

# CITMA REVIEW

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figures step up on  
mental health?*

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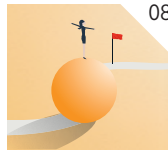


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## PRESIDENT'S WELCOME SPRING SEES OUR WORK CONTINUE

As spring approaches, we are continuing our work across a range of areas. In particular, our work on address for service and representation before the UK IPO is still very much ongoing and remains a key priority for CITMA.

Thank you to everyone who took part in our recent "town hall" meeting. We had an excellent turnout, and the questions and feedback have fed directly into the planning of our next steps. We are looking forward to updating you on our progress.

This will be my final column as President, so I'd like to take the opportunity to make a few important acknowledgements.

The past two years have not been without their challenges, but I'm proud of what CITMA has achieved. Being trusted with this role has been deeply gratifying. Thank you all for your support during my term - I look forward to continuing to contribute to CITMA.

I would like to pay tribute to the network of volunteers who help to keep our work moving forwards. It is the support of these individuals and their firms which has allowed us to achieve all that we have over the past few years.

I would also like to offer my best wishes to my successor, with hopes for a more "normal" term than my own.

Richard Goddard, CITMA President



## Joint honour at 2021 CITMA awards

We were delighted recently to announce the winners of the 2021 CITMA awards. Although we were not able to present the awards at a Christmas Lunch as is traditional, we look forward to congratulating the winners in person soon.

The awards are presented annually for the highest marks achieved by a Student member on the trade mark attorney qualification courses

at Queen Mary University of London, Bournemouth University and Nottingham Law School. In addition, the Roy Scott Award is presented to the student who achieved the top mark on the CITMA Paralegal Course.

This year also saw an unusual joint award, as two participants scored 94 out of 100 in the final exam. On receiving the news, both winners noted that they were honoured to have their efforts recognised in this way.



## SPRING CONFERENCE WILL SEE US RE-CONNECTING

Booking is open for our first major in-person event of the year, our Spring Conference at IET London: Savoy Place. Register at [citma.org.uk/sc2022](http://citma.org.uk/sc2022)

### CITMA AWARD WINNERS 2021:

**Roy Scott Award**  
Gyongyver Filser,  
Freelance  
Szu-Yu Tao,  
Pinsent Masons

**Postgraduate Certificate  
in IP at Bournemouth  
University**  
Hannah Cowley,  
Armstrong Teasdale

**Postgraduate Certificate  
in Trade Mark Law and  
Practice at Queen Mary  
University of London**  
Abigail Macklin,  
D Young & Co

**Professional Certificate  
in Trade Mark Practice  
course at Nottingham  
Law School**  
Jessica Fuller,  
Brand Murray Fuller

*For more information, please visit [citma.org.uk/cawards](http://citma.org.uk/cawards)*



### IPREG CONSULTATION OPEN NOW

IPReg has invited responses to a consultation on its regulatory arrangements. The review will clarify and solidify IPReg's current goals and direction. Responses are welcomed until 5pm on 17th March 2022. Find out more at [citma.org.uk/ipcon](http://citma.org.uk/ipcon)



### UAE JOINS MADRID PROTOCOL

The United Arab Emirates is now the 109th jurisdiction to become a signatory to the Madrid Protocol. It follows Bahrain and Oman as the third Gulf state to join the Protocol, having officially acceded on 28th December 2021. Learn more at [citma.org.uk/uaemadpro](http://citma.org.uk/uaemadpro)



### NO ACTION ON EXHAUSTION

The UK Government needs more time to explore a new exhaustion of IP regime, meaning no change is imminent, it has announced. Following a consultation, the Government said "there is not enough data available to understand the economic impact of any of the alternatives to the current regime". Read more at [citma.org.uk/ipregime](http://citma.org.uk/ipregime)



# HELPING PEOPLE FIND THEIR CAREER IN IDEAS

Andrea Brewster introduces a new mentoring scheme for would-be recruits

**To improve diversity** in the IP professions, we also need to broaden the upstream pipeline. IP Inclusive's "Careers in Ideas" campaign does just that. It's there to raise awareness of, and improve access to, IP sector careers. It produces information, resources and events for two groups: school, college and university students who might want to join the IP professions, along with their advisers; and IP professionals doing outreach work such as careers talks and open days. The Careers in Ideas website showcases various IP-related careers and features basic information and personal stories. We also build relationships with relevant charities and community interest groups, which can help us reach people who haven't yet heard of IP careers – or of IP itself.

There's a problem, though. We can raise awareness and enthuse new candidates. But as they try to enter this new world, they're up against people with parents or friends already in the sector, or students whose schools and universities give training in interview skills and CV writing. So candidates from less privileged backgrounds, much as they might like to join us, often don't measure up to more privileged incomers. Perhaps they're discouraged from even trying.

To help with this, Careers in Ideas has run online application-skills masterclasses that provided tips for creating CVs and covering letters and preparing for interview when applying to train as a trade mark or

patent attorney. These sessions have proved popular, with many attendees contacting the panellists afterwards for further support and advice.

Now, under the leadership of CITMA member Carol Nyahaha (Baron Warren Redfern), we're building a Mentoring Hub to help would-be recruits navigate their way into the IP professions. Mentors in IP-related careers provide general

“

*The recruits we help in 2022 will be the mentors of 2026*

advice about where and when to look for jobs, the skills needed, how to frame an application and what to expect of the recruitment process. The scheme is designed for mentees who don't already have access to this information and support.

Careers in Ideas is about all kinds of IP-related career, so we need mentors in all roles: in-house or private sector,

fee-earning or business support. And from different career levels too. Sometimes it's useful to hear from someone who has only recently joined the sector and knows how it feels to be on the rollercoaster of applications, interviews, rejections and offers.

The time commitment for each mentor is up to the individual and needn't be huge. We use the online MentorLoop platform to match our mentors with mentees and to streamline procedures. Training and support are provided too.

We're confident that this new scheme will help a wider range of people into IP careers. We know it will be rewarding for the IP professionals involved. And the recruits we help in 2022 will be the mentors of 2026, with each cohort providing more diverse role models for future entrants.

If you're a UK-based IP professional, we'd love you to join us as a mentor. Wherever and however you work, you're sure to have useful information and experiences to share.

*For more information and contact details, visit [ipinclusive.org.uk/careers-in-ideas-mentoring-hub](https://ipinclusive.org.uk/careers-in-ideas-mentoring-hub)*



**Andrea Brewster OBE**

is Lead Executive Officer at IP Inclusive

Find out more at [ipinclusive.org.uk](https://ipinclusive.org.uk)

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# “HAVING IT ALL FEELS CLOSER THAN IT EVER DID BEFORE”



Charlotte Duly reflects on her progress as a woman in IP

I was initially excited, and a little flattered, to be asked to write this article. Who wouldn't relish the chance to write a personal piece in their own voice and to be a little less “lawyer”. But no sooner had I accepted than the unwelcome presence of imposter syndrome made itself felt. I had to remind myself that I am a woman who has worked in IP for close to 20 years, progressing to partnership; given my experience and the insights I have gained, I ought to be well placed to be of some assistance to others.

IP as a legal discipline attracts a good proportion of women. Perhaps this is due to the varied

entry channels, the nature of the work or the fact that the hours can be less onerous than some other areas of law and more conducive to family life. However, there is still some way to go in making sure that women are just as likely as men to remain within the profession and progress from junior to senior positions.

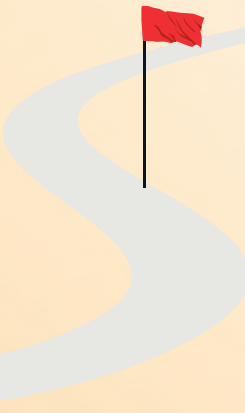
That brings me back to imposter syndrome. A common trait among women, from what I see, is that we pretend we can cope with doing almost everything – working, commuting, housework and childcare – but still feel that we're failing. I've heard it said numerous times that men apply for a job when they meet only 60%

of the criteria, but women apply if they meet 80-100% of them. Men are perhaps more realistic, whereas women are aiming for perfection: a debilitatingly high bar to set oneself from the outset.

## MY OWN IP PROGRESS

I was previously a partner in a firm of attorneys and I am currently in a senior position at a firm of solicitors, so I have progressed through many levels. Early on, I felt that my biology was an issue; I was conscious of it and felt others were too. For example, there was interest, whether conscious or unconscious, as to when I might have children and when the right timing would be, from a career





“ *Don't let imposter syndrome or self-doubt derail you. Apply for that job, put your hand up and lean in* ”

point of view, to take such a step. There was the pressure I put on myself, given my desire to progress to partnership level and to be seen as being capable and present, but others in the profession, notably those in senior positions, also expressed an opinion.

I always wanted to progress to a senior role. I enjoy the flush of autonomy and the thrill of added responsibility that comes with a more senior position. I enjoy training others. I love seeing my team members develop and flourish, becoming the best they can be. In my experience, some women have traditionally felt that they need to act in an aggressive or overbearing manner in order to be a successful leader. They felt that they had a tough time and so others behind them should too. In effect, these women were pulling up the ladder rather than extending an encouraging hand. Happily, times have changed, and I want to be an encouraging leader to my colleagues. And as I've progressed, I have learned that while I may not be able to control how others view women, particularly those in senior positions, I can adjust my own attitude and how I present myself to others.

**BENEFICIAL BREAK**

I am fortunate to work for a firm that offers family-friendly

coaching and promotes family-friendly programmes to all parents, irrespective of gender. It also offers a female leadership programme, which focuses on women recognising their strengths, cultivating their personal brand and leadership. This has allowed me to reflect on my strengths and leadership style and identify ways to get the most out of my career. I was concerned that by embarking on the programme I was simply adding to my already busy schedule, but taking time out to stop, reflect and grow during the working day has been enormously beneficial. I have been allowed to build up a range of important tools, such as breathing techniques and mindfulness. Importantly, I now better understand how my presence and use of language affects others, and how to interpret what others may be thinking or feeling in order to grow my empathetic nature.

As far as helping women achieve their goals and be the best they can be, I've realised that being authentic and honest is key. Let people know what you think and feel; show that you are not a robot but a human being. Be honest if you are uncontactable for an hour because you've decided that attending your child's nativity play is important. (It is!) As long

as the work is under control and colleagues know what you're up to, be honest. These infrequent events take just a short amount of time out of your long working life.

I've learned that wherever you want your career to go, it's important to have a plan and to discuss it with your line manager. How else can they know you want to become a partner, or to travel, or to undertake whatever task interests you if you don't tell them? Help them to help you.

**BE MORE YES**

When it comes to that next role, don't let imposter syndrome or self-doubt derail you. Apply for that job, put your hand up, lean in, go for it and be more "yes". You cannot control other people, but there are steps you can take to help you progress and have the career you want. And women, let's support each other, let's encourage each other. Let's be honest about the challenges we face. I've still got a lot of work to do in this area, but as I continue through my career, including managing and supporting female colleagues, I hope to be a positive role model, to inspire my colleagues, and try to be as authentic as possible. Maybe I am not quite having it all, but it feels closer than it ever did before. ●



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# ARE YOU A LEADING LIGHT?

When it comes to caring for mental health in IP firms, success starts at the top. We asked some senior leaders how they're stepping up

**M**any *CITMA Review* readers will have heard of Jonathan McCartney. But for those for whom the name is new, he was an avid football fan, a kind friend and a loving son. He was also a successful patent attorney, pursuing a career that he loved. Tragically and unexpectedly, in 2017 at the age of just 35, Jonathan took his own life. His family set up the charity Jonathan's Voice in his memory.

As we've reported in the pages of the *Review*, Jonathan's struggle with his mental health is sadly not rare among legal professionals. Mental health charity LawCare found that more than two-thirds of those surveyed had experienced mental ill-health during 2020. In addition, of those who had, almost half did not feel comfortable talking about their struggles at work. While 2020 may have been a particularly stressful year, a 2019 survey by IP Inclusive found that more than half of respondents had been adversely affected by stress in the preceding 12 months, with at least 20% suffering from depression and 40% from anxiety.

