

CITMA REVIEW

ISSUE 454 DECEMBER 2019/JANUARY 2020



OUR MINDS MATTER

*Discover
our industry's
latest thoughts
on mental health.*

+

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IP

IP Support would like to wish our clients and candidates
a wonderful festive break and
a Happy New Year!

WELCOME & CONTENTS



Tania Clark
CITMA President

“
Speakers are flying in from all over the globe to share their knowledge

As you receive this issue, the festive season is nearly upon us and I hope I have spoken with many of you at our Christmas lunches in London and Leeds.

In this edition, we continue to recognise the importance of IP diversity and our wellbeing: CITMA Council member Triona Desmond shares some recent insight on mental health issues on page 12. We also offer a summary of the excellent talks and round-table discussions that took place at our Autumn Conference on page 8.

Finally, be sure to book early for our Spring Conference in March. Speakers are flying in from all over the globe to share their knowledge and to network with you.

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Council to tour in 2020

As noted in Keven Bader’s bulletin in October, the CITMA Council will be meeting with members across the UK during the first half of the new year to get member feedback on the organisation’s priorities for 2021-24. We look forward to engaging with you and will be posting information on how you can get involved at citma.org.uk

SHARP PRACTICES: BE ON GUARD

Stern Young & Partners (SY&P) continues to send, in significant quantities, renewal notices directly to registered rights holders. We continue to have conversations with the UK IPO about this particular sharp practice. Please remain vigilant and regularly remind your clients to contact you regarding any correspondence they may receive about their IP before taking any action.

CITMA ON THE WORLD STAGE

Members of our WIPO Liaison Working Group attended the WIPO Working Group on the Legal Development of the Madrid System for the International Registration of Marks held at WIPO in Geneva in July.

Oscar Benito, Daniel Hardman-Smart and Chris McLeod represented CITMA over the course of the four-day meeting, which is attended by representatives of the trade mark offices of most countries/territories.

IP bodies such as ECTA, MARQUES and INTA are also represented at the meeting, so it is useful for us to have a place at the table, particularly as you and your clients are likely to use WIPO more intensively in the future, depending on the outcome

of Brexit. The working group members were also able to spend time with the representatives of the UK IPO who were at the meeting, which is always instructive and convivial.

In September 2019, Jan Walter, WIPO IP Attaché in Geneva, worked closely with us to arrange a session with the WIPO Director General, Dr Francis Gurry, to promote UK priorities for the global trade mark system. The visit also included a dedicated presentation on WIPO’s AI-assisted trade mark search engine. Find out more about the IPO Attaché function on page 18.

If you are interested in WIPO and a regular user, the CITMA WIPO Liaison Working Group is seeking additional members. Please contact the CITMA office to express an interest.



L-R: Jeff Lloyd (UK IPO) and Chris McLeod (Elkington + Fife) were two of those representing CITMA in July

GET SET FOR OUR SPRING CONFERENCE

Plans are rapidly coming together for the CITMA Spring Conference 2020 on 19th-20th March at IET London: Savoy Place, which will focus on the topic of "Beyond trade marks: a global perspective". Booking opens soon at citma.org.uk

SCENES FROM THE SUMMER

CIPA CITMA Cricket Club captain Andy Spurr provides a welcome reminder of warmer times

On the hottest late August bank holiday weekend in living memory, a touring side from the EUIPO (modestly named "The Intellectuals") visited London for a reverse fixture of CIPA CITMA Cricket Club's 2017 tour. By tradition, we allowed the visitors to bat first and their openers went out to cheers from CIPA and CITMA family and friends.

It was hard work in the field: a short boundary and fast outfield meant regular jogs down the hill to collect balls. As captain I regularly switched the bowlers to try to get a breakthrough, ending up using nine bowlers with varying levels of success. Eventually, we thought we had our first wicket – their captain reached a century but unfortunately (but quite rightly) refused the shouts of the crowd to retire.

In retrospect, it might have been better to have not taken any wickets at all as their number three came in on the back of scoring 184* the day before. All attempts to keep him off strike were futile until the final over when the author clean bowled two in two balls. The field was set for the hat-trick ball, three slips, two gullies and everyone else close in catching. I then bowled it

wide towards the slip cordon and they managed a run to the keeper to return the star batsman to strike.

A target of 233 was set to chase down in 35 overs, which seemed to be about par given the short boundaries and fast outfield. Justin Wilson and Jon Bailey strode out confidently and played with patience and restraint, before Justin was casually stumped. Deepak Winston was also deceived by the pace and was already through his shot by the time the ball hit his front pad and trickled onto the stumps.

This brought on our more "variable" batsmen and, fortunately, the bat found the ball quite frequently, which invariably brought a boundary. Ultimately, Adam Darling played a chanceless innings to bring the contest home with a few overs to spare.

The club is looking for new members. Please contact Andy Spurr at cipaitmacc@gmail.com if you are interested. The next match is nets at Lord's on 28th January 2020.



CIPA CITMA Cricket Club played a touring side from EUIPO last August



MEMBER MOVES

→ VISIT THE CITMA JOBS BOARD: CITMA.ORG.UK/JOBS



Clare Jackman has joined Ashfords as a Partner in its intellectual property team. Contact her at c.jackman@ashfords.co.uk



Dominic Murphy has joined Shoosmiths as a Partner. Contact him at dominic.murphy@shoosmiths.co.uk



Pollyanna Savva has joined Mewburn Ellis as a Part-Qualified Trade Mark Attorney. Contact her at pollyanna.savva@mewburn.com



Charlotte Wilding has joined Kemp Little LLP as Of Counsel, Head of Trade Marks. Contact her at charlotte.wilding@kemplittle.com

IT UPGRADE IS FIRST OF MANY

Lord Smith outlines the ways that IPReg is upping its game

When I knew that we were about to embark on a wholesale replacement and renewal of our customer relationship management (CRM) system at IPReg, I have to confess that I quailed a little. I have seen many disasters come from attempts to change and upgrade IT systems, from the health service to British Airways. I've seen some successes too. The answer has to lie, of course, in not rushing it and in making sure that the client brief is very clearly developed and spelt out from the outset.

We did precisely this at IPReg. We were hampered by the very poor quality of the data systems that had previously been put in place. (We were still having to do manual operations every year for the renewal of practising fees, for example.) However, we were helped by having some very good advisers who held our hand through the entire operation and made sure our technical contractor was kept up to the mark. And we were very clear that the top priority was having in place a system that worked for all our registered Patent and Trade Mark Attorneys.

We have now gone live with the new system, and I fervently hope – all fingers firmly crossed here – that it will live up to the expectations we have of it. We hope that it will save us many expensive hours of manual inputting. That it will enable attorneys to see at a glance

what their own position is. That it will make the whole annual renewal process much speedier and more efficient, and with much less hassle attached.

There will of course be teething problems along the way – there

will, I hope, save some money and make us more efficient and will help us to provide a better service.

This has been the first of three major priorities for IPReg at the present time. The second is to arrange for an office move, as our current lease comes to an end very shortly, and we hope that this relocation will happen just before Christmas. The third is to begin the major process of reviewing and reforming and bringing coherence to the whole range of rules and regulatory procedures that we have in place. At present we have too many inconsistencies, overlaps and ambiguities – and we do want to sort all of these out.

It will be a detailed and laborious task and will need to be done in full consultation with attorneys, and particularly with CITMA and CIPA, throughout. But I'm determined that we will emerge at the end of the whole process as an effective, efficient, fit-for-purpose regulator that the whole IP sector can be proud of. Let's hope our new CRM system is the first step towards that goal!

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*I'm determined
that we will emerge
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purpose regulator
that the whole
IP sector can
be proud of*

always are – but I very much hope that the careful way in which our team has gone about doing it will deliver the results we hope for. It



The Rt Hon the Lord Smith of Finsbury

Chair of IPReg

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ALL EYES ON CHANGE

Amy Salter walks us through a day of talks that took a view on working through dynamic times

In October, the International Conference Centre in Birmingham once again played host to CITMA's Autumn Conference. This year's theme was "Seizing opportunities in a time of change", and the key focus of the day was the importance of good evidence. The event once again saw hundreds of CITMA members assemble to discuss a range of topical issues, meet new colleagues and network with old friends.



THE BUSINESS CASE FOR DIVERSITY

"If you want the best people, you need to widen the net." That was the message from Susi Fish (Boult Wade Tennant) and Kate Swaine (Gowling WLG), who gave a compelling assessment of the benefits of actively promoting diversity within IP firms. Strikingly, the statistics showed that firms in the top quartile for gender diversity and ethnic diversity were respectively 21 per cent and 33 per cent more likely to financially outperform the national average. Further, the statistics show that diversity

also benefits client care, innovation and problem solving, and increases employee retention. Kate also provided insight into the increasing importance that clients place on a firm's approach to diversity and inclusion and how this has affected request for proposals (RFPs).

Susi and Kate are both members of IP Inclusive, the initiative promoting diversity and inclusion in the IP profession. See ipinclusive.org.uk for more information



Susi Fish of Boult Wade Tennant addresses the conference

PHOTOS: SIMON O'CONNOR

HOW TO AVOID INVOKING YOUR PII

Michael Edenborough QC (Serle Court) promised to make the audience's "hearts flutter" with his advice on how to ensure they'll never need to rely on professional indemnity insurance (PII).

Michael walked the audience through some cautionary tales of cases before the UK IPO, EUIPO and the UK courts, highlighting where they fell short of the mark in relation to evidence and the importance of filing the best available evidence first time round.

Cases of note included Brewdog O/048/18 and *Gerry Weber International AG v Guccio Gucci SpA* [2015] RPC 9, AP. Brewdog appealed a Hearing Officer's (HO) assessment of the likelihood of confusion, arguing that the HO should not have taken judicial notice of the "fact" that, when seeing the name Elvis in the context of beer, beer drinkers would think of Elvis Presley, because this could not be proven without evidence.

After accepting that the HO was entitled to take judicial notice of the fact that Elvis Presley was a very famous singer, the Appointed Person agreed that the conclusions drawn in the context of beer could not be reached without evidence.

The revocation of Gucci's GG logo in the second case is a reminder to get the evidence right first time around and put your best foot forward when filing the TM8 counterstatement. In



Michael Edenborough QC talked the audience through a number of key cases

this case, the initial evidence filed by Gucci was found to fall short of the mark for showing genuine use. Strategically, the other side chose not to file any evidence in reply, rendering Gucci unable to file further evidence to defend its registration. Its application to file supplementary evidence was then refused. While Gucci was permitted

to file new evidence on appeal, it is understood that leave was granted on the basis that the reason for initially filing poor evidence was due to advice from Gucci's previous attorneys.

Michael noted that attorneys and clients alike should be mindful that it is very unlikely for new evidence to be admitted on appeal.



APPEALS PROCESS: AP v HIGH COURT

Ian Bartlett (Beck Greener) provided a summary of the key differences and benefits of the High Court process compared with appeals to the Appointed Person.

He then explained the procedural requirements for a High Court appeal, highlighting the applicable Civil Procedure Rules, timescales to be adhered to, how to serve the Notice of Appeal correctly and the relevant forms required. Ian also clarified the purpose of Respondent's

Notices, explaining that if the Respondent is content with the Hearing Officer's decision, then no action is required. However, if the Respondent wishes to argue that there are additional or alternative reasons why that decision should be upheld, a Notice should be filed.

Finally, Ian walked us through the case of *Trump International v DTTM Operations* from the initial *inter partes* hearing at the UK IPO through to the appeal judgment of the High Court.

Autumn Conference 2019

EVIDENCE AND UK IPO PREPARATION

Oliver Morris, Senior Hearing Officer at UK IPO, provided an overview of the mechanisms for filing evidence in IPO proceedings and the constraints of the system. Oliver reminded the audience that evidence and submissions should be made separately; one should not assume that evidence must be filed, but parties should also endeavour not to overlook the obvious and file evidence to support their claims.

He concluded with a warning that internet auto-prompt results and state-of-the-register evidence will hold little sway over the examiner, as neither are considered accurate reflections of the market. He also issued a reminder to consider the relevant jurisdiction and period for assessment when collating evidence for submission.

Before the lunch break, David Stone (Allen & Overy LLP) gave

an engaging talk on best practice, strategy and tactics for High Court proceedings, noting the potential consequences of filing inappropriate evidence and the increasing trend for the judiciary to strike out inadmissible evidence. He stressed the need to draft witness statements in accordance with the Chancery Court Guidance, as highlighted in the case of *JD Wetherspoon plc v Harris and others* [2013] EWHC 1088 (Ch), where all but six paragraphs of a 231-paragraph witness statement were struck out. David's best-practice pointers were:

- Include only relevant evidence, don't tell the judge things they don't need to know;
- make evidence bundles easy to navigate; and
- remember that evidence filed in UK IPO proceedings can end up in court, so get it right from the outset.



David Stone shares his best-practice pointers



IN-HOUSE PANEL PROVES IMPRESSIVE

Leanne Hall (Serjeants) chaired an impressive panel of in-house counsel, featuring Sarah Coomber from Caterpillar, Terry Daly from British American Tobacco and Darrin Shaya from Black & Decker, who provided an insight into their businesses' approaches to brand clearance.

The panel highlighted the importance of building relationships with key business partners in marketing and product development, and the need to build clearance into the earliest possible stage of the development process. The panel's parting advice was to:

- invest in getting to know your client and evaluating the appetite for risk;

“
Invest in getting to know your client and evaluating the appetite for risk

- structure clearance reports to give a clear indication of risk;
- be commercially focused, and don't just report the state of the register; and
- ensure the advice given is specifically tailored to answer the queries raised.

Left to right: Leanne Hall (Serjeants), Darrin Shaya (Black & Decker), Sarah Coomber (Caterpillar) and Terry Daly (British American Tobacco)

LOOKING BEYOND BREXIT

John Coldham (Gowling WLG) discussed case law developments of note in Europe in relation to absolute grounds, genuine use, bad faith and similarity of marks. John's key takeaway points can be summarised as follows:

ABSOLUTE GROUNDS

- It remains difficult to secure trade mark protection for shape marks;
- Evidence from every EU Member State is not required;
- Affidavit evidence from professionals represents the specialist view, not that of the general public; and
- Evidence from entities related to the Applicant, its contractors, directors, licensees or advertising services provider will not be considered to be of the same reliable and credible nature as a statement from a third party (All Star CV v EUIPO, T-611/17).

GENUINE USE

- "Good" evidence of use includes magazines showing the sign, director declarations, screenshots

of price lists, Google Analytics reports, invoices spanning the relevant period, declarations by managers of third-party retailers and declarations summarising the accounts (Mobile.de GmbH v EUIPO, T-412/18).

BAD FAITH

- The relevant date of assessment is the application's filing date; and
- Bad faith can exist even where at the time of the application there was no use by a third party of an identical or similar sign for identical or similar goods (Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ v EUIPO, C-104/18).

SIMILARITY OF MARKS

- Distinctiveness or reputation of the earlier mark should not

be taken into account when comparing the similarity of the marks; this should be an objective assessment. The existence of a link between the marks in the mind of the public concerned, due to distinctiveness or reputation, is only considered if the similarity hurdle is met (Pear Technologies Ltd v EUIPO, T-215/17).



WHAT DOES SKYKICK MEAN IN PRACTICE?

Emmy Hunt and Edwina FitzHugh (both Potter Clarkson), closed the day with discussion of the much anticipated Attorney General's (AG's) opinion on the questions referred to the CJEU in SkyKick. They summarised the key points as follows: are some of the terms in Sky's registrations invalid due to lack of clarity and precision?; is "computer software" one of these terms?; were Sky's applications made in bad faith?; and if so, are Sky's marks wholly or partially invalid?

