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Welcome to the Autumn edition of Boult.bites TM.

The eagle-eyed among you may have spotted that my title is now a little shorter now. As of 1 November, Alex Frost has succeeded me as Managing Partner of the firm. It has been a great honour for me to have led the firm for the past five and a half years; in that time seeing the firm going from strength to strength, becoming international with our offices in Germany and Spain, and continuously being recognised as leaders in our field, among many other fantastic achievements.

In this issue, we update you on important developments in the industry; a reversed Board of Appeal decision by the General Court; an important case for brand owners; and general updates TM team and firm updates. Please do get in touch if you have any questions on the topics covered.

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



## RECENT DEVELOPMENTS

### Innovation and Growth Report 2018-19

The UKIPO has published its latest innovation and growth report for the 2018-2019 financial year. As well as reaffirming the UKIPO's readiness for Brexit, it reports the following interesting statistics, which demonstrate the UKIPO's dedication to delivering excellent IP services:

- There has been an 11.4% increase in new UK trade mark applications filed this year. Growth has been above 10% every year since 2011 and, therefore, this year's figure is consistent.
- Despite the filing increases, the average time it takes to issue examination reports has reduced from nine working days in 2017-2018 to seven working days this year.
- 99% of acceptable applications are registered within four months.

Our firm is also prepared for Brexit. Visit our Brexit Toolkit [here](#) for more information.

### EUIPO Communication on long lists of goods and services

The EUIPO has released a communication reminding users of the disadvantages of filing particularly long lists of goods and services. They refer to a trend of recent registrations containing 3000 – 6000 different terms, instead of the average of 60 – 100. In particular, the risks are: a higher risk of classification deficiencies; delays in publication and registration and an increased risk of conflicts or cancellation. We still await the CJEU decision in the SKYKICK case, which could have wider implications on the legitimacy of filing exceptionally broad specifications.

### Malaysia joins the Madrid Protocol

Malaysia has become the 106th member of the Madrid system. The Madrid Protocol will enter into force for Malaysia on 27 December 2019, from which point trade mark owners can seek protection in Malaysia through the Madrid system. If you would like to discuss the Madrid system of trade mark registration, then please speak to your usual advisor, who will be very happy to help.

### Reduction in UAE official registration fees

Good news for trade mark owners in the UAE: the UAE Trade Marks Office is reducing official trade mark registration fees applicable to applications and renewals by 33%. The decrease in official fees is effective immediately.

### Changes in Saudi Arabia official fees

The Saudi Arabia Trade Marks Office has also announced that the official fees in relation to trade mark searching, filing, registration and renewals are set to decrease. However, there will be an increase in fees to record an assignment and amendment against a registered trade mark, which may offset some of the decreases. The changes will be effective once they have been published in the Official Gazette.

### New Declaration of Use requirement in Argentina

Amendments to the trade mark law in Argentina mean that there is now a requirement to file a sworn declaration of use between the 5th and 6th year of registration. The requirement will apply to all marks registered after 12 January 2013. If no declaration is filed, then renewal of the mark will not be possible at the end of the 10-year period, unless and until the declaration has been filed and late official filing fees have been paid. The implications of this are particularly crucial for non-use cancellation actions, as these declarations will give a clear indication of the extent of use of a mark. Those affected by this new requirement will be contacted by their usual advisor at the relevant time.

### New dispute resolution services form Ukraine and China domain names

The WIPO has recently added dispute resolution services for .UA domain names (Ukraine) and .CN and 中国 domain names (China). This is welcome news for rights owners in these territories.

# General Court makes ruling on conceptual comparison of names

The General Court (“GC”) has reversed an earlier Board of Appeal (“BoA”) decision to find no likelihood of confusion between the signs LUCIANO SANDRONE and DON LUCIANO despite the similarity of the goods in question. The GC’s decision was based on a finding that the only thing that the signs have in common is a first name, LUCIANO, which is less distinctive than a surname, SANDRONE, which allows a consumer, displaying an average level of attention, to differentiate those goods.

