

Bird & Bird & BrandWrites

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Welcome to the seventh edition of BrandWrites by Bird & Bird

At Bird & Bird we're passionate about brands. BrandWrites by Bird & Bird is an international publication that explores topical legal and industry related brand news, featuring recent trade mark cases and key changes to the law, practical advice and commentary from respected brand owners. It features contributions from Bird & Bird's renowned IP team across Europe, Asia-Pacific and the Middle East.

We hope you enjoy it. We welcome questions, comments and suggestions, so please feel free to get in touch with Nick Aries (Editor and Bird & Bird Partner) at nick.aries@twobirds.com or Lorraine Tay (Bird & Bird Partner) at lorraine.tay@twobirds.com.

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What is required to prove acquired distinctiveness?



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In a landmark decision the German *Bundesgerichtshof* has provided guidance on the "dos" and "don'ts" of using surveys to demonstrate the acquired distinctiveness of trade marks. Owners of marks relying on acquired distinctiveness are advised to keep regular records of survey results and document evidence of the use and market perception of the mark in question in order to defend against cancellation attacks.

Background

The applicants in the case applied to cancel the colour *per se* mark "Sparkasse-Red" due to lack of distinctiveness. The court confirmed that, whilst the starting position was that colourless colour marks lacked distinctiveness, such marks could acquire distinctiveness if more than 50% of the relevant public identified the mark as denoting the source of the goods or services in respect of which the mark is registered. The court ultimately found that the "Sparkasse-Red" mark had acquired such distinctiveness.

Acquired distinctiveness and survey evidence

A feature of the proceedings was the high number of surveys submitted by the parties as evidence for (and against) acquired distinctiveness. The court endorsed surveys as being its preferred evidence of acquired distinctiveness, at least for colour *per se* or product shape marks. The court nonetheless emphasised the importance of market and use-related evidence in assessing the acquired distinctiveness. In conducting its assessment the court applied the so called

"Chiemsee" criteria¹, taking into account the duration, territory, extent, market share and advertising volume of the mark in question.

In reaching its decision the court provided useful guidance on the appropriate methodology and wording of surveys on acquired distinctiveness in Germany.

The court confirmed that a three-stage test should be used. The first stage concerns awareness, the correct question being whether the respondent has seen the sign in connection with the product/service before or not. The second stage concerns recognition of the sign as a trade mark, the correct question being whether, in connection with the product/service, the sign indicates to the respondent a specific undertaking or several undertakings (or no undertaking at all). The third stage is about identifying of the name of the brand owner. Acquired distinctiveness is then assessed by looking at the number of respondents who recognised the sign as a trade mark and deducting those who gave the wrong name at stage three. The Court also gave guidance on the correct

¹ *Windsurfing Chiemsee Produktions-und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber (C-108/97)*

formulation of the first stage question, and how to deal with respondents who answer "several undertakings" at stage two.

Trade mark applicants, trade mark holders and cancellation applicants now have a far better understanding of what will be accepted as a reliable survey in Germany, which will bring a higher degree of legal certainty.

Support for 3D product shape marks and other non-traditional marks

Colour and product shape marks share a common characteristic: consumers do not perceive them in isolation but regularly in conjunction with other elements or marks. It is encouraging that the *Bundesgerichtshof* criticised, even in relation to a colour, the imposing of overly strict requirements on what will constitute acquired distinctiveness.

This position contrasts with the English High Court judgment in the "KitKat" 'four-finger' shape trade mark case (currently under appeal).

In the "KitKat" case the Court was prepared to accept that consumers associated the shape of the goods with the "KitKat" brand (and thus with Nestlé), but did not accept that consumers went so far as to rely on the shape to identify the origin of the goods. Holders of non-traditional trade marks will likely welcome the support provided in the Sparkasse case.



OzEmite Spreads Thick

The Federal Court of Australia recently overturned a decision of the Trade Marks Office to remove OZEMITE from the Trade Marks Register on the basis of non-use. The Court decided that use of a trade mark can include promoting a product before it is available for purchase. The outcome is encouraging for traders with a registered trade mark that face a long lead-up time to launch.



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'Concentrated yeast extract' may sound unpleasant - but it's truly delicious. In Australia, VEGEMITE is the most famous kind, but other brands include MARMITE, OZEMITE and AUSSIE MITE.

