



Design **features**

INTRODUCTION

It has been some time since the last edition of Design Features. Europe has had a quiet period in designs, before the first cases reached the Boards of Appeal at OHIM and the higher courts of Europe. Now, however, the OHIM Third Board of Appeal has issued a number of significant decisions. A large part of this issue is therefore devoted to considering the effects of these. Some are appeals from decisions of the

Continued overleaf

INTERNATIONAL DESIGN LAW

DESIGNS OF PARTS, and Parts of Designs

The former British design law permitted registration of the design of part of an article, but only where the part was “made and sold separately”. Although the law has changed as regards applications filed since 2001, it remains in force for those designs applied for before that date.

Many other countries have the same provision. A recent case illustrates how the provision operates in practice.

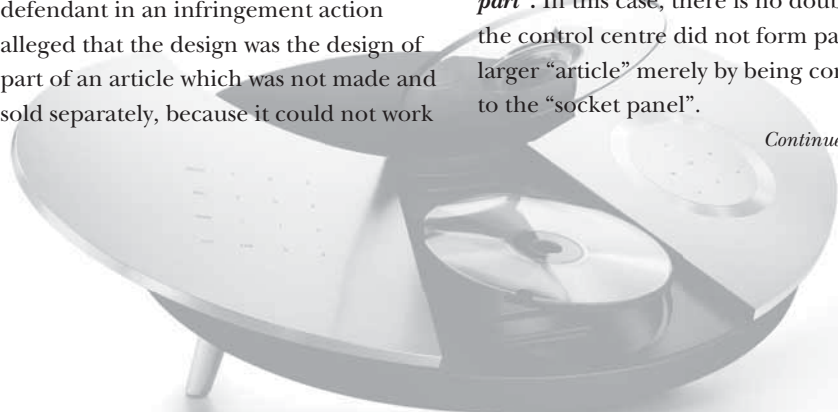
The Hong Kong case *Bang & Olufsen A/S v. To Hok Chung (t/a Mirage Electronics Industrial Co.)*, CACV 207/2006, concerned the Beocenter 2 audio control centre. This plays a DVD or CD, but requires a separate socket panel, to which it is connected by a wire, which supplies the power and speaker connections. The defendant in an infringement action alleged that the design was the design of part of an article which was not made and sold separately, because it could not work

without the socket panel and cable. The Court of Appeal held that the appropriate test was that laid down by *Ford Motor Company Limited’s Design Applications* [1995] RPC 167. The test there was not how products were being made and sold on the market at the date of infringement, but the situation at registration, before the articles to the design were made at all. The House of Lords gave up the attempt to literally interpret the “*made and sold separately*” language and, instead, indicated that “*the answer will ... be supplied in many cases*” by applying the criterion given by the Court of Appeal below, namely, “*that to qualify ... a spare part has to have an independent life as an article of commerce and not be merely an adjunct of some larger article of which it forms part*”. In this case, there is no doubt that the control centre did not form part of a larger “article” merely by being connected to the “socket panel”.

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Introduction continued

Designs Department concerning the filing stage, and some (a growing number) are on points of validity from the Invalidation Division of OHIM. One of these is now on its way to the Court of First Instance, and we await their judgment with interest.

In the meantime, there have been major procedural changes at the UK Designs Registry. We give a brief explanation of these in this issue; on economic grounds, most applicants now use the Community system, but these changes improve the attractiveness of the UK system a little. Finally, we review a number of UK court decisions under the new law. It remains to be seen whether the European Court of Justice will overrule these.

The Hong Kong Court of Appeal added that the question was to be determined by reference to the contents of the application for registration (e.g. the product indicated). There was no indication in the application that the design was the design of a part of an article; it was the design of an article, namely the control unit. It differed in that respect from *Samsonite Corp. v. Makerich Ltd* [2002] 1 HKC 692, which was a design registered in respect of a “wheel assembly for an upright luggage case”, and was hence held to be part of an article, namely the luggage. Infringement was therefore found.

We note (with thanks to Pakpat World Intellectual Property Protection Services) that, following the Pakistan Registered Designs Ordinance 2000, it is possible to register the design of part of an article in Pakistan provided that the article can be made and sold separately.

These provisions all concern designs of separate parts of articles, rather than designs of integral portions of an article (or, viewed differently, portions of the design of an article). In such cases, the former UK practice allowed the applicant to highlight the portion concerned by the use of dashed lines or a red ring, and then indicate that it was the novel portion in the “Statement of Novelty”. However, protection was still obtained only for the article as a whole, and whilst the result of the Statement of Novelty was to increase the importance of the highlighted features, it did not entirely eliminate others. In that respect, the new European system (which clearly states that protection is available both for the design of a separate component part and for the design of part of a product, in other words an integral part) represents a significant advance in protection for applicants.

COMMUNITY DESIGN

COMMUNITY DESIGNS

to be Linked to International System

The EU Commission have announced that Community Designs will be linked to the Hague Agreement System for the International Registration of Industrial Designs, by 1 January 2008. With the adoption of the Geneva Act the Hague System, works somewhat like the Madrid Protocol registration system for trademarks.

The Geneva Act permits member states to perform some national phase examination. It also allows the accession of regional offices such as OHIM. At present, there are only 47 member states of the Hague Agreement, of whom only around half have joined the Geneva Act.

Many of the existing members are already part of the EU. Many major design filing nations, including the US, Japan, China, South Korea, Australia, Canada and New Zealand are not members.

The accession of the EU (through OHIM) will have two consequences:

1. It will be possible for nationals of, or residents in, a member state of the Hague System to file an international application, designating the EU as a whole as a Community Design. The designation fees will be relatively low.
2. It will be possible for EU nationals or residents to file an international design application, thereby designating non-EU members of the Hague agreement.

In view of the limited membership of the Geneva Act of the Hague agreement at present, and of the fact that most of the largest members are already EU states, the system will have only limited attractions at present. However, as new states join, its

attractions will increase. Potential applicants will need to exercise great care, because the Hague System does not harmonise substantive design law: a design which meets the restrictive Hague Agreement requirements may nonetheless be invalid, or of narrow scope, in designated states. Many users will therefore prefer to continue to work through local counsel in each important country instead of using the Hague system.

Non-EU Hague (Geneva Act) countries which might be of interest to applicants are as follows:

BIGGEST ECONOMIES

COUNTRIES WITHIN TOP 100 GDP (EU, FOR COMPARISON, WOULD RANK TOP)

STATE	RANK (GDP)	RANK (GDP PER HEAD)
TURKEY	18	69
SWITZERLAND	20	7
SINGAPORE	44	25
EGYPT	51	117
UKRAINE	52	106
CROATIA	64	49
ICELAND	93	5

WEALTHIEST
COUNTRIES WITHIN TOP 100 GDP PER CAPITA (EU, FOR COMPARISON, WOULD RANK 26TH)

STATE	RANK (GDP)	RANK (GDP PER HEAD)
ICELAND	93	5
SWITZERLAND	20	7
SINGAPORE	44	25
CROATIA	64	49
BOTSWANA	106	58
TURKEY	18	69
NAMIBIA	125	90
THE FORMER YUGOSLAV REPUBLIC OF MACEDONIA	126	91
ALBANIA	111	95

MODERNISATION OF THE UK DESIGN SYSTEM

As from 1 October 2006, the UK Design System has been extensively changed, to correspond to the OHIM Community Design System. The three major changes are:

- a) no search or prior art examination now takes place;
- b) deferment of publication is now possible for all designs (not just certain classes of designs as in the past);
- c) "multiple design" applications are now possible, in which several

designs are filed in the same application, taking advantage of reduced fees.

The "headline" fee rates are unchanged, but the possibility of multiple design applications reduces the overall cost of the filing for larger applicants. The termination of search and prior art examination will, in practice, make little difference since the UK Designs Registry has not performed systematic searches for a number of years.

FROCK HORROR

at Top Shop, and New Look buckles under

The strength of European Community Design laws is becoming apparent in the UK, with a recent slew of cases brought (or threatened) by well known fashion houses and designers against High Street, mass market copycat designs.

Recently, the British High Street clothing retailer Top Shop destroyed its entire stock of a yellow mini dungaree dress, and paid a reported £12,000 to the Fashion House Chloe after allegations that its dress infringed Chloe's IP rights. The shoe designer and manufacturer, Jimmy Choo has used European Community Design right to even greater effect. In the last year, it has been able both to force the retailer Marks & Spencer to withdraw and destroy thousands of handbags which it

alleged infringed its Cosmo silk satin evening bag, and also required clothing retailer New Look not only to withdraw more than 1,000 pairs of its Bonbon shoes, but also to pay £80,000 to Jimmy Choo in damages.

Retailers Primark, Oasis and Kookai are three more British retail names who have fallen foul of the same European Community Design laws and have withdrawn stock or paid compensation to designers and fashion houses

The Community Design Laws are particularly useful for protecting the look of fashion items, whether they are bags, shoes, belts or clothing. Not only is it possible to protect the look of an entire item, but it is also possible to protect a particularly distinctive part, or defining item. For example, this could cover an distinctive belt buckle or heel. The test for infringement will be whether the infringing article has the same overall impression on the informed user (usually taken to be the general public, and not someone specialised in the field).

