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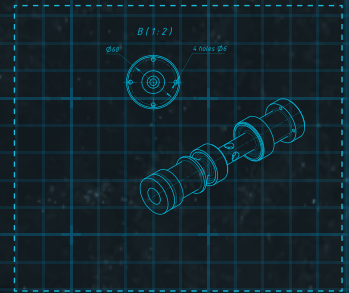
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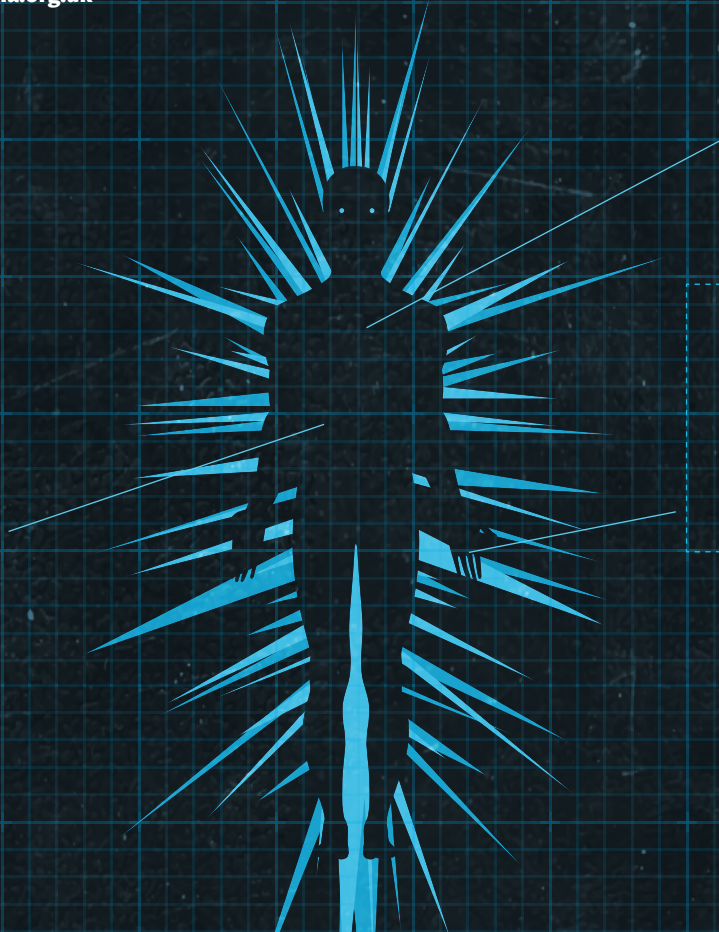
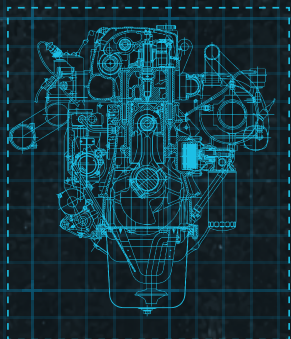
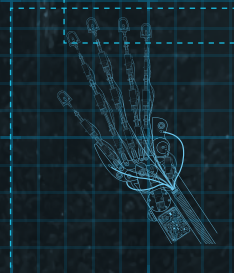
ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

Issue **420** September 2015 itma.org.uk



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OUT OF



THOMSON COMPUMARK PROTECTS 9 OUT OF 10 OF THE WORLD'S MOST VALUABLE BRANDS

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

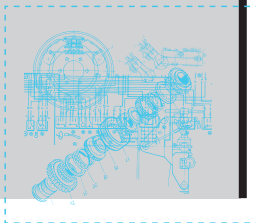
Committee chairs
Executive: Catherine Wolfe,
wolfe.itma@boulton.com
Events: Maggie Ramage,
maggie@ramage.co.uk
Education: Philip Harris,
pharris@st-philips.com
Law & Practice: Imogen Wiseman,
i.wiseman@cleveland-ip.com
Publications & Communications:
 Richard Goddard,
richard.goddard2@uk.bp.com

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 Think, Capital House,
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 Tel: 020 3771 7200
www.thinkpublishing.co.uk
Editor: Caitlin Mackesy Davies
Advertising: Tony Hopkins,
tony.hopkins@thinkpublishing.co.uk
Group Account Director: Polly Arnold
Account Manager: Kieran Paul
Art Editor: Clair Williams
Designer: Alix Thomazi
Senior Sub-editor: Marion Thompson

ITMA Review
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welcome

September 2015



Greetings from my now customary location on page 3 and welcome to the September issue. Summer is officially over, I understand, and we are now into the season of mist and mellow fruitfulness, but those of you who made it to our Summer Reception will have enjoyed an excellent evening at the Little Ship Club by the Thames. We have several photos in this issue.

Our next event is the Autumn Seminar in Birmingham on 23 September 2015. First Vice-President Kate O'Rourke and I look forward to seeing you there.

Elsewhere in this packed issue, we have a timely update on ITMA activities in Scotland, a very important piece on professional ethics and an update on changes to trade mark law in Japan. As we career towards the end of yet another year, I wish you happy reading.

Chris McLeod
ITMA President

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ITMA Insider

CEO bulletin

Highlights from and updates to Keven Bader's July bulletin to members



04

By the time you read this bulletin the sunny summer weather, music festivals and holidays will be over, and we'll be preparing to get more active as the weather cools. For ITMA HQ, however, business has continued at a pretty constant pace.

Here is a summary of some of the projects we have been progressing over recent months.

Royal Charter update

At a meeting of the ITMA Council on 23 June the draft Petition for a Royal Charter, draft Charter and draft by-laws were approved for submission to the Privy Council.

Before submitting these documents we engaged in conversations with other organisations within the legal sector to inform them of our plans and intentions behind applying for chartered status.

We have received various letters of support for our application and recently submitted the draft Petition to the Privy Council Office. These documents are available to view in the members' area of the ITMA website (login is required).

New PR & comms head

We have appointed Richard Hayward as head of PR & Communications. His insight, knowledge and ideas will help us to take a more

coordinated approach. We are delighted to welcome Richard and look forward to improving our communications both internally and externally.

ITMA opportunities

The **Pro Bono Working Group** is looking for new members. The committee is led by our First Vice-President, Kate O'Rourke, and it regularly liaises with the UK IPO, CIPA and IPEC's Judge Hacon in advising on the promotion of pro bono services relating to IP matters in the UK.

The four projects on which the group is working are:

1. Preparation of a list of all currently available pro bono services, including those offered by the IPO, ITMA, CIPA, Law Clinics, the Bar Pro Bono Unit and LawWorks
2. Review of documents prepared by the International Trademark Association to be used in pro bono matters, including letters of engagement and an outline of the benefits of providing pro bono services
3. Review of insurance implications when providing pro bono services
4. Preparation of a list of IP practitioners who are willing to offer pro bono services, and in which fields – for example, advisory only, contentious matters and advocacy.

Facilitating access to justice is an obligation under the Legal Services Act, is strongly encouraged by our Regulator and the IPO, and is guaranteed to give you a warm glow. Please contact me if you are interested in helping Kate and the Pro Bono Working Group.

The **Formal Publications Working Group** is also looking for potential volunteers to assist in an editorial role for the *Community Trade Marks Handbook*.

In addition, the working group is active in the preparation of a number of new publications for the Institute. They need volunteers who can assist with this work and also come up with ideas for future publications.

Facilitating access to justice is an obligation under the Legal Services Act and is guaranteed to give you a warm glow

If you are interested in any of these roles, please contact Mark Hiddleston at mark.hiddleston@hiddlestons.com or on **01959 546212**.

Council strategy meeting

On 15 July the Council of ITMA attended a facilitated meeting to review the current strategic objectives and look into that crystal ball. This is an important meeting to which some of you have contributed ideas, and we hope the gathering will lead to further clarification of the ways ITMA can support its members and the profession in the coming years. ■

Member *moves*



Elkington & Fife is delighted to announce that **Chris McLeod** will be joining the firm as a Partner in September 2015. Chris will be based in the firm's London office and will be contactable by email at chris.mcleod@elkfife.com and by telephone at **+44 (0)20 7936 8800**.



The partners of Kilburn & Strode are pleased to announce the appointment of **Rebecca Davis**, formerly of Mishcon de Reya, as a Senior Associate in their trade mark team. Rebecca may be contacted at rdavis@kilburnstrode.com or on **020 7539 4200**.

Ring the holiday changes

This year our annual London Christmas gathering is moving to a **new day and venue**, as we come together for festive networking at the **London Hilton on Park Lane on Friday 11 December**.

The event will retain its customary format, however, with a pre-lunch drinks reception followed by a traditional three-course meal (including all the trimmings), Christmas puddings and speeches. With some 600 colleagues in attendance, it is the ideal chance to raise your profile, strengthen relationships or simply enjoy festivities with friends.

Find out more at itma.org.uk



SEE YOU AT THE SEMINAR

There are just days to go until our **Autumn Seminar on 23 September**, which will look at **Hot Topics in Industry – The In-house Perspective**.

Register by 16 September to attend the event that will feature talks from leading speakers on developments in the field of IP, as well as great opportunities to network with fellow Trade Mark Attorneys and associates alike. The evening drinks reception, for example, is open to non-delegates, and will enable new visitors and old friends to meet

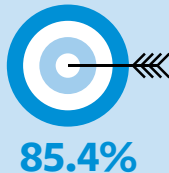
post-sessions to enjoy fine wines, beers and canapés, all of which will round off a great day. There's still time to register at itma.org.uk



UK IPO: Satisfaction stays high

Over the summer, the UK IPO released research on customer satisfaction, which included these highlights:

FIVE-YEAR HIGH With a target of 80% satisfaction set by the Government, the UK IPO achieved more than **85% in 2014/15**, the highest score achieved since it began measuring in this way in 2010/11 and more than 4% higher than 2013/14.



THE 99% Only **1% of customers** expressed dissatisfaction overall, giving a score below 6 out of 10.



SET FAIR **98.5%** of respondents felt that they had been **treated fairly** in their dealings with the IPO.



THE IPO REVIEWS STANDARDS REGULARLY AND SEEKS TO IMPROVE THEM, WITH A BASELINE TARGET TO:



80%

▶ respond to more than **80%** of general **email** enquiries, letters and faxes to our Information Centre **within 1 working day** and more than 95% within 5 working days



80%

▶ answer **80%** of **telephone calls** to its Information Centre **within 20 seconds**

ITMA Summer Reception

Little Ship Club, 8 July 2015

06 | SUMMER RECEPTION



01



02



03



04



05



06



07

01. Members network outside Little Ship Club 02. Rebecca O'Kelly Gillard, Hilary Atherton and Rachel Harrison (all Bird & Bird) 03. Karen Lee (Edwin Coe), Laurie Heizler (Barlow Robbins Solicitors, Guildford), Simon Miles (Edwin Coe), Selina Clifford (Jamie Oliver Group) 04. Duncan Mee, Kate Giannini, Jennifer Eddis, Antonio Grossi, Michael Wakefield (Cerberus Investigations) 05. Jason Aghatise (Charles Russell Speechlys), Harry J Rowe (Squire Patton Boggs), Chris McLeod (ITMA President), Chandni Rani and Mette Marie Sutton (both Collyer Bristow) 06. Charlotte Roe, Roberto Pescador, Josephine Curry (all King & Wood) 07. The view to The Shard and Cannon Street Railway Bridge

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NEWS

FROM UP NORTH

This year's programme of evening seminars in Scotland is now well under way, says Susan Snedden

ITMA Scotland's first 2015 event saw Melanie Martin and Jennifer Marshall from Maclay Murray & Spens' competition law team address the interface between trade mark law and competition law, and provide an overview of how the principles of competition law may affect Trade Mark Attorneys in their day-to-day work.

In particular, the talk looked at parallel trade and exhaustion of trade mark rights in the European Union (EU). These are particularly difficult issues for both competition and trade mark lawyers when they are advising on a brand's route to market.

Readers will be well aware that once goods bearing a trade mark have been put on sale in the EU by the trade mark owner or with its consent, the mark is exhausted and its owner can object to further sales only in very limited circumstances (Trade Mark Directive 2008/95/EC and Council Regulation (EC) No 207/2009). One such circumstance is where an appropriate selective distribution network is in place. A selective distribution system for luxury brands allows the brand owner to control who is authorised to sell its products, as well as setting quality standards and requiring a bricks-and-mortar shop. Sales outside the network may fall into the exhaustion exceptions.

SELECTIVE SCENARIO

For example, in *Copad SA v Christian Dior* (Case C-59/08) the Court of Justice of the EU held that trade mark rights can be asserted when the licensee has resold goods to an unauthorised distributor, despite the

goods already having been placed on the market. To the extent that this damages the allure and prestige of a luxury brand, the licensee will be deemed to be acting without consent and the trade mark will not be exhausted. The underlying selective distribution agreement, which was aimed at protecting the reputation and quality of the brand, was important in this case.

However, selective distribution agreements are enforceable only to the extent that they comply with the relevant provisions of competition law. Restrictions on sales to end users that control the price at which their product is sold or the prevention of sales online are not permissible.

Other distribution models, such as exclusive distribution, may offer less protection and have different implications under competition law.

KEY TOPICS

Among the other key topics were an examination of the pitfalls of the technology transfer block exemption and how competition law seeks to prevent IP owners from abusing positions of market power. In particular, disproportionate and abusive royalties by IP rights owners and refusal to supply or licence their IP rights were discussed. The risks of getting it wrong are serious both for

Trade Mark Attorneys and their clients: licences may be unenforceable. At worst, fines of up to 10 per cent of worldwide turnover can be imposed.

Finally, the speakers noted that online markets and e-commerce are a current area of focus for competition authorities, so brand owners should review their practices to make sure they comply with competition law.