In 1999, businessman Mr Dick Smith coined the term OZEMITE for an all-Australian concentrated yeast extract. After registering OZEMITE as a trade mark, Mr Smith took the brand to the media, spreading the word (excuse the pun) that 'a new yeast extract was in town'. However, supply setbacks meant OZEMITE was not available for purchase until 2012.

In 2001, Mr Roger Ramsay began selling a concentrated yeast extract product called AUSSIE MITE. In 2011, Mr Ramsay successfully applied to have OZEMITE removed from the Register on the basis of "non-use". This decision was appealed to the Federal Court of Australia, which overturned the original decision.

Mr Ramsay argued that use means an "occasion of trade" in respect of "vendible articles", meaning there must be "at least a single act of sale". Given the first jar of OZEMITE was not sold until 2012, Mr Ramsey argued that OZEMITE should be removed.

The Court did not agree. Justice Katzmann stated that "vendible" does not mean sold, rather it means "capable of being sold" and that the very definition of a trade mark is "a sign used or *intended to be used*, to distinguish goods...". Justice Katzmann held that there was a genuine intention to use OZEMITE and the marketing expenditure and promotional efforts demonstrated this.

Supply setbacks should not mean that the trade mark had not been put to "genuine use". If "a single act of sale" were indeed the relevant test, it would leave traders who put goods on the market but fail to make a sale vulnerable to having their marks removed.



All in the name of business

This High Court decision should encourage owners of eponymous brands to think carefully about the possible implications of contractual provisions restricting use of their name if they wish to use it as a brand in the future.



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After starting her fashion business in 1983, Karen Millen subsequently sold it in 2004 under a share purchase agreement (SPA). The SPA contained various restrictive covenants concerning her use of the KAREN MILLEN brand throughout the world, amongst which was an undertaking not to use the name "Karen Millen", or any other name confusingly similar to it, in connection with any similar or competing business anywhere in the world.

In 2011, Millen declared an interest to re-enter the fashion business, prompting the purchasers of the KAREN MILLEN brand to bring proceedings against her. In the most recent of a series of cases between the parties, Millen sought declarations from the Court that her proposed ventures in the United States and China, trading under KAREN MILLEN for homewares and KAREN for any goods and services (including fashion and accessories), would not breach the restrictions in the SPA. It was noted that in carefully trimming the name in this way, Millen was seeking to avoid the purchasers' rights by the narrowest possible margin (though the Court saw this as an astute strategy rather than reckless or dishonest conduct).

The Court considered that the two limbs of the restrictive covenant (confusingly similar name and similar or competing business) had to be considered together, and in context.

To use a confusingly similar name in respect of a competing business would be to misuse the goodwill in the KAREN MILLEN brand, and therefore Millen would be in breach of the SPA if her proposed business would cause confusion which would be detrimental to the goodwill in the KAREN MILLEN brand.

The Court held that use of the KAREN MILLEN name for homewares was likely to confuse customers, not least since these were a type of goods into which fashion brands often branched out. A purchaser of a KAREN MILLEN rug may well believe that it came from the same source as KAREN MILLEN clothing they had purchased previously.

In relation to the activities under the KAREN name, the Court noted that the scope of the declaration sought by Millen was extremely broad. If granted, it might lead to use of the name in Millen's store on clothing, alongside use of the KAREN MILLEN name on homewares, in close physical proximity to the counterparty's stores, in which clothes were be sold under the KAREN MILLEN name. When combined, these factors were likely to produce confusion on the part of consumers, and therefore placed Millen in breach of the SPA.

This decision and other recent decisions such as *Merck KGaA v Merck Sharp and Dohme Corp* provide a useful reminder to brand owners that it is important to consider long-term implications of contractual provisions which restrict brand use when negotiating IP-related agreements such as co-existence agreements.



Forum-shopping in trade mark infringement cases?

The question of where to bring a trade mark infringement claim – in the Court of the place where the infringer has their registered seat or where the infringing goods are marketed – is pivotal to every brand protection strategy. However, the recent practice of district Courts in Poland varies significantly and it is vital that rights holders get this right when seeking preliminary injunctions.

Under Polish law, a civil law case should generally be brought before the Court in the district where the defendant has its registered seat. However, for claims resulting from an unlawful act or a tort (such as trade mark infringement) claimants can also choose to have the case heard by a Court in the district where the act which resulted in harm was committed or where the consequences of that act occurred. In the case of goods marketed under an infringing trade mark, this has led to an interpretation that a claimant may freely choose the district Court in which it brings an action, regardless of where in the country the infringing goods were purchased, and regardless of where the infringer has their seat.

