

D YOUNG & CO TRADE MARK NEWSLETTER *no.81*

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Assos v Asos Own name defence to infringement



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Having recently returned from a successful INTA conference in San Diego, we are looking forward to the annual MARQUES conference in Austria this September, which Anna Reid and Matthew Dick will be attending. Matthew will also be speaking about European design rights at the IIPLA Global IP Summit in London at the end of July. If you'd like to set up a meeting with D Young & Co at either event, or indeed at any other time, please do get in touch.

We hope that you find this month's selection of articles of interest and, as always, we welcome your feedback. We wish all our readers an enjoyable summer.

Editors:

Jackie Johnson & Matthew Dick



Events



29-30 July 2015

IIPLA Global IP Summit, London, UK

The International IP Law Association Global IP Summit 2015 is a forum of in-house IP lawyers, partners, IP agencies, law firms and legal service providers. Matthew Dick will be speaking about European design rights during the summit.

15-18 September 2015

MARQUES Conference, Vienna, Austria

Matthew Dick and Anna Reid will be representing the D Young & Co trade mark and dispute resolution and legal teams at the MARQUES annual conference.

25 September 2015

London Design Festival, UK

Jonathan Jackson and guest speakers from top brand leaders will talk about how to protect and enforce designs. This free seminar at the V&A will be followed by an IP drop-in Q&A.

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Infringement / likelihood of confusion

Assos v Asos Own name defence to infringement

The Court of Appeal has held that use of the mark ASOS did create a likelihood of confusion with the trade mark ASSOS; but, by a majority of 2:1, it also decided that Asos could rely on a defence to that infringement since it was using its own name.

Background

The claimants manufacture and sell specialist cycling products (including clothing) under the ASSOS mark, at the top end of the market. Most of these are sold through distributors in-store; Assos does not encourage the sale of the items on the internet, and does not have an online store. It has various registrations for the ASSOS mark, including a Community trade mark (CTM) covering goods including clothing, footwear, and headgear.

Asos, the defendant, founded in 1999 under the name "As Seen On Screen", is an online fashion and beauty retail business. It has always traded purely online, originally selling only other companies' clothing. The acronym ASOS was adopted in 2002. Around 2004, Asos started to sell its own clothing under the ASOS mark (protected by a UK registration for various goods including clothing).

Assos alleged that Asos' selling clothing and other fashion accessories via the internet under the ASOS mark infringed its CTM and constituted passing off, and that Asos' UK mark was partially invalid. Asos counterclaimed for revocation of Assos' CTM claiming that it had only been used in relation to specialist cycling clothing and ancillary products. It also argued that, at the date of filing the CTM and any relevant priority, it had acquired goodwill in the ASOS mark, and that there had been no customer confusion. In any event Asos felt that it should be entitled to rely on the 'own name' defence, since ASOS was its corporate/trading name and had been adopted honestly.

At first instance, the court partially revoked the CTM and ordered that the specification be limited to "specialist clothing for racing cyclists; jackets, t-shirts, polo shirts, track-suit tops, track-suit bottoms, casual shorts, and caps". (Two members of the Court of Appeal have since agreed with

this, but deleting the word 'racing'.)

The trial judge found that while ASSOS and ASOS were similar, there was no likelihood of confusion, and that use of ASOS had not damaged the distinctive character or repute of the ASSOS mark. Accordingly, the own name defence did not require examination.

Both parties appealed.

Infringement

The Court of Appeal has held that the trial judge erred when assessing the likelihood of confusion between the marks. Although she had correctly found that there was no evidence of actual confusion, she had erred by focusing on that alone. She should also have considered notional and fair use of the mark as registered.

The Court of Appeal accepted that neither mark had a conceptual meaning to the average consumer, rejecting the notion that ASOS is recognised as an acronym for "As Seen On Screen". Furthermore, the marks are visually and aurally very similar. The court held that there was a likelihood of confusion, at least in relation to sales by Asos of casual wear and retail services relating to those goods. The court felt that the trial judge should have found similarly, subject to any applicable defences and attacks on the ASSOS registration.

