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Amazon counterfeit problem, Richemont signs up with Alibaba, and branding turns into blanding: news digest

Every Tuesday and Friday, *WTR* presents a round-up of news, developments and insights from across the trademark sphere. In our latest edition, we look at how plain packaging has led to cigarette price increases, the Minnesota Vikings being mocked over a trademark application, the startup which prevailed in a trade dress battle, Trump reusing a notorious Game of Thrones inspired poster, and much more. Coverage this time from Trevor Little (TL), Bridget Diakun (BD) and Tim Lince (TJL).

Market radar:

Richemont signs up to Alibaba's IP Alliance – Alibaba has [announced](#) that luxury group Richemont has joined the [Alibaba Anti-Counterfeiting Alliance \(AACA\)](#), a partnership between the e-commerce giant and brands that works to protect intellectual property rights on the company's platforms. The partnership brings the number of participants to 115, from 16 countries. Alibaba notes that participants work together in six areas – online monitoring and protection, a product test-buy program, offline investigations and enforcement actions, industry-law enforcement workshops, litigation tactics and public awareness campaigns. As part of the announcement, Michael Yao, Alibaba's senior vice president and head of brand protection and cooperation, declared: "The protection of intellectual property rights requires all stakeholders to work closely together and share their expertise. The AACA will continue its efforts to establish industry best practices for IP protection by creating effective collaboration among brands, platforms and law enforcement." (TL)

Plain packaging leads to increase in cigarette pricing – According to an article [in The Guardian](#), the introduction of plain packaging on tobacco products in the UK has led to "an increase in the sale price of leading brands". Based on a study from Stirling University, it has been found that the price of the most popular cigarette brands has increased by nearly 5% in the 18 months since the legislation was implemented. This finding, the researchers say, "were at odds with tobacco companies' predictions that plain packaging would lead to lower prices and greater affordability", adding: "Tobacco companies were strongly opposed to plain packaging. They appeared adamant that, if the policy was implemented, brands would only be able to compete on price, which would result in lower prices, greater affordability and, consequently, increased consumption." (TJL)

Minnesota Vikings mocked over trademark application – It's the business end of the NFL season, with Wild Card weekend about to commence. One team that didn't make the playoffs – crashing out of contention after a week 17 loss to the Chicago Bears – was the Minnesota Vikings. However, IP expert Josh Gerben

picked up on the team's application for the BRING IT ALL mark just days before that ill-fated game. His spot sparked mockery on Twitter, one fan suggesting "I am filing a trademark application [for] "don't spend 84 million dollars on a QB with a reputation for folding in big games". Meanwhile, other news outlets then reported on how the team was "being laughed at" over the application. Of course, the application is a legitimate one and it is wholly responsible to seek protection around planned slogans and campaigns. In this instance, the mirth is related to the timing. Had the application been filed before the season – in anticipation of great things to come – it would likely have gone unnoticed. In other NFL trademark-related news, Miami Dolphins safety Minkah Fitzpatrick has been sent an office action request from the USPTO in relation to his application for the FITZMAGIC mark. The request notes that the application has been refused because "because the applied-for mark consists of or includes matter which may falsely suggest a connection with [Tampa Bay Buccaneers quarterback] Ryan Fitzpatrick". While refused, the ball has been punted back to Fitzpatrick, who must now decide whether to respond. (TL)

Counterfeits on Amazon "still a huge problem" – A widely-shared article [on FStoppers](#) has looked at numerous reports of the problem of fake SD cards being sold on Amazon. One of the brands most affected by this issue is SanDisk, according to the article, with countless comments [on Reddit](#) recently of users receiving fake photography equipment from Amazon over Christmas. "What is going on with Amazon and fake photography gear?" one user asked. "How are they not pulling stuff off there MONTHS after they are reported as fake?" We've [written extensively](#) about growing calls for Amazon to tackle its counterfeit problem – but it appears that, even when it comes to products in its own warehouses, the issue remains significant. (TJL)

Legal radar:

