

CITMA REVIEW

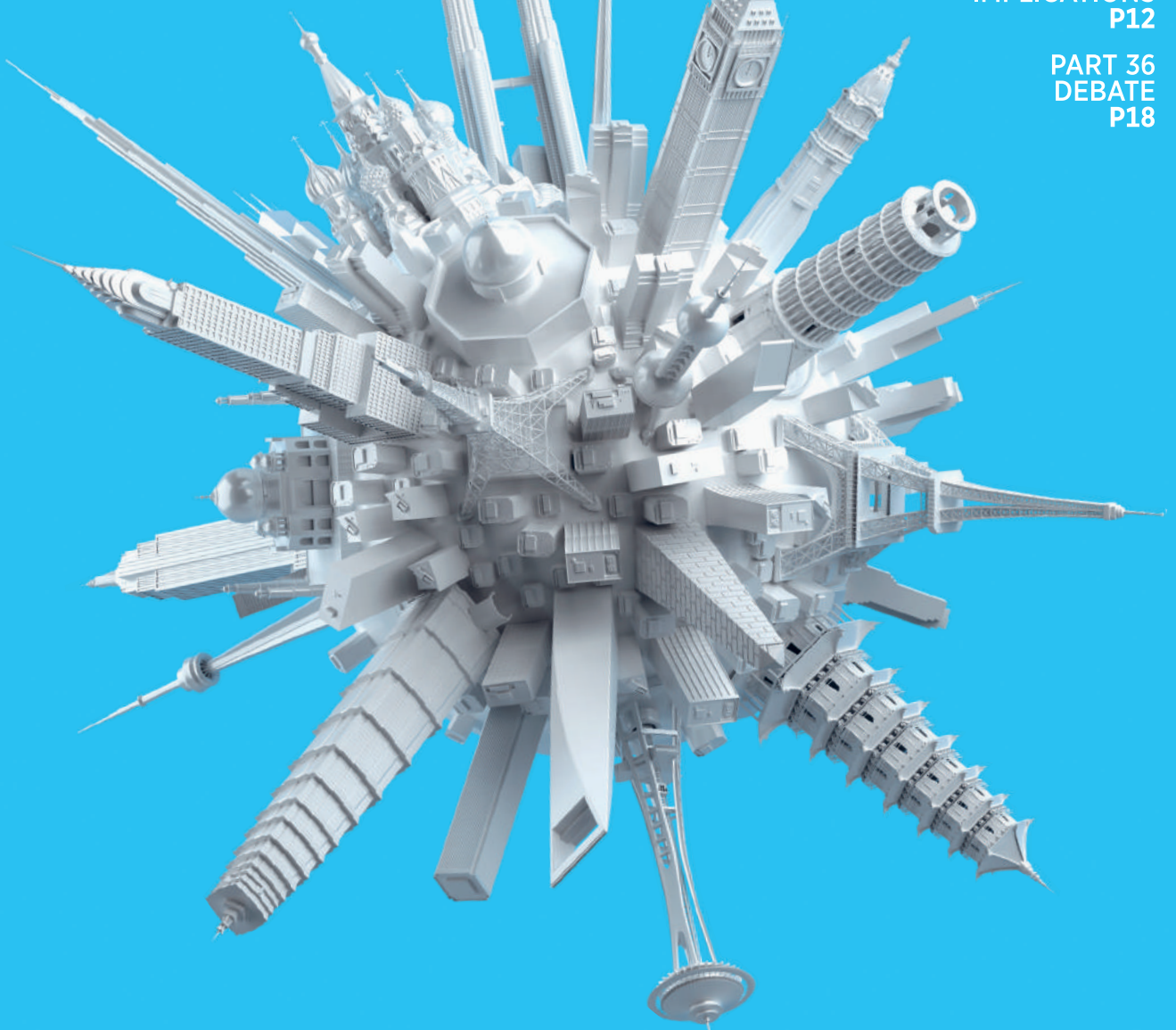
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TRADE MARKS ON TOUR

Viewing some of the world's most famous landmarks through an IP lens



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WELCOME & CONTENTS



Tania Clark
CITMA President

“ The updated CITMA website incorporates user-friendly features



Along with a digital edition of this *Review*, the updated CITMA website incorporates user-friendly features, including streamlined events booking and easier renewals, and allows you to update your specialisms.

The next event you'll want to register for is the Autumn Conference in Birmingham on 8th November, which will cover unregistered rights, honest concurrent use and geographical indications. Plus, make a note in your diary of the Christmas lunches – 7th December for the Northern event and 14th December for London.

Of note in this issue, our Paralegal representative on CITMA Council, Rebecca McBride, discusses the impact of social media on clearance searches. And the chair of our Design and Copyright Working Group, John Coldham, analyses the latest CJEU judgment in the Nestlé appeal in relation to Kit Kat.

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CITMA REVIEW

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PARALEGALS MAKE THE GRADE

Congratulations to the 86 candidates who successfully passed the 2018 CITMA Paralegal Course and are now eligible to become CITMA Paralegal members. The successful candidates received their certificates at a ceremony in Canary Wharf in September.

Maximilian Theiss of Lainé & James LLP received the top mark of

97 out of 100 and will be presented with the CompuMark Award at the CITMA Christmas Lunch.

The CITMA Paralegal membership category, introduced in 2017, reflects a commitment we have made to further support and develop the work of trade mark paralegals, administrators and formalities staff. From 2019,

CITMA Paralegal membership will include a continuing professional development element to enhance standards within the profession.

The 2019 CITMA Paralegal Course is not yet open for registration, but if you are interested in registering for the course, please email tm@citma.org.uk

SUCCESSFUL CANDIDATES

| | | | | |
|---------------------|-------------------------|-----------------------|----------------------|-------------------|
| Rafaela Alkaim | Paul Dicken | Nicola Hart | Azirun Nessa | Santa Sona |
| Katie Bell | Hannah Etienne | Marlena Hellebo | Ben Northshield | Gabrielle Spencer |
| Claire Bowers | Monica Ezsias | Zoe Hooper | Nicole Packham | Lauren Stevens |
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| Edward Brightly | Debora Ferrari Haines | Emma Kirkpatrick | Sam Parish | Janet Strath |
| Georgia Brown | Chanelle Finch | Rickerbys | Priya Patel | Michelle Surmacz |
| Ruth Bryan | Paola Flores Ramos | Jasna Kljajic | Emma Pearce | Hayley Sykes |
| Faye Butler | Kimberley Freeland | Elzbieta Kucharska | Allison Petts | Maximilian Theiss |
| Hannah Champion | Louisa Gavrielides | Sean Lawlor | Gemma Pickavant | Angelina Travkina |
| Hemma Chauhan | Cristina Gherasim | Vânia Liça | Elena Pollard | James Vallois |
| Gillian Craig | Sarah Gibson | Alvaro Loxton Stevens | Kaiser Rahman | Dileen Van Beek |
| Liam Crenan | Tania Greenhalgh | Olivia Markowycz | Heidi Saenger | Jane Walker |
| Jessica Daniels-Dey | Zoe Halfon | Darren McCarthy | Pollyanna Savva | Emma Ward |
| Vivienne Däpp | Lyndsey Hall | Paul McEvaddy | Zuzanna Scott | Jenni Whitfield |
| Tracey Dearne | Árni Halldórsson | Nikolle Medford | Kerys Senior | Wibke Wichert |
| Lizzi Denton | Vanessa Hammler | Heidi Meister | Alexander Shackleton | Alexandra Wither |
| | Alan Hammler | Daniel Moor | Chloe Shiner | Lia Wrigley |
| | Rebecca Louise Harrison | Giovanni Musso | Cheryl Small | |

CANADA IS 55TH HAGUE AGREEMENT MEMBER

On 5th November, Canada will officially join the Hague System, enabling users to choose design protection in the country for international applications.

IN MEMORIAM

Graham Ball

CITMA was saddened to hear of the death in September of Graham Ball, who served as President of ITMA from 1985 to 1987. Among memories from CITMA members comes the following from Keith Havelock: "I remember that Graham, during his term of office, was a very enthusiastic organiser of an Institute conference in Oxford. The meeting was carefully run and included a surprise anniversary presentation to the then Secretary of ITMA, Roy Marshall, at Roy's own Oxford college, which was much appreciated."

Peter Shaw

Potter Clarkson LLP has reported the recent passing of Peter Shaw, who was with the firm for more than 50 years. Peter, a Trade Mark Attorney, started his career after WWII, and retired in the late 1990s. He was key in establishing the firm's Trade Mark Group and trained many attorneys over the years. He was always very willing to help others and offer his much-valued advice and guidance. Those who worked with him report that it took them some time to adjust to office life following his decision to retire.

LAOS – NEW LAW BRINGS SUBSTANTIAL INNOVATION

Laos's new Law on Intellectual Property No.38/NA of 15th November 2017 was published electronically in the Laos *Official Gazette* on 25th May 2018, and became effective 15 days later. The new legislation brings reform to a variety of areas of IP law in the country, but it is with respect to trade marks that the greatest number of amendments have been made.

A digital platform will be created to publish submissions of new trade mark applications. Within 60 days of the publication of a new application, third parties can oppose the registration of the mark.

Previously, the third-party mark holder was required to file a cancellation request with the Department of Intellectual Property. This could only be done after the mark had been issued its trade mark certificate and registered – and within five years of the publication of said registration in the *Official Gazette*. Factoring in delays in the publication process, this often meant

that successful cancellation actions could only prevail after the mark had been put to use for a significant amount of time.

A further important amendment is to the term of protection of registered Laos trade marks – which will now be valid for a period of 10 years following the filing date, rather than the date of registration.

Finally, the updated legislation expands the range of matters that may be registered as trade marks.

It is anticipated that regulations will be issued in due course to supply further guidance to mark holders on the scope and application of the new law. Given the extent of the changes introduced, time will be needed to develop infrastructure and train local officers to streamline registration and opposition procedures. Nevertheless, the introduction of the new legislation signifies a major step forward for Laos's trade mark regime.

Report from Denise Mirandah

MEMBER MOVES

Alessio Brotto



Alessio Brotto has joined the team at Groom Wilkes & Wright as Chartered Trade Mark Attorney.

Alessio can be contacted on 01462 714300 or at abrotto@gwvtrademarks.com

Allister McManus



Elkington & Fife LLP is delighted to announce the appointment of Allister McManus as Associate Trade Mark Attorney.

Contact Allister on +44 (0)20 7936 8800 or at allister.mcmanus@elkfife.com

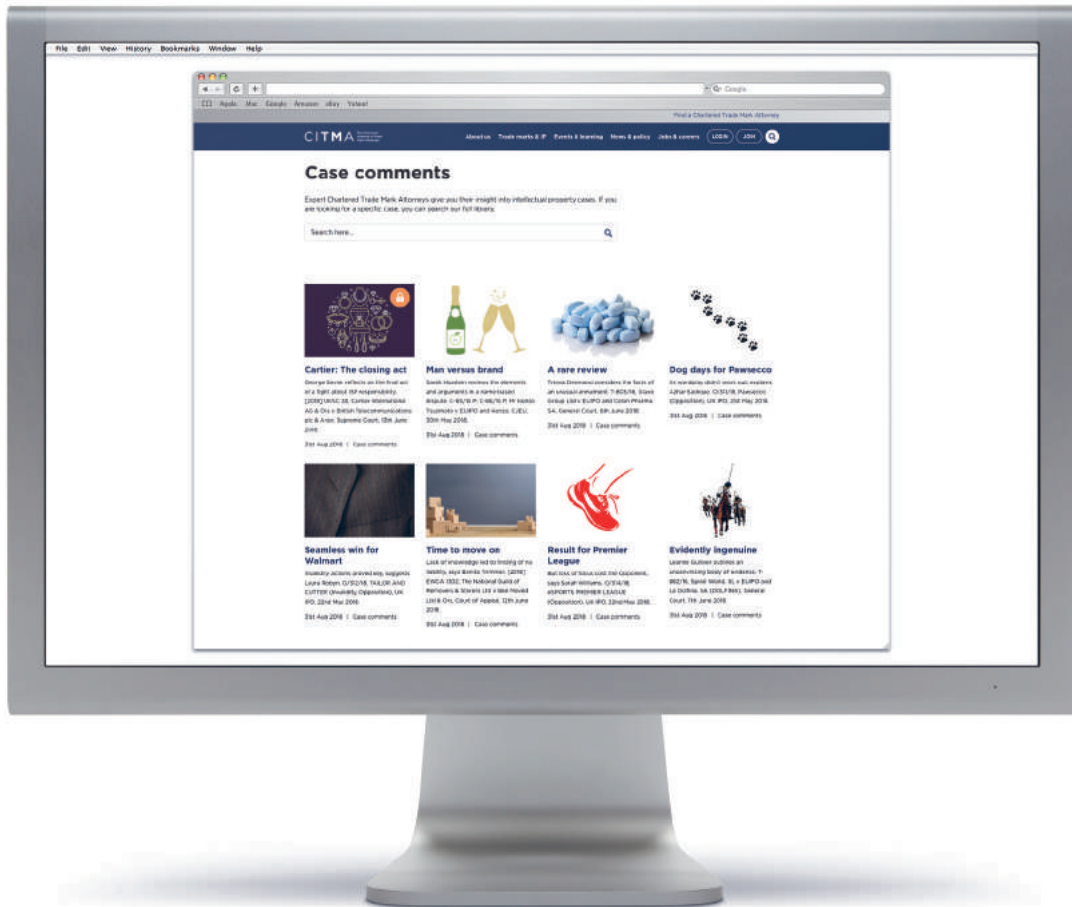
Joe Cohen



Joe Cohen has retired from his 50-year career as a solicitor. For the past 19 years, he has been a partner of and, latterly, a consultant to Collyer Bristow LLP.

