

CITMA REVIEW

ISSUE 457 MAY 2020



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EXIT STRATEGY

*How we've kept IP at the
forefront of Brexit planning*



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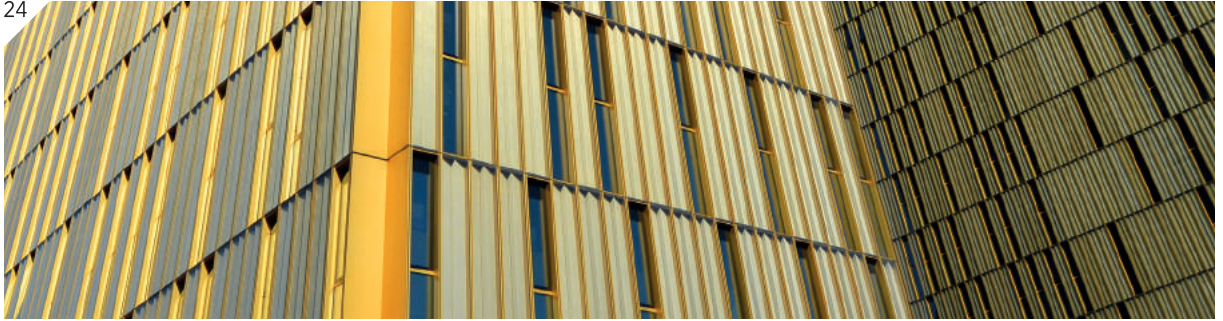
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CITMA REVIEW

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PRESIDENT'S WELCOME A NEW CHAPTER AND NEW CHALLENGES

It is with great pride that I step into the role of CITMA President. I would like to thank Tania Clark for leading the organisation so effectively over the past two years. Tania has done a fantastic job and always stepped up to a challenge, which is evident in our work on Brexit, diversity and the development of our events programme, among many other achievements.

I look forward to continuing our work in these key areas, with Brexit continuing to be a priority.

One of my goals as President is to look at how we can upskill the profession in line with our competency framework for Chartered Trade Mark Attorneys. I hope to develop a range of educational events to help you progress in key areas.

Our CITMA Paralegal membership base continues to grow year-on-year, and the importance of our CPD scheme will continue to rise. I will be looking at what we can do for CITMA Paralegals to bring further recognition to their work.

As we go to press, however, the outbreak of COVID-19 has brought normal life to a halt. Following the Government's advice, we have suspended all in-person events until the end of June. As such, I will be working hard with the Events Committee to make sure you have the CPD learning, development and networking opportunities you need.

In the meantime, we have launched a short survey to get your input on our three-year strategy. We want to hear about the challenges you face, what works well and ways you think that we can continue to develop and grow in the profession. Make sure you have your say before the survey closes on 7th May (see opposite).

This new chapter will bring opportunities and challenges, and I can confidently say that I am looking forward to all of it.

Richard Goddard, CITMA President



Council elections confirm additions to our leadership team

Twelve newly elected members joined our governing Council on 14th April, following the Council election at our AGM in March.

They take up roles on the 20-strong Council, which operates as our governing body, overseeing the business of the organisation. The

Council also formally admits new members of CITMA, makes the final decision on policy and sets our strategic direction.

The group includes two members who have been elected to Council for the first time – Daniel Hardman-Smart (Stobbs IP) and Catherine Wiseman (Barker Brettell) – plus 10 re-elected members.

Newly elected:

Ese Akpogheneta, *BATMark*
Oscar Benito, *GSK*
Mark Foreman,
Osborne Clarke
Richard Goddard, *BP*
Daniel Hardman-Smart,
Stobbs IP
Sanjay Kapur,
Potter Clarkson

Chris McLeod,
Elkington + Fife
Kate O'Rourke,
Mewburn Ellis
Maggie Ramage,
Edwin Coe
Kelly Saliger, *CMS*
Rachel Wilkinson-Duffy,
Baker McKenzie
Catherine Wiseman,
Barker Brettell

OUR EVENTS ARE MOVING ONLINE

Like many organisations at this time, we are moving our events programme online to give continuity for your CPD. See page 41 for details.



New President

Our new President, Richard Goddard, was elected by the Council on 14th April. He has been a CITMA member since 2003 and has been on the governing Council for 10 years.

Richard has led a number of working groups and committees, including the Diversity and Inclusion working group, and currently heads the International Liaison working group. To find the full election results, visit citma.org.uk/about-us/governance

Student and Paralegal representatives

New student and CITMA Paralegal representatives have also been elected to join our Council, each for a two-year term. **Eve Brown**, a trainee from Marks & Clerk, is the new student representative, succeeding Becky Knott (Barker Brettell).

Meanwhile, **Kane Ridley** from Keltie has been elected as the new CITMA Paralegal



Eve Brown and Kane Ridley, the student and CITMA Paralegal representatives

representative, succeeding Rebecca McBride (Mishcon de Reya).

Both Eve and Kane will sit on the Council to help shape the future of CITMA and the wider intellectual property community.

The student and CITMA Paralegal positions are designed to offer greater diversity and a fairer representation of the membership on the Council. Although the representatives have no formal voting rights, they will engage with and be able to directly influence the discussions and decision-making process.

RICHARD TOWNSHEND



NEW MINISTER FOR IP NAMED

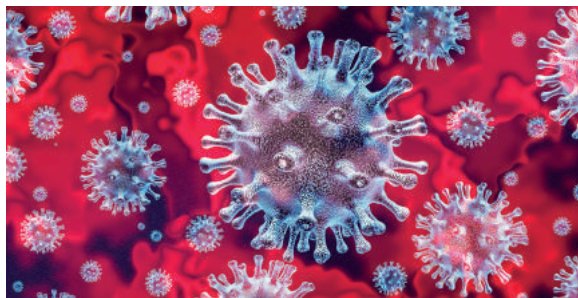
Amanda Solloway MP is the new Minister for Intellectual Property, holding a more focused portfolio than previous incumbents. The MP for Derby North takes up the role as part of her portfolio as the Parliamentary Under Secretary of State for Science, Research and Innovation.

THE COVID-19 CRISIS: WHAT WE'RE DOING

Since the outbreak of COVID-19, we have been closely monitoring the situation and assessing what this means for us, our members, staff and the events we run.

With all staff working from home, we are operating as business as usual, with the exception of the suspension of all in-person events.

We are continuing to fight for you during these uncertain times. If you are facing problems related to COVID-19, please email tm@citma.org.uk



SHAPE THE FUTURE OF YOUR PROFESSION

As mentioned in the President's Welcome, there is still time to take part in a survey of CITMA members and tell us your priorities for our profession. The survey is open to all members and closes on 7th May. To take part, visit surveymonkey.co.uk/r/3DF33TL



REMEMBERING BRIAN MARCH

Senior members of the CITMA community offer their reflections on the life of a respected colleague

“At the Institute’s annual dinner and dance in April 1981, Brian March [pictured above, left] was presented with a copy of *The Times Atlas* as his prize of choice for having achieved the highest mark in the Entrance Examination 1980,” recalls Chartered Trade Mark Attorney and former CITMA President Keith Havelock. “Thus began a distinguished career, as well as a growing interest in and connection with the Institute, in which he was to play a leading part in the years ahead.”

Brian spent the whole of his career with his family firm, Wildbore & Gibbons, operating out of the City of London. Its clientele included household names in the wine and spirits field, among many others.

Brian was the great-great-nephew of one of the firm’s founders, Benjamin Wildbore, and his father Eric was also a leading member of the firm for many years.

By 1987, Brian had become sole principal of the firm. “He confessed to a friend at the time of the firm’s centenary that in virtually every decision he took as principal, he always considered how his father would have reacted,” Havelock says.

Elected to the Council of the Institute in 1987, Brian went on to become President in 1998. His term was notable in many ways, Havelock

notes. “He led a delegation to Parliament that gave evidence as part of a Department of Trade and Industry inquiry into Trading, Trade Marks and Competition; he was instrumental in bringing about the Institute’s change of name to include the word ‘Attorneys’; he arranged for every annual dinner and dance he presided over to be entertained by the Band of the Royal Engineers; and he represented the Institute on the Standing Advisory Committee on Industrial Property (SACIP) on many occasions. Also, amusingly, his picture as President was published in the *Daily Mail* against a backdrop of the lights of Piccadilly Circus with his comments on trade mark issues of the day.”

Havelock remembers Brian as a “devoted family man and supporter of Arsenal FC”. “His retirement party in 2010 was held in a private box at Highbury. In a speech on that occasion, Brian was warmly thanked

for his outstanding contribution to his profession, his unflinching courtesy and his much-valued friendship.

“Sadly, Brian’s retirement was dogged with ill health, and his premature death in March will cause widespread regret. However, his memory will be held in deep respect and affection by his many friends.”

Another former CITMA President, Chris McLeod, also remembers Brian fondly. “Brian and I went back quite a long way,” he says. In the late 1980s, McLeod worked at the Trade Marks Directory Service (TMDS) when it was based in Hatton Garden. “The firm was owned by Wildbore & Gibbons, and I remember being slightly scared when I was told that Mr March was coming in to make an announcement.”

When Brian arrived, “his warmth and openness came through as he informed us that they were selling part of the company to CPA, but that it was business as normal”.

“Our paths crossed many times over the years,” McLeod recalls, “including the two years I spent working at Wildbore & Gibbons, during which I could always rely on Brian for a clear view and some light relief, sometimes at the expense of my football team. I echo Keith’s sentiments and will always remember Brian fondly.”

“

*You could always
rely on Brian for
a clear view and
some light relief*

2019 TOP 19 FILERS

The CITMA Review has completed its annual investigation of filing data for the past calendar year to provide details of the top UK-based filers of UK and EU trade marks

DATA COLLECTION DETAILS

Data provided by Corsearch. Figures represent filers that are the current UK agents for UK or EU trade marks for which applications were made in the 2019 calendar year. Figures do not include WIPO-designated filings, corporate filers or representatives of single corporate entities. Where firms have acquired other firms during the year, the full representation of filings may not be captured. Where firms have multiple IPO accounts under different naming conventions, we cannot guarantee complete representation. Where entities are tied, they are ranked in alphabetical order. Figures should not be relied on for official reporting, marketing, advertising or publicity purposes. Neither CITMA nor the *CITMA Review* can accept responsibility for errors and omissions, notably where an individual practising at a firm is listed individually.

With thanks to Chris McLeod, Chartered Trade Mark Attorney and Partner at Elkington + Fife, and a member of the *CITMA Review* working group, who reviewed the Corsearch data.

TOP 100 UK TRADE MARK FILERS 2019

	Name	Filings		Name	Filings
1	Marks & Clerk	763	51	Nucleus IP	163
2	Stobbs IP	666	52	Sheridans	155
3	Murgitroyd & Company	644	53	DLA Piper UK	152
4	HGF	621	=	Wiggin LLP	152
5	Barker Brettell	612	55	Trade Mark Direct	151
6	Trademark Eagle	610	56	Sipara	150
7	D Young & Co	582	57	Lawrie IP	143
8	Wilson Gunn	567	=	Novagraaf UK	143
9	Bird & Bird	510	59	The Trade Marks Bureau	139
10	Forresters	492	60	Stratagem IPM	138
11	Trade Mark Wizards	487	61	Simmons & Simmons	136
12	Fieldfisher	485	62	Agile IP	131
13	Boult Wade Tennant	458	63	Bailey Walsh & Co	130
14	UDL	415	64	Stephens Scown	129
15	Haseltine Lake Kempner	372	65	Bates Wells & Braithwaite	128
16	Withers & Rogers	350	66	Carpmaels & Ransford	126
17	Cleveland Scott York	341	=	Maucher Jenkins	126
18	Appleyard Lees	337	68	Ashfords	122
19	Groom Wilkes & Wright	320	=	Dollemores	122
20	Lewis Silkin	310	=	Womble Bond Dickinson	122
21	Kilburn & Strode	304	71	RevoMark	120
22	JA Kemp	298	72	Osborne Clarke	119
23	Potter Clarkson	290	73	Katarzyna Eliza Binder-Sony (LegalForce RAPC Worldwide)	118
24	Swindell & Pearson	287	74	Hogan Lovells	117
25	Keltie	281	75	Handsome IP	115
26	Baker McKenzie	274	76	ip21	112
27	Lane IP	270	=	Squire Patton Boggs	112
28	Colman and Smart	268	78	Sandersons	111
29	Albright IP	263	79	Edwin Coe	110
=	Briffa	263	=	Fox Williams	110
31	Mewburn Ellis	262	81	Lincoln IP	107
32	Beck Greener	260	82	Penningtons Manches Cooper	105
33	Mathys & Squire	256	83	Ward Trade Marks	104
34	Dehns	249	84	Pinsent Masons	102
35	Gill Jennings & Every	248	85	Dummett Copp	101
36	CMS Cameron McKenna Nabarro Olswang	245	86	Bristows	100
37	TrademarkIt	233	=	Dennemeyer & Associates	100
38	FRKelly	212	88	Laytons	98
39	Taylor Wessing	210	89	WP Thompson	96
40	Elkington + Fife	204	90	Bonamark	94
41	Cooley (UK)	194	91	Cam Trade Marks & IP Services	93
42	Abel & Imray	192	92	MARCARIA.COM	92
43	AA Thornton	188	93	Freeths	89
=	Stevens Hewlett & Perkins	188	94	Harrison IP	88
45	TM4U	185	95	Brookes IP	86
46	Page White & Farrer	184	96	Burges Salmon	85
47	Venner Shipley	173	97	Brand Protect	83
48	Reddie & Grose	170	98	Eversheds Sutherland	80
49	Wynne-Jones	168	=	Mills & Reeve	80
50	Mishcon de Reya	166	100	Trademark Brothers	77

