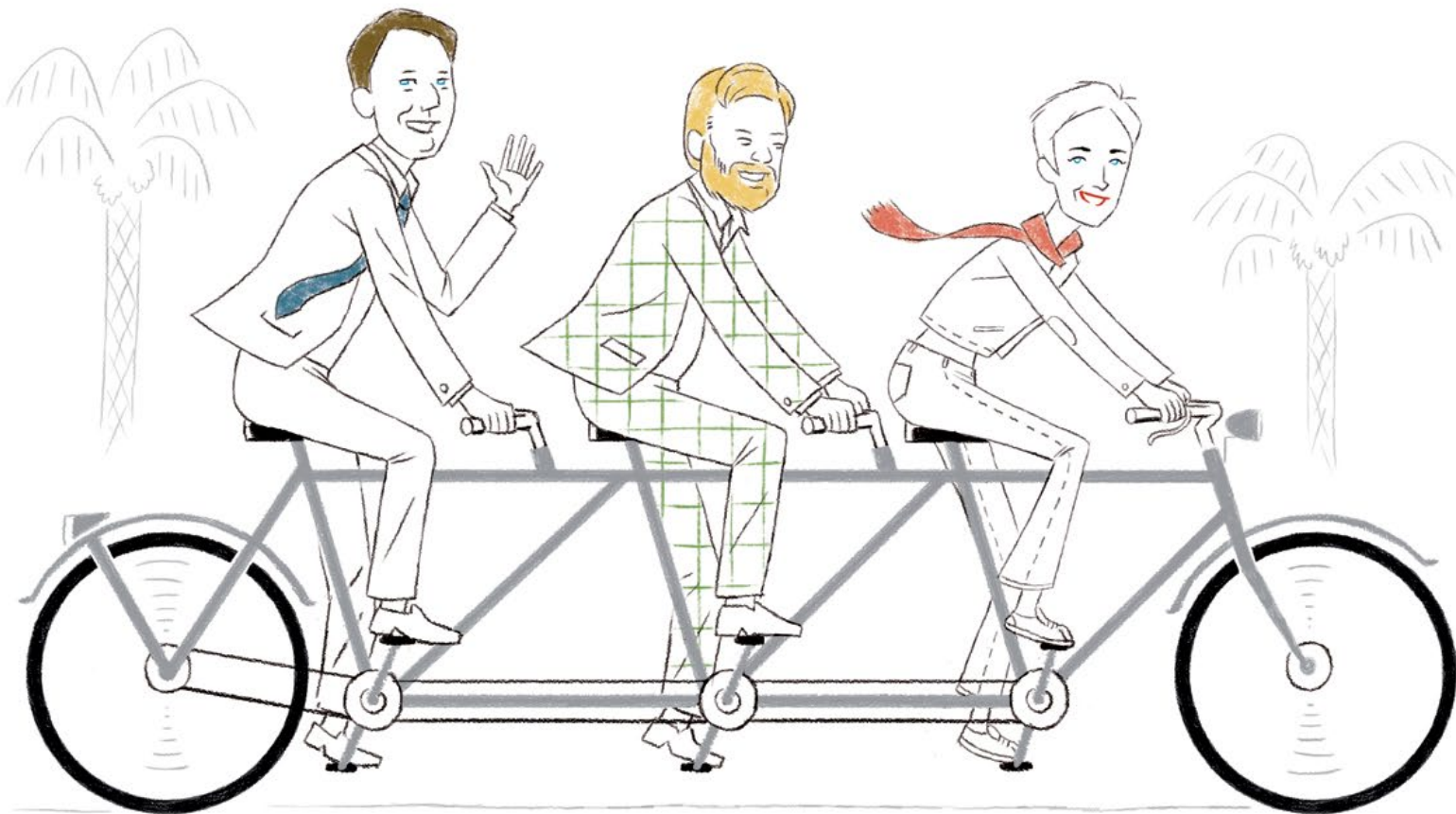




THE
GLOBAL IP
AWARDS

Key Insights from
IP Leaders **2020**

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bomhardIP

BomhardIP is an Intellectual Property boutique based in Alicante, Spain - the home of the EU trademark system - specializing in the registration and enforcement of EU trademarks and designs.

