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ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

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HOW BRANDS BLIND OUR BRAINS

DISCOVER THE HIDDEN SYSTEMS THAT HELP TRADE MARKS
GAIN POWER OVER CONSUMERS **DR CHRISTIAN SCHEIER** p14



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welcome

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ITMA contacts

General enquiries

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

Committee chairs

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

Events: Maggie Ramage,
maggie.ramage@edwincoe.com

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

Law & Practice: Imogen Wiseman,
imogen.itma@cleveland-IP.com

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

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Editor: Caitlin Mackesy Davies

Advertising: Tony Hopkins,
tony.hopkins@thinkpublishing.co.uk

Group Account Director: Polly Arnold
Account Manager: Kieran Paul

Art Editor: Clair Williams

Designer: Alix Thomazi

Sub-editor: Mike Hine

ITMA Review

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

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I had the pleasure, in late January, of delivering the first lectures to those embarking on our 2016 Trade Mark Administrators' Course. One attendee asked how many years' practice are required as a Trade Mark Attorney before a letter from that Attorney would scare its recipient. I answered, in jest, "30 years", which is coincidentally the length of my career in trade marks. As *tempus fugit*, I am approaching the end of my Presidency. But fear not; our forthcoming elections will produce a new President to occupy page three of the *ITMA Review*.

As always, this issue has a broad variety of content to enjoy in the meantime, including reports on this year's charity quiz night and our first moot appeal, an insight into the Orla Kiely empire and contributions from France, the Antipodes and the US.

I will sign off with a personal note of congratulations to our First Vice-President, Kate O'Rourke, awarded an MBE for services to further education.

Chris McLeod
ITMA President

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iTMA Insider



ITMA Vice-President awarded MBE

ITMA First Vice-President Kate O'Rourke has been recognised for services to further education in the New Year's Honours list with an MBE.

For 20 years, Kate has been a member of City and Islington College's governing body, and its Vice-Chair since 1998.

A registered Trade Mark Attorney and Solicitor at Charles Russell Speechlys LLP, Kate leads the trade mark registration and protection team. Her work includes advising on the adoption, registration and enforcement of trade marks and designs internationally.

She has been a member of ITMA for 26 years and has been on its Governing

Council since 2007, becoming First Vice-President in 2014.

Kate said: "I feel very privileged to have been part of City and Islington College for so long, as it has given me wonderful opportunities to work with great people, and for such a great enterprise. Receiving an MBE is just the cherry on top of the ice cream."

After qualifying as a Solicitor in Australia, Kate worked for three years in Sydney before moving to New York to work for the Australian Consulate. After a year in the US, she moved to London and qualified as a Trade Mark Attorney by examination before qualifying as an English Solicitor.

MEMBERSHIP & ENGAGEMENT OFFICER JOINS

We are delighted to announce the appointment of Gavin Graham, who has joined the ITMA Office as Membership and Engagement Officer. Gavin will be responsible for processing new membership applications and renewals, developing and analysing membership data, handling and responding to membership queries and assisting with membership communications.

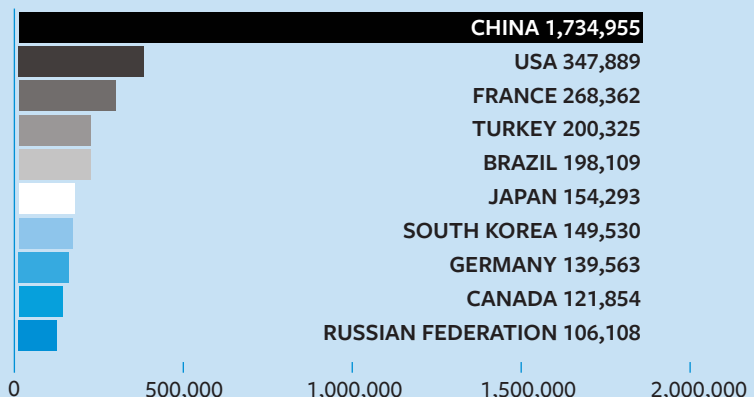
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IP INFO: WHO WAS MOST ACTIVE IN TRADE MARKS IN 2015?

Top 10 countries with published trade marks across all classes

Excerpted from Thomson Compumark's *Annual Trademarks Report: Global Insights on Trademark Trends*, December 2015

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NOTE: Individual marks may be covered in more than one class. Community Trade Mark data not included in this analysis.

SOURCE: THOMSON COMPUMARK SAEGIS ON SERION



Member moves

Elkington and Fife is pleased to announce that **Daniel Sullivan**, formally of Forresters, joined the firm as a Senior Trade Mark Associate in January 2016. Daniel is based in the firm's London office and is contactable by email at Daniel.Sullivan@elkfife.com and by telephone at +44 (0)20 7936 8800.

Helene Whelbourn has joined the London office of Ablett & Stebbing as Senior Trade Mark Associate.

HGF is delighted to announce the arrival of **Jonathan Thurgood** who joined the firm from Carpmaels & Ransford.

Novagraaf's London office has moved to: 2nd Floor, Renown House, 33-34 Bury Street, London EC3A 5AR. Telephone: +44 (0)20 7469 0950.



CHARTER CHECK-IN

On 23 December 2015, ITMA received notification from the Privy Council Office that Privy Council Advisors are formally content with our Petition for a Royal Charter. This is a significant step in the process, but it does not mean we are guaranteed to be granted a Royal Charter and Chartered status. The next stage is for the documentation (the draft Charter and Bye-Laws) to be considered by the Attorney General from a legal perspective. At the time of writing, we are awaiting any comments from the Attorney General.

IN MEMORIAM: DAVID KELTIE 1938-2016



Iwant to create something amazing," isn't a phrase one expects to hear from an IP firm Equity Partner nearing 50. But David Keltie's motto was that, the older you get, the more risks you should take.

So it was that David found himself at Barclays explaining his dream to start a new kind of firm, one in which everyone could grow as people, working together as equals and communicating without fear. With funding agreed, David Keltie Associates opened in December 1988. The unconventional firm reflected its founder's background.

David was born in New Zealand in 1938, the son of a chiropractor. Building on his father's profession, he became a Chartered Physiotherapist, probably uniquely in the IP world. In his early twenties, David set his sights on the US. On the way, he planned to stay for a while in London – but loved it too much to leave. He studied for medical school while practising physiotherapy. One day, a patient said her boyfriend worked for a firm of patent agents. "What's one of those?" asked David. And that was that.

Having persuaded Page White and Farrer to give him a try, David then quickly made himself indispensable. After a while he moved to Haseltine Lake, and later to Baron & Warren, where he developed into a highly skilled and respected Trade Mark Attorney. His then assistant Rosemary Cardas moved with him to co-found David Keltie Associates, in which she later became a partner.

His new environment liberated and amplified David's extraordinary

qualities. Few will ever forget having met him in his pomp. Possessed of the most all-consuming laugh in Christendom, he had child-like exuberance coupled with rock-solid professionalism and a gargantuan appetite for hard work.

It was the greatest joy of David's career that his creation began to snowball as like-minded people were attracted to it. He gave a voice to everyone, ensuring that there was no "them", only one "us". As soon as he could, he awarded equal partnerships; at his insistence, the firm never had a senior partner.

Reflecting its growth, the firm rebranded as Keltie in 2005. David was delighted that the firm won a Queen's Award for its export performance, but he took special satisfaction in its successive high rankings among the *Sunday Times'* Best Companies to Work For.

David dealt with the ageing process by battering it into submission, running marathons in his fifties, scaling mountains in his sixties and continuing to cycle into his mid-seventies. He passed away peacefully on 6 January 2016 after a long illness, bravely fought.

Blessed with inspirational charisma, David radiated love, generosity, encouragement and compassion to colleagues, clients and associates around the world. He was loved dearly by so many people in return, who mourn him with profound gratitude for the difference he made to their lives.

Contributed by Keltie Partnership. A full version of this obituary is available at ipcopy.wordpress.com.

ELWYN ROWLAND ROBERTS

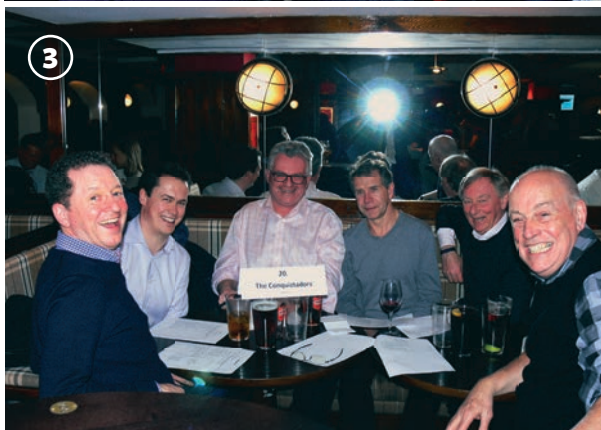
ITMA is sorry to report that Elwyn Rowland Roberts passed away at the end of January. Elwyn was a Fellow member of ITMA until 2000, and an Honorary member until 2007.



UDL does it again



For a second consecutive year, Urquhart-Dykes & Lord LLP takes top spot at ITMA's annual charity quiz night



WHAT'S YOUR SCORE?

Try out five of the night's toughest tests.

1. Turmeric, used in making curry powder, is a member of which family of plants?
2. "You're gonna need a bigger boat" is a line from which film?
3. In 2015, the Prince of Wales was reported to have begun wearing which type of eyewear in private?
4. Which American writer described golf as "a good walk spoiled"?
5. What does a British boxing champion get to keep if he wins three title fights at the same weight?

1. Ginger / 2. Jaws / 3. Monocle / 4. Mark Twain / 5. Lonsdale Belt

- 1) The winning team, the Sixth-Form Leavers, will donate its share of the £1,757 raised to Magic Breakfast. The remainder will go to the ITMA Benevolent Fund. Left to right: Gordon Harris (of Wragge Lawrence Graham), Mark Taylor (of Westbury Research), Mark Green, Edith Penty Geraets, Anna Szpek (all of UDL; Alison Simpson not pictured)
- 2) Imability (Abel & Imray); left to right: Chloe Wildman, Richard Smith, Emily Teesdale, Matthew Smith, Julia Coggins, Richard Mair
- 3) Conquistadors (Keystone Law); left to right: James O'Flinn, Richard Raban-Williams, Matthew Duggan, Oliver Goodwin, Ian Taylorson, Geoffrey Pickerill
- 4) Bill & Ted (Withers & Rogers); left to right: Nicholas Jones, Jon Hauser, Becky Davidson, Rob Patterson, Mark Caddle, Charles King
- 5) A closer look at the coveted winner's trophy



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Birds of a feather?

*Two iconic birds, one chance to make a winning argument.
Jade MacIntyre reports on ITMA's recent moot appeal*

ON 19 JANUARY, Bristows LLP hosted a moot appeal featuring Jack Wills Ltd v House of Fraser (Stores) Ltd [2014] EWHC 110 (Ch), also known as the “Pheasant v Pigeon” case. Former Lord Justice of Appeal Sir John Mummery presided, and his Hogarth Chambers colleagues Guy Tritton and Amanda Michaels represented the Appellant (HoF) and the Respondent (JW) respectively. Jeremy Blum of Bristows chaired the event.

Tasked with a rather difficult appeal, Mr Tritton tried to persuade the Appeal Court that the Judge had erred in his application of Article 9(1)(c) of Council Regulation (EC) No 207/2009. Much of Mr Tritton’s argument revolved around paragraphs 110 and 111 of the judgment and the Judge’s use of the phrase “in the minds of some consumers”. Mr Tritton submitted: that the Judge had erred in his application of current case law by not considering the matter from the perspective of the average consumer; that JW had not identified any factor in which HoF’s use of the Pigeon mark was unfair; and, finally, that the Judge had erred in his finding that a change in the economic behaviour of HoF’s consumers was sufficient to find the link required in Intel. In responding to the Appellant’s case, Ms Michaels submitted that the Judge was correct in his findings, that no findings of fact had been challenged, and reminded the Court that JW’s claim of Article 9(1)(b) infringement succeeded.

In presiding, Sir John ensured that the audience understood that an appeal is very different to a trial and is not, as some counsel think, a retrial. Sir John stressed that Appeal Courts (usually) start with the assumption that the Court below was right and so they need convincing to overturn the original order. Sir John reminded the audience that it is the order from the Court that is appealed, not the reasons for the judgment, and that the Appellant

should be able to state, briefly and very much to the point, what exactly it thinks is wrong with the judgment, as opposed to making a number of (less crucial) points and relying on strength of numbers. Ideally, the Appellant must be prepared to show why the order was wrong within the first 15 minutes of an argument.

In order to be effective as an advocate, preparation and presentation are hugely important, and a good, persuasive argument could potentially win the appeal. In contrast, pointless arguments annoy a Judge. In this appeal, Mr Tritton had the Appellant’s advantage of setting the agenda. Ms Michaels demonstrated how advocates need to be flexible – as the Appellant doesn’t always follow the path you may think from reading the written skeleton – and so amended her arguments reactively. Ms Michaels showed that the Respondent should always remember to emphasise the positive outcomes of the case and reiterate the facts that the Appellant has accepted, as often only a small part of the judgment is appealed and the judges may need a reminder of the bigger picture.

While no official judgment was given in the moot, the whisper among attendees was that Sir John would have dismissed the appeal. ■



► **The version of the pigeon logo used by House of Fraser (left), and Jack Wills’ logo (right)**



Jade MacIntyre

is an Associate (Trade Mark Attorney)
at Bristows LLP
jade.macintyre@bristows.com



KEEPING UP WITH ORLA KIELY

What does it take to safeguard a diversified international design brand? Carrie Bradley brings us into the loop

Innovative designers have a wealth of IP rights at their disposal and identifying these, developing protection strategies and understanding how best to utilise rights requires a focused and considered approach. This, together with a carefully managed portfolio of overlapping rights, is exactly how contemporary designer Orla Kiely is able to protect the creative output and investment that goes into her designs, keeping competitors at bay and preventing them from undermining the identity of her brand.