TOP 100 EU TRADE MARK FILERS 2019



	Name	Filings			Filings
1	HGF	904	52	Osborne Clarke	116
2	Lane IP	796	53	Bailey Walsh & Co	114
3	Stobbs IP	794	54	JA Kemp	108
4	Marks & Clerk	790	55	Keystone Law	102
5	Bird & Bird	584	=	Laytons	102
6	Cooley (UK)	508	=	Sonder IP	102
7	Baker McKenzie	474	58	Dollemores	100
8	Murgitroyd & Company	468	=	Elkington + Fife	100
9	Mewburn Ellis	466	=	Stephens Scown	100
10	Cleveland Scott York	444	61	Lincoln IP	98
11	Withers & Rogers	396	=	Squire Patton Boggs	98
12	Haseltine Lake Kempner	388	63	The Trade Marks Bureau	96
13	UDL	356	64	Lawrie IP	94
14	Beck Greener	344	=	Shoosmiths	94
15	Albright IP	316	66	Norton Rose Fulbright	90
16	Taylor Wessing	310	67	Colman and Smart	88
17	Wilson Gunn	302	68	Dechert	86
18	Potter Clarkson	298	=	Joshi Worldwide	86
19	Groom Wilkes & Wright	294	70	Dummett Copp	84
20	Mishcon de Reya	278	=	EIP	84
=	Trade Mark Direct	278	72	Clarion Solicitors	82
22	Dehns	264	73	Baron Warren Redfern	80
23	Sheridans	254	=	Filemot Technology Law	80
24	Mathys & Squire	238	=	K&L Gates	80
=	Trademark Eagle	238	76	Bear & Wolf IP	78
26	Sipara	230	=	Irwin Mitchell	78
27	Appleyard Lees	224	78	Cam Trade Marks & IP Services	76
28	Lewis Silkin	220	=	Trade Mark Wizards	76
29	DLA Piper	210	=	Wynne-Jones	76
30	Venner Shipley	202	81	Oakleigh IP Services	74
31	Reddie & Grose	198	=	Pinsent Masons	74
32	AA Thornton	190	83	Brabners	72
33	Swindell & Pearson	182	84	Trademarkroom	70
34	RevoMark	178	85	Penningtons Manches Cooper	66
35	Simmons & Simmons	174	=	BDB Pitmans	66
=	Womble Bond Dickinson	174	=	Blake Morgan	66
37	Locke Lord	172	=	Clarke Willmott	66
38	Ladas & Parry	166	=	Withers Worldwide	66
39	Page White & Farrer	164	90	Indelible IP	62
40	Harrison Ip Limited	160	91	Freeths	60
41	Allen & Overy	154	=	Harper Macleod	60
42	WP Thompson	152	=	Maguire Boss	60
43	Fox Williams	150	=	Sandersons	60
44	Abel & Imray	148	95	Edwin Coe	58
45	Stevens Hewlett & Perkins	134	=	Nucleus IP	58
=	Stratagem IPM	134	=	Ward Trade Marks	58
47	Finnegan Europe	130	98	Bromhead Johnson	56
48	Carpmaels & Ransford	126	=	NJ Akers & Co	56
=	Hansel Henson	126	100	Brown Rudnick	54
50	Ashfords	122	=	Clifford Chance	54
51	Bristows	118	=	Harbottle & Lewis	54



BREXIT OUR PATH TO PROTECTING THE PROFESSION

Richard Hayward takes us through the timeline of CITMA’s work to keep IP at the forefront of Brexit planning

Ever since the EU referendum result was announced in June 2016, we have taken a lead on developing options and solutions for the future of IP in the UK. It has been a long process – and we have been there every step of the way, engaging with the people that matter to fight for the best possible outcome.



2016



23rd June 2016
EU referendum vote held, resulting in the decision to leave



JUNE 2016 VITAL PREPARATION

“In the run-up to the referendum, we were ready for either remain or leave winning,” recalls Keven Bader, CITMA’s Chief Executive (right). “We had full statements prepared, ready to send to the media whichever outcome prevailed. We didn’t think we’d need the leave one, but I was glad we had both covered.”



“We made sure that we were ready to act and build a campaign to ensure we were fighting for the best outcome from Brexit for our members and business.”

As it happened, our leave statement detailed that we wanted to “ensure the best possible outcome for members, owners of intellectual property rights and practitioners in the UK”. We also called on the UK Government to ensure rights of representation and a simple and cost-effective transition for the continued protection of EU IP rights in the UK.

A pre-referendum briefing was sent to members in March 2016, so we had already scoped out what we could expect if the leave outcome came to pass.

JULY AND AUGUST 2016 SCENARIO PLANNING

Our Brexit task force first met on **12th July**. It was made up of a range of senior trade mark professionals from across the sector.

We wanted to ensure our next steps were as practical as possible, and we knew we had to work quickly to help set the agenda for what was to come over the years ahead.

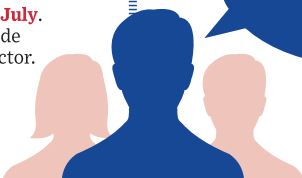
The task force came up with seven possible scenarios – all with pros and cons mapped out. Importantly, we agreed that we favoured “an outcome which minimises the cost and resource burden to business while maximising legal certainty”.

We presented this thinking to the Minister for IP at a meeting in July and shared it with the UK IPO, EUIPO and other stakeholders.

NOVEMBER 2016 SPREADING OUR MESSAGE

It was important to share the message that it was “business as usual” in the UK and that we were actively involved in discussions to ensure the best outcome. A ‘TECH Summit’ offered an opportunity to do so in India. There, CITMA President Kate O’Rourke joined Jo Johnson on a panel to discuss IP rights in a globalised world. We also spoke at the Global IP Summit in Brussels in December.

12th JULY 2016
FIRST CITMA
BREXIT TASK FORCE
MEETING



JANUARY 2017

REFINING OUR SCENARIOS

By now, our **seven scenarios** had become the benchmark for how EU trade marks and registered community designs should be handled in the UK post-Brexit. We had detailed discussions on them with the UK IPO, who showed interest.

From our discussions with members, the UK IPO and other stakeholders, two models emerged as the preferred scenarios: 'Tuvalu' and 'Montenegro'. These scenarios were updated to provide a greater level of detail and to revisit the pros and cons.

MARCH 2017

MEETING IP MINISTER

As Prime Minister Theresa May's letter to Brussels officially triggered the exit process (with an expected UK leave date of 29th March 2019), we had a range of important meetings with Jo Johnson, by then the Minister for IP, on registered and unregistered rights post-Brexit. We brought up the desirability of mutual recognition of professional qualifications, with possible loss of earnings for IP professionals catching the Minister's interest.

We also presented and discussed our updated thinking on the 'Montenegro' and 'Tuvalu' models with the UK IPO and shared some of the concerns and considerations that the UK IPO should take into account when formulating the planned way forward for the continued protection of EU IP rights in the UK.

APRIL 2017

INTERNATIONAL OPPORTUNITIES

Taking our message around Europe and the world, we attended and spoke at the World IP Forum in Bangalore, the CNIPA Conference in Munich and ECTA in Budapest, among many others. We also welcomed a delegation to the UK from IPIC, Canada.

JUNE 2017

MEETING WITH THE EUROPEAN COMMISSION

We took our scenarios to Brussels and met François Arbault, part of the EU's Brexit negotiation team. Kate O'Rourke (pictured below, top) and Tania Clark met with Mr Arbault, who was joined by IP specialists including Thomas Eichenberg, who had worked on the most recent EU trade mark regulation. Also attending were representatives from INTA, Business Europe, AIM, MARQUES, APRAM, and UNION-IP.

"The Commission officials were very well briefed and delved into detail about a number of items, including rights of representation, exhaustion of rights, enforcement and goods in transit – all of which we were able to input on," said Kate.



JULY 2017

MAKING THE CASE FOR MONTENEGRO

To make our arguments on rights of representation and registered rights clear, we published our official position paper. It offered solutions that would set the tone for our future work and provided a clear steer to the UK Government and other stakeholders as to what the trade mark legal profession was calling for.

We set out why UK Chartered Trade Mark Attorneys being granted continuation of rights of representation at the EUIPO would benefit business and ensure the continued strength of the UK IP professions.

On registered rights, we argued that our 'Montenegro' model would be the most practical solution if the UK was not going to continue as part of the EUTM and RCD systems. The 'Montenegro' model would see automatic entry of all EUTMs and RCDs onto the UK IPO register with the same scope of protection, registration date and, where applicable, priority and seniority as the existing EU registration.

We also set out our view on a number of issues that would affect registered rights, including intent to use, seniority and pending applications.

We had the opportunity to share our latest thinking with business at the Institute of Directors' Brexit Seminar, with Kate O'Rourke speaking to an engaged audience that included business leaders and government officials.

SEPTEMBER 2017

INTERNATIONAL OUTREACH CONTINUES

The diaries of our officers were packed with engagements across Europe as we continued to attend meetings and speak at key events in the IP calendar, including the APRAM Conference in Paris, the UK-China IP Symposium, GRUR in Hamburg and BMM in Brussels and Rotterdam.

APRAM CONFERENCE



OCTOBER 2017

DIT DISCUSSION

The future relationship between the UK and EU will in large part be down to future trade negotiations. Our engagement with the Department for International Trade (DIT) has played an important part in ensuring our message reached all the areas of Government it needed to.

NOVEMBER 2017

A UNITED VOICE

We, along with the Law Society, the Intellectual Property Bar Association, the IP Federation and CIPA, wrote a joint letter to the Lord Chancellor's Brexit Law Committee. It outlined key considerations and recommendations that the UK Government must consider in relation to intellectual property following the UK's exit from the EU. We again showed a united voice across the IP legal profession.

2017

17th January 2017
Theresa May sets out the priorities for the UK's Brexit negotiations

29th March 2017
UK triggers Article 50, with its exit set for 29th March 2019

ARTICLE

50

£789
MILLION

DECEMBER 2017 ESTABLISHING EVIDENCE

To make our argument politically for the views and solutions proposed in our position paper, we needed to build an evidence base to take our argument to those who could influence the outcome.

We enlisted the help of public affairs agency Freshwater to put together a business case to take to MPs, the UK IPO and other key stakeholders. With the assistance of an economist, we brought together a compelling set of statistics to build our narrative around.

We found that UK Chartered Trade Mark Attorneys represented a quarter of all EUTMs and over half of all trade marks held by US-based entities. We estimated that the financial cost of losing this work would be in excess of £789m, including the knock-on impact.

We set out our six key messages for the UK Government:

- 1 The cost to UK businesses could be hugely significant, as they look to make sure their products and services are still protected through registration in the EU. The Government needs to confirm the continuation of registered protection.
- 2 CTMAs losing the right to represent clients at the EUIPO would have a significant negative effect on the industry, as well as on the wider business community as a whole, resulting in a contraction of the profession and increased costs to UK plc.
- 3 CTMAs lead the world in representing non-EU organisations at the EUIPO, particularly firms from the US. These vital commercial relationships are seriously endangered by ongoing uncertainty and the potential future loss of rights of representation.
- 4 The businesses within the CTMA profession not only stand to lose a significant amount of income from filing fees, but also from associated income linked to their work with EUTMs and RCDs.
- 5 The UK Government must act to make sure that CTMAs retain their current EUIPO rights of representation post-Brexit.
- 6 The UK Government must provide certainty on its commitment to the UK's trade mark and wider legal and IP sectors to mitigate the loss of business to EU-based competitors before Brexit takes place.

JANUARY 2018 TAKING OUR CASE TO MPs

Members contacted some 100 MPs to outline our evidence. This led to a number of follow-up meetings between members and their MPs to discuss the future of IP post-Brexit, including meetings with Hilary Benn, then Chair of the Exiting the European Union Committee, Anna Soubry and Bill Esterson, then Shadow Minister for IP.

We also met with two members of the All-Party Parliamentary Group for IP: Baroness Neville-Rolfe and Lord Clement-Jones.

Several MPs subsequently asked parliamentary questions on our behalf, which all received responses from ministers.

MARCH 2018 UK AIMS FOR MONTENEGRO MODEL

The UK Government confirmed that it would pursue a version of our 'Montenegro' model and grant all holders of EU trade marks and registered community designs an equivalent UK right upon Brexit. This long-awaited confirmation was timely, as we had meetings with senior UK IPO officials and with the then Minister for IP, Sam Gyimah, in the following two weeks.

We also joined forces with a number of European IP organisations to issue a joint statement to the European Commission following the publication of its draft Withdrawal Agreement and the ongoing negotiations between the EU and UK. The statement, signed by AIM, APRAM, BMM, CITMA, ECTA, INTA and MARQUES, set out proposed solutions to some of the issues posed by IP post-Brexit. These included registered rights, exhaustion, the use requirement and rights of representation.

CITMA President Kate O'Rourke said: "It was important to show there is agreement across a number of organisations on the solutions to how IP should be handled post-Brexit."

MAY 2018 APPG EVIDENCE

Using data gathered for our business case, we submitted evidence to the All-Party Parliamentary Group (APPG) on Legal and Constitutional Affairs' inquiry on the effect of Brexit on the provision of legal services. We outlined the impact on the CTMA profession if rights of representation before the EUIPO were lost. It was another opportunity to reiterate our desired outcome from the ongoing negotiations between the UK and EU.

JUNE 2018 ACTING ON ARTICLE 55

We set out the disadvantages of the approach set out in Article 55 of the European Commission's draft Withdrawal Agreement. The statement, sent to the European Commission, was signed by ourselves, BMM, FICPI-UK, the IP Federation, MARQUES and the Law Society.

OCTOBER 2018 OUR EVIDENCE GOES TO PARLIAMENT

The EU Justice Sub-Committee received a range of evidence from Daniel Alexander QC and Charlotte May. Our business case and evidence submitted to the APPG on Legal and Constitutional Affairs formed part of the evidence heard.