"Take a look at the number of people you know who have had some difficulty over the last two years. Now multiply that by around four. Then you might be getting close to the true number of people having difficulties at any one time," says Catherine Wiseman, Partner and Head of Trade Marks at Barker Brettell.

Legally, all employers have a duty of care to their employees to support not only their physical health in the workplace, but also their mental wellbeing. Yet it's clear to many that such support starts at the top. "Having senior leaders involved in and promoting mental health campaigns signals support, encouragement and understanding of the importance of mental health and in wanting to help those who might be experiencing mental ill-health," says Mary Bagnall, Partner and Head of Intellectual Property at Charles Russell Speechlys.

Recognising the role that senior leaders play in creating a workplace that supports openness and wellbeing, Jonathan's Voice published "Advancing the mental health and wellbeing agenda: ▶

“Cuppa tea” catch-ups can help teams maintain contact



A guide for senior leaders in the intellectual property profession” last year. In return, the *Review* recently caught up with a number of CITMA members in senior positions, including Wiseman and Bagnall, to get a sense for how they and their firms are stepping up to support mental health.

#### WHY ARE IP PROFESSIONALS STRUGGLING?

Jonathan’s Voice and IP Inclusive cite the nature of IP professionals’ work as the most significant cause of mental health difficulties among them: a high workload coupled with tight deadlines and a need for razor-sharp accuracy can create a very stressful environment. This is especially true for perfectionists and particularly conscientious individuals, who tend to put more pressure on themselves to perform.

On top of this, the pandemic has added extra pressures to an already stressful line of work, with people having to cope with lockdown, illness, bereavement, loneliness, isolation and fear of COVID-19. It’s a sea of change, all on top of a heavy workload – triggering more situational and reactional difficulties, as opposed to clinical, ongoing and long-term mental issues – explains Bagnall.

It’s not just stress that can have an adverse effect on mental health in the workplace. Some individuals may be affected by issues related to

### “ Personal accounts and stories raise awareness and help individuals feel less alone

ethnicity, gender and sexuality. Certain groups, such as those from minority ethnic groups and the LGBTQ+ communities, or people with disabilities, are more vulnerable to experiencing mental health difficulties at work. This is why equality, diversity and inclusion work is also intricately connected to staff wellbeing. The firm Mewburn Ellis has prioritised inclusion and diversity using results from a staff survey and feedback sessions as the foundation of a three-year plan to “help our people to feel they belong and can bring their true self to work”, explains Partner and Head of Trade Marks Kate O’Rourke. Importantly, that plan has been developed together with people from all parts of the company and shared firmwide so that leaders in the firm are held accountable for keeping to the timetable, she adds.

#### OPEN THE CONVERSATION

The foundation of better mental health in any organisation is a culture that supports staff wellbeing

and mental health. And in this respect, “there’s always more that firms can do,” says David Stone, Global Head of IP at Allen & Overy. His firm, he says, is taking a partner-led approach that includes fostering a culture in which mental health can be openly discussed. “We’re really centred on people. We try not to focus on poor mental health linked to lack of work/life balance, but rather to take a holistic approach to all the reasons, inside and outside of work, why someone might need support with their mental health.” The firm has more than 40 mental health advocates, made up of partners and other senior professionals, from across the firm’s global offices.

Mental health is talked about more than it was 10 years ago, but some still consider the topic taboo. “Work must continue on normalising conversations about mental health difficulties so that we can reduce and remove stigma,” says Wiseman. “It’s OK to talk about it and everyone needs to feel that.”

Wiseman’s firm, Barker Brettell, also has a set of mental health advocates and ensures everyone knows who these people are through the firm’s telephone directories. Such mental health champions and first aiders help to encourage conversation and dialogue within teams and offer support where individuals may not feel as comfortable speaking to senior colleagues.

Personal accounts and stories invite empathy, raise awareness and help individuals who are suffering to feel less alone. Communicating these also shows that the firm is open to talking about the issue. To this end, Wiseman is open with her team about her own experiences, for example if she is having a tough day: “I want them to be able to be honest with me about how their day, week or life is going. It’s important to build strong relationships with team members, as you then care about each other

and work together to help each other through rough times.”

Charles Russell Speechlys ran a video campaign through which employees, including two senior executives and a leading partner, spoke about their issues. “It was incredibly brave and powerful,” says Mary Bagnall. “It said, essentially, that mental health difficulties can affect anyone, at any level, and should – in fact must – not be perceived as career-limiting.”

David Stone believes that whether or not you have experienced mental health challenges, it’s important to be an active ally to those who have: “I’ve found it helps to listen, educate myself, and try to understand things from their perspective.”

Firms can also invite external speakers to share their stories. “Different speakers will attract different attendees, so it is important to provide different types of events to reach the widest audience possible,” advises Bagnall. In May 2021, more than 200 employees in her firm attended a virtual talk by former international Rugby Union referee Nigel Owens about his mental health struggles.

It’s important for senior leaders to actively engage in firms’ mental health awareness initiatives, says Kate O’Rourke. “I try and attend as many of the events as possible – it’s not enough to just encourage other people to go. Leadership teams, including all partners and senior managers, must demonstrate that they understand the issues and are willing to not just speak up, but also take action to make change.”

Bagnall agrees: “The more campaigns that are run in-house, the more normalised these conversations are, the more senior leaders engage in campaigns or share personal insights – the more likely individuals will feel comfortable to have a conversation.”

#### MANAGE THE PRESSURE

Firms should also examine current company practices and tackle unhelpful aspects of company

## TIPS FOR THE TOP: LEADING A WELLBEING WORKPLACE

- **Have a staff mental health policy and plan.** The UK Government’s “Thriving at Work” review (an independent review of mental health and employers by Lord Dennis Stevenson and Paul Farmer) can be a useful tool when structuring your plan.
- **Challenge the stigma.** Ensure the firm talks about mental health, whether through speaker events or actively signposting resources, and as a leader be open about your experiences.
- **Be honest and authentic.** Being genuine, compassionate and honest in the way you approach this topic is key to creating trust and, in turn, a psychologically safe space for employees to express their difficulties without fearing negative consequences. Jonathan’s Voice recommends first examining your own feelings surrounding mental health difficulties. Only then can you approach the issue with authenticity.
- **Challenge unhelpful company culture.** This includes ending presenteeism and discouraging long hours. And make sure to encourage staff to have a healthier work/life balance.
- **Make resources available.** Give employees access to educational resources and apps, employee assistance programmes, counselling and therapy through private medical schemes. Make sure

people are aware these supports exist and how to use and access them. Ensure your health scheme allows employees access to a range of therapeutic options.

- **Be a good listener.** Listening to what your staff have to say is important too. Consider attending training courses on active listening.

- **Assess mental health risk.** In some cases, it is possible to manage the workflow hazards caused by mental health not only by managing stress and workload levels in the first instance, but also by creating contingency plans for when

someone is off sick or needs to take some pressure off. For instance, it’s often a good idea to have two attorneys assigned to significant clients or cases.

- **Don’t forget that mental health in the workplace is not just about stress.**

Consider, for example, how diversity and inclusion or bullying and harassment is addressed. Such issues also affect how safe people feel in the workplace.

- **Ensure the message comes from the top.** If the senior leadership team doesn’t walk the talk, meaningful change is less likely to happen. Senior staff should be involved in all initiatives across the firm.

- **Don’t think you’re finished.** Regularly audit, go back and see if there’s more you and your firm can do.



During the pandemic, Barker Brettell issued staff with Pause for Mind Boxes to encourage them to take some time out



culture such as presenteeism, long hours and working while taking paid time off. These are often seen as “just part of the job”, but they can raise the risk of stress, anxiety and burnout.

You might worry that such a change in company culture could lead to a decline in standards or an increase in disappointed clients. However, a challenge for any leader is balancing your responsibility across successfully achieving a task, leading your team, and meeting the needs of the individuals within it. There is almost never a perfect balance, but without paying attention to all three of these considerations, a team cannot be successful.

Balancing the needs of clients and their tasks with the needs of your team is never going to be simple – but it is important. “Clients are paying for talented minds, and they are not necessarily going to get the best client service if the lawyers are burnt out, anxious or depressed,” says Bagnall. She has always adopted a team culture whereby her team

works together to assist anyone who feels they cannot cope with their workload. “We have weekly team meetings where workloads and deadlines are discussed, and all the necessary assistance is given to anyone who feels overburdened. Our team-based approach assists in balancing the needs of clients as we identify pressure points and work together to meet the clients’ needs collectively without any one person having to be overwhelmed.”

on time. This occasionally requires us to pull out all the stops – for a deal or a court deadline,” he explains. “At other times, a conversation can work well to set some expectations. I think clients understand that looking after our people is better for all in the longer term.” But leaders must walk the talk: “It is clear that this culture requires buy-in from the top,” says Bagnall. For instance, if you are telling staff that they shouldn’t be working at certain times, lead by example.

## “ Clients understand that looking after our people is better for all in the longer term

works together to assist anyone who feels they cannot cope with their workload. “We have weekly team meetings where workloads and deadlines are discussed, and all the necessary assistance is given to anyone who feels overburdened. Our team-based approach assists in balancing the needs of clients as we identify pressure points and work together to meet the clients’ needs collectively without any one person having to be overwhelmed.”

In this regard, David Stone underscores the importance of managing client expectations. “Clients of course expect the work they are paying for to be right and

### SPOT THE SIGNS

It is important to be able to recognise the signs that someone, including yourself and other senior leaders, is struggling and know when and how to refer it on. “It is easy to think that this is just about looking after the staff and that the partners are somehow above this,” admits Bagnall. The truth is, anyone can be affected, from the most junior to the most senior employee.

Recognising that someone is struggling often involves being able to spot when someone’s behaviour has changed, so the signs will, by definition, depend on the individual. Some people

may become more reserved and others may take more time off. O’Rourke explains that her firm has noticed more instances of issues such as insomnia and migraines during the pandemic.

Such awareness has been made harder by the switch to remote and hybrid working, where regular face-to-face time with your team is no longer guaranteed. “Not being able to see our teams every day has made it harder to spot the signs,” says Wiseman. “This has meant that we have needed to keep in contact with our people and make more space to create and encourage opportunities for people to open up about how they are feeling.” In response, she scheduled weekly “cuppa tea” meetings with her team individually during lockdown.

The nature of the problems that someone may be struggling with and whether they are related to work will also affect how leaders should react. Will time off help? Can reasonable adjustments be made? It is likely that they will need to refer the person to someone with specialist expertise, such as a GP.

For leaders, it is important to educate yourself and all members of the firm about the support that is available. “Employee Assistance Programmes are a good support, but the biggest hurdle is getting people to use them,” explains Bagnall. “Often, people are not aware of the support that is there, even though it will have been regularly advertised.”

It seems clear that those firms taking a preventative approach by creating an open and collaborative culture and proactively ensuring that measures are in place to support anyone struggling will better be able to support their workforce in the moments when they need it. “Being a lawyer or attorney in a City firm environment will necessarily have its pressures, but it is possible to thrive on the challenges while still ensuring good mental health,” says Bagnall. ●

# AN UNLIKELY PAIR?

Keith Havelock looks back at how trade mark and patent rights came to be the responsibility of the same office

**M**any would consider trade marks and patents to be chalk and cheese, so how did it come about that the Trade Marks Registry in the UK became part of The Patent Office?

The current head of the UK IPO, Tim Moss, who is by definition also the Registrar of Trade Marks in the UK, was appointed to his present position in 2017, having previously been head of the UK Companies Registry since 2012. This may of itself be indicative of an affinity between the respective offices. Both are executive agencies of the UK's Department of Business, Energy and Industrial Strategy. But can any similar affinity be deduced between trade mark and patent rights, apart from their both being monopolies in the gift of the state?

## AMALGAMATION

By the mid-19th century, the administration of patent rights had become the responsibility of the Commissioners of Patents, created by the Patent Law Amendment Act of 1852. This meant that responsibility for the day-to-day running of The Patent Office sat with the Clerk to the Commissioners.