Startup wins trade dress battle – Handbag and accessories designer Oliver Thomas has announced victory in a case brought earlier this year by MZ Wallace Inc over the right to use a diamond quilted pattern on handbags. MZ Wallace brought the action based on the pattern used in its tote bags but, following a full trial, the United States District Court in Manhattan found that the company "has no protectable trade dress rights", having "utterly failed to show that the definition of its trade dress on which it settled just this year has achieved secondary meaning". Judge Cote also criticised MZ Wallace's "unsavory" business practices, such as encouraging its employees and family members to post accusations that Oliver Thomas bags are "counterfeit and knockoff goods" on the company's social media channels and using "threatening and disparaging language directed at Oliver Thomas representatives at a trade show". Reflecting on the decision, David H Bernstein of [Debevoise & Plimpton](#), which represented Oliver Thomas, stated: "We were delighted that the court recognized that Oliver Thomas has every right to sell its functional and stylish products in the marketplace. No company has the right to monopolize commonly used, functional features like diamond quilted patterns on handbags, which have been used by fashion companies on handbags for decades. We are also pleased the court concluded that Oliver Thomas' distinctive bags are causing no confusion in the marketplace." (TL)

Amendments to the Trademark Act in the Czech Republic and Slovakia – The [EU-directive-based amendments](#) will come into force in the Czech Republic and Slovakia on the first and 14th of January respectively. A number of changes will follow, but the most important for brand owners is that these Industrial Property Offices will no longer, *ex officio*, refuse new applications which are identical to earlier marks. This will effect unpublished applications filed before the amendment, as well as those filed after it comes into force. As individuals will now be able to register marks which match previous ones without the brand owner knowing, it is crucial for rights holders to regularly monitor new applications to oppose marks which are conflicting, as they only have three months to take action. (BD)

Media watch:

Amazon ‘brand bidding’ article claims dismissed – On [its blog](#), brand protection company Brand Verity has dismissed [a recent BuzzFeed article](#) which claims that Amazon had “engaged in a targeted strategy to aggressively bid on competitors’ branded terms over the Black Friday to Cyber Monday period”. According to the company, the article claims that Amazon’s brand bidding rate over Black Friday weekend came to 182.18%, meaning “an Amazon ad was 1.8 times more likely to appear on a competitor’s brand term – Wayfair, Walmart, Macy’s – than in searches for Amazon itself”. However, such a claim is misleading, says BrandVerity, and Amazon’s bidding on Google keywords tends to be for brands that it sells. “We had limited monitoring (4 times a day) set up over the Black Friday-Cyber Monday weekend across 250 popular brands in 10 industries, and didn’t find any evidence to suggest that Amazon was pursuing an aggressive competitive brand bidding strategy during this time,” they added. (TJL)

Every brand logo “looks the same now” – According to an article [in Quartz](#), the historic trend of distinctive logos is a thing of the past, with 2019 expected to see “branding turn into blanding”. The reason for this is that companies are seeking stronger trademark protection. “By making the plain language of a logo – the name or word – the basis for a trademark, instead of a unique font or color in combination with a specific word or name, brands may be able to better protect their intellectual property,” the article states. One example given was Burberry, which recently changed its century-old mark (featuring a knight on a horse) into a more simple text mark. “A less generous assessment of the minimalist trend is that fashion brands may just be getting less creative and more formulaically corporate,” the article adds, but if such logos lead to trademarks that can be more easily enforced, then – at least on the face of it – it appears to be something worth considering. (TJL)

Trump reuses contentious *Game of Thrones* poster – Earlier this week, US President Donald Trump brought back a notorious *Game of Thrones*-inspired image of himself with the phrase “sanctions are coming”. Rather than posted on Twitter, as it was last November, the image was blown up into a poster and taken to a cabinet meeting. According [to RT](#), the poster’s appearance “has journalists, pundits, and the twitterati confused” as it refers to sanctions from last year. As [we reported back then](#), HBO’s response to Trump’s initial tweeting of the image was effective in avoiding controversy. Just over two hours after Trump’s tweet unleashed the social media storm, HBO’s Twitter account [responded by asking](#), “How do you say trademark misuse in Dothraki?” – referring to the fictional language used in the show (and book series). It’s unlikely HBO will respond to Trump’s poster stunt, but it’s interesting that the US President has ignored (or was unaware) that the poster had caused controversy over its potential trademark misuse. Alternatively, he is aware and is confident that HBO will not pursue legal action despite unhappiness over its use. (TJL)

