

# ITMA review

The Journal of The Institute of Trade Mark Attorneys

Issue no. 382 January/February 2011



## General Court sees red at Deutsche Bahn's colour mark application

Similar words can negate clear visual differences between wine marks

Naturally Active refusal upheld by General Court

Inveresk's breaches of quality standard licensing obligations cost it dear...

Freedom is priceless, but General Court rules out Free mark



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## ITMA Review copy deadlines

Contributions to the *Review* must be received by the 12th of the month for publication in the following month's issue, including whenever possible high-resolution images of authors and relevant graphics. These are best sent as separate files rather than embedded in Word documents. Illustrations or photos often add interest and aid understanding of the issues covered in articles. Please email material to Kelly Robson, Editor, at [kellyrobson@btinternet.com](mailto:kellyrobson@btinternet.com) and Tania Clark at [tclark@withersrogers.com](mailto:tclark@withersrogers.com)

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## ITMA website:

Web: [www.itma.org.uk](http://www.itma.org.uk)



# MEDIA WATCH

In December/January the Institute featured in two national newspapers, the *Times* and the *Telegraph*, as well as in five articles on the [realbusiness.co.uk](http://realbusiness.co.uk) website and in articles commissioned by the *World IP Review Digest* and *Connect* magazine, the bi-monthly newsletter covering six London boroughs.

*The Times* reference came courtesy of Joseph Letang of Dehns whose firm provided the answer to the Money section's Business Question on the use of acronyms. By suggesting ITMA members can help with such queries and by pointing them to our website, Joseph did us a great favour while enhancing his own professionalism by highlighting the fact that he is a member. The *Telegraph* piece featured in a supplement on Business Innovations which also had contributions from the IPO and CIPA. Excellent free "advertising" for those readers who didn't dismiss the supplement along with those other sections that rarely get read!

Of other stories featuring in the media over the festive period, the *Scotsman* reported that the design of Lindt's chocolate bunnies were deemed not to be distinctive by the 'General Court of the European Union'. The *London Evening Standard* reported that Kerstin Rodgers (aka Mrs Marmite Lover!) was challenging London Underground's claims that her pop-up restaurant called "The Underground Restaurant" was infringing TFL's brands. I must be getting old when I have no idea what a pop-up restaurant is or how a restaurant can be run from a Kilburn flat!

On the sporting front we had two stories of note. *The Liverpool Echo* reported that Everton Football Club have applied to register the club's iconic shield and motto "NIL SATIS NISI OPTIMUM" as a CTM, having missed

## OHIM email “alert” system replaces CTM publication letter

From 1 February 2011, OHIM will be stopping the current practice of sending a letter (L124) to applicants or their representatives to inform them about the publication of a CTM application in part A of the CTM Bulletin.

This change follows the successful introduction of CTM Watch email alerts, available in CTM E-Filing, which now provide a quicker and more powerful solution for users wishing to know when their CTMA is published.

The email alert feature requires logging into MyPage and is therefore only available to users of the password-protected platform making it easier to do business with OHIM.

For detailed information on how to set up an alert, visit <http://oami.europa.eu/ows/rw/pages/CTM/FAQ/CTM13.en.do#2400>

out on claiming the Manager David Moyes’ phrase “The People’s Club” to a local market trader. I didn’t realise Evertonians were such classicists. Moving on to Rugby Union, *Rugby World* reported that the traditional version of the All Black’s Haka – the Ka Mate version – was to be registered by the Ngati Toa Iwi, the chief of whom first performed the dance after a Tuwharetoa woman saved his life. Apparently, the Iwi don’t like the idea of people using it inappropriately, such as on tea towels. Well I for one am not going to cross them!

As it was the festive season I relate the story from the *Scotsman*, which reports on a further success for the Scotch Whisky Association in having

Scotch Whisky protected in Panama, apparently its 20th largest export market.

Finally, in addition to the articles referred to above, we issued two press releases in the last two months. One reported the Advocate General’s Opinion on L’Oreal v eBay and the second announced our new sponsorship deal with Corsearch, which will be sponsoring all of our Evening Meetings in 2011. This is excellent news and helps us to keep costs down whilst enabling us to develop a relationship with one of the key players in trade mark support services.

**Ken Storey**  
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**The *London Evening Standard* reported that Kerstin Rodgers (aka Mrs Marmite Lover!) was challenging London Underground’s claims that her pop-up restaurant called “The Underground Restaurant” was infringing TFL’s brands. I must be getting old when I have no idea what a pop-up restaurant is or how a restaurant can be run from a Kilburn flat!**

### IP Benefits Plus

## Member benefits

As we enter 2011, IP Benefits Plus has negotiated a selection of money-saving discounts designed to support you both personally and professionally.

One of those benefits is Member Energy, which is a free price comparison service designed to find the cheapest gas and electricity suppliers in your area. Average member savings are currently £247.16\* so it’s definitely worth a couple of minutes of your time.

For further information and to discover all the benefits available to ITMA members at IP Benefits Plus, visit [www.itma.org.uk/about/join\\_us/benefits](http://www.itma.org.uk/about/join_us/benefits)

\*Terms and conditions apply. See website for full details. Not available in Northern Ireland.

These benefits are managed on behalf of ITMA by Parliament Hill Ltd of 127 Cheapside, London, EC2V 6BT.



Tania Clark (Withers & Rogers) and Tom Scourfield (CMC Cameron McKenna)



John Caisley (Grant Spencer), Maggie Ramage (Alexander Ramage) and Stewart Rayment (Lockhart Hastings)



Alex Bowtell and Henrietta Marsh (CMS Cameron McKenna) and Colin Maher (Novartis, Camberley)

# ITMA 2010 CHRISTMAS LUNCH

14 December, The Lancaster, London. Pictures by Stewart Rayment, Lockhart Hastings.



John Noble (British Brands Group), Emma Stopford, Mireille Giesen Ondin, Sophie Bodet, Jo Grist (all GlaxoSmithKline) and Imogen Wiseman (Cleveland)



**Guy Tritton (Hogarth Chambers) and Nikki Powell (Edwin Coe)**



**Puravee Shah (Murgitroyd), Rita Khaitan (GlaxoSmithKline) and Vicki Bennett (Saunders & Dolleymore, St Albans)**



**Catherine Barbour (Rouse), Mark Bearfoot (Coca-Cola) and Taryn Byrne (Page White & Farrer)**



**Chris Morris and Andrew Tibber (Burgess Salmon)**



**Emma Tuck (Browne Jackson, Birmingham), Peter Guzhar (Carson McDowell, Belfast), Declan Cushley and Sara McNeill (Browne Jackson, Birmingham), Gayle Hodt (GlaxoSmithKline) and Mark Daniels (Browne Jackson, Birmingham)**

# Interview with HH Judge Colin Birss QC

By Tania Clark



Tania Clark



Colin Birss QC

**The procedure for filing claims at the PCC is unwieldy since it involves filing the claim (and paying the fee) at Park Crescent and then the documents are sent to St Dunstons House: is it anticipated that this will change in future?**

Yes, indeed. We are conscious of the fact that it is not very convenient, particularly since patent and trade mark firms do not necessarily have clerks within their departments to do this on their behalf. Therefore we anticipate moving the procedure to the Chancery Registry at the Royal Courts of Justice within the next few months.

**Costs have been capped at £50k, which enables the claimant and defendant to know in advance the maximum liability. Are the set standard levels of costs capped and to what extent is there any discretion?**

There are set standards of costs including, eg:

Settling particulars of claim/defence/reply to defence	£ 6,125
Drafting Witness Statements	£ 5,000
Experts	£ 7,500
Inspection of performance of experiments	£ 2,500
Attending trial	£15,000

These are cumulative and the

amounts set out in the CPR are the maximum amounts for each stage, and therefore if the case settles before going to trial, the work carried out to date will need to be considered when deciding on the costs to be awarded.

**What happens if an infringement action is brought and subsequently an invalidity action, and the claimant is resistant to the two actions being consolidated to enable them to benefit from £50,000 per trial?**

If it makes sense for the two actions to be consolidated then I will do so. Attempts to work round the system of the £50,000 cap will be scrutinised carefully and will not be permitted if they are inappropriate.

**Has the cap of damages of £500k been set? And to what extent would this be discretionary?**

This matter is under consultation. The parties could agree a waiver.

**Should the Statements of Case be examined in greater detail from the very outset as in the Registry, which regularly requests that parties provide more details if a ground has been insufficiently pleaded in the Statement: could the same approach be taken at the PCC?**

We do not have the resources to carry out a procedure in which Statements of Case are examined and

commented upon before the other party responds to them and before a CMC. I was not fully aware of this being done at the Registry. It is unlikely that we could implement this in the near future, although it may be something that we could revisit.

**Statements of Truth now need to be signed by the relevant parties and you refer to this in your CMC in Vivienne Westwood (Dame Vivienne Westwood OBE v Anthony Edward Knight, see p.8 for case report). Is this with a view to individuals being held in contempt of court or an order being made for cross examination of the relevant individual?**

This is about Statements of Truth verifying the Statement of Case. I did refer to a Statement of Truth in the CMC in that case since it had been signed by the attorney who did not have full knowledge of the facts. That is permitted for High Court cases, but in the rules applicable to the PCC the Statements of Truth must be signed by the relevant individuals and you need to identify who is signing for what particular part. Witness statements always have a Statement of Truth from the witness concerned.

**The CMC appears to be particularly pivotal and the occasion when parties can request orders for disclosure of documents, fact evidence, expert evidence, experiments, written submissions and cross examinations; effectively**

**it is like a mini trial, although you are not deciding the trial at that stage?**

CMCs are an in-depth review but they are not a mini trial. I am not deciding the matter but seeing what needs to be done to bring it to trial. In the Vivienne Westwood CMC I made orders for skeleton arguments to be filed for reasons set out in the judgment. I also made an order giving permission for evidence be filed in relation to certain points, but decided that further evidence did not need to be filed on other points.

**Surely once the arguments have been fleshed out, the defendant may then ask for a further order to request disclosure of documents? Is the onus not on the claimant to file adequate pleadings at the outset prior to the CMC?**

Indeed it is, but the onus to file adequate pleadings applies to both sides. An application to submit material over and above what was ordered at the CMC is possible but will only be considered in exceptional circumstances.

**Is a chronology useful with the skeleton arguments and are skeleton arguments produced prior to the CMC or to the actual trial itself?**

Chronologies are usually helpful. In most trials it is useful to have skeleton arguments and these are produced prior to the trial. In the Vivienne Westwood CMC, provision was made for skeleton arguments.

**To what extent have these changes to the PCC been influenced by other European jurisdictions, including the EPO in Munich, and pleadings in the Netherlands where a trial on the pleadings is carried out?**

These changes have undoubtedly been influenced by other European jurisdictions and by proceedings before the EPO.

**In a transfer of proceedings to the High Court (or indeed vice versa) the main criterion is whether the party to the litigation can only afford to bring or defend the claim in the new low-cost PCC. To what extent is it dependent on the**

**parties being an SME or a private individual? I refer you to your decision in the ALK - Abello v Meridian Medical Technology case.**

I dealt with the criteria for transfer in the judgment in that case. It also deals with the matter of parties being SMEs and the value of the claim.

**The impression given in that patent decision was that the parties felt that they would be better served by having the trial in the High Court rather than the Patents County Court. To what extent do you think this was influenced by the name of the court being a County Court, and perhaps we should consider renaming the PCC to drop the word 'County' and have a separate and distinct IP court in its own right?**

This is an interesting question since, in the Commercial Court (which is part of the High Court), there is the Mercantile Court for smaller cases, rather similar in some ways to the PCC but the word 'County' does not appear in its title. The Mercantile Court was a county court at one time but no longer one. It is early days, but perhaps we could revisit this in the future.

**The time limit for trials is two days. To what extent is there any discretion if you overrun, or are you confident that as a result of the CMC it will be kept to that time limit?**

There a discretion, but I will be careful to keep everybody to their respective timetable and will clearly state how many hours I have allowed each party for any particular evidence or arguments.

**It must be difficult to set a time limit when expert evidence is required, so perhaps the PCC will be more suitable for trade mark and design trials rather than patent trials?**

It may be difficult when experts are called since the cross examination can take longer but, again, it is a management issue. I am confident that if times have been set, then the cases will run to time.

**Would it therefore be more advisable to have a single joint expert rather than two experts?**

Single joint experts are not particularly liked by litigants. I would not impose something like that on the parties unless it was appropriate.

**In the CMC in Vivienne Westwood, you set the one-day trial date six months from the CMC and stated the date on which you would hand down judgment (two weeks after the trial). Is this standard procedure?**

Yes. We checked the court's diary and I was confident that the judgment could be produced in that time frame, but obviously it would depend on the circumstances and the time of year. I expect parties to come before me at the CMC with available dates for the trial. Hopefully the trial date will not be more than about six months from the CMC.

**Is it likely that there will be more judges in the PCC in the future?**

The scheme has always allowed for multiple PCCs if wanted and therefore if it was felt appropriate there could be PCCs in other cities, such as Leeds, Manchester, Birmingham, etc. Likewise, there is no reason in principle why one could not have other judges in the PCC. We already do have a Deputy Judge (Michael Fysh), there are IP practitioners who are Records and can sit as deputy judges in the PCC and the High Court IP judges can also act as judges in the PCC.

**To what extent can evidence be filed electronically?**

We have the facilities to receive things by email so long as they can be emailed to my clerk.

**You are keen to encourage trade mark/design/patent litigators to appear before you at the PCC. Are there any particular weaknesses in advocacy skills or the like and any ways in which we can improve?**

I cannot think of any particular weaknesses. It is important for you to gain more experience and confidence and that only comes from becoming familiar with the court and its procedures.

*Tania Clark, Withers and Rogers, tclark@withersrogers.com*

# First Case Management Conference under the new Patent County Court rules

**Dame Vivienne Westwood OBE v Anthony Edward Knight. Patents County Court (HH Judge Birss QC).** Since 1 October 2010, the Patents County Court (PCC) has been operating under a new regime following changes to its rules of procedure. All cases commenced after this date are governed by these new rules, which are primarily focused on costs and case management. Their aim is to speed up and reduce the amount of money spent litigating straightforward intellectual property cases. The Westwood v Knight case discussed below is the first to come before the PCC at the case management stage under these new rules. **Adrian Howes** reports.

It is easily forgotten, no thanks to its name, that the PCC is able to hear cases relating to intellectual property rights other than just patents, so cases relating to copyright, designs and trade marks may be brought before it. Indeed the PCC is due to have its name changed to the "Intellectual Property County Court" to reflect this.

Though this aspect of the proposed changes (in the Intellectual Property Court Users' Committee report on the PPC in July 2009) has yet to take effect, there have been changes to the Civil Procedural Rules (CPR) (see new CPR rules 63.17 to 63.26). These changes include putting a cap on costs of £50,000 on the liability stage of the proceedings and a further £25,000 on any damages enquiry. The cap is cumulative to these totals depending on what stage the case is at. Therefore, in cases which settle before the end of the trial, the party seeking costs will not be able to claim this full amount.

The other significant change includes front-loading the case by requiring parties to set out concisely all their arguments and evidence in their initial pleadings, the idea being that by the Case Management Conference (CMC) the court has a good grasp of the case and may make specific and limited directions on a cost/benefit basis. The PCC is therefore required only to make orders in respect of disclosure, witness statements, expert reports, cross-examination at trial and skeleton arguments in relation to "specific and identified issues" (CPR Rule 63 PD para 29). The hope is that this will lead to cheaper and quicker proceedings. However, it is recognised that the cost/time effectiveness of these rule changes

will only assist if the PCC and the parties involved are able to find the correct balance. They need to ensure that adequate detail is put in each party's statement of case, thereby reducing the directions that may need to be given by the court. At the same time they need to ensure there is neither too much front-loading, with parties producing excessive pleadings, nor the court giving costly directions in relation to evidence and arguments that are more typical of the High Court. A final point worth noting is that the rules also require the initial pleading to be signed off with a statement of truth by any person with knowledge of the facts alleged. This may be more than one individual if more than one person has knowledge of the facts contained therein.

