

Welcome to the Spring edition of Boult.bites TM. First, I would like to wish you and your loved ones good health during these challenging times. As a firm, we are all now working remotely and so far, it's business as usual... just not from our usual locations! Technology has enabled us to stay in touch, with virtual meetings so easy to hold. However, the dress code for meetings has relaxed somewhat and you never know what or who might pop up in the background! We are continually updating our [website](#) with the latest information on measures being introduced by several IP offices around the world in response to Covid-19, and I would encourage you to check this on a regular basis. Please do also contact us directly if you have any questions or concerns.

Introducing our German team

On a different note, I am delighted to share with you news of our further expansion in Germany. Our fantastic colleagues in Berlin, Partner Michael C. Maier, Alexander Stolz (Solicitor/ Rechtsanwalt), Janne Flemming (Paralegal) and Jessica Gräfe (Paralegal) have, due to their expansion, recently moved to much larger premises. They are delighted to have been joined by our newly created team in Frankfurt. The launch of our Frankfurt office, enables us to offer our clients even greater IP resource for both trade marks and patents. Frankfurt is headed by Partner Henning Erb, (a German Patent attorney/Patentanwalt and a European Trade Mark and Design attorney) assisted by Sebastian Stephan (a German Patent attorney/Patentanwalt and a European Trade Mark and Design attorney) and Katharina Rupp (an IP Assistant). Henning is part of the Engineering and Designs Group and an experienced trade mark practitioner.



John Wallace,
Head of Trade Mark and
Domain Names practice

Meet our German team



JOIN OUR UPCOMING WEBINAR SERIES

Coming soon

A series of webinars discussing recent developments in trade mark law and practice.

Currently on the agenda is:

- > **27 April 15:00 GMT** Brexit – Three months on: where are we now? Top tips for brand owners.
- > **26 May 15:00 GMT** Sky v SkyKick – Trade Mark specifications: what do you need to do now?
- > **30 June 15:00 GMT** UK Trade Mark Oppositions – Navigating UK Trade Mark oppositions post-Brexit.



BUSINESS AS USUAL AT BOULT WADE TENNANT FOLLOWING BREXIT

The European Parliament has now ratified the UK's Withdrawal Agreement regarding the UK's exit from the EU. Accordingly, from 31 January 2020 to 31 December 2020, the UK is now in an agreed transition period. In relation to all intellectual property, nothing will change until 31 December 2020, which is now "Brexit Day".

EU trade marks (EUTMs) and International trade marks designating the EU, that have registered before Brexit Day, will be cloned onto the UK Register through the creation of "comparable rights" at the UKIPO. There will be no official fees or additional charges. Thus, any cloned UK rights will retain the same filing and priority dates as the EUTMs, but will exist as independent UK trade marks following the end of the transition period. For any EUTM applications, or EU designations of International Registrations, which have not yet registered and are still pending on Brexit Day, their owners will have a nine-month "special priority period", if they wish to file a UK trade mark application as-of that earlier EUTM's date.

At Boulton Wade Tennant we have offices in Spain and Germany in addition to our UK offices, and will continue to provide a world-class brand protection service. We can assure our new and existing clients that instructions will be carried out before the EUIPO as normal despite the UK no longer being a Member of the EU. Further information regarding the implications of Brexit can be found on our [website](#).

Author: Anousha Vasantha, Trade Mark Assistant

NEWS FROM THE TEAM

> **Boulton Wade Tennant's Trade Mark Group is ranked tier 1 by Managing Intellectual Property**

We are pleased to announce that our Trade Mark Group has been ranked tier 1 for another year by Managing Intellectual Property (MIP) in the Trademark prosecution category 2020.

Head of the Trade Mark practice John Wallace commented, "We are delighted by this news. As always a big thank you to everyone, in all departments, who have worked together to deliver a first class service to all of our clients."

Full details of our rankings can be viewed [here](#).

> On 15 January 2020, Isabel Blanco was a speaker at a discussion organised by the International University of la Rioja (UNIR), which operates in Spain and Latin America, about well-known film, Pirates of Silicon Valley. The film centres on the history of tech giants, Microsoft and Apple. The discussion concentrated on current issues in Intellectual Property rights through an analysis of different segments of the film, with a particular focus on the differences between software protection in the US and Europe, and design protection for graphical user interfaces.