Considering a career move?

Visit the CITMA jobs board at citma.org.uk/job_board



WE'RE DOING DIGITAL EVEN BETTER

Richard Hayward introduces our refreshed and richer online hub



We are delighted to introduce members to our new website, which we hope will significantly enhance your digital interaction with CITMA.

Using our website should be a seamless experience, whatever it is that you are looking to do. Processes for event bookings, membership renewals and updating member details have all been improved and made simpler, with you in mind. We've also built in personalisation. For members, this means that once you've logged in, you will see a homepage that tailors content based on specific areas in which you've told us you are interested – pulling out the content and events that are most relevant to you.

We also want our digital channels to promote IP and the Trade Mark Attorney profession – and attract new people to the site. So, the citma.org.uk homepage is now more focused towards the general public. We are offering richer content that will inform, educate and entertain the public about why it is important to get professional legal advice on their IP rights and strategy.

GETTING STARTED

All members will receive information about how to log in and create a new password. The most important change is that your primary email address is now your username.

Once logged in, you will be able to manage your CITMA membership. You can update your details, see which events you are booked onto, view your renewal history, and more.

ENHANCED SEARCH OPTIONS

We want our new website to work harder for you. Linking business owners and decision-makers with the services of Chartered Trade Mark Attorneys (CTMAs) is a cornerstone of the new design.

Our enhanced searchable directory will help the public find CTMAs. The new search filters will allow people to search not only by location, but also by specialisms.

It is important for all members to keep their profiles up-to-date so you are more likely to be found. You can also add a long-form biography and a profile photo, to make your profile

a more personal introduction and a better marketing and business development tool for you.

We also want you, as part of our community, to be able to find each other more easily – whether you are looking for colleagues at home or abroad. So we have also enhanced our members' directory, which is now accessible without needing to log in.

CONTENT YOU CAN USE

Offering content aimed at the trade mark legal profession is an important aim of the new site. On it, you will find all case comments published in the *CITMA Review* since 2016, and the archive is fully

Getting started checklist:

- Follow the log-in instructions sent to you
- Update your contact preferences
- Add your specialisms
- Check we have the correct information for you
- Add a biography and profile image



searchable. You can also earn CPD by watching recordings of past events in our video library.

We will keep you up-to-date with the latest news that affects the profession, from Brexit to changes in law and practice, as well as the latest job vacancies. And our powerful website-wide search tool will help you find whatever it is that you are looking for.

EASIER RENEWALS

We have made renewing your membership easier. Bulk renewals will be possible on a whole-firm

basis, enabling all members within a firm to be paid for in one go. Subscriptions can be processed and paid for by a named individual at a firm, such as a finance director or administrator. We will be sending further information about bulk membership renewals in the coming weeks. You will, of course, still be able to pay individually, if that is your preference.

STREAMLINED BOOKING

We want you to be able to register for our events more easily. Our new booking process is designed to be as quick and simple as possible. We've added the ability to be booked for an event by someone else, even if that person is not a CITMA member – meaning you don't need to share your log-in information, and allowing several people from a firm to be booked at one time.

BUSINESS-FRIENDLY BLOG

We are also launching a new blog. Aimed at businesses, it will bring visitors to our website with relevant, attractive, informative and entertaining content that will help them learn more about trade marks and IP – and help bust some myths around IP along the way.

By demonstrating the importance of trade marks and the role of CTMAs, we hope to create more searches for CTMAs on our directory – and ultimately more business for our members. If you have an idea for a blog post, please get in touch with me at the email address below.

WE WANT YOUR FEEDBACK

This is a big project, and we will continue to refine the website over the coming months and years. Your feedback will be vital in helping us to do this. Any comments or suggestions, however big or small, are greatly appreciated. ●



Richard Hayward

is CITMA's Head of PR & Communications
richard@citma.org.uk

CITMA Lecture



NO MORE PLAYING NICE

A member event has prompted Peter Byrd to suggest it's time to codify image rights

Some of the most high-profile IP cases of recent times have involved celebrities protecting their “image rights” and preventing (or attempting to prevent) the unauthorised use of their name or image. Making this difficult is the lack of codified protection in the UK, which means making use of the current patchwork of IP rights, privacy laws and advertising codes, none of which were designed for this purpose.

With a particular emphasis on sports stars, this challenge was the subject of a talk by Nick White of Charles Russell Speechlys LLP, delivered to CITMA members in July.

An example of an “image rights success”, said White, was the passing off case in which Eddie Irvine¹ complained that radio station Talksport had doctored an image of him to suggest that the station had his endorsement. Mr Justice Laddie said: “Mr Irvine has a property right in his goodwill which he can protect from unlicensed appropriation consisting of a false claim or suggestion of endorsement of a third party’s goods or business.”

Pop star Rihanna achieved a similar victory against Topshop², but only because Topshop used an image that had been widely used in the promotion of her album and music video, and there was goodwill in that particular image. The Court of Appeal

made it clear that the use of an image of a person on a garment was not in itself passing off, and that a celebrity does not have the right to prevent the use of their image generally.

Sports stars can, and do, register trade marks to protect their name, which provides them with powerful rights. However, White explained,

“

Today’s celebrity culture means that there is huge value in images of celebrities

this is not always straightforward, and different offices tend to have different practices. Take the example of Sir Alex Ferguson³, who was deemed by the UK IPO to be “too famous” to register his name in respect of posters and stickers.

In contrast, EUIPO’s practice allowed football star Lionel Messi to register both word and logo marks covering a wide range of goods and services.

In the case of Panini⁴, copyright law was a help. An unauthorised sticker book containing the images of hundreds of Premier League footballers was held to have infringed copyright in football clubs’ logos. In the Panini case, however, the logos that had been infringed were generally owned by clubs, not the footballers concerned. And generally the copyright in a photo of a celebrity will be owned by the photographer rather than the subject.

Today’s celebrity culture means that there is huge value in images of celebrities, whether it be this year’s Instagram-happy *Love Island* contestants or global superstars like David Beckham or Roger Federer. Surely, with this in mind, there should be a fit-for-purpose mechanism to protect the value in these names and images?



Peter Byrd

is an Associate at Charles Russell Speechlys LLP
peter.byrd@crsblaw.com

1. Edmund Irvine v Talksport Ltd [2002] EWHC 367 (Ch)
2. Fenty & Ors v Arcadia Group Brands Ltd (t/a Topshop) & Anor [2013] EWHC 2013 (Ch)
3. UK IPO O/266/05 ALEX FERGUSON
4. The Football Association Premier League & Ors v Panini (UK) Ltd [2002] EWHC 2779

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IT'S A KNOCK OUT

Rebecca McBride examines social media's impact on the scope of clearance searches

The digital world provides a nearly unlimited platform for communication and an opportunity for brands to reach a global market. An online presence is now necessary to build a successful brand, and this goes far beyond a simple website. Typically, a brand will now also cultivate an active social media presence, which means that a traditional trade mark register search for new brands is no longer sufficient to detect existing prior rights – it is highly recommended to extend searches across platforms, such as Facebook, Twitter, Instagram and YouTube (and new platforms seemingly every day).

As clearance searches can quickly escalate into an expensive exercise if there are multiple jurisdictions and categories to consider, they must be tackled with a specific strategy and ideally through a series of phases. This will ensure that clients are able to evaluate other marks if their first choice is not available, before investing substantially in marketing and packaging with the proposed branding.

KNOCK-OUT SEARCH

Phase one typically consists of a round of knock-out searches. CITMA Paralegals, for example, will be tasked to check the relevant register for any pending or registered identical marks. As part of the initial knock-out search, it is also recommended that a brief check is made on social media platforms for examples of usernames or app names that present an obvious conflict, such as where the name is already in use and goodwill has been built.

Phase two typically involves a more thorough search, looking for pending or registered identical trade marks and/or nearly identical marks. Here, CITMA Paralegals will search the most distinctive elements of the proposed mark. Variations of the mark with suffixes, prefixes and punctuation such as hyphens are also taken into consideration – and this is the time to also search against hashtags. This search will reveal whether:

1. the proposed mark is already in common use by social media users and is therefore too generic to be registered;
2. a hashtag is in use that may have built up sufficient goodwill to support a claim for passing off;



TOP TIP: BE PLATFORM AGNOSTIC

As new platforms emerge, clients should be mindful of preventing third parties from obtaining corresponding accounts, usernames or app names. Clients should also select a mark they can use across all platforms.



“ In 2014, Wyke Farms was the first brand in the UK to successfully register a hashtag as a trade mark on the basis of acquired distinctiveness ”



Rebecca McBride

is a CITMA Paralegal at Pinsent Masons LLP, and Paralegal Representative on the CITMA Council
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3. a hashtag is in use that has also been registered as a trade mark, in relation to descriptive terms, possibly on the basis of acquired distinctiveness through use.

Social media has given marks that would inherently be refused an avenue to registration. In a significant example, in 2014, Wyke Farms became the first brand in the UK to successfully register a hashtag – #FreeCheeseFriday – as a trade mark on the basis of acquired distinctiveness, for its ongoing social media campaign. As a result, clients should be advised that any prominent strapline they may wish to use as a hashtag may be registerable as a trade mark if they can provide sufficient evidence to support their case.

The cautionary saga of Burgerista Operations GmbH v Burgista Bros Ltd and Ors [2018] saw IPEC find there was a likelihood of confusion and subsequently dilution of a trade mark, partly based on evidence of the public using hashtags interchangeably – #burgerista, #london and #burgista on an Instagram post referring to dining at a Burgista restaurant. This is just one example that underlines the importance of conducting searches across social media platforms before investing money in launching a brand, as any subsequent litigation can be costly and damaging to PR.

CLEARANCE SEARCH

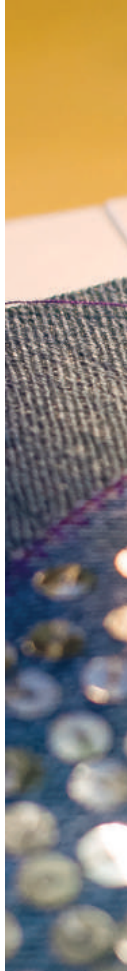
Phase three typically consists of a full clearance search, providing a comprehensive review of identical and similar marks, as well as registered and unregistered rights. This can include: company names, domain names, common law rights, device and logo searches. It is important that from the outset there is a clear understanding of the visual and phonetic elements of the mark, as well as the intended use, including jurisdiction(s) and relevant classes, as this will determine the breadth of the searches.

Clearance searches should be relied on with caution, however, as the results are only as good as the data. As we expand our searches beyond the confines of trade mark databases and begin to explore search engines and social media platforms, we encounter a new challenge of finding a needle in an ever-growing haystack.

Discovering the use of a proposed mark on social media does not automatically disqualify the mark from being taken further through the process. To avoid a possible dispute, a client may decide to proceed with a more informed and tailored application. Clearance actions for revocation and cancellation may also be pursued.

Where registered trade marks appear to pose a risk to the client’s proposed mark, a CITMA Paralegal can gather further information to create a full picture of the brand’s presence and use in the market – potentially leading to revocation for non-use (the five-year rule) or cancellation where it can demonstrate that the mark was descriptive at the time of filing or has become commonplace in the industry, for example through common use as a hashtag.

Ultimately, as trade mark searches become more and more complex, keeping a balance between appropriate checks and budget constraints is a challenge for Trade Mark Attorneys in maintaining their competitiveness. Involving CITMA Paralegals in carrying out searches, for example on social media platforms, should therefore become common practice for the profession. ●



ON THE UP

Repurposed products are on the rise, and should also be on the IP radar, says Carrie Bradley

As any eco-conscious consumer or designer will know, “upcycling” is the creative reuse, or transformation, of one product into another. The practice gives the original product an entirely new lease of life. Materials that have served their original function and have essentially become “waste” are instead regarded as a resource that can be repurposed, either in whole or in part, to become or be used for something else.

Reusing materials in this way reduces not only the amount of landfill that we produce, but also our consumption of new raw materials, and hence our carbon footprint. Upcycling has great imaginative

appeal to domestic hobbyists and features heavily on social media platforms such as Pinterest, where users share resourceful and thrifty craft ideas. The cost-saving benefits of upcycling haven’t gone unnoticed by manufacturers either, particularly those eager to reinforce brand values relating to sustainable practices, most notably in the fashion industry.

Upcycled fashion can take many forms. An item of clothing might be refashioned into a different type of garment. A shirt might be transformed into a dress, or a jumper unravelled and its yarn reused to knit a scarf or a tea cosy. Often, the materials from entirely

unexpected products are upcycled to become fashion items, with, for example, decommissioned fire hoses or parachutes being made into belts or bags, or discarded electrical wire being turned into costume jewellery.

IP ISSUES

Of course, wherever you find innovation you also find IP issues, and upcycling gives rise to a complicated array of risks for upcyclers to navigate.

There is no doubt that, in undertaking this creation process, upcyclers are using their own design ideas and, consequently, new IP rights will subsist within



“ Exhaustion is unlikely to apply given that the original legitimate goods have been materially altered, such that they are no longer being sold in their original, unaltered state

the new end products. However, the first questions that arise are the legitimacy of this practice, whether or not any valid IP rights owned by the designer or manufacturer in any elements of the original product still subsist and, if so, whether they are infringed.