The Westwood case, the first to test these new rules at the CMC stage, took place before the new PCC judge Judge Birss on 22 October 2010 between the famous fashion designer Dame Westwood and a Mr Knight, a seller of goods on the internet. This case was transferred by the High Court to the PCC by an order dated 1 October 2010. On the judgment of Judge Birss this case therefore fell within the new regime. It should be noted at the outset that although Dame Westwood had instructed solicitors and counsel to act on her behalf, Mr Knight was a litigant in person, and due to his unavailability did not attend the CMC. Accordingly, submissions were only made on behalf of Dame Westwood.

A consequence of the transfer of this case to the PCC was that the claimant's pleadings (though not the defendant's on the judge's view) were

in a form typical of pleadings before the High Court. As such they only dealt with allegations and matters of fact rather than argument. Additionally, the statement of truth was signed by the claimant's solicitors rather than those with knowledge of the facts.

The issues raised in the pleadings are not of particular relevance other than they included issues of infringement of copyright and trade marks, a claim of passing-off and the use of a number of domain names by the defendant. The defendant's defence included assertions that certain devices claimed to be infringed were not original works of the claimant (although not in those words).

The judge first considered the adequacy of the pleadings under the new rules. He determined that Mr Knight's pleadings were adequate as they covered the issues so far as they needed to be and the statement of truth had been signed by him. However, he believed the claimant's pleadings required amending under the new rules in three respects. The first was to include a reference to complying with the pre-action protocol as now required in both PCC and High Court pleadings. The second was that the statement of truth required signing by parties knowledgeable of the facts stated therein. As an aside he noted that if a party's solicitors were knowledgeable of certain facts contained in the pleadings they should also sign them. He also added that if more than one person was signing the pleadings they should refer to the sections that they were making the statement of truth in respect of.



The third amendment required by the PCC was more substantive. The judge believed that although the claimant's pleadings had sufficiently stated the details of five of six devices, the claimant had failed to plead sufficiently the details of one device (see below) so required the claimant to amend her pleadings to include details of this device.

Following considerations of the pleadings, the court went on to consider whether any further evidence was required in the proceedings, in addition to that contained in the pleadings. The judge, having noted the changes to the rules, stated:

"It seems to me that one important consequence of the provisions is that, subject to proper safeguards, some relevant evidence will be excluded from trials. Merely because some evidence is relevant will not necessarily justify permission being given to adduce it. On the other hand the parties need to know that the court will give permission for evidence to be filed in a proper case since otherwise there will be a temptation to overload the statement of case with unnecessary material."

A number of requests to produce further evidence were made by the claimant. One request, for example, was for an order that the claimant be allowed to give further evidence on the use of various brands by the claimant, which the defendant had challenged. The court ordered this. The judge in conducting a cost-benefit analysis believed that providing this evidence would be useful. In doing so he also noted that although no evidence was provided by the claimant's solicitor on costs, it may be useful to do so in some cases, though he acknowledged that this was not such a case. This cost-benefit approach was applied to other requests made by the claimant.

For example, the judge also considered whether the claimant should provide further evidence in support of the plea "the claimant is a very well known fashion designer who is known throughout the world, including the United Kingdom". He noted that it was common, particularly in passing-off cases, to produce extensive costly evidence on

this type of issue, even when not really challenged by the defendant and to no real benefit. Accordingly, he agreed with the claimant that it should not have to provide evidence on this.

One particular issue on evidence that arose of relevance to trade mark cases generally was the use of survey evidence and the like to show confusion. The judge, noting this issue, felt that such evidence was complex and costly, and in this case would plainly fail the cost-benefit test – the suggestion being that this would be so in the majority of trade mark and passing off cases. He did, however, allow the claimant to put in evidence from eBay's website suggesting that customers were buying goods from the defendant in the mistaken belief that they were the claimants. Although he recognised that this type of evidence might not be relevant he believed that in this case it would not be costly to produce and might be useful.

In addition to allowing some of the claimant's requests to provide further evidence, the judge, unusually of his own accord, also ordered that the claimant be allowed to provide evidence on one of six devices that the claim related to which the defendant had challenged on the basis of its originality, and hence its subsistence and ownership by the claimant. He realised that it was not normal practice for a judge to make an order in respect of evidence not requested by the parties, but noted he was not requiring the claimant to produce such evidence and that this was clearly a point of contention.

Having considered these various issues of evidence, Judge Birss went on to determine whether any orders should be made regarding disclosure, expert evidence and cross-examination at the hearing. As the claimant had made no submissions regarding these, the judge did not order them. However, he did order that skeleton arguments may be filed. He made this order as the pleadings, being in the form of High Court pleadings, did not contain the parties' arguments.

In doing so he noted that in the 1990s costly statements of case were produced, which the new rules are

intended to avoid, and that the purpose of fuller pleadings under the new rules was to assist the court with appropriate directions at the CMC stage. He stated:

"At the pleading stage it may well be unnecessary to do more than state concisely what the argument is rather than take up space setting it out in elaborate detail. The court is unlikely to need arguments to be addressed in depth for the CMC and permission can always be given (if appropriate as here) for skeleton argument before trial."

As an aside and on the topic of skeleton arguments, it is worth noting that during the CMC the claimant had only submitted a witness statement, and did not provide a skeleton argument as is typical before the High Court. The judge believed this approach to be helpful.

In summary, it is clear that Judge Birss is determined (and rightly so) to allow only additional evidence and arguments which are likely to be of some use and not costly to produce. He has also shown, at least in this case, that he is prepared actively to manage the case on the basis of both submissions made by the parties and to some extent of his own accord. In doing so he also unusually gave a one-day trial date just six months from the date of the CMC, and even more unusually stated a date on which he would hand down judgment, only two weeks after the trial.

If Judge Birss is able to keep this momentum up and finds the right balance between directions and front-loading of the case, thereby keeping costs down, there is every chance the PCC under the new rules will be a success. The danger of course is of falling into the trap which caused the PCC to fail in the 1990s, where parties, under rules intended to streamline the PCC, caused massive front-loading of cases with excessively substantial pleadings being produced. Judge Birss clearly recognises this concern and with hope and historical hindsight will be able to avoid this trap.

**Adrian Howes**, Bird & Bird LLP,  
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Martin Delafaille

# PCC: calculating damages for TM infringement

**National Guild of Removers & Storers Ltd v Silveria (t/a C S Movers) [2010] EWPC 15 (12 Nov 2010), Patents County Court (His Honour Judge Birss QC), 12 November 2010.** The Patents County Court has for the first time considered whether damages calculated on a “user” basis (a measure usually used in patent and copyright cases) are available in trade mark infringement claims. As illustrated by the level of damages awarded, damages calculated on this basis can be substantial. Importantly, the decision also affirms the jurisdiction of the Patents County Court to preside over trade mark infringement and passing off disputes, which should encourage trade mark owners to use this relatively inexpensive forum for lower value or less complex disputes. **Martin Delafaille** reports.

## Background

Under the English legal system, following a successful trial on liability, a trade mark proprietor is entitled to elect between damages and an account of profits. If the proprietor can show that the infringer’s actions have led to lost sales by the trade mark owner, or (on an account of profits) that the infringer has made a profit attributable to the infringing use, then damages are awarded on that basis.

The position, though, is not straightforward if the trade mark owner has not lost any sales, and the infringer has not made any profits that can be attributed to the infringement. In these circumstances, is the trade mark owner entitled to any financial remedy, at all? This was the question dealt with by the Patents County Court and its new judge, HH Judge Birss QC, in *National Guild of Removers & Storers v Silveria*.

## The parties

The National Guild of Removers & Storers is a trade association which represents individuals and companies involved in removals and storage. It has a regulatory and supervisory role over its members. The Guild owns a number of registered trade marks, which members are licensed to use in their advertising and directory entries. In 2003 *Which?* Magazine rated the guild as joint top of the trade associations they surveyed.

The four (separate) defendants were either former members of the Guild, or (in one case) had never been a member. Each used one or more of the Guild’s trade marks in advertisements, websites and/or directory entries. The Guild sued each of the four, and obtained judgment in default against each. The court agreed to hear the inquiry as to damages in respect of each defendant in a single hearing, in which none of the defendants participated.

## Were damages recoverable?

Judge Birss noted that the defendants’ activities had not caused any loss to the Guild. The only basis on which the Guild could recover damages, therefore, was on the so-called “user” basis, whereby a reasonable royalty is awarded for the unlawful use of the Guild’s marks. Although the user principle has been applied in patent infringement cases for many years (see *General Tire v Firestone* [1976] RPC 197, HL) and more recently in copyright and passing off cases (for example *Blayney v Clogau St Davids Gold Mines* [2003] FSR 35 and *Irvine v Talksport* [2003] FSR 35) there has, until now, been some doubt as to whether damages awarded on this basis are applicable to trade mark infringement claims.

In the previous High Court decision of *Dormueil Freres v Feraglow* [1990] RPC 449, Knox J was unwilling to award an interim payment on this

basis in a case of trade mark infringement. Whilst accepting that Knox J did not decide that such damages were not available at all (he simply refused them on an application for an interim payment), the authors of *Kerly’s Law of Trade Marks and Trade Names* (14th Edition, paragraph 19-133) cited Knox J’s decision to support the proposition that it was doubted that the user principle is applicable to trade marks.

Judge Birss held that there is no reason in principle why damages, calculated on the “user” basis, should not be available to trade mark owners, as they are in patent, copyright and passing off cases.

## How are damages on the “user” basis to be assessed?

The judge did not, in this case, explore the factors that the court should assess in determining an appropriate award of damages. He instead noted the general proposition that “it will be a question of fact in any given case to decide the amount of such damages.”

In assessing the level of damages payable, the judge was guided by the Guild’s membership rules which provide post-termination obligations in the event that a member leaves the guild. Although the rules oblige the departing member to delete the Guild’s name and logos from stationery, at the same time they recognise the practical problem that

may arise when a departing member has already placed advertisements in the likes of the Yellow Pages. In these circumstances, the departing member is permitted to continue using advertisements published using the Guild's marks for a significant period afterwards, subject to the departing member paying a weekly licence fee of £100 per week for advertisements appearing in public directories. That fee would be payable until the advertisement(s) expire. The rules also provide that any former member continuing to use the guild's name or logos after the period of any such advertisement shall be liable to a penalty fee of £200 per week until the use ceases.

The judge in this case held that the higher rate was an appropriate royalty rate, even for the defendant who had never been a member of the Guild. In the judge's mind, the higher rate was a fair assessment of what was "unauthorised use". Applying this rate to the periods of the defendants' use, the judge ordered damages in excess of £75,000 against the four defendants.

### Conclusion

This is a significant decision for three reasons:

1. It affirms the Patents County Court's jurisdiction to decide trade mark infringement and passing off claims.
2. It is the first time that damages have been awarded on the "user" basis in trade mark infringement proceedings.
3. Although HHJ Birss QC indicated that each case will be decided on its own facts, that a relatively high level of damages was awarded in this case illustrates that damages calculated on the "user" basis can be substantial.

Nevertheless, this is a Patents County Court judgment and is not binding on the High Court. We will need to see whether the High Court supports the conclusions of Judge Birss. We consider it likely that it will.

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Even quite experienced lawyers not used to the area of dispute resolution can easily muddle up the various different forms of alternative dispute resolution, or ADR. However, ADR may no longer be an appropriate umbrella term for what is actually non-court based or private dispute resolution. Private dispute resolution, or PDR, might therefore be the best way to describe this range of techniques. **Michael Cover** reports.



Michael Cover

## The positives, perils and pitfalls of IP mediation

The first of these, arbitration, has been with us for centuries and, in this jurisdiction, its origins can be traced right back to the 17th century. Arbitration has the benefit of an adjudication of a dispute, albeit a private one, with excellent international cross-border enforceability of the decision, that is the 'award', which is in fact far better than that for court judgments.

Adjudication is a variation, which obtains a contractually-binding decision, without some of the advantages of arbitration.

As we will see, mediation is a voluntary process, whereby a neutral, the mediator, assists the parties to find their own solutions to their disputes and differences.

### Common characteristics

Common characteristics of all forms of PDR include:

- One or more neutrals is chosen by the parties (or at least significant party influence over their selection) and paid for by the parties.
- Institutions may have a role in administering the arbitration or mediation, for example WIPO, ICC, LCIA, INTA and various other sets

of chambers and panels of neutrals.

- The process is confidential, or at least private.
- It is generally (although not always) cheaper.

### Mediation

As we have seen, mediation is a generally voluntary process, which only leads to a binding agreement when the parties have signed the resulting settlement agreement. In the real world, the settlement rate is probably around 65%, comprising disputes which settle on the day of the mediation or shortly afterwards. Mediation is a flexible process which enables the needs, concerns and interests of the parties to be explored, not just their legal positions.

Outcomes can be agreed which no court could order, including doing business on favourable terms in the future. The main business relevance is to be able to resolve disputes, but at the same time to preserve business relationships, for example in the case of a long-term IP licence.

The process typically comprises joint and private sessions between the mediator and the parties and a form of what might be called shuttle

**Mediation has to be entered into by agreement and that either means a mediation clause in, for example, an IP licence or a specific mediation-submission agreement. An example dispute resolution clause providing for mediation and then arbitration is set out at the end of this article.**

diplomacy. In all, it is not a soft option, as, like yoga, it requires much stretching and some pain.

There are probably around 6,000 civil and commercial mediations per year in the UK (see the 4th CEDR Mediation Audit, published in May 2010). There is still a long way to go, even with the gentle growth in numbers of mediations currently being experienced.

### **How do you get to mediation?**

Mediation has to be entered into by agreement and that either means a mediation clause in, for example, an IP licence or a specific mediation-submission agreement. An example dispute resolution clause providing for mediation and then arbitration is set out at the end of this article.

The courts provide what might be called encouragement. They have powers to punish in costs a successful party that unreasonably refuses to mediate, even if that party has been successful in the litigation. This is assisted by what are called 'Ungley Orders', named after the High Court Master Ungley who devised it. This provides that the parties are to consider ADR (effectively mediation) and then are to report to the court if they consider the case unsuitable for mediation in an affidavit or witness statement on a without prejudice save as to costs basis, so that this can be taken into account when the court comes to look at the question of costs.

This probably means that, at least in proceedings in the English High Court, it is always best to give serious consideration to mediation and probably to go through with it. You may not settle but you will almost certainly learn useful information about your opponent's position and concerns.

### **Preparation for mediation**

This is a key feature and, as mediators, we see all kinds of preparation, from the excellent to the shoddy! Excellent preparation will almost always stand you in good stead and begin to get the mediator working with you and engaged.

Topics to address include:

- Mediator selection: do you go for an IP specialist or a generalist? Is

this yet a piece of litigation (perhaps it is a difference over an IP licence)? It could be said that a strong case would see you favouring a specialist, whereas a less strong case might see you favouring a generalist. Whichever kind of mediator you want, do not be afraid of interviewing the potential mediator(s) and even obtaining references.

- There are plenty of mediation institutions and panels and chambers to look at. Some of these have already been mentioned; for example, the writer is a full member of In Place of Strife, the Mediation Chambers.
- Work on the venue and dates. Your own office may offer some home advantage and appeal to the other side as being free.
- Once the mediator has been agreed and appointed, engage with him and begin to get the mediator working for you. A confidential to the mediator briefing paper, in addition to the usual position paper will usually be effective.
- Try to make sure that you have the necessary decision makers there or readily available.
- Who is to be on your team? Do you take the trade mark attorneys and the lawyers; do you take counsel or even your expert? Keep the team tight but perhaps have a wider range of individuals on standby.

### **Opening statements in mediation**

The opening statement at the mediation is your opportunity to tell your story and, at the same time, to focus forward and look beyond the dispute or difference in hand. Identify the issues and begin to suggest options for dealing with them. Consider making an initial offer or small concession to anchor the negotiation but do so on a principled basis, so I am making this offer/concession, as the case may be, because... Stay courteous but do not be afraid of showing emotion; this is your opportunity to show the other side and their advisers how strongly you feel about the dispute or differences.

### **Zones of possible agreement**

Work what your zones of possible

agreement are and think about the same for the other side. This will enable you to frame effective offers and to avoid the 'insult zone', that is, an offer which is ludicrously high or low and which will set you back rather than move you forward. Principled bargaining has already been mentioned and this is the way generally to start. However, there is always a degree of horse trading at the end, so think about how you move seamlessly into what may be a quite fast-moving series of offer and counter-offer.

