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In 2005, a large number of appeals from the OHIM Board of Appeal to the Court of First Instance (CFI) and the ECJ gave further guidance to would-be applicants for staying on course.

On course for registrability

Directions from the Courts

To navigate a successful route to registration, whether at UK or European level, an applicant must avoid objections based upon the inherent characteristics of the mark itself (absolute grounds for rejection), as well as objections from other rights holders who may have conflicting trade mark registrations or common law rights (relative grounds).

Absolute guidance

Article 7(1) of the Community Trade Marks Regulation (and its Trade Marks Act 1994 equivalent, section 5) preclude the registration of marks across several criteria, including where marks may lack distinctive character (Art.7(1)(b)), or are descriptive of the kind, quality and characteristics etc. of the goods/services in question (Art.7(1)(c)). A key decision of the ECJ on absolute grounds concerned an appeal from the CFI which upheld a refusal of an application to register the device mark BioID for computer software, hardware and telecoms concerned with "Biometrical Identification".

A global assessment

The ECJ considered that the approach of the CFI had been correct in its assessment of the distinctiveness of the mark by analysing the composite elements (Bio and ID) as well as the mark as a whole. Composite marks can be assessed by their individual elements, but must also be viewed as a whole – there is no presumption that individual elements lacking distinctiveness cannot in totality have such character.

Independent grounds

However, the CFI had been incorrect in relying upon the fact that the mark was in their opinion common to the trade in assessing distinctiveness under Art.7(1)(b); that assessment is relevant only to Art.7(1)(c). The ECJ emphasised that each of the grounds of Art.7(1) is independent from the others and calls for a separate assessment. In this case, objections under Art.7(1)(b) were "indissociable" from the essential function of a mark of guaranteeing origin, and do not apply to the descriptive considerations of Art.7(1)(c). In light of this, applicants would be well advised to ensure that separate arguments and considerations are deployed to counter potential objections under the various absolute objections, rather than dealing with these grounds as a whole.



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Unfortunately for the applicant in BioID, despite a technically successful appeal, the ECJ substituted its own opinion and came to much the same conclusion as the CFI. Its assessment was that at the time of the application, the average consumer would view the mark as an abbreviation for “biometrical identification”, and as such was incapable of guaranteeing origin – the mark was virtually indistinguishable from the goods/services supplied under it. In addition, the figurative and decorative aspects of the mark were minimal and insufficient to endow distinctiveness.

Immediate and unambiguous?

An interesting comparison to BioID can be found in the CFI's assessment of the mark CELLTECH (for products and equipment related to cell technology). Although from an initial assessment this might appear little different to the shortcomings of BioID as far as the essential function is concerned, in CELLTECH the mark was accepted – the CFI considered that even taken as meaning cell technology, it would not be “immediately and unambiguously” perceived as designating activities in the field of cell technology and associated products. If this approach is correct, it might suggest that the threshold for acceptance under lack of distinctiveness may in fact be lower than previously thought.

Lacking distinctiveness

Other marks rejected by the CFI for lack of distinctiveness in 2005 included CARGO PARTNER (for transport, packaging and storage of goods) and LIVE RICHLY (for financial services). The former was held to consist of generic words not capable of distinguishing the services, where the combination did not present any additional element to distinguish. The latter was dismissed as a simple laudatory formula, and added nothing beyond its obvious promotional meaning to suggest distinctive character.

Wholly descriptive

In terms of marks considered under the descriptive criteria of Art.7(1)(c), three cases before the CFI demonstrate the application of such objections to registrability. A mark which illustrates the policy considerations under these criteria,

MUNICHFINANCIALSERVICES (for financial services) was rejected by the CFI as being solely an indication of the services to be performed under the mark, at a particular geographical location. The marks DIGIFILM and DIGIFILMMAKER (for data carriers and transfer of data services) were similarly rejected, although the CFI did make it clear that for such “neologisms” (ie. novel words) the rejection must be not only of the individual elements combined, but also of the neologism as a whole. Finally, the CFI accepted the mark CLOPPENBURG (for retail services), which although being a defined geographical area (a small town in Germany) had no particular reputation for the services applied for. As such, the relevant public would be at most moderately familiar with the town, and would make no particular association with retail services. It is only if the area has, or may have, a particular reputation in relation to the specification sought that a rejection on the grounds of a geographical designation is warranted.

Relatively objectionable

As in previous years, conflicts between prior rights and marks applied for created a large number of oppositions, appeals and ultimately guidance from the Courts. It has been interesting to note that following a number of key decisions in 2004 that considered when two marks might be considered identical under the relevant legislation, in 2005 the Courts provided further guidance on when two marks may be considered similar, and result in a likelihood of confusion. In our last Brands Review we reported on the guidance on identity from the ECJ concerning the marks ARTHUR and ARTHUR ET FELICIE, which were not identical (see *LJ Diffusion v Sadas Vertbaudet*). In 2005, the CFI considered that these marks, being similar, would create a likelihood of confusion when used in relation to identical goods.

In terms of new cases, a key decision of the ECJ on conflicts between marks arose from a reference by the German national courts to the ECJ in relation to an infringement case.

In *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* a dispute arose between the proprietor of a German national trade mark "LIFE" (for leisure electronic devices), and the major electronics manufacturer Thomson, for distribution and sale of goods bearing the mark THOMSON LIFE. The German regional Court had considered there was no likelihood of confusion, but on appeal the higher regional Court made a referral to the ECJ.

The basis of the referral was whether there was infringement of Art.5(1)(b) of the Trade Marks Directive for identical goods, where a sign consisting of a word mark of "normal distinctiveness" was reproduced in a composite mark of a competitor, and where such elements did not alone determine the overall impression given by the mark, but had an independent distinctive role within the composite mark.

In essence, the question was whether the presence of the competitor's (dominant) company name in the composite mark would dispel the possibility of a likelihood of confusion. Indeed, given Thomson's level of sales and goodwill, it was inevitable that the dominant element in the mark would be THOMSON, rather than LIFE. This concept of a mark with a smaller reputation being subsumed by a larger mark with a stronger reputation is often described as "swamping".

The ECJ held that in those circumstances there might be a likelihood of confusion, because the public might perceive that the proprietors of the two marks were linked economically. Moreover, this confusion might arise even if the earlier mark is not the dominant element in the composite mark, instead having some independent role. Although no clear guidance was provided as to what "some independent role" might entail, it would certainly be consistent with the essential function of a trade mark to conclude that the ability of the earlier mark to guarantee the origin of the proprietor's goods would be compromised if where the goods were identical, the average consumer would not disregard the earlier mark in the composite sign.

Can an element be too dominant?

Although an assessment of the dominant and distinctive elements of a mark is an

important part of the global assessment carried out through the eyes of the average consumer, there has been a perception that perhaps the dominant element, if given too much emphasis, can lead to contrary results. Certainly the decision of the CFI in *BIKER MILES* would indicate some of the difficulties where a dominant element is considered to the exclusion of other distinguishing factors. In that decision, the CFI overturned the finding of the OHIM Board of Appeal that there was no likelihood of confusion between the word mark MILES and a figurative mark for BIKER MILES in respect of articles of clothing in class 25.

The OHIM Board of Appeal had considered that in terms of the overall impression created by the mark, the graphical representation and the verbal element "Biker" were significant in reducing the likelihood of confusion. The CFI considered this was incorrect, and held that the verbal element "Miles" was the dominant element, and as such was identical to the earlier mark. Further, as the intended specification was clothing, it was not uncommon in the fashion retail sector to use sub-brands to distinguish various lines. Since the dominant element in both marks was identical, there was a risk that the BIKER MILES mark might be perceived as a MILES sub-brand. In focusing solely on the dominant element, the CFI considered there to be a likelihood of confusion. However, one might question whether the average consumer would have considered that the additional figurative and conceptual elements might nonetheless have had some independent distinctive role?

Another decision which illustrates the various influences upon the global assessment of conflicting marks is the finding in *LINDERHOF/LINDENHOF*, where the CFI considered that the key differences between the respective uses and consumers of alcoholic and non-alcoholic drinks were sufficient to negate a likelihood of confusion as far as those goods were concerned.

A question of language

A particular focus in 2005 has been on conceptual similarities between various marks, particularly those based upon meanings conveyed in different languages

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across the various Member States. An applicant for a device mark incorporating the word and image SHARK for energy drinks found their application opposed by the proprietor of the mark HAI (also for energy drinks), which is roughly translated as “Shark” in Finnish, Dutch, Danish and Swedish. In that case, conceptual similarity alone was not sufficient to give rise to a likelihood of confusion, but all applicants (and their advisors) would be wise to consider the “hidden meaning” in any mark. This approach was endorsed by Advocate General Jacobs in his opinion in MATRATZEN, in which he considered that registration of a trade mark in circumstances where a significant proportion of traders in and consumers of the product concerned can reasonably be expected to understand the meaning of the word used would contravene Art.3(1)(c).

