

December 2007

Brands Update



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Main news

18 months on - the impact of the new Olympics legislation

In March 2006, the London Olympic Games and Paralympic Games Act became law. Coupled with the existing Olympic Symbol (Protection) Act of 1995, it created some formidable protection for intellectual property relating to the Olympic Games. 18 months on, we take a look at what brand owners should know.

The law

Twelve years ago, the Olympic Symbol etc (Protection) Act 1995 ('OSPA') came into force. It prohibits anyone from using various Olympic mottos, symbol, or the word "Olympics" (and any variations). Furthermore, it prevents anyone from using these elements "or anything so similar as to be likely to create in the public mind an association with it".

As part of the quid pro quo of a successful bid for the Olympics, the International Olympic Committee now requires every host city to take steps to prevent ambush marketing and unauthorised exploitation of the Olympic rights. London achieved this through the controversial London Olympic Games and Paralympic Games Act of 2006 ('London Olympics Act'). With it, the protection for the Olympic rights was bolstered considerably.

It should be noted that OSPA applies to the Olympic rights globally, that is irrespective of where and when the Games may be held. As a result, OSPA also applies to the forthcoming Beijing Olympic Games to be held next year. The London Olympics Act, in comparison, applies only in respect of rights relating to the 2012 Games being held in London.

Ambush marketing

Ambush marketing, according to the body tasked with organising the 2012 Games (the London Organising Committee of the Olympic Games, or 'LOCOG'), is a serious concern. The primary source of the £2 billion funding required to organise and host the Games is the private sector – that is through commercial sponsorship. In order to raise funds, LOCOG must, it says, be able to assure potential sponsors of the value of their investment.

For those not willing, or able, to pay the substantial sums required to become an official sponsor, there is considerable temptation to piggy-back on the Olympic hype – perhaps by (as has been the case in previous Olympics) broadcasting allusive advertisements at key times; buying advertising space around official venues; or handing out free branded merchandise or other promotions which imply a link with the event – all without paying a penny to LOCOG or the IOC. This dilutes the return on sponsorship investment and, LOCOG maintains, affects the price businesses are willing to pay for it.

Some forms of ambush marketing may be 'traditional' infringements of, for example, a registered trade mark or passing off. Protection for these traditional infringements is achieved through the OSPA. However, ambush marketing has proved itself to be sophisticated enough to be capable of avoiding "traditional" infringements whilst still making an unauthorised association with a sporting event. In addition, ambush marketing can take many different forms. OSPA is not broad enough to catch all potential forms of ambush marketing and the London Olympics Act was introduced with the intention of plugging this gap.

The London Olympic Association Right

The London Olympics Act created the 'London Olympic Association Right' ('LOAR'), a brand new type of intellectual property right enforceable by LOCOG.

This right prohibits anyone from attempting to create an association between (i) the provision of goods/services or a person and (ii) the London Olympic Games. 'Association' is a very wide-ranging concept, encompassing the idea of any link with the Olympics – whether this link is commercial, contractual, financial or even sponsorship-based.

Importantly, this association can be in relation to any goods/services, and can be created using any words or images. There are some defences, but these are unclear, untested and do little to redress the impact of this legislation.

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In particular, the Act has effectively restricted the use of certain 'Listed Expressions'. It permits the courts, when deciding whether the LOAR has been infringed, to take account of the use by the party concerned of the following:

Any two of these words (Group A):

- Games
- Two Thousand and Twelve
- 2012
- Twenty-Twelve

Or, any word in Group A plus one or more of the following (Group B):

- London
- medals
- sponsors
- summer
- gold / silver / bronze

What this means for you

The new London Olympics Act does not appear to have been tested by the courts. No doubt LOCOG will be keen to bring a test case in the near future to send a message to the market that it is serious about policing its rights. However, it has been reported that LOCOG has threatened to take action against a number of companies or individuals, relying on its rights under both OSPA and the new London Olympics Act. Set out below are some reported examples that demonstrate that LOCOG is taking a hard line in enforcing its rights and brand owners need to be careful of making any association or reference to the Olympics, even in circumstances where it is clear that they are not holding themselves out as being official sponsors.