SKILLED WORK

Although the courts have made it clear that the definition of what constitutes a work of artistic craftsmanship is narrow, Orla Kiely generally encounters no difficulty in establishing that copyright subsists in new designs the brand creates, which

“

Because the brand has achieved such a high level of goodwill, passing off claims have also been useful in preventing the false endorsement of goods – where the name or imagery has been used without permission

are recognised as being original artistic works involving skill and labour. Her bold, retro-inspired print designs, which feature in a collection of womenswear, accessories and homeware, often include orderly, repeating lines and arrangements of abstract shapes.

The designer’s two-dimensional designs, such as colour combinations, surface decoration and texture, also automatically attract unregistered design right protection for a limited number of years. Such unregistered design rights are specifically intended to provide immediate protection for designs that have a short shelf life (as in the case of the fashion industry).

However, while copyright and unregistered design rights are useful tools in protecting her works, both schemes have limitations. As such, the formal registration of designs is a key priority and, crucially, dispenses with the need to evidence that direct copying has taken place. It also has the advantage of denying infringers the opportunity to rely upon obvious defences, such as the infringing design was “thought up independently”.

Reviews and design-filing programmes are undertaken annually in order to capture and protect the next season’s designs.

BRAND PROTECTION

Orla Kiely’s worldwide recognition has meant that her name, signature and commonly used logos require worldwide protection. Classic designs can often become synonymous with the brand that created them and, in Orla Kiely’s case, the identifiable characteristics that distinguish her

designs from others have connected and engaged with consumers, leading to their emergence as brands in their own right.

The multi-coloured leaf device shown in Figure 1 is an example. In the early days of her career, Kiely first created and applied a multi-stem pattern to cloth laminated onto handbags. It now appears across all of her product ranges, from wallpaper to kitchenware, and on product packaging and related marketing materials.



FIGURE 1

PORTFOLIO APPROACH

By incorporating both registered trade marks and registered design protection into a broader portfolio, the Orla Kiely brand benefits from an enhanced level of legal protection. Crucially, the differing nature of the complementary rights increases the scope and range of enforcement methods available.

This means that action can be taken to stop others unfairly taking advantage of her IP in a broad range of situations.

In particular, registration of Orla Kiely designs protects their use in ways that trade mark law may struggle to enforce, for example in relation to non-competing businesses or comparative advertising.

Likewise, the ability to bring credible trade mark infringement and/or passing off actions also plays an

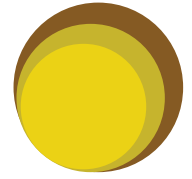
essential role in protecting the brand’s goodwill and reputation.

Because the brand has achieved such a high level of goodwill, passing off claims have also been useful in preventing the false endorsement of goods – where the Orla Kiely name or signature brand imagery has been used without permission.

TYPICAL ISSUES

Predictably, Orla Kiely’s success has made the brand an obvious target for infringers. However, a multi-layered protection strategy provides an effective toolbox for warding off challenges. The most common type of infringement that Orla Kiely encounters concerns variations of her famous multi-stem print, and disputes with department stores, fashion retailers, homeware and furniture companies, and discount stores are also frequent. Constant monitoring for counterfeits and imitations that appear for sale on common auction and retail websites is also necessary. These can often be trickier to identify, as it is less easy to spot non-genuine products with an extensive and seasonally changing product range to police.

Often, we will find designs on products that are similar to those in the Orla Kiely range and which feature extracts from her designs, or cases where slight alterations to a design have been made in the hope of demonstrating that the additional elements are not covered by the scope of the brand’s rights. This is where having a range of rights comes into its own. In particular, being able to argue an infringing article is “similar” to



PROTECTION STRATEGIES FOR DESIGNERS

For well-established designers such as Orla Kiely, it is evident that there are a number of types of IP protection that are essential in order to best protect their key assets and the value of their businesses. For smaller or start-up designers, there are also some lower-cost best practices that can be adopted to make a significant difference in improving their legal position:

- Keep detailed records of the creative process – note pads, sketches, patterns etc are invaluable in defending allegations of Community unregistered design right infringement. If designers document the evolution of a design prototype, these materials can be used to demonstrate that a design was created independently, thereby evidencing that a Community unregistered design right was not copied (thus defeating the claim for infringement). Importantly, contemporaneously date-stamping these records can greatly assist designers in later proving the date of creation and ownership.
- Use appropriate notices of IP rights to prevent claims of innocent infringement – it can be difficult to counter an assertion by an adversary that it has innocently infringed your design. Having clear notices on published materials in which protected matter appears can be a neat way of overcoming or preventing this argument.
- Take full advantage of automatic copyright and unregistered design rights – if you experience an infringement issue and have no registered protection, consider or take advice on what options you may have in terms of using your unregistered rights to tackle the infringement.
- Ownership of designs must be clear – if you are not the sole designer for your company, ensure that employment contracts are clear about who owns anything that is created, and ensure that, where there are any doubts over ownership, appropriate agreements or assignments are put in place.
- Consider the strength of your portfolio of rights and where protection may need bolstering – as a design business grows, it should carefully consider the balance between the cost of protection and cost of infringement in the absence of adequate protection. Budgeting for IP protection is usefully done on a rolling, annual basis, and regular health checks/reviews of your activities to see which of them may lend themselves to protection are a must.

a trade mark, “substantially similar” to one of her copyright works, or that it creates the same “overall impression”, notwithstanding the different elements of the design, means that we can cover most bases.

Another common issue for the brand comes into play when finished products are bought and made into other products by fans, and the modified products are then commercialised. For example, Orla Kiely bed sheets are frequently purchased so that the fabric can be used to make curtains and cushion

covers, or Orla Kiely wallpaper is used to decorate lampshades. This frequently happens with her Rhododendron design (Figure 2).

Normally, when a product is bought, the buyer has the right to use and re-sell that product as he

or she wishes in accordance with the protection afforded through the doctrine of exhaustion. However, there are certain exceptions where these provisions will not apply.

While Kiely is always flattered to have her work admired, action has to be taken against the modification and commercialisation of her products in this way. For one thing, the modified goods are generally of a much lower quality and standard of finish than the equivalent products in her own range, and this means there is the potential for them to be very damaging to her brand and reputation (if the inferior goods are mistakenly believed to be genuine).

Of even greater concern is the fact that the modified goods are untested and uncertified in respect of the relevant health-and-safety legislation and could potentially cause harm or be unsafe. Naturally, Orla Kiely is obligated to take action to prevent their sale.

While safeguarding Orla Kiely’s creativity and repute requires an ongoing commitment to the protection and enforcement of IP rights, it is clear that these efforts are paramount in preserving her long-term success and brand value. ■

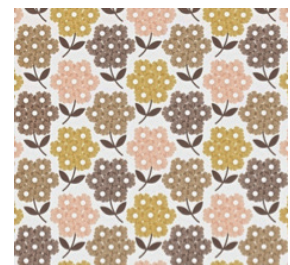


FIGURE 2



Carrie Bradley

is a Senior Trade Mark Attorney at Stobbs IP
cbradley@stobbsip.com

Chris Hawkes, Solicitor at Stobbs IP, co-authored this article.
Stobbs IP is proud to represent Orla Kiely.

SPOILT FOR CHOICE?

Not when it comes to selecting the correct UK court, warns Gill Grassie

Forum non conveniens (FNC) is a common-law principle applied by the courts to allocate disputes to the most appropriate forum, taking into account the interests of the parties and the ends of justice. It is, in broad terms, of no relevance to cases where the competing jurisdictions are European Union Member States, as FNC is excluded in terms of the Brussels Regulation (EU) No 1215/2012. However, it remains alive and kicking as far as courts in the UK are concerned. This has been demonstrated in two recent English cases that went to the Court of Appeal: *Cook v Virgin Media Ltd* and *McNeil v Tesco plc* [2015] EWCA Civ 1287. Both considered whether FNC can apply in the domestic context of the UK, and in particular in allocating disputes to the Scottish and English courts.

These cases demonstrate that a misguided, intra-UK forum-shopping exercise can have adverse consequences where parties have a choice between the Scottish or English courts. This is because one or the other may be judged as not being the more appropriate or convenient forum in the particular circumstances. Although these cases were personal injury cases, the principles apply equally to IP disputes.

GENERAL PRINCIPLES

In IP cases, often the English and Scottish courts have concurrent jurisdiction to deal with the claim. This is because the main grounds of jurisdiction are that a party can be

sued in the courts of the country where it is based/domiciled or where it is committing the allegedly infringing acts or threatens to do so. Often those acts are UK-wide. Thus, in principle, it is often possible to choose to raise action in Scotland in the Court of Session or in England in the High Court or IPEC. These cases also establish that, even if the parties submit to the chosen court's jurisdiction, that may not be the end of the story, as the court is able to override this and decide itself to dismiss a case.

The Civil Jurisdiction and Judgments Act 1982 allocates jurisdiction across the UK's three separate legal systems – England and Wales, Scotland and Northern Ireland. Section 49 of that Act provides that nothing in it shall prevent any court from staying or dismissing any proceedings on the grounds of FNC or otherwise, where to do so is not inconsistent with the Brussels Convention, now largely superseded by either the 2001 Brussels Regulation (EC) No 44/2001 or by the Recast Brussels Regulation (EU) No 1215/2012. These were purely domestic UK cases, and the effect of Section 49 was to maintain the applicability of FNC.

Cook v Virgin Media Ltd and *McNeil v Tesco plc* were brought in the English court, claiming damages for personal injuries alleged to be sustained in Scotland due to the Defender's negligence. The Claimants were based in Scotland and the Defendants were based in England. The Defendants argued that Scotland was the correct court to hear

“

The Court can dismiss actions on its own initiative, as it has an overriding duty to actively manage cases and ensure they are dealt with for the convenience of all concerned



the claims, but they did not actively challenge jurisdiction. Despite this, the Court, on its own initiative, dismissed the cases on the grounds that the proceedings should have been raised in Scotland, as it was the more appropriate forum. The matter was appealed to the Court of Appeal by the Claimants, but the appeal was dismissed.

Importantly, both the first instance and Court of Appeal decisions make it clear that the Court can dismiss actions on its own initiative, as it has an overriding duty to actively manage cases and ensure they are dealt with for the convenience of all concerned, including witnesses. These factors relate to convenience, expense, the relevant law applying and where the parties have their places of business.

IP IMPLICATIONS

Although not related to IP, these cases are still significant. Forum shopping is very common in IP cases, even in the UK. It is important, therefore, that all IP practitioners, including Patent and Trade Mark Attorneys, are aware of this and take account of it in advising clients on UK IP disputes. It is sensible to consider at the outset whether one jurisdiction is clearly the more appropriate forum,

as this will inform the overall strategy adopted. There is risk in ignoring this or getting it wrong, since it is now clear that a court can decide the matter of its own volition.

Furthermore, there is another precedent for the successful application of FNC in a UK patent case: (1) *Vetco Gray UK Limited*; and (2) *Vetco Gray Inc v FMC Technologies Inc* [2007] EWHC 540 (pat). An infringement action had been raised by the Claimant, FMC, in the Scottish Court of Session. Defences were filed in Scotland, arguing non-infringement and raising a validity challenge based on specified prior art. No formal counterclaim for revocation was made in Scotland. Later, English proceedings were raised in the High Court by the Defendants in the Scottish action, claiming invalidity and a declaration of non-infringement. The revocation claims effectively mirrored the validity defences in Scotland. The Scottish Claimant

successfully challenged the jurisdiction of the High Court on grounds of FNC and the English case was stayed. This not only forced the revocation counterclaim to be brought in Scotland, but also gave rise to significant wasted costs, as well as an adverse cost liability for the party that got it wrong. An application for leave to appeal was refused, too, as it was a discretionary decision with no reasonable prospect of success.

The key point is that, in an IP claim forum-shopping exercise (with no international element), even where both England and Scotland are competent jurisdictions, the choice is not the Claimant's absolute right. It will always be subject to the FNC qualification, so FNC needs to be considered early on, as the court may itself raise and deal with it within its discretion. Potential Claimants in IP cases should take this seriously to avoid significant costs liability and an initial psychological blow. ■



Gill Grassie

is a Partner at Brodies LLP
gill.grassie@brodies.com

Robert Buchan, Partner at Brodies LLP, co-authored this article.

How brands blind our brains

Dr Christian Scheier reveals the hidden mechanisms that inform how trade marks gain power over consumers



Over the past 20 years, neuroscience has learned more about the human brain than it did in the previous 100. The main reason is that new brain-scanning technologies provide “live” access to the human brain by exposing which areas are active during the completion of a given task. Over the past 10 years, these new techniques have also been applied to provide better understanding of purchase decisions in general, and the role of brands in particular.

The function of a brand is to act as a “pain reliever” – while a pain reaction is sparked in the brains of consumers when considering price, brands help counteract its impact. In short, we are happy to pay more for the branded product as it represents a reward.¹ The greater the expected reward, the greater the willingness to pay a higher price.

Strong brands also trigger the so-called “cortical relief” effect:² whenever we encounter a strong, familiar brand, parts of the brain that are responsible for reflective thinking are deactivated. In contrast, unfamiliar or weaker brands activate these “thinking” structures. In the framework established by Nobel laureate and psychologist Daniel Kahneman, this means that strong brands enable and support “fast thinking”³ – quick, automatic and associative thinking, as opposed to slower, rule-based and reflective thinking. (To illustrate this quickly: if we ask “how much is two times two?”, the answer comes to mind automatically, without reflective thinking, while asking “what is 17 times 24?” requires reflective thinking.)

