


# CITMA REVIEW

ISSUE 446 DECEMBER 2018/JANUARY 2019



## DESIGNS PINNED DOWN

*From US strategy to UK filing data  
and EU decisions, our authors  
map the latest designs territory*

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# WELCOME & CONTENTS



**Tania Clark**  
CITMA President

“  
*This issue of the CITMA Review focuses on designs*”

As this issue goes to press, we have just enjoyed a successful Autumn Conference in Birmingham. Look out for a full report of that event in the next edition of the *CITMA Review*.

Meanwhile, the next major events are our Christmas Lunches, held in Leeds and London in December. I hope to see you at one of these festive gatherings.

This issue of the *CITMA Review* focuses on designs. Bird & Bird has curated a set of design-related decisions from its European offices. Michael Conway considers the latest statistics on design filings from UK representatives, and Grégoire Bisson of WIPO explains the position regarding Hague filings designating the US.

Have a wonderful Christmas with your family and friends.

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## CITMA REVIEW

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**CITMA**

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## AUTUMN 2018 CONFERENCE

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information in your online profile. The new platform gives you the opportunity to list your specialism, which the public and CITMA members can select and use to narrow their search.

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We were pleased to welcome more than 170 delegates to our annual Autumn Conference in November. This year saw speakers tackle earlier rights and resolving conflicts, along with topics including the impact of the EU Trade Mark Directive, a European perspective on unregistered trade mark rights, and concurrent use.

Look out for our full report in the next issue of the *CITMA Review*.



Leanne Hall of Serjeants addresses the Autumn Conference

### Looking for a case comment?

You can now search and view all case comments we have published in the *CITMA Review* since 2016 on the new CITMA website. Search by company name, case number or topic at [bit.ly/446\\_Comments](http://bit.ly/446_Comments)

## REMEMBER

The Trade Marks Regulations 2018 (implementing the Trade Marks Directive (EU) 2015/2436) come into effect on 14th January 2019. Read detailed guidance at [bit.ly/446\\_IPOGuidance](http://bit.ly/446_IPOGuidance)

# MADRID SYSTEM: 8TH YEAR OF GROWTH

Demand for WIPO's Madrid System grew by five per cent in 2017, making it eight consecutive years of growth for the international trade mark filing service. In its *Madrid Yearly Review 2018 - Executive Summary*, WIPO reports this fact, along with some top-line results for the year, including:

- 56,267 international registrations;
- 674,758 active international registrations;
- 100 Madrid members; and
- 116 countries covered.

The Madrid System was most popular with the US, from which nearly 8,000 applications originated. Other top users were Germany (7,316), China (5,230), France (4,261) and the UK (3,292). Notably, China filed some 1,400 more applications in 2017 than in 2016, amounting to a growth of more than 36 per cent, according to the report.

Learn more and download a host of IP statistics at [wipo.int/ipstats](http://wipo.int/ipstats)

## Potter Clarkson completes acquisition of Wildbore & Gibbons

Two of the UK's oldest IP firms have joined forces, following Potter Clarkson's acquisition of City-based trade mark firm Wildbore & Gibbons.

Following the acquisition, the team has moved to a new home in Holborn, London. Recruitment is under way to grow the trade mark practice, as well as building a full-service IP offering.

The acquisition of Wildbore & Gibbons follows a period of unprecedented growth for Potter Clarkson, with new offices opening in Copenhagen and Stockholm during 2018.

In line with this growth, staff numbers are on course to increase significantly across all locations.



## IP INCLUSIVE: A GREAT WEEK OF WORK

A number of CITMA member firms celebrated the first IP Inclusive Week, held 12th-18th November. CITMA kicked off with a presentation from Vice-President Richard Goddard and 8 New Square's James St Ville (pictured) at the Autumn Conference.

Meanwhile, the UK IPO organised a week in which its staff networks each contributed "something to raise awareness, challenge assumptions and celebrate progress for diversity and inclusion within the IPO and the IP profession". This included a day when volunteer staff took on a "wheelchair obstacle course" to raise awareness of the difficulties that everyday tasks can entail and the strength that wheelchair users require to navigate them.

To assist firms in taking forward the principles of inclusiveness and diversity, IP Inclusive has prepared a "Steps to Inclusion" tool that will help *IP Inclusive Charter* signatories review their diversity and inclusion credentials and identify opportunities for improvement.

Find more information about the tool at [bit.ly/446\\_Diversity](http://bit.ly/446_Diversity)

## MEMBER MOVE



### Cara Baldwin

eccora is delighted to announce that Cara Baldwin will be joining the company as an investigator. Cara has a background as a UK, European and Irish Trade Mark Attorney, with over 18 years' experience in private practice working for top-tier London IP firms. Cara can be contacted at [cnb@eccora.com](mailto:cnb@eccora.com)

### Considering a career move?

Visit the CITMA jobs board at [citma.org.uk/job\\_board](http://citma.org.uk/job_board)



## Spring Conference 2019

# A ROOM WITH A VIEW

CITMA diary dates you don't want to miss

### SAVE THE DATE

#### **CITMA Spring Conference, 13th–15th March 2019**

The 2019 CITMA Spring Conference will take place on the beautiful London riverside, taking up residence at the eminent headquarters of the Institution of Engineering and Technology (IET).

A historic venue in the heart of London, IET London: Savoy Place will be the perfect location for our yearly international celebration of IP for CITMA members.

Plans are under way to offer the usual programme of expert speakers on the issues that are of most interest to our membership, as well as fantastic networking events that will provide opportunities to get to know new CITMA colleagues and catch up with old friends.

### DESIGNS IN FOCUS

#### **Intensive Designs Seminar, 13th March 2019, 2.30–5.30pm**

The full conference schedule will be preceded by an intensive designs seminar, hosted by Gowling WLG at More London Riverside, London SE1.

Chaired by John Coldham, Partner at Gowling WLG, this special session will address “Everything designs”.

Attendees will hear views from the UK IPO on Brexit – just two weeks before it kicks in. In addition, leading barristers and judges will address the latest issues facing the courts, and we'll learn from a host of attorneys on approaches to filing and getting the best protection for designs worldwide.

**We'll be releasing further details soon. Find out more about the Spring Conference and all CITMA events at [citma.org.uk](http://citma.org.uk)**

www.ip-support.co.uk  
020 7776 8966  
info@ip-support.co.uk

A large, stylized graphic of the letters 'IP' in a serif font, centered within a white circular shape. The background is a light grey gradient with a white swoosh that frames the circle.

IP

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# PRIORITY: PARALEGALS

Practical tips on post-registration were the focus of an educational autumn afternoon

A host of specialist speakers took part in October's CITMA Paralegal Seminar, the latest in a series of initiatives aimed at supporting CITMA Paralegals. The afternoon session focused on developing knowledge and increasing efficiency in all aspects of IP post-registration, providing practical tips and advice on proof of use, registration, renewals and maintenance.

Among the speakers was Julius Stobbs of Stobbs IP, who reviewed the concept, practice and intricacies of proof of use at the UK IPO and EUIPO, and addressed the issue of "use in the Community".

Kane Ridley of Keltie LLP looked at the UK trade mark renewal and

restoration process – in particular, at ways renewal can be paid, the fees involved, common errors and how to avoid them. Attendees learned about the UK renewal and restoration workflows, and gained valuable insight into how best to manage renewal portfolios.

Daniel Smart of Colman + Smart took attendees on a whistle-stop tour of some of the more unusual maintenance requirements for trade mark registrations around the world, and then teamed up with Kane to look at key sections of the US Lanham Act and discuss how to effectively submit use that will be acceptable to the USPTO.

After the formal sessions, participants were able to network with our speakers, other paralegals, administrators and formalities staff at a post-event drinks reception.

### KEY TO IMAGES

1. Kane Ridley (Keltie LLP) in post-event discussion 2. Event Chair Ian Collier (Stobbs IP) 3. Daniel Smart (Colman + Smart) 4. Julius Stobbs (Stobbs IP) addresses the gathering 5. Cheryl Small (Astellas Pharma Europe) makes a contribution 6. All eyes were on our expert speakers 7. (L-R) Janet Strath, Pramod Patel and Rebecca Powell (Maucher Jenkins) 8. Enjoying a lighter note during one of the day's sessions



KEEP UP-TO-DATE WITH ALL CITMA EVENTS AT [CITMA.ORG.UK](http://CITMA.ORG.UK)





# TRADE DRESS TO IMPRESS

A US guest took the mystery out of a slightly foreign concept, reports Laura Robyn

**In a lunchtime** talk entitled ‘Getting your IP into shape’, Anna King from Banner & Witcoff shed light on the challenges of, and strategies for, protecting trade dress in the US, addressing CITMA members in Bristol.

With a wide breadth of trade dress experience (prosecution and litigation), Anna provided insight on theory and also gave practical advice aimed at creating a greater awareness of the existence of trade dress for UK professionals whose clients may have eligible rights.

Anna began by anchoring trade dress among other types of non-traditional trade marks protectable in the US, such as fluid marks (the Google doodle being a typical example), and explaining its place on the IP rights spectrum. Because trade dress straddles trade mark and design subject matter, comparing and contrasting the scope of protection afforded by design patents, copyright, utility patents and trade dress was very helpful. In spite of the design elements, trade dress predominantly functions as a trade mark, denoting the origin of products, which also means that it can become generic and needs to be policed accordingly.

Anna also outlined the main hurdles facing those contemplating and/or prosecuting a trade dress application, which are:

- identifying trade dress;
- ornamentation;
- distinctiveness issues (inherent v acquired, with a particularly interesting aside

that distinctiveness can be acquired post-filing);

- functionality; and
- consistent use.

Anna explained these principles with reference to a case study involving prosecution of an application for the features of a cool box while conducting litigation

“

*Anna explained that only designs that are functional in practice are registrable*

based on this pending right. She highlighted in particular the factors and types of evidence US examiners look for when evaluating distinctiveness, stressing the importance of so-called “look for” advertising. This type of evidence relies on the applicant’s marketing materials calling attention to what distinguishes the brand from others (“look for the big brown bear”).

On functionality, Anna explained that only designs that are functional in practice are registrable. This is in contrast to those designs that are legally functional, and in reality only produced in a particular configuration because that shape or colour works better in the context of the product. All bottles are functional, but a particular shape may be protectable. However, if a specific configuration of a functional product (eg toilet paper) is also functional (a quilting design is more absorbent), then a functionality objection will arise. Anna explained that the burden of proof for functionality lies with the examiner, who must provide reasoning if a functionality refusal is to be raised and maintained.

Attendees were then invited to ask questions, which included requests to outline the scope of protection afforded by registered trade dress, discuss genericide as the only ground for revocation, and offer tips on staggering workloads generated in the prosecution stages. In her concluding remarks, Anna briefly touched on using letters of protest to the USPTO as a non-prejudicial strategic tool for third parties seeking to challenge the application.



**Laura Robyn**

is a Trade Mark Assistant at Haseltine Lake LLP  
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# DESIGNS DIGEST 2018

Bird & Bird rounds up Europe's most recent notable design-related decisions

## Belgium

### DAMAGES RESTRICTED FOR UNREGISTERED DESIGNS

In *Kozmoz Design & Display v Eurodisplay* (12th March 2018, A/03515/2015), the Brussels Community Design Court held that Eurodisplay infringed Kozmoz's unregistered Community design rights in a display. The Court found that Eurodisplay had used an identical design, and it issued a cease-and-desist order in Kozmoz's favour.

Despite this decision, the Court did not award any damages as a result of the infringement. Pursuant to Article 88(2) of the Community Design Regulation (Council Regulation (EC) No 6/2002) (CDR) and CJEU case law (*Gautzsch Großhandel*), in all matters not covered by the regulation (including damages compensation), Community Design Courts should apply national law. In Belgium, designs are governed by the Benelux IP Convention, which offers no protection for unregistered designs. Consequently, there is no basis for claiming damages as a result of infringing an unregistered Community design in Belgium.

Article 96 CDR does allow for full compatibility with other types of national design protection. Provided they are original, utility products such as displays are eligible for copyright protection and damages awards under Belgian law. Hence, having established the originality of the design at issue, the Brussels Court did grant compensation in the amount of €7,500 (evaluated *ex aequo et bono*) for copyright infringement.

Report: *Alizée Jolie and Domien Op de Beeck*

## France

### SHINY SHOE HAS INDIVIDUAL CHARACTER

In *StudioA Sarl v Minelli SAS* (4th May 2018, RG 2017/06372: D20180029), the Paris Court of Appeal considered that the details of a sandal constituted individual character.

StudioA, a retailer of flat wedge sandals, sued Minelli for infringement following Minelli's attempt to file a design that StudioA considered similar to its own. Minelli argued that the StudioA shoe was not "new" and was devoid of "individual character", because it was an imitation of a sandal by designer Véronique Branquinho.

The Court of Appeal considered that the shiny aspect on StudioA's sandal conferred a chic look, while the matte Branquinho model had a casual aesthetic. It considered that

the shiny aspect contrasted with the natural look of the sole, while the Branquinho sandal was monochrome. Finally, the Court noted that the buckle of the StudioA model was the same colour as the bridle and had a release at the front that was more accentuated than that of the Branquinho sandal.

The Court found that these visual elements conferred a distinctive appearance on StudioA's sandal, and that a well-informed consumer would easily be able to distinguish it from other designs.

Nevertheless, the impact of this decision remains uncertain, as the decisions rendered by the courts on first hearing are, for the most part, not in accordance with it.

Report: *Elsa Lavaud*



Branquinho design



StudioA design

# Germany

## EYEWEAR DECISION NOT BLACK AND WHITE; BALLERINASCHUH TESTS SCOPE OF PROTECTION

In the Sportbrille proceedings (23rd November 2017, ECLI:DE:BPatG:2018:130418B30Wpat803.15), the German Federal Patent Court considered an invalidity application for a nationally registered ski goggle design. The design representation showed glasses with eyewear straps in different colour combinations. The Applicant argued that the design was devoid of unitary character, and that the application was inadmissible under s1(1) of the German Design Act, as it was an attempt to protect different versions of ski goggles with a single design. In particular, the goggle's frame was presented in both white and black, while the eyewear strap was presented in several colour combinations (black/light grey, white/black and black/dark grey).

The Court did not agree, and commented that the unitary character of the design was to be determined by interpretation of the application documents (ie classification and indication of products, representations of the design). The Court instead found that the unitary character and scope of protection followed from the identical characteristics between the different versions, and accordingly was limited

Meanwhile, in proceedings for Ballerinaschuh, the German Federal Court of Justice considered the issue of infringement (11th January 2018, I ZR 187/16, ECLI:DE:BGH:2018:110118UIZR187.16.0). The Spanish footwear manufacturer of a yellow ballerina shoe with a two-tone sole filed an action against the manufacturer of a similar model under its registered Community design. The latter manufacturer argued that the Plaintiff had released a similar model onto the market and on the internet before filing the Community design application. The Court found that the offer of a similar model on the Plaintiff's website, which was accessible in the EU, was part of the design corpus and needed to be taken into account when assessing the Plaintiff's registered Community design, irrespective of its actual distribution.

