

D YOUNG & CO TRADE MARK NEWSLETTER *no.80*

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VOLVO v REVOLVO spins back to the UKIPO Volvo's success revolves around fatal flaws in first assessment



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Readers will, we hope, be pleased to hear that content for the third edition of our 'European Trade Mark Decisions' book is being considered. We have also begun work on the first edition of a collection of influential and notable design cases. There's plenty to prepare! We expect to publish both books towards the end of this year. Do let us know if you would like to receive a copy of either book hot off the press. We are also delighted to welcome legal assistant Philippa Priestman to our dispute resolution and legal team, and Jennifer Heath as assistant to our trade mark team.

Editors:

Jackie Johnson & Matthew Dick



Events



02-06 May 2015

INTA, San Diego, US

Jeremy Pennant, Ian Starr, Jackie Johnson, Helen Cawley, Tamsin Holman and Matthew Dick will be attending the 137th Annual INTA meeting in May. If you would like to schedule a meeting with us during INTA please do get in touch.

13-14 May 2015

The Business Show, London, UK

Partners Matthew Dick and Nicholas Malden will be talking about the essential IP checklist that start-ups and SMEs should be aware of, during this popular UK business show. Members of all our IP teams (patents, trade marks, dispute resolution and legal) will be on hand at our stand (257) to answer IP questions.

9-12 June 2015

ECTA, Hamburg, Germany

D Young & Co trade mark associate Richard Burton will be attending ECTA's 34th Annual Conference in Hamburg.

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Opposition grounds

VOLVO v REVOLVO

spins back to the UKIPO

Volvo's success revolves around fatal flaws in first assessment

A recent decision of the Appointed Person has found fatal flaws in the Hearing Officer's assessment in a case relating to the marks VOLVO/REVOLVO. The case has been returned to the UK Intellectual Property Office (UKIPO) for a fresh assessment.

Application for REVOLVO

In 2010 Eriks Industrial Services Limited applied to register REVOLVO as a UK trade mark for bearings and parts and fittings covered under classes 7 and 12, as well as design consultancy services related to the aforementioned goods.

Opposition of the application

Volvo Trademark Holding Aktiebolag (Volvo) opposed the application under Sections 5(2)(b), 5(3) and 5(4)(a) on the basis of their earlier UK and Community trade marks for VOLVO, which covered a range of identical and similar goods/services in classes 7, 12 and 42.

The UKIPO rejected the opposition in its entirety finding that there was no likelihood of confusion regarding the class 12 goods. The grounds of opposition under Sections 5(3) and 5(4)(a) and relating to the goods covered by classes 7 or 42 were not considered, because, in the Hearing Officer's opinion, Volvo's position could be no stronger on those bases.

Volvo appealed the decision to the Appointed Person claiming that the Hearing Officer was wrong to have found no likelihood of confusion under Section 5(2)(b), and had fundamentally erred by failing to consider the opposition under Sections 5(3) and 5(4)(a).

In consideration of the case under the various grounds, the Appointed Person found as follows:

Section 5(2)(b) – likelihood of confusion

This ground of Volvo's appeal was dismissed. The Hearing Officer had concluded that there existed only a moderate degree of visual and aural similarity between the marks. This was on the basis that:

- REVOLVO was a single invented word of which VOLVO was not the dominant element;
- the viewing public would not dissect the mark into 'RE' and 'VOLVO'; and
- the marks had no conceptual similarity as VOLVO would be seen as an invented word with no meaning, whereas REVOLVO would be seen as an invented word suggestive of the word REVOLVE.

Volvo argued that the Hearing Officer had failed to take into account that the only difference between the marks was the nondistinctive prefix 'RE', and that the presence of the well known and recognised brand name VOLVO within the contested mark meant that, even if the Hearing Officer did find that REVOLVO was suggestive of the word 'revolve', he should nevertheless have found there existed a likelihood of confusion.

