

Boult.bites™

S P R I N G I S S U E

It won't be long until the Boult Wade Tennant trade mark team attend the International Trade Mark Association's upcoming 139th Annual meeting in beautiful Barcelona.

INTA is always a big event in the trade mark calendar as it provides a forum for catching up with colleagues, as well as discussion of key business issues surrounding intellectual property and brand strategy. Joining me will be trade mark partners: **Tony Pluckrose**, **Emma**

Pitcher, **Catherine Wolfe**, **Felicity Hide** and **Charlotte Duly**, along with a number of attorneys from our **award-winning** group. Do get in touch with your usual Boult Wade Tennant attorney to arrange a meeting at INTA.

So far 2017 has presented us with a plethora of interesting cases and in this edition of Boult.bites, we look at the need to be prudent when dealing with trade mark law in China; we analyse if your name can be separated from

your person; we highlight the use of trade marked keys words in SEO campaigns, and finally offer a useful **reminder** of the difficulties claimants face when establishing a successful passing off claim, in relation to get-up.

John Wallace

Managing Partner and Head of Trade Mark and Domain Names Group

Cherry picking: Michael Jordan's trade mark battle in China

Boult.bites™ has **previously** touched on the battle in China over Michael Jordan's name. Qiaodan Sports Co, based in China, has held a number of registrations for Michael Jordan's name in English and Chinese. Apparently Qiaodan Sports have been using and registering the various marks for approximately two decades but they were sued in 2012 by Jordan who objected to the use of his Chinese name "Qiaodan" (pronounced "Chee-Ow Dahn") and his jersey no. 23 to sell basketball jerseys and shoes. Jordan was concerned that Chinese consumers would be misled into believing that he had authorised the products. In a decision issued at the end of 2016, the Chinese Supreme Court found that Qiaodan Sports must stop using the Chinese characters equivalent to Qiaodan, which is the Chinese script version of Jordan's name. However, Qiaodan Sports have not been stopped from using the phonetic spelling of this mark using English characters.

This is not the end of the matter and we understand that proceedings are ongoing in China. It will be interesting to see who can claim victory overall once all the proceedings are concluded.

Elsewhere, the Lego Group announced that a new Lego factory in Jiaxing, China opened in 2016. A recent news report found that copycat figures are an issue and Richard Wong, General Manager of Asia Manufacturing, Lego, could not tell the real figure from the fake one.

The trade mark law in China is evolving and attitudes towards who should own a trade mark are developing. However, the law and the practice in this area is not as developed as it may one day become. Trade mark registrations are respected in China and being the first to register cements your rights there. It is therefore prudent to file applications for your trade marks in China if you use them there, or anticipate using them there in the near future, just in case someone else gets in there before you.

Author: Charlotte Duly, Partner

News from the Trade Mark team

- > Boult Wade Tennant has been ranked in the top tier of the UK Trade Mark Agency category by the **World Trade Mark Review 1000** for another consecutive year.
- > Trade mark partners Tony Pluckrose, Emma Pitcher, and Catherine Wolfe have recently been named in WIPR Leaders 2017 **handbook**.
- > Boult Wade Tennant's trade mark practice have co-authored the UK chapter of the Chambers and Partners Global Practice Guide trade marks guide, alongside colleagues at Reed Smith LLP. Read the full article **here**.
- > Partner **Tony Pluckrose** was recently invited to speak at an event hosted by the Creative Industries Federation in partnership with Alliance for Intellectual Property. Tony's presentation focussed on "Making the intangible tangible", in relation to valuing your business IP. To contact Tony to discuss matters relating to your own business's IP, please click **here**.
- > **Emma Pitcher**, Partner, will be speaking the American Bar Association's 32nd Annual Intellectual Property Law **conference** in April. Emma will be part of a panel reviewing the effective use of border enforcement mechanisms and consider the need for blocking orders to stop the sale of counterfeit products globally.
- > Partner **Catherine Wolfe** has been invited to speak at the ECTA 36th Annual conference on the legal consequences of Brexit. This year's conference will be held in the Hungarian capital Budapest, between 28 June-1 July. The theme for this year is 'connections'. Click **here** for further information on the event.

What's in a name? Can your name be separated from your person?

Arrom Conseil v EUIPO (other parties before EUIPO: PUIG France SAS in Case T-358/15 and Nina Ricci SARL in Case T-359/15)

Arrom Conseil ("the Applicant") applied to register the following figurative trade mark for goods spanning perfumes and clothing items:



The inclusion of "Romano Ricci" in the mark applied to lead to oppositions based on earlier rights in NINA RICCI and RICCI. The oppositions by Nina Ricci SARL and PUIG France SAS ("the Interveners") argued that there existed a likelihood of confusion as the relevant public would associate the mark applied for with the earlier marks, leading to a likelihood of confusion, and that Nina Ricci had gained a reputation in the EU; thus, the mark applied for should not be registered.

These above arguments were upheld by the Board of Appeal and the Applicant appealed to the General Court ("GC").

An interesting aspect of this case arises from the argument given by the GC in response to the Applicant's plea concerning reputation of the earlier rights. The Court had to consider whether the mark applied for would cause detriment to the repute or distinctiveness of the mark NINA RICCI, particularly if unfair advantage had been taken of the distinctive character or the repute of that mark.

The Applicant argued that unfair advantage would not be taken and claimed 'due cause' for the registration and use of the mark as Romano Ricci was the name of the founder of the Applicant. To add further complication to the matter, Nina Ricci is Romano Ricci's great grandmother.

