

January 2023

In this issue:

<b>Caution use of Urban Dictionary</b> <a href="#">LES BOYS trade mark invalidated</a>	<b>04</b>
<b>Banksy back in charge</b> <a href="#">Board of Appeal reverses EUTM cancellation</a>	<b>05</b>
<b>Lidl v Tesco</b> <a href="#">Court of Appeal allows bad faith claim to proceed</a>	<b>06</b>
<b>Owner of "BIG BABY POP" takes on The Topps Company</b> <a href="#">Genuine use of a 3D mark confirmed despite additional elements</a>	<b>07</b>
<b>UKIPO address for service</b> <a href="#">Is an email address enough?</a>	<b>08</b>

## Parallel imports of medicinal products Four CJEU rulings provide clearer guidance



Full story [Page 02](#)



Our best wishes to all our readers as we welcome in 2023 and all the opportunities that it brings. We are looking forward client visits and events planned for this year and are excited to be attending INTA in Singapore in May with many other trade mark professionals from around the world, having missed the chance to visit this fantastic conference location due to the pandemic in 2020. Do get in touch with the team prior to the conference, or any of our other upcoming events this year (we will keep you posted).

This edition of our newsletter provides some welcome guidance on parallel imports from the CJEU, assessments of bad faith on appeal at the EUIPO and UK High Court, as well as a closer look at use of 3D trade marks in the EU. We consider a cautionary tale of counting on the Urban Dictionary as evidence of the general public's understanding of a concept, and finally a quick update on the dangers of relying on solely an email address as an address for service at the UKIPO. We hope you find this edition of interest.

Richard Burton  
Partner, Trade Mark Attorney

## Events



### INTA 2023 Annual Meeting Singapore, 16-20 May 2023

Members of our trade mark team will be attending this year's INTA meeting in Singapore. Do get in touch if you would like to meet with the team during the conference.

[www.dyoung.com/news-events](http://www.dyoung.com/news-events)

## Subscriptions



For subscriptions and to manage your mailing preferences, please email [subscriptions@dyoung.com](mailto:subscriptions@dyoung.com).

Read this newsletter and previous editions online at [www.dyoung.com/newsletters](http://www.dyoung.com/newsletters)

## Follow us



LinkedIn: [dycip.com/dyclinkedin](https://dycip.com/dyclinkedin)  
Twitter: @dyoungip

# Parallel imports of medicinal products Four CJEU rulings provide clearer guidance

**O**n the hotly debated topic of parallel imports the Court of Justice of the European Union (CJEU) recently issued four rulings, which clarified the conditions for the repackaging and relabelling of medicines and medicinal products in their distribution to other markets. All these decisions were preliminary rulings in response to requests made by national courts in Germany, Denmark, and the Benelux, on the interpretation of the harmonised EU laws.

The main focus in three of the cases was the question regarding whether a trade mark owner is entitled to oppose a parallel importer's repackaging of a medicinal product if the replacement of anti-tampering devices would leave visible traces. The fourth case touched on the question of whether parallel importers can rebrand generic medicines with the trade mark of the reference medicinal product.

### Exhaustion of rights

EU law entitles exclusive rights to the distribution of goods to the proprietor of a trade mark, but only until those goods are placed on the European Economic Area (EEA) market. At this point, the trade mark owner is prohibited from enforcing their rights over distribution, commercialisation or sale of the goods by third parties. However, there are limitations to such exhaustion of rights in the context of parallel importation (when products have been purchased in one EU member state, where they had been sold by the trade mark owner or with their consent, and later sold in another EU member state). The importer is entitled to repackage and relabel the original products only if the five "Bristol-Myers Squibb (BMS) conditions" are satisfied:

1. Reliance on trade mark rights and any objection by the trade mark owner would contribute to the artificial partitioning of the markets between EU member states;
2. The repackaging does not affect the original condition of the product inside it;
3. The new packaging clearly states who repackaged the product and the name of the manufacturer;
4. The presentation of the repackaged

product is not such as to be liable to damage the reputation of the trade mark and of its owner; and

5. The importer gives notice to the trade mark owner before the repackaged product is put on sale and provides a specimen if requested.