1. Little Chef, the restaurant chain, is well-known for its "**Olympic Breakfast**" and is entitled to use the name as its use predates the introduction of OSPA. Little Chef planned to run a promotional campaign for the 20th anniversary of the Olympic Breakfast and wanted to use Olympic medal winner Daley Thompson as the face and voice of the campaign. Little Chef notified LOCOG of its plans and sought LOCOG's permission for this use. However, LOCOG flatly refused permission, citing the need to protect the sponsorship interest of its global partner, McDonald's. The only concession offered by LOCOG was that Little Chef could use Daley Thompson on the strict condition that Thompson's involvement in the campaign remained anonymous, which, from Little Chef's perspective, obviously destroys the value of having a well-known celebrity to endorse its brand.
2. Kent County Council applied for a UK trade mark for "**KENT 2012**" in the form of a logo featuring a prancing horse and colours that were similar to the colour of the Olympic rings. What is unusual about this is the fact that Kent County Council is not a commercial enterprise and some of the 2012 Olympic venues are in Kent. Nonetheless LOCOG reportedly objected to this application and the use of the logo by Kent and the application was eventually withdrawn, an opposition having been filed against it.
3. Children's author Robert Ronsson was threatened by LOCOG with legal proceedings over the title of his fictional children's novel, '**Olympic Mind Games**', reportedly to avoid any confusion as to whether the work was an official licensed product. The cover of the book featured the word "OLYMPIC" in the title and the word "GAMES" was arranged in a style and in colours that were similar to the placement and colours of the Olympic rings.
4. An Internet entrepreneur, inspired by demand for local housing during the Sydney Olympics, was reportedly requested to change his domain name "**london2012rentmyhouse.com**" to the rather less targeted URL "**londonrentmyhouse.com**".
5. A butcher whose premises overlooks the Games' sailing venue in Weymouth Harbour, was required to remove a sign displaying the Olympic rings made from multicolour sausages.

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Who should be concerned?

The reported examples listed above demonstrate that a wide range of activities potentially infringe either OSPA or the London Olympics Act and that LOCOG is serious about enforcing its rights. The scope of OSPA and the London Olympics Act is broad and the defences and exceptions under the legislation are vague. The full extent of LOCOG's rights will not be fully known until a case has been tested by the courts.

In general, brand owners are advised to seek legal advice before engaging in any advertising or marketing activity that refers to the Olympics or makes an association with the Olympics (such as using an Olympian or someone connected with the Olympics to promote a campaign). Although the opening ceremony for the London Olympics is still over four and a half years away, the legislation is already in force. No doubt Olympic fever will continue to build in the UK, particularly as the Beijing Olympics are fast approaching and brand owners wishing to support the London Olympics and the Olympics movement generally will need to be very careful about how they do so.

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Other news

This case will go on!

The recent ruling of the European Court of Justice ("ECJ") in the *Céline SARL V Céline SA* case will make it more difficult for brand owners to prevent the unauthorised use of a trade mark to designate a company, trading or shop name.

The case concerned a dispute between two French businesses over the use of the name 'Céline'. The owner of the trade mark claimed that use of Céline as the name of the defendant's shop was an infringement of its trade mark. The trade mark owner was successful before the French national court, but the defendant appealed on the basis that the Trade Mark Directive requires the mark to have been used in relation to goods or services, and that is not the case where the mark has simply been used as a company, trading or shop name. The French Court of Appeal sought guidance on this issue from the ECJ.