This automatic thinking makes decision-making more efficient for consumers. The human brain strongly favours the known and familiar, which allows it to make decisions on “autopilot”. Because brands trigger this fast-thinking approach, most people do not consciously realise their influence. This has strong implications for marketing in general, and trade mark law in particular.

RULES OF PERCEPTION

Perception largely operates on an implicit level: we have no clue exactly how we are able to

recognise a brand in the supermarket within a fraction of a second, or which processes in our brains are responsible for this. We just see the brand as if we had a camera sitting on our eyes. However, the reality could not be further from this notion, as the two photographs below demonstrate. The top photograph is a picture of a street as we subjectively perceive it. Everything is in high resolution and full colour; it feels as if we have a camera sitting on our eyes.

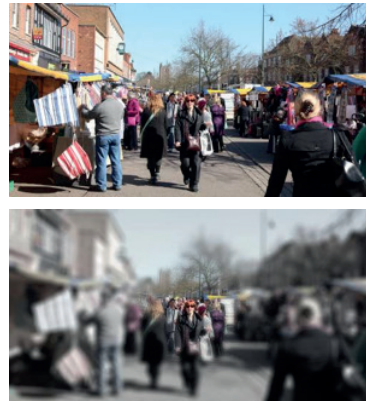
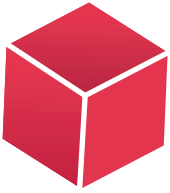


FIGURE 1: PERCEPTION IN FOCUS

Top: What we think we see

Bottom: What the brain actually receives as input

The bottom image shows the objective input our brain receives. We only see a small part in sharp focus and in colour, and the rest gets more and more blurred towards the periphery of our field of vision. The objective input consists of a small, high-resolution sensor (the so-called fovea) as well as a low-resolution peripheral perception. The high-resolution sensor covers only a fraction of the overall input, roughly the size of a thumbnail. Under the circumstances of peripheral perception, reading a brand name on a brand logo, for example, is not possible. However, shapes and colours can be identified (colours up to an angle of 50°). Research reveals that, on the basis of this anatomy of the eye, at each point in time, four to five letters can be recognised in the area that the eye is fixated on. Letters that are further away cannot be recognised.



Thus, the human brain does not perceive objects and products as a whole or as a sort of “photograph”. Rather, specialised nerve cells process the different features of visual objects, such as colours, orientation, shapes or movement. For the brain, a visual product initially consists only of lines, borders, corners, curves, colours or movements. The brain then “breaks down” the product into its separate parts, which are then put together to form a whole. Expressed differently, the explicit and conscious perception of products is an active construction of the brain. Of course, since the brain does not see images, it also does not save images; there is no image database in our heads.

Neuroscientists have calculated that the eye alone “feeds” 10 million sensual impressions per second into the brain. The eye perceives many details, but not everything is equally important. So how does the brain decode paramount patterns in all the data that is delivered by the senses? The answer is diagnostic features:⁴ a chair has four legs; a butterfly has two wings; a car has four wheels. If you remove the back-rest from the chair, it is a stool. The processing of optical information via diagnostic



The challenge is how to take such scientific research and use it to rethink established legal principles, which are not backed up by the available evidence

features is much simpler and more efficient than image-processing, which would probably collapse quickly at a rate of 10 million bits-per-second.

Trade marks leverage the disposition of our perception apparatus for the orientation towards diagnostic features. Because they facilitate and bundle the absorption of the available information regarding a product into a simple visual signal that is accessible for processing in “autopilot mode”, it is valid to say for all trade marks that, the more well known they are, the better they work as diagnostic features. The more distinctive the character of a trade mark, the quicker and more certain the allocation to a certain product, a certain producer or a certain product expectation takes place.

A study regarding object recognition revealed that, when the object was shown to participants for only $\frac{1}{15}$ seconds, 94 per cent of them were able to allocate a bottle shown in the picture to the trade mark Martini without reading, purely on the basis of visual characteristics.⁵ Perceiving and recognising well-known objects and products takes place automatically and quickly, so that conscious further thinking is not possible and also not required. Only the result of the act of perception is conscious.

Certain elements are diagnostic for trade marks: if they are recognised by a large number of consumers, and if they are at the same time only rarely or never allocated to other trade marks in the same product category. An example is the colour red, which is distinctive and easy to learn for Coca-Cola within the category of non-alcoholic beverages. As soon as a second supplier begins to prominently use an “occupied” diagnostic colour – even a similar shade of colour within this colour category – confusion can

be observed. The colour may even lose its diagnostic character, because the trade mark can no longer be allocated clearly to one colour category. Thus, diagnostic colours (or shapes and symbols) in marketing not only have a decorative function, but also play an outstanding role when marking the products and trade marks, especially for visual search at the shelf and identification.

The identifying and differentiating function of such features can be as strong or diagnostic as the trade mark name itself.



FIGURE 2: DIAGNOSTIC SHAPES

Figure 2 shows a number of trade mark diagnostic shapes. These work as reference stimuli for the respective trade mark, even if the colour shading does not correspond to the real or learned colours. However, the reaction is accelerated if several diagnostic features can be used, for example colour and typography.

IMPORTANCE OF IMAGES

The hierarchy of perception indicates a superiority of device marks in comparison to word marks. This is because device marks reach their addressees even in the relatively large area of peripheral or distant perception, in which word marks have no effect, for purely physical reasons. Product presentations are, like trade marks, attached to diagnostic features and many consumers orient themselves based on graphic elements. For example, in market research, many

consumers cannot remember an exact product name, although they regularly buy and use the product. Rather, they refer to the product as, for instance, the “red” deodorant from Brand X.

That’s not to say that words do not play a role, rather that non-verbal stimuli play a similarly important role for trade mark identification, and in some contexts it is primarily the non-verbal stimuli that are used for identification. How the separate features are weighed depends significantly on the specific context, including the appearance of competitors, the consistency of a brand’s appearance with regard to the relevant features, and the marketing and media investments.

(DIS)SIMILARITY

The perception of similarities and dissimilarities is a basic human experience, and is driven by the so-called law of similarity. According to this law, the human perception apparatus groups stimuli as matching when they are similar to each other. What looks similar also belongs together.

In a study regarding the confusion of producers, it was shown that the perceived similarity of packaging and products significantly influences the assessment of whether two products originate from the same producer.⁶ The more similar the outward appearance of two products is, the higher the probability that they will be perceived as matching. However, the similarity of product presentations and signs in the world of goods does not only reveal information regarding origin. The visual similarity is also generalised so that, for example, visually similar products or trade marks are perceived to be similarly related in terms of performance and quality.

RISK OF CONFUSION

Regarding the risk of confusion, two factors are of special importance in perception science: the relevance of peripheral vision in a normal shopping situation and the control of everyday purchases by Kahneman’s fast thinking. The golden Easter bunnies of Lindt and Riegelein give an example (see Figure 3). The right image shows how both designs are perceived through peripheral perception, comparable to the situation in which the consumer stands in the supermarket and registers from distance or in his or her peripheral vision that Easter bunnies are for sale.



FIGURE 3: PERIPHERAL PERCEPTION

The similarity of the outward presentation of the products indicates a similar origin, and the different word marks shown, which correct this mistake, cannot be recognised.

THE CHALLENGE

The challenge now is how to take such scientific research and use it to rethink established legal principles, which are not backed up by the available evidence. There are significant opportunities associated with aligning them with insights from neuroscience and psychology. In a panel at the MARQUES 2015 conference, a judge

at the German Federal Court of Justice said European courts must overcome a “legal bias” against colours and shapes of trade marks as indicators of origin.

Common surveys concerning assertiveness and uniqueness of trade mark characteristics (eg colours, shapes) primarily access the conscious and reflective decision-making system. The trend in marketing investigations is to complement these tools with so-called implicit measures that access fast, automatic thinking. For example, there are now tools that can establish whether colours, shapes or symbols are in fact diagnostic cues for a given brand on an implicit level. Evaluation of diagnostic characteristics of brands is gaining momentum in marketing.

A brand that owns implicit diagnostic cues is more effective in guiding consumers in shops, and in signalling the brand and its rewards. To be an effective “pain reliever”, there is nothing more effective than diagnostic non-verbal cues. ■

- 1) Knutson, B et al (2007), “Neural predictors of purchases”, *Neuron*, 53, 147–156.
- 2) Kenning, P & Plassman, H (2008), “How recent neuroscientific research could enhance marketing theory”, *IEEE Transactions*, Vol 14, 532–538.
- 3) Kahneman, D (2011), *Thinking, Fast and Slow*, McMillan.
- 4) Schyns, PG (1998), “Diagnostic recognition: Task constraints, object information and their interactions”, *Cognition*, 67, 147–179.
- 5) Kapferer, J (1995), “Brand confusion: Empirical study of a legal concept”, *Psychology & Marketing*, 12 (6), 551–568.
- 6) Loken, B, Ross, I & Hinkle, RL (1986), “Consumer ‘confusion’ of origin and brand similarity perceptions”, *Journal of Public Policy & Marketing*, 5, 195–211.



Dr Christian Scheier

is Founder and joint Managing Director of decode

www.decodemarketing.com

Dr Scheier is a neuropsychologist who combines research and practical competence in marketing consultation.



SHORT-CUT SHORTCOMINGS

Stacey Carrara Friends discusses why attorneys in the US should continue to counsel against generic or descriptive marks

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The US Court of Appeals for the Federal Circuit (CAFC) recently issued a decision in an appeal to determine the fate of the mark PRETZEL CRISPS.¹ The holding in this case attempts to shed some light on the standard for determining whether a mark is generic or merely descriptive. To set the scene, a little background on US trade mark law may be helpful.

GENERIC OR DISTINCT?

Federal trade mark rights in the US are based on common-law rights gained by actual use in commerce. For example, trade mark owners must (at some point) prove actual use in commerce by filing a declaration to that effect, along with a specimen demonstrating that use. Applicants must also describe their goods and services with great specificity; for example: “computer software for database management in marketing”, instead of just “computer software”.

In general, descriptive marks are not registrable, barring proof of acquired distinctiveness. However, in order to comply with international laws in accommodating marks that have been registered by another country’s trade

mark office, the US has adopted a Supplemental Register. This secondary register to the Principal Register allows for the registration of marks that the US Patent and Trademark Office (USPTO) deems descriptive, but could, in time, signify source. The owner of a Supplemental Registration may use the ® symbol with the mark, which appears in the USPTO database.

The Supplemental Register does not, however, confer all of the rights accorded by the Principal Register. For example, there is no presumption of validity, ownership or exclusive rights. In addition, a Supplemental Registration cannot be used to prevent importation of infringing goods, and can never be incontestable. A Supplemental Registration also cannot be converted to a Principal Registration. One can, however, re-apply for the mark, claiming acquired distinctiveness, either by showing strong evidence or a presumption after five years of continuous and exclusive use. Generic marks cannot be registered.

Despite these drawbacks, businesses often like to register descriptive or generic marks, as they immediately convey to consumers the nature of the goods or services. However, that

short cut results in a mark that is difficult to register, enforce, use exclusively and build singular source identification on. A highly descriptive mark will often provoke an Office Action from the USPTO “requesting additional information”, which typically means the examiner is gearing up for a genericness refusal. Such a refusal is very difficult to overcome, and difficult to analyse due to seemingly conflicting precedent.

PRETZEL LOGIC

This leads us to Princeton Vanguard v Frito-Lay. In this case, Princeton Vanguard held a Supplemental Registration for the mark PRETZEL CRISPS (PRETZEL disclaimed). After five years,² it applied for the mark on the Principal Register, claiming acquired distinctiveness (also disclaiming PRETZEL). The USPTO approved the mark for publication, but Frito-Lay filed an opposition, claiming the mark is generic. Frito-Lay also petitioned to cancel Princeton Vanguard’s Supplemental Registration.

Both parties submitted consumer surveys and expert reports, as well as evidence of use of the words together and apart. The Trademark Trial and Appeal Board (the Board) first found

“

Choosing a mark comprised of generic words for the goods or services will make registering, protecting and enforcing a brand extremely difficult

that PRETZEL CRISPS is a “compound mark”, not a phrase. It then analysed the words individually and found that, because “Pretzel” is generic for pretzels, and “Crisps” is generic for crackers, PRETZEL CRISPS is generic for pretzel crackers.

In reviewing this case, the CAFC first clarified what it perceived to be a misunderstanding about previous Federal Circuit decisions in genericness cases. It reminded the parties that the proper standard for determining genericness is described in its *Marvin Ginn*³ decision, which set forth two questions: what is the genus of the goods or services at issue, and is the mark as a whole understood by the relevant public primarily to refer to that genus of goods or services? In this case, the CAFC noted the Board had instead relied primarily on language from *In re Gould Paper Corp.*,⁴ which stated that, when a compound mark in its entirety has exactly the same meaning as the individual words, a finding of genericness as to the whole mark is proper. The Board interpreted this case to mean that, if PRETZEL CRISPS is a compound mark, and the words comprising it are individually generic, then the mark as a whole is generic also.

The CAFC explained that Gould is only pertinent to cases where the mark as a whole carries an identical meaning to its separate parts. The court in *Gould* did not skip the analysis as to the mark as a whole, but instead found that the mark as a whole was identical to its parts in meaning, and thus a separate analysis would be redundant. The CAFC stated that

Gould also comported with its other oft-cited precedential holding on this issue, *American Fertility*,⁵ and that subsequent decisions had reiterated this point. Thus, regardless of whether a mark is a compound mark or a phrase, the two-part test in *Marvin Ginn* governs. The CAFC acknowledged that the Board might find it useful to consider the public’s perception of the individual words in a mark, but it must also examine the evidence regarding whether the words joined together give the mark additional meaning in the public’s eye.

