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Boult Wade Tennant's trade mark team at INTA 2016

Summer special

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Editor:

Emma Pitcher, Partner
Rachel Conroy, Attorney

Three of Boult Wade Tennant's award winning trade mark specialists John Wallace, Managing Partner, Tony Pluckrose, partner and Emma Pitcher, partner and chair of INTA's Non-traditional Trade Marks Committee, will be amongst the 9,700 experts from around the world attending the International Trademark Association's 138th annual meeting in Orlando.

This year's INTA annual meeting will encompass numerous committee and client meetings, business development and networking opportunities and educational programmes which will run over the five days.

If you are attending INTA 2016 and would like to get in touch, please contact one of our partners below.



John Wallace
Managing Partner
Head of Trade Mark
and Domain Names Group
jwallace@boult.com



Tony Pluckrose
Partner
Trade Mark and
Domain Names Group
tpluckrose@boult.com



Emma Pitcher
Partner
Trade Mark and
Domain Names Group
epitcher@boult.com



Brexit? – no sweat, for Boulton Wade Tennant!

A referendum will be held on the 23 June 2016, where the British electorate will vote to decide whether to remain a member of the European Union or exit from it. Boulton Wade Tennant is eyeing expansion into the wider EU, so watch this space.

We know there are doubts and fears surrounding the Brexit issue but rest assured Boulton Wade Tennant is in an excellent position to continue to provide the same high quality advice and service to our existing and new clients. Whatever the outcome of the referendum you are in safe hands so don't sweat it!

For further information or should you have any questions on the Brexit issues, please contact your usual Boulton Wade Tennant advisor.

Author: John Wallace, Managing Partner

Ending the abuse – Domain name recovery mechanisms

The internet is now inextricably linked to how brands promote their business and sell to the consumer. One of the most important facets of an online presence is a website which requires a domain name. The first time a consumer will encounter your brand is often through an internet search.

But what happens when a domain name appears which mimics your own; confusing consumers or causing harm to your brand? This is an increasing problem due to the virtually unlimited number of domain names available and the practical impossibility of owning every single domain name that might correspond to your brand.

Fortunately it may be possible to take action against the owner of such a domain name with a view to forcing its transfer to you. The Rights Protection Mechanisms (RPMs)

adopted by the domain registries allow action to be taken swiftly, at relatively low cost and under certain conditions. The two main mechanisms of likely interest to UK brand owners are the Uniform Dispute Resolution Process (UDRP) and the Nominet Dispute Resolution System (DRS).

The UDRP applies to many different domain endings (formerly known as Top Level Domains: TLDs) such as .com, .net, .org and all the new gTLDs such as .london and .sucks and has worldwide application. The DRS applies to .uk and .co.uk domain names and is UK based.

Using these RPMs it may be possible to recover a domain name without having to launch trade mark or passing-off infringement proceedings in court which can be costly and as such should only be considered in the most serious cases.

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Although the entry requirements differ slightly between the DRS and the UDRP it is generally possible to recover a domain name where you have rights which are identical or similar to the domain name and where the domain name is registered and used in bad faith (UDRP) or is an abusive registration (DRS).

The requirements are broad in scope and give many opportunities to set out a cause of action. Some can be straightforward; others can require significant evidence. These RPMs are therefore not an option which is available in each case – more complex situations are still better suited to the courts.

Examples where brand owners can seek to recover a domain name using these RPMs are; a domain name which is set up to confuse consumers into believing there is a connection with you (such as “typosquatting” or sites attempting to trick consumers into believing that there is such a connection); a third party buying a domain and immediately offering to sell it to you at a premium; or a domain name which hosts sponsored adverts on a site which relates to you. Well known marks can also enjoy special protection under these Mechanisms.

These Mechanisms are not, however, a blank cheque to recover a domain name which you would like in your portfolio. There are limits and defences which apply and it is important to carefully consider whether filing a complaint will succeed and may in itself be regarded as an abuse of process. It should be noted that the burden of proof in such cases is on the complainant. And as with

any case involving issues of bad faith the standard of proof is high, generally more so than required in a straightforward infringement or passing off case.

At Boulton Wade Tennant we have considerable experience in this area and have successfully acted for many clients in securing transfer of domain names which were of concern, for

example, www.octopus.com and www.etyres.com. If you come across a domain name which you believe is taking advantage of your brand, or is causing harm, please contact us and we would be happy to discuss with the options available to you.

Author: Peter Vaughan, Attorney

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Evicting company name squatters – the company names tribunal

In today's fast paced and competitive marketplace brand owners necessarily invest a considerable amount of their budget in protecting IP rights as they are often the core element of their business. Brand owners should note that the Companies Names Tribunal (CNT) provides a low cost tool and an addition to their protective arsenal.

The CNT was established by section 69 of the Companies Act, 2006 and the adjudicators are made up of officials of the UKIPO who also deal with trade mark matters. Similar to the procedures for taking action against domain name cyber-squatters, the rationale behind this provision is to stop company name 'squatters' intending to take advantage of the goodwill or reputation of a complainant's name or trade mark, often with the intention of obtaining money from them or preventing them from registering the name.

The procedure is relatively quick. If successful it will result in the removal from or renaming of objectionable companies or limited liability partnerships on the UK Companies Register, who are considered to have *opportunistically* adopted names which are the same [69(1)(a)] or *sufficiently similar* [69(1)(b)] to a name associated with the complainant in which they have goodwill. Costs may also be awarded at the discretion of the adjudicator.

The complaint must set out the reasons why the use of the name would likely mislead in the UK by suggesting a connection between the new company and the applicant. The initial official fee for submitting a complaint is £400. While most applications are undefended, the UKIPO issues about six to eight contested written decisions a year. Oral hearings are not common. Usually the decision is made from the papers.

If the complainant can show that they meet the requirements of section 69, the complaint will be upheld

unless the respondent submits evidence demonstrating that the complaint does not meet the correct criteria to bring the action and/or one of following the statutory defences apply:

- The name was registered before the applicant began the activities on which it is relying to show goodwill;
- The respondent is already operating under the name, is proposing to do so and has incurred substantial start-up costs in preparation, or was operating under the name but it is now dormant;
- The name was registered in the ordinary course of a company formation business;
- The disputed name was adopted in good faith;
- The interests of the applicant are not adversely affected to any extent.

While a CNT application can be filed at any time, action should be taken as quickly as possible once there is real cause for concern. It is important not to overlook the possible defences when considering the merits of bringing the complaint. Some investigation into the new company and its choice of name may be necessary before the complaint is filed to consider whether action under trade mark infringement or passing off provisions would be more effective.

One way to ensure early knowledge of conflicting company names which might be challenged through the CNT process is through setting up a company names watching service which monitors the UK Companies Register for new identical or similar names.

If you would like any further information on this service or to take action against a company name of concern to your business please contact your usual advisor at Boulton Wade Tennant.

Author: Sinead Quigley, Assistant