

CITMA REVIEW

ISSUE 453 OCTOBER/NOVEMBER 2019

Off the mark

*How can we avoid
treading on tradition?*

+

**THE THREAT
FROM 3D
PRINTING**
P8

**SPAIN'S IP
CHANGES**
P12

**BENELUX
REPORT**
P20



The one for your one in a million brand

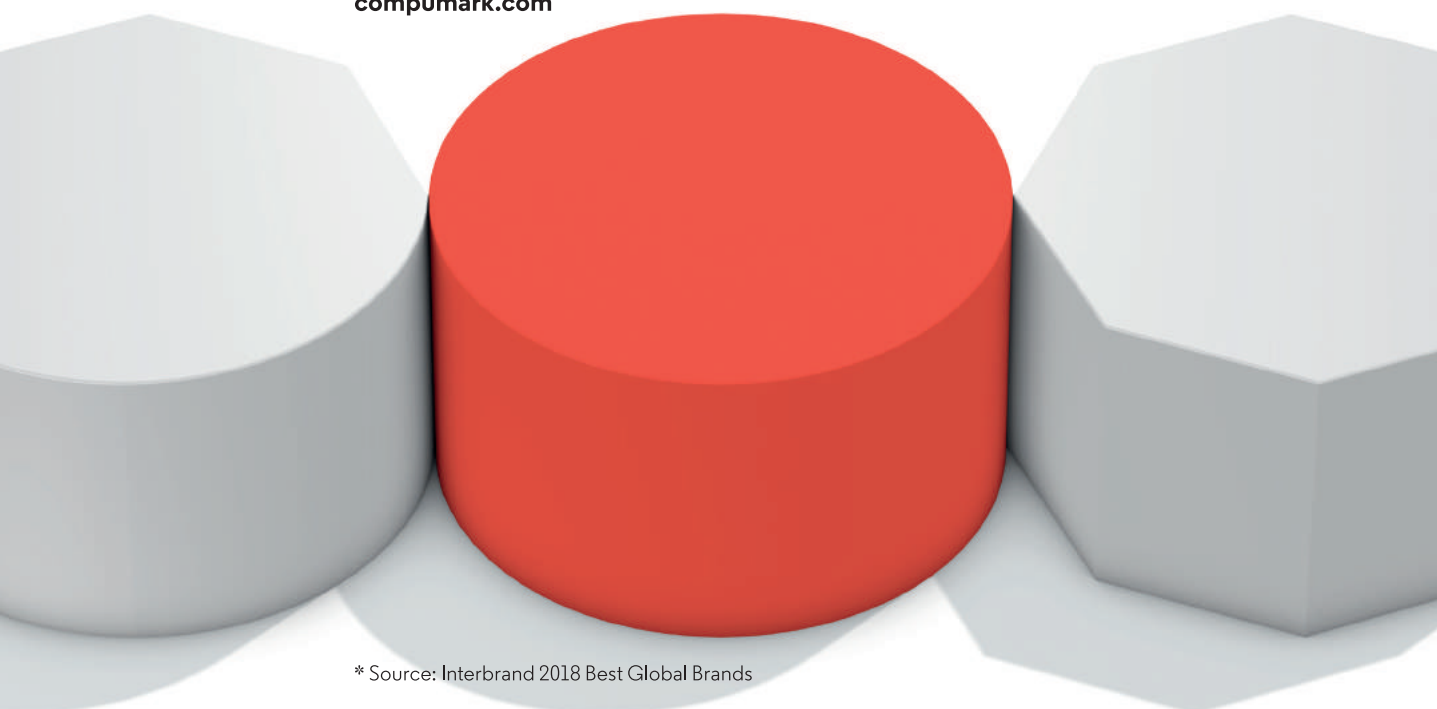
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* Source: Interbrand 2018 Best Global Brands

WELCOME & CONTENTS



Tania Clark
CITMA President

“
Why not publicise CITMA by giving your contacts and clients copies of the Review?”

Autumn is upon us and we begin the run-up to our great social events of the year: the Christmas lunches on 13th December in London and on 6th December in Leeds.

Meanwhile, the renown of the *Review* extends far and wide. A delegation from CITMA attended meetings at WIPO in Geneva recently and the heads of department commented on the quality of our case comments. We discussed Madrid and Hague and problems encountered by our members; WIPO will address these over the coming months.

We encourage our overseas members to contribute to the *Review*. This issue, we have articles from Spain, Benelux and Singapore. On your next business trip, why not publicise CITMA by giving your contacts and clients copies of the *Review*? Contact the CITMA office for copies.

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REGULARS

- 4 Insider *News updates and member moves*
- 41 Events *What's coming up for members*
- 42 TM20 *Pollyanna Savva is inspired by efforts aimed at sustainability*

FEATURES

- 6 Enforcement *Colin Hulme examines a potential cause for embarrassment*
- 8 Technology *Thomas Prock assesses the current threat level posed by 3D printing*
- 12 Spain *Luis-Alfonso Durán unpicks the significant changes to the kingdom's IP regime*
- 14 TCEs *Guidance is needed to help businesses avoid missteps with traditional marks, writes John Swinson*
- 20 Benelux *Michiel Haegens summarises the primary provisions of a widely used trade mark system*
- 24 Singapore *Denise Mirandah explains why an unusual request was denied*

CASE COMMENTS

- 26 [2019] EWHC 2003 (IPEC) *A high-end hotel defends a valuable reputation, writes David Birchall*
- 28 [2019] EWHC 1902 (IPEC) *Emily Scott reviews a transfer from Small Claims*
- 29 O/345/19 *Lizzie Sergeant dishes up a dose of reality*
- 30 O/363/19 *The Applicant wasn't allowed to rock on, explains Louise Foster*
- 31 O/367/19 *Disputes can emerge from political fall-outs, says Sarah Talland*
- 32 O/372/19 *Dale Carter has a bone to pick with the HO here*
- 33 O/418/19 *Peter Collie presents an interesting face-off*
- 34 O/442/19 *Linkage would lead to unfair advantage, writes Désirée Fields*
- 35 000015250 C *The Applicant was reaching for the moon, reports Paul Hegedus*
- 36 000022229 C *A diamond mark is not forever, says Rebecca Campbell*
- 37 B 3 024 158 *Patrick Cantrill awaits the next steps in this dispute*
- 38 B 3 048 470 *The choice to abandon an opposition ground is examined by Ryan Kellingray*
- 39 B 2 686 593 *Amelia Skelding reviews a case of turtle trouble*
- 40 C-124/18P *Red Bull's colour combination came up short again, reveals Chris Hawkes*



USPTO acts on residency concerns

There has been a great deal of publicity about a recent change of practice at the USPTO in relation to representation in respect of US trade mark applications. In August, the USPTO implemented rules requiring all applicants based outside the US to use attorneys licensed in the US to file trade mark applications and to prosecute them. This was intended to address allegations of fraud by a number of Chinese applicants in the context of the requirement to file proof of use of a mark in order to obtain registration.

This was a controversial step, resulting in some USPTO examiners apparently requesting evidence of a street address of an applicant, making

the process unreasonably close to an immigration status check.

Subsequently, as recently reported by *World Trademark Review*, the USPTO has made extensive revisions to the relevant examination guide (*Examination Guide 4-19*) to try to allay concerns and to clarify the situations in which an applicant will have to prove that it has the right to file an application without professional representation, by virtue of being resident in the US. Readers can visit bit.ly/453_USPTO to access the guide.

An article by a US trade mark practitioner discussing this issue in further detail will appear in a future edition of the *Review*.

UK IPO REPORTS ON LATEST PROGRESS

The UK IPO's annual report and accounts for 2018/19 include information on how it is meeting its key targets. According to the report, the UK IPO:

- achieved an overall customer satisfaction rating of 87.5 per cent;
- engaged with more than 90,000 businesses and over 80 per cent of them felt able to make an informed decision about their IP;
- processed record levels of trade marks and design applications;
- successfully implemented the EU Trade Mark Directive, the Portability Regulation and the Marrakesh Treaty;
- set out a new international strategy and established the first IP crime forum in Brazil; and
- was named one of the most inclusive employers in Britain by LGBT equality charity Stonewall and featured in its 2019 Top 100 Employers list.

Access the full report at gov.uk/government/publications/

GET A LEG-UP WITH LITIGATION

Fine-tune your expertise in conducting litigation in the IPEC and High Court by enrolling on the Nottingham Law School Intellectual Property Litigation course. Places are still available for the 14th November start date, so there's no need to wait.

Find out more at ntu.ac.uk

THE CITMA SPRING CONFERENCE IS COMING

The CITMA Spring Conference 2020 is confirmed for 19th–20th March 2020, held at IET London: Savoy Place.
Watch citma.org.uk for further details

SINGAPORE MAKES REGISTRATION MOBILE

The Intellectual Property Office of Singapore (IPOS) has introduced the world's first trade mark registration mobile app, IPOS Go.

The app will allow businesses and entrepreneurs to file their trade marks directly via their mobile devices, according to the IPOS press office.

IPOS explained that: "Filing a trade mark on IPOS Go can now be finished in less than 10 minutes, from the current average of 45 to 60 minutes. Filing costs will also be significantly reduced, as applicants may feel more confident in filing their applications directly with IPOS."

The Office also noted that: "In Singapore, trade mark applications have increased by 30 per cent over

the past five years. The speed and ease of filing will benefit the increasing number of enterprises and entrepreneurs who need a good branding strategy to differentiate themselves from their competitors. Applicants can also track their registration status, be notified of important updates or file for trade mark renewals via the app."

Notably, IPOS Go integrates AI technology to enhance searches for similar trade marks on the IPOS register. It's a feature, IPOS said, that is "essential as more than 40 per cent of the world's trade marks filed today contain images. As the world continues to see a surge in trade marks filings, the AI capability will help business owners better manage their brands."



Madrid e-Renewal gets a makeover

WIPO's new Madrid

e-Renewal services replaced the former offering from 1st August 2019. The enhanced service includes the following key features:

- WIPO account login: renew online with better traceability.
- A modern and dynamic look: an engaging and intuitive user interface.
- Greater clarity: easier selection of contracting parties and goods and services. All renewal scenarios are covered.
- Instant tracking: get a unique WIPO reference number in a confirmation email and a printable summary so you can check renewal status quickly and easily in Madrid Monitor.

Find out more at wipo.int

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The shame game

Colin Hulme questions whether cease-and-desist letters need to be a cause for embarrassment

Nobody wants to be shamed in public. Even less so if the audience includes your client and your peers. Yet this is the risk we run every time we issue a cease-and-desist letter on behalf of a client.

But what is there to be embarrassed about? Your client has invested in its brand and registered a trade mark, and your analysis shows a clear infringement. Back in the day, that would have been it. Threats of going to the press were often empty or, following scrutiny by responsible journalists, came to nothing. But now that the ability to broadcast a grudge to the world is just a tweet away, these threats cannot be disregarded so easily. A well-placed post on social media by a sympathy-worthy infringer claiming bullying by a big brand name can easily get traction. That traction can itself become a newsworthy story and get picked up by the press, even if the initial cause that prompted the letter was not.

Indeed, on paper, we're not doing anything wrong. The USPTO defines a trade mark bully as a "trade mark owner that uses its trade mark rights

to harass and intimidate another business beyond what the law might be reasonably interpreted to allow". I hope none of us would use trade marks as tools of harassment or intimidation. However, assertively pursuing a client's trade mark claim might well be perceived by the alleged infringer as harassment or intimidation – particularly if they are unrepresented.

It is worth considering what is meant by "beyond what the law might be reasonably interpreted to allow". I think it is directed towards the practice of issuing weak or unstateable claims of trade mark infringement, particularly against a smaller entity.

Another definition of bullying that I have found is the act of "seeking to harm, intimidate or coerce (someone perceived as vulnerable)". That seems to fit. A large corporate issuing a weak claim of trade mark infringement against an SME would not merely be notifying the SME about the larger company's trade mark rights, but also seeking to intimidate. SMEs in such circumstances may lack the time or financial resources to cross swords with such larger corporates.



“

The trade mark bullying tag might be used in the media against any rights-holder seeking to enforce its rights in a legitimate fashion



Of course, there is a distinct problem of trade mark enforcement abuse to acknowledge. The 2011 USPTO Trademark Litigation Study commented that “most of the direct respondents claimed at least some degree of first-hand knowledge of instances where unduly aggressive trade mark litigation or pre-litigation tactics (eg cease-and-desist letters) were targeted at small businesses”.

However, the extent to which this goes on is unclear. The vast majority of such bullying letters will be quietly complied with sooner or later, with the claim never being aired in court or in the media. It is suggested that the problem can be cost-effectively policed by shaming, overbearing rights-holders who throw their weight around, but

relatively few small businesses receiving such letters will want to do so. I expect the thought of taking on a commercially powerful corporate with its own media relations team will seem daunting enough.

I think the greater risk is of something short of real trade mark bullying: a normal cease-and-desist letter on behalf of a big-brand client being put into the public domain by that sympathy-worthy recipient. My concern is that the trade mark bullying tag might wrongly be used in the media against any rights-holder seeking to enforce its rights in a legitimate fashion. This can place trade mark holders in a difficult position. They need to positively enforce their trade mark rights for fear of losing or diminishing them, but in doing so can be criticised. Large brands finding themselves in this situation can expect little sympathy from the general public.

How can we manage this risk? First, it is important to have a grown-up conversation with your clients so that they are fully aware of the potential consequences of sending a cease-and-desist letter. Forewarning your client makes managing any consequences a great deal easier.

