

# D YOUNG & CO TRADE MARK NEWSLETTER *no.130*

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In this issue:

**Colour change counts** 04

*But only if the mark is distinctive enough*

**Bit('s) not your coin** 05

*Wright v BTC Core*

**Bulls shoot and miss** 06

*UKIPO rejects invalidity proceedings  
brought by the NBA*

**UKIPO One IPO** 07

**transformation programme**

*A trade mark and design update*

**British Hairways** 08

*Pun intended, but does that make it registrable?*

## Advertising climate neutrality German courts establish divergent requirements



Full Story Page 02



Welcome to the September 2023 edition of our newsletter. The summer months at D Young & Co have been busy, though at least we did not miss out on the sun while we worked! We are pleased to report that in July partner and solicitor Matthew Dick was listed in World Trade Mark Review Global Leaders: Private Practice. We are also excited to be attending the IPO Annual Meeting and the MARQUES Annual Conference - taking place this month in Boston and Berlin respectively. We would like to remind our readers that there are only three months to go until a UK address for service is required, from 01 January 2024. To read more about what this might mean for you see our article on this topic: [dycip.com/ukaddressforservice](https://dycip.com/ukaddressforservice).

Gabriele Engels  
Partner, Rechtsanwältin

## Events



### IPO Annual Meeting

**Boston, USA, 10-12 September 2023**

Jackie Johnson (member of the International Trademark Law and Practice Committee) will be attending this meeting.

### MARQUES Annual Conference

**Berlin, Germany, 19-22 September 2023**

Matthew Dick, Anna Reid, Jana Bogatz and Gabriele Engels will be attending this event. Matthew Dick is a member of the Unfair Competition team, Jana is Vice-Chair of the European Trade Mark Law and Practice team, and Gabriele is Chair of the Cyberspace team.

### PTMG Autumn Conference

**Athens, Greece, 04-07 October 2023**

Tamsin Holman will be attending this conference.

[www.dyoung.com/events](https://www.dyoung.com/events)

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## Green claims

# Advertising climate neutrality German courts establish divergent requirements

July 2023 delivered multiple decisions regarding advertising in Germany using "green claims". The three cases concerned the packaging and print advertising of various products by manufacturers which claim to be "climate-neutral". Jurisprudence since the 1990s has established that climate protection is an increasingly important topic for consumers, which can heavily influence their purchasing behaviour. Therefore, claims of climate neutrality must be carefully evaluated to ensure that consumers are not adversely misled when making purchasing decisions.

Whilst the claim by a fruit gummy manufacturer was deemed compliant, a jam manufacturer and drug store chain were found to be in violation of German Unfair Competition Law (UWG) for different reasons, having labelled their products climate-neutral.

### Climate neutrality is not in itself a false claim

A claim can mislead a consumer if it contains untrue statements or other statements capable of deceiving consumers, thereby motivating them to make economic decisions they would not otherwise have made (Sec. 5 (1) UWG).

The Higher Regional Court Dusseldorf (OLG Düsseldorf) was asked to define the requirements for advertising with a climate-neutral claim displayed on the packaging of fruit gummies by the manufacturer Katjes, and jam by the manufacturer Mühlhäuser. The claimant in both cases, the Centre for Combating Unfair Competition (Wettbewerbszentrale), asserted that the statement was untrue, as the production of neither product was emission free.

The court deemed neither product to violate this provision; the term climate-neutral was not in itself misleading. The average consumer would understand that climate neutrality can be achieved both by actively avoiding producing emissions or offsetting CO<sub>2</sub> with compensation measures, such as emission certificate trading. Therefore, even when CO<sub>2</sub> emissions are released, where they are compensated, the product can still be advertised as climate-neutral without the statement being untrue and misleading.

### Information obligation regarding compensation measures

However, a consumer can also be misled where essential information necessary for an informed decision is omitted (Sec. 5a (1) UWG).

In both decisions, the court emphasized that products advertised as climate-neutral should provide information about how the climate-neutrality is achieved and what compensation measures are taken, whether by the product's own savings or only through compensation measures (such as purchasing CO<sub>2</sub> certificates or supporting third party climate projects). The different approaches and assessment standards for determining a carbon footprint mean that consumers need further information to accurately assess such claims.