### EU Medicines Directive and the Falsified Medicines Directive

Pharmaceutical products are regulated by a number of specific rules, which aim to ensure that such products are safe and that their trade is controlled. Many of such rules are laid down in the EU Medicines Directive (2001/83/EC), as amended by the Falsified Medicines Directive (FMD) (2011/62/EU), and the Commission Delegated Regulation (EU) 2016/161, which introduced additional requirements for the packaging of medicinal products.

Importantly, the outer packaging or (if not applicable) the immediate packaging of a medicinal product must include two main safety measures:

1. a unique identifier (such as a barcode, which verifies the product's origin and authenticity), and
2. an anti-tampering device (for example, a safety seal, which shows if the packaging has been opened or altered).

The verification of those two safety features is necessary in order to guarantee the authenticity of a medicinal product throughout the supply chain. Those safety features may be removed or covered only under strict conditions intended to guarantee the authenticity of the medicinal product and the absence of any tampering.

In recent years some parallel importers have used the FMD as an attempt to justify the necessity of repackaging over relabelling as a general rule.

### Relabelling required instead of repackaging despite visible traces of opening

The CJEU had to assess in three very similar cases the legitimacy of repackaging of medicinal

## ➤ Case details at a glance

*Jurisdiction: European Union  
Decision level: CJEU Parties: Novartis  
Pharma GmbH v Abacus Medicine A/S  
Date: 17 November 2022  
Citation: C-147/20  
Decision: [dycip.com/novartis-abacus](https://dycip.com/novartis-abacus)*

*Jurisdiction: European Union  
Decision level: CJEU Parties:  
Bayer Intellectual Property GmbH  
v kohlpharma GmbH  
Date: 17 November 2022  
Citation: C-204/20  
Decision: [dycip.com/bayer-kohlpharma](https://dycip.com/bayer-kohlpharma)*

*Jurisdiction: European Union  
Decision level: CJEU Parties: Merck  
Sharp & Dohme BV and others v  
Abacus Medicine A/S and others  
Date: 17 November 2022  
Citation: C 224/20  
Decision: [dycip.com/merck-abacus](https://dycip.com/merck-abacus)*

*Jurisdiction: European Union  
Decision level: CJEU Parties: Impexco NV v  
Novartis AG / PI Pharma NV v Novartis AG  
Date: 17 November 2022  
Citation: Joined cases C-253/20 & C-254/20  
Decision: [dycip.com/impexco-novartis-pi](https://dycip.com/impexco-novartis-pi)*

*“BMS” conditions: CJEU, 11 July 1996,  
Bristol-Myers Squibbs v Paranova A/S  
(Case C-427/93), C. H. Boehringer Sohn  
and others v Paranova A/S (Case C-429/93)  
and Bayer AG and others v Paranova A/S  
(Case C-436/93) – the criteria were further  
clarified by subsequent CJEU decisions.*

products, where the replacement of anti-tampering devices (as required by the FMD) would leave visible traces. While the parallel importers feared that the visible and irreversible traces of opening of the original packaging cast a doubt on the integrity of the medicinal products, the pharmaceutical companies said that importers can be compliant by adding a new anti-tampering device covering the traces of the opening of the original packaging to indicate that this new safety seal was affixed during a lawful repackaging.

The CJEU now confirmed in the Bayer and Merck cases that in general repackaging in new packaging and relabelling of parallel imported medicinal products are equivalent forms of repackaging, as regards the effectiveness of the safety features. The legislator explicitly did not want to prevent the reuse of the original outer package.

That said, according to the CJEU in the Bayer case, there is however no per se repackaging entitlement or justification for the importer merely because of the presence of traces on the outer packaging of a medicinal product which were caused by the opening by the parallel importer. As such, these visible traces do not necessarily hinder the importer's access to the new market. Rather, the trade mark owner may oppose repackaging (and insist in relabelling) provided that:

1. the relabelled product still complies with the safety-feature requirements set out in the FMD, and
2. the relabelled product has effective access to the import market.

As defence, the importer will need to provide concrete reasons (and evidence) why they think it is necessary to repackage the product, and why they could not simply replace the security features of the packaging with new security features of equivalent effect.

In the Novartis and Merck cases the CJEU confirmed that the trade mark owner may oppose repackaging and insist on relabelling where:

1. the visible traces of opening of the

original outer packaging are clearly attributable to the (lawful) repackaging by the parallel importer; and

2. the traces would not cause such a strong consumer resistance on the part of a significant proportion of consumers in the importer market to medicinal products repackaged that this would create a barrier to the effective access to the market.

