

A belated Happy New Year.

This year marks a milestone for the firm. In 2019 we will be celebrating our **125th anniversary**. In 1894 Alfred Boult and Harold Wade formed the origins for this firm (read a detailed history [here](#)). In the 125 years since, we have grown to become a leading European firm with an international presence, consisting of a team of over 200 people including 34 partners, stretched across five practice groups and seven offices in three different countries. We could not have achieved this without our loyal friends, clients, and colleagues. I would like to take this opportunity to thank you all for being part of our exciting journey so far, and invite you to celebrate with us throughout the year.

I am also delighted to announce the opening of our Berlin office. The new office location will further strengthen the firm's presence in Europe, Madrid having opened last year. The centrally located office is on one of the most famous avenues in Berlin and will be headed up by Partner Michael C. Maier. You can get to know Michael in our Q&A with him, below.

Now back to what we do best. In this edition we caution brand owners about applications by Gleissner; look at a modern day David and Goliath story involving McDonald's and Irish rival Supermac's; cover recent changes to UK TM law to be aware of; Canada's new trade mark law coming into force later this year; and the latest developments in the Cadbury V Nestlé chocolate wars.

**John Wallace**, Managing Partner and Head of Trade Mark and Domain Names practice group



## HEADLINE ARTICLES

### Welcoming Michael C. Maier to the Boult Wade Tennant family

We are delighted to welcome Michael C. Maier as a Partner in the Trade Mark and Domain Names practice group, and also head of our newly opened Berlin office. Read on as Michael talks to us about IP trends, Brexit challenges, and the exciting city of Berlin.

#### Key IP trends in Germany

Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 has now been implemented into German trademark law with effect of January 14, 2019. The new legal situation will bring various changes for trade mark applicants: for example the requirement of graphical representation when filing a German trade mark application has now been removed, opening a door to new and creative trade mark forms; also it is interesting to note that it is now possible to record a license in the register which was previously not the case; on a more formal side it is important to note for all new trade mark applications the term of protection will now be calculated differently, i.e. 10 years starting from the filing date and no longer 10 years from the end of the month in which the trade mark has been applied for; finally it should be noted that starting from May 2020 cancellation actions based on relative grounds can also be filed before the German Trade Mark Office.

#### European companies need to be ready for...

Political and economic changes, and high competitive pressure.

#### The challenges that Brexit pose for UK businesses

UK businesses will have to thoroughly re-assess their current IP strategies.

#### My leadership motto

Take time and listen to your team mates to understand their needs and motivations

#### Best advice I have received

"Machen und lachen" which basically means: just do it, laugh, enjoy the moment and not to be afraid to fail.

#### My favourite thing about Berlin

As a "real" Berliner I know the city like the back of my hand. Nevertheless, Berlin always offers a surprise – it is constantly changing, i.e. every month there are new clubs, new restaurants etc.; it never becomes boring.

#### My way of unwinding

Being in the music studio and composing new songs

Author: **Michael C. Maier**, Partner



## NEWS FROM THE TEAM

> Partner's **Tony Pluckrose** and Michael Maier will be attending the **INTA Europe Conference**, 18-19 February in Paris. The theme of this year's conference is "Embracing Change".

> Partner **Emma Pitcher** will be attending the American Bar Association's (ABA)-**IPL Annual Meeting and 34th IP Law Conference**, 10-12 April, in Arlington.

> Partner's **Tony Pluckrose, John Wallace, Emma Pitcher, Simon Kahn, Michael Maier** and **Álvaro Cabeza** will be in Boston from 18-22 May for the **141st INTA Annual Meeting**. Topics being covered at this year's conference include: combatting counterfeits and piracy on the internet and in digital media, GDPR, AI; the future of IP law firms in the digital age; and maximizing the perspectives around us.

Please do **get in touch** if you would like to arrange a meeting with any of our Partners at any of the conferences mentioned above.

# Trump Card – Gleissner meets his match...

The business of Mr Michael Gleissner and the numerous companies under his control have been attracting attention for some time.

