

# OHIM

**The Trade Marks and Designs Registration Office of the European Union**

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## The James Nurton Interview

This month Annick Mottet Haugaard takes over as president of ECTA. James Nurton spoke to her about anti-counterfeiting, the study into the European trade mark system and the need for higher-quality decisions from the courts.

### How did you become involved in trade marks?

I was a criminal lawyer at the beginning of my career, after studying law at the University of Liège and at the College of Europe in Bruges. While I was working in a Belgo-Dutch law firm, a colleague left and gave me two files in counterfeiting matters for the Swiss watch industry. After that I got involved in a lot of infringement actions and then a big case in Brussels. I have worked on a lot of counterfeiting matters and enforcement action plans for the luxury goods industry, as well as the automotive and pharmaceutical industries. In Belgium there was a huge counterfeiting problem in the Antwerp diamond-trading district. It can be very interesting – I had a raid once with 80 policemen!

I also became involved in a very important case against a Cuban company involving a geographical indication, which lasted 10 years. It involved all the issues you can imagine. That was a very interesting experience and brought me more into the trade mark area.

### What kind of work do you do now?

I'm an IP litigator, so am involved in all IP-related litigation. That includes distribution, franchising, advertisements and other work. I don't do filing of trade marks but as the Benelux office is quite restrictive there are a lot of provisional refusals to work on. I also do a lot of classical trade mark opposition and infringement cases, mostly for international clients in Belgium.

I work with six lawyers, and it is quite a young but well-qualified team. We cover everything including the criminal aspects and try to take a pragmatic approach: clients want to do business not litigate. It is important to be cost-effective.

### How has anti-counterfeiting work changed?

Before it was just about stopping big containers at the port at Antwerp or at Zaventem airport. But with the explosion of e-commerce the number of files has increased. It's more difficult now as many of the counterfeit goods are not shipped in bulk but instead as micro-shipments.

I try to convince my clients to tackle the consumers and encourage them not to participate in criminal acts. It is important to systematically send cease-and-desist letters to make consumers understand and to train them.

But you have to train the authorities too. Within Europe the importance of IP is accepted, and it is understood that innovation increases competitiveness. It is good that the European Commission and the relevant authorities understand the value of protecting innovation.

### What does your role at ECTA involve?

ECTA has about 1500 members, mostly European trade mark practitioners, from both industry and private practice. As we represent a lot of attorneys, we focus a lot on SMEs. But we try to have a balanced view between the different users.

I've been involved with ECTA for almost 10 years. I attended a meeting in Helsinki and found it very interesting. All our members have a common intellectual interest in promoting the IP system.

I was co-opted four years ago and I take over as president this month. So I have spent the last four years watching and learning – I have a lot to learn particularly on the prosecution side.

### What are your priorities as president?

One of my main tasks will be to follow the study into the trade mark system in Europe, and be proactive. ECTA was created before the CTM was established, so this year is our 30 th anniversary. It is important that we continue to improve the system.

**How do you think the system works?**

It is a very efficient, simple, flexible and affordable system. The enlargement of the EU has posed new challenges, and the burden of the cost has been pushed back in the process. A company may have to wait many months before getting a registration, but today's businesses need to make decisions more quickly. In the US, by contrast, the burden comes earlier. That means it is more expensive at the beginning – but in the EU you have lots of opposition and cancellation actions. Maybe we can reduce these costs.

We have three priorities for the study: first, update the system to make it more efficient; second, increase uniformity by addressing discrepancies in the directive and regulation and going further in harmonisation; and third make sure it remains user-friendly.

We have already sent a 50-page statement to the Max Planck Institute including comprehensive replies to all the questions in the tender and we are proceeding with a complementary note on OHIM's contribution and the most vital issues.

What is important is to find a balance in some areas. For example, genuine use and territoriality is a sensitive question. But you have to make a deep analysis and think about the implications of the decision – and not jump in one direction. If you move one piece of the puzzle, you have to be sure it's still consistent and balanced.

Once in a while, it's always good to sit down and have a look at what's going on. With the economic challenges and EU enlargement, there are new things to consider. But you have to be careful not to complicate the system. For example, the Court of Justice of the EU can complicate things that could be simple. Where there are options in the directive, there has sometimes been discrepancy at the CJ.

It is also important to take into account the interaction with other systems. ECTA has organised some benchmarking with the US and also roundtables with national offices. It is important to see if we can improve the CTM system through national experiences and vice versa.

**What else is ECTA working on?**

There are other issues not covered by the study. The geographical indication problem is a priority for ECTA, as the GI Regulation is being revised by DG Agriculture. Sometimes they forget about trade mark rights and we need a consistent approach. The problem is to ensure that all the agencies involved with IP coordinate with each other. Another important issue is the current review of the EU legislation on customs enforcement.

**How well do you think OHIM works?**

OHIM is a very efficient administrator, but I think the quality of the decisions and the timing should be improved. It is not acceptable to have to wait so long – for example opposition decisions can take many months. Even an average registration takes 12 months, and during that time you're not secure. To have legal certainty, you have to improve the timeliness.

I think the electronic services are very efficient and the comparative database is a very efficient tool. But there remain discrepancies between decisions, which are not always consistent. We need more quality, including at the judicial level. For example, should there be a specialised chamber or court in Luxembourg dealing with trade marks? We're studying the issue – it is an institutional matter, not just about trade marks.

We had a roundtable on the European system recently in Paris and the conclusion of all those involved was that the decisions of the Court are getting so sophisticated. The Court has now said there can be many different functions of a trade mark. When I studied, there were just two functions – to distinguish and to advertise. All others were related to those. The case law has made things more complicated and not increased legal certainty: lawyers cannot give their clients straight answers to questions. We need a more pragmatic approach.

**What are the other big challenges for the future?**

IP is a nest egg for Europe – so it is crucial to be competitive. It is also important to export and create outside Europe an environment favourable to developing IP. China is a big challenge: there is an understanding of IP and the value ladder there but still a lot of work to be done.

In Europe we have an efficient system but it can be improved. It is important also to develop that on a worldwide basis. Another issue is to put in place an EU patent – when you see the success of the CTM and Community design for European industry that has to be the next step.