Whilst the advertising of the fruit gummies by Katjes' fruit gummies advertising was deemed to fulfill this information obligation, the advertising by the jam manufacturer did not.

Neither the print advertisement nor the product packaging of the jam contained any indication of how the advertised climate neutrality was achieved. This information was available on the manufacturer's website, which was displayed both in the print advertisement and on the product itself, but it was not indicated that the information could be found on the website. This was deemed insufficient by the court.

In contrast, the claim of climate neutrality in both the advertisement as well as the packaging of Katjes' fruit gummies was accompanied by a QR code and reference to the website of its certification partner "ClimatePartner". As the spatial restrictions of the chosen method of communication must be taken into account, this was held to be sufficient to fulfill Katjes' information obligation.

### Forest protection projects do not equal climate neutrality

Also, the District Court of Karlsruhe (LG Karlsruhe) was asked to determine the admissibility of the claims "climate-neutral" printed on a variety of products manufactured for and sold by the drug store chain dm. These claims were also accompanied

### ➤ Case details at a glance

*Jurisdiction: Germany*  
*Decision level: OLG Düsseldorf*  
*Case numbers: 20 U 152/22 & 20 U 72/22*  
*Dates: 06 July 2023*  
*Decision (German text): [dycip.com/20-U-152-22](https://dycip.com/20-U-152-22)*  
*Decision (German text): [dycip.com/20-U-72-22](https://dycip.com/20-U-72-22)*

*Jurisdiction: Germany*  
*Decision level: LG Karlsruhe*  
*Case number: 13 O 46/22 KfH - dm*  
*Date: 26 July 2023*  
*Decision (German text): [dycip.com/13-O-46-22-KfH](https://dycip.com/13-O-46-22-KfH)*

### ➤ Useful links

*Proposal for a Directive of the European Parliament and of the Council amending directives 2005/29/EC and 2011/83/EU as regards empowering consumers for the green transition through better protection against unfair practices and better information, European Commission, 30 March 2022: [dycip.com/proposaldirectivegreentransition](https://dycip.com/proposaldirectivegreentransition)*

*Proposal for a Directive of the European Parliament and of the Council on substantiation and communication of explicit environmental claims (Green Claims Directive), European Commission, 22 March 2023: [dycip.com/proposalgreenclaimsdirective](https://dycip.com/proposalgreenclaimsdirective)*

by a reference to “ClimatePartners” (and a number sequence) and with the addition “CO<sub>2</sub>-compensated” product.



The LG Karlsruhe also found that providing the ClimatePartners’ website next to the climate neutrality claim was sufficient to fulfill the information obligation. However, simply providing the name of the certificate partner, without identifying the website, was not deemed sufficient. Further, companies must ensure that the website address (url) provided is correct and complete.

The court also highlighted that consumers must be informed about whether emissions from certain points in the product’s life cycle have been excluded from the calculation of climate neutrality. Depending on the approach, some steps of the life cycle are left out of the determination of emissions, thereby heavily influencing the outcome. For example, the emissions from the manufacture of preliminary products and ingredients can usually only be roughly estimated. Additionally, the consumer must be made aware of whether the emissions generated during the use and disposal of the product are included in the calculation. Not indicating such factors would greatly increase the possibility of “greenwashing” by misleading consumers of the actual net emission balance created by a product.

The court took the evaluation of whether the claim of climate neutrality was actively misleading within the meaning of Sec. 5 (1) UWG a step further than the OLG Düsseldorf and examined the specific compensation measures undertaken to offset CO<sub>2</sub>.

One of the measures sponsored by dm and certified by ClimatePartners is a controversial tree conservation project in Peru. Although such projects undoubtedly contribute to climate protection, the court found that the claim of climate neutrality goes beyond what can be achieved through forest protection. While the complete degradation of CO<sub>2</sub> can take thousands of years, a forest can only bind it for as long as it stands. As the conservation project is only set to run until 2040, the trees could be felled and the CO<sub>2</sub> released in under 20 years. However, when considering a claim of climate neutrality the consumer does not merely expect a delay in climate damage, but a final, permanent compensation.