Typically, Mr Gleissner will file an application for a well-known name and, simultaneously, will file to cancel the brand-owner's registration for that name on non-use grounds. At first glance, it is hard to see the threat to the brand-owner: if they have used their trade mark, then they will be able to provide corresponding evidence of use of that mark at the relevant Patent Office, and save their registration from cancellation. However, Mr Gleissner is taking advantage of the fact that it is time-consuming and expensive to put together a comprehensive dossier of evidence which will satisfy the Office's exacting requirements. It has happened that the evidence has been found insufficient, and Gleissner has been successful in his cancellation actions. This leaves the brand-owner in the invidious position of first having no registration of its own left, and second of infringing the Gleissner registration. It is likely that any such situations could eventually be resolved through a combination of bad-faith and common-law grounds used against Gleissner, that process is costly and uncertain.

However, given the very many such applications and cancellation proceedings brought by Gleissner, the resulting decisions make for interesting reading. Perhaps the most high-profile was a Gleissner application to register the trade mark TRUMP TV, opposed by the businesses owned by Mr Donald Trump. The latter successfully opposed the Gleissner UK trade mark application on bad faith grounds, and the Registrar made an award of costs off the usual scale.

There may also be a further obstacle to Mr Gleissner's activities at the European Intellectual Property Office. One of Mr Gleissner's cancellation applications was successfully struck-out altogether on "abuse of process" grounds, the first time that this has been done successfully at the EUIPO. That case is currently under appeal by Gleissner to the EUIPO's Grand Board of Appeal, but if the strike-out decision stands, then that is an easier route to fight any Gleissner attack than the process of putting together evidence of use.

For the moment, it is important that brand owners are aware of the possibility of such an attack, and that they have solid registrations themselves, evidence of use to hand ready to submit, and a watching service in place to catch and oppose any applications by Gleissner to register their brands. This is particularly true in Benelux, where most of Mr Gleissner's trade mark application processes begin.

**Author: Felicity Hide, Partner**

## Big Mac, big problem

### **EUIPO Revocation No 14 788 C Supermac's (Holdings) Ltd v McDonald's International Property Company, Ltd**

The EUIPO's Cancellation Division has just issued a decision in case No 14 788 C, revoking McDonald's EUTM registration No 62 638 for BIG MAC in classes 29, 30 and 42 in its entirety on the grounds of non-use.

Supermac applied to revoke the BIG MAC registration on the grounds it was not put to genuine use during the five year period following the date of registration in relation to any of the registered goods and services. McDonald's filed evidence of use that included a claim of significant sales in relation to 'Big Mac' sandwiches along examples of the product packaging, promotional brochures, menus, and website pages.

The Cancellation Division were critical of the evidence, noting that whilst some of the evidence related to the relevant time period and to some of the Member States of the EU, McDonald's failed to prove the extent of use of its mark. Furthermore, the EUIPO generally values independent, third party evidence above that emanating directly from the proprietor.

In relation to the website print outs, the Cancellation Division stated that *"the mere presence of a trade mark on a website is, of itself, insufficient to prove genuine use unless the website also shows the place, time and extent of use or unless this information is otherwise provided"*.

To further strengthen the value of the website extracts evidence was required that the specific website has been visited (e.g. data on internet traffic/ hits per day from within the EU) and that orders for the relevant goods and services have been made through the website by a certain number of customers in the relevant period and in the relevant territory. There was no evidence of being able to purchase the goods online nor of a single order being placed through McDonald's website, meaning a connection could not be made between the website and the items sold.

The Cancellation Division also noted, as they have in previous decisions, that Wikipedia entries cannot be considered as a reliable source of information.

The Cancellation Division found the evidence as a whole did not provide conclusive proof that the goods or services were offered under the BIG MAC mark in the EU within the relevant period. Revoking the registration, the Cancellation Division reminded the parties that *"[i]t is up to the EUTM proprietor to show such use in a manner which allows a reasoned conclusion to be made that the use is not merely token"*.