Fashion houses frequently have difficulties with the speed at which the mass market can copy a design – usually within hours of a collection appearing on the catwalk or in the stores. Here, again, the Community Registered Design system can help, with the possibility of deferring publication of

a design. This means that a fashion house could file an application for a registered design to cover salient points of its new products, and, at application, request that the publication be deferred. This means that the application will proceed to registration without a representation of the design being made public. Then, on launching the new collection, the fashion house can terminate deferment, and will have full registered design rights in place at the same time.

But what happens if no registered rights are in existence? Community unregistered designs have the same scope of protection as registered designs (ie, the test is again whether the overall impression of the items is the same). However, if a design is not registered, then the owner of the earlier design must also prove that the item has been copied. Unregistered design rights were recently used to take action on behalf of the designer Fenn Wright Mason, where a print design of a skirt was copied by a supermarket, and for Jeffery-West, whose moccasin shoe design was copied by a number of high street retail stores. One word of warning should, however, be taken into account. If the first disclosure of a design is made *outside* the EU, then there are doubts as to whether unregistered Community design right protection is available.

look

Thanks to our talented multilingual staff Henry Selby-Lowndes (German), Katie Cameron (French) and Angela Fox (Spanish) for their assistance with the non-English decisions

PROCEDURAL ISSUES

GARDEN furniture

Case:	R 1027/2004-3
Date:	13/06/2005
Parties:	Baldwin Lawn Furniture
Design No.:	RCD 174099-0001

A multiple CD was filed by an unrepresented US applicant company and the Designs Department accordingly set a 2 month term to appoint a European representative. The applicant did not do so and the application was refused. The applicant appealed, arguing that they had an EU establishment, and still did not appoint a representative. They appeared surprisingly ignorant of European procedure, but were advised by OHIM to appoint a representative, pay the appeal fee and file grounds of appeal. They did not do so and the appeal was held inadmissible.

Comment

This decision highlights two procedural points; firstly, that those appealing against a decision instructing them to appoint a representative will need for legal reasons to appoint a representative to handle the appeal, and secondly, that appointing knowledgeable local representation is a practical necessity.

Refills

Case:	R 409/2006-3
Date:	10/07/2006
Parties:	Ashraf Abbas
Design No.:	RCD 325303 (refused)

A multiple Community Design application was filed by an individual (apparently resident in London) and the fees paid by another individual from Saudi Arabia - the partner of the appellant, as it later transpired – unaccompanied by reasons for payment. OHIM posted a letter asking the reasons, but it was apparently unanswered within the time limit, and OHIM eventually refunded the fees paid. Meanwhile, the Designs Department faxed a letter asking for payment of fees plus surcharge, which was also unanswered. The application was refused, and an appeal filed. The appellant alleged that they never received either letter from OHIM. The Appeal Board held that OHIM were entitled to communicate notifications by fax (citing T-380/02 and T-128/03). The OHIM fax log indicated that the fax had arrived “OK”. The letter had not been returned undelivered. No evidence was presented as to why they might not have arrived. The appeal was therefore dismissed.

Comment

This decision illustrates the danger and expense involved in filing an application directly from outside Europe, without local professional representation or advice, and relying on international mail.

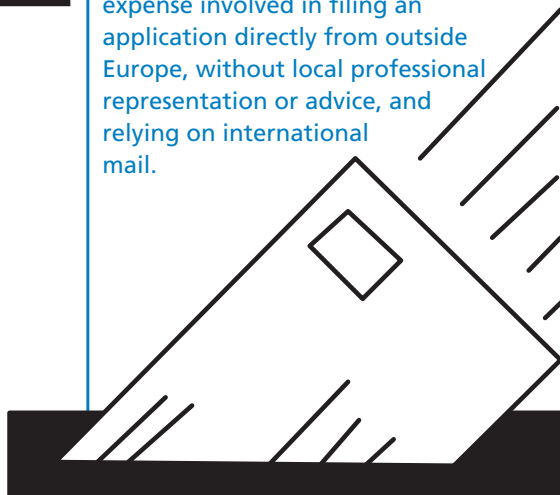
PLASTER

Case:	R 595/2006-3
Date:	18/12/06
Parties:	INFRAIN AG
Design No.:	RCD 000257449-0001 & 0002 (refused)

Two multiple design applications were filed by an unrepresented Swiss applicant company. The Designs Department duly informed the applicant of the necessity to appoint a European representative in addition to paying the outstanding fees in full and set a 2-month term to remedy these deficiencies. This communication remained unanswered. In a communication sent almost a year after expiry of the deadline, the Examiner informed the applicant of the refusal of the applications on the grounds that neither a response had been received, nor a representative appointed. Thereafter, a representative filed an appeal on behalf of the applicant. The Appeal Board held that the appeal did not conform with Art 57. CDR since no written statement of grounds was submitted within four months after the date of notification of the decision appealed. Therefore, the appeal was deemed inadmissible.

Comment

This decision illustrates the importance of appointing a reliable professional representative at the beginning of proceedings.



OFFICE chairs

Case: R 263/2006-3
Date: 07/12/06
Parties: Hadi Teherani AG
Design No.: RCDs 13883-0001 to 0004 (refused)

A multiple CD application filed by an unrepresented applicant German applicant company included a request for deferment of publication under Art. 50 CDR. The usual official communication was sent to the applicant indicating registration and advising that a request for publication would have to be filed before 3 months of the 30-month deferment deadline. Neither a request, nor respective fees had been submitted upon expiry of this deadline. OHIM then informed the applicant of these deficiencies by fax, setting a further deadline for remedying them.

After expiry, the applicant then filed a request for *restitutio in integrum*, providing an affidavit declaring that a change in personnel caused the deadline for requesting publication not to be docketed and thus subsequently missed. The request for *restitutio* was rejected by OHIM. The applicant appealed, arguing that they never received the faxed communication informing them of the deficiencies and therefore could not meet the deadline. This appeal was supported by an affidavit from the responsible employees. The Appeal Board held that the appeal was unfounded because “all due care”, required for *restitutio in integrum*, was absent: the applicant should have organised their office in an orderly manner to observe and control deadlines and thus a restoration could only be effected in the case of an extraordinary event or mistake made by an employee. The Board cited recent Court of First

Instance case law to the effect that where OHIM records show a fax to have been sent, the recipient cannot show the contrary. The appeal was therefore dismissed.

Comment

This decision illustrates the importance of appointing a professional representative as a safety net.

BICYCLE locks

Case: R 351/2004-3
Date: 21/09/2004
Parties: Stenman Holland
Design No.: RCD 110382

An application was filed through the Danish Patent Office, claiming priority from an earlier Danish application filed six months, less one day, earlier. The Danish Patent Office forwarded it to OHIM by Registered Mail. However, when the applicant filed the certified copy of the priority document at OHIM, they informed the applicant that they had received no design application. OHIM would therefore only give a date of filing outside the priority year. The application was examined and allowed, on the basis of the later filing date and with no priority claim, and the applicant appealed the allowance decision insofar as it concerned the filing and priority dates. In the appeal, the applicant got evidence from the Danish Office that the envelope they sent to OHIM had included other filings, and that these had arrived at OHIM. Accordingly, the Appeal Board held that there was proof that the application had arrived at OHIM, and the earlier filing date was allowed.

Comment

This decision illustrates the need to track dates of receipt at OHIM where applications are filed through a national office.

CLEANING sheet

Case: R 893/2006-3
Date: 03/05/2007
Parties: Jun Wu Chao
Design No.: RCD44931 (refused)

An applicant resident in the US, acting through US attorneys, instructed German attorneys in a town some distance from the German Patent Office in Munich. They sent the application on the same day, by air mail, to OHIM in Alicante. The letter was returned to them three weeks later. In the meantime, it appeared, from the postmarks, to have been in Alicante on 22nd November 2005, a date which fell within the six month priority term from the initial US application. The reasons for non-delivery were unclear. Accordingly, OHIM allocated a filing date only when the design was resubmitted, so that the priority right was lost. The applicant appealed. The Board of Appeal dismissed the Appeal; firstly, there was no evidence of what the envelope had contained, and secondly, there was no evidence that it had reached the Office. The failure was attributable solely to the applicant. There were several ways to file a Community Design, each with its strengths and weaknesses, and those who rely on the postal service must suffer the consequences if it goes wrong.

Comment

The Decision illustrates the importance of careful filing. Applicants would be well advised to use an agent who has an office either in Alicante (where OHIM is located) or in the same city as a national patent office (where the applicant can be hand filed) so as to eliminate the inherent unreliability of the postal service.

INVERTER generators

Case:	R 1351/2006/3
Date:	21/05/2007
Parties:	Honda v. Wuxi Kipor Power Co.
Design No.:	RCD 171178-0005

Two designs of a multiple design application were the subject of invalidation proceedings. The Invalidation Division sent letters on each to the proprietor/appellant inviting comments. The proprietor filed comments on one. The Division then wrote again, informing the proprietor that in the absence of comments they were deciding on the basis of the papers on file. The proprietor wrote to say they never received the previous letter and asked for it to be re-sent, but instead the Division revoked the design. Before the Board of Appeal, the Coordinator of the Division asserted that he had *“absolutely no doubt”* he sent the letter out, since he did not have it on file, and that he would have sent both in the same envelope, raising the possibility that the proprietor “probably” overlooked it. The Board held that the duty to prove notification by way of delivery was OHIM’s, and annulled the cancellation decision.