NOVEMBER 2018 NEW WITHDRAWAL AGREEMENT

This continues to assert that owners of registered EUTMs and RCDs will have their rights cloned onto the UK register to ensure continued protection. UK CTMAs would maintain rights of representation for ongoing proceedings at the EUIPO.



28th
February 2018
European
Commission
publishes draft
Withdrawal
Agreement

2018



ARTICLE

55

20th March 2019
UK Government seeks permission to extend Article 50 until 30th June 2019

10th April 2019
Brexit extension agreed until 31st October 2019

28th October 2019
EU agrees extension to 31st January 2019

2019

FEBRUARY 2019

FEEDING INTO SIS

The draft intellectual property statutory instruments (SIs) for implementing the Brexit changes were published. These would bring the legal updates required for Brexit into UK law. CITMA representatives had the opportunity to provide input into the draft SIs.

MARCH 2019

NO-DEAL PREPARATIONS

The UK was due to exit on 29th March, and with Parliament in a deadlock, we prepared for the UK to leave without a deal and the implications of falling off this 'cliff edge'.

We updated our guidance on what would happen in 'deal' and 'no-deal' scenarios in relation to professional representation and IP rights.

APRIL 2019

US TRIP

We took our key messages to the US in a series of roadshows with CIPA and the UK IPO. These allowed us to reassure the key US market that the UK was operating as normal and that the profession would still be able to carry out work post-Brexit.

MAY 2019

SEEKING GUIDANCE

With confirmation by now of a further extension to the Brexit process (until 31st October 2019), we sought guidance for the UK profession from the EUIPO on exemptions and requirements to remain on the register of representatives. This followed our attendance at the EUIPO user group meeting in Alicante the previous month.

The EUIPO set out the evidence required to prove "real and effective establishment" in an EEA Member State, changing from a professional representative to legal practitioner and applying for exemptions as a UK national. The guidance also covered changing from a professional representative to a legal practitioner and applying for exemptions as a UK national.

JULY 2019

NO LET-UP

The arrival of Boris Johnson as Prime Minister signalled with some certainty that the UK would be leaving the EU within the next 12 months. As such, we focused our attention on continuing our fight for rights of representation.

SEPTEMBER 2019

WIPO GUIDANCE

We met with the WIPO in Geneva to discuss no-deal preparations and shared the WIPO's guidance with members.

OCTOBER 2019

PROBLEM SOLVING

Members were informing us that requests for a second EUIPO ID were being rejected in many cases. We took this up with the EUIPO, which issued additional guidance to help the UK profession understand the process and what was needed for a successful application.

FEBRUARY 2020

NEGOTIATING POSITIONS

Following the UK's departure from the EU on 31st January 2020 and the start of the transition period, the UK Government set out its negotiating position on IP by saying that it was "open to co-operation with the EU on intellectual property" and "seeking to ensure high standards of protection for trade marks and designs".

The UK Government said that it seeks an agreement that "secures mutual assurances to provide high standards of protection for IP rights, including registered IP rights such as patents, trade marks or designs".

The document goes on to state that the UK is "open to discussing mechanisms for co-operation and exchange of information on IP issues of mutual interest".

We met with the Minister for IP, Chris Skidmore, shortly before he left the position, and reiterated the importance of the UK IP profession retaining rights of representation before the EUIPO.



OUR NEXT STEPS

With the transition period drawing to a close at the end of this year, the coming months will be vital. We are still prioritising rights of representation for UK CTMAs before the EUIPO. We are also fighting for reciprocity on address for service between the UK and EU. We will keep you up to date as we strive to get the best outcome.



Richard Hayward

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We took our key messages on Brexit to the US in April 2019

“ With the transition period drawing to a close at the end of this year, the coming months will be vital

2020

23rd January 2020
EU (Withdrawal Agreement) Act 2020 receives Royal Assent and becomes law

31st January 2020
The UK leaves the EU with a transition period until 31st December



#USTOO?

Jim Pearson would like everyone in the IP profession to enjoy dignity in the workplace

Unless you've completely cut yourself off from society and all forms of news and social media, you will know that the words "me too" have acquired what some might refer to as a secondary meaning. The social media hashtag went viral in 2017 following multiple sexual abuse allegations against American film producer Harvey Weinstein, who has since been sentenced to 23 years in prison after being found guilty of rape and sexual assault. The "Me Too movement" is now a broader campaign against sexual harassment and assault, particularly in the workplace.

Just to be clear here, I should probably give some examples of what constitutes sexual harassment in the workplace. It might include:

- Indecent or suggestive remarks;
- Making jokes of a sexual nature;
- Sharing, whether intentionally or otherwise, comments of a sexual nature about another person;
- Questions, jokes, or suggestions about a colleague's sex life;
- Displaying pornography in the workplace;
- Circulating material of a sexual nature (by email, social media or messaging platforms, for instance);
- Unwelcome and inappropriate touching (placing a hand on someone's lower back or knee, for example), hugging or kissing; and
- Unwelcome verbal sexual advances, or requests/demands for sexual favours.

Not all perpetrators are senior heterosexual men, and not all victims are less senior women. However, women are significantly more likely to be a victim, and men are more likely to be the perpetrator. As a result, I've focused on this type of sexual harassment here, although many of my comments will apply to instances of sexual harassment where different genders and/or sexual orientations are involved.

DEPRESSING STATISTICS

As a middle-aged, white, male partner in a private practice firm of Patent and Trade Mark Attorneys, I can't say that I've been on the receiving end of any sexual harassment in my professional life. But, as a father of four school-aged daughters, I am familiar with the types of behaviour that girls and women have to endure every day – including derogatory name-calling at school and casually made threats of sexual violence.

Are my daughters going to have to continue to battle against this as they move into paid employment? If recent stats are anything to go by, a young woman working today is more likely than not to have already directly experienced some form of sexual harassment in the workplace. In 2016, researchers from the Trades Union Congress and the Everyday Sexism Project found that 52 per cent of women had experienced unwanted sexual behaviour at work, including groping, sexual advances and inappropriate jokes. Among women and girls aged 16 to 24, the proportion reporting sexual harassment rose to 63 per cent. And yet, the vast majority of instances of sexual harassment go unreported.

ARE WE PART OF THE PROBLEM?

But what about sexual harassment in the workplace within the IP profession? Media coverage on the subject of sexual harassment in the workplace seems to suggest that the legal profession harbours some of the worst culprits.

In March 2018, *The Lawyer* reported that 42 per cent of women in the legal profession said they had experienced sexual harassment at work, including inappropriate comments, propositioning and unwanted physical contact. The same month, the *Financial Times* reported that "in the two years to October 2017, the Solicitors Regulation



Authority (SRA) received only 21 complaints of sexual harassment within law firms, and has received just two reports since then". It seems that sexual harassment is widespread, but victims tend to take little or no action. This might explain why the *FT* chose to publish its findings under the headline "Women lawyers say sexual harassment is fact of life at UK law firms". Indeed, victims tend to find themselves having to "just deal with it" without making a fuss.

Whether or not what's going on in the legal profession as a whole is indicative of the state of affairs within firms employing IP professionals, I think that it's inevitable that improvements can be made. Men in particular, but also women, underestimate how much sexual harassment there is in the UK, by quite some margin.¹ That has serious consequences.

Having a culture where low-level sexual harassment is tolerated – or propagated – by those managing the business is going to drive away talented staff. Victims of sexual harassment are more likely to move firms than take action.² Although the matter is now decades old, I know that one of my former female colleagues almost left our firm when she was on the receiving end of a series of unwanted advances from a more senior male colleague. ▶

“ I’d hope that most of us have the capacity to be decent, respectful human beings

Members of senior management or “star” attorneys in the legal profession seem, historically at least, to have been able to effectively get away with inappropriate behaviour. Times are finally changing, however, with individuals in senior positions in some of the larger law firms in the UK finding themselves accused of less-than-professional behaviour in recent years.³ That has the potential to cause serious embarrassment and reputational damage to their (ex-)firms.

On the flip side, having an open, inclusive and gender-diverse workplace (which will naturally reduce instances of sexual harassment) tends to make firms more productive, more profitable and better at retaining talent, as well as resulting in a better external reputation.⁴

WHAT CAN WE DO?

Detailed guidance on dealing with sexual harassment at work has recently been published by the Equality and Human Rights Commission.⁵ If you’re in a position to make a difference in your workplace, I hope you will consider:

- Making sure that your policies that concern sexual harassment in the workplace are appropriate, understood and put into practice;
- Raising awareness – for example simply reminding all staff that there is a zero-tolerance approach to sexual harassment in the workplace;
- Providing training on the subject, or access to training; and
- Ensuring that those at the top of the organisation lead by example and call out others when they witness poor behaviour among colleagues, clients and suppliers.

If you’re in a management position and think that this is too tricky, not

sufficiently important to tackle or just not your problem, then you should know that this issue is not one that is going to go away quietly. There is an active government consultation on whether the current laws on protecting people from sexual harassment in the workplace are effective. In the meantime, the government’s recommendations and comments following the “Sexual Harassment in the Workplace” report by the Women and Equalities Committee appears to encourage regulators to take a more active role: “Starting by setting out the actions they will take to help tackle this problem, including the enforcement action they will take; and making it clear to those they regulate that sexual harassment is a breach of professional standards and a reportable offence with sanctions.”

ORGANISATIONAL INPUT

For the moment, instances of complaints being made against Patent Attorneys or Trade Mark Attorneys and escalated to IPReg, CIPA or CITMA are rare. However, if the SRA figures are anything to go by, a low number of complaints to a professional or regulatory body should not be taken to suggest that instances of sexual harassment in the workplace are correspondingly low.

IPReg currently takes the view that compliance with statutory and regulatory requirements rests firmly with the regulated entity/individual, meaning that they must take action to ensure they are compliant. Allegations of sexual harassment in the workplace should first be reported to someone senior or in HR within the firm (or, depending on the circumstances, reported to the police or independent legal counsel). If an

allegation is made within a firm, IPReg expects the firm to investigate such an allegation and, if the matter is sufficiently serious to appear to be a breach of the Rules of Professional Conduct, to refer the matter to IPReg. The focus on any investigation by IPReg would probably be on the issue of integrity.

Female readers will no doubt tell me that all this is pretty standard stuff. But I wonder what male readers will think. Will we be lambasted for complimenting someone on a new outfit, or a new hairstyle? Can you comfort someone who is upset by giving them a hug? Is it now risky for two work colleagues, one senior and one junior, to be booked into adjacent hotel rooms when travelling on business, or to have an evening meal together? To some men in senior positions, this now seems like a bit of minefield. Most of us can readily envisage situations where a set of actions would seem innocuous, but the same actions in a different context might seem like sexual harassment.

If you really can’t tell the difference, my advice would be to adopt a cautious approach. However, I’d hope that most of us know how we should behave and have the capacity to be decent, respectful human beings.

Inevitably, some of us will get it wrong some of the time. For the most part, I would hope that this would involve a clumsy comment or doing or saying the wrong thing simply by not knowing the audience sufficiently well. Some of these things will be perceived as undesirable or inappropriate by the person on the receiving end, and that person will often find it difficult or awkward to do anything about the matter. However, if your workplace has a senior management team made up of people who are striving to be decent, respectful human beings, then calling out undesirable behaviour should be seen as a good



HERE'S WHERE TO GET HELP

If you've been a victim of sexual harassment, or worse, or have concerns related to the subject of this article, please consider these actions:

- Talk to someone you trust and can confide in about what's happened.
- Make notes about the incident, especially if recalling the incident is particularly upsetting.
- If you have witnessed sexual harassment taking place within a workplace environment, report or call out the behaviour.
- If you can, tell the perpetrator to stop the unwanted behaviour. You could do this in writing if preferred.
- Find out if your employer has a policy in place that provides a framework for reporting incidents or complaining about the behaviour of others. If so, it should set out what to do and who to approach for help and support.
- Seek help and support from these independent sources:
 - LawCare – 0800 279 6888 (lawcare.org.uk)
 - ACAS Helpline – 0300 123 1100 (acas.org.uk)
 - Citizens Advice Bureau Adviceline – 03444 111 444 (citizensadvice.org.uk)
 - The Samaritans – 116 123 (samaritans.org)
- If you or someone else is in immediate danger, phone the police on 999. Call 101 to contact the police if the incident is not an emergency.

thing. Challenging poor behaviour gives an opportunity for positive change and for the individuals concerned to learn and self-improve.

PERSONAL EXPERIENCE

Pointing out the behaviour of others, particularly those more senior than you, is a scary prospect – but it can work. For example, a little while ago, I said something to a member of staff which I thought was harmless banter, but they later called me out on the matter. I was initially taken aback as I had been completely oblivious to having stepped over the line, but I soon appreciated that my comments were misjudged on that particular occasion. It took courage for that person to approach me, but I appreciated their honesty and openness. In fact, I think we trust each other a little more as a result of the way we both behaved. Organisations that have an open and honest culture, supported and promoted by senior management, will make such conversations easier. I'm convinced that's healthier for everyone concerned.

If tackling things in a direct and informal way doesn't work, a more formal procedure may be required. Ideally, there should be an agreed procedure for dealing with things properly and sensitively. If the behaviour is such that it could be grounds for dismissal or, worse, criminal prosecution, are the individuals in your organisation who might need to be involved (the alleged victim, the alleged perpetrator, HR people, line managers and so on) adequately equipped to deal with the matter?

On the subject of escalation, it's often said that making an allegation of sexual harassment can end the accuser's career. However, being on the receiving end of a serious allegation can also have potentially devastating consequences for the accused – everything from the end of a career to the end of life.⁶

In practice, dealing with this in a proportionate, balanced and sensitive way for all concerned appears extremely difficult to get right. (I, for one, don't want to be the catalyst that unfairly ends a career, or does worse, for anyone.) There needs to be change, but in my view the changes need to centre on promoting a healthy and productive culture in the workplace such that everybody is treated with dignity.