TRADE MARK INFRINGEMENT

It is clear that tension arises between the practice of upcycling and the legitimate interests of brand owners. While no brand owner would be keen to attract the negative backlash that could ensue on social media if it were perceived to be prosecuting the well-meaning, eco-friendly intentions of the upcyclers, it nevertheless has an obligation to safeguard the value of its brand.

It is common for many upcycled products to prominently feature the

brand names and logos of the original products. In some cases, the original brand names are a key feature of the eco-kudos and appeal of the new product, such as a satchel or pencil case fashioned from upcycled chocolate bar wrappers or fizzy-drink cans. In other cases, the use is more subtle, but nonetheless visible, such as where the original trade mark on a designer-label garment appears on the resulting upcycled handbag.

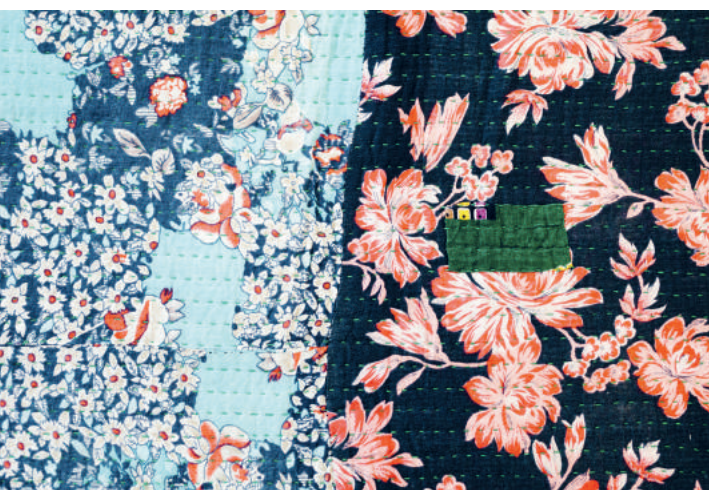
Aside from the obvious unfair advantage that upcyclers gain from the use of the trade mark, brand owners must also act to protect their licensees and consumers. Allowing the marketplace to become flooded with unauthorised branded goods would undoubtedly undermine interest in, and the value of, their licensing programme. In addition, unregulated and untested

upcycled products bearing the brand owner's trade mark, but over which the brand owner has no means of control – for example, in terms of requiring adherence to the product safety standards expected of licensees – have the potential to inflict irreparable reputational damage if their use leads to injury.

This conflict inevitably compels brand owners to act, especially where the upcycling is not confined to a small-scale venture. But how clear is the trade mark infringement line when it comes to upcycling?

HIGH RISK

If a well-known signature fabric that is registered as a trade mark in its own right, such as the Burberry signature fabric, is upcycled from a curtain or bedspread to become an item of clothing, this use is likely to be interpreted as an indication ▶



“ If the designer has chosen to register a particular surface pattern, then it will have a monopoly to make and sell that pattern in relation to any goods for a period of up to 25 years

of trade origin by prospective customers. This is particularly so in the case of well-known trade marks, where even the dissimilar nature of the resulting upcycled goods from that of the original product would not enable the upcycler to escape infringement. Here, to pursue a successful claim, a trade mark owner would have to establish that the new upcycled products will take unfair advantage of the original trade mark owner's reputation, or tarnish that reputation, such as by way of the potential product liability issues mentioned above.

Where the trade mark is not well known, but is nonetheless clearly visible on the resulting upcycled product, the trade mark owner would need to establish that it is likely to confuse consumers as to origin. It is conceivable that consumers might perceive a vintage

Gucci jacket that has been modified or embellished, but fundamentally remains of the same physical nature and bears the original trade marks, as being produced by or under the authority of the brand owner.

In this case, upcyclers might expect the “doctrine of exhaustion”, which prohibits trade mark owners from preventing the resale of second-hand goods bearing their original marks, to offer them a defence. However, in this context, exhaustion is unlikely to apply given that the original legitimate goods have been materially altered, such that they are no longer being sold in their original, unaltered state.

LOW RISK

If an upcycler removes any original trade marks from a product, transforms it into something unrecognisable and then affixes its

own brand name to the finished upcycled product, then there is no use of the original trade mark to identify the source of the goods. So this form of upcycling must fall squarely on the right side of the line.

In addition, since most upcycling practices involve the creation of something unrecognisable from the original product, in most instances, they are unlikely to contravene the law of passing off. Again, the use of a signature fabric would be a likely exception to this, as such use may imply a commercial connection to the original designer or trade mark owner that does not exist, and is therefore likely to constitute an actionable misrepresentation.

COPYRIGHT CONSIDERATIONS

Copyright subsists in artistic works for the life of the author plus 70 years. In the case of upcycled



exclusive rights of the copyright owner, such as “reproducing” the copyright work, or a substantial part of it, in material form. However, many upcycling practices cannot be categorised neatly into one of the restricted acts reserved for the copyright owner. For example, deconstructing the garment and creating something new, or reusing the actual original fabric, are not reproductions of the original, as they do not result in a copy of it. Given the legal arguments that can be framed around these technicalities, the risk of copyright infringement isn’t necessarily straightforward, which is good news for the upcycler.

For original garments in which copyright protection does still subsist, it might not be possible to obtain permission where there is doubt over the identity of the owner, nor practical where a large volume of vintage goods is being upcycled. In the UK, it is possible to obtain licences to use such “orphan works” (where the copyright owner is known) from the UK IPO – although this carries a licence fee. For those upcyclers that are highly risk-averse, this approach could be a token step to try to reduce the risk of liability for copyright infringement, although the cost of multiple licences might ultimately become prohibitive if this is a regular practice.

REGISTERED DESIGNS

UK and EU registered designs allow for the protection of dressmaking patterns and the surface patterns of fabric. They can be protected for up to 25 years, subject to payment of renewal fees. Clearly, any design registration still valid and in force could present an infringement risk for an upcycled product, as a fashion garment or accessory is a “product in which the design is incorporated”, and that product has not been put on the market before.

If an upcycler has included embellishments to a garment that substantially affect the overall impression of the design, the new garment may circumvent the design protection in the original article. However, if the designer has chosen

to register a particular surface pattern, then it will have a monopoly to make and sell that pattern in relation to any goods for a period of up to 25 years, and it is here that an upcycler is more likely to come unstuck.

However, where an upcycler plans to use the actual third-party fabric itself, it is arguable as to whether or not this act constitutes the exploitation of a design that is substantially similar in overall impression to the original. This is because, again, the upcycler is not technically reproducing the protected pattern or creating a pattern that produces the same overall impression.

Practically speaking, if the upcycler is dealing with a large volume of vintage garments, then it will not be time- or cost-efficient to run design register searches for each and every pattern. As an alternative, to provide the upcycler with at least some degree of peace of mind, it might be quicker and cheaper to run proprietor searches on the designs register if the party responsible for commercialising the original garment – such as the owner of any trade marks associated with it – can be identified.

UNREGISTERED DESIGN RIGHTS

The UK unregistered design right protects only the shape and configuration of an article. It does not protect two-dimensional designs – such as a dressmaker’s pattern or surface decoration.

However, EU unregistered design rights do protect surface patterns – albeit only for three years. Again, the risk of infringement would depend entirely on the age of the original garments being used by the upcycler, and on the date on which the corresponding fabric pattern was first created in the EU.

BEST PATTERN TO PROCEED?

From the perspective of IP rights owners, adopting a scorched-earth approach towards tackling all upcycled products is likely to yield considerable negative PR fallout. An alternative approach, and potential solution, might be to ▶

fashion, copyright may subsist in the original fashion designer’s illustrations, dressmaking patterns, or the surface pattern on the fabric itself. Copyright also subsists in works of artistic craftsmanship, and while most generic clothing commonly fails to satisfy the criteria as being sufficiently “artistic” to be considered a work of artistic craftsmanship, it is possible that a one-off, high-fashion, couture garment could be protected by copyright.

Where an upcycler is using original, vintage garments of some age, it is possible that copyright protection that may once have subsisted has since expired; therefore, the degree of risk reduces in proportion with the increasing age of the garment.

Of course, to infringe copyright, it is necessary to exercise one of the



“ Managed carefully, upcycling partnerships can pay dividends to the brand owner’s ‘green’ credentials, and there are already numerous successful examples operating today

instead embrace a collaboration with the upcycler.

Educating upcyclers and encouraging them to join an official licensing programme, so that the products can be monitored for quality standards, brand image consistency and so on, is likely to achieve a far more positive outcome for both parties. Managed carefully, upcycling partnerships can pay dividends to the brand owner’s “green” credentials, and there are already numerous successful examples operating today.

UNIQUE SITUATIONS

Of course, there will be situations where collaboration is not appropriate, such as where dangerous upcycled products are concerned, or where products conflict with core brand values.

Overall, a policy to focus enforcement activities and resources on tackling just these most undesirable types of upcycled products feels like the right way forward for IP rights holders.

A SOUND UNDERSTANDING

Given the rising consciousness of the need for environmentally sustainable and ethically sound manufacturing processes, the desire to break away from using

traditional, “wasteful” resources only seems set to continue.

With commercial and domestic markets now tuned into the potential, it is important that all enthusiasts engaging in upcycling have a sound grasp of the IP implications that accompany it, as should the IP rights owners affected by it. Sadly, the only conclusion we can draw with absolute certainty is that, in all cases, the risk of liability will always be highly fact dependent. ●



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WHO DESERVES THE ANGEL'S SHARE?

Should Scotch whisky distillers be able to monopolise whisky-related words? Robert Buchan is left uncertain after a CJEU decision

In the recent case of the Scotch Whisky Association (SWA) v Klotz (case C-44/17), the CJEU has clarified, and perhaps significantly extended, the scope of protection for geographical indications of origin (GIs).

The SWA represents the majority of whisky distilleries in Scotland, with the right to take action when the GI “Scotch Whisky” is misused. The SWA brought an action in the Hamburg District Court against Mr Klotz, to prevent online distribution of Glen Buchenbach, a whisky produced in the Black Forest of Germany. Though the Glen Buchenbach bottle did not directly incorporate the GI, the SWA argued that consumers would assume the product was made in Scotland because so many Scottish malts are named after the glen in which they are made. This, it argued, was an indirect use of the GI, or at least evoked an image of it.

The CJEU’s decision, following a reference from the District Court of Hamburg, considered the scope of protection given by Articles 16(a) to 16(c) of Regulation (EC) No 110/2008. As regards 16(a), the CJEU held that indirect commercial use covers situations when the “name” at issue is identical or highly similar to a GI, and that “Glen Buchenbach” is not similar to “Scotch Whisky”. This is not a surprising conclusion, as to find otherwise would make 16(b) pointless.

Article 16(b) prevents “any misuse, imitation or evocation, even if the true origin of the product is

indicated”. The Court held that “evocation” occurs when the average consumer envisages a product to be protected by the GI. Mr Klotz argued that “Glen” was a reference to the “Berglen” area of Germany where the whisky originated and that Buchenbach is the name of a local valley. The CJEU emphasised that it was immaterial that the disputed designation is the

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The decision raises the possibility of less clear-cut terms being held to evoke a GI

name of the place of manufacture. Also, the statement on the bottle that the whisky was German was to be ignored. The German Court must now decide if Glen Buchenbach evokes an image of Scotch whisky for the average customer.

Should Scotch whisky distillers have a monopoly over “Glen”? For this author, “Glen” is undeniably a

term that brings Scotland to mind, but would it do so for consumers elsewhere in the EU? The Court emphasised that the image in the mind of the average consumer must be “Scotch whisky” and not just Scotland. Glen is widely used by Scotch distillers – the names of more than 30 single malts start with the word “Glen”, including some of the bestselling international brands. Arguably, the GI regime should prevent such a common designation for Scotch being used elsewhere.

However, while it is fairly easy to see why use of “Glen” may raise an objection given its prominence in Scotch whisky branding, the decision raises the possibility of less clear-cut terms being held to evoke a GI. If the surrounding context and any clarification of product origin are held to be not relevant, this creates a danger that producers may be discouraged from entering the market due to fear of evoking a GI.

Ultimately, national courts have to decide where there is GI evocation. And, clearly, different national courts may reach different conclusions on what evokes a GI for the average consumer. Perhaps we simply have to raise a toast to legal uncertainty?



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'THIS HOUSE BELIEVES PART 36 HAS NO PLACE IN IPEC'

Two rights may make a wrong when a costs regime intended to provide certainty conflicts with a procedural device intended to encourage settlement, writes Tim Bamford



Collyer Bristow’s annual IP debate this year considered the fault line that has recently been exposed between the costs regime in IPEC and the costs consequences of Civil Procedure Rules (CPR) Part 36 offers, in cases such as Phonographic Performance Ltd v Hagan¹ and Martin & Anor v Kogan & Ors.²

The central theme was whether Part 36 offers should trump the IPEC costs cap, or whether the effect on costs of such offers should be limited to the level of costs recoverable under the IPEC regime. In the latter case, would the incentives provided by Part 36 still work? Either way, how should clients contemplating proceedings in IPEC be advised in circumstances where a Part 36 offer may be made that may undermine that protection?

SUPPORTING ARGUMENT

Patrick Wheeler of Collyer Bristow explained that significant rule changes in IPEC were made in 2010 to produce a more streamlined, tightly case-managed procedure. In combination, Parts 45.30 to 45.36 of the CPR and Practice Direction 45.4 introduced a scale of capped recoverable costs for various stages of a dispute and an overall cap, currently set at £50,000 for the liability stage. However, unlike other

parts of the costs rules, there is no reference in these provisions to the effect of Part 36 offers on IPEC capped costs. Accordingly, whether a Part 36 offer is made by a defendant or a claimant, the other party in IPEC has no certainty about what will happen if those costs consequences are triggered.

