

July 2004

Brands update



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Main news

"Suggestive" trade marks - the legal mystery continues (Part 5)

Regular readers of this publication will know that, when it comes to ascertaining exactly what types of marks with possible descriptive meanings (and/or which allude to, or suggest the characteristics of the goods/services for which registration is sought) are not capable of registration, the answer remains something of a legal mystery.

While marks such as COMPANYLINE (for insurance and financial affairs) and BLOOD PRESSURE WATCH (for blood pressure meters) have been found to be incapable of registration, other marks such as BABY DRY (for nappies) and EASYBANK (for banking and banking services) have been registered.

A recent example of the difficulty of ascertaining exactly what types of mark are not capable of registration involved an application by Avon Cosmetics to register the word mark CLEAN CREAM as a United Kingdom trade mark for toiletries, cosmetics, perfumes and other similar goods.

Johnson & Johnson opposed the application, alleging that the words CLEAN CREAM described the essential characteristics of the products of interest and were not capable of being distinctive of a particular trader's goods. As a consequence, the company asserted that the words should not be registered as a trade mark for the goods in issue.

The Hearing Officer deciding the case held that, whilst the words CLEAN CREAM alluded to the products of interest and their characteristics, they were not the normal way of describing such products or their characteristics. Further, he held that whilst the mark CLEAN CREAM consisted of "two standard English words", it exhibited a "syntactically unusual juxtaposition of those words" and was of an "unusual nature". As a result, he felt that the mark could be distinctive of a particular trader's goods, was not devoid of any distinctive character in relation to the products of interest and allowed the mark through to registration.

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Other news

"Suggestive" trade marks - the legal mystery continues (Part 6)

Following on from the CLEAN CREAM decision, the UK Trade Marks Registry has rejected an application to register as a UK trade mark a device mark incorporating a common drawing of a star between the words NATURAL and WHITE, for goods such as toothpaste, cosmetics and soaps.

The Registry held that the average consumer of such goods would see the mark as an indication of the purpose or the nature of the goods for which registration was sought and not as an indication of the trade origin of the goods. The words NATURAL and WHITE in combination were "ordinary words" with "an obvious meaning", namely, to "describe goods that are designed to give or restore a white that is natural in colour, or goods that are natural white in colour". Further, the star element of the mark was commonly used on products such as dental products, such that the average consumer of such goods would see it as "mere decoration" or "an indication of the purpose of the goods".

"Suggestive" trade marks - the legal mystery continues (Part 7)

The UK Trade Marks Registry has also rejected an application to register the mark NATURALLY SMOOTH as a UK trade mark for moisturisers, including shave minimising moisturisers for women.

As in the CLEAN CREAM case, the Registry held that the average consumer of such goods would see the mark as a "message about the intended purpose of the goods" and would not consider the mark as denoting the trade origin of goods bearing the mark. The mark served only to "designate one of the essential characteristics of the goods ... It clearly conveys to customers that these moisturisers will have the effect of leaving the skin feeling 'naturally smooth'".

As a consequence, it was held that the mark would not be seen as a trade mark, serving to distinguish the goods of one trader from those of other traders, without first educating the public that it was a trade mark. The effect of this was that the mark was excluded from registration, on the basis that it was devoid of any distinctive character.

LE MANS - a racing certainty

The Automobile Club de l'Ouest de la France ("ACO"), the organisers and managers of the famous 24 hour Le Mans motor car race, have failed to prevent the registration by Le Mans Autoparts Ltd of the word mark LE MANS as a UK trade mark for car parts and fittings.

This case follows hot on the heels of the failure by the University of Oxford to invalidate a third party's registration for the mark OXFORD BLUE for clothing (as reported in the last edition of Brands Update).

The UK Trade Marks Registry, when deciding the opposition proceedings brought by ACO against Le Mans Autoparts Ltd's application, declared that it was not convinced that the name LE MANS is seen and regarded as a trade mark by the relevant public in the UK.

Whilst it acknowledged that LE MANS has a "well-known significance as the name of a place at which an annual motor racing event occurs" and that "the name is indicative in the UK of a car race in France", it found that there was no "commercial notoriety associated with the name" in the UK. There had been no trade in goods in the UK by ACO under the LE MANS name and mark, such as to lead the relevant public in the UK to regard the mark as a trade mark denoting the origin of those goods.