The registered Community design was therefore found to have a limited scope of protection due to prior publication of a similar model, and was not affected by the allegedly infringing ballerina shoe. However, the Court referred the case back to the Higher Regional Court of Düsseldorf for further evaluation as to whether claims under competition law pursuant to s4(3) of the German Unfair Competition Act should

*“ By using different greyscales, the proprietor validly defined the design's scope of protection ”*

to what was congruently depicted by the design representations. By using different greyscales, the proprietor validly defined the design's scope of protection, ie a pair of ski goggles determined by its shape, with colour combinations specified by grey tones.

Although this approach is advantageous for designs applicants, it may be a disadvantage for third parties that wish to reliably determine the scope of protection for a registered design by means of research. The decision is being appealed, so it remains to be seen whether the German Federal Court of Justice will agree with the initial Court's reasoning.

be considered, and whether unlawfully offering replicas of the Plaintiff's ballerina shoe would unreasonably exploit or impair the Plaintiff company's reputation.

This decision may be important in cases where design registrations have not been obtained, or where the registrations are invalid or have only a limited scope of protection. When it comes to unfair competition law, the previously known design corpus is not of equal relevance and, in contrast to design law, a similar product previously distributed by a company can sometimes increase the individual character of a subsequent product marketed by the same company.  
*Report: Roman Brtka*



IKON IMAGES



## Italy

### “FAST FASHION” BEWARE

The Court of Milan recently confirmed that a Community Design Court may award damages at an EU-wide level for infringement of registered and unregistered designs (2nd July 2018, Docket No. 23303/2016).

In 2016, OTB (parent company of Diesel and Marni) brought an action against the Zara group, claiming that the latter had infringed Diesel’s registered Community design and related unregistered design for the Skinzee-sp women’s jeans; and Marni’s unregistered Community design right for the Fussbett sandal.

The Court found that Zara had infringed the above design rights and ordered an interim injunction in favour of OTB. Earlier this year, the Court of Milan, in its capacity as a Community Design Court, upheld the interim injunction.

The Court held that it would have jurisdiction over Zara,

despite the company being established abroad, under Article 8(1) of the recast Brussels I. The Court noted that Zara’s Spanish companies operated in the same production and commercial chain as OTB’s products traded in Italy.

Zara contended that the Italian Court lacked jurisdiction to decide on the alleged infringement, which occurred outside Italy. The Court applied the principles set out by the CJEU in *Nintendo v Big Ben* – one of the first courts in Europe to do so – and found it had EU-wide jurisdiction to award remedies, including damages. As regards awarding damages, the Court held that, for the infringing activities carried out by the Spanish companies outside Italy, but within the EU, the applicable law would be Spanish law.

*Report: Fulvio Mellucci and Valeria Meli*



Above: Marni’s Fussbett design

Below: Diesel’s Skinzee-sp design



## The Netherlands

### TAKING THE ROUGH WITH THE SMOOTH

In light of the decision by the Hague Court of Appeal in *Arpe v Happy Cocooning* (20th February 2018, ECLI:NL:GHDHA:2018:272), a prospective rights holder should take care when choosing the drawings and pictures of a design it seeks to register.

The Court was required to consider whether Happy Cocooning’s registered design was infringed by Arpe’s gas heater. The Court assessed the overall impression of the gas heaters, and considered that the registered design had a clean, minimalistic appearance with a stony look in monochrome colour, whereas Arpe’s design had a messy, wooden aesthetic with discolorations and a lighter colour scheme.

Contrary to the provisional relief court in first instance, the Court ruled that these differences resulted in a different overall impression. Despite the registered design having a reasonably large scope of protection, the Court ruled that the design of the Arpe gas heater did not infringe the design rights of Happy Cocooning, and that the differences were more eye-catching than the similarities.

*Report: Manon Rieger-Jansen and Sabrina Lodder*

# Poland

## THE SHORT LIFE OF THE SPOTTED COW

The Polish Patent Office (PPO) recently decided that Zielona Budka's industrial design Rp.15331 infringed the rights of the well-known figurative trade mark R.119599, owned by Mlekpól, one of the biggest dairy-product producers in Poland (25th June 2018, Sp.68.2015).

The PPO's decision follows on from a long-standing dispute between the two large Polish ice-cream producers.

In 2015, Mlekpól filed an invalidation request against Zielona Budka's industrial design with the PPO, challenging the registration. It claimed that the so-called cow spots were a characteristic element of the well-known ŁACIATE trade mark, and that the use of spots in Zielona Budka's design infringed its rights. In its original judgment, the PPO found that the ice-lolly shape with irregular stripes did not contain any element of the ŁACIATE marks, in particular the "spots" layout, and dismissed the invalidation request.

Mlekpól appealed the PPO's decision before the Voivodeship Administrative Court in Warsaw (17th November 2016, ref. VI SA/Wa 1135/16). The Court overruled the first instance decision and indicated that the designer mentioned the cow spots specifically in the design description. The Court also noted that the graphic of the design constituted such a pattern, not just irregular stripes in white and brown colours.

The case was then re-examined by the PPO, which upheld the Court's stance and invalidated the industrial design Rp.15331 on the basis of infringement of third-party property rights.

Report: Anna Filonowicz



Zielona Budka's design, Rp.15331



Mlekpól's design, R.119599



# Spain

## DEFINING THE "INFORMED USER"

A decision of the Spanish Supreme Court (5th May 2017, No. 275/2017) has clarified the definition of an "informed user", a term set out in Spanish design law under Article 7 of Law No. 20/2003 on Legal Protection of Industrial Designs.

The object of the litigation included a design based on the traditional Catalanian *trencadís*, a mosaic technique often used by the architect Antoni Gaudí.

The designs at issue were being sold as souvenirs, a situation that led to the analysis of two types of "user": the mere tourist, who buys the item with minimal attention to detail (the consumer degree of attention normally assessed when judging trade mark cases); and the professional retailer of such products, whose professional due care and attention is part of its commercial activity.

The status of an "experienced user" in relation to Spanish

designs has also been further clarified by this decision, as the Court also considered contradictory concepts, such as "author freedom" for designs.

This definition follows the lead of the CJEU decision in *PepsiCo Inc v Grupo Promer Mon Graphic SA*, in which the "informed user" figure stands between the reasonable, circumspect consumer and the professional designer – a person who, due to their personal experience, may appreciate the singularity of the design per se.

Moreover, the decision refers to the necessity of establishing the nature of the object of the design, which will give way to the definition of "informed users", those linked to the professional sector to which the design pertains or those final users who are personally experienced and more attentive to the product characteristics.

Report: María Fernández

WITH THANKS TO COORDINATORS PATRICIA COLLIS, CHARTERED TRADE MARK ATTORNEY, AND MEGAN CURZON, TRAINEE, AT BIRD & BIRD



# STAKE YOUR SECTOR CLAIM

Douglas McPherson offers practical advice on fine-tuning your business focus

**One of the** questions I'm asked most frequently by Trade Mark Attorneys is: "How can I stand out from all of the other Trade Mark Attorneys out there?" My answer (almost) always includes two parts. First, cultivate strong relationships with your clients and contacts – at home and abroad – so you're best positioned for referrals. Second, adopt a sector strategy and develop a "go to" status in the industry sectors that you want to win work from.

A sector strategy provides a clear focus for your business development activity. It allows you to package and promote your particular strengths to a defined audience that you really understand, and which will appreciate your specific experience. Let's face it, the decision-making process behind choosing a professional advisor is primarily based on the mitigation of risk. By communicating that you know what's going on in your chosen sectors and the solutions you can provide to address relevant issues, and by presenting case studies or testimonials, you will "de-risk" the process of choosing you.

Admittedly, some of the people you meet will be in direct competition with existing clients, and conflicts can arise. However, the vast majority of your new contacts won't be direct competitors, leaving you free to act for them. The truth is that the majority of prospective clients will take greater confidence from the fact you have acted for similar businesses and understand the nuances of their markets and the challenges they face when launching and protecting new brands.

Where to start? Some of the answer will be obvious: in which sectors do you have the most clients, and in which do your highest-billing clients operate?

### OPPORTUNITY

You also need to consider opportunity. Is there a big enough sector universe? Are there enough strands within the sectors to keep you safe from conflict and provide a wide enough range of unrelated businesses to pursue? Are the companies involved likely to have large enough portfolios (or the likelihood of growing large enough portfolios) to make winning their business worthwhile?

### INTEREST

Ask yourself: are you genuinely interested in the sector? Your success is going to depend on

your staying up-to-date with what's going on, having an opinion on this and being enthusiastic when you're engaging with your sector at every level.

### IMMERSION

Once you have chosen your sector(s), it's time to immerse yourself. Your first objective is to be recognised as someone involved in your sector who happens to be a Trade Mark Attorney, not as a Trade Mark Attorney trying to get work out of your sector. Gather information on the trends, news and breaking issues. Address what you learn in blogs or share the links and headlines via social media. This essential activity will help you build a profile as someone who's involved in your sector.

### IMPLEMENTATION

Next, get in front of the people within your sector. This will involve both desk research and asking your clients for their insight so you can identify the publications they read, the events they go to and the groups they belong to. The results will highlight the available routes to market, ie how you can move your understanding out of the firm and get it in front of the people you want to be your new clients. This is the hardest part – but worth it!

“

*Address what you learn in blogs or share the links and headlines via social media*



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# ON THE UP

Michael Conway uncovers the UK firms contributing to the rise in design filings

**As reported in** the September 2018 edition of the *CITMA Review* (“CITMA Insider”, page 5), design filings have reached record highs in the UK. The news prompted this author to wonder what contribution UK firms in particular had made to these totals. So, with the help of data collated by Corsearch, we have compiled details of design filing statistics for UK firms in 2017, covering both UK designs and registered Community designs (RCDs), taking the top 50 firms in each case.

### UPWARDS TRAJECTORY

The number of designs filed increased across the tranche of top-filing firms, reflecting the growing recognition by IP-savvy businesses that designs registrations – when properly applied – are an important tool in the IP armoury.

The Trunki case in particular brought home the importance of both registered designs and getting registration right. This led to designs practice and expertise being recognised as a key, stand-alone skill set, rather than as an adjunct to trade marks and patents, as it may have been seen in the past.

In the UK, the explosive growth in total filing numbers over the last two years has also been supported by the improved filing system at the UK IPO, the significant reduction in official

fees from October 2016 and growing demand for UK national designs, driven by Brexit.

### EMERGING AREAS

While total RCD filing numbers are rising at a slower pace than in the UK, EUIPO statistics demonstrate that filings in emerging areas, such as graphical user interfaces, are growing at a significantly higher rate – around 17 per cent annually. This likely reflects a desire among businesses to protect the substantial investment they are increasingly making in digital design.

In an ever more design-focused world, and with the greater certainty that comes with new case law available to define the scope and enforceability of design registrations, we expect the upward trends we are seeing in the filing figures to continue.

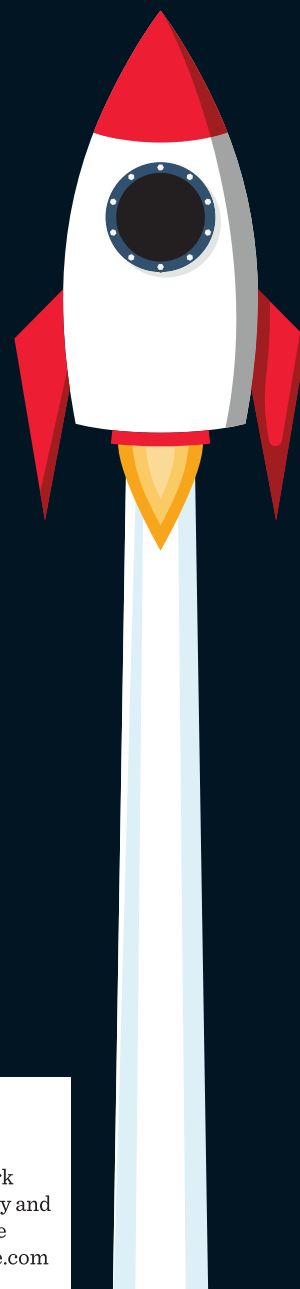
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For full information on RCD registrations at EUIPO, go to [bit.ly/446\\_RCD](http://bit.ly/446_RCD)



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## 2017 TOP UK FILERS OF RCDs

	FIRM	TOTAL
1	Boult Wade Tennant	572
2	Mewburn Ellis LLP	390
3	Barker Brettell LLP	358
4	D Young & Co LLP	342
5	Haseltine Lake LLP	331
6	Dehns	304
7	Carpmaels & Ransford LLP	293
=	Marks & Clerk LLP	293
9	Murgitroyd & Company	282
10	Mathys & Squire LLP	254
11	Wilson Gunn	243
12	Reddie & Grose LLP	236
13	Venner Shipley LLP	225
14	Kilburn & Strode LLP	222
15	Withers & Rogers LLP	189
16	Maucher Jenkins	182
17	HGF Ltd	181
18	Forresters IP LLP	171
19	Potter Clarkson LLP	163
20	Bird & Bird LLP	162
21	Appleyard Lees IP LLP	161
22	AA Thornton & Co	157
23	Patent Outsourcing Ltd	146
24	S.H. & Associates IP Ltd	139
25	Cooley UK LLP	137
26	JA Kemp	125
=	Stone King LLP	125
28	Lewis Silkin LLP	102
29	Gill Jennings & Every LLP	101
=	Urquhart-Dykes & Lord LLP	101
31	Stobbs	94
32	Keltie LLP	92
33	Mishcon de Reya LLP	88
34	EIP	71
=	Hepworth Browne Ltd	71
36	CMS Cameron McKenna Nabarro Olswang LLP	65
37	Adamson Jones	59
=	Baron Warren Redfern	59
=	Beck Greener	59
40	Albright IP Ltd	58
=	Finnegan Europe LLP	58
42	Wynne Jones	57
43	Page White and Farrer	55
=	WP Thompson	55
45	Sipara Ltd	54
46	M Law	50
47	Chapman IP	49
48	Abel & Imray	48
49	Bryers LLP	45
50	McDaniel & Co	41

## 2017 TOP UK FILERS OF UK DESIGNS

	FIRM	TOTAL
1	Carpmaels & Ransford LLP	250
2	Venner Shipley LLP	155
3	S.H. & Associates IP Ltd	130
4	Withers & Rogers LLP	93
5	Gill Jennings & Every LLP	92
6	Elkington and Fife LLP	87
7	Forresters IP LLP	82
8	Swindell & Pearson	79
9	Mathys & Squire LLP	71
10	Cooley UK LLP	69
11	Marks & Clerk LLP	67
12	Boult Wade Tennant	61
13	Appleyard Lees IP LLP	60
14	Briffa Legal Ltd	53
15	Wilson Gunn	49
=	Urquhart-Dykes & Lord LLP	49
17	Dehns	46
18	Abel & Imray	40
=	Haseltine Lake LLP	40
20	Agile IP LLP	38
21	Bromhead Johnson	37
=	Mishcon de Reya LLP	37
23	D Young & Co LLP	35
=	Keltie LLP	35
25	Cleveland Scott York	31
=	Eversheds Sutherland International LLP	31
27	Graham Coles & Co	30
28	Albright IP	29
=	Barker Brettell LLP	29
=	Bird & Bird LLP	29
=	Hutchinson IP Ltd	29
32	Harrison IP Ltd	28
33	Williams Powell	27
34	HGF Ltd	26
35	Finnegan Europe LLP	23
36	Bayer & Norton Business Consultant Ltd	22
37	Sanderson & Co	21
38	London IP Ltd	20
=	Maucher Jenkins	20
=	Wood IP Ltd	20
41	Brookes IP	19
42	Franks & Co Ltd	18
=	Humphrey Evans Intellectual Property Services Ltd	18
=	Lawdit Solicitors Ltd	18
=	IP Consult	18
46	Addleshaw Goddard LLP	17
=	Stephens Scown LLP	17
48	Baron Warren Redfern	16
=	Ellis IP Ltd	16
=	Reddie & Grose LLP	16

Note: Figures represent data received by Corsearch with reference to the calendar year indicated. Includes filings originating from a UK representative or office. Figures do not include corporate filers or representatives of single corporate entities. Figures have not been independently verified and should not be used for official reporting, marketing, advertising or publicity purposes.

