jessup (Philip Morris International) in foreground **05** Chris McLeod and Thomson Reuters prize winner Haydn Lambert (Jenkins) **06** Julie Turner (Ablett & Stebbing) and Puravee Shah (Murgitroyd) **07** Luke Rehbein and Daniel John (Dawn Ellmore Employment) **08** Hogarth Chambers prize winner Eleanor Merrett (Olswang) and Chris McLeod **09** Thomson Reuters team **10** Deborah Hughes, Miguel Mendes, Matthew Lee and Ese Akpogheneta (Pitmans) and Mark Foreman (Rouse) **11** Sian Reeve and Rachel Harrison (Bird and Bird), Duncan Mee, Jennifer Eddis and Michael Wakefield (Cerberus Investigations) **12** Silvia Bertolero (Lambert & Associés, France), Florian Traub (Squire Patton Boggs) and Keven Bader (ITMA) **13** Sean Corbett and Patsy Heavey (Formula One Management) and James Hennigan (Squire Patton Boggs) **14** Justin Bukspan and Martin Chinnery (Lysaght & Co.) **15** Michael Green and Pam Withers **16** Jamie's Italian hosted a modern Northern lunch **17** Lisa Kelly, Catherine French (Sacco Mann) and Lee Curtis (HGF)

Lost your bottle?

John Ferdinand examines who's won,
who's lost - and why - in the fight
for beverage container registration
at OHIM



Trade mark practitioners will be very familiar with this extract from Article 4 of the Community Trade Mark Regulation (CTMR), which clearly provides that the shape of goods and their packaging can be suitable for trade mark registration (emphasis added):

“A community trade mark may consist of any signs capable of being represented graphically, particularly ...*the shape of goods or of their packaging* provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

However, registration of shapes as Community Trade Marks (CTMs) can be notoriously difficult to obtain, as evinced by a recent General Court decision on this question in *Franz Wilhelm Langguth Erben GmbH & Co v OHIM*. This article provides an overview of some notable example cases in the area of beverage bottle shapes and is intended to identify any patterns in decision-making under the CTM Regulation.

Those with experience of using the CTM system will appreciate that, while the wording of the CTMR specifically provides for registration of shape marks if they can function as trade marks, OHIM will almost always refuse shape mark applications in the first instance. This is on the basis that, while there are no additional requirements for distinctiveness required for shape marks over other types of marks, consumers are not in the habit of using the shape of the goods or their packaging to determine the origin of the goods.

Accordingly, there is an additional requirement in practice to show that

the shape of such products must “depart significantly from the norms of the sector” in order to possess the requisite level of distinctiveness to be acceptable for registration.

The field of bottle shapes is an interesting one in this sense, both because there are a reasonably large number of cases concerning this type of product and because manufacturers of beverages have a large degree of design freedom in creating bottle shapes.

Starting with the area of non-alcoholic beverages, reproduced on page 10 are some cases accepted on appeal either to the OHIM Board of Appeal or to the General Court or Court of Justice of the European Union (CJEU). All of these cases were accepted for reasons other than evidence of acquired distinctiveness.

Exceptional cases?

It seems that in the case of the *Oy Sinebrychoff* mark (which is octagonal and designed to look like a battery), the unusual shape design and colour scheme used was held sufficient for the mark to be suitable for registration. For the *Coca-Cola* and *Nestlé* cases, the combinations of ridges and patterns on the bottles were found to be unusual. Although we might readily recognise the *Coca-Cola* bottle shape, it does seem a little surprising that it was accepted without acquired distinctiveness evidence. This might suggest registration of bottle shapes is not so difficult to obtain.

However, the statistics suggest otherwise. A rudimentary search of results indicates that in decisions issued by OHIM, the General Court and CJEU in class 32 and 33 on this topic, almost 90 per cent of applications are entirely refused. This statistic is, in fact, generous in that

some applications have been refused for the main goods of interest but not for other related goods. These cases are, therefore, the exception rather than the rule.

Less successful

The *Pret A Manger* application, featuring the star on the bottle, at first glance appears akin to the *Oy Sinebrychoff* application (albeit slightly less innovative) and simply places a logo of normal distinctiveness on a bottle design. *Pret A Manger* raised the argument that if its star design was registrable, albeit in red, so should the bottle be, but this argument was rejected. Another interesting point in the decision confirmed that the visual significance of the star on the bottle would be diminished because it is transparent in that use. This reasoning seems to contradict the previous cases, where the same finding could apply to the ridges on the *Nestlé* or *Coca-Cola* bottles.

Readers may be forgiven for seeing double between the *Sinalco* mark and *Coca-Cola*'s mark, although the decision on the *Sinalco* mark was not appealed to the same level. Likewise, the *BV Adelholzener* mark seems to possess elements consumers may be capable of using to attribute to a single trade source, at least to the same degree as the *Nestlé* case.

Alcoholic beverages

Decision-making in cases concerning the shape of alcoholic beverage bottles has also shown how apparently inconsistent decisions in this area can be.

The successful *Freixenet* case has been held up as an example to show that shape mark CTMs should not automatically be refused registration and that decision-making is moving →

Accepted and refused bottle shapes:



Oy Sinebrychoff Ab (November 2013 - currently opposed)



Coca-Cola Company (March 2014)



Nestlé Waters (December 2003)



Pret A Manger Europe (August 2003)



Sinalco International (November 2004)



BV Adelholzener Alpenquellen GmbH (April 2013)



Freixenet (February 2012)



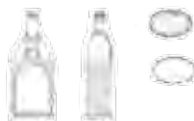
Jose Cuervo (April 2001)



Galliano BV (March 2001)



Old St Andrews Limited (September 2013)



Friedr. Schwarze GmbH & Co. KG (February 2012)



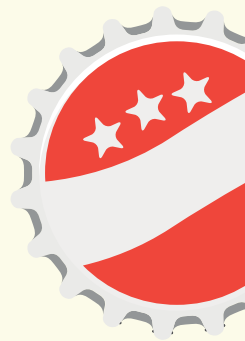
Rémy Cointreau Luxembourg SA (May 2012)



Coca-Cola Company (October 2005)



(The mark was accepted on appeal December 2006)



Decision-making in cases concerning the shape of alcoholic beverage bottles has shown how apparently inconsistent decisions in this area can be

towards reader acceptance of this mark type. The key in this case was that the design is frosted, which is unusual for sparkling wine bottles, and the Applicant did submit evidence to show that this was unusual. However, since the bottle design is otherwise not unusual, it is a little surprising the mark was accepted without any evidence of use.

In practice, another factor in this case was that the earlier first instance decision was heavily criticised and this seems to have worked in the Applicant's favour in this decision. Meanwhile, the use of the wicker-shaped grooves on the Jose Cuervo mark and the "unusual" combination of the conical shape and straight grooves in the Galliano mark were decisive in allowing acceptance of those applications.

Given the acceptance of what looks like a much less visually striking mark by Freixenet, Old St Andrews could feel understandably aggrieved at the refusal of protection for its mark. In this case, it was actually the "eye appeal" of the ornate jewel design of this bottle that worked against the trade mark owner. In the decision refusing registration, it was held that the visual impact of the mark was sufficient to "add substantial value to the goods" and, therefore, provide an additional ground for refusal.

The decision in Friedr. Schwarze seems contradictory to the Jose Cuervo case in that, in this case,

the wicker-style grooves were not sufficient to render the mark suitable for registration. Likewise, the Rémy Cointreau case seems to represent the "unusual combination" of the conical shape and grooves used in the Galliano bottle shape, which makes the refusal of this mark all the harder to explain.

Cola continuum

The three marks shown at the bottom of page 10 were the subject of applications filed by the Coca-Cola Company on 24 October 2005. The first two were accepted but the third mark was refused registration. It was later accepted on appeal. In that appeal decision (issued in December 2006) the original decision was heavily criticised and, in a candid judgment, it was suggested that acceptance of trade mark applications for shape marks of this kind should not be considered as likely as winning "El Gordo" (the top prize in the Spanish national lottery), as is often the perception. Trade mark practitioners will be minded to agree with the sentiment of that judgment. Despite the wording in this 2006 decision, however, it is still difficult

to predict the acceptance of shape mark applications with any certainty.

Nonetheless, common traits have emerged, as I hope the cases discussed have demonstrated:

1. If the shape of the mark is intended to represent another unrelated object it may have a better chance of successful registration (a battery, for example). However, applicants need to be careful to avoid a refusal on the grounds that a mark is "too good-looking" (as in the Old St Andrews case).
2. Aside from the overall shape of the mark, the addition of grooves and patterns (as in the Nestlé and Galliano cases) and other textured elements, such as frosting (Freixenet) a bottle, may assist in improving chances of successful registration.
3. Finally, applicants may well have a better chance of successful registration if they can show the marks are truly unusual in the marketplace by providing extensive evidence of other product shapes.

This general review of cases suggests that OHIM and the General Court/CJEU have over the past few years – and despite one or two notable exceptions – moved from a greater willingness to accept shape marks for registration (for example with the Nestlé, Jose Cuervo and Galliano brands) to a reluctance to register such marks.

However, it still seems that where marks are especially unusual and designed to represent other unrelated objects (as in the case of the Oy Sinebrychoff Ab can) there is room for registration.



John Ferdinand

is a Trade Mark Attorney at Marks & Clerk
jferdinand@marks-clerk.com

A final look at Specsavers

Nick Smee focuses on the lessons learned as a closely watched dispute concludes

12

The trade mark dispute between Specsavers and Asda has been long running and hard fought. For those who have lost sight of the story, it began in 2010 when the High Court held at first instance that Specsavers succeeded in a claim of infringement in respect of Asda's advertising strapline, "Be a real spec saver at Asda". However, the Court rejected the claim that Asda had infringed Specsavers' "Shaded mark" (shown right) and its claim for passing off. The Court also held that Specsavers' "Wordless mark" should be revoked for non-use as it had not been used without the overlaying "Specsavers". Specsavers appealed these findings.

In 2012, the Court of Appeal allowed the appeal, finding that Asda's logo and its strapline "Spec savings at Asda" infringed Specsavers' word mark and its logo marks. However, the Court of Appeal stayed Specsavers' appeal against revocation of the Wordless mark to seek guidance from the Court of Justice of the European Union (CJEU).

The parties settled on confidential terms following the CJEU judgment.

However, Specsavers pursued its appeal against the revocation of the Wordless mark and succeeded, with the Court finding that use of the Shaded mark was genuine use of the Wordless mark. History class concluded, what lessons can the trade mark profession learn from this lengthy process?

Importance of context

In agreeing with the Judge's findings at first instance, the Court of Appeal held that in assessing the likelihood of confusion arising out of use of a sign, the court must consider the matter from the perspective of the average consumer and take into account all circumstances of that use. Lord Justice Kitchin commented the sign is "not to be considered stripped of its context". A key factor taken into account here was the overall impression created by use of the words "Specsavers" and "Asda" across the logo marks. Kitchin LJ said the difference in the two words "removes any possibility of confusion on the part of the average consumer". Clearly then, there is a demonstrable case for the prominent use of a brand name on logos to help prevent confusion. This was echoed in the

2014 passing off case of Moroccanoil Israel Limited v Aldi Stores Limited [2014] EWHC 1686 (IPEC).

The Court of Appeal also found that Asda's logo infringed under Article 9(1)(c) but only as part of the composite campaign. Kitchin LJ took into consideration the fact that the Asda straplines and logo were used in close association in stores and online promotional material. As such, the Court was of the view that this enhanced the resonance of the Asda logo mark with that of Specsavers' in the mind of consumers. This highlights the significance of the wider promotional campaign in the context of a global assessment. Specsavers also ran a case based on the cumulative effect of the signs.

Living dangerously

For the purposes of Article 9(1)(b), the Court of Appeal acknowledged that Asda had not intended to confuse consumers, despite agreeing with the Judge at first instance that Asda had "lived dangerously". Kitchin LJ commented that it is important to distinguish between the defendant who takes a conscious decision to push boundaries and one that intentionally seeks to take advantage

of the goodwill of others. With regards to the former, the outcome of the case will depend on the facts and it is for the court to determine whether there is likelihood of confusion based on its global assessment of all material factors.

