

# CITMA REVIEW

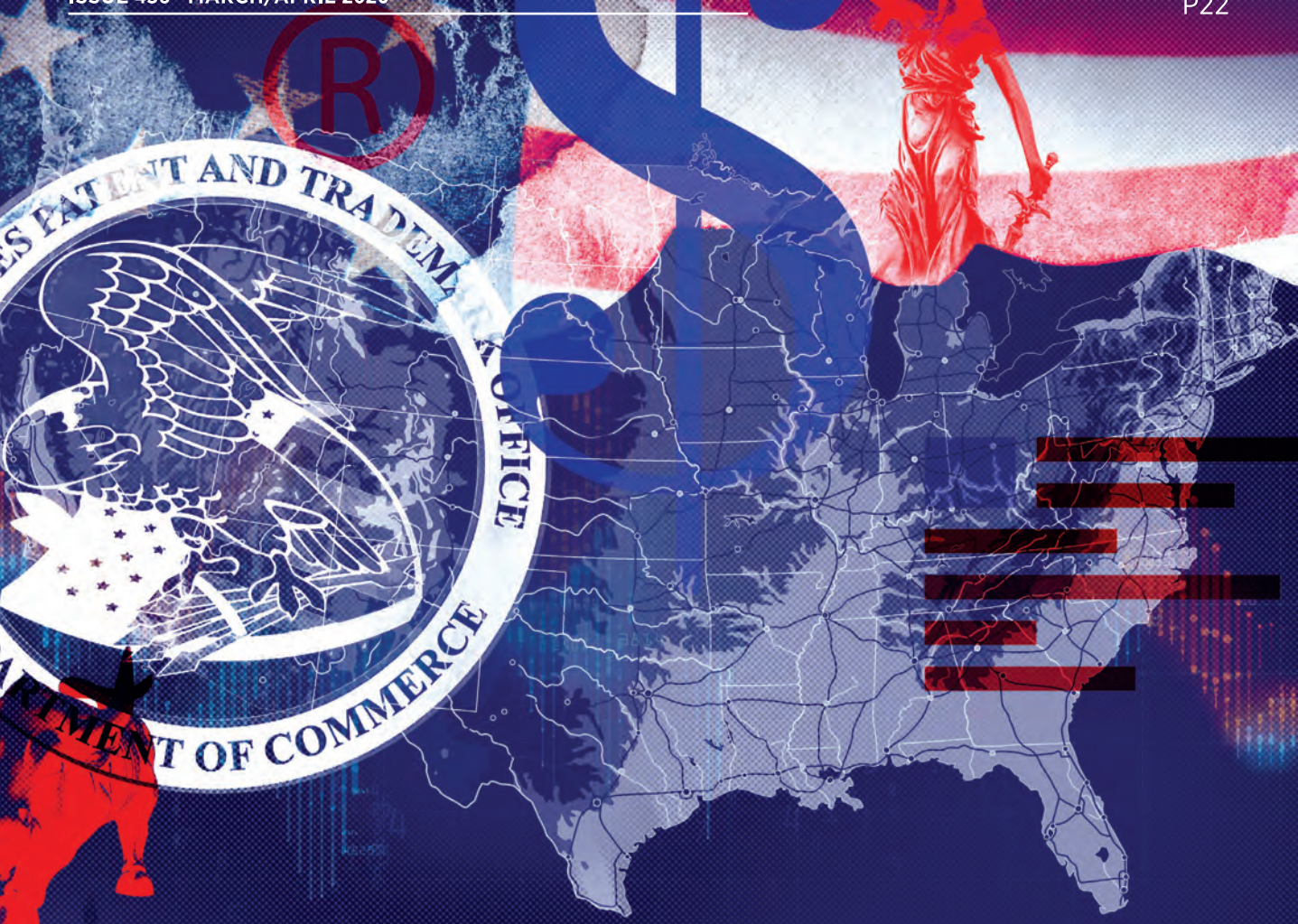
ISSUE 456 MARCH/APRIL 2020

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ADVOCACY:  
MIND THE GAP  
P8

IS IP DIVERSE?  
P17

BIG MAC'S  
BIG WARNING  
P22



## BORN IN THE USA?

*Why the rules have changed for  
overseas trade mark applicants*

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# WELCOME & CONTENTS



**Tania Clark**  
CITMA President

“  
*We are always looking for new ways to promote and improve your skills*

cannot believe that this is the last edition of the *CITMA Review* that I will introduce as CITMA President. The past two years have been one of the most fulfilling periods of my professional life – although my long-suffering colleagues at Withers & Rogers will not be disappointed when I hand over to the new President in April!

This edition shows how we are always looking for new ways to promote and improve your skills. On page 4 is news of the campaign we have just launched, initially targeting the food and beverage sector. On page 8, we look at the increasing number of Trade Mark Attorneys and their firms handling hearings before the UK IPO and Appointed Persons. With the advent of Brexit, this will become an important source of new work from EU and non-EU firms. We also have an international feature on page 12 focusing on the recent changes at the USPTO.

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## CITMA REVIEW

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## REGULARS

- 4 Insider *CITMA* news and updates of interest
- 41 Calendar *What's coming up for members*
- 42 TM20 *Claire Jones, HGF*

## FEATURES

- 6 IPReg *Accreditation must be an ongoing process, says Lord Smith*
- 8 Advocacy *Aaron Wood foresees a war for talent when it comes to UK IPO hearings*
- 12 USPTO *Christopher J Schulte explains why the rules on representation have changed*
- 17 Inclusivity *Is the IP world diverse? Recent research explores this complex question*
- 20 Litigation *How can you increase your success with the Appointed Person?*
- 22 Big Mac *When a big brand fails to prove use, it's time to take notice, says John Coldham*

## CASE COMMENTS

- 26 EWHC 2925 (Ch) *Michelle Phua explains how a small brand bested Bentley*
- 28 BL O/677/19 *This detailed decision leaves an open question, writes Dewdney Drew*
- 29 O/691/19 *Oliver Tidman maps the arguments surrounding a Nosecco mark*
- 30 O/698/19 *Amy Galloway describes why this opposition had no teeth*
- 31 O/696/19 *David Birchall considers the complexities caused by a common element*
- 32 O/704/19 *This case did not go smoothly for the makers of Silk Cut, says Jack Kenny*
- 33 O/703/19 *A softer stance on distinctiveness may have helped Beats, suggests Michael Green*
- 34 O/714/19 *Agreeing coexistence might have been a better approach, notes Serena Totino*
- 35 O/721/19 *Direction made all the difference in this case, writes Rebecca McBride*
- 36 O/726/19 *Emilia Petrossian reports a shining success for the mark's earlier user*
- 37 B 3 066 201 *Gavin Stenton feels the end credits may have rolled on an EUTM application*
- 38 B 3 004 796 *The fact that the signs differed only in their secondary elements was key, David Yeomans writes*
- 39 B 3 068 345 *Donna Trysburg is not surprised by this opposition outcome for Mars*
- 40 B 3 075 718 *A distinctive element sealed this decision, reports Charlotte Duly*



## CTMA campaign to launch

**We are just** about to begin a campaign to promote the work of our members and the expertise of the UK Chartered Trade Mark Attorney profession. Our focus is on promoting the importance of registered intellectual property rights and using a Chartered attorney to give expert guidance on and manage those rights.

The first wave of work will target the food and beverage sector, which is brand-rich, engaged and full of interesting IP stories. We will be publishing content relevant to the sector, including a high-level report on trade marks in the sector, video case studies and web articles.

We would be delighted if you could support the

campaign on a personal level and encourage your firm to do so too. By working together as a profession, we can achieve more. Here are a number of ways that you can support the campaign:

**Use the Chartered title**  
First, distinguish yourself by using the prestigious title that you are entitled to on your email signature, business card and web profile. The Royal Charter embodies your expertise and skills and is a simple and effective way to convey this and instantly build trust. It's also a great way to stand out in a market that is becoming crowded with new entrants – many of whom aren't attorneys and cannot use the Charter.

### Don't miss out on referrals

Every Chartered Trade Mark Attorney has a profile on the 'Find a Chartered Trade Mark Attorney' directory on the CITMA website. This is an important place to connect with would-be clients as a Chartered Trade Mark Attorney because it receives tens of thousands of unique visitors every year. Your profile gives you a chance to showcase your particular talents and style, and our directory is the first port of call when a trade mark or prospective trade mark registration holder contacts the UK IPO for help.

It takes less than five minutes to update with a photo, bio and specialisms, and our statistics show

that those with a completed profile are 50 per cent more likely to be viewed than those without. Direct feedback from members indicates that some have received enquiries via their profiles from people who subsequently become important clients.

### Contribute content

We are also looking for new content that will pique the interest of those who are influential in the food and beverage sector. If you can contribute a blog on the food and beverage sector, please email [richard@citma.org.uk](mailto:richard@citma.org.uk) with details.

We will also be creating content for social media, which we welcome you to share. We will be in touch with this once we launch.

We are excited by the ways this campaign will benefit you and the whole profession, and we hope you will take every advantage of the various opportunities to get involved.

**Increase your impact**  
*Would you like to have a bigger presence in our Chartered Trade Mark Attorney campaign? We are seeking financial contributions, for which you would be listed on the campaign landing page, with a logo and link to your website. You would also be listed as a supporter in the campaign report and mentioned on social media. If this is an opportunity that you would be interested in, please email [richard@citma.org.uk](mailto:richard@citma.org.uk)*

## GET YOUR UPDATE ON DESIGNS

Our webinar with CIPA will give you details of the most important design cases of the year. Book at [citma.org.uk](http://citma.org.uk) by 31st March to secure your place

## CITMA IS COMING

As Chief Executive Keven Bader explained in his most recent letter to members, we are working to develop a series of events to be held around the UK in conjunction with the UK IPO. These events will enable members to hear directly from the UK IPO and also to engage in an interactive session with

CITMA to look at our priorities and help shape our plans for the future.

Over the course of this year, we will be developing a strategic plan for the period 2021-2024. Your involvement will be critical in creating a plan that will help the organisation and the profession to continue to evolve and thrive.

Our aim is to begin the roadshow in May and to visit the north-east, the north-west, the Midlands and the south west of England, plus London and Scotland. Please look out for further information soon at [citma.org.uk](http://citma.org.uk)

## LAWCARE LAUNCHES FIT FOR LAW

LawCare, which provides support for the legal community, has launched a free resource designed to help develop emotional competency and professional resilience in the legal community.

Fit for Law is an interactive course developed with academics from the University of Sheffield and the Open University. It is broken down into small sections and includes a range of interactive activities, and videos from legal professionals discussing wellbeing issues.

Elizabeth Rimmer, Chief Executive of LawCare, said: "We know from our work supporting lawyers over the past 20 years how difficult it is for lawyers to admit that they are struggling with

the pressures of work, which often leads them to seek help only when they are nearing crisis.

"Providing legal professionals with resources to enable them to understand and develop key emotional competencies such as emotional self-awareness, self-reflection and better strategies for emotional self-regulation will equip them more effectively for practice, enhance their wellbeing and potentially reduce levels of stress, anxiety and depression."

The resource is available to everyone studying law or working in the legal profession in the UK and Ireland and could be used as CPD in some jurisdictions.

For more information, visit [fitforlaw.org.uk](http://fitforlaw.org.uk)



## Beck Greener takes back quiz crown

Following a second-place showing last year, former champions Beck Greener came out on top at our annual quiz night, which raised more than £1,900 for charity.

At the event, 24 teams from the intellectual property legal profession filled Salsa! in Temple for an all-out trivia showdown.

Team 'Vince and Colin' from Beck Greener came out on top, winning with a total of 171 points.

Following close behind was 'The Relevant Public' team from Reddie & Grose LLP, with a total of 167 points. Last year's winners, 'A Stonking Majority' from UDL, came a close third with 160.5 points.

The funds raised were split between Great Ormond Street Hospital and the CITMA Benevolent Fund. We look forward to our CITMA Quiz in Edinburgh, coming up on 25th March.

## TALENTED TRIO VIE FOR NATIONAL AWARD

Three talented trade mark paralegals have been shortlisted for the National Paralegal Awards, at which we are once again proud to sponsor the Best Trade Mark Paralegal category.

Last year's winner, Rebecca McBride (Mishcon de Reya LLP), is shortlisted once again. In addition, JoAnna Emery, a student member and Paralegal at

Pure Ideas Limited, and Cooley LLP's Rachel Bowerman have also made the final cut.

CITMA First Vice-President Richard Goddard will present the award on 27th March 2020 at the five-star De Vere Grand Connaught Rooms in London. Head to [nationalparalegalawards.com](http://nationalparalegalawards.com) for a full list of the shortlisted finalists.



# GUARDING THE IP GATEWAY

Accreditation must be an ongoing process, confirms Lord Smith

**Entry into the** intellectual property profession depends on the development of skills and a body of knowledge in the field of either patents or trade marks, or both. That is, of course, only right and proper, as it protects both the integrity of the profession and the rights of the consumer. And that is why IPReg's role in overseeing the quality of the educational routes into the profession is so crucial. It's an aspect of our work to which we are now giving additional emphasis.

Alarm bells sounded recently when we received some feedback from CITMA relating to one course, prompting us to examine carefully both the quality of that course and our own accreditation procedures. We have established an Education Working Group of IPReg board members to look in detail at how we go about the process of oversight. No longer is it good enough for us to go through a reaccreditation exercise for each university provider once every five years, and between times to sit back and assume everything is all right. We are determined to examine what happens on a regular basis, to respond immediately to expressions of concern from those undertaking the courses, to question the providers rigorously, and to step in if necessary. We see

“

*Courses have to be good. And the delivery has to be impeccable*

accreditation as an ongoing exercise, not just a one-off thing.

We were also pleased to see CIPA taking an active role in looking at the patent qualification routes, and the establishment of a CIPA committee to examine this is very welcome.

