

STRUGGLING
WITH STRESS?
ELIZABETH RIMMER p8

IP INVESTIGATION:
ADVANCE PARTIES
GAVIN HYDE-BLAKE p10

SCOTCHING
THE INFRINGERS
ROBERT BUCHAN p16

THE TRIALS
OF TRUNKI
MARGARET BRIFFA p18

ITMA REVIEW

THE JOURNAL OF THE INSTITUTE OF TRADE MARK ATTORNEYS

Issue **426** June 2016 itma.org.uk

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IPO LETTER FROM
VIETNAM p6

2016 IP SALARY
SURVEY p22

TM20 p42



Message in a bottle

WHAT CAN WE DISCOVER FROM THE LATEST
COCA-COLA SHAPE DECISION? **JOHN FERDINAND** p12



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welcome

June 2016



ITMA contacts

General enquiries

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

Committee chairs

Executive: Chris McLeod,
chris.mcleod@elkffe.com

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

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

Publications & Communications:

Richard Hayward,
richard@itma.org.uk

Published on behalf of ITMA by:

Think, Capital House,
25 Chapel Street, London NW1 5DH
Tel: 020 3771 7200

www.thinkpublishing.co.uk

Editor: Caitlin Mackesy Davies

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

Group Account Director: Polly Arnold

Account Manager: Kieran Paul

Art Editor: Clair Williams

Designer: Alix Thomazi

Sub-editor: Mike Hine

ITMA Review

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I am delighted to have been elected as President of ITMA, and to be able to welcome you to the *ITMA Review* in that role. In particular, I have been privileged to lead on our application for a Royal Charter over the past two years, about which we report on page 5. We have begun planning for our rebrand as the Chartered Institute of Trade Mark Attorneys (CITMA) and the accompanying celebrations, and will keep you all informed.

In the meantime, this issue covers news from Vietnam through to Turkey,

via the EU and Scotland, and includes a report on the hotly discussed Trunki decision, as well as the great work of LawCare. Finally, you are likely to receive this just before the EU referendum takes place – the result of which will have implications for our profession. We will be on hand to provide guidance and answer questions following the announcement of a vote to leave or remain.

Kate O'Rourke

Kate O'Rourke
ITMA President

Inside this issue

Regulars

04 ITMA Insider Introducing ITMA's new elected officers

41 Events Diary dates for ITMA members

42 TM20 Overseas member Dr Luigi Sansone seems to be lacking nothing

Features

06 UK IPO Attaché Christabel Koh on Vietnam's increasing appeal

08 Welfare Elizabeth Rimmer discusses how to reduce the pressure of work-related stress

10 Investigation Modern IP investigation is as much about adding to assets as defending them, writes Gavin Hyde-Blake

12 EUIPO John Ferdinand parses out the lessons to be learned from the latest Coca-Cola decision

15 WIPO Charles King wonders if changes to the basic mark requirement are afoot

16 ITMA speaker Robert Buchan on how robust legislation scotches the infringers

18 Designs The Trunki decision may raise concerns for some in the design sector, believes Margaret Briffa

22 Industry intelligence Survey reports on the state of IP industry pay

24 International Mutlu Yıldırım Köse examines a proposed change to Turkey's IP Law

Case comments

26 O/094/16 Timely filing of additional evidence might have seen off this challenge, writes Charlotte Wilding

27 O/129/16 Ben Evans reminds applicants to be objective about their marks

28 C-396/15 Marie McMorrough discusses an instructive adidas decision

30 C-179/15 Joel Smith considers the concept of "use" in online advertising

32 T-30/15 The importance of global assessment was affirmed, reports Oliver Tidman

33 T-816/14 In Tayto, the principles underpinning the comparison of marks were examined, says Maya Muchemwa

34 T-543/14 Hot Sox is distinctive, decides the Court, as Sharon Daboul reports

35 T-210/14 Mederer is given something to chew over, writes Rupert Bent

36 T-61/15 Elliot Stafford on the value of combining broad and narrow terms

37 T-40/09 In Advance, Chris Morris explains why a counter-attack was counterproductive

38 T-778/14 Name drop is no use for Ugly, as Désirée Fields reports

39 T-53/15 Aldi has cause to smile, writes Clare Liang

40 T-160/15 Kathryn Charles examines a MINI victory for BMW

iTMA Insider

Introducing our elected officers

PRESIDENT KATE O'ROURKE MBE

On 19 April, the ITMA Council met to elect officers and Kate O'Rourke MBE was unanimously voted into the role of President. Kate has already begun her two-year term, and looks forward to addressing ITMA members at the ITMA Summer Reception on 5 July.

Immediately following her election, Kate commented: "It is an honour and a privilege to be voted into this role.

ITMA has been a big part of my professional career for many years and I look forward to building on the exceptional work of my predecessors. and continuing to promote the high standards of our members and the embedding of our core values of quality, service and respect."

Kate is a Solicitor and Trade Mark Attorney, with more than 20 years' experience in relation to trade mark and related copyright, design and internet matters. She leads the Trade Mark Registration and Protection team at Charles Russell Speechlys, and her work includes advising on the adoption, registration and enforcement of trade marks internationally.

▶ Chris McLeod passes on the President's Insignia to Kate O'Rourke MBE



THE ITMA OFFICERS

▶ 1st Vice-President, Tania Clark

Tania began her legal career working in the IP departments of firms of Solicitors and in house for a subsidiary of Total. Tania has been a Trade Mark Attorney for the past 15 years and worked for two other major firms of Trade Mark and Patent Attorneys before joining Withers & Rogers LLP in 2006.

▶ 2nd Vice-President, Richard Goddard

Since 2009, Richard has been a Trade Mark Attorney at BP, where his work includes advising on the registration and enforcement of trade marks and designs, and the licensing of trade marks. Richard joined the profession in 2003, working in private practice for several years before moving in house. Richard has been involved in running ITMA's Trade Mark Administrators' Course for several years.

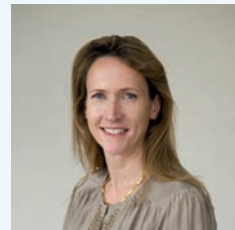
▶ Treasurer, Clare Jackman

Clare, Of Counsel to Norton Rose Fulbright, was previously at a national UK firm and also spent several years in the in-house trade mark team at the Wellcome Foundation, where she was responsible for all aspects of brand management, including creation, registration, licensing and enforcement.

She also had particular responsibility for the company's portfolio of trade marks in South East Asia, where enforcement, anti-counterfeiting and dealing with the grey market played a major part in the role.



▶ Kate O'Rourke MBE
President



▶ Tania Clark
1st Vice-President



▶ Richard Goddard
2nd Vice-President



▶ Clare Jackman
Treasurer

ROYAL CHARTER GRANTED

On 12 April, ITMA was granted a Royal Charter by Her Majesty The Queen at a meeting of the Privy Council held at Windsor Castle

This is a momentous event for ITMA and the Trade Mark Attorney profession. The news paves the way for ITMA to become the Chartered Institute of Trade Mark Attorneys (CITMA) and for Registered Trade Mark Attorneys who are members of ITMA to become Chartered Trade Mark Attorneys.

The change will take place later this year, once the Royal Charter has been legally granted with the Great Seal from the Crown Office. We will keep you updated on the developments and progress.

The Royal Charter is “reserved for eminent professional bodies or charities which have a solid record



► Windsor Castle, where a meeting of the Privy Council granted ITMA's Royal Charter

of achievement” – the new status gives our members recognition for their excellence in qualification, regulation and continuing professional development.

We will be working hard to promote this new status to business, stakeholders and the public, and we will be sharing how you can use

it as a mark of quality for the work that you do.

We would like to take this opportunity to thank everyone who contributed to the Royal Charter process – a number of members have dedicated a lot of time to working on the submission along our journey to this stage.

Member moves



Nellie Jackson has joined Birketts as a Senior Associate in the IP/Brands team, having spent the 10 years prior specialising in IP at Bristows. Nellie is based in the Ipswich office and can be contacted at nellie-jackson@birketts.co.uk or on 01473 299154.



Barker Brettell is pleased to announce the promotion of **Lisa King** to the position of Salaried Partner. Lisa joined Barker Brettell in 2002 and specialises in preparing, filing and prosecuting UK, European Union, overseas and international trade mark applications.



Beck Greener advises that **Peter Smart** retired on 31 March 2016 after more than 30 years in the partnership. He continues his association with Beck Greener as a Consultant.

IN MEMORIAM: NAN RAMAGE

6 February 1947–
7 April 2016



Nan Ramage, who was an Associate member of ITMA, died peacefully at her home in Turves, Peterborough, on Thursday 7 April 2016. Nan, who was born in Elgin, Scotland, trained and worked as a primary school teacher before becoming involved in trade marks. When she moved to London in 1972 with her then-husband Eric Ramage, she worked in one of the search agencies that were then a feature of the Chancery Lane-based trade mark world. Following a five-year return to teaching while living in Lancashire, Nan established her own search agency in 1978. This initially operated from Chichester Rents in Chancery Lane, London, before moving to Peterborough in 1985. Nan retired in 2013 and is survived by her stepdaughter Gemma.

Submitted by Eric Ramage



Eastern promises

Christabel Koh comments on Vietnam's increasing appeal

THE PAST FEW years have seen a huge growth in the number of British businesses interested in Vietnam as a place to trade. This trend accelerated after David Cameron, in the summer of 2015, became the first UK Prime Minister to visit the country. While there, he commented: "Just a decade ago, our relationship was one built on aid, now it is one of trade."

Building on those foundations, Baroness Lucy Neville-Rolfe, the Minister for IP, visited Vietnam, and an IP Memorandum of Understanding with Vietnam was signed between the UK IPO and The National Office of IP of Vietnam. This looks to establish a broad and flexible framework under which to develop cooperation in the field of IP protection, exploitation and utilisation.

Prior to Vietnam's accession to the World Trade Organization in 2007, the country issued many new laws, as well as regulations to strengthen the protection and enforcement of IP rights and upgrade these laws to meet the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). The EU-Vietnam Free Trade Agreement (EUVFTA), signed in 2015, will see EU innovations, artworks and brands be better protected against unlawful copying, including through stronger enforcement provisions.

Generally speaking, Vietnam's IP legislation covers most aspects of protection of IP in accordance with TRIPS, EUVFTA and the Trans-Pacific Partnership. Nonetheless, enforcement mechanisms still need to be strengthened, fines are still too low to be an effective deterrent, and awareness of counterfeits among Vietnamese consumers needs to be raised. I am working alongside the IPO's Intelligence Hub and the British Embassy in Hanoi, together with the Vietnamese Government, on a number of projects to address these areas, including a recent IP-enforcement training programme for Market Surveillance Agency officials in March.

There are, however, some tips to offer that might help IP practitioners in Vietnam:

Forum shopping. The Vietnamese authorities are working towards improving training for court officials, judges, customs authorities and other IP enforcement agencies. However, in many cases, judges in rural areas lack the necessary experience and legal training to bring fair judgments in line with Vietnamese law, which means that choosing the right court for your legal proceedings could be very important.

Evidence. The collection of suitable evidence can be difficult, as some evidence may need to be notarised in order to be admissible in court (eg evidence of sale, manufacture, import or offer for sale of infringing items). Identification of infringements may focus on monitoring products offered for sale at trade fairs and on the internet, which can require considerable time and resources.

Expert opinion. Most IP disputes are handled by administrative authorities rather than courts. However, the authorities still lack the expertise to resolve complex disputes. Expert opinions can help facilitate the resolution of a case by the competent authorities.

Criminal action. IP infringement can be criminalised. However, due to lack of guidance and inconsistency in the legal system, criminal action is not usually feasible in practice.

All in all, Vietnam presents a fantastic opportunity to expand into a fresh market where newly affluent consumers are clamouring for high-quality products. There are risks involved in terms of ensuring your IP is protected and enforced, but I am always on hand to help. ■



Christabel Koh

is the UK IPO Attaché
for South East Asia
christabel.koh2@fco.gov.uk



STRUGGLING WITH STRESS?

Workplace stress is by far the most common reason for calls to the helpline run by LawCare,

an advisory and support service for the legal profession.

Being under pressure is a normal part of life; it can be motivating and help you get things done. And people have different ways of reacting to stress, so a situation that feels stressful to one person may be energising for someone else.

However, being under constant stress, particularly in a professional context, can lead to a feeling of unbearable pressure and leave people unable to cope. Many lawyers have a driven, perfectionist personality that makes them more prone to stress.

Often working long hours in pressured situations, they believe they should always be in control. For these people, feeling unable to cope with work can be particularly difficult.

If you often become overwhelmed by stress, then you need to do something about the situation. Effective stress management in the workplace is critical to your overall health, and being able to recognise the physical effects of stress can help you take control of the situation. Failing to tackle the causes of stress in the workplace can lead to poor decision-making, increased mistakes, time off sick and poor relationships with colleagues.

WARNING SIGNS

The most common signs that indicate you may be stressed are:

Elizabeth Rimmer discusses ways to reduce the pressure of work-related stress

LAWCARE – HOW IT HELPS

“After talking through my worries with LawCare, the burden lifted. It sent me practical advice and offered the support of a LawCare volunteer. Anne called the next day and remembered the stress I described from her own career as a Solicitor. I really felt she was there for me. I had the one-to-one support I craved and was able to talk to her about what I might do to resolve my problems.”

“LawCare gave me a list of ways to say no gracefully and sent me its stress management and relaxation leaflets. It also arranged sessions with a professional counsellor who had experience of the legal profession. With my self-confidence improved, I was able to persuade my employers to provide training and support. I am now really enjoying a new role in the firm.”