Our attorneys from seven different jurisdictions draw from many years of experience gained in highly renowned IP teams of major international law firms. Our streamlined structure enables us to provide legally sound, commercially oriented and cost effective solutions that make our clients' lives easier.

Specialists in

EU trademarks and Community designs

Appeals before the General Court and Court of Justice

Spanish IP services including EU trademark litigation

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**Spain Trademark Prosecution
Firm of the Year**

BOMHARDIP



Spain Trademark Prosecution Firm of the Year

BOMHARDIP

By Verena von Bomhard, Giles Corbally
and Johannes Fuhrmann

Q: Can you tell us about your trademark practice team (eg, size, practice focuses and key individuals)?

A: BomhardIP is a law firm specialising in trademarks and designs. With attorneys from seven different jurisdictions and a team of multilingual paralegals, the firm provides high-level EU IP services to multinational clients, with a focus on EU trademarks and designs, pan-European brand protection and enforcement strategies, alternative dispute resolution and multi-jurisdictional clearance searches. The three partners at the firm – Verena von Bomhard, Giles Corbally and Johannes Fuhrmann – together have more than 50 years' experience of offering highly specialised advice and assistance in EU trademark and design matters.

In less than five years, BomhardIP has received widespread recognition as a leading firm in the trademark field with a specialisation in EU marks. It was ranked silver in the *WTR 1000* 2018 and

2019. Further, it was awarded *Managing Intellectual Property Firm of the Year 2018 and 2019* for trademark prosecution, Spain and has been shortlisted for the same award in 2020.

Q: From a firm perspective, what was your highlight of 2019?

A: No longer being the new kid on the block and continuing to solidify our position as a leading firm in the EU trademark field. Taking on the management of the global trademark portfolios of three large entities (active in the restaurant and nightclub, transportation and toys and games sectors), including all clearance work and trademark dispute resolution work before the EUIPO, and coordinating this work around the world is particularly noteworthy from a volume perspective.

We also enjoyed continuing to work and advise on three Court of Justice of the European Union (CJEU) cases (including one preliminary reference case) and four General Court cases throughout 2019. The firm's members have handled 100 proceedings before the EU courts in Luxembourg, including seven before the CJEU, making us one of few real specialists in this area.

Of course, being nominated for and winning the Global IP Award for Spain Trademark Prosecution Firm of the Year 2020 has been another highlight. Although we are in the Spanish category for our location (Alicante being the home of the EUIPO), we consider this award to be a real reflection of our expertise in the EU trademark field.

Q: What has been the key to your team's success?

A: All our attorneys and paralegals draw from many years of experience gained as members of highly renowned IP teams at major international law firms. The combination of professional expertise with the lean and transparent structure of the boutique firm works to the client's advantage and guarantees direct, high-quality advice from experienced practitioners.

Q: How does your team keep abreast of the latest legal developments in the trademark world?

A: Our professionals are active members of several IP associations, including INTA, MARQUES, the European Communities Trademark Association (ECTA), the Pharmaceutical Trademarks Group, the German Association for the Protection of Intellectual Property (GRUR) and the Asian Patent Attorneys Association.



Verena von Bomhard, partner



Giles Corbally, partner



Johannes Fuhrmann, partner

They are also authors and editors of various articles and legal compendium blogs, and closely follow and participate in the development of the law. Dr von Bomhard serves on the INTA Trademark Reporter Committee, is a member of GRUR's Expert Committee for Trademark and Competition Law and is primary editor of the Kluwer Trademark Blog. Mr Corbally is a member of the INTA Legislation and Regulation Committee and the ECTA Publications Committee, and represents ECTA in the EUIPO Convergence Programme. He is also on the EU advisory board for global trademark search provider Corsearch. Dr Fuhrmann is an active member of INTA's Trademark Offices Practice Committee and the MARQUES European Trademark Law and Practice Team.