You do have to pick your battles when you can. If you have the luxury of doing detailed due diligence and discover that the infringer has a strong social media presence, you should proceed on the basis that your letter will be posted online. Fully explain your client’s reasons for wanting to protect its brand and why the infringing content is unfair and objectionable. A letter that does not paint the recipient in a favourable light is much less likely to end up in the public domain.

A rather more extreme response to allegations of corporate bullying is to keep digging and issue more threats.

If the infringer has issued defamatory comments that will have the effect of damaging the rights-holder’s reputation, then that might be actionable. There is no doubt that such a step would risk being seen as an attempt to gag fair criticism, but in certain circumstances it is an option to be considered.

I enjoy some of the more imaginative approaches taken to address this issue. My stand-out favourite is the Netflix in-house lawyers’ witty use of *Stranger Things* references when trying to stop a pop-up bar from showing episodes of the hit show. In that case, they showed some leniency by giving the bar six weeks to bring the conduct to an end and threatening to “call the infringer’s mom” if they did not. However, I cannot help wondering whether a court would have accepted the letter as being adequate notice of Netflix copyright and claim should they have needed to resort to court action. Clearly, if its humorous approach failed, a rather more serious letter would need to have been sent.

It goes without saying that ensuring the claims made in cease-and-desist letters have a sound basis in fact and law is critical. Yet the risk of clients (and their advisers) being publicly shamed is something that is not going to go away. We need to continue to walk the line, ensuring that trade mark rights are properly policed to avoid them being diminished, while also complying with any relevant pre-action protocol requirements without overreaching.

Ultimately, it is the responsibility of the professional practitioner to push back against clients who wish to issue weak or unstateable claims, just to see what the reaction is. Issuing reasonable and measured letters requesting undertakings that might actually be acceptable has a great deal going for it.

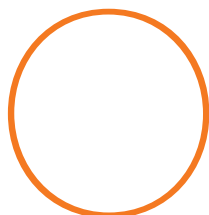


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THE DEVIL'S IN THE DISTRIBUTION

Thomas Prock assesses the threat
to IP rights posed by 3D printing



ver the course of just a few years, the process of copying digital files has gone from being an onerous task requiring the swapping of data carriers (tape-to-tape copying anyone?) to one in which digital files are only ever a few commands

away – or are even delivered automatically without user interaction. While this has made life easier in many respects, disruption on this scale also presents challenges, particularly in defending against a range of IP infringements.

The copying of any files will of course only be attractive if the copyist has the means needed to put the file to its intended use. For music and video files, this is straightforward, as even devices with moderate computing power have the required output interfaces.

The main obstacle to copying physical objects has long been the absence of the means – both the tools and the skills required to use them. However, the democratisation of 3D printing (aka additive manufacturing) through reduced costs and increased availability means the problems faced by those whose products are data-based are also now knocking at the doors of manufacturers of physical products.

CONTRACT PRINTING

This has also resulted in the emergence of a new market: that of the amateur printer. Affordable 3D printing puts the tools for creating physical objects in the hands of a wide range of individuals and households. Even those without a 3D printer can “contract” their printing job out to a large network of printer owners who are only too happy to press the print button for a relatively

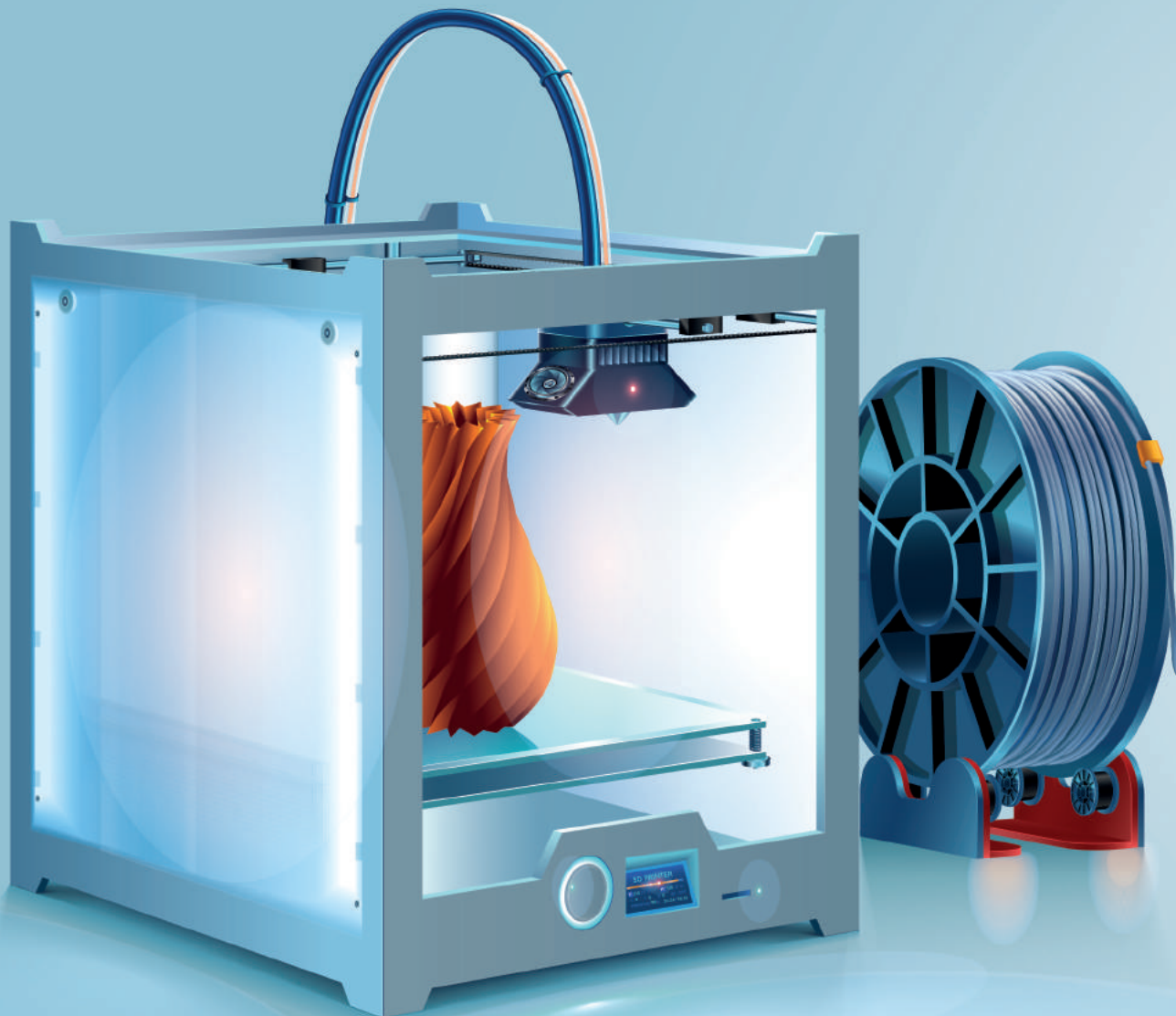
modest fee. And with much of the 3D-printing process now automated, the level of skill required to create tangible objects has reduced considerably.

To support these amateur printers, websites have emerged dedicated to the distribution of digital design files for use in 3D printing. These files provide 3D-print templates, making it easy for private individuals to download design files for products that they can print at home. While amateur 3D printing is only on the cusp of becoming mainstream, this development has long been expected. More than half a decade ago, one global freight and distribution company dedicated an annual conference to the question of how the localisation of manufacturing precipitated by 3D printing would affect its business.

HISTORICAL LESSONS

Just how can companies adapt their business and legal strategies to meet the challenges of this brave new world? The traditional mechanism for protecting against the copying of innovations is IP, including patents, design rights, copyright and trade marks. There are some fairly elaborate methods for removing products from the marketplace or preventing products from getting there in the first place using IP rights. However, some of these methods – in particular detaining products when they cross country borders – don’t work when what is crossing the border is just data.

To use IP rights to protect against a loss of revenue and reputation through 3D printing, the distribution of files via the internet must be addressed. Here, steps taken by the music industry in the past to achieve this can provide valuable lessons. Businesses would do well to learn from that industry’s mistakes when attempting to combat unauthorised downloads using threats of court



“ *Private individuals are often exempt from infringement of IP rights such as patents, meaning that pursuing such individuals may be impossible*

action for copyright infringement. Pursuing individuals can be costly and unwieldy. What's more, the negative publicity associated with pursuing private individuals for such acts is likely to discourage enforcement attempts. Finally, it should be noted that private individuals are often exempt from the infringement of IP rights such as patents, meaning that pursuing such individuals may be impossible, even if desired.

The music and film industries eventually realised that the best way to combat unauthorised downloads was to pursue the websites that hosted the downloads, while also providing a viable option for consumers to purchase content legally online. Product designers and developers should therefore consider developing similar business models based upon legal downloads of design files. As the music industry illustrated, rather than fighting the technology, businesses should find ways to work with it, while still monetising innovation. ▶

“ Patents that have been written to cover a physical product may not cover a design file for printing such a product

However, even those businesses that find a satisfactory model for monetising their intellectual creations may not be out of the woods. Low-quality counterfeit goods can greatly undermine the hard-earned brand and image of a legitimate company in the public eye. Faulty and counterfeit goods also open the door to claims of liability and the erosion of consumer confidence. The ability of 3D-printed objects to circumnavigate borders and customs checks brings an extra dimension to this problem.

So, what recourse might manufacturers have to stop websites that host and distribute unauthorised data downloads?

In order to pursue websites and businesses that distribute unauthorised files, it is necessary to have a right that can be enforced against these parties. IP rights-holders should consider whether their current IP strategy provides protection against the unauthorised downloading of design files and the printing of counterfeit products. For instance, patents that have been written to cover a physical product may not cover a design file for printing such a product. Equally, IP that protects a traditionally manufactured product may not cover one that is created via 3D printing. For example, 3D-printed products may not need certain components (such as screws) that would otherwise be essential on a traditionally manufactured product.

Poorly drafted IP protection could therefore present an opportunity to competitors who seek to imitate rather than innovate. As a result, those involved in creating physical goods (even if the goods aren't intended for 3D printing) will need to take account of the possibility of 3D printing when looking to protect their ideas. Access to patent attorneys with a combination of detailed technical and legal knowledge is essential in this regard.

DATA PROTECTION

Data security will also need to be considered in light of the threat from 3D printing. As distributed manufacturing via 3D-printing technology becomes mainstream – allowing for “just in time” production of spare parts, for example – the risk of the interception of legitimate data files stands to increase. With this in mind, manufacturers and product designers alike will need to ensure that their design files are securely protected from theft. Without these design files, it will be much more difficult for would-be infringers to print knock-off products.

Nevertheless, even if the original design files are never leaked, people may still be able to produce their



own design files for printing counterfeit goods – either through computer-aided design programmes or through the use of 3D scanners that can produce a 3D model of a product quickly and easily.

Accordingly, IP protection will likely still be needed in order to prevent copying, even where design files are protected via strong data security. ●



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Key to the kingdom

Luis-Alfonso Durán unpicks the significant changes to Spain's IP regime

As a result of the transposition of the EU Directive earlier this year, there is a new procedure for trade mark oppositions in Spain. This applies to any new Spanish trade mark application or any Spanish designation in an international trade mark under the Madrid Protocol, filed from 1st May 2019 onwards. Here are the most important changes to remember.

PROOF ON DEMAND

The new procedure entitles the applicant behind a trade mark application opposed by a third party to request proof of use of the opponent's trade mark in the five years prior to the priority date or the filing date of the opposed application, provided that the opposing trade mark has been granted for more than five years.

Notably, while this was previously taken as starting from the date of publication of the grant, it is now counted from the day when the grant became final.

At the time of writing, requests for proof of use have not yet been filed as part of oppositions to trade mark applications – simply because the change is so recent. However, it is very likely that by the time you read this, proof-of-use requests will have been dealt with by the Spanish Patent and Trade Mark Office (SPTMO).

In any case, it is very important to start preparing the proof of use not only from the notification of the

request, but from the beginning of the proceeding, since the deadlines for submitting the proof of use are very short and they are not extendable.

The applicant that receives an opposition from a third party has a term of one month to request the proof of use of the opposing trade mark. This deadline is considered reasonable, as it is only necessary to check whether the date of grant of the earlier opposing trade mark has been final for more than five years at the time of the filing or priority date of the Spanish application and then file the request with the SPTMO.

DEADLINE AND TRANSLATIONS

An opponent now has just one month, upon notification of the request, to submit the proof of use and a Spanish translation of all evidence that is not written in that language. This time limit is not extendable. Once the proof of use is filed and notified, the applicant has a term of one month upon notification of the proof of use to submit arguments.

PRACTICAL GUIDANCE

As a result of these new opposition proceedings, it is advisable to:

1. Check, before filing an opposition, whether the applicant would be entitled to request the proof of use, remembering the change to the date from which the grace period begins. This must be checked carefully, as the SPTMO has said that it will now indicate this final date in its database, but this will not be the case in old files,



even though the new regime also affects those cases. As a result, verification will have to be done by the parties.

2. If proof of use can be requested, we advise checking with the owner whether the opposing trade mark has been used and how; for which of the protected goods/services; what kind of evidence of use is available; and whether the use that could be proven would be sufficient to conclude that the opposition would have a reasonable chance of success.
3. Even if the trade mark has been used, it is also important to check whether the sign has been used

- in a manner that differs from the sign as registered, since, in some cases, that use would not be sufficient. If this is the case, it is important to review the client's portfolio to advise on new applications that fully protect its use and consider whether or not to file the opposition.
4. Given the short time available to submit the proof of use and to translate it (only one month), it would be advisable to start collecting evidence of use as soon as possible so that there is sufficient time to submit the evidence and prepare the eventual translation within the deadline.

which the decision becomes final or within three months of the date on which the EUTM application was withdrawn or ceased to have effect.

