

Make Your Mark

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RGC JENKINS & CO AND MAUCHER BÖRJES JENKINS COMBINE TO BECOME *MAUCHER JENKINS*

We are pleased to announce the new pan-European intellectual property firm, Maucher Jenkins. The merger of two successful and long established European IP firms has created one of the most innovative global IP practices. Since the merger completed in the autumn of 2015, there has been a period of integration to

ensure the combined firm provides the best European filing, prosecution and dispute resolution advice to clients.

For businesses that need both EU and UK IP rights, it makes sense to have representation by one firm that is able to act across all major economies in Europe.

Maucher Jenkins is a one-stop-shop for clients who wish to identify, establish, protect, exploit and enforce their IP rights in the UK, Europe and worldwide.

Our growing litigation practice handles disputes in the European, English and German courts.



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EUROPEAN PERSPECTIVES BREXIT-

THE IMPLICATIONS FOR THE UK AND FOR MAUCHER JENKINS

On 23 June 2016, the UK held a referendum to determine whether it would stay in the EU. Following a series of contradictory polls in the run-up to the referendum, the British public chose, by 52% to 48%, to leave the EU. This result will have far reaching consequences for all sectors of the UK, but this article will look at the implications for Trade Marks and Designs throughout Europe, as well as the implications for the Trade Mark and Designs professions, and how Maucher Jenkins will be managing the process.

The current Prime Minister of the UK, Theresa May, has confirmed that she intends to invoke Article 50 proceedings by the end of March 2017. This is the process, set out in the Lisbon Treaty, by which a member state may leave the EU. The process gives an exiting member state two years in which to negotiate its terms for leaving. If the Article 50 process does commence by the end of March 2017, then the UK will have left the EU by April 2019. There are currently a number of legal challenges to the government being heard by the Courts in the UK, primarily on the basis that the result of the referendum should not be implemented without parliamentary approval. This raises the question of whether MPs in the UK, who may represent constituencies which voted overwhelmingly to leave, should be able to vote to stay in the EU, and whether, as a next step, there should be a General Election to enable constituencies to vote for an MP which best represents their interests.

Much as this writer finds these nuances of constitutional law to be fascinating, I

am reminded that this article is supposed to be about Intellectual Property, and not Gina Miller's pending (at the time of writing) action against the Secretary of State for Exiting the European Union.

EU TRADE MARKS AND DESIGNS – THE FUTURE

The fact of the UK leaving the EU will not affect the existence of EU Trade Mark Registrations, but rather will affect the scope of those Registrations. Clients should therefore be reassured that their EU Trade Mark Registrations will continue to exist and will continue to cover the remaining 27 countries of the EU. The question to be answered is therefore what will happen to the "UK" part of existing and new EU Applications.

In respect of those EU Trade Mark Applications filed after the UK leaves the EU, the answer is fairly simple. These will not cover the UK. Clients should therefore consider filing a UK Trade Mark Application as well as an EU Trade Mark Application. The question of what will happen to the "UK" part of EU Trade Mark Applications filed before the UK leaves the EU is more complicated. We expect there to be transitional provisions put in place after the UK leaves the EU to enable the UK IPO to transfer the protection granted by the EU Registration into a UK National right. The manner in which this will be done is not currently clear. However, the UK Trade Mark profession's representative body, ITMA, has suggested that one or more of the following scenarios could be put into place:

EU Plus – EU TMs no longer cover only the EU, but extend to other countries, including the UK.

Jersey Model – The UK deems EU TM Registrations to have effect in the UK.

Montenegro Model – All existing EU TM Registrations would automatically cover the UK.

Tuvalu Model – EU TM Registration owners would have a grace period after the UK's exit of the EU to file a request to extend the scope of the EU Registration to cover the UK.

Veto – As with the Tuvalu Model, but with the UKIPO having the right to veto protection of the mark in the UK.

Ireland Model – Owners of EU Registrations would be able to create a "new" UK Registration on renewal of the EU Registration, as well as renewing the EU Registration.

Conversion – as with the existing conversion procedure in the EU, a TM owner would be able to apply to "convert" the EU Registration into a UK registration, complete with a new examination procedure. The EU Registration would, however, continue to exist.

Even if something like the Montenegro Model is chosen, and all EU TM Registrations automatically have effect in the UK after the UK leaves the EU, there is likely to be some period of uncertainty while this takes effect. We would therefore recommend that clients consider re-filing their EU Trade Marks in the UK, especially where the mark is a house mark or house logo. Additionally, we would recommend

that consideration be given, when filing a new EU Trade Mark Application, also to filing a corresponding UK Application.

There is also the question of how “use” of a trade mark will be treated. At present, the validity of an EU Trade Mark Registration may be maintained provided it is used, in a genuine manner, in one country of the EU. The question then arises as to how an EU Registration will be treated, post-Brexit, if it has only been used in the UK. We would hope that the EU IPO will consider “use” in the UK to be genuine use in the EU, for some years after the final date of the UK leaving, but we cannot be sure. If, therefore, clients are concerned about the use of their EU Trade Mark Registrations, and particularly if an EU Trade Mark has only been used in the UK, then consideration should be given to re-filing an EU mark, perhaps closer to the final date of Brexit, so as to ensure as long a period of non-vulnerability as possible.

The situation with Registered Designs is similar to that which currently exists in respect of Trade Marks. ITMA has also confirmed that it is looking at the same scenarios as in respect of Trade Marks to ensure the continued validity of EU Registered Designs in the UK.

However, there is one significant difference. Due to the “novelty” requirement which exists as a prerequisite for the validity of a Registered Design, it will not be possible simply to refile in the UK to cover the same subject matter as is already protected by an EU Registered Design. On the plus side, however, as there are no “use” requirements in respect of Registered Designs as there are with Registered Trade Marks, the question of the validity of an EU Registered Design cannot be called into question in this manner.

Clients should, therefore, consider filing UK Registered Designs along with new EU Registered Designs, but there seems to be no reason to attempt to file UK Registered Designs to mirror any existing EU Registered Designs. Although UK IPO

does not examine design applications for novelty, and so the Application is likely to proceed to registration, the validity of that later UK Registered Design could be called into question.

REPRESENTATION AT THE EUIPO

At present, the UK is a member of the European Economic Area (EEA), due to its membership of the EU. If the UK does, therefore, leave the EU, then it will also leave the EEA. Under the current rules of the EUIPO, professionals who are qualified in member states of the EEA are entitled to represent others before the EUIPO. If, therefore, the UK leaves the EU and does not rejoin the EEA, then those UK professionals who are only qualified in the UK, will not be able to act for others before the EUIPO. As our readers will be aware, the question of whether the UK should join the EEA (with all the requirements and commitments that this would entail), is currently the subject of much debate within the UK.

Maucher Jenkins would, however, like to reassure all of its clients that our activities will not be changed, even if the UK does not rejoin the EEA after Brexit. Maucher Jenkins, unlike a number of other firms within the UK, has had a longstanding presence in Germany, with our Munich Office operating for over fifteen years. Further, and far before the UK’s referendum on whether to leave the EU took place in June 2016, RGC Jenkins & Co commenced merger negotiations with the well-established firm of Maucher Borjes & Kollegen in Freiburg, with the merger being completed in August 2015. With Germany remaining resolutely in the EU, we will be able to continue to act before the EUIPO for all of our clients.

Additionally, we have a number of individuals outside of our German offices who are qualified to act not only in the UK, but also in various other countries of the EU, and also a number of other individuals in our UK Offices who are nationals of other member states of the EU. All of

these will be able to continue to act before the EUIPO, even if not based within our German Offices.

Maucher Jenkins is therefore highly confident that we will be able to continue to act for all of our clients, from all of our offices even after the exit of the UK from the EU.

LITIGATION

Both the German and UK Offices of Maucher Jenkins have been increasing their litigation practices over the last few years. There will be no effect of Brexit on our litigation teams, and we will continue to handle disputes in all areas of IPO in the English and German Courts, as well as continuing to manage multi-jurisdictional cases in Europe and beyond.

A WORD ABOUT PATENTS

The subject of patents and the effect of Brexit will be covered more comprehensively in our Patent Issues publication. However, we would like to take this opportunity to reassure all clients that as the EPO is not an EU institution, the exit of the UK from the EU will have no effect on our patent attorneys’ ability to represent third parties before the EPO. Similarly, we will be able to represent clients before the Unified Patent Court, if that body does, indeed, ever come into existence.

Conclusion

This writer had always wondered why the Chinese saying “*May you live in interesting times*” was regarded as a curse. This writer now knows why. We do indeed live in interesting times, but this writer, and the whole of Maucher Jenkins, is confident of the future of the firm, and our continued ability to represent all clients in all areas of IP, both contentious and non-contentious, throughout the EU and further afield.

EUROPEAN PERSPECTIVES

NIKKI KEEPS HER KULE



Fútbol Club Barcelona, commonly known as “Barça”, and its fan base have a long history. The term “Barça fans” refers to the official online fan community of the club, but the ordinary fans who are not formal members are known as “culers”. This name derives from the Catalan word, “cul” – a crude reference to the backsides of supporters who used to sit crammed in a row over the stand at a small stadium in Barcelona where the club played in the early part of the 20th century!

It appears FC Barcelona saw an opportunity to exploit the public’s adoption of the name “CULE” for supporters of the club, by registering the name as a trade mark in Spain for various merchandise goods. FC Barcelona claims that the name “CULE” is well-known in Spain as a reference to its supporters. It is therefore no surprise that FC Barcelona was concerned about an application by Kule LLC, (a U.S. company) to register “KULE” as an EU trade mark for *inter alia* jewellery in class 14, leather goods in class 18 and clothing, footwear and headgear in class 25. Kule LLC represents the interests of the well known American fashion designer

Nikki Kule who began her career with the launch of a range of luxury children’s clothing in 2001 and has since branched out into a so-called “Preppyuxe” women’s collection.

Kule LLC’s EUTM application was published for opposition purposes on 3 August 2011 and FC Barcelona filed opposition. The club based its opposition on Spanish trade mark registrations for the word mark “CULE” covering identical and very similar goods in all 3 classes. FC Barcelona also claimed non-registered trade mark rights and well-known status in “CULE”.

On the face of it, FC Barcelona’s opposition, based on a highly similar trade mark for identical goods was strong. However, the registered rights on which FC Barcelona based its opposition dated back to 1983-1986. Consequently, Kule LLC was entitled to put FC Barcelona to proof of use of the earlier marks in Spain which it did. FC Barcelona filed evidence in order to demonstrate genuine use of the marks. This evidence comprised an extract from a Spanish dictionary defining the term

“culé” and a selection of online print-outs making reference to FC Barcelona and its supporters, nicknamed “culés”.

The Opposition Division rejected the opposition and FC Barcelona filed an appeal. The appeal was dismissed by the Fourth Board of Appeal which found that FC Barcelona had not demonstrated genuine use of the earlier marks in relation to the goods concerned. Use of the term “culé” in connection with supporters of the football club did not constitute genuine use of the mark in relation to the goods in classes 14, 18 and 25 covered by the earlier marks and on which the opposition was based. Secondly, FC Barcelona produced some documents for the first time before the Board during the appeal proceedings. In exercising its discretion as to whether to take these documents into consideration, the Board decided to disregard the documents. Furthermore, FC Barcelona did not prove the existence, validity and scope of protection of the earlier non-registered and well-known marks.

In an appeal to the General Court (*Futbol*

CULE

Club Barcelona v Kule LLC; T-614/14), FC Barcelona argued that the Board of Appeal erred in refusing to take into account documents produced for the first time before it (the Board) during the appeal proceedings and in the second part of its plea, it argued that the documents produced within the period prescribed by the Opposition Division should not have been considered insufficient.

The General Court found that the Board of Appeal had correctly exercised its discretion by providing a statement of reasons and by taking due account of all the relevant circumstances, in particular the fact that the evidence submitted out of time was not actually relevant to the case, as it did not provide indications concerning the place, time or extent of use of the earlier trade marks in relation to the goods covered by the Spanish registrations.

In determining whether the evidence filed within the prescribed time limit was sufficient, the Court noted that proof of genuine use under the EUTM Regulation does not include token use, it must establish real commercial exploitation of the mark to maintain or create a market share. The Court went on to note “genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned”. In reviewing the evidence filed consisting of online printouts, the Court noted that there was no reference in these documents to the trade mark “CULE” in connection with the goods covered by the trade mark registrations on which the opposition was based. Furthermore, the documents were undated so it could not be determined whether the evidence was from the relevant period.

Under the old Proof of Use rules, an Opponent put to proof of use of its earlier mark(s) had to supply evidence of use during the period of five years immediately preceding the date of publication of the contested EUTM (or, as it used to be known, CTM) application. This rule continues to apply in the case of oppositions such as this one, which

were filed prior to the coming into force of the Amending Regulation on 23 March 2016. In the case of oppositions filed after this (March 2016) date, in which an opponent is put to proof of use, evidence of use must be shown for the five year period immediately preceding the date of application or the date of priority of the contested EUTM application.