> On 28 January 2020, Emily Scott attended World Trademark Review's Managing Trademark Assets Europe conference held in London. The conference covered a range of topics, including best practices in strategic trade mark management, dispute resolution and negotiation tactics, and top tips for dealing with counterfeiters and infringers.

> We are very pleased to welcome Timothy Greenwood and Anousha Vasantha to the Trade Mark team. They both joined the firm in the last few months and have hit the ground running. Many of you may already have been in contact with them and we look forward to introducing them to many more of you over coming months.

HARRY POTTER COPYRIGHT RESTRICTIONS RELAXED

With the world in the midst of a pandemic, it's nice to read about initiatives such as this by J.K. Rowling, which I'm sure will provide a much needed and welcome distraction for many!

JK Rowling, author of the "Harry Potter" series, has offered an open licence to teachers, relaxing the usual copyright permissions required to post videos reading the books aloud.

<https://www.worldipreview.com/news/jk-rowling-offers-teachers-open-licence-amid-covid-19-pandemic-19467>

Author: Emily Scott, Trade Mark Attorney

Check out our latest thoughts on our website. Short articles to keep you updated.



JAGUAR'S BATTLE TO REGISTER VARIOUS LAND ROVER MODELS AS 3-D SHAPE MARKS

Decision O/589/19 TRADE MARK APPLICATIONS 3164282/83, 3186701, 3158947/8 AND 3248751 BY JAGUAR LAND ROVER LIMITED TO REGISTER 6 THREE-DIMENSIONAL SHAPE MARKS AND OPPOSITIONS 409980-984 AND 413358 BY INEOS INDUSTRIES HOLDINGS LIMITED

Jaguar Land Rover (JLR) applied to register six trade marks consisting of three dimensional shapes of its legacy Land Rover Series 1, Series 2, Defender 90 and Defender 110 models for a range of goods and services including, among other things, electrical accessories for vehicles in Class 9, vehicles in Class 12, jewellery, watches and badges in Class 14, toy and model vehicles in Class 28 and vehicle repair, maintenance and customisation services in Class 37.

All applications received objections during examination as the marks were considered descriptive for a sports utility vehicle (SUV) and devoid of any distinctive character. JLR overcame these objections by submitting evidence of acquired distinctiveness through use and the applications were accepted and published but subsequently opposed by INEOS, a company reportedly working to launch a British-manufactured SUV described in the automotive press as the "spiritual heir" to the Defender.

INEOS invoked multiple distinct grounds of opposition. JLR denied all grounds and asserted that the marks had acquired distinctive character through use. The UK IPO Hearing Officer held that:

- i. The signs were capable of being graphically represented and/or of distinguishing the goods or services of a particular undertaking, and so the opposition under s.3(1)(a) of the Trade Marks Act 1994 (the Act) failed;
- ii. The signs were descriptive and devoid of distinctive character since their designs did not depart significantly from the norms and customs of the land vehicle sector at the date the applications were filed and/or the shapes may serve in trade to designate the intended purpose of the goods or services; therefore the opposition under s.3(1)(b) and (c) of the Act partially succeeded for a large proportion of the goods and services applied for, including, critically, passenger cars;

- iii. It was not necessary to consider whether the marks consisted exclusively of signs which have become customary in the bona fide and established practices of the trade for the goods and services for which the s.3(1)(b) and (c) objection had succeeded, and there was no evidence that the marks consisted exclusively of signs which have become customary in the bona fide and established practices of the trade for the remaining goods; therefore the opposition under s.3(1)(d) of the Act failed;
- iv. The evidence, which included survey evidence, sales and promotional spend figures, adverts, press articles and evidence of appearances by the cars in film and TV productions, did not establish that the shapes had acquired a distinctive character through use at the date of the applications in relation to passenger cars, contrary to the findings during examination;
- v. The three dimensional shapes applied-for were not shapes which resulted from the nature of the goods themselves, the essential elements of the shapes were not necessary to achieve a technical result, and it was not necessary to consider whether the shapes gave substantial value to the goods; therefore the opposition under s.3(2) of the Act failed;
- vi. The argument that, because the shapes are designs, registration of them as trade marks would be contrary to public policy was misconceived as it did not amount to a sufficiently serious threat to a fundamental interest of society; therefore the opposition under s.3(3)(a) of the Act failed; and
- vii. JLR had a reasonable commercial rationale for applying to register the marks for all goods and services except apparatus for locomotion by air and/or water, in respect of which it was deemed "unlikely, if not wholly implausible" that the shape could be put to use as a trade mark, therefore the application was made in bad faith in relation to those goods only and the opposition under s.3(6) of the Act partially succeeded.