For the purposes of Article 9(1)(c), however, the Specsavers case succeeded on the basis that Asda had intended to lean on Specsavers' reputation. Kitchin LJ held that "if the defendant is a trader with experience of the relevant market, it is permissible for the court to take into account his intention in using the sign complained of because he may be expected to have an understanding of the nature of the market, the characteristics of the average consumer and other matters affecting how that average consumer will react to the use of the sign". As such, evidence of this type might not assist for the purposes of Article 9(1)(b), but can be highly relevant when assessing unfair advantage.

Colour protection

Following the referral to the CJEU, it was held that in relation to Article 9(1)(b) and 9(1)(c), the colour of the alleged infringing mark will be relevant in the global assessment of the likelihood of confusion or unfair advantage if the claimant's black and white Community Trade Mark has been used extensively in a particular colour or combination so that it is associated with that colour in the mind of the public. This is the leading authority on assessing infringement of a black and white mark with enhanced reputation in a particular colour and will continue to be applied when determining infringement cases.

However, the practical application of this case may diminish over time as the latest OHIM guidance on black and white marks is implemented at Registry level. Under the guidelines, colour versions of black and white marks may not be deemed to be genuine uses of these marks, which puts such marks at real risk of revocation. Going forward,



proprietors are advised to register their mark in the colour they intend to use and not simply rely on their black and white marks.

Specifics of use

The CJEU also gave guidance on whether use of Specsavers' Shaded mark can constitute genuine use of its Wordless mark. Applying this guidance in its 2014 judgment, the Court of Appeal focused heavily on the strength of the evidence put forward by both parties. The Court noted a number of crucial factors including:

1. Specsavers had made substantial use of the Shaded mark since around 1995 and it featured heavily in all aspects of the business;
2. Specsavers' marks, both Wordless and Shaded, were genuinely different in design from any other logo used by competitors;

3. Asda had known the Wordless mark denoted Specsavers and that its own logo had started as "the Specsavers logo", although the ellipses had been separated by a "safe distance";
4. Consumers recognise the background logo on Specsavers signage and it was that, rather than the word Specsavers imposed over the top, that denoted the business.

Kitchin LJ held that the evidence strongly showed the Wordless mark served to identify the goods and services of Specsavers. Crucially, consumers perceived the Wordless mark as indicative of the origin of the goods and services in question and the differences between the two marks had not changed the character of the Wordless mark.

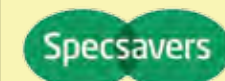
This judgment does not, however, pave the way for endless registrations of commonplace outline shapes. The Court of Appeal stressed that each case would be decided on its own facts. Furthermore, Kitchin LJ said that only in unusual cases will a background logo (registered as a separate trade mark) be considered to be in genuine use when used as part of a composite mark.

This litigation has set important precedents on the use and scope of registered trade marks as well as the contextual factors taken into account when infringement is assessed.

The Specsavers marks



The "Wordless mark"



The "Shaded mark"



Nick Smee

is a Solicitor at Wragge Lawrence Graham & Co
nick.smee@wragge-law.com

Rebecca Ward, a Trainee Solicitor at the firm, acted as co-author.



THE NOT-SO-SECRET DIARY

OF A TRADE MARK

ATTORNEY

(aged 34³ / 4)

*Aaron Wood takes us behind the scenes
as he has his day(s) in Court*

October 2013

I'm under pressure.

As always seems to be the case, I suddenly find myself simultaneously juggling two important tasks. On the one hand, I have the hearing before the High Court in a trade mark matter; on the other I have a presentation the following day at the ITMA Autumn Seminar. I am expecting the hearing in the High Court to take a day – it is an appeal of an unsuccessful opposition and successful counter-claim for revocation on the basis of non-use – but it is late on that day when I am finally able to take my feet as the Respondent and I barely get through my first point before we adjourn until the morning. Counsel on the other side has done a great job of

presenting the evidence in excruciating detail – it makes it sound a lot weightier than I think it is and I am left to admire the product of his experience (he took silk at the time I was sitting my GCSEs). Though, for my first time in the High Court, I have found it far less stressful than presenting a case before the UK IPO – there are far fewer nasty questions. After the hearing, it takes a few weeks for the draft decision to arrive for review – we error-check quickly and send it back for formal handing-down. I am itching to tell everyone that the appeal was dismissed, but that will have to wait.

December 2013

The further appeal has arrived. Part of me expected an attempt to appeal

from the other side, but I feel a mixture of curiosity, excitement and disappointment when the bundle arrives. Disappointment for the client, who hoped we might have exhausted the matter before the High Court, and also curiosity and a small measure of excitement that this small case might have a larger legal consequence.

When the skeleton arrives a fortnight later, I speed-read it, looking for the points of appeal I was expecting and noting those I was not. You prepare your case knowing what you think are your weaknesses, and you hope others do not exploit them – that your arguments will provide sufficient “glue” to ensure the case is sturdy enough to withstand pressure. It appears I have glued well. This is different counsel from the High



Court – junior counsel, where I faced a QC previously – and I wonder whether there will be a leader and junior at the next stage.

As this is a second appeal, the appellant needs to argue strongly for leave to appeal. I take the step of submitting arguments that the appeal is unnecessary as it is predicated on a misreading of the High Court’s decision, and also on the basis that even if the Appellant wins on a point we concede, it would not lead to the overturning of the findings that there was no genuine use. An up-front concession should help trim the matter down.

I also ask for leave to appear. While I am going through the process to become a Trade Mark Advocate, I do not have the qualification yet and I have a decision to make – do I ask to appear? The client is in favour, since I have been fortunate to have represented it thus far – including cross-examination of five witnesses in the UK IPO and the oral hearing at the High Court. Nonetheless, the Court has the discretion to allow a person to be heard, and I ask for leave for myself and a colleague as part of my submissions on the other side’s request for leave – so that there are two of us in case there is a leader and a junior on the other side. I hope, for the client’s sake, that our Opponent’s request is refused and, if not, that we are granted leave to appear. It turns out that I am let down on the first request, but I get my second wish.

April 2014

Skeleton arguments need filing. The timelines are quite extended, but the

Although I may be an expert on the facts, I am arguing to judges with great intellect but no knowledge of those facts. I must avoid skipping over facts that I think are self-evident

case never truly goes out of mind. The appeal bundle has sat in my cupboard for some time: grumbling as I answered OHIM on questions of absolute grounds; whispering to me as I prepared for hearings; tapping its foot as I prepared particulars of claim. Now it has come up for completion.

Having run the case so far, I have a strong feeling that the appeal should be rejected. The possibility of the lame duck – an appeal so limited in its merits as to be a waste of time – is not lost on me, but it is impossible to truly take that view of the other side’s appeal. I can’t forget, also, that although I may be an expert on the facts and evidence in this case, I am arguing to a panel of judges with great intellect but no knowledge of those facts. I must avoid skipping over facts that I think are self-evident or clear.

What’s more, until my skeleton is filed, the Appellant’s arguments are the prism through which the story is told to the Court. Counsel for the Appellant has, for his part, told a particularly compelling back story. While I cannot agree with all of it (I might actively disagree with some parts, and think that others are unproven, and that the shades of meaning are a little unfair), I can marvel at it as a piece of work. I position my response as, largely, my logic providing a contrast to opposing Counsel’s refrain of injustice – the Appellant may wish to take the view that this is all outrageous and unfair, but I have the benefit of the law and logical deduction on my side. The die is cast, and now all communication must fit into that communication pattern from my side.

September 2014

At last, today is the day we finalise the authorities. As well as choosing the cases, the passages to be relied upon must be indicated by a line, and each side must certify that it complies with the relevant practice direction. This includes a recommended limit on the number of cases. It comes as no surprise that there is a massive crossover in the authorities – the cases are well established and it is merely a question of interpretation. Still, we are just over the recommendation. Reading through their authorities, I find the passage I wanted from one of my cases cited with approval, so I knock one off my additions. Formally signed off, it now just remains to formulate the final communication plan: to take that ➔

I find out which Lords of Appeal will be hearing the case and research them. I conclude that in a case reviewing a decision of the UK IPO Opposition Division, I can't expect a better set of Lords of Appeal

final review of the bundles; to try to establish what points the other side may take and the “killer” questions the Lords Justice may ask; and to each contrary point or question develop an answer.

I find out from listings which Lords of Appeal will be hearing the case and I research them. There will be an IP specialist, an administrative law specialist and a commercial law specialist. I conclude that in a case that is reviewing a decision of the Opposition Division of the UK IPO, I can't expect a better set of Lords of Appeal.

There remains an argument about goodwill – a point we believe long-since abandoned at the UK IPO – and I must prepare for it in case we are wrong. This feels like a wrinkle – the potential high point of their case, but one we believe is beset with flaws. It is all the more important I am ready for expansive questions on this subject – that I can shut it down on the facts and the law.

October 2014

Are we on?

The last week of preparation is punctured by calls from the listings team at the Court of Appeal. The case is listed for a day in a two-day window, but something has come up. We are told that the case has a five per cent chance of being heard and we agree to vacate the date – a horrible waste as preparation will be needed to get back on top of the papers later on. Then, within days, we are told that a day is now definitely

free and we are on to be heard – I recommence preparation in earnest. The next day Counsel ask for an adjournment and after a little correspondence it is decided by one of the Lords that the case will be adjourned. The adrenaline finally rushes out as I realise that the preparation must be shelved for a few more months. I give the client the disappointing news over the telephone.

November 2014

Time to start reading again.

The case reappears on the horizon and my preparation is punctured by emails from the other side suggesting that perhaps settlement might occur. The client agrees that until any agreement is signed, preparation must continue alongside negotiations. (It's always possible that these type of negotiations are simply intended to divert attention from real preparation.) The Court confirms that the hearing will occur in early December and I realise there are three “working days” until the hearing, and no settlement.

By late in the month, the final positions are set out. Each of us says we can go no further, and I research the intricacies of settling after the

hearing just in case we cannot do so before it. Then, just when it appears that all is settled, a final sudden hurdle is thrown up: a further person just needs to read through and agree before it is finally signed off.

I wonder what will be added or taken away from the deal by this last-minute intervention.

Despite my concerns, it's less than 24 hours until the deal is done! Both parties put pen to paper and the deal is complete. Now it is down to the teams to tie everything up nicely. The deal assigns the client's rights to the other side, giving both parties the security to move forward.

I pack away the robe, tabs and collars and hope that middle-aged spread will not have set in by the time I need them again.

December 2014

The story hits the online version of a major broadsheet newspaper soon after we settle and I spend a day fielding phone calls, doing interviews with the press and tidying up the consequences of the deal. While this time I don't get to be the first trade mark advocate to appear in the Court of Appeal, the experience has certainly been useful for me and the firm.



Aaron Wood

is a Trade Mark Attorney at Swindell & Pearson Limited
aaron.wood@patents.co.uk

Aaron is a member of ITMA's Higher Rights working group. He has appeared before the UK IPO (including before the Appointed Person), the High Court, IPEC and the Court of Appeal.



Over-Seas gathering: (front, left to right) Chris Cairns (Murgitroyd); Alex Rushent (Corsearch); Eleanor Coates (Murgitroyd); Ryan Hickey (Corsearch); and (back) Aidan Clarke (Marks & Clerk LLP)



Left to right: Sally Cooper (Trade Mark Attorney); Mark Caddle and Tania Clark (Withers & Rogers LLP)

Scottish scene grows stronger

Natalie Charlick explains the progress of what is now a packed programme of local events for the UK's northernmost ITMA members

Just a few years ago, the opportunities to attend ITMA meetings and seminars in Scotland were few and far between. The Scottish ITMA membership was forced to make do with gathering CPD points via webinars, attending London events or finding other creative ways to achieve the required CPD. However, following a successful ITMA Seminar in Edinburgh in September 2011, a small band of the Scottish ITMA membership decided there was a gap in the market and formed a working group to run regular local events.