Previously, when the applicant requested the conversion of an EUTM at the EUIPO for Spain and indicated the name of a Spanish representative, the SPTMO informed the Spanish representative of the assigned Spanish number and fixed a term within which they needed to fulfil the Spanish requirements, including the payment of the Spanish fees.

However, as of 30th May 2019, the SPTMO no longer sends any communication to the designated

“ An opponent now has just one month to submit the proof of use and a Spanish translation

5. Opposition proceedings have become more complex, so it is important that they are conducted by reliable Spanish professionals with good knowledge and experience of Spanish and European trade mark law and who will devote the time and attention required to the case.

EUTM CONVERSION

There have also been changes regarding the conversion of EU trade marks (EUTMs) into Spanish trade marks.

EUTMs can be converted into Spanish trade mark applications when the EUTM has been rejected or withdrawn or when it has ceased to have effect (other than for failure to renew on time). This often happens, for instance, when an EUTM has been rejected on grounds of earlier rights that are not protected in Spain. The request must be filed within three months of the date on

Spanish representatives. It is up to the applicant to submit, through its representatives, the required documentation and the payment of the corresponding official fees. This must be done within a deadline of two months from the date on which the SPTMO received the conversion application from the EUIPO. If this is not done, the application for conversion in Spain will be considered withdrawn.

This means that, unless the Spanish associates are informed that they have been designated as local representatives in an EUTM conversion proceeding for Spain, the deadline could be missed. Therefore, in cases where a conversion of an EUTM into a Spanish application is made, it is essential that the designated Spanish associates are informed immediately so that they can submit all the documents and complete all the formalities before the deadline.



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WAY OFF THE MARK

A guiding international framework is needed to help businesses avoid missteps with TCEs, writes John Swinson

The protection of traditional cultural expressions (TCEs) has gained increasing international attention in recent years. While the debate on how to protect TCEs rages on, recent backlash against companies applying (often successfully) to register culturally significant words, signs and symbols as trade marks shows the urgent need for an international framework to help preserve the rights of indigenous groups and give businesses the clarity they need to navigate this space.

Part of the problem is that there is no universally accepted definition of the term TCE. However, the definition adopted by the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC) provides that TCEs “may be considered as the forms in which traditional culture is expressed, form part of the identity and heritage of a traditional or indigenous community and are passed down from generation to generation”.¹

As discussed in “Signs of change” (*CITMA Review* issue 432), TCEs are generally understood to include (among other things) music, dance, art, designs, names, signs, symbols, performances, ceremonies, architectural forms, handicrafts and narratives.² The UN Declaration on the Rights

of Indigenous Peoples recognises that such peoples have the right to maintain, protect and develop manifestations of their culture.³ Despite this, third parties continue to use TCEs in the course of trade without permission.

TCEs are currently protected to some extent by existing Western IP systems and other laws at a national level. However, the suitability of conventional IP rights for protecting TCEs is widely debated.

In particular, this article will focus on the clash between branding and TCEs, as well as the limitations of Western trade mark systems in granting rights to communities to control their TCEs and benefit from their commercial use (positive protection), on top of preventing other persons from acquiring IP rights over TCEs (defensive protection).⁴ It will examine

“ Part of the problem is that there is no universally accepted definition of the term ‘traditional cultural expression’



the current status of the much-needed international framework for the protection of TCEs that WIPO's IGC has been tasked with establishing, and will provide practical guidance on what businesses can do to avoid accusations of appropriating TCEs.

POSITIVE PROTECTION

As noted, existing Western trade mark laws provide some level of protection for indigenous groups against the misappropriation of TCEs. By registering a trade mark (including a certification mark or collective mark), indigenous peoples can promote their traditional signs and symbols.

Importantly, a trade mark registration can also increase consumer awareness and the commercial value of TCEs and thereby benefit local communities. These marks can then be renewed indefinitely, giving indigenous groups who successfully register TCEs a potentially infinite term of protection.

Certification marks and collective marks allow for collective ownership and use of traditional names, signs and symbols, which is consistent with some indigenous views on the ownership and use of TCEs. There have been a number of examples of trade marks that have been successfully used to protect TCEs, including the Toi Iho certification trade mark in New Zealand, which distinguishes the work of Māori artists from others.⁵

However, there are limitations and hurdles to the use of Western trade mark systems to protect TCEs. For example, in most Western trade mark systems, a trade mark must be used or intended to be used in the course of trade to distinguish the owner's goods or services. This is problematic for indigenous communities who want to protect their culturally significant marks from misappropriation, rather than use the mark when selling goods or services.

Neither is it necessarily practical or financially feasible (due to the costs associated with registering, renewing and enforcing trade mark rights) for indigenous groups to register all existing TCEs. Therefore, these systems are by no means comprehensive or sufficiently adapted to meet the needs of all communities.

DEFENSIVE PROTECTION

The trade mark system also offers some defensive protection against misuse of TCEs. Some trade mark laws prohibit the registration of a sign that is likely to deceive or cause confusion, or that is scandalous, offensive or contrary to accepted morals. There is therefore scope within these provisions to prevent the registration of TCEs by non-indigenous groups on the basis that the proposed mark ▶

is culturally offensive or indicates a false connection to an indigenous group.

However, these concepts are broad and vary between countries, and the trade mark officers required to make a decision on these issues may not be well versed in indigenous cultures or TCEs.

Unfortunately, there is no shortage of examples of businesses that have successfully registered a trade mark consisting of or containing traditional signs and symbols. The frequency of recent and high-profile examples of cultural insensitivity demonstrates that current Western systems are not working effectively as a defensive measure. Here are some prominent examples from recent months.

KIMONO

Kim Kardashian West recently faced public backlash for her “Kimono” shapewear line, which critics argued disrespected Japanese culture and tradition. A kimono is a traditional garment that has been worn by Japanese people for centuries. Although the products do not resemble a traditional kimono in any respect, the shapewear company applied to register the trade marks KIMONO, KIMONO BODY, KIMONO INTIMATES and KIMONO WORLD (some of the proposed marks are shown left). In response to the public backlash, Kardashian West renamed the brand SKIMS Shapewear and has since abandoned her KIMONO trade mark application.

MARKS OF CONTENTION

KIMONO

Registered trade mark No 88479867

KIMONO BODY

Registered trade mark No 88468425

BULA

In September 2018, Ross Kashtan, CEO of the Bula Kava bars and cafés in Florida, successfully registered BULA as a trade mark in the US. The word “bula” translates to “life” and is a culturally significant greeting in Fiji, with a similar use to the word “aloha” in Hawaii. When used as a greeting, “bula” signifies wishes



for longevity and good health. The registration drew criticism, largely from the people of Fiji, and the furore eventually caught the attention of the Fijian Government. Attorney-General Aiyaz Sayed-Khaiyum announced the Government’s intention to contest the trade mark registration with the USPTO and to raise the matter with WIPO. However, the mark remains on the register today.

AUSTRALIAN EXPERIENCE

Australian trade mark legislation does protect a limited range of culturally significant signs, such as “Returned Soldier” and “Olympic Champion”. However, it does not explicitly protect indigenous words and images from being registered as trade marks. Consultation with the indigenous community is also not legally required to trade mark a word or phrase that is culturally significant in Australia.

In 2017, the owners of a central Queensland-based business, GumbyGumby.com, applied to register the phrase GUMBY GUMBY as a trade mark. “Gumby Gumby” is an Aboriginal term for “woman woman medicine” in the language of the indigenous Ghungalu people of central Queensland. The Gumby Gumby is a type of tree that the indigenous group has used for medicinal purposes for generations. Members of the Ghungalu community were outraged by the application, calling it a clear example of cultural appropriation. The trade mark is still in the examination process and at this





“ Trade mark officers required to make a decision on TCEs may not be well versed in indigenous cultures

misleading conduct or a misrepresentation as to the source of the art. A campaign, “Fake Art Harms Culture”, was launched by the Arts Law Centre of Australia, and the Indigenous Art Code and Copyright Agency was launched to address this problem in 2016. Proposals have been made to strengthen consumer protection laws in this regard.⁷

MĀORI MARKS

If Australian trade mark legislation does not provide a strong basis for rejecting the trade mark registration of culturally significant words, the position is different across the Tasman Sea. In New Zealand, trade marks flagged as containing or being derived from any Māori words or imagery must pass through an advisory committee. The committee then considers whether the registration of the trade mark is likely to cause offence to the Māori community. This method (of creating a new mechanism to consider the interests of TCE holders) is a promising step towards preventing the misappropriation of traditional marks in New Zealand.

EVOLVING PROTECTION

The WIPO IGC, which was established by the WIPO General Assembly in 2000, has been tasked with developing an international instrument for the effective protection of TCEs.⁸

In 2014, the IGC released Draft Articles on the protection of TCEs. A revised version was recently released for the IGC’S 40th session. The Draft Articles consist of a lengthy preamble and 15 articles covering matters such as the definition of TCEs, the objectives and beneficiaries of the instrument, and the scope, term and limitations of protection. Each article is expressed as a series of alternatives which are intended to be negotiated and agreed upon by Member States. The articles contain a significant amount of bracketed text, which indicates the matters that are still up for discussion, demonstrating the difficulties associated with negotiating such agreements among multiple stakeholders.

The IGC’s focus for 2019 (as set out in the IGC Mandate 2018/2019) has been to

stage it is not clear whether it will proceed to acceptance.

This is not the first time that a non-indigenous person or group has sought to register an indigenous word as a trade mark in Australia. Shortly before last year’s Commonwealth Games, the Gold Coast 2018 Commonwealth Games Corporation sought to trade mark the word BOROBI for its koala mascot. “Borobi” means “koala” in the traditional language of the indigenous Yugambeh people.

Jabree Ltd, a registered cultural heritage body for the Gold Coast region, opposed the application. Among other arguments, Jabree claimed that the trade mark contained or consisted of scandalous matter, that use of the trade mark would be contrary to law and that the trade mark was misleading as it suggested an association with and approval by the Yugambeh community. However, the Hearing Officer found that Jabree had not established any of the grounds of opposition and allowed the trade mark to proceed to registration.⁶

In Australia, there is also an ongoing issue regarding fake indigenous art; that is, art made by non-indigenous artists in the style of indigenous art. A Parliamentary enquiry was told that as many as 80 per cent of all souvenirs sold in Australia that purport to represent First Nations cultures are inauthentic. While creating and selling such art harms culture, doing so is unlikely to be a trade mark or copyright infringement. But it could be

“ Despite the IGC having existed for almost 20 years, Member States have been unable to reach a common understanding on fundamental issues

undertake negotiations with Member States to address some of these unresolved issues. The IGC’s 40th Session convened in June 2019. The key items on the agenda were to take stock of the progress made by the IGC in 2018 and 2019, and then to make a recommendation to the 2019 General Assembly.⁹ The initial draft report of IGC 40 was published on 18th September 2019.

While meaningful progress has been made over the past year in furthering negotiations between Member States on important issues, there is still significant work to be done in reaching agreement on an international framework for the protection of TCEs. And despite the IGC having existed for almost 20 years, Member States have been unable to reach a common understanding on fundamental issues such as the subject matter and scope of protection. This suggests these issues are unlikely to be resolved any time soon.

PRACTICAL STEPS

As the frequency of recent and high-profile examples of cultural insensitivity demonstrates, the scope of protection offered by domestic systems is inadequate. In the meantime, subject to a limited list of exclusions, companies can trade mark culturally important words and phrases without legal ramifications. But should they? In addition to causing harm to the indigenous owners of TCEs, the misuse of TCEs can also cause significant reputational damage and financial harm to businesses. Just a quick browse of Bula Kava’s Facebook page is enough to show that businesses don’t fare well when they upset their customer base (or entire countries).

However, for those that do choose to pursue such marks, it is prudent for businesses to take proactive steps to avoid even inadvertent misappropriation or unauthorised use of TCEs. For example:

1. Conduct due diligence on any proposed marks (beyond searching the trade mark

register) to ascertain whether the mark may have some intrinsic cultural or social significance to local communities.

Due to the inherent limitations of most trade mark systems, many culturally significant words, signs and symbols will not appear on the trade mark register. It is already common practice when conducting availability searches for any trade mark to go beyond the register to other “common law” sources, including search engines, news sites and business and financial records.

While there is no central database to search cultural expressions, businesses should take extra steps in their clearance searches to identify any potential link between the proposed sign and existing TCEs. Businesses should not assume that well-known TCEs are in the public domain and therefore free to use.

2. Ask for permission and give credit (or even financial benefit) where it is due. While this may seem like an obvious approach, asking for permission to use a TCE is the simplest way to avoid public backlash over the misappropriation of cultural symbols and conflict with indigenous communities.

Indigenous groups may agree to allow a business to use a TCE in the course of trade if the community is adequately consulted and compensated for that use. This compensation may be monetary, but it may also include an acknowledgement, recognition or some form of partnership between the entity and the community.

