

May 2005

Brands update



Contents

Main news	Print this section (page 2)	
Breaking up of trade marks		<i>more</i>
Other news	Print this section (pages 3-5)	
Lapping it up - Victory at Le Mans		<i>more</i>
Don't fence me in		<i>more</i>
Cowell wins again.		<i>more</i>
A little knowledge goes a long way Tin Tin		<i>more</i>
Stand up for Jesus.		<i>more</i>
A premium trade mark		<i>more</i>
Use all at sea		<i>more</i>
Tip of the month	Print this section (page 6)	
No two bites of the SPAM cherry		<i>more</i>
Contacts		

Main news

Breaking up of trade marks

The UK general public, even those who do not eat chocolate biscuits, are familiar with Nestlé's slogan mark HAVE A BREAK ... HAVE A KIT KAT. It is likely that for many of us, the phrase "Have a break" would prompt the response "Have a Kit Kat". The nub of the legal issue recently referred to the European Court of Justice ("ECJ") following a reference by the English Court of Appeal is whether HAVE A BREAK could acquire distinctive character through use in the market of the composite slogan HAVE A BREAK ... HAVE A KIT KAT.

In her opinion, the Advocate General acknowledges that use of a word sequence as part of a word mark can, in principle, lead to that word sequence acquiring the necessary distinctive character for registrability as a trade mark. Any use of a sign can count towards the acquisition of distinctive character. Registration of part of a mark, which is not in itself inherently distinctive, is only possible if, as a result of use of the principal mark, the public perceive the part of the mark in question in itself as an indication of origin.

Here lies the sting in the tail for Nestlé. The Court of Appeal ruled that HAVE A BREAK is inherently non-distinctive. Therefore, assuming the ECJ follows Advocate General Kokott's Opinion, the UK court must be satisfied on Nestlé's evidence that, at the date of application for registration as a result of the use of HAVE A BREAK ... HAVE A KIT KAT, the relevant buying public perceived HAVE A BREAK as an indication of origin. The reflex reaction that causes many relevant consumers to complete the slogan HAVE A BREAK with HAVE A KIT KAT is not sufficient on its own to prove distinctive character.

[Contents page](#)

Other news

Lapping it up - Victory at Le Mans

The organisers of the Le Mans race have successfully overturned a decision of the Trade Mark Registry which rejected their opposition to an application for LE MANS. This had been filed by a UK company for a variety of car parts. The Appointed Person decided that the mark LE MANS did function as a trade mark and distinguished the organisation of motor racing events provided by the opponent from those of other businesses. He stated that it did not matter that the public did not know the identity of who provided the services. He also decided that LE MANS was a well known trade mark. This case sets out useful criteria for deciding whether a mark is well known including the degree of recognition of the mark, the extent and how long it has been used, the extent of advertising and publicity of the mark, if there are trade mark registrations for the mark and the value associated with the mark. In light of this, the Appointed Person decided there was a likelihood of confusion between the applicant's goods and the opponent. He also established that the applicant would be passing himself off by use of LE MANS as there is an obvious connection between car parts and organising motor races.

Don't fence me in

Another decision of the Trade Mark Registry rejecting three-dimensional shape applications! In this case, the applicant filed two UK trade mark applications for three-dimensional shapes for fencing panels. The application was rejected on the grounds that the shapes were not distinctive of the applicant. The Registry held that consumers would not make any assumptions about who supplied fencing based on its shape. The applicant tried to convince the Registry that the fencing had become distinctive of them through their use. However, the Registry found no use had been made of the marks applied for. Even a survey submitted by the applicant was rejected as it only showed recognition within the trade and did not reveal how the marks would be seen by a significant proportion of end users, the relevant customer. As with a number of other three-dimensional shape applications, the fact that there was no independent evidence was fatal to this application.

Cowell wins again

The success of POP IDOL spreads to the UK Trade Mark Registry. A UK trade mark registration for PUB IDOLS (covering karaoke machines and musical entertainment services amongst others) was attacked by the owners of the POP IDOL mark. It was claimed that the PUB IDOLS mark should be declared invalid because it was confusingly similar to POP IDOL. The Registry found that the marks PUB IDOLS and POP IDOL are similar, the mark POP IDOL has a reputation and that the public at large would believe that the PUB IDOLS services were linked with POP IDOL. This was despite the first words of both marks being ordinary English words which on their own are very different. In addition, the Registry decided that PUB IDOLS was passing itself off as being connected with POP IDOL and the owners of POP IDOL could suffer damage by trade being diverted from them and the trade reputation being injured if there were any failings in PUB IDOLS goods and services.

A little knowledge goes a long way Tin Tin

The Court of First Instance has issued two further decisions about trade marks containing two descriptive elements.

The applicant applied for the trade mark BIOKNOWLEDGE for various goods and services including databases providing information about organisms and information and computer services in respect of developing and providing access to databases containing information relating to organisms. As the mark consists of the elements BIO and KNOWLEDGE, the Court of First Instance found that the word BIOKNOWLEDGE has at least one possible meaning, that is providing information about living organisms. Since one of the meanings of the word is descriptive, giving a clear message about a characteristic of the goods and services, the application must be refused registration. The word contained no other elements which could add distinctiveness. Adding together two descriptive elements without anything further does not make the combined mark descriptive. In addition, the fact that the word BIOKNOWLEDGE is not in a dictionary does not mean it is distinctive.