I've found this an extremely difficult article to write. However, I hope that I get people talking about the subject in a healthy and positive way. I'd like the culture within the IP profession as a whole to be one we can all be proud of. I hope you will join me in doing what we can to ensure that our workplaces in the IP profession are safe and happy places for all to work in by making sexual harassment a thing of the past. ●

- 1 [ipsos.com/sites/default/files/ct/news/documents/2018-03/international-womens-day-2018-global-misperceptions-of-equality-and-the-need-to-press-for-progress_1.pdf](https://www.ipsos.com/sites/default/files/ct/news/documents/2018-03/international-womens-day-2018-global-misperceptions-of-equality-and-the-need-to-press-for-progress_1.pdf)
- 2 Just one example can be found here: [rollonfriday.com/feature-content/mythical-sexual-harassment-free-law-firm](https://www.rollonfriday.com/feature-content/mythical-sexual-harassment-free-law-firm)
- 3 See examples here: [natwestbusinesshub.com/content/legal-profession-tackles-metoo](https://www.natwestbusinesshub.com/content/legal-profession-tackles-metoo)
- 4 catalyst.org/research/why-diversity-and-inclusion-matter/
- 5 <https://www.equalityhumanrights.com/en/sexual-harassment-workplace>
- 6 The sad case of the Welsh politician Carl Sargeant is a useful reminder here: [theguardian.com/uk-news/2019/jul/11/who-was-carl-sargeant-what-were-allegations-against-him-wales](https://www.theguardian.com/uk-news/2019/jul/11/who-was-carl-sargeant-what-were-allegations-against-him-wales)

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For the intellectual property field in Singapore, 2019 was an exciting year, with new policies to promote Singapore as an IP hub and legislative reforms leading the charge in opening up new areas of opportunity.

For example, as part of Singapore's co-ordinated endeavour to support artificial intelligence (AI) as an emerging field, the Intellectual Property Office of Singapore (IPOS) has introduced an Accelerated Initiative for an Artificial Intelligence (AI²) programme, which became effective on 26th April 2019.

This programme speeds up the file-to-grant process for AI-related patent applications from the usual two to three years to just six months, which makes Singapore's patent granting for AI-related applications the fastest in the world.

To be eligible for AI² application fast-tracking, an applicant has to meet the following prerequisites:

- The patent application was first filed in Singapore;

- The patent application relates to AI;
- The Request for Grant of Patent (Patent Form 1) and Request for Search and Examination (Patent Form 11) were filed on the same day;
- The patent application contains no more than 20 claims; and
- A supporting document labelled "Fast Track document", stating that the patent application is an AI

Geographical Indications (the GI Registry), which commenced operations on 1st April 2019. The GI Registry is one of the obligations under the EU-Singapore Free Trade Agreement (the EUSFTA), aimed at enhancing the protection of intellectual property in Singapore.

Before its establishment, GIs were protected only in narrow and specific

“ Singapore’s patent granting for AI-related applications is the fastest in the world ”

invention, is furnished during the submission of the Request for Search and Examination (Patent Form 11).

Under the AI² programme, Alibaba Group Holding, one of China's biggest e-commerce companies, has obtained its AI patent in Singapore in just three months, which is a world record.

GI REGISTRY

Last year also saw the implementation of the Singapore Register of

circumstances where a GI related to wines or spirits or was used in a manner which misleads the public or constitutes unfair competition. GIs may now be registered in relation to a broad range of goods, including agricultural products and foodstuffs. These registered GIs are protected from any unauthorised use in respect of the category of goods for which they are registered, where the goods in question do not originate from the

SINGAPORE SWINGS

Following big policy changes in 2019, the time is right to look at IP developments in this fast-evolving country

place indicated by the GI.

This applies whether or not:

- The true origin of the subject goods is used together with the registered GI;
- The registered GI is used by way of translation; or
- The registered GI is used alongside words such as “type” or “style” (eg “Champagne-style wine”).

Remedies that may be awarded in respect of the infringement of GIs include an injunction to restrain the infringing act, damages or an account of profits. Moreover, the Singapore court may order the infringer to deliver infringing goods or other material bearing the GI to the plaintiff.

A new but yet to be implemented feature of registered GIs is the availability of border enforcement measures, including procedures through which an interested party may request Singapore’s customs authority to: (i) seize goods suspected of infringing a registered GI which is to be exported or imported; and (ii) obtain and provide to interested parties information in respect of the seized goods necessary to

commence action for infringement of GIs. These measures are expected to come into force within three years of the entry into force of the EUSFTA (November 2022).

REGISTRATION PROCEDURE

Applicants registering a new GI will have to indicate the categories of agricultural products/foodstuff that the GI will apply to, and the quality, reputation or other characteristic attributable to that place. The proposed GI will then be examined by a Registrar of the GI Registry for compliance with the applicable statutory requirements and will thereafter be published for the purposes of opposition proceedings before proceeding to registration.

Nearly 200 prospective GIs have been singled out for application for registration (subject to the applicable procedures and statutory requirements) in the GI Registry under the EUSFTA. Of these, 138 GIs had been registered by the EU at the time of writing.

DISPUTE RESOLUTION REFORM

The Intellectual Property (Dispute Resolution) Act 2019 (the IPDR Act) was passed by the Parliament of Singapore on 5th August 2019 following public consultations. The IPDR Act will be implemented in phases, with some portions in force already and the rest coming into effect at a later date.

The IPDR Act provides for amendments to Singapore’s Arbitration Act (the AA) and the International Arbitration Act (the IAA) to clarify that IP disputes can be arbitrated in Singapore. These

amendments came into effect on 21st November 2019.

In line with the private nature of arbitration, the AA and the IAA further provide that the resulting arbitral award binds only the parties to the arbitration and not third parties. In particular, an arbitral award does not affect the rights or liabilities of third-party licensees and third-party holders of security interests of the IP right in dispute.

The IPDR Act seeks to simplify the hearing of civil IP disputes by granting the Singapore High Court exclusive jurisdiction over the following matters: (i) infringement of registered (patents, trade marks, registered designs and registered GIs) and non-registered (copyright and unregistered GIs) IP rights; (ii) passing off; and (iii) declarations of non-infringement of patents.

The relevant amendments pertaining to the consolidation of civil IP proceedings for patent infringement, copyright infringement and passing off in the High Court will come into force on a date to be notified. At present, proceedings for patent infringement may be heard by the IPOS, while those for copyright infringement and passing off may be heard in the State Courts. The High Court remains the exclusive forum for infringement proceedings involving registered trade marks and registered designs.

It may not feature in the IPDR Act, but it is likely that the consolidation of civil IP disputes in the High Court will be implemented in tandem with a fast-track IP litigation pathway, which was last mooted in a public consultation in October 2018 by the Singapore Ministry of Law.

THE PATENT GRANT PROCESS

The IPDR Act introduces two new procedures in the patent grant process. Both of these procedures are yet to be implemented and will come into force at a later date.

1. The Third-Party Observation Procedure. A new s32 of the Patents Act formalises the common practice of third parties making informal submissions to the Registrar on

the patentability of an invention in a patent application after it has been published. Any person may, after the publication of a patent application, make observations in writing to the Registrar on whether the invention in the said application is patentable. The observations must be received by the Registrar before the examination report, the search and examination report or the supplementary examination report is issued.

2. The Post-Grant Patent Re-examination Procedure. The IPDR Act proposes a new s38A of the Patents Act to provide for a process by which a person may file an *ex parte* request for the post-grant re-examination of the specification of a patent. The patent will be revoked if the re-examination report shows that there is at least one unresolved objection for which the patent proprietor failed to give a satisfactory response.

Although the grounds for re-examination are similar to those found in s80(1) of the Patents Act (for revocation), the post-grant re-examination procedure allows an opportunity to challenge a patent through re-examination by an Examiner. This can result in the saving of costs due to the *ex parte* nature of the procedure.

EXAMINATION ROUTES CURBED

Prior to 1st January 2020, an applicant was permitted to choose any one of the following search and examination options in order to pursue protection for their patent application¹ in Singapore:

- Request for Search Report within 13 months of the priority date (or the filing date if there is no priority claim), followed by a Request for Examination within 36 months of the priority date (or the filing date if there is no priority claim); or

- Request for a combined Search and Examination Report within 36 months of the priority date (or the filing date if there is no priority claim); or
- Request for Examination Report within 36 months of the priority date (or the filing date if there is no priority claim); or
- Request for Supplementary Examination Report within 54 months of the priority date (or the filing date if there is no priority claim).

However, as of 1st January 2020², the Request for Supplementary Examination Report (the “supplementary examination route”) is no longer available for the following Singapore patent applications:

- Patent Cooperation Treaty (PCT) applications entering the national phase in Singapore, with an international filing date of 1st January 2020 onwards;
- Direct national applications filed on or after 1st January 2020; and
- New applications³, including divisional applications where the actual filing date is on or after 1st January 2020.

Singapore patent applications affected by the closure of the supplementary examination route are now limited to the options of local search and examination and local examination based on a foreign search result, or the other three search and examination options above.

This closure is in line with IPOS’ plans to progressively improve the quality of Singapore’s granted patents. This will ensure consistency in the patentability assessment of all Singapore patent applications. ●

1 Direct national applications. The first option is not applicable to PCT applications entering the national phase in Singapore.

2 Section 29(11A) and Rule 43(4) of the Singapore Patents Act and Patents Rules.

3 New applications are mentioned in s20(3), 26(11) or 47(4) of the Singapore Patents Act.



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MAKING SENSE OF STATEMENTS

Ash Chandarana demystifies financial statements with eight important answers for IP professionals

Financial statements – such as profit and loss accounts, balance sheets and cashflow statements – are widely regarded as the “language” of business. Used properly, they provide a unique insight into the financial performance of a company and can be a vital resource for experts working in the IP arena by articulating the value of trade marks and other intangible assets.

However, they can also seem impenetrable unless you understand the jargon and the principles behind their presentation. Reading the answers to these key questions is a good place to start.

IS THERE A SINGLE FORMAT FOR FINANCIAL STATEMENTS?

No. Financial statements can take many forms, depending on the business structure involved. The financial statements of an unincorporated entity are usually only for internal and tax purposes and can be presented in a variety of ways.

By contrast, incorporated companies and limited liability partnerships (LLPs) are required to file their financial statements at Companies House and must follow some strict disclosure requirements and rules as to how the accounts are presented.

It is also worth noting that an LLP and a limited company will have different terminology and various differing disclosure notes.

CAN YOU RELY ON A FINANCIAL STATEMENT?

Check to see what type of report has been prepared, as this will determine the level of assurance you take from the financial statement. Three of the most common types are:

- Accountant’s report. This informs the reader that the financial statements have been prepared by the accountant, but no tests or checks have been done on the numbers and

no opinion is given on whether the financial statements provide a “true and fair view” of the company’s affairs.

- ISRE 2400 report. Here, the accountant performs a limited review of the financial statements to state whether anything has “come to their attention”. However, no opinion is given as to whether the financial statements provide a “true and fair view” of the company’s affairs.

- Audit report. This confirms that various tests have been performed to check the reliability of the financial statements. As a result, the report is able to provide an opinion on the



financial statements and whether they offer a “true and fair view” of the company’s affairs.

DO ALL BUSINESSES NEED TO BE AUDITED?

No. Small companies are typically exempt from having their financial statements audited if they meet two out of the three following criteria, for two consecutive years:

- Turnover is not more than £10.2m;
- The balance sheet total (gross assets) is more than £5.1m; and/or
- The average number of employees for the year is not more than 50.

However, certain companies (such as banks and subsidiaries that are in the same group as a bank) are always subject to statutory audit, regardless of their size, to ensure their transparency to the public eye.

A business can voluntarily undertake an audit, to provide assurance to its stakeholders regarding its financial statements. Even if a company is exempt from an audit, it must still undertake an audit if requested by 10 per cent or more of its shareholders.

WHAT ARE THE RULES AROUND ACCOUNTING FOR INTANGIBLE ASSETS?

There are specific rules around accounting for intangible assets such as trade marks or other intellectual property. Principally, the intangible asset should only be recognised if it is probable that the expected future economic benefits attributable to the asset will flow to the company and the cost can be measured reliably.

Internally generated brands, logos, publishing titles, customer lists and goodwill cannot be recognised as intangible assets.

Research and development expenditure has a two-stage treatment. While in the research phase, all expenditure must be taken to the profit and loss account, as expenditure is incurred. In the development phase, provided all the following criteria are met, the expenditure can be considered an intangible asset:

- It must be technically feasible to complete the intangible asset so that it can be either used or sold.

- The company must have the intention to complete the intangible asset so that it can be used or sold.
- The company must have the ability to use or sell the intangible asset once it is completed.
- The intangible asset must be able to generate probable future economic benefits and prove its usefulness.
- Adequate resources must be available to the company to complete the development of the intangible asset; and
- The costs incurred can all be measured reliably.

HOW ARE INTANGIBLE ASSETS VALUED?

Intangible assets are capitalised to the balance sheet at cost, which includes any directly attributable costs necessary to produce and prepare the asset for use (legal fees, for example). Where assets

WHAT IS AMORTISATION?

Amortisation is accounting terminology for the depreciation of an intangible asset and is a measure of the impairment and reduction of its value. Amortisation should spread over the useful life of an asset. If you are unable to determine the asset’s useful life, the UK Generally Accepted Accounting Principles (GAAP) state that a maximum of 10 years should be used.

DO THE ACCOUNTS USE UK GAAP OR IFRS?