Claiming that products are climate neutral where the sponsored compensation measure consists of forest preservation was therefore considered false by the LG Karlsruhe. Accordingly, dm was found to be in violation of Sec. 5 (1) UWG and ordered to stop selling and advertising products using the claim of climate neutrality.

### Outlook

A decision from the German Supreme Court (BGH) will (hopefully) be delivered soon, after the Wettbewerbszentrale appealed the “climate-neutral sweets” decision (ref. no. I ZR 98/23). The BGH is expected to provide clear guidelines on what companies must do to legally advertise products with the term “climate neutral”. This would be highly welcome, not only due to the increasing number of companies using green claims to promote their products, but also in light of a large number of (somewhat differing) lower court decisions and lack of uniform standard.

Until the BGH hands down binding guidance, using the claim of climate-neutrality in product advertising will continue to carry the risk of being considered misleading. Companies are told to provide comprehensive information on how the claimed climate neutrality is achieved and

what measures they have taken themselves in this regard. It is not sufficient to refer exclusively to compensation measures taken by third parties and in any event companies cannot rely on a court accepting that the compensation measures are adequate in light of the LG Karlsruhe decision. Companies will need to consider carefully whether a supported climate neutral project enables them to label their products as climate neutral.

It is imperative that the reference to a webpage with further information on how climate neutrality is achieved is given in connection with the term “climate neutral”. Consumers must be able to clearly recognize that they will find the necessary information on this specific url.

### EU perspective

This increase in interest in green claims in Germany corresponds with the EU’s increased efforts in the area. Tackling the issue of greenwashing and unreliable or non-transparent sustainability labels is high on the EU’s list of priorities. One of the instruments designed to do so is the proposal for a Green Claims Directive, introduced by the EU Commission in March 2023 in the context of the EU’s European Green Deal. The directive includes the prohibition of environmental claims and sustainability labels that may mislead EU consumers by establishing several minimum criteria for transparency and credibility.

This proposal comes a year after the introduction of a proposal for a “Directive to empower consumers for environmental change through better protection against unfair practices and better information”. This directive also aims to better protect consumers from misleading advertising with environmentally friendly and sustainable features. It envisions an expansion of the list of banned commercial practices to include various “greenwashing” mechanisms.

Both directive proposals are currently in the process of being revised in various working groups and committees. It is not yet clear when they will be finally adopted.

**Author:**  
**Gabriele Engels**



# Colour change counts But only if the mark is distinctive enough

➤ **Case details at a glance**  
 Jurisdiction: European Union  
 Decision level: EUIPO Second  
 Board of Appeal  
 Parties: Barry's Bootcamp Holdings  
 LLC v Hummel Holding A/S  
 Citation: R 1422/2022-2  
 Date: 10 March 2023  
 Decision (pdf download):  
[dycip.com/bootcamp-hummel](https://dycip.com/bootcamp-hummel)

Judgment in case T-307/17, Adidas  
 AG v EUIPO (pdf download):  
[dycip.com/adidas-t30717](https://dycip.com/adidas-t30717)

**T**he European Union Intellectual Property Office's (EUIPO) Board of Appeal has upheld a decision in favour of the footwear and sportswear brand Hummel, in a revocation action brought by the exercise brand Barry's Bootcamp, with use of a black figurative mark on a white background being successfully proven through reliance on evidence which included use of the mark in alternative colour ways.

