



Make Your **Mark**

Spring 2010

INTRODUCTION

A storm seems to be brewing in the Low Countries that threatens the outlook for CTM owners throughout the EU.

In a recent decision, the Benelux IPO rejected an opposition based on an earlier CTM that had been used only in the Netherlands, holding that use in only one EU country was not genuine use “in the Community.”

The decision in *Leno Merken B.V. v Hagelkruis Beheer B.V.* has stirred up a legal maelstrom, with critics and brand owners in consternation against a ruling that threatens one of the most fundamental perceived benefits of CTM ownership over national rights. It has long been

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EUROPEAN PERSPECTIVES

WHO'LL WIN ON AdWords?

Google's grip on keyword sales revenue tightened in September, when the Advocate-General opined that its sale of third-party trademarks as keywords to competitors was not trademark infringement. Google's display of competitors' sponsored ads as search results for such keywords was also held harmless by the Advocate-General, with the ECJ's judgment expected soon.

This opinion is not the last word in a dispute that has vast implications for online business. However, as the ECJ normally follows the Advocate-General's reasoning, it could point to the likely outcome for right owners and advertisers, whose businesses stand much to gain or lose.

“Use in Respect of Goods or Services”?

The heart of the dispute is whether or not Google's sale of registered trademarks to competitors as advertising keywords can infringe registered marks. To get an action off the ground, though, any brand owners mounting a challenge must prove that the sale of keywords amounts to *use* by the advertiser and/or by Google *in respect of goods or services identical or similar to those of the registered mark*. Can they?

The companies challenging Google

through the referring French courts stumbled in the attempt. Although the Advocate-General recognised that Google was selling keywords for commercial gain and was therefore acting “in the course of trade,” nonetheless the keywords were not, in and of themselves, linked to any goods or services, much less to ones identical or similar to the registered ones.

In the Advocate-General's view, no link between a keyword and actual goods or services arises until an Internet user types in a keyword and prompts Google's search engine to employ an algorithm to display search results, which, when accessed, then display content linked to goods or services. That was a long way down the line from the keyword sale and purchase, and was in any event more relevant to the question of whether Google's display of search results could infringe. At the keyword sale stage, however, there was no link between the keyword and *any* goods or services and the provision of a keyword selected by an advertiser was, in the Advocate-General's view, an internal matter for Google, despite money changing hands. This pure logic applied even to keywords combining brand names and words such as “counterfeit.”

Consequently, in the Advocate-General's view, the mere sale of a keyword by

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assumed that genuine use of a mark in a single EU country would sustain a CTM against non-use attack, and that conviction, in combination with the low cost of securing EU-wide protection, has catapulted the CTM system to a level of popularity never imagined before OHIM opened in 1996.

If the Benelux IPO is right, that understanding will have to change, and CTM owners will need to revisit whether they do in fact still need national rights too. The owner of a CTM subject to use requirements but used in only one member state should still be able to convert to a national application there under Art. 112 (2) (a) CTMR if attacked for non-use, but conversion is unlikely in oppositions and invalidations where the earlier CTM is not itself under revocation proceedings, and in those cases such a CTM might simply be disregarded. The CTM owner with a business in one country only may find, to its dismay, that it has no effective way to block a later conflicting national or CTM right in the absence of a parallel national registration.

The real position will not be clear until the ECJ gets its teeth into the issue, and there is no word yet of a pending reference. This key issue deserves an airing soon, though, and brand owners and advisors will be watching keenly for a resolution.

Meanwhile, it is hard not to detect a whiff of protectionism about a national IPO decision along the Benelux line. National IPOs stand most to lose from the overwhelming popularity of the CTM system, and cynics might (and do) see the BIPO's ruling as a gambit to encourage greater use of the national systems. While the EU's growing membership and population rightly give pause to the view that very geographically narrow use should sustain pan-EU rights, nonetheless a national office is not, in the eyes of most, an objective authority on the issue.

For now, CTM owners who have use in only one EU country might wish to shore up their position with a relevant national right pending guidance from the ECJ. Meanwhile, for the benefit of all involved, the eventual, inevitable reference to that Court will hopefully come soon.

Google could not in itself infringe a registered trademark.

But It's So Confusing...Or Is It?

The Advocate-General then turned his attention to what happened after keywords had been sold. Could Google be liable for trademark infringement where searches for a keyword presented an Internet user with advertisements for infringing and counterfeit goods?

He thought not. Trademark infringement could only occur where the unauthorised use was capable of affecting the essential function of the registered mark—namely, its ability to guarantee origin to consumers. Consequently, trademark infringement presupposed a likelihood of confusion. However, Internet users, the Advocate-General believed, were not the credulous creatures the challenging brand owners contended they were. Internet searches typically disclosed a list of natural search results, sometimes a very long list, many of which would have no connection with the site that an Internet user was seeking. Searches for brands would yield hits not only for brand owners' sites, but also for distributors and authorised and unauthorised re-sellers, competitor sites offering competing brands, and in some cases sites offering counterfeits and replicas.

The average Internet user was used to this in natural search results and therefore viewed them with a healthy scepticism, accepting a hit as the site he or she was seeking only once the site had been visited and its contents perused. Why, the Advocate-General asked, would the situation be any different with sponsored advertisements generated through the sale of keywords to advertisers? Internet users were a phlegmatic lot who typically reserved judgment on the origin of goods offered through a site until the site had been visited. Consequently, the mere display by Google of third-party sponsored advertisements in response to searches for keywords which happened to be registered trademarks was not an

infringement by Google, because there was no resulting likelihood of confusion.

The Advocate-General was reluctant to find even contributory liability in Google's display of search results, even in cases where the content of the actual websites themselves infringed on the traditional criteria. The Advocate-General saw dangers in hanging Google's liability on the indeterminate and unpredictable acts of third parties after the sale of a keyword, which the Advocate-General considered to be blameless in and of itself.

How to Trap a Google Now?

The Advocate-General left the door open for national courts to find contributory liability on Google's part where it could be shown that Google had engaged in practices that directly contributed to acts of infringement by a keyword purchaser.

If, for example, Google were to offer automated information to prospective keyword purchasers "suggesting" third-party trademarks combined with words such as "counterfeit," then such suggestions, regardless whether automated, could be regarded as contributing to any resulting later infringement arising from the linking of the keyword to a website offering counterfeit branded products. Whether this was the case was a matter for the national courts, however.

The Advocate-General also rejected Google's argument that it could resist any such liability by relying on the "safe harbour provision" of Directive 2000/31 ("the E-Commerce Directive") relating to information society services. That provision is intended to protect providers of hosting services from liability in cases where they were storing information at another's request, where the information being stored was in fact unlawful but not known as such by the host, and where the host acted promptly to remove it upon being notified that the content was unlawful.

The Advocate-General accepted that Google was providing a hosting service

and storing information at the request of third parties. However, unlike a typical hosting service, Google had an interest in third parties clicking on sponsored links bought and paid for by Google's advertisers through the so-called AdWords programme. In the Advocate-General's view, the E-Commerce Directive was intended to facilitate a free and open Internet by preventing the imposition of a duty on hosting services to monitor content hosted. However, with such benefits came also responsibilities: in particular, that hosting services should remain neutral as regards the content hosted. Where a host had a vested interest in hosted content being accessed in order to sustain its own advertising revenue, that aim of neutrality was not fulfilled.

Consequently, where national courts saw Google's conduct as tainted enough to create contributory liability, Google could not hide from it behind the "safe harbour provisions" of the E-Commerce Directive.

Comment

With Google largely shielded, the Advocate-General's final but brief examination of liability on the part of the advertisers themselves is of particular interest.

It offers little hope to brand owners, though, as the Advocate-General considered the mere purchase of a keyword not to be a "use in the course of trade" as required for trademark infringement. By merely buying a keyword, an advertiser is acting, in the Advocate-General's view, as a private consumer. It intends no doubt to use the keyword later in trade. But when buying the keyword it is entering into a purely private transaction with Google.

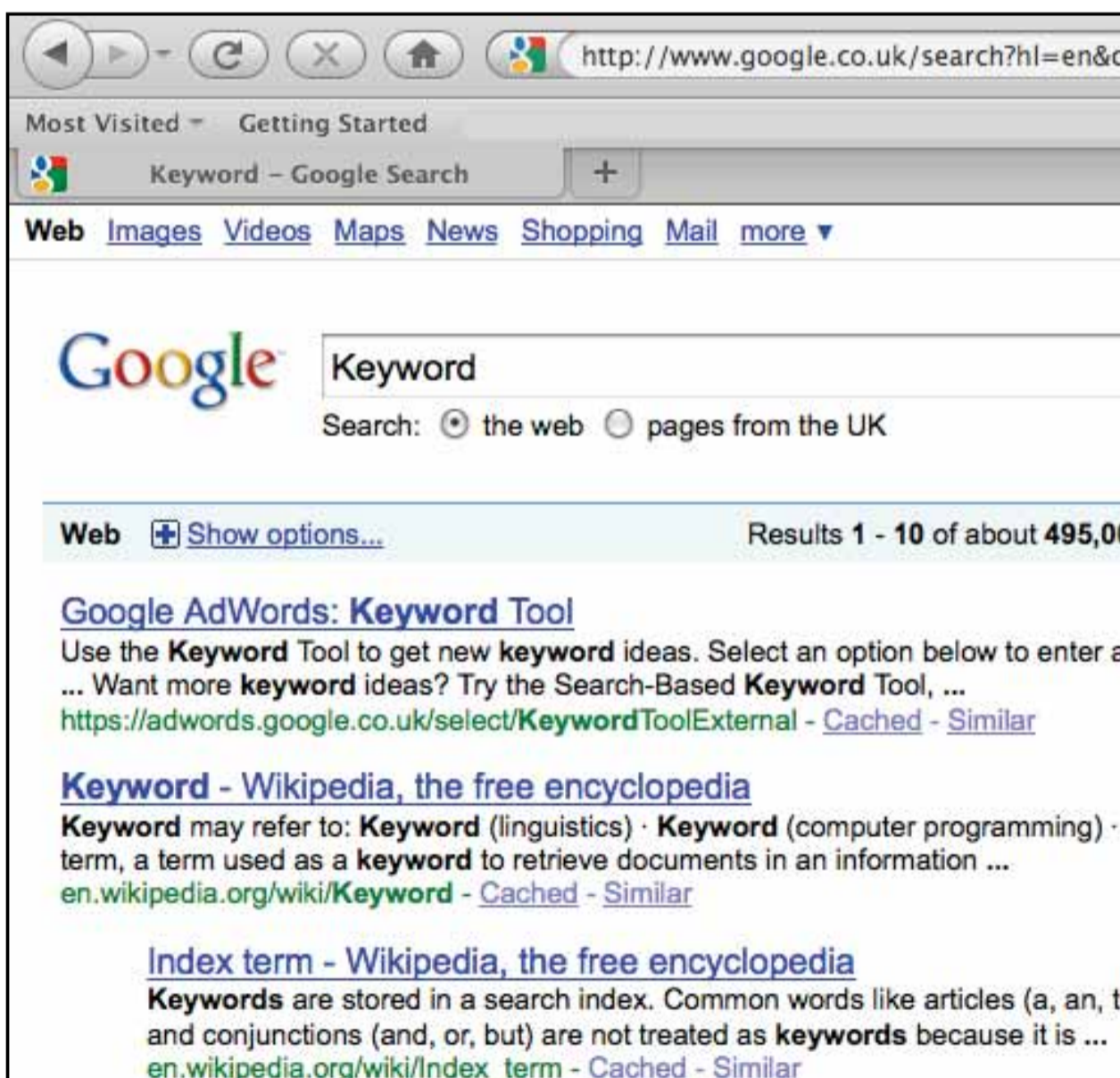
In a crowded and confusing legal landscape, the Advocate-General's fulsome opinion still leaves some areas unaddressed. He considered that where Google sells a brand name *solus* as a keyword, there is no link between the keyword and any goods or services. However, what if the keyword term is a trademark coupled with a product name,

such as "BOSCH refrigerators"? And what of brand names that are so famous as to be automatically associated with a certain product in the public mind, such as PEPSI? If the sale of keywords is truly an internal process only, then there can indeed be no link with goods or services even in these cases. However, since the value of keywords is inextricably linked with their ability to communicate a link with products or services offered by the purchasing advertiser, the distinction the Advocate-General was making here is arguably too fine.

Arguably, too, the Advocate-General gave insufficient attention to the possibility that trademark infringement might arise where other functions of trademarks were affected by Google's display of search results including keyword sponsored links. Internet users might indeed be savvy enough, for the most part, to tell a competitor's site or a counterfeiter's site from the real thing. However, the advertising function of registered marks, recognised by the ECJ most recently in *L'Oreal*, could be damaged and undermined by the undue profile given to competitor and counterfeit results arising directly from the sale of third-party trademarks as keywords. National courts are likely to have to explore this issue for themselves, and it may end up before the ECJ again before too long.

Clearly, though, the ECJ has a difficult line to tread. On the one hand, it is not in the public interest to hobble the Internet with more restrictions than have ever had to be applied to other traditional means of transmitting information, such as the printing press. On the other hand, though, Google appears to be making substantial hay by exploiting competitors' desire to attract custom by relying on the attractiveness of others' registered trademarks to give their own brands undeserved prominence. There is something intrinsically unfair about profiting in that way, both on the part of Google and on the part of those whose activities it facilitates.