The Court of Appeal also considered whether use of the sign ASOS took advantage of, or was detrimental to the distinctive character or repute of the ASSOS mark. For this ground to succeed, the earlier mark must have a reputation and use of the later sign must call the earlier mark to mind. The trial judge had found no infringement here, but the Court of Appeal again disagreed. It felt that infringement had been made out, since Assos had shown that:

- the ASSOS mark has a reputation;
- use of the sign ASOS gave rise to a link with the ASSOS mark in the mind of average consumers; and
- the ability of the ASSOS mark to identify at least some of the goods for

The court held that there was a likelihood of confusion, at least in relation to sales by Asos of casual wear and related retail services



which it was registered as being the goods of Assos had, at least in some circumstances, been weakened.

The mark had therefore suffered damage.

Own name defence

A key question (on which not all the appeal judges agreed) was whether Asos could rely on the 'own name' defence to infringement.

The defence allows a party (including companies) to use its own name in the course of trade, provided it is in accordance with honest practices in industrial or commercial matters. In this respect it was pertinent that the ASOS name had arisen honestly as an acronym for "As Seen On Screen", and that in 2005 the ASOS logo had been simplified, without any knowledge of Assos. Asos' intentions were also relevant, as was the gradual development of the businesses over several years. Despite not having conducted extensive trade mark searches prior to adopting the ASOS name, taking into account all the circumstances, the majority of the judges found that use of the ASOS name was in accordance with honest practices. Asos had not conducted its business so as to compete unfairly with Assos, and overall could benefit from the own name defence.

Dissenting view

One of the three judges disagreed with the majority view on two points:

- The scope of the limitation to the specification of Assos' mark.

> Case details at a glance

Jurisdiction: England and Wales

Court: England and Wales Court of Appeal (Civil Division) on appeal from the High Court of Justice Chancery Division IP Community Trade Mark Court

Parties: Roger Maier and Assos of Switzerland

SA v ASOS plc and ASOS. com Limited

Citation: [2015] EWCA Civ 220

Date: 01 April 2015

Full decision: <http://dycip.com/asos0415>

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the law required the interests of the CTM proprietor (and the relevant public) to be given significantly more weight than the other judges had allowed. Accordingly he felt that the own name defence should not be available to Asos. At the time of writing, no further appeal has been filed.

Author:

Claudia Rabbitts



In short

Although Asos was able to rely (somewhat controversially) on the own name defence, the case highlights the importance of conducting full searches before adopting a brand. Internet searches alone are not necessarily sufficient to ascertain whether a new brand is clear to use: relevant third party rights may not be revealed by the search, as was the case here.

The case also shows how difficult it can be to judge the appropriate extent of a trade mark's specification once it is attacked.

It's a name game Scrabble wins appeal in Scramble squabble

The Court of Appeal recently handed down its judgment in an interesting case relating to the well-known word game SCRABBLE. Mattel, owners of the SCRABBLE brand, had issued proceedings for trade mark infringement and passing off against Zynga, creators of the word game SCRAMBLE (or SCRAMBLE WITH FRIENDS). At first instance all but one of Mattel's claims were dismissed, but the court held that use of the word SCRAMBLE with a stylised 'M' (depicted below), could "on a quick glance" lead to confusion with the mark SCRABBLE.



An earlier word mark for SCRAMBLE, owned by Mattel, was also held to be invalid/revoked as being descriptive and/or generic (otherwise Zynga's use would have infringed it). Both sides appealed.

Mattel scores in Court of Appeal

The Court of Appeal largely ruled in Mattel's favour. It felt that the judge at first instance had erred by not properly applying the jurisprudence and guidance developed over many years and handed down by the Court of Justice of the European Union (CJ). Accordingly it felt able to disagree with his findings.

Context of use

Mattel had argued that the context in which it had used the SCRABBLE mark (eg, in association with tiles, numbers, the concept of premium word scores, background colour) was relevant to the assessment of infringement. The court disagreed, holding that only very limited extraneous matter could be taken into account (following the Specsavers case, reported here: <http://www.dyoung.com/article-specsaversvasda0913>, which had limited such extraneous matter to the use in colour of a mark registered in black and white).

Minimum threshold of similarity

The Court of Appeal also considered whether a minimum threshold of similarity between two marks was required before a court could consider there to be a likelihood of confusion. The trial judge had (perhaps surprisingly) held that there was no confusion between the words

SCRAMBLE and SCRABBLE. The Court of Appeal reviewed a number of CJ decisions and held that no such minimum threshold existed. Rather it is overall similarity that matters, taking all relevant circumstances into account.

