

Welcome to the Spring edition of Boult.Bites.

Our London team has relocated to new premises. The new office has increased collaboration with clients and staff alike allowing us to introduce more agile working practices. Please do update our postal address if you have not already done so, which can be found [here](#).

Speaking of change, although the date of Brexit has now been pushed back to 31 October 2019, there is still much IP related uncertainty and confusion around the topic. To help tackle this, we have created a **Brexit toolkit** that aims to deliver pertinent information to all types of businesses, so that you can meet any Brexit related IP challenges head on. We strongly encourage you to check the toolkit for the latest updates and guidance.

Our new European offices in Madrid and Berlin are up and running. You will see an article on the ZARA case from Dr. Isabel Blanco of our Madrid Office in this issue, along with articles by members of our London team.

And finally, members of our UK and European trade mark team (pictured below) will be attending the **141st INTA Annual Conference**, which this year is being held in Boston, US from 18-22 May. The years' event will highlight a number of trending topics that are transforming the global IP landscape, including: combatting counterfeits and piracy; GDPR; AI in TM; and law firms in the digital age. To those attending, hopefully see you in Boston!

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



## HEADLINE ARTICLES

### The general court rules in favour of ZARA

Good news for the king of fast fashion, INDITEX. The General Court annulled the decision of the Board of Appeal (BoA) of the EUIPO, refusing registration of EUTM Application ZARA TANZANIA ADVENTURES for travel agency, transport of travellers and car rental for which the BoA had allowed the mark to proceed.

#### Background

On 27 April 2009, an EUTM application for ZARA TANZANIA ADVENTURES was filed for travel and tourism services, travel agency, organization of safaris and vacations, transport of travellers and car rental, etc. by Mrs Zainab Ansell and Mr Roger Ansell.

Following publication, Industria de Diseño Textil (INDITEX) filed a notice of opposition based on EUTM registrations for "ZARA" covering Classes 25, 35,39, 41 and 42 on the basis of Articles 8(1)(b) and 8(5) of Regulation No 207/2009.

The Opposition Division partially upheld the opposition brought on the basis of Article 8(1)(b) in respect of all the services in Classes 41 and 43 and all the services in Class 39, except for "railway, river and air transport and rental of vehicles" and rejected the opposition brought on the basis of Article 8(5) of that regulation in respect of "railway, river and air transport and rental of vehicles".

In allowing the application to proceed to registration in respect of all the services in Class 39 and 43, the BoA considered, first, that the marks at issue had to be considered to be similar overall; secondly, that the earlier marks had a reputation for 'clothing, footwear [and] headgear' in Class 25 and 'store services' in Class 35; thirdly, that the applicant had not sufficiently proved either that the use of the sign applied for might give rise to a risk of unfair advantage being taken of the repute of the earlier marks or that it might be detrimental to the distinctive character or the repute of the earlier marks. The Board of Appeal therefore found that the necessary conditions for the application of Article 8(5) were not satisfied.

#### General Court decision

On Appeal by INDITEX, the General Court mainly analysed three different points; the degree of similarity between the marks at issue, the strength of the earlier marks' reputation and the conditions for the existence of one of the risks of injury.

The General Court agreed with the contested decision in relation to the first two points of interest, but not with the third one.

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## NEWS FROM THE TEAM

> We are delighted to announce that our Trade Mark group has been ranked in the top tier of the 2019 Managing Intellectual Property's (MIP) IP Stars UK ranking for trade mark prosecution for another consecutive year. Full details of the ranking can be viewed [here](#).

> Following the recent creation of the Berlin Trade Mark team, we are looking to expand the team by recruiting a fully qualified German Lawyer (Rechtsanwalt / Rechtsanwältin), with experience in trade mark law. Click [here](#) to find out more about this position and to apply.

> The **141st INTA Annual meeting** will take place in Boston, US from 18-22 May. Attending this year will be UK and European partners: Tony Pluckrose, John Wallace, Emma Pitcher, Simon Kahn, Michael C. Maier (Berlin), and Alvaro Cabeza (Madrid). Please do get in touch if you are also attending. Our dairies are already quite packed but we will try to make time to meet with you where possible.

> Many of our trade mark partners, including several who will be attending INTA this year, have been recognised by leading IP publication Who's Who Legal as **leading attorneys** in the field.

> Partner Emma Pitcher has been appointed Vice Chair of the International Trademark Treaties and Law Committee of the American Bar Association Section of Intellectual Property Law (ABA-IPL) and spoke at the recent 2019 ABA-IPL Annual Meeting and 34th Intellectual Property Law Conference in Arlington, Virginia, USA.