It remains open to brand owners, as always, to challenge actual infringing uses on Internet websites. However, many would like



to see the problem rooted out at the source. Whether that is likely depends much on what the ECJ says, when it comes to grapple with the Advocate-General's views. One question that Court might wish to ask itself is, does Google sell the term "google" as an Adword to its competitor search engines? And if not, why not?

In this regard, it is interesting that a search for the term "google" on Google brings up no sponsored links. Nor does a search for "yahoo" on Yahoo, nor one for "ask jeeves" on Ask Jeeves, nor yet one for "alta vista" on Alta Vista. Readers, and the ECJ, will no doubt draw their own conclusions.

Editor's Note:

As we went to print, the ECJ ruled, confirming that Google's sale of keywords was not use of a sign in the course of trade, and that Google did not infringe.

The Court deviated, however, by finding that advertisers could infringe by using keywords identical to competitors' trademarks to display ads for competing goods and services. The Court skipped over whether buying keywords was "use in the course of trade" and instead focused on the risk of confusion arising from their later use, in circumstances where it was unclear whether goods or services offered through an ad displayed in search results did or did not originate from the trademark owner.

The Court regarded Google's neutrality in its hosting service and its ability to rely on the "safe harbour provision" of the E-Commerce Directive as a matter for national courts to assess on a case-by-case basis.

After this ground-breaking decision, Google will probably continue to barter freely with third-party trademarks as keywords. Advertisers should pause and consider, though, whether they are buying a bargain or a lawsuit. This judgment gives trademark owners new muscles to flex, and keyword revenue may decline naturally as a result. Caveat emptor, indeed.

PUNCHING ABOVE WEIGHT IN CTM Reputation Claims

As a brand owner in these troubled times, are you looking for ways to make a little go a long way? It seems the ECJ is there to help, as shown by its brief but illuminating judgment last fall in the *PAGO* drink dispute (*PAGO International GmbH v Tirolmilch Registrierte Genossenschaft mbH*, Case C-301/07). There, the Court held that a reputation in just one EU member state is sufficient to allow a CTM owner to sue competitors who use similar marks for, in particular, dissimilar goods or services.

Wiener Tipple

In *PAGO*, the claimant owned a CTM for a figurative mark depicting as its "essential element" a green glass bottle with a distinctive label and lid in respect of fruit drinks and fruit juices. In Austria, it marketed a successful range of fruit drinks packaged in the bottles. A competitor, Tirolmilch, launched a fruit and whey drink in Austria in similar glass bottles, and *PAGO* sued for infringement of its CTM.

Likely due to uncertainty over whether fruit drinks and fruit juices were similar to fruit and whey drinks, *PAGO* went beyond a normal confusion case and based its claim in part on a reputation in its figurative CTM in Austria, arguing that the use of the Tirolmilch bottle, particularly in ads prominently depicting it, was likely to take unfair advantage of that reputation under Article 9 (1) (c) CTMR.

PAGO unarguably had a reputation in its bottle shape in Austria, where its fruit drinks were widely known and consumed. But should a reputation in just one EU country bring into play a Community-wide right? The Austrian court was unsure and referred the issue to the ECJ.

A "Substantial Part of the EU"?

In reply, the ECJ turned to its 10-year-old decision in *General Motors v Yplon* (Case C-375/97) on the meaning of "reputation in a Member State" under Article 5 (2) of the Directive. In that case, the Court had held that a *national* mark can be regarded as having a reputation sufficient to found an infringement case based on unfair advantage and/or detriment where the mark has a reputation in "a substantial part" of the member state in which it is registered.

By analogy with *General Motors*, the Court held in a brief and unadorned judgment that an infringement action based on a CTM under Article 9 (1) (c) CTMR requires a reputation "in a substantial part of the territory of the Community."

As the role of the Court on a reference is to interpret EU law and not to apply it to the facts, one might not have expected the Court to wade into the politically-charged debate on whether any given member state might be regarded as "a substantial part of the Community." Yet this is just what the Court did. Echoing a similar foray into fact-finding in *General Motors*, the Court observed that it had already found that a part of one of the three Benelux countries was effectively "a substantial part" of the territory of the Benelux. Consequently, the Court felt comfortable in stating that a CTM with a reputation throughout the territory of Austria could be regarded as a CTM with a reputation in a substantial part of the EU. Consequently, a reputation in Austria alone was sufficient to sustain an infringement action based on a reputation claim under a CTM.

Comment

Should size really matter? Those surprised by the *PAGO* judgment might think so.

The value of a CTM is in its geographic spread: for the money, no better value can be had for protecting a mark across the whole of the EU. However, the law relating to CTMs has tended to develop in a way that recognises that the grant of Community-wide rights, which are capable of enforcement against local infringements across the entire EU, should be subject to certain restrictions. For example, CTM protection is not available for marks that lack distinctiveness in one or more EU member states, regardless how distinctive they may be in the others. Likewise, the recent CFI judgment in *Mars Inc. v OHIM* shows that a CTM sought on the basis of acquired distinctiveness will founder if the case cannot be proved for the whole of the EU. Disregarding minor-league economic players is not, it appears, an option.

Yet in *PAGO* one glimpses a more schizophrenic side to European jurisprudence on CTMs, after protection has been granted. As matters stand, a registered CTM owner, for example, may fend off a non-use revocation action with proof of use in a single EU member state (although this issue has yet to be examined by the ECJ). The ability to retain EU-wide protection for a mark used only in a small part of the EU is one of the most attractive features of the CTM versus separate national rights. However, *PAGO* now shows that the benefits do not stop there: the same CTM owner with a business and reputation in a single EU member state can rely on that local reputation to found an infringement claim under a ground, Article 9 (1) (c) CTMR, which does not even require identity or similarity of goods or services nor a likelihood of confusion. The fact that the CTM is a Community-wide right opens the door to such a claim being brought in a member state far-flung from that in which the reputation exists.

In practice, the latter scenario may arise infrequently since a CTM owner may struggle to prove unfair advantage or detriment arising from use in a member state where

the CTM has no reputation of at least the spill-over variety. Whether such damage is likely is a factual issue which has to be evaluated on its own merits. Nonetheless, the issue has yet to face a court, and the potential for extremes arising from *PAGO*'s interpretation of the necessary "reputation in the Community" is concerning. An action in France based on a CTM's reputation in Lithuania or Malta would certainly make the headlines if the CTM owner won.

PAGO is not the end of the story on the definition of a CTM with a reputation for the purposes of an infringement action. Far from it: the actual assessment of reputation and what is truly a substantial part of the EU are fact-questions that national courts are entitled to regard as their own rightful provenance. Consequently, *PAGO* holds an unenviably obscure and uncertain status as

authority on the status of any single member state as a "substantial part of the EU." The barebones reasoning set out by the Court does little to redeem the situation.

If there is one golden strand running through *PAGO* and *General Motors*, though, it is this: once the summit of registration has actually been reached, CTM owners can reap wide geographical benefits over old-style national rights in terms of breadth of protection, enforceability and injunctions. Whether and to what extent national courts uphold CTM infringement actions based on geographically limited reputation claims will likely remain highly fact-dependent, and not at all the simple formula that *PAGO* suggests. However, there is little doubt that when compared with vast numbers of nationals, a small portfolio of sturdy CTMs can indeed be more beautiful.



AFTER NOKIA, DISREGARD WEAK MARKS AT YOUR PERIL

As anyone familiar with mosquitos knows, the smallest things can sometimes cause the biggest trouble. So found Nokia recently, when it stumbled in an attempt to register LIFE BLOG as a CTM due to a challenge by Medion AG based on its short and simple registered German mark, LIFE (*Nokia Oyj v OHIM, Case T-460/07*).

This case and the ECJ's important ruling on composite marks 5 years ago in *Medion* (Case C-120/04) underline the need for caution where a new brand incorporates another registered mark that is only weakly distinctive. Particularly before OHIM, the earlier mark may pack more power than one thinks.

LIFE Begins

The dispute in Nokia began when the Finnish telecoms company applied to register LIFE BLOG as a CTM in Classes 9, 38 and 41 in 2004. Medion opposed on the basis of its own German registration for LIFE in Classes 1, 7 – 11, 16, 21, 28, 37, 38, 41 and 42.

The Opposition Division found for Medion, holding that LIFE and LIFE BLOG were similar and that the goods and services were partly similar such as to create a likelihood of confusion for most of the goods and services claimed. This ruling was upheld on appeal, and subsequently by the General Court. It is not so much the outcome, which might have been predicted, but rather the General Court's reasoning which is illuminating.

In essence, the General Court followed the Board of Appeal in regarding the earlier LIFE mark as being of "normal distinctiveness" in Germany following the ruling by the ECJ to that effect in the earlier *Medion* case. The English word LIFE was in common use in Germany and was likely to be understood as referring to the concept of life rather than to the concept of durability. The term BLOG

on the other hand was widely recognised even in Germany as being short for "web log" and was "rather weak".

Visually and aurally, the General Court regarded the marks as similar, in part because the common element, LIFE, appeared at the start of the later mark and was therefore more likely to come to the attention of the average consumer. Conceptually, the only difference was in the presence of the word BLOG in the later mark; and given the initial position of LIFE and the descriptiveness of BLOG, the conceptual differences would not be sufficient to offset the visual and aural similarities.

LIFE and BLOG were regarded as having equal prominence in the later mark, but given the descriptiveness of BLOG and the initial position of the LIFE element, the latter was regarded as being more likely to attract the consumer's attention.

As it was not disputed that the goods and services were partly identical and partly similar, it was no great leap from here to finding a likelihood of confusion, and the General Court upheld the findings of the Board of Appeal on that point.

Comment

Even before *Nokia*, it was clear from cases like *Medion* that weak registered marks can wield a power disproportionate to their size and distinctiveness. Anyone searching a new mark such as LIFE BLOG would therefore have paused, at the very least, upon noting a registration for LIFE on its own. Nokia's advisors probably did.

However, this is where consensus ends, because how best to deal with short and weakly descriptive marks with such ostensibly wide rights is a matter for long debate.

The fundamental problem in *Nokia* is that the mark in question is, to native English-speaking minds, probably less distinctive than the General Court assumed. The Court attributed some distinctiveness to LIFE on the basis that German consumers were unlikely

to link it to the durability of goods, but would instead think of "life" as a concept in general. In fact, though, in common and especially in advertising parlance, LIFE has come more and more to denote "lifestyle," eg, "products that suit your busy life". As such, it is hard to see how a simple mark such as LIFE could have any distinctiveness at all for "lifestyle" products and services, such as, for example, entertainment equipment, mobile phones, leisure products, clothing, etc.

The Court accepted that some of the products and services at issue in this case were expensive and that the average consumer was likely to take greater care in selecting them. If that really were the case, though, wouldn't the common and descriptive nature of LIFE influence the impression of the average consumer as to whether the sources of LIFE and LIFE BLOG products and services were necessarily economically linked?

It is possible that the outcome may have been different had Nokia been able to show that sufficient numbers of third parties in Germany used LIFE on its own to denote "lifestyle" that the distinctiveness of the LIFE mark was effectively diluted. Such tactics may well prove fruitful in other, similar cases depending on the state of the relevant marketplace; certainly, in a case like *Nokia*, such evidence would not prove elusive in an English-speaking one.

The long reach of Medion's mark in *Nokia* contains a useful lesson, though, rather than just a discourse on the strength or otherwise of one party's rights. That lesson is that ostensibly weak marks may punch above their weight, particularly where it is not obvious that their descriptive meaning is clear in the jurisdictions where they are registered. In such cases, evidence that such marks are understood descriptively in the relevant marketplace can really matter. Failure to prepare an evidence-based case against such Davids can bring down many a Goliath.

MEDION

AUDI DRIVES SLOGANS TO FORE in *Vorsprung* Case

Nearly 15 years after OHIM first opened, slogan marks still find it hard to get inside. In an age of soundbites, the attractiveness of a few catchy words as a marketing tool has never been greater, and slogans such as Audi's well-known *Vorsprung durch Technik* are powerful communicators for business. Yet, the lengths to which companies like Audi have to go to protect their investment in distinctive slogans demonstrate that more progress is needed in educating examiners about the principles that apply to such marks.

Audi Stalls...

Audi first secured CTM protection in 2001 for *Vorsprung durch Technik* (in German, "progress through technology") under no. 621086 for vehicles and parts in Class 12. Protection was granted on the basis of acquired distinctiveness, although by an oversight OHIM failed to communicate that fact to Audi.

The application was originally filed in 1997, and by 2003 Audi sought to protect its slogan for a much wider range of goods and services. It reapplied in Classes 9, 12, 14, 16, 18, 25, 28, 35 – 43 and 45. Given the apparent acceptance of CTM 621086 as inherently distinctive, the examiner's rejection of the new application as non-distinctive must have come as a surprise.

Audi pointed to the prior acceptance, whereupon the examiner admitted OHIM's mistake in failing to inform Audi about the finding of acquired distinctiveness. Nonetheless, the examiner maintained the objection to the new application on the basis that the mark was merely a laudatory advertising slogan which lacked distinctiveness for all the goods and services claimed, all of which related, if only remotely, to technology. Proof of acquired distinctiveness was required for the new application in all classes, even, surprisingly, in Class 12.

Audi appealed unsuccessfully to the

Second Board of Appeal, who were prepared to allow the mark only in Class 12, where proof of acquired distinctiveness had already been recognised. A further appeal to the General Court brought no further joy, and in January the ECJ handed down a ruling on Audi's final appeal.

...Until the ECJ Intervenes

The ECJ's ruling exposes a series of errors on the part of OHIM and the General Court in applying the case law relating to slogan marks.