### Breaking the deadlock

Any mediation will hit the wall at some point and encounter an intractable problem. The mediator should be working to deal with such deadlock, but think about your won solutions and put them forward. These might include varying the people that are meeting, for example the principals without the lawyers. Consider options to add value, like a licence of relevant IP or doing business on favourable terms for the future.

When all is lost, look at final sealed offers, splitting the difference between two final offers. Above all, keep energy up and look for energy on the part of the mediator. If the mediator is not contributing and both parties are getting on well without him, consider sending him home.

### Mediation and the fit with IP

Mediation of IP disputes and differences is in some ways a perfect fit. Confidential resolution of disputes is attractive and the rights are of long term or even indefinite duration.

### Current trends in PDR

Various trends can be detected in the world of private dispute resolution. These could have the theme of hybrids.

Med-Arb is a hybrid blend of mediation and arbitration, with an arbitration delivering a definite outcome after an unsuccessful mediation. The neutral could be a different one for each phase or even the same one, subject to suitable disclaimers in the arbitration agreement, to deal with the fact that the neutral will have picked up confidential information in the private sessions in the mediation phase.

Within mediation itself, there is a convergence of techniques as between civil and commercial and family mediation, with family mediation beginning to use a hybrid model of mediation involving both meetings with both parties present and private sessions.

Dispute Boards are to some extent a mixture of much of what has been discussed in this article. There is the conciliation and even the dispute avoidance phase of mediation, followed by an adjudication. Dispute Boards are standing dispute resolution bodies that are set up to follow through major infrastructure projects, such as dams and tunnels that are funded by institutions such as the World Bank.

As to regulation, mediation in the UK is pretty much unregulated, although the EU Mediation Directive is to be implemented by next spring. How much longer this can continue is uncertain and perhaps it is too late to regulate mediators and we should be looking to regulate mediation itself, as is the case with arbitration. Maybe also mediation has an unexciting image, which is unjustified.

### Sample dispute resolution clause

'Any dispute or difference arising out of or in connection with this agreement shall be referred for resolution by mediation under the terms of the Model Mediation Agreement of the Chartered Institute of Arbitrators. The mediator shall be a Full Member of In Place of Strife, the Mediation Chambers. Should the dispute or difference not be resolved at mediation, such shall be referred to and finally resolved by arbitration by a sole arbitrator. In the event of the parties failing to agree the appointment of an arbitrator, the appointment shall be made by the President of the Chartered Institute of Arbitrators. The Seat of the arbitration shall be London, England and the law of the arbitration shall be that of England & Wales. The parties irrevocably agree to exclude and waive their right to appeal from the award of the arbitrator on a point of law.'

**Michael Cover**, Barrister, Accredited Mediator and Chartered Arbitrator, [mc@michaelcover.com](mailto:mc@michaelcover.com)

**Any mediation will hit the wall at some point and encounter an intractable problem. The mediator should be working to deal with such deadlock, but think about your won solutions and put them forward. These might include varying the people that are meeting, for example the principals without the lawyers. Consider options to add value, like a licence of relevant IP or doing business on favourable terms for the future.**



Emily Peters

# Finding the right balance – the problem of online copyright infringement

The creation and distribution of copyright protected content using the world wide web allows businesses to disseminate their copyright works, providing a global business model. The problems of online copyright enforcement are the same as those encountered in relation to all internet trade, namely identification of the infringing party and jurisdiction of the dispute. The UK courts are rapidly developing the law in this area; however, there is a fine balance to safeguarding the intellectual creation of business and individuals while avoiding expansion of the scope of protection. **Emily Peters** reports.

The way in which copyright proprietors enforce their rights is different in the online environment from traditional copyright enforcement strategies. Direct enforcement against primary infringers is often not economically viable or issues of jurisdiction arise, and as such rights owners are pursuing service providers in respect of joint tortfeasorship, authorising infringement or communication to the public while avoiding the need to pursue large numbers of end users.

## Scope of protection

A work is protected under the Copyright Designs and Patents Act 1988 (CDPA) where it is original – ie, the product of the author's skill and effort – and fulfils the qualification requirements. It is often straightforward to conclude that copyright may subsist in films or music but is more difficult to determine whether copyright subsists in respect of short works of a few words or a short sentence. It is a well-established principle that single words or commands do not constitute literary works (*Navitaire Inc v Easyjet Airline Company* (1) and *Bulletproof Inc* (2) [2004] EWHC 1725 (Ch), *Exxon Corp v Exxon Insurance Consultants International Ltd* [1982] RPC 69). However, copyright can subsist in a

headline as a free-standing original literary work provided sufficient skill and labour were involved in creating it (*The Newspaper Licensing Agency Ltd ("NLA") and others v Meltwater Holding BV* [2010] EWHC 3099 (Ch)). Whether a headline will be a copyright work will be a matter of fact depending on the effort involved in its creation. Where there was not sufficient skill and labour for a headline to be a copyright work in its own right, it could in some circumstances be protected by copyright as a substantial part of the article of which it forms a part. In either case the implications for online service providers are the same where reproduction of a headline as part of a link is held to be copyright infringement (*Meltwater*).

## Section 17 infringement

Copyright is infringed by reproducing the whole or a substantial part of a protected work in any material form including storing the work in any medium by electronic means (s16(3) and 17(2) CDPA). The CDPA must be interpreted in accordance with the Information Society Directive (Directive 2001/29/EC) (the Directive). Article 2 of the Directive requires that member states provide for the exclusive right to authorise or prohibit direct or indirect, temporary or permanent reproduction by any

means and in any form, in whole or in part, of relevant works. The qualitative test of whether a substantial part had been taken has been re-stated by *Infopaq International A/S v Daske Dagblades Forening* ([2009] All ER (D) 212) although in *Meltwater* Mrs Justice Proudman noted that the full implications of that decision have not yet been worked out and that a number of questions remain unanswered by the European Court of Justice.

*Meltwater* provided a tailored commercial media monitoring service called *Meltwater News* to its clients, setting out extracts from the published media featuring the search terms of interest to its clients. The extracts included the headline of the article, the opening text and a "hit extract" showing the context in which the search term appeared. Applying the *Infopaq* criteria, unlicensed end users receiving *Meltwater News* were held to infringe copyright. The hit extract (even an extract as short as 11 words) could constitute a substantial part provided it conveyed the originality of the article by communicating an element which is, in itself, an expression of the intellectual creation of the author. In receiving *Meltwater News*, a local copy of the headline and/or hit extract was made. Going further than this,

Proudman J held that a commercial end user would “more likely than not” infringe copyright by linking to an online article as again a local copy would be made on the end user’s computer.

The most widely publicised type of online copyright infringement is by peer to peer (P2P) file sharing, where users copy material onto their hard drive (infringement under s17 CDPA) and make copies available to third parties for downloading using a P2P network (infringement under s20 CDPA). Many rights owners regard enforcement against widespread infringement by end users who are often individuals as not cost effective or appropriate, and even where details of the subscriber can be obtained by reference to their IP address that does not identify the individual infringer.

### **Infringement by authorising**

Although rights owners can take direct action against end users for infringement under s17 CDPA, this cannot be used to enforce copyright against those ISPs who provide the mechanisms by which infringement can take place but do not copy content themselves. Section 97A CDPA provides that the court may grant an injunction against an ISP where that ISP has actual knowledge of another person using their service to infringe copyright. In *Twentieth Century Fox Film Corporation v Newzbin Ltd* ([2010] EWHC 608 (Ch)), Kitchin J granted an injunction under s97A CDPA against Newzbin, restraining it from including entries in its indices which identified unauthorised copies of the claimant’s films.

Newzbin provided a facility which was directed to film content and enabled its premium users to search for and fetch all Usenet messages which comprised a film. It also provided software (its NZB facility) to reassemble the individual files to save or view the films. Activation of the NZB facility in relation to a film protected by copyright would inevitably result in the production of an infringing copy. A copyright work is infringed under s16(2) CDPA by a person who without the licence of the copyright owner authorises another to do any of the acts restricted by copyright. Mere or

even knowing assistance or facilitation of primary infringement is not sufficient to amount to authorisation. It was held that Newzbin had authorised infringement by the premium users, having involved itself in the acts of identifying and downloading infringing copies so as to make the infringement its own. Newzbin was also a joint tortfeasor with its users having procured and engaged in a common design with its premium members to infringe the claimants’ copyright.

The fact that the claimants were unable to pinpoint specific acts of infringement which Newzbin had procured did not preclude a finding of liability. However, Kitchin J refused to grant a wider injunction restraining Newzbin from including entries identifying any material posted to or distributed through any Usenet group in infringement of copyright, as Newzbin did not have actual knowledge of other users using its service to infringe such rights.

### **Infringement by communication to the public**

Streaming content or offering it for download without consent is likely to infringe copyright in that content by communication to the public. Under s20(2) copyright is infringed where a copyright work is communicated to the public by electronic transmission. Such communication includes broadcasting the work or making it available by electronic transmission in such a way that members of the public could access it from a place and time they selected.

Communication to the public under s20 was interpreted broadly in two recent cases. In *Newzbin*, Kitchin J held that in providing the technology for its premium members to search for films and re-compile them, Newzbin had infringed copyright in those films by communication to the public. In the summary judgment application of *ITV Broadcasting Ltd and others v TV Catch Up Limited* ([2010] EWHC 3063 (Ch)), it was held that the methods of communication set out at s20(2) of the CDPA were a non-limiting list. TV Catch Up converted free-to-air broadcasts into signals enabling users to view live UK television on computers, iPhones and games

consoles. It was held that TV Catch Up’s transmissions were an infringement by communication to the public even though the transmissions were made on a one-to-one basis rather than a broadcast and could not be accessed at a time chosen by its members. This is significant as those responsible for streaming content over the internet where no files are transferred can be held liable for the transmission of unauthorised content on this basis.

### **Exceptions to infringement under the CDPA**

The decisions in respect of s17 infringement, in particular the *Meltwater* decision, may have far-reaching consequences for commercial end users. In addition, it was held that commercial end users would not have a defence to infringement under either the s28A or s30 exceptions. Temporary copying under s28A is solely concerned with incidental and intermediate copying with the consent of the copyright proprietor. The receipt (and copying) of *Meltwater News* by the end user was not generation of a temporary copy for the purposes of a technological process and the making of the copy had independent economic significance as end users paid for the *Meltwater News* service. Receipt of *Meltwater News* was not fair dealing as the end user does not apply his critical faculties to the work (s30(1) CDPA), there was no public reporting of a recent newsworthy event (s30(2) CDPA) and merely providing a link to the original article did not provide a sufficient acknowledgment of the author (s30(2) CDPA).

### **Jurisdiction**

Issues of jurisdiction concerning online enforcement can be complicated and were considered recently in respect of copyright and database infringement in *Football Dataco Ltd and others v Sportradar GmbH and others* ([2010] EWHC 2911 (Ch)). The defendants were Swiss and German companies which provided access to sports data on web servers located in Germany and Austria to customers located around the world (including in the UK). The UK court could not accept jurisdiction in relation to infringement by communication or making

available to the public under s20(1)(a) CDPA or reutilisation under paragraph 12 of the Copyright and Rights in Databases Regulations 1997, as the defendants' servers were based outside the UK. The court adopted the emission theory applied to broadcasts and held that the act of making available to the public by online transmission is committed only where the transmission takes place even where data on a server in one state is accessible by the public of another state.

However, the UK court did have jurisdiction to consider infringement by authorisation where there was a primary act of infringement in the UK. It held that there was a good arguable case that the German company authorised the infringement by its customers as it exercised complete control over the content of pop-up windows displaying sports data which it allowed its customers to access. Accessing the pop-up would create a local copy which, if it contained a substantial part of the copyright work, would be a s17 infringement.

The recent cases show that the law is adapting to find ways to deal with the growth of the internet; however, legislation has some way to catch up. The European Commission's report in relation to the Directive on the Enforcement of Intellectual Property Rights (2004/48/EC) (the Enforcement Directive) stated that the Enforcement Directive had made significant progress in removing disparities in the enforcement of intellectual property rights across the Community. However, the Commission commented on the scale of the increase in online infringement and that the Enforcement Directive did not provide for the difficulties raised in respect of online enforcement. In the report it made various recommendations as to clarifications which would be required to address the specific challenges of the digital environment. The Commission has requested feedback on the report by 31 March 2011.

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**T-281/09 Deutsche Steinzeug Cremer & Breuer AG v OHIM, General Court decision of 16 December 2010.** This is an appeal following the refusal to register the mark CHROMA as a Community Trade Mark (CTM). The General Court rejected the appeal and in so doing considered the proper assessment of 'descriptiveness' and in particular could a sign that is the Greek word for colour describe a 'characteristic' of bathroom ceramics to the Greek-speaking consumer. **Geoff Weller** reports.

## Red light for Chroma CTM application on appeal

The decision under appeal was a Board of Appeal's dismissal of an appeal by the applicant for registration of CHROMA covering inter alia ceramic bathroom goods and tiles, which found in essence that the sign at issue constituted the transliteration into Latin characters of the Greek word 'χρώμα' (colour) and that, since it was a descriptive indication of the characteristics of the goods concerned, there was a ground for refusal in Greece and Cyprus under Article 7(1)(c) of Regulation 207/2009 (CTMR) and also for the same reasons it was devoid of distinctive character under Article 7(1)(b) CTMR.

It was pleaded to the court this was an incorrect assessment under Article 7 and that the mark was registrable. The court focused first on Article 7(1)(c).

Article 7(1)(c) bars from registration "trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of the production of the goods or of rendering of the service, or other characteristic of the goods or service" and Article 7(2) says that this bar applies even where it exists in only one part of the EU.

Having considered the Board's decision in light of the relevant case law, the court upheld the findings that

- CHROMA will be immediately perceived as meaning 'colour' by a Greek speaker;

- the word 'colour' may be used to designate a characteristic of goods, namely their ability to be presented in various shades of colour, or at the very least refers to the use of or presence of non-black or white colours or a range of colours;
- in respect of the goods concerned, an indication that they are available in various colours is a characteristic which is likely to be relevant in trade; and
- from the point of view of the relevant Greek speaking consumer. The sign CHROMA could serve to indicate that the goods were available in various colours and that it therefore designated a relevant characteristic in terms of the marketing of the goods.

Having found no error in the assessment of the refusal under Article 7(1)(c), the court felt no need to review the Article 7(1)(b) objection and held that the appeal was rejected and thus the application is refused.

This case is interesting for practitioners as a review of the assessment of descriptiveness of a mark in the CTM system and also for applicants as a caution that with EU-wide protection also comes possible objection even if only in one EU country, language or alphabet.

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# Bring the world closer?

**Case O-353-10, Decision of the Appointed Person, Mr Geoffrey Hobbs QC, 24 September 2010, UK Trade Mark Application Nos 2500980 BRING THE WORLD CLOSER [series of three] and 2500983 NO WIRES, NO WORRIES [series of two] both in the name of Solomon Telekom Company Limited. Charlotte Duly reports.**

This appeal to the Appointed Person reiterated the tests for determining whether a mark is devoid of distinctive character and provided wise comments for those who are considering appealing a decision.

Solomon filed UK trade mark applications for the marks BRING THE WORLD CLOSER in classes 35, 38 and 41 and NO WIRES, NO WORRIES in classes 16, 35, 38 and 41 on 27 October 2008. Although both marks were filed as series they were essentially word marks.

The UK Registry rejected both of the applications on the basis that the marks were devoid of distinctive character under Section 3(1)(b) of The Trade Marks Act 1994. BRING THE WORLD CLOSER was rejected in its entirety whereas NO WIRES, NO WORRIES was rejected in relation to class 38.

## BRING THE WORLD CLOSER

This application covered "Promotional, advertising and marketing services" in Class 35 and broad specifications in Classes 38 and 41. The hearing officer's decision to reject the application was based on the fact that BRING THE WORLD CLOSER is comprised of four normal English words that form a commonly used phrase. Furthermore, in relation to telecommunications the mark simply advises the average consumer that the services will bring people together. The hearing officer concluded that the mark was not capable of functioning as a trade mark, stating:

"I see the phrase as a readily understandable combination such that, in the context of advertising especially, would not be such as to convey distinctive character".