The decision can be appealed and we note McDonald's also hold a later registration for BIG MAC that cannot be challenged for non-use at this stage.

**Author: Charlotte Duly, Partner**

# New Year, new UK trade mark regulations

UK trade mark regulation No. 825 came into force on 14 January 2019, implementing the 2015 EU Trade Mark Directive. Most of the amendments are familiar as the changes have already occurred in relation to EUTMs but this is a good point to refresh our understanding of the new provisions.

## Proof of use in trade mark opposition and invalidity proceedings

One of the significant changes for rights holders are the new periods for which use must be proven in relation to registered trade marks.

In opposition proceedings, the five-year period will now be calculated from the filing date of the opposed application (or, if applicable, the priority date) where the registration of the earlier trade mark was completed before the start of that period. Previously this period was calculated from the publication date of the opposed application. For example, under the new system if an application is filed on 14 December 2018, without claiming priority, and is published on 14 January 2019 and opposed based on an earlier UK or EUTM registration that was registered/granted on or before 14 December 2018, genuine use will need to be proven for the period 14 December 2013 to 13 December 2018.

An applicant for a declaration of invalidity on relative grounds has to meet two 5-year periods: the first remains as before, namely the five years ending with the filing date of the declaration of invalidity; the second period is new and requires the applicant to also prove use of the mark before the later mark was filed, namely in the five-year period ending on the filing date of the later mark or, if applicable, the priority date. This second period will only be required where, at the relevant date, the earlier mark had already been registered for more than five years.

As before, key principles from case law such as *Ansul* (C-40/01) and *La Mer* (C-259/02) still apply, and as such the use must be genuine, actual use that is not merely token, with the intention of creating or maintaining a market share for the goods/services of the registration. UK trade mark regulation No. 825 came into force on 14 January 2019, implementing the 2015 EU Trade Mark Directive. Most of the amendments are familiar as the changes have already occurred in relation to EUTMs but this is a good point to refresh our understanding of the new provisions.

## Proof of use in trade mark opposition and invalidity proceedings

One of the significant changes for rights holders are the new periods for which use must be proven in relation to registered trade marks.

In opposition proceedings, the five-year period will now be calculated from the filing date of the opposed application (or, if applicable, the priority date) where the registration of the earlier trade mark was completed before the start of that period. Previously this period was calculated from the publication date of the opposed application. For example, under the new system if an application is filed on 14 December 2018, without claiming priority, and is published on 14 January 2019 and opposed based on an earlier UK or EUTM registration that was registered/granted on or before 14 December 2018, genuine use will need to be proven for the period 14 December 2013 to 13 December 2018.

An applicant for a declaration of invalidity on relative grounds has to meet two 5-year periods: the first remains as before, namely the five years ending with the filing date of the declaration of invalidity; the

second period is new and requires the applicant to also prove use of the mark before the later mark was filed, namely in the five-year period ending on the filing date of the later mark or, if applicable, the priority date. This second period will only be required where, at the relevant date, the earlier mark had already been registered for more than five years.

As before, key principles from case law such as *Ansul* (C-40/01) and *La Mer* (C-259/02) still apply, and as such the use must be genuine, actual use that is not merely token, with the intention of creating or maintaining a market share for the goods/services of the registration.

## Definition of a trade mark

The regulation removes the need to represent a mark graphically. However, a mark must still be represented graphically if the UK application will subsequently be used as a basis for a Madrid Protocol filing. The representation must now be *"in a manner which enables the registrar... and the public to determine the clear and precise subject matter of the protection afforded to the proprietor"*

This makes a more flexible system for precisely defining any marks which incorporate, for example, movement or sounds.

## Absolute grounds objections

The list of types of marks which are excluded from registration has been extended to include:

- a) Protected Designations of Origin (PDO) and Protected Geographical Indications (PGI), such as Parma Ham and Stilton Cheese.
- b) Signs consisting exclusively of shapes "or another characteristic" – previously shapes that resulted from the nature of the goods, or is necessary to obtain a technical result, or that gave substantial value to the goods were excluded from registration. This has been broadened to also exclude signs consisting of other intrinsic characteristics of the goods that fulfil these functions. For example, sounds are intrinsic to alarms, so certain sounds may be prohibited from registration for alarms under this ground.