This means that the packaging of the medicinal product should clearly mention the re-packer and provide sufficient information regarding the supply chain on the possible origin of those traces. Also, the CJEU said that parallel importers cannot rely on a general presumption of consumer resistance to such medicinal products. Instead, the parallel importer has to show that there is such a consumer resistance that constitutes a barrier to effective access to that market, which must be established on a case-by-case basis.

### No stricter rules in EU member states allowed

Finally, in the Merck and the Bayer cases, the CJEU also confirmed that the EU member states have no discretion to impose that parallel imported medicinal products must, as a general rule, be repackaged instead of relabelled, which had been the situation in Germany and Denmark. Therefore, EU member states cannot request parallel importers to always repackage a medicinal product rather than to relabel the same.

### Rebranding generic products

In the Impexco case the CJEU ruled that parallel importers cannot generally repackage generic medicines in a new outer packaging and then affix the corresponding trade mark of the reference medicinal product. Such use of the trade mark would only be allowed if (in addition to satisfying all the BMS conditions including “objective necessity”) the two medicinal products are identical in all aspects.

The court clarified that identity could be assumed if the reference medicinal product and a generic medicinal product are manufactured by the same entity (or by economically linked entities) and they

constitute the same product marketed under two different sets of rules. The differences in the rules for those products and how they are perceived by health professionals or patients were not sufficient to consider them different. Otherwise, trade mark owners could contribute to an artificial partitioning of the markets between EU countries by marketing an identical medicinal product sometimes as a reference medicinal product and sometimes as a generic medicinal product. However, there would be no identity if the generics and the branded medicines differ over the pharmaceutical form, the chemical form of the active substance, and its excipients.

In this particular case, the court held that the specific Novartis and Sandoz products in question were identical. However, a rebranding was not considered objectively necessary for the distribution of the medicines in the new market. In particular, the court said an EU member state cannot generally refuse a parallel import licence for a generic medicinal product if the corresponding reference product already has a marketing authorisation in that country. If the reference product has been authorised, the importer does not need to rebrand the product but can simply market the generic medicinal product under the generic brand and the international nonproprietary name (INN). Using the (reputation of the) trade mark of the reference product would only be to the economic advantage of the parallel importer.

In the Merck case, the CJEU also dealt again with questions of “debranding”. The court confirmed that the parallel importer may be liable to damage the reputation of a trade mark in case the importer only reaffixes to the new outer packaging the product specific trade mark of the proprietor, without reproducing the other trade marks and/or the other distinctive signs which appeared on the original outer packaging. Whether or not there is indeed any damage to the reputation of the trade mark concerned is then, however, to be assessed by the national courts.

**Authors:**  
Jana Bogatz & Sophia Karim



# Caution use of Urban Dictionary LES BOYS trade mark invalidated

**T**he appointed person, Daniel Alexander KC, has upheld the UKIPO hearing officer's decision to invalidate the trade mark LES BOYS of AYA Design Group Limited, in relation to perfumes and cosmetics and retail of these goods, on the basis of likelihood of confusion with Chanel's earlier trade mark registration for BOY in class 3.

## Appeal

At first instance the hearing officer found that, while there was insufficient likelihood of direct confusion between the marks BOY and LES BOYS, there was a likelihood of indirect confusion and he upheld the objection to continued registration on that basis. The registered proprietor appealed this decision based on the assessment of how the average consumer would understand the trade mark, the comparison of the mark and sign and the finding of indirect confusion.

## Meaning of the trade mark

Key to the appellant's case was the definition of "Les Boys" and how this term would be understood by the average consumer. The appellant argued that this was fundamental because it affected the way in which the mark would be viewed and the degree of similarity. To this end the appellant relied on the Urban Dictionary definition of "lesboy" which defines the term as "a lesbian-identified male".

However, when assessing the marks the hearing officer determined that the average consumer would view the mark as meaning "The Boys" as "Les" is a well-known French definite article meaning "The".

The appointed person stated that "the mere existence of a word or phrase in the Urban Dictionary does not in any way prove that the particular word or phrase is in fact known to the public or understood as denoting the "definition" given on the website, and far less that it is known and understood by the UK public. I therefore consider that Urban Dictionary entries, the provenance of which is not known, bear very little, if any, weight, without further evidence to show that the concept is known in the UK or that the average consumer of the goods and services would be aware of it".