The General Court concluded that the Opponent in this case had failed to provide evidence showing the place, time, extent

and nature of use of the earlier marks in relation to the goods covered by the registrations on which the opposition was based. It was not good enough that FC Barcelona had shown that the Spanish term “culé” was used in relation to the football club as a nickname for its supporters, as such use was not use in relation to the goods covered by the registrations. Consequently, the Court rejected the second part of FC Barcelona’s plea and the action was dismissed.

Comment

This General Court decision is a blunt reminder to opponents of EUTM applications who rely on marks that are more than five years old at the date of application or at the date of priority of the contested application, that they must be prepared to adhere to the strict Proof of Use requirements concerning place, time, extent and nature of the use as set out in Rule 22(3) EUTMIR.

Opponents cannot rely on public recognition of their marks in isolation to meet the Proof of Use requirements, they must show that the marks have been used during the relevant period in relation to the goods (or services) for which the marks are registered and on which the opposition is based. Furthermore, they must show that the marks have been used in the EU to such an extent as to create a market share in the goods (or services).

One of the online printouts relied on by the Opponent in these proceedings was a printout from the Wikipedia website. The Court issued a reminder that information contained in Wikipedia articles lacks certainty as Wikipedia is a collective encyclopaedia created online, the content of which may be amended at any time and in some cases by anonymous visitors of the website. Whilst this “Wikipedia” rule may make some sense for a certain, limited number of controversial entries, it makes no sense at all for, and cocks a snook at, the vast majority of perfectly legitimate definitions that are found at this free, and widely available, Wikipedia source. No doubt in a decade or so, the Court will catch up with the rest of us.

The outcome of this case is unfortunate for FC Barcelona given their long-standing rights in the trade mark “CULE”, but they were naïve to believe they could rely on these rights without adhering to the strict Proof of Use requirements. It is surprising that, in the absence of relevant evidence, they took this case as far as the General Court. The CULE mark was registered in Spain in classes 14, 18 and 25 back in the 1980s, presumably to coincide with the launch of a range of merchandise under the name. Perhaps it never took off, or the range was phased out over a period of time. Alternatively, it is possible that FC Barcelona registered the name as a trade mark merely as a means of laying claim to it without exploiting it commercially. Whatever the case, FC Barcelona could not expect to succeed in opposition proceedings based on old, unused marks. Rather predictably, they ended up receiving a legal kick in the “cul”.

EUROPEAN PERSPECTIVES

MCMUFFIN WITH YOUR MACCOFFEE, SIR?



If anyone was in any doubt as to the repute of the McDonald's family of "Mc" prefixed trade marks, they will be reassured to note that said repute was recently acknowledged by the (European) General Court in Case T-518/13, *Future Enterprises v McDonald's International Property* issued on 5 July 2016.

BACKGROUND

In January 2010, a Singapore based company, Future Enterprises ("Future"), obtained an EU trade mark registration for the mark **MACCOFFEE** in respect of goods in Classes 29, 30 and 32. In August of the same year, McDonald's applied to invalidate the **MACCOFFEE** registration based on its earlier EU registrations for **McDONALD'S**, **McFISH**, **McTOAST**, **McMUFFIN**, **McRIB**, **McFLURRY**, **CHICKEN McNUGGETS**, **McCHICKEN**, **EGG McMUFFIN**, **McFEAST**, **BIG MAC**, **PITAMAC**, together with the well-known German trademark **McDONALD'S**, covering various classes of goods and services, including Classes 29, 30, 32, 42 and 43.

The invalidity action succeeded on the ground of Article 8(5) EUTM Regulation No. 207/2009, namely that, given the long standing reputation acquired by the **McDONALD'S** trade mark and the establishment, on the part of the relevant public, of a link between the marks **McDONALD'S** and **MACCOFFEE**, there was a serious likelihood that use, without due cause, of the **MACCOFFEE** mark would take unfair advantage of the reputation of the **McDONALD'S** mark.

In June 2013, Future's attempt to overcome the decision of the Cancellation Division was thwarted by the Board of Appeal, which upheld the decision in its entirety. Future subsequently took the matter to the General Court which, in turn, upheld the decision of the Board of Appeal.

GROUND'S FOR APPEAL

In order to invalidate the mark **MACCOFFEE** under Article 8(5) successfully, McDonald's would have to establish that four specific conditions had been met, namely;

- 1) The **McDONALD'S** mark predated the **MACCOFFEE** registration;
- 2) The marks **McDONALD'S** and **MACCOFFEE** were identical or similar;
- 3) The **McDONALD'S** mark was shown to have a reputation in the EU; and
- 4) The use of **MACCOFFEE**, without due cause, would lead to the risk that unfair advantage might be taken of the distinctive character or repute of the **McDONALD'S** mark or might be detrimental to the distinctive character or repute of the **McDONALD'S** mark.

In their appeal to the General Court, Future argued that the second and fourth of these conditions had not been satisfied in the present case.

SIMILARITY OF MARKS

Future claimed that:

- The marks **MACCOFFEE** and **McDONALD'S** were visually dissimilar;
- The prefixes "mac" and "mc" were dissimilar in pronunciation; and
- Conceptually, the marks were dissimilar, since **McDONALD'S** would be understood to be a surname, whereas "mac" in **MACCOFFEE** would likely be understood to refer to the American slang word used to address a stranger.

Although they admitted that the Board of Appeal was incorrect in stating that there was a degree of visual similarity between the two marks in question, the General

Court held that:

- The prefixes "mc" and "mac" were traditionally pronounced in the same way, in particular by the part of the public that perceives them as prefixes of Gaelic names (English-speaking public);
- The marks at issue had a certain degree of conceptual similarity, since the prefixes were perceived by the relevant public as referring to a surname of Gaelic origin and were written interchangeably as such as "mc" or "mac";
- Further, the Board was correct in finding that the final part of the **MACCOFFEE** mark would be understood, at least by the English speaking part of the relevant public, to refer to a hot beverage. Therefore, the relevant public would likely perceive the **MACCOFFEE** mark to be a beverage produced by a person of Scottish or Irish origin;
- Consequently, the overall similarity between the marks was sufficient for the relevant public to establish a link between them, even if it does not confuse them.

Future also contested the Board's findings that:

- a) The existence of the family of "Mc" marks was relevant when assessing whether the relevant public established a link between the marks in question; and
- b) There was a certain degree of similarity between the goods and services in question due to the close links between them.

Future claimed that McDonald's had not



provided evidence that the earlier Mc- prefixed marks belonging to McDonald's were perceived by the relevant public as constituting a family of marks. However, the Court held that the evidence submitted by McDonald's had indeed demonstrated that these earlier Mc- prefixed marks formed a "family of marks" and had been used as such.

Ultimately, what mattered was that the MACCOFFEE mark reproduced the common characteristics that connected the earlier marks of the "Mc" family of marks and that differentiated them from the McDONALD'S trade mark, namely the use of "Mc" (or, in the case of the Future Enterprises owned mark, "Mac") together with the name of an item of food found on a fast-food menu.

With regard to the issue of similarity between the goods and services in question, the Court confirmed the Board's finding that the foodstuffs and restaurant services in question were intended for the same consumers and that those goods and services were therefore complementary. Further, the goods covered by the MACCOFFEE registration could be offered at, and consumed on the spot in, the establishments where McDonald's offered their fast-food restaurant services. Finally, the Court confirmed that McDonald's fast-food restaurant services were available on a take-away basis and the consumer tended to establish a link between the mark affixed to the packaging of the take-way goods and the commercial origin of those goods. Consequently, the Board was right to conclude that the relevant public could establish a mental link between the marks McDONALD'S and MACCOFFEE.

RISK OF UNFAIR ADVANTAGE

Article 8(5) can only be relied upon if the proprietor of the earlier mark can prove that the use without due cause of the later mark takes unfair advantage of or is detrimental to the distinctive character or repute of the earlier EUTM. The establishment of a mere link between the marks is not sufficient to establish protection under Article 8(5).

In the present case, Future disputed the Board's finding that they would take unfair advantage of the reputation

of McDONALD'S through use without due cause of the MACCOFFEE mark. The Board's decision was based on the following assessments:

- 1) The considerable reputation of the McDONALD'S trade mark;
- 2) The distinctive character acquired by the prefix "mc" combined with the name of a menu item or foodstuff, for fast-food restaurant services and goods on the menu of fast-food establishments;
- 3) The fact that the MACCOFFEE mark reproduced the same structure as the "Mc" family of marks; and
- 4) The fact that the goods and services in question had a certain degree of similarity because of the close links between them.

Future did not dispute the reputation of the McDONALD'S mark in respect of fast-food restaurant services, but did challenge the rest of these criteria. However, the Court held that the assessments made by the Board were indeed correct and those factors combined led to the right conclusion that it was highly likely that the MACCOFFEE mark "rode on the coat-tails" of the McDONALD'S mark due to the possible transfer, by the relevant public, of the image of the McDONALD'S mark or of its characteristics to the goods covered by the MACCOFFEE mark.

Future also complained that the Board failed

to take into consideration the coexistence in the market of the McDONALD'S and MACCOFFEE marks in Bulgaria, Estonia, Cyprus, Latvia, Hungary and Poland since 1994, claiming that McDonald's had acquiesced with their mark in these territories. This argument was immediately rejected, since the fact that McDonald's had brought the cancellation action before the EUIPO less than seven months after the registration of the MACCOFFEE mark meant that Future could not claim acquiescence under Article 54(1) of the Regulation in the present case.

The Court held that the "peaceful coexistence" to which the applicant referred was in relation to the coexistence of the McDONALD'S mark with a number of the applicant's national MACCOFFEE marks, but this did not amount to evidence that the coexistence was general and related to all of those national marks. Further, in the Court's opinion, there could have been many reasons for an absence of a challenge against these national marks, which were not necessarily related to the perception of the relevant public in those territories. The Court also pointed out that McDonald's evidence submitted in relation to the present case revealed that some of Future's national MACCOFFEE marks had been the subject of actions by McDonald's before the courts in Germany, Spain, Sweden and the UK, which demonstrated a lack of "peaceful coexistence".

Comment

As mentioned above, Future already uses the MACCOFFEE trade mark in a number of European territories. Indeed, they claim to have been using this brand in Russia in relation to their coffee products since the early 1990s. The writer notes that the MACCOFFEE brand also has a presence in Africa, the Middle East and Asia and is therefore clearly an important brand for Future.

The fast-food goliath McDonald's, on the other hand, operates in over a hundred countries worldwide and is fiercely protective of its lucrative McDONALD'S brand and any fast food related brand containing either the prefix Mc- or its close relation Mac-. Therefore, it is probably safe to say that this is unlikely to be the last dispute to arise between these two parties or indeed any other third party daring to "ride on the coat-tails" of the well-known McDONALD'S brand. This decision certainly counts as an important victory for team McDonald's and will no doubt be relied upon as evidence of their strong reputation in future actions.

NEWS SNIPPETS



The official drive towards plain tobacco packaging continues in the European Union, including the UK, in spite of the fierce resistance being mounted

by major tobacco companies. Plain, or standardised, packaging often requires the removal of attractive, promotional materials from tobacco products, leaving the brand name, written in standard typeface, colour and size, as the only distinguishing feature.

At the EU level, the governing legislation is the Tobacco Products Directive (2014/40/EU). This Directive strengthens the rules on how tobacco products are manufactured and sold in the EU. It also regulates the production and sales of *inter alia* flavoured (e.g. menthol) and electronic cigarettes.

Perhaps the most important features of the Directive are that:

- i) Health warnings (picture and text) must cover at least 65% of the front and back of cigarette and roll-your-own tobacco packaging (with written warnings on the side); and
- ii) EU Member States can also introduce additional legislation requiring standardised (non-promotional) packaging. France, Ireland and the UK have already taken up this opportunity with national legislation that dictates the nature of tobacco products.

The validity of a number of provisions in Directive 2014/40/EU was challenged by British American Tobacco and Philip Morris in a case that reached the Court of Justice of the European Union (CJEU; C-547/14). In rejecting the arguments made by the two tobacco giants, the CJEU found that

- It was open to EU Member States to maintain or introduce further requirements solely in relation to aspects of the packaging of tobacco products that are not harmonised by the Directive.
- The prohibition of elements or features

on packaging, even if factually accurate, that promote a tobacco product or encourage its consumption was proportionate and necessary in order to achieve the public policy objective, namely to protect consumers against the risks associated with tobacco use.

- The Directive's rules on health warnings (text and image), including the size of such warnings, did not go beyond the limits of what is appropriate and necessary.

As mentioned above, the United Kingdom, along with France and Ireland, has taken the opportunity given by the Tobacco Products Directive to introduce new rules requiring plain packaging. This legislation is entitled The Standardised Packaging of Tobacco Products Regulations 2015. It regulates the size, shape, colour and appearance of cigarette and roll-your-own tobacco packaging. It also dictates the nature of the text that may be employed. Essentially, in the UK, all tobacco packaging would have to be olive green and would also have to carry the substantial health warnings required by the Directive.

