A special publication to mark the 75th anniversary of the Institute of Trade Mark Attorneys

Moving with the times
The changing role of the trademark attorney

ITMA’s history in focus
75 years of achievement

The next 25 years
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Grant Spencer welcomes this opportunity to congratulate ITMA as it celebrates 75 years of leadership and service within our industry.

This is also a fitting occasion to launch our new name and our new look. Whilst we have changed the face of our business, there is no change to the quality and range of our services.

We remain specialists in trade marks and designs and shall continue to be a leader in our field, safeguarding the intellectual property assets of our clients...in the UK, across the Community and worldwide.
Reflecting on the past, moving with the times

Dear Members,

I am delighted to be President of ITMA in the year in which we celebrate our 75th anniversary. I hope that as many as you as possible will join me at the Royal College of Surgeons for a celebratory drink and canapés after work on the evening of 24 November 2009, which is the actual anniversary date.

In the following pages, you will read articles from former Presidents on the first 25 years of ITMA’s existence, the middle and second 25 years and the last 25 years. During the first 25 years we saw the introduction of the 1938 Act which was with us for 56 years, in the second 25 years we saw the UK joining the European Union and the effect that European Union law had on this country, and in the third 25 years we saw the introduction of the 1994 Act, the setting up of OHIM and the Community Trade Marks Register, the accession of the UK to the Madrid Protocol with many other territories subsequently following our example, and the introduction of the Community Design. In addition, we have seen a hugely enlarged European Union.

Ian Buchan, another past President, will write on the next 25 years which will include our requirement to be regulated under the Legal Services Act, the new education system which will greatly enhance our standing as part of the legal profession overall as well as, I hope, far greater emphasis on Trade Mark Attorneys as litigators. His article has been written with considerable assistance from another former President, Phil Harris and I am indebted to them both.

Finally, in the succeeding pages, Maggie Ramage, the First Vice President of ITMA and, I hope, my successor next year, will be writing on the changing role of the Trade Mark Attorney.

I joined the profession in 1967 when there were very few female Trade Mark Agents. Certainly, when I first joined the profession after leaving school at 18 with A levels, it did not occur to me that I would one day qualify as a trademark attorney, yet alone ever be President. The practice in the company I joined was for “the men” to be the Trade Mark Agents and “the girls” to be eternal assistants. Even the first woman President, the greatly respected Ms. Sheila Lesley, had yet to take her place as the first female President of the Institute.

Times have changed hugely over the past 40 years but the one thing that I have realised is that it is vital to move with the times. After all, as the human race, we have only survived by being able to evolve.

I hope that in the years ahead Institute members will continue to evolve and keep pace with the times and I wish you all the very best whether you are moving towards the end of your career as a Trade Mark Attorney or whether you are just starting out in the profession.

With my warmest wishes

Gillian Deas
President,
Institute of Trade Mark Attorneys

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In the beginning, there were agents—who for centuries had fed the bureaucracy of the state. Their role was to discharge the formalities involved in the grant of favours/monopolies by the monarch on behalf of clients, principally by the payment of fees and the presentation of documents for signature and/or sealing. With the passing of the Statute of Monopolies in 1624, this began to change and by the time of the establishment of the Patent Office, and the passing of the Trademarks Act of 1875 and the Patents Act 1883, simple agency was no longer an option; “agents” began to acquire professional competence. As a result, the Institute of Patent Agents was formed in 1882 to promote their interests. This Institute received its Royal Charter in 1891 but this Charter, however, did not extend to trademarks—had it done so, history may have been very different.

As separate practice developed under two distinct acts of parliament, it soon became clear to some that the practice of patents and of trademarks were two different professions. By 1930, there was a recognition that the interests of those engaged in practice as trademark agents required more support in terms of professional matters, representation, education and training. Although some activity in this field was carried on by the Chartered Institute of Patent Agents, it was natural for those seeking professional recognition to seek this under the umbrella of a professional Institute for trademarks.
Discussions took place both formally and informally over a number of years, and in 1934, with the possibility of a new trademark act looming, practicing trademark agents decided to meet to discuss the possibility of a separate body to represent the interests of Trademark Agents.

On the 24 October 1934, a group of agents met at the London Chamber of Commerce to discuss the formation of an Institute to become known as the Institute of Trademark Agents. It was agreed that the Institute should be a company limited by member guarantee. The founding members attending that meeting were: G Arthur Wingfield, Sir William S Jarrett, R W Barker, A Romaine Carpenter, Arthur Caton, G B Ellis, K S Goodall, J N Evans-Jackson, E C Neal, M F Rowland and W A Shepherd.

From then on, the fledgling Institute made rapid progress. G Arthur Wingfield was elected as the first Chairman. A limited company was formed and the Institute was formally incorporated on 24 November 1934. At the first meeting of the limited company the nature of the future Institute was largely determined. It is interesting to note that the initial membership was limited to 100 but with a proviso that this could become unlimited when the situation demanded. The office of the Institute was to be the London Chamber of Commerce where it was to remain for the next 50 years.

Our founding fathers set about producing an operating framework for the future with great energy. An administrative Council was established and in December 1934 Sir Edgar Sanders, a Director of the Brewers Society became the first President of ITMA with Sir William Jarrett (one-time Comptroller of the Patent Office) as Vice President. At the end of December 1934 the membership was over 50 and the Institute was solvent with £70 in the bank. Mr Allanby of the London Chamber of Commerce was appointed as the Secretary of the Institute, again establishing an arrangement that was to last for the next 50 years.

As 1934 turned into 1935, the Institute had evolved, in a surprisingly short period of time, to something that we would recognise today. The method of electing new members to the Institute at Council meetings has remained essentially unaltered for 75 years; the need for money in the early years was critical to the long-term survival of the Institute, and the early minutes reflect the same concerns that I witnessed in the “hungry” days of 1985/6 from which one can only conclude that nothing ever changes!

By now ITMA was expanding, Associate Membership and Overseas Membership had been established at an annual rate of one guinea and 50 shillings respectively! The first Ordinary Meeting of the Institute took place on 15 April 1935 at the London Chamber of Commerce with 13 members attending. A 12-member Council was elected, accountants were appointed and various amendments were made to the Memorandum and Articles. About this time the Institute set up a sub committee to look at the establishment of a qualifying examination which resulted in the first examination being held on 21–23 November 1935 in the private suite of Lord Marks at 60 Lincolns Inn Fields, i.e. just a year since inception – fast work!

The year 1935 saw the start of the preparations for the 1938 Act. The negotiations and lobbying with regard to the new trademarks act were proceeding apace with the ITMA team headed by Sir Duncan Kerly KC. A major issue was the possibility of establishing a Register of Trademark Agents. Because of the restrictions in their existing charter, CIPA were proposing to seek a supplement to their charter to include trademarks. ITMA agreed not to oppose this with the proviso that “in the event of ITMA in due course seeking a charter, they trusted that CIPA would give the appropriate support”.

The Institute continued to flourish until the outbreak of the World War II in September 1939, by which time the Institute had some 150 members of all classes and approximately £200 in the bank. It had approved the description “MITMA” to be used by ordinary members of the Institute, was grappling with the finer points of registered users and extensions in opposition proceedings and had joined with CIPA to recommend a scale of fees for use by members.

Wartime inevitably brought a major change to the affairs of the Institute; some members joined the armed forces to serve their country (it is a pity we do not have a record of these). Arthur Wingfield had retired from Council because of continuing ill health and J N Jackson-Evans was elected chairman in his place; he was to remain chairman throughout the 1940s. The first Council meeting after the declaration of war on 12 October 1939 spent most of its time discussing the Emergency Regulations Bill. However, as the war progressed, meetings were severely curtailed, examinations were suspended. At one point the Institute decided that with a bank balance of £224 it was patriotic duty to put £75 of this into Defence Bonds! In some years there was not even an AGM. Wartime also saw the birth of the Trademark Directory Service which attempted to overcome the lack of indexes available from the TMR and which also sought to coordinate searches overseas.

With the coming of peace, the Institute was slow to recover with the first AGM for nearly two years in December 1945. The period of the late 1940s was one of consolidation for the Institute, the examinations restarted and the subcommittee structure of Council began to develop into much the sort of format that we have today.

The minutes record the first Annual dinner on the 20 April 1948 at the Connaught Rooms; it made a thumping great loss of £51.16s.0d which was eventually paid out of Institute funds! The financial loss at Annual Dinners became a subject of comment in the minutes up to and including 1959. Part of the problem was the large number of guests in relation to the attendees and the high consumption on the top table particularly in terms of alcohol, cigars and cigarettes. Gosh how times have changed!

A considerable amount of effort was expended by the Institute on their examinations committee although it is not clear that a corresponding amount of effort went into education and training. By December 1952, concern was being expressed that the standard of candidates for the examinations was rather low in that only two of the seven candidates passed the examination. Today’s candidates would wince at the standards required, the pass mark was an average of 55% or better over all the papers and at least 50% in each paper.

In 1948, some 14 years after its establishment, the Institute thought about an application for a charter. In spite of a considerable number of minute pages on the subject, many enquiries and much research,
no formal application for a charter was submitted.

Membership and qualifications were also major issues throughout the period following World War II. Questions of how to deal with solicitors and agents and others of competence who had qualified since 1934 exercised Council, which decided that, prima facie, individuals with appropriate professional qualifications obtained since then would be eligible for membership.

One of the more difficult problems arose from the Patents Act 1949, CIPA had agreed to amend their rules – the famous Rule 12 – to allow onto the register, heads of department and others with experience in the patents field without the need for examination. ITMA took the view that a patent agent was a patent agent and that they should be accepted as ordinary members wished for such a merger to proceed. So at the end of the first 25 years, our founding fathers had tackled the task of forming and establishing a professional Institute with remarkable speed and clarity of purpose. What has been most surprising in reviewing the minute books of the Institute over its first 25 years has been the rapidity with which the Institute became recognisable as the body we know today. We sometimes think that our generation is the only generation that has grappled with any particular problem, yet reading through the minutes it was almost as if they had been written during my own period of tenure as an officer of the Institute. What shines through is the sheer professionalism of those that established and subsequently served the Institute. Throughout its existence, members have served, given time and effort without any reward other than that of a job well done.

Note: This is a highly abridged version of David’s article. For a full version see the ITMA website www.itma.org.