CALL LAW CARE'S HELPLINE ON **0800 279 6888**
IF YOU NEED SOMEONE TO SPEAK TO

Sleep deprivation. It's a vicious circle: worries about work lead to lack of sleep, and lack of sleep makes it difficult to perform well at work.

Physical changes. Headaches, skin complaints, frequent colds, aching muscles and digestive problems are often indicators of extreme stress.

Drinking and smoking. Many lawyers turn to drinking and smoking to escape from the pressures of everyday life. However, alcohol is a depressant and smoking creates a new stress – craving for a cigarette.

Changes in appetite. You may find yourself comfort eating or skipping meals.

Mood swings. You may become irritated and frustrated, feeling very angry one minute and fine the next. Others may complain that you are short-tempered, selfish and difficult.

Panic attacks. These can happen suddenly, for no clear reason. You may feel nauseous or short of breath, shake, sweat and experience a sense of unreality, as if you're detached from the world around you.

If you recognise any of these warning signs in yourself, it is important to take steps to control workplace stress before it overwhelms you. There may be little you can do to change external pressures, but you can learn how to deal with them better. The first stage in dealing with stress is to identify the source so that you can plan a strategy to tackle it. Common issues identified by callers to the LawCare helpline include:

- job insecurity and lack of status;
- impossible targets;
- unsupportive colleagues and a lack of friends at work;
- long, antisocial or inflexible hours;
- lack of support or supervision; and
- overwhelming responsibilities or difficulties at home.

COPING STRATEGIES

Keeping a stress diary over two or three weeks may help you identify why you are stressed and help you to make positive change. When you feel that you're not coping, write down how you're feeling, including any physical symptoms. Note what you're doing and have just been doing. You can then start looking for clues as to what triggers your stress. As you work through the diary, you may realise that something that appeared insignificant at the time could be a cause of stress.

Although it's easier said than done, it's crucial to talk about stress; don't stay silent. Lawyers, in particular, may feel it's a sign of weakness to admit they aren't coping, but it's better to address problems early, before they get out of control.

Talk informally to a trusted colleague, your manager or a member

of your HR department. Refer to your diary notes of triggers for stress or aspects of work you are finding overwhelming.

There are also a number of other practical steps you can take to help cope with stress:

- prioritise and don't overcommit – learn to say “no” or “I can't do that until next week unless I drop something else”;
- use your full holiday entitlement – take a lunch break and short breaks during the day;
- do one thing at a time – break complex tasks down into manageable chunks;
- eat healthily, exercise, and avoid alcohol and smoking;
- get more sleep and develop a good sleep routine;
- try relaxation or mindfulness techniques;
- talk to a member of your family or a friend, or call LawCare for support on 0800 279 6888.

Everyone who has ever had a job has, at some point, felt the pressure of work-related stress. Remember that stress is not a weakness and it can happen to anyone. You can't always avoid the tensions that can occur in the workplace, but there are lots of positive steps you can take to manage them. ■



Elizabeth Rimmer

is CEO of LawCare

erimmer@lawcare.org.uk

Elizabeth is a former Solicitor, and previously worked at Psychotherapists' organisation the Institute of Group Analysis.



Modern IP investigation is as much about helping brands add to their assets as defending them, writes Gavin Hyde-Blake

ADVANCE PARTIES

Changes in technology, circumstances, laws, and legal practices and strategies have seen the evolution of IP investigation into a modern, highly skilled and technologically competent profession. In fact, although investigations are still a key part of our activities, the name “investigator” is somewhat outmoded. The changing approaches of our clients and profile of our workload casts us more in the role of a commercial consultancy.

At the same time, an increasingly full trade mark register is pushing many attorneys towards adopting more flexible strategies on behalf of their clients. A tactic currently on the rise is to acquire the rights or partial rights from the current holder. This is particularly popular when dealing with non-vulnerable marks – those where there has been use within the past five years – or for marks with a very broad set of classifications where there are unused classes. The approach is also useful to secure prior rights to protect a challenged mark.

“
The approach is the key element to an acquisition. The most important aspect is that it must avoid any suspicion of bad faith

The use by a discrete party, such as an investigator's third-party vehicle, to secure an IP asset can help to ensure a true market value. Often, an approach by a purchaser, particularly a big brand owner or a company that can afford legal representation, has the effect of inflating the cost, despite any true measure of "value".

These acquisitions can be an alternative to opposition or cancellation proceedings, or a way to clear conflicts to a proposed trade mark and safeguard a brand owner's new marketing, product or brand-launch plans. Often an acquisition will follow an in-use investigation to determine the status of the mark vis-à-vis use, and this can give added confidence that the registrant may be prepared to dispose of unwanted classes.

As with all work an investigator undertakes, several things have to be in place before any steps are taken. On the "soft" side of business, a clear and strong conflict policy is absolutely vital. The worst thing any investigator can do is to act – or even be seen to act – against a client's interests. In addition, any organisation involved in acquisitions will need a formal structure to support the work. Ideally, this should be a mix of limited and unlimited companies with a verifiable infrastructure of office, email and telephone facilities. Limited companies are particularly important for any overseas filings, as some territories insist on formal paperwork

in terms of company incorporation certificates. Work in the UK, for example, is a little more flexible, with unlimited trading entities able to sign the necessary paperwork with the IPO.

ACQUISITION PRINCIPLES

The theory behind acquisitions is straightforward: an approach is made to a rights-owner through a third-party vehicle with an offer to obtain the asset. After negotiation, the asset is transferred to the third party, and then on to the ultimate client. In practice, there is much more to consider.

The approach is the key element to the acquisition. The most important aspect is that it must avoid any suspicion of bad faith, an issue that has taken many past trade mark purchases to the courts. A business-to-business approach to the owner, showing a direct interest and offer to acquire the IP asset, is normally the best strategy. The following discussions should then be firmly steered towards the details of the sale, and any direct questions deflected. While it is reasonable to let the seller imagine what they will, on no account should lies be told, or even implicitly confirmed.

In our experience, a seller will sometimes demand to know if there is an ultimate client and its identity. Here, we recommend an assertion of anonymity or discretion, on the basis that the information is commercially sensitive.

After the trade mark has been transferred to the third-party vehicle, consideration should be given to the next step. Some of our clients have requested an immediate transfer on to them, while others have been prepared to leave the asset sitting "on our books" – often if they are in the process of securing other rights as

part of a launch project. In such cases, a licence to use should be put in place.

OTHER ACTIVITIES

Other related activities are also on the rise: for example, the use of an investigator's third-party vehicle as the named party in filing opposition proceedings, or in filing new marks in different territories on behalf of a client who wishes its future product launches to remain anonymous to its competitors.

The same process, with the same attention to avoiding accusations of bad faith, forms the backbone to the acquisition of other IP assets. This can include dealing with company names (negotiating to have a third party change its trading name to an unconnected name) and domain names. We are involved in the third-party acquisition of domain names daily. Often these are one-offs, but sometimes one of our third-party vehicles is used to manage a project, acquiring 10 or more domains from different third parties on behalf of a large brand owner. Again, this allows the brand concept to remain under wraps until the press launch date.

Often these acquisitions involved a measure of investigation at the beginning of the process to correctly identify and contact a domain owner from what can be scant or out-of-date information held on domain registers.

Ultimately, though much has changed in the strategies used by IP professionals, many new challenges are overcome with old techniques and an innovative use of existing infrastructure and skills. There is still the need for old-fashioned skills to dig, uncover and report clearly, and the need for integrity to remain independent and to report the facts, whether or not they are what the client wants to hear. ■



Gavin Hyde-Blake

is a Director at eccora
ghb@eccora.com

Spencer Vold-Burgess, also a Director at eccora,
co-authored this article.



MESSAGE IN A BOTTLE

*John Ferdinand parses out the lessons to be learned from
Coca-Cola's most recent General Court battle*

Following a previous review in the *ITMA Review* of the law and practice of OHIM (now the EUIPO) and the CJEU General Court in respect of bottle shapes (“Lost your bottle?”, February 2015), this article highlights lessons from case T-411/14 (*The Coca-Cola Company v OHIM*, 24 February 2016). In this case, Coca-Cola (the Applicant) attempted to register shape marks as Community Trade Marks (CTMs), both from the perspective of inherent registrability and reliance on acquired distinctiveness evidence.

Coca-Cola has a number of registered bottle-shaped marks, including a successful CTM application in March 2014, without evidence of acquired distinctiveness. Readers will see this as a variant of Coca-Cola’s iconic “contour bottle with fluting”. In the present case, the mark being considered is another 3D bottle shape (the Mark), described in the decision as the “contour bottle without fluting”. Both marks are shown on page 14.

FAMILIAR THEMES

In my previous article, I suggested it was a little surprising that the contour bottle with fluting had been successfully registered with no evidence of acquired distinctiveness. Given that the Mark is a completely smooth bottle shape, there is little for Coca-Cola to cling on to in arguing it is inherently distinctive. Nevertheless, the reasoning for refusal of the application illustrates two points: first, a common tendency to conduct an analysis of the individual elements of the Mark rather than the Mark as a whole; and second, a somewhat limited view of the nature of the commercial sector taken by the Court in its decision.

The Court is eager to stress that refusal of registration is based on review of the overall shape of the bottle, rather than an assessment of its individual element, yet a cursory review of the decision-making process conducted suggests the opposite is true:

- “45 First, as regards the lower section of the mark applied for, it must be considered that that section of the bottle does not possess any characteristics that distinguish it from other bottles available on the market. It is well known that the lower sections of bottles can vary greatly ...
- 46 Secondly, as regards the middle section of the mark applied for, it must likewise be considered that that section does not display any particular features which stand out ...
- 47 Lastly, as regards the top section of the mark applied for, which consists in a funnel shape that bulges slightly at the neck, it is well known that the bottles available on

the market feature characteristics which are more or less similar to those of the mark applied for ... It follows that, even though that feature is somewhat original, it cannot be regarded as departing significantly from the norms and customs of the sector.”

Despite its indication that “lower sections of bottles can vary greatly” and that the top of the Mark “is somewhat original”, the Court dismissed the features individually, then concluded that, since none of the features individually is especially original, the combination of features cannot be.

This conclusion seems overly dismissive, bearing in mind the wording later in paragraph 45: “Nevertheless, such variations do not, generally, enable the average consumer to infer the commercial origin of the goods concerned.” Here, the Court has considered whether consumers would attribute trade mark significance to an individual element of the Mark, rather than assessing how consumers view it as a whole. This approach ignores the fact that the distinguishing effect of unusual elements is magnified in combination with other elements that are not commonplace. Given the Court’s conclusions that the lower sections of bottles are known to vary greatly and the top of the bottle “is somewhat original”, one might consider it more likely the shape as a whole would be acceptable for registration. However, there is no discussion of this point in the decision.

The Court also spent little time considering the Applicant’s argument that different companies in the marketplace use bottle shapes to make their products stand out, and did not dispute the statement in the original Board of Appeal decision that there is “little design freedom” in the area of bottle shapes. Whether or not consumers have a tendency to use bottle shapes as a means of identifying the commercial origin of the goods, the wide degree of variation in design of bottle shapes clearly contradicts the argument that design freedom is limited.

The Applicant also raised an interesting argument that the Mark would be seen as a “natural evolution” of the famous contour bottle with fluting, and so therefore would immediately call to mind an association with the Applicant. Clearly, in the requirement for the EUIPO to consider “all circumstances of the case” this has some merit, but the decision made no comment on this point. While this is understandable given the fact it is akin to relying on acquired distinctiveness of a different earlier mark in supporting a later mark’s inherent distinctiveness, it will be interesting to see if the point is raised in future cases.



Overall, the lack of additional elements such as “fluting”, grooves, or the frosting present in the Freixenet case, always made acceptance of this application on inherent distinctiveness grounds unlikely to succeed, given the reluctance of the EUIPO and General Court to grant registration for shape marks.

EVIDENCE LESSONS

The question of acquired distinctiveness was also considered in this case, and provides some interesting lessons for applicants trying to rely on such evidence to achieve registration of bottle-shaped marks.

The Court held that the survey evidence (conducted in 10 Member States) indicated the Mark might be considered to have achieved the necessary degree of consumer recognition (between 48 per cent and 79 per cent) in the countries in which surveys were conducted. However, the Court did not, of its own motion, extrapolate these figures to other Member States, and stated that for such marks it is probably necessary to show evidence for all 28 countries. Nevertheless, there are suggestions in the recent decision that the Applicant could have done more to extrapolate the results to other countries and that covering a wider (if not comprehensive) spread of countries with surveys might have been more persuasive.

In considering advertising expenditure and sales figures, the Court pointed out that there was no specific breakdown of products sold only in the packaging subject of the Mark. This indicates that applicants for the registration of bottle-shaped marks (and packaging marks generally) should be prepared to give specific breakdowns of products sold in that packaging, especially in respect of figures for marketing and advertising, even if this may be very difficult.

A final point of note concerns the Applicant’s attempt to rely on



The Court held that, because it was not possible to separate the Mark from the overall silhouette of the contour bottle shape, it was not sufficient to support a claim of acquired distinctiveness

evidence related to use of its contour bottle both with and without fluting to support its claim to acquired distinctiveness for the version without fluting. This was based on the reasoning of the KitKat decision, which held that use of a mark in conjunction with other trade mark elements can still be considered use of the mark applied for. The evidence also included reliance on the use of 2D representations of the bottle shape.

While the Court did not rule out the possibility of relying on these arguments in principle, in respect of shape marks it held that, because it was not possible to separate the Mark from the overall silhouette of the contour bottle shape or contour bottle shape with fluting, the use in question was not sufficient to support a claim of acquired distinctiveness. It held the Mark was “subsumed” in the representations relied on in evidence.