In 1875, it was announced that "the offices for the registration of Designs and Trade Marks, having been amalgamated with The Patent



Office, Mr Bennet Woodcroft FRS, Clerk to the Commissioners for Patents, has been appointed Registrar of Designs. No formal appointment in connection with the Registration of Trade Marks has yet been made".

At this time, no office for the registration of trade marks had been established, and although amalgamation with The Patent Office was in the opinion of some contemporary commentators a "reasonable inference", the amalgamation was not essential. The office of Registrar of Trade Marks could have been combined with that of the Registrar of Companies, for example, and when the new Registry did eventually open, it was initially distinct from The Patent Office.

## INCONSPICUOUS ENTRANCE

The Trade Marks Registration Act 1875 mandated the establishment a Trade Marks Registry no later than 1st January 1876. In practice, the authorities were hard-pressed to meet this deadline. Establishing a classification system for goods for registration purposes caused great difficulty, and a final version, based on the system of classification that had been used for the Great Exhibition of 1851, was only settled upon in the December immediately prior to the January 1876 date.

Thus, on 29th December 1875, it was inconspicuously announced at the bottom of a column in *The Times*, that "the Trade Mark Registry Office will be open on 1st January in Quality Court, 47 Chancery Lane. Mr [Henry] Reader Lack of the Board of Trade is appointed Registrar". Mr Reader Lack, later Sir, had apparently accepted the position only on condition that his salary would be £1,500 per annum, which was at the time (with a few exceptions) the highest remuneration in public service.

And so it was that the UK Trade Marks Registry, together with the office of Registrar, became, following something of a last-minute scramble, formally associated with and ultimately a formal division of The Patent Office, later the UK IPO. ●

ALAMY



### Keith Havelock

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With acknowledgements to R.L. Moorby et al, *A Century of Trade Marks 1876–1976* (London: HMSO, 1976) and the *Journal of the Royal Society of Arts*, January 1976.



# A CONVINCING CASE

For Cherrie Stewart, a recent mock mediation webinar moved the needle

**F**or me, considering mediation raises many questions, such as: If you have a strong case, why mediate? Is an offer of mediation an admission of weakness to the other party? Does mediation sometimes lead to high emotions and angry confrontation between the parties, with little being resolved? So, when I heard that CITMA was holding a live mock mediation in November 2021, I saw it as an opportunity to deepen my knowledge of this subject and dispel any misconceptions I may have held.

## CASE RECAP

The mediation event was based upon a fictional scenario previously used in a mock case management conference and hearing staged by CITMA in September 2020 (a report of which appeared in *CITMA Review*, Issue 462).

To briefly summarise this fictitious case, Busy Ltd – the owner of a small café – had traded for 15 years and had secured a registration for its trade mark BUSY in respect of “cafés”. It had polled regular customers regarding the proposed use of the name BUSY BAKER relating to the supply of

homemade cakes and sandwiches. Upon checking the UK trade mark register, it discovered that one Andrew Baker had recently filed a trade mark application for BUSY BAKER covering “cakes; chocolates; chocolate sculptures” in class 30 and “mail order services relating to cakes, chocolates and chocolate sculptures” in class 35. Busy Ltd duly filed an opposition on s5(2)(b) grounds. Having discovered that Mr Baker was a regular visitor to Busy Ltd’s café and had responded to the poll carried out by Busy Ltd, a request for the insertion of s3(6) grounds



was made and accepted. While the s5(2)(b) grounds were dismissed, the s3(6) grounds were upheld and the registration was refused.

On the understanding that the Hearing Officer did not believe there to be a likelihood of confusion, Mr Baker created a website and started selling cakes under the mark “Busy Baker”. He also took out some advertisements that defamed Busy Ltd. Busy Ltd sent a Letter of Claim to Mr Baker alleging infringement under s10(2)(b) and s10(3). In response, Mr Baker threatened a counter-claim for a declaration of invalidity against Busy Ltd’s trade mark registration for the mark BUSY on the grounds that it lacked distinctive character.

The letter sent by Busy Ltd, being compliant with the Pre-Action Conduct and Protocols of the Civil Procedure Rules, suggested that the parties go through the process of mediation.

#### SAFE SPACE

During the live mock mediation webinar, we were shown a truncated version of a facilitated mediation. It was explained that mediation was a safe space in which the parties were invited to explore common ground in a confidential, non-binding and without-prejudice forum facilitated by a neutral mediator who would have a wider perspective and who could ask questions, challenge assumptions and ultimately assist the parties in identifying their needs and achieving a mutually beneficial agreement.

Opening statements from the parties themselves were made, setting out the situation from their own perspective. The parties were then placed into private rooms, with the mediator moving between each party to discuss proposals and counter proposals, gleaning information from each party but only sharing that which she had express consent to, and discussing potential reciprocal arrangements. The session concluded with all parties being present in the same space once more. An agreement for further, more detailed discussion

to take place in the following week was reached in principle.

#### WIDER SCOPE

It was fascinating to see that mediation involves much more than just the legal aspects of the case. Wider commercial aspects were brought into play, including the potential consequences of legal actions on the parties’ businesses and finances, as well as on mental and physical health.

While Busy Ltd potentially had the stronger case, it admitted to the mediator that it did not have the financial resources to take action. Therefore, for Busy Ltd, reaching an agreement was a necessity. Planned changes to its business also had an impact

*“ It was fascinating to see that mediation involves much more than just the legal aspects of the case*

upon its ability to compromise and dictated where it had to stand firm.

Mr Baker, while being aware that he possibly had greater financial resources but a weaker legal position, needed to fully secure the mark BUSY BAKER to enable him to enter a lucrative contract. His commercial needs had a major role to play in his decision-making and willingness to compromise.

With both parties of a mindset to achieve agreement, the mediator worked to explore common ground and attempted to bridge the gap between the expectations and needs of each party, thus enabling progress to be made and creating the foundations for a mutually

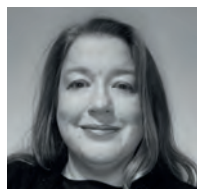
beneficial agreement. This left details to be worked out between the parties in the weeks following mediation, but these were much wider in scope than may have been suggested by the legal issues.

#### ATTORNEY ROLE

The role of the trade mark attorneys present was interesting. The mediator tended to address the parties themselves, but their trade mark attorneys were present to provide legal guidance or context in relation to any individual point or the bigger picture, and to suggest discretion or additional points which their client may otherwise have overlooked. The bulk of the discussion was, however, carried out by the parties themselves and not their representatives.

At the end of the session, June Ralph, an Assistant *Inter Partes* Hearing Officer at the UK IPO who acted as mediator for the scenario, did admit that the parties in this fictitious case were “much franker” than is usual. Even so, it is easy to see how mediation can draw additional information to the fore which may otherwise be overlooked but which could make a significant difference to the direction and outcome of a case.

As the session drew to a close, not only was there an end in sight for the litigation, reducing the stress and financial burdens on the parties, but each of the parties also had the potential to gain something that would significantly aid its business. I was left to draw the conclusion that the option of mediation should not be dependent upon the strength of a case. Instead, it can be a useful tool in any trade mark attorney’s repertoire. It is certainly an option I shall more readily take into consideration going forward. ●



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# BAD COMPANY?

Our authors consider the implications of 2021's key Sky v SkyKick decision, which has given renewed importance to applicants' intentions



On 26th July 2021, the Court of Appeal (CoA) issued another

keenly awaited decision in the long-running Sky v SkyKick trade mark dispute, overturning the High Court's April 2020 decision to narrow the scope of protection afforded by some of Sky's marks based on bad faith (due to overly broad specifications). Sky's successful appeal rested on the fact that the trade marks had in fact not been applied for in bad faith, and that the excision of certain goods and services from its marks was consequently unwarranted.


The CoA's decision in this instance marks the most recent chapter in a dispute that commenced in 2016 when the British media and telecommunications conglomerate Sky issued proceedings against SkyKick, a US-based provider of cloud-based management software.

To recap in summary, Sky argued that the use of the sign "SkyKick" for cloud-based management software infringed five of its UK and EU trade marks for SKY and claimed passing off on the part of SkyKick. SkyKick denied both claims and counterclaimed for invalidity of Sky's trade mark registrations, arguing that:

- a number of the alleged infringements related to goods and services that had no direct relevance to Sky's current core business;
- Sky's registrations for marks relating to certain goods and services, such as "computer software" and "data storage", lacked clarity and precision, and the applications were filed in bad faith; and
- Sky should consequently not have been granted registrations for these wide-ranging rights in the first instance.

In the High Court, Lord Justice Arnold referred various questions to the Court of Justice of the European Union (CJEU). The CJEU determined that, among

other things, an EU mark "cannot be declared wholly or partially invalid on the ground that terms used to designate the goods and services in respect of which that mark was registered lack clarity and precision". In other words, seeking to protect broad terms such as "computer software" would not lead to invalidity on the grounds of lack of precision or clarity. However, the CJEU suggested that if an applicant filed for a mark relating to certain goods and services without any intention to make use of the mark in these areas, this could constitute bad faith if there was "objective, relevant and consistent indicia" suggesting that, at the time of filing, the applicant had the "intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark".



“ *Lack of intention to use a mark in relation to certain goods and services does not, in and of itself, constitute bad faith* ”

Applying the CJEU’s June 2020 ruling, the High Court found that SkyKick had infringed Sky’s rights, but also found that the telecoms giant had acted in “bad faith” when it applied for certain goods and services with no apparent intention to use them. As a consequence, the High Court declared Sky’s EU marks partially invalid and instructed that the goods and services falling outside the scope of Sky’s core business be removed.

Both parties were given permission to appeal the Court’s decision: SkyKick against the finding of trade mark infringement and the extent to which the

Court reduced the scope of Sky’s registered protection; and Sky against the Court’s partial finding of bad faith. Sky ultimately won this appeal following the CoA’s decision on 26th July 2021.

The CoA found in favour of Sky and reversed the High Court’s decision that had rendered its EU marks partially invalid. The CoA highlighted the CJEU’s guidance that a lack of intention to use a mark in relation to certain goods and services does not, in and of itself, constitute bad faith. The CoA also determined that there is no requirement for owners of a mark to offer a commercial justification for using a mark with respect to every single good or service that might fall within a broader term in a specification.

#### **OBVIOUS JUSTIFICATION**

In the case of Sky – which the CoA recognised as having a significant present trade, and an ongoing expectation of trade, in, for example, “computer software” – the CoA deemed that the company was not acting in bad faith despite the broad

specifications of its marks because it had an “obvious commercial justification” for including terms such as “computer software” in its specifications: “An applicant for a trade mark does not have to formulate a commercial strategy for using the mark in relation to every species of goods or services falling within a general description. Such an applicant is entitled to say, ‘I am using the mark for specific goods falling within description X. I have no idea precisely where my business in goods of that description will develop in the next five years, but there will undoubtedly be more such goods than there are now.’”

The CoA did, however, acknowledge that this decision may not apply to cases where no intention whatsoever can be found for using marks with respect to certain terms within a specification, or where marks have been registered for the sole purpose of precluding competitors and other third parties from receiving protection. ▶

## IMPLICATIONS AND ISSUES

The key policy considerations underpinning this long-running case reflect the tension between allowing companies to file broadly and to wield a monopoly for five years and the impact these overly broad specifications have on new businesses who want to find room for their rights on the Register. The practice of over-claiming also makes it very difficult for the trade mark profession and brand owners generally to clear marks accurately.

We can probably all agree that there is too much trade mark “clutter” on the Register, but the difficulty lies in finding a balance between allowing companies to build some commercial expansion into their specification and having appropriate sanctions in place for those who abuse the system. But how to achieve this balance, and what should the sanction be for those who over-claim?

## NATURAL BOUNDARY

When we think of other IP rights, there is a natural boundary that arises around the right – around a patent’s inventive step, for example, or a new copyright created around the extent of a work’s originality. However, for trade marks, barring the absence of earlier rights, there is much more choice. The only boundaries arise from cost and interest. This freedom to self-define boundaries has established a “norm” whereby applicants will file more widely than needed. Because trade marks cannot be challenged for the first five years after registration, it means that applicants are free to monopolise any number of goods and services, regardless of whether they have any real intention to use them.