AUTHOR

David Evans, CPA, EPA, FITMA. Qualified in 1964, joined FJ Cleveland in 1966. David read Chemistry at Imperial College, London. He had over 40 years of experience of patents in the general chemical and electro-mechanical fields, and had particular expertise in fibre technology. David also had a substantial trademarks practice, representing a number of famous international brands. David is a past President of ITMA.
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Finding our feet

Keith Havelock reflects on the period 1959 - 1984: a time of consolidation for ITMA

Being a student member of the Institute of Trade Mark Agents in the late 1950s was a relatively straightforward affair. There were none of today’s various university courses of study, instead professional education could be obtained from only three or four sources. First were the monthly evening meetings of the Institute, addressed by senior practitioners and other worthies, held at the Institute’s oak-panelled headquarters at Cannon Street in the City of London. In those days and until the 1980s, accommodation and administrative services were provided for the Institute by the London Chamber of Commerce and its secretaries were employees of that organisation. At the evening meetings, topics ranged from “Trademark protection in the Persian Gulf” (speaker: an overseas member from Bahrain) and “Service marks in the USA” (speaker: Dr Walter Derenberg) to occasional Brains’ Trusts, where leading members of the bar and senior practitioners gave answers to questions on professional subjects.

In addition to these events, students could attend a short course on general law at the Sir John Cass College in Aldgate, London (now part of the City University), and thirdly there were fortnightly students’ lectures, given or organised by two stalwart Council members of the time, Eric Wenman of ICI and Jack Newton of UDL and later Langner Parry, New York. Students of the time owed a lot to these gentlemen, both of whom served as honorary secretaries of the Institute, answering what we would now see as public relations questions.

Despite the limited range of educational opportunities, students, although few in number (it was not until the mid 1960s that the numbers qualifying reached double figures), generally acquitted themselves well in the annual entrance examinations and, as in the case of their pioneering predecessors, found their work varied and challenging. They sensed its growing significance and importance in economic and business terms, as well as relishing the international and social aspects (somehow trademark people always seem to know how to have a good party). Although specialists in the discipline tended to be treated with a degree of disdain by certain factions of the patent profession, at the students level little notice was taken of such matters. They simply enjoyed getting on with it and had a clear vision that their day would come.

Because they were few in number, young agents often had a lot of responsibility in their firms. Your reporter had a case as a newly-qualified agent in his twenties that went to the court of appeal and involved instructing a leading QC of the day, R.G. Lloyd, later Lord Lloyd of Kilgerran. Also instructed in the same chambers was a flame-haired young barrister named Max Mosley. He subsequently became notorious in racing but started at the trademark bar (you read it here first). In the final advice before the hearing, Lloyd wrote, “A Declaration on the collection of evidence should be made by reference numeral KRH or some more senior member of my instructing agents’ firm”. Naturally there was no way on earth that reference numeral KRH would allow anyone else to steal his hard-earned thunder.

One tangible mark of the profession’s coming of age had been the creation of the Institute’s first emblem, embodied in the President’s badge of office. A gift from the
The D Young & Co Trade Mark Group would like to express their continued support and appreciation for the Institution of Trade Mark Attorneys and congratulate the Institution as it celebrates 75 years of service.

The D Young & Co Trade Mark Group is pleased to be recognised by two leading international intellectual property surveys as a top tier UK trade mark practice. The Legal 500 survey has ranked D Young & Co as a top tier UK trade mark practice for the seventh consecutive year, while Managing Intellectual Property has ranked D Young & Co as one of only two top tier firms for trade mark prosecution work in the United Kingdom in its World IP Survey.

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“Trademarks in the Common Market” grew
ever stronger. At first there were educational
lectures and correspondence in the national
press, to which ITMA contributed, and
then in May 1962, the President of the Board of
Trade wrote to the President of the Institute,
inviting him to nominate members to join a
liaison group whose remit would be to give
government the profession’s views on
proposals by the Common Market countries
(many years before these included the UK)
“to establish a common system of trademark
registration which would carry rights in the
trademark over the whole territory of the
EEC”. This was the first of other such
groups including, later, the Standing
Advisory Committee on Trade Marks (SACTM),
and on Industrial Property (SACIP), which gave the Institute
the opportunity to make its views known to the
government and sister bodies.

The passing of the Plant Varieties and
Seeds Act in 1964 added a new subject to the
syllabus for the Institute’s examinations –
plant variety names. Interest was also
growing in associated subjects such as
geographical indications of origin.
During the period under review in this
article, UK trademark law and practice as such
was becoming increasingly outdated. The
legislation dated from 1938. On two occasions,
the first in 1969 and the second in 1980,
extensive reviews and recommendations for
reform were made by the Institute and
submitted to government and interested circles.
Neither review produced any immediate
positive result, but the former did contribute
towards the setting up in 1972 of a
Departmental Review of UK Law and Practice,
under the chairmanship of H.R. (later Sir
Reginald) Mathys. The then President of the
Institute, Douglas Parker of Shell, was
appointed a member of the Committee.
This was a once-in-a-lifetime opportunity and a mammoth exercise was undertaken to
produce the best possible evidence for
submission to Mathys. Every qualified
member of ITMA was approached individually to assist. The resulting
document, edited by Sheila Lesley of
Forresters, later to become the Institute’s
first female President, was acknowledged as
one of the best put forward. Although the
setting up of the Standing Advisory
Committee on Trade Marks was the only
Institute recommendation to be acted upon
immediately following publication of the
Report, other emphatic recommendations,
such as the need for legislation to provide for
the protection of marks for services as well
as products, and the general message that
modernisation was vital, came across
strongly and registered in the minds of the
legislators. In the mid 1980s and early 1990s
a strong flow of new legislation affecting
trademark and associated rights at last
resulted, incidentally achieving several of the
original goals of the Institute as set out in its
Articles, such as the establishment of a
register of qualified agents and the extension
of legal privilege to their communications, as
well as the possibility of mixed partnerships
between trademark and patent practitioners
being set up.

Other domestic developments taking place
at this time included a long debate
concerning a possible merger between the
Institute and CIPA, ultimately rejected by
the respective memberships. On the day of
the vote, an article appeared in The Times
Business Diary about the possible merger,
depicting the Institute’s emblem.

Several anniversaries were celebrated in the
1970s, including the centenaries of the
first UK Trade Marks Act of 1875 and of the
opening of the Trade Marks Registry in
1876. This last event led to a notable joint
venture between the Institute and Bass
Charrington, owners of Trade Mark No 1,
the Bass red triangle label for pale ale. This
was a competition for the “Bass Award”, a
prize for the best use of a trademark in
advertising, eventually won by Rowntrees
for their mark After Eight. Around the same
time, the ITMA Newsletter was launched
and the Information Committee was
successful in persuading The Times to
publish a supplement on trademarks.
Elsewhere, developments in connection
with the proposed EEC trademark were
gaining momentum, with hearings held in
Brussels to gain the reaction of the
professions in Europe. There was also the
associated question of where the
headquarters of the proposed new system
would be sited. Initially, a movement to site
the office in London, in which the Institute
participated, was supported by Mrs.
Thatcher’s government but later, the same
government changed direction and opted for
another institution, allowing the prize that
had been within its grasp to go to Spain.
Despite this disappointment, the Institute
was growing in strength and influence. Its
own independent office was established and
Margaret Tyler appointed assistant
secretary. A private member’s Bill to
introduce service marks was published and in
May 1984, The Trade Marks Amendment
Act passed into law. ITMA played a major
part in bringing this Act to the Statute Book.
The future was looking bright and the
Institute had definitely found its feet.

AUTHOR
Keith Havelock is a past
President of ITMA, and is
still active in its affairs as
a Council member. A
former senior partner of D
Young & Co, he was appointed Secretary
General of the European Communities
Trade Mark Association, a position he still
holds, in 2001. He was twice Chairman of
the Institute’s Laws and Practice
Committee, first joining it in 1972, and
edited the ITMA Newsletter (now Review)
also for two periods. He is a founder
member of ECTA and has written and
lectured widely on IP subjects.
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1984 to 2009: The years of change

Richard Abnett discusses the introduction of the 1994 Trade Marks Act, the Community Trade Mark and Madrid Protocol

Twenty-five years ago a Trade Mark Agent, as he or she (more usually he) then was, operated under a UK law passed before World War II. Marks were unregistrable for services; they provided no protection for even the identical mark on non-identical goods. Protection for trademarks in Europe could only be sought country-by-country. Most UK Trade Mark Agents had no acquaintance with the Madrid Agreement, which was not open to UK nationals. And we didn’t have computers, let alone the internet.

So much has changed since that time. It has changed not just in one sector of a Trade Mark Attorney’s life, but in every sector. It is no longer practical just to take a chronological view through what has happened in the last 25 years of the Institute’s existence. In whichever area you look there have been enormous and fundamental changes.

Legislation
The first change was the introduction in 1984 of the possibility of registering trademarks for services. This the amending Act did by notionally amending the 1938 Trade Marks Act so that there was one form of the Act for goods and another form for services. Somehow we coped with this, and started filing applications for services on 1 October 1986.

The Copyright, Designs and Patents Act 1988 provided for the possibility of granting privilege for Trade Mark Agents, or more correctly their clients. Thus, these major steps forward for Institute members, arguably the greatest since the establishment of ITMA, were introduced by an Act which did not even mention trademarks in its title.

The 1988 Act also provided for the possibility of mixed partnerships of Patent and Trade Mark Agents.

The next step forward on the domestic scene was the Courts and Legal Services Act 1990. A minor provision, directly initiated by the Institute, was an amendment to the Solicitors Act allowing Trade Mark Agents to prepare deeds relating to Intellectual Property. But the main significant feature of the Act was to lead, somewhat tortuously and only after several years, to rights of audience and representation before the UK Courts, as we see below.

The Institute’s Annual Reports testified to the many other items of primary legislation where the Institute was consulted. One of practical importance was the provision in the Finance Act 1999 by which stamp duty on IP transfer documents was removed.
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The 1994 Trade Marks Act
Of course the major item of UK legislation over the last 25 years was the 1994 Trade Marks Act. The first challenge was to persuade the government to include a Trade Marks Bill in the Queen’s speech at all. The Department of Trade and Industry had given a strong indication that there was a possibility of the Directive being implemented by secondary legislation, which would have been disastrous in giving rise to a hotchpotch of law regulating trademarks in this country. ITMA was able to influence the Bill considerably, and indeed the Bill broke the record for the number of amendments presented as it went through Parliament.

Most importantly from the point of view of the profession, ITMA were able to add what is now Section 86 to the Act, making it clear that registered Trade Mark Agents could use the term “Registered Trade Mark Attorney”. Gaining acceptance for the term “Registered Trade Mark Attorney” legitimised our use of “Trade Mark Attorney”, thereby putting us on an equal footing with our international colleagues.

