

# Bird & Bird & BrandWrites

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# Welcome to the eighth 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 feel free to get in touch with Editor and Bird & Bird Partner, Nick Aries at [nick.aries@twobirds.com](mailto:nick.aries@twobirds.com) or Bird & Bird Partner, Lorraine Tay at [lorraine.tay@twobirds.com](mailto:lorraine.tay@twobirds.com).

## Get in touch

If you would like advice on how best to protect or enhance the value of your brand, get in touch for a complimentary initial consultation: [brands@twobirds.com](mailto:brands@twobirds.com)

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# Samsonite parallel imports: trade mark rights not exhausted in Singapore



Samsonite bags trade mark infringement win against a local parallel importer of genuine Samsonite-branded backpacks. Singapore's High Court rules that the oft-cited "exhaustion of rights" defence does not apply.

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## Why is this case significant?

This is the first local case squarely addressing the meaning of the phrase "put on the market" in the exhaustion of rights provision. The doctrine of exhaustion in Singapore is on the face of it quite broad because it applies to goods put on the market (with the trade mark owner's consent) whether inside or outside Singapore.

## Brief facts

Samsonite's Chinese subsidiary (Samsonite China) was licensed to manufacture and supply Samsonite-branded backpacks under a co-branding agreement with Lenovo.

It was strictly intended that the backpacks were to be given away for free by Lenovo's authorised distributors in China in conjunction with the sale of Lenovo laptops to end users in China.

Instead, some 2,328 backpacks were diverted from their envisioned pathway, and imported into Singapore. Samsonite sued the importer for trade mark infringement; the importer raised the exhaustion of rights defence.

## "Put on the market"?

The court focused on the phrase "put on the market" and noted the following:

- "Put on the market" refers to the situation where an independent third party acquires the right of disposal of the trade-marked goods under circumstances which simultaneously allow the trade mark owner to realise the commercial or economic value of the trade-marked goods.
- The typical circumstance by which such value is realised would include, but is not limited to, the sale of the trade-marked goods; commercial value can be realised through other methods designed to increase brand awareness or penetrate a specific market, for example.
- Mere preparatory acts such as offers for sale do not suffice; a balanced interpretation of the phrase must be consistent with the underlying principle that the trade mark owner must realise the first right of reaping a "reward" for his intellectual labour before his rights can be derogated from under the exhaustion doctrine.
- The "market" in question is contingent on the precise factual matrix of each case and the economic objective of the particular trade mark owner.

### Infringing importer

The court held that Samsonite's economic objective was to give away the backpacks in order to raise awareness of its brand and to achieve market penetration in China through the association with Lenovo. This objective was entirely frustrated because of the unauthorised diversion of the goods and their eventual importation into Singapore. Accordingly, the diverted backpacks had never been "put on the market" and the importer remained liable for trade mark infringement.

### Key takeaway

The decision is unlikely to change the application of the exhaustion doctrine in typical parallel import scenarios. However, in unique factual scenarios where a trade mark owner's specific commercial objectives in relation to its goods are thwarted, it may be possible for the trade mark owner to maintain his right to sue for infringement on the basis that his goods have not in fact been "put on the market".





# Where there's smoke, there's fire – parallel imports and trade mark infringement in Australia



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In Australia, the parallel importation defence to trade mark infringement (under s.123 of the Trade Marks Act 1995) can be relied upon in certain circumstances where a person imports genuine goods affixed with trade marks that have been applied by, or with the consent of, the Australian trade mark owner, whether or not the goods were intended for the Australian market.

In a recent decision of the Full Federal Court of Australia, it has been found that the defence also applies when an importer repackages the imported goods and in doing so re-applies the trade marks to the goods for the purposes of re-sale.

## The facts

Scandinavian Tobacco Group Eersel BV (STG) is a Dutch company that makes and sells cigars, including into the Australia market. STG owns the Australian registered trade marks for its cigar brands (STG Marks).

The Tobacco Plain Packaging Act 2011 (Cth) (TPP Act) requires cigars (and cigarettes) to be sold in a specific type of plain packaging. As a result, STG's cigars are pre-packaged overseas to comply with the TPP Act and then shipped to a local authorised distributor in Australia.