We are very conscious of the fact that successfully undertaking an accredited course is the only way into the profession; that many of those studying for a qualification are doing it at weekends and in their own time; that the cost of courses can be high; that sometimes people travel long distances to attend lectures; and that employers

are quite often supporting and funding the process. The courses therefore have to be good. And the delivery has to be impeccable. When it is not, IPReg has a duty to intervene.

We are also aware that there is currently a rather limited list of university providers. We are keen to see some more competition in this space, although we understand that there will always and must always be a limited capacity. But if one or two alternative providers were to come into the picture, this is something we would welcome. They do, however, have to meet the crucial test of being up to scratch.

The gateway into IP is narrow, by its very nature. But precisely because there are limited options, and the qualification process is so essential for the entrant into the profession, we have to make sure the educational route through it is up to the highest standards. IPReg is determined to play its part in helping to do so.



**The Rt Hon the Lord Smith of Finsbury**  
Chair of IPReg

Lord Smith will be a featured speaker at the CITMA Spring Conference 2020.

**Come and see us at the CITMA Spring conference**



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# WORLD



Aaron Wood foresees a war for talent when it comes to UK IPO appearances

**This time last** year, I got out my crystal ball and predicted a rise in contentious work even if Brexit did not progress. This was based on the concept of “doubling up”, the projection that this would largely affect the number of cases “on the papers”, and an assumption that these would be “children” to EUIPO cases (at the same time expressing the hope that parties would appreciate the particular benefits of the UK system over the EUIPO). I was partly right, but of course Brexit – while seeming to

be inevitable at the time of writing – did not proceed to plan, and so the scale of the rise has not been as large as might have been expected.

Nonetheless, 2019 did see a 16 per cent rise in the number of cases before the UK IPO Tribunal Section and Appointed Persons. This rise is attributed at least in part to the larger number of UK trade mark applications stemming from new filings in the UK alongside the EUIPO.

The UK IPO has addressed this by appointing a number of new Hearing Officers, and the anticipated rise in

# THE



## 2019: FIRM APPEARANCES IN FULL

Position	Firm	Total
1	Keystone Law*	11
=	Stobbs IP	11
3	HGF	10
4	UDL	8
5	D Young & Co	7
=	Murgitroyd	7
=	Wilson Gunn	7
8	Potter Clarkson	6
=	Stevens Hewlett Perkins	6
10	Bird & Bird	5
=	WP Thompson	5
12	Appleyard Lees	4
=	Boult	4
=	Forresters	4
=	Joshi Worldwide	4
=	Lane IP	4
=	Marks & Clerk	4
=	Mathys & Squire	4
=	Maucher Jenkins	4
=	Trade Mark Wizards	4
=	Withers & Rogers	4

\*Includes Wood IP appearances



“ In 2019, the absolute number of hearings rose, meaning that the UK IPO was not only confronted with a greater number of cases overall but also a greater number of hearings

UK oppositions is at least part of the rationale behind the drive to appoint a number of new Appointed Persons. It is anticipated that there will be further growth in the number of contentious cases before the UK IPO.

Meanwhile, the percentage of cases being resolved by way of submissions on the papers rather than by hearings has stayed broadly similar (31 per cent by hearings in 2019, versus 30 per cent in 2018, but somewhat lower than the 38 per cent seen in previous years). It is worth noting, however, that the absolute number of hearings rose, meaning that the UK IPO was not only confronted with a greater number of cases overall but – more importantly – a greater number of

hearings. As to whether it was attorneys, solicitors or counsel that appeared, the percentages changed from 52:48 in favour of barristers in 2018 to 54:46 in favour of barristers over the past year.

In 2018, we reported that only 27 firms had taken part in two or more oral hearings over the previous five years, and that statistic holds true (although the firms involved have changed). Only 52 have had an average of one or more case per year go to an oral hearing – that’s approximately one in seven of the firms that have had an oral hearing in the 11 years for which we have collected data. Only 24 have had an average of more than two hearings per year over that period. The ▶

statistics relating to the percentage of all appearances involving the top five and top 10 individuals and the top 10 firms remain similar to 2018 (21, 31, 31) at 17, 29 and 31 per cent respectively for 2019.

I attribute the slight drop in the first two of those figures to the slightly broader range of counsel appearances last year. While a number of members of counsel appeared many times over both years, 2019 saw some members of counsel return after a few lean years in terms of UK IPO hearings.

If we break down the number of appearances in 2019 by attorneys and solicitors, the top five individuals contributed 22 per cent of the total appearances, of which the top two attorneys contributed 19 per cent of the overall figure.

Over the 11-year period for which data has been analysed, only 35 people have appeared on average more than once per year, of which only nine are not counsel (versus 10 of 40 in 2018). Over the past five years, only 43 individuals have averaged more than one case per year (of which 14 are not counsel). That's broadly similar to last year's figure (16 of 50).

If we look at the same metric for firms, this gives 43 firms over the 11-year period and 47 over the five-year period. This suggests a flat position in a market that is seeing growth. The growth of more than 10 per cent in the number of different legal representatives appearing may suggest the further extension of a "long tail" of representatives who appear only rarely (of the 248 who have appeared five times or fewer

**“ Counsel tend to start taking an increasing number of UK IPO cases at around three years' call, topping out at around seven years' call**

in the past five years, 158 have only appeared once).

With the growth of the IP Enterprise Court, the current heavy flow of patent cases through all the courts, Brexit, and the progression of a number of the most popular junior counsel into more trial work, it will be interesting to see whether there are bottlenecks in 2020 with regard to obtaining the most experienced

counsel for oral hearings, with a resulting growth in the number of attorneys handling their own hearings.

Reviewing the statistics as to when counsel tend to start undertaking UK IPO hearings and when they appear to phase them out in favour of trial work, one sees that there may be a gap coming. A review of the websites of the leading IP chambers suggests that while there were a number of

## 2019: BARRISTER APPEARANCES

Position	Name	Chambers	Total
1	Charlotte Blythe	Hogarth Chambers	9
2	Jamie Muir Wood	Hogarth Chambers	8
3	Tom St Quintin	Hogarth Chambers	7
4	Tom Alkin	11 South Square	6
=	Benet Brandreth QC	11 South Square	6
=	Daniele Selmi	3 New Square	6
=	Nick Zweck	Hogarth Chambers	6
8	Ashton Chantrielle	8 New Square	5
=	Christopher Hall	11 South Square	5
=	Denise McFarland	3 New Square	5
=	Jonathan Moss	Hogarth Chambers	5

## 2019: SOLICITOR/TMA APPEARANCES

Position	Name	Firm	Total
1	Aaron Wood	Keystone Law	11
2	Julius Stobbs	Stobbs IP	10
3	Alan Fiddes	UDL	5
4	Lee Curtis	HGF	4
=	Rigel Moss-McGrath	WP Thompson	4
6	Marisa Broughton	Withers & Rogers	3
=	Max Stacey	Baron Warren Redfern	3
8	Ian Bartlett	Beck Greener	2
=	Michael Brown	Alpha & Omega	2
=	Leighton Cassidy	Fieldfisher	2
=	Patricia Collis	Bird & Bird	2
=	Nick Downing	Downing IP	2
=	Richard Gallafent	Gallafents	2
=	Chris Hoole	Appleyard Lees	2
=	Andrew Marsden	Wilson Gunn	2
=	Chris McLeod	Elkington & Fife	2
=	Jeremy Pennant	D Young & Co	2



## APPEARANCES 2015-2019

### FIRMS

Position	Firm	No of cases
1	Keystone Law*	33
=	Stobbs IP	33
3	D Young & Co	26
4	Haseltine Lake	23
5	Bird & Bird	22
=	HGF	22
7	Beck Greener	21
=	CMS Cameron McKenna Nabarro Olswang LLP	21
=	Potter Clarkson	21
=	Wilson Gunn	21
11	Withers & Rogers	20
12	Marks & Clerk	17
=	UDL	17
14	Murgitroyd	15
15	Kilburn & Strode	14
=	Lane IP	14
17	Boult	13
18	Appleyard Lees	12
=	Cleveland Scott York	12
=	Mathys & Squire	12

\*Incorporates figures for Wood IP

new tenancies in 2012 (six across the leading chambers), this number has since slipped, with no tenancies from these chambers in 2015 and 2017 and lower figures in 2016 and 2018.

Analysis suggests that counsel tend to start taking an increasing number of UK IPO cases at around three years' call, topping out at around seven years' call (presumably as they begin doing more trial work and are simply unavailable). Unless these members of counsel accept a far higher workload, mixing trial and UK IPO work, then there may be a war for talent on its way – which may lead to a hike in the rates of counsel. ●

*All data presented is based on the relevant calendar year(s). Raw data collected from the UK IPO.*



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### BARRISTERS

Position	Name	Chambers	No of cases
1	Charlotte Blythe	Hogarth Chambers	42
2	Tom St Quintin	Hogarth Chambers	32
3	Jonathan Moss	Hogarth Chambers	29
4	Amanda Michaels	Hogarth Chambers	24
5	Simon Malynicz QC	3 New Square	22
6	Ashton Chantrielle	8 New Square	18
=	Philip Harris	-	18
=	Jamie Muir Wood	Hogarth Chambers	18
9	Andrew Norris	Hogarth Chambers	16
10	Michael Hicks	Hogarth Chambers	15


### TMA/SOLICITORS

Position	Name	Firm	No of cases
1	Aaron Wood	Keystone Law	33
2	Julius Stobbs	Stobbs IP	30
3	Ian Bartlett	Beck Greener	14
4	Alan Fiddes	UDL	13
5	Martin Krause	Haseltine Lake	12
6	Marisa Broughton	Withers & Rogers	7
=	Leighton Cassidy	Fieldfisher	7
=	Barbara Cookson	Filemot Technologies	7
=	Lee Curtis	HGF	7
=	Rigel Moss-McGrath	WP Thompson	7



# BORN IN THE USA?

Whether or not you're a domestic representative may now determine your ability to handle a US registration. Christopher J Schulte explains why



“ A rule requiring domestic representation came into effect on 3rd August 2019 and seems to have had a substantial impact already

In an apparent effort to drive innovation and increase investment in intellectual property, local provinces in China have offered incentives to companies and individuals for every US trade mark registration they achieve – as much as \$800 per registration. The result? A massive increase not only in trade mark filings by Chinese applicants, but fraudulent specimens and the unauthorised practice of law.

This has prompted the United States Patent and Trademark Office (USPTO) to develop various initiatives to curb these abuses – including a requirement that overseas applicants retain local counsel – which will change how non-US trade mark applicants conduct business at the USPTO.

#### ORIGINS OF THE CHANGE

Based on the data the USPTO provided related to its new rules, trade mark applications from foreign applicants have risen steadily since 2015 – from 19 per cent of the total applications filed to 26 per cent in 2017. Prior to 2015, applications from China numbered only around 5,000 per year. By 2017, that number had grown by a factor of 10, exceeding 50,000 applications annually. That same period saw a dramatic rise in the percentage of filings from foreign *pro se* (unrepresented) applicants, from 25 per cent to 44 per cent. By contrast, US-owned applications filed *pro se* during that time period remained steady, hovering between 25 and 28 per cent.

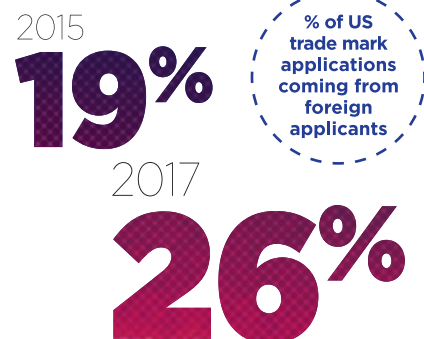
A rule requiring domestic representation came into effect on

3rd August 2019 and seems to have had a substantial impact already. Indeed, after the USPTO reported the impending rule change, filings from China rose substantially. *World Trademark Review* reported that the percentage of applications from China rose from 14.2 per cent of the total daily filings in June 2019 to approximately 50 per cent of all applications in July – and spiking on 28th July at 78 per cent.

A search of USPTO data by TM TKO revealed that 14,322 applications were filed by Chinese applicants from 3rd August to 31st December 2019. The same period in 2018 saw 20,544 applications from China. The rule change appears to have effected a 30 per cent drop in such filings.

#### THE RISE OF THE FALSE SPECIMEN

As many UK filers well know, an overseas applicant can obtain a US trade mark registration in one of two ways. The first is to employ the Paris Convention (or Madrid Protocol) and base the US registration upon a UK (or EU) registration. This approach requires no proof of use of the mark ▶



## THE BAI IMAGES



Spot the difference: some of the interesting images offered by BAI (left) and strangely similar existing brands

at the time of registration (although use will have to be shown at the five-year filing period for maintenance documents).

The second method for obtaining a registration in America is to demonstrate use in the US and obtain what is known as a 1(a) registration based on use in commerce. While the initial application can be filed without any use (an 'intent-to-use' filing basis), a specimen of use of the mark in America will eventually be required for registration.

Chinese filers with no actual intent to use a mark in the US nevertheless filed under a use or intent-to-use basis, with no claim of foreign pending application. (After all, if the goal is to obtain the reward for an overseas registration, why bother

with a local national application?) Moreover, most of these filings were made under the TEAS Plus form, which is the least expensive and fastest way to register a mark. (The filing fee is just \$225 per class as long as the applicant complies with certain requirements, such as using approved specifications from the US ID Manual.)

As the bulk of these filings were based on use (and therefore alleged a 1(a) basis), these filers had to produce a specimen of use to obtain the registration certificate and their \$800 payday. This is where things got interesting, as the USPTO has discovered some rather inventive image manipulation.

### ALTERED IMAGES

A Chinese filer called Shenzhen Outu Intelligent Technology Co., Ltd filed for the BAI mark in various single-class applications for a variety of products and services ranging from food to investment services. However, the Trademark Examining Attorneys assigned to these applications discovered that the majority of the specimens of use were actually altered images of third-party products.