# MAXIMUM IMPACT: USA

In the first of two exclusive articles, Grégoire Bisson explains how to make the most of the Hague System

The UK's accession to the Hague Agreement provides a reason to take stock of the advantages offered by this international design system. In particular, with its recent expansion to jurisdictions in which substantive examination is undertaken, the Hague System seems to have moved from the original concept of a one-size-fits-all vehicle towards an option that requires a more nuanced strategy.

One particular aspect of this is the need to take into consideration the notion of a single inventive concept applicable in the US. Yet experience shows that many types of multiple-design Hague registrations will be accepted by the USPTO.

A Hague registration can contain up to 100 designs as long as they relate to articles falling under a single class of the Locarno Classification; these can be very different articles, eg an office desk and a cradle. But, without a definition of "design" under the Agreement, users enjoy flexibility in their strategies, and often file as independent designs variants or colour versions of one and the same article, or even different depiction styles of that article.

#### RIGHT TO REFUSE

On acceding to the Hague Agreement, the US declared that its Office retained the right to refuse the effects of an international registration pending compliance with the

requirement under US law that the claim include only a single inventive concept. A claim may, however, include several embodiments of a design, as long as these are "patently indistinct" from one another. Embodiments will be considered to be patently indistinct if:

1. their design characteristics are basically the same;
2. their differences are minor relative to their overall appearance; or
3. if the differences are not so minor, they are found in prior art.

#### SUCCESSFUL STRATEGIES



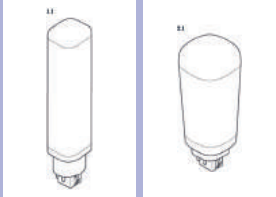



Lack of compliance with the requirement of a single inventive concept is the most frequent cause of refusal by the USPTO. While cases like the previous example of a registration made for a desk and a cradle would likely be refused, it is seemingly a conscious strategy of some users to file broadly for all territories and to leave it for later to decide on which design to retain in respect of the US and what to do with the others. More to the point, however, there is also an abundance of multiple-design Hague registrations that have been accepted by the USPTO (see panel).

Clearly, there is no systematic incompatibility between the requirement of a single inventive concept under US law and the designation of the US in a multiple-design registration under the Hague System. On the contrary, and while caution is to be exercised, these cases are among those that reveal that users whose strategies rely on different designs from a formal viewpoint can still be successful. This is encouraging for those interested in also designating the recently joined Russian Federation, as a relatively similar concept of unity of design applies there. ●

*Note: The opinions in this article are solely those of the author and do not represent an official position from either WIPO or the national offices cited.*

“ There is an abundance of multiple-design Hague registrations that have been accepted by the USPTO

## MULTIPLE DESIGN: SOME SUCCESSFUL APPROACHES

	Registration for	Intnl Reg No	Holder	Registration date
	Same article in different colours (six colour versions of a carpet with a pattern, selection shown)	DM/086 831	De Poortere Deco, société anonyme	18th June 2015
	Same article shown through different depiction styles: where the same deodorising block is shown first through photographs (in different colours totalling 18 designs), then through black-line drawings (one design) and CADs (two designs)	DM/089 522	Tomil s.r.o.	15th Sept 2015
	Same article in different proportions: an LED bulb in its slim and fat versions	DM/088 239	Philips Lighting Holding BV	11th Sept 2015
	Same article with different features: desk phones that differ as to part of their keyboard arrangements	DM/087 390	NEC Platforms, Ltd	24th Aug 2015
	Different articles sharing the same characteristics: an armchair and a sofa	DM/087 157	CINNA	1st July 2015
	Different articles forming a set: a coffee machine (design 1), the coffee pot alone and the machine itself (designs 2 and 3)	DM/094 638	Arzum Elektrikli Ev Aletleri Sanayi ve Ticaret Anonim Şirketi	14th Oct 2015

FOR DETAILS, AND TO SEE ALL RELEVANT IMAGES, GO TO [WIPO.INT/DESIGNDB/HAGUE/EN](http://WIPO.INT/DESIGNDB/HAGUE/EN)

### DEFINING TERMS

The Hague Agreement provides a mechanism for acquiring, maintaining and managing design rights in member territories through a single international application filed with WIPO that results in a single international registration with individual effect in each designated territory.



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# THE SME OPPORTUNITY

IP professionals still have a lot to teach this small but mighty sector, says Richard Ferguson

**I**

2017, 99.9 per cent of all private-sector businesses in the UK were small or medium-sized enterprises (SMEs), accounting for 60 per cent of all private-sector employment and 51 per cent of all private-sector turnover.<sup>1</sup> Evidently, while the businesses involved may be micro, the SME sector as a whole is small or medium in name only.

And, set against the backdrop of burgeoning start-ups and the gig economy, there has never been a greater need for IP protection among this group. Yet SMEs continue to have questions about just how to put such protection in place. There is, therefore, a great opportunity to be seized, if the IP profession is able to offer the answers.

As a regular volunteer at CITMA advice clinics, I've had a chance to see the need for such advice first-hand. So what are some of the recurring questions commonly raised by SMEs at the initial

consultation stages? And what advice have I given?

## **1. Isn't IP protection just for big businesses with deep pockets?**

Many readers in practice will have often heard of an SME deferring IP protection until there is significant commercial growth within the business. The age-old adage "something is better than nothing" is an underlying theme I employ in dispelling this myth.

Understanding a client's unregistered rights position is useful and presents a lower-cost starting point in building an IP strategy. This investigation can also provide an education about the bundle of IP rights that exist. This may include the client's trading history/repute, unregistered designs, copyright and know-how. Other brand assets, such as domain names, web stores and social media accounts, should not be overlooked either. An SME should



build a data bank of all design documents and key emails.

Registered rights can be where costs start to mount. However, even the biggest brands have a finite level of resource and budgetary constraints that they must work to, and an SME might wish to consider crowdfunding as a way to distribute its financial exposure. Developing an IP strategy for the first 12 months of trading can prove invaluable in aligning an SME’s asset protection with its commercial aspirations and investment opportunities. This is where the added value of

a specialist IP practitioner can really be shown.

Which marks or designs to principally protect is a gateway question in developing a rights strategy. Often, SMEs do not have the brand hierarchies of their larger counterparts, so a slightly more hands-on look at how the client is using its brand in the course of trade might be needed – eg shorthand use or iconography on apps and web content. What goods or services should be covered by a trade mark during the first tranche of filings will also need to be addressed, with

regard also to possible “top-up” filings for additional goods/services down the line.

Where trade marks or designs should be covered is another pivotal question, and building the use of priority claims and the Madrid and Hague systems into the filing strategy at the outset can further help to keep costs down.

I recommend a periodic health check of the brand at regular intervals, including at a new financial year, to help ensure that the registered rights align with use in commerce.

1. Department for Business, Energy & Industrial Strategy, *Business Population Estimates for the UK and Regions 2017*, 30th November 2017

“ Registered rights can be where costs start to mount, and an SME might wish to consider crowdfunding as a way to distribute its financial exposure

**2. If I have good business relationships with my suppliers, manufacturers and service partners, do I need legal protection?**

When business is taking off, everything is happening quickly and things are going well, it can be easy ▶



for an SME owner to assume that success and commercial relationships will exponentially grow. Unfortunately, this is often not the case.

As part of the unregistered rights audit, it is worth clarifying the ownership position around assets that would attract copyright and unregistered design protection, where the designer, not the commissioner, will be deemed the first owner of the design.<sup>2</sup> If the SME is not the owner and should be, the relevant assignment documents should be drawn up and executed. NDAs should also be considered.

The shortcomings of IP clauses within supply contracts will be all too familiar to many practitioners, be it the ambiguity of defined terms, omitted scenarios (eg the divestiture of goodwill at the end of the contract) or the absence of any IP provisions altogether.

Needless to say, where an SME is relying on a “gentleman’s agreement”

alone, a formal agreement should be prepared. Conducting a review of any existing supply agreements to check that the relevant indemnities and warranties are provided (and that there are no draconian or prejudicial terms) is also something that should be advised.

### **3. I’m already using my brand. So I don’t need to do formal legal searches, right?**

Thanks to the rise of e-commerce and social media, the world is now a much smaller place than it was 20 years ago. Technological advances have created common sectors, within which brands are vying for exclusive control (eg apps and websites), and generated an increased convergence in what might have previously been deemed reasonably geographical<sup>3</sup> or industrially distinct sectors (eg the television and telecommunications markets<sup>4</sup>). The proposition that a

brand being already established means there’s no need to look for potential conflicting ones is therefore an outdated notion. It is worth checking with the client to see if it is aware of any parties operating with the same/similar name and the background to this usage.

Another common misconception among SMEs is that the registration of a brand name with a domain registrar, social media channel, Companies House, etc is a green light to use the brand. Here, the SME will need advising that such a view does not provide any meaningful legal assurance or act as a defence to a claim for trade mark infringement or passing off. Put simply, there is no substitute for a full trade mark search. Similarly, claims by an SME to have undertaken its own trade mark searches using free databases such as the EUIPO website should be





## “ The technological advances of recent years mean that wider online content monitoring is no longer the preserve of multinationals

### 4. A bit of healthy competition is OK, isn't it?

Another common misconception is that making a specific number of changes in a design – say, seven – automatically suffices to make a later design original and non-infringing. Again, the SME should be questioned around the inspiration for the product/brand asset to determine whether there is the potential for a claim of trade mark, copyright or design infringement, as well as passing off. The practice of “benchmarking” (using existing competitor products/services for inspiration) is a particularly risky business. Proprietor, product and common-law searches, in particular, should be considered.

AdWords/keywords and online marketplace listings<sup>5</sup> can prove another murky area for a fledgling SME. While the general view advanced by the UK and EU courts is that AdWords helps promote healthy competition, an SME will need to exercise some caution in the keywords that it bids on and what end listings it produces in the search results. Where there is any scope for confusion as to the origin of the goods or services offered by the keywords, the SME might need to revise its AdWords practices (eg negative matching).<sup>6</sup>

### 5. My trade mark is registered, so aren't I totally protected?

Obtaining a registration is not the end of the story. As well as understanding the geographic limitations of the registration, the SME will need to be advised

that registered rights do not enforce themselves. Trade mark and domain watches are clearly a useful first step on the brand monitoring ladder. However, the technological advances of recent years mean that wider online content monitoring is no longer the preserve of multinationals. Indeed, a client may care more about how its brand is being received and treated in the real world than within the vacuum of a trade mark register.

Customs records for registered and unregistered rights should also be considered to monitor the real-world landscape. Law enforcement agencies such as Border Force and the Police Intellectual Property Crime Unit, as well as public bodies like Trading Standards, are useful resources for UK SMEs and should not be overlooked. Litigation is also far more viable than many SMEs might expect, thanks to the IPEC's cost caps.

### ENVIALE POSITION

In general, SMEs seeking UK protection are in an enviable position when compared to counterparts in other territories. And while the issues faced by each SME are unique, there are a number of common steps that it can take at the outset to ensure its IP is well positioned – with the help of an engaged IP profession. ●

*If you would like to volunteer at CITMA's free trade mark advice clinics for SMEs, contact [gillian@citma.org.uk](mailto:gillian@citma.org.uk)*

approached with a degree of caution; trade mark searching is an art, and this is another considerable value-add area for any professional representative.

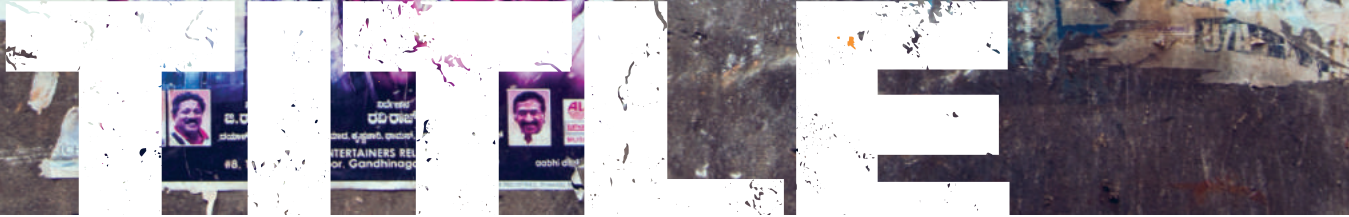
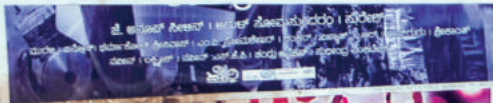
Where trade mark searches have been undertaken by an IP professional, it is important that the client ensures they are revisited, so that the currency of the searches remains valid. For example, a shoe retailer client that has since expanded into producing own-brand jewellery and luggage could now find itself on the wrong side of an infringement claim.

2. For an example of things going awry, see Innocent Drinks' logo dispute in *Fresh Trading Ltd v Deepend Fresh Recovery Ltd & Anor* [2015] EWHC 52 (Ch)  
3. *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834  
4. *Total Ltd v YouView TV Ltd* [2014] EWHC 1963 (Ch)  
5. *Jadebay Ltd & Ors v Clarke-Coles Ltd (t/a Peel Good UK)* [2017] EWHC 1400 (IPEC)  
6. *Interflora Inc & Anor v Marks and Spencer plc* [2014] EWCA Civ 1403



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With Bollywood a vital economic engine, Shilpi Mehta Nanda considers some notable IP conflicts in India's film industry

William Shakespeare may have written: "What's in a name? That which we call a rose / By any other word would smell as sweet". But this is a position with which the Indian film industry surely disagrees, if

evidence from a plethora of legal battles over the titles of Hindi films is any indication.