In light of the recent AG opinion, which suggests that the filing of broad specifications may be perceived as bad faith on the basis that the Applicant's intention is to undermine



the interests of third parties or to obtain a monopoly exclusive right, Emmy and Edwina speculated that the EU may adopt a stricter policy regarding breadth of specifications. This would encourage applicants to provide greater detail about the goods and services they hope to protect.

EUIPO: ADR OPTIONS

Gordon Humphreys summarised the EUIPO's judicial structure, and then provided a detailed explanation of the Alternative Dispute Resolution options available at the EUIPO, focusing on the benefits of pursuing mediation as a means for resolving *inter partes* disputes.

With a reported success rate of just under 70 per cent and the potential to secure meaningful commercial dialogue between the parties, Gordon urged the room to consider mediation as a serious option before embarking on litigation, particularly in cases where the dispute is likely to result in multi-jurisdictional cross-filing of revocation and invalidity actions.



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PIECE OF OUR MINDS

Triona Desmond delves into the most recent research on the industry's attitudes towards mental health

To mark Mental Health Awareness Week in May, CITMA joined with the diversity initiative IP Inclusive and with CIPA to survey the mental wellbeing of the patent and trade mark professions, incorporating the input of CITMA members for the first time.

Interestingly, the results of the IP survey – released in September – indicate that, on the whole, CITMA/CIPA professionals suffer less with mental health issues than the wider legal profession. But what is the picture for others?

This latest survey was composed with the Law Society’s Junior Lawyers Division (JLD) 2019 survey in mind, so that responses could be compared, although the addition of CITMA members means there will be some variation. It addressed the levels of stress incurred by the 1,016

respondents, how they coped and whether support was available. The 2019 results showed a decrease in levels of stress and other mental health problems compared to the previous years.

However, some of the results were alarming. People in our profession have contemplated suicide. Paralegals and students appear more stressed than other CIPA and CITMA members. The current support available appears to be insufficient and a significant number of respondents appear afraid to speak out. CITMA is concerned by the results and is taking positive steps to support its profession.

FINDINGS IN FOCUS

The research shows that more than two-thirds of the respondents have been stressed, anxious and/or depressed in the past year, which

has adversely affected their work. The table below shows that the paralegal cohort had the highest number of sufferers of high anxiety (61.2 per cent), followed by other respondents, and then students.

The greatest worry is the number of respondents who have contemplated suicide in the past 12 months, almost six per cent across the student and “other” groups. When questioned, a number stated that their problems were not related to work or were merely compounded by work. Regardless of the cause, this tells us that we need to be taking the issue seriously at all levels. Looking into the survey’s findings can help us uncover specific areas of focus.

One fifth of our student and paralegal respondents, and approximately a quarter of qualified counterparts, were currently feeling uncomfortable or worse at work.

Looking at a snapshot of the past month only, stress levels were high for up to a quarter of respondents, increasing with seniority of position. As a result, people struggled to cope at work. The stress had also affected, or at least was perceived to have affected, other aspects of people’s lives, causing problems with sleep, appetite, fatigue and other physical effects, and (in particular for qualified attorneys) with relationships outside of work.

DRIVERS OF DISTRESS

Causes of mental health conditions include clients, management, exams and work-life balance. Of the paralegal group, 40 per cent claim to struggle with “poor management”, while more than half of the surveyed students are experiencing exam stress. Nearly a third of qualified

TABLE 1: % EXPERIENCING STRESS AND MENTAL HEALTH PROBLEMS (PAST 12 MONTHS)

	STUDENTS	STUDENTS 2018	PARALEGALS	OTHERS	OTHERS 2018
HIGH STRESS LEVELS	47.0	51.7	61.2	58.4	66.9
ANXIETY	44.8	51.7	53.2	42.8	55.4
DEPRESSION	22.0	27.3	23.0	20.4	30.7
OTHER MENTAL HEALTH PROBLEM (formally diagnosed or not)	6.9	4.1	7.2	4.7	3.0
NONE OF THESE	30.6		20.9	29.2	

attorneys suffered from stress caused by conflict with home life and caring responsibilities. Worryingly, one in 10 paralegals are experiencing bullying or harassment in the workplace.

The report suggested that IP professionals are extremely self-critical; fears around not being good enough and not “fitting in” were cited as major contributors to mental health problems. In addition, more than a 10th of the main survey respondents had experienced anxiety or isolation about, and/or felt the need to hide, aspects of themselves, these figures increasing for students and more so for paralegals.

DIALOGUE AND SUPPORT

More than half of respondents had not made their employer aware of their issues, with students being the least likely to communicate. The report suggests that this could be because of their junior status and concerns about career prospects. Despite being disproportionately affected, paralegals speak out about their issues more than other groups and are more likely to take time off.

Although several commented that they had supportive managers/HR/workplaces, almost 16 per cent of non-students were unaware of workplace support measures. On the upside, 15–20 per cent now have access to a trained mental health first-aider. CITMA has recognised the benefit of these and is organising training so that more can be available. The availability of flexible working arrangements seems to be reasonably good for patent and trade mark professionals, in particular for qualified attorneys.



TABLE 2: BARRIERS TO TIME OFF WORK (TOP FIVE ANSWERS BY %)

	STUDENTS	PARALEGALS	OTHERS
FEELING YOU SHOULD BE ABLE TO COPE ANYWAY	44.2	46.0	37.2
HAVING TOO MUCH WORK TO DO	39.0	51.8	57.4
NONE OF THESE / NOT APPLICABLE	35.1	25.2	26.4
NOT WANTING TO MAKE LIFE DIFFICULT FOR COLLEAGUES	34.2	54.0	38.8
CONCERN ABOUT ITS IMPACT ON CAREER PROSPECTS	28.6	23.0	
NOT WANTING TO LET CLIENTS DOWN			41.6



“ CITMA has recognised the benefit of mental health first-aiders and is organising training so that more can be available

The impact on workplace productivity may be masked as more than 80 per cent of respondents have not taken time off. Productivity, however, may be impacted as sufferers of stress, anxiety and/or depression have more potential to make mistakes. Respondents did not wish to take time off due to high workload, letting people down and feeling that they should cope. More than a quarter of students and nearly as many paralegals had concerns regarding career prospects (see Table 2).

As an industry, there appears to be an opportunity to encourage more dialogue, increase awareness of available support and consider time off to help with mental health issues.

JOB SATISFACTION

It's not all bleak: both job satisfaction levels and current mood were reported more positively this year. All three groups of respondents cited good-to-high levels of job satisfaction when things are going well (see Table 3) and the percentage of students wishing to leave the profession has halved since 2018. However, more than a fifth of all IP respondents were considering job or career changes. That figure is more than a third for the wider legal profession. This is a concern for the legal profession as a whole.

The report also indicates that more than 10 per cent of the main survey respondents had moved to a different job (for example, in a smaller firm, a non-London location or an in-house department) or gone freelance, or had at least planned an “exit strategy”, in order to reduce stress levels.

COPING

Unfortunately, stress was having a negative impact on people, resulting in mistakes (or near-mistakes), reduced confidence, and physical problems such as fatigue and loss of sleep. However, the report indicated a good level of awareness of accepted stress-counteracting strategies. People partake in activities such as physical

exercise, connecting with other people and limiting working hours to combat stress. Most members use family and friends and also sympathetic colleagues for support. Sadly, use of resources such as the LawCare helpline is low.

PROFESSIONAL OPINION

I obtained the opinion of a retired consultant psychiatrist on the survey. She considered it well constructed and recommended an occupational psychologist was involved in any further surveys. She advised looking into methods other professions adopted to reduce stress and prevent people leaving the profession. Surprisingly, she did not consider the figures related to suicidal thought to be high. However, she pointed out that suicide is a highly complex subject. With three different groups involved, she warned that it is difficult to make firm conclusions. However, support is key to those struggling.

Responding to the survey, CITMA President Tania Clark stated: “The results of this survey confirm that mental health and wellbeing is an important issue for the IP legal profession. The findings will be a wake-up call for many in the profession and their firms and shows that together we need to do more. We are committed to working with IP Inclusive, LawCare, firms and our members to maintain an open dialogue and help tackle the stigma around mental health.”

Elizabeth Rimmer, CEO of LawCare, commented: “We were interested to read the survey results, which reflect the issues legal professionals contact our support service about: stress, anxiety and depression. These problems are often caused or exacerbated by a difficult working environment. Lack of support or supervision, an overly critical manager, an unreasonably heavy workload, long hours and sleep deprivation are all very common. Firms need to do their best to create a healthy and happy ▶



TABLE 3: LEVEL OF SATISFACTION WHEN WORK IS GOING WELL (%)

	STUDENTS	STUDENTS 2018*	PARALEGALS	OTHERS	OTHERS 2018*
EXCELLENT	49.8	45.5	40.0	46.0	34.4
GOOD	39.7	40.7	44.4	38.3	44.6
FAIRLY GOOD	8.3	9.0	14.1	13.4	15.3
NOT SO GOOD	2.2	1.8	1.5	1.8	3.2
POOR	0.0	1.2	0.0	0.6	0.0

*AN ADDITIONAL COMMENT OPTION ACCOUNTS FOR MISSING PERCENTAGES

“ We have the potential to create environments in which individuals feel that they can bring their whole selves to work and feel supported by their employers, whatever their level

place to work, not only because it is the right thing to do, but because there is a strong proven business case for it.”

WHAT NEXT?

It is clear that our sector needs to consider mental health as a real issue. The current view is that it should be treated as any other medical condition and our profession should be prepared to take active measures to support our colleagues.

The report provides a number of useful recommendations and advises that IP Inclusive, CIPA, CITMA and individual employers within the patent and trade mark professions should continue to work together to:

- Encourage open dialogue about mental health and reduce the associated stigma.
- Improve workplace cultures to be more inclusive and supportive of those with mental health problems.
- Adapt working practices and workload management to reduce stress levels.
- Improve signposting to relevant resources, both within and outside the sector.

These suggestions appear plausible and should be factored into a workplace, in particular small firms/ businesses and for those who work in-house. Specific support for paralegals and students should be considered. I have spoken to CITMA

members, including students and paralegals, who are not surprised by the findings.

There is a real appetite for industry-wide positive action. I hope this bears fruit soon. We have the potential to create environments in which individuals feel that they can bring their whole selves to work, manage workloads and work-life balance and feel supported by their employers, whatever their level. ●

With thanks to Andrea Brewster, Lead Executive Officer of IP Inclusive, who formulated and reported the survey. The full report can be viewed at bit.ly/454_MentalHealth

RESOURCES AND SUPPORT

Should you require support, please do not hesitate to call on the following resources:

- **LawCare:** CITMA contributes financially to its running. It promotes and supports good mental health and wellbeing in the legal community. Call the free Support Helpline on 0800 279 6888 Mon–Fri, 9am–5.30pm, or webchat, Mon 9am–1pm, Wed 1–5.30pm, Fri 9am–1pm, or visit lawcare.org.uk
- **Samaritans:** For assistance outside of working hours, call the helpline at any time on 116 123
- **IP Inclusive:** See its dedicated page at ipinclusive.org.uk/mental-health-and-wellbeing
- **Jonathan’s Voice:** This charity, to which the report is dedicated, was set up in memory of the Patent Attorney Jonathan McCartney, who in 2017 tragically took his own life. Visit jonathansvoice.org.uk
- **CITMA:** See our pages on “LawCare” and “Why mental health matters” at citma.org.uk/support

NOTES ON METHODOLOGY

- The survey was voluntary and anonymous and contained separate, tailored versions for students and paralegals alongside the main survey of other CIPA and CITMA members. Of the 1,016 respondents, 709 were CIPA members and 232 were CITMA members. Of those, 253 were students, which represented 21.3 per cent of the total CITMA/CIPA student members, and 153 were paralegals (22.6 per cent of all CITMA/CIPA paralegals).
- 2019 responses had increased from the previous year. This may be because the survey was opened up to CITMA members. Respondents came from a range of professional roles, career levels and working environments. Regrettably, in-house professionals were much less well represented than private practice, the majority working in large private practice firms, in a city, not necessarily London.
- When assessing the results, we need to note that respondents with mental health issues are more likely to complete the survey than those without. However, we may not have the full picture – those struggling with stress may not have had the time/inclination to fill out the survey. Therefore, the issue of stress in the IP profession could be more alarming than the results indicate.



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STAKE YOUR CLAIM

Liam Hynes issues a call to action

I'm sure many *Review* readers know about, or even work with, the UK Intellectual Property Office's (UK IPO) IP attaché network. If not, it's never too late to start. Yes, this is a plug for the excellent work the attachés do, but it's also a call for action. The context for our international engagement is changing. We need to ensure that our priorities remain relevant, impactful and aligned with the needs of UK businesses. That's where you come in.

We've taken stock of the role and ambition of the IP attaché network and are looking ahead to what's next. How can we ensure that the international IP environment meets the needs of UK business? And how do we make sure companies have the right tools to benefit from international markets?

Since 2012, the UK IPO has developed the IP attaché network into a tour de force. Based in British overseas posts and working with the Department for International Trade and the Foreign and Commonwealth Office, the attaché network was launched to build IP knowledge among UK businesses, provide practical in-market support and liaise with host governments on the local and international IP environments.

Over the years, the UK IPO network has reached more than 30,000 businesses looking to trade overseas. Attachés have grown their reputation for dealing with some of the thornier IP challenges and now provide tailored support for hundreds of UK companies on issues worth a combined £100m every year.

Beyond the headlines, the network has had an impressive, and hard-fought, impact on the international IP environment. Long-standing

efforts in China have brought about positive changes to the treatment of UK brands in protecting and enforcing their rights. In India, the UK IPO has worked with government counterparts to boost the level of IP awareness among consumers and the business community. And by playing a key role in building awareness of the negative impact of counterfeits in Brazil, we have seen a significant increase in enforcement action against infringing marketplaces.

NO STANDING STILL

It has been a successful journey so far, but we know we can't stay still. The UK Government has set out an ambition to increase the proportion of exports from 30 to 35 per cent of GDP. Getting us there requires reducing market barriers and helping UK businesses to navigate the international trade environment.

Differences in IP systems, concerns about IP protection or a lack of IP knowledge can still act as a barrier to UK businesses wanting to operate and trade overseas. A modern, effective and fit-for-purpose international IP system would assist companies and individuals in maximising the value of their assets.





“ We need to ensure that our priorities remain relevant, impactful and aligned with the needs of UK businesses. That’s where you come in

As highlighted in the Government’s Export Strategy, we know that most of the global growth over the next 10 to 15 years will happen outside of Europe in the emerging economies of Asia, Latin America and Africa. It is only right that we take a fresh look at the work we do on IP in helping to deliver on the UK’s trade and investment ambitions.

Looking at our current footprint, there are two glaring gaps: Africa and the Middle East – two hotbeds for UK investment and growing export markets. Both offer significant market opportunities for British businesses and brand owners. But both have their challenges. Work is already under way to figure out what we can do on IP to improve UK prospects in these regions.

ASSESSING OUR REACH

This isn’t an announcement of new IP attachés, but the time is right to assess our reach and look to the future. We don’t have all the answers – and we won’t have without the engagement of stakeholders like yourselves, who deal with UK companies looking to do business in these regions. We’d be very interested in any experience you have of working in these markets.