The ECJ held that, for there to be infringement, a mark must have been used in relation to goods or services. It further held that, merely adopting/using a mark as a company, trading or shop name, is not use in relation to any goods or services. Conversely, using the mark on goods themselves or their labelling or packaging would be sufficient. The ECJ said that it is for the national courts to 'fill in the gaps' between these two extremes, on a case by case basis. In doing so, the national courts should consider whether the way the mark has been used creates the impression of a link with the trade mark owner. This would occur where the target consumers were likely to interpret the use of the mark as designating the origin of the goods or services of the owner of the mark. The ECJ therefore left it for the French Court to decide whether the use made by the defendant of the 'Céline' mark was liable to affect the essential function of the mark.

The Céline decision will not be welcomed by trade mark owners. In particular, it will make it more difficult for trade mark owners to force third parties to change the name of their company, if that company is not trading. (The one exception will perhaps be where there is clear evidence that the third party intends to trade and to use the mark on the goods/services concerned.) Likewise, where a third party has simply adopted a mark as its company, trading or shop name, but has not used that mark in relation to the actual goods or services it offers, it will be more difficult for trade mark owners to take action. This is an odd result as it would be expected that unauthorized use of a mark at least as a shop name would amount to use in relation to retail services. Unfortunately, the ECJ appears to have decided otherwise.

It should be remembered that the Céline decision only relates to trade mark infringement. As far as the UK is concerned, rights holders should still be able to take action based on their passing-off rights under the principle established in *Halifax plc v Halifax Repossessions Limited*. In that case, the UK courts held mere registration of a company name amounted to passing-off - there was no other reason for registering the name other than to use or threaten to use or encroach on the claimants' well established goodwill. However, this will only be of benefit if the rights holder is able to establish that goodwill attaches to its mark in the UK.

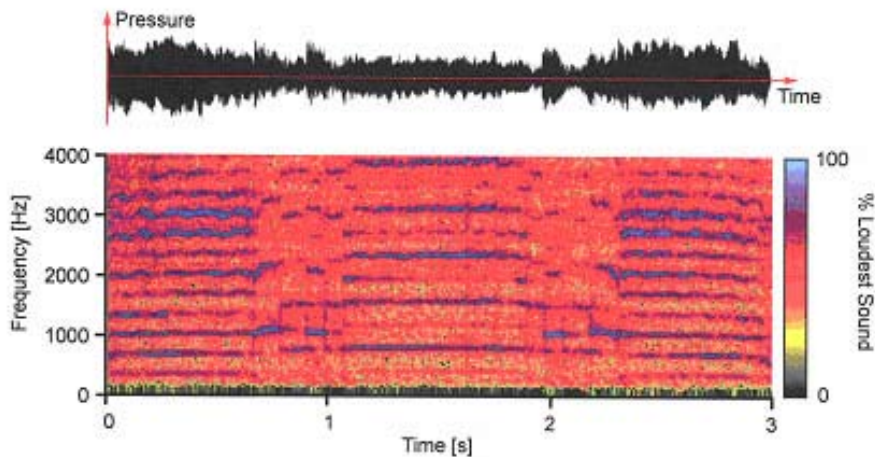
Tarzan's Yell

A basic condition for trade mark registration is that a sign is capable of graphic representation. The reasons are two-fold. First, a trade mark office must know what a mark is before they can examine it for registrability. Second, competitors need to be able to ascertain from the register what marks are protected so that they can avoid infringement. In *Sieckmann*, the ECJ stated that a graphical representation of a trade mark must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

An innovation of the harmonised European trade marks law was that non-traditional marks like sounds, smells, tastes and feels could be registered. However, for some of these marks, notably sounds and smells, satisfying the requirement for graphic representation has proved an uphill struggle. The distinctive TARZAN'S YELL provides an example.

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In February 2004, Edgar Rice Burroughs Inc. applied to register TARZAN'S YELL as a Community trade mark ("CTM") for a variety of goods and services ranging from clothing to entertainment. The yell was depicted through the combination of a description in words and the spectrogram (or sonogram) reproduced below.