In *Princeton Vanguard*, the CAFC found no evidence that the Board compared its findings regarding the genericness of the individual words in the mark with the mark as a whole. The record was replete with evidence regarding the public’s perception of the PRETZEL CRISPS mark, and the Board should have considered this in determining the genericness of the mark as a whole. The CAFC held that the Board took a “short cut” in its analysis and remanded the case for a proper application of the genericness test set forth in *Marvin Ginn*.

In counselling businesses with regard to the distinctiveness of their US marks, we should advise as follows:

- Do not choose a mark comprised of words that are the generic terms for the goods or services represented by

the mark. This will make registering, protecting and enforcing the brand extremely difficult, if not impossible.

- If they insist or already have such a mark in use, they should be aware that, in the US, even a Supplemental Registration will involve an expensive process of arguments and proof through evidence regarding the public’s perception of the mark as a whole, and if found not to be generic, plentiful evidence of acquired distinctiveness. Such evidence will likely include affidavits from customers, distributors or others in the relevant industry; publicity; or media references and consumer surveys.

Hopefully, with this information in hand, brand owners will see the sense in steering away from generic, or even highly descriptive, marks. ■

1) *Princeton Vanguard, LLC v Frito-Lay North America Inc.*, 114 USPQ2d 1827 (Fed Cir 2015) [precedential].

2) After five years of exclusive and continuous use, the owner of an otherwise descriptive mark may file for registration on the Principal Register, under US Trademark Law Section 2(f), claiming acquired distinctiveness. The five years merely creates a presumption of acquired distinctiveness, which the USPTO or a third party may challenge.

3) *H Marvin Ginn Corp v Int’l Association of Fire Chiefs Inc.*, 782 F2d 987, 989-990 (Fed Cir 1986).

4) 834 F2d 1017 (Fed Cir 1987) (SCREENWIPE).

5) *In re American Fertility Society*, 188 F3d 1341, 1347 (Fed Cir 1999). The American Fertility case involved a phrase: SOCIETY FOR REPRODUCTIVE MEDICINE.



Stacey Carrara Friends

is a Shareholder of Ruberto, Israel & Weiner, PC

SCF@riw.com

Stacey’s practice is focused on trade mark, copyright and entertainment law.

SAARC

made
simple

Dr Sheetal Vohra sums up the crucial registration particulars that prevail in this South Asian organisation

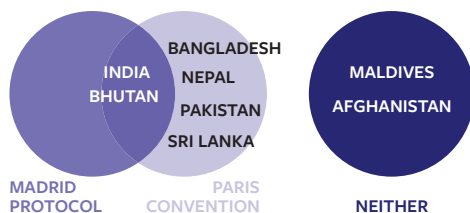
Established on 8 December 1985, the South Asian Association for Regional Cooperation (SAARC) is an economic and geopolitical organisation that includes eight countries, primarily located in South Asia and the Indian subcontinent. Afghanistan became its eighth member state in 2007, joining Bangladesh, Bhutan, India, the Maldives, Nepal, Pakistan and Sri Lanka. Meanwhile, Australia, China, Iran, Japan, the Republic of Korea, Mauritius, Myanmar, the EU and the US have joined SAARC as observers.

The combined economy of SAARC is the third largest in the world, after the US and China, in terms of gross domestic product (using purchasing power parity). This region is, therefore, of significant commercial interest, and protecting trade marks in it must form an integral part of any company's IP strategy. This article aims to equip professionals with the information needed to understand the essentials of trade mark filing requirements inside SAARC.

REGISTRATION

In contrast to the EU, there is no single registration system for SAARC. Only India and Bhutan are signatories to the Madrid Protocol; Afghanistan, Bangladesh, the Maldives, Nepal, Pakistan and Sri Lanka have yet to accede to it. Nonetheless, all SAARC members, except the Maldives and Afghanistan, are contracting parties to the Paris Convention. In addition, most SAARC members follow the Nice classification.

SAARC SIGNATORIES TO MADRID/PARIS



PRE-FILING SEARCH

Pre-filing searches are highly recommended in Afghanistan, Bangladesh, Bhutan, India, Nepal, Pakistan and Sri Lanka for both word marks and device marks. On the other hand, in the Maldives, where there is no specific IP law

office, protection is accorded by the publishing of cautionary notices in local newspapers and no specific trade mark database is maintained.

DOCUMENTS REQUIRED

To file a trade mark registration application in Afghanistan, the applicant needs to furnish power of attorney legalised at the Afghan Consulate, prints of the mark (not required for a word mark) and his or her name, occupation, residential address and country of citizenship. The same information must be provided if a legal representative files. The applicant also has to provide a representation of the mark, a list of the goods and/or services and classes, and the particulars of home registration, if any.

In Bangladesh, an individual applicant must submit his or her name, citizenship and address. For registration by corporate entities, the name, registered address, country of incorporation, nature of business, representation of the goods/services and classification of goods/services must be submitted. There is no requirement to file a legal power of attorney.

In Bhutan, India, Pakistan and Sri Lanka, the trade mark applicant must furnish name and address, details of the goods and services relevant to the application, classification of goods and services, and power of attorney. In Sri Lanka, power of attorney must be signed by two company directors or an authorised person.

The filing requirements are slightly different in Nepal, where the applicant needs to furnish a copy of the registration or licence of the business to supply the product or service relevant to the trade mark. If the applicant is foreign, a certified copy of any foreign registration certificate and address for service in Nepal must be submitted, along with power of attorney.

In the Maldives, there is no statutory law or administrative body for the registration of trade marks. Trade mark protection is provided by way of publication of a cautionary notice in local newspapers, in English and Dhivehi (local language), which states the name, address and nationality of the applicant, legal status of the applicant, trade mark, international class and description of goods/services.

PROSECUTION

A formal examination is part of the registration process in Afghanistan, Bangladesh, Bhutan,



SAARC REGISTRATION PRACTICE IN SUMMARY

COUNTRY	MULTICLASS APPLICATIONS PERMITTED?	OPPOSITION PERIOD (FROM DATE OF PUBLICATION)	REGISTRATION AND RENEWAL TERMS	RECTIFICATION DUE TO NON-USE FROM REGISTRATION DATE
Afghanistan	✓	30 days	10 years (renewed every 10 years)	3 years
Bangladesh	✗	2 months	7 years (renewed every 10 years)	5 years
Bhutan	✓	3 months	10 years (renewed every 10 years)	3 years
India	✓	4 months	10 years (renewed every 10 years)	5 years
Nepal	✗	3 months	7 years (renewed every 7 years)	1 year
Pakistan	✗	4 months (2 months + 2 months)	10 years (renewed every 10 years)	5 years
Sri Lanka	✗	3 months	10 years (renewed every 10 years)	5 years
The Maldives	N/A	N/A	N/A	N/A

India, Pakistan and Sri Lanka, including, for example, an examination of distinctiveness and a search for prior trade marks. In Nepal, a trade mark is refused if it is deemed to: adversely affect the dignity of any individual or institution; have a negative effect on the national interest or people's wellbeing and morale; affect the goodwill of any other person's trade mark; be contrary to the principle, norms and international conventions of industrial property; or already be registered in another person's name.

OPPOSITION

Most SAARC member states follow a publication system to enable third parties to oppose trade marks, the exception being the Maldives, which publishes cautionary notices.

UNREGISTRABLE MARKS

In Afghanistan, a wide range of prohibitions apply, many of which relate to the common themes familiar to most EU states (such as geographical indications or likelihood of confusion), but which notably also include: depictions of the national flag, state emblems and other symbols pertaining to domestic and foreign organisations/institutions or international organisations; marks that are identical or similar to religious symbols; pictures of national leaders and high-ranking state authorities; words and phrases that could be confused with Afghan government departments; marks of official organisations like the Red Crescent, Red Cross or any other similar symbol; and marks repugnant to chastity, morality and public order.

The trade marks that are not registrable in Bangladesh, Bhutan, India, Nepal, Pakistan and Sri Lanka are those likely to cause confusion and deception, likely to offend any religious community, those comprised of scandalous or obscene matter, or those contrary to any law in force or morality. Also prohibited are trade marks for the shape of goods necessary to obtain a technical result, or which add value to goods, and names of chemical compounds declared by the World Health Organization to be International Nonproprietary Names.

In addition, in Bhutan, marks that are identical to, deceptively similar to or constitute a translation of a mark or a trade name that is well known in Bhutan for identical or similar goods or services of another enterprise are unregistrable, as are marks that may

be confused with a well-known and registered mark for dissimilar goods or services where the interests of the owner of such a trade mark is likely to be damaged by such use.

Alongside the above conditions, in India, a mark that consists of or contains the following is unregistrable: an emblem; an official seal of a country; the name of a UN organisation or the letters UNO; the Indian national flag; the official seal or emblem of the national or state government; the name, emblem or official seal of the President of India or a state governor; the name, emblem or official seal of the Union of India; the name or portrait of Mahatma Gandhi, Jawaharlal Nehru, Chhatrapati Shivaji or the Prime Minister; and other matters specified in the Emblems and Names (Prevention of Improper Use) Act, 1950.

Sri Lanka additionally prohibits registration of a mark, collective mark or certification mark, the registration of which has expired and has not been renewed during a period of two years preceding the filing of the application for registration of that mark, or where its renunciation, removal or nullity has been recorded in the register during a period of two years preceding its filing. Further, marks whose registration has been sought in respect of goods or services, the trading of which is prohibited in Sri Lanka, will not be registered.

NON-TRADITIONAL MARKS

As jurisprudence around non-traditional marks is still evolving, the degree of protection accorded to the following varies: sounds, tastes, holograms, moving images, smell or olfactory marks, and colour and shape marks.

In fact, it is not possible to register non-traditional marks in Afghanistan, Bhutan, Bangladesh and Nepal. There is no procedure for registering sound marks and smell marks in Sri Lanka. However, 3D marks are registered in the same way as normal trade marks and the representation of such

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SAARC member states follow a publication system to enable third parties to oppose trade marks, the exception being the Maldives, which publishes cautionary notices

a mark should contain different perspectives of it.

In Pakistan, the Trade Marks Ordinance, 2001 (the current trade mark law in Pakistan) recognises, among other things, words, letters, devices, figurative elements, colours and sounds (and combinations thereof) as trade marks as long as they can distinguish the goods or services of one undertaking from those of other undertakings. This is a broad definition of what may constitute a trade mark and is arguably wide enough to include 3D shape marks that can be registered as figurative marks.

However, if a shape has significant functional features, there is a strong likelihood that other traders will need to use that shape for similar goods. Therefore, the shape will not be inherently adapted to distinguish the goods and, as such, will fall under the above-mentioned grounds for rejection. Other non-traditional trade marks, including colours and sounds, are specifically included in the definition of a mark and may therefore be registered under the Ordinance. While the registration

of smell marks appears to be unsettled in Pakistan, colour marks are potentially registrable after attaining secondary significance.

Under the old Trade and Merchandise Marks Act, 1958, non-traditional marks were not registrable in India. However, under the new Trade Marks Act, 1999, non-traditional trade marks such as the shape of goods, packaging or colour combinations can be registered. Although smells, sound, tastes and holograms are not specifically mentioned, the amended definition of a trade mark is wide enough to cover them. For example, the Trade Mark Registry in India has granted registration to ICICI Bank Ltd for its sound mark by registering the notes that form the bank's jingle.

The first sound mark to be granted registration by the Trade Mark Registry was the Yahoo! Yodel, on 18 August 2008. The Act does not specifically provide for registration of a single colour but does not preclude it either. A combination of colours stands a better chance of registration if it is capable of distinguishing the goods and services of one trader from another. ■



Dr Sheetal Vohra

is Partner and Head-Trade Marks Division, Lakshmikumaran & Sridharan, New Delhi sheetal.vohra@lakshmisri.com

R Parthasarathy, Principal Partner and Head-IP, Lakshmikumaran & Sridharan, India, acted as co-author.

Parlez-vous Anglais?

Silvia Bertolero outlines why English no longer lends a certain je ne sais quoi when registering marks



Not too long ago, French and European jurisdictions considered French consumers to have a poor understanding of foreign languages, especially English.

As a consequence, extremely weak trade marks have, for years, effortlessly passed the hurdles of registrability thanks to the presence of English words, and trade marks with a dubious distinctive character have entered the French Registry.

The past couple of years have, however, been marked by an important shift in the practice of the French Office, the INPI (Institut National de la Propriété Industrielle), and the jurisdictions.

The INPI has adopted a stricter approach with regard to what is registrable, and now more often refuses trade marks that are weakly distinctive/descriptive, despite the presence of foreign terms. The recent refusals issued by the INPI are generally motivated by the fact that consumers now have a much better grasp of English, as it is “a language largely taught and practised in France” (according to an INPI decision).

Of course, changes are still ongoing and it is sometimes hard to strike a balance, the “naïve” French consumer turning suddenly into a marvellous polyglot in some decisions, and then back to his old self in others.

However, the wheels are in motion and this should be saluted.

NOTEWORTHY YEAR

Last year was marked by a few significant French decisions on the subject of trade marks composed of English words. The 22 May 2015 decision from the Paris Court of Appeal in *Rent a Car*, for example, illustrates the hardening of the conditions of protection.

In this 1998 case, a company called *Rent a Car* filed the French word mark *RENT A CAR*, which was registered by the INPI, in classes 12 (vehicles) and 39 (vehicle rental).

Meanwhile, *Enterprise Holdings Incorporated (Enterprise)* had used the denomination “*Enterprise Rent-a-Car*” (see logo below) since

1994, and had successfully registered the trade mark in 2011 in classes 36 and 39.