Awareness of, and access to, the attachés is also an area we want to improve. As we look to strengthen the impact of the network, we want to make sure businesses can access support in key markets and can engage with international institutions on IP. Stakeholder involvement is vital. We welcome your feedback to make sure we get that impact right. ●

Find out more by searching the “intellectual property attaché network” on the gov.uk/ipo website, and subscribe to the UK IPO’s alert service at public.govdelivery.com/accounts/UKIPO/subscriber/new

HERE TO HELP: THE ATTACHÉ TEAM

WHO TO CONTACT FOR INTERNATIONAL ASSISTANCE:

INDIA

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We recognise that takes work and have been taking steps to make that a reality. In July 2019, the UK IPO appointed its first IP attaché to North America, reflecting the important role IP plays in our trading relationship and the significance of our relationship with US counterparts in developing the global IP framework. Kayleigh Nauman will support the UK IPO’s input into any trade discussions with the US and provide insight into US IP policies.

Kayleigh also focuses on building cooperation between the US and the UK on IP matters such as global treaties, simplifying international patent procedures and approaches to IP enforcement. The North America remit also means Kayleigh is able to provide IP advice and support to UK businesses operating in or trading with the US, Canada and Mexico.

The new post in Washington, D.C. follows increased resource in China, with an additional posting in Shanghai, and in South East Asia, where two attachés now serve UK interests across the 10 ASEAN (Association of South East Asian Nations) markets.



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TALKING TECH WITH ERICH SPANGENBERG

Birgit Clark converses with one of the industry's most controversial figures about how modern technologies may shape future IP law and practice

Erich Spangenberg, former law firm partner, investment banker and corporate CEO, has changed the way people think about patents and IP law.

Once best known as a controversial “patent troll” and for his expertise in patent monetisation and predictive analysis, he is now widely recognised as a leading IP strategist.

Intellectual Asset Management put Spangenberg second in its list of the top 40 IP “market makers” whose “connections, decisions and actions drive the ever-expanding global IP marketplace”. *Managing Intellectual Property* listed him as one of the 50 people shaping the future of IP. Most recently, he has founded IPwe, a company using blockchain and artificial intelligence (AI) to create a patent asset class.

BIRGIT CLARK:

You are something of a reformed enfant terrible of the IP world and rose to fame as a patent troll – something you even pointed out during the recent WIPO blockchain standards workshop in Geneva. Can you tell us a bit more about your past and what you are doing now?

ERICH SPANGENBERG:

I did not come to the patent world like most people. I learned about

patents in the late 1990s while I was an executive at a telecom company that was sued repeatedly for patent infringement. Lacking any training or experience in patents, I was not encumbered by any preconceived notions about how the system should work, but I was surprised by how it did.

As a result of this experience, it occurred to me that most business people had a very limited idea of how these assets really behaved, and there were no available resources to alleviate this problem. I saw an opportunity to embrace this arbitrage opportunity, and I exploited it from 2003 until 2012. I learned a great deal – mostly from my mistakes – during this period, and it formed the basis for my views on how the system could be improved and how it should work.

When the US was considering patent reform and the Leahy-Smith America Invents Act (AIA) in 2010, I could not believe that the pharmaceutical industry would embrace this legislation or that it would pass. When it did, I realised that there was an opportunity to use the AI company we had bought in 2007 to build a more efficient invalidation machine. While it was controversial when we launched it in 2013, today it is a standard part of the playbook for most generic pharmaceutical companies.

In late 2016, I discovered blockchain, and after a few months it occurred to me that AI and blockchain could be the technologies that would enable the “IP market” I had been hearing about for years. Since I first entered the IP world in 2003, many have launched plans to create an IP market – some of them, like Intellectual Property Exchange International, were really good ideas backed by very smart people but still failed. While I completely understand the scepticism, I do believe that exponential technologies like AI and blockchain are the technologies that will finally enable the IP market. As it becomes easier to interact with and understand the basic attributes of patents as a result of these technologies, there are some really good things that can happen.

What are the major challenges that patents currently face, and how could blockchain and AI help tackle these?

Intangibles account for more than 70 per cent of most corporate balance sheets, and patents are a material part of intangibles. Very few executives have more than a basic understanding of patents. There are myriad reasons for this, but difficulty in engaging and a lack of transparency are two factors that contribute. AI allows a person



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I believe that exponential technologies like AI and blockchain will finally enable the IP market

to get basic information that can be displayed in an understandable manner – perhaps high-level, but far easier than it has ever been. If you want to go deeper, you can easily get reasonably reliable information – expressed as mathematical probabilities – that a patent is invalid and some other attribute you might care about. If you are an expert, you can drill down even further and apply your professional judgment to those

assessments. AI lowers the discovery cost. Blockchain lowers the transaction cost and makes things like tracking much easier.

So what are the most likely use cases for blockchain and related distributed-ledger technologies that will fuel adoption in IP law over the next five or 10 years?

While we do not foresee exponential technology replacing IP professionals, we believe that the

IP professionals who embrace exponential technologies will replace those who do not. As an IP professional, your client values your judgment and expertise. The busywork that exponential technologies handle extremely well generally prevents the professional from focusing on the high-value and interesting work. In the West, many corporate IP departments are under pressure to improve efficiency and stretch their budgets and

“

IP professionals who embrace exponential technologies will replace those who do not

resources further each budget cycle. However, outsourcing to cheaper labour markets, cutting staff and pressuring vendors to reduce costs have natural limits.

Let's be a bit more controversial: will technologies such as blockchain and AI make IP offices obsolete?

I doubt it. I believe the most enlightened patent offices will embrace exponential technologies as a way to deliver better service to innovators and to fulfil their societal mission. I can't be the only one who thinks a three- or four-year patent application approval period is far too long. Patent offices will either make themselves irrelevant by refusing to adapt or they will embrace exponential technologies as a way to improve their service and mission. We have become accepting of practices and delays that we should not accept.

Smart contracts remain a hot topic, not only in the context of IP law. Canadian science fiction writer Karl Schroeder went so far as to argue that lawyers aren't the future, in a world that he contends will be governed by blockchain-based smart contracts. Is this a feasible assumption? Or do you agree with German IT lawyer Claudia Ott, who has countered, half-jokingly, that smart contracts are just science fiction?

I think smart lawyers will embrace smart-contract technology. At some level, they will not have a choice as smart contracts will become widely accepted – even demanded – by business. Smart contracts do many things that permit entire systems to operate far more efficiently, and

while we anticipate that they will lead to more contract standardisation, there will still be client demand for customisation and, of course, dispute resolution. Smart contracts will not do away with disputes, although the mechanisms for dealing with those disputes may change and alternative dispute resolution methods may become more popular. There is no science fiction about smart contracts – but that is not to say that legal drafting skills and the legal skills applicable to dispute resolution will no longer be in demand.

Should IP and trade mark lawyers learn how to code? How much knowledge should IP lawyers have of modern technologies and what should they be focusing on?

There's no need to learn to code, but I would spend time obtaining an appreciation of the process of coding. A far more relevant skill would be picking up on finance and business metrics. All other assets on corporate balance sheets are subject to financial metrics – and intangibles will soon be subject to similar metrics.

I get asked this question a lot so I'm keen to hear your answer: despite the possibilities that AI and blockchain offer, what are the potential challenges with regard to large-scale legal application? Time. Enterprises simply take time to adapt and change their legacy systems. For an enterprise, [a new technology] not only has to be better, it has to be safe, secure, stable and scalable. It is easy for a start-up to adopt new technologies,

THE SPANGENBERG CV



PROFILE: A serial entrepreneur and founder of IPwe, which uses blockchain and AI to make it easier to analyse, interact with and transact in patents.

FOUNDED: IPNav, 2003-2014, offering strategic advisory services for IP

OTHER ROLES: Investment Banker at Donaldson, Lufkin & Jenrette; Corporate Lawyer and Partner at Jones Day

EDUCATION: BA in Economics, Skidmore College; MSc in Economics, London School of Economics and Political Science; JD, Case Western Reserve University School of Law

but it's different for corporations and government agencies.

If we take a look forward five years, what will be different?

In the West, I believe that if patents do not become an asset class, subject to meaningful metrics, then investment in them will decline. If financial professionals cannot measure patents for simple things like return and perhaps even some range on value, they will refuse to invest or will at least reduce their investment. The next time someone not trained in patents asks you a question, try and give them an answer that someone who is not an IP professional can comprehend. Equally, try to familiarise yourself with exponential technologies and how they can help increase transparency and reduce transaction costs. In China, I see a very different future – more on that another day, but suffice to say those complaining about weak IP protection will be changing their tune. ●



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Reflections of a long-running Trade Mark Attorney

In preparing to end his 48-year membership of the CITMA Council, Keith Havelock casts his mind back over his career and some key IP moments

For many of us who began their trade mark careers in the late 1950s, entry into the profession mostly occurred by pure accident, rather than after, say, a university course in IP. My own entry was slightly more structured in that it all began with a talk given to our local church youth club by a friend's father, the principal of a small firm of Patent Attorneys in Quality Court, Chancery Lane, London – and who eventually offered me my first job. The gentleman in question was the original Mr R G C Jenkins of the eponymous firm.

As I had started working at a relatively young age, I enjoyed a lot of responsibility early on, including the conduct of a successful High Court case, ORANGE GROVE trade mark, reported in *RPC*. At the end of the hearing, the courtesy of the other attorney, Vincent Thornton of AA Thornton & Co, impressed me as the correct way to behave in such circumstances. I attempted to emulate him in all similar situations thereafter. Our Counsel in the case was RG Lloyd QC, later to become Lord Lloyd of Kilgerran, prominent in the Liberal Party under Jeremy Thorpe. Later, when I co-authored an introductory book on trade mark law and practice with a member of his chambers, Lord Lloyd kindly wrote an introduction.

He also assisted the Institute in parliamentary matters. In his last note before the hearing, Counsel's advice included a recommendation that a Statutory Declaration regarding the collection of the evidence be made by "reference numeral KRH or some more senior member of my instructing agents' firm". Naturally, there was no way in which reference numeral KRH was going to let any other body steal his thunder.

STARTING OUT IN CITMA

This period saw the beginning of my personal association with the professional body that was to become CITMA, with which I interacted on behalf of my firm, which was expanding. In this way, the firm began to feature on the trade mark map.

After passing my Institute exams, I became active in its affairs and was invited to stand for election to its Council in 1972 and concurrently to join its Law and Practice Committee (L&P) to help with the preparation of evidence for submission to the Mathys Committee, which had been established by government to examine the state of trade mark law in the UK. This was a broad undertaking in which, uniquely, every qualified member of the Institute was invited to participate. The gathering of a considerable body of well-received evidence was eventually and expertly coordinated by the then L&P chairman, Sheila Lesley.

By this time I had changed firms and was working at Reginald Barker alongside Institute stalwart and founder member, Maurice Rowland. Maurice, as a past President himself, encouraged me to stand for election to that office in due course and so it was that I had the good fortune to be elected as President in 1979, at the age of 39. This experience, over the next two years, was very rewarding. Innovations brought about and decisions taken then and subsequently began slowly but surely to place us – as an independent body representing the UK profession – on the international trade mark map.

A significant event in the field of European trade mark practice took place (also for me personally) with the formation of ECTA (originally named The European Communities Trade Mark Practitioners' Association, but the word "Practitioners" was later dropped). The Association's founder was Eric Wenman, the Company Trade Mark Agent at ICI.

The new group was formed as a UK company limited by guarantee, along constitutional lines similar to those of our Institute. It was thought that UK practitioners would form the largest national group of possible members, so chairmanship of the membership committee fell to me, on the proposal of Dr Wim Mak of Philips, one of the original subscribers representing the Netherlands. The numbers of members and of member states grew steadily



over the years so that today, as the Association nears its 40th year, more than 850 Trade Mark Attorneys from all over the world attend its annual conferences. Thus began my involvement with ECTA that was to continue through 35 years as a member of its Council including, after my retirement from full-time professional practice, 10 years as its Secretary General.

THE D YOUNG YEARS

In 1983, I was one day enjoying a drink with two professional colleagues, who were also or had been Institute Council members, when one of them, Victor Nichols, informed me that a partner in his firm was about to retire. He asked how I would feel about taking the retiring partner's place. This was the point at which I joined D Young & Co and lived happily ever after – well, for the next 21 years, anyway.

Among the decided cases that were heard during my years at D Young, the ARSENAL and BUDWEISER cases were reported in *RPC*, while one involving the WEST INDIAN SEA ISLAND COTTON certification trade mark, whose owners were my clients, was not, although it featured in case notes published in the ITMA newsletter. This case was the first ever heard by William Aldous QC (as he then was), before he became a High Court judge. Another unreported case involved the marks PIZZAEXPRESS versus PIZZA HUT EXPRESS (our client was Pizza Hut), where the Deputy Judge decided, somewhat to our surprise, that the marks were not confusingly similar.

“ *I had the good fortune to be elected as president of the Institute that was to become CITMA in 1979, at the age of 39*

Never before had I witnessed a Counsel (in that case ours was Michael Silverleaf QC) rise to his feet so quickly to claim judgment and costs.

In 1991, my firm celebrated its centenary and I had the pleasure of being partnership chairman at the time. We celebrated our 100 years at a reception for clients and friends at The National Portrait Gallery in London and had an engraved crystal ruler, marked in centimetres, made as an anniversary gift for our friends. The senior partner of our principal US associate at the time noted in his acknowledgement of the item that “it might, at long last, make me come to terms with the metric system”. We were also pleased that John Myall, then Head of the UK Trade Marks Registry, who was to be the Hearing Officer in another reported case in which we were later also involved, the AL BASSAM case, felt likewise able to accept one of the items as a souvenir of our long and always amicable association.

SIGNIFICANT TIMES

Significant things were happening in the profession around this time, both nationally and in Europe. There were grounds for hoping that Parliamentary time would be found for a root-and-branch revision of UK trade mark



Keith Havelock's firm was involved in the ARSENAL, BUDWEISER and WEST INDIAN SEA ISLAND COTTON cases



Keith Havelock was involved in the PIZZAEXPRESS versus PIZZA HUT case, and represented WATERFORD (above)



law in the form of a completely new statute. The Institute's L&P committee was hard at work on the subject and I was fortunate enough to be a chairman of the committee up to 1994, when its members included John Groom, Richard Abnett, Adrian Spencer and Jeremy Pennant. Each of these and other individuals worked painstakingly to ensure that the eventual new Act reflected the needs of industry and thoroughly updated our law. The above quartet was also responsible for the preparation of one of the Institute's first-ever books, on the subject of the new Act.

Business was brisk after the new Act came into force. An application for registration of our clients' WATERFORD Trade Mark for glassware was successful, reversing the earlier decided case refusing the mark.

Concurrently, in Europe, the Community Trade Mark Regulation

“ The specialist organisation formed by a small group of dedicated professionals back in 1934 had quickly become the independent and resilient body we still recognise today

came into effect, paving the way for the tremendous changes in our field of activity that the subsequent opening of the EUIPO (then the Community Trade Marks Office) would bring.

At the time of one of the significant anniversaries of the formation of the Institute, the editors of the *Review* requested that a timeline be prepared showing the significant dates in the history of the profession in general and the Institute in particular. As my friend and past President Brian March had bestowed on me the dubious distinction of being “I suppose the unofficial custodian of the Institute's history”, the task of composing it fell in my direction.

In doing so, two things struck me forcibly. First, that the specialist organisation formed by a small group of dedicated professionals back in 1934 had quickly become the independent and resilient body we still recognise it as being today. Second, that the profession of Trade Mark Attorney was one that had fought long and solidly for recognition, having had set for it a list of objectives by its founders virtually all of which had by that time been achieved. This achievement of objectives – for example, the Register, mixed partnerships, approved regulation and litigation rights and the statutory recognition of the term registered Trade Mark Attorney – came about as a result of prolonged or inspired action by members of the profession, mainly as members of the Institute. Others occurred as a result of changing attitudes as to what should be happening in a just and civilised society.

Around 2012, the Council and officers of the Institute thought it time to consider making another attempt to obtain

a Royal Charter. I say “another” as a previous application in the 1980s had been unsuccessful, possibly mainly on financial grounds, while a more recent application had been withdrawn on political grounds.