Volvo also argued that no evidence had been provided that the mark REVOLVO was suggestive of 'revolve'. The Appointed Person dismissed the latter argument noting that Volvo bore the onus of proving the opposition, and that it was seeking to challenge the weight the Hearing Officer had given to the evaluation of the average consumer's perception of the mark.

It was held that there had been no error of principle on the part of the Hearing Officer in assessing the similarity between the marks.

The Hearing Officer was entitled to take the view that the mark REVOLVO would be suggestive of the word 'revolve'.

The Appointed Person found that this assessment was based primarily on the fact that:

- 'revolve' was well understood to mean 'to roll', and evidence from both

> **Case details at a glance**
Jurisdiction: United Kingdom
Court: UKIPO decision
Parties: Volvo Trademark Holding Aktiebolag and Eriks Industrial Services Limited
Citation: O-061-15
Date: 02 February 2015
Full decision: <http://dycip.com/volvorevolve>

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 We regularly publish IP case updates and articles between newsletters. For up to the minute IP related articles and news visit <http://dycip.com/iparticles>

parties showed that one of the main purposes of a bearing is 'to roll';

- relevant consumers would understand that a bearing rotates in order to reduce friction; and
- no survey or other evidence was provided to show that the public would perceive REVOLVO in any other context.

Sections 5(3) and 5(4)(a) – reputation and passing off

Volvo's appeal under these two grounds was successful. The Hearing Officer had originally held the following :

- **Section 5(2)(b):** consideration of classes 7 and 42 involved the same arguments as class 12, and there would be no material change in the degree of care or consideration of the average consumer or a change in the conceptual evocation of REVOLVO.
- **Section 5(4):** due to the finding of no likelihood of confusion there would be no misrepresentation to make a valid claim under this ground.
- **Section 5(3):** despite Volvo clearly demonstrating the requisite reputation, due to the fact that the element 'volvo' would not 'stand out' in the contested mark it did not provide the necessary 'link' required.

On consideration of Volvo's appeal regarding Section 5(3), the Appointed Person felt it was not clear whether the correct assessment had been applied at first instance. Not only did the Hearing Officer seem to determine the nonexistence of a 'link' on the basis of an absence of a likelihood of confusion under Section 5(2)(b), but he had failed to consider that Volvo's reputation went much wider than class 12 goods, and had failed to take into account any other relevant factors, such as the uniqueness of the VOLVO mark. On this basis the Appointed Person found that the Hearing Officer had failed both to consider the grounds for opposition under Section 5(3) properly, and to give adequate reasons for rejecting it.

With regard to Volvo's appeal under Section

Volvo's goodwill extends to aftercare service and direct sales of genuine VOLVO parts



5(4)(a), the Appointed Person reiterated that this ground did not involve the same test as Section 5(2)(b), as it is dependant on actual 'use' of the mark and was to be assessed from the viewpoint of 'a substantial proportion of customers' (not the 'average consumer'). The Appointed Person agreed with Volvo's assertions that whilst the Hearing Officer had acknowledged Volvo's goodwill, he had in fact failed to assess its breadth, which extended to significant aftercare service and direct sales of genuine VOLVO parts.

The Appointed Person felt it was 'inescapable' that rejection of the Section 5(4)(a) ground had been based purely on a determination of the Section 5(2)(b) ground.

The opposition has now been returned to the UKIPO so a different Hearing Officer

can assess it properly under Section 5(3) and 5(4)(a). It will be interesting to see whether a full assessment of the opposition on these grounds will be able to rotate the decision back into Volvo's favour.

Author:
Wendy Oliver



In short

The Hearing Officer must assess all grounds of opposition on their individual merits and not on the assessment of any other grounds.

The onus on proving that an opposition is well-founded rests with the opponent.