ONGOING EDUCATION

Other events this year have included a presentation on "colour issues" by Simon Malynicz, a barrister with Three New Square, and a Trade Mark Case Update 2015 presented by David Woods and Gillian Anderson of Pinsent Masons. Future plans include:

7 October 2015 John MacKenzie of Shepherd & Wedderburn in Edinburgh, will speak on a recent CJEU case relating to the admissibility of evidence.

29 October 2015 ITMA Scotland will host a drinks reception at the Western Club in Glasgow.

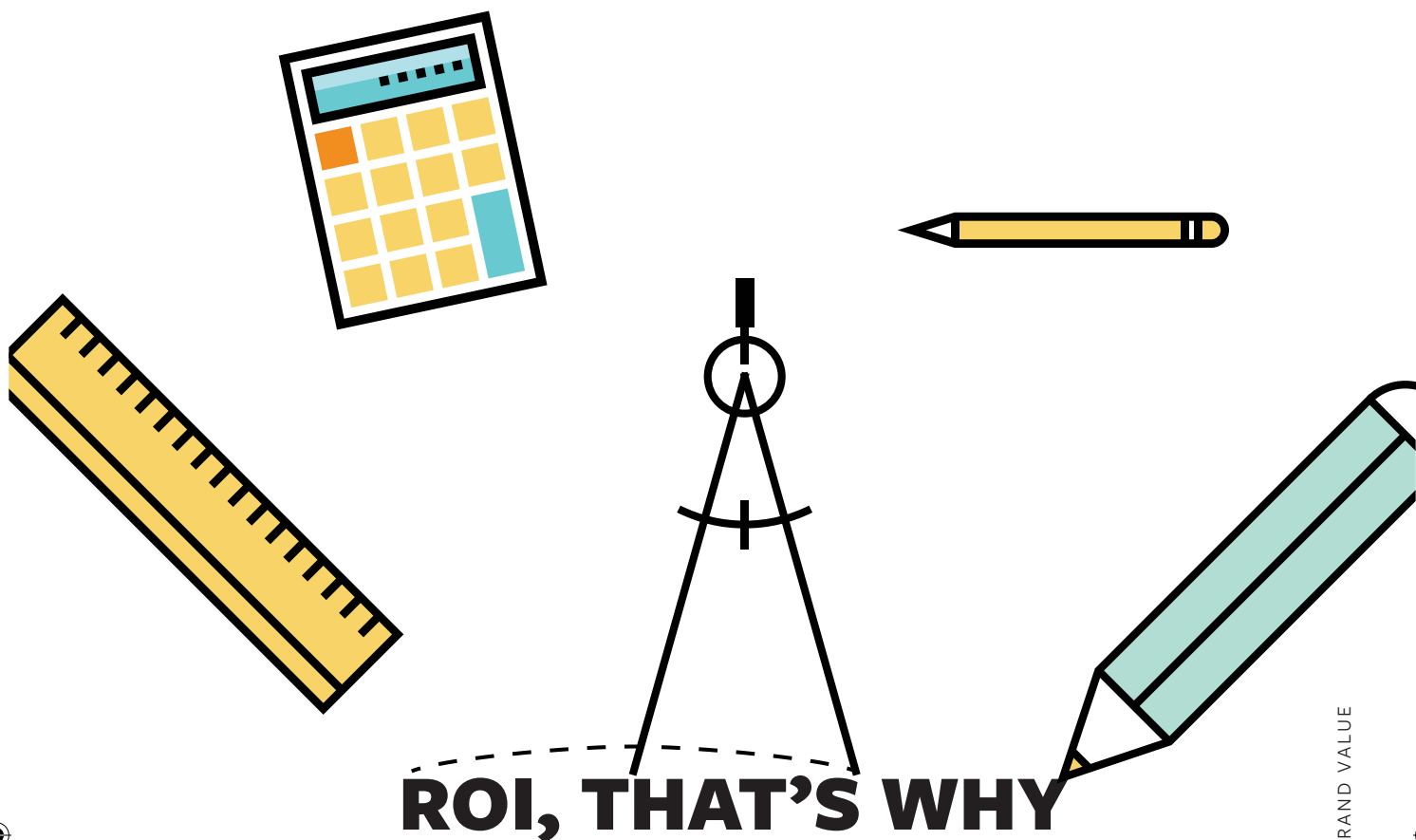
12 November 2015 Mark Caddle of Withers & Rogers will discuss recent OHIM cases, at Brodies in Edinburgh.

Of course, there are also networking opportunities at all ITMA Scotland evening seminars. So to mingle with your fellow Scottish trade mark practitioners, as well as learn, sign up now. ■



Susan Snedden

is Director, IP and Technology, at Maclay Murray & Spens LLP
Susan.Snedden@mms.co.uk



ROI, THAT'S WHY

Tom Farrand outlines the reasons that companies are increasingly asking Trade Mark Attorneys to help assess the worth of their intangibles

We all know brands are important and valuable to a business, but why seek to put an actual value on them? In today's budget-focused boardrooms, Trade Mark Attorneys need to show that the legal rights that protect those brands aren't unnecessary costs, but instead add value to the business. More than that, as your management accountant will tell you, "What gets measured, gets managed."

Brands enable owners to repeatedly charge a premium for what is often the same, or a similar, base product. This applies in all sectors, from computers to coffee, and from painkillers to polo shirts. A pack of Nurofen tablets, for example, will set consumers back 12p per tablet, as opposed to 2p per tablet if they buy a supermarket own-brand ibuprofen equivalent.

It is the brand that entices a customer to pay more and come back for more. The trusted name serves as a reassurance of quality and a shortcut to reading the clinical data or comparing ingredient lists with an own-brand equivalent. This is brand equity.

In the brand valuation process, we are asking: what is that brand equity worth to the business? Or, rather: what is its current worth and can it be further leveraged? Is there more that can be done?

DEFINING THE WHAT

In measuring value, we first define what we are seeking to place a value on. In this context a brand is a marketing-related asset that may include names, terms and logos intended to identify goods, and create distinctive images and associations in the minds of stakeholders, thereby creating economic benefits for the owner. Stakeholders can refer to

consumers, shareholders, investors, media and so on.

How we measure that brand's value depends on the purpose of the valuation. Purpose dictates the premise (or basis), and that, in turn, dictates the method – and different methods produce different results. For example, is the valuation driven by strategic planning, financial reporting, dispute resolution or due diligence? Each of these will result in a different valuation premise and methodology – for instance, the desire to capture market value, as opposed to investment value or liquidation value.

The ISO 10668 was introduced in 2010 to set a "standard" for brand valuation. It covers three categories: legal, behavioural and financial. The first requires there to be an analysis of the strength of legal protection, the second measures stakeholders' attitudes, and the third, financial performance. ▶

BRAND VALUATION EVOLUTION

1988

First notable valuation



Premier Foods, then RHM, turned to valuation as a defensive measure when subject to a hostile takeover bid. It valued Britain's much-loved Hovis brand to show that the takeover offer undervalued the RHM business.

2000

\$1bn securitisation



RHM was, this time, the subject of the first major IP-based securitisation. The company raised more than \$1bn using its brands as security, leading to the issuance of a "brand bond" the following year.

2001

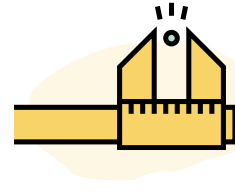
"100 Best Global Brands"



First brand league table published by *Business Week*.

2004

IFRS 3



Introduction of the International Financial Reporting Standard.

Financial performance can be calculated by taking a market-, cost- or income-based approach – such as royalty relief, which looks at how much you could ask a licensee to pay to use your brand. Each of these can result in a slightly (sometimes even wildly) different end calculation. This broadly explains the disparity in results we see in high-profile brand-value rankings such as those produced by Interbrand or Brand Finance. Even within income-based methodology, there are various approaches, so the "standard" has plenty of variety.

Legal protection through trade mark (and other) registrations has touchpoints throughout valuation calculations, no matter which methodology you use; the stronger and better managed that the trade mark portfolio is, the higher the value of the brand may be.

QUESTION OF WHY

Few of us are accountants, so this is not the place for long-winded explanations of brand valuation calculations. For Trade Mark Attorneys involved in valuing brands, the "why" should come before the "how".

Some of the most common reasons for undertaking a valuation exercise include: portfolio disposal or acquisition; preparation for an initial public offering (IPO); transfer pricing; IP licensing; and IP securitisation. Each of these will require a different valuation method, or combination of methods.

But brand valuation is important at any stage of a brand's lifecycle, not just when it comes to a restructuring or sale. Any company needs to see that it is getting a return on investments made, and investing in IP protection is no different to paying for new plant or manufacturing capabilities. It is just more difficult to articulate or quantify.

Of course, investment in protection is only one aspect of outlay in a brand, which could also include, for example, marketing and PR activities to increase awareness. Although a brand valuation will not necessarily prove that the investment in protection is the factor increasing or decreasing brand value, it will always be a factor.

There are instances where a strong brand protection policy has been undermined by bad publicity, which has a negative effect on brand value. Equally, a strong brand can be undermined by an inadequate trade mark protection strategy that prevents the brand owner from, for example, expanding to new countries or new product ranges because someone else owns those rights.

There are also the cases when the value of a company acquisition rested almost entirely with the IP assets being acquired.

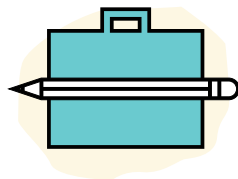
TRADE MARK RATINGS

Intangible assets account for more than half of the total global enterprise value of companies as shown in a study¹ analysing the enterprise value of 56,000 companies listed on more than 100 stock exchanges around the world.

As with many industries, the functional differences between products and services have been narrowed to the point of near invisibility. It is intangible assets, such as brands, that provide the basis for establishing meaningful differences between apparently similar offers.

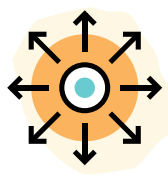
¹ Source: 2014 BrandFinance® Global Intangible Finance Tracker (GIFT™)

2010
ISO 10668



International standard for brand valuation introduced.

2014
League tables



Today, brand valuation league tables are commonplace, and brand valuation has become accepted as an important part of valuing businesses.

Of course, a brand is more than just a trade mark but, without trade mark protection, a brand is potentially worthless. This is why ISO 10668 compliance requires legal analysis to rate the strength and value of the trade mark portfolio that sits behind the brand being valued.

There are numerous methods of analysing the strength of a trade mark portfolio. For valuation purposes, it is important that the method used can be replicated and that an awareness of competitor behaviour is incorporated into the methodology.

Novagraaf provides trade mark ratings for Brand Finance, one of the well-known producers of league tables, as well as an analysis of portfolio strength for its individual brand valuation reports. This is done using a combination of public data, trade mark search tools, and a proprietary methodology and standard “scoring” system that highlights strengths and weaknesses in protection – whether strategic, geographical or product wide. In addition, we make overall recommendations for improvements – generally, areas where companies can act quickly to shore up protection, as well as advice on how to “futureproof” their portfolios.

Many of these “weaknesses” are simply an indication that

the company’s trade mark portfolio has fallen out of step with the reality of its market activity – for example, areas where it has moved into new classes or countries, but overlooked the need to put registrations in place first (or indeed afterwards). We have even seen instances when companies have changed their name after merging with another party, but failed to register trade marks to reflect that. Some require a more detailed follow-up audit to provide further “valuation gap” analysis and advice on remedial actions.

Often, some simple changes to a company’s strategy can significantly improve the rating on the trade mark portfolio, which, in turn, will affect the overall brand value.

Trade marks and associated forms of IP are the one constant in brand creation. A product’s name, the design and colour of its packaging, and the corporate logo are not just marketing tools – they are legal rights that can bring great benefits and growth when nurtured and used properly. Yet they

A strong, well-managed registration portfolio has a direct influence on brand value, and therefore business value

can often be overlooked in the rush to market, or simply considered a drain on resources – an outgoing cost to the business that seems to bring in little return.

That is why it is important for us as an industry to showcase the contribution made by trade mark assets to brand strength. We all know that a strong, well-managed registration portfolio has a direct influence on brand value, and therefore business value. Valuation of that asset can also unlock its true worth, and show that the right trade mark registration strategy is an investment, not just a cost. ■



Tom Farrand

is Managing Director, Trademarks, UK, at Novagraaf
tom.farrand@novagraaf.com

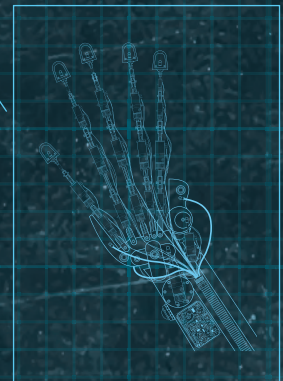
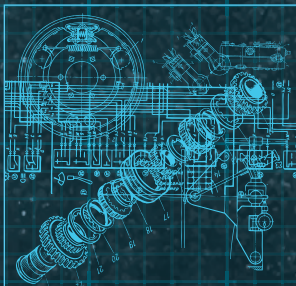
THE ETHICS IMPERATIVE

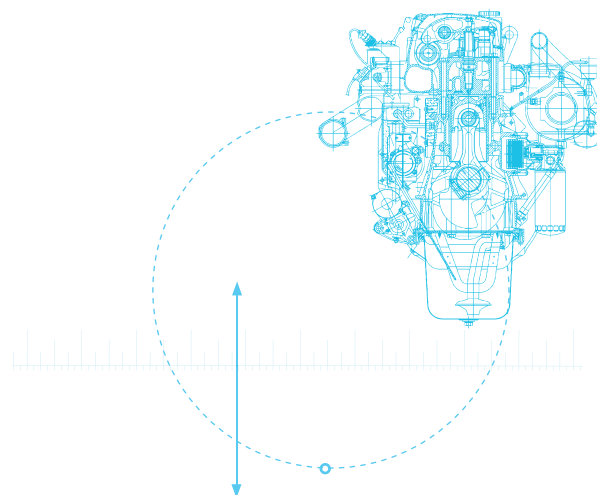
DR MICHAEL JEWESS DISCUSSES THE COMMON PRINCIPLES OF PRACTICE TO WHICH THE PROFESSION MUST PAY HEED

LAW 1 – YOU MUST UPHOLD THE RULE OF LAW, ACT WITH INTEGRITY TOWARDS ALL, AND PRESERVE YOUR INDEPENDENCE.