I lead the working group, assisted by Meena Murrin (Marks & Clerk LLP), Robert Buchan (Brodies LLP), Chris Finn (Murgitroyd & Company) and Tania Clark (Withers & Rogers LLP), the newest member of the team, who completes the line-up. Since the end of 2011, we have successfully run at least four ITMA Evening Meetings per year in Scotland, held in Glasgow or Edinburgh. Evening Meetings are free to members and topics have ranged from a discussion of “Heraldry as opposed to commercial logo”, to design law updates and the Commonwealth Games. IP considerations in the Scottish independence debate, certification marks, a case study of Harris Tweed

and an examination of the impact of social media on IP have also been subjects of our expert speakers. Local Scottish firms such as Brodies LLP, Pinsent Masons LLP, Marks & Clerk LLP, Burness Paull LLP, and Murgitroyd & Company, have all provided generous support by hosting meetings, offering their speaking services and providing a fantastic spread of food and drinks (which has ensured good attendance rates).

Successful year

2014 saw another successful programme, which began with Gillian Anderson, James Monteforte and Jim Cormack from Pinsent Masons in Edinburgh talking about co-existence agreements and providing an update on recent case law. Spring saw Burness Paull in Glasgow host a talk by Katherine Stephens of Bird & Bird on “Plain packaging – a Scottish perspective”. September featured an Edinburgh Evening Meeting hosted by Brodies, where the engaging mediator John Sturrock QC, of Core, led a lively

discussion on the benefits of mediation in IP, with Lindesay Low from the Scotch Whisky Association providing an industry perspective. The programme finished in November with a talk on assignments by Tania Clark of Withers & Rogers, hosted by Marks & Clerk in Glasgow.

Keen to try something new in 2014, the working group also organised a social event at the end of October featuring drinks and canapés as a way to celebrate the success of our Scottish series of seminars over the past couple of years. The reception (photos above) was held in a lovely room overlooking Edinburgh Castle at the Royal Over-Seas League, and the evening was a great success – everyone enjoying the chance to catch up with friends and colleagues.

This year is also expected to be busy, with plans for four Evening Seminars and an autumn social event already in progress. Look out for the adverts and continue to come along to the meetings, as they would not be as successful without your continued support.

Natalie Charlick

is Senior IP Legal Counsel at the Royal Bank of Scotland Group
Natalie.Charlick@rbs.co.uk

ITMA SPRING CONFERENCE 2015

CONVERGENCE

Is European IP coming together or moving apart?

This year's ITMA Spring Conference will focus on convergence and will pose the question of whether the IP law in place is coalescing or disconnecting. Among the topics we are expecting to discuss are:

- Amendments to the CTM Regulations
- The position on import/exports and goods in transit in Europe
- Issues pertaining to distribution of merchandising around the EU
- Comparison of the position on attacking counterfeits across jurisdictions
- The approaches to registrations in black and white, as well as specification issues
- A US view of the Specsavers case

The conference will give attendees insight into the current state of the law and practice, and the likely direction of travel. As always, it will offer great opportunities to network with fellow attorneys and overseas associates alike.

As well as the ample "educational" opportunities, the gala dinner and popular drinks reception will once

again allow new visitors and old friends to meet and network.



OUR NEW VENUE

While keeping our feet firmly in the centre of London, our conference will also have a bit of French flair and historical elegance as it settles into a new home at One Whitehall Place.

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

PROGRAMME HIGHLIGHTS

(subject to change, see itma.org.uk for additional topics and confirmed speakers)

Wednesday 18 March

DRINKS RECEPTION
Venue TBC 18.45-20.15



Thursday 19 March

Featured speakers to include:

- Steve Rowan, UK IPO
- José Miguel Lissén Arbeloa, partner at Gómez-Acebo & Pombo
- Mark Bearfoot, Harley-Davidson
- Cameron Gowlett and Duncan Mee, Cerberus Investigations
- Péter Lukácsi, SBGK
- Matthew Dick, D Young & Co



Friday 20 March

Featured speakers to include:

- Dominic Farnsworth, Lewis Silkin
- Chris Schulte, Merchant & Gould
- Anne Marie Verschuur, NautaDutilh N.V.
- David Muls, WIPO

Thursday 19 March

KEYNOTE SPEECH
Baroness Neville-Rolfe (see below)
Minister for Intellectual Property



Thursday 19 March

GALA DINNER
The best event of the year at which to meet old friends and make new ones.



Booking open now. Reserve your place early to take advantage of our early-bird rates. See itma.org.uk for details or call 020 7101 6090.

ACCOMMODATION OPTIONS

We are holding Deluxe Double bedrooms at the adjoining Royal Horseguards hotel at a rate of £259 based on single occupancy, inclusive of VAT and full English breakfast.

Double occupancy is available at a £15 supplement. Delegates can book online quoting ITMA180315 at guoman.com/en/hotels/united_kingdom/london/the_royal_horseguards/index.html

This offer is subject to availability until 17 February. More favourable rates may be obtained independently.

Alternatively, go to HotelMap.com/M5CUT for a quick link to accommodation near our event.

WHAT'S INCLUDED IN YOUR BOOKING:

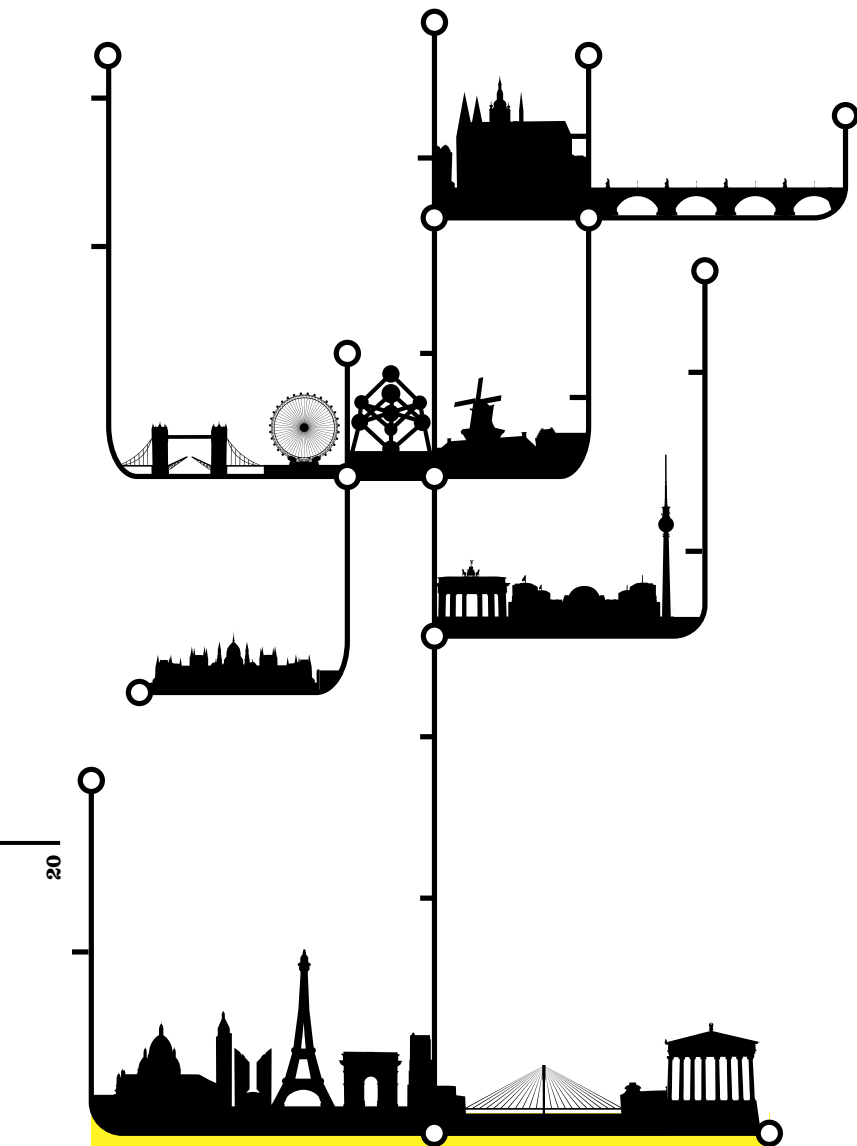
- Entry to all of the conference sessions
- All conference documentation
- Coffee and tea breaks
- Welcome drinks reception and canapés on 18 March
- Conference lunches on 19 and 20 March
- Drinks reception and gala dinner on 19 March
- USB stick containing all of the speaker presentations

CONFIRMED KEYNOTE: BARONESS NEVILLE-ROLFE

We are thrilled that Baroness Neville-Rolfe has agreed to serve as our keynote speaker on 19 March. She was appointed Parliamentary Under Secretary of State at the Department for Business, Innovation and Skills and Minister for Intellectual Property on 17 July 2014. Before assuming this post, Baroness Neville-Rolfe was an executive director on the main Board of Tesco plc from

2006 to 2013. Earlier in her career, she worked as a civil servant in the Ministry of Agriculture, Fisheries and Food, and in the Prime Minister's Policy Unit. She served as Director of the Deregulation Unit in the Cabinet Office from 1995 to 1997. She has also sat on the boards of several major businesses, including serving as a non-executive director of ITV plc and of 2 Sisters Food Group, as a member of the supervisory board of Metro Group, and on PwC's advisory board. She is a member of the London Business School's governing body. In addition, she served as President of EuroCommerce, the pan-European retail and wholesale trade association from 2012 to 2014. In 2007, she received a European Women of Achievement award.





LOCAL GUIDE: LONDON'S EUROPEAN LANDSCAPE

The UK capital attracts people from across the EU. Here are suggestions for how conference visitors can celebrate convergence in the host city



AUSTRIA

The Delaunay, 55 Aldwych WC2
Inspired by the great cafes of Europe, visit The Counter for Viennese patisserie as well as a selection of Weiners and Schnitzels.

BULGARIA

DSTRKT, 9 Rupert St W1
Chef Georgi Yaneff, who is said to have begun cooking at his grandmother's knee in Bulgaria, is now in charge of the international kitchen at this buzzy nightclub and restaurant venue.

GERMANY

Herman ze German, 19 Villiers St WC2
An easy walk away from our venue, you can find a selection of German sausages brought in direct from the Black Forest.

ITALY

Polpo, 41 Beak St W1
"Bàcaro" (humble restaurant) featuring Venetian-inspired small plates and more.

POLAND/HUNGARY

Baltic, 74 Blackfriars Rd SE1
Venture slightly south of our venue for a modern take on old-world favourites – and a wide range of homemade flavoured vodkas.

PORTUGAL

Canela, 33 Earlham St WC2
This daytime deli turns wine bar at night offering a taste of Portuguese food and wine.

SPAIN

Barrafina Soho, 54 Frith St W1
No bookings are taken at this well-regarded tapas bar. Enjoy fresh seafood and perhaps some sherry at the marble-topped, L-shaped bar.

SWEDEN/NORWAY/DENMARK

Nordic Bakery, Golden Square W1
Cakes, breads and sandwiches based on Nordic recipes. Also pick up some cold-pressed lingonberry cordial.

DRINK

BELGIUM

Lowlander Grand Café, 36 Drury Lane WC2

Enjoy the relaxed atmosphere and outstanding beers at “London’s Premier Belgian Grand Café”.



FRANCE

The French House Soho, 49 Dean St W1
A “no mobile phones” rule guards the unique atmosphere of this pub, which acted as the wartime base for Charles de Gaulle.

IRELAND

The Toucan, 19 Carlisle St W1
This Soho pub, oft-described as “legendary”, is said to serve the best pint of Guinness in London.



LATVIA

72 Queensborough Terrace, W2
Slightly further afield, you will find a cosy basement Club Bar where the Latvian community comes together on Thursday, Friday and Saturday nights. See 72qt.co.uk

NETHERLANDS

De Hems, 11 Macclesfield St W1
Named after a Dutch seaman who bought the premises in 1890, the pub was also a meeting place of the Dutch resistance during the Second World War.

SHOP

CROATIA

Taste Croatia, 3 Crown Square, Borough Market SE1
The D’issa Oleum Viride range of extra virgin olive oils from Istria in Croatia is now on sale in Fortnum & Mason, Piccadilly, but drop by Borough Market for a wider selection of the best Croatian products.