Parallel importers of medicines can re-brand...for now

Speciality European Pharma v Doncaster Pharma and Madaus

➤ **Case details at a glance**
Jurisdiction: England and Wales
Court: England and Wales Court of Appeal (Civil Divisions)
Parties: Speciality European Pharma Ltd, Doncaster Pharmaceuticals Group Ltd and Madaus GmbH
Citation: [2015] EWCA Civ 54
Date: 06 February 2015
Full decision: <http://dycip.com/specialityvdoncasteranor>

Over the last thirty years, there has been substantial litigation throughout the European Union in relation to the parallel import of pharmaceuticals from one EU country to another. Such parallel imports are openly encouraged by the EU Commission and are seen as a way of harmonising prices in an area where there is great difficulty in persuading national governments to give up their national health policies.

Paranova guidelines for repackaging

One particular subject of this litigation has been the necessity (or otherwise) for parallel importers to change the brand used on the product they are importing to the one used in the importing country (whether by re-packaging or over-stickering of labels).

The principles to be adopted are now well-known and are called the 'Paranova guidelines' (after the Court of Justice of the European Union (CJEU) decision in Bristol Myers Squibb v Paranova joined cases C-427/93, C-429/93 and C-436/93).

Under those guidelines there are five criteria an importer must meet to be able to repackage a product and re-affix the trade mark upon it, but the key one here was whether use of the brand was "objectively necessary in order to market the product". To answer that question, the court stated that if it would "hinder effective access to the market of the importing member state, any prohibition [on use of the brand] would be unjustified". In this context, 'market' means a 'substantial part of the market'.

Speciality European Pharma v Doncaster Pharmaceuticals and Madaus

In this recent case, the English Court of Appeal (reversing a first instance decision) decided that:

Generic prescribing and fulfilment is actively encouraged by the UK Government



- there must be effective access to all parts of the market;
- even if the part of the market was less than 10%, it was still substantial;
- a parallel importer could not be forced to create a new brand and could use the existing brand.

The case in brief

The facts of the case are complex, but in brief, the generic name of the medicine in question was 'Tropium Chloride' and it was a prescription only medicine for bladder control. It came in two doses – 20mg (which was no longer protected by any patent) and 60mg slow release (which still enjoyed patent protection). Whilst the 20mg was still in patent, Doncaster had had a good business in parallel importing it and over-stickering with the generic name only.

Once the 20mg dose patents expired in 2009, generic companies captured the bulk of this market as their product was much cheaper.

Generic prescribing (and generic fulfilment by pharmacists) is actively encouraged by the UK Government and nearly 90% of prescriptions for 20mg tablets of Tropium Chloride were written generically. Only 8.6% were written with the brand name (REGURIN).

The 60mg slow release product was slightly different as it was protected by patents.

Under UK regulations slow release versions of generic medicines have to be branded (to differentiate them from non-slow release forms), although that branding does not need to feature the UK brand name of the patent owner. Generic prescribing is also still the norm despite the product being patented and branded.

In this case, generic prescriptions actually accounted for 62% of the 60mg market, with the balance being branded. Doncaster had access to all this market (as it had bought the product from, effectively, the patent owner in Europe whose trade mark rights were thereby 'exhausted' by law, meaning it would be

Nissan v OHIM Requests for renewals should be full and timely filed

➤ **Case details at a glance**
Jurisdiction: European Union
Court: General Court
Parties: Nissan Jidosha KK v OHIM
Citation: T-572/12
Date: 04 March 2015
Full decision: <http://dycip.com/t-57212>

very difficult to rely on them to prevent any re-selling of the product) – but Doncaster needed a brand to sell the product.

Decision of the Court of Appeal

The Court of Appeal held that not being able to access the 8.6% 20mg branded market was a reason why it was necessary to use a brand (as opposed to just the generic medicine name).

It then considered whether Doncaster should create its own brand or whether they could use the brand that was already in use by the patent owner's licensee in the UK (ie, REGURIN).

It was held that, given the vagaries of supply that face parallel importers, it was unrealistic to expect them to incur the costs of creating a new brand: prescribing doctors would not be persuaded to recommend a new brand where continuity of supply could not be guaranteed.

