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The Boult Wade Tennant Trade Mark Group has started 2014 on a high with WTR 1000's recent announcement of this year's rankings.

Spring is traditionally a time for new beginnings. In keeping with the season, read our 'Spring Clean' article on **page 2** to see just how you can keep your trade mark portfolio healthy and profitable. Later this year the planned launch of the new Dot London gTLD poses interesting commercial questions for all businesses. Have you considered how you can maximise the potential of the new domain name extensions? Read our article for further information on **page 8**. Also, our article on 'Evidence of use' (**page 5**) explores ways of streamlining the time consuming and sometimes soul destroying experience of evidence collection. It's a useful check list to keep.

As always, should you need further information please contact your usual Boult Wade Tennant advisor. Or why not attend one of our events? To register your contact

details email: [teaandtrademarks@boult.com](mailto:teaandtrademarks@boult.com)

Emma Pitcher, Partner and Charlotte Duly, Trade Mark Attorney, Editors

## > Tougher times at the OHIM

Things are getting tougher at the OHIM! The introduction of their new website has been a challenge to one and all but now appears to be settling down. Of greater concern may be the anecdotal evidence observed by a number of us that the standard of examination at the OHIM has changed. In the early days the level of distinctiveness required to register a mark at the OHIM was relatively low and any hint of a logo or stylisation was normally enough to secure registration.

However, the boot now appears to be on the other foot. There are an increasing number of cases where the UK IPO will accept a mark as being distinctive, only for the OHIM to refuse the same mark on the basis of its English meaning.

The Board of Appeal are no great help with over 75% of decisions (out of over 700) being upheld. In the case of borderline marks, particularly those incorporating some stylisation, care and thought needs to be given as to where and how the application should be filed. Given this, Applicants would be best advised to look to the UK first and the OHIM second in such cases.

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Signed up to our trade mark seminar programme yet? If not email your details to [teaandtrademarks@boult.com](mailto:teaandtrademarks@boult.com)



## > Time for a Spring clean?



With Spring upon us, what better time to review your trade mark protection to ensure that it is adequate.

A regular review of your trade mark protection to ensure that it is both sufficient and up to date is a worthwhile exercise. We can conduct a trade mark audit for you to give your portfolio a thorough overview. Aside from a detailed review, it is worth regularly considering the following points:

- Are the right trade marks protected? Have you amended your word marks or logos over the years to the extent that you now use a different mark to the one that was originally protected? If so, a new trade mark application may be worthwhile so that you have adequate protection to stop third parties using your marks and to ensure that your registrations are not vulnerable to cancellation on the grounds of non-use.
- Is the geographical scope of protection sufficient? Have you recently entered into new foreign territories which require trade mark protection?

- Are your specifications adequate? Have you expanded use of your marks into new goods or services which will require protection?
- Are there marks that you no longer use? If so, they could be allowed to lapse when they are due for renewal. A spring clean of your trade mark portfolio is not simply about increasing protection but also about determining which registrations could be allowed to lapse or in some cases be merged, seniority claimed or re-filed to save costs in the future.
- In light of the new gTLDs, do you require new trade mark registrations in place so that you can obtain new domain names of interest during the sunrise periods?

Keep your trade mark portfolios healthy and review them regularly!

**Author:** Charlotte Duly, Trade Mark Attorney

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## > Domain Name update: .eu extension now available to more registrants

From 8 January 2014, those who are eligible to obtain a domain name ending in the extension .eu has increased. From this date, residents, companies and organisations based in Iceland, Liechtenstein and Norway have been eligible to register domain names that end in .eu.

The press release announcing this states *"Iceland, Liechtenstein and Norway have had close economic ties*

*with the European Union since the Community's early years. Granting them access to the .eu top-level domain is a natural step forward in that relationship."*

For more information please speak to your usual advisor.

**Author:** Charlotte Duly, Trade Mark Attorney

# > When IP rights collide: the impact of Trade Mark rights on a Design Registration

It can often be forgotten that trade marks do not exist in a vacuum; they sit alongside a myriad of other IP rights. Inevitably there are situations where a collision of rights occurs. The case of *Su-Shaun Chen v AM Denmark A/S* is an excellent illustration of this.

The case concerned an application for invalidity of a Registered Community Design for a type of cleaning product. The invalidation action was based on the rarest of marks, a Community Trade Mark Registration for a 3D mark. Therefore, the question of invalidity had to be decided on the basis of trade mark, rather than design, law.

Leaving to one side the question as to “distinctive sign” the court was asked whether the earlier trade mark was “used” in the later design. An overarching comparison of the design and trade mark was made noting their similarities and differences. In light of the major similarities between the mark and the design, it was decided that the differences were of a secondary nature when compared to those similarities. As such, and on the basis of an overall impression, the two were similar enough that the mark could be said to be “used” in the design.