The interpretation has evolved to the extent that many Courts now find it sufficient to establish their jurisdiction on the basis that the claimant purchased the infringing goods in their district from any entity in the distribution chain, and not necessarily directly from the defendant. In practical terms this means that if a wholesaler has its seat in Krakow, sells infringing products to a retailer in Warsaw, who subsequently sells them to consumers, the rightsholder may choose to have the case heard by the district Court in either Kraków or in Warsaw, provided that the sale in Warsaw can be proven (e.g.



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with a receipt from the retailer). This approach is naturally very convenient for trade mark owners.

However, not all Courts share the above interpretation. According to some, such an approach leads to an abuse by the trade mark owner of its rights and in practice results in unjustified forum-shopping. In such instances the Court may declare that it does not have jurisdiction to hear the case and will transfer it to a district Court it considers competent (usually the Court of the seat of the defendant).

This poses a significant risk in particular in the context of preliminary injunction (PI) proceedings. If a district Court decides that it does not have jurisdiction to issue a PI decision, there is a high likelihood that the infringer will learn that a PI motion was filed before the decision is issued by the Court to which the case was transferred. This in turn may vitiate the surprise element of PI proceedings, potentially rendering the seizure of the infringing goods impossible because the infringer will have enough time to dispose of them.



My brand is not there for your political speech



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Brand reputation is one of the most valuable assets businesses own. Trade mark owners will want to avoid undesired political exploitation of their brand, but doing so can pose a challenge. Not so in the Benelux region, where trade mark laws help brands to combat such use, which can be particularly harmful in a world where political campaigns can quickly go viral.

Recently, Belgian voters were confronted with a political campaign featuring a right-wing politician drinking the well-known Belgian trappist beer Westmalle, saying "*Westmal' or halal – The choice is clear*". The same political party also issued a poster with the slogan "*Freedom or Islam?*" next to a photograph of a long-legged woman wearing Louboutin shoes, with slogans such as "Sharia compliant" at her feet and "stoning" at the top of her thighs illustrating the alleged repression of women by Islam.

Political parties are often tempted to include well-known trade marks in their campaigns, to make a political statement or simply to attract voters' attention. Understandably, companies like Westmalle and Louboutin are not pleased with this undesired publicity. However, ending this undesired political exploitation of one's brand by enforcing trade mark rights can be difficult.

At the European level and in many Member States, trade mark legislation only allows brand owners to enforce their rights where a mark is used in the course of trade. This legal hurdle cannot be overcome where a mark is used in a non-commercial political context. But Benelux trade mark legislation provides for protection against non-commercial

use of a mark other than for the purposes of distinguishing goods or services, where the use of that mark takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark without due cause.

Westmalle and Louboutin were able to put an end to the respective political campaigns on the basis of that provision, and the Court considered that political exploitation of a mark – irrespective of the party or ideology at stake – is detrimental to a brand's reputation. Though it received broad support, the decision was criticized by some for having failed to take into consideration the right to freedom of expression as due cause for this use.

When European marks are involved, the outcome is less favorable for trade mark owners. The well-known telecoms service provider O2 failed to prohibit the distribution by the same political party of a book and t-shirts featuring the sign "O2". In addition to the fact that this sign was used as the molecular formula for the element oxygen, the Court pointed out that there was no use of this sign in the course of trade, a prerequisite for a finding of trade mark infringement under European law.

These cases suggest that possession of a Benelux trade mark may be a useful addition to companies' trade mark portfolios, especially for owners of particularly well-known brands which are more often the subject of political or other undesired exploitation, against which Benelux law gives a broad scope of protection.



The mix between copyright and trade mark protection

Can trade mark protection take over when copyright protection has long expired? Can use of a sign for decorative purposes be considered use as a trade mark? A recent Danish Court decision² has had to grapple with these questions.