This UK national legislation was also challenged (by BAT, Imperial Tobacco, Japan Tobacco and Philip Morris) in the English High Court (2016 EWHC 1169). In a long and detailed judgment given by Mr Justice Green, the tobacco companies' arguments were again dismissed. The judge ruled as follows:

"The essence of the case is about whether it is lawful for states to prevent the tobacco industry from continuing to make profits by using their trade marks and other rights to further what the World Health Organisation describes as a health crisis of epidemic proportions and which imposes an immense clean-up cost on the public purse...In my judgment the regulations are valid and lawful in all respects."

As a result, the UK legislation was implemented on 20 May 2016, even though it is reported that BAT and Japan Tobacco intend to appeal the High Court decision.

Finally, in an even more worrying development for tobacco brand owners, it has recently been reported that the French authorities may seek to interpret

their new (national) health code article (Décret no. 2016-334), based, in part, on the provisions of the Tobacco Products Directive, broadly enough to prevent the use of certain tobacco trade marks; *Gitanes* and *Gauloises* being specifically mentioned. The new French (health) article states that health products "must not include any element that contributes to the promotion of tobacco or give any erroneous impression of certain characteristics". It has been suggested in the French press that this could cover impressions of, for example, masculinity, femininity or youth. Given that the *Gitanes* cigarette pack features the image of a slim woman dancing with a fan in one hand, commentators claim that the brand (*Gitanes*) itself could fall foul of the new French law and could therefore be banned. This would, of course, be the doomsday scenario for the tobacco manufacturers. Such a broad interpretation of the legislation would therefore be very fiercely contested.

If the present fight regarding tobacco branding is eventually won by EU legislators, expect them to turn their attention to the activities of alcohol producers, soft drinks manufacturers and fast food retailers.

As, at the time of writing, the writer looks back on the drama that unfolded during the 2016 Olympic Games in Rio de Janeiro, it is hard not to look back, at the same time, to the earlier celebration held in 2012 in London. Although the host nation four years ago could hardly keep up with the medals won, the records broken and the athletic performances imprinted forever on the mind, perhaps, for many Brits, the most memorable aspect of the whole event was the Isles of Wonder opening ceremony that was put together by the creative director, Danny Boyle. There were



many high points, including the Queen's arrival by parachute under the protection of James Bond. From a personal perspective however, the Industrial Revolution scene, during which the five Olympic Rings were forged, stands out. A key aspect of that part of the opening ceremony was a group of 965 volunteer drummers who kept up a cacophony of sound throughout the scene. This group was known as The Pandemonium Drummers and it is with these amateur musicians, and their distinctive name, that our story now unfolds.

After the exhilaration of their Olympic adventure, it is perhaps not surprising that (at least some of) the performers wished to continue their musical activities. They therefore created a Facebook page, a Twitter account and a website. Then they set up a management group of which Mr Howard Kemp was the vice-chairman and Mr Andrew Johnston was also a member. After some disagreements between the various parties, including the incorporation of a company called The Pandemonium Drummers Ltd by Mr Johnston, he (Mr Johnston) was suspended from the Pandemonium Drummers organisation on 29 July 2013. Five days later (on 3 August 2013), Mr Johnston filed a UK trade mark application for *Pandemonium Drummers* in Class 41. This application was opposed (O-144-16) by Mr Kemp (as the trustee for the members of the Pandemonium Drummers Association). The primary ground of opposition was that the application had been filed in bad faith (Section 3(6) of the Trade Marks Act 1994). The unrepresented Association put forward a large amount of hearsay evidence that was given little weight. However, they did also show that Mr Johnston had used his UK right to oppose an EUTM application filed by Mr Kemp (on the authority of the Association) for *The Pandemonium Drummers*. Mr Johnston put forward evidence that he had become the *de facto* spokesman and representative of the Pandemonium Drummers organisation. He also argued that he had only filed the UK trade mark application in order to protect the mark on behalf of all the drummers.

The Hearing Officer was not persuaded that Mr Johnston's activities were well intentioned and refused his application on the basis that it had been filed in bad faith. Mr Johnston had sought to maintain sole control of the trade mark when he was not entitled to do so and thereby to disrupt the Association's activities.

Given that Mr Kemp's EUTM for *The Pandemonium Drummers* has proceeded

to grant, it appears that Mr Johnston drum solo is now over. Perhaps he could set up his own rival group, The Ring O' Stars for example.



The German company, Takko Holding filed an EUTM application in April 2010 for the trade mark *Jackfruit* claiming goods and services in Classes 18, 25 and 35. The application was opposed by the US corporation, Fruit of the Loom, not on the basis of earlier rights in its house mark but rather based on an earlier EUTM for the mark *Fruit* itself covering Class 25 goods. This earlier (*Fruit*) mark was granted on 4 May 2007.

In February 2013, the Opposition Division of the EUIPO partially upheld the US corporation's opposition in respect of some of Takko's Class 18 goods, as well as all of the Class 25 goods applied for.

In response to this adverse decision, Takko filed an appeal and, at the same time (in April 2013) applied to cancel Fruit of the Loom's EUTM registration for *Fruit* in Class 25 on the ground of five years non-use (Article 51(1)(a) of the Regulation). This non-use cancellation action recently reached the (European) General Court for consideration (*Fruit of the Loom v Takko Holding*; T-431/15).

Before the EUIPO's Cancellation Division, the US corporation filed a substantial body of evidence aimed at showing genuine use of the trade mark *Fruit* in the EU during the relevant five year period (26 April 2008 to 25 April 2013). This evidence could be divided into three categories:

- i) Use of the word *Fruit* as part of other trade marks, especially *Fruit of the Loom*;
- ii) Use of the word *Fruit* in various circumstances such as an abbreviation of the company name, in a domain name (*fruit.com*) and in advertising campaigns (The Fruit Code and The Fruit Club); and
- iii) Stand-alone use of the word *Fruit* and the phrase *Fruit 1851* in the preparation

for the launch of a new clothing range (*Born in the USA*). In relation to this alleged use, the evidence showed that, during the relevant period, the *Born in the USA* range of products, which featured the trade marks *Fruit* and *Fruit 1851* affixed on small labels stitched on the goods, was presented to potential business clients in the EU and also featured in catalogues and sample products that were sent to possible EU distributors. However, the *Born in the USA* range did not go into full production and the launch was stopped in 2012.

Taking an overall assessment of the evidence of use provided, the Cancellation Division decided that none of the ways in which the word *Fruit* had been used by the US corporation proved genuine use of the registered mark (*Fruit*). The use of *Fruit* as part of the EUTM proprietor's other composite marks (e.g. *Fruit of the Loom* and *Fruit 1851*) was insufficient as regards the nature of use because those composite marks were not acceptable variations of the registered mark. Further, use of the word *Fruit* in the preparation for the launch of the *Born in the USA* range was not public and outward enough, and was not sufficient to prove the US corporation had seriously tried to acquire a commercial position on the EU market for the mark *Fruit*. Finally, the other uses shown of the word *Fruit* did not convincingly qualify as trade mark use for the registered goods. For all of these reasons, the Cancellation Division revoked Fruit of the Loom's EUTM registration. This decision was confirmed by the Second Board of Appeal (R1641/2014-2).

Fruit of the Loom appealed to the (European) General Court (T-431/15) who took a different view. In annulling the cancellation of the US corporation's EUTM registration, the Court ruled as follows:

- The outward use of a mark does not necessarily mean use aimed at end consumers. The relevant public to which marks are addressed includes end consumers, specialists, industrial customers and other professional users.
- Genuine use of a mark in respect of Class 25 goods could include commercial acts aimed only at professionals.
- Subsequent activities, such as a decision not to launch a clothing range, may not, in principle, be taken into account when assessing the genuine nature of the original activities (e.g.

preparations for launch). However, they may be taken into account if they show that the original activities constituted mere token activities/preparations.

- Even if the use (of *Fruit*) identified by the trade mark proprietor was not sufficient for the general public to become familiarised with the trade mark *Fruit*, that finding did not necessarily apply to professionals operating in the Class 25 area. The Board of Appeal had failed to consider the ways in which clothing was marked and to explain why relevant professionals would have failed to notice labels (bearing the trade marks *Fruit* and *Fruit 1851*) stitched onto clothing.

For all of these reasons, the General Court overturned the Board of Appeal's decision and maintained *Fruit* of the Loom's EUTM registration for *Fruit*.

Whilst this pig's breakfast of a decision (which is very likely to be appealed) gives hope to EUTM proprietors who are seeking to maintain their registrations with the flimsiest of use evidence, it also puts another nail into the coffin of EU trade mark consistency. It now appears that preparations for the launch of a clothing brand, even when that brand is a secondary identifier and even when that launch is abandoned, without a single product reaching the EU general public, can count as genuine use of a trade mark in the EU. Except when it doesn't. When another case with a very similar, or even an identical, factual situation arises who will be able to predict, with any degree of certainty, what the likely outcome will be? In the writer's view, no one will be able to do so, least of all the General Court. As often in EU trade mark practice, it will be useful to have a coin handy in order to toss it.

There is only one way to try to improve this regrettable situation. That is to establish a European Intellectual Property Court, containing IP specialists, with a division that deals exclusively with trade mark cases. Such a Court would of course face its own difficulties and would no doubt make its own contentious decisions. However, the position surely could not possibly be worse than the one that trade mark owners and their advisers face in the EU at present.

To some it is a rude word, to others it embodies the new Elysium, whichever is your point of view, there is no escaping Brexit. If it is not enough to be faced

with the awful political reality, we may soon be confronted

by a range of Brexit products here in the UK (and perhaps elsewhere). One might infer this anyway from the spate of UK and EU trade mark filings for *Brexit* marks that have been filed since the fateful referendum day.

You could perhaps start with *English Brexit Tea*, as provided by the German company Leisure Fun & Toys. If you are looking for something stronger (and who in their right mind isn't?) you might consider a *Brexit* alcoholic beverage provided by any one of John Brewster, London IP Exchange, Halewood International and Gölles GmbH, all four of whom have filed for the dreaded word in either Class 32 or Class 33 or both. Since it is probably best not to imbibe *Brexit* beer or liquor on an empty stomach, you could consider accompanying it with a box of Anita Smith's *Brexit* biscuits, Metodi Yurukov's *Brexit* chocolates or Anthony Rowcliffe and Son's *Brexit Blue* cheese. In difficult times, it is not unusual for the public to lose themselves in light entertainment, so one is gratified to note that Christopher Bryant has sought to protect *Brexit – The Musical*. Perhaps Mr Michael Gove and Mr Nigel Farage, both of whom I understand now have the opportunity to consider new horizons, could be persuaded to take leading parts, possibly as The Ugly Sisters. I see berets, I see lederhosen, I see stiff upper lips.

And finally, if it all becomes a bit too much and you decide to emigrate, you could do worse than approach Allen & Overy's *Brexit Law* for legal advice on the move.

How broad are the rights associated with a stylised letter mark in the UK? Not as broad as you might hope appears to be the answer given in a recent UK trade mark opposition (*RAAMaudio UK v Power Integrations*).

RAAMaudio applied to register the trade mark *PI Supply* for a broad range of goods and services in Classes 9, 11, 16, 35, 38, 41 and 42 in the UK.

The UK trade mark application was opposed, in so far as it claimed goods



and services in Classes 9, 11, 16, 35, 41 and 42, by the US corporation Power Integrations on the basis of an earlier EUTM for a *PI (stylised)* mark, see below, covering Class 9, 41 and 42 goods and services.

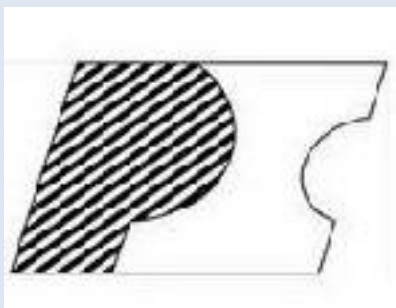
Given the identity and/or similarity of many of the conflicting goods and services, the Hearing Officer's decision essentially came down to a comparison of the two marks. Her findings were as follows:

- The letters P and I were clearly discernible in the opponent's mark, even though they were fairly heavily stylised. There was however a very low degree of visual similarity.
- The first element of the mark applied for (PI) would be pronounced identically to the early mark (*PI (stylised)*). On that basis there was a high degree of aural similarity.
- The average UK consumer of the goods and services at issue would not understand PI as a Greek letter, although some of them would see it as a mathematical symbol. For those who did recognise the mathematical symbol, there would be a conceptual identity between the marks. For the rest the conceptual position was neutral.
- The earlier mark had a reasonably high degree of inherent distinctiveness, although this was attributable to the stylisation rather than to the letters themselves.

Taking all of the above into account, the Hearing Officer ruled in favour of the trade mark applicant in these terms.

"Although the marks are aurally highly similar and conceptually (potentially) identical, my finding that the marks are visually similar to only a very low degree is of particular importance, given that the purchase of the goods and/or services is likely to be predominantly visual. In my view, even where the goods or services in question are identical and the purchases are made by a member of the general public paying only a low degree of attention, the marks in their totalities are sufficiently different that there is no likelihood of confusion, either directly or indirectly, in respect of any of the goods and services at issue. The opposition fails under Section 5(2)(b)."