Trojan Trading Company Pty Ltd (Trojan) imports and sells cigars in Australia. Trojan imported STG's cigars into Australia in their usual branded packaging (i.e. not

in the plain packaging), repackaged the cigars into plain packaging and re-applied the STG Marks in a manner that was compliant with the TPP Act.

STG sued Trojan in the Federal Court of Australia for trade mark infringement, arguing that Trojan had used the STG Marks without its consent when Trojan repackaged the cigars. STG lost at first instance and appealed this decision to the Full Federal Court of Australia.

The court held that as long as the trade mark was initially applied to the goods by, or with the consent of, the registered trade mark owner (in this case STG applied it to the original goods), then, if the goods are purchased by another person who removes and then re-applies the trade marks for the purposes of resale, s.123 of the Trade Marks Act applies and the parallel importation defence to infringement can be relied upon.

### What does this mean for brand owners?

Whilst this decision may seem like cause for alarm for brand owners, it does not mean that trade marks cannot be effectively deployed to prevent importation of grey goods.

Rather, parallel importation of goods can be controlled, either by: (1) the trade marks in Australia being owned by a separate entity from the overseas entity; or (2) by including a carefully drafted notice on the packaging prohibiting tampering with the packaging or the alteration or removal of trade marks on the packaging.



# Unregistered trade mark protection in Denmark: a fairy tale too good to be true?



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No, it is true - you can actually acquire full trade mark protection in Denmark by commencing use of a trade mark without formally registering the trade mark.

The trade mark protection is obtained for the goods and services for which the trade mark is used and will stay valid for as long as the trade mark is continuously used.

This provision in the Danish Trade Marks Act of 1991 might at a glance seem similar to provisions in the trade mark acts of the other Nordic countries – Sweden, Finland and Norway. However, in these countries it is a requirement that the trade mark has become established and/or well known before a trade mark right through use is obtained. There is no such requirement in the Danish Trade Marks Act.

To establish the trade mark right in Denmark there must be real commercial use within the Danish territory, encompassing Denmark, the Faroe Islands and Greenland. There is no requirement for the scale or duration of use - the right can in principle be obtained if the trade mark is marketed in shops and in the daily press for one day.

Two examples from the Danish courts illustrate this. In the first case the trade mark belonged to a US company, and although the trade mark had been used in adverts in the international periodical *Nature* from 1989–2001 which had 250–375 Danish subscribers during this period, this was not deemed sufficient to acquire trade

mark protection. This was both because there were no actual sales in Danish shops and the small Danish circulation of *Nature*. In the second case marketing material with the trade mark had been forwarded by a Danish company to potential customers and a press release had been sent to the media leading to mentions in the Danish newspapers. This was deemed sufficient to acquire trade mark protection.

Even use by “others” might in some instances qualify as real commercial use, i.e. in cases of lawful parallel imports as this concerns the marketing of real goods with the genuine trade mark.

However, relying on trade marks acquired through use calls for extra attention. Trade mark owners tend to forget to save properly dated documentation of the first and continuous use of the trade mark, thereby causing difficulty in proving the priority date from which the right has been acquired and in turn that they hold the older right in conflicts with younger rights.

As stated above, the trade mark protection of a right obtained through use ceases to exist when the use of the trade mark stops. However, mere temporary interruptions of the use do not bring the protection to an end.





In summary – don't despair if you are facing a trade mark infringement in Denmark but don't hold a registered trade mark to fight it. If you have used your own trade mark in Denmark you will most likely have some trade mark protection acquired through use to support your fight.

# In the wake of *Specsavers* and *Levi Strauss*: considerations in proving infringement of bare trade marks in Spain



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Recent applications in Spain of CJEU cases about how/whether the obligation of genuine use is fulfilled for 'combination' trade marks (Colloseum Holding AG vs. Levi Strauss & Co and Specsavers International Healthcare Ltd et al vs. Asda Stores Ltd).