The GC’s decision involved an interesting discussion on whether names can be conceptually compared and how branding practices can influence the context of comparison.

The Applicant, Mr Luciano Sandrone, filed for the mark LUCIANO SANDRONE for goods including “Alcoholic beverages (except beer); preparations for making alcoholic beverages” in Class 33 (“the Application”). The Opponent, owner of the EU trade mark registration for DON LUCIANO, registered for “Alcoholic beverages (except beer)” (“the Earlier Mark”), opposed on the basis of Article 8(1)(b), i.e. that the Application should not be registered due to a similarity with an earlier mark.

The Applicant put the Opponent to proof of use, and argued that the evidence provided did not show genuine use. However, the GC held that the use was sufficient. The GC also disagreed with the Applicant’s argument that the goods were not necessarily similar because there can be differences in the respective origin, grape variety, label and price of the wines to be compared. The GC held “the fact that the consumer takes account of the designation of origin of a wine at the point of purchase cannot be regarded as being of such systemic importance that, as a consequence, wines of different designations of origin may constitute subcategories of goods capable of being considered separately from one another”. Further, the registration was not limited to a particular type of wine, such as “Italian wines” and so the argument was dismissed.

When comparing the signs, the General Court noted that the BoA had correctly considered LUCIANO to be the distinctive element in DON LUCIANO. However, it considered that the BoA had made a mistake when assessing the

distinctive element in LUCIANO SANDRONE. The BoA found that in Germany and Finland both the name LUCIANO and the last name SANDRONE are rare, resulting in each element being equally distinctive. However, the GC stated that as a general rule, a surname is more distinctive than a first name. LUCIANO is a common first name in Spain, Italy, Portugal and France and so it could not be considered a rare name in other member states such as Germany or Finland even if it is uncommon there. This is partly because people within member states have “numerous exchanges” via “current means of electronic communication”. Consequently, the distinctive elements of the marks were LUCIANO and SANDRONE respectively, and so the marks did not coincide in their distinctive elements.

The GC then found there to be at least a low degree of visual and phonetical similarity between the signs. In deciding whether there was a conceptual similarity, it stated that ordinary names that lack any particular concept (i.e. not a celebrity’s name, or an unusual name) cannot be conceptually compared. Therefore, no conceptual comparison should have been made in this case by the lower courts.

In performing the global assessment, the GC held that the BoA had applied the interdependence test between the similarity of signs and goods too mechanically, without taking into account the other factors, and had made four errors. These were as follows:

1. It had wrongly held that the element LUCIANO is distinctive in both signs;
2. It failed to take in to account the specific characteristics of the goods;
3. It did not take in to account the prevalence of Spanish or French names in the wine market, meaning that the fact that both products contained such names did not necessarily mean consumers will perceive them as emanating from the same undertaking;
4. It failed to take into consideration that the shared element LUCIANO has a low degree of distinctiveness in light of its finding in relation to the name LUCIANO being a common name in Spain, Italy, Portugal or France and the numerous exchanges within the European Union.

In relation to the goods, the GC considered it implausible that the average consumer might perceive an economic link between undertakings just because two bottles of wine feature the common name LUCIANO. It held that consumers will use the distinctive last name SANDRONE to identify the origin of the goods. Consequently, the General Court found that there was no likelihood of confusion between the signs and the Appeal was held.

It is clear that evidence of branding practices, specifically in the wine sector held an important part in the GC’s decision. The GC’s consideration of this evidence influenced its decision to consider the distinctive character of the element LUCIANO and the manner in which consumers will perceive it.

It is interesting that the General Court found that within the EU there are numerous exchanges that are facilitated by the current means of electronic communication. Whilst consumers all over the EU have at least some familiarity with the name LUCIANO, it appears that the weakened distinctive character influences the perception in member states where LUCIANO is not common. This is probably true of the UK, where the name LUCIANO is not particularly common. Owners of EU trade marks containing names that are unusual in their country of origin should be careful if that name has a weak distinctive character in other EU member states. This decision shows that the fictional EU “average consumer” is moving closer towards a person who makes transactions and has conversations (electronic or otherwise) in other member states.