This suggests that, while it may be possible to rely on evidence of use of the shape mark in question combined with other elements, it must always be possible to visually separate the mark that is the subject of the application from the overall mark used in marketing materials. As such, in theory, 2D representations of the mark applied for could also potentially

constitute relevant evidence; however, it must still be possible to determine the essential distinguishing features of the 3D mark at hand.

Accordingly, when preparing acquired distinctiveness evidence for protection of bottle-shaped marks, it seems applicants should:

- 1) ensure evidence, and survey evidence in particular, covers all 28 countries if possible;
- 2) provide sales and advertising expenditure for products sold in the particular packaging in question; and
- 3) ensure representations of the mark in evidence illustrate the distinguishing features of the mark at hand either in 2D or 3D form. ■

The March 2014 mark



The February 2016 mark



John Ferdinand

is a Senior Associate at Marks & Clerk
jferdinand@marks-clerk.com



BACK TO BASICS

Charles King wonders if changes to the basic mark requirement are afoot

Most readers will be familiar with the Madrid System's "dependency clause" (Article 6 Madrid Protocol/Agreement), which requires that applicants have an existing "basic" application/registration in a contracting party before they can file an international application using that party's registry as an office of origin. The relevance and necessity of the clause has been sporadically debated before WIPO since the 1970s. One deterrent to change has been the administrative burden of permanently modifying Article 6, which would require a diplomatic conference.

However, there are also other good reasons to maintain it. The Madrid System allows trade mark owners to gain registrations in multiple countries at a low cost and with relative speed. Such a system confers significant advantages on the Madrid applicant. However, without a check or balance, this system might unduly disadvantage the owners of earlier rights capable of preventing the international registration's (IR's) designations from granting. Opposing or invalidating each designation nationally would be costly and lengthy, and out of the question for many smaller businesses. The basic registration requirement facilitates the "central attack", which provides the required balance. What's more, the holder of the IR retains the option of transforming the attacked IR designations into national applications in the designated contracting parties.

Since 2006, however, calls for alterations to dependency have grown louder. Marques published a position paper in 2011 declaring itself in favour of change. Changes were discussed again at the 12th session of the WIPO Madrid System Working Group. One proposed means of easing the potential administrative burden is that dependency could be "frozen" (suspended) rather than abolished. Suspension would be a revocable decision falling within the mandate of the Madrid Union Assembly, with no

requirement for a diplomatic conference. A survey to gather the thoughts of Madrid users was commissioned and among general criticisms of dependency, some important points emerged from the responses:

- 1) Users rarely encountered/followed through with central attacks.
- 2) Sixty-two per cent of users favour the abolition, suspension or restriction of dependency.
- 3) Dependency was a real issue in contracting parties, where applicants typically use marks in different scripts domestically and internationally. Many had filed basic applications in a script that they would never use domestically, solely to be able to file internationally. This presented additional difficulties where the domestic non-use period was a mere three years, two years shorter than the period of dependency.

While the survey results are enlightening, they do not provide an appropriate basis to proceed to a decision. The survey was sent to holders of IRs, representatives and other users of WIPO's online services, who were likely to see dependency as a disadvantage, but Article 6 does not chiefly exist for such parties. Further, while the survey points to the underuse of the central attack, it remains an important theoretical deterrent to sprawling bad-faith IRs, and a necessary counterbalance to the benefits of the Madrid System. There are evident difficulties surrounding non-use of basic marks in non-domestic script, but these could be dealt with through other means, such as modification of domestic non-use provisions. The paper accompanying the survey recommends the Working Group reconsider the "freezing" proposal. We await further developments. ■



Charles King

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

SCOTCHING THE INFRINGERS

Summarising his Spring Conference presentation on whisky brand protection, Robert Buchan explains why he's grateful to a robust regulation regime

While Scotland is famous for the iconic Scotch whisky brand, there may be a lower awareness of key additional legal protection that exists for the drink in the UK, in particular the protection and benefits offered under The Scotch Whisky Regulations 2009 (The Regulations).

The Scotch whisky market is estimated to be worth £5bn to the UK in exports annually and supports more than 40,000 UK jobs. Scotch

whisky has been defined in UK law since 1933 and is protected as a geographical indication (GI) in all 28 countries of the EU and globally.

The Regulations significantly improve the legal protection for Scotch whisky within the UK and, indirectly, overseas. They provide protection in addition to IP that can be relied upon by each distiller and whisky brand, such as trade marks, copyright and passing off.

WIDER PROTECTIONS

The Regulations should be considered when selecting brand and trading names and reviewing or designing the labelling and packaging for Scotch whisky products. The Regulations also aim to protect consumers, by ensuring they are aware of what they are buying

and can also distinguish between higher- and lower-value products.

The Regulations prevent passing off and unfair competition by introducing a variety of clear rules on: the definition of Scotch whisky; labelling of products; the use of distillery or regional names; and what can be said about the age of whisky.

DEFINING TERMS

The Regulations set out a specific legal definition for Scotch whisky and particular categories of whisky. Regulation 3 provides that Scotch whisky must: be distilled wholly and matured in Scotland; be fermented from only cereals, water and yeast; be distilled to retain the aroma and taste of raw materials; have no additives or flavourings; be matured for at least three years in oak casks; and be bottled at a minimum strength of 40 per cent volume.

Regulation 5 makes it clear that no whisky other than Scotch whisky can be made in Scotland.

LABELLING AND CONFUSION

A key provision is Regulation 6, which tackles passing off. This prohibits a person from labelling, packaging, selling, advertising or promoting any drink as Scotch whisky or Scotch if it is not Scotch whisky. A person must not label, package, sell, advertise or promote any drink in any other way that creates a likelihood of confusion on the part of the public as to whether the drink is Scotch whisky. That covers not only a brand name, but also the use of images or symbols associated



with Scotland, such as lochs, mountains or stags.

Further adding to this protection, Regulation 7 makes it compulsory to bottle single malt Scotch whisky in Scotland.

The Regulations define different categories of Scotch whisky. These are: single malt; single grain; blended malt; blended grain; or blended. Regulation 8 makes it compulsory for every Scotch whisky to be labelled with the correct category description, which must appear on the front of the bottle and on any individual packaging, and must be as prominent as any other description used. The practical aim is to set aside the category descriptions from additional descriptions, such as “old” or “premium”.

NAMING RESTRICTIONS

Regulation 9 provides that a distillery name must not be used as a brand name or as part of a brand name of a Scotch whisky, unless the whisky was wholly distilled at that distillery. Labelling, packaging or promotion of a product that creates a likelihood that the public will think it has been distilled somewhere other than where it was actually distilled, or by any person other than the actual distiller, is also prohibited. This tackles the use of a company name that sounds like a location or distillery, especially where the producer is also trading as “X Distillery Limited”.

Regulation 10 provides protection for regional GIs for five traditional regional terms – Highlands, Lowlands, Speyside, Campbeltown and Islay. These terms can only be used for Scotch whiskies wholly distilled in those particular regions, and protects consumers from misleading labels, packaging or advertising.

AGE PROTECTION

The basic rule set out in Regulation 12 is that the only age to be stated on labels or in promotional material is the

age of the youngest whisky in the product. There is a prohibition of any labelling or promotion in a way that includes reference to a number that could create confusion among the public as to whether the number relates to the maturation period of the whisky, its age or when it was distilled.

If labels or advertisements refer to a distillation of a vintage year, only one year of distillation or vintage can be mentioned. The year of bottling or an age statement must appear, and it must appear in the same field of vision as the distillation or vintage year.

ENFORCEMENT POWERS

Regulations 16 to 41 set out a wide variety of strong enforcement powers, including criminal prosecutions and civil actions. Trading Standards and Port Health Authorities are tasked with enforcement and generally will aim to encourage compliance by engaging with parties and issuing improvement notices, but there are also wide inspection and seizure powers to tackle breaches.

As well as allowing direct civil enforcement by a distiller, blender or brand owner, the Regulations importantly provide a collective right of action for The Scotch Whisky Association. The collective right to take action is a key additional weapon in the arsenal protecting Scotch whisky. The Regulations may in practice be relied upon in conjunction with a particular distillery’s goodwill or registered trade mark rights, but do offer a wider variety of options to protect the Scotch whisky brand.

Under Regulation 40, if the Court of Session in Edinburgh or the High Court in London is satisfied that there has been a breach of the Regulations essentially relating to the marketing and labelling of any drinks, an interdict or injunction can be granted to prevent any continuing breach.

As a Scottish IP lawyer, I say “cheers” to the Regulations! ■

“

As well as direct civil enforcement by a distiller, blender or brand owner, the Regulations provide a collective right of action for The Scotch Whisky Association



Robert Buchan

is a Partner at Brodies LLP

robert.buchan@brodies.com



THE TRIALS OF TRUNKI

Trunki's trials and tribulations may have ended in the UK Supreme Court, but the decision may raise concerns for some in the design sector, believes Margaret Briffa

TRUNKI TIMELINE

At the beginning of March, the Supreme Court handed down its much-anticipated decision in *PMS International Group plc v Magmatic Limited* [2016] UKSC 12 (*PMS v Magmatic*).

The Supreme Court upheld the Court of Appeal's finding that PMS's *Kiddee* Case did not infringe Magmatic's Community registered design. Clearly, the decision is disappointing for Magmatic. It also has implications for the wider UK design industry and provides guidance from the Supreme Court on the interpretation of Community registered designs. These should be considered when advising clients in order to maximise their chances of successfully enforcing their Community registered design rights.

CASE HISTORY

In 1998, Rob Law (Mr Law) won the BASF/Institute of Materials Design Award with his *Rodeo* ride-on suitcase. Mr Law continued to develop his design and, in 2003, he applied to register Community design No 000043427-0001 (the CRD).

The *Trunki* product was first sold in 2004 and, since that date, it has been a major commercial success for Magmatic and Mr Law, selling more than two million units worldwide and winning a variety of prestigious awards.

In early 2013, Magmatic discovered that PMS was importing and selling a product called the *Kiddee* Case. Magmatic subsequently commenced High Court proceedings in February 2013 for infringement of the CRD.¹

In his judgment, Mr Justice Arnold found that the *Kiddee* Case did not produce a different overall impression than the CRD. Central to Arnold J's finding of infringement was that the CRD was for shape alone. He stated in paragraph 69 of his judgment: "The CRD is evidently for the shape of the suitcase, and the proper comparison is with the shape of the *Kiddee* Case."²

Other notable points of his decision were:

- 1) disclosure of the *Rodeo* was not afforded protection under the obscure designs exception under Article 7(1) Council Regulation 6/2002/EC of 12 December 2001 on Community designs (the Design Regulation)³;
- 2) the CRD produced a different overall impression to the *Rodeo* and, accordingly, was not devoid of individual character; and
- 3) there may be designs that are not obscure enough to qualify for protection under the obscure designs exception (such as the *Rodeo* in this case), and thus can be relied on as prior art for purposes of Articles 5 and 6 of the Design Regulation, but do not form part of the design corpus when assessing the overall impression created by other designs under Article 10 of the Design Regulation.

APPEAL STAGE

Next, the Court of Appeal decided that Arnold J had fallen into error by holding the CRD to be a design that related only to shape, and had failed to appreciate that the CRD:

- i) was, when considered as a whole, intended to create the impression of a horned animal; and

1998
Award-winning design



2003
Community design
No 000043427-0001



2013
Kiddee Case





It is clear that, in this jurisdiction, it is not straightforward to protect the get-up and shape of distinctive products, especially against copyists. There may be a case for considering whether more robust legislation is needed to tackle the problem

ii) showed a distinct contrast in colour, or tone, between the wheels and the strap on the one hand, and the rest of the suitcase on the other.

As a result of these errors, the Court of Appeal was able to find that the Kiddee Case did not produce a similar overall impression to the CRD.

SUPREME COURT

In considering the Court of Appeal’s judgment, the Supreme Court looked at the two errors identified by the Court of Appeal and found that they should be treated as three criticisms of the High Court judgment.

First, Arnold J failed to afford proper weight to the overall impression of the CRD. It indicates a horned animal, making it significantly different from the impression of the Kiddee Case, which could be seen as either an insect with antennae or an animal with ears. Second, he failed to consider the effect of the lack of ornamentation on the surface of the CRD. And finally, he ignored the colour contrast in the CRD between the body and the wheels.

APPROACH TO INTERPRETATION

Before dealing with these criticisms, the Supreme Court sought to consider the proper approach to the interpretation of images represented in Community registered designs. It made the following points:

- it is up to the applicant to decide what features it wishes to protect;
- images for the design will identify the nature and extent of the monopoly claimed by the applicant; the Supreme Court further elaborated on this point by making reference to an article

written by Dr Martin Schlötelburg, the coordinator for OHIM’s Designs Department, which states that “the selection of the means for representing a design is equivalent to the drafting of the claims in a patent: including features means claiming them”⁴;

- if an applicant wants to disclaim features, this can be done by incorporating broken lines (for drawings), colouring them (for black-and-white photos) or encircling them (for drawings or photos);
- referring to the OHIM Manual⁵ and Commission Regulation (EC) No 2245/2002 (the Implementing Regulation), the Supreme Court emphasised that the above approach was consistent with the fact that an applicant can make a number of applications, and the process of making an application is intended to be simple and inexpensive;
- it is up to the applicant to make clear what it intends to protect and what it intends to exclude; guidance on this can be sought from EUIPO (not from the courts); and
- when a design is filed in colours, the colours are claimed. When a design is filed in a black-and-white drawing or photo, or in monochrome, all colours are claimed.