FRANCE

Maille, 2 Piccadilly Arcade SW1
Three centuries of mustard- and vinegar-making expertise are on display at Maille. Its small but perfectly formed London boutique will add flavour to your visit.

GREECE

Ergon, Picton Place W1
Greek celebrity chef Dimitris Skarmoutsos brings an outpost of his Greek restaurant and deli empire to London. Traditional products from independent Greek producers.

ITALY

Officina Profumo-Farmaceutica di Santa Maria Novella, 1 Piccadilly Arcade SW1
Buy products perfected during 400 years of trading at the London shop of Florentine apothecary Officina Profumo-Farmaceutica di Santa Maria Novella. From “ancient preparations” like calming lozenges (pasticche), to refreshing aromatic waters and eau de Cologne, this tiny shop will take you back in time.



SLOVENIA

Karantania Delicatessen, East Colonnade Market, Covent Garden WC2
Thursdays from 11am to 7pm, pick up delicacies including Cevapcici, a traditional Balkan grilled snack.

SEE

FRANCE

Inventing Impressionism, National Gallery, Trafalgar Square WC2
Investigate the start of this crucial art movement through the eyes of the visionary French art dealer Paul Durand-Ruel.



GERMANY

Heinz Mack: ZERO and More, Ben Brown Fine Arts, Brook’s Mews W1
Enjoy a major solo exhibition of the work of a master of the ZERO movement. Iconic works as well as more recent pieces.

NETHERLANDS

Rubens and His Legacy: Van Dyck to Cézanne, Royal Academy of Arts, Burlington House, Piccadilly W1
An exhibition reflecting the influence and legacy of the “prince of painters”, Peter Paul Rubens.



NORWAY

Marius Neset, Purcell Room, Southbank Centre SE1
The Norwegian jazz saxophonist will perform. For further information, go to southbankcentre.co.uk

UK

History is Now: 7 Artists Take on Britain, Hayward Gallery, Southbank Centre SE1
A septet of UK-based artists each offer their unique take on a particular time in UK history over the past 70 years.



GEORGE SEVIER EXAMINES THE GENESIS OF A POWERFUL TOOL FOR COMBATING ONLINE INFRINGERS

The internet is undoubtedly a tool that brings enormous amounts of information to consumers' fingertips. However, the anonymity that it allows has created new avenues for unscrupulous activity. Rights owners continue to see the impact on sales of pirated digital content being downloaded for free and counterfeit products sold for a fraction of the price of the original.


The law has also been adapting, however, allowing online infringement to be dealt with in new ways. There are now various routes through which rights owners can tackle infringement enabled by the internet. And one method in particular, the use of injunctions to

force internet service providers (ISPs) to block access to particular websites – so-called blocking injunctions – has grown popular.


Where products are listed on third-party websites such as eBay, Amazon or Alibaba, and there is copyright or trade mark infringement – whether in the listing text or images, or in the product – rights owners can take action relatively easily, using take-down processes such as eBay's Verified Rights Owner (VeRO) programme.

However, while sales of pirated copies of DVDs and CDs might once have been a major problem, film and music copyright owners now have more of an interest in curbing file sharing – a widespread practice whereby films and music are downloaded for free. This file sharing

is not conducted through legitimate third-party websites; it is generally conducted by individuals, peer to peer. This means that the operators of websites that promote file sharing are not directly involved, and so may not directly infringe. And, even if they are found to infringe, legal action against the website operators may be ineffective. This was demonstrated famously in *Twentieth Century Fox Film Corporation and others v Newzbin Ltd* [2010] EWHC 608 (Ch), when Twentieth Century Fox was granted an injunction against Newzbin Ltd, the operator of the Newzbin website that facilitated copyright infringement. A matter of days after the judgment, however, the website relaunched as Newzbin2, hosted in the Seychelles (Twentieth Century Fox Film Corporation and



While many hosting providers do act on take-down requests, the operators of rogue websites are adept at moving to new hosts, including hosts who are known to pay little heed to take-down notices



others v British Telecommunications plc [2011] EWHC 1981 (Ch).

Counterfeit goods are advertised on legitimate third-party websites such as eBay, but more often sales are made via independent websites set up for the purpose of trafficking in these goods. Many of these websites are designed to look like genuine outlets and some closely mimic the brand owner's website.

The operators of the websites tend to mask their identities and, as in the example of Newzbin, are able to quickly set up elsewhere if action is taken against them. As a result, actions against these website operators may prove fruitless.

Other options

Other options open to rights owners also have drawbacks.

In theory, rights owners could take action against individual copyright infringers in the UK (but not recipients of counterfeit goods, unless they are importing the goods in the course of trade), using Norwich Pharmacal-type orders to get ISPs to disclose the internet users' identities.¹ However, given the massive number of individual users, this would be largely ineffective, disproportionately expensive and would risk stigmatising the rights owners.

Article 14 of Directive 2000/31/EC (the E-Commerce Directive) states that hosting providers are not liable for the information they store, on

the condition that if they are made aware of illegal activity or information, they act expeditiously to remove or disable access to the information. While many hosting providers do act on take-down requests, the operators of rogue websites are adept at moving to new hosts, including hosts who are known to pay little heed to take-down notices.

Where goods are paid for, payment providers such as Visa can be asked to suspend the accounts of the website operators, but the websites will still be able to accept payment by other means, such as bank transfer.

Some search providers (including Google) are prepared to de-index links to web pages that infringe copyright. However, they do not generally do so in respect of trade mark infringement, absent a court order. Further, although removing such web pages from search results can reduce the number of people who access infringing content, the links to such sites are often disseminated by spam email or via social media.

Admittedly, blocking injunctions do not provide a complete solution, as they do not extinguish the website concerned, they do not result in any direct action against the culprits and they can be circumvented.

However, they have been shown to be effective. The section 97A blocking injunction in respect of The Pirate Bay website caused traffic to the website from the UK to fall by 75 per cent immediately following implementation of the injunction, and it has dropped further since.² By contrast, the number of people accessing the website from elsewhere in the world has seen little change.

Legislative roots

Three European directives provide the backdrop to blocking injunctions in respect of IP infringement.

As previously mentioned, the E-Commerce Directive paved the way for ISPs to block infringing websites. ISPs, as mere conduits, are not liable for information transmitted by them (Article 12), but this, the Directive states "shall not affect the possibility for a court or administrative authority, in accordance with Member States' legal systems, of requiring the service provider to terminate or prevent an infringement".

Article 8(3) of Directive 2001/29/EC ("the Information Society Directive" or "InfoSoc Directive") provides that right holders should be able to apply for injunctions against ISPs whose services are being used to infringe copyright. In the UK, this was

¹ Norwich Pharmacal Company and others v Commissioners of Customs and Excise [1973] UKHL 6

² Dramatico Entertainment Ltd and others v British Sky Broadcasting Ltd and others [2012] EWHC 268 (Ch)

implemented by the introduction of section 97A of the Copyright Designs and Patents Act 1988 (“CDPA”). Since it was first used in the *Newzbin2* case, section 97A has been used by music and film copyright owners to obtain blocking injunctions in respect of numerous websites being used by UK-based consumers for file sharing.

There is no obvious equivalent of section 97A to allow blocking injunctions in respect of trade mark patent or design infringement. At European level, Directive 2004/48/EC (“the Enforcement Directive”) obliges Member States to make remedies available to enforce IP rights (ie not limited to copyright). Article 11 provides for the availability of injunctions against infringers, but ends with the sentence: “Member States shall also ensure that right holders are in a position to apply for an injunction against intermediaries whose services are used by a third party to infringe an intellectual property right, without prejudice to Article 8(3) of Directive 2001/29/EC.”

In the High Court’s October 2014 decision in *Cartier International AG and others v BSKyB and others* [2014] EWHC 3354 (Ch), Mr Justice Arnold confirmed that the effect of the final sentence of Article 11 of the Enforcement Directive is that trade mark owners should be able to seek blocking injunctions in respect of trade mark infringement. While this sentence has not been specifically implemented by the UK Government, Arnold J was satisfied that the Court had the necessary jurisdiction, as recognised in section 37(1) of the Senior Courts Act 1981: “The High Court may by order (whether interlocutory or final) grant an injunction... in all cases in which it appears to be just and convenient to do so.” He considered that this applied not only to injunctions against infringers, but also to blocking injunctions against

Now that the law has been tested, future actions should be more straightforward, and are unlikely to be robustly defended by ISPs

intermediaries. The UK’s five main ISPs were ordered to block their subscribers’ access to websites advertising and selling counterfeit (ie trade mark infringing) products.

Remaining challenges

Differing technologies have been employed by file sharers, such as the use of a BitTorrent system discussed in the *Pirate Bay* case. So far, all have been found to result in infringement.

File sharing websites do not usually host infringing content. Instead, they tend to operate by providing signposts or links to content. There had been a concern that the Court of

Justice ruling in *Nils Svensson and others v Retriever Sverige AB* (Case C-466/12, “*Svensson*”) would have an impact, as the Court of Justice indicated that the provision of links to content may not amount to infringement. However, the High Court has now considered *Svensson*’s impact on file sharing, and confirmed that there is nevertheless infringement (*Paramount Home Entertainment International Ltd and others v British Sky Broadcasting Ltd and others* [2014] EWHC 937 (Ch)).

What next?

In the *Cartier* case, the UK’s five main ISPs were ordered to prevent their subscribers from accessing websites advertising and selling counterfeit (ie trade mark infringing) products. In a follow-up judgment (*Cartier v BSKyB* [2014] EWHC 3765 (Ch)), Arnold J has confirmed that the Court has jurisdiction to grant blocking injunctions where there is infringement of any IP right. However, there is unlikely to be a rash of blocking injunctions in respect of patent or design infringement, cases in which – unlike copyright infringement or counterfeiting – infringement is likely to be less clear-cut and validity may be a real issue.

Nonetheless, copyright owners will continue to use blocking injunctions to stem file sharing, and following the *Cartier* case there will likely be greater use in respect of trade mark infringement. Now that the law has been tested, future actions should be more straightforward, and are unlikely to be robustly defended by ISPs.



George Sevier

is an Associate at Wragge Lawrence Graham & Co LLP

george.sevier@wragge-law.com

George assists trade mark owners in enforcing their brands, particularly online.

Into Africa

Martin Chinnery has tracked down the primary trade mark points of practice in this continent of great contrasts



It's the world's second-largest continent and home to over a billion people. Yet, despite its size, many companies embarking on a "worldwide" trade mark filing programme overlook Africa completely.

There are many reasons for this. Despite its large size and population, many African countries are considered the least developed and poorest in the world. Many Western companies feel they are unlikely to be seeking customers in African countries and consider that the problems inherent in the enforcement of IP rights mean the struggle to obtain registration is not worthwhile.

However, this view seems increasingly outdated in 2015. Over the past 20 years, the advent of the ➔

internet has made the rest of the world more accessible to African consumers, and *vice versa*. China has been a key trading partner with many African countries for decades and has strengthened its trading links in recent years, siting factories in Africa and providing investment in infrastructure. While many of these companies have the best of intentions, others have used IP laws to their own advantage, producing counterfeit goods in countries in which Western trade mark owners do not have trade mark protection.

In recent years, it has become more common for African and Chinese companies to register internationally well-known trade marks in their own name. It comes as a surprise to many trade mark owners to find that in the absence of any prior registrations or use in the country concerned, they may be powerless to prevent this.

Legal systems

Generally, the legal systems of African countries were established during colonial times and can be broadly split between the common law systems of the former English colonies and the civil law systems of the former French and Portuguese colonies. Common law jurisdictions, such as Ghana, Kenya and Nigeria, will recognise trade mark rights acquired through use and are more likely to be amenable to the concept of cancelling trade marks that have been registered in “bad faith”. However, many civil law jurisdictions, such as the Organisation Africaine de la Propriété Intellectuelle (“OAPI”) and Madagascar, operate registration systems in which rights are granted to the first to file, regardless of whether the first to file is the genuine trade mark owner. It is largely in these jurisdictions, some of which lack the concept of “bad faith” in their laws, that many trade mark owners come unstuck.