This decision appears to be in line with the general practice of the UK Trade Mark Office as well as that followed by the EUIPO. See, for example, Appeal No. R1466/2009-1 (*JC AB v Jasper Conran*)



where a *JC monogram* (CTM 4405205) was found to be dissimilar enough to the unstylised, two letter mark *JC* to avoid a likelihood of confusion. See also the UK opposition (*The Royal Academy of Arts v Errea' Sport S.P.A.* (O-036-15 and O-010-16) in which the trade mark *RA* (in bold capital letters) was found to be distinguishable from Errea 'Sports' earlier *RA logo*.

This practice leads to the clear conclusion that the owners of stylised letter marks should also seek, if possible, to protect the letters themselves. Any non-use issues that might affect the long term validity of such a registration can easily be resolved by use of the unstylised mark in written materials such as adverts, catalogues and manuals. A short term cost would, in most cases, lead to a long term saving.

This is an intriguing aspect of the above *PI Supply* opposition. The opponent does in fact own relevant earlier trade mark registrations for marks that contain the unstylised *PI* letters (*PI Databook* and *PI Experts*). However, these were not relied on in the UK opposition. By contrast, in Power Integrations' opposition to RAAMaudio's EUTM applications for *PI Supply* (words and logo) they have been relied on. We shall no doubt eventually see if this leads to different outcomes in the Alicante Office.



Finally, the writer has noted that Power Integrations appears to have switched to a new logo. It may be even more difficult to persuade the trade mark authorities that

this is a stylised form of the letters *PI*.

In an unexpected ruling (*Nissan Jidosha v EUIPO*; C-207/15), the (European) Court of Justice recently decided that common sense should trump the EUIPO's administrative convenience.

The Japanese company Nissan Jidosha owned an EUTM registration for *CVTC* (stylised) in Classes 7, 9 and 12. The registration had been filed on 23 April 2001 and was therefore due for renewal on or before 23 April 2011. On 27 January 2011, Nissan requested renewal of their EUTM registration but only in respect of goods in Classes 7 and 12. The registration was duly renewed for these (Class 7 and 12) goods, but not for the Class 9 goods

which, according to the Office's practice, were removed from the register.

Under the EUTM Regulation (Article 47(3)), an owner has a total of 12 months within which to renew a registration. This period comprises 6 months prior to the renewal date and 6 months after the renewal date (the latter period being referred to as "the grace period"). It was during this (grace) period that Nissan asked the Office to renew its registration in respect of the (previously omitted) Class 9 goods. The Japanese company requested such Class 9 renewal on 14 July, 22 July and 1 August 2011. By a decision dated 26 August 2011, the EUIPO refused Nissan's request to renew their registration in relation to Class 9. This refusal was subsequently confirmed by the Office's Administration of Trade Marks Division. In essence, the Office reasoned that, since Class 9 had already been cancelled due to the partial renewal filed before the renewal date, it was no longer possible to renew the registration in relation to the Class 9 goods. Nissan appealed, first to the Office's Board of Appeal and then to the (European) General Court. Both appeals were dismissed, both tribunals accepting that the EUIPO had been correct in renewing the registration in respect of Class 7 and 12 goods only.

Nissan appealed further to the Court of Justice (CJEU) who took a different, much more flexible approach. The proprietor argued that

- Successive, partial renewal requests are not precluded by Article 47 (renewal) of the Regulation.
- The finding of the General Court (and the Office) prevented proprietors from taking advantage of the 6 month grace period for renewal. It was also tantamount to treating a partial renewal as a surrender of the remaining (non-renewed) goods or services. Since, under Article 50, the article dealing with surrender, a proprietor must explicitly declare the surrender of his rights in writing, a partial renewal was not also the equivalent of a partial surrender.
- The principle of legal certainty does not preclude a request for renewal of an EU trade mark from being supplemented during the 6 month grace period.

The CJEU accepted Nissan's submissions and annulled the General Court's decision. The Court of Justice accepted that

there was nothing in the wording or the intent of the renewal provisions to prevent

the submissions of successive requests for partial renewal up to the end of the renewal grace period. In the CJEU's view, allowing such (successive) requests would not lead to legal uncertainty. Further, the EUIPO was not required to record a partial renewal until the end of the 6 month grace period (rather than at the end of the renewal period, as is the Office's practice at present).

It is to be hoped that this decision will mean that the EUIPO will, from now on, accept amendments or modifications to EUTM renewal requests that are made both before the 10 year renewal term expires and during the renewal grace period.

If they do change their practice and allow second renewal requests, it remains to be seen whether or not the Office will facilitate such second requests by allowing them to be filed through their electronic renewal system. One also wonders whether a prohibitive price might be set to discourage such second requests.

Maucher Jenkins will keep a watchful eye on this area and report any interesting developments, particularly any changes in the EUIPO's renewal practice.

When two different words or phrases have the same or similar meanings in two different European languages, how close do they have to be for confusion to be found? This question was considered in a recent case (*Rotkäppchen-Mumm Sektkellerei v Alberto Ruiz Moncayo*; T-128/15) before the (European) General Court.

Mr Ruiz Moncayo filed an EUTM application for *Red Riding Hood* covering a wide variety of alcoholic products in Class 33. The application was opposed by Rotkäppchen, under Article 8(1)(b) of the Regulation, on the basis of an earlier German trade mark registration (as well as an earlier International trade mark registration) for *Rotkäppchen* covering



“alcoholic beverages” in Class 33.

Both the Opposition Division and the Appeal Board dismissed the opposition on the ground that the two marks were not confusingly similar. The German opponent appealed to the General Court.

Before the Court, Rotkäppchen accepted that *Red Riding Hood* and their earlier mark were visually and phonetically different but argued that they were conceptually similar since both referred to the fairy tale “Little Red Riding Hood”. Even though this is undoubtedly the case, the Court decided that it had not been established in the evidence and preferred to conduct an analysis of the literal meaning of the German word Rotkäppchen (Red Little Hood) and noted that this omitted any reference to a “Riding Hood”, namely a hood worn while riding a horse. It followed, in the Court’s opinion, that these differences could prevent the relevant (English or German) speaking consumers from “perceiving immediately that the meaning of the signs at issue is similar”. On that basis, the Court found that the two marks at issue were not confusingly similar and dismissed the German opponent’s appeal.

This decision is in line with earlier European Court and Appeal Board decisions on likelihood of confusion (Article 8(1)(b)) oppositions. See, for example, the General Court ruling in *Otsotspa v Distribution and Marketing* (T-33/03) in which the two marks *Hai* (German for shark) and the word *Shark stylised in the form of a shark* were found to be distinguishable. See also the Appeal Board decision (*Seat Pagine Gialle v Yell*; R1161/2000-1) that found the two marks *Pagine Gialle & Telephone Device* and *Yellow Pages* to be non-confusing, even though the Italian phrase *Pagine Gialle* means *Yellow Pages*. European trade mark practice in respect of the likelihood of confusion of marks having different visual and phonetic characteristics but the same or similar conceptual meanings (in two European languages) therefore seems to be well established and surprisingly consistent.

When we move on to EUTM oppositions based on marks with a reputation (Article 8(5)) however, a rather different pattern arises. In such oppositions, the (European) Court appears to be willing to accept that marks such as *Hai* and *Shark* and *Pagine Gialle* and *Yellow Pages*, though having a very low degree of similarity, might be close enough, provided the earlier mark also has a reputation, to establish a link between the signs, which would be enough for an Article 8(5) opposition to succeed.

This difference of approach can be seen in two recent (European) Court of Justice (CJEU) rulings, namely

- *El Corte Inglés v The English Cut* (C-603/14) where the CJEU refused to dismiss *El Corte Inglés’* Article 8(5) opposition since they believed that the relevant Spanish public might see a link between the Spanish phrase *El Corte Inglés* and its precise English equivalent *The English Cut*. On that basis, they returned the case to the General Court for further consideration; and
- *Intra-Press v Golden Balls* (C-581/13 and C-582/13) where the CJEU took an identical approach in an opposition involving the earlier mark *Ballon D’or* and the later mark *Golden Balls*. In their ruling on the *Ballon D’or* case, the Court commented (at paragraph 72) that “The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them”.

As always with European trade mark practice, nothing is ever as clear cut as it may, at first sight, appear. The instinct to prevent legitimate competition is never very far beneath the surface.

The rather strict practice that is being followed by the UK Trade Mark Office in relation to the question of genuine use is illustrated by another recent opposition decision (*Nike Innovate v Intermar Simanto*; O-222-16).

Nike applied for a UK trade mark application for *Jumpman* in Class 25. The application was opposed by Intermar on the basis of an earlier EUTM for *Jump* covering footwear (in

Class 25). By the time Nike’s application was published, Intermar’s EUTM had been granted for over 5 years and so, in order to pursue their opposition they had to show genuine use of the trade mark *Jump* in relation to footwear. The evidence of use relevant to the 5 year period prior to the publication of Nike’s trade mark application was as follows:

- 55,000 pairs of footwear (with an approximate value of \$476,000) were sold to a Bulgarian company called Runners.
- The trade mark *Jump* was used in relation to the goods sold.
- The footwear sold was primarily trainers, but some other casual shoes were also sold.
- The sales were made over the course of the last 16 months of the five year period.
- Runners sold the *Jump* products it purchased to end-consumers through its shop in Varna, Bulgaria. The shop had an area dedicated to *Jump* footwear from March 2012 (one year before the end of the relevant period) displaying *Jump* signage.
- Runners sold 170 pairs of the footwear it purchased to a Romanian company in April 2012.
- The opponent produced a Bulgarian language catalogue for its *Jump* footwear products in early 2013, three months before the end of the relevant period. There was no evidence as to its circulation.

From this, and other evidence, the Hearing Officer concluded that the opponent is a Turkish business focused on footwear, which had made sales in various EU countries prior to the relevant 5 year use period but which, during the relevant period, had only made sales in Bulgaria (with evidence of some very modest trade sales to Romania). The footwear sold in Bulgaria was sold via a retail outlet in the substantial town of Varna.



Photographs of the shop and the display of the shoes bearing the *Jump* mark were exhibited in the evidence. The evidence also suggested that there was a focus on Bulgaria, in the light of the catalogue provided.

The Hearing Officer then went on to consider the impact of this level of use of an EUTM on the opponent's ability to rely on that right in the opposition. He reached the following conclusion:

"In my view, the very small scale, very geographically limited use shown, over just 16 months of the relevant 5 year period, is insufficient to constitute real commercial exploitation of the mark in the EU and therefore genuine use. The consequence of this is that the earlier mark cannot be relied upon in these proceedings and the opposition must, therefore, be dismissed."

Given that the Turkish opponent was almost certainly well aware of the widely held view that "use in one EU country is enough to maintain the validity of an EUTM", it filed an appeal before the Appointed Person. However, at this point the opponent came up against the considerable difficulty of persuading this appeal tribunal to overturn a decision of a UK Trade Mark Office Hearing Officer. Essentially to win an appeal before the Appointed Person you have to show that it would be embarrassing for all concerned to maintain the original decision. In the present appeal that was far from the position. The Appointed Person (Mr Daniel Alexander QC), in dismissing Intermar's appeal, commented as follows:

"... the hearing officer's decision was a rational one, in the light of the evidence.... There was tiny proven use in the context of the economic market as a whole in a single shop in a single mall in a single town in one EU state. I do not think it is an irrational conclusion, having regard to case law, to consider that this did not satisfy the requirements of the CTMR."

That reflects the recognition, which underlies some of the case law relating to CTMs, of a need for some degree of proportionality (or at least an absence of gross disproportionality) between the territorial and substantive scope of rights in question and the activities a right owner has done to justify them, particularly bearing in mind that, in the case of trade marks, a proprietor is given 5 years in which to support its retention of the right. That is a general proposition recognized in every branch of intellectual property law and other areas of commercial regulation.

Moreover, in a case of this kind, a trader

is not left without remedy or potential rights. It can apply for national trade mark registrations or it can rely on local laws of unfair competition or similar to preserve the support the local market it may have established. While that is clearly not a solution in every case, decisions of the CJEU have also recognized that a CTM is only one of the instruments in the arsenal of EU and national laws for protecting undertakings' goodwill and the interests of the public."

This case shows that the proof of genuine use of an EUTM remains a controversial issue, at least amongst certain EU national trade mark offices. The EUIPO mantra that "use in one country is enough to maintain an EUTM" has never been fully accepted outside Alicante. And whilst EUTM owners may look askance at the *Jumpman* decision, they should recall that for every case in which they are an opponent seeking to prove genuine use of an EUTM, there will be another case in which they are a later applicant arguing that an opponent (or similar) has not fulfilled the evidential requirements to show genuine use.

There is a balance to be struck here between conflicting national and regional interests, as well as between the interests of earlier and later entrants to the market. Twenty years after the introduction of the EUTM system, the scales are still moving.