After noticing the imminent launch of car-rental services by *Enterprise* under this latter denomination, *Rent a Car* claimed that *Enterprise’s* activities were infringing its prior rights. *Enterprise Holdings* in turn filed a cancellation action against the French trade mark *RENT A CAR* on the basis of lack of distinctiveness.

On 22 November 2013, the *Tribunal de Grande Instance de Paris* considered that the French mark *RENT A CAR* was devoid of distinctive character and, as a consequence, it was fully revoked. Following an appeal filed by *Rent a Car*, the Paris Court of Appeal upheld the decision and confirmed the revocation of the French trade mark on the basis of lack of distinctiveness.

Indeed, the Court considered that the wording “rent a car” to designate this type of service had been commonly used in France and abroad well before 1998. Moreover, “the clients of car-rental services had already in 1998 enough familiarity with the English language to immediately understand the meaning of the words ‘rent a car’, especially as it is demonstrated that the majority of pupils chose English as [their] first foreign language at school”. The Court therefore considered the wording “rent a car” for car-rental services to be descriptive and, as *Rent a Car* did not demonstrate that the phrase had acquired reputation through use, the revocation was confirmed.

ENERGY LACKING

A similar conclusion has since been reached by lower courts, notably the *Tribunal de Grande Instance de Paris* which, on 10 September 2015, decided on the partial revocation of the French trade mark *HUMAN ENERGY* in relation to energy drinks. It considered

that the average French consumer could easily translate the phrase. Once again, the judges considered that the use of a foreign language did not enable any particular identification of a sign that was devoid of distinctive character.

French courts, however, continue to pursue a more moderate approach most of the time. A good example is the French trade mark *GIANT*, owned by well-known fast-food restaurant chain, *Quick*. The Judges of First Instance considered this trade mark to be devoid of any distinctive character for fast-food products (classes 29, 30, 43) on the basis that French consumers can easily identify that the word “giant” designates the quantity or size of the portion, especially as “French consumers are used to English words in retail, and in particular in the fast-food sector”.

However, this judgment was overturned by the Paris Court of Appeal. The Judges of Appeal considered that, despite being comprehensible to French consumers as a synonym of “enormous”, *GIANT* only “suggests in a general and impersonal way the significant size of the portions of products or the importance of the services exploited under this sign”. As a consequence, the Court of Appeal concluded that *GIANT* was evocative, not descriptive.

Although the average French consumer is not fluent in English, applicants should be vigilant when filing trade marks in France. They can no longer hide behind the shield of foreign language. Even if a trade mark is registered, it can no longer be promised a long and peaceful life; courts will not hesitate to revoke it if they consider it descriptive. ■

The Enterprise registration



Silvia Bertolero

is an Intellectual Property Lawyer and European Trade Mark Attorney at Lambert & Associés

lambert@lambert-conseils.com

DOWN UNDER UPDATE

John Hackett introduces the latest IP issues of interest from Australia and New Zealand



AUSTRALIA

A SWING TOWARDS STRICTER CONTROL

It appears the Australian Trade Marks Office will now take a stricter approach when considering requests for extensions of time to file evidence in opposition proceedings.

MG Icon LLC v Caprice Australia Pty Ltd [2014] ATMO 34 was the first contested request for an extension of time under Regulation 9.18 of the Trade Marks Regulations 1995, which came into effect on 15 April 2013.

MG Icon LLC (MG) applied to remove trade mark registration 901355 MATERIAL GIRL in the name of Caprice Australia Pty Ltd (Caprice) from the Trade Mark Register, and Caprice opposed the removal. Caprice requested an extension of time of one month to file evidence in reply to MG's evidence. MG objected to the extension and applied for a hearing.

The Hearing Officer found that three questions only must be considered when deciding whether to grant an extension of time:

- Has the party (and its attorney or agent) made all reasonable efforts to comply with all relevant filing requirements (Regulation 9.18(2)(a)(i))?
- Did the party (or its attorney or agent) fail to file the evidence in time despite acting promptly and diligently at all times (Regulation 9.18(2)(a)(ii))?
- Were there exceptional circumstances that warrant the extension (Regulation 9.18(2)(b))?

For the extension to be granted, the answer to the first two together, or to the third, must be yes.

The Hearing Officer found that Caprice had, up to the period for filing evidence in reply, made all reasonable efforts to comply with filing requirements. It filed the notice of opposition on the due date, and evidence in support only 11 days after its original due date (well within the granted extension period).

The decision highlights some important considerations that should be made when parties in opposition proceedings want to seek an extension of time to file evidence:

- The party is responsible for ensuring that its evidence is filed on time and must act with the goal of filing it on time without the need for an extension.
- A high onus is placed on the party requesting the extension to prove that an extension is warranted in the circumstances.
- Only those matters raised in Regulation 9.18(2) will be considered when an extension of time to file evidence in opposition proceedings is made.
- If relying on Regulation 9.18(2)(a), the party must show that it acted promptly and diligently "at all times" over the evidentiary period. If evidence in reply is late and an extension is not warranted, the party might instead consider making an application to file further evidence. In such instances, the Hearing Officer is not limited to only considering matters in Regulation 9.18(2). It can consider other matters, such as public interest considerations, the probity of the evidence, and whether the evidence was already filed. ■



NEW ZEALAND

NEW BILL GIVES GO-AHEAD TO GEOGRAPHICAL INDICATIONS

Introduced to Parliament on 3 November 2015, the Geographical Indications (Wines and Spirits) Registration Amendment Bill paves the way for wine and spirit geographical indications to be registered in New Zealand.

The Bill seeks to amend the Geographical Indications (Wines and Spirits) Registration Act, enacted in 2006 but not yet brought into force.

Proposed changes include the following:

- A limitation on the length of time a geographical indication is registered, unless a renewal fee is paid, to help fund the cost of implementing and maintaining a registration system;
- Deeming “New Zealand”, “North Island” and “South Island” to be registered geographical indications;
- The Registrar may refuse to register a geographical indication that would likely be offensive to a significant section of society, including Maori.

When the new Bill comes into force, use of a New Zealand registered geographical indication to identify a wine will require adherence to the “85 per cent rule”, whereby at least 85 per cent of grapes used in its production must be harvested in the designated geographical indication.

The introduction of the Bill will be welcomed by the New Zealand wine industry, which sees the registration of geographical indications as supporting its international trade strategies.

BATTS IS BACK IN COURT

First covered in the *ITMA Review* in September 2014, the case of Tasman Insulation New Zealand Limited v Knauf Insulation Limited [2014] NZHC 960 (9 May 2014) – Revocation s66(1) (c) has now been settled.

On 16 December 2015, the New Zealand Court of Appeal largely upheld the decision of the High Court in the trade mark dispute involving Tasman Insulation’s Pink Batts product.

Background in short

The case, which involves rival building products companies, Tasman Insulation New Zealand and Knauf Insulation, dates back to 2011.

Knauf began selling an insulation product under the brand Earthwool. Tasman claimed Knauf was infringing its BATTs trade mark by

using the term “batt(s)” or “BATT” in online marketing and packaging materials for its Earthwool product.

Tasman also alleged that Knauf had breached the Fair Trading Act 1986 by engaging in misleading and deceptive conduct around the marketing of the Earthwool product. In particular, it claimed Knauf was giving the false impression that its product was made from natural wool, when it was made from recycled glass.

Knauf’s response was to apply to revoke Tasman’s trade mark on the ground that “batts” was purely descriptive, and had become a common name in general public use. Knauf also countered Tasman’s claim that use of the word “batts” or “BATT” in the marketing and packaging of its Earthwool product constituted trade mark infringement, suggesting neither would be viewed as “use as a trade mark” under Section 89(2) of the New Zealand Trade Marks Act 2002.

December’s decision

Justice Brown of the High Court dismissed Knauf’s application to revoke Tasman’s BATTs trade mark. He found in favour of Tasman’s claim that Knauf had engaged in misleading and deceptive conduct, but dismissed the infringement claim with one exception, relating to Knauf’s online marketing.

The Court of Appeal largely upheld that High Court decision, finding that the word “batts” was not a common name in public use, and was strongly associated with Tasman Insulation’s Pink Batts product. It noted that, even if the word “batts” had become common, Tasman had strongly promoted its Pink Batts product and trade mark over several years and had done all it reasonably could to ensure its correct promotion by distributors.

A survey showing that a majority of people thought Earthwool was made from wool and not recycled glass helped support the Court’s decision to uphold Justice Brown’s finding that Knauf had engaged in misleading and deceptive conduct in its brand and online marketing.

The Court found that Knauf’s use of the word “batt(s)” on the Earthwool label, packaging and website was descriptive and not trade mark use, and therefore did not infringe Tasman’s mark. ■



John Hackett

is Chairman of Partners at AJ Park, Auckland NZ

John.Hackett@ajpark.com

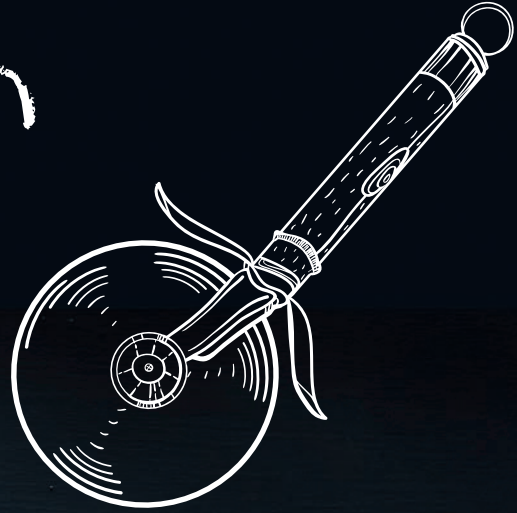


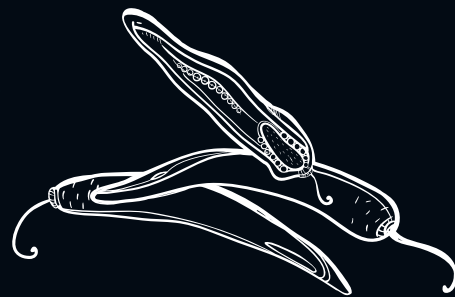
[2015] EWHC 3567 (IPEC), Caspian
Pizza Ltd & Ors v Shah & Anor, IPEC,
9 December 2015



Pizza decision delivered

Court gives Caspian two
for one, writes Carissa
Kendall-Windless





THE CLAIMANT, Caspian Pizza Ltd (CPL), set up a chain of restaurants in Birmingham trading under the name Caspian in 1991. CPL sought to protect its brand by filing two trade marks: (1) the word mark CASPIAN, registered on 8 July 2005 for restaurant and related services; and (2) a device mark (shown below), registered on 21 September 2010 for specified foodstuffs.

In 2002, Mr Shah approached Mr Zarandi (the Second Claimant) asking for a licence to open a Caspian restaurant in Worcester (the Worcester Restaurant). CPL's case is that this restaurant operated under an oral and informal franchise agreement with CPL. The parties subsequently fell out and Mr Shah refused to pay any royalties that fell due. CPL terminated the franchise agreement on 9 December 2013. As a result, a dispute arose as to the right to use the trade name Caspian (and the device bearing the same) in relation to the pizza business.

FRANCHISE FACTS

The first Defendant, Mr Shah, began operating the Worcester Restaurant; during the hearing it was conceded by the Claimants that this was in 2004.

A term of the agreement between the parties was that the goodwill in Mr Shah's franchised business vested in CPL. The Defendants did not accept this and instead contended that there had never been a franchise agreement and, as such, the goodwill had not passed to CPL. If this was held to be the case, then the goodwill remained with the Worcester Restaurant.

It was held that CPL had generated sufficient goodwill since 2004 (or that the goodwill was shared and added to the goodwill of Mr Shah's other pizza restaurants in Worcester) in the Caspian brand for it to give rise to a cause of action in passing off. On the other hand, the Defendants had owned goodwill in the Worcester Restaurant and were entitled to prevent another party trading in the

sale of pizzas in the locality under the Caspian name.

This is because, while CPL had been operating under Caspian in Birmingham since 1991, and had applied for and registered the CASPIAN word mark in 2005, the Defendants began trading under the same brand in Worcester in 2002. In essence, they were trading some 11 years after the Claimants, but three years before the registration of the CASPIAN word mark.

INFRINGEMENT

The Claimants contended that, once the franchise agreement had ended, the Defendants' use of the two marks constituted trade mark infringement and passing off (however, the Claimants' barrister conceded that his clients' case for passing off was unlikely to succeed if they were unable to establish trade mark infringement).

The Defendants counterclaimed that the two marks were invalid because: (i) genuine use was lacking; (ii) the applications were made in bad faith; and (iii) they were registered in contravention of Section 5(4)(a) of the Trade Marks Act 1994 (by virtue of the earlier right used by the Worcester Restaurant).

Judge Hacon found in respect of the CASPIAN mark:

- (i) The claim for revocation would fail because it was an "opportunistic allegation" and the Claimants proved they used the mark between 2005 and 2014;
- (ii) The mark had not been registered in bad faith; however,
- (iii) Mr Shah proved he had accrued goodwill in the CASPIAN name in the Worcester locality and, as such,

he could rely on a Section 11(3) of the Trade Marks Act 1994 defence. As a result, CPL's trade mark registration was invalid as it had been registered in contravention of Section 5(4)(a) of the Trade Marks Act 1994.

As mentioned above, the Defendants counterclaimed that the device mark was invalid on the same grounds. Hacon J held that these claims were not made out and, consequently, the device mark remained validly registered.

He further found that neither trade mark had been infringed by the Defendants.