*“ The BAI specimens offer a prime example of why the USPTO has pushed for rule changes*

# 50%

of randomly audited registrations have resulted in the deletion of some goods and services, according to the USPTO Commissioner's Office

In the case of its class 30 application for various foods including honey and coffee, the Applicant simply doctored actual products originating from New Zealand and Italy. For the application related to beer, the Applicant used a Belgian product (see panel, left).

The Applicant's purported US attorney – Samen Chen of Brooklyn, New York – has been barred from any further activity at the USPTO based on an Exclusion Order dated 21st March 2017. He was involved in more than 900 trade mark applications or registrations. He never responded to the show-cause order that presented evidence that he was not a licensed attorney. His fraudulent specimens and apparent lack of licensure as an attorney in the US were a prime example of why the USPTO has pushed for rule changes.

### ROBUST RESPONSE

This glut of Chinese applications and fraud in specimens has triggered USPTO action on various levels. The Office has commenced a pilot programme to encourage the public to report fraudulent application material and a post-registration audit programme. This random audit requires registrants to provide specimens on additional goods and services in the registration beyond the usual one-specimen-per-class requirement. According to the USPTO Commissioner's Office, 50 per cent of the audited registrations have resulted in the deletion of some goods and services.

The USPTO has also hired a large number of new Examining Attorneys: 61 in 2018, 83 in 2019 and another 40



expected in 2020. The Office has also sought Congressional assistance to amend the Lanham Act (the federal trade mark law) with a number of new proposed laws to combat this situation. These range from a new lack-of-use expungement proceeding to *ex parte* re-examination related to claims of use.

And, as noted, the USPTO now requires all foreign applicants, registrants or parties to be represented by a licensed US attorney. The theory is that the Office will have far greater control over the application process if it can enforce against a local attorney and their licence.

The USPTO has stated that this rule comports with the representation requirements of many other countries, including China, South Korea and the EU. The rule sets out a bright-line test for applicants that fall within the scope of this rule: “foreign-domiciled” applicants, registrants and parties. A “foreign-domiciled” entity is one that does not have a principal place of business (headquarters) in the US. The principal place of business is where the entity’s senior executives or officers ordinarily direct and control the entity’s activities.

While appointment of a US attorney is not required upon initial filing of a normal application at the USPTO (the TEAS Regular and TEAS RF forms), a TEAS Plus form will now require the applicant to include local counsel information at the time of filing or lose the TEAS Plus status. As such, the days of the inexpensive direct filing with a doctored specimen are over.

This new rule may affect tens of thousands of filings. But the impact will be far greater on Chinese applicants than those from the UK. According to searches performed by TM TKO, of the 68,639 applications filed by Chinese applicants in 2019, 66,100 (96 per cent) were use-based or intent-to-use filings with no Paris Convention claim. Only 2,146 of the 5,860 applications from the UK were filed on that basis in 2019 (37 per cent).

While the non-Paris Convention filings from the UK may seem a bit high, it may also be that many of those filings were made based on a non-US filing that was outside of the Paris Convention’s six-month priority period but not yet registered. As the US does not have a filing basis for “eventual registration” of a foreign

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OF 68,639

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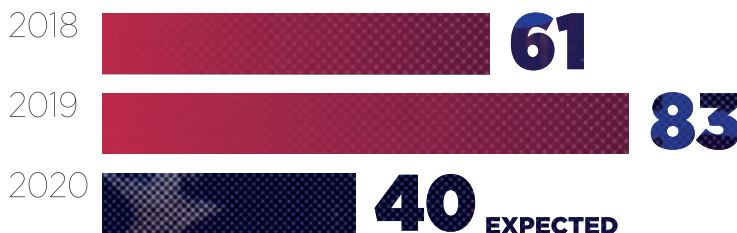
ONLY  
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mark, the only basis available to such applicants is the intent-to-use basis. An example of this is the CAMPERS & DENS mark for office furniture out of Cardiff-based Orangebox Ltd. Its US application was filed on 8th November 2019 but its EU trade mark was filed some two years earlier (US Ser. No. 88/684840 and EUTM Reg. No. 017503533). It therefore had to file under the intent-to-use basis.

Even more enlightening is a search of 2019 applications that show no US attorney representation. Of the 68,639 total applications filed by Chinese owners, 40,956 applications showed no counsel involved (60 per cent). And of those applications, just 1,291 were Madrid Protocol extensions. In contrast, of the 5,834 ▶

**USPTO action: Number of new Examining Attorneys**





**60%**  
NO US ATTORNEY  
REPRESENTATION

Of the 68,639 total USPTO applications filed by Chinese owners,

**40,956**

applications showed no counsel involved

UK filings made, just 1,543 were unrepresented (26 per cent), and of those 1,071 were through the Madrid Protocol (thus no US attorney is listed). While these searches are not perfect (the data is a current snapshot of the applications and does not capture a change in representation status since filing), they generally bear out the reality that the rule change on representation will have a far greater impact on Chinese applicants than on those in the UK, affecting tens of thousands of Chinese applicants versus a few hundred in the UK.

to rely on a foreign registration once it matures, whereas a Chinese applicant with no home filing at all will eventually have to prove use in the US.

Given that the process for many UK filers into the US has always included retaining US counsel to pare down the specification to meet local office practice, not much may change based on this new rule. If a UK applicant files without identifying a US attorney, then an USPTO action will be issued, whereby the applicant must identify local counsel to continue the prosecution.

publication without any complaint by an examiner, no US attorney need be identified. However, since most Madrid filings are based on UK or EU home registrations, it seems unlikely such an extension would sail through the USPTO without any objections as to the specification.

Maintenance and renewal filings are also subject to the new rule. For registrations that came into effect before its implementation, an attorney will now be required to effectuate the renewal. And while Madrid Protocol filings are currently exempt, once the USPTO irons out a suitable modification to the WIPO forms, that could change as well.

Essentially, most applicants from the UK will probably not have to change their approach to seeking protection in the US. However, TEAS Plus applicants who have previously filed under the Paris Convention will now need to sort out local representation. And larger entities filing directly with no local in-house counsel will have to consider whether to claim their US office as their “domicile” in order to eliminate the need for local counsel. A registration that issues on this basis, however, could be attacked later as a violation of the rule requiring local representation. ●

**“** For the most part, filings from the UK are made into the US as an extension of the life of a brand, rather than as a first filing in the world

**EXPANSION INTENTION**

The data related to UK applicants into the US and the above anecdote bear out a distinction that is worth noting. For the most part, filings from the UK are made into the US as an expansion in the life of a brand, rather than as a first filing in the world. Whether or not a UK applicant is able to use a UK (or EU) application for the filing basis, the fact of the matter is that trade mark filings into the US generally follow business plans, as opposed to being the business plan (as is the case with certain Chinese filings). A UK applicant outside the priority period may nonetheless amend the eventual registration basis

Madrid Protocol filings offer one possible work-around. As the Madrid forms do not currently provide a means to identify local counsel, the rule will not be enforced against such requests to extend protection unless a USPTO action on other grounds is issued. That means that if a UK Madrid filer somehow makes it to



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# IS IP DIVERSE?

Two recent pieces of research explore this crucial but complex question

The issue of diversity is firmly on the radar of the IP sector. For example, in a January 2019 report, the Legal Services Board said that it welcomed IPReg's decision to ring-fence funds for diversity initiatives and the move to include diversity data in its new CRM system. At the time of writing, IP Inclusive has welcomed the 147th signatory to its Equality, Diversity and Inclusion Charter, with its Lead Executive Andrea Brewster being named as one of *Managing IP's* 50 Most Influential People in IP for 2019. Meanwhile, in its 2019 Annual Report, IP Inclusive notes that the organisation is reaching "more people, extending our influence, and increasing our ability to make positive change".

Nonetheless, while diversity and inclusion (D&I) activities are clearly valued and ongoing, it remains one

of the most difficult areas on which to find or collect solid, quantifiable data at scale. This was one of the realities acknowledged in the IP Inclusive diversity benchmarking survey released in January. The first survey of its kind, its aim, says Brewster, "was to gather some basic benchmarking data for the IP sector as a whole, against which to measure IP Inclusive's progress in promoting diversity and also to inform our future work".

All told, the survey attracted more than 1,000 responses. Some of the "bigger picture" points that can be taken from the survey results include the news that:

- The IP professions as a whole include a reasonable proportion of women; that proportion being higher among Trade Mark Attorneys and in roles such as IP paralegals, secretaries and business support professionals. (CITMA's current

membership data concurs, indicating that women make up 53 per cent of Trade Mark Attorney members.)

- The level of diversity in terms of sexuality is deemed reasonable compared with the overall UK population. However, the report notes that many non-heterosexuals are unable to be "out" at work, and feedback suggests that there are still improvements to be made in "our sector's understanding and acceptance of less 'conventional' forms of sexuality and gender identity".

- The proportion of disabled people and carers for disabled people in the sector is very low, with many disabled professionals feeling unable to tell their employers about their conditions.

- In terms of social mobility, the responses show that it is – or at least that it has been – possible for people from less privileged backgrounds to access the sector. ▶



• The IP professions have very low levels of ethnic diversity. For example, less than 13 per cent of respondents identified as other than “white”. There appears to be even less ethnic diversity at senior levels (91 per cent identifying as white), but more at junior levels (82 per cent preferring the white designation). The report expresses the hope that this “augurs better for the future”.

In reporting the findings, however, Brewster counsels caution when it comes to taking the results at face value. As she explains in the document, the relative response levels for female and male IP professionals suggest that people from so-called “minority” groups were more likely to have responded to the survey than their counterparts in “majority” groups, and this may have distorted the results somewhat.

In particular, responses related to capturing ethnicity data illustrate the complexity of the endeavour. Despite offering eight potential responses to the question “Which of the following describes your ethnicity”, three per cent of respondents chose the “other” category. Comments on

“ Three-quarters of respondents felt that it was ‘essential’ for colleagues from a BAME background to be visible

this question included “I do not agree with your definition of ethnicity. I am white but I don’t feel that I belong to a ‘white group’” and “Mixed: white + Middle Eastern (the Levant) (NOT Arab or Asian, but stupid diversity forms only ever give the options ‘Arab’ or ‘Asian’, which are not accurate at all for me and often frustrating...)”.

“The question conceded”, says the report, “that it was not possible to get these categories right for everyone... The ‘other’ category was deliberately included to allow people to self-identify in whatever way they chose, and we are grateful to those who took the time to tell us how they do.”

#### CITMA EXPERIENCE

Recognising the critical need for more information on our industry’s diversity, the *CITMA Review* has also recently undertaken a project aimed at capturing views on diversity, in particular those coming direct from

the Black and Minority Ethnic (BAME) community. To this end, a short questionnaire was circulated to a volunteer focus group of 16 IP professionals that identify as coming from an ethnic minority. Participants were questioned on a range of issues, including what firms and the wider profession can do to show their commitment to D&I.

Due to the small sample, and acknowledging that our respondents represent people with a range of different protected characteristics, including their identification as being from a BAME background, we must counsel caution when it comes to generalising the results. However, there are some interesting leads to be taken from both the specific answers and the comments that accompanied them.

Crucially, on the broad question of whether the UK IP profession is diverse on the whole, only one respondent believed that this was the case. In fact, one of the respondents commented: “On entering the profession, the lack of racial diversity made me question whether it was for me.”

All the respondents said that they care about D&I in general (81 per cent said they care “a lot”), and half felt their firms attract and retain qualified and talented people from ethnic minority backgrounds. However, clarity on whether firms have specific initiatives to support BAME people seems to need shoring up. On this question, more than half of respondents answered “don’t know”, with just two out of 16 declaring “yes”. Examples of initiatives that people did note included the use of ‘blind’ CVs in the recruiting process, diversity





events and committees, and collaboration with D&I initiatives that encourage young people to embark on STEM careers. These are all great ideas for firms seeking to develop in D&I.

Meanwhile, 75 per cent considered their own firm/company to be diverse and inclusive. Of those who held this view, three-quarters said that this had influenced their decision to join the firm.

Among the ideas given for demonstrating a commitment to D&I were: “Make the D&I policy prominent during the recruitment process and include it in the new-starter welcome pack”; “Support events celebrating different cultures and provide a proper forum for discussion about issues faced by BAME [employees] in the firm and dealing with any concerns;” and “Involve existing staff from diverse backgrounds in D&I implementation.”

Just over 60 per cent said that they had experienced barriers or challenges before entering the profession, with a lack of work experience and mentoring opportunities emerging as their two top concerns, followed by social class/background (four out of nine respondents) and financial resources (three out of nine respondents).

The majority of those who were able to identify a factor (10 out of 13 respondents) said that they believed their educational background played a vital role in terms of getting them to the position they are in today (this is particularly true for patent practitioners). This was by far the largest factor towards progression cited, with the next being personal/professional networks, cited by five out of 13. Here it may be useful to mention that 69 per cent of respondents attended a Russell Group university.

A notable suggestion by some of the respondents is that firms should widen the pool of universities from



which they recruit, which highlights the importance of outreach initiatives. As one respondent noted: “The Trade Mark Attorney profession isn’t very well-known or understood. I came across it by chance after I had already begun my career in law.”

#### **VISIBILITY ESSENTIAL**

Three-quarters of respondents felt that it is “essential” for colleagues from a BAME background to be visible and proactive in encouraging BAME people to enter and/or remain in the profession. The visibility of ethnic minority IP practitioners, regardless of seniority, would show candidates and those in the early stages of their career that the profession is diverse, open and progressive.

One important takeaway from our group was that the respondents had overcome their respective challenges and are working in the IP profession. This observation and the support that organisations like IP Inclusive receive are a testament to the fact that the UK IP profession as a whole aspires to be open to anyone with the appropriate qualifications and aptitude – if it isn’t entirely there yet.

Some comments from participants also offered encouragement to

prospective IP professionals and a sense of positive change, including the advice that they shouldn’t “be put off by the traditional image of a ‘white, male Oxbridge boys’ club’. This is changing”. Another advises: “Do it! You are welcome and you will not be alone given the growing number of associations for BAME lawyers and professionals.”