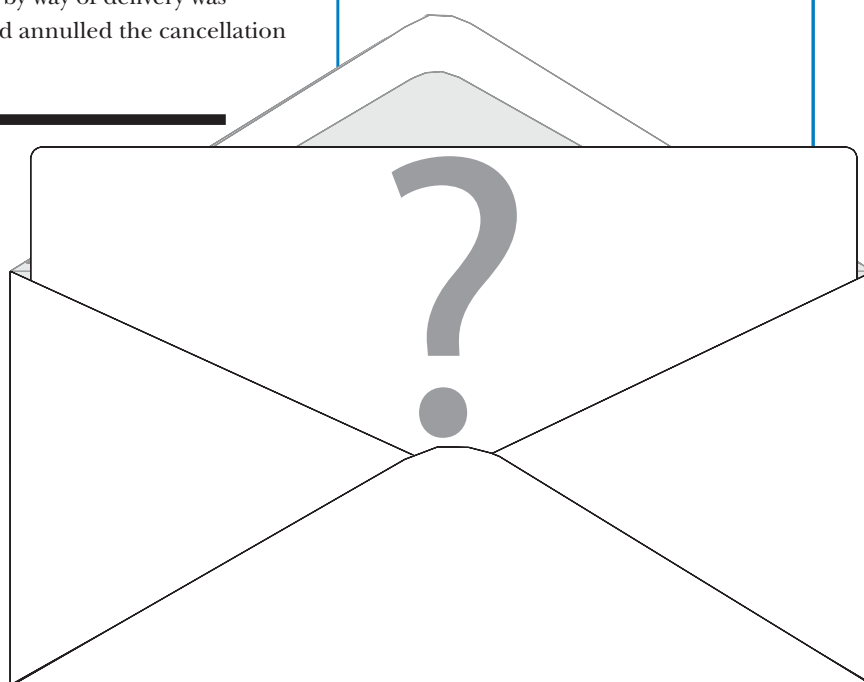
LIGHTING equipment

Case:	R 736/2005-3 & 737/2005-3
Date:	08/12/06
Parties:	Dahlmann-Yave Ltd. v. Dieter Ljubojevic
Design No.:	RCDs 000016183-0001 & 0002

These two decisions concern respective RCDs for lighting equipment which were the subjects of invalidity proceedings. The opponent alleged that the RCDs lacked both novelty and inventive character. The Invalidation Division held them invalid. A month after this decision the opponent submitted a withdrawal of their invalidity action to which the Office responded, informing them that such a withdrawal was not possible after issuance of the decision and that the decision may only be contested through submission of an appeal. The applicant immediately requested a review of the legal interpretation since e.g. under German national law it is possible to withdraw an invalidity action at any stage in time.

“between the instances”. They later filed an appeal on the grounds that the opponent had already withdrawn their invalidity action since both parties had reached a settlement in Cologne District Court.

The Appeal Board held the appeal to be grounded but deemed it unnecessary to look to national law in the existence of Community Law and cited the trademark decision OPTIMA (R 331/2006-G) in which the Enlarged Board of Appeal of OHIM held that an application could be validly withdrawn in the appeal period after a decision to refuse it. They thereby confirmed that the invalidity action was legitimately withdrawn. It would also seem possible to withdraw an action after an appeal Board decision but within the period for further appeal to the Court of First Instance.



COLOUR Charts

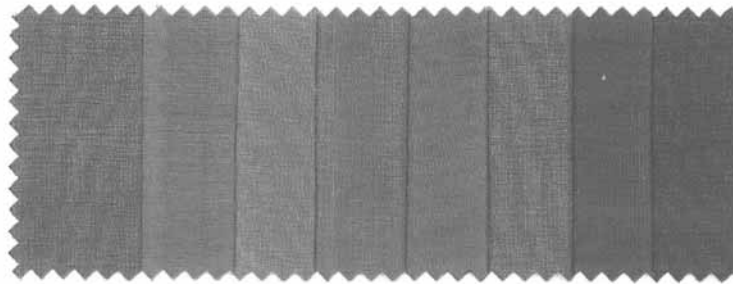
Case: R 576/2004-3

Date: 16/11/2004

Parties: Kerstin Schanze

Design No.: RCD 94693-0001

Ten pages of figures were filed, each with four “colour charts” comprising different-coloured bands (a total of 40 charts), apparently without numbering the views (and without indicating a second



language). The appellant argued that each was a different design (a total of 40 designs). OHIM held that each page was a different design (a total of 10 designs). The Appeal Board allowed the appeal and remitted the application.

Comment

This decision illustrates the crucial importance of proper preparation of the representations to meet European requirements before filing the application.

TAPE

Case: R 965/2004-3

Date: 31/03/2005

Parties: meterex Karl Kuntze

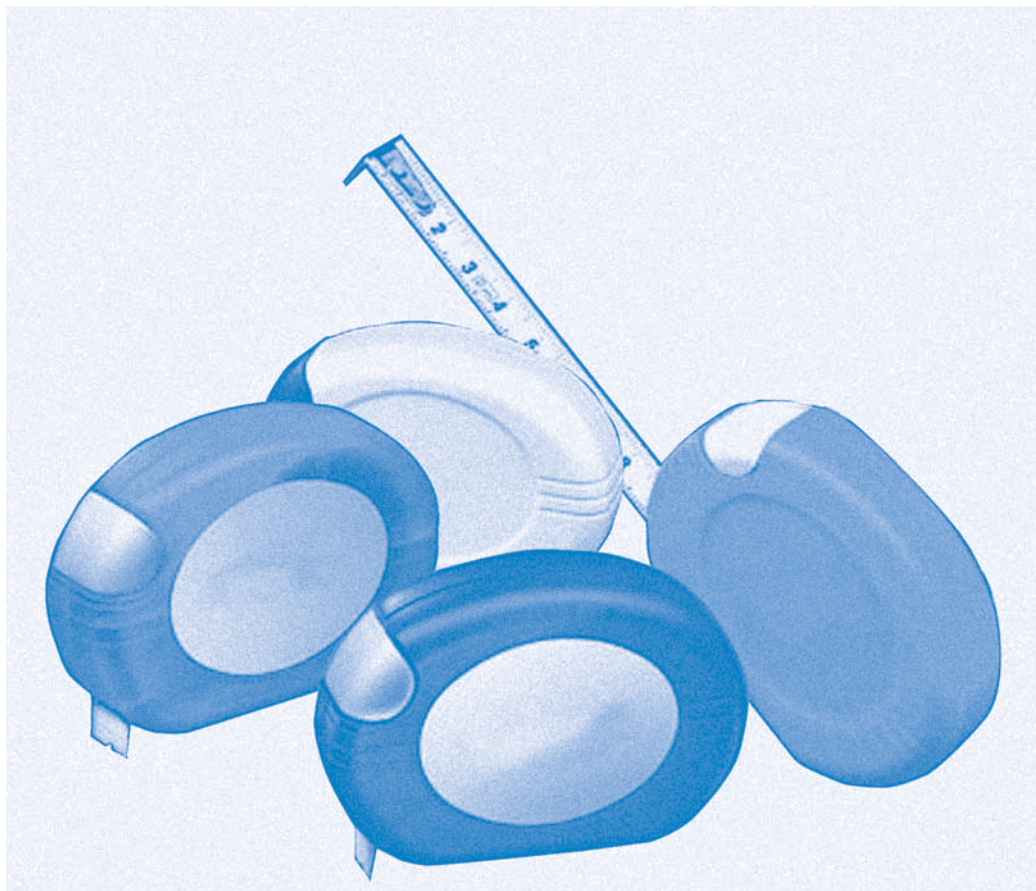
Design No.: RCD 165683-0001

The same design was filed in several colours as a single design through a firm of general lawyers, views 1-4 in one scheme and 5-7 in another. Initially OHIM requested a second fee, but the applicant said there was only one design. On appeal, the Appeal Board agreed that there were two designs, since the informed user would take colour to be an aspect of the design.

Comment

This decision forms the basis of OHIM’s current guidance on colour in designs. It illustrates that it is important to carefully consider the role of colour in a design: filing colour pictures of a design may well limit protection to

those particular colours. Careful planning of the representations of the design, to choose between colour photos, monochrome images or line drawings, is therefore important to secure the best protection.



CAKES

Case:	R 1009/2006-3
Date:	07/05/2007
Parties:	Sabine Decoodt
Design No.:	RCD 451695 (refused)

This case concerns the meaning of the word ‘ornamentation’, used in Art.s 3 and 37 CDR. A design may be the design of a product, or of its ornamentation (Art. 3 CDR). If a CRD covers “ornamentation”, then it is not necessary for all of the products in the application to be covered by the same Locarno class (Art 37 CDR). If this is the case, then an applicant can cover a large number of products in one application which normally would be required to be divided into separate applications. There is no statutory definition of “ornamentation”. The OHIM view is as follows:

According to Article 37(1) CDR and the explanations given in the Examination Guidelines, an “ornamentation” is an additional and decorative element capable of being applied to the surface of a variety of products without significantly affecting their contours. (OHIM Newsletter 5-2005).

This application (filed by the chocolatier at Au Bouquet Romain) covered four designs, classified variously in 01.01 (Bakery), 02-03 (headwear), 09-03 (boxes, cases) 09.99 (labels, packaging), which, according to the applicant, was intended to represent the design of a hat-shaped cake, covered with chocolate, and which was packaged in a hat box. The Office asked that the application be divided, and when no response was filed, the application was refused. Before the Board of Appeal, the applicant argued that the hat and the box were only elements of ornamentation, and that accordingly it would be possible for the application to cover different Locarno classes.