SCRAMBLE mark restored

The trial judge had held the SCRAMBLE mark to be descriptive or generic, noting that it described what was required in Zynga's game ('scrambling' for words from letters), and had also been used by third parties for similar word games. The Court of Appeal disagreed. Although there was a degree of descriptive allusion, overall it felt that SCRAMBLE was not so descriptive as to be unregistrable, and certainly not generic in the sense of being the customary/established means of referring to word games in the European Union. The validity of Mattel's earlier SCRAMBLE mark was therefore restored.

The Court of Appeal agreed that the marks SCRAMBLE and SCRAMBLE WITH FRIENDS were confusingly similar. Therefore, since Mattel's SCRAMBLE mark was now valid again, Zynga's use infringed it.

Likelihood of confusion and unfair advantage

As regards infringement of the SCRABBLE marks, the Court of Appeal held that the trial judge's finding that SCRABBLE and SCRAMBLE were not similar "cannot be supported". There was obvious visual, phonetic and even conceptual similarity between the marks. Nevertheless, the Court of Appeal agreed with the trial judge that (even with a finding of similarity between the marks), there was no likelihood of confusion.

Much of the evidence relied on by Mattel to prove confusion had consisted of consumers' comments on the Internet in tweets and/or game reviews. Comments such as "I thought I read Scrabble but is scramble lol. Downloaded it and skipped tutorial thinking they were the same thing [sic]" and "I am terrible at scrabble with friends" were not sufficient to sway the Court of Appeal to find a likelihood of confusion. It was persuaded that there had been a lot of side-by-side use of the marks, and that Zynga's use of SCRAMBLE had

Case details at a glance
Jurisdiction: England and Wales
Court: England and Wales Court of Appeal (Civil Division) on appeal from the High Court of Justice
Parties: J W Spear & Sons Ltd, Mattel Inc and Mattel U.K. Limited v Zynga INC
Citation: [2015] EWCA Civ 290
Date: 27 March 2015
Full decision: <http://dycip.com/scramblevscrabble>

been extensive and pervasive. Accordingly, the court felt that if there was a real likelihood of confusion, it would have manifested itself in far more abundant evidence of actual confusion – the court did not think that this had been shown. Therefore, the court held that the degree of similarity between SCRABBLE and SCRAMBLE was not sufficiently great to give rise to a likelihood of confusion.

The court also held that there was not sufficient evidence of unfair advantage/detriment for Mattel's claim relating to reputation of the SCRABBLE mark to succeed.

Finally, the Court of Appeal held that there was no infringement by Zynga by its use of the SCRAMBLE logo with the stylised 'M' (which, Mattel had argued, resembled a twisted 'B'). If consumers were reading the 'M' as a twisted 'B', the court felt this would have been reflected in the evidence, which was not the case.

Overall, therefore, this was a win for Mattel.

Author:
Matthew Dick



In short

The court's findings as regards the lack of likelihood of confusion (despite relatively powerful evidence that consumers commonly confused the marks, and the limited visual and phonetic differences between them) reinforces the notion that when considering infringement, the court will look at the overall context in which the allegedly infringing mark has been used.

The extent of side-by-side use of allegedly conflicting marks, and how pervasive a defendant's use has been, may well be important.

Mixing the grape and the grain isn't an IP headache High Court overturns wine and whisky decision

The High Court of Justice has overturned a decision of the United Kingdom Intellectual Property Office (UKIPO) which found a likelihood of confusion between the marks JURA ORIGIN and ORIGIN.

The applicant, Whyte and Mackay, applied to register the mark JURA ORIGIN for Scotch whisky. The opponents, Origin Wine UK Limited and Dolce Co Invest Inc, brought an opposition based on, among other things, a UK trade mark registration for the mark ORIGIN which had been genuinely used in relation to wine, and the following Community trade mark (CTM) registered for alcoholic beverages including wine (the 'ORIGIN mark'):



In the decision, the Hearing Officer considered that both of the opponents' earlier marks had the same level of inherent distinctiveness. He then went on to compare the marks ORIGIN and JURA ORIGIN and concluded that the dominant element of the application was the mark JURA, but that the word ORIGIN retained an independent distinctive role within the applicant's mark. The Hearing Officer also concluded that the goods covered by the marks shared a low degree of similarity and therefore concluded that there was a likelihood of confusion between the marks.