However, it’s clear that there is room for improvement and better understanding. And firms cannot shoulder the burden alone; university careers services should also play their part in informing their students and graduates about the IP profession. Meanwhile, professional bodies such as CITMA and other organisations like IP Inclusive will continue to work to generate insights and foster conversations that will support the future development of D&I in the IP profession. ●

*With thanks to Kingsley Egbunu for his assistance in the design of the CITMA questionnaire and summary. Quotes included represent selected comments from the respondents and may have been edited for clarity. Find out more about IP Inclusive’s diversity survey at [ipinclusive.org.uk](http://ipinclusive.org.uk)*

# TAKE FIVE

## Asking yourself just a few crucial questions may increase your odds of success before the Appointed Person

As the saying goes (more or less), sh\*t happens. And sh\*t decisions happen. The question is what you can do if the outcome is not what you wanted in the first instance. With the odds of success on appeal offering little encouragement (approximately five to 10 per cent of appeals are successful), how can you buck the trend?

### ASK YOURSELF: IS AN APPEAL REALLY NEEDED?

The first issue to consider is whether you actually want to appeal. For example, in one unreported appeal, the Appellant sought to overturn a decision that the defence to an opposition should be deemed withdrawn because the party did not have an EEA-based representative and had not put matters in order (despite reminders from the UK IPO). After much preparation, the parties appeared before the Appointed Person (AP) only for the AP to suggest that what they were seeking was not so much an appeal but a retrospective extension of time to file a form TM33. Counsel for the Appellant took the point, the appeal was vacated (hence no reported decision), and ultimately the Appellant convinced the UK IPO to allow the retrospective extension of

time. If the decision is not on the substance of the dispute, an appeal may not be the solution.

### IS THERE A BASIS TO APPEAL?

Here, the key questions to consider are whether the Hearing Officer (HO) asked the wrong question, misapplied the facts, or just got it wrong.

The first of those is perhaps the most straightforward to examine but the least likely to occur. Unless the HO has ignored your presentation of the relevant law, it is unlikely that an error of law will have arisen. Where you may have more success is where there is a lack of legal reasoning, which may be more common an occurrence in a procedural matter. For example, O/538/18 J W BENSON relates to an application for disclosure of a document. The request was rejected by the HO, but that decision was overturned on appeal – primarily because the HO gave no reasons for the decision, leading the AP to conclude that they should rehear the matter. Ultimately, though, the document did not help the opposing party.

As to an error in the appreciation of the facts, this relates to a failure to take into account relevant factors or an error of taking into account irrelevant factors. Yet, if a factor does not figure explicitly in the written decision, this can be a hard argument

to make. Just because a decision is not expressed perfectly does not mean there's an error in the conclusion. A party may suspect that an irrelevant factor was taken into account, or that a relevant one was ignored, but without clear evidence in the written decision it is difficult to bring such a case. Many of these cases morph into assertions that the HO simply got it wrong.

### HOW WRONG IS WRONG?

The use of “clearly wrong”, “plainly wrong” and other similar forms of words within judgments is aimed at pressing a point. The idea here is that the decision is not simply one that the AP would not have reached, but that it is one outside the bounds within which reasonable disagreement is possible. In short, the appellate judge is satisfied it is wrong.

In such circumstances, it is necessary to push the AP to the conclusion that the decision cannot possibly have been correct. There are a number of practical steps to take:

1. Get a copy of the transcript as soon as possible, or of the recording if no transcript is available. It is important to review the transcript or recording for submissions made that did not figure in the skeleton arguments and which may have influenced the HO.
2. Ask a colleague to review your case critically – are there gaps in the evidence or submissions which were not remedied (for either party)?
3. Can you find any errors of law?
4. Can you portray the decision as one founded on a mistaken reliance on an irrelevant fact or failure to consider a relevant fact?

### WHAT IS YOUR FALLBACK?

In drafting the grounds of an appeal, be aware of your fallback positions. For example, if you believe that the HO took an irrelevant factor into account but it is not stated explicitly in the decision, it is safer to allege reliance on an irrelevant factor and also that the decision overall is wrong. At the

grounds stage, it is not necessary to set out why you believe the irrelevant factor was taken into account. However, you should be prepared at the final hearing to put forward a convincing case as to why the HO cannot simply have heard the irrelevant evidence and given it no weight.

As to the final presentation of the appeal – whether delivered in writing or orally – it is possible (and may be preferable at times) to present all of the facts again as you would at first instance. Assuming there was no cross-examination, the AP is in as

“ *Just because a decision is not expressed perfectly does not mean there’s an error in the conclusion* ”

strong a position to review that evidence as the original decision maker. If your claim is that the decision is just wrong, you need to persuade the AP of the unassailable truth of your case. It is therefore even more important that you are completely prepared to present your position on that aspect of the case in a convincing and straightforward manner. As you are likely to be dealing with only some of the points, it is easier to focus on preparation.

#### **WHAT IS THE IMPACT OF THE MISTAKE?**

It is always worth considering the importance of the mistake. Consider whether any mistakes made in a decision would actually have altered the outcome: is a fact so important as to make an appeal worthwhile on its own? If you cannot answer “yes” to that question, an appeal may simply delay the inevitable and add to the overall costs of the case. ●

*With thanks to Aaron Wood, CITMA Law & Practice Working Group*





## It seems no brand is too large to lose a trade mark for non-use, John Coldham reports

When the famous McDonald's 'Big Mac' word mark is revoked for non-use, then perhaps it's time to sit up and take notice.

In a decision by the EUIPO last year (*Supermac's (Holdings) Ltd v McDonald's International Property Company Ltd 14/788 C*), McDonald's lost its EU trade mark (EUTM) for one of its best-known products, the Big Mac. This happened as a result of a challenge by Irish fast-food chain

Supermac's on the basis that the mark had not been put to genuine use for a continuous period of five years. That decision may be viewed as somewhat surprising given the sheer number of Big Macs that McDonald's sells every day. However, in a rather damning judgment, the Cancellation Division noted that while "the methods and means of proving genuine use of a mark are unlimited" and the standard of proof is not excessively high, in this case McDonald's lost its mark because it "chose to restrict the evidence

submitted". In other words, the evidence wasn't up to scratch.

So if McDonald's can lose its trade mark for lack of genuine use, it is a salutary warning to all trade mark owners not only to ensure they are using their trade marks, but that they are recording evidence of doing so in case there is a challenge at a later date.

### FUNDAMENTAL PRINCIPLE

The fundamental principle of genuine use is that a trade mark is liable to be cancelled where it has

Claridge's Hotel,  
Mayfair, London



not been put to genuine use within a period of five years following registration, or for any subsequent continuous five-year period. It is also important to note that any use of the mark in the immediate three months prior to a revocation action being brought will not be taken into account where the proprietor of the mark is aware of the possibility of proceedings.

While non-use actions can be brought independently of any other claim, they often arise as a counterclaim as part of other proceedings – either an opposition against a subsequent mark, or an infringement proceeding. For example, in a UK opposition, the opponent has to specify the goods and services the earlier mark has been used for in the relevant five-year period. The applicant will then have to decide whether to take this statement at face value or, more commonly, require the opponent to provide evidence of its use. This requirement to assert use, and potentially to prove it, is therefore intrinsic to and inseparable from the opposition process, which means there is always an inherent risk (whatever the magnitude) in opposing an application for a subsequent mark by a third party.

In terms of what constitutes genuine use, the case law is clear. Any use must be more than merely token and must be consistent with the essential function of a trade mark – that is, to denote the origin of goods and services. The use must represent real commercial exploitation of the mark on the market for the relevant goods and services. That's not to say that an assessment of the extent to which a use is genuine is necessarily interchangeable with an analysis of the commercial success or economic strategy of the trade mark proprietor. In fact, there have been cases where a

“ *Use must be more than merely token and must denote the origin of goods* ”

seemingly high number of sales have been found not to equate to genuine use, for example in the scenario where the sale of more than 15,000 bottles of water was not deemed sufficient because the relevant mark was registered for goods in a market where a volume of 15,000 bottles is considered extremely small. What is clear from that case and others is that what amounts to genuine use is highly context-specific, and that context is primarily based on the goods and services for which that mark is registered and the features of those markets. You would not need to show sales

of that volume if the mark were registered for goods such as aeroplanes, for example.

Looking at use of an EUTM, it is important to note that use in a single Member State may be sufficient to establish genuine use, even if the mark has not been used in other Member States. The courts view the EU as a borderless mass, so the question is whether the use is an attempt to take some of the market share in the EU. If it is, it will likely be considered sufficient. Conversely, token use will not be saved just because it has taken place in more than one EU Member State.

So what can you do to ensure you record and present sufficient evidence to prove use?

#### CONSIDER THE PROCEEDINGS CAREFULLY

When considering basing an opposition on your earlier trade mark, or starting infringement proceedings, it is important to consider the potential ramifications that such an action could have on your own trade mark.

In *Claridge's Hotel Ltd v Claridge Candles Ltd & Another* [2019] EWHC 2003 (IPEC), the well-known London hotel, Claridge's, brought a claim ▶



against Claridge Candles for trade mark infringement and passing off in relation to candles bearing the ‘Claridge’ name. A counterclaim was issued for revocation on the basis that Claridge’s trade mark CLARIDGE’S (registered in classes 3, 5, 16, 35, 43 and 44) was over five years old and not in use as registered. This counterclaim succeeded and Claridge’s was required to narrow the scope of its trade mark registration. The registration was reduced so as not to include either class 3 or 5 goods at all, and the remaining classes were also narrowed in scope. Sometimes, brand owners do not mind if their trade mark specifications are narrowed as a result of later legal challenges, provided they still cover the main goods and services for which they are being used. However, Claridge’s lost rather a lot of its registration as a result of pursuing this relatively small candle manufacturer. We can only hope that it understood the risk it was taking.

It is important for trade mark proprietors to consider whether a potentially infringing mark is

actually affecting their business or the distinctiveness of their brand, and whether it is worth risking a non-use challenge being received in response. It is therefore sensible to take care to choose the most appropriate trade mark to base the claim on, rather than simply including every relevant trade mark in the portfolio, and consider alternative ways to resolve the dispute if there is vulnerability that the size of the dispute at hand does not justify.

was noted in *Radoslaw Pielczyk v EUIPO* (Case T-398/18).

While all of these elements are key and the evidence as a whole must cover all four of them, it is worth paying particular attention to the requirement that the time or date of the use should be clearly demonstrated. The first step is to focus on the relevant period for which genuine use must be proved and to ensure that all of the evidence relates to use of the mark within that period – something that proprietors

## “Genuine use cannot be proved by probabilities and suppositions

### THOROUGHNESS IS KEY

If action is needed and the proprietor is required to prove genuine use, it is important to ensure the best possible case is put forward the first time round. As explained above, judges and IP offices are frequently criticising trade mark proprietors for not presenting the most effective evidence the first time, which can often lead to revocation.

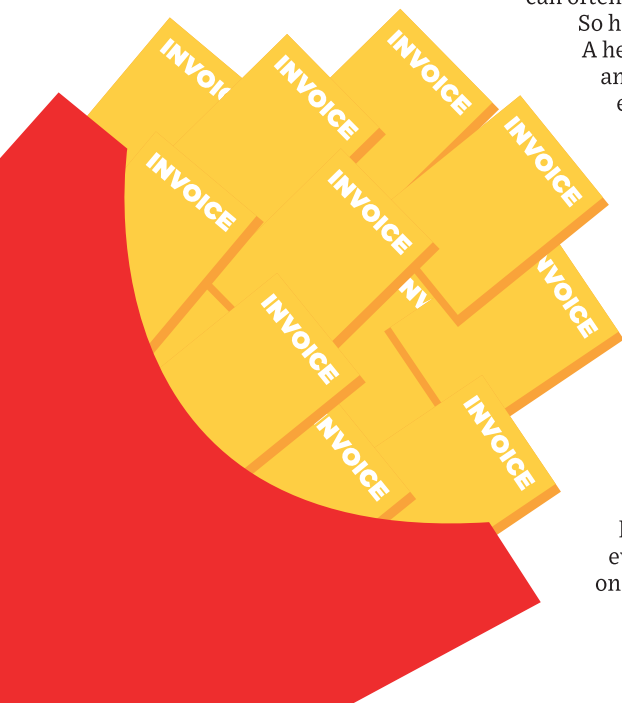
So how do you get it right?

A helpful starting point and framework for ensuring that evidence is sufficiently thorough can be found in Rule 22(3) of EU Regulation No. 2868/95, which states that any evidence adduced in proving genuine use must indicate the place, time, extent and nature of the use. That is not to say that each individual piece of evidence must demonstrate all of those elements; the courts have been clear that evidence is to be viewed on a cumulative basis, as

do badly surprisingly often. There is very limited scope for adducing evidence outside of this period and then relying on an assumption that the same material would have been available during that relevant time, as was attempted in *Benelli v OHIM* (Case T-170/13). As the *McDonald’s* case reminds us, the case law is clear that genuine use of a trade mark cannot be proved by probabilities or suppositions, but must be demonstrated by solid and objective evidence (*La Mer Technology*, C-259/02). The starting point, then, is that the evidence must relate to the relevant time period.

### THE VALUE OF INVOICES

The starting point for any evidence being adduced to prove genuine use is likely to be invoices for products bearing the relevant mark. Standard form invoices will always show the volume of goods and services purchased and will of course be dated. In *Radoslaw Pielczyk* (cited above), a wide spread of invoices covering the full range of the relevant five-year period was particularly effective. However, an invoice in itself will often not be able to communicate all of the elements noted in Rule 22(3), so





## IN SUMMARY: PROVING USE

**1** Always consider the risk and potential rewards of bringing an opposition or infringement claim. Has the trade mark you are relying on been used sufficiently and can you prove it? If not, are there other, narrower marks you can rely on without putting your broader marks at risk?

**2** Ensure you are aware of the relevant period for which use needs to be proved and focus your efforts on compiling evidence for that period.