Domain radar:

Warning over ‘.eu’ domains – Over on *Domain Incite*, Kevin Murphy has [reported](#) on [guidance](#) issued by the UK’s Department for Culture, Media and Sport, which encourages UK individuals and companies to check their eligibility to hold onto previously registered ‘.eu’ domains post-Brexit (the string restricted to natural persons who reside in, or have their registered office or principal place of business within, the European community. The UK government observes: “If you currently hold a ‘.eu’ registration and the related purchase agreement expires before 29 March 2019, the date of the UK’s exit from the EU, it is suggested that you discuss whether you should consider transferring your registration to another top level domain with your local domain name registrar.” (TL)

On the move:

US firm announces new directors – [Sterne, Kessler, Goldstein & Fox](#) has announced the election of six new directors – Ryan C. Richardson, Daniel S Block, Richard M Bemben, Lestin L Kenton Jr, Pauline M Pelletier, and Jason A Fitzsimmons. Block is a director in the firm's electronics practice group, and his practice primarily focuses on patent and anti-counterfeiting litigation at the International Trade Commission and in federal district court, while Bemben is a co-leader of the firm's fintech and blockchain technology industry initiative. (TL)

Hogan Lovells announces promotions – Hogan Lovells has promoted 30 lawyers to the partnership and 47 to counsel, effective 1 January 2019. Four of the partner promotions were in the intellectual property practice - Katie McConnell (in the London office), Stephan Neuhaus (Düsseldorf), Martin Pflüger (Munich) and Christian Tinnefeld (Hamburg). A further six IP specialists were promoted to counsel. The full list is available [here](#). (TL)

Cooley adds partner – [Cooley](#) has expanded its intellectual property team with the addition of Charlie Winckworth, who joins in London as a partner. Winckworth advises global clients on the strategic aspects of obtaining, protecting and commercialising intellectual property rights as well as enforcing them and taking other practical steps to prevent misuse. (TL)

Friday catch-up:

Every Friday in our news round-up we will provide a quick rundown of the latest news, analysis and intelligence posted on *World Trademark Review*. Over the past week (which was shorter than usual due to the seasonal break) we:

- Published [an exclusive](#) year-end review from the UK Intellectual Property Office (UKIPO) on its activities in 2018 and upcoming developments in the coming year – including, of course, Brexit;
- As we entered 2019, we took [a detailed look](#) into the issues and trends that trademark professionals can expect to make headlines in the coming 12 months;
- Sat down with Sandvik AB's trademark and brand protection lead Charlotte Falck, [who explained](#) how she uses interactions with commercial colleagues to create business matrix ratings in a bid to identify enforcement priorities;
- Looked at [a recently launched](#) gambling website, called MysteryBrand, which uses branded products to promote randomised 'mystery boxes', and could be in breach of several laws and should be on the radar of trademark counsel according to legal experts we spoke with;
- Studied new data [which revealed](#) that 4,017 trademark litigation actions were filed in the United States in 2018 – and that, after a near decade of decline, it appears that litigation levels are stabilising in the country;
- Took a look [at the trends](#) which have characterised the trademark landscape in 2018, and discuss what is to come in 2019.

And finally...

Obtain high-level trademark management and brand protection insights – *WTR* is hosting two events, on consecutive days, in Chicago in March 2019. The [Brand Protection Online: Strategies for Ethical Enforcement](#) and [Managing Trademark Assets USA](#) events will deliver high-level insight and practical

takeaways for those tasked with managing, protecting and monetising brands. On 5 March 2019, [Brand Protection Online](#) event will take [a deep dive](#) into practical strategies for fighting infringement on ecommerce sites, navigating the changing domain landscape and managing reputation online. Taking place at the same venue the next day, the fourth annual [Managing Trademark Assets USA](#) will again focus on the cost-effective management of international portfolios, and comes at a time when it is more important than ever for brand owners to ensure they are integrating innovative and disruptive strategies into their trademark operations. To register for Brand Protection Online (or both events) click [here](#). To register for Managing Trademark Assets USA (or both events) click [here](#). (TL)



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