Wheeler then illustrated the competing priorities of the benefits of settlement offers in the Part 36 form with the certainty of cost caps by reference to recent case law. In *OOO Abbott v Design and Display*³, the Claimant made a successful Part 36 offer which required the Court to consider whether costs should be awarded on the indemnity basis, but declined to do so because there was no sanction in the above provisions to lift the caps to accommodate such an award.

However, in *PPL v Hagan*, the judge was urged to follow a Court of Appeal

decision, *Broadhurst v Tan*⁴, made in connection with a fixed (not capped) costs regime for road traffic offences. The Court of Appeal held that indemnity costs could exceed the fixed costs regime. Although in *PPL v Hagan* the Court recognised that fixed costs were very different from capped costs in IPEC, it nevertheless changed tack to apply similar reasoning and exceed the cap where a claimant was entitled to indemnity costs under Part 36.

In *Martin v Kogan*, there was a further shift in approach. The Court indicated that the cap could be exceeded to a limited extent in order to award indemnity costs to a successful claimant. The Court referred to Lord Justice Jackson’s supplemental report on extending fixed recoverable costs.

This proposed a pilot for specific capped costs regimes (where the overall cap is £80,000) in which a successful claimant’s Part 36 offer could result in an award of indemnity costs, and to provide a means for this to act as an effective deterrent, the stage caps could be increased by 25 per cent.

These developments arguably represent a significant shift away from the perceived benefits of the IPEC cost cap regime. The whole point of IPEC costs caps was clearly set out by HHJ Birss in *Westwood v Knight*⁵: “Before they embark on litigation to enforce their IP rights (or defend themselves) the potential users of the [PCC/IPEC] system need to be able to make a prediction in advance as to their likely costs exposure. Their legal advisors need to be able to say with confidence that the costs capping provisions can be relied on.”

IN OPPOSITION

Simon Malynicz QC of Three New Square contended that the overarching public policy interest was to promote settlement and avoid litigation to save costs, both public and private. The Part 36 regime had an important role to play even where it would put the sanctity of cost caps in jeopardy. He further noted that the cost caps in IPEC bore little resemblance to either side’s actual spend. Accordingly, for the Part 36

“*Part 36 offers could be ‘weaponised’ by better-funded litigants against smaller or less well-resourced opponents*”



regime to work effectively, this would require cost caps to be overridden, which he thought was sufficient justification for the approach taken in *PPL v Hagan*. He also thought that there would be no unfairness to litigants otherwise seeking the protection of cost caps if parties were making reasonable and well-judged Part 36 offers.

REPLY

Ashton Chantrielle of 8 New Square, seconding the Motion, asserted that Part 36 offers could be “weaponised” by better-funded litigants against smaller or less well-resourced opponents and, if the protection of the cost cap were removed, such offers would not provide an incentive to settle, but would force capitulation because the risk of continuing would be simply too great.

She felt that, on a practical level, the benefits of Part 36 offers were greatly outweighed by the uncertainty that the *Martin v Kogan* decision caused recently among users of IPEC and their legal advisors, and that the foundations of IPEC had been shaken.

REBUTTAL

In response, Tom St Quintin of Hogarth Chambers reiterated that it was self-evident that settlement of disputes should be encouraged and that the objective of Part 36 offers was to do so. He argued that the primary purpose of the costs regime in IPEC was to provide access to justice for IP litigants who otherwise would have none. Defendants who will fight only where they have the protection of cost caps were, he said, capable of protecting themselves by making their own Part 36 offer and putting themselves in a better position rather than simply capitulating. In those circumstances, the lifting of cost caps remains consistent with



the objective of enhancing access to justice. It reduces the certainty slightly, but counterbalances that with the greater encouragement of settlement.

MOTION CARRIED

Post-debate questions from the audience revealed deep divisions between practitioners as to how best to achieve a balance between the apparently irreconcilable approaches of the costs consequences of Part 36 offers in the context of a cost-capped regime. By a narrow majority, the Motion was carried.

Summing up, the Chair of the debate, Mr Justice Carr, remarked that there were certain drawbacks to the Part 36 regime: in particular, its rigidity, which meant that if the offer was “just right”, then it worked well, but if it was pitched just a pound too low, there would be real consequences. He thought that in the context of IPEC there might be a case for more judicial discretion or not having Part 36 offers at all, but using the alternative of a Calderbank offer.

AMERICAN RULES

The debate revealed a palpable disconnect between policy and procedure. Plainly, both access to justice and promotion of settlement are in themselves desirable

objectives. However, when these aims have the potential to conflict with each other, something has gone awry. The danger in attempting to reconcile the potential for conflict, as in *Martin v Kogan*, is to leave litigants and their advisors uncertain, which may undermine these aims.

Our view is inclined towards the summary provided by Mr Justice Birss in *Westwood v Knight*, which is that the certainty provided by the cost cap regime for litigants in IPEC is fundamental to the successful operation of that court. A pragmatic approach may simply be to allow for the making of Calderbank offers to achieve settlement and to remove Part 36 offers from the process entirely.

A further consideration is whether the cap itself is the problem. Even for the more straightforward type of dispute that IPEC was established to resolve, the actual costs incurred by litigants frequently bear little or no resemblance to the capped costs. One solution might be to raise the value of the caps to something approaching a more realistic level, but to do so would be to dilute the appeal of IPEC as a forum for litigants in person or small businesses.

We therefore suggest that a more radical approach for IPEC would be to adopt the so-called “American Rule” of no-costs awards (other than in exceptional cases). This would provide certainty to litigants and neither side would be troubled by the spectre of a Part 36 offer, which risked increasing their exposure to the payment of legal costs to an unacceptable level.

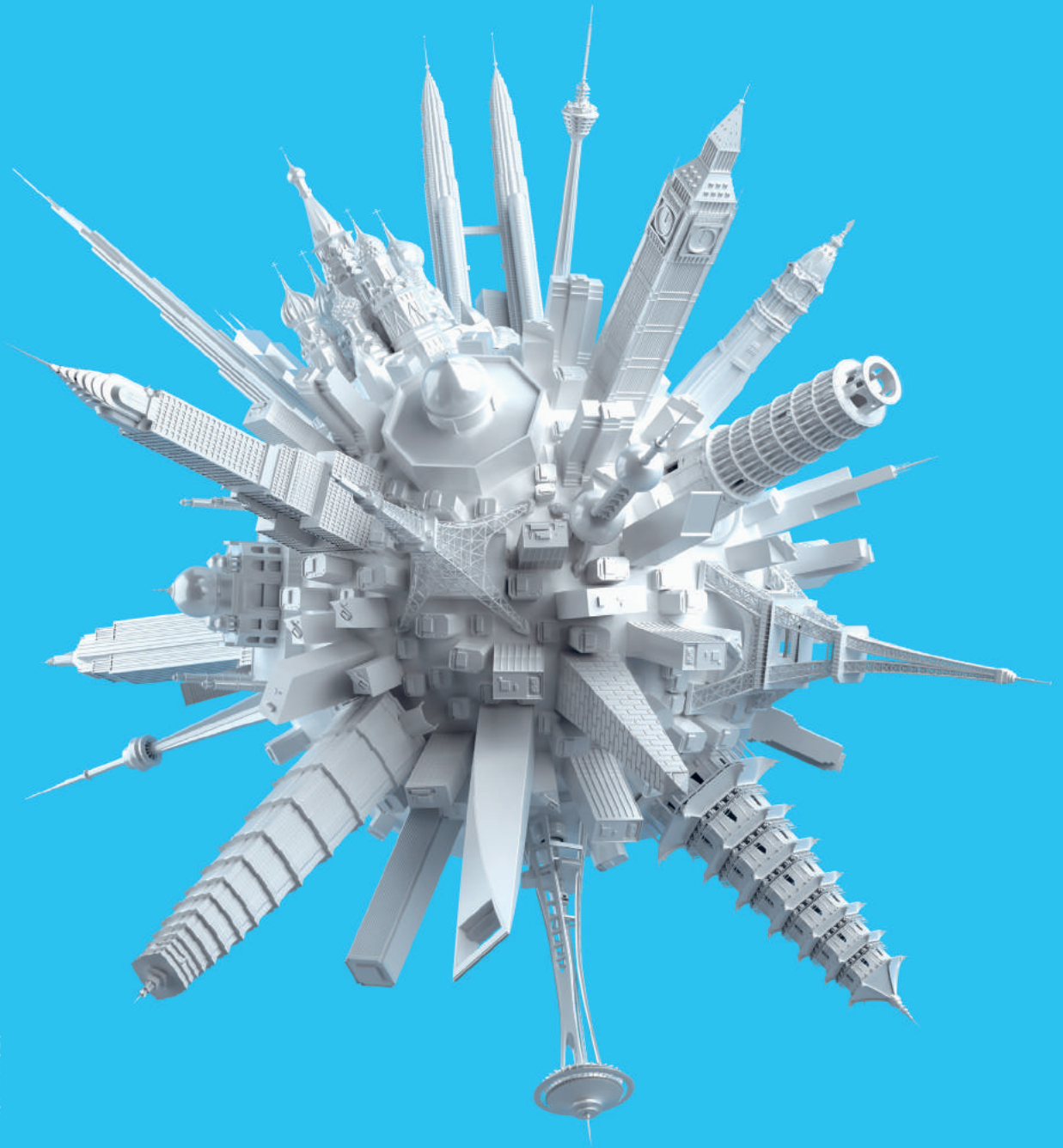
IPEC has developed into a successful forum for the resolution of more straightforward disputes. It would be regrettable if this progress were to be undone by the uncertainties that were the subject of this debate. ●

1. [2016] EWHC 3076 (IPEC)
2. [2017] EWHC 3266 (IPEC)
3. [2014] EWHC 2924 (IPEC)
4. [2016] EWCA Civ 94
5. [2011] EWPC 11



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TRADE MARKS ON TOUR

Leighton Cassidy views some of the world's most famous landmarks through an IP lens

Tourists happily snapping their way through the world's capitals may not realise they run the risk of gramming IP-infringing material. So what are the rights that stand behind some of the globe's most well-known architectural landmarks? ▶



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Buildings that have an exclusively functional shape might fall foul of the registration rules

‘The Gherkin’ (30 St Mary Axe)

TRADE MARK PROTECTION

Stone Properties (Luxembourg) Sarl has a registered UK series mark for 30 ST MARY AXE, and has registered several word marks for THE GHERKIN and GHERKIN. These latter names were coined by the public, raising questions about fair ownership of the marks.

The marks are generally registered in several classes, including class 37 for services such as “property development”, “real estate development” and “building maintenance services”.

Stone Properties is also the registered owner of several shape marks for the Gherkin.

Several recent UK and EU court cases illustrate the potential difficulties in registering and enforcing 3D shape marks, particularly in regard to distinctive character and whether a shape is necessary to obtain a technical result.¹ Buildings that have an exclusively functional shape might fall foul of the registration rules.

For example, is the Gherkin’s swirling, striped pattern exclusively the result of the building’s energy-saving system which allows the air to flow through the spiralling wells?

COPYRIGHT CONSIDERATIONS

The UK’s “freedom of panorama” exception² allows individuals to take photographs or make graphic images or films (or make a broadcast of a visual image) of buildings, sculptures, models of buildings and works of artistic craftsmanship permanently situated in a public place or in premises open to the public without infringing copyright law. In the case of landmarks such as the Gherkin, this is likely to apply.

This is also the case in some other EU Member States, such as Germany³, but not in all. Also watch out for additional copyright-protected work that may feature on the landmark, such as logos or visible artwork. But an exception⁴ exists for “incidental inclusion” of such items in photographs or film. There is also the paternity right, giving the

architect the right to be identified on graphic works or photographs issued to the public representing any building that they have designed.

PRACTICAL IMPLICATIONS

While UK landmarks can obtain trade mark protection, these marks are unlikely to be enforced unless a third party benefited commercially. However, for the enforceability of shape marks in English law, there is a high hurdle to overcome.

Where corporate branding appears on a building, photographers should consider obtaining consent from trade mark owners, even though there is a question as to whether the photograph or film would use the sign as a trade mark, or whether it would affect the function of the trade mark.

Although copyright in some older London buildings may have expired, some newer buildings will still be eligible for copyright protection. For the latter, photographers may be able to avoid infringing copyright by relying on an appropriate defence under English law.

1. Société des Produits Nestlé SA v Cadbury UK Ltd [2016] EWHC 50 (Ch); The Coca-Cola Company, established in Atlanta, Georgia (United States) v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-411/14; The London Taxi Corporation Ltd trading as The London Taxi Company v (1) Frazer-Nash Research Ltd (2) Ecotive Ltd [2016] EWHC 52 (Ch) 2. Section 62, Copyright, Designs and Patents Act 1988 3. According to Article 59 of the “Urheberrechtsgesetz”, (German Copyright Law) 4. Section 31, Copyright, Designs and Patents Act 1988

The Taj Mahal Palace Hotel

TRADE MARKS

On 4th July 2017, the Indian Hotels Company (IHCL) applied to register iconic Mumbai hotel the Taj Mahal Palace in respect of the exterior design under class 43: “services for providing food and drink; temporary accommodation”. This application has not yet reached registration. Applying for this protection was widely thought to be a landmark move for IHCL because, if successful, it would be the first building in India to be granted a registered trade mark.

It is thought the main reason IHCL wants to secure trade mark protection for this building is to protect the unique design and preserve its uniqueness and heritage. However, the authors understand that trade mark protection in India will not be afforded to a building unless there is evidence that “the public recognises [the building] and associates it with the owner’s services”.