## Some of the other notable amendments include:

- **Applications made by agents** – will be refused unless agent justifies their action.
- **UKIPO search reports** – UKIPO will continue to notify applicants about earlier trade marks which potentially conflict but will no longer notify when such trade marks have expired, even if they are within the period within which the registration could be restored. However, if a registration expires and is restored, where a third party uses a similar or identical mark in good faith during the period the mark was lapsed they cannot be sued for infringement (for that period only).
- **Restoring a lapsed registration** – it is possible to request the restoration of a lapsed registration up to one year after the renewal date. Previously, the UKIPO would consider if it was just to restore the registration. The bar has now been lowered and the UKIPO will merely have to be satisfied that the failure to renew was "unintentional".
- **Infringing acts** – the use of a sign as a trade or company name has been specifically included in the list of infringing acts. It is also now possible to take enforcement action against those creating packaging and labels which make unauthorised use of a trade mark. This is possible even before the mark is actually applied to goods or services, allowing action to be taken in relation to a wider range of items used to prepare for counterfeiting.
- **Defences to infringement** – the defences have been amended as follows:
  - o a defence to an infringement action based on non-use has been included.

Continued

- o the own name defence will no longer apply to companies, it now only applies to an individual's use of their own personal name. Since there are no transitional provisions, this could mean that a company which has been able to shelter under this provision will, following 14 January 2019, be left without a defence. The law change does not apply retrospectively, and this provision has yet to be tested in the courts, but consideration should be given to future use. Furthermore, the use of a trade mark within a trade or company name is now specifically included within the list of infringing acts
- **Licensing** – there have been a number of changes to the licensing provisions, including:
  - o trade mark proprietors can now take action against licensees who fail to comply with terms of their licence under trade mark law. Previously they could likely only do so under contract law.
  - o licensees may intervene directly in trade mark infringement proceedings, that were brought by the trade mark proprietor, to obtain compensation for any loss suffered by the licensee.

- **Customs/goods in transit** – trade mark proprietors who believe counterfeit goods using their trade mark are passing through the UK, not destined for the UK market but en route to countries outside the customs territory of the EU, can request that the customs authorities detain them. It will then be up to the person shipping the goods to prove the trade mark proprietor has no right to stop them being marketed in the country of destination.
- **Dictionary entries** – remedies are now available if a trade mark is reproduced in a dictionary giving the impression that it constitutes the generic name of the goods or services for which it is registered.
- **Collective marks** - who can hold collective marks has been extended along with the requirements for the regulations governing the use of the collective mark. Furthermore, the provisions governing when an authorised user can bring an action for infringement have been updated.

If you would like further advice please contact your usual Boulton Wade Tennant advisor.

**Author: Charlotte Duly, Partner**

## Changes to Canada's trade mark law

We are pleased to report that Canada's new trade mark law will come into force on **17 June 2019**. On this date, the law will undergo significant and long-awaited changes, many of which are aimed at simplifying the registration process.

### What are the changes?

Some of the biggest changes are as follows:-

- The definition of a trade mark will be expanded to include non-traditional marks such as colours *per se*, scents, sounds, tastes and moving images.
- Use of a mark will no longer be a condition of registration. This means that it will no longer be necessary to:
  - (a) specify a date of first use of the mark in Canada or details of use and registration of the mark abroad when filing new applications; and
  - (b) file a Declaration of Use to obtain registration for a mark that has been filed on the basis of proposed use in Canada.

This will apply to all applications that are pending when the new law comes into force, meaning that owners of applications that have been accepted for registration will simply need to pay the official registration fees in order to obtain registration, and will not need to submit an accompanying Declaration of Use. Thus, marks that have not yet been put into use in Canada should proceed to registration with ease.

- Canada will adopt the Nice Classification of goods and services. The classification of goods and services is currently voluntary in Canada but it will be mandatory under the new law.