LAW 2 – YOU MUST ACT IN THE BEST INTERESTS OF THE CLIENT, OFFERING A GOOD STANDARD OF SERVICE, WITHIN THE CONSTRAINTS OF RULE 1.

LAW 3 – YOU ARE ENTITLED TO BE PAID FOR YOUR SERVICES, WITHIN THE CONSTRAINTS OF RULES 1 AND 2.





Most readers of this publication will be subject to one or more sets of ethical rules: UK Trade Mark or Patent Attorneys to the Rules of Conduct of the Intellectual Property Regulation Board (IPReg), with Special Rules for litigators; English and Welsh solicitors to the Principles and Code of Conduct of the Solicitors Regulation Authority (SRA); European Patent Attorneys to the Administrative Council's Regulation and the European Patent Institute's Code of Conduct; and so on.¹

Breach of ethical rules can lead to removal from the respective registers or lists, with loss of personal status and loss to the client of privilege² in its communications with you. Some ethical obligations duplicate criminal legislation.

The above regulatory documents are structured in quite different ways. Yet, fortunately (especially for readers subject to more than one regulator), the most fundamental ethical obligations are common to them all.

And some apparent differences arise simply because one regulator may leave implicit what another states explicitly. (Thus, IPReg, *Rules of Conduct*, Rule 5 requires the practitioner to act "with integrity", with accompanying guidance to practise "honestly", while the Administrative Council Regulation, Article 1(1) addresses truthfulness explicitly: "He shall not knowingly make a false or misleading statement." But no one should doubt that IPReg would take a dim view of fibbing in the course of legal practice!)

Rule 1 limits what the client can expect of the practitioner and the ways in which the practitioner is entitled to earn a living

Another common feature is that some obligations take precedence over others. This commonality allows a discussion of the most fundamental obligations (the "big issues") without detailed textual analysis of any particular set of rules.

THE BIG ISSUES

Indeed, a helpful conceit is to compare legal practitioners with robots, as envisaged in the stories of author and academic Isaac Asimov. Asimov depicts a future in which humanity is served by robots of high intelligence. To prevent these robots from taking over from, or destroying, humanity – or being used by one human against others – they are programmed with the three "Laws of Robotics":³

- "1. A robot may not injure a human being, or, through inaction, cause a human being to come to harm.
- "2. A robot must obey the orders given to it by human beings except where such orders would conflict with the First Law.
- "3. A robot must protect its own existence as long as such protection does not conflict with the First or Second Law."

The counterpart for legal practitioners, with a little licence, is as follows:

1. You must uphold the rule of law, act with integrity towards all, and preserve your independence.
2. You must act in the best interests of the client, offering a good standard of service, within the constraints of Rule 1.
3. You are entitled to be paid for your services, within the constraints of Rules 1 and 2.

Rule 2 clearly benefits the client, allowing him to complain if you, the practitioner, proceed ineffectively or unnecessarily expensively. Rule 1 is in the client's interests in that it demands integrity in your dealings with him.

But in general, Rule 1 limits what the client can expect of the practitioner and the ways in which the practitioner is entitled to earn a living. Some things the client might ▶

¹) The author's detailed bibliography supporting this article is at <http://www.researchinip.com/itmaethics.htm>

²) Michael Jewess, *ITMA Review*, October/November 2014, 413, 6-9.

³) Isaac Asimov, *I, Robot* (Gnome Press, 1950, now a HarperCollins Voyager Classic). These laws were admirably crafted, but had enough ambiguity to support ingenious stories.



want a trade mark practitioner to do, but which he should not, are:

- i) Misleading any third party as to the status of a client's right. An extreme instance would be misleading a potential opponent on the last date for a hostile action against the client's trade mark.
- ii) In merger and acquisition (M&A) work, misleading the purchaser about infringement risks being run by the business that the client is selling. Note that this is not the same as your client giving a contractual warranty of non-infringement to the other party - that merely entitles the other party to compensation from the client if an infringement action is subsequently brought against the business it has acquired.
- iii) Misleading a Court or Trade Mark Office. This might be when complying with obligations of discovery ("disclosure" in England and Wales), or when asserting use of a trade mark.
- iv) Supporting the IP aspects of work that breaches law on competition, bribery and corruption, health and safety, or money-laundering, or which helps organised crime.
- v) "Taking advantage" of the ignorance of a person on the other side who has no legal adviser. Of course, if the other side does have a legal adviser, you should in general communicate exclusively via that adviser.

Note that in the UK at least, being in-house does not relieve a practitioner of obligations in such fundamental respects as these (or in respect of conflict, dealt with separately below). Apart from matters such as complaints-handling and professional indemnity insurance, the in-house practitioner has the same key obligations as one working in private practice. A superseded version of the SRA Code dealt with this in a particularly bracing way that

It would be a foolish employer who dismissed an in-house legal practitioner for proper assertion of his professional obligations

the author still commends to all UK in-house practitioners:

"In situations where you are asked [by your employer] to act contrary to your professional obligations then you should not compromise your position and you must refuse to carry out instructions which would have this result, even if ultimately this led to the loss of your job."

In fact, it would be a foolish employer who dismissed an in-house legal practitioner for proper assertion of his professional obligations, because the employer would risk an action for unfair dismissal and thereby the public revelation of its improper instructions.

In the author's extensive experience of in-house work, legal practitioners are "licensed" like "Shakespearean fools": the fool's own occasional, considered assertion of ethical obligations is respected, not punished.

The private practitioner is at least as vulnerable as the in-house practitioner to client pressure, for if he refuses to act on the client's instructions, the client might take away from the practitioner not only the task in question but other work too - and with impunity because there would be no possibility of redress under employment law. But in-house or in private practice,

pressure from the client to do bad things must be resisted.

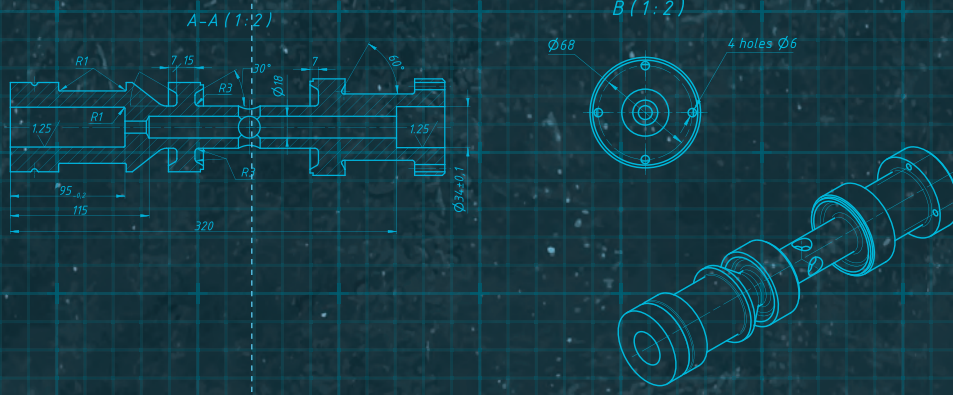
CONFLICT

As a matter of integrity, you the practitioner must not favour your own interests over your client's, or one client's over another's. In addition you must behave openly so as not to give rise to a suspicion that you have done so.

Conflict between practitioner and client

Very direct conflict of interest between the client and the practitioner is rare because most practitioners are too busy lawyering to get involved directly in other businesses that are in the same sector as client businesses. However, if the practitioner *is* so involved, extreme caution is needed: even consent from the client will not resolve the conflict. And grey areas need to be considered, such as spouses' interests and your business links with foreign associates or renewal agents whose services you may be recommending to clients.

Conflict can also be created by inappropriate financial arrangements between practitioners and clients. For instance, an in-house practitioner with an annual objective of completing a particular outward trade mark licensing deal by the end of the year - and therefore whose salary or



bonus depends on the deal – has a conflict with his client. Any outward licence deal, as well as bringing the client money, has “downsides”, namely restriction of the client’s future commercial freedom and contractual liability. So, if the practitioner is keen to get the deal done because he will benefit personally, then he is in a poor position to advise objectively on these downsides. As an in-house head of IP, the author resisted having such objectives imposed on him or his people. In private practice, a conditional or contingency fee structure can create similar conflict; although in litigation in England and Wales compliance with the Damages-Based Agreements Regulations 2013 should avoid problems.

Accepting equity in a start-up in lieu of payment would not only create potential conflict between practitioner and client, but would also compromise independence and be a correspondingly more serious ethical breach.

Conflict between clients

A UK Trade Mark Attorney litigator cannot act on both sides of a litigation, even if the clients are silly enough to consent.

For non-court work – filing, prosecuting, negotiating, drafting, and giving opinions – consent may allow a practice to work for a new client whose interests may conflict with a present client. In this case, the two clients frequently require a “Chinese wall”. However, the longevity of IP rights creates conflicts of a sort most other lawyers do not face. Consider the market

convergence of two long-standing clients of a private practice: one client might expand into pet hospitals from human and animal food products (as Mars did in 2007), and expose itself to a risk of infringing trade marks of an existing healthcare client.

Also consider conflict between present and former clients. Suppose a practice is asked to argue against the scope or validity of a trade mark the application for which it previously filed for a now-departed client. (The departed client might be suing the current client for infringement, or licensing the mark to the current client, or indeed selling the relevant business to it so that the practitioner would be expected to perform due diligence.) Absent client consent, the practice should not do the work, even if it is not in possession of possibly relevant confidential information of the former client.

There is a problem for individual practitioners when they move jobs in that they may be asked to argue against a trade mark for which they filed the application in a previous job. Absent consent, the practitioner should insist on not being involved in the work at all.

Joint ventures or disposals

When a client creates a joint venture or disposes of a business, IP filing and

prosecution practitioners are in a special situation as far as conflict is concerned; readers affected are referred to the author’s work cited at the end of this article.

CLIENT CARE AND SERVICE

Client care and service

(conscientiousness, reporting, billing etc) is hopefully imbibed with “mother’s milk” in all legal practices. A distinctive feature of trade mark practice (as of patent practice) is the frequency with which the practitioner has to deliver bad news to the client. Suppose one does a clearance search for a mark that the client desperately wishes to use and discovers that it is unsafe (especially likely nowadays because of trade mark cluttering in Europe). It is tempting to avoid driving the client away by not forcefully suggesting the devising and clearance of new marks, and to leave him to make a “commercial decision”; but is this giving him the objective advice on his options which he deserves? ■

For a full discussion of this topic, see Chapters 1, 2, and 8 of the author’s Inside Intellectual Property – Best Practice in IP Law, Management, and Strategy (<http://www.researchinip.com/iip.html>).



Dr Michael Jewess

is a Chartered Patent Attorney, European Patent Attorney and European Trade Mark Attorney with extensive senior experience.

michaeljewess@researchinip.com

Michael lectures and writes on IP subjects.

HOT TOPIC

Sophie Davies explains why US brand owners face potential battles as diplomatic relations with Cuba begin to thaw

President Obama's December 2014 announcement that diplomatic relations between the US and Cuba will be restored after more than 50 years of isolation and enmity reignited the interest of many US brand owners in the Cuban market.

These stateside brand owners consequently sought to review their local trade mark portfolios and examine the extent of any IP rights in the country. At the same time, a number of Cuban individuals also tried to exploit the situation by filing local trade mark applications for

famous US brands. Due to Cuba's "first-to-file" system and the fact that prior use of a mark is not required in order to obtain a registration, if successfully registered, these "bad faith" applications could be very damaging to US companies seeking to enter or re-enter the market after so many years and secure desirable IP protection.

LAW AND PRACTICE

While some Caribbean countries remain stuck with outdated trade mark laws, Cuba (perhaps surprisingly for a Communist country) has managed to keep its trade mark law in line with common international standards. For example, it is a signatory to a number of international trade mark conventions, including the Paris Convention, Madrid Agreement and Protocol, Nice Agreement and Berne Convention.

Although for a short time in 1994, US regulations restricted payments from the US to register, maintain or protect IP rights in Cuba, on the whole, the status quo during the embargo was that intellectual property-related payments from US entities, attorneys and/or other individuals to their Cuban counterparts were authorised by the Office of Foreign Assets Control (OFAC) of the US Department of the Treasury under General Licence. This has been particularly important for well-established US brand owners who conducted business in Cuba before the embargo and wanted to keep their registrations alive in the event that the embargo would one day end.

A trade mark can be registered in Cuba pursuant to the Trade Mark and other Distinctive Signs Decree Law No 203 of 1999 and the Denominations of Origin Law No 228 of 2002, which provide for local trade



MARCIN KRZYŻAK AND KAMIRAJA/SHUTTERSTOCK.COM



mark applications. The following information is traditionally required:

- name of the trade mark
- one copy of the mark (unless the mark is word only)
- class(es) and specification of goods and/or services in accordance with Nice Classification
- applicant's name and address
- Power of Attorney
- certified copy of priority document (if priority is claimed)

An alternative to the national registration route is via the Madrid Protocol. The owner of a basic application or registration in another Madrid country (such as the US) can apply for an International Registration designating Cuba. This is sometimes the most cost-effective route for brand owners with a strong basic registration, wanting to roll out filings

A number of Cuban individuals also tried to exploit the situation by filing local trade mark applications for famous US brands

in a large number of countries in unison. Specifications drafted in accordance with the 2015 version of the tenth edition of the Nice Classification should not result in any Office actions in Cuba.

