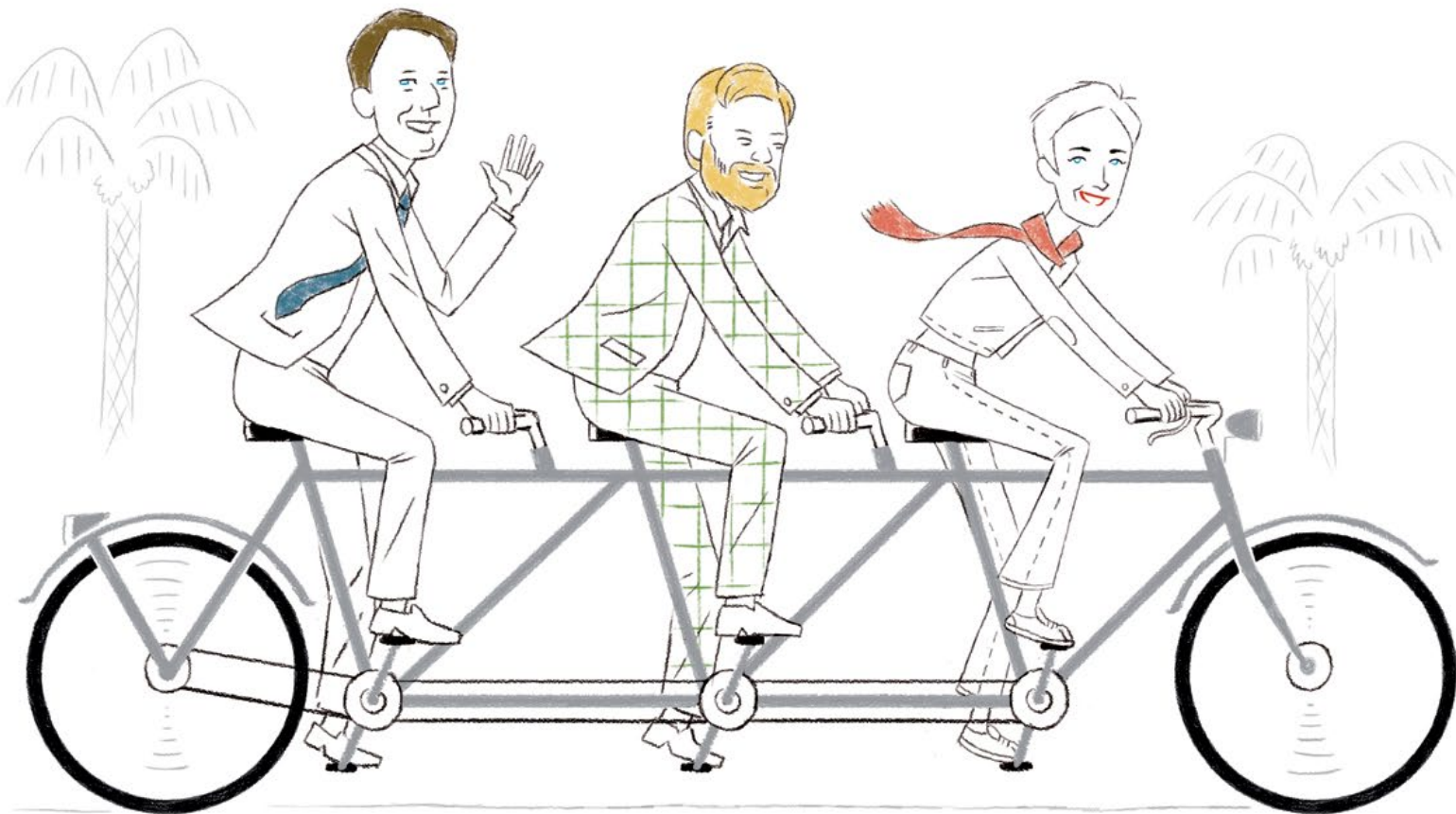




THE
GLOBAL IP
AWARDS

Key Insights from
IP Leaders **2020**

Presented by **iam** and **WTR**



Big firm **vision** • Small firm **efficiency** • Excellence with **passion**

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

THE **GLOBAL IP** AWARDS

Presented by **iam** and **WTR**[™]

**Spain Trademark Prosecution
Firm of the Year**

BOMHARDIP



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.

The logo for BomhardIP, featuring the word "bomhard" in a blue, lowercase, sans-serif font, followed by "IP" in a larger, orange, uppercase, sans-serif font.