FIRST CRITICISM

The Supreme Court agreed with the Court of Appeal that the overall impression of the CRD is that of a horned animal. It further noted that the High Court did not take this into consideration when comparing the similarities and differences between the CRD and the Kiddee Case for the purposes of determining overall impression.

Although the High Court, in assessing the overall impression, referred to the fact that both the CRD and the Kiddee Case shared “horn-like handles”, the Supreme Court felt this supported its view that the High Court did not consider that the horned animal appearance of the CRD was a particularly distinctive feature of the CRD, because Arnold J wrongly referred to the ears and antennae of the Kiddee Case as “horn-like”. Further, although Arnold J stated that horns were an important part of the CRD’s appearance, and that the clasps look like the nose and tail of an animal, this was said when comparing the CRD with the Rodeo.

SECOND CRITICISM

The Supreme Court felt the Court of Appeal was not raising a free-standing criticism here. Instead, it was saying that the absence of ornamentation reinforced the horned animal impression of the CRD. In other words, the second criticism merely supported the first criticism, and therefore was not a stand-alone criticism.

Having dealt with the second criticism, the Supreme Court, *obiter*, stated that:

- absence of ornamentation can be a feature of a design;
- whether absence of ornamentation is a feature of a particular design will be a question of interpretation of the images of that design;
- this may be difficult to establish, because Article 36(3) of the Implementing Regulation prevents verbal descriptions;
- if absence of ornamentation is a feature of a design, it does not mean that, because an item has ornamentation,



TRUNKI TAKE-AWAYS

Following the Supreme Court's decision, here are points to consider when advising on Community registered designs:

- ▶ EUIPO guidance should be reviewed and followed prior to advising on filing;
- ▶ to protect shape alone, use line drawings for broadest protection;
- ▶ the best way to disclaim parts of a design is to use broken lines;
- ▶ an absence of ornamentation is likely to be seen as a feature of a design – avoid this by using line drawing to represent the design;
- ▶ black-and-white and CAD drawings will be seen to cover all colours;
- ▶ grey shading on design is likely to be seen as the designer claiming an absence of ornamentation on the design;
- ▶ tonal contrasts are likely to narrow the scope of protection;
- ▶ consider filing series of registered designs in line drawings and in various colours;
- ▶ obscure disclosure provision is to be interpreted broadly; and
- ▶ consider whether prior art for the purposes of Articles 5 and 6 of the Design Regulation will be too limited to form design corpus for purpose of Article 10 assessment.

there will be no infringement – it is a factor to be taken into account; and

- while a design has to be interpreted in its context, a line drawing is more likely to be seen not to exclude ornamentation.

It is worth mentioning here that the Supreme Court did not make a finding on whether absence of ornamentation was a feature of the CRD.

THIRD CRITICISM

The Supreme Court found that the Court of Appeal was correct in finding that the CRD was not merely for a shape, but for a shape in two contrasting colours (represented in grey and black). Accordingly, when comparing a design in contrasting colours against an alleged infringing article, colouring must be taken into account.

VALUABLE SECTOR

This decision may be seen by some as a blow to the design industry, which contributes £72bn to the UK economy in gross value added, according to the Design Council.⁶ Following the decisions in *Société des Produits Nestlé v Cadbury UK Ltd*⁷, *The London Taxi Corporation Limited v (1) Frazer-Nash Research Limited and (2) Ecotive Limited*⁸, and now this case, it is clear that, in this jurisdiction, it is not straightforward to protect the get-up and shape of

distinctive products, especially against copyists. There may even be a case for considering whether more robust legislation is needed from Parliament to tackle the problem.

Finally, with much debate about possible Brexit, the Supreme Court's attitude to Europe is also of interest. The Supreme Court refers, rather sceptically, to the result of a possible preliminary reference to the CJEU – in particular, that the CJEU would merely state interpretation would depend on the images of the Community registered design in light of the Principal Regulation and Design Regulation. ■

1) Magmatic also claimed copyright infringement relating to aspects of its packaging and unregistered design right infringement. A claim for passing off was also advanced, but not pursued, following Magmatic's application for an interim injunction, in order to obtain a speedy trial.

2) *Magmatic Limited v PMS International Group plc* [2013] EWHC 1925 (Pat), paragraph 69.

3) This was despite: the event being attended by around 20 people, who were mainly students; no images of the Rodeo on the BASF website; and the fact that, although there was a reference to Mr Law having won the award, this was not posted before the date of filing of the CRD.

4) *The Community Design: First Experience with Registrations* [2003] EIPR 383,385.

5) *Manual Concerning Proceedings Before the Office for Harmonization in the Internal Market (Trade marks and Designs), Registered Community Designs, Examination of Applications* (2nd edition).

6) *The Design Economy Report 2015*.

7) [2016] EWHC 50 (Ch).

8) [2016] EWHC 52 (Ch).



Margaret Briffa

is a Partner at Briffa. margaret@briffa.com

Ramsay Monime, a Solicitor at Briffa, co-authored this article.

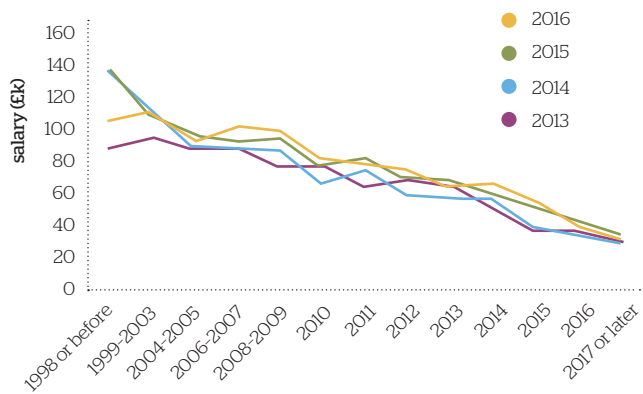
Briffa advised Magmatic in this case.

THE STATE OF PAY

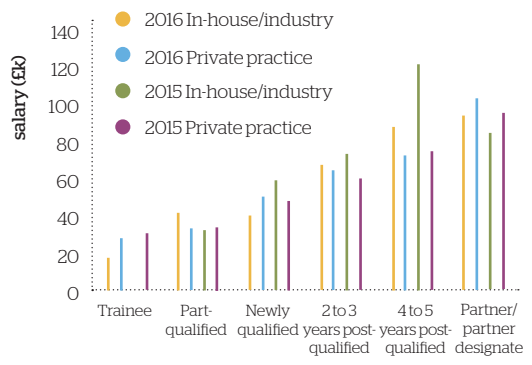
Once again, *Fellows and Associates* has delved into the trends in IP industry remuneration, and we've chosen some highlights

SALARY SPECIFICS

AVERAGE SALARY BY YEAR OF FIRST QUALIFICATION

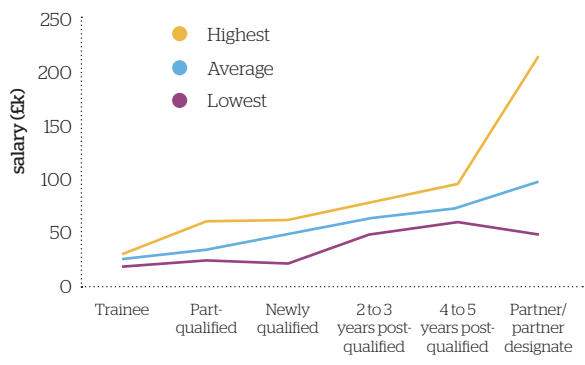


AVERAGE SALARY BY EMPLOYMENT TYPE

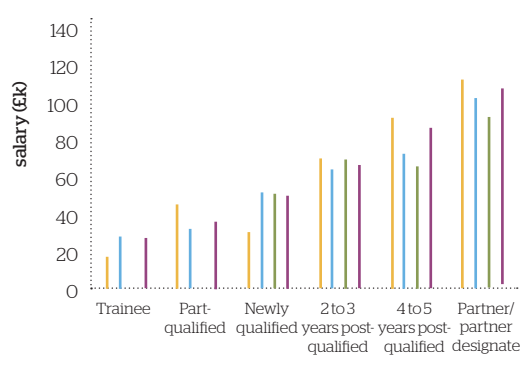


22

UK SALARY RANGE BY YEAR OF FIRST QUALIFICATION



AVERAGE SALARY INCLUDING BONUS



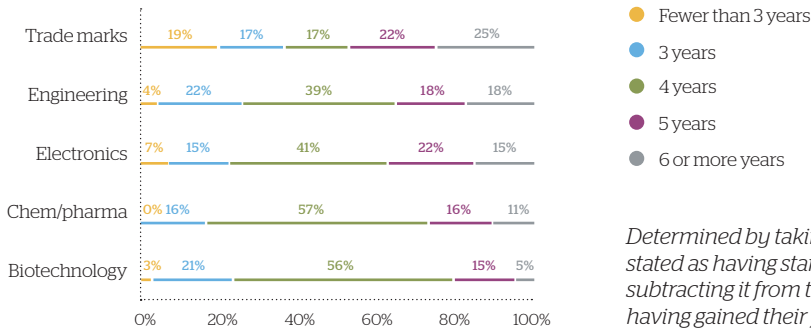
AVERAGE SALARY BY SPECIALISM (£K)

Specialism	Trainee	Part-qualified	Newly qualified	2 to 3 years post-qualified	4 to 5 years post-qualified	Partner/partner designate
Biotechnology	28.9	306	418	672	73.9	92.4
Chem/pharma	-	346	495	68.4	-	126.9
Electronics	-	341	50.4	65.8	77.0	87.6
Engineering	28.0	381	51.6	66.3	75.0	102.1
Trade marks/copyrights/design	18.0	28.0	38.9	58.6	75.2	84.3

- In house/industry ●
- Private practice: unrelated to billable hours ●
- Private practice: related to billable hours ●
- Private practice: combination bonus ●

QUALIFICATION TIMELINE

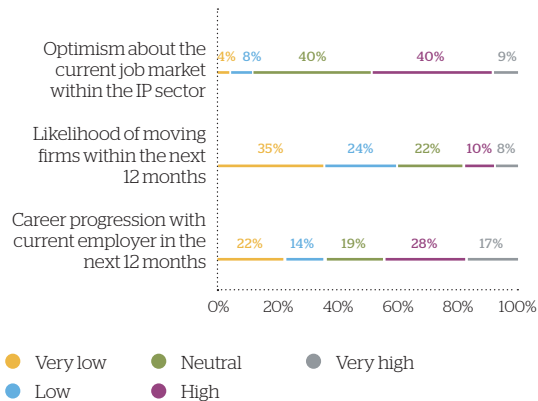
YEARS TAKEN TO QUALIFY BY SPECIALISM



Determined by taking the year the respondent stated as having started in the IP sector and subtracting it from the year they stated as having gained their first qualification

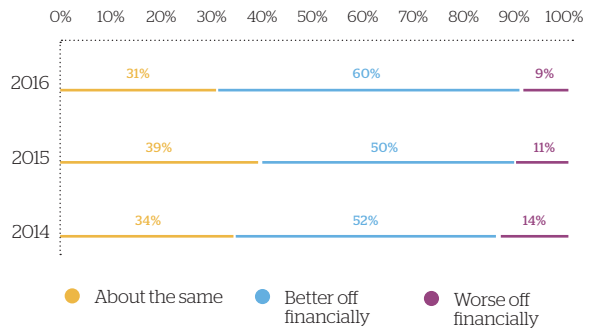
OUTLOOK FOR THE FUTURE

OPTIMISM REGARDING CAREER IN 2016



FINANCIAL STABILITY IN THE COMING YEAR

Respondents' feelings of financial security in 2016 compared with 2015 and 2014



FAST TAKES: BENEFITS



of respondents receive 25 days holiday or more



of respondents have paid for professional memberships



of respondents receive private healthcare



of respondents receive a pension of some sort

Survey author: Michele Fellows **Number of participants:** 228 **Method of collection:** Data collected from a salary survey of the IP profession carried out between 15 December 2015 and 29 February 2016. The online survey was accessible through a weblink, which was promoted on the websites of Fellows and Associates, *The Patent Lawyer Magazine* and The Chartered Institute of Patent Attorneys. Full survey results can be found at fellowssurvey.com and fellowsandassociates.com



TALKING TURKEY

Mutlu Yıldırım Köse examines how a proposed change to Turkish IP Law will affect trade marks and designs

In order to comply with the codification system of the Turkish law further to the decisions of the Constitutional Court, a draft IP law (the Draft Law) has been prepared by the Turkish Patent Institute (TPI) relating to all IP rights other than copyrights. On 24 February 2016, The Ministry of Science, Industry and Technology circulated the Draft Law on the TPI's website, with the consultation ending on 4 March 2016.

When enacted, the Draft Law will replace the decree-laws pertaining to the protection of trade marks, patents, geographical indications and designs, all of which date back to 1995, by bringing them together under one collective statute. It consists of five chapters and approximately 200 provisions, with definition provisions at the beginning and common provisions at the end. It incorporates

the provisions already contained in the existing decree-laws, while introducing some new ones as well.

The Draft Law uses the term "industrial property" and is named The Industrial Property Law. The term "intellectual property" is considered to be more comprehensive and in compliance with international notions. Therefore, it is hoped that, in line with the comments and suggestions, the name of the Draft Law will be changed to The Intellectual Property Law before the draft code is sent to the Council of Ministers.

The aim of the proposed revisions to the trade mark and design chapters is to accommodate some problematic areas experienced during the implementation of the previous decree-laws, filling the gaps that emerged due to the decisions of the Constitutional Court and

becoming further compliant with EU directives.