According to these decisions, the genuine use of a simple trade mark (a "bare" trade mark, i.e., a trade mark with no label, or words, etc.) can be based on the use of another trade mark, which combines the bare trade mark with another trade mark (a graphic, a three dimensional container, etc), provided that the bare trade mark element is perceived as an indication of origin within the composite mark. The facts underlying both cases were similar.

In the *Specsavers* case, the trade mark owner held the following trade marks:

- a EUTMs No 1321298 and No 3418928, consisting of the word "Specsavers"
- b Figurative EUTMs No 449256 and No 1321348, the "shaded logo":



- c EUTM No 5608385:



- d EUTM No 1358589, the "wordless logo":



The conclusion from this judgment was that the "wordless logo" trade mark had been put to genuine use even though this logo was only used together with the word Specsavers, since it still served as a badge of origin.

In *Colloseum*, Levi Strauss owned several EUTMs covering the word mark LEVI'S, amongst others, for articles of clothing and also a German trade mark, which protected the shape of a pocket with the word element 'LEVI'S' in a red rectangular label at its left upper edge:



Levi Strauss also owned the coloured EUTM No 2 292 373 in red and blue, registered on 10 February 2005 for trousers ('mark No 6'). Notably, this EUTM does not include LEVI'S as verbal element. It appears as follows:



Levi Strauss always uses the word element 'LEVI'S' in the red rectangular label at the left upper edge. The Court considered that use of the sign featuring the Levi's word amounted to genuine use of this "bare" EUTM without the LEVI's word.

The "Specsavers/Levi's" doctrine was applied by the Spanish Supreme Court in the Cointreau judgment of last year. Cointreau is a well-known orange-flavoured liqueur with a characteristic bottle. The case handled an imitation of Cointreau's bottle and the Supreme Court declared that the registered "bare" trade mark had been genuinely used, because the combination of the bare

bottle with the label Cointreau was also registered. Therefore the Supreme Court affirmed genuine use and infringement of the registered trade mark.



Bare trade mark

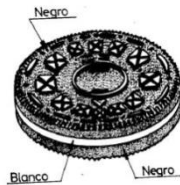


Complete trade mark



Infringing product

The Cointreau decision departed from the previous „Oreo“ judgment of the Supreme Court ([2 September 2015](#)). In "Oreo", the Supreme Court declared the bare "Oreo" trade mark (provided below) should be revoked for non-use. The reason for this declaration was that the trade mark owner always used the Oreo cookie with the word „OREO“ imprinted on it. As a result the owner failed to establish infringement. The judgment did not apply the "Specsavers-Levi's" doctrine because the distinctiveness of the bare trade mark was very weak and no secondary meaning had been proved.



Revoked trade mark



Allegedly infringing product

In conclusion, these cases give rise to the following recommendations for trade mark owners who want to ensure the fullest scope of protection:

- a) it is prudent to separately register word trade marks, bare trade marks (i.e. only the three dimensional trade mark: the bottle, cookie, etc) and the combination of trade marks (the three dimensional final product), as each would be suitable to deploy in different cases; and
- b) if the bare trade mark has a low degree of inherent distinctiveness, it is important to be able to prove the sign has acquired a secondary meaning.



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# Tactics for brand owners dealing with Hungarian customs



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Businesses can seek to turn the increase in customs costs into an enforcement advantage by showing active engagement with smaller shipments of infringing goods. Right holders may wish to re-think applying thresholds to enforcement, or alternatively decide on sending proactive release responses to customs.

Customs agencies are on the frontline of enforcement of intellectual property rights at the EU borders. It is common practice for right holders to file an EU wide application for action (“AFA”) with the relevant customs department.

The AFA is well known for being a very versatile tool as it not only allows the active enforcement of IP rights, but provides an opportunity to oversee the most common routes and entry points of counterfeit products to the EU as well as its sources.

Customs, in order to effectively carry out their task, need the active engagement of the right holders themselves. Active participation however comes with a price, which – in light of the seized amounts – sometimes might seem too high to pay, so right holders tend to introduce enforcement thresholds.

Experience shows that in Hungary, many notifications do not reach the right holders' threshold for enforcement. Generally, this results in a standard 'no response required', letting the goods be released.