The writer's involvement in the latest venture had a touch of serendipity about it. I had been sitting, by chance, next to a fellow alumnus of The Royal Grammar School, Guildford, Richard Tilbrook, at a lunch at the school. Conversation revealed that one of Richard's current roles was as Clerk to the Privy Council, the body whose responsibility it was to grant Royal Charters. Pretty smartly, I told him that our Institute was considering making a new Charter application, to which he replied, “Well, write in”. So we did and you all know the eventual outcome. Not that an enormous amount of work by successive Presidents and the Institute's staff did not have to be done, and several years elapse before the successful result was achieved. Many people both within and without the Institute contributed to this success, but the main plaudits I believe will ever go to Keven Bader, CITMA's Chief Executive, and Kate O'Rourke MBE, President at the time of the grant.

In contributing occasional articles to the *Review*, over the years, it has from time to time occurred to me to question how and why responsibility for trade mark registration in our country ever came to be the responsibility of the *Patent* Office in the first place. Attention to that question may be given in another article in the future. Perhaps even by this author. ●



Keith Havelock

is a Chartered Trade Mark Attorney, CITMA past President and Honorary member, UK and European Trade Mark Attorney

GET UP TO CODE

Maria Cruz Garcia points out the primary changes made last summer to Portugal's IP regime

On 1st July 2019, the new Portuguese Industrial Property Code entered into force, approved by Decree-Law No 110/2018 of 10th December 2018, which incorporates measures to harmonise the Code with EU legislation. The main changes relevant to daily practice are:

- **A graphic representation of the trade mark is no longer required.**

Applicants no longer have to file a graphic representation of the sign together with their trade mark application and it is simply necessary to submit a representation that clearly and precisely shows the subject matter of protection. This change will simplify the registration process for non-traditional trade marks, such as sound, taste and smell marks.

- **The validity term of a trade mark registration now begins from the date of application.**

For registrations granted before 1st July 2019, the first renewal will continue to be counted from the date of registration. However, all subsequent renewals will be counted from the date of application. Renewal notices will be sent out at the appropriate time.

- **Registration (grant) fees have been reinstated.**

The new IP Code reinstates the formality of payment of a fee for the grant of the registration. Failure to pay the fee will cause the registration to lapse. Notices will be sent to advise that these fees must be paid.

- **Proof of use can be requested in opposition proceedings.**

When an opposition is filed against a trade mark application, the applicant can request that the opponent furnish documents

attesting to the use of the mark(s) on which the opposition is based if those trade marks have been registered for more than five years. If no proof of use is provided, the opposition will be dismissed.

This procedure also applies in the case of an *ex officio* provisional refusal issued by the Portuguese Industrial Property Office.

- **An Invalidity Division has been created.**

The Portuguese Industrial Property Office is now competent in the first instance to declare the invalidity of registrations of trade marks, logos, designations of origin and geographical indications – under the previous legislation, this competence lay exclusively with the Court of Intellectual Property. The time limit to file an invalidity action against trade mark registrations is now five years counted from the date of the decision of grant.

“

The time limit to file an invalidity action is now five years



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THE WORLD'S IN MOTION

Ryan Kellingray welcomes the start of a new chapter for UK trade mark registrations

UK trade mark history was made in May, when the first multimedia motion mark reached the country's trade mark register. This follows changes enacted last January via the Trade Marks Regulations 2018, which widened the goalposts for registrable trade mark subject matter and introduced the option to represent trade marks by way of a number of digital formats.

The first successful applicant was Japanese technology conglomerate Toshiba, which sought protection for a one-second animation that shows the familiar TOSHIBA logo being surrounded by a number of multicoloured, origami-inspired unfolding triangles (UK00003375593). Happily, we need not rely on descriptions such as these to ascertain the scope of the trade mark registration, as the animation can be viewed thanks to the inclusion of an MP4 file on the relevant record on the UK IPO register.

The motion mark joins Google's hologram mark (UK00003375918) on the register as part of an exclusive but expanding group: a range of registrations that signify something of a "next chapter" in trade marks and protect bleeding-edge elements of branding. A number of other multimedia motion marks have since followed suit.

The news of the first motion mark registration was greeted with much fanfare by UK IPO Chief Executive Tim Moss. In a press release he heralded the changes, which allow organisations to "explore imaginative ways of reflecting their distinctive brand personalities using creative intellectual property".

Significant investment is made by marketers and brands into leveraging the power of hugely popular short-form video platforms, such as Instagram and Snapchat, to create attractive and engaging animations. It therefore stands to reason that the trade mark system can now be utilised to protect this investment.

PRACTICAL QUESTIONS

That said, a number of practical questions do emerge. For example, how much weight will an examiner give to the distinctiveness provided by the moving elements? How would they interpret an application for a descriptive word mark, in which the word in the mark is the subject of some kind of particular, potentially

distinctive, animation or movement? Given the relative lack of precedent, the examination of such marks will require a more holistic interpretation, at least in these early stages.

This then elicits questions about how straightforward a likelihood of confusion assessment involving such a motion mark would be in opposition or infringement proceedings.

Strategically, does a multimedia motion mark provide much protection over and above a standard figurative or word mark? Furthermore, such multimedia motion marks could not be used, for example, as the basis for a Madrid Protocol application, meaning that overseas protection for any branding elements that derive their distinctiveness from their motion or animation will need to be considered carefully.

Despite these reservations, Toshiba's multimedia motion mark represents the first in what this author envisages will be a long line of such registrations. It offers a practical illustration of the trade mark infrastructure leveraging technology to effectively provide organisations with the tools they need to protect key branding elements exactly as the creator has intended, and exactly how they are used.

See the Toshiba motion mark in action at bit.ly/454_Toshiba

“
Significant investment is made by brands into leveraging the power of platforms such as Instagram and Snapchat”



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Tiny troubles

An 80s reference didn't have sufficient resonance, suggests Ciara Hughes

In August 2017, Tiny Rebel Brewing Company Ltd (the Applicant) filed a UK trade mark application for the CLWB TROPICANA device mark (shown below) covering "beers; shandy, de-alcoholised drinks, non-alcoholic beers" in class 32. The application was opposed by Tropicana Products Inc. (the Opponent) under ss5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994, based on its earlier UK and EU trade mark registrations for the TROPICANA word mark, the TROPICANA device mark (shown below) and its goodwill in the UK in relation to the TROPICANA mark.

The Hearing Officer (HO) decided in favour of the Opponent under s5(2)(b) on the basis of only the Opponent's EUTM registration for TROPICANA, but also considered that the Opponent had established a reputation and goodwill in the UK in the fruit juice market under its TROPICANA mark, and the Applicant's use of the mark applied for would constitute passing off.

The Applicant chose to appeal the HO's decision to the Appointed Person (AP) only in relation to beer and, applying *Meric*¹, the AP observed that the term "beers" encompassed non-alcoholic beers and was therefore identical to the Opponent's non-alcoholic drinks. The AP dismissed the Applicant's offer to limit its specification to exclude non-alcoholic beverages, which came too late in the proceedings and was inconsequential because the level of similarity found existed regardless of alcohol content.

The AP rejected the Applicant's argument that the word TROPICANA was descriptive and non-distinctive for the goods in question based on its dictionary definition of "things associated with or characteristic of tropical regions; objects of the tropics". While accepting that CLWB TROPICANA might be understood by some members of the relevant public as a reference to the Wham! song "Club Tropicana", the AP considered it sufficient that a significant proportion of the relevant public would be

"The AP considered it sufficient that a significant proportion of the relevant public would be confused

confused. The AP further held that the HO had correctly determined that the word TROPICANA played an independent and distinctive role within the mark and there was a low to medium degree of similarity between the marks. The Applicant's appeal therefore failed.

The finding that a likelihood of confusion existed may seem surprising, given the collection of elements comprising the heavily stylised mark, only one of which correlated with the earlier mark. However, this decision demonstrates the expanded scope of protection for an earlier mark with enhanced distinctiveness, and highlights the importance of the sizing and positioning of an individual distinctive element within a complex mark.

KEY POINTS

- ✦ Stylisation and additional elements within a complex mark may not remove the risk of confusion where one distinctive element is identical to an earlier mark
- ✦ The scope of protection for a mark with enhanced distinctiveness extends beyond the goods covered by the specification
- ✦ Offering to amend the specification was not sufficient to dispel the likelihood of confusion between the marks

MARKS

THE APPLICANT'S MARK



THE OPPONENT'S MARK

Tropicana

1 T-133/05 Gérard Meric v EUIPO



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Third-party power

Chris Thomas explains how added opposition can affect an outcome

KEY POINTS

* The UK IPO has some discretion with regards to deciding cases involving s3(1)(b) and (c)

* Third-party observations can play an important role in a decision reached by the UK IPO under s3, even if informal

* The increasing role of legal tech in the marketplace was a likely factor in this decision

This appeal resulting from the decision of the Hearing Officer (HO) on registration of the trade mark LEGAL ENGINEER (No 3235214) was launched by Cloch Solicitors Ltd (the Applicant). The HO had partially refused registration of the mark based on s3(1)(c) Trade Marks Act 1994 (the Act).

INITIAL OBJECTION

On 5th June 2017, the Applicant applied to register LEGAL ENGINEER as a trade mark across a very wide range of goods and services in classes 9, 16, 25, 35, 41, 42 and 45 including software services in class 42 and legal services in class 45. The UK IPO raised an objection in its initial examination report based on s3(1)(b). A letter from the UK IPO stated:

“A search of the Internet describes a legal engineer as a person working with technology and the law industry and therefore when the term is applied to your clients’ goods and services it merely appears as a nondistinctive badge of origin.”

However, following submissions by the Applicant, the application was found to be acceptable for goods and certain services in classes 35, 41 and 42. The application was published on 13th October 2017 in classes 9, 16, and 25 and parts of classes 35, 41 and 42.

THREATENED OPPOSITION

Notices of threatened opposition were filed by Pinsent Mason, Wavelength Law Ltd, High Q Solutions and the Law Society. Third-party observations were filed by the Engineering Council, High Q Solutions Ltd and Shoosmiths LLP raising objections under s3(1)(b)(c) and (d) of the Act.

The UK IPO then determined that the objection under s3(1)(b) and (c) applied more widely than previously thought and the goods and services for which the application was deemed acceptable were further restricted. It stated that: “...the term LEGAL ENGINEER is a term used in the legal profession specifically when describing someone who combines IT skills to engineer and improve the delivery of legal services.”

At a telephone hearing on 5th June 2018 the objection was upheld by the HO based on ss3(1)(b) and (c). The HO accepted that the term was not used customarily in the trade but



1 Agencja Wydawnicza Technopol sp z oo v OHIM [2011] E.T.M.R. 34
2 C 191/01 P Doublemint
3 Wine Oh's application, EUIPO Fourth Board of Appeal [2006] ETMR 95

believed there were enough examples of the term being used in a descriptive manner for the sign to be unlikely to be perceived as the trade mark of one undertaking. In a written statement of grounds, the HO maintained the partial rejection based on s3(1)(c).

GROUNDS OF APPEAL

In its grounds of appeal, the Applicant alleged that:

1. The HO went beyond its role in rejecting marks for goods or services that did not have a specific legal interest. The Applicant objected to the “sudden 11th hour U-turn” after a lengthy examination of the application.
2. The HO’s conclusion that the average consumer would understand the mark as applying to a “legally qualified engineer” or “engineer of law” meant the mark was not objectionable under s3(1)(c).
3. The HO had failed to take into account the perspective of the relevant consumer of the goods within the specification and failed to correctly identify that consumer.
4. The HO had placed unreasonable weight on third-party observations.

LEGAL PRINCIPLES

The AP considered the law with reference to Articles 7(1)(b) and 7(1)(c) of Regulation No 40/94 as stated in case C-51/10¹, key paragraphs of which are paraphrased as follows:

Paragraph 33. A sign has descriptive character under Article 7(1)(c) except where Article 7(3) applies – where it is devoid of any distinctive character as regards the goods or services.

Paragraph 37. Account must be taken of the general interest underlying Article 7(1)(c), to ensure that descriptive signs relating to characteristics of goods or services are freely available to all traders.

Paragraph 38. To refuse to register a sign based on Article 7(1)(c) it is not necessary that it is being used in a descriptive manner at the time of the application. It is sufficient that the sign could be used for that purpose.

Paragraph 39. The grounds for refusal do not depend on there being a real, current or serious need to leave a sign free. The number of competitors with an interest is irrelevant. It is also irrelevant whether there are other more usual signs for designating the same characteristics of the goods or services.

Paragraph 46. The descriptive signs referred to in Article 7(1)(c) are also devoid of any distinctive character for the purposes of Article 7(1)(b). However, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact it may be descriptive.

Paragraph 47. Article 7(1)(b) is distinguished from 7(1)(c) as it covers all the circumstances in

which a sign is not capable of distinguishing the goods or services of one undertaking from those of another.

Paragraph 49. The situations covered by Article 7(1)(c) are those in which the sign describes a characteristic of the goods or services – the kind, quality, quantity, intended purpose, value, geographical origin or the time of production. The list is not exhaustive.

The AP also stated that a sign will be excluded from registration by s3(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services.²

DECISION

Ultimately, the AP held that the wording of the application was such that it could cover goods/services with a legal interest and was therefore objectionable.

It also determined that the Registrar was obliged under ss37 and 40 of the Act to consider its requirements after the mark had been published. The Registrar was entitled to consider third-party observations, although they should be given less weight than a sworn opposition.

The AP acknowledged that the possibility that different meanings might be attributed to the term LEGAL ENGINEER by different people did not take it outside of the ambit of s3(1)(c). There was adequate evidence that the term was used in trade and understood by the average consumer.

In addition, the HO was entitled to make a finding of fact that the average consumer was a specialist with an interest in the legal field.

Finally, the AP rejected the complaint that undue weight had been given to third-party observations.

RESTRICTED SCOPE

The application was allowed to proceed only in respect of the more restricted goods and services in classes 9, 16, 25, 35 and 42. In particular, legal services were excluded from the scope of the registration and services were restricted to a range of data processing services in class 35 and computer game software design in class 42. The appeal was dismissed with no order for costs.

The case makes clear the discretion available to the UK IPO when deciding cases involving ss3(1)(b) and (c). While the Applicant contended that observations filed by third parties had affected the decision, it was open to the UK IPO to revise its decision taking these observations into account.



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More hard times for Easy

Complacency may have played a part, notes Laura Robyn



This case concerns an invalidity action based on relative grounds against a registration for ARNOLD CLARK EASY PAY in the name of Arnold Clark Automobiles Ltd. The mark is registered in respect of a range of financial services in class 36, vehicle repair services in class 37 and vehicle safety appraisal and certification services as well as website-design services in class 42. The invalidity applicant is easyGroup Ltd, relying on its four earlier EU registrations for EASYCURRENCY, easyMoney, EASYGROUP and easyConveyance. The Applicant was put to proof of its claim of enhanced distinctiveness in respect of the earlier rights and neither party filed evidence in the proceedings.

COMPARISONS

The Hearing Officer (HO) swiftly dismissed the Applicant's claims that real-estate services in class 36 and travel and transport services in class 39 are similar to the range of services covered in the registration, dropping the easyMoney mark out of contention.

In comparing the marks, the HO commented that the ARNOLD CLARK element of the contested mark clearly carries more weight. Of the remaining earlier rights, EASYCURRENCY was selected as the strongest basis, so the HO assessed likelihood in respect of it. The HO reasoned that, with the inclusion of EASY as the single point of coincidence, the marks were visually and aurally dissimilar. Conceptually, both marks evoked an idea of convenient and/or straightforward payment, and the HO found the marks similar to a low to medium degree.