PASSING OFF

The Claimants failed to establish that their goodwill extended as far as Worcester when the Worcester Restaurant started trading in 2004, or even now. Therefore, there could not have been any relevant misrepresentation or consequential passing off. The Claimants' claim for passing off failed.

COMMENT

Hacon J has provided guidance as to how localised goodwill can play a big part in establishing an earlier right which is then relied upon in order to revoke a registered trade mark under Section 5(4)(a) of the Trade Marks Act 1994.

The Caspian device mark



Carissa Kendall-Windless

is an Associate at EIP

ckendallwindless@eip.com

Carissa is a Solicitor and Registered Trade Mark Attorney focusing on contentious matters.



Green light for Gutterclear

Chris Morris reveals why colour was crucial to this appeal decision

THIS CASE CONCERNED an appeal against the UK IPO's decision to reject an application to invalidate a registered trade mark owned by Gutterclear UK, shown below.

Envirotecnic, the Appellant (and Applicant for invalidity) owns a Community Trade Mark (CTM) for the word mark GUTTER-CLEAR, registered in class 19 in respect of "non-metal rain gutter filters in the nature of foam inserts for maintaining gutters and downspouts".

The Respondent's trade mark was registered in class 37 in respect of "commercial, industrial and residential cleaning services. Cleaning equipment rental services".

The Appellant based its application for invalidity on Section 47 of the Trade Marks Act 1994 (TMA) on two grounds: (i) likelihood of confusion, under Section 5(2)(b) TMA; and (ii) bad faith, under Section 3(6) TMA. On the second ground, it was argued that the Respondent had failed to inform the Appellant of its application while claiming to be considering a change of business name.

The Hearing Officer rejected the invalidation application. Insufficient similarity between the trade marks was found for a likelihood of direct or indirect confusion to arise on the part of the relevant public. It was also held that the Respondent had not acted in bad faith in its filing.

THE APPEAL

This decision was challenged in an appeal to the High Court, on the basis that there were distinct and material errors of principle, the Hearing Officer having failed to: (i) consider

respective notional and fair use of the CTM and the UK trade mark; and (ii) appreciate the conceptual similarity between the marks.

The Court held that the Hearing Officer had not erred with respect to use, in particular advertising use, of the marks. A consumer's purchasing process had been considered, which looked at the likelihood of the Appellant's goods being purchased in store, online and via word of mouth.

CONSIDERATIONS

When considering conceptual similarity, the Court agreed that the Hearing Officer had not properly taken into account the descriptive nature conveyed by the word elements of the two marks. Had both marks been simply word marks, there would be sufficient similarity to invalidate the Respondent's mark on the basis of similarity and likelihood of confusion. However, no likelihood of confusion was found due to the striking and distinctive colour scheme of the Respondent's mark.

Although conceptual differences were overstated by the Hearing Officer, the High Court upheld that there was insufficient similarity between the marks. In the decision, the Judge expressed surprise that GUTTER-CLEAR was considered registrable without evidence of use.

The mark is, on that basis, likely to have been considered by the Court to be of very low distinctiveness (in line with the Hearing Officer's findings).

With regard to the claim of bad faith, the High Court held that there is no general duty on applicants to inform competitors of their plans. Comments were also made with regard to the "lost opportunity to oppose the mark". The opportunity was said to have no value because, if an opposition based on Section 5(2)(b) TMA had failed, the mark would have proceeded to registration in any event. Had the opposition succeeded, the same attack brought under invalidity proceedings would also have succeeded.

CONCLUSION

This decision raises no new points of law, but it is a helpful reminder of the fact that, even if the appeal court does not agree with exactly how an earlier decision was reached, it will not challenge the findings without a distinct, material error of principle.

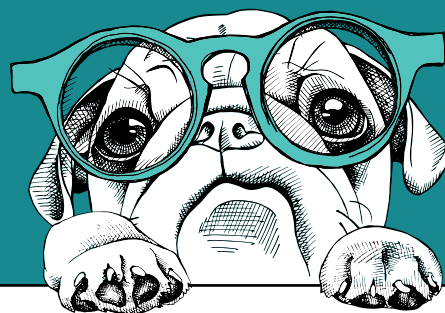
It also demonstrates the potentially very limited scope of protection given to seemingly descriptive trade marks.

The Gutterclear mark



Chris Morris

is an Associate and Trade Mark Attorney in the IP team at Burges Salmon LLP
chris.morris@burges-salmon.com



Memory fails

Opticians simply didn't offer enough evidence of use, says Stephanie Taylor

ON 13 JANUARY 2015, Memory Opticians Limited (Memory) brought an appeal against the Hearing Officer's decision to revoke Trade Mark Registration No 2315482 STRADA in classes 3, 9 and 44. The proceedings arose out of a defensive counter-attack by SdS InvestCorp AG (SdS) following the filing of an opposition by Memory to SdS's International Registration No 943609 STRADA DEL SOLE (designating the UK).

The Hearing Officer held that Memory had not established genuine use of its trade mark in any of the periods relevant to the opposition or revocation action. As such, in his decision of 16 December 2014, the Hearing Officer held that the opposition failed and Memory's registration would be totally revoked as of 16 August 2008.

In its grounds of appeal, Memory alleged that the Hearing Officer had overzealously applied case C-141/13, Reber Holding GmbH & Co KG v OHIM, leading to the application of a *de minimis* test in his assessment



The evidence was not sufficient to constitute genuine use, the Hearing Officer noted. There had been no use of the mark online, no other sales and no real promotion

of genuine use, and ignored material evidence of genuine use presented.

REBER REFERENCE

When assessing the use that had been made of the Memory mark, the Hearing Officer referred to the Reber decision, which he noted represented "a very good example of a form of commercial use that was neither sham nor token, but nevertheless was not genuine". In this case, the mark had been used in respect to a range of chocolates sold in small quantities at an Austrian bakery, which were not deemed to be sufficient to constitute genuine use of the trade mark. The case highlighted that "not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question".

In applying this decision to these facts, the Hearing Officer had noted that: the Memory mark had been applied to goods including spectacles; the UK market for such goods is reasonably large; and evidence of 41 sales of spectacles branded with the Memory mark per year from opticians based in three towns in Wiltshire was not sufficient to constitute genuine use, noting that there had been no use of the mark online, no other sales and no real promotion of the mark. Furthermore, the only evidence of use of the mark

in respect of the goods concerned was a photograph of them in a cabinet drawer, which was not considered to be conclusive of a business wishing to create or preserve a market share.

COMMENTS

Professor Ruth Annand, the Appointed Person, in reviewing the appeal, commented that the decision in Reber did not significantly depart from accepted principles in its assessment of genuine use. However, while there is no *de minimis* threshold for determining genuine use, an assessment should consider: the relevant market for the goods and services concerned; the nature of the goods and services in question; and the scale, scope and frequency of the proprietor's use of its mark. Therefore, while the La Mer decision confirmed that slight use could be sufficient to maintain a trade mark registration, Reber suggests that use in a particular locality may not be sufficient – an assessment of the facts of a case is required.

With this in mind, the Appointed Person was satisfied that the Hearing Officer had undertaken a global assessment of the facts of the case and considered that no error had been made by the Hearing Officer in his review of the evidence of use presented by Memory.

On this basis, the appeal failed.



Stephanie Taylor

is a Senior Trade Mark Attorney at Berwin Leighton Paisner LLP
Stephanie.Taylor@blplaw.com

No dress rehearsal here

Désirée Fields reminds litigants to present all available evidence as soon as possible

MAGNUM PACKAGING (NE) LTD owned a figurative UK trade mark, MY CHOICE!, registered for goods in classes 8, 16 and 21. In October 2014, Astrocraft Ltd filed an application for invalidity under Sections 47(2)(a) and 5(2)(b) of the Trade Marks Act 1994, based on its earlier figurative UK trade mark MYCHOICE.CO.UK for goods in the same classes.

The Hearing Officer found that the goods were either identical or similar and that both marks were dominated by the words “my choice”. He considered the exclamation mark in Magnum’s mark to be commonplace and the oval background “entirely banal”. Granting the declaration of invalidity, he found that there was a likelihood of confusion in relation to all of the goods. Magnum appealed.

FRESH EVIDENCE

On appeal, Magnum sought to adduce fresh evidence that the parties had operated for a substantial period in parallel, that they traded in different channels (as Magnum sells to wholesalers and Astrocraft directly to consumers) and that the MY CHOICE! branded packaging formed a “fairly significant part” of its multi-million pound business.

The Appointed Person noted that the obligation for parties to bring forward all relevant evidence they intend to rely upon before the lower court applies to trade mark appeals and reiterated the circumstances in which fresh evidence would be allowed. This includes where: (i) the evidence could not have been obtained with reasonable diligence for use at the hearing below; (ii) the evidence

would probably have an important influence on the result of the case, though it need not be decisive; and (iii) the evidence was presumably credible. Other relevant factors include whether the evidence could have been filed earlier, the explanation for the late filing and whether the

“

The obligation to bring forward all relevant evidence parties intend to rely upon before the lower court applies to trade mark appeals

other side would be significantly prejudiced by its admission.

Magnum accepted that it could have made evidence available before the lower court, explaining that it did not see the need for it until receipt of the Hearing Officer’s decision. Instead, the evidence was filed one working day before the appeal hearing, without an explanation. Although credible, the Appointed Person found that the evidence did not have real probative

value. The differences in trade channels were not necessarily material to an assessment of confusion, in particular as neither specification of goods was restricted to a particular trade channel. The evidence did not identify: the trade channels through which the parties’ goods had been sold; the goods in the respective specifications that had been sold by the parties; or the periods of sale. The application to adduce additional evidence was therefore rejected.

In the absence of any evidence as to the respective trade channels, the Hearing Officer had correctly assessed the likelihood of confusion on the basis of his own general knowledge.

The identity of the goods was not at issue. The Appointed Person agreed that the respective marks were similar and rejected the appeal.

COMMENT

The decision confirms that the principles applicable to adducing fresh evidence on appeal also apply to trade mark appeals. It presents a stark reminder for parties to ensure that all available evidence is submitted at the earliest opportunity. As Lord Justice Lewison once stated, “The trial is not a dress rehearsal. It is the first and last night of the show.” Only in exceptional circumstances should new, potentially influential evidence be admitted.



Désirée Fields

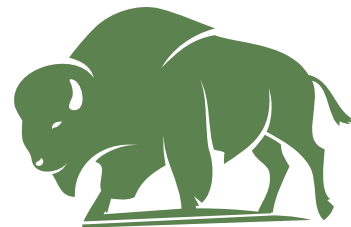
is a Legal Director at DLA Piper UK LLP

desiree.fields@dlapiper.com

Her practice focuses on trade marks and brand protection.

Appeal backs bison branding

Olivia Gregory feels manufacturer may now have a monopoly on a popular animal image



THE COMPARISON OF MARKS is often challenging, particularly when the marks are complex. CEDC International v OHIM – Fabryka Wódek Polmos Łañcut, T-450/13 and T-449/13, cases which hinged on a comparison of marks with multiple elements, are good examples of this. They also demonstrate how complex comparisons can lead to surprising results.

VODKA MIX-UP

The background is that CEDC International Sp. z o. o. (Żubrówka) applied to invalidate one of the trade marks of Fabryka Wódek Polmos Łañcut SA (Wisent), based on Articles 8(1) (b) and 8(5) of Council Regulation (EC) No 207/2009 (CTMR). It also opposed one of Wisent’s marks on the same grounds. Both parties are producers of bison grass vodka. Żubrówka’s actions were based on earlier trade mark rights in the EU, Poland, Italy, Spain, France, Ireland and the UK, including word, figurative and 3D marks.

Initially, OHIM decided in Żubrówka’s favour. These decisions were overturned by the Board of Appeal (BoA), which considered that Wisent’s marks were different to Żubrówka’s. Żubrówka then appealed to the General Court on the basis that the BoA did not conduct a proper comparison of the marks. Żubrówka’s appeals were successful, based on the Polish registration (see box), and the General Court annulled the BoA’s decisions.

The marks consist of the shape of a bottle, a thin line slanted through it,

a logo that depicts a bison and a word mark. However, the BoA focused on the word elements, considering the others secondary. The General Court agreed there were differences in the representations of the bison in the logos, as well as the pronunciation of “Żubrówka” and “Wisent”, but it considered the bison design to be equally as dominant as the words. Overall, it considered the marks similar, in particular conceptually.

CONCEPTUAL ELEMENT

Bison grass, which flavours Żubrówka and Wisent’s vodka, is named after the animal that is fond of eating it. Apart from the representation of a bison in

each logo, the term “wisent” in English and German refers to the European bison, which is “żubr” in Polish. However, the General Court did not find a direct or specific link between “wisent” and “żubr” and the goods in question. Therefore, this decision may be seen to grant Żubrówka a monopoly over bison imagery for bison grass vodka and could cause problems for producers that may naturally wish to draw upon bison imagery in branding.

This case is a reminder that the similarity between complex marks rests upon the overall impression created and that use of different verbal elements alone may not be enough to distinguish between them.