Positive news for parallel importers?

Whilst the single trade mark requirement of the European Medicines Agency's centralised procedure will mean that there will be fewer instances of different brands within the EU for certain medicines, they will not cease altogether, as it is possible to use different trade marks in 'exceptional' cases with prior approval.

This decision is of importance and will be seen as a victory for parallel importers.

However, there may be a further appeal to the Supreme Court, not least because there have been decisions in other EU countries (eg, Denmark, Sweden and Germany) which came to different conclusions as to the issue of "necessity for effective market access" (albeit based on different medicines and different national prescribing and marketing practices).

We await further developments with interest.

Author:
Ian Starr



The General Court (GC) ruling in Nissan v OHIM highlights the need to ensure that renewal requests are made in full before the renewal date expires - otherwise rights may not be recoverable.

The renewal

Nissan owned a Community trade mark (CTM) in classes 7, 9 and 12 with a renewal date of 23 April 2011. On 27 January 2011, Nissan requested partial renewal of the CTM for all goods and services registered, except those in class 9.

The partial renewal was processed and notified to Nissan's trade mark agents in May 2011.

In July 2011, and within the six month grace period for late renewal, Nissan applied to late renew the CTM in class 9.

OHIM's decisions

Both OHIM's Administration Division and the Board of Appeal (BoA) dismissed Nissan's request for the late renewal of the CTM in class 9. The BoA held that the original request for partial renewal of the CTM in classes 7 and 12 only was an "unequivocal partial surrender" of the CTM which cannot be affected by the six month grace period allowed for late renewal.

Nissan appealed to the General Court (GC).

General Court ruling

The GC ruled that the BoA had erred in finding that a request for partial renewal of a CTM amounted to a surrender of the CTM for all goods/services not included in the renewal request. Specifically, the GC held:

- Any request for surrender of a CTM should be expressly made to OHIM in writing.
- A partial renewal request cannot be inferred as a request for partial surrender.
- A renewal request made by a trade mark agent does not equate to an express intention of a trade mark owner to surrender any of its rights.

Nissan no doubt believed its appeal would be upheld by the GC but alas – the GC found

that despite the BoA's error, late renewal of the CTM in class 9 was not possible.

The GC held that the six month grace period provision only applies where there has been no request for renewal.

As Nissan had already requested partial renewal, it was not entitled to use the six month grace period to request renewal of the CTM in class 9 – the request should have been included at the time Nissan requested renewal of the CTM for classes 7 and 12.

Author:
Gemma Kirkland



In short

Requests for renewal must be made in full within the relevant renewal deadline.

If requests for partial renewal are made, it will not be possible to subsequently request that the 'missing' goods/services are renewed during the six month grace period.

Any request for surrender of a CTM must be made expressly in writing to OHIM.

Rights holders should carefully consider whether to renew a CTM in full or partially, as only one opportunity to renew will be granted.

Innocent smoothies and ownership of “The Dude” logo

The importance of obtaining, and retaining, signed copies of agreements

➤ Case details at a glance

Jurisdiction: England and Wales

Court: High Court of Justice Chancery
Division Intellectual Property

Parties: Fresh Trading Limited v Deepend
Fresh Recovery Limited and Andrew Thomas
Robert Chappell

Citation: [2015] EWHC 52 (Ch)

Date: 26 January 2015

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

This is a case that centres on whether a contract which included assignment of copyright provisions was executed; and whether the provisions in that agreement correctly assigned the copyright.

“The Dude”

The claimant, Fresh Trading Ltd (Fresh), asked the court for a declaration that it was indeed the legal owner of the copyright in “The Dude” logo, used for many years in the marketing material of the well-known brand of Innocent smoothies. The logo, used by Fresh since its business started up, consists of a cartoon depiction of a face with a halo.

Fresh v Deepend

Fresh claimed copyright ownership by virtue of a contract that was made with the designers of “The Dude”; if it was not the legal owner, it argued it was the owner in equity.