This has two drawbacks:

- seized goods stay in customs detainment for a longer time - even up to one month – this burden is born by the right holder; and

- local customs tend to become less vigilant in acting on the AFA as they perceive the right holder has lost interest, meaning a bigger fish might get missed later on.

In May 2016 customs storage fees doubled, resulting in a steep rise of administrative costs of up to EUR 200–250 per seizure (for goods weighing between 1-100 kg).

This increase of costs can be turned into an opportunity to respond in a proactive way, even when instructing customs to release goods.

Such active participation only requires one, short and quick, well worded communication emphasising the importance of smaller actions despite not seeking legal action against the alleged infringer. The earlier the communication is submitted, the quicker such goods are released; saving the payment of increased storage fees.

Here's how you can make the most out of your customs program even in the cases of seemingly less significant seizures in Hungary:

- **Deliver dedicated special training** to let them know that you do take the enforcement of your IP rights seriously. This provides a kick-start to the local customs to be more attentive and amp up seizures and detainments.

- **Respond quickly to notifications.** A *'no response'* approach may result in significant administrative costs due to increased storage fees, and have a long-term negative effect on the willingness of customs to take actions based on your AFA, even for larger shipments.
- **Provide feedback and updates.** It is essential to keep customs and your local representatives in the loop on your activity, product developments or new additions to your IPRs to keep customs engaged and alert.

Cooperation is the most effective weapon in local AFA enforcement; a quick reassuring response even to release the goods is more beneficial than no response at all.



# Character names as trade marks: now a distant fairy tale?



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Times are tough for enthusiastic lovers of fictional characters, who want the name of their favourite character to be protected as a trade mark in Germany. The latest decision by the German Federal Patent Court on this issue will cause confusion among trade mark owners and applicants.

Times are tough for enthusiastic lovers of fictional characters, who want the name of their favourite character to be protected as a trade mark. The latest decision by the German Federal Patent Court on this issue will cause confusion among trade mark owners and applicants

In the case at hand, the German word mark “Pippi Langstrumpf” (owned by the family of the inventor of the novel character “Pippi Langstrumpf”, world-famous author Astrid Lindgren) had been registered for accommodation services in class 43 since 2002. In 2012 cancellation of the mark was sought on absolute grounds, lack of distinctiveness and requirement of availability. The German Patent and Trade Mark Office rejected the request for cancellation, however this was overturned by the Federal Patent Court. The Court considered the sign descriptive of accommodation services suitable for parents and children.

The Court argued that the character Pippi Langstrumpf will most likely be associated with its well-known behaviour and adventures. Therefore, consumers will conclude that the accommodation services in question are either especially appropriate for children and their families, or that the accommodation will be in the style of Pippi Langstrumpf’s original home, the Villa Kunterbunt.

The decision is notable as the Court did not consider the specific individual – quite frankly rather distinct - character of the personality of “Pippi Langstrumpf” to be of great relevance but assumed it sufficient that the character “Pippi Langstrumpf” conveys some kind of expectation relating to the adventures and experiences of the character “Pippi Langstrumpf”.

By disregarding the role of the character's individual attributes the scope of absolute grounds for refusal has been greatly expanded. In the decision, the court considered that the ground of refusal applies without the need for an actual connection between the characteristics of the character and the goods/services but also where “the Character” itself or its “adventures” or “experiences” have some kind of association with the goods/services. This certainly leaves room for uncertainty.

Thus, more than ever the court is questioning the protectability of character names in general.

The European General Court, in a similar case, criticised that the EUIPO Board of Appeal did not adequately prove that there is a concrete descriptive relationship between the sign “Winnetou” and the goods and services in question. Bearing this in mind, there is great need for clarification of the concept of “concrete” and “relationship” between a character and goods and services. This concrete relationship is clearly missing in



the case of Pippi Langstrumpf, and it is therefore positive that the decision has been appealed to the Federal Court of Justice.

**“It’s all about origin”**

The Higher District Court in Frankfurt recently found that a perfume bottle on its own can indicate the origin of its aromatic content. One may ask how it is possible that a simple bottle made of glass can be ascribed that level of distinctiveness?