The ultimate question was whether the mark /design were so similar and used on similar/identical goods to cause the consumer confusion. In this instance, the General Court of the EU found the goods were identical (cleaning products) and that the design and trade mark were similar. The design was therefore held to be invalid on the basis of the earlier trade mark right applying the test of trade mark law.



As a result the design owner attempted to argue that the earlier trade mark did not reach the ‘distinctive sign’ requirement. However, it is an established principle that a registration is prima face evidence of validity.

This therefore means the registered mark was regarded as having a minimum degree of distinctiveness. The court held that this was not open to debate in the current invalidity proceedings. The design owner made the mistake of not seeking to invalidate the earlier right but rather to use lack of distinctiveness as a shield. This highlights the importance of a properly thought through strategy in taking action. Whilst focus may be on defending an invalidation action, a more wide ranging and strategic approach is often needed as it may be necessary to invalidate the earlier rights in order to succeed.

Trade marks can impact on designs and designs can likewise impact on trade marks. If you have reason to believe that the shape of your products have begun to be recognised as badges of origin, or indeed if they are so unique as to fulfil this function, then it would be worth considering attempting to seek trade mark protection to try and secure a trade mark registration which is an extremely powerful right that can be used against designs, as well as trade marks.

**Author:** Peter Vaughan, Trade Mark Assistant

## > AdWords: an update

The UK position on trade mark infringement in relation to the use of AdWords was recently clarified in the decision of *Interflora Inc and Interflora British Unit v Marks and Spencer Plc and Flowers Direct Online Limited* [2013] EWHC 1291 (Ch), "*Interflora*" by Mr Justice Arnold.

Having considered the earlier European jurisprudence from the Google France cases, Mr Justice Arnold's decision in *Interflora* remained consistent with the EU position as he held that the use of someone else's trade mark as a keyword is not in itself trade mark infringement. Whether infringement has occurred will depend on whether an essential function of the trade mark has been adversely affected and this will be a finding of fact in every case.

Trade mark infringement will occur where an advertisement does not enable the reasonably well informed and reasonably attentive internet user, or enables them only with difficulty, to ascertain whether the goods and services advertised originate from the trade mark proprietor or

an economically linked undertaking. The onus is on the advertiser, not the trade mark owner, to show that the ad in question was clear as to where the goods or services advertised originate from.

Therefore, trade mark owners do not have the ability to prevent the use of their trade marks as keywords by competitors where the advertisement linked to that keyword is clear in identifying the source of the goods or services advertised and where the essential functions of the trade mark are not adversely affected. However, advertisers who decide to use their competitor's trade marks as keywords may find themselves bearing the burden of proving that reasonable internet users could not have been confused and that the marks have not been damaged.

For a more detailed review of the development of AdWords cases [click here](#).

**Author:** Anusha Arunasalam, Trade Mark Attorney

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## > New gTLDs – Donuts Protected Marks List

Donuts Inc. applied to run the registries for 307 new gTLDs. It is estimated that Donuts will eventually operate 200 of these, therefore acting as a registrar for a vast number of potential new domain names. They have already released a number of new domain name extensions including .bike, .holdings, .clothing, .camera and .land.

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In order to assist brand holders and alleviate potential concerns about new domain names that may conflict with trade mark rights, Donuts offer a product called the Donuts Protected Marks List (DPML).

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In order to assist brand holders and alleviate potential concerns about new domain names that may conflict with trade mark rights, Donuts offer a product called the Donuts Protected Marks List (DPML). Brand owners whose trade marks are recorded with the Trade Mark

Clearing House (read earlier **Bulletins** on this topic) can apply to have their marks recorded on the DPML. Once Donuts have accepted the trade mark on to the DPML, that trade mark will be blocked from registration within a new domain name for all Donuts' new gTLDs for an initial period of five to ten years. The DPML subscription can then be renewed. This means that rights holders can block their trade marks from being registered by a third party within a domain name for every one of the new Donuts' extensions thus preventing the need for defensive domain name registrations.

The DPML only applies to Donuts' new gTLDs. With approximately 1,400 new gTLDs expected, the DPML may not initially look attractive but Donuts will operate a number of very popular extensions. The cost of recording a mark on the DPML is high at approximately US\$3,000 for a five year term and there are a number of caveats and exceptions. However, for those rights holders who are concerned that their trade marks could become the subject of numerous new domain names with a Donuts administered extension, recording trade mark registrations on the DPML may alleviate some concerns.