The defendants, Deepend Fresh Recovery (Deepend), argued that the contract on which Fresh relied was not signed, nor was the unsigned contract binding, and therefore there was no assignment of the copyright in “The Dude”.

Deepend also counterclaimed for copyright infringement. Fresh argued that, as there had been a considerable lapse of time between the creation of the works and the alleged infringement, the counterclaim was precluded by acquiescence, laches or estoppel.

The legal issues

The first question for the judge to consider was whether or not the design agency had, as Fresh claimed, signed the contract, as required for legal assignment of copyright. Upon review of the evidence, the judge found that he was not persuaded that the document had actually been signed. Therefore, legal assignment did not take place in this case.

The judge also added that Fresh would have had difficulty even if the agreement had been signed, as when the contract was made, there was no work in which the copyright could then be assigned, there were only potential works.

Contracts should be signed by all parties and a copy kept safe in case needed in the future



It has long been the position in law that there cannot be an assignment of a future work, but only an agreement to assign.

The judge did find that, despite lack of a signed version of the contract, Fresh and the Deepend had clearly intended to enter into an agreement.

Equitable assignment of copyright

In the absence of legal ownership of the copyright by Fresh, the judge examined whether there might nevertheless be equitable ownership. The judge found that it was not in doubt that the consequence of an agreement to assign the copyright in a future work will often give rise to an equitable assignment in the copyright, when the contractual conditions for the assignment arise. He found that this was the case here and therefore found that Fresh was indeed the equitable owner of the copyright.

Acquiescence, estoppel and laches

As the judge had found that Fresh was the equitable owner of the copyright, he did not consider it necessary to address the

questions of acquiescence, estoppel or laches. However he did indicate that had he found that Fresh had no legal or equitable interest, his inclination would have been to reject the notion that Fresh had infringed: Deepend would have been estopped from bringing a claim for copyright infringement, as the claim was brought after such a long lapse of time, and use of “The Dude” and success of the brand had been known by Deepend for such a long period of time.

Author:

Claudia Rabbitts



In short

This case highlights the importance of having a contract signed by all parties, and of keeping a copy of that contract safe, in case it needs to be produced in the future.

This case also serves as a reminder that copyright cannot be assigned prior to the creation of the works.

Community trade mark opposition proceedings

Scope of discretion for late filing of evidence

Following a revision of OHIM's guidelines in June 2014, late additional evidence may be accepted in Community trade mark (CTM) opposition proceedings where it merely strengthens and clarifies relevant evidence presented before the deadline. Decisions from the General Court (T-393/12 and T-322/13 *Kenzo Tsujimoto v OHIM*) and Board of Appeal (R 102/2014-2 *Pinterest, Inc v Premium Interest Ltd*), provide recent guidance on this matter.

Settled law

At a macro level, these decisions confirmed that the Board of Appeal has a wide discretion under Article 76(2) CTMR and further discretion under Rule 50(1) of the Implementing Regulation to consider additional or supplementary facts and evidence not submitted within the Opposition Division's time frame. Further, OHIM's guidelines say the following factors should be taken into account:

- whether the additional evidence is likely to be relevant to the outcome of the opposition;
- the stage of proceedings at which the late submission takes place; and
- whether the circumstances surrounding its inclusion preclude it.

KENZO V Mr Kenzo Tsujimoto

In the *Kenzo* decisions, the opponent submitted some evidence of reputation prior to the Opposition Division's deadline, however it was deemed insufficient to support notoriety and additional late evidence of use was not considered. The General Court upheld the

Board of Appeal's decision to consider the additional material (filed after the deadline), which was originally submitted to satisfy the applicant's request for proof of use and had been filed within that time limit. Indeed, later filed proof of use may supplement earlier filed evidence of reputation and the court considered that the opponent had made genuine attempts to prove reputation prior to the deadline, plus it was irrelevant that the later evidence could have been filed in time.