The ECJ had indicated previously in *Shieldmark* that a sufficient graphical representation of a sound mark would be achieved through musical notation. A description in words and, or an onomatopoeia would not suffice. The ECJ did not comment on spectrograms.

In the *TARZAN'S YELL* case, the OHIM Board of Appeal held in September 2007 that the written description and spectrogram did not satisfy the requirement for graphic representation. Following *Shieldmark* the verbal description was unclear. Most people could not read a spectrogram and since the spectrogram could not be transformed into a sound, it was not only inaccessible but also non self-contained. The application was therefore refused.

However, a second application for *TARZAN'S YELL* also made in February 2004 did succeed. This time the sound mark was represented in musical notation, which satisfied the requirement for graphical representation.



On examination, the YELL was judged distinctive and the CTM was registered in May 2006.

Following *Shieldmark*, the implementing rules for the CTM were amended in 2005 to facilitate the graphical representation of sound marks. In particular, where a CTM application is filed electronically, it may be accompanied with an MP3 sound file.

Edgar Rice Burroughs Inc. has now made a third CTM application for *TARZAN'S YELL* in which the sound is graphically represented in a spectrogram (as above) and an MP3 sound file. OHIM have accepted the application, which has been advertised for opposition purposes.

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Paint It Black – Bad news for non distinctive trade marks

Two recent cases before the European Court of First Instance (“CFI”) show how difficult it can be to register a non-distinctive trade mark as a Community mark.

In the first application, the applicant applied to register the design of patterned glass for glass and other glass products. Following the initial rejection by the Community Trade Mark Office (“OHIM”) on the grounds the mark was not inherently distinctive, the applicant filed documents in support of its claim that the mark had become distinctive of its goods. Evidence included declarations from professionals in the glass sector stating that if they saw the design they would recognize it as a design of the applicant. The applicant also submitted evidence of sales for eight years and examples of advertising material and stated the mark had been used in the EU since 1970.

Declarations were filed from professionals within ten of the then fifteen member states which represented 90% of the population of the Community. Unfortunately such evidence was not sufficient. The CFI said that as there were no declarations from professionals in five member states the declarations from professionals in the other ten could not establish the required distinctiveness in the remaining five countries. Distinctiveness through use has to be shown throughout the EU.

The CFI went on to state that distinctive character could not be acquired by the “mere production of sales volumes and advertising material”. The Court noted that the applicant had not specified its market share which is of increasing importance in showing distinctiveness.

On the same day the CFI gave judgment on an application for the word BASICS for paints, varnishes and lacquers. The application was initially rejected on the grounds the mark was not distinctive and was descriptive as it may describe the most fundamental or commonly used goods which an artist or decorator may require.

The applicant’s argument that the mark had been registered in national countries was dismissed, the CFI finding that the Community Trade Mark Office is autonomous and exists independently of national trade marks.

The applicant attempted to show the mark BASICS had become distinctive of its products through use. It submitted sales figures for eleven years and also market share figures.

The CFI stated that acquired distinctiveness had to be shown in the part of the Community where the mark was not distinctive. In this case, BASICS being an English word, distinctiveness had to be shown in the then English speaking members of the European Union, the UK and Ireland. The CFI found that no goods bearing the BASICS mark had been sold in Ireland until after the application had been filed and the sales in the UK were minimal. It also stated that the applicant’s claim as to market share had not been proven. The application was rejected.

These cases show that for non-distinctive logo marks, evidence of acquired distinctiveness will have to be shown in all twenty-seven European Union countries. For word marks in an EU language, distinctiveness will need to be shown in the country/countries in the European Union where the language is spoken. Sales figures are not sufficient on their own and declarations and market share figures (which should be independently supported) are essential in showing distinctive character.