Since the Applicant did not substantiate its claim of enhanced distinctiveness in evidence,

the HO held EASYCURRENCY was low in distinctiveness for class 36 services, and of average distinctiveness for class 42 services.

EVIDENCE REQUIRED

Despite its submission that consumers are likely to expect a mark incorporating EASY PAY "to be part of the same stable of services" as the earlier marks, the Applicant did not claim a reputation or plead and demonstrate a family of marks exists. Citing *Il Ponte*, the HO recalled that even if no proof of use is required, where a family of marks is pleaded, use evidence of a sufficient number of marks needs to be filed to demonstrate a family exists for the purposes of assessing likelihood of confusion.

The HO instantly dismissed the possibility of a direct likelihood of confusion and focused on indirect confusion. She explained that the word "easy" is low in distinctiveness and "not one which the average consumer would expect to be exclusive to one undertaking". This, combined with the low visual and aural similarity,

was sufficient to offset the identical services, and no indirect likelihood of confusion was found. All grounds were dismissed and the invalidity failed.

“
Both marks evoked an idea of convenient and/or straightforward payment”

KEY POINTS

- ✦ Where a party pleads a family of marks for the purposes of assessing (indirect) likelihood of confusion, this needs to be supported in use evidence for a number of those marks
- ✦ Companies with a considerable suite of trade marks should not grow complacent when it comes to filing evidence in contentious proceedings
- ✦ Marks that are low in distinctiveness may have enforcement limitations, where enhanced distinctiveness cannot be shown



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Stay in your lane!

The Applicant's actions were naïve, but not an act of bad faith, reports Richard May

In April 2018, Tim Andrew (the Applicant), filed an application in the UK for ChefUber for recruitment-type services in class 35.

Uber Technologies, Inc (the Opponent) opposed the application under ss5(2)(b), 5(3) and 5(4)(a) and 3(6) of the Trade Marks Act 1994. The Opponent based the opposition on two UBER marks, several UBER-prefixed marks and its use of the sign UBER in the UK since 2012.

The Applicant made a number of points in defence, including the fact that ChefUber is a matching service for freelance chefs and hospitality establishments and the parties operate in different sectors.

The Hearing Officer (HO) considered s5(4)(a) first. The Opponent filed substantial evidence to support this ground and, inevitably, the HO concluded the Opponent generated a very strong goodwill associated with the name UBER in connection with its app and transport services.

The HO then had to decide whether this sector-specific goodwill was sufficiently strong enough to assert against an application covering non-competing services. In doing so, the HO applied the principles explored in *Harrods Ltd v Harrodian School* [1996] RPC 697 (CA) that, in a passing off case, what the claimant must prove is not the existence of a common field of activity but likely confusion among common customers of the parties.

STRONG GOODWILL

The Applicant described the services applied for as relating to a “matching service for freelance chefs and hospitality establishments” and it was also clear that the Applicant's intention was to mirror the way UBER operates. Importantly, the HO saw no reason why these services could not be offered through an app. On this basis, the HO concluded that the strong goodwill in UBER, together with the potential similarity in

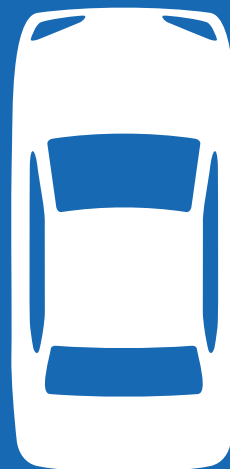
business model, will suggest to a substantial number of customers that ChefUber is a new venture being offered by Uber.

Interestingly, due to the strength of goodwill established by the Opponent, the HO accepted that this misrepresentation would apply to all the applied-for services, despite some relating to the recruitment of people other than chefs, and some being for recruitment consultancy services as opposed to recruitment per se.

REMAINING GROUNDS

The Opponent was also successful under ss5(2)(b) and 5(3), but not 3(6). In terms of the latter ground, while it was clear the Applicant knew of UBER and was attempting to inform customers that his services use a similar business method, there was insufficient evidence to find that the Applicant intended to mislead consumers. According to the HO, the Applicant's actions were naïve, but not an act of bad faith.

This case highlights the scope of protection afforded to household names in the UK. By filing strong evidence, the Opponent was able to rely on transport-sector goodwill to prevent the registration of a trade mark, which covered recruitment-sector services.



KEY POINTS

- ✦ In a passing off case, it is not necessary for the competing services to be similar
- ✦ For an actionable misrepresentation, it is enough if a substantial number of customers/potential customers are deceived into believing there is a common origin as a result of the marks used
- ✦ A sector-specific but strong goodwill is likely to result in a successful passing off action



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No gunk, no confusion

Caroline Phillips points out why the Fast Track is not always the best route

This case concerned a Fast Track opposition filed against the figurative mark NO GUNK NO JUNK (the Applicant's mark) for a wide variety of goods in classes 5, 29, 31 and 32 in the name of No Gunk No Junk Ltd.

The Applicant's Mark was opposed by The S&L Agency Ltd (S&L) based on a UK word mark NO GUNK, and two figurative marks, one registered in the UK and one in the EU, for NO GUNK JUST FUNK! covering cosmetic products and snack foods in classes 3 and 30 (the Opponent's Marks, shown below).

After finding a low to medium degree of similarity between some goods covered under the respective marks, the Hearing Officer (HO) compared the marks themselves. The HO found there to be varying degrees of similarity – primarily due to the common element NO GUNK – yet no confusion was found, and the opposition was ultimately dismissed.

REASONING RATIONALE

Why? In the HO's opinion, the common element NO GUNK is at the "low end" of the distinctiveness scale in relation to the goods where similarity was found, namely facial cleansers, herbal teas, nut-based foods, and beverages, on the basis that the term "alludes to goods that are in some way healthier, cleaner or free from chemicals and additives". In light of this, the Opponent's figurative marks were deemed to be distinctive only due to their stylisation and the device elements.

While there is some merit in these findings, the argument could of course be made that NO GUNK is a phrase that is used in common parlance in relation to products such as, for example, hair gel. However, it would seem more difficult to conclude that the term is inherently

weak in relation to goods such as nut-based foods. This was not, however, a nuance the Opponent highlighted during the Fast Track opposition proceedings, as no written submissions were filed by either party other than some basic arguments at the outset by the Opponent.

FUNDAMENTAL FAILURE

Fundamentally, the Opponent's case fell down due to the failure to demonstrate that NO GUNK should be deemed to perform an independent distinctive role in the Applicant's mark. Had submissions been filed to establish the inherent distinctiveness in this term, and indeed emphasise that NO GUNK was already a registered trade mark of its own right and should be considered *prima facie* distinctive, it is this author's view that there would have been a different outcome.

Trade mark owners should take note of this case when considering a possible opposition. While Fast Track

proceedings can be a quicker and cheaper way to bring an opposition, such a route can be risky, as there are fewer opportunities to influence the final outcome. It is also a stark reminder that the advice "you'll win as your mark is wholly contained within the Applicant's mark" needs to come with a caveat. Perhaps if the Opponent had representation, the outcome may have been different.

“

While Fast Track can be quicker and cheaper, such a route can be risky



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Co-authored by Ben Murphy, Trainee Trade Mark Attorney at Lane IP.

KEY POINTS

- + Conceptual, visual and aural similarity was found and yet the possibility of indirect confusion was ruled out
- + The common element of the mark was too weak to find likelihood of confusion
- + This decision shows the value of obtaining representation during opposition proceedings

MARKS

THE APPLICANT'S MARK

**NOGUNK
NO JUNK**

THE OPPONENT'S MARKS

NO GUNK

**NO GUNK
JUST FUNK!**



**NO GUNK
JUST FUNK!**

A world of pain

Pound for pound, an unrepresented Applicant was outmatched, writes Oliver Tidman

KEY POINTS

Always put an Opponent to proof of use when a mark is more than five years old

Visual, aural and conceptual differences between the marks were enough to avoid confusion for similar services

The Opponent successfully established that a reputation in POUNDLAND existed for almost all class 35 services and that a detrimental link would be made

On 27th September 2018, Vinod Chopra (the Applicant) applied to register the trade marks FIVEPOUNDWORLD and 5POUNDWORLD covering only class 35 services. The application was opposed by Poundland Ltd under ss5(2)(b) and 5(3) of the Trade Marks Act 1994, based on its earlier UK and EU trade marks for POUNDLAND covering, *inter alia*, class 35 services.

The Opponent claimed that a likelihood of confusion existed between the marks and that POUNDLAND has a reputation for all goods and services covered by its earlier marks. It also argued the Applicant's mark would take unfair advantage of and be detrimental to the repute and distinctive character of the POUNDLAND marks.

The unrepresented Applicant filed a counterstatement denying the grounds of

opposition without requiring the Opponent to provide proof of use of its marks. While the Applicant filed no evidence, the Opponent filed substantial evidence to support the reputation of its marks.

OPPOSITION FACTORS

The Hearing Officer (HO) found the marks to be visually and aurally similar to a low to medium degree and conceptually similar to a medium degree.

Assessing the inherent distinctiveness of the Opponent's marks, the HO recognised that although the conjoined words POUNDLAND allude to the characteristics of the services provided (retail services), the Opponent's mark had acquired distinctiveness through extensive use. The relevant consumer would have an average degree of attention depending on the particular goods and services.

Applying the principles discussed in *Meric*, the HO concluded that the goods and services varied from being identical to similar to a low degree, with the exception of those found to be dissimilar.

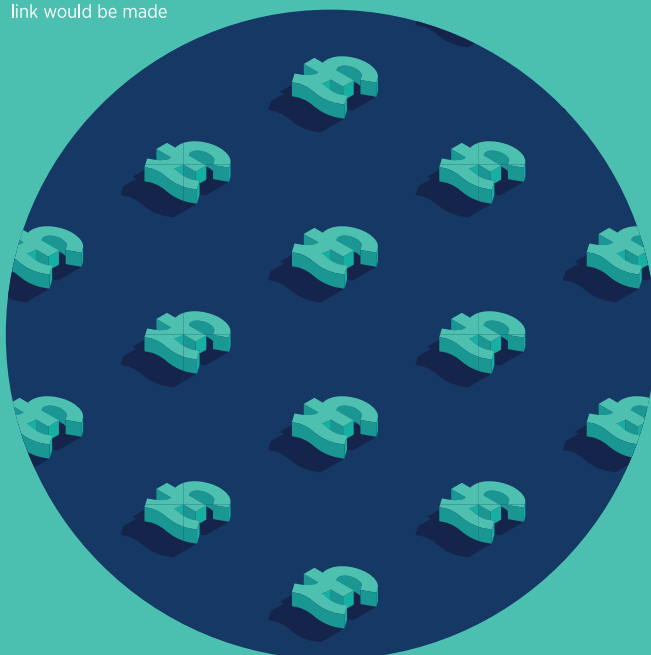
It was noted that consumers may regard the addition of the number 5 or FIVE as a reference to a shop selling goods at a higher price and the HO considered the change from the word LAND to WORLD would not be a natural brand variant for the Opponent.

EVIDENCE INFLUENTIAL

Notwithstanding the fact that the Opponent's marks had acquired distinctiveness, the visual, aural and conceptual differences were sufficient to counteract this and the HO concluded that there was no likelihood of either direct or indirect confusion under s5(2)(b).

However, the Opponent's evidence demonstrated that a significant section of the relevant public would make a link between the marks and therefore use of the Applicant's mark would take unfair advantage, and the Opponent successfully established a reputation for POUNDLAND for all the remaining class 35 services under s5(3).

Therefore, the Opponent was successful in blocking registration for all but services considered too far removed from its own (retail shop window display arrangement services).



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Virtual link was not realistic

Real evidence of reputation was just not provided, says Duncan Balloch

Laduma (the Applicant) is an immersive technology company with offices in the UK, the US, South Africa and Australia. It offers virtual reality (VR) solutions to businesses, including a VR experience it calls CaVRn. A 22ft-wide dome projects a 360° video from floor to ceiling with accompanying audio, allowing users to experience VR without a headset.

The Opponent, Cavern City Tours (Cavern) is a UK company that owns The Cavern Club, a venue in Liverpool known for its association with The Beatles.

In October 2017, Laduma applied to register the figurative UK trade mark The CAVRN in classes 35, 38 and 42. The application (in its entirety) was opposed by Cavern on the basis of ss5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994. In total, Cavern asserted rights in 11 prior registered trade marks as well as common law rights in two unregistered marks (all containing the CAVERN name).

In defending the opposition, Laduma denied all of the grounds asserted by Cavern, emphasising the differences between the marks and the differences between each party's goods and services. Laduma also put Cavern to proof of use in respect of three of its relied-upon marks and requested it show evidence of reputation and requisite goodwill in respect of all of the goods and services for which Cavern claimed under ss5(3) and 5(4).

HEARING AND EVIDENCE

An oral hearing took place in June 2019, at which both parties filed evidence and skeleton arguments. In total, Cavern filed five witness statements, with evidence including CDs, a history of the club, invoices and contracts relating to artist performances, details of published music by Cavern, computer game references and an iTunes report showing 300 downloads over five years under the Cavern Records label. The contracts and invoices provided did not show or contain the trade marks relied upon by Cavern. Further, there was no evidence put forward to show the sale of any CDs included in the list of 11 titles

produced by Cavern Records and only two of those titles were released within the relevant time period (for proof of use).

In fact, a large portion of the evidence submitted by Cavern only showed references to Cavern's marks instead of actual use in commerce.

Laduma submitted two witness statements and focused on contrasting the parties' businesses, where one brand self-described as "a contemporary live music venue" and the other "a specialised immersive technology consultancy".

Cavern relied on two trade mark registrations for the basis of its s5(2)(b) claim. The first was the UK trade mark CAVERN RECORDS in classes 9 and 41, which included audio-visual apparatus and its distribution. The second was the figurative EU trade mark for THE CAVERN CLUB LIVERPOOL Est. 1957 in a number of classes including class 35.

“ A large portion of the evidence submitted only showed references to marks instead of actual use

KEY POINTS

- + Evidence must show genuine trade mark use within the relevant period
- + 300 song downloads in five years may not be real commercial exploitation
- + Quality is more important than quantity

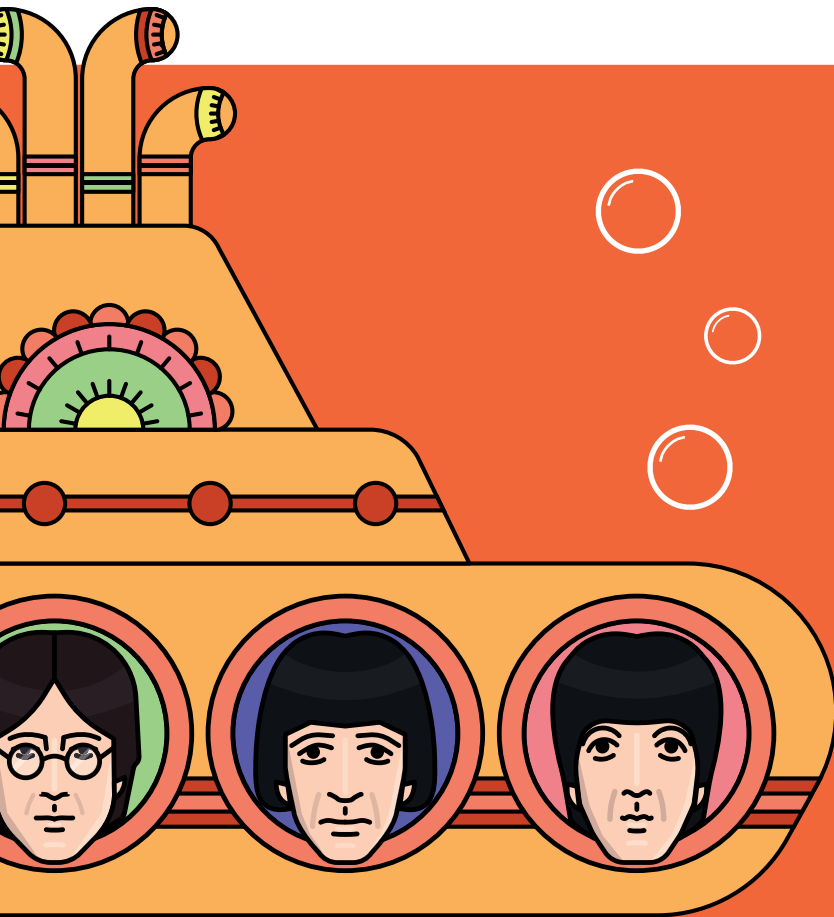
MARKS

THE APPLICANT'S FIGURATIVE MARK

The CAVRN

THE OPPONENT'S FIGURATIVE MARK





Cavern failed to prove genuine use of both prior marks. The Hearing Officer (HO) stated that the evidence presented during the relevant period for the UK mark was “extremely thin”. In relation to the EU mark, it was found that the average consumer would grasp that the mark signifies a club in Liverpool called Cavern. This would be differentiated by the Laduma mark, which has an emphasis on VR and a missing E.