Would a Cheeky Italian be confused with a Cheeky Indian? That was one aspect of the question that the Appointed Person had to consider in a recent UK appeal (*Ashish Sutaria v Cheeky Italian Limited*; O-219-16).

Mr Sutaria learnt his cooking skills at Jamie Oliver's *Barbacoa* restaurant in London. This also inspired his name for *The Cheeky Indian* food stall that he operates in the St Giles area of London. He is reported as commenting "... Jamie Oliver is a cheeky chappy Everybody knows what going for a cheeky Nandos means, like going for a cheeky Nandos. It's very generic and very common." (Ed. Note: My perfect Friday night, a cheeky Nandos with the lads). Since Street Food operators are now very streetwise, Mr Sutaria filed a UK trade mark application for his *The Cheeky Indian* logo (and accompanying slogan "*Indianish Street Food*") in Class 43 in October 2014.



Another mobile catering service that is found on the streets of London is the *Cheeky Italian*. This food trader was established in 2012. It sells its Italian specialities from a 1972 Citroen Hy van that was purchased from a farm in Lille, France. It obtained UK trade mark registrations in Class 43 for both *Cheeky Italian* (stylised) and *Cheeky* in November 2013 and June 2014 respectively.

As the Italian caterer clearly thought that Mr Sutaria's filing was somewhat discourteous, disrespectful, impertinent and impudent, or, as the Italians say, *sfacciato*, they opposed his application. The Hearing Officer found the two marks to be confusingly similar. In doing so, she commented as follows:

"If the average consumer were familiar with either mark and encountered the other they would simply conclude that one was a 'Cheeky' outlet providing Italian cuisine and the other was a 'Cheeky' retailer providing Indian cuisine leading to such a connection between them that would result in a belief that the services are being provided by an economically linked undertaking."

On that basis, she found in favour of the opponent and rejected Mr Sutaria's application.

Mr Sutaria appealed to the Appointed Person (Mr James Mellor QC) who took a different view. In finding in favour of Mr Sutaria, the Appointed Person found that the word Cheeky was not sufficiently powerful, when weighed against the differences between the two marks, to give rise to a likelihood of confusion. In Mr Mellor's opinion, the Hearing Officer's original decision appeared to be based solely on a comparison of the two phrases Cheeky Italian and Cheeky Indian. This seemed to ignore the other distinguishing features of Mr Sutaria's mark. By contrast, the Appointed Person was rather impressed by the various elements in the applicant's combination mark and, when these were contrasted with the *Cheeky Italian* mark, led him to conclude that "a much greater degree of commonality would be required for the average consumer to perceive a brand extension." For these reasons, Mr Mellor dismissed the opposition and allowed Mr Sutaria's UK trade mark application to proceed to grant.

One rather odd aspect of this dispute, to the writer at least, is the absence of any meaningful comparison of the opponent's earlier UK trade mark registration for *Cheeky* (word) with Mr Sutaria's mark at any stage in the proceedings. The Hearing Officer essentially ignored it, the opponent did not press the point and Mr Mellor therefore dealt solely with the possible confusion between the *Cheeky Italian* (stylised) and *The Cheeky Indian* (Logo).

Even if that additional trade mark right for *Cheeky* had featured more prominently, it may not have led to a different outcome in the appeal. However, to ignore its existence in the above opposition seems rather perverse.

The ability of the owner of a well established brand in one country to prevent the registration of an identical or very similar trade mark in the UK was the point at issue in a recent opposition before the UKIPO (*Mr Michael Wright v Dell Enterprises Inc*; O-179-16).

Hogs & Heifers Saloon is a small chain of bars based in the USA. The name is derived from a nickname given to Harley Davidson motorcycles (Hogs) and a not terribly polite reference to women (Heifers). The original bar opened in 1992 in New York. The success of that establishment led to the launch of a second Hogs & Heifers bar in New York, as well as (in 2005) a branch in Las Vegas. A characteristic of these US watering holes has been the encouragement of female customers to get up on the bar (and tables) for a dance with a bartender, as well as the propensity of such drinkers to remove their bras and, for reasons best known to themselves, to hang the discarded items of clothing on the wall.

Although the US owner of the *Hogs and Heifers* trade mark rights has never shown any (public) inclination to expand their business into Europe, they (Dell Enterprises, Inc) did file EUTM and UK trade mark applications for both the phrase *Hogs & Heifers Saloon* and their logo (which features the image of a heifer). All of these applications proceeded to registration. For reasons that will become apparent, Dell Enterprises also owns a recently filed EUTM application dated December 2013 for *Hogs & Heifers* in Classes 21, 25 and 43.

Mr Michael Wright is an Irish entrepreneur who owns a range of bars and restaurants, principally in Ireland. According to the website of his hospitality group (www.michaelfwright.com), after an extensive

fact finding mission to China, Spain and the USA (including visits to Las Vegas and New York), Mr Wright opened The Wright Venue in Dublin which is said to be an entertainment centre featuring a casino, night clubs, bars and restaurants. In December 2013, the last remaining unit (in The Wright Venue) was filled with a *Hogs and Heifers*, American style, restaurant. This restaurant has a motorcycling theme and includes bras hanging from the wall and staff/customers dancing on the bar.

In order to pave the way for this launch, Mr Wright applied successfully to cancel Dell Enterprises' two EUTM registrations (for *Hogs & Heifers Saloon (and Device)*) on the ground of non-use. He also filed two Irish trade mark applications in November 2013 (in Classes 25, 41 & 43) for a stylised version of the phrase *Hogs & Heifers*, as well as for a *Hogs & Heifers logo* that features a pig and a heifer riding a motorcycle. Finally, Mr Wright then filed two UK trade mark applications (for the stylised mark and the logo) claiming priority from the earlier Irish trade mark applications. It was these UK applications that were the subject of the recent oppositions brought by Dell Enterprises before the UKIPO.

In the absence of any valid and enforceable trade mark rights in the UK, Dell Enterprises relied on bad faith (Section 3(6) of the 1994 Trade Marks Act) as their only ground of opposition.

The Hearing Officer, having reviewed the evidence of both sides (including cross examination of Mr Wright) reached the following conclusions:

- Mr Wright did know of the opponent's business when he adopted the (*Hogs & Heifers*) mark himself.
- Certain key themes of the US biker bars had been copied in Mr Wright's Hogs & Heifers bar/restaurant.
- Dell Enterprises had not shown that their bars were known to any material extent in Ireland or the UK.
- The allegations that Mr Wright's activities would benefit from any existing awareness on the part of potential (Irish or UK) customers had not been made out.
- It was reasonable to accept however that, since the business model had worked in the US, it would also work in Ireland and the UK.
- There was no evidence relating to the



US corporation's plans to expand abroad. Mr Wright's activities therefore did not prevent a business with a legitimate interest from expanding to Ireland

or the UK.

- The opponent had no enforceable trade mark rights in the UK, so could not claim to be the legitimate owner in this country.
- Mere knowledge of the use of a mark in another territory was not enough, without some other form of improper conduct, to succeed on the ground of bad faith.
- Copying as such was not unlawful or dishonest. The opponent had no legal right which protects the theme of its US bars. The territorial factor meant that its US trade mark rights had no application in the UK. Therefore there was no form of improper conduct by Mr Wright.

For these reasons, the Hearing Officer dismissed the two oppositions and allowed Mr Wright's UK trade mark applications to proceed. In the absence of appeals, which are unlikely to succeed, the focus of this dispute now moves to the EUIPO where Mr Wright has opposed Dell Enterprises' EUTM for *Hogs & Heifers*. Since Mr Wright's Irish and UK trade mark rights pre-date the US corporation's EUTM application, the outlook for the originator of the *Hogs & Heifers* name and concept also looks bleak down in Alicante.

The above UK oppositions show how difficult it is to prevent a UK trade mark applicant obtaining rights in an earlier, well established foreign brand unless

- There has been some kind of contact between the relevant parties,
- There was good reason to infer that the foreign trade mark owner had an intention to expand into the UK market, or
- The earlier mark had a reputation in the UK at the date of the later (UK) filing.

Dell Enterprises' failure to tick any of these boxes inevitably led to the dismissal of their bad faith oppositions. In an increasingly globalised market, this seems to be a rather harsh treatment of those with original business ideas.

Turning back to the branding of political movements, the writer has noticed that Mr Donald Trump is also active in this



field. Not only is the family name (Trump) registered as an EUTM for a wide range of goods and services in Classes 9, 20, 25, 28, 32, 33, 36, 37, 41 and 43, but a heraldic crest, designed for use with the controversial Trump golf links that have been created near Aberdeen in Scotland, has also been protected in the EU for a wide range of goods and services (see CTM 12628368). According to a Trump company source, "The coat of arms brings together visual elements that signify different aspects of the Trump family heritage. The Lion Rampant makes reference to Scotland and the stars to America. Three chevrons are used to denote sky, sand dunes and sea. The double-sided eagle represents the dual nature and nationality of Trump's heritage. The eagle clutches golf balls, making reference to the great game of golf, and the motto "Numquam Concedere" is Latin for "Never Give Up" – Trump's philosophy". Quite. The absence of Comber Felis Mortuus and Wall Statant symbols appears to be an oversight.

Interestingly, this is not the first coat of arms designed for the Trump dynasty. In an earlier version, protected by CTM 10074391 and 12629648, the family name appears together with the image of a knight holding a spear. The use of this crest got Mr Trump into trouble with the Scottish Court of the Lord Lyon back in 2008. Under a law dating back to 1672, it is a criminal offence in Scotland to use an unauthorised crest. Luckily for us all, the unpleasantness was resolved four years later, to the satisfaction of both the Lord Lyon and Mr Trump, without the need for criminal proceedings. Whether the Trump crest will eventually replace the US Presidential seal remains to be seen.

Two recent EUIPO Board of Appeal decisions involved geographical indications for alcoholic beverages.

The first appeal (R2531/2015-2) involved the EU geographical indication for Hierbas Ibicencas which is protected for aniseed flavoured spirit drinks. Hierbas Ibicencas is a herb based liqueur from the Spanish island of Ibiza.

This GI was cited by the EUIPO Examiner

(under Article 7(1)(j) of the Regulation) against an EUTM application for the trade mark *Ibiza Flirt* covering a variety of spirits in Class 33. The EUTM application had been filed by the Bulgarian company Vinprom Peshtera. The Examiner argued that the mark *Ibiza Flirt* contained the term *Ibiza* which is the anglicised version of the Spanish word *Ibicencas* which, in turn, constituted a significant part of the protected GI. It (*Ibicencas*) also conveyed the geographical aspect of the protected term.

Vinprom appealed to the Board of Appeal. However, the Board confirmed the Examiner's Article 7(1)(j) objection. In the Board's view, all of the spirits claimed in the EUTM application were similar in their characteristics to Hierbas Ibicencas. Even though the spirits of interest to Vinprom had a higher alcoholic content than the Spanish liqueur, the liqueur would still be classified with them rather than with products with a lower alcoholic content (generally below 15%) such as beer, cider and wine.

Those with an interest in Class 33 goods should note that the term *Ibiza* itself is protected as a geographical indication for wine. Both this PGI and the term Hierbas Ibicencas appear to be reasonably consistently enforced against EUTM applicants seeking to register *Ibiza* marks for alcoholic beverages.

In the second appeal (R1105/2015-4), the owner of the European wide PDO (Protected Designation of Origin) rights (Instituto dos Vinhos do Douro e do Porto IP) in (port) wine opposed a complex trade mark for a *Portobello Road No. 171* mark filed by Mr Gerard Feltham covering gin. The opposition was brought under Article 8(4) CTMR based on the opponent's rights in Porto.

The Opposition Division noted the common presence of the word *Porto* and concluded that, to that extent, they were similar visually and phonetically. Conceptually, it was suggested that the relevant public would

- Associate the common element *Porto* with the City of Porto in Portugal, as well as its wine;
- Possibly, in Italy, understand *Bello* as meaning beautiful; and
- In the UK and Ireland, recognise *Portobello* as "a large mature edible mushroom with an open flat cap".

Overall, following this and additional analysis of Mr Feltham's mark (*Road, No. 171, Gin, etc*), the Opposition

Division decided that the two marks were conceptually similar (*Porto*) and dissimilar (*the rest*).

This led to the final conclusion that the two marks are similar and that the opposed mark contained the whole PDO (*Port*). Given that gin and wine were found to be "comparable" products, the Opposition Division's global assessment inevitably led to the decision that there was a likelihood of confusion and that Mr Feltham's EUTM application should be refused.

Mr Feltham appealed and the Board of Appeal showed rather more commercial sense in overturning the original decision. Contrary to the finding of the Opposition Division, the Board decided that "gin" and "wine" were not comparable goods and did not fall within the definition of goods in EU Regulation No. 1083/2013. Further, in the Board's opinion, the two signs were dissimilar. The combination mark applied for would not be split into *Port* plus various (many) other elements. It was much more likely to be associated with London (where *Portobello Road* is situated) than with *Porto* or *Portugal*.