A conceptual shortcoming

Finally, and also in terms of conceptual similarity, a CFI decision suggested that marks with a particular conceptual meaning may in fact receive less protection outside the core area associated with that concept than more ambiguous marks. The CFI considered an opposition to the registration of the mark MOBILIX (telecoms related classes) brought by the proprietor of the prior mark OBELIX (media and entertainment). Although the CFI considered there was some oral/aural similarity, and a slight visual similarity, the earlier mark had a very specific conceptual meaning to the average consumer, being that associated with the well-known comic book characters. Since there was no real crossover in the specification of the two marks, there would be no likelihood of confusion. Consumers would simply not associate the famous Gaul with telecommunication goods and services, so in effect the particular reputation of the mark counted against it. A similarly reasoned decision was handed down by the ECJ in early 2006 in *Claude Ruiz Picasso and others v OHIM*, which considered the conceptual meaning (among others) of the mark PICASSO in relation to motor vehicles.

Although the Courts have confirmed on a number of occasions that the test for registrability of any trade mark is the same regardless of the type of mark, consumers are simply not used to seeing these non-traditional marks as indicia of origin, and therefore the majority of applications fail to perform the essential function of a trade mark.

A break from the norm

Non-traditional marks

The definition of signs in the Community Trade Marks Regulation and the Trade Marks Act is wide enough to encompass a variety of the so called “non-traditional” trade marks, such as shapes, colours, sounds and smells. However, the registration of such marks for all but the narrowest of specifications has proved to be considerably difficult, with a number of key judgments rejecting such marks from the CFI, ECJ and UK Courts in 2005.

A novel shape conundrum

Although there have been a number of applications to register the shapes of packaging, the ECJ considered a novel concept in *Eurocermex SA v OHIM*. Eurocermex were the distributor of the well-known Mexican beer “Corona”, and applied to register the characteristics of the product at point of sale as “a three-dimensional shape and colours of a transparent bottle, filled with a yellow liquid, having a long neck in which a slice of lemon with a green skin had been plugged”. Perhaps unsurprisingly, the CFI upheld the refusal insofar as classes 32 (beer, fruit juices) and 42 (restaurants and snack bars) were concerned.

On appeal, the ECJ considered that the CFI had adopted the correct approach by assessing the combination of the features individually (shape, lemon, colours used) for distinctiveness, and then considering the overall impression of the shape of the bottle and the arrangement of colours. However, what is perhaps more interesting is that the ECJ did not consider that a key concept of the mark relied upon the container being opened and the correct type of fruit being inserted by a third party at the point of sale. How could this concept be guaranteed by the proprietor to act as an indication of origin? Would other traders have to issue instructions not to sell similar shaped bottles with a similar lemon in it? Would the mark be infringed if a lime were used? In this context, it is

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important to remember that the ECJ said in *Arsenal v Reed* that infringement would not just be considered at point of sale, but could take place some time after.

No smell of success

In *Eden SARL v OHIM* (Case T-305/04) the CFI considered an application for “the smell of ripe strawberries” for a whole range of goods from washing powder to clothing (classes 3, 16, 19, 25). The mark applied for was represented by the words, together with a visual representation of a strawberry. Applying the *Sieckmann* criteria, the CFI considered that the mark was not capable of being represented graphically and should be refused. Under the *Sieckmann* rules, any mark applied for must be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”.

On the applicant’s own evidence before the Court it was apparent that there was not a single smell for ripe strawberries, as this would vary according to type and season so the description was not sufficiently precise. In addition, the image represented the fruit, not the sign, so did not amount to a graphical representation of the mark applied for. The practical consequence of decisions such as *Sieckmann* and *Eden* is that until a method of representation can be found to characterise smell by objective standards (such as Pantone for colours or musical notation for sound marks), no registrations are likely to be permitted. These restrictions reflect limitations on the available technology at the Trade Marks Registry, but may also be considered a fair result given the potential for uncertainty for third parties trying to determine the scope of the proprietor’s monopoly.

Other rejections for shape marks were handed down by the CFI in *Bic SA v OHIM* (shape of lighters) and “*Almdudler-Limonade*” A. & S Klein GmbH & Co KG v *OHIM* (shape of a lemonade bottle).

Acquired distinctiveness?

For any trade mark which lacks inherent distinctiveness, it may still be registrable if the applicant can prove that from the use made

of it, it has since acquired distinctiveness in the eyes of the average consumer. However, as far as non-traditional marks are concerned, this has proven to be a very high hurdle indeed.

Perhaps the greatest breakthrough for these non-traditional marks in recent years was handed down by the ECJ in 2005, in a case involving a word mark (more specifically, a slogan). On a reference from the English Court, the ECJ gave judgment in *HAVE A BREAK (Société des produits Nestlé SA v Mars UK Ltd)*. In that case, the Court considered whether the distinctive character of a mark (*HAVE A BREAK*) could be acquired by use of that mark as part of or in conjunction with a larger, composite mark (*HAVE A BREAK...HAVE A KIT KAT*), and in short, answered in the affirmative.

On a broad level, this was a predictable decision and one consistent with the theme of much of the case law before the ECJ in recent years. The ECJ tends not to accept artificial and technical concepts to exclude evidence in its entirety; as in all such matters, the perception of the average consumer is paramount. On a question of evidence, the key concept is whether the average consumer would see the (shorter) mark applied for as distinctive in consequence of the use made of it by the proprietor (however such use arose). It remains to be seen how the English Court of Appeal will apply this guidance to the evidence of use adduced by the applicant.

A break, or breakthrough?

However, arguably the wider application of the *HAVE A BREAK* ruling will be of great assistance to applicants seeking to prove the distinctive character of shapes, colours and packaging acquired through use. First, in most instances distinctive packaging, colours or shapes will be used in conjunction with a brand name, or other marks, to which consumers will inevitably pay more attention. Had the ECJ ruled otherwise, protection of the non-traditional element of the mark might have been automatically excluded.

Secondly, and perhaps more importantly, the decision may change the practice in the registries (and the UK in particular) which have previously relied upon a particular

interpretation of the decision in *Philips*, which suggested that distinctive character could only be acquired through “use as a trade mark”, and that recognition/recollection was not enough. The problem for any applicant is that until the consumer recognises the sign claimed as a trade mark (i.e. indicative of origin), this is not technically trade mark use, so such use would not count towards acquired distinctiveness. Of course, if the consumer did perceive such use as indicating origin, then the mark would probably be inherently distinctive, and registrable in any event. What the ECJ judgment suggests (although it is by no means clear) is that one must look to the end result, not the process, and that if the relevant public perceives the product as originating from the proprietor/applicant, then distinctive character may flow from that use in its entirety: *“use of the mark as a trade mark must be understood as referring solely to the use of the mark for the purpose of identifying the goods/services to the relevant class of persons as originating from that undertaking.”*

Of course, non-traditional marks still face an uphill struggle to achieve registration, but they may well have caught a break at last.

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A number of decisions handed down in the last year have dealt with the revocation of a trade mark for lack of use, including the reversal of the High Court judgment in *La Mer Technology Inc v Laboratoires Goemar SA*, which was discussed in our UK brands review 2005.

Use it, prove it, or lose it

What constitutes “use”?

Although it is not necessary for a trade mark to have been used prior to an application for registration being made, continuing non-use can lead to a registration being revoked. Articles 10-12 of the Trade Marks Directive and Section 46 of the Trade Marks Act 1994 provide that a registered trade mark will be liable to revocation if it is not put to “genuine use” within a period of 5 years from registration or if it is suspended from use for a continuous period of 5 years, unless there are “proper reasons” for non-use. Clearly, the meaning of “genuine use” is crucial in determining an application for revocation. The English law view (under the pre-harmonised 1938 Act) has been, historically, that any use relating to a real commercial transaction (as opposed to sham use purely for the purposes of avoiding revocation) constitutes genuine use, no matter how small.

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The La Mer case

High Court proceedings

Laboratoires Goemar was the proprietor of the trade mark LABORATOIRE DE LA MER, registered in classes 3 and 5. La Mer Technology applied for revocation on grounds of non-use, and, when its application was only partly successful, appealed on the basis that the registrations should have been completely revoked. In the High Court, Mr Justice Jacob (now Lord Justice Jacob) referred certain questions to the ECJ concerning the meaning of “genuine use”.

In fact, the only use that Goemar had made of the mark in the five-year period in question was the sale of £800 worth of goods to an agent in Scotland. These were sold over 5 months in the form of 5 separate deliveries. However, the agent soon ceased trading, and there was no evidence that any of the goods had been sold or offered to any member of the public.

The ECJ decision

Before delivering its decision in response to Jacob J's reference, the ECJ had given a full judgment in the case of *Ansul BV v Ajax Brandbeveiliging BV*, which dealt with similar issues. Consequently its decision in *La Mer* was given in the form of a reasoned order referring to *Ansul*. Among the key points made in *Ansul* were the following:

- Genuine use must be use that is not merely token, serving solely to preserve the rights conferred by the mark.
- Genuine use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him to distinguish the product or service from others which have another origin.
- Genuine use entails use of the mark on the market and not just internal use by the company concerned.
- In determining whether there has been genuine use, regard must be had to all the facts and circumstances; assessing these may involve consideration of the nature of the goods or services at issue, the characteristics of the market involved and the scale and frequency of use of the mark; because these may vary, use need not always be quantitatively significant for it to be genuine.