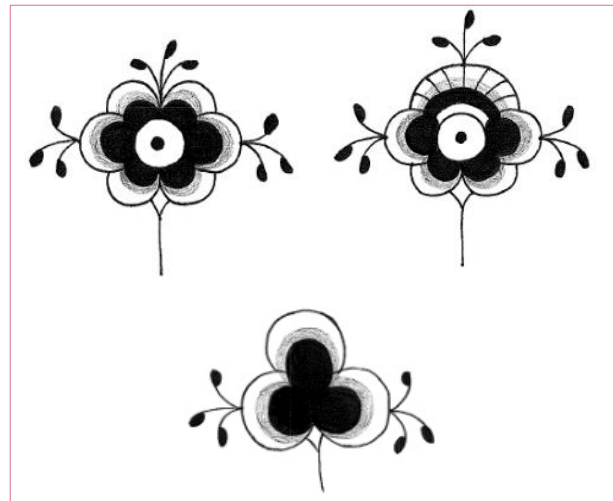
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The case concerned a Danish design classic – Royal Copenhagen's blue fluted white porcelain (referred to as "Musselmalet") and, in particular, a series known as the "Mega Mussel", designed by Karen Kjeldgaard-Larsen and released by Royal Copenhagen in 2000.



In 2011, Royal Copenhagen filed for EU trade mark protection of three figurative marks, depicted below, which were registered in black and white.



² The full judgment can be found at: <http://domstol.fe1.tangora.com/media/-300011/files/V0092001.pdf>. All images in this article were sourced from the document.

The alleged infringer in this case was Norwegian company Porsgrund Porcelænsfabrik who in 2005 introduced a design referred to as "Maxistrå".



The Court held that the Maxistrå series was an infringement of Royal Copenhagen's Mega Mussel, following a comparison and an evaluation of both series by the Court. Most interesting, however, was the basis of the protection awarded by the Court to the Mega Mussel design.

The Mega Mussel products were awarded copyright protection, but the Court went on to state that the use of the Mega Mussel design had given it distinctiveness, and served to identify the products as originating from Royal Copenhagen, and as such had obtained the status of a trade mark. By so doing the Court either seems to have mixed up the distinction between a design/copyright protection and trade mark protection – or to have considered the Mega Mussel products as being three dimensional trade marks.

To support their claim that their three black and white EU trade marks were well-known, and therefore distinctive, Royal Copenhagen submitted a market survey in which the respondents were shown pictures of the respective trade marks painted on white porcelain cups. They were then asked

whether they had seen the *blue* device on white porcelain before and which producer or series of products it made them think of. 70-76% of the respondents answered that the pictures made them think of Royal Copenhagen.



Royal Copenhagen filed more market surveys during the case, all based on pictures of one or several products from the Mega Mussel series, none with the decoration on its own. It is unclear from the decision which of the surveys was used by the Court to support their reasoning.

This case is notable in that it suggests that a decoration that has become part of the public domain in terms of copyright/design protection can be protected as a trade mark, and use of a sign on goods for decorative purposes can be considered use of the sign as a trade mark, therefore rendering it eligible for protection by trade mark law.



Focus on: Brexit



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Implications on trade mark enforcement

The implications of Brexit on the enforcement of trade marks in the UK will depend on the outcome of the UK's negotiations to leave the EU. However, there are steps for brand owners to think about now in order to prepare the way.

Currently, both registered UK national trade marks (UKTMs) and European Union Trade Marks (EUTMs) are enforceable in the UK. The substantive law of enforcement and validity for UKTMs and EUTMs is largely harmonised. In addition, the UK Courts consider and apply the substantial body of case law relating to trade marks developed by the Court of Justice of the EU when enforcing both UKTMs and EUTMs.

The remedies for trade mark infringement are harmonized to some extent across the EU by the EU IP Enforcement Directive. In the right situation, it is currently possible to obtain a pan-EU injunction in the UK Courts to prevent infringement of an EUTM.

The effect of the above is that the law of registered trade marks in the UK is intricately linked with EU law.

The UK Prime Minister Theresa May has indicated that once the UK leaves the EU, current EU laws will automatically be

incorporated into national UK law. For that reason, even after the UK has left the EU, there is likely to be little immediate change with regard to the enforcement and validity of UKTMs.

The matter is different with regard to the enforcement of EUTMs in the UK. The EUTM is a unitary right which, as a matter of EU law, applies only in the EU. Once the UK leaves the EU, on the face of it EUTMs will only be enforceable in the UK if:

- there is a method of converting existing EUTMs to UKTMs, for the UK territory;
- the EUTM regime is amended to permit non-EU Member States; or
- the UK unilaterally decides to honour EUTMs as if the UK had remained in the EU.