This freedom to file goods and services without restriction makes it very difficult to clear marks accurately. It also increases the cost of searching by requiring off-Register checks, particularly where marks are too young to be challenged for non-use.



*“ When the High Court’s decision was delivered and Sky’s marks were declared partially invalid on the basis of bad faith, trade mark owners and practitioners all took a sharp intake of breath*

Giving companies the right to monopolise any number of goods or services for five years gives them a huge advantage, particularly in opposition proceedings, and perhaps this advantage should be balanced by sanctions for trade mark owners who abuse the system by over-claiming. It is now the role of third parties to assume much of the burden, cost and risk of initiating a non-use cancellation action against a trade mark owner who may have over-claimed and monopolised more than their fair share of the Register.

In 2019, when the Advocate General (AG) delivered his opinion on the case, he also emphasised the policy considerations by indicating that specifications covering broad terms such as “computer software” were unjustified and contrary to the public interest because a single trade mark owner could not possibly have a commercial interest in providing all types

of computer software, because software is far too broad in terms of function and field of use.

As a result, the AG suggested that trade marks covering such broad terms (“computer software”, as well as “financial services” and “telecommunications”) may in certain circumstances lead to a finding of bad faith where there is no intention to use the mark in connection with those broad terms and where “the sole objective of the applicant is to prevent a third party from entering the market, including where there is evidence of an abusive filing strategy”. This certainly made practitioners sit up and think very carefully about the extent to which our clients’ trade mark registrations could be vulnerable to counterattacks. It also made us wonder whether this could lead to a possible policy change regarding specifications (could we see subclasses being introduced for class 9, or perhaps Declarations of Use?), or even simply a more subtle shift

instigated by the profession itself, which might choose to adopt a more US-style approach to drafting specifications.

When the High Court's decision was delivered and Sky's marks were declared partially invalid on the basis of bad faith and its specification was restricted to the goods and services with some connection to its established businesses, trade mark owners and practitioners all took a sharp intake of breath. This ruling effectively paved the way for defendants in trade mark infringement cases to attack an overly broad registration on the basis of bad faith. It also opened up the possibility of the courts adopting a "blue pencil" approach to specification interpretation.

The CoA ended up reversing the High Court's decision, stating that SkyKick was precluded from arguing that an entire category of Sky's goods or services could be declared invalid, because the bad faith related to only some of the goods or services that fell within it. Each category of goods and services had to be considered in its own right and in any event, a lack of intention to use was not, of itself, a ground for a finding of bad faith. The fact that Sky did not intend to use the marks "across the breadth of the category", was not the same as finding that Sky had no intention at all to use the marks for that category.

#### **IMPOSSIBLE BURDEN**

In addition, while the High Court concluded that Sky had applied for the marks pursuant to a deliberate strategy of seeking very broad protection, the CoA determined that an applicant does not have to formulate a commercial strategy for using the mark in relation to every type of good or service falling within a general description, because doing so would "create an increasingly impossible burden on applicants". This is of course true, but when an applicant fails to demarcate its own rights fairly and accurately at the outset, this

"burden" shifts entirely to a future counterparty to do, which can also be a very hefty task to undertake. According to the CoA, an applicant with only one item of computer software could apply in good faith for "computer software" as a whole. The absence of a clearly defined plan to use a mark for all goods falling within that specification could not, in itself, constitute bad faith. Trade mark owners and practitioners could breathe a sigh of relief.

However, now that questions have been raised over the validity of broad specifications and an applicant's genuine intention to use a mark, it does appear that there is some judicial sympathy towards smaller companies fending off trade mark disputes against claimants with very significant portfolios. EU case law also indicates a willingness to require that owners of trade

enforce their rights should take a close look at the registration before doing so, to make sure that they can provide some form of commercial rationale for the inclusion of some of the broader terms within their specification, because a failure to do so could result in a loss of at least the broader terms within the specification.

Nevertheless, we expect the urge to over-claim will still creep in, so the legal fog created by broad specifications will remain until the balance is redressed. But what does seem certain is that the SkyKick case has had a lasting impact on current trade mark practice. Gone are the days of going down the "kitchen sink" route with specifications covering "Christmas decorations" for no reason other than the fact that you can. Instead, responsible

*“ The CoA determined that an applicant does not have to formulate a commercial strategy for using the mark in relation to every type of good or service falling within a general description*

marks that may have been made in bad faith – such as where they contain unduly broad specifications or are repeat filings – bear some responsibility in explaining the commercial justification for their filing practices. It certainly looks as though anyone looking to

practitioners should now adopt a much more considered approach when drafting a specification, which benefits everyone – both existing trade mark owners who can still file relatively broadly without fear of a full cancellation, and those who are trying to clear marks to use and register. ●

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# WHEN COSTS COUNT



# Emily Roberts explains what it takes to make sure your IP enforcement strategy remains legally robust and commercially viable

**G**lobalisation and recent worldwide events have been the catalyst for significant changes in the IP infringement landscape, often making enforcement more complex, time-consuming and expensive. But how far should right holders go to protect their IP before the costs of enforcement outweigh the benefits of taking action?

## DEFINING CLEAR OBJECTIVES

As with all business decisions, defining clear objectives for any IP enforcement strategy is crucial. What are the business' primary concerns? Are they reputational, economic, or both? A "win" for one business is not necessarily a "win" for another. Commercial goals differ from one brand owner to the next depending on a number of factors including the size of the business, its unique selling point and brand values.

A critical first step in the cost-benefit analysis of enforcement action is determining when to take action. Even with a bottomless budget, it will rarely be possible to tackle every issue that arises. Relevant to this analysis are a range of legal and commercial considerations, including:

**1 Who is using the mark?** Is it a competitor operating in the same commercial space? Does that competitor have deep pockets and is it likely to be entrenched? If it is a small business or an individual,

depending on the size of your brand, are there likely to be PR consequences arising from any enforcement action you do decide to take? Knowing your opponent and adapting your strategy accordingly is crucial to defining a strategy that is both appropriate and proportionate.

**2 What IP is being used?** Is it a business "crown jewel" or a less significant company asset? How close is it to your own IP? Are there any known issues with enforcing that particular right, such as previous adverse decisions or proof of use requirements that might be difficult to satisfy? Taking a holistic approach to enforcement and weighing up the pros and cons of pursuing a particular matter can avoid an escalation of time and expense further down the line.

**3 In what way is the IP being used?** Is the use deliberate – for example, a parody? Does it relate to counterfeit goods? Is the use particularly damaging from a reputational perspective? Is there actual confusion? Are there safety concerns? Adapting your strategy to be commensurate with the likely impact of infringement ensures you are focusing your energy and resources on business-critical issues.

**4 Where is the IP being used?** Is it a key territory or a strategically significant one for the business? Is the issue purely online? If so, what can be done? Where there is infringement in multiple jurisdictions, the infringer's location, along with other considerations such as court timescales and cost recoverability in a particular location, can have a significant impact on the overall cost of enforcement. It is also important to think about whether the alleged infringer has rights elsewhere that might be a barrier to your own use.

Having considered these factors and defined some clear objectives, keep them under review. As technology progresses, so do infringers. The pandemic has seen an unprecedented move to e-commerce and internet-based infringement, for example.

A successful enforcement strategy should have the flexibility to adapt and respond to new types of threat.

## CARE FOR CORE ASSETS

Think carefully also about what it is that you are protecting. Are you expending unnecessary time and cost in maintaining rights that the business could afford to let lapse (for example, if never used or only used for a promotion)? Be selective in your clearance criteria and focus on those issues and territories that are likely to present the highest risk to the business.

Globalisation brings global issues, so it also pays to think outside the box in terms of the regions where you might seek to protect your IP. For example, think about where you are manufacturing the goods and what protection can be sought there. Countries such as China remain an issue for those producing their goods overseas. Also, consider whether protection should be sought in territories neighbouring any major jurisdictions where the brand may want to launch. Forward planning can prevent costly issues later on.

*“ Even with a bottomless budget, it will rarely be possible to tackle every issue that arises ”*

## ACTIVELY MONITOR

There is no doubt that litigation can be a drain on resources, but failing to police your IP can be costly and undermines the investment made in creating and maintaining those rights. Putting strategies in place to monitor potential infringements can really pay off. Opposing a trade mark at the UK IPO level (for example, when a mark is in its application stages and not yet in use) or challenging a new domain name or company name is far more effective than resorting to costly litigation months later when your opponent is established and entrenched. ▶



*“ If litigation seems an inevitability, it still pays to be selective in terms of form and forum*

#### TECHNOLOGICAL TOOLS

Of course, the rise of e-commerce and social media provides businesses with a unique ability to connect with their supply chains, as well as their customers, at the touch of a button. Use this to your advantage. For example, using social media channels to teach consumers to spot fake versions of a product can streamline enforcement and positively influence brand value. Want to keep your authentication processes closer to your chest? Producing manuals to share with your supply chains (and border enforcement) to educate and assist them in helping you fight infringement can also be an effective tool in fighting counterfeits.

Taking advantage of technological advances in the field of monitoring and enforcement (for example, using AI-enhanced solutions incorporating algorithms to detect counterfeits, infringements and other IP threats) can also be a cost-effective alternative to traditional methods of enforcement. These can be particularly useful in monitoring online infringements, where an oft-cited frustration among in-house IP practitioners and brand owners is the “whack-a-mole problem” (when it seems like you have stopped one form of

infringement or infringer, only to find another has emerged).

The use of AI and integrated technology such as blockchain to assist with the tracking and authentication of physical goods is also on the rise. For example, Nike’s widely publicised patenting of cryptographically secured digital assets for articles of footwear (so-called “CryptoKicks”) and Alibaba’s multiple filings for blockchain-related patents show that there is huge potential for technology to assist with supply chain and transaction management.

#### ASSESS APPROPRIATENESS

Once you have considered the factors above, the legal merits and your commercial drivers, it is worth pausing to think about whether taking action is appropriate. If it is, what kind of action? There are a number of viable, cost-effective alternatives to the traditional

cease and desist letter and court proceedings model which rights holders can consider. For example, picking up the phone or filing a simple notice of threatened opposition may bring your opponent to the table at the fraction of the cost of a formal opposition or threatened legal claim. Similarly, in appropriate circumstances, the Company Names Tribunal, domain name complaints (whether Nominet’s DRS or a UDRP complaint) and use of third-party online complaints procedures (such as Amazon’s or Facebook’s online reporting tools) can all be cost-effective alternatives to traditional litigation.

If litigation seems an inevitability, it still pays to be selective in terms of form and forum. There are several options to choose from according to the complexity of the dispute, each with different procedures and associated costs (as well as specific rules relating to recoverability). The High Court is no longer the default, and the IPEC or Shorter Trials Scheme can help to keep costs down in appropriate cases. Deciding on what action to pursue and how (for example, whether to pursue interim relief, adopt a split trial model or take summary action) will also have an impact on the overall time and expense.

Finally, working collaboratively within the business and with the right external team is invaluable in ensuring that matters are dealt with efficiently and effectively. ●



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A young boy with brown hair and freckles is looking up at a red apple balanced on a branch. An arrow with blue and red fletching is stuck through the apple. The background is a lush green forest with bokeh light effects.

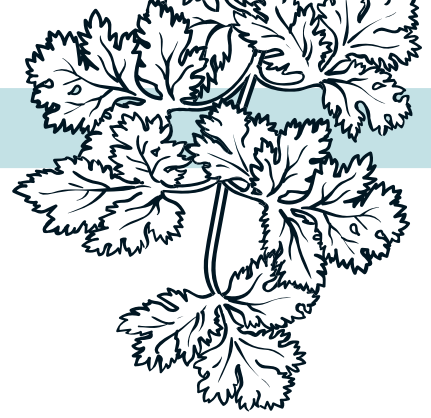
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# On the record

The case confirms the need to run a tight ship when it comes to evidence, writes Robert Milligan

**The UK IPO** has rejected an opposition by Harrogate Distillery Ltd, trading as Whittaker's Gin (the Opponent), against the Little Hare Gin Company Ltd's (the Applicant) UK trade mark application for a series of six figurative marks for LITTLE HARE GIN (as shown opposite) for "gin" goods in class 33 on the basis of a lack of relevant evidence to establish its claims.