A film's title is certainly important in connecting that motion picture to the audience and distinguishing a product (the film) from others. A title is the first contact between the audience and the film, and it is thus crucial that it makes an excellent first impression. So what protection is accorded to this very valuable IP asset?

In terms of titles for single motion pictures (those that are not part of a series) the Kanungo Media case offers a reasonable primer on the concept of trade mark protection.<sup>1</sup> The Court, quoting McCarthy, held that titles of single literary works/ motion pictures have to acquire secondary meaning in order to be protected under trade mark law. In particular, the Court noted that:

"... Regardless of the arbitrary or fanciful nature of the title as compared with the contents of the single book, play, movie, record, etc, secondary meaning is required. Thus, unlike ordinary marks, literary titles of single works which are inherently distinctive are not accorded immediate protection, absent proof of secondary meaning and consumer recognition."<sup>2</sup>

The Court further held that, to justify a temporary injunction in a case of an unregistered title, and to establish a secondary meaning, the title of the motion picture should be capable of associating itself with the particular work or source, and there should be a likelihood of confusion of source, affiliation, sponsorship or connection of potential consumers/audience.

In the above-mentioned case, the Plaintiff (Kanungo Media Pvt Ltd) had produced a Bengali-language film entitled *Nisshabd* in 2005. The

film was shown at various film festivals and won several prizes, but was not commercially exploited. In April 2006, the Defendants announced that they were producing a Hindi-language film with the name *Nishabd*. The Court, after reviewing the evidence, found that the general public associated the title *Nishabd* more with the Defendants' film than with the Plaintiff's, because of the wide publicity and extensive advertisement of the Defendants' film.

The Court also gave weight to the fact that the Plaintiff's film was a Bengali documentary, whose viewership was substantially smaller than the Defendants' mainstream Hindi film. It said that, though the Plaintiff's film had achieved critical acclaim at film festivals, the viewership at such events is limited and of a particular type.

The Court further provided a list of factors that can infer secondary meaning in literary titles: (i) the length and continuity of use; (ii) the extent of advertising and promotion, and the amount of money spent; (iii) the sales figures on purchases or admissions, and the number of people who bought or viewed a work; and (iv) the closeness of the geographical proximity and product markets of plaintiff and defendant.

**FAMOUS FACES**

In *Sholay Media and Entertainment Pvt Ltd v Parag M Sanghavi*<sup>3</sup>, the Delhi High Court restrained the Defendant from manufacturing, selling, offering for sale, distributing, advertising and in any other manner using the registered and extremely well-known film title *SHOLAY* or any other deceptively similar mark amounting to an infringement of the Plaintiff's famous and registered trade mark. The rationale of Indian courts in only protecting such well-known titles was summed up by Justice AK Sikri in *Kanungo Media*. He explained that a literary work is a "specific, separate and

1. *Kanungo Media (P) Ltd v RGV Film Factory (2007) (34) PTC 591 (Del); 138 (2007) DLT 312*  
 2. *McCarthy on Trademarks and Unfair Competition*, 3rd edition (1995), Vol 1  
 3. *CS (OS) No 1892/2006*, order dated 5th October 2006



The Raj Mandir Cinema in Jaipur. Inset: stills from *Bride and Prejudice*

unique commercial item and not one product among many competing products”. The justice continued: “Each book, movie, play or record is an economic market in and of itself, not in competition with other similar literary works. Thus, in fact, this is the genesis for the adoption of the test of secondary meaning for [the] title of a literary work.”

In *Biswasroop Roy Choudhary v Karan Johar*<sup>4</sup>, the Plaintiff sought an interim injunction restraining the Defendants from using the title of the motion picture *Kabhi Alvida Naa Kehna*. The Court held that: “Neither party has conceived or authored the words ‘Kabhi Alvida Naa Kehna’ since admittedly they are part of the lyrics of an extremely popular film song of a vintage spanning over a quarter century and have been on the lips of any number of persons on any given day, throughout India.” It issued the caution that: “Where words or phrases in common parlance are sought to be used with exclusivity, the court should take care to determine which of the parties has ended its journey or traversed an appreciably longer way in the use of such words as a trademark or as a title.”

### SERIES TITLES

In contrast to the treatment of single titles, a series of titles of motion pictures are seen to serve a source-identification function and thus are protected under Indian trade mark law. For example, the series of titles related to *Munna Bhai MBBS*, *Lage Raho Munna Bhai* and *Munna Bhai Chale Amerika*; *Dhoom* and *Dhoom 2*; *Krrish*, *Krrish 2* and *Krrish 3*; *Hera Pheri* and *Phir Hera Pheri* are well protected under Indian trade mark law. The Delhi High Court in *Kanungo*



Media specified that the titles of a series of motion pictures function as a trade mark to indicate that each edition comes from the same source as the others and, therefore, such titles are registerable as trade marks.

### COPYRIGHT PROTECTION

Film titles are not protected under copyright law in India, as they do not pass the threshold of being more than *de minimis*. In *Kanungo Media*, the Court held that the title of a literary work cannot alone be protected by copyright law in India, when considered separately from the plot, characterisation, dialogue, theme song, etc.

And the Supreme Court, in *Krishika Lulla v Shyam Vithalrao*

## FILM IN INDIA: REGISTRATION BASICS

### Protected under:

Trade Marks Act, 1999

### Type of registration:

Service mark

### Class:

41 (Fourth Trade Mark Rule, 2001)

### Registration categories:

Title of a series of films; single film

### Notable registration conditions:

Secondary meaning, in the case of the title of a single film. Established with relation to: duration and continuity of use; strength of advertisement and promotion; production budget; scale of sales and distribution.

*Devkatta*<sup>5</sup>, held that, generally, there would not be any copyright protection for titles of literary works. In that case, the Respondent had written a synopsis of a story titled “Desi Boys” and emailed it to two people. The Respondent sued the Appellants, claiming that they had infringed on his copyright in the title *Desi Boys*, having released a film by that name throughout India in November 2011. The Supreme Court said that the title of a work is not complete by itself, taken separately from the work. Moreover, the combination consists of “Desi” and “Boys”, which are common words, and there cannot be said to be anything original about it.

Ultimately, the title is an important and indispensable part of the bundle of IP rights a producer has in a motion picture. Accordingly, while Indian law aims to avoid consumer confusion in the marketplace, it also protects producers who have invested in a motion picture and its title from infringement and unfair competition. ●



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4. 131 (2006) DLT 458  
5. Criminal Appeal No 258 and 259 of 2013, decided on 15th October 2015

# NEW TOOLS FOR TMs

Turkey's revised trade mark law has been widely welcomed, says Mutlu Yıldırım Köse

## Turkey's Industrial Property

Code No. 6769 (IPC) came into force on 10th January 2017 and brought in a number of new rules, with the major amendments relating to:

- letters of consent;
- non-use defence in opposition and litigation proceedings; and
- time limits for cancellation actions.

Importantly, the IPC introduces the principle of coexistence into Turkish trade mark law. Accordingly, letters of consent from the senior trade mark owner or trade mark application owner have become a new tool in overcoming the citations of earlier, senior and identical, or indistinguishably similar, trade marks by the Turkish Patent and Trademark Office as an *ex officio* refusal ground.

## NON-USE DEFENCE

Another change that directly affects IP practice is the non-use defence. According to the IPC, if the ground trade mark was registered more than five years from the application date (or priority date) of an opposed trade mark application, on request by the owner of the trade mark application, the Office is obliged to ask the opponent to prove the effective usage of the ground trade mark on the relevant goods and/or services in Turkey. The mechanism of a non-use defence is applicable to invalidation and infringement actions as well.

On 28th April 2017, the Office published proof-of-use guidelines, taking into consideration the precedents of EUIPO and the CJEU. The Office stated that the effective use of ground trade marks can be proven with a range of evidence,

including: invoices; catalogues; price lists; product codes; products; packaging; signboard visuals; advertisements, promotions and their invoices; marketing surveys and research; and information about commercial activity in Turkey.

As this procedure is entirely new in Turkey, the evaluation of the

“

*'Colours' and 'sounds' are explicitly stated under 'signs' that can qualify as a trade mark*

evidence submitted has not been tested, but it seems that the most important documents for proving use of the trade mark will be invoices and documents that show the production and sale of the products bearing the trade mark.

## TIME LIMITS

Further, the IPC introduced a new rule concerning the time limits for

filing a cancellation action and adopted the principle of “loss of right due to acquiescence”, which is the same in EU trade mark law. According to this new rule, there is no time limit for filing an application for a cancellation, but, if the owner of an earlier right acquiesces in the use of a later trade mark for a period of five successive years, the senior trade mark owner will no longer be entitled to file a cancellation action, except in cases where the later trade mark was filed in bad faith.

What's more, the graphical representation criteria for signs has changed to “signs capable of being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor” – and “colours” and “sounds” are explicitly stated under “signs” that can qualify as a trade mark. In addition, bad faith has been added as a separate ground for opposition.

Although settled precedents remain to be established, these changes have been widely welcomed by brand owners and Trade Mark Attorneys operating in Turkey.



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# Privilege prevails

Cerryg Jones discusses the detail of a decision that affects future fact-finding

The Court of Appeal recently allowed an important appeal relating to the disclosure of documents created in the build-up to the eventual proceedings brought by the Serious Fraud Office (SFO). Mining company Eurasian Natural Resources Corp Ltd (ENRC), the Appellant, had claimed that the documents were protected by legal professional privilege (comprising litigation privilege or legal advice privilege), and the Court agreed that most of the documents were protected by litigation privilege.

## LITIGATION PRIVILEGE

Generally, litigation privilege can cover communications between a client and its legal advisor and communications between the legal advisor and third parties, while legal advice privilege applies only to confidential communications between a client and its legal advisor. Legal advice privilege covers both Patent Attorneys (under the Copyright, Designs and Patents Act 1988) and Trade Mark Attorneys (under the Trade Marks Act 1994), though it is worth noting that the legislation provides protection only in relation to specific areas of law.

When one wants Patent or Trade Mark Attorney advice to attract legal advice privilege, care should be taken to ensure that it falls within one of these categories. For example, copyright and database right is not expressly included within the relevant legislation, though it may relate to matters that are expressly covered. Advice given by attorneys may also be covered by litigation privilege under the Legal Services Act 2007, but there are additional hurdles to overcome before litigation privilege can apply, as this case illustrates.

## CAUSE FOR CONCERN

The High Court judgment in this case had alarmed legal advisors and clients alike, as they could have subsequently been required to disclose all documents produced during

internal investigations. The Court of Appeal's judgment has now restored some degree of balance. However, there are still hurdles that must be passed before communication can be protected by litigation privilege.

The High Court's decision was largely made on the basis that the eventual prosecution by the SFO was not in the reasonable contemplation of ENRC at the time it began its internal investigation and, even if it had been, the documents were not created for the predominant purpose of being used for such litigation, but rather as part of a fact-finding mission.

## DISAGREEMENT

The Court of Appeal disagreed with the High Court's findings on both points. The Court recognised that, although a large corporation might not be aware of what an internal investigation would unearth, adversarial litigation could still be found on the facts to be in its reasonable contemplation when beginning such an investigation. If the results of an internal investigation undertaken to discover whether any wrongdoing had taken place could not be protected by litigation privilege, corporations might be tempted not to investigate at all.

The Court also made it clear that, even though ENRC had hoped to avoid or settle proceedings with the SFO through the results of its internal investigation, the documents produced could still be covered by litigation privilege, because avoiding or settling litigation was as good a purpose as resisting or defending proceedings.

*“ There are still hurdles that must be passed before communication can be protected by litigation privilege*

## “Corporations cannot easily rely on legal advice privilege where documents are produced with the assistance of employees

### LEGAL ADVICE PRIVILEGE

Because the Court found that most of the documents in question were covered by litigation privilege, it did not consider it necessary to resolve the question of whether they would also have been covered by legal advice privilege. The Court of Appeal did express some opinions on the law of legal advice privilege, in particular in relation to the Court of Appeal's decision in *Three Rivers (No. 5)*.<sup>1</sup>

The *Three Rivers (No. 5)* case had found that legal advice privilege would only attach to communication between a corporate client's employees and its legal advisors where such employees had been tasked with seeking and receiving legal advice. As this narrow approach has been the subject of criticism and other common-law jurisdictions have allowed a much broader and more modern approach, the Court felt that, although it was not required to, it would discuss how it would have determined the matter.

Initially, the Court confirmed that *Three Rivers (No. 5)* was the law and it would have been bound to follow this decision. The Court did, however, consider that the approach adopted in *Three Rivers (No. 5)* was an outdated approach that is inconsistent with the requirement for large corporations to rely on their employees' knowledge of their business. It is unlikely that such a corporation would task its employees to seek or receive legal advice; instead, for internal investigations, it would have to rely on its employees' knowledge and it would be in the interest of the

corporation that any documents produced containing this knowledge could be protected by legal advice privilege.

Despite the Court being bound by its decision in *Three Rivers (No. 5)*, it remarked that, if it had been open to it to depart from this decision, it would have considered doing so. A departure would, however, have to come from Parliament or the Supreme Court.

### BALANCE RESTORED

Therefore, corporations are currently left in a position whereby they cannot easily rely on legal advice privilege where documents are produced with the assistance of their employees – such as notes from interviews taken by legal advisors as part of their overall advice, as was the case here. This is critical to keep in mind in relation to any communication between Patent or Trade Mark Attorneys and a corporate client's employees, especially where the corporation will have to involve a wider pool of its employees in those communications on, for example, non-legal technical or confidential matters.

As litigation privilege can protect communication between a legal advisor and third parties, it may be more relevant where information needs to be gathered from a corporate client's employees. So, although the Court could not overrule *Three Rivers (No. 5)*, its judgment has restored some balance in allowing clients to undertake a potentially essential fact-finding investigation before proceedings are brought or even threatened, without necessarily losing legal privilege over the results of such investigation.