The Appeal was refused on two grounds. Firstly, the ‘ornamentation’ box on the application form had specifically not been ticked, and so it appeared that the applicant had not originally intended the hat and box elements of her design to be ornamentation. Secondly, and more fundamentally, the applicant’s understanding of the meaning of “ornamentation” was incorrect. In this case, the characteristics of shape, colour, etc, related to the product itself, not to any ornamentation of that product and thus the application was subject to the requirements of Art 37, i.e., that all products covered by the application should be covered by the same Locarno class. By way of subsidiary appeal, the applicant requested that the application be allowed to proceed in Class 01-01, (Bakery products) for a cake-hat and its hat box. This was accepted.

So, what is the difference between design of a “product” and that of “its ornamentation”? The decision does not create a new definition, but appears consistent with OHIM’s working definition quoted above. Although both

product and ornamentation may have ‘shape’ ‘colour’ ‘contour’, etc, ornamentation can surely only be something which (a) is incidental to, and does not affect the overall shape of a product, and (b) is applicable to other differently shaped products (hence the inapplicability of the “unity of class” requirement).

Comment

This case usefully clarifies one of the issues concerning multiple design applications. It also serves to point out the importance of preparing and filing accurate applications. Here, the applicant suffered a legal error (misunderstanding of what could be filed as a multiple design), a clerical error (missing the “ornamentation” checkbox) and a tactical error (not taking the chance to divide the application when offered by the examination division). Rather than saving a small amount of money, filing a multiple design with these errors cost the applicant the appeal fee.

Possibly the design concerned



COOKIES

Design:	R 1310/2005-3
Date:	28/11/2006
Parties:	Arluy v. Galletas United Biscuits
No.:	RCD 58334-0001

The design in suit depicted a round sandwich cookie with a filling. The top bore ornamentation in the form of a 16-ray star-shape pattern with arms of alternating length, with a small circle appearing at the end of the shorter arms and a larger circle at the end of the longer arms. The design also included concentric ridges and dots.

On 5 September 2005, the Cancellation Division rejected an application to invalidate the design by Galletas United Biscuits on the basis that the design lacked individual character. Galletas had argued unsuccessfully that the registered design created the same overall impression as its earlier Spanish trademark registration no. 2516524. That mark consisted of the three-dimensional shape of the well-known OREO cookie, comprising two black disc-shaped cookies sandwiching a white filling. The top cookie was depicted with fretted edging and small geometric shapes.

Galletas argued that the Cancellation Division had been wrong to find that the registered design and trademark did not create the same overall impression. Galletas relied in particular on a market survey showing that a majority of Spanish consumers associated black and white sandwich cookies with it, regardless of ornamentation.

Overall Impression

The Board of Appeal dismissed the appeal, upholding the first-instance finding that the RCD did not create the same overall impression as the earlier

trademark. The RCD was evidently not directed, or limited, to the black and white colour scheme, but was directed to the ornamentation on the face of the cookie.

The “informed user” in this case was an average consumer who habitually buys cookies, not a professional or an expert. He or she is familiar with sandwich cookies, their ingredients, and characteristics such as roundness and certain colour combinations, which often denoted flavour or ingredients, which were commonplace. Features of surface ornamentation were therefore more likely to be noted. These were clearly different. The market survey relied on by Galletas was unhelpful because it related only to black and white sandwich cookies, whereas the RCD was not limited to any particular colour combination.

The Board accepted that the public might perhaps rely on the round shape and black and white colour combination in identifying Galletas’ cookies, because its own ornamentation was so complex. However, that was not the case with the registered design, for which the ornamentation was regarded as much simpler. The appeal was dismissed and the decision upholding validity was confirmed.

Prior Trade Mark

The Board held that the black and white sandwich shape was not the subject of the trade mark protection given by the earlier right since that was the necessary shape of a sandwich type cookie: the trade mark was directed to that colour scheme in combination with the particular ornamentation shown. The design was not limited to the combination of

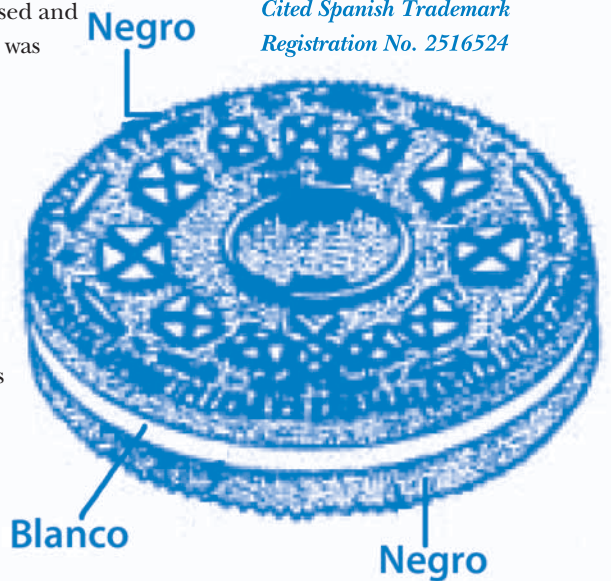
black and white, however, and had different ornamentation. The two were therefore not in conflict.

The attack therefore failed and the design was upheld.

Registered Community Design 58 334-0001



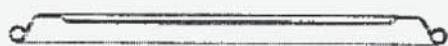
Cited Spanish Trademark Registration No. 2516524



TAZOS or Rappers

Case:	R1001/2005-3 R1002/2005-3 R1003/2005-3
Date:	27/10/2006
Parties:	Grupo Promer Mon-Graphic v. PepsiCo
Design No.:	RCD 58334-0001

These three decisions concerned invalidation actions against three designs, based on the same prior art – an earlier filed but unpublished Registered Community Design number 53196-0001 with a priority date a few weeks earlier than that of the designs in suit. The designs in suit and the prior art related to products well known (at least in Spain) for at least a decade as “tazos” or, in English, “rappers” or “pogs”. These are round metal discs (usually carrying a picture) with an indentation which can be “clicked”, intended to be collected by children. The indication of product was given as “promotional items”. There was evidence showing the marketing of tazos by various parties in the decade preceding the applications. At first instance (see OJ OHIM 2/2006 107), the Invalidity Division held that (1) the test for conflict with an earlier design was whether it created the “*same overall impression*” (the test for infringement of a prior design right, but also that for individual character over a prior publication), and (2) the degree of design freedom for a promotion item was wide since it merely had to be “*inexpensive, children safe and fit to be added to the promoted products*”. On that basis, the designs were similar in outline to the prior rights and created the same overall impression; they were therefore invalid.



Prior design

TEST FOR CONFLICT WITH AN EARLIER DESIGN

The Board of Appeal agreed that the test for conflict with a prior design was whether the “*same overall impression*” (taking into account design freedom) was created. This was apparently accepted by both parties. The Board did not further explain their reasoning but added that that an identical design would also create a conflict.

IDENTITY OF THE “INFORMED USER”

The test person is the “informed user”. The Board commented that this could be a number of different persons, including a child and a marketing manager in a company making biscuits or potato snacks (i.e. a trade buyer), but in any event they would be familiar with tazos.

EFFECT OF PRIOR ART AND DESIGN FREEDOM ON THE TEST

Although the comparison to be performed by the informed user was a comparison between the two designs, the products on the market were relevant insofar as they conditioned the impression formed by the informed user. In this case, the overall disc shape was shared by all the tazos in the marketplace. The informed user would “*disregard elements that are totally banal and common to all examples of the type of product in issue*” – i.e. features that are generic to that genus of product. The relevant degree of freedom was that of a person designing a tazo, not a promotional item in general. That involved considerably less freedom, and therefore “*even relatively small differences suffice to create a different overall impression*”. The designs were upheld as valid.

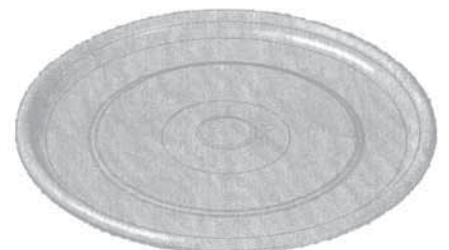
Comments.

The Board of Appeal upheld the case law of the first instance on the basic legal principles applied here (approach to conflicting earlier design rights, effect of design freedom, “crowded field” test). However, their practical approach was different. Whereas the first instance used the broad, generic

indication of product filed by the applicant to define the task facing the designer, and hence found that he had broad freedom and an invalid design, the Board of Appeal used the evidence filed by the parties to define a narrower product and hence a narrower task, as a result of which the design was held valid. On the facts of this case, where the class of product defined by the Board was, at the priority date, apparently well known and distinct within the general field of promotional items, their decision seems reasonable and will be welcomed by practitioners since it removes one of the dangers of naming an over-broad indication of product. However, we can imagine difficult borderline cases, and we note that this approach will place a greater burden on OHIM, and parties, to evaluate evidence of the range of products on the marketplace.

A particularly difficult situation might arise where all the prior art originates from a earlier single successful designer – can a designer’s own success make the user so accustomed to their product that it defines a new genus, allowing third parties to register minor variants? If this is the case, what is the effect on the infringement rights of the earlier designer – have they diluted the individual character of their own design? We should like to assume that the scope of an *earlier* design is fixed at its priority or registration date so that this cannot occur, even if its effect on a later design is evaluated at the priority date of the latter, but there is as yet no guidance on the question. This case will apparently be considered by the Court of First Instance, the first Community design case to reach them, and we may learn more when we read their judgment.