At best, ACO could show that it owned a goodwill under the name LE MANS 24 HOURS as the race organiser of the famous car race in France. However, this goodwill was not sufficient to prevent Le Mans Autoparts Ltd from registering the word mark LE MANS for car parts and fittings (although it may well have been sufficient if Le Mans Autoparts Ltd had sought to register the mark for "entertainment" services, such as the organising of a car race or a series of car races in the UK).

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In the OXFORD BLUE case, it was found that the University of Oxford had never conducted any trade or business under the mark OXFORD BLUE and, as a consequence, the University could not prevent a third party from registering the mark for clothing goods.

In the LE MANS case, whilst ACO could not show that it had sold any goods in the UK under the LE MANS mark, in contrast Le Mans Autoparts Ltd proved to the satisfaction of the Registry that it had sold a variety of car parts and fittings under the mark LE MANS in the UK, prior to the date it filed its application to register the mark as a UK trade mark. As a consequence, the Registry held it had "sufficient a reputation amongst its customer-base so as to generate a trade mark right" and allowed the mark through to registration.

The case is also a lesson in how not to prepare and file evidence in UK trade mark opposition proceedings. The Hearing Officer deciding the case felt that large parts of the evidence filed on behalf of ACO was "irrelevant material". As the Hearing Officer declared: "The object of good evidence is to marry the grounds pleaded to the material needed to be adduced to support them. This the Opponent [ie ACO] singularly failed to do."

Clean judgments for the detergent cases

The European Court of Justice has finally handed down its judgments in the three appeal cases involving applications by Procter & Gamble and Henkel to register as Community Trade Marks a number of three-dimensional square tablets, for use as detergents in washing machines and dishwashers.

In all three cases the Court upheld the first instance decisions of the OHIM examiners and refused to register as Community trade marks the three-dimensional tablets, on the basis that the tablets were not capable of operating as trade marks, as they were devoid of any distinctive character.

The Court held that, in principle, a sign consisting of the three-dimensional shape of a tablet for use as a detergent in washing machines or dishwashers, in combination with the arrangement of the tablet's colours, could constitute a trade mark.

However, that does not mean that the tablet is capable of registration. The question is whether the tablet has "distinctive character" (ie whether it is capable of identifying the products in respect of which registration is sought as originating for one particular undertaking and therefore distinguishing those products from the products of other traders).

"Distinctive character" is to be assessed by reference to the products or services in respect of which registration is sought and by reference to the perception of them by average consumers of the products or services in question, who are reasonably well informed, observant and circumspect.

The Court further held that the criteria for assessing the distinctive character of three-dimensional-shape-of-products marks are no different from those applicable to other categories of trade mark. Nonetheless, the public's perception "is not necessarily the same in relation to a three-dimensional mark consisting of the shape and colours of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent from the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark".

Thus, the closer the shape for which registration is sought resembles the shape taken by the product for which registration is sought, the more likely the shape will be held to be devoid of any distinctive character: "Only a trade mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character".

In the three cases before the Court, all of the washing and dishwasher tablets for which registration was sought were held to contain common, non-distinctive features. As a result, the marks were refused registration.

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Red Bull doesn't give you Sinergy

The owners of RED BULL, the well-known energy drink, have failed to obtain an interim injunction preventing Mean Fiddler (which operates numerous music venues, bars and festivals) from selling a rival energy drink called SINERGY.

Whilst the English judge hearing the application agreed that the presentation and get-up of the SINERGY can was "strikingly similar" to the design of the well-known RED BULL can, the prominence of the brand names on each of the respective cans meant that anyone who looked at and read the front of the SINERGY can would not be deceived into thinking that the product was RED BULL, or an associated or sister drink from the manufacturers of RED BULL.

The judge held that the SINERGY brand name was simply too different from the name RED BULL and would dispel the possibility of deception arising amongst the relevant public, particularly as the target audience for both drinks (18-30 year olds) are, in the judge's own words "acutely brand aware".

The case highlights the fact that, in cases where the packaging and get-up of two rivals' products are very similar, this may not be enough to give rise to claim of passing off if the brand names of the two products are too dissimilar. Each case will depend upon its own facts and, in particular, the manner and circumstances in which the two products are presented, marketed and sold to the relevant public.