3. Understand and respect the significance of TCEs. As Kim Kardashian West’s shapewear line illustrated, in some cases the significance of a particular mark may make it inappropriate for commercial use, particularly where that use is so far removed from the historical use of the TCE. Businesses should be sensitive to these issues and recognise uses that have the potential to cause offence. ●

1 wipo.int/tk/en/folklore
2 See above.
3 Article 11, *UN Declaration on the Rights of Indigenous Peoples* (13th September 2007).
4 WIPO, *Consolidated Analysis of the Legal Protection of Traditional Cultural Expressions/Expressions of Folklore*, Background Paper No. 1 (2nd May 2003).
5 toiho.co.nz
6 *Jabree Ltd v Gold Coast Commonwealth Games Corporation* [2017] ATMO 156.
7 aph.gov.au/Parliamentary_Business/Committees/House/Indigenous_Affairs/The_growing_presence_of_inauthentic_Aboriginal_Land_Torres_Strait_Islander_style_art_and_craft/Media_Releases
8 WIPO IGC Mandate 2018/2019.
9 Draft Agenda WIPO/GRTKF/IC/40/1 PROV.2.



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KEEPING UP WITH THE BENELUX

Michiel Haegens summarises the primary provisions of a widely used trade mark system

Due to an intensive and long-standing trade relationship, trade mark protection in the UK has always been on the radar of companies established in Benelux and vice versa. As the Benelux trade mark system is efficient and of good quality, it is widely used. For those who have not yet encountered it, here are some of the Benelux basics.

LEGAL FRAMEWORK

Benelux consists of Belgium, the Netherlands and Luxembourg, so no separate trade mark laws exist in those countries. Benelux trade mark law is governed by the Benelux Convention on IP, the current version of which entered into force on 1st March 2019. The first version of the Convention replaced the Benelux Trademark Law 1971, which was the first law providing uniform trade mark protection in multiple EU Member States. The Convention is in line with the EU Trademarks Directive (2015/2436, 16th December

2015) and thus is similar in material aspects and provides similar rights.

Benelux is a member to all major international trade mark treaties and agreements, including the Paris Convention, the Madrid Agreement and Protocol, the Nice Agreement and the Locarno Agreement.

NO REGISTRATION? NO RIGHTS

The Convention does not provide for protection of unregistered trade marks, the only exception being well-known marks as prescribed by the Paris Convention. When no registration exists, no trade mark rights can be invoked. Timely registration is therefore of the essence. Unfair competition law (including the bad faith provisions incorporated in the Convention) may provide remedies where no registered trade mark rights exist.

REGISTERING TRADE MARKS

Who can apply?

As a rule, anyone can apply for Benelux trade mark protection. However, regarding collective marks,

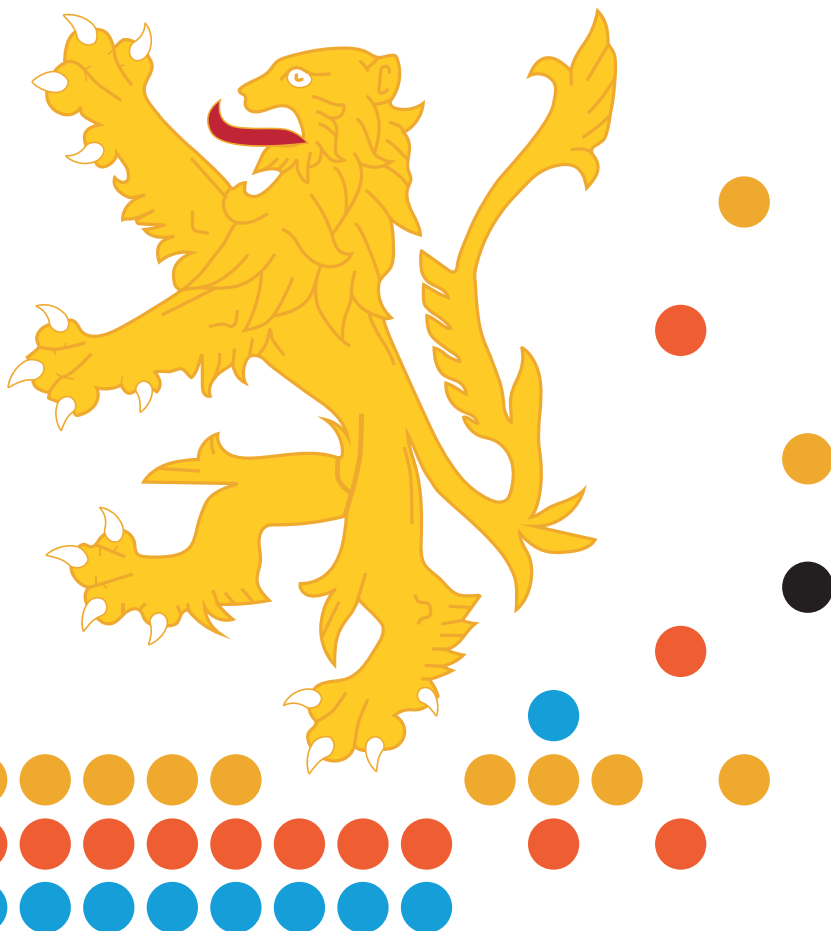
only branch associations or certain public bodies may apply for registration. Representation by a representative established in the European Economic Area is required when an office action is issued or an opposition, cancellation or nullity action is lodged. These criteria also apply to certification marks. The application can be filed in Dutch, French or English. More than 99 per cent of applications are filed electronically.

Formal requirements

No power of attorney is required for filing for trade mark protection in Benelux (or the EU). A priority claim must be evidenced, but this can be done by means of a scan of the priority document.

What can and cannot be protected?

The legal definition of a trade mark in Benelux is quite broad. Benelux legislation and practice regarding the admissibility of trade marks is largely in line with European practice. Despite changes in the



“
If an expedited registration is requested... the mark is registered in two working days

in two working days. With this type of application, the check on absolute grounds and publication takes place after registration.

OPPOSITIONS

An opposition can be lodged on the basis of a prior identical or similar trade mark application or registration for identical or similar goods. Opposition may also be filed on the basis of a mark with a reputation for identical, similar and dissimilar goods, provided that the younger mark takes unfair advantage of, or is detrimental to, the distinctive character or reputation of the earlier mark.

Finally, according to Article 6bis of the Paris Convention, an opposition may be filed based on a (non-registered) well-known mark. The BOIP has publicly stated that it frowns upon oppositions that are based on non-registered marks of which the notoriety is debatable.

Filing does not require grounds to be substantiated and thus it is possible to merely file a formal opposition. However, it is not possible to extend the opposition deadline. The opposition must be filed prior to the end of the publication period (or on the next working day).

Opposition fees amount to €1,045, of which at least €418 (40 per cent) must be paid at the time of filing. The remainder is due at the start of the adversarial part of the opposition proceedings.

The opposition procedure is similar to the opposition proceedings before the EUIPO. When the ▶

law effective as of 1st March 2019, non-traditional trade marks, especially 3D trade marks, may be difficult to obtain.

Costs

On 1st January 2018, Benelux became a fee-per-class area. Until then, application and renewal fees up to three classes were the same. Currently, the fee system is similar to the EUIPO system: €244 for an application in one class, €27 for the second class and €81 for the third class. There are no separate publication or registration fees.

Renewal fees are similar: €263 for the first class, €29 for the second and €87 for the third and any further classes. Additional fees are required for expedited applications (getting a registration number in 48 hours). Both types of applications are usually filed electronically.

EXAMINATION PROCEDURE

The Benelux Office for Intellectual Property (BOIP) is responsible for maintaining the Benelux Trademarks

Register. The registration procedure is electronic, efficient and swift.

An application is checked on formal grounds and subsequently published, after which an absolute grounds check takes place. It is therefore possible that an opposition may need to be filed against an application that is refused by the BOIP on absolute grounds in a later stage of the proceedings.

No check on relative grounds is conducted and no search report is issued. In the absence of objections, the application proceeds to registration in approximately three to four months from the date of application, which includes a two-month publication period. If an office action or refusal is issued, the applicant is granted two months to overcome such objections. The total time taken to overcome a refusal on absolute grounds is six months. If an expedited registration is requested (following payment of the additional fee), an accelerated check on formalities is conducted. If no objections arise, the mark is registered

Benelux in brief

FILING FACTS

Trade mark term

10 years (from application date)

10
years

Term for use

5 years (from date of registration)

5
years

PoA?

No power of attorney is required



Representative required?

Yes, if an office action is issued or an opposition, cancellation or nullity action is lodged



Languages

Dutch French English

Limitations

No protection for unregistered trade marks; non-traditional trade marks may be difficult to obtain



FEES

Application fee
€244 (one class)

Additional class (each)
€27 for the second class
€81 for the third class

Renewal fee
€263 (one class)
€29 for second
€87 for third class+

Expedited applications
Additional fees required

Opposition fees
€1,045 (40% at time of filing)



TIMELINES

Registration timeline
Registration completed in an average of 3-4 months

Opposition period duration
2 months

TREATY TIE-INS

Benelux is a member of the Paris Convention, the Madrid Agreement and Protocol, the Nice Agreement and the Locarno Agreement

opposition is deemed admissible, the statutory two-month cooling-off period starts – the term of which can be extended with the consent of both parties for four month-long terms until an amicable settlement has been reached. When no extension is applied for, the opponent must file its arguments and further evidence within two months. Subsequently, the defendant/applicant is granted a two-month period to file counterarguments or request proof of use (where applicable). When both parties have filed arguments (and, where applicable, have exchanged proof of use and comments), the BOIP will issue a decision.

Only if the opposition is awarded or rejected in full, the opposition fees of €1,045 must be borne by the losing party. Such a decision forms an enforceable title.

LANGUAGES ACCEPTED

The language of the opposition proceedings is the language in which the application was filed (either Dutch, French or English) and can be changed only with the consent of the applicant.

REGISTRATION TERMS

Registrations are valid for 10 years from the application date. The term for use is five years from the date of registration.

REMOVAL FROM THE REGISTER

Any interested party, including the public prosecutor, may invoke the nullity of the registration, and the registration may consequently be invalidated by the Benelux Office or the courts if the mark:

- is a sign which is not distinctive;
- is misleading; or
- has become the usual denomination for the goods or services involved.

In addition, nullity may be requested if the mark involved:

- was filed in bad faith;
- is contrary to public order or morals;
- conflicts with Article 6ter of the Paris Convention;
- is similar or identical to a prior trade mark registered for similar/identical goods or services; or
- is similar to a trade mark with

a reputation in Benelux for dissimilar goods or services or is similar to a well-known trade mark (in the sense of Article 6bis of the Paris Convention).

Finally, revocation may be requested if the mark has not been put to use within five years of its registration.

As of 1st June 2018, any interested person can apply for cancellation (on the basis of non-use) or invalidity (on the basis of a prior right) with the BOIP. These proceedings exist next to the already existing court proceedings. The proceedings with the BOIP are normally swifter and less expensive than court proceedings and generally follow the same structure as Benelux opposition proceedings and EU cancellation and nullity proceedings. The first decisions have already been issued and seem to confirm the view that these proceedings are swift, efficient and of a high standard.

CHANGES IN THE REGISTRATION

Assignment is possible without the goodwill of the business but must be in writing. Recordal of assignments, licences and liens with the BOIP is efficient and straightforward. A scan or photocopy of the underlying document will usually suffice.

For recordation of a licence, lien or limitation, an executed power of attorney of all parties concerned is required. Again, a scan or photocopy of the document will usually suffice. No notarisation or legalisation is required.

Use by a licensee (and indeed any use with prior authorisation from the mark owner) will be sufficient to maintain rights in a Benelux mark.

ENFORCEMENT

While there is no specialised court for general trade mark disputes, most of the district courts and courts of appeal have judges who focus on IP matters. Due to its exclusive jurisdiction for EU trade mark and design matters, the Hague District Court has a number of specialised IP judges.

Most infringement actions will relate to the use of an identical or similar sign for identical or similar

“ *The first decisions... seem to confirm the view that these proceedings are swift, efficient and of a high standard* ”

products or services. In addition, an action can be brought based on alleged infringement of a well-known trade mark.

Remedies first consist of an injunction, and then a recall of infringing products can be demanded, as well as the surrender or destruction of the infringing products. In addition, the infringer may be summoned to provide all relevant information enabling the plaintiff to calculate the damages caused by the infringement. This may include the number of infringing products bought, sold and still in stock, as well as the profits made. In addition, the infringer can be ordered to provide contact details for the supplier of the infringing goods.

In both summary and main proceedings, a claim may be brought for compensation of the legal costs incurred in ending the infringement. This works both ways: if the defendant prevails, they may also request compensation of legal costs. It is not possible to claim punitive damages in Benelux.

In the case of infringement, a rights-holder may bring a separate claim for the surrender of profits made by the infringer from the sale of the infringing products. In a case of bad faith, compensation of damages, as well as a surrender of profit, may be awarded. A claim for compensation can be brought only during proceedings on the merits.

Interim relief is available. Under certain circumstances (particularly a threat of irreparable damage to the trade mark owner) *ex parte* injunctions are also available. An

application for such an injunction is granted only if the plaintiff can make a *prima facie* case of infringement. Additional claims, such as a request for compensation of damages, cannot be granted in *ex parte* cases. As a rule, interim relief can be obtained as long as the infringement persists. The trade mark owner must initiate proceedings on the merit in order to prevent an interim relief decision from losing its effect.

The time limit for action against a registration filed in good faith is five years. The holder of a prior trade mark that has acquiesced for five successive years in the use of a registered later trade mark while being aware of such use will not be entitled to prohibit the use of the later trade mark (Article 2.24 of the Benelux Convention on Intellectual Property). This does not apply when the later mark was filed in bad faith.