In particular, the ECJ found that the General Court appeared to have paid only lip-service to prior decisions recognising that slogan marks are not excluded from registration purely because they are also used in advertising or as incitements to purchase, and that no stricter criteria for distinctiveness can be required of them than for other types of mark. There can be no requirement, for example, that slogans be imaginative or display a "conceptual tension which would create surprise and so make a striking impression" (*OHIM v Erpo Möbelwerk; SAT.1 v OHIM*, Case C-392/02 P).

In Audi's favour, the General Court had found that *Vorsprung durch Technik* could have a number of meanings, was effectively a play on words and might even be regarded as imaginative, surprising and unexpected, and therefore easy to remember. However, in spite of all this, the General Court held that the mark could only be distinctive if it was immediately perceptible as an indication of commercial origin. In this case, the General Court found that the slogan was not immediately perceptible in that way, because it was likely to be understood first and foremost as a laudatory "promotional formula".

The ECJ harshly criticised this reasoning.

The mere fact that a word mark has a laudatory connotation did not mean that it could not also function as a guarantee of origin as well. Provided that were the case, it was irrelevant that the mark might also be understood as a promotional formula. Ruling out Audi's mark because of its promotional potential was tantamount to finding that slogan marks, which typically have a promotional message as well as an origin-indicating one, could not be registrable at all because origin was not necessarily the "first and foremost" message conveyed by the marks.

Notably, the General Court had appeared to accept Audi's mark as being imaginative, surprising and easy to remember, and even perhaps a play on words. Yet this was, the ECJ noted, entirely inconsistent with the finding that the slogan lacked distinctiveness. The General Court had erred in apparently requiring such additional elements of attractiveness in slogan marks, but even so, having found they were there, the Court had been wrong to give those factors no weight in the assessment of inherent distinctiveness.

The ECJ noted the Board of Appeal's finding, at an earlier stage, that the slogan was no more than a banal message to the effect that "technological superiority enables the manufacture and supply of better goods and services." However, even if the mark were to convey that message, the ECJ did not regard it as sufficiently direct and descriptive of the goods to justify finding a lack of distinctiveness on that basis or even an objection under Article 7 (1) (c) CTMR. The mark required "a measure of interpretation" and exhibited "a certain originality and resonance" which made it easy to remember, all of which pointed to the mark being capable of distinguishing.

Comment

Audi found success at last, but it had to drive a long way to get there. Moreover, the fundamental nature of the errors made by OHIM and the General Court show that there is a worryingly wide gap between preaching and practice when it comes to the acceptance of slogan marks.

The ECJ rightly quashed the notion, implicit in the decisions under review, that the presence of a strong advertising message will suffice to exclude a slogan mark from trademark protection. The best slogan marks will always have such a message, and it will often—quite deliberately—be dominant. However, that does not mean that a slogan is not also inherently capable of distinguishing goods and services. The best slogans will do both, but the advertising power of the mark will almost always be at the fore given the purpose and role of slogans: namely, to stick to the reader or listener like glue, and then to unravel their origin-indicating message.

Interestingly, the fame of Audi's slogan for motor vehicles appeared to influence the ECJ in its assessment of inherent distinctiveness. It remarked that the actual success of Audi's slogan as an origin-indicator in Class 12 might make it more likely that the mark could inherently distinguish other goods and services as well, since the average consumer was already used to encountering it in that way for some goods. This approach may be useful to brand owners, like Audi, who have a successful mark registered on the basis of acquired distinctiveness, and who wish to expand the protection to other classes without having to file evidence in support of it.

The ECJ's reasoning on this point suggests that the benefits of acquired distinctiveness might effectively reach out beyond the area of existing protection by making it easier to register the mark as inherently distinctive later for new categories of goods or services. In practice this argument is likely to be difficult, and the ECJ did not explore it sufficiently deeply to give it meaningful support. For owners of successful slogans, though, it may be a card well worth playing where product and service lines expand, but budgets for proof of acquired distinctiveness do not.



KINDER SURPRISED: No *Res Judicata* in OHIM Disputes

When you're in a hole, stop digging is often good advice. Stepping back from a losing case can make sense, not least if it allows a party to come back later with better funding and a stronger, winning strategy. Where failure to appeal leads to an unhelpful decision becoming binding in later proceedings, though, a party can find itself trapped in a dilemma.

Such was the situation in which Ferrero SpA found itself recently in *Ferrero SpA v OHIM* (Case T-140/08). Before the General Court, the makers of KINDER SURPRISE and other well-known KINDER-branded chocolate confectionery forced a re-examination of the rules on *res judicata* in CTM opposition and invalidity proceedings. The resulting clarification is extremely useful to brand owners when revisiting strategy in CTM opposition and invalidation cases.

Reviewing the Situation...

It all began with an opposition by Ferrero SpA to a CTM application for a TIMI KINDERJOGHURT Logo of Tirol Milch for yoghurt products in Class 29. Ferrero filed a streamlined case, relying only on an earlier Italian registration for KINDER for Class 30 goods including chocolate and confectionery.

Ferrero lost at first instance and before the Fourth Board of Appeal. Apparently re-thinking its strategy, it opted not to appeal further to the General Court, but rather allowed the decision to become final. The Tirol Milch CTM was then registered. Ferrero then applied for a declaration of invalidity, relying not only on its earlier Italian registration, but also on a claim to a "family" of 35 other earlier KINDER marks in Italy, France, Spain and elsewhere.

Before OHIM's Opposition Division, the new strategy worked and the CTM was declared invalid. The Second Board of Appeal reversed, however, finding that OHIM was bound by its decision in the earlier opposition proceeding because the outcome had enabled Tirol Milch legitimately to acquire rights in a CTM. The Board held that although the principle of *res judicata* did not specifically apply, nonetheless OHIM was bound by the earlier substantive findings and conclusions in the opposition because the later invalidity proceedings were brought involving the same parties, the same subject matter and the same grounds.

On a further appeal, however, the General Court reversed again. It approved the Board's finding that *res judicata* was inapplicable to CTM opposition and invalidity decisions, in part because they were administrative rather than judicial in nature. It also accepted the Board's view that prior opposition decisions could not be completely ignored in later invalidity proceedings involving the same parties, subject matter and grounds, provided that the findings or issues are "not affected by new facts, new evidence or new grounds."

Nonetheless, it disapproved the Board's finding that there was a principle of legitimate expectations involved in the granting of a CTM. The General Court ruled that because the principle of *res judicata* does not apply, even a final decision in opposition proceedings does not confer any legitimate expectation that a CTM will not later be struck down in invalidity proceedings. If that were the case, then a subsequent invalidity action between the same parties would have no practical effect, despite the CTMR not prohibiting such challenges.

This finding essentially rescued Ferrero's revised attack strategy, although in practice it was of little use to them, as they lost the appeal in any event on the grounds that the marks were not similar.

Comment

Although the Italian confectioner's limited success was somewhat less than sweet, it will nonetheless satisfy the cravings of others for legal certainty on the status of OHIM opposition decisions when subsequent invalidity proceedings are brought.

The decision makes clear that failure in a CTM opposition does not block a challenger from re-asserting its case as an invalidation. It brings OHIM into line with the practice in the UK, where a challenger is not estopped from re-running a failed opposition as a new invalidity proceeding (*SPECIAL EFFECTS*, [2007] RPC 15). In *SPECIAL EFFECTS*, the Court of Appeal regarded the availability of invalidity proceedings as evidence that a mere decision to register could not give rise to a final decision entitling a registrant to certainty that the right could not be removed. This is consonant with the General Court's finding in *Ferrero* that there is no legitimate expectation that a registered CTM cannot be successfully challenged, including by a previously unsuccessful opponent.

It is important to note that this principle does not necessarily apply to the re-running of invalidity proceedings, though. Under Article 53 (4) CTMR, an unsuccessful applicant for

invalidity on relative grounds cannot re-apply for invalidity later on the basis of another right that he could have raised the first time but did not. Such conduct in the UK may also run a case aground as a cause of action estoppel or an abuse of process. So, while a botched opposition might perhaps be put right, a failed invalidation is final.

The ruling in *Ferrero* will benefit opponents who need to re-think their strategy following a disappointing opposition outcome, and shows that it is not necessary to throw good money after bad in appeal proceedings with poor prospects, simply to keep the issues alive. Better instead to keep one's powder dry for a stronger and tighter invalidation case, if the facts support it.

It remains to be seen whether knowing that opposition decisions are not the last word results in more subsequent invalidation claims. It will be a less helpful outcome if parties take it as encouragement to pursue oppositions only languidly and to reserve the real fight, if one is needed, for invalidation. The fact that CTMs once registered can be enforced will hopefully be enough to concentrate parties' minds in an opposition, and in the cases that really count opposition is likely to remain a major battleground.



German Courts Toy with Law in *Opel* Model Decision

The German automaker Opel cannot rely on trade mark rights in its famous lightning blitz device for cars and toys to prevent the distribution of scale models of its cars. This was the surprising outcome of the German Federal Supreme Court's (Bundesgerichtshof's) long-awaited verdict in the *Opel* toy car case ("Opel-Blitz II," BGH, 14 January 2010, I ZR 88/08).

The claimant, Adam Opel GmbH, is the proprietor of a German trade mark registration for the famous *Opel-Blitz* device, covering motor vehicles and toys. The defendant manufactured and distributed radio-controlled toy cars that were copies of the Opel Astra Coupé car in a reduced scale, which featured the *Opel-Blitz* logo affixed to the grille. Opel tried to prevent sales of the models by suing the defendant for infringement of the trade mark registration for the *Opel-Blitz* logo.

The court of first instance, the Regional Court (*Landgericht*) Nürnberg-Fürth, referred the matter to the ECJ for a preliminary ruling. The ECJ decided that the issue was really whether the relevant consumer would interpret the logo device affixed to the toy car as a reference to trade origin and believe that the model car originated from Opel or an economically linked undertaking (C-48/05, 25 January 2007). If so, there could be trade mark infringement. Otherwise,

there would not.

Based on this ruling the Regional Court dismissed the claimant's case (LG Nürnberg-Fürth, 4HK O 4480/04). It held that the relevant consumer would regard the logo as part of the model car rather than an indication of its origin. In other words, the consumer would not attribute the logo to Opel in the sense of trade origin, or assume that there was an economic relationship between the toy car manufacturer and Opel.

The Court of Appeal (*Oberlandesgericht* Nürnberg) as well as the *Bundesgerichtshof* upheld this decision. In particular, the *Bundesgerichtshof* found that the *Opel-Blitz* affixed to toy cars which were models of the original cars would be seen as a reproduction of a detail of the original car rather than a reference to the trade origin of the toy car.

Insofar as the claimant's mark was registered for motor vehicles, the goods concerned (model cars and motor vehicles) were dissimilar so that there was no trade mark infringement based on a likelihood of confusion.

There was moreover no infringement based on unfair advantage of or detriment to the *Opel-Blitz* trade mark's reputation, as the Court ruled that no unfair advantage had been taken and no detriment had been caused.

Comment

This decision is remarkable. Adam Opel GmbH must have felt confident that its registered trade mark covering toys would ensure it the exclusive right to distribute scale models of Opel cars. On the face of it, that was a reasonable assumption and probably one relied on by many other manufacturers of large-scale items like cars, aeroplanes and boats whose creations are copied in the small scale by toy and model manufacturers. Although the decision is logical on the question of trade origin, it nevertheless constitutes a perhaps unexpected limitation on the scope of trade mark rights.

This decision also brings to mind the earlier "Toy Cars" decision of the Bundesgerichtshof ("*Spielzeugautos*", GRUR 1996, 57) in which the court held that the manufacture of toy cars constituted an infringement of the registered design of the corresponding original car. If it looks to registered design law, therefore, Opel may yet have another string to its bow.



OPEL

Snippets

When the Community Trade Mark (CTM) was first introduced to the wider world over 15 years ago, one of the big selling points was that genuine use of the mark in just one EU member state would be sufficient to maintain the validity of a CTM registration after it left its 5 years' grace period. This view was based in part on the Joint Statements of the Council and the European Commission that were published alongside the CTM Regulation in order to assist in the interpretation of that Regulation. It is also the view that is at present followed by OHIM in contentious proceedings involving a potentially vulnerable CTM registration.

From the outset, however, this position always looked a little odd to the writer for two reasons. First, one's instinctive reaction was that such a narrow use did not seem adequate to justify such a wide and powerful monopoly as a CTM registration. Second, and more important, it appears to be in conflict with the conversion provisions set out at Article 112 of the Regulation (now 207/2009) under which CTM registrations could be converted into EU national trade mark applications. In particular, under Article 112(2)(a), it states that conversion shall not take place:

"(a) where the rights of the proprietor of the Community trade mark have been revoked on the grounds of non-use, **unless in the Member State for which conversion is requested the Community trade mark has been put to use which would be considered to be genuine use under the laws of that Member State;**"

If it were clearly the intention of the legislators to allow genuine use of a CTM in one EU member state to maintain the validity (and enforceability) of a CTM, why would the Regulation provide for the conversion of such a CTM when it has indeed been used in a member state?

In a recent opposition (*Leno Marken v Hagelkruis Beheer*) before the Benelux IP Office (BIPO), the "one country" use theory was put to the test and was found wanting. Hagelkruis sought a Benelux registration for the trade mark *Omel* for *inter alia* advertising services. The application was opposed by Leno based on their CTM registration for *Onel* covering identical services. Since Leno's CTM registration had been registered for over 5 years, Hagelkruis asked them to prove genuine use in the Community. Leno provided evidence of their use of the mark in the Netherlands arguing that this

was sufficient, under Article 15 of the CTM Regulation, to maintain the validity of their CTM right.