Catching a cold at the Registry – Another pharmaceutical decision

Influcare Limited filed an application in the UK for the mark FLUSENZA for goods including pharmaceutical products in Class 5. The application was opposed by MedImmune Vaccines, Inc on the basis of their UK registration FLUZEND for pharmaceutical products.

The hearing officer found that pharmaceutical trade marks are not subject to a different standard of test than other trade marks in relation to likelihood of confusion. In this particular case, the goods in the application and the goods covered by the registration covered both prescription and non-prescription products.

The hearing officer stated that the marks had to be assessed by reference to their overall impressions and he could not indulge in an artificial dissection of the trade marks. He stated that he did not consider that the average consumer would divide the words up and discard the FLU element which he said “might describe” the purpose of the goods.

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The hearing officer rejected the applicant's claim that he should ignore the FLU prefix as it could be descriptive in relation to certain goods. He stated that one element of a mark cannot be discarded although little weight may be given to it. He found that the marks were phonetically and visually similar and that there was no conceptual dissimilarity. In the light of this, he found that there was a likelihood of confusion. This is another case where the end consumer's opinion is important in assessing similarity between pharmaceutical trade marks.

What's the use? More guidance from the EU Courts

In two recent cases, the CFI and ECJ have provided further guidance on what amounts to "genuine use" of a mark - a key issue arising in opposition proceedings where the applicant of a later mark who is challenged by the owner of an earlier mark that has been registered for more than five years requires the opponent to prove that it has used - and is therefore entitled to rely on - the earlier mark.

In the first case, La Mer Technology, Inc. applied to register the word mark LA MER as a CTM for (among other things) cosmetic products in class 3. The application was opposed by Laboratoires Goëmar, based in particular on its earlier French trade mark registration for the LABORATOIRE DE LA MER word mark, covering marine products-based cosmetics.

The CTM opposition proceedings formed part of a wider battle between the two companies regarding these marks, waged in a number of jurisdictions - including UK Court revocation proceedings involving a previous referral to the ECJ on the question of Laboratoires Goëmar's "genuine use" of its earlier UK mark.

The OHIM Opposition Division upheld the CTM opposition on the grounds that there was a likelihood of confusion between the marks and that, pursuant to La Mer Technology, Inc.'s proof of use request, Laboratoires Goëmar had established genuine use of its earlier French mark. La Mer Technology, Inc.'s appeal was dismissed by the Board of Appeal, and the case was appealed to the CFI.

On the question of Laboratoires Goëmar's use of its earlier mark, the CFI set out the requirements for proving use established under a line of European Court cases, including that: there is genuine use where the mark has been used in a real sense to create or preserve an outlet for the relevant goods or services; token use purely for preserving trade mark rights does not count; the mark must have been used publicly and outwardly; even minimal use can be sufficient provided it maintains or creates a market share in the relevant sector; and use must be demonstrated by solid and objective evidence.

The evidence of use submitted by Laboratoires Goëmar was arguably small. It included 10 invoices, confirmation by a printing company of the production of order forms for Laboratoires Goëmar, a brochure, a number of packaging samples and two advertisements. La Mer Technology, Inc. also claimed that the evidence showed use of LABORATOIRE DE LA MER as a company or trade name, as opposed to a trade mark.

The Court held that the evidence supplied, although not considerable, was sufficient to establish genuine use of LABORATOIRE DE LA MER as a trade mark. In particular, the Court noted that the 10 invoices were illustrative only, and so did not represent the total amount of actual sales. Sales effected in two of the invoices singled out by the Court, totalling around Euros 420, were deemed not to be so low that the use could be said to be merely token.

The Court also upheld the finding that the marks were confusingly similar - in particular based on the overall conceptual similarities between the words LA MER and LABORATOIRE DE LA MER, the word LABORATOIRE being descriptive and having a low distinctiveness in respect of cosmetic products.

The CFI's judgment provides further confirmation that, although there is no fixed minimum threshold for establishing genuine use, that threshold is relatively low, provided some level of non-token, public and outward-facing use can be established.