The first of these options is thought to be the most likely. There are a number of matters for the UK government to consider during that process, including whether, if EUTMs are converted to UKTMs, that process should be automatic or voluntary, and whether it should be subject to payment of a fee. Furthermore, transitional provisions will need to be

enacted to address matters including whether EUTMs which have only been used outside the UK shall continue to be valid within the UK; and whether EUTMs that have only been used in the UK shall continue to be valid in the rest of the EU.

One area of concern is what will happen to ongoing enforcement actions based on EUTMs when the UK leaves the EU. As the UK Courts will cease to be EUTM Courts when the UK leaves they will cease to have jurisdiction over EUTMs. There is therefore uncertainty as to the status of any pending litigation and whether the UK Court will be able to grant remedies. It is likely there will be transitional provisions to deal with this situation but whether this is the case and what effect they will have is unclear.

It may therefore be sensible for businesses to file national UKTM applications now for their most important marks, to provide more certainty should it become necessary to commence enforcement action in the UK Courts prior to the leave date. If unopposed, a UKTM application can proceed to registration within 4 months.

Implications on trade mark licensing

Assuming the UK does grant EUTM holders a national UKTM right to fill the gap left when the EUTM no longer covers the UK, there are also potential implications on existing trade mark licences. This is because the legislative regime for licences of UKTMs differs from that covering EUTM licences. The issues arise where:

- there is an existing licence of an EUTM;
- the licensed territory is, or includes, the UK; and
- no UK national marks are currently included in the licence.

If the existing EUTM licence defines its territory as the "European Union", there is a question at the outset whether the UK would continue to be part of the licensed territory post-Brexit.

There are competing arguments, and the answer will vary on a case by case basis. As a result:

- parties to existing licences ought to consider amending the licence, where necessary, to clarify the position.
- parties currently (re-)negotiating a licence ought to provide whether the term EU means "as constituted from time to time", or "as at the date of the agreement".
- in each case, parties ought to contemplate other States joining or leaving the EU in future.

Assuming the answer to the question above is that the territory of the existing EUTM licence *does* continue to include the UK, there is then a question over whether the licence covers the newly created UKTM (equivalent to the EUTM). This might well be so, either as a matter of contractual interpretation, or by virtue of specific transitional legislation. If it is, then there are a few points for the licensor and licensee to consider.

For example, the licensor should be aware that its licensee may have better rights post-Brexit to enforce the new UKTM against third parties than it had in relation to the EUTM. For example, the right to call on the licensor to enforce the UKTM, failing which the right to take enforcement action in its own name. The licensee will not have such rights where the parties have already included provisions to the contrary in the licence agreement. So:

- a licensor currently (re-)negotiating an EUTM licence whose territory includes the UK ought to address how enforcement is dealt with, and seek to exclude these "enforcement" rights of the licensee.
- for an existing EUTM licence whose territory includes the UK but that is not currently up for renegotiation, a licensor in a strong bargaining position should consider seeking to amend it to exclude these rights.

As regards licensees, businesses who are currently licensed to use an EUTM in the UK should seek to register the licence at the UK IPO as soon as the new UKTM deriving from the EUTM comes into existence. This is because a licence of a UKTM is only effective against a third party acquiring a conflicting interest (such as a party buying the UKTM, or a subsequent licensee whose rights conflict) if it has been registered at the UK IPO.

There may of course be practical difficulties at the UK IPO because the underlying licence document will not refer to the new UKTM, unless it is amended. This is a matter on which suitable transitional provisions would be helpful, though perhaps unlikely to be forthcoming in this case.

EUTM Representation post-Brexit: business as usual for Bird & Bird

Of course, Bird & Bird will continue to act as representatives for EUTMs after Brexit. Not only does Bird & Bird have offices in a large number of EU countries, unaffected by Brexit, but also the Bird & Bird UK office will remain able to act as representative before the EU IPO, as well as the EU General Court and CJEU (because it contains lawyers qualified in EU member states such as Republic of Ireland and Spain).



High Court rules on “relevant public” and comparative advertising

The Singapore High Court has ruled that the "relevant public" - for the purposes of determining the likelihood of confusion for trade mark infringement where pharmaceutical products are concerned should include end-users, when the end-users are involved in selecting the products they would use. The High Court also ruled on the defence of comparative advertising for the first time, holding that the defence does not apply when the advertisement in question was misleading.