The Benelux Office rejected Leno's opposition, on the basis that they had not provided adequate evidence of genuine use of the trade mark *Onel* in the Community. According to BOPI

- The Joint Statements that accompanied the CTM Regulation were not legally binding (relying on the ECJ's decision in *Praktiker* (C-418/02));
- The "one country" theory of genuine use was at odds with the conversion provisions of the CTM Regulation; and
- More generally, if the rights conveyed by a trade mark monopoly (in particular a CTM registration) reached beyond the EU member state in which that trade mark was actually used, it would obstruct the free movement of goods and services in the Community.

Given the significance of this decision, OHIM immediately issued the following statement: "*OHIM – applying the principle of the unitary character of the CTM – continues to consider that boundaries of member states should not play a part in assessing 'genuine use' within the EU single market, as recently outlined in its contribution to the European Commission study on the overall functioning of the trade mark system in Europe*".

As Mandy Rice-Davies famously said in the notorious trial that followed the Profumo scandal in the 1960s, "He would say that, wouldn't he?"

In the writer's opinion, the Benelux Office's decision is correct and the ECJ's decision in *PAGO*, see elsewhere in this edition of **Make Your Mark**, is wrong. A CTM registration is a very powerful and wide reaching monopoly. It covers 27 countries and a potential consumer population of 500 million. If neither opposed nor the subject of absolute grounds objections, a CTM registration costs less than £2,000 to obtain. It is therefore submitted that, unless certain restrictions are placed on the enforcement of a CTM, the CTM regime will eventually push EU national trade mark offices (and the trade mark rights that they issue) to the point of extinction. The only way to avoid this happening is to accept that, if you own a pan-European right, the price you have to pay to enforce it should be higher than that required to enforce a mere national right. If you are not prepared to pay that price, then obtain a national right

(which, in itself, is now an extremely cheap and simple process via the Madrid system).

Eventually, the conflict between the diverging views on the validity and enforcement of CTM rights will be a political decision, even though it will be taken by a Court (the *ECJ*). When taking that decision, however, the Court should be mindful that the fate of EU national trade mark offices will lie in its hands.

Another doctrine of the OHIM faith is that claims to class headings protect all goods or services in that class. This is a view that is not universally shared by all EU national Trade Mark Offices, in particular the UK Trade Mark Office. Thus, a Class 9 class heading is interpreted by the CTM Office as covering "computer software", even though such goods are absent from the wording of that class heading. By contrast, the UK Office would refuse to acknowledge the presence of "computer software" in such a Class 9 specification, unless it were specifically mentioned, when interpreting such a specification in contentious proceedings.

However, when examining a UK trade mark application on absolute grounds, the UK Office is in rather an invidious position. Do they, for example, accept a mark that is clearly non-distinctive or descriptive in respect of computer software if such goods are not in fact mentioned in the application's specification, when they know that, once granted, the owner would be in a position to enforce that right at OHIM as if it were protected for computer software? The compromise that they have reached is to raise absolute grounds objections during the examination of cases such as those set out above, but to interpret such specifications in contentious proceedings in a literal sense, that is, if computer software is not specifically claimed, it is not protected.

The UK Office's examination practice was put to the test recently in a case (*Chartered Institute of Patent Attorneys (CIPA) vs UKIPO*) involving the trade mark *IP Translator*. CIPA had applied to register their mark in respect of "education; providing of training; entertainment; sporting and cultural activities" in Class 41. In other words, for the Class 41 class heading.

Following their published practice, the UK trade mark examiner rejected the mark under Sections 3(1)(b) and (c) of

the 1994 Trade Marks Act on the basis that the mark would “designate the nature of the services e.g. translation services in the fields of intellectual property”. CIPA replied that they had not claimed such translation services and that the mark *IP Translator* should be perfectly acceptable for the Class 41 services that had in fact been claimed. The Institute argued that the *Sieckmann* criteria (ECJ case C-273/00) that applied to trade marks, namely that they should be “clear, precise, self-contained, easily accessible, intelligible, durable and objective” should also apply to specifications of goods and services. The UK Office’s practice was said to fail such a test.

Unfortunately for CIPA, the Section 3(1) (b) and (c) objections were maintained. This decision relied in part on a ruling of the Court of First Instance (*BMI Bertollo v OHIM*) where the class headings set out in an Italian trade mark registration were viewed as protecting all goods in the relevant classes. It should be noted, however, that in that case, the Court did not hear any arguments that put the contrary view. The decision also maintained the UK Office’s present position that the public interest is best served by interpreting class headings in a broad sense for the purposes of Section 3 (absolute grounds) examination.

Don’t be surprised if this decision is appealed. Perhaps it will be the case that will eventually reach the ECJ and put an end to the controversy that surrounds this important point of practice.

The fight against counterfeit goods was dealt a serious blow by a recent decision (*Nokia v HM Revenue & Customs*) of the English High Court.

A shipment of fake *Nokia* branded phones, on their way from Hong Kong to Colombia, had made a transit stop at London’s Heathrow airport. Nokia became aware of the counterfeit products and asked HM Revenue & Customs (HMRC) to seize them under the EU Customs Regulation (1383/2003). HMRC refused to do so, taking the position that such goods in transit could not usually be classed as counterfeit within the terms of the Regulation. HMRC maintained that they would only act in such cases if there was strong evidence that the goods might be diverted onto the EU market.

Nokia, not surprisingly, were not happy with this interpretation of the EU Regulation and sought a High Court judicial review of HMRC’s decision. Unfortunately, the Judge (Mr Justice

Kitchin) ruled in favour of HMRC on the following basis:

- i) Goods in transit through the EU, that were not destined for the EU, did not fall within the definition of counterfeit goods set out in the EU Customs Regulation. They could therefore not be seized under that Regulation, even if they were in fact counterfeit. The mere risk that the goods could be diverted into the EU was not enough to justify seizure.
- ii) In order to succeed in a trade mark infringement action, a trade mark proprietor had to show that goods, even counterfeit goods, had been put on the EU market. Goods in transit, in the absence of, for example, clear evidence that they might be diverted, could not be classed as infringing goods. In reaching this decision, the Judge relied on two earlier decisions, *Eli Lilly v 8PM Chemist* and *L’Oreal v eBay International*.
- iii) The EU Customs Regulation (1383/2003) had not introduced new tests for deciding whether or not a mark was being used in the course of trade or for judging the existence (or otherwise) of trade mark infringement.

It is understood that Nokia has appealed against this adverse decision and that the Court of Appeal has sought a ruling on this crucial question from the ECJ.

It is clear from the rigorous reasoning of Mr Justice Kitchin that the EU Customs Regulation is deficient and needs to be amended to allow counterfeit goods that are passing through the EU to be seized. In the meantime however, it is to be hoped that the ECJ finds a way to interpret the present Regulation that allows Nokia to succeed. The public interest demands it, whatever the wording of the Regulation. After all, if the European Court can find a way to interpret “dissimilar goods” to mean “identical, similar and dissimilar goods” in the *Davidoff* case (C-292/00), then it should not be beyond their wit to rule that the present wording of the Customs Regulation can be stretched in a way that favours the legitimate interests of honest traders and that is to the detriment of the crooks who manufacture counterfeits.

The European Court of Justice (General Court) has decided (in *Stella Kunststofftechnik v OHIM*; T-27/09) that opposition proceedings and revocation proceedings are entirely autonomous and can run side by side at OHIM.

Stella Kunststofftechnik (Stella K) had opposed a CTM application for the trade

mark *Stella Pack* (figurative) made by Stella Pack for a wide variety of goods. In their opposition, Stella K had relied on an earlier CTM registration for *Stella* covering a range of identical and similar goods which had been registered for less than 5 years at the date of publication of Stella Pack’s CTM application. It followed that, in the opposition proceedings, Stella K would not have to file any evidence of genuine use of their mark and could rely on the full list of registered goods, whether they had sold them or not.

Before a decision was reached in the opposition, however, Stella K’s CTM registration became vulnerable to a non-use revocation action (5 years after its grant) and Stella Pack duly filed such an action before OHIM’s Cancellation Division. At this point, the opposition proceedings were suspended.

The Cancellation Division, having considered the evidence of use that Stella K had filed, decided to revoke their CTM registration partially. Stella K appealed, arguing that their proof of use was adequate to resist the revocation action and that, more generally, the revocation action should be dismissed as inadmissible given the pending opposition proceedings.

The Board of Appeal, in confirming the original decision of part-revocation, rejected both arguments. In the Board’s view, the existence of the opposition proceedings was irrelevant to the consideration of the revocation action.

Stella K appealed again to the European Court of Justice (General Court). Again their appeal was dismissed. According to the Court, the two proceedings were distinct with their own separate purpose. The General Court also ruled that, if the earlier mark were to be revoked, the opposition would be devoid of purpose. In other words, even if the earlier CTM right was in existence at the publication date of the later CTM application and was revoked from a date after the later CTM application’s publication date, the revocation of the earlier CTM should lead to the opposition being rejected.

The suggestion by the General Court that, in the circumstances outlined above, “the opposition would be devoid of purpose” is in line with OHIM’s practice, but is at odds, both with an earlier decision of the Court of First Instance (*Coyote Ugly*;



T-161/07), as well as the practice of the UK Trade Mark Office, following the *Riviera* decision (2003 RPC 59).

These matters were recently discussed in a UK trade mark opposition between Associated Newspapers and C.A. Simpson. The relevant facts of the case were these. Associated filed a UK trade mark application on 21 August 2001 which was published for opposition on 1 July 2005. Simpson owned an earlier CTM registration which had a filing date of 10 December 1999 and a grant date of 17 June 2003. It followed that, at the date of publication of Associated's application (1 July 2005), Simpson's registration was not subject to proof of use requirements. The opposition was fought and Simpson prevailed. However, on 11 May 2009, Associated sought to revoke Simpson's CTM registration for non-use and then subsequently (at the hearing which took place on 14 May 2009) argued that, should they (Associated) lose the opposition, then there should be a stay of execution of the adverse decision pending the outcome of the OHIM revocation proceedings. Should those proceedings be successful, then the opposition should fail since Simpson would no longer own an earlier trade mark right.

The Hearing Officer, Mr Smith, rejected this argument and refused the stay. Relying on the *Coyote Ugly* and *Riviera* decisions, and following established UK Trade Mark Office practice, Mr Smith found that, even if Associated's revocation action were successful, it would only be successful from 11 May 2009 (the date the revocation action was filed). This meant that Simpson's earlier CTM registration would still have been in existence at the key date in the opposition proceedings, namely the date of publication of Associated's later UK trade mark application (1 July 2005). Thus, even if Associated's revocation action succeeded, Simpson would still own an earlier trade mark right at the relevant date and his opposition would still succeed.

Those who have reached this point in Snippets will now realise, if they hadn't before, that the harmonisation of EU trade mark practice still has a very long way to go.

There was a time when proceedings before the UK Trade Mark Office could best be described as cheap and cheerful. The pleadings sometimes left something to be desired, the evidence could occasionally be, shall we say, limited and, as a result,

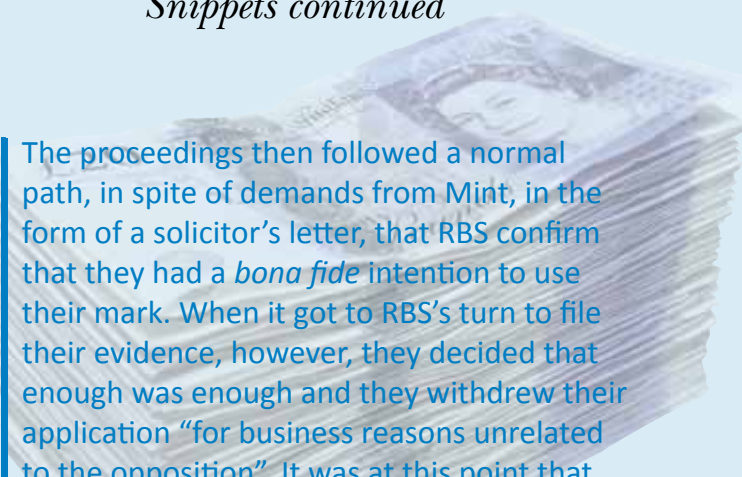
the Hearing Officer had, in some cases, to employ a certain amount of imagination when reaching a decision. However, in the writer's view, the majority of these decisions were correct and, if they were not, there was a good chance of overturning them on appeal. Further, both parties had had "their day in court" on a very limited budget. In other words, the system was accessible to all and it worked.

As a result of a series of recent Court cases however, in which the pleadings and/or the evidence filed before the UK Trade Mark Office has been heavily criticised, appeal tribunals have become increasingly constrained from overturning the original decisions and litigants are even estopped from arguing their case in the High Court because of an earlier Office decision (see the *Firecraft* case discussed elsewhere in this edition of **Make Your Mark**), all this has changed.

Proceedings before the UK Office are now treated as mini-trials. Since the Office's decisions are also extremely difficult to overturn on appeal, the importance of putting your best case forward at first instance (that is, before the Office) is now widely recognised. Not surprisingly therefore, the cost of contentious proceedings before the Office has risen considerably. As a result, some Hearing Officers, though not all, have started to award costs to the winning party that dwarf previous awards. This is particularly the case when a party has been found to have acted unreasonably and a costs award that is off the normal scale is sought. In one such case (*Target Brands v Music Choice*), for example, an astonishing costs award of £112,000 was made to Music Choice.