In contrast with the proof of use evidence relied on in the LABORATOIRE DE LA MER case, the evidence submitted in the THE BRIDGE case discussed below - namely, a catalogue and a small number of advertisements - was held to be insufficient by the ECJ. In that case, the ECJ also confirmed that the owner of the earlier mark does not necessarily need to establish continuous use of the mark throughout the whole of the relevant five year period, provided that the scale and frequency of use demonstrate that the mark was used in an effective, consistent and stable manner.

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Company names and the Companies Act 2006 – A new hope

The recent ECJ decision in the case of Celine (discussed above) has focused brand owners and lawyers' minds on the issue of company names. Whilst the decision delivered a blow to the enforceability of registered trade mark rights where a third party is using a registered trade mark as its company name but not in relation to its goods and services, the Companies Act 2006 brings a new hope and a significant overhaul to the existing regime of company names in the UK.

Sections 66 to 74 of the Companies Act 2006 (the "Act") deal with the similarity of a company's name to other names. The Department for Business, Enterprise and Regulatory Reform (BERR) recently announced that these provisions will come into force on 1 October 2009, a year later than originally intended. However, it is possible that the commencement date will be brought forward again to October 2008. BERR is due shortly to make its final decision on this.

Section 66(1) is nothing new and prohibits the registration of a company under a name that is already in existence. However, section 66 also gives the Secretary of State the power to make regulations dealing with which matters are to be disregarded and which words, letters and symbols are to be taken as the same when comparing a proposed name against an existing name.

BERR has published draft regulations (titled the Companies (Company and Business Names) (Miscellaneous Provisions) Regulations 2007) dealing with this. Notable included matters which are to be disregarded are the word "plus", the symbol "+", "www" where it appears at the beginning of the name, and the words "UK", "group", "imports", "com", "co uk", and "eu" where they appear at the end of the name. So, for example, the names "BP+ Limited", "WWWBP Limited" and "BP CO UK Limited" cannot be registered due to the existing registration of "BP Plc". However, this does not prevent the registration of similar names within a group of companies, provided written consent is given and submitted to Companies House by the earlier company.

Section 67, as under the previous law, gives the Secretary of State the power to direct a company to change its name if it has been registered in a name that is the same as or too like an existing name. Under section 68, any such direction must be given within 12 months of the company's registration and must specify the period within which the company is to change its name. A failure to comply with the direction is an offence committed by the company and every officer of the company who is in default.

Most important is the new right set out in section 69 of the Act, entitling any person to object to a company's registered name. This does not just give companies the right to object but also individuals. An objection may be brought on the ground that the company's name is the same as a name associated with the applicant and in which he has goodwill, or that it is sufficiently similar to such a name that its use in the UK would be likely to mislead by suggesting a connection between the company and the applicant. The Act defines "goodwill" as reputation of any description but it is not yet clear whether there will in fact be a threshold to meet.

The Act lists a number of defences to an objection. First, that the name was registered before the commencement of the activities which the applicant relies on to show goodwill. Second, that the company is operating under the name or is proposing to do so and has incurred substantial start-up costs in preparation or was formerly operating under the name and is now dormant. Third, that the name was registered in the ordinary course of a company formation business and the company is available for sale to the applicant on the standard terms of that business. These three defences, however, will be defeated if the applicant shows that the main purpose the name was registered was to obtain money (or other consideration) from the applicant or to prevent him from registering the name. The fourth defence is if the name was adopted in good faith. Finally, it is a defence if the respondent can show that the interests of the applicant are not adversely affected to any significant extent.

The objection is made to a company names adjudicator and the Secretary of State is given the power to appoint such adjudicators and to make regulations to govern the proceedings before them. The DTI (predecessor to BERR) proposed that these regulations extend to the admission of evidence and the management of proceedings and that they be based on the Registered Designs Rules 2006 with UK Intellectual Property Office members appointed as adjudicators.