## Should parties rely on Urban Dictionary definitions in UKIPO proceedings?



Based on these points, the appointed person upheld the hearing officer's view of the definition of the mark. The take away from this is that relying solely on the Urban Dictionary definition of a term is not going to get you anywhere in UKIPO proceedings.

## Indirect confusion

The other interesting aspect of this case is the discussion around the finding of indirect confusion, which is where consumers do not mistake the sign for the trade mark, but believe that goods/services denoted by the sign come from the same undertaking as goods/services denoted by the trade mark or from an undertaking which is economically linked to the undertaking responsible for goods/services denoted by the trade mark.

The appointed person quoted *Iain Purvis QC sitting as appointed person in LA Sugar Ltd v Back Beat Inc (O375/10)*, where he set out a useful, although not exhaustive, list of instances of indirect confusion:

"a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

While it was held that the present case does not fall exactly into any of the above, the appointed person held that the hearing officer was correct in finding indirect confusion on the following grounds:

- on the assumption that the average consumer would see the element "Les" as a French definite article, Les Boys has added a non-distinctive element to the earlier mark;
- the respective marks would be remembered as either singular or plural "BOY" marks. The elements are also sufficiently distinct in the trade mark that the "Boys" element can legitimately be regarded as performing a separate (and sufficiently independent) specific distinctive role from that of the "Les" element;
- cosmetics and related products and services is a commercial sector in which brand extensions are not uncommon and may therefore be expected by an average consumer
- the term "BOY" does possess some low level distinctive character in relation to the goods.

The appeal was dismissed on all grounds.

## Author:

Kate Cheney





# Banksy back in charge

## Board of Appeal reverses EUTM cancellation

### Case details at a glance

Jurisdiction: European Union

Decision level: Board of Appeal

Parties: Pest Control Office Ltd and Full Colour Black Ltd

Date: 25 October 2022

Citation: R 1246/2021-5

Decision (PDF): [dycip.com/banksy-monkey-image](https://dycip.com/banksy-monkey-image)

**T**he EUIPO's Board of Appeal annulled the controversial decision to cancel Banksy's EUTM for the LAUGH NOW BUT ONE DAY WE'LL BE IN CHARGE mark, on the grounds of bad faith (under Article 59(1)(b) of the EU Trade Mark Regulation 2017/1001).



### Background

The EUTM, which covers the mark depicted above, was filed by Banksy's representatives, Pest Control Office Ltd. In its cancellation application, Full Colour Black Ltd pointed out that the mark had previously been displayed on Banksy's Gross Domestic Product website which "encourages the copying, borrowing and uncredited use of Banksy's imagery" for activism, education and personal entertainment purposes. Banksy also famously stated in the past that "copyright is for losers" and has not enforced those rights as that would entail him losing his anonymity.

In the lower instance decision, the EUIPO Cancellation Division ruled that the mark had been applied for in bad faith, as the proprietor's intention at the time of filing had been to obtain legal rights in the sign other than copyright rights. The EUIPO considered that this was inconsistent with the function of a trade mark.

### Subsistence

On review of the earlier decision, the Board of Appeal found that the same artwork or sign may be protected by both copyright and trade mark law. The fact that the mark at issue represented one of Banksy's artworks which could have been protected by copyright law did not automatically preclude that same mark from functioning as a badge of origin for the goods and services at hand. As a result, it could function as a trade mark.

The cancellation applicant failed to convince the Board of Appeal that the contested sign would be non-distinctive due to its alleged decorative nature. The mere claim that the contested sign was decorative represented a subjective view which "could not be verified".

The Board of Appeal noted that the representation of an ape wearing an empty label included in the EUTM was not merely ornamental feature which would go unnoticed, but an unusual combination of striking elements which would be kept in mind by the consumers. Further, it was noted that the subject matter of goods and services does not follow automatically from the fact that a sign contains an artwork, because copyright and trade mark law can protect different aspects of the same work or sign. Thus, a creative work can be protected as a trade mark even if it has entered the public domain under copyright law, for example if it acquires a secondary meaning. The cancellation applicant's arguments on descriptiveness and non-distinctiveness were therefore rejected.

### Bad faith

On bad faith, a holistic consideration of various factors was required. The Board of Appeal took into account:

- The fact that the sign was publicly available as an artwork (graffiti) which could be reproduced by the public;
- the fact that Banksy did not take steps to protect his copyright in relation to non-commercial uses of the work; and
- Banksy's critical views on copyright.