The reasoned order further emphasised the role of a trade mark in creating a market for the goods. Genuine use is "use in the course of trade, on the market for the goods"; use can qualify as genuine "on condition that it is deemed to be justified, in the economic sector concerned, for the purpose of preserving or creating market share".

In both decisions, the ECJ emphasised that "genuine use" entails the use of the mark for the purpose of creating or preserving a market for the goods.

The High Court decision

When the case returned to the High Court it was heard by Mr Justice Blackburne (owing to Jacob J's elevation to the Court of Appeal in the interim). His decision relied heavily upon the fact that the goods had not been offered for sale nor sold to

the public as end-users. Although the transactions between Goemar and its agent were not merely token use, the fact that the goods were not offered to the public meant that the use of the mark in those transactions did not serve the essential purpose of a trade mark in creating or preserving a market.

Blackburne J found that the market in which the mark had to be used was that for consumers or end-users of the products, and concluded that, because these products had not been marketed or sold to consumers, the use made of it did not constitute "genuine use". He therefore allowed the application for revocation.

The Court of Appeal decision

The judgment of Lord Justice Mummery, with which the other judges concurred, identified as the key issue the use of the mark in the market for the goods. He went on to find that Blackburne J's emphasis on the market for consumers and end-users was misplaced: "The Court of Justice did not rule that the retail or end user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine." Mummery LJ noted that trade marks are used to create a market and to identify the origins of goods on the market that exists between foreign manufacturers and importers just as they are on the retail market, and that in that market the mark had been used in accordance with its essential function. He also noted that use need not be on a large scale for it to be genuine.

Lord Justice Neuberger clarified the position with regard to the statement in *Ansul* referred to above that use of the mark had to be "consistent with the essential function of a trade mark". Although that statement refers to the consumer or end-user market, it does not state that, to be genuine, the mark must actually be used in that market; it merely says that the use of the mark must be consistent with its use in the end-user market. The order for revocation of the mark was therefore set aside and the revocation proceedings dismissed.

This decision clarifies that, providing use of a trade mark is consistent with the essential



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function of a trade mark and not token or internal, it can constitute genuine use for the purposes of revocation regardless of the extent of the use or the market on which it is used.

What is “internal” use?

The *La Mer* case confirmed that internal use by a trade mark owner does not constitute “genuine use” for the purposes of opposing revocation proceedings. Blackburne J’s decision in the High Court that the transaction between Goemar and its agent amounted to nothing more than a transaction between a parent company and its subsidiary was decisively rejected. These were arm’s length transactions between companies at different levels of the supply chain who were otherwise not associated.

The nature of internal use also arose in the decision of Professor Ruth Annand as Appointed Person in respect of an application for the revocation of a graphic trade mark including the word OMEGA. The registered proprietor of the trade mark, Omega SA (Swiss) adduced in its defence of the trade mark certain transactions that had taken place between it and The Swatch Group (UK) Limited (UK). Swiss and UK are subsidiaries of the same parent company. However, the hearing officer characterised this use as internal. Swiss appealed, complaining (*inter alia*) that the hearing officer was wrong to characterise the relationship thus.

Professor Annand referred to *Ansul* in coming to her decision on this point. She concluded that nothing in *Ansul* led to the conclusion that transactions between companies in the same group must necessarily be classed as internal. Instead, she referred to the ECJ’s statement that “regard must be had to all the facts and circumstances relevant to establishing whether commercial exploitation of the mark is real”. She decided that the hearing officer had erred not only on the facts (he appeared to have been mistaken as to the nature of the relationship, believing that UK was a subsidiary of Swiss), but also in law, by concentrating excessively on marketing and sales to the retail market (as in the High Court decision in *La Mer*) and failing to take

into account all the circumstances of the case. She went on to find that, on the facts, which included evidence that UK paid the same price for Swiss’s products as any other third party importer, the relationship between Swiss and UK was at arm’s length in relation to at least one category of products.

Taken together, *La Mer* and *Omega* give a narrow meaning to “internal use”, which is a phrase that is not found in the Community Trade Marks Regulation (CTMR) and appears to have been introduced by *Ansul*. Arm’s length transactions between a manufacturer and an importer are not to be regarded as internal use, and, subject to the other circumstances of the case, transactions between sister companies do not necessarily constitute internal use either. This is consistent with the wording used in *Ansul*, which refers to “internal use by the undertaking concerned”.

Does use by a third party count?

Ansul also confirmed that use of a trade mark by a third party with the permission of the registered proprietor can be sufficient to establish use for the purposes of opposing revocation.

The issue of third party use in this context was considered further by Advocate General Jacobs in his opinion in the case of *The Sunrider Corporation*. Sunrider had applied to register the mark VITAFRUT for certain non-alcoholic drinks. Juan Espadafor Caba (Caba) opposed the application on the grounds of similarity to its mark VITAFRUIT. Sunrider put Caba to proof on use of the mark, as it is entitled to do by Article 43 of the CTMR. Caba presented evidence of the use of the mark by a third party and argued that this use met the requirements of Article 15(3) of the CTMR, which provides that “use of the Community trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.” The Office for Harmonisation in the Internal Market (OHIM) agreed and rejected Sunrider’s application. Appeals to the OHIM Board of Appeal and to the Court of First Instance of the European Communities (CFI) having failed, Sunrider appealed to the ECJ.

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Sunrider complained that the CFI had failed to consider properly whether the use of the mark by the third party constituted use by Caba. In particular, it argued that the CFI had taken into account implicit statements and evidence and had made improper assumptions rather than relying on solid evidence. Effectively, Sunrider argued that the CFI could not assume that the third party use was with consent, and that it had erred in failing to require Caba to prove that the third party use was with consent.

Advocate General Jacobs, agreeing with the decisions of OHIM and the CFI, allocated the burden of proof differently. He considered that, by maintaining that the use by the third party constitutes genuine use, Caba impliedly claimed to have consented to that use. He also noted that, had Caba not consented to the use by the third party of the mark, the third party would have committed a trade mark infringement, in which case it would have been very unlikely to have assisted the proprietor of the trade mark. The fact that it did assist was of itself evidence that the use was with permission.

If endorsed by the ECJ, this reasoning creates a new presumption in favour of the proprietor of an earlier trade mark that use of the mark by a third party is with consent. The applicant for the new mark now bears the burden of proof, and must prove that such use was without consent.

Like *La Mer*, the opinion in *The Sunrider Corporation* also emphasises that small quantities are no bar to establishing genuine use; in this case the value of the goods bearing the mark was just €4,800, but this was sufficient.

Is the use in the correct form?

Finally, the meaning of use for the purposes of defending an application for revocation was also considered in the context of use of a graphical mark in a form other than that in which it was registered.

In *GfK AG v OHIM*, GfK applied to register as a CTM the word mark ONLINE BUS in the field of business consultancy services.

This was opposed by another German company, *Betreuungs- und Unternehmensberatungs* (also known as Bus) which had registered as a national mark a graphical sign in which the word BUS was prominent.

GfK took advantage of Article 43 of the CTMR to require Bus to provide proof of genuine use. Article 43(3) provides that use of a national trade mark can also be adduced as grounds for opposing a new CTM registration.

Article 15(2)(a) of the CTMR provides that use of a CTM includes use “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”. However, there is no equivalent provision relating to national marks.

In this case, the proof of use provided by Bus was of use of a national trade mark in a form differing from the form registered. However, OHIM and the OHIM Board of Appeal upheld Bus’s opposition. GfK appealed to the CFI on the grounds that use in a form different from that registered did not fulfil the requirements of Article 43 of the CTMR, and that the saving provision at Article 15(2)(a) for uses of a mark in a different form did not apply to national marks.

In the event the CFI upheld the opposition, agreeing with OHIM that Article 15(2)(a) of the CTMR should be interpreted to apply to earlier national marks as well as CTMs. This appears to close a lacuna in the CTMR, OHIM having accepted that Article 15(2)(a) does not expressly cover use of an earlier national mark in a form different from that of its registration.

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In certain circumstances, a proprietor's trade mark can be used by a third party without consent, and without liability for infringement.

Use of marks by a competitor

Most typically such use arises in comparative advertising, when marks are used to identify the goods/services of the proprietor for the purposes of a comparison, typically explicitly or impliedly unfavourable, with a competitor's equivalent goods/services. Two decisions in 2005 (although both only at an interim stage) gave further guidance on the interpretation of the relevant rules, as well as suggesting that the defence under section 10(6) of the Trade Marks Act 1994 may well be of much wider application than initially thought.

A fair comparison?

In *O2 Limited v Hutchinson 3G UK Limited*, O2 objected to a comparative advertisement which took the form of a price comparison between O2's mobile phone prices and those of mobile operator "3" concerning pay-as-you-go tariffs. The advertisement in question began with a shot of bubbles set out in a circle which expanded to full screen together with a voice over saying "on O2 pay-as-you-go the first three minutes peak rate call each day could cost you 75p". This was accompanied by detailed text on screen and a further voice over "or, with freepay that exact same call could cost you 15p".