### KEY POINTS

- ✦ The Court held that documents produced during an internal investigation prior to the commencement of proceedings can be protected by litigation privilege
- ✦ The Court clarified the law in *Three Rivers (No. 5)* that communications between legal advisors and employees of a corporate client will not be protected by legal advice privilege unless such employees were tasked with seeking and receiving legal advice
- ✦ The Court was critical of the decision that narrowly defined the client when dealing with corporate entities and opened the door to an eventual appeal to the Supreme Court on this point



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1. *Three Rivers District Council & Ors v The Governor & Company of the Bank of England (No. 5)* [2003] EWCA Civ 474

# Blue Sky delayed

And a prolonged period of uncertainty lies ahead, believes Joel Smith

## KEY POINTS

✦ Sky was refused permission to appeal, but may yet appeal the High Court judgment, once the outcome is known from the CJEU

✦ Trade mark proprietors will face a prolonged period of uncertainty in registering and/or enforcing trade marks (both in the IPO and courts) until the judgment is delivered

**In the case** of Sky plc & Ors v Skykick UK Ltd & Anor<sup>1</sup>, the High Court referred five questions to the CJEU on trade mark issues relating to bad faith (for filing with no intention to use) and clarity issues with trade mark specifications. Mr Justice Arnold found that the use of SKYKICK infringes the Claimants' SKY marks pursuant to Article 9(2)(b) of Regulation (EU)

2017/1001, as there is a likelihood of confusion between the marks, but only if the Claimants' trade marks are valid. Therefore, the outcome of the infringement case depends on the validity of the Claimants' trade marks, which can only be decided once the CJEU has answered the questions referred to it.

The case before Arnold J is at interim stage, pending the CJEU judgment, as he has yet to make all the relevant findings of fact. Sky sought permission to appeal from the Court of Appeal and, on 6th September 2018, the Court handed down its judgment, refusing Sky's application. The Court found that there was no obstacle to the Court of Appeal hearing an appeal, on the basis that EU law is *acte clair* and/or that the reference to the CJEU was unnecessary. The Court of Appeal can do anything that the trial judge could have done, and, as Arnold J could have declined to make the reference to the CJEU, the Court of Appeal could also do this and give final judgment.

## COMPLEXITY RATIONALE

While the Court asserted that it did have jurisdiction to hear an appeal at this stage

of the proceedings, in this case it decided that it should not do so. The rationale was that hearing the appeal would invite unnecessary procedural complexity. If the Court were to hear the appeal at this stage, this would include a decision on whether the reference to the CJEU should be made. If the Court were to decide to make the

reference, costs would have been incurred on an exercise that had gained nothing, since there was already a pending reference from the High Court.

If the Court declined to make the reference to the CJEU, it might still find that it lacked the necessary findings of fact to conclude on the validity of the trade marks and would

then have to remit the case back to the High Court (leaving open the unattractive prospect of a further appeal back to the Court of Appeal).

## KNOCK-ON EFFECTS

Sky argued that the case had given rise to real uncertainty for the industry and was having profound knock-on effects in UK trade mark cases. The Court took the view that it was better to allow the reference to the CJEU to proceed, as the right course is to obtain the necessary rulings from the CJEU, sooner rather than later, so that certainty for the industry can be restored. The CJEU's judgment in this case will be very important, as it could have wide-ranging implications, as previously valid registered trade marks may now be invalid or partially invalid.

“  
*Sky argued that the case had given rise to real uncertainty for the industry and was having profound knock-on effects*”



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1. [2018] EWHC 155 (Ch) and [2018] EWHC 943(Ch)



# No second showing

The first outing is the place to reveal all relevant evidence, says Lucy Cundliffe

**This case considered** the circumstances in which fresh evidence can be adduced on appeal from the Registrar at the UK IPO.

Mr Cooper was the owner of four UK trade marks, which Consolidated Developments applied to revoke on the grounds of non-use. Having considered the evidence submitted, the Hearing Officer (HO) revoked three of the registrations and maintained one in relation to a limited specification.

Mr Cooper appealed to the Appointed Person (AP). He did not directly challenge the first-instance decision, conceding that the HO had reached the correct decision on the basis of the evidence before him. Instead, Mr Cooper sought to introduce new evidence, submitting that the HO could and would have maintained the marks for a wider range of goods and services had this evidence been before him at first instance.

The AP elected to refer the matter to the High Court on the basis that the appeal raised points of general legal importance within the scope of rule 72(5) of the Trade Mark Rules 2008. Mr Justice Carr opined that the Court (or the AP) had jurisdiction to admit fresh evidence on appeal and considered the relevant authorities to identify the principles guiding the decision to exercise (or not) that discretion in trade mark appeals. Applying those principles to this case, the judge concluded that Mr Cooper's new evidence should not be admitted and that his appeal should be dismissed.

## IMPORTANT FACTOR

A factor identified as particularly important in this case was that the admission of Mr Cooper's new evidence would have required that the case be remitted to the Registry for a rehearing. The Court stressed the importance of fostering finality in litigation and the desirability of

avoiding multiplicity of proceedings and delays in the Registry. This weighed heavily in the present case, especially as, in the Court's view, the evidence sought to be adduced would not clearly have had an important influence on the outcome of the case and, in any event, could and should have been adduced at first instance (despite Mr Cooper's accounts of his struggles with depression, which he claimed rendered him unable properly to consider at the time the evidence available to him). That said, the Court considered that the exercise of discretion is a balancing act between the various different factors, as a blanket refusal to admit evidence could also lead to injustices. Ultimately, however, the admission of new evidence on appeal should be the exception and not the rule.

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*The Court stressed the desirability of avoiding multiplicity of proceedings and delays in the Registry*

reiterates the importance of ensuring that all relevant, available evidence is submitted at first instance. As expressed so aptly in *Fage UK Ltd v Chobani UK Ltd*<sup>1</sup>, and applicable by parity of reasoning to Registry proceedings: “The trial is not a dress rehearsal: it is the first and last night of the show.”

## KEY POINTS

- ★ The admission of fresh evidence on appeal should be the exception and not the rule
- ★ The exercise of discretion in the decision to admit new evidence on appeal is a balancing act between various relevant factors
- ★ Where the admission of new evidence would effectively result in a rehearing at first instance, the interest in ensuring finality in litigation may tip the balance against admission

## HISTORICAL APPROACH

The refusal to admit fresh evidence in this case is in line with the restrictive approach that has historically been applied by the courts. This decision offers practitioners a useful summary of the guiding principles governing the admissibility of fresh evidence on appeal and

1. [2014] EWCA Civ 5, [2014] FSR 29



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# To IPEC or not?

It's a popular forum, but, asks Patrick Cantrill, is it appropriate?

**With 2017** a record year for the IPEC, which handled 367 cases, it is timely to consider further guidance given in this case about the factors to be considered when deciding whether the IPEC is the appropriate forum.

The Claimant maintains the archives of the fashion designer Massimo Osti, is the proprietor of registrations for MASSIMO OSTI and MASSIMO OSTO ARCHIVE (the Marks), and alleged trade mark infringement and breach of contract by the first Defendant and, in his personal capacity, its sole shareholder and director, John Sharp. The breach of contract claim arose from the allegation that, following the liquidation of a US company with which the Defendants had been associated and from which the Claimant had licensed the Marks, an implied licence arose between the First Defendant and the Claimant (the Implied Licence).

It is alleged that the Defendants infringed by using the Marks outside the terms of the Implied Licence and breached the Implied Licence by not paying royalties or delivering royalty statements. The Defendants denied the allegations and counterclaimed that the Marks were invalid for lack of distinctive character and being descriptive pursuant to Articles 59(1)(a), 7(1)(b) and 7(1)(c) of Regulation (EU) 2017/1001.

The Claimant sought €79,835 by way of unpaid royalties; damages for contractual breach; an EU-wide injunction prohibiting infringement of the Marks; delivery up or destruction of infringing items; and an inquiry as to damages or an account of profits in respect of the alleged infringements.

Proceedings commenced in the general High Court but, on its own initiative, the Court transferred the case to the IPEC. The Claimant thus applied to have this transfer set aside.

## LEGAL PRINCIPLES

Master Clark referred to paragraph 9 of the Civil Procedure Rules (CPR) PD30, which explains that, when deciding on transfers to or from the IPEC under CPR 63.18, the Court will consider whether a party can only afford to continue the claim in the IPEC, and whether the IPEC is the appropriate forum based on the value of the claim, the complexity of the

issues and the estimated length of the trial. He also had regard to paragraph 1.3 of the 2016 IPEC Guide, related to affordability, value of the claim, complexity and trial length.

## AFFORDABILITY AND VALUE

Although the First Defendant was a "micro" company that could not by itself afford litigation in the general High Court, it was part of a group with substantial assets. Moreover, the evidence filed as to the means of the Second Defendant was very limited. Accordingly, the Master treated affordability as a neutral factor. With regard to monetary value, the net value thereof was well within the maximum value (£500,000) of damages awardable by the IPEC.

As for the value of injunctive relief, although the Claimant sought a pan-EU injunction, it had not provided evidence as to the value of its business or the value attributable to the exploitation of the Marks. The Master also noted that the Claimant had not sought an undertaking from the Defendants to refrain from subsequent manufacture. Due to a lack of evidence, the Master was unable to form a view on the value of the Marks.

## COMPLEXITY AND TRIAL LENGTH

The Master held that: the issues of the case did not present a degree of complexity that made it inappropriate for the IPEC; the claim could be heard within the usual two days for IPEC cases; and, consequently, that the case would remain in the IPEC.

The decision is a reminder that, if a party wishes to challenge a transfer to the IPEC, it must offer cogent evidence that addresses the factors laid out in CPR PD30 and elsewhere. The consequences, in terms of cost, of such transfers can be severe.

## KEY POINTS

- ♦ The IPEC's caseload has grown significantly and there is pressure to ensure that this trend continues in order to keep an affordable IP disputes forum available
- ♦ This ruling demonstrates that a party that wishes to challenge the IPEC as the correct forum should address thoroughly and with cogent evidence all the factors on which such transfer decisions are made



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# Springing into action

Injunctive relief was warranted. Heather Williams explains why



**With this judgment**, the High Court has granted a 12-month springboard injunction against the Respondents (who were also intended additional Defendants), restraining them from soliciting, contracting with or dealing with defined restricted persons in relation to defined restricted products.

The existing Claimant and Applicant (Seatriever), together with proposed additional Claimants, sought interim injunctive relief against the intended additional Defendants and Respondents, including a 12-month springboard injunction. A springboard injunction is designed to remove or limit the advantage or head start that an employee has gained through unlawful activities, typically through the misuse of the employer's confidential information.

While the Respondents consented to being joined in the proceedings and did not object to interim injunctive relief being ordered against them as regards their alleged, but disputed, misuse of confidential information, they did object to the springboard injunction and to certain ancillary orders that were being sought regarding the disclosure of information.

## CLAIM BACKGROUND

The present claim was launched in June 2017 against Mr Daly, who had been Seatriever's global sales director, raising allegations of breach both prior to his departure from the company in March 2017 and subsequently, the latter alleging breach of contractual post-termination restraints and misuse of confidential information. Following disclosure, it became apparent that Mr Daly had been in contact with the Respondents and had allegedly offered to provide them with confidential information of the Claimants.

Unfortunately for the Claimants, there was little hard evidence of the Respondents having targeted the Claimant's customers, or a plan to do so imminently. The Respondents highlighted the fact that disclosure of the confidential information was said to have occurred in May 2017, yet no use was evidenced to have

taken place until May 2018. In this respect, the Claimant's case was materially lacking.

The Claimants were nonetheless able to demonstrate that misuse of their confidential information by the Respondents would give the latter a clear and unfair competitive advantage. In addition, there was evidence of actual or potential misuse of the group's confidential information in terms of product copying. The Claimants therefore established that there was a serious issue to be tried in those respects.

## CASE MADE

Accordingly, the Court was satisfied that the Claimants had made out the case for the grant of a springboard injunction lasting for 12 months in respect of eight restricted persons. This was a reduction of the Claimant's proposed order, which included 36 parties. The Court found that injunctive relief was appropriate in light of the fact that there was a risk that the Respondents could use the Claimant's confidential information to divert business from the Claimants. In the Court's view, the destruction of the Claimant's business relationships was not something that could be remedied by damages.

In addition to the injunctive relief, the Court was also asked to consider whether early electronic disclosure should be ordered to compel the Defendants to disclose any confidential information of the Claimants in their possession. The Court denied this request, stating that the Claimants had failed to demonstrate that it was either necessary or proportionate to make an order to that effect.

## KEY POINTS

- ✦ A springboard injunction has advantages compared to a regular injunction
- ✦ The Court is prepared to award a springboard injunction even in the absence of actual misuse by a defendant



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# On with the game

A childhood staple resisted a recent challenge, writes Charlotte Wilding

## KEY POINTS

✦ The action failed on the grounds that Hasbro had unequivocally put the mark MONOPOLY to genuine use in the UK in the time periods claimed

✦ The fact that the registered mark was for the plain word and the mark as used was presented on a black rectangle with shaded elements did not affect its distinctive character

**Hasbro, Inc** is the proprietor of UK trade mark registration No 711981 MONOPOLY for “board games”, filed on 3rd November 1952 and registered on 12th August 1954. Kreativni Dogadaji d.o.o. (Kreativni) filed an application to revoke Hasbro’s registration on the basis of sections 46(1)(a) and (b) of the Trade Marks Act 1994.

Kreativni claimed an effective revocation date of 4th November 1957 under s46(1)(a), but the earliest possible date on which revocation could take place was in fact 13th August 1959. Kreativni had based the date on the day that followed the expiry of the five-year period after the mark was filed, not registered. Accordingly, the s46(1)(a) claim was dismissed at the outset.

The five-year periods Kreativni claimed were: 4th November 2002–3rd November 2007 (effective revocation date 4th November 2007); 4th November 2007–3rd November 2012 (effective revocation date 4th November 2012); 4th May 2012–3rd May 2017 (effective revocation date 4th May 2017). Kreativni also argued that use of MONOPOLY could not indicate the origin of the goods in question, as the purpose of the game is to achieve a property market monopoly.

## EVIDENCE

Hasbro denied the grounds and stated that Kreativni was aware of Hasbro’s use due to an EU opposition proceeding (No B1918641).

Hasbro provided a witness statement by Mr Nigel Hutton, its Senior Vice President International Legal, which included: details about the history of MONOPOLY and its versions; parts of the 2008/2009 box; annual sales figures; sample invoices; marketing figures and materials; catalogues with images of the product; licensing details; and market research analysis from 2016.

Kreativni criticised Hasbro’s evidence – in particular, the catalogue evidence and the fact that the witness statement was provided by an employee of Hasbro.

## DECISION

The action failed on the grounds that Hasbro had unequivocally put the mark MONOPOLY to genuine use in the UK in the time periods claimed. Further, “consumers would not view MONOPOLY as denoting a characteristic of the goods instead of indicating trade origin”.

With regard to Kreativni’s criticism of the evidence, this was also dismissed. The Registrar agreed that: “[While] the mere existence of catalogues does not necessarily prove that they were distributed, the catalogues in question are Argos catalogues. It is a notorious fact that Argos regularly produces catalogues in the UK.” Also, Hasbro provided invoices showing sales to Argos.

Moving on to the witness statement, the rules surrounding this are far less prescriptive than those set out under the EU trade mark regulations, and a witness statement is considered a normal form of evidence, provided that it is signed and dated, and includes a statement of truth.