It usually takes about 18 months for the General Director of the Office of Intellectual Property in the Ministry of Science, Technology and the Environment to process a national Cuban application. The examination time frame under the Madrid Protocol is similar. As part of the examination process, the Cuban application is screened against any prior conflicting applications and/or registrations and, if necessary, a preliminary refusal issued. It is possible to overcome a preliminary refusal at the discretion of the General Director if, for example, a valid coexistence agreement between the interested parties exists.

After the examination stage, a Cuban application will be published for a 60-day period for opposition purposes by persons or entities holding a prior right that would be affected if the third-party application in question were to be granted. It is open to question whether US entities or individuals who do not own any registered or unregistered trade mark rights in Cuba qualify as an "affected party". If it can be demonstrated that a US entity is the owner of a well-known mark in Cuba as per Article 6bis of the Paris Convention (which may in itself be difficult to demonstrate given the lack of trade and, more often than not, reputation, in the country over such a long period), the US entity may be deemed an affected party under the Office of

Intellectual Property's relatively recently revised policy. However, the policy itself remains ahead of the Cuban legislation, which is yet to be updated in this regard.

Absent objection or opposition, a Cuban trade mark will pass through to registration and remain valid for 10 years from the date of filing, after which it can be renewed for like periods.

SEVERAL CHALLENGES

There are three main camps of US brand owners with an interest in Cuba, each of which may face various challenges moving forward.

In the first camp are the US brand owners who entered the Cuban market and obtained trade mark registrations before the embargo. While those brand owners have trade mark registrations in place (assuming they have kept up to date with the renewal fees), given that Cuban trade mark registrations become vulnerable on grounds of non-use three years after the date of registration, the registrations are vulnerable. Therefore, it is advisable for such brand owners to apply to re-register their marks in Cuba right away, to avoid losing any revocation proceedings invoked by a particularly cunning trade mark hijacker who simultaneously applies to register the mark he has sought to revoke. It should be noted that the embargo is not considered as a proper reason for non-use under Cuban law.

The second camp is comprised of the US brand owners who, due to the normalisation of relations between Cuba and the US in recent times, may



be able to export particular products to Cuba under a general licence, licence exception or recent change in licensing policy. Some of the relevant products falling under this category are certain: agricultural commodities, medicine and drugs, medical devices, building materials, and tools and equipment for private sector agricultural activity. Brand owners producing such products should look to obtain Cuban trade mark protection as soon as possible in order to protect their position before they start using their brand locally.

In the final camp are the owners of well-known US brands, some of which may be so young that they were not registered or used in Cuba prior to the embargo. One individual, Gustavo Alejandro Fuentes Ledo, has so far sought to register around 70 Cuban registrations in bad faith. Mr Fuentes Ledo has been particularly brazen in his choice of marks, which includes Royal Caribbean International, Capital One, Chase, NFL, OfficeMax, Denny's, Nordstrom and JetBlue, to name but a few. Interestingly, in a number of cases he has chosen to register his marks in device, rather than word, form. This is a positive for the brand owners who often own copyright protection in the devices, which can be asserted against the respective applications in opposition/invalidity proceedings.

As mentioned above, despite the fact that these US brands may be "well known" outside of Cuba through use, they may not have obtained a reputation in Cuba significant enough for the brand owners to benefit from Article 6bis protection. Despite this, in the case of Mr Fuentes Ledo at least,

it is possible that the General Director will take into account that this individual currently resides in the US and has travelled extensively, and, as such, cannot be said to be unaware of famous US brands.

Another potential cause of action against bad faith filings may exist under Article 7 of the General Inter-American Convention for Trade Mark and Commercial Protection (Washington 1929) of which both Cuba and the US are signatories. This Article provides protection where the bad faith applicant was aware of the US brand owner's earlier use of the mark in another contracting state. However, it is yet to be seen whether the protection offered under this Convention will be recognised and upheld in Cuba. Even if it is, US brand owners will need to collect and submit the relevant evidence that the bad faith applicant had the requisite knowledge before or on the filing of the application.

SENSIBLE STEPS

Opposition and invalidity proceedings in Cuba can be lengthy, costly (all evidence should be submitted in Spanish) and unpredictable. If a US brand owner has any interest in Cuba, it should seriously consider filing a defensive trade mark application immediately, rather than risk facing

Opposition and invalidity proceedings in Cuba can be lengthy, costly and unpredictable

the brunt of opposition/invalidity costs. Where opposition and invalidity proceedings cannot be avoided, fresh applications should be filed simultaneously in order to protect the brand owner's position pending the outcome of those proceedings. Another option is to seek to pay off the bad faith applicant and have the mark assigned. This depends on the value of the brand and the amount requested.

Also, given that it generally takes 12 months for the Cuban Office to process an assignment application, this may delay any use of the mark in Cuba that is dependent on a valid registration. Finally, it is also prudent for US entities to consider whether they have adequate copyright and patent protection in Cuba. ■



Sophie Davies

is an Attorney at HSM IP Ltd, Cayman Islands
sdavies@hsmoffice.com

A WEB ALTERNATIVE

Justin Bukspan explains the basics of a new project aiming to open up the internet

Have you heard of Frogans? Its creators claim it is “the next major change for the internet”. They believe that the World Wide Web has grown too complex and less open than originally intended and are launching Frogans as an alternative way of sharing information over the internet. It aims to help users and developers escape from the “closed and virtually unavoidable ecosystems” created by the tech giants.¹ Frogans promises to provide a stable, secure, easy-to-use system, available free of charge and able to work side by side with the established World Wide Web.

HOW IT WORKS

A Frogans site appears as a small window on a user’s computer. Its shape and contents are determined by the developer, and users navigate from page to page as they might view a set of slides. That site will look identical regardless of the internet-connected device on which it is viewed, whether a desktop computer, tablet or smartphone. To visit the site, one needs to download a free Frogans Player, analogous to a web browser.

Essentially, Frogans is an alternative software layer for the internet alongside email and the World Wide Web. While those two use the familiar @ and a dot respectively, Frogans employs an asterisk in its address naming structure as follows: network*site. Publishers can register their own dedicated network, or opt to use a generic Frogans network if they are only interested in having one site.

The system accepts a variety of alphabets and Chinese characters and works with 179 languages. Links to a regular web address can be inserted into a Frogans site, ensuring that both technologies work side by side.

SUPPORTING FRAMEWORK

The project was initiated by the French start-up STG Interactive SA in 1999. However, in 2012 it transferred all its rights to Frogans to the non-profit “OP3FT” (Organisation for the Promotion, Protection and Progress of Frogans Technology) to ringfence the technology and its stewardship from commercial pressures.²

In return, STG Interactive now manages all Frogans addresses (the Frogans Core Registry) under licence from the OP3FT, together with a dispute resolution mechanism that is very similar to the Uniform Domain-Name Dispute-Resolution Policy (UDRP) of ICANN (Internet Corporation for Assigned Domain Names and Numbers).

A phone call to the OP3FT revealed that “Frogans” was a made-up word created to be pronounceable in many languages and easy to register.

That non-profit entered into a registry agreement with ICANN under which the former operates the .frogans top-level domain (TLD)³,

providing a formal bridge with the World Wide Web.

IP IMPLICATIONS

Frogans has not yet gained much traction, and its current gradual launch has probably been eclipsed by the ongoing expansion of the TLDs. Excitement in that new technology might have also been dampened by its long development period.

Nevertheless, it is potentially much more affordable than a “regular” website and it aims to bring a wide range of benefits. Thus, the adoption of Frogans by companies and individuals may increase as awareness grows and brand owners identify opportunities to use it to support their online presence and broader businesses. For the immediate future, the possibility of cybersquatting may provide a compelling reason for clients to sign up, especially since registration opened to entrepreneurs in June. Find out more at frogans.org. ■

¹ http://lentreprise.lexpress.fr/internet-autrement-les-projets-un-peu-fous-ou-tres-serieux-de-start-up-francaises_1528411.html (in French, quote translated by the author)

² <https://www.youtube.com/watch?v=4E0Bz1ZclOQ>; <https://www.op3ft.org/en/resources/ar/op3ft-ar-2012-en.pdf>

³ <https://www.icann.org/resources/agreement/frogans-2013-12-19-en>



Justin Bukspan

is a member of the Domain Name Working Group of ITMA’s Law and Practice Committee.



The case for coverage

*Ian Wishart reveals
why rights holders
may want to
reconsider the
usefulness of
IP insurance*



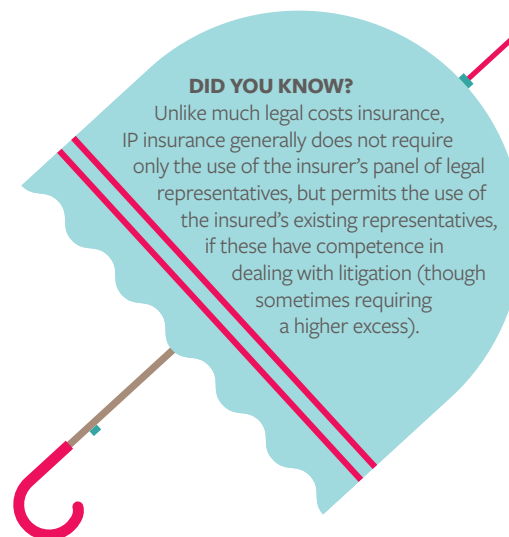
Recent developments in IP insurance have challenged the view held by some Trade Mark Attorneys that IP insurance is expensive and often not much use. Principal among these is the fact that insurers (Lloyd's syndicates and the London Market) and brokers are better informed and educated about IP, and new policies have been developed that better meet the needs of IP owners, especially SMEs (small and medium-sized enterprises). In July, the UK IPO held a conference on the subject, reflecting the Government's positive view of such insurance.

PROTECTION BASICS

In discussing the subject, we should start with some basics. First, it must be acknowledged that insurance

companies exist to make money, and not as a charitable service to the public. While there is a principle that premiums should be fair to both insurer and insured, this is easier in areas of insurance where there are a lot of similar risks. For motor insurance, for example, there are many thousands of identical cars on the road, and the insurer can build up a "pool" of premiums from drivers who do not require compensation on which it can draw for the driver who does make a claim. By contrast, no IP risks are identical. In addition, IP insurance providers have not yet built up premium pools of much size. This means that the insurers tend to be cautious in establishing a fair premium rate for any risk.

Traditional IP insurance covers the legal expenses of pursuing an infringer or defending against an



DID YOU KNOW?

Unlike much legal costs insurance, IP insurance generally does not require only the use of the insurer's panel of legal representatives, but permits the use of the insured's existing representatives, if these have competence in dealing with litigation (though sometimes requiring a higher excess).

An attack on an important brand may involve not only legal costs insurance – to pursue an infringer – but also cyber insurance

action for infringement. Some insurers, but not all, will, for an additional premium, also include damages cover. Such insurance is quite easy to understand, and may be compared to health insurance. If there is an existing infringement situation at the time insurance is purchased, an insurer will exclude any costs related to that situation.

And premiums will vary according to the territory (coverage in the US, in particular, is more expensive because of the frequency and cost of actions), the limit of costs covered, the type of IP and IP landscape around it, and the client's turnover.

The cheapest policy known to the writer covers pursuit costs of up to £100,000 for a single trade mark (with an excess of only £1,000), pursued in the Intellectual Property Enterprise Court (IPEC), assuming the prospect of success is 60 per cent or more, and a reasonable IP situation. The cost is £1,072, plus six per cent Insurance Premium Tax (the insurer is Cigna).

QBE Insurance offers pursuit and defence cover for IP owners at an affordable premium, dependent on risk, which is suitable for SMEs. Bearing in mind that studies have shown that intangibles comprise 70 to 80 per cent of the value of many SMEs, it can certainly be argued that insuring IP is at least as important as insuring a business's physical property against fire or theft and – bearing in mind the examples discussed – can be done at a lower cost.

Even conventional legal costs insurance has additional uses. Insurers may permit the client to publicise the fact that it has insurance, as this may deter some of the firms that might respond to an accusation of infringement by an SME by, in effect, saying, "So what are you going to do about it?" IP insurance cover can be mentioned in a cease-and-desist letter. It has also helped in refinancing discussions by providing improved financial security, and an additional check on the existence and strength of the IP.

INDUSTRY INNOVATION

The insurance industry has been active in trying to meet the ever-increasing risks to companies. For example, an attack on an important brand may involve not only legal costs insurance – to pursue an infringer – but also cyber insurance (at present, more common in the US) to fund the rebuilding of websites, the costs of employing PR specialists, and generally the costs of recovering the situation. A development that addresses this is "reputational risk" insurance, to mitigate the very considerable financial damage that can follow an attack on a brand's or a company's reputation.

In another example of industry innovation, the leading organisation for designers in the UK, ACID (Anti Copying in Design), has recently introduced a product for its members, called "ACID IP Insured". For registered designs, and those unregistered designs recorded on the ACID database by their creators, the policy provides up to £100,000 of cover for actions taken in IPEC, for only £899 a year.

In addition to these quite specialist products, more directly financial policies are available. Although it is not permissible to insure the value of IP such as a trade mark, where a clear income stream can be attributed to IP such as a brand, that income stream can be insured ▶



There is now an argument that even large companies should consider transferring the risk of a “catastrophe-sized” legal action to an insurer

so that loss to the income – for example, as a result of third-party action – will be indemnified.