In *Allergan Inc. & Anor v Ferlandz Nutra Pte Ltd*, the Claimant, Allergan, owned a registered trade mark for Latisse in respect of “pharmaceutical preparations for the treatment of eyelashes”. The Defendant promoted and sold an eyelash growth product under the sign LASSEZ. The Singapore High Court decided that the Defendant's acts amounted to trade mark infringement.

In relation to the assessment of the likelihood of confusion, the Defendant argued that the “relevant public” should be confined to medical practitioners because end-users of the Claimant's products had no access to them other than through medical practitioners. The Court disagreed. It held that end-users should also be taken into account if (but only if) end-users were involved in selecting the products they would use. In this instance, end-users would ask clinic staff for eyelash growth-enhancing products and then be referred to both the Latisse and Lassez products, which were displayed side-by-side in clinics.



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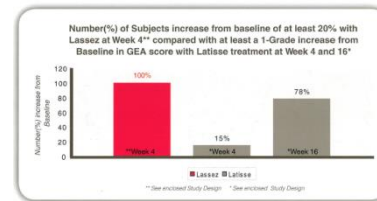
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Separately, in considering the applicability of the defence of “fair use” for comparative advertising, the Court held that in deciding whether the use was “fair”, a relevant consideration was whether the advertisement contained a materially false or misleading statement.



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The Defendant's advertisement used results for the two products which were based on different tests in different studies. This was deemed misleading and, accordingly, the defence did not apply.

Take-aways:

- When selecting a name or logo, even where products and services are primarily targeted at professionals or available to end-users only through professionals, brands should consider whether end-users will play any role in the selection process. If so, the perspective of end-users must be taken into account to ensure that the product or service can be properly distinguished from a competitor's.
- When using comparative advertising in marketing products or services, brand owners are advised to ensure that the data presented is directly comparable. If this is not possible, then the data should not be included in a comparative chart or table. Additionally, clear and prominent disclaimers should be included in the advertisement to alert the user to any differences.
- Brands would do well to be mindful of who may have access to their marketing material, and ensure that it is prepared accordingly. If information is not intended for end-users, the advertisers ought to make that clear in the ad, and take steps to ensure that it will not be seen by end-users in the ordinary course of events.

This report is based on an article which first appeared in Intellectual Property Magazine. The authors represented the Claimant in this case.

Use with caution! Henkell keeps the cork in the bubbly as it fails to demonstrate genuine use of its prior trade mark



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The EU General Court has provided a timely reminder that it is essential to choose carefully the earlier mark invoked in opposition proceedings, and gives a wake-up call on the "correct" use of a trade mark to show "genuine use" – it is essential that it guarantees the identity of the goods' origin.

In this case, Ciacci Piccolomini d'Aragona (Ciacci) filed an application for the registration of an EU mark "PICCOLOMINI" in relation to alcoholic beverages, and in particular sparkling wines. Henkell & Co (Henkell) opposed the mark, based on its earlier EU mark PICCOLO.

In response, Ciacci requested that Henkell prove genuine use of the earlier mark, as it had been registered more than five years earlier. Henkell stated that it had used the mark PICCOLO in relation to sparkling wine in various Member States of the EU, and provided a number of documents to demonstrate this, including invoices.

While the Opposition Division of the EUIPO upheld the opposition, notably considering that the applicant had established genuine use of its earlier mark, the Board of Appeal considered that the applicant did not meet that requirement. In particular, the Board of Appeal found that the proof of use submitted by Henkell did not demonstrate use of

the mark to guarantee the identity of the origin of the goods for which it is registered – its essential function.

The Board of Appeal thus annulled the decision of the Opposition Division and accepted the PICCOLOMINI mark for registration.

Upon appeal by Henkell, the General Court followed the reasoning of the Board of Appeal, finding that the term PICCOLO was not displayed on the goods or on the packaging in a prominent way which would attract the consumer's attention. The term PICCOLO appeared in the overall image only as a secondary and ancillary element. In addition, as the Board of Appeal had underlined, the Court considered that the term PICCOLO was used merely to describe the size of the bottle, whereas the term Henkell was predominant, both on the goods and on the packaging.