Picaro is no Picasso

The Picasso estate has failed to prevent the registration of the mark PICARO as a Community Trade Mark for vehicles, parts for vehicles, motor cars, trucks and vans.

The European Court of First Instance held that PICASSO has a "clear and specific semantic content for the relevant public", namely the famous painter Pablo Picasso. The use of the mark PICASSO as a brand name for motor vehicles would not, as far as the average consumer was concerned, override its perception as being the name of the famous painter. Further, the fact that the mark PICASSO was well known as corresponding to the name of the famous painter did not mean that this would heighten the likelihood of confusion between the marks PICASSO and PICARO when used on motor vehicles.

As far as the Court was concerned, the similarity of the marks was not sufficient to give rise to a conclusion that the relevant public might think that the goods in question came from the same undertaking, or economically linked undertakings. As a consequence, it held there was no likelihood of confusion between the two marks.

Alexander McQueen v. McQueen Clothing Co

Alexander McQueen, the well-known fashion designer, has failed on appeal to uphold a first instance finding by the UK Trade Marks Registry that, based on his earlier registration and use of the mark ALEXANDER McQUEEN, there would be a likelihood of confusion, misrepresentation and damage if it permitted an independent third party to register the mark McQUEEN CLOTHING Co for bags, trousers for casual wear, t-shirts, sweatshirts, jackets and tops.

Mr Geoffrey Hobbs QC (acting as an Appointed Person authorised to hear appeals from first instance decisions of the UK Trade Mark Registry) held that he did not believe that the evidence before him supported the proposition that the name McQUEEN by itself would be interpreted as a reference to the mark and name ALEXANDER McQUEEN by the average consumer of the goods concerned at the date of the opposed application for registration of the mark McQUEEN CLOTHING Co. Thus, in his view, the marks ALEXANDER McQUEEN and McQUEEN CLOTHING Co could "co-exist in the marketplace without giving rise to a likelihood of confusion".

Mr Hobbs was also not persuaded that, through Alexander McQueen's use in trade of the mark ALEXANDER McQUEEN since about 1990, this meant that he could prevent the registration of the mark McQUEEN CLOTHING Co. The evidence showed that the mark McQUEEN CLOTHING CO had been used in the UK since before 1990 for the goods in issue. This predated any use made by Mr McQueen of the name and mark ALEXANDER McQUEEN.

However, he did agree that there would be a likelihood of confusion between an earlier Community trade mark application made by Alexander McQueen for the mark McQUEEN and the mark McQUEEN CLOTHING Co. In his opinion, the use of the additional words CLOTHING Co were not sufficient to enable the two marks to co-exist in the marketplace without giving rise to a likelihood of confusion. Thus, subject to the Community trade mark application

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for the mark McQUEEN proceeding to registration, he upheld this aspect of the first instance decision of the UK Trade Marks Registry and ruled that the application to register the mark McQUEEN CLOTHING Co should be refused if and when the Community trade mark application proceeded to registration.

It is interesting to note that Mr Hobbs rejected a request by the owner of the McQUEEN CLOTHING Co mark to have the determination of the opposition proceedings stayed, pending final determination of invalidity proceedings that the owner of the McQUEEN CLOTHING Co mark intended to bring against the Community trade mark application for the mark McQUEEN. Mr Hobbs felt that to grant a stay in such circumstances would only prolong the "uncertainty as to the status of the application for registration [of the mark McQUEEN CLOTHING Co]" and he concluded that this would not be in the interests of either party.

Immoral and distasteful

An application to register the word FOOK as a UK trade mark for clothing, footwear and headgear, has been rejected on the basis that the mark is contrary to public policy and to accepted principles of morality.

The Registry took the view that, in certain parts of the United Kingdom, aural use of the word FOOK would be interpreted by many as aural use of a well-known, offensive, swear word. Further, when seen, the word FOOK would be identified as "no more than a visual rendition" of the aural pronunciation of this offensive taboo word.

The applicant sought to convince the Registry that the mark was registerable on various grounds, including the fact that the word is, allegedly, an acronym for "Friends only OK"; that there are already UK and Community registered trade marks for the mark FCUK; and the fact that FOOK is both a Chinese surname and a Chinese word meaning "Blessing."