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### The condition relating to the existence of one of the risks of injury

As regards the risk of unfair advantage being taken of the distinctive character or the repute of the earlier trade marks, the BoA stated that the opponent had not put forward any information which made it possible to understand satisfactorily how the risk of an unfair advantage could have arisen and pointed out that the opponent had not taken into consideration the huge differences between the goods and services concerned, having regard to their nature, purpose, method of use, service provider, manufacturer and the means by which they are marketed.

In this regard, the General Court considered that the BoA had erred in finding that the opponent confined itself to making general allegations regarding the existence of a risk of unfair advantage. Furthermore, regarding the differences between the goods and services covered by the marks at issue, it must be pointed out that, in the present case, those differences are not, in themselves, capable of precluding any risk of unfair advantage being taken by the use of the mark applied for.

In view of the foregoing, the General Court stated, the BoA did not carry out an overall assessment of the risk, covered by Article 8(5) of injury linked to unfair advantage, since in assessing the claims made by the opponent in that regard, it did not take into account the strength of the earlier marks' reputation or their degree of distinctiveness and therefore the General Court annulled the decision of the Second Board Of Appeal of the EUIPO.

The Spanish Company argued that there is a high likelihood of confusion between their clients if this trade mark exists.

**Author: Dr. Isabel Blanco, PhD and Lawyer (Spanish Qualified)**

> Partner Catherine Wolfe and Trade Mark Attorney Donna Trysburg will be attending ECTA's 38th annual conference in Edinburgh, 26-29 June.

## Trumped by Trump: round two for Gleissner

There is history behind the activities of Mr Michael Gleissner and his related companies, one of which filed an application to register TRUMP TV as a UK trade mark. Mr Gleissner and his companies tend to file many trade mark applications, often for marks which are used and well-known by established entities.

In this case, a Gleissner company named Trump International Limited (TIL) had a sole director, namely Mr Gleissner. TIL filed in the UK to register TRUMP TV, and was opposed pre-registration by DTTM, a company which holds the trade mark registrations previously owned by Mr Donald Trump. DTTM no longer has any connection with Mr Donald Trump.

DTTM argued that the TRUMP TV application had been filed in bad faith and that it conflicted with the earlier DTTM-owned trade marks. TIL defended the opposition by filing arguments that its application was not in bad faith, but filed nothing further. In particular, it filed no evidence. DTTM on the other hand did a thorough job of demonstrating that other companies controlled by Mr Gleissner had been involved in numerous similar proceedings, some involving the Apple-owned trade marks. At the stage of a decision from the Trade Marks Registry, the Registrar found that TIL acted "below the standards of commercial behaviour judged by ordinary standards of honest people, and that the Application is accordingly refused for bad faith". TIL appealed this to the High Court, where on 28 February Mr Justice Henry Carr handed down his judgment.

TIL argued that the Registrar had been swayed by evidence relating to other proceedings, and was hence biased and had not applied a fair test to the present TRUMP TV case. TIL also argued that fresh evidence should be admitted before the High Court, even though it was not put in to the Registry.

Looking at the issue of judicial bias first, Mr Justice Carr found that the evidence relating to other proceedings involving Gleissner or Gleissner-controlled companies was "admissible and relevant" and had contributed to the Registry's understanding of the relevant facts. The Registry had not been biased either favour or disfavour toward the TIL case.

The late evidence which TIL wished to have the High Court consider was made up of three witness statements, one from Mr Gleissner himself, one from a lawyer instructed by Mr Gleissner and his companies to register trade marks and negotiate contracts, and one from a paralegal who assists Mr Gleissner with the incorporation of companies and trade mark registrations. The Gleissner statement sought to "set the record straight" and to "clear his name", stating that his business model was to invest in entities that possessed unrestricted and unfettered intellectual property rights. The Court decided not to admit this late evidence:

it could have been put in at the Registry stage, would not have been relevant to showing that the TRUMP TV application had been filed in good faith, and the Gleissner assertion of his bona fide intent to use the mark was, said Mr Justice Carr, "not credible".