TRADE MARK SPECIFICS

Importantly, the terminology for the distinctiveness of a trade mark has changed. Accordingly, signs to be registered as trade marks are regulated in the Draft Law as follows: "A trade mark, provided that it is capable of distinguishing the goods and services of one undertaking from the goods and services of other undertakings, and can be shown in the Registry, ensuring that the subject of the protection provided to the trade mark owner is clearly and precisely understandable, may consist of all kinds of signs, such as words, including personal names, designs, colours, letters, numerals, sounds and shapes of the goods or their packaging." Therefore, as under the new EU Trade Mark Directive, to be counted a trade mark, it would be



The design chapter of the Draft Law includes changes that achieve greater compliance with the relevant EU directives

sufficient if the subject matter of protection is clearly and precisely understood.

Another notable change is that the Draft Law introduces the principle of coexistence into Turkish trade mark law. Accordingly, letters of consent from senior trade mark owners or application owners, or coexistence agreements, shall be acceptable in overcoming the citations of earlier, senior, identical or indistinguishably similar trade marks by the TPI as an *ex officio* refusal ground. This is an important change, which overcomes the present *ex officio* refusal that prevents the registration of many new trade marks.

IP IMPACTS

Furthermore, the term for opposition for trade marks has been shortened to two months from three. It is also worth noting that the TPI's Trademarks and Industrial Design Bulletins will now be published twice monthly, rather than once a month, following a recent decision by the TPI.

Another change that will directly affect IP practice is that, during the opposition proceedings before the TPI, opponents will have to prove genuine use, or produce justified reasons for non-use within the past five years, of trade marks that they cite as grounds for the opposition, if so requested by the applicant. Accordingly, if the opponent cannot prove genuine use or produce justified reasons for non-use, the opposition will be rejected. There is a similar provision for infringement actions as well. Thus, non-use of a trade mark cited as grounds for an infringement

action can also be cited in defence in an infringement action.

As the Draft Law gives the TPI the task of reviewing evidence filed relating to the genuine use of the relevant trade mark(s) during opposition proceedings, when the first version of the Draft Law was shared by the TPI, a discussion followed about whether or not claims for annulment of registered trade marks due to non-use should also be handled by the TPI (instead of by civil courts). Following the consultation on the draft, a provision was added stating that the right to invalidate a trade mark on grounds of non-use rests with the TPI. However, the enforcement date of this provision has been postponed for seven years.

MAJOR AMENDMENTS

Other main amendments contained in the Draft Law with regards to trade marks are:

- signs containing geographical indications cannot be registered as trade marks;
- bad faith has been added as a separate ground for opposition and cancellation;
- the five-year period for filing a cancellation action has been regulated under a separate provision; and
- the holder of a trade mark will not be able to argue that it has a registered right, and that its use of a registered

right cannot constitute infringement of an earlier mark.

The design chapter of the Draft Law also includes changes that achieve greater compliance with the relevant EU directives. First of all, the name of the chapter has been changed from Industrial Designs to Designs and, regardless of whether they are industrial or not, all designs will be protected. Further, the provisions regarding spare parts have been harmonised with EU law; unseen parts/devices (eg parts of an engine) cannot be registered as designs.

Another change is that novelty examination has been introduced for design applications. Therefore, if the Draft Law enters into force, the TPI will review the novelty of designs, which will give it another task to handle. Further, the criterion for distinctiveness has been changed to "difference" from "significant difference". The opposition term has also been shortened to three months from six months.

The Draft Law is deemed to be a favourable development and it is expected to resolve some major issues for IP rights-holders. It will be finalised after receiving the opinions of stakeholders. It will then be sent to the Turkish Parliament for discussion and enactment. It is expected to enter into force later in 2016. ■



Mutlu Yıldırım Köse

is a Managing Associate at Gün + Partners, Istanbul
mutlu.yildirim@gun.av.tr

One in the eye

Timely filing of additional evidence might have seen off this challenge, writes Charlotte Wilding

THIS CASE CONCERNS Visioncare at Home Limited (VCH) and Visioncall Limited (VL), companies offering eye care passports or reports primarily aimed at elderly care homes.

VCH applied to register the mark shown below right under Application No 3032938, as well as filing a declaration of invalidity against VL's UK Registration No 2652006 for EYE D on the basis of Sections 47(2) and 5(4) (a), and Sections 47(1) and 3(6) of the Trade Marks Act 1994 (TMA). VL later opposed VCH's application on the basis of Sections 5(2) (b), 5(3) and 5(4) (a), and Section 3(6) TMA.

The Hearing Officer issued the below decisions on 4 June 2015:

1. Invalidation – failed in its entirety. Registration No 2652006 therefore remained valid;
2. Opposition – partially succeeded. Application No 3032938 was permitted to proceed to registration in respect of a reduced specification; and
3. VL was awarded costs of £2,300.

On 2 July 2015, VCH filed an appeal against the first decision, which would have repercussions in respect of the second and third decisions if successful.

GROUNDINGS OF APPEAL

Under Sections 47(1) and 3(6) TMA, VCH argued that VL did not have the right to file an application for EYE D, as the mark was devised by an employee of VL at an event held by VL for customers and staff. This was dismissed by the Hearing Officer on the basis that "VL had the right to file an application for a mark created by an employee of a wholly owned subsidiary".

“

The Appointed Person held that, as the companies presented themselves as a single undertaking, there was no consumer deception

Further, this ground was not expressly addressed in the appeal and there was no application to amend the grounds of appeal, such that additional arguments could not be considered.

The Appointed Person confirmed the Hearing Officer's findings that there "was no impropriety on the part of VL in applying for registration in VL's name of the EYE D trade mark, which had been put forward by [an employee] and her group".

With regard to Sections 47(2) and 5(4) (a) TMA, the Hearing Officer held that VL had established prior goodwill in the mark from June 2012, whereas VCH's goodwill in its mark only began to accrue from its launch in November 2012. VCH argued that any goodwill in VL's mark in fact belonged to the user of the mark, Community

Eyecare (UK) Limited (CEL), trading as Visioncall, meaning VCH had the earlier goodwill and rights.

The Appointed Person held that, as CEL is a wholly owned subsidiary of VL, and the companies presented themselves as a single undertaking, there was no consumer deception and the benefit of consumer goodwill was attributed to the Visioncall group (ie CEL and VL). As an aside, it is worth noting that VL was not permitted to supply additional evidence supporting its arguments under this ground.

In view of the above, the appeal was unsuccessful and the award of costs increased to £3,200.

COMMENT

This case highlights the need to provide all documents and arguments at the earliest possible date, so as to be able to rely on them in proceedings. It is well established that additional arguments will not be considered, particularly where an application to amend the grounds of appeal has not been filed.

The VCH mark No 3032938



Charlotte Wilding

is a Senior Associate at Keltie LLP
Charlotte.Wilding@keltie.com



It's nothing personal

Ben Evans reminds applicants to be objective about their marks

THIS CASE CONCERNED an appeal to the Appointed Person of the UK IPO's decision to uphold an opposition brought by The Polo/Lauren Company LP against HQ Accountancy Solutions Ltd's (HQ's) application for a mark for various goods in class 25.

The opposition was brought under Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (TMA) based on various registrations for the mark POLO (and variations of the same) in class 25.

The Hearing Officer, deciding on the papers, upheld the opposition against all of the goods in HQ's application on the basis of Section 5(2)(b) TMA and thus did not proceed to consider the merits of the Sections 5(3) and 5(4)(a) TMA grounds. In finding in favour of the Opponent, the Hearing Officer, applying *Sabel BV v Puma AG*, considered that the average consumer would perceive the HQ mark as "comprising the word POLO with a picture of a polo mallet alongside it. It will not be seen as an invented and stylised word TPOLO".

THE APPEAL

At appeal, HQ argued that the Hearing Officer had erred in two respects: 1) that the opposition had been filed out of time and thus should have been rejected; and 2) that the Hearing Officer was wrong to reject the application on the basis that the application was for the word POLO not TPOLO.

Amanda Michaels, sitting as the Appointed Person, dismissed the first Ground of Appeal referring to Section

80(2) TMA (references to days are to business days) and finding HQ's argument in its first Ground as being "technically incorrect".

The Appointed Person also dismissed the second Ground of Appeal, finding that the Hearing Officer was correct to consider the application as objectively perceived by the average consumer, regardless of the Applicant's intentions when creating the mark in question.

PERCEPTION POINTS

In dismissing HQ's second Ground of Appeal, the Appointed Person confirmed that the marks are to be considered from the notional objective standpoint of the average consumer, and thus that the Hearing Officer had not erred in his conclusion that the mark would not be perceived as a five-letter word beginning with the letter T (ie TPOLO), but instead as the word POLO with a picture of a polo mallet alongside it. While HQ may have intended the mark to be TPOLO, which was accepted by both the Hearing Officer and the Appointed Person, it is not the subjective perspective of the Applicant that is to be considered. The Hearing Officer was therefore correct to consider the mark from the objective perception of

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The Appointed Person confirmed that the marks are to be considered from the notional objective standpoint of the average consumer

the average consumer and had not, as the Applicant had alleged, replaced the same for his personal opinion.

CONCLUSION

This decision raises no new points of law, but is nonetheless a useful reminder of the basic principle of an appeal (that it is a review and not a re-hearing) and the importance of considering marks from the perspective of the average consumer, not through the lens of one's own opinion or by relying on the Applicant's intentions.



Ben Evans

is an Associate and Trade Mark Attorney at Blake Morgan LLP
ben.evans@blakemorgan.co.uk

adidas earns its *STRIPES*

Marie McMorrow discusses
an instructive footwear decision

THE CJEU has upheld a decision of the General Court that allowed adidas to oppose the registration of a trade mark consisting of two parallel stripes placed on the side of footwear.

The decision followed an application by Shoe Branding Europe to register a Community Trade Mark (CTM) that consisted of two parallel stripes on sports footwear. The goods for which the registration was sought were contained within class 25 of the Nice Agreement and covered “footwear”. An image of the mark is shown on page 29.

In 2010, adidas filed a Notice of Opposition to the registration of the CTM based on several earlier trade mark registrations, which included a CTM, registered in 2006, consisting of three parallel, equally spaced stripes applied to footwear, positioned in the upper area between the laces and the sole, as also depicted on page 29.

adidas claimed that the two-stripe mark was confusingly similar to its existing three-stripe registrations and that it would therefore take unfair advantage of, or be detrimental to, the repute of such marks pursuant to Articles 8(1)(b), 8(4) and 8(5) of the Council Regulation (EC) No 207/2009. The Opposition Division of OHIM rejected the opposition in 2012, as did the second Board of Appeal

(BoA) of OHIM thereafter. The key findings were as follows:

1. The BoA considered that the difference in the number of stripes and their respective positions on the footwear was sufficient to find that the marks were dissimilar.
2. It held that, notwithstanding the earlier reputation of the adidas trade marks, the differences in the number of stripes was sufficient to prevent any likelihood of confusion in the mind of the reasonably well-informed, observant and circumspect public. It held this notwithstanding that the goods were identical and that the earlier signs, taking their extensive use into consideration, could be considered to have at least a “normal degree of distinctiveness”.
3. It also considered that the relevant section of the public was unlikely to consider that there was a link between the two marks when taking into account the differences in the number of stripes and their positioning, regardless of the reputation of the earlier adidas marks. As such, despite recognising that adidas had used its three-stripe marks extensively and that, therefore, the marks enjoyed an enhanced distinctiveness, the BoA considered that adidas’s striped marks were inherently non-distinctive, so that they could only enjoy protection against identical or highly similar reproductions.

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The General Court found that minor differences, such as the lengths of the stripes, were not sufficient to influence the consumer’s overall impression

ADIDAS APPEAL

adidas appealed to the General Court, which upheld adidas’s appeal and annulled the BoA decision.

It found that the BoA wrongly held that the two marks were dissimilar, which meant that it had, in turn, wrongly decided that there was no likelihood of confusion on behalf of the public and that no unfair advantage was being taken of the reputation of the earlier adidas three-stripe trade mark.

It found that the BoA had attributed too much importance to the positioning and inclination of the stripes and whether they were in sets of two or three. The average consumer would only find these differences to be noticeable if they



had undertaken a close inspection of the products.

The General Court also found that the BoA was incorrect in disregarding a number of similarities between the two marks, including that they both included parallel stripes, were of the same width, were designed to contrast with the background to which they were applied, and were broadly in the same position on the side of the shoe.

After carrying out a global assessment of the two marks and considering the similarities, the General Court held that the BoA was wrong to decide that the marks were dissimilar. Consequently, the BoA was also wrong to find that the mark did not take unfair advantage of the earlier adidas mark.

CJEU APPEAL

Shoe Branding Europe appealed to the CJEU on a number of grounds, including that the General Court had: made an incorrect assessment of the average consumer; made an incorrect assessment of the likelihood of confusion of the marks at issue (in that the likelihood of confusion must be assessed globally); and demonstrated poor judicial conduct.

In a decision dated 17 February 2016, the CJEU upheld the General Court's judgment. The CJEU agreed with the General Court that the BoA had not provided a proper statement as to the reasons regarding the similarity of the signs at issue.

The General Court had found that minor differences between the marks, such as the different lengths and angles of the stripes, were not sufficient to influence the consumer's overall impression or negate the similarities between the marks. The CJEU therefore considered that the General Court had conducted a proper global assessment of the two marks and had not erred in law.

Consequently, Shoe Branding's appeal was dismissed and the General Court decision upheld, which meant that adidas's opposition succeeded.

IMPORTANT POINT

The decision in this case demonstrates the significance of trade mark owners

being able to demonstrate any acquired distinctiveness through use of marks.

Where a non-traditional mark may initially be considered to lack distinctiveness, once the distinctiveness can be established, protection may be much wider and brand owners may be able to enforce their rights much more effectively throughout the EU against competitors that seek to copy aspects of their trade dress.