The Registry was not convinced of these arguments and held that the word FOOK, when used in relation to the goods for which registration was sought, "would cause greater offence than mere distaste to a significant section of the general public." Thus, it was excluded from acceptance as a UK registered trade mark.

A big blue indeed

An application to revoke a UK trade mark registration for a logo mark incorporating the words BIG BLUE (for computers, computer parts and fittings and computer software and programs) has succeeded, on the basis that the mark had only been used by the proprietor, in the period of five years following its registration, in respect of services and not the goods for which the mark was registered.

The Hearing Officer deciding the case explained that the registered proprietor's business involved the sale and supply of computer hardware and software by mail order, telephone, fax and via the Internet. The goods sold were branded goods of third party manufacturers (e.g. Compaq, IBM, Toshiba, etc). None of the goods sold by the proprietor were branded with the BIG BLUE logo mark.

This led the Hearing Officer to conclude that the mark had only been used by the proprietor in relation to retail services and not in relation to the goods for which the mark was registered (e.g. through trading in own-branded goods bearing the BIG BLUE logo mark). As a consequence, the mark was liable to be revoked.

The case highlights the importance of filing carefully drafted and well thought out trade mark specifications. Brand owners need to ensure that the specifications for which they seek to register their trade marks reflect the reality of their trading situations. If not, their marks will be vulnerable to revocation.

Coco goes nuts

Chanel Limited ("Chanel") has successfully opposed an application by Coco de Mer Limited to register a device mark incorporating the words COCO DER MER, together with the image of a Coco de Mer palm tree nut, for goods such as perfumes, cosmetics, jewellery, clothing and bags.

Mr Justice Patten, hearing the case on appeal from the UK Trade Marks Registry, upheld the Registry's decision that there would be a likelihood of confusion between Chanel's COCO trade mark and the applicant's COCO DE MER device mark.

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He agreed with the Registry that the average consumer would not understand what the phrase COCO DE MER meant and would regard the first part of the phrase, namely COCO, as "clearly the most catchy part of the phrase and the one element in it which is more likely to attract consumers' attention than the remaining two words DE MER or the graphic style in which the words are presented."

In his view, the average consumer would regard the word COCO as the distinctive element of the COCO DE MER device mark. As a consequence, he held that the average consumer might well assume that there was an economic link between goods bearing the word mark COCO and identical goods bearing the COCO DE MER device mark, believing that the later "are simply a brand or variant of those marked COCO", and upheld the Registry's decision to reject the application for registration of the COCO DE MER device mark.

It is interesting to note that Mr Justice Patten acknowledged in his written judgment that no evidence had been put before him, or the Registry, of any actual confusion arising in the marketplace. Nevertheless, he was still of the view that a likelihood of confusion existed and that therefore the application was not capable of registration as a UK trade mark.

Is it in our nature, or is it our nature?

In a case before the UK Trade Marks Registry, it has been held that the mark ELVEDEN IT'S OUR NATURE is not registerable for goods which are identical or very similar to those for which the mark IT'S IN OUR NATURE is registered, because there is a likelihood of confusion.

Mr Mike Reynolds, hearing the case on behalf of the Registry, declared that, whilst the slogan IT'S IN OUR NATURE had a low degree of distinctiveness (being a slogan comprised of ordinary English words, producing an "unremarkable and natural" expression), there was, nevertheless, a high degree of visual, aural and conceptual similarity between this slogan and the words IT'S OUR NATURE, "particularly when allowance is made for imperfect recollection."

Although, in his view, the additional word ELVEDEN did enable the respective marks to be distinguishable from one another, he nevertheless felt that the word ELVEDEN might well be seen by the relevant public as a "previously unobserved housemark" which belonged to the owners of the IT'S IN OUR NATURE trade mark. As a consequence, he could not allow the mark ELVEDEN IT'S OUR NATURE to proceed to registration for goods identical or very closely similar (i.e. "such that they could be expected to appear in close proximity in a retail trading environment") to those for which the earlier mark IT'S IN OUR NATURE is registered.

Ms and Mizz can co-exist

The result of two recent appeals from first instance decisions of the UK Trade Marks Registry is that the marks Ms and MIZZ have been found capable of co-existing, when used in respect of magazines for girls and young women.