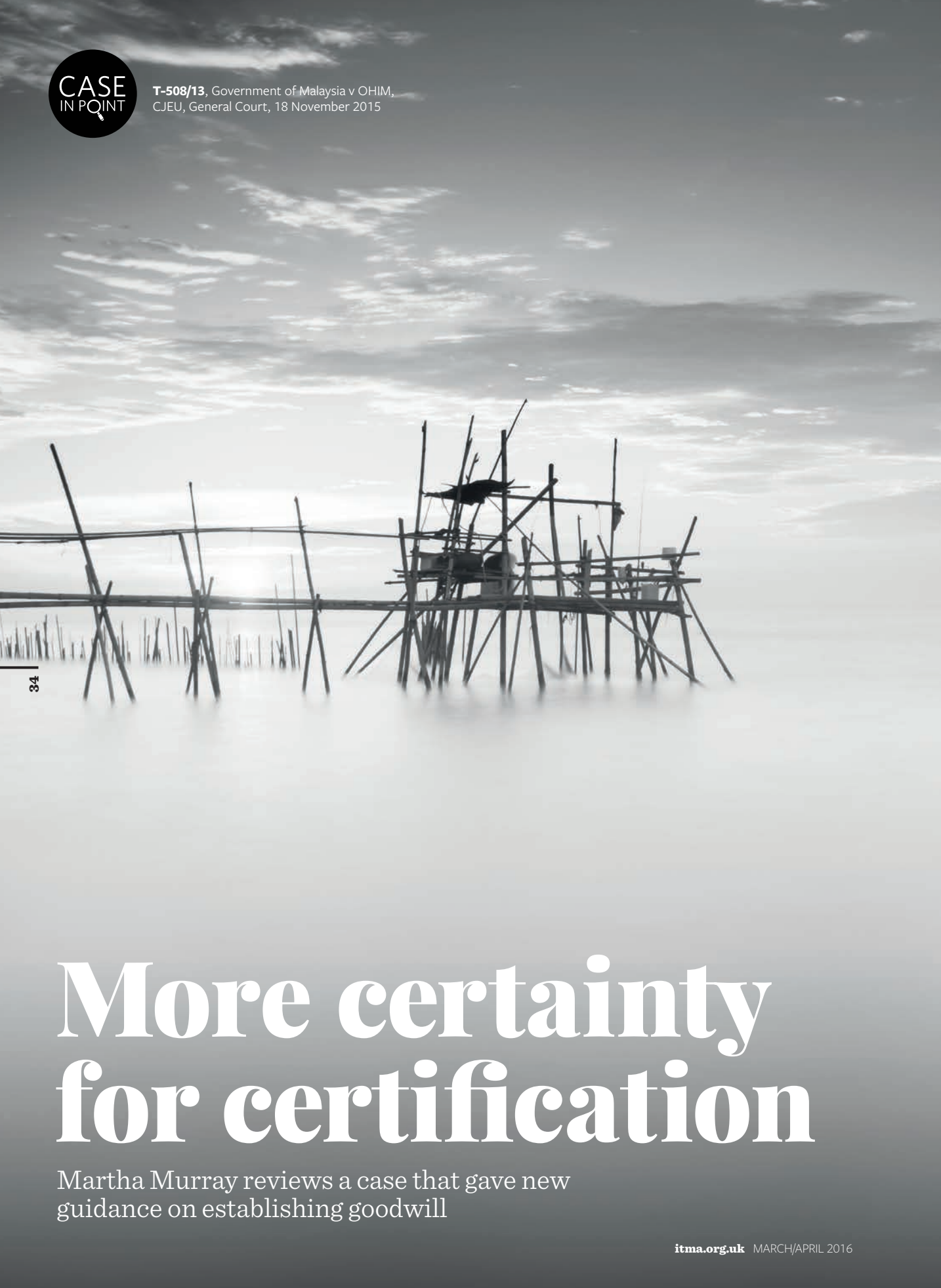
In summary: actions and marks

ACTION	ŻUBRÓWKA’S MARKS	WISENT’S MARKS
Invalidity based on Articles 8(1) (b) and 8(5) CTMR	Polish trade mark registration No 189866 	CTM registration No 5142039  <i>Class 32 – mineral and aerated water and other non-alcoholic drinks; fruit drinks and fruit juices</i> <i>Class 33 – alcoholic beverages (except beers)</i>
Opposition based on Articles 8(1) (b) and 8(5) CTMR	<i>Class 33 – alcoholic beverages</i>	CTM application No 7044472  <i>Class 33 – vodka</i>



Olivia Gregory

is a Trade Mark Assistant at Appleyard Lees
Olivia.Gregory@appleyardlees.com



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More certainty for certification

Martha Murray reviews a case that gave new guidance on establishing goodwill

THE GENERAL COURT has upheld a decision of the Board of Appeal (BoA) in finding that the Government of Malaysia (the Opponent) cannot prevent the registration of a figurative mark incorporating the words HALAL MALAYSIA based on its alleged unregistered rights in an identical sign. The Court revisited the conditions necessary to establish passing off under UK law and considered whether passing off is available for certification marks. In ultimately agreeing with the BoA, the Court held that the evidence provided by the Opponent was insufficient to establish goodwill.

BACKGROUND

In May 2010, Mrs Vergamini (the Applicant) filed a Community Trade Mark application to register a figurative sign including the words HALAL MALAYSIA for various goods and services in classes 5, 18, 25, 29, 30, 31, 32 and 43. Opposition was filed in October 2010 on the grounds of Articles 8(1) (a) and (b), and 8(4) of Council Regulation (EC) No 207/2009 (CTMR), on the basis of an identical, unregistered mark. The unregistered mark is used as a certification mark to inform consumers of the compliance of goods and services, including food, with Sharia law and the halal diet.

Both the Opposition Division and the BoA rejected the opposition under Article 8(1) (a) and (b), finding that the Opponent had not established the well-known character of the earlier sign in the EU for the purposes of Article 8(2) (c) CTMR and Article 6bis of the Paris Convention.

The opposition also failed on the grounds of Article 8(4) CTMR. Interestingly, the BoA took the view that it had not been established that passing off was available for certification marks, but indicated that such marks could be protected by the “extended” form of passing off, which enables several traders to have rights over a sign which has acquired a reputation in the market. The BoA could not safely conclude, however, that goodwill had been established on the basis of the evidence provided by the Government of Malaysia.

The Opponent appealed to the General Court, claiming that the OHIM had misinterpreted the requirements of passing off under UK law for the purposes of

Article 8(4) CTMR. The Opponent also alleged that the OHIM had incorrectly assessed the evidence submitted to prove the reputation and goodwill of the earlier mark.

CLASSIC CASE?

The Opponent argued that the BoA erred in finding that the goodwill in the certification mark was shared between it and the authorised users, and therefore that the opposition should be based on the “extended” form of passing off, rather than the “classic” form (in which goodwill belongs exclusively to the proprietor of the mark). The Opponent alleged that an assessment of the opposition under the assumption of extended passing off negatively affected the BoA’s consideration of the evidence. Therefore, the question for the Court was whether the Opponent, as administrator of a certification system, could be the sole proprietor of the goodwill attached to the earlier mark.

The Court took the view that consumers would recognise the certification mark as indicating that various goods and services comply with the halal diet, according to the control system guaranteed by the Malaysian government. In contrast with the BoA, therefore, the Court found that the Opponent must be regarded as the sole owner of the goodwill.

Nonetheless, the Court agreed with the BoA in finding that the Opponent had not demonstrated the existence of goodwill on the evidence, regardless of whether the assessment concerns classic or extended passing off. The BoA’s consideration of the extended form of passing off could not, therefore, invalidate its ultimate decision.

EVIDENCE

The evidence provided by the Opponent included a list of Malaysian exporters and European importers, which only contained three entities relevant to the UK market. An export

declaration and separate invoice showed that 1,685 products bearing the mark had been imported into the UK between 2008 and 2010, a figure considered negligible by the Court and insufficient to prove knowledge of the certification mark among the relevant public. Annual turnover figures for the global halal food market were believed to be of limited evidential value since they did not indicate what percentage of turnover was achieved by products bearing the sign during the relevant period. There was also uncertainty regarding the dates of product sales resulting from various promotional activities at department stores in the UK.

The Court therefore held that the BoA was correct to find that goodwill in the certification mark could not be established on the evidence, and the appeal was dismissed in its entirety.

CLARIFICATION

The decision clarifies the position regarding certification marks as a basis for passing off under UK law. It also establishes that, depending on the circumstances of the case, the proprietor of a certification mark can be the sole owner of the goodwill despite the use of the mark by other operators. The case is indicative of the need for precise evidence of genuine trading activities, within the relevant period, which acquire customers and increase reputation, as it is clear that some use of a sign does not necessarily prove the existence of goodwill.

The Applicant’s mark



The Opponent’s mark



Martha Murray

is a Trainee Trade Mark Attorney at Withers & Rogers LLP
mmurray@withersrogers.com



A sketchy scenario

Thomas Coop explains why Jaguar’s case was felt to need definition

IN NOVEMBER 2012, Jaguar Land Rover filed a three-dimensional Community Trade Mark (CTM) application for the sketch shown below in classes 12, 14 and 28.

NON-DISTINCTIVENESS

The application was examined and rejected in respect of “land, air and water vehicles and apparatus” in class 12, and “games and toys” in class 28, on the basis that the mark was devoid of distinctive character. The decision was appealed to the Board of Appeal (BoA) which upheld the decision in class 28 but partially annulled the decision for “apparatus for locomotion by air or water”. The sign for the core goods of interest (ie land vehicles) was considered to be merely a variation of the norm and thus non-distinctive.

An appeal was filed to the General Court, which held that, for “land vehicles, games and toys”, the mark did not depart from the norm sufficiently to be considered distinctive. The General Court partially annulled the decision of the BoA in respect of vehicles as well as apparatus for locomotion by air or water because the sign was considered to depart from the norm with respect to these goods. The broader impact of these decisions is to consider: (i) the specimen of the mark as filed; and (ii) the value of obtaining some form of registered protection.

Regarding point (i), the Applicant attempted to rely on numerous reviews of the car, which described its design in glowing terms, including an award as Car Design of the Year. It is clear from the decision of the BoA and the General Court that these reviews did not concern the sketches filed, but rather the ready-made car. As noted by the General Court, OHIM may not take into account characteristics of the mark that are not set out in an application.

The comments in both decisions suggest that, when filing an application, it is sensible to consider filing photographs of a product shape rather than technical drawings. This may help to:

- highlight the distinctive elements of the shape that the Applicant is trying to protect; and
- support reliance on materials, such as reviews, that support a claim that the mark is distinctive, and which may otherwise be rejected.

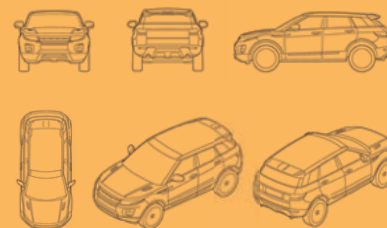
Some consider this decision a partial victory for the Applicant, as it will put third parties on notice of the Applicant’s intention to enforce its

rights broadly. In reality, the Applicant has no legal rights in relation to land vehicles, games and toys, absent of acquired distinctiveness post-registration. As such, the value of using this application for enforcement purposes is likely to be limited.

CONCLUSION

The first takeaway is to ensure that an application as filed will show the distinctive elements of the shape. In some instances, it may be prudent to file photographs. The second is that, although there is some value in putting others on notice, the actual value of these rights as an enforcement tool is likely to be limited.

The Jaguar CTM application



Thomas Coop

is a Trainee Trade Mark Attorney at Baker & McKenzie LLP
Thomas.Coop@Bakermckenzie.com

Promo problem persists

Yet another slogan is deemed insufficiently distinctive, says Mathilda Davidson

IN ANOTHER CASE that demonstrates how difficult it can be for advertising slogans to satisfy the distinctiveness and non-descriptiveness registrability requirements, the EU's General Court has refused to allow registration of the mark GROWTH DELIVERED in relation to advertising, education and technological services.

DISTINCTIVENESS DENIED

Information Resources Inc originally sought registration of the phrase GROWTH DELIVERED as a Community Trade Mark (CTM) word mark in classes 35, 41 and 42 in April 2013. Registration of the mark was initially refused by the examiner in July 2013 on the basis of Article 7(1) (b) and (c) and Article 7(2) of Council Regulation (EC) No 207/2009 (CTMR). The examiner found that the mark fell foul of both the Article 7(1) (b) requirement for distinctive character and the Article 7(1) (c) prohibition on purely descriptive marks. That view was confirmed by the OHIM Board of Appeal (BoA). The latest General Court judgment deals only with the Article 7(1) (b) question of distinctiveness.

In its judgment, the General Court stresses that, as a point of law, a higher bar for registrability does not apply to marks that function (even primarily) as advertising slogans and that slogans are by no means precluded from registration per se. The key question, as ever, is whether the mark is capable of "guaranteeing to consumers the origin of the goods or services which it covers", irrespective of whether "the mark is at the same time understood

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The key question, as ever, is whether the mark is capable of 'guaranteeing to consumers the origin of the goods or services which it covers'

—

– even primarily understood – as a promotional formula” [paragraph 21].

LIMITED ATTENTION

The General Court confirmed the BoA's finding that the relevant public, for the purposes of assessing the mark, consists of consumers and English-speaking professionals whose level of attention is, in general, average to high, but is low in the case of a promotional message. In relation to GROWTH DELIVERED, the General Court concluded that:

“Since the relevant public is not very attentive if a sign does not immediately indicate to it the origin or intended use of the services, but just gives it purely promotional information, it does not take the time either to enquire into

the various possible functions of the sign at issue or mentally to register it as a trade mark. Therefore, the relevant public, faced with the services concerned, will immediately perceive the word sign GROWTH DELIVERED, without further specific analytical or interpretative reflection, as a laudatory or promotional reference to the high quality and usefulness of the services concerned and not as an indication of their commercial origin” [paragraph 45].

Since the Article 7(1) (b) ground of non-distinctiveness for absolute refusal of registration was satisfied, the General Court dismissed the appeal on this basis and did not go on to consider the arguments in relation to the Article 7(1) (c) ground of descriptiveness.