The end result was that the six applications were refused for all but a handful of goods likely to be of ancillary, at best, interest to JLR, such as USB sticks, statuettes and balloons.

The case is a good example of the uphill battle faced by trade mark owners who wish to register three-dimensional shape trade marks. Even if a shape is one which is recognisable or might even be thought iconic in some circles, it will be very difficult to persuade the registrar that the shape itself performs a trade mark function, absent other traditional branding elements such as names and logos.

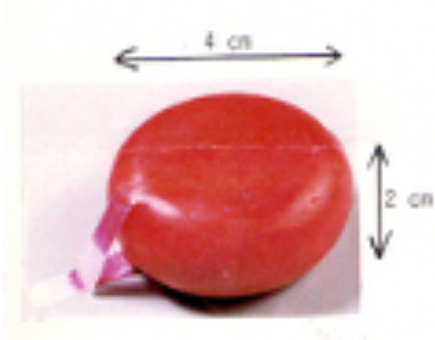
It is also interesting to note the Hearing Officer's comment that simply because a design is old fashioned does not mean it departs significantly from the norms and customs of the sector, as consumers will be aware of retro designs and will expect shapes of second hand goods to reflect the period in which they were originally designed and marketed.

Finally, we will need to wait a little longer for sorely needed guidance on the "difficult and developing" question of whether a shape adds substantial value to goods and is consequently objectionable under s.3(2), which the Hearing Office declined to consider in the absence of full arguments before him on the topic.

Author: Donna Trysburg, Trade Mark Attorney

THE FIGHT FOR THE BABYBEL TRADE MARK

This case concerns an appeal by Fromageries Bel SA (FBSA) against the decision of Hearing Officer (HO) Allan James to declare FBSA's UK trade mark registration no. 2060882 (the Trade Mark) for the 3D shape mark shown below invalid.



Mark Description/Limitation

“The mark is limited to the colour red. The mark consists of a three dimensional shape and is limited to the dimensions shown above”.

The invalidity action was brought by J Sainsburys Plc (Sainsburys) and they succeeded in invalidating the Trade Mark on the grounds that it did not fulfil the requirements of s.(3)(1)(a) of the Act. Essentially that the Trade Mark did not meet the definition of a trade mark and was not a sign capable of being represented graphically and capable of distinguishing the goods or services of one undertaking from those of other undertakings.

UKIPO decision

The Hearing Officer (HO) identified the essential characteristics of the mark as ‘the shape of the goods in the dimensions indicated in the representation of the mark, the protrusions making up the pull tag, and the colour red’. The case turned on whether the colour red was defined with sufficient clarity and precision.

The HO stated, where colour is an important element of a mark, such as in this case, ‘defining the colour with the broad description “red” is insufficiently precise to satisfy the requirement for a graphical representation of the trade mark.’ Importantly the HO went on to explain that the mark is not limited to the colours shown in the representation of the mark, as the description does not state this; furthermore, there is no rule that the representation of the mark trumps the description. The representation of the mark and

the description do not match, which leads to ambiguity; some people would regard the mark as including any shade of red per the description, whilst others would see the image of the mark and view it as covering only the specific shades of red that they see from the representation. Due to the lack of clarity over the parameters of the mark, the invalidity action succeeded under s.(3)(1)(a), on the grounds that it was not graphically represented, as was defined in s.1(1) of the Act at the time the Trade Mark was registered.

FBSA appealed the decision to the High Court, raising the following grounds:

- 1) The Hearing Officer was incorrect to apply the Sieckmann criteria to a mark that is not a colour mark per se.
- 2) The Hearing Officer failed to interpret the registration as limited to the red colour shown in the representation of the mark.
- 3) If the Sieckmann criteria apply to a mark which is not a colour mark per se, the proprietor of the mark should be allowed to limit the rights conferred by the mark by now specifying a particular pantone code.

High Court Decision

FBSA conceded the first ground, namely that the Sieckmann criteria does apply to all marks. They restated this ground to an argument that the Sieckmann criteria should be applied differently depending on the type of mark. In this case, as colour was one of several essential characteristics of the Trade Mark, there was no requirement to specify the hue of red in the description.