This decision is a reminder that not just any use of a mark will constitute genuine use of this mark, especially where more than one mark is displayed on the same packaging or label. A mark must be used in accordance with its essential function – to guarantee the origin of the goods.

Had the mark PICCOLO been used in larger characters alongside the name Henkell, the applicant may have been successful in its opposition.

More generally, it is important to collect relevant material carefully during the life of the mark to be in a position to demonstrate genuine use of the mark and help secure success in opposition proceedings or in the course of a cancellation action or counterclaim for revocation for non-use.



Brand watch



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Record year for Madrid trade mark applications

The World Intellectual Property Organization (WIPO) has announced that it received 50,000 international Madrid trade mark applications in 2015. This figure is a record high, and represents a 10% increase on the number of applications received in 2014. The top three countries of origin for applications were the US, Germany and France.

Looking to the future, a number of countries across the world are due to accede to the Madrid System, with Canada, Mauritius and Trinidad and Tobago due to join in 2017, along with a number of other countries from across the ASEAN region, Latin America and Africa.

WIPO intends to unveil a number of new features, the most significant of which is Madrid Monitor – a searchable database currently being tested, which WIPO envisages being a "new gateway to the Madrid System".

The feature will allow users to search for detailed information on trade mark registrations, track the progress of international applications, receive status updates on applications and transactions, and monitor competitors' trade marks using a customisable "watched marks" list.

Turning to the topic of Brexit, WIPO's legal director commented that "it's business as usual until we hear otherwise", but noted that brands are being cautious and pragmatic in relation to the UK's withdrawal from the

European Union, with an increase in the number of applicants "ticking the box of the UK and EU" when making applications on the Madrid System.

Read more here:

<http://www.worldipreview.com/news/marques-2016-wipo-reports-record-year-for-madrid-applications-12286>

Specsavers seeks to trade mark "should've"

Specsavers has been using the phrase "should've gone to Specsavers" since 2003, and it has been registered as a trade mark within the EU since 2005. A recent Specsavers advert featured John Cleese, reprising his role as Basil Fawlty in a spoof of a well-known scene from Fawlty Towers, mistaking a police car for his own and attacking it with a tree branch. The advert is accompanied by the full Specsavers catchphrase and the hashtag "#should've".

The full catchphrase "should've gone to Specsavers" is integral to Specsavers' marketing campaigns, and the contraction "should've" is used to drive its campaigns on social media. The words are important to Specsavers because they help to distinguish the brand from others in the market. In August, Specsavers applied to the UK Intellectual Property Office (UKIPO) to trade mark the words "should've" and "should've" in respect of five classes of goods and services, including optical products and hearing aids, retail and optical services, and paper products. The application has been given initial approval by the UKIPO, though nine notices of threatened opposition have been filed by third parties. Those third parties have until 12 November 2016 to file their oppositions.

Whilst some commentators have expressed surprise at the UKIPO's decision to approve the mark, this would not be the first time that the UKIPO has accepted that a single word in common use could be distinctive and worthy of registration. There is also precedent for brand owners registering shortened versions of their advertising slogans. Nestlé holds "have a break" in addition to "have a break, have a KitKat", and over 20 years ago, Carlsberg registered the word "probably", distinct from their well-known slogan "probably the best lager in the world".

The move to register "should've" represents wise brand strategy from Specsavers, as the single word format translates well for use in domain names and as a social media hashtag. Brands with similar catchphrases and straplines will be awaiting the outcome with bated breath.

If Specsavers succeed in registering the mark, there may well be a flurry of similar applications.

Further details are available on our MediaWrites blog:

<http://www.mediawrites.law/i-shouldve-thought-of-that-specsavers-apply-to-trade-mark-a-single-word/>

Number of counterfeit goods intercepted by the EU rises 15%

New figures released by the EU Commission report that more than 40 million counterfeit goods were seized by customs authorities across the bloc in 2015, corresponding to a value of nearly €650 million. This figure was around 5 million more than in 2014, representing an increase of 15%.

The figures show that cigarettes were the category of goods most frequently detained (27%), followed by the combination of food and beverages, toiletries, medicines, toys and household electrical goods (25.8%). The principal country of origin for counterfeit goods was China, trailed by Montenegro, Hong Kong, Malaysia and Benin.

The vast majority of the products detained were suspected of trade mark infringement (a combined 93.83% for Community, national and international trade marks). In more than 91% of seizures the goods in question were destroyed or became the subject of infringement proceedings in cooperation with the rightsholder.