## The background

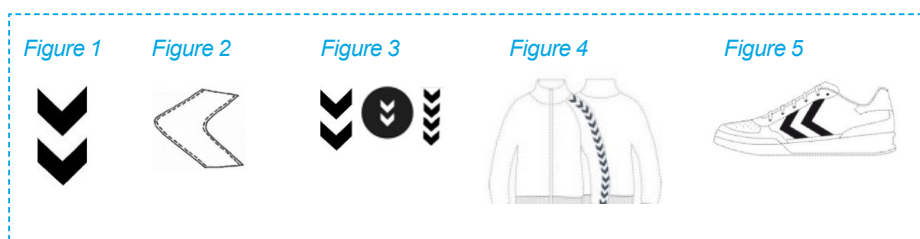
Hummel Holding A/S (Hummel) owns an international registration for the sign, see figure 1, above right, (the sign) designating, *inter alia*, the EU, where it had been registered for various goods/services since 2006 (the registration). In 2019, Barry's Bootcamp Holdings LLC applied to revoke the registration on the basis of non use. In response Hummel submitted over a thousand pages of evidence showing the mark in use in broadly one of three ways:

1. use of the sign as registered;
2. use of the colour-inverted sign (for example, white chevrons on black bags/socks/balls); and
3. use of the sign on a coloured background (for example, on blue bags/yellow socks).

The Cancellation Division held that Hummel had partially succeeded in proving genuine use broadly in respect of sports bags in class 18, clothing, footwear and headgear relating to sports, leisure and fashion in class 25, and balls for sports/games in class 28. Barry's Bootcamp Holdings appealed.

## The appeal

A focus of Barry's Bootcamp Holding's appeal was the argument that the simplicity of the sign means that it has a low degree of inherent distinctiveness, such that even minor variations could alter its distinctive character. It relied, *inter alia*, upon the judgment in Adidas v EUIPO (case T-307/17) where it was held that inverting the colours of Adidas' trade mark for three black stripes on a white background altered its distinctive character. In dismissing Barry's appeal, the Board of Appeal sought to distinguish this case from earlier case law.



In C-307/11 the Court of Justice of the European Union (CJEU) confirmed that the mark shown above, figure 2, lacked distinctive character, as regards use on shoes, because it could be applied in a decorative way to any part of a shoe, and did not depart from the norms of the sector. In contrast, the Board of Appeal considered the sign was "considerably" less simple than the mark shown in figure 2; it also has no stitches implying it is intended to decorate shoes or clothing.

The Board of Appeal further noted that in an earlier opposition, filed by Hummel against Barry's Bootcamp Holdings' application to register its own chevron mark (R 349/2021-5), Hummel's marks shown above, figure 3, were all held to have inherent, albeit low, distinctive character.

The Board of Appeal also considered the rejection of the position mark shown above, figure 4, due to it being perceived as a decorative element (R1232/2017-2), but noted that the sign is not a position mark showing a chevron sequence, rather, it is a figurative mark consisting of two identical chevrons.

Finally, the Board of Appeal also considered the mark shown above, figure 5, which was initially rejected for footwear as it was considered to be a basic non-distinctive position mark (R 2604/2017-5), even though it was then accepted as having acquired distinctiveness. The Board of Appeal contended that the sign, which consists of two identical chevrons characterised by their outline, equal thickness and width, and the equal distance between them, is not as simple as the examples cited.

Accordingly, it held that use of the colour-inverted sign, that is, white chevrons (which maintained the same outlines, thickness and width) on a black background, did

not alter the sign's distinctive character, and that use of the colour-inverted sign therefore constituted genuine use.

With regard to the use of the black chevrons on a coloured background, for example, yellow socks, the Board of Appeal also held these to be acceptable variations of the sign, relying on case law to do so, as the chevrons and their contrast against a light background was maintained.

## Comment

Although Hummel ultimately succeeded in this case, it would have been far easier, and cheaper (given the amount of evidence required), had Hummel owned registrations for the colour-inverted sign and/or the chevrons on key coloured backgrounds. Accordingly, this case provides a useful reminder that filing for registered trade mark protection for marks in the form in which they are actually used is strongly advised.

**Author:**  
 Olivia Oxtan



## In short

This case confirms that using a registered mark in alternative colours does not necessarily alter its distinctive character such that the use cannot constitute genuine use. However, this only applies if the sign is sufficiently distinctive. To avoid this necessarily subjective assessment and potentially save costs and time, obtaining protection for each form of a mark as used is advised.