O2 objected to the price comparison (75p as opposed to 15p) as being grossly misleading and an over-simplification of any legitimate comparison. It based its claim on a mix of UK national marks and CTMs, being word marks for O2 and various device marks featuring bubbles. 3 argued that the comparison was accurate, alternatively fair, and that Section 10(6) of the Trade Marks Act 1994 applied.

Different regimes

Although there were two interim hearings before the Court, the more interesting application was before Pumfrey J. As is typical, several references were made to the last major comparative advertising case, *British Airways plc v Ryanair Limited*. However, an unusual aspect of the O2 case was that it concerned CTMs as well as domestic UK marks. Further, the time for compliance and implementation of the Comparative Advertising Directive, Directive 97/55 EC had passed (see S.I. 2000/914).

A key difference between the national and CTM regimes often overlooked by brand owners is that Section 10(6) of the Trade Marks Act is a "home-grown" provision of relevance only to UK marks. As far as CTMs are concerned, the relevant provision is Article 12(b) of the Community Trade Mark Regulation (use in the course of trade of indications concerning the kind, quality, intended purpose etc. provided use is made in accordance with honest practices).

“
A key difference between the national and CTM regimes often overlooked by brand owners is that Section 10(6) of the Trade Marks Act is a "home-grown" provision of relevance only to UK marks.

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“Honest” Use?

Section 10(6) may only be relied upon as a defence to trade mark infringement if the competitor has acted in accordance with “honest practices” in the relevant market. In this regard, Pumfrey J. referred to *Cable & Wireless v BT plc* in 1998 which had set out a list of considerations which were largely restated in the *BA v Ryanair* case. In particular he emphasised that the test is objective and has to be gauged against what is reasonably to be expected by the relevant public of advertisements for the goods and services in issue, that the general public are used to the methods of advertisers, but that an advertisement which is significantly misleading is not honest. Further, the advertisement must be considered as a whole, and a minute textual examination is not appropriate.

“Take Home” message

An interesting element of *O2* was that Pumfrey J. approached the various marks relied upon differently. As far the *O2* word marks were concerned, the Court found that in the relevant section of the market to which the defendant directed their advertisements, on a preliminary assessment of the matter the “take home” message for consumers was true – 3 were significantly cheaper, albeit subject to restrictions. It was therefore found that there was no arguable case for infringement of the *O2* mark as far as an interim injunction application was concerned.

An unfavourable comparison

However, separate considerations applied in relation to the bubbles marks. The Court commented that the use of the bubbles in the advertisement was “certainly gratuitous” and would not be indispensable to the making of any comparison. Although the image used in the advertisement was by no means identical to the registered marks, Pumfrey J. noted a “strong suspicion that the defendants had used the bubbles as a way of emphasising the unfavourable nature of the comparison”. For the purposes of an interim assessment, it was

found that there was an arguable case for infringement of the bubbles marks.

The claimant’s case for an injunction failed on the balance of convenience – there was no real evidence of dishonesty, the case for confusion concerning the bubbles marks was weak and the damage caused to the claimants was on any view small. The Court was not satisfied that the disruption caused by an injunction would be proportionate to the damage caused and for that reason refused to grant interim relief.

ECJ reference declined

Subsequently *O2* sought the referral of a number of questions to the ECJ on a wide range of issues, not just those related to comparative advertising. The Court declined to make the reference on the basis that a reference at the interim stage was premature, likely to be incomplete and would delay the trial, which might impact on the quality of the evidence. The threshold of the test under Article 234 of EC Treaty had not been met - a reference “must be necessary for the national Court to give judgment”.

A wider application of section 10(6)?

The High Court considered an application for an interim injunction for an entirely different type of use by a competitor in *Wolters Kluwer (UK) Limited v Reed Elsevier (UK) Limited*. Wolters Kluwer (UK) Limited (trading as CCH) published an online subscription-based seminar service for accountants, called “CCH Seminars”. Wolters were the proprietors of a trade mark for the words CCH in classes 9, 16, 35 and 41. Until July 2005, the content for the service was provided by a company called Online Tutors Limited. CCH then switched to an alternate supplier.

Use of mark

Reed (Lexis/Nexis) subsequently contracted Online Tutors to provide content for a competing service called “Tolley’s Seminars Online”. The dispute originally arose from the following advertisement: “Subscribers

“

Section 10(6) may only be relied upon as a defence to trade mark infringement if the competitor has acted in accordance with “honest practices” in the relevant market.

”

“
 ...if the mark was
 being used to identify
 the goods and services
 which were those of
 the proprietor of the
 mark, then it was
 permitted; if it was
 being used to identify
 the goods and services
 of someone else, then
 it was not
 ”

to CCH Seminars Online, the former name of the service, should call 0208 662 2000 and LexisNexis will honour their existing subscription free of charge until its expiry”.

When CCH complained, Reed issued correction notices making it clear that CCH was continuing with its own service, and that the LexisNexis service was an alternate, competing offering, not a re-branding. A subsequent advertisement made reference to the agreement with Online Tutors as “...the company behind the former version of CCH Seminars Online”, repeating the offer to existing subscribers of CCH for free access.

CCH applied for an interim injunction against LexisNexis for infringing the mark CCH under section 10(3) of the Trade Marks Act 1994. (The substantive proceedings also contained allegations of libel and malicious falsehood.) Reed accepted the use of CCH in the advertisement did prima facie infringe section 10(3), but claimed a defence under section 10(6).

A purposive construction

The application for an interim injunction was dismissed by Mann J. His judgment makes for an interesting review of the wider application of section 10(6). Mann J. noted that although the principal intention of section 10(6) was to permit comparative advertising, the wording was capable of applying to circumstances outside of comparative advertising. What mattered was the way in which LexisNexis was using the CCH mark – if the mark was being used to identify the goods and services which were those of the proprietor of the mark, then it was permitted; if it was being used to identify the goods and services of someone else, then it was not.

On the facts, and despite their clearly wider commercial purpose (to obtain the proprietor’s subscribers), Mann J concluded that LexisNexis’s use of the CCH mark was on its face permitted. If so, was the LexisNexis use honest in industrial and commercial matters? Mann J considered that CCH had failed to establish any strong or reasonable argument of dishonesty

under section 10(6) – in his view LexisNexis’ use of the CCH mark was no more commercially dishonest than “proper” comparative advertising; it was not seeking to prey unfairly on CCH’s reputation, but offering an alternative service.

Use to indicate origin

The Court also considered that LexisNexis’ use of the CCH mark in its advertisements to indicate the origin of its service, by identifying Online Tutors as the provider of the material, was also not an infringement. Again, the mark was being used to describe CCH’s (former) service and was permitted by section 10(6).

In terms of the balance of convenience for the injunction, damages would be an adequate remedy for CCH (following *American Cyanamid*) since LexisNexis was a substantial company and any loss suffered by CCH should be possible to calculate if at trial LexisNexis was found to infringe.

Purposive, or permissive?

It is interesting to note that the decision in *Wolters* continues the line of authority on section 10(6) where the Courts have generally taken a very permissive approach, stating that the intention of the section is as far as possible to permit comparative advertising, rather than restrict it. This approach is therefore in line with more recent decisions such as *O2* and *Ryanair*, and consistent with the older authorities such as *RBS Advanta* and *Cable & Wireless*. It is notable that, because of the application of section 10(6), very few brand owners have been successful in infringement actions concerning comparative advertising although it remains to be seen how the Courts will treat a similar case which deals with CTMs alone, rather than UK marks. Certainly, the minor discrepancies between the treatment of UK and CTM registrations can work both for and against brand owners in differing situations.

In June last year the Court of Appeal gave a rare split judgment in a passing off case which has implications for those considering the sale of a business and the transfer of goodwill.

Passing off

A problem of persona

Sale and transfer of business

Mr. Adlem ran a funeral directors business from 1965 to 1993 which he sold to a third party under an agreement which provided that the business was transferred as a going concern and permitted the purchaser to carry on the business in succession to, and to the exclusion, of Mr. Adlem. Goodwill was expressly included, to which most of the purchase price was attributed. Mr. Adlem promised not to carry on a similar business in a ten mile radius for five years, although he was permitted to continue a separate side line business in headstones. He did so, and in fact also assisted the purchaser in directing funerals (it was unclear as to whether this was as an employee or a self employed consultant). The purchaser continued to trade under the existing trading name "Richard T Adlem Funeral Director".

In 2000 the business was sold to IN Newman Limited (Newman) and at first Mr. Adlem continued to assist and made no objection to Newman's use of the business name. Then in 2001 Mr. Adlem started advertising his own services under the name "Richard T Adlem" and Newman complained. Adlem continued advertising using the name but tried to distinguish himself from Newman's business by referring to his business as "the original" and "no connection with Richard T Adlem operating from [Newman's telephone number]". He also complained to magazines about Newman's advertisements and as a result of threats made of potential legal action, the magazines refused to run Newman's advertisements. In 2002 Adlem registered a trade mark for RICHARD T ADLEM FUNERAL SERVICES covering funeral services and headstones.

Success at first instance

On the passing off claim the High Court found in favour of Mr. Adlem, but held that the new owner had not infringed his trade mark. The Court decided that although goodwill had been transferred in 1993, Adlem had subsequently acquired his own goodwill in the trading name by virtue of his continued assistance to the first purchaser and then to Newman. The parties therefore shared the goodwill in the trading name.