Judge Hacon disagreed and stated that where a mark contains colour but is not a colour per se mark, the need to precisely state the hue will depend on the extent to which other elements of the mark serve to make the mark capable of distinguishing. In this case, he held that the Trade Mark would only be capable of distinguishing if a particular colour red was used. Therefore, the Trade Mark should be limited to a single shade of red and the first ground of appeal was rejected.

Turning to the second ground of appeal, Judge Hacon agreed with the HO that the Trade Mark is not limited to the particular shade of red shown in the picture, stating ‘the picture does not take precedence over the description’. Based on the description, it would be concluded that the colour red encompassed any shade of red and, if this conclusion was not reached, it would result in an inconsistency between the description and the picture. As such, the second ground of appeal was rejected.

Lastly, FBSA applied to limit the rights conferred by the Trade Mark by specifying the pantone code as Pantone 193C. This was deemed not permissible as it would introduce an additional feature in to the content of the Trade Mark and would make it distinctive, which would affect the description of the mark.

As such, FBSA's appeal was dismissed and the invalidity action was upheld by Judge Hacon.

Take home points

This case demonstrates the importance of clarity as to subject matter of the mark to be protected and, in particular, the challenges of registering non-conventional marks. It also highlights the need to carefully review the representations of existing trade marks to ensure they are not at risk of similar validity challenges.

Although the requirement for a trade mark to be graphically represented has been removed from s.(3)(1)(a) of the Act, the requirement for a trade mark to be represented clearly and precisely remains, as does the need for a trade mark to be capable of distinguishing the goods or services of one undertaking from those of other undertakings. The issues raised in this case therefore remain important.

Author: Roshani Muniweera, Trade Mark Attorney

SUSSEX ROYAL

There was a significant amount of press attention given recently to the trade mark applications filed by Prince Harry and Meghan Markle in the name of their foundation, Sussex Royal The Foundation Of The Duke And Duchess Of Sussex ("the Foundation").

As can often be the case with reports on other trade mark matters that make the news, the coverage by mainstream news outlets was, at times, inaccurate and appeared to lead to some confusion, even among some industry professionals.

To summarise the series of events:

- A UK application for SUSSEX ROYAL was filed on 21 June 2019 covering Classes 16, 25, 35, 36, 41 and 45.
- An International application was then filed, claiming priority from the filing date of the UK application and designating the EU, the USA, Canada and Australia.
- The UK application was subsequently withdrawn as part of the settlement reached between the Royals, but before it was withdrawn, no fewer than 14 Notices of Threatened Opposition were filed against the UK application!
- In addition, various other applications containing the words SUSSEX ROYAL were filed around

the world by third parties in 2020 before the withdrawal of the UK application. This included applications at the EUIPO, and in the USA, Canada, Switzerland, Italy, Germany, Romania, Hungary, Spain and Argentina.

The withdrawal of the UK application has possibly saved the Foundation a lot of time and money in dealing with disputes that may have followed. Although we will not be able to see how these played out, this matter still highlights some important learning points for individuals and businesses when launching a new brand:

- File an application and secure your domain names before announcing a new brand – By doing this, you obtain a filing date and secure your position against any third parties who may seek to file applications or register domain names themselves after you announce your intentions for a new brand. Filing first in remote jurisdictions where the trade mark register cannot be easily searched is possible if you are keen to keep the details of an announcement under wraps.
- Make use of the priority period – Once your first application is filed, you will have six months to file in other countries while claiming priority from the first filing date. At this stage, careful thought should be given as to where you intend to use your mark now and in the future. Defensive filings can also be considered in some countries.

If you file in a country in the future, after the priority period ends, you may find that other third parties have obtained earlier rights and these can be difficult, if not impossible, to overcome.

- Conduct clearance searching – Clearance searching for a new mark is always advisable and is best done before final business decisions are made. In the current case, many of the applicants who filed later applications containing the words SUSSEX ROYAL may have benefited from clearance searching, as this could have revealed the International application that was filed by the Foundation.
- Be aware of laws and regulations surrounding emblems and other protected marks – The reason for the withdrawal appears to have primarily been the Foundation's inability to use a mark containing the word ROYAL for commercial gain under UK Trade Mark law. This is something for others to bear in mind when deciding on a new mark. Many countries have laws and regulations surrounding particular emblems or words that can only be used in certain circumstances and it is important to check this before proceeding if there is any doubt.