The Registrar had been an intervener in this case, seeking the Court's guidance on how to deal with similar proceedings involving Gleissner-owned or controlled entities in the future. Although Mr Justice Carr did not make any statements to the effect that all such proceedings should automatically find against the Gleissner activities, he did state some useful principles, including that

- i. Where an application is made for a well-known trade mark with which the applicant has no apparent connection, this requires explanation and justification by the applicant;
- ii. Other instances of such applications by the applicant (or persons or companies connected to the applicant) may be admissible as similar fact evidence and may refute the explanation and justification provided by the applicant;
- iii. It is necessary to distinguish between unsubstantiated allegations and established facts of direct relevance to the case before the IPO. In the present case the similar fact evidence was potentially probative and it was just to consider it;

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Mr Justice Carr also reminded the Registry – and, by means of this judgment, parties before it – that it is possible for the Registry to strike out proceedings “brought for an ulterior and improper purpose” as an abuse of process, and that brand owners need not restrict themselves to Registry proceedings as UK trade mark applications require a statement of bona fide intent to use. If such use would infringe or pass off, then infringement or passing off court action may be possible, directly against the entity which filed the application, without going through the Registry proceedings.

**Author: Felicity Hide, Partner**

## Pitfalls of pleadings on appeal – it could lead to an unfair advantage

This Appeal decision highlights the need for rigorous analysis of pleadings before the Appointed Person (AP). Full details of the decision can be found [here](#).

The Opponent, Match.com, Opposed a UK application for MUSLIM MATCH (the Application) that covered similar dating services and a number of other related counselling, information and mediation services. The Hearing Officer (HO) correctly found that there was a likelihood of confusion between the marks for the similar dating services. The Appeal concerned a specific sub-set of goods against which the HO initially rejected the Opposition.

The HO’s reasoning focused around her conclusion that the services were dissimilar. Unlike the Opponent’s services, these services were carried out by highly trained and specialised individuals, were unlikely to share trade channels, and there was no competition or complementarity between the goods. There could therefore be no likelihood of confusion and the objection under section 5(2)(b) therefore failed.

Even after finding that the Opponent had a reputation for dating services, the dissimilarity of the services and lack of a likelihood of confusion influenced the HO’s decision in finding that there was not a sufficient link to find that the use and registration of MUSLIM MATCH would take unfair advantage or be detrimental to the earlier mark. The objection under section 5(3) therefore failed. The HO then incorrectly (as stated by Geoffrey Hobbs sitting as the Appointed Person (AP)) failed to assess the relevant factors of passing off, and, instead, dismissed this ground of opposition 5(4) by stating it was analogous to the likelihood of confusion claim that had already been dismissed.

In its Grounds of Appeal, the Opponent pleaded that the HO had erred in her decision because the services are not conducted by highly specialised individuals; but instead by untrained individuals as the industry is largely unregulated. They argued that the services share trade channels, are both most commonly offered by the internet or via online social media platforms and are all services which focus on interpersonal relationships and connecting people. These additional facts were beyond the scope of the evidence filed in the Registry proceedings and therefore were not relevant in evidencing that the HO had erred in her initial conclusion finding that the services were dissimilar. The Opponent also did not request leave to submit additional evidence to support their assertions of fact.

Most fatally though, the pleadings did not state that the HO had erred in coming to the conclusion that there was no link between the marks, even if, the relevant services are not similar and there may not be a likelihood of confusion. Neither did they state that the HO had failed to assess the relevant factors for a finding of passing off.

The AP stated “The Opponent cannot expect or require this Tribunal to work through the papers and proceed as if it was sitting inquisitorially to decide the opposition do novo.” The question on this Appeal is whether it was open to the HO, on the evidence and materials before her, to conclude as she did. The AP went on to say that based on the Opponent’s criticisms of the HO’s conclusions – “I am not prepared to say that it was not open to the Hearing Officer on the evidence and materials before her to come to the conclusion that she did.”

This is a fitting reminder that pleadings on Appeal will be critically analysed by the AP and that you cannot expect the AP to review the initial facts and come to their own conclusion. If you do not plead a particular error in law then the AP will not consider it. It is a shame in this case as there were errors in the initial decision and the tone of the judgement suggests that the AP could have been inclined to find in the Opponent’s favour.

**Author: Henry Schlaefli, Trade mark attorney**

## Spring cleaning: Australian non-use grace period reduced to tackle cluttered register

Australia has recently reduced the time period before which a trade mark registration can be challenged for non-use.

Any person may apply to have a trade mark removed from the register on the basis that the registered trade mark has not been used for a continuous period of three years before the date of the removal application. The Australian Trade Marks Act 1995 previously stated that a non-use application could only be filed following a five year period from the filing date of the trade mark. The Amendment Act provides that a non-use application can now be made following a three year period from the filing date of the trade mark registration. However, the changes apply only to trade mark applications filed on or after 24 February 2019.