“

...the agreement provided that the business was transferred as a going concern and permitted the purchaser to carry on the business in succession to, and to the exclusion of Mr. Adlem

”

“
*The former owner
 now had no more
 right to use the
 name than a
 complete stranger.*
 ”

Court of Appeal overturns

An appeal by Newman was successful by a majority of 2:1, on the basis that Mr. Adlem had transferred the goodwill in the business name in 1993 and could not subsequently derogate from such transfer. His registered trade mark was also invalid in light of this. This conclusion was reached on the basis of the terms of the sale agreement in 1993. Mr. Adlem had clearly assigned the entire goodwill of the business including the trading name even though the name was not expressly mentioned. After expiry of the five year restriction he could only set up a similar business under the same name if it was made very clear that this was a separate and distinct business; otherwise this would derogate from the grant of goodwill which he made in 1993. He now had no more right to use the name than a complete stranger. Any goodwill created while he assisted the purchasers did not accrue to him personally, regardless of the employment capacity in which he had worked; it accrued to the business which he had sold.

In his own advertisements Adlem had made misrepresentations creating the impression that Newman was the “usurper” and it was very likely that he had gained the benefit of customers who would otherwise have gone to Newman. There was no evidence of actual confusion but this did not matter – his actions had largely destroyed Newman’s business in any event. Although there is an “own name” defence in passing off it is extremely limited in ambit and requires honesty. Here Mr. Adlem could not benefit from it given the misrepresentations made.

Dissenting judgment

In her dissenting judgment Lady Arden found that under the 1993 agreement there had never been a transfer of the right to make exclusive use of the name. There was no absolute rule that the sale of a business and the goodwill attached involved transferring the exclusive right to use the business name, although she acknowledged that this would be usual. Further, Mr. Adlem had retained a business in his own name and by working with Newman had acquired his own goodwill to which Newman had consented, resulting in shared goodwill. On the issue of misrepresentation Mr. Adlem’s advertisements were small scale and were unlikely to have caused much confusion.

Implications for business acquisitions

The majority Court of Appeal judgment is supported by the facts. Although the goodwill in the trading name was not specifically dealt with in the sale agreement, and the facts of the case were complex and unusual, it is difficult to see what other goodwill there could have been in this type of business. The sum of £54,000 was paid for goodwill alone in relation to a business whose annual turnover was reportedly only £94,000 and it seems unlikely that the intention was not to transfer full rights to the business name. The High Court and the dissenting judgment in the Court of Appeal appear to defy the intention of the sale agreement and business efficacy generally. However, the dispute would probably have been avoided if the sale agreement had been absolutely clear in its terms on the transfer of the trading name and the permitted activities of Mr. Adlem following sale.

A string of parallel imports cases continued throughout 2005, further clarifying the law largely in favour of brand owners.

Parallel imports

A good year to be a brand owner

Trade from outside the EEA

The Courts gave a resounding “no” in 2005 to the unauthorised importation of branded consumer goods into the UK from outside Europe by third parties. The issue came to the fore in the lucrative electronics market, with middle men and traders seeking to benefit from high consumer demand for Sony's new PSP console and Hewlett Packard's personal organisers (*Sony v Nuplayer* and *Hewlett Packard v Expansys*).

In both cases the goods were sourced from the Far East with the aim either of undercutting UK prices or pre-empting the official UK launch date for the product. Sony and Hewlett Packard took legal action based on their registered trade marks to prevent this trade which disrupted their distribution chains within Europe. The ECJ had made clear in 2001 in the case of *Davidoff/Levi v Tesco/Costco* that unless the trade mark owner had given unequivocal consent to the sale of its branded goods within the EEA, the proprietor's rights would be infringed by any importation, sale or advertisements of such goods. The High Court had no hesitation in fully implementing that decision by granting summary judgment in favour of both brand owners on the same day.



The High Court had no hesitation in fully implementing the Davidoff decision by granting summary judgment in favour of both brand owners on the same day.



Inventive, but unsuccessful

The Court rejected an assortment of inventive arguments raised by the importers, finding that:

- a claim that the importer had removed Sony's trade mark from its products was not genuine and was as a practical matter impossible (although had it been possible, interesting questions would have arisen about the extent to which dealing in a “de-branded” product constitutes trade mark infringement)
- brand owners do not give the necessary consent just because they may not fully police their rights
- even if some parts of the brand owner's organisation may have acquiesced in exporting to Europe, for example by oversupplying particular local markets, this did not constitute consent
- the fact that sales and advertising took place over the internet was no defence to trade mark infringement
- the enforcement of trade marks by brand owners in these circumstances was not an abuse of their dominant position under Article 82 of the Treaty of Rome.

“
...the ECJ found that
the goods could not
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brand owner had firm
evidence that the
ultimate destination
was within the EEA.”

Similarly in the case of *Sportswear v Sarbett Ghattaura*, which involved the parallel importation of clothing sold with defaced labels, the Court struck out a defence raised by the importers under Article 81 of the Treaty of Rome based on the alleged anti-competitive conduct of the trade mark owner and his distributor. Even if there had been such conduct there was insufficient “nexus”, that is, an insufficient connection between the alleged breach of competition law and the infringement of trade mark rights. While there might be a separate claim under competition law the trade mark owner’s right to enforce his trade mark was unaffected.

These judgments confirm that brand owners do have clear powers to prevent the importation into the EEA of their goods. As always, the principal difficulties in bringing such actions are the practical ones of identifying defendants, tracking their activities and ensuring that a consistent approach has been taken throughout the brand owner’s organisation.

Trade within the EEA

The basic rule is of course that parallel trade is permitted across national European borders, but that there is an exception under trade mark law where the trade mark owner has “legitimate reasons” to object (Article 7(2) of the Trade Marks Directive). Currently, debate in this area focuses on the repackaging by importers of branded pharmaceutical products, which has culminated in the case of *Boehringer Ingelheim v Swingward*. The case, which has been active for over five years, is undergoing a second reference to the ECJ to determine in particular whether a parallel importer may “de-brand” (remove the manufacturer’s trade mark) or “co-brand” (add his own design elements or housestyle to new outer packaging). A hearing before the ECJ took place in January 2006, with the Advocate General’s opinion expected in April 2006, and hopefully a full judgment to follow before the end of this year. The result will be of importance not only to the pharmaceutical industry but to anyone involved with parallel imported goods.

Goods held at Customs

An interesting ECJ judgment was given in 2005 concerning the status of goods held by Customs within the EEA under the transit and warehousing procedures whereby they may be held in the EEA temporarily without incurring import taxes. In *Class International v Colgate Palmolive*, a consignment of imported AQUAFRESH toothpaste from South Africa was detained, believed to be counterfeit. In fact it was a genuine parallel imported product and the question arose as to whether the brand owner could use registered trade mark rights to prevent its onward transit. The destination of the goods was unknown and in these circumstances the ECJ found that the goods could not be impeded unless the brand owner had firm evidence that the ultimate destination was within the EEA. As yet they had not entered the EEA market. Thus there had been no infringing use.

Separate ownership of marks

Parallel trade will not be permitted in any event (whether within or from outside the EEA) where a trade mark is in the separate ownership of more than one party and the consent of both has not been demonstrated. Last year, in the case of *Bolton v Swinghope* a pharmaceutical company succeeded in preventing parallel trade of its branded product within the EEA because the trade mark, while owned by it in the UK, was owned by another entity in the country of export, whose consent was irrelevant to the question of exhaustion of Bolton’s rights. For this reason, the product had not been placed on the market with the consent of the UK trade mark owner and therefore was not free to move around the European market. The *Bolton* case follows well established European case law, set out in *Hag II* and *IHT Internationale*. Such a scenario is more common than may be imagined and will often occur following a transfer of some of the intellectual property rights connected with a brand as part of a corporate transaction. The defendant also failed in an estoppel

defence, the Court finding that a mere delay of five months on the claimant's part before raising complaint could not give rise to such a defence.

The future

Generally, it seems that the arguments available to defendants in parallel imports cases are themselves becoming exhausted, and with a result expected from the ECJ in the *Boehringer* case shortly, it is to be hoped that a further degree of clarity will be achieved to the benefit of both trade mark owners and those who deal in parallel imports.

“

...arguments available to defendants in parallel imports cases are themselves becoming exhausted...