None of these factors demonstrated that the proprietor did not have the requisite intention to use the contested mark as a trade mark. Even if Banksy had indeed opted for trade mark protection instead of copyright in order to preserve his anonymity, that was irrelevant for the purposes of trade mark law and "did not exclude an intention to use the trade mark".

It was also stated that Banksy had the right to express critical opinions on copyright, pursuant to Article 19 of the Universal Declaration of Human Rights which protects freedom of expression. In any event, it would have been difficult for the cancellation applicant to prove that the EUTM proprietor had a negative view on IP rights, and that this negative view of copyright directly led to the filing of the EUTM (with no intention of using the sign as a trade mark).

Finally, it was noted that the cancellation action had been filed in November 2019, less than a year after the EUTM had been registered (March 2019), without regard to the five year grace period. Banksy still has time to commence genuine use of the EUTM before that period expires.

Finding that the Cancellation Division had erred in its finding of bad faith, the Board of Appeal rejected Full Colour Black's request for an invalidity declaration in its entirety.

### Author:

Agnieszka Stephenson



### In short

The Board of Appeal's decision contains a far less generous assessment of bad faith principles than the first instance decision, and could constitute a positive development for brand owners seeking to enforce a broad range of IP rights over the same work.

# Lidl v Tesco

## Court of Appeal allows bad faith claim to proceed

➤ **Case details at a glance**  
*Jurisdiction: England & Wales*  
*Decision level: Court of Appeal*  
*Parties: Lidl Great Britain Limited and Lidl Stiftung & Co KG v Tesco Stores Limited and Tesco PLC*  
*Date: 25 October 2022*  
*Citation: [2022] EWCA Civ 1433*  
*Decision: [dycip.com/lidl-tesco-ewca-1433](https://www.dycip.com/lidl-tesco-ewca-1433)*

**T**he Court of Appeal has granted Tesco's appeal against an order of the High Court, striking out allegations in its defence and counterclaim that Lidl had applied for registration of certain trade marks in bad faith.

### Background

In the High Court proceedings, Lidl claimed Tesco's use of its "CLUBCARD PRICES" sign (shown below, right) amounted to trade mark infringement of its own mark "the wordless mark" (shown below, left). Both the sign and mark are based on a yellow circle on a blue square background.



Tesco counterclaimed for a declaration of invalidity of the wordless mark on the basis that it had never been used, that Lidl had never intended to use it, and hence that the intention when registering it was to use it as a legal weapon in bad faith.

Tesco further argued that Lidl had abused the trade mark system, and "evergreened" by applying to re-register the wordless mark in 2002, 2005, 2007 and 2021, which was further evidence of bad faith.

These arguments were struck out by the High Court.

### The appeal

In its appeal, Tesco relied on two grounds.

1. The judge had failed to apply the correct test to the striking out application under rule 3.4(2)(a) of the Civil Procedure Rules, and that it had also failed to take into account that bad faith is a developing area of the law.
2. The judge had failed to properly consider the pleaded facts and inferences of the bad faith claim as a whole.

### The decision

Whilst it disagreed with Tesco's argument that the wrong test was applied by the judge, the Court of Appeal agreed that the judge had failed to consider that bad faith was a developing area of law. However, this alone would not have been sufficient justification for interfering with the judge's decision.

The Court of Appeal also agreed that Tesco's second ground for appeal was well founded, especially considering that no disclosure as to Lidl's intentions when registering the mark had taken place yet.

The High Court judge was wrong to say that Tesco's allegation (that the wordless mark was applied for solely for deployment as a legal weapon) was "no more than assertion", as all allegations in statements of case are assertions as to facts. It was no objection that this allegation was pleaded as an inference. It was open to Lidl to produce evidence as part of a summary judgment application to show that this factual assertion was unsustainable, but it did not. Furthermore, Lidl could not disprove this inference by simply counter-asserting that

it was entitled to a wider scope of protection than that provided by the mark with text; a factual investigation into the reputation and goodwill that its mark enjoyed was required.