It is always worth checking the basis of preparation of the financial statements. We have noted all our points above using a convention called FRS 102, under UK GAAP. However, it is possible that the financial statements could be prepared under International

“ Used properly, financial statements can articulate the value of trade marks and other intangible assets ”

have already been capitalised, the revaluation model can be applied, revaluing the asset each year going forward.

WHEN CAN THE VALUE OF GOODWILL BE RECOGNISED?

Internally generated goodwill cannot be recognised on the balance sheet. However, if a company is purchased for £10m, with all net assets (including any intangible assets attributable to the acquired company) being valued at £7m, the remaining £3m is recognised as ‘goodwill’ in the group financial statements. Goodwill can also arise on the purchase of a business, rather than a company.

Financial Reporting Standards (IFRS) instead. One difference between IFRS and UK GAAP for intangibles is that under IFRS intangibles must be capitalised in the development phase if certain criteria have been met, while under UK GAAP companies can opt to capitalise intangibles once the criteria (similar but not the same as those under IFRS) have been met. ●

Note: This article is intended as a general guide. No responsibility for loss occasioned to any person acting or refraining from action as a result of this material can be accepted by the author or publisher. This information is in accordance with legislation in place as of 1st February 2020.



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SKYKICK OFFERS LITTLE

Significant issues remain
for brand owners following
an anticlimactic finale,
according to our authors



SATISFACTION

In a ruling handed down three days before the UK left the EU, the Court of Justice of the European Union (CJEU) answered the questions referred by SkyKick (C-371/18, 29th January 2020) as follows:

- A registered trade mark containing terms which are not clear and precise cannot be found to be partially or wholly invalid. The Regulation

provides an exhaustive list of grounds for invalidity, and there is no existing provision to justify such a finding. Further, the existing “public policy” grounds would not be extended to cover such situations. This was a departure from Advocate General Tanchev’s opinion issued in October 2019. As a result of this finding, there was no need to consider whether the term “computer software” lacked sufficient clarity or precision; and

- A trade mark application filed despite the applicant having no intention to use the mark for the goods and/or services covered by the registration may constitute bad faith – but only where it can be shown that the applicant deliberately

intended to monopolise certain goods and services in order to undermine third-party interests. Where bad faith is shown in respect of certain goods and services, the trade mark registration could be found invalid in respect of just those goods and/or services, rather than the whole registration.

Brand owners and their advisers had predicted that the CJEU ruling would have a significant impact on our day-to-day practice. In particular, that it would:

- Give teeth to the previous CJEU ruling in IP TRANSLATOR and allow third parties to expunge unclear or imprecise specification terms;
- Broaden the scope of bad faith invalidity so that it might apply to wide-ranging circumstances where a lack of commercial rationale for protecting certain terms could be used to remove existing registrations or as a defence against trade mark infringement; and
- Change existing filing practices, perhaps moving towards a US-style system requiring detailed specifications of goods and services, which would help to declutter the registers.

So, were any of these predictions correct? Well, the CJEU clearly stated that invalidity is not available as a means to enforce the requirements set out in IP TRANSLATOR, because a lack of clarity and precision

within the specification is not a ground for invalidity in the relevant legislation. This means that clarity and precision requirements remain a registry issue upon examination of a trade mark application.

The CJEU specifically mentions revocation as the appropriate way for third parties to expunge unclear and imprecise terms from a trade mark registration. This is not particularly helpful, because it means that third parties have to wait until after the expiry of the five-year grace period before they can take action against a registration which might, in the meantime, be asserted against them. Until that time, the brand owner can maintain a monopoly over an unclear/ unprecise term (such as “computer software”, although the status of that particular term was not addressed by the CJEU).

By directing potential defendants to revoke unclear specifications, it seems likely that a significant number of non-use cases will be raised where the meaning of certain specification terms is questioned in conjunction with their genuine use. And in doing so, it seems that the CJEU has simply put off dealing with the problem, providing no resolution for the issue of unclear specifications within the five-year grace period. A more stringent requirement for specificity ▶

CJEU headquarters
in Luxembourg

“ It seems that the CJEU has simply put off dealing with the problem, providing no resolution for the issue of unclear specifications

of certain terms, such as that used in US, appears to have been rejected by the CJEU.

Therefore, those of us looking to clear and protect new brands will continue to find ourselves dealing with the uncertainty caused by these poorly defined earlier rights.

REPERCUSSIONS

Even though the CJEU didn't permit invalidity in these circumstances, there have been interesting repercussions at the registry level which could broaden the potential scope of this ruling.

Perhaps reflecting the view of (then) Mr Justice Arnold, who had stated in his referral to the CJEU that a trade mark for "computer software" is both "unjustified and contrary to the public interest because it confers on the proprietor a monopoly of immense breadth which cannot be justified by any legitimate commercial interest of the proprietor", both the UK and EU registries have been refusing new applications covering "computer software".

If other registries adopt a similar approach to identifying and refusing a wider range of unclear or imprecise terms, then in the longer term we should see marks with clearer specifications coming onto the registers. This would promote clarity and precision at the outset, rather than placing the onus on third parties to challenge specification terms post-registration. This is a positive step for all brand owners and practitioners alike and may allow the UK IPO to examine specification terms more rigorously than the EUIPO, post-Brexit.

BAD FAITH IN FOCUS

The law surrounding bad faith is largely unchanged. The CJEU avoided controversy by stating that a finding of bad faith could be partial and would not necessarily lead to the invalidity of the whole registration. However, the ruling highlights the challenges in proving bad faith.

The CJEU describes the conditions under which bad faith for absence of intention to use is actionable: where a filing is made with the intention of undermining, in a manner inconsistent with honest

“ Clearer specifications would promote clarity at the outset, rather than placing the onus on third parties to challenge post-registration

practices, the interest of third parties, or of obtaining (without even targeting a specific third party) an exclusive right for purposes other than those falling within the functions of a trade mark.

These are narrow conditions and cannot easily be proved by the invalidity applicant. However, it does seem clear that the sharp practice known as 'evergreening' (where a proprietor files a new application every five years to circumvent the proof of use requirement or possible revocation) is likely to fall into this category, meaning that evidence of evergreening could lead to an inference of bad faith. The UK requirement to provide a declaration of intention to use upon filing an application could also lead to such an inference, but does not give rise to a ground of invalidity.

A related question of interest is what will happen if a brand proprietor seeks to rebut that inference. This issue was raised before the Board of Appeal in MONOPOLY (R1849/2017-2, 22nd July 2019), a case in which there had been an oral hearing to determine the intention of the proprietor at the time that the refilings were made. In EUIPO proceedings, might we see an increased use of oral hearings before the Cancellation Division?

IS IT A WIN?

This CJEU ruling is seen by many as a positive outcome for brand owners. It won't require them to carry out extensive reviews of their existing portfolios or file new trade mark applications to remove imprecise or unclear terms, as had been feared. However, the difficulties raised surrounding such specification terms should be kept in mind by practitioners and brand owners looking to file future applications.

To avoid future invalidity, brand owners might refile more narrowly and in a manner that reflects the genuine use that they would be able to prove, if required. However, as the outcome of invalidity proceedings will be limited, and will only remove those goods and services where bad faith is shown in accordance with the CJEU's criteria, there is little disincentive to change filing practices significantly.

Ultimately, this anticlimactic ruling does little to resolve the increasingly cluttered register and the unclear scope of some earlier registered rights, which are significant issues still facing existing and future brand owners. ●



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Brewdog is blown out

A key argument was considered irrelevant, Oliver Tidman notes



This appeal resulting from the decision of the Hearing Officer (HO) on registration of UK trade mark BREWDOG DOGHOUSE was launched by Brewdog plc (the Applicant). The HO had partially refused registration of the mark following opposition by Doghouse Distillery Ltd (the Opponent), based on s5(1)(b) of the Trade Marks Act 1994 (the Act).

INITIAL OPPOSITION

In October 2017, the Applicant applied to register BREWDOG DOGHOUSE as a trade mark for services in classes 40 and 43, including services for providing food and drink. The Opponent filed notice of opposition in February 2018 based on its earlier UK trade mark for DOGHOUSE (shown below) against all services in classes 40 and 43.

As a result of the visual, aural and conceptual similarity of the marks and because the majority of the services in classes 40 and 43 were considered either identical or similar, a likelihood of indirect confusion existed and the opposition partially succeeded.

GROUND OF APPEAL

In its grounds of appeal, the Applicant alleged that:

1. The HO had erred in finding that “hotel accommodation services” and “temporary accommodation services” were similar to a medium degree to the Opponent’s class 43 services, but the Applicant did not otherwise challenge the HO’s assessment of similarity of goods or services; and
2. The HO had failed to properly compare the marks and had not taken into account the alleged enhanced distinctiveness and reputation of the BREWDOG element, as well as the dominant dog-head device element in the Opponent’s mark.

DECISION

Ultimately, the Appointed Person (AP) held that artificially dissecting the marks in order to arrive at the decision that the marks were visually and aurally similar to a medium degree, and conceptually similar to a medium-to-high degree, was the correct approach.

The AP rejected the Applicant’s second ground of appeal because, for one thing, the enhanced distinctiveness or reputation

of the mark (or the BREWDOG element of it) is irrelevant to an opposition based on s5(2)(b).

While the AP acknowledged, applying *Meric*¹, that consumers normally pay more attention to the beginning of marks, that cannot

apply in every case.² Despite the dog-head device being larger than the word DOGHOUSE, the AP agreed that the natural eye would be drawn to the word and therefore both elements played an equal role in the overall impression of the Opponent’s mark.

Finally, the AP rejected the Applicant’s first ground of appeal because pub services could include the provision of accommodation and, conversely, hotel accommodation services could include the provision of restaurant and bar facilities.

¹ T-133/05 Gérard Meric v EUIPO

² T-698/17 MAN Truck & Bus v EUIPO

“
The rule in Meric cannot apply in every case”

KEY POINTS

- The enhanced distinctiveness or reputation of a mark or one of its elements is irrelevant to an opposition under s5(2)(b)
- Where the earlier mark is entirely included in the contested mark, that is an indication of similarity, and the dominant element may not always appear at the beginning

MARK

OPPONENT’S MARK



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Who's the lucky lady?



The decision went for the Opponent, reports Sophie Soeting

This case concerns a UK trade mark application for MILLIONAIRE LADY in class 3 in relation to perfume oils and sprays, essential oils and household fragrances (the Opposed Mark). Puig France, Société par Actions Simplifiée (Puig) opposed, relying on four EU trade mark registrations, all registered in class 3 (the latter two have broader specifications):

1. A word mark for LADY MILLION;
2. A stylised mark for LADY MILLION;
3. A stylised mark for LADY MILLION LUCKY, including the words PACO RABANNE; and
4. A word mark for LADY MILLION EMPIRE.

Puig has used the LADY MILLION marks in relation to a Paco Rabanne women's fragrance collection since 2010 in the UK, with more than 2.6 million units sold between 2014 and 2018, at a turnover of around £80m.

Puig opposed on the basis of s5(2)(b) of the Trade Marks Act 1994 (likelihood of confusion), s5(3) (unfair advantage, detriment to distinctive character or reputation) and s5(4)(a) (passing off).

In relation to passing off, Puig's initial reliance on use in relation to "perfumery, shower gel and body lotion" was restricted to "perfumery" during the evidence rounds.

LIKELIHOOD OF CONFUSION

The term "perfumery" in Puig's specifications was found to be broad enough to include the perfume oils, sprays and essential oils in the Opposed Mark, making them identical. While the similarity between perfumery and household fragrances was only superficial, Puig's third and fourth marks did include "household fragrances".

Despite the different positioning of the words in the competing marks, the Hearing Officer (HO) reached the conclusion that the Opposed Mark and Puig's first two marks were:

- Visually similar to a well above medium degree (noting that the goods would likely be selected by predominantly visual means);
- Aurally similar to a fairly high degree; and
- Conceptually similar to a fairly high degree.

Despite their "mild laudatory connotations", Puig's marks had at least a medium degree of inherent distinctive character, and its evidence confirmed that they had obtained a high degree of distinctive character. The HO therefore concluded that there would be direct (and

indirect) confusion in relation to the first two Puig marks (except in relation to household fragrances), and also in relation to the LADY MILLION EMPIRE mark.

OTHER OBJECTIONS

Given the very clear position taken on the likelihood of confusion, the HO did not consider the alternative grounds of opposition in detail, instead referring to a range of recent Appointed Person and Court decisions concerning procedural efficiency. This included BritanniaMed (BL O/173/19), in which the Appointed Person said the approach to this issue should be considered in an appropriate case. For the benefit of any appellate body, therefore, the HO set out only briefly the relevant case law and the basis of its decision, finding that the opposition had been made on those grounds.

KEY POINTS

It is important to consider which goods and services you should rely on during opposition proceedings, particularly for passing off – including during evidence rounds

This decision is a fairly standard assessment of the likelihood of confusion test in the context of consumer goods where the visual assessment is key

Procedural efficiency, and whether Hearing Officers should address all issues that require a finding of fact, requires consideration in an appropriate case

The HO took a very clear position on the likelihood of confusion



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A sobering decision

Robecca Davey details a win for Dame Vera Lynn



On 14th June 2018, Halewood International Brands Ltd (Halewood) applied to register the mark VERA LYNN for “alcoholic beverages (except beer); spirits” in class 33. Dame Vera Lynn (Dame Vera) opposed, relying on the grounds of passing off and bad faith, on the basis that celebrities are known to endorse products, and also noting that “Halewood had not sought her permission to use her name as a trade mark”.

PASSING OFF

In assessing whether the criteria for passing off had been met, both parties agreed that Dame Vera enjoyed goodwill in musical performances as well as charitable services.

Turning to misrepresentation, Halewood argued that none had taken place on the grounds that Dame Vera was not known for endorsing products. It also argued that VERA LYNN had become rhyming slang for gin, something that Halewood had not pleaded in its defence but had filed evidence of.