The GC upheld the Board of Appeal's rejection of this argument when considering this point of law. They stated that neither the regulation nor case-law provides any sort of unconditional right to the registration of a first name or a surname. The Applicant also did not give any arguments explaining how the relationship between the parties could constitute due cause for registration of the mark. This decision seems to separate any ability to use a mark from registration and confirms that there is no right to a registration, even if the mark is for an own name that can be legitimately used.

A further interesting point to add to the discussion of these cases is the finding that there exists a likelihood of confusion between the marks due to the common "RICCI" element. It can be argued that the Court's argument of a 'certain' visual and phonetic similarity could lead to an appeal. Although the GC did take into consideration that the other word elements of the contested mark were 'visually striking', the court ultimately decided that the second element 'by Romano Ricci' would attract the relevant public's attention and lead to conflict with the earlier rights.

Author: Lana Yahya, Trade Mark Assistant

Plumbing the depths of keyword use in online advertising

Victoria Plum Limited v Victorian Plumbing Ltd [2016] EWHC 2911

This was a case examining the interaction between Adwords and trade marks, a topic which is becoming increasingly important to brand owners as they compete for visibility in search results.

Victoria Plum (previously Victoria Plumb) and Victorian Plumbing both operate online plumbing stores and have traded alongside one another for a number of years. There was no attempt by either party to stop the other using its name.

Victoria Plum, the Claimant, was however objecting to Victorian Plumbing, the Defendant, using their marks, and marks which were confusingly similar, as keywords for securing adverts on Google.

There are several leading cases regarding the use of competitor's trade marks as keywords. These have established that although such use can constitute use of a trade mark it can be acceptable where the adverts are "transparent" as to the source of the advert. Although there are some other factors, put simply, it must be clear that the advert does not relate to the competitor whose mark you are using as a keyword. This approach is justified on the basis of encouraging competition and thus consumer choice.

This case, however, highlights some of the boundaries of this approach. Here the two marks were sufficiently similar that the transparency requirement could not be met. It was not possible for a consumer to determine from whom the underlying advert originated. Consequently the use was not permissible and trade mark infringement was found.

It had also already been accepted that there was infringement where the keyword of the competitor was appearing in the advert itself – this clearly did not meet the requirement for transparency.

This case highlights the risk of using a competitor's trade mark where there is a high degree of similarity between the marks. It is also a useful reminder that the right to use a competitor's marks as keywords in search engine adverts is not unfettered and there must be a focus on ensuring that the advert is clear as to where and who the advert will direct.

A defence of honest concurrent use was run to try and introduce the long running co-existence between the parties. This is a developing area of trade mark law but in this instance was given short shrift. The defence applies to use of your own mark, not that of a competitor.

Finally a word of caution. The Claimant had also been using the Defendant's mark as their keyword. By the time of the trial this had stopped but the Defendant was able to counter-claim for passing off. One can only imagine the knots the Claimant tied themselves in trying to argue their use was acceptable where the Defendant's was not! Inevitably they could not show such use was acceptable and the counter-claim for passing off succeeded. A very clear example of if you don't like it yourself, then don't do it to someone else!

Author: Peter Vaughan, Trade Mark Attorney

Measuring the law of passing off and get-up

George East Housewares Limited v. Fackelmann Gmbh & Co Kg and Probus Creative Housewares Limited [2016] EWHC 2476 (IPEC)

This decision from the UK Intellectual Property Enterprise Court (High Court of Justice) is a useful reminder of the difficulties faced by claimants when trying to establish a successful passing off claim in relation to get-up. The case ([full decision here](#)) also contains a very useful walkthrough of the case law and jurisprudence behind this area of UK trade mark law.

In brief, the claimant has manufactured and sold conical measuring cups in the United Kingdom for many years, with claimed sales of up to 100,000 units per year. The measuring cups are made of stainless steel, have stripes of bold colour to their exterior, and have measuring guides printed on the inside of the cones.

At a trade fair in Birmingham in February 2013 (the relevant date) the claimant saw the defendant's measuring cups, which bore a striking resemblance. In fact, the defendant's measuring cups even had similar interiors, even with some of the same (intentional) typographic errors on some of the measuring guides and an identical misplaced apostrophe.

The claimant complained to the defendant (Probus who imported the goods to the UK), but in spite of certain assurances, the defendant's measuring cups continued to be imported into the UK in 2013 to 2015. The claimant then filed its claim at the Intellectual Property Enterprise Court in March 2015.

Read the full story [here](#).

Author: **Luke Portnow**, Trade Mark Attorney

EDITORS

Emma Pitcher, Partner
Charlotte Duly, Partner

CONTRIBUTORS

Luke Portnow, Trade Mark Attorney
Peter Vaughan, Trade Mark Attorney
Lana Yahya, Trade Mark Assistant

> Missed the last edition of **boul.t.bites**™? Catch up by clicking [here](#)



Meet the trade mark team at INTA

Like us, the International Trade Mark Association is preparing for the 139th Annual INTA Meeting. This year's meeting will take place between 20-24 May in Barcelona, the cosmopolitan capital city of Spain's Catalonia region.

The annual meeting provides extensive learning opportunities, with almost 300 customized educational opportunities and over 30 INTA-hosted networking events running over the five days. We look forward to seeing many of you. To arrange a meeting with a member of our Trade Mark team, please click [here](#). Alternatively, please contact one of our attending partners below.



John Wallace
Managing Partner
and Head of Trade Mark
and Domain Names Group

[View profile](#)



Tony Pluckrose
Partner

[View profile](#)



Emma Pitcher
Partner

[View profile](#)



Catherine Wolfe
Partner

[View profile](#)



Felicity Hide
Partner

[View profile](#)



Charlotte Duly
Partner

[View profile](#)

WHAT WE DO



MEET THE TEAM



PUBLICATIONS



We aim to work with our clients, not just for them