- With the introduction of classes, official filing and renewal fees will be payable on a class-by-class basis. This is consistent with the practice in many other countries, including the UK and at the EUIPO, where it is necessary to pay additional fees according to the number of classes included in an application. The result in Canada, however, is that it will unfortunately be more expensive to register and renew marks in multiple classes under the new law than it is currently.
- The renewal term for registrations will be shortened from 15 to 10 years.
- Canada will become a member of the Madrid Protocol, meaning that Canada can be designated under the International registration system.

### Recommended action

- With the upcoming introduction of additional class fees, those interested in registering a new trade mark in Canada should consider filing an application for the mark now. This is particularly the case if the goods and/or services of interest span multiple classes, since there is the potential for cost savings under the current law.
- Similarly, those with current registrations in Canada where the goods and/or services fall into multiple classes may wish to consider renewing the registrations now, before the new law comes into force. There is currently no specific window during which a registration in Canada can be renewed and, therefore, it can be renewed now, regardless of its expiry date. Registrations renewed under the current law will be subject to the current fee structure; however, registrations renewed after the new law comes into force will be subject to a per-class renewal fee. There is, therefore, the potential for cost savings under the current law.

If you have any questions about the upcoming changes or would like to discuss any of the issues raised, then please contact your usual advisor.

**Author: Emily Scott, Trade Mark Attorney**

# Chocolate wars

The latest case to come out of the “chocolate wars” between Cadbury UK Ltd (“Cadbury”) and Société des Produits Nestlé SA (“Nestlé”) involved Cadbury attempting to amend the following description of one of their UK trade mark registrations (No. 2020876A) for the colour purple:

*“The mark consists of the colour purple, as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods. The mark consists of the colour purple (Pantone 2685C) as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods.”*

The reason for this request was a ruling in a separate opposition filed by Nestlé against a later application by Cadbury, also for the colour purple, where it was held that the same description was not valid:

*“The description of the mark as including not just the colour purple as a sign, but other signs, in which the colour predominates over other colours and other matter, means that the mark described is not ‘a sign’. There is wrapped up in the verbal description of the mark an unknown number of signs”*

Given the above, Cadbury attempted to amend the description of their earlier registration so that it would be valid and not vulnerable to a challenge by Nestlé. However, a trade mark’s image or description usually cannot be amended once registered. To get around this, Cadbury argued that the original description should be construed as meaning the registration is a series of two marks, with the first mark in the series being the colour purple on the whole of the surface and the second mark being when it is the predominant colour. If successful, they could have asked for the second mark in the series to be deleted, leaving them with the wording which just referred to the colour purple being on the whole surface of the packaging of the goods.

This argument and the request to amend the description were refused by the Registrar, and the High Court on appeal. Cadbury then filed an appeal at the Court of Appeal. The Court of Appeal agreed with the lower courts. The wording was held to be a description of an invalidly registered earlier single mark, rather than two or more marks forming a series. Floyd LJ said that he believe the informed reader of the description would view the various alternatives covered by the wording as describing “parts of a generalised but imprecise description of a single mark”.

There is some sympathy to be had with Cadbury’s position, as the description was entered in line with the guidance at the time and they were therefore following established practice. It remains to be seen whether Nestlé decide to attempt to invalidate Cadbury’s registration, and whether there would be any merit in Cadbury raising a defence that they were simply following guidance from the Registrar.

**Author: Connor Thorogood, Trade Mark Attorney**

## EDITORS

**Emma Pitcher, Partner**

**Daniela Paull, Trade Mark Attorney**

## CONTRIBUTORS

**Felicity Hide, Partner**

**Charlotte Duly, Partner**

**Michael C. Maier, Partner**

**Emily Scott, Trade Mark Attorney**

**Connor Thorogood, Trade Mark Attorney**

> Missed the last edition of **boul.t.bites** TM?

Catch up by clicking **here**



WHAT WE DO



MEET THE TEAM



PUBLICATIONS

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