As a result of this fundamental change in the nature of UK Trade Mark Office proceedings it is now not unusual to read decisions in which six figure costs awards are sought. For example, in a recent appeal (*Foreign Supplement Trade Mark v Maximuscle*) to the Appointed Person (Mr Hobbs QC), the opponent claimed costs of over £150,000. In another case (*Royal Bank of Scotland (RBS) v Mint Partners*), however, where an outrageous costs award of £96,000 was requested, the Hearing Officer, Mr Smith, struck a blow for common sense, if not the more reasonable approach of a few years ago.

In the *RBS* case, the opponent, Mint, relied on various relative grounds of opposition, as well as the accusation that RBS's application had been filed in bad faith (Section 3(6) of the 1994 Trade Marks Act).



The proceedings then followed a normal path, in spite of demands from Mint, in the form of a solicitor's letter, that RBS confirm that they had a *bona fide* intention to use their mark. When it got to RBS's turn to file their evidence, however, they decided that enough was enough and they withdrew their application "for business reasons unrelated to the opposition". It was at this point that Mint's representatives claimed £96,000 in costs. The UK Office saw no reason to award costs above the normal scale and refused to do so. Mint persisted and requested a hearing. At the hearing, it was disclosed that RBS had incurred costs of £2,500 in the opposition, whilst Mint had incurred costs of £96,000 employing trade mark attorneys, solicitors and both English and Scottish counsel.

The Hearing Officer was having none of it. He decided that in the original opposition, Mint would have been awarded £1,100 in costs. However, because of their persistence with the request for additional costs, which was denied, RBS would, in turn, be awarded £1,100. As a result, no overall costs award was made in favour of either party.

It is clear that a return to the much more informal nature of proceedings that made justice (albeit, in some cases, rough justice) available to all before the UK Trade Mark Office is unlikely. However, it is imperative that the UK Office continues to resist the sort of costs award that was being sought in the *RBS* case. In the writer's view, an award above the normal scale should only be contemplated if the behaviour of one of the parties is clearly dishonest. In all other cases, such an off-the-scale award should not be made.

If the Office follows that practice and resists calls for significant increases in costs awards in contentious proceedings, then it is hoped that the message will eventually get home to all parties (and their representatives) that incurring six figure sums when contesting proceedings before the UK Office is both disproportionate and unjustifiable.

Let me test you. Which of the following marks do you consider to be confusingly similar, *Solvo/Volvo*, *Vinopoly/Monopoly*, *Agile/Aygill's*, *Famoxin/Lanoxin* and *Ester-E/Esteve*? The answers are at the bottom of this Snippets article. If you got four out of five correct, a place on an OHIM Tribunal or the European Court clearly awaits you.

In the writer's view, the outcomes of these five cases illustrate the difficulty of clearing trade marks for registration and use in Europe, as well as predicting the

outcome of CTM oppositions. They also exemplify two fundamental flaws in the practice that has developed in relation to the comparison of marks.

The first flaw is the weight that is often given, particularly by the European Court of Justice, to the phonetic similarity of trade marks. This is perfectly illustrated by the *Solvo/Volvo* case. Overturning earlier findings of a lack of similarity between the two marks by both the Opposition Division and the Appeal Board, the General Court ruled that, although there was no visual or conceptual similarity between the marks, this was outweighed by their phonetic similarity. This finding was reached in spite of the fact that the Class 9 goods at issue were “computer programs for warehouse management systems and computer programs for container terminal systems”, clearly the sort of goods where an errant grandparent might mis-hear the name of the Christmas present or the type of confectionery requested by their grandchild. It is submitted that, as consumers, we live predominantly in a visual and a conceptual world. Phonetic misunderstandings when making purchases, particularly in the business world, are few and far between. The sooner the ECJ begins to give phonetic similarity the (low) weight it deserves therefore, in the overall assessment of the two marks, the better.

In the *Vinopoly/Monopoly* and *Agile/Aygill's* cases, the (alleged) phonetic similarity of the two marks also played its part, although in both of these cases the marks were also said to be visually similar. The writer finds the latter finding (of visual similarity) in the *Agile/Aygill's* case incomprehensible.

The second flaw will be well known to regular readers of **Make Your Mark** and that is the Court's (and the Office's) treatment of cases involving Class 5 goods. It is an astonishing fact of CTM practice that marks with a greater degree of similarity are allowed to coexist for pharmaceutical products than would be allowed for consumer items, such as toys and sweets. Both the *Famoxin/Lanoxin* and *Ester-E/Esteve* cases confirm this wrong-headed, even dangerous, approach. Both of these contentious proceedings involved Class 5 products and both findings of a lack of similarity relied on the higher degree of attentiveness that is allegedly shown by those involved, including the end consumers (patients), when comparing two pharmaceutical products (and their marks). What never appears to

be part of the global assessment in these Class 5 cases is that first the goods involved are poisons and second that many of the likely consumers will be old and forgetful and, in almost every case, ill. These factors should at least counterbalance the authorities' reliance on the “attentiveness” of doctors, etc.

For those who couldn't bring themselves to read the whole of this article, these marks were all found to be similar: *Solvo* and *Volvo* (*Volvo Trademark Holding v Elena Grebenshikova*, Class 9, General Court (T-434/07)), *Vinopoly* and *Monopoly* (*Hasbro v Lenip Business Management*, Classes 9 & 28, Opposition Division No. B1206044) and *Agile* and *Aygill's* (*Peek & Cloppenburg v Redfil*, Classes 18, 25 & 28, CFI (T-386/07)). By contrast these two were not: *Famoxin* and *Lanoxin* (*The Wellcome Foundation v SeroGenetics Institute*, Class 5, CFI (T-0493/07, T-26/08, T-27/08)) and *Esteve* and *Ester-E* (*Laboratorios Del Dr Esteve v The Ester C Company*, Class 5, CFI (T-230/07)).

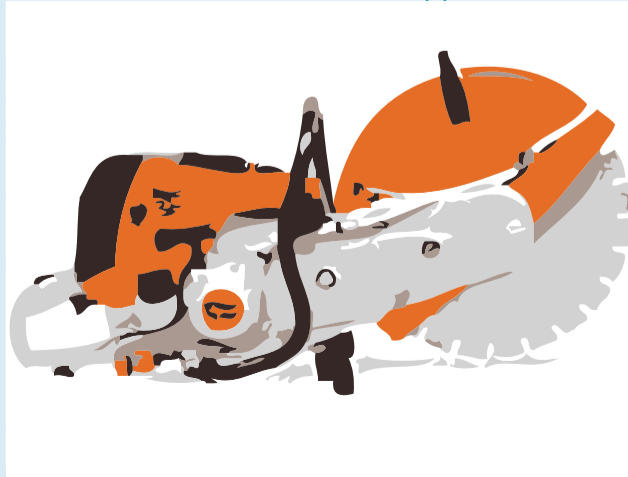
A recent OHIM decision involving a colour mark suggests that the registration of such trade marks is not the lost cause that was previously believed.

In this case, (*Andreas Stihl v OHIM*, R 355/2007-4), the OHIM Board of Appeal allowed an International trade mark application designating the CTM (no. 877450) to proceed on the basis of acquired distinctiveness. The mark applied for consisted of *an image of a power tool bearing the colours orange and grey* together with the following explanation:

“Colours claimed: Orange and grey. Partial: The colours orange and grey as applied to the goods; the colour orange is applied to the top of the housing of the goods and the colour grey is applied to the bottom of the housing of the goods; the dotted outline of the goods is intended to show the position of the mark and is not a part of the mark”.

The goods claimed were “Power tools, namely power operated cut-off machines”, that is, chainsaws.

The mark was rejected as non-distinctive and/or descriptive of the goods (Article 7(1) (b) and (c) of the CTM Regulation) by the CTM Examiner. Andreas Stihl appealed. In the



appeal, Stihl argued as follows in favour of the inherent registrability of the mark:

- The mark claimed was not a colour combination *per se* but a colour combination as applied to the goods.
- Colour *per se* can be inherently distinctive, particularly when the list of goods claimed is very restricted and the relevant market is very specific, as in the present case.
- The orange/grey combination was unusual for the products claimed and neither colour was a common warning colour aimed at protecting the relevant public against hazards.

Stihl also filed the following evidence of acquired distinctiveness:

- Evidence of the sale, turnover, market share, advertising and advertising spend for its chainsaws in every country of the EU.
- Testimonials from the Austrian Forestry Association, Austrian private forest owners, the German Federal Association of power-operated tools and four Danish and Spanish companies and associations, all attesting to the association of the orange/grey colour combination with Stihl.
- Market surveys conducted in France and Germany indicating about 60% and 70% association (respectively) of the claimed colour combination with Stihl.

The Board of Appeal maintained the original objections to the inherent registrability of the mark following the usual path that all marks are treated equally but some (colour marks, for example) are treated less equally than others. In relation to the non-trade mark uses of orange and grey, the Board commented that orange is used as a warning/safety colour (e.g. on traffic cones), whilst grey is associated with products made out of metal or plastic.

Turning to the evidence of use however, the Board decided that this was sufficient to overcome the Examiner's objections. The evidence of sales, turnover, market share and advertising, although not sufficient in themselves did demonstrate that Stihl was the market leader in the field and that the orange/grey combination was in use throughout the EU.

In addition, the French and German surveys both showed an impressive level of recognition by the relevant public. These surveys, when combined with the other evidence filed by the CTM applicant, led the Board to find that it was reasonable to

extrapolate the French and German level of recognition across the whole EU. On this basis, the objections raised under Articles 7(1)(b) and (c) of the CTM Regulation were waived and the CTM application was allowed to proceed.

This case gives some hope at least to those who are seeking to register non-traditional trade marks, such as colour or shape marks, as CTMs. It is still necessary to show a significant level of commercial activity throughout the EU (all 27 countries), but the willingness of the Board of Appeal to extrapolate market survey results in just two EU countries to the whole of the region is a welcome and, it is submitted, commercially sensible approach.

Having said all of this, the writer believes that the CTM Office raised the incorrect objection in this case. Under Article 4 of the CTM Regulation, a CTM must be “capable of being represented graphically”. In the case of *Ralf Sieckmann v OHIM* (C-273/00), the ECJ ruled that the equivalent provision of the Trade Marks Harmonisation Directive (89/104/EEC) should be interpreted as meaning that a properly, graphically represented trade mark must be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”. How can a mark, such as the above Stihl colour combination mark, in which the amount of colour present and the positioning of that colour are both unknown, be viewed as precise? The Stihl mark protects literally thousands of potential trade marks. In the writer’s view, such a mark should never be accepted as meeting the *Sieckmann* criteria. So whilst the Board of Appeal’s ruling in the *Stihl* case is welcome, the mark under consideration should have been rejected under Article 7(1)(a) of the CTM Regulation as an imprecise graphic representation.

In a decision (*JC AB v Jasper Conran*; Opposition No. B961070) that places a question mark over the extent of protection that will be accorded to certain letter trade marks, OHIM’s Opposition Division found that a *stylised form of the letters JC* was not confusingly similar to an earlier Swedish trade mark registration protecting the letters *JC* themselves.

In its decision, the Opposition Division found that the CTM applied for was a monogram and then, rather more controversially, that the precise nature of the monogram could not clearly be ascertained. For this reason, they found that the two marks had no visual similarities, that the later mark could not be pronounced and that therefore the



applicant’s and the opponent’s marks were dissimilar.

This decision is under appeal. However, if the Appeal Board also finds the monogram applied for to be illegible, the appeal is unlikely to succeed. It will be more interesting, however, if the Appeal Board finds, as it should, given the rather common font that is used in the opposed mark, that the later mark will be seen as a JC mark. In such circumstances, one might have thought that a finding of similarity might be inevitable. However, it is OHIM’s practice to give one and two letter marks a limited breadth of protection and so, even if the legibility of the CTM mark applied for is accepted, the opponent is by no means certain to win. An adverse outcome for the opponent would be in line with earlier OHIM decisions involving a comparison of letter marks, see, for example *Sincrostar v Maxime Monseur* (Appeal No. R342/2008-1) and *Agnes Trouble v Buttress* (Opposition No. B1159427).

Under Article 37(2) of the CTM Regulation (207/2009), the CTM Office has the power to require a CTM applicant to disclaim exclusive rights in a non-distinctive element of a mark. For reasons of administrative convenience, this power is not exercised by CTM examiners. This means that there are thousands of CTM registrations that contain non-distinctive elements that can be, and in some cases are, relied on to prevent the registration of later marks containing the identical non-distinctive element. See, for example, the OHIM appeal (*GS v Caserti Salvi*; R684/2003-2) in which the owner of a CTM for the non-distinctive phrase *Terre D’Italia* (in Italian, “The Land of Italy”) plus a device successfully opposed a later CTM for *Terre D’Italia* plus a completely different device. However, a recent decision of the Court of First Instance (*Technopol v OHIM*; T-425/07 and T-426/07) could represent a first step towards forcing a change in the Office’s disclaimer practice (or lack thereof).

The case involved two figurative trade marks, one of which contained the numeral 100, the other the numeral 300. The CTM applications had been refused by the CTM examiner as

non-distinctive/descriptive (Articles 7(1)(b) and (c), CTMR 207/2009) in respect of various forms of printed matter in Class 16 and puzzles in Class 28. The Polish applicant appealed. In a very welcome move, the Board of Appeal asked the applicant to disclaim exclusive rights in the numerals 100 and 300 before it would consider the appeals. This request was refused and, as a result, the Appeal Board dismissed both appeals.

