

January 2010

We are pleased to welcome Zoë Gaye to Haseltine Lake

Zoë, an IP and Media Solicitor, specialises in:

- Intellectual property
- Advertising and marketing law
- Website content and domain name issues
- Terms and conditions for use in B2B and B2C contracts



Zoë has experience of various non-contentious IP issues including advertising and marketing, copy clearance, licensing transactions, website terms and conditions, and brand exploitation.

Prior to joining Haseltine Lake, Zoë trained as a solicitor at the international law firm Osborne Clarke and qualified in March 2007. Post-qualification Zoë was seconded to one of the world's largest computer and technology corporations where she supported the UK and EMEA marketing departments and provided UK-focused advertising law advice.

Media and entertainment (including sport and sponsorship) is a sector in which Zoë has particular interest and expertise, having worked for the BBC and a publishing company prior to becoming a solicitor. Zoë has a detailed knowledge of the media industry and the legal and commercial issues affecting it, and has advised on prize promotions, and terms and conditions for competitions. At the BBC, Zoë undertook work relating to program clearance, IP litigation and advised on general commercial terms and trade mark protection. In addition, Zoë has experience of drafting a wide range of media agreements, including the television production and distribution agreements for a major UK sporting event.

Zoë's experience in these areas dovetails neatly with Haseltine Lake's core IP work, and we are delighted to offer expertise in these closely related areas.

You can contact Zoë at zgaye@haseltinelake.com, or on (+44) 0117 9103200

Electronic registration certificates for CTMs

OHIM is no longer issuing printed trade mark registration certificates. The new electronic certificates will be available in pdf format; they should look the same as the previous paper certificates, and will have the same legal value.

Our aim is to reduce paper correspondence to a minimum, and we welcome this new practice at OHIM. We will continue to check registration details and report them to you, and to store them in our electronic records.

The PAGO decision – out of juice?

For a decision of such importance to Community trade mark owners, the decision of the European Court of Justice (ECJ) in this case was noticeably light in detail. The case concerned an appeal from the Austrian Supreme Court in relation to the PAGO fruit juice trade mark, which enjoys a significant reputation in Austria.



If the owner of a CTM can show that its trade mark has a reputation "in the Community", it enjoys significantly wider enforcement rights than in the case of a mark without a reputation. The key question is, what does "in the Community" mean:

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throughout the Community or, if not, what area of the Community? The Austrian court wanted to know if a reputation in Austria alone was enough.

Advocate General Sharpston's advisory opinion to the ECJ was that "in the Community" meant "in a substantial part of the territory of the Community" and that one member state did not constitute a "substantial part". She stated that the starting point must be the territory of the Community regardless of frontiers, and that an analysis which took into account national boundaries would lead to "*the (deeply invidious) question of what is a sufficiently important Member State to be considered to be 'substantial'.*"

The ECJ agreed with the definition given to the phrase "in the Community" but decided that you could not preclude one member state being a substantial part of the Community; you had to look at the facts of each case to determine if this was the case.

Although a number of observers have indicated that this now means that a reputation in one country is enough to establish a reputation in the Community, we doubt that this necessarily follows. Rather, you have to look at the nature of the trade in the goods or services under the mark and decide whether, in the circumstances of that trade, one member state is a substantial part of the Community market. If the market is regional (for example, equipment for a sport that is played predominantly in just one member state) a reputation in that member state would likely suffice. The PAGO trade mark had a reputation in Austria – a country with less than 2% of the EU's population – for fruit juice, a category of goods sold throughout the EU and for which Austria is not particularly known. The ECJ said a reputation in Austria "may be considered" sufficient and it is now left to the Austrian court to apply the rather Spartan guidance it has been given.

Haseltine Lake will open a branch office in The Hague, Netherlands in mid January 2010

The Hague branch office will be led by Michiel Cramwinkel and Achim Krebs, experienced European and Dutch patent attorneys who join Haseltine Lake from a global energy and petroleum organisation.

The Hague branch office will give us an important platform for augmenting our offering to European and international clients. The Hague is the main centre of European Patent Office activity after Munich, where we already have an established office, and a growing number of opposition hearings are being held in The Hague. As well as providing European and Dutch patent prosecution services, the office will provide IP strategy services including due diligence, IP mapping and portfolio reviews, and litigation support.

A HAPPY AND PROSPEROUS NEW YEAR TO ALL!

Jane More O'Ferrall

Partner – Bristol

UK and European Trade Mark Attorney
Email: janemof@haseltinelake.com

Zoë Gaye

IP & Media Solicitor – Bristol

Solicitor
Email: zgaye@haseltinelake.com

Corinna Hiscox

Attorney – Bristol

UK and European Trade Mark Attorney
Email: corinnah@haseltinelake.com

Martin Krause

Partner – Bristol

UK and European Trade Mark Attorney
Email: mkrause@haseltinelake.com

Elizabeth Lowe

Attorney – Bristol

UK and European Trade Mark Attorney
Email: elowe@haseltinelake.com

Michael Conway

Attorney-in-training – Bristol

Email: mconway@haseltinelake.com