Use of mere product packaging is often thought not to be use as a trade mark, as the consumer often does not understand the shape or packaging of a product (as opposed to, say, the brand name) to indicate its origin, even if the design is particularly aesthetically pleasing. However, packaging can in fact indicate the origin of a product if the design in question significantly differs from customary designs and if the public in the relevant sector has come to recognise the packaging as denoting the

product's origin.

In this case, the perfume packaging consisted of a perfume bottle with a cap in the shape of blossom, which was registered as a three-dimensional trade mark. The court held that the distribution of another perfume whose bottle was similarly designed constituted infringement of the bottle trade mark.

In this decision the specific branding characteristics in the perfume sector were decisive: perfumes are offered in increasingly eye-catching accessorised bottles, having the effect that the shape of the bottle or packaging has become a key factor in indicating the origin of the goods. Although the public might not always fully appreciate the aesthetic ambitions behind a flacon design, the consumer will actually identify perfumes by their bottles only – in addition to words and logos that the product's packaging might also contain. This decision underlines the importance of the particular characteristics of the sector concerned when evaluating packaging shape marks.



# Q&A - TALISMAN: A smarter solution to online brand protection



Helen Saunders  
Head of Intelligence & Operations  
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BrandWrites talks to Helen Saunders, Head of Intelligence & Operations at INCOPRO, on the global fake goods market, the impact it has on lost sales and brand damage, and why Bird & Bird are using TALISMAN as their solution of choice to combat this growing concern for brands.

## 1) How extensive is the counterfeit goods market and what is the impact on brands?

In a 2016 OECD report it was revealed that the global fake goods market is worth over \$450 billion in lost sales and brand damage. In Europe, a report from the European Union Intellectual Property Office (EUIPO) in 2015 revealed that the apparel and accessories industries lose approximately €26.3 billion (roughly \$27.7 billion) in revenue annually to counterfeiting.

Having evolved in offline marketplaces, most modern counterfeiting now takes place online, via websites, online marketplaces, social media and chat platforms. Search a luxury brand on various social media and a series of images promoting counterfeit products will come up. Sometimes a selfie will appear of a person holding a counterfeit product, together with a series of contact numbers for chat platforms for keen buyers. To make matters worse, the rise of 3D printing has opened up a whole new avenue for counterfeiters.

In the luxury sector, although a counterfeit sale is not necessarily a lost sale by the brand owner due to the price differential, it's no secret that exclusivity sells.

Consequently, when branded goods become accessible to everyone, those who frequent high-end stores will become less likely to associate themselves with that brand.

Of course, it's not just luxury brands that are affected. The top five categories are: consumer electronics; apparel; computers; appliances; and foodstuffs.

## 2) Tell us about Talisman and the connection with Bird & Bird

Talisman is a fully comprehensive, innovative and intelligent online brand protection solution. Brands that use Talisman can track, prioritise, and enforce across all digital platforms. This includes marketplaces, domains/websites, social media, paid search, 3D printing and mobile apps. By joining up with Incopro, Bird & Bird's team of IP lawyers are able to offer the Talisman technology as a further service to clients across the vast array of industries affected by online counterfeiting.

### 3) What makes Talisman different?

Talisman is uniquely well set up to combat the ‘whack-a-mole’ problem (as soon as online counterfeit is taken down, another quickly pops up in its place). The Talisman technology intelligently connects data across a combination of social media accounts, online marketplaces, web domains, and chat apps (such as WeChat). Talisman clusters all these channels together so that businesses can enforce brand protection at scale, focussing on the root causes.

In the case of one fashion brand, Talisman’s advanced clustering technology succeeded in connecting an online marketplace shop, a Facebook page promoting this shop, plus an app used to sell counterfeit products. Due to targeted enforcement efforts, all infringing stock was completely removed.

### 4) How could Talisman benefit Bird & Bird clients?

For Bird & Bird clients, the Talisman technology enables Bird & Bird to offer pioneering services that provide connected intelligence to direct different methods of enforcement. This strategic approach facilitates Bird & Bird’s clients to take more decisive and immediate action and supports them to implement their IP enforcement strategies cost effectively.