Finally, the Registrar noted that, although Hasbro’s use was in relation to “a single type of board game, it would be pernickety to try to sub-categorise the specification”. The fact that the registered mark was for the plain word and the mark as used was presented on a black rectangle with shaded elements did not affect its distinctive character.

This case highlights the importance of ensuring that effective revocation dates are accurate. That being said, the Registrar noted that, had this error been amended, it would not have affected the outcome of the proceedings. Further, provided that a mark as used does not alter the distinctive character of the mark as registered, where genuine use is found, this will be sufficient to defeat a revocation claim.



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# Classic case

Yet Charlie Bond believes that further guidance could be useful

On 19th January 2017, the famous soprano Sarah Brightman applied to register two trade marks for her series of Royal Christmas Gala concerts that she runs with the Royal Philharmonic Orchestra. However, the use of the word “royal” proved to be fatal to the success of the application.

The proposed trade marks were a series of two images. In the first (shown below right), ROYAL CHRISTMAS GALA was written in gold, and a gold crown appeared between two lions, similar to those seen on a coat of arms. The second showed the same image in black and white.

## REPORT REFUSAL

On 25th January 2017, the UK IPO issued its examination report, which explained that the application failed under sections 3(5) and 4(1)(d) of the Trade Marks Act 1994. These prevent the registration of words, letters or devices likely to lead persons to think that the applicant either has, or recently had, royal patronage or authorisation. When refusing the application, the IPO highlighted that the marks contained both the word “royal” and imagery associated with the Royal Family (eg a crown).

Ms Brightman was advised that she could overcome this objection if she obtained written permission from the Lord Chamberlain’s office, but she failed to do so.

Ms Brightman challenged the decision not to register her trade marks at a hearing on 17th July 2017. It was argued that the UK Courts have interpreted s4(1)(d) to mean “likely to lead the average consumer to believe” there was royal patronage, whereas, in this case, the consumer would at most be caused to wonder if there were a royal connection.

Further, it was argued that the average consumer is used to seeing the word “royal” in branding (eg Royal Court Theatre). While consumers might wonder whether there is a royal connection, it was argued that

speculation is not sufficient to prove confusion would occur.

In its decision, the IPO said that an assessment of the trade mark as a whole is necessary. The term “gala” denotes a special occasion; the proposed marks would therefore be compared to televised events attended by royals (eg the Royal Variety Performance). The use of a crown and lions reinforces the royal connection, and therefore falls under section 4(1)(d).

The IPO decided that the average consumer would have no reason to doubt that the concert had royal patronage. After all, it was called Royal Christmas Gala and accompanying regal imagery was used.

“

*It was argued that the average consumer is used to seeing ‘royal’ in branding*

## EXAMINER INPUT

This is a classic case of the decision turning on the facts. In the absence of any evidence of consumer perception of the name, this decision appears to have depended on what the specific examiner involved thought of the mark. As Ms Brightman argued, many registered trade marks incorporate the term “royal”. In this case, it seems that the rejection of the mark was based on a combination of the use of regal imagery and the word “royal” in the context of something that many consumers associate with royal patronage (a special musical event). In that context, the decision does appear to be correct. However, in order for it not to appear that decisions will depend on the luck of the draw as to which examiner is involved, it would be helpful for the IPO to produce greater guidance on what is likely to be accepted in this situation.

## KEY POINTS

- ✦ The IPO looks at the mark in its entirety
- ✦ The Lord Chamberlain’s office’s permission is required to include ‘royal’ in a trade mark
- ✦ There remains uncertainty about how the rules relating to the use of the word ‘royal’ will be applied

UKTM APPLICATION  
NO 3207535



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# Fitness fall out

Richard May reflects on a clear case of likely confusion

In March 2017, Clinton Slater (the Applicant), a fitness instructor, filed an application in the UK for a sign (depicted below right, top) in classes 35 and 41 (the Application). The Application contained the words “Outdoor Physical Training” and covered training-related services, such as “physical training” and “conducting fitness classes”.

Outdoor Physical Training Ltd (the Opponent) opposed the Application under sections 5(4)(a) and 3(6) of the Trade Marks Act 1994, alleging passing off and bad faith, respectively. The Opponent (and its director, Barnaby O’Neill), claimed the Application was the logo of its fitness training business and that the Applicant, being a former director of the Opponent, had applied for the Application to draw business away from the Opponent, having fallen out with Mr O’Neill.

The Applicant denied the allegations and claimed he created the name “Outdoor Physical Training” and the Application. Of relevance in this case is that the two protagonists – the Applicant and Mr O’Neill – were both directors (and shareholders), between 2013 and 2017, of the Opponent, which had its own legal status as a limited company.

## BAD FAITH

The Applicant’s written submissions focused heavily on his claim to copyright in a second, older logo, depicted below right (bottom) – the Old Logo. The Hearing Officer (HO) rightly concluded that this was a red herring. Even if the Applicant did own the copyright in the Old Logo, it did not negate the fact that, when the Application was filed, he was a director of the Opponent and owed a fiduciary duty to protect its interests. Despite this, the Applicant filed a logo knowing the Opponent was using it and knowing the subsequent registration of it would jeopardise the ongoing trade of the Opponent. Accordingly, the HO found the filing of the Application amounted to bad faith.

## PASSING OFF

The HO considered the three familiar factors required to succeed under a passing off claim. In terms of goodwill, the HO was happy to accept that, despite a lack of detailed evidence of trading, the Opponent owned the goodwill in the Application, because the Application had only ever been used by the Opponent since circa 2015. Once goodwill was established, the HO



concluded that deception was inevitable if the Applicant were to use the Application in his personal capacity. The HO went on to conclude that it was also inevitable that damage would occur, because the Applicant would be “assuming the mantle” of the Opponent and would clearly divert trade through such a confusing form of use. Consequently, passing off was made out.

## CLEAR DIRECTION

This case highlights the problems that can occur when business partners fall out and there is no apparent understanding of the legal status of a limited company in respect of IP rights. The case makes it clear that there are reliable provisions under trade mark law that will support the interests of the limited company/user of a trade mark in circumstances where a director acts in a manner that is contrary to the interests of the company.

## KEY POINTS

- +
- The HO found that filing a UK trade mark to prevent another party from using it amounted to bad faith
- +
- The use of a trade mark by a director of a company in his personal capacity will amount to passing off if the company owns the goodwill in the trade mark

THE APPLICANT’S  
UKTM NO 3217732



THE OPPONENT’S  
OLD LOGO



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# Final nail in the coffin?

The failure of another application may mark the end of the road, suggests Gavin Stenton

**Following two unsuccessful** attempts at registration in 2006 and 2009, Edward Green & Company Ltd (Edward Green) filed a UK application for the sign shown below right, covering footwear (and accessories) in class 25.

On 11th April 2017, the Examiner raised an objection under s3(1)(b) of the Trade Marks Act 1994, stating that the mark was devoid of distinctive character. Edward Green subsequently requested a hearing and filed evidence of acquired distinctiveness. Following a hearing on 4th September 2017, the s3(1)(b) objection was maintained and the evidence of acquired distinctiveness held to be insufficient. Additional submissions and evidence of acquired distinctiveness were filed on 7th November 2017. However, on 4th December 2017, the objection was upheld and the application refused. Edward Green then filed form TM5 on 4th January 2018, requesting a full statement of grounds of the reasons for the refusal.

## EXAMINER'S GROUNDS

The Examiner stated that, despite Edward Green's attempts to persuade the Examiner to the contrary, the relevant consumer was the general public. Although Edward Green's shoes cost more than £900 per pair, it did not follow that the relevant consumer would be a specialist and it would be inappropriate to discount potential members of the public based merely on the Applicant's commercial intent.

The Examiner then explained that the sign was devoid of any distinctive character because it "does not possess any particular feature which would distinguish it from simply a series of nails used to fix the heel to the upper part of the sole". Consumers would not therefore attach any trade mark significance to such a simplistic sign.

When considering acquired distinctiveness in the context of non-traditional trade marks, the

Examiner focused on the doctrine of reliance and referenced Vibe Technologies (O/166/08), noting that: (i) mere association is not enough; (ii) the use of the sign must establish in the perception of the average consumer that the product originates from a particular undertaking; and (iii) that perception must result from the use of the sign as a trade mark.

In assessing the evidence of acquired distinctiveness (which included details of the shoe manufacturing process, turnover figures, advertising strategy and witness statements from customers and trade experts), the Examiner explained that it failed to demonstrate that the sign itself had been used as a trade mark, or had made any attempt to highlight to consumers that the nail heel pattern denoted trade origin. Citing Birkenstock Sales GmbH (O/072/18), the Examiner concluded that the evidence would have been more persuasive had the Applicant shown that it had conducted a programme of education in its marketing activities.

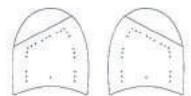
## EU CHALLENGES

Edward Green has a corresponding EU trade mark application (No 17945135) pending before EUIPO that includes a claim of acquired distinctiveness. On the basis of its UK trade mark application, this EU application is likely to face significant challenges, not only because acquired distinctiveness will need to be shown in all 28 Member States, but also possibly on the basis that the nails (as "characteristics" of the sign) could be construed as being necessary to obtain a technical result (which cannot be overcome by demonstrating acquired distinctiveness).

## KEY POINTS

- ✦ The average consumer of luxury fashion goods is likely to be the general public, irrespective of a premium price point
- ✦ Applicants for, and users of, non-traditional signs should invest in educating their consumers so that they recognise such signs as veritable badges of origin

THE EDWARD GREEN APPLICATION



"The arrangement of nail heads in groups on the underside of a left shoe heel and the underside of a right shoe heel around a part of the perimeter thereof"



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 Holly Strube, a Senior Associate and Solicitor at Penningtons Manches LLP, assisted with this article.

# Application goes up in smoke

Damage to an established mark was too likely, reports Emmy Hunt

In August 2017, Just Enough Programme Ltd (the Applicant) sought to register the stylised mark shown below right in connection with a range of goods in class 34, including “cigarettes; tobacco products” in addition to smoking paraphernalia and tobacco alternatives.

Beiersdorf AG (the Opponent), the German proprietor of the NIVEA brand of cosmetics, skincare and haircare products, opposed the Application based on s5(3) of the Trade Marks Act 1994. The Opponent relied on earlier registered rights and reputation in NIVEA. The Opponent alleged that the use of the Applicant’s mark in connection with any goods or services would result in consumers making a connection with the Opponent. As the Application covered class 34 goods, including for tobacco and cigarettes, it argued the reputation of its NIVEA trade mark would also be damaged.

## OPPONENT’S ISSUES

The Opponent put forward significant evidence to show long-standing use of the NIVEA mark, such that it was clear, and the Applicant did not contest, that it enjoyed a reputation in relation to cosmetics, skincare products and shaving cream.

The more significant issue was whether the average consumer would make the necessary link between the earlier NIVEA mark and the Applicant’s mark. Following Intel, the Hearing Officer (HO) considered the similarity of the marks, the nature of the goods and relevant section of the public, the strength of reputation of the earlier mark, and the degree of distinctive character of the earlier mark, finding that:

- The marks were more or less identical, the only difference being visual in respect of the circular swirl of the Applicant’s mark.
- There was reputation in the earlier NIVEA mark in the field of cosmetics, and the Applicant did not dispute this.
- The NIVEA mark is invented and has a high degree of inherent distinctiveness. The Opponent’s significant use of NIVEA further enhanced its distinctiveness.
- In favour of the Applicant, the gap between the Opponent’s products and the class 34

goods covered by the Application was “not insignificant”.

The HO also took into account the weight of the other factors, all of which were heavily in favour of the Opponent. The HO considered it inevitable that a consumer would see the Applicant’s Mark and think of the Opponent’s earlier mark, thereby establishing the necessary link.

Finally, the HO considered the reputation of the NIVEA mark in respect of beauty and body care and the resulting damage to that reputation. The Opponent, together with Cancer Research UK, has campaigned to educate and inform the public about skin cancer. The Applicant’s products are smoking products (or alternatives), and the HO considered that they would be perceived as harmful to health, to varying degrees, and the public would be aware that at least some of them are proven to directly cause cancer. Consequently, the HO found that any link between the Applicant’s mark and the Opponent’s earlier mark was likely to be detrimental. The Opposition succeeded in its entirety.

## EVIDENCE INFLUENTIAL

This case demonstrates that there may be broad circumstances in which a mark with reputation might be successfully relied on. In particular, despite there being a “not insignificant gap” between the goods of interest to the parties, evidence of a high level of distinctiveness (inherent and acquired) of the earlier mark can help establish a link in the consumer’s mind. Evidence clearly identifying the nature of the damage caused to the reputation of the earlier mark was also a significant consideration in determining the outcome of the opposition.

## KEY POINTS

- The Opponent successfully established that there was a reputation in NIVEA for class 3 products
- The HO found that a link would be made between the earlier rights in NIVEA and the later application for a stylised mark featuring that word
- The tobacco products covered by the later application could cause detriment to the earlier mark, as such products would be perceived as harmful to health
- The HO found that the opposition based on s5(3) was clearly made out, and rejected the application in its entirety

THE APPLICANT’S  
MARK - UK  
APPLICATION  
3252786



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# Boon for brand owners



Rosalyn Newsome welcomes this decision on the continuity of control

**Mitsubishi Shoji Kaisha Ltd** (Mitsubishi) holds a word mark and a figurative mark for MITSUBISHI and the logo shown below right in the EU and Benelux. Mitsubishi uses Mitsubishi Caterpillar Forklift Europe BV to manufacture and sell its own forklift trucks in the EEA.

Since 2009, Duma Forklifts NV (Duma), a forklift trader, and its affiliate GS International BVBA (GSI), both based in Belgium, have purchased forklifts from a company within the Mitsubishi group, but based outside the EEA. They then imported the forklifts into the EEA, using a customs warehousing procedure. The forklifts were then modified to comply with EU standards, and the Mitsubishi marks, identification plates and serial numbers were replaced with signs owned by Duma and GSI.

Before the Belgian Court of Appeal, Mitsubishi argued that modification in this manner constituted an infringement of its rights. On this point, the Court of Appeal stayed the proceedings and referred the case to the CJEU.

## SIGNIFICANT OBSERVATIONS

The CJEU made a number of significant observations. First, it noted that the removal of Mitsubishi's marks deprived it of the right conferred to it under *Zino Davidoff and Levi Strauss (C-414/99)* – namely, to control the marketing of goods bearing the Mitsubishi mark in the EEA.

Second, the Court held that the removal of Mitsubishi's marks and the affixing of new signs on the goods prevented Mitsubishi from being able to retain customers by virtue of the quality of its goods. It also affected the ability of the trade mark to perform its main purpose – namely, establishing the origin of the goods – and, as such, it also distorted competition. The Court referred to the earlier case of *TOP Logistics (C-379/14)* and others, which confirmed that any act by a third party that prevents the proprietor of a registered trade mark in one or more Member States from exercising its right to control the first placing

of goods on the market in the EEA bearing that mark stops the trade mark from fulfilling its purpose. In addition, such actions deprived Mitsubishi of the possibility of obtaining, by putting the goods on the EEA market first, the economic value of the product bearing that mark and, therefore, of its investment.