The Act maintained the examination of applications on relative grounds, but provided that there should be a review of the system after 10 years. An initial review in 2001 resulted in a decision that relative grounds examination would continue. Any celebrations were short lived; examination on relative grounds ceased in 2007.

The Community Trade Mark and Madrid Protocol
Throughout the 1980s the Institute had been involved in discussions with the Government about the then-planned Community Directive and Regulation on Trade Marks, and on the proposed Madrid Protocol. The Regulation establishing the Community Trade Mark was eventually finalised in 1994 and the Institute then embarked on a rapid education programme for its members in advance of the formal opening of the Community Trade Marks Office on 1 April 1996. It is little more than a dozen years ago, but it is now probably true that the majority of Trade Mark Attorneys spend most of their time dealing with Community trademarks rather than UK trademarks.

The Madrid Protocol became effective at the same time. It is true to say that relatively little use of it was made by British companies, at least until 2004, when the link between the Madrid protocol and the Community Trade Mark was established. That opened a whole new range of possibilities, and thus complexities, with which UK Trade Mark Attorneys have had to grapple.

Designs
When the Institute was first set up the idea of becoming involved in designs was specifically excluded. Over the last 25 years that initial decision has been firmly reversed. The Institute was involved in discussions from 1995 on the Community Designs Directive and Designs Regulation, and on the amendment of The Hague Agreement. The adoption of the Directive and Regulation at the end of 2001 served to provide publicity to this form of Intellectual Property. The Institute co-operated with CIPA in the production of a Community Designs Handbook which was published in 2005.

Institute services
In 1984 the Institute set up its own premises at Panther House on the edge of Clerkenwell. After some heart-searching, the Secretariat was moved out of central London to Croydon, where it now remains, a decision which quite clearly was the right one. The premises and staff have steadily increased, though Margaret Tyler has served continuously since that date, becoming Secretary in 1986 and justly receiving an MBE in 2004.

Education and training for qualified Trade Mark Attorneys has vastly improved following the introduction of continuous professional development requirements in the year 2000. The monthly ITMA Review is now full of topical case reports. Two major publications jointly launched by ITMA and CIPA are the UK Trade Marks Handbook and the Community Trade Marks Handbook.

The debt owed by practicing members to their administrators is enormous, and since 1997 the Institute has run a Trade Mark Administrators course, leading to a Certificate which recognises their contribution and training.

Publicity for Trade Mark Agents’ services has been an increasingly important activity for the Institute. In 1993 the Institute adopted its “tile” logo, which still provides it with a crisp and clear identification. A Public Relations committee established in 1994 promotes the activities of Trade Mark Attorneys, and in 1997 appointed Ken Storey as PR Manager. Under his guidance the Institute has been represented at many business exhibitions around the country, and issues regular press releases. The Institute has also attended several meetings of INTA, in particular in Amsterdam, Atlanta and Berlin, and has sent delegations to Japan, China and the USA.

Contentious work
As noted above, the Courts and Legal Services Act led to an application to the Lord Chancellor’s office for rights of audience and representation before the UK Courts.

Eventually, effective 1 May 2005, suitably-authorised Trade Mark Attorneys could at last appear before the County Court and on certain interim matters in the High Court.

Litigation and contentious matters are forming an increasing proportion of the work of a trademark attorney. This has led to the establishment of an Intellectual Property Registration Board, and to wider control of the activities of trademark attorneys, which parallels that of others involved in the law, in particular solicitors. While the increasing recognition of our profession that this witnesses is to be welcomed, it may have far-reaching effects on what we require from our Institute. It no longer has responsibility for examinations, nor for discipline, and thus its primary focus will move more clearly towards safeguarding the interests of its members and publicising their services.

Where are we now?
We started the last quarter-century as trademark registration agents, but have truly become trademark attorneys, lawyers versed in our sophisticated area of intellectual property. The profession has faced many challenges, and opportunities, over this time. We can expect more, but we have shown that we have the resources, the expertise and the will to continue uniquely to provide commerce with the specialist service it needs to look after its all-important brands.

1 For more on ITMA’s involvement in the 1994 Act, see the author’s paper in Trademark World’s publication World Focus: Celebrating ITMA, October 2004, pages 22-25

AUTHOR
Richard Abnett practises extensively in trademarks and is a Fellow of ITMA. He was a Council Member for 20 years and its President from 1992 to 1994. He has been with the London firm of Reddie & Grose throughout his professional career. Mr Abnett is joint general editor of a regularly-updated practitioner’s loose-leaf manual on the European Community Trade Mark, and has co-authored training manuals for intellectual property trainees.
What the future holds

The next 25 years of ITMA will see new regulation and a new education system. Ian Buchan discusses the issues

I have been asked to write about two topics close to my heart; regulation of the trademark profession and the new education system for budding trademark attorneys. I shall be considering also the likely effects of regulation and the change in the educational process on the profession over the next 25 years.

I will not be looking too closely at the minutiae of regulation and the new education system because I think they are already well known to you. I will be focusing rather on my opinion of the effects and benefits of these changes to the profession.

Now the legal bits. The views expressed here are my own and do not necessarily reflect those of Potter Clarkson LLP (for whom I am a Consultant), IPREG (on whose Board I sit) nor those of ITMA Council.

Regulation

Historically, Trade Mark Attorneys were perceived, in some quarters at least, as being “inferior” to solicitors, for example, because they were not “lawyers”.

In my view The Legal Services Act 2007 (The Act) has changed that for ever. The Act, for which ITMA lobbied in support over many years, (going back to the time when David Evans was President) recognises that Trade Mark Attorneys are lawyers to be treated and dealt with on the same footing as solicitors and barristers, for example.

This in my view is a huge step forward in properly recognising the unique and highly professional skill set that we individually and collectively possess.

One quid pro quo of this recognition under The Act is that, along with all the other “lawyers” we are to be regulated by an independent body, in our case The Independent Regulation Board Limited, (IPREG) rather than by the Institute as previously.

IPREG will be responsible for establishing and regulating compliance with a Code of Conduct, CPD requirements, and a Disciplinary Code all of which we will have to adopt and use. In addition IPREG will establish, maintain and publish public Registers for firms and individual attorneys.

I know there are concerns about the potential costs, complexities and perceived potential added burdens of being regulated by IPREG and the Legal Services Board, (LSB).

While I acknowledge that there may well be a moderate increase in costs to practitioners I firmly believe that the benefits of regulation, to both the consumer and practitioners, totally outweigh any perceived disadvantages of independent regulation. There are in addition other potential benefits to trademark attorneys that flow from The Act.

What are those benefits?

1. There is increasing pressure on the government and its agencies to introduce legislation to prevent those practitioners and firms, who are not on the Register of Trade Mark Attorneys or the Entity Register respectively, from using titles such as “Trade Mark Attorney”. This pressure has arisen as a result of belated recognition by the authorities, arising from discussions during and subsequent to the introduction of The Act, that at present anyone can call themselves a “Trade Mark Attorney”. On the assumption that pressure bears fruit then we should get to the position where only those of us, and our firms, who are regulated will be able to use the title “Trade Mark Attorney” to distinguish us from those offering trademarks services in the UK who are not so regulated.

2. The fact that we are now accepted as “lawyers” must enhance, in my opinion, our status in the eyes of our clients and
ITMA, in association with InBev, owners of the famous Bass Red Triangle trade mark, invite you to celebrate 75 years of history as documented in this supplement on

Tuesday 24 November between 6.00 and 8.00pm
in the
Edward Lumley Hall of the Royal College of Surgeons,
35-43 Lincoln’s Inn Fields, London

Attendance is FREE to ITMA members and only £40 to non members

Join us for fine wines and canapés and perhaps a bottle of beer.

To apply for tickets please contact val@itma.org.uk

(Places are limited to 400 so apply early)
our colleagues in other legal professions. It will also assist our efforts to gain rights of audience at forums such as the CFI, from which of course we are presently excluded, partly on the grounds that we are not “lawyers” within the court’s statute.

3. I think that, in the eyes of our clients, and potential clients, the fact that we are now both recognised as lawyers, and subject to independent regulation, must give us a competitive advantage vis-à-vis our competitors, both here and in Europe, who offer the same services but are not subject to the Act and independent regulation. That is an advantage which I would urge you all to exploit when marketing your services.

Our clients should now feel even more comfortable using the services of Trade Mark Attorneys regulated by IPREG knowing that those so regulated act according to a strict code of conduct, have to undertake CPD and are subject to independent scrutiny and sanctions in the event of successful complaints. After all if you were a client who would rather deal with? An attorney subject to independent regulation or one not so subject?

4. A further benefit is that you will be able to continue carrying out “reserved activities” such as drafting assignments, appearing in Court, if you are a litigator, which would otherwise be unavailable to you as an attorney not subject to regulation by IPREG.

5. Finally The Act introduces LDP’s, Legal Disciplinary Partnerships, which allows other lawyers and indeed non-lawyers to enter into partnership with Trade Mark Attorneys, and ABSs (Alternative Business Structures) which, when introduced, will allow non-lawyers to own firms of, or employ, Trade Mark Attorneys. LDP’s for example allow you to employ or have in partnership solicitors and barristers who could handle litigation for you.

Education
The new educational system for Trade Mark Attorneys is due to start in 2010. From that time new entrants to the profession will be required to complete satisfactorily three components in order to be qualified; a law course (presently to be run by Queen Mary College), a Practice Course (currently to be run by Nottingham Law School) and finally satisfy the experience requirements, not yet established but likely to be three years full-time experience of trademark attorney work.

It will be evident from this summary that the days of being taught in house and sitting the JEB exams, both foundation and finals, are over for all new entrants to the profession. The primary reasons for the change from the existing system are:

• the high failure rate of candidates, particularly in the final exams, despite extensive coaching of candidates by way of tutorials and seminars – a rate wholly at odds with outcomes in comparable professions

• the perception that the exams concentrated too much on exceptional areas and exotic minutiae but did not adequately test a candidate’s core skills, in particular their skills of advocacy, preparation of evidence and day-to-day practice

• a recognition that the whole process was educationally flawed in that most of the teaching and examination of candidates was carried out by practitioners, who while being very good Trade Mark Attorneys, were generally not trained to teach or examine candidates

• a desire to establish a system that would be seen to be credible, robust and transparent, which was taught and examined by educational specialists and accredited by ITMA as a recognised external body and fair to the candidates leading to the establishment of a benchmark qualification that will be recognised by all as the best in the EU. This, after all, is recognised generally as being the modern way of best training professionals

There are obvious potential issues with the new system. The prime one being the cost to firms, or individuals, of paying for and attending all the courses, a cost that is not present, at least obviously, under the existing system. Having said that the indirect cost to firms, which is generally not accounted for, in fee earner time spent teaching trainees the skills they will now gain on the two compulsory courses may well be equal to the cost of these courses.