**Author:** Charlotte Duly, Trade Mark Attorney

## > Evidence of use



Whether you are a trade mark owner or a party looking to enforce unregistered rights, you will no doubt have experienced the potentially time consuming and soul destroying experience of evidence collation. This process need not be as daunting as it sounds.

With this in mind, we have prepared the following advice to help you prepare for the day when you will need to provide evidence of use of your trade mark.

### When is evidence of use required?

In addition to defending and maintaining your registrations, proof of use may also be required when trying to enforce your rights. By way of example, proof of use could be required in the following situations:

- Opposition or invalidity proceedings before the UKIPO and OHIM where the earlier registration is more than five years old or the Opponent has claimed a reputation or unregistered rights as a basis for opposition.
- In defence of non-use revocation proceedings against a UK or CTM registration that is more than five years old.
- Infringement or passing-off proceedings in Court where the earlier registration is more than five years old or the Claimant has claimed a reputation or unregistered rights as a basis for taking action.
- To prove acquired distinctiveness for an otherwise unregistrable mark.
- To obtain registration in some territories where a Declaration of Use must be filed, for example in Canada and the USA.
- To support a Declaration of Use and/or renewal application for some foreign registrations, for example in the USA.

### What constitutes evidence of use?

You will need to provide evidence of use of the mark as registered (or with differences that are so insignificant that they would go unnoticed by the average consumer) and in relation to the goods and services covered.

For the purpose of proving use of a mark, suitable forms of evidence include photographs of the mark in use, copies of advertisements and marketing materials, invoices and brochures.

In proceedings where you are required to prove the extent of your use, for example following a claim of reputation or unregistered rights, you will likely need to provide details of your turnover and sales figures, price lists, annual reports, customer and/or market surveys, third party articles or publications regarding you and your mark and details of any awards won etc.

### How can the burden be eased?

As can be seen, evidence of use of a mark is required in a wide range of situations and sometimes deadlines can be short. To ease the burden, we recommend the following:

- Take photographs of your products and packaging once a year.
- Keep a copy of any brochures or marketing materials that you produce and make a note of where they have been circulated and when.
- Keep a copy of your advertisements and any third party publications about your business, and make a note of where they were placed and when.
- Keep a selection of invoices issued to clients each year in all of the territories where you have sold your goods or provide your services.
- Keep a log of your turnover and sales figures for each year, broken down by territory.
- Keep downloads from your website featuring the mark in use and information as to the number of hits/visits to it.

An important point to be made is that the evidence must show use of the mark as registered. If you make any amendments to the way in which you display your mark then please contact us so that we can review your mark in use to ensure you have adequate protection.

**Author:** Lisa Ormrod, Trade Mark Attorney

## > Glasgow 2014: Bracing for an ambush in the run up to the 2014 Commonwealth Games



This summer Glasgow, the largest city in Scotland, will welcome hundreds of sports men and women as well as thousands of supporters and visitors for the 2014 Commonwealth Games. Following their successful bid to hold the event, one of the central priorities of the Organising Committee (Glasgow 2014 Ltd) was to satisfy the Commonwealth Games Federation's requirements in respect of providing support and protection for the sponsors of the event.

The trade marks of the Games are legally protected by a combination of registered trademarks, copyright, UK registered designs, and common law. However, as well as protecting the integrity of the Games and its branding, the aim is to ensure that those businesses which are not official sponsors do not gain financially from being associated with the Games through what is often described as ambush marketing.

Ambush marketing campaigns come in a variety of forms, but at their core they are focused on drawing

attention from one brand, usually an official sponsor, onto another through various creative efforts. They can come

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in crude forms such as the unauthorised use of logos and designs associated with the event to more subtle examples, where the public are misled or confused about who is actually sponsoring the event. In other words, these parties will attempt to use an association with Glasgow 2014 to generate commercial income without paying the Organising Committee for the right to do so.

The attraction of ambush marketing is obvious. Often more money is spent by non-sponsors than those who sign up to officially sponsor such events. Some common methods include association with individual sports stars rather than

teams, parodying official ads, the use of public domain imagery, association with the sport rather than the event and use of retired sports men and women in advertising campaigns.

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One example of an ambush strategy occurred in the 2010 World Cup during a match between Denmark and Holland, when 36 girls in mini-skirts were accused of being models for the Dutch beer Bavaria and attempting to ambush the World Cup and its official beer sponsor, Budweiser. They were removed from the stadium.

More recently during the London 2012 Olympic Games Nike, who were not an official sponsor, stole attention from the commercial rival Adidas through their effectively designed neon yellow VOLT shoes which were worn by some of the prominent sports stars. The vivid colour drew a wave of attention to the Nike brand.