## NO WIRES, NO WORRIES

As "telecommunication services" is a abroad term, the hearing officer determined that the average

consumer was likely to vary depending on the actual services offered but all consumers, even of the more basic services, would have a moderate level of attention and knowledge. NO WIRES, NO WORRIES was therefore rejected by the hearing officer for the services covered by class 38 on the basis that the mark would advise the consumer that wireless, worry free telecommunications would be on offer. The hearing officer found the meaning of the mark to be "plain" and "unambiguous".

## Appeal to the Appointed Person

Solomon appealed both of these decisions to the Appointed Person under section 76 of The Act. The statement of case filed by Solomon was extremely bare, simply stating that they did not agree with the decisions. Rule 71(1) of the Trade Mark Rules 2008 deals with appeals to the Appointed Person and states that the Notice of Appeal needs to include the grounds of appeal and the case in support of the appeal. The Appointed Person in this case reiterated the important point that appellants must "...question whether they have genuine grounds for appeal and not simply pursue an appeal for the sake of it".

However, Solomon did provide a little more detail in its skeleton arguments. With regard to BRING THE WORLD CLOSER, it was argued that the original decision did not review the matter thoroughly enough and the distinctiveness or otherwise that the mark should have been assessed in relation to all of the services covered by the application rather than the general terms only. In the case of NO WIRES, NO WORRIES, arguments were submitted on the basis that the mark is linguistically imperfect and would require some interpretation for a consumer to transform the mark from an indicator of origin to one that is completely devoid of distinctive character. It was argued that services

may suffer technical faults despite being wire-free, meaning that consumers would be unlikely to take the meaning of the mark literally. Solomon's skeleton arguments also seized upon a claim by the hearing officer that NO WIRES, NO WORRIES had a basic alliteration and rhythmic structure meaning that the mark could not be devoid of any distinctive character.

In summary, in both cases Solomon argued that the hearing officer's reasons for rejecting the applications were insufficient to establish that the marks in question lacked distinctive character.

## The decision

In his decision, the Appointed Person referred to Easistore Limited's application to register WE CREATE SPACE in Class 39 (O-342-10). This decision discussed exclusion from registration on the grounds of Section 3(1)(b). When assessing whether a mark should be refused registration under this section, the matter should be viewed from the perspective of the relevant average consumer to determine whether the mark at issue would serve to indicate that the goods or services originated from a single economic undertaking.

The Appointed Person essentially agreed with the hearing officer's assessment of BRING THE WORLD CLOSER, viewing the mark as a whole as being a statement regarding an advantage from the use of the services offered. The mark would be perceived by the average consumer as being origin-neutral as it involved no verbal manipulation which would render it distinctive. Therefore, the appeal in relation to Classes 38 and 41 was dismissed. The UKIPO offered to waive the objection to Class 35 and therefore BRING THE WORLD CLOSER was allowed to proceed for this class.

The Appointed Person also agreed with the hearing officer in relation to NO WIRES, NO WORRIES, finding no substance in the arguments put forward by Solomon. The appeal was therefore dismissed in relation to Class 38. NO WIRES, NO WORRIES was allowed to proceed for Classes 16, 35 and 41 for which no objections were raised.

**Charlotte Duly**, *Boult Wade Tennant*, [cduly@boults.com](mailto:cduly@boults.com)



Mark Bhandal

## Similar words can negate clear visual differences between wine marks

**T 35/08, Appeal to the General Court, 23 November 2010, Community Trade Mark Application 3079159 for ARTESA NAPA VALLEY and device in Class 33 in the name of Codorniu Napa Inc (Codorniu) and Opposition 000681686 thereto by Bodegas Ontañón, SA (Bodegas). Mark Bhandal reports.**

On 13 March 2003, Codorniu filed an application for a CTM for a word and device composite mark.

The composite mark was made up of the words ARTESA in bold gold capital letters against a black rectangle in a prominent position and NAPA VALLEY in copper bold capital letters against a black rectangle in a lower position and a sinuous gold element in a copper triangle against a grey square which also housed the ARTESA and black rectangle in a prominent position.

The application was filed for “wines produced and bottled in Napa Valley, California, USA” in Class 33.

Bodegas brought opposition proceedings against registration of the application for all the goods in Class 33. The Opposition relied on Article 8(1)(b) of Regulation No 207/2009 and (for the purposes of the appeal to the General Court) was based on earlier CTM Registration 2050623.

The CTM registration was a black and white word and device composite mark made up of the word ARTESO in plain capitals, which was positioned underneath the image of a centaur straddled by a rider. Both the centaur and rider are holding a staff and an amphora hangs from each end of the staff.

The CTM registration was registered in respect of inter alia “alcoholic beverages (except beers)” in Class 33 on the 22 January 2001.

On 31 March 2006, the Opposition Division upheld the Opposition.

On 20 November 2007, the Board of Appeal upheld the Opposition Division ruling following an appeal by Codorniu, which subsequently appealed to the General Court.

### The General Court’s findings

It was not directly disputed by Codorniu that the goods at issue were identical nor that the relevant public was composed of average European

consumers. The crux of the appeal was the dispute over the similarity of the marks and whether there was a likelihood of confusion.

### Similarity of marks

Unsurprisingly, the General Court stated that the assessment of the similarities of the mark should be made by assessing the visual, aural and conceptual similarities of the marks. It also stated that this involves more than just comparing one component of the mark with the corresponding component of the other mark and the assessment must be made by examining each of the marks as a whole.

However, in certain circumstances where one such component dominates over the other components of the composite mark such that the other components could be considered negligible, the assessment of the similarity of the mark may be carried out solely on the basis of that dominant element

(C 334/05 P OHIM v Shaker [2007] ECR I 4529, paragraph 35).

The General Court found the word elements to be the dominant component of both marks, but that the remaining components were not necessarily negligible. It is notable that the General Court completely discounted the words 'NAPA VALLEY' because of their less prominent position and smaller size, and would be perceived by the average European consumer as an indication of geographical origin and were therefore descriptive.

In agreement with the Board of Appeal, the General Court found that although there were differences between the marks, particularly in the shape, size and colour of the graphical components, there were also similarities; namely between the word elements 'ARTESO' and 'ARTESA', and the capitalisation and positioning of those words. Therefore the Board of Appeal was correct to find a degree of visual similarity.

The General Court also agreed with the Board of Appeal that there is a strong degree of aural similarity between the word elements 'ARTESO' and 'ARTESA'. The General Court disagreed with Codorniu's argument that the presence of 'NAPA VALLEY' is enough to prevent any aural similarity because of the inferior position and size of those words on the label, the descriptive quality of those words, and the likelihood that they would be omitted from wine lists and disregarded when consumers order a bottle of wine in a bar or restaurant.

In view of the rarely used Spanish word 'ARTESA' (meaning vessel of a specific shape for kneading bread) having no meaning to the average European consumer, 'ARTESO' being a made up word, the device in the application having no discernable meaning and the device in the CTM Registration having no clear and definite meaning, the General Court found neither a conceptual similarity nor dissimilarity.

### Likelihood of confusion

The General Court disagreed with Codorniu's argument that there was significant graphical differences and that the visual aspect of the goods

played an important role in this sector of commerce.

In a global assessment of the likelihood of confusion the visual, phonetic or conceptual aspects of the opposing signs do not always have the same weight. It is appropriate to examine the objective conditions under which the marks may be present on the market (Joined Cases T 117/03 to T 119/03 and T 171/03 *New Look v OHIM – Naulover (NLSPOORT, NLJEANS, NLACTIVE and NLCollection)* [2004] ECR II 3471, paragraph 49). Where the goods are sold in a self-service environment, such as shampoo in a supermarket, then the visual component may play a weightier part in the global assessment of the likelihood of confusion. Conversely, where the goods are sold orally such as when ordering a bottle of wine in restaurant (which is the present conditions) then the aural similarity may have a more important role (T 88/05 *Quelle v OHIM – Nars Cosmetics (NARS)* 8 February 2007).

### Outcome

In view of the identical nature of the goods, a strong aural similarity, a degree of visual similarity and the importance to be accorded to the aural similarity, the General Court found a likelihood of confusion.

### Comment

Looking at the marks *prima facie*, many trade mark practitioners and perhaps many more trade mark owners may take the view that the marks are dissimilar. Given some of the visual and conceptual differences between the two marks, it is easy to see how Bodegas chose twice to appeal this decision.

However, this case highlights the importance of the final part of the comparison of two trade marks; that is the objective conditions under which the marks may be present on the market and whether there is a likelihood of confusion in those market conditions.

**Mark Bhandal**, *Simmons & Simmons LLP*, [Mark.Bhandal@simmons-simmons.com](mailto:Mark.Bhandal@simmons-simmons.com)

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# General Court sees red at Deutsche Bahn's colour mark application

**Deutsche Bahn AG v OHIM, Cases T-404/09 and T-405/09, General Court, 12 November 2010.** The General Court has upheld two of OHIM's Board of Appeal decisions that Deutsche Bahn AG (DB) should be prevented from registering colour combinations of light grey and "traffic red" as Community trade marks in class 39. The General Court confirmed that the criteria applied for assessing the distinctive character of colour trade marks are the same for goods and services, under Article 7 (1)(b) CTMR. **Triona Desmond** reports.



Triona Desmond

## Background

In March 2008, DB filed two Community trade mark applications for colour combinations which covered 'transport of persons and goods by rail' in class 39. The marks were described as follows:

"The colour light-grey (ral 7035) is over the colour traffic-red (ral 3020), these again over the colour light-grey (ral 7035) arranged; the relationship of the colours amounts to from top to bottom light grey; Traffic-red; Light-grey = 7: 1: 2."

"The colour light-grey (ral 7035) beside the colour traffic-red (ral 3020) arranged. The relationship of the colours is light grey: Traffic-red = 1: 1."

OHIM refused the applications on the basis of Article 7(1)(b). DB appealed, but its appeals were dismissed on the basis that the marks were devoid of distinctive character. DB then filed appeals at the General Court, requesting OHIM's Board of Appeal decisions be overturned.

DB argued that the supply of services does not inherently involve the use of colour, so the colour performs no function in connection with services and colour trade marks can therefore be registered (T-173/00 KWS Saat AG v OHIM). In addition DB argued that OHIM's assessments in these actions were contrary to case-law and the

office had ignored the fact that different criteria were applicable to the registration of colour marks for services than for goods. DB claimed that the colour combination of light grey and traffic red, which the German national railway company uses, for example, on its high speed trains, had no purely decorative role, but enabled the public to identify the commercial origin of its rail services.

## Findings of the court

The General Court disagreed with DB and held that the same rules applied to the registrability of trade marks for goods and services. The General Court referred to *Libertel* (Case C 104/01 [2003] ECR I-3793) and *Heidelberger Bauchemie* (Case C-49/02 [2004] ECR I-6129) stating that, other than in exceptional cases, colours or colour combinations, although they are capable of providing certain associations of ideas, do not initially have a distinctive character. Furthermore, the general public must be considered by not unfairly restricting the availability of colours to others who offer the same type of goods or services to those for which registration was sought.

The General Court found that the two colours contained in both applications lacked distinctiveness individually, and when combined, did

not provide any perceptible differences from the colours commonly used for railway services. The General Court agreed with OHIM that the light grey, which could be seen as a dirty white, was commonly used for technical equipment necessary for providing these services, for example in connection with train carriages, engines and control commands along the rails. In addition, red was used for warning on road signs or to make a consumer aware of advertising and the combinations of a dirty white (grey) and red were representative of the signalling of caution on railroad signs and level crossing gates. With this in mind the General Court rejected the appeal and concluded that overall the combination of colours would only be perceived as functional or decorative and did not indicate the origin of the services.

## Comment

Unsurprisingly DB were unable to overcome well-established case law, so if applicants wish to obtain registration of a Community trade mark consisting of a colour or a combination of colours, they will generally still need to file evidence of acquired distinctiveness.

**Triona Desmond**, *Hammonds LLP*, [triona.desmond@hammonds.com](mailto:triona.desmond@hammonds.com)

# Naturally Active refusal upheld by General Court

**Case T-307/09, Liz Earle Beauty Co Ltd v OHIM. Judgment of the General Court (Eighth Chamber), 9 December 2010.** The EU General Court has upheld OHIM's Board of Appeal decision to refuse the word mark NATURALLY ACTIVE for cosmetics and related goods and services in classes 3, 5, 16, 35 and 44. The decision was annulled with respect to goods in class 18. **Sharon Daboul** reports.



Sharon Daboul

In December 2007, Liz Earle Beauty Co Ltd (Liz Earle) filed a Community Trade Mark application for NATURALLY ACTIVE for goods and services related to cosmetics in classes 3, 5, 16, 18, 35 and 44. The application was refused in its entirety on the basis of Articles 7(1)(b) and 7(2) CTMR, that the mark applied for was devoid of inherent distinctive character. The applicant had not furnished sufficient evidence of acquired distinctiveness to overcome Article 7(3) objections.

## Decision of the Second Board of Appeal

Liz Earle's appeal was unsuccessful, the Board of Appeal finding NATURALLY ACTIVE to be a mere promotional indication. Furthermore, the Board of Appeal held that the applicant had not demonstrated distinctiveness acquired through use in all the member states.

## Decision of the General Court – Article 7(1)(b)

The General Court agreed with the finding that NATURALLY and ACTIVE are ordinary words; the mark being a grammatically correct expression with clear meaning for goods or services concerning cosmetics and beauty care.

The Board of Appeal had rightly concluded that the term NATURALLY would be understood as referring to natural ingredients (common in cosmetics), and ACTIVE would indicate that the cosmetic goods or services had an effect (ie, acts). In the context of the application, NATURALLY ACTIVE gave the

impression that it enabled a result to be achieved, produced by natural ingredients. Consequently, NATURALLY ACTIVE would be viewed as a laudatory term and no indicator of origin.

The Board of Appeal had been right to refuse registration on Article 7(1)(b) grounds, for classes 3, 5, 35 and 44. The General Court also agreed with the reasoning against the class 16 goods (printed matter, books and publications...), which would be designed to promote cosmetic products. NATURALLY ACTIVE could be understood as referring to a characteristic of the products mentioned or depicted within the printed matter.

Regarding class 18 however, the General Court found the Board of Appeal decision lacked proper reasoning for why the sign was non-distinctive for these goods; purses, wallets and cases for mirrors in particular. Distinctive character must be assessed by reference to each of the goods and services, and the contested decision had been too general in this respect. The Board of Appeal should have drawn distinction between homogeneous goods or services directly linked with cosmetics, and the goods in class 18. OHIM's contention that the mark conveyed the message that the goods are intended for naturally active people, or referred to the quality of the cosmetics rather than the goods themselves, was held insufficient.

## Article 7(3)

The General Court agreed that the

relevant consumers are European English-speakers. By implication, this included all member states where basic English words may be understood. A sign consisting of grammatically correct English words might have meaning not only for native speakers but also those with sufficient knowledge of English.

Acquired distinctiveness must be evidenced in the substantial part of the EU where English is spoken. By supplying evidence of use relating to the UK, Ireland and Germany only, the applicant failed to demonstrate use in all the countries where basic English could be understood, ie the Scandinavian countries, Netherlands and Finland.

The court could not hold that the mark had acquired distinctiveness in the EU.

The decision of the Second Board of Appeal was annulled for class 18 and the remainder of the action dismissed.

## Comment

This decision reminds CTM applicants that acquired distinctiveness must be evidenced in a substantial part of the EU. Where a mark consists of basic English words, which both individually and in combination are likely to be understood throughout the EU, the relevant consumers will be taken to be European English-Speakers, and the applicant must substantiate accordingly.

**Sharon Daboul**, MW Trade Marks, [sharon@mwtrademarks.com](mailto:sharon@mwtrademarks.com)



Matt Hervey

# The problem of acquiring distinctiveness throughout ever enlarging EU region

**CNH Global NV v OHIM (Case T-378/07), The General Court of the European Union (Second Chamber), 29 September 2010, (I Pelikánová, President, K Jürimäe and S Soldevila Frago (Rapporteur), Judges).** The General Court held that the applicant for a figurative mark must establish that, before the application was filed, the mark acquired distinctiveness *throughout* the Community in respect of a significant part of the

relevant public. Evidence of acquired distinctiveness is required for every member state regardless of the strength of the evidence for some member states. The relevant public includes all those interested in purchasing or using the goods or services concerned. It was artificial to exclude those whose interest was merely 'potential' because, for example, they currently lacked the means to buy. **Matt Hervey** reports.