Since the system has yet to start there is no data on which to base any comparisons. I am therefore forced to speculate about the effects and benefits of the new system.

I believe strongly that the new system will produce Trade Mark Attorneys who are thoroughly grounded in all aspects of the law, all having been taught in a coherent and professional manner by educationalists. Those Attorneys will then have been fairly examined on those aspects, and at the same time will have obtained the vital practical experience during the course of their employment. In consequence I think that the overall skill sets of the future Attorneys will be greater and of a more even nature than at present, thus raising yet further their standing in the eyes of clients and competitors.

Finally, the Institute is revising its Litigator Training course and we expect that in the very near future, it will be possible to choose between full advocate and representational qualifications, taught in a much more appropriate and proportionate structure, which should enable many more practitioners to acquire these skills. The Institute is also working closely with the IP Judges and other professions to reform the PCC to make this a more readily accessible and useful forum. If these plans come to fruition, trademark litigation should increase.

Conclusion
The combination of the new education system and independent regulation will, in my view, create a profession which has the highest educational and regulatory standards placing it in pole position for dominating trademark work in the UK and before OHIM for the foreseeable future.

Without independent regulation and the new education system there is, in my view, a serious risk that the profession could stagnate and we would all lose our present standing as the experts of choice for clients.

AUTHOR
Change and challenges

Maggie Ramage on the changing role of the UK trademark attorney

The past 75 years have seen enormous changes for the UK trademark profession. In the last 15 years, we have had a complete new UK trademark law, seen the advent of the UK joining the Madrid Protocol, and the European system of trademark registration and design registration before OHIM. In more recent years, we have seen the rise of the internet and domain disputes. Our first UK trademark litigators have qualified (2005), with rights of audience in the Patents County Court, and with training in advocacy and case management. Among other things, we now have a recent set of new rules from the IPO, the abolition of Section 5, or citation of prior rights, on new UK Trade Mark Applications, a new Company Names Tribunal, and also mediation.

All of these areas have shown an increasingly complex subject and The Institute of Trade Mark Attorneys has been well placed not only to implement new procedures, but to have been proactive in being involved in consultation groups, to help lobby, advise and shape the new procedures with government officials, before those procedures start.

It is no longer the case that the role of the UK Trade Mark Attorney concentrates on trademark protection. It is increasingly the case that defence and contentious issues are the day-to-day work, with a larger number of differing areas of IP law and practice to consider.

Regulation changes

Perhaps the biggest change for the UK profession in recent years, and for the future, is regulation of intellectual property trademark and patent attorneys for the first time, by the Joint Regulatory Board, known as IPREG. We have set this up between ITMA and CIPA as a joint Board, starting in 2010, and following the implementation of the Legal Services Act 2007. We now have regular contact with the Ministry of Justice, as a result of this. This new Regulation is already reshaping our Institute, as we will all have to comply with the Joint Code of Practice with IPREG, to satisfy the requirements of the Legal Services Board and Office of Legal Complaints.

Certain areas traditionally overseen by ITMA for their members will now be overseen, along with the equivalent areas for CIPA, such as education and training, continuing professional development requirements and disciplinary matters, by the new IPREG Board.

I believe the new regulatory regime can only be good for the joint IP professions, to set out a new gold standard for our practice, but of course, traditionally, we have had few disciplinary matters to address overall, compared with other branches of the law in this country.

I am well aware that there are at present concerns about the cost of regulation, and we will all have to grapple with those per head, as well as perhaps registration of legal entities in the future. However, I believe regulation will raise our profile positively with the public.

ITMA plans to relocate the Head Office shortly. The lease is up in Croydon in March 2012. We are already working on a feasibility study to look for future premises, perhaps closer to the centre of London, and we hope we may be able to house our own Committee meetings, and perhaps tutorials and other meetings as well.

Therefore, for the future, our Institute faces huge challenges, probably bigger than at any time in our history.

We took on last November a chief executive (ex-IPO), Keven Bader, to help Council members and officers, and to steer through these turbulent waters we will be facing. He is doing an excellent navigation job. We are already substantially re-working the structure of ITMA, to face the future.

Margaret Tyler MBE, our UK Registrar, will be retiring in 2009, after a long career with ITMA, although we will all have to comply with the Joint Code of Practice with IPREG. We thank Margaret for all her hard work over the years. She will be missed by us all.
International links

We are forging ever closer links with OHIM, joining in on an annual British Day, to discuss ongoing practices and procedural matters, and attend regular Registry Practice Working Group meetings with the same viewpoint with the UK IPO. The officers also have regular meetings with senior personnel from the IPO, to include our own Registrar.

We have also formed increasingly strong ties with the international groups, such as ECTA, Union and MARQUES, and our sister Institutes, GRUR (Germany), APRAM (France) and BMM (The Benelux), with meetings held annually around Europe to discuss matters of joint importance, often resulting in joint presentations and lobbying to OHIM and WIPO.

We have run some very successful lecture tours to the USA, and recently ran our third presentation tour to Beijing and Tokyo, and these were well received by members of the CTA, the JPAA and the JTA. We hope to continue these in the future, perhaps visiting new countries, to explain our activities and the benefits of joining our Institute as overseas members.

For INTA we recently had a particularly successful reception, hosted at the British Embassy in Berlin, and will be repeating this exercise at the British Embassy in Boston in 2010.

In the UK, we are now running regular visits to our own practitioners around the UK, having visited Bristol and Birmingham this year, with Glasgow coming up later on this year, to help our members keep updated and informed of progress, particularly on regulatory matters. Indeed, we have travelled around the country, taking the Chairman of IPREG with us, to explain the new procedures. It is important that everyone in this country is aware of the big changes about to come.

Each year, we run successful international conferences, last year for the first time in Alicante, with Lisbon this year, and London next March.

For the future, we plan to run regular half-day seminars, to keep our members up to date on topical new procedures and practices, and new case law, as it comes up.

Developments in education

Furthermore, we are implementing a new education and training regime, with the help of universities, to ensure that our student members will be well equipped to face the complexities of the IP world, and all the changes which are coming up over the next few years. We hope that students who train under the new system will be at the forefront of the future UK profession, and will be seen by the world as well trained in IP in the UK and before OHIM and WIPO.

We hope to attract more members in the future, particularly those from overseas, who would benefit from the information and updates in practice and procedures we can provide.

I am proud to be part of ITMA at such an interesting time in its history.

AUTHOR

Maggie Ramage is a UK Trade Mark Attorney and a European Trade Mark Attorney. She is also a member of INTA, ECTA and MARQUES. Maggie has worked for the Californian-based Raychem Corporation, Beecham Group (now part of GlaxoSmithKline), and British Telecommunications. Maggie became a partner in Alexander Ramage Associates in 1991.
INDIA’S GEOGRAPHICAL INDICATIONS

Protecting traditionally-produced goods

Sunita K Sreedharan of SKS Law Associates explores India’s Geographic Indications

Geographical Indications (GI) occupy a unique position among the traditional and emerging intellectual property (IP) rights. One of the many features that distinguish GIs from other IP rights is the fact that they confer exclusive rights on the community to sell goods produced using traditional practices. Unlike other forms of IP rights which protect new creations of human intellect, the GIs protect traditional practices that are usually a function of the environment and the biodiversity inhabited by a group of people. GIs protect traditional practices that are always a function of the environment and the biodiversity inhabited by a group of people to earn their livelihood.

By virtue of this definition, it stands to reason that there is an abundance of GIs in the old world with developing economies rather than in the new world that are usually developed economies. Another important distinction that sets GIs apart from other IP rights such as patents, copyrights, trademarks and industrial designs is in the form of ownership. A GI is a community right in a regime that is mostly a blatant assertion of private right of exclusivity and ownership.

The global awakening

Until the latter quarter of the 20th century, recognition of traditionally-produced goods and wines was limited to a few items with powerful lobby to safeguard their trade interests. With the multi-lateral acceptance of the Agreement on the Trade related Aspects of Intellectual Property Rights (TRIPS Agreement) in the mid 1990’s, GIs were recognised as important IP rights significant to the trade and economy. Indirectly, it also leveraged the traditional knowledge and traditional communities or practices based on traditional knowledge to the position of a trade practice of significant economic value.

Defining GIs

One way of describing GI is by classifying the goods produced in broad categories based on the use by the consumer. A traditional knowledge traditionally practiced to produce goods that are evocative of its geographical origin may result in an agricultural produce or handicrafts or textiles or even food. Examples of such classification of protectable GIs could be:

• Agricultural produce such as Basmati rice, Alphonso mangoes, the various teas including the Darjeeling tea and the Nilgiri tea and the exotic spices including the cardamom, the black pepper and the turmeric.

• Handicrafts including Bidri stonework, Aranmula Kannadi or the polished metal mirror of Kerala, Silver Filigree work of Karimnagar

• Textiles including the Pochampally Ikat, Kanjeevaram silks, Pashmina shawls and ‘Chikan’ work of Lucknow

• Food and drinks prepared by way of distinctive practices such as the Cashew fen’ of Goa.

The TRIPS Agreement’s definition focusing on wines and spirits is a limiting definition. So unless a traditional community is well-organised with a very large corpus to lobby or fight to protect the trade-related aspects of the fruits of labour of the community there is very little authority afforded to the traditional community to protect its IPR.

The GI laws in India

India has learnt this the hard way in the Basmati case. India’s inability to prevent the misuse of the name Basmati, traditionally accorded to the fragrant long-grained rice harvested at the foothills of the Himalayas, in an international forum was the catalyst that pushed the enactment of the GI Act which came into force on 15th September 2003. The official name of the enacted law “The Geographical Indications of Goods (Protection and Registration) Act 1999”, explains the reason for its enactment.

Unlike other IPRs there is no creation of an intellectual property, but recognition of an existing right as an exclusive right. Traditional knowledge and traditional practices are often a function of a number of factors including the biodiversity, the socio-economic fabric and political exigencies of a sovereign state. For instance the migration of artisans whether it be under political patronage or due to a political upheaval would push the envelope with regard to survival and earning of livelihood.