Undeterred, Technopol appealed again, this time to the CFI, arguing that the numerals 100 and 300 were distinctive in respect of the Class 16 and 28 goods claimed and that, not surprisingly, OHIM had already accepted very similar figurative marks containing 100 and 200 for identical goods in the past (see CTM registrations nos. 3419322 and 3418845). The CFI dismissed the appeals.

In the Court’s view

- The figures 100 and 300 would be perceived by the consumer as a description of characteristics of the goods, for example as the number of pieces in a puzzle or the number of crosswords in a crossword book.
- If registration of the marks applied for were not made subject to any conditions, the impression might be given that the exclusive rights extended to the elements 100 and 300, thereby preventing them being used in other marks. Consequently, ... the inclusion of these signs in the marks applied for might give rise to doubts as to the scope of protection afforded to the marks.

These comments by the CFI could apply to thousands of existing CTM registrations. It is unlikely that this case on its own will cause OHIM to change its practice in respect of disclaimers. That will require severe criticism of the practice from the European Court in contentious proceedings in which a CTM owner is seeking to exercise rights in non-distinctive subject matter.

It has been clear from day one, however, what the Office’s practice should be in this area. First they should require disclaimers from CTM applicants in relation to non-distinctive/descriptive elements of marks applied for. Second, when the owner of such a CTM containing a disclaimed element seeks to exercise his rights, that element should be given no weight. Thus, in the *Terre D’Italia* case mentioned above, OHIM should have only accepted the earlier CTM with a disclaimer to the



phrase *Terre D'Italia*. The comparison with the later mark should then have ignored the presence of *Terre D'Italia* in both marks and a finding of no likelihood of confusion should have been made.

The CTM Office's practice in relation to geographical indications is to accept such indications as registrable trade marks unless the place is associated with the goods or services claimed or is likely to be associated with them in the future.

In *Mineralbrunnen Rhön-Sprudel v Schwarzbräu* (CFI, T-226/08), the registrability of *Alaska* in respect of Class 32 goods, including mineral water, was considered. In 1998 Schwarzbräu had obtained a CTM registration for the word *Alaska*. Three years later (in 2001), Mineralbrunnen sought to cancel the registration as non-distinctive, descriptive or deceptive of the goods claimed.

The Cancellation Division rejected the action and, with it, all of Mineralbrunnen's arguments. On appeal, the Board of Appeal also found the registration to be valid, given that, according to the Board, the average EU consumer would not associate *Alaska* with the production of mineral water. On further appeal to the CFI, the court ruled that, although place names are quite often used as brands for water products, and there was some association of *Alaska* with the production of such products, the relevant EU public would not have thought in 1998, when Schwarzbräu's CTM was registered, that water was exported from Alaska to the EU.

This case has been appealed again to the ECJ. Given the difficulty of proving the position in 1998, this appeal may also fail. However, it is submitted that, even in 1998, it was reasonably foreseeable that mineral water would be produced in and exported from Alaska. Certainly a search of the internet for "Alaska(n) water" now produces numerous websites for companies that produce or sell such Alaskan-produced mineral water. It is therefore submitted that it should now be possible to cancel Schwarzbräu's CTM registration, in so far as it claims water products, on the basis that *Alaska* has become the common name in the trade for mineral water or, if used in relation to mineral water that is not sourced from Alaska, it is liable to mislead the public (Articles 51(1)(b) and (c) CTMR).

The Carlyle is an exclusive hotel situated in New York. Since its opening in 1930 it has seen numerous famous men and women pass through its doors. Every US president from Truman to Clinton, for example, has stayed there. In spite of, or perhaps because of, such high profile guests, however, the hotel has a reputation for discretion, being referred to as a "Palace of Secrets" by The New York Times.

The Carlyle, LLC owned a UK trade mark registration for *The Carlyle* covering "hotel, restaurant, cabaret, cocktail lounge, banquet facilities and health spa services" in Class 42. An Austrian company, Mascha & Regner Consulting, applied to revoke this registration on the ground of five years non-use.

The ultimate owner of the New York hotel, Rosewood Hotels & Resorts, filed the following evidence in the form of a Witness Statement completed by its Vice President and Secretary:

- The number of UK residents who had stayed at the hotel during the relevant period and the revenue from those guests;
- The existence of a London sales office, run by Rosewood, through which bookings at *The Carlyle* could be made, as well as pre-payment for hotel stays;
- Dealings between Rosewood's London sales office and UK tour operators and travel agents leading to the latter offering stays at *The Carlyle* hotel;
- A book launch of an illustrated history of the hotel organised by Rosewood's London sales office;
- A toll free number for the UK through which reservations at Rosewood hotels, including *The Carlyle* could be made;
- Rosewood's website, www.rosewoodhotels.com, through which reservations at *The Carlyle* could be made;
- Numerous articles in major UK newspapers and magazines about, or featuring, the New York hotel.

The registered proprietor argued that the marketing and advertising of *The Carlyle* hotel in the UK was enough to establish genuine use of the mark in this country in relation to the Class 42 services protected. It was also argued that the proprietor had provided "hotel reservation, booking and information services" and that these were a sub-category of "hotel services".

The Hearing Officer was not convinced and revoked the registration. She found that no evidence of marketing or advertising *The Carlyle* hotel had been established in the UK and so she saved herself from having

to decide the tricky question whether such services alone would constitute genuine use of *The Carlyle* in the UK in respect of hotel services. She also refused to consider the "hotel reservation" etc point, since she decided that this had been raised for the first time at the Hearing and the applicant to revoke had had no prior notice of it.

In the *Extreme* trade mark case (2008 RPC 2), Mr Arnold QC, sitting as the Appointed Person, said that "Whilst a bare assertion of use would not suffice as evidence of use, a statement by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark had been used would not constitute bare assertion". As this appears to have been the nature of the evidence put forward by *The Carlyle* hotel, it is perhaps no surprise that this decision is under appeal to the High Court.

The applicant to revoke, Mascha & Regner, owns a CTM application for *Carlyle* covering *inter alia* "providing temporary accommodation". If they prevail in these UK revocation proceedings, as well as in related CTM revocation proceedings, they are likely to obtain a CTM registration which, in principle at least, they could use to seek to prevent all marketing, advertising and reservation activities for *The Carlyle* hotel in the European Union. Given that such activities have been conducted for decades, the stakes in this particular trade mark battle are undoubtedly high.

What rights do the successors have in the name of a famous dead person in the UK? The answer, both from earlier cases such as *Elvis Presley* (1999 RPC 567) and from more recent cases, such as *Manders Paints v The Picasso Estate*, is very few.

Manders Paints applied to register the trade mark *Picasso* for paints and similar products in Class 2. The Picasso Estate opposed the application based on

- Bad faith (Section 3(6) of the 1994 Trade Marks Act);
- An earlier CTM registration for *Picasso* covering vehicles and similar, together with their reputation in that mark in relation to those goods (Section 5(3));
- Their use of the trade marks *Picasso* (word and stylised) in relation to motor vehicles (Section 5(4)(a)). The stylised version of the mark being in the form of Pablo Picasso's signature.

- The well-known nature of *Picasso* as a trade mark (Section 56).

The opponent filed evidence attesting to the fame of Pablo Picasso as an artist, as well as their significant use of and reputation in the trade mark *Picasso* (both word and signature) in relation to motor vehicles. They also provided evidence of widespread licensing activities which allowed third parties to use the name *Picasso* and the artist's works in relation to a broad range of goods, though not including paints. Finally, they showed that the applicant was using *Picasso* as a brand of paint and in a stylised form that was very similar to the artist's signature.

In response, Manders referred to their earlier successful non-use revocation action of a UK trade mark registration for *Picasso* in Class 2; this revoked UK trade mark registration being owned by a member of the artist's family. Manders also showed that the names of famous dead artists, such as Matisse, Renoir and Whistler, were registered as trade marks in relation to paints and similar goods by unconnected third parties.

The Hearing Officer rejected the opposition on the following basis:

- Even though he accepted that the opponent had established a reputation in *Picasso* as a trade mark in relation to motor vehicles, he decided that, because of the repute of Pablo Picasso as an artist, the relevant public would associate the name *Picasso* with the artist, rather than the motor vehicle. Further, although the owners of motor vehicles did on occasion purchase motor vehicle repair paints, these goods were not in competition or complementary. Thus, the relevant consumer would not make the necessary link between the applicant's and the opponent's goods and the Section 5(3) ground of opposition was rejected.
- On a similar basis, the Hearing Officer decided that the passing off ground of opposition (Section 5(4)(a)) also failed. The opponent had produced no evidence to show that specific car models (such as *Picasso*) and vehicle paints shared the same trade mark. The use of *Picasso* by the applicant in respect of paints (and similar) would therefore not result in a misrepresentation, leading to the public believing that such paints were authorised by the Picasso Estate or to any damage of the opponent's trade in vehicles.

- Turning to the question of bad faith (Section 3(6)), the Hearing Officer was not persuaded by the evidence before him that Manders had acted in bad faith. In the Hearing Officer's view, it was fair for the applicant to conclude, in the absence of information illustrating the opponent's commercial rights in the name *Picasso* in respect of Class 2 goods, that it was free to apply to register that mark for those goods in the UK.
- Finally, the Hearing Officer, following the findings in the *Elvis Presley* case (a name unique to a particular person does not, of itself, have distinctive character as a trade mark), decided that *Picasso* was not well-known as a trade mark in the UK. He therefore rejected the Section 56 ground of opposition.

The owners of the Picasso Estate have fought a heroic battle seeking to maintain a trade mark monopoly in the name in the EU. Further, there is no doubt that, given the commercial exploitation of the name, both before and after the artist's death, the name *Picasso* is more likely to be viewed as a brand than most other artists' names. However, cracks are now starting to appear in the walls protecting the Estate's interests. Three out of ten CTM registrations for *Picasso* marks are now owned by third parties, whilst six out of eight UK trade mark registrations are in the hands of others.

If the writer were advising the Estate, he would recommend filing CTM applications for *Pablo Picasso*, *Picasso* and the *Picasso* signature in all forty five classes. He would then fight the inevitable oppositions and see what protection he obtained from the wreckage. He would continue to oppose all third party owned trade mark applications for *Picasso* marks. He would diarise the dates when the existing third party owned trade mark registrations became vulnerable to non-use revocation and attack them as soon as the relevant dates were reached. In about four years' time, he would file new CTM applications for the names and signature, again in all forty-five classes. This aggressive trade mark policy would be combined with an equally aggressive licensing exercise which would aim to licence registered trade mark rights rather than unregistered rights. It would take time, but with sufficient funds and determination, it should be possible for the Estate to regain commercial exclusivity in the artist's names in the EU, well before

the copyright in his artistic works runs out.

Since its first broadcast in December 1960, *Coronation Street* has been, and remains, one of the most popular soap operas on British television. As in most British soap operas, much of the action takes place in the fictional public house, the *Rover's Return*, which has always sold the equally fictional *Newton & Ridley* beer.



Not surprisingly therefore, when the all-too-real *Newton & Ridley* Beer

Company applied to register the trade mark *Newton & Ridley* for beer and similar goods in Class 32, the application was opposed on a number of grounds by ITV Studios, the broadcaster of *Coronation Street*. One of the grounds (Section 5(4)(a) of the Trade Marks Act 1994) claimed that the applicant's use of the mark applied for would pass off their Class 32 goods as those of the opponent.

The Hearing Officer, on the evidence before him, decided that the opponent had established goodwill in the phrase *Newton & Ridley* in relation to entertainment services, though not in respect of beer or other Class 32 goods. Further, even though the trade mark applicant and the opponent did not operate in common fields of activity, the Hearing Officer was prepared to accept that the use of *Newton & Ridley* by the applicant would constitute a misrepresentation since many beer consumers would assume that the producer of such beer had been licensed by the maker of *Coronation Street*. Finally, the Hearing Officer accepted that the registration of the mark by *Newton & Ridley* Beer would damage ITV's goodwill because

- In view of restrictions on product placement in tv programmes, the use of the trade mark *Newton & Ridley* by the trade mark applicant would force ITV to give the fictional beer a much less prominent position in the programme and this would eventually lead to a total loss of its goodwill; and
- The applicant's registration of *Newton & Ridley* would deprive ITV of future licensing opportunities for its fictional beer (should the restrictions on product placement be lifted).

It followed for these reasons that the opposition based on Section 5(4)(a) of the Act succeeded.



Ernst August Prinz von Hannover Herzog zu Braunschweig und Lüneberg applied to register his coat

of arms as a CTM in a wide variety of classes (CTM application no. 5627245).

Unfortunately for the Prinz, the British royal family has more than a hint of German blood coursing through their veins, not least from the House of Hanover (four Georges and one William) that reigned from 1714 to 1837. This meant that the Prinz's coat of arms, apart from the inscription *Suscipere et Finire* (Latin for To Undertake and To Accomplish) which replaced the royal emblem's *Dieu Et Mon Droit*, bore a striking resemblance to the British coat of arms.

As a consequence, the OHIM examiner raised an objection to the CTM mark based on its proximity to the protected royal emblem (Article 7(1)(h) CTMR). This objection was sustained by the Board of Appeal (R1361/2008-1).

Given that the Prinz's claim to the British throne, let alone the Hanoverian coat of arms, is probably stronger than that of Prince Charles, it is no surprise to learn that he has appealed the Board's decision to the European Court.