## Background

CNH Global NV applied for the figurative sign illustrated opposite. The sign was sought in respect of tractors (Nice Class 12) and described as a 'combination of the colours red, black and grey as applied to the exterior surfaces of a tractor, namely red as applied to the bonnet, roof and wheel arches, light and dark grey as applied to the bonnet in a horizontal stripe and black as applied to the front bonnet grill, chassis and vertical trim'.

The examiner rejected the application because CNH failed to establish distinctive character throughout a substantial part of the Community. Although CNH had shown 'outstanding' sales figures in Western Europe, it had failed to prove extensive use in the (mainly agricultural) new member states.

The First Board of Appeal confirmed the decision. The relevant public was farmers. The combination of colours lacked inherent distinctiveness and

CNH had failed to show the sign had acquired distinctive character in the new and some of the older member states.

## The grounds of appeal before the General Court

CNH argued that the requirements of Article 7(3) had been met.

First, the relevant public was not farmers in general but present owners and prospective purchasers of tractors, excluding, for example, the owners of small farms and those without the means to make such a purchase.

Second, it suffices to adduce evidence for a substantial part, not the whole, of the Community. In particular, CNH argued that evidence of outstanding sales in the older member states sufficed because the older member states represented 90% the Community. (The 90% figure is not explicitly explained in the judgment; it may refer to sales in relation to the size of the market.) Moreover, the 'relevant' public (present owners and

prospective purchasers of tractors, according to CNH) was very small in the new member states because the farms there were too small for tractors.

CNH did not dispute that the combination of colours lacked inherent distinctive character.

## The findings of the court

The court rejected CNH's appeal.

The court summarised the existing case law:

1. A mark may acquire distinctiveness where, through the use made of it, 'at least a significant proportion of the relevant sector of the public identifies the goods or services concerned as originating from a particular undertaking because of the mark'.
2. It must be shown that the mark has acquired distinctiveness 'through the territory in which it did not, *ab initio*, have such character'.

3. The question requires an overall assessment of the evidence, and the following may be considered: the mark's market share; the intensity, geographic spread and length of the use; the investment in promoting the mark; the proportion of the 'relevant class' to whom it is distinctive; and statements from trade and professional associations.
4. The distinctiveness must be assessed in relation to the goods or services for which the mark is registered and in relation to the presumed perception of the average consumer of the goods or services who is reasonably well informed, observant and circumspect.
5. The distinctive character must have been acquired before the application was filed.

The court applied the case law to the issues in dispute: the relevant public and the extent of the acquired distinctiveness through the Community.

First, the court rejected the distinction between 'prospective purchasers' and those who are 'only potentially interested'. For the purposes of trade mark law, goods are of potential interest only to prospective purchasers.

The court held that the relevant public for CNH's mark was all farmers. It was wrong to exclude farmers with only a 'potential interest' such as those with small farms or those without the means to purchase. According to the evidence, various manufacturers had developed compact tractors for small farms. Farmers with limited means should not be excluded because their circumstances might change or, for example, financing might be extended by distributors.

Second, the court confirmed that acquired distinctiveness must be shown throughout the Community. Article 7(3) must be read in the light of Article 1(2) which requires the Community trade mark to have 'unitary' character. Article 1(2) implies that Community trade marks must have 'equal effect throughout the Community' and that such marks

must have distinctive character throughout the Community. The court warned against confusing this test with the requirement under Article 5(2) that a mark have a reputation in a 'substantial part' of a member state.

Therefore, CNH needed to prove that, when its application was filed, the mark had acquired distinctiveness throughout the Community (excluding those parts where the mark was distinctive *ab initio*). Because the application was filed in July 2004, the Community included the ten new member states which joined, two months earlier, in May 2004.



Finally, the court considered the value of the evidence provided by CNH. First, CNH did not provide evidence covering all of the member states. None of CNH's arguments on the evidential value of its documents could overcome the incompleteness of the coverage. For example, the affidavits submitted by CNH came from professional associations in Belgium and the UK and the court held that the knowledge of these professionals would probably be restricted to their own countries. Second, sales volumes and advertising materials were secondary to direct evidence of acquired distinctiveness (such as affidavits) because they do not reveal the perceptions of the relevant public. Such secondary evidence cannot on its own be proof of acquired distinctiveness. Third, the court held that the market shares submitted by CNH were unreliable because of 'significant inconsistencies' in the evidence. Finally, photographs submitted by CNH only evidenced use of the mark, not the perceptions of the relevant public.

## Comment

The court confirmed the clear and stringent rule for acquired distinctiveness: this must be shown in every member state as at the filing date of the application. The court also gave practical guidance on necessary evidence. Evidence must be provided for all member states, regardless of the strength of the evidence for some member states. Direct evidence, such as affidavits from professional associations, is required to prove the perception of the relevant public. Secondary evidence, such as sales volumes and advertising materials, can only demonstrate the use made of a sign and on its own is insufficient to prove acquired distinctiveness.

The court's approach to defining the relevant public is less clear. The court drew conclusions from the 'essential functions' of trade marks but provided little reasoning. Working back from the court's conclusions, the judgment appears to suggest two principles. First, the relevant public is made up of consumers and end-users interested in purchasing (or using) the relevant goods or services.

This excludes those, such as mechanics, historians, sociologists and political analysts, interested in the goods or services for other reasons. Second, it is artificial to limit the relevant public to those with a realistic current prospect of purchasing the goods and services. The judgment supports a general principle that the relevant public also includes those with an interest in purchasing the goods or services but who lack the means. On the other hand, it is not clear whether it is open to an applicant to exclude those whose circumstances preclude the use of the goods and services. CNH failed to prove that tractors were unsuitable for the small farms of certain member states. But the court also said the 'small size of farms ... *could not* call into question such a conclusion [that farmers are the typical consumers of tractors]' (emphasis added). It is not clear whether the court is suggesting a general principle that conditions in specific member states cannot alter the definition of the relevant public.

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Ellen Forrest-Charde

# General Court ruling puts a thorn in Gotcha's side

**Case T-169/09, Vidieffe Srl v OHIM (25 November 2010).** The General Court has annulled the decision of the First Board of Appeal which had upheld part of a decision of OHIM's Opposition Division challenging an application for the word mark GOTHA due to a likelihood of confusion with an earlier device mark including the word GOTCHA. The case demonstrates that the court will consider facts which are in "common knowledge" (ie, in dictionaries and various media) if they are relevant to the case in point. **Ellen Forrest-Charde** reports.

## Background

In 2004, Vidieffe applied to register GOTHA as a Community trade mark in respect of various goods in classes 18 and 25. Perry Ellis International Group Holdings Limited opposed the application, arguing that the mark was likely to be confused with its earlier mark, GOTCHA and device (set out below), registered for goods in the same classes.

## The earlier decisions

The Opposition Division of OHIM rejected the opposition in full; in its view, the visual, phonetic and conceptual differences between the two marks created a different overall impression, even if the goods were identical. Perry Ellis appealed.

The First Board of Appeal allowed part of the appeal, due to a low visual similarity and a high degree of phonetic similarity between the marks, which would be important in countries which did not attribute meaning to the marks and accordingly, found that there would be a likelihood of confusion between the marks in those countries.

Vidieffe appealed solely on the grounds of a breach of Article 8(1)(b) of the Regulation.

## Decision of the General Court

Given that the goods in the case were "convenience" items, the court agreed with the Board's assessment that the relevant public was the average consumer in the EU, being a reasonably well-informed and circumspect person. It reiterated the principle that likelihood of confusion

could include a risk that the public might consider the goods to come from the same business or that the businesses were economically linked in some way and reminded the parties of its duty to balance all of the facts in the case and that a low degree of resemblance in one area might be offset by strong similarities in other areas.



In respect of similarity between the goods, the court noted as follows: all of the goods in class 25 and 'trunks, travel bags, umbrellas, parasols, canes' in class 18 covered by the application were identical to the goods covered by the earlier registration; 'leather or imitation leather goods (not included in other classes)' covered by the application might be considered as identical or similar to 'handbags' in the earlier registration, 'walking sticks' in the application and 'canes' in the earlier mark were similar, as they fulfilled the same purpose; and 'leather and imitation leather' were dissimilar to all of the goods for which the earlier mark was registered.

In its consideration of the marks "as a whole", the General Court took the customary three-pronged approach below.

## Visual similarity

Whilst the court ultimately agreed with the board that the marks were visually similar, it criticised the way in which the latter had arrived at its conclusion, and particularly the importance accorded to the word element.

The board had raised the principle, derived from case law, that consumers typically refer to products by name rather than by describing the logo element with the result that, in composite marks, the word element often has a greater impact than the logo element. However, it had not sufficiently explained why, in the present case, the word element in the earlier mark had a greater impact. It had also been noted in the board's conclusions (and not challenged by the court) that the applicant's mark was purely a word mark while the earlier mark incorporated the image of a black rose, below which the stylised word 'gotcha' appeared; however, the General Court noted that the rose was highly visible in the earlier mark, and incorporated into the word element (the "t" of "gotcha" was the stem, the other letters akin to the rosebush). This, in its view, reduced the importance of the word element.

Moreover, the court indicated that the particular marketing methods employed by the clothing and accessories industry were relevant to the consideration of the importance of the word element. If the particular goods were normally sold in self-service shops (ie, the consumer chooses the item himself), the visual



aspects would have more importance, whilst if sold orally, the phonetic similarity would be more important. It considered that, in the clothing sector, images were often at least as important as the word element as consumers might purchase clothing on the basis of recognising the image, rather than the word.

In any event, the court concluded that there was a low degree of similarity between the marks in that the applicant mark contained five of the same letters, in the same order, with the only difference being the middle letter “c”, which, the court, agreeing with the board, felt that consumers would probably disregard.

### Phonetic similarity

The court further criticised the board’s conclusion that phonetic similarities between the two marks were strong. In its reasoning for this conclusion, the board had maintained that the insertion of a “c” in the earlier mark did little to alter the final sound of the word “gotcha”, that the two words had two syllables and that the same rhythm, length and intonation applied to both marks.

The court wholly disagreed; in its view, the inclusion of the “c” changed the sound from a lisping “th” sound to a harsh “ch” sound. Moreover, the “t” sound was also different in that it accompanied the vowel in “gotha”, but was audible with the “got” and the “tcha” in “gotcha”. These effects changed the length, rhythm and intonation of each mark.

The court noted also that the board had not provided evidence for its reasoning that there was no difference in meaning between the marks in languages other than English.

Accordingly, the court held there was only a very low degree phonetic similarity between the marks.

### Conceptual similarity

The court agreed that “gotcha” was a slang word, understood by English speakers and particularly the young, and that the applicant’s mark would be understood by Germans, being the name of a German town. However, the board had also argued that the

majority of consumers in the EU would consider that the marks were works of fiction. In the present case, Vidieffe brought forward new facts to counter this, which were admitted as they were ‘common knowledge’ and published in various media. These facts indicated that “gotha” meant aristocracy in certain languages. Therefore, whether German or not, a significant portion of the relevant public would understand the meaning behind “gotha” and the marks were sufficiently distinguishable.

### Likelihood of confusion

Turning to its global assessment of the likelihood of confusion, the court felt that the visual differences between the marks (being the image and the “c”), as well as the differences in pronunciation and the fact that the applicant mark was a synonym for aristocracy, reduced the likelihood of confusion between the marks when used in relation to identical/similar goods. With the appeal upheld and the opposition rejected in full, Vidieffe was successful.

### Comment

Since the application for and dispute over the “gotha” mark, Perry Ellis has successfully obtained Community trade mark registrations for the word mark “gotcha” (in 2008 and 2009) for goods in numerous classes — it would have been interesting to see whether the outcome would have been different if these had been registered in 2004. We can also conclude from this case that the court is fully prepared to admit additional facts on appeal if these are relevant and in the relevant public’s “common knowledge” (for example, published in dictionaries and the media). The common knowledge facts also appeared to be determinative to the outcome of this case. Accordingly, those seeking to defend weaker cases before OHIM’s Boards of Appeal and/or the General Court would be well advised to collect “common knowledge” evidence to bolster their cases in the future.

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# Domain names – three Nominet cases compared

Jo Bixby reports

## 1. DECKERS OUTDOOR CORPORATION V MR DAVID LEE – NOMINET'S DRS 15/10/10: FEELUGG.CO.UK SNOWUGG.CO.UK UGG2ALL.CO.UK UGGBAILEYBUTTON.CO.UK UGGCLASSIC.CO.UK UGGS4SALE.CO.UK UGGSBOOT.CO.UK UGGSCARDY.CO.UK UGGSHORT.CO.UK EGGSLINE.CO.UK UGGSOUTLET.CO.UK UGGTALL.CO.UK.

Deckers Outdoor Corporation is an international footwear manufacturer founded in 1979. It trades/markets its brand under the 'UGG' trade mark.

Mr David Lee is an individual residing in China who registered the domain names in dispute between March and October 2009. Mr Lee was using the websites attached to the domain names to sell counterfeit UGG boots. He used Deckers Outdoor Corporation's copyright protected material on the websites to confuse customers and to make it look like the websites and the products sold on them were authorised by or associated with Deckers Outdoor Corporation.

Deckers Outdoor Corporation filed a domain name complaint. Mr Lee was something of a repeat offender (having on two previous occasions had to hand over UGG-related domain names) and did not respond to this complaint.

In the normal way for cases brought under Nominet's DRS in order to win the dispute the complainant, Deckers Outdoor Corporation needed to prove that on the balance of probabilities it had rights in respect of a name or mark which is identical or similar to the domain names and that

the domain names, in the hands of Mr David Lee, were abusive registrations.

### Decision

In this complaint, the domain names all incorporated the UGG trade mark in its entirety and the additional wording, such as *uggboot.co.uk*, did not make the domain names in themselves distinctive. The Expert was of the opinion that, when Mr Lee registered the domain names, he would have been aware of the UGG brand and he was therefore piggy-backing on the goodwill and reputation of the UGG trade mark. The Expert found in favour of Deckers Outdoor Corporation and decided that the domain name registrations were abusive registrations.

### Comments

This was a straightforward case for a transfer under Nominet's DRS. The decision does, however, serve as a timely reminder to all would-be complainants that it is for the complainant to prove its case in each complaint and that just because the respondent fails to respond to a complaint, it does not mean that the domain name(s) will be automatically transferred to the complainant. Indeed, although Nominet's procedure document allows the Expert to draw whatever inferences he likes from the respondent's failure to respond to a complaint, in this case the Expert specifically pointed out that he did not draw on the inference from the respondent's failure to provide a response.

## 2. JUMPTEC LTD T/A CCM MOTORCYCLES V HAINES & CO MOTORCYCLES – NOMINET'S DRS 4/10/10: CCMSPARES.CO.UK

Jumpte Limited t/a CCM Motorcycles (CCM Motorcycles) sells CCM motorcycles and corresponding spare

parts either directly to the public (via its website at *www.sparesccm.com*) or via its dealership network, although (and this was disputed between the parties) there may have been a period during which CCM Motorcycles did not itself sell spare parts. The respondent, Haines & Co Motorcycles was one of CCM Motorcycles' authorised dealers and used the domain name *ccmsparses.co.uk* to sell both genuine and non-genuine spare parts for CCM motorcycles.

CCM Motorcycles argued, amongst other points, that anyone reviewing the website at *ccmsparses.co.uk* would expect that the website be operated by CCM Motorcycles itself and/or to only sell genuine parts.

Haines & Co Motorcycles (Haines) argued that it was clear that the website was operated by a dealer and not CCM Motorcycles. The homepage of the website was headed with 'Haines & Co'; Haines also displayed CCM Motorcycles' logo and a statement which read that CCM "no longer deal direct to the public for spare parts" and CCM Motorcycles argued that all of the above was done in an attempt to confuse and mislead customers. Haines, however, argued that the previous owners had given its consent to purchase the domain name and the failure to remove the statement had been an oversight. Haines had a new website being launched which did not include the statement and which made clear which parts were genuine and which were not. It gave supply issues from CCM Motorcycles as a reason for selling non-genuine parts on the website.