In relation to the ORIGIN mark, the Hearing Officer considered that whilst the leaf device was eye-catching, such devices are commonplace on alcoholic labels and would go unnoticed by consumers. Overall, the Hearing Officer concluded that there was a moderate degree of similarity between the marks and as the goods concerned were identical, this resulted to a likelihood of confusion between the marks.

Origin Wine and Dolce Co Invest appealed to

the High Court. The basis of the appeal was essentially that the Hearing Officer had failed to:

- a. apply the Medion case correctly;
- b. fully analyse the visual, aural and conceptual similarities between the marks; and
- c. give account to the fact that the common element between the marks had a low level of distinctiveness which is not usually sufficient to result in a likelihood of confusion between the marks.

The appeal was heard by Arnold J who decided as follows.

1.Failure to apply the Medion case correctly
Arnold J agreed that an error of principle had occurred because the Hearing Officer had failed to consider how the average consumer would understand the ORIGIN mark in the context of the relevant goods.

In particular, Arnold J held that the average consumer would understand ORIGIN as referring to the origin of the goods ie, as indicating that the goods originate from JURA. This was particularly so given that the product at issue was Scotch whisky, the origin of which is a very important factor to consumers. Accordingly, Arnold J held that the ORIGIN mark was inherently descriptive or at the least non-distinctive in relation to the goods and that the word ORIGIN would not be considered to have an independent distinctive role within the application.

2. Failure to fully analyse the visual, aural and conceptual similarities between the marks
Arnold J agreed that the Hearing Officer committed errors of principle when comparing the mark JURA ORIGIN with ORIGIN mark., as the Hearing Officer had discounted the vine leaf element of the ORIGIN mark, despite describing it as "eye-catching" earlier in his decision. Arnold J considered that the vine leaf element was conceptually relevant as it reinforced the message that the ORIGIN mark originated from a wine producer.

3. Failure to give account to the fact that the common element between the marks

Case details at a glance
Jurisdiction: England and Wales
Court: High Court of Justice Chancery Division
Parties: Whyte and Mackay Limited v Origin Wine UK Limited and Dolce Co Investing
Citation: [2015] EWHC 1271 (Ch)
Date: 06 May 2015
Full decision: <http://dycip.com/origintrm>



has a low level of distinctiveness which is not usually sufficient to result in a likelihood of confusion between the marks.
Arnold J concluded that the Hearing Officer had erred as a result of his earlier error when assessing the distinctive character of the two earlier marks. Having concluded that there were various errors of principle in the Hearing Officer's decision, Arnold J went on to re-consider whether there was a likelihood of confusion between the marks at issue.

Conclusion

Arnold J concluded that, on an overall assessment, there was no likelihood of confusion between the marks JURA ORIGIN and ORIGIN.

Author:
Anna Reid



In short

This case includes a helpful discussion of the Medion case.

It also serves as a helpful reminder of some of the principles surrounding likelihood of confusion and composite marks (ie, marks into which the entirety of an earlier mark has been subsumed).

Sky rains on Skype's parade

Sky v Skype

In the latest stage of a long-running battle, the General Court (GC) has upheld broadcaster Sky's oppositions to telecommunication company Skype's Community trade marks (CTMs) for the SKYPE word and figurative marks on the basis that they are confusingly similar to SKY.

Skype Ultd (Skype) applied for the word marks SKYPE and figurative mark 'Skype' as CTMs (the 'Skype marks') in 2004/2005 for a range of goods and services in classes 9, 38 and 42. Sky plc and Sky IP International Ltd (together 'Sky') opposed the applications on the basis of their earlier word CTM, SKY, filed in 2003 and registered in 2008, which covers goods and services in classes 9, 38, 41 and 42.

Sky was successful at first instance and on appeal. Skype appealed to the GC, submitting that the SKY and Skype marks were not similar; that the Skype marks had acquired a secondary meaning; and that there had been coexistence on the market without confusion for a number of years.

Findings of the General Court

The GC agreed with the Board of Appeal's analysis, that the relevant public was the public at large and professionals. Whilst the court sympathised with Skype's argument that the relevant consumer chooses some of the goods and services covered by the marks at issue with care, as peer-to-peer communication services are aimed at a general public, it should be assumed that the relevant consumer does not have greater technical expertise than the average end consumer.