RCDs



COFFEE MAKER

Case:	R 216/2005-3
Date:	08/11/06
Parties:	ISOGONA, S.L. v. CENTREX, S.A.U
Design No.:	RCD 000005269-0001

The design in suit depicted line-drawing external views of a coffee maker having 14 sides or facets. It was invalidated on 22 October 2004 on the basis that it lacked novelty under CDR Art. 25(1)(b) and (e), together with Arts. 4 and 5. The Cancellation Division relied in particular on evidence that the design in question had been on the market in the EU since the 1950s. The Cancellation Division dismissed arguments that the interior of the subject coffee maker was different from similar coffee makers already on the market, as the interior was not depicted in the design drawings and was not,

therefore, protected. They considered it unnecessary to decide whether novelty had been destroyed by the publication of Centrex’s earlier figurative CTM no. 998450 (published 30 August 1999) covering *inter alia* “coffee pots,” depicting a very similar coffee maker but with the word mark OROLEY appearing on the waist.

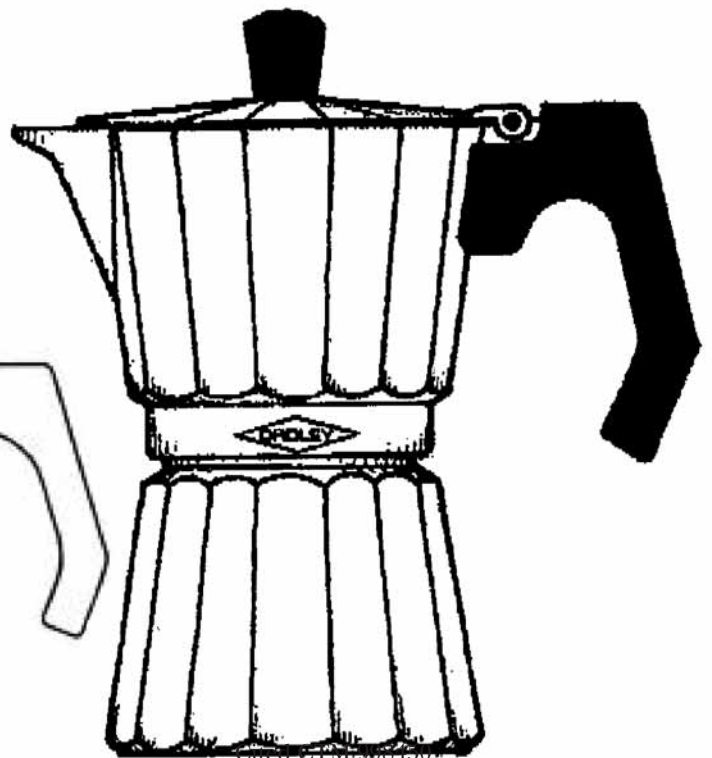
Isogona, the proprietor, appealed, arguing that Centrex had not relied on lack of novelty as a ground for invalidity, but rather on CTM no. 998450 as a prior right. As such, it claimed that the first instance decision to invalidate under CDR Art. 5 had been made *ultra vires*. If the matter were treated as a comparison between the design and the CTM, notable differences in the external appearance of the design and the CTM would emerge, not least the presence of the word OROLEY in the earlier CTM.

Isogona further argued that the interior of its coffee maker was different from the prior art because it was smooth rather than faceted.

The Board of Appeal rejected Isogona’s arguments. It held that Centrex had indeed pleaded lack of novelty by stating that “*the mere existence of the CTM shows that the design of the coffee maker protected under the RCD is not novel.*” Based on the photographs and clippings provided by Centrex at first instance, which depicted coffee makers of the same general shape and proportions, and including the same number of facets, the Board upheld the finding that the design lacked novelty. The Board also upheld the Cancellation Division’s finding that the internal parts of the design were not shown in the representations and therefore could not support the claim to novelty.



Registered Community Design 000005269-0001

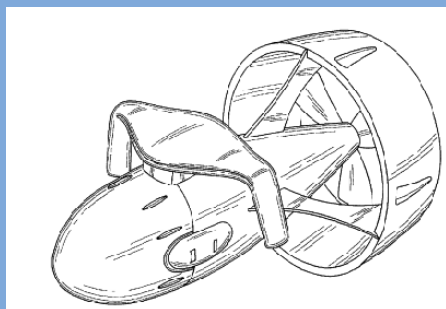


Underwater MOTIVE DEVICE

Case: R0196/2006-3
Date: 22/11/2006
Parties: Ampel 24 v. Daka Research

Design No.: RCD 225073-0001

This was an invalidation application concerning the design of a scooter for divers. The prior art consisted of an earlier European Patent (which, however, was published less than 12 months before the application date and was therefore ignored), a US design patent, and a product on the market. Many of the design features were alleged to be dictated by function. At first instance, the design was held to lack novelty over the prior art as differing only in “immaterial variations”. The proprietor/appellant argued on appeal that the prior art all related to an earlier product, and that the design was a novel “design update”, with changes “which allow the customer to recognize the original design but which have sufficient impact on the overall impression for the customer to realize that it is a new design.” There was little design freedom because of the technical function, so the differences in the shape of the handles were sufficient to give a new overall impression.



Prior art

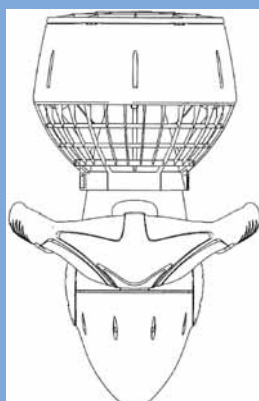
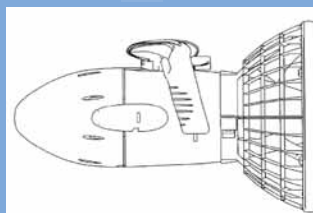
EFFECT OF FUNCTIONAL CONSTRAINTS ON DESIGN FREEDOM

The Board of Appeal confirmed that the effect of limited design freedom “especially on account of technical constraints” is that “even small differences ... may be sufficient to endow the design with technical character”.

However, here, there was significant design freedom to change the shape of the other parts of the device, or add ornamentation, without compromising their function. It was therefore not possible to ignore the rest of the device and concentrate only on the handle. Overall, the impressions were similar and the design was invalid.

Comment

The Board pointed out that the applicant could have sought protection for the handle alone, in which case they might well have produced a valid design. There is, however, an unfortunate ambiguity in their comment on this point. They refer to this possibility on the basis that the handle is a component part (i.e. one that can be assembled and disassembled). It appears to us that this possibility is also open where the design is the design of an integral part of a product, a conclusion which may now be open to doubt in view of this decision.



RCD

DRINKS Cans

Case: R 784/2005-3
Date: 14/03/2006
Parties: Ball Packaging Europe
Design No.: RCD 230990-0001

The application claimed two priorities, one a month after the other. OHIM rejected the second priority claim on the general principle that “priority can only be claimed from the first-filed application”. The Appeal Board allowed the appeal; Art 8 CDIR and Art 4F PC mention multiple priorities, as does the Decision of the President EX-03-9. The appeal fee was refunded.

Comment

This decision supports the formal concept of “multiple priorities”. However, as OHIM do not perform any substantive examination on filing, the Appeal Board did not explain how that concept might apply to designs in general, or the particular design involved in the appeal. Whereas a patent may have multiple claims, each involving a different priority, it is harder to see how this can apply to a single design where protection is for the “overall impression” rather than piecewise for its individual components. The practical significance of this decision may therefore emerge only when the design is involved in litigation.



RCD 230990-0001



First priority document



Second priority document

MIDAS

Case: R 609/2006-3

Date: 03/05/2007

Parties: Hee Jung Kim v.
Honeywell Analytics

Design No.: RCD 162425-0004

The design consisted of the words “*midas™ – Everything we touch is safer*” with significant decorative elements. The indication of product was “logos”. The attack on validity was based on a prior trade mark right under International Registration “MIDAS”, covering classes 7, 9 and 11 for a variety of household goods and white-goods, which was published before the filing date of the Community Design. The cancellation action was brought on the basis of Article 25(1)(e) CDR, which provides that a Community Design may be declared invalid “*if a distinctive sign is used in a subsequent design, and Community Law or the law of the member state governing that sign confers on the right holder of the sign the right to prohibit such use*”. A “sign” in this context includes a trademark. At first instance, the design was held invalid, on the basis that use of the Community Design in a logo would constitute use in the course of trade. The proprietor of the design appealed, on the basis that, firstly, merely applying to register a design did not constitute use in the course of trade, and

that, secondly, the trademark proprietor could only prevent “trademark use” whereas use of a design could not be assumed to be “trademark use”. They also commented that the design as a whole was dissimilar to the word mark.

COMPARISON OF THE DESIGN AND THE MARK

The Board of Appeal found that, in this case, “midas” was the dominant element of the design and that, therefore, the design would be visually perceived as including the sign “midas”. They also considered phonetic similarity and conceptual similarity, as if the design were a trade mark. Overall, they found on these bases that there was use of the trademark “MIDAS” within the meaning of Art. 25(1)(e) CDR.

TRADE MARK USE

As to the “trademark use” arguments, the Board held that, in a commercial context, when applied to products, their packaging and get up, the design “may be perceived as a sign”. Given that the design was a two-dimensional figurative logo, which could be applied to an infinite range of products and services, including those covered by the trademark, it was “conceivable” that the public might see the design as an indication of origin, jeopardising the trademark proprietor’s rights. Accordingly, they upheld the rejection.