Author: Connor Thorogood, Trade Mark Attorney

RECENT DEVELOPMENTS

Venezuelan Trade Marks Office

There have been two recent developments at the Venezuelan Trade Marks Office:

- First, as of 10 February 2020, all new trade mark applications must exclusively use the International Nice Classification system to classify goods and services, rather than the local classification system, which had previously been applicable. This is welcome news as it brings the Venezuelan Office in line with many IP Offices around the world and is intended to speed up and simplify examination and prosecution of applications.
- Second, a new service has launched which enables interested parties in opposition proceedings to file a request and pay an accompanying fee to speed up the issuance of decisions. Please contact your usual advisor for more information if this expedited service is of interest.

Increase in official filing fees in Tunisia

We have received unwelcome news that official fees at the Tunisian Trade Marks Office have recently increased by 100%. Please contact your usual advisor for more information, particularly if you are considering a new trade mark filing in this territory.

Applicant email address now required for US trade marks

From 15 February 2020, it has become mandatory at the United States Patent and Trade Mark Office ("USPTO") to provide an email address for each Applicant when filing new trade mark applications. This will affect any new national trade mark applications filed from this date and, unfortunately, the USPTO will not issue a filing date for an application without it.

Even if there is an appointed representative, a separate email address for the Applicant is required. The rationale behind this is understood to be so that the USPTO can contact the Applicant if representation ends.

This change will, at least for now, not affect new International trade mark applications which designate the US because these are transmitted to the USPTO by WIPO and do not include an email address for receiving USPTO correspondence.

For pending trade mark applications / designations, an Applicant email address will need to be provided when responding to any examination reports that issue, or when filing post-registration maintenance documents and renewal applications, in order to maintain existing trade mark registrations on the USPTO Register.

RECENT DEVELOPMENTS CONT.

We would recommend creating a specific generic email address specifically for communication and correspondence related to US trade mark matters – for example, trademarks@companyname.com or USPTO@companyname.com - and details of this should be provided to your usual advisor here at Boulton Wade Tennant.

The USPTO will only use the email address provided in instances where they cannot contact your attorney of record, so its use should be rare.

Canada and Brazil join the Madrid Protocol

The World Intellectual Property Organization (“WIPO”) has confirmed that Canada and Brazil have now joined the international trade mark registration system, with effect from 17 June 2019 and 2 October 2019, respectively.

Until now, it has only been possible to file applications at the national Canadian and Brazilian trade mark offices, when protection was sought in these territories.

Going forward: depending on the total number of territories of interest, it should now be easier and more cost-effective for many to register trade marks in Canada and Brazil via the International registration system.

Furthermore, and importantly for those with existing International Registrations, it is now also possible to file for “subsequent designations” in these two countries, i.e. to add Canada and Brazil to the existing International Registrations.

South Africa approves Madrid Protocol accession

In further exciting news, South Africa’s accession to the Madrid Protocol was approved by its Parliament in November last year. It will take some time for the required legislative amendments to be written into law, enabling South Africa to officially join the international registration system but watch this space!

Myanmar update

Myanmar’s long-awaited new Trade Mark law is not yet in force but latest guidance suggests that this may happen sometime during the middle of this year. In preparation for the changes, we set out below what we know so far:

- There is expected to be an initial “soft opening” of the new IP office, during which it will be possible to re-file marks registered under the current law via a Declaration of Ownership.
- The soft opening is expected to last for 6 months, following which there will be a “grand opening” of the new IP Office. Marks not registered under the current law can only be filed following the grand opening.
- Filing fees will apply to re-filed applications, but these are not yet known. The IP Office is expected to announce the fees towards the end of the soft opening period, following which we expect local professional fees to be set.
- Re-filing during the soft opening means that the re-filed application will take precedence over applications filed when the IP office has its grand opening.

If you have trade marks registered under the current law via a Declaration of Ownership and would like continued protection for these marks under the new law, then please contact your usual advisor to discuss further.

Please also contact your usual advisor if protection for new trade marks is of interest in Myanmar to discuss the timing of any such new applications. It is recommended to consider registering new trade marks under the current law as soon as possible, in order to take advantage of the soft opening period under the new law. It is possible that Covid-19 will affect the timing of the new law, but we will endeavour to keep you updated with developments.

New misleading invoice alert from the EUIPO

The EUIPO has issued an alert for a new type of misleading invoice/demand for payment, this time taking the form of a fake EUIPO decision. [Read more.](#)

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