Regional systems

OAPI

Often referred to as the “African Union”, OAPI bears no relation to the inter-governmental organisation of the same name. OAPI provides a centralised registration system for its

A peculiarity of the OAPI system is that while it allows multi-class filings, it is not possible to include goods and service classes in one application

member countries, which are mainly French-speaking nations in West Africa. There are currently 17 OAPI member countries: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Comoro Islands, Congo, Equatorial Guinea, Gabon, Guinea, Guinea Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal and Togo, and registration of a mark at OAPI covers all the member territories. It is not possible to cover certain territories only.

The registration system is depository; applications are examined to ensure that formalities are complied with, but OAPI does not refuse applications on absolute or relative grounds. This means that it is possible to obtain a registration within 18 months of filing, but also that it is possible to obtain a registration that is unenforceable. There is a six-month opposition term after registration. A peculiarity of the OAPI system is that while it allows multi-class filings, it is not possible to include goods and service classes in one application.

By African standards, OAPI is a highly efficient Registry. The trade mark law is largely based upon French law, which means that decisions of the French Trade Mark Office, OHIM and the Court of Justice of the European Union (CJEU) are influential. While it is not perfect, OAPI’s Opposition Commission has issued sensible and logical decisions.

By international standards, the official fees are high, but the fact that 17 countries are covered by a single filing means that the system is considered to be good value for money by many trade mark owners.

However, although opposition proceedings are handled by OAPI, cancellation proceedings are heard in the courts, and court proceedings in Africa can drag on for years. Although OAPI registrations can be enforced in the courts of any member state, it is recommended that if there is a choice of jurisdiction, any legal proceedings are commenced in Cameroon, as this is where the OAPI office is situated. It is also the country that has the most lawyers and judges with experience of handling IP matters.

ARIPO

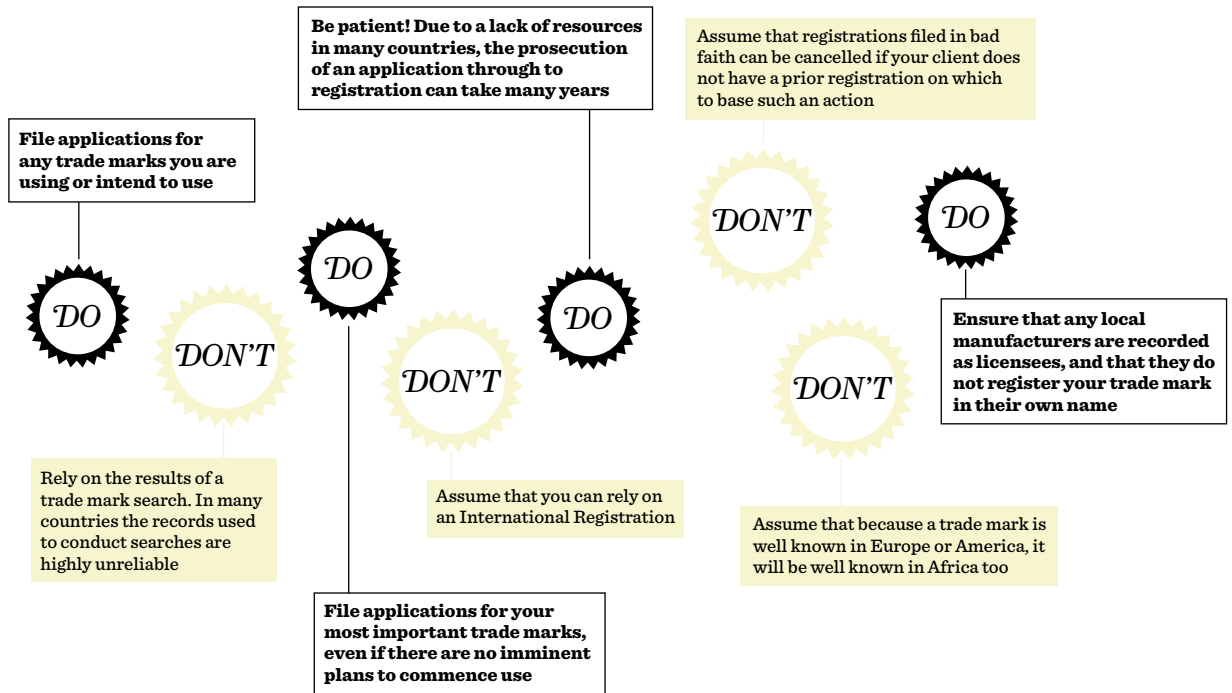
Registration of trade marks at the African Regional Intellectual Property Organization (“ARIPO”) is in accordance with the Banjul Protocol. Countries currently party to that protocol are Botswana, Lesotho, Liberia, Malawi, Namibia, Swaziland, Tanzania, Uganda and Zimbabwe. Unlike OAPI, applicants can designate which of these countries to cover, paying additional fees for each member state.

However, there is presently no harmonisation between the provisions of the Banjul Protocol and the national laws in the nine member states. The ARIPO system is cumbersome and slow, mainly due to the inefficiencies of some of the national offices. Relatively few trade mark applications have been filed at ARIPO, and even fewer have reached registration. ARIPO is making efforts to improve matters, but the system is unlikely to be popular until more countries join up and there is full harmonisation between national laws and the Banjul Protocol.

International option

Those who rely on International Registrations should take care when designating countries in Africa. Some fully comply with their obligations under the Madrid Agreement or Protocol, however several countries are signatories to the Protocol but

FILING IN AFRICA... Dos and Don'ts



have done nothing to amend their national laws to recognise the effect of International Registrations.

International Registrations designating Algeria, Botswana, Egypt, Kenya, Madagascar, Morocco, Mozambique, Rwanda and Tunisia are recognised and enforced by the authorities in these countries.

However, the status of International Registrations in other African jurisdictions is questionable. Ghana, Sierra Leone, Swaziland and Zambia are signatories to the Madrid Protocol, but have not enacted domestic legislation to enable International Registrations to be recognised.

As these are all common law jurisdictions, it is widely believed that International Registrations designating these countries will remain ineffective until appropriate amendments to the national legislation have entered into force.

Despite being a member of the Madrid Agreement since 1984 and the Madrid Protocol since 2010, Sudan ignored designations from WIPO until relatively recently. However, it has begun to issue examination reports and provisional refusals to WIPO without any changes to the law or Regulations. As a common law jurisdiction, the validity of

International Registrations that designate Sudan could be open to challenge.

In Lesotho, Liberia, Namibia and São Tomé and Príncipe, no domestic legislation has been introduced to recognise International Registrations, but the laws of these nations state that in the event of a conflict between international treaties and domestic laws, the terms of the international treaties shall prevail.

However, until the validity of International Registrations has been challenged in the courts of these particular countries, the status of International Registrations is open to doubt.

OAPI filed an instrument of accession to the Madrid Protocol on 5 December 2014, so the Protocol is due to enter into force on 5 March 2015. OAPI officials are insistent that designations of international classes will be processed and registered. Nevertheless, there are no plans to amend the IP law at the present time so their validity may be challenged.

Local knowledge

There is not enough space available to summarise the laws and practices of every country in Africa, but the following have idiosyncrasies that are worthy of note.

ANGOLA

Angola is one of the world's fastest-growing economies and of increasing interest to trade mark owners.

Unfortunately, the disorganised nature of the IPO means that applications are prosecuted slowly and it is not unusual for applicants to wait as long as seven years – or more – to achieve registration.

DJIBOUTI

Djibouti enacted a modern IP law in 2009, which is TRIPS-compliant and provides for the filing of multi-class applications and priority claims, commercial names, geographical indications and names of origin, as well as the control of unfair competition. As a civil law jurisdiction, rights accrue to the first to file, but there is no provision for opposition; those wishing to take action against conflicting trade marks must do so in court.

Unfortunately, the authorities in Djibouti have set the official fees at a prohibitively high level for most applicants, totalling almost US\$1,000 for filing a trade mark in one class.

This has made Djibouti one of the world's most expensive places to file trade marks, and has led to a significant decrease in applications. ➔

By African standards, Kenya has one of the most efficient systems of trade mark registration

ERITREA

There are no local IP laws and, until recently, the publication of Cautionary Notices was the only form of “protection” available. However, although the publication of Cautionary Notices is essentially an informal arrangement, they must first be approved by the Eritrean Government. Without providing any explanation, the Government has suspended the publication of all notices and the situation is not expected to change until a trade mark law has been introduced.

ETHIOPIA

In 2012, Ethiopia published new Regulations bringing into force the Trade Mark Registration and Protection Proclamation 2006. The Regulations required owners of trade mark registrations filed under the old law (filed before 7 July 2006) to re-register existing registrations. This applies to all cases, irrespective of whether they have been renewed since. The deadline for re-registration was 18 December 2014.

Regrettably, and despite lobbying from law firms, the IPO has ruled re-registered cases will not retain their original filing date, but will be granted new numbers and will date from the date the application for re-registration was filed.

KENYA

By African standards, Kenya has one of the most efficient systems of trade mark registration. Applications can be registered within 18 months, and International Registrations designating Kenya are processed in accordance with Kenya’s obligations under the Madrid Protocol.

MADAGASCAR

Madagascar was originally a member of OAPI, but left in the mid-1970s. It is a civil law country in which rights are obtained by the first to file. Trade mark piracy is rife, and there is no mention in the law of the cancellation of registrations filed in bad faith. The Trade Mark Office (OMAPI) does examine applications and will reject applications on relative grounds.

Unfortunately, there is no procedure for appealing against rejections; appeals against the refusal of applications have to be filed with the courts. Inevitably, this can be a long and arduous process, with no guarantee of success. Although court proceedings in Madagascar are relatively inexpensive in comparison with other jurisdictions, appeals can last for years. Applicants can be frustrated to find that co-existence agreements and letters of consent are only accepted by OMAPI if they are filed at the same time as the application concerned.

Furthermore, it is common for local distributors of imported goods to register the trade marks of the goods they are selling, but in their own name. Unless the genuine trade mark owner can show that the mark is internationally well known within the meaning of Article 6bis of the Paris Convention, success in cancellation proceedings against a rogue registration is unlikely.

Fortunately, OMAPI is one of the few Registries in Africa with computerised records, and searches are fairly accurate. Because of the problems in appealing against rejection notices, it is recommended that searches are conducted prior to

filing so that any potential bars to registration can be addressed before a rejection notice is issued.

MOZAMBIQUE

The Mozambique Trade Marks Act requires that Declarations of Intent to Use should be filed every fifth year, calculated from their respective filing dates in Mozambique. However, it does not matter whether the trade mark is in use or not, and there is in fact no declaration to be signed; a fee is simply paid to the Trade Mark Office to keep the trade mark on the Register.

NIGERIA

In terms of population, Nigeria is the largest country in Africa, with 174 million inhabitants. A common law country, its trade mark law is broadly similar to the UK Trade Marks Act 1938. Applications are examined and can be refused on absolute or relative grounds. There are several peculiarities; for instance, despite Nigeria's membership of the Paris Convention, priority claims cannot be made. Additionally, the Registry began to accept service marks in 2007 without amending the law to recognise such marks, so the validity of trade marks registered in classes 35 to 45 may be challenged if relied on in court.

Due to a lack of resources and skilled staff, Nigeria's Registry has a

rather unfortunate reputation. Many applications filed 20 or even 30 years ago remain pending, and the prospects of these applications being progressed to registration are minimal, as the Registry's official files will have been lost. The lack of computerisation of the Registry's records and a chaotic card index filing system means that searches are unreliable, to the extent that conducting a clearance search is, in many instances, a waste of time.

However, a distinction may be drawn between the fate of old applications and recently filed cases. New applications are examined quickly and it is not uncommon for applications filed today to be examined within a year and registered within two.

Whereas the publication of the *Trade Marks Journal* used to be a rare occurrence, with years passing between each issue, in recent times it has been published five or six times a year, and this has accelerated the registration process.

The Nigerian Food and Drug Administration ("NAFDAC") plays a vital role against counterfeiting and requires foodstuffs, pharmaceutical and medical products, and cosmetics to be registered before they can be legally sold. Applications to register a product must be accompanied by evidence that the trade mark used is registered in Nigeria.