The Hearing Officer (HO) therefore had to decide whether a significant proportion of the relevant public (the general public of drinking age) would, upon seeing the mark VERA LYNN used in relation to an alcoholic beverage, think that Dame Vera had endorsed it. It was decided that, given the goodwill and well-known status of Dame Vera, a significant portion of the relevant public would call her to mind, so misrepresentation was established.

It followed then that damage would also arise, as Dame Vera’s ability to control her goodwill would diminish. This conclusion could not be overcome by Halewood limiting its specification to simply “gin”.

BAD FAITH

In support of the claim of bad faith, Dame Vera relied on the evidence of goodwill, stating that Halewood was clearly trying to exploit her good name and reputation. Halewood did not file evidence to disprove this claim, only the evidence that VERA LYNN

is cockney rhyming slang. While the burden of proof in a claim of bad faith initially falls with the party making the allegation, the Applicant’s intention when filing was fundamental to this claim and could not be proved by the Opponent. As such, the fact that Halewood provided no evidence that adequately explained its intention resulted in a finding that, on a balance of probabilities, it had filed in bad faith. The opposition therefore succeeded on both grounds.

TAKEAWAYS

This decision is another indication that well-known people may be able to prevent others from using their name, provided that all relevant criteria are met, despite the lack of image rights in the UK. It also shows that a passing off claim can be effective when a celebrity can show goodwill in their name and that the nature of the unauthorised use would create a false impression of endorsement.

Finally, it is a useful illustration of where the burden of proof may be reversed when an allegation of bad faith is reliant on evidence of an applicant’s intentions when filing.

KEY POINTS

✦ This case reiterates that a celebrity with goodwill in their name can rely on a passing off action to prevent unauthorised use of that name in a manner that would create a false impression of endorsement

✦ The burden of proof may be reversed when an allegation of bad faith relies on evidence of an applicant’s intentions at the time of filing



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One more Loch Ness mystery

Evidence of use was completely absent, says Paul Hegedus

These UK IPO invalidation proceedings, filed by Duncan Taylor Scotch Whisky Ltd (the Applicant), concern six trade mark registrations containing the words LOCH NESS (all for alcoholic products) in the name of Loch Ness Spirits Ltd (the Proprietor). The grounds for invalidation were based on s47(2)(b) and s5(4)(a) of the Trade Marks Act 1994.

The Applicant for invalidity argued it was currently a producer of Scotch whisky and other spirits and had used LOCH NESS WHISKY as one of its original (unregistered) brands since 2008, some seven years before the Proprietor. It claimed that the LOCH NESS WHISKY product was brought to market (and the mark had been used) by related companies of the Applicant called The Original Loch Ness Whisky Company Ltd and The Loch Ness Whisky Company Ltd (the Related Companies) under an implied licence. By virtue of this, the Applicant argued that it had acquired goodwill under the mark.

RETALIATION

In retaliation, the Proprietor put the Applicant to proof of this claimed goodwill and stated that the examples of use provided by the Applicant to illustrate earlier rights showed, if anything, use by the Related Companies rather than the Applicant. In particular, an extract from an online spirits retailing website from 2019 post-dated the start of these proceedings and was discounted by the Hearing Officer (HO).

In its observations, the Proprietor lodged evidence showing that there appeared to be no corporate connection between the Applicant and the Related Companies. Consequently, it argued that there was

no possible basis on which the Applicant could claim the benefit of any goodwill generated by the Related Companies. Curiously, the HO noted that in the Applicant's statements of account submitted for the period December 2007 to December 2016, there was no provision for the acquisition or amortisation of goodwill or any record of the Related Companies.

The Applicant's pleaded case was that

The Original Loch Ness Whisky Company Ltd was a wholly owned subsidiary of the Applicant and by virtue of this there was an implied licence. The Proprietor's evidence was able to show that this was not the case. In fact, the Applicant did not appear to have

ever owned shares in The Original Loch Ness Whisky Company Ltd. The Proprietor was also able to present evidence showing that The Original Loch Ness Whisky Company Ltd filed dormant company accounts between 2009 and 2016, the years leading up to the relevant dates.

Given all of this, it was the HO's assessment that the Applicant was not able to show that it was the owner of any goodwill generated from use of the LOCH NESS mark in relation to whisky and this was "sufficient reason" for the ultimate decision to reject the Applicant's invalidity claims.

“
The examples showed use by the Related Companies rather than the Applicant”

KEY POINTS

- ✦ The HO in this decision was quite critical of the Applicant's lack of evidence to substantiate its prior rights claims
- ✦ Invalidation applicants should heed this warning and ensure there is sufficient evidence available indicating prior use/ownership of unregistered rights before commencing invalidation proceedings



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Partial victory for Tiffany Parmar

This big brand wasn't all-powerful, writes Leanne Gulliver

Tiffany Parmar (the Applicant) applied to register the word mark COTSWOLD LASHES BY TIFFANY under UKTM 3305906 for goods and services in classes 3, 41 and 44 (the Application). The US-based luxury jeweller Tiffany and Co. (the Opponent) successfully opposed the Application under s5(2) of the Trade Marks Act 1994, but the Opponent's grounds under s5(3) and s5(4)(a) failed.

BACKGROUND

The Opponent opposed the Application on the basis that, contrary to:

1. Section 5(2)(b), the Application was confusingly similar to earlier registrations EUTM 13118872 for TIFFANY (class 3), EUTM 13118682 for TIFFANY & CO (class 3), EUTM 14816961 for TIFFANY (class 41), UKTM 1404785 for TIFFANY (class 14), and UKTM 404350 for TIFFANY & CO (class 14);
2. Section 5(3), use of the mark would take unfair advantage of and dilute the distinctiveness of EUTM 13118872, EUTM 13118682, UKTM 1404785, and UKTM 404350; and
3. Section 5(4)(a), holding that the Opponent had goodwill and reputation in its TIFFANY and TIFFANY & CO signs for jewellery, scents, body cleaning and skin-care preparations and use of the mark would lead to misrepresentation and cause damage.

PROOF OF USE

The Applicant requested proof of use of the Opponent's earlier UKTM 1404785 for TIFFANY (registered for all goods in class 14) and UKTM 404350 for TIFFANY & CO (registered for "Horological instruments; goods in class 14 made of precious metal or coated therewith, jewellery, imitation jewellery, precious stones and horological instruments"). The Opponent's evidence related to TIFFANY and TIFFANY & CO and demonstrated use of these marks for jewellery, watches and silverware.

The Hearing Officer (HO) found that use of the mark TIFFANY & CO is "effectively analogous" with use of TIFFANY.

No consumer would be in any doubt as to the origin of the goods.

Taking into account the evidence and the principles established in *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014], the HO held that a fair specification for both marks would be "jewellery; watches; silverware", and this is the specification the Opponent was able to rely upon in the s5(2)(b) ground of opposition.

DECISION

Given the similarity between the signs and the Opponent's earlier rights in classes 3 and 41, which were considered to be identical and similar to the goods and services covered by the Application, the HO held that a likelihood of confusion exists under s5(2)(b).

The opposition under s5(3) failed because the Opponent's evidence was insufficient to demonstrate that the marks possess a reputation. Even if the Opponent had demonstrated that, the HO considered that the average consumer would not immediately link goods in class 3 or services in classes 41 and 44 with the Opponent given the limited scope of that reputation (jewellery only).

The opposition under s5(4) failed as the evidence was insufficient to claim goodwill in "jewellery". However, the HO held that although the average consumer of the Applicant's goods and services may know of the Opponent, they will not equate cosmetics, training courses or beauty therapy with the Opponent because the Opponent has no business activities in such areas, and it is not usual for jewellers to branch out into such niche markets.



KEY POINTS

- ✦ A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because they have used it in relation to a few
- ✦ Where genuine use has been made of a mark in respect of goods or services covered by the wording of the specification, consider how the average consumer would fairly describe those goods or services
- ✦ Where evidence is filed to support a wide range of goods and services, it is necessary to indicate which parts of the evidence relate to which goods or services



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Opponent gets a roasting

Attacks on three fronts didn't help, explains Hannah Cramp

The Square Mile Coffee Roasters Ltd (the Applicant) applied for the mark shown below for, among others, training, education and publishing services in class 41 and the provision of coffee products in class 43. Classes 41 and 43 were opposed by Marriott Worldwide Corporation (the Opponent) on the basis of s5(2)(b), s5(3) and s5(4)(a) of the Trade Marks Act 1994. The Opponent relied on a UK registration in class 43 and an EU registration in classes 43 and 44 for its "Griffin mark" (shown below). Both were put to proof of use.

EVIDENCE

To support use of the UK registration, the Opponent relied on a decision of the Appointed Person which had upheld the Hearing Officer's (HO) finding that the registration had been genuinely used in relation to the class 43 services. This was accepted.

The Opponent's EU trade mark covered a broader specification that was supported by an EUIPO Board of Appeal (BoA) decision finding that the registration had been genuinely used. The HO did not find itself bound by this, because it was not clear whether the BoA had reviewed the same evidence as was before the HO in this

case. The EU mark was therefore restricted to the same specification as that of the UK registration.

This confirms that reliance on an EU BoA decision may not be sufficient in UK registry proceedings; without additional evidence, "the onus is on the opponent to prove its case".

SECTION BY SECTION

Following an interesting discourse on mythical creatures, the HO concluded that the marks were similar only to a low degree, taking into account the verbal elements of the application. A high degree of similarity was found between some of the services in class 43, but no similarity with respect to services relating to publishing and training in class 41. The provision of training to staff for the purpose of performing their contract did not equate to the provision of training services.

Weighing these factors together, the HO concluded that there would be no likelihood of confusion.

Regarding s5(3), the HO concluded that use of the Opponent's UK registration was geographically limited to one hotel and had been used in conjunction with its MARRIOTT brand. The HO therefore concluded that the evidence did not support there being a reputation.

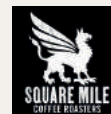
The HO did, however, conclude that the evidence related to s5(4) supported the Opponent having goodwill in its mark. That said, considering the low degree of similarity between the marks and that the Opponent's mark was used with the JW MARRIOTT name, the HO held that there would be no misrepresentation due to the visual differences between the marks. The opposition was dismissed in its entirety.

KEY POINTS

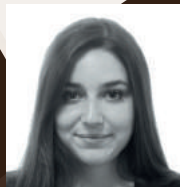
- ✦ Goodwill is separate to reputation
- ✦ Provision of training to staff for the purpose of performing their contract does not equate to the provision of training services
- ✦ Prior EU decisions alone may not suffice at the UK IPO without additional evidence

MARKS

APPLICANT'S MARK



OPPONENT'S MARK



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Amazon lacks convincing ring

Rose Smalley looks at the Court's reverse reasoning

The General Court (GC) has dismissed an appeal by Amazon Technologies (Amazon), upholding the partial refusal of Amazon's trade mark application for a figurative mark RING in class 9 (the Application).

The Application – specifying doorbells, motion sensors, video monitors and video cameras, among other things – had been partially rejected pursuant to Articles 7(1) (b) and (c) of Regulation 2017/1001 (the Regulation) by the Fifth Board of Appeal (BoA). Amazon's appeal centred on three pleas – distinctive character, descriptiveness and insufficient reasoning – which the GC examined in reverse order.

The relevant public (reasonably well-informed, observant and circumspect average consumers from a professional public with a high level of attention) and definition of “ring” (“to make a clear resonant or vibrating sound”) were not disputed.

INSUFFICIENT REASONING?

Amazon argued that the BoA had failed to give sufficient reasons for the refusal for all goods in question and for classifying the goods in one homogenous group.

The GC clarified that the BoA was permitted to use general reasoning for a homogenous category, provided the goods were “interlinked in a sufficiently direct and specific way”, such as through common characteristics relevant to the analysis of whether or not the ground for refusal applied. The BoA had explained the common link between the goods in question – their use for monitoring, security and surveillance, which could sound or ring when activated – so the GC held that Amazon's complaint on this front was unfounded.

The GC confirmed that the BoA had reasoned that “ring”, in relation to such goods, would inform the relevant consumer of the nature of those goods or indicate that those goods include an alarm system

producing a “clear resonant or vibrating sound”. The BoA's refusal was therefore substantiated under Article 94(1) of the Regulation.

DESCRIPTIVENESS

Amazon claimed that, as none of its goods had the purpose of producing a ringing sound (motion sensors detect movement; video cameras and monitors convey images; doorbells signal arrival), the mark is allusive at most. However, the GC upheld the BoA's decision, confirming that “ring” would inform consumers of the functionality of the goods, without further thought, and therefore was descriptive of the intended purpose of the relevant goods.

The GC also explained that the existence of alternative functions does not preclude the possibility of those goods including a ringing alarm. Similarly, the absence of a ringing alarm would not prevent the relevant public from perceiving its potential inclusion. It was a sufficient ground for refusal that one possible meaning for “ring” was descriptive of the goods in question. Regarding doorbells alone, the link between the mark and the very nature of the goods would be immediate.

DISTINCTIVE CHARACTER

In view of the finding that one absolute ground was applicable (as above), the GC did not need to examine Amazon's plea as to the distinctiveness of the mark.

KEY POINTS

- +
- The Court can collectively refer to a homogeneous group of goods or services, provided they are interlinked in a sufficiently direct and specific way, including by a relevant characteristic to which the absolute ground applies
- +
- Public perception of potential characteristics is more relevant than the actual characteristics of the goods or services when considering the descriptiveness of the mark

MARK

THE AMAZON APPLICATION

ring



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 Co-authored by Lewis Sanderson, Trainee Solicitor at Womble Bond Dickinson.