Banning of the weaving and sale of the Shaltoosh shawl by the government under the Wildlife (Protection) Act of 1972 is a
case in point. The social concern for the Shahtoosh goat lead to the ban on the weaving and sale of the shawl made from the fine fleece of the Shahtoosh goat. The economic impact has been devastating having a direct impact on the livelihood of the Shahtoosh shawl weavers and trade.

The ban by the government took away the means of livelihood of entire traditional communities as well as the traders, forcing them to seek other forms of craft to eke out a living. Incidentally, a large number of the weavers have successfully transferred their fine skills to Pashmina weaving.

But like all other IPRs here too the overriding concern has been the effect of the creation of a right on the GI on trade. The elements of GI are basic and few:

GI is a community right used to identify agricultural, natural or manufactured goods that have been produced or processed or prepared in that territory.

The GI has been practiced traditionally and originates from a definite geographical territory. The GI must be evocative of a place in having a special quality or reputation.

**Trade off with Trademarks**

However there are a number of instances where the traditional knowledge is not necessarily confined to a geographical region as in the case of the Shahtoosh-Pashmina transition. The fine art of weaving both the Shahtoosh as well as the Pashmina are confined to the state of Kashmir and therefore the requirement of Geographical indication of a place is easily fulfilled.

There are other forms of traditional practices and skills that do not qualify for GI registration under the law since their practice is too widespread to have significant geographical indication of place. An case in point is that of the Bikaneri Bhujia, a tongue-tickling savoury of distinctive taste with a distinctive name purported to be of Bikaner, a city in the state of Rajasthan but too widespread to be registered as a GI practiced in Bikaner.

Is it then possible to protect these as collective marks under the Trade Marks Act 1999. Incidentally “collective rights” are the only other intellectual property that have a community right of ownership.

**Conclusion**

GI can become a very powerful competitive tool for the SMEs collectively involved in manufacturing and marketing of agricultural goods, foodstuff, handicrafts, traditional arts, etc. However, given that a majority of the GIs originate from the unorganised sector, the government has a very significant role to play in turning GIs into enduring brands.

**AUTHOR**

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New gTLDs – burden or benefit?

Katy Cullen of Walker Morris examines the potential benefits and drawbacks of new generic top-level domain names

The anniversary of the Institute of Trade Mark Attorneys is an opportunity to reflect on significant changes in the trademark world during its lifetime. One such change is the phenomenal growth of the internet and its impact on brand owners. It is difficult to imagine life before the internet. With an estimated 1.6 billion users worldwide, it forms an integral part of both commercial and social life and provides an unprecedented forum for instant communication on a global basis.

Although its origins lie with the US government, interest from the commercial world eventually followed and by the mid-1990s the internet economy had arrived. In order to navigate the vast amount of information available, an Internet Protocol (IP) addressing system was developed using strings of numbers. However as the number of users grew, a simpler Domain Name System was introduced and numerical addresses were transformed into user-friendly name-based addresses – suddenly 213.249.138.165 became walkermorris.com.

The Internet Corporation for Assigned Names and Numbers (ICANN) was established in 1998 to co-ordinate the internet’s naming system, including the management of generic top-level domains (gTLDs). Every domain name ends in a top-level domain e.g. .com, .org, .net. The second-level domain (SLD), appearing to the left of the top-level domain, is chosen by the applicant and is often linked to its name or brands e.g. walkermorris.com denotes the law firm of the same name.

It soon became apparent that domain names were a lucrative commodity which could be bought and sold at a profit and this presented a new challenge to brand owners. In the landmark case British Telecommunications Plc & Others v One in a Million Limited & Others ([1999] 1 ETMR 61), the defendant registered a number of domain names incorporating the names of high-profile UK companies, and sought to resell them to the brand owners. The domain names were not used, but their mere registration was held to be an ‘instrument of fraud’, and the defendants were forced to transfer the domain names to the respective companies of the same name.

With the continual rise of domain name disputes, brand owners sought a cost-effective alternative to court-based trademark litigation. An alternative dispute resolution (ADR) procedure evolved, culminating in the Uniform Domain Name Dispute Resolution Policy (UDRP) which came into force on 1 January 2000. The UDRP is an arbitration system which is mandatory for all ICANN accredited bodies through which domain names are registered. As at 31 July 2009, 18,754 UDRP decisions have been issued proving that it is the forum of choice for most domain name disputes.

Against this background, in June 2008, the ICANN board approved the introduction of new gTLDs. In 2008 there were approximately 174 million domain names worldwide, with the numbers steadily rising. In an effort to release space for further domain registrations, under ICANN’s proposals the number of gTLDs will be increased from 21 to an infinite number with the first round of registrations commencing in 2010.

ICANN is developing procedures to protect brand owners, which at the time of writing are yet to be finalised.

However amid this fear, could the new gTLDs create a link between domain names and brand names. This risks the proliferation of disputes, increased outlets for counterfeit goods and the ultimate breakdown of consumer trust. To allay these fears, following consultation with brand owners, ICANN is developing procedures to protect brand owners.

As the anniversary of ITMA passes, the trademark world awaits the introduction of new gTLDs with anticipation. Will they radically change how brands are used, perceived and policed on-line? Or will they simply prove to be the next ‘Millennium Bug’ – requiring a lot of preparation but with relatively little impact?

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With the potential registration of their brand names as new gTLDs, the internet looks set to become the Wild West of the trademark world unless robust procedures to protect earlier rights are put in place.

At the heart of these concerns lies the function of gTLDs and their public perception. Initially, gTLDs described the nature of the applicant e.g. .com denoted a commercial organisation. Although the rules have relaxed, to a large extent this link remains. Nominet, the organisation responsible for managing the .uk country code TLDs, produced a domain name industry report in 2008. It cited research carried out by Opinion Matters indicating that 72 per cent of British internet users will choose a .co.uk domain in preference to .com because “it says the information available on the website is local, relevant and most of all trusted”. However, as there are no restrictions on who can own a .co.uk domain, consumers are unwittingly purchasing sub-standard goods from parties based outside the UK seeking to exploit this trust.

It is inevitable that the adoption of brand gTLDs will create a link between domain names and brand names. This risks the proliferation of disputes, increased outlets for counterfeit goods and the ultimate breakdown of consumer trust. To allay these fears, following consultation with brand owners, ICANN is developing procedures to protect brand owners, which at the time of writing are yet to be finalised.

However amid this fear, could the new gTLDs create the ultimate indication of origin online? If a brand owner secures control of brand gTLDs, it can manage the registration of SLDs – thus creating a secure internet presence of authorised websites and instilling genuine consumer trust.

As the anniversary of ITMA passes, the trademark world awaits the introduction of new gTLDs with anticipation. Will they radically change how brands are used, perceived and policed on-line? Or will they simply prove to be the next ‘Millennium Bug’ – requiring a lot of preparation but with relatively little impact?

AUTHOR

Katy Cullen is head of trademarks and designs at Walker Morris
Excellence* in IP

*excellence (fr), die vorzüglichkeit (de), excelencia (es), eccellenza (it), perfectiune (ro), kitűnőség (hu), dokonalost (cz), excelência (pt), förträfflighet (se), doskonalost (pl), excellentie (nl), превъзходство (bg), odličnost (sl)

Trade marks  Designs
Trade names  Advertising
Trade dress  Copyright
Domain names  Know-how
Patents  Data Protection
Proposed changes to the Romanian law on trademarks

Dragos Vilau and Ionut Lupsa of Vilau & Mitel outline a recent amendment to Romania’s trademark law

Trademarks and geographical indications are protected in Romania based on Law no 84/1998 considered to be harmonised already with the «acquis communautaire» however even after Romania joined the EU in 2007, the Romanian legislation is still undergoing the process of harmonisation with the EU legislation.

The Romanian government made several attempts to harmonise the current law on trademarks by two drafts sent to the Romanian Parliament in July 2007 and June 2008 however none of these reached the final steps of the legislative process.

Following the adoption of the European Directive 2008/95/CE on 22 October 2008, the Romanian government sent a new and improved draft (“Amendment”) to the Romanian parliament, seeking to harmonise the Romanian Law on Trademarks with this latest EU Directive.

The Amendment will be considered an important milestone by Romanian IP practitioners since it simplifies the entire trademark prosecution procedure at the Romanian Patent and Trademark Office (RPTO) and radically shortens the deadlines.

The proposed changes in the Amendment in summary:

- Sounds and holograms are expressly mentioned as being capable of being registered as trademarks;
- Signs of high symbolic value (religious symbols, badges, emblems and escutcheons other than those covered by Article 6 ter of the Paris Convention) are specifically excluded from registration;
- The trademark applications will be published electronically seven days from filing;
- Relative ground of refusals can no longer be raised ex officio by RPTO;
- The deadline for filing oppositions was reduced to two months (instead of three months);
- The deadline for filing appeals with RPTO was reduced to 30 days (instead of three months);
- Opposition proceedings are finalised with a preliminary opinion mandatorily considered during the full examination by RPTO;
- Opposition proceedings can be suspended;
- Full examination of a trademark application should be made by RPTO within six months from publishing (or four months if an additional urgency is paid);
- The starting point for the five years regressive period is now expressly indicated as being the date of registration with the Trademark Register;
- The Amendment contains specific provisions in respect of the conflict between an earlier community trademark and a national trademark registered in Romania;
- The word “resemblance” was used instead of the traditional “similarity” (close resemblance) concept already used by current Romanian Law on Trademarks and the European Directive 2008/95/CE.

Eligibility for trademark registration

Although the current law on trademarks is not expressly mentioning that sounds (audible) are capable of being registered as trademarks, thus following the principles established by the former and current European Directives when defining a trademark, sounds, tri-dimensional, moving and positional trademarks were accepted for registration even before Romania ratified on 16 March 2009 the WIPO Singapore Treaty which expressly acknowledges tri-dimensional, holograms, moving and positional marks as well as the non-visible signs trademarks as being capable of registration.
Without abandoning the EU traditional trademark definition, the 2009 Amendment specifically extends the signs capable of being registered to holograms and audible however in the same time it extends the signs which cannot be registered to include signs of high symbolic value, in particular a religious symbol, badges, emblems and escutcheons other than those covered by Article 6 ter of the Paris Convention and which are of public interest, unless the consent of the competent authority to their registration has been given in conformity with the legislation of the Member State.

Simplified trademark prosecution

The most important changes contained by the 2009 Amendment are connected with the trademark prosecution process. The trademark applications will be published electronically within seven days from filing and will be subject to third parties oppositions on absolute or relative grounds of refusal within two months from publishing (the deadline for filing an opposition is under the current law on Trademarks of three months from publishing).