As the owners of the rights in *Port*, *Porto* and similar appear to have an unlimited budget when it comes to seeking to enforce their rights, even against totally different marks such as Mr Feltham's, an appeal to the General Court would not be unexpected.

Talking about names, there has been a lot in the press about the US trade mark fight between the 48 year old Australian pop star (and former soap opera actress) *Kylie Minogue* and the 19 year old, American reality television "personality" *Kylie Jenner*, a character in the TV programme *Keeping Up With The Kardashians*.

The dispute between the old *Kylie* and the new *Kylie* over rights in the trade mark *Kylie* is not restricted to the US however. In the EU, the former Australian soap star appears to have the upper hand, owning a number of earlier EUTM and UK trade mark registrations for both *Kylie* and *Kylie Minogue* for both entertainment services and a broad range of merchandise. Having said that, her rights in *Kylie* itself are quite limited and nearing the end of the grace period. So, although Ms. Minogue Sr has opposed both of the young pretender's EUTM applications (for *Kylie* and *Kylie Cosmetics*), the energy of youth might still overcome the wisdom of experience. We shall see.



Specsavers is a well-known chain of opticians that operates in the UK. It employs a logo in which the word *Specsavers* appears in white lettering within two “kissing”, dark green coloured ovals. The company owns CTM rights protecting the word mark, the logo in black and white and the two “kissing” ovals, again in black and white, but without the word Specsavers.

These rights have been much litigated, particularly against the UK supermarket Asda.

Specsavers are also well-known for their slogan “*Should’ve gone to Specsavers*”. These are often associated with sporting dramas. So, when the 2012 London Olympics opened with a women’s football match between North Korea and Colombia and the authorities raised a South Korean flag during the anthems before the match causing the North Koreans to flounce off the pitch, Specsavers had an advert in the newspapers the very next day which featured images of the two flags (North and South) accompanied by the recommendation that they “*Should’ve gone to Specsavers*”. This immediately associated the company with the London Olympics but without breaking any draconian (Olympic) laws and without having to pay a king’s ransom to become a sponsor, a partner or an official hanger-on. Clever.

In another example, during the 2014 World Cup in Brazil, after the Uruguayan forward Luis Suarez appeared to take a bite out of the shoulder of the Italian defender Giorgio Chiellini, the following day Specsavers published an advert featuring Chiellini and a dish of cannelloni with a cross next to Chiellini and a tick next to the cannelloni. Once again, the accompanying message was “*Should’ve gone to Specsavers*”.

Such quick witted and witty advertising has led to Specsavers’ slogan becoming very well-known in this country. Understandably, it is protected by an EUTM registration. It has been reported however, that the company is now seeking to protect the word *Should’ve* (and *Shouldve* without the apostrophe). This is no doubt a ploy aimed at preventing one of their competitors or, more likely, one of the British supermarkets coming up with a lookalike phrase containing the word. In principle, the writer can see no particular reason why the word should not be registrable, although enforcing it against a

phrase such as “*Should’ve trusted Asda*” might be a challenge. Having said that, the registration of *Should’ve* may not be a shoo-in, since an earlier UK trade mark application for “*Should’ve gone to*” that was filed by the optician in 2006 failed to be accepted.

Apple appears to be having difficulties in obtaining relevant, registered trade mark protection for its latest device, the *iWatch*.

Before the EUIPO, an EUTM application for *WATCH*, owned by an affiliated company, Brightflash USA, was refused by the Board of Appeal (R-1694/2014-1) in respect of “chronometric instruments and timepieces” in Class 14 on the basis that the mark was non-distinctive and descriptive (Articles 7(1)(b) and 7(1)(c) of the Regulation). The Board took the view that the trade mark applied for would be perceived as meaning “timepieces or chronographs interactive or connectable to the Internet”.

This EUTM application still covers Class 9 goods including “computer software; cameras and computers”. However, these goods have been opposed by three companies, Ice IP, Probandi Ltd and Swatch AG. In the latter case, the Swiss watch company has relied in part on earlier EUTM rights in the trade mark *iswatch* (stylised).

In the UK, an Apple Inc. owned UK trade mark application for *WATCH* appears to have befallen a similar fate. This UK case was originally filed in Class 9 and 14 but the Class 14 goods disappeared three months after filing. The remaining Class 9 goods were opposed by Swatch AG, once again based in part on the Swiss giant’s EUTM rights in *iswatch* (stylised) covering Class 14 goods and related services in Class 35.

In a recently published opposition decision (O-307-16), Apple has now lost (subject to appeal) a significant proportion of its Class 9 goods. The Hearing Officer found that the opponent’s *iswatch* (stylised) “horological and chronometric apparatus and instruments” (in Class 14) were close enough to Apple’s *WATCH* “computers, computer hardware and wireless communication devices” to lead to a likelihood of confusion. He therefore refused the opposed word trade mark application for those and related Class 9 goods. That left Apple’s UK application covering only “computer software; security devices; computer peripherals; parts, components and cases for all the foregoing goods”. The opposed application was allowed to proceed for this



narrow range of Class 9 goods.

It is noticeable that, at the Apple UK website (www.apple.com/UK), the list of products includes *iPhone*, *iPod*, *iTunes* and *Watch*. The writer could find no reference to the brand *iWatch*. Instead the terms *Apple Watch* and *Watch plus the (well-known) Apple logo* are used.

Apple has had a habit throughout its history of getting into trade mark disputes and then finding a way out of them. It remains to be seen if a solution to their *iWatch* problems can also be found.

You might have thought that the *Balti* style of cooking originated in the mountainous northern region of Pakistan known as *Baltistan*. Not if you came from the English city of Birmingham, you wouldn’t. The citizens of that city claim that the *Balti* style of curry was invented, then perfected, in Birmingham. The word is said to be derived from the Urdu word *Balti*, meaning bucket. The dish is cooked in a round-bottomed, wok-like dish with two handles, a *Balti pan*. *Balti* restaurants, otherwise known as *Balti houses*, are said to have originated in a small area of Birmingham, known as the *Balti Triangle*. It’s like the *Bermuda Triangle*, but you disappear into the toilet rather than into the sea.

With the increased popularity of curry as a meal in the UK, and a growing range of pre-cooked “*Balti*” dishes being stocked by UK supermarkets, those who claim to have originated the term have decided to try to protect their rights. That is why the Birmingham *Balti* Association only recently applied to register *Birmingham Balti* as an EU Traditional Speciality guaranteed (TSG) product in March 2015.

In a decision published in May 2016, the EU authorities refused the TSG application. The reason given was that it was not possible to determine the nature of the final recipe to be followed. Since *Balti* refers to a style of cooking rather than to a rigid set of ingredients, and since *Balti* chefs pass down their recipes by word of mouth and use additional spices to create their own signature dishes, perhaps the rejection of the Birmingham *Balti* TSG was inevitable.



Having said that, the local press suggested that the EU authorities, in making this decision, were being “anti-British” ahead of the EU referendum (which took place a month later in June 2016). Given that Birmingham eventually voted 50.4% to Leave the EU, it could be viewed as a mistake by those authorities not to have curried favour ahead of the vote by simply allowing the application.

Richard III, King of England from 1483 until his death in battle in 1485, has never got a good press. Blamed by William Shakespeare, and most others besides, for the murder of the young Edward V and his brother Richard of Shrewsbury (the Princes in the Tower), his defeat and death in the Battle of Bosworth Field, the final, decisive battle of the Wars of the Roses, was little mourned.

After the Battle of Bosworth, Richard's body was taken to the English city of Leicester and buried without ceremony in Greyfriars Church whose ruins are now located beneath a car park. After that, silence, although it was rumoured that the former King's remains had been removed during the Reformation and thrown into the local River Soar.

The Richard III Society was set up in 1924 to try to secure a more balanced assessment of the much maligned King. For decades this proved to be an uphill struggle until, in 2012, the society struck gold or, at least, an unidentified skeleton in the aforesaid (Greyfriars Church) car park, unearthed by an archaeological excavation (which the society had commissioned).

early 2013 that the remains were those of the long lost monarch. After a legal battle with the city of York over the right to bury the King again, this time in a marked grave, Richard III was reinterred amidst much pomp and circumstance in Leicester Cathedral in March 2015.

The city of Leicester has made much of this. There is a Richard III visitor centre and a Richard III walking trail, as well as Richard III short breaks. These are all associated with the city's new Richard III logo (see UK trade mark registration no. 3112841). It has even been suggested that the proper burial of the much-maligned King was the catalyst for the extraordinary story of Leicester City FC in 2015-16 whose capture of the English Premier League crown (as 5000-1 outsiders) has been explained in some quarters as the lifting of a century long sporting curse. Leicester City's leading scorer was Jamie Vardy, a Yorkshireman, which would give new meaning to Shakespeare's well-known words in Richard III, “Now is the winter of our discontent, Made glorious summer by this sun of York”, if the Bard had only spelt the word son correctly.

Smith is a very common surname. It is in fact the most prevalent surname in many English speaking countries including Australia, UK and USA. There are over half a million people who share the surname Smith in the UK.

One might have thought that, under any commercially realistic trade mark policy, this might have given the appropriate authorities pause for thought before granting monopolistic rights in such a surname.

Under the EUIPO's Wild West surname practice however, virtually anything goes. This explains why a German company, K&L Ruppert Stiftung owns an EUTM registration for Smith in Classes 18 and 25.

It is one thing to grant such a registration for a very common surname, it is another thing entirely to allow the owner to claim broad rights in the name in contentious proceedings. Unfortunately another aspect of the Office's (and the European Court's) practice is to allow such broad right to be claimed.

A recent General Court case (Yongyu Zhang v K&L Ruppert Stiftung; T-295/15) illustrates the point perfectly. Mr Zhang applied to register the trade mark Anna Smith for fashion goods in Classes 14, 18 and 25. The EUTM application was opposed, insofar as it claimed classes 18



and 25, by K&L Ruppert on the basis of their earlier EUTM registration for Smith.

The Opposition Division rejected the opposition stating that consumers in the area of fashion were used to differentiating between similar brands. Predictably the Board of Appeal overturned that decision finding that the two marks were visually, aurally and conceptually similar.

Mr Zhang appealed to the (European) General Court but to no avail. Taking the usual, simplistic line of reasoning, the Court found that because the later mark contained the whole of the earlier mark, they were similar. Further, they rejected as “ineffective” the argument that, in the fashion sector, a minor difference (such as the addition of a first name) could be significant because “trade marks are often derived from the same family name in said sector”. The Court therefore ruled in favour of the opponent and rejected Mr Zhang's EUTM application (for Class 18 and 25 goods).

The EUIPO's (and the European Court's) practice in the area of surnames is wrong and inevitably leads to poor decisions being given, as in the above Anna Smith case. First, why is the Office's examination of common surnames so different to that of common dictionary words? If it is seen as against the public interest to allow an EUTM applicant to monopolise a non-distinctive or descriptive English word without requiring proof of acquired distinctiveness, why is it not seen as against the same public interest to allow the same applicant to monopolise a very common British surname? In both cases, the likely inconvenience posed by such a monopoly (of a non-distinctive/descriptive word or a common surname), to third party competitors and to the general consumer, would appear to be the same. And yet, in the leading case on surnames (Nichols v Registrar of Trade Marks; C-404/02), the Court of Justice (CJEU) refused to accept that reasoning, legitimising the present free-for-all.

If that were not bad enough, the Office's and the Court's practice on the comparison of names has simply compounded the error. In the vast majority



Employing the DNA fingerprinting techniques developed at Leicester University, as well as other identification methods, it was confirmed in

of cases, it should be perfectly possible to differentiate between a surname and a full name, both on the trade mark register and in the market. People do this every day of their lives, why should it be different in a commercial context? This is particularly the case in the fashion (Class 18 and 25) area, where purchasers are quite discerning and where the comparison will be predominantly visual. The only circumstances where such a more liberal and commercially realistic practice might not be followed is where the surname has gained a reputation in the market, marks such as Armani, Chanel and Dior spring to mind.

It will come as no surprise to learn that K&L Ruppert's EUTM registration for Smith coexists with 47 other EUTM registrations in Class 25 for marks containing Smith, although, for reasons that the writer fails to understand, the state of the trade mark register is no longer a matter of any interest to the trade mark authorities. Nor will it come as a surprise to learn that Mr Zhang's Anna Smith brand of clothing is sold worldwide, including throughout the European Union. The Anna Smith brand coexists on the EU market with other fashion labels such as Goodwin Smith, Paul Smith, Teddy Smith and Smith & Jones. Trade mark practice and trade mark registers should reflect the reality of the market. The sooner the EUIPO and the European Court recognises this, the better.

In contrast to the *Hogs & Heifers* oppositions discussed earlier in this Snippets section, another recent UK bad faith (Section 3(6)) case (*Ferhat Anush v Renovest Gayrimenkul*; O-189-16) was decided rather differently.

Mr Anush filed a UK trade mark application for a *Huqqa sign* for a variety of goods and services in Classes 34, 41 and 43 including restaurant services. The application was granted in November 2014. A huqqa (or when anglicised hookah) is an Eastern smoking pipe.