While IP insurance tends to be purchased by smaller SMEs, including one-person start-ups and micro-businesses, there is now an argument that even large companies (that have long “self-insured”) should consider transferring the risk of a “catastrophe-sized” legal action to an insurer. Insurance can cover legal and other costs, such as damages above a level of cost that the company is prepared to accept (up to a limit, of course). Depending on a company’s structure, the IP involved may be owned by or held for the benefit of a business unit that is less able to carry the cost of major litigation than the parent company.

As mentioned above, IP insurance is primarily “before the event” (BTE), in that the client must declare when contracting for a policy that it is not aware of a situation that could give rise to a claim. If that does not apply, however, and the case is a good one, it may be possible to arrange litigation funding. Generally, however, in IP cases it is often more important to obtain an injunction than damages, so a litigation funder needs to be able to see how it will recover its costs.

There is also “after the event” (ATE) cover, which is intended to protect against costs awarded against the loser in an action, although for IP cases the cost can be high. This cover is a bit of a gamble for the ATE insurer because, after the Jackson reforms, the cost cannot be allocated as a cost to be paid by the other side

if you win. As mentioned, in many IP cases, damages may not be very large, and in normal commercial litigation the ATE insurer recovers the cost of the cover from damages. All this means that BTE insurance is recommended!

COURT COSTS

In recent months, prompting considerable outcry from lawyers, the Ministry of Justice has announced some quite significant increases in court costs. Even in IPEC, intended to be a quick, simple and low-cost forum, the increase seems dramatic. The new system calculates court fees as five per cent of the value of the claim, and it seems that the intention may be to make a profit to be fed back to the Exchequer.

This just adds to the cost of bringing an IP action in the courts, and gives comfort to those intending to “try it on”. If the value of the claim is £10,000, the fees show a modest rise from £455 to £500, but at a value of £200,000 the rise is from £1,515 to £10,000. There is clearly a strain between this reality and the idea of “access to justice”.

For the rights owner, IP specialist barrister Jane Lambert gives plenty

WARNING SIGN

The ACID IP Insured scheme, launched in February 2015, incorporates a vivid logo, which when used in correspondence or stationery provides a proactive deterrent to would-be infringers.

As Rosa Wilkinson, Director of Innovation, UK IPO commented on the ACID website, the use of such a logo “sends a powerful message that the rights holder is not to be trifled with”.



of good advice on her blog, including: “Consider before-the-event insurance and let the insurer worry about court fees.”

Finally, both Trade Mark Attorneys and Patent Attorneys should be mindful of the existence of IP insurance – particularly if the client is a sole trader or SME that could not afford to enforce its IP rights – when applying to register those rights. If insurance is applied for at the application stage, a discount can generally be negotiated because the client does not yet have the ability to enforce its rights. ■



Ian Wishart

is Director of Sybaris Legal & IP. Ian has served on CIPA’s trade mark committee and initiated CIPA’s pro bono programme. Sybaris Legal & IP was involved in developing ACID IP Insured.



EVIDENCE AND THE IPO

Amanda Michaels recaps the eight key points of her online ITMA briefing on use of evidence in inter partes proceedings

Many *inter partes* cases turn on the quality and relevance of the evidence. In a perfect world, clients would always produce clear, relevant and probative evidence in plenty of time for it to be presented in a logical and compelling form. As that may not happen, it is useful to keep in mind these general points:

- **Be clear about your objectives.** Determine the points and facts you need to prove. For instance, it may be necessary to produce evidence of the similarity between particular goods/services, unless they are consumer goods/services with which the Tribunal will be familiar. It is common for evidence to relate to goods/services for which there has already been use, ignoring the rest of a wider specification. Where bad faith is alleged, evidence will be needed to displace the presumption that someone acted in good faith (Hotel Cipriani [2009] RPC 9) or to permit proper inferences to be drawn (Ian Adam [2011] FSR 21).
- **The challenge of confusion.** A likelihood of confusion is hard to prove. Instances of unprompted confusion are rare, and the views of individuals may not represent those of the relevant public as a whole or show “real world confusion”. Post Interflora, surveys to establish the likelihood of confusion are unlikely to be allowed and permission is needed to rely on one.
- **Justifying surveys.** Surveys to show distinctiveness or reputation may be permitted, but this will be the case only if the (usually high) cost can be justified.

- **Look critically at your documents.** Consider whether a witness needs to explain what they are, their relevance or how they relate to the relevant date.
- **Distinguish between evidence and submissions.** (See Killer Chorus O/431/12.) And between evidence and assertion. In the UK, a witness statement from someone with knowledge of the relevant facts is not a bare assertion (Extreme [2008] RPC 2) and, if unchallenged, carries weight. Contrast this with the need in OHIM to corroborate such evidence by independent evidence and documents (Case T-308/06, Buffalo Milke Automotive).
- **Flag up a challenge.** A challenge to a witness’s evidence in UK IPO proceedings must be done ahead of a hearing (Extreme, and Tribunal Practice Note 5/2007). Any request for cross-examination must be justified and the points to be addressed – but not the questions – identified. Challenging a witness is not the same as pointing out lacunae in the other side’s evidence, such as a lack of documents proving genuine use of a mark.
- **Get it right first time.** A trial or trade mark hearing is not a “dress rehearsal” but “the first and last night of the show” (Lord Justice Lewison in Fage v Chobani [2014] EWCA Civ 5) and an appeal is not a rehearing but a review, so

additional/fresh evidence will rarely be admitted (see the tests in Ladd v Marshall applied in Dupont [2004] FSR 15). If the Hearing Officer has identified holes in your evidence, it is extremely difficult to plug them with evidence that was always available to you. If evidence comes to light after the hearing but before the first instance decision is handed down, an application should be made to admit it straight away. At the appeal stage, it should be filed with the Grounds of Appeal and the basis of the application should be set out in an accompanying witness statement – this should address the Ladd v Marshall criteria. The difficulty in adducing additional/fresh evidence on appeal reinforces the need to analyse with care what your client needs to prove its case or refute the other side’s case.

- **Take notice of Tribunal Practice Notes.** For example, the guidance in Tribunal Practice Note (TPN) 1/2015 points out why it is inappropriate to file evidence dated after the relevant date, unless it can be explained how it sheds light on the factual position at the relevant date. The TPN also limits the volume of evidence, so parties may have to apply greater quality control – another reason to push your client to provide you with documents in good time. ■



Amanda Michaels

is a Barrister in private practice at Hogarth Chambers
amichaels@hogarthchambers.com



A BREAK WITH TRADITION

Nami Togawa heralds recent changes to trade mark law in Japan







Effective from 1 April 2015, the Japanese Trademark Law, first enacted nearly 60 years ago, was amended. One of the key points in the revised Trademark Law is to introduce non-traditional trade marks such as colour per se, sounds, motion, holograms and position.

Crucially, under the revised Trademark Law, the definition of a trade mark was changed.

Specifically, Article 2.1, which stated “a ‘Trademark’ in this Act means any character(s), figure(s), sign(s) or three-dimensional shape(s), or any combination thereof, or any combination thereof with colors (hereinafter referred to as a ‘mark’)...” was revised to: “‘trademark’ in this Act means any character(s), figure(s), sign(s), three-dimensional shape(s), color(s), any combination thereof, sound(s), and other mark(s) specified by a Cabinet Order which allow recognition by human sensory perception (hereinafter referred to as a ‘mark’)...”



FIG 1: EXAMPLES OF PROTECTABLE NON-TRADITIONAL MARKS

SOUND	COLOUR PER SE	HOLOGRAM	POSITION	MOTION
<p>Hisamitsu Pharmaceutical Co Inc</p> <p>(words sung to the tune represented)</p>  <p>CTM Reg 2529618</p>	<p>7-Eleven Inc</p>  <p>AU Reg 749403</p> <p>Mars UK Limited</p>  <p>CTM Reg 3793361</p>	<p>American Express Company</p>  <p>US Reg 3045251</p>	<p>Christian Louboutin</p>  <p>US Reg 3361597</p>	<p>20th Century Fox</p>  <p>US Reg 1928423</p>

NON-TRADITIONAL MARKS

Under the revised Trademark Law, colour per se marks can be registered, while under the old Trademark Law colours could be registered only if they were combined with figures, etc.

Sound, motion, hologram and position marks can also now be protected. For example, Figure 1 offers examples of non-traditional trade marks that are protectable under the revised Trademark Law.

The Japan Patent Office (JPO) announced that there were 624 trade mark applications for non-traditional trade marks within one month after the revised Trademark Law was enacted (out of 13,511 trade mark applications in April 2015, in total). Of these applications, colour proved to be the most popular type of mark, at just over 41 per cent of the total, and more innovative marks such as motion and hologram marks still outliers (see Figure 2).

APPLICATION ADVICE

Below is a brief discussion of how applicants can appropriately obtain protection for non-traditional trade marks, especially colour per se marks, which would be the most difficult to obtain trade mark registration for among all types of

non-traditional trade marks in light of recent practice regarding 3D trade mark applications and case law.

Distinctiveness of colour per se marks

The new examination guidelines issued by the JPO state the following:

- If a trade mark is a combination of colours, the trade mark shall be examined as a whole.
- If a trade mark is one that specifies locations to which respective colours should be applied, the locations shall not be taken into account in the examination.

However, at this time it is unclear just how examiners at the JPO determine distinctiveness of colour per se marks. For example, the following marks would not be registered because of lack of distinctiveness:

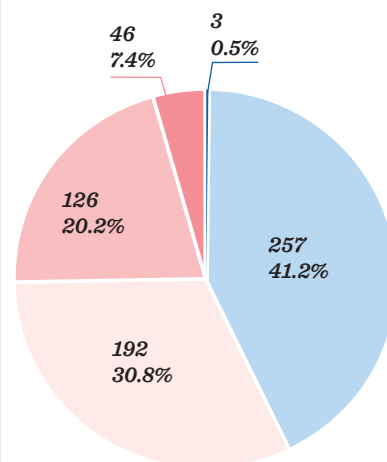
1. Colours that are commonly used for goods or services. For example, the use of red and white for bridal services in Japan, where this combination is commonly used in such a context.
2. Colours that are generally adopted for products. For example: colours naturally derived from the goods; colours commonly used to secure function of the goods; colours that are generally used to increase attractiveness of the goods in the relevant industries; colours

that are indispensable to the goods; colours that may be adopted for goods in the relevant industries; colours that may be used as patterns or background colours – for instance, black and silver are examples of colours that have a



FIG 2: NON-TRADITIONAL TM APPLICATIONS, JPO APRIL 2015

Colour Motion
Sound Hologram
Position





Based on recent precedents relating to acquired distinctiveness, the Court seems to have relaxed the requirements for “identity”

common relationship to particular product sets, for instance tyres and mobile phones, respectively.

The JPO’s new guidelines also state that colour *per se* marks will generally be considered descriptive, so it is necessary to prove acquired distinctiveness through actual use in Japan to register such marks.

OTHER CONSIDERATIONS

Because many non-traditional trade marks will be considered relatively descriptive, many applicants who wish to obtain registration for non-traditional trade marks will have to prove acquired distinctiveness through actual use.

Under Article 3.2 of the Japanese Trademark Law, relatively descriptive marks can be registered if applicants can demonstrate that Japanese consumers can associate the mark with a particular commercial origin or source.

In any evidence of such use the mark should be identical to the filed mark according to the JPO’s

examination guidelines, which state that: “Registration through the application of this paragraph is only acceptable when the trade mark and the designated goods or designated services in an application are identical to those actually used.”

Regarding “identity of the filed mark and the used mark” in relation to colour *per se* marks, they will be considered identical if general consumers would perceive that the prominent parts in these marks are identical.

Also, identity of the used mark and the filed mark is examined by considering: hue; saturation and brightness; the colour proportion; and the colour scheme.

RELAXED APPROACH

The JPO strictly examines “identity of the trade mark and the designated goods or designated services in an application and those actually used” in accordance with its guidelines. A claim of acquired distinctiveness is only accepted if the trade mark and the designated goods or services in an application are identical to those actually used. However, based on recent precedents relating to acquired distinctiveness, the Court seems to have relaxed the requirements for “identity”.

The leading case regarding relaxed requirements for proving acquired distinctiveness is the “Maglite case” (Case No 2006 (Gyo-ke) 10555), for which a decision was rendered on 27 June 2007, by Japan’s Intellectual Property High Court. The marks related to the case are shown opposite.



KEY JAPANESE IDENTITY CASES

MAGLITE

Case No 2006 (Gyo-ke) 10555, IP High Court

Filed mark



Designated goods – class 11: flashlight

GAULTIER PERFUME BOTTLE

Case No 2010 (Gyo-ke) 10366, IP High Court

Filed mark



Designated goods – class 3: beauty products (cosmetics), soaps, perfumery, cosmetics

The decision of the Court, in summary, was that the filed mark is not inherently distinctive.

Although the used mark is slightly different from the filed mark – since the used one includes the letters “MINI MAGLITE” while the filed mark consists of only the 3D shape – those marks should be deemed as substantially identical and, thus, the filed mark should be registered based on acquired distinctiveness.

This court decision is remarkable in that it allowed a 3D shape per se to be registered as long as:

- 1) the 3D shape itself is a substantial part of the filed and used mark
- 2) the filed mark and the used mark are substantially identical, and
- 3) there has been extensive use of the filed mark in Japan.

After this case, other cases followed.

The Gaultier Perfume Bottle Case (Case No 2010 (Gyo-ke) 10366, IP High Court) is another remarkable case where the Court seems to have relaxed the requirements for “identity”. Here the IP High Court’s position was that the filed mark is not inherently distinctive.