SIERRA LEONE

Sierra Leone's trade mark law dates back to 1946, as does its classification system. Using the old British classification system in force before the Nice Agreement, goods are divided into 50 classes and there is no provision for the registration of service marks.

SOMALIA

The Trade Marks Registry in Mogadishu has been closed since 1991 as a result of the civil war and the consequential disruption to the country's infrastructure. Since that time no one has been able to file new applications for trade marks, or to renew existing trade mark registrations.

Somalia remains in turmoil politically and, while there is now a formal government in place, all indications are that the legal and court systems are largely non-functioning for the time being.

TANZANIA

The United Republic of Tanzania comprises mainland Tanganyika and the Zanzibar Archipelago, which merged in 1964.

Unfortunately, the trade mark laws of Tanganyika and Zanzibar have not been harmonised and it is still necessary to file separately in both jurisdictions to obtain trade mark protection in the entire country.

The validity of designations of Tanzania in ARIPO trade marks is also open to question due to Tanganyika and Zanzibar both operating separate systems of trade mark registration.



Martin Chinnery

is Director of Trade Marks at Lysaght & Co
martin@lysaght.co.uk



The name game

Shoe designers tread on each other's toes in conflict over eponymous brands, reports Hannah Bosworth

This recent Appointed Person decision, delivered by Geoffrey Hobbs QC, substantially upheld the original decision of Mr Oliver Morris, in a consolidated set of oppositions in favour of the shoe brand Nicholas Deakins Ltd ("NDL"). The parties involved were NDL and shoe designer Justin Deakin ("JD").

Both parties sought to prevent the other from registering DEAKIN or DEAKINS in relation to class 25, including claims that the applications were made in bad faith (Section 3(6)), the marks were confusingly similar to an earlier mark (Section 5(2)(b)) and that the applications could be prevented by unregistered rights through use (Section 5(4)(a) of the Trade Marks Act 1994).

Central factor

A partnership arrangement (and its dissolution) proved central to the case. Justin Deakin and Craig Tate were the founding partners of NDL. In 1993, Deakin sold his rights to Tate and the partnership was dissolved. The UK stylised Trade Mark No. 2396693 NICHOLAS DEAKINS was registered for class 25 in 2005 by NDL, after Justin Deakin had signed a contract of dissolution that contained the clause: "Mr Deakin is free to use his own name in any business of [which] he is a part." From this agreement, JD interpreted the clause as consent to register his own name as a trade mark, also for class 25.

Thus, in 2007 JD registered the UK Trade Mark No. 2443925 JUSTIN

DEAKIN; NDL did not take any action at this stage. JD believed his name had a reputation, claiming "in the fashion industry it is common for goods to be associated or otherwise marked with the designer's name".

The problems began when JD subsequently attempted to register UK Trade Mark No. 2489547 DEAKIN for class 25 in 2008. This was refused, on opposition by NDL, due to passing off and the likelihood of confusion.

A few months later in 2008, NDL attempted to register UK Trade Mark No. 2501575 DEAKINS for classes 25, 18 and 35, which was opposed by JD. While JD succeeded in preventing NDL registering DEAKINS for class 25, the application proceeded to registration for classes 18 and 35.

Finally, JD attempted to register the stylised UK Trade Mark No. 2534122 MASTER DEAKIN SON OF MR. DEAKIN in 2009 for class 25.

This was rejected on the basis of passing off as NDL had goodwill in the mark DEAKINS.

Overall, Mr Hobbs QC refused JD's appeal, aside from one small point based on the likelihood of confusion for class 25 of the UK Trade Mark No. 2501575 DEAKINS, though this did not change the ultimate outcome of the oppositions.

No one should make assumptions about IP rights residing in their own names

Useful guidance

This case, while clearly fact-specific, offers some useful guidance for rights owners entering into or leaving a partnership, as well as those building a brand around and seeking protection for use of their names. The conflict between JD and NDL could have been avoided had it been more clearly and thoroughly addressed in the contract.

Ultimately, no one should make assumptions about IP rights residing in their own names.



Hannah Bosworth

is a Trainee Trade Mark Attorney at Stobbs (IP) Limited

Hannah.Bosworth@stobbsip.com

Hannah assists with all types of trade mark practice, from filing applications to dealing with disputes, protection and enforcement.

Case breaks for Greyleg

Luke Portnow savours the distinctive flavour of descriptive use

A large part of this Appointed Person (appeal) decision confirms a basic but important tenet: the way in which a trade mark, whether registered or unregistered, is used by its owner can have a major impact on its enforceability. The case also highlights the difficulties in establishing a passing off claim, and having secondary or “limping marks” considered capable of indicating origin.

Background

Greyleg Investment applied to register the word mark HOKEY POKEY for “ice cream frozen yoghurt” [sic] in class 30. This was opposed by BR IP Holder LLC (Baskin Robbins) under Section 5(4)(a) of the Trade Marks Act 1994 on the basis that it had used HOKEY POKEY in the UK on ice cream goods since 1997 and, therefore, owned goodwill in the mark.

Both sides filed a substantial volume of evidence and attended a hearing. The Hearing Officer held that there was no evidence to support Baskin Robbins’ claim to goodwill. If anything, the evidence supported the Applicant’s argument that HOKEY POKEY is (or was being used by Baskin Robbins as) a description of an ice cream flavour – clearly showing HOKEY POKEY being used descriptively to indicate to the public the flavour of an ice cream and with “HOKEY POKEY” always appearing alongside “BASKIN ROBBINS” on invoices and packaging. With no goodwill, there could be no misrepresentation or damage, and so the opposition was rejected.

Baskin Robbins appealed this decision up to the Appointed Person.

The first ground of appeal was promptly rejected. The Appointed Person held that while a flavour designation or descriptor may be capable of generating its own goodwill and function as a trade mark independent of the trade name with which it has been used, none of the evidence submitted was of the kind identified in case C-353/03, *Société des Produits Nestlé SA v Mars UK Limited*, [2006] FSR 2 (Have A Break) to show that the name had come to operate as its own indicator of trade origin.

Baskin Robbins’ second appeal ground, that the Hearing Officer was wrong to hold that HOKEY POKEY had become descriptive through the use made of it by Baskin Robbins, was also rejected. Although a descriptive term for honeycomb elsewhere, there was no evidence that UK consumers saw “HOKEY POKEY” as such.

The third appeal ground, that Baskin Robbins had (as a logical consequence of its extensive use of HOKEY POKEY) generated goodwill in the name, was also dismissed. Here the evidence was deemed to clearly show use of HOKEY POKEY as a descriptor (for an ice cream product) with trade origin tied to its combined use alongside “BASKIN ROBBINS”. The

The use that had been made of the name by Baskin Robbins had not amounted to trade mark use and so had not generated goodwill

use that had been made of the name by Baskin Robbins had not amounted to trade mark use and so had not generated goodwill.

Useful précis

This appeal to the Appointed Person, when read in its entirety, provides a very useful and succinct précis of case law surrounding how the Registry considers the impact of descriptive use of a trade mark on a consideration of passing off under *Jif Lemon*¹ and *Reddaway*². It also shows how evidence filed in support of any type of action can (even unintentionally) show use of secondary or “limping” trade marks in such a way that they cannot indicate origin, rendering the mark unable to be the type of indicator of trade origin identified in *Have A Break*.

¹ *Reckitt & Colman Ltd v Borden Inc* [1990] 1 All ER 873

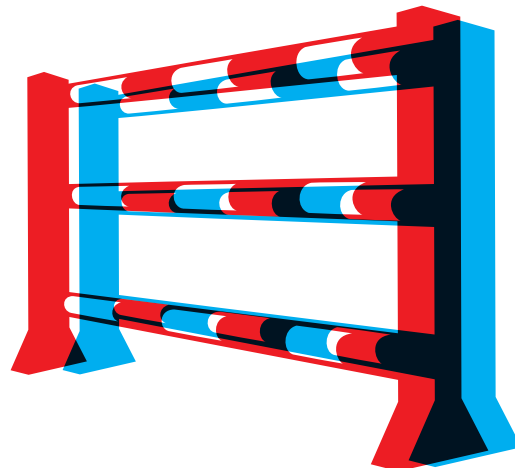
² *Reddaway v Banham* 13 RPC 218 (HOL) and *McCain International Limited v Country Fair Foods Limited* and *Another* [1981] RPC 69 (COA)



Luke Portnow

is a Part Qualified Attorney at Boulton Wade Tennant
LPortnow@Boulton.com

Luke works on prosecution and contentious matters for a range of clients.



Tripping over 3D hurdles

Jude King foresees trouble ahead for a children's furniture classic

A preliminary ruling in the recent "Tripp Trapp" children's chair dispute clarifies issues – in addition to distinctiveness – of which brand owners should be aware when looking to register three-dimensional trade marks of their product shapes.

The case concerned the validity of a Benelux trade mark registration of the shape of the L-shaped "Tripp Trapp" chair (marketed by the Dutch company Stokke and shown below).

Hauck's "Alpha" and "Beta" children's chairs were considered to bear a strong resemblance to the "Tripp Trapp" chair. Stokke sought to enforce its trade mark rights, resulting in the inevitable call for Stokke's trade mark to be invalidated.

Invalidity was alleged under Article 3(1)(e) of the Trade Marks Directive 2008/95/EC ("the Directive") on the basis that:

- the shape was determined by the very nature of the product itself; and
- the sign consisted only of a shape that gave substantial value to the goods.

The national court referred questions to the Court of Justice of the European Union (CJEU) for a preliminary ruling regarding interpretation of these grounds.

Natural shape

The Court stressed that the first-mentioned ground was not restricted to preventing registration only of "natural" or "regulated" products. Although it does not apply to signs that include an essential or important element that is not inherent to the generic function of the goods (ie a decorative or

imaginative element), it does extend beyond signs that consist exclusively of shapes that are indispensable to the function of the goods. The Court, therefore, ruled that this provision covers signs that consist "exclusively of the shape of a product with one or more essential characteristics which are inherent to the generic function or functions of that product and which consumers may be looking for in the products of competitors".

Accordingly, to assess their prospects of obtaining a registration, owners will have to consider the essential characteristics of their product shape on a case-by-case basis to assess whether any of them are not inherent to the generic function of the goods.

Substantial value

The Court emphasised that goods could derive substantial value from several characteristics, and not from purely aesthetic value, and still be caught by this ground of objection. Using the example of the "Tripp Trapp" chair, its value could also derive from characteristics including the safety, comfort and reliability of the product. It is, therefore, possible for product shapes that have essential functional characteristics, as well as a significant aesthetic element, to be refused registration or be declared

invalid on this basis, if the criteria of this provision are fulfilled.

The Court also noted that the public perception of the shape is only one of the relevant factors that "may" be taken into account when assessing whether the shape gives substantial value to the goods. Other factors that could be relevant include: (i) the artistic value of the shape in question and any promotion strategy that focuses on accentuating the aesthetic characteristics of the product; (ii) the shape's dissimilarity from other shapes in common use on the market concerned; and (iii) a substantial price difference in relation to other similar products.

The Tripp Trapp chair



Jude King

is a Trainee Solicitor at Browne Jacobson LLP

jude.king@brownejacobson.com

Jude works on advertising and marketing issues, contentious and non-contentious IP, licensing and commercial contract work.

Recommended reading

James Moore suggests this case offers a crash course in the canon of law in two crucial areas

This case concerns an appeal of the decision of the Fifth Board of Appeal of OHIM of 17 May 2013 (Case R 2099/2012-5) to the General Court.

The Appellant had filed a Community Trade Mark (CTM) application to register the mark PRECISION SPECTRA for class 9 and 10 goods. The examiner had allowed registration of the mark in relation to a limited selection of goods in class 10, but refused the application for the class 9 goods and the remaining class 10 goods. The basis for the refusal was that the mark was descriptive and non-distinctive in relation to the refused goods. The Appellant appealed the contested decision to the Fifth Board of Appeal, which upheld it, and then to the General Court.