PRACTICAL IMPLICATIONS

A key benefit of securing trade mark protection for this iconic building is that IHCL would be authorised to control and limit unfair commercial use of the exterior likeness of the Taj Mahal Palace by third parties that may tarnish or dilute the image.

With this registration in place, third parties would no longer be able to use images of the hotel for commercial purposes without a licence from IHCL, and selling items with the hotel image would be considered an infringement. Yet IHCL’s registration would not prevent individuals taking a picture of the hotel and posting it on social media, as this is considered a “non-commercial” purpose.



Sydney Opera House

TRADE MARKS

The Sydney Opera House, a World Heritage listed landmark, has been protected by a registered trade mark owned by the Sydney Opera House Trust. Australian Trade Mark Registration No 1577707 covers a range of goods and services in a range of classes, and includes the specific wording: “The Trade Mark consists of the 3-dimensional shape as shown in the representation(s) attached to the application”.

The trust also has several additional trade mark registrations for the opera house, including pictorial 2D front and side views of the building.⁵

PRACTICAL IMPLICATIONS

Individuals cannot produce, for commercial purposes, products that display the opera house without first obtaining the consent of the trust, which can, therefore, benefit commercially from its registration by charging a fee to those wanting to produce souvenirs displaying the building.

The trade mark protects a wide range of goods spanning “soaps and cosmetics” in class 3 to “meat, fish, poultry and game” in class 29. This means that the potential for trade mark infringement is far-reaching. For example, a commercial entity or business that wants to post an image of the opera house on a commercial blog or social media page could be prevented from doing so by the trust.

The registration, however, has no impact on photographs that may be taken for personal use, and the trust continues to have no control over this activity.



5. bit.ly/2w08915; bit.ly/2oUz0VL

The Eiffel Tower

TRADE MARKS

The official Société d'Exploitation de la Tour Eiffel (SETE) website outlines that the Eiffel Tower benefits from trade mark protection and lists use of the Eiffel Tower “brand” as “controlled use”, meaning that: “Products may be labelled with this reference following the negotiation of a licensing agreement examined on a case-by-case basis.”⁶

While SETE’s French word and image marks have expired, Ville de Paris (translated as “City of Paris”) is currently the official owner listed on the French Register of several Eiffel Tower registrations. These include French Registration No 3968414 for EIFFEL TOWER as a word mark in a wide variety of classes, and French Registration Nos 99803692 and 99803691 for a 2D depiction of the tower covering all classes.

Interestingly, there are separate filings for the tower at night, covering all classes.

The protection provides Ville de Paris with control over the use of the word mark Eiffel Tower and/or images of the Eiffel Tower by third parties in respect of an extraordinarily wide range of infringing uses for both goods and services.

COPYRIGHT

Photographs taken during the day are not a problem, but when the stars come out different rules apply. The terms differentiate between daylight hours – during which the image of the Eiffel Tower falls in the public domain – and night-time hours, when the tower is illuminated. Taking photos at night is subject to prior

authorisation by SETE and often payment of a fee, which will be determined by the type of media use.⁷

The background to this rule relates to a quirk in copyright protection afforded to the Eiffel Tower. Strictly speaking, the tower’s copyright has expired. Gustave Eiffel died in 1923, so the tower has been in the public domain since 1993 (life of the author plus 70 years). But its lighting (installed in 1985) is a relatively recent addition, and SETE claims this is a copyright-protected artistic work that is separate from the structure itself.

Indeed, whether the lighting of the Eiffel Tower is actually protected separately as an artistic work from the structure itself is an interesting

question. It is socially and legally accepted that the international copyright treaty⁸ gives protection for artistic works including “production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression”, and therefore the lighting could be considered “artistic work” under this treaty. But it is debatable that the lighting would actually be considered an artistic work in an enforcement context. Such a decision has yet to be determined by the courts.

In addition, France is strict in terms of the “freedom of panorama” exception. Under Article 5⁹ of the Copyright Directive, EU Member States can limit copyright protection for works including architecture permanently situated in a public place, but this is not mandatory. Italy, Belgium and France have opted out of this exception, so individuals have to comply with the national laws there as opposed to EU law.

PRACTICAL IMPLICATIONS

During daylight hours, tourists and professional photographers are free to publish and sell pictures of the Eiffel Tower. Even after sundown, an individual taking a quick selfie in front of the tower won’t be caught by this quirk.

However, although copyright protection applies in restricted hours, it’s still advisable to take care not to infringe Ville de Paris’s trade mark rights. For example, anyone planning to sell or publish a photograph of the tower taken in the day, and accompany it with the words “EIFFEL TOWER”, may not be clear of all IP infringements. Using the trade mark protected term EIFFEL TOWER in the course of trade may indeed be a trade mark infringement.



9. Article 5, Directive 2001/29/EC of the European Parliament and of the Council of 22nd May 2001 on the harmonisation of copyright and related rights

6. toureiffel.paris/en 7. toureiffel.paris/en/business/use-image-of-eiffel-tower 8. The Berne Convention

THE LAST WORD FOR TRAVELLERS

Countries continue to distinguish between photographs taken for individual and commercial use. In the latter instance,

IP protection afforded to landmarks is likely to be relied on more heavily by owners. As with any IP protection, however, any

enforceable right is not secure until it has been tested. In the UK, trade mark registries and courts have traditionally been less accommodating in allowing

owners to enforce non-traditional trade marks.

In the meantime, you should be safe to post that Insta of the Gherkin or the Eiffel Tower (during the day)



The Empire State Building

TRADE MARKS

The ESRT Empire State Building, LLC (ESRT) owns several trade mark registrations for the Empire State Building in New York, including: US Registration No 2411972 EMPIRE STATE BUILDING for “entertainment services, namely, providing observation decks in a skyscraper for purposes of sightseeing” in class 41 and Registration 2413667 for “real estate services, namely the management and leasing of real estate” in class 36.

For the 2D depiction of the building, ESRT has a US Registration for similar specifications in classes 36 and 41. According to the description that accompanies the 2D registration: “the mark consists of the shape of the exterior of a skyscraper with a pointed, spindled top. The lining shown in the drawing

is a feature of the mark and is not intended to indicate colour”.

ESRT therefore owns federal registrations for the word mark EMPIRE STATE BUILDING for observation deck, sightseeing and real estate services, as well as design mark registrations for the same services for this 2D depiction of the building exterior. It also has similar protection in the EU for the EMPIRE STATE BUILDING word mark (EU Registration No 15829856) and for the 2D and 3D depictions of the building (EU Registration Nos 15829815 and 15817075).

PRACTICAL IMPLICATIONS

The enforceability of these registrations played out in 2016 in US opposition proceedings, ESRT Empire State Building, LLC v Michael Liang.¹⁰ The Respondent used a picture of the building on beer

bottles without obtaining consent or a licence from ESRT. The Respondent also applied to register the logo in 2011 with the intent to use the mark in commerce for alcoholic and non-alcoholic styles of beer.

The Trademark Trial and Appellate Board found that ESRT’s mark was: famous for the purposes of dilution; inherently distinctive or had acquired its distinctiveness through its exclusive use of its mark; and had a strong degree of recognition. The Board ruled that the Respondent’s beer logo was likely to cause dilution by blurring ESRT’s mark, and ruled in ESRT’s favour.

The case shows it is risky to use all or part of this famous mark, whether it consists of words and/or a design; if you plan to, you must secure permission from the rightful trade mark owner before proceeding.

Note, however, the contrasting case of Rock and Roll Hall of Fame and Museum v Gentile Production¹¹, where a museum’s building design was registered as a trade mark. Photographer Charles Gentile took a picture of the museum and sold posters that used this image. The museum sued Gentile for trade mark infringement in respect of the image, but was unable to produce evidence to demonstrate that the public relied on the building as a trade mark.

The case ultimately failed because the public had not relied on the landmark museum to identify the source of the owner, and therefore it could not be held to be a valid trade mark, and should not have been registered. Based on this case, this will be a key distinguishing factor when deciding whether the registered trade mark protection for a building is valid and enforceable. ●

10. ESRT Empire State Building, LLC v Michael Liang, Opposition No. 91204122 (TTAB 17th June 2016)

11. Rock & Roll Hall of Fame & Museum, Inc v Gentile Prod, 71 F. Supp. 2d 755 (ND Ohio 1999)

for personal use, but think twice if money is going to change hands for the image.

The Christ the Redeemer statue in Rio de Janeiro, Radio City Music Hall in New

York, and St Peter’s Basilica in Rome are just some of the other landmarks that have copyright restrictions based on commercial and/or editorial use.



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The feeling's not mutual

Heather Williams on why IPEC refused to extend the tort of passing off

This case confirmed that, in principle, the law of passing off can protect goodwill associated with the name of a type of organisation. However, the Claimant was not successful in its bid to show that there was sufficient goodwill in the term “mutual” when “mutual” is defined as an organisation owned solely by all or some of its customers.

PARTIES AND BACKGROUND

The Claimant, The Military Mutual Ltd (MML), arranges the provision of insurance services to existing and past members of the armed forces and their families. The first Defendant, Police Mutual Assurance Society Ltd (PMAS), is the successor company to an association set up in 1866 to provide financial and welfare support to police officers, police staff and their families (the Police Force). During the trial it emerged that PMAS's direct dealings are still with the Police Force only, and MML accepted that PMAS's activities with the Police Force qualified it as a “mutual” within MML's definition.

The second to fourth Defendants are subsidiaries of PMAS (together Forces Mutual). In April 2016, the website forcesmutual.org was set up, offering insurance services and operated by the second and fourth Defendants. The financial services offered by Forces Mutual include insurance for military kit, life insurance, dental and health insurance, and other financial products, such as mortgages and savings products.

CLAIM BASIS

The proceedings concerned the use of the word “mutual” in Forces Mutual's trading name. Forces Mutual does not allow customers who are members of the armed forces to become members and part owners of Forces Mutual or PMAS. Accordingly, MML claimed that Forces Mutual was not a mutual entity within MML's definition. MML's case was that

its status as a mutual gives it a cause of action for passing off against Forces Mutual. MML claimed it would have no objection if Forces Mutual's trading practices were changed to bring them within MML's definition of a mutual or if the word “mutual” was excluded from the trading name.

OTHER ISSUES

HHJ Hacon provided that, in extended passing off cases, the claimant must establish goodwill in the collective business in a type of product, that the name is distinctive of that type of product among a significant proportion of the public, and that the ownership of the goodwill is shared among the relevant traders of that class of products.

MML argued that “mutual” unambiguously meant a stated type of organisation. However, MML failed to consistently define the term in either the pleadings or in the course of the trial. MML claimed that, by April 2016, the public recognised the term “mutual”, when used in the context of financial organisations, as designating a specific category of financial organisation, being one solely owned by at least some of its customers. By April 2016, MML had been trading for one year and claimed it shared the collective goodwill owned by financial organisations associated as a mutual.

MML accepted that PMAS operated as a mutual, but argued its subsidiaries trading as Forces Mutual did not. As Forces Mutual did not offer products that confer on the purchaser membership and part ownership of PMAS or Forces Mutual, the use of the term “mutual” in its trading name amounted to a misrepresentation.

MML argued that the false representation had resulted in a loss of business, and further that Forces Mutual's use of “mutual” diluted and therefore damaged the collective goodwill associated with a financial mutual.

THE MAIN ISSUE

It was common ground that “mutual” has at least one broad meaning recognised by the relevant public. That meaning was interpreted to include some understanding that a mutual has no shareholders and is owned by stakeholders, who may be employees, customers or individuals of other kinds. However, it was noted that there are many examples of organisations described as mutual that are not owned solely or at all by customers, for example the John Lewis Partnership.

MML argued that, in the case of financial mutuals, there was a second, distinct and narrower meaning of “mutual”. This definition included the apparently well-known feature



KEY POINTS

✦ In principle, the law of passing off could protect goodwill associated with the name of a type of service or organisation

✦ Clearly defining the goodwill relied on is key to succeeding in this type of claim



“ MML argued that Forces Mutual’s use of the term ‘mutual’ diluted and therefore damaged the collective goodwill

that the organisation is owned solely by some or all of its customers.

Forces Mutual’s principal argument was that there was only one broad meaning of “mutual” and that if there existed any goodwill it was therefore shared by all mutuals operating within that broad meaning. Because Forces Mutual’s trading activities fell within the broad definition of a mutual, it was claimed there could be no misrepresentation when MML started to trade in April 2016, as, at that time, the Forces Mutual constituent companies were joint owners of the goodwill.

Various dictionary definitions were submitted and multiple witnesses were called to weigh in on the definition of a “mutual” in the context of a financial organisation. The evidence did not support the claim that the relevant public believed financial mutuals are invariably owned by some or all of their customers. MML’s witnesses confirmed that many organisations acknowledged to be mutuals fell outside MML’s definition. It was concluded that the term “mutual” had only one known broad meaning.

HHJ Hacon did not accept that any significant part of the public held the belief that, in the context of financial organisations, “mutual” meant that it must be owned solely by all or some of its customers. Accordingly, it was held that the shared goodwill asserted by MML did not exist and the claim was dismissed.

OPEN DOOR

Though the Claimant was unsuccessful, HHJ Hacon has left open the door to others who may seek to rely on collective goodwill associated with a service or type of organisation. However, it is clear that, in order to succeed, it is necessary to succinctly define the class of service and demonstrate this singular meaning is associated by the relevant public with the services in question.