**3** Check that your evidence tells a full story about the place, time, nature and extent of use of the mark, in relation to the products and services at hand. Ensure that there are no gaps in your evidence.

**4** Try to avoid relying on statements written by the proprietor or others associated with the proprietor. Where these are used, ensure that they are corroborated with independently verifiable documents or evidence.

to tell a comprehensive story of trade mark use, further evidence will be needed. Clearly demonstrating the connection between the specific goods referred to on an invoice and the actual use of the mark is key, for example by showing the packaging used at that time (bearing the mark). Even small details such as evidence showing the country in which the purchaser of the goods is domiciled – by printing company registrar extracts, for example, or showing evidence of onward sale via retailers in a particular country – can be useful for proving the territories

into which the goods have been sold and where a mark has been used.

### INVOICE ALTERNATIVES

Where invoices do not exist, there are still options available to prove genuine use, although some are stronger than others. The Big Mac case provides some particularly useful guidance on which types of evidence are and are not viewed favourably by the courts and IP offices, and how best to present such evidence so that it is most effective.

In that case, the trade mark proprietor relied particularly on website printouts, packaging and brochures showing use of the relevant mark. These materials failed to meet the requirements of Rule 22(3). In particular, it was noted by the Cancellation Division that website printouts showing the mark were insufficient to prove genuine use without further information being adduced as to where and when the website had been made available and, more importantly, how many people had actually visited the website. This could have been shown through, for example, the use of internet traffic data. It was also noted that for website printouts to be truly useful, it is important to show how the goods and services which are the subject of the revocation challenge can actually be purchased through that website. In relation to brochures and other marketing materials, the Big Mac case also shows us that simply bringing these materials to court with no supporting documents that provide context or explain them is not particularly helpful. Again, further information is required to

explain how the materials were circulated and to whom, as well as whether they ultimately led to purchases.

It is clear from the Big Mac case and others that written statements or affidavits produced by the trade mark proprietor or others associated with it, attesting to the use of a mark, are given relatively less weight than independently verifiable evidence. The key lesson from the case law is that, where it is necessary to use written statements, then these should be corroborated as far as possible by independent evidence (see, for example, Benelli, paragraph 71, cited above). Some other less conventional forms of evidence have also been used by parties attempting to prove genuine use, including Wikipedia entries and ‘guess the logo’-style board games. These have generally not been received well, particularly Wikipedia, as this can be edited freely so is not considered a reliable source.

Cases concerning genuine use very often turn on the quality of the evidence that is presented. It is therefore important to consider whether the evidence is of sufficient quality and relevance. Do not fall into the trap of assuming that a small handful of documents, and an invitation to the court or registry to extrapolate from there, will do the trick. It almost certainly will not. ●

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# Small brand bests Bentley

Michelle Phua explains why this was such a stunning decision

**On 1st November** 2019, the High Court ruled in favour of a small, family-run clothing company, Bentley Clothing, in a trade mark infringement claim against the renowned luxury car manufacturer, Bentley Motors, by virtue of s10(1) of the Trade Marks Act 1994 (the Act).

This decision was stunning, as many saw it as a real-life example of a David and Goliath battle. What was truly remarkable, though, was: (i) the Court's assessment of what is an identical mark under s10(1) and; (ii) that a brand's reputation, which would otherwise be seen as a vital tool in registration proceedings, could now be an Achilles' heel in an infringement claim.

## BACKGROUND

The Claimant is clothing company Brandlogic and its exclusive licensee Bentley 1962 Ltd,

which began a business in 1962 (together, Bentley Clothing). Bentley Motors (Bentley), the Defendant, had only ventured into the clothing business in 1987.

The marks in issue concerned use on clothing and headgear under class 25, shown right. The Bentley signs are known as the "B-in-Wing device" and the "BENTLEY word mark". Together, they are the "Combination Sign".

In 1998, Bentley Clothing became aware of Bentley's clothing range and approached it to discuss licensing. The parties engaged in several negotiations, but no agreement was reached. In 2004, Bentley filed an EU trade mark application for the BENTLEY word mark under class 25, expanded its clothing range and issued several proceedings against Bentley Clothing at the UK IPO and the EUIPO to revoke its associated marks. Bentley Clothing retaliated by issuing infringement proceedings.

## ONE SIGN OR TWO?

In deciding whether there is an infringement under s10(1) or s10(2) of the Act, the question was whether the Combination Sign would be seen by the average consumer of clothing as one sign or two. In this regard, "parties who are sophisticated in brand" – such as publishers in the automobile industry and design agencies – were ruled out from the scope of s10.



In the evidence presented by Bentley Clothing, Bentley itself treated the Combination Sign as two separate marks. Examples included: (i) referring to the Combination Sign in plural on swing tags attached to Bentley's clothing and in the T&Cs issued in relation to its clothing collection; and (ii) allowing licensees to use the Combination Sign either together or separately. The Court rebuffed Bentley's 2014 brand guidelines, which required use of the Combination Sign as one, finding it unrealistic to expect the average consumer to be aware of such brand policy.

The Court also dismissed Bentley's claim of issue estoppel, as the proceedings previously decided by the UK IPO related to a claim of passing off and the average consumer's interpretation of the Combination Sign was not considered. The Court therefore decided that because the two marks were used so extensively and separately in the past, the average consumer would naturally perceive these elements as two different signs.

### LIKELIHOOD OF CONFUSION

Judge Hacon went on to consider the likelihood of confusion in case the Combination Sign was to be treated as one under s10(2). Reference was made to *Maier v ASOS plc* [2015] EWCA Civ 220's principles, and assessment was made on the assumption that Bentley Clothing had made a notional and fair use of the BENTLEY word mark in relation to clothing and headgear.

It was clear that the dominant element of the Combination Sign was the BENTLEY word mark. The Court's reasoning was that given the popularity of the B-in-Wing device in the UK, the BENTLEY word mark below the device would only increase the likelihood of confusion. This was further reinforced by the verbal element of the BENTLEY word mark, as the average consumer would be more likely to refer to the goods by quoting the name than by describing the figurative element of the trade mark.

### DEFENCES

The two defences considered in this case were the Transitional Provisions of the 1994 Act and honest concurrent use. Under the Trade Mark Act 1938, a trade mark owner could not sue for infringement in respect of goods or services for

which the mark was not registered. Bentley therefore had a continuing right to sell jackets, silk ties, caps and scarves,

as these were not covered by the BENTLEY mark registered by Bentley Clothing before 1994. However, the more important question was whether the defence applies to a wider use of the mark. Judge Hacon thought it would be absurd to think it was Parliament's intention to allow parties to branch out into new uses of signs which have since become the exclusive right of a trade mark proprietor.

This defence therefore did not entitle Bentley to continue the sale of other types of clothing or headgear by using that sign on the goods themselves or on catalogues or other material attached to the goods.

In relation to honest concurrent use<sup>1</sup>, the Court acknowledged<sup>2</sup> that it would be possible for the two separate entities to coexist, such that the inevitable confusion that arises has to be tolerated. However, Bentley's conduct was found to exacerbate the level of confusion beyond what was inevitable, thus encroaching on Bentley Clothing's goodwill.

### PRAGMATIC DECISION

The Court was entirely pragmatic and sympathetic in assessing the merits of this case. The judgment not only highlighted the strength of trade mark protection, but also underlined the risk of a finding of infringement when a reputed brand tries to enter a new market by incrementally increasing its commercial activities without giving due respect to the existing right holders in the given area.

Lastly, it may be good practice to ensure that combination signs are always used in a consistent manner and align with present as well as future business plans.

*“ Bentley's conduct was found to exacerbate the level of confusion beyond what was inevitable*

### KEY POINTS

- + Reputation of marks established in one trade area may not necessarily mean easy access to another
- + Real-world use of a mark will impact the assessment of what is an identical or similar mark
- + The importance of conducting thorough searches before launching into new areas of business cannot be emphasised enough

### MARKS

BENTLEY CLOTHING MARKS:



No. 1180215

BENTLEY

No. 2505233  
(WORD MARK)

BENTLEY

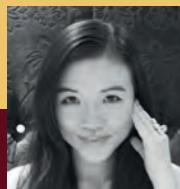


No. 2177779A  
(SERIES MARK)

BENTLEY MOTORS' COMBINATION SIGN:



BENTLEY



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# A difficult distinction

This detailed decision leaves an open question, writes Dewdney Drew



**A1 Arborists Ltd** (A1) and the European Forestry and Environmental Skills Council (EFESC) had worked together for a period of time, with a view to establishing a common certification standard for chainsaw competency, one of the monikers for which would be “ECC European Chainsaw Certificate”. A notable point in the collaborative period was a meeting in London in August 2011, when the parties concluded the meeting by signing a number of action items written on a whiteboard. One of the action items was that intellectual property would be shared. After that, the parties went their separate ways.

In May 2017, A1, which had pursued its own programme in the UK following the parting of ways, filed a number of UK trade mark applications, including for ECC EUROPEAN CHAINSAW CERTIFICATE, to secure its position when it appeared that EFESC was claiming exclusive rights to the mark. EFESC opposed the applications on a number of grounds, including bad faith.

At a hearing before the UK IPO, four of the eight applications survived opposition, and EFESC failed to demonstrate genuine use of its earlier EUTM for ECC EUROPEAN CHAINSAW CERTIFICATE (stylised, shown right) which was registered for “certificates” rather than training or certification services. However, the remaining four, including ECC EUROPEAN CHAINSAW CERTIFICATE, were found to have been filed in bad faith and were refused.

A1 appealed to the Appointed Person. The grounds included:

- The relevant date for assessing bad faith was May 2017 and not August 2011;
- Regard was not given to the absence of usage by EFESC in the UK and the years of usage by A1, prior to A1 filing the UK applications;
- The Hearing Officer (HO) did not ascertain the actual state of mind of A1 in May 2017 but rather what it should have known;
- A negative finding as to bad faith was not open to the HO in the absence of an unequivocal challenge to the written

evidence, cross-examination (of A1’s principal) and cogent or persuasive reasons in support from EFESC;

- A1’s evidence that it filed the applications to secure its position should be accepted;
- It cannot be bad faith to file a UK application for a mark that may conflict with another mark being used abroad, where the other party has not used the mark in the UK for five years; and
- No reliance should have been placed on A1’s alleged failure to investigate the validity of EFESC’s EUTM, since an investigation would have shown it not to have been used (as the HO indeed found).

The appeal was dismissed on all grounds. The five-year non-use period was rejected as a guideline for the expiration of “a bad faith event”. It was found that the HO had duly assessed the Applicant’s state of mind in May 2017.

The absence of cross-examination was found to be no bar to a finding of bad faith, especially considering that evidence is filed sequentially at the UK IPO, thus allowing a witness to respond to any challenges to his evidence as they arise.

In conclusion, the distinction between conflict of rights disputes and bad faith disputes can be difficult to draw. Ultimately, the Appointed Person found this case to concern the latter, with a decision that leaves open the question as to when the possibility of a counterparty claiming bad faith “expires”.



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## KEY POINTS

- ✦ The expiry of the five-year non-use period is not determinative of a bad faith allegation
- ✦ Bad faith can still be found in the absence of a cross-examination
- ✦ Filing a trade mark application to preserve your position in a conflict of rights scenario can still be bad faith

## MARK

EFESC’S EARLIER MARK

**ECC**<sup>SM</sup>  
European Chainsaw Certificate

# Prosecco gains partial win

Oliver Tidman maps the arguments surrounding a prominent PDO

**On 10th January** 2018, Les Grands Chais de France (the Holder) requested protection in the UK for the international registration (IR) for the figurative mark NOSECCO (the Mark, shown right), covering non-alcoholic wines and non-alcoholic sparkling wines in class 32. Consorzio di Tutela della Denominazione di Origine Controllata Prosecco (the Opponent) opposed the IR under s3(3)(b), s3(4), s3(6) and s5(4)(a) of the Trade Marks Act 1994 (the Act). The Opponent co-ordinates and manages the denomination of Controlled Origin (PDO) Prosecco.

The Opponent claimed that it and its members had goodwill attached to PROSECCO, which had been used throughout the UK since December 2009 in relation to “wines” and “sparkling wines”, in addition to promotional activities. Following *Chocosuisse*<sup>1</sup>, however, the passing off claim was partially struck out in relation to “wines” and “sparkling wines” because, as required by a trade association, the Opponent had failed to join at least one of its trade members to the opposition.

## UNLAWFUL

The Opponent claimed under s3(4) of the Act that the Mark should be refused, as it was contrary to Articles 102 and 103(2) of Regulation 1308/2013, where the latter article refers to “any misuse, imitation or evocation [of the PDO]”. Because a vast amount of sales had occurred by the relevant date and there was similarity between the PDO and the IR in relation to highly similar goods, the Hearing Officer (HO) found that the PDO would be evoked within the meaning of Article 103(2) and that the Holder would gain an advantage.

## DECEPTION

Relying on s3(3)(b) of the Act, the Opponent also claimed that the Mark would deceive the public as to the quality, characteristics and origin of the Holder’s goods. It would also make the public believe that the goods offered under the Mark were in some way compliant with or licensed by the PDO. Given the

similarities between PROSECCO and the Mark, which as a whole had the appearance of a wine label and included Italian words reinforcing the Italian message, the HO concluded that there was a serious risk for deception of the public.

Notwithstanding the successful opposition, the Opponent’s bad faith and passing off arguments failed. The HO stated that even if the evocation of Prosecco was the Holder’s intention for opportunistic reasons, sailing close to the wind would not, of itself, constitute a finding of bad faith under s3(6) of the Act.

In terms of the remaining passing off claim under s5(4)(a), the HO decided that there was insufficient evidence for establishing goodwill in the UK and a lack of any explanation as to how the IR would result in misrepresentation and damage.