The Tribunal held that despite the marks having some degree of similarity, most of the goods and services were dissimilar in nature, purpose, method of use and market distribution. It is important to note that some of the services in class 35 were identical, however the HO concluded that overall there was neither direct nor indirect likelihood of confusion taking all matters into account.

SECTION 5(3)

Along with the two marks already mentioned, Cavern also relied on a further four UK and five EU registrations for the basis of its s5(2)(b) claim, asserting a reputation in respect of each of the prior marks, which would lead the relevant public to believe Laduma’s trade mark was from the same or an economically connected undertaking to Cavern. These

included registrations for the word mark CAVERN CLUB, THE CAVERN and THE CAVERN CLUB, as well as a logo for THE CAVERN LIVERPOOL THE MOST FAMOUS CLUB IN THE WORLD in a number of classes.

It was accepted that Cavern’s evidence did show use and reputation in respect of a number of goods and services, including primarily those connected with clothing and nightclub services. However, in assessing whether a link to Cavern’s earlier marks would be raised in the minds of consumers upon seeing the later filed Laduma mark, the HO said no link would arise. In conclusion, the opposition under s5(3) failed.

SECTION 5(4)

The third claim was in relation to Cavern’s unregistered rights in the signs THE CAVERN and THE CAVERN CLUB. Cavern submitted they had been used since 1957 and had therefore acquired goodwill, including in relation to goods and services such as clothing, photographic and cinematographic apparatus, audio-visual reproduction in electronic and digital form, and entertainment services.

Once again, the HO criticised Cavern’s reputation evidence saying there were significant weaknesses. After its assessment of the evidence, the Tribunal found goodwill had only been established in relation to live music services, food and drink services, and clothing. The fields of activity were found to be so dissimilar that there could be no misrepresentation by Laduma, therefore the claim failed in its entirety.

Given Cavern’s assertion of 11 registered rights and two unregistered rights supported by five witness statements, the Tribunal awarded Laduma legal costs on the upper end of the scale.

QUALITY REQUIRED

This case illustrates that evidence quality is more important than quantity. Evidence should also show genuine trade mark use instead of merely referencing a mark. As anticipated, an abundance of documents referencing your mark alongside a famous rock band is unlikely to amount to sharing such a reputation.



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Monsters banished



Amelia Skelding reports that a big-name brand failed to scare off an application

Monster Energy Company (the Opponent) filed an opposition against EU trade mark (EUTM) application No 17866964 for REDMONSTER covering classes 16, 18, 21, 25, 35 and 41 in the name of Plus4U (the Applicant).

The opposition, directed against all goods and services, was based on various earlier EU and UK trade marks for MONSTER, MONSTER ENERGY and MONSTER REHAB spanning a number of classes, as well as non-registered UK trade marks (UKTMs) for MONSTER and MONSTER ENERGY used in relation to drinks. The Opponent invoked Articles 8(1)(b), 8(4) and 8(5) EUTMR.

For procedural efficiency, the Opposition Division (OD) based its initial assessment on EUTM registration No 9144536 for MONSTER in class 21 (Earlier Mark 1) and UK trade mark registration No 3254983 for MONSTER in classes 9, 16, 18, 25, 32, 35 and 41 (Earlier Mark 2) as these were most similar to the contested mark.

As the marks differed only by the addition of the term RED, they were held to be visually, aurally and conceptually similar to an average degree. However, the OD deemed it highly conceivable that the contested mark would be perceived as a sub-brand of the Opponent's family of marks. The Applicant argued that many other trade mark registrations that include the word MONSTER existed, but it was held that the register does not necessarily reflect the marketplace because it cannot be assumed that all registrations are in use.

Overall, the OD found that there was a likelihood of confusion. Accordingly, the contested mark was rejected for the goods

and services found to be identical or similar to those of Earlier Marks 1 and 2, but not for those found to be dissimilar.

The OD then assessed MONSTER ENERGY and MONSTER REHAB. The goods and services were identical, but the marks had sufficient differences, so the opposition under Article 8(1)(b) was rejected.

The Opponent failed to establish reputation because the marks were never used alone or in standard typeface, only in combination with a claw-like device, and the term MONSTER was always displayed in a highly stylised typeface. Consequently, the opposition based on Article 8(5) was refused.

The non-registered marks for MONSTER and MONSTER ENERGY were found to have been used in the course of trade in the UK in relation to drinks. However, the Article 8(4) ground failed because the goods and services applied for were sufficiently different to those on which the claim was based that there was no misrepresentation.

So, it seems that being a big-name brand is not always enough to find a likelihood of confusion if the mark or goods and services are sufficiently removed from those in which its owner enjoys fame.

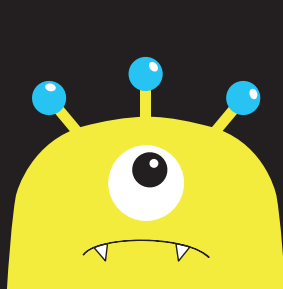
KEY POINTS

- ✦ The principle of interdependence played a pivotal role in finding a likelihood of confusion
- ✦ Evidence of reputation should not present use of a word mark with significant differences, such as prominent figurative elements and highly stylised typefaces



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No legal legacy

Richard Ferguson warns not to underestimate the value of a word mark

This case involved an opposition against an application for HERITAGE ART & DESIGN OF THE OLYMPIC GAMES (see image below) by Comité International Olympique (Association). The opposed goods were household and kitchen utensils and cleaning products in class 21. The application was partially opposed by Beko Plc (the Opponent) based on its registered rights in the word mark HERITAGE in class 11 for cookers and stoves, pursuant to Article 8(1)(b) EUTMR.

As the marks relied upon by the Opponent were more than five years old, the Applicant requested that the Opponent submit proof of use. The Opponent provided a relatively limited number of samples including brochures, online customer reviews, invoices and sales figures. While some of the evidence was dated outside the relevant period, the Examiner concluded that purchases of the relevant goods were made within the relevant period. Overall, the evidence submitted proved genuine use during the relevant period in the EU in relation to the goods at issue.

CONSERVATIVE COMPARISON

In considering a likelihood of confusion between the marks, the Examiner found “household or kitchen utensils and containers” confusingly similar on the basis that utensils, cooking pots, grills and steamers would all be aimed at the same public and serve the same or a similar purpose as cookers and stoves. However, no similarity was found with the cleaning materials. Although it was not fatal here, the assessment is arguably overly conservative, with there being a fine line of complementarity between pot and pan scrapers (utensils) and pan scourers, etc. (cleaning products).

Turning to the marks themselves, the Applicant submitted that HERITAGE was a very weak element, but this was given short shrift for the relevant goods, which were new and functional products. The Examiner dismissed (understandably) the ART & DESIGN OF THE OLYMPIC GAMES text element due to its weak distinctiveness and small size. However, the Examiner’s dismissal of the five interlaced rings of the Olympic flag is somewhat surprising.



RANK REDUCED

Given the very identifiable shape of the Olympic rings, their position at the start of the mark and larger size than the HERITAGE text, this author would have expected them to rank at least equally with the word element on a visual assessment. The marks were considered to be aurally and conceptually similar and a likelihood of confusion found.

Beko may have succeeded here, but it is conceivable that any party in receipt of such a decision could feel aggrieved by such conservative assessments on the complementarity of goods and the discounting of key brand elements such as the Olympic rings.

Decisions such as this reinforce the value of a word mark registration and the need for practitioners undertaking trade mark searches not to discount the risk posed by word marks where a client intends to add a house mark or other figurative element.

KEY POINTS

- ✦ Where it is submitted that a mark has a low level of distinctiveness, broad-brush statements alone are insufficient
- ✦ Beware discounting the risks posed by a word mark simply because a house mark or other well-known or distinctive figurative element is intended to be added to an application

MARK

THE APPLICANT'S MARK



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The power of suggestion

Even a slight link is enough to end evocation, reports Henry Schlaefli

The Applicant filed for a declaration of invalidity against the registration No 487637 for CREAM (covering “clothing for women”), invoking Article 59(1)(a) EUTMR, which was found to be descriptive under Article 7(1)(c).

The Applicant submitted sufficient evidence that at the time of filing the word CREAM was descriptive for clothing. This included extracts from dictionaries going as far back as 1991, and various extracts from publications showing examples of the word CREAM being used to describe coloured clothing.

COUNTER ARGUMENTS

The Proprietor’s counterarguments stated that the mark was suggestive or evocative and that the plurality of the meanings of CREAM implies that consumers are unlikely to perceive it as description of the goods. It referred to a Fourth Board of Appeal decision, which found that the word PINK was not descriptive for sunglasses, bags or bedding. It also submitted examples of registrations that had been accepted, and quoted the EUIPO’s guidelines, for example, the registration of “flamingo” for clothing. It also relied upon an earlier German Court decision that had found infringement of the registered trade mark for CREAM, arguing that the same subject matter had already been decided and could not be considered again by the EUIPO.

In the event that none of these arguments were sufficient the proprietor relied upon evidence of 20 years’ use and that the registration now had acquired distinctiveness.

EUIPO OUTCOME

The EUIPO found the mark to be descriptive for the goods in question for the English-speaking

countries. The Office did not go on to consider whether the mark was also non-distinctive or generic. The key points of law being that “it is sufficient that at least one of the possible meanings of a word sign designates a characteristic of the goods concerned” (C-344/07 FOCUS), which was the case here, and “the fact that a word might have different meanings in different context does not preclude the application of Article 7(1)(c)”, if one of the possible meanings is descriptive (T-278/09 GG).

The EUIPO also explained that “evocation is characterised by the absence of a sufficiently close link between the sign applied for and the relevant goods, so that it does not go beyond the lawful domain of suggestion”. The EUIPO highlighted that its guidelines are not binding legal acts for the purposes of interpreting provisions of EU law. It found as the German Court decision had not decided on validity of the mark but instead on infringement, there was presumed validity. It reiterated that national decisions, from a court or otherwise, have no binding effect on the Office since the EUTMR regime is independent of the national systems. In any case, the earlier national registrations were not in English-speaking countries.

On the question of acquired distinctiveness, despite showing extensive use in other Member States between 2010 and 2016, there was very little evidence concerning the English-speaking territory for which the objection applied. The Office therefore found no acquired distinctiveness for the relevant countries.

Note: at the time of writing, the decision had not been appealed

KEY POINTS

- ✦ Earlier EUIPO examination decisions, national office and national court decisions are likely to be of little persuasive value
- ✦ Evidence of acquired distinctiveness outside the countries where the objection bites is unlikely to be helpful



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Cloudy connection

Rebecca McBride sees the obvious problem with the evidence for cancellation

Clouds Sky GmbH (the Cancellation Applicant) sought invalidation of a figurative EU trade mark (the Mark) containing the words “Wi-Fi Powered by The Cloud”, in a cloud shape, for goods and services in classes 9, 28, 38 and 41. The contested mark was applied for in September 2010 and registered in February 2011 by The Cloud Networks Ltd (the Proprietor).

Clouds Sky GmbH filed a cancellation action in June 2016, in respect of all goods and services. It was unsuccessful in demonstrating that at the relevant date (the date of filing of the application) the Mark was descriptive and/or non-distinctive for the goods and services in question. Further, it did not consist exclusively of a sign that had become, before the date of application, customary in the current language or in the bona fide and established practices of the trade.

In its submissions, the Cancellation Applicant relied on a single Wikipedia extract dating from 2016 to demonstrate that “cloud computing” had existed since the 1970s (in other words, before the application date). It argued that the terms “The Cloud” and “Wi-Fi powered by” were inherently descriptive and that the composition of two English words for “The Cloud” corresponded with English grammar rules, having the effect that it would not communicate something different or unusual to its standard definition.

APPLICANT’S BURDEN

As the Mark was subject to a presumption of validity, the burden was on the Cancellation Applicant to demonstrate that the registration should be invalidated. Pursuant to Article 59(1) (a) EUTMR an EU trade mark shall be declared invalid where it has been registered contrary to the provisions of Article 7 EUTMR. The Board of Appeal (BoA) reached the decision that, as the Cancellation Applicant had submitted a single piece of evidence with limited value and – significantly – no evidence regarding the mark as a whole, the Cancellation Division had not

erred in rejecting the request for a declaration of invalidity.

LIMITED VALUE

In particular, the BoA noted that the position in relation to Wikipedia extracts has become more nuanced in recent General Court case law, in that the reliability of such evidence cannot be called into question by the mere fact that users can add new entries. However, it remains the case that such evidence has limited probative value, and it should generally be confirmatory, supporting other sources of information such as scientific studies and extracts from technical publications.