The time frame for the resolution of an enforcement action for registered and unregistered rights will depend on the type of remedy sought. *Ex parte* injunctions and interim relief can be obtained almost immediately if the case is sufficiently urgent. As a rule, interim relief cases will be decided in approximately 14 days. Cases on the merits are usually decided in six to 12 months.

Finally, although trade mark infringement is mentioned in the Dutch Penal Code, public prosecutors do not show much interest in pursuing IP cases. An exception may be IP infringement cases which are connected to large criminal cases. ●



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IN

the context of trade marks, it is relatively common for parties in opposition and invalidation proceedings to

adduce sales and marketing figures (which are, more often than not, deemed confidential) as part of their evidence in support of their case. But should the confidentiality of these sales and marketing figures be safeguarded, and if so, under what circumstances?

These were some of the interesting issues that arose for the first time before the Registrar of Trade Marks at the Intellectual Property Office of Singapore (IPOS) in an interlocutory application for confidentiality safeguards by TWG Tea Company Pte Ltd (the Applicant) and the objection thereto by T2 Singapore Pte Ltd & Tea Too Pty Ltd (the Opponent).

The Applicant sought to register the trade marks SINGAPORE BREAKFAST, NEW YORK BREAKFAST, LONDON BREAKFAST and CARAVAN in relation to tea and other goods in class 30. The Opponent filed an opposition against the application on the following grounds, *inter alia*: that the marks are devoid of any distinctive character under s7(1)(b) of the Trade Marks Act (Cap 332), and that the marks are descriptive of the goods in question under s7(1)(c) of the Act.

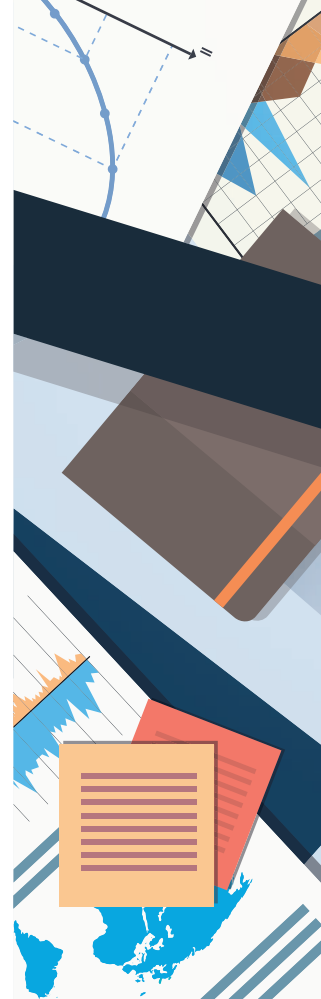
The Applicant argued that, in any event, the marks have “in fact acquired a distinctive character as a result of the use made of [them]”, and pursuant to s7(2), that the marks should “not be refused registration by virtue of [s7(1)(b) or (c) of the Act]”. In support, the Applicant sought to adduce evidence of sales and marketing figures, which it asserted constituted confidential information. Accordingly, prior to disclosing

the information to the Opponent, the Applicant sought various confidentiality safeguards. The Opponent refused to provide the confidentiality undertaking, constraining the Applicant to apply to the Registrar for the confidentiality safeguards to be imposed on the Opponent.

In response to the fundamental question – whether there’s a difference between a case where a party is seeking confidentiality protection over information that it voluntarily puts forward in support of its case (as here), and a situation where it is compelled to provide that information – the Registrar answered in the affirmative, while also stating that a person should generally not be permitted to have his cake and eat it too.

Furthermore, the Registrar observed that it is unfair to impose confidentiality obligations on a party in respect of information that it never asked for in the first place, and that confidentiality undertakings should not be imposed in such cases. However, the Registrar clarified that this does not mean that confidentiality safeguards should never be imposed (although the case for imposing such safeguards would need to be compelling). The Registrar then ventured to list some of the factors that ought to be considered, including the following:

1. The importance of the information to the issues in dispute. The more critical the information, the less likely it should be kept private. In accordance with the principle of open justice, it is important to be able to ascertain the basis of a court or tribunal’s decision.
2. The degree to which the information is confidential. The same type of information may already be accessible through public sources (for example, if the party providing



ONE STEP TOO FAR

Denise Mirandah explains why the Registrar put a stop to an unusual applicant request



“ *The more critical the information, the less likely it should be kept private* ”

the confidential information is publicly listed, some of the information may be available, or the information may have been disclosed through industry or trade publications).

3. How current the information is. In most trade mark disputes before IPOS, the tribunal is concerned with the status of matters at the date of application for registration of the mark in dispute. This could be a few years before the date when the information is provided, and the older the information, the less likely that it will still be commercially valuable.
4. Whether the parties are competitors. If so, it would be more important to have confidentiality safeguards, but this cannot be decisive since the parties in such proceedings will in many cases be competitors.
5. The extent of the prejudice to a party should the confidential information be disclosed to its competitor. This will depend on the facts of each case.
6. The stage of the proceedings. As the matter advances towards a hearing, it will become progressively more important for a party to be fully apprised of the case it has to answer, and it is plausible that more individuals within that party might need access to the confidential information

to enable meaningful discussions as to the conduct of the case, including whether the possibility of a settlement should be explored.

Taking into account these factors, and applying them to the factual matrix of this case while balancing the various competing interests, the Registrar decided that the confidential information, and in particular the Applicant’s sales figures, should be protected by appropriate confidentiality safeguards at this stage.

Be that as it may, with respect to the Applicant’s request for a direction that the Opponent ought to provide an indemnity against “any loss, damage, liability, claims, demands, fees, costs and expenses (including legal and professional costs and expenses)” incurred by the Applicant arising from any breach of the undertaking by the Opponent, the Registrar ruled that this went too far and could not be granted.

The Registrar observed that, bearing in mind that the Opponent had not asked for the confidential information in the first place, it is all the more important that such onerous obligations should not be imposed on it.



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Class complaint

A high-end hotel defends a valuable reputation, writes David Birchall

In this case, Claridge's Hotel Ltd (the Hotel), the high-end London hotel patronised by royalty from Queen Victoria right up to the present Queen, complained about the use (and proposed use) by the Defendants of a CLARIDGE sign on candles and perfumery goods. The Hotel claimed that such use infringed (or would infringe) the Hotel's two UK-registered trade marks of CLARIDGE'S under s10(2) and s10(3) of the Trade Marks Act 1994 and would also amount to passing off.

Both UKTM registrations relied upon by the Hotel had passed the fifth anniversary of their registration dates. The Defendants, an English company and its sole owner/director, counterclaimed for revocation of the Hotel's aforementioned UKTM registrations on the basis of non-use. Partway through the claim, the Hotel voluntarily surrendered one of these UKTM registrations in full and some elements of the other, proceeding with the claim on the basis of the trimmed registration only. That trimmed UKTM registration of CLARIDGE'S covered, among other goods and services:

- "toiletries; shampoos; conditioners; bath preparations; body lotions; essential oils; shower gels; moisturiser" in class 3;
- "bath preparations; hair care and hair cleaning products; hand care and hand cleaning products" in class 5;
- "magazines" in class 16; and
- "hotel, restaurant, café and bar services; arranging and booking hotels and accommodation services; accommodation reservation services; provision of facilities for meetings, functions, conferences and conventions; catering services" in class 43.

The decision of the IPEC provided useful clarification on the following issues:

1. whether the placing of toiletry-type goods marked with a hotel's name in UK hotel rooms constituted genuine use of a UKTM registration of the hotel's name for such goods;
2. whether the distribution by a hotel of a biannual magazine to its guests (with each edition having a run of approximately 15,000 copies) constituted use of the hotel's UK registered trade mark on "magazines"; and
3. whether acceptance by a hotel of bookings

and reservations from guests for its own hotel amounted to the provision of "booking" or "reservation" services.

To succeed with its claim under s10(2) of the Act, the Hotel would have to prove at least similarity between the goods and services covered by its trimmed UKTM registration and the Defendants' goods. However, first of all, the Hotel needed to prove use of its UKTM registration to defend the counterclaim.

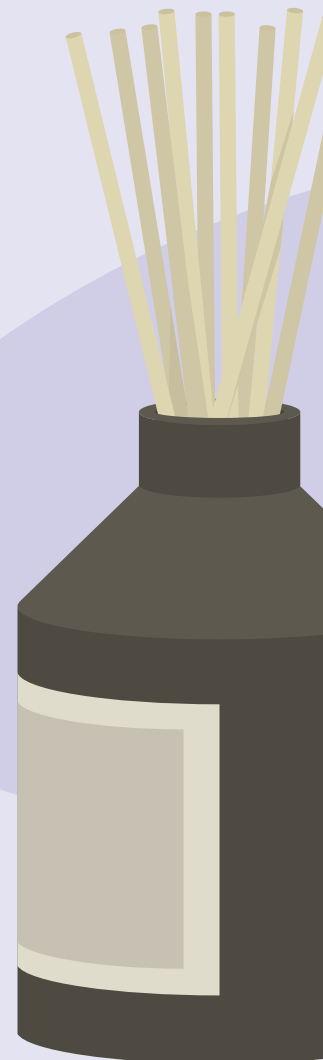
GENUINE USE

In C-495/07, Silberquelle GmbH v Maselli-Strickmode GmbH, the CJEU confirmed that where a proprietor of a mark affixes that mark to items that it gives, free of charge, to purchasers of its goods, it does not make genuine use of that mark in respect of the class covering the items given away.

The Hotel sought to differentiate between: (a) goods and services offered on a purely promotional or ancillary basis, and (b) goods and services that were offered in association with another service but that were promoted in their own right and that constitute a factor in the decision of consumers to choose the associated service, such that there was "real commercial purpose" behind them. The Hotel maintained that the public, when selecting a hotel, took toiletries into account and that, indeed, some Claridge's guests sold their Claridge's toiletries on eBay afterwards, demonstrating that the public recognises the real value in them even if the Hotel had not sold them.

The IPEC rejected this argument, holding that, since the Hotel had never marketed toiletries, it had not created or preserved a market in them. The IPEC held that, while the use made might help to create a market for hotel services, no evidence had been adduced showing that the toiletries were a factor in a consumer's choice of hotel.

The Hotel also sought to rely on a paragraph in a UK IPO decision (O/134/15) regarding revocation of the RAFFLES trade mark on the basis of non-use, in which it was conceded that since services for the provision of food and drink were part and parcel of "hotel services", a finding of genuine use on hotel services



“ No evidence had been adduced showing that the toiletries were a factor in a consumer’s choice of hotel

KEY POINTS

- ✦ Claimants should not rely on vulnerable trade mark registrations
- ✦ Giving away goods, free of charge, to purchasers of other goods does not constitute genuine use of a trade mark on the goods given away

would automatically mean a finding of genuine use on services for the provision of food and drink. The IPEC held that the relevant paragraph could not be relied on as an authority for finding genuine use of a mark on specific services just because consumers would expect such services to be included within/ alongside a broader service on which use was proven. The counterclaim therefore succeeded in relation to all the class 3 and 5 goods.

Likewise, the IPEC held that the Hotel’s distribution of biannual magazines to guests, since it did not create or preserve a market for magazines under the Claridge’s mark, did not constitute genuine use on “magazines”.

The IPEC held that there was no evidence showing that the Hotel had provided “arranging and booking hotel and accommodation services” or “accommodation reservation services” under the Claridge’s mark.

The Hotel’s UKTM registration was significantly trimmed by the successful counterclaim for revocation and the claim under s10(2) of the Act failed.

Despite the earlier findings, in view of the Hotel’s substantial reputation for hotel services, the IPEC found that the Defendants’ use of CLARIDGE on the goods constituted (or would constitute) both infringement under s10(3) of the Act and passing off.

While the Hotel succeeded in stopping the Defendants’ use, the case is a reminder of the dangers of failing to use UK trade mark registrations and the folly of relying on old and unused trade mark registrations as a basis for trade mark infringement claims. The recipient of an infringement claim who decides to defend it will, if properly advised, invariably attack any vulnerable UKTM registrations relied upon on the basis of non-use.



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Low value, high tech

Emily Scott reviews a counterfeit case transferred from Small Claims

This trade mark infringement case concerns two occasions on which the Defendant, ID Management Systems, was alleged to have sold counterfeit MIFARE-branded smart cards. The Claimant, NXP BV, claimed infringement of various EUTM registrations for marks comprising and containing MIFARE, covering, *inter alia*, smart cards in class 9. The case was transferred from the Small Claims Track to the IPEC Multi-Track, where it was treated as a low-value claim.

COUNTERFEITING QUESTION

Were the Defendant's cards counterfeit?

The Claimant relied on in-house technical reports on tests carried out on samples of the Defendant's cards. The reports concluded that the Claimant did not make either set of cards; however, the report on the second set contained some ambiguities.

The Defendant did not attack the report on the first set of cards in its pleadings but raised unpleaded arguments in its skeleton argument for trial. It relied on a disclaimer at the end of the report, in which the Claimant made no representations or warranties as to the information. The Defendant submitted that the Claimant had failed to prove the cards were counterfeit and that a finding in the Claimant's favour would be "tantamount to accepting the Claimant's say-so".

The Court found that the cards were counterfeit, holding, *inter alia*, that:

- A sense of proportionality was required when assessing the Claimant's evidence. The IPEC provides "low-cost access to justice rather than insisting on perfection".
- The report was produced by a department whose job it was to check for counterfeits of the Claimant's products in the real world; the Court had been given no reason to suppose that its reports had been questioned by anyone else.

- The Defendant could and should have pleaded its arguments if it had wanted to attack the report (eg the techniques and equipment used).
- The disclaimer makes no difference as it made clear that the information itself "is believed to be accurate and reliable".