It is to be noted that RPTO is no longer able to examine relative grounds of refusal. Thus, provided there are no oppositions filed by third parties based on earlier rights, RPTO will proceed to the full examination of the trademark application within six months from publishing (this period can be reduced to four months by paying an additional urgency fee representing the registration and examination fee).

On the other hand, provided that oppositions are filed by third parties, RPTO is bound to communicate the opposition immediately (however no specific time frame was provided) to the applicant whose application publishing (the deadline for filing an opposition is under the current law on Trademarks of three months from publishing).

The opposition proceedings with RPTO can be suspended if the opposition was filed based on a pending trademark application or the opposed trademark is subject to a cancellation/revocation action.

Should any of the above suspension cases not subsist any longer, either the opponent or the applicant is able to continue the opposition proceedings.

One of the essential changes is that the opposition will be finalised with a preliminary opinion of the Opposition Committee within RPTO which will be mandatorily considered during the full examination by RPTO. Pursuant to the current Law on Trademarks the opposition proceedings are finalised with a decision which is subject to appeal in three months.

The Amendment states that on the applicant request, the opponent shall be required to present proof of effective and genuine use of its earlier trademark in the last five years preceding the opposed application publishing. This principle was applied until now during the opposition proceedings by RPTO in the absence of a specific provision in the Trademark Law, based exclusively on a rule contained by the Trademark Law Regulations no 855/1998 which led to debates on the validity of these Governing Rules.

RPTO is bound to finalise the full examination process within six months (or four months if the urgency fee was paid) and will then issue a registration decision which is immediately registered in the Trademark Register and published electronically within two months of the registration decision being issued.

RPTO’s decisions are subject to appeal either by the applicant within 30 days from receipt or from publishing in the case of appeals lodged by any other interested party.

Finally, the Amendment contains two important procedural provisions.

The first one is of huge importance. It establishes that the Bucharest Tribunal will judge all cases concerning Community Trademarks (CTMs), the second one – referring to the requirement that the trademark owner should be summoned in all cases involving trademarks makes sense only when appeals against RPTO decision are brought to court although summoning the trademark owners will lead to both an additional burden for the court and plaintiffs and to cases being delayed for longer periods of time as the summoning of international trademarks and CTMs owners proved to be a long and repetitive – sometimes unsuccessful – process.

Exhaustion of rights, licensing and assignment issues

The exhaustion of rights issue was disputed in case law, however only in isolated cases. While some courts took the view that the exhaustion of rights should be international, most of the courts embraced the EU Directive principle of the European exhaustion of rights.

The Amendment is now clearly opting for the Community exhaustion of rights and thus a trademark owner will not be able to prohibit the use of a trademark in relation to goods which have been put on the market in the Community by the proprietor or with his consent, unless there are legitimate reasons for the owner to oppose further commercialisation (ie. the condition of the goods is changed or impaired after they have been put on the market).

In respect of licensing, the Amendment is now clearly providing what was already retained as a matter of principle in the case law that the validity of a trademark registration or an intervention request in a counterfeiting action will not be affected by the absence of registering the license with RPTO.

In respect of trademark assignments, the Amendment is clearly stating that besides the assignment, a trademark can be transferred by way of inheritance and forced execution and now confirms the safe and long practice conducted by RPTO to suspend any transfer (including licensing) until a final decision is taken in connection with such contentious trademarks.

Finally, under the Amendment the licences and assignments will be opposable to third parties as of the date of publication by RPTO in the Official Intellectual Property Bulletin. Currently, the Law on Trademarks provides that licenses and assignments are opposable to third parties from the date of registration with the Trademark Registry.

Cancellation for non-use decrypted

The long-debated issue in the Romanian case-law on how the five years’ non-use period starting point was to be determined will soon become history. This issue was disputed for a long time both in doctrine and case law as a result of the current law on trademarks not specifically mentioning a starting point for the regressive period of five years.

This led to a series of contradictory decisions issued by first and second-level jurisdiction courts however eventually crystallised by the High Court of Cassation Justice who took the view that the five-year regressive period starts with the filing date since the applicant has both rights (ie. exclusive right to use) and obligations (ie. the effective and genuine use) attached to a trademark.

Although the Amendment will definitely change the case law once more, providing clearly the starting point for the five years’ regressive period as being the registration of the trademark with the Trademark Register (i.e. database) is more than welcomed.
**Registration of and conflict with CTM**

The Amendment dedicates an entire chapter to CTMs describing both the procedure for filing a CTM application with RPTO (who forwards the application to OHIM within two weeks of receipt) and transformation of a CTM in a national application based on the Council Regulation (EC) no 207/2009 provisions.

Moreover, the Amendment contains provisions with respect to solving the conflict between an earlier community trademark and a national trademark registered in Romania, stating that where the owner of the earlier community trademark registration has tolerated the use of the later national mark for a period of five successive years, either an invalidity claim or an opposition against the later mark shall be declared inadmissible in respect of the products and services for which it was tolerated, unless the later trademark was applied for in bad faith.

**Infringement of trademark rights and counterfeiting**

The Amendment fully harmonised its provisions with those of the European Directive 2008/95/CE providing that a trademark owner shall be entitled to prevent third parties not having his consent from using in the course of trade:

(a) a sign which is identical with the trademark in relation to goods or services which are identical with those for which a trademark is registered;

(b) a sign where, because of its identity with, or resemblance to, a trademark and the identity or similarity of the goods or services covered by the trademark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trademark.

(c) a sign which is identical with, or resembling to, a trademark in relation to goods or services which are not similar to those for which the trademark is registered, where the latter has acquired a reputation in Romania and where use of that sign without due cause would take unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark.

The rationale behind the use of the word “resemblance” instead of the traditional “similarity” concept already used by current Romanian Law on Trademarks and the European Directive 2008/95/CE is not clear. Some might say these are synonyms and there is really no difference between them while others might support the change and argue that the word resemblance seems to be closer to the Romanian language given its local etymology.

Nevertheless, a preliminary linguistic opinion revealed that “resemblance” seems a bit more permissive than “similarity”. In fact according to any English dictionary the word similar is defined as “closely resembling”. As a result, this change might lead to a radical change in the Romanian case law since the judge appears to have an easier task in determining if two signs resemble compared to the analysis made for establishing that two signs are closely resembling. The burden of proof will be easier for trademark proprietors however only time will tell if IP practitioners are more comfortable dealing with resemblances instead of similarity or will just continue to focus on the similarity concept.

In respect of counterfeiting, the part of the Amendment dealing with the incrimination of counterfeiting as an offence was not subject to a careful consideration and unfortunately in case this part of the Amendment will pass the entire legislative process as it is, case law debates around this issue will continue.

Firstly, for practical reasons it was preferable to define three distinct offences against a trademark instead of globally referring to counterfeiting in the cases of unlawful placement on the market of a product bearing an identical or similar mark with one registered for identical or similar products, or under a geographical indication suggesting that the product concerned originates from a geographical region other than its true region of origin with the intent of misleading the public as to the geographical origin of the product.

Secondly, we note that the provision introduces, as a criminal offence, the use of an identical or similar mark (and not of just a sign), which obviously perpetuates the same inadequate terminology used in the current law on trademarks. While this might help trademark proprietors in their fight against counterfeiters, maintaining a debate on the terminology might be in fact be a boomerang against them since this will continue to be speculated by counterfeiters in their defence.

Thirdly, when dealing with counterfeiting the Amendment is using both the similarity and resemblance concepts which might be either an indication that the text of this provision is not final or that there was really no clear intention of using a different word (i.e. resemblance instead of similarity).

However, in respect of counterfeiting, three other new provisions are more than welcomed:

- interim measures (such as the seizure of counterfeited goods and equipments used for such purposes) will be taken based on the criminal procedure which will not only be able to speed up the battle against counterfeiting but in the same time will reduce the costs borne right now by trademark proprietors

- in respect of conserving evidences, the trademark proprietor or a central authority can secure, obtain and conserve information and/or documents by way of interim measures

- abusive conduct of trademark proprietors is now expressly mentioned as leading to the court being able to order that plaintiffs should bear all damages incurred following an abusive conduct by a plaintiff, thus balancing the rights and duties of trademark proprietors.

The abrogation and as a result non-incrimination of counterfeiting as unfair competition according to the Amendment was only made for the purpose of having one enactment regulating this offence (i.e. the Law on Unfair Competition) and does not mean that the use of trademarks and geographical indications against loyal practices in industrial or commercial activity will no longer be considered an act of unfair competition.

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Anyone for lookalikes?

Tom Farrand of Harrison Goddard Foote takes a look at own-label and lookalike products

Take a large pitcher and fill it with ice. Mix one part well-known 175-year old brand with three parts economic downturn. Add some optimistic weather forecasts and a handful of traditional English summer events. (In tribute to the long-running Pimm’s advertising campaign.)

The news that Diageo has issued proceedings against Sainsbury’s (the UK’s second largest supermarket chain) seems to be the most interesting summer event in the world of trademarks. For those who missed it, this concerns Diageo’s Pimm’s brand and Sainsbury’s own-brand Pitcher’s, which has some rather similar features of label, get-up, bottle shape and colour, and is recommended to be mixed with lemonade and fruit. Is this just another battle between a major brand owner and a supermarket over lookalike products? Or is there more to this than Sainsbury’s stepping over Diageo’s line of what can be tolerated?

We’re told that here in the UK 38% of the groceries we buy are supermarket own-brand products and that this has risen to over 40% during the current economic downturn. With unemployment, and the fear of it rising, and with own-brand products typically 20% cheaper than branded products, the trend is likely to continue for a while at least. All of which presents an opportunity for supermarkets and justifies some serious investment in own-label product development.

The problem is that the own-label products are often deliberately designed to look like the branded equivalent. Not to confuse customers (obviously!), but to help them make an informed choice. The supermarkets can sail close to the wind because usually they are big customers of the brand owner who will be reluctant to object even if the supermarket has gone too far. But this has always been the way. Nothing new here surely?

L’Oreal case
Well perhaps. The extra ingredient in Diageo’s secret recipe could be the recent decision of the ECJ in the L’Oreal case, which was seen as a great victory for brand owners over imitators. Again, for those who missed it, that was a referral of various questions from the UK Court of Appeal to the ECJ. In particular this concerned smell-alike perfumes where the packaging, trademarks and general get-up “winked” at the brand owner. The case prompted a request for clarity on whether the defendants’ use of look-a-like packaging had taken unfair advantage of the reputation of the relevant L’Oreal marks even if it did not “jeopardise the essential function of the registered trademark as a guarantee of origin and does not harm the reputation of that mark, whether by tarnishment of its image or dilution or in any other way”.