<sup>1</sup> *Chocosuisse Union des Fabriants Suisse de Chocolat v Cadbury Ltd* [1999] RPC 826 CA

## KEY POINTS

- ✦ A figurative mark containing elements of a PDO can be found to be contrary to law
- ✦ Join at least one trade member to opposition proceedings if claiming passing off as a trade association
- ✦ There should be a real, as opposed to purely theoretical, risk of public deception

## MARK



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# Happy outcome for MySmile

Amy Galloway describes why this opposition had no teeth

The UK IPO has rejected an opposition by Integrated Dental Holdings Ltd (the Opponent) against EZGO Group Inc's (the Applicant) application for figurative mark MySmile (see right) in class 3 (the Application).

The Opponent based its opposition on s5(2)(b) of the Trade Marks Act 1994 and relied upon six UK trade mark registrations, which are registered in a number of classes, including class 3 (the Registrations). As the goods in class 3 of the Application and the Registrations were largely identical (eg, dental bleaches, cleaning preparations), the decision turned on the comparison of the signs and the subsequent likelihood of confusion.

## COMPARISON OF SIGNS

Of the Registrations, the UK IPO focused on MY DENTIST (word mark), {my}skin (figurative mark) and MY (word mark), with the other three signs being swiftly dismissed due to the additional elements and stylisation.

On MY DENTIST, while the visual and aural identity of "My" was recognised, the different ensuing words and additional figurative "lips" device in the Application culminated in a finding of a low degree of visual and aural similarity. The overlap in the meaning of "a smile" (an expression of mouth/teeth) and "a dentist" (who treats teeth), led to a medium degree of conceptual similarity.

On {my}skin, despite both marks including "My" and "Smile", the stylistic differences, varying size and position of "Smile" and extra

wording in the earlier mark resulted in only a low degree of visual similarity. Whether the earlier mark would be articulated as "my skin" or "my skin: frame your smile", a low degree of aural similarity was found, and as both marks refer to the human body (skin and mouth), the UK IPO found conceptual similarity to a low degree.

On MY, the similarity between this earlier mark and the Application rested solely on the word "My". Given the addition of "Smile" and the figurative element in the Application mark, the UK IPO found the marks were visually and conceptually similar to a low degree, with there being a medium degree of aural similarity.

## LIKELIHOOD OF CONFUSION

The representative of the Opponent referred to a "family of marks" argument during the hearing. However, as it was not pleaded in the TM7, the UK IPO did not consider this claim in assessing the likelihood of confusion.

As a result of the differences between the signs, with the highest degree of similarity being a medium degree, no likelihood of direct confusion was found. While it was accepted that the start of a mark – in this case the identical 'My' – usually makes a greater impression than the end, less weight is given when the beginning is common and non-distinctive. The UK IPO concluded that even the identity of the goods did not offset the low degree of similarity between the marks.

## KEY POINTS

Where a common and non-distinctive element is the main similarity between signs, confusion is less likely to occur

If you intend to refer to a claim at a hearing, this should be included in the initial pleadings and supported by filed evidence

The beginning of a mark does not always make the greatest impression, especially when preceded by stylisation and elements that are more distinctive

## MARKS

OPPONENT'S UKTMs (SELECTED)

{my}dentist

{my}dentist

{my}skin

{my}

THE APPLICANT'S FIGURATIVE MARK

MySmile



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Includes a contribution by Lewis Sanderson, Trainee Solicitor at Womble Bond Dickinson.

# Lo or no

David Birchall considers the difficulties in opposing a mark where the shared element is non-distinctive

**Lo-Dough Ltd** (the Opponent) successfully registered LO-DOUGH and LO DOUGH as a series of UK trade marks in 2016 in respect of, *inter alia*, foodstuffs falling into class 30, including pizza.

In February 2018, Scratch Meals Ltd applied to register the stylised trade mark shown below right in respect of various foodstuffs in classes 29 and 30, including pizza.

The Opponent opposed the entire application on the basis of its earlier marks under s5(2)(b) of the Trade Marks Act 1994 and also under s5(4)(a) on the basis of unregistered rights in the same marks.

The Opponent argued that the goods applied for were identical or similar to those for which its earlier marks were protected. It also argued that, since PIZZA CO was purely descriptive of the goods applied for, the dominant and distinctive elements of the opposed mark were the words NO DOUGH, thus creating a likelihood of confusion.

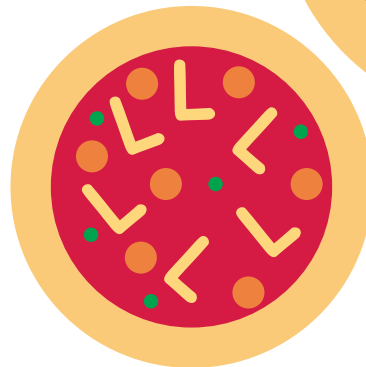
## SIMILARITY

All the class 29 goods applied for, other than “game, fish, seafood; eggs; preparations for making soups; dairy products”, were found to be at least similar to the goods for which the earlier marks were protected. Where the class 30 goods applied for were not found to be identical to the goods protected under the earlier marks, they were found to be at least similar.

The Hearing Officer (HO) found that for pizza goods, the word PIZZA and the “pizza slice” device in the centre of the opposed mark were non-distinctive but that for non-pizza goods they were distinctive.

Overall, visually, the marks were found to have an above low, but not medium, similarity. Aurally, the marks were found to have low similarity. Conceptually, the marks were found to be similar.

For the goods for which dough is not an ingredient, the earlier marks were held to be neither allusive/suggestive of the goods themselves nor descriptive and to have an above low, but not as high as medium, degree of inherent distinctive character. For goods



which may contain dough, it was held that the distinctive character of the earlier marks was very low. The HO referred to case law which held that where the only similarity between the marks is a common element with low distinctiveness, that points against a likelihood of confusion.

The HO dismissed evidence filed by the Opponent to show an instance of actual confusion in relation to pizza products following the position taken in previous cases: that traders choosing marks which have low or no distinctiveness for the goods in question must tolerate use by third parties which they believe to be confusing.

Although noting that LO and NO sound and look alike and that both precede DOUGH, the HO held that there was no likelihood of confusion, either directly or indirectly, even in respect of goods found to be identical.

While the Opponent claimed to have sold foodstuffs under its marks since December 2015, it was held that there was little evidence of sales before the application date of the opposed mark and no evidence of amounts spent on advertising/marketing. The opposition failed under s5(4) too.

## KEY POINTS

+

If the only similarity between marks is a common element with low distinctiveness, that points to there not being a likelihood of confusion

+

The courts have frequently stated that traders choosing marks that have no or low distinctiveness for the goods in question must tolerate use by third parties

## MARK



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# Silk case does not go smoothly

Jack Kenny summarises an opposition in which he represented the applicant

**The UK IPO** has dismissed an opposition filed against an application for HOUSE OF SILK after finding no likelihood of confusion with the Opponent's SILK CUT marks.

JT International SA (the Opponent) filed an opposition against the application in the name of P.T. Sumatra Tobacco Trading Company (the Applicant), which had been filed in respect of cigarettes, tobacco and related goods. The Opponent invoked s5(2)(b) and s5(3) of the Trade Marks Act 1994 (the Act), relying on its UK registrations for SILK and SILK CUT covering identical and similar goods.

The Applicant requested proof of use of the Opponent's marks. The Opponent's evidence consisted of sales and turnover figures, and examples of how the mark SILK CUT had been used on cigarette products. While the Hearing Officer (HO) was satisfied that there had been use of the SILK CUT mark, there was no such evidence for the SILK mark.

The HO then turned to the question of whether use of the mark SILK CUT could constitute use of SILK. The HO noted that use of a sign differing from a registered trade mark can constitute genuine use if the differing elements do not alter the mark's distinctive character. Nevertheless, the word SILK would be perceived as a reference to the qualities of silk (ie, smooth), and so the word did not retain an independently distinctive role in SILK CUT. Consequently, the HO agreed with the Applicant's submission that the Opponent could not rely upon its SILK mark.

Turning to a comparison of the marks, the HO noted that due to

tobacco regulations in the UK, the customer must make a verbal request when purchasing the goods. Therefore, an aural comparison of the marks was particularly important. Visual considerations would also be important, as the customer would likely have sight of the product at the point of purchase.

As the average consumer would not proceed to break down the marks into their various elements, the HO determined that the overall impression of the marks lay in the combination of the word elements as a unit (HOUSE OF SILK and SILK CUT), with no individual words dominating in either mark. Therefore, despite the overlap of the word SILK, the marks were deemed similar only to a low degree when compared visually, aurally and conceptually.

The evidence submitted by the Opponent allowed the HO to conclude that the distinctive character of the mark SILK CUT had been enhanced to a high to medium degree through use. Nevertheless, the HO did not find a likelihood of confusion, particularly due to the low degree of similarity between the marks.

Considering indirect confusion, the HO also held that the average consumer would not conclude that the marks originated from the same or economically linked undertakings, nor would either mark be perceived as a brand extension of the other.

Turning to s5(3) of the Act, the HO concluded that the mark SILK CUT had a moderate reputation. However, the average consumer would not make a link between the two marks so no unfair advantage could be conferred by the Applicant. As a result, the opposition was rejected in its entirety.

## KEY POINTS

- ✦ Use of a sign differing from a mark as registered must only differ in elements that do not alter the mark's distinctive character
- ✦ Even where the earlier mark has a reputation, a link must still be made between the marks for any unfair advantage to be taken

*The author represented P.T. Sumatra Tobacco Trading Company in these proceedings.*



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# Beats comes out best

The UK IPO's softer stance on distinctiveness may have helped here, suggests Michael Green

**Beats Electronics LLC** (Beats) filed an opposition on 19th October 2016 against UK Application No. 3171040 for the word mark BAR BEATS, filed by Virtual Jukebox Ltd (Virtual) on 23rd June 2016. The application covered goods/services in various classes, including 9, 41 and 42, which were all the subject of opposition.

Beats based its opposition on a family of marks, including EU registrations and IR equivalents for a number of marks, including BEATS, BEATS MUSIC and BEATS 1, covering various terms included in classes 9, 38, and 41. It claimed likelihood of confusion under s5(2)(b) of the Trade Marks Act 1994 and relied upon s5(3) to claim a reputation, particularly in relation to headphones and loudspeakers.

Virtual put Beats to proof of use of its vulnerable EU registrations and claim of reputation. It also argued that the term BEATS is descriptive/non-distinctive, along with the dissimilarity of the respective marks and goods/services.

The Hearing Officer (HO) first concluded that the evidence presented by Beats was sufficient to maintain the EU marks as a basis of opposition. Interestingly, when considering the distinctiveness of Beats' marks, the HO stipulated that "although beat is a unit of music, the word BEATS cannot be used to describe a musical recording". He therefore found BEATS MUSIC to be distinctive to a low to medium degree.

When comparing the marks and goods/services at issue, he found a medium degree of visual and aural similarity between the marks, but the conceptual assessment varied based on whether the average consumer would appreciate the musical connotation of BAR BEATS. Moreover, a number of the Beats' goods/services covered were found to be identical or highly similar to Virtual's.

As such, the HO found a likelihood of both direct and indirect confusion between BAR BEATS and CLUB BEATS, but only a likelihood of indirect confusion with BEATS solus. The HO concluded that Beats had established a

reputation in BEATS for "headphones, earphones and audio speakers", a conclusion reached despite most of the evidence relating to the BEATS BY DR DRE mark.

However, the dissimilarity between the remaining goods/services was sufficient to preclude any finding of a link between the marks and so the reputation established did not materially alter the HO's earlier decision. Beats was therefore partially successful in relation to those goods/services found to be identical or highly similar.

The fact that Beats established a reputation in BEATS solus, despite a large chunk of its evidence relating to the BEATS BY DR DRE mark, highlights how reputation can be achieved even when a mark is used in close conjunction with another brand or artist, and where the quantity of evidence is not always the deciding factor.

Further, the apparent finding of direct confusion between CLUB BEATS and BAR BEATS is noteworthy, as this has been rationalised on the basis of conceptual similarity between CLUB and BAR, along with the common BEATS element, which is arguably inherently weak. To find a low to medium level of distinctiveness, despite those goods being equipment that includes "beats", reaffirms the slightly softer criteria used by the UK IPO when establishing distinctiveness. The EUIPO's stance in analogous oppositions involving Beats (nos. B002164906 and B002472937) found the mark to be only "allusive" in respect of these goods.

This raises a further question: would the EUIPO's interpretation of distinctiveness have led to the case being decided in the same way?

## KEY POINTS

- ✦ Beats managed to establish a reputation for its mark despite a large amount of evidence relating to the BEATS BY DR DRE mark
- ✦ Direct confusion appears to have been found between CLUB BEATS and BAR BEATS solely on the basis of conceptual similarity between CLUB and BAR, along with the common BEATS element



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# Food for thought

Parties might have considered a coexistence agreement, suggests Serena Totino

**SCA Investments Ltd** (SCA) filed three UK trade mark applications for the marks GOUSTO and GOUSTO logos for goods in classes 29 and 30, among others (the Applications). The brand GOUSTO resulted from combining the words “gusto” and “gourmet”, and it is currently used by a popular UK start-up that delivers recipe boxes.

Giuliani SpA, an Italian company selling products for diabetics, filed three oppositions against the Applications, based on the similarity with the prior EU marks GIUSTO and GIUSTO logos (the Prior Marks) for goods in classes 29 and 30 (mainly fruits, vegetables, desserts, and coffee).

SCA subsequently filed an invalidity action against one of the Prior Marks in an attempt to suspend the opposition proceedings. However, the UK IPO held that such a suspension should not be allowed: in the event of a successful invalidity action before the EUIPO, the Opponent would have the chance to convert the EU mark and obtain national protection in the UK, given that the mark would be descriptive in Italian, not in English.

Because the Opponent operates mainly in Italy, the Applicant required the Opponent to provide proof of use of the oldest Prior Mark. The UK IPO was satisfied that the Prior Mark was used in the EU in light of a number of Irish catalogues and invoices related to products sold in Bulgaria, Italy, Malta and Ireland, amounting to some £50m worth of goods sold in the EU.