The Defendant ran its own tests on the second set of cards using the Claimant's hardware and software. The cards were found to be genuine (or 80 per cent likely to be so). As the Claimant's and Defendant's evidence was in conflict, the Court held on the balance of probabilities that the Claimant had not proven the cards to be counterfeit.

CONSENT

The Defendant claimed that the Claimant had given unequivocal consent to both sets of cards being put on the market under the MIFARE mark in the European Economic Area.

As per *Davidoff*¹ and *Mastercigars*², consent must be unequivocal to demonstrate that a trade mark proprietor has renounced its intention to enforce its rights.

The Defendant relied on a white paper sent to it by the Claimant, warning the Defendant against using unauthorised or counterfeit MIFARE products. The Court held that the Claimant's advice in the paper was "unexceptional" and did not begin to amount to unequivocal consent to either cards being put on the market in the EEA.

The action, therefore, succeeded in relation to both sets of cards.

“
The cards were found to be genuine (or 80% likely to be so)

KEY POINTS

- Proportionality is a key consideration in IPEC cases – the IPEC will take a pragmatic view of evidence
- Pleadings should contain all facts and arguments
- Consent must be unequivocal



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¹ Case C-414/99 Zino Davidoff v A&G Imports
² *Mastercigars Direct v Hunters & Frankau*
EWCA Civ 176, [2007] RPC 24



A dose of reality

Lizzie Sergeant summarises the circumstances that saw a celebrity lose out

Ms Ferne McCann (the Applicant) applied to invalidate UK trade mark registration No 3160229 FERNE and FERNE BEAUTY, registered as a series in the name of CP Management London Ltd (the Proprietor). The application for registration was filed on 19th April 2016 (the relevant date). The trade marks are registered in relation to class 3 goods including cosmetics and tanning products as well as related retail services in class 35 and beauty care services in class 44.

The Applicant applied to have the registration declared invalid under s47(1) and/or (2) of the Trade Marks Act 1994 on the basis that the registration was contrary to ss3(6), 5(4)(a) and 60(3).

In particular, the Applicant claimed that FERNE and FERNE MCCANN were, at the relevant date, distinctive of her goodwill, and use of the trade marks without her consent constitutes a misrepresentation to the public and takes unfair advantage of her goodwill. In addition, the Applicant claimed that she and the Proprietor were party to an Endorsement Agreement (EA) at the relevant date, which gave the proprietor a licence to use her name to promote self-tanning products during the term of the EA but did not provide for the Proprietor to register the marks. The EA was terminated in February 2017.

In support of her acquired goodwill in FERNE, the Applicant submitted that she is a very well-known celebrity having starred in reality TV series *The Only Way is Essex* (TOWIE) and *I'm a Celebrity... Get Me Out of Here!* The Applicant also featured in celebrity magazines and had a column entitled "The Only Way is Ferne".

The Proprietor conceded that, as a celebrity, the Applicant did have protectable goodwill at

the relevant date. However, they argued that all media references to the Applicant as FERNE contained additional identifiers, such as her surname, photo or reference to TOWIE, and that FERNE alone was not distinctive of her goodwill. The Hearing Office (HO) accepted this, noting that it is clear that the Applicant is known as Ferne McCann.

Turning to the EA, the HO considered whether use of FERNE as a brand constituted, by itself, an "endorsement" (as defined in the EA) of the Proprietor's products. If it did, according to the EA, the Proprietor could not use FERNE after the EA was terminated.

However, as it had been determined that FERNE alone was not distinctive of the Applicant at the relevant date, FERNE alone did not fall within the definition of "endorsements". The EA therefore provided that the Proprietor was the owner of the FERNE trade mark and the goodwill generated under it. The application for invalidation under s5(4)(a) failed.

The HO noted that there was no evidence that the Proprietor's application was an attempt to stop the Applicant from using FERNE. Therefore, the application for invalidation under s3(6) failed.

The final ground for invalidation, under s60(3), was rejected as the HO concluded this claim was not sufficiently pleaded.

KEY POINTS

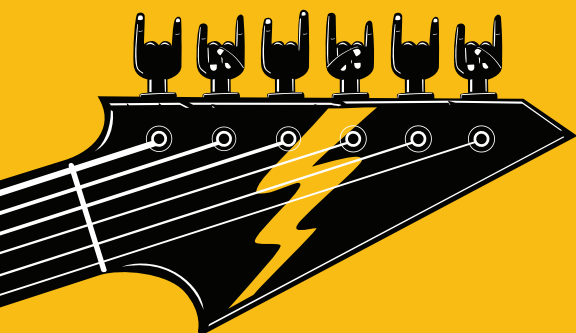
- It is not sufficient to rely on protectable goodwill in a given mark where that mark is not distinctive of that goodwill

- This case highlights the difficulty in establishing protectable goodwill in a Christian name alone. The public needs to be educated so as not to rely on other identifying features, such as an image or surname



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Rock on?

This wasn't the case for the Applicant, explains Louise Foster

On 21st January 2015, White Outline Ltd (the Applicant) filed a UK series application for the marks shown below right in respect of “provision of sporting activities; provision of rock-climbing facilities and training; BMX park hire; skateboard park hire” in class 41.

DHP Family Ltd (the Opponent) opposed based on UK trade mark registration No 2623177 for the mark ROCK CITY covering “nightclub services; organisation, promotion and presentation of live performances; sporting and cultural activities” in class 41 claiming breach of ss5(1), 5(2) and 5(3), as well as s5(4)(a), of the Trade Marks Act 1994.

The Opponent filed evidence demonstrating its activities as the ROCK CITY music venue since 1980, and also referred to six sporting events that had been held at the venue since 1997. A subsequent round of evidence attempted to show an association between skateboarding and music.

The Applicant's evidence claimed that it had operated an indoor climbing centre in Kingston-upon-Hull since 1994 and an indoor skate park since 1996 under first ROCK CITY and, since 1997, ROCKCITY. On this basis, the Applicant claimed a defence of honest concurrent use of the respective marks for more than 22 years.

The earlier registration was not subject to use requirements and so the Opponent could rely on all the services covered. The services applied for were found to be identical to the Opponent's registered sporting and cultural activities. Having dismissed the Opponent's claim that the marks were identical, the Hearing Officer (HO) carried out a global assessment and concluded that there was a likelihood of both direct and indirect confusion.

HONEST CONCURRENT USE

For such a defence to apply, the HO must be satisfied that the parties had been trading such that the relevant public had been exposed to both marks and was able to differentiate between them without

confusion, or that the circumstances were sufficiently exceptional that some confusion ought to be tolerated.

Reiterating that the Applicant's mark conflicted with the Opponent's in relation to the latter's sporting activities, the HO stated a view that the handful of such events held at the Opponent's venue was not sufficient to constitute an established period of coexistence. The exceptional circumstances that had allowed the Court in Anheuser-Busch (C-482/09) to find that the mark does not denote the origin of one undertaking alone could therefore not exist in this case.

Thus the defence failed and the finding under s5(2)(b) succeeded.

OTHER GROUNDS

Considering the claims based on s5(3) and s5(4)(a), despite finding that the Opponent had reputation and goodwill in the mark for music events and nightclub services, it was not considered that the public would link these services and the provision of sporting activities by the Applicant, nor that a substantial number of the public would be deceived. The Opponent was not considered to have reputation or goodwill in relation to sporting activities. Thus, these grounds of opposition failed.

REGISTERED RIGHTS

Despite having operated under its mark since 1994, the Applicant made no partial counterchallenge to the Opponent's registered sporting activities on the basis of prior use. As honest concurrent use was not arguable in respect of the relevant services, the Application was rejected in its entirety.

KEY POINTS

- ✦ The decision demonstrates the strength of having a trade mark registration and how useful it can prove in the five-year grace period
- ✦ The Opponent's lack of use for sporting activities helped it to succeed in this case
- ✦ The HO indicated that the evidence filed by the Applicant to demonstrate its use was not as comprehensive as it might have been

MARKS

White Outline Ltd marks



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A political problem

When parties fall out, IP disputes can rise out of the ashes, says Sarah Talland

This decision concerns two trade mark registrations for a fledgling political party and claims by the Applicant for invalidation that these should not have been registered by the proprietors due to claims under the tort of passing off, pursuant to s47(2)(b) of the Trade Marks Act 1994 (the Act), which refers to s(5)(4)(a) of the Act.

The background to the case is that the proprietors, Mr Vaughn and Lady Brook, and the Applicant for cancellation, Mr Whitby, were all members of a new political party named The British Voice, formed in 2014. Mr Whitby was the elected party Chairman. Evidence filed in the proceedings documented a falling out between the parties, culminating in the apparent expulsion of Mr Vaughn and Lady Brook from the organisation in 2015. Shortly after leaving the party, Mr Vaughn and Lady Brook applied to register the two marks shown right.

Mr Whitby, remaining as the party Chairman and recognised as party leader by the Electoral Commission, later learned of the registrations and filed invalidation actions based on passing off. There was an apparent allegation of bad faith, but this was not properly pleaded in the proceedings and therefore not considered in the decision.

Most of the evidence filed relates to the formation of the party, the creation of the phoenix logo and the eventual disagreement between the parties, rather than specific evidence of goodwill. Nonetheless, the decision found that goodwill exists in the name THE BRITISH VOICE as well as the phoenix logo and PROTECTING BRITISH PEOPLE.

GOODWILL QUESTION

The real issue in this decision was whether Mr Whitby was able to rely on the goodwill to succeed in the invalidation actions. An earlier

decision in this case was appealed to the Appointed Person on this point, following which the decision was cancelled and referred back to the Registry. The new decision has carefully reviewed these issues and held that Mr Whitby was able to rely on the goodwill, given his position as Chairman and official recognition of him as party leader.

The decision considers whether the proprietors, as founding party members, also had a basis to claim ownership of the party's assets. The decision concluded that these two individuals should be treated no differently to unconnected members of the public when it comes to considering passing off.

Finally, the decision considers the issues

of misrepresentation and damage, swiftly concluding that as the trade marks are identical to the name, logo and slogan of the political party, both grounds are satisfied.

The registrations have therefore been declared invalid. A request for off-scale costs of £28,000 was made by Mr Whitby

as a litigant-in-person, which was then denied.

Readers may recall similar disputes concerning music groups and band names, and the issues that arise when original members leave the group and continue using identical or similar names. This decision shows the importance of having legal agreements in place concerning ownership of the name when forming any type of group or organisation.

“

The decision finds that goodwill exists in the name as well as the phoenix logo

KEY POINTS

- ✦ Goodwill was established but the issue of entitlement to rely on that goodwill was at issue
- ✦ A bad faith ground could have been a useful additional claim in this case
- ✦ Ownership of an organisation's IP should be carefully considered at the outset

MARKS



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App owner chases its tail

Dale Carter has a bone to pick with the HO here

The Applicant in this case, DogApp Ltd, offers a mobile app for dog owners and applied for the figurative mark shown below right in respect of classes 9, 35 and 38. None of the Applicant's goods or services were specified as relating to dogs.

The Opponent, DogBook App Ltd, offers a comparable social media app for dog owners named "The Dog App". The Opponent opposed the Application under s5(2)(b) of the Trade Marks Act 1994, relying on the figurative mark, also shown below right. The Opponent's registration was not subject to proof of use and its specification included goods and services limited to the field of pets as well as broader terms with no limitation as to their field of use.

Applying Meric, the Hearing Officer (HO) found the goods and services to be identical. The average consumer was the general public, whose level of attention would be average, or slightly higher than average if the app is offered by paid subscription. The act of purchasing an app was primarily a visual one, although it was not discounted that an app could be recommended by word of mouth.

HO ASSESSMENT

The distinctive character of each mark was assessed on the basis that the interests of the parties lie in dog-related apps. It was held that the words DOG APP and THE DOG APP are non-distinctive and descriptive in this context. The figurative components of each mark formed their dominant and distinctive elements. The marks were found to be visually similar to a low degree, aurally identical and conceptually similar to a high degree.

Due to that analysis of the verbal elements, the dissimilar figurative elements and the visual nature of the purchasing act, the HO

found no likelihood of direct confusion. Indirect confusion was also ruled out, any association arising because of the coincidental use of descriptive language.

CONCLUSION CONSIDERED

Overall, the HO appears to have arrived at the right conclusion, but I wonder if a slightly different outcome should have been reached in relation to goods/services unrelated to dogs.

Led by the Applicant's evidence, the HO focused on the contested goods aimed at dog owners offered via an app. In doing so the HO did not consider notional and fair use of either mark across the full breadth of the specification. The HO accepted that the Opponent's mark is more distinctive for goods and services that are not dog-related, where the verbal and visual elements played a more or less equal role in the overall impression.

Notwithstanding that the Applicant's mark "may cross over the line in terms of likelihood of confusion" in relation to non-dog-related goods and services, and despite there being identical goods and services in play, the HO did not consider whether a likelihood of confusion existed for the broader categories.

It could be argued that the opposition should have succeeded against the non-dog-related goods and services covered by both specifications and for which the coinciding words DOG APP hold some degree of distinctiveness.

“
It was not discounted that an app could be recommended by word of mouth”

KEY POINTS

✦ Marks containing non-distinctive verbal elements that do not dominate their overall impression have a narrow penumbra of protection

✦ The mark of an opposing party that is not subject to proof of use should be assessed based on notional and fair use across the full breadth of the opposing party's specification

MARKS

The DogApp logo



The Opponent's mark



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Face-off

Peter Collie presents a decision that hinged on the difference between certain services

YouTuber Jelle Van Vucht (“Jelly”) applied to register the cartoon version of himself in the UK (shown below right, top). The application covered: “clothing” (class 25); “selling of [clothing] whether or not via the internet (webshop services)” (class 35), and “merchandising” (class 35).