In the first case, IPC Media Limited (the owner of the MIZZ mark) opposed an application by Liberty Media for Women LLC to register the mark Ms for periodical magazines for women. The Registry rejected the opposition and this decision was upheld on appeal.

Whilst it was acknowledged that a magazine under the title MIZZ had first been published in the UK by IPC before Liberty first published its Ms Magazine in the UK, it was not felt that consumers would be confused between the two titles, such as to lead to a finding that Liberty was guilty of misrepresentation, or to have "trespassed onto [IPC's] goodwill". The Hearing officer declared that he did "not consider that there is much in the way of source motivation in the purchase of a magazine, the selection being primarily based on the content."

In the second case, Liberty (the owner of the Ms mark) opposed an application by IPC to register the mark MIZZ for magazines for teenage girls and young women. The Registry rejected the opposition and the decision was also upheld on appeal. It was felt that consumers would be "well able to distinguish one title from another."

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Advertising and the ASA

Ofcom has announced proposed changes to the regulation of television and radio advertising.

Under the proposals, the Advertising Standards Authority ("ASA"), which currently deals only with non-broadcast advertising, will be responsible for the self-regulation of all advertising content across all media, providing "a single letterbox for all complaints, in a co-regulatory partnership with Ofcom."

If the proposals are approved by both Houses of Parliament, the intention is to introduce the new system on the 1st of November this year, subject to a probationary period of two years. Following a successful completion of this probationary period, the intention is for the system to operate for a further eight years, before being subject to renewal by Ofcom.

Streamlining the trade mark registration process

The US Patent and Trade Mark Office, the Japan Patent Office and the Community Trade Mark Authorities ("OHIM") have agreed on a list of identifications and classifications for goods and services that will be accepted in respect of trade mark applications filed in any of the three offices.

The initial list has over 7,000 entries. Those who use designations taken from the list to describe and classify the goods and/or services for which they seek registration will have the comfort of knowing that examiners in each of the three offices will accept the applications. This should enable a faster examination service and will provide greater certainty to trade mark owners.

The intention is that further additional identifications and classifications will be added to the list as and when the three offices agree to new designations of goods and services.

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Tip of the month

Many readers may already be aware of this month's tip, but we thought it was worth reporting it nevertheless.

When, as a brand owner, you are looking to file an application to register your mark in the UK as a trade mark, it is prudent first to carry out a clearance search to check that your mark does not conflict with any earlier registered marks.

As a consequence of carrying out such a clearance search, brand owners often discover that, whilst there are no earlier registrations for an identical mark to the one for which they seek registered protection, there are a number of marks that could be regarded as "similar" marks.

In such circumstances, if a brand owner files an application to register its mark as a UK trade mark it is quite possible that the UK Trade Marks Registry might reject the application, unless it can be convinced by the brand owner that the marks can co-exist and will not lead to confusion in the marketplace. This will take time, cost money, will delay the application and, ultimately, there is no guarantee that the brand owner's argument will succeed.

Such a situation is particularly frustrating for a brand owner where they are convinced that the Registry is being over cautious (ie because, in reality, the brand owner has a fairly good idea that the owner of the earlier "similar" trade mark would not, of its own volition, oppose the brand owner's application to register its mark).

If, as a brand owner, you think you will be faced with such a possibility if you file a trade mark application in the UK, due consideration should be given to filing an application for a Community trade mark, either as an alternative to or in addition to, making a UK-only application. This is because OHIM (the organisation responsible for determining the registrability of Community trade mark applications) cannot, of itself, reject an application on the basis of an earlier registration for a similar mark to the mark for which registration is sought. It can only do so following the bringing of successful opposition proceedings by the owner of the early similar mark.

Please bear in mind, though, that filing for a Community trade mark, rather than a UK trade mark, may, as a consequence, present a brand owner with an entirely new set of problems (which time and space do not permit us to cover in this article). Whether it is better overall to file for a UK, rather than a Community trade mark, or vice versa, will depend upon a variety of factors and the circumstances of each case. Professional advice should therefore always be sought before you decide how best to proceed.

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For further details on any of the topics raised in this update please contact one of the individuals named below or your usual contact at Taylor Wessing, who will be pleased to answer your queries.

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