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La guerra della moda

A fashion-brand conflict turned on genuine use, bad faith and passing off, reports Jade MacIntyre

KEY POINTS

* Summarises the CJEU and domestic case law on targeting, and the factors that will determine whether online offers containing trade marks are targeted at the UK or other EU Member States (and therefore represent genuine use in those countries)

* Suggests that trade mark applications will not be bad faith just because they are filed during dispute negotiations and are intended to bolster a party's negotiating position. This is the case even if the applicant does not inform the other party of the application

This case concerned what Mr Justice Arnold called a “trade mark war” between two well-established fashion businesses. Both had used the Italian-sounding GIORDANO mark since the 1980s, the first Claimant’s (Walton) main markets being Asia, Australasia and the Middle East, and the Defendant’s (Verweij) main market being Europe. While neither party is an Italian company, the brands had been inspired by the name of a pizza restaurant and a wine brand respectively.

The case featured Walton’s claim for the infringement of various UK and EU trade marks and Verweij’s counterclaim for revocation for non-use and/or invalidity (on the grounds of bad faith and passing off). Ultimately, all of Walton’s marks, save for one UK mark, were revoked for non-use. The remaining mark was invalidated on the basis of passing off, and Verweij’s passing off counterclaim was also successful.

DISCONTINUANCE

On the “eve of trial”, Walton filed a notice of discontinuance in relation to infringement of its EU trade marks. Verweij applied for the notice to be set aside, arguing that Walton was seeking to shield its EU marks from a determination of validity by the Court. Arnold J concurred and set aside the notice as an abuse of process. He explained that, if the notice were to be permitted, it would only be on the condition that Walton undertook not to assert the EU marks against Verweij in any other EU Member State or rely on



them before EUIPO. Even if the discontinuance were not an abuse, the Court would have still set the notice aside so as to determine all issues justly and at proportionate cost.

REVOCATION FOR NON-USE

Verweij sought and obtained revocation of all of the trade marks save for one UK mark. Arnold J pointed out that revocation for non-use was “the most important issue in the case”.

The judge divided up the question of genuine use by Walton of the GIORDANO mark in the UK/EU by Walton into:

1. offline use in pop-up stores and by means of a licence agreement; and
2. online use in the form of (a) advertising and offers for sale; and (b) specific sales.

In respect of offline use, the Court agreed with Verweij that pop-up stores represented token use, ie non-genuine use for the purpose of trying to maintain trade marks. It was accepted that the online use was not merely token.

SALES CONSIDERED

The Court considered Walton’s online offer of GIORDANO branded clothing, especially on its “global e-shop”, and whether this targeted the UK or elsewhere in the EU. Arnold J considered a number of CJEU and domestic authorities, and favoured the judgment of Mr Daniel Alexander QC sitting as a Deputy High Court Judge in *Abanka dd v Abanca Corporación SA* [2018] Bus LR 612, which he found to be consistent with CJEU case law. This judgment emphasises that mere online visibility of the mark in the UK and the possibility of deliveries to the UK were not sufficient to establish genuine use. A proprietor has only targeted the UK/EU and genuinely used its mark therein if it has “itself ‘pushed’ its business and mark into the UK [or EU], not if it has been ‘pulled’ into the UK [or EU] by (for example) its customers abroad, even though they may be based in the UK [or EU]” (see paragraph 103 *Abanka*).

While the e-shop offered delivery to the UK and the EU, Arnold J noted it offered delivery to nearly all countries in the world and that prices and payment were in US dollars. The e-shop had no UK or EU address, phone number or email address. Further, while data showed that there had been UK and EU visits to the website, there were reasons to believe many of these visits were from people from countries in the Claimant’s core markets who were temporarily in the UK/EU. Considering these and other factors, Arnold J concluded the online offer was not targeted at the UK or any country in the EU. The websites did not “push” advertisements to the UK/EU, but rather were “pulled” into these jurisdictions

“ In respect of offline use, the Court agreed with Verweij that pop-up stores represented token use, ie non-genuine use

by users who had encountered the Claimant’s mark while in the Claimant’s core markets.

SPECIFIC ONLINE SALES

While the advertisements and offers for sale were not targeted at the UK or EU, and therefore did not represent use of GIORDANO in three jurisdictions, the Court considered that specific sales to customers did represent use of GIORDANO in relation to clothing in the UK and the EU. However, the Court considered the number of sales to be commercially insignificant in the context of the Claimant’s own business, and also in comparison to the enormous fashion market in the UK/EU more generally. Due to the *de minimis* nature of the sales, while there had been use, there had been no genuine use of the marks.

BAD FAITH

Verweij’s claim that Walton’s most recent UK trade mark application had been in bad faith because (*inter alia*) it was an illegitimate attempt to bolster its position in negotiations was dismissed. Although the parties were already in discussions and Walton did not inform Verweij of the filing, the “trade mark war” had already started. It was clear to both parties that the other side would take steps it considered appropriate to protect its interests.

INSTRUCTIVE CASE

The setting aside of the discontinuance and the revocation of EU marks despite the pending EUIPO proceedings is instructive of the high level of discretion the English courts have in conducting trade mark proceedings. This case also provides a good summary of the law on targeting in relation to online offers and whether use is *de minimis*. Further, it shows that the English courts will be slow to classify applications as bad faith when they are tactical moves within a genuine trade mark dispute.



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Nothing beats a trade mark

Richard May summarises a case that was fast and flurry-ous

LNDR (pronounced L-N-D-R), a premium activewear brand, has successfully sued Nike for trade mark infringement and passing off in IPEC within five months of issuing the claim form. The judgment shows the speed at which the English IP courts can act when a case is urgent.

The claim was brought by Frank Industries, the owner of UK and IR (EU) trade marks for LNDR, registered in respect of, among other things, “clothing ... sportswear” in class 25 (the LNDR Marks). The Defendants were entities in the Nike group. Frank Industries complained about Nike’s use of the sign LNDR in its high-profile “Nothing Beats a Londoner” campaign, which commenced in January 2018 and quickly gained popularity in a blaze of social media activity. The complaint was directed at phrases like “Nothing beats a LNDR” and “Show you’re a LNDR”, but also against the signs depicted opposite, where LNDR was used in conjunction with Nike’s swoosh trade mark on, for example, clothing.

PRETRIAL ACTIVITY

The full trial was preceded by a flurry of activity. Frank Industries sent a letter before action on 26th January 2018 and subsequently applied for an interim injunction on 19th February 2018. Frank Industries was able to rely on evidence of actual confusion because three witnesses, on seeing the sign LNDR in the Nike campaign, believed that Frank Industries and Nike were collaborating. On 2nd March 2018, HHJ Hacon granted an interim injunction and directed an expedited trial of the claim at the Claimant’s request. Nike appealed, but on 13th March 2018 the Court of Appeal substantially upheld HHJ Hacon’s decision. The net result was that Nike was forced to stop using LNDR in

its campaign and archive or blur past references to LNDR on most of its social media accounts, pending a full trial.

FULL TRIAL FAST

The importance of the case to both parties was reflected in the speed with which the claim came to trial. Five months after issuing the claim, the full trial took place in IPEC before Mr Justice Arnold. The main issues to be decided were:

1. the validity of the LNDR Marks;
2. infringement under Article 10(2)(b) of the Trade Marks Directive (the Directive) and Article 9(2)(b) of the EUTM Regulation (the Regulation); and
3. Nike’s defence under Article 7(1)(b) of the Directive and Article 14(1)(b) of the Regulation.

On the first issue, context was key. Nike argued that the LNDR Marks were invalidly registered by virtue of being inherently descriptive as an abbreviation meaning Londoner. Frank Industries disagreed and stated that, even now, people ask what LNDR means. Indeed, Nike was unable to point to any dictionary reference that defined LNDR as Londoner. Instead, Nike largely relied on social media posts featuring references to “Lndr” meaning Londoner. The Court was not persuaded. While the meaning of “Lndr” in the online posts may have been clear by their context, ie London-related topics, this failed to establish that LNDR would be perceived by consumers as meaning Londoner when used in the context of clothing. Consequently, the Court concluded the LNDR Marks were valid and inherently distinctive to a moderately strong degree.

CONFUSION QUESTION

On the second issue, the Court was quick to conclude LNDR is similar to LNDNR: the marks being identical save that the middle two letters are transposed. Neither did it hesitate to conclude that the contested goods (clothing) were identical. The main concern was whether Nike had used LNDR “in relation to clothing”, ie as a trade mark. Nike argued it had not. Nike contended: (1) its famous trade marks, NIKE

“ Nike argued that the LNDR Marks were invalidly registered by virtue of being inherently descriptive



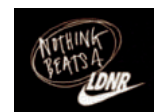
KEY POINTS

- ✦ The Court had to consider how the public would perceive LDNR and LNDNR in context
- ✦ The Claimant succeeded in bringing an expedited claim for trade mark infringement and passing off in IPEC five months after issuing the claim

NIKE'S USE OF LDNR EXAMPLE 1 (THE LOCK-UP)



EXAMPLE 2 (THE NBAL LOCK-UP)



Osborne Clarke acted for Frank Industries in the proceedings.

and the swoosh, clearly denoted origin; and (2) consumers would not perceive LDNR as denoting origin because they would perceive it to mean Londoner. The Court considered the evidence, which included the Lock-up (see right) on Premier League football advertising boards and on T-shirts worn by the likes of Sir Mo Farah and bearing the ® symbol next to both the swoosh and the sign “LDNR”, and concluded that Nike did use LDNR “in relation to” clothing. This conclusion was supported by the Court’s assessment that, when Nike launched its campaign in January, LDNR was not an established or recognised abbreviation, even though in some contexts it was capable of being understood by some as meaning Londoner. It followed that Nike had infringed the LNDNR Marks due to a likelihood of confusion.

On the third issue, Nike argued that, even if there was a *prima facie* case of infringement, it could rely on the defence of honest descriptive use. To establish this defence, Nike had to show that LDNR indicated a characteristic of the goods and that the sign had been used in accordance with honest practices. For the reasons already discussed, the Court decided LDNR was not an indication of any characteristic of clothing. In terms of honest use, the Court considered several factors, including: Nike’s knowledge of the LNDNR Marks (having conducted a clearance search six months before launching its campaign); that Nike should have appreciated that there was a likelihood of confusion and that Frank

Industries would object; continued use of LDNR by Nike would interfere with Frank industries’ ability to exploit the LNDNR Marks; Nike did not establish sufficient justification for using LDNR; and Frank Industries complained very quickly. In light of these factors, the Court did not consider that Nike acted fairly and it would not be in accordance with honest practices for Nike to continue its use of LDNR in the future. Accordingly, Nike’s defence failed.

CONTEXT IS KING

This case highlights the importance of how signs are perceived in context, particularly non-dictionary defined terms. In this case, context was king and the Court was satisfied that enough people would perceive LDNR as a brand name, despite accepting that some would understand it to mean Londoner. It must have helped that Frank Industries was able to provide three witnesses who were confused into thinking there was a collaboration between the two parties. The case also highlights the speed with which IP courts are prepared to act in urgent matters, which is very necessary in today’s digital age.



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A healthy disagreement

Ben Evans reviews a decision regarding overlapping scope

This case concerned a 6th March 2003 exclusive UK trade mark licence agreement pursuant to which the licensor (the predecessor of GNIC) gave the licensee, Holland and Barrett, an exclusive right to use seven registered trade marks.

Of those marks, only two were used by the licensee. The other five were not used for a period of five years before the trial. Sections 46(1)(a) and (2) of the Trade Marks Act 1994 (TMA), Article 58(1)(a) of Council Regulation 2017/1001 and clause 5.6 of the licence all provided for revocation of a licence for non-use.

Warren J had agreed with GNIC that on termination of the licence of the five marks for non-use, GNIC was entitled to use those marks freely, and he held that it was not necessarily implicit in the exclusive licence of one mark that GNIC would not make use of any of the other marks (all of which were similar, incorporating the letters GNC), as the other marks were already subject to their own exclusive licences. The Court of Appeal held that this was wrong because it treated marks with overlapping scope as if they were distinct and ignored a key express term of the contract, the conventional exclusivity clause, through which the licensor had agreed not to use confusingly similar marks.

RIGHTS CLARIFIED

It is not controversial that, while a licence is in force, the licensor is not free to use

any confusingly similar mark in the territory on relevant products that would be in breach of the exclusivity clause in the licence. The Court of Appeal clarified that the licensee's rights against the licensor were only contractual in nature – an act committed by the licensor was not an infringing act under the Trade Marks Act 1994 because it had the

consent of the owner of the trade mark, the licensor itself.

The effect of this decision is that where there is a conventional exclusive licence (ie where the licensor agrees not to use marks that are confusingly similar) in place for a number of trade marks of overlapping scope, if the licence is validly

terminated for non-use in relation to some of those marks, the licensor does not acquire a right to carry out any act in relation to the marks with terminated licences that would amount to a breach of exclusivity of the licences that remain in force.

COROLLARY

The corollary is that the licensor is free to use the marks in respect of which the licence has been revoked, notwithstanding the remaining licence over other marks, if it can do so in a manner that does not breach the terms of the remaining licence. In practice, this would mean, for example, use in a different territory and/or for different products.

KEY POINTS

- ✦ Where a licence is validly terminated for non-use in relation to some marks within a licensed set, the licensor does not acquire a right to carry out any act that would amount to a breach of exclusivity of the licences that remain in force
- ✦ Where there is a licence for the exclusive use of particular trade marks, the licensee's rights against the licensor are contractual rather than statutory because, to be an infringing act, use of a mark must be without the consent of the owner of the mark, ie the licensor

“

The licensor is free to use the marks in respect of which the licence has been revoked if it does not breach the terms of the remaining licence



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Tough time for Trump TV

Robert Cumming considers this an extraordinary decision

On 4th July 2018, the Registrar gave his decision in opposition proceedings brought by DTTM Operations LLC (DTTM) against an application to register TRUMP TV. This was UK application number 3193965 filed by Trump International Ltd (TIL) seeking protection in relation to various telecommunications and film production services in classes 38 and 41.