The UK IPO stated that the trade marks at issue are similar to a medium degree and that the goods in class 29 and 30 are similar to the extent that they cater for the same dietary needs. In fact, although all these goods are related to foodstuffs, some of them are not complementary or in competition with each other and will not be found in close proximity on the supermarket shelves.

The UK IPO decision better defined the scope of protection of the Applications, taking

into account the goods for which the Prior Marks were protected, leaving the Applicant with full protection for goods and services in classes 16 and 39, which still suit the Applicant’s core business (instructional teaching material relating to food and the transport of goods).

This decision makes us wonder if a coexistence agreement focused on the core businesses of the parties would have been a more efficient approach to such a case. Certainly, this is one of those cases that will be missed

after Brexit, given that EU marks will no longer be the basis of a UK opposition against a UK application.

Lastly, we note that the word mark GOUSTO has been refused before the EUIPO and found to be descriptive of the term “taste” in Greek. Overall, it’s not a rewarding brand choice for a start-up that

is now facing a number of IP-related issues as part of its international business strategy. Although a catchy brand name may attract consumers in the short term, a “functional” brand is likely to avoid a few headaches for business owners, especially for young companies with limited resources.



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## KEY POINTS

- ✦ An EU trade mark that has not been put to use in the UK is sufficient to oppose a UK trade mark application, for the time being
- ✦ Reputation of a UK unregistered trade mark does not play a role in opposition proceedings
- ✦ An invalidity action at the EU level does not justify the suspension of a UK opposition proceeding if the invalidity grounds do not apply in the UK

## MARKS



## THE PRIOR MARKS



# Direction makes the difference

Puma lacked a prerequisite for a confusion finding, writes Rebecca McBride

On 19th July 2018, Shanghai Warrior Shoes Co. Ltd (the Applicant) applied to register the mark shown below, covering a variety of goods in class 25. On 31st October 2019, PUMA SE (Puma) opposed all the goods, based upon s5(2)(b), s5(3) and s5(4)(a) of the Trade Marks Act 1994, relying upon its earlier EU trade mark (also shown below) registered in classes 18, 25 and 28.

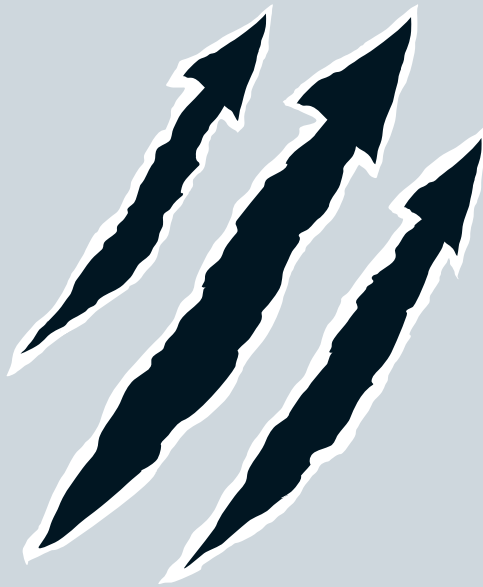
Under s5(2)(b), although the goods were identical (the Applicant's goods fell within Puma's broader terms), the marks were deemed not similar. Visually, there would be a medium degree of attention and the purchase was likely to be primarily visual. Ultimately, the marks would be perceived as depicting two abstract devices.

Even though both have a curved main stripe following a diagonal direction, the Applicant's stripe travels concavely upwards, and Puma's concavely downwards. The additional vertical stripes in the Applicant's mark created a noticeable difference, and overall there was no visual similarity between the marks. Further, even considering the marks in the context of their use (ie, on the outer side of sports shoes), the devices alone looked "starkly different".

By definition, it was unnecessary to consider aural similarity of a figurative mark without word elements. Conceptually, neither mark had any concept discernible from its inherent qualities. Accordingly, there was no need for the likelihood of confusion assessment, and the claim under s5(2)(b) was unsuccessful.

Under s5(4)(a), Puma claimed goodwill in the UK as a result of use of its form-strip mark since 1958 in relation to "apparel, footwear and headgear". Again, although there was substantial goodwill at the relevant date, the lack of overall similarity between the marks resulted in a finding of no misrepresentation.

Similarly, under s5(3), while Puma's mark had acquired a significant reputation from its association with famous athletes and celebrities, and offered high sales and marketing figures, there was no similarity



when the marks were compared overall. Accordingly, the Hearing Officer followed the approach in *Pear Technologies v EUIPO* (T-251/17): that a visual comparison should not take into account the earlier mark's reputation. As the marks were not similar, the public would not perceive any link and, therefore, this final ground also failed.

The decision is a reminder that overall similarity between marks is a prerequisite for the existence of a likelihood of confusion. Only where there is some overall similarity, even where it is faint, is it necessary to carry out the global assessment and determine whether there is a likelihood of confusion. Where there is no similarity, as was the case here, there should be no further assessment.

## KEY POINTS

- + The Hearing Officer followed the General Court's approach in *Pear Technologies v EUIPO* (T-251/17) and reinforced the rule that the reputation of an earlier mark should not be considered when carrying out a visual comparison of similarity
- + Consideration of the likelihood of confusion is triggered only after a finding of similarity between the marks
- + While the threshold of similarity is not unduly burdensome, its significance should not be underestimated

## MARKS

THE APPLICANT'S MARK



THE PUMA MARK



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# One shining success

A comeback is unlikely for Unicorn Co., reports Emilia Petrossian

**On 2nd October 2017**, Popaball Ltd (Popaball) applied to register UNICORN SHIMMER in classes 2 and 30. Unicorn Shimmer Co. Ltd and Danielle Broomfield (Unicorn Co.) filed a joint Notice of Opposition against this application based on passing off and bad faith (the first opposition).

On 27th February 2018, Unicorn Co. applied to register 'Unicorn Shimmer' in classes 30 and 32, which was opposed by Popaball (the second opposition) on the grounds of likelihood of confusion with its application for UNICORN SHIMMER.

## FIRST OPPOSITION

To succeed in its passing off claim, Unicorn Co. had to show that it had acquired goodwill prior to the filing date of Popaball's application. Danielle Broomfield claimed to have use of UNICORN SHIMMER since 19th September 2017, namely via Facebook and Instagram, on unicornshimmerco.co.uk and via Unicorn Shimmer Co. Ltd, incorporated on 27th October 2017. Therefore, Unicorn Co. needed to show significant goodwill over a very short period of time.

Goodwill despite a relatively short period of trading can be established by providing evidence of "substantial takings". However, although Unicorn Co. provided evidence of use such as its Facebook page having reached one million hits, there was no evidence of associated sales. Therefore, the UK IPO found that Unicorn Co. did not acquire protectable goodwill prior to the application date. Accordingly, this ground failed.

Unicorn Co. also claimed bad faith, as Popaball had filed its application despite being aware of Unicorn Co.'s advertisements. However, the Registrar did not consider Popaball to be acting in bad faith, as it had taken action to avoid conflict by conducting searches prior to filing (Unicorn Co.'s application had not been filed at that stage) and was merely seeking to protect its own interests and further its business in a market

in which it was already operating (under the mark SHIMMER).

The Registrar found that Popaball's "behaviour could be considered distasteful or sharp business practice, but that in itself is not sufficient for a finding that the Opponent has acted in bad faith". The ground of bad faith therefore failed, and, given that both grounds failed, the opposition failed.

## SECOND OPPOSITION

The Registrar confirmed that marks are identical if the only difference is the use of upper or lower case, as this is insignificant and will go unnoticed by the average consumer. Accordingly, given the identical/similar goods, there was a likelihood of confusion. Popaball's opposition against Unicorn Co. therefore succeeded and Popaball was awarded costs.

The first decision confirms the need for substantial use to demonstrate goodwill if the period claimed for passing off is short. Further, prior knowledge of use of a mark does not necessarily result in bad faith if the Applicant is merely seeking to protect its own existing business.

The second decision highlights the fact that marks may be identical when using different cases, where no stylisation or additional elements are applied.

Unicorn Co. had until 28th December 2019 to appeal both oppositions but did not do so. Given that Popaball appears to have prior use of UNICORN SHIMMER, it is unlikely that Unicorn Co. would have succeeded.

## KEY POINTS

- ✦ Passing off over a short period of time cannot be found without prior established goodwill and reputation or substantial takings
- ✦ Detailed evidence of reputation is key
- ✦ Prior knowledge of a mark before filing, and filing due to that knowledge, is not sufficient for bad faith



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# Sequel not expected

Gavin Stenton feels the end credits may have rolled for a cinema chain's EUTM application



In May 2018, leading UK cinema chain Odeon Cinemas Holdings Ltd (Odeon UK) filed an EU trade mark application for the figurative mark shown below, covering a range of goods and services in classes 9, 16, 41 and 43. A comparatively small Romanian film distributor, Odeon Cineplex SRL (Odeon Romania), relying on a senior Romanian trade mark registration for ODEON in classes 9, 35 and 41, subsequently opposed Odeon UK's application, alleging: (i) a likelihood of confusion; and/or (ii) unfair advantage/detriment to the reputation of its senior registration, under Articles 8(1)(b) and 8(5) EUTMR respectively.

On 29th November 2019, the Opposition Division (OD) partially upheld Odeon Romania's opposition in respect of Odeon UK's core cinematic goods and services in classes 9 and 41. Absent any evidence of reputation being filed by Odeon Romania, the OD rejected the claim under Article 8(5) and proceeded to assess the opposition exclusively under Article 8(1)(b).

In doing so, the OD concluded that there was no overlap or similarity in terms of the class 16 (paper and printed) goods and class 43 (food and drink) services covered by Odeon UK's application, but that the vast majority of the class 9 goods and class 41 services (in particular those of a cinematic nature) covered by Odeon UK's application were either identical or similar to those covered by Odeon Romania's senior registration.

Comparing the respective marks through the eyes of the relevant Romanian consumer, the OD concluded that the marks were visually, aurally and conceptually "highly similar", the 'LUXE' element being likely to be perceived as a misspelling of the Romanian word for "luxury" ("lux"), and therefore descriptive of the quality of the goods and services. It was thus non-distinctive and of no distinguishing effect, particularly given its smaller size and subordinate position within Odeon UK's mark.

Having found that certain goods and services were identical or similar, and that the marks were highly similar, the OD held that it was "highly conceivable that the relevant consumer will

perceive [Odeon UK's mark] as a sub-brand [or] variation of [Odeon Romania's] earlier mark, configured in a different way according to the type or range of goods or services that it designates". Accordingly, the opposition was upheld in respect of all the identical and similar class 9 goods and class 41 services.

Given the limited prospects of successfully appealing the decision and Odeon UK's apparent lack of senior rights in Romania, a sequel seems unlikely under the circumstances. Instead, Odeon UK may be considering coexistence terms, or alternatively (to the extent that Romania is not a target market) converting its EUTM application into a series of national applications.

“  
*Given the limited prospects for appeal, a sequel seems unlikely*”

## KEY POINTS

- + This decision highlights the risks that even established domestic brands face when seeking geographic expansion
- + The decision also underlines the unitary nature of EUTMs and the fact that a senior right in a single Member State is sufficient to prevent registration as an EUTM

## MARK

THE ODEON UK MARK



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Laurence Nelson, a Trainee Solicitor at Penningtons Manches Cooper LLP, was co-author.

# Hello, fresh problems

The fact that signs differed only in secondary elements was key, says David Yeomans

**HelloFresh SE (HF)** applied to register the mark below as an EU trade mark for a variety of goods and services. Linea Nivnice, A.S. (Linea) opposed the application on relative grounds (likelihood of confusion) based on a number of earlier registrations, the most significant of which – for the purposes of the opposition – was the Czech trade mark registration also depicted below.

The Czech mark comprises a stylised version of the word HELLO and a strapline in Czech below, which translates as “healthy snack always ready for a trip”. It is not entirely clear why the Opposition Division (OD) decided to determine the outcome based solely on the Czech right, but, the judgment points out that the Czech right is not subject to proof of use.

Some of the opposed goods were deemed identical and some similar to those upon which the opposition was based, and the opposed services were deemed similar to a low degree. The marks were deemed similar visually, and highly similar aurally and conceptually. A likelihood of confusion was found for all of the opposed goods and services, and the opposition was therefore entirely successful.

The OD’s determination that the differences between the signs were confined to weak or secondary elements and aspects was vital. The shared element HELLO was deemed to be distinctive in relation to the goods and services at issue. It was also held to be the dominant distinctive element of both trade marks. Once this had been decided, a finding of likelihood of confusion was inevitable, at least in relation to the goods and services deemed identical and/or similar to a high or average degree.

A case could be made that no likelihood of confusion exists in relation to the goods and services found to be similar to only a low degree. However, the OD deemed this a case in which the low degree of similarity of some of the goods/services was offset by the higher degree of similarity between the signs.

This case serves as a reminder of the interdependence principle. It also illustrates how, when differences between marks are confined to weak or secondary elements and the goods and services are similar to at least a low

degree, a finding of likelihood of confusion will usually follow. In addition, although the Opponent may have benefited in not having to provide evidence of use in this case, the door is left open for HF to convert its EU application into national applications outside of the Czech Republic.