Notably, the opponent successfully argued that evidence not physically filed in proceedings, but submitted to OHIM in parallel proceedings between the same parties prior to the deadline, could be taken into account; this was also the case where evidence had previously enabled the Board of Appeal to confirm reputation of the earlier CTM and had only been referred to in the notice of opposition and response.

Pinterest v Premium Interest

Key to this case was the substantiation of earlier unregistered rights by Pinterest, who opposed Premium Interest's application for the CTM word mark PINTEREST. OHIM granted Pinterest one time extension to file substantiation evidence, but refused a second request made after Pinterest had appointed a new representative. Prior to the extended deadline, Pinterest filed substantiations and some evidence, including an affidavit from its in-house counsel, an interested party, which featured estimated user and hit figures for the Pinterest service but did not provide independent corroborating sources. Akin to the *Kenzo* decisions, evidence filed after the deadline was not taken into account by the Opposition Division, which did not consider Pinterest's earlier rights to be substantiated.

Case details at a glance

Jurisdiction: European Union

Court: General Court

Parties: *Kenzo Tsujimoto v OHIM and Kenzo (France)*

Citation: T-322/13 and T-393/12

Date: 22 January 2015

Full decisions: <http://dycip.com/t-32213> and <http://dycip.com/t-39312>

Jurisdiction: European Union

Court: OHIM Second Board of Appeal

Parties: *Pinterest, Inc v Premium Interest Ltd*

Citation: R 102/2014-2

Date: 24 February 2015

Full decision (pdf): <http://dycip.com/R1022014-2>

On appeal, Pinterest submitted further evidence to corroborate the data in the affidavit; this was accepted by the Board of Appeal, which noted that Pinterest had believed in good faith that their initial evidence of use was sufficient and that the fresh evidence had been filed to tackle OHIM's concerns over the objectivity of the affidavit figures.

Ultimately the Board of Appeal confirmed that additional evidence may be taken into account where it merely supplements relevant but insufficient evidence submitted within the time limit and where the opponent intends to strengthen or clarify the content of the initial evidence. This case has now been returned to the Opposition Division for re-examination, in order to take into account the additional evidence.

Take home message

Whilst these decisions indicate that OHIM is open to considering additional evidence in opposition proceedings, it is clear that acceptance is contingent on it corroborating and strengthening existing relevant evidence. Clients should therefore be prudent to remain vigilant and to submit evidence by given deadlines wherever possible; the price of failing to fulfil such formalities could be crucial.

Author:

Jennifer Heath



In short

Relevant arguments must be submitted before the deadline, but additional evidence may supplement or corroborate insufficient evidence in certain cases.

Evidence of use is relevant to evidence of reputation.

Parties are encouraged by the courts to submit evidence by given deadlines.

Clients are advised to submit evidence by given deadlines whenever possible



D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

Event / London Business Show

IP Protection for start-ups and SMEs Talk to us at the London Business Show



The Business Show is expected to draw more than 25,000 aspiring entrepreneurs and small-medium business owners looking for inspiration, advice and networking. The event's overriding goal is to help drive business onwards and upwards, across all industries.

Your product, your business: IP essentials for start-ups and SMEs

During the show D Young & Co partners Nicholas Malden (European patent attorney) and Matthew Dick (trade mark solicitor) will present a snapshot of how IP rights can protect your ideas. The presentation will cover practical steps your business should take to protect your brand, innovation, design or product.

This presentation will run at 14.00-14.30 on Wednesday 13 May and will repeat at 14.45-15.15 on Thursday 14 May.

Talk to D Young & Co at stand 257

As well as presenting during the show, our IP specialists will be on hand to answer questions and share information. If you are attending and would like to join us, you'll find us at stand 257.

The UK Intellectual Property Office (UKIPO) will also be exhibiting at the show to run their popular 'branding workshop'.

For further information about the show, and to book tickets to attend, visit the Business Show website:

www.greatbritishbusinessshow.co.uk

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