In relation to Tesco's claims of Lidl abusing the trade mark system, the Court of Appeal considered that seeking unjustifiably broad protection may amount to such abuse, but that whether it constitutes bad faith is a fact-sensitive question which depends on the applicant's intentions. The Court of Appeal disagreed with the judge, and found that Tesco's pleading did give rise to a real prospect of the presumption of good faith being overcome. Furthermore, the Court of Appeal disagreed with the judge's finding that Tesco's failure to plead in relation to the mark with text was significant; the judge had failed to recognise that Tesco's case was based on more than the mere existence of overlapping marks. Hence, Tesco's pleading of abuse of the trade mark system by Lidl did have a real prospect of success.

Regarding the claim of "evergreening", the Court of Appeal found that Tesco had done enough at this stage by giving particulars of the allegation by way of a spreadsheet of the re-registrations, and confirmed that this plea had a real prospect of success.

### Author:

Anna Reid



### In short

This decision reaffirms the high threshold for strike out applications, especially considering the high threshold of proof required for the underlying counterclaim of bad faith. Whilst Tesco was successful in showing that this counterclaim has a realistic prospect of success, the question of whether it is successful or not will be determined at the main proceedings in 2023.

The Court of Appeal has granted Tesco's appeal against an order of the High Court



# Owner of “BIG BABY POP” takes on The Topps Company

## Genuine use of 3D mark despite additional elements

**T**his decision re-confirms the rights of 3D trade mark owners, especially when they may have already found it difficult to get trade mark protection in the first place.

### Background

In 1999 The Topps Company filed a 3D mark for the sign shown below for various goods (confectionery, sugar confectionery, sweets, candies and sherbet) in class 30:



In 2018 Mr Trebor Robert Bilkiewicz filed an application for revocation of Topps Company's three-dimensional EU trade mark pursuant to Article 58(1)(a) EUTMR. Topps Company filed evidence that the mark had been used as shown below (also showing the word mark “BIG BABY POP”):



Both the Cancellation Division and later the Second Board of Appeal denied genuine use of the 3D mark, arguing that the mark had merged with the additional figurative and word elements and thus constituted a different sign. Topps Company then further appealed the decision to the General Court and assigned the mark to the new owner (The Bazooka Companies).

### General Court decision

The General Court annulled the decision and confirmed genuine use of the mark.

1. The court did consider the registered shape and the shape of the baby bottle as used to be identical. They said the existing differences (especially in the proportions) are hardly perceived by the relevant public.

This case concerned the use of 3D and word marks relating to confectionery



2. The court confirmed that a registered trade mark used only as part of a composite mark or in combination with another mark must still be perceived as an indication of the origin of the goods in question.

In that context, the court also emphasised again that the acquisition of distinctive character may result from the use of an element of the registered trade mark as part thereof and from the use of a separate trade mark in conjunction with the registered trade mark. In such cases, it is sufficient that, as a result of that use, the relevant public actually perceives the goods or services identified exclusively by the mark applied for as originating from a particular undertaking. No different standards are to be applied in the parallel context of assessing genuine use. The Court of Justice of the European Union (CJEU) had also confirmed already in the Bullerjan (shape of an oven) case (C-698/17 P) that a three-dimensional mark can be used in conjunction with a word element, without necessarily calling into question the consumer's perception of the shape as an indication of the commercial origin of the goods.

In this particular case, the court found that as well as occupying a significant part of the surface of the product, the word mark “BIG BABY POP!” also alluded to the shape of the baby bottle of which the contested mark was composed (the stylised letter “i” in the shape of a baby bottle and the word “baby” referred

to the users of baby bottles). Further, the court states that in the confectionery sector it is very common to find the combination of a 3D shape with additional word or figurative elements. Moreover, from a commercial and regulatory point of view, it would be “inconceivable” to sell the goods in question solely in the shape of the contested mark without any label applied to its surface.

Finally, the court confirmed that the 3D mark did not have to appear on all evidence material such as invoices. In this case, the invoices only showed the word mark “BIG BABY POP!” but the court said this was not unusual and it would be difficult to insert a 3D mark on all business documents.

**Author:**  
**Anna Scheuermann**



### In short

This decision is welcomed and further strengthens the position of owners of 3D marks by confirming that 3D marks can be genuinely used in combination with word marks, as long as the 3D mark is still perceived by consumers to be an indication of origin.



# D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

## Address for service

# UKIPO address for service Is an email address enough?

A recent appeal to the appointed person in relation to a UK invalidation action has questioned whether official UKIPO papers sent only by email have been validly served.