Brands update

The Court of First Instance has also considered three applications for SnTEM, SnPUR and SnMIX for metallic products. The Court of First Instance followed the decision of the Community Trade Mark Office that the applications were descriptive of the goods in question. The relevant consumers were metallurgy specialists. The element Sn is the chemical symbol for tin. TEM is an abbreviation of temper, a heat treatment characteristic of the goods in question, PUR of purity and MIX of mixture. A trade mark composed of elements, each of which is descriptive, is itself descriptive unless there is a difference between the combined word and the elements. The Court found there was no perceptible difference between the three marks and the sum of their parts. The applicant's argument that there are other ways of describing the same characteristics did not help them as this was immaterial. The applications were therefore rejected.

Stand up for Jesus

The Appointed Person in the UK has recently considered the provision of the UK trade mark law which prevents registration of trade marks if they are "contrary to public policy or accepted principle of morality". He also considered the right to freedom of expression under the European Convention on Human Rights. The mark in question was JESUS, applied for for a wide range of goods including soaps, clothing and games. The Appointed Person stated that the religious significance of a mark is not always sufficient to make a mark contrary to morality. The dividing line is between marks which are distasteful and marks which cause outrage. He stated that use of the name JESUS as a trade mark would offend certain religious sensibilities and would cause greater offence than mere distaste. He therefore refused the application. He also considered that parties have a right to freedom of expression and that the ability to refuse "immoral" trade marks could be a limit on this right. Free speech should not be illegitimately diminished. However, he stated this right to freedom of expression had to be moderated by the right to reject offensive trade marks. The fact that CHRIST and JESUS 2000 are Community trade mark registrations is not relevant to the situation in the UK.

A premium trade mark

In contrast to BLOKKNOWLEDGE, the Court of First Instance has allowed an application for EUROPREMIUM. This application covered goods intended for packing, storage or transport, advertising and transport and storage services.

Initially, an objection was raised that the mark was descriptive as it was likely to be perceived by consumers as an indication of the quality and European origin of the applicant's goods and services. The Court stated that it was in the public interest to allow all parties to be able to use descriptive marks and no party should be able to monopolise them by registering them as trade marks. The Court also found that EURO would be understood by consumers in general (the relevant public in this case) as a reference to EUROPEAN, and PREMIUM would be understood to mean of high quality.

However, the geographical origin of the goods and services in question, which relate to postal transport, was not a characteristic which determined the consumer's choice. In addition, PREMIUM was merely a laudatory term rather than descriptive. As such, because neither element described the goods and services in question, the application was allowed.

Use all at sea

Readers of *Brands update* will be aware that a UK trade mark registration has to be put to genuine use and that if it is not genuinely used for a period of five years or more following registration, it can be removed from the Register.

The long-standing dispute about the trade mark LABORATOIRE DE LA MER has recently returned to the UK following a reference to the European Court. The point at issue was whether an £800 sale of Class 3 products (perfumes and cosmetics containing marine products) sold by the proprietor to the proprietor's agent was sufficient genuine use.

The agent was a small enterprise based in a fishing village in Scotland and after the sale, ceased business and was struck off the register of companies.

The question for the Court to consider - was it necessary to have goods bearing the mark come to the attention of members of the public in the UK or was it sufficient for such goods to be imported into the UK with a view to their subsequent sale to the public even though, by reason of the fact that the distributor who imported them ceased to

Brands update

operate, no sale to the public occurred? Which is genuine use? The Court found that the trade mark owner's use has to be sufficient to maintain or create a share in the market for the goods in question. Whether the use is genuine use will depend on the facts of the case. The Court stated that the sale or offering for sale (for example, in a trade magazine) of a single costly item in a specialised market may be sufficient. However, the sale of a low-priced everyday product (for example, the sale of a single jar of face cream or offering for sale half-a-dozen such jars on a shop shelf) would almost certainly not be.

In this particular case, the sale over five months of £800 worth of products to the distributor was not sufficient as there was nothing to indicate the products were ever offered for sale to members of the public or that the public's attention was brought to them by other steps such as advertising. The mark was revoked.

[Contents page](#)

Tip of the month

No two bites of the SPAM cherry

This issue's practical tip comes out of the disputes between the manufacturer of SPAM and the owner of the registered trade mark SPAMBUSTER.

The claimant in this particular case had brought an action in the UK Trade Marks Registry claiming the mark SPAMBUSTER was invalid. The action was dismissed.

It later brought an action in the High Court claiming that the mark was invalid and also should be revoked. The Court struck out the invalidity claim stating that the claimant was now barred from attacking the mark on the grounds of invalidity having raised this matter once and failed. More importantly for these purposes, the Court also struck out the claims for invalidity and revocation on the grounds of an "abuse of process". The Court made it clear that the claim for revocation should have been made at the time of the earlier proceedings.

A claimant should therefore take care that, when it wants to attack a mark, it relies on all the grounds it can at that particular stage. If it fails to do so, it may be prevented from bringing an action later on the grounds that it did not rely on in the first action.

[Contents page](#)

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[Contents page](#)