# Bit('s) not your coin

## Wright v BTC Core

Case details at a glance

Jurisdiction: England & Wales

Decision level: High Court

Parties: Wright & Ors v BTC Core & Ors

Citation: [2023] EWHC 222 (Ch)

Date: 07 February 2023

Decision: [dycip.com/bitcoinwrightvbtcc](https://dycip.com/bitcoinwrightvbtcc)

Jurisdiction: England & Wales

Decision level: Court of Appeal

Parties: Wright & Ors v BTC Core & Ors

Citation: [2023] EWCA Civ 868

Date: 20 July 2023

Decision: [dycip.com/wrightvbtccourttofappeal](https://dycip.com/wrightvbtccourttofappeal)

There are multiple cases currently ongoing in the High Court of England and Wales that revolve around Dr Craig Wright's claim to be Satoshi Nakamoto, the pseudonymous creator of the Bitcoin system. In this particular offshoot, Dr Wright is suing a host of defendants for infringements of copyright and database rights that he claims to own in the Bitcoin system. The basis of one such claim is that copyright subsists in what is called the Bitcoin file format. That is a contentious issue.

The issue arose pre-trial, in the context of an application by Dr Wright for permission to serve proceedings outside of the jurisdiction. To obtain permission it was not necessary for Dr Wright to demonstrate that copyright does, in fact, subsist in the Bitcoin file format, but instead that there was a real prospect of successfully establishing that fact at trial. At first instance, the court did not agree there was a real prospect but this was overturned on appeal.

### The Bitcoin file format

The Bitcoin system is made up of a series (or chain) of digital files (or blocks) that record information specific to transactions of the digital currency, Bitcoin. The information in each digital file must be recorded in a specific format. Dr Wright claims that copyright exists in the format/structure of those digital files, that is in the Bitcoin file format.

### High Court decision

The judge at first instance was in "no doubt" as to the structure of the Bitcoin file format.

The major issue, as the judge saw it, was that the Bitcoin file format had not been recorded, defined or set out in a material form.

Dr Wright argued that the Bitcoin file format was defined when the Bitcoin system was run and digital files were created in that format. From those files, the Bitcoin file format was identifiable. However, the judge deemed that the files created in that format simply **reflected** the Bitcoin file format, they did not in themselves **define** the Bitcoin file format. As such, his view was that in copyright terms, there was no "fixation" of the Bitcoin file format, and so there was no identifiable "work" in which copyright could subsist.

### Appeal

The fundamental issue on which the Court of Appeal differed from the High Court was whether the Bitcoin file format had to be separately defined (for example, in a standalone template setting out the file structure) in order for there to be fixation, and so for copyright to potentially subsist. The short answer is no.

While the structure must be fixed, "it does not necessarily follow that content defining (or describing or indicating) the structure is required in order to fix it. **All that is required is that the structure be completely and unambiguously recorded**" (emphasis added).

The running of the Bitcoin system, and so the reading and writing of files in the Bitcoin file format, could fulfil that requirement. Evidence

submitted by Dr Wright also supported that conclusion, as it demonstrated that third parties had been able to deduce the Bitcoin file format from looking at digital files in the Bitcoin system.

The consequences of this are two-fold:

1. the Bitcoin file format could exist as a "work" capable of copyright protection; and
2. the Bitcoin file format was identifiable with sufficient precision and objectivity, so that the scope of copyright protection it enjoyed could be understood by the proprietor and third parties.

### Author:

Phil Leonard



### In short

These judgments provide useful clarification on the "fixation" requirement in copyright law under English law. It is important to remember, however, that the Court of Appeal judgment only goes so far as to say that Dr Wright has a real prospect of succeeding at trial on the argument that copyright subsists in the Bitcoin file format. That is a relatively low bar. The Court of Appeal expresses reservations about whether the Bitcoin file format could meet the test for copyright subsistence. In particular, where the Bitcoin file format is potentially only differentiated from other file formats because of technical considerations, does it meet the originality test? The conclusions at trial could provide welcome clarification on copyright subsistence in the context of databases and computer programmes.