### Decision

The Expert found in favour of CCM Motorcycles and decided that the domain name registration was an abusive registration. The key issue, according to the Expert, was the message that Haines was conveying to the public through its use of the domain names. The statement saying that CCM Motorcycles did not supply spare parts direct to the public was a big factor in the Expert's decisionmaking.

The Expert found that, on the balance of probabilities, Haines must have

known since at least 2005 that CCM Motorcycles had resumed its sale of spare parts direct to the public. The Expert also felt that potential customers would 1) fall into a 'bait and switch' scenario where they have sought genuine parts but upon viewing the website end up buying non-genuine parts and/or 2) be misled into purchasing a non-genuine part when they think they are purchasing a genuine part.

Further, the Expert found that the sale of both genuine and non-genuine parts on the same website takes unfair advantage of CCM Motorcycles' rights in the CCM name. It would either divert sales away from CCM Motorcycles or jeopardise CCM Motorcycles' control of its reputation, or both.

### Comments

This case follows a reasonably long line of Nominet DRS cases where a word which simply describes the complainant's goods (in this case 'spares') is attached to the complainant's name or mark. It was however less straightforward than a number of previous cases because the respondent in this case was in fact an authorised distributor for the complainant and was therefore arguably entitled to use the domain name at least in certain circumstances.

There were, however, a number of other factors which tended towards the Expert's finding that this was an abusive registration, including the fact that the respondent was offering both genuine and non-genuine goods and the misleading statement about the complainant and its supply of spare parts that appeared on the respondent's website.

### 3. TRAVELLERS EXCHANGE CORPORATION LIMITED V JOE NEW (T/A FAIRFX) – NOMINET'S DRS 13/10/10: TRAVELEXPENSIVE.CO.UK AND TRAVELEXPENSIVE.CO.UK

Travellers Exchange Corporation Limited (TECL) is a well-known currency exchange business and is part of the Travelex group of companies, which has been in operation for nearly 30 years. It owns

numerous registrations worldwide for TRAVELEX and other related trade marks (such as TRAVELEX WORLDWIDE MONEY, with a distinctive blue, red and white colour combination) and has websites at [www.travelex.com](http://www.travelex.com) and [www.travelex.co.uk](http://www.travelex.co.uk) and owns several other domain names including TRAVELEX.

Joe New is an individual associated with FairFX plc (FairFX) that operates a currency exchange business and since 2006 has been a competitor of TECL via its website at [www.fairfx.co.uk](http://www.fairfx.co.uk). The domain names [travelexexpensive.co.uk](http://travelexexpensive.co.uk) and [travelexpensive.co.uk](http://travelexpensive.co.uk) (as well as the '.com' equivalents) were registered in April 2010 by Mr New.

The websites attached to the domain names contained a link to [www.fairfx.co.uk](http://www.fairfx.co.uk) which directed potential customers of TECL to FairFX and featured the word 'travelexpense' in the same blue, red and white colour combination as used by TECL in an attempt to confuse potential customers into thinking that the websites were connected to or authorised by TECL. The website also included a statement which read "Did you know that Travelex charges you 5.75% to withdraw leftover cash when you get back home?" followed by "Save money. Choose FairFX.com as your travel money provider this summer" and gave the overall impression that FairFX was cheaper than TECL across the board.

Even if the potential customer realised that the websites were not connected to TECL, initial interest confusion had occurred and this was evidence of an abusive registration (they cited *Comite Interprofessionel du Vin de Champagne v Steven Terence Jackson* DRS No. 4479).

TECL argued that TRAVELEX together with the words 'EXPENSIVE' and 'PENSIVE' was a direct attempt and/or a play on words used to deceptively indicate that TECL was expensive. It submitted that there was a confusing similarity between their trade mark and the domain names. FairFX had no legitimate non-commercial interest in the domain names and had therefore registered the domain names to unfairly disrupt TECL's business, to

tarnish its name and services and to dilute the reputation of the trade mark which was unfairly detrimental to TECL's rights and that the link directing potential customers to FairFX constituted bad faith registration and use.

FairFX argued that the domain names were not identical or similar to TECL's TRAVELEX trade mark and that its use was fair for the purpose of criticism and comparative advertising rather than to disrupt TECL's business. The fact that customers chose to go with FairFX after visiting the website was merely a legitimate consequence. The domain names were most likely to be interpreted as 'travel' and 'expensive' or 'travel' and 'pensive' and could therefore relate to any travel price related websites and when you search the domain names on Google or Yahoo the website attached to the domain names appear more than ten pages down.

### Decision

The Expert reminded us that Nominet's DRS policy requires a finding of similarity and not 'confusing similarity'. He dismissed FairFX's arguments and found that the domain names were similar to TECL's marks and its use was not legitimate comparative advertising rather they were used for commercial purposes as part of a 'bait and switch' operation. The Expert decided that the domain names were an abusive registration and that they should be transferred to TECL.

### Comments

Nominet's DRS policy does provide respondents with a potential defence if they can satisfy the Expert that they have acquired/used the domain name(s) for fair use grounds for example as a criticism or tribute site. However, to make out this defence, the respondent must also satisfy the Expert that it acquired/used the domain name(s) solely for non-commercial purposes. The defence is not available where the domain name(s) is clearly being used as a bait and switch exercise to lure customers away from your competitors.

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# Nike claim partial win on appeal but may still pay the price of initial lapse

**Nike International Limited v OHIM (T-137/09), ECJ, 24 November 2010.** The General Court has annulled the First Board of Appeal's decision that Nike International Limited (Nike) had not been in a position to prove that it was the owner of an earlier right on which it had relied in opposition proceedings. As Nike had not produced proof of its status as a party to opposition proceedings the Board of Appeal held that it was not entitled to appeal against the Opposition Division's decision. The Board of Appeal failed to give Nike an opportunity to produce additional evidence of the transfer of the earlier right, in order to show that it had locus standi. **Triona Desmond** reports.

## Background

In January 2006, Aurelio Muñoz Molina filed a Community trade mark application for the word mark "R10" for goods in classes 18, 25 and 35.

In October 2007, DL Sports & Marketing Ltda (DL) filed a notice of opposition against the goods in classes 18 and 25. The opposition was filed under Article 8(2)(c) and Article 8(4) relying on the non-registered sign "R10". No evidence was filed in support of the opposition even though an extension to the initial deadline had been obtained.

Over two months after the deadline had expired, Nike's lawyers informed the Opposition Division that on 20 June 2007, DL had assigned numerous trade marks and industrial property rights to it. Nike's lawyers stated that they had been instructed to pursue the opposition proceedings and, accordingly, requested that they were entered as representatives and requested a four-month suspension of proceedings. These requests were rejected.

Nike filed an appeal which was found inadmissible on the grounds that Nike had not produced proof of its status as a party to the opposition proceedings and, consequently, that it was not entitled to appeal against the Opposition Division's decision. The Board of Appeal found that, at

that stage of the proceedings, Nike's lawyers had not claimed or proved that the earlier right relied on in support of the opposition was among the trade marks transferred to Nike. The transfer agreement detailing the marks assigned only confirmed that Nike had acquired certain Community trade marks, but not, specifically, the earlier right relied on.

Nike appealed further to the General Court requesting that the court overturn the Board of Appeal's decision to dismiss the earlier appeal, provide a ruling on the substance of the appeal, and that it rule that the Board of Appeal and the Opposition Division had infringed Article 73. In addition Nike requested an order that the proceedings revert to an earlier stage so as to remedy the fact that it had not had the opportunity to correct the deficiencies as assignee of the earlier right and/or, at the very minimum, that the decision be correctly notified to the representative of the owner of the earlier right.

The first and second pleas in law relating to the Opposition Division's decision were rejected at the beginning of the proceedings, as actions may only be brought before the Community courts against decisions of the Boards of Appeal under Article 65(1) of Regulation No 207/2009). As a result, the Opposition Division could not be accountable.

## Third plea in law - potential infringement of the OHIM Guidelines

Nike submitted that the Board of Appeal was not entitled to find its appeal inadmissible on the ground that it was not the owner of the right on which the opposition was based. According to the OHIM Guidelines, if the copy of the registration certificate of the trade mark on which an opposition is based states as proprietor a party other than that which filed the opposition, the opposition is accepted as admissible on the assumption that the earlier mark was transferred to the opponent before the opposition was filed. Nike considered that the same applied in this case.

## Findings of the court

The court found that if the assignment of the trade mark relied on occurred after the opposition was filed but before OHIM's final decision, OHIM would have ensured that the rights of the party which originally filed the opposition were protected. However, in this case the assignment of the earlier right had occurred before the opposition was filed. In addition, the Board of Appeal was required to ensure that the person who brought the appeal had locus standi with regard to the Opposition Division's decision (see Case T 301/03 Canal Ireland v OHIM – Canal Jean (CANAL JEAN CO NEW YORK) [2005]

ECR II 2479, paragraphs 19 and 20). Therefore the court concluded that the OHIM guidelines were not infringed by the Board of Appeal and furthermore the Board of Appeal was legally entitled to examine Nike's locus standi. As a result this plea was dismissed.

### **The second plea in law, alleging infringement of Article 73 and of other related provisions**

Nike claimed that the contested decision breached its rights of defence, since it was based on an interpretation of the transfer agreement on which Nike was unable to submit observations, and the contested decision also breached other provisions applicable, including Rule 31(6) of Commission Regulation (EC) No 2868/95, as Nike did not have the opportunity to correct deficiencies in relation to proof of the transfer of the earlier right.

OHIM claimed that the Board of Appeal had not infringed Nike's rights of defence since Nike was not a party to the proceedings before the Opposition Division. Nike requested to be party to proceedings after the deadline to substantiate its earlier rights had expired and it produced no evidence of the assignment in its favour of the earlier right relied on in support of the opposition. Therefore OHIM argued that the Board of Appeal did not infringe Rule 31(6) as proceedings had already been concluded, so it was too late to allow deficiencies to be rectified.

### **Findings of the court**

Rule 31(6) of Regulation No 2868/95 states that with regard to the transfer of Community trade marks, where the conditions applicable to the registration of a transfer, which include the obligation to produce documents duly establishing that transfer, are not fulfilled, OHIM is required to notify the applicant of the deficiencies and that "if the deficiencies are not remedied within a period specified by OHIM, it shall reject the application for registration of the transfer."

In this action the court confirmed that the Board of Appeal had found that Nike had not been in a position to prove that it was the owner of the earlier right and, consequently, that it

had not produced proof of its status as a party to the opposition proceedings and therefore was not entitled to appeal the Opposition Division's decision. Nonetheless the court found that the Board of Appeal had failed to give Nike an opportunity to produce additional evidence of the transfer of the earlier right on which it had relied in order to show that it had locus standi.

The court did not accept OHIM's arguments that, as Nike had applied to be substituted for the original opponent after the closure of the opposition proceedings this disallowed it from appealing. As the owner of the trade mark relied on in support of the opposition, the court confirmed that the assignee has locus standi with regard to the decision by which the opposition proceedings are concluded. Although Nike produced no evidence of the assignment to it of the earlier right relied on in support of the opposition, the court held that the Board of Appeal should have allowed it to remedy that. Therefore the court upheld the plea regarding the contested decision, and found that there was no need to consider whether Nike's rights of defence were infringed.

The court held that it could not allow Nike to file additional arguments and evidence concerning the assignment to it of the national right relied on in support of the opposition and give a ruling on the admissibility of the appeal before the Board of Appeal in the light of that new evidence. Instead the court annulled the contested decision and rejected the claim for amendment of that decision, therefore not examining Nike's fourth plea.

### **Comment**

Although Nike was victorious to a degree, it does not change the fact that the deadline to submit evidence in support of the opposition was missed. It will be interesting to see if Nike progress any further with this case or whether it falls at the next hurdle. This case shows that, ideally, the opponent should always be the party who owns the earlier rights at the time of filing the opposition.

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Susan Snedden

# Inveresk's breaches of quality standard licensing obligations cost it dear...

**Tullis Russell Papermakers Limited v Inveresk Limited [2010] CSOH 148.**

**Court of Session Judgment 10 November 2010, Lord Drummond Young.** The Scottish Court of Session has recently demonstrated again its pro-IP stance by awarding £4.25m damages in a hard-fought dispute relating to brand value diminution. Of particular interest is the approach taken by the court to the calculation of the damages. **Susan Snedden** reports.

The parties to the dispute were rival Scottish paper manufacturers Tullis Russell (the pursuer/claimant) and Inveresk (the defender/defendant). Both companies manufactured high-quality board for use in applications such as greetings cards, product packaging and phone cards. Each company had a number of different brands of paper and board.

Tullis purchased Inveresk's GEMINI brand and customer information related to that brand in June 2005. A key part of their decision to purchase the brand was based on the strength of the goodwill in the GEMINI brand.

The terms of the purchase agreement was structured so that for a handover period of five months after the acquisition (known as the 'services period'), Inveresk would continue to manufacture and distribute GEMINI products under licence from Tullis. At the end of the services period, Tullis would take over the manufacture and distribution of the GEMINI products.

Tullis paid Inveresk £5 million for the

acquisition and a further £5 million for Inveresk's services during the services period. The judge held that on a proper construction of the contracts forming the deal, the full £10 million was paid for the GEMINI brand.

## Relevant licence terms

Inveresk had various contractual obligations during the services period aimed at preserving the goodwill in the GEMINI brand, including:

- to use all reasonable endeavours to maintain existing levels of customer service and promote a successful integration of the GEMINI brand into Tullis; and
- not to sell any GEMINI products which failed to comply with quality standards, and to comply with all relative and statutory and regulatory requirements.

## Inveresk's breaches

During the services period, the GEMINI products manufactured by Inveresk contained a considerably

higher proportion of defects than usual (3.5 times the historic average). In addition, Inveresk dealt with customer complaints directly without including Tullis and evidence demonstrated that they had adopted an antagonistic attitude towards customers who complained about GEMINI products during that period.

Tullis sued, seeking compensation for Inveresk's actions and breaches during the services period, which they argued had diminished the value of the GEMINI brand.

Lord Drummond Young accepted Tullis's argument that in the paper industry a certain number of quality complaints were inevitable since paper and board are largely natural products, and as such, essential components of any such business were (1) a good quality control procedure; and (2) a good complaints handling procedure.

The court held that Inveresk was in breach of its contractual obligations to Tullis. The value of the GEMINI

brand and its goodwill lay in the likelihood that customers who had purchased or considered purchasing GEMINI products would do so in the future. By failing to manufacture products of a satisfactory quality and then dealing with the resultant complaints poorly, Inveresk damaged the brand.

### Nature of the loss

Tullis argued that their losses comprised:

1. loss of sales and a consequent loss of profits on those sales; and
2. loss of future profits due to important customers of the GEMINI brand either ceasing to purchase the GEMINI products or purchasing them in far reduced quantities compared to their historic orders.

Lord Drummond Young considered that these heads of loss were an appropriate measure of the damage to the brand's value. A brand has value through being converted into additional sales and thus additional cash flow. These losses related to the degree to which revenue generation was impaired by Inveresk's actions.

### Causation

Tullis successfully established that the losses it had suffered were caused by Inveresk's actions. They demonstrated a fall in GEMINI orders during or shortly after the services period. The court accepted that in the paper industry, the brand was more important to the customer (typically paper merchants) than the identity of the manufacturer, and that if a brand was perceived as unreliable or defective, the customer would switch brand. There was evidence that some GEMINI customers had indeed done so. Other factors relevant to causation included the nature of the paper industry and the effects of changes of brand ownership within that industry.

### Quantifying the loss

Both Tullis and Inveresk led detailed expert evidence on loss quantification. The main disagreement between the experts was whether quantification should be assessed by (i) considering each

customer individually and whether Inveresk's actions resulted in a loss of business from that customer; or (ii) by selecting a portfolio of customers, and establishing the likely drop in sales to each portfolio as compared to the likely sales if there had been no breach of contract.

Lord Drummond Young preferred the portfolio approach. He considered that it was more statistically robust and adequately took effect of customer-specific events which could otherwise affect the calculation. A customer-by-customer approach would be largely impractical and more prone to customer idiosyncrasies.