Essentially, the answer was that if the defendant is “free-riding” on the back of a brand’s reputation then there is infringement even if the ultimate consumer is not confused.

When the ECJ judgement was published back in June I was wondering whether the confidence it might add would embolden brand owners sufficiently for them to have a go at the supermarkets. It could be coincidence, but the Diageo and Sainsbury’s spat has followed rather quickly.

I should not pre-judge things, and I do not know all the facts or the basis of Diageo’s claim, but it seems to have all the features of the L’Oreal case. We will await the outcome with interest.

I confess that I am instinctively inclined to side with the brand owner in these matters. I also recognise that it is not quite as simple as a supermarket taking advantage of all the hard work the brand owner has done in developing goodwill and reputation. Things are never quite so black and white.

As a spokesperson from Sainsbury’s pointed out, “customers are savvy enough to know what they are buying”. While there is plenty of evidence that customers think that own-brand products are made by the brand owners (often they are), customers also understand that no matter who makes the product, the supermarket is responsible for specifying the ingredients, quality and price. So you could well conclude that customers are not confused but are indeed making an informed decision between buying a higher-priced branded product with, say, superior ingredients, or a slightly cheaper version.

Global assessment
The ECJ’s L’Oreal judgement made it clear that there has to be a global assessment of the situation. In the case of supermarkets they are mostly carrying the branded product on their shelves, and usually more prominently displayed than their own brand product (although the brand owner may have to pay for that privilege).

There seems to be enough uncertainty in spite of the L’Oreal decision for the dilemma of brand owners to continue as to whether to sue their important customers the supermarkets.

I took one important message for trademark practitioners from the L’Oreal case. The ECJ judgement makes it pretty clear that there is some real value in registering the get-up, containers, labels, packaging etc. of a product as a trademark. You can only sue for infringement under s 10(3) (art. 5(2)) if you have a trademark registration. As a trademark practitioner who has sometimes been a little uncertain as to the real value of such registrations, this at least was a welcome aspect of the judgement.

The extra ingredient in Diageo’s secret recipe could be the recent decision of the ECJ in the L’Oreal case, which was seen as a great victory for brand owners over imitators.

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BUILDING BRIDGES™
Romania grants its first utility model

Doina F. Tuluca and Ana-Maria Baciu of Nestor Nestor explain Romania’s new utility model law

The first utility model granted in Romania was published on 30 June 2009 in the Official Bulletin of Industrial Property – Inventions Section no. 6/2009 under the title Internal combustion engine without crankshaft system (no. 2008 00009 U1).


Utility model protection covers any technical new invention having as object the shape or structure of a product, but not plant varieties or animal breeds, biological material, products consisting of chemical or pharmaceutical substance, processes or methods.

According to the Utility Models Law the computer programs per se may not be protected through registration as utility model. However, the Regulation for the Implementation of the Utility Models Law provides that programmable apparatuses, in which at the first sight the technical characteristics of the invention is carried out by means of a computer program, as well as the computer program products for data processing systems expressed by the logical running thereof, may form the subject of a utility model application.

The registration of a utility model is valid for six years from the filing date and may be renewed for two successive periods of two years each. The validity of the utility model may not exceed 10 years from the filing date.

The registered utility model confers to its owner an exclusive right of exploitation of the invention throughout its duration and the right to prohibit the third party to manufacture, use, offer for sale, sell or import the object of the invention protected through utility model.

According to the Utility Models Law, the utility model application and the patent application may be converted into each other, subject to certain conditions being fulfilled. Thus, a utility model applicant may request the conversion of the said utility model into a patent application, before the decision on registration is made. The applicant of a patent application may request the conversion of the application into a utility model application within three months from the date on which the Patent Office publishes the mention of the decision to grant the patent or to reject the patent application.

The utility model application must relate to a single invention. During the examination procedure it is verified if the subject matter of the invention is not excluded from the protection by utility model and if the invention is presented in manner sufficiently clear and complete a person skilled in the art to be able to carry it out.

The Patent Office does not examine the subject matter of the utility model application to assess if the conditions of being new, exceeding the framework of the mere professional skill or being industrially applicable are met.

Within six months from the filing date for the utility model applications complying with the requirements for granting the certificate, subject to payment of a fee by the applicant, the Patent Office prepares a search report mentioning the documents taken into consideration. Within two months from receipt of the search report,
the applicant may amend the claims of the application, by filing a new set of claims. In this case the Patent Office will not conduct an additional search report, or supplement the existing one.

The decision with respect to the registration of the utility model is made by an Examination Board within the Patent Office. The decision of registration is made subject to the legal requirements being fulfilled and the applicant having paid the fee for publication, issuing the certificate and maintenance of protection for the first six years.

The decisions of the Examination Board may only be appealed by the applicant. The Utility Model Law does not include a pre-grant opposition period for the third parties.

Decisions on utility models produce effects towards third parties from the date of the publication of their mention in the Official Bulletin of Industrial Property.

The registered utility model may be cancelled throughout its duration upon the request of an interested party, if the utility model does not meet the conditions for being granted. The cancellation procedure is ruled before a Reexamination Board within the Appeals Department of the Patent Office. That decision of the Reexamination Board may be appealed in front of the Bucharest Tribunal within 30 days from communication. The Tribunal’s decision may be appealed in front of the Bucharest Court of Appeal of within 15 days from communication.

Certain provisions of the Patent Law no. 64/1991 as republished – ie. provisions concerning definitions, the right to be granted a patent, filing and examination of a patent application, including priorities and withdrawal of application, rights conferred by a patent and corresponding obligations, as well as rights of prior use, transfer and defence of rights – are applied mutatis mutandis to utility models.

The official fee for filing a utility model application is €30 (if filed in hard copy) or €20 (if filed by electronic means), while the fee for conversion of a utility model application into a patent application is €100. The fee for publication of the utility model (including the maintenance fee for the first six years) is €400, while the renewal fee is €200 for the first renewal and of €300 for the second renewal.

The decision of registration is made subject to the legal requirements being fulfilled and the applicant having paid the fee for publication, issuing the certificate and maintenance of protection for the first six years.

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Lysaght & Co. – a familiar service in the strangest of places

Louise Audhlam-Gardiner and Caroline van Dijk of Lysaght outline the company’s international IP expertise

Lysaght & Co. is a well-established specialist in IP matters in developing countries around the world. This unique niche has been carved out over the past 63 years through Lysaght’s meticulous accumulation of know-how and experience in those jurisdictions that are unfamiliar to many applicants and their counsel.

By concentrating its efforts on scrutinising the laws in a wide range of far-flung and exotic jurisdictions, and by gaining a thorough understanding of their local customs and practice, Lysaght ensures that potential pitfalls are minimised or obviated, and that the registration of intellectual property rights is kept as simple as possible for the applicant. The volume of work which Lysaght processes in these countries has also made it possible to establish close partnerships and negotiate competitive prices with local associates.

In addition to working with local associates, Lysaght also has strong links with many Registries around the world, which have been built up through a history of filing applications directly with those Registries wherever allowable. Similarly, Lysaght is proud of its OAPI practice, which has been established over the past 30 years in an exclusive partnership with one of the leading practitioners in the Cameroon, Cabinet J. Ekeme. Through regular participation in the review and evolution of OAPI law and practice, an excellent working relationship has been forged with the OAPI officials.

Although the internet has facilitated communications with the developing world, and it is therefore increasingly simple for applicants to locate contacts for themselves in these jurisdictions, finding a professional-looking website does not necessarily guarantee that a quality service will be received. On the other hand, clients know that they can rely on Lysaght’s professional and responsive approach and that care will have been taken in its selection of local associates. This enables clients to use their own time more efficiently, by leaving them free to concentrate on their own areas of specialisation.

By virtue of their extensive experience in working in over 140 jurisdictions, Lysaght can also coordinate worldwide filing and recordal projects, and assist in filling any gaps in worldwide portfolios. This service includes the re-registration of UK registered patents and trademarks in the jurisdictions where this is possible.

Competitive charges can be negotiated, and using a “one-stop shop” is a cost-effective means for clients to obtain IP rights in a wide range of countries. In this way, Lysaght can serve as an extension to a company’s own IP department, to handle the filing, prosecution and renewal of that company’s rights worldwide.

While IP owners might consider that they can save money by omitting “low priority” jurisdictions from their registration portfolios, Lysaght’s experience shows that this short-sighted approach may in fact prove to be more costly in the long term. Failure to protect important brands in jurisdictions where rights are acquired by the first to register can prove extremely difficult and sometimes impossible to resolve. This is of particular significance in countries where local distributors are quick to register their suppliers’ trademarks, where counterfeiters and trademark pirates are rife, and where local laws may not recognise an applicant’s “bad faith” as a valid reason to cancel a trademark.

Lysaght’s expertise and know-how centres in particular around those areas of the world which are most pertinent to such issues of trade, commerce and counterfeiting. It is no coincidence that Lysaght has adapted and responded to the ever-changing IP environments, and it is this proactive and flexible approach which has kept Lysaght at the forefront of its niche market.

The detailed knowledge base and wealth of experience which Lysaght & Co. has accumulated enables them to provide a world-class IP service. Things are made easy, even in the most difficult of jurisdictions!

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AUTHORS

Louise Audhlam-Gardiner

Caroline van Dijk
Caroline graduated from Cambridge University in 1980, and was called to the Bar in 1981. She joined Lysaght & Co. in 1983 and became managing director in 1991. She recently retired from the Board of Directors and now works part-time. Caroline specialises in the laws of OAPI and French-speaking Africa.
A producer of consumer goods is unlikely to find a path beaten to his door in the absence of an expensive advertising campaign. However, in a competitive environment, every representation of a product or service is about what others are not. This gives rise to comparative advertising where one party advertises his goods or services by comparing them with the goods or services of his competitor.

The comparison is made with a view towards increasing the sales of the advertiser, either by suggesting that the advertiser’s product is of the same or a better quality to that of the compared product or by denigrating the quality of the compared product. This raises concerns over dividing a line between advertisements that are actionable and those which are not.

The Monopolies and Restrictive Trade Practices 1984 (MRTP Act), the Consumer Protection Act 1986 and the Trade Marks Act 1999 work in tandem to provide the basic structure that governs the law of Comparative Advertising.