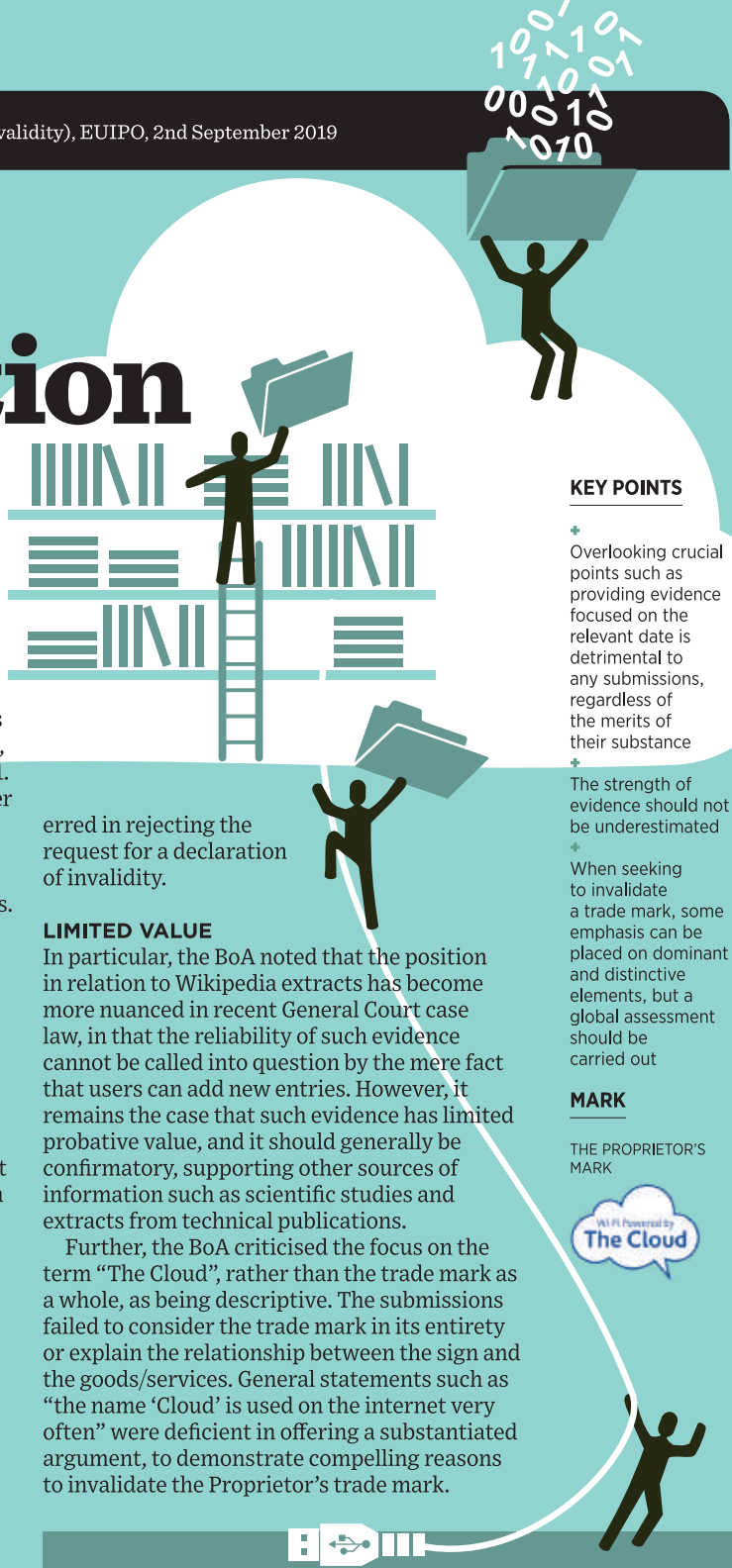
Further, the BoA criticised the focus on the term “The Cloud”, rather than the trade mark as a whole, as being descriptive. The submissions failed to consider the trade mark in its entirety or explain the relationship between the sign and the goods/services. General statements such as “the name ‘Cloud’ is used on the internet very often” were deficient in offering a substantiated argument, to demonstrate compelling reasons to invalidate the Proprietor’s trade mark.

KEY POINTS

- + Overlooking crucial points such as providing evidence focused on the relevant date is detrimental to any submissions, regardless of the merits of their substance
- + The strength of evidence should not be underestimated
- + When seeking to invalidate a trade mark, some emphasis can be placed on dominant and distinctive elements, but a global assessment should be carried out

MARK

THE PROPRIETOR’S MARK



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Oh Deere!

A famous name benefits from a procedural oversight, says Gavin Stenton

The EUIPO has determined an opposition brought by Deere & Company, manufacturer of agricultural, construction and forestry machinery (the Opponent), against an application filed by Jian Gui Zhao (the Applicant), for the mark shown below (the Application). The Application covered various leather goods in class 18, clothing in class 25 and toys and sports equipment in class 28. The Opponent opposed all the goods on the basis of an alleged likelihood of confusion with its senior EU registration for JOHN DEERE (word mark), pursuant to Article 8(1)(b) EUTMR.

The Opponent's JOHN DEERE registration covers goods and services in 21 classes. The Applicant sought to put the Opponent to proof of use of the class 18, 25 and 28 goods relied upon. However (and potentially crucially to the ultimate outcome), the Applicant's request was held to be inadmissible as it did not take the form of an unconditional request contained in a separate document (per article 10(1) EUTMDR). Though such a request may be filed simultaneously with other submissions, it must be contained on a separate sheet – including it under a separate section or header within general submissions is insufficient.

In the absence of a need to prove use, the vast majority of the goods applied for were held to be either identical or similar to the Opponent's goods. Where the Opponent's specification used expressions like “including” and “in particular”, the Office gave the preceding terms a broad interpretation, and held subsequent terms to be non-exhaustive examples (in contrast to its approach to terms such as “namely”, which indicate an exhaustive list).



“

The case hung on a comparison of the signs

the relevant public as either DEERC or DEERE. As a result and given the lower degree of attention that would be paid by the relevant public to the common forename JOHN, the signs were considered to be materially similar. The Office subsequently found there to be a likelihood of confusion (including that the Applicant's mark could be construed as a sub-brand of the Opponent) and the Opposition was thus upheld for almost all the goods.

This case is a stark reminder of the importance of fully complying with the EUIPO's procedural rules and guidelines in opposition proceedings.

The case therefore hung on a comparison of the signs. Here, the Office focused on the English-speaking public, on the basis that both signs could have conceptual meanings in English (“deere” being an alternative spelling for the word “deer”). The Office found that, due to its stylisation, the Applicant's sign might be interpreted by

KEY POINTS

✦ A request for proof of use in EU opposition proceedings must be made unconditionally and in a separate document to any other submissions

✦ When preparing specifications of goods and services, carefully consider clarifying terms such as “including” and “in particular”, in contrast to qualifying terms such as “namely”

MARK

THE APPLICATION

DEERC



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Yet-a-nother issue with a-porter

Upfront differences between marks may not prevent a likelihood of confusion, says Sarah Husslein

In this decision, the Opposition Division of the EUIPO (OD) found that an application for USED-A-PORTER should be refused under Article 8(1)(b) EUTMR.

Used A Porter International AB (the Applicant) hoped to register the word mark USED-A-PORTER for “mobile data communications apparatus” in class 9, “trinkets or jewellery” in class 14, “ready-made clothing” in class 25 and “sports and fitness” in class 41 (the Application). The Net-a-Porter Group (the Opponent) filed an opposition against all the goods and services, alleging a likelihood of confusion notably with the earlier EU trade mark registrations for NET-A-PORTER registered in relation to goods/services in classes 9, 14, 25 and 41 (the Earlier Marks). The Opponent also invoked Articles 8(4) and 8(5) EUTMR.

COMPARISON

Unsurprisingly, the OD considered the goods and services covered by the Application to be either identical or similar to those covered by the Earlier Marks.

Turning to the comparison of the marks, the Office decided to focus on the English-speaking part of the public. In view of the goods/services at issue, it considered that the relevant consumer will understand the element A-PORTER as an allusion to the French expression for ready-to-wear clothing (prêt-à-porter) used in the fashion industry.

Furthermore, the OD noted that NET will be understood as the short form of internet. Although the combination of words used in the Opponent’s mark involves a use of à-porter that does not comply with its traditional use in the fashion world, given the renown of the phrase “prêt-à-porter”, the consumer will necessarily see that ending as clearly alluding to that phrase. Therefore, the OD considered that this construction eliminates any allusiveness that may affect

its distinctiveness. Similar considerations also applied to the Application.

The Office noted that both signs show identical structure and length and will be pronounced with the same rhythm and intonation. It held that the marks were therefore visually and aurally similar. The OD considered the marks to be conceptually similar (although to a low degree) as they share a clever reference to the term prêt-à-porter.

FINDINGS

Overall, the OD found that the marks can easily be confused, particularly in light of the identical structure, their average distinctiveness and the similar length of their first verbal elements. Even if consumers do not confuse the marks, a likelihood of association exists, as consumers may think that the Application is a new version of the Earlier Marks designating a new range of products.

In view of the above, there is a likelihood of confusion on the part of the relevant English-speaking public, and therefore the opposition succeeded under Article 8(1)(b). The Office did not assess the other grounds of opposition.

The examination of the similarity between the marks must take into account the overall impression given by them, and differences between the first sections of the signs (which would generally have a substantial weight) may be incapable of negating a certain degree of similarities in the overall impression given by those signs as perceived by the relevant consumers.

KEY POINTS

- ✦ A-PORTER alludes to the French expression for ready-to-wear clothing, which will be understood by the English-speaking consumer
- ✦ A likelihood of confusion is possible even if the differences between the marks lie in their beginnings
- ✦ The EUIPO recalls the importance of the overall impression conveyed by the marks

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The Office decided to focus on the English-speaking part of the public



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defendant is established. The place where damage occurred will naturally be the Member State in which the trade mark is registered (see C-523/10 Wintersteiger AG v Products 4U Sondermaschinenbau BmbH). Therefore, HHJ Hacon found that AMS Neve was entitled to bring its claim for infringement of the UK national marks and passing off in the UK.

Perhaps surprisingly, the IPEC judge came to the opposite conclusion when assessing jurisdiction over the EUTM claim. Rather than Brussels I, this is governed by the EUTMR. A defendant may be sued in the Member State in which it is domiciled. However, under this regulation, the relevant exception to the general rule, set out in Article 97(5), provides that a claim may also be brought “in the courts of the Member State in which the act of infringement has been committed or threatened”. The judge noted that this is to be interpreted independently of the notion of “where the harmful event occurred” (under Brussels I) and considered relevant CJEU case law, in particular C-360/12 Coty Germany GmbH v First Note Perfumes NV [2014] E.T.M.R (Coty).

In Coty, the Advocate General (AG) had observed that “the place where the act of infringement was committed is a narrower concept than the place where the harmful event occurred” and “the vocabulary used in Article 93(5) seems to point to active conduct”. The CJEU agreed with the AG that the “linking factor relates to active conduct”. Applying this ratio to the present case, the IPEC judge found on the evidence that Heritage Audio had never supplied, nor actively advertised or offered to sell products in England, and therefore the UK court did not have jurisdiction.

CJEU

That decision was appealed. The Court of Appeal then referred a question to the CJEU on the interpretation of Article 97(5) – in essence, whether an EUTM infringement claim could be brought in the Member State in which consumers and traders targeted by the advertising and offers for sale are located, notwithstanding the fact that the defendant made decisions and took steps to bring about that electronic display in another Member State.

The CJEU clarified that Article 97(5) is intended to give proprietors a choice. It confers

jurisdiction only in respect of acts committed or threatened within the territory of the Member State in which the court is situated, whereas Article 97(1) confers jurisdiction to assess infringements throughout the EU. Therefore a proprietor can, in theory, elect to bring multiple actions, each constrained to acts of infringement within a single Member State.

When assessing its jurisdiction under Article 97(5), a Member State court must be satisfied that the allegedly infringing acts were committed within that territory. When the alleged acts are advertising and offering for sale, such acts are committed where the consumers to whom the adverts are “directed” are located, following the line of reasoning in C-324/09 L’Oreal and Others.

The CJEU made a series of observations to back this stance. If the L’Oreal approach were not followed, would-be infringers could seek to evade the rights of EUTM proprietors by establishing online adverts from other jurisdictions. There is also a practical rationale to this approach – it will be very difficult in many cases for a trade mark proprietor to establish where an infringer first made the decision and implemented the technical measures to activate an online advertisement.

The CJEU considered that, although they are independent, the concepts of “Member State in which the act of infringement has been committed” and “place where the harmful event occurred” must have a degree of consistency. An EUTM infringement claim may be brought in the Member State in which consumers to whom an online advert is directed are located, notwithstanding that the decision and act of placing such adverts was made in another Member State.

LIMITED OPTIONS

While claimants may often elect to bring claims within their “home” Member State, relying on Article 97(5) jurisdiction, the remedies available to them will be limited to the acts of infringement taking place within that territory (unless it is also the defendant’s domicile). This limitation should always be considered when deciding where to bring a claim. Notably, the CJEU’s judgment does not focus on the evidence required to show that an online advert is directed to the consumers of a particular Member State, as opposed to merely being accessible to such consumers. This remains an interesting dividing line, which will no doubt be stress-tested further.



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Choice words

Bonita Trimmer notes this CJEU clarification on jurisdiction

KEY POINTS

✦ In cases of online infringement, EUTM proprietors can elect to issue proceedings in the Member State in which the defendant is domiciled, or in which the consumers to whom the adverts are “directed” are located

✦ If the proprietor chooses the latter, the court’s jurisdiction and remedies available will be restricted to the particular acts of infringement within that jurisdiction

The CJEU has issued a judgment concerning the jurisdiction of Member State courts to decide cases of online EU trade mark (EUTM) infringement. It confirms the ability of brand owners combating online infringement to issue proceedings in the place of the defendant’s domicile or the Member State in which consumers targeted by the online adverts/offers for sale are located.

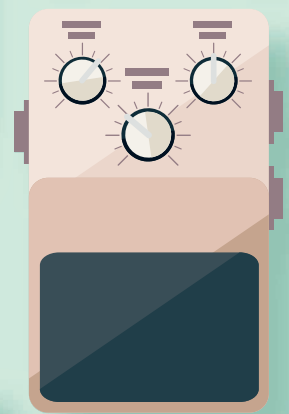
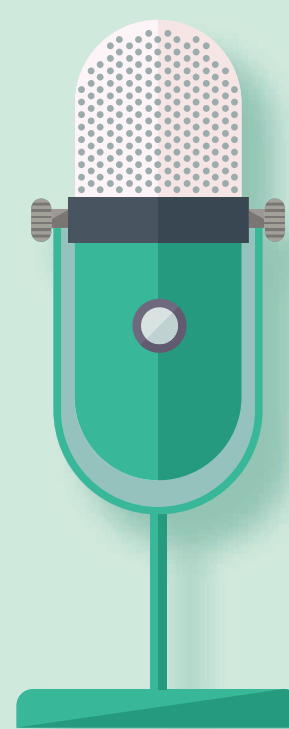
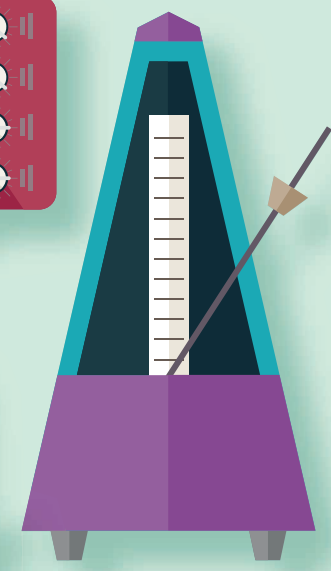
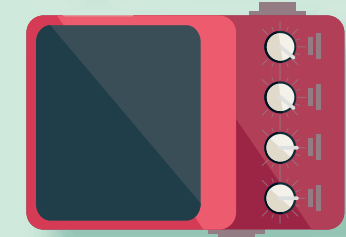
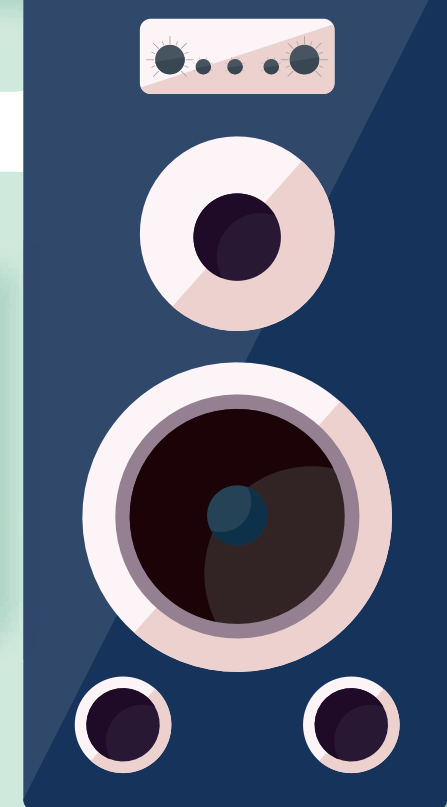
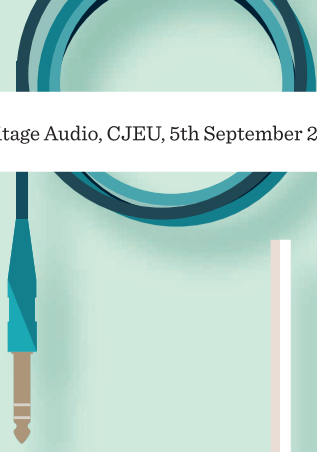
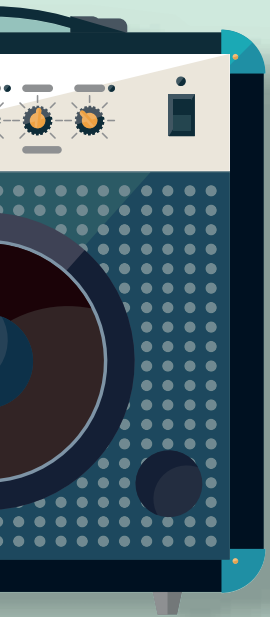
The Claimant, AMS Neve, is a UK-based manufacturer of audio equipment. It issued a claim in IPEC against Spanish company Heritage Audio, alleging infringement of an EUTM for the number combination 1073, as well as two UK device marks, all registered for class 9 goods associated with sound recording and processing. It also alleged passing off.