This means that those who wish to file non-use revocation actions against Australian registrations that were filed on or before 23 February 2019 must still wait for the five year period from the filing date to pass. Those filed on or after 24 February 2019 are required to wait only three years from the filing date before such an action can be filed.

The change to this law came into force following a 2016 review of Australia’s IP arrangements. The investigating body, the Productivity Commission, found that the Australian trade marks register was “cluttered” with trade marks that are not being used. This is particularly important in Australia because they are a territory whose IP Office examines on relative grounds (i.e. the Examiners inspect the register for similar earlier marks and these must be overcome before registration is possible). The changes mean that those who find themselves blocked by an earlier registration that is not used can apply to have a trade mark removed from the register at an earlier date than previously possible.

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Whilst the Amendment Act reduces the grace period before it is possible to file non-use revocation actions, it does not change the period of non-continuous use that must be established by the non-use applicant, which is still three years.

**Author: Naomi Jenkins, Trade Mark Attorney**

## Reform of Spanish trade mark law No 17/2001

The new law, through which the existing Spanish trade mark law is partially amended to transpose the Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015, entered into force on January 14 2019.

Decree 23/2018 of the Cabinet introduced the following amendments: Firstly, the main changes in relation to formal aspects are the following:

- The requirement for graphic representation of the mark has been removed. The representation of the mark can now be by any means that allows to determine the clear and precise subject matter of the protection granted.
- Signs which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with Union legislation, national law, or international agreements to which the Union or Spain are a party to will not be registered as trade marks, thus providing for protection for plant variety rights in respect of plant varieties of the same or closely related species.
- The category of well-known trade marks as such disappears and from now on only trade marks with a reputation require the knowledge of the trade mark not only by the average consumer in the specific market sector but also by the general public.

Secondly, procedural matters introduced make important amendments to both the opposition and invalidity procedures; these will come into force as of January 14, 2023.

The main change refers the competence for invalidity and revocation related proceedings from the courts to the Spanish Patent and Trade Mark Office (SPTO). Going forward, the courts will only have jurisdiction in counterclaims brought in infringement proceedings.

Further, on May 1, 2019, Royal Decree 306/2019 of April 26 entered into force, which modifies some articles of the Regulations of the trade mark law, namely, in oppositions against new trade mark applications, filed as from 1st May 2019, it is now possible for the applicant to request proof of genuine use of the opposing trade mark

This legislative harmonization represents a significant step forward for the proper functioning of the Internal Market and for the benefit of all consumers.

**Author: Dr. Isabel Blanco, PhD and Lawyer (Spanish Qualified)**

## New regime for trade mark registrations in Myanmar

The new trade mark Law (signed on 30 January 2019) in Myanmar introduces, for the first time, a regime for the registration of trade marks for brand owners. This replaces the old system (still currently in place), where trade mark protection is claimed via a Declaration of Ownership with the Registry of Deeds and the publishing cautionary notices in newspapers at regular intervals. Following the signing of the new law, the applicable practice regulations and administrative structures will need to be set up before it will be possible to file new trade mark applications in the territory. The new regime will be administered and implemented via two new statutory bodies, the Central Committee for Intellectual Property Rights and the Intellectual Property Rights Agency.

The new law adopts a "first-to-file" system, replacing the old system of "first-to-use", and introduces substantive examination of applications, oppositions, invalidation and cancellation actions. Trade mark registrations in Myanmar will be valid for 10 years and renewable for further 10 year periods.

New applications may claim priority under the Paris Convention, and may designate multi-classes. In addition, there is provision for "well-known" trade marks and criminal penalties for trade mark infringement and counterfeiting.

### Next steps for interested brand owners

Whilst it is not yet possible to file new trade mark applications, the following steps may be taken by brand owners who are interested in obtaining trade mark registrations in Myanmar:

- Prepare documents required for registration under the new law in Myanmar, which includes certificates of records with the office of Registration of Deeds (however, there is no system for automatic registration of trade marks based on existing records)
- Review the portfolio to ensure that any existing protection under the old regime is in force.
- Retain evidence of use such as cautionary notices, which may be submitted to support a new trade mark application.
- Any licences having effect in Myanmar should be audited and up to date.

**Author: Ai Ling Lim-Lee, Trade Mark Attorney**

### EDITORS

**Emma Pitcher, Partner**

**Daniela Paull, Trade Mark Attorney**

### CONTRIBUTORS

**Felicity Hide, Partner**

**Dr. Isabel Blanco, PhD and Lawyer**

**Ai Ling Lim-Lee, Trade Mark Attorney**

**Henry Schlaefli, Trade mark attorney**

**Naomi Jenkins, Trade Mark Attorney**

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