However, the filed mark has been used for more than 15 years and

its unique shape helped achieve recognition with regard to the 3D mark per se. Therefore, the court accepted acquired distinctiveness of the filed mark.

The interesting point of this decision is that the Judge allowed registrability regarding not only “perfume” but also other goods, despite the fact that the Applicant used the filed mark in connection with “perfume” only. Therefore, this Court decision relaxed the requirements for both “trade mark” and “goods” being judged “identical”.

According to the JPO, it will refer to these court cases when judging acquired distinctiveness of non-traditional trade marks.

RECOMMENDATIONS

Ultimately, although it may be difficult to register colour per se marks, as the IP High Court has

relaxed the requirements for “identity” between a filed mark and a mark in use when proving acquired distinctiveness, the chance of success in registering relatively descriptive marks (whether non-traditional or traditional marks) will be likely to increase in an appeal or litigation to rescind a trial decision.

Under the circumstances, regarding relatively descriptive marks, we recommend trying to obtain registration by proving acquired distinctiveness in Japan.

To obtain protection for a colour in a specific position in a product (for example, the colour “green” shown in the picture of a pen shown below, there are two options: obtaining trade mark registration for a colour mark, or obtaining trade mark registration for a position mark.



In this case, we would recommend trying to obtain trade mark registration for a position mark, because it would be easier to convince an examiner that the mark (the green-coloured clip) functions as a source identifier of a product.

Using and obtaining protection for non-traditional trade marks is an important route through which companies can identify their goods or services, diversify their brand strategies and increase their brand values using unconventional brand messages. With this in mind, the amendment of the Japanese Trademark Law will undoubtedly be beneficial. ■



Nami Togawa

is a Registered Patent Attorney and a Partner of Seiwa Patent & Law in Tokyo trademark@seiwapat.co.jp

Yoshiki Tohyama, Registered Patent Attorney at Seiwa Patent & Law was co-author.





NOW case finally concludes

Jonty Warner feels the result may be more reliance on Section 56 in future

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The Supreme Court has rejected a claim of passing off brought by Starbucks (HK) and PCCW Media (together “PCCW”) against the well-known media group Sky, following the launch of Sky’s internet-based TV service NOW TV.

Even though PCCW’s Hong Kong-based NOW TV service enjoyed – according to the trial judge – a modest reputation in the UK, the Supreme Court affirmed the “hard line” approach of the UK courts that a claim of passing off requires goodwill in the form of customers in the UK.

BACKGROUND

Since 2003, PCCW has provided a closed-circuit IPTV (internet protocol television) service in Hong Kong (since March 2006, this has been branded NOW TV). By 2012, there were around 1.2 million subscribers in Hong Kong, but it had no UK-based customers, as it is not possible to receive its service in the UK. However, it relied on the following as evidence that UK residents had become familiar with its service:

- Chinese speakers permanently or temporarily resident in the UK at the relevant date had been exposed to it when resident in, or visiting, Hong Kong.
- Programmes and trailers had been available on PCCW’s “channel” on YouTube.
- A few of its programmes had been available as videos-on-demand on various international flights, including three that flew into the UK.

In March 2012, Sky announced the launch of its new “over the top” (“OTT”) IPTV service under the name NOW TV. Sky launched NOW TV in beta form in mid-July 2012. At that time, PCCW had plans to expand its service outside Hong Kong, including to the UK, but these were in their early stages and not yet in the public domain.

In April 2012, PCCW issued proceedings for trade mark infringement (based on its figurative Community Trade Mark for NOW) and passing off. Mr Justice Arnold dismissed all of PCCW’s claims. On its passing off claim, he decided that PCCW had failed to establish the first necessary element (the others being misrepresentation and damage),

namely goodwill in relation to its services in the UK. The “modest” reputation of PCCW’s service among the Chinese-speaking community in the UK was not sufficient, as there were no customers in the UK for the purposes of establishing goodwill. After the Court of Appeal upheld this finding, the Supreme Court gave PCCW permission to appeal on this sole issue.

ULTIMATE DECISION

Lord Neuberger (with all the other Lordships agreeing with his judgment) affirmed the law that a claimant in a passing off action must establish that it has actual goodwill in the UK, involving the presence of clients or customers in the UK for the products or services in question. A detailed analysis of a series of key passing off cases over the past century (such as *Budweiser*) led to the conclusion that this approach represented the consistent view of the UK courts.

PCCW argued that this “hard line” approach conflicted with other jurisdictions, relying on cases in Ireland, Canada, New Zealand,



Australia, South Africa, Hong Kong and Singapore. It argued that these cases supported the contention that the reputation or goodwill associated with a mark for a particular product or service should extend to circumstances where a mark is simply associated with that product or service as a matter of reputation.

Lord Neuberger agreed that an Australian case (*ConAgra v McCain*) provided some support for PCCW's argument. However, the Singapore decisions had followed the UK approach. As for other Commonwealth jurisdictions, Lord Neuberger said that the position was less clear (albeit the position in the US appeared to be consistent with that in the UK). He concluded that it did not appear to be the case that there was "anything like a clear trend in the common law courts outside the UK away from the 'hard line' approach".

TERRITORIAL APPROACH

Lord Neuberger also found indirect support for the territorial approach to goodwill in various trade mark provisions, including the genuine use requirement, and decisions confirming that mere accessibility of a website in a particular jurisdiction is not sufficient to conclude that offers for sale are targeted at consumers in that territory.

The Supreme Court concluded that as PCCW had no customers in the UK it had not established the requirement of goodwill in the jurisdiction. To the extent that UK-based residents did associate NOW TV with its service, they could only be customers of PCCW in Hong Kong. As for the availability

The Supreme Court has affirmed the territorial nature of goodwill in passing off actions in the UK

of PCCW's services via websites and international airlines, this was merely intended to – and did – promote PCCW's Hong Kong business, and was not sufficient to constitute goodwill.

Lord Neuberger recognised that the implications of the Court's decision would be of acute significance in an age of global electronic communications, and relatively quick and cheap foreign travel. However, the Court's conclusion followed from the balancing exercise required in passing off actions, namely between the public interest in free competition

and the protection of a trader against unfair competition. A finding that a reputation within the jurisdiction was sufficient would, in the Court's view, have tipped the balance too far in favour of protection as against free competition.

AUTHOR VIEWPOINT

The Supreme Court has affirmed the territorial nature of goodwill in passing off actions in the UK. It has also confirmed that a reputation acquired through advertising is not sufficient to found a claim in passing off. Its decision provides a significant measure of certainty to those looking to clear a new brand in the UK.

However, as acknowledged by the Supreme Court, Section 56 of the Trade Marks Act 1994 (which applies Article 6bis of the Paris Convention in relation to "well-known marks") may provide an important remedy for owners of marks (whether registered or unregistered) that satisfy the criteria for a well-known mark, even if they have no goodwill in the jurisdiction. There have been only a limited number of cases where a claimant has relied upon Section 56, but these may become more prevalent in the future.

King & Wood Malletsons LLP acted for Sky in this case.



Jonty Warner

is an Associate Solicitor at King & Wood Malletsons LLP
jonty.warner@eu.kwm.com

Outdoorsy opposition is upheld

Chris Morris believes the decision shows the importance of consumer education

This case concerns the unsuccessful appeal by Go Outdoors against the decision of the UK IPO to uphold Skechers' opposition to two applications, for the signs GO WALKING and GO RUNNING.

Skechers challenged the applications to register the signs for class 35 retail services on absolute grounds. It alleged that the signs are descriptive for the services claimed (Section 3(1)(c) Trade Marks Act 1994) and also non-distinctive (Section 3(1)(b)). The UK IPO rejected the opposition on the first ground, but accepted it on the second and the applications were refused.

Go Outdoors appealed to the High Court. Skechers served a Respondent's notice, arguing that the opposition should also have succeeded on the descriptiveness ground.

THE APPEAL

Mrs Justice Rose emphasised that the role of the appellate court is not to retry the case, but to review the judgment of the lower court to see if it is wrong. She also stressed that the warning by Baroness Hale about how ordinary courts should approach appeals to them from expert tribunals such as the UK IPO must apply. She went on to consider each of the three grounds of appeal:

1. The Hearing Officer at first instance found that, while GO WALKING/RUNNING does not describe a retailing

service (and therefore a 3(1)(c) objection was not valid), "the marks are a normal way of offering shoes and clothing for use when running or walking" so the 3(1)(b) ground succeeds.

On appeal, Go Outdoors contended that this was inconsistent. The Court disagreed, because the findings are in answer to very different questions. The signs were not descriptive, but they were non-distinctive because the public would perceive them as merely pointing to where goods are to be found in the store. This ground of appeal failed.

2. Go Outdoors also argued the original decision misapplied the Audi test (C-398/08), when considering the registrability of slogans. Again, the Court rejected this: although the Hearing Officer found the signs did not have the quality of originality or resonance of Audi's phrase, "Vorsprung durch Technik", he did not say that, on that basis alone, they must be rejected. He made an overall consideration and came to a reasoned conclusion.
3. The final ground of appeal was that the Hearing Officer failed to give the evidence of acquired distinctiveness proper consideration. The Court found that although the summary was concise it was also accurate.



The UK IPO found that the public would not see the signs as an indication of origin

The appeal was rejected. While there was no need to consider Skechers' Respondent's notice, Mrs Justice Rose found that the Hearing Officer's decision to reject the 3(1)(c) ground of opposition was correct.

INTERESTING LESSON

This was an interesting lesson for brand owners. Go Outdoors had long-standing and widespread use of the signs applied for and significant exposure. However, the UK IPO found that the public would not see the signs as an indication of origin, but to merely "indicate the intended purpose of the goods they are retailing, or indicate the area of the store where goods for the intended purpose are being sold".

This is a useful reminder that using signs for a long time in the course of trade will not automatically render an objectionable sign registrable. A claim to acquired distinctiveness must also show that the customer has been educated to perceive the sign as an indication of origin.



Chris Morris

is an Associate and Trade Mark Attorney in the IP team at Burges Salmon LLP

Chris.Morris@burges-salmon.com

District found not distinctive

Property developers should consider
registering marks early, observes
Thomas Hooper



On 6 March 2013, Canary Wharf Group (CWG) filed a UK trade mark application for the word mark CANARY WHARF. Protection was sought in respect of printed matter (class 16) and a range of services, including real estate, building construction and design, car parking, landscape design and security services (classes 36, 37, 39, 42, 44 and 45).

Initially, the UK IPO rejected the application on absolute grounds. The Examiner took the view that CANARY WHARF was devoid of distinctive character and descriptive of the goods and services applied for, as per Section 3(1)(b) and (c) Trade Marks Act 1994, respectively.

After applying the criteria for geographical marks that is neatly set out in *Windsurfing Chiemsee Produktions v Huber* (Joined Cases C-108 and 109/97 [1999] ETMR 585), the Hearing Officer upheld the Examiner's decision. The mark applied for designated the subject matter of the goods and also the geographical origin of the services, as they will be served from the Canary Wharf area. CANARY WHARF was, therefore, not registrable for the goods and services applied for.

CWG appealed to the High Court. It took the view that the *Windsurfing* criteria had been wrongly applied and, because it owned the area historically, there was no public policy reason why it should not be allowed to secure registration. CWG had demonstrated some use of the mark, which in its mind was enough to show acquired distinctiveness, and so appealed on this point also.

DECISION

The High Court upheld the rejection of the application. After applying the *Windsurfing* criteria, and considering whether the relevant class of persons would associate the goods and services applied for with the Canary Wharf area, it was held that Canary Wharf is recognised throughout the UK as a London business district. Hence, it is unsurprising that the services applied for were the types of services that were "perfectly natural to reside in or service a business district".

In relation to the class 16 goods, the Court held that, if CANARY WHARF appeared on printed matter such as books, business directories or newspapers, the public would understand that it referred to the business district. They would not assume that such publications were "controlled by a single economic entity".

The Court agreed that the class 16 application should fail also.

Finally, the Court considered acquired distinctiveness, dismissing this very quickly. The evidence provided by CWG only showed

some use of the mark in relation to the running of the Canary Wharf estate. This use was geographically limited to the Canary Wharf area. In relation to the goods and services applied for, there was no relevant use elsewhere in the UK.

THE TAKEAWAY

As CWG had historical ownership of the Canary Wharf area and although it still retained certain controls over the business district, trade mark applications should have been filed much earlier.

Trade marks that are well recognised by the relevant UK consumers as geographical areas are likely to experience difficulties when attempting to secure registration, unless the goods or services applied for are distant enough to not be associated in the relevant consumers' minds.

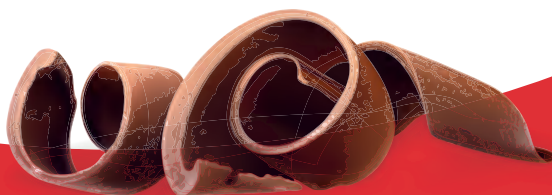
The Court's structured review and application of case law to the present facts helps to clarify that geographical place names can be registered as trade marks, but, for public policy reasons, strict conditions remain in place.



Thomas Hooper

is a trainee Trade Mark Attorney at Baker & McKenzie
Thomas.Hooper@bakermckenzie.com

Nestlé fails to catch a break



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It seems that an unbranded “four finger” shape will not be registrable in the UK, says Kate Swaine

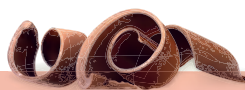
Société des Produits Nestlé SA (Nestlé) sought to register the “four finger” shape shown on the next page for goods in class 30: chocolate; chocolate confectionery; chocolate products; confectionery; chocolate-based preparations; bakery goods; pastries; biscuits; biscuits having a chocolate coating; chocolate-coated wafer biscuits; cakes; cookies; and wafers.