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Analysis and statistics 2005

European Court of Justice 2005

Parties and Case No.	Mark	Issue	Held
Class International BV v Colgate-Palmolive Company and others (Case C-405/03)	AQUAFRESH	Entry of goods into Community where not previously been sold, trade mark rights, use of mark in the course of trade, onus of proof	Proprietor cannot make the placing of the goods conditional upon the existence of a final destination (failed on Article 5(1) and 3(c)), the proprietor may oppose the offering or sale of goods when it necessarily entails putting goods on Community market (succeeded on Art 5(3)(b), onus on proprietor to prove 5(3)(b))
Medion AG v Thomson Multimedia Sales Germany & Austria GmbH (Case C-120/04)	LIFE/THOMSON LIFE	Likelihood of confusion, interpretation of Directive, distinctiveness	Where identical goods/services there may be likelihood of confusion where the sign was composed of the company name (of another) and a registered mark with normal independent distinctiveness
BioID AD v OHIM (Case C-37/03 P)	BioID	Registration, distinctive character	Application dismissed, mark would be perceived as no more than a description of goods/services applied for
Praktiker Bau- und Heimwerkermarkte AG v Deutsches Patent- und Markenamt (Case C-418/02)	PRAKTIKER	Retail services trade mark application, interpretation of Directive	Details on nature and specifications of registrations for retail services
Société des produits Nestlé SA v Mars UK Ltd (Case C-353/03)	HAVE A BREAK	Distinctiveness of phrase, interpretation of Directive, distinctiveness acquired through use as part of or in conjunction with a registered mark	Distinctive character may be acquired through use as part of or with another composite mark
Eurocermex SA v OHIM (Case C-286/04 P)	3D mark of a bottle, plugged with slice of lemon (CORONA)	Distinctive character, distinctiveness acquired through use, 3D mark, absolute grounds for refusal	Application dismissed as lacking distinctive character
The Gillette Company and another v LA-Laboratories Ltd Oy (Case C-228/03)	GILLETTE and SENSOR	Packaging with stickers stating that the blades were compatible with Gillette's handles, spare parts, infringement of trade mark, "honest use"	Necessity of use to indicate intended purpose was critical, consideration of what constitutes honest use

Source: tables and statistics compiled from cases reported on the Westlaw, Butterworths All England Direct, New Law Online, UK Patent Office and OHIM websites. Other cases may have been reported elsewhere.

Court of First Instance 2005

Case Ref No.	Mark	Issue	Held
T-12/04	3D shape of a lemonade bottle	Whether shape registrable due to lack of distinctiveness	Application dismissed
T-164/03	MONBEBE	Likelihood of confusion: assessing similarity of marks and the goods	Application dismissed
T-336/03	MOBILIX	Likelihood of confusion: assessing aural/visual similarity of marks and the goods on a global assessment	Opposition dismissed
T-305/04	Smell of ripe strawberries	Whether the application should be allowed despite it being unable to be represented graphically	Application dismissed
T-379/03	CLOPPENBURG	Descriptiveness – registrability of place name	Registration allowed
T-379/03	HAI	Likelihood of confusion: assessing similarity of marks and the goods on a global assessment	Opposition dismissed
T-423/04	B K R	Likelihood of confusion: assessing similarity of marks and the goods	Application allowed
T-123/04	CARGO PARTNER	Distinctiveness in relation to specific services	Application dismissed
T-130/03	TRAVATAN	Likelihood of confusion: assessing similarity of marks and the goods and genuine use of the goods	Application dismissed
T-320/03	LIVE RICHLI	Distinctiveness in relation to the relevant public and its attentiveness/the public's perception/exclusive use of the mark/imaginativeness of the mark	Application dismissed
T-140/02	INTERTOPS	Whether mark was contrary to public policy not the conduct of the person applying for the mark	Application dismissed
T-178/03/ T-179/03	'DigiFilm' and 'DigiFilmMaker'	Distinctiveness of the mark and its individual elements	Application dismissed
T-312/02	SELENIUM-ACE	Likelihood of confusion: assessing similarity of marks and the goods and assessing which parts of the mark are dominant	Application dismissed
T-126/03	ALADIN	Likelihood of confusion: assessing similarity of marks and the goods and genuine use of the goods	Opposition allowed
T-301/03	CANAL JEANS CO	Likelihood of confusion: assessing similarity of marks and the goods and assessing which parts of the mark are dominant and the figurative element impact	Opposition dismissed
T-19/04	PAPERLAB	Descriptiveness of the mark in relation to the services/goods it sells	Application dismissed
T-385/03	BIKER MILES	Likelihood of confusion: assessing similarity of marks and the goods and assessing the overall impression of each mark and the previous mark's distinctiveness	Opposition allowed
T-186/04	SPAFORM	Interpretation of rule 18	Opposition rejected in part
T-7/04	Limoncello della Costiera Amalfitana	Likelihood of confusion: assessing similarity of marks and the goods, assessing the overall complexity of the applicant's mark, the dominant elements of the marks and their visual similarities	Application allowed
T-316/03	Munich Financial Services	Distinctiveness of mark, descriptive character, type of goods	Application dismissed
T-67/04	SPA-FINDERS	Likelihood of confusion: assessing similarity of marks and the goods, the reputation of the earlier mark and the distinctiveness of the word spa	Opposition dismissed
T-352/02	PC WORKS	Likelihood of confusion: assessing similarity of marks and the goods and their market, assessing the dominant element in the marks in context with the overall impression of the marks	Application dismissed
T-390/03	CM	Likelihood of confusion: assessing the degree of similarity between the marks and the goods/services and the target public's likely perception	Opposition dismissed
T-160/02 – T-162/02	Playing cards figures cards generally	Descriptiveness: assessing whether there was a general association between the marks and playing cards generally	Application dismissed
T-22/04	WESTLIFE	Likelihood of confusion: assessing the degree of similarity between the marks in the target public's view	Opposition allowed
T-269/02	RUFFLES	Demonstration of ownership and use of existing mark for opposition to proceed and fact of national registration of trade mark not sufficient to obtain CTM	Application dismissed

Source: tables and statistics compiled from cases reported on the Westlaw, Butterworths All England Direct, New Law Online, UK Patent Office and OHIM websites. Other cases may have been reported elsewhere.

Case No.	Mark	Issue	Held
T-318/03	ATOMIC BLITZ	Failure to provide evidence of renewal of earlier mark	Application allowed
T-273/02	CALPICO	Likelihood of confusion: assessing the degree of similarity (visual/aural/conceptual) between the marks	Opposition dismissed
T-211/03	FABER	Likelihood of confusion: assessing the degree of similarity between the stylised marks and the likelihood of confusion in the target public's view	Application allowed
T-380/02 and T-128/03	PAN & CO	Conditions governing notification of decisions by fax	Respondent entitled to effect notification by fax, application dismissed
T-260/03	CELLTECH	Distinctiveness of mark and its descriptive character as to the type of goods	Application allowed
T-112/03	FLEXI AIR	Likelihood of confusion: assessing the similarity between the marks and the type of goods	Application dismissed
T-185/03	ENZO FUSCO	Likelihood of confusion: assessing globally the similarity between the marks and the goods they applied to and the likelihood of confusion in the target public's view	Application dismissed
T-169/03	SISSI ROSSI	Likelihood of confusion: assessing the similarity between the marks and the type of goods	Opposition dismissed
T-169/02	NEGRA MODELO	Likelihood of confusion: assessing the overall similarity between the marks bearing in mind distinctive and dominant components and the goods they applied to and invalidity due to use	Application dismissed
T-296/02	LINDENHOF	Likelihood of confusion: assessing globally the public's perception of the goods, the similarity between the figurative marks and the type of goods	Opposition dismissed
T-57/03	HOOLIGAN	Likelihood of confusion: assessing language interpretations of words, visual similarity and the public's perception	Opposition dismissed
T-387/03	BIOKNOWLEDGE	Distinctiveness of mark and its descriptive character as to the type of goods	Application dismissed
T-334/03	EUROPREMIUM	Distinctiveness of mark and its descriptive character as to the type of goods- analysis of word premium	Application allowed
T-367/02 to T-369/02	SnTEM, SnPUR and SnMIX	Distinctiveness of chemical symbols and their descriptive character as to the goods they related to and the understanding/knowledge of the target consumer	Application dismissed
T-359/02	STAR TV	Likelihood of confusion: assessing the nature and method of use of goods/services, the end users and whether they were competitors as well as the overall similarity between the marks	Application dismissed
T-275/03	Hi-FOCuS	Evidential rules- admissibility of document	Application allowed- Document should have been taken into account
T-242/02	Top	Distinctiveness of mark and evidence used in support of acquired distinctiveness	Application dismissed
T-396/04	NICKY	Likelihood of confusion: assessing the similarity of the goods and the overall similarity between the marks	Application dismissed
T-3/04	KINJI	Likelihood of confusion: assessing overall similarity between the marks on a global basis as viewed by the public and the similarity between the goods	Opposition dismissed
T-346/04	ARTHUR ET FELICIE	Likelihood of confusion: assessing overall similarity between the marks viewed by the relevant public assessed globally and the similarity between the goods.	Application dismissed
T-135/04	Online Bus	Evidence of use of earlier mark (different to version shown for opposition) and likelihood of confusion between the marks	Application dismissed
T-154/03	ALREX	Likelihood of confusion: assessing globally the public's perception of the marks and the similarity of the goods/services as well as the overall similarity between the marks	Opposition allowed
T-29/04	Cristal Castellblanch	Genuine use of mark/ likelihood of confusion: assessing globally the public's perception of the marks and the similarity of the goods/services as well as the overall similarity between the marks	Application dismissed
T-169/04	CARPOVIRUSINE	Likelihood of confusion: assessing globally the particular consumer audience's perception of the marks and the similarity of the goods/services as well as the overall similarity and dominant features of the marks	Application dismissed
T-262 AND 263/04	Bic- 3D shape of lighter	Evidence of distinctiveness acquired through use	Application dismissed
T-384/04	clean.x	Likelihood of confusion: assessing the particular consumer audience's perception of the marks and the similarity of the goods/services as well as the overall similarity and features of the marks	Opposition dismissed

Source: tables and statistics compiled from cases reported on the Westlaw, Butterworths All England Direct, New Law Online, UK Patent Office and OHIM websites. Other cases may have been reported elsewhere.