As the facts of this case demonstrate, despite the General Court's statement that slogans are not subject to a higher bar for registrability, it remains challenging to secure registered protection in practice. Consumers are very skilled at tuning out promotional messages and so it can be difficult for ad slogans to break out of their promotional role and achieve the necessary level of distinctiveness that would allow them to function in their own right as indicators of origin.



Mathilda Davidson

is a Senior Associate at Wragge Lawrence Graham & Co LLP

mathilda.davidson@wragge-law.com

Mathilda advises across the spectrum of IP and marketing matters.

Character fight for K-Swiss

Stripes were believed to be banal, as Charlotte Blakey reports

K-SWISS SOUGHT registration of the mark shown on this page under the Community Trade Mark (CTM) designation of International Registration No 932758 in class 25 (defined as “athletic shoes, namely tennis shoes, basketball shoes, cross-country and jogging shoes and casual shoes” as of 8 October 2013) on 23 May 2013.

The designation was refused protection on 4 March 2014 under Article 7(1)(b) Council Regulation (EC) No 207/2009 (CTMR) on the basis that it is devoid of distinctive character. K-Swiss appealed this decision on 23 April 2014.

The Second Board of Appeal (BoA) dismissed this appeal on 30 October 2014 on the basis that the five parallel stripes do not have any original feature, in that they are a banal, generic embellishment, in view of the widespread practice of using a stripe pattern on sports shoes.

The action to the General Court (Second Chamber) was filed on 6 January 2015.

K-SWISS ARGUMENTS

1. *Infringement of Article 7(1)(b)*

The practice of placing marks on the sides of shoes is commonplace among sports-shoe manufacturers, such that consumers pay more attention to the shapes and will naturally consider them to be trade marks.

2. *Infringement of Article 76(1)*

K-Swiss argued the BoA ought to have supplemented the evidence provided.

DECISION

Regarding infringement of Article 7(1)(b), the argument was rejected. The BoA correctly held that stripes are nothing more than a banal, generic embellishment. A simple, mundane design is unlikely to acquire distinctiveness just because it is placed on the sides of shoes.

Further, because the sign in question extends to the full height of the sides of the shoes, it lacks originality; the size variation is determined by the shape of the object with stripes on.

Although K-Swiss provided information to show that many manufacturers of sports shoes display signs on the sides of shoes, this does not demonstrate that the average customer will automatically link said signs with particular manufacturers.

Where simple geometric shapes on the sides of shoes are recognised to belong to a particular manufacturer, the distinctive value of the mark may be explained less by its positioning on the shoe and more by its intensive use. Accordingly, simple geometric shapes do not necessarily have a distinctive function.

The General Court held that K-Swiss did not provide sufficient evidence to show that the average

“

Where simple geometric shapes are recognised to belong to a particular manufacturer, the distinctive value may be explained less by the mark’s positioning and more by intensive use

consumer would consider the mark applied for to indicate the origin of the goods at issue and not see it as a mere decorative element.

The argument for infringement of Article 76(1) was also rejected. It is not for the BoA to supplement evidence. K-Swiss did not provide specific and substantiated information to show that the mark applied for has an intrinsic, distinctive character.

Ultimately, the General Court rejected the action in its entirety.

COMMENT

The decision confirms that simple geometric marks will be considered inherently unregistrable unless sufficient evidence of acquired distinctiveness can be provided. This evidence must demonstrate that the average consumer connects the sign applied for with a particular undertaking without further thought or consideration.

The K-Swiss mark

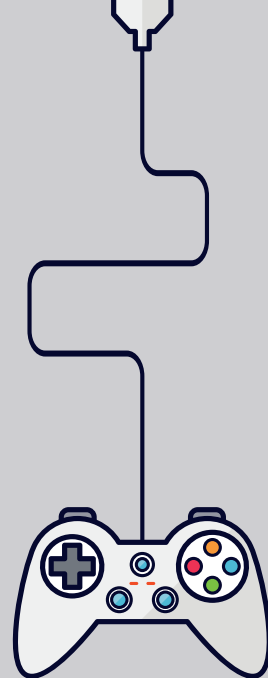


Charlotte Blakey

is a Senior Associate at Keltie
charlotte.blakey@keltie.com

Little consolation for Sony

Case hints at a wider scope for exploitation, suggests Cameron Brown



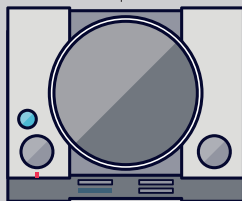
THIS CASE SEES Sony Computer Entertainment Europe (SCEE) attempting to achieve cancellation of a figurative Community Trade Mark (CTM, “contested mark” as shown) registered by Marpefa SL. Purveyor of the hand-held PS Vita gaming device, SCEE appealed to the General Court after being unsuccessful before the Cancellation Division and Board of Appeal (BoA).

SCEE appealed the decision handed down by the BoA, claiming that it infringed Article 15 (1) and (2) of Council Regulation (EC) No 207/2009 (CTMR), as well as the Principle of Partial Use. The appeal was successful on the latter grounds and unsuccessful on the former. It is the former line of argument that yields the most interesting engagement, perhaps unsurprisingly.

EVIDENCE OF USE

The evidence of use submitted by Marpefa before the Cancellation Division featured the “figurative mark” shown, along with use of the word VIETA on invoices and similar. This evidence was accepted as genuine use in relation to the contested mark.

SCEE argued that this was not use of the relevant mark; rather, it was use of a mark that departs from the distinctive character of the contested mark and was therefore not genuine use of the registered mark.



Applying the dicta of cases *Atlas Transport and Fishbone*, the General Court stated that the distinctive character of a mark is maintained where the elements removed from the mark have only weak distinctive character in their own right. In this instance, these elements are the stylistic features of the contested mark that are not present in the figurative mark. Accordingly, the distinctive character of the contested mark was present in the word VIETA and SCEE’s assertion was rejected.

It is interesting to note that the stylistic elements are dealt with individually, split into the border, the font (including letter case) and the various stylistic rectangles. These are individually deemed to be non-striking and only weakly distinctive. This does not acknowledge

the distinctive character of the elements, and the mark, as a whole.

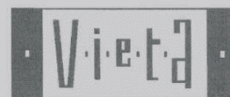
Such a test may be of interest to brand owners who alter their logos over time, for instance when undertaking brand refreshes. Where distinctive character is pooled in the word element of the mark, following the test above, one

may vary the stylistic features of a logo considerably. It is worth noting also the General Court’s discussion of this test in the recent case of *Arthur*, published five days after this decision. The Court acknowledges that the stylistic elements are secondary to the word element but, importantly, that they contribute to the distinctive character of the mark holistically. This is an important variation and may have yielded a different result in this case.

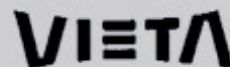
CONCLUSION

At a glance, the figurative mark feels unlikely to constitute use for the sake of the contested mark. The take-home for brand owners, therefore, is cautious optimism; the decision would suggest that the scope for commercial exploitation of a mark, during the relevant use period, may be expanding.

The contested mark



The figurative mark



Cameron Brown

is a trainee Trade Mark Attorney at Stobbs IP

Cameron.brown@stobbsip.com

Cameron recently completed a secondment with a major client and will now train full-time with Stobbs IP.



Unkindest cut?

Rosalyn Newsome looks forward to further reasoning on this similarity decision

ON 9 FEBRUARY 2010, The English Cut SL filed Community Trade Mark (CTM) application 8868747, THE ENGLISH CUT. The application was published designating “clothing, except suits, trousers and jackets; footwear, headgear”. El Corte Inglés opposed the application on the basis of earlier Spanish and CTM marks for El Corte Inglés in classes 25 and 35.

The opposition was based on Article 8(1)(b) and 8(5) of Council Regulation (EC) No 2007/2009, but was rejected on the basis that the marks were dissimilar. El Corte Inglés filed a notice of appeal, which the First Board of Appeal (BoA) also dismissed.

The BoA agreed with the assessment under Article 8(1)(b), stating that the signs were not visually or phonetically similar. However, it admitted that, notwithstanding the average Spanish consumer’s low-level knowledge of English, the term “English” would be understood as conceptually similar to the Spanish term “Inglés”. Consequently, the BoA



found the signs conceptually similar in relation to one of the word elements, but that, as a whole, the signs were not similar. The BoA then concluded that, on a global assessment, the public would be unlikely to establish any conceptual link between “El Corte” and “Cut”.

Regarding Article 8(5), the BoA found that despite a substantial reputation as a department store, El Corte Inglés had not provided sufficient evidence to show there was actual or potential detriment or unfair advantage being taken of the marks. Consequently, the 8(5) basis was also rejected.

On 22 November 2012, El Corte Inglés brought an action for annulment before the General Court. It put forward three grounds for the appeal, arguing: first, that the General Court had distorted the facts presented; second, infringement under Article 8(1)(b); and third, infringement under Article 8(5)(5).

The first and second grounds of appeal were rejected. However, the third ground of appeal relating to the assessment under Article 8(5) was upheld as well founded, and the matter has now been referred back to the General Court.

El Corte Inglés successfully argued that the assessment criteria under Article 8(1)(b) and Article 8(5) are

different. Article 8(1)(b) is conditional on the finding of a degree of similarity between the signs that is capable of giving rise to a likelihood of confusion on the part of the relevant public. The existence of a likelihood of confusion is not, however, necessary in order for an argument to be successful under Article 8(5), which merely requires the signs to be sufficiently similar that the relevant public is led to make a connection or link between the signs. It does not require the connection to lead to confusion or a likelihood of association.

Consequently, it was held that the General Court had erred in the application of the law; it should not have simply disregarded its own finding (at paragraph 29 of the judgment of the Appeal) that there was conceptual similarity between the signs at issue. In those circumstances, the General Court should have then examined whether the acknowledged degree of conceptual similarity was sufficient, taking into account other relevant factors, to establish a basis for infringement under Article 8(5).

This is a useful decision to remind practitioners as to the different legal distinctions and assessment criteria under the different Articles. It will now be interesting to monitor for the subsequent judgment.



Article 8(1)(b) is conditional on finding a degree of similarity between the signs that is capable of giving rise to a likelihood of confusion in the relevant public



Rosalyn Newsome

is a Trade Mark Attorney and Partner at Barker Brettell LLP
rosalyn.newsome@barkerbrettell.co.uk

events

More details can be found at itma.org.uk



Date	Event	Location	CPD hours
16–18 March	ITMA Spring Conference History & Heritage	One Whitehall Place, London SW1	9
16 March	ITMA Drinks Reception Part of the ITMA Spring Conference	Jewel, London W1	
17 March	ITMA Gala Dinner and Drinks Reception Part of the ITMA Spring Conference	Tower of London, London EC3	
23 March	ITMA 2016 Open Meeting; ITMA AGM & ITMA Benevolent Fund AGM; Drinks Reception	Charles Russell Speechlys LLP, London EC4	
20 April	ITMA London Evening Meeting Certification Marks – the weapon of the Guardians of the Orb	Royal College of Surgeons, London WC2	1
20 April	IPO & ITMA Roadshow	Walker Morris, Leeds	1
10 May	ITMA London Evening Meeting The future of the CTM/EUTM	Royal College of Surgeons, London WC2	1
12 May	IPO & ITMA Roadshow	Maclay Murray & Spens, Edinburgh	1
14 June	IPO & ITMA Roadshow	Burges Salmon, Bristol	1
28 June	ITMA London Evening Meeting	Royal College of Surgeons, London WC2	1
20 July	ITMA London Evening Meeting	Royal College of Surgeons, London WC2	1
6 September	IPO & ITMA Roadshow	Charles Russell Speechlys LLP, London	1

The IPO & ITMA Roadshow reaches Leeds in April. See itma.org.uk for details

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





I work as... an IP lawyer partner at Jacobacci law firm, specialising in trade marks, domain names, design, copyright, patents, unfair competition, passing off and advertisement, other than in contractual law and consumer protection.

Before this role... I was a Trade Mark Attorney and assistant to a professor of Civil and Comparative Law at Turin University.

My current state of mind is... happy.

I became interested in IP when... I began to look more closely at advertisements, especially those in the cosmetics field, first of all a Boots advertisement concerning Boots No7 lipstick.

I am most inspired by... weather, literature and flowers.

In my role, I most enjoy... giving advice and outlining strategies to enforce IP titles, first on a non-contentious level and now at all levels, before civil and criminal authorities.

In my role, I most dislike... to revise invoices.

On my desk is... an appeal brief for enforcing a famous colour brand,



Overseas member Paola Gelato brings a touch of Italian style

a brief in defence of an alleged patent infringement and a criminal complaint for a blatant infringement of a 3D mark.

My favourite mug... says "be patient and wait".

My favourite place to visit on business is... Paris.

If I were a trade mark or brand, I would be... Chanel, for its eternal glamour and style.

The biggest challenge for IP is... to correctly apply harmonisation and unified rules, but without

forgetting national specifications and particularities.

The talent I wish I had is... to better understand numbers and maths.

I can't live without... my lipstick and my earrings.

My ideal day would include... a nice walk in a park or in a garden, to breathe in the season and feel the colours and the atmosphere.

In my pocket is... a four-leaf clover.

The best piece of advice I've been given is... to take your time when you give advice or offer an opinion.

When I want to relax I... do some gardening or read garden magazines.

In the next five years I hope to... be able to reduce the pressure of work.

The best thing about being a member of ITMA is... the opportunity to compare Italy's system with the UK's, and learn about the English approach to IP by speaking with local professionals. This helps me to understand the differences that remain, although IP rights, in many aspects, are harmonised at a European level.

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dp ahuja &co.

14/2, Palm Avenue, Calcutta 700019, INDIA
Telephone: +91 33 40177100 • Facsimile: +91 33 40082269
patents@dpahuja.com • trademarks@dpahuja.com • litigation@dpahuja.com