In the English High Court, Mr Justice Arnold ruled in January 2014 that Nestlé’s shape was devoid of inherent distinctive character in respect of all the goods covered by its application.

However, a finding that a mark is devoid of inherent distinctive character does not prevent registration if it is demonstrated that the mark has acquired a distinctive character. This raises the question: what needs to be demonstrated in this context? Would it be sufficient to show that the average consumer recognises the shape and associates it with Nestlé or, specifically, a KitKat chocolate bar? Or that the shape actually is that of the Nestlé KitKat product? Note that there is no KitKat branding on the shape itself.

Advocate General Wathelet opined that it is not sufficient for these





SHAPE EXCLUSION CONSIDERATIONS

ESSENTIAL FEATURE OF THE MARK

APPLICABLE PROVISION OF ARTICLE 3(1)(E)

x) The rectangular “slab” shape of the mark as it appears on the form of application, including the relative proportions of length, width and depth

3(1)(e)(i) The feature results from the nature of the goods themselves

y) The presence, position and depth of the breaking grooves arranged along the length of the bar, which effectively divide the bar into detachable “fingers”

3(1)(e)(ii) The position (ie the angle) of the grooves was necessary to obtain a technical result

z) The number of such grooves, which, together with the width of the bar, determine the number of “fingers”

3(1)(e)(ii) As y), it was necessary for there to be three grooves in order for there to be four fingers, each of which was of the desired portion size

purposes that the average consumer recognises the mark and associates it with Nestlé’s KitKat. For the mark to have an acquired distinctive character for the purposes of the Trade Marks Directive 2008/95/EC (and Section 3(1) of the UK Trade Marks Act 1994), the evidence must demonstrate that the average consumer recognises, with no possibility of confusion, the exclusive origin of the goods concerned – in other words, that the shape depicted is that of a KitKat, and only a KitKat.

In the English proceedings, there was a factual finding that consumers associate the shape with KIT KAT (and therefore with Nestlé), but that they rely on the word mark KIT KAT and other marks used in relation to the goods to identify the trade origin of the products. If the Court of Justice of the European Union (CJEU) follows Advocate General Wathelet’s opinion on this point, the case on acquired distinctiveness would appear to be a challenging one for Nestlé.

However, in view of his findings on the law on shape exclusions in this case, the acquired distinctiveness dispute may prove moot.

SHAPE EXCLUSIONS

Article 3 of the Trade Marks Directive prohibits registration of signs that consist exclusively of: i) the shape which results from the nature of the goods themselves; ii) the shape of

goods which is necessary to obtain a technical result; iii) the shape which gives substantial value to goods. The UK Trade Marks Act contains a similar provision.

In the English proceedings, the three essential features of Nestlé’s shape were each found to fall within a prohibition of Article 3(1)(e) (see the summary table above). But none of the essential features fell within all of the Article 3(1)(e) restrictions. Does this prevent the shape exclusion of Article 3(1)(e) from biting?

In the Advocate General’s opinion, no. Noting that trade mark law constitutes an essential element in the system of competition in the EU, he explained that the intent behind Article 3(1)(e) is, in accordance with the CJEU’s decision in *Hauck GmbH & Co KG v Stokke A/S and Others* (C-205/13), “to prevent the exclusive and permanent right which a trade mark confers from serving to extend indefinitely the life of other rights which the EU legislature has sought to make subject to limited periods”. In the Advocate General’s opinion,

it must follow from this that if any one (or more) of the criteria listed in Article 3(1)(e) is satisfied, in respect of one (or more) of the essential features of the shape, Article 3(1)(e) precludes registration.

COMMENT

It remains to be seen whether the CJEU will follow the Advocate General’s opinion in the *Nestlé v Cadbury* case. If it chooses to do so, it would be adopting a narrow interpretation of the legislation and setting tough challenges for parties seeking to register shape marks:

- First, there would be a fairly high evidential burden on applicants asserting acquired distinctiveness. Recognition and association would not be enough; applicants would have to demonstrate that, in the eyes of the average consumer, the guarantee of origin was met in the absence of any other trade mark that is usually used in conjunction with the shape mark.
- Second, if any single essential feature of a mark fell within any of the exclusions of Article 3(1)(e), the mark would not be registrable. This would be a clear signal that the courts will strictly limit anyone using trade mark law to try and extend unlimited protection to product shapes.

Nestlé sought to register the “four finger” shape below, which omits the embossed wording on KitKat bars



Kate Swaine

is a partner and Head of Brands and Designs at Wragge Lawrence Graham & Co LLP
kate.swaine@wragge-law.com





On 28 September 1994, Associated Newspapers Limited (“ANL”) applied to register METRO in class 16 (Registration No 1586405, 24 January 1997).

On 3 October 1997, Bauer Radio Limited (“BRL”) applied to register METRO RADIO for: advertising, marketing and promotional services (class 35); telecommunications and a broad range of broadcasting services (class 38); and a range of radio entertainment services and other activities, including arranging, organising and provision of concerts, live and musical entertainment (class 41) (Registration No 2147054B, 23 July 1999).

On 22 May 2000, ANL filed an application for metro.co.uk and metro.com (series mark) under Application No 2233378, which was published on 8 February 2008 for a wide range of goods and services in classes 9 (digital music, etc), 16, 35 (advertising and promotion of

business services, etc), 36, 38 (telecommunication services, etc) and 41 (publishing services, organisation of exhibitions and shows, etc).

OPPOSITION AND APPEAL

BRL opposed ANL’s application on the basis of its earlier registration in classes 35, 38 and 41. ANL put BRL to proof of use of its mark in relation to all services relied upon during the relevant period. ANL challenged parts of the witness statement filed by BRL, and in particular the relevance of the exhibit in the form of a printout dated after the end of the relevant use period, and submitted that BRL did not evidence genuine use of its mark for advertising services. BRL did not file further evidence in reply.

ANL filed an application to revoke METRO RADIO for non-use for all registered services other than radio broadcasting. These actions were consolidated, at which point BRL filed further evidence in the form of two witness statements.

The Hearing Officer held that BRL provided satisfactory proof of use in relation to certain parts of the specification and in particular advertising, marketing and promotional services (class 35), website services (class 38) and services including arranging and organising concerts, live entertainment and musical performances (class 41).

Further, it was held that there was a reasonable degree of similarity between the marks and that there was a likelihood of confusion in relation to all goods and services that were identical or similar.

ANL filed an appeal on the basis that BRL’s opposition should have only succeeded in relation to a restricted range of services all connected with radio broadcasting, and that BRL’s mark should have been revoked in relation to all other services. In this connection, ANL challenged the Hearing Officer’s findings of use in relation to concerts, live and musical entertainment,



This case reiterates that, to prove genuine use, adequate proof of use needs to be submitted



advertising services and website services.

BRL filed a Respondent's notice that was several months out of time.

It also produced another witness statement that sought to clarify and supplement a previous witness statement. ANL objected to BRL's application to file the Respondent's notice out of time as well as the further witness statement.

On appeal, the Appointed Person analysed whether BRL's use was genuine (established in *Ansul and La Mer*) in relation to the services that the Hearing Officer found to be satisfactory by looking at whether the use created or maintained a share of the market and how the relevant public viewed the relationship between the mark and the goods/services during the relevant date (*Stichting BDO v BDO Unibank* [2013] EWHC 418 (Ch) at [51]). In some respects, BRL's evidence was of low quality, did not specify the particular dates of use, did not explain the nature of some of the supporting documents and was incomplete.

Although BRL did not provide a proper explanation for the late filing of the notice or identify any errors in the Hearing Officer's decision, the Appointed Person considered that ANL was not prejudiced by the defect in the notice or by its lateness and therefore allowed BRL to rely on the notice. In connection with BRL's application to adduce new evidence on ANL's appeal, BRL had earlier opportunities to file evidence that it

failed to use, and did not provide a proper explanation for the delay. Case No O/147/13, *Naturex*, is a useful reminder of the law and practice on admitting new evidence on appeal, and was cited.

BRL was not permitted to adduce the new evidence on appeal for many reasons, including the fact that it would be prejudicial to ANL.

Most of the broader specification terms under METRO RADIO were revoked for non-use as genuine use was not proved. However, the mark remained registered for those services in relation to radio services. In connection with the opposition, BRL's remaining specification was taken into account when making a global assessment of the likelihood of confusion at the relevant date.

INVALIDATION ATTEMPT

ANL filed an invalidation action against METRO RADIO in respect of advertising services and relied on METRO in relation to "newspapers" on the basis that newspapers are highly similar to advertising services.

BRL put ANL to proof of use, in respect of which a substantial amount of material was filed that demonstrated genuine use. A likelihood of confusion was found in respect of advertising services, and it was determined that BRL's

registration should be cancelled in respect of these services.

BRL appealed, submitting that newspapers and advertising services were dissimilar. BRL was also prepared to amend its specification to "radio advertising services" should the submission be dismissed. It was held that the respective goods and services were complementary and, as such, there was a likelihood of confusion. Further, the fall-back wording was considered to be procedurally unfair because of the time at which this was proposed. METRO RADIO was found to be invalid, except for radio advertising and the unchallenged services.

CLOSING THOUGHTS

This case reiterates that, to prove genuine use, adequate proof of use needs to be submitted. The evidence must be of probative value, and clear and precise on what use there has been, and explain why a broader specification is appropriate for any narrow use. Further, there must be a real commercial exploitation of the mark for the requisite purpose at the relevant time, taking into account the perceptions of the average consumer. It is also a useful reminder of the law and practice on admitting new evidence on appeal.

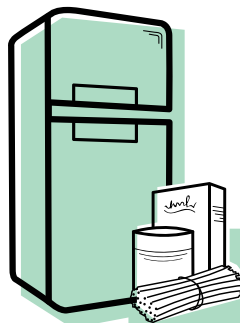


Eleni Mezulanik

is a Trade Mark Assistant at Keltie LLP
eleni.mezulanik@keltie.com

AP dismisses Shezan appeal

Variant mark found not to be genuine use, reports Carrie Bradley



The HO commented upon the paucity of evidence of use provided, noting that it lacked detail

This matter concerned an appeal to the Appointed Person (“AP”) in respect of the UK IPO’s revocation of UK Trade Mark Registration No 2029477, partial revocation of UK Trade Mark Registration No 2019696 and partial dismissal of Opposition No 200708 by decision of the Hearing Officer (“HO”), Mr M Boyle, on 20 June 2014 (O-277-14).

By way of background to the dispute, the Respondent in the appeal (Mr Hussein Ayyub) filed UK Trade Mark Application No 2531996, featuring a series of five composite marks comprising the word “Shazans”. This was opposed by Shezan Services (Private) Limited (“SSP”) under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) on the basis of its two earlier UK Trade Mark Registrations (Nos 2019696 and 2029477) for the stylised mark “Shezan”.

Mr Ayyub denied the grounds of opposition and put SSP to proof of use of the earlier trade marks under Section 6A of the Act. Mr Ayyub also applied for revocation of the marks relied upon by SSP on the grounds of non-use. Both parties filed evidence and the matter came before a hearing on 3 April 2014.

The HO identified the relevant periods of time for which proof of use needed to be demonstrated and the relevant case law in relation to genuine use. In particular, the HO gave detailed consideration to the applicable approach to determine whether the use of a variant form of a registered mark

constitutes genuine use (ie did the mark used represent a form differing in elements which altered the distinctive character of the registered mark).

In this case, the HO found that, although the distinctive character of the registered mark resided essentially in the word “Shezan”, the use of a different manner of stylisation and differing visual elements in the mark used did alter the overall distinctive character of the mark. As such, the form of use could not be relied upon by SSP. The HO also commented upon the paucity of evidence of use provided, especially noting that it lacked detail and that the required detail must have been at the disposal of the witness concerned.

SSP APPEAL

SSP appealed to the AP under Section 76 of the Act, contending that the HO erred in principle in his approach to the application of the law on proof of use to the facts before him, and on the issue of the use of a variant form of a mark to that registered.

SSP submitted that the HO should not have considered the paucity of evidence, but rather findings of fact, as the test for genuine use does not include a quantitative element. The AP countered that evidence gave no

details of dates when use had taken place, the extent of use, or the actual form in which the mark was claimed to have been used. As such, the AP determined that the HO was entirely right to find that the evidence lacked sufficient detail to discharge the burden upon SSP to establish genuine use and to satisfy the Registrar that the registrations should be retained.

The AP also supported the HO’s finding that use of the mark in the form relied upon should not be regarded as use of the mark as registered, confirming that the HO had correctly identified and applied relevant case law and was entitled to find that the difference between the marks, although perhaps not great, were sufficiently material that they altered the distinctive character of the mark. In the absence of material error of principle in his analysis, the HO’s decision could not be properly overturned. The appeal failed on all grounds.



Carrie Bradley

is a Senior Trade Mark Attorney and Head of Trademarks & Designs at LOVEN IP

carrie.bradley@loven.co.uk

Carrie advises on IP protection, enforcement and dispute resolution.



T-183/13, T-184/13, T-423/12, Skype Ultd
v OHIM – Sky plc and another (SKYPE),
CJEU, General Court, 5 May 2015

Split decision

For his part, Philip Davies finds the decision in these joined cases particularly perplexing

These cases are problematic. The two word mark cases (T-183/13 and T-184/13) concern the same word mark, SKYPE, but for different (but related) sets of goods and services. T-423/12 is a figurative mark, which is the word “skype” enclosed in a bubble shape (below right). With the device element found to be “merely decorative”, the main comparison to be made was between the word part of the sign and Sky’s word mark.

Sky plc opposed the registration of these three marks under Article 8(1)(b) of Council Regulation (EC) No 207/2009 (CTMR), which deals with identity with, or similarity to, an earlier trade mark and identity or similarity of the goods or services, leading to a likelihood of confusion. The Board of Appeal found that there would be a likelihood of confusion, at least among the UK public.