When assessing similarity, the GC endorsed OHIM's findings that the goods and services were identical and that there was a medium degree of visual, phonetic and conceptual similarity between the marks. The figurative element in the Skype mark, surrounding the word element 'skype' with a borderline in the shape of a cloud or bubble, was deemed to have a merely decorative function, as it simply highlights the word 'skype' without adding an identifiable shape. Indeed, the relevant public might recognise the border as a cloud, which



could increase conceptual similarity as clouds are found in the sky. Further, the word 'sky' might be recognised within 'skype', being located at the beginning of the marks applied for. Skype's argument that both signs are relatively short and therefore differences have greater weight did not undermine this analysis. Moreover, the court agreed that SKY had an enhanced distinctiveness in the UK, on account of the public's recognition of it, in respect of some relevant goods and services in classes 9, 38 and 41; and noted that enhanced distinctiveness could apply to areas of activity that were being developed at the time of Skype's filing.

Skype's claims that:

1. the Skype marks had high distinctiveness, having acquired, through extensive use, a secondary meaning;
2. the SKY mark had a low inherent distinctiveness and its use by third parties had resulted in dilution of the brand; and

3. the SKY and Skype marks had peacefully coexisted on the market for a number of years without confusion

were all rejected by the GC.

First, the court considered that claim (1) amounted to nothing other than distinctiveness acquired through use and the mark did not itself convey conceptual information. This would not in any case be a defence to an opposition; the court noted that it is recognition by the relevant public of the earlier mark (rather than the mark applied for) that is relevant when considering likelihood of confusion.

Regarding claim (2), the GC considered that any weak inherent distinctiveness of SKY for some goods and services would not affect others and would be outweighed by the SKY mark's enhanced distinctiveness on account of its very high reputation.

Claim (3) was rejected as the marks had only

➤ **Case details at a glance**
Jurisdiction: European Union
Court: General Court
Parties: Skype Ultd v OHIM, Sky plc and Sky IP International Ltd
Citations: T-423/12, T-183/13 and T-184/13
Date: 05 May 2015
Full decisions: <http://dycip.com/T-423-12>, <http://dycip.com/T-183-13> and <http://dycip.com/T-184-13>

coexisted for peer-to-peer communication services, which was not core to SKY's business, and coexistence for one isolated and highly specific service was insufficient to diminish likelihood of confusion for the entirety of those goods and services.

Comment

It will be interesting to follow Skype's inevitable appeal to the Court of Justice of the European Union; if Skype does not succeed at that final stage, the Skype marks will not be registrable. However Skype will not be faced with a rebrand unless and until Sky brings infringement proceedings against Skype's use of the Skype marks (and even then, the English courts may reach a different conclusion to OHIM). Notably, Sky has already successfully asserted its rights against Microsoft, who acquired Skype in 2011, when Microsoft was forced to change the name of its "SkyDrive" offering to "OneDrive".

Author:
Jennifer Heath



In short

The GC upheld Sky's opposition to the word and figurative Skype marks on the basis that they are confusingly similar to the SKY mark.

Skype's claims that the Skype marks had high distinctiveness; that there was dilution of the Sky brand; and that the marks were coexisting were all rejected.

This case concerns registry proceedings so does not prohibit Skype from continuing to use its marks.

Can you be happy in Alicante?

Assessing inherent distinctiveness

➤ **Case details at a glance**
Jurisdiction: European Union
Court: General Court
Parties: Steinbeck GmbH v OHIM
Citations: T-707/13 and T-709/13
Date: 30 April 2015
Full decisions: Not available in English at time of print

For a while now the widespread perception has been that OHIM's policy regarding the registrability of marks has gradually been becoming more and more strict. A recent case from the General Court (GC) confirms these fears to the extent that marks often acceptable to the UK Intellectual Property Office (UKIPO) and certainly the US Patent and Trademark Office (USPTO) are often summarily dismissed in Alicante despite the best efforts of brand owners and their outside advisors.