The Opponent is the owner of registrations for the word TRUMP (EUTMR 10289064 in classes 9, 28, 41 and 43) and the TRUMP logo (shown below) (EUTMR 10289064 in classes 18, 24, 25, 28, 36, 41, 43 and 44). It claimed that, under s5(2)(b) of the Trade Marks Act 1994 (the Act), the goods in its registrations – including cash registers, fire-extinguishing apparatus, animal skins and whips – are similar to, for example, satellite communication services.

The Opponent also claimed under s5(3) that it has a reputation in the word TRUMP in relation to golf equipment and sports and conference facilities and that, under s5(4), it has rights in passing off that would be infringed through the use of TRUMP TV. Finally, the Opponent alleged that the application was filed in bad faith under s3(6).

MALA FIDES?

The Hearing Officer (HO) considered Red Bull¹ to determine whether the Opponent acted in bad faith. He noted the evidence addressed the reputation and goodwill aspects of ss5(3) and 5(4)(a) and that the Opponent is not linked to Donald Trump, a presidential candidate at the time of application.

The Opponent's evidence also included an article from *World Trademark Review*, which

speculated as to the Applicant's owner's business model. The HO noted that the fact the Applicant's owner owned a large number of other registrations "... cannot of itself sustain a claim of bad faith". The HO acknowledged a connection to film production services and investment in technology businesses. However, the HO was uncertain about the Applicant's motives and found it likely the intention was to gain advantage from a link to the Trump name.

In summary, the marks are not identical and there was no registration for TRUMP in relation to class 38 services; the unrepresented Applicant filed only a basic counterstatement, no evidence, no response to the other side's evidence and no written submissions; the HO recognised a professional background but found not only that he was uncertain about the Applicant's motives, but also that it was acting in bad faith and its actions were so egregious it should pay off-the-scale costs of £15,105.70.

EXTRAORDINARY OUTCOME

The HO inferred bad faith at least partly on the grounds of a lack of intention to use under s32(3). That is arguably contrary to the Trade Marks Directive 2008/95/EC, which is the precise question referred to in Sky Plc.² The decision is on appeal to the High Court.

KEY POINTS

- ✦ The case raises the question of whether s32(3) of the Trade Marks Act 1994, which requires an intention to use a UK trade mark at the time of filing, is compatible with the European Trade Marks Directive (2015/2436/EU)
- ✦ In addition, does an overly broad specification render the entire trade mark registration invalid? If so, will this lead to an increase in invalidity proceedings for "kitchen sink" trade mark specifications?
- ✦ Finally, should third parties be able to oppose under s3(6) even if they have no rights?

EU TRADE MARK
NUMBER 10289064



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1. Red Bull GmbH v Sun Mark Ltd and Sea Air & Land Forwarding Ltd [2012] EWHC 1929 (Ch)

2. Sky Plc & Ors v SkyKick UK Ltd & Anor [2018] EWHC 155 (Ch)

Appleyard Lees IP LLP is representing TIL in the High Court.

No support for decking claim

The Applicant's evidence was put to the test, writes Dale Carter

In 2016, G&M Safe Deck Ltd (the Applicant) applied to register a pure-colour mark for "Safety platform decking made of High-density polyethylene (HDPE), all for use in the house building industry" in class 19. The application included an acceptable claim to the colour Orange, Pantone 1595C.

A s3(1)(b) (Trade Marks Act 1994) objection was overcome at a hearing based on evidence of acquired distinctiveness through use. Following its publication, J. Mac Safety Systems Ltd (the Opponent) opposed the application under ss3(1)(a) and 3(1)(b), although the s3(1)(a) objection was later dropped.

ILLUSTRATIVE EVIDENCE

The Applicant's evidence covered a full five-year period and included evidence of third-party safety platform decking in colours other than orange. Correspondence solicited from the trade and the Applicant's own customers was also filed confirming that orange safety decking was distinctive of the Applicant. Much of this evidence was not presented in witness statement format.

Sales revenue figures were provided (amounting to some £3m between 2011 and 2017), together with a selection of sales invoices and evidence of market share. The Applicant (who spent only £200 per year on advertising) provided copies of a small number of marketing communications, a sales brochure and a list of companies targeted for marketing purposes. Google Analytics data was submitted, which showed an increasing trend in visits to the Applicant's website.

The Opponent filed evidence illustrating that third parties used red, orange and other colours in relation to safety platform decking, and criticised the Applicant's market share and revenue figures, which were low in the context of its own figures as well as others in the same market.

In assessing the parties' evidence and applying the principles set out in *Windsurfing and Libertel*, the Hearing Officer (HO) found that the Applicant's sales figures were respectable, if low. The Applicant's market share of between five and eight per cent was considered reasonable, but the lack of advertising did not assist its case. Much of the Applicant's third-party evidence was solicited for the proceedings and it included a direct request to a trade body to provide a statement confirming that orange decking was distinctive of the Applicant. While the HO

considered this evidence to carry "some weight", it was weak on account of being hearsay.

The HO was not persuaded that the evidence supported a claim to acquired distinctiveness and refused the application.

This decision highlights the importance of testing evidence robustly. It also illustrates the importance of third parties "policing" the trade mark registers so that the opportunity to challenge the acceptance of a mark is not lost, and a third party does not acquire trade mark rights that are unjustified in terms of their subject matter and/or scope. When the subject matter of a trade mark is colour, it is arguably all the more important for trade mark owners to be vigilant, so that they do not lose the ability to use the same or a similar colour in the sector concerned.

“
The evidence carried some weight but was weak on account of being hearsay”

KEY POINTS

✦ Soliciting evidence for use in proceedings may lead to that evidence being given little weight or discounted entirely

✦ If evidence supporting a claim to acquired distinctiveness is not tested with sufficient rigour it may lead to a mark being accepted that should otherwise be refused

✦ Watching services can be a useful tool to enable an early objection to be raised where it appears that a third party may be granted an unjustified trade mark monopoly



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Fenyves left feeling blue

Rose Smalley explains that token stylistic elements will not help descriptive marks

The General Court (GC) has affirmed the Board of Appeal (BoA) decision that an application to register the figurative mark BLUE in class 32 for “Soft drinks and non-alcoholic beverages, with the exception of energy drinks and isotonic sports drinks” could not be accepted, as the unremarkable stylistic elements of the representation were insufficient to overcome the inherent descriptiveness of the mark.

The Applicant, Klaudia Patricia Fenyves, appealed the BoA decision on the basis of infringement of Articles 7(1)(c) and 7(1)(b) of Council Regulation (EC) No 207/2009. On the first limb, the Applicant argued that the BoA was wrong to consider the word element descriptive, and the figurative elements banal and commonplace.

Under Article 7(1)(c), descriptiveness is assessed from the perspective of the relevant public, in relation to the goods and services concerned. The GC swiftly rejected the Applicant’s arguments that the BoA had mischaracterised the average consumer’s level of attention, as it had correctly identified they would be reasonably well informed, observant and circumspect.

The GC reiterated that it is unnecessary that the signs and indications composing the mark are actually being used in a descriptive sense; it is sufficient that such signs and indications might be used for such purposes. Therefore, a word sign must be refused registration if at least one of its possible meanings designates a characteristic of goods or services concerned.

The GC concluded that the word “blue” was descriptive because:

- blue would be naturally understood by the relevant public (the general public being English-speaking territories of the EU) immediately and without further thought, as referring to the colour blue;

- it was common knowledge that terms denoting colour may be used to designate goods in the drinks sector; and
- manufacturers may use colour to distinguish beverages and therefore it may be perceived as a significant characteristic of the goods in question, important to drawing custom.

It was also held that the figurative elements were not eye-catching or memorable; in particular, the typeface and diagonal setting were unlikely to draw attention, and the colours used were “ordinary”. The GC affirmed the BoA’s finding that the graphic representation was not sufficient to distract the relevant public from the descriptive message conveyed by the word element.

Having made its finding on Article 7(1)(c), it was sufficient that one of the absolute grounds for refusal applied to the mark, so the GC did not examine the merits of the plea regarding breach of Article 7(1)(b).

The GC provided interesting commentary about relying on earlier registrations in support of applications. It confirmed that, while examiners must take previous applications into account

to ensure equal treatment and sound administration, the examination must still be stringent and full in each case, bearing in mind the particular factual circumstances, with the purpose of determining whether the sign is caught by a ground for refusal.

“
It was held that the elements were not eye-catching or memorable”

KEY POINTS

✦ Figurative elements will only assist descriptive signs where they are memorable, eye-catching and distract from the descriptive message

✦ Although examiners will consider previous similar applications, this will not be determinative in securing a similar registration

THE APPLICANT’S FIGURATIVE MARK

Blue



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Adieu to france.com

State symbols were held to be too similar,
says Jack Weaver

On 9th August 2014, France.com, Inc. filed an EU trade mark application for a mark covering classes 35, 39 and 41 (shown right, top). The French Republic opposed the application on the basis of its prior international registration (which designated the EU) (shown bottom right), covering classes 9, 35 and 41. The opposition was based on a likelihood of confusion per Article 8(1)(b) of Regulation No 207/2009 (now Article 8(1)(b) of Regulation No 2017/1001).

The opposition was rejected by the Opposition Division. However, this decision was annulled on appeal by the French Republic, it having been held that there was an average degree of visual similarity and that the marks were phonetically and conceptually identical. France.com, Inc. appealed against the annulment.

GC DECISION

The General Court's (GC's) ruling focused on re-evaluating the likelihood of confusion per Article 8(1)(b) of Regulation No 207/2009.

On the issue of visual similarity, the GC reiterated that, even though the signs contain similar word elements, this did not mean they were visually similar. It disagreed with the Board of Appeal's (BoA's) finding that the signs were visually similar, stating that: the Eiffel Tower was represented in different ways; the word element was depicted in different ways (different fonts and cases were used, and the Applicant's sign included .com); and finally, though the same colours were used, the Applicant's sign was predominantly blue, whereas the earlier mark

was predominantly black. Overall, the signs were held to have a low degree of visual similarity.

The GC held that any figurative elements should not be taken into account for the purposes of phonetic similarity. It agreed with the BoA that the signs were almost identical, as many consumers will refer to the Applicant's mark as "France" and perceive ".com" as referring to a website.

The GC also agreed with the BoA that the signs were conceptually similar, because both contain almost exclusively elements that refer to the same concept – the state of France – including the Eiffel Tower and tricolour flag. The pentagon on the Applicant's mark also brings to mind the shape of France.

LIKELIHOOD OF CONFUSION

The ruling confirmed there is a likelihood of confusion due to a high degree of phonetic and conceptual similarity. The Applicant submitted that, in the 21 years it had operated france.com, there were no instances of confusion, and the French Republic had supported its services for many years. However, the GC noted that "the repute of a trade mark is relevant, in assessing the likelihood of confusion, only as regards the repute of the earlier mark".

EARLY WARNING

This decision is again a warning that trade mark registration should be sought as early as possible. Even though the French Republic promoted the Applicant's domain for more than two decades, it eventually seized control of the domain and put a redirect in place to the state-run tourism agency, triggering this long-running trade mark dispute.

KEY POINT

- Business owners should obtain trade mark protection as early as possible, especially when a geographical name is included in the mark

THE FRANCE.COM MARK



THE FRENCH REPUBLIC'S MARK



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Cava case goes flat

The Court saw the distance between a PDO and a contested mark, explains Melanie Stevenson

Cave de Tain L'Hermitage, union des propriétaires, registered with EUIPO the CAVE DE TAIN logo (shown below right) in respect of “wines with a registered designation of origin; vin de pays” in class 33. Consejo Regulador del Cava applied to declare the Contested Mark invalid on the basis that it was an evocation of the protected designation of origin (PDO) CAVA under Article 7(1)(j) of Regulation No 207/2009 (now Regulation 2017/1001) and Article 52(1)(a) of that regulation (now Article 59(1)(a) of Regulation 2017/1001), read together with Articles 118l and 118m of Council Regulation (EC) No 1234/2007.

The Cancellation Division dismissed the invalidity action, finding that similarity between the signs was limited (with the visual differences being particularly significant), that the understanding of “cave” to mean “wine cellar” was not limited to French consumers, and that no evidence had been presented in support of the notion that the Contested Mark evoked the PDO.



EVOCATION EXPLORED

The Board of Appeal (BoA) upheld the decision of the Cancellation Division. Exploring the concept of “evocation” of a PDO, the BoA found that it was necessary to take into account the function of the PDO, specifically “the protection of the geographical origin of a product with which specific qualities or characteristics are associated because of that origin”.

CAVA, the BoA said, was a “descriptive term referring to sparkling wine from Spain and a dictionary Spanish word meaning ‘cave’ (‘cellar’) in French or ‘wine cellar’ in English”. The Contested Mark does not refer to the geographical origin of Cava. In fact, CAVA could only evoke a Spanish origin of Cava, whereas the Contested Mark could only evoke a French origin. If consumers did not understand the

French or Spanish meaning of CAVE or CAVA, that would only further distance the Contested Mark from the PDO.