Comments

This case illustrates the approach of the Boards of Appeal to the difficult

question of conflict between fundamentally different intellectual property rights. Unfortunately, the Community Design regulation sets forth the test for conflict in broad, general terms. Clearly, the test is whether the design would infringe the earlier trademark, but it is unclear how the design should be presumed to be used. For example, should the design be presumed to be used on the goods within the “indication of product”, or on any goods? It is unclear from this decision whether the Board were influenced by the indication of product submitted by the applicant or whether they proceeded on the basis that the design was inherently a logo applicable to many different products. Should the design be presumed to be used alone, or is evidence of its actual or proposed usage admissible? Is the actual usage of the prior mark relevant, or can it be challenged only by way of an invalidity action and, in that event, will the design proceedings be stayed?

At first instance, OHIM indicated that the applicant might have avoided invalidity by disclaiming the word “midas” – the Board made no comment on this point. If the earlier mark is viewed as a question of conflict between two rights, a disclaimer would seem sufficient, but if it is approached purely on an infringement test (as in this case) it is unclear whether a disclaimer would overcome the problem. ■

midas™
Everything we touch is safer

CASH REGISTER

(and point of sale Data Processing Equipment)

Case: R 1421/2006-3

Date: 25/07/2007

Parties: Casio Keisanki KK

Design No.: RCD 204763-0001

In this case (handled by our firm), the application was filed with an indication of product reading *Cash Register and Point of Sale Data Processing Equipment*. OHIM unilaterally altered the indication of product to *“Cash Registers: Data Processing Equipment”*. The effect was to broaden the indication of product: the original indication referred only to equipment which was a cash register and a point of sale data processing equipment, whereas the new indication referred to any equipment which was a cash register or any kind of data processing equipment. The reason for the modification arises from Art. 3(3) CDIR, which indicates that applicants should “preferably” use Locarno classification terminology. By way of background, OHIM maintains a large database of Locarno terms which it has translated into all EU languages (the “EuroLocarno” database). Where an applicant uses such terms, the application requires no subsequent translation and can therefore be granted very quickly, whereas translation adds a delay on the order of months to the process. It has therefore been OHIM policy for some time to substitute equivalent EuroLocarno terms for the indication of product as filed, and that policy has been instrumental in the very fast registration times achieved.

However, as in the present case, Examiners sometimes substitute a term with a different scope. According to the legislation, the indication of product has no effect on the “scope of protection” but it is unclear whether it can have any other effect for example on validity. In this case,

the applicant objected to the change, on the basis that if the Examiner wished to change the indication, the applicant should have had an opportunity to comment first.

FINDINGS

The appeal was filed after publication of the design, many months after the change had been made, so there was an initial question of whether the appeal was filed in time. The Board held that *“any change made by the Office to the contents of a design application should be open to appeal, at any time – before the registration proceedings are terminated.”* The appeal was thus in time.

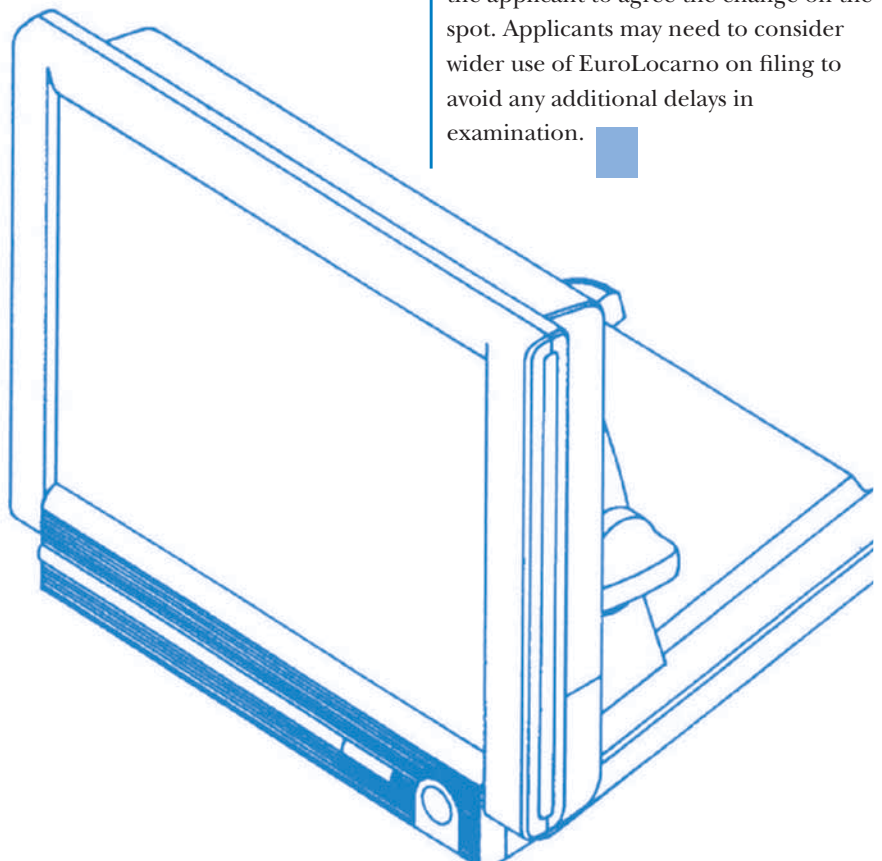
As to the merits, the Board did not rule on the actual effects of the indication of product. However, they commented that they could not rule out that it might have effects on the following:

- *The extent of exclusive rights (i.e. infringement rights);*
- *The determination of the field of prior art and of the identity of the “informed user”.*

The applicant had also raised the question of conflict with a prior trade mark; the Board did not specifically comment on that issue.

In the view of the Board, *“the indication of the product must be, as a rule, carefully worded.”* Practitioners will therefore wish to consider how broad it is wise to go, so as to get the best tradeoff between protection and validity. The Board confirmed that use of Locarno terminology, whilst “preferred” under the Regulations, could not be forced on the applicant.

The Board also commented that *“any modification proposed by the Designs Department must be submitted to the applicant for consideration.”* This might, if taken to extremes, result in slowing the current rapid processing times for applications by either making translation mandatory in many more cases, or causing the issuance of many Examination Reports. Hopefully the Office will therefore continue to make unobjectionable substitutions or, if they consider major surgery is necessary, ring the applicant to agree the change on the spot. Applicants may need to consider wider use of EuroLocarno on filing to avoid any additional delays in examination. ■





FLASHING LIGHTS

The Flashing Badge Company Limited v. Groves [2007] EWHC 1372 (Ch)

This was a summary judgment application in a copyright infringement case. Summary judgment applications are still relatively rare in UK intellectual property cases, but the changes to civil practice since 2000 have made them more attractive.

The action concerned the design of “flashing badges”. To quote from the judgment,

“The badges are novelty badges bearing messages of a familiar type: for example, “Happy Birthday” (a message in banner form above five lit candles sitting on a lavishly iced and decorated cake), “Princess” (the dot on the “i” of “Princess” being in the form of a star, the word itself being in flamboyant script and set within the design of a simple crown), “Little Monster” (in large, ostensibly freehand letters), “13 at last” (a large number above the “at last”), “16 TODAY” (in similar format), “21 TODAY” (a design set within the shape of a key), “40 Today” (a large 4, a smaller 0, on top of the “Today”, all set under three balloons), “Lets Party” (a flamboyant “Party” beneath a less flamboyant “Lets”), “Birthday Girl”, “World’s Best Dad”, “Best Nan In The World”, and so on in similar vein. Each badge is in a distinctive style, with colours selected by Mr Dingley. Each was designed to have six flashing, battery powered LEDs, which he positioned so as to give the most effective glow to the particular badge. Each LED has a particular colour. Mr Dingley designed the placement of the LEDs so that their colours did not clash with the colours of the badge designs.”

There was no doubt that the designs of the surfaces of the badges were “artistic works” protected by copyright in the UK. There was also no doubt that these had been copied, and imported from China. The defendant admitted copyright infringement in relation to the cardboard backing sheets on which the badges were mounted. However, in relation to the badges themselves, they made a defence under Section 51 of the Copyright, Designs & Patents Act 1988, which removes copyright protection from designs of most three dimensional objects. In this case, the badges were three-dimensional (although flat) and their outlines followed the shape of the copyright two-dimensional logos.

Analysing the earlier Court of Appeal case, *Lambretta Clothing Co. Limited v. Teddy Smith (UK) Limited* [2005] RPC 88, the judge held that the key question for the operation of Section 51 was whether the artistic work could only exist as part of the shape of that particular product. In this case, the artistic works could be applied to any other substrate, and were therefore not excluded from copyright protection under Section 51.

Comment:

This decision helpfully clarifies that copyright protection in the UK is widely available for two-dimensional designs, such as the logos in the present case (which are primarily stylised text with some simple graphics). It appears likely that Unregistered Community Design right would have also been available in this case, although it was not pleaded.

BAIT BAGS

Bailey v. Haynes [2006] EWPC 5

This case concerned infringement of UK and Community unregistered design rights in bait bags for catching freshwater fish. The bags were produced by knitting a soluble polymer mesh.