The application was opposed by Toca Boca AB (Toca), owner of EUTM No 13838107 (the Earlier Mark, below right), which covers clothing, a number of consumer goods, such as computer games, and various electronic entertainment services. The opposition was based on the likelihood of confusion, reputation and passing off.

Identity was found between the clothing goods included in both the application and the registration, and the Hearing Officer (HO) proceeded on the basis that “selling of [clothing] whether or not via the internet (webshop services)” meant retail services for clothing. This service has a complementary relationship to “clothing” (covered by the Earlier Mark). The HO concluded that the terms share a medium degree of similarity.

DEFINING TERMS

In assessing the broad term “merchandising”, the HO cited guidance from *YouView TV v Total Ltd* [2012] EWHC 3158 (Ch). When interpreting the scope of terms, their limits should not be allowed to become “fuzzy” and “imprecise”. “Merchandising” is primarily a business-to-business (B2B) service, but all of the goods covered by the Earlier Mark were consumer goods. Therefore, the HO drew a boundary between the two terms and concluded that there was no similarity.

Notwithstanding the fact that the Earlier Mark is a comparatively basic smiley face logo, the HO gave little weight to the more noticeable differences between the marks, such as the size of the teeth. The marks were held to be visually similar to a medium degree, conceptually identical and “if referred to aurally, are likely to coincide”.

The HO concluded that there was a likelihood of confusion, and the opposition



succeeded in relation to “clothing” and “selling of [clothing] whether or not via the internet (webshop services)”. It failed in respect of the dissimilar services.

The HO went on to consider the opposition based on the remaining two grounds only in respect of the outstanding term “merchandising”.

REMAINING GROUNDS

Toca’s evidence successfully demonstrated that its mark enjoyed a reputation. However, it was held that the reputation extended only to software apps aimed at children. The gap between such apps and “merchandising” was too great to satisfy the requirement that a link must be established by the relevant public to the Earlier Mark when confronted with the later mark. The s5(3) claim failed. Ultimately, this gap also served as a reason for the HO to dismiss the s5(4)(a) claim.

The case emphasises the need to consider the relevant consumer when assessing similarity of goods and services. It highlights the difference between consumer-targeted goods/services and services that are B2B in nature.

KEY POINTS

- + Even seemingly simple figurative marks can enjoy an arguably wide scope of protection
- + “Merchandising” is primarily a B2B service, resulting in a different relevant “consumer” than for consumer goods

MARKS

International trade mark No 1344414



EUTM No 13838107



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Parody put in its place

Linkage would lead to unfair advantage, writes Désirée Fields

In May 2017, Addicted Original Ltd (Addicted) filed a UKTM application for the Addicted Logo (shown below right) in classes 25, 35, 36 and 42, broadly covering clothing, retail services, retail financing services and retail design services. The logo achieved registration in August 2017.

In September 2019, adidas AG filed an invalidity action relying on ss5(2)(b), 5(3), 5(4)(a), 3(3)(a) and 3(6) of the Trade Marks Act 1994. adidas relied on its Trefoil Logo filed in May 1981 (shown below right) and registered for sports clothing, outer clothing and footwear in class 25.

Evidence from adidas showed that it had made genuine use of the Trefoil Logo in relation to clothing and footwear. The Hearing Officer (HO) found that the parties' goods were identical or highly similar and that the marks were visually similar to a low to medium degree, aurally similar to no more than a low degree and conceptually dissimilar, and that the Trefoil Logo had a high degree of inherent distinctive character that had been further enhanced through use. The HO did not consider that the average consumer would mistakenly recall one mark for the other but would recognise the difference between the made-up word "adidas" and ordinary dictionary word "addicted". Therefore, there was no likelihood of direct confusion. While the HO found that it was very likely that the Addicted Logo would call to mind the Trefoil Logo, this was mere association and not indirect confusion. The claim under s5(2)(b) failed.

RECOGNITION REASONING

Upholding the invalidity action under s5(3), the HO found that due to the Trefoil Logo's strong reputation and high degree of inherent distinctive character, consumers would likely recognise that the Addicted Logo was based on the Trefoil Logo and make a link in respect of all the goods and services covered by the Addicted Logo.

While not every consumer would recognise the image in the Addicted Logo as a marijuana leaf, they would still make a link due to the similar shape device in combination with a word starting with AD- presented in the same font. For consumers recognising the marijuana leaf, the link was made because the Addicted Logo was parodying the Trefoil Logo with reference to an illegal drug. That connection alone in the mind of consumers would cause detriment to adidas' reputation (even where the Addicted Logo was used in relation to dissimilar goods and services). The HO also held that basing its mark upon the Trefoil Logo created a degree of familiarity for consumers when confronted with the Addicted Logo, thereby giving Addicted an unfair advantage, as it would not be required to go through the same marketing effort and expense as adidas.

The HO further found that the registration was contrary to public policy or to accepted principles of morality contrary to s3(3)(a). However, she rejected the passing off claim under s5(4)(a). She did not consider the bad faith claim under s3(6).

CONFUSION OR LINK?

Given its strong reputation, most consumers would likely make the link between the Trefoil Logo and the Addicted Logo, even if they would not confuse the origin of the goods and services. This link in the minds of consumers alongside the possibility of tarnishing the reputation and taking unfair advantage of the investment in the adidas brand led to success under s5(3).

KEY POINTS

- The fact that one mark calls to mind the other is mere association and not confusion
- Where consumers recognise a mark referring to an illegal drug as a parody of an earlier mark, that connection may cause detriment to the earlier rights-holder's reputation
- Parodying an earlier mark gives the owner of the later mark an unfair advantage, as it would not need to go through the same marketing effort and expense as the owner of the parodied mark

MARKS

The Addicted Logo



adidas' Trefoil Logo



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Reaching for the moon

Prior rights did not hold up, reports Paul Hegedus

These EU Registry proceedings involved the filing of a declaration of invalidity by Luna AE (the Applicant), a Greek company, against all the goods in classes 24 (textiles) and 25 (various clothing items) of Luna Italia SRL's (the Registrant) EUTM registration No 16308108 (shown right). The invalidity action was based on the Applicant's prior rights in its mark (shown right, covering various undergarment-type goods in class 25), the subject of EUTM registration No 9773896.

It was argued by the Applicant that the Registrant's mark should never have proceeded to registration and accordingly should be declared invalid by virtue of Article 60(1)(a) EUTMR:

1. by virtue of covering the same or similar goods; and
2. the signs being similar (as they contained the identical verbal element "LUNA" and a low level of stylisation).

PROOF OF USE

During the substantive proceedings, the Registrant had requested the Applicant provide proof of use of its mark, asserting that the mark relied upon in the proceedings was more than five years old. However, the Cancellation Division (CD) confirmed that the relevant date in cancellation proceedings is not the date of filing the contested EUTM (as it is in opposition proceedings) but the date of the cancellation request. Therefore, the request for proof of use was found to be inadmissible.

SIMILARITY OF MARKS

In assessing the similarity of marks, the CD commented that overall the signs coincide with the word LUNA, which is the only distinctive verbal element. The additional word in the Registrant's mark – SPLENDIDA – is a laudatory term and the figurative elements play only a secondary role in the

assessment of likelihood of confusion. All in all, the marks were held to be visually similar to an average degree and aurally and conceptually similar to a high degree (given both associations with the moon).

In assessing each of the goods, the majority of the class 25 clothing items in the Registrant's specification were held to be identical or at least similar to the Applicant's earlier undergarment goods. However, various forms of headwear and

footwear were held to be dissimilar. The CD stated: "footwear, headgear and underwear are not usually sold close to each other in the same department and companies producing footwear and headgear rarely (if ever) produce underwear and vice versa". Further, all of the Registrant's class 24 goods

were held to be dissimilar.

REPUTATION

Considering all of the relevant circumstances, including the relevant degree of public attention as being average/moderate, the CD ordered the Registrant's mark to be declared invalid in respect of those goods that were similar and identical to the Applicant's earlier mark. After reviewing all of the Applicant's evidence, the CD came to the conclusion that the evidence did not demonstrate that the Applicant's mark had acquired a reputation in Greece and Italy, as originally claimed. Thus, the Applicant's claim under Article 8(5) was dismissed.



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KEY POINT

- For industries in which the level of consumer attention is average/moderate (and not high), trade mark owners can expect the EUIPO to apply a lower threshold when assessing similarity of marks

MARKS

EUTM registration
No 16308108



EUTM registration
No 9773896



Diamond mark is not forever

One applicant for invalidity is making no friends, says Rebecca Campbell

In September 2016, PT Maspion applied to register a figurative mark featuring a stylised diamond device and the words BLACK DIAMOND as an EU trade mark (EUTM) (shown below right). Protection was sought in relation to cookware-related goods in classes 1 and 21 and the application proceeded to registration in January 2017.

Several months earlier, The Cookware Company Global Sourcing Ltd (Cookware Company) had applied for its own EUTM featuring a diamond device (also shown below right). Protection was sought in respect of cookware-related goods in classes 2 and 21 and this application featured the word INFINITY. Registration was achieved in July 2016.

In 2018, Cookware Company filed EU applications for the word marks BLACK DIAMOND, BLUE DIAMOND, GREEN DIAMOND and RED DIAMOND. It also filed an application for a declaration of invalidity against PT Maspion's registration, invoking Article 60(1)(a) EUTMR and Article 59(1)(a) in conjunction with Article 7(1)(b) and (c). It was not able to rely on BLACK DIAMOND because this had been filed after PT Maspion's registration. Instead, Cookware Company alleged that PT Maspion's trade mark was descriptive, non-distinctive, and confusingly similar to its 2016 registration.

In its submissions, Cookware Company argued that there was a likelihood of confusion because the goods concerned were identical and the two signs conceptually and visually similar. The black diamond device was "in both instances ... positioned at the beginning of the mark" and INFINITY in the later mark would allude to the durability of black diamonds. BLACK DIAMOND could mean anthracite (also known as "hard coal") and so describe the goods. Cookware Company relied on an earlier EUIPO decision in which an application for the words BLACK DIAMOND had been rejected.

PT Maspion denied both grounds. The goods and marks were dissimilar, there was no likelihood of confusion and BLACK

DIAMOND was not descriptive or non-distinctive. Even if BLACK DIAMOND could be understood as a reference to anthracite, the goods were not made of this material and the device was sufficiently stylised.

EUIPO AGREEMENT

The EUIPO Cancellation Division agreed. Cookware Company had not provided sufficient evidence or arguments to show that the opposed mark was descriptive and/or non-distinctive. There was also no likelihood of confusion. Visually, the marks shared only the diamond devices and these had "nothing in common apart from the fact that they will be recognised as diamonds". Aurally, the marks were dissimilar and conceptually they were similar only to a low degree. Even if the goods were identical, consumers would undoubtedly be able to distinguish them. The application for invalidity was rejected in its entirety and a costs award issued in PT Maspion's favour.

WIDER DISPUTE

It remains to be seen whether the decision will be appealed. In the meantime, the wider dispute continues: PT Maspion retaliated by filing an opposition (currently suspended) against Cookware Company's application for the BLACK DIAMOND word mark alleging confusion with its own earlier figurative mark.

Diamonds may be forever, but it is clearly important to register one's diamond word marks early.

KEY POINTS

- Visually, the marks shared only the diamond devices and these were so different in stylisation that they had "nothing in common apart from the fact that they will be recognised as diamonds"
- Ensure trade mark applications are submitted as early as possible and be wary of the risk of counter-attacks when filing opposition or cancellation actions

MARKS

EUTM registration
No 015815541



EUTM registration
No 015128234



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WE must wait

Patrick Cantrill awaits any next steps in this dispute

WE Brand Sàrl (WB) opened its first WE store in 1998 and has grown across continental Europe to run 211 shops in seven countries. Employing its earlier right under EUTM No 7209571 for the word mark WE (the Mark), it opposed the application for WE THE KIDS by Italian clothing company OVS SpA (OVS). However, the failure by WB to file sufficient enhanced distinctiveness evidence to bolster its claim for likelihood of confusion (Article 8(1)(b) EUTMR) led the Opposition Division to reject the opposition.

CONFUSION CONSIDERED

OVS's sign depicts each letter of W-E T-H-E K-I-D-S in unconnected, multicoloured circles (see right). The Opposition Division (OD) found in its assessment for likelihood of confusion that:

- the goods and services in classes 25 and 36 were identical;
- the marks were visually and aurally similar to a very low degree (both contain "WE"); and
- the marks were conceptually similar, although OVS's application was a mark with other concepts, such as the circles forming human heads and a pyramid-like shape. These figurative elements were found to hinder the reading of the mark.

DISTINCTIVENESS

WB needed to show that its mark had enhanced distinctiveness, which must be assessed at the time the contested application was filed (2017).

WB submitted a range of evidence dated mainly in 2013 and 2015, including: (i) an extract from Wikipedia; (ii) extracts from the Opponent's website; (iii) a witness statement

from the CFO of WE Fashion Group (part of the Opponent); and (iv) an internal investment turnover table. WB also submitted proof-of-use evidence in response to OVS's move to cancel WB's EU registration. It filed this separate evidence after the deadline for enhanced distinctiveness had passed on 28th May 2018. The OD did not exercise its discretion to allow this late evidence but explained that, in any case, such evidence would not have altered its position.