Talisman has also been tailored to meet the requirements of many online platforms and registrars, and this includes sending notices in the recipients’ local language. To bolster this function, Bird & Bird can work with Incopro’s team of multi-lingual analysts who work with brands, online platforms, and registrars to guarantee the robust takedown of infringing items. By choosing to offer its clients the Talisman technology, Bird & Bird is taking an active role in supporting its clients through best practice procedures across their client’s global IP strategy.

### 5) Do you have some examples of success?

Brands using Talisman have enjoyed many success stories. For example:

- Improving the number of takedowns on Instagram from 100 posts to 250,000 a month for one client
- For another client, achieving a 95% decrease of issues within four months on key platforms: iOffer, eBay and DHgate
- 8 million counterfeit products removed from online platforms within four months for one client
- For copyright focussed clients, success in achieving 99% compliance on social media and marketplaces
- Success in implementing immediate takedown capabilities on various platforms due to the relationships built with those platforms

For further information on using Talisman as part of your company’s brand protection strategy, contact Phil Sherrell, [phil.sherrell@twobirds.com](mailto:phil.sherrell@twobirds.com) or Rebecca O’Kelly-Gillard, [rebecca.okelly@twobirds.com](mailto:rebecca.okelly@twobirds.com).



# A deep dive into website "targeting" law and its application to banner ads in UK case of *Argos v Argos*



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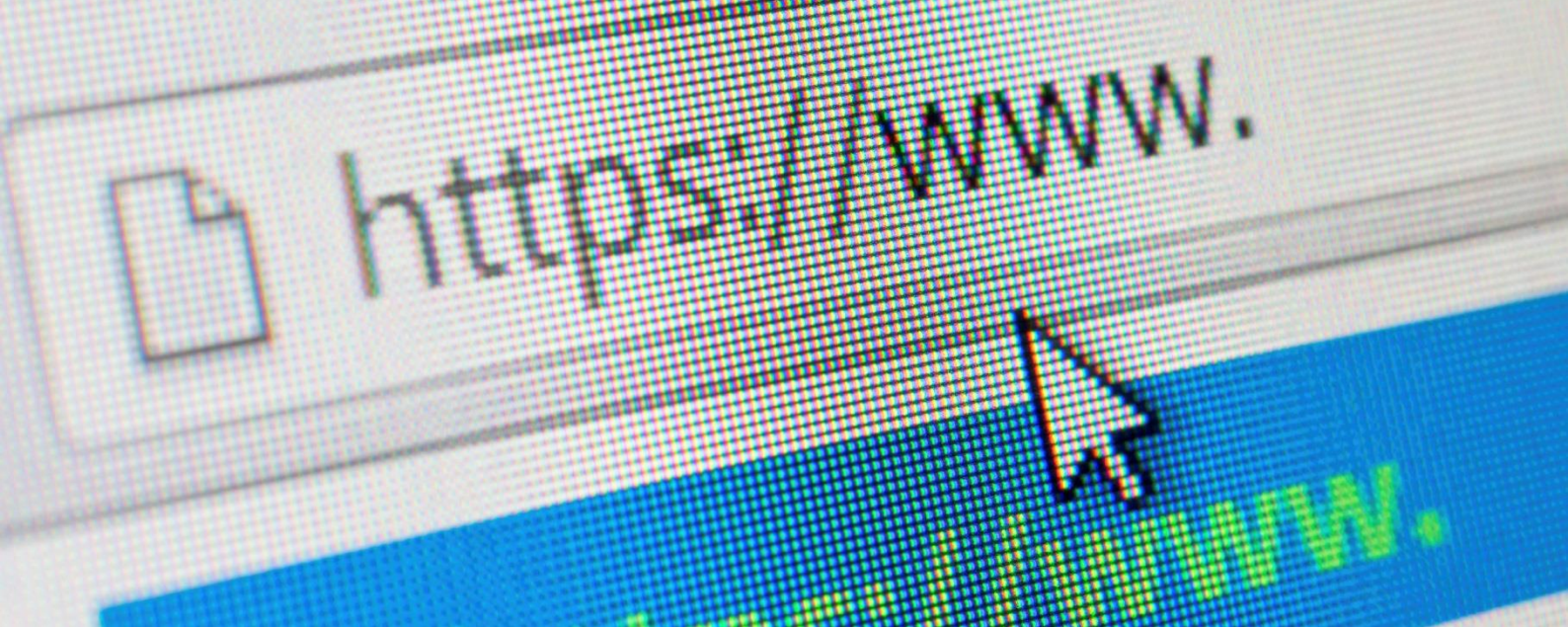
In February 2017 the UK High Court handed down its judgment in an online trade mark infringement case. The Judge gave a thorough examination of the law relating to the "targeting" test. This test is used in the EU to determine if use of a sign on a website is being made in a particular country. The case is notable for its deep dive into the relevant law, and for being the first case looking at this test in the context of banner ads.