The UKIPO had cancelled a registration in circumstances where (it stated) invalidity papers had been sent to the registrant by both email and registered mail and no defence had been filed. In fact the papers had been sent by email only, and that email had not been read by the recipient (it went to a spam folder and was then auto-deleted).

Rule 79 of the Trade Marks Rules 2008 provides that electronic delivery of UKIPO documents is deemed to be effected by transmitting an electronic communication containing the document to an address provided to the UKIPO by the recipient as an address for the receipt of electronic communications. Unless the contrary is proved, such delivery is deemed to be effected immediately upon transmission of the communication.

The appointed person noted the prevailing view (albeit subject to criticism and pressure

for modernisation) that an email address does not qualify for recognition as an "address for service" because it does not designate any particular premises at which papers intended for a particular person can with confidence be physically delivered. The Supreme Court had also held that electronic service needs to be an organised (rather than an *ad hoc*) process.

Despite the apparently clear guidance in the Trade Mark Rules, and the fact (which was not established) that the registrant may have given an email address to the UKIPO when filing their application, the appointed person noted that he was not satisfied that the Trade Mark Rules enabled an email address to be used by the UKIPO as an address for service. As such, he held that the invalidity papers had not been correctly served, and the case was remitted to the UKIPO for further processing.

The case is reminiscent of the recent MARCO POLO decision (from the same appointed person) which held that notifications to holders of UK designations of international registrations had not been validly served in a number of cases.

**Author:**  
**Matthew Dick**



## Contact details

London  
Munich  
Southampton

T +44 (0)20 7269 8550  
F +44 (0)20 7269 8555

mail@dyoung.com  
www.dyoung.com

To update your mailing preferences or to unsubscribe from this newsletter, please send your details to [subscriptions@dyoung.com](mailto:subscriptions@dyoung.com). Our privacy policy is available to view online at [www.dyoung.com/privacy](http://www.dyoung.com/privacy).

This newsletter is intended as general information only and is not legal or other professional advice. This newsletter does not take into account individual circumstances and may not reflect recent changes in the law. For advice in relation to any specific situation, please contact your usual D Young & Co advisor.

D Young & Co LLP is a limited liability partnership and is registered in England and Wales with registered number OC352154. A list of members of the LLP is displayed at our registered office. Our registered office is at 120 Holborn, London, EC1N 2DY. D Young & Co LLP is regulated by the Intellectual Property Regulation Board.

Copyright 2023 D Young & Co LLP. All rights reserved.  
'D Young & Co', 'D Young & Co Intellectual Property' and the D Young & Co logo are registered trade marks of D Young & Co LLP.

## Contributors

**Partner, Trade Mark Attorney**  
**Richard Burton**  
rpb@dyoung.com  
[www.dyoung.com/richardburton](http://www.dyoung.com/richardburton)



**Partner, Rechtsanwältin**  
**Jana Bogatz**  
jab@dyoung.com  
[www.dyoung.com/janabogatz](http://www.dyoung.com/janabogatz)



**Senior Associate, Trade Mark Attorney**  
**Kate Cheney**  
klc@dyoung.com  
[www.dyoung.com/katecheney](http://www.dyoung.com/katecheney)



**Partner, Trade Mark Solicitor**  
**Matthew Dick**  
mjd@dyoung.com  
[www.dyoung.com/matthewdick](http://www.dyoung.com/matthewdick)



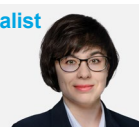
**Legal Assistant**  
**Sophia Karim**  
syk@dyoung.com  
[www.dyoung.com/sophiakarim](http://www.dyoung.com/sophiakarim)



**Partner, Solicitor**  
**Anna Reid**  
amr@dyoung.com  
[www.dyoung.com/annareid](http://www.dyoung.com/annareid)



**Trade Mark & Design Specialist**  
**Anna Scheuermann**  
aqs@dyoung.com  
[www.dyoung.com/annascheuermann](http://www.dyoung.com/annascheuermann)



**Senior Legal Manager**  
**Agnieszka Stephenson**  
aas@dyoung.com  
[www.dyoung.com/agnieszkastephenson](http://www.dyoung.com/agnieszkastephenson)



## Subscriptions



If you would like to receive our IP-related news and invitations to our webinars and events, please send your details to [subscriptions@dyoung.com](mailto:subscriptions@dyoung.com) or visit our website: [www.dyoung.com/subscriptions](http://www.dyoung.com/subscriptions)