The Trademarks Act 1999 has incorporated the provisions related to this concept in Ss. 29(8) and 30(1). Section 29(8) of the Trade Marks Act provides that a registered trademark is infringed by any advertising of that trademark if such advertising takes unfair advantage and is contrary to honest practices in industrial or commercial matters, is detrimental to its distinctive character, or is against the reputation of the trademark.

Section 30(1) has, however provided a limitation on this mandate, for what would otherwise have been an infringing act under Section 29, if the impugned use of the mark is in accordance with “honest practices” in industrial or commercial matters. However, there is no definition or explanation as to what constitutes “honest practices” under the Trademarks Act 1999.

Section 29A(4) of the MRTP Act limited comparative advertising by making any unfair method or unfair or deceptive practice which gives false or misleading facts disparaging the goods, services or trade of another person, an ‘unfair trade practice’. This definition has been adopted pari materia in the Consumer Protection Act, 1986.1

Considerations in deciding whether an advert is actionable
Does the defendant’s advertisement depict the plaintiff’s product or service?
Comparative claims may not explicitly name a competitor, they may implicitly refer to the competitor. Even though the brand name or the logo of a competitor may not be shown or blocked, an advertisement can still be actionable if they clearly indicate towards the competitor’s product by showing its colour, contours, the overall shape and packaging.2 This is because when an advertisement seeks to attract consumers to its product and away from other competing products, it is obvious that the advertisement targets those people also who are currently using the plaintiff’s product and are intimately aware of its look and so know its colour, shape, size, contour, packaging, bottling.

Consequently, the comparison must be from the perspective of an average person with imperfect recollection but that person must be picked from the category of users of the product allegedly sought to be disparaged or slandered.3

Generic disparagement of a rival product without specifically identifying or pinpointing the rival product is equally objectionable. No one can disparage a class or genre of a product within which a complaining plaintiff falls and raise a defence that the plaintiff has not been specifically identified.4 Even if the class of goods targeted by the defendant is not within which the plaintiff falls, but the public at large carry an impression, right or wrong, in their minds that plaintiff’s product belongs to the particular class and the defendant is aware of this, such an advertisement would still be actionable.5

Does the defendant’s advertisement disparage or denigrate the plaintiff’s product?
The term “disparagement” has not been defined in any statute, but judicial pronouncements have adopted its dictionary meaning.

Black’s Law Dictionary defines disparagement as “Matter which is intended by its publisher to be understood or which is reasonably understood to cast doubt upon the existence or extent of another’s property in land, chattels or intangible things or upon their quality” and “A falsehood that tends to disparage the goods or services of another party is actionable in a common law suit for disparagement.”

The Delhi High Court7 noted the New International Webster’s Comprehensive Dictionary and the Concise Oxford Dictionary definitions.

In order to estimate an issue of disparagement, the following factors are to be kept in mind, namely:

1) Intent of commercial
2) Manner of the commercial
3) Storyline of the commercial
4) The message sought to be conveyed by the commercial.

Of these factors, if the “manner of the commercial” ridicules or condemns the product of the competitor then it amounts to disparagement but if the manner is only to show one’s product as better or best without derogating the other’s product then that is not actionable.” Mere puffery of goods is not actionable. However by comparison the tradesman cannot slander nor defame the goods of the competitor nor can call it bad or inferior.”

Comparative advertising in India
Ameet Datta of Luthra & Luthra explains how Indian law differentiates free commercial speech from disparagement

Celebrating ITMA | 2009
The Calcutta High Court summarised the law on the subject in the matter of Reckitt & Colman v M.S. Ramachandran and another.

1. A tradesman is entitled to declare his goods to be the best in the world, even though the declaration is untrue.
2. He can also say that his goods are better than his competitor’s, even though such statement is untrue.
3. For the purpose of saying that his goods are the best in the world or his goods are better than his competitor’s, he can even compare the advantages of his goods over the goods of others.
4. He cannot, while saying his goods are better than his competitor’s, state that his competitor’s goods are bad. If he does, he defames his competitors and their goods, which is not permissible.
5. If there is no defamation to the goods or to the manufacturer of such goods, no action lies, but if there is such defamation an action lies and if an action lies for recovery of damages for defamation, then the court is also competent to grant an order of injunction restraining repetition of such defamation.

Consequently, in India a trader is entitled to make a statement that his goods are the best and make statements which may amount to puffery and the same will not give a cause of action to other traders or manufacturers of similar goods to institute proceedings as there is no disparagement or defamation to the goods of the manufacturer. However, a manufacturer is not entitled to say that his competitor’s goods are bad so as to puff and promote his goods. If an action lies for defamation an injunction may be granted.

However, if any trader is entitled to puff his own goods, such “puff” may involve the denigration of his rival’s goods. It is therefore difficult to adjudicate whether a trader is simply puffing goods or has crossed the line and disparaged another’s goods. Between the two extremes there is an extremely wide field and the test suggested is:

Whether a reasonable man would take the claim being made as being a serious claim or not. That is, whether a reasonable man would take the claim in the alleged slander seriously or dismiss it as advertising puff. If it is the former then, it is a case of disparagement and if it is the latter then, it is a case of mere puffery which is not actionable.

The publication of advertisements being free commercial speech is protected by

Article 19 (1) (a) of the Constitution of India. However this freedom may be subjected to reasonable restrictions which can be traced in the context of commercial speech or advertising in Article 36A of the MRTP Act and Section 2 (1) (r) of the Consumer Protection Act, 1986.

A trader has every right to market its product by claiming that its product is superior in quality, and has freedom of speech and expression. However, this does not permit a trader to cause damage or irreparable injury to the product of others. If the words used in an advertisement are intended to cause damage and loss to the product of another, the trader shall be restrained from issuing such advertisements.

Consequently, if a disparaging advertisement falls within the definition of the term “unfair trade practices” an action may lie before the Consumer Forum at the instance of a consumer or consumers or before a Civil Court at the instance of a manufacturer, marketer or a consumer.

Several important terms related to the concept of comparative advertising such as “disparagement” and “honest practices” are not defined in any legislation, and the dictionary meaning or judicial interpretations have to be used in ascertaining the meaning of these terms.

Although Indian law allows comparative advertisement, unfair trade practices or disparagement in a manner contrary to honest commercial practices are actionable.

As it stands today the law in India does not address the issue in a direct or comprehensive manner in any legislation finding its basis in the patchwork quilt of context specific legislations such as the Trade Marks Act, 1999, the Consumer Protection Act and (the erstwhile MRTP Act).

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Comparison: Fourth Edition, Volume 4

India: Comparative Advertising

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ITALY'S INDUSTRIAL PROPERTY CODE

Italian Industrial Property Code amended

Edith van den Eede and Julia Holden of Trevisan & Cuonzo Avvocati take a look at Italy’s reinforced protection for IP rights holders

On 29 July, Italian legislators enacted Law No 99 which entered into force on 13 August 2009 and amended, among others, the Italian Industrial Property legislation as well as provisions relating to IP criminal offences. The law also prepares the ground for the creation of a National Anti-Counterfeiting Board, to continue the work of the Anti-Counterfeiting High Commissioner – whose activities stopped at the end of last year following a change in government policy.

The main changes
In particular, as a consequence of the rephrasing of Article 134 IP Code establishing the procedural rules applicable to IP related cases, the competence of the specialist IP Courts appears to have been broadened. The scope of the new legislation will be better defined as case law develops and interprets its precise boundaries. The new provision has immediate application for proceedings pending at the date the law comes into force, unless in the meantime a decision on the competence in pending proceedings has already been taken.

In addition, Article 127, (1) IP Code, relating to the manufacture, distribution or sale, and production for profit, of products that infringe IP rights, has been deleted. In practice the provision – in a slightly re-worded version – re-appears in the new Article 517-ter of the Italian Criminal Code, which establishes that such activities are now punishable by imprisonment of up to 2 years and/or with a fine of up to €20,000 – compared to the previous rather limited fine of €1,092 under Art. 127 (1) IP Code.

Finally, an important change has been introduced by Article 239 IP Code which provides for limits to protection under copyright and design rules. This article was subject to intense controversy on a national and EU level and was already subject to modification in 2007 following the EU Commission's proceedings against Italy for its infringement of the Design Directive.

The new and revised Art. 239 relating to the protection granted to designs in accordance with the Italian Copyright Law states that copyright protection “does not apply to parties which, prior to 19 April 2001, started the production or commercialisation of products manufactured in accordance with designs that were in or had entered the public domain. In such cases this activity can be continued within the limits of the prior use. The manufacturing and commercialisation rights cannot be transferred separately from the company.”

One change already causing controversy is the introduction of the “prior use” limit, which could be interpreted as limited to both the territory in which prior to 2001 commercialisation took place and the exact products for which such commercialisation had commenced. At present, two references for a preliminary ruling from the Milan Court (Case C-219/09 and C-168/09) have been lodged before the ECJ.

Criminal penalties increased
The penal fine foreseen by amended Art. 473 of the Criminal Code (abbreviated to CC) for infringement of registered trademarks has been substantially increased to up to €25,000 (previously up to €2,065), while the fine for infringement of design and patent rights has been increased to up to €35,000.

Furthermore, for designs or patent infringements, imprisonment has been increased to a maximum of four years (instead of the previous maximum of three years, which remains the case for trademark infringement).

Penal sanctions have also increased for the trading of products under a false sign (Article 474 CC). In particular, the introduction into the Italian territory, for profit, of products traded under an infringing or altered registered trademark is now punishable with one to four years’ imprisonment (previously two years) and a fine increase from €5,500 to up to €35,000 (the previous limit was €2,065). The same provision provides for a fine of up to €20,000 and a maximum two-year prison sentence for stocking for sale or otherwise trading in the above infringing products.

The imprisonment term for the sale of products under false signs has been doubled to two years. This criminal offence is also punishable with a maximum fine of €20,000.

Furthermore, besides Art. 517-ter CC, another new criminal offence was introduced under Art. 517-quater CC, laying down a maximum two-year imprisonment and a fine up to €20,000 for the infringement or alteration of geographical indications and designations of origin on food products. This sanction is also applied for the importation or sale, for profit, of the same.

Unlike the Legislative Decree no 297/2004 providing for administrative sanctions on misleading use of protected geographical indications, this new criminal offence only relates to foodstuffs. In any event, this provision seems to be an improvement, although the interpretation by case law will better clarify the position here.

Finally, greater powers of seizure are granted to the police to tackle counterfeitters. The above legislative changes should provide for a more balanced set of rules and assist more effectively in the continued fight against counterfeiting in the Italian jurisdiction.

AUTHORS
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