

boult

BOULT WADE TENNANT

boult.bites™

> Cornish pasty? It's a question of Protected Geographical Indications (PGI)



Many of us will be familiar with a Cornish pasty. However, how many of us know that the Cornish pasty name is protected and there are limitations on when it can be used. In 2011, the Cornish pasty was awarded Protected Geographical Indication status. A Protected Geographical Indication (PGI) is one of three different ways, devised by the European Union, of protecting and promoting the names of quality agricultural products and foodstuffs.

A PGI is the name of an area, specific place or country used to describe an agricultural product or foodstuff. The agricultural product or foodstuff at issue must:

- originate from that area, specific place or country; and
- have a specific quality, goodwill or other characteristic property attributable to the area; and
- be produced, processed or prepared in the geographical area concerned.

Therefore, only a pasty made in Cornwall, in the traditional manner and following the traditional recipe can legally be called a Cornish pasty.

PGI status provides legal protection against manufacturers outside the area imitating the regional product and selling it under the protected name. Not only does this protect the reputation and quality of the traditional product but it also helps raise awareness of a particular product, and its special characteristics, amongst consumers.

However, PGI status can be revoked, as was discovered by the brewer Scottish & Newcastle. PGI status had been granted to Newcastle Brown Ale, specifying that the beer had to be produced within the city of Newcastle. However, Scottish & Newcastle, the sole producer of Newcastle Brown Ale, moved their production to Gateshead in 2005, resulting in revocation of the PGI status by the EU two years later.

There are a number of pending applications in the UK for PGI status, including Yorkshire Wensleydale cheese and West County Lamb.

Author: Lisa Ormrod, Trade Mark Attorney

Spring Edition Content

> Cornish pasty?
It's a question
of Protected
Geographical
Indications (PGI)
Pg1

> The (second)
100 years war?
Pg2

> SES Trade
Marks - the birth
of the Eurasian
Community
Trade Mark?
Pg2

> CTM owners
beware... ONEL/
OMEL case impacts
Pg3

> Update in
relation to the UK
Intellectual Property
Office
Pg3

> Madrid Protocol
update: Mexico and
New Zealand can
now be designated,
India to join
Pg4

> Hot off the press
– Proposed changes
to the Community
Trade Mark
Pg4

> The (second) 100 years war?

The Trade Mark battle between Budějovický Budvar and Anheuser-Busch in relation to the Trade Marks BUD and BUDWEISER has been fought for more than a century.

A judgment of the General Court of the European Union (GC) of 22 January 2013, in relation to Joined Cases T-225/06, T-255/06, T-257/06 and T-309/06 is the latest instalment of this epic battle. It relates to four Community Trade Mark (CTM) applications filed by Anheuser-Busch over the period 1996 to 2000 for either the word mark BUD or a figurative BUD mark. Budějovický Budvar opposed all four CTMs on the basis of their earlier rights including a likelihood of confusion with an International Registration for a figurative BUD mark and rights in BUD as an appellation of origin.

At first instance the CTM Registry's (the OHIM) opposition division found for Budějovický Budvar in relation to one of the CTMs, rejecting the application for some of the services. The other three oppositions were dismissed due to a lack of evidence of the earlier rights relied on. This led to a series of appeals, first to the OHIM's Board of Appeal where all four oppositions were dismissed. Then Budějovický Budvar appealed this decision to the GC which annulled the Board of Appeal's decisions, finding that the CTMs should be refused registration. Anheuser-Busch appealed this decision to the Court of Justice of the EU.

The Court of Justice clarified that in oppositions relying on a non-registered Trade Mark or other sign, that an unregistered right can only prevent a CTM proceeding

to registration if it is actually being used. The Court confirmed that the use must be significant, as well as more than merely local, in accordance with the provisions of Article 8(4) of the Community Trade Mark Regulation. Also the use must be in the territory in which that unregistered right is protected; use in another territory is not sufficient. The use of the earlier unregistered right must date from before the filing date of the CTM; use of the unregistered right after the filing date of the CTM but before the publication date would not be sufficient to prevent registration.