Similar to the London Olympic and Paralympic Games Act 2006, the Glasgow Commonwealth Act 2008 (Games Association Right) Order 2009 was drafted to attempt to limit ambush marketing campaigns by non-sponsoring brands during the event. The Order gives the organisers the right to both restrict and authorise certain parties to associate themselves with the games as well as providing additional protection by introducing the offence of creating an unauthorised commercial association between people, goods or services and the Games.

While it is difficult to envisage all the possible ways ambush marketers will strike, the organisers have had the opportunity to learn from, and build upon the lessons of past events, especially the 2012 London Olympic Games, to formulate a policy for upcoming and future events. For instance, during the London Olympics, only Visa (a main sponsor) credit cards were accepted in the Olympic village; there was an official non-sponsoring brand exclusion zone; property owners in the vicinity were restricted from selling advertising space to non-sponsors and athletes' endorsement of non-sponsoring brands was restricted on social media such as Twitter.

It remains to be seen what affect the legal and policy deterrents will have on potential ambush campaigns in Glasgow. How ambush marketeers will creatively adapt their efforts to circumvent the legislation remains to be seen. So let the Games begin...

**Author:** Sinead Quigley, Trade Mark Assistant

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## Madrid Protocol subsequent designations – what you need to know

One of the benefits of a Madrid Protocol registration is the ability to subsequently designate other territories as and when they become of interest, thus increasing the scope of protection. Of the 91 members of the Madrid Protocol, just five cannot be subsequently designated where a Madrid Protocol registration was filed before that country became a party to the Protocol. Those relevant territories, with their date of joining, are as follows:

Estonia	–	18 November 1998
India	–	8 July 2013
Namibia	–	30 June 2004
Philippines	–	25 July 2012
Turkey	–	1 January 1999

These countries are able to refuse subsequent designations under Article 14(5) of the Protocol which states that, *“Any State or organization ... may...declare that the protection resulting from any international*

*registration effected under this Protocol before the date of entry into force of this Protocol with respect to it cannot be extended to it”.*

Any Madrid Protocol application filed after the territory in question became a party to the Protocol can be extended subsequently to designate that party. For example, a Madrid Protocol application filed on or after 30 June 2004 can subsequently designate Namibia but one filed prior to this date cannot. Of course, any new Madrid Protocol application can designate these five territories.

It remains to be seen whether this policy, in particular in the case of India, whose joining of the Protocol was long anticipated and is the most recent of these five territories to join, will deter use of the Protocol to obtain protection in this territory.

**Author:** Charlotte Duly, Trade Mark Attorney

## > Dot London gTLD launch

London is set to play a part in internet history when it becomes one of the first cities in the world to have its own domain name extension. The new “.london” generic Top Level Domain (gTLD) is set to be rolled out between Spring and Summer 2014.

Until recently, gTLDs were limited to a closed list of suffixes that most people will be familiar with, such as .com, .net, .org or country codes such as .fr or .co.uk. The opening up of the internet naming system, which is being coordinated by the Internet Corporation for Assigned Names and Numbers (ICANN), has seen nearly two thousand applications for new gTLDs submitted. These applications are currently being processed by ICANN. At time of writing 200 applications had been given the go-ahead by ICANN, including the .london application.

London joins the likes of Paris, Berlin, Vienna, Tokyo and New York City, all of whom have also opted to plant a virtual flag pole in this brave new digital world, in the hopes of boosting local business and opening up choice in the market for domain names.

Second level domains under the .london top level domain are expected to be available to register from Spring 2014, with the first .london websites likely to go live in the summer.

For further information please contact your usual adviser.

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Regulated by IPReg

There will be a “Sunrise” period prior to the launch of .london, in which owners of registered trade marks which have been recorded with the Trade Mark Clearing House

will be given the first chance to acquire .london addresses corresponding to their trade marks. This will be followed by the “Landrush” phase, in which interested parties will be invited to bid for popular domains. It will also be possible to reserve domain names in advance of the launch. Any reserved domain names which are not claimed during the Sunrise or Landrush periods will be automatically sold to the reservation holder.

While the introduction of new gTLDs undoubtedly gives more choice to consumers and businesses and presents excellent opportunities to be more creative with web presence, it is expected that cyber squatters will also look to benefit from

this and from any confusion that may arise during the transitional period. Clients would be well advised to review their existing domain name policies and consider whether it might be appropriate to defensively register any second level domain names under any of the new gTLDs to be launched. Clients should also consider recording their trade marks with the Trade Mark Clearing House in order to benefit from Sunrise periods during the launch of .london and any other new gTLDs.

**Author:** Donna Trysburg, Trade Mark Assistant

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If you would like any further advice on securing a .london domain, preventing third parties from registering your trade mark as part of a .london domain or on new gTLDs more generally, please contact your usual Boulton Wade Tennant advisor.

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