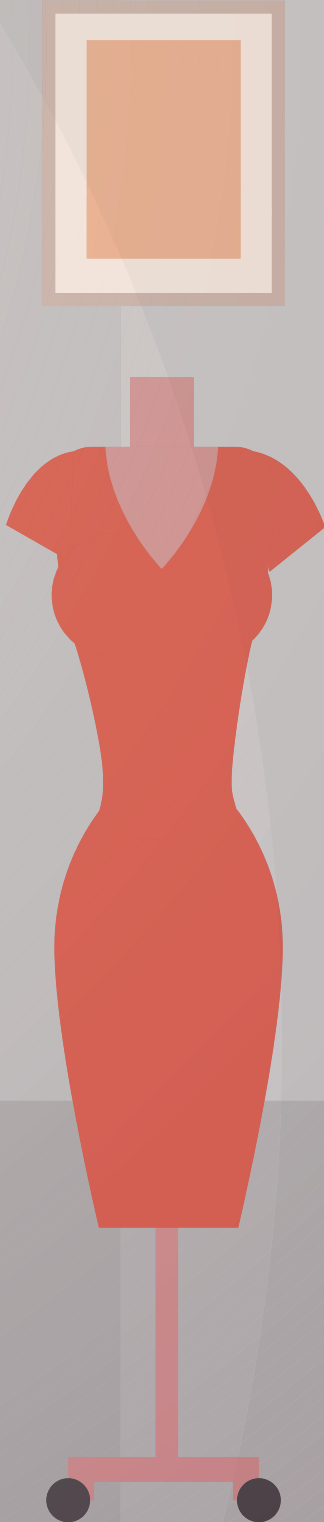
Heritage Audio had advertised and offered the allegedly infringing goods for sale on its website and social media. The offers for sale were worded in English and the website listed distributors established in various countries including the UK. AMS Neve alleged that these acts of advertising and offering for sale took place in the UK and other EU Member States. Heritage Audio did not deny that the products might be purchased in the UK, but said it had never made sales in the UK nor appointed a UK distributor, and it therefore challenged the UK court’s jurisdiction to hear the claim. The matter was first heard by His Honour Judge Hacon in October 2016. He dealt first with the UK-based rights, before turning to the EU mark.

BRUSSELS I

Jurisdiction of the court with regard to the UK-based rights is governed by EU Regulation No 1215/2012, often referred to as “Brussels I”. The general rule, stipulated at Article 4, is that a defendant shall be sued in its place of domicile. One of the exceptions to the general rule is given at Article 7(2), which provides that a defendant may be sued, in matters relating to tort, “where the harmful event occurred or may occur”. CJEU case law has established that this wording covers both the place of the event giving rise to the damage and the place where the damage occurred.

The event giving rise to the damage will often occur in the Member State in which the





KEY POINTS

Bad faith is not a simple yes or no answer – all facts and evidence must be analysed

Dissimilar goods/services may not overcome bad faith

MARKS

THE INTEVENER'S MARK



THE KOTON MARK



cancelled by a Spanish court in 2016. Koton's appeal against that decision is pending. However, the fact that Koton maintained its relationship with Mr Esteban despite the 2004 Spanish registration suggests that there cannot be bad faith. Finally, regarding the alleged error of law, this should be assessed on the grounds of likelihood of confusion.

Accordingly, Mr Esteban asked that the CJEU confirm the judgment under appeal and order Koton to pay costs.

CJEU FINDING

The CJEU held that, “[w]hile... the concept of ‘bad faith’ presupposes the presence of a dishonest state of mind or intention, that concept must moreover be understood in the context of trade mark law, which is that of the course of trade... Consequently, the absolute ground for invalidity referred to in Article 52(1)(b)...applies where it is apparent from relevant and consistent indicia that the proprietor of an EUTM has filed the application for registration of that mark not with the aim of engaging fairly in competition but with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, or with the intention 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, in particular the essential function of indicating origin...”

Essentially, bad faith and the intention of an Applicant is subjective and must be considered taking into account all of the circumstances relevant to the individual case. The GC should have taken account of the fact that Mr Esteban sought registration of a sign comprising the stylised word KOTON not only for services in class 39 but also in the remaining classes registered by Koton.

The CJEU set aside the GC judgment of 30th November 2017 and annulled the decision of the EUIPO of 14th June 2016. However, it rejected the claim that the contested mark be declared invalid as it is for a competent body of the EUIPO to adopt a new decision based on the comments made in the decision.

This case is a reminder that all facts and evidence must be taken into account when considering bad faith, not simply a likelihood of confusion. Accordingly, the fact that an application is filed in dissimilar goods/services is not enough to overcome a finding of bad faith. We now await the decision of the EUIPO regarding the invalidity of the contested mark.



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Maltese fight-on

The EUIPO will be the next to comment on the case of a contested Koton mark, writes Charlotte Wilding

Mr Nadal Esteban (the Intervener) applied for an EU trade mark (EUTM) application in classes 25, 35 and 39 on 25th April 2011 for the logo shown opposite. On 26th April 2011, Koton Mağazacılık Tekstil Sanayi ve Ticaret AŞ (Koton) filed a notice of opposition based on confusing similarity with its earlier Maltese trade mark registration in classes 25 and 35 and International Registration (see opposite), designating several Member States of the EU, in classes 18, 25 and 35.

The EUIPO upheld the opposition in respect of classes 25 and 35, but not class 39. This decision was later confirmed by the Fourth Board of Appeal (BoA), resulting in the contested mark registering in class 39 on 5th November 2014.

On 5th December 2014, Koton filed an application for a declaration of invalidity based on bad faith, given that Mr Esteban had a prior relationship with Koton. This was rejected by the Cancellation Division. Koton filed an appeal against this decision on 4th September 2015, which was dismissed by the Second BoA.

ANNULMENT SOUGHT

On 23rd September 2016, Koton sought the annulment of the above Second BoA decision and that the EUIPO be ordered to declare the registration of the contested mark invalid. Koton alleged infringement of Article 52(1)(b) (bad faith) claiming the BoA had been wrong to find that the goods or services covered by the marks at issue were required to be identical or similar for the purposes of applying that provision. The General Court (GC) dismissed the action for three reasons:

1. When interpreting Article 51(1)(b) in *Lindt*¹, the examples of factors to be considered when assessing bad faith were only examples and “account may also be taken of the commercial logic...” The GC held that the BoA had merely applied the case law.
2. The evidence provided by Koton, including the existence of an earlier business relationship between the parties and the presence of KOTON in the contested mark showed that Mr Esteban had knowledge of the earlier marks but not that he had a dishonest intention.
3. The contested mark was registered for dissimilar services, so there could be no likelihood of confusion.

On appeal, Koton relied on a single ground of appeal, alleging infringement of Article 52(1)(b), which was assessed in respect of the provisions of Regulation No 207/2009, as Regulation No 2017/1001 was not in force at the date of registration of the contested mark or date of the declaration of invalidity.

KOTON AND EUIPO

Koton argued that the GC erred in law by finding that the existence of bad faith presupposes that the contested mark is registered for identical or confusingly similar goods or services. This is not a requirement set out in the Regulation or case law. Further, the GC contradicted itself in stating that the factors listed in *Lindt* are only examples drawn from several factors.

Koton asked that the CJEU set aside the judgment under appeal, annul the decision at issue, declare the contested mark invalid and order both parties to pay costs.

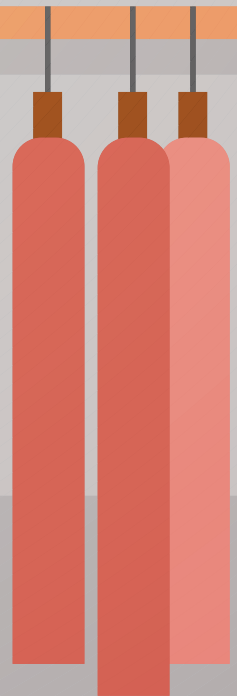
The EUIPO also contended that the BoA and GC erred in law and incorrectly applied Article 52(1)(b) but focusing on class 39. Instead, they should have considered Mr Esteban’s intention at the time of filing the application, which covered classes 25, 35 and 39. Further, they should have properly considered the fact that the mark contained KOTON and the figurative element of Koton.

The EUIPO asked that the CJEU grant the appeal and order both parties to pay costs.

MR ESTEBAN

Mr Esteban disputed any bad faith. He also claimed that the relationship with Koton ended in 2006 and concerned goods under a different mark. Furthermore, Mr Esteban registered a word and figurative mark containing KOTON in 2004 in Spain, which predated the International Registration of Koton resulting in the latter mark being

“ All facts and evidence must be taken into account when considering bad faith



Putting out the light

The Applicant was left in the dark, reports Rose Smalley



The **General Court (GC)** has rejected an appeal by SLL Service (the Applicant) against the Second Board of Appeal (BoA) decision to refuse registration of figurative mark LUMIN8 in classes 6, 19 and 20, following opposition by Elfa International, proprietor of an EU registration for word mark LUMI in identical classes, pursuant to Article 8(1)(b) EUTMR.

In the appeal, the parties accepted that the relevant public consisted of both building-sector professionals and DIY amateurs, paying an above-average level of attention. The similarity of the goods was also undisputed. Therefore, the decision turned on the similarity of the signs (visually, phonetically and conceptually), and the resultant likelihood of confusion.

ASSESSMENT

Visually, the GC endorsed the BoA's findings that the signs were similar to an average degree. It highlighted that the entirety of the earlier mark appeared in the Applicant's mark, and noted the identity of the first four letters. It remarked that consumers are likely to pay greater attention to the start of a word (in this case, the identical part), and that this was capable of diluting the attention paid to the remainder of the word. Neither the commonplace "8" nor minimalistic stylisation was deemed sufficient to outweigh these similarities.

Phonetically, the GC reinforced the BoA's judgment that the signs were similar to an average degree. The GC reiterated that the coinciding pronunciation of LUMI- could not be outweighed by the addition of N and 8. Further, the GC considered 8 had only a "normal degree of distinctiveness", conveying no specific

meaning or concept to the preceding LUMIN. The syllabic differences between the signs could not create a significantly different phonetic impression.

Conceptually, the GC remarked that at least some part of the relevant EU public would consider both "lumi" and "lumin" alluded to light (deriving from the Latin word "lumen") – even if not all of the relevant EU public spoke English or a Romance language. The GC noted it was sufficient to rely on only one part of the relevant EU public for a finding that the marks were similar, and concluded the signs were conceptually similar to a low degree.

CONFUSION LIKELY

Based on the above findings, being an average degree of visual and phonetic similarity, a low degree of conceptual similarity, plus similarity of goods and an unchallenged finding of the BoA that the earlier mark had a normal degree of distinctiveness, the GC held there was a likelihood of confusion, even when a higher level of attention is paid by the relevant public.

KEY POINTS

- ✦ Minimalistic and banal stylisation does little to reduce overall similarity
- ✦ Conceptual similarities perceived by only part of the relevant EU public can still be relied upon
- ✦ Where the start of two signs are visually and phonetically identical – particularly where the latter wholly contains the former – it will be difficult to demonstrate that such similarity would not lead to a likelihood of confusion

“
The decision turned on the similarity of the signs and the likelihood of confusion



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 Includes contribution by Lewis Sanderson,
 Trainee Solicitor at Womble Bond Dickinson.

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Events

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DATE	EVENT	LOCATION	CPD HOURS
6th December	CITMA Northern Christmas Lunch*	Browns, Leeds LS1	
13th December	CITMA London Christmas Lunch**	London Hilton on Park Lane, London W1	
16th January	CITMA Afternoon Seminar Accounts for non-accountants	PKF Littlejohn, London E14	2
24th January	CITMA Webinar	Log in online	1
11th February	CITMA Charity Quiz Night	Salsa! Temple, London WC2	
25th February	CITMA London Lecture+	Venue TBC	1
27th February	CITMA Paralegal Webinar+	Log in online	1
18th March	CITMA Welcome Drinks Reception*** Part of the CITMA Spring Conference	Brasserie Blanc Southbank, London SE1	
19th-20th March	CITMA Spring Conference***	IET London: Savoy Place, London WC2	9
19th March	CITMA Spring Conference Gala Dinner***	House of Commons, Palace of Westminster, London SW1	
25th March	CITMA, ITMA and CITMA Benevolent Fund AGM	London	

†DATE PROVISIONAL. VISIT CITMA.ORG.UK TO CONFIRM AND BOOK

SUGGESTIONS WELCOME

We have an excellent team of volunteers who organise our programme of events. However, we are always eager to hear from people who 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 Jane at jane@citma.org.uk with your ideas.

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THE TRADE MARK 20

Q&A

Khemi Salhan

aims to make herself indispensable

I work as... an Associate in the Gowling WLG IP team. My day-to-day routine primarily involves dealing with brand and design disputes.

Before this role, I was... a law student at Durham. Then I worked as a sales assistant in Selfridges while I was studying for my LPC.

My current state of mind is... calm. It's a Friday.

I became interested in IP when... I studied it in my final year at university. I liked the idea of trying to protect and reward creativity and innovation.

I am most inspired by... my dad. He's a criminal solicitor who set up his own practice at 27. Whenever I've had a long day, I think: "Well, at least I didn't have to go to a police station at 3am this morning."

In my role, I most enjoy... going to court. It's a culmination of all of your team's hard work over many months – your arguments are finally presented.

In my role, I most dislike... admin, for example file opening, conflicts and billing.

On my desk are... a Cadbury Flake, notebooks and perfume.

My favourite mug says... "Britney survived 2007. You can handle today."

My favourite place to visit on business is... a client's business. I



“

Whenever I've had a long day, I think: 'Well, at least I didn't have to go to a police station at 3am this morning'

love going to see how they work day to day. It always makes a change from an office.

The biggest challenge for IP is... trying to keep up with the way technology changes creative processes and innovation. And Brexit.

If I were a brand, I would be... Jaeger-LeCoultre (a luxury watchmaker): a bit fancy and difficult to pronounce. And perhaps always on time.

My ideal day would include... a lie-in, brunch, shopping, a nap and cocktails.

In my pocket is... my security pass and some lip balm.

I can't live without... a big jumper. I hate being cold.

The talent I wish I had is... being able to dance like a prima ballerina.

When I want to relax I... watch a *Poirot* with a cup of tea.

The best piece of advice I've been given is... make yourself so indispensable that they wonder how they did it without you.

In the next few years, I hope to... be a great solicitor.

The best thing about being a CITMA member is... meeting other people in the industry.



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Wishing you all a very

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and a Happy New Year!

*For all your attorney and support
needs, now or in the New Year,
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