Three representative portfolios of customers were identified. Tullis's expert then estimated the difference between the actual sales, and the likely sales to each portfolio had there been no breach of the quality standards and compliance with the licence terms, with reference to three alternative accounting methodologies: (1) estimating likely sales on a customer by customer basis; (2) estimating likely sales by reference to sales to customers not affected by the breaching acts; and (3) estimating likely sales by reference to the market share the GEMINI brand would have enjoyed had there been no breach.

The judge considered the results of all of these calculations and concluded that damages should be awarded towards the top end of the range of average losses.

### Commentary

This judgment is a salutary warning for licensees that a failure to adhere to terms relating to product quality and customer service can result in a large financial penalty. It also contains very useful detailed analysis of the methods used to quantify Tullis's losses, and the court's approach to quantification and to expert evidence on such issues. It also demonstrates that the Scottish court was firmly of the view that the value of the brand was at the heart of the transaction and needed to be robustly protected.

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# Freedom is priceless, but General Court rules out Free mark

**Case T-365/09, General Court, Michalakopoulou Ktimatiki Touristiki AE v OHIM, Intervener – Free SAS, 27 October 2010.** The General Court has dismissed an appeal by the opponent to a CTM application, in a case involving highly similar marks but goods and services with a low degree of similarity. The decision of the court reinforces the fact that appeals to the General Court are just that – appeals, not a chance for the case to be decided afresh. **Patricia Kelly** reports.

In October 2003 a CTM application was filed for the word mark FREE covering goods in class 16, including “publications, magazines, newspapers”. The application was filed by Eidikes Ekdoseis AE, a company which was later taken over by the applicant in the present appeal, Michalakopoulou Ktimatiki Touristiki.

The application was opposed by Free SAS under Article 8(1)(b) of the CTMR, on the basis of an earlier French registration for the word mark FREE, covering services in class 38 relating to messages and messaging, and on the basis of a French registration for the mark (right), covering services in classes 35 and 38, including: “advertising, newspaper subscription services for third parties; electronic mail services and electronic distribution of information particularly for internet-type worldwide communication networks”:

The opposition also included Article 8(4) grounds, on the basis of the company name FREE; the trade name FREE, and the domain name ‘free.fr’. The Opposition Division rejected the opposition in its entirety. The intervener appealed and the First Board of Appeal upheld the opposition insofar as it was based on Article 8(1)(b).

## Appeal to the General Court

Michalakopoulou Ktimatiki Touristiki AE appealed to the General Court, arguing that the decision should not be upheld as the Board of Appeal did not state reasons in support of all aspects of its decision. They also called into question the Board of Appeal’s findings on similarity of goods and services, as well as those

on similarity of marks and likelihood of confusion.

The court firstly considered whether the appeal was admissible as at the date on which the appeal was lodged by the applicant the transfer of the contested application to that party had not yet been registered with OHIM. The court ruled that the appeal was admissible. The takeover of Eidikes Ekdoseis occurred and was registered with the appropriate registry prior to the issuance of the Board of Appeal decision. The relevant national law made clear that from the date of registration of that



transaction the applicant took the place ipso jure of Eidikes Ekdoseis. The court was of the view that the right to bring an action could be exercised by the transferee of a business.

In terms of the Board of Appeal’s findings under Article 8(1)(b), the applicant argued that they did not explain why the services covered by the earlier word mark were similar to the goods covered by the mark applied for but just commented on the similarity between those goods and the services covered by the earlier figurative mark. The court stated that, whilst Article 75 of the CTMR places a duty on OHIM to state the reasons on which decisions are based, the question of whether that duty is fulfilled is to be assessed by reference to the wording of the decision in question, its context and the whole body of legal rules

governing the matter in question. Article 42(5) of the CTMR makes clear that in making a decision in an opposition, OHIM simply has to determine whether there is a ground for refusal of registration which warrants the rejection of the trade mark application. It is not required to make a decision in relation to each of the grounds put forward in the opposition. Therefore, the fact that the Board of Appeal did not comment on the similarity of goods and services in relation to the earlier word mark did not mean that the decision handed down was vitiated by a failure to state reasons or inadequate reasoning. The fact that the comparison was made in relation to the figurative mark was sufficient.

In relation to the similarity of the goods and services in question, the applicant argued that the purpose of the publication of magazines, newspapers and books covered by the mark applied for cannot be regarded as being similar to that of the services covered by the earlier figurative mark, such as the distribution of information by telecommunication networks and the internet. They were of the view that the effect of considering such goods and services to be similar would be to monopolise the distribution of a wide range of information to the detriment of the public.

The applicant pointed out that information services fall within a number of classes of the Nice classification, according to the subject matter of the information in question, so that, in order for the various types of information distributed to be regarded as similar, such similarity must be based on common uses or users and on similar purposes or channels of distribution. They also



argued that the services offered by the opponent are not in any way connected with the distribution of information to be found in a magazine or newspaper but solely with information relating to information links and telecommunications. They stated that the information covered by the earlier figurative mark, which is distributed as a service, may take a great variety of forms, and that such services are therefore not similar to the goods covered by the mark applied for.

The court pointed out that the comparison of the goods/services must relate to those covered by the specifications for the marks in question, and not to those for which the earlier mark has been used (unless there have been proof of use proceedings, which was not the case here).

The court held that the Board of Appeal, who considered the relevant public for these purposes to be average French-speaking consumers, did not err in considering that the printed publications covered by the contested CTM application have the same purpose as the online information distribution service covered by the earlier figurative mark. The Board of Appeal was also found to be correct in considering that the differences in the nature and distribution channels of the goods and services at issue are not sufficient to cancel out their similarity, since, for persons at whom the publications and services in question are directed, what matters is to obtain the desired information. The medium by which that information is provided is of secondary importance. It was therefore held that the Board of Appeal was correct to conclude that there was some similarity between the goods/services in question.

The court then considered the applicant's arguments in relation to the comparison of the signs in question. The applicant argued that the dominant element of the earlier figurative mark was not the word "free". They felt that the mark creates the impression of an indivisible whole, composed of the word "free", the slogan 'la liberté n'a pas de prix' ('freedom has no price') and a leaping silhouette and it is not possible to

regard the latter two elements as negligible. The applicant argued that the relevant public would pay more attention to the slogan written in its native tongue and that the word "free" is a common word which needs the slogan to give the mark a distinctive character.

The applicant felt that the presence of the slogan ruled out any aural similarity with the mark applied for and that the marks are conceptually different as the earlier mark evokes freedom of movement and economic freedom and the mark applied for evokes individual freedom. The applicant was therefore of the view that the Board of Appeal erred in finding that there was a likelihood of confusion.

The court pointed out that as the Board of Appeal did not carry out an assessment of similarity of goods/services in relation to the earlier word mark, that mark could not be taken into account for the purpose of assessing whether there is a likelihood of confusion. In considering the earlier figurative mark, the court was of the view that the word 'free' forms the dominant element within the overall impression created by the mark. They pointed out that the word has a much more distinctive character than the slogan contained within the mark; the word 'free' dominates the visual impression created by the mark, because it is considerably bigger than the other components and is much easier to remember and pronounce than the slogan. They felt that it was the visual domination which conferred on the leaping silhouette a sense of the context of the mark. They pointed out that the word 'free' is widely used not only among the English-speaking public but also among all other persons with a basic knowledge of the English language who form part of the relevant public, and that the silhouette in question does not have any particularly striking characteristics which might detract attention from the element 'free'.

The court therefore ruled that the Board of Appeal was correct to conclude that the conflicting marks are visually and aurally similar, since the average consumer will read, pronounce and remember principally

the word 'free' in the earlier mark. The court also held that the Board of Appeal was correct in finding that the marks at issue are conceptually the same, by taking account of members of the relevant public who understand the meaning of the word 'free', whilst those who are unaware of the meaning will not perceive any message. The applicant's arguments on the conceptual differences in the marks were dismissed on the basis that consumers relying on an imperfect recollection of marks were unlikely to be capable of making such a subtle distinction as to the conceptual content of the two signs at issue. It was therefore held that the Board of Appeal did not err in finding that the signs at issue are very similar.

In terms of the global assessment of the likelihood of confusion, the court pointed out that the Board of Appeal rightly observed that the low degree of similarity between the goods and services concerned is offset by the high degree of similarity between the signs at issue, so that the relevant public might be led to believe that the applicant's publications and the information distribution services offered online and via telecommunication networks by the intervener have the same commercial origin.

The appeal was therefore dismissed in its entirety.

### Conclusion

Whilst not stating anything new, this case is a useful reminder of the nature of appeals. It also provides a useful reminder of the fact that a very high degree of similarity in marks can indeed offset a lesser degree of similarity in goods/services, and that it is necessary to fully consider the goods/services covered by marks in opposition proceedings, rather than the goods/services actually in use. Finally, the comments on the similarity of the goods and services in question provide a reminder that it is important to consider such matters in the abstract, rather than simply on the basis of their classification, particularly when dealing with concepts such as information.

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# AX: establishing a new process for dealing with limited oppositions

Appeal to the High Court, 16 November 2010, International Trade Mark Registration 926043 designating the UK for AX in Classes 09, 12, 14, 16, 18, 24, 25, 26, 28 and 35 in the name of Giorgio Armani SpA and Opposition 71683 thereto by Sunrich Clothing Limited.

**Lydia Torne** reports.

On 23 March 2007, Giorgio Armani SpA (GA) filed an International Registration designating the UK for the wordmark AX in relation to "clothing, shoes, headgear" in Class 25. This application was subject to a limited opposition by Sunrich Clothing Limited (Sunrich) under section 5(2)(b) of the Trade Marks Act 1994 on the grounds that it was similar/identical to its earlier trade mark registration for AXE for similar/identical goods in Class 25, namely "clothing for men and boys".

The hearing officer found in both her initial decision and her supplementary decision (provided at GA's request) that the marks and goods were sufficiently similar to give rise to a likelihood of confusion on the part of the consumer and held that the opposition succeeded in respect of all goods in GA's Class 25 specification.

GA subsequently appealed to the court on the basis that:

- (A) the marks were not sufficiently similar to cause a likelihood of confusion on the part of the consumer; and
- (B) in the event the marks were similar, the hearing officer had unfairly and incorrectly treated the opposition as if it were an opposition to all of GA's Class 25 goods rather than just "clothing for men and boys"; accordingly, the remaining goods in Class 25 should proceed to registration eg,

"clothing for women and girls, shoes and headgear".

## Decision of the High Court

The court upheld the hearing officer's decision regarding the similarity of the marks and goods and agreed that there existed a likelihood of confusion on the part of the consumer.

However, the court held that the hearing officer had erred in failing sufficiently to acknowledge that the opposition was limited to a sub-set of Class 25 goods and by incorrectly finding that the opposition had been successful in respect of all GA's Class 25 goods.

In reaching this conclusion, the court rejected Sunrich's argument that, by failing to submit an unconditional application to amend its specification during proceedings, and, in view of the hearing officer being unable appropriately to amend the specification, the entirety of GA's Class 25 specification should fail. In rejecting this argument, the court noted that such an argument was inherently flawed due to the fundamental difficulties of an applicant providing such an amendment during proceedings whilst still preserving its position that the opposition should not succeed.

On finding itself without directly applicable precedent on this matter, the court applied the mechanisms suggested for dealing with problems of amendments to specifications in

Citybond Trade Mark [2007] RPC 13. The court held that the hearing officer should have realised that, if the opposition succeeded, GA's Class 25 specification would require amendment which the hearing officer could not make. Further, the hearing officer should have held a case management conference to establish a mechanism by which to address the possibility of amendment of the specification. The court remitted the matter back to the hearing officer to address amendment of the specification accordingly.

## Comment

This case provides some further authority as to how to deal with amendment of the list of goods/services following successful limited oppositions. Notably, the suggested solutions in Citybond include the provision of an interim decision on the opposition, thereby allowing an unsuccessful applicant to submit suitable amendments to its specification for the Registrar's consideration, prior to a final decision being made. In affirming and applying the solutions from Citybond in this decision, the court has taken a step towards establishing a new process for dealing with limited oppositions and it will be interesting to see whether such an approach is adopted by the Registry in due course.

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*Lisa Richardson*

## Fresh Direct win appeal

**0-367-10, Appeal to the Appointed Person, Iain Purvis QC, 6 October 2010, UK Trade Mark Application Nos 2482441 FRESH DIRECT & device (series of 3) and 2482442 FRESH DIRECT LOCAL & device (series of 3) in Classes 29, 31 and 39 in the name of Fresh Holdings Limited.** On 20 March 2008, Fresh Holdings Limited (FHL) applied

to register the word marks FRESH DIRECT (application no 2482441) and FRESH DIRECT LOCAL (application no 2482442) as part of a series. The device elements of the marks show a fruit being picked by hand (FRESH DIRECT) and a gate surrounded by hedgerows (FRESH DIRECT LOCAL). Both applications covered the same goods and services in Classes 29, 31 and 39, namely foodstuffs, agricultural products and the transport, packaging and storage of food products. **Lisa Richardson** reports.

On 30 April 2009, the hearing officer refused both applications in their entirety on the basis of sections 3(1)(b) and 3(1)(c) of the Trade Marks Act.

The hearing officer also held that the marks did not satisfy the requirements of a series mark as provided for under section 41(2) of the Act. The Appointed Person agreed with this decision. However, as the applications pre-dated October 2009 enabling the series application to be divided, this procedural issue could be remedied at a later date should the remaining marks in the series be found to be registrable.

Upon issuance of the hearing officer's decision, FHL filed an appeal against the decision for both applications and also filed two fresh UK applications for the same series of marks covering the same goods and services but this time partly relying upon distinctiveness acquired through use.

Before discussing the appeal decision, it is important first to review the outcome of the examination of the later filed applications. As before, the word-only marks were refused.

However, in contrast to the previous decision, the Registry this time decided that the word and device marks were inherently registrable for some of the goods and services covered by the applications.

Specifically, the application for FRESH DIRECT & handpicking device was found to be inherently registrable for all the goods and services covered by Classes 29 and 39. The application was also allowed for a limited specification, namely "fresh fruits and vegetables", in Class 31 on the basis of acquired distinctiveness through use.

The application for FRESH DIRECT LOCAL & gate device was found to be inherently registrable for some of the goods in Class 29 only, namely those not considered to be fresh products. However, the acquired distinctiveness claim for this mark was rejected.

### Hearing before Appointed Person

At the appeal hearing, a number of concessions were made by the Registrar following the inconsistency in the decisions reached. As a result, it was agreed that the later decisions were to be preferred and that the

The examination of a mark consisting of a combination of non-distinctive words and an allusory device element is clearly very subjective, which can result in different decisions as to inherent registrability being reached by different examiners.

mark FRESH DIRECT LOCAL & gate device was to be found to be inherently registrable for all services covered in Class 39 to bring it in line with the application for FRESH DIRECT & handpicking device.

In light of this, only four issues remained, namely the registrability of the word marks FRESH DIRECT and FRESH DIRECT LOCAL, the registrability of FRESH DIRECT & handpicking device for the remaining goods in Class 31 and the registrability of FRESH DIRECT LOCAL & gate device in Class 31 and for the remaining goods in Class 29.

### Decision

In respect of the word-only marks, the Appointed Person considered firstly the inherent registrability of FRESH DIRECT and FRESH DIRECT LOCAL in relation to all of the goods and services applied for and held them not to be registrable.

On consideration of the claim for acquired distinctiveness, whilst the evidence was found to show significant trade in the relevant area at the date of application, such trade was exclusively with business customers. A sponsorship deal with a show jumper and the use of the mark on lorries driving around the country were not sufficient to show that the general public (seen as the relevant class of person for the goods and services at issue), or a significant proportion thereof, would associate the marks with a particular undertaking and so this claim was rejected.

Following the hearing at the Registry, FHL, as a last-ditch attempt to secure registration on the basis of acquired distinctiveness, proposed the addition of a limitation to the specification, namely "all of the aforementioned goods to be sold in bulk on a wholesale basis". Whilst not yet commented on by the Registry, the Appointed Person took the opportunity to raise his concerns as to how the goods at issue could be properly defined by reference to trade channels or quantity of goods sold. This issue was not taken any further as the Appointed Person felt that such a request would need to be raised with the Registry at a later date either as an amendment to the current applications or as part of fresh applications.