The Court of Justice referred the matter back to the GC for judgment to analyse the facts of the case in light of the guidance provided. The GC found that Budějovický Budvar had not filed any evidence of use of a mark that was of more than mere local significance from before the filing date. The evidence of use filed was extremely limited; it related to a small geographical scope and only demonstrated the sale of a very limited number of bottles of beer. For example, in relation to Austria, evidence of use of the unregistered right outside of Vienna was minimal, which suggested just 24 bottles were sold in six towns and 240 bottles in another town over a period of two to three years. Based on the lack of sufficient evidence of the existence of an unregistered right the GC dismissed all of Budějovický Budvar's actions against the CTM application.

The end? Probably not!

Author: Charlotte Duly, Trade Mark Attorney

> SES Trade Marks - the birth of the Eurasian Community Trade Mark?

The Eurasian Economic Commission (EAEC), supervisor of integration processes between Kazakhstan, Russia, and Belarus within the Eurasian Customs Union and Single Economic Space (SES), has published a draft Agreement on Trade Marks, Service Marks and Appellations of Origin. Once ratified by EAEC members, the agreement will provide for the establishment of a 'SES Trade Mark', further harmonizing intellectual property protection in these three countries.

According to the draft document, SES Trade Marks would be filed through the national trade mark registries of Kazakhstan, Russia or Belarus. Upon grant they would be protected throughout the EAEC territories, coexisting with national rights in the same way that a Community Trade Mark does. The working language for SES trade mark applications will be Russian.

This is a significant development for this heavily populated and geographically expansive area. Could we be witnessing the birth of the 'Eurasian CTM'? We will keep you up-to-date as this issue develops.

First the CTM, then the SES, and now the LTM?

Hot on the heels of the SES Trade Mark system is the new Lusophone Trade Mark (LTM) – details of which are soon to be agreed between members of the Comunidade dos Países de Língua Portuguesa (CPLP - an intergovernmental organisation consisting of nations where Portuguese is an official language: Portugal, Brazil, Angola, Mozambique, Cape Verde, São Tomé and Príncipe, Guinea-Bissau, and East Timor). (Continued on next page)

Just like a CTM (and its Eurasian cousin the SES) this new system will provide a unified trade mark registration system, whereby one LTM registration will have protection in all CLPL countries, co-existing alongside existing national rights.

CLPL member countries are expected to publish a joint "Final Declaration", setting out the internal procedures that will be put in place, in order to establish the new LTM system.

Author: Luke Portnow, Trade Mark Assistant

> CTM owners beware... ONEL/OMEL case impacts

Case C-149/11 Leno Merken B.V. v Hagelkruis Beheer B.V. (ONEL/OMEL)

The Court of Justice of the European Union (CJEU) handed down its much anticipated decision in Leno Merken B.V. v Hagelkruis Beheer B.V., better known as the ONEL/OMEL case, on 19 December 2012. The question at issue was whether use of a Community Trade Mark (CTM) in just one member state of the E.U. is sufficient to show genuine use of the trade mark "in the Community", or whether use in two or more member states is required.

The answer to this question has potentially enormous ramifications for CTM owners, as genuine use of a trade mark is essential to maintain the ongoing validity of the CTM and in order to be able to rely on the CTM in opposition proceedings.

The CJEU found that territorial borders of the E.U. member states are irrelevant for the purposes of assessing whether or not there has been genuine use of a trade mark within the Community. Instead, the phrase "in the Community" must be taken to mean that all use outside the Community is irrelevant to this assessment. All facts and circumstances must be considered in the assessment of whether there has been genuine use in the Community.

The CJEU found that it could not rule out a situation where use of a trade mark in one member state would be sufficient to show genuine use in the Community. However, it was implied that this would be difficult to prove except in special circumstances, such as where the market for particular goods or services was restricted to an individual member state.