The UK application was the subject of an invalidation action brought by a Turkish company Renovest Gayrimenkul. Amongst the grounds relied on by Renovest was bad faith (Section 3(6)). The evidence put forward by the opponent showed that :

- They owned a number of Huqqa shisha bars and restaurants in Turkey.
- Mr Anush's mark was a photograph of Renovest's signage for its Istanbul based (Huqqa) restaurant.
- The opponent had plans to expand its



Huqqa chain into London and these plans had been reported in the Turkish press which was widely read by the Turkish community in the UK.

Mr Anush claimed that his mark had been created for him by a designer, that he had never been to Istanbul and that he was unaware of Renovest's restaurants. These statements were all deemed to be false by the Hearing Officer who had no difficulty in finding that Mr Anush's UK right had been filed in bad faith and therefore cancelling it under Section 3(6). Rather impressively Renovest also established ownership of the copyright in their *Huqqa logo* and, on that basis, also ran a successful Section 5(4)(a) ground of opposition based on that (copyright) ownership.

Given that the Hearing Officer had found that Mr Anush had not been telling the truth in his submissions, he now faces a costs order of £18574.

Mr Anush was, according to this decision, a blatant copyist. If you do decide to copy the activities of a foreign brand owner, and you wish to avoid the fate of Mr Anush, you have to choose the right brand to copy and then be more subtle than Mr Anush was when developing a better stylised mark or logo and bringing that stylised mark/logo to the UK market.

Courtaulds was a United Kingdom based manufacturer of fabric, clothing, artificial fibres and chemicals. It was established in 1794 by George Courtauld and his cousin Peter Taylor. For a period of over 180 years, the company progressed from small scale silk weaving to large scale man-made fibre production until in the mid-1970s, it had become the world's largest textile manufacturer.

Like much of British industry however, from the 1980's onwards, it entered a period of decline and, after a series of mergers, demergers and takeovers, it ended up in the ownership of PD Enterprise Ltd, a privately held company based in Hong Kong. This company, through a sister company Montfort Services Sdn, now owns long established brands such as Berlei and Gossard, as well as Samuel Courtaulds. The UK trade mark and EUTM rights in Courtaulds itself for textiles and clothing, are owned by another Hong Kong based company Magellan Textile Holdings. This company also

owns the trade mark rights in other former Courtaulds owned brands such as Aristoc and Pretty Polly.

The Birmingham (UK) based company Noveltext retails a range of products including textiles. It is run by three individuals (Mahmood Shafi, Bushra Shafi and Yasser Shafi). Noveltext does not appear to have any historic connection with Courtaulds. In spite of this, in November 2014, Messrs Shafi filed a UK trade mark application for a Courtaulds Fabrics coat of arms in respect of a wide range of textile products in Class 24. This application was opposed by both Montfort Services and Magellan Textile.

In the case of Montfort, the opposition (O-209-16) was based on the opponent's earlier EUTM for Samuel Courtaulds in Classes 25 and 35. In the case of Magellan, the opposition (O-204-16) was based principally on the ground of bad faith and on the opponent's earlier EUTM registration for Courtaulds in Classes 24 and 25.

Both oppositions were dismissed. In the Montfort opposition, where no proof of use of the earlier trade mark Samuel Courtaulds was required, the issue essentially came down to a comparison of the Courtaulds Fabrics coat of arms for Class 24 goods and Samuel Courtaulds for Class 25 goods. In the Hearing Officer's view, there was no likelihood of confusion given the differences between both the marks and the two sets of goods.

In relation to the Magellan opposition however, the Hearing Officer had to do rather more work before reaching his decision. In this case, the earlier EUTM relied on was outside its non-use grace period and so Magellan was asked to prove genuine use of the trade mark Courtaulds during the relevant 5 year period. In spite of evidence that the opponent had supplied the well-known UK retailer TK Maxx with 5000 units (each containing two pairs of men's underpants) bearing the Courtaulds name, the Hearing



Officer rather surprisingly found that no genuine use of the registered mark had been established. The discrepancy between this finding and the General Court's ruling in the Fruit case mentioned above is startling. Be that as it may, a lack of genuine use meant that Magellan's principal grounds of opposition (based on their earlier EUTM) fell away.

The Hearing Officer then turned to Magellan's bad faith ground of opposition (Section 3(6)). The opponent argued that the applicants were aware of the Courtaulds brand and the Courtaulds Fabrics crest before filing their application. They also argued that it was the Shafi's intention to take advantage of Magellan's reputation and goodwill in Courtaulds.

Further the opponent pointed to other, now withdrawn UK trade mark applications that had been filed by the same applicants for marks such as Courtaulds Est 1794 and Courtaulds Textiles, as well as for another historic fashion brand Horrockses. None of this was enough to persuade the Hearing Officer to make a finding of bad faith. In his view the evidence had not established that there was anything in terms of existing goodwill or reputation from which the applicants would benefit. Additionally, since there is no property in heritage per se, the filing of an unused, historical mark would not, in the absence of any form of residual goodwill or other relative right, be considered an act of bad faith.

It is a sad commentary on the decline of much of British industry since the Second World War that a former household name such as Courtaulds is now unable to prevent a third party from copying one of its most iconic brands for commercial purposes. Whether the Hong Kong companies now seek to prevent the use of the historic Courtaulds Fabrics coat of arms by the Shafis, and indeed whether they are in a position to do so, is a question for the future. It has been done in the past, the distant past when the writer was a mere infant. In 1954, Manchester Corporation successfully sued the Manchester Palace of Varieties in the High Court of Chivalry for using its coat of arms.

In another recent case, (*Coca-Cola Company v OHIM*; T-411/14), the General Court sounded the death knell again for those seeking to register three dimensional marks as EUTM on the basis of acquired distinctiveness.

Coca-Cola filed an EUTM application in December 2011 for a non-fluted variation of its classic, contoured bottle shape

(EUTM 10532687). Perhaps unsurprisingly, the Examiner refused the mark as non-distinctive (Article 7(1)(b)).

However, Coca-Cola also filed evidence of acquired distinctiveness which included sales figures throughout the EU (the veracity of which were questioned during the Court appeal, see below) and surveys in 10 EU countries namely Denmark, Estonia, France, Germany, Greece, Italy, Poland, Portugal, Spain and the UK. These surveys found a level of recognition of between 48% (Poland) and 79% (Spain) for the trade mark applicant's bottle shape. None of this was enough to persuade the Examiner to withdraw his Article 7(1)(b) objection.

Coca-Cola appealed and the Board of Appeal confirmed the Examiner's decision. Coca-Cola appealed to the (European) General Court. The Court had no difficulty in finding that the 3D mark was inherently non-distinctive. They then moved on to the question of acquired distinctiveness. The Court first considered the survey evidence provided by the applicant. It is perhaps worth setting out in full their conclusions.

"As regards the surveys relied on by the applicant, it must be held that the Board of Appeal was correct to find that those surveys were not capable of proving that the mark applied for had acquired distinctive character throughout the European Union in respect of a significant part of the relevant public. The surveys were conducted in 10 EU Member States, namely Denmark, Germany, Estonia, Greece, Spain, France, Italy, Poland, Portugal and the United Kingdom, even though the European Union had 27 Member States at the date on which the application for registration was lodged. It is true that the surveys in question concluded that the mark applied for had acquired a distinctive character in the 10 Member States where they were carried out, with the recognition rate being between 48% (Poland) and 79% (Spain); however, they did not establish that that was also the case in the other 17 Member States. The results of those surveys cannot be extrapolated to the 17 Member States in which no surveys were conducted. In that regard, it must be pointed out that, particularly in respect of the countries that became members of the European Union after 2004, the surveys provide almost no information regarding the perception of the relevant public in those Member States. Even though surveys were conducted in Poland and Estonia, there is no justification for extrapolating the conclusions relating to those two countries to the other states which became members of the

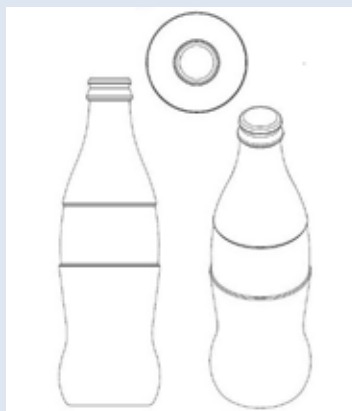
European Union after 2004. Furthermore, the applicant has not demonstrated that certain Member State markets covered by the surveys are comparable to others and that the results of those surveys could be extrapolated to them. It is not for the Court to make assumptions in that regard.

In the light of the foregoing, it must be concluded that the surveys are not sufficient in themselves to prove to the requisite standard that the mark applied for has acquired distinctive character through use, throughout the European Union, in respect of a significant part of the relevant public".

Having summarily dismissed the results of the surveys collated at no doubt great expense, the Court then moved onto Coca-Cola's sales figures. As these appear to have been full of inconsistencies (the sales in Lithuania for example being given as almost twice those in Poland, even though the population of the latter is thirteen times that of the former), the Court (probably correctly) concluded that they had no evidential value. For these reasons, the Court dismissed Coca-Cola's appeal and confirmed the rejection of the EUTM application.

Given the apparent inconsistencies in some of the evidence put forward by Coca-Cola in this case, the writer can understand the overall finding of the General Court. This however does not apply to their comments on the applicant's survey evidence. It seems to be accepted, even by the European Court, that it should be unnecessary to conduct surveys in all EU countries in order to establish the acquired distinctiveness of a non-traditional trade mark, such as a shape mark. However, as a result of a series of





European Court decisions, it is quite unclear as to how many surveys would be sufficient. In the above *Coca-Cola* case, ten surveys were conducted in countries that (in total) account for 76% of the EU population. If, as the European Court is also at pains to emphasise, the EU should be treated as a single unitary entity, how can convincing surveys conducted in ten countries, accounting for over three-quarters of the EU's population, not be enough to establish acquired distinctiveness? Further, if such a breadth of surveys is inadequate, how many would pass the test, 15, 20, 25? And how much of the EU would need to be covered, 50%, 90%, 99%? The only realistic conclusion that one could draw would be that it is necessary to conduct surveys in all of the (now) 28 countries of the Union in order to obtain a trade mark registration. Given the financial implications of such a solution, it would seem that the only practical way of protecting shape marks in the EU in the future will be to turn to registered design protection, a regime that offers cost-effective rights without the need for an unknown, though large, number of expensive surveys.

Winnetou is the fictional, Native American hero of several novels written in German by Karl May. The writer, who died in 1912, is one of the best selling German authors of all time having sold over 200 million books worldwide, amongst them the four Winnetou novels. The Winnetou books were portrayed on the silver screen during the 1960s in a series of films that feature the French actor Pierre Brice as Winnetou and the American (former Tarzan) actor Lex Barker as the hero's blood brother Old Shatterhand. The Winnetou stories have also been told in theatrical productions and TV programmes. In 2003, no doubt in order to protect future entertainment and related merchandising activities, the successors of Karl May obtained an EUTM registration (in the name of Karl May Verlag) for Winnetou covering a wide range of goods and services including films in Class 9, printed matter in Class 16 and film production in Class 41.

In 2011, it was reported that the German

film production company Constantin Film had plans to revive the Winnetou series of westerns with a new adaptation written by Michael Blake (who also penned the script for the film *Dances With Wolves*). The planning for this venture was no doubt assisted by the fact that the original Winnetou novels were by 2011 well outside their periods of copyright protection. In order to clear the path for the project still further, Constantin Film also applied to cancel Karl May Verlag's EUTM registration on the ground that the mark was descriptive of goods or services relating to the pictorial character Winnetou (Articles 7(1)(b) and 7(1)(c) and Articles 52 (1) and 52 (2) of the Regulation).

The Cancellation Division of the EUIPO rejected the cancellation action. Constantin Film appealed and the Board of Appeal reversed the decision (in part). The Board found two earlier decisions of the German Court on the nature of the Winnetou mark to be particularly persuasive. Those (German) Courts had found the mark Winnetou to be descriptive in relation to printed matter, the publishing of books and magazines and film production. Bearing that in mind, and also taking account of other arguments and evidence filed by Constantin, the Board cancelled Karl May Verlag's EUTM as non-distinctive and descriptive, in respect of a wide range of goods and services that it deemed connected with books, radio and television, including potential merchandise related to such goods and services. In fact, all that remained of Karl May's original broad specification was "printer's type" and "printing blocks" in Class 16.

A no doubt rather startled Karl May Verlag appealed to the European General Court (*Karl May Verlag v Constantin Film Production*; T-501/13). The (General) Court annulled the decision of the Appeal Board. In the Court's view,

- The Appeal Board had treated the decisions of the German Courts as binding which was contrary to EUTM case law.
- The Appeal Board had inadequately reasoned as regards the perception of the sign Winnetou beyond its meaning as evocation of a fictional character.
- The Appeal Board had also failed to give adequate reasons as to why the word Winnetou would be seen by EU consumers as signifying Native American or Native American "style" products. Further, they had not explained why so many of Karl May's goods would be viewed by consumers as "merchandise".