The Opponent invoked sections 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act), relying on a UK trade mark registration (the Hare Mark) covering "gin" in class 33, and unregistered rights in the Hare Mark throughout the UK since 15th July 2015 in relation to "gin".

The Opponent had to prove a reputation and goodwill in the Hare Mark prior to 11th March 2020 (the Relevant Date).

## REPUTATION AND GOODWILL

The Opponent's evidence took the form of two witness statements in the name of a director of Tameseal Ltd, the company that had created the Hare Mark. It was not clear why this director was filing evidence instead of the Opponent itself. However, the Hearing Officer (HO) still took this evidence into consideration.

The witness statements were accompanied by 20 exhibits summarised as: a screenshot showing the use of the Hare Mark on a bottle of gin on Fortnum & Mason's website; screenshots of other gin goods produced by the Opponent that did not contain the Hare Mark; industry awards won by the Opponent for its gin products; the Opponent's directors' memberships of the Gin Guild in 2016 and the Worshipful Company of Distillers in

2020; a photograph of an open box containing two bottles of gin bearing the Hare Mark; and three photographs of the Opponent's distillery.

Although the evidence showed use of the Hare Mark on a bottle of gin listed for sale via Fortnum & Mason's retail website, such evidence was after the Relevant Date. Without evidence of sales, advertising spend or turnover figures for gin sold under the Hare Mark in the UK, the HO was unable to infer from the evidence that the Opponent had sold any bottles of gin bearing the Hare Mark prior to the Relevant Date.



“ Evidence of industry awards did not assist in proving reputation

The evidence filed by the Opponent of industry awards did not assist in proving reputation, as no evidence or explanation was provided as to the reach of the awards in the UK, their relevance to the UK public or whether they were decided upon by a panel of judges or members of the public.

The memberships of the Gin Guild and the Worshipful Company of Distillers had to be discounted, as well as the evidence showing use of the mark on other products and at the distillery, as these usages were not evidence of use of the Hare Mark on gin products per se.

While the HO accepted that the distillery was likely to produce gin products, they could not infer a reputation without evidence of how much gin was produced, how much was sold in the UK and how many UK consumers were likely to see the Hare Mark on the Opponent's gin products. As a result, the HO found that the Opponent had failed to prove a reputation in the Hare Mark prior to the Relevant Date, and the claim under s5(3) of the Act failed.

The evidence filed to support the Opponent's s5(4)(a) claim was the same as that filed in support of s5(3). Unsurprisingly, based on the evidential deficiencies set out above, the HO found that the Opponent had not established goodwill in the Hare Mark to maintain a claim of passing off. As a result, the claim under section 5(4)(a) failed and the opposition was rejected.

#### EVIDENTIAL FORMALITIES

As an aside, the HO went on to note that the Opponent had filed a number of submissions wherein it sought to explain and expand on the evidence filed. It also sought to introduce additional statements of fact, such as use of the Hare Mark on gin products displayed in the TV shows *The Apprentice* and *The Yorkshire Vet*. The Opponent also claimed to operate tours of its distillery for members of the public. However, neither statement was supported by the evidence, and as the submissions did not contain a statement of truth they could not be admitted into evidence. Had the Opponent addressed these additional statements in its witness statements or an additional witness statement, then the HO would have been able to consider these points in the overall assessment of reputation and goodwill.

This case illustrates the importance of brand owners maintaining good records of the use of their marks so that when



“ Brand owners should maintain good records of the use of their marks so that evidence can be readily collated

they do wish to enforce their rights, evidence can be readily collated.

It also serves as a timely reminder that evidence of a reputation and/or goodwill needs to show use of the mark relied on in relation to the goods and/or services claimed, alongside evidence of sales, market reach and advertising spend. The evidence also needs to be prior to the relevant date.

Finally, practitioners need to be careful in keeping submissions and statements of fact separate and should ensure that witnesses explain the relevance of why they are filing evidence in proceedings.

At the time of writing, the decision had not been appealed.

#### KEY POINTS

- ✦ Maintain good records of the use of marks so that evidence can be readily collated as needed
- ✦ Evidence of a reputation and/or goodwill must show use of the mark relied on in relation to the goods and/or services claimed, and must be prior to the relevant date
- ✦ Keep submissions and statements of fact separate and ensure that it is clear why witnesses are filing evidence

#### MARKS

THE APPLICANT'S FIGURATIVE MARKS



THE OPPONENT'S MARK



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# Head first

Laura Robyn explains why Skullcandy's arguments spoke loudest

**These cases concern** opposition and invalidity proceedings filed by Skullcandy, Inc., the American developer and manufacturer of audio products, against a trade mark application and registration for the HY-PHY PRO and HY-PHY PRO AAV AUDIO ALL ABOUT VALVES logos (shown opposite) in the name of Mr Kef Tesfaye. The contested marks cover headphones and related amplifiers and connectors, mobile phone covers and earphones in class 9, scooters in class 12 and several clothing and headgear items in class 25.

Relying on its earlier UK designations, Skullcandy claimed a likelihood of confusion exists with its skull logo (also opposite) for its portable media players, speakers, earphones and headphones in class 9, backpacks and handbags in class 18, and clothing and hats in class 25. It further claimed a reputation and substantial goodwill under the mark in respect of the class 9 goods.

## LIKELIHOOD OF CONFUSION

The HO found identity between the earphones, headphones and speakers in the contested marks and Skullcandy's protected goods. The amplifiers, adapters, consoles and cases for headphones were held to be similar to a low degree to Skullcandy's earphones and headphones in class 9. The remaining goods were found to be dissimilar. The average consumer for the goods at issue was determined to be a member of the general public paying a medium degree of attention. The purchasing act was held to be dictated primarily by visual considerations.

The HO agreed with Skullcandy's assertions that its skull logo mark had, through use, gained an enhanced degree of distinctiveness in respect of the protected goods. Turning to the comparison of the marks, the HO noted that the marks differed visually in all elements other than the inclusion of a facial aspect of a skull (albeit presented in reverse contrast). Conceptually, the marks shared the facial front skull message identically, with the HY-PHY PRO word elements likely to be understood as meaning "Professional-quality, high-fidelity headphones". Overall, the marks were found to be visually similar to a low to medium degree (HY-PHY PRO) or to a low degree (HY-PHY PRO AAV AUDIO ALL ABOUT VALVES) and conceptually similar to a medium degree. No aural comparison could be made.

Concluding that the enhanced distinctive skull element in this instance went beyond giving rise only to a mere association, the HO determined that there was indirect likelihood of confusion in respect of the identical and similar goods. The claims failed, however, in respect of the dissimilar goods.

## REPUTATION

Applying General Motors<sup>1</sup>, the HO recalled Skullcandy's use evidence and remarked that the reputation it enjoys under its skull logo mark "can be said to be a strong one". This was found to be a result of Skullcandy's long, continuous and significant presence in the UK, as well as its extensive promotional activity and generated brand awareness. Having already concluded that the contested marks would give rise to a likelihood of confusion

“ *The HO decided that the ‘reverse silhouette’ was an acceptable variant use* ”

## USE EVIDENCE

In relation to Skullcandy's evidence of use and reputation, the Hearing Officer (HO) remarked that:

- A significant proportion of the evidence showed use of the mark not in its registered form, but in "reverse silhouette" (ie, a white skull with black eye sockets); and,
- Various materials were undated, and the veracity of some of Skullcandy's financial figures, when queried by the holder of the contested marks, was called into question and scrutinised by the HO.

Notwithstanding these comments, the HO decided that the "reverse silhouette" was an acceptable variant use "which does nothing to affect the distinctive character" and that revenue, promotional expenditure and brand awareness were shown to be "quite substantial". The mark was found to have been put to genuine use in respect only of earphones and headphones in class 9.



## KEY POINTS

- ✦ A reverse silhouette version of a logo mark was found to be an acceptable variant capable of the registered form
- ✦ It is important to determine the creative origin and potential subsequent transfer of rights in logo marks, so that applications/registrations are not exposed to challenge on bad faith grounds
- ✦ Absent likelihood of confusion, a claim for passing off based on the same mark is likely to fall at the misrepresentation hurdle

## MARKS

### CONTESTED MARKS

Application



Registration



SKULLCANDY, INC  
EARLIER MARK



marks that he had created the contested marks using a third-party website, which retained ownership of the designs. In response to the bad faith allegations, the holder of the contested marks filed a further

statement clarifying that he had sought the necessary consent from the website owner to use the logo design. The HO, applying Red Bull<sup>2</sup>, decided that Skullcandy's claim had not been set out sufficiently in view of the seriousness of the allegation. The bad faith claim was rejected.

Finally, the opposition succeeded in its entirety, resulting in rejection of the application and invalidation of the registration. Although not ultimately material in this decision, this case again underlines the importance of determining the creative origin and potential subsequent transfer of rights in logo marks, as otherwise trade mark applications/registrations are open to challenge on bad faith grounds. In addition, where there is no likelihood of confusion, a claim for passing off based on the same trade mark is also likely to fall (to the same extent) at the misrepresentation hurdle.

and that Skullcandy's mark enjoys an enhanced degree of distinctive character, the HO felt that the requisite link would be made.

Noting its significant position in the UK headphone and earphone market, the HO found that use of the contested marks would take unfair advantage by riding on the coat-tails of Skullcandy's established brand. Further, it was held that use of the contested marks would cause damage given Skullcandy's reputation for quality products. The reputation claims succeeded in respect of all goods covered by the contested marks.

### PASSING OFF AND BAD FAITH

The HO confirmed that Skullcandy has a protectable goodwill in respect of earphones and headphones under its skull logo mark and that there would be misrepresentation from which damage flows. This was, however, only the case in respect of the identical and similar goods, as determined under the likelihood of confusion claims. The passing off claims therefore succeeded only in part, to the same extent as the likelihood of confusion claims.

During the procedural rounds, Skullcandy applied to introduce bad faith claims in both proceedings, which were admitted by the Tribunal. The additional grounds were based on a statement by the holder of the contested

1 C-375/97  
2 [2012] EWHC 1929 (Ch)



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# There can only be one boss

A distinctive verbal element showed its strength, reports David Birchall

In 2020, two joint Applicants applied to register a coloured drawing of the upper part of a long-haired woman wearing a strapped top, with the words “Self Made: Girl Boss” appearing on a curved line at the base (shown right) as a UK trade mark in classes 16 and 35. Ms Khadijah Ward (the Opponent) opposed the class 16 element of the application covering “motivational cards” under s5(2)(b) of the Trade Marks Act 1994. The opposition was based on an earlier UK trade mark registration of the depiction of the head of a woman in black and white, which incorporates the phrase “DarkGirlBoss” on the top left-hand side within what appears to be the woman’s hair. The Opponent based the opposition on the following goods covered by the earlier registration: activity books; Advent calendars; advertisement boards of card; advertising posters; advertising publications; announcement cards; agenda books; and anniversary cards.

Interestingly, the Opponent took advantage of the fast-track procedure available for UK trade mark oppositions based solely on claims of identity with similarity to earlier marks on the register (and not on unregistered rights or reputation). This procedure is rarely used; it was used for just 6.2% of all UK trade mark oppositions filed in 2019.

The Applicant defended the application by simply denying the basis of the opposition. Neither party requested leave to file evidence or make oral arguments, so the opposition was decided on the basis of the papers.

The Hearing Officer (HO) found the goods on which the opposition was based highly similar to the opposed “motivational cards”, that they would be sold through the same trade channels, and that the average consumer was

a member of the public buying a greeting card whose attention level is low to medium.

While finding that the eye was drawn to the words in both marks, the HO assessed the degree of similarity between the marks as follows: visual – lower than medium; aural – medium; conceptual – highly similar. The HO found both the shared phrase “Girl Boss” and the earlier mark in its entirety to be inherently distinctive to a medium degree.