Argos UK Limited (Argos), a UK-based retailer, sued Argos Systems Inc. (ASI), a US-based provider of software. Argos alleged that ASI had infringed its 'ARGOS' mark through ASI's use of the domain name [argos.com](http://argos.com) in conjunction with banner ads displayed on the website via Google AdSense. Some of these ads were for Argos itself, because Argos participated in Google's AdWords program. The Deputy Judge found that by signing up to the Google AdWords Ts&Cs Argos had given express consent to ASI's use of [argos.com](http://argos.com) in conjunction with display of the claimant's ads. It was relevant that Argos did not object, and could not have objected, to ASI's use of ARGOS in its domain name, without more; a claimant may still be able to object to a use which was neither pre-existing nor lawful by itself, despite taking part in the AdWords program.

Aside from the consent issue, the Deputy Judge also found that neither the whole nor any sufficient part of ASI's was targeted at the UK. Accordingly ASI did not use the sign 'ARGOS' in the UK. Although ASI had no

presence outside the Americas, 89% of its website's traffic was from the UK. This appeared to result from UK users typing [argos.com](http://argos.com) into the address bar expecting it to be the claimant's domain name. As a result, Argos argued that ASI was conducting a secondary ad-based business in the UK. ASI argued that the traffic was fleeting and trivial, as 85% of UK users left ASI's site after 0 seconds, with almost none clicking beyond the landing page. The Court found that this, combined with the American-style buildings on the landing page, ASI's contrasting logo and Americanised spelling, meant a UK user would conclude that the website was not aimed at them. The Deputy Judge also considered the correct legal approach to the question of intention, the role of banner ads in targeting, and whether there is a need to show the whole website is directed at UK users:

- There was some evidence that ASI had intended to direct a particular version of its website to the UK. The Deputy Judge's view was that the enquiry should be directed at the effect of the website on users when



viewed objectively, even where the website operator's subjective intention was to the contrary (although he did not go so far as to say evidence of intention was necessarily irrelevant).

- Argos relied on evidence that some of the banner ads displayed on argos.com were for UK businesses, such as retailer John Lewis. The Deputy Judge considered there was inadequate evidence of what ads had appeared in real-world scenarios, and that given the high bounce rate it was likely average UK internet users did not look at the ads anyway. Even if they had, and they considered the *ads* were directed at them, his view was this would not have led users to conclude the *website* itself was directed at them.
- The Deputy Judge's view was also that there was no hard and fast rule that to demonstrate targeting to the UK a claimant needs to show the entirety of the website was so targeted. If the evidence showed that some part of the website were so configured as to attract a substantial number of UK users, it may be appropriate to have regard to that part of the website alone, even if, viewed globally, the website is clearly not directed to UK users.

# Institutional Double Vision: launching a pharmaceutical brand in Poland



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On 3 March 2017 The Polish Patent Office (PPO) and the Polish Office for Registration of Medicinal Products, Medical Devices and Biocidal Products (URPL) issued a joint communication on issues to be taken into account when launching new pharmaceutical brands in Poland. However, both authorities ignored the fact that the same work is being done twice.

## State of play

A marketing authorisation (MA) is required to launch a new pharmaceutical product. Nevertheless the approval of the product's brand in the course of MA proceedings does not alone afford satisfactory protection. This is why businesses should also have their pharmaceutical brands registered as trade marks.