As part of its appeal, the Appellant sought a declaration that the mark was eligible for registration. The General Court dismissed this request on the grounds that the purpose of bringing actions before the Court is to have the lawfulness of decisions of the Boards of Appeal examined and to obtain, as the case may be, the annulment or alteration of those decisions. Consequently, such an action cannot have the objective of obtaining confirmatory or declaratory rulings in respect of contested decisions.

The Appellant sought the annulment of the Board of Appeal's decision by arguing: that the mark was not descriptive for the refused goods; that OHIM had been wrong not to examine whether the mark was devoid of distinctive character;

The third plea was dismissed on the basis that the Board of Appeal exercises circumscribed – not discretionary – powers

and that the Board of Appeal had abused its discretion and breached the principle of equal treatment, as it had ignored earlier registrations containing the word “precision” or the word “spectra”.

Court conclusions

The General Court dismissed the first plea on the basis of relevant settled case law concerning the descriptiveness of a mark.

The General Court then upheld the right of the Board of Appeal not

to examine whether the mark lacked distinctiveness as it had already found that the mark was descriptive, although it reiterated settled case law that “a word mark which is descriptive of characteristics of goods or services... is, on that account, necessarily devoid of any distinctive character in relation to those goods or services.”

The third plea was dismissed on the basis that the Board of Appeal exercises circumscribed – not discretionary – powers, and that the question of whether a sign is eligible for registration as a CTM must be assessed solely on the basis of Regulation (EC) No 207/2009, as interpreted by the Courts of the European Union, and not on the basis of the previous decision-making practice of the Boards of Appeal.

Established canon

This decision of the General Court demonstrates that there is now an established canon of settled case law relating to the descriptiveness and lack of distinctiveness of a mark and that it is usually very difficult to overcome such objections through argument, unless a material error has been made in the assessment of those issues. A read of the decision in relation to the references to settled case law is highly recommended.



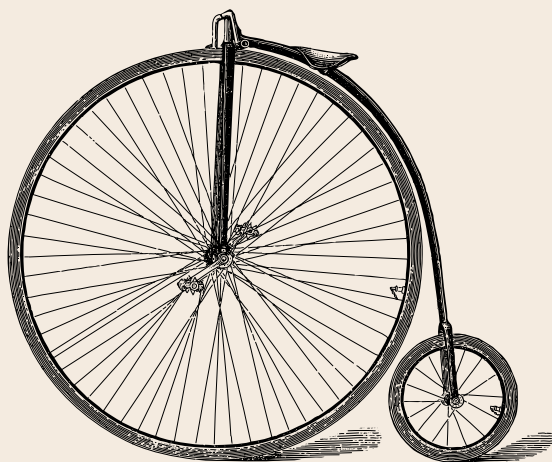
James Moore

is a registered Trade Mark Attorney with
Simmons & Simmons LLP
james.moore@simmons-simmons.com



Mounting problems

An unusual sporting mark was too obscure to stand up to a famous brand, says Rupert Bent



Cycle polo, a relatively unknown sport that dates back to 1891, has recently caused a stir at the General Court thanks to a proposed registration being met with fierce opposition... on horseback.

The facts

FreshSide Ltd (“FreshSide”) applied to register a Community Trade Mark (Figure 1, right) in respect of goods in class 18 (travel bags and umbrellas), class 25 (clothing, footwear and headgear) and class 28 (gymnastic and sporting articles not included in other classes). The Polo/Lauren Company, LP (“Lauren”) opposed this, on the basis of two of its earlier marks: a Community mark (Figure 2), and a national mark registered in Austria (Figure 3).

Before it reached the General Court, Lauren’s appeal from the Opposition Division had been dismissed by OHIM’s Board of Appeal on the basis that the signs in issue were dissimilar overall. OHIM emphasised that the differences between the signs prevailed over their similarities, attaching particular importance to the difference in mount (one mark depicts a rider on a bicycle versus a mark depicting a rider on horseback). OHIM contended that the lack of visual and conceptual similarity would simply not allow the Board of Appeal to conclude there was a likelihood of confusion.

Decisive issues

Article 8(1)(b) of the Community Trade Mark Regulation (EC) No 207/2009 provides that, upon opposition by the proprietor of



an earlier mark, the mark applied for must not be registered if – because of its identity with, or similarity to, an earlier mark and the identity or similarity of the goods or services covered by the marks – there exists a likelihood of confusion on the part of the public in the territory in which the earlier mark is protected. While the OHIM Board of Appeal held that the threshold for successful opposition had not been met because the marks were dissimilar, the General Court disagreed, reaching the opposite conclusion on similarity.

In considering the perspective of the public, the Court noted that the average consumer normally perceives the mark as a whole, and does not engage in an analysis of its various details (C-334/05 P OHIM v Shaker [2007] ECR I-4529). As a result, the court should do the same. The General Court also stated that if from the view of the relevant public the signs are at least partially identical in one or more relevant aspects (visually, phonetically or conceptually), two marks will be held to be similar (T-385/09 Ancco v OHIM – Freche et fils (ANN TAYLOR LOFT) [2011] ECR II-455).

On this analysis, the General Court found that the Board of Appeal’s finding that the bicycle was the dominant element in the mark was inaccurate, as this did not consider the mark as a whole. It noted that the representations of each mount used a similar amount of space within the graphic – in other words, a similar proportion of the mark’s total area – to the space used by the polo players and mallets, and therefore the latter could not be regarded as “negligible” in the marks at issue.

There were, moreover, a number of other similarities between the marks that could not be described as insignificant, including the fact that both marks featured: (i) a person holding a polo mallet in the air; (ii) a person not represented in any specific colour; (iii) a person represented head on, but slightly in profile; (iv) polo mallets at the same angle; (v) graphic representations to indicate that the person is in motion; and (vi) relative dimensions (ie a similar ratio between the height and width). The General Court held, therefore, that “a visual comparison of those signs gives the impression of a certain symmetry”, which led it to the decision that the marks had “at least, a low degree of visual similarity”.

Conceptual level

At a conceptual level, the General Court echoed the finding of the Opposition Division that the marks at issue were conceptually similar to the extent that they both contained the representation of a polo player. The Court noted that conceptual differences may counteract phonetic and visual similarities to a large degree where one of the marks has a clear and specific meaning that can be immediately grasped by the relevant public (C-16/06 Les Éditions Albert René v OHIM [2008] ECR I-10053). However, as no evidence had

been put forward to suggest that bicycle polo is a sport or game sufficiently known to the public, the General Court found that FreshSide’s mark failed to establish it was anything more than an “emergent sport” and, therefore, the marks were held to have a low degree of conceptual similarity.

As the marks were visually and conceptually similar, the General Court found in favour of Lauren.

Comment

The reversal of the Board of Appeal’s decision in this case highlights that even where objective criteria are applied in making these assessments there will always be a degree of subjective analysis.

The General Court also provides an important reminder that conceptual differences can trump visual and phonetic similarities, showing how vital it can be to produce evidence illustrating these differences, particularly in the minds of the relevant public.

The marks in conflict



Fig 1



Fig 2



Fig 3



Rupert Bent

is a Partner at Walker Morris LLP
rupert.bent@walkermorris.co.uk

Defying description

Sarah Talland
points out the difficulties
of proving distinction of
three-dimensional marks



This case is an appeal against a decision by OHIM to uphold the cancellation of a three-dimensional trade mark registration on the grounds that the mark was devoid of distinctive character.

The Applicant, Mr Giorgio Giorgis, owned a three-dimensional Community Trade Mark (CTM) registration for the mark shown on page 37 (the Contested Mark). The mark consists of the shape of two glass, goblet-shaped transparent containers and the shape of a cardboard casing with openings at the top and on the sides. The mark was registered in class 30 for, *inter alia*, “ice-creams”.

In January 2010, Comigel SAS filed an application for a declaration that the registration was invalid on the basis of Article 52(1)(a) of Regulation (EC) No 207/2009, namely that the

three-dimensional mark was devoid of distinctive character.

In April 2011, the Cancellation Division agreed that the mark was devoid of distinctive character and rejected the Applicant’s arguments that the mark has acquired distinctiveness through use. The mark was declared invalid in respect of all goods covered by the registration. On appeal, the First Board of Appeal of OHIM upheld the decision of the Cancellation Division.

The decision

On appeal to the General Court, the Applicant alleged that the Board of Appeal had assessed the distinctive character of the three-dimensional mark and the relevant public’s level of attention incorrectly, and that the evidence of acquired distinctiveness had not been properly considered.

In particular, the issues of distinctive character and the relevant public were discussed in detail.

1. Distinctive character

The Court repeated established case law principles applicable to three-dimensional marks, namely that although the same criteria are to be applied when assessing the distinctive character of three-dimensional marks as for other types of mark, the perception of the relevant public is not necessarily the same for all marks. This is particularly the case, as it was here, where the three-dimensional mark consists of the appearance of the product itself. This means that establishing distinctive character of a three-dimensional mark is, in practice, often more difficult than in relation to a word or figurative mark.



Establishing distinctive character of a three-dimensional mark is, in practice, often more difficult than in relation to a word or figurative mark

In circumstances such as these, it must be shown that the three-dimensional mark departs significantly from the norm or customs of the sector, and is thereby liable to fulfil its essential function of indicating origin (Joined Cases C-344/10 and C-345/10 Freixenet v OHIM and CJEU).

The Applicant sought to argue that its three-dimensional mark differs from the norm and customs of the sector in that the packaging “conveyed an image of quality and being handmade”. The Court held, on the contrary, that the types of container as shown in the three-dimensional mark were widely used for ice-cream products and, therefore, did not depart significantly from the norm and customs of the sector concerned.

The Applicant further argued that the Board of Appeal had identified the three-dimensional mark incorrectly, using an inaccurate description. The Court held that the description used by the Board of Appeal to describe the three-dimensional mark was a fair one, and it did not matter that this differed

from the Applicant’s preferred explanation of the mark, particularly as the registration did not contain a description of the mark.

Finally, the Court held that the Applicant’s evidence of acquired distinctiveness was insufficient, as the evidence submitted related to use of the three-dimensional mark in conjunction with a distinctive word mark and, therefore, did not show use of the three-dimensional shape as a trade mark.

2. Relevant public

The Applicant sought to argue that the average consumer of ice cream displays a high level of attention, given that their choice is made on the basis of various factors, including flavour, ingredients and method of consumption. The Court made short shrift of this argument, pointing out

that ice cream products are inexpensive, everyday goods, and consumers of such products will plainly make their choice on the basis of their tastes. The Court upheld the Board of Appeal’s finding that the average consumer of ice cream will not display a particularly high level of attention.

Warning

This decision demonstrates the difficulty of acquiring and, more importantly, maintaining a registration for a three-dimensional mark without substantial evidence of its use as a trade mark. It may also serve as a warning to include a description along with applications for three-dimensional marks, so that this description can be used when assessing the mark.

The contested mark



Sarah Talland

is a Registered Trade Mark Attorney at Wildbore & Gibbons LLP
sarah.talland@wildbore.eu

With thanks to Chris Baume for editorial assistance.

Court sends clear message

The Court reinforced the obligation of OHIM to state the reasons for its decisions, says Amélie Gérard



On 4 March 2011, ALMA – The Soul of Italian Wine LLLP (“The Applicant”) filed a Community Trade Mark (CTM) application for a figurative mark SOTTO IL SOLE ITALIANO SOTTO il SOLE in respect of “wines” in class 33. Miguel Torres, SA filed an opposition against the above-mentioned mark based on its earlier trade marks, *inter alia*, CTM VIÑA SOL in class 33, under Article 8(1)(b) and (5) of Regulation (EC) No 207/2009. The Opposition Division upheld the opposition and the Applicant filed an appeal with OHIM against the decision.

The Board of Appeal of OHIM, taking into account the similarity of the signs, the distinctive character and reputation of the earlier trade mark, and the identity of the goods, found there was a link between the signs such that registration of the mark was prevented under Article 8(5). Therefore, the Board of Appeal dismissed the appeal.

Pleas in law

The Applicant raised four pleas in law, namely, infringement of Article 64, Article 8(5), Article 8(1)(b), Article 75 and Article 76(1) of Regulation (EC) No 207/2009.