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

# Evergreening and obtaining a Monopoly right

The controversial topic of “Evergreening” has received yet more attention following an EUIPO Board of Appeal decision between Hasbro, the owners of the “MONOPOLY” trade mark, and Kreativini Dogadaj, who filed an invalidity action on the grounds that Hasbro’s re-filing of the word mark was in bad faith.

Evergreening, or keeping a trade mark perpetually “young” (registered for less than five years), can be useful for enforcement purposes. Use of a mark is of course the most important thing but proving it can be tricky; as a number of brand owners have recently found out. It is costly, labour intensive and the outcome can be uncertain.

So, when is a re-filing of a trade mark acceptable practice and when is it bad faith? The case law suggests that updating a logo or device mark is fine. Legitimate evolution of a logo or device is likely to quash any arguments of bad faith, irrespective of the scope of the goods and services. Re-filing of a word mark is more tricky if the changes differ only in immaterial differences, as in the Canal/Canal plus/ + case.

However, what if I change the specification of my word mark? If the mark is identical, then filing for any goods and services already included by the literal and usual meaning in the first filing is risky. As this case has proven.

In scenarios like this, the EUIPO has previously ruled that the new filings are simply extensions of the first filings. Therefore, they are treated as old filings and the owner is required to furnish use within opposition proceedings.

However, this new ruling has gone a step further, declaring the Monopoly EUTM invalid for all goods and services encompassed by the scope of the original filing. The factual circumstances of this case and Hasbro’s repeated filings almost certainly affected the Board’s ruling that new filing was in bad faith (this was the fourth time Hasbro had filed the mark). The EUIPO summarised this as follows:

“The contested EUTM contains numerous goods and services which are simply a repeat of the earlier, already existing EUTMs ‘MONOPOLY’. All of the mentioned circumstances imply that the intention of the EUTM proprietor was to take advantage of the EU trade mark rules by artificially

creating the situation where it would not have to prove genuine use of its earlier marks for the goods and services mentioned. Bad faith partially proven.”

On the one hand, this ruling goes some way to keep the marketplace in check. Trade marks should be “use it or lose it” and overly aggressive enforcement strategies relying on marks that trade mark owners don’t use distorts this. However, this may seem harsh on trade mark owners that use their marks on all of their goods and services and legitimately expand into new business areas but do not want to have to go to the effort of renewing multiple separate registrations for identical trade marks, each with different goods and services.

The take home message is that careful consideration should be made when re-filing a mark that you already have protection for. The amendment of a trade mark specification alone, which still contains “old” goods and services, may not be sufficient to prevent a re-filing of an identical trade mark being held to be in bad faith.

**Author: Henry Schlaefli, Trade Mark Attorney**

## NEWS FROM THE TEAM

> Partner, and past president of CITMA, **Catherine Wolfe**, has accompanied a UK government visit to China as a representative for CITMA. A series of IP events are being organised to coincide with the visit, including the UK-China IP Symposium held in Beijing, which will focus on the UK Intellectual Property Office’s (IPO) cooperation with China’s State Intellectual Property Office (SIPO).

> Partners, **Emma Pitcher** (London office) and **Michael C. Maier** (Berlin office), will be attending the **Annual INTA Leadership meeting 2019**, which will be held in Austin, Texas, between 19 and 22 November 2019.

> **Donna Trysburg** will be attending the ACG Conference and Reception 2019 in London, 6-7 November. The conference will focus on brand protection and guidance on how to future-proof your IP approach.

> Trade Mark Partner, Felicity Hide, and Engineering and Designs Partner, Matthew Ridley, have been invited to present at **the Annual Update for Senior Trade Mark & Design Administrators** in London on 7-8 November 2019. The meeting will cover EUIPO legal reforms, focusing on changes to the law and practice, including a case law summary.