It makes no difference to that conclusion that the removal of the Mitsubishi marks and the affixing of new signs took place when the goods were still placed under the customs warehousing procedure; importing the goods into the EEA and marketing them is “use in the course of trade”, which, of course, is preventable use.

## NEGATIVE IMPACT

The decision continued, stating that, even though the relevant public may be able to identify the forklifts as being made by Mitsubishi based on their appearance, Duma's actions prevented Mitsubishi from benefiting from any reputation the Mitsubishi marks would have acquired through use on its forklifts and impeded use of its marks to serve as a factor in sales promotion or as an instrument of commercial strategy. This could have a negative impact on the economic performance of the business. Therefore, it was held that Mitsubishi was entitled to prevent Duma and GSI from continuing their actions.

In summary, the Court held that use that is deemed to prevent the trade mark proprietor's right to control the first placing of goods bearing a mark on the market in the EEA is contrary to the objective of undistorted competition and is preventable. A welcome judgment for brand owners.

## KEY POINTS

- + Any act by a third party that prevents a proprietor of a registered trade mark in one or more Member States from exercising its right to control the first placing of goods on the market in the EEA bearing that mark stops the trade mark from fulfilling its purpose
- + Use that is deemed to prevent the trade mark proprietor's right to control the first placing of goods bearing a mark on the market in the EEA is contrary to the objective of undistorted competition

THE MITSUBISHI LOGO

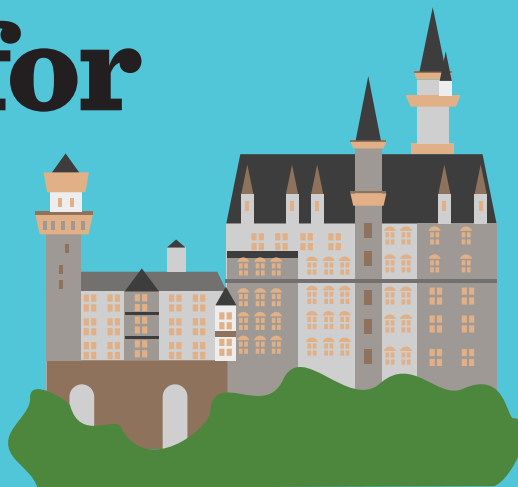


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# Swansong for Souvenir

Rachel Garrod looks at the reasons why this appeal was considered unfounded



In 2011, the Freistaat Bayern registered NEUSCHWANSTEIN (word mark), in various classes, at EUIPO. The Appellant, Bundesverband Souvenir – Geschenke – Ehrenpreise eV, subsequently filed an application for a declaration of invalidity on the basis that the application had been filed in bad faith as per Article 52(1)(a) of Regulation (EC) No 207/2009 and the mark itself was descriptive and non-distinctive as per Articles 7(1)(b) and 7(1)(c). EUIPO rejected the invalidity application, resulting in an appeal to the General Court (GC). This was dismissed in its entirety.

In September 2016, an appeal was filed at the CJEU. The Appellant submitted that the GC had:

- incorrectly considered that, for certain goods, the relevant public's degree of attentiveness was higher;
- incorrectly found that the name "Neuschwanstein", meaning "new swan stone", was colourful and original, such that the relevant public would not make a connection with the goods/services concerned;
- contradicted itself by acknowledging that Neuschwanstein Castle was geographically locatable, but stating that it could not be regarded as a geographical location; and
- inaccurately stated that Neuschwanstein Castle was a museum.

The above part of the appeal was rejected as inadmissible. The Appellant restricted itself to disputing the appraisal of facts conducted by the GC, simply seeking a new appraisal of the facts, without claiming that there had in fact been any distortion of those facts by the GC.

## GEOGRAPHICAL QUESTION

The Appellant also submitted that the GC did not consider whether "Neuschwanstein" could be an indication of the geographical origin of the goods/services for the purposes of Article 7(1)(c).

In Windsurfing Chiemsee (C-108/97 and C-109/97), the Court held that, while an

indication of the geographical origin of a product usually states the place where that product was or could be manufactured, the connection between a product and a geographical location might depend on other ties, such as the fact that the product was conceived and designed in that geographical location.

The Appellant therefore argued that the place where the goods/services were marketed should be regarded as a tie connecting those goods/services with Neuschwanstein Castle.

## APPEAL DISMISSED

This argument was dismissed, as it was considered unreasonable to conclude that, in the mind of the relevant public, the place of marketing to which the name "Neuschwanstein" related was a description of a quality or an essential characteristic of the goods/services covered. Although items were sold as souvenirs, because Neuschwanstein Castle was not the place where the goods were produced or services rendered, the trade mark could not be indicative of the geographical origin of the goods/services. This part of the appeal was therefore rejected as unfounded.

The other grounds of appeal regarding Articles 7(1)(b) and 52(1)(b) were also rejected as either inadmissible or unfounded. The appeal was therefore dismissed in its entirety.

## KEY POINTS

- ✦ An appeal is not an opportunity for the Appellant to simply seek a new appraisal of the facts without at least claiming that there had been some previous distortion of those facts
- ✦ The marketing of goods/services will not necessarily be regarded as a tie connecting those goods/services to a particular geographical location, thus preventing registration of a mark under Article 7(1)(c)



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# Pattern of failure

The Court did not tread lightly on Birkenstock's application, says Justin Bukspan



**Shoe manufacturer Birkenstock** obtained an international registration for a pattern in relation to various goods in class 10 (including surgical and orthopaedic items), class 18 (various leather goods) and class 25 (including clothes, footwear and shoe inserts), and designated the EU. The representation of the mark was a square-shaped section of that pattern (see below right).

The Examiner issued a refusal for lack of distinctive character. The Board of Appeal (BoA) dismissed Birkenstock's appeal, and the General Court (GC) allowed only a few goods. Before the CJEU, the Appellant relied on three main grounds.

## FIRST GROUND

The first ground concerned the legal position that the assessment of the distinctiveness of patterns was comparable to that of 3D signs – and thus required to consider the shape of the goods to be covered by the patterns, or the influence of technical factors. Thus, the pattern applied for would need to differ significantly from the usual practices for the goods concerned in order for it to be regarded as distinctive.

Previously, Birkenstock had claimed before the GC that the BoA should not have assumed that the sign as represented on the register (ie an image contained within a square) would be automatically reproduced and continued as a pattern to cover the goods designated by the application. If it had not, the bar to assess the distinctiveness of Birkenstock's mark would have been lower.

The GC held that only when it was unlikely that the sign would be repeated should it not be regarded as a surface pattern. Thus, this encompassed only a small portion of the goods included in the application: artificial limbs, eyes and teeth; suture materials; suture materials for operations; animal skins, hides. The application could

therefore only proceed towards publication for that reduced list of goods.

Birkenstock argued before the CJEU that the GC should have instead applied the criterion of "most likely use". In response, the CJEU ruled that "possible" (instead of "unlikely") use of the sign as a surface pattern for the goods covered was sufficient. Therefore, this ground of appeal was dismissed.

## SECOND AND THIRD GROUNDS

For its second ground, the Appellant claimed that the GC had adopted a contradictory approach when assessing the distinctive character of the mark. Because assessment was to be done on a case-by-case basis, the Appellant alleged that the GC should not have referred to earlier cases on the distinctiveness of 2D and 3D signs in its judgment. The Court disagreed, saying that, while the assessment does indeed have to be carried out on a case-by-case basis, the GC was allowed to make reference to comparable cases when stating the rationale for its evaluation of the distinctive character of a mark.

The third ground was more procedural. The Appellant alleged that the GC had distorted some of the evidence by stating that it was "well known" that some of the goods listed in the application usually displayed surface patterns. Without seeing evidence from the Appellant that it was not well known that the above goods usually displayed surface patterns, the Court could not hold that the facts had been distorted.

The appeal was therefore dismissed.

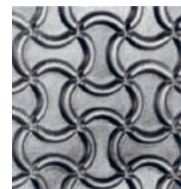
## KEY POINTS

✦ The CJEU ruled that "possible" (instead of "unlikely") use of the sign as a surface pattern for the goods covered was sufficient

✦ While the assessment has to be carried out on a case-by-case basis, the GC was allowed to make reference to comparable cases when stating the rationale for its evaluation of distinctive character

✦ The Appellant provided no evidence that it was not well known that the relevant goods usually displayed surface patterns, so the Court could not hold that the facts had been distorted

THE BIRKENSTOCK  
REGISTRATION



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# Collective questions

Emily Scott examines two recent quandaries referred to the CJEU

In a reference from the Estonian Court of Appeal, the CJEU has considered whether a body that provides collective representation for trade mark owners has standing to bring proceedings in its own name and whether the limitations of liability for infringement set out in Articles 12–14 of the E-Commerce Directive<sup>1</sup> apply to the provider of a rental and registration service for IP addresses.

The referral was made in the course of proceedings between the Claimant, Coöperatieve Vereniging SNB-REACT UA (SNB-REACT), and the Defendant, Mr Deepak Mehta, who rents IP addresses to third parties. SNB-REACT claimed that Mr Mehta had registered domain names that unlawfully used signs identical to trade marks owned by 10 of its members, and websites that unlawfully offered for sale goods bearing such signs.

The Court of First Instance dismissed the action on the basis that SNB-REACT had not shown that it had standing to bring the action in its own name, owning no rights over the trade marks at issue. In addition, although Mr Mehta was shown to own IP addresses linked to the allegedly infringing domain names and websites, it was not established that he owned them or had unlawfully used the signs. The domain names and websites were operated by a third party. Liability could not, therefore, be established.

SNB-REACT appealed the decision and two questions were referred to the CJEU; in short:

1. Is Article 4(c) of the IP Enforcement Directive<sup>2</sup> to be interpreted as meaning that Member States are required to recognise bodies collectively representing trade mark proprietors as persons with standing to pursue legal remedies in their own name to defend the rights of trade mark proprietors, and to bring actions before the courts in their own name to enforce the rights of trade mark proprietors?
2. Are Articles 12–14 of the E-Commerce Directive to be interpreted as meaning that even a service provider whose service consists in registering IP addresses, thus enabling them to be anonymously linked to domains, and in renting out those IP addresses, is to be

regarded as a service provider within the meaning of those provisions – and to whom the exemptions from liability provided for in those Articles apply?

## QUESTIONS

In interpreting Article 4(c) of the IP Enforcement Directive, the CJEU confirmed that a body collectively representing trade mark proprietors is entitled to seek, in its own name, remedies for the purpose of defending the rights of the proprietors it represents and to bring legal proceedings, in its own name, to enforce those rights, on the conditions that:

- a. the body is regarded by national law as having a direct interest in the defence of its members' rights; and
  - b. the national law allows the body to bring legal proceedings for that purpose.
- These are both matters for the referring court to verify.

In reiterating settled case law, the CJEU concluded that the safe harbours provided by Articles 12–14 of the E-Commerce Directive apply to an IP address rental and registration service if the service falls within the scope of those Articles (ie hosting or caching of infringing information, or acting as a “mere conduit” of it), and insofar as:

- a. the activity is of a merely technical, automatic and passive nature, which implies that the service provider has neither the knowledge of, nor control over, the information transmitted or cached by its clients; and
- b. the service provider does not play an active role by allowing its clients to optimise their online sales activity.

These questions of fact are for the referring court to verify.

## KEY POINTS

- ✦ A collective body has standing to bring proceedings in its own name as long as it is recognised by national law as having a direct interest in the defence of its members' rights
- ✦ An IP address rental and registration service is exempt from liability for infringement if its activities fall within the scope of the safe harbours provided by the E-Commerce Directive and it has no knowledge or control over the information it transmits or stores, and plays no active role

1. Directive 2000/31/EC  
2. Directive 2004/48/EC



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# Of global importance

This case underlines the need to assess marks from a wider perspective, says Victoria Rodriguez

**With this decision**, L'Occitane kept its trade mark registration, as the General Court (GC) confirmed that there was no likelihood of confusion between EAU PRECIEUSE and NUIT PRECIEUSE.

While the Cancellation Division found that there was likelihood of confusion, as both of these marks contained the word “*précieuse*”, both the Board of Appeal (BoA) and the GC agreed that there was not, and reiterated that assessment on that issue must be global. In other words, marks should not be artificially dissected or deconstructed with no regard to the overall impression of the sum of the elements.

## SHORT STORY

In a nutshell, Chefaro Ireland DAC (Chefaro) sought to invalidate the EU trade mark registration NUIT PRECIEUSE held by Laboratoires M&L SA (known as L'Occitane) in class 3 on the grounds of Articles 8(1)(b) and 8(5) of Regulation (EC) No 207/2009 (now Articles 8(1)(b) and 8(5) of Regulation (EU) 2017/1001), and on the basis of its earlier national French mark EAU PRECIEUSE, covering conflicting goods in class 3.

Chefaro's invalidity application was initially upheld by the Cancellation Division. The BoA, however, annulled the decision, concluding, *inter alia*, that the word “*précieuse*” could not be regarded as the dominant element of these marks, being merely a laudatory adjective qualifying two different nouns, “*eau*” and “*nuit*”, so the similarities between these marks were insufficient for likelihood of confusion to arise.

Not content with the above decision, Chefaro brought the case to the GC. The Court, however, dismissed the action in its entirety and emphasised the importance of the overall impression given by the marks.

Importantly, while Chefaro disputed the level of distinctiveness of the separate elements of the marks and whether “*précieuse*” was the common

dominant/distinctive element of the marks, for both the Court and the BoA, this was an “artificial dissection” of the signs, as the first and second elements of each sign were intrinsically linked, and they will be perceived as a complete phrase that is understood in its entirety.

## INTERDEPENDENCE

As highlighted by the Court, a global assessment of the likelihood of confusion not only implies some interdependence between the factors, but also that conceptual differences between two signs may counteract the phonetic and visual similarities between them, provided that at least one of those signs has, from the point of view of

the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately.

In this sense, the Court took the view that the signs are similar only to the extent that both reproduce “*précieuse*”, a laudatory adjective which the relevant French public would perceive in the context of

each of the marks, but not independently from the nouns qualified by it (namely, “*nuit*” and “*eau*”). As the BoA noted, while the earlier sign refers to water that is precious, the other refers to the idea of a cherished or esteemed night, which is clearly a different concept. Further, the fact that these marks are conceptually dissimilar weighs against the existence of a likelihood of confusion.

The importance of assessing likelihood of confusion globally cannot be overemphasised.