“  
When differences between marks are confined to weak or secondary elements, a finding of likelihood of confusion will usually follow

## KEY POINTS

- ✦ The low degree of similarity of some of the goods/services was offset by the finding of a higher degree of similarity between the signs
- ✦ The fact that the differences between the signs were confined to weak or secondary elements and aspects was likely key

## MARKS

THE HELLOFRESH STYLISED MARK

Hello  
FRESH

THE LINEA MARK

HELLO  
ZDRAVÁ SNACKA  
NA CESTY VÍDEJ GUAROVANÁ



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# Victory is sweet for Mars



Donna Trysburg isn't surprised by this opposition outcome

## KEY POINTS

- ✦ Remember to review existing goods and services coverage when launching a new product line, brand extension or co-branding projects under existing brands
- ✦ The evidence was unlikely to have proved sufficient to establish a reputation in the EU had the case been decided post-Brexit, due to heavy reliance on UK-based materials
- ✦ The EUIPO continues to take a hard line on marks it considers descriptive/non-distinctive and minimally stylised and can sometimes fail to appreciate nuanced or layered mark meanings

## MARK

THE CONTESTED MARK

*milkywhey*

In this unsurprising decision, the Opposition Division (OD) found that use of the stylised mark MILKYWHEY depicted below (the contested mark), applied for in relation to “dietary and nutritional supplements” in class 5, would take unfair advantage of the distinctive character and repute of Mars’ earlier EU trade mark (EUTM) for MILKY WAY, registered and reputed for “chocolate bars” in class 30. Mars also invoked Article 8(1)(b) EUTMR, but Mars having succeeded under Article 8(5), the OD considered it unnecessary to examine whether there was also a likelihood of confusion.

Mars filed substantial evidence relating to at least eight EU Member States in support of its reputation. This included turnover figures for 2014 to 2018, including €148m of EU sales in 2018, press articles, references to independent market research and industry studies, and a witness statement confirming a first-use date in the UK in 1935 and detailing a MILKY WAY branded protein bar launched in 2017 which had achieved €900,000 in EU sales to date.

The best and most rounded evidence related to the UK. The OD, noting that reputation in a single Member State will suffice, held that the earlier mark had a reputation in the EU in relation to chocolate bars at the filing date of the contested mark.

Mars did not establish reputation for the wide-ranging class 29 and 30 goods claimed. The OD also observed that the evidence showed use of MILKY WAY for protein bars without establishing reputation for those goods, but this did not assist because they were not covered by Mars’ earlier mark.

The OD focused the comparison of signs on the English-speaking UK public. The signs were deemed visually highly similar and aurally identical but not conceptually similar, since MILKY WAY would be understood as the galaxy to which the solar system belongs,

whereas MILKY in the contested mark would be understood as resembling milk in colour, and WHEY would be understood as a by-product of sour milk commonly used in dietetic substances such as protein powders.

The necessary link was established due to the signs’ similarity, the reputation in MILKY WAY, and because confectionary and protein bars can be in competition.

The OD agreed with Mars that the contested mark would exploit and take unfair advantage of the distinctive character and repute of MILKY WAY, citing the natural link which would be made by consumers, the long-standing and strong reputation in MILKY WAY, and the behaviour of the Applicant in applying to register a number of EUTMs evoking well-known brands, indicating a clear intention to influence consumer economic behaviour by creating an association between its dietary supplements and the names and flavours of well-known products.

As there was no due cause, the opposition was upheld for all contested goods. The decision was still open to appeal at time of writing. Had Mars registered MILKY WAY in relation to protein bars, it could potentially have avoided the costs of providing evidence of reputation throughout the EU. It is also interesting to see the marks considered conceptually dissimilar when one would expect most UK consumers to recognise the play on words that gives the marks at least one shared meaning.



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# Kiss your mark **GOODBYE**

A distinctive element sealed this decision, reports Charlotte Duly

**Cuneyt Ortan filed** an EU application (the Application) covering classes 38 and 41 for the KISS FM logo shown below. The Application received three oppositions, one of which has been decided, rejecting the Application in its entirety.

Radio Blanca, S.A. operates Kiss FM radio, which has been broadcast in Spain since April 2002. It opposed the Application on the basis of five national Spanish trade mark registrations under Article 8(1)(b) EUTMR, claiming a likelihood of confusion. As the opposition was based on more than one earlier trade mark, the matter was first examined in relation to Spanish registration No. 2879817 for the KISS TV mark, also shown below.

The services in classes 38 and 41 were found to be identical or similar. The radio broadcasting services of the Application were found to be similar to the Opponent's television broadcasting services, as the nature and purpose can be the same and were found to be in competition to some extent. The relevant consumers overlap significantly, and it is not uncommon for the same company to operate in the fields of television and radio under the same name.

Education services provided by radio were found to have a low degree of similarity with electronic publications of books and newspapers online due to the proximity of the commercial fields and as both are distributed through the same channels to the same relevant public. The relevant territory for comparing the marks is Spain, with consumers displaying an average degree of attention.

KISS FM and KISS TV coincide with the KISS element, which has no meaning for a significant part of the Spanish-speaking public and is distinctive for the services covered. TV would be understood by the Spanish public as an abbreviation for

the word "television" and descriptive of the services covered. The logo element of the earlier KISS TV mark was perceived as a TV screen and of low distinctiveness.

FM stands for "frequency modulation" both in Spain and throughout the EU. Like TV, due to its descriptive nature, it was also found to be weak. The red lipstick logo of the Application had no meaning in relation to the services and was found to be distinctive.

Overall, the marks were found to be visually, aurally and conceptually highly similar.

Neither mark had an element that was regarded as more dominant than the others but, as per previous case law, the verbal components were likely to have a stronger impact on the consumer than the figurative components;

consumers were more likely to refer to the marks by the word elements. Both marks shared the initial identical verbal element KISS, and the colours black and red.

Based on a global assessment, there was found to be a likelihood of confusion on the part of the Spanish public. That decision isn't a big surprise, but it does remind us that the relevant public can vary depending on the earlier rights relied on. That can then impact the assessment of the similarity of the marks at issue. At the time of writing, the decision had not been appealed.

“  
*The red lipstick logo had no meaning in relation to the services*”

## KEY POINTS

- A common English word may not have a meaning in other EU Member States, so bear this in mind when assessing similarity
- Where services have overlapping distribution channels, this can lead to them being regarded as similar
- Word elements form a key part of comparisons, even when large figurative elements are present

## MARKS

EUTM NO. 17970573



SPANISH  
REGISTRATION  
NO. 2879817



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# Calendar

What's coming up from CITMA and other IP events of interest



DATE	EVENT	LOCATION	CPD HOURS
18th March	CITMA Welcome Drinks Reception* Part of the CITMA Spring Conference	Brasserie Blanc Southbank, London SE1	
19th-20th March	CITMA Spring Conference*	IET London: Savoy Place, London WC2	9
19th March	CITMA Spring Conference Gala Dinner*	House of Commons, Palace of Westminster, London SW1	
25th March	CITMA, ITMA and CITMA Benevolent Fund AGM	London	
25th March	CITMA Edinburgh Quiz	Le Monde Hotel, Edinburgh EH2	
31st March	Joint CITMA/CIPA Designs Webinar John Coldham (CITMA) and David Musker (CIPA)	Online	1
12th May	CITMA Lecture – London	CMS, London EC4	1
22nd May	CITMA Paralegal Seminar Obstacles to trade mark registrations	Keltie LLP, London SE1	3
21st May	CITMA Webinar Money laundering	Online	1
11th June	CITMA Webinar What is a mental health first-aider?	Online	1
10th July	CITMA Paralegal Webinar Trade mark infringement	Online	1
14th July	CITMA/CIPA Webinar Brexit	Online	1
18th August	CITMA Webinar	Online	1
15th September	CITMA Lecture – London Copyright	Allen & Overy, London E1	1
28th September	CITMA Webinar	Online	1
20th October	CITMA Paralegal Webinar Customs enforcement	Online	1
4th November	CITMA Autumn Conference – Birmingham*	The ICC, Birmingham B1	5
24th November	CITMA Lecture – London	Baker McKenzie, London EC4	1

## SUGGESTIONS WELCOME

We have an excellent team of volunteers who organise our programme of events. However, we are always eager to hear from people who want to speak at a CITMA event, particularly overseas members, or to host one. We would also like your suggestions for event topics. Please contact Jane at [jane@citma.org.uk](mailto:jane@citma.org.uk) with your ideas.

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# THE TRADE MARK 20

Q&A

# Claire Jones

can't live without her carbs

**I work as...** a Senior Chartered Trade Mark Attorney at HGF.

**Before this role, I was...** working for another IP firm.

**My current state of mind is...** positive and focused, mixed with a little annoyance at the constant rain.

**I became interested in IP when...** I needed to gain some experience in a legal field while studying for the Legal Practice Course. I started working in the IP department for a Magic Circle law firm and loved the variety. I was hooked from then on!

**I am most inspired by...** ambition. And anyone who brings me gifts.

**In my role, I most enjoy...** deadlines! I also enjoy interacting with clients and being able to evolve and adapt to their requirements and expectations. It's great being able to give good news, but I also like finding solutions when faced with challenges.

**In my role, I most dislike...** a large, unfiled and unread email inbox.

**On my desk is...** a mug of coffee and a bacon sarnie.

**My favourite mug...** is a big Darth Vader. I will rule the galaxy with or without you.

**My favourite place to visit on business is...** Manchester: good food, good bars and an easy commute from London.

**My ideal day would include...** beer, gin, food and people.



“

*Some IT advances could change how we see, protect and enforce IP*

**The biggest challenge for IP is...** Brexit (yawn). But also, I think, technological advancements, including AI. Firms' IT solutions will need to manage the demand and the administrative processes in general, but some of the advances could also change how we see, protect and enforce IP across a number of different sectors. Combine that with the challenges IP firms are facing in having to reduce prices, and the pressure to align IP with business strategy, and there are certainly some interesting times ahead!

**In the next five years I hope to...** establish my five pillars of growth and develop a five-year plan.

**When I want to relax I...** sleep.

**In my pocket is...** pocket dust, oxygen, nitrogen and argon. Ooooh, and lint.

**The talent I wish I had is...** the ability to teleport. I would love to cut down on commuting, and not having to travel would be mean more holiday time!

**I can't live without...** carbs.

**If I were a trade mark or brand, I would be...** IKEA – the wonderful everyday! It's all well-designed, functional and good value.

**The best piece of advice I've been given is...** read. A lot. It imparts so much information and knowledge. Remember the 10,000 hours rule: to achieve greatness, you must spend 10,000 hours on focused, deliberate practice in developing a skill. This just goes to show that you never stop learning and growing as a person.

And, importantly, never go to a supermarket when you're hungry.

**The best things about being a member of CITMA are...** the opportunity to network with colleagues in the profession, and access to good legal updates and case law summaries.

Claire is inspired by IKEA's strong design principles



**i-Search**

Trademark Availability Searches with Legal Opinion



# BRINGING YOUR PROJECT SAFELY HOME

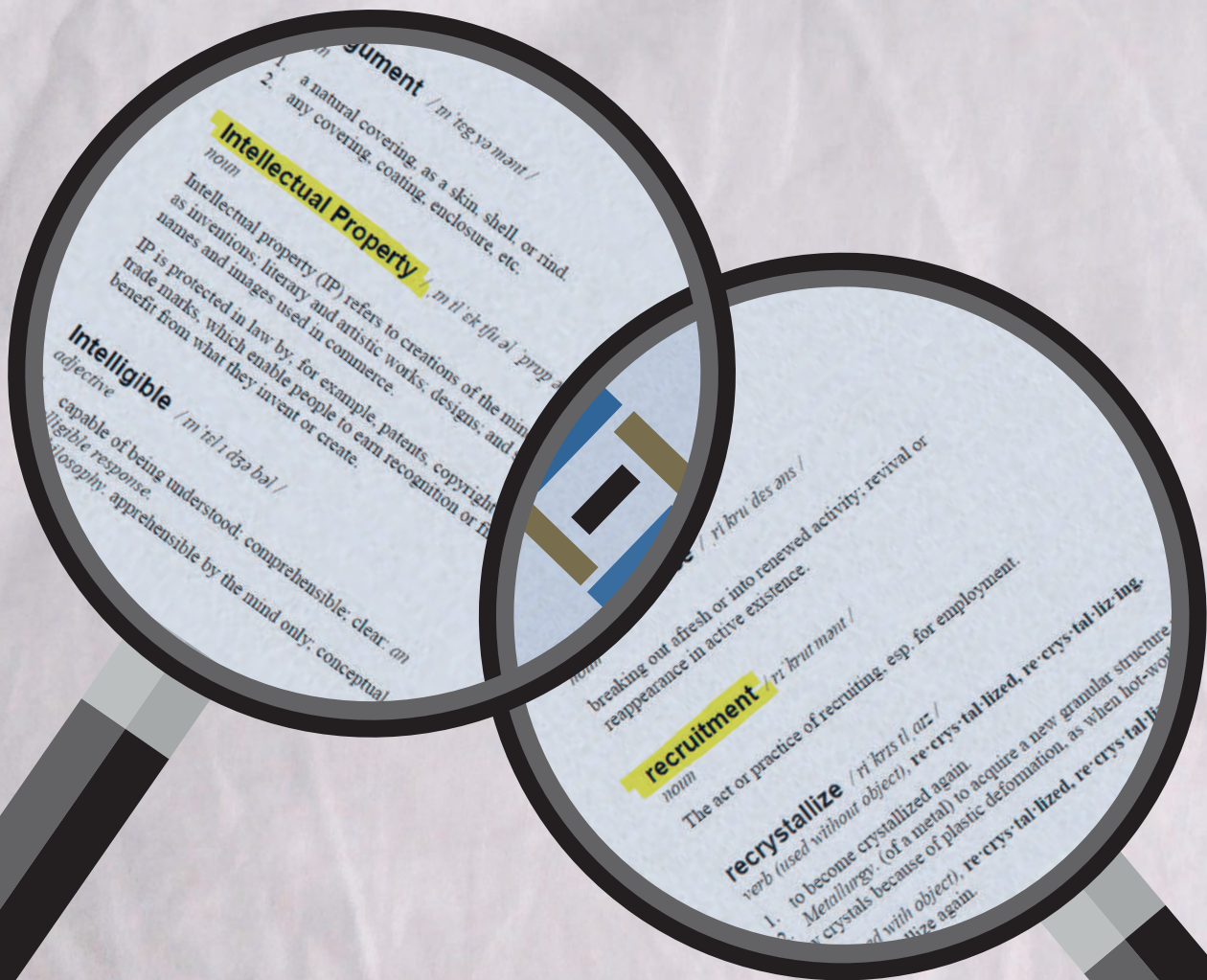
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