Court of Appeal 2005

Parties and Case No.	Mark	Judge	Issue	Held
La Mer Technology Inc v Laboratoires Goemar SA [2005] ALL ER (D) 493 (Jul)	LABORATOIRE DE LA MER	Mummery LJ, Neuberger LJ and Black J	Revocation of trade mark for non-use, meaning of genuine use	Appeal allowed
IN Newman Ltd v Adlem [2005] ALL ER (D) 228 (Jun)	RICHARD T ADLEM	Jacob LJ, Tuckey LJ, Arden LJ	Assignment of goodwill in business name, passing off	Appeal allowed
R v McCrudden [2005] ALL ER (D) 309 (Feb)	General counterfeit goods	Laws LJ, Dame Heather Steel and HHJ Stephens QC	Unauthorised use of trade mark, criminal law, scope of defence for not having knowledge as to the trade mark infringement	Appeal dismissed
R v Sheik [2005] ALL ER (D) 393 (Apr)	NOKIA	Tuckey LJ, Christopher Clarke J, Sir Douglas Brown	Sentencing, use of trade mark without authority	Appeal dismissed

High Court 2005

Parties and Case No.	Mark	Judge	Issue	Held
Almighty Marketing Ltd v Milk Link Ltd [2005] ALL ER (D) 256 (Nov)	MOO JUICE	Kitchin J	Evidence of use required in revocation proceedings, no requirement to provide info of a specific nature so long as it amounts to an arguable case	Appeal allowed- owner established sufficient evidence
Bolton Pharmaceutical Co 100 Ltd v Swinghlope Ltd [2005] ALL ER (D) 224 (Jul)	KALTEN	Terence Mowschenson QC	Summary judgment: trade mark infringement for parallel imports, whether the defences had any real prospect of success	Summary judgment granted
Sales v Stromberg [2005] ALL ER (D) 368 (Jul)	VORTEX ENERGISERS	Wyand QC	Whether design right subsisting in design document, infringement of right, copyright	Infringement of design held
French Connection Ltd and others v Fresh Ideas Fashion Ltd and another [2005] ALL ER (D) 52 (Nov)	FCUK	Kitchin J	Use of similar trade mark, infringement, passing off, summary judgment	Application allowed
Intel Corporation v Intelsoft [2005] ALL ER (D) 346 (Oct)	INTELSTOFT	Mann J	Trade names, infringement, use of similar trade mark, whether questions were answered properly (upon request for further information)	Application allowed
Global Projects Management Ltd v Citigroup Inc and others [2005] ALL ER (D) 182 (Oct)	CITIGROUP.CO.UK	Park J	Trade name, unjustified threats of trade mark infringement, passing off	Application allowed
GMG Radio Holdings Ltd and others v Tokyo Project Ltd and another [2005] ALL ER (D) 155 (Oct)	HED KANDI	Kitchin J	Injunction, balance of convenience	Application dismissed
Sportswear Co Spa and another v Sarbeet Ghattaura (trading as GS3) [2005] ALL ER (D) 17 (Oct)	STONE ISLAND	Warren	Removal of clothing labels on genuine goods, defence of anti-competitive behaviour, parallel trade, trade mark infringement	Application dismissed
Wolters Kluwer (UK) Ltd (trading as CCH) v Reed Elsevier (UK) Ltd (trading as LexisNexis Butterworths) [2005] ALL ER (D) 96 (Sep)	CCH	Mann J	Advertisement of trade mark services, injunction, trade mark infringement	Application dismissed
Kabushiki Kaisha Sony Computer Entertainment and another v Electricbirdland Ltd [2005] ALL ER (D) 73 (Aug)	PLAYSTATION	Pumfrey J	Importation of goods bearing trade mark, consent, parallel trade, trade mark infringement	Application allowed
Wistbray Ltd v Creative Nature Ltd [2005] ALL ER (D) 52 (Aug)	DRAGONFLY	Blackburne J	Use of similar trade mark, likelihood of confusion, trade mark infringement	Opposition allowed
General Cigar Co Inc v Partagas y Cia SA [2005] ALL ER (D) 505 (Jul)	CIFUENTES	Lawrence Collins J	Trade mark registration, disclaimer, disclaimed part as to similarity between the marks	Application dismissed
Argentum Ltd v Middlesex Silver Co Ltd [2005] ALL ER (D) 378 (Jul)	ARGENTUM	Patten J	Non-use, revocation, evidence of use, evidential formalities	Appeal allowed
Hays plc and another v Hays Montrose [2005] ALL ER (D) 377 (Jul)	HAYS/MONTROSE	Rimer J	Trade mark infringement, judgment in default of defence	Appeal dismissed
Realtors UK Ltd v National Association of Realtors [2005] ALL ER (D) 374 (Jul)	REALTOR	Mann J	Opposition to registration	Appeal dismissed
Kabushiki Kaisha Sony Computer Entertainment and another v Nuplayer Ltd [2005] ALL ER (D) 188 (Jul)	PLAYSTATION	Lawrence Collins J	Parallel imports, trade mark infringement, internet sales	Application allowed
Hewlett-Packard Development Company LP and another v Expansys UK Ltd [2005] ALL ER (D) 170 (Jul)	HO/IPAQ	Laddie J	Summary judgment, parallel imports, trade mark infringement	Application allowed
Betafence Ltd v Registrar of Trade Marks [2005] ALL ER (D) 346 (Jun)	Shape of wire fencing	Floyd QC	Registration of trade mark, distinctiveness	Appeal dismissed
Re Mitsubishi Corporation Ltd [2005] ALL ER (D) 82 (Jun)	MITSUBISHI	Evans-Lombe J	Injunction, infringement of trade mark, balance of convenience	Application allowed

Source: tables and statistics compiled from cases reported on the Westlaw, Butterworths All England Direct, New Law Online, UK Patent Office and OHIM websites. Other cases may have been reported elsewhere.

Parties and Case No.	Mark	Judge	Issue	Held
Play It Ltd and another v Digital Bridges Ltd [2005] ALL ER (D) 185 (May)	PLAY IT	Sir Andrew Morritt V-C	Injunction, passing off	Modified application allowed – injunction granted subject to a guarantee on the cross undertaking in damages
O2 Holdings Ltd and another v Hutchison 3G UK Ltd [2005] ALL ER (D) 195 (Mar)	O2/bubbles	Sir Andrew Morritt V-C	Comparative advertising, trade mark infringement, application to refer questions to the ECJ	Application dismissed
Phones 4u Ltd and another v Phone4u.co.uk Internet Ltd and others [2005] ALL ER (D) 143 (Mar)	PHONES 4 U	Richard Sheldon QC	Trade mark infringement, passing off, deception, damage to reputation and goodwill, limitations of registered trade mark	Claim dismissed
Eurodrive Car Rental Ltd v Enterprise Rent-a-Car [2005] ALL ER (D) 31 (Mar)	e	Laddie J	Opposition to registration, likelihood of confusion	Appeal dismissed
L'Oréal SA and others v Bellure NV and others [2005] ALL ER (D) 243 (Jan)	PERFUMES	Hart J	Trade mark infringement, similar mark and identical goods, application to strike out some of Particulars of Claim	Application dismissed
Hormel Foods Corporation v Antilles Landscape Investments NV [2005] ALL ER (D) 206 (Jan)	SPAMBUSTER	Richard Arnold QC	Revocation of trade mark, estoppel/abuse of process, distinctiveness	Claim dismissed
Condé Nast Publications Ltd v Peers Hardy (UK) Ltd [2005] ALL ER (D) 21[2005] ALL ER (D) 21 (May)	VOGUE	Pumfrey J	Passing off, application for 2nd expert witness evidence	Application dismissed

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Appeals to Appointed Person 2005

