



Eric Ramage of Edwin Coe LLP

Lawyer Monthly often features legal experts on the matter of Trademarks, but this month we spoke to Eric Ramage of Edwin Coe LLP, who gave LM particular insight into the progression of the UK's Trademarks landscape since the origins of the internet and the EU's efforts to establish a just and fair Trademarks legal system.

Eric Ramage is a registered UK trade mark attorney with Higher Courts Certificate and representative before the European Union Intellectual Property Office. He joined the legal profession 1969, and qualified in 1972. Formerly the senior partner at specialist trademark practice Alexander Ramage Associates LLP, Eric joined Edwin Coe LLP "Of Counsel" in 2015, bringing over his former partner and most senior staff to help strengthen Edwin Coe's IP department.

**How has the process of protecting trademarks evolved through the years in the UK?**

There have been two significant changes. When I started in the profession, it was the first user of a trademark who was deemed entitled to protection and exclusive use. That is no longer the case, it is now the first registrant who is deemed entitled to monopolise it, with some limited exceptions.

Secondly, trademarks are becoming less territorial. A trademark registered with the European Union Intellectual Property Office (EU IPO) covers all 28 countries of the EU, including the UK within a single registration. Additionally, the growth of the internet makes it more important commercially to ensure a trademark is actually free to be used in all potential markets to which a business reaches, not just in the country in which it is based.

**How complex and lengthy is the current process of fighting an infringement in the UK?**

It is certainly a task where it pays to be well advised, but the process has been made more efficient by the introduction of the Intellectual Property Enterprise Court (IPEC) which hears IP cases having a value of less than £500,000. The general Civil

Procedure Rules (CPR) provide the framework for proceedings but clearly Part 63 CPR (Intellectual Property Claims) applies more or less throughout.

The IPEC has a multi-track and a small claims track. The multi-track has a limit on damages of up to £500,000 and costs orders are proportionate to the nature of the dispute and subject to a cap of no more than £50,000. The small claims track is for claims with a value of up to £10,000, and costs orders are highly restricted.

**Do you believe IP law could be altered to make this process smoother? Please explain.**

IPEC generally speaking is working well. It is often said that IP rights are "private rights" and the appropriate redress for infringement is through the civil courts, and rights holders can be left to get on with it. Increasing understanding of how the court system works and what elements make for a successful outcome will be an important part of any decision to sue, especially for small businesses.

However, when infringement is so widespread, and so damaging, that legitimate businesses are in danger of collapse, it can no longer be regarded as a private matter. There must be a framework which supports the effective and appropriate enforcement of all IP rights. That framework has to be accessible, and – equally important – it must keep pace with new models and channels of infringement.

**Having witnessed and been at the centre of IP issues surrounding the internet since its conception, what would you say have been the key developments on internet related IP matters over the last twenty years?**

The internet as we know it has only been in existence for about twenty years. When I joined Nominet's Policy Advisory Board (the PAB) in 1999, there was no existing dispute resolution policy in relation to UK domain names and the ICANN UDRP relating to dot coms was only being introduced. My first job on the PAB was on a working party which resulted in Nominet's DRS, relating to UK domains, which was kept under review during my years on the PAB. I am glad to say that Case law has kept pace in the field of domain names; it is now well established that simply registering a domain name can constitute an act of passing off in English law.

**As the internet spans the globe, how do you help businesses protect their IP and trademarks beyond the boundaries of UK jurisdiction? What are the challenges involved in this?**

There are very many ways. Firstly, "protection

and prevention": Identify not only the countries in which you intend to trade but those in which acts of trademark piracy may be a way of commercial life. Consider whether your brand is (a) actually free for use and (b) adequately protected?

As people like Apple have found to their cost, many jurisdictions operate a very strict "first to register" regime and it can be impossible to recover a trademark or domain name registered by a third party before you have entered the market (There are actions we can take should the need arise but prevention is always the best policy). Are your distribution agreements up to date and do they cover IP rights, notably what a distributor is and is not allowed to do? Has ownership of domain names been adequately covered? Indeed do you have a domain name policy in force at all?

Secondly, "recovery and enforcement": With domain names and websites, the main challenges are jurisdiction and secrecy, including the increasing tendency for domain names to be registered to so-called privacy services, but there are ways of getting round that, and it is possible to bring the infringing web site down, by a number of means.

We work with skilled investigators to identify perpetrators and bring the infringer to book. As to jurisdiction, I have brought successful complaints against a number of domain names working directly with the relevant authorities including in Ireland and even in Belgium. On those occasions when I am not allowed to work direct I try to work with someone whom I know personally. I work closely with a number of professional colleagues in my European professional association and try to meet up with as many as possible of my overseas associates as often as I can (often at least once if not twice a year).

**As implementing trademark protection can be lengthy and costly, how do you minimise this process for businesses you advise?**

We work here as part of a team, each handling

that part of a client's portfolio to which he or she can bring best added value. Working closely with the client is usually an excellent source of 'adding value' and minimising costs. Also when I work outside my own jurisdiction it helps to personally know the people you are working with.

**How has your work begun to visibly change on the back of the EU's newly introduced Trademark Regulation system?**

It is early to say. Apart from the welcome reduction in the official fees, that part of my work which most closely relates to the EU has not visibly changed.

**You often lecture on domain name recovery; what are the most notable cases you have advised on in this domain and what would you say to young lawyers looking to pursue an internet centred legal career?**

Unfortunately, too often, a 'notable case' is one when the client seeks my advice after the event, for example those who in setting up distribution networks, have given tacit – or even explicit – consent to distributors to register invaluable domain names in the distributors own name. Once such consent is given or implied, so far as UDRP is concerned, it cannot be withdrawn. Notable successes include use of the IPEC to recover domain names where UDRP or DRS proceedings might have failed on a technicality and at the same time I have obtained an order prohibiting further infringement and passing off, and recovered costs and damages (which of course cannot be recovered under UDRP or DRS). To the young lawyer, I say that internet and domain name law is to some extent now where trademark law was when I joined the profession, it is in development; in the early days the internet was likened to the Old Wild West, it is now settling down, but it certainly needs 'peacemakers' if not law enforcement officers. **LM**



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