> **John Wallace** (London) and **Álvaro Cabeza** (Madrid) attended the ASIPI (Inter-American Association of Intellectual Property) conference in Lima in late October 2019.

> **Emma Pitcher** attended the ABA IP West conference in San Antonio, Texas in early October 2019.

> **Daniela Paull** and **Anusha Arunasalam** recently attended the Marques Annual Conference in Dublin which, as ever, boasted a number of highly useful conference sessions and well-organised receptions. A visit to the Guinness Storehouse was one of the many highlights! As always, it was a fantastic opportunity to catch up with old friends and make new ones.



Daniela Paull and Anusha Arunasalam in sunny Dublin for the Marques Annual Conference



Marques Annual Conference in Dublin

## NEWS FROM THE TEAM CONT.

> On 14 October 2019, **Emily Scott** attended a Brand Protection Online Europe event run by the World Trademark Review (WTR). Speakers included experts in the field of online brand protection and enforcement, including in-house counsel from a number of well-known brands, who gave fascinating insights into online brand protection strategies, including in the ever-changing social media landscape.

> **Emily Scott** and **Peter Vaughan** recently attended the "As the UDRP turns 20: looking back, looking ahead" conference at WIPO in Geneva. Attendees included domain name specialists, including many respected UDRP panellists, with sessions discussing key themes and developments in UDRP practice and case law. Of particular interest was a thought-provoking session on what the future might hold for the UDRP.

> **Roshani Muniweera**, **Emily Scott** and **Henry Schlaefli**, who all qualified as Chartered Trade Mark Attorneys in 2018, attended CITMA's UKIPO day for newly qualified attorneys in Newport, Wales.

The day provided an invaluable opportunity to gain a better understanding of the workings of the UKIPO and involved discussions with trade mark examiners, a talk from Oliver Morris, the Head of the Tribunal and a tour of the UKIPO office.



Henry Schlaefli, Emily Scott and Roshani Muniweera at the UKIPO

> **Janne Flemming** attended INTA's Trademark Administrators and Practitioners (TMAP) meeting in Berlin in September. The conference covered a broad range of topics, from the kind of IP rights that exist and how to get protection for them, to new non-traditional kinds of trade marks and the role of artificial intelligence in IP. Speakers from IP Offices and In-House professionals shared their knowledge, experience, and practical tips on the role of a trade mark administrator. The conference also provided many opportunities to network with colleagues from all over the world.



Janne Flemming from our Berlin office at the TMAP 2019 conference

## FIRM NEWS

> Boulton Wade Tennant ranked band one by Chambers and Partners 2020 in the "Intellectual Property: Patent & Trade Mark Attorneys Department, UK-wide" category. In the ranking, the firm is noted for "Impressive patent prosecution practice spanning all fields of technology and noted for excellence with regard to trade marks", with several of our Trade Mark partners being highlighted as notable practitioners of the field. Read full details [here](#).

> The firm has also been recognised as top tier by leading directory Legal 500 2020, for another consecutive year. The Trade Mark practice is commended for its "strength in both portfolio management and strategic trade mark development and in oppositions and appeal cases, including in-depth experience in cooperating with solicitors for high-stakes infringement cases". Read full details [here](#).

> Partner, **Susi Fish**, was invited to talk at the recent CITMA Autumn conference as part of her involvement with the IP inclusive initiative. Susi, alongside Emma Dennis of Gowling WLG, spoke on the increasingly important topic of diversity and inclusion in the workplace, including how it can affect your bottom line. Their presentation can be downloaded on the CITMA website, [here](#).



### EDITORS

**Emma Pitcher**, Partner

**Emily Scott**, Trade Mark Attorney

### CONTRIBUTORS

**Naomi Jenkins**, Trade Mark Attorney

**Henry Schlaefli**, Trade Mark Attorney

**P.S Know anyone interested in exploring a career in IP?**

The application process for our 2020 Vacation Scheme is now open! [Learn more here.](#)

WHAT WE DO



MEET THE TEAM



PUBLICATIONS



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