Read more here:

http://europa.eu/rapid/press-release_IP-16-3132_en.htm



Upcoming industry events and awards

Digiday Brand Summit

5 – 7 December 2016

Utah, USA

This event focusses on how brand marketers are evolving to keep up with the changes in the industry.

<http://digiday.com/event/brand-summit-2016-december-deer-valley/>

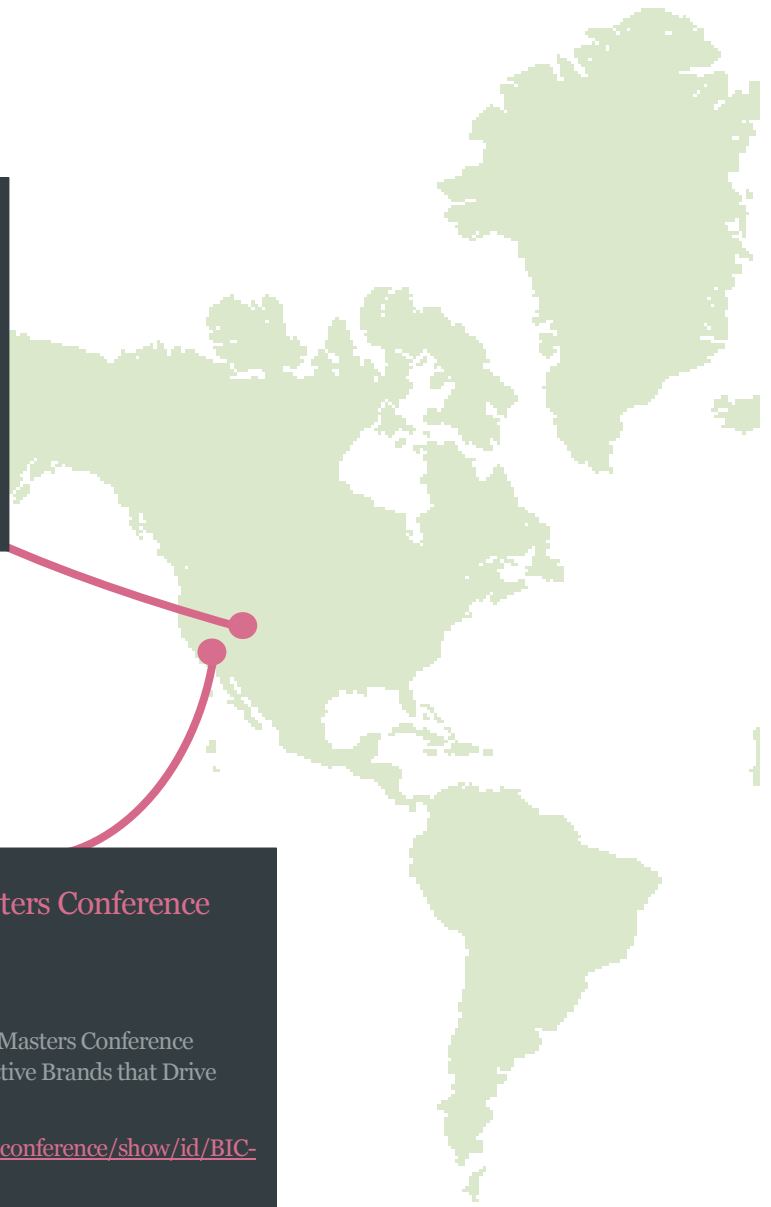
2017 Brand Masters Conference


15 – 17 February 2017

California, USA

The 2017 ANA Brand Masters Conference theme is “Highly Effective Brands that Drive Results”.

<https://www.ana.net/conference/show/id/BIC-FEB17>





Social Media in the Pharmaceutical Industry

17 – 19 January 2017

London, UK

The conference will focus on how best to harness new technology and includes discussions on the latest industry trends.

<http://bit.ly/2eMAx9V>

Luxury Brands Symposium

16 – 17 March 2017

Hong Kong

The symposium will explore luxury brand protection.

<http://www.marques.org/conferences/>

Sustainable Brands

8 – 9 March 2017

Tokyo, Japan

The conference will highlight how companies are establishing environmental and social purpose into the core of a brand.

<http://www.sustainablebrands.jp/event/en/sbt2017/>

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