Shoe Branding Europe's mark



The adidas CTM



Marie McMorrow

is a Partner at dwf
marie.mcmorrow@dwf.law

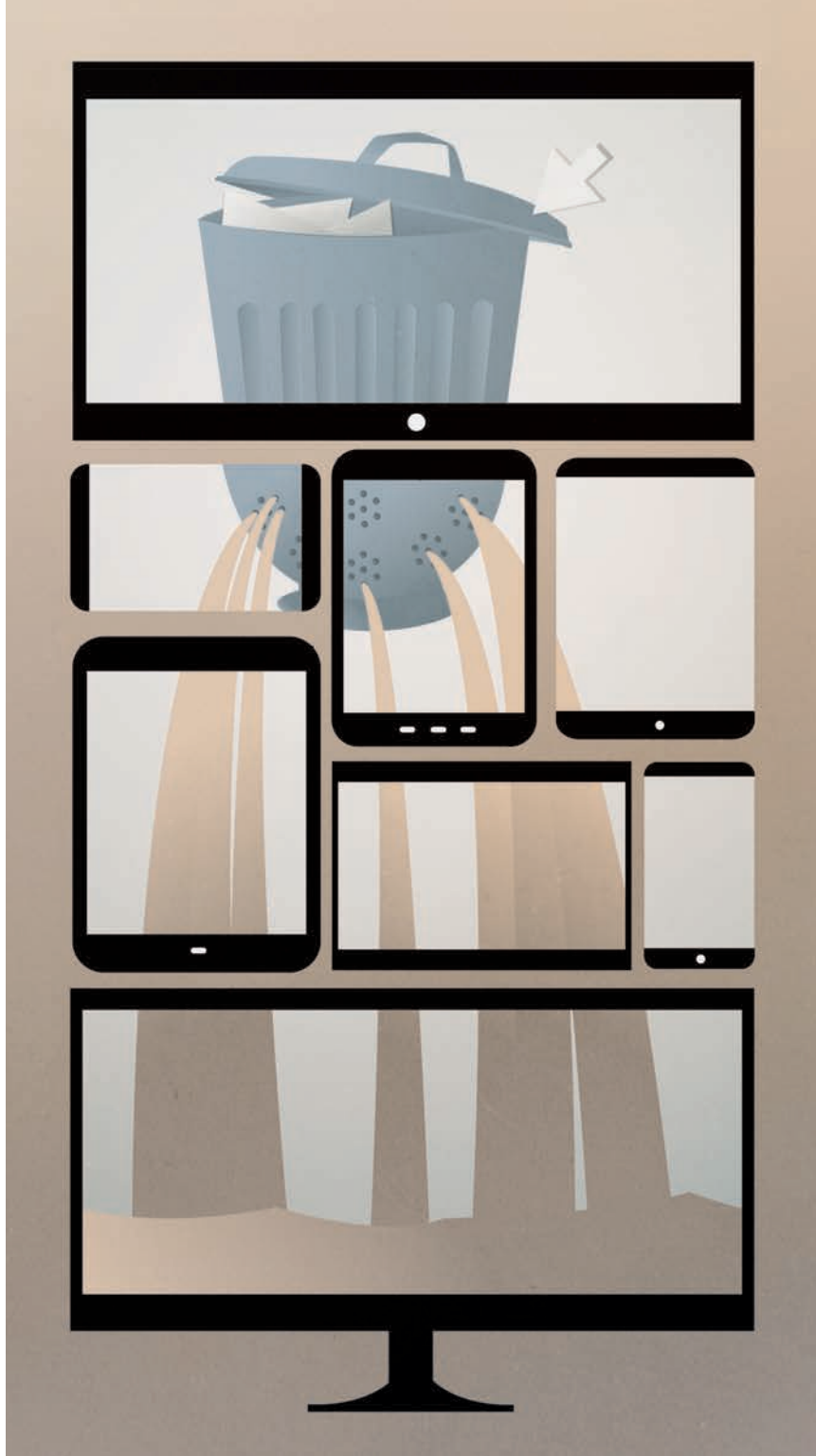
FOR A TRADE MARK proprietor to avail itself of protection of Article 5(1) of Directive 2008/95/EC and prevent a third party from using a sign identical or similar to its trade mark, it must, *inter alia*, overcome a preliminary hurdle of establishing that a third party is “using” such mark in the course of trade.

A finding of infringement will hinge, *inter alia*, on the meaning ascribed to the word “using”. A preliminary reference was made to the CJEU on this point in the context of online advertising. The CJEU ruled that, while the online publication of an advert referring to a third party’s trade mark is attributable to the advertiser, and so may amount to “use” by the advertiser, such use must involve consent, direct control or indirect control by the advertiser in order for a proprietor to rely on Article 5(1) against the advertiser.

The dispute in issue involved Daimler AG (Daimler) and Együd Garage (EG), a car dealership. A subsidiary of Daimler and EG entered into a contract for the supply of services. Under this contract, EG was entitled to use Daimler’s registered trade mark MERCEDES-BENZ.

EG used an online advertising service company, Magyar Telefonkönyvkiadó Társaság (MTT), to place an advert that stated that EG was an “authorised Mercedes-Benz dealer”. During this period, several other websites published, without EG’s consent, online adverts presenting EG as an authorised Mercedes-Benz dealer.

Following the expiry of the Daimler contract on 31 March 2012, EG requested that MTT amend its advert



Web control is considered

The Court was asked to clarify the concept of “use” in online advertising, explains Joel Smith

“

The CJEU noted that the expression ‘using’, according to its ordinary meaning, involves active behaviour and direct or indirect control of the act constituting the use

so that it no longer made reference to EG being an “authorised Mercedes-Benz dealer”. EG also wrote to the operators of websites that had published adverts without EG’s consent to request the removal of such adverts. Despite EG’s action, the advert containing the trade mark continued to remain on the internet, both through MTT’s service and other website operators.

Daimler brought an action before the Budapest Municipal Court seeking a declaration that, through the adverts, EG infringed its registered trade marks pursuant to Article 5(1), and an order that, *inter alia*, EG remove the adverts and refrain from further infringement. EG’s defence rested on its submission that it had attempted to end all use of the trade mark and that, other than the MTT advert, the adverts appeared without EG having any influence on their content or publication.

CJEU REFERRAL

The Budapest Municipal Court referred a question, which the CJEU interpreted as asking “whether Article 5(1) (a) and (b) must be interpreted as meaning that a third party, who is named in an advertisement published on a website, which contains a sign identical or similar to a trade mark in such a way as to give the impression that there is a commercial relationship between him and the proprietor of the trade mark, makes a use of that sign which may be prevented by that proprietor, even where that advertisement has not been placed by that third party or on his behalf, or where that third party took all reasonable steps to have it removed”.

As the CJEU noted, it is established law that the use of the trade mark by EG, without the proprietor’s

authorisation, to inform the public that EG carries out repairs of goods covered by that trade mark, or is specialised in such goods, constitutes, in certain circumstances, a use of that mark for the purposes of Article 5(1) (a). However, for the period in which the Daimler contract was in force, Daimler, as proprietor, consented to such use.

The crux of the issue was whether, following the expiry of the Daimler contract, EG was using the trade mark where: (i) EG had requested that MTT remove the original online advert; and (ii) online adverts, over which EG had no control, were placed on other websites without its consent.

The CJEU held that “an advertiser cannot be held liable for the acts or omissions of such a provider who disregards the instructions given by that advertiser ... Accordingly, where that provider fails to comply with the advertiser’s request to remove the advertisement at issue, the publication of that reference on the referencing website can no longer be regarded as a use of the mark by the advertiser.”

It also held that “an advertiser cannot be held liable for the independent actions of other economic operators, such as those of referencing website operators with whom the advertiser has no direct or indirect dealings and who do not act by order and on behalf of that advertiser, but on their own initiative and in their own name.”

Daimler, as proprietor of the trade mark, could not rely on Article 5(1) to require that EG remove the adverts and refrain from further infringement. The decision of the CJEU appears fairly consistent with general liability principles and, arguably, provides a common-sense approach. The CJEU noted that the expression “using”, according to its ordinary meaning, involves active behaviour and direct or indirect control of the act constituting the use. It was recognised that EG had requested that MTT remove the reference to “Mercedes-Benz”, and that it had no dealings with the operators of the “unauthorised” online adverts. Even though EG may have benefitted financially from the online adverts, EG had no control over them and, as the CJEU noted, “no one can be legally obliged to do the impossible”.

NEW CHALLENGES

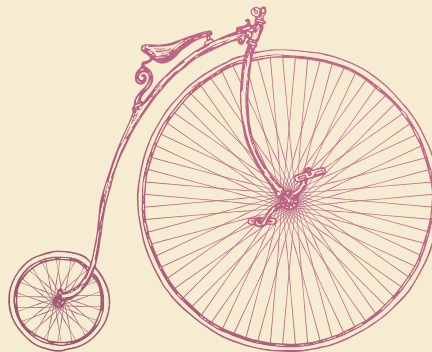
Online advertising is becoming one of the core channels through which many businesses communicate to the public. However, compared with more traditional forms of print advertising, internet advertising brings its own considerations, including the loss of control over an advert once it appears online. Where a trade mark proprietor has not consented to a third party using its trade mark in an online advert, to prevent such use, the proprietor should only consider deploying an argument under Article 5(1) where the advertiser has control over the use of the advert, or has consented to it. Where the advertiser has no control, or has not consented to the use, other avenues may have to be explored. As the Court highlighted, a proprietor could consider taking action directly against the website operators to force them to block the web pages (following the authority in the UK adopted in *Cartier International v British Sky Broadcasting*).



Joel Smith

is a Partner in the IP group at Herbert Smith Freehills LLP
joel.smith@hsf.com

Jessica Welborn, Associate at Herbert Smith Freehills LLP,
co-authored this article.



Going global

The Court affirmed the importance of a global approach to assessment, reports Oliver Tidman

THE EU GENERAL COURT has confirmed the decision of the OHIM Board of Appeal (BoA) that there was a likelihood of confusion under Article 8(1)(b) Council Regulation (EC) No 207/2009 (the Regulation) between a proposed Community Trade Mark (CTM) application for INFINITY and two earlier figurative CTMs consisting of the word element “infini” and a figurative element of three quadrilaterals (shown below).

part similar. It could not be disputed that, *inter alia*, the bicycle rims and rear view mirrors in the earlier marks were included in the category of bicycle parts and accessories in the proposed CTM, with the result that the goods in class 12 were identical. The BoA had also been correct to find that exercise bicycles in class 28 were similar to bicycles in class 12, explaining it was irrelevant that they were in a different class, as similarity depended on objective comparison.

were identical and the presence of the final syllable “-ty” in the proposed CTM did not prevent the existence of that similarity. The BoA did not err in finding that the marks were conceptually identical in Belgium and France, as the French word “*infini*” is the root of the English word “infinity”.

Accordingly, the Court confirmed the BoA’s finding that there was a likelihood of confusion between the marks.

32

BACKGROUND

On 25 April 2012, Infinite Cycle Works Ltd (the Applicant) filed a CTM for the word mark INFINITY in classes 12, 25 and 28. On 13 July 2012, Chance Good Ent Co Ltd, filed a notice of opposition pursuant to Article 41 of the Regulation based on the two earlier figurative CTMs. On 10 October 2013, OHIM allowed the CTM application in respect of “clothing; headgear; [and] footwear” in class 25 and “inline skates” in class 28, but rejected it in respect of “bicycles; bicycle parts; [and] bicycle accessories” in class 12 and “exercise bicycles” in class 28.

On 22 November 2013, the Applicant filed a notice of appeal with OHIM, pursuant to Articles 58 to 60 of the Regulation, against the decision of the Opposition Division.

THE DECISION

The Court agreed that the respective goods were in part identical and in



The first three syllables of each mark were identical and the presence of the final syllable ‘-ty’ in the proposed CTM did not prevent that similarity

The marks were also held to be visually similar, with the word element of the earlier marks reproduced in full in the proposed CTM. The figurative element consisted of simple geometric shapes, and therefore could only be regarded as a commonplace and banal element. From a phonetic perspective, the first three syllables of each mark

GLOBAL APPROACH

The decision serves as a reminder of the global assessment required. If the Court had adopted the approach taken by the Applicant, it would have had the effect of disregarding the similarity of the marks in favour of one based on the distinctive character of an earlier mark, which would then be given undue importance. Consequently, where an earlier mark is only of weak distinctive character, a likelihood of confusion would exist only where there was a complete reproduction of those marks, whatever the degree of similarity.

The Infini mark



Oliver Tidman

is a Senior Solicitor at Burness Paull LLP
Oliver.Tidman@burnesspaull.com

Keeping it real

The Court reviewed the principles underpinning the comparison of marks, says Maya Muchemwa

IN 2010, Tayto Group Ltd (Tayto) applied to register the figurative mark REAL HANDCOOKED (the Mark) for goods in classes 29 and 30.

On 28 September 2010, MIP Metro Group Intellectual Property GmbH & Co KG (MIP) filed an opposition to Tayto’s application based on its earlier registration for REAL QUALITY (the Earlier Mark) covering classes 29 and 30. MIP’s opposition was based on Article 8(1)(b) of Council Regulation (EC) No 207/2009 (the Regulation). Both marks are shown below.

MIP’s opposition was upheld. Tayto then filed a notice of appeal to OHIM under Articles 58 to 64 of the Regulation against the decision of the Opposition Division.

By a decision of 6 October 2014 (“the contested decision”), the Fourth Board of Appeal (BoA) of OHIM dismissed the appeal.

Tayto then brought an action against the BoA’s decision.