To that end a new brand must undergo two independent examinations carried out by different authorities under different laws. For instance, granting MAs is entrusted to the URPL and is governed by the Pharmaceutical Law of 6 September 2001, whilst the PPO handles trade mark registration, a process governed by the Industrial Property Law of 30 June 2000. As these outcomes are independent, obtaining an MA does not guarantee its holder trade mark protection for the new brand, nor does obtaining a trade mark for the new brand guarantee that it will be approved as the name or brand of the pharmaceutical.

Paradoxically, the scope of these two examinations partly overlaps due to similar criteria being applied by both authorities.

- Earlier marks/brands. An MA for pharmaceuticals under a certain brand may be refused on the basis of an identical or similar existing brand of pharmaceuticals, and a trade mark application may be rejected upon an opposition based on an identical or similar earlier trade mark. Since most pharmaceutical brands are registered trade marks, both the PPO and URPL actually take into account the same items.
- INNs. A pharmaceutical brand should not be confused with an international non-proprietary name (“INN”) for that pharmaceutical’s active ingredient, and a trade mark should have distinctive character. Since trade marks for pharmaceuticals are considered devoid of distinctive character if identical (or almost identical) to relevant INNs, INNs are taken into account by both authorities.
- Deceptiveness. Both pharmaceutical brands and trade marks should not deceive the public, e.g. as to therapeutic indications.

### Conclusion

Performing two independent examinations assessing similar grounds for refusal creates an obvious overlap. Perhaps it would be more beneficial if the PPO and URPL cooperated more closely with each other so that one authority could benefit from the expertise of the other (e.g. the PPO's expertise in visual, oral and conceptual comparison of marks, and URPL's expertise with regards to INNs) in order to avoid duplicating the work and to provide the applicant with a clear answer from both the regulatory pharmaceutical and trade mark perspective. Nevertheless, since the joint communication sticks firmly to the existing status quo, for now the PPO and UPRP seem to be happy with underlining their separate areas of expertise rather than developing closer cooperation.







# The European Union Trade Mark: A Practical Guide



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The European Union Trade Mark (EUTM) system allows brand owners to protect and enforce a trade mark in every EU Member State through just one registration. EUTMs were previously known as Community Trade Marks and this unique trade mark registration system revolutionised the way brands are protected in the EU.

2016 saw substantial changes to the EUTM system, not least the change of name. This practical guide describes how the EUTM system works following those changes, including: what can be protected; how registrations are obtained and maintained; the many potential obstacles to registration and how to overcome them; and the rights given by a registration. In addition it explains the specific and peculiar features of the EUTM system, such as seniority and conversion, and covers the link between EUTMs and the Madrid Protocol.

For full details, including a free sample chapter, go to <http://www.globelawandbusiness.com/books/the-european-union-trademark>.

# Upcoming industry events and awards



## 19th Anti-Counterfeiting & Brand Protection conference

25 – 27 September 2017

New York, USA

By attending the 18th Anti-Counterfeiting & Brand Protection Summit, you will obtain valuable insight from those who are working in – or are currently building – an anti-counterfeiting & brand protection program.

<https://www.anticounterfeittingsummitwest.com/>

## Sustainable Brands Detroit

22 - 25 May 2017

Detroit, USA

This event focusses on understanding the role of brands in shaping our future.

<http://events.sustainablebrands.com/sb17det/>



## Question the Trade Mark Judges

18 October 2017

London, UK

Meet with the judges that regularly render judgments in trade mark matters.

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

## MARQUES Annual Conference

12 – 13 October 2017

Prague, Czech Republic

The theme for the MARQUES 31st Annual Conference is BRANDS and CULTURE. Many of the sessions will address different aspects of this question, focusing on legal issues and challenges.

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

## Global Brand Protection Summit

2 – 4 October 2017

Amsterdam, The Netherlands

8th annual Global Brand Protection Summit will return to Amsterdam in 2017. The summit brings together brand protection and IP specialists in an active discussion of the key issues facing the industry.

<http://www.arena-international.com/gbps>

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