The HO held that, because different words precede the phrase “Girl Boss” in both marks and because there are sufficient differences

between the pictures (eg, the contrasting features of the women), the marks would not be mistaken for each other. Thus, there was no likelihood of direct confusion.

However, the HO found the shared phrase “Girl Boss” to be striking for the goods concerned and held that the differing

additional words did not change the phrase’s meaning. On this basis, the average consumer would conclude that the marks indicate goods from the same or linked undertakings, with the differences indicative of a variation on a theme. Thus, indirect confusion was likely.

The fact that the shared phrase was inherently distinctive for the goods concerned carried the opposition, and this decision is a reminder of the strength of a distinctive verbal element, even in a challenge to a later mark with many other different features.

“  
The shared phrase  
‘Girl Boss’ was  
striking for the  
goods concerned

## KEY POINTS

✦ The overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components

✦ The average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind

✦ Indirect confusion occurs when the average consumer realises the marks are not the same but attributes similarity to the parties being the same or related

## MARKS

Opponent’s trade mark



Applicant’s trade mark



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# Mama mia! Here we go against

The sound of these marks had significance, says Amelia Skelding



**On 11th November 2020**, Societa' Vissana Industria Lavorazione Alimentare Srl (the Opponent) filed an opposition against all the goods and services of EU trade mark application No. 18137309 for MAMA PIZZA (see below), in the name of Mama Pizza und Hot Wok Franchise GmbH & Co. KG (the Applicant). The opposition was based on international trade mark registration No. 830031 designating the EU for MAMA MIA (see below). The Opponent invoked Article 8(1)(b) EUTMR.

The opposition was based on goods in class 30 ("Truffled, salted and sweet food products, pizzas, focaccias and deep-frozen products"). The contested goods and services were: class 30 ("Pizzas; fresh pizza; pasta; pasta dishes") and class 43 ("Food and drink catering; providing temporary accommodation; food preparation services; supplying of meals for immediate consumption; and serving food and drink for guests in restaurants"). The Opposition Division (OD) found the goods in class 30 to be identical or highly similar to the Opponent's "pizzas". However, the services listed in class 43 were found to be of low similarity, with the exception of "providing temporary accommodation", which was deemed to be dissimilar.

## ASSESSMENT

The expression "Mama Mia" was found to allude to good quality or consumer satisfaction, but would not, contrary to the Applicant's view, be perceived as a direct description of any characteristics of the relevant goods. Therefore, the degree of distinctiveness was considered average.

The stylisation of the marks was held to be merely decorative and therefore non-distinctive. As is typical with marks consisting of both verbal and figurative elements, the verbal component was held to have a stronger impact on the consumer than the figurative elements.

Visually, the marks share the term "Mama". They differ in the verbal element "Mia" of the earlier mark and "Pizza" of the contested sign. They also differ in the figurative elements, but this was held to have a lower impact. The OD noted that the coinciding element, "Mama" was at the beginning of both marks and that, as consumers read left to right, this part of the mark catches their attention the most. The signs were found to be visually similar to an average degree. The marks were found to be aurally similar to an above-average degree.

The OD held that the relevant consumer would recognise that "Mama" means "mother". The other concepts were found to have a limited impact on the conceptual perception of the signs. Therefore, the signs were found to be highly similar conceptually.

## REJECTED

The OD found there to be a likelihood of confusion, including association (for example, the later mark could be seen as a sub-brand of the "Mama" brand). The contested trade mark was rejected for all the goods and services found to be identical or similar, but not for those considered dissimilar. This case illustrates that even if the figurative elements of two marks are quite different, if there are strong verbal similarities the marks may well be considered similar, particularly when the coinciding terms are at the beginning of the mark.

## KEY POINTS

- + Even if the figurative elements of two marks are different, strong verbal similarities may result in the marks being considered similar
- + A shared element that is distinctive and at the beginning of both marks may mean they are considered similar, even if it is followed by dissimilar terms

## MARKS

EU APPLICATION  
NO. 18137309



INTERNATIONAL  
REGISTRATION  
NO. 830031



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# Weakness warning

Victoria Leach cautions against being economical with EU evidence post-Brexit

**Now that the** UK is no longer part of the EU, UK evidence of repute and use is no longer directly relevant in establishing repute or enhanced distinctive character within the EU. This case emphasises the challenges faced by brand owners with a UK-based reputation as a result.

## BACKGROUND

The Applicant, Editorial Ecoprensa S.A., filed EU trade mark (EUTM) application No. 18084541 for the figurative mark shown opposite. An opposition was filed by The Economist Newspaper Ltd based on Article 8(1)(b) and 8(5) EUTMR. The opposition was decided based on the Opponent's EUTM

registration No. 192096 for the figurative mark shown opposite.

First, the Opposition Division (OD) assessed the evidence filed by the Opponent in the proceedings to consider: (i) whether the earlier mark had been put to genuine use; and (ii) whether it had acquired a reputation/enhanced distinctiveness. UK evidence of use assisted the Opponent in establishing genuine use of the mark within the EU, as the relevant period for establishing genuine use coincided with the period prior to the end of the transition period when the UK withdrew from the EU. However, when it came to establishing reputation and enhanced distinctive character, UK evidence was not sufficient to establish the position in the EU, as the UK was not part of the EU at the time the decision was taken by the Office.

## LATE-FILED EVIDENCE

The Opponent substantiated its reputation via evidence filed on 18th May 2020. Following the Applicant's request for proof of use, the Opponent filed additional evidence on 3rd November 2020. After the expiry of the time limit, the Opponent then filed further evidence on 8th July 2021.

The Office weighed up using its discretionary power to take into account the evidence filed after the November deadline. In doing so, it considered the criteria laid out in the Fishbone decisions (T-415/09 and C-621/11 P). In particular, the Office found that relevant evidence was filed within the time limit initially set and therefore the later evidence can be considered supplementary. The Office also found it relevant that the Applicant disputed the initial evidence submitted by the Opponent, which justified additional evidence in reply. Further, the Office found that the additional evidence merely strengthened and clarified the evidence submitted initially, as opposed to introducing new elements of evidence. On this basis, the Office used its discretion to take into account the extra evidence submitted in July 2021.





“ *In almost all EU languages, the word for ‘economics’ derives from the same root, resulting in a reduced degree of distinctive character* ”



#### ASSESSMENT OF GENUINE USE

Next, the Office considered whether the Opponent’s evidence met the criteria for genuine use while assessing the place, time, extent and nature of use. It found that the evidence did establish genuine use but in relation to the following part of the goods and services only:

- Class 9: Audio and video recordings.
- Class 16: Books, magazines and printed publications.
- Class 41: Organisation of conferences and seminars.

#### OPPONENT’S REPUTATION

The Office then considered whether the evidence filed by the Opponent could establish that it enjoyed either acquired distinctive character in the earlier EUTM or a reputation in the EU.

Because the UK was no longer a part of the EU at the time of taking the decision, any evidence filed relating to this territory could not prove enhanced distinctiveness or reputation in the EU unless the findings could be extrapolated to the territory of the EU. This is different to the assessment of genuine use, where UK evidence could establish use in the EU provided it related to the period prior to the end of the Brexit transition period on 31st December 2020.

The Office found the extent of use by the Opponent was insufficient to establish reputation or enhanced distinctiveness in its mark in the EU, since most of the evidence submitted related to recognition of the earlier mark in the UK or worldwide.

#### LIKELIHOOD OF CONFUSION

The goods and services in the application were considered identical or similar to varying degrees of similarity and partly dissimilar to those in the Opponent’s earlier EUTM. Nevertheless, upon comparison of the marks, they were held to be visually and aurally similar to a low degree in view of the different figurative elements and aspects, as well as the different beginnings, endings and lengths. In this regard, the Office

considered that the meaning of “Economist” in English and “Economista” in Spanish would be understood within the EU as meaning something related to the economy.

In particular, the Office found that in almost all EU languages the word for “economics” derives from the same root. As such, the respective verbal elements “Economist” and “Economista” possess a reduced degree of distinctive character. On this basis, the marks were considered conceptually similar to a low degree.

Given the meaning of the word “Economist”, a likelihood of confusion analysis was considered, bearing in mind the lower than average degree of distinctiveness of the earlier mark since the Opponent could not establish enhanced distinctive character in the EU. In this context, it was found the average consumer would pay less attention to the coinciding string of letters “Economis\*” and would focus on other elements in the signs, such as the distinctive element “ST” in the Applicant’s mark. Accordingly, no likelihood of confusion was established and this ground of opposition was rejected. Since the Opponent had not established reputation in the EU, the opposition on the Article 8(5) ground was rejected.

#### DIFFICULT CASE

This was a difficult case for the Opponent. Without evidence of repute or enhanced distinctive character, the inherent weak nature of the verbal element “The Economist” weighed heavily against its case. Had the Opponent had been able to establish enhanced distinctive character of its mark within the EU, this may have been sufficient to establish a likelihood of confusion.

#### KEY POINTS

- \* UK evidence of repute and use is no longer directly relevant in establishing repute or enhanced distinctive character within the EU
- \* This may present an additional challenge for brand owners whose repute and use of an EU trade mark is concentrated in the UK

#### MARKS

APPLICANT’S MARK  
(EU APPLICATION  
NO. 18084541)



OPPONENT’S MARK  
(EU REGISTRATION  
NO. 192096)

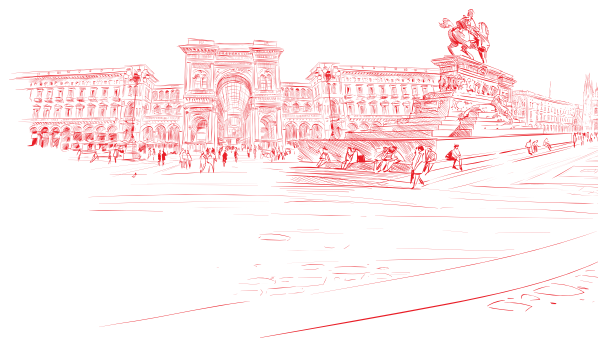


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# Pushing the boundaries



Francesco Simone explores a case that stretches an established principle

## KEY POINTS

It is established case law that the word elements of a trade mark tend to be more distinctive than its figurative elements, but this decision pushes the boundaries of that principle

The word element of a complex trade mark can be the dominant element even if it has a weak distinctive character, provided it is sufficiently prominent

The reputation of the applied-for mark is irrelevant in opposition proceedings, as it refers to facts and events that happened before the filing date of the application

## MARKS

INTERNATIONAL REGISTRATION NO. 1329545



THE OPPONENT'S BIRD'S HEAD MARK



On 31st December 2015, AC Milan (the Applicant) applied for an international registration (No. 1329545) for the trade mark shown below, designating the EU. The application covered a broad range of goods and services, including stationery in class 16.

On 6th April 2017, InterES Handels- und Dienstleistungs GmbH & Co. KG (the Opponent) filed an opposition against AC Milan's application, requesting its partial refusal in relation to stationery products. The opposition was based on likelihood of confusion with the Opponent's German trade mark registration No. 1122392, protecting the word mark MILAN.

The Opposition Division (OD) upheld the opposition, and the Applicant filed an appeal against the decision. The appeal was dismissed by the Board of Appeal (BoA) on 14th February 2020. The Applicant filed a further appeal before the General Court (GC).

## PROOF OF USE

The Opponent was called to submit evidence of use of its trade mark, but part of the evidence showed use of the word "Milan" along with the image of a bird's head (shown left). The Applicant argued that this part of the evidence should be disregarded as it does not refer to the earlier mark as registered, but to a different mark.

The GC dismissed the Applicant's argument, citing case law to the effect that the word elements of a complex mark are in principle more distinctive than its figurative elements, because consumers more easily refer to a product by quoting its name than by describing the figurative element of the mark.<sup>1</sup>

For the purposes of proving use, two different versions of a mark are considered equivalent when they differ in elements

that do not affect their distinctive character, which is a high threshold of similarity. It is another established principle that when the common element between two marks has a weak distinctive character, this can be more easily affected by the presence of additional, non-negligible elements.