GC AGREES

The General Court (GC) upheld the decision of the BoA. The Applicant had argued that consumers associate particular qualities

with products protected by the PDO CAVA independently of the origin of those products. In response, the GC repeated the definition of a PDO at Article 93(1)(a) of Regulation No 1308/2013, from which it follows that the characteristics associated with products protected by PDOs are inextricably linked with their geographical origin. The GC also confirmed that the differences between the PDO and the Contested Mark precluded the possibility of evocation of the PDO.

KEY POINTS

- ✦ The “essential function” of a geographical indication is to “guarantee to consumers the geographical origin of goods and the special qualities inherent to them”
- ✦ The qualities and characteristics associated with protected products are inextricably linked with the geographical origin of those products

THE CONTESTED MARK



“
CAVA could only evoke
a Spanish origin,
whereas the Contested
Mark could only evoke
a French origin



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Cheese applications take a grilling

Jack Kenny explains why popularity put paid to a certification mark argument

The General Court (GC) has upheld the decisions of an EUIPO Board of Appeal, which had rejected oppositions brought by the Republic of Cyprus (the Opponent) against two EU trade mark (EUTM) applications concerning the word “halloumi”.

Back in 2012, the Interveners in the two cases, Papouis Dairies Ltd and Pagkyprios organismos ageladotrofon Dimosia (POA), filed EUTM applications for two figurative signs – PALLAS HALLOUMI and COWBOYS HALLOUMI (shown below right), respectively. Both applications covered “cheese made out of cow’s milk and/or sheep’s milk and/or goat’s milk ... salt, rennet”. The Republic of Cyprus opposed both applications, claiming that they would result in a likelihood of confusion with its earlier UK certification mark for HALLOUMI and cause detriment to the reputation of the mark.

The Board of Appeal (BoA) rejected both oppositions, finding that the shared word element “halloumi” had only a weak distinctive character. Further, the BoA held that the Opponent had failed to prove that the UK public would perceive its mark as a reference to a certification. As a result of the differences between the marks, coupled with the weak distinctive character of the certification mark, there was no likelihood of confusion. The Opponent sought to annul the decision, contesting that the BoA had erred in its findings.

Finally, the BoA found that the Opponent had not proved that its certification mark had acquired a reputation.

LINK LACKING

Referring to its previous judgments (joined cases T-292/14 and T-293/14 HALLOUMI and XAΛΛΟΥΜΙ), the Court noted that the term “halloumi” was perceived by the Cypriot public as designating a speciality cheese from Cyprus. The Court agreed that this could be extended to the public of the UK. Indeed, evidence filed by the Opponent, including sales volumes and

marketing materials, supported the idea that the general public perceived halloumi as a speciality cheese from Cyprus. However, it did not show that the term “halloumi” was understood as linked to a certification mark.

As a result, the Court upheld the BoA’s finding that the UK public would not understand the term “halloumi” as “an indication of its certified quality”. The Court agreed with the BoA’s conclusion that the earlier certification mark possessed a weak distinctive character as a result of its descriptive meaning.

The BoA also agreed with the Court’s assessment of a low degree of similarity between the marks, given the weak distinctive character of the term “halloumi” and the differences between the signs in question. It followed that, despite the identity of the goods and the common presence of the descriptive term “halloumi”, there was no likelihood of confusion between the earlier certification mark and the contested applications.

COMMON PROBLEM

The decision demonstrates the difficulty in relying on certification marks where the term has become so commonly used that the relevant public is not accustomed to perceiving it as a certification. Had the Republic of Cyprus been able to demonstrate that the UK public recognised the certification mark as such, then the Court may have been more willing to find an enhanced distinctive character of the mark, which could have offset the differences with the contested applications.

KEY POINTS

- ✦ The GC held that the term “halloumi” possesses a weak distinctive character, and the UK public would not perceive the term as “an indication of its certified quality”
- ✦ The decision demonstrates the difficulty in relying on certification marks where the term has become common or generic

THE INTERVENERS’ SIGNS



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Promising precedent

Earlier decisions can be evidence of reputation, reports Suzan Ure

KEY POINTS

✦ Evidence consisting of earlier decisions must be considered

✦ Sufficient reasoning for departing from earlier decisions must be provided

✦ There may be more certainty or predictability where previous decisions have been decided, particularly for reputation-based Article 8(5) claims where previous decisions have found a mark to have reputation

In February 2013, Gemma Group filed an EU trade mark application for a figurative mark featuring bounding felines in class 7 for “machines for processing of wood; machines for processing of aluminium; machines for treatment of PVC”, which was subsequently opposed by Puma under Article 8(5) of Regulation (EC) 207/2008. Puma considered that the applied-for mark was similar to its earlier international registrations “with reputation” for two marks covering baggage-related goods, clothing, games and sports equipment in classes 18, 25 and 28.

APPEAL HISTORY

For “reasons of procedural economy”, the Opposition Division processed the opposition on the assumption that Puma had the required reputation to support its Article 8(5) claim. Despite this, it failed to find the required “link” between the applied-for and earlier marks, and

rejected the opposition. The Board of Appeal (BoA) dismissed Puma’s appeal. Although it agreed there was a degree of visual similarity between the earlier and applied-for marks, having examined the evidence submitted by Puma, it ruled that Puma did not have sufficient reputation. Further, even had sufficient reputation been found, the required “link” did not exist. In reconsidering the evidence, the BoA rejected the earlier decisions submitted as evidence of Puma’s reputation, asserting that it is not bound by earlier decisions.

On further appeal to the General Court, Puma argued that the principles of legal certainty and sound administration had been infringed by the BoA’s rejection of the evidence relating to Puma’s reputation, that the BoA had not provided its reasons for departing from previous decisions and, further, that it had not requested supplementary evidence to make a full evaluation.

At the end of the series of appeals, the CJEU ruled that, in relation to reputation, the three conditions (that the marks at issue be either identical or similar, the earlier mark have a reputation, and there be a risk that the use would without due cause take unfair advantage of or be detrimental to the distinctive character or repute of the earlier mark) are cumulative. Further, all relevant factors must be considered, including market share, intensity, geographical scope and size of investment – as per General Motors (case C-375/97, EU:C:1999:408).

PERTINENT ENDPOINT

The notable point of the CJEU’s decision relates to the principles of sound administration. It was held that where earlier EUIPO decisions relating to the reputation of a mark were relied on as evidence, these had to be taken into account, even if a different stance to those decisions is subsequently taken. Explicit reasons for departure from these decisions must be given, and merely stating that EUIPO decisions must be assessed on the merits of each case will not be sufficient reasoning.

Although this outcome does not establish a system of binding precedent for EUIPO decisions, it encourages increased diligence to earlier decisions. The level of consistency that will result remains to be seen, but it is certainly a promising precedent.



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Kit Kat closure?

Could this argument go still further? John Coldham considers

The CJEU has handed down its judgment in relation to Nestlé's EU mark for the shape of its Kit Kat chocolate bar, finding that the Board of Appeal (BoA) had incorrectly found the mark to be valid.

It is the latest move in a case dating back to March 2002, when Nestlé applied for the EU shape mark (shown below right), in class 30 for biscuits, among others. The mark was registered in July 2006. In March 2007, Cadbury Schweppes (now Mondelez) filed an invalidity application, arguing that the mark was devoid of distinctive character.

Parallel UK litigation proceeded between the parties regarding Nestlé's application for a UK mark for the same shape. In May 2017, the Court of Appeal upheld Mr Justice Arnold's first instance decision and refused to register the UK mark on the basis that Nestlé had failed to prove acquired distinctiveness in the UK.

EUROPE'S VIEW

By contrast, in Europe, the General Court (GC) held in December 2016 that Nestlé had proved acquired distinctiveness not only in the UK, but also in nine other countries (Denmark, Germany, Spain, France, Italy, the Netherlands, Austria, Finland and Sweden). As at March 2002 (the filing date of the mark), the population of these countries represented almost 90 per cent of the total EU population.

Nevertheless, the GC found such a "merging" of territories was not permissible. The relevant question was whether, throughout the EU, a significant proportion of the relevant public perceive a mark as an indication of origin; lack of recognition in one part of the territory could not be offset by a higher level of awareness in another. The GC accordingly considered that the

approach of the BoA, in concluding that distinctive character had been acquired through use without adjudicating on whether the mark had acquired distinctive character in Belgium, Ireland, Greece and Portugal was incorrect. (The GC seemed to forget Luxembourg.)

The CJEU agreed. Nestlé's mark was not inherently distinctive in any part of the EU. Nestlé therefore had to prove acquired distinctiveness in every Member State. As Nestlé had not done this, it was incorrect for the BoA to have found the mark to be valid.

Though the decision sets a high bar for proving acquired distinctiveness, the CJEU highlighted that a mark owner might be able to rely on the same evidence to show acquired

distinctiveness across several Member States in some circumstances. For example, where the mark acquired groups more than one Member State in a distribution network and treats them as if they were one national market. Equally, there may be situations where, due to a cultural,

geographic, or linguistic proximity between two Member States, the relevant public of the first has a sufficient knowledge of the products and services on the national market of the second. The evidence will still need to demonstrate that the mark is distinctive across the EU.

POTENTIAL NEXT STEPS

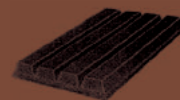
It remains to be seen how Nestlé will take the matter forward procedurally. It is presumably too late to file additional evidence in relation to the March 2002 application, but if the existing evidence is not sufficient, Nestlé could file a new application – in which case it would have to prove acquired distinctiveness in each Member State of a significantly larger EU.

KEY POINTS

✦ The owner of a mark that lacks inherent distinctive character must prove acquired distinctiveness in every Member State in respect of which the inherent distinctive character is lacking

✦ In certain cases, the same evidence may be relied on to show acquired distinctiveness across several Member States, for example where the relevant public of the first has a sufficient knowledge of the products and services present on the national market of the second

THE NESTLÉ SHAPE MARK



“
A mark owner might be able to show acquired distinctiveness across several Member States”



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Alice Stagg, a Principal Associate at Gowling, co-authored.

It's time to register for the annual CITMA Christmas Lunches! Get into the holiday spirit by registering at citma.org.uk →



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| DATE | EVENT | LOCATION | CPD HOURS |
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| 17th October | CITMA Webinar* An update on groundless threats | Log in online | 1 |
| 1st November | CITMA Day Seminar for Litigators – London | London | 7 |
| 1st November | CITMA Lecture – Edinburgh IP case law update | Brodies, Edinburgh EH3 | 1 |
| 8th November | CITMA Autumn Conference and Networking Drinks Reception* Relative disharmony – earlier rights and resolving conflicts | ICC, Birmingham B1 | 5 |
| 12th–18th November | IP Inclusive Week Find out more at ipinclusive.org.uk | UK-wide | |
| 14th November | CITMA Webinar* SRA equivalent means: drafting the application | Log in online | 1 |
| 19th November | CITMA Paralegal Webinar Transactions | Log in online | |
| 27th November | CITMA Lecture – London* A canter through the cases | 58VE, London EC4 | 1 |
| 29th November | CITMA Lecture – Leeds Emerging professional liability risks for IP professionals | Walker Morris, Leeds LS1 | 1 |
| 7th December | CITMA Northern Christmas Lunch | TBC | |
| 14th December | CITMA London Christmas Lunch** | London Hilton on Park Lane, London W1 | |

SUGGESTIONS WELCOME

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

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THE TRADE MARK 20

Q&A

Adjoa Anim

picks up the case for women's pockets

I work as a... Chartered Trade Mark Attorney at HGF Ltd's London office.

Before this role, I was... an Adjudicator at the Financial Ombudsman Service.

My current state of mind is... serene after a short break in Bled, Slovenia.

I became interested in IP when... I studied it on the Legal Practice Course.

I am most inspired by... the work IP Inclusive is doing to help make our profession one in which all members can feel welcome and thrive.

In my role, I most enjoy... the varied nature of my clients. A working day can see me deal with cases that touch on fashion retail, heavy industry, education services, food and drink, personal grooming, engineering, entertainment and pharmaceuticals. What's not to love about that?

In my role, I most dislike... drafting bills. Even worse, unpaid bills.

On my desk is... apart from work, a bottle of plant food I am using to revive a dying orchid with very little success, and a small piggy bank containing 78 pence and 25 kuruş. The only way is up.

My favourite mug says... "Woof!" alongside a picture of Pluto. Only sophisticated items for someone of my calibre!

My favourite place to visit on business... was Barcelona for the INTA 2017 conference. The atmosphere was great, the weather was lovely and it was amazing to meet so many



The biggest challenge is to attract people from a significantly wider pool of talent

friendly colleagues and make lasting connections.

If I were a trade mark/brand, I would be... Coca-Cola. I have been caffeine- and fizzy-drink-free for the past 10 years (relapsing a few times with the odd lemonade or tonic water). I am none the happier. If I cannot enjoy the drink, I might as well make money from other people's enjoyment.

The biggest challenge for IP... specifically for UK practitioners, is to attract people from a significantly wider pool of talent – not for the sake of public diversity targets, but to genuinely improve our profession.

The talent I wish I had is... to be able to play an instrument. Anything beyond my tambourine skills would be an achievement.

I can't live without... toast. Bread is my friend.

My ideal day would include... a swim. Swimming gives me time to get away from everything else and guarantees me a good night's sleep.

In my pocket is... I don't have pockets. The sad thing is that many women's clothing items do not have them. In fact, this important issue has recently been the subject of BBC coverage and intense debate on Twitter. Even brides have been asking for proper pockets on their big day.

The best piece of advice I have been given is... to pick my battles.

When I want to relax, I... swim or read.

In the next five years I hope to... be a stronger swimmer and take up studying Portuguese again.

The best thing about being a member of CITMA is... the sense of community and the way in which we share knowledge.



Lake Bled, Slovenia

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