## KEY POINTS

✦ Marks cannot be artificially dissected or deconstructed as regards individual elements. If the elements of each sign are intrinsically linked so that they will be perceived as a complete phrase, then this needs to be considered

✦ A global assessment of likelihood of confusion not only implies some interdependence between the factors, but also that conceptual differences between two signs may counteract the phonetic and visual similarities

“

*The BoA concluded that ‘précieuse’ could not be regarded as dominant*

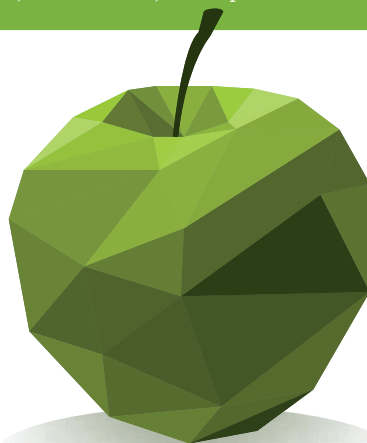


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# Sweet but short?

Adrian Dykes feels that this Apple victory may be short-lived



In 2012, Apo International, a supplier of projector lamps, filed an EU trade mark application for an APO device (shown below right) in classes 9, 11 and 35. The application was opposed by Apple, which relied on its apple silhouette mark, both as a prior registration and as a well-known mark under Article 6bis of the Paris Convention (among other apple device marks), and two APPLE word marks. Grounds relied on were likelihood of confusion, extended protection and unregistered rights. The opposition failed on all three grounds.

The Opposition Division concluded that the similarity between the marks was below average and that, despite the goods and services being identical, there was no likelihood of confusion, and the claim under Article 8(4) failed for the same reasons. Under Article 8(5), the Opposition Division concluded that Apple failed to provide evidence of the form of damage, or to provide a coherent argument that there was a likelihood of damage.

The opposition was upheld before the Board of Appeal (BoA), which took the view that the marks were not at all similar. The analysis under Articles 8(1)(b) and 8(5) ended at that point, and the opposition failed.

## APPEAL TO THE GC

Apple appealed to the General Court (GC), claiming that the BoA failed to apply the case law dealing with the comparison of marks. Essentially, Apple argued that the BoA incorrectly concluded that the marks were dissimilar and failed to apply the other assessments under Articles 8(1)(b) and 8(5).

Referring to the previous case law of the GC and the CJEU<sup>1</sup>, the Court recounted that, if there is some similarity, however faint, between the marks at issue, then that is sufficient for the full assessment to be conducted under the relevant article. It is only where any similarity between the marks is ruled out that the provisions of these Articles do not need to be assessed.

The Court noted that marks are similar if they are at least partially identical in one

or more aspects – visually, aurally or conceptually – when considering the overall impression on the relevant public (in this case, the public at large).

Bizarrely, EUIPO argued that consumers would be likely to see the device element of Apo International’s mark as a capital “C” with a letter “Y” (above the “a”), and that the type of fruit alluded to was impossible to define. The Court rejected these arguments, holding that a significant part of the relevant public would see the device as an apple, and that both the word and device elements would have a comparable impact on the image of the mark. The partial outline of an apple was sufficient to make the mark similar to Apple’s silhouette device.

The same could not be said in relation to the APPLE word marks: the overlap of two letters was not sufficient to counterbalance “clear differences” between the marks.

Conceptually, EUIPO argued that the letter combinations “apo” and “capo” had no meaning and could not be conceptually similar to an apple (word or device). The Court rejected this argument, finding conceptual similarity between all the marks at issue. Aurally, there was similarity with the word marks – the overlap of the syllable “ap-” was sufficient.

## NEXT STEPS

The matter will be sent back to the BoA for further consideration. With the gateway test of similarity of marks now satisfied, the grounds of opposition will need to be assessed in full, meaning Apple’s victory might be short-lived.

1. C-552/09 Ferrero v EUIPO, EU:CL2011:177; T-480/12 The Coca-Cola Company v EUIPO, EU:T:2014:1062

## KEY POINTS

- + Where there is some similarity between marks at issue, a full assessment must be conducted
- + With the gateway test of similarity of marks satisfied, the grounds of opposition will need to be assessed in full

## THE APO DEVICE



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# Tigha tamed

An obscure term didn't do the trick, as David Yeomans explains

**This case concerns** an opposition by Taiga AB against an EU trade mark application filed by ACTC GmbH for the mark TIGHA in classes 18 (a variety of bags) and 25 (various items of clothing). The opposition was based on claimed likelihood of confusion with the earlier EU trade mark registration for TAIGA, protected in classes 9, 18 and 25. The earlier mark was subject to the proof of use requirement.

The opposition was rejected by the Opposition Division. Taiga AB appealed, and the appeal was partially upheld, which led to the application being refused for the class 25 goods. The Board of Appeal (BoA) found that:

- i. use of the earlier mark had been proven for certain goods (including "clothing" in class 25);
- ii. the goods applied for in class 25 were identical/highly similar to the goods for which use had been proven; and
- iii. the marks were sufficiently similar for there to be a likelihood of confusion for the overlapping goods. ACTC then appealed the rejection of its class 25 goods to the General Court (GC).

ACTC argued that the BoA had assessed the proof of use incorrectly. It argued that the proof only referred to outdoor clothing for protection against cold, windy and/or rainy weather and that, because this constituted a coherent group within the general category of clothing, it was wrong to determine that the Applicant had proven use for "clothing" and to have assessed the similarity of the respective goods on that basis.

The GC rejected this argument for two reasons. First, it stated that, although intended to protect against weather, the goods for which use had been proven have the same purpose as general items of clothing, since they are all intended to cover the human

body. Second, the fact that the goods have particular weather-protective properties did not matter because specific characteristics of goods are not relevant to the identification of subcategories. For these reasons, it was determined that weather-protective outdoor clothing did not constitute a subcategory within clothing.

ACTC also argued that (in view of the proof of use supplied) the respective goods were different, serving different purposes, and that the BoA had therefore assessed the likelihood of confusion incorrectly. Unsurprisingly, in view of its decision on the proof of use point, this argument was rejected by the GC.

ACTC also argued that the marks were not confusingly similar owing to conceptual differences. It argued that the mark applied for has no meaning, whereas the earlier mark TAIGA describes an expansive boreal (northern) forest.

However, the GC was not convinced that consumers based outside of the north and east of Europe would grasp that meaning. Besides a Wikipedia extract, ACTC had not supplied any evidence that might have convinced the GC otherwise.

This case provides some interesting guidance regarding how the GC interprets the subcategorisation of goods and services. Although each case will be assessed on its own merits, the way in which the proof of use was assessed in this case could perhaps be taken as good news for trade mark owners.

## KEY POINTS

- ✦ Specific characteristics of goods are not relevant to the identification of subcategories
- ✦ The GC determined that weather-protective outdoor clothing did not constitute a subcategory within clothing

“

*The way in which the proof of use was assessed in this case could perhaps be taken as good news for trade mark owners*



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# Car clash

Absent a finding of similarity, consumers cannot make an association between two marks, writes Désirée Fields

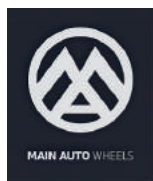
## KEY POINTS

✦ The similarity between two marks must be based on a global assessment of the visual, phonetic and conceptual similarities between them, and without regard to use in actual commerce

✦ Word elements are usually considered more distinctive than figurative elements, since consumers tend to refer to a product by name

✦ Absent a finding of similarity between two marks, consumers cannot make an association between two marks for the purposes of Article 8(5)

THE PAALUPAIKKA APPLICATION



VOLKSWAGEN EUTM



In May 2014, Paalupaikka filed a figurative EU trade mark (EUTM) application (see below left, top) in classes 12 and 35, including for vehicles and advertising services in classes 12 and 35. Volkswagen opposed under Articles 8(1)(b) and 8(5) of Regulation (EC) No 207/2009 (now Regulation (EU) 2017/1001). Volkswagen relied on two earlier EUTMs, registered for identical and similar goods and services in classes 12 and 35.

EUIPO's Opposition Division rejected the opposition, holding that the respective marks produced a different overall impression and that Volkswagen had not shown that the mark applied for would take unfair advantage of or be detrimental to the distinctive character of its earlier marks. EUIPO's Fourth Board of Appeal (BoA) dismissed Volkswagen's appeal. Volkswagen appealed to the General Court (GC).

## SHADES OF DIFFERENCE

Volkswagen argued that the BoA had wrongly attributed importance to the word elements MAIN AUTO WHEELS, which Volkswagen submitted were a footnote or slogan, lacked distinctive character and occupied a subsidiary position in the mark applied for. Dismissing those arguments, the GC confirmed the BoA's finding that the words were not negligible and would catch the attention of consumers, due to the capital letters, simple font and contrasting colour.

The GC found that the word sequence – main, auto, wheels – was unusual and not descriptive of the goods and services applied for. It enabled consumers to more easily discern the letters “M” and “A” in the circle above. Accordingly, the figurative element was not the only decisive factor in assessing the overall visual impression produced by the marks.

The GC agreed that the figurative elements were visually different and dismissed Volkswagen's other arguments, in particular that the BoA should have taken actual use into

account, noting that the confusion had to be assessed solely on the basis of a comparison of the marks.

The GC agreed that phonetic comparison was only possible if the relevant public perceived the letters “V” and “W” in the earlier marks. Here, it was appropriate to compare MAIN AUTO WHEELS with “VW” or “WV”. Conceptually, the GC agreed that the word AUTO within the mark applied for was internationally understood as “car”, and that the English-speaking public would understand the meaning of WHEELS and MAIN. The GC found that Volkswagen's marks did not convey any conceptual meaning. Concluding that the marks were overall dissimilar, the GC dismissed Volkswagen's appeal under Article 8(1)(b).

## NO ASSOCIATION

The GC noted that, for Article 8(5) to apply, three cumulative conditions had to be fulfilled. The first was that the marks concerned had to be identical or similar. The others related to reputation and the risk that the use of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark. For the relevant public to be able to establish a link between the respective marks, there had to be a certain degree of similarity between them. Given that the marks were held to be dissimilar, Volkswagen's case under Article 8(5) fell at the first hurdle.

## AFFINITY NEEDS MUST

A finding of similarity between two marks is crucial in order for a case under Article 8(5) to bite. Absent such a finding, consumers cannot make an association between them. In that regard, the analysis must be carried out solely by comparing the contested mark as applied for and the earlier mark as registered, without regard to actual use in commerce.



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Watch this space!  
 Details of the CITMA Spring  
 Conference programme will be  
 online soon at [citma.org.uk](http://citma.org.uk) →



# Events

More details can be found at [citma.org.uk](http://citma.org.uk)

DATE	EVENT	LOCATION	CPD HOURS
7th December	CITMA Northern Christmas Lunch*	Jamie's Italian, Leeds LS1	
14th December	CITMA London Christmas Lunch**	London Hilton on Park Lane, London W1	
13th March	CITMA Intensive Designs Seminar	Gowling WLG, London SE1	3
13th March	CITMA Networking Drinks Reception Part of the CITMA Spring Conference	TBC, London	
13th-15th March	CITMA Spring Conference	IET London: Savoy Place, London WC2	9
14th March	CITMA Gala Dinner Part of the CITMA Spring Conference	TBC, London	

Our 2019 programme of lectures and webinars will be announced shortly. Check [citma.org.uk](http://citma.org.uk) for details →



## SUGGESTIONS WELCOME

We have an excellent team of volunteers who organise our programme of events. However, we are always eager to hear from people who are keen to speak at a CITMA event, particularly overseas members, or to host one. We would also like your suggestions on 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

# Rachel Wilkinson- Duffy

is sold on being part of the solution

**I work as...** a Senior Trade Mark Associate in the IP department of Baker McKenzie, London.

**Before this role, I was...** a PA at Baker McKenzie. When a trainee position opened up, I thought it couldn't do any harm to go for it. It never occurred to me that I'd still be loving the job more than a decade later.

**My current state of mind is...** looking forward to some pre-Christmas sunshine on a break in Malaysia.

**I became interested in IP when...** a Trade Mark Attorney at another firm I worked at suggested I take the ITMA (as it then was) exams. I loved the subject enough to survive the old qualification route of five foundation papers and three finals.

**I am most inspired by...** Kate O'Rourke, and am still in awe of the incredible job she did in handling the two quite tumultuous years of her CITMA presidency.

**In my role, I most enjoy...** disputes that have an unusual spin and bring an extra challenge.

**In my role, I most dislike...** matching invoices to budgets – a task I would not begrudge losing to AI-enabled computers.

**On my desk is...** a mini Chinese teapot and cup, and lots of green tea. On a bad day, it helps me convince myself that I'm being healthy.



“

*I would love a chance to go back and explore Kowloon, where I was born*

**My favourite mug says...** “Baker Allies” – it's our firm's support network for LGBT+ initiatives.

**My favourite place to visit on business is...** Hong Kong. Prior to INTA 2014, I was last there at the age of seven, so I enjoyed seeing how it has changed into a business hub. I would love a chance to go back and explore Kowloon, where I was born.

**I can't live without...** my Pinnacle racer. Being able to rely on it for the daily commute keeps me sane.

**If I were a trade mark, I would be...** Irregular Choice. I would like to think that, like the brand, I'm a bit weird and yet wonderful.

**The biggest challenge for IP is...** the increasing tolerance for public-policy drivers being used to encroach on IP rights.

**The talent I wish I had is...** serenity, but I've come to terms with the fact that it just doesn't match up with my personality.

**My ideal day would include...** a morning swim at a Tuscan villa, lunch in a local village, horse riding, then an al fresco dinner.

**In my pocket are...** a few doggy waste bags – we own two large dogs.

**The best piece of advice I've been given is...** be part of the solution, not part of the problem. It has helped me achieve a positive outcome many times.

**When I want to relax, I...** take a long soak in the bath while catching up on the *CITMA Review*.

**In the next five years, I hope to...** encourage more CITMA members to be active in committees and working groups. I have got so much out of my own involvement and effort.

**The best thing about being a CITMA member is...** interaction with the unique, diverse membership. I have never come away from an event feeling that I didn't learn something.

## Sacco Mann... Santa Claus? Same difference.



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New opening for a Trade Mark Attorney to join the friendly, inclusive team of one of the region's leading practices. The role will include a mix of non-contentious and contentious work across sectors ranging from consumer goods, luxury fashion brands and financial services products. Finalist level through to qualified Attorneys will be considered.

### **Trade Mark Administrator : South West**      **TJB59265**

Well established, national IP firm seek an IP Administrator. Ideally CITMA qualified, you will have gained Trade Marks experience from a similar position. Duties include, audio copy typing, liaising with clients and diary management for various fee earners.

### **Trade Mark Formalities Administrator : London**      **TJB59228**

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### **Trade Mark Paralegal : London**      **TJB58539**

This internationally expanded practice specialises in non-traditional trademarks and offers support for the entirety of brand protection and focusses on providing commercial advice. You will have a knowledge of filing UK and EU applications, experience working amongst a team of fee earners and hold excellent communication skills.

### **Newly Qualified Trade Mark Attorney : London**      **VAC59157**

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