This ruling does not provide any hard and fast rules. The fact that the CJEU specifically declined to rule that use in only one member state is not enough to show genuine use in the Community, is good news for CTM owners who only use their trade mark in one member state.

Nevertheless, the territorial scope of use is still one of the factors which will be considered to determine whether or not there has been genuine use of the trade mark in the Community. CTM owners would be well advised to record and document all use of their CTMs in as many territories of the E.U. as possible, even if such use is only in relation to preparations to enter a new market in another member state of the E.U.

The full text of the decision of the Court of Justice can be found [here](#).

Author: Donna Trysburg, Trade Mark Assistant

> Update in relation to the UK Intellectual Property Office

Since 31 March 2013, the UKIPO has calculated opposition periods as 'beginning immediately after' the publication date. This means that an application will be open to opposition for two months from the date of publication, rather than two months minus one day. For example, an application published on 11 April 2013 will have an opposition deadline of 11 June 2013 (extensible by one month upon request).

Other changes are occurring as the UKIPO enhances its services. These include:

- improvements to the online Trade Mark search facility
- amended Trade Mark forms
- improvements in electronic correspondence, including a link to respond to examination reports and an e-correspondence web form
- a new integrated Trade Marks Journal.

The UKIPO also has a new logo, the Royal Coat of Arms. This is part of a wider move with regard to branding across UK Government departments.

Author: Charlotte Duly, Trade Mark Attorney

> Madrid Protocol update: Mexico and New Zealand can now be designated, India to join

The Madrid Protocol now spans even more territories. From 10 December 2012 New Zealand could be designated in applications under the Madrid Protocol. Mexico joined the Protocol too and could be designated from 19 February 2013. The addition of Mexico and New Zealand brings the total number of members of the Madrid Protocol to 88.

This means that not only can any new applications filed via the Madrid Protocol designate these territories but they can also be added to existing Madrid Protocol registrations as subsequent designations. Subsequent designations can be made at any time and extend the geographic scope of a registration's protection. The new territory designated becomes part of the bundle of national rights which makes up the International Registration. However, the protection afforded will be effective from the date on which that subsequent designation is recorded in the International Register, rather than the earlier date of protection of the International Registration itself.

From 8 July 2013, it will be possible to designate India too. This will bring the total number of members to 89. For further information immediately please read the recent bulletin: [India joins the Madrid Protocol on 8 July 2013](#). We will provide further updates on designating India in the next edition of [boulton.bitesTM](#).

Author: Charlotte Duly, Trade Mark Attorney

> Hot off the press – Proposed changes to the Community Trade Mark

Details of draft legislation proposed by the European Commission have been leaked providing information on proposed changes to Community Trade Marks (CTMs) and the OHIM.

Some of the proposed changes include:

- The ability to file CTMs at national offices will be abolished;
- CTM application fees will become due immediately upon filing;
- Application fees to cover a single class rather than up to three classes (although the total cost to file in three classes is expected to remain at a similar level);
- The optional search of some national registers will be abolished;
- Ability to register sound and smell marks;
- Ability to oppose a CTM on the grounds of bad faith in certain circumstances;
- Changes to customs procedures so that an importer must prove that the counterfeit goods are destined for outside the EU;

- Incorporation of the IP TRANSLATOR decision on specifications of goods and services;
- Introduction of certification marks;
- Greater harmonisation of national laws and procedures to bring them in line with the CTM system;
- Changing the name of CTMs to "European Trade Marks" and the OHIM to "European Union Trademarks and Designs Agency".

We will report further on the changes once they become final – watch this space!

Author: Charlotte Duly, Trade Mark Attorney

For further information please contact your usual adviser.

Verulam Gardens
70 Gray's Inn Road
London WC1X 8BT
United Kingdom

telephone
+44 (0)20 7430 7500

facsimile
+44 (0)20 7430 7600

email boulton@boulton.com
website www.boulton.com

Offices also in Reading,
Oxford and Cambridge

Regulated by IPReg