If an objection under section 69 is upheld, the adjudicator shall direct the company to change its name to one that does not raise objection and set a deadline for such change. If the name is not changed by the deadline, the adjudicator may determine a new name for the company.

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The new regime will give brand owners another route to take against companies that are registered with names that use their names and marks. The advantages of bringing an objection before a company names adjudicator are that there is no need for a trade mark registration to be held, nor is there a requirement to show that the company is using the name in relation to its goods or services. The right to object bears similarities to passing off rights, although there is currently no need for an applicant to show damage and the goodwill requirement looks to be an incredibly low burden to pass. We will have to wait for the commencement date before we can really appreciate the benefits and burdens of the new system but the provisions can only be good news for brand owners and are likely to be all the more important in the wake of Celine.

Tom (and Ben) and Jerry

Two recent decisions of the UK Trade Marks Registry have shed some further light on the interpretation of the absolute grounds for refusing registration, under Section 3(1) of the Trade Marks Act 1994.

The applicant applied to register LICK ME ICE CREAM for ice cream and other frozen confectionery under Class 30. The application was opposed by Minghella Ltd, who contended that the mark offended against Sections 3(1)(b) and 3(1)(c) because it is entirely descriptive of the manner in which the goods are consumed and would not be seen as an indication of origin by consumers.

As to whether the mark is distinctive, the Hearing Officer found that while the words "LICK ME" would be understood as an invitation to consume the product, it is unusual in that it is the product itself which is extending the invitation. In addition the mark is grammatically incorrect and although it is easily understood it is also syntactically unusual. The Hearing Officer found that the average consumer, in this case the general public, would take the term "LICK ME" to be a badge of origin just as it would "Ben and Jerry's". As a result, the opposition under Section 3(1)(b) failed.

The opposition under Section 3(1)(c) also failed. While the Hearing Officer accepted that the words "ICE CREAM" described the products for which registration was sought, he did not accept the contention that "LICK ME" served as a sign or indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods, or other characteristics of the goods. He found that "LICK ME" alluded to the quality being so good that you would want to lick it in order to prolong the experience but that this is not a usual method of describing such products.



The second decision concerned the application to register the device mark set out to the left, in Class 30 in respect of "confectionery, chocolate and chocolate products, pastries". The Registry objected, under Section 3(1)(b) stating that the mark consisted "essentially of the device of a mouse being a representation of the goods" and so "was devoid of distinctive character for confectionery products in the form of a chocolate mouse". The applicant argued that the mark might allude to a characteristic of the goods, but was not a representation of the goods. The Hearing Officer accepted that the mark was "not an actual representation of the product" but maintained that it was "closely similar" so that the average consumer would see the mark on a wrapper as an indication that the package contained chocolate mice, chocolates decorated with the image of a mouse or goods decorated with chocolate mice and not as a badge of origin of the goods. The Applicant appealed and argued that the mark does not consist simply of a picture of a mouse but that it has somewhat anthropomorphic features, is shown on a background which shades from bright blue to white and that there is a white cloud or "milk spill" across the mouse's middle designed to carry the name of the product. The Applicant also emphasised that the mark is not a representation of the particular products upon which it has been used to date. The Appointed Person accepted this point noting that those goods consist of small, individually wrapped, basically trapezoid, filled chocolate sweets. The sweets are moulded roughly into the shape of an animal, which could be a mouse or a cat and certainly do not much resemble the mouse in the device mark.

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The Appointed Person found that the relevant public, in this case the general public, are accustomed to perceiving figurative marks as signs identifying commercial origin and that there is nothing special about the trade in confectionery, chocolates and pastries in this respect. While there are products on the relevant market which consist of a range of chocolate-shaped animals, the Appointed Person found that the mouse device is plainly stylised and is not a mere representation of the product, in part because the additional elements of the mark, particularly the “milk spill” distinguish the mark from a purely descriptive sign. The Appointed Person accepted that the mark may allude in some way to the nature of the products sold under it, but mere allusion to the characteristics of a product, not amounting to descriptiveness, will not preclude a mark from registration. Despite the modest degree of distinctiveness, the mark was registrable.