Reference Number	Mark	Hearing Officer	Issue	Held
O/333/05	m.d.e.m.	Richard Arnold QC	Jurisdiction of AP to reconsider decision in exceptional circumstances	Appeal dismissed
O/306/05	m.d.e.m.	Richard Arnold QC	Relative grounds: similarity of services	Cross appeals allowed in part, dismissed in part
O/305/05	Ben Sherman merchandising	Richard Arnold QC	Relative grounds: similarity of goods/services	Appeal dismissed and opposition upheld
O/282/05	OMEGA CONSTELLATION	Prof Ruth Annand	Partial revocation for non-use: genuine/internal use	Specification restricted (as amended)
O/281/05	OMEGA	Prof Ruth Annand	Partial revocation for non-use: genuine/internal use	Specification restricted (as amended)
O/261/05	MOTOWN	David Kitchin QC	Appeal against interlocutory decision; revocation for non use	Appeal dismissed
O/253/05	LE SPOSE DI GIO'	Geoffrey Hobbs QC	Relative grounds: comparison of marks, English equivalents	Appeal dismissed: relative grounds upheld
O/252/05	SKORPI	Geoffrey Hobbs QC	Relative grounds: comparison of marks	Appeal dismissed: no relative grounds
O/251/05	WISI	Geoffrey Hobbs QC	Full revocation	Appeal successful (in part). Mark restored, but with reduced specification
O/249/05	SIMPLYCLICK	David Kitchin QC	Refusal of registration on absolute grounds: descriptive	Appeal dismissed, but returned to Registrar on amended specification
O/238/05	EXCEL	Richard Arnold QC	Relative grounds: marks used concurrently	Appeal dismissed: relative grounds upheld
O/236/05	BACTI GUARD	David Kitchin QC	Appeal against interlocutory decision; strike-out of proceedings for alleged breach of delimitation agreement; restraint of trade	Appeal dismissed, but returned to Registrar for further factual investigation
O/227/05	OMEGA	Prof Ruth Annand	Relative grounds: similarity of goods/services	Appeal dismissed: relative grounds upheld
O/226/05	BARNEYS	David Kitchin QC	Relative grounds: opposition refused	Appeal dismissed: no relative grounds
O/218/05	power bat ENERGY DRINK	Richard Arnold QC	Relative grounds: similarity of marks	Appeal dismissed: opposition upheld
O/191/05	YORK	Geoffrey Hobbs QC	Order to treat opposition to revocation as withdrawn	Appeal allowed: order set aside
O/182/05	FOOK	David Kitchin QC	Absolute grounds: public policy/morality	Appeal dismissed: absolute grounds upheld
O/181/05	FAIRLIGHT	David Kitchin QC	Costs	Cost award made
O/180/05	CRYSTAL	David Kitchin QC	Costs	Cost award made
O/169/05	BUFFALO CREEK	Richard Arnold QC	Relative grounds: similarity of marks	Appeal dismissed: relative grounds upheld
O/168/05	Michaels DRINKS STOP	Geoffrey Hobbs QC	Objection to amendment of application	Appeal dismissed
O/144/05	PENGUIN/THE PENGUIN	Geoffrey Hobbs QC	Relative grounds: similarity of marks	Appeal dismissed
O/141/05	KO BOXER	Prof Ruth Annand	Relative grounds: similarity of marks, well known marks	Appeal allowed: likelihood of confusion established
O/127/05	The QUORN HUNT	Geoffrey Hobbs QC	Settlement and discharge of opposition	Appeal allowed
O/122/05	Isosceles CONSULTING INC VITALITY DRIVER	Prof Ruth Annand	Total revocation: evidence of use	Appeal dismissed: revocation upheld

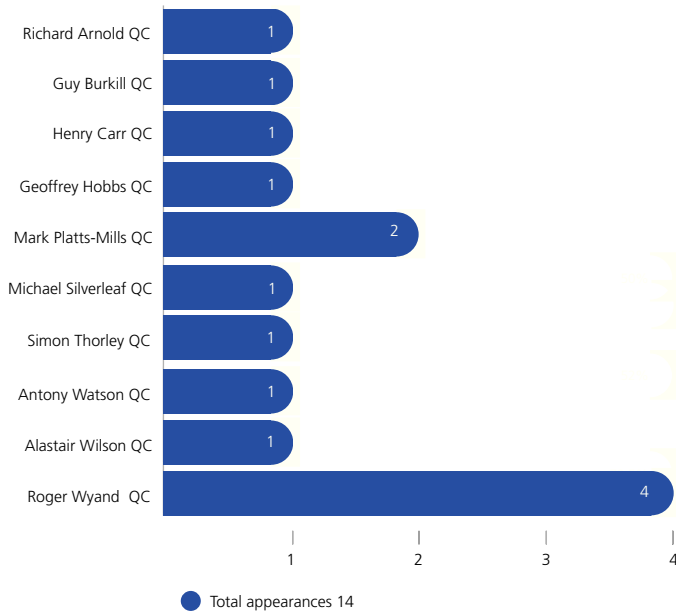
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Reference Number	Mark	Hearing Officer	Issue	Held
O/121/05	JAIL HOUSE ROCK	Geoffrey Hobbs QC	Total revocation, agreement to assign	Decision set aside by consent
O/081/05	NATURALLY SMOOTH	Geoffrey Hobbs QC	Lack of distinctiveness	Appeal dismissed
O/080/05	MOVIE STAR	Richard Arnold QC	Costs appeal on interim decision	Appeal dismissed
O/079/05	CARSMART	Richard Arnold QC	Relative grounds: similarity of marks, interdependence	Appeal allowed in part, dismissed in part: likelihood of confusion on part of specification
O/053/05	TRIDENT	Prof Ruth Annand	Partial revocation for non-use	Appeal allowed in part, specification reduced
O/043/05	MERLIN	Richard Arnold QC	Relative grounds: similarity of services, interdependence, distinctiveness, passing off	Appeal allowed in part, dismissed in part
O/035/05	LINKIN PARK	Richard Arnold QC	Absolute grounds: "celebrity" trade marks, distinctiveness for certain goods	Appeal dismissed
O/021/05	JESUS	Geoffrey Hobbs QC	Absolute grounds: public policy/morality	Appeal dismissed: absolute grounds upheld
O/013/05	WALKERLAND	Prof Ruth Annand	Application in bad faith	Appeal dismissed: bad faith established
O/012/05	LE MANS	Richard Arnold QC	Relative grounds: passing off, misrepresentation	Appeal allowed: opposition upheld

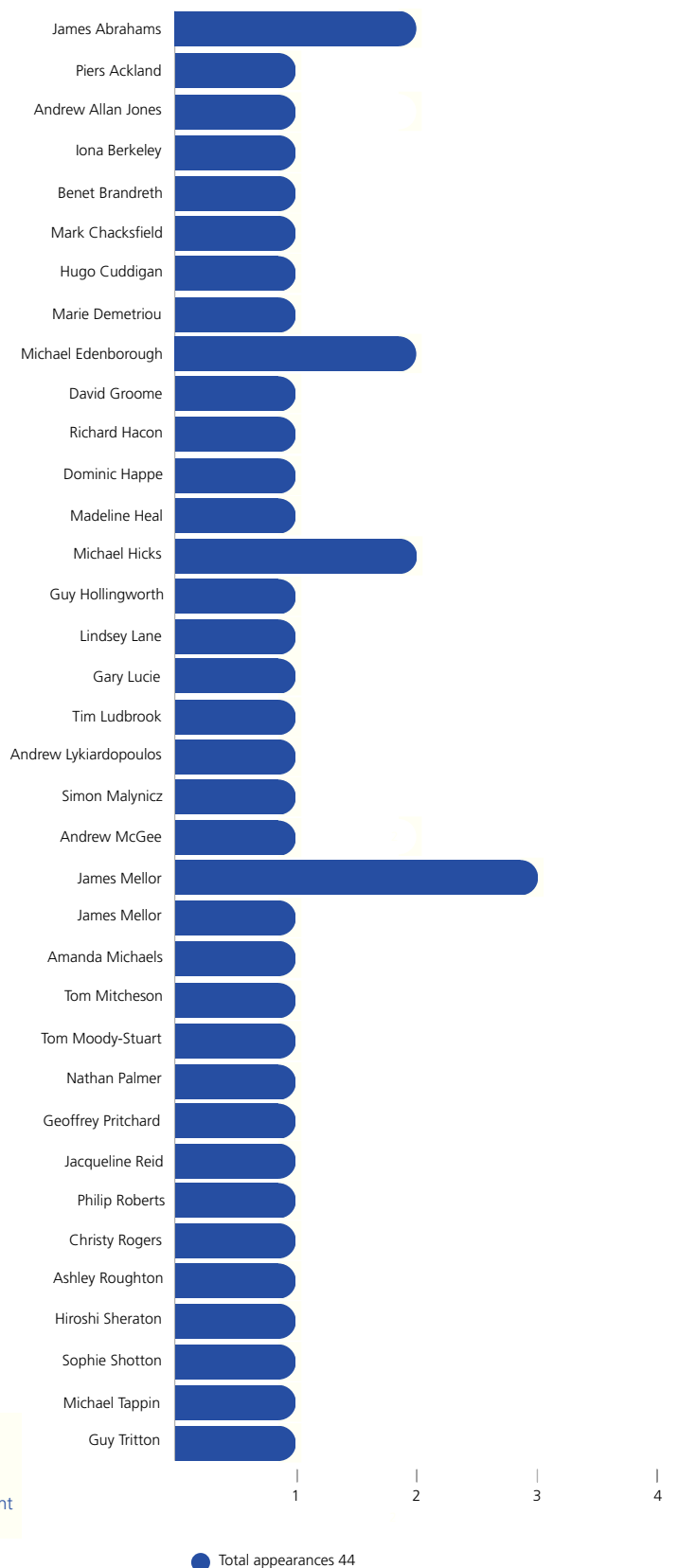
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Counsel appearances 2005

Leading counsel



Junior counsel



Source: tables and statistics compiled from the High Court and Court of Appeal cases reported on the Westlaw, Butterworths All England Direct, New Law Online, UK Patent Office and OHIM websites.

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