We spend our whole lives differentiating between different people who have different, in some cases only slightly different, names. Yet when it comes to trade marks that consist of names, the authorities, both at OHIM and in the European Court, assume that it is beyond us to distinguish between such names. This odd assumption was confirmed in a recent judgment (*Rahmi Özdemir v Aktieselskabet; T-11/09*) of the General Court.

The CTM application was for the trade mark *James Jones* in Class 25. It was opposed on the basis *inter alia* of an earlier CTM registration for *Jack & Jones* covering identical goods. The Court confirmed the similarity between the two marks that had also been found by the Opposition Division and the Appeal Board. Here is a flavour of the Court's reasoning:

- The differences between Jack and James and the absence of an ampersand in the CTM applied for were not enough to avoid a conclusion of visual similarity;
- The words Jack and James have a certain phonetic similarity, given the fact that they both begin with the "dj" sound and

are both monosyllabic. Further, the word "and" (or equivalent) is commonly used and will not be very striking phonetically. It followed that there was a phonetic similarity.

- Consumers might interpret the two marks at issue as referring to the same person... the presence of the ampersand did not exclude all conceptual similarity between the signs.

Instead of picking every letter and syllable of these two marks apart for analysis, might the writer suggest that they are considered as a whole. One is a full name of a single person (James Jones), the other will be seen as the surnames (or possibly first name and surname) of two people. This fact alone should be enough to allow consumers who, on the whole, are quite sophisticated when it comes to purchasing clothing (or footwear or headgear), to distinguish clearly between the two marks.

Further, although it does not appear to have been an issue raised in these proceedings, Jones is a very common surname in the English (or Welsh) speaking world. This fact is evidenced by numerous names containing Jones being registered as CTMs in Class 25. See, for example, *Devon & Jones, Bullock & Jones, Crockett & Jones, Indiana Jones, Indigo Jones, Joyce Jones (& Device), Tom Jones, Catherine Zeta-Jones, Bobby Jones*, the list goes on. The writer is aware that this fact alone is not persuasive when considering the weight to be given Jones in the two marks at issue above (although, in his opinion, it should be). However, it is submitted that it is a clear pointer towards the fact that the owners of these marks believe that they can coexist, both on the register and in the market, without any likelihood of confusion.

It is simply not understood, why in the absence of a reputation acquired through significant use of a name mark (for example, *Calvin Klein*, where a link with a later Klein name mark could be imagined), the authorities believe that the consuming public who, in their private lives, are perfectly capable of distinguishing between two names with a common element, mysteriously lose that ability when they enter a shop.

If you register an unusual bottle shape as a CTM what breadth of protection will you receive against competitors? Extremely narrow appears to be the answer judging by the European Court's decision in *Weldebräu v Kofola Holding (T-24/08)*.

Kofola applied to register (CTM 3367539) *the shape of a transparent*

glass bottle having a helical-shaped neck and the (almost illegible) word snipp at the bottom of the bottle in Classes 30, 32 & 33. Weldebräu opposed the CTM application based on their earlier CTM registration (no. 690016) for *a green glass bottle also having a helical-shaped neck* protecting goods in Classes 21, 32 and 33.

The opposition was rejected by both the Opposition Division and the Board of Appeal, given the visual differences between the two bottle shapes. Weldebräu appealed to the General Court.

The General Court confirmed the earlier decisions. In the Court's view no phonetic or conceptual comparison between the marks was possible, the latter point being agreed by the opponent. The Court therefore concluded that the comparison was purely visual. On that basis, given the differences in the height, width and colour of the two bottles, a lack of visual similarity was found.

The writer disagrees with the conclusion that no conceptual comparison could be made between these two marks. Both bottles had helical-shaped necks, a shape that appears to be highly unusual in the trade. Surely a bottle with a spiral neck is a "concept", in which case both marks are conceptually identical.

In spite of this, it is also true that the two bottle shapes are visually quite dissimilar and it is therefore understandable, on the basis of the evidence (or lack of evidence) that was filed by the opponent, why all three Tribunals rejected this opposition.

If it is true, as Weldebräu maintains, that their helical-shaped bottle neck was, until Kofola appeared, unique, then they should have done far more to maintain their monopoly in this shape by emphasising its unique nature (and unique source) in its advertising and on its packaging. Nothing of this nature appears to have been filed by the opponent in this opposition. If you develop a unique product shape and go to the trouble of producing it, then flaunt it in a manner that leads to instant recognition and immediate association with either a brand or the producer. Anything less will eventually lead to a loss of monopoly and, in the longer term, generic status.

If Nestlé can monopolise "a mint with a hole", then Weldebräu should have been able to monopolise "a bottle with a spiral". Unfortunately for Weldebräu it may now be too late.



HOLDING FIRE AT IPO

Douses Hopes in FIRECRAFT

If a competitor attacks your trademark registration, how seriously do you need to take the claim if it is not before the court? Very, according to the High Court recently in *William Evans & Anr. v Focal Point Fires Plc (FIRECRAFT)* ([2009] EWHC 2784 (Ch)). The ruling in *FIRECRAFT* significantly raises the status and effect of IPO decisions and demonstrates the serious commercial consequences that can lie in wait for those who fail to defend, or pursue, an IPO-level challenge as fully as though it were before the court. Following this decision, UK brand owners need to re-evaluate how they approach actions before the IPO.

One Little Spark

Ironically, this seminal ruling arose from a commercial dispute which was, for all practical purposes, over by the time the matter was heard.

The Defendant had been selling gas fires in the UK under the name FIRECRAFT since 2001. Before it began use, the Defendant had the mark professionally searched and found no obstacles. The Defendant secured a UK trademark registration for the mark in summer 2000. The Claimant, who had been selling stone fireplaces in the UK under the identical mark FIRECRAFT since 1991, applied to invalidate the Defendant's registration on the basis that the use of the mark was liable to be prevented under the law of passing off. In November 2008, the IPO declared the registration invalid and the Defendant did not appeal.

Although the Claimants threatened to bring passing off proceedings in court to secure an injunction and damages, the Defendant did not agree to cease use until May 2009, by which time proceedings had already been issued. The High Court therefore needed to rule only on whether there had been past acts of passing off such as to warrant damages and whether a *quia timet* injunction against future acts of passing off should be granted.

A Real Conflagration

The Defendant argued that in spite of the IPO ruling in the invalidation proceeding, the Claimant needed to prove its case on passing off before the Court. The Defendant contended that it now had better evidence than it had led before the IPO, which would prove that in fact there had been and would be no misrepresentation. It had refrained from leading that evidence earlier because IPO proceedings have traditionally not been fought out so painstakingly as court proceedings, not least because costs recovery before the IPO is, in most cases, so much lower.

In reply, the Claimants argued that the fundamental issue was whether the IPO's invalidity ruling was final and binding on the Court insofar as it involved a decision that the Defendant's use had been "liable to be prevented under the law of passing off." The Claimants asserted that it was, and that the Defendant's effort to force them to make their case all over again in court, with all the incumbent costs, was an abuse of process. The Claimants moreover argued that the Defendant was estopped from challenging the IPO decision on the passing off point, which had become final.

The Court sided strongly with the Claimants. In its view, the IPO decision on invalidity had required the hearing officer first to determine whether the Defendants' use amounted to passing off. The IPO was required to apply the same test as the Court, and the hearing officer had been satisfied that the Defendant's use would amount to a misrepresentation and that there would be resulting damage arising from confusion as well as a risk of tarnishment. The decision on passing off was essential to the decision on whether the registration was valid, and the mere fact that the IPO had no jurisdiction to award damages or an injunction did not mean that it did not enjoy a parallel jurisdiction with the Court in determining the essential issue of passing off on an invalidity claim.

Consequently, the IPO's decision on whether the Defendant's use would

amount to passing off had become final and created an issue estoppel, preventing the Defendant from forcing the Claimants to re-prove their case on the same issue in later proceedings. Further, there was a cause of action estoppel, in that the cause of action for passing off (although not the relief therefor) had already been determined by the IPO, who enjoyed a parallel jurisdiction with the Court on that point, and could not be re-litigated by either party once the determination had become final.

The Court was particularly scathing of the Defendant's failure to lead all its evidence in the IPO proceedings. The mere fact that the Claimants did not indicate, while the IPO proceedings were underway, that they intended to sue for relief before the Court was no excuse for not leading all relevant evidence while the issues were being determined by the IPO. *"This is precisely the kind of thing," the judge wrote, "which the Courts deplore. The Courts are anxious to ensure that all matters as far as possible are determined expeditiously and with one hearing. It would be quite wrong...to allow the Defendant to adduce more evidence in an attempt to reverse the Hearing Officer's un-appealed decision. In my view it would be... an abuse of the process..."*

Comment

The impact of this decision will be widely felt. It has already begun to make waves at the IPO, who almost immediately issued a practice notice indicating that in light of *FIRECRAFT*, parties and their representatives would now be required to attend hearings in invalidity proceedings based on relative grounds rather than allowing them to be decided on the basis of the papers.

Parties to IPO invalidity proceedings will have to count the costs. In *FIRECRAFT*, the parties racked up costs of over £100,000 each in (presumably the combination of) the original IPO action and the subsequent court action on the status and effect of the IPO ruling. In an ordinary IPO action, parties often run a low-key case because costs recovery is usually so low that they would never recover

anything approaching actual costs. However, institutionalised low costs recovery is increasingly at odds with the severity of the consequences for parties who fail to run a full case and defence at IPO level. The IPO is not *per se* a low-costs forum and parties treat it as such at their peril. Those who give IPO case preparation the care and attention it deserves should not be punished by the inability to recover costs at a level that reflects what the IPO expects parties to put into a case. Higher costs exposure, moreover, would better concentrate all parties' minds and contribute to the early resolution of cases that should not be litigated all the way to a decision.

Of course, where infringement actions are not already pending, potential invalidity claimants have the option whether to bring their action before the IPO or the High Court, and if they opt for the latter the normal court rules on costs will apply. The fact that costs exposure before the IPO is currently so much lower makes it a more attractive forum than the Court for would-be claimants who are not sure of the strength or commercial value of their case and who prefer not to run the risk of an adverse costs award in court.

Is that approach appropriate, though, where a trademark owner is actually passing off and causing damage to the goodwill owner? The IPO may be able to determine whether the use of a registered mark amounts to passing off, but it cannot order damages or an injunction. In *FIRECRAFT*, the Claimants obviously considered the Defendant's actions to be damaging but nonetheless brought the claim before the IPO first. Here, though, the parties' respective business spheres were one step removed. If they had been closer, then litigating the issue before the IPO first could have allowed serious losses to be multiplied. As IPO proceedings generally take longer than those before the Court, such increased losses could be severe even if the later application to the Court for relief were decided by summary judgment.

The effect of final IPO decisions in invalidity matters must also be contrasted with the effect of decisions in oppositions, which can only be brought before the IPO. The Court of

Appeal in *Special Effects* ([2007] RPC 15) found that in oppositions, IPO decisions were not final and conclusive such as to give rise to issue or cause of action estoppel preventing an unsuccessful opponent from re-running the same case in invalidity proceedings (or presumably, by analogy, in court proceedings for eg passing off) with better evidence. By the same token, an unsuccessful trademark applicant is entitled to expand on its failed opposition defence in any subsequent infringement or passing off claim before the Court, in an effort at least to save its ability to use a mark.

The recent *KINDERJOGHURT* case before the General Court indicates that much the same principle applies before OHIM: an unsuccessful opponent who does not appeal can apply for invalidity later, with more and better evidence. However, it is important to note that bringing a subsequent action that should not have been necessary had the case been prepared properly the first time, or with the intention of harassing another party into incurring costs in re-litigating issues, may amount to an abuse of process.

So it is that a small fire, doused before the High Court even turned to it, has resulted in a decision that bristles with implications for others. Recognising that IPO proceedings merit full and careful case preparation will help parties obviate the risk, as will watch services that allow them to mount first-instance challenges through opposition rather than invalidation. However, for its part, the IPO will need, in this writer's view, to recognise the growing status and effect of its decisions, and to bring its costs rules more into line with the reality for parties.

DOWN IN ONE

as VODKAT Held Passing Off

In a recent case concerning vodka, the High Court re-examined the law of extended passing off in relation to product types. In *VODKAT (Diageo North America, Inc (and Anr) v Intercontinental Brands (ICB) Ltd. (and Ors) [2010] EWHC 17 (Ch)*, the Court developed themes from earlier passing off cases involving the names “champagne” and “advocaat,” and confronted interesting points about when extended passing off can occur, and the type of party that may claim it.

Mixed Drinks

In this case, the well-known alcoholic drinks purveyor, Diageo, brought an action against Intercontinental Brands to prevent the sale of a vodka-based drink called “VODKAT,” on the basis that it passed itself off not as one of Diageo’s own branded products, but rather as real vodka, when in fact it was not.

In *VODKAT*, the term “vodka” was held to describe a clearly defined class of goods, regulated since 1989 by European legislation. Under it, vodka must contain a minimum of 37.5% alcohol by volume (ABV), and is formally defined as “a spirit drink produced by either rectifying ethyl alcohol of agricultural origin or filtering it through activated charcoal...”, or as “a spirit drink produced from ethyl alcohol of agricultural origin obtained following fermentation with yeast from either potatoes and/or cereals, or other agricultural raw materials”.

In contrast with this, Intercontinental’s VODKAT product was a mere 22% ABV, and was classified as “other fermented beverage”. Due to its lower ABV, the duty payable on the VODKAT product was considerably lower (£2.85 per litre) than would have been the case for vodka (£8.49

per litre). Unsurprisingly, therefore, the VODKAT product was a hit with shoppers and public houses looking to save money on their tipple.