COURT COMPARISONS

In the General Court, the relevant public was found to be averagely circumspect and the goods and services were found to be identical. The Court affirmed that the comparison of goods and services must be made with consideration of what the Community Trade Mark (CTM) and the prior CTM are registered for, rather than the current use of the mark.

The real bite in these cases came in the comparison of the signs. The Board of Appeal had found that the marks were: visually similar (SKYPE contains SKY, as its first three letters); aurally similar (the only difference being a final “p”); and,

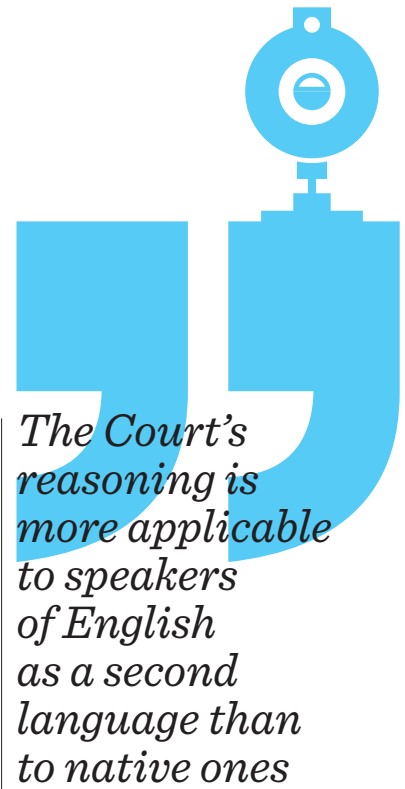
conceptually, the marks were found to be moderately similar on the basis that the relevant public would appreciate that the English word “sky” was contained in SKYPE.

In the General Court, Skype argued: first, that the Board had “artificially split” SKYPE into SKY and PE, even though it is a unitary word; and second, that since the signs are relatively short, small changes would be particularly important.

The Court affirmed the Board’s view and stated: “[I]t is the very fact that the letters ‘sky’ are found in the beginning of the mark applied for that makes the term ‘sky’, which is part of the basic vocabulary of the English language, easily identifiable therein.” The reasoning seems to be that this was not a “split”, but, rather, recognition of the presence of the word SKY therein. The Court thought that the shortness of the sign could not overcome this similarity.

DISSENTING VIEW

This is, with great respect, clearly erroneous. On this line of reasoning, the General Court seems to think that English speakers, for example, see (and think of) the words “bet” in “better” and “con” in “conservative”. The Court’s reasoning is more applicable to speakers of



English as a second language than to native ones.

This case shows the perils of making linguistic arguments to a multilingual tribunal, which is likely not to include any native speakers of the critical language. Practitioners should be aware of the potential pitfalls, and bolster their evidence accordingly. Unfortunately, as this error is a matter of fact, rather than law, it is quite possible that this judgment will be left standing if an appeal is taken to the Court of Justice.

The Skype figurative mark



Philip Davies

is a Professional Support Officer in IP at Simmons & Simmons LLP
Philip.Davies@simmons-simmons.com

Bex Heard, Supervising Trade Mark Attorney at Simmons & Simmons, co-authored this report.



T-55/13, Formula One Licensing BV v OHIM & Idea Marketing SA, CJEU, 21 May 2015



Opposition lacks winning formula

Small differences can be decisive when it comes to short marks, concludes Stephanie Taylor

In March 2007, Idea Marketing SA (Idea) filed an International application designating the European Union for the mark F1H2O covering goods and services in classes 9, 25, 38 and 41. The Community Trade Mark (CTM) designation was published for opposition purposes. Formula One Licensing BV (Formula One) filed an opposition based on a range of International registrations designating EU Member States, including under CTM registrations and UK registrations for the mark F1, as well as the stylised F1 marks shown opposite, covering a range of goods and services in classes 1, 3, 4, 7,

8, 9, 11, 12, 14, 16, 18, 21, 24, 25, 28, 29, 30, 32, 33, 34, 35, 36, 38, 39, 41, 42 and 43. The opposition was based on all of the goods and services protected by the earlier marks, and directed against all goods and services covered by Idea's application. Formula One relied on the grounds of Council Regulation (EC) No 207/2009 (CTMR) Article 8(1)(b) and 8(5) in support of the opposition.

CHAIN OF EVENTS

The OHIM Opposition Division dismissed the opposition and Formula One appealed to the OHIM Board of Appeal. The Board of Appeal

dismissed the appeal and upheld the Opposition Division's decision, finding that there was no likelihood of confusion between the earlier Formula One marks and Idea's mark, and that Idea's mark would be perceived by the average consumer as referring to a chemical formula.

Furthermore, the Board of Appeal determined that Formula One's International registration for the mark F1 was devoid of any distinctive character for goods and services connected with sporting events or merchandising of such events. In respect of the remaining goods and services, the mark had a limited

IMAGES: JULIE LUCHT/MRSEGU/SHUTTERSTOCK.COM



distinctive character that was not enhanced by its use by Formula One. Nor had the mark acquired distinctive character, as it was held that the reputation in the F1 mark stemmed from its use in a stylised form.

The Board of Appeal acknowledged that Formula One had developed reputation in the stylised F1 marks for certain goods and services, but dismissed the opposition insofar as it relied on Article 8(5) because it held that the Idea mark and the Formula One marks were not similar.

GENERAL COURT APPEAL

Formula One appealed to the General Court alleging infringement of Articles 8(1)(b) and 8(5), and disputing the Board of Appeal's decision on the reputation attached to the Formula One marks and the likelihood of confusion between the marks of Formula One and Idea.

The Court held that the Idea mark could not be broken down into the components F1 and H2O, as suggested by Formula One, and that the Idea mark is twice as long as the Formula One marks, but capable of being easily remembered by the average consumer. It also agreed that the Idea mark was likely to be thought of as a chemical formula.

Although the average consumer generally attaches more importance to the start of marks, this principle cannot hold in all cases and does not override the principle that, when assessing similarity of marks, account must be taken of the overall impression created by them.

Turning to a phonetic comparison, the Court held that the fact that the start of the Idea mark is pronounced the same way as the Formula One marks was not sufficient to offset the other differences and that, in

Courts will not always apply the principle that marks with the identical prefixes should be found to be similar

particular, the difference between the length of the signs would be more striking phonetically than visually.

Conceptually, while the Formula One marks have a clear meaning relating to the Formula One class of races and racing cars, the Idea mark has no clear concept, but is likely to be perceived as a string of numbers and letters or as a chemical formula due to the H2O element.

The Court also upheld the Board's finding that the mark F1 has a commonly understood meaning as an abbreviation of "Formula One" and so has weak distinctive character for goods and services associated with the field of motor racing.

As such, the Court held that the Board of Appeal was correct to find that there was no likelihood of confusion between the Idea mark and the Formula One marks, even in respect of goods and services found to be identical.

Finally, the Court held that, because one of the conditions for making a finding under Article 8(5) was not met, namely similarity between the marks in question, the Board was correct to reject the opposition on this ground.

MATTER OF PRINCIPLE

This case demonstrates that the courts will not always apply the principle that marks with the identical prefixes should be found to be similar, and that small differences between short marks will make a big difference in the assessment of whether these marks are found to be similar.

The Formula One marks



Stephanie Taylor

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

Change of stripes

In adidas comes a reminder that similarity can be subjective, suggests Emma Reeve

40 CASE COMMENT

LEONARD.ZHUKOVSKY@SHUTTERSTOCK.COM

On 1 July 2009, Shoe Branding Europe BVBA filed a Community Trade Mark (CTM) application for the mark shown top right, to apply for “footwear” and described as:

“The trade mark is a position mark. The mark consists of two parallel lines positioned on the outside surface of the upper part of a shoe. The parallel lines run from the sole edge of a shoe and slope backwards to the middle of the instep of a shoe. The dotted line marks the position of the trade mark and does not form part of the mark.”

In September 2010, adidas AG filed a notice of opposition to registration of the mark applied for in respect of all the goods referred to in the application for registration. The opposition was based, *inter alia*, on the earlier rights in a number of marks (shown right) that related to, variously: “footwear”; “sports footwear”; “sports and casual footwear”; “footwear, including sports and casual footwear”; “sports footwear, sports clothing (including knitted fabrics)”. In describing the marks, reference was made to “parallel equally spaced stripes”, “three stripes contrasting with the base colour of the footwear” and “three parallel equidistant stripes applied to pieces of clothing or footwear”.

DECISION TIMELINE

In May 2012, the Opposition Division rejected the opposition. On 2 July 2012, the Applicant filed an appeal with OHIM. In November 2013, the Second Board of Appeal of OHIM

(“BoA”) dismissed the appeal. In its decision, the BoA took the view that the differences in the number of stripes and their respective positions on the shoe were sufficient to find that the signs at issue were, overall, dissimilar. It rejected the opposition filed on the ground that the relevant section of the public was unlikely to establish a link between the marks at issue, considering that their differences in the number of stripes and their positioning were determinant, whatever the reputation of the earlier marks may have been. Finally, the BoA rejected the opposition because adidas had failed to substantiate its ownership of the German non-registered mark.

LATEST POSITION

In May 2015, the General Court held that the Board of Appeal was wrong to conclude that the marks at issue were visually dissimilar. Instead, the Court decided that the marks were visually similar because of the parallel sloping stripes, equidistant, of the same width, contrasting with the base colour of the shoe, placed on the outside of the shoe.

This case shows the continued difficulty faced when assessing visual similarity between figurative trade marks, and reiterates that, ultimately, the decision is taken subjectively.

The Applicant’s mark



The adidas marks

CTM No. 3517646



German No. 944624



German No. 944623



German No. 39950559



German No.
897134



International
Registration No.
391692



Non-registered
trade mark



Emma Reeve

is an Associate at Mathys & Squire
ecreeve@mathys-squire.com

events

More details can be found at itma.org.uk

Date	Event	Location	CPD hours
22 September	ITMA London Evening Meeting* Parallel Proceedings: Evidence and delays at OHIM and the courts	Royal College of Surgeons, London	1
23 September	ITMA Autumn Seminar* Hot topics in Industry	Hyatt Regency, Birmingham	5
23 September	ITMA Autumn Drinks Reception* Part of the ITMA Autumn Seminar	Hyatt Regency, Birmingham	
7 October	ITMA Scottish Evening Meeting European Court decisions on admissibility, evidence and bad faith	Shepherd & Wedderburn LLP, Glasgow	1
20 October	ITMA London Evening Meeting* OHIM Case Law Update	Royal College of Surgeons, London	1
22 October	ITMA CPD Webinar The NOW case		1
29 October	ITMA Scottish networking drinks reception	The Western Club, Glasgow	1
29 October	ITMA Trade Mark Administrators' Afternoon Seminar UK Application Process and Examination with related online tools	Marks & Clerk LLP, London	
12 November	ITMA Scottish Evening Meeting Discussion of recent OHIM cases	Brodies LLP, Edinburgh	1
13 November	ITMA & APTMA Day Seminar and Dinner The Irish Perspective	Hilton Dublin (seminar) and Drury Buildings (dinner)	4-5
24 November	ITMA London Evening Meeting* CJEU and General Court Decisions - 2015	Royal College of Surgeons, London	1
11 December	ITMA Christmas Lunch**	London Hilton on Park Lane	
16-18 March (2016)	ITMA Spring Conference	One Whitehall Place, London	9

IMAGE: BARTKOWSKI/SHUTTERSTOCK.COM



We join APTMA to look at IP from the Irish Perspective in November

41 EVENTS

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I work as... an IP solicitor at Briffa. I am also a notary public.

Before this role... I qualified in Scotland before working for the Judicial Office and in-house at a firm of Patent and Trade Mark Attorneys in Edinburgh, while also juggling study for my Diploma in IP Law and Practice at Oxford and tutoring law students at the University of Edinburgh.

My current state of mind is... optimistic. I am off to the set of *Game of Thrones* in a few days!

I became interested in IP when... I was introduced to it as an Honours subject at Aberdeen University. But I have always been particularly interested in brands, some of which appeal to all the senses.

In my role, I most enjoy... helping clients achieve their business goals, while learning about their latest creations and technology.

I most dislike... receiving scam invoices from clients via fictitious IP offices telling me they've been overcharged!

If I were a trade mark/brand, I would be... Omega. It was the first watch on the moon.

On my desk is... files, a coaster from a couture fashion house and a lime



Oliver Tidman shares some music-inspired aspirations

green pen, which complements the office colour scheme perfectly.

My favourite mug... is a personalised reusable travel cup. It was a freebie from a client.

My favourite place to visit on business is... Scotland – there is less traffic and beautiful scenery.

I am most inspired by... honest, sincere people who have a sense of humour.

The biggest challenge for IP is... the protection and enforcement of IP

rights in emerging international markets, particularly online, where the efficacy of their registration system is yet to be fully established and tested.

The talent I wish I had is... to play music by ear so that I can accompany anyone.

I can't live without... my wife. She is my social secretary.

My ideal day would include... a victory for a client and a chocolate bar.

In my pocket is... iPhone, memory stick, wallet, keys, business cards and a name badge from a tech event I recently attended.

The best piece of advice I've been given is... always tailor your advice to the commercial needs of your client.

When I want to relax I... go for a jog or play the saxophone, hopefully at Ronnie Scott's one day!

In the next five years I hope to... increase my involvement with ITMA and see more foreign associates.

The best thing about being a member of ITMA is... meeting other members of the profession and attending socials!

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



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Support vacancy contact:
dawn.ellmore@dawnellmore.co.uk

Attorney vacancy contact:
kevin.bartle@dawnellmore.co.uk