- The goods characterised as "merchandise" were not related closely enough to form a homogenous class. It was therefore incorrect to give an overall general statement of reasons for cancelling them.

This case will no doubt be appealed to the Court of Justice (CJEU)). It certainly needs to be since the practice of the EUIPO in the area of the protection of fictional characters (as EUTM) is a mess. Consider, for example, the Office's published examination practice (Part B; Examination; Section 4; Absolute Grounds of Refusal) which state that titles such as *Cinderella* and *Peter Pan* are incapable of performing a distinctive role in relation to, for example, books or films because consumers would simply think that these goods/services refer to the story of *Cinderella* or *Peter Pan*, this being the only meaning of the terms concerned. Contrast that with the decisions made in the Winnetou case. The Cancellation Division dismissed the action in relation to all of the goods and services claimed including books and films. The Appeal Board cancelled the EUTM registration in respect of virtually all of the claimed goods and services. Throw into this particular mix, the Board of Appeal decision in *Yves Fostier v Disney Enterprises* (R1856/2013-2) in a cancellation action against an EUTM registration for Pinocchio and the Cancellation Division decision (now appealed; *Robert W Cabell v Zorro Productions*; Cancellation Action No. 7924C) in which an EUTM registration for the trade mark Zorro was declared invalid for "printed matter" in Class 16 and "entertainment; cultural services; providing of training; sporting activities" in Class 41 and the lack of consistency can be understood. It remains to be seen if the CJEU will identify some wood amongst these particular trees.

In the writer's view, the test should be this. Is the name of the fictional character associated with one person or one organisation or has it become part of the public domain? If the former, then the name should be registrable as a trade mark for all goods and services including products such as books and films. If the latter, then the practice set out in the Examination Guidelines should apply, although with the caveat that, if goods and services about the fictional character are excluded, then even the disallowed products should be accepted. It seems reasonable to the writer that the mark Pinocchio should be registrable for printed matter provided the goods do not relate to the Pinocchio fictional character.

UK COURT DIARY

GLAXO GETS PUFFED OUT.....

If you are an asthma sufferer, you may be familiar with Glaxo's Seretide® Accuhaler® product.

Seretide®, which is a combination of an inhaled corticosteroid (fluticasone propionate) and a long-acting bronchodilator (salmeterol xinafoate), is used in the treatment of chronic obstructive pulmonary disease (COPD). Seretide® is available for use both in the form of the Accuhaler® and as a metered dose inhaler. Both products employ two shades of the colour purple, the darker shade (of purple) being the more prominent. In 2004, Glaxo filed an EU-wide (EUTM) trade mark application to protect the two shades of light and dark purple that it uses on its Seretide® inhalers. The mark was granted in 2008 (EU trade mark registration no. 3890126). The registered mark is set out below,

"The trade mark consists of the colour dark purple (Pantone code 2587C) applied to a significant proportion of an inhaler, and the colour light purple (Pantone code 2567C) applied to the remainder of the inhaler".

As can be seen, the mark comprises a visual representation of the two purple colours, as applied to the circular Accuhaler® inhaler, and is accompanied by a written description. The mark does not appear to have been accepted based on evidence of acquired distinctiveness through use. It was deemed inherently registrable by the EUIPO.

When Glaxo's competitor, Sandoz launched its own purple coloured inhaler named AirFluSal® Forspiro® which was also designed to deliver a fluticasone/salmeterol combination aimed at the treatment of COPD, Glaxo sued them for *inter alia* trade mark infringement based on their above mentioned purple colour combination registration. Sandoz's AirFluSal® Forspiro® inhaler product is shown below.

Sandoz counter-claimed that Glaxo's colour combination registration was invalid under Article 52 of EU Council Regulation No. 207/2009 in that the mark was neither a sign nor capable of being represented graphically (Article 4 of the Regulation).

As an aside, this dispute was part of wider litigation. However, for the purposes of this article, we will only concentrate on the High Court's decision assessing the validity of Glaxo's colour registration (*Glaxo Wellcome UK Limited (t/a Allen &*

Hanburys) & Glaxo Group Limited v Sandoz Limited (2016 EWHC 1537).

THE ARGUMENTS

Sandoz's main argument for invalidation of Glaxo's EUTM 3890126 was that, by virtue of the written description, Glaxo's mark was not a single sign but a collection of an almost limitless number of signs, echoing the judgment of Sir John Mummery (LJ) in the 2013 English Court of Appeal case, *Société des Produits Nestlé S.A. v Cadbury UK Limited [2013] EWCA Civ 1174* ("Cadbury Colour Purple") (*Maucher Jenkins successfully represented Nestlé in that case*).

In the *Cadbury Colour Purple* case, the Court of Appeal refused Cadbury's UK trade mark application to register a swatch of purple (Pantone 2685C) with the following written description,

"The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods".

because it contained an unknown number of signs due to the reference to "predominant" (in the written description) and therefore lacked the required clarity, precision, self-containment, durability and objectivity to qualify for registration.

In the present case, Glaxo argued, in their defence against the invalidation action, that the correct starting point for assessing the scope of their colour combination mark was the visual representation rather than the written description and that the single sign being claimed was an "abstraction" of the visual representation. In the alternative, to the extent the colour combination mark might encompass more than one sign, the variants within the registration formed a narrow group that were permitted.



THE DECISION

Judge Hacon was not persuaded by Glaxo's arguments and held their EUTM registration (no. 3890126) to be invalid because it lacked clarity, precision and uniformity. Whilst a single sign could potentially include variant forms these must be "very minor", "insignificant" and "go unnoticed" by the average consumer.

In this case, the visual representation and written description were incongruent and presented the average consumer with a "puzzle" as to the form of the mark; the description was not qualified and narrowed to a single sign as depicted in the visual representation. Whilst the visual representation by itself could be a single sign (albeit, the Judge thought, more suited to protecting the 3D shape of the inhaler rather than its colour), the written description could not.

Judge Hacon also held that both the visual representation and the written description should be considered and one element shouldn't be given more weight than the other; it depends on the circumstances of each case. Further, it was for the Court to decide this question, without reference to the average consumer.

Perhaps not surprisingly, Glaxo are currently seeking permission from the Court of Appeal to appeal this decision. We expect the permission application to be decided by the end of the year.

Comment

In our view, Judge Hacon has reached the right decision in this case; the written description Glaxo have used is, in our opinion, imprecise and potentially covers an infinite number of signs, only one of which is illustrated visually.

This case also demonstrates the considerable difficulties associated with validly registering a colour or combination of colours in the EU, when that colour or combination of colours is not used in a uniform manner on the goods.

Further, it highlights the pitfalls of filing an application for a colour (or a colour combination) mark which includes a detailed, written description that could create uncertainty as to the scope of monopoly sought.

All is not lost for Glaxo however since it also owns UK trade mark registrations for the colour marks shown below that were filed between 2003 and 2007. These registrations all include arguably more precise written descriptions than the invalid EU trade mark registration, although it is somewhat surprising that they were allowed by the UKIPO without proof of acquired distinctiveness through use. This may yet leave the registrations vulnerable to cancellation:

• UK REGISTRATION NO. 2353195A



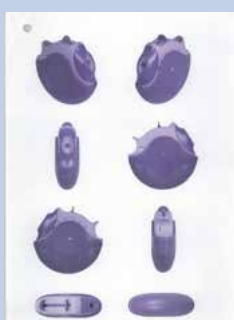
The trade mark consists of the colours dark purple (Pantone code 2587C) and light purple (Pantone code 2567C) applied to the surface of an inhaler, as illustrated in the representation attached to the form of application.

• UK REGISTRATION NO. 2353195C



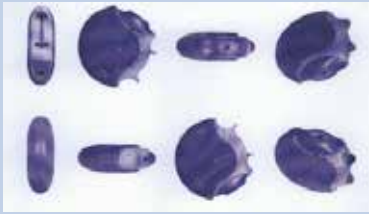
The trade mark consists of the colours dark purple (Pantone code 2587C) and light purple (Pantone code 2567C) applied to the goods, as illustrated in the representation attached to the form of application.

• UK REGISTRATION NO. 2353195D



The trade mark consists of the colours dark purple (Pantone code 2587C) and light purple (Pantone code 2567C) applied to the outer casing of the goods, dark purple being the predominant colour and light purple being applied to the remainder of the goods, the arrangement and proportions of the colours shown in the representation attached to the form of application.

• **UK REGISTRATION NO. 2353195E**



The trade mark consists of the colour dark purple (Pantone code 2587C) applied to a significant proportion of the goods, and the colour light purple (Pantone code 2567C) applied to the remainder of the goods, the colours being applied respectively to opposite ends of the goods, as illustrated in the representation attached to the form of application.

During their litigation with Sandoz, Glaxo also applied to register a “Libertel” style colour mark as a UK trade mark (application no. 3108001) and an EUTM (application no. 14596951) comprising a swatch of purple colour plus a written description that just identifies Pantone 2587C.

Both applications were accepted *prima facie* (which again, is a surprise) but are under opposition; the UK application having been opposed by Sandoz and the EUTM application by Sandoz’s parent company Novartis (along with a German company, Minerva).

It will be interesting to see whether the English Court is given an opportunity, in Sandoz’s opposition to Glaxo’s UK application no. 3108001 for the single colour mark (Pantone 2587C) to address Lloyd (LJ’s) *obiter* comments at paragraphs [58]–[62] in the Court of Appeal’s *Cadbury Colour Purple* decision where he cast doubt on the validity of a *Libertel* style mark that consists of just a swatch of colour plus a Pantone code.

Lloyd LJ commented as follows:

58. *It seems to me that some of the reasoning of the Hearing Officer and of the judge proceeds on a false basis as to the effect of the CJEU’s decision in Libertel. The judge described that case as deciding that “pure colour marks are in principle capable of being registered”: see the judgment at paragraph 47. In one sense that is correct, but I believe it can be, and has been, taken as going further than it should (Emphasis added). The application for*

registration under consideration in that case showed coloured orange the space which was designated for the representation of the sign, and the section in which the colour of the mark was recorded was completed with the word “orange”: see the Advocate General’s Opinion, paragraph 22, and the court’s judgment, paragraph 15. That manner of proceeding was held to be inadequate because the specification of the precise colour depended entirely on the colouring of the registration application. This might change over time through fading and, even if it did not, it would not be identifiable with any kind of precision except by reference to the original application form. A process of reproduction might alter the exact colour. For that reason, the use of a reference point such as a Pantone shade was held to be necessary, the colouring on the original registration application being insufficiently accessible or durable, and the word orange being far from sufficiently precise.

59. *The Court held at paragraph 68 that: “The reply to the first question referred must therefore be that a colour per se, not spatially delimited, may, in respect of certain goods and services, have a distinctive character within the meaning of Article 3(1)(b) and Article 3(3) of the Directive, provided that, inter alia, it may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The latter condition*

cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognised identification code.”

60. *This evidently allows for the possibility that a sign consisting of a colour as such may have an acquired distinctive character, but the decision is that, in order to qualify for registration, even if it has become distinctive, it must satisfy the tests of being clear, precise, self-contained, easily accessible, intelligible, durable and objective, and that to reproduce the colour on paper is not enough, whereas reference to a suitable code may be.*
61. ***That seems to me to be a decision that registration of a colour mark is not possible unless these tests are satisfied. It is not a decision that, if those tests are satisfied, then registration is possible. What more is needed for a sign which satisfies all of those tests to be registrable was not the subject of argument before the court. (Emphasis added).***
62. *As this case shows, there are considerable potential problems in seeking to show that a pure colour mark is properly registrable. The tests referred to in paragraph 68 of the Libertel judgment are aimed, among other things, at ensuring that both registration authorities and actual or potential competitors know the scope of the mark which is applied for or has been registered. Such persons must be able to tell not only whether a given mark is within the scope of the registration applied for or effected, but also whether it is not within that scope.*

Glaxo therefore still face challenges trying to protect and enforce its inhaler colours and we look forward to seeing how this plays out both in the UK and, more widely, in the EU.

OUT & ABOUT

WHO	WHERE	WHEN
Katie Cameron Kana Enomoto	PTMG Autumn Conference Oslo	5-7th October 2016
Cara Baldwin Joanne Ling Richard Parsons	ITMA Autumn Seminar Birmingham	6th October 2016
Reuben Jacob Richard Parsons Edward Rainsford	Medica 2016 Dusseldorf	14-17th November 2016
Katie Cameron Tim Pendered	INTA Leadership Meeting Hollywood, Florida	15-18th November 2016

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PEOPLE NEWS

We are very pleased to announce that Richard Parsons qualified as a Solicitor in July 2016. Richard also has a First Class Masters degree in Physics and a Law Degree.

We are also very pleased to announce that Anne Hancock and Haydn Lambert have joined our Trade Mark Paralegal Team. Both have successfully completed the ITMA Trade Mark Administrators' Course, and have substantial experience in Trade Mark formalities.

If we can offer you advice on the topics discussed in this Newsletter or any other intellectual property matter, please contact us at:

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