Diageo claimed that the use of VODKAT was misleading, but in order to get its passing off action off the ground it needed to prove that it owned protectable goodwill in the descriptive term “vodka.” As “vodka” was a clearly defined product, the question was then whether vodka had a reputation which gave rise to goodwill amongst a significant section of the public, and whether Diageo was entitled to bring an action based on that goodwill. The Court found that there was a protectable goodwill in the descriptive term “vodka” because it related to a clearly defined class of goods, namely vodka, and that Diageo, as a vodka manufacturer, was entitled to bring the action on the basis of



its substantial sales of various brands of vodka, including the SMIRNOFF brand.

It is important to bear in mind here that the level of “goodwill” required to allow an action for passing off to be brought is different from the concept of “reputation.” The judge made it clear that goodwill did not need to be in products having a high quality, but rather must be in respect of a “clearly defined class of goods”.

Bottoms Up

Having decided that Diageo was entitled to sue, the next point for the judge was whether the use of VODKAT for a vodka-based product that was not in fact vodka was a misrepresentation on the part of the Defendant. Here, Diageo’s case was assisted by the get-up used by the Defendant on its labels, which were seen as attempting to give a “Russian” or “Eastern European” feel to the product. As the research showed that the average consumer associated vodka with Russia or Eastern European countries, the imagery reinforced the idea that the consumer would have as to the type of product being offered.

This was reinforced by evidence that in many shops, VODKAT was sold on shelves with other genuine vodka products, although due to the much lower rate of duty payable, was considerably cheaper per litre to purchase. The evidence showed that there was widespread confusion about the nature of the product, not only among consumers, but also among retailers.

The final requirement for a finding of passing off is for damage to have occurred. In this case, there was evidence that VODKAT had been used in pubs and

Down in One... continued

bars for “house doubles”, the practice of selling a double measure of a cheaper spirit at a lower price than would have been the case for a branded spirit. The evidence showed that VODKAT had been used by pubs as the “house spirit” vodka, and thus had potentially taken sales from Diageo and its SMIRNOFF brand. The judge decided that even if there had been no evidence of lost sales, the use of the VODKAT term was likely to “erode the distinctiveness of the term ‘vodka,’” and therefore found in Diageo’s favour.

Comment

This case is an important development in the law of “non-traditional” passing off.

In earlier, similar cases (such as those involving the terms “champagne” and “advocaat”), there seemed to be an assumption that when a product was alleged to have been passed off as a particular type of product, some “reputation” in the sense of high quality or exclusiveness was required, rather than merely “goodwill” in a product descriptor.

However, *VODKAT* shows that the test is not one of reputation or quality, but rather whether a descriptive product type name is used for a “clearly defined class of goods,” such that the defendant’s use of it for some other type of product would amount to a misrepresentation.

VODKAT is a salient reminder that competitors may take market share not only by using identical or similar brand names, but also by producing and selling similar, but not identical, products cheaper. Often this is legitimate, but where the public is misled by the inappropriate use of a product name, it is not. Diageo’s success in *VODKAT* is proof positive that vigilance against both types of unfair competition can pay off.

BEGINNING OF THE END FOR SERIES MARKS

One of the great unsung benefits of filing a UK trademark, as opposed to a CTM, was always the series provision. Under it, an applicant could file for a series of marks “not differing from each other in their material particulars,” without additional cost. The provision enabled businesses to protect, in a single filing, a number of marks that were essentially the same but differed in minor respects during use.

Where marks of uncertain registrability were concerned, however, the series provision offered another advantage: it enabled applicants to file for a mark on its own, and with other distinctive matter, in a single application without additional cost. Such marks would not form a true series and would not be allowed to proceed to registration. However, they would be examined, and on the basis of that an applicant could decide which marks to delete or divide out into separate applications, without losing the original filing date, and without the expense of multiple application fees at the outset for marks that might ultimately be rejected as non-distinctive or descriptive.

OHIM has never offered anything comparable, and for businesses with specific interests in the UK, the UK-IPO practice on series marks was practical and highly cost-effective, both for true series marks and for marks of borderline registrability, where a budget-friendly filing strategy with a built-in fallback was needed.

In October 2009, however, the series marks provision was amended and the new rules severely limit its usefulness. In particular, no more than 6 marks will be permitted in any given series; an additional fee of £50 will apply to every mark in the series beyond two, without the possibility of refund if marks are later dropped; and finally, most notably, it will no longer be possible to divide marks out from a series into separate applications. Marks that are not accepted or not regarded as forming part of a true series can only be deleted. They can be re-filed but will not bear the original filing date, as they would in a divisional.

Comment

Although the IP profession in the UK was consulted on other changes introduced last autumn, the alterations to the series practice came as a surprise.

The IPO may have been motivated in part by the impression that some users abused the system by filing excessively high numbers of marks in a series. Each mark in a series must be examined and the absence of corresponding remuneration in the form of further filing fees meant that the use of examiner resources was out of proportion to the fees being paid for them. However, the abolition of the ability to divide marks out from a series into separate applications retaining the original filing date seems a draconian response, when the introduction of a more substantial per-mark supplemental fee would arguably have achieved the same objective.

Whether marks form a true series is often arguable and under the new practice, many who legitimately seek to protect what they regard as a true series will lose the original filing date for rejected marks if the examiner disagrees. Such applicants will have to re-file fresh applications for any marks rejected from the series without any chance of obtaining a refund of the additional series uplift. The need for such further filings is an additional burden on industry at a time when budgets are already constrained, and discourages trademark filings at a time when building and protecting strong IP rights to keep competitors off the grass is at its most important.

At a stroke, therefore, the UK-IPO has discarded a practice that not only greatly benefited its customers, but which enhanced its attractiveness and competitiveness as an alternative to OHIM for businesses with specific interests in the UK. Given OHIM’s own aggressive fee reductions last spring, the UK-IPO needs all the help it can get. The series changes run counter to this; time will tell whether they translate into a competitive edge for OHIM in relation to applicants with interests in the UK.

IPO Clarifies Hearsay Rules

In a U.K. opposition, your adversary files in evidence letters addressed “To Whom It May Concern.” The letters were clearly solicited for the proceedings and you suspect that they were drafted by your adversary’s advisors, and are not the authors’ own words. Do the IPO’s hearsay rules offer an effective way to challenge admissibility or weight?

The admissibility and status of such letters were the focus of a recent decision by the Appointed Person in an appeal on a revocation matter (*DUCCIO Trademark*, BL O343-09). As a result, the IPO issued a notice clarifying its practice in relation to hearsay evidence and giving useful guidance for those who have to rely on it, assess its weight, or seek to draw out its weaknesses.

“To Whom It May Concern” Letters

In *DUCCIO*, the registered proprietor sought to rely on four letters addressed “To Whom It May Concern” that had clearly been solicited for the proceedings. These letters were hearsay, since the authors did not give direct evidence in the form of a witness statement, statutory declaration or affidavit. Under Rule 64 (1) (a) and (b) TMR 2008, evidence in IPO proceedings may be given by way of witness statement, statutory declaration or affidavit, or in any other form that would be admissible as evidence before the court.

Under S. 1 of the Civil Evidence Act 1995, hearsay evidence is admissible before the court. S. 4 CEA 1995 sets out various considerations relevant to assessing its weight, though, including whether the maker of the statement could reasonably and practicably have been called as a witness, how contemporaneous the hearsay was to the relevant matters, whether there was multiple hearsay, whether there was any motive to conceal or misrepresent, whether the hearsay statement was edited or made in

collaboration or for a particular purpose, and whether circumstances suggested an attempt to prevent proper evaluation of its weight.

The IPO’s practice on the admissibility and weighting of hearsay evidence in the form of “To Whom It May Concern” letters was set out in Tribunal Practice Notice 1/2008. Despite its acknowledgment of the provisions of the CEA, the TPN invited the conclusion that such evidence, was in general, to be accorded little weight because of the lack of attestation.

At first instance in *DUCCIO*, the hearing officer made some general observations about the “To Whom It May Concern” letters without making it clear exactly what weight he was according to them.

Consequently, on appeal, the Appointed Person decided (for this and other reasons) to remit the case back to a different hearing officer for reconsideration.

The Practice, Amended

The Appointed Person also took the opportunity, however, to comment on the ambiguity of TPN 1/2008 and on the fact that hearsay evidence should, in line with the practice of the courts, be weighed in the context of the evidence as a whole. As a result, the IPO re-issued its TPN under new number 5/2009, clarifying this. The new practice listed the relevant considerations from the CEA for determining the weight to accord to such evidence, but added some further specific guidance on “To Whom It May Concern” letters.

In particular, the TPN states that such letters can be filed as attachments to witness statements, statutory declarations or affidavits by the authors of the letters, in which case the letters are no longer hearsay, but rather direct evidence. Alternatively, they can be filed as attachments to witness statements,

statutory declarations or affidavits by the party seeking to rely on them, in which case they will be hearsay.

Where such letters are filed as hearsay, the IPO will assess their weight based on the factors set out in S. 4 CEA 1995, and the weight accorded will not be reduced simply because the evidence is hearsay. However, it may be reduced if, for example, the statement was made some time after the relevant event, when the same statement made in a signed witness statement, statutory declaration or affidavit would have been given more weight. Indeed, some hearsay statements may be given no weight at all if, for example, there is reason to suspect a motive to conceal or misrepresent matters.

The TPN advises parties to ensure that all evidence on which they rely is as far as possible direct evidence in attested form to ensure that it is accorded the weight that the party relying on it considers it to deserve.

Comment

Although *DUCCIO* included a direct criticism of the hearing officer’s failure to consider the “To Whom It May Concern” letters in the overall context of the evidence, the need to do that should go without saying. For example, it is a relevant question whether the hearsay letters are supported by other evidence, and if they are they should be accorded greater weight.

The new TPN does, however, helpfully confirm that such letters remain admissible hearsay when filed as attachments to a witness statement, statutory declaration or affidavit made by the party relying on them, and clarifies the approach to assessing their weight by reference to the S. 4 CEA factors.

Such letters are never ideal as evidence and when they are filed, it is often because the party relying on them is unadvised or cannot persuade the makers of the statements to take part in the proceedings as witnesses.

However, such letters are readily spotted as having been created specially for the proceedings, often with the heavy guiding hand of the party or its advisors, and this in itself can be a factor affecting weight if the letter is submitted as hearsay rather than direct evidence. When such letters are in an adversary's arsenal, their credibility may well be open to challenge on this basis.

Drawing out other weaknesses, such as the passage of time between an event and the making of a statement relating to it, any multiple levels of hearsay, and whether in fact the author of the statement could reasonably have given direct evidence as a witness (which will often be the case unless the witness is dead or outside the jurisdiction), are also worthwhile angles at which to chisel.

In cases where a party has no option but to resort to "To Whom It May Concern" letters as evidence, it should ensure that its entire case does not rest on these. Such letters should support, and be supported by, other evidence, and be made by authors who are ostensibly reliable and well-informed about the matter in question, without any obvious motive to conceal or misrepresent the facts. Such letters must, moreover, be filed as attachments to a witness statement, statutory declaration or affidavit by the party relying on it. Even compliance with all of this does not guarantee the same level of persuasiveness as if the evidence were direct, but it does afford the best chance when hearsay must be filed.

Where reluctant trade witnesses or the like are involved, though, the best case will always be by way of direct evidence from known witnesses. The gentle persuasion needed to recruit and retain such witnesses is arguably some of the most useful advocacy of all.

The information contained within this Newsletter is not intended to provide an exhaustive or comprehensive statement of current law or practice. No reliance should be placed upon it as a basis for any legal action or commercial decision and for any individual case specialist professional advice should always be sought in order to determine the applicability of any relevant legislation.

OUT AND ABOUT

INTA ANNUAL MEETING

JENKINS HOSPITALITY SUITE May 23, 24 and 25

Stephen James, Hazel Buckley, Tim Pendered, Katie Cameron and Angela Fox will be hosting our annual hospitality suite at Boston's Four Seasons Hotel. To arrange a meeting with a member of our team, or for further event details, please email events@jenkins.eu

WHO	WHERE	WHEN
Felix Rummler Sascha Zieglmeier	Exhibiting at: MedTech Pharma Congress Nuremberg	June 30 - July 1, 2010
Katie Cameron	ITMA/CIPA Designs Practice Day London Katie will be speaking on filing design applications.	13 April 2010
	Geneva Group Annual Conference Madrid, Spain Katie will be speaking on trade marks, generally.	23 April 2010

For event enquiries please contact events@jenkins.eu

DESIGNS & COPYRIGHT

David Musker and Katie Cameron are running Designs & Copyright tutorials for trainees, and refresher courses for corporate in-house departments, this spring/summer in London. The tutorials cover:

- An overview of the applicable rights and how they intersect, interact and overlap;
- A review of ownership issues relevant to designs;
- A walk through some past exam papers.

If you are interested in attending a tutorial, please register your interest by emailing Katie at kcameron@jenkins.eu

JENKINS NEWS

NEW STARTERS

We are pleased to welcome new technical assistant, Eric Young, to our London office, Patents Department. Eric graduated from the University of Nottingham, with a Master in Science degree in Physics in 2009. During his MSci year, he worked with the University's School of Biomedical Sciences to develop algorithms for the analysis of abnormal neural activity, and was awarded the Tessella Prize for Best Final-Year Project involving Computing. He is particularly interested in Astrophysics and Particle Physics.

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