N is for no

Eleni Mezulanik puzzles out why a mark received partial registration

SSC NAPOLI SpA (the Opponent) filed an opposition against EUTM Application No. 016046583 (shown below) in classes 18, 25 and 35 against all goods/services in the name of Aicha Oucheikh (the Applicant).

The opposition was based on Italian Trade Mark Registration No. 1449489 (the First Mark); Italian Trade Mark Registration No. 1140263 (the Second Mark); and IR No. 992435, designating protection in the EU (the Third Mark). All marks are shown below.

The goods and services relevant to the marks at issue were found to be identical or similar (to varying degrees) and were directed at the public at large for classes 18 and 25 and at the professional public with specific knowledge and experience for some of the services in class 35.

Comparing the contested mark to the First and Second Mark, no elements could be considered clearly dominant, although all marks share the single letter “N”. The First Mark was held to be visually similar to an average degree and the Second Mark was held to be visually similar to a low degree to the contested mark. Aurally and conceptually, the contested mark was held to be identical to the First and Second Mark.

The Opponent claimed reputation in relation to “clothing, footwear and headgear” in class 25 and “sporting activities” in class 41. The evidence as filed did not demonstrate that the First Mark had acquired an enhanced degree of distinctiveness or reputation through use. However, the Second Mark had been used consistently and intensively together with the names ‘SSC Napoli’ or ‘Napoli’. Such use showed that the Second Mark enjoyed a high degree of recognition among the relevant public. Nonetheless, the evidence succeeded in showing only that the Second Mark had acquired a reputation for “sporting activities” in class 41 and not all goods/services.

It was held that the First Mark had an average degree of distinctiveness and that the Second Mark had acquired a reputation in class 41 and had a normal degree of distinctiveness in relation to the remaining goods/services. There was a likelihood of confusion on the part of the public, and the opposition was partly well

founded on the basis of the First Mark. As such, the contested mark could have been rejected for the goods found to be identical/similar.

However, it was held that the “considerable differences” in the colour arrangement and double rings of the Second Mark would enable the

relevant public to distinguish the marks, even for identical and similar goods. The Third Mark was held not to be confusingly similar to the contested mark as it contained verbal elements in addition to those of the Second Mark.

With regard to reputation, it was held that “sporting activities” and “clerical services” were different, and it would be unlikely that the relevant public would make a mental link between the contested mark and the Second Mark. Further, the contested trade mark was likely to take unfair advantage of the distinctive character or the repute of the earlier mark. The contested mark was therefore rejected for all goods/services with the exception of “clerical services”.

“
No elements could be considered clearly dominant, although all marks share the single letter ‘N’”

KEY POINTS

✦ According to the General Court, a single letter or numeral may be inherently distinctive. Only when the later trade mark causes a sufficiently different visual impression can a likelihood of confusion be safely ruled out

✦ Absence of any of the three requirements of Article 8(5) EUTMR (identity/similarity, prior reputation, risk of injury) will lead to the rejection of the opposition

✦ Even if the requirements are fulfilled, an opposition may still fail if the applicant establishes due cause for the use of the contested trade mark

MARKS

EUTM APPLICATION NO. 016046583



ITALIAN TRADE MARK REGISTRATION NO. 1449489



ITALIAN TRADE MARK REGISTRATION NO. 1140263



IR NO. 992435



SSC NAPOLI



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First UK test for Cofemel

EU alignment on artistic works has been left in doubt, suggests Caspar Rebling

Here, Response Clothing Ltd (Response) sued The Edinburgh Woollen Mill Ltd (EWM) for copyright infringement, claiming that a “wave arrangement” jacquard fabric design is protected as an artistic work under s4 of the Copyright, Designs and Patents Act 1988 (CDPA).

The key question considered was whether the wave arrangement is protected as a “graphic work” or “work of artistic craftsmanship”. Having concluded that the definition of a graphic work could not be extended to include a fabric design, His Honour Judge Hacon reviewed relevant case law related to the latter designation.

Finding *Hensher*¹ inconclusive on the appropriate standard of assessment, HHJ Hacon turned to the test laid out in *Bonz*, that the individual making the fabric should be “both a craftsman and an artist, [where a] craftsman is a person who makes something in a skilful way and takes justified pride in their workmanship. An artist is a person with creative ability who produces something which has aesthetic appeal.”² HHJ Hacon concluded that the wave arrangement could qualify for protection under that test.

EU ALIGNMENT

HHJ Hacon noted the *Marleasing* principle: to interpret UK copyright law, where possible, in line with the EU Copyright Directive and the Court of Justice of the European Union’s interpretation. He found that it is possible to do so only to a certain extent when assessing a work of artistic craftsmanship.

The *Cofemel* decision stated that EU Member States cannot through national law impose a requirement of aesthetic or artistic value.³ The only requirements were for the work to be original and an expression of the author’s free and creative choices. HHJ Hacon noted that English case law may conflict with EU law here. In the *Bonz* test (also referred to in *Lucasfilm*), aesthetic appeal is clearly a limb for assessing a “work of artistic craftsmanship”. Since the wave arrangement fabric did

have artistic appeal and qualified for protection under both CDPA and the Copyright Directive, HHJ Hacon decided it was unnecessary to apply *Cofemel*.

The claim of primary infringement was dismissed. However, having found that the garments supplied by other firms to EWM were infringing copies of Response’s wave arrangement, EWM’s possession and sale of such copies in the course of business constituted an act of secondary infringement.

POINTS OF INTEREST

This is the first UK case that considers the *Cofemel* decision on the definition of “artistic works”. Two interesting points are raised. First, this case suggests that English law on what qualifies as “works” of artistic craftsmanship conflicts with recent EU case law. While *Cofemel* clearly precludes the requirement for “artistic or aesthetic appeal”, English case law still considers this element in the assessment. Second, if HHJ Hacon did not find the wave arrangement to have “aesthetic appeal”, following *Cofemel*, it is worth considering whether it would have been granted protection, seeing as it was found to satisfy the definition for “original” work.

1 *George Hensher Ltd v Restawhile Upholstery (Lancs) Ltd* [1976] AC 64

2 *Bonz Group (Pty) Ltd v Cooke* [1994] 3 N.Z.L.R. 216

3 *Cofemel* (C-683/17)

KEY POINTS

✦ The judgment indicates that English law may be incompatible with EU case law in relation to the definition of “artistic craftsmanship”

✦ The judge did not specifically address the apparent conflict between the exclusion of the aesthetic appeal requirement and UK law



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Cheesemaker sees red

David Birchall examines a recent decision regarding specifying colour elements of marks

In 1997, Fromageries Bel SA (FBSA) obtained a UK trade mark registration for the mark shown opposite, for which the following description was entered on the UK IPO's register: "The mark is limited to the colour red. The mark consists of a three-dimensional shape and is limited to the dimensions shown above".

In order to be registrable as a trade mark, a sign must, under s1(1) and s3(1) of the Trade Marks Act 1994 (the Act), be capable of being represented in a manner which enables others "to determine the clear and precise subject matter of the protection afforded to the proprietor".

INVALIDITY ACTION

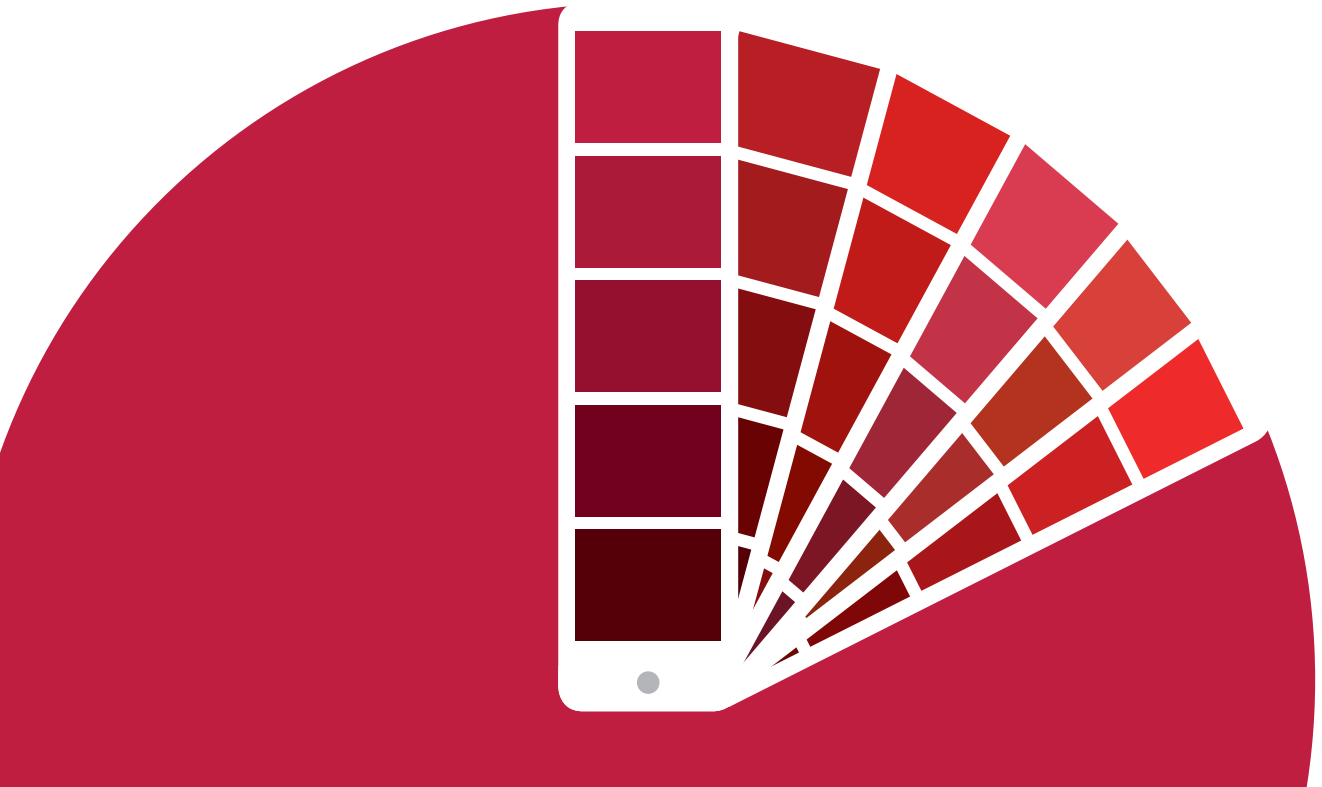
J Sainsbury plc (Sainsbury's) applied to invalidate FBSA's registration on the basis

that, *inter alia*, the mark did not satisfy the requirements of s1(1) of the Act because the phrase "the colour red" in the description did not provide sufficient clarity and precision.

The Hearing Officer (HO) considered the Sieckmann criteria¹ and then assessed the essential characteristics of the challenged trade mark. The colour red was found to be an essential characteristic.

The HO agreed that there was scope to question whether the protruding parts of the cheese casing (seen on the left-hand side of the image opposite) qualified under the description "red", but ultimately accepted that they did.

Next, the HO considered whether the colour red was defined with sufficient clarity and precision, referring to the judgment in *Libertel*² and the practice of using recognised colour



identification codes. The HO opined that the Libertel requirements apply to all marks for which colour is an essential characteristic.

The HO considered three alternative sources for the primary indication of the subject matter of a trade mark: (i) the written description; (ii) the picture; or (iii) neither.

The HO held that “the colour red” wording did not satisfy the Libertel requirements. The HO also held that the absence of colour identification codes in FBSA’s registration meant that the colours were not represented in an objective and durable manner. On this basis, FBSA’s registration was declared invalid.

BASIS OF APPEAL

FBSA appealed the invalidation decision, arguing the following three separate bases: (i) the Sieckmann criteria should be applied in a different way depending on the type of mark (for example, the colour in a mark like FBSA’s might not need to be defined with as much precision as in a registration of a colour per se); (ii) not interpreting the mark as being limited to the pictorial representation was an error; and (iii) FBSA should be allowed, under s13(1) of the Act, to limit the rights conferred by its registration to Pantone No 193C.

FBSA filed new evidence, including evidence of many other registrations on the UK IPO register which it argued must necessarily be likewise invalid. Sainsbury’s challenged the admissibility of the new evidence but the Court ultimately agreed to it being introduced.

FBSA argued that there are two types of colour mark: one where the colour is the only essential characteristic of the mark and another where it is not. The UK IPO wrongly categorised the mark as belonging to the first category, FBSA argued, explaining that the colour red was not the only essential characteristic of the mark and therefore it did not need to be defined with such precision.

The Court held that there was a connection between the Sieckmann criteria and the requirement that the mark be capable of distinguishing the goods of one undertaking from those of another. It determined that use of a colour code is liable to assist not only in meeting the Sieckmann criteria but also in ensuring that the mark is capable of distinguishing goods.

The Court picked out two registrations from the list of UK registrations, all of which FBSA argued would be invalid on the basis of the decision under appeal. One was a stylised version of COCA COLA and the other a stylised version of TESCO. The description of the former mark is: “the applicant claims the colours red,

silver, white and yellow as an element of the mark”. The description of the latter mark is: “the applicant claims the colours red and blue as an element of the mark”. The Court held that the precise hue would be unlikely to play a significant role in either of these marks’ capacity to distinguish and that a variation of the hue would not necessarily affect their ability to distinguish.

The Court held that the real question was whether FBSA’s mark was capable of distinguishing FBSA’s cheese from the cheese of others if the hue used is any hue of red which FBSA chooses to use from time to time. On this point, the Court concluded that, on the balance of probabilities, FBSA’s mark could only be capable of distinguishing if a specific shade of red used on the main body of the products is associated with FBSA’s cheese. FBSA’s first ground of appeal therefore failed.

The Court also rejected the second ground of appeal – that the registration should be limited to the pictorial representation provided.