The GC stated that additional figurative elements in the earlier mark as used on the market can be disregarded for the purpose of proving use, even if they are not negligible, provided they do not alter the distinctive character of the mark as registered. However, does this principle hold firm even when, as the Court found,

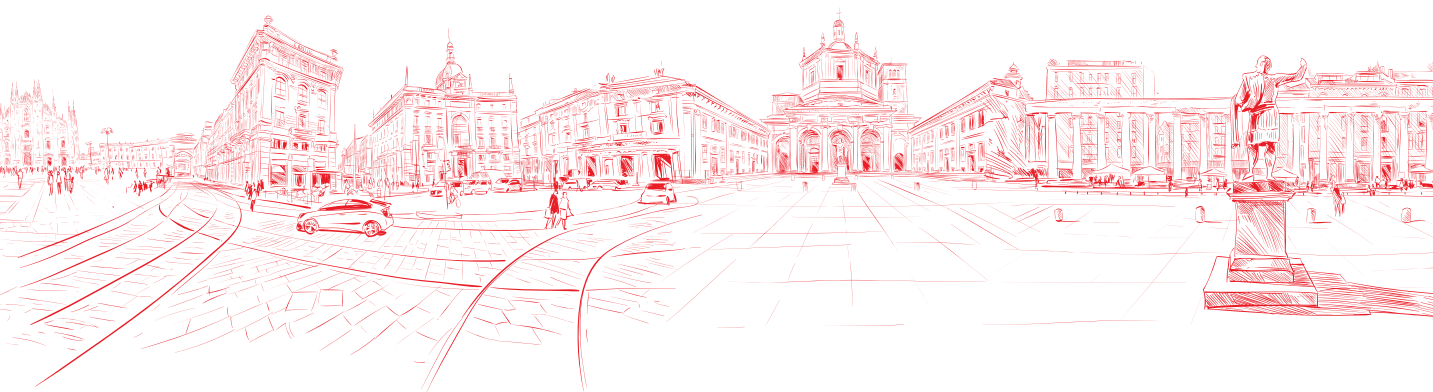
*“ There is still a question remaining as regards whether the Scorify test was correctly applied*

the word element has a weak distinctive character? The case law cited by the Court does not assist, as the word elements of the marks in question had a much higher degree of distinctiveness than "Milan". This could potentially be brought to the attention of the Court of Justice in a further appeal by the Applicant, but it may not be sufficient to change the outcome of the proceedings.

## LIKELIHOOD OF CONFUSION

In assessing the likelihood of confusion, the Court first examined the elements of the applied-for mark, to determine their level of distinctiveness and identify any dominant element.

The Court considered that the word "Milan" has three meanings: the city of



Milan, the first name Milan or a species of bird of prey. The Court agreed with the BoA that, insofar as “Milan” is perceived as a reference to the city, it has a weak distinctive character.

In its decision, the BoA stated that the figurative element of the applied-for mark “will be perceived by a large majority of the public primarily as a decorative element, and not as an element indicating the commercial origin of the goods”. Given that the logo in question is an ordinarily distinctive coat of arms, rather than a decorative image, the BoA’s view appears extraordinary, as it would make most logo marks on the market incapable of functioning as badges of origin and therefore undeserving of registration. This also appears inconsistent with the BoA’s own view that the logo is distinctive in relation to the goods concerned.

The GC, in turn, held that the logo is distinctive, but that it should nevertheless be disregarded when comparing the two trade marks, as the dominant element of the applied-for mark is the word “Milan”. The Court based this finding on two precedents: *Scorify v EUIPO*<sup>2</sup> and *Cotecnica v EUIPO*.<sup>3</sup> *Scorify* established that when the word element of a trade mark is substantially longer than the figurative element, it attracts the attention of the average consumer more, while *Cotecnica* established that an element of a complex mark with weak distinctive character can still be dominant when it is prominent in size and position.

There is, however, still a question remaining as regards whether the *Scorify* test was correctly applied, considering that the proportions and positions of the elements of the SCORIFY mark are much different than in the applied-for mark, where the logo and the word “Milan” are similar in size and neither is substantially

longer, and also considering their different alignment. Based on that assessment, the Court concluded that the trade marks are similar and therefore ruled in favour of the Opponent.

The Court also confirmed the established principle that the reputation of the applied-for mark is irrelevant in opposition proceedings, as the point in time when the applied-for mark is examined is the filing date of the application, while its reputation would bring into the proceedings facts and events that happened before that date.

In a further curious turn of events, the EUIPO was ordered to pay the travel expenses of AC Milan’s representatives, in relation to a request for a hearing that the EUIPO filed and then withdrew a week before the hearing was due to take place.

Overall, this decision pushes the boundaries of the principle that word elements tend to be more distinctive than figurative elements, giving more value to the word element even when this has a weak distinctive character and is only slightly bigger than its figurative counterpart. This is a potential basis for a further appeal, but considering the very limited scope of this opposition and the uncertain outcome, AC Milan will need to carefully consider whether the high costs of further proceedings are justified.

1 *Borrajo Canelo v OHIM – Tecnoazúcar* (PALMA MULATA), T-381/12  
2 T-328/19  
3 T-136/17



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# No shortcuts allowed



There is no one-size-fits-all approach to a likelihood of confusion analysis, says Désirée Fields

**The General Court (GC)** has upheld a decision of the Board of Appeal (BoA) finding a likelihood of confusion between the figurative mark “P.I.C. Co.” and the earlier stylised mark “PIK” in respect of all goods and services concerned, apart from “pasta shells; hushpuppies [breads]” in class 30.

## BEHIND THE DECISION

In May 2016, PIK-KO AD filed an EU trade mark application for the figurative mark shown opposite (the Contested Mark) for food products in class 30 (including confectionary, pasta shells, hushpuppies, foods made from cereals and grains, and ice cream) and retail and wholesale services related thereto in class 35.

“ *With short signs, there still has to be a case-by-case assessment to rule out any similarities* ”

The Contested Mark achieved registration in May 2018. In June 2018, Haribo Ricqles Zan filed an application for a declaration that the Contested Mark was invalid in respect of all the goods and services for which it was registered based on its earlier French trade mark registration for a figurative mark (shown opposite) registered for “confectionary” in class 30 and “retailing, wholesaling and sale via mail order of confectionary” in class 35 under Article 53(1)(a) of Regulation No. 207/2009 (now Article 60(1)(a) of Regulation No. 2017/1001) read in conjunction with Article 8(1)(b) EUTMR.

The EUIPO’s Cancellation Division (CD) upheld the invalidity application and declared the Contested Mark invalid in its entirety. The Fifth Board of Appeal

partially upheld PIK-KO AD’s appeal, confirming the CD’s decision that all the goods and services were identical or similar, with the exception of “pasta shells; hushpuppies [breads]” in class 30. PIK-KO AD applied to the GC to annul the BoA’s decision.

## CAREFUL COMPARISON

The GC confirmed that the relevant territory for the likelihood of confusion analysis in this case was France and that, depending on the goods and services concerned, the level of attention of the relevant public, consisting of the general public and professionals, varied from average to higher than average.

Taking all the relevant factors relating to the goods and services into account, including their nature, intended purpose, method of use, distribution channel and whether they were in competition with each other or complementary, the GC agreed with the BoA’s assessment as regards identity and similarity.

As regards the comparison of the signs, the GC noted that in a composite mark word elements are generally perceived as being more distinctive than figurative elements. This is because the average consumer more easily refers to the goods or services by citing the name of the mark than by describing its figurative elements.

The GC observed that the respective signs shared the same initial capital letters “P” and “I”, even though the letter “I” was represented differently and appeared as an inverted “I” in the earlier mark. The signs were visually similar. In particular, the elements of similarity were present in the initial parts which would attract consumer attention more than the following parts insofar as the relevant public would pay far more attention to the element “P.I.C.”

in the Contested Mark than to the rest of the elements. However, the level of visual similarity was low due to the differences in the graphic representation of the marks (ie, the second word element “Co.” in the Contested Mark and that mark’s non-distinctive, figurative and purely decorative elements).

Phonetically, the GC found that it was unlikely and artificial to assume that the relevant public would pronounce each letter of the “P.I.C.” element separately. In reality, consumers would most likely pronounce it as the word “Pic” in French. A situation in which letters were separated by full stops was in no way comparable to one in which letters were separated by an ampersand (such as in the case of M&M’s or H&M) and which was pronounced as “and”. Accordingly, the GC concluded that the earlier mark and the “P.I.C.” element of the Contested Mark would be pronounced identically by a significant part of the relevant public. The “Co.” element, which was clearly removed from “P.I.C.”, had no distinctive character and would attract only a low level of attention from the relevant public. Therefore, it could not be excluded that it would not be pronounced.

Conceptually, the GC noted that the Earlier Mark did not convey any meaning.



Similarly, while the “P.I.C.” element in the Contested Mark resembled the French word meaning “peak”, it was unlikely that it conveyed that meaning. The only conceptual difference between the signs was confined to “company”, which was intrinsic to the secondary and non-distinctive “Co.” element of the Contested Mark. Accordingly, the respective marks were conceptually different since the Contested Mark was capable of having a meaning for part of the relevant public, whereas the Earlier Mark had none.

#### A GLOBAL ASSESSMENT

The GC noted that the likelihood of confusion had to be assessed globally with regard to all the relevant factors. Where the signs concerned were three-letter signs, the difference of one letter was not necessarily sufficient to exclude similarity, in particular where that letter was phonetically similar.

The GC further remarked that there was no general rule relating to the treatment of three-letter signs that could be inferred from the case law. Acknowledging that it was true that, when faced with short signs, the relevant public was more likely to perceive what differentiated them, there still had to be a case-by-case assessment to rule out any similarities between the signs.

Having regard to the visual and phonetic similarity of the respective signs, the normal degree of distinctiveness of the respective signs and the higher-than-average level of attention of the relevant public, the GC upheld the BoA’s finding of likelihood of confusion.

#### COMPLEX AREA

Carrying out a likelihood of confusion analysis involves a multifactorial assessment where several variables need to be carefully considered. While reference to previous case law can be of assistance, as the GC noted here by reference to case law involving two- or three-letter marks, a one-size-fits-all approach cannot be applied in this complex area; it requires a considered and nuanced approach.

#### KEY POINTS

- ✦ A likelihood of confusion analysis involves a nuanced and considered approach taking into account all the relevant factors
- ✦ Even in the case of short signs where the relevant public is more likely to perceive minor differences, a careful case-by-case assessment is required

#### MARKS

THE CONTESTED MARK



THE EARLIER MARK



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# It's all about energy

A flavourful addition didn't add up for the Court, writes Felicity Hide

**This joined case** relates to the decisions of the Second Board of Appeal of the EUIPO, relating to two revocation proceedings between Frito-Lay Trading Company (Frito) and Monster Energy Co. (Monster).

The earliest application in these proceedings was filed by Monster on 3rd November 2010 for the word mark MONSTER, covering class 30, "Coffee-based beverages and coffee-based beverages containing milk", and class 32, "non-alcoholic beverages", namely energy drinks and energy drinks flavoured with coffee, all enhanced with vitamins, minerals, nutrients, amino acids and/or herbs. The second application was filed on 5th November 2010 for the word mark MONSTER ENERGY in class 30 only.

On 25th April 2017, Frito filed for the revocation of these marks on the grounds that they had not been put to genuine use within a continuous period of five years. Monster submitted evidence of use of those marks. However, the Cancellation Division (CD) revoked both contested marks for most of the goods, finding that use had been proved only in connection with class 32.

Monster subsequently filed two notices of appeal with the EUIPO under Articles 66 to 71 Regulation 2017/1001, which were dismissed by the Second Board of Appeal (BoA) on the ground that Monster had not proved use during the relevant period for anything other than energy drinks.

The drinks in question were Monster's "X-Presso Monster Hammer" and "X-presso Monster Midnite", and on photographs of those drinks, the wording "espresso

coffee drink with milk" appeared. The BoA therefore found it necessary to distinguish between "coffee-based beverages" in class 30, whether or not they contained milk, on the one hand, and "energy drinks" in class 32 on the other.