THE CLAIM

Tayto’s action was based on four points, including infringement of Article 8(1)(b), three of which were dismissed by confirmation of the contested decision.

Tayto did not dispute the German public as the relevant consumer, nor did it dispute the comparison of goods, as several goods covered by both marks were undoubtedly either identical or similar.

Instead, Tayto’s claim disputed the assessment of distinctive and dominant elements of the marks, the similarity of the marks and the likelihood of confusion. Its contention was set out in three parts:

- i. The Earlier Mark was devoid of distinctive character;
 - ii. The BoA’s finding that the consumers understood the meaning of the Earlier Mark’s word elements ought to have led to a finding that the Mark was descriptive; and
 - iii. The finding of similarity should not have been reached solely on the basis of the word element “real”, which was wrongly considered as dominant.
- The Court confirmed the BoA’s finding of inherent distinctiveness on the basis that “the distinctive character of a mark must be assessed specifically by reference to the goods or services designated”. Although the consumers understood the terms “real” and “quality”, they had no meaning in regards to the goods in question, and thus the Mark would not evoke the nature of the goods.

The Court confirmed the BoA’s decision on descriptiveness on the basis that the German public would not perceive the Mark as an “expression on its own”, as it was unaccustomed to multilingual expressions.

As to similarity, the Court recalled that both marks are figurative, with the word “real” as the dominant element and the accompanying words being smaller in size, thus creating an impression of visual and aural similarity. The “handcooked”

element of the Mark was considered negligible due to its size.

Conceptual similarity between the marks was also disputed on the basis that the Mark formed a “whole having a distinct conceptual meaning”. The Court rejected this argument due to the negligible nature of the “handcooked” element of the Mark and concluded that the elements “real” and “handcooked” could not “form a meaningful whole”.

The Court concluded that the marks were similar.

WEIGHTY ISSUE

This decision serves as a reminder that the more negligible an element of a mark, the lesser weight it carries in a comparison – particularly when it is so small that it is almost illegible, as it is unlikely to affect how consumers perceive the mark visually, aurally or even conceptually.

The Tayto mark



The MIP mark



Maya Muchemwa

is a Trainee Trade Mark Attorney at Marks & Clerk
mmuchemwa@marks-clerk.com



Positive step for Hot Sox

The disputed mark is distinctive for hosiery decides the Court, Sharon Daboul reports

RENFRO CORP (the Intervener) had registered a Community Trade Mark covering the word mark HOT SOX (the Mark) for “hosiery” in class 25. ProVima Warenhandels GmbH (the Applicant) filed an invalidity action. It relied on Articles 7(1)(b) and (c) of Council Regulation (EC) No 207/2009 as the grounds for demonstrating that the Mark lacked distinctive character and was descriptive of the goods.

The Applicant had been unsuccessful before the Cancellation Division and the Board of Appeal (BoA) on the basis that, even were the element “sox” understood by consumers as being a misspelling of the word “socks”, the word “hot” was unnatural and fanciful for clothing.

The Applicant appealed to the General Court.

DECISION

The General Court agreed with the BoA, finding that the term “hot” as in “extremely warm” or “very high temperature” describes neither a characteristic of socks, nor their purpose. The function of socks is to keep feet warm, and not to make them hot, so “hot” might actually be seen as an undesirable connotation.

The Court considered that the term “hot” has other meanings, including something fashionable, or seductive and provocative. The Court affirmed the decision of the BoA, which had held that these meanings were neither non-distinctive nor descriptive for “hosiery”.



The Court found that the incorrect spelling of ‘sox’ would attract consumers’ attention in combination with the term ‘hot’

The Applicant also tried to show that “sox” is an obvious misspelling of the English word “socks”, making the Mark descriptive of the goods. The Court did consider this argument but noted, from the evidence, that the term “sox” did not replace the term “socks” in the Intervener’s use of the Mark. The term “sox” was always accompanied by the adjective “hot” and it was never used in isolation.

To be descriptive, the public would have to immediately perceive, without further reflection, a direct and specific relationship between the sign and the goods in question. The Court held that it is not enough for one of the elements of a sign to be descriptive,

and that the Mark should be examined as a whole.

The Court found that the incorrect spelling of the element “sox” would attract consumers’ attention. In combination with the term “hot”, which is unusual for hosiery, the Mark formed a sufficiently original whole to be capable of meeting the minimum threshold for distinctive character.

Overall, HOT SOX was held to be acceptable for registered trade mark protection.

ENCOURAGING OUTCOME

This decision reiterates some of the key factors that are relevant to the examination of an application on registrability grounds. It is a reminder that, for a mark to be descriptive, it must describe a characteristic of the goods. In this case, HOT SOX did not describe hosiery, despite the multiple connotations of the term “hot”. Further, the case is a reminder that, where a mark consists of a very obvious misspelling, it may still confer distinctive character.

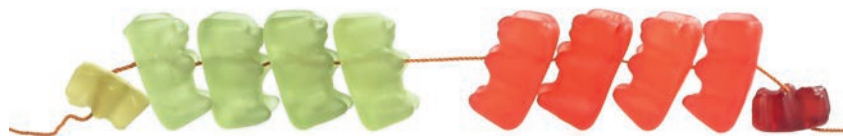
While the outcome is perhaps not surprising, it is encouraging and provides an opportunity to review the Court’s common-sense assessment on registrability.



Sharon Daboul

is a Registered Trade Mark Attorney and Senior Associate at EIP
sdaboul@eip.com

Based in London, Sharon handles UK, Community and international trade mark portfolios, including searches, filing, prosecution and maintenance of trade mark rights.



Cadbury's *sweet* victory

The Court has given Mederer something to chew over, writes Rupert Bent

THE APPLICANT in this case, Mederer GmbH (Mederer), sought, by way of an international registration designating the EU, to register a figurative mark containing the words “gummi bear-rings” (the Contested Mark, shown below) in class 30 for “confectionary consisting of or containing fruit gum and/or foam sugar and/or jelly”. Cadbury Netherlands International Holdings BV (Cadbury) successfully opposed the registration, based on Article 8(1) (b) of Council Regulation (EC) No 207/2009, relying on its earlier Spanish figurative mark in class 30, which contained the word “gummy” (the Cadbury Mark, shown below).

In 2012, Cadbury opposed the registration of the Contested Mark on the grounds that the mark was, by reason of its similarity to the Cadbury Mark, likely to cause confusion on the part of the public in the territory in which the Cadbury Mark was registered. After evidence of use was provided, OHIM’s Opposition Division first determined that the relevant territory was Spain.

The Opposition Division, finding that the goods covered by the marks were identical, focused on the marks themselves. It found that the inclusion of the word “gummi” in the Contested Mark caused the marks to be visually and aurally similar, both “gummi” and “gummy” sharing all but one letter and sounding identical when spoken. The Opposition Division further found that the words had no meaning for the Spanish public and, as such, the marks had no conceptual similarity. Noting that the average consumer’s level of attention when purchasing

confectionary is low, the Opposition Division found that there was a likelihood of confusion, and therefore rejected the Contested Mark pursuant to Article 8(1) (b).

APPEAL

Mederer subsequently appealed the decision. It argued that the Opposition Division had erred by not giving sufficient weight to the other elements of the Contested Mark, namely the graphic element and the word “bear-rings”, both of which, it claimed, should be awarded greater significance than the smaller word “gummi”. In affirming the Opposition Division’s decision, OHIM’s Board of Appeal (BoA) held that the positioning of the word at the beginning of the Contested Mark meant that a consumer with a low level of attention would be drawn to it. The BoA further determined that the almost identical nature of the words “gummi” and “gummy” meant that the other, dissimilar elements would be overlooked.

Still not satisfied, Mederer appealed the BoA’s decision. It submitted that the Opposition Division and the BoA had wrongly considered that the term “gummy” had no meaning for the relevant public and argued that it was an English word descriptive of the goods at issue that would be

understood by Spanish consumers. The General Court rejected this argument and, confirming earlier case law, found that the average consumer’s knowledge of foreign languages could not be assumed and, in any event, the word “gummy” was not a basic English word. The General Court held that Spanish consumers would regard the word as fanciful and would therefore be more likely to associate the Contested Mark with the Cadbury brand. The General Court accordingly rejected Mederer’s appeal.

REMINDER

The decision provides a useful reminder of a number of themes relevant to the assessment of Article 8(1) (b). In particular, applicants should bear in mind the positioning of words within a figurative mark, as well as the relevant public’s understanding of those words.

The Contested mark



The Cadbury mark



Rupert Bent

is a Partner and Head of Intellectual Property at Walker Morris
rupert.bent@walkermorris.co.uk

Unoe: a case for the complex

Having reviewed this decision, Elliot Stafford suggests the value of using a combination of broad and narrow terms

IN JULY 2012, 1&1 Internet AG (the Applicant) filed a Community Trade Mark (now EUTM) application for the word mark 1E1 (the Mark) in classes 35, 38, 42 and 45, covering internet design, creation and advertising services. The Mark was opposed by Unoe Bank SA (the Opponent) on the basis of Article 8(1)(b) Council Regulation (EC) No 207/2009, citing its two previous registrations: a word mark, UNO E, in class 45; and a figurative mark, 'unoe', in classes 35, 38 and 42.

In the first instance, the opposition was rejected by the examiner. However, the Board of Appeal (BoA) subsequently upheld the opposition, finding a likelihood of confusion due to the earlier marks' average levels of distinctiveness, the aural similarities between the marks, and the finding that they convey the same concept of 'one' (notwithstanding that the targeted Spanish consumers may not confuse the marks conceptually).

The Applicant appealed to the General Court against the BoA's decision.

DISPUTED POINTS

The Applicant claimed that it disputed the relevant public as determined by the BoA, although it seems that it merely disputed whether the relevant public had been properly taken into account when assessing confusion. It submitted that, although consumers use the services in these classes frequently, they do not regularly purchase them, and, when they do, the price is high.

The Applicant also disputed the finding of identity for the services

in class 35, and of high similarity/identity for the services in classes 38, 42 and 45. The General Court agreed with it insofar as the services in class 45 were concerned; the opposition based on that class was dismissed. However, the General Court determined that the services in the remaining classes were, in fact, contained within the scope of the services registered for the earlier figurative mark, and were therefore identical/highly similar.

The comparison of the marks was limited to the earlier figurative mark and the Applicant's Mark, both of which were found to have an average level of distinctiveness. The General Court then found that, although the marks were not visually similar, and were only conceptually similar to a weak extent, they were phonetically similar to an average degree.

Despite finding an average degree of phonetic similarity and a weak degree of conceptual similarity between the marks themselves, and an identity/high degree of similarity between the services, the Court nonetheless found that there was no likelihood of confusion.

INTERESTING ASSESSMENT

The assessment of the services is interesting here. Notably, the services in classes 35, 38 and 42 of the

Applicant's Mark were deemed to fall within the broader terms of the specification of the Opponent's mark. This decision reminds practitioners to carefully consider whether specific terms are, in fact, encompassed by broader, more general terms. It flags the potential value of drafting specifications that include both broad and narrow terms, as a protective measure and to enable effective enforcement, and also from a defensive standpoint in case of opposition.



Elliot Stafford

is a Trainee Solicitor at Stobbs
elliott@stobbsip.com

Setback for Advance

Chris Morris explains why a counter-attack was counterproductive

THIS CASE CONCERNS an appeal against a decision of the Fourth Board of Appeal (BoA) of OHIM to dismiss Advance Magazine Publishers' (Advance's) appeal against the Opposition Division's decision to uphold an opposition against its application to register the word mark VOGUE CAFÉ. The original opposition was based on three earlier marks, shown below.

The appeal was unsuccessful, and the decision of the General Court reinforced previous principles relating to: i) the impact on appeals of related actions, and the timing of those actions; and ii) the suspension of proceedings pending the outcome of other actions.

The key point of the appeal was that registrations No 255186 and No 2529728 no longer exist, having been cancelled by the Spanish courts. Mark No 2529728 was cancelled *ab initio*, but No 255186 was revoked with effect from a date after the adoption of the contested decision.



The Board of Appeal justified the decision not to suspend on the grounds that mark No 3064219 was not the sole basis for opposition

BASIS FOR OPPOSITION

As mark No 2529728 was cancelled *ab initio*, the General Court confirmed it must be deemed to never have had legal effect and could not, therefore, form a basis for opposition.

In contrast, as mark No 255186's revocation took effect after the date of adoption of the contested decision, the mark still had full legal effect on the date of the decision. The General Court confirmed that, in accordance with established case law, it was right that the mark was a valid basis for opposition and must be taken into account.

The General Court then went on to consider the supplemental argument that OHIM had wrongly found the Opponent's proof of use in respect of mark No 255186 to be adequate. This was also dismissed, and the Court upheld the opposition on the basis of mark No 255186.

SUSPENSION

Advance also argued that proceedings should have been suspended, pending its opposition against mark No 3064219. The General Court confirmed that OHIM has broad discretion in deciding whether to suspend proceedings. In this case, the BoA justified the decision not to suspend on the grounds that mark No 3064219 was not the sole basis for opposition. Since the

opposition succeeded on other grounds, No 3064219 was not decisive and there was no need to suspend. The General Court agreed and this plea was also dismissed.

SENSIBLE RESTATEMENT

This case is a sensible restatement of existing principles and a reminder to practitioners that, when considering counter-attacks as a form of defence, careful thought needs to be given as to whether the eventual outcome will actually assist the client's case in the final analysis.