Registration of the BE HAPPY trade marks

The case concerned the trade mark BE HAPPY, originally registered by the trade mark owner Creativ Ent. GmbH back in 2007 for a range of goods in classes 16, 21, 28 and 30, with a subsequent and separate registration in 2010 for goods in classes 9, 11 and 18. Both marks proceeded through the application process without obstacle and neither mark was opposed with the result that both were registered.

Cancellation of the BE HAPPY trade marks due to lack of distinctive character

In February 2012 applications were filed by a German competitor seeking a declaration of invalidity on the basis that the marks were devoid of any distinctive character. The Cancellation Division upheld the application for invalidity, a decision confirmed by the Board of Appeal. The trade mark owner took the case to the GC which issued its judgment on 30 April 2015. The GC concluded that, whilst the trade mark BE HAPPY expresses an objective message inviting one to "be happy", the message is not a direct reference to the quality or nature of the goods covered by the contested marks. Notwithstanding this the court found that the mark BE HAPPY would immediately be perceived by the public as an expression that promotes the purchase of goods/services. The GC therefore concurred with the Board of Appeal that the mark was devoid of any distinctive character because of its "promotional and laudatory nature".

The owner had alleged before the Board of Appeal that the decision to cancel the registration was merely as a result of recent case law for slogans which have, for the most part, been rejected outright

as unregistrable before OHIM; however, the GC rejected this argument.

The owner was left with two cancelled registrations despite originally being protected for a range of goods including computers, glasses, coffee making machines, bags and handbags, games and confectionery. As a result one might reasonably conclude from the judgement of the court that BE HAPPY would be unregistrable in respect of any goods/services.

You can BE HAPPY in class 10

Readers may therefore be interested to learn that in the very same month as this judgement OHIM has examined, accepted and published another application for BE HAPPY in relation to goods in class 10. Is this an inconsistency on the part of OHIM?

The case law is clear in that if consumers can make a direct link between the goods and the mark in question then there is likely to be an absence of distinctive character. Can the acquisition of a handbag make you "be happy"? What about the consumption of sweets?

Readers can decide whether or not they would place the goods of the very recently accepted application into the same category or not. They include a wide range of goods which can probably best be described as "providing adult pleasure" and thus one might think, happiness (temporary or otherwise). Time will tell whether the resulting registration will stand up to any subsequent challenges.

In any event, we see no real reason why the BE HAPPY mark should not be registrable on the basis that the proprietor would only be able to prevent third parties from using marks virtually identical to those as protected. In the case of the phrase "be happy", the trade mark owner could never hope to monopolise either word appearing in its mark – thus its rights would lie in a combination of the two and be afforded a very limited scope of protection. OHIM's approach to assessing inherent distinctiveness continues to be increasingly strict.

Author:
Jeremy Pennant



D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

Trade mark procedure and practice

New titles and fewer pages EU and UK trade mark reforms

EU trade mark reforms could include a misleading change

Following two years of discussion, the European Parliament, Council of Ministers and European Commission have all now issued statements indicating agreement to the policies for reform of the trade mark system in the European Union.

The proposed reforms will attempt to create closer cooperation between national offices and the Office for Harmonization in the Internal Market (OHIM) and a streamlined process to registration and contentious matters. They will also introduce additional benefits such as reduced Community trade mark (CTM) official fees and enhanced rights to trade mark owners against counterfeit goods while they are in transit across the EU.

The reforms will also see OHIM renamed as the 'European Intellectual Property Office'. Whilst the potential benefits of streamlined processes, enhanced rights and reduced fees are welcome, we can't help find OHIM's proposed new name rather misleading – being an 'IP office' indicates they administer all IP including patents, but they do not!

UKIPO – contentious proceedings no longer a matter of 'War and Peace'

A recent Tribunal Practice Notice issued by the United Kingdom Intellectual Property Office (UKIPO) has brought in a restriction to the number of pages which can be filed in standard evidence rounds of contentious matters.

The UKIPO indicates this move is due to parties filing what they consider to be "irrelevant or unnecessary evidence" and a growing concern over the resources required by the office to review and process it. Going forward the main evidence filed by both parties will be limited to 300 pages, with evidence filed in reply limited to only 150 pages. These page limits do not include any written arguments or submissions which accompany the evidence. There are various ways we can adapt evidence filed to ensure it is within these page limits but sufficient for its purpose, especially when proving reputation. However, if you are concerned please speak to your usual D Young & Co trade mark advisor.

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