Dr Wright is suing for infringements of copyright and database rights in the Bitcoin system



# Bulls shoot and miss UKIPO rejects invalidity proceedings brought by the NBA

## Case details at a glance

Jurisdiction: United Kingdom

Decision level: UKIPO

Parties: NBA Properties Inc v

Pizza Texas Bulls Inc

Citation: O/0644/23

Date: 07 July 2023

Decision: [dycip.com/nbavpizzatexasbulls](https://dycip.com/nbavpizzatexasbulls)

**N**BA Properties Inc (the National Basketball Association or NBA) has failed in its attempt to have the Pizza Texas Bulls Inc figurative bulls head mark declared invalid.

## Background



Pizza Texas Bulls Inc is the registered proprietor of UKTM 3554542, registered in classes 30, 39 and 43 for pizza, pizza delivery and restaurant-based goods and services.

The NBA owns a series of bulls head trade marks used by the Chicago Bulls basketball team, a team notable for its successes in the 1990s when led by Michael Jordan. These marks are registered for various goods and services including sporting and cultural entertainment services under class 41.



## The claims

The NBA made an application for a declaration of invalidity of the Pizza Texas Bulls Inc contested mark on five grounds:

1. Section 5(2)(b) of the Trade Marks Act 1994: likelihood of confusion.
2. Section 5(3) of the Trade Marks: reputation and detriment and/or unfair advantage.
3. Section 56 of the Trade Marks Act: well-known marks.
4. Section 5(4)(a) of the Trade Marks Act: passing off.
5. Section 5(4)(b) of the Trade Marks Act: copyright.

Pizza Texas Bulls Inc denied these claims, arguing that the differences between the marks, as well as the goods and services for which they were registered, created no confusion. Interestingly it did not request proof of use of the earlier marks, nor did it submit any evidence of their own. For its part, the NBA chose not to request

a hearing for this opposition, nor did it file written submissions in lieu of this.

## The decisions

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

The NBA sought to argue that there is a very strong relationship between sporting/cultural events and food such as pizza. However, the UK Intellectual Property Office (UKIPO) placed no weight on this argument and found the goods and services concerned to be dissimilar. Hence, there was no likelihood of confusion and this claim was dismissed.

### Section 5(3) reputation and detriment/unfair advantage

The NBA filed voluminous evidence in its attempts to establish the reputation of the earlier marks such as: promotional materials from UK-hosted matches; broad merchandising and sales figures; social media figures; and viewing figures of matches and other materials such as Netflix's "The Last Dance" documentary. These materials led the UKIPO to conclude that the earlier marks enjoy only a moderate reputation in the UK in relation to basketball-related entertainment. The registrar pointed out that some of the NBA evidence was too vague, and its failure to contextualise figures damaged its chances of establishing any reputation beyond basketball-related entertainment. When assessing whether a link would be made between the earlier and contested marks the UKIPO found there was a low to medium degree of similarity between the marks themselves, and no similarity between the goods and services for which they were registered. Hence, no link between the marks would be made by the average consumer and this claim failed.

### Section 56 well-known mark

This claim requires that either: a) the goods or services be identical or similar and there being a likelihood of confusion; or b) use of the contested mark takes unfair advantage of, or is detrimental to the earlier marks. Following the reasoning they applied to the two claims above, the registrar dismissed this claim as well.

### Section 5(4)(a) passing-off

While the NBA was able to show they had

accrued a moderate level of goodwill in relation to their basketball-based business, the UKIPO pointed out that proving a misrepresentation and resulting damage where there is no common field of activity is a heavy burden. Based on a tenuous overlap between the two parties fields of activity, it was considered that members of the public would be unlikely to be deceived into believing Pizza Texas Bulls Inc's goods would be linked to the NBA. In finding this, the registrar interestingly did not consider the NBA to be a household name in the UK.

On this basis, no misrepresentation or consequent risk of damage was found and this claim was dismissed.

### Section 5(4)(b) copyright claim

This final claim concerned the two logos shown below specifically:



Whilst finding that the works qualify as artistic works and are capable of copyright protection, the registrar considered that the similarities between the works and the contested mark were insufficiently close for the purposes of this claim, and were more likely a result of coincidence than copying. More fundamentally, however, the NBA had failed to file any evidence supporting its claims that it had contracted a Mr Dean Wessel to create the works. The registrar was therefore unsatisfied that the NBA had even demonstrated that it was the owner of the works. Therefore, this claim was also dismissed.

