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INTA President Ronald van Tuijl of JT International

When did you become interested in IP?

It was in the final year of my law studies in the Netherlands. One of the subjects I could choose was copyright and that got me into the area of IP. My thesis was also on copyright – on the role of collecting societies on the internet.

My first role was an in-house practitioner at KPN Telecom. I worked there for around five years and trained as a Benelux trade mark and design attorney. The focus was on trade marks and designs and also copyright. It was a really interesting period. They were the biggest trade mark owner in the Benelux and they also owned internet providers, so there were issues about liability. I learned a lot.

I moved to Unilever and spent a good eight years, and that formed me as an IP counsel. I worked on a wide range of portfolios across food and beverages and personal care, from Ben & Jerry's to Lipton Ice Tea. They're very different brands, and the brand strategy is different. As you move to different portfolios in the company you move to different roles.

I came to a point where I wanted to broaden my horizons and I joined Philips Electronics for about three years. Philips also has a very large IP portfolio and it was very professional and project-based so again I learned a lot. Then in August 2012 I moved to Switzerland to my current position as Intellectual Property Trade Marks Director at JT International. People joked that I had worked for all the Dutch multinationals so it was time to move abroad!

What does your current job involve?

In my team I have a group of trade mark counsel reporting in to me. There are currently four managers and five assistants. Together we handle all the company's tobacco brands globally. I have overall responsibility for that and oversee the
activities of the managers. I manage people in their own development and ensure there is consistency in the work they do. The managing part is an important part of my role, but also I handle litigation – that's something I focus on a lot. The team is working with the brand groups and the agent network, while I work with other functions in the company, such as the taxation department.

We have about 36,000 trade marks, which are spread worldwide - globally we have several markets that are key markets - but it's a centralised IP function. We pick up designs in the trade mark team, but the patent group pick up some of the designs too. We have a small portfolio of domain names but we don't have a big online presence, due to the restrictions that apply to the tobacco industry.

What are your expectations as INTA President?

The Presidential Task Force is focusing on the role of in-house IP professionals such as myself. In my career I've seen all sorts of changes to in-house teams regarding who they report to, how work is handled, the size of the team, what is insourced and outsourced and so on. I wanted to understand whether some of this is the result of economic crisis of technological development, or whether there is a trend, and to ask questions such as: what opportunities are there for people to further their career?

The Task Force is hopefully going to come up with a set of recommendations as to what INTA can do to support in-house practitioners on those topics, to see how in-house practitioners can participate and be active in INTA, and whether INTA is offering the right opportunities. Next to the task force, growing the regular INTA membership is important because we need to hear their voice.

Are the challenges increasing for in-house practitioners?

My feeling when I talk to people is that there is something in that. For example, has technology evolved to such a point that fewer people can do more work? The amount of emails you get on a daily basis is not a sign of whether your work has become easier: you are more than just a person who's answering all the questions. You should be the guardian of IP and go outside your organisation to learn more by participation in associations or in seminars. If that is slowly minimised, the question is: are you contributing all that you can to your company?

What other plans do you have as President?

With the different committees, we will see more policy work coming up, and I expect to see Board resolutions arising from the work of those committees. One of those is the new Designs Committee, and we recently held a designs conference in Singapore with AIPPI.

We are also opening an office in Singapore, and
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this year we will hold the first INTA conference in Africa for 20 years, which shows the growing internationalisation of INTA.

What do you think are the biggest challenges in trade marks?

The EU reforms are very important, in particular concerning goods in transit, the classification of goods and services and administrative procedures for oppositions and cancellations. We've all read the reform package so know what's coming, but we need to know how the changes will impact industry, our brands and clients.

Another important issue is internet governance, in particular the new gTLD process and the IANA transition. These are two topics that trade mark owners cannot ignore.

And plain packaging is a trade mark and a brand issue with the potential to impact a number of industries, so that is important to focus on. I think trade mark owners need to be aware of this issue and they are. The proof of that is that INTA passed a Board Resolution last year on plain and highly standardised packaging. The Board represents a multitude of companies in different industries and they passed that Resolution.

Do you think the EU reforms are welcome?

It is a significant step towards a more harmonised and more modern trade mark system. There will be new opportunities. The reform as such provides tools for businesses to protect and enforce trade mark rights. I believe the changes will result in a speedier, more accessible and more efficient system. Accessibility will be improved, not only because of the reduction of renewal fees but also the elimination of the graphical representation requirement. I'm curious to see what will happen there. It will also be more efficient because of the goods-in-transit provisions.

Of course you are always hoping for the ultimate harmonisation. We would have liked to see bad faith added as an opposition ground. We would also have liked to see the removal of ex officio examination on relative grounds.

Do you think the EUTM has been successful?

I think it has been very successful and the filing and renewal statistics confirm that.

We are very supportive of regional systems and of expanding the Madrid System, because it simplifies registration and maintenance and usually a result of that is lower cost. It can also result in harmonisation in trade mark offices at different levels, and we all benefit from that.

Is there anything you would like to see improved in the EU?

Speed will always be everybody's answer – we can all benefit from faster decisions. We always ask for...
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more speed but maybe that shows that so much else is working well!

If you look at how a company develops, it used to take years to roll out a new product – I can remember we would file a trade mark application and wait to see if there was an obstacle. But the speed to market for companies is increasingly fast. If you wish to have freedom-to-use or to enforce a mark associated with a product, you need faster procedures. And with social media and globalisation, you can be famous overnight – literally. With that comes the exposure and the risk of people filing bad faith applications. If it takes a year to take action on that, it’s too long, so it all comes down to speed.

What’s been your most interesting case?

I had an interesting case in 1999 involving Sinterklaas – the Dutch equivalent of Santa Claus – which is of course a fictitious person played by many different people. At that time, there was one actor considered the official Sinterklaas who arrived on a steam boat in the harbour in November. The company I worked for used an image of that Sinterklaas. The actor and the broadcaster requested a preliminary injunction to stop the use of that image. The interesting question was: does a fictitious person have image rights? But it didn’t go into that much detail because the actor himself was recognisable, and so his image was protected under Dutch copyright law. There was an article saying you can object to the use of your image if you have a reasonable interest.

Under case law that included a reputation you can commercialise and that’s what happened in this case: the court found the actor had a reasonable case to prevent the use of the image.

The decision came on 2nd December and we had 24 hours to remove all the point-of-sale materials from stores all over the Netherlands. It was a high-profile case, legally interesting and attracted a lot of publicity. Was he recognisable, was he popular? Yes and yes. But if we’d had any other Sinterklaas, it would not have been the same.