The marks at issue



Spanish registration No 255186



Spanish registration No 2529728



CTM application No 3064219



Chris Morris

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

Name is no use

A strategy of reputation by association was not enough to satisfy the Court, reports Désirée Fields

IN MAY 2007, Group Lottuss Corp SL filed a Community Trade Mark (CTM, now EUTM) application for the word mark COYOTE UGLY in classes 41 and 43. Ugly Inc (Ugly) opposed the application based on its earlier CTM for COYOTE UGLY, a registration that had been revoked at the date of the opposition. Ugly also sought to rely on its alleged unregistered rights in the mark COYOTE UGLY and claimed that the mark was well known within the meaning of Article 6bis of the Paris Convention.

OHIM's Opposition Division rejected the opposition. OHIM's Board of Appeal (BoA) upheld the decision, finding that:

- Ugly's CTM registration for COYOTE UGLY had been revoked before the filing date of the opposition;
- Ugly's evidence focused on the *Coyote Ugly* film and soundtrack and did not prove that Ugly itself had used the mark in the course of trade in the EU; and
- the operation of Ugly's chain of bars in the US under the name *Coyote Ugly* was not well known in the EU.

BASIS FOR OPPOSITION

On appeal to the General Court, Ugly argued that the BoA had erred in assessing both the effect of the declaration of revocation of Ugly's earlier CTM and the evidence of the existence of Ugly's earlier rights.

Dismissing the appeal, the General Court noted that it was established law that a CTM was deemed revoked from the date of the application for revocation. Since Ugly's earlier CTM had been revoked prior to the filing of the opposition, the mark could not be relied upon as a basis for opposition.

Ugly argued COYOTE UGLY was a non-registered mark under Article 8(4) of Council Regulation (EC) No 207/2009. Ugly's evidence, which focused on the *Coyote Ugly* film and soundtrack rather than Ugly's own use of the mark, included untranslated Spanish documents; printouts from imdb.com and Wikipedia; internet search results for the term "coyote ugly"; and copies of extracts from the United States Copyright Registry attesting to the registration of the motion picture *Coyote Ugly* and its merchandise. Most of the evidence related to the US and was confined to entertainment services in class 41.

Ugly does not own the COYOTE UGLY mark in relation to the film, and there was no evidence that the film's copyright owners were using that sign on Ugly's behalf. Ugly's argument was essentially that the film was based on its chain of bars in the US and was very successful. Therefore, Ugly argued, people within the EU were aware of the link between the film and Ugly's bar and COYOTE UGLY was a non-registered mark. However, neither this line of argument nor the evidence submitted met the threshold for demonstrating that Ugly had used the mark COYOTE UGLY "in the course of trade" in the EU.

Ugly relied on the same evidence to argue COYOTE UGLY was a

“

Ugly does not own COYOTE UGLY in relation to the film, and there was no evidence that the film's copyright owners were using that sign on Ugly's behalf

well-known mark. However, this argument was also dismissed, because the evidence mainly concerned the film's success (Ugly was unconnected to both the film and soundtrack), and failed to indicate the degree of knowledge or recognition of the mark in the EU.

DESTINED TO FAIL

Establishing unregistered rights and well-known trade mark status requires the production of the right evidence, both qualitatively and quantitatively. By relying on the high-profile success of the film and soundtrack, Ugly sought to rely on a reputation in the mark COYOTE UGLY that was not its own. Its case was, therefore, destined to fail.



Désirée Fields

is a Legal Director at DLA Piper UK LLP
desiree.fields@dlapiper.com

Désirée's practice focuses on trade marks and brand protection.

Bethan Lloyd, an Associate at DLA Piper, contributed to this article.

Dental impression

Conceptual confusion was not found, giving Aldi cause to smile, writes Clare Liang

IN THIS CASE, which examines the factors determining whether likelihood of confusion exists within the meaning of Article (8) (1) (b) of Council Regulation (EC) No 207/2009, the General Court considered the balance to be struck between the visual, phonetic and conceptual features of the marks when considering their overall impression. It upheld the Board of Appeal's (BoA's) decision, which overturned that of OHIM's Opposition Division.

BACKGROUND

In February 2012, Aldi Karlsruhe K/S (Aldi) filed opposition proceedings against a Community Trade Mark application by credentis AG for the word mark CURODONT in respect of goods and services in classes 3 and 44. The opposition was based on Danish registration number VR 199406075 EURODONT.

The Opposition Division found the contested goods "dentifrices [and] mouthwashes" to be identical, and "cleaning and polishing preparation for use in dental technology and dental practices" to be similar to the goods protected by the earlier mark. However, the contested services in class 44 were regarded as dissimilar to the goods in class 3. Furthermore, the Opposition Division found that there was a clear conceptual difference between the marks due to the inclusion of the element "Euro" in the earlier mark. The Opposition Division took the view that this conceptual difference outweighed the visual and aural coincidences, and the opposition was rejected in its entirety.

Earlier mark: EURODONT

Class 3 - Mouthwashes and dentifrices, not for medical purposes, in particular toothpastes and mouthwashes

Contested mark: CURODONT

Contested goods and services:

Class 3 - Cleaning and polishing preparation for use in dental technology and dental practices; dentifrices and mouthwashes

Class 44 - Hygienic and beauty care for human beings

ALDI APPEAL

Aldi successfully appealed the decision. The BoA found that the contested goods in class 3 were identical to those protected by the earlier mark, and the contested services in class 44 were similar. Crucially, the BoA took the view that the marks should be considered as a whole, and that there was no conceptual similarity between them, indicating that the prefix "Euro" has no specific meaning in relation to the protected products. Citing an extensive list of case precedents, it emphasised that, because the mark applied for reproduced in substantial part the earlier mark, the signs were sufficiently similar to make the relevant public believe that the identical goods and services in the application have the same trade origin or are economically or industrially linked.

RESOLUTION

The General Court agreed with the BoA and upheld its decision, reiterating that "the sole difference of one letter between the signs at issue cannot cancel out the similarity between them". Bearing in mind the visual and phonetic similarity of the marks, as well as the identical and similar goods and services, "the likelihood of confusion must be assessed globally, according to the relevant public's perception of the signs and the goods and services in question, and taking into account all factors relevant to the circumstances of the case".

This case illustrates how any conceptual similarity between marks tends to be regarded as less likely to cause confusion than where there is visual and aural similarity.



Clare Liang

is a Trainee Trade Mark Attorney at Appleyard Lees IP LLP
Clare.Liang@appleyardlees.com

A MINI victory for BMW

For registrations, Kathryn Charles counsels considering the most challenging public

IN THIS CASE, relying on Article 8(1)(b) of Council Regulation (EC) No 207/2009 and its earlier word mark MINI (registered for goods in class 12), Bayerische Motoren Werke AG (BMW) successfully opposed registration of LG Developpement's (LG's) figurative mark MINICARGO as a Community Trade Mark (CTM). BMW's opposition was rejected at first instance, but it successfully appealed to the OHIM Board of Appeal (BoA), whose decision was affirmed by the General Court.

RELEVANT PUBLIC

The General Court considered that the French public alone was not the relevant public, as the absence of a likelihood of confusion in France did not rule it out elsewhere in the EU. However, it was sufficient that a likelihood of confusion existed in part of the EU, and the BoA was therefore entitled to restrict its assessment of the likelihood of confusion to the UK public for procedural economy.

THE GOODS

The General Court confirmed that the "trailers" for which LG sought registration were within the broader category of "land vehicles" covered by BMW's mark, which was not limited to a particular market or method of marketing (as LG had argued). The goods in issue therefore included identical goods.

THE MARKS

The marks were confirmed as being visually similar to an average degree,

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The marks were confirmed as phonetically similar to an average degree, as the English-speaking public would pronounce 'mini' identically

the word "mini" being common to both marks, and "cargo" being descriptive of the goods and devoid of distinctive character. The figurative elements of LG's mark did not dispel the impression of visual similarity: the red rectangle and white letters of LG's mark were not novel, and the sparkle above the letter "n" would either go unnoticed or draw the attention of consumers to the word "mini".

The marks were also confirmed as phonetically similar to an average degree, as the relevant English-speaking public would pronounce "mini" identically. However, the BoA had erred regarding conceptual

similarity. The word "mini" only characterised the size of the object designated, whereas "cargo", meaning "load", determined the mark's meaning; therefore, the marks were conceptually similar only to a low degree.

However, taken as a whole, there was an average degree of similarity between the marks and, as the goods covered by the marks were identical, and the enhanced distinctiveness of BMW's mark was not disputed, the General Court found there was a likelihood of confusion.

The argument that the "mini" in MINICARGO would be understood as the opposite of "maxi" in LG's French trade mark MAXICARGO was rejected, and French decisions relied on by LG were neither binding nor relevant to an assessment of the likelihood of confusion as regards the relevant public in the UK.

CONCLUDING THOUGHTS

When dealing with a CTM (now EUTM) application, it is prudent to take care to look at the EU as a whole. Grounds for refusal of registration, or for revocation, should be considered from the perspective of the relevant public in the most challenging part of the EU for the mark in question.



Kathryn Charles

is a Trainee in the IP team at Gowling WLG
kathryn.charles@gowlingwlg.com

Alexandra Brodie, a Partner in the IP team, assisted with this article.

Celebrate summer at the ITMA Summer Reception on 5 July



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events

More details can be found at itma.org.uk

Date	Event	Location	CPD hours
8 June	ITMA Webinar Yoyo.email v RBS case*		1
14 June	IPO & ITMA Roadshow	Burges Salmon, Bristol	1
28 June	ITMA London Evening Meeting Up to date in the Rolls Building†	Royal College of Surgeons, London WC2	1
5 July	ITMA Summer Reception including new President's Address §	Institute of Directors, London SW1	
20 July	ITMA London Evening Meeting †	Royal College of Surgeons, London WC2	1
6 September	IPO & ITMA Roadshow	Charles Russell Speechlys LLP, London	1
14 September	ITMA Webinar *		1
27 September	ITMA London Evening Meeting †	Royal College of Surgeons, London WC2	1
6 October	ITMA Autumn Seminar & Drinks Reception †	Hyatt Regency, 2 Bridge St, Birmingham	5
25 October	ITMA London Evening Meeting †	Royal College of Surgeons, London WC2	1
16 November	ITMA Webinar *		1
22 November	ITMA London Evening Meeting †	Royal College of Surgeons, London WC2	1
9 December	ITMA Christmas Lunch and Drinks Reception *	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 host or speak at an ITMA event. We would also like your suggestions on event topics. Please contact Jane at jane@itma.org.uk with your ideas.

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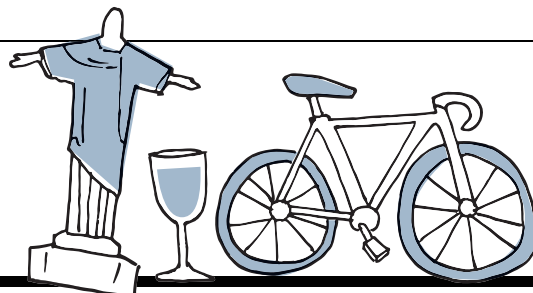


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THE TRADE MARK 20

Q&A



I work as... Advocate and head at Salomone Sansone in Valletta, Malta.

Before this role, I... spent some time as a trainee at Deloitte Malta, before moving on to read articles with a local law firm. I was then managing partner at a law firm I set up with a friend from my university days. Eventually, we parted ways while I was busy restructuring the family IP practice, which I now lead, into a fully fledged law firm.

My current state of mind is... busy busy busy, but happy. I just love my work and consider myself lucky in this regard. I combine this with quality time with the wife and kids, whenever I can get it.

I became interested in IP when... my grandfather, who had been practising on his own for more than 20 years, let me into his world and began explaining what he did. I quickly realised the international flavour to IP work, and it was not long before I was spending hours helping my grandfather wherever possible.

I am most inspired by... the precious lessons my grandfather taught me: never allow yourself to become too anxious about a problem; it never helps. Keep calm, check the law and the answer will be found, perhaps the next day and with a fresh mind.

In my role, I most enjoy... obtaining favourable judgment in cases involving large amounts of counterfeit goods. Trade in counterfeits is a scourge, and it



Overseas member
Dr Luigi Sansone seems to
be lacking nothing

gives IP lawyers a sense of purpose to feel they are representing clients on the right side of the fence in the ongoing battle against the underworld.

In my role, I most dislike... nothing, absolutely nothing.

On my desk is... close to nothing. It's the end of the day and I make sure to clear my desk before I leave to go home.

My favourite mug says... nothing; I don't drink instant coffee or soup. I love my espresso machine and can't live without it.

My favourite place to visit on business is... Rio de Janeiro; no doubt about that.

If I were a trade mark or brand, I would be... No Name – I hate showing off!

The biggest challenge for IP is... the battle against the ever-growing trade in counterfeit merchandise and piracy.

The talent I wish I had is... nothing. I'm nearly 47 now and happy the imperfect way I am.

I can't live without... having something to do. I guess I'll never retire.

My ideal day would include... a good, healthy start to the day on my bicycle; driving the kids to school; a long and productive day at the office or in Court; and finally a great meal with a glass of good Italian wine. Happy days!

In my pocket is... nothing, really.

The best piece of advice I've been given is... honesty is the best policy. Never move out of line, and life will be good.

When I want to relax I... spend time with the wife and kids (who are not so small anymore, actually).

In the next five years I hope to... find ways to remain as productive as ever while managing to somewhat reduce the long working hours.

The best thing about being a member of ITMA is... exposure to friends and colleagues from all over the world.

Dawn Ellmore Employment

Patent, Trade Mark & Legal Specialists



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There is some flexibility on the level of experience applicants may have, and we are inviting applications from candidates with a drive and passion for trade marks, whose ideas on how to improve the firms' existing portfolio would be welcomed.

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Business support: james.smithson@dawnellmore.co.uk

+44 (0)20 7405 5039

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