With both word marks refused, FHL were left with the remaining word and device marks currently only accepted for some of the goods and services applied for, as outlined above.

The Appointed Person found it difficult to justify the rationale behind the Registry's acceptance of the device marks on the basis of inherent distinctiveness in relation to goods in Class 29 but not in relation to goods in Class 31. He believed the reasoning behind the decision came down to whether or not the goods listed in each class were fresh and locally produced, and that the Registry had found the device marks simply reinforced this idea.

As Class 29 includes meat, fish, eggs and milk, all of which can be fresh and locally produced, no such distinction can be drawn on this basis.

On consideration of the marks themselves, the Appointed Person found the device elements to be allusory at most and therefore inherently registrable, a decision consistent with the Registry's acceptance of the marks for goods in Class 29.

As a result, the Appointed Person overturned the hearing officer's decision to allow acceptance of the word and device marks as a series of two for all goods and services applied for.

### Comments/summary

The examination of a mark consisting of a combination of non-distinctive words and an allusory device element is clearly very subjective, which can result in different decisions as to inherent registrability being reached by different examiners.

One further point to note in this situation is that, should applicants wish to include a fall-back position by way of an amendment to the specification, this should be entered early on in the proceedings whether at an ex parte hearing or in written submissions. The Registry needs to be given the opportunity to review and comment upon such a request. An appeal to the Appointed Person is not the proper forum.

**Lisa Richardson**, *Boult Wade Tennant*,  
[lrichardson@boulton.com](mailto:lrichardson@boulton.com)

# Big changes in Greece

A year ago we published a discussion of myths and realities of Greek trade mark practice which tipped the scale in favour of adversities rather than efficiencies. Happily, a generally tough and demanding year later, progress has been achieved. Not to say that all is rosy, yet there are steps being made in the right direction.

New legislation expediting the process before the administrative courts in Greece (also affecting trade mark actions, following oppositions or cancellation petitions) has been passed in mid-December 2010, with a variety of progressive measures that have been much needed. Compared to those in the UK and US, the previous Greek administrative courts system was practically programmed for delays, dead-end procedures and frustrating postponement of results. Not so anymore. The primary aim of the legislator is expediting procedure, by fine-tuning each and every possible step that may affect the total process.

This should be made possible by implementing, among others, the following provisions: direct recourse to the highest administrative court level (Council of State) as well as allowing the pre-judgment opinion requests from lower courts to the Council of State whenever new issues requiring clarification or even the setting of new precedent arise; and a two-month time-frame for court hearings being scheduled, in significant or broadly applicable issues. These, in conjunction with new ADR routes being put in place currently, should help facilitate the judicial resolution of trade mark disputes in Greek jurisdiction. More will follow in the next ITMA Review. Stay tuned.

**Eleni Lappa**, *Drakopoulos Law Firm*,  
[elappa@drakopoulos-law.com](mailto:elappa@drakopoulos-law.com)

# Marlboro raise the roof in Singapore

Thanks to the ingenious advertising and marketing strategies of Phillip Morris Products SA (Phillip Morris), the MARLBORO brand is not only well known in most countries (to smokers and non-smokers alike) around the world, it also ranked at number 8 out of 100 on Forbes' list of valuable brands this year. **Geetha K** reports.

Phillip Morris, however, claims that it is not so much the word MARLBORO or the glorified brave cowboys and heroes of the early advertising years that influence cigarette buyers in Singapore to buy their cigarettes, instead, it is their unique packaging that consists of a roof device and the colour combination of its packaging that draws customers to purchase their cigarettes.

On this basis they filed an opposition to the registration of the trade mark COUNTRY for tobacco, cigarettes, matches and smoker's articles by PT Perusahaan Dagang Dan Industri Tresno (Perusahaan Dagang) before the Intellectual Property Office of Singapore (IPOS) on 14 November 2006.

Phillip Morris's trade marks have been used in Singapore since January 1981. On the other hand, Perusahaan Dagang has yet to use its trademarks in Singapore.

The crux of Phillip Morris's argument in the opposition lies in how the "roof device" in their mark is a prominent and distinctive element and that Perusahaan Dagang's device is visually similar to their "roof device". It was contended that although there are other elements such

as MARLBORO, MARLBORO LIGHTS and MARLBORO MEDIUM and a coat and arms device in each of Philip Morris's registered marks, they are not sufficient to distinguish the two marks due to the prominence of the "roof device".

In addition, Phillip Morris also submitted that there are similar colour combinations between the marks in dispute, such as;

1. Both marks have a red portion (consisting of a five-sided roof design) and a white portion.

2. The word 'Marlboro MEDIUM' in the opposition mark and the word Country in the application mark are in black.
3. The opponent's coat of arms and the applicant's shield device adopt the colours red and gold.
4. The words in the coat of arms in the opponent's mark and the words INTERNATIONAL and 20 A KING SIZE FILTER are represented in white.

IPOS, in considering the arguments above, and in comparing the two marks, held that Phillip Morris's opposition, which hinges at large on the fundamental similarity of the roof device and colour, was weak on all grounds.

This is because firstly, the roof device on Perusahaan Dagang's mark is on the side as opposed to the top and unlike Philip Morris's device, the device in Perusahaan Dagang's mark is asymmetrical. The roof device mark also cannot be used to determine overall similarity between the two marks as at most, the roof device only consist of 50% of the marks respectively. Other components on each mark have to be considered. In this case, the word elements on both marks take up the other 50% of the marks. It is clear that the two words are different. In the application mark, the main word is COUNTRY whereas Philip Morris's main words are MARLBORO, MARLBORO LIGHTS, and MARLBORO MEDIUM respectively.

The arguments by Philip Morris that there is a possibility that the shop assistant will place the packets of Perusahaan Dagang's cigarettes sideways, that the word COUNTRY is a normal, non-distinctive word and that the application by Perusahaan Dagang was made in bad faith were also dismissed by IPOS.

As both marks are composite marks, the words "talk" and this is especially when (as is the case with both marks) the roof device is not a well understood object. Therefore it was held that the dominant feature on Philip Morris's marks is the word MARLBORO and not the roof device. Comparing both marks in their entirety, it is clear that they are visually dissimilar. Therefore, there is no likelihood of confusion.

The above argument is also strengthened by the method in which customers purchase cigarettes in Singapore. Due to statutory restrictions, a customer cannot pick a pack of cigarettes off the shelf but must approach a counter staff for assistance. A customer will have to tell the shop assistance the brand of cigarettes they intend to purchase. This shows that it is the word MARLBORO which is pertinent.

This case is noteworthy because it gives a clear judgment on distinguishing composite marks and the importance of words in such marks. Although it is clear that Philip Morris has goodwill in relation to the MARLBORO mark in the relevant sector of the Singaporean public, namely the smoking community, there is no misrepresentation on Perusahaan Dagang's part.

On a whole, Phillip Morris's popularity as a cigarette brand due to its long-term presence and wide exposure in Singapore backfired for the brand to a certain extent, as customers would recognise Philip Morris's goods as those which encompass the word MARLBORO, and were less cognisant of the roof device, colour, or symbols on the packaging.

**Geetha K**, KASS International Sdn Bhd, [ipr@kass.com.my](mailto:ipr@kass.com.my)

## NEWS OF MEMBERS



Left to right: Ian Starr, Anna Reid, Tamsin Holman, Cam Gatta

D Young & Co LLP have launched its litigation practice on 1 January this year. The Dispute Resolution & Litigation Group is headed up by partners **Ian Starr** and **Tamsin Holman**, with new recruits **Camillo Gatta** and **Anna Reid** joining at associate level. It is the first firm of patent and trade mark attorneys to establish a legal disciplinary practice in the UK. Pitmans has strengthened its team with the promotion of **Sally**



Sally Britton

**Britton** to the position of director. Based at Pitmans' City of London office, Sally works within the Pitmans SK division of the firm, advising clients within the sports and entertainment arenas. She specialises in brand protection and exploitation, including trademark and design prosecution, portfolio management, infringement matters, ticketing issues and commercial contracts.

## STUDENT COLUMN

Happy New Year! We hope that 2011 is progressing well for all student members.

If you are waiting for results from the November 2010 exams, we wish you the very best of luck! The results are due to be published on Monday, 4 April 2011.

If you would like to receive your marks by email, please contact [sharon@jointexaminationboard.org.uk](mailto:sharon@jointexaminationboard.org.uk). Further information is available on the Joint Examination Board website. Please remember that this coming November is the last opportunity to sit all three advanced papers for the first time.

The Queen Mary Law Course and Intensive NLS Course are now underway. If you are currently attending either of these courses, we would like to receive feedback from you.

Don't forget to keep an eye on the Students' Area of the ITMA website for updates from the E&T Committee. If you have any queries in relation to the new qualification system, please consult the website as a first port of call.

The FAQ document and flow-chart are a great place to start, if you are not sure on your options. If your query is still unanswered, please direct it to [gillian@itma.org.uk](mailto:gillian@itma.org.uk) and we will endeavour to respond as soon as we can.

Finally, we are delighted to welcome four new student representatives to the E&T Committee: Elizabeth Dunn, Christopher Hawkes, Amie Jordan and Claire Keating.

Regards, **Sharon Daboul**, MW Trade Marks; **Jayne McClelland**, AstraZeneca; **Rebecca Tilbury**, Harrison Goddard Foote

## Notice on the publication of the JEB 2010 examination results

Results for the 2010 examinations will be published on Monday 4th April 2011.

Individual letters informing candidates of their marks in the various papers will be posted on Friday 1st April 2011 so that they can be expected to arrive on Saturday 2nd April 2011. The letters will be sent to the address given on the exam application form. Any change of postal &/or email address must be notified to me by Friday 25th March 2011.

In addition to posted letters we will send the results letter to candidates by email on Saturday 2nd April 2011. If you would like to receive your results by email please email me at [Sharon@jointexaminationboard.org.uk](mailto:Sharon@jointexaminationboard.org.uk) with the email address your results should be sent to and I can add you to the email notification list. Failure to advise me will result in your results letter only being sent by post.

Please note that examination results **will not and cannot** be given out over the telephone.

The JEB, CIPA and ITMA will post the pass lists on their websites on Monday 4th April 2011 at 11am so that candidates and others will be able to see the lists that morning.

Please note that neither CIPA or ITMA will be able to answer questions about the results.

**Sharon Mitchell**  
Secretary

The title of the case comment on page 16 of the December 2010 issue has been perceived as inappropriate, and we apologise to the author and to anyone who was offended by it.



Keith Robert Farwell

## Obituary: Keith Robert Farwell 1965 – 2010

Our partner Keith died suddenly and unexpectedly, on 15 December 2010. He had been recovering successfully from a major operation to counteract a long and debilitating illness. The courage with which he fought this illness; full on, not accepting any restriction to his activities, whilst fully aware of all of its implications, brought nothing but admiration from those who knew. It was a measure of the man that few guessed how ill he was.

He was the son of our retired partner, Bob Farwell.

Keith was dynamic and intellectually brilliant. He gained a BA in English from the University of York and an MA in Archaeology at University College London. This was followed by a career change, training and qualifying as a trade mark attorney with William Jones in Norwich. It was there that he met his future wife, Rebecca Chambers. Together they subsequently set up their own "boutique" trade mark consultancy, Farwell-Chambers; Keith working as a consultant to, among others, a multi-national pharmaceutical group, senior

London law firms, and Phillips & Leigh. Keith became a partner of Phillips & Leigh in 1999.

These are just the "bare bones" of Keith's professional career. Anyone who met him, either personally or professionally, could not but be impressed by his enthusiasm, voracious appetite for work, dominating competence and single-minded devotion to whichever project he was concerned with at the time.

These attributes not only benefited our practice, especially our clients, but the IP profession as a whole.

He edited, or contributed to:

*The Trade Marks Handbook (Sweet & Maxwell, 1991 onwards)*

*The Community Trade Marks Training Manual (CIPA, 2000; new edition 2005)*

*Training Manual on International Registrations (Madrid System)(CIPA, 2006)*

*The UK Trade Marks Training Manual (CIPA, 2001; new edition 2007)*

*Foundation Level Trade Mark Law for*

*Patent Attorneys (CIPA, 2009)*

*The Community Trade Marks Handbook (Sweet & Maxwell, 2001 onwards)*

*Foundation Level Training Manual: The Principles of Trade Mark Law for Patents Candidates (CIPA, 2010)*

He lectured in trade marks to students studying at Queen Mary College, University of London. He served for four years as an Examiner to the JEB. He had been a member of the CIPA Trade Marks Committee (serving as Vice-Chairman) and was a member of the CIPA Textbooks & Publications Committee with special responsibility for the training manual series.

For one so relatively young, his contribution to pre- and post-qualification training for patent and trade mark attorneys was immense and unparalleled.

It was for The Community Trade Marks Training Manual that he received the rare honour of being elected, at the young age of 38, a Fellow of the Institute of Trade Mark Attorneys; a measure of his standing in the trade marks profession.

Keith leavened his professional loaf with a continuing interest in archaeology and a taste for single malt whiskies. He was an enthusiastic dog-walker and O-gauge model railway builder. In the family tradition, he amassed a huge collection of books. Keith and Rebecca also enjoyed travelling to exotic places worldwide and, latterly, touring Europe in their enormous camper van.

At Phillips & Leigh we will miss and never forget him, he leaves a big hole in our lives. He is survived by his wife Rebecca; they had no children.

A small funeral service was held in Norwich on 6th January 2011.

In memory of Keith we are gathering at Dr. Johnson's House [www.drjohnsonshouse.org](http://www.drjohnsonshouse.org) at 6 o'clock on Thursday 24th February 2011. All are welcome, but we would be grateful for an email to [enquiries@pandl.com](mailto:enquiries@pandl.com) should you plan to come.

*The Partners and Staff of Phillips & Leigh*

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# FORTHCOMING EVENTS 2011

Date	Event	Location	CPD Hours
8 February	<b>ITMA Charity Quiz Night</b>	Penderal's Oak, London	0
11 February	<b>International Registration of Designs Workshop ITMA, ECTA, WIPO &amp; IPO</b>	Bird & Bird, London	3.5
11 February	<b>Trade Mark Administrators' Seminar</b>	Marks & Clerk, London, London	0
15 February	<b>ITMA London Evening Meeting Clark Lackert, Dickstein Shapiro LLP, U.S.A. 'Global Brand Protection Against Online Infringements'</b>	Royal College of Surgeons	1
15 March	<b>ITMA London Evening Meeting</b>	Royal College of Surgeons	1
16-18 March	<b>ITMA Spring Conference</b>	Claridge's, London	9
16 March	<b>Dinner with ITMA at Claridge's</b>	Claridge's, London	0
17 March	<b>Dinner with ITMA at The Natural History Museum</b>	Natural History Museum, London	0
21 - 22 March	PTMG 82nd Conference	The Grand Hotel, Brighton	
19 April	<b>ITMA London Evening Meeting &amp; Reception</b>	Royal College of Surgeons	1
14-18 May	INTA 133rd Annual Meeting	San Francisco, California, USA	
9-11 June	ECTA 30th Annual Conference	Stockholm, Sweden	
21 June	<b>ITMA London Evening Meeting</b>	Royal College of Surgeons	1
12 July	<b>ITMA Summer Reception</b>	HQS Wellington, London	0
19 July	<b>ITMA London Evening Meeting &amp; Reception</b>	Royal College of Surgeons, London	1
13 September	<b>ITMA London Evening Meeting - Kris Williamson, Advocacia Pietro Ariboni, Brazil - 'National and Madrid filings, plus South American developments'</b>	Royal College of Surgeons	1
13-16 September	Marques Conference	Baveno, Lake Maggiore, Italy	
12-15 October	PTMG 83rd Conference	Prague, Czech Republic	
25 October	<b>ITMA London Evening Meeting &amp; Reception</b>	Royal College of Surgeons, London	1
15 November	<b>Joint ITMA &amp; LES Annual Seminar</b>	Royal College of Surgeons, London	tbc
29 November	<b>ITMA London Evening Meeting &amp; Reception</b>	TBC	1

More details can be found at [www.itma.org.uk](http://www.itma.org.uk). Bold type indicates an ITMA organised event.

ITMA London Evening Meetings & Receptions kindly sponsored by Corsearch