The OD found that much of the evidence submitted by WB was insufficient to support the claim of enhanced distinctiveness. This decision comes close on the heels of other decisions in which the EUIPO has adversely scrutinised the nature and extent of the evidence submitted in trade mark proceedings, such as the failure of McDonald's to submit acceptable proof of use of its BIG MAC mark (Cancellation No 14 788 C).

RAMIFICATIONS

WB had evoked the common approach that a registered word mark would prevail over a figurative application that includes the same word, but the OD held that such is not a general principle and all assessments must be made on a case-by-case basis. If a sign is figurative enough, it can be seen as sufficiently different to an earlier mark because the global assessment must consider the overall impression of the mark, being as the relevant public would see it and not an analysis of each individual element.

The OD found that the relevant consumer (mainly the public at large) would not recall WB's mark. At the time of writing, the deadline for notice of appeal was approaching. So, "WE" wait.

KEY POINTS

- To prove enhanced distinctiveness, show that advertising activity affected the perception of the relevant consumer
- Evidence regarding proof of use is unlikely to be accepted if it is submitted out of time
- Although verbal elements of a mark usually have a stronger impact, this fact cannot undermine the principle that the global assessment of a mark must take into account the overall impression of that mark

MARK

The OVS SpA sign



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Resting on reputation

The choice to abandon an opposition ground is examined by Ryan Kellingray

Tarkan Soner Sevinçli filed an EU trade mark application for the word HOLLIS (shown below right), covering a range of goods in class 9. Abercrombie & Fitch Europe Sagl filed an opposition on the basis of various earlier trade mark registrations in the EU for HOLLISTER.

When initially filed, the opposition was based on Article 8(1)(b) EUTMR, alleging a likelihood of confusion, as well as on the reputation grounds contained in Article 8(5). However, as the proceedings progressed, Abercrombie & Fitch opted not to substantiate the latter ground, purportedly on the basis of “procedural economy” in light of what it believed was the “clear likelihood of confusion”. As such, the opposition proceeded solely on the basis of the similar mark, coupled with the range of identical and similar goods, and a resultant likelihood of confusion.

OPPOSITION DECISION

The EUIPO upheld the opposition for almost all of the contested goods.

The Opposition Division (OD) found that the marks HOLLIS and HOLLISTER were visually and aurally similar to a higher than average degree, highlighting the importance of the first part of the mark in conducting this assessment. In conducting the comparison of the goods in question, the OD held that the application covered a number of identical goods that were covered by both synonymous and broad language in Abercrombie & Fitch’s earlier registration, along with many which were “at least similar”.

In doing so, it reaffirmed the long-standing position that, where it appears in a trade mark specification, the term “including” introduces a non-exhaustive list of examples. The EUIPO

also reaffirmed the position that “remote similarity” between goods and/or services in opposition will suffice to bring these into the purview of the likelihood-of-confusion assessment. The only goods for which such a “remote similarity” was not found were “decorative magnets”, against which the opposition was subsequently unsuccessful.

In finding that there was a likelihood of confusion in relation to the remainder of the application, the OD highlighted the importance of the coincidence of the distinctive verbal element HOLLIS. The position of the differentiating suffix TER at the end of the earlier mark is less likely to catch consumers’ attention.

USEFUL EFFORT?

While Abercrombie & Fitch was successful on Article 8(1)(b) grounds in what appears to have played out as a relatively straightforward opposition, the deletion of the Article 8(5) ground is an interesting point. The high

threshold for substantiating a reputation for these purposes means that decisions about whether to collate and submit such evidence will need careful consideration and will be circumstantial, depending broadly on the strength of any likelihood-of-confusion argument – even where such a reputation could, and should, rightly be asserted.



KEY POINTS

- ✦ It may be worth considering whether it is efficient or cost-effective to substantiate an Article 8(5) claim of reputation in EUIPO opposition actions given the high threshold for proving this
- ✦ EUIPO interprets the word “including” in trade mark specifications as introducing a non-exhaustive list
- ✦ The first part of the mark is dominant in a likelihood-of-confusion assessment

MARK

EUTM application No 17 215 931

HOLLIS



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Turtle troubles

Amelia Skelding is reminded that small differences can have a big impact

Certina AG (the Opponent) filed an opposition against EU application No 1257407 for a figurative turtle mark (shown right) in the name of TRB International SA (the Applicant) for all goods in class 14. The opposition was based on international trade mark registration Nos 116985 (Earlier Mark 1) and 1175867 (Earlier Mark 2) designating the EU for the figurative marks. The Opponent invoked Article 8(1)(b) and Article 8(5) EUTMR.

COMPARISONS MADE

The goods were found to be identical, covering watches, *inter alia*. The public's degree of attention was found to be average to high, given that the contested goods cover both inexpensive and luxury products.

The Opponent tried to argue that the most relevant part was the device element, since the verbal components occupied a secondary position.

However, the Opposition Division (OD) disagreed, stating the verbal elements were located in prominent central positions, depicted in easily perceived black, upper-case lettering against a contrasting white background and, moreover, were superimposed over the figurative elements.

Furthermore, it is known that where a sign is composed of verbal and figurative elements, the consumer is likely to focus primarily on the verbal element as a point of reference. In contrast, the contested sign was purely figurative. As there was no verbal counterpart in the contested sign, it was not possible to compare the signs aurally.

With regards to the figurative elements, although both marks contained turtles, they were held to be depicted differently: the turtle in the earlier marks being symmetrical and static, but the contested sign being more dynamic and realistic. Overall, the degree of visual similarity was found to be low and the conceptual similarity was found to be very low for Earlier Mark 1 and low for Earlier Mark 2.

REPUTATION

The Opponent claimed that its earlier trade marks had a reputation due to long-standing use in the EU for all the registered goods. However, the evidence submitted was held to be insufficient because it only pertained to a limited subset of goods, lacked information about the source and, most importantly, predominantly showed use of the words CERTINA or DS in isolation, without the turtle design.

FAILURE EXPLAINED

The OD found that the earlier marks and the contested sign were not similar enough to lead to a likelihood of confusion. Importantly, it would not go unnoticed by the relevant public that the contested sign was purely figurative, while the earlier marks included verbal

elements. Overall, the differences between the signs were held to outweigh their similarities, so the Article 8(1)(b) ground failed.

The Article 8(5) ground also failed because it had not been established that the earlier trade marks had a reputation due to insufficient evidence, as examined above. Since the

opposition failed on all grounds, it was rejected in its entirety.

When comparing figurative marks, the inclusion of verbal elements can have a significant impact on similarity. Furthermore, nuanced differences between figurative mark designs, such as symmetry and realism, can be enough to change the overall impression of those marks.

KEY POINTS

- + Small differences can have a significant impact when comparing figurative marks
- + The importance of verbal elements in figurative marks should not be overlooked
- + It is important to ensure that any evidence is in order (ie dated, source identified, availability to the public, etc)

MARK

EU application
No 1257407



International trade
mark registration
No 116985



International trade
mark registration
No 1175867



“
As there was no verbal counterpart, it was not possible to compare the signs aurally”



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Time for Red Bull to bow out

Its colour combination again came up short on certainty, reveals Chris Hawkes

This decision concerned trade mark applications made by Red Bull GmbH (RB) for two colour marks (shown right), both the subject of invalidation applications by Optimum Mark (OM).

Both RB marks were registered on the basis that they had acquired distinctiveness through use, and each had an accompanying description. The descriptions, crucially, indicated Pantone references and also a ratio or proportional colour guidance. However, OM filed for invalidity at EUIPO and argued, in essence, that these descriptions were not specific enough regarding arrangement or uniformity to ensure that consumers would be able to make purchases with certainty, and also that the type of arrangement in which the two colours would be applied to the goods was not self-contained, clear and precise.

EUIPO's Cancellation Division, First Board of Appeal and the General Court (GC)¹ all agreed the marks were not sufficiently precise. They noted, citing *Heidelberger Bauchemie* (C-49/02), that the graphic representation of the marks and descriptions did not satisfy the requirements of precision and durability, and that the marks allowed for the arrangement of the two colours in many combinations, which may produce very different overall impressions.

PRESENT DECISION

RB further appealed to the CJEU, putting forward five grounds of appeal – most notably arguing the GC had erred in its assessment of Articles 4 and 7(1)(a) CTMR. RB advanced an argument that *Heidelberger* had been misinterpreted by the GC, which held that marks consisting of colour combinations must thoroughly specify the colours' spatial arrangement and erred in finding that the graphic representation of the marks was insufficiently precise absent such arrangement.

RB argued that *Heidelberger* should be interpreted in context, and that, in finding

the mere juxtaposition of colours was not sufficient to constitute a precise and uniform graphic representation, the GC infringed the requirement that a trade mark must be viewed as filed – *Apple* (C-421/13). In doing so, RB said the GC failed to have regard to a specific feature of colour-combination marks, which is not to have contours.

The CJEU cited *Hartwall* (C-578/17), reciting the requirement for marks to have a graphic representation in accordance with Article 4 EUTMR, where the subject matter and scope of protection are clear and precise. Verbal descriptions of marks must clarify their subject matter and scope in a way that does not give rise to any doubt and cannot be inconsistent with the graphic representation.

PRECISION REQUIRED

In this latest decision, the appeal was dismissed. The CJEU noted that RB's marks and descriptions would allow numerous combinations and would not satisfy the criteria such that consumers could perceive or recall any specific colour combination or rely on the marks with certainty. Absent a systematic arrangement associating the colours in a predetermined and uniform way, RB's marks could not meet the requirement for clarity and precision.

This decision reminds us of the perils of applying for colour-combination marks, and the requirement for precision in their descriptions such that only one clearly defined mark would be perceived by an individual inspecting the register. Marks that do not achieve this will be vulnerable to invalidity.

KEY POINTS

- ✦ Extra care should be taken when preparing to file colour combination marks
- ✦ Careful consideration should be given to the graphical representation and any accompanying description
- ✦ It is vital to ensure that the representation and description are compatible, and only denote one trade mark in one form

MARK

The Red Bull mark



¹ curia.europa.eu/juris/liste.jsf?num=T-101/15



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CITMA's range of webinars continues, including an introduction to patents, with support from Corsearch. See citma.org.uk/events to register



Events

More details can be found at citma.org.uk

DATE	EVENT	LOCATION	CPD HOURS
17th October	CITMA Autumn Conference – Birmingham* Seizing opportunities in a time of change	The ICC, Birmingham B1	5
22nd October	CITMA Webinar* Flip-flopping between sandals and thongs: Australian and New Zealand trade mark law	Log in online	1
31st October	CITMA Lecture – Manchester Domain name disputes post-GDPR	Marks & Clerk LLP, Manchester M1	1
7th November	CITMA One Day Seminar for Litigators	Laytons, London SE1	5
12th November	CITMA Paralegal Webinar* The Chinese “super trade mark”	Log in online	1
14th November	CITMA Webinar* UK case law update	Log in online	1
26th November	CITMA Lecture – London* Fashion and IP	Allen & Overy LLP, London E1	1
28th November	CITMA Lecture – Leeds Are the UK and EU IPOs ready for non-traditional trade marks?	Womble Bond Dickinson, Leeds LS1	1
3rd December	CITMA Webinar* Introduction to patents	Log in online	1
6th December	CITMA Northern Christmas Lunch**	Browns, Leeds LS1	
13th December	CITMA London Christmas Lunch***	London Hilton on Park Lane, London W1	

SUGGESTIONS WELCOME

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

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THE TRADE MARK 20

Q&A

Pollyanna Savva

is inspired by sustainability

I work as... a Part-Qualified Trade Mark Attorney at Withers & Rogers.

Before this role, I was... a Trade Mark Examiner at the UK IPO.

My current state of mind is... excited to decorate a flat I've recently moved into.

I became interested in IP when... I was looking for routes into the legal profession and stumbled upon a job at Withers & Rogers during the summer break of my degree.

I am most inspired by... people who make changes in order to live sustainably.

In my role, I most enjoy... working on applications and disputes involving non-conventional trade marks, as they tend to be challenging.

In my role, I most dislike... comparing long specifications.

On my desk are... hand cream, lip balm and a foldable metal straw.

My favourite mug says... "I love lamp" – it's a quote from the film *Anchorman*.

My favourite place to visit on business is... Paris, because I can put my language degree to good use, and French pastries are my weakness!

In my pocket is... I don't have any pockets, but I'm sure there's a Polly Pocket joke in there somewhere.



“

I hope to run Le Marathon du Médoc. It's fancy dress and involves stopping for a glass of wine at various châteaux in the south of France

If I were a brand, I would be... Lululemon, because I live in their leggings, whether I'm going to the gym or not!

The biggest challenge for IP is... for trade marks it's got to be Brexit.

My ideal day would include... lying on a beach with white sand, reading a thriller novel and eating sushi.

I can't live without... my noise-cancelling headphones.

The talent I wish I had is... to perform circus trapeze.

The best piece of advice I've been given... comes from Baz Luhrmann in the form of the lyrics to "Everybody's Free (to Wear Sunscreen)".

When I want to relax I... go to a yoga class or bake a cake.

In the next few years, I hope to... run Le Marathon du Médoc. It's fancy dress and involves stopping for a glass of wine at various châteaux in the south of France.

The best thing about being a CITMA member is... the charity quiz night. My team came second this year and we've set our sights on first place in 2020!



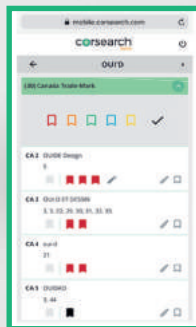
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