By its fourth plea in law, the Applicant submitted that the Board of Appeal acted in breach of its duty to provide a statement of reasons insofar as it did not take into account evidence provided. That evidence consisted of pages from various websites, concerning bottles of wine featuring trade marks containing the words “sol”, “sole”, “soleil” or “sun” and/or images of the sun and also

examples of CTMs, registered in class 33, containing those same words and/or images. This was in order to show that the word “sol” and translations thereof have a very weak distinctive character in the wine sector.

Article 75 provides that decisions of OHIM must include a statement of the reasons on which they are based. This must be done in a clear and unequivocal manner. The duty to state the reasons on which decisions of OHIM are based has a twofold objective:

- 1) to enable the persons concerned to ascertain the reasons for the measure so that they can defend their rights;
- 2) to enable the Courts of the European Union to exercise their jurisdiction to review the legality of the decision.

In the present case, neither the Opposition Division nor the Board of Appeal mentioned the evidence provided by the Applicant and, accordingly, it cannot be established that such evidence was taken into account, even implicitly, when the Board gave its decision on the similarities between the signs and the risk of dilution to the Opponent’s earlier rights. In particular, the Board’s finding that the word “sol” had no descriptive character does not permit the assumption that the Board took into account the evidence. Consequently, the Board acted in

The obligation to state clear reasons is likely to leave less room for OHIM to argue that its reasoning is implicit

breach of its duty to provide a statement of reasons.

As such, the Applicant’s appeal was successful and the Board’s decision was annulled.

Recommendation

As the General Court has adopted a formal position in respect of Article 75, the obligation to state clear reasons is likely to leave less room for OHIM to argue that its reasoning is implicit. Where OHIM’s judgments fail to address key evidence or argument, an appeal should be recommended.



Amélie Gérard

is a Trade Mark Assistant at Keltie LLP
amelie.gerard@keltie.com

Amélie assists with the filing and prosecution of UK and Community trade mark and design applications.

Polish public provides key

Local language knowledge led the Court's decision, writes Claire Stockill

This case involved an appeal to the General Court by Junited Autoglas Deutschland GmbH & Co KG ("Junited") against a decision by the Board of Appeal upholding an opposition, based on Article 8(1)(b) Regulation (EC) No. 207/2009, to Junited's Community Trade Mark (CTM) application for the mark UNITED AUTOGLAS in classes 12 and 37 by Belron Hungary Kft ("Belron"), owner of the Polish figurative mark AUTOGLASS No. 170096 (shown) in classes 12, 21 and 37.

Junited's arguments

Junited argued that there was no likelihood of confusion between the marks because the relevant public, here the general public in Poland, would perceive the term "autoglas(s)" as descriptive, designating glass for automobiles, and that it was solely the figurative element of Belron's mark that warranted protection. Junited alleged that the relevant public would focus on the initial dominant element of its mark: "united", and this sufficiently distinguished the two.

Court considerations

Dismissing the appeal, the General Court affirmed that the goods and services in classes 12 and 37 covered by the marks were similar or identical in relation to windscreens and repair services for vehicle glass.

In relation to Junited's argument that the word "autoglas" is descriptive, the General Court found that, while the term exists in English and German to designate glass for automobiles, it does not exist in

Polish. In that language, the word "auto" can signify automobiles or refer to an automatic device. The Polish word for glass, "szklo", is also highly dissimilar.

Junited imputed to the Polish general public a certain level of English or German without evidencing the claim – the word "glass" could not be considered a rudimentary English word. Given the fact that there is little similarity between the English/German and Polish words for "glass", and that the word "auto" can have more than one meaning in Polish, there was little reason to assume that the term would be descriptive to the Polish public.

As for Junited's assertion that the first part of its mark, "united", was dominant and should be the only element considered for comparison with Belron's mark, the General Court conceded that the first part of a mark often does attract more attention than the elements that follow. However, given that the term "autoglas" was found to have distinctive character, there was no reason for Junited to claim that it

should be disregarded for purposes of comparison.

Although the General Court found that the marks had a low degree of visual similarity, a medium level of phonetic similarity, and were to some degree conceptually similar, it held that because the goods and services covered were partly identical, there was a risk that the Polish general public may consider the goods and services as coming from the same undertaking. As such, there was a likelihood of confusion within the meaning of Article 8(1)(b).

Final word

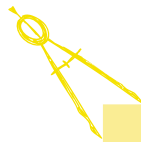
This case highlights that, without evidence to support an argument that the relevant public will find a particular term to be descriptive, it will be difficult to convince OHIM that this is the case, especially in circumstances in which the applicant wishes to impute to that relevant public a certain level of comprehension of foreign vocabulary.

Junited imputed to the Polish general public a certain level of English or German without evidencing the claim




Claire Stockill

is a Trainee Solicitor at Kempner & Partners LLP
stockill@kempnerandpartners.com



London college learns its limits

Neighbouring institutions will continue to co-exist, as Chris Morris explains

Even a business with an unquestionable reputation (to the layman) may not have an actionable goodwill

This case concerned the ability of a state secondary school in the west London council ward of Cranford to prevent a third party also using the name Cranford in respect of educational services.

Cranford Community College (“CCC”) has existed as a secondary school since 1975 and been known as Cranford Community College since 1997. Cranford College Limited (“CCL”) was incorporated as a private venture in 2010 offering further education courses and trades as “Cranford College”.

Both establishments are located within Cranford.

The CCC case focused primarily on its strongest claim, that of passing off based on a claimed goodwill in the name Cranford College. The main defence relied on by CCL was that the name was descriptive and, as such, it either provided no basis for an action of passing off, or minor differences in CCL’s trading style were sufficient to provide a defence.

As Judge Hacon confirmed in his judgment, “it has long been established that a trade name which is descriptive in its literal meaning may be protected by the law of passing off if it has acquired a secondary meaning so that in the relevant market it has come to distinguish the claimant’s goods or services”.

However, he also confirmed that it was well established that in such a scenario minor differences may avoid a passing off claim. In the first place,

therefore, CCC needed to show that the name Cranford College had established a secondary meaning with the relevant public, such that it referred to, and only to, CCC.

Judge Hacon spent some time defining the relevant public in this instance: they will live in CCC’s catchment area and will include, especially, students, as well as the parents and guardians of potential students. It is in relation to that group that the claimed potential harm would occur. Limited national and even international recognition was dismissed.

CCC put forward evidence concerning its recognition as Cranford or Cranford College. Some of this related to use by people who worked at the college, and some by other parties that did not fall within the Judge’s definition. Having considered this, Judge Hacon found no secondary meaning, and hence no goodwill, had been established.

Misrepresentation

Despite the case falling at that first hurdle, Judge Hacon went on to consider misrepresentation. CCC put forward its nine most compelling instances of actual confusion in

support of this limb. In every case, Judge Hacon found that the individual was not a member of the relevant public; instead what was shown was confusion “of the sort that is to be expected when two organisations use the same descriptive name”.

Damage

Judge Hacon finally, and briefly, considered damage. He accepted that damage of the type argued by CCC – a pattern of falling application numbers resulting from a bad reputation – would constitute relevant damage. However, CCC had failed to show any actual damage. The Judge also stressed that any damage would only be relevant if it resulted from a misrepresentation by CCL, which CCC had failed to demonstrate.

Established principles

This case clearly highlights the long-established principles of a passing off claim, alongside the limitations of the action when a party chooses to trade under a descriptive name. Even a business with an unquestionable reputation (to the layman) may not have an actionable goodwill.



Chris Morris

is an Associate, Trade Mark Attorney at Burges Salmon LLP
chris.morris@burges-salmon.com
 Chris is a member of the firm’s IP team.

events

More details can be found at itma.org.uk

Date	Event	Location	CPD hours
12 February	ITMA Seminar and Drinks Reception with the IPO	Burges Salmon, Bristol	1.5
24 February	ITMA London Evening Meeting* "Survey Evidence", Michael Browne, Redd Solicitors, and Philip Malivoire	Royal College of Surgeons, London	1
4 March	ITMA Talk in Leeds	St Philips Chambers, Leeds	1
18 March	ITMA Spring Drinks Reception Part of the ITMA Spring Conference	Venue TBC	
18-20 March	ITMA Spring Conference	One Whitehall Place, London	
19 March	ITMA Gala Dinner Part of the ITMA Spring Conference	Venue TBC	
25 March	ITMA Benevolent Fund AGM ITMA AGM & Open Meeting	Charles Russell Speechlys LLP, London	
28 April	ITMA London Evening Meeting*	Royal College of Surgeons, London	1
19 May	ITMA London Evening Meeting* "Colour Issues", Simon Malynicz, Three New Square	Royal College of Surgeons, London	1
16 June	ITMA London Evening Meeting*	Royal College of Surgeons, London	1



Bristol will host one of our first events of 2015, at which we welcome the IPO

*Kindly sponsored by





I work as... a founding (in 1961) Senior and Managing Partner of the Law Offices of Dr Christos A Theodoulou.

Before this role... I was an Officer in the UN in New York, and an Assistant Professor of Political Science at Panteion University in Athens. I sat on the Executive Committee of AIPPI for many years, was a member of the ECTA Council for nine years, and have been a member of the Council and the Board of the Institute of Professional Representatives before the European Patent Office (EPI) since 1998. I am also the oldest, I believe, Overseas Member of ITMA for Cyprus (since 1985) and a member of CIPA. I have written books and articles on law, IP, history and international relations (in Greek, English and French), and write regularly for Cypriot newspapers.

My current state of mind is... always alert and open to discoveries.

I became interested in IP when... a friend who was in IP suggested that because of my cosmopolitan background, and knowledge of languages and international studies, the sector would suit me. He was right.

I am most inspired by... people for whom honesty and adherence to principles is a way of life.

In my role, I most enjoy... meeting with people from all over the world.

In my role, I most dislike... dishonest and cunning people.



Long-standing Overseas Member Dr Christos A Theodoulou sends greetings from Cyprus

On my desk are... files, and all kinds of magazines. I also have a baby picture of my grandson, Christos. I usually cannot find what I am looking for on my desk, which is when my secretary comes to my aid.

My favourite mugs... come from places I have visited; for example, the Philippines, Crete and Rothenburg ob der Tauber in Germany.

My favourite place to visit on business is... Paris, where I like having lunch in one of the bistros around the Europe Metro station. Also London, where I enjoy lunch at

the Old Hall at Lincoln's Inn, and finally Munich, where I meet friends in the canteen of EPO.

If I were a brand, I would be... McDonald's or Unilever, which have been clients for years.

The biggest challenge for IP is... to be enforced in all countries.

The talent I wish I had is... to be able to draw better. When I attended school in Cyprus, I was not awarded the prize for overall performance because I had a grade of 5/10 for drawing.

I can't live without... working, reading and long walks.

My ideal day would include... not many troubles from my work.

In my pocket are... money for daily expenses, credit cards, my identity card, a handkerchief and my car key.

The best piece of advice I've been given is... from my father: to be honest and independent.

When I want to relax I... go for a long walk.

In the next five years, I hope to... be healthy, working and travelling.

The best thing about being an ITMA member is... meeting interesting people from all over the world.

If you'd like to appear in TM20, contact caitlin@thinkpublishing.co.uk

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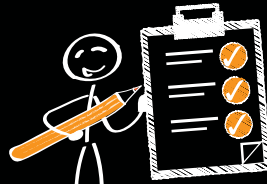
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kevin.bartle@dawnellmore.co.uk
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daniel.john@dawnellmore.co.uk

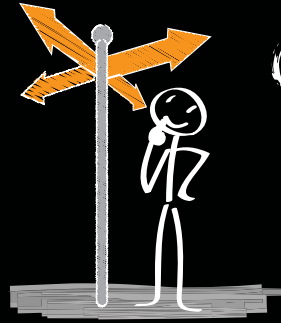


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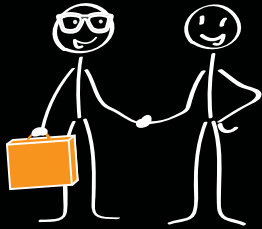


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