Author:  
Laurie Ford



## In short

This opposition reiterates not only the need to ensure that evidence critical to support a claim is filed, but also that irrelevant or vague evidence is not filed, as such evidence is equally capable of damaging a claim's chances of success.

UKIPO "IPO Transformation programme: second consultation", 22 August 2023:  
[dycip.com/one-ipo-second-consultation](https://dycip.com/one-ipo-second-consultation)

"Launch of the UKIPO One IPO Transformation Programme", 26 April 2021:  
[dycip.com/ukipo-one-ipo-launch](https://dycip.com/ukipo-one-ipo-launch)

# UKIPO One IPO transformation programme second consultation

## A trade mark and design update

The UK Government has launched a consultation on how the trade mark and design system can deliver better digital services. The consultation marks the next stage of the "One IPO Transformation Programme", a five-year initiative to modernise and improve the existing services, policy and practice of the current UK intellectual property system.

For an overview of the One IPO Transformation Programme, please see our earlier article "Launch of the UKIPO One IPO Transformation Programme":  
[dycip.com/ukipo-one-ipo-launch](https://dycip.com/ukipo-one-ipo-launch)

The UK Intellectual Property Office (UKIPO) is calling for views on key trade mark and design issues, including:

- online public document inspection,
- document inspection/confidentiality, and
- series trade marks.

The consultation is open until 11:59am on 31 October 2023.

### Online document accessibility

As the UKIPO progresses towards digitising and modernising its services, it seeks to improve public accessibility to documents and address existing issues and disparities within the current system. It proposes to introduce an online document inspection service for trade marks and designs, similar to the Ipsum service for patents.

For patents, the Ipsum service allows free online access to patent-related documents.

However, no such facility exists for trade marks and designs. The current system is not as convenient or efficient, requiring parties either to physically visit the UKIPO or request copies through a paid service. Moreover, online there are only limited bibliographic details of trade mark and design documents. While the current system offers some privacy advantages, the consultation suggests that the process is inefficient and documents are not as readily accessible as they should be, particularly for overseas parties.

The proposed online document inspection service aims to make documents easily accessible, although certain documents would remain confidential. Also, the UKIPO suggests allowing applicants and third parties to seek the removal of documents due to the presence of sensitive or personal information, in an attempt to balance transparency and privacy. For practitioners, a new online service could significantly improve the efficiency of conducting research and due diligence, thereby facilitating quicker decision-making.

### Confidentiality requests

For trade mark and design documents, confidentiality is assessed by the UKIPO on a case-by-case basis. The consultation acknowledges that the current system suggests a lack of standardised procedures, potentially leading to inefficiency and oversights.

The UKIPO's proposed changes would align with existing provisions for patents, including introducing a post-filing window of 14 days to make a confidentiality request and allowing third parties to do so.

As more data become digitally available,

these changes are likely to be welcomed by practitioners and rights holders alike, especially when commercially sensitive data are involved.

### Series marks

Under a single application, applicants can currently file up to six variations of a trade mark as a "series mark". When filed correctly, series marks provide a more cost-effective and streamlined process and, in particular, can be beneficial for businesses and brands striving to maintain a cohesive brand image. However, the convenience of the current system has led to increased rates of objections and unintended misuse, particularly among unrepresented applicants. For instance, many applicants file unrelated trade marks under a series, possibly aiming to take advantage of reduced costs for dual examination. The consultation indicates that the misuse of series marks raises concerns about the integrity of the system and questions whether series marks really do offer more legal protection compared to standalone trade marks. To address these issues, the consultation presents three possible pathways for the UKIPO to take:

1. Retain the current system.
2. Limit the number of marks in a series.
3. Discontinue series marks altogether.

In theory, reforming the framework of series marks could lead to a more straightforward and efficient system, allowing for better resource allocation and reducing the likelihood of objections; however, the UKIPO needs to ensure that it continues to deliver value to customers.