The BoA stated that the *Encyclopaedia Britannica* defined an "energy drink" as: "Any beverage that contains high levels of stimulant ingredient, usually caffeine, as well as sugar and often supplements, such as vitamins or carnitine, and that is promoted as a product capable of enhancing mental alertness and physical performance. Energy drinks are distinguished from sports drinks, which are used to replace water and electrolytes during or after physical activity, and from coffee and tea, which are brewed, contain fewer ingredients, and may be decaffeinated. Energy drinks also differ from soft drinks, which either do not contain caffeine or contain relatively small amounts of caffeine..."

The "X-Presso Monster" goods contained L-carnitine, B vitamins, ginseng and taurine; ingredients which, according to the BoA, were not commonly used in "coffee-based beverages containing milk", but which are often found in energy drinks.

The fact that the "X-Presso Monster" goods contained 1.3% coffee extract was not convincing, as Monster had not explained whether those goods were brewed or not. Further, the view was taken that although those goods might be coffee-flavoured, they also contained a broad range of ingredients not commonly found in "coffee-based beverages" and that the label on those goods clearly indicated that they had a "high caffeine intake".

The BoA concluded that the "X-Presso Monster" goods were, even if coffee-flavoured, essentially energy drinks.

“ The BoA found it necessary to distinguish between ‘coffee-based beverages’ in class 30 and ‘energy drinks’ in class 32

E

F



“ The GC referred to *Alpha Calcit v EUIPO*, which sets out the principle that a finished product is defined by its function

Monster sought to annul the contested decisions to the extent that they revoked the contested marks. The EUIPO and Frito sought to dismiss the action and to order Monster to pay the costs.

#### TRIPARTITE PLEA

Monster relied on the following plea in law in three parts:

(i) The BoA failed to have regard to the “principle that a product can be correctly classified, and therefore put to genuine use, in more than one class, in view of its composite nature”;

(ii) The BoA erred when it found that use had not been proved in connection with the goods concerned because those goods shared certain characteristics with energy drinks in class 32, and gave undue weight and significance to those characteristics;

(iii) The BoA erred in taking the manufacturing process of the goods into account for the purposes of its assessment.

In relation to the first part of the plea, the GC referred to *Alpha Calcit v EUIPO* –

*Materis Paints Italia (CALCILITE)*<sup>1</sup>, which was considered by the BoA in its decision. This sets out the principle that a finished product is defined by its function or purpose, whereas this specific situation was that of “a multi-purpose composite object”, which might be capable of being classified in a number of classes because of its various functions or intended purposes.

The GC held that the BoA had correctly found that it was necessary to refer to the general principle rather than to the specific situation relating to “multi-purpose composite objects”. In accordance with that principle, it was held that the BoA correctly found that the real function or purpose of the “X-Presso Monster” goods was to serve as energy drinks in class 32, albeit coffee-flavoured ones including milk.

The Court further held that Monster could not usefully claim that the “X-Presso Monster” goods are “multi-purpose composite objects”, saying:

“Multi-purpose composite objects are goods which are sold as a whole, but in which each of the components has an independent and distinct market value and could be marketed without the other specific component which is sold with it. By contrast, [Monster’s] canned beverages constitute an inseparable homogeneous product which fulfils one main function, namely that of being essentially a stimulating

#### KEY POINTS

+ Goods are defined according to their function and purpose when it comes to assessing genuine use

+ It may be possible for goods to fall into more than one class if they have components which each have an independent and distinct market value

+ In Monster’s case, the defined purpose of the goods led to classification solely as an energy drink, with its flavour being considered a characteristic that did not define its function

energy drink, in the present case one of which is flavoured with coffee.”

A coffee beverage is, unsurprisingly, characterised by the presence of coffee, whereas an energy drink has a number of ingredients, with the coffee flavour having a secondary role. Monster’s case was not helped by its own evidence, which stressed the “energy” function of the drinks.

With regard to the second plea, Monster argued that if it were the case that its “X-Presso Monster” goods cannot fall within more than one class, the BoA had attributed undue weight and significance to the characteristics associated with energy drinks in class 32 and had taken insufficient account of the characteristics which indicate that those goods are class 30 coffee-based beverages.

The GC found the BoA to be correct in that the real function or purpose of those goods was to serve as “energy drinks, albeit coffee-flavoured variants thereof including milk”. What’s more, the BoA had correctly pointed out that the “X-Presso Monster” goods contained ingredients commonly found in energy drinks but which weren’t normally found in coffee-based beverages. Consequently, the second plea was also rejected.

In relation to the third plea, the GC found that the BoA had correctly carried out the global assessment of whether the use of the contested marks was genuine and had also correctly found that the function and purpose of the “X-Presso Monster” goods met the definition of an energy drink. This meant that genuine use for the coffee-based goods had not been proven. Consequently, the GC also rejected the last plea, and the action was dismissed in its entirety.

### FUNCTION AND PURPOSE

The case law says that goods are defined according to their function and purpose when it comes to assessing genuine use. We are also told that goods may fall into more than one Nice class if they have components that each have an independent and distinct market value.

However, in this case, it appeared that the Monster drinks did contain coffee as well as other ingredients and may well have fulfilled more than one purpose. It is easy to have some sympathy with Monster’s position on this.

Monster pleaded the CALCILITE case on “multi-purpose composite objects”. However, the Court clarified that in order to be considered as such, each component of the item must have an independent and distinct market value and be capable of being marketed without the other specific component sold with it. No examples of this are given, which leaves us to speculate. For example, would a power tool sold with detachable battery and accessories be considered a multi-purpose product?

“ *Monster argued that the BoA attributed undue weight to the characteristics associated with energy drinks in class 32* ”

In Monster’s case, the Court defined the goods as “an inseparable homogeneous product which fulfils one main function”. There may be two messages to glean from this. First, if the product is “homogeneous” and cannot be separated into parts, it is harder for it to claim more than one function. Second, a test of the “main function” led to the coffee flavour being discounted as simply a characteristic. Although the Monster drinks may have had more than one characteristic, the test is the “main function”.

It is easy to assert a general principle of “register your mark for the goods you actually use the mark upon”. However, it seems that the “main function” of a homogeneous product is still open to interpretation. As a result, it would seem prudent to register for all the functions of the product, in case a court should disagree as to which one is the “main” one.

1 T-742/14



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We are already looking forward to gathering with members at our Spring Conference in March. More details soon at [citma.org.uk](http://citma.org.uk)

# Calendar

Our upcoming events for members and other IP events of interest

DATE	EVENT	LOCATION	CPD HOURS
1st March	CITMA Webinar Anti-ambush marketing	Online	1
8th March	CITMA Webinar International Women's Day	Online	1
11th March	CITMA Webinar National Careers Week: Becoming a Chartered Trade Mark Attorney	Online	1
16th – 17th March	Spring Conference*	IET London: Savoy Place, London WC2	5
22nd March	CITMA Webinar Unfair competition in Europe	Online	1
21st April	CITMA Webinar Copyright	Online	1
26th April	CITMA Charity Quiz Night	Salsal Temple, London WC2	
26th April	IP Inclusive 2022 Annual Meeting	Online	
25th May	CITMA Webinar Introduction to US design law	Online	1

■ CITMA event ■ IP Inclusive event

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## YOUR INPUT IS WELCOME

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

# THE TRADE MARK 20

Q&A



## Nicki Alvey

is not afraid to ask

**I am a...** voluntary lay Trustee of CITMA's Benevolent Fund.

**Before this role, I...** worked for a number of membership institutes as an executive director. I am now semi-retired and a magistrate in north Essex.

**My current state of mind is...** even more focused on how life can change in an instant. Having lost a young step-daughter in a rail accident in 2005 and now with this pandemic, it has never been more true that we should appreciate what we have rather than what we don't.

**I became interested in CITMA's Benevolent Fund when...** I attended a networking event for membership organisations in 2015 and heard that the fund was seeking a new Trustee.

**I am most inspired by...** people who seem to be able to give equal commitment and enthusiasm to their personal life and their career, while also finding time to look after others.

**My favourite place to visit on business was...** Rio de Janeiro. The stunning natural scenery, landmarks and beaches, together with the warmth of the local people, makes Rio unforgettable.

**In my role, I most enjoy...** being part of giving support to CITMA members in times of hardship and struggle.



“

*It has never been more true that we should appreciate what we have*

**In my role, I most dislike...** not having more funds to distribute. While CITMA is generous – as are some firms and individuals – the Benevolent Fund would always welcome more private donations. As they say, “every little helps”.

**On my desk are...** piles of different projects all on the go at once.

**My favourite mug is...** a Snoopy mug.

**In my pocket is...** a crumpled-up list of things I need to do.

**If I were a trade mark/brand, I would be...** the Big Lottery Fund, because it has a lot of money to distribute to good causes.

**The biggest challenge for CITMA's Benevolent Fund is...** growing the fund so that it can help more members. If you or your firm are able to consider a one-off or regular donation, it might help a colleague in the future or be there for you should you need it.

**The talent I wish I had is...** to be able to sing well, and not just “hold a note”.

**I can't live without...** my 14-year-old step-cat Phoebe, who is part Siamese and thinks she's a dog!

**My ideal day would include...** more than an hour of guilt-free “me time” (with Phoebe on my lap, of course).

**The best piece of advice I've been given is...** “if you don't ask, you won't get”.

**When I want to relax I...** go for a four-mile walk while catching up on my favourite radio programmes.

**In the next five years I hope to...** have completed 25 years as a magistrate and have my projects under control.

**The best thing about being involved with CITMA is...** making a positive contribution to the organisation and its members.

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A large, stylized graphic of the letters 'IP' in a serif font, centered within a white circular shape. The background is a light blue-grey gradient. The 'I' and 'P' are white, and the circular shape is also white, creating a high-contrast logo.

IP

Our current vacancies include:

Senior Associate - London/Remote  
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Trade Mark Records Clerk - Fully Remote  
Trade Mark Team Supervisor - London/Remote  
Trainee Trade Mark Attorney - London

# Your search ends here.

## **IP MANAGING ASSOCIATE - LONDON TRADE MARKS**

This leading international law firm are looking for someone who has a strong drive to succeed and develop within the firm, as well as working effectively as part of a unique team. Do not hesitate to get in contact to find out more about this amazing opportunity...

## **TRADE MARK ATTORNEY SHEFFIELD**

A well respected firm based in Sheffield is seeking a qualified trade mark attorney to join their thriving practice, to assist with the impressive and exciting range of work handled by the trade marks team. A competitive salary and benefits package are on offer.

## **NEWLY QUALIFIED/FQ - LONDON TRADE MARK ATTORNEY**

You will have exposure to a range of clients with a high variety of work, therefore excellent communication skills are a must. Rest assured, your hard work and dedication will be rewarded with an excellent salary and benefits package.

## **PARTNER/HEAD OF TRADE MARKS LONDON**

We are pleased to be working with a reputable law firm on a brand-new venture to create a trade mark department. You will be heading up the department and bring in fresh ideas on how to grow the trade mark attorney practice and be part of an exciting new project.

## **TRADE MARK FORMALITIES ADMINISTRATOR - LONDON**

This top IP firm is looking for an individual to complete their bustling team. The role is currently being offered on an initial 6-12-month FTC with a view to go permanent, along with a home/office working arrangement. You must have a minimum of 1 years' experience.

## **TRADE MARK PA - C£42,000++ LONDON**

This is an unmissable chance to work in this beautiful city, in stunning offices, joining a friendly team and firm who genuinely care for their employees. The role is a perfect opportunity to work on a larger scale and gain exposure to all thing's trade marks.

## **SENIOR TRADE MARK COORDINATOR (C£47,000++) - LONDON**

We are working with a firm who are offering a part office/part home working arrangement. The motivated individual must have at least 4 years' experience and working knowledge of using WebTMS and know how to file Trade mark applications (both UK and EU).

## **TRADE MARK PARALEGAL - GLASGOW CITMA QUALIFIED**

The successful candidate will have a minimum of 2 years' experience in the Trade Mark field. If you feel like you fit the bill, please get in touch today. An enticing starting salary along with endless room for progression – this role won't be round for long!

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