Il Ponte fails to establish “Bridge” family

Where a proprietor owns a number of marks with a common element, for example, the EASY- prefixed marks, they may be able to employ a family or series of marks argument to prevent a competitor from registering or using a trade mark containing the same element. The principle is well established in English law and was recently confirmed by the ECJ in Case C-234/06 P, *Il Ponte Finanziaria SpA v. OHIM concerning THE BRIDGE and other handbag and leather goods marks*.

A family of marks argument will only work if a number of marks containing the same element in the same ownership are not only registered but also used in the market. It can then be said that the common element has gained added awareness or distinctiveness in the minds of the relevant public so that when a later mark, which also incorporates that element is encountered, the consumer mistakenly believes that here is another mark in the same family. Moreover, use of the later mark with the common element might enable the later user to free ride on the reputation of the family.

Il Ponte own a number of Italian registrations with “BRIDGE” in common including figurative and word marks for BRIDGE, THE BRIDGE, OLD BRIDGE and FOOTBRIDGE. They opposed a later CTM application for BAINBRIDGE in relation to similar goods. Their family of marks argument failed because they failed to furnish proof that the marks claimed to be within the family (or at least a sufficient number) had been used.

The CFI whose decision was confirmed by the ECJ gave some useful pointers on when a family of marks argument might have optimum success. The strongest case will be where the common family element always appears in use in the same place, e.g., as a prefix or suffix and where the later mark displays characteristics that mean it can easily be associated with the family. The latter might not be the case where the common element is positioned elsewhere within the later mark or the later mark conveys a different overall impression to the consumer (which might be said of BAINBRIDGE and the “BRIDGE” marks).

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Tip of the month

On your (trade) marks, get set, go!

The UK Intellectual Property Office (“UKIPO”) has issued a consultation document on a proposed ‘Fast Track’ application process for trade marks (and patents). Under the proposed scheme the UKIPO would examine trade mark applications within 10 business days of receiving a completed application and fee. Currently, most applications take between four and six months to be examined, which can be problematic for businesses working to a short timescale, such as when launching a new product or issuing legal proceedings. As a ‘premium’ service, it is proposed that the fast track service would cost £500 per application (covering one class), £300 more than the standard service. Additional classes would remain at £50 per class for both services.

To be eligible to use the faster service the application would need to be filed electronically, paid for at the time of application, and would be limited to one trade mark (rather than an application for a series of marks). The UKIPO would then issue the results of the search for earlier conflicting marks and any objections to the mark within the 10-day period. It is envisaged that the fast track process would be used in around 10% of applications (approximately 4,000 per year). After the examination process (either the fast track or standard service) the application would then go through the statutory 3-month opposition period prior to registration, as is currently the case.

The consultation document is available through the [UKIPO website](#).

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Contacts

Taylor Wessing Intellectual Property specialists

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

Trade Marks specialists:

| | | |
|--------------------|---------------------|--|
| Ruth Annand | +44 (0)20 7300 4233 | r.annand@taylorwessing.com |
| Christopher Benson | +44 (0)20 7300 4803 | c.benson@taylorwessing.com |
| Charles Lloyd | +44 (0)20 7300 4806 | c.lloyd@taylorwessing.com |
| Roland Mallinson | +44 (0)20 7300 7081 | r.mallinson@taylorwessing.com |
| Richard Price | +44 (0)20 7300 4826 | r.price@taylorwessing.com |
| Jason Rawkins | +44 (0)20 7300 4834 | j.rawkins@taylorwessing.com |

Editor:

Christopher Benson

www.taylorwessing.com

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