In relation to the third ground of appeal, the Court referred to the 2004 decision regarding an application to register the three-dimensional shape of a Polo mint, in which it was held that it was not appropriate to introduce colour-related details which would make a mark distinctive and registrable via a limitation under s13(1) of the Act. The Court agreed with the finding in that case that there was an important distinction between a limitation which narrows the scope of acts that would infringe a trade mark and a limitation that would affect the description of the mark itself.

The Court held that limiting the colour of FBSA’s registration to Pantone 193C would not simply limit the rights conferred on FBSA under s9(1) of the Act but would affect the description of the mark itself. On this basis, the Court refused FBSA’s request to do so. The appeal therefore failed in its entirety.

The decision is a reminder of the advisability of regularly reviewing the validity of trade mark registrations in the light of clarifications provided by case law.

1 Sieckmann v Deutsches Patent und Markenamt (C-273/00)
2 Libertel Group BV v Benelux – Merkenbureau (C-104/01)

KEY POINTS

- There is no rule that the pictorial representation of a mark takes precedence over a description
- Under s13(1) of the Trade Marks Act 1994, the owner of a mark can agree to a specific limitation
- Amendments cannot be made to the description of a mark through a limitation

MARK

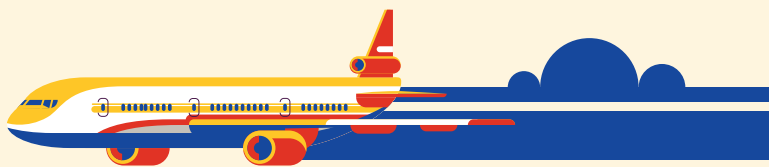
FBSA’S REGISTRATION



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A frank discussion



The Court found a failure to disclose all material facts fairly, says Justin Bukspan

The first Defendant was a Colombian airline providing domestic flights in its country, trading under the “EasyFly” name (a partial acronym of its registered name, Empresa Aérea de Servicios y Facilitación Logística Integral SA). The Second Defendant was the director of the company. The Claimant, easyGroup, owner of the ubiquitous “easy” family of marks including “easyJet”, complained that EasyFly had:

- Allowed UK-based customers to book tickets from its website, easyfly.com.co, although that site was fully in Spanish and displayed prices in Colombian pesos;
- Displayed the EasyFly logo (opposite), which was predominantly orange and blue, on the site;
- Sent marketing emails bearing that EasyFly logo to UK consumers who had provided their contact details;
- Commissioned similarly branded aircraft from French supplier ATR, which had carried out test flights in France before delivering the planes; and
- Allowed a press release from ATR to be made available at the Farnborough Airshow 2018, although there was no evidence that any of the 15 copies produced had been picked up.

An action for infringement of its registered trade marks and passing off was filed by easyGroup. Because the Defendants did not have a place of abode in the UK, easyGroup applied without notice for permission to serve the Defendants out of jurisdiction in Colombia.

In addition, the Claimant sought to add ATR as a Third Defendant, which was granted initially but dismissed by Mr Justice Nugee *set aside*, claiming that there were deficiencies in the application.

Indeed, several requirements needed to be satisfied, and they were reviewed by the Court.

They included the need for a serious issue to be tried (CPR 5 6.36, Practice Direction 6B, paragraph 3.1, and case law) and the requirement for “full and frank disclosure” (White Book (Civil Procedure 2019), paragraph 6.37.4). Thus, Nugee J reviewed whether the alleged facts could arguably constitute trade mark infringement in the UK and the EU and passing off in the UK, and then he reviewed whether “full and frank disclosure” had indeed taken place.

TRADE MARK INFRINGEMENT?

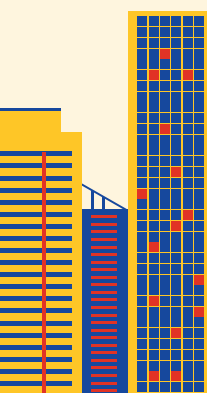
Nugee J reviewed whether the facts, as presented in the statement of case and the witness statement written by easyGroup’s solicitor, would support an arguable case for trade mark infringement and passing off.

As regards the website, it was noted that while easyfly.com.co could be accessed anywhere in the world, the case law stated that it actually had to be targeted at the UK. Notably, the site was in Spanish, with prices in Colombian pesos.

On the other hand, although the flights offered were exclusively within Colombia, any advertising and sales to UK customers would constitute use of the mark in the relevant jurisdiction. Thus, the marketing emails, the ticket sales and the press release at the air show were possible infringing uses of the mark.

The Defendants claimed that the presence of “EasyFly” on the press release amounted to the insertion of a corporate name. Nugee J highlighted that it was arguable here that a link had been established between that sign and the airline services provided, and thus it could have been a form of advertising. Further, the use of “EasyFly” there may have affected the function of easyGroup’s marks, and it could be argued that seeing EasyFly in the press release could be interpreted as meaning that the airline services had an origin associated with easyGroup.

Likewise, the painting and flying of the planes (in full view of the public) before they were delivered to Colombia – even if the aircraft were only test-flown in France without any passengers



“ *The ambiguous phrases left the position unclear and may have unwittingly misled the lower court* ”



on board – was a form of branding and advertising.

There was therefore an arguable case for trade mark infringement.

PASSING OFF

There was no question that easyGroup had goodwill in easyJet and its family of “easy” marks in the UK, the first requirement for passing off. There was an arguable case that the Defendants’ use of its signs could constitute misrepresentation that its services were associated with easyGroup, which would cause damage to the Claimant because of dilution of its brand. The absence of actual evidence of confusion among UK consumers and of damage did not prevent there being a serious issue to be tried. The possible loss of control by easyGroup of its brand was an important concern and the matter did raise triable issues.

FULL AND FRANK DISCLOSURE

It was argued that there had been procedural failings, the most important of which was the failure to make full and frank disclosure of facts material to a without-notice application, as required in the White Book (Civil Procedure 2019).

The evidence provided by the Claimant was in a witness statement drafted by its solicitor. It stated that EasyFly’s services were “inferred [to be] sold to persons wishing to travel from London, or other airports in the EU, to Colombia”. A natural reading of that statement would be understood to mean that EasyFly might be offering flights from London or the EU to Colombia, while the intended meaning was that travellers from London or the EU to Colombia could purchase internal Colombian EasyFly flights before their departure. Likewise, the particulars of the claim included the statement that the Defendants “offered passenger airline services [...] in the European Union and/or the UK”. While the witness statement contained as an exhibit a letter on behalf of the Defendants

stating that EasyFly did not operate services into or out of the UK or the EU, a judge could not be expected to pick something from the exhibits unless it had been pointed out to him; material facts had to be explicitly drawn to his attention, as stated in the White Book.

Likewise, stating that the Defendants’ website and Facebook page were “accessible” to customers in the UK and EU, without pointing out that they were all in Spanish or that prices were only in Colombian pesos, confirmed Nugee J’s position. The fact that the tickets were available to UK and EU customers through a broker and not via direct sales, and that the business was entirely Colombian, should have been highlighted.

That amounted to a failure to disclose all material facts fairly. It was probably not deliberate, but the ambiguous phrases did “leave the position unclear and may have unwittingly misled” the lower court.

On that basis, Nugee J set aside the order for permission to serve out of the jurisdiction. Thus, easyGroup would have to reapply for permission at a later date.

KEY POINTS

- + An order to serve out of jurisdiction requires adherence to very high procedural standards by the claimant
- + The requirement for full and frank disclosure does not just mean making the relevant information available to a judge – it must also be easy to understand from a “natural reading”

MARK

THE EASYFLY WEBSITE LOGO



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Clear ride for Red Bull

Free-riding was evident, reports Charlotte Wilding

Here, Big Horn UK Ltd, Voltino EOOD and Lyubomir Enchev (the Defendants) were alleged to have infringed the registered EU trade marks of Red Bull GmbH (the Claimant). However, the judgment concerns the First and Third Defendants only, as judgment against the Second Defendant was issued in October 2019.

CASE BACKGROUND

In February 2018, Red Bull brought infringement proceedings against the Defendants on the basis that they used signs similar to Red Bull's trade marks on energy drinks and bottled water in the UK and EU (Articles 9(2)(b), (c) and 9(3)). The First Defendant, Big Horn UK Ltd, is a UK company set up by the Third Defendant, Mr Enchev (the sole director), in May 2017 to sell the goods that were the subject of these proceedings.

In August 2016, the Second Defendant filed an EU trade mark application for a device depicting two rams (see right), which Red Bull opposed (registration refused on 7th January 2019). However, Big Horn energy drinks began to be sold in the UK and Bulgaria regardless. Red Bull's test purchases found the cans used were identical in shape and size to its own.

As the First and Third Defendants did not serve any witness evidence or disclosure, the precise nature of their involvement with the Second Defendant was unclear. At trial, Mr Enchev said he started negotiations with the Second Defendant in April 2017 to be a distributor of Big Horn energy drinks. A

contract (undisclosed) was entered into in May 2017 and terminated on 1st March 2019 (although advertising was ongoing after termination). However, it is not disputed that the First Defendant imported and sold energy drinks in the UK and Mr Enchev was the "controlling mind".

ARTICLE 9(2)(C)

Given the marks cover the same goods and are visually and conceptually similar, the judge found that the Big Horn signs would cause the average consumer to link those signs with Red Bull's trade marks. As there was no evident due cause, use of the Big Horn signs took unfair advantage of the distinctive character and reputation of Red Bull's trade marks.

The judge held: "It is quite evident that Big Horn's signs have been designed so as to enable Big Horn to free-ride on the reputation of Red Bull, and to benefit from the very considerable marketing efforts of Red Bull to create a particular image associated with its trade marks."

ARTICLE 9(2)(B)

The judge declined to consider likelihood of confusion in detail, but said he "would not have been persuaded that the Big Horn signs give rise to a likelihood of confusion... Rather, it [is] far more likely that the average consumer would perceive the Big Horn products as cheaper or alternative versions of Red Bull's products, stimulating sales of the former in a way that would not have occurred had the Big Horn signs not evoked so directly the visual and conceptual forms of the Red Bull trade marks".

Accordingly, the Big Horn signs were found to infringe Red Bull's rights. Being sole director, Mr Enchev was also liable as a joint tortfeasor.

KEY POINTS

- ★ A finding of unfair advantage to the distinctive character or reputation of a mark does not necessarily also mean that there is a likelihood of confusion
- ★ A sole director runs a high chance of being found liable as a joint tortfeasor

MARKS

RED BULL
EUTM NO. 3629342



EUTM NO. 52746



BIG HORN



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Calendar

An important update on our future events programme

Like other organisations in the UK, we've taken the decision to suspend all in-person events until at least 30th June 2020. We will continue to monitor the situation and will keep you regularly updated on our events programme through our member communication channels.

In the meantime, we will be providing you with more online opportunities, including an increase in webinars and digital learning.

Several of the talks that were unable to go ahead at our Spring Conference will be available to watch as webinars. Our Spring Conference webinar specials will provide you with a cutting-edge perspective on global intellectual property.

We continue to be committed to making sure you have a full events programme so you can continue to earn CPD and develop your knowledge.

You can also earn CPD by watching recordings of our past events. All the events with the "play" symbol in the events archive on our website are viewable. Visit citma.org.uk/events

We will also be regularly adding new events to our calendar. Again, you can view what is coming up and book at citma.org.uk/events

Thank you for your support during this time. We look forward to the full resumption of our events programme in due course.



THE TRADE MARK 20

Q&A

SONOS

Scott Gardiner

is cautiously optimistic

I work as... an Associate, Chartered Trade Mark Attorney at Clyde & Co in Dubai, UAE.

Before this role, I was... working as a Chartered Trade Mark Attorney in the UK.

My current state of mind is... cautiously optimistic. Of course, recent global events have caused significant social and economic disruption. They have, however, also shown that, through innovation, we will always find new ways of staying connected.

I became interested in IP when... as an undergraduate law student, I helped the UK IPO deliver a summer exhibition intended to inspire innovation and educate young people about the role and value of IP. It also involved me dressing as one half of the famous animated duo Wallace and Gromit.

I am most inspired by... my cousin Emma who, despite ill health, is one of the most positive people I know.

In my role, I most enjoy... my varied duties and responsibilities and the many household brand names that I have the privilege of working with.

In my role, I most dislike... almost all tasks involving numbers!

On my desk is... my iPhone, the latest edition of *Evo* magazine (for supercar enthusiasts) and a (cold) cup of coffee.



“

My Arabic is very much a work in progress!

My favourite mug says... “Sunderland AFC – Consectatio Excellentiae” (the English language translation being “in pursuit of excellence”). It goes without saying that, despite this having been the club’s motto for some time, excellence has so far eluded my favoured football team.

My favourite place to visit on business is... Barcelona – if not for its architecture and seemingly never-ending meandering streets, then definitely for its food and drink.

In my pocket is... a Paul Smith pen – a leaving present from colleagues at my previous firm.

If I were a brand, I would be... SONOS. Its technology is innovative, intuitive and reliable – all desirable qualities for a Trade Mark Attorney.

The biggest challenge for IP is... AI and understanding how, as a profession, we can use it to enhance the service that we provide.

The talent I wish I had is... the natural ability to speak other languages. My Arabic is very much a work in progress!

I can’t live without... my family and friends. The events of recent weeks have reminded me of this.

My ideal day would include... breakfast overlooking the Persian Gulf followed by a ‘spirited’ drive to the summit of Jebel Jais in time for sunset.

The best piece of advice I’ve been given is... “do unto others as you would have them do unto you”. So far, it has served me well.

When I want to relax I... put on my favourite album and open a bottle of my favourite beer (London Pride, for anyone buying).

In the next five years I hope to... resume my travel plans. South Africa is next on my list.

The best thing about being a CITMA member is... the opportunities it provides for learning and the friends you make along the way.

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