The UKIPO's determination to engage in reform demonstrates a commitment to addressing longstanding issues and recalibrating the system for clarity, efficiency, and fairness. Input to the consultation process from legal practitioners and brands holders alike will be integral in shaping the future of intellectual property practice in the UK, ensuring that the UK remains one of the best places in the world to protect and enforce valuable corporate assets.

### Authors:

Matthew Dick & Sophia Karim



# D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

## Parody trade marks

# British Hairways Pun intended, but does that make it registrable?

**T**his decision of the Bundespatentgericht (German Federal Patent Court or BPatG) focuses on parodic signs and whether these can be opposed based on well-known trade marks.

### Background

In 2013 a German individual filed for "British Hairways" for "hair salon services" in class 44. British Airways opposed the mark *inter alia* based on European trade mark (EUTM) No. 6561534 (shown below), covering, among others, "airline services" in class 39. The German Patent and Trade Mark Office (DPMA) rejected the opposition. British Airways appealed the case to the BPatG.

## BRITISH AIRWAYS

The BPatG upheld the appeal and cancelled the mark. The BPatG found no likelihood of confusion. However, it confirmed reputation of British Airways (see mark above) for "airline services", and that the relevant public would establish a link between the marks given (1) the high similarity of the signs and (2) the very high reputation of the earlier mark. Further, "British Hairways" would take unfair advantage of "British Airways". In particular, the owner confirmed to have chosen the

name to attract more customers. That such puns would be common in the hair salon business was considered irrelevant.

The use was also considered to be without due course. The court agreed that "British Hairways" was protected as a parody. Nonetheless, freedom of the arts and freedom of expression (if applicable) would not outweigh British Airways' IP rights. "British Hairways" clearly takes unfair advantage of the strong reputation of British Airways. Therefore, it would be unreasonable to grant an exclusive registered right to "British Hairways", irrespective of its proposed use.

While freedom of the arts and freedom of expression may be raised as defences in relation to use, this does not apply to registrations.

**Author:**  
**Yvonne Stone**



*Jurisdiction: Germany*  
*Decision level: Bundespatentgericht*  
*Parties: British Airways Plc v private individual*  
*Citation: 30 W (pat) 15/19*  
*Date: 20 January 2022*  
*Decision: (German text):*  
[dycip.com/britishhairways](http://dycip.com/britishhairways)

### Contact details

**London**  
**Munich**  
**Southampton**

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

[mail@dyoung.com](mailto:mail@dyoung.com)  
[www.dyoung.com](http://www.dyoung.com)

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### Contributors

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



**Partner, Rechtsanwältin**  
**Gabriele Engels**  
[gae@dyoung.com](mailto:gae@dyoung.com)  
[www.dyoung.com/gabrieleengels](http://www.dyoung.com/gabrieleengels)



**Legal Assistant**  
**Laurie Ford**  
[lcf@dyoung.com](mailto:lcf@dyoung.com)  
[www.dyoung.com/laurieford](http://www.dyoung.com/laurieford)



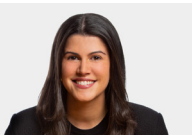
**Legal Assistant**  
**Sophia Karim**  
[syk@dyoung.com](mailto:syk@dyoung.com)  
[www.dyoung.com/sophiakarim](http://www.dyoung.com/sophiakarim)



**Associate, Solicitor**  
**Phil Leonard**  
[pel@dyoung.com](mailto:pel@dyoung.com)  
[www.dyoung.com/philleonard](http://www.dyoung.com/philleonard)



**Associate, Solicitor**  
**Olivia Oxtan**  
[oho@dyoung.com](mailto:oho@dyoung.com)  
[www.dyoung.com/oliviaoxtan](http://www.dyoung.com/oliviaoxtan)



**Senior Associate, Rechtsanwältin**  
**Yvonne Stone**  
[yvs@dyoung.com](mailto:yvs@dyoung.com)  
[www.dyoung.com/yvonnestone](http://www.dyoung.com/yvonnestone)



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