Q: What challenges are being raised by clients most frequently at the moment?

A: The MONOPOLY decision of the EUIPO Board of Appeal and the *Skykick* case before the CJEU have led to some uncertainty among trademark owners. There have been many doubts with regard to the possible vulnerability of re-filed marks and trademarks with wide specifications. The CJEU's judgment in the latter case has gone some way to alleviate concerns; however, it has not resolved them entirely. These decisions will still have an effect on the general trademark filing strategies of some of our clients. The other evergreen issue is of course Brexit and its impact on trademarks and their validity and enforcement going forward, as well as filing strategies.

Q: The firm is relatively young. What have been the key factors in successfully building its reputation and scaling up in such a short timeframe?

A: Our multilingual and multi-jurisdictional approach combined with strong partnership involvement is something that our clients appreciate when we support them in EU and worldwide trademark matters. In addition, given our set up in Alicante, the home of the EUIPO, and considering that Dr von Bomhard has been involved in EUIPO proceedings since the office opened its doors 25 years ago, few other law firms can match our experience in EUIPO matters or in handling cases before the Luxembourg courts.

Q: Over the past few years, there has been a swathe of changes to practice as a result of the EU trademark reforms. What impact have these had on your team and its strategic approach to trademarks?

A: The EU trademark reforms have brought a lot of positive changes and developments. We would highlight, for EUIPO proceedings, a certain alleviation with regard to formalities in filing submissions – in particular, translation requirements – and for national proceedings, the move towards administrative revocation and invalidity proceedings before national offices, rather than full-fledged litigation before national courts. We are looking forward to these changes finally being transposed into all national laws and practices.

Q: What are the main IP challenges facing rights holders in Europe?

A: People probably expect us to say Brexit but actually, given the proactive approach taken by both the EUIPO and the UK Intellectual Property Office (and corresponding legislator), the impact on trademark owners should not be too great and the situation appears relatively clear.

On the other hand, while trademark law is harmonised in the European Union, there are still local differences in practice. Some national offices or courts continue to maintain national practices that disregard CJEU case law. This concerns, for example, the question of whether a plaintiff can obtain an injunction against use of a sign for which the infringer holds registered rights. There is clear CJEU case law that having a registration is no excuse for infringement, but in some countries, offices and courts will not grant an injunction unless the registration is cancelled. This is frustrating for IP owners and difficult to explain to clients.

“There should be default judgments against parties that show no interest in making their case”

Q: What do you think are the big trends to affect trademark professionals over the next few years?

A: AI is certainly something that will add value to the trademark world. We do not believe that AI can replace the assessment of a well-trained lawyer, but it will affect how we conduct trademark clearance in the future and could allow us to predict the outcome of cases more precisely. That said, the art of legal practice lies in beating statistics and reaching an unexpected result through creativity – something that AI is unlikely to achieve any time soon.

Q: Finally, if you could make one change to the trademark world, what would it be?

A: We would place greater emphasis on legitimate interest considerations compared to the letter of the law. This goes beyond *Arnold LJ v CJEU in Skykick*. For example, in EUIPO proceedings, there should be default judgments against parties that show no interest in making their case. Where someone has filed a mark and never put it to use, so that it is cancelled, they should not be entitled to any rights deriving from the former registration. The attorney general in Case C-622/18 saw that differently, based on the letter of the law. We would prefer for there to be more commercial reasoning behind trademark decisions and policies.

The second thing is less systematic but immensely practical: significantly raising the reimbursable costs in EUIPO proceedings. Parties are often unwilling to engage in settlement negotiations and there is no financial incentive to settle rather than fight. In addition, the reimbursable costs bear no relation to the real costs in EUIPO proceedings.

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