Since the design rights protects the design of part of a product, the judgment firstly confirmed that, when dealing with unregistered design rights (either UK or European), the plaintiff can select at the time of the litigation which part of the design of the product they wish to enforce. This is in contrast with registered designs, where it is necessary to carefully select at the time of filing the design which parts are to be protected.

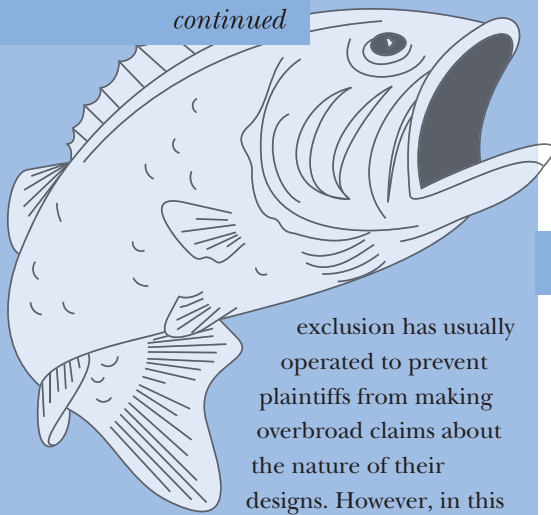
The judge found that the designs satisfied the necessary level of novelty and individual character. However, the defendants successfully proved that they had independently originated their design, so that there was no copying (and hence no infringement).

The interesting legal points, however, concerned the statutory exclusions, which are different for UK and Community unregistered design right. An Unregistered Community Design is excluded from protection where its features are “dictated solely by its technical function”. In this case, the design was made solely for the purpose of containing finer types of bait. However, the evidence showed that other mesh designs would also, to some extent, achieve the same effect. Accordingly, in line with previous UK case law, the judge held that the design was not excluded from protection as a Community Design.

There is no corresponding “functionality” exclusion for UK unregistered design right, but there is an exclusion for design features which are “a method or principle of construction”. In the past, this

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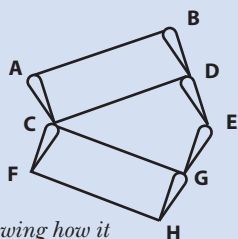


exclusion has usually operated to prevent plaintiffs from making overbroad claims about the nature of their designs. However, in this

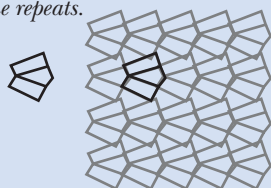
case, the evidence showed that the mesh design was essentially generated by the particular “Atlas warp stitch” knitting method used to make it. Thus, giving protection to the design would indeed, in this case, monopolise the method or principle of construction “by Atlas warp stitch knitting”. Thus, not without hesitation, the judge came to the conclusion that UK unregistered design right protection was excluded.

Comment:

This case usefully highlights the different treatments of functional designs under UK and Community unregistered design right regimes. Community design rights are excluded where the appearance is the inevitable result of the *technical function* of the design. That exclusion does not bite on UK unregistered design right. However, UK unregistered design right protection is excluded where the design is the inevitable result of the *process used to make it*.



The 1cm Design, showing how it is made of the repeats.



DOMESTIC AIRSPRAY Freshener Cans

Proctor & Gamble v. Reckitt Benckiser [2006] EWHC 3154 (Ch)

This case concerns domestic aerospray freshener cans for the Febreze™ product, registered as Community Design RCD 97969-0001.

The case turned on whether the defendant Reckitt Benckiser’s product was similar enough to be an infringement. Legally, this involves determining whether the two create the same “overall impression” to the “informed user”, bearing in mind the design freedom available.

The judge held that the “informed user” should be aware of designs on the market over the recent past, and product trends, but not to have an “archival mind” aware of absolutely everything in the field. Further, the “informed user” does not need more than a “basic appreciation of the technical aspects of the limitations impinging on the design”.

The judge held that “design freedom” could be limited by the nature of the product, by health and safety requirements, or by the rules of some organisation regulating the field, as examples of external constraints which would apply to all designers. However, it was wrong to consider internal commercial constraints such as the need to use existing tooling, because these constraints would not be objective in the

sense of applying to all designers in the field.

Although there were many differences between the two, the overall impression was the same. The judge noted that courts in Austria, Belgium, France and Italy had held the designs to be similar, and took this into account when deciding that there was infringement.

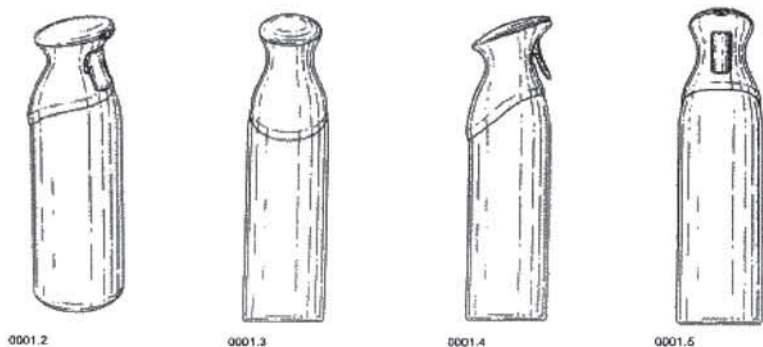
Comment:

As well as taking account of other European court decisions, the judge considered, and generally approved, the approach to assessing similarity of designs which was developed by the OHIM invalidation division. We can therefore expect the UK courts in future to be in harmony with OHIM decisions.

Reckitt-Benckiser Airwick new cap



RCD 97969-0001 Proctor & Gamble



PSPs

Sony Computer Entertainment v. Pacific Game Technology (Holding) Ltd [2006] EWHC 2509 (Pat)

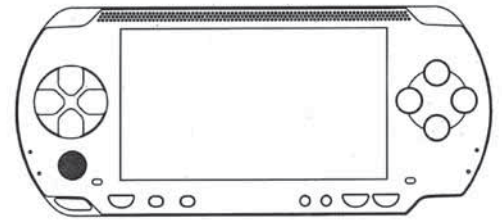
Sony brought an action against a Hong Kong defendant which sold products (including PSPs) into the UK via the internet. These PSPs were genuine Sony devices, but sold for the Japanese market only, as was clear from the packaging. Sony sued under their Registered Community Designs 244793-0001 - 0006. They also sued under various other design and trademark rights, and under copyright.

The defendants claimed that they committed no acts within the EU, since they existed only in Hong Kong. However, the judge noted that their website was in

English, quoted prices in sterling, included spurious EC Certificates of Conformity, and so on. He therefore concluded that *“the acts of which complaint is made have ... been perpetrated not in Hong Kong but here in the EEA. It would make no sense if intellectual property rights in the EEA could be avoided merely by setting up a website outside the EEA crafted to sell within it”*.

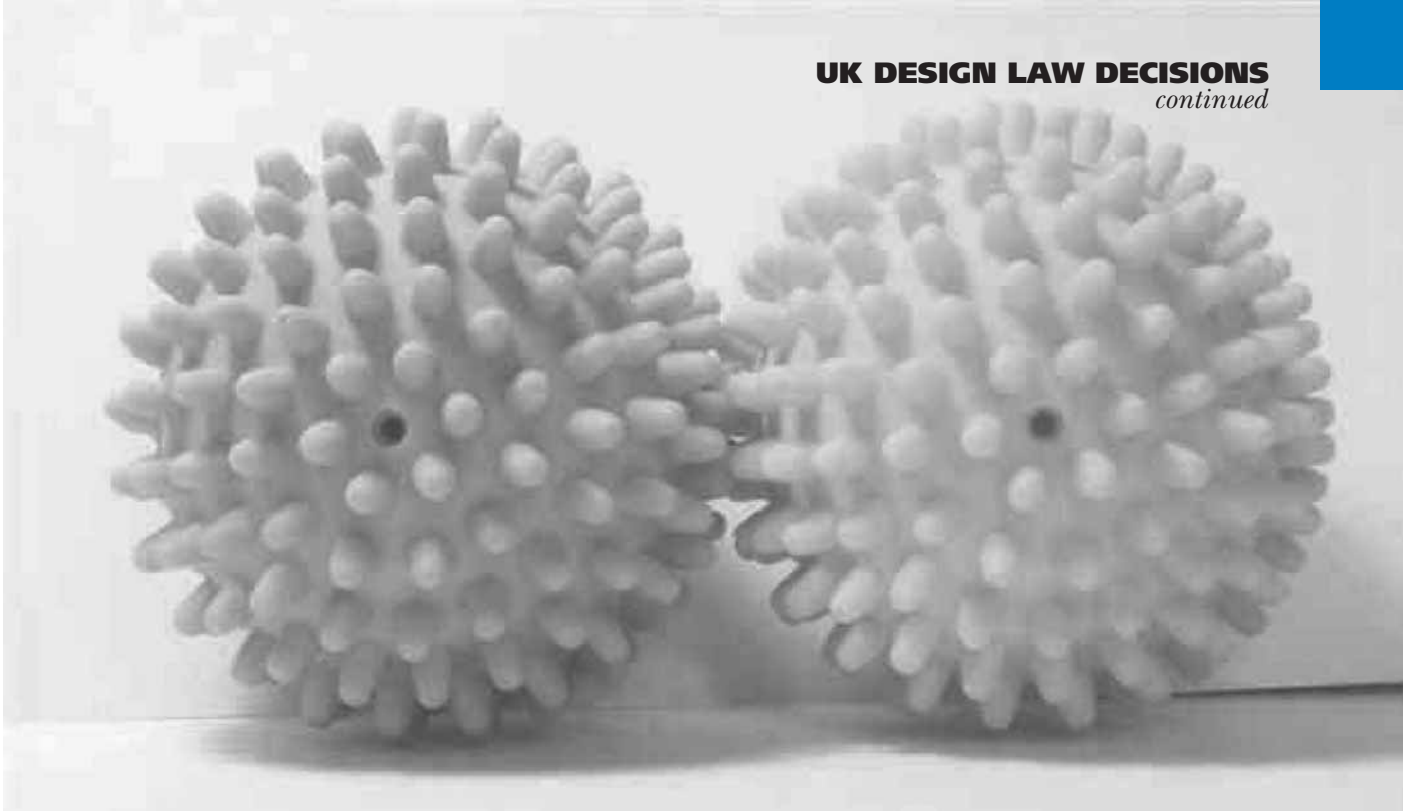
Comment:

This case indicates clearly that UK courts can be used to stop parallel importers selling into the EU from Hong Kong or elsewhere.



RCD 244793-0001 Sony PSP





RCD 000217187-0004 Green Lanes

FLATIRONS AND WASHING, cleaning and drying equipment

Green Lane Products Ltd v. PMS International Group Ltd & Ors [2007] EWHC 1712 (Pat)

This case concerned infringement of a registered Community Design (nos. 0002171817-0001 to 0004), registered for products indicated as “flatirons and washing, cleaning and drying equipment” by Green Lane Products. A pair of spiky blue and pink plastic balls were marketed for use in a tumble drier, to soften the fabrics. PMS, the defendant, had since 2002 been buying spiky plastic balls from China and marketing them in the EU as massage balls. In 2006, they decided to market the same balls as laundry drier

balls (in competition with Green Lane), and also for several other purposes such as hand exercisers or dog toys. Green Lane informed PMS that any use other than for massage balls would infringe their Community Design. This trial was on a preliminary point: namely, which disclosures constituted prior art.

For Community Designs, prior art constitutes disclosed matter, except where the disclosure “could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community”. The question here was, which was the “sector concerned”: the sector of the prior art (i.e. massage balls) or the sector of the design (i.e. laundry balls). The judge held that the design would be infringed whatever the product, so that the registration did not merely cover “flat irons and washing, cleaning and drying equipment”, but any product whatsoever (see *Landor & Hawa International v. Azure Designs Limited* [2006] EWCA Civ 1285). PMS, the defendant, would not in any case be prevented from doing what they did before the design, because there is a prior use defence under Community Design law. However, if the design were valid, they would be prevented from using their massage balls

for other purposes.

The judge concluded that the “sector concerned” was the sector of the prior art. In the course of the judgment, he cited with approval “Community Design Law – Principles and Practice” by David Musker, Head of the Jenkins Design Team (which stated the same conclusion).

Comment:

This judgment is welcome in confirming that the rights under a Community Design extend to any product regardless of the indication of product filed at OHIM (though the OHIM Boards of Appeal have indicated that that point is not quite certain, see below) and, as a corollary, that publication of a design in any sector prevents the further monopolisation of that same design in any other sector. It should be noted, however, that the decision does not deal with the question of “individual character”. In cases where a design is transposed from one sector to another and changes are made, the “informed user” responsible for assessing the differences may be located in the sector of the registered design rather than that of the prior art.

PARTNERSHIP NEWS

Dr Neil Condon joined Jenkins as a partner and opened our new office in Bristol (between London and the Patent Office in Newport), at the address below. Neil graduated from Cambridge University in 1992 with a degree in Natural Sciences specialising in Physics. He was awarded a PhD in 1996 by the University of Manchester for using scanning tunnelling microscopy to study nano sized structures formed on the surfaces of wide band gap semiconductors.

He entered the patent profession with Jenkins in October 1996 and qualified here professionally in 2000. In November 2000 he joined the UK patent department of Siemens. He returned to private



practice in June 2005 with another firm of UK Patent Attorneys and re-joined Jenkins in July 2007 to set up the Firm's office in Bristol.

He specialises in physics and electronics based inventions and has particular experience in preparing and prosecuting patent applications in the telecommunications field.



Dr David Brinck joined Jenkins in 2006 and became a partner at the beginning of 2007.

David graduated from Oxford University in 1990 with a degree in Physics, and subsequently was awarded an MSc in

Optoelectronic and Laser Devices by Heriot-Watt University and a PhD in Physics by Southampton University. Following a brief period working at the Technische-Universitaat Hamburg-Harburg as a post-doctoral research scientist, David joined the patent profession in 1996. In addition, in 2006 David was awarded an LLM in Intellectual Property Litigation.

David has worked with a wide range of clients, from multinational corporations to private inventors. He has particular experience in advising start-up companies on their patent strategy.

Phil Treeby also joined the partnership at the beginning of 2007.

He has been with Jenkins since 2001, having previously worked for a London based firm of solicitors and a leading Manchester based firm of patent attorneys.

His work concentrates around electronic and electromechanical inventions, with particular emphasis on semiconductor devices, image copying and surveillance

systems. He is a frequent visitor to Japan, and has spent some time working there on secondment with a Japanese law firm.



Jenkins is pleased to announce that partners Dr Stephen James and Hazel Buckley were awarded their certificates as Trade Mark and Design Litigators allowing them the same rights in UK proceedings for trade marks and designs as a solicitor. Jenkins now has 5 attorneys with litigation rights. We believe that training in litigation enables us to provide better prosecution services for our patent, trade mark and design clients, giving them rights ready to be enforced.

OFFICE NEWS

The Jenkins Munich office has moved and expanded, with the arrival of Henry Selby-Lowndes Henry graduated from King's College, London with a BSc. (Hons) degree in Physics with Medical Applications in 1999. Prior to joining Jenkins in 2006, he worked at the Munich office of a leading international IP law firm dealing with a broad range of technology and many contentious issues. This also enabled him to gain particular experience of managing and coordinating the prosecution of varied IP portfolios on behalf of a large HK-based multinational company, and also improve his German language skills to a fluent level. If you require advice on German designs or any other intellectual property matters, please contact our German office.

OUT AND ABOUT

Dr Stephen James ended his term as President of ITMA and was elected chair of ITMA's Laws & Practice Committee.

Stephen James, David Musker, Hugh Dunlop, David Brinck, Katie Cameron and **Angela Fox** also attended the WorldLeaders in IP dinner in London in November 2006, where Make Your Mark was named Best Achievement in Education.

David Musker and **Katie Cameron** represented ITMA at the Design Week Awards in February 2007.

Dr Stephen James, Roger George, Tim Pendered and **Hazel Buckley** attended the INTA annual meeting in Chicago in May 2007, where Hazel hosted a table topic on CTM opposition practice. **Jennifer Pratt** and **Katie Cameron** assisted at our hospitality suite there.

Hazel Buckley will also be attending the Marques meeting in Portugal in September.

Dr Stephen James, Roger George, Tim Pendered will attend the INTA Leadership

meeting in Orlando, Florida in November.

Nina Hurley attended the ECTA Conference in Deauville, France in June 2007.

Katie Cameron attended the March meeting of PTMG in Edinburgh and spoke on ECJ judgments at the ITMA spring conference in London in March. She will speak on comparative U.S. and E.U. design laws at the Midwest Intellectual Property Institute in Minneapolis in September, and on registered designs at a Hawskmere conference in London in November.

David Musker spoke on the overlap between design and trademark law at a seminar at Queen Mary and Westfield College in London in February, attended the Anti-Counterfeiting Group annual conference in Nottingham in May 2007, and will attend the November Asian Patent Attorneys Association meeting in Adelaide, Australia, where he has been invited to participate in the Design Committee meeting on the overlap between trade marks and designs.

Staff news

Congratulations to **Cara Baldwin**, who passed her UK qualifying examinations in April 2007. She is now fully qualified as a UK Registered Trade Mark Attorney and a European Trade Mark and Design Attorney qualified to represent at OHIM.

Alvin Lam, Nicolas Jones, Adam Brocklehurst and **Dr Philip Cupitt** have all just passed their European Patent Attorney Qualifying Exams.

Congratulations also to **Silke Petzold**, who is on maternity leave with her fourth child.

Dr Sarah Taylor was awarded her Certificate in IP Law from Queen Mary University earlier this year.

We welcome several new professionals:

Madeline Picker joined us from Philips, where she was Senior Patent Attorney and Head of IP Administration. She graduated in 1989 with an honours degree in Physics, and qualified as a UK and European Patent Attorney in 1994, and worked until 2005 in private practice. She has wide experience in all aspects of patent attorney practice, particularly in semiconductors, software and communications.

Dr Vincent Jennings graduated with a First Class honours degree in Mathematics and Physics in 1998 and was awarded his PhD in 2003. Over 2003 to 2007 he worked in Osaka for two large patent firms, and is presently training to become a UK and European Patent Attorney.

Keqian "May" Xu graduated in 2005 with a 1st class honours degree in Electronic and Communication Engineering from The University of Bath. She went on to receive a MSc degree the following year in Communication and Signal Processing from Imperial College, London. She joined Jenkins in 2007 and is training towards qualification as a patent attorney. May is fluent in Mandarin, which is her mother tongue, and she also has a good level of Cantonese.

If you would like extra copies of this Newsletter or one of our other publications, please either return a copy of this page to David Musker at our Caxton Street address or send an email to: dmusker@jenkins.eu

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